

## TRADE MARKS ACT 1995

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

Re: Opposition by MYOB Technology Pty Ltd to registration of trade mark applications 979274(36) MYOFP - and 979272(36) MIND YOUR OWN FINANCIAL PLANNING proceeding in the name of Slick Solutions Pty Ltd.

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| <b>DELEGATE:</b>       | <b>Iain Thompson</b>   |
| <b>REPRESENTATION:</b> | <b>Opponent</b><br>Adam Sears of Davies Collison Cave                                |
|                        | <b>Applicant</b><br>Did not appear or put in written submissions                     |
| <b>DECISION:</b>       | 1. s52 opposition, 44,- registration refused.<br>2. Costs ordered against applicant. |

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#### Background

1. Slick Solutions Pty Ltd, ('the applicant') has filed applications to register trade marks, current details of which are:

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| App No:            | 979274   |
| Filing Date:       | 22 November 2003   |
| Acceptance Advert: | 22 April 2004  |
| Services:          | <b>Class: 36:</b> Financial services, including purchase payment and bill payment services, electronic purchase payment and electronic bill payment services; electronic banking services; electronic accounts payable services; funds, money and currency transfer services; financial advisory, consultancy and provision of financial information relating to the aforesaid services; the aforesaid services being provided electronically or by other means; insurance; financial affairs; monetary affairs; real estate affairs; sale/purchase of financial products and services |
| Trade Mark:        | MYOFP  |

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|--------------------|--|
| App No:            | 979272   |
| Filing Date:       | 22 November 2003   |
| Acceptance Advert: | 6 May 2004   |
| Services:          | <b>Class: 36:</b> Financial services, including purchase payment and bill payment services, electronic purchase payment and electronic bill payment services; electronic banking services; |

electronic accounts payable services; funds, money and currency transfer services; financial advisory, consultancy and provision of financial information relating to the aforesaid services; the aforesaid services being provided electronically or by other means; insurance; financial affairs; monetary affairs; real estate affairs; sale/purchase of financial products and services

Trade Mark: MIND YOUR OWN FINANCIAL PLANNING

2. On 16 July 2004, MYOB Technology Pty Ltd, ('the opponent') filed Notices of Opposition ('the Notices') to the registration of the trade marks. The Notices cite most of the available grounds under the *Trade Marks Act 1995* ('the Act').
3. Evidence in support was duly served and filed in accordance with the Act and regulations thereto. There is no evidence in answer.
4. As a delegate of the Registrar of Trade Marks, I heard the arguments of the opponent, made by Adams Sears of Davies Collison Cave, at a hearing in Melbourne on 6 June 2006.

### **Evidence**

5. Evidence in support of the opposition in the form of a statutory declaration by Andrew Craig Winkler, CEO of MYOB Limited (the parent company of the opponent), of Burwood East, Victoria, shows that the opponent has used and registered a number of trade marks based around its well-known MYOB trade mark in Australia. The opponent's use of the MYOB and MIND YOUR OWN BUSINESS trade marks started in 1992 in relation to financial and accounting software. The opponent has sold goods or provided services relating to financial and business management under this family of trade marks to some 500,000 small businesses in Australia and elsewhere in the world and approximately 10,000 accounting firms worldwide.
6. The acronym MYOB is an initialisation of the words Mind Your Own Business. The words MIND YOUR OWN BUSINESS are also a registered trade mark of the opponent

and occur alongside their acronym on the opponent's advertising and promotional materials.

