

**TRADE MARKS ACT 1995**

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

Re: Opposition by Bombala Council to registration of trade mark applications 1165437, 1165438, 1165439, 1165441 & 1165443 (35) - **PLATYPUS COUNTRY SERIES** - filed in the name of Peter Wilkshire.

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**DELEGATE:** Jock McDonagh  
**REPRESENTATION:** Opponent: Neil Murray instructed by Mallesons Stephen Jaques  
Applicant: Not represented, written submissions only  
**DECISION:** 2009 ATMO 33  
Section 52 opposition - s 62A - Ground made out.  
Costs – awarded against the applicant.

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**Background**

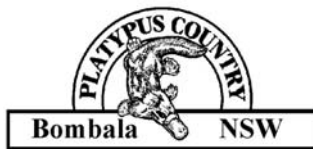
1. Peter Wilkshire (“the applicant”) filed applications on 11 March 2007 to register five trade marks, current details of which appear below:

Application Numbers:      1165437      1165438      1165439      1165441      1165443

Priority Date:      11.03.2007

Goods/Services Class 35:      Retailing of goods (by any means)

Trade Marks:



1165437



1165438



1165439



1165441



1165443

2. The trade marks were accepted for possible registration, under the provisions of the *Trade Marks Act 1995* (“the Act”), and advertised for opposition purposes on 19 July 2007. Bombala Council (“the opponent”) filed Notices of Opposition under section 52 of the Act, objecting to the registration of the trade mark. The opponent and applicant served and filed evidence in accordance with the *Trade Marks Regulations 1995* (“the Regulations”) after which the matter was set down before me, a delegate of the Registrar of Trade Marks, for a hearing on 26 February 2009, in Canberra.

### **Evidence**

3. The following evidence was filed and served pursuant to the Act:

<b>Declarant</b>	<b>Status</b>	<b>Date, Known as</b>	<b>Exhibits</b>
<i>Evidence in Support</i>			
Karen Cash	Economic & Tourist Development Officer Bombala Council	20 February 2008, Cash 1	KLC1 & KLC2
Robert John Stewart	Mayor of Bombala	20 February 2008, Stewart	RJS1
Gregory Alan Roberts	Fmr Tourism Promotions Manager	20 February 2008, Roberts	GAR1
Ian Alexander Sellers	Vice president Delegate Progress Association	20 February 2008, Sellers	IAS1
Jeremy Neil Charter	Fmr Economic Development Officer Bombala Council	13 February 2008, Charter	JNC1
Sally-Ann Thompson	Retailer	20 February 2008, Thompson	SAT1
<i>Evidence in Answer</i>			
Peter John Wilkshire	Applicant	24 June 2008 Wilkshire	PJW1
<i>Evidence in Reply</i>			
Karen Cash	Economic & Tourist Development Officer Bombala Council	25 August 2008, Cash 2	KLC3




### **The Hearing**


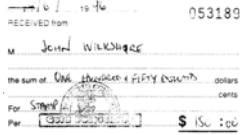



4. The applicant elected not to appear at the hearing and relied on written submissions. He did attend the proceedings as an observer but did not participate in them. The opponent was represented by Neil Murray of counsel, instructed by Mallesons Stephen Jaques, lawyers.

5. The Notice of Opposition cited most grounds of opposition available to the opponent under the Act; however, in his submissions Mr Murray, for the opponent, only relied upon the grounds of opposition under sections 42, 43, 44, 58, 59, 60 and 62A. For the sake of completeness and with the concurrence of the opponent, I find that the remaining grounds of opposition, those under sections 41, 61 and 62, have not been established.
6. The opponent bears the onus of establishing, on the balance of probabilities, at least one of its grounds of opposition if it is to prevent or restrict registration of the applicant's trade marks.
7. In providing the reasons for my decision, I shall address the grounds of opposition in the same order as counsel for the opponent did in the hearing.

