



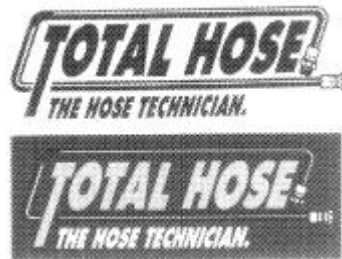
TRADE MARKS ACT 1995

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

Re: Opposition by Total Rubber Services (Aust) Pty Ltd to registration of trade mark application 739458(37) - TOTAL HOSE - THE HOSE TECHNICIAN- in the name of Diana Beth Mooney.

Background

Total Hose (Australia) Pty Ltd filed trade mark application 739458 on 17 July 1997. Registration is sought for two trade marks, to be registered as a series under s 51 of the *Trade Marks Act 1995* ("the act"). The second trade mark is essentially a version of the first, limited to specific colours, yellow and red on a blue background. In black and white, the two trade marks are depicted:



Since the difference is immaterial for present purposes I will, in what follows, deal with the marks as though they were one.

The services specified, in class 37 of the *International (Nice) Classification of Goods and Services*, are: "Repair, installation and maintenance services, being repair, installation and maintenance services in connection with hoses of all kinds, functions and materials".

The Trade Marks Office ("TMO") examined the application and objected that it was, in simple terms, too close to an earlier trade mark, TOTAL HOSE, registered by another person, Total Rubber Services (Aust) Pty Ltd. The conflicting trade mark is registered as number 676460. It is registered in class 17, for rubber and PVC hose, and has a priority date of 30 October 1995.

The applicant for registration provided evidence that it had used its trade mark continuously from a date earlier than the priority date of the conflicting registration. This, the applicant argued, triggered the provisions of s 44(4) of the act and authorised acceptance of the application.

A delegate of the Registrar of Trade Marks, after considering the evidence put in by the applicant, accepted the application for registration. The TMO advertised the pending registration and, as is usual in such cases, advised the earlier registration's owner of this fact. That owner, Total Rubber Services (Aust) Pty Ltd, ("the opponent") opposes registration and has filed a Notice of Opposition.

The parties followed the evidence process set out in Part 5 of the regulations. During this time, the trade mark application changed hands and, once this information was recorded at the TMO, the new owner became, for all current purposes, the applicant. That person is Diana Beth Mooney, and I will refer to her as "the applicant" in the remainder of this decision. The application was originally filed by Total Hose (Australia) Pty Ltd. That company is now the sole authorised user of the trade mark under licence from the applicant, and I will refer to it as "the licensee" in what follows.

The applicant requested that the matter be heard. I conducted that hearing and am to decide the opposition under delegation from the Registrar of Trade Marks. At the hearing, the applicant was represented by Ben Fitzpatrick of counsel, instructed by Lyn Meston-Watson, a solicitor of the firm of Minter Ellison. The opponent was represented by Susan Thompson, also of counsel and instructed by Warren Chandler, a trade mark attorney of the firm of Pipers, Trade Mark Attorneys.

Evidence

The opponent filed and served copies of declarations by John Keays and Reginald Roberts to support its opposition. The Keays declaration incorporates annexures JK1, JK2 and JK4-33. These annexures include an earlier declaration by Mr Keays and a number of supporting declarations that I will come to in due course, including one by Keith Whitbourne.

In answer, the applicant relies on declarations by Charles Mooney, with supplementing trade declarations by John Haynes, E.J. Mullins, Tony Avard, Graeme Smith, Arthur Squires, Chris Pailthorpe and Graham Hart.

In reply, the opponent relies on three more declarations made over time by John Keays, and a second one by Keith Whitbourne.

General observations

With the assistance of the comments of counsel at the hearing, I will set down the basic elements of the evidence that bears on this matter. I will leave more detailed consideration until I deal with the specific issues raised by the opponent.

The opponent's evidence in support

The basis of the opponent's case is in the declarations of Mr Keays, with annexures, some of which are declarations by other traders. Mr Keays is the Managing Director of the opponent, which he initially refers to as being Total Rubber Services Pty Ltd. The opponent is a retailer of a wide range of industrial and automotive hoses, ranging from radiator hoses to welding hose, steel reinforced steam hose and milk tanker hose. It has operated since 1985. At least some of its hoses are branded with the words TOTAL or TOTAL HOSE. The majority of the opponent's price lists and brochures are prominently marked with a logo consisting of the letters TRS beside the words TOTAL RUBBER SERVICES.

