TRADE MARKS ACT 1995

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

Re: Opposition by CareerBuilder, LLC to application under section 92 of the Act by Careerbuilders Pty Ltd to remove trade mark registration number 838244(35) - **MY CAREERBUILDER** - in the name of CareerBuilder, LLC

DELEGATE:	**Michael Kirov**
REPRESENTATION:	**Opponent: No appearance and did not lodge written submissions** **Removal Applicant: Christian Bova of Counsel, instructed by Mallesons Stephen Jaques, Lawyers**
DECISION:	**2009 ATMO 31** **s.92(4)(b) opposition: No relevant use shown and opposition not established. No reason for exercise of discretion in Opponent's favour. Trade Mark to be removed. Costs awarded against Opponent.**

Background

1. CareerBuilder, LLC ("the Opponent") is the registered owner of trade mark registration 838244, relevant details of which are as follows:

Trade mark number:	838244
Registered from:	7 June 2000
Services:	**Class: 35** Feature of on-line personnel recruitment information and job information services provided via the global computer network
Trade Mark:	**MY CAREERBUILDER**

2. Hereafter I refer to the MY CAREERBUILDER mark as "the Trade Mark" and to the services covered by registration 838244 as "the Services".

3. The Opponent is an American company which has provided recruitment services in the United States and elsewhere via various media including the Internet since 1995 and under its current name CareerBuilder since 1998

4. On 10 March 2006, Careerbuilders Pty Ltd ("the Removal Applicant") filed an application under section 92(4)(b) of the *Trade Marks Act 1995* ("the Act") for removal of the Trade Mark from the Register, alleging it was not used in good faith for the Services during the three year period ending on 10 February 2006 ("the Non-use Period").

5. The Removal Applicant is an Australian company which was incorporated in 2004. Its evidence indicates that it has continuously used the name and trade mark CAREERBUILDERS since then in relation to the services in the recruitment, training and coaching fields covered by its own currently pending Australian trade mark application 1033764 for the CAREERBUILDERS mark. The services covered by this application, which was filed on 17 March 2005, are on the face of it similar to the Services. Not surprisingly, therefore, registration 838244 was cited as a significant obstacle to application 1033764 and this has apparently prompted the present removal application.

The Opposition

6. Section 100(1)(c) of the Act provides that the Opponent bears the onus of rebutting an allegation made against it under s.92(4)(b), by establishing that the Trade Mark (or the Trade Mark with additions or alterations not substantially affecting its identity) was used in good faith during the Non-use Period, or that there was an obstacle to use during that period. I proceed on the basis that the relevant standard of proof is on the balance of probabilities.

7. On 5 July 2006 the Opponent filed a Notice of Opposition to the removal ("the Notice"), raising several grounds of opposition. Of these, the principal ground relevant to the matter at issue at the hearing was that:

> The Opponent has used or authorized use of the Registered Trade Mark with additions or alterations not substantially affecting its identity, in good faith in Australia in relation to which the non-use application relates during the three-year period ending one month before the date of the removal application. (sic)

8. I mention I am proceeding on the basis that words such as "the services to" were inadvertently omitted after the words "in relation to" and before the words "which the non-use application relates".

9. The Notice also challenges the Removal Applicant's status as a "person aggrieved" and in any event calls on exercise of the Registrar's discretion under s.101 of the Act, if necessary, in the Opponent's favour.

10. The Opponent's evidence in support consists of statutory declarations by:

- Farhan Yasin made on 10 May 2007, with Annexures A, B and C;
- Ryan Fitts made on 5 July 2007, with Annexures A, B, C and D; and
- Ryan Fitts made on 6 July 2007, with Annexures A and B.

11. The Removal Applicant's evidence in answer consists of a statutory declaration by:

- Christian James Harper made on 3 September 2007.

12. The Opponent did not file or serve any evidence in reply.

13. A formal hearing of the matter was originally scheduled for July 2008 at the Removal Applicant's request. However in July 2008 the Removal Applicant made a successful application for leave to serve further evidence and the hearing was adjourned. The further evidence consisted of a statutory declaration by:

- Christian James Harper made on 22 July 2008.

14. The Opponent did not serve any evidence in reply to this further evidence and the matter was in due course heard before me as delegate of the Registrar of Trade Marks in Sydney on 2 March 2009. Christian Bova of Counsel appeared for the Removal Applicant. The Opponent did not appear, nor was it represented, nor did it file any written submissions.

The Evidence and Submissions

Standing

15. The application for removal of the Trade Mark was filed on 10 March 2006, prior to significant amendment to the relevant legislation which took effect from 23 October 2006, and thus the pre-amendment legislation is applicable. A removal applicant was then required to have the standing of "a person aggrieved". The Opponent challenges the Removal Applicant's status in this regard.

