



TRADE MARKS ACT 1955

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

Re: A late application for an extension of time to serve evidence in support of an opposition by AUSTRALIAN PROFESSIONAL RODEO ASSOCIATION INC. to registration of trade mark application number 675053 in the name of WRANGLER APPAREL CORP.

and

Opposition by AUSTRALIAN PROFESSIONAL RODEO ASSOCIATION INC. to registration of trade mark application number 675053 in the name of WRANGLER APPAREL CORP.

As set down by 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, the authority I refer to is the 1955 Act.

Background

Application number 675053 was lodged on 12 October 1995 in the name of WRANGLER APPAREL CORP. (Wrangler). The application was for registration of the word mark PRO RODEO and was advertised as accepted in the *Official Journal* of 11 January 1996 for the statement of goods:

"Articles of clothing including men's, women's and children's jeans, pants, shorts, knit/woven tops, shirts, vests, jackets, sweaters, blouses, belts, shoes, stockings and socks" in Class 25.

Notice of opposition to the mark's registration was lodged on 11 April 1996 by AUSTRALIAN PROFESSIONAL RODEO ASSOCIATION INC. (APRA). The notice recited grounds as laid

out in the *Trade Marks Act 1995*. The Trade Marks Office (the Office) acknowledged receipt of the notice to Biggs & Biggs, solicitors, APRA's representatives, in an official notice dated 18 April 1996. A letter was also sent to Biggs & Biggs by the Hearings Support Unit on 16 April 1996, advising that the opposition was proceeding under the terms of the 1955 Act and inviting APRA to amend the grounds to accord with that Act. No reply was received by the Office. Nonetheless, it is possible to infer some grounds from that notice which fall under the 1955 Act.

The main grounds of opposition, as stated in the notice and which can be related to the 1955 Act, may be summarised as relating to claims that the mark was not distinctive of Wrangler, that registration of the mark by Wrangler would be likely to cause deception and confusion because of the reputation gained by APRA for its own similar mark, and that Wrangler was not the proprietor of the mark applied for because of prior use by APRA of another mark,. It is not clear when service of the notice of opposition was made on the agents for Wrangler. However, the Trade Mark regulations state that evidence in support of an opposition must be served on an applicant within three months after the notice of opposition has been lodged at the Trade Marks Office, a date which is not in question. The evidence was thus due to be served on 11 July 1996.

As no evidence was served by the due date, an Official Notice was sent to both sides in the matter on 26 July 1996 noting this and advising that it was now open to Wrangler to seek a hearing under reg. 49(2) to determine the matter. No reply was received from APRA. Wrangler's attorney, Shelston Waters, then lodged, on 25 July 1996, a letter seeking such a hearing. On 20 September 1996, the Office dispatched formal hearing notices to both parties in the matter advising of a hearing to be held on 16 October 1996. On 15 October 1996, the day before the scheduled hearing of the substantive matter, Mr Peter Ryan of Biggs & Biggs sent a letter, accompanied by statutory declarations by Mr Ryan and Stephen Hilton, dated 15 and 16 October 1996 respectively, seeking approval under s.130 of the Act for an extension of time to "the end of next week" - presumably to 25 October 1996 - to serve the evidence in support and seeking a hearing on that matter. No reasons were given as to why the application had been made out of time other than a mention at paragraph seven of Mr Ryan's declaration that:

Unfortunately, the time for the filing of evidence on behalf of the Opponent was allowed to pass without such evidence being filed.

The reason given for seeking the extension itself was referred to in para 13 of Mr Ryan's declaration that:

Bob Berg [a manufacturer of jeans endorsed by APRA] has been in America for approximately 1½ months and is returning to Australia next week. An extension is sought at least to the end of next week to allow the further evidence to be prepared, signed, filed and served.

Wrangler advised that it objected to the extension being granted and, consequently, the dispute was set down before me, as an officer delegated by the Registrar to hear the matter, in Sydney on 16 October 1996. APRA was represented at the hearing by Ms Julia Baird of counsel who was instructed by Biggs & Biggs. Wrangler was represented by Mr David Wilson of Shelston Waters.

