



TRADE MARKS ACT 1955

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

Re: Opposition by TIME INC to registration of trade mark application number 619029 in the name of DEEKE MISKIN, STEPHEN JOHN BUSH AND NIGEL DAVID JAMES DEERING.

Background

As provided for in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this opposition. Accordingly, unless otherwise specified, any reference to the act in this decision is a reference to the *Trade Marks Act 1955*.

Application number 619029 was lodged, on 20 December 1993, by Deke Miskin, Stephen John Bush and Nigel David James Deering ("the applicants"). The application was for registration of the trade mark shown below, for magazines.



Unless there is some reason to do otherwise, I will, in what follows, refer to the applicants' mark as THAT'S LIFE!. However, this is by way of a convenient and conventional short form only.

The trade mark was advertised as accepted for future registration in Part B of the register, in the *Official Journal* of 14 April 1994. Notice of opposition to the trade mark's registration was lodged, following the granting of an extension of time to do so, on 13 October 1994, by Time Inc ("the opponent"). There were nine grounds of opposition listed in the notice but the primary grounds which were pursued at the hearing were based on sections 28 and 33 of the act. That is, that use of the trade mark by the applicants would be likely to cause deception or confusion because of the reputation of the opponent's trade mark, and that the present trade mark was substantially identical or deceptively similar to prior registered trade marks owned by the opponent.

The evidence

The service and lodgment of the evidence in support and answer relied upon by both parties were completed by 17 July 1996. At this time, after requesting a total of six month's extension of time to serve its evidence in reply, the opponent advised that it no longer wished to serve that evidence, and requested a hearing. The hearing came before me, as a delegate of the registrar, in Sydney. Mr Martin Pollock from H.R. Hodgkinson & Co. represented the applicants and Ms Fleur Hinton from Spruson & Ferguson appeared for the opponent.

The evidence comprised:

Evidence in support

- * Statutory declaration by Harry M. Johnston III, Vice President of Time Inc, dated 6 July 1995, with exhibits HMJ-1 and HMJ-2 and annexures A to E.

Evidence in answer

- * Statutory declaration by Deke Miskin, one of the applicants, dated 18 October 1995, with annexures A to Q

Submissions for the opponent

Ms Hinton began her submissions by making clear that she did not intend to press the ground of opposition that the applicant was not the proprietor of the trade mark. Nor did she intend to argue that the trade mark was not distinctive. Instead, she based her case primarily upon the grounds of sections 28 and 33 of the act.

With reference to section 33, Ms Hinton drew my attention to the history of the opponent's registered trade mark no 70313, as described in the declaration by Harry M. Johnston. This registration is for the trade mark:



for "printed periodicals and publications" in class 16. The trade mark has been used continuously in relation to a magazine since 1936. Originally a weekly publication distributed in the US and Canada, the magazine has passed through several transformations from 1946 onwards. All the different forms were distributed in Australia, commencing in 1947. In 1978, LIFE became a monthly magazine and has been distributed continuously in Australia in that form since then.

According to Mr Johnston, LIFE Magazine features articles on political, scientific, religious, sporting, health and other world issues as well as articles on fashion. The magazine specialises in photojournalism.

Ms Hinton distinguished the many examples put forward in the applicants' evidence of other magazine titles containing the word LIFE. She said that other publications where the word LIFE is used, in the context of TV LIFE etc, differ from the trade mark THAT'S LIFE!. The latter, by the addition of the demonstrative pronoun, is saying simply THAT IS LIFE. She drew an analogy between "That's" and an equals sign, arguing that this was in contrast to other, more

qualified, marks in the applicant's evidence. Examples of these would be TRUCKIN LIFE or SURFING LIFE. Ms Hinton submitted that the applicants' trade mark is clearly substantially identical or deceptively similar to the opponent's earlier, universally well-known registration, within the meaning of section 33 of the act.

