

TRADE MARKS ACT 1995

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

Re: Opposition by The Pharmaceutical Plant Co Pty Ltd to registration of trade mark application 971766(5) - **TRIPLEX** - filed in the name of TP Health Ltd.

DELEGATE:	Alison Windsor
REPRESENTATION:	Opponent: Susan C Thompson of counsel instructed by Barrett Walker lawyers Applicant: Michelle Howe, associate of Davies Collison Cave, Patent and Trade Mark attorneys
DECISION:	S52 opposition Grounds under section 44, 58 and 60 not established. Opposition unsuccessful. Costs awarded against opponent.

Background

1. TP Health Ltd (“the applicant”) filed an application to register a trade mark. Current details of the application are shown below.

Application Number: 971766

Trade Mark **TRIPLEX**

Filing Date: 24 September 2003

Acceptance advertised: 22 April 2004

Goods claimed: **Class 5:** Medicinal herbs, herbal substances, pharmaceutical, medical, vitamin preparations, food and nutritional substances for medical and therapeutic purposes

2. During the course of examination, registered trade mark 779202 was raised as a ground for rejecting the application, under the provisions of section 44 of the *Trade Marks Act 1995* (“the Act”). Details of this registration as they currently stand are as follows:

Trade Mark number: 779202

Trade mark:



Priority date: 25 November 1998

Goods claimed: **Class 5:** Herbal and homoeopathic medicines

3. The applicant provided the examiner with a statutory declaration claiming continuous use from a date earlier than the registered trade mark's priority date. The application proceeded to acceptance for possible registration under the provisions of subsection 44(4) - prior and continuous use. The acceptance was advertised on 22 April 2004.
4. The Pharmaceutical Plant Co Pty Ltd ("the opponent"), owner of the cited trade mark registration, filed a notice of opposition on 31 May 2004. 12 grounds were nominated, but on closer inspection, these can be reduced to six, being grounds under sections 41, 42, 44, 58, 60 and 62.
5. The usual service of evidence followed, and in due course the application came before me, as delegate of the Registrar, at a Hearing in Canberra on 7 April 2006. Susan Thompson of counsel represented the opponent via telephone conference, while Michelle Howe, associate of Davies Collison Cave appeared to represent the applicant.

Evidence

6. The evidence filed and served is set out in the table below.

Declarant	Date Declared	Exhibits
<i>Evidence in support</i> Gordon S Robertson Graham Williams	24 August 2004 24 August 2004	GR-1 to GR-8 GW-1 to GW-2
<i>Evidence in Answer</i> Katherine Louise Kemp Bruce McGilvray	20 April 2005 18 May 2005	KLK-1 BG-1 to BG-3
<i>Evidence in Reply</i> Leofwin Alston	21 September 2005	

Evidence in Support

7. The Robertson declaration states that the opponent company was established as a vehicle to purchase an existing business which manufactured herbal medicines, and had been trading since 1987 under the name “The Pharmaceutical Plant Company”. The opponent company continued trading and built on the existing business goodwill with emphasis on manufacturing, preparing and processing herbal and homeopathic medicines, herbal preparations and associated products. These goods were distributed and sold via naturopathic and homeopathic practitioners and various retail outlets, including pharmacies and health food shops throughout Australia. The declaration attests to the various licences and certifications held by the company in respect of its herbal and medicinal preparations.
8. Towards the end of 1992, the company decided to promote certain medicinal homeopathic products and herbal preparations by establishing what they referred to as their “plex” range. Mr Robertson states the suffix “-plex” is short for “complex”, and its use is consistent with the commonplace naming of herbal medicines used throughout the homeopathic fraternity, referring to those substances containing two or more active ingredients. Included in this range and first promoted and sold throughout Australia around early 1997, he says, is the TRIPLEX preparation. This preparation is an anti-parasitic remedy comprised of three main ingredients – black walnut, wormwood and cloves. The substance is based on “Dr Hulda Clark’s original formula of a proven and well respected anti-parasitic remedy”. Dr Hulda Clark is described in the declaration as a “world renowned” Canadian naturopath.
9. The Robertson declaration notes that there have been various versions of the word TRIPLEX in use on the goods with or without the “get-up” shown in the now registered trade mark, and with or without use of the word “herbal” in conjunction.
10. The Williams declaration is made by Graham Williams, a qualified homeopath with 10 years experience as a homeopath and natural therapist and experience within the retail health industry as well. From his experience within the industry Mr Williams says he is familiar with both substances which carry the TRIPLEX name. He notes they are very different substances, one being an antiparasitic based on Dr Hulda Clark’s original formula, and the other being a blend of three types of Echinacea herb, generally used for immune deficiency and/or acute infection. Mr Williams states his

awareness of both products being sold in the same and similar retail outlets throughout Australia.

