



TRADE MARKS ACT 1995

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

Re: Opposition by Ownit Homes Pty Ltd to registration of trade mark application 992888(42) - **OWNIT CONVEYANCING AND DEVICE** - filed in the name of Craig Harrison Lee.

DELEGATE:	Terry Williams
REPRESENTATION:	Opponent: Kellie Stonier, and Joe Ganim, Hopgood Ganim solicitors Applicant: Claude Anese, Cullen & Co, patent attorneys
DECISION:	S 52 opposition: s 58 and 59, marks not substantially identical – s 60 and 42, no significant extent of confusion likely.

Background

1. Trade mark application 992888 was filed on 10 March 2004 by Intpro Pty Ltd and Pacific Aspect Pty Ltd. Craig Harrison Lee is the assignee of those companies and is now recorded as the applicant for registration of the trade mark. The trade mark itself is as follows:



2. The services covered by the application are:

The provision of residential and commercial property conveyancing services and associated legal services, including the provision of these services via a website or by other electronic means; legal services in this class.

3. After examination, the Trade Marks Office has accepted the application for possible registration. However, Ownit Homes Pty Ltd (Homes) has opposed registration. The

opposition has followed the process in part 5 of the regulations under the *Trade Marks Act 1995* (the Act).

Evidence and hearing

4. The evidence relied on by the parties is as follows:

Declaration by Paul Ganim, with exhibits A-R, in support of the opposition.

5. These exhibits bring into evidence some earlier declarations filed and relied on in another and earlier opposition matter. That material came into being when, in 2003, Homes opposed registration of application 918978. That application was filed by Pacific Aspect Pty Ltd and Linda Jameson, to register the mark in question. Homes's material includes an earlier declaration made in 2003 by Paul Ganim. Application 918978 was withdrawn, well after opposition was filed by Homes and indeed just before the opposition was ready for decision. Homes's material in the current matter also includes the evidence in answer relied on by the applicants in the earlier matter.

Declaration by the applicant in answer to the opposition.

6. Mr Lee declares that the first use of this mark in relation to conveyancing services was by two lawyers, Karl Jameson and Robert Hynes. Mr Lee's information appears to be very much second-hand, but his version of events is that this earlier use was licenced by Pacific Aspect Pty Ltd and Linda Jameson, and subsequently by Pacific Aspect Pty Ltd and Intpro Pty Ltd, the latter of whom had, so Mr Lee asserts, acquired Ms Jameson's interest. The last-mentioned companies are the direct predecessors in title to Mr Lee in relation to the present application.
7. Mr Lee disclaims all knowledge of the prosecution of the earlier (now withdrawn) application and the opposition by Homes, of which he was put on notice at least as early as April 2004. He asserts that he was "advised that the withdrawal was unrelated to the grounds of opposition" but is silent on what the true explanation might have been.

Declaration by Paul Ganim in reply to the above.

8. I will come to the details of this in due course.
9. After completion of the evidence process, I was assigned to hear and decide the matter under delegation from the Registrar of Trade Marks. At the hearing, Claude

Anese, patent attorney, of Cullen & Co appeared for the applicant. The opponent was represented by Kellie Stonier, solicitor, of the firm of Hopgood Ganim, solicitors, and by Joe Ganim, a principal of that firm.

Grounds discussed

10. The opponent, Homes, relies on grounds under s 58 (ownership) and s60 (conflicting prior reputation). As a consequence of the latter, Homes also submits that a ground under s 42 (use contrary to law, specifically the various *Fair Trading Acts* of the States, dealing with conduct by individuals that is likely to mislead or deceive). I will deal with the grounds in that order.

Ownership

11. Section 58 is established if the opponent can point to use of the same mark for the same kind of thing at a date that is earlier than both the filing date of the present application and the use by the applicant or a predecessor in title. The proposition that the usage must be for “the same kind of thing” comes originally from Hicks’ case¹ and Homes argues that it is applicable here.
12. Homes relies on the declaration of Paul Ganim to show that Homes trades in housing design and architectural services and the building and sale of residential houses. According to Ms Stonier, the applicant and Homes both provide services in relation to residential property and the sale of houses. *Ipsa facto*, she argues, the services provided must be the same. I note the evidence of Paul Ganim in this. Mr Ganim asserts that “Homes has been using this mark in relation to design, architectural services, construction and sale of residential houses...”.
13. At the hearing, Mr Anese was critical of this, arguing that the opponent is simply a builder of residential homes. Ms Stonier did not dispute (and, on the evidence, could not dispute) that this is where the opponent’s reputation lies.

