



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

Re: Opposition by Sydney Opera House Trust to the registration of trade mark applications number 537290 and 537292 in the name of Sydney Convention and Visitors Bureau Limited.

**Background:**

After examination, trade mark applications number 537290 and 537292 were advertised as having been accepted for registration. The applicant in both instances is the Sydney Convention and Visitors Bureau Limited, which I will refer to simply as “the applicant” from this point. The respective goods and services are:

- (for 537290): Paper, cardboard and goods made from these materials, printed matter, stationery and photographs being brochures, pamphlets and promotional and advertising matter, and
- (for 537292): The promotion of Sydney as a tourist destination and convention and conference centre, including representation of Sydney at trade and tourist fairs and exhibitions

The mark in question is as follows:



The applications were lodged on 4.7.90, and it is long established law that the rights of the applicant are to be decided as at that date.

Registration of the application is opposed by Sydney Opera House Trust (“the opponent”) on various and wide-ranging grounds. The opposition process has followed the course set out in the regulations. Both sides served evidence to support their positions, as provided by the regulations, and the opposition came on for hearing and decision by me, as a delegate of the Registrar of Trade Marks.

At the hearing, the applicant was represented by Mr David Wilson, a patent attorney of the Sydney firm of Shelston Waters. The opponent was represented by Ms Jennifer Stuckey-Clarke of counsel, instructed by Katrina Pechar, a solicitor of the firm of Abbot Tout, solicitors.

As set down in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this opposition. Accordingly, the provisions to which I will refer, below, are those of the 1955 act.

As I have said, both sides have filed evidence to support their positions. The evidence relied on by the parties is fairly extensive. What it establishes about the history of the matter is critical in what follows and it will be most effective if I marshal the facts which are in evidence, interspersing these with the submissions of the parties as to what those facts actually signify. I thus review the facts under the headings and issues on, at the hearing, by the opponent. Under those headings, should any ground be sufficiently well established, it is of course common ground between the parties that the onus is on the applicant to show that it is entitled to its registrations and that, in dubio, the applications must be refused.

At the outset, I will note that this dispute occurred in a context where the two parties were well aware of each other. Mr Martin, the General Manager of the opponent, is a director on the board of the applicant, on which he represents a constituency of various organisations which have become members of the applicant. Mr Martin has been elected to the board to represent those member businesses in the sector defined by the applicant as “Education, attractions, arts”.

In this capacity, Mr Martin was present at the meeting of the applicant’s board of directors at which the question of a new logo was considered. That logo, (“the original design”) has elements much like the device shown at the head of this decision. It does differ, however. It includes the words “CONVENTION & VISITORS BUREAU”, in small capitals, above the stylised sails, and “YOU’RE BEAUTIFUL”, in intermediate sized capitals, below and smaller than, the word “Sydney”. There were also some differences in the stylised opera house. In the original design, only four sail shapes were shown - the sail at the right of the group at the top of this decision is the addition. Nor does the original version show the band of white just below the top edge of each sail.

The minutes of the board meeting, in evidence and relied on by the applicant, show that Mr Martin voted for adoption of the new logo. The minute papers do not include an actual copy of the logo, as presented to the board by the advertising company which created it, but other elements of the evidence, to which I will refer, allow the original design to be reasonably clearly established.

Mr Wilson argued that the words at the top and bottom were extraneous to the other matter, not necessarily always intended by the applicant to be part of the logo which it was considering adopting. Thus, he argued that the present application, without the words “CONVENTION & VISITORS BUREAU” at the head, and without the words “YOU’RE BEAUTIFUL”, could be reconciled with the original decision. However, I do not accept this. The words in question were in a fax sent by the applicant to the opponent after the board meeting. The fax incorporates in a nutshell the essence of the applicant’s explanation of the adoption of the mark, as well as being definitive of what the applicant’s board meeting had before it. In that fax, John Rowe, then the Managing Director of the applicant, stated:

Attached is a black and white copy of the new SCVB logo, which was approved at last week’s Board Meeting, for your information. The actual colours are indicated.

As we discussed, I do not see any problem with the fact that both our logos use the Opera House sails design, because each logo is individually quite different.

