FEDERAL COURT OF AUSTRALIA

Henley Constructions Pty Ltd v Henley Arch Pty Ltd [2023] FCAFC 62

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| Appeal from: | *Henley Arch Pty Ltd v Henley Constructions Pty Ltd* [2021] FCA 1369 |
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| File numbers: | VID 737 of 2021  VID 164 of 2022 |
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| Judgment of: | **YATES, ROFE AND MCELWAINE JJ** |
|  |  |
| Date of judgment: | 28 April 2023 |
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| Catchwords: | **TRADE MARKS** – appeal – where primary judge found that the respondent’s registered trade mark HENLEY was valid and infringed by the first appellant – whether primary judge erred in finding that HENLEY was capable of distinguishing the respondent’s services under s 41 of the *Trade Marks Act 1995* (Cth) (the **Trade Marks Act**) – where primary judge found that HENLEY was not inherently distinctive – where primary judge found that s 41(6) was satisfied – no error established in finding that s 41(6) was satisfied  **TRADE MARKS –** infringement – substantial identity –whether primary judge erred in finding that HENLEY CONSTRUCTIONS is substantially identical to the respondent’s registered composite mark comprising the words HENLEY and PROPERTIES with device elements – error established – appeal allowed in part  **TRADE MARKS –** infringement – deceptive similarity – whether primary judge erred in finding that certain marks used by the first respondent are deceptively similar to the respondent’s registered marks – no error established  **TRADE MARKS** – infringement – use as a trade mark – whether primary judge erred in finding that the first appellant had used certain signs as trade marks – whether primary judge failed to have regard to the setting in which each sign was used – no error established  **TRADE MARKS** – infringement – prior use defence – whether primary judge erred in finding that the first appellant had not established a defence under s 124 of the Trade Marks Act – where primary judge found that the respondent’s use of the infringed marks HENLEY COLLECTION, HENLEY RESERVE and HENLEY ESSENSE was use of HENLEY based on s 7(1) of the Trade Marks Act – where primary judge found that the first appellant had not used HENLEY CONSTRUCTIONS prior to the respondent’s first use of HENLEY – error established – appeal allowed in part  **CONSUMER LAW** – misleading and deceptive conduct – false or misleading representations – whether primary judge erred in finding that the first appellant had contravened the Australian Consumer Law and the *Trade Practices Act 1974* (Cth) – whether primary judge erred in finding that the respondent had a relevant reputation – whether primary judge erred in finding that the building and construction industry is a national industry – whether primary judge erred in finding that there to be evidence of consumer confusion – no error established  **TRADE MARKS** – relief – whether primary judge erred in directing the question of an account of profits be determined separately after all other relief – where trial set down on all issues – no error established  **TRADE MARKS** – cross appeal – whether primary judge erred in finding that the first appellant’s use of 1300HENLEY was not use as a trade mark – error established – cross-appeal allowed  **COSTS** – application for leave to appeal from costs judgment of primary judge – offer of compromise under r 25.14(3) of the *Federal Court Rules 2011* (Cth) – where primary judge ordered that the appellants pay the respondent’s costs on an indemnity basis – whether primary judge erred in finding that the respondent obtained a judgment more favourable than its offer of compromise – application for leave to appeal dismissed |
|  |  |
| Legislation: | *Competition and Consumer Act 2010* (Cth) Sch 2 ss 18, 29  *Trade Marks Act 1995* (Cth) ss 7, 17, 41, 62, 92, 120, 122, 124  *Trade Practices Act 1974* (Cth) ss 52, 53  *Federal Court Rules 2011* (Cth) r 25.14(3) |
|  |  |
| Cases cited: | *Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd* [2017] FCAFC 56  *Blount Inc v Registrar of Trade Marks* [1998] FCA 440; 83 FCR 50  *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* [2018] FCA 235; 129 IPR 482  *Carr v Finance Corporation of Australia Ltd (No 1)* (1981) 147 CLR 246  *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511  *Colorado Group Ltd v Strandbags Group Pty Ltd* [2007] FCAFC 184; 164 FCR 506  *Energy Beverages LLC v Cantarella Bros Pty Ltd* [2023] FCAFC 44  *Glazier Holdings Pty Ltd v Australian Men’s Health Pty Ltd* [2000] NSWSC 253  *Henley Arch Pty Ltd v Henley Constructions Pty Ltd (No 2)* [2022] FCA 231  *Henley Arch Pty Ltd v Henley Constructions Pty Ltd* [2021] FCA 1369; 163 IPR 1  *In Re The Magnolia Metal Company’s Trade Marks* [1897] 2 Ch 371  *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* (1991) 30 FCR 326  *Meehan v Glazier Holdings Pty Ltd* [2002] NSWCA 22; 54 NSWLR 146  *Optical 88 Ltd v Optical 88 Pty Ltd (No 2)* [2010] FCA 1380; 275 ALR 526  *Optical 88 Ltd v Optical 88 Pty Ltd* [2011] FCAFC 130; 197 FCR 67  *Oxford University Press v Registrar of Trade Marks* (1990) FCR 1  *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407  *Urban Alley Brewery Pty Ltd v La Sirene Pty Ltd* [2020] FCA 82; 150 IPR 11  *Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd* [2010] FCA 1367; 191 FCR 297 |
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| Registry: | Victoria |
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| Solicitor for the Respondent: | Ashurst |

ORDERS

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| --- | --- | --- |
|  | | VID 737 of 2021  VID 164 of 2022 |
|  | | |
| BETWEEN: | HENLEY CONSTRUCTIONS PTY LTD ACN 123 122 038  First Appellant  PATRICK SARKIS  Second Appellant | |
| AND: | HENLEY ARCH PTY LTD ACN 007 316 930  Respondent | |

|  |  |
| --- | --- |
| order made by: | YATES, ROFE and mcelwaine jj |
| DATE OF ORDER: | 28 APRIL 2023 |

THE COURT ORDERS THAT:

1. Subject to Orders 2 to 4, the parties bring in agreed orders giving effect to these reasons for judgment.

2. In the event that the parties cannot agree on the orders to be made:

(a) within 10 days of the date of these orders, each party serve on the other a draft of the orders the party proposes, supported by written submissions not exceeding three pages; and

(b) within a further seven days, each party serve on the other party responding submissions not exceeding two pages.

3. At the time of service referred to in Order 2, the parties provide copies of the served documents to the Chambers of each member of the Full Court.

4. Subject to further order, the question of the orders to be made in this appeal be determined on the papers.

Note: Entry of orders is dealt with in Rule 39.32 of the *Federal Court Rules 2011*.

REASONS FOR JUDGMENT

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THE COURT:

# INTRODUCTION

1 The appellants, Henley Constructions Pty Ltd (**Henley Constructions**) and Patrick Sarkis, have appealed from a judgment of a single Judge of the Court. Mr Sarkis is the sole director of, and shareholder in, Henley Constructions.

2 In the proceeding below, the present respondent, Henley Arch Pty Ltd, alleged that Henley Constructions had: (a) infringed the respondent’s registered trade marks by dint of s 120(1) of the *Trade Marks Act 1995* (Cth) (the **Trade Marks Act**); and (b) contravened certain provisions of the Australian Consumer Law (Sch 2 to the *Competition and Consumer Act 2010* (Cth)) (the **ACL**) and the *Trade Practices Act 1974* (Cth) (the **Trade Practices Act**). The respondent alleged that, in respect of Henley Constructions’ trade mark infringements, Mr Sarkis was a joint tortfeasor. It also alleged that, in respect of Henley Constructions’ contraventions of the Australian Consumer Law and the Trade Practices Act, Mr Sarkis was liable as a person involved in those contraventions.

3 In respect of the allegations of trade mark infringement, the appellants denied infringement and raised certain defences to infringement. Henley Constructions cross-claimed seeking cancellation of the registered marks from the Register of Trade Marks or their removal for non-use (or, alternatively, that limitations be placed on the scope of their registrations). The appellants also denied the alleged contraventions of the ACL and the Trade Practices Act.

4 The primary judge largely accepted the respondent’s case: *Henley Arch Pty Ltd v Henley Constructions Pty Ltd* [2021] FCA 1369; 163 IPR 1 (**J**). We summarise the primary judge’s findings below at [20]-[93].

5 On 25 November 2021, the primary judge granted declarations in respect of Henley Constructions’ trade mark infringements and contraventions of the ACL, and Mr Sarkis’s involvement in those infringements and contraventions. His Honour also made orders dismissing Henley Constructions’ cross-claim, restraining the appellants from engaging in specified conduct, and requiring the appellants to take all steps necessary to transfer certain domain names to the respondent. His Honour made a number of procedural orders. On 18 February 2022, Rofe J granted leave to appeal from those orders.

6 On 17 March 2022, the primary judge made costs orders. On 31 March 2022, the appellants filed an application seeking leave to appeal from those orders. This leave application has been heard concurrently with the present appeal.

7 The respondent has cross-appealed on the single ground that the primary judge erred in finding that Henley Constructions had not used the sign 1300HENLEY as a trade mark. It has also filed a notice of contention seeking to support the primary judge’s findings in relation to the validity of the registration of the respondent’s work mark HENLEY, and the primary judge’s findings of contravention of the ACL.

8 We have concluded that the cross-appeal succeeds, and the appeal succeeds in part.

# BACKGROUND

9 The respondent is a builder of homes in Victoria, South Australia, Queensland and New South Wales. Since 1989, it has used a number of trade marks in the promotion of its business.

10 From 1989 until about 2005, it used the following marks (which the primary judge called the **Initial Henley Devices**):



11 From about 2005, it used the following marks (which the primary judge called the **2005 Henley Devices**):

 

12 From about 2017, it used the following marks (which the primary judge called the **2017 Devices**):

 

13 The respondent is the registered owner of the following trade marks, which compromise or include the word HENLEY (the **registered marks**):

| Mark | Reg. No | Priority Date | Registered Services |
| --- | --- | --- | --- |
| HENLEY | 1152820 | 18 December 2006 | Building and construction services (class 37); architectural, engineering, design, drafting and interior design services (class 42) |
|  | 1152818 | 18 December 2006 |
| HENLEY WORLD OF HOMES | 1152819 | 18 December 2006 |
| HENLEY ESSENCE | 1806558 | 2 November 2016 | Building and construction services (class 37); architectural, engineers, design, drafting and interior design services including construction design and construction drafting (class 42) |
| HENLEY RESERVE | 1806561 | 2 November 2016 |
| HENLEY COLLECTION | 1806570 | 2 November 2016 |

14 It will be observed that the registered marks can be classified according to their registration dates. Trade mark 1152818, trade mark 1152819, and trade mark 1152820 (respectively, the **818 mark**, the **819 mark**, and the **820 mark**) were registered with effect from 18 December 2006. Trade mark 1806558, trade mark 1806561, and trade mark 1806570 (respectively, the **558 mark**, the **561 mark**, and the **570 mark**) were registered with effect from 2 November 2016 (together, **the 2016 registered marks**). The significance of this classification is relevant to the application of the appellants’ defence under s 124 of the Trade Marks Act.

15 It will also be observed that, other than the 818 mark, the registered marks are word marks. The 818 mark is a composite mark comprising the words HENLEY and PROPERTIES, represented in a particular stylised form and arrangement with device elements (which the primary judge called the **“HENLEY PROPERTIES” Device Mark**).

16 Henley Constructions is a property developer focussing on the construction of residential unit blocks in and around suburban Sydney. It is also involved in the construction of commercial units and private homes (including home renovations).

17 In conducting its business, Henley Constructions used a number of signs and devices. These include the words HENLEY and HENLEY CONSTRUCTIONS, and the following logos (the **Henley Constructions logos**):

(a) the **first Henley Constructions logo**:



(b) the **second Henley Constructions logo**:



(c) the **third Henley Constructions logo**:



18 Henley Constructions has used other signs and devices, such as:

(a) the domain name henleyconstructions.com.au;

(b) the domain name Henleygallery.com.au;

(c) the name THE HENLEY DISPLAY GALLERY;

(d) the name HENLEY BUILT;

(e) crane signage using the word HENLEY; and

(f) various hashtags in social media, specifically #henleyconstructions, #henleygallery, and #henley.

19 The primary judge found that Henley Constructions’ use of each of the signs and devices noted in [17] and [18] above infringed each of the registered marks. In doing so, he rejected the appellants’ defences to infringement, including those raised by their cross-claim. However, the primary judge was not persuaded that Henley Constructions’ use of the telephone number 1300HENLEY, or its use of number plates incorporating the element HENLY or HNLY, involved trade mark use.

# THE PRIMARY JUDGE’S REASONS

20 The primary judge published comprehensive reasons for judgment (1005 paragraphs comprising 289 pages). The following is a summary of those reasons, which provides the necessary context in which to understand the issues raised in this appeal.

## The evidence

21 After making some introductory remarks (including identifying the registered marks and other marks used by the respondent), the primary judge surveyed the evidence adduced by the respondent (at J[17] – [176]) and the evidence adduced by the appellants (at J[177] – [351]). His Honour made a number of important findings in respect of the adoption of the name HENLEY CONSTRUCTIONS.

22 The thrust of the evidence given by Mr Sarkis and his wife, Vanessa Sarkis, was that “in or around June or July 2006” or “on or around 10 September 2006” (the evidence given by Mr Sarkis and Mrs Sarkis varied in this detail), Mr Sarkis and Mrs Sarkis discussed Mr Sarkis’s ambition to own a construction company that would become Australia’s biggest builder and developer. Mrs Sarkis offered to come up with some company names for the soon-to-be established company that was to fulfil this ambition.

23 After initially coming up with a large list of names, Mrs Sarkis arrived at a shortened, handwritten list comprising:

(a) “Belcorp D’s/C’s”;

(b) “Henley D’s/C’s”;

(c) “Cordell D’s/C’s”;

(d) “Meridian C’s”;

(e) “Walford C’s/D’s”;

(f) “Bel C’s”; and

(g) “Denoble D’s/C’s”.

24 It is not in dispute that the reference to “D’s” in the list was to “Developments” and the reference to “C’s” was to “Constructions”.

25 Mrs Sarkis gave evidence as to how she arrived at these names. The primary judge did not accept the truthfulness of that evidence. It is not necessary to descend to the detail of the primary judge’s findings with respect to Mrs Sarkis’s choice of names other than for “Henley D’s/C’s”. It is sufficient to record that, on all the evidence, the primary judge was satisfied that, in 2006, Mrs Sarkis conducted Google searches of names already used in the construction industry and then assessed if adding the words “Developments” or “Constructions” meant that they were available names to register as company names with the Australian Securities and Investments Commission (**ASIC**).

26 Mr Sarkis gave evidence that he did not undertake any research of who his competition was likely to be in the building industry. However, after canvassing and considering the views of others, he decided to select “Henley Constructions” as the name for his company.

27 Paragraph 30 of Henley Constructions’ Amended Defence alleged that Mr Sarkis’s chose the corporate name “Henley Constructions Pty Ltd” in good faith. The particulars to that paragraph stated:

Mr Sarkis chose the name “Henley Constructions” due to his pre-existing fondness of the male name “Henley”. This fondness includes the fact that Mr Sarkis has mentioned to his wife prior to the Selection Date that if they had a son he would like to call him “Henley Joseph Sarkis”.

28 In cross-examination, Mr Sarkis said that he did not provide those instructions to his solicitors. The primary judge noted, however, that Mr Sarkis’s solicitor, Lance Scott, gave evidence that Mr Sarkis did provide those instructions. The primary judge commented that the discrepancy between Mr Sarkis’s evidence and Mr Scott’s evidence, in this regard, was not explained and that the particulars to paragraph 30 of Henley Constructions’ Amended Defence were unreliable.

29 Mrs Sarkis’s evidence was that she had first heard of the name “Henley” in mid-2006 when watching an American reality television show in which one of the participant’s sisters was named “Henley”. She said that she subsequently conducted a Google search of the name and found that it was of English origin, meaning “high meadow”.

30 At J[265], the primary judge found:

265 Mrs Sarkis, under cross-examination, denied making an internet search of the name “Henley Properties” in 2006. Mrs Sarkis denied that, in her searches to find a building company name, she came across the name “Henley Properties” and the website www.henley.com.au. Mrs Sarkis denied ever undertaking a Google search of the name “Henley” alone. Mrs Sarkis agreed that she would have searched on Google for “Henley Constructions”.

31 In cross-examination, Mrs Sarkis denied that, in her searches to find a company name, she came across the name “Henley Properties” and the henley.com.au website.

32 At J[319], the primary judge found:

319 I do not accept Mrs Sarkis’s denial that she did not come across the name Henley Properties and the henley.com.au website when searching the internet to find a building company name. Mrs Sarkis gave evidence that she conducted Google searches of the name “Henley Constructions”. Mrs Sarkis said that she did not remember conducting a Google search for the word “Henley” on its own. Mrs Sarkis said that she would have searched on Google for “Henley Constructions”. That critical fact was not deposed to in her affidavit nor *viva voce* evidence in chief. Mrs Sarkis said that she searched on Google for “Henley name meaning” and “Henley Constructions” but she did not recall typing the word “Henley” into Google by itself. Mrs Sarkis also denied seeing the henley.com.au website. I do not accept this evidence of Mrs Sarkis. The cross-examination below is instructive:

So if you go to page 2498 [of the Court Book, being part of annexure “LNS-6” to the affidavit of Lance Newman Scott affirmed 9 May 2019], this is a search here, a particular search, but it’s a search for any website which has the word Henley in it, [and] any website which has the word homes or building or marketing. Do you see that?---I do. Yes.

Yes. And obviously, homes and marketing are not very aligned to the word constructions, but you agree that building is aligned to the word constructions?---Yes. I agree. It’s similar. Yes.

Yes. And I put to you that if you have put in a search for Henley Constructions, you would have got a result very similar to what we see at [page] 2499 [of the Court Book], which is at the second position. This is a worldwide search:

*Display home Victoria Henley home Henley Properties Group.*

And I put it to you that’s exactly what happened in November 2006. Do you agree with that?---Sorry. Can you repeat that question?

I put it to you that in November 2006, you would have seen a search result like this when searching for Henley Constructions. I put it to you you did get a search result similar to this when you searched for Henley Constructions on Google, which came up with the second link, which is – there’s a yellow highlight on part of it:

*Display home Victoria Henley home Henley Properties Group Victoria.*

You see that?---Yes. I can see that. Yes.

And I put it to you when you put together this list, you saw that on Google searching?--- No, because I don’t remember ever seeing that.

