

TRADE MARKS ACT 1995

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

Re: Opposition by Sportsgirl Pty Ltd to registration of trade mark application 1069548(25) - **SPORTSBOY** - filed in the name of Filip Sali.

DELEGATE:	Iain Thompson
REPRESENTATION:	Opponent: Tony Lolis Applicant: no appearance
DECISION:	2007 ATMO 71 Section 52 opposition. Section 44 – opposition established. Registration refused – costs awarded against applicant

Background

1. Filip Sali, ('the applicant') of Hawthorn, Victoria, has applied to register a trade mark, current details of which appear below:

Appn Number:	1069548
Priority Date:	11 August 2005
Goods:	Class: 25 Clothing, footwear, headgear, clothing accessories in class 25
Trade Mark:	SPORTSBOY

2. The application has been examined and accepted for possible registration by a delegate of the Registrar of Trade Marks – the application was advertised as such in *The Australian Official Journal of Trade Marks* on 8 December 2005.
3. On 8 March 2006, Sportsgirl Pty Ltd, ('the opponent') of West Melbourne, Victoria, filed Notice of Opposition ('the Notice') to the registration of the trade mark. The Notice recites the following grounds of opposition under the *Trade Marks Act 1995* ('the Act'):

1. The trade mark is not capable of distinguishing the applicant's goods in respect of which registration of the trade mark is sought by the applicant from those of other persons and registration should be rejected under Section 41 of the Act.
2. The use of the trade mark would be contrary to law and registration of the trade mark by the applicant would be contrary to Subsection 42(b) of the Act.

3. The use of the trade mark would be likely to deceive or cause confusion and registration of the trade mark would be contrary to Section 43 of the Act.

4. The trade mark is substantially identical with or deceptively similar to one or more trade marks including, but not limited to, 192015, 224387, 483812, 518955, 608315, 652294, 703039, 703040, 703041, 720490, 731436, 990673, 990676, 1006560, 1026860 and 1042835, in respect of similar goods and/or services or closely related goods and/or services and for which the priority date is earlier than that of the trade mark the subject of the application and its registration would therefore be contrary to Section 44 of the Act. The trade mark has not been used by the applicant to satisfy the requirements of Section 44(3) and/or 44(4) and there are no other circumstances which make it proper for the Registrar to accept the application.

5. The applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods specified in the application and registration would be contrary to Section 59 of the Act.

6. The use of the trade mark would be likely to deceive or cause confusion and registration of the trade mark would be contrary to Section 60 of the Act.

7. Registration of the trade mark ought to be refused in the exercise of the Registrar's discretion, by reason of the conduct of the applicant and/or the nature of the mark and/or of its use and/or on such other grounds as the Registrar or the court, on appeal, may see fit to allow.

Opponent seeks an award for costs in its favour.

- 4. The opponent filed two statutory declarations in support of its opposition – one by Naomi Milgrom, the Director of the opponent, the other by Fiona Marie Symons, a solicitor who has the care and conduct of the opposition, of Davies Collison Cave. There is no evidence in answer.
- 5. Both parties were advised of their entitlement to request to be heard in the matter or to make written submissions – subsequently, as a delegate of the Registrar of Trade Marks, I heard the arguments of the opponent made by Tony Lolis of Davies Collison Cave at a hearing in Melbourne. The applicant did not appear or make written submissions.
- 6. At the hearing Mr Lolis tendered a further declaration by Tony Victor Lolis, solicitor, of Davies Collison Cave. This declaration has been served on the applicant at his

address for service – the letter was returned to Davies Collison Cave marked ‘Return to Sender, Filip Sali is not on this address, travelling o/s’. Mr Sali has not seen the declaration and has not responded to it – but I am satisfied that it was served on him at his address for service.

7. The declaration is relevant to the proceedings in that it is alleged to demonstrate contact between the applicant and a representative of the opponent concerning both the opponent’s SPORTSGIRL trade marks and the opposed trade mark prior to these proceedings. I will accept the declaration since it is relevant and its significance cannot be displaced by the fact that it was returned to sender, from the address for service.

