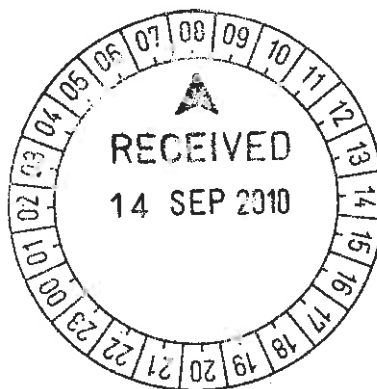




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Hazan Hollander
Ashington Court
Level 2 Suite 201
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SYDNEY NSW 2000

Attention: Yves Hazan

Dear Opponent

Re: Opposition by Carole Anne Bunter to registration of trade mark application 1127005(6, 37, 45) - **SECUREVIEW** - filed in the name of SecureView Australia Pty Ltd.

Your ref: 080537

I refer to the recent hearing, held in Sydney on 20 July 2010, in relation to the above opposition matter.

I have now had the opportunity to review all of the relevant material and decide this matter. Attached is my decision, including written reasons, made as the delegate of the Registrar.

This decision can be appealed in the Federal Court. Please note the provisions of the Federal Court Rules Order 58, Rules 4(2) and 4(2A) which read, respectively:

(2) An appeal must be instituted [*at the Federal Court*] within 21 days after the date of the decision appealed from or within such further time as the Court, on application, fixes, unless a law of the Commonwealth provides otherwise.

(2A) The notice of appeal must be served on the Commissioner (in this case, the Registrar) and all other parties to the appeal within 5 days of the day on which the notice of appeal is filed.

Yours sincerely

Iain Thompson
Hearing Officer
Trade Marks Hearings
04 September 2010



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MANAGEMENT SYSTEM
— ISO 9001 —



TRADE MARKS ACT 1995

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

Re: Opposition by Carole Anne Bunter to registration of trade mark application 1127005(6, 37, 45) - **SecureView** - filed in the name of SecureView Australia Pty Ltd.

DELEGATE:	Iain Thompson
REPRESENTATION:	Opponent: Written submissions of P.A. Madigan of Counsel instructed by Hazan Hollander. Applicant: Ben Fitzpatrick of Counsel instructed by Shelston IP
DECISION:	2010 ATMO 86 s52 opposition - s58 grounds – pre-use activities by applicant; opponent’s evidence of a Yellow Pages® entry and other material is of weight in establishing use of trade mark. s58 ground established. Costs awarded against applicant.

Background

1. In this matter SecureView Australia Pty Ltd of Oyster Bay, New South Wales, (‘the applicant’) has applied to register a trade mark under the *Trade Marks Act 1995* (‘the Act’). Current details of the application appear below:

Application No: 1127005
Priority Date: 1 August 2006
Goods/Services: **Class 6:** Building materials of metal; fittings of metal for building; hardware of metal (small); insect screens of metal; hinges of metal; grilles of metal; goods of common metal not included in other classes; gates of metal gates of metal, for the protection of children; fittings of metal for windows; fittings of metal for building; doors of metal; door fittings, of metal; door frames of metal; door handles of metal; door panels of metal; door stops of metal; buildings (fittings of metal for -); bolts of metal; bolts of metal, and chemical fixatives (kits comprising -) for attaching or reinforcing; window frames of metal; goods of common metal not included in other classes.
Class 37: Erection of security fencing; installation of security systems; installation of window coatings; installation of window films; installation of window frames; maintenance and servicing of security alarms; repair of security locks.

Class 45: Providing information, including on-line, about security; advisory services relating to security; advisory services relating to the security of premises; monitoring of burglar and security alarms; provision of security information; provision of information relating to security.

