



## TRADE MARKS ACT 1995

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

Re: Opposition by Fiskars Inc to an application under section 92 of the Act by Roy Gripske & Sons Ltd to remove trade mark number 707010(8) - **GATOR BLADE** - in the name of Fiskars Inc

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<b>DELEGATE:</b>	<b>Rachel Dunn</b>
<b>REPRESENTATION:</b>	<b>Opponent</b> Catherine Hustwick of Madderns <b>Applicant</b> Elisa McCutcheon of Cullen & Co
<b>DECISION:</b>	<b>Registration limited to the goods of “Garden shears including hedge shears and grass shears”.</b>

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#### **Background**

1. Trade mark number 707010 is registered for the word trade mark:

### **GATOR BLADE**

2. The registration is in class 8 of the *International (Nice) Classification of Goods and Services*, for “Manually operated lawn and garden tools, including hedge shears and grass shears”. The date of registration is 23 April 1996, and the trade mark owner is Fiskars Inc.
3. Roy Gripske & Sons Ltd (the removal applicant) made an application under section 92 of the *Trade Marks Act 1995* (the Act), for removal of the trade mark from the Register on 7 February 2003. The removal applicant amended this application on 14 February 2003, and the action then proceeded pursuant to s92(4)(a) and (b). The application was advertised for opposition purposes in the *Australian Official Journal of Trade Marks* dated 6 March 2003. On 4 June 2004 notice of opposition was filed by the trade mark owner, Fiskars Inc (the opponent).

4. The period of time covered by the removal application (relevant period) in terms of paragraph 92(4)(b) is 13 January 2001 to 13 January 2003.

### **Application for removal**

5. The grounds cited in the removal application are those set out in paragraphs 92(4)(a) and (b) of the Act:

(a) That, on the day on which the application for the registration of the trade mark was filed, the applicant for registration has 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.

6. The removal applicant indicated that it was aggrieved by the opponent's registration, and that removal was sought for all the goods covered. Two statutory declarations by Elisa McCutcheon, from the removal applicant's legal firm Cullen & Co, accompanied the removal application. In the declarations Ms McCutcheon stated that she had made investigations into the use of GATOR BLADE and that it appears that the opponent has not used the trade mark in the Australian marketplace.

### **Notice of opposition**

7. The opponent responded in its notice of opposition that:
  - When the trade mark was filed the applicant had an intention in good faith to use the trade mark GATOR BLADE in Australia

- In the relevant three year period, the trade mark GATOR BLADE has been used in Australia in relation to the goods for which it is registered.

## **Evidence**

### *Evidence in support*

8. The evidence in support consists of a statutory declaration in the name of Alf Peter Niclas Naes, the opponent's marketing manager, and three exhibits. Mr. Naes states that goods being hedge shears and grass shears have been sold under the trade mark GATOR BLADE in Australia since at least 1999. Sales figures for the years of 2001, 2002 and the year to date of 2003 have been given. The first of the exhibits is a catalogue, entitled "Fiskars Australia 2001 Lawn and Garden Catalogue". The catalogue shows use of the trade mark for the goods of hedge shears and grass shears and is clearly dated for use in 2001 - within the relevant period. The two remaining exhibits show labels for hedge shears and grass shears bearing the GATOR BLADE trade mark, however these are undated and do not add to the opponent's case of proving use within the relevant period.

### *Evidence in answer*

9. The evidence in answer consists of two statutory declarations and four exhibits. Paul Gripske, director of the removal applicant, makes the first statutory declaration and it attests to the lack of any use, or use in good faith, of GATOR BLADE on any goods other than those of hedge shears and grass shears. Elisa McCutcheon makes the second statutory declaration. Ms McCutcheon attests to the removal applicant's status of a person aggrieved and explains the history of the removal applicant's trade mark application for the term GATOR MULCHER and the fact that other GATOR trade marks currently co-exist on the Register. She mentions that the United States registration for GATOR BLADE is effectively only covering the goods of hedge shears and grass shears, and no use in Australia can be found for GATOR BLADE products other than hedge shears and grass shears. The exhibits show other traders in Australia using GATOR trade marks, the opponent's United States' trade mark registration and other GATOR trade marks on the United States' register. United States' Trademark Law showing that trade marks can only be renewed in the United States for the goods that the trade mark is actually being used for, is also exhibited.

## **Hearing**

10. The opponent then requested a hearing, which was held in Canberra before me, as delegate of the Registrar, on 24 June 2004. Ms Catherine Hustwick, of Madderns Patent and Trade Mark Attorneys represented the opponent. The removal applicant was represented by Ms Elisa McCutcheon of Cullen & Co.

## **Removal applicant's standing as a person aggrieved**

11. The removal applicant's standing as a person aggrieved in this matter was never contested by the opponent. Section 92(1) of the Act requires a removal applicant to be a "person aggrieved". In its application for removal, the applicant has asserted that it is aggrieved by the registration of 707010 and this assertion is substantiated by Ms McCutcheon's declaration which constituted part of the evidence in answer.
12. I am satisfied that the applicant is a person aggrieved.

