



## TRADE MARKS ACT 1995

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

Re: Opposition by ISUZU-GENERAL MOTORS AUSTRALIA LIMITED  
to registration of trade mark application number 644230 in the name of  
JACKEROO WORLD PTY LTD

#### Background

On 27 October 1994, Belholme Pty Ltd filed an application number 644230 to register a trade mark. Subsequently the mark was assigned to Jackeroo World Pty Ltd (the applicant), and the recordal of the assignment in the Trade Marks Office was effected accordingly. The applicant sought registration of the mark:



The mark was accepted for registration in respect of "4 wheel drive motor vehicle parts and accessories in the class, excluding caravans and parts of caravans", which goods belong in class 12. Following the advertising of acceptance of the mark in the *Australian Official Journal of Trade Marks* of 31 October 1996, a notice of opposition was filed on 31 January 1997 by Isuzu-General Motors Australia Limited (the opponent). Of the thirteen grounds of opposition, at the hearing, the opponent primarily focussed on the grounds in terms of subsection 41(2), that a trade mark must

be rejected for registration if it is not capable of distinguishing the applicant's goods or services; and on the section 60 ground, that the opposed mark was likely to deceive or cause confusion, given the reputation established by the opponent's mark.

### **Evidence**

It will be convenient here to summarise the opponent's and applicant's evidence only as it relates to the grounds of opposition upon which the opponent relied during the hearing.

As evidence in support, the opponent has filed two statutory declarations. The first is by Ralph Keith Johnston, director of Arkajon Communications Pty Ltd, who has been engaged by the opponent to undertake enquiries regarding use of the opponent's trade mark JACKAROO and the mark of the present application. To achieve this aim, his company had distributed questionnaires to persons in the motor vehicle trade whose employment involves the ordering and purchase of vehicle parts and accessories for a range of vehicle manufacturers. He exhibits the returned questionnaires and provides a short analysis of the participants' responses to the questions.

The second declarant, George Beattie, director of marketing of the opponent company, sets out the history of the opponent's mark JACKAROO, first use of which occurred in Australia in 1981 by General Motors-Holden Limited, and proceeds to outline the history of the opponent company. He says that since the sale of the first JACKAROO vehicle, replacement parts and accessories for every part of the vehicle, as well as a wide range of motor vehicle parts and accessories, have been available for sale in Australia. Use of the mark JACKAROO, in respect of the vehicle parts and accessories, is illustrated in copies of the exhibited brochures and other material. The declarant lists the annual number of vehicles sold in Australia, together with their sales value. He also provides the sales figures for parts and accessories. To show how the trade mark JACKAROO is promoted, the declarant attaches to his declaration various samples of advertising and sets out figures on the advertising expenses.

Expressing his opinion on the likelihood of confusion arising between the opponent's and applicant's marks, Mr Beattie stresses the telephone order services which, he says, are utilized both by the applicant's and the opponent's customers. He claims that the

applicant reconditions and offers for sale original JACKAROO parts, which practice is a major concern to the opponent, as the purchaser may wrongly believe that those parts are covered by a guarantee or warranty from the opponent of the Holden dealer network, but does not support his statement by any evidence. Noting the minor difference in the spelling between the word "Jackeroo" in the applicant's mark and the opponent's mark JACKAROO, he attaches to his declaration a copy of an article where the opponent's mark has been identified as JACKEROO. One of the exhibits to his declaration was withdrawn following some complexities concerning its contents.

The evidence in answer comprises a statutory declaration, with exhibits, by Robert Buck, managing director and shareholder of the applicant company. The applicant has been engaged in a number of activities, including the provision of services in relation to second-hand and reconditioned parts, as well as new parts and accessories for four wheel drive motor vehicles. As far as the present application is concerned, the applicant manufactures new spare parts to fit four wheel drive vehicles which include the "Isuzu UBS" and are sold under the present mark. The declarant says that the applicant's policy is to offer consumers of four wheel drive vehicles a choice between "genuine" and "non-genuine" parts and accessories, thus a choice between price and quality of those goods.

