

Batch - 8072513

CLAYTON UTZ

TXR

Registered post

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

**NOTE - EVIDENCE FORWARDED
TO EXAM SERVICES**

1 April 2015

Dear Registrar

**Australian trade mark application no. 1523118 for WE'RE THERE FOR YOU
in classes 16, 25, 35, 36, 37, 39, 41, 42, 43
in the name of Royal Automotive Club of Victoria (RACV) Limited**

We refer to the first examiner's report (**Report**) dated 19 February 2013.

On 13 February 2015, we sent to IP Australia by courier:

1. a letter dated 13 February 2015;
2. the statutory declaration of Carolyn Sandiford made on 16 July 2014 and Exhibit CS-1 to Confidential Exhibit CS-76 thereto (which, as you will note, contains several items of confidential information); and
3. a letter of consent from The Royal Automobile Club of WA (Inc),

collectively **Materials**.

After speaking with Margaret Christian of IP Australia, we understand that IP Australia received the Materials but has subsequently been unable to locate them.

In order to allow the examiner to consider our response to the Report, we enclose copies of the Materials, the originals of which were sent to IP Australia on 13 February 2015 as set out above.

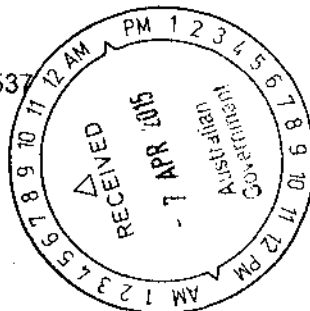
We look forward to receiving notification of acceptance or a further examiner's report in due course. If you have any queries, please do not hesitate to contact us.

Yours sincerely

Mark Krenzer, Special Counsel
+61 3 9286 6385
mkrenzer@claytonutz.com

Enc

Our ref 214/385/80138537



Registered Post

13 February 2015

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

Dear Registrar

**Australian trade mark application no.1523118 for WE'RE THERE FOR YOU
in classes 16, 25, 35, 36, 37, 39, 41, 42, 43
in the name of Royal Automotive Club of Victoria (RACV) Limited**

We refer to the first examiner's report (**Report**) dated 19 February 2013.

We enclose:

1. the statutory declaration of Carolyn Sandiford made on 16 July 2014 and Exhibit CS-1 to Confidential Exhibit CS-76 thereto (which, as you will note, contains several items of confidential information); and
2. a letter of consent from The Royal Automobile Club of WA (Inc).

Distinctiveness objection

The statutory declaration of Ms Sandiford outlines the extensive use that has been made of the WE'RE THERE FOR YOU trade mark by the applicant in Australia since May 2003 for a wide range of services.

1. The applicant has used the WE'RE THERE FOR YOU trade mark in Australia continuously since 2003 for a diverse range of goods and services, including:
 - (a) insurance services, including home, building, personal effects, car, motorbike, boat, caravan, travel, landlord, renters, commercial and business insurance;
 - (b) financial advice, vehicle finance and loan services;
 - (c) emergency home assist services;
 - (d) home security services;
 - (e) emergency roadside assistance services for cars, bicycles, wheelchairs and scooters;
 - (f) holiday resorts and facilities available at those resorts including accommodation, dining, use of function space, golf and other sporting activities;
 - (g) tourism and travel services including travel insurance, car hire, attraction tickets, tours and cruises;
 - (h) member benefits;
 - (i) vehicle inspection and drive school services; and

- (j) vehicle fleet care services.
2. The applicant has used the WE'RE THERE FOR YOU trade mark in Australia continuously since 2003 in a broad range of both printed and electronic media to advertise and promote the relevant services, including:
- (a) television advertisements;
 - (b) advertisements published in newspapers, magazines and directories;
 - (c) brochures and other publications produced and distributed to the public;
 - (d) advertisements displayed in trams and in Adshells at bus stops;
 - (e) point of sale advertising materials, counter mats, A5 tent cards and posters in its retail stores;
 - (f) envelopes, letters, vehicle stickers and magnets;
 - (g) large outdoor banners and billboards;
 - (h) signage and brochures displayed at boat and caravan exhibitions; and
 - (i) the applicant's website (where the trade mark is prominently displayed at the top of the pages).
3. The applicant's website has had over [REDACTED] views.
4. The applicant has spent more than [REDACTED] on advertising media and promoting its services in Australia under the WE'RE THERE FOR YOU trade mark.
5. The applicant has generated substantial revenue as a result of sales of its services in Australia under and by reference to the WE'RE THERE FOR YOU trade mark (as set out in Confidential Exhibit CS-75).
6. A research study showed that 27% of people tested knew without being prompted that the applicant is connected to the WE'RE THERE FOR YOU trade mark.
7. The applicant will continue to extensively advertise and promote its services in Australia under the WE'RE THERE FOR YOU trade mark and expects to substantially increase the revenue generated from its activities over the forthcoming years (as set out in Confidential Exhibit CS-76).

We submit that, as a result of:

- the applicant's extensive use of the trade mark for over 10 years;
- the applicant's extensive advertising and promotion of its services under the trade mark for over 10 years; and
- the applicant's proposed future use of the trade mark,

the WE'RE THERE FOR YOU trade mark is (or at least will become) distinctive in fact of the applicant's claimed goods and services. Accordingly, we submit that the objection under section 41 of the *Trade Marks Act 1995 Cth* should be withdrawn.

