

TRADE MARKS ACT 1995

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by Communicare Inc to registration of trade mark application 1021142(35, 36, 41, 43, 44, 45) - **COMMUNICARE** - filed in the name of Communicare Sydney.

DELEGATE:	Iain Thompson
REPRESENTATION:	Opponent: Sophie Goddard, Senior Counsel. Applicant: Doreen Perrin of Lesicar Perrin
DECISION:	S52 opposition – section 44 – s44(3) and 4) considered – prior user of trade mark in relation to all services applied for not established – opposition established – application refused registration. Costs ordered against applicant. 2009 ATMO 19

Background

1. In this matter, Communicare Sydney, (formerly Sydney Rescue Work Society) of Burwood, NSW, ('the applicant') has filed application to register a trade mark, current details of which appear below.

Application No: 1021142
Priority Date: 20 September 2004
Services: **Class: 35** Employment services; personnel recruitment; placement services; arranging and conducting of programs associated with employment, personnel recruitment and personnel placement; business referral services; consulting, information and advisory services associated with the aforementioned services
Class: 36 Financial services; loan services, including arranging and conducting of loan schemes and the provision of loans; bill-paying services; charity services; fund raising services; financial counselling; consulting, information and advisory services associated with the aforementioned services
Class: 41 Education and training services; arranging and conducting of seminars; career counselling services being education/training advice; arranging and conducting of literacy programs; translation and interpretation services; provision of discussion forums; arranging and conducting of parenting education programs; community and migrant settlement services being such services in the area of training and education; anger management services; consulting, information

and advisory services associated with the aforementioned services

Class: 43 Community, family and care services in this class; child care and day care services including vacation child care services; day nursery services; aged care services in the nature of accommodation; accommodation services; community and migrant settlement services being such service in the area of housing; crisis residential services; consulting, information and advisory services associated with the aforementioned services

Class: 44 Counselling services including individual, family counselling; therapeutic and rehabilitation services; aged care services in the nature of medical and nursing services; consulting, information and advisory services associated with the aforementioned services

Class: 45 Personal and social services rendered by others to meet the needs of individuals being community, migrant settlement, family and personal care services, such services including: community development and community building; referral services; personal, family and practical support services; outreach services; arranging and conducting parenting programs; arranging and conducting a family reunification and community reintegration program; aftercare services; consulting, information and advisory services associated with the aforementioned services

Trade Mark: COMMUNICARE
Endorsements: Provisions of subsection 44(4) applied.¹

2. The application was accepted for possible registration and advertised as such in the *Australian Official Journal of Trade Marks* on 13 October 2005.
3. On 11 January 2006 Communicare Inc of Cannington, Western Australia, filed Notice of Opposition to the registration of the trade mark (hereinafter ‘the

1. Subsection 44(4) provides an exception to the provisions of subsections 44(1) or (2):

(4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

(a) beginning before the priority date for the registration of the other trade mark in respect of:

- (i) the similar goods or closely related services; or
- (ii) the similar services or closely related goods; and

(b) ending on the priority date for the registration of the applicant's trade mark; the Registrar may not reject the application because of the existence of the other trade mark.

Note 1: An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

Note 2: For *predecessor in title* see section 6.

Note 3: For *priority date* see section 12.

opposed trade mark'). I will record now that the main thrust of the opponent's opposition is based on the opponent's registration 985319.

Application No: 985319
 Priority Date: 19 January 2004
 Services: **Class: 35** Employment services; personnel recruitment; placement services; arranging and conducting of programs associated with employment, personnel recruitment and personnel placement; business referral services; consulting, information and advisory services associated with the aforementioned services
Class: 36 Financial services; loan services, including arranging and conducting of loan schemes and the provision of loans; bill-paying services; charity services; fund raising services; financial counselling; consulting, information and advisory services associated with the aforementioned services
Class: 41 Education and training services; arranging and conducting of seminars; career counselling services being education/training advice; arranging and conducting of literacy programs; translation and interpretation services; provision of discussion forums; arranging and conducting of parenting education programs; community and migrant settlement services being such services in the area of training and education; anger management services; consulting, information and advisory services associated with the aforementioned services
Class: 43 Community, family and care services in this class; child care and day care services including vacation child care services; day nursery services; aged care services in the nature of accommodation; accommodation services; community and migrant settlement services being such service in the area of housing; crisis residential services; consulting, information and advisory services associated with the aforementioned services
Class: 44 Counselling services including individual, family counselling; therapeutic and rehabilitation services; aged care services in the nature of medical and nursing services; consulting, information and advisory services associated with the aforementioned services
Class: 45 Personal and social services rendered by others to meet the needs of individuals being community, migrant settlement, family and personal care services, such services including: community development and community building; referral services; personal, family and practical support services; outreach services; arranging and conducting parenting programs; arranging and conducting a family reunification and community reintegration program; aftercare services; consulting, information and advisory services associated with the aforementioned services

