



TRADE MARKS ACT 1955
DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS
WITH REASONS

Re: Opposition by John Vivien Murray to an application by Major League Baseball Properties, Inc. to remove the trade mark MARLIN, registration B229320(25), from the Register

Trade mark B229320 is registered in the name of Carrycode Pty Limited. The registration is for the word **MARLIN** and it covers *articles of clothing including rainwear and waterproof clothing of all descriptions*. The trade mark (the subject registered) has been on the Register since 2 June 1969.

On 5 April 1993, Major League Baseball Properties, Inc. (hereafter Major League Baseball) applied under the provisions of section 23 for an order that this trade mark be removed from the Register. Major League Baseball claims it is a person aggrieved by the registration and states the following grounds for removal:

- (a) The trade mark was registered without an intention in good faith on the part of the applicant for registration that it should be used in relation to those goods by it and there has in fact been no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being earlier than 1 month before this application.
- (b) Up to 1 month before the date of this application, a continuous period of not less than 3 years has elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade

mark in relation to those goods by the registered proprietor or a registered user for the time being.

- (c) By reason of any one or more of the matters set forth in the preceding paragraphs the Registrar in the exercise of his discretion ought to remove the trade mark from the Register.

On 25 November 1993, Major League Baseball served notice of the removal application on the registered proprietor of the trade mark who, at that stage, was John Vivien Murray. Mr Murray subsequently assigned the trade mark to Carrycode Pty Limited and this assignment was entered in the Register in March 1995. The facts of this assignment arise as an issue in the removal action.

Service of notice of the removal application brought about advertisement in the *Official Journal of Trade Marks* and commenced the three months in which a person may object to the removal. Mr Murray did object. This brought the provisions of Division 2 of Part VII of the Trade Mark Regulations into operation and, accordingly, both sides served evidence. A statutory declaration by Angela Ryan constitutes the evidence in support of the removal application; two declarations, one by Mr Murray and one by Graham William Halford constitute Mr Murray's evidence in answer; and a declaration by Spiros Pappas constitutes the applicant's evidence in reply.

The removal application then came to a hearing before me in Sydney on 6 July 1995. The opponent, Mr Murray, was represented by Mr Graham Halford of Halford & Co.. The applicant, Major League Baseball, was represented by Mr Andros Chrysiliou of Chrysiliou Moore Chrysiliou.

Mr Halford's submissions on behalf of Mr Murray are on three footings. First he argues that the applicant, Major League Baseball, is not a person aggrieved; second he argues no prima

facie case for removal has been made out; and third he argues that there is no case for removal because the applicant's evidence establishes that **MARLIN** was in use, by the registered proprietor, during the crucial three years period of 5 March 1990 - 5 March 1993.

Mr Chrysiliou argues counter to these submissions and, should his arguments fail, he urges me to exercise my discretion and remove the mark on grounds of public interest and the proprietor's failure to attend to statutory obligations.

I shall deal with these issues in turn.

The applicant's standing as a person aggrieved

Section 23 of the Act specifies that a removal action may be brought about on the application of *a person aggrieved*.

Major League Baseball asserts its aggrieved status by way of a pending application to register the word **MARLINS** as a trade mark for *clothing, footwear, and headgear*. This application now confronts a section 33 objection based on the subject registration, **MARLIN**. Progress on the Major League Baseball application to register **MARLINS** is therefore halted by reason of the subject registration.

Mr Halford submits that the mere existence of an application impeded by the registered mark does not qualify that trade mark applicant as a person aggrieved. In support of this point of view he draws my attention to a number of the recognised authorities, and in particular, the following words from Kitto J.'s judgement in *Continental Liqueurs Pty. Ltd. v G. F. Heublein & Bro. Inc.* [1959-1960] 103 CLR 422 at 427 and 428. This passage, says Mr Halford, commences with the generally broad position that, in respect of establishing locus standi as a person aggrieved,

[i]t is enough to say that the respondent has shown an intention of preventing the applicant from using the word, if by any means it can do so, and on some future occasion it may well rely for this purpose on the trade mark now in question. The applicant has applied for registration ... and the examiner has made adverse reports under s33(2) on the ground, amongst others, that the proposed ... mark ... so closely resembles the [opponent's] mark as to be likely to deceive.

