

TRADE MARKS ACT 1995

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

Re: Opposition by The PAS Group Pty Ltd to protection of International Registration Designating Australia 1127534(25) - **PAS LOGO** – (International Registration number 889128) filed in the name of Egon Pedersen.

DELEGATE:	Michael Kirov
REPRESENTATION:	Opponent: Jane Owen of Middletons, Lawyers Holder: Claude Anese of Cullen & Co, Patent & Trade Mark Attorneys
DECISION:	2009 ATMO 17 Regulation 17A.29 opposition: Grounds under ss. 42(b) and 60 pressed. No ground established. Extension of protection to Australia allowed. Costs awarded against Opponent.

Background

1. Application 1127534, an international registration designating Australia (“IRDA”), was filed in the name of Egon Pedersen (“the Holder”) of Denmark under the Madrid Protocol on 18 May 2006 (“the Priority Date”). IP Australia was notified of this on 3 August 2006 and, following examination of the IRDA, advertised on 25 January 2007 its intention to extend protection to Australia.

2. Details of the IRDA are as follows:

Application Number: 1127534
International Number: 889128
Priority Date: 18 May 2006
Goods: **Class: 25** Clothing, footwear, headgear
Trade Mark:



(“the Trade Mark”)

3. On 20 April 2007 The PAS Group Pty Ltd (“the Opponent”) lodged Notice of Opposition (“the Original Notice”) to extension of protection of the IRDA to Australia.

4. On 19 February 2008 the Opponent completed service of its evidence in support of the opposition, being Statutory Declaration by Eric Morris made 18 January 2008 with Exhibits A to G (“the Morris Declaration”).
5. On 19 June 2008 the Holder’s attorneys formally advised that the Holder would not be serving evidence in answer and requested the matter be set down for hearing.
6. The matter was heard before me as delegate of the Registrar of Trade Marks on 17 October 2008 in Sydney. Claude Anese of Cullen & Co, Patent & Trade Mark Attorneys appeared for the Holder. Jane Owen of Middletons Lawyers appeared for the Opponent.

Grounds of opposition

7. While the Original Notice specified several grounds, Ms Owen advised IP Australia and Mr Anese by fax sent on the eve of the hearing that the Opponent would only be pressing grounds corresponding to sections 42(b) and 60 of the *Trade Marks Act 1995* (“the Act”). The fax included an amended Notice of Opposition (“the Amended Notice”) containing these two substantive grounds only, in addition to a general request that the Trade Mark should not be registered “in the special circumstances of the case”. By consent, the Amended Notice has effectively replaced the Original Notice in these proceedings.
8. That said, the Amended Notice, unlike the Original Notice, purported to include s.60 as it stood following significant amendment under the *Trade Marks Amendment Act 2006*. This amendment to s.60 only however applies to trade mark applications filed before 23 October 2006¹. The Priority Date of the opposed application is 18 May 2006. I am thus proceeding on the basis that the Opponent’s s.60 ground is as set out in the Original Notice, namely:

The Trade Mark is substantially identical with or deceptively similar to a trade mark that, before the priority date of the Trade Mark, had acquired a reputation in Australia such that the use of the Trade Mark in respect of the goods and/or services for which the Trade Mark is sought to be registered would be likely to deceive or cause confusion.

¹ *Apple Computer v TodayTech Group Pty Ltd* [2007] ATMO 40

9. The ground based on s.42(b) of the Act contained in the Amended Notice is simply that “the use of the Trade Mark would be contrary to law”. In her fax to IP Australia and to Mr Anese on the eve of the hearing Ms Owen however specified:

that Egon Pedersen’s (the Applicant) use of the Mark in relation to the goods and/or services would be contrary to the provisions of sections 52 and 53 of the Trade Practices Act 1974 (Cth) or the equivalent provisions in the relevant State legislations, and thereby contrary to law

10. At the hearing itself Ms Owen further specified that with respect to s.53 of the *Trade Practices Act 1974* (Cth) it was in particular ss.53(a), (c) and (d) (and their relevant State equivalents) on which the Opponent relied.
11. I confirm I am proceeding on the basis that the Opponent need establish one or both of its grounds of opposition on the balance of probabilities.²

Preliminary Issue

12. At the hearing Mr Anese sought to tender an “Historical Company Extract” relating to the Opponent company, which Mr Anese had obtained via the online database of the Australian Securities and Investments Commission on 14 October 2008 (“the ASIC extract”). Ms Owen strongly objected to this. I nevertheless confirmed at the hearing I would look at the document and, to the extent that it shed light on matters requiring determination in the opposition, would take its contents into account.
13. I mention there is ample authority that I may take such publicly available information into account if relevant, provided the material in question is purely factual (and not open to significantly differing interpretation) and provided natural justice is accorded to the parties³. Here I do not believe the Opponent can legitimately claim it has been “ambushed” or has otherwise been denied natural justice since it must be assumed the Opponent was and is already aware of the details of its own incorporation. Moreover it is only factual matters disclosed on the face of the ASIC extract such as the date of incorporation and the dates changes to the Opponent’s name were recorded which appear to be of significance.

