

12 April 2012

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Doc no 14513312

The Registrar of Trade Marks
IP Australia
PO Box 200
WODEN ACT 2606

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Dear Madam

Wells Manufacturing, L.P.
Australian trade mark application no 1358743
WELLS in classes 7 & 9

We refer to the examiner's first report dated 28 July 2010 wherein the Examiner raised the following objections:

- 1 a descriptiveness objection on the basis that WELLS is a common Australian surname and a geographical indicator;
- 2 three prior citations for WELLS FARGO in the name of Wells Fargo & Company; and
- 3 formalities objections.

The Applicant's submissions are set out below. The 21 month deadline for this application is **28 April 2012**. Accordingly, please consider these submissions on an urgent basis.

1 Distinctiveness

The Examiner has objected to the registration of the WELLS trade mark on the grounds that:

- (a) WELLS is a common Australian surname; and
- (b) WELLS is a geographical indicator, being the name of a city in Somerset in the United Kingdom which has a reputation for electrical instruments. WELLS is also the name of towns in Minnesota and Texas in the United States and that each of these cities has a reputation for manufacturing.

The Applicant submits that WELLS is inherently distinctive of the goods covered by this application and qualifies for registration on a prima facie basis. Alternatively, the Applicant submits that WELLS has acquired distinctiveness through extensive use as a trade mark in Australia prior to the filing date of this application (29 April 2010).

1.2 Supporting Evidence

The Applicant encloses a statutory declaration of Stephen M Hildebrand, the Marketing Director of the Applicant, together with exhibits SMH-1 to SMH-5 (the **Hildebrand Declaration**).

The Hildebrand Declaration details the use, sales and promotion of the WELLS trade mark by the Applicant in Australia and, in particular establishes that:

- (a) The Applicant has been operating as an original manufacturer of WELLS vehicles electronic parts and accessories in the United States of America since 1903 (see Hildebrand Declaration, paragraph 5);
- (b) The Applicant's company was named after its founder, Robert C. Wells. (see Hildebrand Declaration, paragraph 5);
- (c) The Applicant is one of the world's leading suppliers of replacement sensors and other vehicle electronics for virtually all vehicle makes and models, selling 38,000 different parts and accessories in over 300 product categories (see Hildebrand Declaration, paragraphs 6 & 7).
- (d) The WELLS trade mark was first used in relation to the Applicant's WELLS branded electronic parts and accessories in Australia since on or about 9 September 1998 (see Hildebrand Declaration, paragraph 9).
- (e) The Applicant's WELLS branded goods are sold in Australia through a local sales agency, Brandlines Pty Ltd and a network of Australian distributors (see Hildebrand Declaration, paragraph 9).
- (f) The Applicant's WELLS goods are generally purchased by automotive technicians and car enthusiasts with a specialised level of technical knowledge about the specific brands and parts that they purchase (see Hildebrand Declaration, paragraph 10).
- (g) The Applicant has used the WELLS trade mark consistently on all corporate and marketing communications and materials such as brochures, advertising, promotional literature and stationary (see Hildebrand Declaration, paragraph 12 and Exhibit SMH-1).
- (h) Confidential Annexure A to the Hildebrand Declaration sets out the annual wholesale sales figures for the Applicant's WELLS goods sold to distributors in Australia for the years 2004 to 2010 in US dollars.
- (i) The WELLS trade mark has been widely advertised and promoted by the Applicant and its distributors in Australia. This promotion includes:
 - exhibition at trade fairs and exhibitions;
 - via an E-catalogue available at the website www.wellsve.com;
 - on online social networking sites Facebook and YouTube; and
 - in a complimentary quarterly publication created by the Applicant for automotive technicians, sales staff, parts and accessories distributors, called CounterPoint.(see Hildebrand Declaration, paragraphs 13, 15 – 17, Exhibits SMH-3, SMH-4, SMH-5)
- (j) The Applicant has expended considerable time, effort and money in promoting the trade mark WELLS in Australia.

1.3 Geographical objection

The Examiner has raised a geographical objection on the basis that WELLS is the name of:

- a city in Somerset in the United Kingdom;
- a town in Minnesota in the United States; and
- a town in Texas in the United States,

and that each of these cities has a reputation for manufacturing.

