



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

**Re: Trade Mark applications 567221, 567233, 567238, 567241, 578657 and 578659
in the name of Mobil Oil Corporation.**

Mobil Oil Corporation has applied for the registration of a trade mark, in a typeface as follows, with the letter O in red and the rest in blue, in various classes:

Mobil

The goods specified in the various applications are, respectively:

567221: Jewellery; watches; clocks and other chronometric instruments; precious metals and their alloys and all other goods in this class

567233: Raw timbers; agricultural and horticultural products and all other goods in this class

567238: Communication services including television and radio services and all other services in this class

567241: Entertainment and education services and all other services in this class

578657: First aid kits; bandages; surgical scissors; tweezers and all other goods in this class

578659: Mouth organs; children's musical instruments and all other goods in this class

Registration is sought in Part D of the register. Part D deals with the defensive registration of trade marks and the essential registrability questions are set out in s 93(1) of the Act. This provides:

Defensive registration of well-known trade marks

93. (1) Where a trade mark registered in Part A of the Register has been used to such an extent in relation to all or any of the goods or services in respect of which it is registered that the use of the trade mark in relation to other goods or services would be likely to be taken as indicating a connexion between those other goods or services and the registered proprietor, the trade mark may, upon the application of the registered proprietor of the trade mark, be registered as a defensive trade mark in Part D of the Register, in the name of the applicant as proprietor, in respect of all or any of those other goods or services notwithstanding that he does not use or propose to use the trade mark in relation to those other goods or services and notwithstanding anything in section 23.

Several examiners reports have issued on these applications. The common theme to all of them is that the applicant has not established such a connexion. In support of this the examiner notes that the goods and services in question in the present applications are a long way from what is said, by the examiner, to be Mobil's main business area. The examiner has also relied on the decision of King J. in *Mobil Oil Corp v Registrar of Trade Marks* 1 IPR 366.

The principles and the mark at issue in that case are not those of the present ones. The earlier case dealt with the word MOBIL simpliciter. King J also felt himself obliged, at that time, to reject as inadmissible in a court of law the applicant's survey evidence. That evidence was tendered to answer the question, put to members of the public in a professionally conducted random survey, "what does (the word MOBIL, printed in black letters on a white card) mean to you".

That decision none the less sets down some fairly definite constraints on the present application. These are givens, a part of the background of the present applications unless for some reason they are no longer applicable:

- 1) As to pronunciation, 'there is no significant similarity to the ear between "mobil" and "mobile" in so far as any substantial section of the Australian public is concerned.' (supra at p375)
- 2) MOBIL is none the less not, on King J's framing of the relevant test, an invented word.

That latter is a finding that will generally make it harder to gain a part D registration (*Bingo Pty Ltd's application*, AOJP 19.4.62, p 775 at p 778).

One aspect of the decision which is relevant now, is King J's speculation about the extent and effect of the applicant's then-current reputation. At p 378, with my own italicised additions:

I do not think the reputation (*in respect of various petrol, oil and agricultural products*) is strong enough to establish that the public would have regarded the mark, when used in respect of the goods applied for (*toys and playthings*), as identifying the appellant as the marketer of those goods; on the evidence it could establish no more than that the public would regard the mark as identifying the appellant as the marketer of the goods in respect of which it had used the mark before 1976. Thus in appropriate circumstances, the public would see the mark appearing on the goods applied for as advertising the applicant's petroleum products. An example might be where the mark is printed on golf balls already bearing another manufacturer's mark. ...(But) in a context which would not normally be taken as advertising other goods, the public, being unaware of any use of the mark in respect of the goods applied for, would tend not to be influenced in their appreciation of the significance of the word by the sales relied on by the applicant. They might think that some other enterprise was using in an area of trade remote from the trade in petroleum products the same mark as that used by the appellants in respect of petroleum products.

This is something that may not necessarily be so today, since the business now operated by Mobil is considerably more diversified and is known to be so, particularly at the retailing end. None the less, that authority provides considerable support for the prima facie objection that the applicant has met in all its applications.

The applicant elected to be heard on the question of the substantive objections. At the hearing, it was represented by Mr John Gibbs, a patent attorney of the attorney firm of Phillips Ormonde and Fitzpatrick.

