

## TRADE MARKS ACT 1995

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

Re: Opposition by Greenfield Products Pty Ltd to registration of trade mark application 957248(Class 7 and twenty one other classes) (International Registration No. 802337) - **YELLOW** - filed in the name of YelloStrom Verwaltungsgesellschaft mbH.

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<b>DELEGATE:</b>	<b>Alison Windsor</b>
<b>REPRESENTATION:</b>	<b>Opponent:</b> Ahearn Fox, Patent & Trade Mark Attorneys <b>Holder:</b> not represented
<b>DECISION:</b>	<b>2007 ATMO 27</b> <b>Reg 17A.29 opposition</b> – ground established under section 59 – no intention to use trade mark in Australia – protection refused

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#### **Background**

1. Trade mark application 957248 is an international registration designating Australia (IRDA). It was filed on 28 November 2002 by Yello Strom Verwaltungsgesellschaft mbH (“the holder”). The IRDA was originally filed for 37 classes but presently covers goods and services in 22 classes. I do not consider it necessary to set these out in any detail.
2. Greenfield Products Pty Ltd (“the opponent”) filed notice of opposition on 14 July 2005, claiming most grounds of opposition available to it under the provisions of the *Trade Marks Act 1995* (“the Act”). Notice of opposition to the protection of an IRDA is governed by the provisions of regulation 17A.29.
3. The opponent filed evidence in support of the opposition. However, as the holder has not nominated an address for service in Australia<sup>1</sup>, there was no requirement for the evidence to be served on the holder<sup>2</sup>. The holder of the trade mark did not file or serve evidence in answer.

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<sup>1</sup> Regulation 17A.33

<sup>2</sup> Subregulation 17A.33(3)

4. By letter dated 18 December 2006, the opponent requested a decision on the written record. I have been delegated to decide the matter.

### **The law, evidence and submissions**

5. Having considered the notice of opposition, the correspondence on the application file and the evidence in support and submissions provided by the opponent, I am satisfied that this matter can be decided under the provisions of section 59 of the Act.
6. Section 59 reads as follows:

#### **59 Applicant not intending to use trade mark**

The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods and/or services specified in the application

7. The opponent has submitted that the holder's failure to respond once the opposition was filed is prima facie evidence that it no longer has an intention to use the trade mark in relation to the goods and services specified in the IRDA.
8. In support of their submissions, the opponent referred to the decision in *Sapient Australia Pty Ltd and Sapient Corporation v SAP AG* [2002] 55 IPR 68 where the delegate, when discussing section 59, said the following:

This ground is also one where an applicant's intention to use is relevant. However, it is a ground written in the present tense and looks at the present state of the intention of the applicant. ... Thus, section 59 deals with current defects in intention to use, interlocking with s 58, under which the intention and facts at the time of filing are the relevant elements.

9. The opponent submitted that the holder's lack of action in a number of instances clearly indicates that it no longer has an intention to use the trade mark, and that the circumstances of the matter mirror those of *JTI d.o.o. v Japan Tobacco Inc* [2006] ATMO 34.
10. The opponent also referred to a letter from the firm of trade mark attorneys who had prosecuted the IRDA during the examination process requesting their name be

removed from the Trade Marks office records as address for service for the holder.

The letter reads in part as follows:

In April 2004 we were instructed by our client to proceed no further on its behalf in relation to the above two trade mark applications. Subsequently, our file was closed in June 2004

...

We confirm our request that [we] be withdrawn as the address for service in relation to the above two trade mark applications.

11. The date referred to above is well prior to the filing of the opponent's notice of opposition. This letter, and other information the opponent has provided is sufficient for me to infer that the holder, by the time the notice of opposition was filed, no longer had any intention to use the trade mark in Australia. This is made especially clear by the letter quoted above, and the fact that the holder has not replaced its address for service in Australia, nor has it responded to letters from the office despite numerous opportunities to do so. Under these circumstances, I am satisfied the ground of opposition under section 59 has been established.

### **Decision**

12. The opponent having established a ground of opposition, I refuse to extend protection in Australia in respect of all goods listed in the IRDA.

### **Costs**

13. The opponent has requested its costs, and having been successful, is so entitled. I award costs against the holder at the official scale.

Alison Windsor  
Hearing Officer  
Trade Marks Hearings  
24 May 2007