



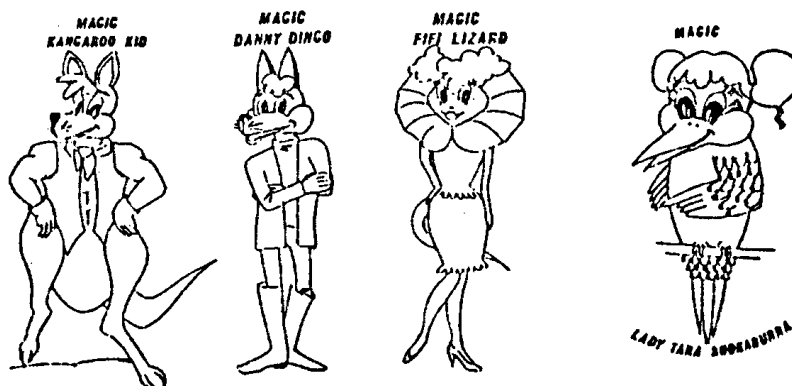
## TRADE MARKS ACT 1955

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

**Re:** Opposition by MATTHEW JAMES COULTER to the registration of Trade Mark application number 581639 in the name of STEVEN LOGAN

Application No. 581639 was lodged on 2nd July, 1992 in the name of STEVEN LOGAN ("the applicant"). The application was for registration of the mark shown here:

#### **AUSSIE TEAM**



Acceptance of the mark in respect of "education, providing of training, entertainment", in class 41, was advertised in the *Official Journal* of 30th September, 1993. Under the provisions of section 49 of the Act, a notice of opposition to registration of the applicant's mark was lodged on 21st December, 1993 in the name of MATTHEW JAMES COULTER ("the opponent") based on the grounds that the words MAGIC KANGAROO KID in the applicant's mark are deceptively similar to the opponent's mark of application No. 588364, that the applicant has no intention of using the subject mark in respect of "movie and/or video industry", and on the claim of prior use of the opponent's mark of the said application.

In terms of reg.43, the evidence in support was served by Mr. Geoffrey John Coulter under power of attorney from the opponent. It consists of an affidavit by Mr. Geoffrey John Coulter, with exhibits "A - J", stating that in view of the extensive use of the mark THE KANGAROO KID in Australia since 1989, now the subject of pending application No. 588364, the applicant's mark is likely to cause deception or confusion in the course of the provision of services. In support of this contention are annexed various exhibits of copies of the promotional literature, and articles from magazines and newspapers. Mr. Coulter states further that, to the best of his knowledge, the applicant did not intend to use his mark in the film and video industry. He also acknowledges the differences between the marks under consideration when they are viewed in their entirety, and expresses the opinion that the marks could coexist on the Register under the provisions of sub-section 34(1) of the Act.

In terms of reg. 44, the evidence in answer was due on 21st June, 1994. On 12th July, 1994, the applicant transmitted by facsimile some material for that purpose, but as he failed to apply for a late application for an extension of time to serve the evidence in answer, it was not accepted by the Office.

The matter was set down for a hearing in Canberra on 26th August, 1994. The opponent was represented, on telephone, by Mr. Geoffrey Coulter, who has a power of attorney, as mentioned earlier. Mr. Steven Logan, the applicant, represented himself.

## **Decision**

### ***Section 33***

Sub-section 33(2) of the Act provides that:

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.

Even though it was claimed in the notice of opposition that deception or confusion was likely to be caused by use of the applicant's mark, no submissions to that effect were made by the opponent at the hearing. It is noted, however, that even if the marks in question were found to be substantially identical or deceptively similar, the subject mark would not contravene the provisions of sub-section 33(2), having been lodged earlier than the mark of the opponent, which was lodged on 14th October, 1992. The opposition based on this ground therefore fails.

### ***Intention to use***

The onus of making out a case of lack of *bona fide* intention to use the mark applied for rests on the opponent. In the case *Aston v. Harlee Manufacturing Co.* (1960) 103 CLR 391 Fullager J. said at page 401:

"There is another element mentioned by Dixon J. in the *Shell Co.'s Case*, which is stated as essential to the proprietorship of an unused trade mark. That element is the intention of the applicant for registration to use it upon or in connexion with [services]. As to this I need only say that I do not regard his Honour as meaning that an applicant is required, in order to obtain registration, to establish affirmatively that he intends to use it. There is nothing in the Act or the Regulations which requires him to state such an intention at the time of application, and the making of the 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 providing the absence of intention."

