



TRADE MARKS ACT 1955

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

Opposition by WELLA AG to the registration of trade mark application number 587303 in the name of NEWAYS, INC,

and

Reasons for refusal of an extension of time to serve evidence in answer to the opposition

Trade mark application 587303 seeks registration of the mark as shown on page four of this document. While the application has been accepted for registration, this is opposed by Wella AG (“the opponent”).

In such a case, the regulations under the *Trade Marks Act 1955* allow an opponent an opportunity to serve on the applicant, Neways, Inc, evidence in support of its opposition. This has been done, and the solicitors for the applicant have confirmed that evidence in support was served on them on 15.12.94.

The service of that evidence triggered the opportunity for the applicant to serve its own evidence in answer to the opposition. Three months are allowed for this, but no evidence in answer has been served. As it was entitled to do in such a case, the opponent asked that the opposition be heard.

However, before the hearing commenced, the applicant lodged a statutory declaration supporting a late application to serve evidence in answer. The circumstances set out in the declaration were such that I wrote to the parties, indicating that I did not consider that there was anything in the declaration which came within the “special circumstances” provision of regulation 69 of the trade mark regulations. I put

the applicant on notice, therefore, of my intention to refuse to grant the extension unless the applicant wished to be heard in the matter. It did.

The opposition itself was still due to be heard at the appointed date and time in Canberra. I therefore advised the parties - both of whom were planning to make telephoned submissions - that I would hear the extension matter first. I put both parties on notice that, if I was able to decide this by refusing the grant of an extension, I would then go on to hear the opposition immediately thereafter.

At the hearing, the applicant was represented by Mr Bill Morrow, a senior associate of the firm of Finlaysons, solicitors. The opponent was represented by Mr Peter Marsh, patent attorney of the firm of F.B. Rice and Co.

Mr Morrow argued that the evidence which the applicant now wished to bring forward would go to the use of the trade mark. He argued that this was very relevant to my ultimate decision and that the public interest, as many decisions of this office show, argues for complete disclosure of such relevant information.

However, as Mr Marsh argued, the only hard information as to the nature of the evidence is in the statutory declaration which Mr Morrow had previously made out. While it is there asserted that the evidence is "relevant", little more is known than this. Otherwise, the applicant relies on Mr Morrow's declared belief that, because of management changes in the local and head offices of the applicant, senior management of the applicant did not appreciate the importance of lodging evidence in answer.

The applicant may believe that the evidence is relevant but, since its nature is described by Mr Morrow in only the most general terms, there is no knowing if it is likely to affect the final outcome.

The only reason for the delay in serving the evidence at its proper time was, apparently, a neglect of the matter by the applicant. When the applicant for an extension bears, as it does, the onus of showing some special circumstance to exist, the failure to be more specific about the nature of the evidence

may be fatal. In such a case as this, if the result is that the trade mark is not registered, no harm will have been done to anyone's interests except the applicant's. I should, as a general principle, have no hesitation in refusing an extension of time in such a case.

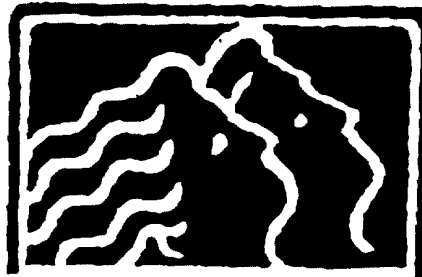
Without going into detail, the case here is very much short of the sort of the special circumstances addressed in cases decided in the light of *D'Urban v Canpio* (1990) AIPC 90-658. See, for instance, *Maconochie Seafoods v Food Marketers Pty Ltd* (1991) AIPC 90-735, or *Gordon and Rena v Barrymores* (1993) 18 IPR 71. Accordingly, I was able to decide the extension request on the day. I refused to grant the extension which the applicant sought.

That being so, Mr Marsh commenced his submissions on the opposition itself. Essentially, he relied on grounds under sections 28 and 33 of the Trade Marks Act. He relied on the established reputation of the opponent's trade mark, and on the registration of that mark for essentially the same goods as those now specified by the applicant.

