



TRADE MARKS ACT 1995

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

Re: Opposition by Amalgamated Television Services Pty Limited to the registration of trade mark application number 714818 in the name of Sylvia Margret Clissold for the word trade mark **HOME AND AWAY** in Class 3

Background

Application number 714818 was filed on 9 August 1996, in the name of Sylvia Margret Clissold (the applicant). The application was for the registration of the trade mark:

*Home
and
Away*

covering the statement of goods, "Dentifrices, soaps, perfumery, essential oils, cosmetics, hair lotions" in Class 3. Subsequent to examination, the trade mark was advertised as accepted in the *Australian Official Journal of Trade Marks* of 10 April 1997.

A notice of opposition to the trade mark's registration was filed by Amalgamated Television Services Pty Limited (the opponent), on 10 July 1997. That notice listed a number of grounds, all of which the opponent pursued at the hearing. These were, in order of submission at the hearing, under ss. 58, 59, 60, 41, 42, 44, 43, and 55. Accordingly, these grounds are the subject of this decision and the reasons for it.

The opponent requested a hearing in the matter and it came before me, as a delegate of the Registrar, in Sydney. At the hearing, the opponent was represented by Ms

Kerry Moore Chrysiliou of Chrysiliou Moore Martin. Appearing on behalf of the applicant was Ms Annette Freeman of Spruson & Ferguson.

The Evidence

The evidence in support comprises a declaration by Catherine Rothery, Legal Counsel of the opponent, who declares as to the history of the television series HOME AND AWAY in Australia and overseas. She lists several trade marks, registered by the opponent for the words HOME AND AWAY, in various classes, including 41, 28, 25, 16, 30 and 9. She discusses the use of the expression in the merchandising of goods in connection with the promotion of the series since 1988 and attaches, as exhibits, a selection of such items distributed in Australia, including various articles of clothing, brochures, a CD and a video. She gives retail figures for merchandise sold in Australia and overseas under the marks, and also lists and exhibits examples of media articles which feature the words.

The applicant's evidence in answer comprises a declaration by Sylvia Clissold, the applicant for registration. Ms Clissold gives details of several internationally registered trade marks owned by her, comprising the words HOME AND AWAY, including one Australian registration, number 662617 in Class 5 for the goods, "Disinfectant sanitary product". She outlines the reasons for her coining of the mark and the history of her use of it on that product. She further declares as to searches that she conducted of the IPAustralia trade marks database for the mark in Classes 3 and 5 which, she says, did not reveal any other applicants or registered owners of the marks. She annexes, as exhibits, copies of Australian and international registration certificates for the mark.

The evidence in reply comprises a declaration by Jack Lloyd, a Director of In Character Pty Ltd, a company which locates licensees for principals wishing to merchandise their trade marks in Australia. He gives his professional opinion regarding the merchandising of marks in relation to films or television shows, saying that the most common categories sold in relation to such a practice are toys, clothing, stationery, posters and books. He says, however, that it is not unusual for such merchandising to extend to personal items such as soaps, perfumery, oils and cosmetics, particularly when a show is directed to a youth market such as the

opponent's television series, and that he would believe that this was the case if he saw that mark upon such items.

Submissions

I will attempt to present here a brief summary of the main points made by both sides during their extensive submissions in relation to all of the grounds contained in the notice of opposition.

In relation to the s.58 ground, Ms Moore Chrysiliou said that the mark HOME AND AWAY had been used by the opponent in relation to the television series since 1988, well before the present priority date, on t-shirts, caps, umbrellas, key-rings and compact discs. She said that these goods could be considered the "same kind of thing" as those covered by the present application, relying for support here upon such precedent as *Hicks' case* (1897) 22 VLR 636, *Settef S.p.A. v Riv-Oland Marble Co (Vic) Pty Ltd* 10 IPR 402 and *Prestige v Potter & Moore Ltd* (1939) 9 AOJP 3311.

