

EASTERN CARIBBEAN SUPREME COURT

IN THE HIGH COURT OF JUSTICE

[CIVIL]

SAINT LUCIA

CLAIM NO. SLUHCV2021 /0359

BETWEEN:

THE INDEPENDENT TOBACCO FZE

Applicant Intended Appellant

And

- 1. REGISTRAR OF COMPANIES AND INTELLECTUAL PROPERTY**
- 2. KHAIRT AL MINAFIE CO FOR TRANSPORT AND GENERAL TRADING**

Respondents

Before:

The Hon. Mde. Justice Cadie St Rose-Albertini

High Court Judge

Appearances:

Mr Keith Isaac of Counsel for the Applicant Intended Appellant

Mr Mark Maragh of Counsel for the Second Respondent

Mr George K Charlemagne and Ms Kozel Creese appearing Amicus Curiae

2021: December 1, 20

DECISION IN CHAMBERS

- [1] **ST ROSE-ALBERTINI, J. [Ag]:** The applicant, The Independent Tobacco FZE ("IT"), seeks an extension of the time within which to appeal a decision of the Registrar of Companies and Intellectual Property ("the Registrar"), namely Decision No. 3/2021 in the matter TM/2019/00108 dated 29th July 2021 ("the Decision"). The Decision is the outcome of an application by Khairt Al Minafie Co. for Transport and General Trading ("KAM") to

register the trade mark "BUSINESS ROYALS Device" in Saint Lucia, to which IT filed an opposition to KAM's registration and use of the mark. The Registrar has decided in favour of KAM and permitted its registration and use of the mark.

- [2] The application to extend the time to appeal the Decision is supported by the affidavit of Mrs. Brenda Floissac-Fleming, one of the agents of IT in Saint Lucia. A Notice of Opposition to the application was filed by KAM, and is supported by the affidavit of Ms. Tisa Dawes, legal secretary for KAM's legal practitioner.

The Issues

- [3] Two issues have arisen for resolution:-
1. Whether the time within which to file the appeal should be extended?
 2. Should the Registrar be named as a party to the appeal?

Issue 1 : Should the time be extended for filing the appeal?

The Law

- [4] IT cites section 19 of the **Trade Marks Act**¹ ("the Act") as the basis of its right to appeal the Decision. This section 19 provides a right to an applicant, who applies to register a trade mark, to appeal against a decision of the Registrar either rejecting the application or accepting it subject to conditions or limitations. As IT was not the party who applied for registration of the trade mark this section is not applicable. The appropriate provision is section 40 of the Act which gives a party the right of appeal to the High Court, in circumstances where an application for registration of a trade mark has been opposed. That section allows the opponent to the registration of a mark, to appeal a decision of the Registrar to register the trade mark.

¹ Cap 13.30 of the Laws of Saint Lucia

- [5] An appeal to the High Court under any enactment is governed by Part 60 of the Civil Procedure Rules 2000 ("the CPR"). As stipulated in CPR60.2(1) and (2) it is initiated by way of a fixed date claim form to which must be annexed the grounds of appeal. CPR 60.5 requires that the claim form and grounds of appeal be served within 28 days of the date on which notice of the decision was given to the claimant.
- [6] Part 26 of the CPR outlines the court's general case management powers, and among them CPR 26.1(2)(k) permits the Court to grant an extension of time for complying with any rule. It states: -
- "(2) Except where these rules provide otherwise, the court may -*
- (k) extend or shorten the time for compliance with any rule, practice direction, order or direction of the court even if the application for an extension is made after the time for compliance has passed;"*
- [7] Of note also is CPR 26.9(1) which empowers the court to rectify matters, where a procedural error has occurred. This rule only applies where the consequence for failure to comply with a rule has not been specified by any other rule and states: -
- "(3) If there has been an error of procedure or failure to comply with a rule, practice direction, court order or direction, the court may make an order to put matters right."*
- [8] No consequence is stipulated for failure to file and serve an appeal within the time stipulated in CPR 60.5, thus, the Court has the discretion under Part 26 to extend the time for compliance, to put matters right. The matters to which the Court should have regard when exercising this discretionary power are established by case law. Additionally, the Court is required to give effect to the overriding objective for dealing with cases justly, when exercising any discretion given by the rules.²
- [9] The relevant considerations for granting extension of time were addressed in **John Cecil Rose v Anne Marie Uralis Rose**³, where Sir Dennis Byron CJ stated:

² CPR 1.1 & 1.2

³ Civil Appeal No. 19 of 2003 (Saint Lucia)

"[2] Granting the extension of time is a discretionary power of the Court, which will be exercised in favour of the applicant for good and substantial reasons. The matters which the Court will consider in the exercise of its discretion are: (1) the length of the delay; (2) the reasons for the delay; (3) the chances of the appeal succeeding if the extension is granted; and (4) the degree of prejudice to the Respondent if the Application is granted."