So far, so good. But then Mr Halford points out, His Honour continues:

In all the circumstances it seems to me too clear for argument that the applicant has a **substantial business interest** in getting the trade mark removed from the register, and accordingly is entitled to maintain the application as a 'person aggrieved'. (my emphasis)

Mr Halford asserts that it must follow that in order to qualify as a person aggrieved, a section 23 applicant cannot rely solely on the fact that it has a pending trade mark application, and that application is impeded by the registration under attack. A section 23 applicant, he says, must also show, as Kitto J. here lays down, that it has a **substantial business interest** in getting the registration removed.

This line of argument finds some support in Lord Herschell's observations in the House of Lords judgement on *Powell's Trade Mark* (1894) 11 RPC 4. At page 7 His Honour comments that the statutory words which limit removal action to *person aggrieved*,

were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer .. .

Mr Halford's position is, I believe, that a trade mark application is not evidence of actual business activity, and the filing of an application for registration of a trade mark is not sufficient to show that Major League Baseball has any motive beyond officious interference. He says, that in order to establish its credentials as a person aggrieved, Major League Baseball needs to show it has a trading interest in those goods for which it seeks to have B229320 removed. In further support of this position he refers me to *Lever Brothers, Port*

Sunlight, Ltd., v Suniwhite Products, Ltd., (the Sunlight case) (1949) 66 RPC 84, where it was decided *inter alia* that a rectification action failed because Romer J. found that the applicant for removal only manufactured soapless detergents and these were not sufficiently close to perfumery and cosmetics in the proprietor's trade mark registration to establish the applicant as aggrieved.

Mr Chrysiliou, in response, refers me to directives of McLelland J. in *Ritz Hotel Ltd. v Charles of the Ritz Ltd* 12 IPR 417 at 454:

The meaning of the expression of person aggrieved in legislation cognate with sec ... 23(1) of the Act has been the subject of consideration in numerous cases ... Decisions of high authority appear to me to establish that the expression has no special or technical meaning and is to be liberally construed. It is sufficient for present purposes to hold that the expression would embrace any person having a real interest in having ... the trade mark removed in respect of any goods ... and thus would include any person who would be, or in respect of whom, there is a reasonable possibility of his being appreciably disadvantaged in a legal or practical sense by ... the trade mark remaining unremoved In my opinion the concept does not admit of further refinement.

It is clear from McLelland J.'s finding that a person may acquire the status of *person aggrieved* if the mark under attack prevents that person from registering its own trade mark. But I agree with Mr Halford that such a claim could founder if it is shown that behind the trade mark application there is no real business intent. As per the *Sunlight case* (*supra*), if Major League Baseball has no interest in using the trade mark **MARLINS** for clothing, then, the prima facie evidence of the trade mark application would falter, and thence fail to support the locus standi.

Here it is fact that Major League Baseball has an pending application to register the trade mark **MARLINS**. As per the directives of Fullagar J. in *Aston -v- Harlee Manufacturing Co.*, (1960) 103 CLR 391 at 401, a trade mark application is -

to be regarded as prima facie evidence of intention to use.

And His Honour continues:

I cannot think that the Registrar is called upon to institute an inquiry as to the intention of any applicant, and I think that, on an opposition or on a motion to expunge, the burden must rest on the opponent or the person aggrieved, of proving the absence of intention.

Similarly I hold that Major League Baseball's application to register the mark **MARLINS** is to be regarded as an intention to use that mark for the goods nominated in the application, and it is for the opponent to the removal action to demonstrate otherwise. I have been shown no evidence to support the contention that Major League Baseball does not have an intention to use its mark, or that it cannot, does not, or will not be able to use this mark in the course of trade. I am not prepared to conclude, simply from absence of evidence on Major League Baseball's present activities, that its trade mark application is wanting. The opponent's submission here relies on nothing more than speculation and I find that Major League Baseball's position as a person aggrieved, as founded on its application to register a substantially identical trade mark, has not been upset.

