



TRADE MARKS ACT 1995

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

Re: Opposition by HARD ROCK CAFE INTERNATIONAL (USA), INC.
to the registration of trade mark application number 559189 in the name of
FINRADIO S.R.L.

Background

This matter concerns an application number 559189 to register a trade mark, filed on 8 July 1991, by Finradio s.r.l. (the applicant). The applicant sought registration of the trade mark shown here



It applied to register the mark in class 41 for the following services:

Education and entertainment services as are included in this class, including: production and distribution of movie, radio and television programs; television and radio entertainment services; entertainment theatrical productions, musicals, reviews; organisation of games and competitions; publication and edition of books, newspapers and magazines.

The advertisement of acceptance of the application appeared in the *Australian Official Journal of Trade Marks* of 4 April 1996. On 28 June 1996, Peter Morton filed a notice of opposition to registration of the applicant's mark. Subsequently, he assigned the registered trade marks, upon which the opposition relies, to Hard Rock Cafe Licensing, Inc. On 16 June 1998, the Registrar was advised that the opposition was to proceed in the name of Hard Rock Cafe International (USA), Inc., as that corporation had been entered as the proprietor of the opponent's marks relevant to this opposition.

Henceforth, in this decision, Hard Rock Cafe International (USA), Inc. will be identified as "the opponent".

At the hearing, the opponent concentrated on submissions and evidence based on two of its grounds of opposition:

- * that the opposed mark is substantially identical with, or deceptively similar to the opponent's registered marks in respect of closely related goods or similar services - section 44;
- * that, having regard to the opponent's established reputation in its marks, use of the applicant's mark would be likely to deceive or cause confusion - section 60.

Evidence

The evidence in support comprises a statutory declaration, with exhibits, by Horace G. Dawson, III, senior director of business affairs of and for the Hard Rock Group which consists of a number of different companies, including Hard Rock Cafe Licensing, Inc. Rank Organisation Plc is the ultimate parent company of this group of companies. The declarant says that at the time of filing the notice of opposition, Mr Morton had been the owner of a number of registered marks in Australia which are listed in his declaration. In 1982, Mr Morton sold his interest in the "Hard Rock Cafe" restaurant in London, which had become popular for American style food, particular entertainment and rock theme surroundings. He operated new "Hard Rock Cafe" restaurants in various cities in the United States of America and established three such restaurants in Australia. In 1996, the marks registered in Australia were assigned to Hard Rock Cafe Licensing, Inc., one of the Hard Rock Cafe Group of companies. As Mr Dawson's declaration was filed before the change of ownership notified on 16 June 1998, there is no reference in the declaration to Hard Rock Cafe International (USA), Inc., the name entered as the current opponent. The Hard Rock Cafe Group, through its licensees or entities under its control, operates the "Hard Rock Cafe" restaurants, maintaining the same format as the original "Hard Rock Cafe" restaurant in London. The first restaurant in Australia was opened in Sydney, followed by one each in Melbourne and Surfers Paradise. To illustrate the special nature of the restaurants in Australia, Mr Dawson has annexed to his declaration photographs, copies of menus and newspaper and magazine articles. In addition to providing restaurant services, the opponent sells, in the restaurants, clothing and other goods bearing the "Hard Rock Cafe" trade marks. Mr Dawson further exhibits some

promotional material and, in confidential annexures, states the number of persons who have attended the restaurants in Australia, as well as revealing the sales records of the three restaurants.

Mr Giovanni Miscioscia, whose statutory declaration with exhibits has been filed as evidence in answer, is the sole director of the applicant, having held the position since April 1991. He declares that the applicant's mark was adopted in 1988 to distinguish radio program services provided by the applicant under the title "Rock Café". The programs were syndicated to the Italian public broadcasting corporation and available through approximately 77 local radio stations throughout Italy. In October 1990, the applicant began producing a television program using the title "Rock Café and electric guitar device". This program was shown in Italy by a public television station which telecasts the program via satellite throughout the world. The applicant has secured registrations of the subject mark in a number of jurisdictions, copies of the registrations being displayed in the declarant's exhibits. Mr Miscioscia says that, despite the operation of the opponent's restaurants in a number of European countries which have had access to the applicant's programs for some years, there has been no conflict with the opponent's services - other than a number of opposition proceedings.