The applicant, said Mr Anese, provides conveyancing services for all manner of buyers, including those who buy apartments and factory buildings and those who buy vacant land as an investment. Additionally, even those who were buying an established residential property would not necessarily need to deal with a builder at

¹ (1897) 22 VLR 636 at 640

all. I agree with Mr Anese. The test “same kind of thing” is a practical one and, in practice, there is very little to connect the work of a builder and of a conveyancing service. Homes is a licenced builder and while it might, in the course of its trade in building construction, engage an architect, that does not establish a trade in architect services². Likewise, if a builder is to make a profit, it must of necessity sell its product. That does not establish a trade in the service of selling houses, much less in the legal services to which the present application relates.

14. Ms Stonier and Mr Joe Ganim both noted that it was commonplace for builders to have a “cosy relationship” with architects, lawyers etc. I accept that this is probably so, in order that a builder would be able to refer a client to such necessary adjuncts. Consistently, I note that the declaration by Paul Ganim in the evidence in reply sets out brief details of a conversation with a completely unidentified person who allegedly thought it was “clever” of the opponent to have formed Ownit Conveyancing. As to this, I agree with Mr Anese. The recital of this conversation is quite strange for its complete lack of detail. Paul Ganim, the declarant, appears to have been at pains to say nothing about whether he knew the unidentified person or not, or the context of the encounter, in an elevator, that resulted in the conversation. While I accept that Mr Ganim has accurately recounted what he recalls to be the words spoken, the context in which the conversation took place is not at all clear and I cannot give it full weight as an instance of what an ordinary member of the public might infer.
15. While I will deal elsewhere with allegations of confusion between the two businesses, there is nothing in the evidence to make me think that the nature of the services is the same.

Moreover, Ms Stonier argued that the trade marks are substantially identical. The respective trade marks are as follows, for easy comparison:

² See, for example, *Mid Sydney Pty Ltd v Australian Tourism Company Ltd* - 42 IPR 561 at 561 “Nor, we think, does it help to identify a number of discrete aspects of the hotel business which, if carried on in other circumstances, might be characterised as the provision of property management services. In this context, each will take its character from the overall nature of the business which Touraust intends to conduct”



16. As the case law notes, substantial identity is a matter for side by side comparison. Consistently, Mr Anese pointed to the visible differences between the two marks. The words HOMES and CONVEYANCING were significant elements, he said. Mr Anese differed strongly from the view of Ms Stonier, who argued that the difference between “Homes” and “Conveyancing” adds nothing to the overall distinctiveness. However, for my part I would say that, if once it is decided that the marks in question *are* being used for the same kind of thing, an applicant should not be able to seize on descriptive words in his own mark in an attempt to prove that the marks are not in conflict. See, for instance, *PB Foods Ltd v Malanda Dairy Foods Ltd*³ – CHILL vs CHOC CHILL.
17. As to the differing graphic elements, I can appreciate the value of the arguments put up by Ms Stonier. It might be said that the practical impact of the two, even on a side by side comparison, is very close; both trade marks are graphics that use triangles to allude to a simple sketch of a house, of one sort or another. However, it is equally obvious that the opponent is using chevrons and horizontal underlining where the applicant is using a more literal depiction of a house roof, albeit with underlining. While the end result may be, in a vague sense, an allusion to a house, the methods by which the applicant and opponent have done this are quite distinguishable.
18. However, Mr Anese’s written submissions concede that the opponent has also used the plain word mark OWNIT HOMES, a concession that is consistent with exhibit PG-06 to the Ganim declaration of 2003. It might be that the adding of two chevrons and an underlining to the plain word mark OWNIT HOMES would not allow the applicant to escape the net of substantial identity when this is cast for ownership

³ [1999] FCA 1602

purposes with such a starting point. Here, I note that in *Gummow J*⁴ put the matter in terms of:

The phrase "substantially identical" requires a total impression of similarity to emerge from a comparison between the two marks. In a real sense a claim to proprietorship of the one extends to the other.

19. For my own part, I would confess to some doubt about the “realness” of the distinction that Mr Anese would have me draw on the basis of two chevrons and an underlining, were that all there was to the matter. Significantly, however, I have also found that there is a considerable disparity in the services of the applicant and of Homes. This in turn obliges me to give due weight to the different descriptive words “Homes” and “Conveyancing” and to conclude that the marks are not substantially identical.

