



**TRADE MARKS ACT 1955**  
**DECISION OF A DELEGATE OF THE REGISTRAR OF**  
**TRADE MARKS, WITH REASONS**

Re: Opposition by Toyota Motor Corporation Australia Limited to the registration of trade mark applications number 640196 and 640197 in the name of John Wilding.

**Background:**

After examination, trade mark applications number 640196 and 640197 were advertised as having been accepted for registration. The applicant is John Wilding and the mark in question is as follows:



Mr Wilding seeks registrations in classes 25 and 12. Application 640196 covers all goods in the former class - essentially clothing, footwear and headwear - and application 640197 is directed to motorcycles. The applications were lodged on 9.9.94.

Registration of the applications is opposed by Toyota Motor Corporation Australia Limited ("Toyota") on various grounds. After Toyota had served a copy of its evidence in support on Mr Wilding, Mr Wilding failed to serve any evidence in answer to the oppositions. Accordingly, Toyota requested that the opposition be heard. The oppositions came on for hearing and decision by me, as a delegate of the Registrar of Trade Marks.

As set down 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, the provisions to which I will refer, below, are those of the 1955 act.

At the hearing, the opponent was represented by Rohan Singh, a solicitor of the Sydney branch of the firm of patent attorneys Davies Collison Cave. The applicant did not appear.

Essentially, Mr Singh attacked the applications under three headings:

- overall onus - the applicant's failure to show that it was entitled to a registration
- proprietorship
- deception or confusion potentially caused by use of the applicant's trade mark.

I will deal with these issues in that order.

#### *Onus*

As to this, Mr Singh submitted, quite rightly, that the applicant is *in petitorio* - that Mr Wilding is under an onus to show that he is entitled to a registration. Unless he meets that onus, the applications must be refused.

Mr Singh relied on a line of reasoning typified by *Camelot Design Industries v Bernard Leser Publications Pty Ltd* (1987) 90-436 at p 37,830:

By not responding in any way to the opposition proceedings the applicant renders its application more susceptible to refusal, since it is not appropriate that the Registrar act as advocate on its behalf. However, it is appropriate that I consider the opponent's case to the extent of finding whether or not there are matters for the applicant to answer. If there are, and the applicant has not answered them, the matter must be resolved in favour of the opponent.

However, as I said to Mr Singh at the hearing, this cannot be taken too far. When a party fails to appear, it forfeits the tactical advantage of being able to explain its case and highlight the weaknesses of that of its adversary. However, as illustrated by the last two sentences I have quoted above, there is still an evidentiary onus on an opponent to make a case for the applicant to have to answer. It is now for me to decide if that is so, either under the two headings which Mr Singh addressed at length or otherwise.

#### *Proprietorship*

Mr Singh argued that, to succeed under this heading, Toyota would have to show use of essentially the same mark for the same kind of thing. To this he added an elaboration that "same kind of thing" must be taken to mean "goods of the same description". Here, he relied on *Rolewa Rentals v Champagne Moet et Chandon*, 1985 AIPC 90-238. In that case, the hearing officer, Mr Hancock, relied on a principle which goes back to *Hicks' Case* (1897) 22 VLR 636 at 640, and to which Mr Singh also referred.

This issue of the scope of the relevant goods on which an opponent is entitled to rely is one which I have dealt with previously. It will be simplest if I paraphrase what I said in that earlier case, which is yet to be reported:

In *Rolewa*, the Hearing Officer treated “the same kind of thing” as a meaning “goods of the same description”. The decision gives no authority for this step. It is not a step considered in any of the precedent cases he notes in his decision.

The outcome is comparable to that of *Magic Marker v Shachihata* (1984) AIPC 93-217. In that latter decision, another hearing officer, Mrs Hanlon, appears to have come to a similar conclusion, though it is obiter to her actual finding. As Shanahan notes at p 158 of *Australian Law of Trade Marks and Passing Off, Second Edition*, her decision, despite her comments at page 39,311 which support Mr Singh’s line, produced a finding only under s 28(a). Mrs Hanlon had, on the other hand, refused in another instance to find that first use on clocks, prior to the date of application, “necessarily determines the opposition as far as watches are concerned”. See *Hermes SA v E T Swift and Co Pty Ltd* (1984) 2 IPR 432 at 438.

