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TRADE MARKS ACT 1995

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

Re: Opposition by Bravehearts Inc to registration of trade mark application 1103464(41) – **BRAVE HEARTS and device** - filed in the name of Brainstorm Productions Pty Ltd.

DELEGATE:	Frances Aarnio
REPRESENTATION:	Opponent: Carmen Champion of counsel, instructed by Henry Davis York, Sydney Applicant: Andrew Fox of Counsel, instructed by Spruson & Ferguson, Sydney
DECISION:	2009 ATMO 25 Section 52 opposition – s 60 ground established; costs awarded against applicant.

Background

1. On 14 March 2006 Brainstorm Productions Pty Ltd ('the applicant') applied to register the trade mark depicted below for *Education, namely children's theatre in education (live performance and accompanying support material)* in class 41:



2. The application was examined, and on 13 July 2006 advertised as accepted for possible registration in the *Official Journal of Trade Marks*.
3. On 21 July 2006, Bravehearts Inc ('the opponent') filed Notice of Opposition, listing grounds under ss 58 and 60 of the *Trade Marks Act 1995*.
4. The parties filed and served Evidence in Support, Evidence in Answer, Evidence in Reply, and Further Evidence.
5. The opponent requested to be heard and the matter came before me as a delegate of the Registrar in Sydney on 15 October 2008. Carmen Champion of counsel,

instructed by Henry Davis York, represented the opponent. Andrew Fox of counsel instructed by Spruson & Ferguson, represented the applicant.

6. The applicable law is that which existed as at the filing date of the application, 14 March 2006 ('the priority date').
7. The opponent has the onus of establishing a ground of opposition on the balance of probabilities.¹

Evidence and submissions

Opponent's evidence and submissions

8. The opponent filed and served the following evidence prior to the hearing:

Type	Declarant	Date	Exhibits	Referred to as
Evidence in support	Hetty Johnston	18 December 2006	HJ1-14	H Johnston (1)
Evidence in reply	Hetty Johnston	22 November 2007	HJ1-4	H Johnston (2)
Further evidence	Hetty Johnston	4 March 2008	HJ1-53	H Johnston (3)
	Lynette Patman	4 March 2008		L Patman

9. At the hearing the opponent sought permission under regulation 5.15(1) (b) to file and serve further evidence, namely the statutory declaration of Hetty Johnston dated 15 October 2008 ("H Johnston (4)"). The opponent submitted that the evidence had become available shortly before the hearing and, further to declarations H Johnston (3) and L Patman, the evidence showed instances of confusion occurring between the competing marks, one instance being as recent as September 2008. Although all of the instances of confusion referred to took place after the priority date, the evidence, the opponent said, had a bearing on the true state of affairs as at the priority date (see *Conde Nast Publications v Virginia Taylor*²).

¹*Pfizer Products Inc v Karam* [2006] FCA 1663.

² [1998] FCA 864.

10. The applicant reminded me that the evidence should only be allowed into proceedings if it was of relevance and not available beforehand.
11. After weighing the opponent's argument against the additional cost and inconvenience to the applicant, I advised the parties that I considered the nature of the material was of relevance to the proceedings and that it was appropriate to grant the opponent permission to serve the further evidence. A copy of H Johnston (4) was subsequently provided to the applicant, who indicated that it would make verbal submissions in response to the evidence during the course of the hearing.
12. I will turn now to the opponent's evidence and submissions in general.
13. The opponent argued that registration of the applicant's trade mark would lead to deception and confusion because of the opponent's reputation in deceptively similar trade marks that contain the terms BRAVEHEARTS or BRAVE HEARTS. Its arguments may be summarized as:
 - The opponent is a not for profit organization registered under the *Collections Act 1966 (Qld)*. It provides charitable services relating to the prevention of child sexual abuse.
 - In September 2001, under its former name, the People's Alliance Against Child Sexual Abuse Inc, the opponent applied to register the word BRAVEHEART as a trade mark for *children's charity services*. Registration was opposed by a third party and the application was eventually withdrawn.
 - In November 2001, the opponent changed its name to BRAVEHEARTS INC. At about that time it also developed a logo consisting of a cartoon lion. Since early 2002, the opponent has used both the words BRAVEHEARTS INC, and a combination of the words BRAVE HEARTS and lion logo, to indicate the origin of its charitable services.
 - In late 2002, with assistance from government agencies and experts in the child protection field, the opponent developed an interactive CD, "Ditto's Keepsafe Adventure" to teach children how to protect themselves against sexual abuse. The mark BRAVEHEARTS INC appears on the CD. In 2003, the CD was offered for

sale in a number of retail outlets, via a website www.ditto.com.au, and direct from the opponent by telephone. The CD was launched nationally at White Balloon Day in 2004. In 2005, it was favourably reviewed in a New South Wales educational magazine. Later in the same year, the opponent began to develop the CD material into a live performance for schoolchildren. The show, which is also named “Ditto’s Keepsafe Adventure”, has been presented to schools in Queensland, Western Australia, New South Wales and Victoria.

