

## TRADE MARKS ACT 1995

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

Re: Oppositions by Golden Land Group Pty Ltd and by Haoliang Sun to registration of trade mark application 1041262 (16 & 41) - **CCS (stylised) & 3 Chinese Characters** - filed in the name of Chinese Culture School Inc

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<b>DELEGATE:</b>	<b>Michael Kirov</b>
<b>REPRESENTATION:</b>	<b>Opponents: Mark Goldblatt of Counsel, instructed by Michael Butcher of Lander &amp; Rogers Lawyers</b> <b>Applicant: Sue Gatford of Counsel, instructed by Michael Paphazy of Maddocks, Lawyers</b>
<b>DECISION:</b>	<b>2009 ATMO 12</b> <b>s.52 opposition: grounds under ss. 44, 58, 60 and 62(b) pressed.</b> <b>Grounds under ss.58, 60 and 62(b) not established.</b> <b>Ground under section 44 established; however Applicant entitled to rely on section 44(4) in respect of “Education services” in Class 41.</b> <b>No award of costs made.</b>

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#### Background

1. These are two essentially identical oppositions brought by Golden Land Group Pty Ltd (“GLG”) and by Haoliang Sun (“Mr Sun”) (collectively “the Opponents”) pursuant to s.52 of the *Trade Marks Act 1995* (“the Act”) to registration of the trade mark subject of application number 1041262 in the name of Chinese Culture School Inc (“the Applicant”). Since the Opponents filed essentially identical Notices of Opposition (“the Notices”) on the same day, have engaged the same legal representation throughout and rely on the identical evidence, both oppositions were heard together as if a single opposition brought by joint-opponents. It is accordingly expedient to deal with both oppositions in this one decision.

2. Details of the opposed application are as follows:

Application Number: 1041262  
Priority Date: 10 February 2005  
Services: **Class 16:** Printed matter including newspapers  
**Class 41:** Education services and publishing services

Trade Mark:



(“the Trade Mark”)

Endorsements: The applicant has advised that the Chinese characters appearing in the trade marks (sic) may be transliterated as XIN JIN SHAN and translated into English as NEW GOLDEN MOUNTAIN or NEW GOLDEN LAND.

Provisions of subsection 44(4) applied.

3. The matter was heard before me as delegate of the Registrar of Trade Marks on 18 September 2008 in Melbourne. Mark Goldblatt of Counsel, instructed by Michael Butcher of Lander & Rogers Lawyers, appeared for the Opponents. Susan Gatford of Counsel, instructed by Michael Paphazy of Maddocks Lawyers, appeared for the Applicant.
4. At the heart of these oppositions is the Opponents' claim to prior rights in the Chinese name or phrase 新金山, which appears as a significant element in the Trade Mark. This name or phrase is made up of three very common Chinese characters, with the approximate pronunciation in Mandarin (according to the Pinyin system) of XIN, JIN and SHAN, and bearing the primary meanings of "new", "gold" and "mountain" respectively. Hereafter I refer to this name or phrase as "the characters 新金山".
5. It should be noted that all of the deponents in this case appear to be native speakers of Mandarin Chinese and often refer in their (English) declarations to the characters 新金山 simply as "the Chinese characters 'Xin Jin Shan' ". Often, however, the deponents also refer to the "words" 'XIN JIN SHAN', by which it is usually apparent from the context they are referring to those "words" rendered in Roman letters, rather than to their representation in Chinese characters. Where necessary I refer hereafter to these as "the words XIN JIN SHAN".
6. I mention, too, that the evidence indicates that the characters 新金山 have in use been rendered in various fonts and in various styles of calligraphy. I have not however considered this a relevant factor in this decision.

### **Grounds of Opposition**

7. The Notices list six grounds corresponding to sections 41, 43, 44, 58, 60 and 62(b) of the Act, in addition to a general request for exercise of the Registrar's discretion in the Opponents' favour. At the hearing Mr Goldblatt indicated the Opponents would not be pressing the grounds based upon sections 41 and 43 and I formally find these

grounds abandoned. Although not listed in the Notices at all, Mr Goldblatt initially also sought to press grounds based on sections 42(b) and 58A of the Act. The Applicant, as far as I am aware, had no notice of this prior to the hearing. While I do not believe their inclusion was likely to, or indeed *could*, have altered the ultimate result in these oppositions, I do not consider these two grounds in this decision.

8. For the sake of completeness I mention that section 58A was created by item 29 of Schedule 1 to the *Trade Marks Amendment Act 2006* (“the Amendment Act”). Its application is set out in item 30(1) of Schedule 1, which says “The amendment made by item 29 applies to...applications for registration of trade marks made after the commencement of this item”. The Amendment Act further specifies that items 29 and 30 were to commence on the day the Amendment Act received Royal Assent. That day was 23 October 2006. The opposed application was filed well before this date, on 10 February 2005, and thus s.58A is not available to the Opponents in any event.
9. I confirm I am proceeding on the basis that the Opponents bear the onus of establishing one or more grounds of opposition on the balance of probabilities<sup>1</sup>.

### **Evidence**

10. The parties filed Evidence in Support, Evidence in Answer and Evidence in Reply and, as it eventuated by consent, further Evidence in Answer and further Evidence in Reply, as set out below:

#### ***Evidence in Support***

- Statutory declaration by Haoliang Sun made 11 December 2006, with Exhibits HS 1 to HS 24 (“Haoliang 1”)
- Statutory declaration by Tsebin Tchen made 11 December 2006 (“Tchen”)
- Statutory declaration by Baoquan Chen made 11 December 2006 (“Chen 1”)

#### ***Evidence in Answer***

- Statutory declaration by Ai Yun Liu made 20 November 2007, with Exhibits AL-1 to AL-61 (“Liu 1”)
- Statutory declaration by Shu Jun Li made 20 November 2007, with Exhibits SL-1 to SL-3 (“Li”)
- Statutory declaration by James Ye made 20 November 2007 (“James Ye 2”)

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<sup>1</sup>Following *Pfizer Products Inc v Karam* (2006) 70 IPR 599 at paragraphs [6] to [26]

- Statutory declaration by Hong Zhu made 20 November 2007 (“Zhu”)
- Statutory declaration by Jessica Li made 15 November 2007 (“Jessica Li”)
- Statutory declaration by Daniel Ye made 19 November 2007 (“Daniel Ye”)
- Statutory declaration by Michelle Mai made 18 November 2007, with Exhibit MM-1 (“Mai”)
- Statutory declaration by Yaping Jiang made 15 November 2007, with Exhibits YJ-1 to YJ-2 (“Jiang”)
- Statutory declaration by Gang Wang made 21 November 2007 (“Wang”)

***Evidence in Reply***

- Statutory declaration by Baoquan Chen made 18 February 2008 (“Chen 2”)
- Statutory declaration by Liya Lin made 20 February 2008, with Exhibit LL 1 (“Lin”)
- Statutory declaration by Zhou Jian Hua made 21 February 2008 (“Hua”)
- Statutory declaration by Hui Yu Xian made 21 February 2008 (“Xian”)
- Statutory declaration by Haoliang Sun made 21 February 2008, with Exhibits HS 25 to HS 37 (“Haoliang 2”)

***Further Evidence in Answer***

- Statutory declaration by Michael Joseph Emil Paphazy made 4 September 2008
- Statutory declaration by Ai Yun Liu made 4 September 2008, with Exhibit AL-62 (“Liu 2”)

***Further Evidence in Reply***

- Statutory declaration by Haoliang Sun made 16 September 2008, with Exhibits HS 38 to HS 41 (“Haoliang 3”)

11. At the commencement of the hearing Ms Gatford sought to formally incorporate into the Applicant’s evidence a statutory declaration made by James Ye on 30 November 2005 (including Exhibit JY-1 and referred to hereafter as “James Ye 1”). The Applicant had filed the original of this declaration with IP Australia on 2 December 2005 in support of (then pending) application 1041262 and in particular, relying on s.44(4) of the Act, to assist in overcoming the citation of GLG’s registration 979149 新金山 (pronounced XIN JIN SHAN) in Classes 16 and 41. The Opponents were already aware of this declaration and its contents, since the declaration is explicitly referred to, and indeed its contents challenged, by Mr Sun in Haoliang 1 in the

Opponents' evidence in support. Indeed, the Opponents' ground of opposition under s.62(b) of the Act is based in part upon the contents of James Ye 1. After hearing submissions from Mr Goldblatt I accordingly confirmed I would admit the statutory declaration in question and, to the extent that it was relevant to the issues to be decided, would take its contents into account.