The Examiner contends that Wells in Somerset in the United Kingdom has a reputation for electrical instruments. By contrast the Applicant submits that Wells in Somerset is the smallest city in England with a population of approximately 10,000 people and despite its small population size is classified as a city because of its famous 13th century Cathedral. The

cathedral and associated religious and architectural history has made Wells a popular tourist destination. The name Wells was derived from the three wells dedicated to Saint Andrew.

Wells in Texas marks the junction of US Highway 69 and Farm Road 1247 in southern Cherokee County. Whereas, Wells in Minnesota was named after J.W. Wells. As at a census conducted in July 2009:

- the city of Wells in Texas in the United States had a population of 794 people; and
- the city of Wells in Minnesota in the United States had a population of 2,326 people.

The Applicant submits that:

- 1 the Wells city in the UK and Wells towns in the USA do not have a reputation for the goods offered by the Applicant. Further, due to their size alone, the Applicant submits that the towns of Wells in the USA have little (if any) world renown;
- 2 the name WELLS does not have an obvious or potential connection with the goods offered by the Applicant. Due to the small size of each city and town, it is highly unlikely that other traders would seek to use the word WELLS as a trade mark in respect of class 7 and 9 goods offered by the Applicant. Class 7 and 9 goods have no inherent relationship with the cities and towns named Wells; and
- 3 the evidence of the Applicant's use of the WELLS mark in Australia before the filing date of the Application set out in the Hildebrand Declaration, demonstrates that the Applicant's WELLS mark distinguishes the Applicant's goods.

On these bases, the Applicant submits that WELLS is inherently distinctive of vehicle electronic parts and accessories in classes 7 and 9.

1.4 WELLS in inherently distinctive of the class 7 & 9 goods claimed

On the basis of the evidence of use, sales and promotion of the Applicant's WELLS mark in connection with vehicle electronic parts and accessories in Australia since at least as early as 1998, the Applicant submits that the Examiner's descriptiveness objection be withdrawn as WELLS is inherently distinctive for the following reasons:

- by virtue of its use, sales and promotion of WELLS trade mark in Australia, the Applicant created a reputation for its WELLS branded goods in Australia well before the filing date of this application (29 April 2010);
- WELLS does not describe the goods of the Applicant;
- the foreign geographical cities and towns named Wells do not have a reputation for the goods offered by the Applicant; and
- the WELLS trade mark is inherently distinctive and uniquely identifies the Applicants goods.

2 Citation objections

The following prior marks in the name of Wells Fargo & Company were cited against this application:

No	Trade Mark	Goods & Services	Status
335643	WELLS FARGO	Class: 37 Equipment and building maintenance and repair services	Removed – Not renewed
376308	WELLS FARGO	Class: 37 Alarm (burglar or fire) installation and repair	Removed – Not renewed

363719	WELLS FARGO	Class: 9 Electrical and electronic equipment; including communications, monitoring and alarm equipment for central station protective and/or service systems; fire detection and prevention apparatus; parts and accessories in this class for all the foregoing	Registered
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As trade mark registration nos 335643 and 376308 have been removed for non-renewal, we request that these citations be withdrawn.

The Applicant respectfully submits that the objection against remaining citation no 363719 (the **cited mark**) should be removed for the reasons set out below:

- (a) The Applicants mark and the cited mark are not substantially identical nor deceptively similar due to their visual and phonetic differences. While the Applicant's WELLS mark is wholly contained within the cited mark, the addition of the distinctive word "Fargo" in the cited mark is sufficient to prevent confusion amongst members of the public as to trade source. Fargo is, as the Examiner stated, a city in North Dakota. However, in Australia, Fargo is well known for being the name of an acclaimed 1996 comedy movie, the main character of which is a criminal used car salesman. Consequently, the addition of FARGO in the cited mark sufficiently distinguishes the marks. Furthermore, the Applicant's WELLS branded goods are generally purchased by discerning automotive technicians and car enthusiasts with specialist knowledge about the parts and brands that they buy;
- (b) The endorsement in the cited mark specifically exclaims that registration of WELLS FARGO gives the cited owner no right to the exclusive use of the surname WELLS;
- (c) The goods offered under the cited mark relate to '*electrical communications, monitoring and alarm equipment...fire prevention and prevention apparatus*'. Wells Fargo & Company, the owner of the cited mark is a diversified financial services company providing banking, insurance, mortgage and investment services with their headquarters in San Francisco. Consumers purchasing the Applicant's WELLS electronic parts and accessories for vehicles, trucks and marine watercrafts will not be confused or deceived by the distinctly different electrical monitoring and detection and prevention alarm goods offered under the WELLS FARGO mark by a financial services company with a generally global reputation as a bank.
- (d) In the unlikely event that the examiner finds that section 44(1) is made out, the Applicant submits that due to the Applicant's honest concurrent use of the WELLS trade mark or other circumstances, it is proper to accept the WELLS trade mark in light of the cited mark. In support, the Hildebrand Declaration establishes that the Applicant honestly adopted the WELLS trade mark in 1903 naming the business, Wells Manufacturing, after the founder Robert C. Wells. The Applicant has used the WELLS trade mark in respect of vehicles electronics parts and accessories continuously in Australia since at least as early as 1998 and at the time of commencing use in Australia and also at the time of applying for trade mark application no 1358742, the Applicant was not aware of Wells Fargo & Company's cited registration no 363719 for WELLS FARGO in class 9 (see Hildebrand Declaration, paragraphs 5, 8, 19).
- (e) The Applicant has used the WELLS trade mark in Australia in relation to electronic parts and accessories for automobiles, trucks and marine watercrafts since 1998 without objection.
- (f) The Applicant adopted the WELLS trade mark globally in 1908. The Hildebrand Declaration attests to the fact that the deponent is not aware of any instances of confusion arising between the Applicants WELLS mark and Wells Fargo's WELLS FARGO mark and that the companies have amicably co-existed, at least in the United States, for over 100 years (see Hildebrand Declaration, paragraph 19).

3 Resolving classification issues raised

In response to the formalities issues raised, the Applicant requests that the specifications be amended as follows (with amending text in bold and underlined):

Class 7: Goods for automobiles, trucks and marine watercrafts, **namely** ignition system components, fuel system components, fuel injection components and emissions system components.

Class 9: Goods for automobile, trucks and marines watercrafts, **namely** wire products comprise of electrical conductors for connecting electrical components in a vehicle; ignition wire sets, wire, cable and wiring accessories; automotive and other vehicular sensors; battery accessories for connecting the battery electrical equipment and supporting a battery in place; ~~starting and charging system components~~, **starting system components including starters, voltage rectifiers, diodes, electric starting cables, electrical wires, voltage regulators, voltage stabilizers;** and electrical switches

4 WELLS is inherently distinctive

We submit that:

- (a) Through extensive use, the Applicant's WELLS trade mark is inherently capable of distinguishing the goods claimed in the application;
- (b) Australian trade mark registration no. 335643 and no. 376308 have expired and no longer block the Applicant's trade mark application;
- (c) The WELLS trade mark is not substantially identical with or deceptively similar to the remaining cited mark, registration no. 363719 for WELLS FARGO in class 9 and in any event the Applicant has honestly adopted and used the WELLS trade mark in Australia prior to the date of filing (being 29 April 2010) without any instances of confusion or deception; and
- (d) Once amended, the goods listed in class 7 and 9 are appropriately listed.

Favourable reconsideration and acceptance is respectfully requested.

Yours faithfully
Freehills



Celia Davies
Partner

Commonwealth of Australia
STATUTORY DECLARATION
Statutory Declarations Act 1959

In the matter of Australian Trade Mark application no. 1358743 for WELLS in the name of Wells Manufacturing, L.P. **(the Application)**

I, Stephen M Hildebrand of 309 Pheasant Court, Fond du Lac, Wisconsin, USA, make the following declaration under the *Statutory Declarations Act 1959*:

- 1 I am the Director of Marketing of Wells Manufacturing, L.P. (**Wells**). I have worked for Wells for 6 years and I have held the position of Director of Marketing for one year.
- 2 I am authorised to make this declaration on behalf of Wells. I make this declaration from my own knowledge and belief, except where indicated to the contrary. Where I have obtained information from others, I believe such information to be true and correct.
- 3 I make this declaration in support of the Application.

Confidentiality

- 4 The information contained in the annexures marked "CONFIDENTIAL" is commercially sensitive and confidential to the Applicant and concerns its business, commercial or financial affairs. Disclosure may cause significant harm to the Applicant. Accordingly, the annexures should be maintained as confidential and are provided on the basis that they are not disclosed to any other parties other than with the express written consent of the Applicant and subject to appropriate undertakings as to confidentiality. The Applicant regards information in the annexures as exempt from release in respect of any application under *the Freedom of Information Act* due to Section 43 of that Act.

Wells Manufacturing, L.P.