**Discussion**

8. Before examining the various grounds of opposition I believe it will be helpful to consider the chronology of the events leading up to application for registration of the applicant's trade marks.

Date	Event	Diagram	Remarks
1989	Applicant says he develops image of platypus for a proposed business venture		Wilkshire, PJW1, page1
12.5.95	Opponent lodges trade mark 660826 in class 35 (tourism promotions in relation to Bombala region),		Stewart para 11 (application withdrawn 19.12.96)
17.02.97	Opponent lodges Trade mark 727812 in class 35 (tourism promotions in relation to Bombala region)	PLATYPUS COUNTRY – BOMBALA REGION	Stewart para15
Date	Event	Diagram	Remarks
February to April 1997	Negotiations between opponent and <i>Australian Geographic</i> , which provides sketches for replacement platypus to opponent		Stewart para 16,

28.4.97	<i>Australian Geographic</i> assigns all right and title to platypus logo to opponent		Proceeds to use mark, from at least July 1997
14.6.97	Applicant receives rubber stamp receipt from stamp maker		Wilkshire para 3, PJW1, page2
18.8.00	Applicant lodges Trade Mark 847229 in class 41 ((education; providing of training; entertainment, sporting and cultural activities for people who are interested in fossicking for gold)		
7.2.03	Opponent lodges Trade Mark 942740 in class 35(tourism promotions, advertising)		Unsuccessfully opposed by applicant. Applicant appeals decision
9.3.07	Opponent accepts offer to settle appeal		
11.3.07	Applicant lodges applications 1165437, 1165438, 1165439, 1165441 & 1165443 in class 35 retailing of goods (by any means))		
13.3.07	Consent orders filed in court		Includes undertaking by applicant not to interfere with opponent's 942740 mark

9. Trade mark 660826 was withdrawn by the opponent after a dispute with *Australian Geographic*, which considered that the platypus depicted was the same as *Australian Geographic's* trade mark. *Australian Geographic* agreed to assist the opponent in developing a new depiction of a platypus for the opponent in exchange for the opponent withdrawing its application. See Stewart paragraphs 14 to 16.

10. It is immediately apparent that the basic style of each of the depicted trade marks is the same, being an arch bearing the words “PLATYPUS COUNTRY” surmounting a rectangular panel with a description contained within it, and a depiction of a platypus arranged within the arch.
11. Upon close examination of the depictions of platypuses, it is also apparent that, with the exception of the withdrawn application 660826, each platypus is identical. Moreover, each platypus is identically arranged within the logo. For example the hind right foot of each platypus is placed below the second “P” in the word “platypus” and the end of each tail is under the letter “U” in “country”. The bill of each platypus is positioned in the rectangular panel in such a way that the bill is between the two words of text (except in the case of the applicant’s registration 847229). These details are pointed out by the applicant in his written submissions.
12. The applicant, in his written submission, states that “[i]t is uncontroversial that my mark was first developed in 1989, computer enhanced in 1996 and a computer enhanced image developed into a stamp in 1996.” With respect, this statement itself is controversial and goes to the heart of the matter.
13. In his submissions the applicant states “The Hearing Officer must determine from the evidence if the Bombala Council is the author of deception.”
14. I agree with the applicant that I cannot accept that the identical depictions of platypus within identical devices are the result of coincidence. The evidence in Stewart detailing the development of the design of the opponent’s registration 942740 by at least two different draughtsmen satisfies me that it is unlikely that either the Bombala Council or *Australian Geographic* copied the applicant’s sketch.
15. However, I do not think I can fairly conclude that as a matter of fact the applicant has deliberately copied the opponent’s mark. None of the evidence in these proceedings has been tested by cross-examination, so it would be unfair for me to so conclude as a matter of fact. I do feel that, on the balance of probabilities, it is more likely that the applicant copied the opponent’s marks than the reverse situation.
16. While I do not discount the applicant’s evidence that while fishing in 1989 he thought of using a platypus logo for a gold fossicking business venture, I am not satisfied that

that the hand-drawn sketch tendered in evidence was made before the Bombala Council commenced using its marks based on application 660826.