Trade Mark: **SecureView**
(‘the opposed trade mark’)

2. The application was examined in compliance with section 31 of the Act and the opposed trade mark was advertised as accepted for possible registration on 28 February 2008 in the *Australian Official Journal of Trade Marks*.
3. On 26 May 2008, Carole Anne Bunter (‘the opponent’) served and filed Notice of Opposition (‘the Notice’) to the registration of the opposed trade mark. The Notice recites most of the grounds available under the Act and does refer to a ground under section 58 (under which, I consider, this matter is most conveniently and obviously decided). Section 58 was also amongst those grounds argued at the hearing which I conducted as a delegate of the Registrar of Trade Marks in Sydney on 20 July 2010. At the hearing the opponent relied on written submissions by P.A. Madigan of Counsel, instructed by Hazan Hollander; the applicant was represented by Ben Fitzpatrick of Counsel, instructed by Shelton IP, patent and trade mark attorneys.

The Evidence

4. For the sake of brevity in this matter I will discuss only the evidence of the parties that is essential to my decision under the section 58 ground.
5. The evidence in this matter comprises five statutory declarations. The opponent has served and filed the declaration of Carole Anne Bunter dated 25 November 2008 in support of the opposition. The applicant has served and filed the declarations of Philip Hendrick Van Der Woerd dated 19 November 2009 and the declarations of Samuel John Hallahan dated 23 September 2009, 5 November 2009, and 17 December 2009. The opponent has served and filed in reply the declaration of Carole Anne Bunter dated 9 March 2010. There are also documents in evidence supplied by the opponent as the result of a request by the applicant for production of documents however these are incidental to my decision and I will not discuss them.
6. In her declaration, the opponent states that she has been making fly screens, window screens, screen doors and like products since approximately 1984, initially in

partnership, then as a sole proprietor under the business name Buzzoff Flyscreens Security & Screening Systems. This business is, says the opponent, centered in the Newcastle and Lake Macquarie region of New South Wales, but additionally operates in Sydney and the Central Coast region of New South Wales, and sells through distributors across Australia.

7. The opponent declares:

In approximately January 2004, I became interested in developing a new type of security door product made out of a galvanised stainless steel mesh rather than traditional flyscreen mesh. I had previously sold security screens made of traditional flyscreen mesh on a metal frame with metal bars or grilles that would obstruct the view of a person on the inside of the door looking outside. I was interested in developing a security door made of a fine galvanised stainless steel mesh that could be used without the need for the reinforcement of metal bars and which would be stronger than an ordinary security door made from flyscreen mesh. At that time, I coined the name and mark 'Secureview' as I believed this would be a good name for my proposed security screen product.

By November 2004, I had prepared designs for the product and approached Shellhold Pty Ltd ('Shellhold'), a wholesaler of hardware products located in the suburb of Matraville in Sydney, NSW, about the availability of various types of security mesh products that I wished to use for products to be sold by me under the Secureview mark.

In early December 2004, I received samples of galvanised mesh and stainless steel mesh from Shellhold. I created sample security screen products made of stainless steel mesh and galvanised mesh that I subsequently sold under the name and mark 'Secureview'. Exhibited hereto and marked "CAB-4" is a copy of an invoice dated 15 May 2005 in respect of a sale of a security screen product under the 'Secureview' name and mark.

On 16 August 2005, I placed an order with Shellhold for quantities of the galvanised mesh and stainless steel mesh, and advised Shellhold at that time that I would be using the mesh products to manufacture a security screen product that I was going to offer for sale and sell by reference to the trade mark Secureview.

I have continued to order security mesh products from Shellhold which I have used to manufacture my 'Secureview' security screens. Exhibited hereto and marked "CAB-5" is a letter from Mr John McCauley of Shellhold Pty Ltd in respect of the details set out in paragraphs 6 to 9.

Since approximately May 2005, I have used the name and mark 'Secureview' in respect of my security screen product continuously to date.