It would appear from exhibit JK-6, part of the opponent's evidence, that the applicant's licensee originally traded as Kwickfix the Hose Man. On 6 October 1995, the licensee wrote, apparently to at least one of its customers, to advise of this change of name. The letter states that "This is a name change only, and reflects more our activities with our mobile on-site units". From imprints at the top of this letter, it was either sent to, or otherwise came into the possession of, H.I.S Hose Pty Ltd on 11 October 1995, but there is no evidence at all about how widely the letter was distributed by the licensee.

H.I.S. Hose Pty Ltd is the employer of Reginald Roberts, one of the other people who made a declaration in support of the opposition. Mr Roberts states that his business competes directly with the opponent. Mr Roberts confirms that the opponent has a reputation for its trade in TOTAL branded hoses. He says that employees of his company refer to the opponent's products as Total Hose. He sets out his reaction when he learned that Kwickfix had changed its name to Total Hose the Hose Technician: "I believed that the change of name had been initiated as a result of some form of association or merger with the opponent, leading to the opponent providing a newly formed mobile technical service". Mr Roberts says that he learned that this was incorrect when he raised the matter with Mr Keays.

Mr Keays also refers to the conversation with Mr Roberts. He refers to a similar conversation with Bob Smart, the managing director of Pirtek Pty Ltd., which company he describes as another hose supplier and repairer. However, there is no evidence from Mr Smart.

The applicant's evidence

The principal declaration of the applicant is that of Mr Mooney. Mr Mooney is the managing director of the company that filed the trade mark application and is now the exclusive licensee of the applicant. According to his evidence, the trade mark was first used in connection with the services specified in this application in September 1995. He has exhibited, as part of his declaration, an earlier declaration that he relied on during examination of the application by the TMO. Taking the two declarations together, he states that at the date of adoption of the trade mark, September 1995, his company "was not aware of any of the cited marks". These are identified specifically by number. The earliest of these is 676460, to which I have already referred, which was filed on 30 October 1995. The remaining applications, filed later, are not overly relevant to this proceeding and Ms Thompson did not rely on them at the hearing.

The applicant, through her licensee, provides an on-site plant maintenance and repair service. The licensee, a Victorian company, specialises in servicing and replacement of hose assemblies and fittings for industry in general. The licensee, as shown in exhibit CWM2 of the Mooney declaration, routinely refers to itself as TOTAL HOSE. Its brochure asserts that it provides services to businesses in over 200 industries including aluminium, chemicals, agriculture, beverages, construction and earthmoving. Mr Mooney asserts that applicant's trade mark has a high profile within the relevant trade and that, to the best of his knowledge, there has been "no confusion arising with the goods provided by the opponent under its brand name". It is not entirely clear just where the applicant provides its services, but its supporting declarations come mostly from traders in New South Wales and Victoria, with one from Queensland. Mr Mooney has not said why the trade mark in question was adopted.

The applicant's evidence includes seven declarations that go to the issue of possible confusion of the applicant's marks with those of others. The declarations of Messrs Mullins, Smith, Pailthorpe follow a common pattern. The declarants "are not aware of the use of the trade mark TOTAL HOSE on hoses and (are) therefore not aware of the name of the company who may use this trade mark".

The declarations of Messrs Avard and Squires and Hart are similar, but declare that they are only aware of the use of the words TOTAL HOSE by Total Hose (Aust) Pty Ltd. In Mr Haynes' declaration, the relevant portion (including the text that has been struck out, apparently before signing) reads:

I am not aware of the use of the trade mark TOTAL HOSE on hoses, ~~and am therefore not aware of the name of the company who may use this trade mark.~~

Opponent's evidence in reply

The opponent relies here on three more declarations by Mr Keays. Mr Keays begins by noting that his earlier declaration refers to the opponent as being Total Rubber Services Pty Ltd. He notes in the evidence in reply that this is not strictly correct but declares that "the Opponent refers to itself and is frequently recognised by its clients" in those terms.