- [10] Similarly, in **BBL Limited and Irina Savelieva v Canouan Resorts Development Limited and Canouan Realty Limited**⁴, Farara JA. put it this way:

"[57] ...this discretion is not to be exercised in a vacuum, but in accordance with well-established principles, and with a view to giving effect to the overriding objective. It is trite that in determining an application to extend time or to vary the time imposed in an order of the court for compliance, the court must consider (i) the length of the delay, (ii) the reasons for the delay, (iii) any prejudice to the respondent; and (iv) whether the applicant's pleaded case is, in any event, a hopeless one - the chances of success. However, these four considerations or factors, which to some extent are reflected at CPR 26.8(2), are not exhaustive of the matters to be taken into account by the court in determining an application to extend or to vary time for compliance."

- [11] Again, in **Carleen Pemberton v Mark Brantley**⁵, Periera CJ. said:

"[12]...This discretionary power, although a very broad one, cannot be exercised in a vacuum or on a whim, but must be exercised judicially in accordance with well established principles. Overall, in the exercise of the discretion the court must seek to give effect to the overriding objective which is to ensure that justice is done as between parties."

The Principles

[13] Much depends on the nature of the failure, the consequential effect, weighing the prejudice, and of course the length of the delay, and whether there is any good reason for it which makes it excusable. This is by no means an exhaustive list of all the factors which may have to be considered in the exercise. Another very important factor, for example, where the application, as here, is to extend time to appeal, is a consideration of the realistic (as distinct from fanciful) prospect of success."

⁴ SVGHCVAP2019/0006

⁵ HCVAP2011/009 (Saint Christopher and Nevis)

Analysis

Length of the Delay

- [12] This factor must be considered in the context of the circumstances of the case, in particular the reason(s) for the delay⁶ and that such delay must be reasonable and not inordinate. In **Harold Simon v Carol Henry and Tracey Joseph**⁷, Singh JA explained: -

"In deciding whether this can be described as being reasonable or as being inordinately long, the application will have to be considered in accordance with its own particular facts and a relevant factor for such consideration would be the reason for the delay. If there is no reason or the reason is unacceptable then there should have been no delay..."

- [13] IT's evidence is that notice of the Decision was received on 30th July 2021 and the appeal ought to have been filed by 30th August 2021. As the application for extending the time was made on 30th August 2021, which was within the time for filing the appeal, it could not be said that there was any delay as such, because IT applied to extend the time for compliance before the stipulated time for such compliance had expired.

- [14] It is generally accepted that delay is measured from the expiry of the date for compliance. Thus, the application was made promptly. This was the view taken by Farara JA in **BBL Ltd.** when he said: -

"[59] This question of the length of the delay is not, in my view, in issue in this case, as the appellants' October 2018 application was filed some 5 days prior to the expiration of the time imposed in the unless order for the filing and exchange of the witness statements. The appellants acted with promptitude when they realised they would not be in a position to file their witness statements within the period of approximately 1 month granted by the learned judge..." [Emphasis added]

- [15] KAM took issue with the fact that IT filed an amended application on 27th October 2021. The original application had requested that the time for filing the appeal be extended to 15th October 2021. In the amended application that date was changed to 15th December 2021. KAM says that days after the initially requested extension had passed, IT sought a further extension.

⁶ See *Rose v Rose* at paragraph 3 (supra note 3).

⁷ Civil Appeal Motion Suit No. 1 of 1995, at page 3.

- [16] For the reasons already stated this argument is of no moment, given that the original application was filed within the time for filing the appeal. In any event, the reason for amending the date requested in the original application, is because the application would not have been heard by that date, as it was listed for hearing on 28th October 2021. This could not, in fairness, be held against IT.

