



TRADE MARKS ACT 1995

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

Re: Opposition by Lorelle Cotter to an application by World Wrestling Federation Entertainment, Inc to remove trade mark number 588297(28) in the name of Lorelle Cotter

Background

Trade mark registration 588297 is registered in the name of Lorelle Cotter ("the opponent"). That registration has effect from 14 October 1992. It is for the trade mark *ATTITUDE*, registered in class 28 for *games in this Class*.

On 29 September 1999, Titan Sports Inc World Wrestling Federation Inc (formerly Titan Sports Inc) of Samford Connecticut, United States of America ("the applicant") filed an application for removal of the trade mark from the Register. The removal application was advertised on 21 October 1999. The opponent filed a Notice of Opposition to the application on 5 January 2000.

The applicant alleged that it was a "person aggrieved" within the meaning of the *Trade Marks Act 1995* ("the Act") and relied on paragraphs (a) and (b) of section 92(4) of the Act. The applicant alleged that the opponent had not used the trade mark, or used the trade mark in good faith, in the period commencing three years and one month before the date of filing: section 92(4)(b). This period ("the relevant period") is 29 August 1996 to 29 August 1999. Further, the applicant alleged that on the day that the opponent filed the application for registration it had no intention in good faith to use, authorise to use, or to assign the Trade Mark in respect of all the goods covered by the registration: section 92(4)(a).

In turn, the opponent alleged in the Notice of Opposition that:

1. The applicant is not a person aggrieved within the meaning of section 92(1) of the Act;

2. The application for registration was made with an intention in good faith to use the trade mark in relation to the goods, and in fact it has been so used;
3. the trade mark has in fact been used by the trade mark owner in respect of goods for which it has been registered within the relevant period;
4. in the alternative, if there has been no use of the mark during the relevant period, any failure to use was due solely to special circumstances, and was not due to an intention to abandon the mark or an intention not to use it;
5. in the alternative, the Registrar should refuse to remove the trade mark from the Register in the exercise of his discretion.

The matter came before me as a delegate of the Registrar of Trade Marks for hearing in Canberra on 12 December 2001. The opponent was represented by Ms Carmen Champion of counsel, who appeared by telephone. The applicant relied on written submissions.

Legislation

Section 92 of the Act relevantly provides as follows:

92 Application for removal of trade mark from Register etc.

- (1) A person aggrieved by the fact that a trade mark is or may be registered may, subject to subsection (3), apply to the Registrar for the trade mark to be removed from the Register.
- (2) The application:
 - (a) must be in accordance with the regulations; and
 - (b) may be made in respect of any or all of the goods and/or services in respect of which the trade mark may be, or is, registered.
- (3) An application may not be made to the Registrar under subsection (1) if an action concerning the trade mark is pending in a prescribed court, but the person aggrieved may apply to the court for an order directing the Registrar to remove the trade mark from the Register.
- (4) An application under subsection (1) or (3) (***non-use application***) may be made on either or both of the following grounds, and on no other grounds:
 - (a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:
 - (i) to use the trade mark in Australia; or
 - (ii) to authorise the use of the trade mark in Australia; or
 - (iii) to assign the trade mark to a body corporate for use by the body corporate in Australia;in relation to the goods and/or services to which the non-use application relates and that the registered owner:

- (iv) has not used the trade mark in Australia; or
 - (v) has not used the trade mark in good faith in Australia;
- in relation to those goods and/or services at any time before the period of one month ending on the day on which the non-use application is filed;
- (b) 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.

There are a number of elements of section 92 that must be satisfied before the Registrar will exercise his powers under the section, namely:

- (a) the applicant must be a "person aggrieved";
- (b) the application must be in the correct form and must relate to at least some of the goods for which the trade mark is registered;
- (c) there must be no Court proceedings pending which relate to the trade mark; and
- (d) at least one of the grounds referred to must be made out.

In the present case, the only contentious issues are (a) and (d), namely, whether the applicant is a person aggrieved and whether it is correct in its assertion that section 92(4) has been satisfied. I note that in its submissions, the applicant did not press the section 94(4)(a) ground.

The application for removal is in the correct form and covers all the goods for which the trade mark is registered. The application also states that it is the applicant's understanding that there are no pending court proceedings. The opponent did not dispute this.

The Evidence

Details of the evidence filed and served by the parties is shown in the following table:

Declarant	Date declared	Exhibits	Known As
<i>Evidence in Support</i>			
Lorelle Cotter	1 April 2000	LC-1 to LC-3	Cotter 1
<i>Evidence in Answer</i>			
Kenneth James Taylor	26 September 2001	KT-1 to KT-9	Taylor
<i>Evidence in reply</i>			
Lorelle Cotter	5 November 2001	LC-1 to LC-5	Cotter 2

The Cotter 1 declaration provides a history of how the opponent invented and developed her ATTITUDE board game, from 1992 up to and including the relevant

period. The game is a personal development tool, said to assist players to come to terms with themselves and thereby improve their means of dealing with life. The opponent states that during the relevant period she sold a number of her games, provided a number of games on approval, and promoted the product with various educational and community bodies.

