



## TRADE MARKS ACT 1995

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

Re: Opposition by Caterpillar, Inc to registration of trade mark application 726902(12) - LANDCAT AND DEVICE - filed in the name of Amco (Vic) Pty Ltd.

#### Background

Amco (Vic) Pty Ltd (the applicant) filed application number 726902 on 31 January 1997. The applicant applied to register the trade mark:

**LANDCAT** 

The goods claimed on the application are "tractors" in class 12.

Acceptance of the application was advertised in the *Australian Official Journal of Trade Marks* of 26 June 1997. On 26 September 1997, Caterpillar, Inc (the opponent) filed a notice of opposition to registration of the mark. The opponent has listed twenty-two grounds of opposition. At the hearing, the opponent pressed only four of those grounds, namely, those based on section 44, including subsections 44(1), 44(3) and 44(4), and section 60. In addition, it was proposed that some consideration be given to the ground in terms of section 58.

The hearing on the opposition was held in Melbourne. Mr Robert Kelson of Callinan Lawrie, patent and trade mark attorneys of Melbourne, appeared for the opponent. No representations were made on behalf of the applicant, either in person or by way of written submissions.

**The evidence**

The evidence in support consists of 12 statutory declarations or affidavits. Nine of these are in the form of questionnaires from persons who have been involved, for varying periods of time, in the heavy machinery sales and support services industry.

An affidavit made by Gene Bolmarcich, Intellectual Property counsel of the opponent company, claims that the opponent is the world's largest manufacturer of earth moving machines and heavy equipment. The opponent holds many trade mark registrations in Australia, which are listed in an annexure to the affidavit. These include registrations for the word trade mark CAT and a CAT logo mark for use in association with, among other things, a wide variety of heavy equipment, as well as computer software and programmes. Information is provided of the sales of heavy machinery in Australia under the two trade marks, as well as advertising and promotion of the goods. In addition to selling heavy equipment, earthmoving equipment and related products, the opponent uses the mark CAT on various software programmes sold to the opponent's dealers and customers and, as evidence of this the deponent exhibits an identification list of various software programmes licensed and distributed by the opponent. A reference is made by the deponent to announcements of the opponent's plans to manufacture skid steer loaders; exhibits to the affidavit contain copies relating to these announcements.

Two statutory declarations in the evidence in support are made by Judy Spence, the advertising and promotion consultant for Caterpillar of Australia Ltd (Caterpillar Australia). Ms Spence annexes copies of status reports of the opponent's trade mark registrations in Australia. She says that the opponent and Caterpillar Australia take care of protecting the opponent's marks and the reputation attaching to those marks, and that both companies have engaged in a number of actions and activities aiming at protecting the marks. For this purpose, booklets, training and approval processes endeavour to ensure that the trade marks are used only by those entitled to do so and in strict accordance with the Caterpillar corporate identity and communication guidelines. A copy of one of these booklets is exhibited by her as evidence.

In her second statutory declaration, Ms Spence states that she has been advised that a number of the questionnaire/declarations executed by a range of persons engaged in the earthmoving

industry, and filed as part of evidence in support of the opposition, were technically informal. From perusing the copies of the answered questionnaire/declarations, she has no reasons to doubt the accuracy of the answers of the persons concerned. She notes that the names and addresses of the persons involved generally formed part of the answers and that all the documents appeared to have been signed by the person providing the answers. The original copies of those documents, which are identified as 'statements' by the opponent's attorney in the letter accompanying the copies, are annexed to her declaration.

### **Submissions and discussion**

Mr Kelson first referred to the opponent's evidence filed as 'statements'. He said that this evidence should not be rejected out of hand for the reasons as follows: all the statements appear to have been signed by the persons who answered the questions, those persons were identified and their answers could have been tested by the applicant, and some of the statements merely failed to comply with the formalities required for statutory declarations. These statements, Mr Kelson submitted, must be accorded some weight.