Cited registrations

The Report identified five existing trade mark registrations that the examiner considers closely resemble the WE'RE THERE FOR YOU mark. The registrations are all in the name of The Royal Automobile Club of WA (Inc).

The enclosed letter of consent from The Royal Automobile Club of WA (Inc) consents to the use and registration of the WE'RE THERE FOR YOU mark by the applicant on the condition that that the registration includes the following endorsement:

"The rights given by registration of this mark extend only to all Australian States and Territories except Western Australia".

The applicant requests that an endorsement in those terms be recorded in relation to this application. We submit that the citation of the five prior registrations should then be withdrawn, on the basis that the letter of consent constitutes "other circumstances" making it appropriate to accept the application (in accordance with section 44(3)(b) of the *Trade Marks Act 1995* (Cth)).

Classification issues

1. Goods or services in class 36

The Report sought further information on the following services claimed in class 36:

- (a) *Superannuation bonds*
- (b) *Rollover funds including rollover bonds.*

To address this issue, the applicant requests that the class 36 specification of services be amended to read as follows (to make it clear that the relevant services are types of financial services):

Insurance services including home, building, personal effects, car, boat, caravan, compulsory third party, travel, life and personal accident insurance, insurance bonds and annuities; insurance information; insurance brokerage and consultancy; financial services including financial planning, secured and unsecured personal loans, commercial loan finance and debentures, superannuation bonds, rollover funds including rollover bonds.

2. Goods or services in class 37

The Report concluded that some of the services claimed in class 37 are incorrectly classified, namely:

Information relating to traffic, including such services provided over a global computer network (including the Internet).

The applicant agrees to transfer those services to class 39 (in respect of which other services have already been claimed in the application).

The amended class 37 specification of services will then read:

Motor vehicle maintenance and repair; repair information; emergency breakdown assistance for land vehicles, including motor vehicles, bicycles, wheelchairs, scooters and other mobility aids; repair, maintenance, fuel consumption and performance information relating to and

information about specifications, safety and features of motor vehicles, including such services provided over a global computer network (including the Internet).

The amended class 39 specification of services will then read:

Car rental; car parking; courier services; escorting and transporting travellers; message delivery; transportation of passengers, luggage and freight; vehicle towing; travel arrangement; travel agency services; travel and tourism advice, information and reservations, including such services provided over a global computer network (including the Internet); arranging and operating tours and tour guide services; transport and travel information; information relating to traffic, including such services provided over a global computer network (including the Internet).

* * * * *

We submit that, once the objections under sections 41 and 44 have been withdrawn and the classification issues have been appropriately addressed, this application is in order for acceptance. We therefore look forward to receiving notification of acceptance of the application in due course.

Thank you for your assistance. If you have any queries, please do not hesitate to contact us.

Yours sincerely

Mark Krenzer, Special Counsel
+61 3 9286 6385
mkrenzer@claytonutz.com

Our ref 214/385/80138537

27 January 2015



For the better

The Registrar of Trade Marks
IP Australia
Trade Marks Office
Discovery House
PHILLIP ACT 2606

Dear Registrar

Australian trade mark application no. 1523118 for WE'RE THERE FOR YOU in classes 16, 25, 35, 36, 37, 39, 41, 42 and 43 in the name of Royal Automobile Club of Victoria (RACV) Limited

Our organisation is the registered owner of trade mark registrations:

1. no. 780601 for RACWA WE'RE THERE FOR YOU and logo;
2. no. 780602 for RACWA FINANCE WE'RE THERE FOR YOU and logo;
3. no. 780747 for RACWA INSURANCE WE'RE THERE FOR YOU and logo;
4. no. 780748 for RACWA TRAVEL WE'RE THERE FOR YOU and logo; and
5. no. 948853 for RACWA INSURANCE ADVANTAGE SERVICE WE'RE THERE FOR YOU and logo.

Our organisation consents to the use and registration, in all Australian States and Territories except Western Australia, of the WE'RE THERE FOR YOU trade mark by Royal Automobile Club of Victoria (RACV) Limited for the following goods and services:

Class 16: Paper, stationery, books, newspapers, journals, periodicals, directories, maps, charts, pamphlets, badges included in this class; advertising matter and all other printed matter

Class 25: Clothing, footwear and headgear, including golf related leisure apparel

Class 35: Retailing of replacement and spare parts (including batteries and auto glass) for land vehicles, including motor vehicles, bicycles, wheelchairs, scooters and other mobility aids; auditing, examining, reviewing and assessing the working, performance and activities of motor vehicle wholesalers and retailers; providing reviews of motor vehicle wholesalers and retailers; conducting of business appraisals

Class 36: Insurance services including home, building, personal effects, car, boat, caravan, compulsory third party, travel, life and personal accident insurance, insurance bonds and annuities; insurance information; insurance brokerage and consultancy; financial services including financial planning, secured and unsecured personal loans, commercial loan finance and debentures; superannuation bonds; rollover funds including rollover bonds

Class 37: Motor vehicle maintenance and repair; repair information; emergency breakdown assistance for land vehicles, including motor vehicles, bicycles, wheelchairs, scooters and other mobility aids; repair, maintenance, fuel consumption and performance information relating to and information about specifications, safety and features of motor vehicles, including such services provided over a global

computer network (including the Internet); information relating to traffic, including such services provided over a global computer network (including the Internet)