The evidence

8. Ms Milgrom attests to the registration, use, and reputation, of the opponent’s SPORTSGIRL trade marks. The trade mark SPORTSGIRL was adopted in 1948 by the Bardas family of Melbourne and used in relation to a store in Swanston Street. In 1960, a SPORTSGIRL store was opened in Sydney. The company expanded during the 1970s and by the 1980s there were over 100 SPORTSGIRL stores throughout Australia.
9. In the 1990’s the business changed hands and further expanded its operations under the trade mark SPORTSGIRL in New Zealand, Hong Kong, and Thailand. In 1999, the business changed hands again when the current owner acquired the business and trade marks.
10. The retail value of turnover under the opponent’s SPORTSGIRL trade mark is very high, and a commensurate amount of money is spent by the opponent advertising and promoting goods sold under its trade mark SPORTSGIRL. Examples of the advertising are exhibited to Ms Milgrom’s declaration; the opponent runs a website that obtains 50,000 ‘hits’ per month; and the opponent further promotes its goods sold under the trade mark on billboards and at fashion events.
11. Ms Milgrom also avers:



During 2003 and 2004 my Company offered for sale a range of accessories including pendants, necklets, bracelets and rings under the trade mark SPORTSGIRL BOY. Attached hereto and marked Exhibit


"NM-14" is a copy of the label applied to these goods. The goods were offered for sale by SPORTSGIRL stores throughout Australia. A total of 11,673 items were sold under the SPORTSGIRL BOY trade mark.

I am aware that it is common in the Australian fashion industry for businesses to offer for sale both women's and men's clothing. Examples of businesses offering for sale both women's and men's clothing include Sportscraft, Country Road, Jag, Saba, Mooks, Colorado, Just Jeans, Jeans West, Cotton On, Fletcher Jones, Giordano and Rivers

12. Ms Symons declaration is compendious and is related to the latter paragraph in Ms Milgrom's declaration, above. Put as briefly as possible, Ms Symons attests to a pattern of applications and registrations on the Australian, United Kingdom, European Community, and United States, trade mark registers of what may be termed 'pairings' of trade marks in Class 25 of the *International (Nice) Classification of Goods & Services* which incorporate or imply a 'boy/girl' motif, or relationship.
13. A few examples from the Australian and European Community registers will suffice:


Australian



Owner	Trade Mark	Numbers	Status
Platypus Wear Inc		745702	Registered
	BAD BOY	774278	Registered
	BAD GIRL	777094	Registered
Pacific Brands Clothing	JUST 4 BOYS	1148524	Pending
	JUST 4 GIRLS	1148528	Pending
JM & LE Pty Ltd		1085653	Lapsed

Owner	Trade Mark	Numbers	Status
Jonathon Cotsoglou		1029083	Registered
Thirdcosta Pty Ltd	wogboys	722586	Registered
	WOGGIRLS	728521	Expired – renewal possible
GSM (Operations Pty Ltd	BILLY BOY	763111	Registered
	BILLY GIRL	763113	Registered

14. There are some six other examples given in evidence concerning the Australian register of trade marks.

European Community

Owner	Trade Mark	Numbers	Status
Urban Decay Cosmetics LLC	CANDY BOY	504407	CTM Registered
	CANDY GIRL	504431	CTM Registered
Greenspot Limited	FINTER BOY	701037	CTM Registered
	FINTER GIRL	1313022	CTM Registered
Karsten Masthoff		2168581	CTM Registered
STADE (Société Anonyme à conseil d'administration)	RUGBY GIRL	5016118	CTM application opposed
	RUGBY BOY	5016126	CTM application opposed

Owner	Trade Mark	Numbers	Status
No Ordinary Designer Label Limited, trading as Ted Baker		2985745	CTM Registered
		1334176	CTM Registered

15. An analogous and more extensive pattern of applications and registrations is found on the USA and United Kingdom registers of trade marks.
16. The further evidence is the declaration by Tony Victor Lolis. This declaration exhibits a memorandum from Gavin Gage, Buying Manager, Apparel, of the opponent to Darise Riley, of Sussan Corporation. Mr Gage says in his memorandum:

The meeting with Filip Sali [the applicant] in January of this year [2006] was to discuss what he was currently doing and if there was any possibility in Filip developing womenswear product for Sportsgirl under the "Young Designer" concept.

I recall the meeting going for approximately 45 minutes at which time I was taken through photos of previous collections Filip had shown at 'Melbourne Fashion Week,' story boards and garments.

The meeting was predominately about Sportsgirl and womanswear. Filip then mentioned that he believed there should be a "Sportsboy" for guy's as there wasn't anyone doing the equivalent of Sportsgirl for guys in Australia. It was an off the cuff comment at which time I agreed.

The meeting concluded at which time I agreed to keep in contact as the collection shown were not right for the business at that time.

Since then I have received two emails from Filip being invitations to collection showings he has done. Both times I have declined due to prior commitments. [parenthetical material added].