And I put to you that you clicked on that link and you went to a website which looks very much like the website at page 2506 [of the Court Book]?---I’m just going there now.

Yes?--- I’ve never seen that.

I put to you that you thought that Henley was a good name, but you knew that Henley was being used, for example, as Henley Properties Group on this website. So you did an ASIC search, saw that Henley Developments and Henley Constructions Proprietary Limited were not in use, and so you put in on your list; you agree with that?---No.

33 Having considered other aspects of Mrs Sarkis’s evidence in cross-examination, the primary judge found:

320 I find on the evidence that Mrs Sarkis, when she conducted a Google search in 2006 for the name “Henley Constructions”, would have seen the second position listing of the Henley Properties Group’s website. I find that, at the relevant time in 2006, Mrs Sarkis found the website www.henley.com.au and knew that the name “Henley” was being used by Henley Properties Group who operated a business in Victoria, South Australia and Queensland in respect of building and constructing homes. I find that Mrs Sarkis then conducted an ASIC search and saw that the names “Henley Developments” and “Henley Constructions” were available to be registered. Mrs Sarkis then put the name “Henley D’s/C’s” on the shortlist.

34 At J[323], the primary judge also found:

323 I find that Mrs Sarkis conducted a Google search in 2006 and found the Henley Properties Group website, www.henley.com.au, and told Mr Sarkis about the Henley Properties Group website. Mrs Sarkis conceded in cross-examination that she did search Henley Constructions in Google, and Google searches conducted in 2006 show that a Google search of “Henley” with any of “homes”, “building” or “marketing” retrieved the www.henley.com.au website as the second listed search result. In these circumstances, it should be inferred that, when Mrs Sarkis searched “Henley Constructions” in 2006 (which Mrs Sarkis has conceded she did in fact do), Mrs Sarkis came across the Henley Properties Group website.

35 With respect to Mr Sarkis’s evidence, the primary judge found:

339 In light of the findings made above, I find that, by December 2006, Mr Sarkis had knowledge of the business of Henley Arch and its use of the names “Henley Properties Group” and “Henley”. Mr Sarkis had that knowledge because Mrs Sarkis had informed him that she had conducted Google searches and ascertained the existence of Henley Arch’s website www.henley.com.au and the use of the names “Henley Properties Group” and “Henley”. I find that Mr Sarkis had knowledge of Henley Arch’s use of “Henley Properties Group” and “Henley” prior to the incorporation of Henley Constructions Pty Ltd on 13 December 2006 and had been informed by Mrs Sarkis that the names “Henley Constructions” and “Henley Developments” were available to be registered on the ASIC register. I find Mr Sarkis, with that knowledge, had Mr Murabak obtain registration of both those names for the benefit of the first respondent.

36 Having surveyed the evidence, the primary judge turned to consider the respondent’s case on trade mark infringement.

## The case on trade mark infringement

37 The respondent produced a **Particulars Table** which identified the signs which Henley Constructions allegedly used and which, according to the respondent, infringed its registered trade marks: see J[354]. Conspicuously, the Particulars Table did not identify, in respect of each sign, the registered mark alleged to have been infringed. It appears, however, that the respondent’s case was that each of the registered marks (listed in [13] above) was infringed by each particularised act. The Particulars Table is reproduced in Schedule A to these reasons.

38 Although admitting that Henley Constructions had used the sign HENLEY CONSTRUCTIONS as a trade mark, the appellants disputed that Henley Constructions had used the other signs as trade marks for building and construction services.

39 One of the allegedly infringing signs was 1300HENLEY. The primary judge was not persuaded that this sign was used by Henley Constructions as a trade mark. His Honour held:

455 The display of the phone word “1300HENLEY” is a contact number, rather than a brand. This is because it provides a method by which persons can contact Henley Constructions. In the context in which it is used, I do not accept that consumers would view this as a brand or a badge of origin.

40 The respondent also alleged that various number-plates used by Henley Constructions—such as 01-HNLY, 05-HNLY, and 12-HNLY —infringed the registered marks. Once again, the primary judge was not persuaded that these signs were used by Henley Constructions as trade marks. His Honour held:

456 With respect to the licence plates, in my view, a consumer would not view a number plate as projecting a brand or a badge of origin. If anything, a consumer would view a number plate as a way of identifying a vehicle. I am not persuaded that the use of “HENLY” or “HNLY” on a number plate entailed trade mark use.

41 However, subject to these exceptions, the primary judge was persuaded that Henley Constructions had used the other signs (referenced in the Particulars Table) as trade marks for its building and construction services in a manner that infringed each of the respondent’s “relevant registered trade marks” under s 120(1) of the Trade Marks Act. The primary judge referred to these as **Infringing Signs**.

42 On the question of trade mark comparison, the appellants admitted that the sign HENLEY was substantially identical with the 820 mark (HENLEY). They denied, however, that the sign HENLEY CONSTRUCTIONS was substantially identicalwith the 820 mark (HENLEY) or the 818 mark (the “HENLEY PROPERTIES” Device Mark). The primary judge found to the contrary: J[470].

43 The primary judge found that the sign HENLEY CONSTRUCTIONS was also deceptively similar to the 818 mark (the “HENLEY PROPERTIES” Device Mark): J[479]. His Honour said that the same reasoning applied to the comparison between each of the signs “#henley constructions” and “henleyconstructions.com.au”: J[479]

44 The primary judge found that each of the other Infringing Signs was deceptively similar to the 818 mark (the HENLEY PROPERTIES Device Mark): J[480].

45 The primary judge found, further, that each of the other Infringing Signs was deceptively similar to each of the other registered marks—namely, the 819 mark (HENLEY WORLD OF HOMES) (J[482] – [485]), the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION) (J[486] – 489]).

## Claims under the ACL and the Trade Practices Act

46 The primary judge then turned to consider the respondent’s case on misleading or deceptive conduct and false or misleading representations. The respondent’s case was that Henley Constructions’ conduct in promoting itself using the signs HENLEY CONSTRUCTIONS and HENLEY (including as part of signs that incorporate one or both of those names) was misleading or deceptive in contravention of s 18 of the ACL and constituted the making of representations in contravention of ss 29(1)(g) and 29(1)(h). The respondent also relied on the corresponding provisions of the Trade Practices Act (ss 52, 53(c) and 53(d)) in relation to Henley Constructions’ conduct up to the commencement of the ACL. It is convenient to refer to the claims under the ACL and the Trade Practices Act as, simply, the **ACL claim**.

47 The respondent contended that the date for assessing its reputation—which was central to its case in this regard—was February 2007, when Henley Constructions commenced using its name on invoices. The respondent contended, alternatively, that the relevant date was February 2017.

48 The respondent’s case was that, at both dates, it had a significant reputation throughout Australia in the HENLEY brand in respect of building and construction services.

49 The appellants accepted that at relevant times the respondent had a significant reputation in the HENLEY brand in at least Victoria in respect of the building and construction of single detached houses and townhouses. They contended, however, that this reputation did not extend to building homes in New South Wales and did not extend to the construction of multi-dwelling residential apartments.

50 Moreover, the appellants contended that the relevant date for assessing Henley Constructions’ conduct was December 2006, when Henley Constructions entered into a contract with a development company to build a multi-dwelling apartment block in Camperdown located in inner-Western Sydney.

51 The primary judge was satisfied that Henley Constructions commenced using its name in February 2007, as the respondent had contended. His Honour was satisfied that there was no earlier use by Henley Constructions of the sign HENLEY CONSTRUCTIONS as a trade mark in respect of building and construction services.

52 The primary judge was also satisfied that, after Henley Constructions was put on notice of the respondent’s claims by a letter dated 13 April 2017 (see J[59]), Henley Constructions “ramped up” its marketing and promotion using the sign HENLEY CONSTRUCTIONS including by enlarging the word HENLEY and by reducing the size of the descriptive word CONSTRUCTIONS.

53 The primary judge rejected the appellants’ submission that the respondent’s reputation did not extend to building homes in New South Wales and did not extend to the construction of multi-dwelling residential apartments. The primary judge found that the respondent had a significant reputation throughout Victoria, Queensland and South Australia, which extended into New South Wales. His Honour also found that this reputation was not limited to single dwelling detached homes but extended to multi-dwelling residential townhouses or, more generally, to the respondent as a builder of homes.

54 The primary judge also rejected the appellants’ submission that the Australian building industry is State and Territory based, and not national.

55 Further, the primary judge did not accept the appellants’ submission that the respondent’s reputation was limited such that Henley Constructions’ use of the sign HENLEY CONSTRUCTIONS in relation to the construction of multi-dwelling residential apartment building would not lead to confusion. In this connection, the primary judge was not persuaded, on the evidence, that the relevant class of the public would understand and appreciate the differences in construction between detached single dwelling homes, townhouses and multi-dwelling residential apartment buildings.

56 As to Henley Constructions’ conduct, the primary judge found that, between February 2007 and February 2017, Henley Constructions used HENLEY CONSTRUCTIONS and HENLEY, including as part of signage, in a “sporadic and limited fashion”. From around February 2017, Henley Constructions used HENLEY CONSTRUCTIONS and HENLEY in “an increasing manner”. The primary judge accepted that, from February 2017, Henley Constructions sought to promote itself to a broader section of the public by escalating its marketing activity and by expanding the channels through which it advertised, including by way of social media platforms.

57 In making those findings, the primary judge accepted that Henley Constructions had used the trade indicia particularised in the Particulars Table, on a number of the occasions identified in the table. The primary judge was satisfied that Henley Constructions had represented that:

(a) it was the respondent;

(b) it was affiliated with the respondent;

(c) it was sponsored or approved by the respondent;

(d) its services were provided by, or with the licence or authority of, the respondent;

(e) its services were affiliated with the respondent; and/or

(f) its services were sponsored or approved by the respondent.

58 The primary judge noted his understanding that there was no dispute that, if made, these representations were false. His Honour observed that, in any event, it was obvious that those representations, if made, were false.

59 In light of his findings, the primary judge found that Henley Constructions had contravened ss 18, 29(g), and 29(h) of the ACL and, at relevant times before the commencement of the ACL, ss 52, 53(c), and 53(d) of the Trade Practices Act.

## The trade mark defences

60 The appellants contended that Henley Constructions had a defence under s 122(1)(fa) of the Trade Marks Act to the respondent’s claims of infringement.

61 Section 122(1)(fa) provides:

(1) In spite of section 120, a person does not infringe a registered trade mark when:

…

(fa) both:

(i) the person uses a trade mark that is substantially identical with, or deceptively similar to, the first-mentioned trade mark; and

(ii) the court is of the opinion that the person would obtain registration of the substantially identical or deceptively similar trade mark in his or her name if the person were to apply for it; …

62 In essence, the appellants contended that Henley Constructions was entitled to registration of the sign HENLEY CONSTRUCTIONS as a trade mark in respect of building and construction services or, alternatively, in respect of building and construction services relating to multi-dwelling residential apartments in New South Wales, if it were to apply for that mark. The respondent disputed that entitlement on a number of bases.

63 The primary judge rejected that defence. He did not accept that the appellants had established that Henley Constructions had the right to register HENLEY CONSTRUCTIONS as a trade mark, for the reasons given at J[670] – [716]. There is no appeal against the rejection of that defence.

64 The appellants contended that Henley Constructions also had a defence under s 122(1)(a)(i) of the Trade Marks Act, which provides:

(1) In spite of section 120, a person does not infringe a registered trade mark when:

(a) the person uses in good faith:

(i) the person’s name or the name of the person’s place of business; …

65 The primary judge rejected that defence, for the reasons given at J [747] – [757]. At J [747] – [748], the primary judge said:

747 Henley Constructions cannot succeed in establishing that it, at all times, used the name “Henley Constructions” and occasionally the name “Henley” in good faith as the name of its business: see Amended Defence, particulars to [19] and [34]. This is because, from its very first use on 10 February 2007, Mrs Sarkis, Mr Sarkis and Henley Constructions knew of the existence of Henley Arch’s business which was promoted by use of the website www.henley.com.au and the “HENLEY PROPERTIES” Device Mark in connection with building and construction services. I reject Mr and Mr Sarkis’s and Henley Constructions’ evidence that they did not know of the existence of Henley Arch’s business, its use of the website www.henley.com.au and its use of the “HENLEY PROPERTIES” Device Mark and the “HENLEY” trade mark in connection with the promotion of Henley Arch’s building and construction services.

748 Furthermore, I find, on the evidence, that after being put on notice by Henley Arch’s cease and desist letter on 13 April 2017, Henley Constructions “ramped up” its promotional activity of the mark “HENLEY CONSTRUCTIONS” and, in a new logo, increased the size of the dominant word “Henley” and reduced the size of the descriptive word “Constructions” such that it became more likely that consumers would be confused in this regard.

66 There is no appeal against the rejection of that defence.

67 The appellants also relied on the “prior use” defence provided by s 124 of the Trade Marks Act:

**124 Prior use of identical trade mark etc.**

(1) A person does not infringe a registered trade mark by using an unregistered trade mark that is substantially identical with, or deceptively similar to, the registered trade mark in relation to:

(a) goods similar to goods (***registered******goods***) in respect of which the trade mark is registered; or

(b) services closely related to registered goods; or

(c) services similar to services (***registered******services***) in respect of which the trade mark is registered; or

(d) goods closely related to registered services;

if the person, or the person and the person's predecessor in title, have continuously used in the course of trade the unregistered trade mark in relation to those goods or services from a time before:

(e) the date of registration of the registered trade mark; or

(f) the registered owner of the registered trade mark, or a predecessor in title, or a person who was a registered user of the trade mark under the repealed Act, first used the trade mark;

whichever is earlier.

Note 1: For ***deceptively similar*** see section 10.

Note 2: For ***predecessor in title*** and ***date of registration*** see section 6.

(2) If the unregistered trade mark has continuously been used only in a particular area of Australia, subsection (1) applies only to the use of the trade mark by the person in that area.

68 This defence was limited to the claims of infringement of the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION), being the marks registered with effect from 2 November 2016. The primary judge noted that the appellants made no claim of prior use by Henley Constructions of HENLEY, alone, as a trade mark given that the appellants had denied that Henley Constructions had, in fact, used HENLEY as a trade mark.

69 The primary judge was satisfied that Henley Constructions had used HENLEY CONSTRUCTIONS in relation to services that were similar to, or the same as, the services in respect of which the 2016 registered marks were registered. He was also satisfied that Henley Constructions had continuously used the mark HENLEY CONSTRUCTIONS in relation to those services before 2 November 2016. However, the primary judge was not satisfied that Henley Constructions had used HENLEY CONSTRUCTIONS before the respondent “first used the trade mark”: s 124(1)(f). It is clear that, here, the primary judge considered the “trade mark” for the purposes of s 124(1)(f) of the Trade Marks Act to be HENLEY, not HENLEY ESSENCE, HENLEY RESERVE, or HENLEY COLLECTION.

70 In reaching a conclusion, the primary judge called in aid s 7(1) of the Trade Marks Act, which provides:

(1) If the Registrar or a prescribed court, having regard to the circumstances of a particular case, thinks fit, the Registrar or the court may decide that a person has used a trade mark if it is established that the person has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark.

Note: For ***prescribed court*** see section 190.

71 At J[768] – [770], the primary judge reasoned:

768 In this respect, the priority date for the “HENLEY” registered mark is 18 December 2006. Henley Arch has continuously used the “HENLEY” registered mark at least since that date. As I have already stated above, in my view, each of the 2016 registered marks is dominated visually by the word “Henley”, it being the first and distinctive word in the mark followed by a descriptive term such as “Collection” being descriptive of building and construction services such as a collection of homes. Henley with the descriptive term “Reserve” refers to building and construction services which are special. Henley with the descriptive term “Essence” refers to the essence or essential building and construction services. In other words, each of the 2016 registered marks predominantly uses the dominant memorable feature, being the word “Henley” alone, with the addition of a formal, descriptive word. The use of the 2016 registered marks, in my view, constitutes use of “HENLEY” with an addition or alteration that does not substantially affect the identity of the trade mark “HENLEY”. In my view, “HENLEY COLLECTION”, “HENLEY RESERVE” and “HENLEY ESSENCE” are use of the trade mark, “HENLEY”.

769 In these circumstances, I do not accept that Henley Constructions has used the “HENLEY CONSTRUCTIONS” mark before “the registered owner of the registered trade mark … first used the trade mark”: TMA, s 124(1)(e). This is because Henley Constructions did not use the “HENLEY CONSTRUCTIONS” mark before the priority date for Henley Arch’s “HENLEY” mark and, for the reasons stated above, pursuant to s 7(1) of the TMA, Henley Arch’s use of the 2016 registered marks is use of the “HENLEY” registered mark.

770 As a consequence, I am not satisfied that Henley Constructions has established a defence under s 124 of the TMA.

72 In relation to this defence the respondent contended that, in any event, as at 2 November 2016, Henley Constructions had not used a number of the signs referenced in the Particulars Table—specifically:

(a) the second Henley Constructions logo;

(b) 1300HENLEY;

(c) the third Henley Constructions logo;

(d) THE HENLEY DISPLAY GALLERY;

(e) henleygallery.com.au;

(f) HNLY; or

(g) the crane signage particularised as reference I in the Particulars Table.

73 The primary judge referred to these signs as the **Post-November 2016 Signs**.

74 The primary judge concluded that, as at 2 November 2016, Henley Constructions had not used the Post-November 2016 Signs and that the “prior use” defence in s 124 of the Trade Marks Act was not available to Henley Constructions in respect of those signs.

## The cross-claim

75 Henley Constructions claimed that the registration of the 820 mark (HENLEY) should be cancelled under s 88(1)(a) of the Trade Marks Act. The claim was based on two grounds: first, as at 18 December 2006, the 820 mark was not capable of distinguishing the respondent’s services in respect of which the mark was registered (see s 41); and second, the Registrar had accepted the application for registration of the mark on the basis of a representation that was false in material particulars (see s 62(b)).

76 Henley Constructions also claimed that the 820 mark had not been used in New South Wales in the period 7 October 2015 to 7 October 2018 and that its registration should be made subject to two limitations, expressed as: (a) “Registration does not cover the State of New South Wales”; and (b) in respect of the class 37 services in respect of which the mark was registered, “none of the above being in relation to multi-dwelling residential apartment buildings”.