The exhibits to the Cotter 1 declaration include testimonial letters from users of the game, 31 invoices or receipts for the relevant period, and a number of rejection letters from manufacturers of board games.

A private inquiry agent commissioned by attorneys of the applicant to investigate the use of the opponent's trade mark is the author of the Taylor declaration. His investigation commenced on 3 January 2001 and concluded on 20 January 2001. The investigation examines the business premises and activities of the opponent and the evidence in support of the opposition.

Cotter 2 refers to the Taylor declaration and responds to a number of matters raised in the evidence in answer, with supporting exhibits were appropriate.

There was no other evidence served and filed by either party.

Standing

A person aggrieved

The first issue to be determined in relation to the registration in question is the status of the removal applicant as a person aggrieved, as required by subsection 92(1) of the Act. This is a threshold test, the interpretation of which has been the subject of considerable attention by the courts. For example, see the description of a person aggrieved given by McLelland J in *Ritz Hotel v Charles of the Ritz* (1988) 12 IPR 417, at page 454:

It is sufficient for present purposes to hold that the expression would embrace any person having a real interest in having the Register rectified, or the trade mark removed in respect of any goods, as the case may be, in the manner claimed, and thus would include any person who would be, or in respect of whom there is a reasonable possibility of his being, appreciably disadvantaged in a legal or practical sense by the Register remaining unrectified, or by the trade mark remaining unremoved in respect of any goods, as the case may be, in the manner claimed.

The applicant submitted that evidence of its aggrieved status can be found in the removal application, the declaration in support of the application and in the lodging by the applicant of application 799627 for the trade mark WWF ATTITUDE (stylised) in classes 9, 16, 25, 28, and 41. The applicant's statement of goods for class 28 includes board games.

The applicant further submitted that there is no requirement to file a statement of user. The applicant contends that the effect of section 17 of the Act is that the making of the trade mark application is *prima facie* the statement of user or use. The applicant also contends that, given it has an unchallenged intention to use the mark WWF ATTITUDE (stylised), it has a reasonable apprehension of liability for infringement. Given that the opponent's trade mark has been cited against the applicant's application 785704, this provides a clear indication that the opponent's registration is an inhibition on the commercial activities of the applicant.

The applicant submitted that the onus on the applicant to establish standing is not severe and should be liberally construed, citing *Ritz Hotel v Charles of the Ritz*, *supra*, and the decision of Trade Marks Hearing Officer Zars in *First Brands Properties Inc v Interco Vertrieb Kosmetischer Erzeugnisse GmbH* (2000) ATMO 51.

The opponent submitted that the applicant had failed to lead any evidence, or satisfactory evidence, to show that it used the mark or that it has formulated plans to use it in Australia. The filing of an application does not support the drawing of an inference that the applicant intends to use the mark: *Kraft General Foods v Gaines Petfoods Corp* (1996) 34 IPR 198, per Sackville J at 209.

The opponent submitted that no probative weight should be given to the statement in the declaration in support of the removal application, to the effect that the applicant is the proprietor of the mark subject to application number 799627. The opponent contended that the applicant had had two years in which to provide evidence of a clear business interest in the removal of the mark.

In my opinion, the opponent's submissions better reflect the current authorities relating to *person aggrieved*. Further judicial consideration has indicated that the mere lodging of a trade mark application is not sufficient to establish that a person is aggrieved: *Kraft General Foods v Gaines Petfoods Corp*, *supra*. The comments of

Drummond J in *Woolly Bull Enterprises Pty Ltd v Reynolds* (2001) 107 FCR 166, at paragraph 7 provide relevant assistance to this matter:

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.

The first ground of opposition cited by the opponent was that the applicant was not a person aggrieved. This put the applicant on notice that the matter was in dispute and was likely to be argued at the hearing. The applicant had an opportunity to provide evidence to support its claim in evidence in answer. However, the applicant did not do so.

Although the Act places the burden on the registered proprietor of a trade mark regarding the proof of use or intention to use, the authorities support the proposition that there is still an onus on the removal applicant to establish that he/she is an aggrieved person and therefore entitled to make an application under section 92. It seems to me that this is consistent with an underlying philosophy of the Act that the party best able to provide evidence of certain things is the party required to prove those things.

Following the directives of *Woolly Bull Enterprises Pty Ltd v Reynolds*, supra, and the lack of any material evidence to support its statement, I find that the removal applicant has failed to establish to my satisfaction that it is a person aggrieved by the registration of trade mark number 588297. The applicant therefore has not shown that it has the necessary standing to apply for this removal application.

Conclusion

I find that the removal applicant has failed to establish the threshold test of being a person aggrieved. Therefore, I refuse the application.

Costs

Both parties sought to have their costs. I see no reason why costs should not follow the event. In accordance with section 221 of the Act, I direct that the applicant pay the costs of the opponent in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations 1995*).

Jock McDonagh
Hearing Officer
28 March 2002