

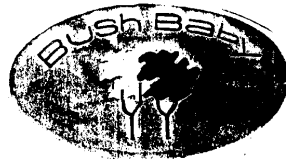


TRADE MARKS ACT 1955

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

Re: Opposition by SPASTIC CENTRE OF NEW SOUTH WALES and THE NEW SOUTH WALES SOCIETY FOR CHILDREN AND YOUNG ADULTS WITH PHYSICAL DISABILITIES to the registration of Trade Mark application number 567570 in the name of NATURAL PAPER

Application No. 567570 was lodged on 19th November, 1991 in the name of NATURAL PAPER ("the applicant"). The application was for registration of the mark shown below:



we love animals

It sought registration of the mark in respect of "clothing footwear headgear". The application was advertised as accepted in the *Official Journal* of 25th June, 1992, and on 24th December, 1992 a notice of opposition to registration of the trade mark was lodged by SPASTIC CENTRE OF NEW SOUTH WALES and THE NEW SOUTH WALES SOCIETY FOR CHILDREN AND YOUNG ADULTS WITH PHYSICAL DISABILITIES ("the opponents"). It is noted that in the notice of opposition the applicant's name appears as 'NATURAL PAPER PTY. LTD.', which does not affect the validity of the opposition. The main grounds of opposition may be summarised as being based on the applicant's non use of the mark or intention to use it; claims of proprietorship under s. 40 of the Act; that owing to the similarity between the applicant's mark and the works of May Gibbs, and the extensive use of the works and substantial

reputation of the marks of May Gibbs and the Bush Baby characters, any use of the mark in respect of the specified goods would cause deception or confusion; that the mark's use would be likely to deceive or cause confusion under para. 28(a), and that the present mark's use would be contrary to law and not entitled to protection in a court of justice. Filing and service of the evidence in support was completed on 16th December, 1993. The evidence in answer was therefore due to be served by 16th March, 1994. In the absence of any evidence by the prescribed date, the Registrar advised the parties concerned, in terms of reg. 70, that if no hearing on the matter was sought within 21 days of the date of the letter, being 25th May, 1994, the matter would be decided on the material available to him. No request for a hearing had been received within the time specified.

Opponents' Evidence in Support

This evidence, with exhibits, consists of three statutory declarations. The first of these declarations is by Mr. Timothy Charles Munro Curnow, the managing director of Curtis Brown (Australia) Pty. Limited, the company acting as theatrical agent, merchandising agent and literary agent for the opponents since approx. 1975. This company has actively sought to licence and continues to licence the use of "May Gibbs" works to produce an income for the opponents. As an agent for the opponents, Mr. Curnow has inspected and approved all material incorporating any part of the words of the late May Gibbs in which capacity he has come into possession of a number of documents and other material and products. He has also been responsible for the supervision and approval of the material published and products manufactured to ensure the integrity of the works of May Gibbs. The author and artist May Gibbs first used the expression "Bush Babies" in a series of small books published in 1916 and 1922 which have been reprinted a number of times, including several times in the 1980's and 1990's. One of the books was titled "Flannel Flowers and Other Bush Babies". Recently three of the books have been published as a

miniature series called "Bush Babies". In his opinion, the expression "Bush Babies" is commonly used and understood to refer to the series of unique characters created by May Gibbs. As a consequence of his involvement in the marketing of the various products manufactured under the licence agreements, he believes that the public has come to identify the words "Bush Baby" and "Bush Babies" as referring to the characters created by May Gibbs. To Mr. Curnow's declaration are annexed a considerable number of exhibits, which are listed and described hereunder:

"A": copies of the cover and title pages of the "Bush Babies" book series;

"B": a list of titles of works published by May Gibbs;

"C": a list of May Gibbs works published by Angus and Robertson Publications and for sale as at 29th September, 1991;

"D": copies of the covers, title page and other printed material of "May Gibbs Diary" and a "May Gibbs Note Book";

"E": copies of proof sheets relating to a proposed publication of a book on craft ideas using May Gibbs characters;

"F": copies of "Advance Information Sheets" of publications, particularly those making reference to the "Bush Babies";

"G": a page from a Japanese publication advertising the works of May Gibbs;

"H": a list of licence agreements: within this group of companies the characters are commonly referred to as the "Bush Babies";

"I": a photocopy of a label for children's clothing referring to the "Bush Babies";

"J": a photocopy of a shirt displaying May Gibbs characters with the words "Australian Bush Babes";

"K": a photocopy of a child's jumpsuit displaying May Gibbs characters with the words "Gumnut Babies";

"L": photocopies of handicraft material referring to May Gibbs characters;

"M": a schedule of the handicraft products sold;

"N": copies of advertising of handicraft material;

"O": a photocopy of a place mat and coaster with a copy of an article used in the packaging of these articles;

"P": a copy of a medallion displaying some of May Gibbs characters;

"Q": a copy of a schedule of licensees indicating royalties paid to the opponents.

Mr. Curnow states that if the words "Bush Baby" is a registered trade mark owned by a person or company other than the opponents, it would cause the public to believe that the products sold under that mark were in some way associated with the works of May Gibbs or the opponents. He is particularly concerned that the use of such a mark in the sale of stationery and clothing would affect the sale of similar products being sold under licence from the opponents.

