

## TRADE MARKS ACT 1995

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

Re: Opposition by Australian Pensioners Insurance Agency Pty Limited to registration of trade mark application 1068440(36) - **APRE AUSTRALIAN PENSIONERS REAL ESTATE GROUP with slogan and device** - filed in the name of Annette Brennan and Bruce Woodberry.

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<b>DELEGATE:</b>	<b>Don Nancarrow</b>
<b>REPRESENTATION:</b>	<b>Opponent: Helen Kearney of Middletons Lawyers, Melbourne Applicant: Bruce Woodberry</b>
<b>DECISION:</b>	<b>2007 ATMO XX s 52 opposition: s 44, s 60 – respective trade marks of parties not deceptively similar; s 42(b) – use of trade mark not contrary to law; application to proceed; costs awarded against opponent.</b>

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#### Background

Application number 1068440, a representation of which is depicted below, was filed on 5 August 2005 in the names of Annette Brennan and Bruce Woodberry ('the applicants').



Other details of the application are:

Goods/services: **Class 36:** Real estate affairs for pensioners

Acceptance advertised: 8 December 2005

Registration was opposed by Australian Pensioners Insurance Agency Pty Limited ('the opponent') by means of a Notice of Opposition filed on 8 March 2006. The notice listed grounds under eight sections of the *Trade Marks Act 1995* ('the Act'). Thereafter both parties filed and served their evidence and the matter came before me, as a delegate of the Registrar, at a hearing in Melbourne on 5 March 2007. The applicants were self-represented with submissions from Mr. Bruce Woodberry whilst the opponent was represented by Ms. Helen Kearney of Middletons Lawyers of Melbourne.

## The Evidence

The evidence filed and served in accord with the Act and the Regulations thereto is set out in the table below.

<b>Declarant</b>	<b>Status</b>	<b>Date Declared, Known As</b>	<b>Exhibits</b>
Evidence in Support			
Stephen Harvey Mildred	General Manager of opponent	5 June 2006 – Mildred 1	‘SMH-1’ to ‘SMH- 18’
Evidence in Answer			
Bruce Woodberry	Co-applicant	15 August 2006 – Woodberry	‘BAW-1’ to ‘BAW-11’
Evidence in Reply			
Stephen Harvey Mildred	General Manager of opponent	15 November 2006 – Mildred 2	‘SMH-19’

The evidence in support goes to show that the opponent company was founded in 1986 and provides insurance services to a target market of Australian pensioners. Initially the opponent only accepted the over-55 age group as being eligible for their services but from May 2006 this has been revised to the over-50 age group.

Mildred 1 also provides detail of the opponent’s use of its trade marks in advertising – in the print media and by means of stickers, catalogues and brochures, as well as on their own stationery. Exhibits ‘SHM-7’ to ‘SHM-15’ inclusive demonstrate advertising of the opponent’s services via the internet and on television and radio, in magazines and journals, trade shows, the Yellow Pages telephone directory and by means of sponsorship arrangements, particularly of Seniors Week nation wide.

The opponent has also documented 14 cases where persons in contact with their office have claimed that they have suffered some level of confusion concerning whether the opponent was associated with the applicants (‘SHM-16’).

The Woodberry declaration gives a history of the company through which the real estate business is operated. The two trade mark applicants here, Annette Brennan and Bruce Woodberry are co-directors of that company. The applicants claim to have

commenced use of the trade mark applied for on 1 November 2004. The first documented use shown in the evidence is 7 July 2005 ('BAW-7a').

The single exhibit ('SHM-19') to Mildred 2 is a printout from the LJ Hooker Real Estate Group website. The page promotes insurance services available through Suncorp and GIO for the benefit of those who have used Hooker's real estate services.

### **Grounds of Opposition**

The Notice of Opposition nominated grounds under eight sections of the Act but at the hearing the opponent chose to rely on only those under sections 42(b), 44 and 60. For completeness I formally find that the grounds nominated under the other five sections of the Act have not been established.

### **Submissions, the Law and Comments**

#### ***(a) Section 44***

The relevant legislation allows:

#### **Identical etc. trade marks**

##### **44.(1) ....**

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar services* see subsection 14(2).