The claim in the notice of opposition as to the applicant's lack of intention to use the mark in respect of the "movie and/or video industry" was not pursued at the hearing, nor evidence made available to substantiate this assertion. As indicated by Fuller J., supra, it is not the Registrar's responsibility to go beyond the statement in terms of reg. 8, which normally accompanies an application. Pursuant to this regulation, in the present instance the applicant has stated that the subject mark is being used, or is intended to be used, by the owner throughout Australia, on all the services specified in the application. In the absence of any evidence to the contrary then, I must dismiss this ground of opposition.

***Prior use***

Although the opponent did not rely on the proprietorship question in the notice of opposition, it must be considered in relation to the claim based on the use of his mark before the date of the present application.

At the hearing, Mr. Coulter's main submissions concentrated on the earlier use of the mark, THE KANGAROO KID, than the lodgment date of the present application, which is the relevant date for determining proprietorship (see *Seven Up Co. v. O.T. Ltd.* (1947) 75 CLR 203). Prior use of the opponent's mark in Australia was claimed since 1989, at least in respect of "film making and shows". The exhibits annexed to Mr. Coulter's declaration establish the fact that Mr. Matthew Coulter, the opponent, known as 'The Kangaroo Kid', has won quadricycle racing championships in Australia in 1987, and since then, in 1990 and 1991, has demonstrated his skills in shows in Australia, in 1989 has appeared in a television programme 'Run the Gauntlet', and has performed spectacular stunts overseas. No indication as to the value of the services is provided, nor the extent to which the mark has been exposed in Australia.

Mr. Logan, on the other hand, submitted that he holds copyright since 1988 in the book titled "Aussie Team", which features the 'Magic Kangaroo Kid' as one of the characters, and therefore he is entitled to prior use of his mark by virtue of the copyright protection. While that may be the case, I will point out here that the question of whether or not copyright subsists in the applicant's mark is not within the competence of the Registrar to decide (see "*Karo Step*" Trade Mark [1977] RPC 255 and "*Oscar*" Trade Mark [1979] RPC 173).

An application to register a mark can only be properly made by the proprietor of the mark. The question of proprietorship was explained in *Settef SpA v. Riv-Oland Marble Co. (Vic.) Pty. Ltd.* (1987) 10 IPR 402 by McGarvie J. at pages 413-414:

"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."

Thus, the person who has used the mark in Australia in respect of the same goods or services and before the date of the subject application, becomes the proprietor at common law. However, in such instances the mark under consideration must be the same, 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 decide whether the opponent's and applicant's marks may be regarded substantially identical, I will view the marks in light of the criteria outlined in *Shell Co. (Aust.) Ltd. v. Esso Standard Oil (Aust.) Ltd.* (1961) 109 CLR 407, where Windeyer J. enunciated at page 414:

"In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison."

As already noted, the opponent's conflicting mark comprises the words THE KANGAROO KID, its application seeking registration for: "Entertainment, film making, conducting fairs, shows, exhibitions, competitions, parades, indoor & outdoor entertainment, recreation and sporting activities", of which the entertainment services are the services also of interest to the applicant. The opposed mark consists of four cartoon characters: kangaroo, dingo, frill-neck lizard and kookaburra, identified as the MAGIC KANGAROO KID, MAGIC DANNY DINGO, MAGIC FIFI LIZARD and MAGIC LADY TARA KOOKABURRA, all presumably constituting the AUSSIE TEAM, which words appear prominently above the characters. The only common element shared by both marks are the words KANGAROO

KID, otherwise the marks are totally different, when inspected in close proximity, and I believe they would be perceived as such by users of the marks.

Consequently, even if I were to conclude that the opponent used his mark before 2nd July, 1992 in respect of "shows and competitions", since the marks under consideration are not substantially the same marks, the applicant's claim to proprietorship and therefore to prior use of the mark, has not been displaced. Accordingly, the opposition on the issue of prior use is unsuccessful.

### **Conclusion**

The opponent has failed in his opposition to registration of the mark of the application on all three grounds of the opposition. I therefore dismiss the opposition.

Vija Zars  
Senior Examiner  
12 September, 1994