Freshfood Holdings Pte Limited v Pablo Enterprise Pte Limited [2021] FCA 323

https://lawcasesummaries.com/knowledge-base/freshfood-holdings-pte-limited-v-pablo-enterprise-pte-limited-2021-fca-323/

Facts

- Freshfood appealed a decision of a delegate of the Registrar of Trade Marks ("**the Decision"**). Notice of the decision was served on Pablo's service address:

Pizzeys Patent and Trade Mark Attorneys Pty Ltd ("**Pizzeys**")

GPO Box 1374

Brisbane, QLD 4001

Phone: (07) 3221 9955

Fax: (07) 3221 8077

Email: jmsimpson@pizzeys.com.au

("**Service Address**")

- The Decision concerned a successful application filed by Pablo Enterprises Pte Ltd ("**Pablo**"), a Singapore-based company, pursuant to s 96 of the *Trade Marks Act 1995* (Cth) to remove the appellant's Australian Registered Trade Mark No. 170010 for the word PABLO filed on 25 October 1961 in class 30: coffee ("the **PABLO Mark"**)
- On 29 January 2021, Freshfoods filed its notice of appeal ("**the Notice**") under r 34.24 of the FCR. Freshfoods served the Notice on Pablo on the Service Address by email on 29 January 2021.
- On 2 February 2021, Pizzey's indicated that they had not received instructions from Pablo to accept service of the notice of appeal.
- Out of an abundance of caution, Freshfood also caused a copy of the Notice to be served on Pablo on 5 February 2021 at its registered corporate address in Singapore, through an authorised Singaporean process server, Mr Abdul Rahman bin Suleiman. This method of service purportedly conformed with Singaporean law.
- Pizzeys informed Freshfoods on 15 March 2021 that they did not have instructions to act and could not accept service.
- On 22 March 2021, Freshfoods realised that no regulations had been enacted implementing s 215(8) of the Act allowing documents to be served on an electronic address. Freshfoods served a further copy of the Notice on Pablo's registered address.

Issues

- Whether service of the notice of appeal of a delegate's decision on an address for service in Australia which has been provided by a party pursuant to s 215 of the Act constitutes effective service

Held

- Freshfoods submitted that an appeal to the Federal Court pursuant to s 104 of the Act (which requires the filing of a notice of appeal under r 34.24 of the FCR) may be described as a document served under the Act and that s 215(6) allowed service on Pablo's Service Address.
- In *Apple Computer Inc v Apple Corporations SA* (1989) 16 IPR 329, Wilcox J held that an application to the Court under s 23 of the Act for non-use of a trade mark may properly be described as a document "*under*" that legislation and sub-reg 74(4) of the Regulations (then in force) operated to allow service at the address shown in the Register.
- Thawley J declined to follow the Court's reasoning in Apple Computer. It is the FCR which provides that the notice of appeal is to be served, not the Act. Further, since Apple Computer was decided, Rule 10.08 of the FCR was introduced concerning service on a registered owner of a trade mark. This does not apply because the appeal was *by* the registered owner of the trade mark.
- Thawley J also made orders confirming service of the Notice on the Singaporean office, despite not applying for leave to do so prior, noting that there was no bilateral treaty between Australia and Singapore in respect of service of foreign proceedings.

Full Text

The full text is available here:

https://www.judgments.fedcourt.gov.au/judgments/Judgments/fca/single/2021/2021fca0323