- Before the relevant priority date, the opponent had garnered a significant reputation in use of both the marks BRAVEHEARTS INC and BRAVE HEARTS and lion in connection with its services. It has used and promoted the marks by way of public rallies, television and radio interviews, newspaper and magazine articles, community announcements, public awareness campaigns such as White Balloon Day, the opponent’s website and charitable collections. Items featuring the marks have included the educational CD, stationery items, press releases, collection tins, and uniforms worn by members of the opponent.
- The opponent is aware of instances of confusion that have occurred between the applicant’s play and the opponent’s educational performance.

Applicant’s evidence and submissions

14. The applicant’s evidence consisted of the following:

Type	Declarant	Date	Exhibits	Referred to
Evidence in answer	Jennifer Johnson	13 February 2007	BH1-30	J Johnson (1)
Further evidence	Jennifer Johnson	22 January 2007 ³	BH1-19	J Johnson (2)
	Kasadevi Curtis	4 April 2008		
	Bronwyn Corby	4 April 2008		
	Jennifer Johnson	10 October 2008		J Johnson (3)

15. The applicant contends there is no real likelihood of confusion arising if its mark is registered for the following reasons.

³By way of J Johnson (3), Ms Johnson corrects this date to 4 April 2008.

- The applicant is well known in Australia as a producer of educational theatre for schoolchildren. Its shows are designed to assist children to deal with a wide range of social issues, including diversity, bullying, harassment, sexual abuse and change.
 - In 2001, it developed its “Brave Hearts” show. The show is aimed at Kindergarten to Year 6 and deals with resilience and coping with change. After the show’s first live performance in March 2002, the applicant received official approval to present it in schools in New South Wales and Queensland. The show was advertised by print media and direct mail, and follow-up educational material, including posters and a CD, was designed and printed.
 - The “Brave Hearts” show has been included in the applicant’s program since 2003 and has toured schools in Queensland, New South Wales, Australian Capital Territory, Victoria and South Australia.
 - In 2004, the show received the New South Wales Department of Education’s Frater Award in recognition of excellence within the Performances for Schools Program 2004. The show’s theme song, which is also entitled “Brave Hearts”, was included in the 2005 edition of the ABC’s “Sing” book and CD. 70,000 copies of the 2005 edition were sold in schools and homes Australia-wide.
 - As at the priority date, the opponent may have gained a reputation in relation to *charitable services* but there is no evidence that the opponent had used any marks containing Brave Hearts or Bravehearts Inc in relation to *education services*.
 - The applicant has not encountered any instances of confusion. In March 2006, it modified its “Brave Hearts” mark. Given the differences that now exist between the competing marks, the opponent’s lack of reputation in the education field, and the nature of the applicant’s show, there is no real likelihood of confusion in the future.
16. In addition to the above arguments, the applicant pointed to inconsistencies in the opponent’s evidence, in particular statements in, and exhibits attached to, the declaration H Johnston (3) relating to the opponent’s activities in the education field. I will refer to this in more detail later in this decision.

17. The applicant sought its costs. It also contended that, should the opponent be successful, costs should not be awarded against the applicant because of the opponent's conduct in preparing its evidence in support. Soon after service of evidence in reply, the opponent had sought permission to serve further evidence, stating that service of the evidence would not prejudice the applicant nor lead to significant costs implication. The evidence subsequently served had been extensive and had contained a number of inconsistencies. This had required the applicant to prepare and serve considerable detailed evidence in response, and had incurred additional expense and unnecessary delay in resolution of the opposition.

Grounds of opposition

18. At the hearing, the opponent pursued the s 60 ground only. For completeness, I record that the opponent has not established the s 58 ground listed on the Notice of Opposition.

Section 60

19. As it relates to this decision s 60 reads:

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.

20. The opponent did not allege the competing marks were identical, but pressed the issue as one of deceptive similarity. Therefore, to satisfy the ground of opposition, the opponent needs to establish:

- A pre-existing trade mark that is deceptively similar to the applicant's trade mark;
- the acquisition prior to the relevant priority date of a reputation in Australia by the pre-existing trade marks; and

- because of that reputation, a likelihood that use of the applied-for trade mark would deceive or cause confusion.