- 5 Wells Manufacturing was founded in 1903 in the USA and was named after its founder, Robert C. Wells. Wells Manufacturing is an original equipment manufacturer of WELLS vehicle electronics parts and accessories which are sold and marketed by the WELLS trade mark globally.
- 6 Wells Manufacturing is one of the world's leading suppliers of replacement sensors and other vehicle electronics for virtually all vehicle makes and models.
- 7 Wells Manufacturing sells 38,000 different parts and accessories in over 300 product categories with prices ranging from a fraction of a cent to hundreds of dollars per item.

Sales and promotion of WELLS goods have resulted in distinctiveness

- 8 The WELLS trade mark was first used in relation to the Applicant's vehicle electronics goods in Australia on or about 9 September 1998.

- 9 The Applicant's WELLS vehicle electronics parts and accessories are sold in Australia through a local sales agency and distributor, Brandlines Pty Ltd, Mount Kuring-gai, NSW. Brandlines has been a distributor of WELLS products in Australia since April 2007. Other current and prior distributors of WELLS vehicle parts and accessories in Australia include Motospecs of 2C Glendenning Road, Glendenning NSW 2761, Australia; Tridon Australia Pty Ltd of 15-27 Derby Street, Silverwater, Australia; Eagle Performance Wholesale of 92 South Gippsland HWY, Dandenong, Victoria, Australia 3175; Annick Trading Pty Ltd, 20 Wentworth Street, Granville, Australia.
- 10 The Applicant's WELLS goods are usually bought from these distributors by automotive technicians and car enthusiasts. In my opinion, these customers generally have a high level of technical knowledge and are specific about the parts and brands that they buy.
- 11 **Confidential Annexure A** sets out the wholesale sales value of WELLS vehicle electronics parts and accessories sold in Australia during the period 2004 to 2010.
- 12 The WELLS trade mark is used on packaging, brochures, invoices, sales literature and stationary. Now produced and shown to me and marked **Exhibit SMH-1** are examples of this use.
- 13 The Applicant's vehicle electronics parts and accessories which are branded with the WELLS trade mark are promoted at trade fairs and exhibitions, in catalogues and online. Now produced and shown to me and marked **Exhibit SMH-2** are examples of this promotion.
- 14 **Confidential Annexure B** shows Well's approximate annual global promotional expenditure for WELLS goods.
- 15 Wells promotes its WELLS vehicle electronics parts and accessories via the website www.wellsve.com. This website features an E-Catalogue through which potential customers can search for the year, make and model of a car to determine which WELLS replacement parts and accessories are available for that specific vehicle. This website also features How-To videos and tutorials for fitting WELLS parts and accessories into cars. Extracts from website www.wellsve.com are set out in **Exhibit SMH-3**.
- 16 WELLS goods are also promoted via social media sites such as Facebook and Youtube. Extracts from Well's Facebook and Youtube sites are set out in **Exhibit SMH-4**.
- 17 Since 1997 Wells has published (in print and online) CounterPoint, a complimentary quarterly publication created as a technical resource for automotive technicians, sales staff, parts and accessories distributors. The CounterPoint publication discusses a variety of subjects commonly encountered in repair shops and parts stores on a daily basis and specifically promotes WELLS vehicle electronics parts and accessories. A selection of issues of CounterPoint from 1997 until present are set out in **Exhibit SMH-5**.

This Application

- 18 Since 1998, the Applicant has built up a reputation in relation to its WELLS vehicle electronics parts and accessories in Australia, such that the WELLS trade mark has become exclusively associated with the goods covered by this application.
- 19 At the time of commencing use of the WELLS trade mark in Australia in 1998 and applying for trade mark application no 1358743 for WELLS in classes 7 and 9, the Applicant was not aware of Wells Fargo & Company's cited registration no 363719 for WELLS FARGO in class 9. The Applicant's WELLS mark was adopted globally in 1908. I am not aware of any instances of confusion arising between Wells Fargo & Company's WELLS FARGO mark and the Applicant's WELLS mark. The companies have amicably co-existed, at least in the United States, for over 100 years.
- 20 I am not aware of any other trader or original equipment manufacturer using WELLS, or a similar name, in relation to the vehicle electronics parts and accessories specified in this Application.
- 21 I believe that further use of the WELLS trade mark in Australia will simply enhance the reputation that the WELLS trade mark already enjoys in relation to vehicle electronics parts and accessories in Australia.
- 22 I understand that a person who intentionally makes a false statement in a statutory declaration is guilty of an offence under section 11 of the *Statutory Declarations Act 1959*, and I believe that the statements in this declaration are true in every particular.