77 Henley Constructions claimed, further, that the 818 mark (the “HENLEY PROPERTIES” Device Mark) had not been used in Australia, or alternatively New South Wales, and should be removed from the Register or, if not removed, the registration should be made subject to the two limitations sought for the 820 mark.

### Cancellation

78 Section 41 of the Trade Marks Act, as in force as at the date of registration of the 820 mark, provided:

**41 Trade mark not distinguishing applicant’s goods or services**

(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For ***applicant*** and ***predecessor in title*** see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant’s goods or services in respect of which the trade mark is sought to be registered (***designated goods or services***) from the goods or services of other persons.

Note: For ***goods of a person*** and ***services of a person*** see section 6.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

(a) the Registrar is to consider whether, because of the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant’s goods or services from the goods or services of other persons; and

(c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant’s goods or services from the goods or services of other persons.

Note 1: For ***goods of a person*** and ***services of a person*** see section 6.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

(6) If the Registrar finds that the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

(b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

(b) the time of production of goods or of the rendering of services.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

79 The primary judge found that there was nothing inherently distinctive about the sign HENLEY in relation to building and construction services. Indeed, at J[824] he found that HENLEY was, without more, a “non-distinctive mark”. Nevertheless, the primary judge was satisfied that, as at 18 December 2006, the mark had the capacity to distinguish the building and construction services provided by the respondent and was registrable on the basis provided by s 41(5) of the Trade Marks Act in its then form. The primary judge went further and, on the basis of the evidence as to the respondent’s use of HENLEY in various forms, found that, as at 18 December 2006, HENLEY had, in fact, become distinctive of the building and construction services provided by the respondent such that the requirement of s 41(6) of the Trade Marks Act, in its then form, was satisfied. Therefore, this aspect of Henley Constructions’ challenge failed.

80 Section 62(b) of the Trade Marks Act provides:

The registration of a trade mark may be opposed on any of the following grounds:

…

(b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

81 Henley Constructions submitted that, in order to overcome an objection that the 820 mark was not registrable because of s 41 of the Trade Marks Act in its then form, the respondent filed written submissions and a declaration from one of its officers, Janine Armstrong. Henley Constructions submitted that these documents falsely represented that the respondent had engaged in national use of the HENLEY mark and that it intended to expand that use, at a time when, in fact, the respondent had a branding strategy for each State market. For New South Wales, that strategy was to operate under the EDGEWATER brand. Henley Constructions contended that these allegedly false representations were material to the Registrar’s decision to accept the application for registration, and caused acceptance to occur.

82 The primary judge was not satisfied, on the evidence, that the statements made in the written submissions and the declaration conveyed the alleged representations. The primary judge said that the evidence on this issue was “simply inadequate to make any findings”.

83 The primary judge also found that the objection failed on the question of causation. There was no evidence upon which a finding could be made as to what information the Registrar relied upon in accepting the application for registration.

84 Therefore, this aspect of Henley Constructions’ challenge also failed.

### Removal for non-use

85 Relevantly, s 92 of the Trade Marks Act provides:

(1) Subject to subsection (3), a person may apply to the Registrar to have a trade mark that is or may be registered removed from the Register.

(2) The application:

(a) must be in accordance with the regulations; and

(b) may be made in respect of any or all of the goods and/or services in respect of which the trade mark may be, or is, registered.

(3) An application may not be made to the Registrar under subsection (1) if an action concerning the trade mark is pending in a prescribed court, but the person may apply to the court for an order directing the Registrar to remove the trade mark from the Register.

Note: For ***prescribed court*** see section 190.

(4) An application under subsection (1) or (3) (***non-use application*** ) may be made on either or both of the following grounds, and on no other grounds:

(a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:

(i) to use the trade mark in Australia; or

(ii) to authorise the use of the trade mark in Australia; or

(iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods and/or services to which the non-use application relates and that the registered owner:

(iv) has not used the trade mark in Australia; or

(v) has not used the trade mark in good faith in Australia;

in relation to those goods and/or services at any time before the period of one month ending on the day on which the non-use application is filed;

(b) that the trade mark has remained registered for a continuous period of 3 years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner:

(i) used the trade mark in Australia; or

(ii) used the trade mark in good faith in Australia;

in relation to the goods and/or services to which the application relates.

Note 1: For ***file*** and ***month*** see section 6.

Note 2: If non-use of a trade mark has been established in a particular place or export market, then instead of the trade mark being removed from the Register, conditions or limitations may be imposed under section 102 on the registration of the trade mark so that its registration does not extend to that place or export market.

Note 3: For when the registration of a trade mark is taken to have effect, see sections 72 and 239A.

…

86 The primary judge found that the respondent had established, on the balance of probabilities, that it had used the 820 mark in good faith, including in New South Wales, in respect of the registered services in the claimed non-use period.

87 Further, the primary judge was not persuaded that a limitation should be imposed on the specification of the class 37 services, as sought by the appellants. In this regard, the primary judge was persuaded that there was not a meaningful distinction between, on the one hand, building and construction services and, on the other hand, building and construction services in respect of multi-dwelling residential apartments.

88 In any event, the primary judge was satisfied that the respondent had, in fact, used the 820 mark in respect of multi-dwelling residential apartments. His Honour also said that, even if he had not been persuaded of that fact, he would have been persuaded to exercise the discretion under s 101(3) of the Trade Marks Act not to remove the mark from the Register.

89 As to the 818 mark (the “HENLEY PROPERTIES” Device Mark), the primary judge reasoned (at J[954]) that “a total impression of similarity emerges” from a comparison between the 818 mark and the 2005 Henley Devices. He reasoned, further, that the only relevant difference between the 818 mark and the 2005 Henley Devices was that the 818 mark included the word PROPERTIES in smaller font encased by a rectangular bar.

90 The primary judge then considered whether the respondent’s use of the 2005 Henley Devices was use of the 818 mark with additions or alterations that did not affect the identity of the 818 mark: see s 7(1) of the Trade Marks Act. He answered that question in the respondent’s favour and found that the respondent’s use of the 2005 Henley Devices was use of the 818 mark. This led the primary judge to conclude that the respondent had used the 818 mark in the claimed non-use period.

91 However, the primary judge also stated that “if that position be doubted”, he would exercise the discretion under s 101(3) of the Trade Marks Act not to remove or partially remove the 818 mark from the Register.

## Ancillary liability

92 The primary judge found that Mr Sarkis was liable as a joint tortfeasor for Henley Constructions’ trade mark infringements and for aiding and abetting, or being knowingly concerned, directly or indirectly, in Henley Constructions’ contraventions of the ACL.

## Relief

93 It is only necessary to refer to one aspect of the primary judge’s consideration of the appropriate relief. In the course of final submissions, the primary judge ordered that the question of whether there should be an account of profits be dealt with separately and after all other relief in the proceeding had been determined. Accordingly, the primary judge did not consider that question further in his reasons for judgment. We observe, however, that, on 5 November 2021, the primary judge ordered the parties to provide proposed minutes of orders to give effect to his reasons for judgment, including a timetable for the steps required for a hearing on the relief sought by the respondent for an account of profits. On 25 November 2021, his Honour ordered that there be an account of profits made by the appellants by reason of their infringement of the respondent’s registered marks.

# OVERVIEW OF THE APPEAL AND THE CROSS-APPEAL

94 The appellants do not seek to challenge a number of the primary judge’s findings and conclusions. They nevertheless contend that the primary judge erred in finding that Henley Constructions infringed the registered marks (**Grounds 1 and 2**).

95 Specifically, the appellants contend that the primary judge erred in:

(a) failing to find that the registration of the 820 mark (HENLEY) is invalid on the ground that the mark is not capable of distinguishing the respondent’s services, and, consequently, in failing to cancel that registration (**Grounds 1, 3, 4 and 5**);

(b) finding that Henley Constructions’ unregistered word mark HENLEY CONSTRUCTIONS is substantially identical to the 818 mark (the “HENLEY PROPERTIES” Device Mark (**Ground 7**);

(c) finding that each of certain signs and devices used by Henley Constructions—namely, HENLEY CONSTRUCTIONS; the Henley Constructions logos; henleyconstructions.com.au; THE HENLEY DISPLAY GALLERY; the crane signage; various hashtags (not #henley); Henleygallery.com.au; and HENLEY BUILT—are deceptively similar to each of the registered marks (leaving aside the HENLEY word mark) (**Ground 8**);

(d) finding that Henley Constructions had used certain signs and devices—namely, the hashtags; henleyconstructions.com.au, HENLEY; THE HENLEY DISPLAY GALLERY; Henleygallery.com.au; and HENLEY BUILT—as trade marks in respect of the designated services (**Ground 9**);

(e) finding, in relation to the defence under s 124 of the Trade Marks Act, that Henley Constructions’ word mark HENLEY CONSTRUCTIONS and the first Henley Constructions logo were not used prior to the respondent’s use of the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION) (**Ground 10**); and

(f) finding, in relation to the defence under s 124 of the Trade Marks Act, that the second Henley Constructions logo, the third Henley Constructions logo, and certain crane signage, were not used prior to the respondent’s use of the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION) (**Ground 11**).

96 The appellants also contend that the primary judge erred in finding that a consumer of building and construction services is likely to be led into error, and be misled into the belief, that Henley Constructions is affiliated, sponsored, approved, or licensed by the respondent, such as to constitute a contravention of ss 18, 29(g), and 29(h) of the ACL, and at relevant times before the commencement of the ACL, ss 52, 53(c), and 53(d) of the Trade Practices Act (**Ground 12**).

97 The appellants also contend that the primary judge erred in directing that the question of an account of profits be dealt with separately, and after all other relief in the proceeding has been determined (**Ground 13**), and in granting injunctive relief in the form his Honour did (**Grounds 14 and 15**).

98 For completeness, we record that the appellants do not press Ground 6 of the notice of appeal.

99 As noted, the respondent cross-appeals on the single ground that the primary judge erred in finding that Henley Constructions’ use of 1300HENLEY was not trade mark use. The respondent contends that the primary judge should have found that Henley Constructions’ use of 1300HENLEY infringed each of the registered trade marks, and that this use also contravened the Trade Practices Act and the ACL. The respondent contends, further, that the primary judge should have found that Mr Sarkis is jointly liable with Henley Constructions for these infringements, and as an accessory in relation to the contraventions.

100 As also noted, by its notice of contention, the respondent seeks to support the primary judge’s finding concerning the validity of the registration of the 820 mark (HENLEY). The respondent contends that the primary judge was correct to conclude that s 41(5) of the Trade Marks Act (as in force at 18 December 2006) applies to that registration, although not for the reason that his Honour advanced. Further, the respondent contends that, even if the HENLEY word mark is not capable of distinguishing its designated services, the mark should not be removed from the Register on discretionary grounds.

101 The respondent also seeks to support the primary judge’s findings of contravention of the ACL and the Trade Practices Act by contending, in the alternative, that the relevant date for considering Henley Constructions’ conduct is February 2017.

# VALIDITY: THE 820 MARK (HENLEY)

## The appellants’ submissions

102 Grounds 1, 3, 4 and 5 of the notice of appeal are directed to the validity of the 820 mark (HENLEY) gauged by reference to s 41 of the Trade Marks Act as in force at the priority date of 18 December 2006. It is to be remembered that the primary judge found that, at that date, HENLEY had the capacity to distinguish the respondent’s building and construction services, and thus satisfied the requirement of s 41(5) of the Trade Marks Act. However, the primary judge also found that, at that date, HENLEY had, in fact, become distinctive of those services, and thus satisfied the requirement of s 41(6) of the Trade Marks Act. By grounds 1, 3, 4 and 5 of the notice of appeal, the appellants challenge each of those findings.

103 As to the finding in respect of s 41(5), the appellants rely on the primary judge’s finding (at J[810]) that there is nothing inherently distinctive about HENLEY as a trade mark in relation to common services, like building and construction services, and his Honour’s finding (at J[824]) that HENLEY, without more, is a “non-distinctive mark”. These findings were informed by other findings made by the primary judge about the use of HENLEY as a surname and as a geographical name.

104 The appellants submit that, having made these findings, the primary judge erred at J[828] in finding that the requirement of s 41(5) of the Trade Marks Act was satisfied in respect of the respondent’s building and construction services. The appellants submit that the requirement of s 41(5) could only have been met if the primary judge had been satisfied that, at the relevant date, the mark was “to *some extent* inherently adapted to distinguish” the respondent’s services. On his Honour’s findings, this requirement could not be met. They submit that his Honour’s finding to the contrary at J[828] was an “obvious” error. In oral submissions, the appellants referred to this as “a slip”.

105 As to s 41(6), the appellants submit that the primary judge was required to give specific consideration to the extent to which the mark itself (i.e., HENLEY) had been used. The appellants submit that the primary judge’s finding that, at the priority date, HENLEY had become distinctive of the respondent’s building and construction services involved a number of errors.

106 First, the appellants rely on a number of authorities which discuss the cogency of the evidence that is normally required to establish that a descriptive word, such as a geographical name, has become distinctive of the particular source of given goods or services.

107 Secondly, and relatedly, they submit that use of a mark in association with a logo (whether or not as part of a composite mark) will “substantially dilute” the significance of the use of the mark, in contrast to use of the mark without a logo.

108 Thirdly, the appellants refer to that part of J[828] where, after finding that HENLEY had the capacity to distinguish the respondent’s building and construction services, the primary judge said:

828 … It follows that I am satisfied on the evidence that the requirements of s 41(5) of the TMA as at 18 December 2006 have been satisfied and that the “HENLEY” mark has acquired distinctiveness as at the priority date of the building and construction services provided by Henley Arch.

109 The appellants submit that the primary judge’s finding that s 41(5) of the Trade Marks Act was satisfied could not support a finding that s 41(6) was satisfied.

110 Fourthly, the appellants submit that the primary judge’s findings at J[826] – [827] concerning the respondent’s use of HENLEY alone or with additions, and his Honour’s reliance on the findings he made as to the respondent’s use of, and reputation in, the word HENLEY when dealing with the respondent’s ACL claims, reflect error because aspects of these findings were not concerned with the use of HENLEY simpliciter but HENLEY in association with other trade mark elements.

111 In this connection, the appellants submit that the primary judge’s reasons do not “expose” for analysis the uses of HENLEY simpliciter before the priority date. The appellants submit that the Initial Henley Devices and the 2005 Henley Devices contain a device element (in the appellants’ words, “a distinctive triangular logo”) and, in the case of the Initial Henley Devices, additional words (“properties group”, “properties” or “properties group of companies”), which preclude a finding of substantial identity with HENLEY. They submit that the website to which the domain name henley.com.au resolves (when used as part of a URL) features the composite use of logos and words (as described above) which “could not suffice to eclipse the ordinary signification of HENLEY”. The appellants submit, further, that the primary judge’s findings in relation to the ACL claims “provide no illumination”.

112 Fifthly, the appellants submit that mere use of, or reputation in, a descriptive word is not enough to establish acquired distinctiveness for the purposes of s 41(6) of the Trade Marks Act.

## Analysis

113 The primary judge found that, at the priority date, the respondent had extensively used the word HENLEY by itself, in the domain name henley.com.au, and as part of the Initial Henley Devices and the 2005 Henley Devices. His Honour found that the use of HENLEY in conjunction with the device and other word elements of the Initial Henley Devices and the 2005 Henley Devices did not affect the identity of HENLEY in that context and that consumers would identify services sold under those signs by the word HENLEY.

114 In reaching these findings, the primary judge referred to the evidence of the respondent’s reputation which he had discussed when dealing with the claims made against the appellants under the ACL. The respondent’s case in that regard was that, as at February 2007 (the date of first use by Henley Constructions of HENLEY), and also at February 2017, it had a significant reputation throughout Australia in the HENLEY “brand” through its extensive promotion and use of the names HENLEY and HENLEY PROPERTIES in respect of building and construction services.

115 The primary judge also recorded that it was not in dispute that, at all relevant times (meaning, in the context of the ACL claim, as and from February 2007 when Henley Constructions commenced to use HENLEY), the respondent had a significant reputation in HENLEY, at least in Victoria in respect of the building and construction of semi-detached houses and townhouses.

116 The primary judge’s reference to this fact not being in dispute appears to derive from a number of sources.

117 First, in its opening submissions on its cross-claim (by which, amongst other things, it attacked the validity of the 820 mark under s 41 of the Trade Marks Act), Henley Constructions conceded that, due to the respondent’s activities in Victoria, HENLEY was “a known brand in the project home market in Victoria” at the priority date for the 820 mark.

118 Secondly, this concession was confirmed in oral argument during the course of the hearing below, when clarification was sought by the respondent as to what was in issue in the proceeding so far as the respondent’s reputation in HENLEY was concerned. The following exchange took place between the primary judge and counsel for the parties:

MR CORDINER: Your Honour, I raise this other just final matter. Your Honour will recall in my opening that I stressed that we were relying in the main on the reputation within Victoria, that is, the build-up of the reputation in Henley, Henley properties, and etcetera, in Victoria.

HIS HONOUR: Yes.

MR CORDINER: And we took it from last week’s objections hearing that there wasn’t really much debate about the reputation in Victoria. We’ve sought to clarify that with our friends.

HIS HONOUR: Yes.

MR CORDINER: Unfortunately, I don’t think it’s in a satisfactory state in the sense that maybe it’s about adjectives, or was it a significant reputation or not significant reputation, etcetera. Our position is we don’t want to have to tender all the material which supports the existence of a reputation in Victoria which was significant, but if our friends – unfortunately, if they take the position there was not one, then we might have to go through that process. So I will still keep engaging with our friends, but I put your Honour on notice - - -

HIS HONOUR: Yes.

MR CORDINER: - - - that we don’t want to be blamed for having to rely on material to support a reputation when, unfortunately, our friends have put us to that point.

HIS HONOUR: Yes. Let me hear from Mr Hennessy. Mr Hennessy, I must say, last week at least when I was dealing with objections as to evidence, I must say that what I took out of what had transpired between the bench and the bar table was that it was accepted that Henley had a reputation in Victoria for residential homes, and a significant reputation, and what’s really at issue here is what, if any, reputation do they have elsewhere.

MR HENNESSY: Well - - -

HIS HONOUR: Am I right in that?

MR HENNESSY: That’s correct. That’s what I’ve taken out of it.

HIS HONOUR: Good.

MR HENNESSY: So I’ve got – I must plead ignorance about what dispute there is that’s going on.

HIS HONOUR: Well, it doesn’t sound like there is a dispute anymore, Mr Hennessy.