Ms Hinton then went on to address the issue of section 28, and whether the applicants, in adopting a trade mark the use of which was likely to deceive or confuse, had been guilty of blameworthy conduct. She noted that the registrar now follows the practice as laid out in the decision of Hearing Officer Homann in *Titan Manufacturing Co v John Terence Coyne* 22 IPR 613 - that is, that all paragraphs of section 28 should be read together. This follows the High Court decision in *New South Wales Dairy Corporation v Murray Goulburn Co-operative Company Ltd* 18 IPR 385, the *Moo/Moove* case. It is also the practice set out in the *Official Journal* of 12.9.91.

None the less, Ms Hinton argued that there were real practical difficulties confronting any opponent who was attempting to show blameworthy conduct on the part of an applicant at the application stage. The sum of her argument was that, because of the different onus on an applicant for registration, the evidentiary standard should not be the same as in a rectification matter.

Ms Hinton pointed out that, since filing their application, the applicants have already used their trade mark to such an extent in the mass market that their unit sales have exceeded those of the opponent. She noted that they had originally requested expedited examination of their application, due to a "fear of possible infringement", as evidenced in a letter they wrote to the Trade Marks Office in 1994. From this letter it is quite clear that the applicants were concerned about their own status, not that of any third party, as a possible infringer. Ms Hinton suggested that the wording of the letter adds weight to the very likely supposition that the three applicants, all being involved in publishing, must have been well aware of the opponent's trade mark when making their application. Therefore, on the balance of probabilities, the applicants

had hoped to gain the protection of a registration, possibly to assist them to then, at some future time, achieve rectification of the register by removal of the opponent's trade mark LIFE.

Ms Hinton concluded her submissions by seeking the opponent's costs in this matter.

Submissions for the applicants

Mr Pollock began his submissions by noting that the opponent had not pressed its ground of opposition based on proprietorship. He said that, from his point of view, this ground was not available to the opponent, as the trade marks in question are not substantially identical.

Mr Pollock then went on to address the opponent's arguments that the applicants' trade mark offends against the provisions of section 28 of the act. He said that the opponent was not entitled to assign particular motives to the applicants, or to imply a guilty intent. There was nothing to support any of the opponent's allegations. Presumably the applicants would have been aware of the opponent's LIFE magazine, but it did not necessarily follow that they would have considered their own trade mark to be deceptively similar. If they had searched the register before making their application, they would have found many other LIFE trade marks already coexisting on the register.

Mr Pollock noted that the CANNON case, *Canon Kabushiki Kaisha v Brook* (1996) AIPC 91-268, had endorsed the line of Trade Mark Office decisions following from *Titan*, supra. Mr Pollock argued that the crucial thing in that case was that the Japanese Canon company had failed to "prove" blameworthy conduct on the part of the applicant.

Further, although Mr Pollock did not dispute the long history of the opponent's trade mark, he did dispute the status Ms Hinton attributed to LIFE as an icon in the magazine world. He said that the opponent's own recent sales figures for the magazine, provided in the declaration by Mr Johnston, did not support a case for such status. In any event, Mr Pollock contended, the evidentiary onus was upon the opponent to demonstrate blameworthy conduct by the applicants. This it had not done.

Mr Pollock then went on to look at the opponent's case under section 33. He cited the tests set out in *Parker J Pianotist Co's Appn* (1906) 23 RPC 774, at 777:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

If, considering all those circumstances, you come to the conclusion that there will be confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be confusion in the mind of the public which will lead to confusion in the goods - then you must refuse the registration, or rather you must refuse registration in that case.

Mr Pollock then took me through the five tests in detail, arguing that, taking into account:

- the look and sound of the trade marks
- the goods to which the trade marks are applied
- the nature and kind of customer
- the surrounding circumstances, and
- what is likely to happen in the course of normal and fair use of the trade marks;

the trade marks LIFE and THAT'S LIFE! are not deceptively similar.