## **Use During Relevant Period**

13. The relevant legislation is contained in section 100 of the Act. In brief the Act says that in any proceedings relating to an opposed application, it is for the opponent to rebut the allegations made under paragraphs 92(4)(a) and (b). The opponent is taken to have rebutted the allegations if it establishes that the trade mark in question, without substantial alterations, has been used or used in good faith. Alternatively, if it is established that circumstances were an obstacle to the use of the trade mark during the relevant period, the opponent may still rebut the allegations even though the trade mark may not have been used at all.
14. *Woolly Bull Enterprises Pty Ltd v Reynolds* [2001] FCA 261 allows a single bona fide use of the trade mark in the relevant period to defeat an application for removal. The use must be genuine commercial use in accordance with the test in *Imperial Group Ltd v Philip Morris & Co* [1982] FSR 72.
15. I am satisfied that there has been genuine commercial use of GATOR BLADE in Australia within the relevant period for the goods of hedge shears and grass shears. Thus, the removal application has failed for the goods of hedge shears and grass

shears, however for the remaining part of the specification - manually operated lawn and garden tools - no use has been shown.

16. Both parties made submissions in relation to what should occur to the goods upon which use has not been shown. The opponent contests that use on hedge shears and grass shears can be justifiably interpreted as being use of the trade mark in respect of "manually operated lawn and garden tools" and that the specification should remain in its entirety. The opponent relies upon the case of *McHattan v Australian Specialised Vehicle Systems Pty Ltd and Another* 34 IPR 537, wherein Drummond J indicated that distinctions can be too finely drawn between goods that use has been shown for and goods that are similar. For example, use on the goods of a sedan motor car should equate to use on a utility motor car, and use on armoured military vehicles over 8 tonnes is the same as use on smaller armoured military vehicles. The case of *Kefir Culture Natural Pty Ltd V Société Des Produits Nestlé Sa* 58 IPR 644 was also cited. In that case use had been shown for the goods of sachets of kefir granules, however the whole specification of "Kefir and yoghurt; drinks comprising kefir and yoghurt, not being drinks included in other classes" was allowed to remain on the Register.
17. The removal applicant submits that the registration should be restricted to accord exactly with the evidence of use. It further submits that use on a narrow range of goods does not constitute use on all of the significantly broader range of goods covered by the registration, and points to the case of *Gordon & Rena Merchant Pty Ltd v Ocky Docket (Australia) Pty Ltd* 24 IPR 357, in which the specification was limited to shorts and t-shirts, to illustrate this stance.
18. I do not believe that use on two lines of goods, grass shears and hedge shears, equates to use of the specification "manually operated lawn and garden tools" in its entirety, and I reject the view that this registration should remain in its present form. After considering the arguments of both parties the cases to which they have referred me, I have come to the conclusion that the specification should be limited to read "Garden shears including grass shears and hedge shears".

### **Discretionary power**

19. The opponent has submitted that if I come to any conclusion that limits the goods of its registration, it would be proper for me to exercise the discretion allowed pursuant

to subsection 101(3) of the Act and retain the present registration. It is suggested by the opponent that such discretion should be used in order to remove any likelihood of deception or confusion arising from the use of the same or similar trade marks by other traders with respect to closely related goods. The removal applicant submits that use of such discretion requires special facts and circumstances or an overriding question of public interest, as found in *Ritz Hotel Ltd v Charles of the Ritz Ltd* (1988) 12 IPR 417. They further submit that such terms are not present in this case.

20. I find there is nothing before me to constitute a significant risk of deception and confusion, no special circumstances that hindered use of the trade mark on the entire broad range of goods, and nothing to suggest that the public interest lies in the preservation of this registration in its entirety. There is no evidence before me to suggest that the opponent would ever extend the GATOR BLADE trade mark from the goods of garden shears to its other lines of bladed tools such as tree pruners, let alone its broader range of tools including axes, hoes and weeders encompassed in its current specification. I direct that trade mark number 707010 be removed from the Register for all goods in class 8 other than:

Garden shears including hedge shears and grass shears.

The removal of the goods will proceed after one month from the date of this decision. If the Registrar is served with a notice of appeal before that time, I direct that the removal will not take place until such time as that appeal is decided or discontinued.

### **Costs**

21. Both parties sought costs. As the removal applicant in this case has not been totally successful, it could be seen as fair and appropriate in all circumstances to allow each party to bear its own costs. However, there is information before me that allows diversion from this path.
22. On December 31 2003 the removal applicant requested an amendment to its removal application, so as to allow the goods of “hedge shears and grass shears” to remain on the register. The opponent disagreed with this proposal and the amendment was not allowed by this office, however the offer had been made. The removal applicant also offered to settle the matter, suggesting that a restriction of the goods to “hedge shears

and grass shears” would allow for withdrawal of the removal application. Whilst this offer was made only in the week before the hearing, and was dismissed by the opponent as being a limitation it could not live with, again the offer was made.

23. The removal applicant attempted to minimize costs and hoped to avoid a hearing in this matter, albeit on its own terms. Additionally, Fiskars Inc as registered owner is answerable for the fact that it applied to register GATOR BLADE for a wide statement of goods and, as far as I can judge on the material presented, there was an absence of any real intention to use the trade marks for anything other than garden shears. In the circumstances, I think it appropriate that Fiskars Inc pay half of the costs of Roy Gripske & Sons Pty Ltd, in the amounts provided for in Schedule 8 of the Trade Marks Regulations, and I make this direction accordingly.

Rachel Dunn  
Senior Examiner  
Trade Marks Hearings  
31 August 2004