MR HENNESSY: From our – it’s news to me. And it may be that there’s some adjective in correspondence that has been the subject of a dispute, but you would have seen – your Honour would have seen, including from our written submissions, references to it’s not in – I think to this effect. It’s not in dispute that it’s a known brand.

HIS HONOUR: Well, I thought a lot of what your cross-examination was directed to this morning was to that very point.

MR HENNESSY: Exactly.

119 Thirdly, in its written closing submissions, Henley Constructions said (with reference to its opening submissions on its cross-claim):

As Henley Constructions has repeatedly made plain there is no issue about the fact that Henley Arch has acquired a reputation in the brand “Henley” in Victoria. At issue is whether it has a reputation in that brand in other [S]tates, most relevantly NSW.

120 Notwithstanding its acceptance that the respondent had acquired a reputation in the HENLEY “brand” at the priority date of the 820 mark, Henley Constructions argued before the primary judge that the respondent’s reputation in the “brand” was limited in that the reputation did not extend to building homes in New South Wales (as indicated by the above quotation), and it did not extend to the construction of multi-dwelling residential apartment buildings. This was the true area of contest, not whether the respondent had a reputation (which, in oral argument before the primary judge, the appellants accepted was a significant reputation) in the HENLEY “brand” in respect of building and construction services at the relevant time.

121 The primary judge rejected the submission that the respondent’s reputation in HENLEY in respect of building and construction services was geographically limited (as Henley Constructions had contended) and found that the respondent had a significant reputation throughout Victoria, Queensland and South Australia, which extended into New South Wales.

122 The primary judge also found that the respondent’s reputation was not limited to single dwelling detached homes but extended to multi-dwelling residential townhouses and, more generally, to the respondent as a builder of homes.

123 Further, the primary judge was not persuaded, on the evidence, that the relevant class of the public would understand and appreciate, in any event, the difference between the construction of detached single dwelling homes, townhouses and multi-dwelling residential apartment buildings.

124 Although the concession to which we have referred was not specifically mentioned in J[826], [827] and [829] of the primary judge’s reasons, his Honour’s findings in respect of the ACL aspect of the respondent’s claim, particularly as to its reputation, were referred to. We are in no doubt that those findings were of considerable importance to his Honour’s consideration of the question of whether, at the priority date of the 820 mark, HENLEY did, in fact, distinguish the respondent’s building and construction services from the building and construction services of other traders. But, his Honour’s findings on the respondent’s reputation in HENLEY in relation to building and construction services were not based simply on the concession. The primary judge’s findings were based on his Honour’s consideration of the totality of the evidence on this subject.

125 A fair reading of the primary judge’s reasons shows, clearly, that his Honour firmly had in mind the principles by which a sign is adjudged to be capable of distinguishing goods and services for the purposes of s 41 of the Trade Marks Act, particularly where the sign comprises an arguably descriptive word, including a geographical name. This is manifest from his Honour’s extensive quotations from *Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd* [2017] FCAFC 56 at [236]; *Colorado Group Ltd v Strandbags Group Pty Ltd* [2007] FCAFC 184; 164 FCR 506 (***Colorado***) at [128]; and *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* [2018] FCA 235; 129 IPR 482 at [92] – [93], and, his recourse to illustrative examples from *Colorado*, *Blount Inc v Registrar of Trade Marks* [1998] FCA 440; 83 FCR 50; *Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd* [2010] FCA 1367; 191 FCR 297; *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511; and *Oxford University Press v Registrar of Trade Marks* (1990) FCR 1.

126 A fair reading of the primary judge’s reasons also shows, clearly, that the primary judge firmly had in mind Henley Constructions’ submissions on this question. The primary judge recorded these submissions at length, noting in particular Henley Constructions’ submission that HENLEY lacked inherent distinctiveness in relation to common services, like building and construction services, because (a) HENLEY (and its variant HENLY) was a surname or a component of a surname used by substantial number of people; (b) HENLEY was also a geographical location; and (c) people with surnames containing or consisting of HENLEY or HENLY may reasonably want to use those names to describe their services, and traders from a geographical location called HENLEY may want to refer to that location as the place from which their services emanate or the location at which those services are provided.

127 We note, however, that, in relation to the name HENLEY as a geographical location, the primary judge was not satisfied that the evidence supported Henley Constructions’ contention that consumers associated, or would associate, the name HENLEY with particular localities. As the primary judge correctly observed at J[805], when considering whether a geographical name has, for trade mark purposes, the capacity to distinguish a trader’s goods or services, the focus is the ordinary signification of the name in question. In other words, is the name, according to its ordinary meaning, understood as a geographical name? See, for example, the treatment of the name COLORADO in *Colorado* at [128]. A geographical name does not assume significance for trade mark purposes “simply because some place upon the earth’s surface has been called by it”: *In Re The Magnolia Metal Company’s Trade Marks* [1897] 2 Ch 371 at 393.

128 Further, a fair reading of the primary judge’s reasons shows, clearly, that the primary judge firmly had in mind Henley Constructions’ submission that, at the priority date of the 820 mark, HENLEY had not *acquired* distinctiveness, in the sense of distinguishing the respondent’s services from the services of other traders.

129 We accept that the primary judge’s reliance on s 41(5) of the Trade Marks Act—to find that the HENLEY mark had the capacity to distinguish the respondent’s building and construction services—was an error, having regard to his Honour’s earlier finding at J[810] that HENLEY is not inherently distinctive. Given the primary judge’s finding at J[810], it is, with respect, also difficult to follow his Honour’s chain of reasoning in J[828] (quoted above) in which, with reference to s 41(5) of the Trade Marks Act, he expressed his satisfaction that HENLEY *had* acquired distinctiveness at the priority date.

130 However, when regard is had to J[829], we are satisfied that the primary judge gave separate attention and consideration to s 41(6) of the Trade Marks Act and the question of whether, as at the priority date of the 820 mark, HENLEY had in fact become distinctive of the respondent’s building and construction services. To be clear, we are not persuaded that the primary judge’s finding in relation to s 41(6) was reached on the basis that satisfaction of the requirement of s 41(5) meant that the requirement of s 41(6) was also met.

131 Further, we are satisfied that the primary judge’s finding in relation to s 41(6) was directed to the correct question, which was not merely about reputation, but about the designation of trade source. This is signified by his Honour’s specific reference to the following passage in Lockhart J’s judgment in *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* (1991) 30 FCR 326 at 336, which his Honour quoted in part at J[829] when expressing his ultimate conclusion that, at the priority date of the 820 mark, HENLEY had in fact become distinctive of the respondent’s building and construction services:

Distinctive means distinctive in the sense that the mark distinguishes the registered proprietor’s goods from others of the same type in that market, though it does not mean that the goods must specifically identify the plaintiff as the source of those goods. Often the identity of the supplier will be unknown, but what is important is that a significant number of consumers in the relevant market identify the plaintiff’s goods as coming from one trade source.

132 It is beyond question that when, in the context of s 41(6), the primary judge referred to the respondent’s reputation in HENLEY, he was referring to reputation in the sense of designating the particular trade source of given services—here, the respondent’s building and construction services.

133 We do not accept that the primary judge’s finding in relation to the satisfaction of s 41(6) was affected by error because his Honour took account of the respondent’s use of HENLEY with device elements and other words, as well as the respondent’s use of HENLEY alone.

134 Here, the primary judge accepted the respondent’s submission, based on s 7(1) of the Trade Marks Act, that its use of the Initial Henley Devices and the Henley 2005 Devices in relation to building and construction services was also a use of the 820 mark—that is, a use that did not substantially affect the identity of HENLEY, itself, as a trade mark in respect of those services.

135 It is to be noted that the 820 mark is, simply, the word HENLEY, unconfined by any particular form of graphical representation or other limitation. The registration of the 820 mark conferred on the respondent a monopoly in the trade mark use of the name HENLEY in relation to the services for which it was registered. This monopoly extended to the trade mark use of the name in particular stylistic renderings, including in association with device elements and other words.

136 The primary judge’s point was that, even when used in the context of the Initial Henley Devices and the 2005 Henley Devices, the word HENLEY was *the* sign by which consumers would identify the respondent’s services. In other words, as a matter of substance, these uses were simply exemplifications of the use of HENLEY itself which, before the priority date, contributed to the acquisition of distinctiveness of the name HENLEY as the source of the respondent’s building and construction services at the priority date.

137 In submissions, the appellants argued for a different outcome by seeking to distinguish the Initial Henley Devices and the 2005 Henley Devices by a process of reasoning that (a) relied on the primary judge’s finding that HENLEY was not inherently distinctive, and (b) gave prominence to other aspects of the Initial Henley Devices and the 2005 Henley Devices, such as the triangular device and, in the case of the Initial Henley Devices, the words PROPERTIES GROUP, PROPERTIES GROUP OF BUILDERS, and PROPERTIES. The endeavour in this argument was to shift attention from the word HENLEY and to place emphasis on these other elements so as to subsume the name HENLEY within them, and destroy its separate identity when so used.

138 The appellants contended, in particular, that the word PROPERTIES was of some significance because, contrary to the primary judge’s finding at J[479], the word PROPERTIES does not signify building and construction services. On the appellants’ argument, the word PROPERTIES, as used in various forms in the Initial Henley Devices, imparts some special quality which sets apart the Initial Henley Devices from use of the word HENLEY itself.

139 We are not persuaded by this argument because it ignores the context in which the respondent used the Initial Henley Devices—namely, building and construction services—and, hence, leaves out an important integer of the factual inquiry with respect to the acquisition of distinctiveness for the purposes of s 41(6). The word “properties” is a general word whose particular meaning will be informed by, and gain colour from, the context in which it is used. In the present case, that context was the respondent’s provision of building and construction services. Seen in that context, “properties” conforms to an understanding of those services. Indeed, one iteration of the Initial Henley Devices expressly draws that connection in the collocation PROPERTIES GROUP OF BUILDERS. Thus, rather than setting apart the Initial Henley Devices, the word PROPERTIES was, in use, simply descriptive of the services in relation to which the respondent used HENLEY as a trade mark, albeit in conjunction with other elements, to designate the trade source of those services.

140 We are not persuaded that the primary judge’s reliance on the use of HENLEY in the context of the Initial Henley Devices and the 2005 Henley Devices is affected by error. We are satisfied that it was open to the primary judge to find that these were instances of the use of HENLEY as a trade mark, based on s 7(1) of the Trade Marks Act. Specifically, we are not persuaded that, in the context of the provision of building and construction services before the priority date of the 820 mark, the use of the triangular device and/or the word “properties” in association with HENLEY, as exemplified by the Initial Henley Devices and the 2005 Henley Devices, substantially affected the identify of HENLEY, as a trade mark, in respect of those services.

141 Similarly, we are not persuaded that the primary judge erred in his reliance on the respondent’s use of the domain name henley.com.au as also a use of the sign HENLEY as a trade mark before the priority date with additions or alterations that do not substantially affect the identity of that mark.

142 We add that, to the extent that the appellants’ submissions call into question the extent of the respondent’s use of HENLEY, alone, as a trade mark before the priority date of the 820 mark, we were taken, in the course of oral argument, to many examples where the respondent had used HENLEY frequently (and, it would seem, routinely) as a trade mark in relation to its services. We do not accept the appellants’ submission that the primary judge’s finding—that HENLEY, simpliciter, was used extensively by the respondent before the priority date—is not supported by the evidence.

143 For these reasons, we are not persuaded that the primary judge erred in finding that the 820 mark (HENLEY) satisfied s 41(6)(a) of the Trade Marks Act at its priority date.

144 Therefore, Grounds 1, 3, 4 and 5 of the notice of appeal succeed only to the extent that, based on his earlier findings, the primary judge erred in concluding that s 41(5) was satisfied. Notwithstanding that limited success, the primary judge did not err in finding the 820 mark as having been validly registered. This is because the primary judge did not err in finding that s 41(6)(a) was satisfied at the priority date.

## The notice of contention

145 By its notice of contention, the respondent seeks to support the validity of the 820 mark on the basis that the requirement of s 41(5) of the Trade Marks Act was satisfied at the priority date (Grounds 1 and 2). The respondent also seeks to make a contention as to how the discretion in s 88 of the Trade Marks Act should be exercised should we come to the view that the requirements of s 41 were not satisfied in relation to the registration of that mark (Ground 3).

146 Given our conclusion that the primary judge did not err in finding that s 41(6) was satisfied at the priority date, and that Grounds 1, 3, 4 and 5 of the notice of appeal succeed only to a limited extent, these contentions do not arise for determination.

# INFRINGEMENT: THE 818 MARK (THE “HENLEY PROPERTIES” DEVICE MARK)

## The appellants’ submissions

147 The primary judge found (at J[473]) that HENLEY CONSTRUCTIONS and the 818 mark (the “HENLEY PROPERTIES” Device Mark) were substantially identical marks. Ground 7 of the notice of appeal challenges this finding.

148 The substance of the appellants’ submission is that, in reaching his conclusion, the primary judge misapplied the test stated by Windeyer J in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 (***Shell***) at 414:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison … Whether there is substantial identity is a question of fact.

149 The appellants submit that the essential elements of the 818 mark include the triangular device and the inclusion of the word PROPERTIES rendered in “block shading”. The appellants submit that these elements are absent from the word mark HENLEY CONSTRUCTIONS, with the consequence that the two marks cannot be substantially identical.

## Analysis

150 We are conscious that the comparison which the primary judge undertook was an aural and visual comparison that involved judicial estimation. Minds may well differ on such a comparison and, where they do, this difference does not necessarily mean that the primary judge’s comparison is affected by error. We accept that an appellate court should give due weight and respect to a primary judge’s evaluative assessment, and should exercise caution in reversing such an assessment: *Optical 88 Ltd v Optical 88 Pty Ltd* [2011] FCAFC 130; 197 FCR 67 at [25] – [39]; *Energy Beverages LLC v Cantarella Bros Pty Ltd* [2023] FCAFC 44 at [158] – [160].

151 Nevertheless, we are persuaded that, when determining the question of trade mark infringement, it was not reasonably open to the primary judge to find that, on a side by side comparison, the sign HENLEY CONSTRUCTIONS, as a word mark, is substantially identical to the 818 mark (the “HENLEY PROPERTIES” Device Mark).

152 In undertaking this comparison, it is necessary to remember that the 818 mark is not simply the word HENLEY: cf the 820 mark. It is a composite mark involving word and device elements in a particular arrangement and stylistic rendering: see [13] above. The monopoly conferred by registration is limited accordingly. This limitation must be recognised.

153 Although the word component HENLEY is present in both marks, and is certainly a prominent feature of both, an overall impression of identity between the two does not emerge. Mere resemblance between HENLEY CONSTRUCTIONS and the particular sign that is the 818 mark—based only on the presence of the word HENLEY—is not enough to establish substantial identity between the two. Bearing in mind the limitations of the registration of the 818 mark, this relative lack of identity between the two signs persuades us that the primary judge misapplied the trade mark test for determining whether two marks are substantially identical.

154 Ground 7 of the notice of appeal succeeds. We note, however, that the primary judge also found that HENLEY CONSTRUCTIONS was deceptively similar to the 818 mark. Although not expressed as such, we understand this to be an alternative finding by the primary judge in respect of the infringement of that mark. The appellants’ challenge to the primary judge’s finding of deceptive similarity is part of Ground 8 of the notice of appeal.

# INFRINGEMENT: VARIOUS MARKS AND THE ISSUE OF DECEPTIVE SIMILARITY

## The appellants’ submissions

155 Ground 8 of the notice of appeal challenges the primary judge’s general finding at J[478] that the Infringing Signs used by Henley Constructions as trade marks were deceptively similar to each of the respondent’s registered marks.

156 Relevantly to this ground of appeal, the Infringing Signs are:

(a) HENLEY CONSTRUCTIONS and the Henley Constructions logos;

(b) the domain name henleyconstructions.com.au;

(c) the domain name Henleygallery.com.au;

(d) the name THE HENLEY DISPLAY GALLERY;

(e) the name HENLEY BUILT;

(f) crane signage using the word Henley; and

(g) various hashtags in social media, specifically #henleyconstructions and #henleygallery.

157 This ground involves multiple trade mark comparisons. However, a number of the appellants’ submissions were broadly-based contentions, a number of which were applicable to all, or at least a number, of the comparisons under challenge. The appellants’ submissions may be summarised as follows.

158 First, the appellants submit that while all the marks possess the common element HENLEY, they also possess other elements. The Infringing Signs possess elements which are not possessed by the registered marks.

159 Secondly, the appellants submit that the word HENLEY is a purely descriptive word.

160 Thirdly, in relation to the comparison of HENLEY CONSTRUCTIONS with the 818 mark (the “HENLEY PROPERTIES” Device Mark), the appellants submit that an imperfect recollection of the 818 mark “would not attribute primary attention to the descriptive HENLEY”. The appellants submit that the logo in the 818 mark is distinctive and is apt to be remembered along with the word PROPERTIES. The appellants submit that both these elements are missing from the sign HENLEY CONSTRUCTIONS. The appellants submit, further, that the 818 mark and HENLEY CONSTRUCTIONS comprise or include ordinary English words. As such, there is no reason to conclude that any single word in the marks is more prominent than any other word.

161 Fourthly, the appellants submit that, in comparing the other Infringing Signs with the 818 mark, the primary judge erred in finding that the HENLEY component of those signs was, alone, their key memorable feature. The appellants submit, further, that, in undertaking this comparison, the primary judge relied, erroneously, on an imperfect recollection of the other Infringing Signs, not on an imperfect recollection of the 818 mark.

162 Fifthly, in relation to these comparisons, the appellants submit that the primary judge erred in in reasoning (at J[481]) that the word HENLEY, as the name of various localities, was not “so prominent” that these localities possessed “commonality in the eyes of consumers”. In this connection, the primary judge noted that he was not referred to any evidence to support the contention that consumers associate the word HENLEY with these localities, although his Honour accepted that traders (as distinct from consumers) in these localities may wish to use HENLEY as a name for their services. The appellants submit that the “descriptiveness of Henley obviated any need” for the evidence to which the primary judge referred. The appellants also submit that the primary judge erred in regarding as relevant the manner in which the respondent used the 818 mark.

163 Sixthly, the appellants submit that the primary judge erred in finding that HENLEY was the distinctive element of the 819 mark (HENLEY WORLD OF HOMES), the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION), in circumstances where, in their submission, HENLEY is purely descriptive. The appellants submit that the other words of these marks are no less memorable than HENLEY.