17. The Notice and evidence shows that the opponent has a number of trade mark registrations in Australia of which I will recite three as being relevant:

Regn Number: 192015
 Priority Date: 24 December 1964
 Goods: **Class: 25** Articles of clothing for women being casual clothes, knitwear, blouses, skirts, slacks, bridal wear, coats, frocks, dresses, suits, stockings, after-five ensembles, sub-teens wear, and clothing accessories including belts; but excluding sportswear of all kinds and undergarments,
 Trade Mark: SPORTGIRL

Regn Number: 703040
 Priority Date: 22-FEB-1996
 Goods: **Class: 25** Clothing, clothing accessories in class 25, footwear and headgear

Trade Mark: 

Regn Number: 518955
 Priority Date: 12 September 1989
 Goods: **Class: 25** Clothing, including boots, shoes and slippers; and all other goods in this class
 Trade Mark: SPORTSKIDS

The grounds

18. At the hearing, the opponent argued grounds of opposition under sections 44, 60, and 42 of the Act. For the sake of completeness, I now note that those other grounds on the Notice have not been established.

Section 44

19. Section 44 of the Act relevantly provides:

44 Identical etc. trade marks

(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.

20. Given that the goods in question are the same goods, and that the registrations on which the opponent relies are earlier than that of the opposed application, the sole question for my consideration under section 44 is whether the trade marks of the parties are deceptively similar.

21. Deceptive similarity is defined by section 10 of the Act:

10 Definition of *deceptively similar*

For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

22. In *Registrar of Trade Marks v Woolworths* [1999] FCA 1020, at paragraph 50, French J discussed the concept of deceptive similarity in the following terms:

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."

23. The classic statement concerning the comparison of the trade marks is that in *Australian Woollen Mills Limited v F S Walton and Company Limited* [1937] HCA 51; (1937) 58 CLR 641:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard. Evidence of actual cases of deception, if forthcoming, is of great weight.

24. And in *In Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777), Parker J said:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods -- then you may refuse the registration, or, rather, you must refuse the registration in that case.

25. The opponent submits that the opposed SPORTSBOY trade mark incorporates the essential distinguishing or memorable features of the SPORTSGIRL and SPORTSKIDS trade marks, with the respective trade marks adopting the word SPORTS in conjunction with a second word of similar meaning being a young person with both words in each trade mark conjoined. The opponent further submits that:

In London Lubricants (1920) Limited's Application (1925) 42 RPC 264 at 279, Sargant LJ observed that "the tendency of persons using the English language to slur the termination of words ... has the effect necessarily that the beginning of words is (sic) accentuating comparison, and ... the first syllable of a word is, as a rule, far the most important for the purposes of distinction".

The Applicant has adopted the same first word as the word adopted in the Opponent's suite of SPORTSGIRL and SPORTSKIDS trade marks.

As observed in *Fitton's application*¹ the words "likely to deceive or cause confusion" place no limitation "upon the nature of the confusion or deception so envisaged, whether it be visual or phonetic confusion of the marks themselves, what is termed contextual confusion, or deception as to the trade provenance of the goods".

Confusion can result from the "well-known trade practice of traders in adopting a certain word as a trade mark and construing other trade marks for distinguishing characteristics of their goods by using such words as a basis and adding thereto prefixes of a qualifying nature"².

26. I think that the type of analysis suggested by the opponent, above, in the circumstances of the opposed trade mark, is problematical. The common, or shared, element between the trade marks is the word 'sports'. The word has a very low capacity to distinguish the goods of any one trader in respect of the goods of interest

¹ *John Fitton & Co. Ltd's Application (1949) 66 RPC 110 at 113:*

² *Kodak Australasia Pty Ltd's Appn (1936) 6 AOJP 1724 (Reg)*

here which are 'clothing etc'. One might readily expect that any trader who is making sports clothing might alight upon the word to use in respect of its clothing for the sake of its ordinary meaning – as such, the word is not one which the ordinary public is accustomed to use to distinguish between the goods of one trader and another. The word 'sports' is accordingly of much the same sort of genus as is the word 'cola' which was referred to in *The Coca-Cola Co of Canada Ltd v Pepsi-Cola Co of Canada Ltd* (1942) 59 RPC 127. The situation here thus contrasts with that in *Fitton*, above, where the Assistant Comptroller said:

With reference to the nature of the confusion alleged the evidence furnished on behalf of the Opponents by their trade declarants is directed not so much towards showing that the two marks 'Jests' and 'Easyjests' might themselves be confused either visually or orally, as towards establishing that confusion would result, owing to the presence of the common element 'Jest' in each mark, in traders and the public being induced to believe that the two sets of goods sold under the marks emanated from one and the same trade source.