As I said at the Board Meeting, we regard the Opera House as the major symbol for Sydney and in fact Australia in our international marketing activities

As Mr Wilson noted at the hearing, the fax was in black and white. The applicant described, in the fax to the opponent, the “actual colours” represented by the black and white copy which was sent. So far as can be seen from the evidence, in the version actually adopted by the board, the words “CONVENTION & VISITORS BUREAU” and “YOU’RE BEAUTIFUL” were indicated to be in “reflex blue”, the same colour as used for the sails. The word “Sydney”, on the other hand, was to be in warm red. This information about colours would not have been necessary had not the applicant wished to reassure the opponent about what was actually to be adopted. What was adopted was said, in my opinion, to include the words in question. Any looseness or uncertainty about what was being adopted and to be used has, in my opinion, crept in subsequently.

Mr Martin’s own evidence puts a different face to the adoption of the logo. Mr Martin apparently rang the applicant after the relevant board meeting. His own uncontroverted declaration is to the effect that he expressed, to the then managing director of the applicant, Mr Anthony South, the opponent’s reservations: “I said to him...It is, in our view, the same as our logo”.

The upshot of all this was that officers of the opponent attended two meetings with the designers of the applicant's logo. These led to a revision of the logo. I will refer to this later version as "the revised logo". The revised logo incorporated all the words of the original design and a total of five sails, identical in their rendition to those shown at the head of this decision.

For clarity, the revised logo is as follows:

For reference, I will say that the word content and style is exactly as in the original design and that the only changes that I can see are in the addition of one sail at the right side of the logo and in the adding of a band of white along the top edge of each sail.

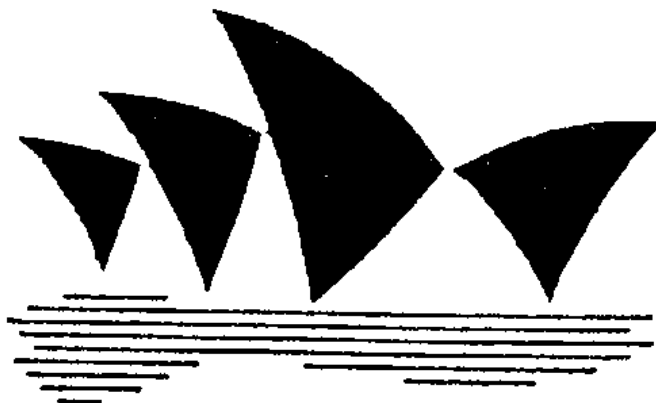
There is no doubt, of course, that the applicant has used - and applied to register - the device element without all of the words present in the logo as adopted. It has used the mark, as applied for, ie showing just the sails and the word "Sydney", on brochures and promotional material on a fairly regular basis. In one instance at least, that mark has been used in a brochure which, on the facing page, mentioned the opponent and showed the opponent's trade mark. The brochure in question, called the *Sydney Facilities Guide*, is dated 1995-96. Both trade marks, I will add, were in that instance relatively small, used in the margins, almost as decorative trim to make the look of the brochure more pleasing to the eye. The brochure is a substantial document of some 200 pages. It seems from the evidence that the first edition of this publication to feature the trade mark the subject of the opposed applications was the 1992-93 edition, which apparently sold for \$30.00 per copy.

Returning to the events of February 1990, Mr Martin, on what he now declares was a very sketchy understanding of how the logo would be used, told the applicant that the revised design

“was acceptable”. Mr Martin declares that he did not know that registration of the logo as a trade mark was intended by the applicant.

In several instances, as Mr Wilson noted, Mr Martin’s declaration fails to draw a clear distinction between the thing originally adopted by the board of the applicant and the thing as sought to be registered by them. Mr Martin’s declaration can be read as though he sees the two things as one and the same, or as consistent. That is something that Mr Wilson noted in his argument that the applicant’s actions are “broadly consistent” with the board meeting and with developments since then. I will say, here and now, that I do not accept Mr Wilson’s argument that such actions were necessarily consistent with the action taken at the board meeting. I will return, below, to the extent to which the two can be reconciled.