164 Seventhly, the appellants submit that, in determining whether the Infringing Signs were deceptively similar to the 818 mark, the 819 mark, the 558 mark, and the 561 mark, the primary judge erred in failing to consider these marks and the Infringing Signs “as wholes”.

## Analysis

165 We will deal with each of the appellants’ submissions in the order summarised above.

166 As to the first submission, it may be accepted that the compared marks display differences in detail. This does not mean, however, that the primary judge’s findings on deceptive similarity bespeak error for that reason. The primary judge’s findings, in this part of his reasons, were not that the compared marks are substantially identical, let alone that they are the same marks. In a case where the question of infringement is to be determined by recourse to the notion of deceptive similarity, it is to be expected that there will be differences between the compared marks. The question is whether, notwithstanding these differences, an impugned mark is deceptively similar to the registered mark, in the sense that the impugned mark so nearly resembles the registered mark that it is likely to deceive or cause confusion: see s 10 of the Trade Marks Act. Therefore, we do not see the appellants’ first submission as advancing this ground of appeal in any material way.

167 As to the second submission, we proceed on the basis of the primary judge’s finding that, at the priority date of the 820 mark, HENLEY was not inherently distinctive as a trade mark (J[810]) but was, nevertheless, distinctive in fact of the respondent’s building and construction services (J[829]). These findings were highly relevant to the validity of the 820 mark. They are not, however, germane to the question of trade mark infringement and, in particular, to the assessment of deceptive similarity. Therefore, we do not see the appellants’ second submission as advancing this ground of appeal in any material way.

168 The appellants’ third, fourth and fifth submissions concern the primary judge’s comparison of the Infringing Signs with the 818 mark (the “HENLEY PROPERTIES” Device Mark).

169 The appellants’ third submission concerns the primary judge’s particular comparison of the sign HENLEY CONSTRUCTIONS with the 818 mark and his Honour’s finding that HENLEY CONSTRUCTIONS was deceptively similar to that mark. In substance, this submission simply invites the Full Court to undertake its own comparison and to substitute a finding of lack of deceptive similarity for the primary judge’s own view. As we have noted, the registration of the 818 mark is limited in various respects: [152] above. It is also important to bear in mind that the issue is, as we have said, deceptive similarity.

170 In this regard, we observe that the primary judge’s comparison correctly took into account the fact that the 818 mark includes the triangular device and the word PROPERTIES. However, his Honour reasoned that, in the 818 mark, the component HENLEY is “emphasised considerably” and that the component PROPERTIES, which is in smaller font underneath the HENLEY component, is descriptive of building and construction services. We see no error in this approach to determining the issues of deceptive similarity or his Honour’s analysis. We would not, therefore, interfere with the primary judge’s evaluative conclusion.

171 The appellants’ fourth and fifth submissions concern the primary judge’s comparison of the other Infringing Signs with the 818 mark. In relation to these comparisons, the primary judge accepted that the word HENLEY was a common surname and a geographic location in Sydney, and part of the name of other geographic locations in South Australia and Western Australia. His Honour accepted that traders in those locations may wish to use HENLEY as a name for their services. However, his Honour did not accept that persons viewing the 818 mark or the Infringing Signs would associate those signs with the particular localities referred to by the appellants.

172 We do not accept the appellants’ fourth submission that, in undertaking these comparisons, the primary judge misapplied the test of imperfect recollection. We take the primary judge’s reference at J[480] to the word HENLEY being the “key memorable feature” of the other Infringing Signs as no more than a finding concerning the dominance of HENLEY in each of them. The primary judge’s finding at J[480] must be considered in the context of his Honour’s reasons at J[481], where he continued, and elaborated on, his comparisons of these marks. At J[481], the primary judge said:

481 … in my view, the impression, based on recollection, of the “HENLEY PROPERTIES” Device Mark, that persons of ordinary intelligence and memory would have, is that [the respondent] is a building company. I believe such persons would be left with the same impression on viewing Henley Constructions’ signs. This flows in particular from both entities using the word “Henley” and similar words for similar services, being “properties” and “constructions”. …

173 This quotation shows that his Honour’s comparisons involved the correct application of the doctrine of imperfect recollection—namely, an imperfect recollection of the mark in suit (here, the 818 mark) and the impressions of persons on viewing the impugned mark(s): *Optical 88 Ltd v Optical 88 Pty Ltd (No 2)* [2010] FCA 1380; 275 ALR 526 (***Optical 88***) at [112]. Other, related parts of the primary judge’s reasons (see J[482] – [485]) show that his Honour was applying the doctrine of imperfect recollection correctly in relation to the recollection of the respondent’s registered marks.

174 The appellants’ fifth submission also concerns J[481] of the primary judge’s reasons and, again, focuses on what the appellants contend is the descriptiveness of HENLEY within the context of the 818 mark. Here, the primary judge was not dealing with the validity of the 818 mark, but only with the question of whether the 818 mark was infringed by Henley Constructions’ use of the other Infringing Signs. Once again, the issue was deceptive similarity. The primary judge did not accept that consumers would associate the component HENLEY, as it appears in the 818 mark, with the localities to which the appellants referred. This finding was open to the primary judge. We are not persuaded that his Honour erred in reaching those findings.

175 Further, we do not accept the appellants’ submission that, in undertaking these comparisons, the primary judge took into account the manner in which the respondent actually used the 818 mark. As shown by the above quotation, the primary judge’s comparisons were based on the imperfect recollection of the 818 mark, not the respondent’s actual use of that mark.

176 The appellants’ sixth and seventh submissions concern the primary judge’s comparison of the Infringing Signs with the 819 mark (HENLEY WORLD OF HOMES), the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), and the 570 mark (HENLEY COLLECTION).

177 The appellants’ sixth submission is, in substance, a reiteration of its contention that the word HENLEY, when appearing in the respondent’s registered marks, is simply a descriptive element of no particular significance when undertaking a comparison of the Infringing Signs to the registered marks for the purpose of considering the question of deceptive similarity.

178 The primary judge considered these comparisons at J[482] – [489]. In these paragraphs, his Honour explained his conclusions on the question of deceptive similarity by reference to his finding that the “dominant memorable feature” of the 819 mark, the 558 mark, the 561 mark, and the 570 mark, is the word HENLEY and that the Infringing Signs have the same feature either alone or with additions that do not distinguish them in a way that would remove the likelihood of confusion: see at J[485] and [487]. These findings were open to the primary judge. We are not persuaded that his Honour erred in reaching those findings.

179 As to the appellants’ seventh submission, we do not accept that, in undertaking his comparisons of these marks, the primary judge failed to compare the relevant marks “as wholes”. His Honour’s reasons show, clearly, that he did not err as the appellants contend.

180 As a general observation, we note that, correctly, the primary judge undertook his trade mark comparisons by reference to the services for which the respondent’s marks were registered and Henley Constructions’ corresponding use of the impugned signs in relation to building and construction services.

181 For these reasons, Ground 8 of the notice of appeal does not succeed.

# INFRINGEMENT: VARIOUS MARKS AND TRADE MARK USE

## The appellants’ submissions

182 The primary judge’s findings that the Infringing Signs were deceptively similar to the respondent’s registered trade marks were made in the context of his earlier finding at J[457] that Henley Constructions had used the Infringing Signs as trade marks. Ground 9 of the notice of appeal challenges this earlier finding.

183 The appellants submit that, in determining whether a sign was used as a trade mark, the primary judge should have observed whether the “display” of the sign served the purpose of indicating a connection in the course of trade with the appellants’ services from the perspective of a relevant consumer observing the sign in the setting in which it is presented: *Shell* at 425. The appellants’ emphasised that this means the *whole* setting in which the sign is presented.

184 The appellants contend that the primary judge erred in not considering the whole setting in which each of the Infringing Signs appeared to the relevant consumer. They contend that, rather, the primary judge observed each of the Infringing Signs in isolation. They contend that, when the whole setting is considered, it ought to be found that each of the Infringing Signs has not been used by Henley Constructions as a trade mark. The appellants’ submissions did not descend to greater particularity on this aspect of the appeal.

185 Under this ground of appeal, the appellants also advance a particular challenge to the primary judge’s finding in relation to Henley Constructions’ use of HENLEY on crane signage. They contend that the primary judge erred in finding that HENLEY had been used on crane signage when (in the appellants’ submission) HENLEY CONSTRUCTIONS was used.

## Analysis

186 The primary judge’s particular findings on trade mark use with respect to the Infringing Signs are found at J[458] – [465]. We observe that these findings were preceded by a detailed summary of the respondent’s submissions on trade mark use with reference to the Particulars Table (J[356] – [369]) and a detailed summary of Henley Constructions’ submissions on the same issues (J[391] – [403]). His Honour’s findings on trade mark use were also preceded by a consideration of relevant case authorities on what constitutes trade mark use: J[433] – [438]. It is not suggested that the primary judge did not correctly identify the relevant legal principles on this question.

187 The primary judge considered it to be uncontroversial that the Infringing Signs were used as trade marks in the provision of building and construction services. He noted, however, that Henley Constructions had admitted trade mark use only in respect of the HENLEY CONSTRUCTIONS sign.

188 The primary judge’s findings commenced with the general observation (at J[460]) that each of the Infringing Signs had been used in relation to either the provision of Henley Constructions’ building and construction services or the promotion of Henley Constructions’ building and construction services in a manner which would lead a person viewing these signs to identify them as badges of origin of those services. The primary judge also expressed his agreement with the respondent’s submissions on this topic.

189 The primary judge then proceeded to make a number of specific findings at J[461]. It is not necessary for us to summarise these findings. They do show, however, that the primary judge did, in fact, consider the Infringing Signs in the context in which they were used and was satisfied that they were used by Henley Constructions as branding for its building and construction services.

190 We are not persuaded, therefore, that, in arriving at his findings and overall conclusion on trade mark use, the primary judge did not have regard to the context in which each of the Infringing Signs was used. Indeed, a fair reading of the primary judge’s reasons shows, persuasively, the contrary to be the case.

191 In the course of oral submissions, we were invited to reconsider the primary judge’s findings on trade mark use by reference to the uses identified in the Particulars Table. We have done so, bearing in mind our conclusion that the primary judge did not err in his understanding of the legal principles to be applied. We are not persuaded that there is any proper basis on which we should interfere with the primary judge’s findings on this issue.

192 As to the crane signage, a number of images were tendered which appeared to show the mark HENLEY simpliciter on Henley Constructions’ cranes. In cross-examination Mr Sarkis insisted that the word CONSTRUCTIONS also appeared in the images, presumably to suggest that the signs on the cranes were, in fact, HENLEY CONSTRUCTIONS and not HENLEY.

193 Mr Sarkis was challenged with the proposition that, in fact, the word CONSTRUCTIONS did not appear with HENLEY. He maintained his position. At J[461(8)], the primary judge found that HENLEY was, in fact, fixed to the cranes and was used as a trade mark. It is tolerably clear that the primary judge rejected Mr Sarkis’s evidence on the presence of the word CONSTRUCTIONS, at least in conjunction with HENLEY.

194 We have viewed the images. In some of them, it is possible that the word CONSTRUCTIONS appears faintly in reverse lettering, thereby indicating the possibility that the word CONSTRUCTIONS was used on a different part of the crane. However, even if that be so, the images still show the use of HENLEY not in immediate association with the word CONSTRUCTIONS. We are not persuaded, therefore, that the primary judge erred in finding that HENLEY was affixed to Henley Constructions’ cranes, and used as a trade mark.

195 Even if it be assumed that HENLEY CONSTRUCTIONS was used as part of the crane signage, contrary to the primary judge’s finding, this would not lead to a different outcome on trade mark infringement in relation to the 820 mark because the appellants accept that HENLEY CONSTRUCTIONS, as a trade mark, is deceptively similar to HENLEY and, for the reasons given above, we are not persuaded that the primary judge erred in finding that the 820 mark was validly registered.

196 For these reasons, Ground 9 of the notice of appeal does not succeed.

# INFRINGEMENT: THE PRIOR USE DEFENCE

## The appellants’ submissions

197 Grounds 10 and 11 of the notice of appeal concern the appellants’ unsuccessful prior use defence. This defence relates to the infringement of the 2016 registered marks—specifically, the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE) and the 570 mark (HENLEY COLLECTION), all of which have the priority date of 2 November 2016.

198 The appellants contend that Henley Constructions used the HENLEY CONSTRUCTIONS mark and the first Henley Constructions logo before 2 November 2016, and that this “ought to have set the basis of a prior use defence” under s 124 of the Trade Marks Act.

199 It will be recalled that the primary judge found (at J[767]) that the respondent had first used HENLEY as a trade mark, before Henley Constructions had used HENLEY CONSTRUCTIONS as a trade mark. The primary judge reasoned as follows:

(a) The respondent had used HENLEY as a trade mark continuously since 18 December 2006 (the date of registration of the 820 mark (HENLEY)).

(b) The “dominant memorable feature” of the 2016 registered marks is the word HENLEY, with the other words used in the marks (respectively, ESSENCE, RESERVE, and COLLECTION) functioning as merely descriptive terms.

(c) The use of each of the 2016 registered marks was a use of HENLEY with an addition or alteration that does not affect the identity of the marks as HENLEY.

(d) In other words, the use of HENLEY COLLECTION, HENLEY RESERVE, and HENLEY ESSENCE was use of HENLEY as a trade mark pursuant to s 7(1).

(e) Henley Constructions had not used the HENLEY CONSTRUCTIONS mark before the date of registration of the 820 mark (HENLEY).

(f) Accordingly, the date in s 124(1)(e) applies when determining whether the defence is available, namely 18 December 2006.

(g) Henley Constructions had not used the HENLEY CONSTRUCTIONS mark before that date.

200 This reasoning led the primary judge to conclude, at J[770], that Henley Constructions had not established a defence under s 124 of the Trade Marks Act.

201 The appellants contend that, in effect, the primary judge made a finding that the respondent’s use of HENLEY was a use of each of the 2016 registered marks.

202 The appellants further contend that the primary judge erred in finding that the second Henley Constructions logo, the third Henley Constructions logo and the crane signage (depicted in row I of the Particulars Table) were not used before the priority date of the 2016 registered marks.

203 In this connection, the appellants contend that the second Henley Constructions logo and the third Henley Constructions logo were merely the first Henley Constructions logo with additions or alterations that do not substantially affect the identity of the first Henley Constructions logo. So considered, the use of all three logos should be attributed to the earliest use of the first Henley Constructions logo. The appellants contend, therefore, that the primary judge should have found that the prior use defence applied to the use of the HENLEY CONSTRUCTIONS mark, and all the Henley Constructions logos.

204 The appellants made no separate submission in respect of Henley Constructions’ use of the crane signage, although Ground 11 specifically refers to such signage. The particulars to Ground 11 include particular (b):

The primary judge erred in finding that HENLEY (solus) was affixed to a crane as opposed to signage including the word CONSTRUCTIONS appearing under HENLEY and in doing so made a finding of fact that was not open on the evidence or which was against the evidence or without regard to the whole evidence ….

## Analysis

205 We are satisfied that the primary judge erred in concluding that the s 124 defence does not apply to the infringements of the 2016 registered marks by Henley Constructions’ use of the HENLEY CONSTRUCTIONS mark.

206 The primary judge’s finding at J[768] that the use of the 2016 registered marks constituted use of the HENLEY mark (with additions or alterations that do not substantially affect the identity of HENLEY as a mark), was not the inquiry which s 124 demanded. Section 124 directs attention to the registered mark that is alleged to have been infringed. It asks the question whether the alleged infringer used the alleged infringing mark before the date of registration of the registered mark or the date of first use of that mark (whichever is earlier). Henley Constructions was not raising the s 124 defence in respect of the alleged infringement of the 820 mark (HENLEY), but in respect of the alleged infringements of the 558 mark, the 561 mark, and the 570 mark, respectively. The starting point for the primary judge should have been the date of registration or first use of each of those marks, not the date of registration or first use of the 820 mark.

207 Can it be said that the respondent’s use of HENLEY was a use of the 558 mark (HENLEY ESSENCE), the 561 mark (HENLEY RESERVE), or the 570 mark (HENLEY COLLECTION)? While each of the 2016 registered marks includes the word HENLEY, each registered mark is more than simply that word. Each mark is a compound mark with a separate identity based on the inseparable presence of ESSENCE, RESERVE, and COLLECTION, respectively. In our view, those additional words are integral to the identity of each registered mark. They are not mere surplusage that can be ignored. Accordingly, we are not persuaded that the respondent’s use of HENLEY was a use of HENLEY ESSENCE, HENLEY RESERVE, or HENLEY COLLECTION for the purpose of considering the s 124 defence.

208 The primary judge noted (at J[761]) that the respondent accepted that the relevant date for considering the s 124 defence is 2 November 2016. His Honour found that Henley Constructions had continuously used the HENLEY CONSTRUCTIONS mark in relation to services for which the 2016 registered marks are registered, including before 2 November 2016. On the basis of that finding, we see no reason why the defence under s 124 of the Trade Marks Act does not apply to Henley Constructions’ use of that mark. The primary judge erred in finding to the contrary.

209 Ground 10 of the notice of appeal also contends, in substance, that the primary judge erred in finding that the first Henley Constructions logo was not used before the date of registration of the 2016 registered marks. However, it does not appear to us that the primary judge made any finding in that regard in relation to the s 124 defence. This may have been because Henley Constructions pleaded no such allegation in its defence: see paragraphs 35 to 39 of the First Respondent’s Amended Defence.

210 That said, the primary judge accepted the respondent’s case on infringement with respect to Henley Constructions’ use of the first Henley Constructions logo, with reference to the Particulars Table. The Particulars Table identifies that the first Henley Constructions logo was used on Henley Constructions’ website from November 2009 to about February 2015 and on signage at various locations from early 2009 to February 2016.

211 While these uses are before the date of registration of the 2016 registered marks, they do not fully address the inquiry mandated by s 124, which is an inquiry as to the continuous use of the impugned mark in the course of trade before the earlier of the date of registration of the registered mark or the date of first use of the registered mark, up to the time of infringement.

212 It is appropriate that we mention, at this point, the respondent’s position that, despite the findings made by the primary judge in relation to the application of the s 124 defence in respect of Henley Constructions’ use of HENLEY CONSTRUCTIONS as a trade mark, the case it advanced at trial in relation to the s 124 defence proceeded on a “narrower basis” and concerned only the Post-November 2016 Signs: see [72] – [73] above. These signs included the second Henley Constructions logo, the third Henley Constructions logo, and the crane signage.