The Keays declaration of 21 August 2000 has not been properly witnessed. This is not fatal, as the substance of it is essentially argument, not fact. Mr Keays asserts, and I accept, that various sorts of engineering and machinery sales businesses require the supply, installation and maintenance of hydraulic and other hoses.

The opponent has also shown, in its evidence in reply, that in fact the firms by which Messrs Avard, Mullins and Haynes are employed have all bought hose from the opponent at some stage in the year 2000, as has the applicant's licensee.

The final part of the evidence in reply is the second Whitbourne declaration. This goes to the issue of possible confusion. Mr Whitbourne is the Managing Director of a firm that supplies hand and power tools and engineering and material handling supplies. He declares (underlining present in original):

His company requires the supply of hoses for its activities

It buys these, generally, from the opponent

"I understand that the types of services provided by the applicant in this matter are services that (my company) often requires to be performed upon or by means of hoses(s) supplied by Total Rubber Service (Aust) P/L. I have stated in my previous declaration that I understand hoses supplied by Total Rubber Service (Aust) P/L bearing the TOTAL brand to mean TOTAL HOSE and that Total Rubber Services (Aust) P/L is the source of origin of such hoses

While I am/am not fully aware in this instance of the applicant I believe that not only there is an overlap between the applicants and opponents client base because the goods and services are interrelated, but it is my opinion that if I was to see the trade mark Total hose the hose technician I would be caused to wonder whether it

might be the case that there is a connection between services provided by the applicant and goods provided by Total Rubber Services (Aust) P/L."

I note, however, that the declaration of Mr Whitbourne is not fully executed. While it has been witnessed, the qualification of the witness has not been stated. Perhaps more significantly, I think the substance of the declaration is open to question. It is incomplete, and so is something on which it would be unwise for me to put great weight. The declaration seems to me to have been drafted in words that are not necessarily the true mind of the declarant. Mr Whitbourne, when presented with it for signing, was not sufficiently *au fait* with its substance as to see the need to strike out either "am" or "am not" at the critical and underlined place.

I will also note that nowhere in the opponent's evidence is there any suggestion that it has at any stage suggested to the applicant that it objects to the use, by the applicant, of the trade mark in question.

Issues and decision

The opposition was originally based on a wide range of grounds. However, the matter was finally argued under the headings of sections 44 and 60. Section 44, in so far as it is relevant, reads as follows

Identical etc. trade marks

44 (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.

At the hearing, Ms Thompson based her client's opposition, as it arises from s 44, on trade mark registration 676460. This registration is for the trade mark TOTAL HOSE, in respect of "rubber and PVC hoses". This is the trade mark to which I have already referred. Its priority date is 30 October 1995.

Mr Fitzpatrick conceded, when I put the matter to him at the hearing, that the provisions of s 44(2) are triggered, ie that the marks are, at least prima facie, deceptively similar and the goods and services "closely related" for the purposes of subsection 44(2). On the evidence before me, which suggests that there is some degree of overlap at both the selling and servicing ends of the applicant's maintenance services, any other conclusions would be difficult to justify.

The evidence from the applicant shows that it has continuously used the subject trade marks from at least as early as 11 October 1995. This is before the priority date of the earliest of the opponent's registered trade marks. I therefore find that the provisions of s 44(4) were properly applied. No ground of opposition has therefore been established under s 44.

Perhaps anticipating such a conclusion, Ms Thompson pressed an argument under the terms of section 60. For reasons that follow, it will be efficient to deal with the s 60 issue without going into the applicability of s 44(3).

Section 60:

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.

The questions under s 60 are distinct:

1. Is there a substantially identical or deceptively similar trade mark?
2. Had that trade mark acquired a reputation in Australia at the priority date?
3. Will use of the applied-for trade mark result in deception or confusion because of the reputation of that trade mark?

The opponent can rely on any trade mark, registered or unregistered, for any goods or services. In this case it has used and can rely on three trade marks: the unregistered trade marks TOTAL and TOTAL RUBBER SERVICE and the registered trade mark TOTAL HOSE. I must therefore evaluate the s 60 ground for each of these trade marks.