16. I am nevertheless satisfied from the evidence that the Removal Applicant is indeed a person aggrieved within the meaning of s.92(4)(b). It has provided evidence of its use of the "word" CAREERBUILDERS, both as part of its corporate name and as a trade mark for services which I accept are similar to the Services, from its incorporation in

May 2004 to 10 March 2006 (and beyond). It has used the CAREERBUILDERS mark on its business stationery, in its publicity brochures and leaflets, and on its website at www.careerbuilders.com.au and has given details of significant amounts spent on marketing the services in question prior to 10 March 2006. While one might wonder whether the Removal Applicant might not have made appropriate enquiries and discovered the existence of the Opponent and of the Trade Mark before itself adopting an apparently similar mark for similar services, this is not relevant to the issue of whether the Removal Applicant should be considered to be a person aggrieved at the time it filed the removal application.[1].

17. I accept that the Removal Applicant would have had reasonable concerns as at 10 March 2006 as to whether its use of the CAREERBUILDERS trade mark would be objectionable to the Opponent. I am thus satisfied the Removal Applicant meets the often quoted test of McLelland, J in *Ritz Hotel Ltd v Charles of the Ritz Ltd* (1988) 12 IPR 417 ("the *Ritz* case"), at 454, that an applicant is aggrieved if there is a reasonable possibility of the applicant being appreciably disadvantaged in a legal or practical sense if the trade mark subject of the removal application were to remain on the Register.

Actual Use

18. The "use" of the Trade Mark in Australia during the Non-use Period claimed by the Opponent and shown in its evidence is entirely by means of the Opponent's website at www.careerbuilders.com ("the Website"). That is to say, the Opponent has no physical presence in Australia other than the Website which, although accessible from Australia, is I understand maintained on a server in the United States[2].

19. The evidence indicates the Opponent continuously operated the Website before, during and after the Non-use Period. Mr Yasin, who is the President of the Opponent's "International Group", annexes to his declaration a spreadsheet with the title "Media Trend Report" (of unspecified provenance but dated "9/12/2006"). This spreadsheet is said to detail the number of "unique visits" from Australia to the

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[1] See for example *Woolly Bull Enterprises Pty Ltd v Reynolds* (2001) 51 IPR 149, at [11] to [12].

[2] Mr Yasin annexes a history of the Opponent downloaded from the Website on 10 May 2007 and does highlight that the Opponent apparently "created a new partnership in Australia with mycareer.com.au in 2003". However, no further details of the nature of this relationship are given, no information concerning who or what entity is meant by the description "mycareer.com.au" is provided and there is no indication that the Trade Mark was ever actually used by, or on the website of, "mycareer.com.au", or indeed if such a website existed.

Website (and to some 22 other, apparently unrelated, websites in the "Career Services and Development" field) during, *inter alia*, the relevant periods July 2005 to September 2005 (3 months) and January 2006 to February 2006 (2 months)[3]. This annexure indicates there were a total of 256 unique visits to the Website from Australia in these particular five months, at an average of some 51 visits per month documented.

20. In his first declaration of 5 July 2007 Mr Fitts, who is the Opponent's "Senior Counsel", says that the Website "provides users with the ability to register their details in order to access the services offered by reference to the MY CAREERBUILDERS (sic) trade mark". (I mention I am assuming this was a typographical error and Mr Fitts intended to refer to the Trade Mark.)

21. The first Fitts declaration includes a table which is said to set out "the number of registered users of the website who have listed 'Australia' as their country of residence when registering their details on the website". This table provides figures for each month from February 2003 to February 2006, which range from a minimum of 61 in February 2003 to a maximum of 203 in November 2005 and total some 4,878 users in all. The average figure over the 37 month period documented is thus just under 132 per month.

22. I mention that there is an apparent discrepancy between the figures given by Mr Yasin (discussed in paragraph 19 above) and those provided by Mr Fitts. According to Mr Yasin, the number of unique visits to the Website from Australia for the five months of July, August and September 2005 and January and February 2006 totaled, as mentioned, 256. However, according to the table in the first Fitts declaration the total number of people who registered on the Website during these particular five months and who also listed Australia as their country of residence was 837. I conclude therefore that the majority of people who registered as a user on the Website during the five months in question (and on the face of it throughout the entire Non-use Period) and who listed Australia as their country of residence did so from outside Australia.

[3] Why these particular five months were specified (along with figures for March, April, May and July 2006, which are after the Non-use Period) is not explained.