On the s.59 ground, she said that, whilst it was difficult for the opponent to establish this ground, the applicant had done nothing to rebut the allegation of non-use, had not expressed an intention to use the trade mark upon the nominated goods and had presented no evidence of use.

Ms Moore Chrysiliou said, with regard to the s.60 objection, that the marks in suit here were virtually identical, and that the opponent had widely used its mark on a variety of services and associated goods since 1988 - well before the priority date of the present application. She said that the evidence showed that the opponent had a wide reputation for its mark, especially amongst younger people, who were well aware of the practices of marketing and licensing. She said that such a knowledgeable market would expect that there was a connection between the show associated with the opponent's mark and the kind of goods used in merchandising or licensing of like entertainment. She relied for support here upon such precedent cases as *Radio Corporation Pty Ltd v Disney* (1937) 57 CLR 448 and *NBA Properties Inc v Gaunt* (1999) 44 IPR 225 (the RAPTOR PIZZA case). She submitted that the Registrar should be able to take judicial notice of the renown of the HOME AND AWAY television series. Although the applicant had made much of its registration of the words HOME AND AWAY for Class 5 goods, such items were not of the type

usually used in merchandising. She said that no Class 3 goods had yet been sold by the applicant and it could not claim any reputation in such goods, relying again for support here on the RAPTOR PIZZA case, supra. She said that the applicant had not served any evidence to dispute the s.60 ground of the opponent's opposition, thereby strengthening the opponent's case - *Fletcher Challenge Ltd v Fletcher Challenge Pty Ltd* [1981] 1 NSWLR 196.

She said that, relative to the s.41 ground of opposition, because of the renown which the opponent had in its trade mark HOME AND AWAY, the applicant's mark comprising the same phrase was not capable of distinguishing the applicant's goods

On the s.42(b) ground, Ms Moore Chrysiliou submitted that the use of the opposed trade mark would be contrary to the consumer protection provisions of the *Fair Trading Act 1997 (New South Wales)* and also s.120(3) of the *Trade Marks Act 1995*.

On the s.44 ground, she said that the applicant's trade mark and opponent's registered mark, number 494510, are virtually identical and that the Class 25 goods of the latter mark are goods which are closely related to those of the present application. She said that this was because both sets of goods were used in relation to the beautification of the person and also could be used in relation to the promotion of a television show. She pointed to the *Hicks'* and *Prestige v Potter & Moore Ltd* cases, both supra, to support her arguments here.

In relation to the s.43 ground, she submitted that because of the fame of the opponent's mark, then the use of the applicant's mark would lead to deception or confusion because of the connotation that there was some sponsorship, approval or connection with the makers of the opponent's television show - which did not exist. She said that this could be exacerbated by the inference which could be drawn by the public that the opponent accepted or selected the quality of the products sold under the applicant's mark. She submitted that the applicant could have chosen the words AWAY AND HOME for her mark if her intention was not to trade upon the opponent's renown. However, she had chosen not to. Ms Moore Chrysiliou pointed to the Office decision, *Down To Earth (Victoria) Co-Operative Society Ltd v Schmidt* (1998) 41 IPR 632, (the EARTHAVEN CONFEST case) as an authority for her submissions here.

Ms Moore Chrysiliou finalised her submissions by saying that the Registrar, in the exercise of his discretion under s.55, ought to refuse to register the applied for mark for several reasons including: the opponent's reputation in its own mark; the lack of evidence of use of the present mark; the inconvenience to the opponent in its merchandising if the present mark was registered, versus the relative lack of bother to the applicant in choosing a new mark; the possibility of the applicant preventing the use of the opponent's promotional activities using its own mark; and the negative publicity and financial damage to the opponent stemming from the misuse of the mark by the applicant.

She closed her submissions by seeking costs in favour of the opponent.

Ms Freeman commenced her submissions on behalf of the applicant by giving the background of that party's choice and use of the trade mark, first on Class 5 goods and then in relation to this application in Class 3. She said that the applicant had adopted the mark honestly, particularly given that her search of the Trade Marks Office records had not revealed any applications or registrations of these words in either of Classes 3 or 5.