213 At J[771], the primary judge made an alternative finding that, if he was wrong in his principal finding at J[770]—that Henley Constructions had not established a defence under s 124 of the Trade Marks Act—then he would hold that, as at 2 November 2016, Henley Constructions had not used the Post-November 2016 Signs.

214 As we have noted, the appellants challenge this finding by contending that the use of the second Henley Constructions logo and the third Henley Constructions logo were, in substance, use of the first Henley Constructions logo with additions or alterations that do not substantially affect the identity of the first Henley Constructions logo as a trade mark, and that Henley Constructions had used the first Henley Constructions logo before 2 November 2016.

215 The respondent does not contend that this was not an issue before the primary judge. Rather, it contends that s 7(1) of the Trade Marks Act cannot be invoked when applying the prior use defence under s 124 in respect of the use of an unregistered trade mark.

216 In this connection, it submits that s 7(1) provides “guidance” only in respect of registered trade marks. It submits that the Court should take a purposive approach to the construction of s 7(1) and that support for its position is provided by *Optical 88* at [177] and *Urban Alley Brewery Pty Ltd v La Sirene Pty Ltd* [2020] FCA 82; 150 IPR 11 (***Urban Alley***) at [228] – [229].

217 We do not agree that s 7(1) of the Trade Marks Act only applies to the use of registered trade marks and cannot be used in establishing the defence under s 124. In terms, s 7(1) refers to the use of a “trade mark”, not a “registered trade mark”. Both expressions are defined in the Trade Marks Act.

218 A “trade mark” is defined as having the meaning of s 17, which provides:

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.

219 Unquestionably, this definition applies to an unregistered trade mark.

220 A “registered trade mark” is defined in the Trade Marks Act as meaning “a trade mark whose particulars are entered in the Register under this Act”.

221 Plainly, the Trade Marks Act itself draws a distinction between a “trade mark” and a “registered trade mark”, when it is necessary to do so. Section 7(1) draws no such distinction. It simply refers to the use of a “trade mark”. The provision should be given a meaning and application according to its terms. There is no reason why this beneficial provision should be read down by the insertion of qualifying words, or words of limitation, which Parliament itself did not see fit to use.

222 The decisions in *Optical 88* and *Urban Alley* do not compel a different conclusion. There is nothing in the respondent’s citation of *Optical 88* that supports its contention. The respondent’s citation of *Urban Alley* is misplaced. In that case, O’Bryan J did not express the view that s 7(1) has no role to play in the s 124 defence. Rather, his Honour found (at [229]) that s 7(1) did not assist the respondent in that case. His Honour found that, while the word “pale” is descriptive of beer, the removal of that word from the mark URBAN PALE substantially altered the mark.

223 Further, we agree with the appellants’ contention that use of the second Henley Constructions logo and use of the third Henley Constructions logo can be taken as a use of the first Henley Constructions logo with alterations that do not affect the identity of the first Henley Constructions logo as a trade mark.

224 As it does not appear to be in dispute that Henley Constructions used the first Henley Constructions logo before 2 November 2016, and as the only point taken on appeal by the respondent is its argument based on the limits of s 7(1) of the Trade Marks Act (which we have rejected), it follows that, as argued, the defence under s 124 of the Trade Marks Act applies to Henley Constructions’ use of the first Henley Constructions logo, the second Henley Constructions logo, and the third Henley Constructions logo in relation to the infringement by those signs of the 2016 registered marks.

225 The appellants’ position on crane signage is of a different character. According to their notice of appeal, the only issue is whether the primary judge erred in fact in finding that only HENLEY was affixed to Henley Constructions’ cranes.

226 This aspect of Ground 11 of the notice of appeal goes nowhere. First, according to the Particulars Table, the respondent made no case that the HENLEY CONSTRUCTIONS mark, or the Henley Construction logos, were used on crane signage. Further, the primary judge was not persuaded that the HENLEY CONSTRUCTIONS mark was used on the crane signage. Hence no case on infringement was found in this regard.

227 For these reasons, Ground 10 of the notice of appeal succeeds, as does Ground 11 (other than in respect of the crane signage).

# CONTRAVENTIONS OF THE ACL AND TRADE PRACTICES ACT

## The appellants’ submissions

228 Ground 12 of the notice of appeal concerns the primary judge’s findings that Henley Constructions had contravened the ACL and the Trade Practices Act. The appellants contend that his Honour erred in making those findings. They identify three alleged errors.

229 The first alleged error concerns the primary judge’s finding that the respondent had a reputation in the “Henley” brand. The appellants contend that, in making that finding, the primary judge failed to pay regard to the fact that HENLEY had no capacity to distinguish the respondent’s services. According to the appellants, for this reason any use of HENLEY by Henley Constructions, with or without added words or logos, could not be misleading.

230 The second alleged error is that the primary judge erred in finding that the respondent had a sufficient reputation in the name HENLEY as at February 2007 to support his findings of contravention. There are a number of aspects to this part of the appeal.

231 First, the appellants dispute that they made the concession recorded by the primary judge at J[556] concerning the respondent’s reputation in HENLEY.

232 Next, the appellants contend that the primary judge erred in inferring that: (a) there would have been many persons in New South Wales visiting the respondent’s website in the period 2001 to 2002 (J[572]); and (b) the respondent built an additional 182 homes in Victoria for New South Wales customers before 2007 (J[562]). The appellants submit that these findings were based on conjecture only.

233 Finally, the appellants contend that the primary judge erred in finding (at J[574]) that the Australian building industry is national. As to this finding, the appellants dispute that there can be (or could have been) any “spillover” of reputation in a mark, from State to State.

234 The third alleged error is that the primary judge erred in finding at J[599] that the evidence of Mr Boyer was evidence of consumer confusion.

235 In the course of oral submissions in reply, the appellants advanced a new argument, which was not raised by their notice of appeal or advanced in their submissions in chief. They submitted that if there was, in trade or commerce, misleading or deceptive conduct by use of the name HENLEY in relation to Henley Constructions’ building and construction services, it was not Henley Constructions who engaged in the misleading or deceptive conduct, but other actors—specifically, real estate agents. The appellants contend that they are not legally responsible for the misleading or deceptive conduct of third parties.

## Analysis

236 We are not satisfied that the primary judge erred as the appellants contend.

237 As to the first alleged error, the appellants’ contention that the word HENLEY has no capacity to distinguish is a throwback to Henley Constructions’ challenge to the validity of the 820 mark (HENLEY) based on s 41 of the Trade Marks Act. That challenge has failed, for the reasons given above. The primary judge found that, as a trade mark, HENLEY had the capacity to distinguish, based on satisfaction of the requirement of s 41(6)(a) of the Trade Marks Act with respect to factual distinctiveness. Therefore, the appellants’ contention is incorrect. As at 18 December 2006, the HENLEY mark had the capacity to distinguish the respondent’s building and construction services from the building and construction services of other traders.

238 But, more importantly, the question of whether the ACL or the Trade Practices Act were contravened in the ways found by the primary judge is not answered by recourse to the principles of trade mark law with respect to the validity of registered marks. This does not mean, however, that the primary judge’s finding (at J[829])—that the HENLEY mark had in fact become distinctive of the respondent’s building and construction services “in the sense of the mark distinguishes the registered proprietor’s goods from others of the same type in that market”—was not properly informed by his Honour’s factual findings that were reached in the course of considering whether the appellants contravened the ACL and the Trade Practices Act as alleged by the respondent. We therefore reject the appellants’ contention—based, as it is, on trade mark principles—that any use of HENLEY by Henley Constructions, with or without added words or logos, could not be misleading for the purposes of the ACL and the Trade Practices Act.

239 As to the second alleged error, the primary judge’s observation at J[556] was:

It was not in dispute that at all relevant times, [the respondent] has had a significant reputation in its name “Henley”, at least in Victoria in respect of the building and construction of semi-detached houses and townhouses.

240 The tenor of this finding is that the appellants did not dispute before the primary judge the fact that the respondent had a reputation in HENLEY in Victoria in respect of the building and construction of semi-detached houses and townhouses.

241 As we have discussed, in opening submissions, during the hearing, and in closing submissions before the primary judge, the appellants made it perfectly clear that they accepted that the respondent had a reputation—indeed, a “significant” reputation—in Victoria “in residential houses”. Their case was that the respondent’s reputation was not more widespread, geographically.

242 In its closing submissions with respect to its cross-claim, Henley Constructions added a further qualification: not only was the respondent’s reputation in Henley geographically limited, it was a reputation based on use “overwhelmingly in relation to detached and semi-detached house building services”.

243 It will be appreciated that, if anything, the primary judge’s observation at J[556] gave the appellants’ concession a more limited operation by confining it to “semi-detached houses and townhouses” as opposed to “residential houses” or “detached and semi-detached house building services” (the latter being descriptions used by the appellants before the primary judge). We do not think, however, that anything turns on this difference. We do not accept that the primary judge’s observation at J[556] gives rise to any appealable error.

244 With regard to the appellants’ contentions concerning errors in the primary judge’s fact-finding, it is necessary for us to refer, in a little detail, to the evidence, as recorded by the primary judge.

245 Mr Harvey, a co-founder and former director of the respondent, made a number of affidavits. He gave evidence that, since January 1990, the respondent had contracted with persons located throughout Australia to build and/or sell homes in Victoria.

246 In an annexure to his first affidavit, Mr Harvey provided a spreadsheet, the purpose of which was to demonstrate, over an extended period, how many houses located in Victoria had been sold by the respondent to people residing outside Victoria, including New South Wales. Mr Harvey accepted that there were aspects of the spreadsheet that were anomalous. These anomalies were explored in Mr Harvey’s cross-examination.

247 One anomaly related to “Null” entries with respect to the “Settled Date”. As the primary judge explained (at J[36]):

36 ... First, there were entries in the spreadsheet which recorded that the “Settled Date” for a home was “Null”. Mr Harvey explained that these “Null” entries, in his experience with the records of Henley Arch, indicate that there was no settlement date entered into the relevant Henley Arch database, but that did not mean that no settlement occurred. Mr Harvey accepted that these “Null” entries were data entry errors. These errors occurred when a person did not enter the settlement date for the relevant home construction into the database. Mr Harvey accepted that he had not reviewed each of these “Null” entries to identify whether a data entry omission could explain each of them, but Mr Harvey’s experience was that “Null” entries generally indicated that a staff member had omitted to enter the relevant settlement date data into the relevant database.

248 Another anomaly in the spreadsheet was the recording of a settlement date “1 January 1900”. Mr Harvey accepted that this was obviously an error. He was not able to identify the cause of the error.

249 During the trial, the respondent ultimately produced a summary document, which the primary judge reproduced at J[38] and J[561].

250 The primary judge accepted Mr Harvey’s evidence that the respondent builds homes located in Victoria under the names HENLEY and HENLEY PROPERTIES for customers located in New South Wales. With respect to the data shown in the summaries reproduced at J[38] and J[561], the primary judge held (at J[562]):

562 This data shows, and I find, that Henley Arch built at least 54homes in Victoria for customers located in New South Wales prior to 2007. If the homes recorded in the “Null” and “1900” columns are included, Henley Arch built 182 homes in Victoria for New South Wales customers before 2007. There were issues arising in relation to these “Null” and “1900” entries. I have referred to these issues above. While I acknowledge those issues, having heard the evidence of Mr Harvey, I accept that Mr Harvey provided an honest and adequate explanation in relation to them. I do not accept that those issues meant these houses with a corresponding “Null” or “1900” entry were not built by Henley Arch. In my view, the better inference is that there was an issue with the data entered into Henley Arch’s systems in respect of these “Null” and “1900” entries, but those data entry issues did not mean that the relevant houses were not in fact built by Henley Arch.

251 It will be appreciated from J[562] that, having seen and heard Mr Harvey as a witness, the primary judge was satisfied with Mr Harvey’s explanations. The primary judge was also satisfied that they were “data entry issues” which, importantly, did not mean that the houses had not been built by the respondent.

252 We are not persuaded that this finding was not open to the primary judge. His Honour’s finding was not based on mere conjecture. Further, having been satisfied of these facts, the primary judge did not err by taking account of the “Null” and “1900” entries when considering the homes that the respondent had built in Victoria for New South Wales customers before 2007.

253 With regard to the visits to the respondent’s website, Mr Harvey gave evidence that, since around 2003, the respondent has promoted its business and the business of the Henley Properties Group at its website, www.henley.com.au. There was a mobile version of the website, and a desktop version. The respondent has used Google Analytics to track the visits to the site, although this tracking did not occur before 2013.

254 In his first affidavit, Mr Harvey produced the relevant data for desktop website visits and mobile website visits for each year from 2013 to 2018. This data was also broken down on a State by State basis.

255 The primary judge found that, since about 2003, the respondent had marketed the HENLEY “brand”, and its building and construction services, via the website, to consumers throughout Australia and internationally. The primary judge also found that, since about 2003, the respondent promoted its website in its marketing and promotional materials, including brochures.

256 The appellants’ submission concerning website visits focuses on the primary judge’s findings on the website visits by persons in New South Wales. These visits were summarised in a table reproduced at J[56] and J[571]. The primary judge made the following finding about that data (at J[572]):

572 Now, this data concerns a period post-2013. However, it represents a reasonably large number of people each year visiting Henley Arch’s website from New South Wales. Those numbers have been fairly consistent since 2014. It can be inferred that the number of website visitors would have been less than these figures in the period between 2001 and 2007. However, on the basis of this data, I believe it can also be safely inferred, and I find, that there would have been many persons in New South Wales visiting Henley Arch’s website in the period 2001 to 2007. That further supports Henley Arch having a reputation in New South Wales in or around late 2006 and early 2007.

257 It is important to understand the context in which this finding was made. Mr Harvey had also given evidence about the activities of the Henley Properties Group in New South Wales from 1995 to 2018, including by its wholly owned subsidiary, Henley Properties (NSW) Pty Ltd and, later, its wholly owned subsidiary, Edgewater Homes Pty Ltd.

258 At J[563] – [573], the primary judge reviewed the evidence of the respondent’s business activities in New South Wales. His Honour was satisfied that the evidence established that, in New South Wales, the respondent’s business prior to 2005 was “reasonably substantial”. Further, his Honour was satisfied that the data of the respondent’s building activities in New South Wales, taken with the data of persons in New South Wales purchasing homes located in Victoria, ensured that the respondent had a “genuine reputation in New South Wales for home building”: J[568].

259 It was only after making these findings that the primary judge turned to consider the data of desktop website visits and mobile website visits from persons in New South Wales, and the significance of that data.

260 Given the findings that the primary judge had already made, we are not persuaded that it was not open to his Honour to draw the inference, expressed at a somewhat high level of generality, that there would have been “many” persons in New South Wales visiting the respondent’s website in the period 2001 to 2007. Obviously, the primary judge was not prepared to make, and did not purport to make, a more precise finding. Given the data on website visits that his Honour had for the period 2013 to 2018 (which showed yearly visits ranging from 15,646 visits to 33,189 visits), taken with the evidence of the respondent’s business activities in New South Wales in the years preceding 2013 (and, in particular 2001 to 2007), including the promotion of its website, it beggars belief that there would not have been many persons in New South Wales visiting the respondent’s website in the period 2001 to 2007. What is more, the primary judge viewed the website data as merely supporting the existence of a reputation which he had already found to have existed at the relevant time.

261 As to the primary judge’s finding that the building and construction industry in Australia is (and was) a national industry, the appellants did not elaborate, in any detailed way, on why the primary judge erred in reaching his finding. The appellants certainly did not provide a sound basis for why we should interfere with the primary judge’s finding on this issue, as we were invited to do.

262 The primary judge gave detailed consideration to this question at J[575] – [590]. His Honour’s consideration included an analysis of the regulatory framework that governs the building and construction industry in Australia, as well as aspects of the evidence given by Mr Harvey and Mr Tatian. Mr Tatian was a Building Certifier and Building Consultant who was called by the appellants.

263 The primary judge also called in aid the evidence which showed that a number of consumers in New South Wales purchased the respondent’s homes in Victoria, as well as the evidence of persons located in New South Wales accessing the respondent’s website. His Honour considered that this evidence diminished the force of any submission that the construction industry was highly localised or State-based. The primary judge also took into account the normal economic forces of supply and demand.

264 In our view, the primary judge’s finding that the Australian building and construction industry was a national industry was open to him, as was his rejection of the appellants’ contention that that industry was State- and Territory-based.

265 We now turn to Mr Boyer’s evidence. The sole basis on which the appellants contend that the primary judge should not have relied on Mr Boyer’s evidence is that Mr Boyer “had a relationship” with the respondent.

266 To be precise, from July 2006 to May 2017, Mr Boyer was the Commercial Manager in the Melbourne office of James Hardie Australia Pty Ltd (**James Hardie**). Later, he became the Head of Commercial Sales in Australia for Karndean International Pty Ltd (**Karndean**). At the time he made his second affidavit, Mr Boyer had left his employment with Karndean. When Mr Boyer worked at James Hardie, the respondent was a customer of that firm and Mr Boyer personally managed the relationship between the respondent and James Hardie. Further, the respondent was a client of Karndean which Mr Boyer brought to Karndean in 2017 as a result of the relationship he had with the respondent while at James Hardie.

267 When Mr Boyer was at James Hardie he came across an article on the Internet published by “Architecture and Design” titled “Experienced NSW builder keen to repeat AFS LOGICWALL success”. The article referred to Henley Constructions as the experienced builder. Mr Boyer’s evidence was that, when he read the article, he thought that Henley Constructions might be an “offshoot” of the respondent because of the word HENLEY in Henley Constructions’ name. After reading the article, Mr Boyer sent an email to the respondent enquiring whether the Henley Constructions business in Sydney had anything to do with the respondent.

268 The appellants’ contention regarding Mr Boyer’s evidence was directed to J[599] of the primary judge’s reasons, where the primary judge found that the addition of the word CONSTRUCTIONS to Henley Constructions’ name did not serve to distinguish Henley Constructions’ building and construction services from those provided by the respondent. The primary judge said:

599     ... I find that the use of the marks “HENLEY CONSTRUCTIONS” and “Henley” in the various styles does not serve to distinguish the building and construction services provided by Henley Constructions from those of Henley Arch. Indeed, Mr Damian Boyer, a former sales representative of James Hardie, a supplier to Henley Arch, gave evidence that, when he saw the name “Henley Constructions”, this caused him to email Henley Arch to enquire as to whether there was an association. In my view, that provides actual evidence of a well-informed consumer being led into error, or having a tendency to be led into error, by reason of merely reading the name “Henley Constructions”. The error, or tendency to be led into error, was that Mr Boyer entertained the possibility that Henley Constructions was associated with Henley Arch (the subject line of Mr Boyer’s relevant email was: “Guys, does the below business based in Sydney [namely, Henley Constructions,] have anything at all to do with [Henley Arch]?”). Of course, there is no such association.

