

10a. Overcoming a citation

5. Other special circumstances

~~Pursuant to~~Under section 26(b) of the Act, a trade mark may proceed to registration where “other special circumstances” exist that, in the ~~opinion of Court’s or~~ the Commissioner’s ~~opinion or the Court~~, makes it “proper” for the trade mark to be registered.

As with honest concurrent use, this condition depends on commercial realities which, in the ~~Court’s or the~~ Commissioner’s opinion, justify registration ~~notwithstanding despite~~ a real risk of deception and confusion.

In *Berlei Bali Limited v Bali Brassiere Co Inc* (1968) 118 CLR 128, Fox J stated:

Section 12(2) [of the 1938 UK Act] is dealing with special circumstances. Thus, it refers to the “case of honest concurrent use, or of other special circumstances”; it is dealing with special circumstances which justify taking the case out of the ordinary rules so that justice may be done to the applicant.

Honesty of use is still essential. However, applications which fail to overcome citations on the basis of use may be able to overcome them because of “other circumstances”.

These circumstances could include the following:

5.1 Applicant may overcome citation because of their earlier registered trade mark

The Office will offer an applicant for a mark, which is also the proprietor of a registered earlier filed mark, the opportunity to advance its later filed application to acceptance on the grounds of s26(b), in the face of any intervening registration in the name of a different proprietor and cited against the applicant’s application, provided that all of the following criteria are met:

- 1) The intervening mark:
 - a. does not have an earlier filing date than that of the applicant’s earlier mark,
and
 - b. clearly conflicts with the applicant’s earlier trade mark, and
 - c. is registered
- 2) The applicant’s earlier mark is not subject to proceedings
- 3) The applicant’s later filed mark is the same or a substantially identical mark, in respect of the same or very similar goods/ services, to its earlier trade mark registration

The applicant will need to agree to the following explanation being entered on the Register:

“Section 26(b) of the Trade Marks Act 2002 applies because of prior rights from (enter IP number(s)).”

Example 1: Proprietor of mark 3 will be offered the opportunity to advance mark 3 to acceptance on the grounds of s26(b).

Applicant files for a new mark:

DOLINE (Mark 3)

In class 33 for spirits and liqueurs

Intervening trade mark registration:

DOLINES (Mark 2)

In class 33 for alcoholic cocktails

Applicant's earlier trade mark registration:

DOLINE (Mark 1)

In class 33 for wines, spirits and liqueurs

Example 2: Proprietor of mark 3 will not be offered the opportunity to advance mark 3 to acceptance on the grounds of s26(b)

In this example, while applicant's later filed mark is the same mark as its earlier filed mark, the later filed mark is not in respect of the same or very similar goods to its earlier trade mark registration because the specification is much broader than the applicant's earlier registration. In this situation the Office will cite mark 2 against mark 3 and will not offer to accept mark 3 on the grounds of s26(b).

Applicant files for a new mark:

DOLINE (Mark 3)

In class 33 for wines, spirits, liqueurs

Intervening trade mark registration:

DOLINES (Mark 2)

In class 33 for alcoholic cocktails

Applicant's earlier registration:

DOLINE (Mark 1)

In class 33 for spirits

5.2 Applicant has previously consented to the registration(s) of a potential citation

Where the owner of an application facing a citation/(s) has previously given consent to the registration of that potential citation/(s) as owner of a still earlier mark, it will not usually be necessary to cite the intervening mark(s) unless the owner's latest application covers additional goods/ services which creates additional conflict with the goods/ services covered by the potential citation(s).

The Office, in this situation, will enter the following explanation on the Register:

“Section 26(b) of the Trade Marks Act 2002 applies because the owner has previously consented to the registration of (enter IP number(s) of the potential citation(s)).”

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