To the second declaration by Mr. Paul Lucas, the solicitor of the opponents, is attached a copy of the will of May Gibbs, which attests the fact that all the works of May Gibbs, with copyrights therein and all royalties thereof, are payable to the opponents.

The third declaration is by Mr. Robert John Holden, the founding director of the Museum of Australian Childhood. He has been responsible for organising a popular exhibition of the May Gibbs works and has lectured on the merit of her works, as well as written many articles on her. He expresses the opinion that any person in Australia familiar with literature would readily identify the words "Bush Baby" with May Gibbs. He has prepared a report on the use of those words as used by May Gibbs, a copy of which is annexed to his declaration as exhibit "A".

Decision

Proprietorship and Intention to Use the Mark

Under the provisions of sub-section 40(1) of the Act:

A person who claims to be the proprietor of a trade mark may make application to the Registrar for the registration of that trade mark in Part A or Part B of the Register.

In *Settef SpA v Riv-Oland Marble Co. (Vic.) Pty. Ltd.* (1987) 10 IPR 402, McGarvie J. explained at pages 413-414:

"Acquiring proprietorship

...

The basic common law principle is that the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark there: *Re Registered Trade Mark "Yanx"*; *Ex parte Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at 203; *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at 603; *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* (1984) 59 ALJR 77 at 83. A person who becomes proprietor of a trade mark in this way is entitled at common law to restrain a person who later commences to use the trade mark.

...

In considering who, within s 40(1) of the Act was at the time of Settef's application for registration the proprietor of the trade mark, one considers who at common law was the proprietor in Australia: *The Shell Co of Australia Ltd v Rohm & Haas Co* (1949) 78 CLR 601 at 625 and 627. Settef claims to be the first person to have used the trade mark in Australia and therefore to have been proprietor at common law in Australia."

In order to succeed in the claim to proprietorship in a mark (except where there has been no use at all of the mark), a person must be able to demonstrate first use of the mark in Australia, and the use relied upon must be shown to be for the purpose of indicating or so as to indicate a connection in the course of trade between the specified goods and that person (see section 6 of the Act and *W D & H O Wills (Australia) Ltd v Rothmans Ltd* (1956) 94 CLR 182 at 191 and *Estex Clothing Manufacturers Pty Ltd v Ellis & Goldstein Ltd* (1967) 116 CLR 254 at 271).

In instances where the question of proprietorship is raised, the parties must be claiming the same mark, or one which is substantially the same (see *Kendall Co. v. Mulsyn Paint*

& Chemicals (1963) 109 CLR 300 and *Tavefar Pty. Ltd. v. Life Savers (A/asia) Ltd.* (1988) 12 IPR 159). To determine whether the marks under consideration are substantially identical, I turn to the criteria in this regard considered by Windeyer J. in *Shell Co. (Aust.) Ltd. v. Esso Standard Oil (Aust.) Ltd.* (1961) 109 CLR 407.

The subject mark consists of an oval shape containing the words BUSH BABY over a device of two trees and the words WE LOVE ANIMALS appear under the oval device. The marks which are applied to the articles of clothing produced for the opponents under licence are illustrated in exhibits "I", "J" and "K". The first of these used on children's clothing shows a label with the words "May Gibbs" rendered in a special script with eucalyptus leaves and gum nuts in a circle device. The label also contains the words "Bush Babies" at the bottom, also in an unusual script, and a butterfly device between the circle and these words. The copy of the shirt under exhibit "J" depicts two heads peeping out of gumnut devices, which bear the words "Snugglepot" and "Cuddlepie". These devices are surrounded by eucalyptus flowers and leaves with the words "Australian Bush Babes" appearing underneath. The child's jumpsuit of exhibit "K" shows a label comprising the words "Gumnut Babies", two of the "babies" sitting on a log, the words "May Gibbs" in a circle, and the words "By Junior International", as well as some gum leaves and gumnuts. In comparing the marks, the only similar element in these marks which could be said to resemble the applicant's mark are the words "Bush Baby", otherwise the marks in their entirety are quite different from the mark of this application. It is clear therefore that these marks cannot be regarded as substantially identical.

The opponents have not substantiated their claim that the applicant does not use the mark. On the other hand, nor is there any evidence available that the applicant has commenced using the mark. The only statement in this regard is a statement made by the applicant, in accordance with reg. 8, to the effect that, as of 13th May, 1992, the applicant was using

or was intending to use the mark throughout Australia on all of the goods specified. And in this connection, in *Aston v. Harlee Manufacturing Co.* (1960) 103 CLR 391 Fullagar J. enunciated at p. 401:

"[T]he making of an application itself is, I think, to be regarded as prima facie evidence of intention to use. 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."

In view of my previous comments then, the opponents have failed to displace the applicant's claim to proprietorship of the subject mark, nor have they demonstrated the allegation that the applicant does not use the mark or has no intention to use it. The opponents have therefore been unsuccessful in respect of these grounds in the opposition.