At the hearing, I advised the parties that, in my opinion, I had three options after hearing submissions from both sides in the matter of the belated extension of time. These were, firstly, that I would reserve my decision. In this event, the matter could not proceed further until I came to a conclusion and issued a decision. This is because, the result being unknown, it would not yet be possible for APRA to submit the evidence in dispute, or for Wrangler to know what evidence it needed to answer. Secondly, I could allow the extension. This would also defer the matter until the evidence was served and Wrangler could assemble its own evidence in answer, in accordance with the times laid down in the regulations. The last option was to refuse the extension sought. This would mean that no evidence in support could then be served and a hearing in the substantive matter could proceed immediately. The reason for this was because the situation would be as before the belated application for an extension of time.

Decisions

Having listened to the submissions of the parties, I adjourned proceedings for a short time to consider the matter. I then called the parties back to the hearing room and announced my decision. I announced that I had decided that, as the extension had been made out of time, then the matter should proceed under the provisions of reg.69 where "special circumstances" should be shown which prevented the application for the extension being made within the time provided by regulation 43. It was my opinion that these circumstances either did not exist, or had not been shown. Having given

full consideration to all of the factors involved, I refused to extend the time under s.130 within which APRA could serve evidence in support of its opposition. Having so found and, subject to any appeal from that decision, I proposed to then proceed to hear the matter of the opposition. APRA's counsel, Ms Baird, advised me that she had received instructions from Biggs & Biggs that, should I decide to take the course which I had, then APRA did not wish to be heard in the substantive matter. She then withdrew from the proceedings. I now also advise that I awarded costs in the matter of the hearing of the application for an extension of time to Wrangler.

I then heard submissions from Mr Wilson, for Wrangler, on the matter of the opposition. Having heard these submissions I gave the matter due consideration and then announced my decision that the opposition had not been successful and that the mark should proceed to registration, subject to any appeal from that decision. Significant in my findings was the fact that there was no evidence to support the grounds contained in the notice of opposition, and that APRA chose not to make any submissions to support those grounds. I awarded costs in the matter of the opposition to Wrangler.

Having so found in both matters, I now give my reasons for coming to such conclusions.

Extension of time

Submissions

Ms Baird went through the chronology of events which occurred between the dates of lodgment of the notice of opposition and the late lodgment of the application for the extension. She said that the Registrar should have regard in the present matter to the substance of the application and ignore any minor defects which might be present. She said APRA had been using its own similar mark on clothing in class 25 and outlined some details of such use on jeans. She said that the opposition was a serious one, as was obvious from the Ryan declaration lodged in support of the current application for extension. It involved APRA's extensive reputation in a common law mark. She said that the grounds of the opposition were based on s.24, that the mark was not distinctive of Wrangler, on s.28, that use of the mark by Wrangler would lead to deception and confusion, and on s.40, that Wrangler was not the proprietor of the mark.

Ms Baird said that the evidence, for which the extension to lodge had been sought, consisted of a Statutory Declaration by Stephen Michael Hilton which had been executed on 16 October 1996 and other evidence, including a declaration, by Mr Bob Berg, which would be served within the time sought to be extended. She said that the Ryan declaration showed that Biggs & Biggs had received no correspondence from Wrangler's attorneys and did not know whether the notice of opposition had been received. The first time that Mr Ryan had been aware of the present matter was when he had received the hearing notice from the Office in relation to the substantive opposition. She said that no special circumstances needed to be shown for the application being made late. Here, she said that she was relying on the decision in *Bernard Leser Publications Pty Ltd v Spiritual Sky Group Co Pty Ltd* (1985) 5 IPR 149, where it was said that there should be independent operation of reg.69 and s.130. Therefore, although an applicant for an extension of time under s.130 needed to justify the grant of an extension, special circumstances did not need to be shown merely because the application had been made late.