What, then, was the opponent’s own logo, the cause of Mr Martin’s expressed concern? It is as follows:



This trade mark is registered for goods in various classes. Among the registrations are numbers 488685, in respect of “Entertainment services, production of opera, shows, and concerts”, and 488687. The latter was filed on the same date, 9.6.88, in respect of “All goods in this class including paper and paper articles, printed matter, periodicals, stationery, adhesive material, ordinary playing cards”.

The records of the Trade Marks Office show that the examiner who dealt with the present applications came to a conclusion like that of Mr Martin. Objections were therefore taken in terms of ss 33(1) and 33(2), under the Trade Marks Act 1955. The basis of these was that the present applications were said to be deceptively similar to registrations 488687 and 488685 respectively. The present applications were allowed to proceed only on application of the provisions of sub-section 34(1). It is time I set down these relevant provisions:

**33. (1)** Subject to this Act, a trade mark is not capable of registration by a person in respect of goods if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in

respect of the same goods, of goods of the same description as those goods or of services that are closely related to those goods, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

(2) Subject to this Act, a trade mark is not capable of registration by a person in respect of services if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same services, of services of the same description as those services, or of goods that are closely related to those services, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

#### **Concurrent use**

**34.** (1) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, the Registrar may permit the registration of trade marks which are substantially identical or deceptively similar, or, but for the honest concurrent use or other special circumstances would be deceptively similar, for the same goods or services or other goods or services, by more than 1 proprietor subject to such conditions and limitations (if any) as the Registrar imposes.

It is also worth noting that Mr South, the present Managing Director of the applicant and a declarant in the present opposition, has previously made a declaration in support of the application of s 34(1). In this he was successful, and the provisions of s 34(1) were applied to allow the applications to proceed, at least to the acceptance stage. Mr South's earlier declaration, while relied on before the trade mark examiner, is not part of the evidence in these proceedings. And for good reason - it is incorrect.

I raised, at the hearing, some discrepancies between what Mr South had to say to the examiner of trade marks and what he now has to say when the applicant is confronted with opposition proceedings. Since this bears, albeit indirectly, on what is to follow, it is necessary to set out part of the evidence that was before the Registrar's delegate at the time of acceptance, and as it now is.

Before acceptance, Mr South said, in a declaration made in August 1994:

The mark was developed in November 1989 and has been used continuously in both Australia and internationally since that time.

Now, for the purpose of the present opposition, Mr South declares that the mark was not in fact launched until April 1990. This is much more consistent with the present evidence. The board of the applicant had not even voted to adopt the original design until January 1990, and the revised version was not apparently considered by Mr Martin until February of that year. It is unfortunate that Mr South is only now able to be clear about the date of the launch - and, indeed, that Mr Martin was present at that launch.

Mr Wilson had no specific explanation for the five month discrepancy in Mr South's declarations. He did concede, when I put the matter to him, that the effect of the discrepancy was to increase the apparent duration of the period of use before the filing of the opposed applications on 4.7.90. In simple terms, the effect of that which Mr Wilson categorised as an "error, corrected on closer examination" was to increase the prior use which could be considered for the purposes of s 34(1). What was in truth a period of just over three months was thus wrongly stated to be just over eight months. Such over-statement will always assist an applicant.

Mr Wilson argued that there was also a "special circumstance" in terms of s 34(1) that was applicable here. He argued that such special circumstances are a separate provision within s 34(1), able to be relied on in their own right irrespective of the duration or otherwise of the period of honest concurrent use. I will come to that in due course. Sufficient for the moment that it be flagged as an issue.

As to the business of the applicant, it is quite clear that it is seriously engaged in promoting the entire Sydney area as a venue for "business tourism". As part of this, the trade mark in question appears on letterheads, on promotional brochures and guidebooks and, apparently, on the stationery of members. The applicant is funded jointly by its members and by the NSW Government.

The applicant has brought into evidence a mini-survey of the opinions of experienced officers in various organisations, all of which are members of the applicant. Ms Stuckey-Clarke objected to my giving any weight to this survey. I will dispose of that question now.