Class 39: Car rental; car parking; courier services; escorting and transporting travellers; message delivery; transportation of passengers, luggage and freight; vehicle towing; travel arrangement; travel agency services; travel and tourism advice, information and reservations, including such services provided over a global computer network (including the Internet); arranging and operating tours and tour guide services; transport and travel information

Class 41: Educational, training and instructional services, including such services provided over a global computer network (including the Internet); arranging and conducting of seminars, workshops and conferences; advisory services relating to education, training and instruction; correspondence courses; organisation of exhibitions for entertainment and educational purposes; publication of printed matter; publication of electronic books and other electronic publications; educational examination services; provision of educational and instructional information via a website; providing sporting facilities, including facilities for playing golf, golf tuition, golf tournaments and golf events including corporate golf events; golf course management; club services; entertainment and cultural services, events, activities and facilities; organising, conducting, providing and providing information in relation to entertainment and cultural events and activities; providing entertainment facilities and services, including gaming; driving schools and driving instruction for drivers of motor cars and other land vehicles; driver training, education and instruction in road safety, including driver, passenger, pedestrian and bicycle safety

Class 42: Vehicle inspections and assessments

Class 43: Providing food and drink; providing services and facilities for providing food and drink, including restaurant services, bistro services, bar services, kiosk services, catering; providing services and facilities for providing food and drink for weddings, receptions, conferences, corporate and social functions and events; providing of temporary accommodation".

This consent is conditional upon the WE'RE THERE FOR YOU registration including the following endorsement: "The rights given by registration of this mark extend only to all Australian States and Territories except Western Australia".

Signed for and on behalf of The Royal Automobile Club of WA (Inc.)

Date:

30/1/15

Signature

TERRY AGNEW

Name and Position

COMMONWEALTH OF AUSTRALIA

Trade Marks Act 1995

IN THE MATTER of Australian trade mark application no. 1523118
(Application) in the name of **ROYAL AUTOMOBILE CLUB OF VICTORIA LIMITED (RACV) Limited (Applicant)**

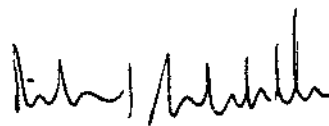
and

IN THE MATTER of an objection under section 41 of the *Trade Marks Act 1995 (Cth)*

STATUTORY DECLARATION

I, CAROLYN SANDIFORD, of 10 Young Street, Brighton 3186, General Manager, Marketing, SOLEMNLY AND SINCERELY DECLARE as follows:

1. I am the General Manager, Marketing for the RACV Group and an employee of the Applicant. I have been employed by the Applicant in my current role since 2004. In that role I am and have since I started in that role been ultimately responsible for managing and coordinating the marketing by the Applicant of the goods and services available under its brands, including WE'RE THERE FOR YOU.
2. I am authorised to make this statutory declaration on behalf of the Applicant. In my current role I have access to the books and records of the Applicant.
3. Except where I state to the contrary or the context indicates to the contrary, I make this statutory declaration based on my own knowledge or from reviewing the books and records of the Applicant to which I have access. To the extent that I state that, or the context indicates that, I do not make this statutory declaration from my own knowledge or from reviewing the books and records of the Applicant, I make it from information that has been provided to me by the named persons who I believe to have given true and reliable information to me.
4. Where I refer to an Exhibit in this statutory declaration, each Exhibit has been produced and shown to me before execution of this statutory declaration and marked with an alphanumeric indicator comprising my initials and a number that increases in sequence for each exhibit, for example "Exhibit CS-1", "Exhibit CS-2" and so on.



Background of Applicant

5. Since its initial formation in 1903, the Applicant has run a multi-faceted, member focused organisation offering a diverse range of goods and services. The Applicant currently has over 2 million members and is (and has for many years been) one of the largest member organisations in Australia.
6. The Applicant has for many years operated (directly or through agents) a network of shops throughout Victoria where its Services are promoted and sold. The Applicant currently has a network of 21 shops in Victoria, and I believe that this number has been fairly constant since about 2003.
7. Services that have been offered by the Applicant in Australia for many years (collectively the **Services**) include:
 - (a) insurance services, including home, building, personal effects, car, boat, caravan and travel insurance;
 - (b) roadside assistance and repair services for vehicles including cars, motorcycles, bicycles, wheelchairs and scooters;
 - (c) arranging the provision by others of car rental and courier services;
 - (d) conducting vehicle inspections and assessments;
 - (e) providing information services and advice on vehicle fuel consumption and information about motor vehicle specifications, safety and other features;
 - (f) providing vehicle towing and transportation services;
 - (g) providing travel arrangement and agency services and tourism advice and arranging and operating tours;
 - (h) providing educational, training and instructional services, arranging and conducting seminars, workshops and conferences;
 - (i) organisation of exhibitions for entertainment and educational purposes;
 - (j) publication of books, brochures and other printed materials;
 - (k) providing sporting and leisure facilities including golfing facilities;

- (l) providing food and drink and services and facilities for providing food and drink including restaurant, bistro and bar services including such services for corporate events, weddings, conferences and other social functions and events;
- (m) accommodation services;
- (n) clothing, footwear and headgear;
- (o) retailing of replacement and spare parts for vehicles; and
- (p) reviewing and assessing the performance of vehicle wholesalers.