Mr Buck says that, in contrast to the massive visual and auditory advertising aimed at large sections of the population, undertaken by the opponent, the applicant advertises its goods to a small specific section of the population. This is achieved by direct distribution of pamphlets, and by word of mouth by members of the various arms of the motor trade, four wheel vehicle owners, clubs of such owners and specialist magazines. The applicant's mark is also displayed on stationery, sales pamphlets, premises and customer newsletters, Mr Buck says. Samples of some advertising material are annexed to Mr Buck's declaration.

Mr Buck points to what he considers to be the marked differences between the external appearance of the applicant's only premises in Victoria and the premises occupied by the opponent's dealers who are required to meet certain prescribed standards of uniform external presentation, including the installation of specially designed exterior signs, lion logos and corporate colours. He exhibits photographs to

illustrate his statement. With reference to a photograph of the interior of the applicant's sales area, Mr Buck says that it is clear that the applicant is not passing itself off as a Holden dealer, but, instead, offers consumers a broader range of choice of parts and accessories than a Holden dealer by being fiercely independent and unaligned with any major manufacturer.

In rebutting the opponent's evidence, Mr Buck states further that, to his knowledge, the mark JACKAROO is not affixed to the parts, or displayed on packages manufactured by the opponent, because the parts are manufactured for vehicles sold in many countries under different national brand names. He says the parts are distributed internationally, unmarked or usually marked with the ISUZU brand, and, in Australia, the parts are packaged under a HOLDEN label. In this respect, a number of exhibits of packaging and pages of catalogues are attached to his declaration. In an attempt to prove his point further, he refers to other copies of catalogues which, he says, show commonality of certain parts between the JACKAROO and RODEO brand cars. He says that the parts may be fitted to different vehicles and become, for example, a JACKAROO part only when the part is fitted to a JACKAROO vehicle. Mr Buck believes it is not possible to identify accurate figures which represent value of sales under the JACKAROO trade mark, as Mr Beattie has done in his declaration. He expresses the view that the reputation claimed by the opponent is, in fact, a reputation in respect of the ISUZU or HOLDEN brand parts, not parts bearing a JACKAROO trade mark, and therefore, the alleged deception or confusion between the opponent's and applicant's marks is unlikely.

In relation to the questionnaires annexed to Mr Johnston's declaration, having considered the survey evidence in some detail, Mr Buck concludes that it is substantially flawed in design and execution and fails to demonstrate any deceptive similarity between the marks.

The evidence in reply comprises statutory declarations executed by George Beattie and Ralph Keith Johnston, the same declarants whose declarations are included in evidence in support. The purpose of both these declarations is to rebut some of Mr Buck's statements. In particular, Mr Beattie points out that, even if a mark is not applied to the goods, it is regarded as proper use of the mark. Further, he says that,

although a single spare part sold by the opponent may suit one or more different vehicles, the purchasers seeking a new or replacement spare part for a JACKAROO vehicle will request either a JACKAROO part, or a HOLDEN JACKAROO part.

The opponent also filed further evidence - a third declaration, with exhibits, by Mr Beattie. This declaration is to serve as an explanation of evidence filed originally with Mr Beattie's first declaration, included in the evidence in support, which had caused some complications to the applicant in reading the information contained in one of the exhibits. With reference to the annexed exhibits, Mr Beattie explains the system of the parts catalogue and how the various parts are identified.

The applicant applied, and was permitted to serve, further evidence in reply: a statutory declaration by Colin Andrew Sharp, with exhibits, and a second declaration by Mr Buck. Mr Sharp is the managing director of P.E.R.S.O.N.A.L., a company operating in management research and performance evaluation consultancy, with expertise in survey research and questionnaire design. He also holds the position of Associate Professor of Management at Flinders University in South Australia. In response to the applicant's request, he has examined the questionnaires annexed to Mr Johnston's first declaration. After setting out a detailed analysis of the questionnaires, he concludes that the questionnaires are not a useful basis from which to take inferences about confusion of marks in the marketplace, as questionnaires and their interpretation are themselves highly confusing. Nevertheless, he says, the responses do not show the expected 50% incorrect choice of the products bearing the marks.