Deceptive similarity

21. Deceptive similarity is defined by s 10:

Definition of *deceptively similar*

10. 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. The tests for deceptive similarity are well established and laid down by Dixon and McTiernan JJ in *Australian Woollen Mills Ltd v F S Walton & Co Ltd*⁴. At [658] their Honours stated:

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.

23. In *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd*⁵ Windeyer J said:

On the question of deceptive similarity a different comparison must be made from what which is necessary when substantial identity is the question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's marks that persons of ordinary intelligence and memory would have; and, on the other hand, the impression that such persons would get from the defendant's television exhibitions.

24. The opponent points to its use of two marks. The first of these marks comprises the words BRAVEHEARTS INC. The second is a composite mark comprised of the

⁴ (1937) 58 CLR 641.

⁵ (1961) 109 CLR 407 at 414-415.

words BRAVE HEARTS in roman font separated by the device of a cartoon lion. The lion is rounded and it features a large heart at the end of its tail.

25. The opponent submitted that the words BRAVEHEARTS or BRAVE HEARTS are essential features of each of the competing marks, and, as per *Starr Partners Pty Ltd v Dem Prem Pty Ltd (No. 2)*⁶ the marks would be remembered by the word elements. In addition, the opponent contended, the applicant's mark and the opponent's composite marks each contain a large heart device. Overall, the opponent argued, the competing marks present the same ideas. In response, the applicant pointed to the obvious visual differences between the marks as sufficient to mitigate any likelihood of confusion.
26. I acknowledge there are visual differences between the competing marks, namely the different device elements, and the presentation of the word elements. The words in the opponent's marks are in plain font whereas each of the words in the applicant's mark is in a different font. Despite these visual differences, I agree with the opponent that the marks create the same net impressions. They share the same word elements, and create the same idea of emotional courage.
27. BRAVEHEARTS is the distinguishing and memorable feature of the opponent's first mark, BRAVEHEARTS INC. The words BRAVE HEARTS also feature prominently in the opponent's second mark. While the lion may create a strong impression on some very young children, older children and adults who would be included in the target market are likely to recall the words and the central idea of courage symbolized by the lion. Both marks are likely to be remembered by the words and the idea they create.
28. Despite the stylization of the applicant's mark, the word elements are the identifying features. As a whole, the mark creates the same idea of "emotional courage" as the opponent's marks, the heart device serving to reinforce the "emotional" concept.
29. I am satisfied the competing marks create the same impressions and are deceptively similar.

⁶ (2007) 71 IPR 459.

Reputation as a trade mark

30. The applicant argued that any reputation the opponent had at the priority date was as a lobby group in relation to child sexual assault, and that such reputation was limited to Brisbane, Queensland.
31. In *McCormick & Co Inc v Mc Cormick*⁷ Kenny J considered the question of reputation. At [127] Her Honour decided that, as far as s 60 is concerned, what might be intended by reputation is recognition of the trade mark by the public generally.
32. As a not for profit organization, the opponent provides *charitable services*. As it does not sell its services, or offer goods for sale for its personal profit, it is dependent on establishing a commercial reputation through exposure of its marks to the public by other means, for example, community announcements, business papers and advertising material, fund raising activities and educational material.
33. I am satisfied the opponent has provided sufficient evidence of public use and recognition of the marks to show it has the required reputation.
34. It has, since 2002, used both the trade mark BRAVEHEARTS INC and the composite marks BRAVE HEARTS and lion device, in connection with community service announcements and press releases, on its stationery, in relation to fundraising, on uniforms worn by its staff members, collection tins, in relation to promotion of public awareness campaigns such as White Balloon Day, on T-shirts and in connection with sales and promotion of the educational CD.
35. At the priority date, the opponent's services centered in Queensland. Given the sensitivity of the social issue it covers, however, the opponent had received media exposure Australia-wide. As a representative of the opponent, its founder had taken part in national radio and television interviews. Articles relating to the opponent and its services had appeared in national newspapers and magazines, and politicians and celebrities had acknowledged its efforts and achievements under the trade marks.

⁷ (2000) 51 IPR 102.

