
Trade Marks Update

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Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Proposed amendments to s 41 TMA:**
 - Explanatory Memorandum:
 - Presumption of registrability was a policy objective of TMA
 - *Blount* reversed presumption of registrability for s 41(5)-(6)
 - Proposed amendments are intended to clarify that presumption of registrability applies to s 41
 - Intention is that if Registrar is equally unsure whether or not TM is capable of distinguishing, doubt should be resolved in applicant's favour

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Proposed amendments to s 41 TMA:**
 - Explanatory Memorandum:
 - Not intended to require that TM should “*clearly not be registered*”
 - Rather, “*as with other grounds*”, it is intended that the balance of probabilities applies
 - Amendments are not intended to alter key concepts of:
 - “*inherently adapted to distinguish*”
 - “*capable of distinguishing*”
 - “*does or will distinguish*”
 - TMs which are “*sufficiently*” inherently adapted to distinguish on their own would not fall within new s 41(3) or (4) and could not be rejected under s 41.

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Proposed amendments to s 41 TMA:**
 - S 41 rearranged, and tests reformulated in the negative
 - S 41(2) and (3) replaces current s 41(3) and (6):
 - TM taken not to be capable of distinguishing if it is “*not to any extent inherently adapted to distinguish*” the designated goods or services from those of others; and
 - “*the applicant has not used the TM before the filing date in respect of the application to such an extent that the TM does in fact distinguish the designated goods or services as being those of the applicant*”

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Proposed amendments to s 41 TMA:**
 - S 41(2) and (4) replaces current s 41(3) and (5):
 - TM taken not to be capable of distinguishing if it is “*to some extent, but not sufficiently, inherently adapted to distinguish*” the designated goods or services from those of others; and
 - the TM does not and will not distinguish the designated goods or services as being those of the applicant having regard to the combined effect of the following:
 - extent of inherent adaption to distinguish
 - the use or intended use of TM by applicant
 - any other circumstances

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Proposed amendment to s 126 TMA:**
 - New s 126(2) – Court may award additional damages if appropriate, having regard to:
 - flagrancy of the infringement
 - need to deter similar infringements
 - conduct of the infringer after the infringing act or after being informed that it had allegedly infringed
 - any benefit accrued to the infringer
 - all other relevant matters
- Consistent with s 115(4) Copyright Act, s 122(1A) Patents Act

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Other key proposed amendments to TMA:**
 - S 52 – prescribed form notice of opposition
 - New s 52A – TM applicant may file notice of intention to defend opposition
 - New s 54A – opposed TM application lapses if applicant does not file notice of intention to defend opposition within prescribed time
 - S 229 – TM and patent attorney’s privilege extended to communications, records and documents made for the “*dominant purpose*” of providing intellectual property advice
 - Ss 134-139 – more detailed procedure for Customs seizure
 - New s 134A – Customs CEO may permit objector or designated owner to inspect seized goods

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Other key proposed amendments to TMA:**
 - Ss 145-149 – more detailed provisions for indictable and summary offences, and stronger penalties for:
 - Falsifying or removing registered TM: s 145
 - Falsely applying registered TM: s 146
 - Making a die etc for use in TM offence: s 147
 - Selling, importing etc goods with false TMs: s 148
 - New s 147A – indictable and summary offence for drawing or programming a computer to draw a registered TM likely to be used in the course of an offence
 - New s 147B – possessing or disposing of things for use in TM offence

Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

- **Other key proposed amendments to TMA:**
 - Ss 35, 56, 67, 83(2), 83A(8), 84D and 104:
 - Both Federal Magistrates Court and Federal Court will have jurisdiction to hear appeals from Registrar's decisions on acceptance, rejection, opposition, amendment, revocation and removal for non-use
 - New s 190(aa):
 - Federal Magistrates Court added as a prescribed court
 - No longer limited to the Federal Court and State and Territory Supreme Courts
 - Jurisdiction to hear infringement claims (s 125) and revocation of registration (ss 86-88)

Report card – your performance as a profession

Substantive TM appeals

Year	Full Federal Court	High Court
2006	1	NIL
2007	NIL	NIL
2008	1	NIL
2009	3	NIL
2010	3	2
2011	1	NIL

Assessment: must try harder

Report card – your performance as a profession

Good news:

IP Australia statistics: record year for new TM applications.

Food Channel Network Pty Ltd v Television Food Network GP
(2010) 185 FCR 9

- The Food Channel PL applied for TM FOOD CHANNEL & logo 
- During application, The Food Channel PL assigned TM to Food Channel Network PL
- Both companies controlled by same person
 - Different TMs and companies used by him randomly
 - Confusion on the evidence: which company was true owner and intended to use TM?
- TM opposed by Television Food Network GP
- TMO [2006] ATMO 88: opposition dismissed
- Collier J: ss 58 and 59 grounds established

Food Channel Network Pty Ltd v Television Food Network GP
(2010) 185 FCR 9

Keane CJ, Stone and Jagot JJ, re s 58:

- The opponent bears the onus in opposition proceedings
- Under s 58 the onus does not shift after prima facie case is made out
 - Applicant is not required to prove its ownership
- If evidence unclear, then opposition fails
- Each of The Food Channel PL, Food Channel Network PL or their common director could “claim” to be owner and thus was eligible to apply under s 27(1)(a)
- Given the onus on the opponent, uncertainty in the evidence is fatal to the opponent, not the applicant

Food Channel Network Pty Ltd v Television Food Network GP
(2010) 185 FCR 9

Keane CJ, Stone and Jagot JJ, re s 59:

- The intention to use must exist at the date of application
- Once opponent makes a prima facie case of lack of intention to use, the onus shifts to the applicant
- Applicant's director gave evidence of intention
- Collier J erred in finding no intention