Reasons for the Delay

- [17] The reason given for the delay in IT's affidavit in support is as follows:

•...instructing counsel, Sarmad Manto, was unable to provide timely instructions due to the applicant's intended applicant's busy travel schedule, the scale of the applicant's intended applicant's business comprising offices in the Middle East and Africa and attorney's offices in the Middle East and North America; the prevailing covid restrictions and a health emergency in his attorney's household. He was therefore unable to communicate and provide instructions for the appeal.

- [18] I agree with KAM that these are mere bald assertions which do not assist the Court, and do not, in any event, amount to good or cogent reasons for being unable to comply with the 28-day period for filing and serving the appeal. These assertions reveal that IT did not give any, or any sufficient attention to timely prosecution of its appeal, preferring instead to prioritize other matters such as travel and other aspects of its business. Modern technology allows for communication across borders, the use of which has not been affected by Covid 19 restrictions. The courts have pronounced time and again that the lack of diligence on the part of an attorney is not a good reason for delay, whether it is explained in terms of the volume of work the attorney is maintaining, or difficulties experienced in communications.⁸

- [19] The only seemingly acceptable reason given is the health emergency in the attorney's household, but this has not been particularized in any level of detail to qualify as a good reason. Where an applicant has failed to put forward cogent evidence in support of such application, the position of the Court of Appeal in **BBL Ltd.** is instructive. It was said that:-

⁸ See *Rose v Rose*, at paragraph 4 (supra note 3)

"[61J Dealing specifically with the legal and evidential burden placed on applicants for such relief, and the quality of evidence which an applicant ought to put before the court in support of such an application, the learned Chief Justice opined (in part) at paragraph 15:

"The onus was on the appellant to show by credible and particularized evidence that he had met the threshold warranting consideration of the grant of relief. He was required to clearly demonstrate to the court that his failure to file his witness statements was not intentional - in essence that he had taken all reasonable steps to meet the timeline and then to show why notwithstanding taking such reasonable steps, that he was unable to meet it. I agree with the learned judge that the information that the appellant chose to put forward for the judge's consideration was woefully inadequate... The court must be given a clear, detailed and accurate picture of what occasioned the failure and what was done in seeking to remedy it. Up to the time of the hearing, there was no evidence produced that the witness statements had been signed and were ready for exchange far less exhibited in an effort to demonstrate diligence.»
[Emphasis added]

[20] IT has not shown what diligent or reasonable steps were taken towards ensuring that the appeal was filed in time, and why, notwithstanding such steps, it was unable to meet the deadline. Thus, a good explanation or good reasons for the failure have not been proffered. Nevertheless, without diminishing the importance of complying with the rules, the absence of good reasons must be considered in the context that what is before the Court which is an in-time application to extend the time for filing the appeal.

[21] Although IT has not provided good reasons for the inability to file the appeal in time, that is not fatal to the application, and due regard must be given to all the other factors which must be weighed in the balance. The Court of Appeal explained this exercise in the **BBL Ltd** case, in this way:-

"[67] However, the matter does not end there because, even where an applicant for relief pursuant to CPR 26.1(2)(k) has failed to satisfy one of the considerations for the grant of an extension of time to comply with an order of the court, such failure is not immediately fatal to the application, ... In discharge of its duty to do justice to the parties, the court must consider all the factors and circumstances put before it, including the effect which a refusal will have on the applicant and its case; whether the failure can be remedied within a reasonable time; what effect the extension sought would have on the litigation including on any trial date; what, if any, prejudice an extension would cause to the other party or parties to the litigation; the proportionality of refusing to grant the

extension sought in relation to any failure to comply with the court's order; and that, in the interest of the proper administration of justice, the orders of a court, especially unless orders, must be obeyed, unless there is some good reason for excusing the non-compliance. **Put another way, the court must apply the overriding objective in determining which way to exercise its discretion and, in doing so, the relevance of the factors relied on and the weight to be attached to each such factor, is a matter for the court to decide in all the circumstances.**"⁹ [Emphasis added]

Prospect of Success

- [22] In BBL Ltd. the Court of Appeal explained the threshold for "chance of success" and how the courts ought to weigh this factor. Farara JA stated:

*"...However, I observe from prior decisions of this Court in cases such as Quillen v Harneys, Westwood and Riegels (No.1) and Joseph Hyacinth v Allen Joseph that significant weight ought only be attached to the chances of success where it is shown that the applicant's case is either hopeless, even where there are substantial reasons for the delay, (in which case the court should refuse to exercise its discretion to extend time) or where the chances of success are very strong (in which case the court has an admittedly broad discretion to extend time)."*¹⁰ [Emphasis added]

- [23] IT has said that there is a good chance of succeeding on appeal, because an appeal under Part 60 of the CPR is by way of rehearing and the High Court may receive further evidence on matters of fact. It is deposed that IT intends to adduce evidence in support of its appeal, including but not limited to the use of the mark "BUSINESS ROYALS" in Saint Lucia.

- [24] I have examined the Decision and note that IT raised three grounds of opposition before the Registrar. I also note that IT failed on each ground mainly because of a lack of evidence of its ownership and use of the trade mark within Saint Lucia, prior to KAM's application for registration¹¹.

- [25] On behalf of KAM, it was submitted that IT has not shown a good prospect of success because it has merely restated the grounds of opposition and has failed to advance any argument to show that the findings of the Registrar were indeed incorrect in her findings.

⁹ At paragraph 67 (supra note 4)

¹⁰ At paragraph 72 (supra note 4)

¹¹ See paragraphs 93, 99-103, 105-106 of the Decision

[26] The powers of the High Court on an appeal against a decision of the Registrar are contained in the Act and Part 60 of the CPR, which provide as follows:

"171. Powers of High Court

On hearing an appeal against a decision or direction of the Registrar, the High Court may do any one or more of the following-

- (a) admit further evidence orally, or on affidavit or otherwise;*
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Registrar;*
- (c) order an issue of fact to be tried as it directs;*
- (d) affirm, reverse or vary the Registrar's decision or direction;*
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;*

m order a party to pay costs to another party."

CPR 60.8, on hearing an appeal: -

"60.8 (1) Unless an enactment otherwise provides, the appeal is to be by way of rehearing.

(2) The court may receive further evidence on matters of fact.

(3) The court may draw any inferences of fact which might have been drawn in the proceedings in which the decision was made.

(4) The court may-

(a) give any decision or make any order which ought to have been given or made by the tribunal or person whose decision is appealed; and

(b) make such further or other order as the case requires; or

(c) remit the matter with the opinion of the court for rehearing and determination by the tribunal or person.

(5) The court is not bound to allow an appeal because of -

(a) a misdirection; or

(b) the improper admission or rejection of evidence;

unless it considers that a substantial wrong or a miscarriage of justice has been caused".

[27] The Act is modelled on the Australian Trade Mark Act, and the learning from that jurisdiction is instructive. Section 197 of the Australian Act is identical to section 171 of the Act. IP Australia, which is the Australian government agency responsible for administering Australia's intellectual property rights regime, in its **Trade Marks Manual of Practice and Procedure**, reiterates the nature of the appeal as follows :-

"Such an appeal is not an appeal merely to decide whether the decision of the Registrar can be supported but a complete re-decision, on the material before the court, of the entire question. The appeal is in the nature of a de novo hearing." ¹² [Emphasis added]

[28] The position is supported in **Malibu Boats West, Inc v Catanese**¹³, where the court noted:

6. Although the proceeding is styled an "appeal" (see s 51) **it is not a proceeding in the appellate jurisdiction of the Court, but in its original jurisdiction:** *A & F Pears Ltd v Pearson Soap Company Ltd* (1925) 37 CLR 340; *Jafferjee v Scarlett* (1937) 57 CLR 115; *Eclipse Sleep Products Inc v The Registrar of Trade Marks* (1957) 99 CLR 300. **Accordingly, the appeal must be determined as if it were an original application. Thus, it is not necessary to decide whether the decision of the Registrar was correct in law.** However, his decision should be taken into account, being the decision of a skilled and experienced person. [Emphasis added]

[29] In **Philmac Pty Ltd v Registrar of Trade Marks**¹⁴ it was said:

3. The appeal is brought pursuant to s 35(b) of the Act. Section 197 of the Act sets out the powers of the Court on hearing an appeal against a decision of the Registrar. It provides that the Court may do any one or more of the following:

- "(a) admit further evidence orally, or on affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Registrar;
- (c) order an issue of fact to be tried as it directs;
- (d) affirm, reverse or vary the Registrar's decision or direction;
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;

M order a party to pay costs to another party."