Use of the WE'RE THERE FOR YOU mark in relation to the Services

8. The WE'RE THERE FOR YOU mark is used by the Applicant throughout Australia (but mainly Victoria) in respect of the Services. In this statutory declaration I detail the ways in which the Applicant has and continues to use the WE'RE THERE FOR YOU mark.

Use of WE'RE THERE FOR YOU in connection with insurance services

9. The WE'RE THERE FOR YOU mark has been and continues to be used by the Applicant in connection with insurance services, including home, building, personal effects, car, boat, caravan and travel insurance. These services have been promoted as set out below.

Television Advertisements

10. Since 2006, the Applicant has continuously used the WE'RE THERE FOR YOU mark in television advertisements promoting insurance products offered by or under licence from the Applicant. Now produced and shown to me marked "Exhibit CS-1" is a CD containing three television advertisements, each promoting the insurance services offered under licence from the Applicant. At the end of each advertisement, the WE'RE THERE FOR YOU mark is displayed at the bottom right hand corner of the screen. These television advertisements were extensively broadcast on free to air television in Australia in 2013 and in 2014.
11. Now produced and shown to me marked "Exhibit CS-2" is a CD containing another television advertisement promoting the insurance services offered under licence from the Applicant. At the end of that advertisement the WE'RE THERE FOR YOU mark is displayed in the centre of the lower third of the screen. This television advertisement was extensively broadcast on free to air television in Australia in 2006. The Applicant has also since 2006 used the mark in other television advertisements broadcast in Australia to promote the insurance products offered under licence from it.

12. The Applicant intends to continue to promote insurance services through television advertisements that conclude with the display of the WE'RE THERE FOR YOU mark.

Print Media

13. From 2006 onwards, the Applicant has continuously promoted its landlord insurance services in connection with the WE'RE THERE FOR YOU mark in printed materials, including by distributing brochures bearing the mark and causing advertisements bearing the mark to be published in newspapers and magazines in Australia.
14. Now produced and shown to me:
- (a) marked "Exhibit CS-3" is a collection of advertisements bearing the WE'RE THERE FOR YOU mark which were published in newspapers and magazines circulating between November 2006 and March 2012; and
 - (b) marked "Exhibit CS-4" are two covers of Landlord Insurance Product Disclosure Statement and Policy Booklets bearing the WE'RE THERE FOR YOU mark, which were produced and distributed to the public in Australia between November 2006 and November 2012.
15. From 2009 until the date of this declaration, the Applicant has continuously promoted its renters insurance services under and by reference to the WE'RE THERE FOR YOU mark in print media, including advertisements published in Australian newspapers and displayed inside trams.
16. Now produced and shown to me:
- (a) marked "Exhibit CS-5" are examples of advertisements bearing the WE'RE THERE FOR YOU mark which were published in newspapers and magazines in October 2009;
 - (b) marked "Exhibit CS-6" are examples of advertisements bearing the WE'RE THERE FOR YOU mark displayed inside trams in February 2009; and
 - (c) marked "Exhibit CS-7" is an example of an advertisement which was published in March 2009 in the printed publication distributed by real estate agents to prospective purchasers and tenants, including at open for inspections at properties.
17. From 2004 until the date of this declaration, the Applicant has continuously promoted its home insurance services under and by reference to the WE'RE THERE FOR YOU mark in printed materials distributed in Australia, including brochures, advertisements in newspapers and

magazines and outdoor billboards.

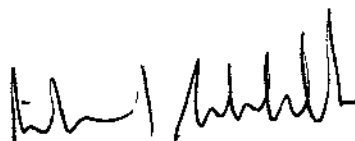
18. Now produced and shown to me:

- (a) marked "Exhibit CS-8" are examples of advertisements bearing the WE'RE THERE FOR YOU mark which were published in newspapers, magazines and directories circulating in Australia between March 2004 and September 2011;
- (b) marked "Exhibit CS-9" are examples of brochures and point of sale advertising materials bearing the WE'RE THERE FOR YOU mark which were distributed to the public through RACV stores during the period between August 2005 and May 2013;
- (c) marked "Exhibit CS-10" is a copy of an example of an image bearing the WE'RE THERE FOR YOU mark that was incorporated on counter-mats that were used at RACV stores;
- (d) marked "Exhibit CS-11" are examples of an image bearing the WE'RE THERE FOR YOU mark that was displayed on large outdoor banners in 2008;
- (e) marked "Exhibit CS-12" are copies of Product Disclosure Statements for home insurance products which bear the WE'RE THERE FOR YOU mark and have been distributed to the public between 2007 and 2013;
- (f) marked "Exhibit CS-13" are examples of home insurance calculation guides bearing the WE'RE THERE FOR YOU mark which were distributed to the public in Australia between November 2006 and November 2011; and
- (g) marked "Exhibit CS-14" are examples of advertisements bearing the WE'RE THERE FOR YOU mark which were printed in newspapers and magazines in Australia, providing information for people affected by events such as fires and storms.

19. The Applicant has continuously promoted its motor insurance services in connection with the WE'RE THERE FOR YOU mark in print media including advertisements in newspapers and magazines, brochures and banners and large outdoor advertisements.