#### ***S.44 - substantially identical or deceptively similar trade marks***

In pointing to Mr Bolmarcich's affidavit, Mr Kelson noted that the opponent was the world's largest manufacturer of earthmoving machines and heavy equipment. It was also evident that its manufacturing operations extended to a wide range of construction, mining and agricultural machinery, including tractors and engines. The large number of the opponent's trade mark registrations in Australia covered a wide range of goods and services, as was evident from Ms Spence's exhibit.

Turning to the s.44 ground, Mr Kelson directed my attention to the various tests to be considered in determining deceptive similarity, such as the impression based on recollection of the opponent's marks when used in a normal and fair manner - *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407; the combination of the visual impression and judicial estimation of the effect produced in the course of the ordinary conduct of affairs - *Coca-Cola Co v All-Fect Distributors Limited* [1999] FCA 1721 at para 42 and *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641 at 659; aural perception of the marks; and the idea suggested by the marks - *Coca-Cola v All-Fect* at para 42.

Mr Kelson submitted that five of the opponent's registrations for the word mark CAT or CAT logo, the latter mark being the word CAT in large bold letters with a triangle at the base of the letter 'A', predated the present application and clearly embraced the same goods or goods of the same description as claimed in the application. In developing his argument, he pointed to tractors being used to draw implements and loads, or as a source of power for static or mobile agricultural machinery. He said that tractors were not confined to wheeled vehicles, as shown in exhibits to Mr Bolmarcich's affidavit, and that they varied greatly in price from very cheap low-power models up to expensive high-power models. In determining the matter, consideration had to be given to a whole range of tractors and different kinds of potential purchasers - *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-5 and commented on by French J in *Registrar of Trade Marks v Woolworths Limited* (1999) 45 IPR 411.

In respect of the CAT logo mark, Mr Kelson submitted that the word CAT was so dominant in the mark that, under conditions of "imperfect recollection", the idea suggested by it would be that of CAT. In the applicant's mark, despite the fact that the term LANDCAT was not comprised of two separate words, the term LAND was not so striking as to overwhelm the term CAT. Furthermore, the word LAND within the mark being an essentially descriptive term was likely to be perceived as a related mark to the opponent's CAT and CAT logo marks. In pronouncing the word LANDCAT, Mr Kelson said, the hardness of the suffix CAT places stress on it; it was difficult to slur 'Cat' contrary to stressing the first syllable. Mr Kelson also observed that the word CAT, shared by the opponent's and applicant's marks, did not appear to be common to the trade.

Turning to seven of the opponent's CAT or CAT logo marks in respect of services, Mr Kelson submitted that those marks were deceptively similar to the opposed mark for the same reasons he had advanced in respect of the registrations of those marks for the goods. Relying on the criteria relating to the assessment of closely related goods and services, as set out by the Hearing Officer in *ICI Australia Operations Pty Ltd v Duco-Magic (Australia) Pty Ltd* (1999) 46 IPR 228, Mr Kelson arrived at the conclusion that the applicant's tractors were, in general, closely related to the services of the opponent's seven registration. Referring to some of the opponent's services in particular, he said that marketing services, business consulting services and computer application services were often provided by the manufacturer of the goods

concerned. He said that training in maintenance of tractors was a service closely related, because it was usually provided, at least initially, by the manufacturer. Another closely related service was testing to provide indications of engine performance and/or engine wear and material testing to predict the life of earthmoving equipment. Maintenance and repairs of tractors, Mr Kelson said, as well as their rental and leasing were also services carried out either by persons authorised to do so by the manufacturers of the goods, or were provided by the manufacturers themselves.

Section 44 of the Act states that -

### **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.

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

- (a) it is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods 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 services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

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

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

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.

(4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

(a) beginning before the priority date for the registration of the other trade mark in respect of:

(i) the similar goods or closely related services; or

(ii) the similar services or closely related goods; and

(b) ending on the priority date for the registration of the applicant's trade mark;

the Registrar may not reject the application because of the existence of the other trade mark.

Note 1: An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

Note 2: For *predecessor in title* see section 6.