The purpose of Mr Buck's declaration is to demonstrate his qualifications in commenting on the questionnaires. This was in response to Mr Johnston's claim as to the absence of any indication that Mr Buck was qualified in that area.

The hearing on the opposition was held in Melbourne on 4 February 1999. The opponent was represented by Mr Ken Hamilton of Phillips Ormonde & Fitzpatrick, patent and trade mark attorneys of Melbourne. Mr Buck, the managing director of the applicant company, appeared on behalf of the applicant.

### **Opponent's submissions**

Mr Hamilton introduced the two grounds of opposition based on subsection 41(2) and section 60, adding that the opponent proposed to concentrate mainly on the latter ground of opposition. On outlining the legal principles relevant to section 60, he commenced his submissions on the question of prior reputation of the opponent's mark, saying that it was clear from Mr Beattie's declaration in the evidence in support that the mark JACKAROO had been used extensively in Australia. It was uncertain from the applicant's evidence what the date of first use of the applicant's mark was, although he noted Mr Buck's statement that the applicant had provided a range of services since the date of its incorporation. He reminded me that the filing date of the opposed application would therefore be after this date.

Relying on the tests of comparing competing marks, as set out in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407, Mr Hamilton believed the marks to be substantially identical. He stressed the importance of the net impression of the marks as per *Clark v Sharp* (1898) 15 RPC 141, and the fact that most people do not have a perfect recollection of what they see. He said that the back of the car in the applicant's mark had an uncanny resemblance to the opponent's JACKAROO vehicle which, given the word "Jackaroo" in the mark, suggested double emphasis. In considering the idea of the mark in terms of *Jafferjee v Scarlett* 57 CLR 115, Mr Hamilton submitted that, although the word "Jackaroo" did not have a reference to any particular goods, a reputation in that word had been established for four wheel drive cars. Therefore, one would wonder whether the words JACKAROO WORLD in the applicant's mark were to be associated with objects used by a person jackaroo, or something relating to JACKAROO cars. To support his further contention of a possible perception that the goods under the respective marks were related, Mr Hamilton referred, in particular, to *Seven-Up Co v Bubble Up Co Inc* (1987) 9 IPR 259, where, he said, it was held that the presence of the word "Up" in the marks was likely to lead persons to the belief that the products of the marks had some relationship.

Mr Hamilton discussed the importance of considering how the respective marks would be identified in telephone orders, as both the applicant and the opponent employed this means of communication. He then posed the question as to whether

the addition of the word "World" to "Jackeroo" in the applicant's mark resulted in inventing a new trade mark, which distinguished it from the mark JACKAROO. To answer this question, he said it was necessary to consider the JACKEROO WORLD mark in the context of other "World" marks, for example, the logical association of the word "Sega" with "Sega World", or "Disney" with "Disney World". On this basis, the opposed mark created an impression that the goods or services provided under this trade mark were somehow endorsed by, or related to, the owner of the mark JACKAROO.

Concerning Mr Buck's statement in his first statutory declaration, supported by reference to three cases - *Tecmo Kabushiki Kaisha v Tokyo Denki Kabushiki Kaisha (t/a Tokyo Electric Co Ltd)* (1995) AIPC 91-177, *Hypertec Pty Ltd v Kabushiki Kaisha Tec (also t/a Tec Corporation)* (1996) AIPC 91-245 and *Cooper Engineering Company Pty Ltd v Sigmund Pumps Ltd* (1952-1953) 86 CLR 536 - that the incorporation of one owner's mark in another person's mark did not render those marks substantially identical or deceptively similar - Mr Hamilton submitted that, in the cases cited, special circumstances had been established to allow concurrent registration of the marks.

