

## TRADE MARKS ACT 1995

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

Re: Opposition by Schott Aktiengesellschaft to registration of trade mark application 1114102(11) - **SINGLE SHOT** - filed in the name of Ian Sumner.

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<b>DELEGATE:</b>	<b>Frances Aarnio</b>
<b>REPRESENTATION:</b>	<b>Opponent: Michelle Howe of Davies Collison Cave, Sydney</b> <b>Applicant: Not represented</b>
<b>DECISION:</b>	<b>2009 ATMO 6</b> <b>1. s 52 opposition: s 44, s 60 pressed but not established - marks not</b> <b>deceptively similar.</b> <b>2. Costs awarded against opponent.</b>

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### **Background**

1. On 17 May 2006 Ian Sumner ('the applicant') applied for registration of the trade mark SINGLE SHOT ('the opposed application') for *Solar collectors (heating)* in class 11. The application was examined, and on 14 September 2006 advertised as accepted in the *Official Journal of Trade Marks*.
2. Schott Aktiengesellschaft ('the opponent') filed a notice of opposition on 14 December 2006, listing all the allowable grounds of opposition under the *Trade Marks Act 1995* ('the Act').
3. The matter came before me as a delegate of the Registrar of Trade Marks in Sydney on 14 October 2008. Michelle Howe of Davies Collison Cave represented the opponent. The applicant did not appear at the hearing, nor did it file any written submissions.
4. The applicable law is that which existed as at the filing date of the application, 17 May 2006.
5. The opponent has the onus of establishing a ground of opposition on the balance of probabilities.<sup>1</sup>

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<sup>1</sup>*Pfizer Products Inc v Karam* [2006] FCA 1663.

6. At the hearing, the opponent pursued grounds under s 44 and s 60 only. For completeness, I record that the opponent has not established the remaining grounds listed on the Notice of Opposition.

### **Evidence**

7. The opponent's evidence in support of the opposition comprised:
  - Statutory declaration of Katherine Louise Kemp dated 12 February 2008, with Exhibit KLK-1. Ms Kemp is a trade mark searcher of over 22 years experience and currently employed by Davies Collison Cave, Patent and Trade Marks Attorneys. Her declaration gives details of a search she conducted of the Australian Trade Marks Office database for trade marks in class 11 containing the word SHOT, or its phonetic equivalent. Of the marks her search revealed, only the applicant's mark and trade marks owned by the opponent covered *Solar collectors (heating)* or similar goods.
  - Statutory declaration of Wolfgang R Wentzel dated 20 February 2008 with Exhibits WW1-WW6. Since 1991 Mr Wentzel has been Head of the Trade Mark Department of the opponent. He provides background information relating to the opponent's production and development of photovoltaic components since 1958. With the commencement of the opponent's solar division, Schott Solar, in 2005, the opponent's Australian subsidiary, Schott Australia, became active in promoting and distributing solar products. Promotion has taken place by a variety of media, including trade journals, environmental publications, the opponent's own website and its business newsletter. Mr Wenzel provides figures relating to the Australian promotion of Schott Solar products for 2005-2006, sales figures for Schott products in Australia (including solar products) for 2005-2007, and details of market share in 2006-2007.

### **Submissions and reasons**

#### ***Section 44***

8. Section 44(1) of the Act reads:

### Identical etc. trade marks

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

(a) the applicant's trade mark is substantially identical with, or deceptively similar to:

(i) a trade mark registered by another person in respect of similar goods or closely related services; or

(ii) a trade mark whose registration in respect of similar goods or closely related services 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 goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

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

Note 2: For *similar goods* see subsection 14(1).

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

9. To be successful under this ground the opponent must establish a registered or pending trade mark which (i) has an earlier priority date than the priority date of the opposed trade mark application, (ii) is substantially identical with or deceptively similar to the opposed mark, and (iii) is for the same or similar goods or closely related services.
10. The opponent relies on the following registered trade marks:

Trade mark	Classes	Priority date
822611 SCHOTT TERMOFROST <sup>2</sup>	11, 20	7 February 2000
1027252 SCHOTT  1027253 <b>SCHOTT</b>	1, 2, 3, 5, 7, 9, 10, 11, 12, 16, 17, 19, 20, 32, 37, 40, 42	21 November 2003
1078816 SCHOTT PTR	9,11,21	11 January 2005

*Priority date*

11. All of the opponent's marks have priority dates before that of the opposed application.

<sup>2</sup> In its submissions the opponent referred to this trade mark as SCHOTT THERMOFROST. A review of IP Australia records shows the mark as filed and registered is SCHOTT TERMOFROST.