I heard the opposition matter, as the delegate of the Registrar, in Canberra on 23 November 1998. Mr Gerard Skelly of Spruson & Ferguson, patent and trade mark attorneys of Sydney, appeared for the opponent. The applicant was represented by Mr John Hawker of Callinan Lawrie, patent and trade mark attorneys of Melbourne.

Submissions and discussion

Section 44 - substantially identical or deceptively similar marks

In relation to the ground of opposition based on section 44, Mr Skelly first referred to the principles on deceptively similar marks outlined in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407, observing that the doctrine of imperfect recollection stemming from *Rysta Ltd's Appn* (1943) 60 RPC 87 needed to be taken into account. He also mentioned *Pianotist Co's Appn* (1906) 23 RPC 774 and *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641 as being relevant for the directives on comparing conflicting marks. Following the criteria set down in these cases, one had to judge the overall impression of the respective marks,

he said, noting that composite word and device marks were usually recalled by reference to the actual word. While a close comparison of the marks revealed visual differences, such differences were not solely determinative of the issues concerning deceptive similarity, as considered in *de Cordova v Vick Chemical Co* (1951) 68 RPC 103. A more relevant case, Mr Skelly said, would be *Johnson & Johnson v Kalnin and Another* 26 IPR 435 where the mark BAND-AID was found to be similar to BAND-IT. The elements comprising the opponent's and the applicant's marks were so similar as to leave a general impression in one's mind of rock music which was associated with a cafe environment. He noted that, although the opponent's marks of registrations 348436 and 396198 were rendered in block capitals, those marks could be represented in any clearly discernible form of lettering, as discussed in *Morny Ltd's Trade Marks* (1951) 68 RPC 131. Mr Skelly submitted further that the concept of "contextual confusion" was relevant here: "hard rock" was a certain type of rock music and therefore "rock cafe" was likely to be perceived as related to "hard rock cafe", leading the consumers to a false belief that the services originated from the same source. In relation to the "contextual confusion" aspect, Mr Skelly relied on *John Fitton & Co Ltd's Appn* (1949) 66 RPC 110, *Kodak (A/sia) Pty Ltd's Appn* (1936) 6 AOJP and *Arendsen's Appn* (1932) 2 AOJP 433. In Mr Skelly's opinion, the risk of confusion would be heightened in the present case because the opponent had a family of trade marks with a common element "Hard Rock Cafe" and it was important to remember that the persons concerned were the ordinary run of the mill citizens. Mr Skelly noted that the United Kingdom Registry had also found the opponent's and applicant's marks to be deceptively similar, referring to a published decision, under number 20016, in *Intellectual Property Decisions, February 1997*.

Moving on to the services of the opposed application, Mr Skelly indicated that they included a whole range of entertainment and education services. As restaurants provided a form of entertainment, music being one and theatre restaurants being another, a specification "restaurant services" would include a place where music and other forms of entertainment were provided. He remarked that in *Weller Hotels & Taverns Pty Ltd v TGI Friday's Inc* (1994) 30 IPR 631, discotheque services were considered to be of the same description as alcoholic beverage bar services. My attention was also directed to the opposition matter in the United Kingdom, *supra*,

where a narrower range of the class 41 services than those of the present specification, which covers education and entertainment services generally, were pronounced to be of the same description. It was clear, from the opponent's evidence, that entertainment was part of the opponent's restaurant services and that factor should be considered in relation to the notional use concept, Mr Skelly said. Although the case law on services of the same description had not developed to the same extent as on goods of the same description, by analogy with *Jellinek's Appn* (1946) 63 RPC 59, the appropriate test would include the consideration as to whether the services in question might be expected to be provided by one trader under the same mark, he submitted. Concerning goods closely related to the services, Mr Skelly relied on *Re Aussat Pty Ltd* (1993) AIPC 91-004, saying that there was a very close commercial nexus between some of the goods embraced in the opponent's class 9 registration 556367.

Commencing submissions on the section 44 issue on behalf of the applicant, Mr Hawker agreed that viewing the marks side by side was not the relevant test. However, from the opponent's evidence, it was apparent that the mark HARD ROCK CAFE was predominantly used with a circular device and in a particular script. It appeared that, at least on the promotional and related material, the logo form of the opponent's mark was dominant and, although the opponent's marks would be identified as "Hard Rock Cafe", the significant visual elements in the marks were important in the present context, because the marks had partly achieved notoriety through this visual use of the logo. Similarly, the awareness of the applicant's mark, at least in part from the television programs, had been gained through the visual medium. In the circumstances, taking into account their significant differences therefore the marks were distinguishable, Mr Hawker said.