Before leaving this question, I note that in a recent case from the Federal Court, so far as I know not yet published, a pending trade mark application failed to support a standing of person aggrieved. The case is *Kraft General Foods Inc. -v- Gaines Pet Foods Corporation*. Justice Hill delivered judgement on 28 July 1995, and he says:

Where an applicant for a trademark in fact uses that trademark despite the registration of the trademark of another or intends to use that mark in business the applicant will be a person aggrieved within the meaning of s23(1). If, however, a person is merely an applicant for a trademark but neither uses that mark nor intends to use it in the future, the mere fact that the person is an applicant would not result in the conclusion that the person was a person aggrieved. It follows that the submission made on behalf of Kraft [the removal applicant] that an applicant for a trademark will always be a person aggrieved could not be accepted in such wide terms. It is not the application *per se* for registration of a new mark which makes the applicant a person aggrieved in an expungement applicant, it is the fact that the

applicant must, to obtain registration of the mark, either use it or propose to use it.

The pending application which the removal applicant (Kraft) relied on was a 1989 application and, when challenged in the Court, Kraft declined to support its claim with witnesses or statements under oath regarding the intention of use in 1989. It also declined an offer of time in which to produce that evidence. Considering this and a number of other matters, Hill J. said, on the facts of the case, that:-

In all circumstances I am not satisfied, on the balance of probabilities in the present case, that Kraft either used the mark or proposed or intended to use it.

I distinguish these facts from the present case, wherein no evidence is led to disturb the prima facie evidence of Major League Baseball's application, and where Mr Halford's submissions amount to no more than an unsubstantiated allegation that Major League Baseball's trade mark application was made with no proper intentions of use.

The prima facie case

Before any onus shifts to the registered proprietor to demonstrate that it has used the mark, the applicant for removal has to establish a prima facie case that, for the crucial three years, there was no use.

Mr Halford, for the opponent, submits this has not been achieved.

The applicant's primary evidence is the Ryan declaration. This gives an account of how Ms Ryan, a solicitor with Mr Chrysiliou's firm, made enquiries 'with people with a knowledge of the trade' of their awareness of goods bearing the **MARLIN** trade mark. She located instances of use but found it confined to a narrow range of clothing - *viz* wet weather sailing clothing and life-jackets. Swing tags attached to items sold under this mark carried reference to a company called Marlin International or Marlin Australia, but made no reference to Mr Murray, the registered proprietor. In the three years from March 1990 to March 1993 these

goods, it seems, were made and marked by the company Marlin International Pty. Ltd.. Ms Ryan made further enquiries of the Australian Securities Commission ascertaining that, from March 1990 to March 1993, Mr Murray was a director of Marlin International Pty. Ltd., and that the principal activity of this company was the manufacture of *marine wear*. Then, from a search of major telephone directories (1990-93), the following information came to light:

- Mr John Vivien Murray is the chief executive of Marlin International Pty. Ltd.
- Marlin International Pty. Ltd. manufactures *aquatic and wet weather clothing*
- no listings in the *Yellow Pages* could be found for Mr Murray, Marlin Australia or Marlin International Pty. Ltd. in relation to any clothing except as *raincoat wholesalers and manufacturers*.

This evidence constitutes the applicant's prima facie case, and Mr Halford criticises it on a number of levels. He says:

- Ms Ryan is not a person with knowledge of the clothing industry, and she does not give sufficient information to establish that she contacted persons who have that knowledge. She merely says - in her clause 5 - she made enquiries *with people with a knowledge of the trade*. In the absence of any account of who these people are, of their experience and ability to comment on use in the relevant three years, or even of their number, the evidence is not acceptable.
- The search of the telephone directories (1990 to 1993) is likely to be out of phase with the relevant three years (March 1990 to March 1993) because of the time lag between publications. The extent of the search is in any case unclear.
- The fact that **MARLIN** goods do not appear, under the clothing head, in the *Yellow Pages* is not significant. Use of *Yellow Pages* is no more than a business option and absence of a mark from the *Yellow Pages* does not establish non-use.

