

TRADE MARKS ACT 1995

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

Re: Opposition by Multiplex Limited to registration of trade mark application 961766(37) - **MULTIFIX** - filed in the name of Eastcoast Holdings Pty Ltd.

DELEGATE:	Jock McDonagh
REPRESENTATION:	Opponent: Dr Michael Brewis of Wray & Associates, Attorneys Applicant: Mr Tim Wishart of Walker Smith & Breen, Solicitors
DECISION:	S52 opposition - grounds under section 41, 44, 58 & 60 not established -trade mark may proceed to registration. Costs awarded against the opponent.

Background

1. The applicant, Eastcoast Holdings Pty Ltd, applied to register the following trade mark:

Application Number: 961766

Priority date: 15 July 2003

Services: **Class 37:** Electrical and building maintenance and contracting

Trade Mark: MULTIFIX

Advertised: 27 November 2003

2. The opponent, Multiplex Limited, filed notice of opposition to the trade mark's registration on 27 February 2004. An amended notice was filed on 20 December 2004. The notices listed nine grounds of opposition provided in the *Trade Marks Act* 1995 ("the Act"), effectively all of the grounds available.
3. The opponent duly served and filed evidence in support. The applicant served and filed evidence in answer.
4. The matter came to a hearing before me by telephone, as a delegate of the Registrar of Trade Marks, in Canberra on 6 April 2005. Dr Michael Brewis of Wray & Associates,

Attorneys, represented the opponent. Mr Tim Wishart of Walker Smith & Breen, Solicitors, represented the applicant.

Evidence

5. The evidence consists of the following declarations:

Declarant	Date declared	Exhibits	Known As
<i>Evidence in Support</i>			
Mark Gregory Wilson	10.08.2004	MGW-1 to MGW-44	Wilson
<i>Evidence in Answer</i>			
Lynton William Rose	11.11.04	LWR-1 to LWR-9	Rose

6. The Wilson declaration is made by the company secretary of the opponent company. He details the opponent's business activities in Australia and provides a comprehensive list of the opponent's various trade marks, along with examples of them in use, and much detail going to the reputation of the opponent in the building and related industries.
7. The Rose declaration is made by a director of the applicant. He provides a background to the adoption of the word *multifix* by the applicant and its use. He declares that the word is uncommon generally, although he concedes that there are some other companies using the business name in the building industry albeit not in class 37. He further states that he is unaware of any actual confusion involving the names *multifix* or *multiplex*. Exhibited with the declaration are copies of business name searches, trade mark searches and Google searches.

Ground relied upon at hearing

8. At the hearing, the opponent relied upon only four grounds of opposition:
- (a) trade mark not capable of distinguishing the applicant's services (s.41)
 - (b) trade mark substantially identical with, or deceptively similar to, a trade mark with an earlier registration (s.44)
 - (c) trade mark substantially identical with, or deceptively similar to, a trade mark that has acquired a reputation in Australia (s.60)
 - (d) the applicant is not the owner of the trade mark (s.58)
9. The material filed as evidence in this matter does not support the remaining grounds of opposition, and I formally dismiss them.

Ground 1: Section 41 - Capable of Distinguishing

10. Section 41 provides for the assessment of the capability of trade marks to distinguish the designated goods or services of one trader from the goods or services of other persons. The initial step is provided for, in terms of subsection 41(3):

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

11. The classic statement of the test involved is that of Kitto J in *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511 at 514:

[T]he question whether a mark is adapted to distinguish [is to] be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives - in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess - will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

12. For the opponent it was submitted that Note 1 to subsection 41(6) states, inter alia:

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services.

13. Dr Brewis further submitted that the mark may be readily separated into the two parts *multi* and *fix*. He stated that each of these parts has an everyday meaning plain to all. The Macquarie Dictionary (Third Edition 2001) provides a definition of *fix* as “to repair”, or “to put in order or in good condition; adjust or arrange”, or “a method of fixing some problem”. *Multi* is defined as meaning many. Taken together as the word *multifix*, the two elements form a word that retains a plain meaning, and it is that of “a multiplicity of fixing type services”.

14. It was submitted that the application relates to *electrical and building maintenance and contracting*, and that it is in the nature of maintenance and contracting services that they fix a variety of defects as well as performing preventative functions. A substantial proportion of the services, is of a repair or fixing nature, and the word *multifix* is therefore wholly descriptive of the applicant's services.