269 We are not persuaded that the primary judge erred in relying on Mr Boyer’s evidence. The fact that, formerly, Mr Boyer had an arms-length commercial relationship with the respondent through James Hardie and, later, Karndean does not, of itself, diminish the cogency of his evidence as to his perception when seeing Henley Constructions’ name in the article to which he referred, especially when, at J[160], the primary judge accepted Mr Boyer as an honest witness.

270 For these reasons, Ground 12 of the notice of appeal does not succeed.

271 We do not propose to entertain the appellants’ argument that they are not legally responsible for the misleading or deceptive conduct of third parties. This was not part of the appellants’ case before the primary judge, who was not called upon to determine whether part of the conduct on which the respondent relied was the conduct of others, and not the conduct of Henley Constructions, in which Mr Sarkis was involved. As we have already noted, this argument only surfaced in the appellants’ oral submissions in reply.

272 For completeness, we note that, following the hearing of the appeal, the respondent sought the Full Court’s leave to advance, in writing, supplementary submissions on this new argument. The request for leave was accompanied by the supplementary submissions themselves. This was not appropriate. The course taken was, in practical effect, the provision of the supplementary submissions to the Full Court without leave: *Carr v Finance Corporation of Australia Ltd (No 1)* (1981) 147 CLR 246 at 258. In our view, the appropriate course was for the respondent to seek leave, explaining the basis for that application. The supplementary submissions should only have been provided upon the granting of leave, not beforehand. Nevertheless, on 18 May 2022 we granted leave to the respondent to rely on the supplementary submissions. However, given our conclusion that the appellants’ new argument should not be entertained, it is not necessary for us to consider these submissions further.

## The notice of contention

273 By its notice of contention, the respondent seeks to support the primary judge’s findings that Henley Constructions had contravened the ACL and the Trade Practices Act by contending that, if the primary judge erred in his assessment of the respondent’s reputation in the name HENLEY as at February 2007 in respect of the respondent’s supply of building and construction services, then the relevant date for assessing its reputation was February 2017, at which time the respondent held a sufficient reputation to establish its claims in this regard (Ground 4 of the notice of contention).

274 Given our conclusion that Ground 12 of the notice of appeal does not succeed, this contention does not arise for determination.

# RELIEF: ACCOUNT OF PROFITS

## The appellants’ submissions

275 During closing submissions, and after hearing from the parties, the primary judge decided that he would determine the respondent’s claim for an account of profits separately, after he had determined the question of all other relief: J[989]. Ground 13 of the notice of appeal contends that the primary judge erred in making that decision.

276 In this connection, the appellants submit that the trial had been set down on all issues with no separate order for the determination of liability. The parties had tendered evidence during the course of the trial relating to the respondent’s claim for an account of profits. The appellants submit that the respondent’s evidence did not support an order for monetary relief on the basis of an account of profits, or otherwise. The appellants submit that the primary judge provided no reasons for coming to his decision that the question of an account of profits be determined separately.

## Analysis

277 In dealing with this ground of appeal, it is important to bear in mind two matters.

278 The first matter is the circumstances in which the primary judge’s decision came to be made. The prospect that the question of the respondent’s claim for an account of profits should be dealt with separately was raised by the primary judge, not the parties. What is more, it was raised by the primary judge after reflecting on the closing submissions which the respondent had made on the question of pecuniary relief during the previous day of the hearing. The primary judge said that he was “not comfortable” in dealing with the question of an account of profits for a number of reasons, which he expressed to the parties. The appellants are wrong in contending that the primary judge did not give reasons for his decision.

279 It is clear from the transcript that the parties were at issue as to the sufficiency of the evidence, then before the primary judge, to determine that question. It is also clear that the primary judge was concerned that, up to that point, he had not been given appropriate assistance on that question in the submissions he had received.

280 The appellants, through their counsel, foreshadowed that, but for the prospect raised by the primary judge, they would have submitted that the respondent had “simply failed in relation to this claim of relief” and that “[the appellants] would prefer to see this go now”. However, noting the primary judge’s “degree of discomfort”, counsel for the appellants stated that “we don’t want to push hard against that”—a reference, no doubt, to the appellants’ degree of resistance to the prospect that the primary judge had raised. Indeed, counsel for the appellants said: “we can see the sense alternatively of hiving it off”.

281 The second matter is that, in dealing with this ground of appeal, it is also important to note that Order 8 made by the primary judge on 25 November 2021 was that there be an account of profits arising from the trade mark infringements which his Honour had found. Thus, his Honour’s reference at J[989] to the question of an account of profits being dealt with separately after all other relief in the proceeding had been determined must be understood as meaning the determination of the amount payable on taking that account, not whether there should be an account of profits.

282 We do not see error in the primary judge reaching, and giving effect to, his decision to defer dealing with the question of an account of profits (in the sense we have noted) until after dealing with the respondent’s other claims for relief. The taking of an account of profits is a two-step process involving a finding that a person is an accounting party and, if so, that an account be taken. How the account is taken is a matter for further orders or directions; commonly the account is verified by affidavit, a method is determined to resolve objections and upon completion of the procedure the defaulting party is ordered to pay the amount found to be due: see generally, *Glazier Holdings Pty Ltd v Australian Men’s Health Pty Ltd* [2000] NSWSC 253 at [150]–[156] (Austin J) and on appeal *Meehan v Glazier Holdings Pty Ltd* [2002] NSWCA 22; 54 NSWLR 146 at [31]–[33] (Giles JA, Sheller and Beazley JJA concurring). The appellants were accounting parties upon the findings of trade mark infringement and involvement therein. The orders made by the primary judge were orthodox. How the account is to proceed, whether before the primary judge or a referee, will be a matter for the primary judge to determine. The parties remain free to make submissions to the primary judge on that question.

283 Ground 13 of the notice of appeal does not succeed.

# RELIEF: INJUNCTIONS

284 The appellants do not address Grounds 14 and 15 of the notice of appeal in their written submissions.

285 Ground 14 of the notice of appeal contends that the primary judge erred in finding that non-pecuniary relief should be granted in relation to the Infringing Signs. This ground is premised on the appellants succeeding on their grounds of appeal with respect to the trade mark issues. Ground 15 of the notice of appeal contends that the primary judge erred in finding that non-pecuniary relief should be granted in relation to the Infringing Signs that have not been used “in breach” of the Trade Marks Act.

286 We understand both grounds to mean that injunctive relief for trade mark infringement should not be granted where trade mark infringement has not been established. While that simple proposition is correct, it does not follow that use of the Infringing Signs, in trade or commerce, is not covered by the other injunctive relief granted by the primary judge, where that use constitutes conduct, or is an integral element of conduct, or the making of a representation, that constitutes a contravention, or threatened contravention, of the ACL.

287 The question of whether non-pecuniary relief was correctly granted by the primary judge, or should be varied, now falls to be assessed against the appellants’ success on the appeal and the respondent’s success on the cross-appeal.

# CROSS-APPEAL: 1300HENLEY

## The cross-appellant’s submissions

288 The primary judge found (at J[454]) that the sign 1300HENLEY did not infringe the registered marks because Henley Constructions had not used that sign as a trade mark.

289 At J[455], the primary judge said:

455 The display of the phone word “1300HENLEY” is a contact number, rather than a brand. This is because it provides a method by which persons can contact Henley Constructions. In the context in which it is used, I do not accept that consumers would view this as a brand or a badge of origin.

290 Having made that finding, the primary judge, understandably, did not proceed to consider whether 1300HENLEY was deceptively similar to any of the registered marks. It also seems that the primary judge did not take the use of that sign into account when considering the respondent’s ACL claim: see J[593] – [594].

291 By its cross-appeal, the respondent contends that the primary judge erred in finding that Henley Constructions had not used 1300HENLEY as a trade mark. It submits that the primary judge should have found that, by using 1300HENLEY, Henley Constructions infringed each of the registered marks.

292 The respondent submits that, while one of the functions of the sign 1300HENLEY was to convey to consumers a telephone phone number (being 1300 436 539), that function did not preclude the sign from also being used as a trade mark. The respondent submits that, in the context in which it was used, the sign would also be perceived by consumers as a badge of origin in relation to building and construction services. The respondent submits that, in each of the instances of use, Henley Constructions chose to use the letters rather than the phone number itself. In doing so, Henley Constructions gave prominence to the word HENLEY which would draw the attention of consumers to this word as distinguishing Henley Constructions’ services from those of other service providers. The respondent contrasted the hypothetical position of Henley Constructions using an anodyne sign such as 1300BUILD (1300 28453).

293 The respondent submits that the use of 1300HENLEY was akin to the use of a domain name for a website which, while functioning as a uniform resource locator directing consumers to a website, also performs the function of the trade mark.

294 Further, the respondent contends that Henley Constructions’ use of 1300HENLEY constituted conduct that contravenes ss 18, 29(1)(g) and 29(1)(h) of the ACL, regardless of whether its use also constituted trade mark infringement. The respondent submits that, in light of its reputation, as found by the primary judge, a person seeing 1300HENLEY would believe that the services offered in connection with that sign were connected with it.

295 The respondent contends that the primary judge should have held that Mr Sarkis was (a) a joint tortfeasor in relation to this infringement of the registered marks, and (b) a person who either aided or abetted, or was knowingly concerned in, Henley Constructions’ contraventions of the ACL in this regard.

## Analysis

296 The cross-appeal does not raise any question of principle. It simply raises the question whether the primary judge came to the wrong conclusion on a question of fact, involving an evaluative judgment.

297 While, undoubtedly, Henley Constructions used the sign 1300HENLEY as a telephone number, it did so for promotional purposes—namely, to promote the name HENLEY as the source of the building and construction services that Henley Constructions was offering in trade. In this way, Henley Constructions was using 1300HENLEY as a sign to distinguish its services from the building and construction services provided by other traders.

298 The appellants point to the fact that, in some instances of use, 1300HENLEY was accompanied by the numerals (of a telephone number) to which HENLEY, as a word, corresponds. The appellants submit that this underscores the fact that 1300HENLEY was, in these instances, only being used as, and would have been understood as being used as, no more than the means of communicating a telephone number.

299 In our view, rather than supporting the primary judge’s finding, this fact supports a finding of trade mark use. Had Henley Constructions merely wished to communicate a telephone number, it could have done so. Rather, it took advantage of the opportunity presented by a telephone number to communicate the dominant element of its name as the source of building and construction services.

300 Further, contrary to the appellants’ submission, we do not accept that Henley Constructions used HENLEY, in this context, as merely the means by which a telephone number could be more easily recalled. Any word could have been used for that purpose. Henley Constructions chose to use the name HENLEY. This choice was obviously deliberately made for promotional purposes, and as a trade indicium.

301 For these reasons, we are persuaded that the primary judge erred in finding that consumers would see Henley Constructions’ use of 1300HENLEY as only a telephone number and not also as a sign designating the trade source of Henley Constructions’ building and construction services.

302 The appellants resisted the cross-appeal solely on the question of trade mark use. They did not contest the respondent’s contention that 1300HENLEY was deceptively similar to the registered marks.

303 The primary judge made no finding on the question. It falls to us to decide that question. It is sufficient for us to say that we are satisfied that 1300HENLEY is deceptively similar to the 820 mark. Indeed, there is much to be said for the view that 1300HENLEY is a use of HENLEY with merely added matter which does not avoid the consequences of trade mark infringement under s 120(1) of the Trade Marks Act: see *Optical 88* at [99] and the cases there cited. We are satisfied that infringement has been established.

304 We think it is likely that the primary judge’s consideration of the respondent’s claims under the ACL and Trade Practices Act, without reference to Henley Constructions’ use of 1300HENLEY, was an oversight. Having regard to the primary judge’s findings in respect of Henley Constructions’ use of the Infringing Signs in the context of the respondent’s ACL claim, we are persuaded that Henley Constructions’ use of 1300HENLEY was of the same representational character. We are persuaded, therefore, that this was also a contravention of the ACL.

305 On the basis of the primary judge’s other findings concerning Mr Sarkis’s liability, we are satisfied that Mr Sarkis was a joint tortfeasor in respect of Henley Constructions’ infringing use of 1300HENLEY as a trade mark. On the same basis, we are also satisfied that Mr Sarkis was involved in Henley Constructions’ contravention of the ACL by reason of its use of 1300HENLEY.

306 Therefore, the respondent’s cross-appeal succeeds.

# LEAVE TO APPEAL: COSTS

307 In separate reasons for judgment (*Henley Arch Pty Ltd v Henley Constructions Pty Ltd (No 2)* [2022] FCA 231 (**CJ** or the **costs judgment**)), the primary judge decided that the appellants should pay the respondent’s costs on an indemnity basis, and as a lump sum, from 11.00 am on the second business day after the “2019 Offer” was served on the appellants.

308 The “2019 Offer” was a formal offer of compromise made by the respondent on 26 November 2019 pursuant to r 25.14(3) of the *Federal Court Rules 2011* (Cth), which provides:

(3) If an offer is made by an applicant and not accepted by a respondent, and the applicant obtains a judgment that is more favourable than the terms of the offer, the applicant is entitled to an order that the respondent pay the applicant’s costs:

(a) before 11.00 am on the second business day after the offer was served—on a party and party basis; and

(b) after the time mentioned in paragraph (a)—on an indemnity basis.

Note 1: ***Costs on an indemnity basis*** is defined in the Dictionary.

Note 2: The Court may make an order inconsistent with these rules—see rule 1.35.

309 The 2019 Offer was in these terms:

1. You consent to orders being made in the proceeding as follows:

(a) The Respondents, whether by themselves, their directors, officers, employees or agents or otherwise, be restrained from using as a trade mark, without the licence or authority of the Applicant, the following signs:

(i) Henley; and/or

(ii) Henley Constructions; and/or

(iii) Henley Constructions Pty Ltd; and/or

(iv) 1300 HENLEY; and/or

(v) www.henleyconstructions.com.au; and or

(vi) any other sign that is substantially identical, or deceptively similar, to “HENLEY”,

in the course of trade in relation to building or construction services.

(b) The claim and cross-claim be otherwise dismissed with no order as to costs.

2. The applicant authorises the Respondents, up until 31 May 2020 and not beyond, to use:

(a) Henley; and/or

(b) Henley Constructions; and/or

(c) Henley Constructions Pty Ltd; and/or

(d) 1300 HENLEY; and/or

(e) www.henleyconstructions.com.au,

in the course of trade in relation to building or construction services, provided only that the Respondents will otherwise undertake all steps necessary and as expeditiously as possible to rebrand their business to a name that does not include “HENLEY” or any word that is substantially identical, or deceptively similar, to “HENLEY”.

This offer of compromise is open to be accepted for **14 days after service of this offer of compromise**.

(Original emphasis.)

310 The primary judge was persuaded that r 25.14(3) was satisfied. At CJ[34], his Honour said:

34 I find that the 2019 Offer of compromise was a genuine offer in the context of the proceeding, and ultimately judgment was more favourable for Henley Arch than the terms of the 2019 Offer. This is so because the offer gave up any claim to legal costs, had no injunction based on the ACL claim and contained a six-month transition period for the Respondents to stop using the impugned signs as a trade mark in respect of building or construction services. This is in contrast to the findings in the Liability Judgment, wherein I found that Henley Constructions infringed Henley Arch’s intellectual property rights with respect to a number of its trade marks, and found that Henley Arch was entitled to injunctions against Henley Constructions due to its contraventions of ss 18 and 29 of the ACL. Further, I ordered that the Respondents pay the Applicant’s costs of and incidental to the hearing of liability on the claim, and the costs of and incidental to the cross-claim. Henley Arch clearly obtained a judgment that was more favourable than the state of affairs in the 2019 Offer. As such indemnity costs should be awarded against the Respondents from 11am on the second business day after the 2019 Offer was served on the Respondents pursuant to r 25.14(3).

311 The appellants seek leave to appeal from the costs judgment. They contend that the primary judge erred in finding that the 2019 Offer satisfied r 25.14(3). They contend that the respondent did not obtain a judgment more favourable than the terms of that offer.

312 The appellants focus on clauses 1(a)(iv) and 2(d) of the 2019 Offer which, if accepted, would have restrained them from using 1300HENLEY as a trade mark, except for a limited period (on conditions). They point to the fact that the primary judge did not find that use by Henley Constructions of 1300HENLEY was trade mark use. They contend that this result, in their favour, was not a “minor” matter which could be put to one side in the primary judge’s consideration of r 25.14(3). The appellants submit that the respondent has the onus of establishing that the judgment it obtained was more favourable than the 2019 Offer, and that the respondent had not discharged that onus.

313 We are far from persuaded that the primary judge erred in his assessment of the 2019 Offer and whether the respondent obtained judgment that was more favourable than that offer. Be that as it may, we have found that the primary judge erred in not finding that Henley Constructions’ use of 1300HENLEY was an infringement of, at least, the 820 mark. We would not, therefore, interfere with the primary judge’s findings on the question of costs.

314 In the circumstances, we would not grant leave to the appellants to appeal from the costs judgment.

# CONCLUSION

315 We have found that the appeal succeeds in part. We have also found that the cross-appeal succeeds.

316 The parties should now bring agreed orders giving effect to these reasons. We see no reason why the appellants should not bear the respondent’s costs of the appeal, the cross-appeal, and the appellants’ application for leave to appeal from the costs judgment.

317 If the parties cannot agree on the orders to be made, they should serve on each other a draft of the orders which they propose, supported by written submissions not exceeding three pages, within 10 days of the date of the appeal judgment. They should serve, within a further 7 days, any responding submissions, not exceeding two pages. Copies of the draft orders and the supporting and responding submissions are to be provided to the Full Court. Subject to further order, the question of the orders to be made on appeal will be determined on the papers.