Deception and confusion

20. Under this heading, the opponent relies on s 60, which I will not set out in full. The threshold question is met, in that the competing marks are deceptively similar, albeit that I have found them not to be substantially identical for purpose of deciding the ownership question.
21. As to the remaining elements, while I accept Mr Anese’s contention that the reputation enjoyed by Homes is limited to the area around Brisbane or, at most, South-East Queensland, I do not think that this greatly assists the applicant. Clearly, within that area Homes is well known and there are a significant number of people who are well familiar with the work of Homes in the building industry since 1972. Clearly, these people will take that knowledge with them into the market for conveyancing services. Is there, then, any reason to apprehend that in that market there will be a significant level of confusion, or of people in general being “caused to wonder”⁵?
22. The lawyers for Homes have noted that the evidence suggests that this may be the case and it is necessary to examine the evidence in some detail. At issue are the

⁴ *Carnival Cruiselines Inc v Sitmar Cruises Ltd* (1994) 120 ALR 495 at 513

⁵I am to be satisfied that there was a sufficient likelihood of either deception or confusion, in terms as reformulated by French J in *Registrar of Trade Marks v Woolworths* (45 IPR 411). “The question ... is not whether consumers might be confused (in the sense of wondering about a common origin or connection) but whether there is a reasonable likelihood that they will be confused.”

Moden, Martins, Norquay, Thompson, Kratzman and Ganim declarations. The first 5 of these are made by staff, consultants, or in one instance the partner of an employee, of Homes.

23. Ms Norquay and Ms Moden have each made both a first and a second declaration, the latter dated 10 December 2003. Mr Anese was critical of the fact that the text of these latter was identical. Indeed, the substantive part of the texts is also common to the Kratzman declaration. In each of these, the declarant sets out her recollection of “between 3 and 4” phone calls, the nature of which is then set out in identical terms. Taken at face value, each declaration suggests that the callers asked the general question “Does Ownit Homes do conveyancing?” Each declarant to the precise response to this seemingly broad question: “I responded ... that Ownit homes is a building company and is not connected with Ownit Conveyancing”. Mr Anese was dismissive of this, saying that such evidence went against the case argued by Homes. Mr Anese sought to portray the callers as people who were aware of the applicant, arguably *not* aware of Homes, and seeking the applicant by reference to an (at the time) yet-to-be-listed phone number.
24. He may well be right. I think the stereotyped nature of these declarations may suggest that I should not take them literally. It strikes me as odd that, for no reason that is apparent from the declarations, staff of Homes should go out of their way to respond to general questions about conveyancing with an explicit disclaimer of any connection with the applicant. Because of this oddness they therefore form a pattern with the earlier declarations: it suggests to me that either the callers were indeed looking for the applicant, and doing so by phoning Homes, or that the staff of Homes anticipated that this would prove to be the case whenever the topic of conveyancing came up. The picture is made clear by the earlier declarations. Ms Norquay gives quite credible detail of one caller, who apparently was quite difficult to convince that there was no such connection. As Mr Anese noted, approximately four of the callers, according to Ms Moden’s first declaration, having apparently asked a general question, went on to seek, specifically, advice about the phone number of the applicant. This is consistent with the Martins declaration, where callers are portrayed as asking “whether Ownit Homes were Ownit Conveyancing”.

25. The evidence establishes that it was only in August 2003 that there was a phone book entry for the applicant. Mr Jameson, a lawyer and apparently an authorised user of the predecessor in title to the present applicant, had by then been in business for some time.
26. As the lawyers for Homes noted, the fact that the pattern of calls to Homes did not abate after August 2003 might be significant. However, as Mr Anese noted at the hearing, the later Norquay and Moden declarations were made in December 2003. They may equally well be consistent with a marked reduction in confusion once the new phone book came into play. Both of those declarants referred to events since their first, April 2003, declaration. Both declarants are silent about when the later calls to which they refer were made, and it is well within the bounds of plausibility that none of the calls they refer to were made after August 2003.
27. To this, Paul Ganim's declaration is the sole reply. He asserts that the confusion continues but gives only a single instance. He uses the form of words "As recently as January 2005", and implies that the instance he sets out is one of many. The instance he gives is of the conversation in an elevator and I have already set out Mr Anese's criticism of this account, under the heading of "Ownership". While I accept that Paul Ganim is of the view that confusion persists, the strange example he chooses to give in his declaration is not in itself convincing.
28. Ms Thompson's declaration is somewhat different. She was caused to wonder about a connection between the two firms when viewing the positions vacant advertisements in a newspaper. Ms Thompson says quite plainly that she assumed that her husband's business "had commenced a conveyancing practice".
29. The remaining instance of arguable confusion is in a wrongly addressed letter, referred to in the Jameson, Ganim and Lee declarations. It appears that a letter was addressed, incorrectly, to:

Karl Jameson
Ownit Conveyancing
GPO Box 56.
Brisbane.
30. It was received, coincidentally, by a firm of lawyers who rent that box at the Brisbane GPO. Those lawyers forwarded it to Homes. The applicant asserts that, since the

correct PO Box for Mr Jameson at the time was PO Box 156, this is not evidence of confusion so much as of a typographical error. Mr Anese argued likewise. However, I cannot agree with this. It is evidence that a firm of lawyers, on receiving mail meant for a firm of conveyancers, were of the view “This must be meant for Homes”, of whom, presumably, they were already aware. That, clearly, is a relevant form of confusion, albeit that the circumstance that allowed it to come to light was a simple typographical error.

31. I do not think that the applicant has entirely explained away the suggestion that the phone calls to Homes, or the letter, or Ms Thompson’s reaction when viewing personnel advertisements, could indicate a pattern of confusion. Nor need it do so. I can well agree that some people, in the lack of a relevant phone book entry for the applicant, might think that some connection existed with Homes given the commonality of the word OWNIT and the arguable or perceived common clientele of builders and of conveyancers. Such people would presumably be inclined to ring Ownit Homes, where they might not “take a punt” on ringing, say, Ownit Pet Minding. Clearly, the lawyers who rent PO Box 56 at the Brisbane GPO, and Ms Thompson with her newspaper, made similar inferences. I do not suggest, overall, that the risk of confusion is non-existent, or that the Homes’s concerns in mounting this opposition have been fanciful.
32. Those, however, are not the relevant test under s 60. I am required to refuse registration if I am satisfied that there would be a significant risk that reasonable people, knowing of the opponent, Homes, would be caused to wonder at a connection with the applicant. Homes has not satisfied me that this is the case. Assertions about confusion are not facts. The actual extent of confusion after August 2003 has simply not been established, and, for all I know, may be confined to Ms Thompson, the mysterious elevator person and a firm of solicitors.
33. Conversely, Homes has brought in evidence about the extent of the use of the trade mark identical to the subject mark, for conveyancing services, at the hands of Mr Jameson and Mr Hynes. I referred to that circumstance under “Background”. At that time, as Mr Anese noted, the business was very successful. There were up to 320 conveyances being conducted each month. It is not at all surprising, therefore, that a mere handful of idle speculations, phone calls etc should have resulted.

34. Finally, there are the first principles of what conveyancers do, vis a vis builders. Aside from the fact that customers may be clients of both at the same time, there is very little overlap. Moreover, the buying or building of a house is not something that people take lightly. The legalities may be complex and I am not at all convinced that, were they to reflect on the matter as is appropriate in such a case, many buyers of land would expect to obtain their legal advice and assistance from a builder, potentially a builder with whom they might be about to contract.
35. The question of deception and confusion is not solely a matter of evidence and is ultimately a matter for my own judgement. As observed by Heerey J in *Nettlefold Advertising Pty Ltd v Nettlefold Signs Pty Ltd*⁶:

The question whether the use of a mark is likely to deceive or cause confusion is in the end a question of impression and common sense; it is a "jury question" in which the judge is entitled to give effect to his or her own opinion as to the likelihood of deception or confusion: *Murray Goulburn Co-op Ltd v New South Wales Dairy Corp*⁷.

36. Accordingly, I do not find that the existence of a low-level possibility of confusion of mind, while doubtless annoying to Homes, would justify a finding that the s 60 ground is established. Therefore, the related test under s 42, that use of the trade mark would be contrary to law, is also not established. The relevant test for such purposes goes to conduct that would be likely to mislead or to deceive, a higher-level test.

Conclusion and costs

37. The trade mark application 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. I direct that Homes pay the costs of the applicant to the extent fixed by the scale in the regulations.



T. E. Williams
29 August 2005

⁶ (1997) 38 IPR 495 at 501

⁷ (1990) 24 FCR 370; at 377; 16 IPR 289; at 296