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

Sub-sections (3) and (4) of section 44 have no application here and so I am only required to consider sub-section (2). In order to establish opposition under this ground the opponent has the burden of providing the following:

- a trade mark, either registered or pending registration, in the name of a person other than the applicant, and in relation to which the applied-for trade mark is either substantially identical or deceptively similar;

- the trade mark in the name of the other person must be in respect of similar services or closely related goods; and
- the priority date of the trade mark of the other person be the earlier.

The expression ‘deceptively similar’, in the first of these tests, is defined within section 10 of the Act, which provides:

**Definition of *deceptively similar***

**10.** For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

The expression, ‘similar services’, in the second of the tests above, is defined within sub-section 14(2) of the Act, which provides:

**Definition of *similar goods and similar services***

14. (2) For the purposes of this Act, services are *similar* to other services:

- (a) if they are the same as the other services; or
- (b) if they are of the same description as that of the other services.


I also note the comments of French J (with agreement from Tamberlin J) in *Registrar of Trade Marks v Woolworths Limited*, 45 IPR 411, at paragraph 39:

The logic of s 44(2) suggests that the determination whether goods are closely related to the services in question is logically antecedent to the determination whether the trade mark in respect of the services is deceptively similar to that in respect of the goods.

Thus, I am to consider the issue of the similarity of the respective services before I consider the similarity of the respective trade marks.


Ms. Kearney provided a listing of five registered trade marks owned by the opponent’s parent company, Australian Alliance Insurance Company Limited, that she claimed conflicted with the present application in the way that s. 44(2) sets out.

These registrations are detailed below.

Number	Trade Mark	Priority date	Goods/services
448760		18 July 1986	Domestic building, contents and valuables insurance (class 36)
628913	A.P.I.A.	4 May 1994	Insurance services in this class including car insurance, caravan insurance, travel insurance, domestic building, contents and valuables insurance, boat insurance and life

			insurance (class 36)
720013	 Beyond 50	21 October 1996	Insurance services including car insurance, caravan insurance, travel insurance, domestic building insurance, building contents and valuables insurance, boat insurance and life insurance (class 36) Educational and entertainment services relating to insurance, financial and life-style matters including health and diet, television and radio entertainment, information services in this class, television programmes, radio programmes; publication of magazines and books; organisation and running of educational seminars and exhibits (class 41)
799712	 Australian Pensioners Insurance Agency	8 July 1999	Insurance services including the provision of domestic building, contents, valuables, motor vehicle, boat, caravan, travel, medical, life and pet insurance; financial services including provision of cash management accounts, credit cards, debit cards, pension products, life assurance products; financial advice (class 36)
853380	AUSTRALIAN PENSIONERS INSURANCE AGENCY	12 October 2000	Insurance services being provision of domestic building, contents, valuables, motor vehicle, boat, caravan, and travel insurance (class 36)

For purposes of comparison, the corresponding details of the present application are as follows:

Number	Trade Mark	Priority date	Goods/services
1068440		5 August 2005	Real estate affairs for pensioners (class 36)

Mr. Woodberry provided submissions concerning both infringement (section 120 to section 130 of the Act inclusive) and the tort of passing off. Those issues are not

directly part of this opposition proceeding although he did comment on the issues of deceptive similarity and substantial identity of competing trade marks and, where relevant, I have considered those comments.

It is clear that all five trade marks that the opponent drew to my attention have priority dates earlier than 5 August 2005 – thus, the third of the three factors under sub-section 44(2) favours the opponent for each of the five trade marks.

In relation to the second of the factors, concerning the degree of similarity of the services, the applicant provides real estate services whilst the opponent offers all kinds of insurance services and, in relation only to 720013, various educational and entertainment services.

The initial principles for comparison of similarity of services were in train before it was possible to register a trade mark for services in Australia. Such legal precedent as *Jellinek's Application* (1946) 63 RPC 59; *John Crowther & Sons (Milnsbridge) Limited's Application* (1948) 65 RPC 369; *Reckitt & Colman (Australia) Limited v Boden* (1945) 70 CLR 84 and *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Limited* (1954) 91 CLR 592; 1A IPR 465 applied for a comparison of goods. These authorities established that there are three principal factors to be considered when comparing goods of respective parties to determine if they are of 'the same description' or 'similar'. They are: (1) the nature of the goods, including their origin and characteristics; (2) the uses made of them, including their purpose; and (3) the trade channels through which the goods are bought and sold.