² Following Gyles, J in *Pfizer Products Inc v Karam* (2006) 70 IPR 599

³ See for example *Dow Chemical Co v CH Boehringer Sohn KG* (1987) 9 IPR 360 (at 364); *Prosimmon Golf (Aust) Pty Ltd v Dunlop Australia Ltd* (1987) 9 IPR 425 (at 428); *Amco Wrangler Limited v Jacques Konckier* (1987) 10 IPR 376; *McDonalds Corporation v Bellamy* (2004) 62 IPR 133; *Geoffrey Inc v Hoyle* (2004) 63 IPR 196 (at 200)

Submissions and Evidence

14. It was common ground that to possibly establish either of its opposition grounds the Opponent would in the circumstances of this case first need to identify a trade mark or trade marks to which the Trade Mark is at least “deceptively similar”⁴ and which had a significant reputation in Australia as at the Priority Date. Ms Owen began her submissions indicating that the Opponent relied upon the following three trade marks:

- PAS
- The PAS Group



15. Hereafter I refer to these three trade marks as “the Opponent’s Trade Marks”.

16. Evidence concerning the Opponent and use of the Opponent’s Trade Marks in Australia is contained in the Morris Declaration, Mr Morris being the Opponent’s Chief Executive Officer. Mr Morris explains that,

The Opponent was registered as a company by DB Capital Partners, the private equity arm of Deutsche Asset Management, and commenced operations in 2004.

17. He exhibits pages from the Opponent’s website (downloaded on 10 January 2008⁵) which state the Opponent was established:

...as part of a roll-up strategy in the apparel sector. With the backing of its majority private equity shareholder, The PAS Group’s management and board continue to target other successful, established businesses that will add further value to the Group.

The PAS way of doing business is to leverage off the collective businesses (sic) expertise and industry experience of our management team in order to maximize shareholder value.

18. The essence of Mr Morris’ evidence is that as at the Priority Date the Opponent owned four apparel businesses (identified as ‘Yarra Trail’, ‘Breakaway’, ‘The Hopkins Group’ and ‘Design Works’), which businesses in turn owned a number of

⁴ As defined in s.10 of the Act

⁵ I mention in passing that there is no evidence this website was in existence before the Priority Date.

apparel “brands” (unrelated in any respect to the Trade Mark), each of which, says Mr Morris, “enjoys a significant reputation throughout Australia and internationally”.

19. There is however no evidence that any of these businesses themselves used any of the Opponent’s Trade Marks at all. Indeed, there is no evidence that the Opponent itself used any of the Opponent’s Trade Marks before the Priority Date for goods in Class 25, or in fact for any goods. The only documented “use” of any of the Opponent’s Trade Marks prior to 18 May 2006 in the Opponent’s evidence is contained in three short articles published on 13, 21 and 24 April 2006 on the website ‘theage.com.au’ and in the trade magazines ‘The Ragtrader’ and ‘Inside Retailing Weekly’ respectively. These three articles, presumably based upon a press release by the Opponent at the time, carry essentially the same information, namely that ‘Pacific Apparel Solutions’ (later shortened in the articles to simply ‘PAS’) had a week earlier purchased its fourth established Australian apparel business, the Hopkins Group. In exhibiting these articles Mr Morris indicates they support his explanation that:

The Opponent’s registered company name at the time of registration was Pacific Apparel Solutions Group Pty Ltd. This proved to be a cumbersome name which few within the industry used. As a result the Opponent was chiefly referred to as the “PAS Group”.

20. Ms Owen submitted the three articles showed that the Opponent was, by the Priority Date, “known by and in association with the mark PAS”. I reject this. I am, rather, persuaded by Mr Anese’s submissions that the articles do not show use of any of the Opponent’s Trade Marks by the Opponent. They most likely indicated nothing more than that the journalists concerned adopted the acronym as shorthand for the purposes of the articles, as journalists invariably do. Moreover, he argued, the articles concerned the Opponent’s financial dealings, in particular its acquisitions of apparel businesses, and not any trading activity in relation to goods in Class 25. As Mr Anese put it, “the ordinary reader would not infer from such articles that the opponent is using PAS as a trade mark in relation to clothing”.
21. Not unreasonably in my view, Mr Anese also pointed out that if these three articles, published barely a month at best before the Priority Date, constitute the only substantive evidence the Opponent can adduce of its “use” of the Opponent’s Trade Marks before the Priority Date, then the Registrar could surely not be satisfied the requisite reputation which might underpin the opposition has been established. I

would only add that there is no evidence of what kind of readership the articles may have enjoyed and I am unable to assess how statistically relevant their circulation might have been in any event.