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| I certify that the preceding three hundred and seventeen (317) numbered paragraphs are a true copy of the Reasons for Judgment of the Honourable Justices Yates, Rofe and McElwaine. |

Associate:

Dated: 28 April 2023

# SCHEDULE A

| **Ref** | **Dates of use** | **Instances of use** | **Services** | **Evidence reference** |
| --- | --- | --- | --- | --- |
| **A.** | **C:\Users\rallen\Desktop\JPEG HENLEY\Capture25.JPG** (**first Henley Constructions logo**) | | | |
| A.1 | November 2009 to about February 2015 | On website at www.henleyconstructions.com.au (the **Henley Constructions Website**) | Building and construction services for “small interior renovations” up to “large apartment blocks” with depictions of terraces, townhouses, two and three storey multi-dwelling residential apartment blocks and commercial buildings | JML-13 Tender Bundle: 1555-1560 [Henley Constructions admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  Ex A18 |
| A.2 | Early 2009 to February 2016 | On signage at least at the following locations and times:  Early 2009 at 4-6 Marlborough Road, Homebush West, New South Wales;  (a) Early to mid-2012 at 15-17 Larkin Street, Camperdown, New South Wales;  (b) Around March 2015 at 456-458 Gardeners Road, Alexandria, New South Wales;  (c) February 2016 at 59-65 Chester Avenue, Maroubra, New South Wales. | Building and construction services in respect of a three to five storey multi-dwelling apartment block at the sites it was displayed | JML-10 Tender Bundle: 1525  JML-44 Tender Bundle: 2055  Ex R22  (also at HQ building on door – JML-10 Tender Bundle: 1525-1526) |
| **B.** | **“henleyconstructions.com.au” (Henley domain name)** | | | |
| B.1 | November 2009 to about February 2015 | On Henley Constructions Website | Building and construction services for “small interior renovations” up to “large apartment blocks” with depictions of terraces, townhouses, two and three storey multi-dwelling residential apartment blocks and commercial buildings | Admitted facts paragraph 7 Notice of Dispute Tender Bundle: 86, Ex A14  JML-13 Tender Bundle: 1555-1560 [Henley Constructions admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  Ex A18 |
| B.2 | Early 2009 to February 2016 | On signage at least at the following locations and times:   Early 2009 at 4-6 Marlborough Road, Homebush West, New South Wales;   Early to mid-2012 at 15-17 Larkin Street, Camperdown, New South Wales;   Around March 2015 at 456-458 Gardeners Road, Alexandria, New South Wales;   February 2016 at 59-65 Chester Avenue, Maroubra, New South Wales. | Building and construction services in respect of a three to five storey multi-dwelling apartment block at the sites it was displayed | Ex R22  JML-44 Tender Bundle: 2055 |
| B.3 | February 2017 – August 2018 | On Henley Constructions Website | Building and construction services for “boutique and large-scale residential projects ranging from 10 to 500 units” | Admitted facts paragraph 7 Notice of Dispute Tender Bundle: 86, Ex A14  JML-13 Tender Bundle: 1561-1581 [admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  JML-14 – Henley Constructions Website at 27/2/17 [admitted accurately depict, in response to paragraph 36 of the First Notice to Admit, see paragraph 10 Notice of Dispute Tender Bundle: 86, Ex A14]  Ex A18 |
| B.4 | Since August 2017 | On business cards | Building or construction services in respect of single dwellings and multi-dwelling low rise and medium rise multi-storey apartment blocks | Business cards Tender Bundle: 1532 [Business cards - admitted appearance paragraphs 4, 5 Notice of Dispute Tender Bundle: 86, Ex A14] |
| B.5 | From about July 2018 | On Instagram | Building and construction services in respect of residential and commercial projects | Ex A20 |
| B.6 | Since at least 15 February 2018 | On Facebook | Building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Ex A19  JML-91 |
| **C** | C:\Users\rallen\Desktop\JPEG HENLEY\Capture27.JPG (**second Henley Constructions logo**) | | | |
| C.1 | February 2017 – August 2018 | On Henley Constructions Website | Building and construction services for “boutique and large-scale residential projects ranging from 10 to 500 units” | JML-13 Tender Bundle: 1561-1581 [admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  JML-14 – Henley Constructions Website at 27/2/17 [admitted accurately depict, in response to paragraph 36 of the First Notice to Admit, see paragraph 10 Notice of Dispute Tender Bundle: 86, Ex A14]  Ex A18 |
| C.2 | Since the latest August 2017 | On a brochure provided to the public in respect of the Aperture Apartments, Marrickville (or authorised such use) | Building and construction services in respect of a multi-dwelling apartment block | JML-10 Tender Bundle: 1530 [admitted accurately depict, in response to First Notice to Admit, see paragraph 6 Notice of Dispute Tender Bundle: 86, Ex A14]  PS-10 |
| C.3 | From October 2018 | At the website at www.aperturemarrickville.com.au (or authorised such use) | Building and construction services in respect of apartments at the “Aperture at Marrickville” construction project | PS-7 Tender Bundle: 4088, 4089 |
| **D** | **HENLEY CONSTRUCTIONS** | | | |
| D.1 | Around 28 March 2017 | Advertisement in *Inner West Courier Newspaper* | Building and construction services for “high-quality residential projects” and a multi-dwelling apartment block | Advertisements annexed to Amended Defence at Tender Bundle: 4908, 4909 – and see admitted facts paragraph 12 Notice of Dispute Tender Bundle: 86, Ex A14  PS-10, Tender Bundle: 4131, 4132 |
| D.2 | Since at least 15 February 2018 | On Facebook | Building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Ex A19  JML-91  Ex A20 and PS-9 (Instagram) |
| D.3 | From October 2018 | At the websites (or authorised such use):  www.aperturemarrickville.com.au   at www.thebirdwood.com.au  www.libertysutherland.com.au   from July 2019,  www.quartierdrummoyne.com.au | Building and construction services in respect of apartments at the specified construction project | PS-7 Tender Bundle: 4088, 4093, 4099, 4104  PS-10 |
| D.4 | From the latest February 2019 (but no earlier than 2 May 2018) | At its website at the domain name www.henleygallery.com.au | Building and construction services in respect for residential projectsand the multi-dwelling apartment block at the “Aperture Apartments” construction project | JML-59 |
| D.5 | Since at least prior to 25 July 2019 | Generally and for friends, including for Ali Hassan at the property at 23 The Grand Parade, Brighton-Le Sands, New South Wales 2216, including by display on hoarding at that site | Building and construction services in respect of single dwelling structural alterations, single dwelling non-structural renovations, construction of new duplexes, and construction of new single dwellings | JML-90 Tender Bundle: 5798, 5799 |
| **E** | **HENLEY** | | | |
| E.1 | February 2017 – August 2018 | On Henley Constructions Website (including vertical image of HENLEY sign at ground level of a building) | Building and construction services for “boutique and large-scale residential projects ranging from 10 to 500 units” | JML-13 Tender Bundle: 1558, 1569, 1570, 1575, 1580 [admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  JML-14 – Henley Constructions Website at 27/2/17 Tender Bundle: 1585, 1586, 1590 [admitted accurately depict, in response to paragraph 36 of the First Notice to Admit, see paragraph 10 Notice of Dispute Tender Bundle: 86, Ex A14]  (before Feb 2017, see A18 page 2)  On Henley gallery website at JML-59 Tender Bundle: 2148, 2151 |
| E.2 | Around 28 March 2017 | Advertisement in *Inner West Courier Newspaper* | Building and construction services for “high-quality residential projects” and a multi-dwelling apartment block | PS-10 |
| E.3 | Since around mid 2017 | On the number plate of utes decorated with decals showing the third Henley Constructions logo (that have been parked at or in front of building and construction sites), including in the form HENLEY and H3NL3Y | Building or construction services in respect of single dwellings and multi-dwelling apartment blocks | PS-9 Tender Bundle: 4117 (Instagram image of “Fleet of vehicles” showing decal)  P Sarkis XXN T.321.23-34 |
| E.4 | From at least September 2018 | At ground level on the front of the building and (up to a time before September 2019) at 128 Parramatta Road, Camperdown, New South Wales [when used in conjunction with THE HENLEY DISPLAY GALLERY and the third Henley Constructions logo] | Building and construction services for an apartment block called “Aperture” or “Marrickville Luxury Apartments” | JML-46 |
| E.5 | From October 2018 | At the website at www.aperturemarrickville.com.au (or authorised such use) | Building and construction services in respect of apartments at the “Aperture at Marrickville” construction project | PS-7 Tender Bundle: 4088 |
| E.6 | From October 2018 | At the website at www.thebirdwood.com.au (or authorised such use) | Building and construction services in respect of multi-dwelling apartment block at the “Birdwood” construction project | PS-7 Tender Bundle: 4093 |
| **F** | **1300 HENLEY** | | | |
| F.1 | February 2017 – August 2018 | On Henley Constructions Website | Building and construction services for “boutique and large-scale residential projects ranging from 10 to 500 units” | JML-13 Tender Bundle: 1566-1568, 1570, 1574, 1577, 1579 [admitted accurately depict, in response to paragraph 35 of the First Notice to Admit, see paragraph 9 Notice of Dispute Tender Bundle: 86, Ex A14]  JML-14 – Henley Constructions Website at 27/2/17, Tender Bundle: 1583, 1584, 1587, 1589, 1590, 1593, 1594 [admitted accurately depict, in response to paragraph 36 of the First Notice to Admit, see paragraph 10 Notice of Dispute Tender Bundle: 86, Ex A14] |
| F.2 | Since August 2017 | On business cards | Building or construction services in respect of single dwellings and multi-dwelling low rise and medium rise multi-storey apartment blocks | JML-10 use on Business cards Tender Bundle: 1532 [Admitted appearance paragraphs 4, 5 Notice of Dispute Tender Bundle: 86, Ex A14]  (also at HQ building on door – JML-10 Tender Bundle: 1525-1526) |
| F.3 | Since at least 15 February 2018 | On Facebook | Building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Ex A19 (pages 11, 13)  JML-91 Tender Bundle: 5807 |
| **G** | C:\Users\rallen\Desktop\JPEG HENLEY\Capture28.JPG (**third Henley Constructions logo**) | | | |
| G.1 | After 10 May 2017 | On the side of up to around 15 “ute” vehicles (that have been parked at or in front of building and construction sites) | Building or construction services in respect of single dwellings and multi-dwelling low rise and medium rise multi-storey apartment blocks | Ex R22 (page 28)  Ex A19 (page 19)  Ex A20 (page 17)  JML-17  PS-9 Tender Bundle: 4117 (Instagram image of “Fleet of vehicles” showing decal) |
| G.2 | After 10 May 2017 | On hoarding at construction sites, in email signatures, and on business cards | Building or construction services in respect of single dwellings and multi-dwelling low rise and medium rise multi-storey apartment blocks | Ex A19  Ex A20 (page 12)  Ex R4  Ex R22  JML-17  JML-47 Tender Bundle: 2080  JML-49 Tender Bundle: 2092, 2093  JML-50 Tender Bundle: 2097  JML-51 Tender Bundle: 2104  JML-10 use on Business cards Tender Bundle: 1532 [Admitted appearance paragraphs 4, 5 Notice of Dispute Tender Bundle: 86, Ex A14]  PS-9 |
| G.3 | Since around mid-2017 | On signage at the following sites:  (a) At least around June 2017, at the “Aleya” site, at 1 Sparkes Lane, Camperdown, NSW;  (b) At least around February 2018, at 233-235 Botany Road, Waterloo, NSW;  (c) At least from September 2018 to April 2019, at 81-83 Waterloo Road, Punchbowl, NSW;  (d) At least around September 2020, at the “Chanel” building at 27 Church Street, Camperdown, NSW;  (e) From at least March 2021, at the “Botany Living” site at 1445-1447 Botany Road, Botany, NSW  (f) In around August 2017, at a construction site at 507-509 President Ave, Sutherland, NSW  (g) In around September 2017, at the “Birdwood” construction site at 203 Birdwood Road, Georges Hall, NSW.  (h) In around October 2017, at a construction site at 1356-1362 Botany Road, Botany.  (i) Between at least May 2019 and February 2020, at a construction site at 9 Wrights Road, Drummoyne, New South Wales (for the “Quartier” project). | Building and construction services in respect of a multi-dwelling apartment block at each of those site (and in relation to the Punchbowl site in respect of building and construction of a multi-dwelling two storey aged care facility (St Charbel’s Care Centre) at that site). | Ex R22  Ex A19  EX R4  Ex A20 (page 12)  JML-47 Tender Bundle: 2080  JML-49 Tender Bundle: 2092, 2093  JML-50 Tender Bundle: 2097  JML-51 Tender Bundle: 2104 |
| G.4 | From at least September 2018 | At ground level on the front of the building and (up to a time before September 2019) at 128 Parramatta Road, Camperdown, New South Wales | building and construction services for an apartment block called “Aperture” or “Marrickville Luxury Apartments” | JML-46 Tender Bundle: 2070, 2071  Ex A20 (page 10) |
| G.5 | From about July 2018 | On Instagram | building and construction services in respect of residential and commercial projects | Ex A20  PS-9 |
| G.6 | Since at least 15 February 2018 | On Facebook | building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Ex A19  JML-91 |
| G.7 | From July 2019 | At the website www.quartierdrummoyne.com.au (or authorised such use) | building and construction services in respect of a three storey multi-dwelling building at the “Quartier” construction project at 9 Wrights Road, Drummoyne, New South Wales | PS-7 Tender Bundle: 4105 |
| G.8 | Since at least prior to 25 July 2019 | Generally and for friends, including for Ali Hassan at the property at 23 The Grand Parade, Brighton-Le Sands, New South Wales 2216, including by display on hoarding | building and construction services in respect of single dwelling structural alterations, single dwelling non-structural renovations, construction of new duplexes, and construction of new single dwellings | JML-90 Tender Bundle: 5798, 5799 |
| G.9 | From around September 2017 | On completed low to medium-rise multi-dwelling apartment blocks, including at least:  (a) From September 2017, at the “Birdwood” building, at 203 Birdwood Road, Georges Hall, New South Wales;  (b) From August 2018, at the “Aleya” building, at 1 Sparkes Lane, Camperdown, New South Wales;  (c) From December 2018, at 59-65 Chester Avenue, Maroubra, New South Wales;  (d) From August 2019, at the Camperdown “HQ” building, at 128 Parramatta Road, Camperdown, New South Wales;  (e) From March 2020, at the “Quartier” building, at 9 Wrights Road, Drummoyne, New South Wales;  (f) From July 2020, at the “Noah” building, at Gladesville, New South Wales;  (g) From October 2020, at the “Chanel” building, at 27 Church Street, Camperdown, New South Wales. | building and construction services | Ex R22  Ex A19  Ex R2  Ex R3  Ex R4  Ex A20 (pages 2, 3, 5, 10, 14, 15)  JML-91  PS-9 Tender Bundle: 4115 |
| G.10 | Since at least November 2019 | on safety hats and hi-vis clothing | Building and construction services | Ex A19 (page 12)  Ex A20 (page 6) |
| **H** | **THE HENLEY DISPLAY GALLERY** | | | |
| H.1 | From at least September 2018 | At ground level on the front of the building and (up to a time before September 2019) at 128 Parramatta Road, Camperdown, New South Wales | Building and construction services for an apartment block called “Aperture” or “Marrickville Luxury Apartments” | JML-46 Tender Bundle: 2072  Ex A20 (page 13)  PS-9 Tender Bundle: 4127, 4128 |
| H.2 | From October 2018 | at the website at www.aperturemarrickville.com.au (or authorised such use) | Building and construction services in respect of apartments at the “Aperture at Marrickville” construction project | PS-7 Tender Bundle: 4089 |
| H.3 | From the latest February 2019 (but no earlier than 2 May 2018) | at its website at the domain name www.henleygallery.com.au | Building and construction services in respect of residential projectsand the multi-dwelling apartment block at the “Aperture Apartments” construction project | JML-59 |
| **I** | C:\Users\rallen\Desktop\JPEG HENLEY\Capture30.JPG C:\Users\rallen\Desktop\JPEG HENLEY\Capture31.JPG C:\Users\rallen\Desktop\JPEG HENLEY\Capture33.JPGC:\Users\rallen\Desktop\JPEG HENLEY\Capture34.JPG | | | |
| I.1 | From at the latest 2018 and ongoing | On a crane located around 30m in the air including when lit up at night, including at:  (a) Between at least around September 2018 to November 2019, at St Charbel’s Care Centre, 81-83 Waterloo Road, Punchbowl, New South Wales ;  (b) From at least March 2021 at the “Botany Living” site at 1445-1447 Botany Road, Botany, New South Wales. | Building and construction services at each site and generally for building and construction services | Ex R22 (pages 25, 27) |
| I.2 | From about 2018 | On Facebook and Instagram | Building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Facebook - Ex A19 (pages 2, 10)  Instagram - Ex A20 (pages 7, 8) |
| **J** | **“#henleyconstructions”, “#henleygallery”, “#henley”, images of the third Henley Constructions logo appearing on decals on vehicles, hoarding at constructions sites and safety/hi-vis clothing** | | | |
| J.1 | From about July 2018 | On Instagram | Building and construction services in respect of residential and commercial projects | Ex A20 (#henleyconstructions all) (#henley at pages 11, 13)  PS-9 (#henleyconstructions)  PS-9 Tender Bundle: 4119 (#henleygallery),  PS-9 Tender Bundle: 4127, 4128 (#henley) |
| J.2 | Since at least 15 February 2018 | On Facebook | Building and construction services in respect of residential and commercial projects, repair, flooring, remedial work, general maintenance and cleaning services, and a number of multi-dwelling apartment blocks | Ex A19  JML-91 |
| **K** | **Henleygallery.com.au; HENLEY BUILT** | | | |
| K.1 | From the latest February 2019 (but no earlier than 2 May 2018) | At its website at the domain name www.henleygallery.com.au | Building and construction services in respect of residential projectsand the multi-dwelling apartment block at the “Aperture Apartments” construction project | JML-59 (domain name henleygallery.com.au)  JML-59 (HENLEY BUILT) Tender Bundle: 2148, 2151 |
| **L** | **HNLY** | | | |
| L.1 | Since around mid 2017 | On the number plate of utes decorated with decals showing the third Henley Constructions logo (that have been parked at or in front of building and construction sites), including in the form 01-HNLY, 05-HNLY, 12-HNLY | Building or construction services in respect of single dwellings and multi-dwelling apartment blocks | PS-9 Tender Bundle: 4117 (Instagram image of “Fleet of vehicles” showing decal)  P Sarkis XXN T.321.23-34 |