



## TRADE MARKS ACT 1995

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

Re: Opposition by Medicon eG Chirurugiemechaniker-Genossenschaft to registration of trade mark application 649033(10) - MEDISON- filed in the name of Medison Co Limited.

#### ***Background***

Application 649033 was filed by Medison Co Limited ('the applicant') on 19 December 1994 ('the priority date') and sought registration of the trade mark ('the applicant's trade mark') appearing below:



The goods in respect of which registration was sought included:

Electrocardiographs, medical apparatus and instruments, probes for medical purposes, radiological apparatus for medical purposes, ultrasonic probe in this class, video endoscope, electronic endoscope

The examiner, in a report, objected *inter alia* that registration 129584(10) MEDICON was substantially identical or deceptively similar to the applicant's trade mark (and that therefore an objection existed to the registration of the trade mark in terms of section 33(1) of the *Trade Marks Act 1955*).

Following some argument about the similarities of the trade marks, and an amendment to the specification of goods to that above in order to resolve some classification issues raised by

the examiner, the applicant lodged a statutory declaration and evidence in terms of section 44(3) of the *Trade Marks Act 1995* which by then had come into force.

I will not go into the details of the declaration presently, as I will discuss it in some detail later in these Reasons.

Following consideration of the material submitted by the applicant in support of the declaration, the application was accepted (for the goods as specified above) for registration subject to the endorsement:

Provisions of section 44(3) applied.

On 23 Oct 1997, the application was advertised in the Official Journal of Trade Marks as accepted for registration. On 23 Jan 1998, within the time allowed to do so, Medicon eG Chirurgiemechaniker-Genossenschaft ('the opponent') filed Notice of Opposition to the registration of the applicant's trade mark. The grounds under which the application was opposed and argued will become apparent within my Reasons but I will note now that the opponent is the owner of the trade mark cited during examination. The opponent's evidence in support of the opposition consists of a statutory declaration, with exhibits A to H, of Hubertus Scholz (the Scholz declaration). The applicant's evidence in answer consists of a statutory declaration by Min-Hwa Lee, with exhibits MLH-1 to MHL-5 (the Lee 2 declaration).

The hearing of the issue was before me in Sydney. Wayne Willis of F B Rice & Co represented the opponent, and Annabel Reader of Baldwin Shelston Waters represented the applicant. Before detailing the submissions of the parties' representatives I will briefly outline the evidence before me - which will include that set before the examiner - that being the earlier declaration by Min-Hwa Lee which I will identify as the Lee 1 declaration.

#### The Lee 1 Declaration

Lee is the Chief Executive Officer of the applicant and makes the declaration on the basis of first hand knowledge or inquiries made. The applicant's trade mark, the declarant says, was adopted in 1992 - the circumstances and reasons for the adoption of the trade mark are not stated. Use of the trade mark in Australia is stated to have commenced in 1992 and the

declarant says that at the "time of commencement of use of the trade mark my company was not aware of the existence of the trade mark MEDICON." The declarant goes on to state that, "The trade mark is used in Australia on all the goods covered by Pending Application 649033. The goods covered by Pending Application 649033 are sold throughout Australia."

The declaration then attests to the sales in Australia of some 100 units, worth about \$10,000 each, prior to the priority date.

Advertising and promotional figures are given for the whole world without specific figures for Australia with an explanation that it is difficult to extract the relevant figures for this country. Appended to the declaration are some brochures, shipping documentation and in-house magazines which show the applicant's trade mark in use in relation to ultrasound equipment.

The declarant states no knowledge of "any instances of confusion arising between the Trade Mark and the cited trade mark MEDICON."

#### The Scholz declaration

Mr Scholz says he is a director of the opponent and has been in its employ for 13 years and the material in his declaration stems from access to the relevant records of the opponent or his personal recollection.

The declarant states his knowledge of the details of the opposed application and annexes the notice of acceptance published in the Official Journal of Trade Marks to his declaration. He notes his awareness of the application of the 'honest concurrent user' provisions of the Act to the opposed application. Mr Scholz states that he has been furnished with a copy of the declaration, which I have referred to as the Lee 1 declaration, outlined above.