8. The opponent gives a list of advertisements which include the trade mark SECUREVIEW which have appeared in the Newcastle *Yellow Pages*® between 2006 and 2009.
9. The relevant 2006 *Yellow Pages*® advertisement (which the opponent states she ordered in 2005) relied upon by the opponent appears below:



10. I will digress now to note that the evidence in answer of Mr Hallahan, a solicitor in the employ of Shelton IP, demonstrates that in 2006 the cut-off date for advertising in the 2006 Newcastle *Yellow Pages*® was March 2006 and that the publication would have appeared in June 2006. It is not clear to me from the evidence how soon the above advertisement would have appeared in the electronic version of the publication.
11. There are, as submitted by Mr Fitzpatrick for the applicant, problems with placing much weight upon the invoice evidence of the opponent – most notably, these documents appear to be issued on a date at which the entity issuing them had not come into existence. There are possible explanations for this – such as these invoices were subsequently printed off a computerised system in which two set of data have been confusingly merged – however no explanation of these discrepancies has been furnished by the opponent.
12. Mr Philip Henrick Van der Woerd is a director and company secretary of the applicant. He says:

In early 2006, I began to develop a new stainless steel security mesh screen product. In order to develop and market this product, I decided to create a new business. At that time, after many discussions with my wife about a potential name for my new product and new business, my wife suggested the name "Secureview" to me.

In early 2006, I conducted extensive searches for the name "Secureview" using:

- (a) the Yellow Pages;
- (b) the internet;
- (c) the databases of domain name registration providers; and
- (d) the public database of the Australian Securities and Investments Commission (ASIC).

As a result of these searches, I did not identify any other person or entity in the Australian security door and screen industry that was using the name or trade mark "Secureview". I therefore decided to use the name "SecureView" as the name for the new company that I intended to form, and as the name for my new product.

In preparation for launching my new business and product, on 27 February 2006, I gave a presentation to potential stakeholders in my proposed business venture. This presentation was attended by a number of people from within the industry, including people who worked with fabricators in the security door industry from Sydney, Melbourne and Brisbane. During the presentation, I informed attendees that I intended to incorporate a proprietary company called "Secureview", which would distribute a range of stainless steel products, particularly security screens and doors, throughout Australia through a network of dealers. I also advised attendees that, of the products to be distributed by SecureView, the lead product brand would be "SecureView", being the new stainless steel security mesh screen that I had developed. None of the attendees indicated that they were aware of the name "Secureview" being used by any other person within the industry.

On 18 May 2006, I lodged an application to register SecureView [sic] as a proprietary company with ASIC. Annexed to this declaration and marked "PW-2" is a copy of a printout that I have caused to be obtained from the public records of the ASIC, relating to SecureView.

On 23 May 2006, I registered the domain name www.secureview.com.au in the name of SecureView, with Domain Central. Annexed to this declaration and marked "PW-3" is a copy of the results of a Whois query for www.secureview.com.au performed at the website hosted at the domain name www.mywebname.com.au. Shortly after I registered the domain name, I began working with Mark Skinner Advertising in

Brisbane to create material for the website that I intended to launch using that domain name.

On 1 July 2006, I lodged an application with the Australian Taxation Office to register SecureView for GST purposes. Annexed to this declaration and marked "PIA/-4" is a copy of a printout that I have caused to be obtained from the website www.abr.business.gov.au relating to SecureView's ABN and GST status.

Between 1 June 2006 and mid August 2006, I prepared marketing material for SecureView and its products. This involved having promotional photos taken of SecureView's products, writing the copy for the marketing material, consulting on the appropriate layout and appearance of the marketing material, and arranging for the printing of the material. Annexed to this declaration and marked "PW-5" is a copy of a brochure for SecureView's products which SecureView began distributing on or about 19 August 2006.

On 1 August 2006, I caused [this opposed application] to be filed on behalf of SecureView. [Parenthetical material added]

Onus

13. The opponent bears the onus of establishing one or more grounds of opposition on the balance of probabilities: *Pfizer Products Inc v Karam* [2006] FCA 1663. See also *Chocolaterie Guylian N.V. v Registrar of Trade Marks* [2009] FCA 891 (18 August 2009) at [22] to [26].

