

**TRADE MARKS ACT 1995**

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

Re: Opposition by Barry Plant Holdings Pty Ltd to application under section 92 of the Act by Pilling Systems to remove trade mark numbers 874477(36) - **SET DATE** - in the name of Barry Plant Holdings Pty Ltd

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<b>DELEGATE:</b>	<b>Jock McDonagh</b>
<b>REPRESENTATION:</b>	<b>Opponent: Sam Ricketson instructed by WMB Lawyers Applicant: Neville Rochow SC instructed by MorganWard Solicitors</b>
<b>DECISION:</b>	<b>2009 ATMO 02 Section 92 opposition – s92(4)(a) - opponent established use – trade mark to remain on register – costs awarded against applicant</b>

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**Background**

1. Barry Plant Holdings Pty Ltd (‘the opponent’) is the registered owner of a trade mark, current details of which appear below:

**Trade mark number:** 874477  
**Registered from:** 3 May 2001  
**Services:** Class 36: real estate consulting

**Trade mark:** **SET DATE**

2. On 16 May 2007, Pilling Systems (‘the 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.
3. On 3 September 2007 the opponent filed Notice of Opposition to the removal, claiming use of the trade mark in good faith.
4. The matter came before me, as a delegate of the Registrar of Trade Marks, for hearing in Melbourne on 16 September 2008. The opponent was represented by Sam Ricketson of Counsel, instructed by WMB Lawyers. The applicant was represented by Neville Rochow of Senior Counsel, instructed by MorganWard Solicitors.

**Evidence**

5. The following evidence was filed and served pursuant to legislation:

<b>Declarant</b>	<b>Status</b>	<b>Date, Known as</b>	<b>Exhibits</b>
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<i>Evidence in Support</i>			
Michael John McCarthy	Director of Opponent	27.11.2007, McCarthy 1	MJM1 to MJM20
<i>Evidence in Answer</i>			
David Pilling	Principal of Applicant	14.03.2008, Pilling	
<i>Evidence in Reply</i>			
Michael John McCarthy	Director of Opponent	20.06.2008, McCarthy 2	MJM21

### **Submissions**

6. The opponent submitted that the applicant was not a “person” for the purposes of the Act, in that Pilling Systems was neither a corporate entity recognised by law nor a human person.
7. The opponent provided various materials that it submitted was evidence of use of its trade mark during the relevant period. The material included real estate publications, newsheets, information sheets, marketing material, office get up, newspaper advertising, and general media promotions.
8. The applicant based its submissions on the evidence put forward by the opponent. It argued that the registered trade mark had not been used. Rather, such use as was established related to a different mark with substantial additions or alterations (namely, SALE BY SET DATE).
9. The applicant submitted that there is neither merit nor substance in the opponent’s objection to the applicant’s standing. The applicant was clearly David Pilling. In the alternative, the applicant submitted that the application could be amended pursuant to section 66 of the Act.

### **Discussion and Reasoning**

10. Section 100 puts the onus on the trade mark owner to rebut an allegation of non-use. The allegation which is made pursuant to section 92(4) is that the trade mark in question had been registered for a continuous period of three years ending one month before the day on which the non use application was filed and during which time there had been no use in good faith of the mark in Australia in relation to the goods and/or services covered by the registration. The opponent must therefore show that the trade mark has been used in Australia in respect of the registered services during the

relevant period. For the purposes of section 92(4)(b), the relevant three year period is 16 April 2004 to 16 April 2007.

11. The use must be genuine commercial use in accordance with the test in *Imperial Group Ltd v Philip Morris & Co* [1982] FSR 72. A single bona fide use of the mark in the relevant period is sufficient to resist an application for removal: *Woolly Bull Enterprises Pty Ltd v Reynolds* [2001] FCA 261 (2001) 51 IPR 149 ("*Woolly Bull*") at paragraph 17. However, Wilberforce J, in *Nodoz Trade Mark* (1962) RPC 1 at 7, said that if a registered owner relies on one single act of use of the mark, then that single act ought to be established by "if not conclusive proof, at any rate overwhelmingly convincing proof."
12. The tribunal may not be persuaded by evidence that is solely from the internal files of the opponent: *Nodoz*, supra; or of a circumstantial nature: *Trina Trade Mark* [1977] RPC 131; although one invoice, if genuine, will suffice: *Geo W McPherson v Remington* (1999) 47 IPR 636.
13. It should be noted that mere assertions of use without documentary support are generally given little weight: *Great White Shark Enterprises Inc v Joose Apparel Pty Ltd* (1998) 41 IPR 208, *Steen Petersen v Daniel Baden and Garth Harris* [2003] ATMO 83.
14. The evidence provided by the opponent shows the trade mark used in a variety of ways. In correspondence, it is usually accompanied by the words "sale by" and shown as Sale by SET DATE<sup>®</sup>, Sale by Set Date<sup>®</sup>, SALE BY SET DATE<sup>®</sup> or SET DATE<sup>®</sup>. On brochures and marketing materials, the trade mark is typically represented as shown:

Sale by SET DATE<sup>®</sup>

Or



15. Exhibit MJM4 to McCarthy 1 is a representative sample of a market appraisal produced by the opponent during the relevant period, in this case 10 November 2006. It includes discussion of the methods of sale of real estate, which are entitled **SALE BY SET DATE<sup>®</sup>**, Sale by Auction, Sale by Auction and private sale. Each method is described in a section of text beneath a heading comprising the method name.
16. The section heading in the exhibited market appraisal for “Sale by SET DATE” is as represented as **SALE BY SET DATE<sup>®</sup>**. The phrase **SALE BY SET DATE<sup>®</sup>** is used three times in the text of the relevant section of the appraisal; however, **SET DATE<sup>®</sup>** is used once.
17. I am satisfied that the trade mark is shown to have been used in good faith by the opponent on at least one occasion in respect of the opponent’s services. I am also satisfied that, despite the manner of presentation in the exhibited materials, the words “sale by” are merely descriptive in the same way that they are when used before “auction” and “negotiation”.
18. The most common use of the opponent’s trade mark during the relevant period was as shown in the two illustrations depicted in paragraph 14 above. In both instances, I am satisfied that the opponent’s trade mark is being relevantly used.
19. In both cases the words SET DATE are contained within a separate rectangular box, such box being of a different and more distinctive colour to the surrounding material. Within the box is usually the small ® sign indicating that the opponent is asserting trade mark use.
20. Even if the trade mark used were **SALE BY SET DATE**, I am satisfied that the descriptive words “sale by” are additions that are not such as to affect substantially its identity.
21. Having found that the opponent has successfully rebutted the purported applicant’s claim of non-use, the standing of the applicant is of little relevance. It is thus not necessary to address specifically this aspect of the opponent’s case.

**Decision**

22. I am satisfied that the opponent has used its trade mark with respect to the services specified in the registration. I therefore dismiss the application to remove the trade mark.

**Costs**

23. As the removal applicant has been unsuccessful I award costs against him at the scale found in Schedule 8 of the *Trade Mark Regulations 1995*.

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
14 January 2009