Discussing the nature of the respective services, Mr Hawker submitted that he did not dispute the link between the provision of services in cafe restaurants, bars and discotheques, but considered the services provided by the applicant not to be similar to those of the opponent's "Hard Rock Cafe" registrations. He distinguished the services by the persons concerned having to make certain decisions and the manner in which those services were accessed; a restaurant, by definition, involved attendance, which required a decision by the consumer as to what type of restaurant to attend, whereas the applicant's services were accessed by television or radio, possibly using a

program guide. As a consequence, in deciding whether they wished to eat, or whether they chose to be entertained by switching on radio or television, the people involved were making two fundamentally different decisions. He also argued that the providers of the services engaged into entirely different activities, pointing out that the applicant's services were created and produced in an entirely different manner to the restaurant services. There was a clear division between what the consumers received and what the providers presented, he explained, and therefore any confusion was very unlikely. Mr Hawker added that, despite any reservations about the applicant's evidence, it could be gleaned from it that in at least certain jurisdictions in Europe, the marks co-existed. This factor, he said, should outweigh any speculation of the likelihood of their confusion.

The relevant provisions under section 44 read:

44.(2) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
 - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
 - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

In claiming that use of the subject mark would be in conflict with the opponent's marks, the opponent has relied on eight of its registered marks in Australia. Six of these marks comprise words, the details of these marks being:

Class	Number	Trade Mark	Services
348436	HARD ROCK CAFE	42	Cafes
396198	THE HARD ROCK CAFE	42	Restaurant services in class 42
438821	BABY HARD ROCK CAFE	42	Restaurant services
468884	HARD ROCK CAFE	42	Restaurant services
492525	BABY ROCK	42	Restaurant services

493522 BABY ROCK CAFE 42 Restaurant services

The mark of the other two registrations, 426051 and 556367, is shown here:



The former registration covers "restaurant services" in class 42. Registration 556367 is in respect of goods in class 9, being: "All goods in this class inclusive of sunglasses, spectacle cases, spectacle frames and spectacle lenses".

All of these opponent's marks were registered before the filing of the present application on 8 July 1991.

Viewing the marks now being considered beside each other in light of the directives by Windeyer J in *Shell v Esso*, supra, quite clearly, there emerge sufficient differences between the marks for them not to be termed as substantially identical. When comparing first the applicant's mark with the opponent's marks which feature a device, i.e. a guitar on one hand and a disc on the other, the unique stylized form of lettering rendering the words in these marks as well as the absence of the word "hard" from the applicant's mark, there seems to be no question as to their dissimilarities. The differences between the other marks to which the opponent has referred in the context of section 44 ground are further enhanced when considering the unusual visual features in the applicant's mark, such as the guitar device, part of which forms the initial letter of the word "rock" and the special script of the word "café" as opposed to the mere words constituting the opponent's marks.

In the same case, *Shell v Esso*, at 415, his Honour also set down the guidelines for consideration of deceptively similar marks:

On the question of deceptive similarity, a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on

recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have...

Under section 10, trade marks are deceptively similar if they so nearly resemble each other as to be likely to deceive or cause confusion.

Except for the mark BABY ROCK of registration 492525, all the other opponent's marks identified for the purposes of the present proceedings and the opposed mark have in common the words "rock cafe". It seems to me, and here I entirely agree with Mr Skelly's submissions, that these words would invariably be associated in the minds of the general public with a certain type of cafe where its patrons can listen to rock music while partaking of their meal. The guitar device displayed in the applicant's mark reinforces this image. The words "hard rock", simply describing rock music played loudly with a heavy beat, when conjoined with the word "cafe" convey almost the same idea as "rock cafe". It is the idea expressed by these words that is likely to be remembered by the ordinary persons interested in the services in suit rather than the fact that there are some other details included in the marks. In support of this contention I turn to *Jafferjee v Scarlett* (1937) 57 CLR 115, at 121-122. It was also observed by Lord Radcliffe in *de Cordova v Vick*, supra, at 106, that "in most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impression or some significant detail than by any photographic recollection of the whole". In this regard, I take Mr Skelly's point that the opponent's marks registered as words in ordinary letters would constitute legitimate use of those marks in any legible form of their letters. Moreover, as submitted by Mr Skelly, in the present situation it is also relevant to take into account the fact that the words "rock cafe", which are contained in all the opponent's registered marks but one, could evoke a relationship with the opponent's existing trade marks, suggesting that the services specified by the applicant emanate from the same source, as has been considered in *John Fitton*, supra, in that case the mark EASYJEST having been refused in face of JEST. In my opinion, therefore, all the opponent's marks identified in the list above, except the mark BABY ROCK, are deceptively similar to the opposed mark.