It will be convenient to start with the unregistered trade mark TOTAL and the very similar registered trade mark TOTAL HOSE. It is appropriate to take these two together because of their obvious similarity and because it is not always clear from the evidence, to which I will come below, just which trade mark is being used at any given time. Accordingly, for the purposes of this aspect of the decision, I will deal with those two of the opponent's trade marks as though they were one. Any reference to the single trade mark TOTAL in what follows should be seen as a reference to either or both of those trade marks.

Deceptively similar trade mark?

Ms Thompson submitted that all of the case law relevant to the comparison of marks under s 44 carries over into s 60. As to the opponent's (unregistered) trade mark TOTAL, the one-word mark that is branded onto hoses, the answer to the first question is "yes", it is deceptively similar to the applicant's mark. Similarly with regard to the registered trade mark TOTAL HOSE. I agree with Ms Thompson's simple submission that the trimmings that differ do not sufficiently distinguish either of the opponent's trade marks from that of the applicant. The word TOTAL is present in both marks and will strongly impress itself on the recollection as the distinguishing element. She noted the decision of the Full Federal Court in *Sports Cafe Ltd v Registrar of Trade Marks* 42 IPR 552. The Court agreed with the decision that the plain word mark THE SPORTS CAFE was deceptively similar to a device mark in

which the elements SPORTS CAFE were a significant, but not a dominant, element. This, she said, was not a case where the elements not in common were enough to differentiate the competing trade marks. This case, she argued, and I accept, can be distinguished from *Registrar of Trade Marks v Woolworths*, 45 IPR 411 where the differing element (WOOLWORTHS) tellingly distinguished one trader's mark from the other's.

Reputation?

I set out the relevant definition of "reputation" for the purposes of s 60. According to Kenny J, in *McCormick & Company Inc v McCormick* [2000] FCA 1335:

[I]t is true that the assessment of the reputation of a trade mark goes far beyond mere examination of sales or turnover of goods sold under that trade mark and contemplation of the advertising and promotional figures. As regards a trade mark, its reputation derives both from the quantum of sales under that mark and also the esteem, or image, projected by that trade mark. The quantum of sales, advertising and promotion contributes to the 'recognition' component of the trade mark's reputation. The credit, image and values projected by a trade mark attaches to the 'esteem' component of the reputation as do the public events and other trader's marks with which [the] owner of the trade marks in question chooses to associate the trade marks via sponsorships, cross-promotions, 'contra deals' and so forth.

It follows that a trade mark used in relation to goods with comparatively low sales may have a high and strong reputation by virtue of the high credit or esteem in which it is held or, conversely, that a trade mark which has very high sales may have a strong reputation notwithstanding the lack of esteem that attaches to it. The particular popular images, or sets of values, that attach to the trade mark are also, therefore, important parts of the reputation of the trade mark and may be as strong an associative force in the minds of the public as the association of the trade marks with the goods or services themselves.

In practice, it is commonplace to infer reputation from a high volume of sales, together with substantial advertising expenditures and other promotions, without any direct evidence of consumer appreciation of the mark, as opposed to the product: see, e.g., *Isuzu-General Motors Australia Ltd v Jackaroo World Pty Ltd* (1999) 47 IPR 198; *Marks & Spencer plc v Effem Foods Pty Ltd* (2000) AIPC ¶91-560; *Photo Disc Inc v Gibson* (1998) 42 IPR 473; and *RS Components Ltd v Holophane Corp* (1999) 46 IPR 451.

I now turn to the evidence in detail, starting with the Keays declaration. Mr Keays is the Managing Director of the opponent. He has, in his first declaration, set out sales and advertising expenditure for 'hoses under the trade mark "Total"'. Those figures are impressive. Without being too specific, the stated sales figures first rose above one million dollars in 1987 and above three million dollars per year in 1996. However, I am not entirely

satisfied, for reasons to which I will come, that all of the hoses referred to by Mr Keays were sold under that trade mark (TOTAL) or by reference to the trade mark TOTAL HOSE.

It is not clear just when the opponent started to supply hoses that were unambiguously branded either TOTAL or TOTAL HOSE. Exhibits JK4 and JK5 are relevant here. As Mr Keays describes them:

Exhibited hereto as exhibit JK4 is a copy of a letter sent from HS R&A Co. Ltd., a rubber and automotive company in Korea indicating their knowledge of first use of the "Total" brand on or in relation to hoses commencing on March 1990.