Service trade marks were introduced in Australia in the late 1970's and the Act provides the definition at sub-section 14(2), as quoted above, as a starting point to decide whether two sets of services are 'similar'. In this case, because the respective services of the parties are not the 'same' (paragraph 14(2)(a)), the definition of 'similar' reduces to 'of the same description' (paragraph 14(2)(b)).

The factors developed in precedent cases for a comparison of goods v. goods have been imported for a comparison of services v. services in the Full Federal Court case *MID Sydney Pty Limited v Australian Tourism Co Limited*, (1998) 42 IPR 561, with comments from Burchett, Sackville and Lehane JJ at 567-568:

Are, then, services to be provided by Touraust services of the same description as that of services in respect of which MID's mark is registered: s 120(2)(c)? That expression in the context of services seems to have received no reported

judicial consideration. This is partly because the statutory protection for trade marks used in relation to goods has been extended to trade marks in relation to services only relatively recently: see F J Smith, “The Trade Marks Amendment Act 1978” (1979) 52 ALJ 118.

....

The question whether two sets of goods are “of the same description” has, however, been considered in a number of decisions.

....

We accept that these principles, subject to any necessary modification, apply in relation to services.

The natures of the respective services here, for both ‘real estate’ v. ‘insurance’ and ‘real estate’ v. ‘education and entertainment’, are markedly different. The uses of the respective services, their purpose and usual characteristics of delivery also differ on many fronts.

Ms. Kearney submitted that a commonality existed in relation to ‘real estate’ services v. ‘insurance’ services in the present matter because both were involved in the major assets and financial well being of the target market of pensioners.

The only point of convergence of the respective services that is apparent to me, is that both services may be used concurrently when a property is purchased – that is, the real estate is obtained and quite often one of the first activities of a new owner is to insure the new asset, or where the purchaser enters into a mortgage arrangement with a financial institution it is likely that insuring the asset is compulsory. The opponent sought to highlight this link by means of exhibit ‘SHM-19’ to Mildred 2. This exhibit is a copy of a web-page from the real estate company L. J. Hooker who, via this page, provide information on Home and Contents Insurance. I note that the insurance being offered is not provided by L. J. Hooker but by two other entities – the Suncorp and GIO insurance companies. This material does not go to show an example of a single business offering both ‘real estate’ and ‘insurance’ services under a common trade mark, but merely an endorsement or recommendation for apparently independent insurance services that a customer of Hooker’s real estate services may wish to pursue.

The fact that the two services may be required in such close proximity in time does little to convince me that the ‘nature’ or ‘purpose’ or ‘uses’ or ‘characteristics’ of the respective services are at all similar.

Mr. Woodberry had submitted that the respective services of the two parties are significantly different and I have reached the same conclusion that ‘real estate’ services and ‘insurance’ services are not services ‘of the same description’.

I draw the same conclusion for ‘real estate’ services v. ‘education and entertainment’ services (class 41 for 720013). There is nothing before me that would direct me to conclude that the ‘nature’, ‘purpose’, ‘uses’ or ‘characteristics’ of the respective services are in any way similar.

From the foregoing, I find that the ground of opposition under section 44 has not been established because the respective services are not ‘similar’ as required in terms of sub-paragraph 44(2)(a)(i).

**(b) Section 60**

The legislation for this ground of opposition allows:

**Trade mark similar to trade mark that has acquired a reputation in Australia**

**60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

In terms of this ground of opposition it is for the opponent to point to a trade mark, whether registered or in common law use, which is:

- either substantially identical with, or deceptively similar to, the trade mark in the application
- which, before the priority date, has acquired a reputation in Australia such that
- use of the applicant’s trade mark would lead to deception or confusion.

One important feature of the requirements for section 60 is that, unlike section 44, the respective goods and/or services need bear no relationship. Obviously, however, the closer the relationship between the respective goods or services of the parties then the less will be the need for strength of reputation in order to bring about the same likelihood of deception or confusion. The opponent submitted that the five trade

marks listed under the section 44 ground, above, provided such a barrier under section 60.

