

## TRADE MARKS ACT 1995

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

Re: Opposition by Apple Inc to registration of trade mark application 1145308(20)  
- **i-photo** - filed in the name of Artistic Licence International.

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DELEGATE:	Michael Kirov
REPRESENTATION:	Opponent: Brian Elkington, of Clayton Utz, Lawyers Applicant: No appearance and did not lodge any written submissions
DECISION:	2009 ATMO 15 s.52 opposition: Ground under s.59 established. Registration refused. Costs awarded against Applicant.

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#### Background

1. This is an opposition brought by Apple Inc (“the Opponent”) pursuant to s.52 *Trade Marks Act 1995* (“the Act”) to registration of the trade mark **i-photo**, subject of application number 1145308 filed in the name of Artistic Licence International (“the Applicant”).
2. Details of the opposed application are as follows:  
Application Number: 1145308  
Priority Date: 8 November 2006  
Services: **Class 20**: Frames for photographs; frames for pictures  
Trade Mark: i-photo
3. I am proceeding on the basis that the Opponent bears the onus of establishing one or more grounds of opposition on the balance of probabilities<sup>1</sup>.
4. The Opponent’s Evidence in Support is contained in a Statutory Declaration by Thomas R. La Perle made on 6 February 2008, with Annexures A to H.
5. The Applicant has neither filed any evidence, nor responded in any other manner to the opposition.
6. The matter was heard before me as delegate of the Registrar of Trade Marks on 14 October 2008 in Sydney. Brian Elkington, of Clayton Utz, Lawyers, appeared for the

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<sup>1</sup> Following *Pfizer Products Inc v Karam* (2006) 70 IPR 599

Opponent. There was no appearance by the Applicant, nor did it file any written submissions. Indeed, IP Australia has not heard from the Applicant since the opposed application was filed more than two years ago on 8 November 2006.

*The Applicant*

7. It is necessary to say something about the Applicant at this stage.
8. I note that the Applicant filed the opposed application in the name of “Artistic Licence International”, suggesting that the Applicant may have been an individual (or individuals) who, or possibly a company (or companies) which, had registered this name as a business name. The Applicant also however provided the ACN (that is, Australian Company Number) 112 237 920 in its application. I have checked the publicly available online records of the Australian Securities and Investments Commission (“ASIC”) which indicate the ACN in question belongs to a company, whose full name is “Artistic Licence International Pty Ltd”. (No business name containing or consisting of the words “Artistic Licence International<sup>2</sup>” appears in ASIC’s online records.)
9. ASIC’s records indicate the company “Artistic Licence International Pty Ltd” was first registered on 16 December 2004, but that the only document lodged with ASIC since incorporation (and up to the time of writing) was notification of a change of address, which was lodged on 14 February 2007.
10. The address the Applicant provided to IP Australia when the opposed application was filed on 8 November 2006 is clearly incomplete, being “Level 2, George Street, Sydney 2000, NSW Australia”. Not surprisingly given “George Street” is one of Sydney CBD’s main thoroughfares stretching for some three kilometres, all correspondence sent by IP Australia to this nominated address has been returned by Australia Post marked “Insufficient Address”.
11. IP Australia staff consequently checked for and located an entry for “Artistic Licence International” on the website ‘www.whitepages.com.au’ (that is, the electronic “White Pages” or online telephone directory) on 29 July 2007. This entry indicated the address of “Artistic Licence International” was “1/822 George Street, Sydney

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<sup>2</sup> Whether the word “Licence” is spelled as “Licence” or “License”.

2000” and that its telephone number was (02) 9011 7575. IP Australia wrote to “Artistic Licence International” care of this address on 29 July 2007 requesting it to formally advise its current address. This letter, too, was returned by Australia Post, this time marked “Not at Level 1/822 George St”.

12. On 27 August 2007 an IP Australia staff member then telephoned (several times throughout the day) the number for “Artistic Licence International” which had earlier been located in the electronic White Pages. The telephone was however never answered.
13. On 14 September 2007 an IP Australia staff member again called the telephone number the Applicant had provided at the time the opposed application was filed. The call was answered by a machine. The staff member left a detailed recorded message providing information about the trade mark opposition on foot and requesting correct address details so that relevant correspondence could be sent. IP Australia has not received any response.
14. As at the time of writing, the only entry in the electronic White Pages for an entity whose name contains or consists of the words “Artistic Licence International<sup>3</sup>” remains that described in paragraph 11 above. I have again tried this number several times both at night and during business hours over the past few days and was met with a “busy” signal each time. I then telephoned Telstra’s “faults” department and was informed that the number, according to its records, is not currently allocated.
15. At the hearing Mr Elkington confirmed that all correspondence sent by his firm to the Applicant’s nominated address for service had been returned by Australia Post marked “Insufficient Address”.