Television Food Network GP v Food Channel Network PL [2010] HCATrans 303

- Application for special leave to appeal to the High Court
- Heard by French CJ and Gummow J on 12 Nov 2010
- TV Food's appeal point:
 - if, at conclusion of TM opposition, the evidence leaves doubt about whether TM should be registered, opposition should be decided against applicant
 - FFC erred at [28]: "*s 55 contemplates that registration may be refused only 'to the extent (if any) to which' a ground of opposition 'has been established'.*"
 - the word "*only*" is not in s 55
 - no presumption of registrability under s 55

Television Food Network GP v Food Channel Network PL [2010]
HCATrans 303

- Working Party report pre 1995 Act:
 - in opposition, onus should remain on applicant to justify registration
 - if matter left in doubt, opposition should be resolved against applicant

Television Food Network GP v Food Channel Network PL [2010]

HCATrans 303

Gummow J:

- Re s 55 and establishing a ground of opposition:
 - *“Prima facie, one would have thought that the establishment has to be by the proponent of the ground, namely the opponent.”*

Television Food Network GP v Food Channel Network PL [2010] HCATrans 303

French CJ:

- re FFC at [72] re s 59: that once opponent makes out prima facie case of lack of intention to use TM, onus shifts to applicant.
- “I am a bit uneasy about that nomenclature”*
- “Does that carry with it any more magic than the proposition that if the opponent has made out a prima facie case and the applicant either stands silent or does not put anything in which in any way responds to it the registrar can find that, as a matter of inference of the necessary factual matters that the ground is established?”*
- “Onus is like phlogiston, it sort of shifts from one thing to another.”*

Television Food Network GP v Food Channel Network PL [2010]
HCATrans 303

French CJ, refusing special leave to appeal:

- The decision of FFC was substantially correct.
- *“although we are not to be taken as endorsing the general application of notions of shifting onus in opposition proceedings, in our view the result was correct.”*

[PS Macquarie Dictionary:

“phlogiston, noun, a non-existent chemical which, before the discovery of oxygen, was thought to be released during combustion.”]

Optical 88 Ltd v Optical 88 Pty Ltd (No 2) (2010) 89 IPR 457

- Applicants based in Hong Kong and ran international chain of optometrists stores under various OPTICAL 88 TMs
- Respondents emigrated from Hong Kong to Australia, and established OPTICAL 88 optometrists
- “88” is propitious in Asian traditions, and looks like spectacles
- Applicants sued for TM infringement

Yates J on deceptive similarity:

- Respondent’s TM OPTICAL 88 store signage is deceptively similar to Applicant’s TM:



- Respondent’s various Chinese character TMs are also deceptively similar to Applicant’s other TMs

Optical 88 Ltd v Optical 88 Pty Ltd (No 2) [2010] FCA 1380

Yates J on TM defences:

- Respondent entitled to defence under s 122(1)(a)(i)
 - use of own name in good faith
 - Respondent had innocently adopted its corporate name
 - Use does not cease to be in good faith when the likelihood of deception is brought to the notice of an alleged infringer
- Respondent also partially entitled to defence under s 124
 - Prior continuous use predating all but one of Applicant's TM registrations
- Thus, TM infringement claim failed
- Copyright, passing off and TPA claims also rejected
- Successful cross-claim under s 92
 - OPTICAL 88 TMs removed for non-use

***Optical 88 Ltd v Optical 88 Pty Ltd* [2011] FCAFC 130**

Cowdroy, Middleton and Jagot JJ:

- On s 122(1)(a)(i) defence: use of own name in good faith
 - Appellant argued that defence did not cover use of “OPTICAL 88” as part of a discrete sign which incorporates additional elements, eg:
 - OPTICAL 88 Vision Centre
 - OPTICAL 88 Vision Centre 9787 3621
 - OPTICAL 88 with 88 in stylised logo form
 - OPTICAL 88 Vision Centre in stylised logo form
 - OPTICAL 88 with OPTICAL 88 in Chinese characters
 - OPTICAL 88 VIP Card

***Optical 88 Ltd v Optical 88 Pty Ltd* [2011] FCAFC 130**

Cowdroy, Middleton and Jagot JJ:

- Upheld Yates J on defence under s 122(1)(a)(i):
 - Defence bites when the use of the name is the reason for the finding of infringement
 - Insofar as the additional material was not part of appellant's TM, authorities cited did not assist appellant
 - The dominating element of appellant's TM is OPTICAL 88, logo plays only a secondary role
 - Thus, the essential and distinguishing characteristic of TMs is OPTICAL 88
 - Only the use of name OPTICAL 88 gives rise to infringement, not any additional material
- Rejected argument that, in light of Yates J's findings, respondent's future use of name could not be in good faith
- Rejected various other grounds of appeal

Mars Australia PL v Société des Produits Nestlé (2010) 86 IPR 581

- Nestle successfully opposed registration of the following colour as a trade mark in respect of cat food: 
- Mars appealed to Federal Court
- Nestle withdrew its opposition
- The court nevertheless considered opposition grounds:
 - s 62(b): false representation to registrar
 - s 41: insufficiently distinctive

Bennett J:

- no causal link between the false representation and the delegate's acceptance of TM, s 62(b) opposition dismissed.
- as at the priority date TM was in fact capable of distinguishing the goods and so was TM registrable under s 41(6).