Mr Scholz appends part of the surgical catalogue of his company and draws my attention to various high frequency and endoscopic equipment listed in the publication.

He says the MEDICON trade mark has been in use in Australia for a long time - at least several decades and notes the opponent's registration of its trade mark in Australia dates from 1956. The MEDICON trade mark is registered by the opponent in over 50 countries

worldwide and is very well known, he says, throughout the world in relation to surgical apparatus and instruments.

Next Mr Scholz avers that the first contact between the opponent and the applicant was in December 1993 when a cease and desist letter was sent from the opponent's German attorneys to "Medison GmbH" protesting at the use of the MEDISON trade marks in relation to surgical products in Germany. A copy of the cease and desist letter is annexed as Exhibit C to the declaration and the Medison Europe GmbH (as they were more properly named) response is attached at Exhibit D to the declaration.

The opponent considered the response to the cease and desist letter to be unsatisfactory and commenced proceedings against Medison Europe GmbH in the District Court of Homburg. A settlement was reached between the parties and copies of the settlement and an English translation thereof are annexed to the declaration as Exhibit F. In brief, Medison Europe undertook, *inter alia*, not to use either its company name (and to delete that name from the company register), or the applicant's trade mark, in relationship to:

Electro-cardiographs, medical appliances and instruments, in particular probes for medical purposes, radiological appliances for medical purposes, ultra-sound diagnosis instruments, ultra-sound probes, video endoscopes, medical work stations, in particular computerized visualized filing systems.

Mr Scholtz then avers that Medison Co Ltd did not discontinue use of the applicant's trade mark in Germany, as agreed to, and so a further cease and desist letter was written to Medisonic Medizinische Gerate GmbH (formerly known as Medison Europe GmbH) and the applicant. A second agreement was entered into and a copy of this document (and its English translation) is annexed to the declaration as Exhibit H. In this agreement the applicant undertook to not to use the designation MEDISON as a trade mark or business name in its business activities in the Federal Republic of Germany and to withdraw its trade mark.

The declarant next states that the opponent is opposing trade mark registrations in the United Kingdom, Greece and South Africa and these oppositions were lodged on 14 Aug 1996, 11 Oct 1996 and 13 Jun 1997 respectively. The opponent does not refute these claims.

Mr Scholtz concludes by drawing my attention to the Lee 1 declaration where the declarant stated, on 20 Sep 1997, a lack of awareness of any instances of confusion arising between the MEDICON and MEDISON trade marks. Mr Scholtz states that he is of the view that as at 20 Sept 1997, the applicant was aware of the conflict between the parties and the confusion that had already taken place between the MEDISON and MEDICON trade marks in various countries around the world.

#### The Lee 2 Declaration

The declarant is the same person who made the Lee 1 declaration and firstly identifies the applicant's trade mark and the opponent.

The Lee 1 declaration is referred to and annexed as exhibit MHL 2 to the declaration. Supplementary sales and advertising figures and brochures are then given - however as these post date the priority date, these are irrelevant. The declarant then refers to the Scholtz declaration and goes on to state that the Scholtz declaration does not evidence whether any of the specific products referred to in the declaration have been sold in Australia.

The Lee 2 declaration continues by claiming that the circumstances in Germany are not relevant to the situation in Australia and annexes a translation of Exhibit B to the Scholtz declaration (the letter from Medison Europe GmbH responding to the initial cease and desist letter from the opponent).

Departing from the Lee 2 declaration briefly, I must state that I find the contents of this letter to appear to confirm the presence of confusion. After firstly stating that there has been no instance of confusion between the firm's names and no risk of confusion between the two trade marks, the letter continues:

With regard to similarity between the two trademarks and our selling products, we again assert that there will be no potential consumers to confuse the two firms which have manufactured and sold only ultrasonic mechanism.

We hope to well solve this matter due to such confusion.

The Lee declaration states that the breach of the initial agreement, which led to the second settlement agreement, is relevant to Germany only and is not relevant to other jurisdictions including Australia.

