

TRADE MARKS ACT 1995

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

Re: Trade mark application number 1229662(41) – **ASPIRE FUTURE LEADERS and device** - in the name of University of Western Sydney.

DELEGATE:	Frances Aarnio
REPRESENTATION:	Applicant: Mr Tokunbo Olibinri of Parity Law
DECISION:	2009 ATMO 10 Section 44; deceptive similarity; application rejected.

Background







1. On 12 March 2008 the University of Western Sydney ('the applicant') applied to register the following trade mark for *Education; providing of training; entertainment; sporting and cultural activities* in class 41:



2. Examination of the application was expedited at the request of the applicant. In all, two adverse reports were issued. The examiner maintained that there were grounds for rejecting the application under s 44 of the *Trade Marks Act 1995* ('the Act') because the applicant's mark was deceptively similar to 14 trade mark registrations and applications ('the cited trade marks').
3. On 16 September 2008 the applicant requested to be heard. The matter came before me as a delegate of the Registrar of Trade Marks in Sydney on 14 October 2008. Mr Tokunbo Olibinri of Parity Law represented the applicant.

Submissions

4. The cited trade marks are:

Trade mark	Priority date	Owner	Class	Status
672075 ASPIRE	8 September 1995	Acer Incorporated	9	Registered
785998 A.S.P.I.R.E	19 February 1999	Australian Olympic Committee Inc	2,5,16,24,25, 28,29,30,32, 36,38,39,41	Registered
889243 	12 September 2001	Aspire Training & Consulting	16,41	Registered
958664 	23 June 2003	Australian Olympic Committee Inc	24,25,28,35, 41,45	Registered Provisions of para 44(3)(b) applied. Provisions of s 44(4) applied.
1009272 	2 July 2004	Aspire	16,25,28,35, 41,42	Registered Provisions of para 44(3)(b) applied.
1036859 	7 January 2005	Aspire IP Pty Ltd	36,41	Registered
1036977 	7 January 2005	Sandra lee Woods	36,41	Registered
1156486 ASPIRE	16 January 2007	Aspire IP Pty Ltd	36,41	Deferred
1156488 	16 January 2007	Aspire IP Pty Ltd	36,41	Deferred
1193503 ASPIRE OUTLOOK	15 August 2007	Aspire IP Pty Ltd	36,41	Deferred
1195428 ASPIRE WEALTH COACHING	22 August 2007	Sandra lee Woods	36,41	Deferred
1195429 ASPIRELIVE; ASPIRE LIVE	22 August 2007	Aspire IP Pty Ltd	36,41	Deferred
1220305 AspireUNITE	21 January 2008	Aspire IP Pty Ltd	36,41	Under examination
1220241 Aspire to BE More	25 January 2008	The Australian Episcopal Conference of the Roman Catholic Church	35,36,41	Registered

5. The applicant submitted that its mark is not deceptively similar to any of the cited trade marks. In essence, the applicant argued there was no real likelihood of confusion. Its trade mark should be viewed as a whole and considered in the context of the normal course of business in which it would operate.
6. It drew my attention to the following:
 - The service the applicant offers under the trade mark is a leadership program for young talented students. In that business context, the emphasis would be on the visual impression created by the marks.
 - Proper emphasis should be given to the words FUTURE LEADERS within the mark. As those words are integral to the idea of the mark and the program offered under the mark, they would form part of the public recollection.
 - The applicant's mark also contains a coloured flame device above the letter I. The device is prominent in the mark and it should be given appropriate emphasis.
 - Research shows the word ASPIRE is widely used in a trade mark and business sense across many fields, including education and training. The public would be used to distinguishing between marks which employ the word ASPIRE and would pay more attention to the differences between the marks.
7. To support its argument, the applicant provided the statutory declaration of Angelo Kourtis, dated 14 October 2008, with Annexures A and B. Mr Kourtis is Marketing Director of the applicant, a position he has held for 5 years.
8. The declaration sets out particulars of the trade mark's use as well as information relating to the leadership program the applicant offers under the trade mark. At Annexure A are brochures relating to various scholarship and development programs provided by the applicant. Annexure B provides marketing expenditure for the Aspire Future Leaders program for 2008.

Reasons

Section 44

9. So far as it relates to this application s 44 reads:

Identical etc. trade marks

(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.

(3) If the Registrar in either case is satisfied:

- (a) that there has been honest concurrent use of the 2 trade marks; or
- (b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

Note: For *limitations* see section 6.

(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.