Sporte Leisure PL v Paul's International PL (No 3) (2010) 88 IPR 242

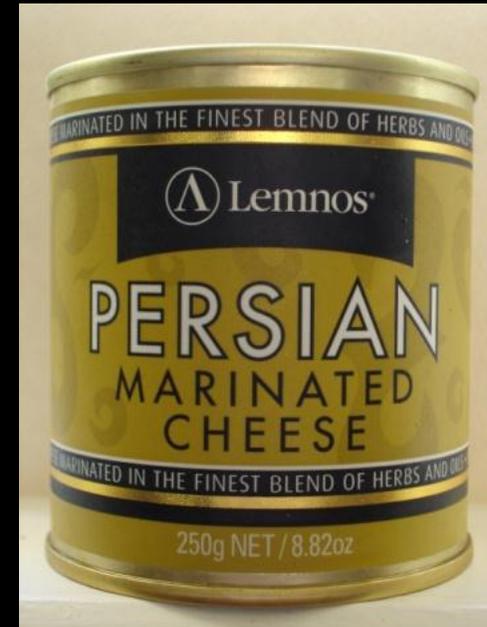
- Paul's imported garments bearing Sporte Leisure's TMs.
- Paul's relied on s 123 defence: TM applied with registered owner's consent
- Paul's argued that TMs had been applied by third party in Pakistan pursuant to a licence agreement with Sporte Leisure

Nicholas J:

- Pursuant to the Licence Agreement the consent of the owner only extended to garments produced for sales to regular customers in India
- Therefore TMs applied without registered owner's consent
- Importation into Australia constituted TM infringement

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297

- Yarra Valley's registered TM, since 2000: PERSIAN FETTA for dairy products including cheese
- Yarra Valley and Lemnos products appeared as follows:



- Yarra Valley sued for TM infringement, TPA and passing off
- Lemnos cross-claimed to cancel TM PERSIAN FETTA

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297

Middleton J on cross-claim under s 41 (not distinctive):

- Applicant for TM cancellation bears onus, including under s 41(5) and (6)
- Yarra Valley's PERSIAN FETTA was developed in 1996 by Mr Thomas, based on his experience of a white fetta style cheese he had seen in an Iranian village in 1973
- Mr Thomas also used a book containing a recipe "*Feta and Iranian White Cheese from Pasteurised Cow's Milk*"
- Mr Thomas used "*Persian*" to describe a style of fetta
- Minimal promotion of Yarra Valley's product before TM application in 2000
- Some press reports and books referred to Yarra Valley's product as being developed from a Persian recipe
- After 2000, PERSIAN FETTA became Yarra Valley's best selling product, over half of its total sales

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297

Middleton J on cross-claim under s 41 (not distinctive):

- Since 2000, third parties had used PERSIAN and PERSIAN FETTA in Australia
- Evidence admitted of use of references to Persian style fetta cheese in international books
- Conclusion: there is a style of fetta which originates from or is associated with geographical location Persia
- Little doubt that “*Iranian Fetta*” would not be registered
- “*Persian*” and “*Iranian*” are still interchangeable
- There is a “*possible relationship*” between fetta and Iran/Persia (*Colorado* per Allsop J)
- PERSIAN FETTA not inherently adapted to distinguish cheese:
 - s 41(6) applies, not 41(5)

Yarra Valley Dairy Pty Ltd v Lemnos Foods Pty Ltd (2010) 191 FCR 297

Middleton J on s 41(6):

- Only scant evidence of Yarra Valley's use of PERSIAN FETTA before 2000 filing date
- Important not to equate use with distinctiveness (eg SOAP)
- PERSIAN FETTA usually used with YARRA VALLEY DAIRY very nearby
- PERSIAN FETTA not used as a TM
- S 41(6) cannot allow registration

Middleton J on s 41(5), even if it applied:

- After 2000, many press reports that Yarra Valley's product was derived from Iran – relevant under s 41(5)(a)(iii)
- After 2000, PERSIAN FETTA still not used as a TM
- S 41(5), even if applicable, would not allow registration
- TM cancelled, no need to consider infringement

Hills Industries Limited v Bitek PL (2011) 90 IPR 337

- Since 2002, Hills (and predecessor) owned DGTEC/DGTEK TM for “*Digital and electronic products including televisions, video players, DVD players; CD players, decoders and cameras*”
- 2004: Bitek applied for DIGITEK for “*TV installation accessories including external TV antennas, none of the foregoing being set-top boxes*”
- Bitek then used DIGITEK for various television accessories
- Hills opposed Bitek’s DIGITEK TM
 - TMO: TMs deceptively similar, but goods not similar
- 3 related cases before Federal Court:
 - Hill’s appeal from opposition
 - Bitek’s application to remove Hills’ DGTEC TM for non-use
 - Hills’ infringement case: Bitek’s DIGITEK goods infringed Hills’ DGTEK TM (and passing off/TPA)

Hills Industries Limited v Bitek PL (2011) 90 IPR 337

Lander J on standard of proof for opposition:

- Opponent must prove that TM “*should clearly not be registered*”
- Conflicting views of trial judges need to be resolved by the Full Federal Court

Lander J, finding deceptive similarity:

- Pronunciation of DIGITEK and DGTEC is quite similar
- Similar in appearance and meaning

Lander J, finding goods not similar:

- Televisions etc are “*fundamentally different*” to television installation accessories including television antennas
- Respective goods are interdependent, but not interchangeable
- Different trade channels

Hills Industries Limited v Bitek PL (2011) 90 IPR 337

Lander J on s 44(3):

- Opposition must be determined at priority date
- Evidence of use after priority date is not relevant to:
 - s 44(3)(a): honest concurrent use
 - s 44(3)(b): other circumstances

Lander J on s 60:

- Evidence of \$20 million sales revenue for DGTEC set-top boxes does not prove any reputation at all
- It may prove that set top boxes were very marketable goods at that time, for persons who wanted to upgrade from analogue to digital television
- Appeal against opposition dismissed

Hills Industries Limited v Bitek PL (2011) 90 IPR 337

Lander J, allowing partial removal for non-use:

- Court has discretion to narrow scope of registration by redrafting specification of goods
- Hills' broad inclusive specification of goods to be amended to limit it to the goods actually used

Lander J, allowing partial infringement case:

- DIGITEK deceptively similar to DGTEK
- Bitek infringed by sale of DIGITEK set-top boxes and remote controls, similarity of goods conceded by BITEK
- Bitek's other television accessories not of the same description as televisions, thus not infringing