Section 58

14. Section 58 of the Act provides:

58 Applicant not owner of trade mark

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Note: For *applicant* see section 6.

15. I agree with Mr Fitzpatrick's submissions concerning the applicable tests under section 58 and adapt them, below.
16. Section 17 of the Act provides:

What is a trade mark?

17. A *trade mark* is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Note: For *sign* see section 6.

17. The fundamental role of a trade mark is to operate as a badge of origin. As noted by Lord MacMillan in *Aristoc Ltd v Rysta* (1944) 62 RPC 65 (HL):

If there is one thing that may be described as fundamental in this branch of the law it is that the function of a trade mark is to indicate the origin of the goods to which it has been applied.

18. In *Montana Tyres Rims & Tubes Pty Ltd v Transport Tyre Sales Pty Ltd*, in discussing section 17 of the Act, Wilcox J. stated:

Despite the width of the term dealt with, there is no reason to doubt that the essential purpose of a trade mark continues to be indication of the origin of goods. A purchaser's enquiry about the origin of goods will usually be answered by identifying their manufacturer.

19. The first person to use a mark in Australia in respect of particular goods or services is the owner of the mark, with respect to those particular goods or services: *Shell Co. (Aust) Ltd v. Rohm and Haas Co.* (1948) 78 C.L.R. 601. Absent any use of a trade mark in Australia, its owner is the person who first makes a valid application to register it as a trade mark for particular goods and/or services. This right of ownership extends to substantially identical marks. *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994) AIPC 91-049. The use must be in relation to the same goods or the same kind of thing (per Holroyd J. in *Re Hicks Trade Mark* (1897) 22 V.L.R. 636 at 640). As noted by Justice Dixon in *Shell Co (Aust) Ltd v. Rohm and Hass Co* (1948) 78 CLR 601 at 628:

authorship involves the origination or first adoption of the word or design **as and for a trade mark** . (emphasis added)

20. To be relevant the use must be a use of the sign in Australia as a trade mark in respect of the claimed goods and services: *Moorgate Tobacco Ltd v Philip Morris Ltd* (No 2) [1984] HCA 73; (1984) 59 ALJR 77 ('Moorgate'). Moreover, in *Moorgate Tobacco Co Ltd v Philip Morris Ltd* (1984) 156 CLR 414 at 432; 56 ALR 193 at 204; 3 IPR 545 at 556 ; [1984] HCA 73 Deane J said:

The prior use of a trade mark which may suffice, at least if combined with local authorship, to establish that a person has acquired in Australia the statutory status of proprietor of the mark, is public use in Australia of the mark as a trade mark, that is to say, a use of the mark in relation to goods for the purpose of indicating or so as to indicate a connexion in the course

of trade between the goods with respect to which the mark is used and that person.

21. In *Shahin Enterprises Pty Ltd v Exxonmobil Oil Corporation* [2005] FCA 1278 Shahin had placed a sandwich board, or A-frame sign, bearing the words ON THE RUN COMING SOON on a footpath outside their business and claimed this was use of a trade mark. Lander J said (at [70] to [77]):

In *Moorgate and Settef SpA v Riv-Oland Marble Co (Vic) Pty Ltd* (1987) 10 IPR 402 (the authority to which Drummond J referred), there was evidence that the mark had been applied to the goods. There is no such evidence in this case.

There is no evidence that there was ever any intention to use that sign to distinguish goods or services dealt with or provided by the applicant in the course of trade for goods or services dealt with or provided by any other person.

There is a clear distinction, in my opinion, between conducting a business under a particular name and using a mark in respect of goods or services. The intention which the applicant needed to establish was an intention to use a mark to distinguish goods or services in the course of the applicant's trade from goods or services provided by any other person. Because it has established that it intended to use the name to brand its businesses, that does not mean, however, it has established that it has used a mark or a sign to distinguish goods or services in the course of trade.