The declarant then states that the Lee 1 declaration, whilst stating that the applicant when commencing use of the applicant's trade mark in Australia was not aware of the existence of the trade mark MEDICON, was impliedly making that statement in relation to Australia. And that, further, the statement that the declarant was unaware of any instances of confusion was made in relation to the Australian market-place.

The declarant concludes by stating an awareness of the conflicts between the applicant and opponent in a number of jurisdictions at the time the Lee 1 declaration was made but an unawareness of any instances of confusion at that time.

*The submissions*

Mr Willis, for the opponent, largely confined his submissions to those surrounding the operation of section 44(3) - the honest concurrent user provisions of the Act - except where responding to Ms Reader's submissions.

Ms Reader addressed the terms of the notice of opposition which encompassed sections 58, 60, 43, 41 and 42 of the Act as well as the above mentioned grounds under section 44(3).

Lest there be any doubt, I dismiss the grounds under sections 58, 60, 43 42 and 42 of the Act and note that these were not pursued by the opponent at the hearing.

*Reasons*

At the hearing, Ms Reader presented strong argument to the effect that the trade marks are not deceptively similar so it is appropriate to address this question prior to any consideration of the issues under section 44(3) (should it then be necessary for me to do so).

Section 44 of the Act provides as far as is relevant to this issue:

**Identical etc. trade marks**

**44.(1)** Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

(a) the applicant's trade mark is substantially identical with, or deceptively similar to:

(i) a trade mark registered by another person in respect of similar goods or closely related services; or

(ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and

(b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar goods* see subsection 14(1).

Note 3: For *priority date* see section 12.

[.....]

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

(a) that there has been honest concurrent use of the 2 trade marks; or

(b) that, because of other circumstances, it is proper to do so;

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

Note: For *limitations* see section 6.

[.....]

Given that the applicant has conceded that the goods in question are "similar goods", and there is no question as to the earlier priority date of the opponent's application, the questions remaining in terms of subsection 44(1) are whether the trade marks in question are substantially identical or deceptively similar.

Further, section 44 of the Act should be read in the light of section 33 which states:

**Application accepted or rejected**

**33.(1)** The Registrar must, after the examination, accept the application unless he or she is satisfied that:

(a) the application has not been made in accordance with this Act; or

(b) there are grounds for rejecting it.

Note: For the grounds on which an application may be rejected see Division 2.

**(2)** The Registrar may accept the application subject to conditions or limitations.

Note: For *limitations* see section 6.

(3) If the Registrar is satisfied that:

- (a) the application has not been made in accordance with this Act; or
  - (b) there are grounds for rejecting it;
- the Registrar must reject the application.

(4) The Registrar may not reject an application without giving the applicant an opportunity of being heard.

Note: For *applicant* see section 6.

In *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 (29 July 1999), para 34, French J said of section 33:

The condition of refusal of an application is that the Registrar is satisfied that there are grounds for rejection. If not so satisfied the Registrar must accept the application. Unless the Registrar thinks that the proposed trade mark is likely to deceive or to cause confusion then all other things being equal, the application must be accepted.

And at para 45:

The position now is that the Registrar and the Court at first instance would need to be satisfied that there was a reasonable likelihood of deception or confusion before denying acceptance of the application for registration.

Substantial identity is to be gauged by a side by side comparison of the trade marks. In the words of Windeyer J in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, at 414;:

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 feature of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

In applying this test, the device comprised of arcuate lines capped with the distorted letter M, within the applicant's trade mark, makes sufficient impact on the overall impression of the two trade marks to set them apart from each other. Thus, I do not consider the trade marks to be substantially identical.

However, as concerns deceptive similarity, there is a different test to be applied. In the *Shell* case, *supra*, Windeyer J said:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is the question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impression that such persons would get from the defendant's television exhibitions.

Again, in *Re: application by Pianotist Co Ltd* 1A IPR 379, Parker J, as he then was, observed:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion — that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods — then you may refuse the registration, or rather you must refuse the registration in that case.