Inconsistencies in opponent's evidence

36. The applicant pointed to inconsistencies in the opponent's evidence, in particular statements in H Johnston (3) which purport to demonstrate evidence of the opponent's use of its marks in connection with live performances before the relevant priority date. The material contained at these exhibits uses a variety of web addresses and email addresses, or displays references to material which other evidence provided by the opponent suggests did not exist at the date claimed. Although the opponent attempted to address some of these inconsistencies in its submissions, I accept the applicant's concerns.
37. In its submissions, the opponent stated that it registered the domain name www.bravehearts.org.au in 2002 but went live with the website in 2004. Exhibit HJ-16 of H Johnston (3), however, shows the opponent applied to register the domain name **braveheart.org.au** (my emphasis) on or about 19 September 2001. At Exhibit HJ-17 of H Johnston (3) is an email dated 24 April 2002 relating to a web site www.bravehearts.com.au, (my emphasis) and the results of a search on WayBackMachine that shows use of its current domain name, www.bravehearts.org.au, from August 2003.
38. All I am able to draw from this is that the opponent applied to register a domain name braveheart.org.au on or about 19 September 2001 and began using its current website www.bravehearts.org.au in August 2003. Therefore, the opponent's evidence that purports to predate August 2003, but which features the domain name www.bravehearts.org.au, must either show an incorrect web address, or originate from a later date than that claimed.
39. I am not prepared to speculate as to which of the latter may be correct, nor do I imply that the opponent has set out to mislead. However, I cannot include contradictory material in an assessment of the opponent's reputation. I wish to make it clear that I have given no weight to material that purports to predate August 2003, but which features the applicant's current domain name, or to material that purports to predate the relevant priority date, 26 March 2006, but which displays or contains references to events that had not then occurred or material that did not exist. Those exhibits are HJ-22, HJ-23, HJ-32, HJ-33 and HJ-45 of H Johnston (3).

40. Leaving aside the material referred to at paragraph 39 above, I am satisfied the opponent's evidence includes sufficient examples of public use of the marks before the relevant priority date to establish the required reputation.

Deception and confusion

41. The applicant has used its trade mark in connection with its show since 2002 and has not encountered any instances of confusion. It has always used its Brave Hearts mark together with its company name and considers confusion is unlikely in the future, particularly as the subject of its show is "coping with resilience and change". As the opponent correctly points out, the concern is not with the use to which the applicant has put its mark but the use to which the applicant could properly put the trade mark should it gain registration.
42. French J in *Registrar of Trade Marks v Woolworths Ltd*⁸, while discussing the question of deceptive similarity, considered deception and confusion. At [428] he commented:

...(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

⁸ (1999) 45 IPR 411.

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 363:

“. . . 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.”

43. The opponent has not demonstrated a strong reputation in relation to educational services at the priority date. However, s 60 does not require a similarity of goods or services.⁹ It is sufficient if consumers are likely to infer some trade association between the respective sets of products.
44. The services designated by the applicant are broad and not limited to any particular genre. The opponent has garnered a reputation in connection with a high profile and sensitive social issue – the prevention of child sexual abuse. While ever the applicant’s services cover education in relation to that issue, or any related psychological or social topic, I am satisfied that some members of the target market will infer a commercial connection between the applicant’s services and the opponent. The closer the applicant moves to the opponent’s area of reputation, the stronger the likelihood of confusion.

Summary

45. In summary, I am satisfied that at the relevant date the opponent has a reputation in Australia in marks comprising the words BRAVEHEART INC, and the words BRAVE HEARTS and lion device. I am also satisfied that the extent of that reputation is such that the applicant’s use of its trade mark in relation to its designated services is likely to cause deception and confusion.

Decision

46. Section 55 provides:

⁹ *Natural Supplementary Association Inc v Body for Life International Pty Ltd* (2004) 59 IPR 634.

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.

47. The opponent has established the s 60 ground of opposition. In accordance with s 55(a), I refuse to register trade mark application 1103464.

Costs

48. Both parties requested their costs in this matter. It is usual that costs follow the event. However, the applicant argued that if the opponent was successful, the opponent's conduct in serving evidence in support of the opposition should be taken into account and costs should not be awarded against the applicant.
49. I reject the applicant's argument that the opponent's conduct has been such that it is not entitled to any costs in this matter. The opponent has made out its case and has incurred the normal costs in doing so. I agree, however, that the applicant has incurred additional expense and unnecessary delay in the resolution of this matter, because of the manner in which the opponent prepared its evidence in support. In the circumstances, although the applicant is the unsuccessful party, I see no reason why it should bear the full burden of costs, even in terms of the scale.
50. Accordingly, I award costs against the applicant in accordance with Schedule 8, Part 1 of the *Trade Marks Regulations*, with the exception of Item 2, Evidence in Support.

Frances Aarnio
Trade Marks Hearings

30 March 2009