



## TRADE MARKS ACT 1995

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

Re: Oppositions by Kevin John Mansfield to applications under section 92 of the Act by Rembrandt Suits Ltd to remove trade mark numbers 675261(25) - **ENDURANCE SPORTS MADE TO LAST** - in the name of Kevin John Mansfield

---

<b>DELEGATE:</b>	<b>Jock McDonagh</b>
<b>REPRESENTATION:</b>	<b>Opponent: none</b>
	<b>Applicant:</b> Janice Luck of Phillip Fox Lawyers
<b>DECISION:</b>	1. Trade Mark to be removed from Register 2. Costs awarded against opponent

---

#### Background

1. Trade mark registration 675261 is registered in the name of Kevin John Mansfield ("the opponent"). That registration has effect from 17 October 1995. It is for the trade mark ENDURANCE SPORTS MADE TO LAST, registered for the following goods:  
*All sports clothing, footwear and headgear in class 25*
2. On 13 August 2003, Rembrandt Suits Ltd, ("the applicant"), filed application for removal of the trade mark from the Register, on the basis of non-use in the period commencing three years and one month before the date of filing. This period, ("the relevant period"), is 13 July 2000 to 13 July 2003. The opponent filed Notice of Opposition to the application on 28 November 2003.
3. The applicant alleged that it was a "person aggrieved" within the meaning of the *Trade Marks Act 1995* ("the Act") and relied on section 92(4)(b) of the Act. The applicant alleged that the opponent had not used the trade mark or not used the trade mark in good faith during the relevant period.
4. In turn, the opponent alleged in the Notice of Opposition that the trade mark had been used by the opponent in Australia and used in good faith in Australia during the relevant period.

5. The matter came before me as a delegate of the Registrar of Trade Marks for hearing in Melbourne on 17 February 2005. The removal applicant was represented by Ms Janice Luck of Philip Fox Lawyers of Melbourne.
6. The opponent was not represented at the hearing.

### **Legislation**

7. Section 92 of the Act 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.

Note: For *prescribed court* see section 190.

- (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.

8. There are a number of elements of s.92 that must be satisfied before the Registrar will exercise her 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.
9. The application alleges that the applicant is aggrieved by the registration of 675261 ENDURANCE SPORTS MADE TO LAST. The standing of the applicant has not been disputed by the opponent.
10. 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.
11. In the present case, the only contentious issue is (d), namely, whether the applicant is correct in its assertion that section 92(4)(b) has been satisfied.

### **The Evidence**

12. Details of the evidence is shown in the following table:

<b>Declarant</b>	<b>Date declared</b>	<b>Exhibits</b>	<b>Known As</b>
<i><b>Evidence in Support</b></i>			
Kevin John Mansfield	23.02.04	A to C	Mansfield 1
Kevin John Mansfield	26.02.04	A	Mansfield 2
<i><b>Evidence in Answer</b></i>			
Brian Martin	16.08.04	A and B	Martin 1
Karen Joy Martin	16.08.04	A	Martin 2
Craig Raymond Douglas	25.08.05	CRD1 to CRD9	Douglas

### **Use During Relevant Period**

13. The relevant legislation is contained in of section 100 of the Act. The relevant parts state:

100(1) In any proceedings relating to an opposed application, it is for the opponent to rebut:

...

- (c) any allegation made under paragraph 92(4)(b) that the trade mark has not, at any time during the period of 3 years ending one month

before the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services.

...

- (3) For the purposes of paragraph 1(c), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time during the period referred to in that paragraph, been used, or been used in good faith, by its registered owner in relation to the relevant goods and/or services if:
  - (a) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by its registered owner in relation to those goods or services during that period

14. The use must be genuine commercial use in accordance with the test in *Imperial Group Ltd v Philip Morris & Co* [1982] FSR 72. A single bona fide use of the mark in the relevant period is sufficient to resist an application for removal: *Woolly Bull Enterprises Pty Ltd v Reynolds* [2001] FCA 261 ("*Woolly Bull*") at paragraph 17. However, Wilberforce J, in *Nodoz Trade Mark* (1962) RPC 1 at 7, said that if a registered owner relies on one single act of use of the mark, then that single act ought to be established by "if not conclusive proof, at any rate overwhelmingly convincing proof."
15. It should be noted that mere assertions of use without documentary support are generally given little weight: *Great White Shark Enterprises Inc v Joose Apparel Pty Ltd* (1998) 41 IPR 208, *Steen Petersen v Daniel Baden and Garth Harris* [2003] ATMO 83.
16. Mr Mansfield's evidence in support consists of declarations made by himself. In Mansfield 1, Mr Mansfield declares that in March 1997 he authorised Tony Benza, trading under the name Body Power Australia ("the licensee ") to use the trade mark and that "such use by the licensee has been continuous and consistent from that date up to including the present, and extends to use on the products themselves and on invoices issued by the licensee in respect of sales of clothing and accessories, including shorts, tops, caps, belts and wrist bands." Exhibits A, B and C of Mansfield 1 and Exhibit A of Mansfield 2 contain material alleged to substantiate this use.
17. Apart from Exhibit C to Mansfield 1, the exhibits do not provide any evidence of the date the products depicted were purportedly offered for sale, sold or otherwise

distributed or promoted or, in most cases, when the photographs of the products depicted were taken. Further, Exhibits A and B of Mansfield 1 do not relate to goods covered by the registration.

