

## TRADE MARKS ACT 1995

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

Re: Opposition by Estate of Francisco Coll Monge, Francisco David Coll, Executor, to registration of trade mark applications 1045723 and 1045726(9, 16, 25, 41, 45) - **ALC**, and **AMERICAN LEADERSHIP COLLEGE** - filed in the name of Americana Leadership College Pty Ltd.

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<b>DELEGATE:</b>	<b>Iain Thompson</b>
<b>REPRESENTATION:</b>	<b>Opponent: Robert Conrad by teleconference</b> <b>Applicant: Michael Ellicott</b>
<b>DECISION:</b>	<b>16 ATMO 2009</b> s52 opposition - grounds under sections 58, 41, 43 and 60: evidence not relevant to grounds: opposition not established Costs awarded to applicant

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#### Background

1. In this matter, Americana Leadership College Pty Ltd, ('the applicant') of York Street, Sydney, NSW, has applied to register two trade marks, current details of which appear below:

Application No: 1045723  
Priority Date: 11 March 2005  
Goods/Services: **Class: 9** CDs, CD-ROMs, discs, audio and video tapes, audio and visual recordings, educational films, publications being in electronic form supplied on-line from databases or from facilities provided by way of a global computer network (including websites), electronic publications  
**Class: 16** Printed matter including but not limited to promotional literature, books, magazines, newsletters, brochures, cards, posters, letterhead, stationery and advertising  
**Class: 25** Clothing, footwear, headgear  
**Class: 41** Conferences, seminars, live musical performances, classes, courses, educational services, meetings, leadership training, including spiritual leadership training  
**Class: 45** Church services, religious services, spiritual services, counselling in the field of religion and spirituality

Trade Mark: ALC

Application No: 1045726  
Priority Date: 11 March 2005

Goods/Services: **Class: 9** CDs, CD-ROMs, discs, audio and video tapes, audio and visual recordings, educational films, publications being in electronic form supplied on-line from databases or from facilities provided by way of a global computer network (including websites), electronic publications  
**Class: 16** Printed matter including but not limited to promotional literature, books, magazines, newsletters, brochures, cards, posters, letterhead, stationery and advertising  
**Class: 25** Clothing, footwear, headgear  
**Class: 41** Conferences, seminars, live musical performances, classes, courses, educational services, meetings, leadership training, including spiritual leadership training  
**Class: 45** Church services, religious services, spiritual services, counselling in the field of religion and spirituality

Trade Mark: Americana Leadership College

2. Following examination of the applications, they were advertised as accepted for possible registration in the *Australian Official Journal of Trade Marks* on 14 July 2009.
3. On 14 October 2005, the Estate of Francisco Coll Monge, Francisco David Coll, Executor, ('the opponent') filed Notice of Opposition ('the Notice') to the registration of the trade marks. The Notice recites grounds of opposition under section 58, 41, 44 and 60 of the *Trade Marks Act 1995* ('the Act').
4. As a delegate of the Registrar of Trade Marks, I heard the submissions of the parties at a hearing in Canberra on 20 November 2008. The opponent was represented by Robert Conrad and Francisco David Coll who attended by teleconference from the USA. The applicant was represented by Mr Michael Ellicot, Counsel, instructed by Amy Cowper of Addisons both of whom appeared in person.
5. The parties have served and filed their evidence in accordance with the Act and regulations thereto.
6. The Evidence in Support of the opposition comprises statutory declarations by:
  - Francisco David Coll, dated 25 January 2006
  - Francisco David Coll, dated 8 March 2006
  - Sandra Marcia Adler dated 1 February 2006
  - Sandra Marcia Adler dated 10 March 2006

- Maria A Coll dated 29 December 2005
  - Robert Conrad dated 11 March 2006
  - Robert Conrad dated 3 April 2006
  - Francisco D Coll dated 3 April 2006
  - Thomas Shantz dated 3 April 2006.
7. The evidence in answer comprises a declaration by Stephen Gibbs dated 23 July 2007.
8. The evidence in reply comprises statutory declarations by:
- Leonie Chappell dated 10 March 2008
  - Robert Conrad dated 22 March 2008
  - Robert Conrad dated 17 April 2008
  - Jeanette Campbell dated 17 March 2008
  - Paul Rear dated 19 March 2008
  - Louise Simons dated 20 March 2008

### *Discussion of Evidence*

9. The evidence shows that the late Dr Francesco Coll was some form of religious evangelistic self-improvement teacher who taught at public classes and seminars and, in the process, developed a 'bank' of intellectual property largely in the copyright and trade mark areas.
10. The evidence filed in support of the opposition is replete with allegations of fraud or conversion of said intellectual property following the death of Dr Francesco Coll. The allegations relating to these claims as they relate to Australia are (as far as I can see) completely unsupported by the evidence before me and I take no notice of them.
11. In terms of the grounds of opposition, as stated, there are but few questions which interest me. These are the usual ones of:
- ❖ When (if ever) were the trade marks first used in Australia?
  - ❖ Who first used the trade marks in question in Australia?