Ms. Kearney conceded that the applicants' trade mark could not be considered to be 'substantially identical' with any of the five, but argued that it was 'deceptively similar' to each of them.

The accepted test for deceptively similar trade marks is found in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd*, (1961) 109 CLR 407 at 415 where Windeyer J discusses the concept, in the words:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions.

I note also that Justice French commented, in dealing with a comparison of marks under section 44, in *Registrar of Trade Marks v Woolworths Limited*, 45 IPR 411 at [50]:

In *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-5, which concerned the 1905 Act, Kitto J set out a number of propositions which have frequently been quoted and applied to the 1955 Act. The essential elements of those propositions continue to apply to the issue of deceptive similarity under the 1995 Act. Applied also to service marks and absent the imposition of an onus upon the applicant they may be restated as follows:

(i) To show that a trade mark is deceptively similar to another it is necessary to show a real tangible danger of deception or confusion occurring. A mere possibility is not sufficient.

(ii) A trade mark is likely to cause confusion if the result of its use will be that a number of persons are caused to wonder whether it might not be the case that the two products or closely related products and services come from the same source. It is enough if the ordinary person entertains a reasonable doubt.

It may be interpolated that this is another way of expressing the proposition that the trade mark is likely to cause confusion if there is a real likelihood that some people will wonder or be left in doubt about whether the two sets of products or the products and services in question come from the same source.

(iii) In considering whether there is a likelihood of deception or confusion all surrounding circumstances have to be taken into consideration. These include the circumstances in which the marks will be used, the circumstances in which

the goods or services will be bought and sold and the character of the probable acquirers of the goods and services.

(iv) The rights of the parties are to be determined as at the date of the application.

(v) The question of deceptive similarity must be considered in respect of all goods or services coming within the specification in the application and in respect of which registration is desired, not only in respect of those goods or services on which it is proposed to immediately use the mark. The question is not limited to whether a particular use will give rise to deception or confusion. It must be based upon what the applicant can do if registration is obtained.

In relation to deceptive similarity of trade marks Ms. Kearney cited the comments of Sir Wilfred Greene MR in *Saville Perfumery Limited v June Perfect Limited and F. W. Woolworth & Co Limited*, 58 RPC 147 at 162; 1B IPR 440 at 453:

In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark. I do not pause to examine these appellations, since the idea conveyed is free from ambiguity. In deciding whether or not a feature is of this class, not only ocular examination, but evidence of what happens in practice in the particular trade is admissible. In the present case the evidence leaves me in no doubt as to the word "June" being the distinguishing or essential feature of the appellant's mark. It is by this word that traders and members of the public who see the mark on the goods which they purchase describe the appellant's goods, and indeed I should have been surprised if it had been otherwise.

Ms. Kearney argued that the opponent's five trade marks had such a 'distinguishing feature' because they had come to be known, through use, as the AUSTRALIAN PENSIONER trade marks and that these words, because they were also present in the trade mark applied for, were likely to result in deception or confusion especially where the trade marks were described orally and heard aurally. In addition, she submitted that many cases of actual confusion had occurred and were documented in 'SHM-16' to Mildred 1.

Two of the opponent's trade marks (628913 and 720013) either consist of, or contain, the letters A. P. I. A. without any reference to the words AUSTRALIAN PENSIONERS. These letters, when considered by means of their sight or sound, are simply too different from the letters APRE in the present trade mark to bring about any sort of deception or confusion and I discount 628913 and 720013 from further consideration.

The other three trade marks that Ms. Kearney brought to my attention (448760, 799712 and 853380) all contain or comprise the words AUSTRALIAN PENSIONERS INSURANCE AGENCY.

