



## TRADE MARKS ACT 1955

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

Re: Opposition by Imax Corporation to registration of trade mark application number 630522 in the name of Maxvision Pty Limited for the trade mark **MAXVISION** in class 41

#### **Background**

As provided for in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this opposition. Accordingly, unless otherwise specified, any reference to the Act in this decision is a reference to the *Trade Marks Act 1955*.

Application number 630522 was lodged on 24 May 1994, in the name of Maxvision Pty Limited (the applicant). The application was for the registration of the trade mark **MAXVISION** for the statement of services subsequently amended to read: "Cinema services inclusive of producing, distributing and exhibiting motion pictures and related cinema services in this class", in class 41. The trade mark was advertised as accepted in the *Australian Official Journal of Trade Marks* of 21 December 1995.

Notice of opposition to the trade mark's registration was lodged on 20 March 1996, by Imax Corporation, (the opponent). The notice of opposition listed 15 grounds but the only matters which were later pursued at the hearing were under ss.24, 28(a), (b) and (d), 33(2) and 40. It was further alleged that the applicant had not satisfied the onus on it to show that the mark was entitled to registration and that registration should be refused at the Registrar's discretion.

The service of the evidence in support, answer and reply from the respective parties was completed by 22 October 1998. The opponent requested a hearing in the matter and it came before me, as a delegate of the Registrar, in Sydney. Ms Julia Baird of

Counsel, instructed by Davies Collison Cave appeared on behalf of the opponent. The applicant was represented by Ms Joanne Martin of F.B.Rice & Co.

### **The Evidence**

The evidence in support comprises a declaration by Brian Hall and exhibits. Mr Hall, the Vice President, Marketing, Japan and Asia-Pacific, of the opponent, outlines the history, business and organisational relationships of his employer throughout many countries, including Australia, and also of its trade marks IMAX and OMNIMAX. He outlines the development and mechanics of the various IMAX and OMNIMAX motion picture systems, rides and audio systems, describes the screens and cinemas necessary for showing the projected pictures, the IMAX film library, and also the various awards won by the opponent since 1986 for its IMAX systems. He annexes, as exhibits, several advertising brochures, and various publications and photographs which give details on IMAX films and theatres. He gives a breakdown of the various IMAX theatres world-wide, the number of people who have seen an IMAX film since 1970 and the total revenue generated by the system, annexing documents relating to attendances and revenue. Mr Hall further addresses the Australian IMAX and OMNIMAX experience, lists and describes the various theatres and their history and plans for future expansion, gives details of the publicity of the IMAX systems attained through the various media, and discusses the advertising and promotion of those systems, giving details of world-wide expenditure on these items. He annexes a great number of media articles and news releases all related to the IMAX concept. Mr Hall also gives his version of the history and format of the applicant's MAXVISION cinema, which he says is of a similar nature to those operated by the opponent. He says that he is aware of several instances of confusion caused by use of the applicant's mark in relation to its cinema. He details some of his allegations of confusion and attaches exhibits which, he says, demonstrate this.

The evidence in answer comprises a declaration by Robert Whittingham, the Managing Director of the applicant. He describes the applicant's development of a giant screen complex and tourist venue, and the invention and adoption of the present trade mark MAXVISION in relation to it. He gives a number of business names in the film industry which, he says, include the part word MAX in their business names and he exhibits industry documents which list these. He says that the applicant is producing, in conjunction with the Australian Film Finance Corporation, a film

specifically for showing at the MAXVISION complex. Mr Whittingham further gives financial details of services sold under the trade mark and outlines advertising costs in relation to it. He also annexes copies of press releases regarding the applicant and its activities, together with copies of advertisements and articles where, again, the applicant and its cinema venue are featured. He does concede that there have been "many instances of confusion" between the MAXVISION and IMAX theatres but says that is not because of any similarity of the trade marks, but that they are a result of the very similar services provided by both parties.