11. Mr Williams attests to two specific instances he is aware of when there was confusion between the TRIPLEX products. These occurrences he dates within 2 months prior to the signing of his declaration.

Evidence in answer

12. The Kemp declaration consists of reference to a search of the Trade Marks Office electronic database, and includes a list of 120 entries in class 5 appearing on the database all of which include the suffix “-plex”.
13. The McGilvray declaration attests to the purchase in January 2001 of a business known as Greenridge Botanicals. From their business records Mr McGilvray states that the trade mark TRIPLEX was first used in May 1997 for a herbal formulation consisting of a blend of three types of Echinacea. He states the herb is known for its ability to help reduce the severity of acute symptoms of colds and flu, as well as to relieve the symptoms of allergies, hay fever, mucous congestion, tonsillitis and laryngitis. The declaration provides sales figures for the TRIPLEX product covering the period July 1997 to June 2004, as well as numbers of items sold. The advertising figures provided, Mr McGilvray notes, are for a complete range of goods under the Greenridge banner, not just the TRIPLEX product.
14. Mr McGilvray attests to 30 years experience in the manufacturing and marketing of pharmaceutical and complementary healthcare products and in that time, he says, he has never heard of the use of the trade mark TRIPLEX by any other company or individual in respect of the same goods in the same field until this opposition was filed. He also states that there has been no confusion between the two substances reported via a 1800 consumer assistance help line run by his company.

Evidence in reply

15. The evidence in reply consists of a single declaration by Leofwin Alston, director of a company known as Inner Glow Health Products Pty Ltd. He attests to 12 years involvement as an owner/operator of businesses in the complementary health industry. Mr Alston attests to familiarity with the opponent’s products over a number

of years. He also attests to recent instances of confusion between the two TRIPLEX products, which he states occurred in 2005.

Submissions

16. I shall address the submissions of the parties as is necessary in my reasons, below.

Discussion and reasons

17. The opponent's submissions dealt with grounds raised under section 44, section 58 and section 60. For completeness, I find the grounds under sections 41, 42 and 62 have not been established.

Section 44 – identical etc trade marks

18. In respect of this ground, the Act relevantly allows the following:

Identical etc. trade marks

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; or

(ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; 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.

...

(3) If the Registrar in either case is satisfied:

(a) that there has been honest concurrent use of the 2 trade marks; or

(b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

Note: For *limitations* see section 6.

(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.

19. The notice of opposition referred to a number of trade marks as support for grounds under section 44. The marks are listed below:


Number	Trade Mark	Class
376023	MITSUBOSHI TRIPLEX	7
383961	TRIPLEX	21
433366	NUTRIPLEX	3
578873	TRIPLEX	12
591213	NUTRI-PLEX BY RENA WARE	21
644640	CENTRIPLEX	9
960479	TRIPLE-XZONE	25
971766	TRIPLEX	5

20. In its submissions, the opponent noted that the final entry on the list was in error, as it should have shown its own trade mark, 779202. It then advised it did not intend to argue that any of these trade marks were substantially identical or deceptively similar. The applicant, in its submissions, argued that not only were none of these trade marks relevant, but that since the opponent's trade mark did not form part of this list, the opponent could not now rely on it as a basis of opposition under section 44. They went on, however, to address the applicant's trade mark in detail, understanding the possibility that the Hearing Officer may decide to consider the registration as a basis for opposition. While it is preferable for an opponent to identify which trade marks it considers to be relevant to grounds for opposition under section 44, and the Trade Marks Office encourages parties to do this, identifying the trade mark in the notice of opposition is not a requirement of either the Act or the Regulations.¹ In its evidence

¹Note that there is a requirement to supply relevant trade marks in notices of opposition which are filed in respect of applications proceeding under the Madrid Protocol.

in support, the opponent made it abundantly clear where its concerns lay. What I need to consider now, is how section 44 affects the applicant's trade mark, given the existence of the opponent's trade mark.