To complete the enquiry in relation to section 44 of the Act, I must also investigate whether the respective marks are similar and whether the nominated services are

closely related to the opponent's goods. Noting that "similar services", under subsection 14(2), are defined as the same services or services of the same description, I will adopt the factors that were considered in relation to "services of the same description" under the *Trade Marks Act 1955*. Applying the factors which were relevant to deciding the question of goods of the same description - Romer J in *Jellinek's Appn*, supra - to determine whether the services are similar, regard must be had to the nature of the services, their uses, and the trade channels through which they are provided.

The marks of the opponent's registrations 396198, 426051, 438821, 468884, 492525 and 493522 are registered in respect of restaurant services, whereas the registration 348436 covers cafes. A restaurant, in the normal sense of the word, is a public premise where meals are served to customers. A cafe is usually associated with a rather unpretentious place similar to a small restaurant where customers could expect to obtain coffee or tea and light refreshments, or meals. In some countries, as indicated in the *Macquarie Dictionary*, alcohol and other refreshments are also served in such locations. Essentially, the function of restaurants and cafes is the procuring of meals and beverages to customers. The opponent's evidence has shown that the "Hard Rock Cafe" restaurants provide not only meals but also entertainment, including musical and television entertainment. In his declaration, Mr Dawson says that these restaurants are used "as venues to promote local and international musicians, television, film and other personalities as well as television shows". Having regard to the entertainment services which feature in the opponent's restaurants, it has been submitted that, given the business and commercial reality, the services of the present application are similar to those provided by the opponent. I do not agree with this proposition.

I have been referred to a Trade Marks Office decision, *Weller v TGI Friday's*, where the hearing officer held that discotheque and alcoholic beverage bar services are of the same description. In a subsequent unpublished and a more relevant decision *Johnny Rockets Licensing Corporation v Pacific Ventures International Limited*, issued on 13 December 1995, I stated, at 5-6:

"... I am not satisfied that discos and musical entertainment are provided in the majority of restaurants. Considered in light of the tests outlined in *Jellinek's*

Appn (1946) 63 RPC 59, the aim of discos and musical entertainment is to amuse or to afford diversion to the listeners. Such entertainment may be presented in vocal or instrumental form, or a combination of both, or as a show with songs, instrumental music and dancing, whereas the primary purpose of restaurants is to provide meals and drinks in a comfortable atmosphere, recorded or live music often being played in the background. In theatre restaurants live entertainment usually follows the completion of a meal to allow members of the audience to concentrate on the presentation. To my knowledge, persons responsible for live performances in restaurants do not normally provide services associated with the serving of food. While the combination of these services in the opponent's theme restaurants may be an exception to the accepted and common practice, the primary function of its restaurants is, I believe, the provision of meals, the song and dance performance by the waiters playing a subsidiary role."

I am not convinced that the situation here is not similar. The entertainment supplied in the opponent's restaurants appears to serve only an ancillary function to the provision of food services. In this regard, I observe that the opponent advertises its "Hard Rock Cafe" restaurant in the dining section of the Sydney Tourist guides. Thus, from *Where Magazine*, covering the week from 15 to 21 November, 1996, one would ascertain that the attraction of the restaurant in Sydney is inherent in its food, drinks and memorabilia pertaining to rock 'n' roll:

"What could be more international than rock 'n' roll and hamburgers? The Hard Rock Cafe has both! This incredibly successful chain of cafes has made its mark in all major cities of the world and they house the world's largest collection of rock 'n' roll memorabilia. Great atmosphere, great drinks and g-r-e-a-t burgers!..."