Referring to questionnaires in the opponent's evidence, Mr Hamilton said that this evidence had been provided, despite the onus being on the applicant to prove no likelihood of deception or confusion or the marks occurring. He had noted the applicant's queries concerning the statistical significance of that evidence, but wished to point out that, even though the majority of cases in this area suggested that that form of evidence was not admissible, it was relevant to direct to my attention the confusion of the marks amongst a number of persons in the trade.

Mr Hamilton requested that costs follow the decision.

### **Applicant's submissions**

Although Mr Buck covered all the grounds stated in the notice of opposition, I will extract and outline here his submissions only as they related to Mr Hamilton's primary submissions.

In making some preliminary comments, Mr Buck said the opponent was apparently arguing that it possessed rights in the common law trade mark JACKAROO in respect of class 12 goods. However, the fact that two applications had been filed for the same mark, one by General Motors Corporation of the United States of America and the other by the present opponent, showed that the General Motors group of companies had doubts as to whether the opponent possessed such a mark. He said that the goods under JACKAROO mark were sold by dealers franchised by Holden Limited, not by the opponent and were known as HOLDEN JACKAROO. Further, the opponent had failed to provide any evidence that the opponent applied the trade mark to, or in relation to, the parts and accessories of the vehicles and that the applicant's exhibits confirmed this. Displaying the mark in the form of literature, which were *aides-de-memoire* and not catalogues in the sense of department store catalogues, did not show use of the mark in the trading process, he said. Moreover, the parts and accessories in question were identified only by a part number, which was common to other vehicles sold by the opponent, as indicated in the applicant's evidence. Thus, an owner of a HOLDEN RODEO, for example, buying a genuine part for a RODEO vehicle would end up with an identical part in the same packaging, and bearing the same number, as an owner seeking the part for a JACKAROO vehicle. In his declaration, Mr Beattie had stated that purchasers were seeking a new or replacement spare part for a JACKAROO vehicle, but this did not indicate reference to a part of the vehicle bearing the mark JACKAROO. For these reasons, Mr Buck said, the opponent could not claim the mark JACKAROO distinguished the parts and accessories. Such use contrasted with use of the subject mark in relation to the goods in a manner whereby the purchasers clearly recognised the goods to be those of the applicant.

With reference to *Shell v Esso*, supra, in submitting that the marks under consideration were neither substantially identical nor deceptively similar, Buck said that there were thirty points of dissimilarity between the marks, which he had noted in his declaration, filed as evidence in answer. Further, the applicant's mark was a complex graphic design, whereas the opponent's mark consisted of a single ordinary English word, and that word did not appear anywhere in the applicant's mark. Contrary to the opponent's contention, Mr Buck submitted that, even if the word "Jackeroo" had been included in the applicant's mark, that factor in itself did not

render the mark substantially identical, as had been found in the cases cited in this regard by Mr Hamilton.

As far as an impression left in a person's mind of the applicant's mark was concerned, Mr Buck argued that it told a story by a combination of depicting an Australian journey through the outback world of a jackaroo/jackeroo with action and movement, as well as light and shade. He said that it was the applicant's experience that the customers tended to remember the outback scene represented in the applicant's mark. Moreover, even a common idea expressed by the respective marks did not mean the marks would be likely to lead to confusion, as per *Cooper Engineering v Sigmund Pumps*, supra. It was also important to take into account that the potential customers would be reasonable and sensible people. As to the telephone purchases, that was not a major factor, because only a small proportion of sales were conducted on the telephone - sales on the Internet being used in preference.

Mr Buck referred to the conclusion reached by Professor Sharp, that the survey evidence presented by the opponent did not prove the likelihood of deception or confusion by use of the applicant's mark. The replacement parts and accessories for the HOLDEN JACKAROO vehicles were expensive, he said, and therefore purchasers would exercise a high degree of care; those goods did not belong to the bag of sweets or ice cream category, but fell within the \$300 to \$400 price range. The very significant difference in price for the same part number, i.e. between the prices of the Holden dealers for genuine parts for JACKAROO vehicles and those charged by the applicant, indicated a further reason for not confusing the marks. Moreover, persons servicing their own cars would have no difficulty in recognizing the differences between the products. The mechanics in the motor vehicle business, Mr Buck stressed, were constantly making decisions for customers on whether to use genuine or non-genuine parts and would not confuse them. It was ultimately the difference in the price of the parts that would decide the matter.