20. Now produced and shown to me:

- (a) marked "Exhibit CS-15" are examples of advertisements published in newspapers, magazines and directories between September 2003 and April 2013;



- (b) marked "Exhibit CS-16" are examples of advertisements displayed in Adshells located at bus stops in March 2008;
- (c) marked "Exhibit CS-17" are examples of brochures and point of sale advertising materials displayed and offered to the public in RACV stores dated between June 2005 and April 2011;
- (d) marked "Exhibit CS-18" are examples of advertisements displayed on posters between June 2005 and May 2013;
- (e) marked "Exhibit CS-19" are examples of the print that was displayed on large outdoor banners between November 2004 and April 2009;
- (f) marked "Exhibit CS-20" are examples of envelopes and letters displaying the mark;
- (g) marked "Exhibit CS-21" is a copy of an example of a print that was displayed on counter-mats at RACV stores;
- (h) marked "Exhibit CS-22" are examples of Product Disclosure Statements for motor insurance services supplied to the public between 2008 and 2010;
- (i) marked "Exhibit CS-23" are examples of advertisements referring to specific areas; and
- (j) marked "Exhibit CS-24" is a collection of advertisements promoting motor insurance for vintage and classic cars published in newspapers and magazines between December 2004 and September 2011.

21. From 2009 onwards, the Applicant has continuously promoted its motorbike insurance services in connection with the WE'RE THERE FOR YOU mark in print media including brochures and advertisements in newspapers and magazines.

22. Now produced and shown to me marked "Exhibit CS-25" are examples of advertisements published in newspapers and magazines.

23. The Applicant has continuously promoted its caravan insurance services in connection with the WE'RE THERE FOR YOU mark in print media including brochures and advertisements in newspapers and magazines.

24. Now produced and shown to me:

- (a) marked "Exhibit CS-26" are examples of advertisements published in newspapers, magazines and street directories between 2003 and 2013; and

(b) marked "Exhibit CS-27" are examples of brochures provided to the public between 2008 and 2013.

25. The Applicant has continuously promoted its boat insurance services in connection with the WE'RE THERE FOR YOU mark in print media including brochures and advertisements in newspapers and magazines.

26. Now produced and shown to me:

(a) marked "Exhibit CS-28" are examples of brochures provided to the public in RACV stores; and

(b) marked "Exhibit CS-29" are examples of advertisements published in newspapers, magazines and street directories from 2004 to 2013.

27. The Applicant has continuously promoted its commercial and business insurance in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines.

28. Now produced and shown to me:

(a) marked "Exhibit CS-30" are examples of advertisements published in newspapers and magazines between September 2004 and September 2013;

(b) marked "Exhibit CS-31" are examples of banners displayed outdoors between January 2005 and June 2013;

(c) marked "Exhibit CS-32" are examples of advertisements published in street directories in April 2013; and

(d) marked "Exhibit CS-33" are examples of advertisements displayed on point of sale advertising materials, brochures provided to the public in RACV stores and posters in store between December 2007 and May 2012.

Use of WE'RE THERE FOR YOU in connection with financial services

29. The Applicant has continuously promoted its financial advice services, vehicle finance services and loan services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines.

30. Now produced and shown to me:

- (a) marked "Exhibit CS-34" are advertisements published in newspapers and magazines;
- (b) marked "Exhibit CS-35" are brochures provided to the public;
- (c) marked "Exhibit CS-36" are examples of advertisements displayed on posters in store between December 2004 and January 2006; and
- (d) marked "Exhibit CS-37" are examples of financial services guides dated between 2009 and 2013.

Use of WE'RE THERE FOR YOU in connection with home repair services

31. The Applicant has continuously promoted its emergency home assist services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines.

32. Now produced and shown to me:

- (a) marked "Exhibit CS-38" are examples of advertisements published in newspapers and magazines between 2009 and 2013;
- (b) marked "Exhibit CS-39" are examples of advertisements displayed on point of sale advertising materials and posters in store between April 2009 and January 2012;
- (c) marked "Exhibit CS-40" are examples of advertisements displayed on A5 tent cards in store in August 2010;
- (d) marked "Exhibit CS-41" are examples of brochures provided to the public between September 2009 to July 2013;
- (e) marked "Exhibit CS-42" is a brochure with a magnet; and
- (f) marked "Exhibit CS-43" are brochures containing the terms and conditions between 2009 and 2012.

Use of WE'RE THERE FOR YOU in connection with security services

33. The Applicant has continuously promoted its home security services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines.

34. Now produced and shown to me:

- (a) marked "Exhibit CS-44" are examples of advertisements published in newspapers and magazines between 2005 and 2010; and
- (b) marked "Exhibit CS-45" are examples of brochures provided to the public.

Use of WE'RE THERE FOR YOU in connection with motor vehicle services

35. The Applicant has continuously promoted its emergency roadside assistance services for cars, bicycles, wheelchairs and scooters in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.

36. Now produced and shown to me:

- (a) marked "Exhibit CS-46" are examples of brochures provided to the public between 2006 and 2013;
- (b) marked "Exhibit CS-47" are examples of prints that was displayed on counter-mats at RACV stores in 2007 and 2008;
- (c) marked "Exhibit CS-48" are examples of advertisements displayed on point of sale advertising materials and posters in store between April 2007 and April 2013;
- (d) marked "Exhibit CS-49" are examples of advertisements displayed on A5 tent cards in store between November 2007 and June 2013;
- (e) marked "Exhibit CS-50" are examples of advertisements published in newspapers, magazines and street directories between 2005 and 2013;
- (f) marked "Exhibit CS-51" are examples of Terms and Conditions brochures for emergency roadside assistance services;
- (g) marked "Exhibit CS-52" are vehicle stickers; and
- (h) marked "Exhibit CS-53" are examples of advertisements displayed in Adshells located at bus stops.