A promotional pamphlet in exhibit J of Mr Dawson's declaration describes another opponent's restaurant in a like manner:

"While you're in Surfers Paradise, don't forget to visit some of rock 'n' roll's greatest legends. At the Hard Rock Cafe you'll find the food, atmosphere, merchandise and memorabilia that have made us famous throughout the world, plus Australia's first and only Hard Rock shop."

Any entertainment that the patrons of the opponent's "Hard Rock Cafe" restaurants have an opportunity to enjoy would be an additional attraction to the primary business of the restaurants as places for obtaining a meal in themed surroundings. The entertainment and serving of the food may occur under the same roof, but there is no evidence that these services are provided by the same persons. Even if that were the case then, obviously, it would not be the only decisive factor in this matter.

Having reached the conclusion that the opponent's restaurant services do not have such a close nexus of similarity, as contended by the opponent, and in light of the tests propounded in *Jellinek's* case, supra, I do not believe that the apparatus and instruments used in relation to education and entertainment services, which services are claimed by the applicant, could fall in the category of services closely related to the opponent's goods covered by registration 556367.

Accordingly, while I regard the applicant's mark to be deceptively similar to the opponent's marks, with the exception of one, the opponent has failed to convince me that the services provided under those marks, are similar to the applicant's services, or the goods of the opponent's class 9 registration are closely related.

Reputation acquired by the opponent's marks - s.60

On the issue of the section 60 ground, Mr Skelly referred me to the prior use of the opponent's mark in relation to the restaurant in Sydney, submitting that, irrespective of such use, many Australians would have been familiar with the opponent's theme restaurants. This knowledge would have been derived from international travel and from the normally great fanfare associated with the opening of the opponent's new restaurants, as well as the publicity surrounding the Australian Record Industry Awards (ARIA) evening held in the Sydney restaurant. Even not taking into account the direct substantial use of the opponent's mark in Sydney, the necessary reputation in the opponent's marks would have been acquired through their international use in the café restaurants, Mr Skelly said. Discussing the actual manner of use of the opponent's marks and the fair and notional use of the subject mark, Mr Skelly submitted that the opponent's evidence showed a close relationship between entertainment services and the opponent's restaurants and that there existed a very strong inference that the opposed mark could trade off the opponent's reputation. He said there was a blurred distinction between themed entertainment venue as opposed to providing entertainment itself. The opponent might be in the restaurant business but it was a themed restaurant business which was the driving force that attracted clients to the restaurant.

In reply to these submissions, Mr Hawker said the applicant did not question the significant reputation in the opponent's marks. However, it did not accept that that

reputation was so significant and so broad that registration of its marks solely for restaurant services would allow the opponent to monopolize the very areas in which it had actually gained its own reputation. Simply having a reputation associated with celebrities and memorabilia should not, in a trade mark sense, grant the opponent a monopoly so as to prevent other parties from engaging in entertainment services, particularly if the marks used were different. In any event, in relation to the reputation, the opponent could not rely on events that did not take place before July 1991, he said.

Under the provisions of section 60 -

- 60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:
- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
 - (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

As I have already determined that the opposed mark is deceptively similar to a number of the opponent's marks registered before the filing of the present application, pursuant to the provisions of section 60, it remains for me to decide whether those opponent's marks have acquired such a degree of reputation prior to the application that the applicant's mark, used in a normal and fair manner in relation to the services specified, would be reasonably likely to cause deception and confusion amongst a substantial number of people - *Smith Hayden & Co Ltd's Appn* (1946) 63 RPC 97, at 101. The relevant date, the date of the application, is 8 July 1991.

Of the opponent's three "Hard Rock Cafe" restaurants operating in Australia, only the restaurant in Sydney had been opened before the priority date, the other two restaurants having commenced business only in 1995 and 1996, respectively. The opponent has submitted that many Australians would have been acquainted with the type of restaurant bearing the name "Hard Rock Cafe" from their visits overseas and the extensively publicised opening of new restaurants. While it would be reasonable to expect that a certain number of Australian tourists would have encountered the opponent's trade marks in relation to restaurants during their travels overseas, particularly in London and some cities in the United States of America, no evidence

substantiates this contention. There is no denying that the "Hard Rock Cafe" restaurants have been involved in community activities, including sponsorships for various worthy causes, which have attracted wide publicity in newspapers and magazines, as evidenced in Mr Dawson's exhibits. The restaurant in Sydney has been promoted under the HARD ROCK CAFE marks in tourist guides and has received considerable publicity when the event of announcing the ARIA nominations was held in that restaurant in August 1996. Mr Dawson's further exhibits demonstrate the opponent's endeavours in promoting its restaurants in the print media circulated nationally. In addition, as pointed out by Mr Skelly, the opening of the opponent's restaurants has attracted a great deal of attention and publicity. However, most of the activities and promotion in relation to all three of the opponent's restaurants occurred only after the opening of the restaurants in Melbourne and Surfers Paradise, i.e. subsequent to filing of the application. Therefore, for the purposes of section 60, only any reputation present in the marks in relation to the restaurant in Sydney would be of relevance.