17. The opponent's evidence in these proceedings is to be preferred to that of the applicant because it is more reliable than that of the applicant. The opponent's evidence is more reliable because it is supported by independent parties and is also derived from the Bombala Council's official files. The opponent's evidence exhibits all the hallmarks of truth and is logical.
18. On the other hand, the applicant's statements are either unsupported or poorly supported. The purported hand sketch appears very much like a tracing of the opponent's logo. The receipt and letter from the stamp maker are so devoid of detail as to render them next to useless as supporting evidence.
19. It is also clear from the tenor of the applicant's evidence and submissions that he harbours ill will (characterized as a "vendetta" by counsel for the opponent) towards the opponent and, indeed, anyone disagreeing with his points of view. In my opinion this apparent ill will also adversely affects the reliability of the applicant's evidence in these proceedings.
20. The applicant seeks to impeach the evidence of Stewart and Cash by pointing to "conflicting sworn versions", and that such contradiction contaminates their entire evidence. The applicant submits that this also amounts to criminal conduct.
21. An example of "conflicting" evidence to which the applicant refers is that in Cash 1, stating that the opponent's 942740 mark was used from April 1997 (indeed this is repeated in Peters), while Stewart deposes to the mark being used from at least July 1997. Another example cited by the applicant was that Mr Stewart had made reference to use of the mark in June 1997 in evidence in other proceedings.
22. There is no contradiction in evidence. All statements conform to the chronology as detailed above. Ms Cash and Mr Stewart are stating what they observed or remembered. The opponent received the final design of its mark from *Australian Geographic* in April 1997 and began to use it from the date of receipt. Stewart states that the mark was used at least from July 1997, for which month he has an example in evidence. "At least July 1997" is not inconsistent with "June 1997".

## **Grounds of Opposition**

### ***Section 62A – Application made in Bad faith***

23. In terms of this ground of opposition the legislation reads:

#### **Application made in bad faith**

62A. The registration of a trade mark may be opposed on the ground that the application was made in bad faith.

24. This ground of opposition came into force on 23 October 2006 following amendments to the Act. At the time of this hearing, there had been no published decision from this office based on the ground. However, the opponent directed my attention to the Explanatory memorandum to the *Trade Marks Amendment Bill 2006* and to UK case law relating to similar provisions and discussed by Paul Sumpter in his article *Section 62A: Pandora’s box for trade mark practitioners?* (2007) 18 AIPJ 110.
25. Counsel for the opponent submitted that in the UK the similar “bad faith” provision does not require the application to have been made dishonestly because that word is not used: *Harrison v Teton Valley Trading Co* [2005] FSR 10 at [20]. Sir William Aldous held “No doubt an application made dishonestly will be made in bad faith, but it does not follow that if dishonesty is not established, bad faith cannot have existed.” His Lordship reasoned that bad faith required knowledge by the defendant that what he was doing would be regarded as bad faith by persons adopting proper standards.
26. Counsel also pointed to UK cases that indicate that bad faith will be established where someone has applied to register a mark which he has previously recognized as the property of another with whom that person has a course of dealing or some other relationship: *William Leith New Century Marquees* (SRISO/018/00, UK Registry) p.9.
27. The opponent pointed out that the applicant had applied for the marks after agreeing to terms of settlement with the opponent but before the Federal Court had a chance to make the consent orders. As part of the settlement, the applicant agreed not to threaten the opponent or the opponent’s licensee with any form of action in relation to the use of Bombala Council’s 942270 mark.