4. **That provision discloses a clear intention that an appeal of this kind be conducted as a new hearing:** *Blount v Registrar of Trade Marks* (1998) 83 FCR 50 (Blount) per Branson J at 59. The function of the Court is not to determine whether the decision of the Registrar can be supported or to traverse its correctness in law and fact. It is to determine, on the material before the Court, whether the Phi/mac application should be accepted or rejected: see *Blount*; *Registrar of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411. Weight should be given to the Registrar's opinion as that of a skilled and experienced officer, although the Court is considering the application afresh: *Jafferjee v Scarlett* (1937) 57 CLR 115; *Rowntree PLC v Roi/bits Pfy Ltd* (1988) 90 FLR 398. On this appeal, the Court, in lieu of the Registrar, is to apply the provisions

¹² IP Australia, Trade Marks Manual of Practice and Procedure, Part 52.5 - Rights of Appeal from Decisions of the Registrar, Paragraph 5.1 Appeal to the Federal Court or the Federal Circuit Court. Date Published: 06 Nov 2021. Found at: <https://manuals.ipaustralia.gov.au/trademark/5.-rights-of-appeal-from-decisions-of-the-registrar>

¹³ (2000) AIPC 91-605)

¹⁴ [2002] FCA 1551

of the Act and decide on the evidence properly placed before the Court whether the application for registration should be granted. [Emphasis added]

- [30] Thus, under Part 60 the Court has very broad powers on appeal against a decision of the Registrar and may receive further evidence on matters of fact in such manner as it sees fit, and draw any inferences as deemed fit. It is a rehearing or hearing de novo of the application and not a hearing to determine if the Registrar's decision can be supported. Therefore, KAM's argument that IT has not shown how the Registrar erred in law is immaterial, as this is not the function of the Court on hearing the appeal. In the circumstances, I am of the view that if IT can produce the requisite evidence on appeal, it has a good chance of success and not one that is merely fanciful or hopeless.

Degree of Prejudice

- [31] On behalf of IT, it was submitted that an extension of time will cause no prejudice to KAM, whilst denial of an extension will result in extreme prejudice to IT. It was further submitted that the Registrar has no identifiable interest in the appeal or the trade mark and will not be prejudiced in any way. KAM has been allowed to register the mark and filing the appeal would not operate as a stay of the Decision unless a stay is ordered by the Court or the Registrar. Therefore, KAM will remain free to use the trade mark in the ordinary course and for any commercial purpose as it may desire, even if the application is granted, and the appeal filed. Further, it is argued on behalf of IT that as the extended date requested is due to elapse in less than a month, KAM would not be left with the possibility of the appeal negatively impacting its affairs for an inordinate period of time. Conversely, should the application be refused, IT will be stripped of its sole right of appeal and would be left with no recourse for the potential harm which it has suffered from the Decision. This outcome would be particularly egregious considering that the appeal is to be by way of rehearing which is meant to provide IT with a fresh opportunity to present evidence and law on which the Court can then make any order that it sees fit.
- [32] It was submitted on behalf of KAM that the actions of IT are highly prejudicial as KAM has been held to ransom by the failure to file the appeal within the requisite period, and to

advance adequate reasons for such failure. This has caused unnecessary financial hardship and continuing legal expense to KAM.

[33] In my opinion KAM has failed to show any, or any substantial prejudice, that it will suffer as a result of granting of the application. The application was made during the time for filing the appeal and there was no delay. It is further inconceivable that the presence or absence of good reasons for failing to file the appeal within the time period impacts the prejudice that KAM may suffer, and KAM has failed to elucidate the connection. All that has been offered is the bald assertion that it will suffer financial hardship and legal expense, which is unsupported by any details or particulars.

[34] As KAM has been allowed to register the trade mark and is free to use it in the ordinary course, it is difficult to see what prejudice will be suffered by extending the time to file the appeal. On the other hand, I agree that IT stands to suffer grave prejudice if the time is not extended, as it will lose the only opportunity to appeal the Decision. Further as the appeal is to be by way of rehearing, coupled with the wide powers of the Court under Part 60, IT has the opportunity to place before the Court any evidence that it failed to adduce in the opposition proceedings before the Registrar and therefore has a reasonable chance of success on the appeal. In the circumstances I conclude that there would be little or no prejudice to KAM if the application is granted, but substantial prejudice to IT if denied.