Ms Baird said that the issues to be considered were as set out in *Vangedal-Nielsen and Others v Commissioner of Patents and Another* (1980) 33 ALR 144 and which had more recently been listed in an Office decision, *The Australian Olympic Committee Inc v Brennan* 30 IPR 44. She said that these were, firstly, the length of time already allowed. The Hearing Officer in that case had said extensions of time of around nine months to serve such evidence were regular. In the present case, the application for registration had only been filed a year ago and appeared to have been accepted in less time than was normal. The notice of opposition had been lodged in April 1996 and no extensions of time to serve evidence had yet been allowed. Secondly, the seriousness of the opposition should be considered. She said that this had already been shown in the Ryan declaration, where the issues of disputed proprietorship, and deception and confusion had been raised. Much of the material to support these claims was in the material sought to be served by APRA. Ms Baird said that the Registrar should have regard to the public interest. She said that this would best be served by having all the relevant material before him or her before deciding the matter. In the present instance, the evidence to be served had been clearly defined and to grant the extension was not to

open the floodgates to a vast amount of material. Also, there was the possibility of deception and confusion arising if the mark was registered. This was an important consideration, and the obvious inexperience of APRA's solicitors in trade mark matters and their misunderstanding of Office procedures should not deny APRA the chance to submit its evidence. She said that the time now sought was not extensive and that its grant would not unduly inconvenience Wrangler who had, up until now, expended little energy in the matter. This should be compared with the inconvenience APRA would suffer if it was denied the right to serve its evidence. She concluded her submissions by seeking costs in favour of APRA in the matter.

I asked Ms Baird at this point why Biggs & Biggs had not replied to the various notices and letters sent by the Office during the period since the notice of opposition had been lodged and the present hearing. She said that she had no instructions on this except to point to the solicitors' inexperience in trade mark matters, especially the confusion caused by the coexistence of the 1955 and 1995 Acts. She submitted that there was certainly activity now, which demonstrated the seriousness with which APRA regarded the matter.

In reply, Mr Wilson said that it was inappropriate that the present extension sought be granted. He said that the relevant section which applied to the application was s.130. As this involved APRA seeking to have the Registrar exercise a discretion in its favour, then it was incumbent upon that party to give a good reason for seeking the extension. This, he said, it had not done. As the application had been made out of time, then the matter came under the provisions of reg.69. That regulation said that the Registrar needed to be satisfied that special circumstances existed which caused the application to be lodged out of time. He said that nothing had been put forward to show that there had been any of those circumstances present at the time of the application. He said that the leading decision in relation to this matter, which showed that these conditions should apply, was that made by Assistant Registrar Farquhar of this Office in *D'Urban Inc v Canpio Pty Ltd (1990)* AIPC 90-658. Mr Wilson said that, even if reg.69 did not apply, then at least some good reason should be shown by APRA as to why the application had been made late. Again, nothing had been put

forward to this effect, the only mention of such a situation being in the Ryan declaration, where he commented that the time had indeed passed.

Mr Wilson said that guidance in matters of applications for extensions of time under the *Trade Marks Act 1955* could be found in the Federal Court decision of *Lyons (trading as Mitty's Authorised Newsagency) v Registrar of Trade Marks* (1983) 1 IPR 416. There were some similarities between that case and the present instance, in that both of the applicants for extension were represented by solicitors and both had been made out of time. However, in *Mitty's* case an application to serve the evidence had been made only 10 days late. In the present instance, three months had passed before any action had been taken.

Mr Wilson said that the three principles, which arose from *Mitty's* case, to be applied in such applications for extensions of time, were whether the applicant had made out an adequate case as to why the time allowed had been insufficient, the balance of convenience between the parties if the application was refused, and that the public interest be best served. He said that, in the present instance, there had been no real case made out as to why the time which had so far elapsed had not been long enough for the evidence to be assembled and served. Additionally, no special circumstances had been put forward at all as to why the application had been made out of time. He said that there had been a long period of inactivity from Biggs & Biggs and APRA had not discharged the onus of showing why the initial three months, allowed in the legislation, had been insufficient to serve its evidence in support. In relation to the balance of convenience between the parties, Mr Wilson said that Wrangler had prepared itself for a hearing of the substantive matter and carried out all of the correct procedures, believing that the matter had reached that stage. Now, registration of its trade mark could possibly be further delayed if the extension was granted. He said that if the extension of time was refused and the case proceeded to registration, it was always open to APRA to challenge that registration in the courts. With regard to the public interest, he said that it would be better served if the matter was not prolonged; that was why time limits had been clearly set out in the regulations. He said that it was also not in the public interest if more and more evidence was always allowed, allowing matters to drag along indefinitely. He said that no matter which way

my decision went in the extension of time matter, costs should be awarded to Wrangler, given the inconvenience which it had suffered.