Mr Wilson noted that it may not necessarily be easy to find major players in the business tourism industry who are not members of the applicant. However, I must reject the survey for other and self-evident faults in its methodology, so I am not called on to deal with the subsidiary question of the affiliation of those surveyed.

For one thing, the survey attracted only five replies. I have not been told how many were sent out, but the fact remains that a meagre handful of responses was received. It is very unlikely that such a small number could be statistically significant. More to the point, the survey is unacceptable in the way it presents information to those surveyed. They are told of the two competing marks and of the date of first use of each. They are told about the dispute between the parties. They are given the opportunity to compare the two marks, then invited to admit to either being or having been deceived or confused by the concurrent use of the two marks. Since the two marks are presented as having co-existed for about five years at the time of survey, the question about deception or confusion is tantamount to asking those individuals to admit to being more mistake-

prone than the rest of their colleagues. Even if that were not so, the careful and considered responses of those surveyed, made in writing in the full knowledge of all the facts, are not, in my view, something which I should give more than token weight in reaching my own decision. The reason for this is that my own decision goes to the overall likelihood of deception and confusion among ordinary traders in the ordinary circumstances of commerce. Experienced traders who are also members of the applicant make up only a tiny fragment of the broad market for, in particular, class 16 goods.

It remains to note that the opponent's trade mark has been asserted to have been used in the sale of goods which have been generally categorised as "class 16 goods". While sales figures go back to 1983, the figure of \$8437.50 is quoted as the value of sales for not just that year but for each and every year following up to and including 1990. This leads me to doubt the accuracy of the specifics of that claim and it is in any case difficult to decide if the use in question is indeed use as a trade mark.

Trade mark use, as a swing tag attached to goods, has been asserted by the opponent in relation to jewellery. Without more information on how those goods were sold it is again impossible to say if the device in question figured in the sales in question. However, these sales commenced no earlier than 1993 and are not relevant to the matters in dispute as at the filing date of these applications.

What is quite clear is that the opponent's trade mark has, since it was adopted in 1983 in relation to the production of shows, concerts and operas, become reasonably well-known to the relevant public. I use the words "reasonably well known" cautiously, since the mark is not always prominently used on the opponent's brochures, leaflets and calendars. None the less, I think it more likely than not that the opponent's mark had a significant reputation and was reasonably well known to a reasonable number of people in the entertainment industry.

It appears that the opponent was unaware of the application to register the present form of the mark until October 1992.

### *Issues and Decision*

I turn first to the questions under ss 33 and 34.

As to the overlap of respective goods and services, Mr Wilson conceded that the application in class 16 is inevitably within the scope of the opponent's registration for all goods in that class.

As to "services of the same description", for the purposes of s 33(2), counsel for the applicant noted that there is evidence that the Opera House is regularly used as a venue for community and cultural events. That may be so, and I do not disagree. However, what is relevant for the notional comparison under s 33 of the Act is the scope of the services for which the opponent is actually registered. These are "Entertainment services, production of opera, shows and concerts". Those services, while quite broad, seem to me to be narrower than some of the business that the applicant actually conducts. Thus, while I can use the opponent's evidence as illustrative of some of the things that may fall within the scope of entertainment services, I do not see its actual business as being as definitive of the scope of its registration.

Ms Stuckey-Clarke argued that the opponent trades in entertainment services as part of its trade in, for example, conference venue hire. She stressed that the public were well aware of this overlap, and that deception or confusion would be inevitable in the circumstances of the present case. In pitching the matter on those terms, she relied on *American Express Company v NV Anev* (1985) AIPC 90-258. I will turn to that decision, albeit briefly.

At p 36,473 in that report, the Registrar's delegate, Mr Hancock, adapted the classic test for "goods of the same description" under s 33(1) to the comparable question of services of the same description under s 33(2). He adopted the tests used by Romer J in *Jellinek's application* (1946) 63 RPC 59: the nature, purpose and trade channels of the services. Mr Hancock, as I read the decision, relied on the fact that there is considerable overlap of trade channels, plus the fact that public deception or confusion would result if the services with which he was then concerned - travel agents services vs insurance services - were both to originate under the same well known trade mark. That was the basis of his decision under s 28(a) of the Trade Marks Act.