*Similar goods*

12. The opponent submitted that goods covered by the opposed application, *Solar collectors (heating)* in class 11, were similar to the following goods covered by the opponent's registrations:

822611	Class 11: Apparatus for . . . heating
1027252 1027253	Class 9: Apparatus and instruments for conducting, switching transforming, accumulating, regulating and controlling electricity and their components, photovoltaic installations and devices for the transformation of solar energy into electricity and their parts and fittings, photovoltaic elements, namely modules, batteries and converters; photovoltaic monitoring systems; solar collectors for current production and their components, included in this class  Class 11: Solar collectors for heat generating, included in this class their parts and fittings, included in this class; solar technical components parts made of glass, namely solar collector modules
1078816	Class 9: Absorber tubing for parabolic trough collectors for solar thermal applications included in this class  Class 11: Absorber tubing for parabolic trough collectors for solar thermal applications included in this class

13. Romer J in *Jellinek's Application*<sup>3</sup> observed that the question of similar goods requires a consideration of the nature, use and trade channels of the respective sets of goods. In *John Crowther & Sons (Milnsbridge) Ltd*,<sup>4</sup> the Assistant-Comptroller elaborated on those observations. At 372 he said:

In arriving at a decision upon this issue the reported cases show that I have to take account of a number of factors, including in particular the nature and characteristics of the goods, their origin, their purpose, whether they are usually produced by one and the same manufacturer or distributed by the same wholesale houses, whether they are sold in the same shops over the same counters during the same seasons and to the same class or classes of customers, and whether by those engaged in their manufacture and distribution they are regarded as belonging to the same trade. In the case of *Jellinek's Application* (1946) 63 RPC 59 Romer J classified these various factors under three heads, viz, the nature of the goods, the uses thereof, and the trade channels through which they are bought and sold. No single consideration is conclusive in itself.

14. Applying these established criteria, I think there is no doubt that the applicant's goods are the same or similar to the opponent's goods set out at paragraph 12 above. They

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<sup>3</sup> (1946) 63 RPC 59.

<sup>4</sup>(1948) 65 RPC 369.

have the same characteristics and trade channels. Those engaged in their manufacture would be likely to regard them as belonging to the same trade.

*Comparison of marks*

15. The opponent did not contend that the competing trade marks were substantially identical but submitted that they were deceptively similar.
16. In terms of s 10 of the 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.
17. The tests for deceptive similarity are well known. They rely on a comparison of the net impression created by each of the competing marks<sup>5</sup>. In *Australian Woollen Mills*<sup>6</sup> at 658 Dixon and McTiernan JJ stated:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard.

18. Taking into account the change in onus under the 1995 Act, French J in *Registrar of Trade Marks v Woolworths*<sup>7</sup> recast the established criteria. At 428 he said:

In *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 94-5, 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:

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<sup>5</sup> *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407; *Australian Woollen Mills v FS Walton & Co Ltd* (1937) 58 CLR 641 ('*Australian Woollen Mills*').

<sup>6</sup> (1937) 58 CLR 641.

<sup>7</sup> (1999) 45 IPR 411.

(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 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.

19. The opponent submitted that confusion would be likely because of the impressions created by the marks, particularly in the context of the ordinary manner of purchase of the goods. A consumer would usually make a decision to purchase because of knowledge gained by word of mouth, or after discussions with a technician who would purchase the goods on behalf of the consumer. In such circumstances, the aural impressions created by the marks would be very important.
20. Expanding this argument, the opponent contended that SHOT was likely to be seen as the memorable and distinctive element of the applicant's mark, because the word has no meaning in relation to the designated goods and is not in common use as a trade mark in the relevant field<sup>8</sup>. For similar reasons, SCHOTT is likely to be the memorable element of the opponent's marks. Given the phonetic similarity of SHOT and SCHOTT, the marks are likely to create the same impressions.
21. Confusion was still likely, the opponent said, even if consumers recalled the applicant's mark as SINGLE SHOT. The opponent has established a series of

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<sup>8</sup> Statutory declaration of Ms Kemp dated 12 February 2008.

SCHOTT marks for solar products. Consumers would think SINGLE SHOT indicated a “single” version of a SCHOTT product.

22. I agree the words SCHOTT and SHOT are aurally similar. While some consumers in Australia may pronounce the word SCHOTT with a hard “c” as in “school”, I think the most common pronunciation would be with a soft “c” and the result would be equivalent to the word SHOT. However, I do not agree such aural similarity gives rise to deceptive similarity of the competing marks or that confusion is likely in the marketplace. Firstly, the effect of the trade marks as wholes must be judged<sup>9</sup>. Secondly, the purchase or installation of solar collectors is not a decision the ordinary customer would make in haste or without paying some attention to the product.