Reason for the Decision

Regulation 43 of the *Trade Marks Regulations* reads, inter alia:

43. An opponent shall-

- (a) serve on the applicant, within three months after the notice of opposition has been lodged at the Trade Marks Office, a copy of the declarations on which he relies in support of his opposition

Section 130 of the Act reads as follows:

Where, by this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

The extension in the present instance is sought from the Registrar under s.130 and it is "out-of-time". In such situations, contrary to Ms Baird's submissions, the Office does not now follow the decision in *Bernard Leser Publications Pty Ltd v Spiritual Sky Group Co Pty Ltd*, supra. As Mr Wilson correctly pointed out, such matters are now looked at as set out in *D'Urban Inc v Canpio Pty Ltd*, supra. Thus, whenever an application for an extension is made outside the time laid down in the regulations, reg.69 is now regarded as applying with full force to the consideration of that extension, even though the ultimate source of power to grant those extensions is in section 130.

Regulation 69 provides that:

An application for an extension of time under these Regulations shall be in writing and shall be lodged at the Trade Marks Office-

- (a) before the expiration of the time sought to be extended; or
- (b) if the Registrar is satisfied that special circumstances existed which prevented the application being made before that time, within such time as the Registrar allows.

Given that reg.69 is now triggered, the "special circumstances" mentioned in that regulation must be shown which are sufficient to satisfy the Registrar before s/he can favourably exercise his discretion. Only if those circumstances are shown to the Registrar's full satisfaction, can s/he further consider the matter of the extension itself. If that is successfully accomplished, the criteria used to decide the case would be the same as those at issue as in the *Lyons* case, supra. This means that the applicant for the extension must then discharge its onus of making out a proper case for the granting of the extension, and the Registrar should also consider the balance of convenience for both parties in allowing the extension and the public interest.

In *D'Urban Inc v Canpio*, supra, the facts at issue were of an initial misunderstanding as to the efficacy of service on a Document Exchange, followed by 14 months of inaction once the invalidity of that service was brought to the attention of the attorney concerned. In that case, although the extension was ultimately refused, Assistant Registrar Farquhar agreed that, as with the finding in *Genentech v Wellcome Foundation Ltd*, (1987-88) 11 IPR 401, reg 69 should be interpreted liberally.

In *Genentech*, supra, Supervising Examiner Roveta referred to *Jess v Scott* (1986) 70 ALR 185 as establishing that the modern interpretation of the expression "special circumstances" in the Patents regulations should be a liberal one. Mr Roveta noted, at p 405, after he had looked at relevant court decisions:

The point is that both courts appeared to take the view that the particular expression with which we are here concerned - even though, apparently, a somewhat more stringent requirement than that of the court rule - ought to be liberally interpreted by a tribunal so as not to let an appellant suffer unfairly.

Mr Roveta also concluded that

the word "prevented" ought to be given a broad meaning so as to give effect to the regulation in situations where the person concerned has failed to apply on time owing to some circumstance which has prevented the knowledge of the need to apply coming to that person's attention.

On consideration of those comments, Ms Farquhar, in *D'Urban*, supra, had formed the conclusion that reg.69 can be applied to remedy the consequences of "errors or omissions made by the applicant for extension, or by their agent". However, in the application of reg.69, *all* of the surrounding circumstances must be considered and the final question must be if, as a whole, there is anything about them that is "special".