37. The Applicant has also promoted its emergency roadside assistance services for vehicles in connection with the WE'RE THERE FOR YOU mark in television advertisements. Now produced and shown to me marked "Exhibit CS-54" is an example of a television advertisement that was extensively broadcast on free to air television in Australia in about November 2006.

Use of WE'RE THERE FOR YOU in connection with accommodation, sporting and food and

drink services

38. The Applicant has continuously promoted its resorts and the facilities available at those resorts including accommodation, dining, use of function space, golf and other sporting activities and services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.

39. Now produced and shown to me:

- (a) marked "Exhibit CS-55" are examples of advertisements published in newspapers and magazines between November 2005 and July 2012; and
- (b) marked "Exhibit CS-56" are examples of brochures and point of sale advertising materials promoting the golf services offered by the Applicant.

Use of WE'RE THERE FOR YOU in connection with tourism and travel services

40. The Applicant has continuously promoted its tourism and travel services including travel insurance, car hire, attraction tickets, tours and cruises in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.

41. Now produced and shown to me:

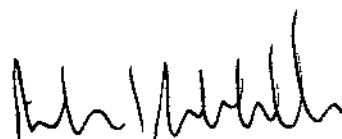
- (a) marked "Exhibit CS-57" are brochures provided to the public;
- (b) marked "Exhibit CS-58" are advertisements published in newspapers and magazines; and
- (c) marked "Exhibit CS-59" are examples of advertisements displayed on point of sale advertising materials and posters in store between December 2006 and April 2013.

Use of WE'RE THERE FOR YOU in connection with other services

42. The Applicant has continuously promoted the benefits available for RACV members (such as vehicle inspection services) in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.

43. Now produced and shown to me:

- (a) marked "Exhibit CS-60" are examples of brochures between July 2007 and September 2013;



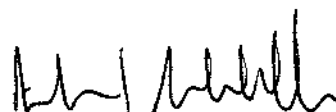
- (b) marked "Exhibit CS-61" are examples of advertisements published in newspapers and magazines between September 2004 and January 2013;
- (c) marked "Exhibit CS-62" are examples of advertisements displayed on point of sale advertising materials and posters in store between November 2006 and April 2013; and
- (d) marked "Exhibit CS-63" are examples of envelopes and letters displaying the mark.

Use of WE'RE THERE FOR YOU in connection with driver education and vehicle inspection services

- 44. The Applicant has continuously promoted its vehicle inspection and drive school services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.
- 45. Now produced and shown to me:
 - (a) marked "Exhibit CS-64" are examples of advertisements published in newspapers and magazines between October 2004 and October 2011;
 - (b) marked "Exhibit CS-65" are examples of advertisements displayed on point of sale advertising materials and posters in store between November 2005 and July 2011;
 - (c) marked "Exhibit CS-66" are examples of advertisements displayed in Adshells located at bus stops in September 2009; and
 - (d) marked "Exhibit CS-67" are examples of brochures provided to the public between October 2005 and December 2010.

Use of WE'RE THERE FOR YOU in connection with fleet care services

- 46. The Applicant has continuously promoted its fleet care services in connection with the WE'RE THERE FOR YOU mark in print media, including advertisements in newspapers and magazines and brochures.
- 47. The Applicant's fleet care services are a bundle of services which RACV provides to businesses that operate a fleet of vehicles. Services provided include emergency roadside assistance, supply of spare parts for vehicles and vehicle towing services.
- 48. Now produced and shown to me marked "Exhibit CS-68" are examples of advertisements from 2006 to 2011 promoting the Applicant's fleet services.



Other uses of WE'RE THERE FOR YOU

49. In addition to the print materials and television advertisements referred to in the preceding paragraphs, the Applicant has also used the trade mark continuously since 2003 in other ways in connection with the Services.

Outdoor billboards and advertisement

50. The Applicant has continuously promoted the Services in connection with the WE'RE THERE FOR YOU mark through large scale, outdoor advertising to the general public.
51. Now produced and shown to me marked "Exhibit CS-69" are examples of the billboards used to promote the Services, including home and car insurance, home assistance and emergency roadside assistance and general benefits offered to all RACV members.

Exhibitions and Shows

52. The Applicant has promoted its caravan services at caravan exhibitions in connection with the WE'RE THERE FOR YOU mark. Now produced and shown to me marked "Exhibit CS-70" is an example of signage displayed at caravan exhibitions in 2010, 2011, 2012 and 2013. From information provided by the organisers of the March 2013 caravan exhibition, I believe that approximately 50,000 people attended the exhibition.
53. The Applicant has promoted its boat services at boat exhibitions in connection with the WE'RE THERE FOR YOU mark. Now produced and shown to me marked "Exhibit CS-71" are examples of signage and brochures displayed at a boat shows in May 2009, 2010 and 2013.