Mr Chrysiliou responds to these criticisms by claiming that the enquiries have proved their worth through unearthing inconspicuous use in a specialist area of the industry. These discoveries, he says, prove the persons to whom Ms Ryan directed her enquiries, were qualified to comment. Further, he says, it is a regular business practice to make use of the *Yellow Page* listings, and Marlin International Pty. Ltd.'s absence from all categories other than *rainwear* must carry weight in showing that it does not produce any general clothing lines. And, says Mr Chrysiliou, if there is a serious time lag between notification and publication of the directories which would account for this absence, evidence of that lag should have been put forward - and it was not.

I fully agree with Mr Halford that the description of the people contacted in Ms Ryan's enquiries is well short of being adequate. I am indeed required to evaluate the quality of the evidence and that must include the standing of the interviewees and their competence to comment on use of a mark over the relevant three years. The Ryan declaration is devoid of any records which allow me to do this. In effect, Major League Baseball asks me to accept Ms Ryan's own assessment of her enquiries. However, Mr Chrysiliou points out that Ms Ryan's investigation did locate use in lesser known byways of the clothing industry, and I agree that this lends support, and tends to bear out her claim that she did contact people with knowledge of the trade. The search of the companies register, while not conclusive in itself, agrees with her findings that Mr Murray and his company confine their activities to marine wear and rainwear. And the information from the *Yellow Pages*, again, though in itself not conclusive, assists in confirming that use of **MARLIN** is restricted to a narrow field of clothing.

Mr Halford is clearly right, in that an enquiry set up with an undisclosed number of unidentified members of a trading community will not establish a prima facie case of non-use. If this was all that Major League Baseball relied on, the prima facie case would fail. However, the Ryan evidence, in sum, discloses two issues of use which warrant concern. First, although it demonstrates that the trade mark **MARLIN** was in use in the three year

period, it also indicates that use fell well short of the wide range of goods comprehended by the registration. Second, the absence of Mr Murray's name from the sales brochures and swing tags located by Ms Ryan, raises a question of whether the proprietor of B229320 was in fact associated in any way with this use. Taken all together, and having heard Mr Chrysiliou's argument and his reminder of the difficulty of proving a negative, I find, on balance, that the Ryan declaration just meets the slight evidence required to shift onus onto the opponent (*Estex Clothing Manufacturers Pty Ltd v Ellis and Goldstein* (1966) 116 CLR 254).

The proprietor's evidence of use

I turn then to the evidence of use submitted in the Murray declaration. In short, this tells us that John Vivien Murray was the registered proprietor of the **MARLIN** trade mark till 14 March 1995, whereupon an assignment to Carrycode Pty Limited is entered in the Register. As managing director, Mr Murray held 75% of Marlin International Pty. Ltd. The remaining 25% of the company was held in trust for him. His position and his share holding enabled him to have and to exercise 'complete control over the company and its day-to-day operations'. He goes on to say:

I was personally responsible for the quality, types and quantity of goods which were offered for sale and sold by Marlin International including those goods bearing the **MARLIN** Trade Mark, for how those goods were promoted and for all other marketing decisions of Marlin International in relation to those goods.

During the period 2 March 1990 to 2 March 1993, Marlin International sold the following range of goods bearing the **MARLIN** Trade mark:

- (i) rainwear
- (ii) warmwear
- (iii) life jackets
- (iv) industrial protective clothing
- (v) wet suits

Mr Murray then quotes significant sales figures for each of the three years in question, and attaches catalogues illustrating the range of goods available under the **MARLIN** trade mark. Then, at annex B, Mr Murray lists 13 retail outlets which, he says, stock general clothing items and, between March 1990 and March 1993 stocked goods bearing his registered trade mark, **MARLIN**.

Mr Chrysiliou criticises the evidence on six counts which I shall list and then address.

