



TRADE MARKS ACT 1995

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

Re: Opposition by Hutchison Whampoa Enterprises Limited to registration of trade mark application 782614(9 and 42) - **IDOM AND DEVICE** - filed in the name of IDOM Australia Pty Limited.

Background

IDOM Australia Pty Limited (the applicant) filed the above numbered application on 11 January 1999 in class 42, in respect of 'computer consultancy, computer programming, computer software' for the trade mark represented below.

IDOM

During the course of examination, the application was amended so as to include goods in class 9 as being part of the original claim made in class 42. The examiner had also cited four registered trade marks (in the name of the present opponent) as conflicting with this application and so preventing its acceptance. The applicant, however, provided a declaration with exhibits indicating that the mark has been used continuously from a date prior to the application date of the four conflicting registered marks. This material enabled acceptance of the application, with an endorsement to indicate that the provisions of s.44(4) applied to its acceptance.

The advertisement of the acceptance of the application was made in the *Australian Official Journal of Trade Marks* (the Journal) of 27 May 1999. At that time, the specification of goods and services read:

'Computer software' in class 9; and 'Computer consultancy, computer programming' in class 42.

Hutchison Whampoa Enterprises Limited (the opponent), on application, were granted an extension of time to file a notice of opposition and, within the time allowed to do so, filed its notice on 23 November 1999. Thereafter, the opponent served evidence in support and the applicant served evidence in answer in the matter. In December 2000, the parties apparently attempted to negotiate a settlement in some manner but this did not come to fruition. Following this endeavour, both parties had the opportunity to request to be heard in the matter but failed to take up the option. It has now been directed to me for decision.

The Evidence

The opponent's evidence in support consists of a single declaration from Trent Czinner, Legal Manager of Hutchison Telecommunications (Australia) Limited ('HTAL'). In his declaration Mr Czinner states that HTAL is authorised to use the opponent's registered device trade mark, a representation of which is shown below.



This trade mark is registered under numbers 580593(9), 580594(16), 580595(38) and 580596(42). The exhibits to the declaration show that use of the opponent's mark is, apart from one item, always in conjunction with the words 'Hutchison Telecoms' in advertising, point of sale information and promotion, invoices, company worksheets, pricing quotations, purchase orders, cheques, service alteration forms and sundry agreement forms. The one item, on which the above mark is used, solus, is a copy of an extract from a 'Terms and Conditions' document. Mr Czinner attests that the mark has been used in all mainland States and Territories of Australia, and he also provides annual revenue and advertising expenditure for the calendar years 1996 to 1999 inclusive.

The applicant's evidence in answer comprises a single declaration from Alan John Lyons, the Managing Director of the applicant company. He asserts that the applicant has used its mark from 8 January 1992. Mr Lyons's declaration has copies, as exhibits, of promotional material

as used on the opponent's website in December 1999, June 2000 and December 2000. Mr Lyons also outlines the nature of the applicant's business interests.

Submissions

From the time when both parties were offered the opportunity to be heard, not only did they fail to take up that option but neither party chose to file any written submissions to support their case. However, both parties had previously written to this Office making various claims concerning this opposition. I do intend to consider all of this material on file as supporting written submissions in the matter. The correspondence that I refer to here is as follows:

- a letter dated 10 September 1999, from the opponent, prior to the notice of opposition being filed, requesting that acceptance be revoked,
- a letter dated 8 December 1999, from the applicant, contesting the grounds of opposition relied upon by the opponent,
- a letter dated 29 June 2000, from the applicant, commenting on the opponent's evidence in support.

The opponent asserted that the acceptance should be revoked on the basis that there was 'an error or omission in the course of the examination' process. The opponent had obtained a copy, under Freedom of Information legislation, of the evidence of use filed by the applicant to establish its claim of 'prior continuous use' of its trade mark, under s.44(4). The opponent challenged that this evidence did not show prior use because it did not indicate that the device portion of the applicant's mark had been used adjacent to the word IDOM. In addition, the opponent also charged that brochures submitted to support the applicant's claim were undated and that the e-mail address quoted by the applicant in this evidence was not registered until September 1998 - although the applicant claimed use of the mark from 8 January 1992.

The final challenge from the opponent here, was that there were no advertising or sales figures provided to support the claim of use of the applied for mark, prior to the date of registration of the opponent's marks, on 17 June 1992.

The applicant, in its written submissions, claims that the presently applied for mark and the opponent's mark are not similar and discusses in great detail a comparison of the marks. The applicant has also commented that, not only are the marks significantly different but that the business interests of the parties are also diverse. The applicant states that it is in the field of IT consultancy, mainly in the financial sector, with an interest in designing, developing and implementing software and software packages. The applicant has also claimed that the opponent's business lies in developing communications systems such as mobile telephones.