### **The Parties**

12. Before discussing the four specific grounds pressed it is necessary to say something about the parties and their history leading up to these oppositions, as disclosed through the parties' evidence. In doing so I am mindful that there are some discrepancies in the details of the evidence given by several of the declarants, some of which have been explicitly and painstakingly challenged in later filed evidence. That is perhaps to be expected when a number of people are asked to recall details of events which occurred more than ten years ago. Nevertheless, the following outline emerges from the evidence as a whole.

### ***The Applicant***

13. The Applicant is an incorporated association in Victoria under the *Associations Incorporation Act 1981 (Vic)* ("the AI Act"), with its registration as such dating from 20 September 1993. Under this legislation an "association, society, club, institution or body formed or carried on for any lawful purpose and that has not less than five members" may apply for registration and, once registered, "has perpetual succession, may have a common seal, has power to acquire or hold (whether on trust or absolutely) and dispose of property and is capable of suing and being sued" (section 14). Section 3 of the AI Act defines "property" as including "real and personal property and any estate or interest in any real or personal property". This thus includes a trade mark registration, which section 21(2) of the (Trade Marks) Act indicates is "personal property".
14. The six original members of the Applicant on 20 September 1993 were Mr Sun (being one of the current Opponents), his wife Liya Lin, Shu Jun Li and his wife Ai Yun Liu, James Ye (who is the Applicant's "Public Officer" as defined in the AI Act) and his wife Hong Zhu. Somewhat surprisingly this membership remained unchanged as at the date of the hearing, although this appears to be a formal matter and not one of any substance to the issues in the oppositions themselves. Mr Sun himself states in

Haoliang 1 para 23 that he has “not been associated with [the Applicant] since 2005” and refers to “splitting with the Applicant in 2005” in paragraph 24 of Haoliang 2. Baoquan Chen (“Mr Chen”), a director and shareholder of GLG and business partner of Mr Sun, says in paragraph 7 of Chen 1 (made on 11 December 2006) that Mr Sun then had “no involvement” with the Applicant. For the record and explicitly referring to Mr Chen’s statement, the Applicant’s Public Officer, James Ye, states in James Ye 2 that “This is misleading for the reason that Mr Sun is still a member of the Applicant as he has not taken any active steps to resign his membership from the Applicant.” As indicated, however, I have not considered this issue relevant to my decision.

***Haoliang Sun***

15. Mr Sun was an Assistant Professor at the Central Academy of Fine Arts in Beijing, PRC before coming to Australia in 1991 with his son to join his wife, Liya Lin, herself formerly a lecturer at the same Beijing institution. At the time Liya Lin was teaching at various language schools in Melbourne and Mr Sun also initially taught Chinese at Monash University and another language school in Melbourne.

***Golden Land Group Pty Ltd (“GLG”)***

16. According to the Australian Securities & Investments Commission’s (“ASIC”) online records GLG was incorporated on 23 April 2001. Mr Sun explains that he, Mr Chen “and two other people who are members of the Applicant” had in 1995 “commenced a printing business and registered the business name ‘Golden Land Printing & Co’” (in English). After limited success initially these “two other people” (who are not named) left the business at some point and eventually in the year 2000 Mr Sun too “transferred [his] interest” in the ‘Golden Land Printing & Co’ printing business to Mr Chen. By 2001 Mr Chen apparently asked Mr Sun if he could operate the printing business through a company he (Mr Chen) would like to incorporate under the name ‘Golden Land Group Pty Ltd’ and Mr Sun agreed (Haoliang 1 paras 26-28 and 35; Chen 1 paras 3-5).
17. Mr Chen says that when Mr Sun “transferred to me his interest in the business known as Golden Land Printing & Co” in 2000 Mr Sun “consented to me continuing to use that name and the Mark on the understanding that he remained the owner of the Mark”. However, Mr Chen nowhere in his declaration identifies what he understands

by the (capitalized) word “Mark”. I mention too that the only explanation Mr Chen gives as to why Mr Sun’s permission would have been required is that, “He is a highly respected man and teacher and it is well known that he devised and owns the name ‘Xin Jin Shan (Golden Land)’ and that any business which uses those words in its name is one in which he has an involvement and which accordingly is to be highly regarded.”

18. Mr Sun became a director and shareholder of GLG “from 2004” (Haoliang 1 paras 32 and 36; Chen 1 paras 3 and 4), it being apparent from ASIC’s database that this occurred on or about 13 October 2004. I understand from this that Mr Sun was in fact not involved with the printing business of Mr Chen and GLG in any capacity as owner of the business from the time he “transferred” his interest in the business to Mr Chen in 2000 until he became a shareholder and director of GLG on or about 13 October 2004.

***Establishment of Focus Culture School***

19. In November or December of 1992 Mr Sun acquired a part interest in a monthly Chinese language magazine called ‘Focus’ (in English, with a corresponding name in Chinese characters), which had been published in Melbourne since October 1991, and was engaged as its editor-in-chief (Haoliang 1 para 8, Haoliang 2 para 9). He became full owner of the magazine “in 1993”, being some date after 1 November 1993 (Haoliang 1 paras 9 and 10; Lin para 5).
20. In late 1992 Mr Sun says he “decided to start my own school to teach Chinese children the Chinese language so that they could maintain their contact with and knowledge of their homeland”. As Mr Sun puts it, he then “asked other people I had got to know to help me run the Chinese language school” (Haoliang 1 para 19). Mr Sun indicates that at least some of these “other people” were Mr Sun’s wife Liya Lin, Shu Jun Li and his wife Ai Yun Liu, (all being members of the Applicant), and a Mr Li Jiang Hong and his wife Hui Xu (Haoliang 2 paras 6 and 11). This last mentioned couple are not referred to again in the Opponents’ evidence, which does not take issue with Ai Yun Liu’s statement that, “One week after opening the school, Li Jiang Hong and his wife, Hui Xu, withdrew from assisting at the school.” (Liu 1 para 10). My understanding from the totality of the evidence is that Mr Hong and Ms Xu took no significant part in events thereafter.

21. Mr Sun says that “shortly after becoming a part owner of ‘Focus’ [magazine] in [November or December] 1992” he also suggested to his then co-owner, a Mr Shi Hui Yan, “that the magazine should set up a weekend Chinese language school”. He says that, “While Mr Yan was not interested in running a school, he agreed that I could use the name of *Focus* magazine to establish such a school. Mr Yan and I came to a verbal agreement that (a) I could use the name *Focus* for the school, (b) I could use the *Focus* magazine to write articles to publicise and promote the *Focus Culture School* and (c) I could use the telephone, photocopier and other resources of *Focus* magazine.” (Haoliang 2 para 10).
22. It is not immediately apparent why, (other than out of courtesy), Mr Sun would have needed Mr Yan’s “verbal agreement” to start up a weekend language school under the name ‘Focus Culture School’ and I have in any event not considered the issue relevant to my decision. Mr Sun says he did so because the magazine “was very influential in the Chinese community”. The November/December 1992 ‘Focus’ magazine was however only the 11<sup>th</sup> edition to be published. No circulation figures, advertising revenues or other such details are in evidence. I note too that, notwithstanding the “influence” the magazine may have had in December 1992, Mr Sun immediately changed its name from ‘Focus’ as from January 1994 when he had become the magazine’s full owner and the uncontradicted evidence of Ai Yun Liu is that the magazine ceased publication altogether after 1994 (Liu 2 para 5).
23. The Applicant and Mr Sun appear to agree that the final decision to establish the school and to call it *Focus Culture School* was made at a party or social gathering at the home of Shu Jun Li and Ai Yun Liu on or about 12 December 1992 (Sun 2 para 12; Liu 1 para 5; Li para 5). Mr Li indicates that all six members of the Applicant, to whom he refers as the “founders of CCS [Chinese Culture School]”, were present and took part in these decisions (Li 1 para 5), although Mr Sun says James Ye and his wife Hong Zhu “were not founders of Focus Culture School and were not involved until around February 1993, when they enrolled their son, Daniel Ye, as a student...” (Haoliang 2 para 6). He does note that Hong Zhu in fact commenced teaching maths at the school “a few weeks after the school term commenced” but that “it was not until September 1993 when the school was registered as an association called Chinese Culture School Inc that James Ye and Hong Zhu became members of CCS” (Haoliang

2 para 6). I mention that it is somewhat unclear to me what Mr Sun understands by “members of CCS”, given that this terminology appears to be taken from the AI Act and yet Chinese Culture School Inc did not become registered under the AI Act until September 1993.