18. Exhibit C to Mansfield 1 is stated to contain samples of some of the invoices issued for sale of clothing accessories bearing the trade mark from 2002 to 2003. The exhibit contains nine invoices. These invoices are curious in that, although they span a period of three years, they are numbered consecutively 31 to 39 and account for only a small proportion of the allegedly more than 400 units of clothing and accessories stated to be sold annually under the trade mark. Further, the invoices do not satisfy the requirements of tax invoices under GST legislation and invoices marked as “on consignment” do not show the price of goods.
19. Of the nine invoices, two do not relate to goods subject to the registration and two fall outside the relevant period.
20. Only one of the remaining invoices contains reference to the trade mark. This invoice refers to “4 XL Endurance Training Tops”. In the two Martin declarations, the proprietors of the business that allegedly received these goods deny selling sports clothing bearing the mark or being able to locate any documentary evidence relating to the transaction.
21. The Douglas declaration is made by a private inquiry agent who attended the premises of the businesses that allegedly received the goods subject to the remaining invoices. The evidence is to the effect that it is unlikely that relevant goods bearing the trade mark were supplied during the relevant period.
22. I note also that the opponent did not provide any documentary evidence to support his assertion in paragraph 4 of Mansfield 1 that there was a written agreement between the opponent and Mr Tony Benza authorising Mr Benza to use the opponent's mark.
23. The opponent did not provide any evidence in reply. Without evidence to explain the deficiencies in the evidence in support of the opposition that are quite clearly illustrated by the applicant's evidence in answer, I cannot be satisfied that the opponent has discharged the onus to prove that it has used the trade mark during the

relevant period. Accordingly, I am not satisfied that the opponent, or an authorized user, has used his registered trade mark. I dismiss this ground of opposition.

## **Registrar's Discretion**

### **Determination of opposed application—general**

**101. (1)** Subject to subsection (3) and to section 102, if:

- (a) the proceedings relating to an opposed application have not been discontinued or dismissed; and
- (b) the Registrar is satisfied that the grounds on which the application was made have been established;

the Registrar may decide to remove the trade mark from the Register in respect of any or all of the goods and/or services to which the application relates.

**(2)** Subject to subsection (3) and to section 102, if, at the end of the proceedings relating to an opposed application, the court is satisfied that the grounds on which the application was made have been established, the court may order the Registrar to remove the trade mark from the Register in respect of any or all of the goods and/or services to which the application relates.

**(3)** If satisfied that it is reasonable to do so, the Registrar or the court may decide that the trade mark should not be removed from the Register even if the grounds on which the application was made have been established.

24. In deciding an opposed removal application, the Registrar is called on to exercise a discretion: the Registrar "may" remove a registration or "may" decide that the trade mark should not be removed even if the grounds for removal have been established. The proper exercise of that discretion by the Registrar will generally be as per *Ritz Hotel v Charles of the Ritz* (1988) 12 IPR 417, at 482:

If the condition of exercise of the court's power has been established, the entry of the mark should be expunged, or the mark should be removed, as the case may be, "unless sufficient reason appears for leaving it there: cf Application by *Carl Zeiss Pty Ltd* (1969) 122 CLR 1 at 11 and *Astronaut* trade mark [1972] RPC 655 at 672.

25. What constitutes "sufficient reason" has been enunciated by Deputy Registrar Hardie in *Figgins Holdings Limited v Beltrami SpA* (1998) 46 IPR 411, at 418:

Under subsection 101(3) the Registrar needs to be "satisfied that it is reasonable" to leave a mark on the Register even when the grounds on which the removal application is made have been established. This requires the Registrar to be satisfied that there is sufficient reason for leaving it there. The reason would need to be based on special facts and circumstances, or an overriding question of public interest. The onus for showing that those circumstances exist is on the opponent to the removal application.

26. I have had regard to the evidence served in this matter and to the submissions made by the solicitor for the applicant at the hearing in deciding, as the delegate of the

Registrar, whether there is sufficient reason to leave the present trade mark on the Register.

27. I am not satisfied on the evidence and submissions before me that there are any special facts and circumstances, or an overriding question of public interest.

**Conclusion and Costs**

28. I find that the opponent has not discharged the onus placed on him under the *Trade Marks Act 1995* of showing why trade mark registration number 675261 ENDURANCE SPORTS MADE TO LAST should not be removed from the Register on the grounds of non-use during the period in question.
29. Therefore, I dismiss the opposition and direct that registration number 675261 ENDURANCE SPORTS MADE TO LAST be removed from the register unless, within one month from the date of this decision, the Registrar is served with a copy of a notice of appeal. If the Registrar is so served, I direct that removal shall not occur until the appeal has been decided or discontinued.
30. As to costs, I see no reason why costs should not follow the event. I direct that the opponent pay the costs of the applicant in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations 1995*).

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
20 May 2005