Exhibited hereto as exhibit JK5 is a copy of a letter from HS R&A Co. Ltd., a rubber and automotive company in Korea indicating that they have been supplying rubber hoses to Total Rubber Services Pty. Ltd. bearing the brand "Total" at both ends (excluding water suction hoses, water discharge hoses).

Those letters are not written to Mr Keays or his company and, were it not for Mr Keays' strong assertion, they would appear to have little connection with this matter. The writer is identified only as Charlie, of HS R&A Co. Ltd., a rubber and automotive component company in Korea. The letter is written to Mr Don Moon, the managing director of a company called Sunmoon Pty Ltd, a company whose location and connection with the matter are not clear to me. The letters say that the Korean company has supplied hoses, with the exceptions specified, "branded TOTAL HOSE at both ends" since March 1990.

Similarly, Exhibit JK20 shows that the supply to the opponent of rubber layflat hose branded TOTAL LAYFLAT probably commenced in January 1993.

Consistent with this, I note that a price list (JK18) dated February 1990 does not distinguish between hoses marked either TOTAL or TOTAL HOSE and those that are not. Exhibit JK19 is similar but undated. The only trade marks on the price lists are the name of the opponent and its TRS logo. The document lists a wide range of applications and includes a reference to GOODYEAR ORTAC HOSE. I find it curious that neither the trade mark TOTAL nor TOTAL HOSE is mentioned. It is at least as likely that the exhibit is simply a catalogue of various hoses that are for sale from the opponent in its role as a retailer using, as a trade mark, the name of the opponent company, sometimes shortened to TOTAL RUBBER SERVICE. I infer that the goods may have been unbranded or sourced from a variety of manufacturers and thus bearing the trade marks of those manufacturers.

I reproduce here the cover pages of JK18 and JK19:

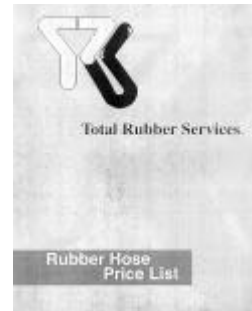


Exhibit JK25 is a promotional brochure, apparently a current one since it refers to an event in 1981 as being of 20 years past. It confirms that the opponent sells products bearing a number of trade marks that are clearly not the opponent's. Mr Keays asserts, despite this, that this is an exhibit "wherein the TOTAL brand name is displayed prominently in close relation with sub-headings such as Rubber Hose, PVC hose, Irrigator Hose". However, where the word TOTAL is used it is typically, as on the cover, an emphasised part of the words **TOTAL RUBBER SERVICES** together with the TRS logo. Inside the brochure, in expressions like "the **Total** Commitment to Growth", it is use in a context where Total Rubber Service is already clearly understood.

I therefore think that Mr Keays, while speaking honestly, is not speaking with precise legal accuracy when he asserts that this is a use of the trade mark TOTAL in relation to hoses, either for a trade in goods or in relation to retail services. I think that, when Mr Keays set out 'the value of sales of hoses under the mark "Total"', he may have set out figures for the sale, by the opponent, of hoses in general. This may have been under the broad banner of Total Rubber Service or some similar trade mark that contains the word TOTAL but such actions not amount to the use of TOTAL as a badge of origin of either goods or services.

I am, however, prepared to leave this aside for the moment. I accept, from the evidence in general, that the opponent does and has supplied a reasonable amount of hose that is in fact branded TOTAL. Secondly, the opponent's supporting declarations attest to a reputation in the trade mark TOTAL. As Mr Clifford puts it, in exhibit JK1, dated "23rd day of 1999(sic) 1999":

We have certainly and distinctively come to associate the brand "Total" with hoses supplied by Total Rubber Services Pty Ltd (the opponent). It is quite natural and automatic for me to think of "Total" and industrial "hose"

conjunctively and in direct association with supply from Total Rubber Services Pty Ltd.