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

Under s.10, a trade mark is taken to be deceptively similar to another mark if it so nearly resembles that other mark that it is likely to deceive or cause confusion.

The details of the five opponent's registrations specifically mentioned by Mr Kelson in relation to the goods are set out hereunder:

Number 98534 for the word mark CAT in class 7 is registered from 14 April 1949, the statement of goods reading:

Internal combustion engines, diesel engines, and other power-supplying machinery adapted for employment as stationary or portable power units for industrial, marine and other uses; cable-control units for controlling cable actuated equipment for earth moving and other purposes; hydraulic-control units for controlling hydraulically actuated equipment for earth-moving and other purposes; electric generators and diesel electric generator sets for furnishing electric power; and parts, tools, attachments, accessories and equipment associated with all of such products and included in this class; agricultural and horticultural machinery and parts of such machinery.

Number 188613 for the word mark CAT in class 12, registered from 14 April 1963 for the goods:

Internal combustion engines, diesel engines, and other power-supplying machinery adapted for employment as the source of power for self-propelled vehicles, scraping carrying and dumping units adapted to be employed for scraping and collecting earth, rock, or like materials and transporting and dumping said materials, power and manually controlled graders, scarifiers, scrapers, bulldozers, rippers and plows adapted to be employed for the construction and

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maintenance of roads, for moving and removing earth, rock, snow and like materials, and for other uses; tractors adapted to be employed in farming operations, road building, mining, logging, earth moving, hauling, pushing and for other purposes; and parts, tools, attachments, accessories and equipment associated with all such products and included in this class; and structural parts thereof.

Number 275050 for the word mark CAT in class 12, registered from 3 January 1974 in respect of the goods:

All goods included in Class 12



Number 502753 for the mark  
January 1989 for the goods:

(CAT logo) in class 7, registered from 10

Machinery for earthmoving, earth conditioning and material handling namely, loaders, pipelayers, motor graders, scrapers, bulldozers, compactors, rippers; tool bars, cable controls and hydraulic controls for the foregoing goods; such replacement parts, accessories and attachments as are included in this class for all the foregoing goods; engines for powering the foregoing machinery and for industrial and marine applications, and as prime movers in electric sets namely, internal combustion engines, diesel engines, natural gas engines, and marine engines; and such replacement parts, accessories and attachments as are included in this class for all the foregoing goods; marine gears, track links, track shoes and track pins; electric generators, and electric sets for supplying electrical power to home, industry, hospitals, and the like, including diesel electric sets and natural gas electric sets; and all other goods in this class; the foregoing excluding wheels of all kinds in this class.



Number 502756 for the mark  
in respect of the goods:

(CAT logo) in class 12 from 10 January 1989

Vehicles for earth and material hauling and handling namely, trucks and tractors; engines in this class; such replacement parts, accessories and attachments for all of the foregoing as are included in this class; all other goods in this class.

In *Shell v Esso*, supra, of substantially identical marks, Windeyer said 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 features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison....

The applicant's mark consists of a combination of two recognizable words LAND and CAT, represented in thick upper case letters and featuring a paw device at the end of the mark. The applicant's marks on the other hand are single word marks. Some resemblance can be discerned between the style of letters 'A' and 'T' in the word CAT within the applicant's mark and the opponent's logo, but that is where the similarities end. On the side by side comparison, the prefixed word LAND to CAT and the paw device create an overall different effect from the opponent's marks - the short syllable word CAT or the CAT logo. The respective marks therefore are too dissimilar so as to be taken to be substantially identical.

Mr Kelson has referred to the test concerning deceptive similarity expounded in *Australian Woollen Mills v Walton*, supra. In that case Dixon and McTiernan JJ stated 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 the 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 goods under consideration are specialized, and I think it can be assumed that the price range of those goods is quite high. Such goods are normally selected for purchase with particular care and forethought. Brochures describing the features of the product would be studied by the potential purchasers, the machinery would undergo careful inspecting and testing before making the final decision as to whether it is suitable for one's particular needs. For those reasons I do not think the question of confusing the marks on the basis of imperfectly remembering their exact nature is a significant factor. For similar reasons, any perceived confusion likely to arise from pronouncing the word LANDCAT with emphasis on the word CAT would play only a minor role. However, the question of so called 'contextual confusion' needs close consideration.