In conclusion, Mr Buck submitted that I should bear in mind the fact that the applicant was a very small organisation, that had merely sought to apply for registration of its mark. If the applicant were required to pay heavy costs caused by legal proceedings to a foreign company in the event of it being unsuccessful in the present proceedings,

it would be unreasonable to suffer such costs simply as a consequence of filing an application. Such practice would be responsible for a strong disincentive to Australian owners of marks to apply for registration of their marks.

### **Discussion**

*Section 60 - trade mark similar to another trade mark that has acquired a reputation in Australia*

This section reads as follows:

- 60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:
- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
  - (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

In section 10, a deceptively similar trade mark to another mark is defined as one which so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

In terms of this section, it needs to be determined first whether the applicant's mark is substantially identical or deceptively similar to a mark, whether it is a registered mark or is not registered, that is claimed to have acquired such a degree of reputation in Australia before the respective applicant filed the application to register its mark, that use of the applicant's mark, in a fair and reasonable manner, would be likely to deceive or confuse a substantial number of the prospective customers - *Smith Hayden's Application* (1946) 63 RPC 97 and *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Limited* (1954) 91 CLR 592. The considerations as to whether a mark is substantially identical or deceptively similar are based on case law principles and common sense.

In *Shell v Esso*, supra, Windeyer J has set down the now well-known directives in relation to the criteria on substantial identity of trade marks, as recognized by both parties in the present proceedings. At p 414, his Honour states:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

The applicant's mark is composed of a number of elements, which include words and devices, whereas the opponent's allegedly conflicting mark simply comprises one word JACKAROO. Looking at the marks, as suggested by Windeyer J, the only close common element in the marks is present in the interchangeable word "Jackaroo/Jackeroo", otherwise the total impression created by the marks bears no resemblance. Accordingly, the marks should not be regarded as substantially identical.

To consider further the question of deceptive similarity, I turn to the guidelines enunciated in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641, at 658:

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.

While I must consider the respective marks in their entirety, as I was reminded by Mr Hamilton, having regard to the above criteria, the determinant factor of this matter will depend upon what impact the marks are likely to leave in the minds of persons interested in the goods offered for sale by both the applicant and the opponent in circumstances where the marks are not available for close inspection for comparison. In this process, it will be necessary to look at the appearance of the marks, any

meaning the marks might convey, the way they may be identified aurally and the type of customers dealing with the goods.

Both Mr Hamilton and Mr Buck have relied on the relevant case law in discussing the factors to be considered when comparing trade marks. I now propose to make an independent assessment which may, in some instances, cover the same or similar ground made in the submissions.

The fact that the additional elements to the word "Jackeroo" in the applicant's mark render the mark quite different from the opponent's mark, when consideration is given to the visual aspect, is indisputable. However, the dissimilarities between the marks are diminished when other factors are taken into account. It has been said in, *Rysta Ltd's Appn* (1943) 60 RPC 87, at 108, that persons who are familiar with one trade mark, but who only vaguely remember the particulars of the other mark, could potentially be deceived or confuse the marks. If an essential feature of an earlier mark, or a mark purported to have a reputation, has been incorporated in the applicant's mark, in the present case this feature being the word "Jackeroo", which conveys the same meaning as "Jackaroo", this could also give rise to confusion, as considered in *de Cordova v Vick Chemical Co* (1951) 68 RPC 103. In that case, Lord Radcliffe observed, at 106:

... in most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole.