Online Promotion

54. The Applicant has since 2003 and continues to promote the Services on its website in connection with the WE'RE THERE FOR YOU mark. The mark is prominently displayed on the top of the home page of and other pages at the Applicant's main website, located at <http://www.racv.com.au/wps/wcm/connect/racv/Internet/Primary/home> (Website). Visitors to the Website can access information about the Services using links originating from this page.
55. Now shown to me marked "Confidential Exhibit CS-72" are:
- (a) a document setting out the number of page views of the Website each month since January 2009; and
 - (b) a document setting out the number of unique hits on the Website each month since January 2009.

To obtain the relevant number for each month, it is necessary to calculate the sum of the absolute (rather than the percentage) figures in the four columns. The Applicant does not have any data about the number of page views and unique hits before 2009.

56. The information contained in Confidential Exhibit CS-72 is confidential to the Applicant, and its disclosure to competitors of the Applicant may irreparably damage the commercial or other interests of the Applicant. I therefore request that the Registrar of Trade Marks requires that the information contained in the document in Confidential Exhibit CS-72 be held in the Trade Marks Office confidentially, in accordance with section 226A of the *Trade Marks Act 1995* (Cth).

Research into the level of recognition of the WE'RE THERE FOR YOU mark amongst the general public

57. In 2012, the Applicant commissioned brand tracking research to assess the recognition of (among other brands) the WE'RE THERE FOR YOU mark among the general public.
58. The research involved asking 400 participants questions to test recognition of RACV tag line and trade mark, WE'RE THERE FOR YOU. One third of the survey participants were not members of the Applicant. Participants were first asked which company they believe WE'RE THERE FOR YOU is connected too. Although 61% of participants could not recall, more than a quarter (27%) mentioned the Applicant without being prompted. Awareness that the tag line was for RACV was slightly higher amongst those earning more than \$50,000 per annum (33%) than those living in lower income households (20%).
59. The participants in the survey were selected to reflect the adult Victorian population in respect of age as well as:

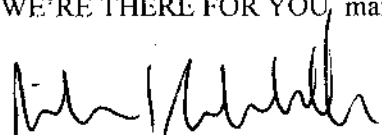
Gender, 48% males / 52% females (achieved - 37% males / 63% females); and

Location, 74% metropolitan Victoria / 26% non-metro Victoria (achieved - 75% metro / 25% non-metro)

60. Now produced and shown to me marked "Exhibit CS-73" is a copy of the research study.

Sales and promotional expenditure

61. The Applicant has spent significant sums on advertising media and in promoting the Services in Australia under or by reference to the WE'RE THERE FOR YOU mark during the period



from 2003 to 2013. Now produced and shown to me marked "Confidential Exhibit CS-74" is a table showing the expenditure excluding GST by the Applicant on advertising media and in advertising and promoting the Services in Australia under and by reference to the WE'RE THERE FOR YOU mark over the previous 10 financial years.

62. The information contained in Confidential Exhibit CS-74 is confidential to the Applicant, and its disclosure to competitors of the Applicant may irreparably damage the commercial or other interests of the Applicant. I therefore request that the Registrar of Trade Marks requires that the information contained in the document in Confidential Exhibit CS-74 be held in the Trade Marks Office confidentially, in accordance with section 226A of the *Trade Marks Act 1995* (Cth).

Revenue

63. The Applicant has generated significant revenue as a result of providing the Services in Australia under or by reference to the WE'RE THERE FOR YOU mark over the last 10 financial years. Now shown to me and marked "Confidential Exhibit CS-75" is a document showing the total revenue generated by the Applicant from providing the Services in Australia between December 2003 and 2013, including a breakdown of the amount of that revenue attributable to each financial year. The document also breaks down the amounts attributable to several different categories of the Services.

64. The information contained in Confidential Exhibit CS-75 is confidential to the Applicant, and its disclosure to competitors of the Applicant may irreparably damage the commercial or other interests of the Applicant. I therefore request that the Registrar of Trade Marks requires that the information contained in the document in Confidential Exhibit CS-75 be held in the Trade Marks Office confidentially, in accordance with section 226A of the *Trade Marks Act 1995* (Cth).

Future use of the WE'RE THERE FOR YOU mark

65. The Applicant's use of the WE'RE THERE FOR YOU mark in Australia, as set out above, been significant. The offering, provision, advertising and promotion of the Services in Australia by and on behalf of the Applicant under and by reference to the WE'RE THERE FOR YOU mark will continue over the coming years. The Applicant will continue to use the WE'RE THERE FOR YOU mark extensively in relation to the Services in its publications, print advertisements, online promotional activities and other media to advertise and promote the Services in Australia, with the materials that the Applicant will use, which are of the same kind as are included in the Exhibits referred to in paragraphs 10 to 55 above.



66. Now produced and shown to me marked "Confidential Exhibit CS-76" is a document setting out the Applicant's budgeted Australian advertising and promotional expenditure for the Services under and by reference to the WE'RE THERE FOR YOU trade mark during the 2014/2015 financial year, including a breakdown of the planned expenditure to promote separate categories of services. As can be seen from that document, the Applicant's total planned advertising and promotional expenditure for the Services under and by reference to the WE'RE THERE FOR YOU trade mark during the 2014/2015 financial year exceeds [REDACTED]

67. The information contained in Confidential Exhibit CS-76 is confidential to the Applicant, and its disclosure to competitors of the Applicant may irreparably damage the commercial or other interests of the Applicant. I therefore request that the Registrar of Trade Marks requires that the information contained in the document in Confidential Exhibit CS-76 be held in the Trade Marks Office confidentially, in accordance with section 226A of the *Trade Marks Act 1995* (Cth).