To assess the extent of that reputation, I turn to the confidential exhibits annexed to Mr Dawson's declaration. These set out the attendance numbers of all three of the opponent's restaurants, covering the period from April 1989 to November 1996, and to the annual sales resulting from the attendances as from 1991. There is no indication as to the separate amounts representing the provision of the actual restaurant services and the value of different merchandise items, such as clothing bearing the mark, which are sold in the restaurants. Given the relatively short duration of its operation before July 1991, this evidence demonstrates considerable popularity of the opponent's "Hard Rock Cafe" restaurant in Sydney in the relevant period, but I am not satisfied that a substantial number of persons outside the Sydney area would have been aware of the opponent's theme restaurant trading under the name HARD ROCK CAFE. From this evidence and what I have said previously, it is obvious that it would be impossible for me to conclude that the reputation of the HARD ROCK CAFE marks had spread extensively to other parts of Australia before the existence of the present application.

According to Mr Miscioscia's evidence, before October 1990, the applicant had used the subject mark in relation to radio programs exclusively in Italy. The declarant's

statement that the applicant's television program had been seen throughout the world via the satellite since adoption of the mark for such use is not evidenced by the program having reached the viewers in Australia. There is an assertion that the applicant's services under the opposed mark have a considerable reputation "throughout Europe and other parts of the world". If that is so, it appears that the reputation of the mark in respect of the applicant's radio and television presentation services did not extend to Australia before the applicant applied to register the mark.

While an opponent would normally have a more formidable case in terms of section 60 if its services were similar to those of the applicant, or the goods closely related, it could still succeed even if the services and goods under consideration were not of such nature. D.R. Shanahan in *Australian Law of Trade Marks and Passing Off*, second edition, at 166-167, discusses cases where, in view of some close connection between the goods or services, those goods or services could be perceived to be associated. Concerning the actual manner of use of the opponent's marks, it has been submitted by the opponent that Mr Dawson's evidence shows close nexus between entertainment and the opponent's restaurants. In this regard, particular attention has been directed to the decorative use of the guitars, menus in the shape of a guitar and the prominently placed guitar on top of the opponent's Surfers Paradise restaurant. Furthermore, it has been said that the combination of the words "rock" and "cafe" in the opponent's marks would strengthen the association between entertainment services in a cafe setting.

It is clear, that in order to sustain opposition based on section 60, the opponent must first establish reputation in the mark or marks in respect of the relevant goods or services before the priority date. Consideration may then be extended to the question as to whether, having regard to that reputation, use of the applicant's mark was likely to cause deception or confusion amongst reasonable users of the marks. In each case cited by Mr Shanahan, the opponent had established long, substantial and extensive use of the respective marks in relation to the goods, for example, in *Prestige Ltd v Potter and Moore Ltd* (1939) 9 AOJP 3311, *H.J. Lees & Sons (London) Ltd's Appn* (1955) 72 RPC 75 and *Camelot Design Industries Group Pty Ltd v Bernard Leser Publications Pty Ltd* (1987) AIPC 90-436. Unlike these cases, and for the reasons stated earlier, in the present instance the reputation in the opponent's marks had not

reached an appropriately significant level so as to justify consideration as to whether there exists an association between the opponent's and applicant's services which would be likely to deceive or confuse a substantial number of the prospective customers.

Conclusion

I have found the opponent to be unsuccessful in relation to both grounds of opposition it pursued at the hearing. It follows that the opposition in these proceedings is dismissed. Subject to any appeal from this decision, application number 559189 should proceed to registration.

The opponent sought costs in the matter. However, the applicant being the successful party in the proceedings is entitled to costs and I so award them.

Vija Zars
Hearing Officer
22 February 1999