His decision sheds less light on the related but more technical question under s 33. Mr Hancock begins, under the heading "The services compared" by noting that, because of the dates in question, there was no question of an objection arising under s 33 in respect of services of the same description. He goes on to note that, of the services with which he was concerned, there was quite extensive overlap of trade channels. He also stresses, consistent with *Jellinek's case*, supra, that mere overlap in trade channels is not likely to be decisive where there is wide disparity in the nature and purpose of the services.

Ms Stuckey-Clarke argued that because the Opera House expends quite a lot of money on promoting its services - which services include entertainment services - there was, in a sense, a complete overlap between the “promotion” aspect of what the applicant does and the promotion aspect of the business of any trader.

At the hearing, Ms Stuckey-Clarke did not press the argument that the services specified in application 537292 were closely related to the goods in the opponent’s class 16 registration. While Mr Wilson did not accept that there was any conflict between the competing services, he did not press argument on that score. That was because of his belief, reflecting that of the applicant, that it will ultimately be the comparison of the trade marks themselves that rules out any objection under s 33.

I will address the relevant headings applied by Mr Hancock in assessing services of the same description.

Nature: The applicant’s service is one that combines advertising with advocacy. That is to say, it promotes the venues in Sydney as well as promoting Sydney itself as the ideal destination. However, it does not trade in entertainment services per se: its members pay their dues to the applicant because it serves the interests of all of them in general. Those members are drawn from areas as diverse as the banking sector and transport operators. Their diverse interests would not be served if it was even arguable that the applicant was a competitor with any of them.

Purpose: No service or trade in goods can be carried on without promotion in some form or other, even if it be only word of mouth, of the thing being traded in. But that similarity must not be taken too far. An advertising service is, of its nature, a service rendered to traders by third parties for the purpose of attracting consumers towards the businesses of the traders. Entertainment services, on the other hand, are rendered to the consumer by the entertainment venue.

Trade channels: Again, these must reflect the divergent natures of the services in question.

Accordingly, I conclude that the services of application 537292 are not of the same description to the entertainment services specified in the opponent’s class 41 registration.

Nor do I conclude that the services specified in application 537292 are closely related to the goods of the opponent’s class 16 registration. Since the matter was not fully argued before me, I will simply note that Mr Hancock’s conclusion in *American Express* is not an appropriate guide for me in the present case. Here, the practical differences in the nature, purpose and trade

channels of the goods and services are paramount. What the applicant does is accurately reflected in its statement of services, and what it does is not, by any ordinary stretch of the words, closely related to the work of publishers, stationers, booksellers or newsagents.

*Comparison of marks*

In brief, Mr Wilson argued that the applicant's mark does no more than make use, among many such uses that are to be found in printed matter, of what is after all a notable feature of the Sydney skyline. He noted that, in evidence, there are many occurrences of a device of the Sydney Opera House, and that "opera house" is now an indexing term used by the Trade Marks Office to describe the features of relevant trade marks.

Mr Wilson categorised the opponent's trade mark, against that background, as being notable as a placid device, "tranquil and sombre", memorable for the horizontal lines of shading under the sails. This he contrasted with the vigorous flourishes of the word Sydney in the applicant's mark and with the overall dynamic ("explosive") look of that mark as a whole. His argument, put simply, was that in a field crowded with differing representations of the Sydney Opera House, the two versions now in suit would readily be distinguished in practice.

Ms Stuckey-Clarke countered by saying that, nowhere in evidence are there two marks as close as the present two.

Both representatives agreed that the appropriate test is as per *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641

In deciding this question, the marks ought not, of course, to be compared side by side. 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, their 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."

Again, there was common ground that it is enough if the ordinary person entertains a reasonable doubt - see *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594 - the decision of Kitto J.

I must attempt to approach the matter allowing for reasonable possibilities of imperfect recollection, on the one hand, and, on the other, that the Sydney Opera House is world-famous and regularly shown in pictures, drawings and cartoons.