24. As regards adoption of the name ‘Focus Culture School’, the Applicant contends that, as Shu Jun Li puts it, “The school had no connection with Focus Magazine except for the fact that Mr Sun was a founding member of the school.” (Li para 6). Mr Li’s wife, Ai Yun Liu, says “This name was derived from the name of Mr Sun’s magazine. It did not occur to me at the time that the name of the school would be of any importance, as the original intention of setting up the school was to benefit our own children and the children of our close friends.” (Liu 1 para 14).
25. For his part, Mr Sun asserts throughout his declarations that ‘Focus’ magazine had a close connection with the field of education generally and that, “Without the initial support of the magazine and my involvement with the magazine both as editor-in-chief and owner, the establishment of the school would not have been possible and that support from the magazine continued long after the school opened.” (Haoliang 3 para 4). While it is apparent the magazine lent support to the establishment of the school (and thereafter), how critical that support was is disputed by the Applicant. The Applicant also disputes the magazine necessarily had a close connection with the field of education generally, a view with which, on the evidence submitted by both the Applicant and Mr Sun, I would tend to agree. Once again, however, I do not believe either issue to be significant in these oppositions or relevant to my decision.
26. The first public announcement concerning the school was made in the January 1993 issue of ‘Focus’ magazine under the heading “Good News: *FOCUS Cultural School* Comes” (according to one of two English translations provided with Mr Sun’s evidence). The (first English translation of the) announcement begins, “With great support and endeavour from people of various lines, the *FOCUS Cultural School*, organized by the journal *FOCUS*, is ready to welcome students on February 6<sup>th</sup>, 1993...” (Haoliang 2 para 13, Exhibit HS25). The announcement then gave brief details of the classes being offered and when and how to enroll.

27. For the record I note the second translation of this announcement Mr Sun has for some reason also provided (Haoliang 3 para 3(a) Exhibit HS 38) is slightly different:

With support and efforts from all parties, preparations are completed for establishment of the Focus Culture School, which has been founded by *Focus* magazine. It will be formally opened on 6 February 1993.

28. The 'Focus Culture School' held its first classes on the weekend commencing 6 February 1993 (Li paras 7 to 12, Haoliang 3 para 3(a), Exhibit HS38). On that first day there were six students in attendance, three being children of members of the Applicant (including Simon Sun, the son of Mr Sun and his wife Liya Lin), two being the children of "close friends" of Ai Yun Liu and the sixth being the child of Li Jiang Hong and his wife Hu Xia mentioned in paragraph 17 above (Liu 1 para 7).

***Incorporation of the Applicant***

29. Ms Liu relates that, "As a result of the collective efforts of myself, Shu Jun Li, James Ye, Hong Zhu, Mr Sun and Liya Lin (Founding Members), the enrolment of students in the school increased steadily during 1993. Subsequently, the Founding Members decided to register an incorporated association in the name of the Applicant to run the school." (Liu 1 paras 12 and 13, Exhibit AL-1). As mentioned earlier, registration of 'Chinese Culture School Inc' under the AI Act took place on 20 September 1993.
30. I pause at this point to consider one of the consequences of incorporation under the AI Act. The AI Act specifies that the association have a set of formal (written) "rules". The rules must make provision for the various matters listed in the Schedule to the AI Act and if the association has not formulated its own rules then the "model rules" prescribed under the AI Act apply by default. The Applicant's rules, which are not mentioned in the parties' evidence, should confirm such matters as how many members are required to constitute a quorum capable of making decisions or entering binding contracts in the name of, and with the authority of, the Applicant as a whole.
31. Mr Sun does claim that, "In September 1993, when the school was officially registered as an association, I became the chairman" (Haoliang 2 para 3), although "chairman" is not a term used in the AI Act and I have not considered the claim relevant to my decision. I am satisfied from the evidence that following incorporation the Applicant, however it may have organized its internal governance, undertook the management of the school, and did such things as enter employment contracts with

teachers, in its own name, ‘Chinese Culture School Inc.’, and not in the name of any of the individual members.

32. Moreover, in the absence of evidence as to the content of the incorporated association’s rules I am proceeding on the basis that the Applicant must be effectively constituted such that Shu Jun Li, Ai Yun Liu, James Ye and Hong Zu, acting collectively, have at all times had the capacity to bind the Applicant, whether or not with the express consent of Mr Sun and his wife Liya Lin. I note this view appears consistent with the fact that the four members of the Applicant mentioned have continued to operate their school since splitting from Mr Sun and his wife in 2005 and indeed have taken actions such as the filing and prosecution of application 1041262 in the face of opposition by Mr Sun.

***Adoption of the name Xin Jin Shan and the Characters 新金山***

33. All the parties appear to agree that in November 1993 the six members of the Applicant unanimously decided to change the name of ‘Focus Culture School’ to ‘Xin Jin Shan Culture School’ (in English, with the corresponding name in Chinese incorporating the characters 新金山 ) and that this change took effect from January 1994 (Haoliang 1 para 21; Haoliang 2 para 18; Lin para 8; Liu 1 para 15; Li para 13; James Ye 2 paras 4 and 5; Zhu paras 4 and 5).
34. Mr Sun and his wife Liya Lin on the one hand, and the four other members of the Applicant on the other, disagree as to who first proposed this new name and on details such as at whose home the decision to change the name was made. Much of the evidence of the parties in fact concentrates on who first thought of the name (which concept Mr Sun refers to throughout his evidence as “authorship”) and who proposed the change. As discussed further below, however, I have not considered any of these issues relevant to my decision.
35. In November 1993, after becoming sole owner of ‘Focus’ magazine, Mr Sun says he “immediately commenced considering how to change the name” of the magazine (Haoliang 1 paras 9 and 10) and he consequently decided to rename it ‘新金山’, subtitled in English as ‘Golden Land’. This was announced in the “November/December 1993” issue of ‘Focus’ magazine, in which the corresponding change to the name of ‘Focus Culture School’ was also apparently first publicized.

The English translation provided (Haoliang 3 Exhibit HS40) gives, in part, the following, somewhat oblique, explanation of the new name's connotations and apparent aptness:

What a similarity it is by comparing what we are doing with what our ancestors have done. Like the old generations, we came here to seek for the full life of freedom, wealth and happiness by leaving the motherland, going across the seas with the sacrifice of blood and tears. Then, XINJINSHAN, the name fully representing our bitter and proud, came upon us. (sic)


36. The announcement (as translated) continues:

Therefore, in order to fulfill the need of the future, we determine to transfer the current journal FOCUS to a brand new name called XINJINSHAN from January 1994. ... At the same time, the 'FOCUS Cultural School' which was beloved in the past one year will be renamed as 'XINJINSHAN Cultural School'. Here, I want to highlight that the important reason we determined to change the names both of the journal and our school lies in the consideration of the further development for the children and our school.

37. On 30 December 1993 Mr Sun registered 'GOLDEN LAND (XIN JIN SHAN) MONTHLY MAGAZINE' (that is, in English) as a business name in Victoria (Haoliang 1 para 16, Exhibit HS3). I note in passing that there is no evidence that Mr Sun, (or anyone else for that matter), applied to register 'XIN JIN SHAN CULTURE SCHOOL' (or similar) as a business name at this time (or at any time before the filing of application 1041262), and my check of ASIC's online records appears to confirm this.

38. The first edition of Mr Sun's magazine with the new name issued in January 1994. In an editorial in that issue Mr Sun explains that the characters 新金山, which as mentioned literally translate into English as "new gold mountain", allude to a once popular colloquial name for Victoria (or Melbourne) used by Chinese after gold was discovered in Victoria in the mid 19<sup>th</sup> century (by analogy to the then popular name for California or San Francisco which was "Jiu Jin Shan" or "old gold mountain") (Haoliang 1 para 13, Exhibit HS1). I note that Ai Yun Liu (Liu 1 para 16) and Gang Wang (Wang para 7), a professional English/Chinese translator and interpreter, also mention the characters 新金山 allude to the city of Melbourne and say they are still "frequently" used by the Chinese community in Melbourne or Australia when referring to Melbourne.

*The Applicant's Adoption of the Opposed Trade Mark ("the Trade Mark")*

39. In addition to the Chinese characters 新金山 the Trade Mark of course contains a relatively distinctive logo element comprising a stylized rendition of the Roman letters CCS, namely  ("the CCS Logo").
40. Yaping Jiang, now a principal of an unrelated school but formerly a teacher at the Applicant's school from 1995 to 2001, explains that, "In March 1995, the Applicant promoted a public competition in the Chinese Weekly newspaper for the development of a logo for CCS." (Jiang para 5)<sup>2</sup>. Ms Jiang exhibits a copy of the newspaper advertisement published on 10 March 1995 along with an English translation (Exhibit YJ-1) and I note the translation provided begins with the words, "Xin Jin Shan Culture School is a weekend school which has been registered with the Victorian government." The advertisement also apparently states that, "The copyright [in the winning logo] will be owned by our school."
41. Ms Jiang says the winning logo (designed by a Mr Fu Hong) was announced in the Chinese Weekly newspaper on 8 May 1995 and she exhibits that announcement and an English translation (Exhibit YJ-2). The announcement (as translated) explains that the winning logo "is framed around the English letters 'CCS', which is short for the English name of our school – 'Chinese Culture School' ". The (English translation of the) announcement concludes with, "Our school logo has been officially registered, with its copyright owned by the school. No individuals or organizations are allowed to copy or use it without approval. Actions will be taken against any offenders." It is nowhere explained in the Applicant's evidence what "officially registered" might refer to in this context.
42. Both the advertisement of 10 March 1995 and the announcement of 8 May 1995 prominently feature the name 'Xin Jin Shan Culture School' (in both Chinese characters and in English), but that there is no mention of Mr Sun or of any other individual connected with the school.
43. At some point in 1995 (or from January 1996 at the latest) the Applicant commenced using the Trade Mark. As Ai Yun Liu puts it (Liu 1 para 21),

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<sup>2</sup> I note in passing that Mr Sun's magazine apparently did not carry this advertisement, consistent on the face of it with the evidence of Ai Yun Liu that to her knowledge the magazine ceased publication altogether after 1994 (Liu 2 para 5).


