

TRADE MARKS ACT 1995

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

Re: Proposal to revoke acceptance of trade mark application numbers 1211836
(37, 42) - **APEX FENNER**, and 1212087 (37, 42) -



in the name of J.H.FENNER & CO. LIMITED.

DELEGATE:	Heath Wilson
REPRESENTATION:	Applicant: Anthony Norris of Collison & Co Patent and Trade Marks Attorneys of Adelaide.
DECISION:	2009 ATMO 07 Section 38 – error or omission in examination – reasonable in all the circumstances - Acceptance to be revoked

Background

1. On 23 and 26 November 2007, J.H. Fenner & Co. Ltd filed applications to register the trade marks 1211836 and 1212087 respectively. During examination, the relevance of Trade Mark Registration No. 485210 was considered by an examiner of trade marks, but the official file is noted to show that the examiner was of the view that the services were distinguishable for section 44 purposes, and the current applications were accepted. The Trade Marks Office later decided to revoke the acceptance on the basis of a section 44 ground in relation to trade mark 485210. The applicant was given the opportunity to be heard, and invoked the right for a decision in the matter of the proposed revocation. I have been delegated to decide the matter of whether the revocation of acceptance for the above trade marks is appropriate.

The Law


Section 38 of the *Trade Marks Act 1995* (“the Act”) provides:

- (1) *Before a trade mark is registered, the Registrar may revoke the acceptance of the application for registration of the trade mark if he or she is satisfied that:*


- (a) *the application should not have been accepted, taking account of all the circumstances that existed when the application was accepted (whether or not the Registrar knew then of their existence); and*
- (b) *it is reasonable to revoke the acceptance, taking account of all the circumstances.*

Reasons

2. The considerations under the amended provisions of section 38 indicate that all the circumstances must be taken into account when determining whether it is reasonable for Registrar to revoke the acceptance.
3. The crucial consideration for this mark is one of “deceptive similarity” under section 44 of the Act, and it is the main thrust of the applicant’s submissions. It involves a comparison of the following trade marks:

Trade mark registration:	1211836; 1212087	
Trade mark:	APEX FENNER;	
Owner:	J.H. FENNER & CO. LIMITED	
Goods Specification:	<p>Class: 37 Installation, repair and maintenance of conveyor systems and their parts; installation, repair and maintenance of conveyor belts and belting</p> <p>Class: 42 Safety inspection services; preparing reports; risk assessment services; consultancy services; all relating to conveyor systems and belts and belting therefor</p>	

With the following trade mark:

Trade mark registration:	485210	
Trade mark:		
Owner:	Apex Consolidated Industries Limited	
Goods Specification:	Class: 42 Retailing services excluding such services in respect of golfing apparatus and equipment, non-alcoholic beverages and	

beers, motor vehicles; fertilisers, controlled release fertilisers, slow release fertilisers, manures, soil conditioners, soil treatment goods; catering services excluding such services in respect of non-alcoholic beverages and beers; providing facilities for exhibitions; vocational guidance; professional consultations; project studies; editing; preparation of reports; services in this class rendered by the Association to its membership; benevolent services in this class rendered by the Association to the community to foster active interest in the civic, commercial, social and moral welfare of the community

4. The test for deceptive similarity is stated in *Australian Woollen Mills Ltd v F. S. Walton and Company Ltd* (1937) 58 CLR 641 (per Dixon and McTiernan JJ at 658):

‘the marks ought not ... 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 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.’

5. In the instance of a trade mark combining a device with a word (such as 485210 & 1212087), customers will more naturally refer to the word, when ordering the product or services (*American Trading & Shipping Co Ltd’s Appn* (1936) 6 AOJP 78 (Reg)). Despite the devices being different, the verbal similarities between the two marks give rise to confusion.
6. As “APEX” is a distinctive term for the services of “preparing reports” and appears as the major element, it is more likely to be referred to as such for the brand. At the very least, the average consumer would assume a trade connection between the APEX and APEX FENNER, and would be likely to be confused or misled as to the trade source.
7. If a “mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection”, (*Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at 162 (HL)) this can cause confusion. The main feature in this case would be the term “APEX” as it is the prefix of the mark, and is an original term for the services. This feature is a major element of both of the applicant’s marks (1211836 and 1212087).

8. The fact that the applicant's mark also consists of a surname "FENNER" does, to some extent assist in the differentiation between the marks. However, it occurs after the word "APEX", and the commonness of a surname in a mark may result in it being seen as a non-essential feature, with less emphasis being placed on it than the word "APEX."
9. The services in trade mark 485210, in part, read:

“Class: 42: *professional consultations; project studies; editing; preparation of reports; services in this class rendered by the Association to its membership;*

- are similar services to:

“Class: 42: *Safety inspection services; preparing reports; risk assessment services; consultancy services; all relating to conveyor systems and belts and belting therefore”* in the current applications.

Whereas the applicant has limited their “preparing reports” to that relating to “conveyor systems and belts and belting therefore”, this is still encompassed in the broad claim “preparation of reports” in Class 42 of registration 485210. As a result, that owner could conceivably be preparing reports on the same subject matter (conveyor systems and belts) as the applicant.

10. Taking into account the above test, I am satisfied that the mark should not have been accepted taking into account all of the circumstances. Therefore the first limb, that is, subsection 38(1) (a) of the Act is satisfied.
11. The second limb, subsection 38(1) (b), is whether Registrar is satisfied that it is reasonable to revoke the acceptance, taking into account all of the circumstances. Under the previous section 38 legislation and *Re Application by Remington Products Inc (1990) 18 IPR 251*, if the objection to acceptance is the result of nothing more than a difference in opinion between trade mark officers, or a change of mind on the part of a trade mark officer, then revocation of acceptance is not appropriate. It is worth noting that the mark 485210 was extracted in the examiner's search strategy as “Different goods and /or services.”

12. While it is no longer a requirement that there be an error in examination, it is clear that the examiner considered the mark 485210 to have different services from the current application. This is clearly not accurate, due to the comparison I have set out above. Accordingly, this information was overlooked or discounted, and, in my view, led to the failure of a ground for rejection being raised.
13. While any withdrawal of acceptance should not be proposed lightly, I have taken into account that this citation may be overcome quite easily, either by deleting/refining the conflicting services, or obtaining a letter of consent from the owner of the cited mark as they may not be interested in the specific subject matter of the applicant. I am satisfied that there has been a clear error in examination, and the presumption of registrability is not applicable in this matter.
14. The applications have not been opposed, but there remains a public interest in the proper application of section 44, and in not allowing two deceptively similar trade marks with specifications containing similar services to remain on the register, (see *Aceto Balsamico Del Duca Di Adriano Grosoli SRL v Registrar Of Trade Marks* (2008) 75 IPR 400 p36), even at the price of a small inconvenience to the applicant. Trade mark owners who have trade marks incorporating the word “APEX” may be satisfied that their pre-existing registrations have been suitably considered and their prior rights taken into account (see: *Re Application By Channel Four Television Corporation* (2007) 72 IPR 163 Para 17).
15. On a balance of the inconvenience to the applicant, and the need to ensure the trade mark register is consistent and accurate as possible, I am satisfied that it is reasonable to revoke acceptance under section 38 of the Act, and return the trade mark to examination, allowing the holder to appropriately overcome any grounds for rejection.

Decision

16. I therefore direct that the acceptance of applications 1211836 and 1212087 be revoked 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 the revocation shall not occur until the appeal has been discontinued, or in the event of a decision of the court, that the application be subject to that order.

Heath Wilson
Hearing Officer
Trade Marks Hearings
20 January 2009