***Hills Industries Limited v Bitek PL* [2011] FCA 644**

- Leave under s 195 granted by Mansfield J to appeal from Lander J's decision on ss 44 and 60
- Contended errors on s 44:
 - Lander J erred in not finding TV antennas etc similar to TVs:
 - should have considered whether sale of both goods under same TM is likely to confuse (*Gallo*)
 - should not have considered similarity of TMs separately from similarity of goods (*Woolworths*)
- Contended error on s 60:
 - Not finding “*any reputation*” from \$20 million sales of DGTEC products
- Appeal to FFC subsequently settled

Solahart Industries PL v Solar Shop PL [2011] FCA 700

- Solahart owned SOLAHART TMs for goods including:
 - solar operated hot water systems
 - domestic water heaters
 - apparatus for heating
- Alleged infringement by Solar Shop by sale of roof-mounted photovoltaic solar panel systems under SOLAR HUT
- Photovoltaic panels generate electricity from solar radiation

Perram J on comparison of goods:

- Respective goods not the same for s 120(1):
 - Not to be accepted that a device which generates electricity and thereafter powers an apparatus for heating is, without more, such an apparatus

Solahart Industries PL v Solar Shop PL [2011] FCA 700

Perram J on goods of the same description under s 120(2):

- Question of “*goods of the same description*” will often be inherently contestable
- “*The delimitation of such a concept is notoriously controversial: one may no more readily answer whether a monkey is an animal of the same description as a baboon than one may say that trade mark attorneys are lawyers of the same description as intellectual property barristers.*”

Solahart Industries PL v Solar Shop PL [2011] FCA 700

Perram J on goods of the same description under s 120(2)(a):

- Photovoltaic solar electricity generator panel systems are of the same description as solar hot water systems
 - Technical mechanism in each is profoundly different
 - But to a consumer, the choice lies between purchase of a solar powered hot water system and a solar powered electrical generator
 - Similar motives may lie behind a decision to purchase either, including environment and government rebates
 - Ultimately, classes of consumers of each goods sufficiently overlap, like beer and wine (*Gallo*), even though the goods are not interchangeable for every customer
 - there is a more than trivial degree of substitutability

Solahart Industries PL v Solar Shop PL [2011] FCA 700

Perram J on goods of the same description under s 120(2)(a):

- However, solar electricity generator panel systems are not of the same description as “apparatus for heating”
 - too general
 - Wine may be of the same description as beer, but it is too much to say that wine is a good of the same description as a drink

Perram J on services closely related to goods under s 120(2)(b):

- Do not see how installation of solar electricity generator panel systems is “closely related” to solar hot water heaters

Solahart Industries PL v Solar Shop PL [2011] FCA 700

Perram J on comparison of TMs:

- SOLAHART and SOLAR HUT not substantially identical
- However, SOLAHART and SOLAR HUT deceptively similar
 - HART and HUT are visually different and have different meanings
 - But aural impression is decisive
 - nearly imperceptible difference

Solahart Industries PL v Solar Shop PL [2011] FCA 700

Perram J on use as a TM:

- SOLAR HUT used by Solar Shop PL as a TM in
 - on website www.solarhut.com.au
 - in TV, radio, newspaper commercials and telephone sales
 - in domain name www.solarhut.com.au
 - goods available on website under SOLAR HUT
 - domain name largely analogous to a shop front
 - later, in domain name www.solarhut.com.au when used to take consumers to new website at www.sunsavers.com.au

Solahart Industries PL v Solar Shop PL (No 2) [2011] FCA 780

Perram J:

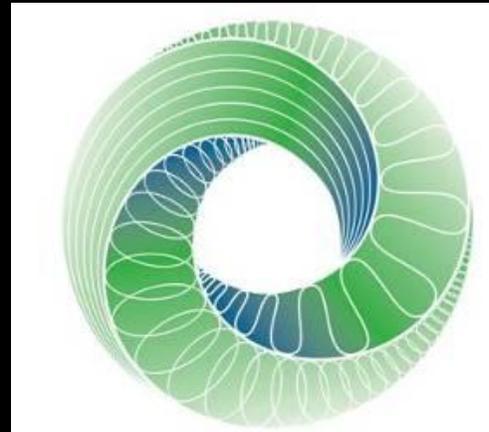
- Injunction granted in TM cases should be limited to restraining identified acts of infringement
 - Not appropriate to grant injunction restraining infringement of TM generally
 - Patent cases distinguished
- Delivery up unnecessary for materials referring to respondent's former brand, which has been replaced
 - No temptation for respondent to breach injunction

Symbion Pharmacy Services PL v Idameneo (No 789) Ltd [2011] FCA 389

- Applicant's device TM:
 - Not limited to any colour, so registered for all colours by operation of s 70



- Respondent used device TM for radiology services (within Applicant's specified services):



***Symbion Pharmacy Services PL v Idameneo (No 789) Ltd* [2011] FCA 389**

Jessup J on deceptive similarity:

- Radiology services are a specialised market
- Evidence of persons accustomed to dealing in that market is essential as to the likelihood of deception or confusion
 - Lord Diplock, *General Electric* (1972) 1B IPR 543
- Without such evidence, the Court should not decide likelihood of deception or confusion for itself
- Applicant called no such evidence, so TM case must be dismissed
- (NB – Applicant succeeded on a contractual case)

(Full Court appeal heard, decision pending, but limited to the contract case.)