Ms Freeman discussed various aspects of the evidence, saying that the opponent's Rothery declaration was deficient in that it was not supported by any ratings or survey documentation in that party's claims as to the renown or success of the opponent's television programme. She said that this case could be distinguished in this regard from that of *Twentieth Century Fox Film Corporation & Anor v South Australian Brewing Co Ltd & Anor* (1996) 34 IPR 225 (the DUFF BEER case). She said that, despite the evidence showing that the opponent's show was broadcast in the UK, US and New Zealand, the respective marks had coexisted in those markets with no problems. She discussed the opponent's evidence of merchandising, saying that it was limited to only certain goods not related to Class 3 and it was unclear as to the amount of Australian use. She disputed that the Lloyd declaration constituted evidence in reply to the evidence in answer, saying that it introduced new material and opinion. She referred to several cases to support her contention here, including *Legal and General Life of Australia Limited v Carlton-Jones & Associated Pty Ltd* (1986) AIPC 90-268

On the s.58 ground, Ms Freeman conceded that the respective marks were so similar as to be virtually the same mark. However, she said that the applicant was the owner of the mark applied for here, as regards Class 3 goods, when the tests cited in *Shell Co. (Aust.) Ltd v Rohm and Haas Co.* (1949) 78 CLR 601 were applied. She said that the applicant's personal care products and the clothing sold by the opponent were not the "same kind of thing", as contemplated in *Hicks'* case, *supra*.

As far as the opponent's case that the applicant had no intention to use her mark, Ms Freeman said that there was no evidence to support that claim and that there was an onus on the opponent to show any absence of intention.

On the s.60 ground, Ms Freeman said that, as at the date of filing, the opponent had only sold some of the goods which it had claimed as being part of its merchandising campaign, which could only be described as "minimal" at best. She said that there was not enough evidence to establish that the television series was so famous as to establish a likelihood of confusion occurring following the use of the applicant's mark on her completely different Class 3 goods. She said that any reputation in the opponent's mark was limited to the series, that it did not extend to the present goods and that it was really a question of whether sufficient people would be misled as to origin - especially given that there was no reference to the opponent's show, or to any of its characters, on the applicant's packaging. She argued that all of the surrounding circumstances should be considered in determining any deception or confusion - *Jafferjee v Scarlett* (1937) 57 CLR 115, and that there would not be any reasonable likelihood of these occurring if the mark was used in a normal and fair manner. She said that there needed to be a real tangible danger of deception and confusion occurring, not just a mere possibility - *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592. She continued that the applicant had no wish to associate her products with the opponent's television show, and that the opponent did not have universal rights to the words HOME AND AWAY as a trade mark for all goods. She said that the applicant had already used the mark on Class 5 goods intended to maintain hygiene and, as the Class 3 goods here were also used for the same purpose, then there was a nexus between those goods which was far closer than might be between the present goods and the clothing sold by the opponent.

Ms Freeman said, on the s.41 ground, that the inherent registrability of the mark had not been put into doubt by any of the opponent's evidence and that no objections on this ground had been raised during examination.

She said that the opponent had not been able to support its claim that the use of the mark by the applicant was contrary to law. She said that the mark had not yet been used by the applicant on the Class 3 goods and so there could be no substantiated allegations of passing off or infringement.

In relation to the ground that the present mark offended under s.44, Ms Freeman said that, although the applicant's and the opponent's registered marks were substantially the same, the applicant's Class 3 goods were not similar to the opponent's Class 25 goods, or to any of the other goods covered by its registrations. She referred for support here to the tests laid down as a guide to determine this in *Jellinek's App'n* (1946) 63 RPC 59.

On whether the opposition succeeded on the s.43 ground, Ms Freeman said that there had to be a connotation within the subject mark itself which might cause deception and confusion through its use. She said that there was nothing in the present mark which might cause such things to occur. She referred for support here to the words of the Hearing Officer in *Intel Corporation v Magratex International Pty Ltd* (1998) 41 IPR 406 at 413-414.