First, in relation to the declaration, there is no break-down of the annual sales figures, and thus no indication of the relative sales between the various clothing lines. He submits that invoices should have been readily available and if presented would have added some substance to the evidence of use.

Second, he refers me to the evidence in reply - the Pappas declaration - to Mr Pappas' failed attempts to reach the various clothing outlets Mr Murray says stock **MARLIN** items, and to the information received from outlets Mr Pappas did contact. In general he was given to understand that these outlets did not deal in general clothing.

Third, Mr Chrysiliou pointed out that Mr Murray had not produced any evidence to show that he himself ever used this trade mark. This, says Mr Chrysiliou, was evidence that Mr Murray could not have had a fixed and firm intention to use the trade mark **MARLIN** when, in 1969, he applied for registration.

Fourth, he submitted that directives from the High Court in the *Farmer & Co. Ltd. -v- Anthony Horden & Sons Ltd.* (1964-65) 112 CLR 163, and from the Federal Court in *New South Wales Dairy Corporation -v- Murray Goulburn Co-Operative Ltd.*, the *MOO/MOVE case* (1988 - 1989) 14 IPR 26 at 41, precluded the applicant from relying on use by an unregistered licensee in a removal action. Here Mr Chrysiliou directed me to comments in Shanahan, D.R. *Australian Law of Trade Marks and Passing Off* at 314

and referred me to Aikin J.'s judgement in *Pioneer Electronic Corporation and Another - v- Registrar of Trade Marks*, 17 ALR 43 where, at 57, His Honour says:

If the mark is used merely to indicate a connection with some unidentified person who has the right to use the mark it must indicate a connection with both the proprietor and the user, as it would if it indicated the identity of both by use of eg, a label displaying the mark and stating 'Manufactured by A Ltd. under licence from B Ltd'.

Mr Chrysiliou turned here to the swing tag exhibited in the Ryan declaration, which clearly does not make any reference to Mr Murray. Nor, indeed do any of the **MARLIN** trade brochures submitted by Mr Murray or Ms Ryan.

Fifth, Mr Chrysiliou refers me to the assignment - this he points out actually took place in 1993, but there was no action to record it on the Register of Trade Marks until 1995. Furthermore, he says, this assignment which was without goodwill, raises doubts about the validity of the assignment and interposes questions of trafficking. These matters, and Mr Murray's lax attitude to registering his licensee, he says, should weigh in favour of exercising any discretion in favour of Major League Baseball.

Sixth and last, Mr Chrysiliou comments on the character of the goods illustrated in the Marlin International Pty. Ltd. brochures - and because of the very special nature of wet weather gear, advocates that no other goods coming within the scope of trade mark registration qualify as being same goods, or as goods of the same description. Consequently, should I find, contrary to his submissions, that use is established for wet weather gear, then I should order that the mark be removed for the balance of goods comprehended by the registration.

I turn then to consider these submissions.

First, it is certainly true that there is no breakdown in the sales figures provided in the Murray declaration. Sales are, however, substantial - on average, more than \$1m for each of the relevant three years. From the evidence of the trade brochures and Mr Murray's statement, I accept that the sales were of rainwear, warmwear, life-jackets, industrial protective clothing and wetsuits, and I am satisfied that sales of goods in each of these categories were conducted over those three years. I note Mr Chrysiliou's objection that life-jackets and industrial protective clothing are in class 9, are therefore outside the scope of the registration and are to no account. However, having regard to the affinity between the class 25 wet suits and life jackets (for example, as per the final page of Ryan exhibit A2) I find they can be regarded as goods of the same description - and therefore, use of **MARLIN** on life jackets can be taken into account per section 23(2). On the other hand, I should disregard any use in relation to industrial protective clothing. Considering, however, the extent of use solely in relation to the class 25 goods, as confirmed by the brochures and the Ryan declaration, I clearly must find that over the three critical years there was substantial use of the subject mark.