The Applicant commenced using the three Chinese characters ‘新金山’ as its trade mark immediately after the school was renamed in January 1994. Following the adoption of the school logo designed by Hong Fu in 1995, the characters ‘新金山’ were used in conjunction with the logo, and have been used on a continuous basis by the Applicant since then.


44. Exhibited with Ms Liu’s declaration are copies of 45 of the “newsletters” (in Chinese) published by the Applicant (and part translations thereof in English) from the 5<sup>th</sup> issue dated January 1994 up to the 74<sup>th</sup> issue dated October 2002 (Exhibits AL-4 to AL-49). It is apparent from these that the characters 新金山 (rendered in the style 新金山) appear on the masthead without the CCS Logo up to the December 1995 (20<sup>th</sup>) issue, but appear together with the CCS Logo (with the characters rendered in yet another, slightly different, style of calligraphy) in essentially the same configuration as the Trade Mark as from the January 1996 (21<sup>st</sup>) issue.
45. It is convenient to here mention that neither Mr Sun nor GLG makes any claim as to rights in the CCS Logo.



***Events after 1995***

46. There appears to be no substantial disagreement amongst the parties as to what occurred from 1995 up to the 10 February 2005 filing date of the opposed application. Key events spanning this period are set out in the chronology below, which for ease of reference also includes some of the more significant events discussed above:

<b>Date</b>	<b>Event</b>
October/November 1992	Mr Sun acquires a part interest in ‘Focus’ magazine
12 December 1992	Mr Sun, his wife Liya Lin, Shu Jun Li, his wife Ai Yun Liu, (and possibly others) decide to start operating a Chinese language school in Melbourne and agree to call it ‘Focus Culture School’
January 1993	‘Focus’ magazine announces the opening of the school on 6 February 1993 and invites enrollments
6 February 1993	The ‘Focus Culture School’ commences classes

20 September 1993	The Applicant is registered in Victoria as an incorporated association
November 1993	<p>The Applicant (with all six members agreeing) decides to change the name of ‘Focus Culture School’ to ‘Xin Jin Shan Culture School’ (and corresponding name in Chinese characters) as from January 1994;</p> <p>Mr Sun becomes full owner of ‘Focus’ magazine, which announces in its November/December issue the change of name as from January 1994 of both the magazine and the school</p>
30 December 1993	Mr Sun registers ‘GOLDEN LAND (XIN JIN SHAN) MONTHLY MAGAZINE’ (in English) as a business name in Victoria
January 1994	<p>Mr Sun changes the name of ‘Focus’ magazine to ‘新金山’ (being the characters 新金山 in a particular style), sub-titled as ‘GOLDEN LAND’ in English on the front cover, as from the January 1994 edition</p> <p>The school commences use of the characters 新金山 as (the non-descriptive part of) its Chinese name</p>
10 March 1995	The Applicant advertises in the ‘Chinese Weekly’ newspaper a competition for the design of a logo for the school, with copyright in the winning design to be owned by the school
8 May 1995	The Applicant publishes the winning logo design in the ‘Chinese Weekly’ newspaper, this being the  design appearing in the opposed trade mark (“the CCS Logo”)
2 June 1995	Mr Sun, Shu Jun Li, Ai Yun Liu (all members of the Applicant) and Baoquan Chen register the (English) business name ‘Golden Land Printing & Co’ in Victoria and commence a printing business under that name. Mr Li and Ms Liu “depart” from the business after its limited success initially (Haoliang 1 para 27)

January 1996	The Applicant adds the  design to the name of the school as it appears on the masthead of its regular internal newsletter
“In 1996”	Mr Sun says he commenced a publishing business called ‘Golden Land (Xin Jin Shan) Publishing House’ (apparently in English, although presumably with a corresponding name in Chinese characters) (Haoliang 1 para 30). Examples of 3 publications from 1997, 1996 and (again) 1996 forming Exhibits HS12, HS13 and HS14 respectively however in fact show use of the name ‘Golden Land Publishing House’ (in English) alongside the (nearly) corresponding name in Chinese characters incorporating the characters 新金山
10 January 1997	‘Golden Land Publishing House’ (in English) is registered as a business name in Victoria, (presumably by Mr Sun and presumably in Mr Sun’s name, although not stated) (Haoliang 1 para 31, Exhibit HS15)
“In 1997”	Mr Sun opens a bookshop in Melbourne called ‘Xin Jin Shan Chinese Bookshop’ (in English, although Exhibit HS8 which apparently evidences this shows only the (nearly) corresponding name in Chinese characters) (Haoliang 1 paras 33 and 34, Exhibit HS8)
2000	Mr Sun transfers his interest in the ‘Golden Land Printing & Co’ printing business to Baoquan Chen (Haoliang 1 para 28)
“In 2001”	Mr Sun consents to Baoquan Chen’s request that Mr Chen operate the ‘Golden Land Printing & Co’ printing business “through a company which he [Mr Chen] would like to call ‘Golden Land Group Pty Ltd’ ” (Haoliang 1 para 35)
23 April 2001	‘Golden Land Group Pty Ltd’ (“GLG”) is incorporated

19 November 2003	 <p>GLG applies to register  as a trade mark in Classes 16 and 41 (now regn 978950)</p>
20 November 2003	GLG applies to register 新金山 as a trade mark in Classes 16 and 41 (now regn 979149)
30 April 2004	Mr Sun registers 'XIN JIN SHAN CHINESE LANGUAGE AND CULTURE SCHOOL INC' (in English) as an incorporated association in Victoria (Haoliang 1 para 25, Exhibit HS5)
2 May 2004	GLG applies to register GOLDEN LAND as a trade mark in Class 41 (now regn 1000067)
"From 2004"	'Golden Land Publishing House' is run through GLG, of which Mr Sun says he became a shareholder and director (Haoliang 1 para 32)
"In 2004"	Mr Sun transferred his interest in 'Golden Land Publishing House' to GLG, of which Mr Sun says he became a shareholder and director (Haoliang 1 para 36)
13 October 2004	According to ASIC's online records Mr Sun becomes recorded as a director and shareholder of GLG
Late 2004 or early 2005	Mr Sun and his wife Liya Lin cease their association with the Applicant (albeit remaining officially recorded members under the AI Act)
10 February 2005	The Applicant files application 1041262

47. While not relevant to my decision I note for the record that at about the time the opposed application was filed on 10 February 2005 and thereafter Mr Sun and/or GLG have remained active, apparently using the characters 新金山 in relation to at least the following two new enterprises:

- “Since 2005”<sup>3</sup> Mr Sun has operated a Chinese language school in Melbourne called ‘Xin Jin Shan Chinese Culture and Language School Inc’ (in English and whose corresponding name in Chinese includes the characters 新金山) and a coaching school called either ‘Xin Jin Shan Coaching School’ (ditto) or ‘XJS Coaching School’ (Haoliang 1 para 25);
- In July 2006 GLG commenced publishing a weekly newsletter called ‘Golden Land (Xin Jin Shan) Educational Weekly’, (in English and whose corresponding name in Chinese includes the characters 新金山) (Haoliang 1 para 37 and Exhibit HS19).

## **Submissions and Reasoning**

### ***Section 58***

48. The ground based on section 58 is indicated in the Notices as follows:

The Applicant is not the owner of the Opposed Trade Mark.

49. Section 58 of the Act is reproduced below:

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

50. Mr Goldblatt opened his submissions by pointing out that there was, as he put it, a “direct clash” between the evidence of the parties as to who might fairly assert “authorship” of the characters 新金山 as a trade mark. This certainly appears to be the case if “authorship” is understood to refer to a party who first conceives of a particular trade mark or who first intends to use that trade mark in relation to particular goods and/or services. However “authorship” in this sense is neither a necessary nor a sufficient prerequisite for a valid claim to “ownership”<sup>4</sup> of that trade mark for those goods or services. Whereas the parties’ evidence contains conflicting accounts of who first thought of the characters 新金山 and who first proposed using them as the name and trade mark for the Applicant’s school, I do not accordingly believe it is necessary for me to form a view one way or the other on those questions in order to decide the oppositions.