22. In *The Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 at 426; [1963] ALR 634 ; 1B IPR 523 at 535 ; [1961] HCA 75, Taylor J said:

In particular, I agree that in order for the respondent to succeed in the suit it was necessary that it should appear that the use by the appellant of the animated figure or device which it employed was used by it as a trade mark. It was not, in my view, sufficient merely to show that, in the language of s 62, it was used in the course of trade.

23. In determining whether a sign is being used as a trade mark, the context in which the mark may be used is all important. See *Shell Company of Australia Ltd. v. Esso Standard Oil (Australia) Ltd* supra per Kitto J. at 422. See also *Aldi Stores Ltd Partnership v. Frito-Lay Trading Company GmbH* (2001) 54 IPR 344 per Lindgren J at [62], per Hill J at page 353; *Unilever Aust Ltd v. Karounos* [2001] FCA 1132 per Hill J. at 361; *Johnson and Johnson* per Gummow J. at 347; *Kenman Kandy* per Lindgren J at [84].

24. A sign will be used as a trade mark if the use is such as to distinguish the goods or services of the person who uses it from those of other traders so that it is a badge of origin of those services. See *Shell Co. of Australia Ltd. v. Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 per Kitto J. at 422-425; *Mark Foy s Ltd v. Davies Coop and Co Ltd* supra at 198-200 per William J.; *Johnson and Johnson Australia Pty Ltd v. Sterling Pharmaceuticals Pty Ltd* (1991) 30 FCR 326 at 335 per Lockhart J., 342 per Burchett J. and 347-8 per Gummow J.
25. Where a person seeks to rely on one, or a few, instances of alleged use, in respect of particular goods then the evidence of such use must be supported by overwhelmingly convincing proof (per Lord Wilberforce in *Nodoz Trade Mark* [1962] RPC 1 at 7).

Discussion

26. The trade marks of the parties are to all intents identical: see *Sitmar, Shell Co*, above.
27. Accordingly, this matter essentially resolves itself to the question as to whether the alleged use of the trade mark in June 2006 in the Newcastle *Yellow Pages*® by the opponent preceded any purported use of the trade mark by the applicant before the filing of this application. Moreover, if the applicant did not use the trade mark prior to filing this application, it is left to be decided whether opponent used the trade mark in the Newcastle *Yellow Pages*® advertisement of June 2006 and thus establishes her ownership of the trade mark prior to 1 August 2006.
28. The instances of purported use relied upon by the applicant are:
 1. The presentation to a group of potential stakeholders on 27 February 2006.
 2. Lodgment of an application to register SecureView as a proprietary company with ASIC on 18 May 2006.
 3. Registration of the domain name www.secureview.com.au on 23 May 2006.
 4. Lodgment of an application with the Australian Taxation Office to register SecureView for GST purposes on 1 July 2006.

5. Preparation of marketing material for SecureView and its products between 1 June 2006 and mid August 2006.

29. I adopt the numbering of the preceding paragraph to discuss the issues raised within the corresponding subparagraphs below:

1. *Preliminary discussions.* It is not necessary for goods or services to have actually been sold for use 'in the course of trade' to have occurred. The offering for sale of goods or services, if genuine, will suffice. In 'Moorgate' 156 CLR 414, Deane J stated at 433 that:

The cases establish that it is not necessary that there be an actual dealing in goods bearing the trade mark before there can be a local use of the mark as a trade mark.

His Honour went on to state that in the cases where a small amount of use had been found sufficient to determine that the trade mark had been used in the course of trade:

... it is possible to identify an actual trade or offer to trade in the goods bearing the mark...

In 'Moorgate' it was found that there was no local use of the trade mark as a trade mark; there were merely preliminary discussions and negotiations about whether the trade mark would be used.

