TRADE MARKS ACT 1995

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

Re: Opposition by Vigilante Systems Pty Ltd to application under section 92 of the Act by Neupart & Munkedal A/S to remove trade mark number 539126(9) - **VIGILANTE** - in the name of Vigilante Systems Pty Ltd

DELEGATE:	**Claudia Murray**
REPRESENTATION:	**Opponent** Laurence Thoo, Patent and Trade Mark Attorney, Davies Collison Cave Sydney.
DECISION:	1. Section 92 Removal Application: applicant not a person aggrieved - application refused. 2. Costs awarded against removal applicant.

Background

1. Trade mark number 539126 is registered for the word trade mark:

VIGILANTE

2. The registration is in class 9 of the *International (Nice) Classification of Goods and Services*, for "Electronic hardware and software and associated peripherals in class 9". The date of registration is 26 July 1990, and the trade mark owner is Vigilante Systems Pty Limited.

3. Danish company Neupart & Munkedal A/S (the removal applicant) made application under section 92 of the *Trade Marks Act 1995* (the Act), for removal of the trade mark from the Register on 28 November 2001. It was advertised for opposition purposes in the *Australian Official Journal of Trade Marks* dated 10 January 2002. On 9 April 2002 notice of opposition was filed by the trade mark owner, Vigilante Systems Pty Limited (the opponent).

Application for removal

4. The grounds cited in the removal application are those set out in paragraph 92(4)(b) of the Act:

> That the trade mark has remained registered for a continuous period of 3 years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner:
>
> (i) used the trade mark in Australia; or
>
> (ii) used the trade mark in good faith in Australia;
>
> in relation to the goods and/or services to which the application relates.

5. The removal application indicated that the applicant was aggrieved by the opponent's registration, and that removal was sought for all the services it covered. A statutory declaration by Michelle L. Wilson, registered trade mark attorney from the opponent's legal firm, Watermark Patent and Trade Mark Attorneys, accompanied the removal application. In the declaration, Ms Wilson stated that the opponent's trade mark had been cited against two pending applications made by the removal applicant. She also declared that trade enquiries made by her firm:

> ...failed to reveal any definitive use of the trade mark VIGILANTE. Use of the word VIGILANTE as a company name or identifier was found to be limited to use in relation to security hardware for residential or commercial properties.

6. The relevant period covered by the removal application in terms of paragraph 92(4)(b) is 28 October 1998 to 28 October 2001.

Notice of opposition

7. The opponent responded in its notice of opposition that:

- The applicant was not a person aggrieved within the meaning of section 92
- The conditions required by subsection 92(4) had not been fulfilled
- The trade mark had been used by the registered owner, during the relevant period

- The Registrar's discretion should be exercised in favour of the registered owner, by virtue of the circumstances surrounding the use and registration of the trade mark.

Evidence

Evidence in support

8. The opponent's evidence in support comprises a statutory declaration dated 1 August 2002, by Lee Chua, Managing Director of Vigilante Systems Pty Limited. Mr Chua explains that his company was founded in 1980. Since then, he declares, it has been involved, on an on-going basis, in the development, advertisement and sale of hardware and software bearing the VIGILANTE trade mark relating to electronic security equipment for protecting residential and commercial premises, and telecommunication and computer networks. This use therefore occurred both prior to, and during the relevant period covered by the removal application.

9. Mr Chua's declaration is accompanied by Exhibits LC-1 to LC-7, being various photocopies of undated brochures, labels, letterheads and business cards, featuring the VIGILANTE trade mark. He attests that these exhibits all reflect use of the trade mark by his company, during the relevant period.

Evidence in answer

10. Despite seeking several extensions of time within which to file and serve its evidence in answer, the removal applicant eventually elected not to respond to the opponent's evidence with any evidence of its own.

Hearing

11. The opponent then requested a hearing, which was held in Sydney before me, as delegate of the Registrar, on 16 March 2004. Mr Laurence Thoo, of Davies Collison Cave, Patent and Trade Mark Attorneys, Sydney, represented the opponent. No communication was received from the removal applicant, which ceased to have legal representation or indeed an address for service in Australia, in January 2004.

Removal applicant's standing as a person aggrieved

12. At the hearing, Mr Thoo made submissions in relation to the status of the removal applicant as a person aggrieved. He also dealt with the extent to which the opponent's evidence demonstrated use of its trade mark during the relevant period. He then concluded with mention of the public interest and the discretion afforded the Registrar under subsection 101(3), to refuse to remove a registered trade mark, even if the grounds on which the removal application was made have been established. These latter issues will need no further attention, however, as the removal applicant's case has failed at the very first hurdle, which is the threshold test of eligibility to make an application under subsection 92(1).