Priority dates

10. The priority dates of the cited marks are all earlier than that of the application.

Closely related goods and similar services

11. The applicant made no submissions on the relationship between its services and the goods and services covered by the 14 cited trade marks. For completeness, I record that having applied the established tests¹, I am satisfied the applicant's services are closely related or similar to the following goods and services covered by the cited trade marks:

Trade mark	Class	Goods/services
672075	9	Computers
785998	16	Teachers' guide books. . ., all of the foregoing relating to the history of the Olympic Games and the ethos, ideals and spirit of the Olympic Movement
	41	Education; providing of training; entertainment, sporting and cultural activities
889243	16	Publications – training resources (not related to computers)
	41	Training (not related to computers)
958664	41	Education for Olympians; providing of training for Olympians; entertainment, sporting and cultural activities for Olympians
1009272	16	. . . printed matter, printed publications . . .teaching materials (except apparatus); none of the aforementioned goods being provided to or for Olympians or in relation to the Olympic Games, the International Olympic Committee or the Australian Olympic Committee
	41	Boarding schools, club services (entertainment), correspondence courses, . . . entertainer services, entertainment, entertainment information, game services provided on-line from a computer network, providing golf facilities, gymnastic instruction, holiday camp services (entertainment), presentation of live performance, organization of balls, organization of competitions (entertainment), organization of exhibitions for cultural purposes, organization of shows (impresario services), party planning (entertainment), practical training (demonstration), . . . providing sports facilities, radio entertainment, providing recreation facilities, rental of sports equipment (except of vehicles), rental of stadium facilities, rental of tennis courts, nursery schools, sport camp services, television entertainment, timing of sports events, tuition, none of the aforementioned services being provided to or for Olympians or in relation to the Olympic Games, the International Olympic Committee or the Australian Olympic Committee
1036859	41	Education and providing training in relation to financial affairs, including real estate superannuation, share trading, investment strategies, insurance, financial planning and fund management; all of the aforementioned services excluding education, providing of training and entertainment services in relation to sporting and cultural activities
1036977	41	Education and providing training in relation to financial affairs, including real estate, superannuation, share trading, investment strategies, insurance, financial planning and fund management; all of the aforementioned services excluding education, providing of training and entertainment services in

¹ *Jellinek's Application* (1946) 63 RPC 59; *John Crowther & Sons (Milnsbridge) Ltd* (1948) 65 RPC 369; *Registrar of Trade Marks v Woolworths Limited* 45 IPR 411.

		relation to sporting and cultural activities
1156486	41	Education; training; wealth coaching; arranging and conducting classes, courses, seminars, symposia and workshops, including those in the field of financial and investment services; information, management, advisory and consultancy services in relation to all the aforementioned services, all of the aforementioned services excluding education, providing of training and entertainment services in relation to sporting and cultural activities
1156488 1193503 1195428 1195429	41	Education and providing of training in relation to financial affairs, including real estate, superannuation, share trading, investment strategies, financial planning and fund management; wealth coaching; arrangement and conducting classes, courses, seminars, symposia and workshops, including those in the field of financial and investment services, information, management, advisory and consultancy services in relation to all the aforementioned services; all of the aforementioned services excluding education, providing of training and entertainment services in relation to sporting and cultural activities
1220241	41	Charitable services, namely education and training
1220305	41	Education and providing of training in relation to financial affairs, including real estate, superannuation, share trading, investment strategies, financial planning and fund management; wealth coaching; arranging and conducting classes, courses, seminars, symposia and workshops, including those in the field of financial and investment services; information, management, advisory and consultancy services in relation to all the aforementioned services, all of the aforementioned services excluding education, providing of training and entertainment services in relation to sporting and cultural activities

Comparison of trade marks

12. 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.
13. The tests for deceptive similarity are well known. They rely on a comparison of the net impression created by each of the competing marks².
14. In *Australian Woollen Mills*³ 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

² *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*').

³ (1937) 58 CLR 641.

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.

15. Taking into account the change in onus under the 1995 Act, French J in *Registrar of Trade Marks v Woolworths*⁴ 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:

- (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.

⁴ (1999) 45 IPR 411.

16. Because of the nature of the leadership program it is offering under the mark, the applicant maintained that emphasis should be on the visual impression created by the marks. The applicant also suggested that consumers would be used to distinguishing ASPIRE marks as the word is frequently used in a business and trade mark sense, including for education and training services.
17. I note that there are currently seven registered trade marks (owned by six different parties) containing the word ASPIRE on the Trade Marks Register in class 41. The education and training services covered by those marks are mostly in different and unrelated fields. Where the marks cover the same services, the owners have provided evidence of use or other circumstances, which has allowed acceptance.
18. Here the applicant has not restricted its application to any particular field of education but has applied to register its trade mark for the full range of education, training, entertainment, sporting and cultural services in class 41. In assessing whether deception and confusion is likely, therefore, I must assume normal and fair use of the applicant's mark on that full range of services.
19. Nevertheless, I agree that in this case the visual impacts of the marks carry greater weight than aural similarity. There is an increased global use of visual media and an obvious heavy reliance on visual perception in the marketplace. Aural perception is still relevant and particularly important where goods or services are ordered verbally. However, given the nature of the services involved, and taking into account the likely manner in which they will be promoted to, and selected by, the public, the visual impressions created by the marks are more important.
20. The applicant argued that in assessing the impression created by the applicant's mark I must give proper emphasis to all of that mark's features. I accept this submission. However, this does not mean that each of the features within the mark will be equally memorable or striking. In *Starr Partners Pty Limited v Dev Prem Pty Ltd*⁵ at paragraph 22, Lindgren, Emmett and Finkelstein JJ observed:

The first step in the analysis is to identify the impression produced by the registered mark considered in its entirety. Similarity is not based on only part of the registered mark. On the other hand, when one decides upon the impression produced by that mark it is not improper to give more or less weight to particular

⁵ [2007] FCAFC 42 (28 March 2007).

features of it, provided the ultimate conclusion is based on a consideration of the mark in its entirety. This approach does no more than recognise that one word or feature of a mark can be more striking and memorable than another.

21. When the applicant's mark is viewed as a whole, it is the word ASPIRE which immediately strikes the eye. It is clearly dominant, and more memorable than the other features. The elements FUTURE LEADERS and the flame device are secondary and not as significant. The words FUTURE LEADERS appear in a subordinate position under the word ASPIRE and in much smaller and lighter font. The flame device above the letter I is reasonably tall but it is somewhat nondescript and not striking.
22. The idea of the mark is that created by the word ASPIRE. That is how consumers are likely to remember the mark and identify the services offered under it. I cannot see that they would recall it in any other way. It is worth noting that in its promotional literature the applicant consistently refers to the training program it offers under the mark as "Aspire" or "the Aspire Program".⁶
23. I turn now to the 14 cited trade marks. With the exception of trade mark 1220241, the impression created by the cited trade marks is of the word ASPIRE. Whether the word ASPIRE appears in each of the marks alone, with other words or device elements, in each case it is the element by which the mark is likely to be known and recalled.

672075, 785998, 1156486

24. Trade marks 672075, 785998 and application 1156486 consist of the word ASPIRE. Although full stops separate the letters in trade mark 785998, consumers are still likely to view the word as ASPIRE.

1193503, 1195428, 1195429, 1220305

25. These marks all contain the word ASPIRE in combination with other words. ASPIRE is an essential and distinguishing feature of each mark. The other words appearing in the marks such as OUTLOOK, WEALTH COACHING, LIVE, UNITE are likely to be viewed as descriptive material or indirect references to the designated services.

⁶ Annexure A of the statutory declaration of Angelo Kourtis.

889243, 958664, 1009272, 1036859, 1036977, 1156488

26. Where a trade mark combines a device with a word, the word is of primary importance as it is that element that consumers are likely to remember⁷. While all of these marks contain other word and device elements, ASPIRE is clearly the prominent and memorable feature.
27. I consider the applicant's mark is deceptively similar to the 13 cited trade marks discussed above. I accept there are differences between the marks and these may play a role if the marks were to be compared side by side. However, when the marks are considered in isolation and the matter depends on the impression or recollection of the mark formed in the mind of the average customer, there is a real likelihood of confusion as the impressions created by the marks are the same.

1220241

28. The remaining cited trade mark is trade mark 1220241, Aspire to BE More. This mark also contains the word ASPIRE but as a whole it does not create the same impression that the applicant's mark creates. The phrase Aspire to BE More has an obvious corporate identity. Consumers are likely to recall the whole phrase and its meaning. I do not consider the applicant's mark is deceptively similar to this registered trade mark.

Likelihood of confusion

29. I am satisfied the applicant's trade mark is deceptively similar to trade mark registrations 672075, 785998, 889243, 958664, 1009272, 1036859, and 1036977 and trade mark applications 1156486, 1156488, 1193503, 1195428, 1195429 and 1220305. As these marks have earlier priority dates than the applicant's mark and cover similar services or closely related goods, I consider there is a real likelihood of confusion arising.
30. The applicant has not brought to my attention formal evidence of use that will allow acceptance of its trade mark under the provisions of s 44(3)(a) or s 44(4). I am not

⁷ See *American Trading & Shipping Co Ltd's Appn* (1936) 6 AOJP 78; *Havana Club Holding SA v Pac-Rim Management Services Ltd* (1998) 43 IPR 177

aware of any other circumstances that will allow acceptance of the mark under the provisions of s 44(3)(b).

Decision

31. Subject to any appeal from my decision, I reject trade mark application 1229662 under s 33(3) and s 44(2) of the Act.

Frances Aarnio
Hearing Officer
Trade Marks Hearings

6 February 2009