22. While the Opponent has in its evidence also claimed use of the Opponent's Trade Marks on stationery, on signage and on its various websites, I am neither satisfied any of this use occurred before the Priority Date, nor in any event that it was use in relation to goods or services similar to the "*Clothing, footwear, headgear*" covered by the opposed application. Indeed the examples of stationery in evidence bear the Opponent's address at "Building 5, Level 1, 658 Church Street, Richmond, Victoria", whereas the ASIC extract indicates the Opponent only recorded its move to this address with ASIC in August 2007. It is apparent too that photographs of signage in evidence were taken at this relatively recent address.
23. The only figure Mr Morris provides for "[t]he amount expended on advertising and promoting the [Opponent's Trade Marks] and the services in which it relates" is for the period "since August 2006", again some time after the Priority Date. No advertising or promotional material of any kind is exhibited.
24. Mr Morris also provides a figure said to be "[t]he turnover of the [Opponent] from 22 November 2005 to 30 June 2007", a period commencing around six months before the Priority Date. There is however no indication of how this "turnover" was generated, nor as to what particular goods and/or services it relates. I am accordingly unable to accord this evidence any significant weight. I note in passing that the significance of the 22 November 2005 date is explained with the assistance of the ASIC extract tendered by Mr Anese and discussed further below.
25. The Morris Declaration is moreover replete with a number of vague and apparently inaccurate claims, including the following:
 - The Opponent was registered as a company by DB Capital Partners, the private equity arm of Deutsche Asset Management, and commenced operations in 2004.
 - Since 2004 the Opponent has become one of Australia's largest wholesale apparel companies...

- The Opponent has continuously used one or more of the [Opponent's Trade] Marks within Australia since 2004.
26. As Mr Anese pointed out in his submissions, these statements are not only vague, they might on the face of it be said to be misleading. The ASIC extract indicates the Opponent was not incorporated until 22 November 2005, less than six months before the Priority Date. Further, its original name was 'Pacific Apparel Consulting Pty Ltd', and not 'Pacific Apparel Solutions Group Pty Ltd' as stated by Mr Morris⁶.
27. I note the Opponent's original name does not lend itself to coinage of the acronym 'PAS'. The ASIC extract indicates the Opponent recorded the change from its original name to 'Pacific Apparel Solutions Group Pty Ltd' on 13 April 2006, some five weeks before the Priority Date. It was however not until 4 August 2006, some months after the Priority Date, that the Opponent recorded the change from 'Pacific Apparel Solutions Group Pty Ltd' to its present name of 'The PAS Group Pty Ltd'.
28. In my view there is merit in Mr Anese's submissions that, as the Opponent's Chief Executive Officer when he made the Morris Declaration, Mr Morris must be taken to have known, or have had ready access to, basic details concerning the Opponent's incorporation date and the dates it formally changed its name. If he did know these things, then he failed to disclose them. If he did not, then the reliability of his evidence is in any event open to question.
29. There is nevertheless no need to dwell on these aspects of the Opponent's evidence. Even if the evidence were taken at face value it falls well short of establishing one or more of the Opponent's Trade Marks had sufficient reputation in Australia as at the Priority date to support either of the Opponent's opposition grounds under sections 42 or 60.

Decision

30. I have found that neither ground relied on by the Opponent has been established and as the Registrar's delegate in this matter I thus dismiss the opposition. I direct that protection of the Trade Mark be extended to Australia one month from the date of this decision in respect of all of the goods listed in the IRDA. If the Registrar has been

⁶ As quoted in paragraph 19 above.

served with a notice of appeal before that time, I direct that protection shall not occur until the appeal has been decided or discontinued or, if this decision be successfully appealed, that the application be dealt with as the Court sees fit. If the Registrar has not been served with a notice of appeal before that time the International Bureau will be notified of this decision as soon as practicable after the appeal period has ended, in accord with Regulation 17A.34(2).

Costs

31. Mr Anese requested an award of costs in the Holder's favour. As the successful party, the Holder is entitled to its costs and I award costs against the Opponent as per Schedule 8 of the *Trade Marks Regulations 1995*.

Michael Kirov
Hearing Officer
Trade Marks Hearings
18 February 2009