Amongst other points, Mr Pollock stressed the difference between his clients' publication, and that of the opponent. He described the opponent's LIFE Magazine as an up-market, general interest publication, sold monthly and featuring international issues. He went on to depict his clients' magazine as one which targets "women of a lower socio-economic level", a low-priced, all-Australian weekly magazine for women wanting "real stories about real people". Hence the choice of title, with an "exclamation indicating resignation or tolerance"- THAT'S LIFE! The magazine is a "newsy" magazine "based on puzzles and tabloid stories". In short, Mr Pollock said, the magazines themselves, and therefore the customers of those magazines, are entirely different.

Mr Pollock concluded his submissions by suggesting that, if I did find that the trade marks were deceptively similar, I should apply the special circumstances provision of subsection 34(1) to his clients' application. This would be based upon the substantial reputation his clients' successor has established in the trade mark since filing, and the considerable hardship my refusal would cause to that party, per *Rundles Pty Ltd v Trussardi SPA* (1993) AIPC 90 - 958. Mr Pollock also sought his clients' costs, should they be successful.

Discussion

Neither Ms Hinton nor Mr Pollock was able to more clearly describe the “newsy” nature of the applicant's magazine, in contrast to the “serious” nature of the opponent's. Suffice it to say that, in the magazine universe, the applicants' and opponent's magazines are at more or less opposite ends.

The applicant relied, in written submissions to the trade mark examiner, on the demarcation of its magazines from LIFE. Ms Hinton was highly critical of this submission. She noted, from *Sym Choon & Co v Gordon Choon Nuts Ltd* (1949) 80 CLR 65, that it was not permissible to rely on what the parties have so far done. As the matter is often put: “the test is, what can the applicant do if he obtains registration” - *Smith Hayden & Co Ltd's application* (1946) 63 RPC 97. To this I turn.

Section 33 - Substantially identical or deceptively similar

Sub-section 33(1) reads:

Subject to this Act, a trade mark is not capable of registration by a person in respect of goods 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 goods, of goods of the same description as those goods, or of services that are closely related to those goods, 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.

The present application covers “magazines” in class 16, and the opponent's trade mark is in respect of “printed periodicals and publications”. There is no doubt that the respective sets of

goods covered by the two competing trade marks overlap. The question I must determine, then, in order to decide whether section 33 applies to the applicant's trade mark, is whether it is substantially identical with, or deceptively similar to, the opponent's trade mark.

Mr Pollock has argued that the two trade marks are not substantially identical. A definition of substantially identical is given in *Shell Co of Australia v Esso Standard Oil*, (1963) 109 CLR 407 at 414, where Windeyer J said:

In considering whether the 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.

In applying this definition to the trade marks in question, I must agree that a side by side comparison does raise differences between the essential particulars of the two marks LIFE, one word in upper case, and "That's Life!", rendered as two words in upper and lower case, together with an exclamation mark. I therefore do not believe the competing trade marks are substantially identical.

The question of whether the trade marks are deceptively similar is a far broader issue. A test for deceptive similarity is described in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641, at 658:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, their similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard. Evidence of actual cases of deception, if forthcoming, is of great weight.

The declaration by Mr Miskin provides a list of 47 current publications containing the word LIFE. The applicants could, I think, be forgiven for believing in the first instance that their magazine THAT'S LIFE! could also co-exist in the field without "ordinary people", accustomed to that wide field of co-existing publications, being deceived or confused. It is significant, also, that no evidence of deception has been provided by the opponent.

Notwithstanding these observations, I cannot help but agree with the opponent that, unlike the many other publications with names such as TV LIFE, TRUCKIN LIFE, EATING FOR LIFE, etc, the trade mark THAT'S LIFE does not contain an additional noun qualifying the aspect of "life" being addressed in the publication so titled. The addition of the demonstrative pronoun suggests instead that this magazine is indeed closely related to the opponent's LIFE magazine. Taking into account the sound of each trade mark, the impression given by each trade mark, the idea of each trade mark and even the descriptive quality of the word LIFE in each trade mark, I am drawn to the conclusion that the two trade marks are deceptively similar in the manner laid down in cases such as *De Cordova v Vick Chemical Co.*, (1951) 68 RPC 103 and *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147. It was found in those cases that, if the later mark incorporates the essential or distinguishing feature of the earlier mark, then confusion is likely to result. That is not to say that incorporation of one mark within the other is necessarily decisive. Shanahan, at p 171 of *Australian Law of Trade Marks and Passing Off*, second edition, makes that clear. However, such an overlap of elements should signal caution unless, to adapt from *Sym Choon*, supra, the proposed mark is overall so unlike the rival mark that it is not reasonably probable that there will be confusion in the event of imperfect recollection.