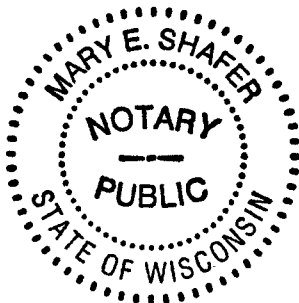
Declared at Fond du Lac in the State of Wisconsin, USA, on April 5, 2012 before me:

Mary E. Shafer
Signature of person before whom the declaration is made

Stephen M Hildebrand
Signature of person making the declaration

Notary
Title of person before whom the declaration is made

Stephen M Hildebrand
Full name of declarant



Freehills

TEA(1)
TSD

27 April 2012

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Doc no 14658895

The Registrar of Trade Marks
IP Australia
PO Box 200
WODEN ACT 2606

Dear Madam



Wells Manufacturing, L.P.
Australian trade mark application no 1358743
WELLS in classes 7, 9

Wells Manufacturing, L.P of 26 South Brook Street, Fond du Lac, Wisconsin 54935, United States of America requests an extension of time of 1 month from 28 April 2012 to 28 May 2012 under s 224 of the *Trade Marks Act 1995* (Cth) to place this trade mark application in order because of special circumstances outlined in the supporting statutory declaration.

We enclose:

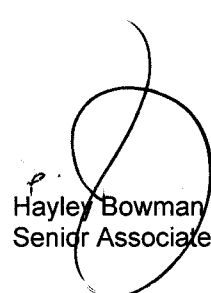
- 1 a supporting statutory declaration made by Celia Davies on 27 April 2012; and
- 2 official fees of \$100.

We look forward to receiving notice that the extension of time has been granted.

Yours faithfully
Freehills Patent & Trade Mark Attorneys



Celia Davies
Partner



Hayley Bowman
Senior Associate

Enc

Commonwealth of Australia
STATUTORY DECLARATION
Statutory Declarations Act 1959

In the matter of Australian
Trade Mark Application
No. 1358743 for WELLS in
classes 7 & 9 in the name of
Wells Manufacturing, L.P.

I, Ike Papageorge, of Level 43, 101 Collins Street, Melbourne VIC 3000, legal practitioner, make the following declaration under the *Statutory Declarations Act 1959*:


- 1 I am a legal practitioner with Freehills of Level 43, 101 Collins Street, Melbourne VIC 3000, Australia (**my firm**).
- 2 My firm represents Wells Manufacturing, L.P. (**the Applicant**), of 26 South Brooke Street, Fond du Lac, Wisconsin 54935, United States of America, and is the address for service in relation to an application for registration of the mark WELLS (**the trade mark**) which was filed on 29 April 2010. I am responsible for the care and conduct of this matter on behalf of the Applicant.
- 3 I make this Statutory Declaration from my own knowledge, except where the context indicates to the contrary. Where the context indicates to the contrary, I make this Statutory Declaration from information which I believe to be true.
- 4 I make this declaration in support of an application under s 224 of the *Trade Marks Act 1995* (Cth) for a one month extension of time of the acceptance date for this trade mark application.
- 5 The examiner raised objections to the application on the basis of section 41, section 44 and formalities objections.
- 6 The Applicant has been gathering evidence to respond to the examination objections raised. This has entailed collaboration between the Applicant in Wisconsin in the United States of America, the Applicant's Attorney in the United States of America, the Applicant's Australian distributors and my firm.
- 7 The original executed and notarised declaration of Stephen M Hildebrand, the Marketing Director of the Applicant, was lodged with IP Australia, together with submissions in response to the examination report on 12 April 2012.
- 8 The Applicant therefore requests a further one month extension of the acceptance deadline to allow the Examiner sufficient time to consider the submissions and evidence lodged.
- 9 In these special circumstances, I submit that the one month extension of time sought is reasonable and justified.

I understand that a person who intentionally makes a false statement in a statutory declaration is guilty of an offence under section 11 of the *Statutory Declarations Act 1959*, and I believe that the statements in this declaration are true in every particular.

Declared by
Ike Papageorge
at Melbourne in the State of Victoria
on 27 April 2012


Ike Papageorge

Before me:


Legal Practitioner

LOUISA JANE VICKERS
Frachilis
101 Collins Street Melbourne
An Australian Legal Practitioner within the
meaning of the Legal Profession Act 2004.