21. Three questions must all be answered in the affirmative before a decision can be made on how the provisions of section 44 apply:
- Is the priority date of the opponent's trade mark earlier than that of the applicant?
 - Are the two trade marks substantially identical or deceptively similar?
 - Are the goods similar goods?
22. There is no question about the priority date. The opponent's trade mark, 779202, has a priority date of 25 November 1998, well before the applicant's priority date of 24 September 2003. This question is answered in the affirmative.
23. Considering the two goods specifications, it is clear that the opponent's claimed goods, herbal and homoeopathic medicines, are a subset of the applicant's claimed goods - medicinal herbs, herbal substances, pharmaceutical, medical, vitamin preparations, food and nutritional substances for medical and therapeutic purposes. This question is thus also answered in the affirmative.
24. The remaining question is whether the two trade marks are substantially identical or deceptively similar. The trade marks are as follows:

971766	TRIPLEX
779202	

25. The test for whether trade marks are substantially identical requires that the two trade marks “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”.²
26. On a side by side comparison, there are some differences between the trade marks. The opponent's trade mark has hyphenated the word TRIPLEX as TRI- PLEX. They have also added some “get-up” to the word – oblique lines, the word “herbal” and

² Per Windeyer J in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407 at 414-415:

variations in font within the word TRI-PLEX The applicant's mark is the plain word TRIPLEX in upper case letters. I am satisfied that, on a side by side comparison, the total impression of the marks will always be the word TRIPLEX. The additional material in the opponent's trade mark serves only as descriptive or decorative adjuncts to the word. It is immaterial whether the word is divided or not. The total impression is one of complete similarity, and the two trade marks must be regarded as substantially identical.

27. The third question is thus answered in the affirmative.

Discretion within section 44

28. Having found the three questions pertinent to section 44 answered in the affirmative is not, however, the end of the matter. There is a discretion within section 44 for the Registrar to take account of concurrent use or prior use of a trade mark. These provisions allow trade marks which are caught by the provisions of subsection 44(1) to coexist on the register, and it is appropriate here that I consider them, the more so since I note the application was accepted for possible registration under the provisions of subsection 44(4).

Prior use – subsection 44(4)

29. If, during the course of examination, an applicant satisfies the examiner that the requirements of subsection 44(4) have been met, the trade mark application will be accepted for possible registration. For the purposes of achieving acceptance, the examiner will request the applicant provide a statutory declaration which attests to the applicant's use of their trade mark from before the earlier trade mark's priority date, continuing up until at least their own filing date. The declaration is taken at face value at the examination stage.
30. The examples of the trade mark in use which were provided show the following two versions of the word TRIPLEX when it is in use on the goods claimed:



Image 1



Image 2

31. The opponent in its submissions puts weight on the presence of the word “echinacea” or the expression “immune booster” used with the trade mark, pointing to the importance of these terms in creating a “composite mark”.
32. What I consider is important here is a basic question, but one which is significant in respect of this opposition: does the evidence the applicant has provided show use of the trade mark as filed, or does it show one with a different identity?
33. The word TRIPLEX or TriPlex is prominent on each label. Despite the additional material, which includes the word “Greenridge”, a triangular device pointing down from the top edge, as well as the word “herbal”, or the expression “liver tonic” mentioned by the opponent in its submissions, the main thrust of the label is the word TRIPLEX. The labels also include colours and in Image 1, a checked background, but I do not consider these latter factors are of great import for the purpose of this consideration.
34. The trade mark as filed is the word TRIPLEX in plain uppercase letters. The use demonstrates two minor changes in font styles, noted above at the beginning of paragraph 33. These are additions or alterations which do not substantially affect the identity of the trade mark. Any additional words used with the trade mark are either descriptive words, such as “herbal” or “liver tonic”, or are another trade mark entirely such as “Greenridge”. It is not unusual for a trader to use more than one trade mark on its labeling, and this is what is shown on the applicant’s labeling. I am satisfied the mode of use does not change the identity of the trade mark the applicant has applied for.
35. As well as the questions about the mark in commercial use, there are questions about the claimed date of first use. For the purposes of responding to the examiner’s first