23. Neither the Opponent nor the Removal Applicant raised this apparent discrepancy in their evidence or submissions, although I accept, as mentioned, it is in principle possible that expatriate Australians may have registered on the Website while overseas. I in any event accept, as I understand Mr Bova conceded on behalf of the Removal Applicant, that people in Australia could and did access the Website during the Non-use Period. I further accept that some 4,878 people claiming Australia as their country of residence in fact registered their personal details on the Website during the three years in question, although it is unclear what proportion of these people did so by accessing the Website from Australia itself.

24. What then is the Opponent's evidence as to how the Trade Mark was "used" via the Website during the Non-use Period and for what services is the use claimed? Mr Yasin merely mentions in his declaration that, "The Opponent's website bears [the] Trade Mark." The only other information he provides which might arguably relate to the Trade Mark is buried in the five page "extract obtained from the Opponent's website detailing the history of the Opponent", which forms Annexure B to his declaration. This extract was downloaded from the Website and printed on 10 May 2007. The information in question, to which Mr Yasin does not specifically refer in the declaration itself, is contained in one of five entries for the year 2000 and states:

> **Personalization Features**
> My CareerBuilder.com launches, providing job candidates with the power of a Personal Search Agent, which allows candidates to establish Job Search Profiles, receive e-mail updates on jobs of interest, easily apply for jobs and manage multiple resumes and cover letters.

25. The Opponent makes no further reference in its evidence to "My CareerBuilder.com". There is no evidence that a website with this address operated during the Non-use Period and was a means by which the Trade Mark may have been used for the Services or, if it did operate, that it was directed at and accessed by people in Australia.

26. In his two declarations, Mr Fitts is only slightly more expansive. In his first declaration, as mentioned above, Mr Fitts includes a table showing the number of people who registered as users on the Website during the Non-use Period and who also indicated their "country of residence" was Australia. He then refers to "the Wayback Machine", which he explains in his second declaration (and which I accept)

is a service offered through the website www.archive.org which archives and makes available on demand copies of website pages as they actually appeared on the world wide web on specific dates in the past ("the Wayback facility"). Mr Fitts then indicates that four specific users, who are unnamed but to whom Mr Fitts refers as "user UD4HH6Z8MYHZXZ7MX0", "user U1B4PR6GLHNQBP7DSMY", "user U1C2H766Q6YWR24KHJT" and "user U8C7NW77WGGMSNFVXF1",:

> …entered Australia as his or her country of residence and registered their personal details on the website on [a certain date].

27. The four dates Mr Fitts mentions are 8 April 2003, 28 January 2004, 2 October 2005 and 1 January 2006, all being within the Non-use Period. Mr Fitts annexes copies of four archived pages obtained via the Wayback facility said to show the Website's homepage as it was as at those four dates. Mr Fitts states that each of the four pages in question:

> …clearly shows use of the MY CAREERBUILDER trade mark which the user would have viewed on [the relevant date] before proceeding to the registration section of the website.

28. The Trade Mark can indeed be seen on each of the four archived homepages. It appears a single time on each homepage, as a "label" (for want of a better word) on one of several "tabs" of similar appearance displayed along the top of each of the archived homepages. These "tabs" are or signify, I assume, links to other pages on the Website to which a person will be taken if the tab is clicked. Such labeled tabs, or "hot links", will be familiar to any person who uses the world wide web. I mention that while the homepages, as might be expected, appear to contain a large number of clickable links, the majority of these are on the face of it indicated by a simple change in colour in the word carrying the link, or by the word's being underlined. The "tabs" displayed along the top of the homepages, by contrast, are relatively more prominent than the majority of clickable links described above in that the "labels" they carry are in a larger point size than most of the other text on the homepages and in the case of the 8 April 2003 and 28 January 2004 homepages the "tabs" themselves are drawn to resemble the identifying tabs found on real files in real-world filing cabinets.

29. In the case of the 8 April 2003 homepage there are four such tabs, bearing the labels "Find Jobs", "Post Resumes", "Mycareerbuilder®" (with the element MY underlined

and somewhat stylized, the word “career” in lower case, no spaces between words and the whole followed by the ® symbol) and “Advice & Resources”.

30. In the case of the 28 January 2004 homepage there are seven tabs, bearing the labels “Home”, “Find Jobs”, “Post Resumes”, “Job Alerts”, “My CareerBuilder”, (rendered this time in plain text as indicated and without the ® symbol), “Advice & Resources” and “Career Fairs”.