Second, the evidence of the Pappas declaration would become relevant if I were deciding whether the trade mark should remain registered for general clothing items. Mr Halford submits the declaration is of little worth because, he says, it is rife with leading questions, addressed to unknown persons with no known qualifications. However, I do not see a case for considering 'general clothing'. I thus have no reason to draw on the Pappas evidence and I will not consider it any further.

Third, is the question of Mr Murray's *bona fide* intentions to use his mark. I find, as per the allegations regarding Major League Baseball's intention to use its trade mark **MARLINS**, that this allegation, now raised by Mr Chrysiliou, is similarly speculative. The fact is that the mark has been in use. Whether this use was as Mr Murray, in 1969, originally intended, or as he subsequently decided to be for the best is not, I think, material. By 1989 Mr Murray's solely owned business was turning over more than \$1m per annum, and whatever that

original intention might have been, the fact is that by this date his business was up and running, and goods produced by the business were successfully being marketed under his registered trade mark. The fact that a registered proprietor's solely owned business is producing the goods in question seems to me to confirm rather than deny an intention to use. Generally I would observe, that in the face of the extensive use attested to by Mr Murray, it would require a good deal more than a surmise founded on implications as to user arrangements - some 20 years after the event - to displace the prima facie evidence of intention inherent in a trade mark application.

Fourth, is the status of Marlin International Pty Ltd and Mr Chrysiliou's contention that it is not a registered user, and that I should find that use by an unregistered licensee cannot be relied on as a defence against removal. His reference to the *MOO/MOOVE case* (supra) at 41 points me to Gummow J.'s observation that

The expression "registered proprietor" in relation to a trade mark means the person for the time being entered in the register as the proprietor of the trade mark

This definition, as per section 6(1) of the Act, has not constrained the courts on numerous occasions from finding that use of a trade mark by a licensee, who is under the supervision and control of the registered proprietor, can successfully defeat an attack. As per Aikin J in *Pioneer* (supra - 17 ALR 43) at 55

[T]he essential requirement for the maintenance of the validity of a trade mark is that it must indicate a connection in the course of trade with the registered proprietor, even though the connection may be slight, such as selection or quality control or control of the user in the sense in which a parent company controls a subsidiary [I]t is essential both that the user maintains the connection of the registered proprietor with the goods and that the use of the mark does not become otherwise deceptive. Conversely, registration of a registered use will not save the mark if there ceases to be the relevant connection in the course of trade with the proprietor or the mark otherwise becomes deceptive

The concern expressed by Aikin J. with regard to uncontrolled use is that it will lead to deception and is clearly contrary to public interest. However Mr Murray did not abrogate his controlling responsibility . He says he held control and he duly exercised it and was personally responsible for the quality, type and quantity of goods sold by Marlin International Pty Ltd under the **MARLIN** trade mark. Registration of a use under Part IX of the Act is no more than an option. It is certainly not a requirement. This is confirmed by Aikin J. at p54 where he quotes, with approval, Grahame J. in *Re G.E. Trade Mark* [1969] RPC 418:

"The registered use provisions are permissive only and not a compulsory prerequisite for retention of validity of the mark and that, provided the conditions of control are adequate, there is no reason for holding by using the mark without a registered user the parties have destroyed the mark" . That decision was upheld in the Court of Appeal [1970] RPC 339 ... the *Bostich case* ...

There appears to me to be every reason to adopt the *Bostich* line of cases as equally applicable in Australia. I respectfully agree with the reasoning in those cases and will proceed on that basis.

Mr Chrysiliou suggests to me that Mr Murray could not be in control of use of the mark through Marlin International Pty Ltd because as managing director he was no more than an employee of that company. This is clearly wrong. Mr Murray had authority to direct matters both through his role as managing director and as the owner of the company and his declaration says he directed the use by way of these authorities. I find that there is no evidence that Mr Murray did not maintain his connection with the mark and through that connection used the mark on the goods as specified and over the relevant years.