Ms Reader, at the hearing, stated that there were both visual and aural differences between the trade marks sufficient to set them apart. I cannot agree in regard to any aural differences between the trade marks that this is necessarily so. It is not obvious to me that the MEDICON trade mark of the opponent will necessarily be pronounced "MEDI-KON". It seems as equally logical to me that the letter "C" could be spoken as is the French 'Ç' with the effect that the words within both trade marks would be pronounced identically. This is particular so of a trade mark whose primary market and place of manufacture of the goods is within the European Union and with regard to the goods which are for use within 'medicine' which has a soft letter 'C'.

However, when considering the expense and specialty of the goods, it is probably unlikely that they will be ordered by the relevant members of the public over a counter by the spoken word. It is more likely that the goods will be ordered from a distributor. Accordingly, the visual impression of the two trade marks is of greater importance in this comparison (although the above observations will be a factor in any 'imperfect recollection' of the

opponent's trade mark: *Aristoc v Rysta* (1945) 62 RPC 65 and *Coca-Cola Co of Canada Ltd v Pepsi-Cola Co of Canada Ltd* (1942) 59 RPC 127).

The visual impressions of the trade marks are very similar: in drafting these reasons I have found a continuing need to refer to the official file to ensure I am attributing the correct word trade mark to each parties. I am satisfied that a person who has seen, or who knows, the opponent's trade mark would, on seeing the applicant's trade mark, confuse the two of them. The device component of the applicant's trade mark is not so prominent that it is the way in which the applicant's trade mark will be recognised and referred to. Further, the device component is abstract and innominate; that is, it is not an immediately recognisable object that could readily be named by potential purchasers and thus used as a mnemonic aid or verbal tool in distinguishing the trade marks. It is the word MEDISON that forms the major part of the applicant's trade mark and will be the way in which the trade mark is referred to, recognised and remembered.

In coming to the above conclusion, I have weighed the similarities between the trade marks against the relative expense and specialty of the goods. In general, the more expensive the goods, the more care is exercised in their purchase: *LANCER Trade Mark Application* [1987] RPC 303; similarly, the greater the technical expertise of those involved in ordering goods, the less likely are trade marks to be confused: *Re Application By Retec Ltd* (1988) 12 IPR 413. However, here I believe that the differences between the trade marks are so slight that they are not mitigated by the degrees of expense and complexity of the goods.

#### Section 44(3)

The comments of French J, noted above, from *Woolworths, supra*, concerning the principle that the Registrar (or his Delegates) should not reject an application unless he is satisfied that it will confuse, logically extends to the application of the 'honest concurrent user' provisions of the Act. That is, I should not reject this application unless I am satisfied that the applicant has not made out a case of honest concurrent user.

In *Alex Pirie & Sons Ltd's Application* (1933) 50 RPC 147 and *John Fitton & Co Ltd's Application* (1949) 66 RPC 110 five factors are given to be considered in assessing whether parallel use of a trade mark has been 'honest concurrent use':

- the extent of the user in time and quantity;
- the degree of confusion likely to ensue from the resemblance of the marks —which is a measure of public inconvenience;
- the honesty of the concurrent use;
- whether any instances of confusion have in fact been proved;
- the relative inconvenience which would be caused if the mark were registered.

One other factor affects this application; that is, the question of whether any of the user of the trade mark has been concurrent (in the sense of being congruent through the same distributors) with use of the opponent's trade mark. If it is not shown that any of the user has been concurrent, the provisions of section 44(3) may not be applied: *Re "L Amy" Trade Mark* [1983] RPC 137

Of the above criteria, the most important factor is the 'honesty' of the concurrent user, "for if the concurrent use is not honest it is as nothing" : per Mr Myall in the *Granada case* [1979] RPC 303 at p 313. I will, however, dispose of the five factors in the order in which they appear from *Pirie's Case*, above.

#### *The Extent*

The relevant date before which use of the mark must have occurred is the date of application for registration of the trade mark by the applicant: the priority date - here 19 December 1994 - see "*Granada*" *Trade Mark* [1979] RPC 303 at 312; *Gloy & Empire Adhesives Ltd's Application* (1934) 51 RPC 63 at 69.