Mr Gibbs commenced his submissions by noting the extent of business done by Mobil under its goods and service marks. He relied here on the declaration of Mr Peter Sanguinetti, Assistant General Counsel and Company Secretary to Mobil Oil Australia, a wholly owned subsidiary of

the applicant. Mr Sanguinetti has set out the relevant sales and other business details of the applicant in Australia. These amounted to sales, in 1990, of about \$100 per head of population in Australia. He states that in addition to Mobil's service stations - some 1500 sites in 1981 - Mobil Handy Marts have been in operation since 1983 and that by 1991 there were 290 such retail outlets throughout Australia. Nor is all Mobil's business done through its service stations or Handy Marts. MOBIL mineral turpentine and kerosene have been available through hardware stores and larger chain stores since some time in the 60's.

Mr Gibbs also referred to a further declaration, by Mr Hugh Hubbard. Mr Hubbard is a lecturer in Marketing with the Royal Melbourne Institute of Technology and, prior to this, worked as a consultant in a variety of marketing research companies. On the face of it, Mr Hubbard appears to be very well qualified to speak on both the theory and the practicalities of marketing.

Mr Hubbard notes the extent of involvement of Mobil with road safety campaigns and with the Arts. It also contributes very substantial amounts to education, sports and community fitness programs. He states that "such contributions build significantly on the goodwill attaching to the MOBIL name, outside the areas traditionally regarded as part of Mobil's core business". He emphasises that Mobil is well known as one of the biggest corporations trading in Australia. More significantly, he states that "The MOBIL trade mark will have been associated with all the activities of the corporation, directed at the benefit of a number of publics well beyond those who actually purchase specific commercial products or services."

Mr Hubbard notes that marketing experts have recently begun to understand that there is more to the reputation of a business than simply what he calls the fundamental values of the products and services it sells. "More and more consumers want to know exactly what a corporation is about", according to one of the authorities he quotes. "Hence", declares Mr Hubbard, "the plethora of recent literature and practice known as 'Integrated Marketing Communications'

designed to maximise the positive synergies between the various forms of public communication".

Mr Hubbard builds these premises into a theorem: "Irrespective of the class of goods and services, any organisation carrying the MOBIL trade mark could be accused of either passing off or threatening the brand equity of Mobil Oil Corporation."

Mr Hubbard has chosen his words carefully in the declaration, but in some instances his framing, while supportive of the applicant's case, does not go far enough to address the concerns of s 93. In particular, while Mr Hubbard has been quite definite about the accusation of "passing off or threatening the brand equity" of the applicant, he has been less than categorical about the extent to which the trade mark MOBIL will in fact be associated with the applicant in respect of particular goods and services. As Mr Gibbs noted, Mr Hubbard is a marketing expert and not a lawyer, so his declaration may well reflect the practicalities of the situation without necessarily addressing the issues of law which are the basis of my decision. Equally, the choice of words shows that his statements have been carefully weighed.

In the main, Mr Hubbard has looked at the relationship between the applicant and the goods or services in various classes. For example: (emphasis added) "In my opinion, jewellery, precious stones, horological instruments, and small items made from or coated in precious metals are all goods of a type which members of the Australian public would expect to purchase at a convenience store such as a Mobil Handy Mart. Accordingly, for the reasons previously discussed it is my opinion that **a proportion** of the Australian public would infer a connection in the course of trade with Mobile Oil Corporation if the trade mark MOBIL were to be used in relation to these goods". I presume the "reasons previously discussed" is a combination of the general points made in the previous 14 pages of the declaration, including the size of Mobil Oil Australia, his belief about passing off or threatening the applicant's brand equity and his belief that customers would not be surprised to find MOBIL branded products in a Mobil Handy Mart.

This is typical of the form of statement made about most of the goods and services at issue in these applications, though the reasons why Mr Hubbard believes a connection would be inferred by " a proportion" of people vary. Sometimes the reasons given are not very compelling in relation to some of the goods in question. For example, the sale of pharmaceutical and medical products including first aid kits, plus Mobil's road safety campaign record, are said by Mr Hubbard to justify an expectation, on the part of consumers, of a connexion between Mobil and veterinary apparatus among other things. While ultimately I agree with Mr Hubbard's overall opinion, the examiner was entitled to dispute the detailed claims which are said to give rise to the beliefs which Mr Hubbard believes the public would hold.