Once the time set by the relevant regulation has passed, the onus on an applicant for an extension to justify the conduct that has caused it to need extra time is considerably increased. I have considered the complete lack of any reasons put forward by APRA in respect of the lateness of the application. As nothing was said about why the application was late, I cannot find that there was anything to constitute "special circumstances", for the purposes of reg.69, which prevented the application being made on time. The only factors which Ms Baird could suggest as being mitigating in this regard, were that the firm of solicitors representing APRA were inexperienced in the prosecution of trade mark opposition matters and that they misunderstood Office procedures. Consequently, they became confused as to the correct date that the evidence was to be served. However, the regulations are clear that the due date for service on an applicant of the evidence in support of an opposition is three months after the date of lodgment - a date about which there is no confusion. Additionally, several letters were sent by the Office to APRA's solicitors, Biggs & Biggs, either pointing to the provisions of s.43, advising that the evidence was overdue, and in the last instance, advising on 20 September 1996 that a hearing was to be held to decide the matter on 16 October 1996. Despite all of this, Biggs & Biggs did not do anything until immediately before the hearing in the substantive matter was scheduled to take place. Thus I cannot agree that the solicitors' inexperience, although perhaps contributing to the situation, is the prime reason for the application for service of the evidence being made late. I am of the opinion that the person in that firm who was responsible for the prosecution of

the case seems to have treated the matter without any degree of care or urgency once the mistake had been brought to their attention. A period of over three months had passed after the due date before an application for the extension was received by the Office on 15 October 1996. This was despite the fact that advice on the matter of the evidence in support had been drawn to the attention of APRA's representatives several times in letters or notices from the Hearings section of the Office. The only comment about the lateness of the application from Biggs & Biggs was in Mr Ryan's declaration that, "Unfortunately, the time...was allowed to pass without such evidence being filed," - a statement with which I concur. I am of the opinion that this is where APRA's case fails. In my estimation, the apparently lax prosecution of the matter by Biggs & Biggs on behalf of APRA amounts to, "...a mere casual regard for the times prescribed by the Act and Regulations" as outlined in *Bundy American Corp v Rent-a Wreck (Vic) Pty Ltd* (1985) 5 IPR 307, and distinguishes the present case from the liberal interpretation of "special circumstances" contemplated in *D'Urban*, supra. I feel that this was a mistake seemingly compounded by an indifferent approach to the timetable laid down in the regulations. In this instance then, I find that APRA has not discharged its onus of showing that "special circumstances" existed which prevented the application for extension being made on time.

It is unfortunate that APRA will be disadvantaged by the apparent inaction of its solicitors in the matter but I simply cannot find anything in the Declaration by Mr Ryan, or in the submissions by Ms Baird, which could lead me to the conclusion that special circumstances existed that precluded the application for the extension being lodged within the time specified. On the other hand, Wrangler has done everything that it could to bring the matter to a speedy conclusion and I do not think that such an eleventh hour attempt to prosecute the matter should cause it to be penalised by having the registration of its mark further delayed. I also think that it does not serve the public interest well if the smooth and orderly conduct of opposition matters is disrupted by the approval of an extension sought in such circumstances.

Accordingly, I refused the application for an extension of time to serve evidence in support and awarded costs in the matter to Wrangler.

Opposition

Submissions

As Ms Baird had withdrawn after I had refused the extension of time sought, it was left to Mr Wilson, on behalf of Wrangler, to continue in the matter of the substantive opposition. He said that, in the absence of any submissions on behalf of APRA's case or any evidence in support of its opposition, the matter should be decided strictly on consideration of its notice of opposition. He said that it was well established that the onus was on an applicant for registration to show why its mark should be registered, referring for support here to *Eno v Dunn* 7 RPC 311. However, he said that the onus fell on an opponent to substantiate its case in a matter where it was relying upon evidence of prior use or reputation, referring to the decision in *Arthur Fairest Ltd's App'n* (1951) 68 RPC 197. He said that, although it was the Registrar's practice, in a case where no evidence in support had been served, to allow an applicant the opportunity to lodge evidence in answer to an opposition, Wrangler had chosen not to take such a course in the present instance. This was because Wrangler felt that, here, there was nothing in the notice which required evidence to answer it.

However, because of the ultimate onus carried by Wrangler, Mr Wilson proceeded to address each of the paragraphs contained in Annexure A to the notice of opposition. He said that the mark, relied upon by APRA in its assertions of prior use and substantial reputation, was not identified and, in any case, there was no evidence to substantiate any such claims. Consequently, he said, the opposition must fail on these grounds. In any event, because of the Office's inference from the case law that s.28 should be read conjunctively, any opposition based upon that section of the Act in relation to alleged deception and confusion, must fail because it had not been established that Wrangler had been guilty of any blameworthy conduct. He said that any allegations of lack of capacity to distinguish must also fail. The mark had been accepted by the Registrar's delegate and nothing had been shown by APRA to the contrary. He concluded his submissions in the matter by seeking costs in favour of Wrangler.