In other words, the reputations of the trade marks TOTAL and TOTAL HOSE were, by some time in 1999, when the declarations were made, enhanced by the knowledge that this trade mark denotes goods from the opponent. The opponent is a long-established firm that trades under the trade mark TOTAL RUBBER SERVICE, a firm with which the various declarants had been doing business since roughly 1989. This knowledge, that the opponent firm is the source of the goods, is an integral part of the reputation of the opponent's trade marks TOTAL and TOTAL HOSE, when used for a trade in goods. The other declarants to whom Mr Keays has referred, and on whom the opponent relies, similarly attest to a flow of the opponent's reputation into that of the trade mark TOTAL.

This flow, however, can only achieve so much. The opponent's declarants attest to a reputation reinforced, both now and in 1999 when they made their declarations, by knowledge of the business of the opponent. No matter how solidly they do this, they have not sufficiently addressed the reputation of the trade marks TOTAL and TOTAL HOSE as at the priority date in July 1997. What the reputation of these trade marks was, jointly or separately, at that time, is a matter of guesswork. My uncertainty about just how extensively those actual trade marks had been used, and over what time, exacerbates this. The weight of the evidence is that, while customers may identify TOTAL hoses with the opponent, the trade mark that has been primarily used for the retailing of hoses is not TOTAL but TOTAL RUBBER SERVICES or TOTAL RUBBER SERVICES (AUST) PTY LTD or some similar variation such as the TOTAL RUBBER SERVICES PTY LTD referred to by Mr Keays.

Therefore I find that the opponent has not established a reputation in the trade marks TOTAL and TOTAL HOSE, at the priority date, with any degree of clarity. However, despite the sketchy picture painted by the evidence, and my doubts about the extent of the reputation that such evidence can establish, it is necessary to complete the third leg of this analysis.

Likelihood of deception?

Mr Fitzpatrick, for his part, argued that the opponent had simply not met its evidentiary onus. There was no convincing survey evidence, for example. There was no evidence that anyone who was a customer of either the applicant or the opponent had been deceived. This was, he said, remarkable because the evidence showed that the applicant's mark had been in use since

September 1995 - here, he referred to the changing of name of the Kwickfix business - and the opponent had been aware of this since about that time.

Mr Fitzpatrick argued that the adoption of the mark by the applicant had been open and honest, and widely communicated to the trade. Despite this, the only clear first-hand evidence that anyone had been confused was, he said, in the Roberts declaration, but Mr Roberts was not, in fact, a customer of either firm so much as a competitor of the opponent's.

He also argued that, although there was clear evidence that the opponent was aware of the use, it had taken no action to stop it and, indeed, had been content to sell TOTAL hoses to the applicant. Such acquiescence argued strongly, he said, that there was little practical risk of deception or confusion.

He said that one likely reason for this was that the opponent accepted that it could not assert a monopoly in the word "total". He pointed to the way the opponent itself had used "total" in what he said was a descriptive way: JK25 to the Keays declaration, to which I have already referred. Mr Fitzpatrick drew my attention to examples such as (emphasis and capitalisation present in original): "The **Total** Source for all your Industrial Rubber Needs", "allowing us to offer a complete Total Hose Service" etc.

Ms Thompson was dismissive of this. It did not, she said, prove that "total" was a directly descriptive word. She noted the emphasis and capitalisation used by the opponent and argued that to see the usage in evidence as descriptive was to miss the entire point of the purpose for which the words were being used. It seems to me that, while the word "total" can be bent to suit a descriptive purpose, Ms Thompson is right. TOTAL is a word that is inherently adapted to distinguish and I accept that it has sometimes been so used. I have already said that the relevant use of words as a trade mark for hoses in JK25 is TOTAL RUBBER SERVICE, but there is, in other exhibits, use of the word TOTAL alone. The fact that the opponent can also create a play on words in JK25 does not refute the trade mark function, in other places, of the word in question.

Ms Thompson noted that there is no requirement in law that an opponent produce actual instances of deception or confusion, though such evidence existed here. As to acquiescence, it was true that the opponent had not taken court action to stop the applicant using its trade mark. However, she noted that this should not, in principle, have a bearing on an opposition

conducted at the Trade Marks Office. The opponent was vigorously prosecuting the opposition and was entitled to have it decided on its merits.