What is meant by the term 'contextual confusion' was stated by the Assistant-Comptroller in *John Fitton & Co Ltd's Appn* (1949) 66 RPC 110 at 113:

With reference to the nature of the confusion alleged the evidence furnished on behalf of the Opponents by their trade declarants is directed not so much towards showing that the two marks "Jests" and "Easyjests" might themselves be confused either visually or orally, as towards establishing that confusion would result, owing to the presence of the common

element "Jest" in each mark, in traders and the public being induced to believe that the two sets of goods sold under the marks emanated from one and the same source.

While each of the words in the applicant's mark, LAND and CAT, has a distinct meaning, in the context in which the mark is to be used, i.e. in respect of tractors as farm equipment, the meaning of the word LAND, as was submitted by Mr Kelson, refers to soil or earth, simply qualifying the word CAT. Thus, deception or confusion between the marks is likely to be caused in view of the purely descriptive word LAND in the applicant's mark and the presence of the word CAT in each of the marks, rather than by any perceived visual or phonetic similarities between the marks. For further support of this contention I refer to *Kodak (A/asia) Pty Ltd's Appn* (1936) 6 AOJP 1724 (in that case the marks involved being HYPERPAN and PAN), and to *Arendsen's Appn* (1932) 2 AOJP 433, where the Deputy Registrar refused registration of the mark NEW ERA in face of the earlier mark ERA because, as he stated at 433:

The only distinguishing characteristic is the existence of the word "New" qualifying the word "Era", which in my opinion would convey the idea to the mind of the purchasing public that the goods are those of Hadfields Limited and are possessed of some new characteristic such as a new quality or virtue, and as such would in my opinion be likely to cause deception or confusion.

There is no question that the goods of the subject application and the opponent's registrations, the particulars of which are shown above, are similar, i.e. the same goods or goods of the same description within the meaning of s.14 of the Act. "Tractors" are explicitly included in the statements of goods of registrations 188613 and 502756 and would also be embraced in registration 275050, which covers all goods in class 12. As the nature and general use of a tractor is that of farm machinery and the goods of registration 98534 include "agricultural and horticultural machinery and parts of such machinery", which goods would also be encompassed in the claim "all other goods in this class" of registration 502753, the applicant's goods are of the same description as those covered by the two registrations.

I find therefore that the applicant's mark is deceptively similar to the opponent's marks of registrations 98534, 188613, 275050, 502753 and 502756, which registrations cover similar goods to "tractors".

In submitting that the applicant's tractors are related goods to services included in several of the opponent's registrations, Mr Kelson mentioned the following.

Number 327454 for the word mark CAT in class 37, registered from 1 February 1979 for the services:

Engineering construction; maintenance work, maintenance and repair of machinery; service, maintenance and repair of engines, or electrical generation equipment, of electrical machinery and accessories, or earthmoving, construction and materials handling machinery, of land vehicles and equipment; all other service, maintenance and repair services relating to land vehicles; rental and leasing services in respect of tractors, bulldozers, excavators and other earthmoving and construction equipment; and all rental and leasing services in this class in respect of machines and equipment.

Number 327468 also for the word CAT in class 36, registered from 1 February 1979 in respect of the following services:

Rental and leasing services in this class in respect of machinery and equipment, and other insurance and financial services.

The following five registrations are for the mark



henceforth to be referred to

as the CAT logo.

Number 502766 for the CAT logo mark in class 35, registered from 10 January 1989 for the services:

Marketing services in this class; marketing research; business consulting services in this class in relation to application engineering, systems analysis, job analysis, seismic analysis, material handling analysis, equipment specification and custom engineering services, machine customising services; computer application services in this class in relation to order processing and parts and machine locating in this field of earthmoving, construction, materials handling, and power generating equipment.