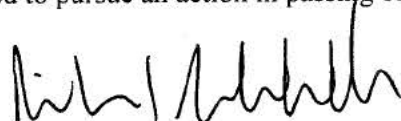

Conclusion

68. By reason of:

- (a) the extensive provision by the Applicant in Australia of the Services since about May 2003 under and by reference to the WE'RE THERE FOR YOU mark;
- (b) the promotion and advertising undertaken by the Applicant in Australia for the Services under or by reference to the WE'RE THERE FOR YOU mark; and
- (c) the intended future use by the Applicant of the WE'RE THERE FOR YOU mark in Australia in connection with the Services,

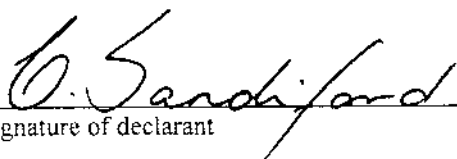
I believe that a substantial number of members of the Australian public specifically and exclusively associate the WE'RE THERE FOR YOU mark, when used in relation to insurance and associated services, with the services of the Applicant.

69. I therefore further believe that the Applicant not being able to register the WE'RE THERE FOR YOU mark in Australia may result in substantial detriment to the Applicant. If the WE'RE THERE FOR YOU mark is not registered, the protection offered by trade mark registration under the *Trade Marks Act 1995* (Cth) would be denied to a trade mark that I believe has acquired substantial goodwill and reputation in Australia. In addition, if another person misappropriated the Applicant's goodwill and reputation in the WE'RE THERE FOR YOU mark, the Applicant would be forced to pursue an action in passing off or under the


Competition and Consumer Act 2010 (Cth) to protect its goodwill and reputation in respect of the WE'RE THERE FOR YOU mark. I have been informed by Mr Krenzer that, if the Applicant took such action to protect its goodwill and reputation in the WE'RE THERE FOR YOU mark, it would have to go through the considerable expense of gathering documentary evidence of its reputation and goodwill and prove such reputation and goodwill in the court in which any legal proceedings are commenced.

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 (Cth)*, and I believe that the statements in this declaration are true in every particular.



Signature of declarant

Declared at **NOBLE PARK** on the **16TH** day of July 2014

Before me: 
Signature of witness

Full name of witness

Address of witness:

RICHARD CAMERON TWEDDLE
8/473 Bourke Street, Melbourne 3000
An Australian Legal Practitioner
within the meaning of the
Legal Profession Act 2004 (Vic.)

Qualification of witness

EVIDENCE SUMMARY SHEET

s41(5) / s41(4)

Trade Mark Application Number: 1523118
Trade Mark: WE'RE THERE FOR YOU
Applicant Name: Royal Automobile Club of Victoria (RACV) Limited
Filing Date: 31/10/2012
Objection Type: Desc

Evidence Summary

1. How the trade mark is being used (See Part 19A of the Manual):

Despite mark being in close proximity to the 'RACV' brand, does not necessarily function as mere description of the goods/services or has its significance diminished by the additional material - of somewhat similar prominence and does act as a badge of origin; demonstrated tm use.

2. How the trade mark is being promoted:

Television advertisements, print media (newspaper, magazines, booklets, brochures, billboards, etc), exhibitions, online promotions (website).

3. The geographical extent of the use:

21 shops in Victoria, but Australia-wide based on online presence.

4. Duration of use (including date of first use, continuous use):

Declarant claims mark was used since about May 2003 and has been continuous.

5. How substantial is the sales volume/turnover:

Declarant claims turnover figures of [REDACTED] from 2003/2004 to 2012/2013.

6. Unit cost:

N/A

7. How much has been expended on advertising:

Declarant claims advertising expenditure figures of [REDACTED] from 2003/2004 to 2012/2013. Declarant also claims that the applicant is planning on expending in excess of [REDACTED] for the 2014/2015 financial year.

8. Goods/services the trade mark has been used on:

As applied.

9. Overseas use:

N/A

10. Intended use:

N/A

11. Other Circumstances:

EXAMINER'S RECOMMENDATION s41(5)/ s41(4)	<input checked="" type="checkbox"/> Applied / Overcome
--	--

EXAMINER'S REASONS:

Declarant claims mark was used by the applicant since about May 2003 is continuous; Declarant claims research was undertaken by applicant in 2012 to assess the recognition of the mark among the general public - the results showed that 27% of the participants recognised the mark being connected to the applicant without being prompted; very substantial turnover figures of [REDACTED] from 2003/2004 to 2012/2013; advertising expenditure also substantial with figures of [REDACTED] from 2003/2004 to 2012/2013; contents provided does demonstrates use of the mark as a badge of origin despite close proximity to 'RACV'; use is Australia-wide based on online presence; on balance of factors including the inherent adaptability of the mark to distinguish, mark is capable of distinguishing its goods and services from those of other traders.

S41(5) could be applied under the following conditions / S41(4) could be overcome by:

Examiner: Michael Yoon

Date: 15 May 2015

REMINDERS:

- **S41(5) applies to applications with a filing date prior to 15 April 2013**
- **S41(4) applies to applications with a filing date on/after 15 April 2013**
- **Add Endorsement**