I think the decisions in *Rolewa Rentals* and *Magic Marker* (both supra) may therefore be incorrect elaborations of the principle which flows from *Hicks’ case*. The point has yet to be judicially considered, but Shanahan, in the text above, also expresses some doubt about the extent to which *Hicks’s case*, supra, was taken in those decisions.

I turn to *Hicks’s case*. There, a registration under the (Victorian) *Trade Marks Act 1890 (No 2)* was under attack. Even at that time, that act used words suggestive of s 33 of the later Commonwealth *Trade Marks Act 1955*. But the words were not used in relation to infringement.

Section 16 of the Victorian act prevented the registrar granting conflicting registrations for “the same goods or description of goods” in the lack of an order from the Supreme Court. Section 20 provided that “Registration of a person as proprietor of a trade mark shall be prima facie evidence of his right to the exclusive use of the trade mark, and shall after the expiration of five years from the date of the registration be conclusive evidence of his right to the exclusive use of the trade mark,

subject to the provisions of this Act”. Section 20 does not define the goods for which that exclusive right was bestowed, but section 9 says that a trade mark must be registered for “particular goods or classes of goods”. Given that s 16 allows registration of identical trade marks when the goods are neither the same nor of the same description, the monopoly given by s 20 was clearly confined (“subject to this act”) to the goods for which the mark was registered. Section 16 created, as s 33 does under the 1955 act, a system of buffer zones between monopolies.

Under s 16 of the Victorian act, an existing registration could, if goods of the same description were involved, interfere with another person’s ability to obtain his/her own registration. Under s 21, a person could not institute “a proceeding to prevent or to recover damages for the infringement of a trade mark” unless s/he had applied for registration and either been granted registration or had it refused. But under neither s 16 nor s 21 could a prior registration for different goods interfere with the right of that other person to use his/her trade mark.

Under the (Commonwealth) *Trade Marks Act 1955*, the infringement test is more explicit. That later act does not simply make a statement about the right to exclusive use of the trade mark. Thus, unlike the early Victorian statute, infringement is defined in the legislation itself. By definition, under s 62(1), there can be no infringement if the mark of the alleged infringer is applied to goods not specified in the registration. By definition, therefore, one party cannot interfere with another party’s right to use a trade mark unless the same goods are at issue. It is only the existing right, the right to use a trade mark, which was considered in *Hick’s case*, not some future “right” to gain a registration, and in any case the 1955 act makes explicit provision for a prior user to gain registration.

Accordingly, if Toyota is to succeed in its opposition, the trade mark use it needs to show will need to be in relation to the same goods for which Mr Wilding seeks registration.

Mr Singh conceded that the marks must be substantially identical. There is now fairly clear authority for this. Here I rely on the decision in *Karu Pty Ltd v Robert Leon Jose* (1994) AIPC 91-101, in which Drummond J followed Gummow J’s decision in *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994) 120 ALR 495 or (1994) AIPC 91-049.

Given this, some of the evidence relied on by Toyota is irrelevant. The issue of proprietorship is therefore not to be considered in the light of any use by Toyota of a device of a pig running on its hind legs, or of a leaning pig shown in head and shoulders view. These pigs, in the evidence, always carry a football. They are far from being substantially identical to the pig device which Mr Wilding seeks to register.

It is not necessary to go into great detail about the evidence in this matter. To deal with the essentials of the opponent's case, I will summarise the basics:

- 1) Other than the footballer pig, Toyota has used a pig of various shapes and sizes as part of its advertising campaign in relation to motor cars, vans and four wheel drive vehicles. In at least one such advertisement, I can concede that the pig used by Toyota is substantially identical to the applied-for mark.
- 2) In a television advertising campaign, images of pigs are shown to transmorphose. What starts as a chubby domestic pig becomes, apparently, a pig which is arguably substantially identical to the one which Mr Wilder seeks to register.

Mr Singh argued that use in advertisements was necessarily trade mark use. Of this, I am not convinced. It will in all instances be for an opponent to meet an evidentiary onus and show that the use of the element was "for the purpose of indicating, or so as to indicate a connexion in the course of trade" between the opponent and the goods. Here I quote from one aspect with which Kitto J dealt in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407 at p 425. Kitto J made it clear that, it is not sufficient if a device be used or understood only as representing the opponent's goods for some allegorical purpose. "The connexion in the films between the oil drop man and the petrol he symbolizes is a connexion limited by the purpose of the occasion". Kitto J held that, if viewers were to conclude only that the oil drop man's purpose was to convey a particular message about Shell petrol, the use was not trade mark use.