report, the applicant nominated a first use date of April 1998. The McGilvray declaration provided as evidence in answer claims first use in May 1997. Neither of these dates is substantiated in the evidentiary material. Exhibit BG-1 to the McGilvray declaration, however, consists of a document labeled “General National Advertising Schedule 1999”, thus substantiating a date some time in that year. This date is later than the opponent’s priority date of 25 November 1998. I am therefore not satisfied that the applicant’s claim for prior use has been made out.

Honest concurrent use – paragraph 44(3)(a)

36. Even though the grounds on which the application was initially accepted for registration have not been substantiated, consideration may be given to the matter of honest concurrent use, as provided for by paragraph 44(3)(a). In the *McCormick’s*³ decision, Kenny J affirmed that the applicability of the criteria pertinent to the *Trade Marks Act 1955* and its predecessors are of equal applicability to the *Trade Marks Act 1995*. At paragraph 30, she said:

“Section 44(3) gives the Registrar a discretion to accept an application that would otherwise be rejected under s 44(1) in the case of honest concurrent use or other circumstances making it proper to do so. The authorities establish that the principal criteria for determining whether registration should be permitted pursuant to s 44(3) include:

- (1) the honesty of the concurrent use;
- (2) the extent of the use in terms of time, geographic area and volume of sales;
- (3) the degree of confusion likely to ensue between the marks in question;
- (4) whether any instances of confusion have been proved; and
- (5) the relevant inconvenience that would ensue to the parties if registration were to be permitted.

...⁴

These factors are not necessarily exhaustive of the matters to be considered, but they are a useful guide: see *In Re Electrix Ltd's Application* [1957] RPC 369 at 379.

³ *McCormick & Company Inc v McCormick* [2000] FCA 1335

⁴ See *In Re Alex Pirie & Sons Ltd's Application* (1932) 49 RPC 195; (1933) 50 RPC 147 at 159-160; *In Re John Fitton & Co Ltd's Application* (1949) 66 RPC 110 at 112; and *Stingray Surf Co Pty Ltd v Lister* (1997) 37 IPR 306 at 310-311.

37. Both parties, in their submissions, made reference to these criteria. It is appropriate that I consider them in some detail.

The honesty of the use

38. In *McCormick*, supra, at paragraph 31, Kenny J said:

The rights of the parties are to be determined as at the date of the application for registration - in this case, 9 March 1992: *Southern Cross* at 594-95; *In Re Simac SpA Macchine Alimentari's Application* (1987) 10 IPR 81 ("Simac") at 90-91; *Aromas Pty Ltd v Aroma Coffee & Tea Co Pty Ltd* (1997) 40 IPR 75 ("Aromas") at 86; and *Trepper v Miss Selfridge Ltd* (1991) 23 IPR 335 at 346.

The honesty of concurrent use refers to "commercial honesty, which differs not from common honesty": see *In Re Parkington & Co Ltd's Application* (1946) 63 RPC 171 at 182. In that case, Romer J said at 181-182:

[T]he circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user.

39. The relevant date is 24 September 2003, the application date of the trade mark under opposition.
40. The only information about the adoption of the trade mark are to be found in the applicant's submissions which state "the applicant's predecessor, Greenridge Botanicals, adopted the trade mark TRIPLEX in good faith". As there is little information to hand concerning the applicant's acquisition of the Greenridge business, it is not surprising that this material is missing. The submissions go on to say "it is reasonable to conclude that the applicant's predecessor was not aware of the opponent's use of the trade mark TRIPLEX at the time of adoption of its trade mark TRIPLEX". I consider this to be speculation on the part of the applicant, and decline to give it significant weight.
41. The claimed dates of first use are very close – the opponent's "early 1997" as against the applicant's "May 1997". Neither date is substantiated – both are claims made within the leading declarations provided by the parties. The opponent has given a rationale for choosing its trade mark – this is set out in paragraph 8 above. As a general comment, the two word elements, TRI and -PLEX are each elements with relevance to the product concerned. According to the *Oxford English Dictionary*, TRI is a combining form meaning "three"; -PLEX is a suffix meaning "times" or "fold".