Essentially the applicant's mark comprises the words JACKEROO WORLD and a prominent rear representation of what is obviously a four wheel drive vehicle, all enclosed in a circle. The persons familiar with the opponent's vehicles bearing the mark JACKAROO are likely to see the presence of a vehicle in the mark as merely a graphic representation of a JACKAROO four wheel drive. Considered in that context, the idea or general impression formed by the marks and carried away by consumers would be the same or similar - *Jafferjee v Scarlett*, supra. This observation leads me to consideration of a further relevant factor, based on the assumption that the words JACKAROO WORLD in the subject mark could be taken to indicate related goods produced by the same manufacturer, or suggest a connection with the opponent, as held in *John Lysaght Ltd v Reid Bros and Russell Pty Ltd* [1907] VLR 432, where

the new mark consisting of the word EMPIRE with a globe device was held to be deceptively similar to the word GLOBE, also with a globe device, because it might be believed that the goods shared the same origin. This principle has been applied, in relation to trade marks, in a number of subsequent decisions. In the present case, the words JACKEROO WORLD in the opposed mark are likely to imply a connection with the opponent, by indicating an extension of a range of goods originally sold under the mark JACKAROO. It should be noted, however, that in light of the findings in *Tecmo v Tokyo Denki*, supra, I am not prepared to accept that it would be sufficient for the applicant's mark to be considered as substantially identical or deceptively similar simply because the opponent's mark in its entirety has been enclosed in the opposed mark.

On occasions when the goods are ordered by telephone, the person ordering the goods would not be relying on any description of the visual graphic details in the mark, but would select the words as a tool for identifying the marks, in the present case being the word JACKAROO or the words JACKEROO WORLD, "Jackaroo", of course, being phonetically equivalent to "Jackaroo". Here I find support in *Golden Crumpet Co Australasia v Harding Manufacturers Pty Ltd* (1987) 8 IPR 147. Further, although possibly not a major consideration here, in *London Lubricants (1920) Ltd's Appn* (1925) 42 RPC 264, at 279, it was observed that persons speaking the English language tend to slur the ending of words with the result that the beginning of the words is usually accentuated. Thus, irrespective of the device elements appearing in the applicant's mark, the similarities between the words may cause confusion. I have considered the applicant's reference to the Internet facility which is increasingly used by the customers in purchasing its goods. It appears, however, that some orders of purchases are still communicated by telephone.

Whilst I acknowledge that the persons dealing with the goods in question would not be impulse buyers, but knowledgeable people with ordinary intelligence, the goods are not of such a highly technical nature as to be handled only by qualified mechanics or automotive enthusiasts, and they do not appear to belong to the exorbitant price range category so as to eliminate any risk of confusion based on absolute discernment.

Having considered the surrounding circumstances, with the result of finding that the marks now being considered are deceptively similar, I turn to the issue of the alleged prior use and reputation of the opponent's mark JACKAROO, and whether that reputation would be likely to deceive or cause confusion. The relevant date for determining the rights of the parties is the date of the present application - 27 October 1994 - *Southern Cross Refrigerating v Toowoomba Foundry*, supra. The same case also makes it clear that the onus rests on the applicant to establish no reasonable likelihood of deception or confusion of the competing marks.

First, with reference to Mr Buck's query as to a continuous chain of ownership of the mark JACKAROO, I believe Mr Beattie, in his first declaration, has adequately explained the various links leading up to the present opponent, to whom have been transferred all the assets and goodwill in respect of the vehicles and parts under the mark JACKAROO. The opponent has continued to import and sell goods under the mark in Australia, a process commenced by General Motors-Holden Limited. In the absence of any contrary evidence, I accept these statements as facts.

According to the information supplied in Mr Beattie's declaration, the gross sales of the motor vehicles in Australia bearing the mark JACKAROO, from 1981 to 1994, have reached \$742,526,000 in respect of 25,224 motor vehicles. These are substantial sales, given that a four wheel vehicle, shown in the opponent's exhibits, is often purchased by persons, presumably, as a second car to be used only for driving through areas of rugged and difficult terrain. While no sales value has been provided for parts and accessories for the corresponding period, the sales, covering a two year period from 1993 to 1994, have been estimated to be \$19,319,329. Advertising of the products under the mark JACKAROO has been carried out by the opponent through the electronic and print media and, as samples of this advertising, are displayed a large number of copies of media releases, newspaper and magazine articles, as well as brochures. While this evidence displays representative samples of advertising for each year from 1981 to 1997, many copies of the samples do not show how, and to what extent, these advertisements were publicised. Of those newspapers which have published an article each in relation to the JACKAROO vehicle before 1994, to my knowledge, only *The Age* and *Herald* enjoy national distribution. There is no indication as to how the news releases issued at various times were utilized. The