15. I am satisfied that the definitions of the component words of the applicant's trade mark are correct. However, I do note that the Macquarie Dictionary provides some 30 definitions for the word fix, ranging from "to make fast, firm, or stable" and "to get (a meal), prepare (food)", through "to castrate or spay" and "a bribe". I note, too, that *multifix* – unlike *multiplex*, for example – is not considered to be a word in the Dictionary.
16. I am not satisfied that "*multifix*" has a plain meaning, nor that it is directly descriptive of the services detailed under the opposed application as *electrical and building maintenance and contracting*.
17. In my opinion, "*multifix*" has been shown to be an invented word, whose components are capable of providing indirect reference to the applicant's services. There is nothing in the evidence, however, to show that "*multifix*" has any direct meaning in respect of electrical and building maintenance and contracting services. It may be that electrical and building and contracting services involve any one or more of the multiplicity of meanings of "*fix*", but "*multifix*" is not a word that directly describes a characteristic of the applied-for services themselves. It is therefore not a word, which for the sake of its ordinary signification is likely to be required by other persons in their supply and promotion of electrical and building maintenance and contracting services. I find, therefore, that I am satisfied that the applicant's mark MULTIFIX is capable of distinguishing the goods and services nominated in the application.
18. I find that the opponent has not established this ground of opposition.

Ground 2: Section 44 - Deceptive Similarity

19. To establish the s.44 ground, the opponent must establish all of the following:
 - At the priority date
 - there was a substantially identical or deceptively similar trade mark application or registration
 - in respect of similar services or closely related goods
 - in the name of a person other than the applicant.

20. The opponent submitted that the Mark is substantially identical with, or deceptively similar to, the following of the opponent's registered trade marks.

Trade Mark Number	Trade Mark	Services	Priority Date
546000	<p style="text-align: center;">MULTIPLEX</p> <p style="text-align: center;">MULTIPLEX</p>	<p>Class: 37 Building and construction services being construction engineering, demolition of buildings, building and property development services, building maintenance and repair services, building insulation, building sealing, cleaning of buildings, cabinet making, construction engineering, rental of construction equipment, rental of excavators, elevator installation and repair, factory construction, harbour construction, machinery installation, machinery maintenance, machinery repair, painting services, pier breakwater building, pipeline construction, pipeline maintenance, plastering, plumbing, scaffolding, underwater construction, warehouse construction and repair</p>	16.11.1990
546001	<p style="text-align: center;">MULTIPLEX</p> <p style="text-align: center;">MULTIPLEX</p>	<p>Class: 42 Services in this class relating to the building and construction industry being consulting engineering services, architectural services, architectural consulting services, design services, drafting services, construction drafting services, engineering drawing services, engineering services, land surveying services, landscape gardening services, providing housing accommodation, and catering services</p>	16.11.1990
546002	<p style="text-align: center;">MULTIPLEX The Well Built Australian</p> <p style="text-align: center;">MULTIPLEX The Well Built Australian</p>	<p>Class: 37 Building and construction services being construction engineering, demolition of buildings, building and property development services, building maintenance and repair services, building insulation, building sealing, cleaning of buildings, cabinet making, construction engineering, rental of construction equipment, rental of excavators, elevator installation and repair, factory construction, harbour construction, machinery installation, machinery</p>	16.11.1990

		<p>maintenance, machinery repair, painting services, pier breakwater building, pipeline construction, pipeline maintenance, plastering, plumbing, scaffolding, underwater construction, warehouse construction and repair</p>	
546003	<p>MULTIPLEX The Well Built Australian</p> <p>MULTIPLEX The Well Built Australian</p>	<p>Class: 42 Services in this class relating to the building and construction industry being consulting engineering services, architectural services, architectural consulting services, design services, drafting services, construction drafting services, engineering drawing services, engineering services, land surveying services, landscape gardening services, providing housing accommodation, and catering services</p>	16.11.1990
895078	MULTIPLEX LIVING	<p>Class: 35 Marketing, promotion, publicity and advertising of real estate including residential real estate; exhibitions relating to real estate development; promotion of industrial and technology parks and of residential property</p> <p>Class: 36 Management and operation of industrial and technology parks and of residential property; real estate agency services in this class, including real estate property leasing rental and management; real estate appraisal and valuation; real estate sales; provision of finance, including financial information services and financial management and finance services relating to real estate; mortgage broking and provision of mortgages for real estate purchase; real estate broking; insurance services, including insurance of real estate; insurance brokerage, insurance consultancy, insurance information, insurance underwriting all being related to real estate and/or real estate agencies</p> <p>Class: 37 Building and construction services; demolition of buildings; building and property development, including residential property development; building cleaning, maintenance and repair;</p>	15.11.2001

