

Foll Rohmoser v Registrar of Trade Marks 70 ALR 613	Foll Stafford Miller Ltd v Jean Patou Parfumeur 11 IPR 409	Foll Canton & United Breweries Ltd v Miller Brewing Co 9 IPR 295	Cons Application by Yamen Pty Ltd, Re 16 IPR 383	Cons/Not Foll Danby Pty Ltd v Commissioner of Patents 15 ALD 739	Dist Danby Pty Ltd v Commissioner of Patents 12 IPR 151	Dist/Not Foll Danby Pty Ltd v Commissioner of Patents 82 ALR 491	Dist Mitty's Authorised Newsagency v Registrar of Trade Marks 78 FLR 217	Appl Atomic Skifabnk Alois v Reg of Trade Marks 13 FCR 199
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[HIGH COURT OF AUSTRALIA.]

THE KING

AGAINST

THE REGISTRAR OF TRADE MARKS ;

EX PARTE J. S. STAEDTLER.

Trade Mark—Registration—Opposition—Notice of opposition—Extension of time—Power of Registrar—“ Unless otherwise expressly provided ”—Trade Marks Act 1905-1922 (No. 20 of 1905—No. 25 of 1922), secs. 38, 105.*

H. C. OF A.
1936.

The power of the Registrar of Trade Marks under sec. 105 of the *Trade Marks Act 1905-1922*, “ unless otherwise expressly provided,” to extend the time specified for doing any act does not apply to the lodging of a notice of opposition to the registration of a trade mark under sec. 38. The provisions of sec. 38 relating to the time for lodging the notice “ otherwise expressly ” provide within the meaning of sec. 105.

MELBOURNE,
June 10.

Starke, Dixon,
Evatt and
McTiernan JJ.

RULE NISI for mandamus.

The firm of J. S. Staedtler of Nurnberg, Germany, applied for registration of a trade mark in respect of goods including pencils, chalks, ink, drawing paper and similar goods. The acceptance of the application was advertised in the Official Journal on 31st October 1935. The period of three months for lodging notice of opposition to the registration of the trade mark under sec. 38 of the *Trade*

* The *Trade Marks Act 1905-1922* provides :—Sec. 38 : “ Any person may, within three months after the advertisement of the application or such further time not exceeding three months as the Registrar on application made within the first period of three months allows, lodge at the Trade Marks Office a notice of opposition in duplicate to the regis-

tration of the trade mark, setting out the grounds on which he relies to support his notice.” Sec. 105 : “ Where by this Act any time is specified within which any act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.”

H. C. OF A.
1936.

THE KING
v.
REGISTRAR
OF TRADE
MARKS;
EX PARTE
J. S.
STAEDTLER.

Marks Act 1905-1922 expired on 31st January 1936 and no notice of any opposition to the registration of the trade mark and no notice of any application for an extension of time for lodging such notice was filed in the Trade Marks Office within such period. On 30th April 1936 an application was filed by the Royal Pencil Co. Ltd. of London for an extension of time for the purpose of lodging an opposition to the registration of the trade mark. J. S. Staedtler refused to consent to the extension of time and an application for such extension was made to the Registrar of Trade Marks, who granted the application, purporting to act under sec. 105 of the *Trade Marks Act*.

J. S. Staedtler obtained from the High Court a rule nisi for a mandamus to compel the Registrar to register the trade mark and issue a certificate of registration to the applicant.

Dean, for the prosecutor. Sec. 38 of the *Trade Marks Act* provides a period of three months within which to oppose the registration of the trade mark. It also provides that on an application made within such period of three months the period may be extended for a further time not exceeding three months. The application to extend the time was not made within the period of three months from the advertisement of the application as required by sec. 38. Moreover the Registrar extended the time for making the application beyond the period of three months provided by sec. 38. He purported to act under sec. 105, which gives power to extend times for the doing of anything required to be done under the Act, but this is subject to the provision contained in sec. 105, "unless otherwise expressly provided," and it is otherwise expressly provided in sec. 38. Sec. 38 expressly limits the time within which a notice of opposition may be made to three months from the advertisement. If it is not then made, it can only be made if the applicant has applied for and obtained an extended time within which to make his application, and an application for such extended time must be made within the first period of three months. There are times provided by the Act which may be extended under the provisions in sec. 105. It is the design of the Act that in applications under sec. 38, at the expiration of the time prescribed, the applicant will know exactly where he stands.

Tait, for the Registrar of Trade Marks. There is power under sec. 105 for the Registrar to extend the particular time in question here. The limit in sec. 38, "not exceeding three months," applies to further time that may be given for the lodging of the advertisement. The application to extend the time has to be made within three months unless the extension is granted. The words "unless otherwise expressly provided" in sec. 105 go with the words "may . . . extend" and are not attached to the following words. Time may be extended even though the time has expired for doing the act. In sec. 55, dealing with renewal applications, there is another form of words used. Under that section the Registrar cannot extend the term beyond the period of fourteen years.