N.V. Sumatra Tobacco Trading Co v British American Tobacco Services Ltd [2011] FCA 1051

- NVS applied for LUCKY DREAM and LUCKY DRAW for cigarettes, ashtrays, cigars, tobacco, lighters, matches, smoker's articles
- BAT opposed under ss 44, 60 and 43
- BAT's prior TMs: LUCKIES and LUCKY STRIKE for manufactured tobacco
- TMO [78 IPR 441]: upheld s 44 opposition against all goods:
- No apparent basis for potential customers to entertain a reasonable doubt that LUCKY DREAM or LUCKY DRAW was a deliberate variation of LUCKY STRIKE or LUCKIES
- But, evidence showed a significant prospect of outright mistake by some salespersons when asked for "*a packet of Luckies*"

***N.V. Sumatra Tobacco Trading Co v British American Tobacco Services Ltd* [2011] FCA 1051**

Greenwood J on standard of proof in TM opposition:

- Opponent must establish that TM “*should clearly not be registered*”, not just balance of probabilities
 - Followed:
 - Full Federal Court in *Lomas*, albeit obiter
 - Bennett J in *Torpedoes*, Finn J in *Austereo*, Cooper J in *Health World* and Lander J in *Kowa*
 - Not followed:
 - Gyles J in *Clinique* and *Pfizer* or Sundberg J in *Chocolaterie Guylian*
- Question of higher or lower standard of proof must be determined by Full Federal Court

[NB – balance of probabilities still seems to apply in TMO
eg [2011] ATMO 95; [2011] ATMO 96]

***N.V. Sumatra Tobacco Trading Co v British American Tobacco Services Ltd* [2011] FCA 1051**

Greenwood J finding deceptive similarity:

- LUCKY DRAW and LUCKY DREAM do not bear visual or phonetic resemblance to LUCKY STRIKE
- No other cigarettes in the market contain the word LUCKY
- Retailers and consumers refer to the LUCKY STRIKE brand by the nickname and abbreviation LUCKIES
- Legislative changes have introduced progressive prohibition on various levels of promotion of cigarette products
 - Oral engagement between a customer and retailer has become the dominant mechanism for purchasing
 - Consumer cannot inspect product on shelf
- Transactions occur in some sites which are busy and noisy
- Real likelihood of aural confusion between LUCKIES and LUCKY DRAW and LUCKY DREAM
- Opposition established under ss 44 and 60

N.V. Sumatra Tobacco Trading Co v British American Tobacco Services Ltd [2011] FCA 1051

Greenwood J on similar goods:

- *“It is difficult to see how “ashtrays . . . , lighters, matches or smokers’ articles could be described as “manufactured tobacco”.”*
 - [No further consideration of authorities on “*goods of the same description*”, eg *Gallo, Jellinek* etc]
- ss 44 and 60 opposition not established for those goods, but established for all other goods

Greenwood J on s 43:

- Not satisfied that there is “*some connotation*” in LUCKY DREAM or LUCKY DRAW which would be likely to deceive or cause confusion

***N.V. Sumatra Tobacco Trading Co v British American Tobacco Services Ltd* [2011] FCA 1228**

Collier J, refusing leave to appeal under s 195(2):

- Greenwood J did not incorporate a reputational aspect into his analysis of deceptive similarity under s 44
- Greenwood J was not required to apply a “two-stage” test for deceptive similarity, namely:
 - whether the TMs look alike or sound alike; and
 - if they do, whether the resemblance is likely to deceive

***Austin Nichols & Co v Lodestar Anstalt* [2011] FCA 39**

- Lodestar owned TM WILD GEESE for alcoholic beverages
- Product concept: WILD GEESE Irish whiskey
- Named after Irish soldiers of fortune fighting for France from 1691 to WW2
- Austin made and sold WILD TURKEY bourbon whiskey
- Austin had TM application for WILD GEESE WINES
- Austin sought removal of Lodestar's WILD GEESE TM
 - s 92(4)(b): 3 years non-use admitted by Lodestar

TMO:

- TM removed for wine, fortified wine and wine based spirits
- Lodestar appealed to Federal Court

***Austin Nichols & Co v Lodestar Anstalt* [2011] FCA 39**

Cowdroy J, finding Austin is “*person aggrieved*”:

- *Health World* requires liberal construction of “*person aggrieved*”
- Austin’s and Lodestar’s “*trade rivalry*” encompasses alcoholic and non-alcoholic drinks

Cowdroy J, finding no obstacles to use of TM for s 100(3)(c):

- no causal link between Lodestar’s involvement in ongoing worldwide litigation over WILD GEESE and specific non-use of TM in Australia
- non-use in Australia resulted from Lodestar’s deliberate decision to develop other international markets in priority to establishing its market in Australia
- no relevant obstacle caused by difficulties encountered in sourcing and promoting WILD GEESE whiskey

***Austin Nichols & Co v Lodestar Anstalt* [2011] FCA 39**

Cowdroy J, exercising discretion under s 101(3) to allow Lodestar's registration to remain:

- Lodestar's use of WILD GEESE TM in Australia was not until 3 years after the non-use period - weighs heavily against Lodestar
- Substantial use by Lodestar of WILD GEESE TM in other jurisdictions during and after non-use period
- International profile of WILD GEESE whiskey products is relevant but of limited weight unless profile is sufficient to raise possibility of confusion in Australia if TM is removed
- Lodestar did not abandon its intention to use WILD GEESE TM
- Lodestar's use of WILD GEESE both in Australia and internationally requires that TM remain on register
- Not detrimental to purity of the register, no evidence of confusion

Bad faith – s 62A

Still no Court decisions on bad faith under s 62A

TMO upheld oppositions for bad faith in:

- *Pritchard Pacific PL & Anor v Brendon McCarrison & anor* [2010] ATMO 46
 - Applicant knew of opponent's TM and made misleading statements to clients
- *Marvel Characters Inc v Gary Charles* [2011] ATMO 92
 - Applicant said he chose GHOST RIDER name simply because he liked it, not to trade off Marvel's character
 - However, evidence showed he used indicia specific to Marvel's "*Ghost Rider*" comic book character

No bad faith – s 62A

- *Giga PL v Neville Klaric* [2010] ATMO 121
 - Applicant had applied for numerous TMs and domain names consisting of other traders' TMs plus “*hardcore*” or “*maximum*”
- Insufficient evidence of bad faith:
 - *Ministry of Dance (NSW) v Jason Coleman's Ministry of Dance PL* [2011] ATMO 12
 - *New Look Ltd v Payless Shoes PL* [2011] ATMO 14
 - *Parkside Towbars PL v Tow-Safe PL* [2011] ATMO 17
 - *Q Dance Australia PL v Avant Media* [2011] ATMO 56