The matter must be approached in a practical sense and I realise that "that's life", standing alone, is a commonplace expression, as Mr Pollock argued. Thus, the applicant's mark has a layer of meaning not present in LIFE. This does go some way to reducing the possibilities of confusion or uncertainty.

Conversely, I must also give some weight to the fact that both marks may be used on a red background. The applicant has already brought this about and cannot be heard to say that, even in the notional context of s 33, it is an unlikely or extreme coincidence that the opponent might do the same, as in fact it does. The evidence tends to establish that red is a prominent colour, used by other publishers for just that reason.

Taking these factors together, I think I can fairly say that a not-insignificant segment of magazine buyers in general would be deceived or confused by the co-existence of the two competing trade marks. In saying this, I am of course directing myself to the hypothetical possibility that the applicant and opponent may produce the same sort of magazine, since this is clearly within the scope of both the existing registration and the present application. The comparison under s 33 must always be such a notional one, divorced from the real-world marketing decisions of the parties to date. Overall, I find that the opponent has been successful in terms of section 33 of the act.

Section 28 - Deception and confusion

The provisions of this section of the act read as follows:

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 test to be applied under paragraph (a) of these provisions has been well established by cases such as *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd*, (1954) 91 CLR 592, where it was said:

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 the two products come from the same source.

Section 28 is to be applied, in assessing what the applicant may do if it obtains registration, against the actual reputation of the opponent at the date of the disputed application - *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd*, supra. The opponent's reputation at that date was significant, having been steadily built up over a considerable period of time. Although the applicants have disputed the opponent's representation of itself as an "icon" in the publishing world, nevertheless the evidence has established that LIFE magazine enjoys a significant reputation.

I have already indicated that I believe the trade marks LIFE and THAT'S LIFE! to be deceptively similar. I would therefore have to conclude that, at the time of filing the application, there would indeed have been a real risk that the result of use of the applicants' trade mark would be that many people would be caused to wonder whether the two publications came from the same source. Accordingly, the provisions of subsection 28(a) have been established.

Regardless of my finding in relation to subsection 28(a), the opponent also needs to show that the applicant had acted improperly in relation to its application. This is as per *New South Wales Dairy Corporation v Murray Goulburn Co-operative Company Limited* (1990) 171 CLR 363, *Titan Manufacturing Company Pty Ltd v John Terence Coyne* (1991) 22 IPR 613 and *The Canon Kabushiki Kaisha v Robert James Brook and Rachel Brook trading as The Cannon Watch Company* (1996) AIPC 91-268.

Having balanced the evidence, I do not see that the applicants' act of lodging their application, even in the probable knowledge of the reputation of the opponent's trade mark, constitutes blameworthy conduct. It is clear that the applicants have been at pains to distinguish their actual goods from those of the opponent. From even a cursory glance at the magazine's cover, one is left in no doubt whatsoever as to either the market at which it is directed or the type of material that may be found within its pages. It may be that to be confused, by any member of its target audience, with the "internationally oriented, up-market" LIFE magazine would be viewed as undesirable by the owners of THAT'S LIFE weekly. I thus think it is more likely than not that they have sound commercial reasons for wishing to avoid any confusion with the "up-market"

magazine LIFE. Looking at all the available details, it seems to me that on the balance of probabilities there was no blameworthy motive on the applicants' part.