Mr Fitzpatrick stressed the weight that should be put on the evidence of the applicant's declarants. This, he said, would go some way to negating the possibility that there was, in practice, deception or confusion. Concerning these, Mr Keays has implied in his evidence, and Ms Thompson argued at hearing, that there is something contrived, or deliberately careful, in the what she said was the applicant's reliance on declarations that postulate the (non-existent) TOTAL HOSE as a conflicting brand. She argued that this was very questionable when the opponent's mark, according to Mr Keays, is TOTAL, solus.

It would be surprising, Mr Fitzpatrick said, if I concluded that those declarations were carefully worded: the charge normally levelled at evidence that was to be devalued by a deciding officer was that it was carelessly prepared. I agree with him to an extent. I do not conclude that the declarations are artfully worded so as to divert the matter onto the recognition of another trade mark. I have already said that I do not share Mr Keays's view that the opponent consistently uses the trade mark TOTAL, solus. There is clear evidence in JK 4 and 5 that at least some of the opponent's hose was branded TOTAL HOSE or TOTAL LAYFLAT. Therefore, I believe I can give the applicant's supporting declarations some weight, though obviously they are not tendered as a representative sample.

On the other hand, the firms that employ Messrs Avard, Mullins and Haynes have, at least in recent times, been customers of the opponent. I could give their declarations more weight if they went to the perceptions of the declarants now that they are aware, or have some chance of being aware, of the allegedly conflicting mark. As matters stood at the time they made their declarations, the fact that they were unaware of the opponent's trade mark, and therefore unlikely to be deceived or confused, is far from reassuring about the likelihood of deception or confusion among others who might encounter one trade mark while knowing of the other.

Ms Thompson noted the evidence that, in fact, there was deception or confusion (Roberts declaration, second Whitbourne declaration and the alleged conversation with Bob Smart of Pirtek.) She noted that there was no onus on an opponent to prove that there had been actual instances of confusion. She said that I could rely on the extent of the opponent's use, in a specialised industry, to have generated a reputation in the trade mark and to have so prepared the ground as to make deception or confusion sufficiently likely.

Conclusions re s 60

On balance, I am not satisfied that there was, at the priority date of the opposed application, a significant risk of deception or confusion attributable to the reputation of the trade marks TOTAL or TOTAL HOSE.

I appreciate Mr Fitzpatrick's argument that I should set the section 60 bar high in this case, so as not to allow the opponent to claim too broad a monopoly in a word that is capable of uses other than trade mark use (*Hornsby Building Information Centre Pty Ltd v Sydney Building Information Centre Ltd*, (1978) 140 CLR 216). I have done this to the limited extent necessary for a word such as TOTAL. However, I think it is also important that the height of the bar for section 60 should reflect that it is a ground of opposition based on likelihood, not simply on inferences and speculations.

In *Registrar of Trade Marks v Woolworths*, 45 IPR 411 at 428, French J restated the tests for deceptive similarity which stem from *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592. Of particular relevance is this:

A trade mark is likely to cause confusion if the result of its use will be that a number of persons are caused to wonder whether it might not be the case that the two products or closely related products and services come from the same source. It is enough if the ordinary person entertains a reasonable doubt.

It may be interpolated that this is another way of expressing the proposition that the trade mark is likely to cause confusion if there is a real likelihood that some people will wonder or be left in doubt about whether the two sets of products or the products and services in question come from the same source.

This reflects, of course, the changed onus under s 44, which initially applies in ex parte matters, prior to the acceptance of an application for registration. I do not believe that French J was suggesting, in referring to "some people", that it would be sufficient if a mere handful of people would be left in doubt. Firstly, I do not believe that he was attempting to modify his previous stipulation, for which there is long-standing authority in a case to which he had just referred, that the doubt that must afflict the "ordinary" person must be a "reasonable" one. Secondly, the formulation requiring that the number of people affected by doubt or confusion be "substantial" has been repeatedly endorsed. The only thing that has shifted is the onus, not the benchmark. The benchmark comes from *Smith Hayden's application* (1946) 63 RPC 97 and *Kendall Company v Mulsyn Paint and Chemicals* (1963) 109 CLR 300 at 305, where Kitto J repeated and expanded what he said in *Southern Cross*. He added the

reference to "substantial" as an express adoption of that formula from comparable UK decisions subsequent to *Smith Hayden*.