13. The mirror argument to Mr Thoo's case for the public interest in maintaining his client's trade mark on the Register, is that there is also a public interest in removing unused trade marks from the Register. Notwithstanding this, section 92 gives the right to apply for removal of a trade mark that has not been used, not just to any person, but only to a "person aggrieved". Therefore, the question of how an applicant may be properly determined to be such a person has been the subject of considerable attention by the courts. For example, see *Ritz Hotel v Charles of the Ritz* (1988) 12 IPR 417, and *Kraft Foods Inc v Gaines Pet Foods Corporation* (1996) 34 IPR 198. From the latter case comes the further determination that a removal applicant's aggrieved status is to be taken as at "the date of commencement of the proceedings in which the claim for removal of the mark is made" (page 206).

14. In *Kraft Foods Inc v Gaines Pet Foods Corporation,* supra, at pages 210-211, Sackville J observed:

> In my view, the mere fact that a person has filed an application for registration of a trade mark, without more, is insufficient to establish that the person is appreciably disadvantaged, in a legal or practical sense, by the continued registration of an identical or deceptively similar mark. The position is likely to be different if the application for registration is accompanied by material that clearly demonstrates an intention to use the mark. If the application and supporting documentation are tendered in evidence in the removal proceedings, the inference would be (in the absence of further evidence) that the applicant for removal has a sufficient interest in the proceedings to be a "person aggrieved". Of course, it is also open to the applicant in the removal proceedings to adduce independent evidence to establish that it had used or intended to use the trade mark at the relevant time. But the fact of filing the application, of itself, does not

> establish that the applicant is a person aggrieved for the purposes of proceedings under s.23(1) of the [Trade Marks Act 1955].

15. Here, in declaring itself aggrieved by the registration it sought to remove, the removal applicant referred only briefly to the existence of its own two trade mark applications, against which the opponent's registration had been raised as a citation. The Registrar would have taken its unchallenged claim to the requisite standing at face value, and not have looked behind it. However, the opponent did challenge that standing in its notice of opposition. This put the applicant firmly on notice that the matter was in dispute, as was, of course, its allegation that the opponent's trade mark was unused during the relevant period. The applicant had an opportunity to provide evidence to support its claim in evidence in answer, but it did not do so. Instead, it withdrew from the process, choosing not to file or serve any evidence in response to the notice of opposition, or to the opponent's evidence, or to defend its case at the hearing.

16. I have previously found against an opponent which neglected to claim that the applicant was not a person aggrieved in its evidence in support, belatedly addressing the issue during the hearing (*I Can't Believe It's Yogurt v Unilever Plc* (2001) 55 IPR 207). However, that opposition differed markedly from the case before me here, as the removal applicant's standing was not questioned in the notice of opposition, and therefore remained unchallenged until the matter was heard. To allow the introduction of the issue at that stage would have been a clear denial of natural justice. Further, the removal applicant had otherwise pursued its case diligently throughout, filing and serving evidence in answer, and appearing at the hearing. By contrast, here Neupart & Munkedal A/S has made an application to remove the trade mark registration, thereby obliging its owner to file notice of opposition and evidence to support that notice, only to apparently abandon its application beyond that point. Under these circumstances, which have led to the opponent being put unnecessarily to some significant degree of inconvenience, I believe it is inappropriate to give the benefit of any doubt to a removal applicant which has made no effort to properly establish its standing before me.

17. Mr Thoo drew my attention in his submissions to *Lorelle Cotter v World Wrestling Federation Entertainment Inc* [2002] ATMO 28 (28 March 2002). I agree with him that it has certain parallels with the present opposition. The observations of

Drummond J in *Woolly Bull Enterprises Pty Ltd v Reynolds* (2001) 107 FCR 166 at paragraph 7, which were cited in that case, are also pertinent here:

> An object of the 1995 Act is to create, by registration of trade marks, a species of tradeable property - see ss 21 and 22 - but only where such marks are connected with actual or contemplated trade in goods and services. It would be contrary to this object of the 1995 Act to accord standing to a person to attack a registered mark on the ground that that person had made his own application for registration of a conflicting mark where there was no proof that the person either had a trade in goods marked with the mark the subject of his registration application or had a bona fide intention to trade in such goods. Such a person cannot be said to be "appreciably disadvantaged in a legal or practical sense" by a mark he wishes to attack remaining on the Register, though he might wish to traffick in marks as distinct from to trade in marked goods.

18. Weighing all of the above into consideration, I find that the removal applicant has no standing as a person aggrieved by the opponent's registration.

Decision

19. The removal applicant has failed to meet the threshold criterion, of being a person aggrieved, for making its application under subsection 92(1). Accordingly, I must refuse the removal application.

Costs

20. The opponent has sought its costs in this matter. I see no reason why costs should not follow the event. I direct the unsuccessful removal applicant, Neupart & Munkedal A/S, to pay the costs of the opponent in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations 1995*).

Claudia Murray
Hearing Officer
Trade Marks Hearings
24 June 2004