### **Grounds of Opposition**

16. The Notice was filed on 1 June 2007 and lists twelve specific grounds corresponding to various provisions of the Act. At the hearing, however, Mr Elkington indicated the Opponent would only be pressing those grounds based on sections 42(b), 44, 58, 59 and 60 of the Act and limited his submissions accordingly. I am treating the remaining grounds listed in the Notice as abandoned. That said, I consider the

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<sup>3</sup> Again, whether the word “Licence” is spelled as “Licence” or “License”.

opposition may appropriately be decided based on the Opponent's s.59 ground in this case and it has not been necessary to specifically address the Opponent's further grounds in this decision.

## **Discussion**

### ***Section 59***

17. The ground based on section 59 is indicated in the Notice as follows:

The Applicant does not intend to use, or authorise the use of, or to assign to a body corporate for use by the body corporate in Australia, the trade mark in relation to the goods specified in the application.

18. Section 59 of the Act is reproduced below:

The registration of a trade mark may be opposed on the ground that 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 and/or services specified in the application.

Note: For *applicant* see section 6.

19. Hearing Officer Debrett Lyons conducted a review of authorities on the issue of intention to use in the recent decision of *Americana International Limited v Suyen Corporation* (2008) 75 IPR 596 ("the BENCH BODY Logo case"). It is of course well accepted that for most available grounds of opposition under the Act the relevant date at which the parties' rights should be assessed is the date the opposed application was filed. However, as pointed out by the Hearing Officer in the BENCH BODY Logo case, there have been a number of decisions noting s.59 is written in the present tense and that its operation is therefore a continuing one. As the Hearing Officer put it (at [27]):

What is clear is that the intention of the applicant is an ongoing intention not limited by its state of mind at the filing date of the application. Less clear is the proposition that the relevant date is the date the Notice of Opposition was filed. Other cases, some of which are referred to later, suggest that the relevant date is the date of the hearing, but it seems to me that the correct "cut-off" date is when the last evidence is filed. In some cases, for example where further evidence is admitted at a hearing, that date might be the hearing date. In very rare cases, it might even coincide with the filing of the notice of opposition, but what seems to me to be critical is the time when the record of admissible evidence closes.

20. While not crucial in this particular matter, I confirm I am proceeding in this decision on the basis that the relevant date for assessing the Applicant's intention to use the opposed device mark subject of application 1145308 is 13 February 2008, being the date the La Perle declaration constituting the Opponent's evidence in support was filed with IP Australia (and the day after service of a copy of the declaration on the Applicant was attempted).
21. As discussed in the BENCH BODY Logo case, the High Court's decision in *Aston v Harlee Manufacturing Co* (1960) 103 CLR 391 is longstanding authority that applying to register a trade mark is prima facie evidence of intention to use. Subsequent decisions indicate this prima facie presumption may be rebutted where the evidence readily gives rise to the drawing of an adverse inference and that evidence remains unchallenged and unrebutted by the applicant<sup>4</sup>. The onus does not however shift to an applicant merely because an opponent *questions* the applicant's intention in its Notice of Opposition or submissions<sup>5</sup>.
22. In seeking to upset the presumption that the Applicant had the requisite intention to use as at 13 February 2008 Mr Elkington firstly pointed to the fact that neither IP Australia nor the Opponent has been able to communicate with the Applicant, with all correspondence sent to its care of the address it nominated in its application having been returned by Australia Post. He noted that the Applicant had on the face of it originally either provided IP Australia with an incorrect or incomplete address, or had subsequently moved from the address nominated in its application. More than 15 months had passed between the filing of the application and the filing of the Notice without the Applicant ever advising IP Australia of this or ever apparently enquiring of IP Australia as to the fate of the application. This, he submitted, in itself indicated a loss of interest in the opposed trade mark and cast doubt on the Applicant's intention to use it as at 13 February 2008.
23. In fact, as indicated earlier, since the opposed application was filed IP Australia has not heard from the Applicant to this day, a period spanning well over two years.