Trade Mark: COMMUNICARE

4. The alert reader will have already noticed that both the trade marks of the parties and the respective specifications of services are identical.
5. As the opposition must obviously succeed under section 44 of the Act, I will confine my discussion of the evidence and issues to those relevant to that section.
6. As a delegate of the Registrar of Trade Marks I heard the submissions of the parties at a hearing in Canberra on 29 January 2009. Doreen Perrin of Lesicar Perrin represented the applicant via teleconference link. Sophie Goddard, Senior Counsel, represented the opponent.

Discussion of the Evidence

7. The evidence in support of the opposition is contained in statutory declarations by Martine Lynette Pitt and Edwin Raymond Powell.
8. Relevant to the ground under section 44, the evidence in support establishes the existence of the opponent's trade mark registration that I have detailed above and the opponent's reliance on it in these proceedings.
9. The evidence in answer comprises a statutory declaration by John Charles Wilson. I think that it can be fairly said that Mr Wilson's declaration establishes only that the applicant has provided childcare services since 1997 under the sign COMMUNICARE SYDNEY when it was registered as a business name in New South Wales. The circumstances concerning the adoption of the trade mark are not clear but it would seem to be apparent that the applicant was aware of another identical business name registration in the name of a person other than the applicant and believed it had an assent from that person to the use of the business name. It is not clear that that other person was the opponent; and consent to the use of a business name is not, of course, consent to the use of a trade mark.
10. The applicant's claims to provide services other than childcare services do not appear to be well based. I note that Mr Wilson says:

Since 1972 my Organisation has been providing food and drink to children in its care on a daily basis. It has also been providing accommodation during the opening hours of the various child care centres of which it operates. In an attempt to provide professional services based on the needs of the child, my Organisation has been providing trained personnel who can consult, inform and advise the parents of the children in its care.

To assist immigrants from non English speaking countries my Organisation provides translation and interpretation services. My Organisation endeavours to assist immigrants in assimilating into the community by providing educational services and information to assist them in contacting other nationality specific services. Attached herewith and marked Exhibit JW-3 are several copies of the pamphlets relating to my Organisation which have been translated into other languages.

11. I do not believe that these claims establish that the applicant provides translation services or is involved in the service of the provision of food and drink. It is unlikely that the applicant is paid for translating services per se. It is also unlikely that the applicant is paid separately for the provision of food and drink. *Prima facie* the services are an integral part of the childcare services that the applicant performs and are not ones offered separately by the applicant.
12. The sign COMMUNICARE SYDNEY appears prominently on the several annual reports appended to Mr Wilson's declaration. It is not obvious to me that this sign is being used on these publications as a trade mark rather than as a business name in such a way that it meets the definition of 'trade mark' at section 17 of the Act:

What is a trade mark?

17. A *trade mark* is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Note: For *sign* see section 6.

13. For example, the sign below uses the words 'Communicare 123rd Annual Report' thus referring to 'Communicare' as a person, rather than indicating a source of services.

communicare
123rd ANNUAL REPORT 2004/2005

14. In the other sign on the front of the same Annual Report, the reference to a person or organization is more obvious:

communicare
SYDNEY FOUNDED 1882 ABN 11 000 073 870

15. Similar observations apply to brochures appended to the declaration in answer.

Section 44

16. It is agreed by the parties that the trade marks are identical and the services of the parties (as specified) are also exactly the same. The application is not thus registrable in terms of subsection 44(2) unless the provisions of either subsections 44(3) or (4) apply.