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<sup>3</sup> Although not significant to my decision, I mention that there is no evidence this occurred prior to 10 February 2005.

<sup>4</sup> Or “proprietorship” as it was referred to in earlier legislation and judicial discussion. In this decision I use the words “owner” and “proprietor” *and* “ownership” and “proprietorship” interchangeably, as the context demands.

51. In this regard I note that although the word “owner” is not defined in the Act, there are numerous decisions where courts have considered its meaning. It is well established that in the absence of fraud the owner of a trade mark in Australia for particular goods or services is taken to be the first person to use it in the course of trade in Australia in relation to those goods or services.<sup>5</sup> In the absence of any use for relevant goods or services, then the first person to apply to register a trade mark in relation to those goods or services will, in most cases, be entitled to claim to be the owner of it in relation to those particular goods or services<sup>6</sup>.
52. It is particularly in relation to this latter case of an unused trade mark that the concept of “authorship” arises, this being one of the elements said to support the claim of ownership required of an applicant by s.27(1)(a) of the Act, although even in this case “authorship” of a trade mark does not necessarily refer to the person who first thought of it, or first decided to use it. In *Shell Co. of Australia Ltd v Rohm and Haas Co.* (*op. cit.*), Dixon, CJ notes (in connection with the *Trade Marks Act, 1905*, although just as applicable to the current legislation), at [7]:

The basis of a claim to proprietorship in a trade mark so far unused has been found in the combined effect of authorship of the mark, the intention to use it upon or in connection with the goods and the applying for registration.

53. Dixon, CJ explains (at [8]) that “authorship” in this context “involves the origination or first adoption of the word or design as and for a trade mark”. In reflecting on these words in the later case of *Aston v Harlee Manufacturing Co* (1960) 103 CLR 391 Fullagar, J said (at [19]):

I do not think that the requirement of “authorship” means that the applicant must be the true and first inventor: he has not to establish anything analogous to what an applicant for letters patent for an invention must establish. I do not think that an opponent of an application for registration of a trade mark could succeed by saying merely “I thought of it first”, or even “I thought of it first and communicated it to the applicant.” It is otherwise if the opponent has used the mark in relation to goods [or services].

54. Fullagar, J then goes on to consider *Re Hicks’ Trade Mark* (1897) 22 VLR 636, one of the leading cases concerning ownership or proprietorship of a trade mark. It is

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<sup>5</sup> *Seven Up Co v OT Ltd* (1947) 75 CLR 203


<sup>6</sup> *Shell Co (Aust) Ltd v Rohm and Haas Co* (1948) 78 CLR 601, per Dixon, J at 627-628

apparent from *Hicks' case* that in order to establish their section 58 ground the Opponents would need to establish a party other than the Applicant first *used* the Trade Mark (or one “substantially identical” thereto) in Australia for goods or services adjudged to be “the same kind of thing” as the goods and services covered by application 1041262 before the 10 February 2005 filing date of the application, or before the Applicant’s first use of the Trade Mark for relevant goods and services, whichever is the earlier<sup>7</sup>.

55. As mentioned earlier the Opponents do not claim any rights in the CCS Logo, which on the face of it forms a significant element of the Trade Mark as a whole. While the Opponents claim use of the characters 新金山 for various goods and services prior to 10 February 2005, there is no evidence before me that either opponent has ever used the Trade Mark as a whole for any goods or services. Accordingly, the Opponents’ s.58 ground might only be established if the characters 新金山 alone are considered “substantially identical” to the Trade Mark as a whole.


56. Both Ms Gatford and Mr Goldblatt referred to the well known formulation for assessing substantial identity set out by Windeyer, J in *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1963) 1B IPR 523, where his Honour said at 528:

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 feature of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

57. When such a side by side comparison is made it is quite apparent in my view that the addition of the element  is, in Windeyer, J’s terms, an “important” difference, in that it readily allows the two trade marks to be visually distinguished one from the other. Moreover, as Ms Gatford pointed out in referring to cases such as *Arbormasters Pty Ltd v Arbormaster Training Inc* [2007] ATMO 7 (5 February 2007) and *Link Recruitment Pty Ltd v Link Employment and Training Inc* [2006] ATMO 39 (12 May 2006) and the cases discussed therein, the weight of authority is to the effect that the addition of a logo to a word mark substantially affects the identity of that word mark.

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<sup>7</sup> See also *Carnival Cruise Lines v Sitmar Cruises Ltd* (1994) 31 IPR 375

58. I thus find that the Opponents' s.58 ground, to the extent it is based on prior use of a trade mark the same as or substantially identical to the Trade Mark, is not established.
59. For the sake of completeness I note that GLG was the registered owner of registrations 978950  新金山 GOLDENLAND, 979149 新金山 and 1000067 GOLDEN LAND prior to 10 February 2005. However once again the Trade Mark is neither the same as, nor substantially identical to, any one of these three trade marks on the face of it and the registrations cannot therefore be relied upon to displace the Applicant's claim to ownership of the Trade Mark.
60. It is appropriate at this point to comment on a further claim made by Mr Sun which might in principle be considered relevant to the Opponents' s.58 ground. In particular, Mr Sun claims not only "authorship" of the characters 新金山, but also that he gave the Applicant his (verbal) "permission" to use them provided he (Mr Sun) remained "involved" with the Applicant's school. As Mr Sun puts it in Haoliang 1 at paragraph 22:

However, I did not give the [Trade] Mark or transfer in any way ownership of my rights in the [Trade] Mark to the school but only gave it permission to use the [Trade] Mark for as long as I was involved in the school, as the use of the [Trade] Mark informed the Chinese community of my involvement with the school. As I was the founder of the school and owner of the magazine it did not occur to me or anyone else at the time that it was necessary to document this agreement in any way. It was assumed that my involvement in the school and with the other people involved would continue.

61. I mention that Mr Sun does not explain how it is he knows what other members of the Applicant were assuming at the time. The Applicant in fact concedes Mr Sun's consent or "permission" to adopt the characters 新金山 as the name of its school as from January 1994 (being, it will be recalled, the same time Mr Sun commenced use of the same characters as the new name for 'Focus' magazine) was sought and obtained. However the Applicant says Mr Sun's consent was sought in his capacity as a member of the Applicant and that in any event merely seeking and obtaining his "permission" would certainly not grant Mr Sun any personal rights in or to the characters he did not already have.
62. What individual members of the Applicant (including Mr Sun) may have been thinking or assuming at the time is however not a matter I need consider. As

previously discussed, the owner of a trade mark for particular goods or services is taken to be the first person to *use* it in the course of trade in relation to those goods or services.<sup>8</sup> Similarly, Mr Sun would need to show (significant) *use* of the characters 新金山 to assert rights in them sufficient to underpin successful proceedings for passing off or for breach of the *Trade Practices Act 1974*. Accordingly, if Mr Sun had any “rights” in the characters 新金山 as a trade mark in January 1994 when the Applicant’s school commenced their use then he had to have acquired those rights through prior use for relevant goods or services.

63. No such prior use is shown, or indeed effectively claimed, in the evidence before me. There seems no doubt on the evidence that the first time Mr Sun personally used the characters 新金山 in the course of trade for any goods or services was when he used them for the new name of ‘Focus’ magazine as from the January 1994 issue, having announced the proposed change in the November/December 1993 issue.
64. On the face of it, therefore, the only “rights” Mr Sun might have successfully asserted in or about January 1994 in the characters 新金山 would have been as common law owner, acquired through first use, in relation to magazines. Even in this respect his “rights” would be limited to the right to register the characters in relation to magazines (and goods of the same kind) over the competing claims of others, rather than the kind of rights acquired through long, continuous use which might be otherwise enforceable at law or in equity.
65. Further, of course, even if Mr Sun were able to demonstrate that he had used the characters 新金山 for relevant goods or services before January 1994 and that he had then effectively granted the Applicant a (conditional) license to use them this would still not advance the Opponents’ s.58 ground because the characters are neither the same as, nor substantially identical to, the Trade Mark in any event.
66. In summary, the Opponents’ s.58 ground is not established.

#### ***Section 44***

67. The ground based on section 44 is indicated in the Notice as follows:

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<sup>8</sup> *Seven Up Co v OT Ltd* (1947) 75 CLR 203

The Opposed Trade Mark is substantially identical with or deceptively similar to one or more trade mark registrations and/or applications having an earlier priority date in respect of similar goods/services, including registration no 979149

68. Section 44 of the Act is reproduced below:

### **Identical etc. trade marks**

**44.(1)** Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

- (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar goods or closely related services; or
  - (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

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

Note 2: For *similar goods* see subsection 14(1).