7. Brief details of some of the opponent's relevant registrations are:

Reg Number 931872  
Priority date: 24 October 2002  
Goods/Services: Class: 9 Computer software and software packages for business and business management, accounting, electronic payment, office administration, processing of sales and purchases, calculation of GST, manuals sold therewith as a unit  
Trade Mark: MIND YOUR OWN BUSINESS

Reg Number 784312  
Priority date: 2 February 1999  
Goods/Services: Class: 9 Computer hardware, computer software including software packages directed to accounting; instructional and other manuals sold therewith as a unit  
Class: 16 Printed publications and printed matter; instructional and other manuals and publications relating to computers and computer software  
Class: 35 Retail and wholesale of computer hardware, computer software and manuals for use therewith  
Class: 41 Educational and training services relating to computers and computer software  
Class: 42 Computer hardware and computer software development and consultancy services; computer hardware and computer software support services  
Trade Mark: MYOB

Reg Number 865577  
Priority date: 9 February 2001  
Goods/Services: Class: 35 Business administration, business management, business assistance; business services; business advisory, consultancy and provision of business information relating to the aforesaid services; the aforesaid services being provided on-line, electronically or by other means  
Class: 36 Financial services, including purchase payment and bill payment services, electronic purchase payment and electronic bill payment services; electronic banking services; electronic accounts payable services; funds, money and currency transfer services; financial advisory, consultancy and provision of financial information relating to the aforesaid

services; the aforesaid services being provided electronically or by other means

Class: 42 Computer services relating to the provision of access to computer databases, the Internet and other facilities including providing a portal site on the Internet providing links to other sites; providing access to databases and Internet sites for the retrieval and downloading of information relating to financial affairs; computer research, advisory, consultancy and information services relating to the aforesaid services

Trade Mark: MYOB

Reg Number 721728

Priority date: 14 November 1996

Goods/Services: Class: 9 Computer software including accounting software

Trade Mark: M.Y.O.A.

Reg Number 721729

Priority date: 14 November 1996

Goods/Services: Class: 9 Computer software including accounting software

Trade Mark: M.Y.O.C.

8. Mr Sears appends to a declaration of his in support of the opposition a search of the Trade Marks Office database of trade marks on ATMOSS which shows that the only other trade marks in relevant associated classes for closely related goods or services which contains the 'prefix' MYO- is 826716(9), (35), (36), (38), (39), (41), (42) MYOSPHERE.

### **Submissions**

9. The opponent was prepared to argue its grounds under sections 44(2), 60 and 42(b). At the hearing, after listening to the opponent's submissions in relation to section 44(2), I told Mr Sears that I would decide this matter under that ground as this matter, to my mind, is quite clear-cut.

### **Reasons**

10. Section 44 of the Act relevantly provides:

- (2) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:
- (a) it is substantially identical with, or deceptively similar to:
    - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
    - (ii) a trade mark whose registration in respect of similar services or closely related goods 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 services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar services* see subsection 14(2).

Note 3: For *priority date* see section 12.

Note 4: The regulations may provide that an application must also be rejected if the trade mark is substantially identical with, or deceptively similar to, a protected international trade mark or a trade mark for which there is a request to extend international registration to Australia: see Part 17A.

11. I think that, here, there is no question that the goods and services of the opponent are not either similar or closely related to the services of the applicant. Indeed, for reasons that I will mention later in this decision, the services, at least, must be similar services.
12. The registrations on which the opponent relies all have priority dates that are earlier than that of the opposed applications. The questions that remain, therefore, are whether the trade marks of the parties are either substantially identical or deceptively similar.
13. The trade marks of the applicant, when compared side-by-side are (respectively) not substantially identical to any of the corresponding trade marks relied on by the applicant.
14. Deceptive similarity is defined within section 10 of the Act:

### **10 Definition of *deceptively similar***

For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

15. The expression 'deceptively similar' was discussed in *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 at paragraph 50, French J, with Tamberlin J agreeing, made the following propositions:

(i) To show that a trade mark is deceptively similar to another it is necessary to show a real tangible danger of deception or confusion occurring. A mere possibility is not sufficient.

(ii) A trade mark is likely to cause confusion if the result of its use will be that a number of persons are caused to wonder whether it might not be the case that the two products or closely related products and services come from the same source. It is enough if the ordinary person entertains a reasonable doubt.

It may be interpolated that this is another way of expressing the proposition that the trade mark is likely to cause confusion if there is a real likelihood that some people will wonder or be left in doubt about whether the two sets of products or the products and services in question come from the same source.