The general thrust of these claims is that an unquantified proportion of the public would hold such a belief that a connection existed. This unquantified belief, which Mr Hubbard asserts would exist in relation to many goods and services, is to be contrasted with his statement that "carpets and mats for cars and other vehicles, as well as travelling rugs, are goods of a type which members of the Australian public would **expect particularly** to be offered by Mobil in conjunction with its service station business."

In addition, he has made some fairly sweeping statements which are not easy to accept. In particular, Mr Hubbard declares that "transportable buildings of metal... ironmongery, small items of metal hardware ... safes, goods of common metal ... are all goods in respect of which trade marks are used only to a small extent. Many of these goods are typically sold by reference to a description of the product and the name of the supplier, rather than a reference to a trade mark which is intended to convey a particular image in relation to these goods". Perhaps Mr Hubbard uses "trade mark" in some sense other than the strict one of s 6 of the Trade Marks Act, eg to identify a label with an emotional impact "intended to convey a particular image", and he is thus declaring that metal goods of the type in question are not sold with this particular sort of emotional appeal.

Be that as it may, I also find it hard to understand what Mr Hubbard means when he declares that customers would expect to find typewriters for sale in convenience stores such as the ones operated by Mobil. Typewriters are not, to my knowledge, the sort of consumable items which are sold in convenience stores in general. Since there is no evidence that they have ever been sold in Mobil's stores in particular, such a statement is difficult to accept at face value.

Mr Gibbs argued that it would have been very difficult to prepare one declaration that went to all of the public perceptions of the trade mark MOBIL in relation to the wide diversity of Part D applications originally lodged. Mr Hubbard's declaration was meant to be an alternative to the traditional approach of the stereotyped declarations commonly relied on to demonstrate that a reputation exists in the trade. Such declarations have been criticised in the courts and, of particular relevance to the present matter, were criticised in one of the few precedent cases in relation to a Part D application, *Ferodo Ltd's application*, 62 RPC 111. As Evershed J put it: "twenty-five such statements might appear impressive in weight of paper but would represent so slight a fraction of the whole population as to be no guide to popular opinion and no reliable measure of the notoriety of the mark."

Mr Gibbs went on to make some very relevant distinctions between the present case and FERODO. In that case, Evershed J interpreted the somewhat different words of the UK Statute to provide that:

it is in my opinion necessary to show that the word "Ferodo" has become so well known in its application to goods of the specific kind, that is, brake and clutch linings and the like (originating in fact from the Appellants) that its use in relation to other goods ... - for example when applied to a bottle of aspirin tablets or a packet of cigarettes - would be likely to lead persons buying those other goods ... to suppose that they originated from the same person who made and marketed "Ferodo" brake and clutch linings.

There were several factors militating against such a conclusion in the FERODO case. The mark was known to be that of a specialist trader - analogous to the mark BOVRIL, which, while

well-known, was known to be restricted in application to a particular line of goods. Evershed J noted the further example of SPITFIRE, of the greatest possible fame in England at that time as the name of a successful fighter plane. But that fame was limited by the manner in which it had been built up, and no connection in the course of trade would be inferred between a tube of SPITFIRE toothpaste and the manufacturer of the aircraft of the same name.

Evershed J was also forced, by the differing provision of the UK Trade Marks Act, to exclude any possible non-trading connection. The use of a mark on goods for promotional purposes was one that might occur to the public, but Evershed J made a decision to exclude the possibility of that inference from his deliberations. He addressed only case where the use "is a part of the (applicant's) business or trading enterprise" in the narrowest sense of those words.

On the other hand, said Evershed J, if the mark had been registered and used in respect of a wide variety of goods required by the common man, its application to other goods even of a very different kind might fairly lead to the inference of a trade connection.

As Mr Gibbs argued, MOBIL is no longer just the trade mark of a manufacturer. Mobil is the operator of convenience stores and, as Mr Hubbard noted, Mobil will be held responsible for selecting the goods sold in those stores and ultimately held responsible, to some degree, for their quality, either good or bad. Even as regards its most narrowly defined core business, Mobil's products and advertising were such as would reach the majority of Australians. Moreover, the mark would be familiar to Australians as that of a very large and diverse enterprise. That, of course, is very much in contrast to what was said of Ferodo or, more particularly, of Ferodo's goods, by Evershed J.