The earliest registration of any of the trade marks that the opponent relies upon is 18 July 1986. This registration, for trade mark number 448760, occurred under the *Trade Marks Act 1955* and an endorsement was required (and agreed by the present opponent). The current endorsement reads:

**“Registration of this trade mark shall give no right to the exclusive use of the device of a MAP OF AUSTRALIA and the words AUSTRALIAN PENSIONERS INSURANCE AGENCY\*”**

**Provisions of section 26(2) applied\***

**The preceding endorsement(s) were recorded prior to commencement of the Trade Marks Act 1995.\*”**

Rights in the individual elements here, the device of the MAP OF AUSTRALIA and the words AUSTRALIAN PENSIONERS INSURANCE AGENCY were disclaimed in order to gain registration of the trade mark as a whole. The application gained registration – the lack of distinctiveness being overcome on the basis of evidence of use – in the trade mark as a whole, and thus it is difficult to now claim rights in elements that were considered to be so descriptive as to require the disclaimer in order to proceed to registration initially.

The disclaimer severely weakens the opponent’s claim under section 60 – although not necessarily fatally. I note that Romer J commented in *Payton & Co Limited v Snelling, Lampard & Co Limited* (1900) 17 RPC 48, at 56, that:

[W]hen one person has used certain leading features, though common to the trade, if another person is going to put goods on the market, having the same leading features, he should take extra care by the distinguishing features he is going to put on his goods, to see that the goods can be really distinguished, ....

There are two factors here that need some comment. The ‘certain leading features’ relied on by the opponent here are the words AUSTRALIAN PENSIONERS (although two of the three trade marks also contain the letters APIA or A.P.I.A. and a map of Australia). However, these words cannot be considered to be ‘common to the trade’ in the present case because the respective services of the parties are not, in fact, the ‘same trade’. The words AUSTRALIAN PENSIONERS in the respective trade marks, highlight a commonality brought about because the parties have a common target consumer rather than by any sort of the offering of a similarity in services.

Secondly, if, as the opponent claims, the words AUSTRALIAN PENSIONERS have, through use, come to be the words by which the opponent's three trade marks are known – then sufficient evidence of that state of affairs would need to be before me to negate the effect of the opponent having disclaimed its rights in the words AUSTRALIAN PENSIONERS INSURANCE AGENCY.

The only material that the opponent brought to my attention concerns the number of persons who have suffered confusion between the applicant's and opponent's trade marks. Ms. Kearney submitted that the confusion had occurred because of the use of the identical words AUSTRALIAN PENSIONERS in the respective trade marks followed by a description of the services, either INSURANCE AGENCY or REAL ESTATE GROUP as the case may be. In Mildred 1 the opponent submitted three digital versatile discs (exhibit 'SHM-8'), a compact disc (exhibit 'SHM-9') and many copies of the opponent's *Beyond 50* magazines (exhibit 'SHM-10') along with a variety of pages from telephone directories and sponsored functions, all designed to demonstrate the opponent's advertising. These items consistently show that the opponent uses the letters APIA, the words AUSTRALIAN PENSIONERS INSURANCE AGENCY and at times, in the spoken medium, the words AUSTRALIAN PENSIONERS INSURANCE. Nowhere in the advertising did I find a reference to simply AUSTRALIAN PENSIONERS and I do not accept that this is how the opponent's trade marks are generally referenced by consumers.

Given my previous comments about possible means of negating the effect of the disclaimer (and the level of descriptiveness in the words themselves), I do not accept that the evidence is strong enough to support the opponent's submission.

Concerning the cases of confusion that the opponent quoted, the evidence lists 14 events ('SHM-16' to Mildred 1). I have some difficulty interpreting exactly what this exhibit actually shows. Three of the informants claimed to have seen the applicant's advertising on television. The applicant's evidence shows that advertising was via radio on station 5AA in Adelaide and this has not been disputed by the opponent. Such a circumstance brings into question the value of this evidence and also brings into question the methodology of the evidence collection. Was all of the information, obtained from persons who were said to be confused, given freely – without any prompting? In such circumstances, is it realistic to expect that three people out of a sample of 14 would volunteer information that was so obviously incorrect? If the

opponent obtained the material by asking questions about the applicants' advertising then it begs the question – were the informants led in some way? The tenor of the opponent's evidence is that the informants all volunteered the information, but given that three did not accurately remember the advertising medium I find that I am left in some doubt about the weight that can be given it.