(iii) In considering whether there is a likelihood of deception or confusion all surrounding circumstances have to be taken into consideration. These include the circumstances in which the marks will be used, the circumstances in which the goods or services will be bought and sold and the character of the probable acquirers of the goods and services.

(iv) The rights of the parties are to be determined as at the date of the application.

(v) The question of deceptive similarity must be considered in respect of all goods or services coming within the specification in the application and in respect of which registration is desired, not only in respect of those goods or services on which it is proposed to immediately use the mark. The question is not limited to whether a particular use will give rise to deception or confusion. It must be based upon what the applicant can do if registration is obtained.

In respect of the last proposition, Mason J observed in *Berlei Hestia Industries Ltd v The Bali Co Inc* (1973) 129 CLR 353 at 362:

"the question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark. The issue is whether that use would give rise to a real danger of confusion."

16. There is another factor which I should, when considering the likelihood of confusion between the trade marks of the parties, take into account in appropriate cases. In *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641, Dixon and McTiernan JJ stated:

The rule that if a mark or get-up for goods is adopted for the purpose of appropriating part of the trade or reputation of a rival, it should be presumed to be

fitted for the purpose and therefore likely to deceive or confuse, no doubt, is as just in principle as it is wholesome in tendency. In a question how possible or prospective buyers will be impressed by a given picture, word or appearance, the instinct and judgment of traders is not to be lightly rejected, and when a dishonest trader fashions an implement or weapon for the purpose of misleading potential customers he at least provides a reliable and expert opinion on the question whether what he has done is in fact likely to deceive. Moreover, he can blame no one but himself, even if the conclusion be mistaken that his trade mark or the get-up of his goods will confuse and mislead the public.'

17. This approach was adopted by Branson J in *NEC Corporation v Punch Video (S) Pte Limited* [2005] FCA 1126 where the evidence established that the applicant had exactly copied the font in the NEC portion of the trade mark NECVOC from the trade mark of the opponent.

18. Concerning the comparison of the trade marks, Dixon and McTiernan JJ in *Australian Woollen Mills Ltd*, above, at page 658 say:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, their similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected.

19. And Lord Parker (then Parker J) in *Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777, said:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -- that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods -- then you may refuse the registration, or, rather, you must refuse the registration in that case.

20. I am thus to consider all of the surrounding circumstances in deciding whether the trade marks of the parties are deceptively similar to each other.
21. I think that it is quite plain that the letters in the applicant's trade mark MYOFP are an initialisation of the words Mind Your Own Financial Planning since those are the words in the applicant's other opposed trade mark which is here under consideration.
22. There are no other registered trade marks on the Australian register (apart from those here under discussion) which are susceptible to the MIND YOUR OWN [...] construction. The MYOSPHERE trade mark, mentioned above, which is in related classes is registered for goods and services associated with mobile phone technology. The trade mark MYOSPHERE is, I will note, an obscure pun as it is (in its ordinary sense) a word used to describe certain groups or clusters of animal cells in microbiology – the pun is with clustered or grouped 'cell' phone technology. I do not see this registration as assisting the applicant in any way since it is obviously a word, rather than an acronym, and is furthermore a real word (albeit it one not in common use). It is most unlikely, I think, that this word would be seen by most people as 'Mind Your Own Sphere'.
23. The signs MYOB and MYOFP are likely to be pronounced as an initialisation rather than as words. This reinforces the similarities between them. Further, the construction MYOB (or MIND YOUR OWN BUSINESS) is, in relation to the goods and services of the opponent, memorable and distinctive. It is likely to be retained and remembered by the public and recalled when seeing the opposed trade marks. There is no suggestion in the evidence (nor is it within my experience) that the construction MIND YOUR OWN [...] is in any way common to the trade of the parties or normally used by other traders in relation to their goods or services. On this basis, it is likely that purchasers will perceive the trade marks of the parties as being related and having a common source in trade.