The evidence in reply consists of a declaration by G. Mary Ruby, the Vice-President and Secretary, Legal Affairs of the opponent, who takes issue with several assertions in Mr Whittingham's declaration, particularly in relation to the applicant's screening of feature films, giving instead her understanding as to the facts. She disputes the size claimed by the applicant of its screen and also a newspaper article, which she annexes, which quotes Mr Whittingham in relation to claims about the state of large screen film venues in Australia. Ms Ruby goes on to challenge Mr Whittingham's claims regarding the widespread use of the word MAX in the industry, saying that the opponent was the only user of that word element, as a trade mark, in relation to large screen cinemas.

### **Submissions**

I will attempt to summarise here the main points made during the extensive submissions by both parties as they relate to the grounds relied upon by the opponent's counsel at the hearing.

Ms Baird said, in relation to the ground of opposition under s.33(2) of the Act, that the present mark was at least deceptively similar to trade marks owned by the opponent and that the services covered by the application were the same services as those covered by the opponent's marks, of the same description as those services, or closely related to the opponent's goods. Here, the opponent was relying upon its registrations of the words IMAX and OMNIMAX in both classes 9 and 41. She referred to the tests outlined in *Pianotist Co's App'n* (1906) 23 RPC 774, in support of her claim of deceptive similarity of the marks involved, and also to *Rysta Ltd's App'n* (1943) 60 RPC 87 regarding the concept of imperfect recollection of marks which, she said, did not have to persist up to the point of sale - *Southern Cross Refrigerating Co v*

*Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592. She said that the marks of both parties here all included the essential feature MAX, which was an allusion to MAXIMUM. She submitted that the other integers in the marks were both visually and phonetically less important, and that the idea carried away from all marks would be the same. She said that the word VISION, included in the applicant's mark, was merely descriptive of its large screen format services - also the business operated by the opponent. She said that, as such, the present mark MAXVISION must be considered deceptively similar to both of the opponent's marks IMAX and OMNIMAX. She compared the situation to those decided in the *De Cordova v Vick Chemical Co.* (1951) 68 RPC 103 and *Polo Textile Industries Pty Ltd and Anor. v Domestic Textile Corporation Pty Ltd* (1993) 26 IPR 246 cases, amongst others.

Ms Baird said that the services of the applicant and the goods and services of the opponent all were related to large screen cinemas and films, and could only be considered the same or closely related in nature. She relied here for support on such cases as *Jellinek's Appn* (1946) 63 RPC 59 and *Caterpillar Loader Hire (Holdings) Pty Ltd v Caterpillar Tractor Co* (1983) 1 IPR 265. She submitted that the evidence showed many instances of actual confusion in the market between the marks, which added weight to claims of deceptive similarity.

With regard to the s.28 ground, that the use of the mark by the applicant would be likely to lead to deception and confusion, Ms Baird said that the applicable principles were set out in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd*, supra. She said that the onus was on the applicant to satisfy the Registrar that there was no reasonable probability of confusion, yet the evidence in the case showed many instances of actual uncertainty occurring amongst the public, the media and in the industry, pointing to the words of Burchett J in *Conde Nast Publications Pty Ltd v Taylor* (1998) 41 IPR 505 at 509 regarding any confusion which had been shown to have occurred after the date of application. She said that there was even the "amazing" admission in the Whittingham declaration, forming part of the applicant's evidence, that such confusion had indeed occurred. She said that, because the applicant's cinema had not opened until after the date of application, it could not have had a separate reputation for the present mark in relation to large cinema related services. She pointed, in contrast, to the considerable reputation enjoyed by the opponent's marks, as was shown by the evidence.

Ms Baird said, in relation to the s.24 ground, that the subject trade mark was not distinctive nor was it capable of becoming distinctive of large cinema services, or of the applicant's services in particular. This was because the mark was obviously constructed from the words MAXIMUM and VISION. She said that this meant that it was descriptive of the large vision aspect of the services and that it was also non-distinctive of the applicant's services because it was one which other traders would legitimately desire to use to describe their own similar services. She said that, even if such an objection had not been taken during examination, this was not enough to overcome such a ground during opposition proceedings.

On the s.40 ground, Ms Baird said that the applicant could not be the proprietor of the trade mark for all of the services, as the evidence showed that it did not use or intend to use it in relation to one part of the present statement of services - "distributing motion pictures".