I come to that conclusion here. The purpose of the pig in Toyota's advertisements is to show that, as various captions emphasise, Toyota's vehicles have more grunt. This would not, of itself, negate a trade mark function. However, the latter question is separate and is to be tested by looking at the evidence and forming my own conclusions about intended and perceived purpose. I do not accept that the Toyota pig has any function, in anything that is in evidence, other than allegorical.

I have reproduced the most clear-cut instance of the printed use by Toyota of a pig similar to Mr Wilder's.

As to the television advertisements, I am equally unconvinced. Toyota's case there apparently depends on the transmorphosing of a farmyard variety of pig into a wild boar-style pig. Whatever the effect of doing this, it is not sufficient to rely, in evidence, on still drawings taken from an advertisement which is not itself in evidence. If it is to be said that the use in question is trade mark use, that use must be shown in sufficient detail to allow me to come to that conclusion as a positive finding on a question of law.

In summary, I have not been shown a single instance of the use of a pig, substantially identical to Mr Wilding's trade mark, as a trade mark in relation to either clothing or motorcycles.

*Deception or confusion.*

Under this heading, I leave aside the secondary question of the overall action of s 28 of the *Trade Marks Act*. I will not repeat Mr Singh's analysis of established law under s 28(a) of that act. It is clear that I may refuse the present applications if I am satisfied that the use of the trade marks in question, in any of the legitimate ways falling within the scope of normal trade uses for the goods in question, would lead to deception or confusion. The overall action of s 28 will set the framework for this decision. See the Official Journal of 12.9.91, which is now followed with the explicit approval of the Federal Court.

Mr Singh argued that an unacceptable amount of deception or confusion would be the case given the reputation of Toyota's pig emblem - be it used as a trade mark or otherwise - at the date on which Mr Wilding applied for registration.

Let me first agree that the Toyota pig, in its various forms, was probably quite well known at the relevant date. Sales campaigns involving the pig had started in October 1992. There was wide coverage in the press, on television and on outdoor advertising both at fixed locations and on the side of buses.

Toyota dealers had also been able to buy, either singly or in bulk, soft toy pigs much like the one I have already illustrated. However, there is no evidence of any sale of such toys in 1993 and even in 1994 no more than about 1600 toys were sold.

All things considered, I am satisfied that Toyota's advertising campaign was well known in relation to motor vehicles at the relevant date. I appreciate Mr Singh's argument that motor vehicles and motor cycles may be goods of the same description or at least be produced by the same companies. However, while these two issues are relevant, neither of them is necessarily decisive on the question of the likelihood of public deception or confusion. This is the matter which I am to assess.

For all that other companies are well known to make both cars and motor bikes, Toyota is not one of them. I see nothing about the manner or extent of Toyota's activities to date that would cause the reputation of its pig-based advertising campaign to intrude into the clothing trade or into the buying and selling of motor bikes. I see no reason why, to paraphrase Kitto J in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, any reasonable person would suspect that Toyota had done so. Accordingly, section 28(a) is no impediment to registration.

Otherwise, I am unable to determine any issue as to possible breach of copyright or any other issues of law. Toyota has not passed the threshold tests of showing that it has such rights or that anything

Mr Wilder seeks to do in using the trade marks is in contravention of them. Perhaps, since Mr Wilder has not sought to explain or justify his position, this would have been an easy threshold to get over. However, the closest that Toyota comes to this is a simple statement: it is asserted in evidence that Toyota is the owner of copyright in various drawings of the pig. That may well be true, but its relevance to the present matter is something that is, prima facie, beyond my competence.

Accordingly, having considered the evidence relied on by Toyota, I conclude that there is no impediment to the registration of these trade marks. In the absence of any appeal, I direct that the applications proceed to registration, subject to Mr Wilding's paying the necessary fees.

While Mr Wilding may ultimately be successful in obtaining registration, he has paid very little attention to procedures under the Trade Mark Regulations. It appears from the file that he may no longer be interested in the fate of these applications. In the circumstances, I make no award of costs.

T. Williams  
Hearing Officer.

2 June 1997