Insufficiently distinctive – s 41

HEELGUARD

Grated access covers made of metal for pits, trenches, drains etc

Paige Stainless Pty Ltd v Aco Polycrete Pty Ltd [2011] ATMO 87

Insufficiently distinctive – s 41

BLU-RAY

Class 9: Optical and magneto-optical disc players and recorders for audio, video and computer data etc

Blu-Ray Disc Association [2011] ATMO 51

Insufficiently distinctive – s 41

FARM TO FABRIC

Class 35: wholesaling and retailing services

Sustainable Living Fabrics Pty Ltd v Instyle Contract Textiles Pty Ltd [2011] ATMO
66

Insufficiently distinctive – s 41

SAM THE KOALA and

for chocolates and colouring books



Museums Board of Victoria v Maryann Martinek [2011] ATMO 65



Insufficiently distinctive – s 41

SAM THE KOALA and

for chocolates and colouring books

- Photo in global media after Black Saturday 2009
- The most famous koala in the world
- Facebook page with over 60,000 fans
- An “*icon of hope*” and important focus for the outpouring of public grief and charity in aftermath of the bushfires
- Died on 6 August 2009, body on display at Museum Victoria (like Phar Lap)

TMO: very strong likelihood that other persons might also have thought of that name and wanted to use it on similar goods, eg for fundraising by the Museum, CFA or Wildlife Rescue and Protection Inc

Museums Board of Victoria v Maryann Martinek [2011] ATMO 65



Insufficiently distinctive – s 41

ASK A LOCAL

Class 38: telecommunication of information; and

Class 42: Research services

Phone Directories Company Australia Pty Ltd v Telstra Corporation Limited [2011] ATMO 78

UNIVERSAL

Class 9: Lifejackets etc

Marlin Australia Pty Ltd [2011] ATMO 73

Insufficiently distinctive – s 41

“trade mark consists of the WHITE COLOUR of the bottle in which the goods are sold”

No inherent capacity to distinguish.

Applicant unable to show that the mark is capable of distinguishing for the purposes of s 41(6).

Grove Fruit Juices Pty Ltd [2011] ATMO 1



Insufficiently distinctive – s 41(5)

GRASSPROTECTA and
TURFPROTECTA

Building materials (non-metallic) etc

Boddingtons Limited [2011] ATMO 57

Sufficiently distinctive – s 41

YELLOW

Various classes including telephone books, telecommunication and communication services.

Section 41(5) applied

Phone Directories Company Australia Pty Ltd v Telstra Corporation Limited [2011] ATMO 34

Sufficiently distinctive – s 41

OXALATIN RTU

Pharmaceutical preparations

SANOFI-AVENTIS v EREMAD PTY LTD [2011] ATMO 43

Contrary to law – s 42(b)

FLYING KANGAROO

Not accepted that Flying Kangaroo had been used by QANTAS "as a *trade mark*" therefore s 60 ground failed BUT successful on s 42(b) (via s 52 TPA).

QANTAS Airways Limited v Danniell Amadio [2011] ATMO 84

Not scandalous– s 42(a)

POMMIEBASHER

H.O. Terry Williams: *“the term is ... part of ordinary and acceptable, if colourful and colloquial, language. So far as I can ascertain, it suggests that a person so described is markedly and stridently biased in his/her view of the English. However, the term does not go so far as to suggest that such a person engages in racial vilification, or is prone to verbal abuse or is literally one who “bashes” or assaults English people.”*

Peter Hanlon [2011] ATMO 45

No endorsement required: s 43

HIMALAYAN SPRING MINERAL WATER - “WATER CLOSEST TO HEAVEN”

No endorsement required limiting use to water from Himalayas

Mount Everest Mineral Water Pty Ltd v Himalayan Spring Mineral Water Pty Ltd [2011] ATMO 80

c.f. *Mount Everest Mineral Water Limited v Himalayan Spring Mineral Water* [2010] ATMO 85 where an endorsement was required for the mark:

**HIMALAYAN SPRING MINERAL WATER - BOTTLED
IN THE SACRED HIMALAYAS OF NEPAL TO THE
VIBRATIONAL CHANTING OF TIBETAN MONKS**

Substantially identical TMs

VOYAGER CLUB v VOYAGER

Travel agency services etc v administering “frequent user” credits

South African Airways (Proprietary) Limited v Virtuoso, Ltd [2011] ATMO 30

Substantially identical TMs

DOTEASY v



Computer network address management services v domain name registration

Doteasy Technology Inc v Dot Easy Australia Pty. Ltd. [2011] ATMO 88

Substantially identical TMs

DFO

v

Class 40: Butchery (meat preparation);
food and drink preservation etc

Class 36: Administration of insurance etc



Class 35: Retail services etc

Class 36: Leasing & management

“I consider it likely that consumers would mistakenly assume a connection between, for example, a store identified by a particular trade mark that sells meat, and a trader providing butchery services under a similar trade mark.”

Not substantially identical TMs

**MINISTRY
OF DANCE** v



Dance, performance, education and training related to dance

Ministry of Dance (NSW) Pty Limited v Jason Coleman's Ministry of Dance Pty Ltd [2011] ATMO 12

Deceptively similar TMs - words

DENT WIZARD TOOLS v DENT WIZARD
CHIP WIZARD
PINSTRIPE WIZARD
DETAIL WIZARD

“The trade marks strongly suggests that they are related, ...via the common use of the distinctive element WIZARD preceded by a word with direct application in the automotive repair services industry. The trade marks thus propose a likely common trade provenance for the goods and services in question.”