Ms Baird said that the applicant bore the onus of showing that the mark qualified for registration. She said that it had failed to do this because it had adopted the mark in full knowledge of the opponent's marks and its cinemas - as shown in the evidence - and she said that the Registrar's discretion should be exercised to refuse registration of the mark.

She closed by seeking an award of costs in favour of the opponent.

In her submissions in reply, Ms Martin said that there was no evidence to support the opponent's contention that the applicant did not own the trade mark for all of the services applied for - including the distribution of films. She said that there was a limited market in Australia for that particular service and there was nothing to say that the applicant did not intend to distribute films at some time in the future. She said that the opponent's and applicant's marks here were not substantially identical and that, according to the tests outlined in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd*, (1961) 109 CLR 407, neither the opponent, nor anyone other than the applicant, could claim to be the proprietor of the mark MAXVISION.

She said that the applied for mark and the opponent's registered marks were neither substantially identical nor deceptively similar. With respect to claims of deceptive similarity, she said that the net impression and meanings of the marks here were different - despite the common element MAX. She said that the first syllables I- and OMNI- in the words IMAX and OMNIMAX were important in differentiating those marks from the present word MAXVISION, where the word MAX formed the beginning of the mark. She relied on the comparison of marks in such precedent cases as *Coldstream Refrigerators Ltd v Aircraft Pty Ltd* (1950) 20 AOJP 1491 and *Dial an Angel v Sagitaur Services* 19 IPR 171 to support her submissions. She said that there were many marks in Class 9 which contained the word element MAX and which coexisted on the Register. This word, she submitted, had a meaning and referred to something being large. As such, she said, the other elements included in the marks should be considered as being important in any comparison. She pointed here to such cases as *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd* (1952) 86 CLR 536 to illustrate her point. She said that the marks in conflict here did not even appear to be related and that the two marks owned by the opponent similarly did not seem to belong to a "family" of marks.

In relation to whether use of the applied for trade mark would lead to deception and confusion because of the opponent's reputation in its own marks, Ms Martin said that the opponent's evidence showed that it used the word IMAX, in relation to its services, at Dreamworld in Queensland since 1980 and the word OMNI (and not OMNIMAX) since 1987 in Townsville and Perth. She said that this meant that there might be some reputation for the word IMAX, in relation to large screen cinemas in Australia, but it was unclear whether any reputation, as at the date of lodgment, resided in the word OMNIMAX. She said that much of the opponent's evidence, in relation to reputation for its marks, post-dated the critical date of application and was not relevant here. In any event, she said, she had already argued that the respective marks were not even deceptively similar. She said that, if I found that any reputation existed for the opponent's marks, then such a reputation would assist in precluding confusion - especially in relation to the concept of "imperfect recollection". She relied for support here upon the decisions in such cases as *Chanel Ltd v Chantal Chemical & Pharmaceutical Corporation* 19 IPR 108. She said that, although the opponent's evidence claimed that some journalists might have been confused in referring to the subject mark, these people were not experts in relation to wide screen

cinema. She said that, accordingly, I should give no weight to any examples of confusion pointed to in the evidence.

In relation to the opponent's allegation that the mark was not distinctive nor was capable of becoming so, Ms Martin said that no evidence had been lodged to support such a claim and that, in any case, the examiner had already found that the mark was distinctive during examination. She said that a combination of two ordinary words, or parts of words, could form a distinctive mark, and that is what had been done here.

She concluded her submissions by seeking an award of costs in the matter in favour of the applicant.

### **Discussion**

In giving the reasons for my decision in this opposition matter, I will only deal with the grounds pursued by Ms Baird at the hearing - those under ss.24, 28, 33 and 40 - which I believe should be considered in coming to a decision here.

#### ***Section 24 - Distinctiveness***

Section 24 (1) reads:

**24. (1)** A trade mark is registrable in Part A of the Register if it contains or consists of:

- (a) the name of a person represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word;
- (d) a word not having direct reference to the character or quality of the goods or services in respect of which registration is sought and not being, according to its ordinary meaning, a geographical name or a surname; or
- (e) any other distinctive mark.

The basic requirement for the registration of any trade mark in Part A is that it is distinctive, i.e. adapted to distinguish the goods of its owner from the similar goods of other traders. The test as to whether or not a mark is adapted to distinguish is well established. If the mark is one which other traders would desire to use, without improper motive, upon or in connection with their own services or closely related goods, then registration will generally be denied - *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511.