I consider that the preliminary discussions referred to in the applicant's evidence were of like kind to those in 'Moorgate' and there is no evidence before me that the opposed trade mark was placed before the public for the purpose of eliciting orders in relation to goods or services at that time.

2. *The company name registration.* Registration of a company name is not use of a trade mark – this registration creates a business entity distinct from any trade mark which might be used by that business entity (and that trade mark may or may not be similar to the name that is registered for the business entity): see *Bates v Adams* (2007) 73 IPR 384. In commenting on the registration of business names (under which no entity is created) Lander J stated in *Shahin Enterprises Pty Ltd v Exxonmobil Oil Corporation* [2005] FCA 1278:

There is a clear distinction, in my opinion, between conducting a business under a particular name and using a mark in respect of goods or services. The intention which the applicant needed to establish was an intention to use a mark to distinguish goods or services in the course of the applicant's trade from goods or services provided by any other person. Because it has established that it intended to use the name to brand its businesses, that does not mean, however, it has established that it has used a mark or a sign to distinguish goods or services in the course of trade.

3. *The domain name registration.* Registration of a domain name, per se, is not use of a trade mark. In *Sports Warehouse, Inc v Fry Consulting Pty Ltd* [2010] FCA 664, Kenny J stated:

It is not suggested that mere registration of a domain name can amount to use of the mark. More must be shown. Plainly enough, not all domain names will be used as a sign to distinguish the goods or services of one trader in the course of trade from the goods or services of another trader. Sports Warehouse is correct in its submission that that whether or not a domain name is used as a trade mark will depend on the context in which the domain name is used. In this case, the domain name is more than an address for a website, the domain name is also a sign for the Applicant's online retailing service available at the website. In the context of online services, the public is likely to understand a domain name consisting of the trade mark (or something very like it) as a sign for the online services identified by the trade mark as available at the webpage to which it carries the internet user.

4. *Application for GST with the ATO.* This is not a public use of the trade mark – it records only the applicant's compliance with Australia's taxation laws.
5. *Preparation of marketing material.* The material which the applicant states that it prepared includes promotional photos taken of SecureView's products, writing the copy for the marketing material, consulting on the appropriate layout and appearance of the marketing material, and arranging for the printing of the material. I infer that the above activities might be best stated as "the preparation of a brochure." This brochure was, states the applicant, first placed before the public on 19 August 2006. While this may constitute an offer to trade in terms of 'Moorgate' (if the goods were then available for sale: *Radford & Co's Application* (1951) 68 RPC 221) the use is not before the priority date of the opposed trade mark.

30. The above instances of purported use of the opposed trade mark do not, individually, amount to a use of the opposed trade mark before the priority date of the opposed application. Whether these activities, collectively, amount to a use of the opposed trade mark must, I consider, also be answered in the negative. In *Woolly Bull Enterprises Pty Ltd v Reynolds* [2001] FCA 261, Drummond J stated:

...the owner will not use its mark unless it has so acted to show that it has gone beyond investigating whether to use the mark and beyond planning to use the mark and has got to the stage where it can be seen objectively to have committed itself to using the mark, that is, to carrying its intention to use the mark into effect.

31. An example of the collective activities of a party as constituting use of a trade mark lies in the decision of Gummow J in *Buying Systems (Aust) Pty Ltd v Studio SrL* [1995] FCA 1063. The case concerned the trade mark STUDIO for magazines. The opponent claimed to be the owner of the trade mark, and in support lodged evidence showing it had obtained business cards and letterheads bearing the mark. Crucially, it had also solicited third parties to advertise in the magazine. These activities could not constitute a dealing, as the application was in respect of magazines, not advertising services. However, the combination of activities in *Studio* and a placement of the trade mark before the public, indicated a clear intention coupled with preparatory steps demonstrating an objective commitment to use, sufficient to 'constitute a relevant use of the mark' in respect of the relevant goods.