Section 28 - Deception and Confusion

The provisions of this section of the Act are:

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.

The provisions of para. 28(a) must be considered in light of the well established principles in cases, such as *Southern Cross Refrigerating Co. v. Toowoomba Foundry Pty. Ltd.* (1954) 91 CLR 592, where the High Court said at p. 608:

"Registration should be refused if it appears that there is a real risk that the result of the user of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source."

However, as a consequence of the High Court decision in *New South Wales Dairy Corporation v. Murray Goulburn Co-operative Company Ltd.* 18 IPR 385, the Registrar follows the practice outlined in *Titan Manufacturing Co. v. John Terrence Coyne* 22 IPR 613, namely, that paragraphs (a) and (d) of s. 28 should be read conjunctively. Since then many office decisions have dealt with the conjunctive, rather than disjunctive, aspect of s. 28. Having regard of this practice, even if I were to find that the marks under consideration were likely to deceive or cause confusion, it would be also necessary to determine whether any blameworthy conduct existed on the part of the applicant which would disentitle the subject mark to protection in a court of law.

In assessing the reputation question, the relevant date is the date of lodgement of the applicant's application (see *Southern Cross v. Toowoomba Foundry*, supra). It is therefore necessary to consider the evidence of use of the marks in Australia prior to that date.

In his declaration, Mr. Curnow has expressed the view that in light of the recognition of the words "Bush Baby" and their association with the popular author May Gibbs, the use of these words by a person or company which was not under licence of the opponents, would cause the members of the public to incorrectly associate the goods under that mark with the opponents. The copy of May Gibbs' will attests to her bequeathing "all my published books manuscripts drawings cartoons works of art (except portraits of my Relatives) together with all my copyright therein and all royalties now or hereafter payable in respect thereof" to the opponents. Mr. Curnow's exhibits "A" to "G" concern publications either comprising the literary works of May Gibbs with drawings, or containing only the drawings of her characters. These exhibits demonstrate that the covers of the publications bear not only the book titles with illustrations of various characters associated with the author, but also incorporate the name of the author "May

Gibbs" in a circle, including those of the books titled "Bush Babies" and "Flannel Flowers and Other Bush Babies". It is also noted that the word "bushbaby", as defined in The Macquarie Dictionary, describes "any of the small lemurs of the liris family, of the genus Galago, esp. G. grassicaudatus, of eastern Africa, with nocturnal habits", which meaning is more likely to be connected with the applicant's mark having regard to the phrase WE LOVE ANIMALS in the mark, rather than be seen as the unique "Bush Baby" characters borrowed from the books of May Gibbs. Consequently, while since 1916 through these publications the expression "Bush Babies" denoting the various characters of May Gibbs, such as "Gum-nut Babies", "Boronia Babies", "Gum-Blossom Babies" and "Wattle Babies", have become well known and recognised by children and adults alike, I do not think that at the time of lodging the present application, 19th November, 1991, use of the words "Bush Baby" in the applicant's mark would have led a substantial number of people (see *Kendall v. Mulsyn Paint*, supra) to believe that the applicant's goods came from the same source as the publications produced under licence by the opponents, having regard to substantial overall difference between the subject mark and the titles of the publications, which also include the name of the author of the works and illustrations.

The exhibit "H" of Mr. Curnow's declaration contains a list of companies which have been granted licences by the opponents to produce articles displaying the work of May Gibbs. Copies concerning a number of those articles are annexed under exhibits "I", "J", "K", "L", "N", "O" and "P", the words "Bush Babies" appearing only on a clothing label as shown in exhibit "I", and "Australian Bush Babes" - exhibit "J". However, there is no evidence that the goods bearing the conflicting words have been sold before the date of this application. The only information concerning sales of the products is contained in the exhibits "M" and "Q"; the first indicates unit sales of handicraft material (some appearing in exhibits "L" and "N") from August, 1987 to August, 1993 in respect of goods bearing the words "Bush" or "Babies", but not "Bush Baby" or "Bush Babies" in

combination, and the latter contains a list of royalties received by the opponents from the licensees during the period from 1991 to 1993. Neither the place mats under exhibit "O" nor the medallion under exhibit "P" contains the words "Bush Baby" or "Bush Babies".

Despite lodging extensive and detailed evidence of the history and popularity of the memorable characters created by May Gibbs in her literary works and the use of those characters in relation to an increasingly wide range of products, the opponents have failed to provide clear evidence that, having regard to the opponents' reputation in the words "Bush Babies" at the relevant date, a substantial number of persons likely to be interested in purchasing the goods specified in the application, would at least be caused to wonder whether the goods had a common origin, or whether the source of these goods had a connection in the course of trade. Likewise, I can find no evidence of the opponents' allegation that registration of the applicant's mark is not entitled to protection in a court of justice. Accordingly, the opponents have been unsuccessful in relation to the grounds in the opposition based on paras. 28(a) and 28(d) of the Act.

Conclusion

I have found against the opponents on each of the grounds on which they relied, and therefore the opposition is dismissed. The applicant having succeeded is entitled to costs relating to the opposition, and I so award them.

Vija Zars
Acting Hearing Officer
31 August, 1994