Mr Gibbs noted Mr Hubbard's declared opinion, as a marketing expert, that "the number of people likely to infer such a connection will in my opinion be increased if the word MOBIL is represented in any vertical non-italicised, plain or bold sanserif type face; or if the word MOBIL is represented with the letter M in upper case and the other letters in lower case; or if

the letter O is in contrast in colour to the other letters; or if the letter O is in red with the other letters being in blue."

Finally, Mr Gibbs stressed that the "course of trade" aspect, noted by Evershed J, was absent from the Australian Act. Under the Australian provision, it is sufficient that use of the mark be "likely to be taken as indicating a connexion between those other goods or services" and the applicant. The fact that the connexion might be seen to be that of a promotional use, or a selection as to merchantable quality or otherwise not the strictest connection of use in the course of trade, is not significant.

I put it to Mr Gibbs that, whatever the connexion may be, the framing of the test in terms of "likely to be taken as indicating" was reminiscent of the test under s 28, "likely to deceive or cause confusion". The latter test is also imported into s 33 by virtue of the definition of "deceptively similar" marks, s 6(3).

In interpreting the test under s 28, the authorities have consistently required more than the existence of a few individuals who would hold the necessary belief. It is necessary that the belief amount to a "reasonable doubt". Per Kitto J in *Southern Cross Refrigerating v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 595: "a mere possibility of confusion is not enough - for there must be a real tangible danger of its occurring". There must be a "substantial number" of people, see *The Kendall Co v Mulsyn Paints*, (1963) 109 CLR 300 at 305, who would hold the relevant belief or beliefs. I note, however, and borrow, the UK explanation of the philosophy involved, that the word substantial must be applied properly and sensibly as being a judicial gloss - see Lord Upjohn in *Bali trade mark* [1969] RPC 472 at 496.

In short, the evidence to date does not of itself go far enough in quantifying the extent to which individuals would expect a connexion between the mark at issue and Mobil. I put this difficulty to Mr Gibbs at the hearing.

He argued that, in view of the number of applications involved, survey evidence, while helpful, would be expensive for the applicant and might not give ideal and unbiased results. Mr Gibbs argued that it would probably give a distorted picture if one group was surveyed in relation to a multiplicity of contexts in which the mark might or might not indicate, to those surveyed, some sort of connexion. As he argued, accurate views might not be given if survey participants were subjected to a multiplicity of questions, all of the form "would you associate this trade mark, on such-and-such goods, with anyone?".

I note that application 578657 faces the further objection, raised by the examiner, that it is deceptively similar to registration 213379, for the mark MOBILITE. The latter registration is in respect of "Electric lamps and electric lighting fittings, apparatus and appliances, including table and bench lamps and lamp stands" and dates from 1967, nine years before the application at issue in *Mobil Oil v Registrar*, supra. The earlier registration exists in the name of a person other than Mobil Oil Corp and the examiner maintains that the trade marks are deceptively similar and in respect of conflicting goods.

The hearing was adjourned to allow me to consider what, if any, further evidence might be necessary. I now issue my decision on matters as I understand them to stand.

Decision

While I can see Mr Gibbs' point about the difficulty in collecting accurate and persuasive survey evidence, Mobil has taken it on itself to file many part D applications at once. The fact that it may be difficult to prepare survey evidence to support them all is simply part of the process. Mobil is attempting to show that a general theory holds true when tested in relation to a wide range of goods and services, and I do not think that the present two declarations can, in themselves, be sufficient.

On the other hand, I can rely on the fact that many other of Mobil's Part D applications have in fact gone ahead on the basis that the Registrar's delegates have taken a practical view of just what the public would in fact expect of the mark MOBIL when applied to many diverse goods.

At this point, let me be very clear. The mark which has so far been registered to Mobil in Part D is the word MOBIL simpliciter. That mark has been registered for goods as diverse as first aid kits, fuel drums of plastic, chains and locks, spark plugs, spanners and wrenches, lights, bulbs and batteries for vehicles, maps and manuals, gaskets, ropes and chemical process services. Many of them, it is true, have some sort of connection with cars or car parts. But on the other hand, if the word MOBIL is expected to denote a connexion with the applicant in relation to, per registration 567213, "Cleaning preparations; polishes and waxes; soaps and shampoos; all the foregoing for vehicles", it does not take very much more to tip the scales in relation to other cleaning products in general. Similarly, if the word MOBIL will indicate a connexion with the applicant when used on first aid kits and spanners, I think that the same connexion will be invoked when the coloured representation now at issue is used on a very much wider range of goods.