I have taken due regard of the prominent word “Sydney” in the applicant’s mark. However, the simple fact is that the Sydney Opera House is not the only opera house in the world. For all that it is an element of difference between the two, it is also descriptive. In applying the doctrine of imperfect recollection, the inclusion of the name of the city in question is not a hinge which can bear any great weight. Conversely, while being a descriptive element, it is also a piece of visual bulk under the sails, the position occupied, in the opponent’s mark, by the horizontal lines. It is a fact that, in the applicant’s mark, the two loops of the letters “y” in “Sydney” correspond to the low parts of the underlining in the opponent’s mark. This is an element which affects. I doubt that many people would recall it in those terms but it is a possibility which must be weighed for what it is worth.

I find it difficult to balance the relevant principles, which operate against each other. I say, as to that balance, that the matter is not clear-cut but that the applicant has not done enough to distance its mark from the device featured in the opponent’s registration and from the overall look of that competing mark. There is too much of overall similarity in the way the sails of this familiar building have been characterised in the two marks. While it may be that many graphic artists would come to similar renditions of the profile, that does not detract from the fact that, in practice, the one mark is, as a whole, likely to be taken for the other. It follows that the application 537290 is, given the overlap of the goods, caught by the provisions of s 33.

It was with this in mind that the applicant, when seeking acceptance of its applications, sought to invoke the provisions of s 34, to which I have already referred.

*Section 34*

Mr Wilson argued again the essential elements of honest concurrent use under s 34(1). While the honesty of the adoption is the chief of these, the extent of the use must also be considered.

I do not think I can accept, under that particular heading, the use of the applicant's mark after lodgement. It has been said that this can constitute a special circumstance. I will come to that presently, but for the moment let me say that, on the whole, such a brief period of use prior to lodgement of the application is unlikely to be sufficient. That is particularly so if there is any doubt about the surrounding circumstances - as here there is. The applicant has not always used the mark it now seeks to register. Sometimes, at least, the name of the applicant appears as part of the mark. Accordingly, if the use in question is a test of real likelihood of deception, the test has not always been of the marks with which I am now concerned.

I turn then to the special circumstances said to lie in the use of the mark since the date of lodgement and in its adoption with the consent of the opponent. Here, Ms Stuckey-Clarke raised what seems to me to be a complex legal issue. She argued that, despite the fact that the entire matter was discussed by businessmen in simple terms and with no reference to a licence arrangement, some form of implied licence was created. As Ms Stuckey-Clarke invited me to see the matter, the opponent, generously and in the intention that the relationship would hold firm, exchanged certain implied promises with the applicant. This was arguably done, she said, for some mutual benefit, on the basis that both parties would act on the understanding.

Mr Wilson was severely critical of this, countering that this notion of the relationship was remarkably different from what the parties had in fact done and had said to each other. It was all very well for Mr Martin to have had some sort of understanding - sketchy, as it now turns out - of what the applicant intended to do with its trade mark. That did not, in Mr Wilson's argument, amount to an exchange of promises or to an establishment of an implicit controlling relationship. As Mr Wilson argued it, the applicant had amended its mark to appease the opponent. Why, he asked, should it then think it was using the trade mark - its own trade mark - under licence? I am inclined to agree with this. If such issues of law are to be further untangled, it will have to be on appeal.

However, Ms Stuckey-Clarke also argued that the applicant had lulled the opponent into a false sense of security. It had then applied to register a mark which was significantly different to that which, in the light of the opponent's concerns, it had moved to adopt after discussions with the opponent. It had failed, moreover, to tell the opponent that it had reneged or varied its undertaking. Ms Stuckey-Clarke thus argued that the applicant's actions to date amounted to having unclean hands.

Mr Wilson argued that the applicant had acquiesced to the subsequent changes. However, the evidence of acquiescence is not very convincing. The revised version of the mark apparently came to the knowledge of the opponent in 1992. The applications which embody that mark were opposed in December 1994 and the oppositions have been on foot since that time.

It seems to me that, while the applicant devised the trade mark honestly, it has been less than painstaking in its dealings with the opponent since then. Nor did it fully disclose the matter when the question of s 34 of the Trade Marks Act was first raised during the examination of the applications. I do not see that there is anything in these circumstances that should convince me to grant, under the special circumstances leg of s 34(1), a registration that would otherwise not be available to the applicant.