- ❖ What goods or services were the trade marks in question used on?
  - ❖ To what extent in terms of duration, volume, and geographical distribution have the trade marks been used in Australia?
  - ❖ How and to what extent were the trade marks publicized and known to Australians?
12. Further, if the opponent wishes to rely on the principle in *Conagra Inc. v McCain Foods (Aust.) Pty Ltd* (1992) 33 FCR 302 ('*Conagra*') and the reputation of the opposed trade marks within Australia based on their use within another country is to be relied upon, the opponent must demonstrate this affirmatively with evidence rather than allegations.
  13. Unfortunately, the opponent's concerns with the allegations of fraud or conversion of the trade marks makes the answers to the questions which I have posited above very difficult to get to grips with as this information (and documentary corroboration of it) has apparently been viewed as being incidental to the opponent's disquiets.
  14. Certainly, this is not an appropriate forum for an examination of many of the opponent's claims.
  15. Some of the materials submitted by the opponent suggest that they could establish ownership on behalf of either party but, on close inspection, do not. For example, an exhibit to the declaration in support by Francisco D Coll, dated 3 April 2006, carries a map of Australia on the front and is a brochure advertising the benefits of courses conducted in 1976-1977. However, it is impossible to discover from this brochure who conducted the courses – was it the applicant, the opponent, or some other person?
  16. Other material appended to declarations such as that of Mr Shantz of 3 April 2006 which I gather are intended to establish the historical use of the trade marks do not because of the obviously more recent publication of the material due to the copyright 1978-2004 claim printed on them.
  17. Stephen Gibbs, in his evidence in reply, states that all courses offered under the opposed trade marks in Australia are offered by his company and have been since 1977. Many of the materials put in by Mr Gibbs suffer from the same defects as

those put in by the opponent – they do not affirmatively demonstrate who is offering the courses.

18. However, exhibit SG-10 is from the year 1978 and ties the offer of courses under the trade mark Americana Leadership College and ALC to the applicant whose name appears on the final page. Other material originating within the USA and directed, apparently, to Americans who might wish to attend the same course in Australia in 1978 were directed to make their cheques payable to Dr Francisco Coll.
19. Similar materials from later dates support the applicant's claims to have used the trade marks continuously in Australia since at least 1978 and is readily distinguishable from the materials originating within the USA..
20. The same problems that beset the opponent's evidence in support also plague its evidence in reply – and, in addition, many of the materials submitted by the opponent show apparent use of the trade marks in question by Americana Leadership College Pty Ltd – the applicant in these proceedings.

### **Discussion**

21. The onus in opposition proceedings is on the opponent to establish at least one ground of opposition, on the balance of probabilities.
22. I am not satisfied that the opponent has shown any use of the opposed trade marks within Australia by a person other than the applicant which is relevant to these proceedings.
23. Neither am I satisfied that the opponent has shown that the opposed trade marks have a reputation within Australia based on the use of the opposed trade marks in the USA (and thus the principle in *Conagra* is not available to the opponent).
24. Accordingly, the grounds of opposition may disposed of in short order.

### **Grounds**

#### **Section 58**

25. Section 58 of the Act provides:

**Applicant not owner of trade mark**

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

Note: For *applicant* see section 6.

26. Ownership of a trade mark arises in two different ways – at statute by the filing of an application to register that trade mark on particular goods or services, or at common-law by the use of that trade mark by the owner on particular goods or services. The owner of the trade mark is the person who first uses it, or first files the application, whichever is the earlier.
27. It follows that a claim to ownership of an application filed under the Act can be displaced by evidence of use of the trade mark before the priority date of the application by a person other than the applicant on the same kind of thing (as regards goods or services): *Re Hicks' Trade Mark* (1897) 22 VLR 636, at 639-40.
28. However, the opponent has not demonstrated use of the trade marks before the priority date by a person other than the applicant – in fact, the applicant has demonstrated that it first used the trade marks in 1978 in Australia and should be regarded as their owner in Australia since that date.
29. Accordingly the opponent has not established this ground of opposition.

**Section 60**

30. Section 60, at the priority date of the opposed application, read:

**Trade mark similar to trade mark that has acquired a reputation in Australia**

**60.** 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.

31. The opponent's evidence does not establish that its trade marks had a reputation in Australia at the priority date of the opposed application.
32. The ground under section 60 is not established.

## **Section 41**

33. Section 41 looks to the inherent qualities of a trade mark and whether it is adapted to distinguish the goods or services from the similar goods or services of another trader. For example, the trade mark WHEELBARROW is not inherently adapted to distinguish the wheelbarrows of one trader from those of another trader as it is a word that other traders need to use in relation to their wheelbarrows.
34. Here the opponent has led no evidence that the trade marks in question lack inherent capacity to distinguish the goods or services of the applicant from the similar goods or services of another trader.
35. The opponent has not established its ground under section 41 of the Act.

## **Section 55**

36. Section 55 of the Act provides:

### **Decision**

**55.** 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.

37. The opponent has not established any of the grounds of opposition.
38. The trade mark applications may then proceed to registration one month from the date of this decision. If the Registrar has been served with notice of appeal or appeals before that time, I direct that registration(s) of the trade mark(s) shall not occur until the appeal has been decided or discontinued.

## **Costs**

39. The applicant is entitled to its cost which I award against the opponent at the official scale – I note that the applicant's costs in relation to its evidence are limited to those associated with the filing of one single declaration and the receipt and consideration of declarations filed by the opponent in relation to a single matter; costs in relation to the hearing are awarded for one single opposition as the two matters were, in essence, argued as one with identical issues.

Iain Thompson  
Hearing Officer  
Trade Marks Hearings  
12 February 2009