Ms Baird submitted for the opponent that the derivation of the mark MAXVISION is obvious and that the word directly refers to large screen cinemas and related services. I do agree that the prefix MAX and the word VISION might be inferred to separately have some reference to the services sought here. However, they are not the only words which could be used to describe the services here and I think that, when they are put together to form a trade mark, there is a degree of invention inherent, despite having some reference to the services involved. Such an allusion need not be fatal to the applicant's case because a trade mark need not be absolutely unsuggestive - *Burroughs Wellcome & Co's Trade Mark* (1904) 21 RPC 217 - the TABLOID case. I also think that it does take some degree of mental exercise to arrive at the conclusion that their conjunction has a meaning. It would seem to me that, if another provider of such services required to use that combination as trade mark, then their motives could well be suspect.

I therefore find that the opposition is unsuccessful on this ground.

*Section 33 - Substantially identical or deceptively similar*

Sub-section 33 (2) of the Act reads:

(2) Subject to this Act, a trade mark is not capable of registration by a person in respect of services if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same services, of services of the same description as those services, or of goods that are closely related to those services, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

The opponent does have several registered trade marks which include the word element MAX and which pre-date the present application.

These are:

For the mark IMAX

262994(9), for "Developed motion films; motion picture projectors; cameras; optical printers and film editing machines; motion picture screens; and parts of and fittings for the aforementioned products" and

442224(41), for "Displaying motion picture films and the operation of motion picture theatres for exhibition of films".

For the mark OMNIMAX

269244(9), for "Developed motion picture films, motion picture projectors, cameras, optical printers included in this class and film editing machines, and motion picture screens" and

442225(41), for "Displaying motion picture films and the operation of motion picture theatres for exhibition of films".

Ms Baird, at the hearing, conceded that the marks of the respective parties were not substantially identical but strongly asserted that they were deceptively similar. Sub-section 6(3) defines a mark as deceptively similar if it is likely to deceive or cause confusion. Here, the marks should not be placed side by side but consideration should be given to any common net impression inferred from the two marks. I refer here to the judgment in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641, where Justices Dixon and McTiernan said:

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 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, their 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. Evidence of actual cases of deception, if forthcoming, is of great weight.

Here, the situation relies upon the so-called "imperfect recollection" of the marks in the market place, as discussed in cases such as *Rysta Ltd's App'n*, supra, and referred to by Ms Baird. I believe it is the case here that the word element MAX is the most memorable portion of the opponent's trade marks IMAX and OMNIMAX. In the former mark, there is only the addition of the letter "I" and in the latter, the prefix OMNI- can mean "all" or "everything".

As I have said, the present mark MAXVISION comprises a fusion of the words MAX and VISION. I am of the opinion that the prefix MAX- is also the most memorable part of that mark, the word element -VISION being able to be largely discounted given its direct reference to the perception of the medium of cinema. Accordingly, I believe that the portion of all of the marks owned by the respective parties which would be carried away, especially by those who attend large screen cinemas or use related goods, is the word element MAX. To reinforce this conclusion, I observe that the evidence shows that there have been numerous instances of confusion between the respective marks which, as Justices Dixon and McTiernan said in the *Australian Woollen Mills Ltd* case, supra, is of "great weight" in determining the matter. I therefore conclude that the respective marks here are deceptively similar.

The second leg under this ground is whether the services here are of the same description as the opponent's services, or are closely related to the opponent's goods, which are covered by its marks. The present statement of services covers, broadly, cinema services, while the opponent's services are the display of films and the operation of cinemas. To my mind, all of these services are clearly of the same description. Similarly, the opponent's goods include film, projectors, cameras and the like, which are used in relation to the present services. I believe that these must, accordingly, be considered as being closely related to the services sought to be covered by the present application.

Having had regard to all of the above, I can only find that this ground of opposition under s.33 must be successful.

### ***Section 28 - Deception and confusion***

The provisions of this section of the Act read as follows:

**28.** A mark:

- (a) the use of which would be likely to deceive or cause confusion;
- (b) the use of which would be contrary to law;
- (c) which comprises or contains scandalous matter; or
- (d) which would otherwise be not entitled to protection in a court of justice, shall not be registered as a trade mark.