Dent Wizard International Corporation v Michael Cross [2011] ATMO 55

Deceptively similar TMs - words

ACCENTRO

v

ACCENTURE

Real estate/property brokerage & advice etc

Accenture Global Services GmbH v San Empero Group International Pty Ltd
[2011] ATMO 77

CASHPAL

v

PAYPAL

Advice on finance etc v

financial transaction management

PayPal, Inc. v Credibanc Pty. Ltd. [2011] ATMO 76

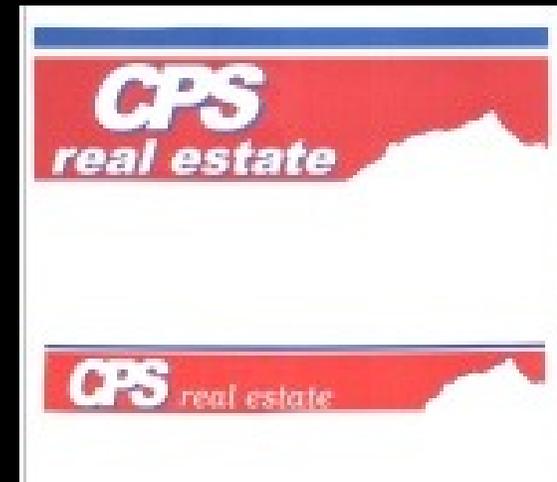
Deceptively similar TMs



v



and



Class 36: Real estate/property brokerage
& advice etc

Complete Property Solutions Pty Ltd. [2011] ATMO 54

Deceptively similar TMs



v



Clothing

Eyewear, footwear etc

Sixty International SA. v Rodi Jeans Pty Ltd. [2011] ATMO 62

Deceptively similar TMs



and

OMEGACHEF

Class 16: paper, cardboard etc

v

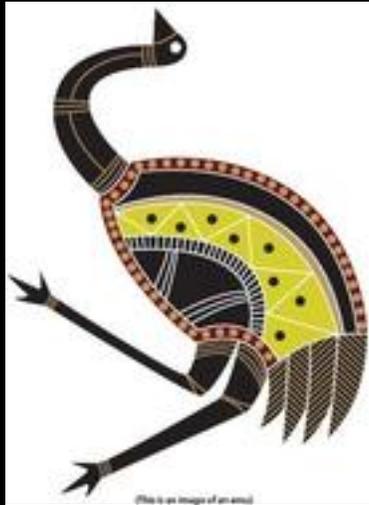


and

OMEGA

Omega SA (Omega AG) Omega Ltd v Mark Robinson, Brenda Robinson
[2011] ATMO 58

Deceptively similar TMs



v



(and some other similar

marks)

Alcoholic beverages (except beer) and wine products

Constellation Australia Limited v Littore Family Wines Pty Ltd [2011] ATMO
47

[Federal Court appeal pending]

Deceptively similar TMs



v



Travel goods and luggage including bags etc

Wenger SA v Courier Luggage Pty Ltd [2011] ATMO 31

Deceptively similar TMs - words

JUNGLE CHEWS v JUNGLE JELLIES

JUNGLE JOLLIES

JUNGLE JUICE

Class 30: various foods including confectionery.

SAF Foods Investments Pty Ltd [2011] ATMO 36

Deceptively similar TMs - words

**NU SKIN
BEGINS**

v

NEW SKIN

Cosmetics, skincare products etc

NSE Products Ltd v International Waters Pty Ltd [2011] ATMO 35

Deceptively similar TMs

MOTOQUIPE v



Retailing of car accessories etc

Champ International Sales Pty Ltd v Che Shing Co Pty Ltd. [2011] ATMO 8

Deceptively similar TMs

MYOC

v

MYOB

Carbon measurement software
& accounting

software

Business

MYOB Technology Pty Ltd v John Miller [2011] ATMO 5

Deceptively similar TMs



and



v KATHMANDU QUICK DRY

and



Clothing, footwear, headgear

clothing, headgear, footwear.

Empire Brands Pty Ltd [2010] ATMO 129

Deceptively similar TMs

TAcT

v

TAFT

Beauty care products; soaps; skin care preparations for the hair

Cosmetic

Henkel AG & Co. KGaA v Mary Vlachiotis [2011] ATMO 4

Deceptively similar TMs – words

BRIVIS PROFILER v **PROFILE**

Class 11: Ducted evaporative air conditioners

Climate Technologies Pty Ltd v Carrier Air Conditioning Pty Ltd. [2011] ATMO 49

Deceptively similar TMs – words and devices

hairfood

v



&



Class 3: Hair care preparations; shampoos; rinses; conditioners;

Isabella Thomas Holdings Limited [2011] ATMO 52

(Mark would also have been rejected pursuant to s 41(5) as it was regarded as having only limited capacity to distinguish and no evidence of capacity to do so was provided).

Not deceptively similar TMs - words

YELLOW

v

YELLOW BUS

YELLOW DUCK

YELLOW ZONE

(and others)

Phone directories etc

Various classes

Phone Directories Company Australia Pty Ltd v Telstra Corporation Limited [2011] ATMO 34

Not deceptively similar TMs - words

TIRON

paints

v

TIMIRON

pearlescent pigments for use as
ingredients for cosmetic preparations

Merck KGaA v Advanced Intellectual Holdings Pty Ltd. [2011] ATMO 79

Not deceptively similar TMs - words

SOUL REBELLION v REBELLION

Various classes including sound and video records, sound and video recording and reproduction apparatus

Chris Kingsley v David Scott [2011] ATMO 20

Not deceptively similar TMs - words

vNET v **VISIONNET**

Video conference services etc

Vantage Systems Pty Ltd v IVision Pty Ltd [2011] ATMO 90

Not deceptively similar TMs - words

OXI v **OVI**

Various classes incl jewellery, watches, mobile phones & retail

Nokia Corporation v Gavin Hutcheson [2011] ATMO 10

Not deceptively similar TMs - words

RIVERS v **RIVER ISLAND**

Various classes incl clothing and retail services

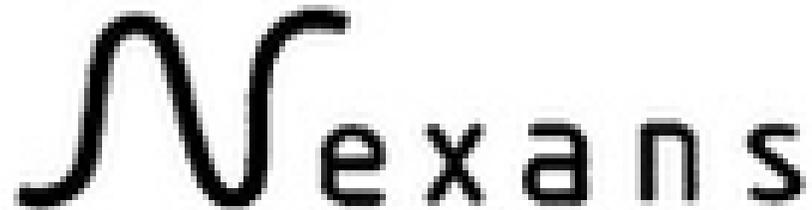
Rivers (Australia) PL v River Island Clothing Co Ltd [2011] ATMO 10