The word TRIPLEX is therefore a logical construction for goods involving three ingredients. It is not beyond the realms of possibility that two people dealing in the kinds of goods these parties deal in would think of the same construction and decide to use it as a trade mark. Given the closeness of the claimed dates of first use and the fact that two companies who were setting out to produce herbal complexes were geographically separate from each other, I am able to entertain the possibility that neither party was aware of the other at the time of adopting their respective trade marks. However, this possibility does not go far towards establishing that the trade mark was adopted honestly by the applicant's predecessor in business.

42. Mr McGilvray, at paragraph 12 of his declaration states that he has been associated with the manufacturing and marketing of pharmaceutical and complimentary (sic) healthcare products for thirty years, and in that time he says he has acquired a knowledge of the trade names and trade marks used by different manufacturers in the field. He says in that time he has not heard of any other trader using the word TRIPLEX in respect of the same goods in the same field until the filing of this opposition.
43. The applicant has demonstrated extensive use of his trade mark over a number of years. While Mr McGilvray did not supply information to satisfy me his predecessor in business adopted its trade mark honestly, I am satisfied Mr McGilvray himself was unaware of the existence of the opponent's trade mark registration until informed by the Trade Marks Office. I am satisfied his use of the trade mark over the years attested to has been honest use.

Extent of use of the trade mark

44. The applicant has provided sales figures for goods sold under the trade mark for the period 1997-98 to 2003-2004. The relevant date is 24 September 2004. These figures allow for at least 5 years use by the time the application was filed, and during the whole of that time the opponent's trade mark was also present in the market.
45. From the figures supplied to me, it appears the applicant's goods are sold at a lower price than those of the opponent. The applicant's sales both in dollar figures and number of units sold, is much larger than that of the opponent. Neither party was able to supply targeted advertising figures, but it is clear both parties advertise their goods via various means. The applicant appears to advertise much more widely than the

opponent, advertising in mainstream publications such as newspapers, while the opponent advertises within its specialist market by providing material to practitioners twice per year. On the basis of the information provided to me, I am satisfied that the applicant has concurrently used its trade mark alongside that of the opponent for at least 5 years.

The degree of confusion

46. It is appropriate to note here the actual goods both parties produce and sell under their trade marks. The opponent's goods are an anti-parasitic complex, made from three herbal ingredients – wormwood, black walnut and cloves. The purpose of the substance is to rid the body of unwanted passengers – intestinal parasites such as intestinal flukes and worms which may be harmful to general health.
47. The applicant's product also consists of a mixture of three herbal ingredients, but these are three types of Echinacea. The product has a completely different purpose to that of the opponent, being an immune system booster or herbal tonic comprising extracts of three Echinacea plants, and designed to help the body deal with infections such as colds and flu. It is unlikely to have any particular effect on internal parasites.
48. On the face of it, the likelihood of confusion between these two trade marks appears high. The trade marks are deceptively similar. The goods are sold in many of the same outlets. However, these two substances are not interchangeable. A person obtaining the wrong one, while unlikely to be morbidly affected, will certainly not get the result they expect from its use. Rather than one party benefiting from the trade mark reputation of the other if the wrong product is purchased, the effect on the company is likely to be deleterious when the expected result from the product is not obtained.
49. In the *Moo/Moove* case⁵, at paragraph 12 of his judgment, Deane J observed:

The doctrine of honest concurrent user meant that a degree of confusion had to be tolerated within the system. The mere fact that the use of a mark would be likely to deceive or cause confusion was not necessarily sufficient to support an injunction restraining that use. That, Lord Diplock explained, at pp 745, 748; pp 521, 524 of All ER, was how s.11 and its predecessors came to be interpreted in such a way that something more than mere deception or confusion was required to disentitle a trade mark to protection in a court of justice.