material contained in such publications as the owners' handbooks, services communication books and internal magazine *InRoads*, obviously, are not intended for wide circulation. The defects of this evidence notwithstanding, the opponent appears to have expended considerable sums on media advertising, which is apparent from the amount \$2,216,194 spent between 1992 and 1994, in addition to \$300,991 in respect of direct advertising.

Mr Beattie's exhibits support his statement that the opponent's motor vehicles are identified either as HOLDEN JACKAROO, or as JACKAROO, in the advertising and promotional literature. He states that this is a standard practice of badging all the vehicles in the Holden dealer network. Where the mark JACKAROO appears separately, the advertisements also refer to HOLDEN, which suggests that, while members of the public might recognize the origins of the vehicles, they would identify the particular car line as JACKAROO. In brochures, service manuals and parts catalogues, where reference is made to parts and accessories, those goods are clearly identified by a description or a number, indicating JACKAROO as the vehicle for those goods. I have no reason to doubt Mr Beattie's statement that the opponent's customers request a JACKAROO part, or a HOLDEN JACKAROO part. I understand this to mean a reference to the part as well as the particular vehicle, both known by the trade mark JACKAROO, rather than simply a part for a JACKAROO vehicle.

Pursuant to the *Trade Marks Act 1995*, even if a trade mark is not physically applied to the goods, it still constitutes use in relation to those goods. Thus, in terms of paragraphs (b) and (c) of subsection 9(1) of the Act:

**9.(1)** For the purposes of this Act:

...

- (b) a trade mark is taken to be *applied in relation to* goods or services:
  - (i) if it is applied to any covering, document, label, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade; or
  - (ii) if it is used in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services; and
- (c) a trade mark is taken also to be *applied in relation to* goods or services if it is used:
  - (i) on a signboard or in an advertisement (including a televised advertisement); or

- (ii) in an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document ...

In terms of the above definition, the way in which the opponent's mark JACKAROO has been used, as shown in its evidence, is considered as use of the mark in the course of trade. If the parts and accessories designated for a JACKAROO vehicle may be suitable for other opponent's vehicles, or their packaging carries no trade mark, as was argued by the applicant, this does not detract from the fact that the opponent has used the mark in respect of those goods.

Having regard to my earlier comments, I consider that, despite the deficiencies in the opponent's evidence, the opponent had built up an extensive reputation of the mark JACKAROO in respect of motor vehicles and a reasonable reputation under that mark for parts and accessories prior to the date of the present application.

The applicant has not provided any details as to turnover in respect of the goods under its mark. Advertisements featuring the mark, however, have been inserted in newsletters and a magazine in 1995 and 1996, exhibited to Mr Buck's declaration. Given this evidence, it appears then that no use of the applicant's mark has occurred before the filing of the application. Indeed, Mr Buck himself states in his evidence in answer declaration that the use commenced "at least since the date of incorporation of Jackeroo World Pty Ltd on 2/12/94".

In turning to the question of deception or confusion, I refer to *Southern Cross v Toowoomba Foundry*, supra, where Kitto J said, at 595:

It is not necessary, in order to find that a trade mark offends against the section, to prove that there is an actual probability of deception leading to a passing off. While a mere possibility of confusion is not enough - for there must a real, tangible danger of its occurring - it is sufficient if 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 that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt. In considering the probability of deception, all the surrounding circumstances have to be taken into account.

As the evidence of actual confusion of the marks under consideration, Mr Beattie has referred to an article published in the *Weekly Times* of 7 August 1995, where, in the title of the article, the opponent's JACKAROO vehicle has been described as a

"Jackeroo" vehicle. It seems to me that, on that occasion, the error was caused by an oversight or a misspelling of the word, rather than any serious confusion of the marks on the part of the article's author.