24. I am thus satisfied that the trade marks of the applicant are deceptively similar to those of the opponent.
25. The opposition under section 44 is established for the above reasons. However, the opposed applications are unusual as further discussed below.
26. Both of the two opposed trade marks have similarities which correspond to two of the opponent's registered trade marks – MYOB and MIND YOUR OWN BUSINESS. This suggests a degree of copying of the opponent's trade marks (which, as I have discussed, above, use a construction which is unique to the opponent's registered trade marks). This, of course, is not determinative in itself – imitation is the most sincere form of flattery and, in the context of the opposed applications, is allowable if the result is not that the use trade marks would confuse or deceive.
27. However, the similarities do not end here. In Class 36 of the *International (Nice) Classification of Good and Services*, the opponent's specification of services is:

Financial services, including purchase payment and bill payment services, electronic purchase payment and electronic bill payment services; electronic banking services; electronic accounts payable services; funds, money and currency transfer services; financial advisory, consultancy and provision of financial information relating to the aforesaid services; the aforesaid services being provided electronically or by other means

28. The specifications of services in the opposed applications read:

Financial services, including purchase payment and bill payment services, electronic purchase payment and electronic bill payment services; electronic banking services; electronic accounts payable services; funds, money and currency transfer services; financial advisory, consultancy and provision of financial information relating to the aforesaid services; the aforesaid services being provided electronically or by other means; insurance; financial affairs; monetary affairs; real estate affairs; sale/purchase of financial products and services

29. The differences between the specifications of services of the parties lie only in those words that are underlined, above. At the hearing, Mr Sears advised me that he had drafted the specification of services in Class 36 for the opponent's registrations having reviewed

the opponent's business plan. On my request, Mr Sears has furnished a statutory declaration to that effect (both the copying of the specification and an anticipation that the opponent might rely on it are acknowledged in a letter from the applicant on the official file). The opponent's specification of services is thus not one which has been, for instance, innocently copied from a Class heading or Class description or some other source – it is one that has been copied from the opponent's registration with the opponent's registrations in mind and probably in view at the time of the copying.

30. The similarities between both the trade marks in question and the specifications of services leads me to consider that, at the lowest it can be stated, there is an inference that the applicant or an employee has been fully aware of the similarity of the trade marks, has known that the applicant's trade marks are based on those of the opponent, and has copied the specifications of services accordingly. At the highest it could be stated, there is an inference that the applicant has set out to copy as nearly as it thought it could the opponent's trade marks, has patterned its applications accordingly, and has also copied its relevant specification of services. The most obvious reason for this copying is that the applicant wished to piggyback on the reputation of the opponent's trade marks – however, the only problem with this approach to the adoption or coinage of trade marks is that confusion or deception is the most likely result.

31. Whichever of the reasons for the copying of the specifications is true, the result is materially the same. In the first, a person who is employed by the applicant believes that the trade marks are so similar to the opponent's that, when filing the applications, he or she copied the opponent's specification of services. If this belief existed amongst the applicant's employees, it is most likely that a member of the public would be similarly deceived or confused.

32. However, in the absence of evidence from the applicant which would dispel the proposition, I think that the latter course of action (suggested at paragraph 30, above) of the applicant is more likely. The inference is one which is open to the applicant to explain and the applicant has not. The inference is that the applicant wished to associate its trade marks and services with the trade marks of the opponent and to thus adopt the reputation and goodwill contained within the opponent's trade marks and has copied them as nearly as it could. So, the combined effect of all of the similarities leads, inevitably, I consider, to a conclusion that it is appropriate to apply the rule in *Australian Woollen Mills*, above, at paragraph 16. As there has obviously been conscious copying of the specification, and the two opposed trade marks show such marked similarities to two of the opponent's well-known trade marks, copying of the trade marks should also be inferred and the opposed trade marks should be presumed to be likely to deceive or confuse.

33. The opponent has established its grounds under section 44.

### **Decision**

34. Section 55 of the Act provides:

**55.** Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

(a) to refuse to register the trade mark; or

(b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

35. I refuse to register applications 979272 and 979274.

**Costs**

36. The opponent is entitled to its costs in relation to each of the oppositions (which it has approached as two separate matters), and I order costs against the applicant at the official scale.

Iain Thompson  
Hearing Officer  
Trade Marks Hearings  
19 June 2006