Note 3: For *priority date* see section 12.

**(2)** Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

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

Note 2: For *similar services* see subsection 14(2).

Note 3: For *priority date* see section 12.

**(3)** If the Registrar in either case is satisfied:

- (a) that there has been honest concurrent use of the 2 trade marks; or
- (b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

Note: For *limitations* see section 6.

(4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

(a) beginning before the priority date for the registration of the other trade mark in respect of:

(i) the similar goods or closely related services; or

(ii) the similar services or closely related goods; and

(b) ending on the priority date for the registration of the applicant's trade mark;



the Registrar may not reject the application because of the existence of the other trade mark.

Note 1: An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

Note 2: For *predecessor in title* see section 6.

Note 3: For *priority date* see section 12.

69. At the hearing Mr Goldblatt indicated that, in addition to registration 979149 mentioned in the Notices, the Opponents were also relying on registrations 978950 and 1000067. The three registrations, all of which are owned by GLG, are detailed below:

Regn.	Priority Date	Trade Mark	Goods and/or Services
978950	19 Nov 2003		<b>Class: 16</b> Cultural publications including educational publications <b>Class: 41</b> Cultural activities; publication of newspapers
<b>Endorsements:</b> The applicant has advised that the Chinese characters appearing in the trade mark may be transliterated as XIN JIN SHAN which translates as NEW GOLDEN MOUNTAIN.			
979149	20 Nov 2003		<b>Class: 16</b> Printed matter being cultural publications <b>Class: 41</b> Cultural activities including education, training and entertainment
<b>Endorsements:</b> The applicant has advised that the Chinese (Mandarin) characters appearing in the trade mark may be transliterated as XIN JIN SHAN which may be translated into English as NEW GOLDEN MOUNTAIN.			

1000067	2 May 2004	GOLDEN LAND	<b>Class: 41</b> Cultural activities including education, training and entertainment and publication of newspapers
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70. The priority dates of the three registrations relied upon by the Opponents, being 19 and 20 November 2003 and 2 May 2004, are all earlier than the 10 February 2005 priority date of opposed application 1041262. To establish their section 44 ground the Opponents therefore need to establish on the balance of probabilities that:

- the opposed application covers “similar”<sup>9</sup> goods and/or services to those covered by one or more of the registrations relied upon; and
- the Trade Mark is substantially identical or deceptively similar to one or more of the relevant trade marks subject of the registrations relied upon.

71. I mention that in assessing whether any of the goods and/or services covered by the opposed application are “similar” to any of the goods and/or services covered by registrations 978950, 979149 and/or 1000067 I must assume use of the respective trade marks in a “normal and fair manner” for any of the goods or services covered by the application and the various registrations<sup>10</sup>. It is the statutory rights granted by registration which must be compared and not the actual use (if any) that may have been made of the respective marks in the past.

72. Section 14 of the Act defines “similar goods” and “similar services” as follows:

(1) For the purposes of this Act, goods are *similar* to other goods:

- (a) if they are the same as the other goods; or
- (b) if they are of the same description as that of the other goods.

(2) For the purposes of this Act, services are *similar* to other services:

- (a) if they are the same as the other services; or
- (b) if they are of the same description as that of the other services.

73. Ms Gatford explicitly indicated in her written submissions the Applicant conceded the services covered by the opposed application were similar to those covered by GLG’s registration 979149. I am satisfied this is the case given the broad ambit of the

<sup>9</sup> As defined in section 14 of the Act

<sup>10</sup> *Smith Hayden & Co. Ltd’s Application* (1946) 63 RPC 97 (Ch D); *Registrar of Trade Marks v Woolworths Limited* (1999) 45 IPR 411

registration's Class 41 specification, which it will be recalled covers "Cultural activities including education, training and entertainment".

74. I am likewise satisfied the "Education services and publishing services" covered by the opposed application are similar to the "Cultural activities including education, training and entertainment" and the "Cultural activities including education, training and entertainment and publication of newspapers" covered by registrations 978950 and 1000067 respectively.
75. While Ms Gatford did not, as far as I noted, address the issue in relation to Class 16, I am also satisfied the goods covered by the opposed application are similar to those covered by registrations 978950 and 979149.
76. I thus now turn to the question of whether the Trade Mark is "substantially identical" or "deceptively similar" to one or more of GLG's relevant registered trade marks. I have already of course found that the Trade Mark is not "substantially identical" to the characters 新金山 alone. Taking this into account I have similarly concluded the Trade Mark is not substantially identical to any of GLG's registered trade marks. Are, then, any of the relevant trade marks deceptively similar?
77. Section 10 of the Act defines the expression "deceptively similar". The opposed mark must so nearly resemble the earlier mark that it is likely to deceive or cause confusion. In *Registrar of Trade Marks v Woolworths* (1999) 45 IPR 411 French J said of deceptive similarity:

*In Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-5, which concerned the 1905 Act, Kitto J set out a number of propositions which have frequently been quoted and applied to the 1955 Act. The essential elements of those propositions continue to apply to the issue of deceptive similarity under the 1995 Act. Applied also to service marks and absent the imposition of an onus upon the applicant they may be restated as follows:

(i) To show that a trade mark is deceptively similar to another it is necessary to show a real tangible danger of deception or confusion occurring. A mere possibility is not sufficient.

(ii) A trade mark is likely to cause confusion if the result of its use will be that a number of persons are caused to wonder whether it might not be the case that the two products or closely related products and services come from the same source. It is enough if the ordinary person entertains a reasonable doubt. It may be interpolated that this is another way of

expressing the proposition that the trade mark is likely to cause confusion if there is a real likelihood that some people will wonder or be left in doubt about whether the two sets of products or the products and services in question come from the same source.

(iii) In considering whether there is a likelihood of deception or confusion all surrounding circumstances have to be taken into consideration. These include the circumstances in which the marks will be used, the circumstances in which the goods or services will be bought and sold and the character of the probable acquirers of the goods and services.

(iv) The rights of the parties are to be determined as at the date of the application.

(v) The question of deceptive similarity must be considered in respect of all goods or services coming within the specification in the application and in respect of which registration is desired, not only in respect of those goods or services on which it is proposed to immediately use the mark. The question is not limited to whether a particular use will give rise to deception or confusion. It must be based upon what the applicant can do if registration is obtained.


In respect of the last proposition, Mason J observed in *Berlei Hestia Industries Ltd v The Bali Company Inc* (1973) 129 CLR 353 at 362:

“...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.”

78. As both Ms Gatford and Mr Goldblatt agreed, in order to assess the question of deceptive similarity the trade marks should not be compared side by side.<sup>11</sup> Rather, an attempt should be made to assess the impression they would produce in the minds of relevant potential consumers based on their look and sound, with due allowance for imperfect recollection. In this regard it is enough if the person of ordinary intelligence and memory would be caused to wonder, or be left in doubt, about whether the goods and/or services in question come from the same source. That said, Ms Gatford highlighted the fact that the characters 新金山 did not have a “sound” as such to people not literate in Chinese characters, but would tend to be recalled by such people merely as “three Chinese characters”. She thus argued that for such people the presence of the CCS Logo in the Trade Mark was sufficient to distinguish it from GLG’s relevant trade marks.

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<sup>11</sup> *Australian Woollen Mills Ltd v F.S. Walton & Co* (1937) 58 CLR 641 (at 658); *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 109 (at 415)

79. Even if the trade marks were considered from the perspective of what Ms Gatford characterised as the “possible target audience”, namely the Chinese speaking (or literate) community in Australia, she submitted the relevant trade marks should not be considered deceptively similar in view of the prominence of the CCS Logo in the Trade Mark. In this regard she quoted from the joint judgment of Wilcox, Kiefel and Bennett, JJ in *Melbourne Chinese Press Pty Ltd v Australian Chinese Newspapers Pty Ltd* (2004) 63 IPR 38 (at [59]) that “similarities of sound and meaning do not play as important a part as they might in relation to some other goods”.
80. Their Honours’ words were however clearly directed at the particular case of trade marks used on the mastheads of newspapers and took into account the usual way newspapers are sold to the relevant public. The case is distinguishable also because there the characters involved were directly descriptive of newspapers<sup>12</sup> (from the perspective of people literate in Chinese characters) and it was found the style of calligraphy chosen by the alleged infringer deliberately mirrored that of the registered trade mark owner.
81. In the present case I consider one of the significant “surrounding circumstances” (in terms of paragraph (iii) of French, J’s words quoted in [75] above) is that the relevant consumers of the Applicant’s goods and services are likely to be able to read the characters 新金山 and I confirm I am proceeding on this basis. In passing I mention for the record that I am personally reasonably literate in Chinese characters and am in particular very familiar with the three, very common, characters 新金山.
82. I turn now to the specific trade marks relied on by the Opponents. The 新金山 trade mark subject of registration 979149 is, albeit rendered in a slightly different style of calligraphy, wholly contained within the opposed trade mark, with the additional element  being effectively the sole feature distinguishing the Trade Mark from the earlier trade mark. I do not however believe this additional material is sufficient to obviate a real tangible risk of a number of people (who can read the characters in question) being caused to wonder whether it might not be the case that the relevant goods and services dealt with under the two trade marks come from the same source.