The date of first use of the trade mark was some time during 1992 during which year the applicant sold a total of 3 units within Australia. During 1993, the applicant sold a total of 36 units in Australia. It is not clear at what date in 1992 use commenced but it is clear that use was either very slight throughout the year or it started very late in 1992. It follows that, depending on when use in 1992 started, the applicant had one to two years use prior to the priority date late in 1993.

There are no figures given concerning advertising or promotional activities relating to the trade mark within Australia, although world-wide figures are given. It is difficult to

apportion any of the figures given to Australia since the applicant does not give any details of its world-wide sales or the total number of units sold. Some of the applicant's promotional literature is in evidence but it is unsupported by evidence about how widely it has been distributed within the Australian market-place and appears to be material which is also used overseas - it has not obviously been published for the Australian market-place.

Thus, I do not consider that, at the priority date, the applicant's trade mark had been used to the extent that honest concurrent user could be properly assessed.

### *The Degree of Confusion*

Given the similarities between the trade marks, the nexus between the goods and the fact that the market into which the goods are sold is identical for both parties, I would expect the degree of confusion between the goods to be very high. Ms Reader, for the applicant, argued that the case here is a borderline one and the applicant had opted to present evidence of honest concurrent as a matter of convenience - not as a concession that the trade marks would be confused. I do not accept that the case is a borderline one and, in the light of the applicant's knowledge of its situation in Germany, I would view the claim that the evidence of concurrent user of the trade mark as not being a concession as optimistic.

### *The Honesty*

As observed above, if the use of the trade mark has not been honest, it has been as nothing. Of the requisite 'honesty' to be exercised, Romer, J stated in *J R Parkington & Co Ltd's Application* (1946) 63 RPC 171 at 182-3:

It is commercial honesty, which differs not from common honesty, that is the criterion; and it is commercial honesty alone that can found a basis for the commercial claims to which Sargant J referred in *Maeder's case* (1916) 33 RPC 77.

In such situations as this, the onus is on the applicant to make out or establish its case of honest concurrent use. I think this onus must extend to the honesty with which the applicant does so. In other words, it is necessary for the applicant to be fully frank in its dealings with the Registrar or the Registrar's delegates.

As observed by Mr Willis in his submissions, the applicant is silent on its reasons for the adoption of this trade mark and the circumstances surrounding the adoption of the trade mark.

There are a number of factors which, in combination, have satisfied me that the applicant has not reached the requisite standard of honesty in its concurrent use of the trade mark. As noted above, the honesty of the concurrent use of the trade mark must extend to claims and statements made by the applicant before me as a delegate of the Registrar of Trade Marks or, previously, to the examiner responsible for the application.

In the Lee 1 declaration the declarant made "a solemn declaration by virtue of the *Statutory Declarations Act 1959*, and subject to penalties provided by that Act for the making of false statements in Statutory Declarations, conscientiously believing the statements in this Declaration to be true in every particular". In particular the declarant stated that the trade mark was in use for all of the goods covered by the application. This is not true. The applicant has, subsequent to the hearing, offered to restrict its claim to those goods on which it actually uses the trade mark but this does not go to remedy the veracity of the claim at the time it was made. The declarant also stated he was not aware of any instances of confusion arising between the trade mark and the cited trade mark MEDICON. This *prima facie* flies in the face of the dispute between the instant parties in Germany and oppositions to trade mark registration by the opponent elsewhere in the world evidenced by the opponent. In the subsequent Lee declaration the declarant averred that the prior declaration was obviously made in the context of the trade mark's use in Australia. I have some difficulty in accepting this for the following reasons. The terms used by the declarant in the Lee 1 declaration are all embracing. The statement is made in the context of a foregoing statement, which would appear to embrace a wider forum than Australia, that at the "time of commencement of use of the trade mark my company was not aware of the existence of the trade mark MEDICON." The advertising figures in the declaration are international, as are many of the publications and brochures appended to it. So it is not at all obvious that the statement was contextually limited to the Australian market-place. Further, the statement was made with the knowledge that there was a dispute in Germany: under those circumstances, and in the light of 'commercial honesty', the declarant might not be obliged to disclose the dispute but should make it clear in the declaration that his statement is confined to Australia.