31. In the case of both the 2 October 2005 and 1 January 2006 homepages there are also seven tabs, this time with the labels “Home”, “My CareerBuilder” (rendered as indicated), “Find Jobs”, “Job Recommendations”, “Post Resumes”, “Job Alerts” and “Advice & Resources”.

32. Mr Fitts’ second declaration does not take matters much further. As mentioned above when discussing Mr Fitts’ first declaration, he explains how the Wayback facility operates. He also annexes:

    - what he describes as “a search result page” obtained from the Wayback facility (the significance of which is unexplained and which is not apparent to me); and
    - some 39 archived homepages obtained from that facility showing how the Website’s homepage looked on 39 discrete dates during the period 25 January 2002 and 1 April 2006 (the majority of which fall within the Non-use Period).

    As he did in his first declaration Mr Fitts states that each of these archived pages:

    > …clearly shows use of the MY CAREERBUILDER trade mark in connection with the Opponent’s services

33. Certainly the Trade Mark can be seen on each of the relevant archived homepages in question, essentially appearing in the same manner as described in paragraph 28 above in connection with the four annexures to Mr Fitts’ first declaration. This much, indeed, was not in effect disputed by Mr Bova. However, as Mr Bova pointed out in relation to the totality of the Opponent’s evidence, the mere fact that the Trade Mark could be <u>seen</u> on the Website’s homepage during the Non-use Period and that the Website’s homepage could be and was accessed from Australia during this period does not of itself establish the Opponent was using the Trade Mark in good faith as a trade mark in Australia for the Services.

34. Mr Bova emphasized in his submissions that there is no evidence that any person, whether in Australia or elsewhere, ever followed the link labeled with the Trade Mark by clicking on it. Indeed, there is no evidence as to what could be seen on the linked page if the link were followed, nor of what specific services, if any, might have been aimed at people in Australia via the linked page. The only light, such that it is, Mr Yasin's or Mr Fitts' evidence sheds on this is Mr Fitts' somewhat circular statement, quoted in paragraph 20 above, that the Website as a whole "provides users with the ability to register their details in order to access the services offered by reference to the MY CAREERBUILDERS (sic) trade mark" and, possibly, the oblique reference to "mycareerbuilder.com" buried in Annexure B to Mr Yasin's declaration and mentioned in paragraph 24 above.

35. The Opponent may of course consider that once the very specific wording of the Services is taken into account then it has in effect established its use of the Trade Mark notwithstanding the apparent deficiencies in its evidence. The Services are specified as "Feature of on-line personnel recruitment information and job information services provided via the global computer network" in Class 35. The words cannot however be taken, on the face of it, to refer to a "feature" of the *Website* itself, namely the "tab" bearing the Trade Mark as a label. For one thing there is no suggestion in the evidence that the Opponent provides services in the field of web design or similar. Further, such services would most likely belong in Class 41 in any event. I would instead interpret the word "feature" as it appears in the Services as referring to a particular aspect of the general job information services in Class 35 the Opponent provides.

36. As indicated, however, I am unable to say from the evidence what the specific "feature" is. It follows that I am unable to say whether the "feature" in question had any relevance to people in Australia. Certainly there is no evidence that a single person in Australia availed themselves of this enigmatic feature and I am thus inevitably drawn to the conclusion that the Opponent has not discharged the onus it bears under s.100(1)(c).

37. I mention that Mr Bova also referred to a number of decisions in the UK and Australia which have considered whether claimed use of a trade mark via the Internet should be considered as "use" in the course of trade in the country concerned for the purposes of

the respective countries' trade marks legislation. I do not believe it is necessary here to discuss all these cases, since in the main they appear to me to be in substantial accord with what is considered the leading Australian decision on the issue, that of Merkel, J in *Ward Group Pty Ltd v Brodie & Stone Plc* (2005) 64 IPR 1. In words to which Mr Bova referred and which are apt in relation to the current opposition his Honour said:

> **[43]** In summary, the use of a trade mark on the internet, uploaded on a website outside of Australia, without more, is not a use by the website proprietor of the mark in each jurisdiction where the mark is downloaded. However, as explained above, if there is evidence that the use was specifically intended to be made in, or directed or targeted at, a particular jurisdiction then there is likely to be a use in that jurisdiction when the mark is downloaded. Of course, once the website intends to make and makes a specific use of the mark in relation to a particular person or persons in a jurisdiction there will be little difficulty in concluding that the website proprietor used the mark in that jurisdiction when the mark is downloaded.

38. Here, as mentioned, there is no evidence that the Opponent's claimed "use" of the Trade Mark on the Website was specifically intended to be made in, or directed or targeted at, people in Australia. Even had the Opponent identified the specific services it offered under the Trade Mark, accordingly, it would not in my view have discharged its onus under s.100(1)(c) unless it had satisfactorily addressed this issue.