Discussion

The notice of opposition listed grounds under s.57 of the Act in terms of ss.39, 41, 42(b), 43 and 44, and also grounds under ss.58, 59, 60, 62(a) and 62(b). However, with respect to the grounds under ss.39, 41, 42(b), 43, 58, 59 and 62(a), I can find no support in either the evidence or in the written submissions and, in respect of those grounds, I find that opposition is not successful. The opponent's evidence does, however, go toward supporting grounds taken under ss. 44 and 60, and the opponent's earlier written submissions could also be interpreted as arguing the ground under s.62(b). These three grounds, then, become the focus for the remainder of this decision and will be treated in that order.

(a) Section 44 - Identical etc. trade marks

The legislation, insofar as it is relevant to the present matter allows:

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;

.... 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;
 - 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)

(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.

There are four trade marks on which the opponent seeks to rely to establish this ground of opposition. Each is registered in respect of the 'four squares' device represented in the **Evidence** section above. These registered marks are 580593(9), 580594(16), 580595(38) and 580596(42). All four have a priority date of 17 June 1992.

In the majority of cases, where a comparison is to be made under s.44, it is useful to compare the goods and/or services of the respective competing marks before comparing the actual trade marks involved.¹ In the present case, however, for reasons that will become apparent, I intend to consider the comparison of the marks first.

As set out in s.44(1) and (2), I must determine whether or not the respective marks are either substantially identical or deceptively similar.

¹ *Registrar of Trade Marks v Woolworths Limited* 45 IPR 411 at 425.

In relation to the accepted test for substantial identity of trade marks, this has been set out in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* 109 CLR 407 at 414 where Windeyer J said:

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.

For the sake of this side by side comparison, I once again reproduce these marks.

The applicant's mark.



The opponent's marks.



The most striking difference between these trade marks concerns the existence of the 'word' IDOM in the applied for mark, without any corresponding attribute in the opponent's marks. I believe that such a singular feature totally outweighs the similarities of the respective devices in these marks. The 'total impression of resemblance' that emerges is, in my view, not one approaching identity and, thus, I find that these marks are not substantially identical.

The test for deceptive similarity of trade marks is expressed in different terms. This is set out in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407 at 415, where Windeyer J said:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in 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 impressions that such persons would get from the defendant's television exhibitions.

Moreover, because the marks are not being seen side by side, another factor must be considered. This factor was referred to in *Rysta Limited's Application* (1943) 60 RPC 87 where Luxmoore LJ held at 108 that:

It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution.

The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

The opponent's registered marks, of course, do not have word elements that may be imperfectly recollected but instead, consist of a device. The impression left in mind by the opponent's device, in my opinion, will likely be one of two images. Either it will be recalled as a simple black square divided equally into four smaller squares or, for some, the joining of the top two smaller squares will be recalled because it is an unusual feature in the context of that mark. For a small number of careful observers of trade marks, the letters 'HT' may be recalled from the opponent's mark (the H formed by the black squares and the T from the white lines in between). The applicant's mark, I believe, will not present any such attributes. The impression for the vast majority will simply be the 'word' IDOM and the device element will not be readily recalled at all. It is by means of the 'word' IDOM that the applicant's goods will be referenced and that part of the mark will dominate the device element. For some others, if the device is remembered at all, the memorable feature will be the square in the lower right 'falling' away from the other three. I do not believe that prospective purchasers would be satisfied, in the marketplace of today, to rely on an unembellished simple square device as the trade mark of any trader. Where a trade mark consists of a relatively simple looking geometric shape, prospective purchasers are more inclined to scrutinise the mark and look for, and recall, a minor variation in the mark to ensure that they can identify the trade source.

I do not believe that the impression left by the opponent's 'squares' device mark will be recalled in a manner sufficiently similar to the applicant's mark, to override the effect of the 'word' IDOM, to result in a 'reasonable likelihood of deception or confusion among a substantial number of people'². In addition, the comments of Justice French in *Registrar of Trade Marks v Woolworths Limited*, supra, at 426 and 428 indicate that I would need to be

² *Smith Hayden & Co. Ltd's Application* (1946) 63 RPC 97 at 101.

'satisfied' of a reasonable likelihood of deception or confusion occurring, rather than a mere possibility, in order to find the respective marks to be deceptively similar. I am not satisfied that this would be the case.

From the above, I find that the respective marks of the applicant and the opponent are neither substantially identical nor deceptively similar. Several consequences flow from this conclusion. One is that it is not now necessary to consider whether or not the goods and services of each party are similar. Another is that this ground of opposition has not been established. A third is that the applicant does not require the provisions of s.44(4) to be applied in order for the mark to proceed.