The test to be applied under paragraph (a) of these provisions, on which the opponent partly relies, has been well established by cases such as *Southern Cross Refrigerating Co*, supra, where it was said, at 608:

Registration should be refused if it appears that there is a real risk that the result of the user of the mark will be that a number of persons will be caused to wonder whether it might not be the case the two products come from the same source.

I have said, in relation to the s.33 ground, that I consider that the opponent's marks IMAX and OMNIMAX are deceptively similar to the presently applied for trade mark MAXVISION, especially when considered in relation to large cinema services. As Ms Baird said, such cases as *De Cordova*, supra, and also *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147, show that, if the later mark incorporates the essential or distinguishing feature of the earlier mark, then confusion might well result. However, that confusion must extend to a substantial number of people likely to be concerned in the purchasing of the goods: *Kendall Co v Mulsyn Paint and Chemicals* (1963) 109 CLR 300.

In assessing the reputation of the opponents' mark in Australia, the relevant date is the date of lodgment of the opposed application, 24 May 1994 - *Southern Cross*, supra. The opponent's reputation at that date in this country, with respect to its own marks and services, is shown in the opponent's evidence. From that material, it would appear that the opponent had established, at the appropriate date, a significant reputation in this country for its IMAX trade mark, although the situation regarding the OMNIMAX mark before 1994 is not as clear. I agree with Ms Martin where she said that some of the evidence relating to the IMAX theatre at Darling Harbour is not relevant, because it refers to the period post lodgment. However, there were three cinemas using the IMAX system operating in Australia prior to May 1994 and I am satisfied, from the evidence, that most people using the opponent's services and goods would have been aware of that trade mark in relation to them. Additionally, the combination of the long lead up to the construction of the Darling Harbour theatre and the consequent publicity generated by the project, the presence of the theatres on the Gold Coast, in Townsville and in Perth, and the discussion of the concept in the Australian media would have meant that there was a reasonably high public awareness of the IMAX concept. Accordingly, I think that it would be fair to say that

most people who would have known about the services of large screen cinemas at that time would have also been well aware of the IMAX trade mark.

Despite Ms Martin's arguments to the contrary, I find that the instances of confusion amongst journalists in relation to the IMAX concept and the MAXVISION cinema, as revealed by the evidence, is significant. The evidence reveals a substantial amount of misuse of the opponent's trade mark in the reporting of the opening of the applicant's Katoomba cinema. I agree with Ms Baird that evidence of events after the application date may be taken into account in determining whether there might have been deception and confusion at an earlier time - see the words of Burchett J in *Conde Nast Publications Pty Ltd*, supra, 509. Even the applicant's declarant, Mr Whittingham, admits to knowledge of "...many instances of confusion..." between the respective marks. I do not think that, as Ms Martin has submitted, it is commonplace for journalists to misuse or confuse trade marks, although I do concede that there is sometimes some misunderstanding amongst them in relation to the difference between trade marks and business names. However, given the degree of confusion about the present situation amongst this profession, usually cognisant of the need to check the facts before going to print, I would think that the general cinema going public could be even more confused with respect to the respective trade marks. It is they who are the consumers of both parties' services, not experts who might be conversant with slight differences in the technologies. I think that it is highly possible that members of the public, who know of the opponent's IMAX system and theatres in Australia and overseas, could make the incorrect assumption that the MAXVISION big screen cinema in Katoomba is another IMAX or OMNIMAX cinema slightly re-badged for the Blue Mountains location. Given all of this, I find that the requirements of paragraph 28(a) have been made out in respect of both of the opponent's marks.

It was previously the practice of the Registrar to require that blameworthy conduct be shown, in addition to the likelihood of deception and confusion, for an opposition based upon s.28 to be successful. This followed the High Court decision in *New*

*South Wales Dairy Corp v Murray Goulbourn Co- operative Co Ltd* 18 IPR 385 (the Moo/Moove case) and the interpretation of that case, as laid out in the decision of Hearing Officer Homann in *Titan Manufacturing Co v John Terrence Coyne* 22 IPR 613, which inferred from the High Court decision, that a conjunctive reading of s.28 was necessary. However, a decision of the Full Federal Court, on appeal, in the case of *Nettlefold Advertising Pty Ltd v Nettlefold Signs Pty Ltd* (1999) AIPC 91-455 has since issued. There, the Full Court said that a disjunctive reading of s.28 was the correct approach when deciding oppositions to registration. Therefore, conduct which is deemed to be "blameworthy" need not now be shown for success under the whole of s.28.