The Court's Finding

[35] The application was filed promptly, having been filed within the period stipulated for filing an appeal. Although the reasons given for the inability to file and serve the appeal within the stipulated time were not good or cogent reasons, KAM has failed to demonstrate that it will suffer any prejudice if the application is granted, whereas IT has shown that it will suffer grave prejudice should the application be denied. IT has also shown that its case is not fanciful or hopeless and has a prospect of success. In the circumstances, applying the overriding objective to do justice between the parties, would warrant granting the application and extending the time within which to file the appeal.

Issue 2 : Should the Registrar be named as a party to the Appeal?

Law and Analysis

(36] The Act, the Trade Mark Regulations¹⁵ and Part 60 of the CPR do not address the question whether the Registrar should be made a party to an appeal filed pursuant to section 40 of the Act. Section 170 of the Act, however, expressly allows the Registrar to appear and be heard at the hearing of an appeal. Additionally, CPR60.4 provides *inter alia* that the claimant must serve the claim form and grounds of appeal on every party to the proceedings in which the decision was made, and the person by whom the decision appealed against was made.

(37] As mentioned before, the Act is modelled on the Australian Trademarks Act, and section 196 of the Australian Act is identical to section 170 of the Act. The Australian **Trade Marks Manual of Practice and Procedure**, states as follows:

"5.4 Role of the Registrar in an appeal

*According to Rule 34.23 of the Federal Court Rules, **the Registrar may appear and be heard in any proceedings, but is not a party to proceedings other than an appeal which is (a) from a decision of the Registrar and (b) in which there is no party in opposition to the party bringing the appeal.***

*In an appeal to the Federal Court from a decision of the Registrar in an **ex parte matter, the Registrar is clearly a party to the appeal.** Similarly, if an application is made to the AAT or to the Federal Court or Federal Circuit Court under the AD(JR) Act for review of a decision of the Registrar or a delegate in an *ex parte* matter, the Registrar or the delegate is a party to proceedings before the Tribunal or the Court and will appear or be represented. **In either forum the Registrar will articulate the merits of the matter and the law applicable but will avoid defending the decision in a partisan manner.** See *Phi/mac Pty Ltd v Registrar of Trade Marks* [2002] FCA 1551 at 5, and *Phi/mac Pty Ltd v Registrar of Trade Marks (No 2)* [2003] FCA 207 at 12.*

Opposition matters, by definition, involve two parties and thus the Registrar is not required to be joined as a party to an appeal from such a decision. However, section 196 of the Act provides that the Registrar may appear and be heard at the hearing of an appeal to the Federal Court or the Federal Circuit Court against a decision or direction of the Registrar and this applies

¹⁵ Statutory Instrument No 17 of 2003

even when there is a party in opposition. (See comments of Finkelstein J in *Malibu Boats West, Inc v Catanese* (2000) A/PC 91-605).

Normally the Registrar would not participate in inter partes proceedings. See for example *The Queen v. Australian Broadcasting Tribunal; ex parte Hardiman* [1980] HCA 13; (1980) 144 CLR 13, the source of the *Hardiman* principle.

There may be instances where it is appropriate for the Registrar to attend in the capacity of a Friend of the Court (*Amicus Curiae*). While this would rarely be the case, it may be appropriate where, as in the *Malibu* case (*supra*), the party in opposition did not appear. Justice Finkelstein approved the Registrar's appearance noting that:

"(t)his was a proper course for the Registrar to take. Often the Court is greatly assisted by the appearance of the Registrar in such circumstances. It is to be expected, as has occurred in this case, that the Registrar will make submissions in a non-partisan fashion."