⁵ *New South Wales Dairy Corp. v Murray Goulburn Co-Op Co. Ltd.* (1990) 171 CLR 363

50. In the *CHOC CHILL* case⁶, Carr J, despite finding the likelihood of confusion was high (albeit, apparently, confined to Western Australia) allowed the registration to proceed. I am inclined to follow this ruling because of the surrounding circumstances of this case.

Instances of actual confusion

51. The opponent makes reference to recent instances of confusion it has become aware of. The Williams and Alston declarations both refer to situations where purchasers have been unsure which substance carrying a TRIPLEX trade mark was the appropriate one. These are not well documented and appear to have occurred post the relevant date. I am unable to give them a lot of weight because they occurred well after the date at which I must consider the state of play. The applicant, however, declares it is not aware of any confusion at all, despite running a 1800 Customer Assistance telephone line for its customers.
52. I consider there is a high probability of confusion between the two substances. However, they are both sold via trade outlets where it is possible to seek advice on the appropriateness of the particular remedy. I consider this mitigates to some extent the amount of confusion which will actually happen in the market.

The relevant inconvenience

53. I consider the balance of inconvenience here lies with the applicant. Both parties have used their trade marks in the trade for a number of years. If I was to refuse to register the applicant's trade mark, its years of presence within the market would be unrecognised. It seems to me appropriate that this use be reflected on the register of trade marks in order to demonstrate it has rights in the trade mark, and allow it to use the provisions of the Act to protect its trade mark should it be threatened by third parties.
54. The opponent, on the other hand, already has its trade mark registered. It is unlikely to be more inconvenienced by the registration of the applicant's trade mark than it already has been by the presence in the same market of the similar trade mark.
55. In the exercise of my discretion under section 44(3), having weighed all the factors noted above, I find the applicant has demonstrated honest concurrent use of its trade

⁶ *PB Foods Ltd v Malanda Dairy Foods Ltd* [1999] FCA 1602 (17 November 1999)

mark with that of the opponent. However, I also find this use is only demonstrated in respect of the goods discussed in paragraph 47 above – that is, “herbal tonic comprising extracts of three Echinacea plants”. If I find the remaining grounds of opposition are not established, I shall revert to this matter when giving my decision.

Section 58 – applicant not owner of the trade mark

56. The ownership rights in a trade mark reside in either the first use in trade in Australia on the relevant goods⁷, or the making of the application to register⁸, whichever is the earlier. Neither party has substantiated its date of first use. Annex GR-8 of the Robertson declaration includes a copy of a faxed letter to a pharmacy advising of the opponent’s product pricing to pharmacies as at 3 December 1997. This date is well before the applicant’s filing date (24/9/2003) but is after both parties claim they began use of their trade marks under common law.
57. I find that since the opponent has not substantiated a date of first use, I am unable to be satisfied that it has the right to claim ownership of the trade mark. The ground of opposition under section 58 has not been established.

Section 60 – trade mark with a reputation in Australia

58. The opponent has not provided sufficient information to support a claim for a reputation as envisaged by this section of the Act. Its sales volumes are not large, and evidence about promotion and recognition in the trade are more hinted at than substantiated. This ground of opposition therefore has not been established.

Decision

59. The opponent has not established grounds of opposition under sections 58 and 60. In respect of the ground under section 44, I will register the trade mark under the provisions of subsection 44(3)(a) - honest concurrent use - on the condition the applicant requests its goods specification be amended to read “herbal tonic comprising extracts of three Echinacea plants”. If this condition is not met, the application is refused. The request should be made within one month of the date of this decision.

⁷ See *Settef S.p.A. v Riv-Oland Marble Co. (Vic) Pty Ltd* 10 IPR 402 at 413. This is in reference to the common law right in the trade mark.

⁸ See *Shell Co (Aust) Ltd v Rohm & Haas Co* (1948) 78 CLR 601 at 625 to 628

Appeal

60. This decision is subject to appeal to the Federal Court. If the registrar is notified of an appeal, the application should not be amended or registered until the Court has decided the appeal, or the appeal has been discontinued.

Costs

61. The applicant having been successful is entitled to its costs and I award costs as per Schedule 8 of the Regulations against the opponent.

Alison Windsor
Hearing Officer
Trade Marks Hearings
23 June 2006