### *Section 28*

This provision deals, among other things, with the registration of trade marks that may, because of an established and conflicting reputation in the hands of another trader, give rise to deception and confusion.

I will set down the relevant provisions:

#### Scandalous and improper marks

28. A mark-

(a) the use of which would be likely to deceive or cause confusion;

(b) the use of which would be contrary to law;

(c) which comprises or contains scandalous matter; or

(d) which would otherwise be not entitled to protection in a court of justice,

shall not be registered as a trade mark.

In their relevant fields, the two parties to this opposition appear to be well-known. However, I am not convinced that there is any reasonable prospect of deception or confusion in relation to the specialised trade in promotion services specified in application 537292. Accordingly, I find that s 28(a) has not been established in relation to those services.

I have already said, on the other hand, that the opponent's trade mark is reasonably well known in relation to entertainment services. From this reputation, there is an unacceptable level of risk of deception or confusion arising in relation to class 16 goods. Not only are printed goods regularly produced by those who trade in entertainment services, they are often inseparable from them. In the case of theatre programmes, for instance, they are designed to be an adjunct, to assist in delivery of the services and to enhance the enjoyment of these. In the case of tickets, possession of the printed matter ensures the delivery of the service. Equally, the practical extent of the overlap between entertainment services and printed goods has been recognised by entrepreneurs,

who routinely sell promotional books and posters etc based on the actual play or screenplay in question.

The applicant asserts, through the making of application 537290, that it is intending to trade in the general run of class 16 goods. I am, in such a case, satisfied that there would be a reasonable risk of deception or confusion in relation to some class 16 goods.

That finding establishes that s 28(a) of the Act is triggered. Ms Stuckey-Clarke noted the Registrar's interpretation of the overall construction of s 28, as advised in the *Official Journal* of 12.9.91. That interpretation has been accepted by Tamberlin J in the recent case of *Canon Kabushiki Kaisha v Brook*, 1996 AIPC 91-268. Ms Stuckey-Clarke accepted, from this, that s 28(a) was not of itself sufficient to preclude registration. Something more has to be shown, some circumstance which might disentitle the trade mark to protection in a court of justice.

Ms Stuckey-Clarke relied, in this latter question, on a decision of Sheppard J in *Nike International Ltd v Campomar Sociedad Limitada*, 1996 AIPC 91-271. Sheppard J has confirmed that various references to "blameworthy conduct" should, on balance, be seen as simply a convenient shorthand reference to conduct which would disentitle an applicant to relief in a court of equity.

From this basis, Ms Stuckey-Clarke invited me to see *Sporoptic SA v Arnet Optic* 32 IPR 430 as putting an initial onus on an a person applying for registration of a trade mark to show that it was not guilty of blameworthy conduct. Here, she relied on a detailed reading of p 441 of the report. However, I do not think that the terms of the decision can be seen in isolation from the evidence. On my reading, the delegate, having considered the opponent's evidence, inferred from the totality of the evidence that the motives of the applicant were likely to have been blameworthy. The initial evidentiary onus was on the opponent but in *Sporoptic* the evidentiary burden had passed to the trade mark applicant. When the balance was tested by the delegate, the decision was against the applicant.

I have already said that I am not satisfied with the applicant's decision to adopt the presently applied-for mark in the light of the debate attendant on the opponent's objection to the original version. I think, without going further into the matter, that the applicant's conduct in the present matter is what Ms Stuckey-Clarke categorised as disentitling for the purposes of the overall action of s 28.

Accordingly, s 28 acts as a bar to the registration of application 537290. In such a case, s 34 cannot be available to such an applicant as a matter of principle.

***Conclusion:***

Application 537290 is caught by both s 28 and s 34. I refuse to register that application.

Application 537292, on the other hand, is not so caught. Accordingly, I direct that, in the absence of an appeal, application 537292 proceed to registration.

As to costs, I direct that each party bear its own.

T.E. Williams  
Hearing Officer.  
24 June 1997