See also *Advantage-Rent-A-Car Inc v Advantage Car Rental Pty Ltd* [2001] FCA 683 at 23 - 32.¹⁶[*Emphasis added*]

- [38] In *Malibu Boats West, Inc v Catanese*, the appeal arose from an application for registration of a trade mark which had been opposed. The application was refused, and the applicant for registration appealed. However, the opponent did not appear in the appeal. Finkelstein J made the following observations:

*"4. Notwithstanding the non-appearance of the opponent, the appellant is not the only party who appears. **The Registrar has intervened for the purpose of making submissions. The Registrar is entitled to take this course.** Section 115 of the 1955 Act provides that the court may grant the Registrar leave to intervene in an appeal to the court from a decision, direction or order of the Registrar. Further, O 58 r 3 of the Federal Court Rules provides that the Registrar may appear and be heard in any proceeding from a decision of the Registrar in which there is no party in opposition. The position is different under the 1995 Act. **Now the Registrar may appear as of right: sees 196. Presumably he may do so even when there is a party in opposition, notwithstanding O 58 r 3.***

*5. **The Registrar indicated that his appearance in this appeal was for the purpose of providing assistance to the Court because of the absence of opposition. This was a proper course for the Registrar to take. Often the Court is greatly assisted by the appearance of the Registrar in such circumstances. It is to be expected, as has occurred in this case, that the Registrar will make submissions in a non-partisan fashion.***"[*Emphasis added*]

¹⁶ IP Australia, Trade Marks Manual of Practice and Procedure, Part 52.5 - Rights of Appeal from Decisions of the Registrar, Paragraph 5.4 Role of the Registrar in an Appeal. Date Published: 06 Nov 2021. Found at: <https://manualsipaustalia.gov.au/trademark/5.-rights-of-appeal-from-decisions-of-the-registrar>

[39] In the case of **Philmac Pty Ltd v Registrar of Trade Marks**¹⁷, the applicant appealed under s 35 of the Trade Marks Act 1995 (Cth) from a decision of a delegate of the Registrar of Trade Marks that the trade mark applied for failed to satisfy the requirements of the Act. The application before the Registrar was not contested. Mansfield J noted the role of the Registrar in such an appeal:-

"5. The Registrar sought to play a non-partisan role at the hearing of this application. The interest in opposing the application was presented as being the public interest in the proper application of the provisions of the Act which delegates of the Registrar must regularly interpret and apply. In particular, the Registrar took the view that the determination of the application would assist in identifying the proper approach to be taken by delegates in the application of the Act to pending and future applications for registration of colour marks." [Emphasis added]

[40] **Advantage-Rent-A-Car Inc v Advantage Car Rental Pty Ltd** is another case in which a party to an opposition had not appeared in an appeal and therefore the Registrar joined as a party to the appeal. There, the applicant appealed from a decision of a delegate of the Registrar of Trade Marks dismissing its opposition to the registration of a trade mark and allowing the respondent's application for registration of the mark to proceed to registration. The first respondent (the applicant for registration of the trade mark) had not appeared. The Registrar filed a notice of appearance as allowed, under section 196 of the Trade Marks Act 1995 (Cth) and O 58 r 3 of the Federal Court Rules. Accordingly, the Registrar was joined as the second respondent in the proceedings.

The **Court's** Finding

[41] Like the Act, the Australian Trade Marks Act makes provision for the Registrar of Trade Marks to appear and be heard in an appeal from a decision of the Registrar. In that jurisdiction it appears that the rules only require the Registrar to be named as a party when the appeal involves a decision in which there is no opposing party. When there is an opponent who does not appear in the appeal, the Registrar may also file a notice of appearance to be joined as a party. Notwithstanding, it is accepted that the Registrar may appear and be heard as of right even when there is an opposing party in the appeal. The

¹¹ [2002] FCA 1551

rationale for the Australian approach is that where there is no opposing party, the Registrar's role is to provide assistance to the court in a non-partisan way.

[42] Although the Australian approach is not legislated in this jurisdiction, in the present case which is *inter partes*, where the applicant for registration of the trade mark has appeared and made submissions to the Court, there can be no need for the Registrar to be named as a party to the appeal. The cases cited above establish that the appeal is by way of rehearing or a de nova hearing in which the Court may consider evidence which was not before the Registrar and decide the case afresh as it sees fit. If for some reason, the Registrar wishes to appear, that right is enshrined in section 171 of the Act, and she may do so of her own volition.

Conclusion

[43] In concluding, I make the following orders:

1. The Applicant/Intended Appellant is granted an extension of time until 15th January 2022 to appeal against Decision No. 3/2021 in TM/2019/00108 dated 29th July 2021.
2. There is no requirement to join or name the Registrar as a party in the appeal.
3. There is no order for costs.

Cadie St Rose-Albertini
High Court Judge

By the Court

[SEAL]

Registrar