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<sup>12</sup> Ms Gatford did argue that the characters 新金山 might be considered descriptive themselves in the context of the parties’ trade marks, given they allude to an apparently popular Chinese nickname for Melbourne or Victoria. However, I do not consider this to be significant in this case.

Clearly, too, to the extent either mark is referred to orally by those who can read Chinese characters it is likely to be referred to by reference to the pronunciation of the characters 新金山. I thus have little hesitation in finding the Trade Mark deceptively similar to the 新金山 trade mark subject of registration 979149.

83. I also consider the Trade Mark is deceptively similar to the  trade mark subject of registration 978950, again assuming the relevant consumers are taken to recognise the 新金山 characters common to both trade marks. While both the Trade Mark and GLG's mark also contain distinctive logos, it is by the (Chinese) "words" they contain that I believe the marks are likely to be recalled by relevant consumers. In this regard the English words "GOLDEN LAND" contained in the registered mark, while not a direct translation of the characters 新金山, do in my opinion serve to reinforce the meaning the characters carry.
84. The Trade Mark is however not deceptively similar to the GOLDEN LAND trade mark subject of registration 1000067 in my view, the only point of similarity being that "golden land" is arguably a (partial) translation of the characters 新金山.
85. In summary, I have found that the Trade Mark is deceptively similar to the trade marks subject of registrations 978950 and 979149 and that the opposed application covers goods and services similar to those covered by the two registrations. The Opponents have accordingly established their section 44 ground.
86. Notwithstanding the Opponents have established their s.44 ground I now consider whether the Applicant's "prior continuous use" of the Trade Mark as indicated in its evidence is sufficient to make out a case for coexistence on the Register under s.44(4) of the Act, as submitted by Ms Gatford.
87. I am satisfied the evidence clearly shows the Applicant used the Trade Mark continuously from at least January 1996 up until 10 February 2005 (and beyond) to distinguish the education services it was providing from those of others. Indeed, this is not effectively disputed by the Opponents. This in my view is sufficient for s.44(4) to apply with respect to the "education services" in Class 41 covered by application 1041262.

88. The “publishing services” in Class 41 and the “Printed matters including newspapers” in Class 16 covered by application 1041262 are however more problematic. The Applicant’s evidence certainly shows use of the Trade Mark since January 1996 in relation to a number of publications, as Ms Gatford submitted, including for example on the masthead of its regular school “newsletter” (Exhibits AL-20 to AL-49), in a “promotional booklet” produced in 1996 (Exhibit AL-50), on the front cover of exercise books provided to students (Exhibits AL-51 and AL-52) and elsewhere.
89. However on the face of it all of these publications were directly related to the education services the Applicant was providing. The publications relied upon were clearly produced for teachers and students of the school or for the information of students’ parents. There is no evidence any of the publications enjoyed a wider circulation or were made available to the public generally in the course of trade. Nor is there any evidence that the Applicant has ever offered or provided “publishing services” as such to the public, when the particular, specialized services embraced by that description are properly appreciated.
90. Moreover, it is apparent that most (and possibly all) of the exhibited examples of publications said to evidence use of the Trade Mark for “printed matters including newspapers” and/or for “publishing services” were not actually printed by the Applicant in any event. In this regard I note the publications in question (apart from the school newsletter) invariably bear, quite prominently, the words “PRINTED BY GOLDEN LAND PRINTING & CO” (in English, with Chinese characters corresponding to the English words “New Golden Land Printing Company” appearing immediately below the English words).
91. In summary, I find that the Applicant is entitled to rely upon s.44(4) only in connection with the “educational services” in Class 41 covered by its application, and not for any of the goods or other services claimed.

### ***Section 60***

92. The ground based on section 60 is indicated in the Notice as follows:

The Opposed Trade Mark is substantially identical with or deceptively similar to a trade mark that, before the priority date of the Opposed Trade Mark, had acquired a reputation in Australia such that use of the Opposed Trade Mark would be likely to deceive or cause confusion.

93. Section 60 of the Act itself (as it stood at the date the opposed trade mark application was filed<sup>13</sup>) is reproduced below:

The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:



- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

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

Note 2: For *priority date* see section 12.

94. Here the comparison is between the trade mark 新金山, in which the Opponents claim one or both of them had developed the relevant reputation in Australia as at 10 February 2005, and the Trade Mark. As regards the threshold question in paragraph (a) of Section 60, I have already found that the Trade Mark is deceptively similar to the 新金山 trade mark subject of GLG's registration 979149 in terms of sections 44 and 10 of the Act. As mentioned, the calligraphy in which the registered mark is rendered was not a factor relevant to that finding. In terms of section 60 it likewise appears to me to be of virtually no significance to the issue of deceptive similarity in this case whether the use relied on by the Opponents is for the characters 新金山 in any particular font or style of calligraphy<sup>14</sup>.

95. Evidence concerning the Opponents' use of the characters 新金山, and the claimed reputation the characters enjoyed as at 10 February 2005 as a result, is contained in the declarations of Haoliang Sun (1, 2 and 3), Baoquan Chen (1 and 2), Tsebin Tchen and Hui Yu Xian. Ms Gatford did point out that much of the use shown was

incidental, as it were, to use of the trade mark . However if, as I consider appropriate in this case, the relevant consumers of the goods or services provided by the Opponents are taken to be those people who can read the Chinese characters concerned, then in my view use of the characters as a prominent element in the 

<sup>13</sup> See *Apple Computer Inc v Todaytech Group Ltd* [2007] ATMO 80

<sup>14</sup> Contrast the decision of the Full Federal Court in *Melbourne Chinese Press Pty Ltd v Australian Chinese Newspapers Pty Ltd* (2004) 63 IPR 38 discussed earlier, where the style of calligraphy used for a newspaper's masthead was considered critical.

mark as a whole should indeed contribute to the reputation the characters alone eventually develop.

96. That said, I do not believe the Opponents' evidence shows sufficient use of the characters 新金山, in whatever form, to make out the requisite "reputation" as at 10 February 2005 contemplated by s.60. In *McCormick & Co Inc v McCormick* (2000) 51 IPR 102, for example, Kenny, J noted (at 128) in relation to how reputation may be shown:

In *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302 at 343; 23 IPR 193 at 234, Lockart, J said:

[R]eputation within the jurisdiction may be proved by a variety of means including advertisements on television or radio, or in magazines and newspapers within the forum.

Justice Kenny continued (at 129):

In practice, it is commonplace to infer reputation from a high volume of sales, together with substantial advertising expenditures and other promotions, without any direct evidence of consumer appreciation of the mark, as opposed to the product:...

97. As previously mentioned, the evidence indicates Mr Sun first used the characters 新金山 in the course of trade as from the January 1994 edition of his magazine. There is however no evidence as to the extent of the magazine's circulation, or of its sales or advertising revenue, or of how it was sold or distributed. Moreover, Mr Sun does not take issue with Ai Yun Liu's statement that to her knowledge the magazine was not published at all after 1994 (Liu 2, para 5). This is notwithstanding Liu 2, a relatively short declaration of five paragraphs, was made on 4 September 2008 and Mr Sun made a subsequent declaration on 16 September 2008 with the apparent sole purpose of specifically addressing those matters in Liu 2 with which he took issue.
98. Mr Sun says he, Baoquan Chen and two other people, (both of whom are unnamed but are said to be members of the Applicant), then commenced a printing business which used the characters 新金山 in its Chinese name and they registered the business name 'Golden Land Printing & Co' (in English) in Victoria on or about 2 June 1995. However Mr Sun says that the business was "not initially successful" and that the two members of the Applicant departed as a result. Mr Sun himself transferred his share of the business to Mr Chen in 2000. Neither Mr Sun nor Mr Chen has provided any

significant information in their various declarations concerning the business, such as turnover figures or the like, upon which I might begin to assess how it might have contributed to the Opponents' reputation in the characters 新金山.