The mark actually used by the opponent is very much as it is registered, under number 306328. That mark is as follows:



The opponent also has a later application, no 595004, for relevant goods, and has registered the same mark for different goods. But whatever the extent of the reputation, and whatever the goods for which the opponent has a registration, the essential point on which this opposition can be decided is this: is the opponent's mark, be it as used, or as registered under number 306328, too close to the applicant's mark. The applicant's mark is as follows:



NEWAYS

In formulating the two issues as one, I none the less note that there are many differences between the two sections. It is only paragraph (a) of s 28 that deals with a trade mark the use of which is likely to deceive or cause confusion. The rest of the section deals with a variety of other failings. The overall action of the section is itself the subject of considerable analysis - refer the *Journal* of 12.9.91. Be that so, however, one thing is quite simple. Paragraph (a) of 28 deals with marks which, if used as applied for in the light of the opponent's established reputation, would be likely to deceive or cause confusion.

Section 33 deals with deceptively similar trade marks. It is contingent on a definition in s 6(3), which specifies:

(3) For the purposes of this Act, a trade mark shall be deemed to be deceptively similar to another trade mark if it so nearly resembles that other trade mark as to be likely to deceive or cause confusion.

Therefore, the two provisions, s 33 and s 28(a) can, in the present instance, have a common hinge, the comparison of marks. This issue was addressed by both representatives.

Mr Marsh relied, in brief terms, on the principles set down at page 172 and following in Shanahan's *Australian Law of Trade Marks and Passing Off*. He addressed, in particular, the headings of

imperfect recollection and the net impression of the entirety of the two marks. He did concede that the mark of the opponent invariably includes the word WELLA. However, he noted that the word NEWAYS in the applicant's mark was quite small. He argued, additionally, that the opponents' reputation has been built up, and a registration granted, for a WELLA mark that includes a very striking emphasis on a flowing head of hair.

The opponent's evidence is relevant, in part, to the novelty of such a device. The vice president and corporate counsel of the opponent, Herr Stollreiter, a resident of Germany, is "not aware of a similarly styled device featuring a Woman in Profile with back flowing hair in Australia in connection with cosmetics and hair care preparations". I do not accept this declaration as being the definitive word on the subject, since "similarly styled device" is open to interpretation.

A second declaration, by the company secretary of the opponent's Australian subsidiary, goes a little further and is more specific. The declarant, Mr Schroder, says that he knows of other individuals or companies using devices featuring flowing hair in Australia in connection with cosmetics and hair-care preparations. However, at least as at March 1992, some two and a half years before the date of Mr Schroder's declaration, only the opponent used "a device featuring a woman in profile with back-flowing hair".

This may be true in a general sense, or quite literally true if the word "featuring" is taken to mean whatever Mr Schroder intends it to mean. But, while the opponent may contend that it has a visually striking version of such a device, for my own part, there is not all that much that is unusual about the idea of a female head, in profile, in relation to cosmetics or hair products.

Mr Morrow pointed out that to any practical purpose the two marks look very different. Both have word elements. Only one has a single head, the other has two heads, apparently of a man and a woman.

He referred to two decisions of delegates of the Registrar of Trade Marks: *PIRANHA BEACH, Meldrum v Grego* 24 IPR 201, and *WILD THING, Wilder Days v Karhugh Properties* 27 IPR 473. Mr Morrow distinguished the first of these; it was a case in which the common element was a fish which was readily identified as a piranha, a device which was prima facie distinctive on clothing. Nor, in that case, was the prior registered mark given any other word mark to identify it for verbal use. In *WILD THING*, on the other hand, the marks had been allowed to coexist despite the fact that they included the word *WILD* and the devices of big cats, two leopards on one hand and a tiger on the other.

Mr Marsh argued that those two decisions were not overly relevant to my present decision, which I should take on its own merits. That is of course true. None the less, on the obvious principles which are set out in general terms in *Shanahan* and treated briefly in *WILD THING*, the present marks do not seem to me to be able to be confused in any reasonable circumstance.

While I give reasonable weight to what the opponent's declarants have said about the rareness of a device such as the opponent's, the points of difference between the two competing marks outweigh any possibility of imperfect recollection to the extent that I am prepared to register the applicant's mark. It has discharged the onus on it to show that there is no reasonable likelihood of problems.

I therefore dismiss the opposition and direct that, subject to any appeal from this decision, the application proceed to registration. I award costs in accord with the scale to the applicant.

T. Williams
Hearing Officer
9 November 1995