Not deceptively similar TMs – words and devices



NEX1

v



Nexans

Networks cables, network connectors, LAN cables etc

Nexans v Nex 1 Technologies Co., Ltd [2011] ATMO 24

Not deceptively similar TMs – words and devices

**ADULT
HARDCORE
MATCHMAKER** v

(and variants)

ADULT MATCHMAKER &



Class 45: Registration of domain names etc

Class 45: Dating and
personal services

“The fact that the opponent’s and applicant’s services are in the same class does not mean that those services are of the same description.”

Giga Pty Ltd v Neville Klaric [2010] ATMO 121

Not deceptively similar TMs – words and devices

WHITE LINE SKUNK

v



and



Class 25: clothing and Class 35: retail

Nerrin and Glenn Warr [2011] ATMO

Not deceptively similar TMs – words and devices

SPARQ

v

SPARCO and

Clothing

The Sparco logo features the word "sparco" in a lowercase, rounded, sans-serif font. The letters are white with a slight shadow effect. Below the text is a thick, white horizontal bar that spans the width of the word.

Sparco SpA v Nike International Ltd [2011] ATMO 81

Angel. M

v

ANGELS

Clothing

Major League Baseball Properties, Inc v Blooming Angel Pty Ltd [2011] ATMO 83

Not deceptively similar TMs – words and devices



v **MULTIWAY**

Class 28: Gaming machines etc

Ainsworth Game Technology Limited v IGT, a Nevada corporation
[2011] ATMO 53

Not deceptively similar TMs – words and devices



v



Various classes incl transportation of scrap metals v
ships/boating/transportation

CMA Corporation Ltd v CMA CGM [2011] ATMO 95

Not deceptively similar TMs – words and devices



v



Discount services etc

and similar marks

American Airlines, Inc. v Member Advantage Pty Ltd [2011] ATMO 13

Confusion likely: s 60



v



(and variants)

Jacuzzi Inc v Jazzi Pool & Spa Products Co., Ltd [2011] ATMO 39

Confusion likely: s 60

K-Y SENSUAL SILK v SYLK and

Massage oils and personal lubricants



*Geneva Marketing Pty Ltd v Johnson & Johnson, A New Jersey Corporation.
[2011] ATMO 19*

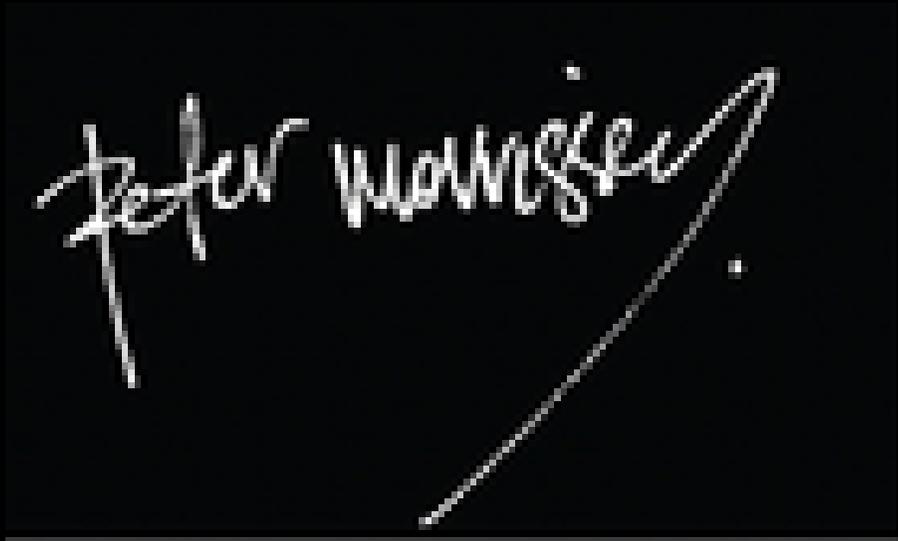
Confusion likely: s 60

PETER MORRISSEY

and

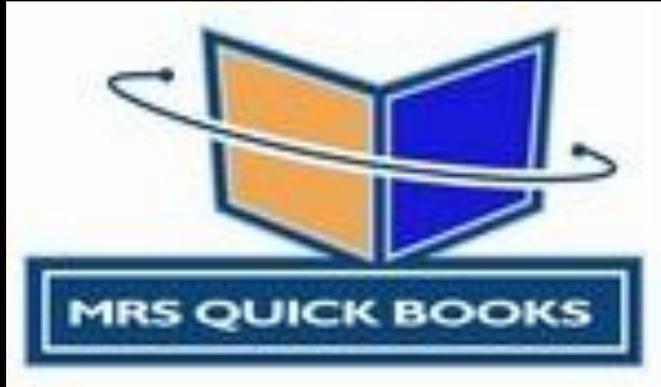
v

MORRISSEY



M Webster Holdings Pty Ltd v Peter Morrissey Pty Ltd [2011] ATMO 23

Confusion likely: s 60



v QUICKBOOKS

Class 9: Computer software

Class 16: Instruction manuals

Class 35: Accounting; business accounts management etc

Intuit Inc v Cadcam Computer Design Pty Ltd [2011] ATMO 50

Confusion likely: s 60

**ADULT
HARDCORE
MATCHMAKER**

(and variants)

v

ADULT MATCHMAKER &



Class 45: Registration of domain names etc

Class 45: Dating and personal services

Giga Pty Ltd v Neville Klaric [2010] ATMO 121

That's all folks . . .