		<p>building insulation; building sealing; cabinet making; rental of construction equipment; rental of excavators; elevator installation and repair; factory construction; harbour construction; machinery cleaning, installation, maintenance and repair; painting; pier breakwater building; pipeline construction, maintenance and repair; plastering; plumbing; scaffolding; underwater construction; warehouse construction and repair; property development services, including the development of industrial and technology parks; development of residential property</p> <p>Class: 42 Engineering services, including consulting engineering and construction engineering; architectural services; architectural consulting services; design services; drafting services, including construction drafting services; land surveying services; landscape design and gardening services; engineering drawing services; landscape gardening services; providing housing accommodation; catering services</p>	
913965	MULTIPLEX INTERIORS	<p>Class: 37 Building and construction services being construction engineering, demolition of buildings, building and property development services, building maintenance and repair services, building insulation, building sealing, cleaning of buildings, cabinet making, construction engineering, rental of construction equipment, rental of excavators, elevator installation and repair, factory construction, harbour construction, machinery installation, machinery maintenance, machinery repair, painting services, pier breakwater building, pipeline construction, pipeline maintenance, plastering, plumbing, scaffolding, underwater construction, warehouse construction and repair</p> <p>Class: 42 Services in this class relating to the building and construction industry being consulting engineering services,</p>	23.05.2002

		architectural services, architectural consulting services, design services, interior design services, drafting services, construction drafting services, engineering drawing services, engineering services, land surveying services	
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21. It is clear that each of these marks bears an earlier priority date than that of the applicants, that they relate to similar services, and they are registered in the name of a person other than that of the applicant.

22. In considering whether marks are ‘*substantially identical*’, they are to 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 that comparison’

Shell Company (Aust) Limited v Esso Standard Oil (Aust) Limited (1961) 109 CLR 407 at 414-415.

23. The opponent did not contend that the opposed mark was substantially identical to its own. Having applied the appropriate test, I find that the applicant’s trade mark is not substantially identical to those of the opponent.

24. The test to determine whether trade marks are ‘*deceptively similar*’ is set out in *Shell Company v Esso* at 415:

‘The marks are not now to be looked at side by side [as for substantial identity]. The issue is not abstract similarity, but deceptive similarity ... the comparison ... 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 impression that such persons would get from the defendant’s [trade mark]’

25. Further the Court added at 416, that:

‘[The] deceptiveness that is contemplated must result from similarity; but the likelihood of deception must be judged not by the degree of similarity alone, but by the effect of that similarity in all the circumstances.’

26. The criteria for deceptive similarity have been set out in *Australian Woollen Mills Limited v F S Walton & Co Limited* (1937) 58 CLR 641 at 658 and by Parker J in

Pianotist Co's Application (1906) 23 RPC 774 at 778 and reiterated in *Registrar of Trade Marks v Woolworths Limited* (1999) 93 FCR 365; 45 IPR 411.

27. As was observed by Williams J in *Sym Choon & Co Limited v Gordon Choons Nuts Limited* (1949) 80 CLR 65 at 78:

'The basic principle is that the proposed mark must be so unlike the rival mark that it is not reasonably probable that a purchaser who knows of the latter and has an imperfect recollection of it is likely to be confused.'

28. An attempt must be made to estimate the effect or impression produced by the mark in the mind of potential customers. The application of the criteria requires a practical assessment of the impression of the marks and the circumstances surrounding the way in which the mark can be used in respect of the goods of the applications in comparison to the opponent's marks. In so undertaking this task it is important to identify the essential features of the opponent's marks and the impression recollected and determine whether that/those essential features are to be found in the mark and what role they play in the mark.
29. The essential feature of the prior registered mark (in a s.44 comparison) or the prior used mark (in an s.60 comparison) is an important element of the impression gained from imperfect recollection. "The identification of an essential feature depends partly on the Court's own judgment and partly on the burden of the evidence that is placed before it": *de Cordova v Vick Chemicals Co.* (1951) 68 RPC 103, at 106.
30. The weight to be afforded elements common to both marks is largely dependent upon how dominant the common elements are in each mark, the nature of that common element - whether it is distinctive or descriptive - and the nature of the elements of each mark that are not held in common - whether they are distinctive or descriptive.
31. It has been held by the High Court that where the common element in two marks is descriptive there is a heavy onus in establishing a likelihood of deception and that such common words must to some extent be discounted in considering whether the marks are deceptively similar: *Cooper Engineering Pty Limited v Sigmund Pumps Limited* (1952) 86 CLR 536 (RAIN KING and RAINMASTER). Conversely, where the other components of a mark are directly descriptive of the relevant goods/services or

are ordinary English words, used in their ordinary way, those components to some extent will be discounted in the Registrar's analysis of the likely recollection of the mark. Those non distinctive components will leave less of an impression in the mind's eye.

