

TRADE MARKS ACT 1995

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

Re: Opposition by Garry John Arbrew to registration of trade mark application 1144564(12) - **AXLE ARMOUR** - filed in the name of Promoto Melbourne Pty Ltd.

DELEGATE:	Jock McDonagh
REPRESENTATION:	Opponent: Benjamin Fitzpatrick of counsel, instructed by Griffith Hack, patent & trade mark attorneys Applicant: David Franklin of FB Rice & Co, patent & trade mark attorneys
DECISION:	2009 ATMO 47 Section 52 opposition section 58 – applicant not the owner of trade mark - costs awarded against applicant

Background

1. Promoto Melbourne Pty Ltd. ('the applicant') is the applicant for registration of a trade mark, current details of which are:

Application No: 1144564
Priority Date: 9 November 2006
Goods: Class 12: Vehicle bumpers
Trade Mark: AXLE ARMOUR

2. Following examination, the application was accepted for possible registration and advertised as such in the *Official Journal of Trade Marks* on 15 March 2007.
3. On 14 June 2007, Garry John Arbrew ('the opponent') filed a Notice of Opposition under section 52 of the *Trade Mark Act 1995* ('the Act'), objecting to the registration of the trade mark.
4. The parties served and filed evidence in support and evidence in answer to the opposition. That evidence is shown below:

Declarant	Status	Date, Known as	Exhibits
<i>Evidence in Support</i>			
Peter Allen Whelan	Mechanic, motorcycle dealer	4.12.07, Whelan	
Mark Lamont	Sales representative	17.07.07, Lamont	
Malcolm Alexander Callander	Former director and warehouse manager Raven Racing	26.10.07, Callander 1	

Mark Cooper	Purchaser	18.07.07, Cooper	
Matthew John Olle	Distributor	11.07.07, Olle	
Garry John Arbrew	Opponent	12.12.07, Arbrew	GJA-1 to GJA-8
<i>Evidence in Answer</i>			
Greg Webb	Company Director	31.03.08, Webb	
Frank Hadju	Director and owner of applicant	14.04.08, Hadju	P1 to P18
<i>Evidence in Reply</i>			
Malcolm Alexander Callander	Former director and warehouse manager Raven Racing	27.06.08, Callander 2	
Simon Nikolaus Warkotsch	Director Raven racing	20.11.08, Wakotsch	

5. The opponent asked to be heard and the matter came before me as a delegate of the Registrar of Trade Marks, in Melbourne on 26 March 2009. The opponent was represented by Benjamin Fitzpatrick of Counsel, instructed by Griffith Hack, patent & trade mark attorneys. The applicant was represented by David Franklin of FB Rice & Co., patent & trade mark attorneys.
6. The Notice of Opposition cited most grounds of opposition available to the opponent under the Act; however, at the hearing Mr Franklin limited his submissions to those grounds of opposition under sections 58 and 60. For the sake of completeness, I treat the remaining grounds of opposition as having been abandoned.

Discussion

Section 58

7. Section 58 of the Act provides:

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

8. To succeed on this ground, absent any evidence of use by the applicant before the priority date of its application, (as is the case here), the opponent must be able to demonstrate use prior to that date, of the same or a substantially identical trade mark, in relation to the same goods or goods considered the “same kind of thing”.¹

¹ *Re Hicks Trade Mark* (1897) 22 VLR 636.

9. It is clear from the evidence that both parties have been involved in the motorcycle accessory business for about 10 years. Both parties manufacture and sell products including axle bumpers, which are fitted to the ends of motorcycle axles to provide protection to the axle, brake calipers, fork legs and swing arms in the event of an accident. The axle bumpers are also referred to as vehicle bumpers.
10. The vehicle bumpers have been called “Oggy Knobbs” by the applicant, which he has registered as a trade mark. The opponent has apparently produced vehicle bumpers that bore the name “Ozynobs” for some time until requested to cease doing so by the applicant.
11. The opponent claims use of the trade mark AXLE ARMOR since 2004, while the applicant claims to have used the applied for mark since filing the application. The applicant also claims that the name was coined in 2002 in discussions between Malcolm Callander and Frank Hajdu in 2002, with regard to the “Oggy Knobb” product. The applicant stated that Mr Callander had suggested using “Axle Armour” as a name for the products.
12. From the outset, there was no dispute between the parties as to whether their respective goods of interest were anything other than what may fairly be described as ‘the same’. The identity of the goods being thus established, the remaining issue for determination is whether the opponent has used an identical, or substantially identical, trade mark on those goods, prior to the filing date of the application.
13. The accepted test for substantial identity involves side-by-side visual comparison of the relevant trade marks². A finding of substantial identity means that ‘in a real sense a claim to proprietorship of the one [trade mark] extends to the other.’³
14. I find that AXLE ARMOUR and AXLE ARMOR are substantially identical. I note that the opponent also used the trade mark AXLE ARMOR AUSTRALIA in a device; however, the essential element of the device was “AXLE ARMOR”. I consider AXLE ARMOR AUSTRALIA and device to be substantially identical to AXLE ARMOUR.

² *Shell Co. of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1961) 109 CLR 407 at 414-5.

³ *Carnival Cruise Lines Inc v Sitmar Cruises Ltd*, 31 IPR 375, at 391.

15. While the applicant's submissions dissected the opponent's evidence with a view to impeaching it, there has been no effective contradiction of the opponent's evidence of use of AXLE ARMOR as a trade mark in respect of the same goods prior to the application date of the applicant's mark.
16. Mr Hadju's evidence refers to a conversation with Mr Callander in 2002 suggesting the use by the applicant of AXLE ARMOUR as a trade mark. This is directly contradicted in Callander 2 and, in any event, the mere discussion of a mark without more does not constitute relevant use.
17. In Hadju, there was evidence that the applicant was not aware of any prior use of the mark by the opponent and an ATMOSS search had revealed no prior or pending application. Although there is evidence of a history of ill feeling between the parties, there is no suggestion of any bad faith involved in the application. The applicant's knowledge or otherwise of prior use of the opponent's mark is not relevant to the section 58 ground.
18. In summary I am satisfied that the opponent has established that prior to 9 November 2006 it used a trade mark (or trade marks), to which the opposed mark is substantially identical, for goods the same as, or the same kind of thing as, the "vehicle bumpers" covered by the opposed application. I accordingly find that the applicant is not the owner of the applied for trade mark in terms of section 58 of the Act.
19. Having found in favour of the opponent in terms of section 58 there is no need for me to discuss the other ground pressed at the hearing; however, that ground or any others in the Act may also be relied on in the event of an appeal of this decision.

Decision

20. 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.

21. The onus is upon the opponent to establish one or more grounds of opposition. I find that the opponent has met the onus upon it, in terms of the ground of opposition under section 58 argued at the hearing. Accordingly, and subject to a successful appeal from my decision, I refuse to register trade mark application 1144564.

Costs

22. It is usual for costs to follow the event, and I see no reason to depart from that principle here. I award costs, according to the official scale set out in Schedule 8 of the *Trade Marks Regulations 1995*, against the trade mark applicant.

Jock McDonagh
Hearing Officer
Trade Marks Hearings
30 June 2009