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<sup>4</sup> See for example *Phillip Morris Products SA v Sean Ngu* [2002] ATMO 96; *Sapient Australia Pty Ltd and Sapient Corporation v SAP Aktiengesellschaft* (2002) 55 IPR 638; *Danjaq, LLC v Resource Capital Australia Pty Ltd* (2004) 61 IPR 651

<sup>5</sup> See for example *Medley Distilling Company v Croakers Gully Australia* (2000) 53 IPR 430; *Wal-Mart Stores Inc v Ozark-London Ltd* (2004) 62 IPR 165

Nevertheless, if this were the only information available to me it might not of itself suffice to upset the prima facie presumption discussed by the High Court in *Aston v Harlee Manufacturing Co*. However there are further matters apparently bearing on the issue in this case.

24. Mr Elkington also invited me to consider the fact that the opposed application was one of four applications the Applicant has filed with IP Australia and argued that the history of the Applicant's other three applications shed light on the Applicant's intention to use the opposed trade mark as at the relevant date. Details of these other three applications were not included in the Opponent's formal evidence and I thus firstly address the question of whether it is reasonable in the circumstances to consider them at all.
25. In this regard Mr Elkington noted that at first blush, as he put it, decisions touching on the Registrar's ability to consider matters not explicitly in evidence might appear somewhat contradictory, with some cases saying the state of the register (or other material readily available to the public) could, indeed should, be considered and some suggesting such consideration is inappropriate. On further review, however, he submitted the cases consistently indicated such material could be considered, provided natural justice was accorded to the parties and provided the material in question was purely factual and not (relevantly) capable of significantly differing interpretation.
26. In support of this position he quoted from a number of decisions. In *Dow Chemical Co v CH Boehringer Sohn KG* (1987) 9 IPR 360, for example, the Hearing Officer concerned, after noting that the issue was a "vexed question", pointed out that the Registrar's "prime concern is for the public interest" and concluded (at 364) that the Registrar might:

have regard to his own general knowledge, reference material at his disposal, circumstances which his own enquiries show to prevail in a particular trade or place, the state of the Register of Trade Marks or to material contained in his own records, provided only that natural justice is accorded the affected party.
27. In similar vein in *Prosimmon Golf (Aust) Pty Ltd v Dunlop Australia Ltd* (1987) 9 IPR 425 the Hearing Officer said (at 424):

The Registrar functions as a tribunal, and such a function becomes impossible if resources are denied to him. Thus, while the Registrar may act to obtain the comments of one or both parties where facts or information are likely to be contentious, that does not impede the Registrar's main concern, which is the protection of the public interest in ways consistent with natural justice.

28. The Hearing Officer made similar comments in *Amco Wrangler Limited v Jacques Konckier* (1987) 10 IPR 376, where an opponent had objected to his taking into account matters not formally in evidence, adding only the proviso that:

...while the Registrar is obliged to consider all material available to him in determining an opposition, matter which has not been placed fairly on the hearing table and exposed to the scrutiny of both sides must be treated with caution.

29. Nor can it be said the Registrar's ability to take into account publicly known or available factual material, in appropriate circumstances, was removed by the (current) Act when it came into force in 1996. In *McDonalds Corporation v Bellamy* (2004) 62 IPR 133 the Hearing Officer concerned indicated that he would only give "very low weight" to submissions as to the state of the Register when the relevant trade mark applications or registrations referred to had not been served and filed in the party's formal evidence. The Hearing Officer continued (at 134):

My reasons for this are that, while it may be appropriate for a delegate of the Registrar to refer to the state of the Register if this evidence is straightforward and of ready interpretation, such is not the case here.

30. In *Geoffrey Inc v Hoyle* (2004) 63 IPR 196 the same Hearing Officer said (at 200):

Ms Baird submitted that in view of comments in the decisions *Ocean Spray Cranberries Inc v Registrar of Trade Marks* (2000) 47 IPR 579 at 590 [35]–[36] and *McDonalds Corp v Bellamy* (2004) 62 IPR 133 at [6], it is inappropriate to refer to the state of the Register of Trade Marks. However, in terms of *Ocean Spray*, I think that it is true to say that here the present applicant does not refer to the state of the Register in order to establish the trade mark's registrability per se, but rather to address the state of the marketplace. And, the point in *Bellamy* was not that it was inappropriate to refer to the Register to establish the state of the marketplace, but rather that if the state of the Register was to be relied upon, and the analysis was to be one which was other than straightforward, the state of the Register should be in evidence in order that the other party could properly consider and answer it.