28. Counsel for the opponent continued that the applicant appears to have a vendetta against the opponent, as evidenced by his history of making complaints of no substance against the opponent and its staff. Details of such complaints are contained in Cash 1, paragraphs 49 to 54.
29. Counsel submitted that the applicant had wide and long-standing knowledge of the opponent's use of its various trade marks displaying the terms "Bombala Region", "Delegate Region" and "Bombala Council".
30. In all the circumstances, counsel for the applicant submitted that the behaviour of the applicant demonstrates that the applicant has no intention in participating in the trade mark registration system in a responsible manner.
31. Since the hearing, there has been a Trade Marks Office decision relating to the section 62A ground: *Hard Coffee Pty Ltd v Hard Coffee Main Beach Pty Ltd* [2009] ATMO 26 (1 April 2009). In this case, Hearing Officer Nancarrow found that the section 62A ground had been made out where an applicant sought registration of trade marks that were deceptively similar to business names of the vendor of a business the applicant had purchased. The contract of sale expressly reserved for the vendor intellectual property rights in the relevant business names.
32. Hearing Officer Nancarrow stated (at paragraph 11):
  11. For an assessment of 'bad faith' as it applies to such a situation it would appear that there would need to be an element of intentional dishonesty or a deliberate attempt to mislead the Registrar in some way in the claim made by means of the application.
33. This approach is broadly that adopted in *Harrison v Teton Valley Trading Co*, supra. The decision was also consistent with the reasoning in *William Leith New Century Marquees*, supra.
34. In this case, I am satisfied that the applicant was at the relevant date aware that the opponent had used trade marks identical or virtually identical to those which he seeks to register. In Wilkshire, paragraph 27 refers to page 19 PJW1, which exhibits the opponent's use on 6 August 1997 of a mark identical to application 1165438. At paragraph 41, the applicant exhibits a photograph of the opponent's signage that is identical to applications 1165439 and 1165441 except for the words "population –

350 Elevation – 760m” appearing in place of the words “NSW” and “Region” respectively.

35. The applicant clearly has “applied to register a mark which he has previously recognized as the property of another with whom [he] has a course of dealing or some other relationship”, exemplifying bad faith as defined in *William Leith New Century Marquees* (supra).
36. Further, the lodgment of the applications after the applicant has agreed to terms of settlement with the opponent but before the Federal Court has had an opportunity to issue consent orders might in the circumstances also amount to an application made in bad faith. A reasonable person must surely be aware that such applications would interfere with the opponent’s rights in its trade mark 942740.
37. I am satisfied that the evidence shows that the circumstances were such that a ‘reasonable person’ standing in the shoes of the applicant, would have been aware that he /she ought not to apply for trade mark registration.
38. Having found in favour of the opponent in terms of section 62A there is no need for me to discuss the other grounds set out in the Notices of Opposition although these grounds or any others in the Act may also be relied on in the event of an appeal of this decision.

## **Decision**

39. Subsection 55(1) of the Act provides:
  - (1) 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.
40. The onus is upon the opponent to establish one or more of its grounds of opposition. Justice Gyles has recently referred to the standard of proof required in terms of a

‘balance of probabilities’.<sup>1</sup> I find that the opponent has met the onus upon it, in terms of the grounds of opposition under section 62A argued at the hearing. Accordingly, and subject to a successful appeal from my decision, I refuse to register trade mark applications 1165437, 1165438, 1165439, 1165441 and 1165443.

### **Costs**

41. It is usual for costs to follow the event, and I see no reason to depart from that principle here. I award costs, according to the official scale set out in Schedule 8 of the *Trade Marks Regulations 1995*, against the unsuccessful trade mark applicant, Peter Wilkshire. The taxing of the costs for the second and subsequent oppositions is to be weighted as per *Hume Industries (Malaysia) Berhad v James Hardie & Coy Pty Ltd*, (2001) 53 IPR 591.

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
26 May 2009

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<sup>1</sup> *Pfizer Products Inc v Karam* [2006] FCA 1663 (1 December 2006); (2006) 70 IPR 599