
Opposition to “Dickie Peacock” trade mark rejected

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In *Williamson-Dickie Manufacturing Company v Richard Magney* [2012] ATMO 81 (14 September 2012) the owner of the stylised “Dickies” trade mark was unsuccessful in opposing the registration of the “Dickie Peacock” trade mark for use in relation to socks and apparel. The opposition action was based primarily on the footing that the “Dickie Peacock” trade mark was substantially identical with or deceptively similar to the opponent’s stylised “Dickies” trade marks, which are registered in the same class (class 25 — socks, apparel (clothing, footwear, headgear)).

Comment

This was an interesting case and I thought the opponent had reasonable prospects of success, especially on the deceptive similarity ground. The applicant for registration heavily criticised the opponent’s evidence (on use of the opponent’s trade marks in Australia for example) and this criticism seemed to be largely accepted by the Registrar. The applicant’s success on the deceptive similarity ground was not determined by this issue, but the successful attack by the applicant set the tone of the case. In a nutshell, this case shows that parties need to ensure their own evidence is fulsome and sound; and they need to be aware of any chink in their opponent’s armour which may be successfully exploited. Setting the tone of the case can have significant advantages.

Section 44(1) — substantial identity or deceptive similarity

Section 44(1) of the Act provides, among other things, that an application for the registration of a trade mark must be rejected if the applicant’s trade mark is *substantially identical with or deceptively similar to a trade mark registered by another person in respect of similar goods or closely related services and the applicant’s priority date is not earlier than that of the other trade mark.*

The Delegate of the Registrar of Trade Marks cited Windeyer J’s comments in *Shell Company (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) CLR 407 (at 414 to 415) in support of the proposition that “substantial

identity” and “deceptive similarity” are independent criteria to be judged in different ways. Substantial identity requires the two trade marks to be “compared side by side”, whereas a deceptive similarity comparison is based on recollection of the trade marks that persons of ordinary intelligence and memory would have.

In considering the substantial identity issue, the Delegate of the Registrar noted that salient features of the applicant’s mark, “Dickie Peacock” are that the words *in combination* would likely be perceived as the name of a person (first name Dickie, surname Peacock — real or fictitious) whereas the opponent’s trade mark, “Dickies” did not have that same connotation. The Registrar also noted that all but one of the opponent’s registrations is for composite marks featuring a distinctive device in addition to the word “Dickies”. For these reasons the Delegate of the Registrar found that the trade marks were not substantially identical.

On the deceptive similarity issue, the Delegate noted Mason J’s comments in *Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353 at 362; 1 ALR 443; 47 ALJR 550; BC7300036 where Mason J said:

... the question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark. The issue is whether that use would give rise to a real danger of confusion.

The Delegate agreed with the applicant that merely sharing an element in common (in this instance the expression “Dickie”) is not necessarily sufficient to render the trade marks in question deceptively similar: *Capitol Clothing Pty Ltd v Hush Fashions Pty Ltd* [2006] ATMO 79.

The Delegate found that the applicant’s trade mark, Dickie Peacock, was not deceptively similar to the opponent’s “Dickies” trade mark. In particular, the Delegate relied on the difference in appearance between the two trade marks (two words, Dickie Peacock, in combination for the applicant), how the trade marks are pronounced, as well as in terms of the meaning of the two trade marks. The Registrar noted that the word

“Dickies” of itself has no meaning. The Delegate also noted that the opponent’s argument that it had established a “family” of trade marks was not sufficiently supported by the evidence.

Section 60 of the Act (reputation)

The Delegate also considered opposition on the basis that the opponent’s trade marks had, before the priority date of the applicant’s trade mark, in respect of the relevant class of goods, acquired a reputation in Australia and use of the applicant’s trade mark would be likely to deceive or cause confusion (s 60). The Delegate found that the evidence of reputation was not sufficient to make out this ground.

Section 42(b) of the Act (contrary to law)

Finally, the Delegate considered s 42(b) of the Act (use of the trade mark contrary to law). However, as the

Delegate found that because use of the trade mark for the goods in question was unlikely to deceive or cause confusion in terms of s 60 of the Act, this s 42(b) ground could not be made out (given the test under s 42(b) was higher than under s 60): *McWilliams Wines Pty Ltd v McDonald’s System of Australia Pty Ltd* (1980) 3 ALR 394.



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