31. In the present case I am accordingly prepared to consider the Applicant's three other trade mark applications to see if they might shed any light on its intention to use the

opposed trade mark. I do not believe the Applicant would be denied natural justice since it must be assumed the Applicant is already aware of the details of its own applications. Moreover, it is only factual matters such as what information the Applicant supplied to IP Australia and the fate of the applications that need be looked at. For similar reasons I am satisfied it is appropriate in this case to make use of the information available to me based on the enquiries discussed in paragraphs 8 to 14 above. Indeed, these enquiries were made in an effort to contact the Applicant so that it might be made aware of the opposition and have the opportunity, if it so wished, to respond to it.

32. For ease of reference relevant details of all four applications are set out in the following table:

Number	Class	Trade Mark	Date Filed	Address for Service supplied	Status
1060658	9	<b>smart candle's</b> <b>smart candles</b> (Series)	16.06.05	PO Box 3383 Tamarama 2026 NSW	Lapsed 11.1.07
1140833	41		13.10.06	Level 2, 822 George St Sydney 2000 NSW	Lapsed 19.6.08
1145308	20	<b>i-photo</b>	8.11.06	Level 2, George St Sydney 2000 NSW	Opposed
1145309	16, 21	<b>i-frame</b>	8.11.06	Level 2, 822 George St Sydney 2000 NSW	Lapsed 19.6.08

33. I note the following matters based on the publicly available (online) details of the four applications:

- All four were filed by the Applicant itself electronically through IP Australia's website;

- To this day the Applicant has never contacted IP Australia in relation to any of the applications since filing them, although I believe it is reasonable to assume it was and is capable of checking their status through IP Australia’s website if it so wished;
- On the face of it the Applicant inadvertently omitted to enter the number “822” before “George St” when filling in the online application form for the opposed application;
- The address “Level 2, 822 George Street, Sydney 2000 NSW” the Applicant provided (or apparently *intended* to provide in the case of the opposed application) for its three most recent applications is different from the address appearing from at least 29 July 2007<sup>6</sup> (and up to the time of writing) in the electronic white pages, which has “Level 1” not “Level 2”;
- In the case of the three lapsed applications, IP Australia issued adverse reports upon initial examination and the applications eventually lapsed some 15 months thereafter because the Applicant did not respond.

34. In my view the history of the Applicant’s three lapsed applications as set out and discussed above does reflect adversely on the likelihood that the Applicant had the requisite intention to use the opposed trade mark as at 13 February 2008. The fact that the Applicant filed all four of its applications electronically and apparently without the assistance of an attorney to my mind indicates it was/is “Internet-savvy” and had/has the ability to access and use IP Australia’s website. I note, too, that parties wishing to file trade mark applications electronically are provided with a significant amount of guidance on IP Australia’s website as to when they might expect their application(s) to be examined and possibly accepted for registration and how to check details of their application(s) using the online “ATMOSS” search facility.

35. When these factors are considered in addition to the matters discussed in paragraphs 7 to 15 above I believe it is reasonable to infer the Applicant did not have the requisite

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<sup>6</sup> See paragraph 11 above

intention to use the opposed trade mark as at 13 February 2008. The fact, too, that the Opponent has not been heard from in the 12 months or so since 13 February 2008 only serves to reinforce such an inference. Further, in drawing the inference I do not think it can be said that the Applicant has been denied natural justice. It has failed to ensure its contact details with relevant entities such as ASIC, Telstra and IP Australia are accurate, and reasonable attempts made by IP Australia to ascertain effective contact details have been unsuccessful for this reason.

36. An adverse inference as to the Applicant's intention to use the opposed trade mark in the particular circumstances of this case having been found, the BENCH BODY Logo case (and the cases discussed therein) indicate the Applicant bears the onus of refuting it. This, of course, it has not done. The opposition ground based on s.59 of the Act is therefore established and it is not necessary to discuss the further grounds pressed by the Opponent.

### **Decision**

37. 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.

38. I have found the opposition to be successful on the ground raised pursuant to section 59 of the Act. I accordingly refuse to register trade mark application number 1145308.

### **Costs**

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

Michael Kirov  
Hearing Officer  
Trade Marks Hearings  
12 February 2009