H. C. OF A.
1936.
THE KING
v.
REGISTRAR
OF TRADE
MARKS;
EX PARTE
J. S.
STAEDTLER.

T. W. Smith, for the Royal Sovereign Pencil Co. Ltd. (on whom notice of the order nisi was directed to be served). Sec. 105 gives the Registrar a general power to extend the time, except where provisions in effect say there must not be an extension. A provision that an act must be done within a specified time is not such an express direction. In the present case the Registrar had power to extend the time. The rules relating to mandamus proceedings have not been complied with.

Dean, in reply. The provisions in sec. 38 are mandatory. There is a complete provision in sec. 38 for extending the time, and that provision cannot be overridden by sec. 105, which is a mere general provision. This is a proper case for mandamus.

The following judgments were delivered :—

STARKE J. I have more difficulty about this matter than my learned brethren in view of the arguments that have been put to us, but I am not prepared to dissent from their view that sec. 38 provides a complete and exhaustive statement of the conditions and the times within which extensions of time for lodging opposition may be granted.

The decision will be that there will be a rule absolute for mandamus, that the Registrar proceed in the application for the trade mark as one in which no opposition has been lodged within

H. C. OF A.
1936.

THE KING
v.
REGISTRAR
OF TRADE
MARKS;
EX PARTE
J. S.
STAEDTLER.

the time limited by sec. 38, or any time to which the same might lawfully be extended, and there will be no order as to costs.

DIXON J. I agree. By sec. 105, a general power is given to the Registrar to extend the times limited by the Act. It is a power which enables the Registrar to extend such a time either before or after its expiration. It contains no limit upon the period to which he may extend it. It contains no limit upon the time within which an application for extension may be made. Sec. 38 limits the period for lodging opposition to three months. It then proceeds to deal with the extension of that time. It imposes two conditions: first, that the time shall not be extended beyond three months and next, that the application for an extension shall be made within the original time. The words "on application made within the first period of three months" appear to me to be an express provision confining to the time limited for lodging the opposition the power of the Registrar to entertain an application for an extension of the time for opposition. This, in my opinion, is inconsistent with the full application of the general power given to the Registrar by sec. 105 to extend times after their expiration. It is true that the section does not say that the Registrar must allow an extension of time for opposition within the period limited for lodging the opposition. But sec. 38 does expressly require the making of the application to him for such extension within that period. This is necessarily restrictive of a power to extend a period after its expiration, which otherwise would be exercisable whenever invoked. It is, therefore, inconsistent with the full operation of the power derived by the Registrar from sec. 105. Sec. 47 shows the reason for this. It is that, on the expiration of time for opposition, when no opposition is lodged, the Registrar's duty to register becomes absolute. It appears to me that sec. 38 exhaustively states the conditions governing an extension of time for lodging opposition.

I agree that a mandamus should go in the form stated by *Starke J.*

EVATT J. I agree. The main command of sec. 38 is that any person may, within three months, lodge at the office a notice of opposition. Then the Legislature proceeds to permit of an extension of the period of three months. The provision added to secure such

purpose is that the notice of opposition may be lodged within "such further time not exceeding three months as the Registrar on application made within the first period of three months allows." This added provision includes interrelated matters and should be regarded as a unit and not analyzed into separate and independent powers. It authorizes the Registrar to allow further time, provided that such time does not exceed three months, and it also requires that the application for such extension shall be made "within the first period of three months." The provision thus creates a rule for extension of time which is quite distinct from the general power to extend conferred by sec. 105. It allows of extension in a different manner and by other means than those contemplated by sec. 105. In short, sec. 38 provides "otherwise" and does so "expressly" within the meaning of sec. 105.

The mandamus should go.

McTIERNAN J. I agree. Sec. 38 in my opinion exhaustively and specially states the conditions upon which a person may apply for an extension of time within which to lodge a notice of opposition. Because of the express provision thereby made limiting the period in which such application may be made, sec. 105 gives no authority to extend the time after that period has expired.

Rule absolute for mandamus. No order as to costs.

Solicitors for the prosecutor, *Shaw & Turner.*

Solicitor for the Registrar of Trade Marks, *W. H. Sharwood,*
Crown Solicitor for the Commonwealth.

Solicitors for the Royal Sovereign Pencil Co. Ltd., *Bullen & Burt.*

H. D. W.

H. C. OF A.
1936.
THE KING
v.
REGISTRAR
OF TRADE
MARKS;
EX PARTE
J. S.
STAEDTLER.
Evatt J.