Number 502767 for the CAT logo mark in class 36, registered from 10 January 1989 in respect of the services:

Providing financing services in the field of business, equipment economics and maintenance and cost record systems, financing equipment inventories and purchases.

Number 502768 for the CAT logo mark in class 37, registered from 10 January 1989 in respect of the services:

Maintenance and repair services in the field of varying types of machinery; leasing services in the field of earthmoving and material handling equipment.

Number 502769 for the CAT logo mark in class 41, registered from 10 January 1989 in respect of the services:

Educational services, namely conducting training classes and seminars concerned with management and maintenance training and finance.

Number 502770 for the CAT logo mark in class 42, registered from 10 January 1989 in respect of services:

Chemical analysis services of oil sampling and testing to provide an indication of engine performance and/or engine wear; material testing services relating to inspecting and predicting the life of earthmoving, construction, materials handling and power generating equipment.

All these registrations have registration dates prior to the date of the present application.

Having found the applicant's mark to be deceptively similar to the opponent's marks CAT and CAT logo in terms of s.44(1)(i), I must determine whether the goods of the present application are closely related to the services covered by the above opponent's registrations.

In *Registrar v Woolworths*, supra, in discussing the relationship between goods and services that may be designated as closely related, French J said at 424:

The relationship may, and perhaps in most cases will, be defined by the function of the service with respect to the goods. Services which provide for the installation, operation, maintenance or repair of goods are likely to be treated as closely related to them. Television repair services in this sense are closely related to television sets as a class of goods. A trade mark used by a television repair service which resembles (to use the language of s 10) the trade mark used on a prominent brand of television sets could be deceptively similar for suggesting an association between the provider of the service and the manufacturer of the sets. Similar examples were suggested in *Caterpillar Loader Hire (Holdings) v Caterpillar Tractor Co* (1983) 1 IPR 265; 48 ALR 511 by Lockhart J....

I do not consider it essential, in this case, to analyse all the services of the opponent's registrations to determine whether the applicant's designated goods are closely related to those services, suffice it to say that, following the guidelines of his Honour, services such as maintenance and repair are directly performed on tractors (services encompassed in registrations 327454 and 502768) and rental and leasing services are often provided by the manufacturers of tractors or their agents (services covered by registrations 327454 and 327468).

Having regard to the above, I must conclude that the applicant's mark is deceptively similar to the opponent's marks CAT and CAT logo, which are registered in respect of similar goods and closely related services to the goods of this application.

No evidence has been filed by the applicant to satisfy either the provisions of s.44(3) concerning "honest concurrent use" or "other circumstances", or the provisions under s.44(4) relating to use of the mark before priority dates of the opponent's registrations.

From all the foregoing it follows that the grounds of opposition in relation to ss.44(1), 44(3) and 44(4) of the Act have been established.

***S.58 - ownership of the mark***

Mr Kelson submitted that, in the event of a finding that the applicant's mark is substantially identical to the opponent's CAT and CAT logo marks, I should turn my attention to use of the those marks as evidenced in Mr Bolmarcich's affidavit and exhibits. From those documents it could be inferred, he said, that there were considerable sales of various items of equipment, including tractors, prior to filing of the present application and that those sales were made by reference to the opponent's said marks.

It has been well established that, for considerations of the ownership issue in terms of s.58, the applicant's and the opponent's marks must be identical or 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. In discussing the s.44 ground, I decided that the similarities between the marks are too far removed for the marks to be substantially identical or almost identical. Thus, s.58 is not an appropriate ground for the opponent to pursue the ownership question.

***S.60 - reputation of the opponent's marks***

In relation to the issues surrounding this ground, Mr Kelson cited *Nettlefold Advertising Pty Ltd v Nettlefold Signs Pty Ltd* (1997) 38 IPR 495 where, at 501, Heerey J has summarised the relevant case law. Mr Kelson emphasized the extensive reputation of the opponent's marks in Australia, adding that the reputation was bolstered by vigorous trade mark protection and education in trade mark use on the part of the opponent. Referring to some of the supporting declarations and statements, he noted that both the declarants involved in the relevant

industry as suppliers of the opponent's goods as well as those independent of the opponent had consistently expressed a concern that the mark LANDCAT would indicate some connection with the opponent.