To support the contention of the possibility of confusion of the marks, the opponent has relied on forty-five questionnaires from persons dealing with the ordering and supplying of vehicle spare parts. These accompanied Mr Johnston's declaration. While I cannot give much value to unsworn questionnaires, I have decided to evaluate their contents and make some general comments. It is evident that the majority of the respondents of the questionnaires have been associated with the vehicle parts trade for long periods ranging from one to thirty-six years. With the exception of four persons and one who has failed to respond to the question, all the others have been aware of the opponent's JACKAROO mark for considerable number of years and most know of its use in respect of a motor vehicle or, specifically, the four wheel drive vehicle. Ten also acknowledge recognition of the JACKAROO vehicle parts. Of those who have inserted an answer to the appropriate question as to whether they recognize the applicant's mark, only four have answered in the affirmative, but, significantly, almost half of all the respondents say that they would associate the applicant's mark with the opponent, or another of the General Motors Corporation group of companies. This inferred connection of the applicant's mark with the opponent, or its related companies, I cannot totally ignore. It suggests uncertainties as to the correct source of the applicant's goods amongst those directly engaged in the relevant trade.

Having considered both the opponent's and the applicant's evidence, together with the respective submissions in light of the legal precedents, I find that, given the impressive reputation built up in the opponent's mark JACKAROO in respect of motor vehicles, being four wheel drive vehicles, and the flow-on of that reputation to the parts and accessories for such vehicles, together with the exposure of the mark for those goods as shown in the evidence, use of a deceptively similar applicant's mark for the same type of goods would result in a real risk of deception or confusion amongst a substantial number of potential customers. Alternatively, on seeing the applicant's mark, the persons who are familiar with the opponent's mark, by virtue of its long use, are likely to believe that the products share the same trade origin. Even though I have given only limited weight to the results of the opponent's

questionnaires, that evidence reinforces my conclusions as to the validity of the objection to registration of the subject mark based on section 60.

As to honest concurrent use of the applicant's mark, mentioned by the applicant, reliance on the provisions of subsection 44(3) of the Act would be inappropriate here, as no prior registered mark, or a mark pending registration, constituted an impediment to the applicant's mark under subsection 44.

*Whether the applicant's mark is capable of distinguishing*

In relation to this matter, the relevant sections of the Act read:

**41.(2)** An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

**41.(3)** In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

The question to decide here is to what extent the applicant's trade mark is inherently adapted to distinguish the goods in respect of which registration of the mark is sought. In this regard, the attention is focussed solely on the mark, leaving aside any comparison with the opponent's mark or marks, or what opinion the persons aware of the opponent's mark might form of it, as is required in relation to section 60, or subsection 44(1).

The subject mark, as has been submitted by Mr Buck, illustrates a story - a driver and passenger in a four wheel drive vehicle driving through a sun-drenched desert. The inclusion of the words JACKEROO WORLD in the mark may suggest the action as taking place somewhere in the Australian outback. Those words do not, however, describe any quality or characteristic of the applicant's nominated goods. I see no reason why the applicant's mark should be rejected in terms of section 41 of the Act.

**Conclusion**

I have found the opponent has succeeded in relation to its ground of opposition based on section 60, but has failed on the section 41 ground. Consequently, I have no option but to refuse to register the mark of application number 644230, subject to any appeal from my decision.

**Costs**

The Registrar generally awards costs to the successful party in opposition proceedings. An owner of a mark has every right to protect its valuable and well-known trade mark from competitors by opposing, in terms of the relevant provisions of the Act, registration of a mark which bears close resemblance to that mark. I do not see how I can use my discretion in favour of the applicant by not awarding costs against it in the present proceedings. In awarding costs to the opponent, however, I have decided it is entitled to costs as set out in items 1 to 12, in Schedule 8 of the Regulations, but it should not claim any costs in relation to its further evidence which, with more forethought, could have been presented in a comprehensible form.

Vija Zars  
Hearing Officer  
27 April 1999