27. The above words were in the context of the element JESTS being inherently distinctive of the goods in question. However, the word 'sports' within the parties' trade marks has a quite different kind of work to do.
28. The words 'girl' or 'kids' in the opponent's trade marks do, of course, only indicate the intended consumers of the goods – so they are in very much the same category of word as the words 'sports' and 'cola' mentioned above.
29. On this type of analysis, where the elements that form the trade marks, and the trade marks as wholes, are taken and considered in isolation from all of the circumstances, the trade marks of the parties are not strongly 'similar'.
30. However, I do not think that this is the end of the matter. There remains that fact that the opponent has used the trade mark SPORTSGIRL BOY, and the trade mark SPORTKIDS is registered by the opponent – I have no information as to whether the latter trade mark has been used. There is also the report by Mr Gage of his meeting with the applicant to the effect that:

The meeting was predominately about Sportsgirl and womanswear. Filip then mentioned that he believed there should be a "Sportsboy" for guy's as there wasn't anyone doing the equivalent of Sportsgirl for guys in Australia.

31. The applicant's alleged observation is, of course, capable of quite innocent explanation – neither does it necessarily go so far as to invoke the principle in *Australian Woollen Mills*, above, that:

The rule that if a mark or get-up for goods is adopted for the purpose of appropriating part of the trade or reputation of a rival, it should be presumed to be fitted for the purpose and therefore likely to deceive or confuse, no doubt, is as just in principle as it is wholesome in tendency. In a question how possible or prospective buyers will be impressed by a given picture, word or appearance, the instinct and judgment of traders is not to be lightly rejected, and when a dishonest trader fashions an implement or weapon for the purpose of misleading potential customers he at least provides a reliable and expert opinion on the question whether what he has done is in fact likely to deceive. Moreover, he can blame no one but himself, even if the conclusion be mistaken that his trade mark or the get-up of his goods will confuse and mislead the public. But the practical application of the principle may sometimes be attended with difficulty.

32. However, given the pattern of use and/or registration of the trade marks SPORTSGIRL BOY and SPORTSKIDS by the opponent, and the applicant's alleged statement that there might be some kind of equivalence in both the trade marks SPORTSGIRL and SPORTSBOY and the goods – together with the fact that the evidence shows that these types of GIRL/BOY coinages in trade marks are not uncommon in the Australian marketplace and across the British, American, and European marketplaces, I think that the opponent has done sufficient work in transferring the onus onto the applicant to show that the trade mark will not confuse or deceive.
33. This is particularly so when the above circumstances are juxtaposed against the undoubted reputation of the opponent's primary SPORTSGIRL trade mark. The case-law indicates that in some circumstances it is impractical to ignore the reputation of a trade mark in the comparison – particularly where the that reputation is strong and unlikely to be divorced from the minds of consumers in any comparison they might make: *Registrar of Trade Marks v Woolworths* [1999] FCA 1020; *Coca-Cola Company v All-Fect Distributors Ltd* (1999) 96 FCR 107; *CA Henschke & Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42; (2000) AIPC 91-640; (2001) ATPR 41-793; [2000] FCA 1539.

34. The applicant has not put in any evidence. In not electing to appear or respond, “*in any way to the opposition proceedings the applicant renders its application more susceptible to refusal, since it is not appropriate that the Registrar act as an advocate on [the applicant's] behalf*”: *Camelot Design Industries Group Pty Ltd v Bernard Leser Publications Pty Ltd* (1987) 9 IPR 596 at 598. I am mindful that *Camelot* was a decision under the *Trade Marks Act 1955* where the onus was on the applicant to show that the use of its trade mark would not confuse or deceive. I am also mindful that I must consider the fair notional use of the opposed trade mark: *Re Smith Hayden and Co's Application* (1946) 63 RPC 97 at 101.8:

Assuming a use by the proprietor of each of the cited trade marks in a normal and fair manner in respect of any of the goods covered by those registrations, is the court satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if the applicant for registration (the respondent to this application) also uses its mark normally and fairly in respect of goods covered by the proposed registration.

35. However, as I have said, the opponent’s evidence does, in my consideration, require an explanation from the applicant. The opponent’s evidence, taken as a whole, suggests that the application in these circumstances of the test in *Smith Hayden* might be have been countered by the thrust of the opponent’s evidence. I am also mindful of the words of Mason J in *Berlei Hestia* , above:

"...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."

36. Accordingly, I find that the opposition in terms of section 44 has been established.
37. As it is not necessary, I will not discuss the opposition in terms of sections 60 and 42.

Decision

38. 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.

39. I refuse to register application 1069648.

Costs

40. The opponent has requested its costs – as it has been successful, I award costs against the applicant at the official scale.

Iain Thompson
Hearing Officer
Trade Marks Hearings
22 October 2007