Reason for the Decision

In coming a decision in the matter of the opposition, I have had to consider that the notice of opposition lodged was couched in terms of the *Trade Marks Act 1995* when it should have been made under the 1955 Act. However, as I said at the beginning of this document, it is possible to infer some grounds of opposition from the notice in terms of ss.24, 28 and 40 of the latter Act.

Section 24 (1) reads:

A trade mark is registrable in Part A of the Register if it contains or consists of-

- (a) the name of a person represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word;
- (d) a word not having direct reference to the character or quality of the goods or services in respect of which registration is sought and not being, according to its ordinary meaning, a geographical name or a surname; or
- (e) any other distinctive mark.

The basic requirement for the registration of any trade mark in Part A is that it is distinctive, i.e. adapted to distinguish the goods of its owner from the similar goods of other traders. The test as to whether or not a mark is adapted to distinguish is well established. If the mark is one which other traders would desire to use, without improper motive, upon or in connection with their own goods, then registration will generally be denied - *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511.

Nothing was put forward by APRA to support its assertion that Wrangler's trade mark is not adapted to distinguish its products from those of other traders. The application was examined and accepted by the Registrar's delegates with no objections. As there was no reason to overturn these actions I dismissed the opposition as it was based on this ground.

Section 28 reads:

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, on which APRA can be said to have relied, has been well established by cases such as *Southern Cross*, (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.

However, that risk must extend to a substantial number of people likely to be concerned in the purchasing of the goods: *Kendall Co v Mulsyn Paint and Chemicals* (1963) 109 CLR 300. Again, nothing was submitted by APRA to support its allegation that the use of the trade mark by Wrangler would be likely to deceive or cause confusion and there is no prima facie reason for me to have found that such was the case.

Additionally, as Mr Wilson pointed out, the Registrar now follows the practice as laid out in the decision of Hearing Officer Homann in *Titan Manufacturing Co Pty Ltd v Coyne* (1991) AIPC 90-808, which followed the Office's interpretation of the High Court decision in *New South Wales Dairy Corp v Murray Goulbourn Co-op Co Ltd* 18 IPR 385. This is that all paras of s.28 should be read together. This means that, had I found that the mark was likely to deceive or cause confusion, then it would also have been necessary to find that it would not have been entitled to protection in a court of law before an opposition could succeed under s.28. In any event, in the present case, I note that there is nothing before me to show that there has been any blameworthy conduct on the part of Wrangler, nor any other circumstance which would disentitle the mark to protection in a court of justice. I therefore found that the opposition had failed on both legs of s.28 and I accordingly dismissed the opposition as it was based on this ground.

Section 40(1) reads:

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

On that subject, McGarvie J said in the case of *Settef S.p.A. v Riv-Oland Marble Co (Vic) Pty Ltd* 10 IPR 402:

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)* 59 ALJR 77 at 83.

...

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* (1949) 78 CLR 601 at 625 and 627.

In other words, the first user of the mark in Australia - for the relevant goods and prior to the date of application - becomes the proprietor at common law. That proprietorship, however, is limited to "the same kind of thing", as per Holroyd J in *Hick's Trade Mark* (1897) 22 VLR 636. Any small amount of use will suffice, but the effect of the act relied on to constitute use must be the creation, in the minds of those concerned, of an impression that goods of a particular trader are being offered for sale in Australia. This has been affirmed in later cases such as in *Seven Up Co v O.T. Ltd* (1947) 75 CLR 203. There were no submissions made, or evidence in support lodged, to suggest that Wrangler did not first use its mark in this country and is therefore not the proprietor of the mark in Australia. I therefore dismissed the opposition on this ground.

Therefore, having found that APRA had failed on all of the grounds relied upon, I dismissed the opposition in its entirety and awarded costs in the matter to Wrangler.

Ian Forno
Hearing Officer

31 October 1996