I find it difficult to accept that any sort of confusion is directly attributable to a visual or aural mistaken belief that A.P.I.A. or AUSTRALIAN PENSIONERS INSURANCE AGENCY or AUSTRALIAN PENSIONERS INSURANCE could be misread or misheard for either APRE or AUSTRALIAN PENSIONERS REAL ESTATE GROUP. Rather, it seems that logic, and the comments of the informants (though I do not give their comments great weight) guide me to the conclusion that any mistaken belief lies in contextual similarity. That is, that although consumers realise that the respective trade marks are not the same, there may be a degree of confusion in wondering whether the trade marks are linked in some way to a common source<sup>1</sup>.

Though I accept that some level of contextual confusion is possible, I put this down to the lack of strength in the trade marks themselves. There is an inherent risk in joining together a group of elements in a trade mark which are, individually, lacking in distinctiveness. The fact that the words AUSTRALIAN PENSIONERS INSURANCE AGENCY needed to be disclaimed (and evidence of use was required) before the opponent's first trade mark was registered points to the lack of distinctiveness of the words – and associated with this reality is that others may also need such words in the normal course of their business.

Both parties have, as a target market, pensioners who live in Australia. Both parties have some right to use the description (which lacks distinctiveness) and a map of Australia (which lacks distinctiveness) as part of their respective composite trade marks. The rights gained by registration of a trade mark, made up of such elements, subsist in the trade mark as a whole. The opponent here has shown that it has accepted that risk by its agreement to the disclaimer.

Although there may be some level of contextual confusion due to the descriptive elements in both trade marks I do not believe that the level of deception or confusion

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<sup>1</sup>*John Fitton & Co. Ltd's Application*, 66 RPC 110, at 113

is unacceptable, especially given that the respective trade marks are used in quite different commercial enterprises.

I find that the applicants' trade mark is neither substantially identical with, nor deceptively similar to, any of the five trade marks of the opponent. I also add in passing that had I found the applicants' trade mark deceptively similar to the three trade marks that contained the phrase AUSTRALIAN PENSIONERS INSURANCE AGENCY another difficulty would have arisen. This is because the opponent's evidence did not adequately differentiate between the reputation that had been acquired by those that contained the phrase and those that contained merely the letters A.P.I.A. and not the phrase. As the matter stands I have no need to consider reputation because I have already found that the applicants' trade mark is not deceptively similar to any of the opponent's five trade marks.

From the foregoing I find that the ground of opposition under section 60 has not been established.

**(c) Section 42(b)**

Here the legislation allows:

**Trade mark scandalous or its use contrary to law**

**42.** An application for the registration of a trade mark must be rejected if:

- (a) ...
- (b) its use would be contrary to law.

Under this ground of opposition Ms. Kearney submitted that use of the present trade mark would be contrary to law because it would breach the *Trade Practices Act 1974* (TPA). This claim was made on the basis that use of the trade mark would amount to misleading or deceptive conduct under section 52 of the TPA because consumers would be misled into believing that the applicants enjoyed some form of association with the opponent.

I note that Hearing Officer Jock McDonough comments in *Pierre Fabre Dermo-Cosmetique v Senator Automation Pty Limited*, [2006] ATMO 66, at [30]:

Therefore, neither the section 44 nor the section 60 grounds can be made out. Furthermore, the test for deceptive similarity under the Act involves consideration of a lower threshold than the deception or misrepresentation to be found in passing-off or contravention of the *Trade Practices Act 1974*. Therefore, the section 42(b) ground cannot be made out either.

The same circumstances exist here. Thus, the ground of opposition taken under section 42(b) has not been established.

**Decision**

From the foregoing, no ground of opposition has been established. My decision, in terms of section 55 of the Act, is that this trade mark application, numbered 1068440, for the composite trade mark APRE AUSTRALIAN PENSIONERS REAL ESTATE GROUP with slogan and device, may proceed to registration (provided that the sealing fee has been paid) one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been discontinued, or in the event of a decision from the Court, that the application be subject to that order.

**Costs**

Both parties requested their costs in the matter. I see no reason why costs should not follow the general rule. I award costs against the opponent and direct that the opponent pay the costs of the applicant in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations 1995*).

Don Nancarrow  
Hearing Officer  
Trade Marks Hearings  
11 May 2007