Further, at the date of application the applicant was aware of the dispute in Germany as the first agreement between the parties was entered into during July 1994 (indeed, by the priority date the applicant had already broken the first German agreement and entered into a second).

It seems to me that the requisite standard of 'commercial honesty' would (under these circumstances) involve a precautionary search for the present opponent's trade mark on the Australian Register of Trade Marks prior to further use of the trade mark in Australia or the lodgement of an application to register the trade mark. I note that the applicant has stated that the dispute over the similarity of the trade marks is limited to Germany but has not explained why this should be so. While the German disputes (and the settlements thereof) themselves are limited to Germany, it is not obvious to me why the trade marks should be considered to be confusingly similar in Germany but not elsewhere.

#### *Instances of Confusion*

There have been no reported instances of confusion. However, this observation should be read in the light of those below the heading 'congruency' and above under 'extent'.

#### *The Balance of Convenience/Relative Inconveniences*

The issues under this heading have been considered by the Registrar or his delegates in issues such as *Emdon Investments Pty Ltd v Shell International Petroleum Co Ltd* (1988) 12 IPR 525 and *Mccormick & Company Inc v Mccormick* (1998) 42 IPR 515. The cases show that I am to consider the relative inconvenience to the parties as well as the public interest. Although Ms Reader argued the applicant would suffer undo hardship through not having its trade mark registered, I am not convinced this is so. As part of the agreement between the parties in Germany, the applicant has not only removed its trade mark from the Register but has agreed not to use it. As Ms Reader elsewhere observed, the applicant is continuing to use its trade mark in Australia - any hardship suffered by the applicant by not securing a registration would thus appear to be slight.

On the other hand, the opponent has not led any evidence to show how it would be disadvantaged or inconvenienced by the registration of the applicant's trade mark. Any loss of commercial distinctiveness (as referred to, for example, in *Woolworth*, supra, by French J.) may arguably be as great whether the applicant's trade mark is registered or not.

If the trade mark has remained in use, it is arguably in the public interest to allow the trade mark onto the Register in order that the applicant can prevent infringing use by a third party. Further, it is in the public interest that the Register of Trade Marks, as far as is possible, reflect the *status quo*.

*Congruency*

As noted above, one of the essential elements for establishment of honest concurrent use is to show that the trade marks have been used not just, to use Mr Willis' term, "contemporaneously" but congruently. That is, the goods of the applicant and opponent should have been sold through the same trade channels: "*L 'Amy' Trade Mark, supra.*" This is in order that the presence or absence of public confusion between the trade marks can be positively stated and a true assessment of whether the public does in fact distinguish between the trade marks be reached. While this requirement is not present during the examination of an application, it is a feature of oppositions before the Registrar, when it is raised, and before the Courts. Both the applicant and the opponent have been silent in their evidence on whether the parties' identical goods have been sold through the same trade channels or within the same market-place. On balance, the opponent's evidence might suggest that they have not.

*Summary*

At the date of application the trade mark had not been used to the extent that honest concurrent use could be established by the applicant. Given the close similarities of the trade marks and the identity of the trade channels and market place, the degree of confusion would appear to be high. The honesty of the concurrent user has not met the standard of 'commercial honesty' envisioned in the cases. Although there were no instances of confusion at or by the relevant date, this could be due to the low extent of user or lack of congruency in the use. And, it is not clear where the balance of convenience lies although this may weigh more in the applicant's favour.

I am therefore satisfied that the applicant has not made out a case of 'honest concurrent use' of the trade mark.

*Decision*

I am satisfied that the trade mark the subject of the application is deceptively similar to that of the opponent and, further, that the applicant has not made out a case for the honest concurrent use of its trade mark. I therefore refuse to register application 649033.

*Costs*

The opponent, having been successful in its opposition, is entitled to its costs which I award against the applicant.

Ian Thompson  
Hearing Officer

<7 February 2000>