39. For the sake of completeness I mention that the Removal Applicant also sought to rely on claimed admissions by the Opponent in correspondence which apparently passed between the parties in late 2006 and early 2007. The claimed admissions were essentially "summarized" by Mr Harper in his first declaration, but copies of the correspondence itself were not in evidence. As indicated to Mr Bova at the hearing I do not believe I am able to give Mr Harper's interpretation of this correspondence in his unsworn declaration any significant weight and it has not played any role in the decision I have reached.

Registrar's Discretion

40. Notwithstanding I have found the Opponent has failed to show relevant use of the Trade Mark, I turn now to s.101 of the Act. Section 101(1) says that in such circumstances the Registrar "may decide to remove the trade mark from the Register in respect of any or all of the [registered services]", whilst s.101(3) explicitly provides

discretion may be exercised in the Opponent's favour, and removal not be ordered, if the Registrar is satisfied it is reasonable to do so. As Mr Bova pointed out, the accepted "default" position remains as put by McLelland, J (at 481-2) in the *Ritz* case in connection with the removal provisions of the now repealed *Trade Marks Act 1955*, namely that in the absence of relevant use a mark should be removed "unless sufficient reason appears for leaving it there". The Opponent accordingly bears the onus of establishing sufficient reason exists for an exercise of discretion in its favour.

41. Early decisions considering exercise of the discretion under s.101 suggested an opponent would need to show special facts or circumstances, or an overriding question of public interest, to warrant leaving a mark on the Register in the absence of relevant use[4]. In the recent decision in *Pioneer Computers Australia Pty Ltd v Pioneer KK* [2009] FCA 135 (23 February 2009), however, Bennett, J said:

> 167. The discretion under s.101(3) is a broad discretion to decide not to remove a trade mark from the Register or not to carve out some of the goods and services for which the mark is registered, even if s.92 grounds have been made out, if the Court is satisfied that it is reasonable to do so. Irrespective of the lack of use of the trade marks on the removal goods and the removal services in the relevant period, there is a discretion not to alter the registrations.
> 168. In *Kowa Company*[5] at [98], Lander J rejected the submission that a party seeking the exercise of the discretion needs to show "exceptional circumstances". In *E & J Gallo*[6] at [198], Flick J agreed with Lander J that there is no requirement to establish exceptional circumstances. With respect, I also agree with Lander J that there is no warrant to read a requirement for exceptional circumstances into s.101(3).
> 169. In *E & J Gallo* at [202]-[203], Flick J stated that the following factors set out by Falconer J in *Hermes Trade Mark* [1982] RPC 425 were of assistance in considering the exercise of the discretion:
>
> - there had been no abandonment of the trade mark;
> - the registered proprietors of the mark still had a residual reputation in the mark;
> - there had been sales by the registered proprietors of goods for which removal was sought since the relevant period ended;
> - the applicants for removal had entered the market without having taken steps to ascertain from the Register whether anyone had a right to exclude their use of the mark;
> - the registered proprietors were not aware of the applicant's sales under the mark.

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[4] See for example *Figgins Holdings Pty Ltd v Beltrami SpA* (1998) 46 IPR 411 (at pp 418-9).
[5] *Kowa Co Ltd v NV* Organon (2005) 66 IPR 131
[6] *E & J Gallo Winery v Lion Nathan Australia Pty Ltd* (2008) 77 IPR 69

42. I accept that the Opponent is not required to establish "exceptional circumstances" exist in order to possibly benefit from an exercise of discretion in its favour. I am nonetheless not satisfied the circumstances in this case merit exercise of the discretion, particularly when there is no evidence the Trade Mark enjoys any reputation at all in Australia, and I decline to do so.

Decision

43. I find that there was no use of the Trade Mark in good faith in the course of trade in Australia for the Services during the Non-Use Period and thus that the opposition has not been established. I further find no circumstances have been shown which warrant exercise of the Registrar's discretion to not remove the Trade Mark in respect of all of the Services. I accordingly direct that registration 838244 be removed from the Register one month from the date of this decision. If the Registrar has been served with a notice of appeal before then I direct that removal shall not occur until the appeal has been discontinued or, in the event of a decision from the Court, that the registration be dealt with as the Court sees fit.

Costs

44. As the successful party, the Removal Applicant is entitled to its costs and I award costs against the Opponent as per Schedule 8 of the *Trade Marks Regulations 1995*.

Michael Kirov
Hearing Officer
Trade Marks Hearings
7 May 2009