Although Ms Baird did make some submissions at the hearing alleging such behaviour by the applicant, I think that, in the light of the *Nettlefold* decision, there is no need for me to make a finding in this regard in relation to the present case. However, I will add here that there does not appear to be anything in the evidence, or which stems from Ms Baird's submissions, that would indicate to me that the applicant has been engaged in any wrong-doing in relation to this trade mark.

Given the effect of the foregoing, I find that the opponent has been, overall, successful on the s28 opposition ground.

#### ***Section 40 - Proprietorship***

Section 40(1) reads:

**40. (1)** A person who claims to be the proprietor of a trade mark may make application to the Registrar for registration of that trade mark in Part A or Part B of the Register.

On that subject, McGarvie J. said in the case of *Settef S.p.A. v Riv-Oland Marble Co (Vic) Pty Ltd* 10 IPR 402:

The basic common law principle is that the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark there: *Re Registered Trade Mark YANX*; *Ex parte Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at 203; *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at 603; *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* 59 ALJR 77 at 83.

...

In considering who, within s.40(1) of the Act, was at the time of Settef's application for registration the proprietor of the trade mark, one considers who at common law was the proprietor in Australia: *The Shell Co of Australia Ltd v Rohm & Haas* (1949) 78 CLR 601 at 625 and 627.

In other words, the first user of the mark in Australia - for the relevant services and prior to the date of application - becomes the proprietor at common law. That proprietorship, however, is limited to "the same kind of thing", as per Holroyd J. in *Hick's Trade Mark* (1897) 22 VLR 636. Any small amount of use will suffice, but the effect of the act relied on to constitute use must be the creation, in the minds of those concerned, of an impression that the services of a particular trader are being offered for sale in Australia. This has been affirmed in later cases such as in *Seven Up Co v O.T. Ltd* (1947) 75 CLR 203.

I believe, in deciding the issue of proprietorship, that s.40 only applies when the marks are identical or so similar as to be virtually the same mark - *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994)AIPC 91-049 and *Karu Pty Ltd v Jose* ( 1994) AIPC 91-101. It is obvious that the marks owned by the respective parties here are not the same, although I have found that they are deceptively similar. Additionally, there is no evidence to support a claim that the applicant was not the first user of its mark MAXVISION in this country on all of the services covered by the application and is therefore not the proprietor of the mark in Australia for those services.

Given the foregoing, I find that the opponent is not successful on the s.40 ground.

### ***The Registrar's discretion***

The opponent has raised certain arguments and provided evidence, as previously outlined in this decision, to support its allegations that the applied for mark is deceptively similar to its own prior registered marks, and that deception and confusion could and has ensued from its use given the opponent's reputation in its own marks on the same or similar services and goods. This is enough in my opinion, to shift the onus, under the *Trade Marks Act 1955*, to the applicant to demonstrate that that it is entitled to register its trade mark. The applicant has argued against all of the grounds relied upon by the opponent at the hearing. However, despite this it has not done enough, in my opinion to overcome the onus upon it particularly in relation to ss.28

and 33. I therefore can see no reason to exercise the Registrar's discretion in favour of allowing the application to proceed to registration.

**Conclusion**

I have found that the opponent has succeeded in its grounds of opposition under ss.28 and 33, but has failed to be successful under ss.24 and 40. I have also found that there is no reason shown to me for a favourable exercise of the Registrar's discretion in the applicant's favour. It follows then that the opposition as a whole has been successful. Therefore, subject to any appeal from this decision, I refuse to register the trade mark, the subject of this application.

**Costs**

I can see no reason why costs should not follow the event here and, accordingly, I order that the applicant should pay the costs of the opponent.

Ian Forno  
Hearing Officer

18 January 2000