*Effect of the trade marks as wholes*

The opponent’s marks

23. The opponent’s trade marks 1027253 and 1027253 consist of the word SCHOTT in plain font, and in a slightly stylized form. SCHOTT is a surname<sup>10</sup>, presumably of Germanic origin. As far as I am aware, it has no meaning in relation to solar goods and the impression that it is likely to conjure in the minds of the ordinary customer is that of a person or business entity named SCHOTT. The marks create that impression, both in plain font and in the stylized form.
24. Trade mark 1078816 creates the same impression. In this mark, SCHOTT appears with the letters PTR, both in plain font. When the mark is considered as a whole, SCHOTT is the memorable and distinctive feature. The letters PTR act as a descriptive term (an acronym for parabolic trough receiver) or simply as an indicator of product model.
25. Trade mark 822611 is somewhat different. It consists of the two words SCHOTT TERMOFROST in plain font. Both words are equally strong in the mark. They are each distinctive of the goods and the expression does not have a meaning as a whole. I think either word could fix itself in the minds of consumers. Consumers who were aware of other SCHOTT marks, may recall the mark as a “Schott” mark. However, as

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<sup>9</sup> *Clark v Sharp* [1898] 15 RPC 141, 146 (Byrne J); *Melbourne Chinese Press Pty Ltd v Australian Chinese Newspapers Pty Ltd* 9204) 63 IPR 38, 42 (Wilcox, Kiefel and Bennett JJ).

<sup>10</sup> SCHOTT occurs 140 times in Australian Trade Marks Office Search for an Australian Surname.

TERMOFROST is an invented word and is equally strong in the mark, many consumers would recall the mark by that term.

The applicant's mark

26. The applicant's mark, SINGLE SHOT, creates a very different impression to any of the opponent's marks. SINGLE SHOT is an expression consisting of two common and well-understood English words. As it has an obvious corporate identity, I think it unlikely that consumers will recall only the SHOT element of the expression. Rather, they are likely to recall the whole expression and its meaning, ie one shot or single operation, and regard it as an oblique reference to a functional aspect of the applicant's goods.

*Manner of purchase*

27. There is a heightened awareness in the general community of the challenges of climate change. Information on the different types of renewable energy products is readily available via the internet, consumer organizations, government entities, print media, and housing and environment trade shows. Solar products often feature in popular lifestyle and gardening television programs and they are promoted via all the usual media. To encourage use of renewable energy resources, Governments at the federal, state and local level are providing financial incentives such as "green" loans for energy efficient homes and rebates on the purchase of renewable energy products.
28. With such a wealth of information available, I think it unlikely that the ordinary customer for solar collectors would purchase such goods or enter into an installation agreement in an uninformed manner or relying solely on word of mouth. Whether they decided to purchase and install the collectors themselves or engage the services of a technician, they are likely to pay some attention to the system suitable for their location and dwelling, the different products available, how those products work, their cost, any benefits and savings they would achieve, and any financial assistance to which they may be entitled.
29. I do not consider there is a real likelihood of confusion arising even if a customer paid no attention whatsoever to the product and placed the purchase decision entirely in the hands of a supplier or installation technician. Suppliers and installers of solar

products would be familiar with the different products available. They would recall SINGLE SHOT by its ordinary English meaning, and understand the term as an oblique reference to functionality. In such circumstances, they are not likely to confuse the applicant's mark with either SCHOTT or TERMOFROST, or give the impression to their customers that the competing marks denote related products.

30. The opponent also drew my attention to confusion that might arise if the applicant used its mark with SINGLE obscured and SHOT highlighted, for example, on solar collectors installed at an angle on a rooftop. There is a very small possibility of confusion arising in this way if a person had gained only an aural impression of the opponent's marks. However, I do not think such confusion would normally arise or would be significant. What I must consider is the usual manner in which ordinary people behave. It seems to me that a person of ordinary intelligence and sense would pay some attention to detail when purchasing solar collectors. This would mitigate their relying on, or placing much weight on, an impression of a trade mark gained in the manner suggested by the opponent.
31. In summary, I am not satisfied the competing trade marks are deceptively similar or that there is a real tangible danger of confusion occurring.
32. The opponent has not established the s 44 ground of opposition.

### ***Section 60***

33. Section 60, in the form applicable in this instance, reads:

#### **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.

34. To satisfy this ground of opposition, the opponent needs to establish:
  - A pre-existing trade mark;

- substantial identity or deceptive similarity between the applied-for trade mark and the pre-existing trade mark;
  - the acquisition, by the relevant date, of a reputation in Australia by the pre-existing trade mark; and
  - a likelihood that, because of that reputation, use of the applied-for trade mark would be likely to deceive or cause confusion.
35. The opponent's evidence shows use and promotion of its marks as at the relevant priority date. However, I have already found that none of the opponent's trade marks is deceptively similar to the applicant's mark, which is the threshold test set out at s 60(a). The s 60 ground is therefore not established.

### **Decision**

36. Section 55 of the Act provides:

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.

37. As the opponent has not established any of the grounds of opposition on which it relied, the opposition fails.
38. Accordingly, I direct that the application may proceed to registration after 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 either the appeal has been discontinued or, otherwise, the court orders that registration proceed.

### **Costs**

39. It is usual for costs to follow the event. As the applicant did not have legal representation, file evidence, appear at the hearing, or make written submissions, it is difficult to see how it could have incurred costs in this matter. However, the opponent

has not established any of the grounds of opposition and the applicant is entitled to its costs should there be any. Accordingly, I award costs against the opponent at the usual scale.

Frances Aarnio  
Hearing Officer  
Trade Marks Hearings  
19 January 2009