Finally, Mr Kelson requested that costs be awarded to the opponent.

The relevant section of the Act reads:

**Trade mark similar to trade mark that has acquired a reputation in Australia**

**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.

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

Note 2: For *priority date* see section 12.

As discussed above, I have found that the applicant's mark is deceptively similar to the opponent's marks CAT and CAT logo. The next step to decide is whether, because of the reputation achieved by the opponent's marks, the applicant's mark, if used in a fair and normal manner in relation to the specified goods, would be reasonably likely to cause deception and confusion amongst a substantial number of persons - *Smith Hayden & Co Ltd's Appn* (1946) 63 RPC 97. The reputation of the conflicting marks is to be determined as at the date of filing the subject application - *Southern Cross v Toowoomba Foundry*, supra. The date of the application is 31 January 1997.

In this regard, I am mindful of the fact that the test concerning deception and confusion set out by Evershed J in *Smith Hayden* has been changed by French J in *Registrar v Woolworths*, supra, as it relates to the 1995 Act. Whereas under the repealed Act, it was for the Registrar to be satisfied that the mark applied for "will not be reasonably likely to cause deception and confusion" to enable the mark to be accepted for registration, under the current Act, the Registrar needs to be satisfied that use of the mark the applicant desires to register will result in a reasonable likelihood of deception and confusion.

The opponent's claim as to the substantial exposure of its marks in Australia is supported by sales value of the heavy equipment reaching well over one billion U.S. dollars during the

short period between 1992 to 1995. Since 1974 many millions of U.S. dollars have been spent on advertising and promoting the opponent's products, the amounts since 1988 being in excess of U.S. 30 million dollars per annum. Although no separate figures covering advertising in Australia have been made available, a number of magazines circulated in Australia have carried advertisements of the marks in relation to heavy equipment. In addition, awareness of the marks has been promoted through distribution of brochures to customers by heavy equipment dealers. I also accept the proposition that a further factor contributing to the enhancement of the marks' reputation could be attributed to the opponent's stringent policy of protecting its trade marks and educating the public on their correct use.

Of the persons who have made the declarations or statements, which constitute part of the opponent's evidence, all but two say that, on seeing the applicant's trade mark they would connect it with the opponent or its related companies. As a number of these declarations are of informal nature and most of the declarants are involved in the sale of the opponent's products or the provision of related services, I am obliged to give them only limited weight. They do, however, suggest that a proportion of persons who have been engaged in the heavy machinery industry for a significant period of time and who claim to be familiar with various trade marks, would be likely to believe that the applicant's goods originated from the opponent.

The applicant has not attempted to rebut any of the opponent's claims either by filing evidence or making submissions. The opponent's evidence adequately demonstrates the huge reputation that attaches to both of the opponent's marks in Australia, at least far as it relates to heavy equipment, amongst the persons who would be interested in and dealing with such goods. Having regard to that reputation and the close resemblance of the marks in question, I think a real, tangible danger does exist that use of the applicant's mark in respect of tractors would be deceptive and confusing to a substantial number of persons. Some evidence of the likelihood of this occurring can be drawn from the declarations and statements to which I have referred earlier.

From what I have said above it is obvious, I think, that the opponent has established its ground of opposition in relation to s. 60.

**Conclusion**

I have found that the opponent has succeeded on all the grounds upon which it chose to rely, except upon the ground based on s.58. Accordingly, the opposition as a whole is successful. I therefore refuse to register the trade mark, the subject of this application.

**Costs**

I do not see any reasons why costs should not follow the result. I order that the applicant pay the costs to the opponent, in accordance with the official scale.

Vija Zars  
Hearing Officer

26 May 2000