32. The words '*likely to deceive or cause confusion*' in s.10 place no limitation on the nature of the confusion or deception envisaged, whether it be visual or phonetic confusion of the marks themselves or confusion or deception as to the trade provenance of the goods: see *John Fitton & Co Ltd's Application* (1949) 66 RPC 110 at 113.
33. The test for deceptive similarity under the Act involves consideration of a lower threshold than the deception or misrepresentation to be found in passing-off or contravention of the *Trade Practices Act 1974*. It is enough for the mark to 'cause confusion'; it is enough that there is a real, tangible danger that a consumer would be caused to wonder whether there is a connection between the marks, or the trade origin of goods or services supplied under them; or have reasonable doubt: *Woolworths* at paragraph 50.
34. I consider that the essential feature of the opponent's marks that are to be compared with that of the applicant is the word "*multiplex*". I note that this is a word defined in the Macquarie Dictionary and means "manifold, many".
35. While it is true that the opposing marks contain the prefix "*multi*" and end with "x", the words are both visually and aurally quite distinct. I consider that the emphasis would be placed on the second syllable of both words and the sounds of them are very different.
36. The relevant market is of some significance in the comparison of the marks. The services are relatively expensive and will be bought by relatively discerning people. The fact that the opponent is arguably the pre-eminent building company in Australia would, in my opinion, lessen the likelihood of confusion in the marketplace.
37. I am not satisfied that the marks are deceptively similar and I therefore dismiss this ground of opposition.

Ground 3: Section 60 – Prior Reputation

38. To satisfy s.60, the opponent has the burden of establishing the following elements:
- a pre-existing trade mark;
 - substantial identity or deceptive similarity between the applied for trade mark and the pre-existing trade mark;
 - the acquisition of a reputation in Australia by the pre-existing trade mark; and
 - a likelihood that, because of that reputation, use of the applied for trade mark would be likely to deceive or cause confusion.
39. I have already found that opposed marks are neither substantially identical nor deceptively similar, so this ground cannot succeed. Consequently, I dismiss this ground of opposition.

Ground 4: Section 58 – Ownership of the Trade Mark

40. Section 58 provides that the registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark. In order to establish this ground, it is incumbent upon an opponent to show that, in the time before filing, the applicant is not the first user in trade in Australia of the applied-for trade mark. To do so, the opponent must show, at a minimum, that not only is the applied-for trade mark substantially identical to the older trade mark, but that it is applied to the same kind of goods: *Re Hicks' Trade Mark* (1897) 22 VLR 636 at 640.
41. The opponent pointed to Exhibits LWR-4 and LWR-5 of the Rose declaration, which showed the results of a Google search and a business names search respectively. Both searches were based upon the word *multifix*.
42. The opponent then asserted that the applicant had failed to provide evidence to show that the applicant's claimed use was before that of all these other parties identified in the searches. It was further submitted that the applicant has had the opportunity to produce evidence of the extent of its use and reputation in the trade mark MULTIFIX, but has failed to do so.
43. I cannot concur with the opponent's line of reasoning for this ground. The burden is on the opponent to establish its grounds. It is for the opponent to establish that a substantially identical trade mark to that of the applicant has been used as a trade

mark in respect of the same kind of goods or services before the priority date of the applicant's trade mark.

44. The opponent has not done so. It is not enough to point to a list of instances of the word *multifix*, and expect the applicant to disprove that these are instances of prior trade mark use. I dismiss this ground of opposition.

Decision

45. The opponent has not established its grounds of opposition. Therefore, the applicant's trade mark may proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been decided or discontinued.

Costs

46. The applicant sought its costs. I see no reason why costs should not follow the general rule. I award costs against the opponent and direct that the opponent pay the costs of the applicant in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations 1995*).

Jock McDonagh
Hearing Officer
Trade Marks Hearings
29 July 2005