



TRADE MARKS ACT 1995

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

Re: Opposition by Arturo Salice SpA to registration of trade mark application 752998(6) - SALICE - filed in the name of Nikpol.

Background

This issue arises out of the filing, on 20 Jan 1998, by Nikpol Pty Ltd (Nikpol) of application 752998 to register the trade mark SALICE in Class 6 of the International (Nice) Classification of goods and services for the goods:

Cupboard and door hinges, metal building materials, runners for drawers, small items of metal hardware, furniture hinges; all the foregoing being goods in this class

On 24 April 2000 the application was accepted for registration and advertised as such on 21 May 1998. On 21 August 1998, Arturo Salice SpA (Arturo) filed Notice of Opposition to the registration of the trade mark. Arturo's evidence in support of the opposition was lodged on 11 March 1999. Nikpol did not file any evidence in answer.

The issue came before me to be heard in 28 October 1999 and Arturo was represented by Mr Wayne Willis of F B Rice & Co, Patent and Trade Mark Attorneys of Sydney. Representations in the issue were made by telephone attendance.

The submissions were in terms of section 58 of the *Trade Marks Act 1995* (the Act) and their thrust will become apparent from my reasons.

The evidence

The evidence in support of the opposition consists of one statutory declaration which is by Luciano Salice (the declarant) and shows that Arturo has been using the trade mark SALICE in respect of furniture hinges in Australia since 1979 via agents in this country. The

declaration exhibits both sales figures and invoices for the years 1994 to 1997 relevant to the sale of their goods in Australia.

Reasons

Section 58 of the Act provides:

Applicant not owner of trade mark

58. The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Note: For *applicant* see section 6.

The principle flowing from *Re Hicks' Trade Mark* (1897) 22 VLR 636; 3 ALR 75 and confirmed in other cases such as *Shell Co of Australia Ltd v Rohm & Haas Co* (1949) 78 CLR 601; [1949] ALR 661 is that ownership (the same as 'proprietorship' under the *Trade Marks Act 1555*) is established by showing prior authorship of the same trade mark and prior use in respect of the same kind of thing. In the absence of any evidence of the prior use of the applicant's trade mark, the 'prior use' is to be ahead of the priority date of this application: 20 January 1998. In *Carnival Cruise Lines Inc v Sitmar Cruises Limited* (1994) 31 IPR 375, Gummow J speaking of the decision in *Shell, supra*, said:

When the decision is understood in this way, it does not supply any general authority for the proposition that in the case of disputed claims to proprietorship under the present statute anything less than substantial identity between the two marks will suffice. The phrase "substantially identical" as it appears in s 62 (which is concerned with infringement) was discussed by Windeyer J in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 at 414. It requires a total impression of similarity to emerge from a comparison between the two marks. In a real sense a claim to proprietorship of the one extends to the other. But to go beyond this is, in my view, not possible. There is, as Mr Shanahan points out in his work, p 158, real difficulty in assessing the broader notion of deceptive similarity in the absence of some notional user in Australia of the prior mark (something postulated by s 33) or prior public recognition built up by user: s 28 (a).

In *Shell, supra*, at 629, Dixon J observed of 'authorship':

... it involves the origination or first adoption of the word or design as and for a trade mark. This is well brought out by the Victorian case of *Re Hicks' Trade Mark* (1897) 22 VLR 636; 3 ALR 75, which was decided on legislation in much the same form as the English Act of 1875. Hicks had obtained registration of the word "Empress" for stoves. A stove the design of which had been registered had been sold under the name Empress by the predecessors in title of Metters Brothers. Metters Brothers moved to rectify the register by expunging Hicks' trade mark. For Hicks it was argued that prior user by him was unnecessary and that by registration he had made himself proprietor of the mark. In the course of the argument Holroyd J said:

A person cannot be properly registered unless he is the proprietor. Proprietor is the person who at the moment he makes application to be registered is entitled to the exclusive use of the name, whether he then or before publicly adopted it. A man cannot be said to have adopted a name if someone else has done so before him. Section 19 merely says that the act of applying is to be deemed equivalent to public user. No one could otherwise be entitled to registration as proprietor unless he had publicly used the trade name before. The section does not affect the fact that another person used the name first. The difficulty here is that although Hicks may have by virtue of his application publicly used the name, someone else publicly used it before him.

The evidence in support of this opposition shows that Arturo has had 'authorship' and use of the identical trade mark prior to the priority date of the application in respect of goods which are encompassed within the specification of goods of the opposed application. While I am mindful that the opposed application can be successfully opposed only to the extent of 'the same kind of thing' as far as the goods are concerned, I have no argument from the applicant as to what goods within its specification do not constitute 'the same kind of thing'. It would seem that the specific goods on which the applicant has use of the trade mark, door hinges, are in any case captured by the general expressions "metal building materials" and "small items of metal hardware". I have had no argument from the applicant on how these expressions could be restricted to avoid the 'same kind of thing' as 'door hinges'; or, whether "runners for drawer" are the same kind of thing as metal hinges. I do not see my role as being an advocate on behalf of the applicant and will in the absence of argument to the contrary, accept the opponent's position that the goods of Nikpol and Arturo are 'the same kind of thing'.

Decision

The opposition is successful and I refuse to register 752998 in its entirety.

Costs

Arturo has been successful and is entitled to its costs in this matter, which I award against Nikpol.

Ian Thompson
Hearing Officer

4 April 2000