17. In *McCormick & Company Inc v McCormick* [2000] FCA 1335, Kenny J said of subsection 44(3) and honest concurrent use:

Section 44(3) gives the Registrar a discretion to accept an application that would otherwise be rejected under s 44(1) in the case of honest concurrent use or other circumstances making it proper to do so. The authorities establish that the principal criteria for determining whether registration should be permitted pursuant to s 44(3) include:

- (1) the honesty of the concurrent use;
- (2) the extent of the use in terms of time, geographic area and volume of sales;
- (3) the degree of confusion likely to ensue between the marks in question;
- (4) whether any instances of confusion have been proved; and
- (5) the relevant inconvenience that would ensue to the parties if registration were to be permitted.

See *In Re Alex Pirie & Sons Ltd's Application* (1932) 49 RPC 195; (1933) 50 RPC 147 at 159-160; *In Re John Fitton & Co Ltd's Application* (1949) 66 RPC 110 at 112; and *Stingray Surf Co Pty Ltd v Lister* (1997) 37 IPR 306 at 310-311. These factors are not necessarily exhaustive of the matters to be considered, but they are a useful guide: see *In Re Electrix Ltd's Application* [1957] RPC 369 at 379.

THE HONESTY OF THE USE

The rights of the parties are to be determined as at the date of the application for registration - in this case, 9 March 1992: *Southern Cross* at 594-95; *In Re Simac S p A Macchine Alimentari's Application* (1987) 10 IPR 81 ("Simac") at 90-91; *Aromas Pty Ltd v Aroma Coffee & Tea Co Pty Ltd* (1997) 40 IPR 75 ("Aromas") at 86; and *Trepper v Miss Selfridge Ltd* (1991) 23 IPR 335 at 346.

The honesty of concurrent use refers to "commercial honesty, which differs not from common honesty": see *In Re Parkington & Co Ltd's Application* (1946) 63 RPC 171 at 182. In that case, Romer J said at 181-182:

[T]he circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user.

18. I consider that the honesty of the use includes the making of the application for registration which is claimed to be predicated upon that use. The claimed specification is a copy of the opponent's specification and has not been amended by the applicant even though it is quite apparent that the bulk of the services are ones which it does not offer and it has no realistic basis for believing that it has done or does so. Any claim that the trade mark has been honestly used upon these other goods is obviously not viable.
19. It thus remains to be considered whether the opponent's argument that the application is incapable of registration under the provisions of subsection 44(4), recited above, is correct.
20. The opponent's argument must, in my consideration, be correct. While the applicant argues that the application should be accepted in respect of services that it might be expected to perform, this is not the function of subsection 44(4). The provision is framed in the way it is so that the actual equities in, and past use of, the applied-for trade mark is reflected in any registration which ensues. Here it appears that if the applied for trade mark has been used continuously prior to the filing date of the opposed application, that use is only in relation to 'childcare services.'
21. I have given a great deal of thought as to whether it is appropriate to allow the application to proceed if the claim is limited to 'childcare services'. However, it is not obvious from the evidence that the applicant has used a trade mark in relation to those services continuously from a date prior to the filing date until the date when the application was filed. The language of subsection 44(4) places the onus on the applicant to satisfy me that the provisions of the subsection ought to be applied and the evidence is not clear that the applicant has so used the applied for trade mark – it appears to have used only a business name or if it has used a trade mark this is not clear within the evidence filed by the applicant. I must also note that I would have grave reservations about so limiting the application when the applicant has apparently mirrored the opponent's complex specification of

services within its application and ought to have restricted its specification voluntarily far earlier in the opposition process – if an applicant adopts an ‘all or nothing’ approach in the face of the explicit language of the Act, it can hardly express surprise at such an outcome.

22. The opponent has established its opposition in terms of section 44 of the Act.

Decision

23. Section 55 of the Act provides:

Decision

55. Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application; having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

24. I refuse to register application 1021142.

25. The opponent is entitled to its costs at the official scale which I award against the applicant.

Iain Thompson
Hearing Officer
Trade Marks Hearings
26 February 2009