I did not find Ms Hinton's scenario for the applicants' purpose in making their application at all convincing. I do not agree that the present manner of use will result in practical conflict or confusion. Conversely, if the applicants' mark is, now or in the future, directed into a field closer to that of the opponent, that would clearly be blameworthy conduct and imperil their own registration, not that of LIFE.

I have considered Ms Hinton's arguments about the extent of the onus on an opponent to show that the applicant has been, in the context of *Moo/Moove*, supra, blameworthy. It seems to me that she may have a point and that there is no way to realistically expect, from an opponent, the sorts of attacks that may be available to a party seeking rectification. A registered proprietor, in a rectification case, can be expected to have used its trade mark and to have defended its rights, rather than acquiescing to infringing conduct. Its own conduct is thus much more open to inspection than that of a mere applicant, who may not yet have used the mark in question. The extent of the evidentiary onus will be a practical question to consider in other matters. However, the facts are against Ms Hinton in this instance.

It follows, therefore, that the opponent has not been successful in its ground for opposition under section 28 of the act.

Section 34 - Special circumstances

Given my conclusion that, on balance, the provisions of section 33 do apply to this application, I now proceed to consider whether the provisions of section 34 also apply. Subsection 34(1) states that:

In the case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper to do so, the Registrar may permit the registration of trade marks which are substantially identical or deceptively similar, or, but for the honest concurrent use or other special circumstances would be deceptively similar, for the same goods or services or other goods or services, by

more than 1 proprietor subject to such conditions and limitations (if any) as the Registrar imposes.

The relevant date at which honest concurrent use is to be established is the date of filing, that is, 20 December 1993. However, there had been no use of the applicants' trade mark at that time. It follows that I can apply section 34 to this application only if I am satisfied that other special circumstances exist which make it proper for me to permit its registration in the face of the cited trade mark.

The applicant's evidence shows that its successor in title launched the magazine THAT'S LIFE! in May 1994, with a substantial, (and continuing), Australia-wide advertising campaign in television, radio and the print media. Since that time it has sold a formidable number of copies, well in excess (by the opponent's own observation) of the turnover of the opponent's magazine for a similar period. The magazine has become, according to the applicants' evidence, the fourth largest selling weekly magazine in Australia, behind WOMAN'S DAY, NEW IDEA and TV WEEK. Clearly, refusal of the applicants' highly profitable trade mark at this time would cause them considerable hardship.

I have examined the form and content of the THAT'S LIFE! magazine, and compared it with that of the opponent's LIFE magazine. I have already expressed some sympathy with the applicants' suggested reasoning in choosing the name of their publication in the face of the opponent's. Having seen the manner in which the applicants have used their trade mark, I consider that their actual and extensive use in no way leads the potential customer to be deceived or confused as to any possible connection with the opponent's magazine. In any event, whether deliberately or otherwise, their manner of use of their trade mark has arguably extinguished that possibility of confusion. In the future, as I have said, the applicants' registration would be in peril if the owner changes marketing strategy and brings about deception or confusion.

I am satisfied that the applicants honestly adopted the trade mark THAT'S LIFE in the first instance, that their use of the trade mark has also been honest and such as to remove any

possibility of confusion with the opponent's trade mark. As Mr Pollock submitted at the hearing, no evidence whatsoever of deception or confusion between the two trade marks in question has been provided by the opponent in the course of these proceedings, for reasons which are fairly clear: there has been, in practice, none. Further, the opponent has never moved to take any legal action to prevent the applicants' use of their trade mark. I am also satisfied that the applicants' successors would suffer considerable hardship from the loss of their trade mark, in which a substantial investment has been made.

Taking all of the above into consideration, I find that a case exists for registration of this trade mark application under section 34.

Conclusion

I have found that the opponent has established the ground under section 33 relied on in the notice of opposition. However, I have also found that a case exists for registration of the subject trade mark application under the provisions of section 34. I therefore dismiss the opposition and, subject to any appeal from this decision, direct that the trade mark should proceed to registration.

The opposition has failed and I award costs to the trade mark applicant.

Terry Williams
Hearing Officer
31 July 1997