Fifth, in respect of the assignment of the mark from Mr Murray to Carrycode Pty Limited, it is a fact that the assignment took place on 3 March 1993, and that the application to enter this assignment on the Register was not filed until 11 January 1995. Moreover, as Mr Chrysiliou points out, this assignment was without goodwill and this, he submits, establishes a scenario for trafficking. Mr Halford's explanation regarding the goodwill is that this was

previously assigned to Carrycode Pty Limited along with Mr Murray's business. The use attested to by Mr Murray clearly precludes any adverse operation of section 82, and 20 years use, I believe, must successfully rebut the allegations of trafficking. Moreover, although section 20 is mandatory, it does not specify any time limits, and I am not prepared to penalise Mr Murray on account of the fact that his application to assign the mark was not as prompt as it could have been.

Lastly, then I come to a consideration of the goods.

It will be useful for me, however, to set down first that I have found that ground (a) of the removal application has not been made out because it has not been shown that Mr Murray applied for registration without an intention to use the trade mark in relation to the goods of the application. Further I find that in the critical three years from 5 March 1990 to 5 March 1993, this trade mark was in use and that this use was by Mr Murray through the company Marlin International Pty Ltd. As Mr Chrysiliou points out, however, this use is not for all goods comprehended by the trade mark registration, and I agree with him that the mark should be removed for those goods for which no use has been shown.

Turning back then to Mr Chrysiliou's submission that the use of the mark has been confined to marine and wet weather clothing and the specialist nature of these goods precludes a finding that the registration should be allowed to continue for anything more. Broadly speaking, I think that this very nearly sums up the situation. However, Mr Murray does refer to *warmwear* and I note on one of the 1990 - 1993 catalogues, at exhibit A1 an illustration of *Warm Wear Under Garments Jacket and Trousers - Warmth without bulk - Thermal insulation ... Twice as warm as down ... Extremely light weight and compressible - Elasticised wrists - Polyester cotton lining - Machine washable*. I note that this brochure in fact refers to Carrycode Pty Limited "previously Marlin International Pty Ltd" - but I accept Mr Murray's statement that this is the range of goods available from Marlin International Pty Ltd in the period up to March 1993.

It was not put to me that *wet weather gear* and *rainwear* were same goods, or goods of the same description as any other goods in class 25, and I therefore do not intend to look further into that question. In respect of *warm wear undergarments* however, I think it is self evident they are same goods as *undergarments* in general.

Discretion

I do not agree with Mr Chrysiliou that public interest warrants removal of this mark in total. Nothing put before me shows use of the mark has been deceptive. Nothing put before me substantiates Major League Baseball's claim that Mr Murray applied in less than good faith for the registration of this trade mark. Nor do I consider tardiness in attending to an assignment sufficient grounds for removing a mark.

Decision

I have decided that for goods, other than those on which Mr Murray has shown use, and for *undergarments*, this trade mark is to be removed from the Register. Taking account of Mr Halford's comments that should the goods be brought back, he would consider a specific statement more satisfactory than a general specification, I find that the trade mark registration should be removed for all goods other than:

Rainwear and marine and wet weather gear in this class including walkers' coats and capes, over trousers for walkers and riders, full length coats, jackets, including motor bike jackets, and spray jackets; undergarments including thermal undergarments; and wet suits being goods in this class.

Accordingly, unless the matter is appealed I order that the Register be amended to delete the trade mark registration number B229320 for all goods other than those I have specified.

Costs

Both parties applied for costs. Mr Halford says that if the mark is only partly removed, the opponent is entitled to costs because, if I understand, he claims that the applicant is at fault

in not fully disclosing the basis of its standing as a person aggrieved. However, I must observe that for many years this mark has been registered for goods greatly exceeding those for which use has now been shown, and it was open to the opponent, Mr Murray, to amend the mark accordingly. This may or may not have avoided the present proceedings. However, in as much as there were matters that could have been undertaken by the applicant to help confine proceedings, there were equally, I think, opportunities for the opponent. I find therefore that there is no reason why the costs should not follow the cause, and as the action by Major League Baseball has succeeded in reducing the scope of the registration, I accordingly award costs to the section 23 applicant, Major League Baseball.

Helen R. Hardie
Deputy Registrar
28 September 1995