32. I do not consider that the applicant's activities had progressed to this stage in relation to either the goods or services of the opposed application until at least 19 August 2006 when it began distributing its brochure for the purpose of soliciting orders. It was, considering all of the other activities, at this date when commercial activity, *in the course of trade*, commenced in relation to the opposed trade mark, the trade mark was placed before the public and orders were solicited.

33. Thus the relevant date is the date on which this opposed application was filed: 1 August 2006.

34. Accordingly, if the advertisement of the opponent, which appeared in the Newcastle *Yellow Pages*® in June 2006 (before the priority date of 1 August 2006) constitutes a use of the trade mark, the opponent has successfully established her opposition.

35. The advertisement will be good evidence of the use of the trade mark by the opponent if it was use as a trade mark and there were goods available for sale when the advertisement appeared: see the decision of the British Registrar in *Radford & Co's Application* (1951) 68 RPC 221, which has since been followed by the Australian Registrar— see *John Toh v Paris Croissant Co. Ltd* [2010] ATMO 34.
36. Whether the opponent's use of the sign Secureview, in the *Yellow Pages*® advertisement constitutes use of the sign as a trade mark depends on the context in which it is used – there is no formula which can be applied and each matter turns on its own circumstances – the process is an objective assessment of the sign in the milieu of its use: *Aldi Stores*; *Unilever Aust Ltd v. Karounos*; *Johnson and Johnson*; and *Kenman Kandy*, above.
37. For the sake of convenience, I again reproduce the advertisement on which the opponent relies:



38. The sign Secureview in the above advertisement has no dictionary meaning or obvious denotation to ordinary Australians and contextually appears in clear contrast to the commonplace dictionary words which accompany and surround it. It is thus, I consider, not a sign which is condemned by the company which it keeps but – despite the facts that it is rendered in the same typeface and size as the other words in the advertisement – it contrasts with them in having the appearance of being an invented and not a generic or descriptive word. It is a word used then by the opponent, and the opponent only, to designate only her goods as incorporating the “Latest Stainless

Steel Technology". Any person reading the advertisement would, I consider, be bound to understand that the word Secureview was being used as a trade mark by the opponent in the advertisement in relation to security and screening systems in much the same way that trade marks might be used in the expressions 'Coca Cola Soft Drinks' or 'Omo Washing Powders.'

39. Although there are problems with the opponent's invoice evidence, such as that referred to above, I am satisfied that, on the balance of probabilities, the weight of the evidence before me supports the view that at the time that the advertisement appeared in the 2006 Newcastle *Yellow Pages*® there were goods available to be sold under the trade mark and that the use of the trade mark was in trade. In particular, the evidence of the contemporaneous supply to the opponent of substantial amounts of materials by Shellhold to be manufactured into goods, coupled with the above advertisement, supports the proposition that the trade mark was then in use in relation to goods in the course of trade and that it served so as to indicate a connection between the goods and the opponent.
40. It logically follows that the opponent has the earlier use of the trade mark in relation to goods which are the same kind of thing as those of the applicant and thus she is the owner of the trade mark in relation to those goods in Australia.
41. I have given some thought as to whether it is appropriate to limit the opposed application to the claimed services only. I have no submissions as to whether this might be appropriate and each party appeared to argue on an 'all or nothing' basis. It is apparent that some, at least, of the services might normally be performed by any person involved in the provision of the goods – the provision of information concerning those goods and their installation, for example. I have no wish to appear to advocate for either party and will consequently regard the opposition as having been established in its entirety.
42. I thus find that the opponent has established her opposition under section 58.

Decision

43. Section 55 of the Act provides:

Decision

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


- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application; having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

44. I refuse to register application 1127005.

Costs

45. Costs appropriately follow the outcome of the matter and I award costs against the applicant at the official scale.



Iain Thompson
Hearing Officer
Trade Marks Hearings
13 September 2010