

Case commentary: Muir Electrical v Good Guys

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The High Court has overturned the Assistant Commissioner of Trade Marks, holding that it is not possible to grant an extension of time where the time for taking a step has expired.

In *The Muir Electrical Company Pty Limited v The Good Guys Group Limited* (CIV-2009-404-4965, High Court Wellington, 18 December 2009, Lang J) Muir Electrical was the owner of 12 registered trade marks for word and logo versions of THE GOOD GUYS. The Good Guys Group applied to revoke the trade marks on the basis of non-use. Muir Electrical filed its counterstatement and evidence of use in time and The Good Guys Group applied for several extensions of time for filing its evidence. The Good Guys Group then inadvertently missed its deadline. Regulation 98 of the Trade Marks Regulations 2003 provides that an applicant for revocation must either file evidence, notify the Commissioner that it does not intend to file evidence or notify the Commissioner that it withdraws the application or the application is discontinued.

The Commissioner deemed The Good Guys Group's applications for revocation discontinued. The Good Guys Group then applied for and were granted a retrospective

extension of time under regulation 32 which provides that the Commissioner can extend time under the regulations “except where these regulations stipulate that time must not be extended”. Muir Electrical opposed the granting of an extension of time and a hearing was held. The hearings officer allowed the retrospective extension of time. Muir Electrical then appealed to the High Court.

Certain regulations specifically state that the Commissioner cannot extend the deadline after the deadline has passed. Regulation 75 which sets out the circumstances when the Commissioner can extend time for filing a notice of opposition is one such regulation. It provides that the “Commissioner must not extend the deadline after the deadline has passed”. Regulation 98 which sets out the requirements for an applicant filing evidence in a non-use proceeding, contains no such prohibition on extending time after a deadline has passed. Despite this, the High Court ruled that at the expiry of the extension of time, the Good Guys Group’s applications for revocation had been discontinued and it was not possible to “turn back the clock” and grant a retrospective extension of time. Neither The Good Guys Group nor the Commissioner could take any further step to revive the applications.

Even though it was not necessary, because it already ruled there was no jurisdiction to extend time, the High Court went on to consider whether the retrospective extension was justified. Regulation 32 provides that the Commissioner can extend time where there are “genuine and exceptional circumstances”.

Muir Electrical submitted that as The Good Guys Group had not submitted an affidavit

or declaration setting out the genuine and exceptional circumstances, the Commissioner should not rely on “unsworn and unsubstantiated assertions”. The High Court agreed holding that in a contested case, it will generally be necessary for applicant to place assertions of fact before the Commissioner by way of affidavit or declaration. This was not considered fatal because the facts were within the knowledge of The Good Guys Group’s counsel and there was nothing to suggest the information provided by counsel was false or misleading in any way and the circumstances were considered to be genuine. However, in respect of “exceptional”, an oversight by counsel was not considered to be unusual or out of the ordinary. The result of the oversight, namely the discontinuance of the applications for revocation, was not considered to be an exceptional circumstance, but instead one that is provided for by the statute itself.

The decision in *The Muir Electrical Company Pty Limited v The Good Guys Group Limited* demonstrates the harsh consequences that can follow if a deadline is inadvertently missed.

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