I consider that there is a similar issue under Part 5 of the act, where an opponent carries a responsibility of establishing, to the necessary extent, a ground of opposition.

I do not think that s 60 can be seen merely as some sort of recasting of s 44 without stipulations as to either the registration of the allegedly conflicting mark or the overlap or otherwise of the competing goods or services. Section 60 is a ground of opposition, and a powerful one. The Federal Court has said, *McCormick*, supra, that s 44(3) is not a shield against the application of s 60. I presume, therefore, that the same conclusion should apply to s 44(4). Notionally, if either s 44(3) or 44(4) applies then, in terms of s 44(2), there must already be a conflict. In the present case it is between the applicant's trade mark and the opponent's registered mark, TOTAL HOSE. I cannot therefore accept that, to win an opposition, all that the opponent needs to do is point to a reputation in a (very similar but unregistered) trade mark and to the possibilities that are already inherent in any section 44(4) acceptance. There must, in addition, be sufficient ground for a belief on my part that deception or confusion is

- not only possible but also sufficiently likely and
- attributable to a reputation in the conflicting trade mark.

I do not rule out all possibility of confusion, but I am far from satisfied that there is any significant likelihood of this, or that, if it exists, it is attributable to a reputation in the trade marks TOTAL or TOTAL HOSE extant at the date the present application was filed. I therefore find that no ground of opposition has been established under s 60 in relation to the trade marks TOTAL and TOTAL HOSE.

Remaining Trade Mark: Total Rubber Services

Here the threshold question is the deceptive similarity of the trade mark TOTAL RUBBER SERVICES, which I find has been used as a trade mark on at least some of the opponent's material. I note, however, that Ms Thompson did not press this trade mark as giving rise to a ground of opposition. It is one to which I turn simply to fully consider the matter.

The applicant's trade mark is, in black and white:



I do not believe, in deciding the question of the deceptive similarity of these two allegedly conflicting trade marks, that I can take any account of the reputation of the opponent under its trade mark. The comparison of the marks is an abstract one. It may well make good sense for people such as Mr Roberts, whose evidence is on file, to think that expansion into the delivery and installation of hoses is a logical move for a large business such as the opponent. That, however, is not part of the threshold question posed by s 60 and does not render the two marks deceptively similar.

The proper abstract question requires me to allow for the ordinary levels of imperfect recollection of the opponent's trade mark TOTAL RUBBER SERVICES when comparing that mark with the applicant's, or vice versa. I think I should also allow for the fact that one trade is used for the retailing of hoses, the other for a slightly different activity, the installation and maintenance of them. This as one of the "surrounding circumstances" referred to in *Pianotist* trade mark (1906) 23 RPC 774 or 1A IPR 379. Though not a feature of the marks, it certainly intrudes directly on their comparison. The relevance of *Pianotist* formulation was endorsed by the High Court in *Cooper Engineering Co Pty. Ltd. v. Sigmund Pumps Ltd* (1952) 86 CLR 536.

Even if I exclude that factor, the two trade marks are visually and conceptually sufficiently different to an extent that no ordinary person could incorrectly take one for the other or be left in any doubt as to their differences. The differences also outweigh the commonality of the word TOTAL to the point where, once the question of the opponent's reputation is deliberately excluded, nobody would expect that the mere presence of the word TOTAL in both marks was likely to be an indication of some connection or common source. Without more, I see no reason why any ordinary person would expect any connection at all between the source of the TOTAL HOSE service, under the mark as applied for, and the opponent's TOTAL RUBBER SERVICE business.

Therefore, there can be no question of this trade mark of the opponent giving rise to a ground of opposition under s 60.

Decision and Costs

I have not found that any ground has been established under s 60. In addition, I have found that the application was rightly accepted under the provisions of s 44(4). My decision, therefore, is that:

- The application should be registered unless, within one month of the date of this decision, the opponent serves on the Registrar a copy of a notice of appeal. If such a copy is served, I direct that registration not occur until the appeal is either dismissed or discontinued.
- The opponent pay the costs of the applicant to the extent of the official scale.

Terry Williams
Hearing Officer
29 June 2001