Let me also note that the present applications were originally filed for the word MOBIL in plain block letters. They were amended to the present, more restrictive, form in October 1994 when the other information in the Hubbard declaration failed to convince the examiner.

Accordingly, when assessing the weight which Mr Hubbard's declaration can be given, I think I should have some regard for the concessions that have already been made in relation to the word MOBIL simpliciter. With that as a starting point, I also agree with Mr Hubbard that the chance of the public expecting a connexion with Mobil Oil Corporation is very significantly enhanced by rendering MOBIL in the particular form now the subject of this application.

Accordingly, I may be prepared to accept the applications provided that the goods or services are more precisely and reasonably defined. Given that the onus is on the applicant to establish

registrability, it is hard to see how this can be done for a list of goods as broad as "all goods in this class". The applicant should therefore propose, within two months of the date of this decision, statements of goods or services which it believes are reasonable.

Conflict with an earlier registration - MOBILITE:

This matter is an objection only in relation to application 578657, which covers all the surgical and medical apparatus in class 10. Without going into the fine points of the matter, the correctness of the examiner's objection hinges on two questions; the deceptive similarity of the marks and the inter-relationship of the goods, as per s 33.

Mr Gibbs argued that the applicant is entitled to invoke s 34, which would allow the application to proceed in the face of an objection under s 33 in view the "special circumstance" provision of s 34(1). The applicant cannot point to actual use in respect of relevant goods, but Mr Gibbs argued that the strength of the applicant's case in relation to Part D would justify the application of the special circumstances provision. He argued that the public interest required Mobil's mark to be registered to prevent any improper trading, by others, on the name of the applicant.

For present purposes, at the acceptance stage, it seems to me that the applicant has done enough to show that the word MOBIL, rendered as it presently is, is special and is generally associated with Mobil Oil Corp. But on the other hand the coining of the word MOBILITE is reminiscent of some of the things said by King J about the possible interpretation of the word MOBIL as "a disguised or mistaken rendition of the word "mobile". Perhaps those things do not apply to the word MOBIL with as much force now as they did when MOBILITE was accepted, but I do not think that the word MOBIL is quite so special when it is confronted with a registration of MOBILITE, of long standing and derived in a way that may be relevant.

At the very least, there is some reason to speculate, for goods for which MOBILITE is registered, on the extent to which a connexion might be drawn between MOBIL and the applicant to the reasonable exclusion of others. While I note and give great weight to the

colours and font used to render the word MOBIL in application 578657, I think that the applicant still has a way to go in proving the worth of its case where an unconnected party has a prior claim for a deceptively similar mark.

Mr Gibbs argued that the relevant question goes to the use, rather than the mere fact of registration, of MOBILITE. It is true that in *Ferodo*, supra, Evershed J referred to the question of proof that a conflicting mark had not been "used and applied to any goods falling within those classes". However, the onus is on the applicant to show that special circumstances exist, not on the Registrar to prove the contrary by showing that a deceptively similar trade mark is actually in use. In any case there is, at least prima facie, an inference that the mark MOBILITE, being registered, has in fact been used. The registration of that mark may be based on factors which are not so applicable now but, none the less, the presence of the mark MOBILITE on the register marks out an area where s 93(1) does not, prima facie, apply. Consequently, the applicant cannot claim a special circumstance to exist in relation to those goods.

Given that the applicant cannot rely on s 34 to overcome the effect of s 33, I will simply state that I find the applicant's trade mark deceptively similar to the trade mark MOBILITE. The applicant's goods, as presently specified, are indeterminate and may well include goods of the same description as the lighting fittings and apparatus of the earlier registration, 213379. I will therefore require the statement of goods of application 578657 to be specified and to exclude any goods of the same description as those covered by the conflicting registration. The applicant should propose a suitable amendment.

Other matters

The objections raised in relation to applications 567238 and 578659 involve the possibility of conflict with trade marks which either were the subject of applications which have now lapsed or are of marks that contain the element "mobile" rather than "mobil". I withdraw those citations.

There are procedural and formality matters to attend to. These were not the subject of the hearing and are not the subject of this decision.

T. Williams

Hearing Officer

31 July 1995