99. In 1996 Mr Sun then “started a business called ‘Golden Land (Xin Jin Shan) Publishing House’ ”(Haoliang 1 para 30). He exhibits three publications produced by the business in 1996 and 1997, from which it can be seen the characters 新金山 appear in the Chinese version of the business' name. Once again, however, there is no information given about the business itself which might assist me in assessing the merits of the Opponents' s.60 ground of opposition. Indeed, there is nothing in the evidence to suggest that the three publications exhibited were not the only ones ever produced by the business.
100. In 1997 Mr Sun then “established a bookshop under the name ‘Xin Jin Shan Chinese Book Shop’ ”. He exhibits a photograph of the front of the book shop premises, from which it can be seen the characters 新金山 appear prominently in the bookshop's corresponding Chinese name. The evidence is otherwise silent as to anything which might support the Opponents' s.60 ground, such as the nature of the business, how long it may have operated, what its turnover may have been, or similar.
101. To further support their s.60 ground, the Opponents also rely on two declarations by third parties. Tsebin Tchen, a Town Planner and former Federal senator and currently Chair of the Australian Housing and Urban Research Institute, has known Mr Sun “since about 1991”. Mr Tschen says he was aware at the time when Mr Sun changed the name of his magazine in January 1994 “to three Chinese characters which can be described as ‘Xin Jin Shan’ meaning new golden mountain or new golden land” and mentions, “It was the first time I had seen this concept or these characters used in this context”. Mr Tschen also recalls Mr Sun “about that time” having started a printing business, a Chinese book importing business and a Chinese language school, all of which used the “same name or characters Xin Jin Shan”. Mr Tschen says he visited the Applicant's schools on several occasions prior to 2005 and “was aware that Sun was the principle (sic) member of the school”.
102. Mr Tschen notes that Mr Sun is “a prominent figure in the Chinese community in Australia and is a highly regarded teacher”. He concludes that in his view, “any

Chinese school, educational, publishing or cultural enterprise or publication using the name ‘Xin Jin Shan’ will be one in which Sun would be expected to have an involvement” and that “it would certainly cause confusion in the Chinese community if anyone else used ‘Xin Jin Shan’ in these areas of endeavour”.

103. I have not however found it possible to place much weight on Mr Tschen’s opinion as far as the Opponents’ s.60 ground is concerned. While he attests that Mr Sun commenced several businesses in the mid 1990s, he provides no details of the businesses and there is no indication he is aware of any relevant activity by Mr Sun since the various businesses were “commenced”. The one apparent exception is that he visited the Applicant’s schools a number of times prior to 10 February 2005 and, although he characterises Mr Sun’s involvement with the Applicant’s school as being “the principle (sic) member”, what Mr Tschen understands the significance of this characterisation to be is not explained.

104. The Opponents also rely on the declaration of Hui Yu Xian to support their s.60 ground. Mr Hui says he has had his children “taught by Haoliang Sun and at his school since 1995 except for one year”. The one exception was the year 2005 when he apparently re-enrolled his daughter at the Applicant’s school before learning that Mr Sun had left and “in the belief it was still Sun’s school”. There is however no evidence that any other people were confused in this way. Moreover, as discussed, the evidence shows that the Applicant (including Mr Sun) was the entity which operated the school at all relevant times and not Mr Sun personally in any event.

105. In summary and based upon the evidence as a whole I am not satisfied the Opponents’ reputation in the characters 新金山 as at 10 February 2005 was such that the Applicant’s (ongoing) use of the Trade Mark was likely to deceive or cause confusion amongst a significant number of people. I accordingly find the Opponents’ s.60 ground is not established.

***Section 62(b)***

106. The ground based on section 62(b) is indicated in the Notice as follows:

The Opposed Trade Mark was accepted for registration on the basis of evidence or representations that were false in material particulars,

which essentially mirrors the precise words of the subsection itself.

107. There were two separate bases to the Opponents' submissions under s.62(b), although the first of these is effectively dependant upon the Opponents' s.58 ground being established and is therefore easily dismissed. In particular, it was submitted on behalf of the Opponents that the offending evidence or representations concerned the Applicant's (implicit)<sup>15</sup> claim to be the "owner" of the characters 新金山 for relevant goods and services when it originally filed application 1041262. The merits, if any, of this argument need not be considered since, as already discussed, the Trade Mark is neither the same as, nor substantially identical to, the characters 新金山 alone. Thus, even if the Opponents were able to demonstrate the Applicant was not the "owner" of the characters 新金山 for relevant goods and services as at 10 February 2005, (something which is not in my view necessarily established in any event), this was not the trade mark the Applicant applied to register in any event.

108. Further, Ms Gatford referred me to the following passage from *Subafilms Limited v Tenancy Management Pty Ltd* [2006] ATMO 11 (11 January 2006), in which the Registrar's delegate considered the scope of s.62(b) and its possible overlap with s.58:


In *Kiwi Munchies Pty Ltd v Kraft Foods Holdings Inc* [2005] ATMO 22 the delegate noted (at paragraph 35) that section 62(b) is 'clearly directed to evidence that was material in the decision to accept the application for registration.' This is consistent with the 1992 report of the Working Party to Review the Trade Marks Legislation which said [at 1.3.3.8A(8)] registration could be opposed on the ground 'that acceptance of the trade mark has been obtained by misrepresentation; the Working Party intends that "misrepresentation" should be interpreted as meaning "a material misrepresentation of relevant facts" '. As noted by the delegate in *MB Holdings (Aust) Pty Ltd v B2 Import & Export SA CC* (2001) 54 IPR 584 (at 587) there is no ground for rejection on the basis of ownership and 'it is unlikely, in the lack of something more, that the extent of the representation as to ownership present in the making of an application can be "the basis" of the decision to accept the application.' There is nothing before me to show a different conclusion is warranted in this case. Ownership of the applicant's trade mark was not material to the decision to accept the application. Accordingly I find the section 62 ground fails

109. The second basis to the Opponents' submissions under s.62(b) concerned an alleged false representation contained in James Ye 1. This, it will be recalled, was the statutory declaration by Mr Ye made on 30 November 2005 which the Applicant filed with IP Australia on 2 December 2005 in support of (then pending) application 1041262. In particular, the purpose of the declaration was to support coexistence on

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<sup>15</sup> That is, implied by s.27(1) of the Act.

the Register with GLG's registration 979149 新金山 under s.44(4) of the Act on the grounds of "prior continuous use". The offending representation alleged is Mr Ye's statement that:

The Applicant has used the Trade Mark [  ] continuously in Australia since at least 1994 in connection with education, entertainment and publishing services, and printed matter including newspapers, and in particular in connection with the operation of a community based school intended to promote Chinese culture and language for local Chinese communities.

110. On the face of it the statement is false since the Applicant's evidence in these oppositions indicates the Trade Mark was not in fact first used until 1995 at the earliest, being some time after the public competition for the design of the CCS Logo took place. Rather, the trade mark the Applicant used "since at least 1994" and up to the time the CCS Logo was adopted consisted of the characters 新金山 alone. The question I must decide is thus whether Mr Ye's statement should be characterised as false in material particulars to the extent that acceptance of application 1041262 under s.44(4) of the Act would not otherwise have occurred.
111. Bearing in mind the intentions of the Working Party as quoted above that the misrepresentation complained of should be "a material misrepresentation of relevant facts" I do not believe Mr Ye's statement, although strictly speaking false, is caught by s.62(b). The only reason GLG's registration 979149 新金山 had been cited against application 1041262 was because the Trade Mark contained the characters 新金山. It was accordingly the fact that the Applicant had used these characters for relevant goods and services "since at least 1994" which was on the face of it material to the decision to invoke s.44(4), whether or not the characters were also used together with the CCS Logo.
112. Moreover, as Ms Gatford argued, even if the Applicant had *not* used the characters in question prior to its adoption of the Trade Mark, and Mr Ye's statement had then used the words "since at least 1996" in place of the offending words "since at least 1994", the decision to apply s.44(4) would undoubtedly have been taken in any event.
113. I accordingly find the Opponents' s.62(b) ground is not established.

**Decision**

114. Section 55 of the Act provides:

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

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

115. I have found the oppositions to be partially successful on the ground raised pursuant to section 44 of the Act, that is in relation to the “publishing services” in Class 41 claimed by the opposed application and in relation to all of the goods in Class 16 claimed. I find no ground of opposition established insofar as the “education services” in Class 41 are concerned. I accordingly refuse to register trade mark application number 1041262 unless, within one month from the date of this decision, the application is restricted to “Education services” in Class 41. If the application is so restricted, it may proceed to registration. If, however, the Registrar has been served with a notice of appeal within one month from the date of this decision, I direct that the disposition of the application be in accordance with the Court’s direction or order.

**Costs**

116. Both Ms Gatford and Mr Goldblatt requested an award of costs in their client’s favour. As none of the parties has been entirely successful, however, I have decided not to award costs against any party on this occasion.

Michael Kirov  
Hearing Officer  
Trade Marks Hearings  
6 February 2009