(b) Section 60 - Trade mark similar to trade mark that has acquired a reputation in Australia

Under this opposition ground the Act reads:

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 threshold test involved here is that the respective marks of the applicant and opponent are found to be either substantially identical or deceptively similar. From my consideration under s.44 above, I have already found these marks not to be so. Thus, opposition under this ground I also find to be not successful.

Notwithstanding this finding, I also intend to briefly mention another matter in connection with s.60. This section of the Act places an onus on the opponent to show that its mark has acquired a reputation such that use of the applied for mark will be likely to cause deception or confusion. Exhibits 'TC1' to 'TC5' inclusive to the Czinner declaration show 25 separate uses of the opponent's mark. However, in 24 of these, the words HUTCHISON TELECOMS are displayed in bold lettering, in association with the device mark. In my opinion, the words here provide the 'heart' of the trade mark of the opponent for which a reputation is claimed. The applicant's composite IDOM mark could not be considered deceptively similar to the opponent's composite HUTCHISON TELECOMS mark by any measure. In these

circumstances, even had I found the applied for mark deceptively similar to the opponent's device mark alone, because the acquired reputation lies in the opponent's composite mark, I would not have found that deception or confusion would be likely as a result of use of the applied for mark.

(c) Section 62(b)- Application etc. defective etc.

Firstly, I must stress that the opponent did not actively pursue this ground of opposition in its evidence, but for the sake of completeness - because neither party provided written submissions at the end of the evidence process - I intend to briefly discuss this issue. This subsection of the Act allows:

62. The registration of a trade mark may be opposed on any of the following grounds:

(a)

(b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

Note: For *file* see section 6.

Shortly before Hutchison Whampoa Enterprises Limited (HWEL) became the opponent by filing the notice of opposition, its agent wrote to this Office with the claim that the acceptance for registration of this application ought to be revoked. HWEL made this claim on the basis that the endorsement that had been placed on the Register for this application had been wrongly made, because the applicant's prior use of the mark had not been adequately shown in its evidence.

HWEL argued that the applicant's evidence of use fails to establish the use of the composite mark from 8 January 1992 because it is not clear whether the device element in the mark had been used from that time. The agent also claimed that brochures annexed to the applicant's declaration referred to an e-mail address that had not been set up until September 1998. HWEL then asserted that the only evidence to support such use was the statement of Mr Lyons in his declaration setting out the history and use of the mark.

The examiner wrote to the agent, setting out the onus placed on an applicant where it seeks to obtain an acceptance by means of s.44(4) and stating that the applicant had met the prerequisites. The requirements here are not burdensome and are set out in Part 28 of the *Trade Marks Office Draft Manual of Practice and Procedure* at 3.3 with the words:

Evidence should consist firstly of a leading declaration usually provided by a competent member of the applicant organisation. It should contain a history of the trade mark with information as to the first known use of the trade mark by the applicant or the applicant's predecessor, and evidence that, since that time until the priority date of the application, use on the goods or services in question has been continuous.

The examiner provided the agent with quite correct information on this issue for the examination setting. However, had HWEL, when it later became the opponent in this matter, chosen to go on with the issue of evidence to prove its prior use of the mark, it would have arguably had a case. The evidence provided pre-acceptance might have met the requirements to gain acceptance but may not be sufficient to meet a challenge in an opposition matter. The evidence showing use, as at 8 January 1992, is only circumstantial. The agent's challenge that 'brochures annexed to the applicant's declaration referred to an e-mail address that had not been set up until September 1998' is only partly correct. This is because one of the attached documents, a ten page booklet which details the history of 'THE IDOM GROUP', is not from that e-mail address. The booklet, which uses the mark applied for, gives a year by year detailed history of the group of companies that stops abruptly in 1992. The booklet, unfortunately, is undated but provides circumstantial evidence that the mark was used in 1992. Thus, had the opponent made a strong challenge in its evidence in support, the applicant would have needed to do more, if I had determined that the s.44(4) endorsement had been required, in order for the application to proceed to registration.

In terms of the ground of opposition under s.62(b), the opponent has asserted, in the notice of opposition, that the applicant may have provided information or evidence that is 'false in material particulars'. When the actual material is scrutinised, however, I am not convinced that it is false. The mark may, or may not, have been used from 8 January 1992 - the evidence, on a balance of probabilities, shows that the mark was used from some time in 1992 - but, just exactly when in that year is a matter of conjecture. The evidence of use is simply inconclusive on the point. This falls short of the onus on the opponent to establish that 'the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars'.

Thus, I find that this ground of opposition has not been established.

Conclusion

From the foregoing, I have found that none of the grounds claimed in the notice of opposition have been successful. As a result, in my capacity as the delegate of the Registrar in this matter, I dismiss this opposition.

Don Nancarrow
Hearing Officer

22 March 2001.