Regarding the opponent's argument that the Registrar should use his discretion adversely by refusing registration here, Ms Freeman said that this was not warranted. She said that the inconvenience to the opponent would be minimal, whereas that caused to the applicant would be significant, especially given that she had been working on her goods since 1966.

Analysis

As I have previously stated, in giving the reasons for my decision in this opposition matter, I will deal with the grounds of opposition in the order pursued by Ms Moore Chrysiliou at the hearing.

Section 58

This section reads:

58. The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

The term "owner" in the *Trade Marks Act 1995* equates to that of "proprietor", as referred to in the *Trade Marks Act 1955* - see p.2 of the *Readers Guide* to the 1995 Act. The initial onus, with respect to ownership, is on the applicant for registration. As is stated in s.27 of the Act:

27.(1) A person may apply for the registration of a trade mark in respect of goods and/or services if:

- (a) the person claims to be the owner of the trade mark; and
- (b) one of the following applies:
 - (i) the person is using or intends to use the trade mark in relation to the goods and/or services;
 - (ii) the person has authorised or intends to authorise another person to use the trade mark in relation to the goods and/or services;
 - (iii) the person intends to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods and/or services.

As Ms Freeman submitted, ownership of a trade mark depends on a combination of authorship and first use and, as per *Shell Co. (Aust.) Ltd v Rohm and Haas Co.*, supra, may be claimed either on being the first user of the trade mark in Australia, in relation to the nominated goods or services, or on the basis of the making of an application for registration. 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 the goods of a particular trader are being offered for sale, in this country, under the trade mark. The applicant here has certainly been the first to apply for the mark in Class 3 in Australia and it is implicit, from its application, that it intends to use the mark - if it does not already do so. It has thus satisfied the onus upon it and that onus shifts to the opponent to show that it is not the case.

The dispute of a claim to ownership of a mark can only proceed to be considered where the opponent can also show that the word or words it relies upon as being owned by itself or another person is substantially identical with the mark, the subject of the application for registration. As Gummow J. said in *Carnival Cruise Lines Inc v Sitmar Cruises Ltd.* (1994) AIPC 91-049 at 38,114, when referring to the concept of

proprietorship in the *Trade Marks Act 1955*, and to *Shell Co. (Aust.) Ltd v Rohm and Haas*, supra:

[*Shell v Rohm and Haas*] does not supply any general authority for the proposition that in the case of disputed claims to proprietorship under the present statute anything less than substantial identity between the two marks will suffice. The phrase "substantially identical" was discussed by Windeyer J. in *The Shell Company of Australia Limited v Esso Standard Oil (Australia) Limited* (1961-1963) 109 CLR 407 at 414.

Here, the applicant's and the opponents trade marks are so close as to be clearly substantially identical with each other and so the first leg of this opposition ground has been established.

However, a claim disputing ownership of particular goods or services is limited to "the same kind of thing" - as per Holroyd J in *Hicks'* case, supra. The present application covers the goods, "dentifrices, soaps, perfumery, essential oils, cosmetics, hair lotions ", while the opponent has claimed use, prior to the application date here, on different goods comprising clothing, umbrellas, key-rings and compact discs. Ms Moore Chrysiliou has claimed that both sets of goods are the same kind of thing because they could possibly be used in merchandising campaigns and relied upon the decision in the RAPTOR PIZZA case, supra, for support. However, nothing was decided there, in relation to goods being the same for the purposes of disputed ownership, and I think it is drawing a long bow to say that two sets of physically unlike goods can be considered the same merely because they could both be sold in promoting a television show. I therefore consider that the respective sets of goods are not the same, as contemplated in *Hicks'* case, supra.

Accordingly, I find that the opponent is unsuccessful on this ground of its opposition.

Section 59

This section reads:

59. The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) 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 specified in the application.

Ms Moore Chrysiliou has said that the applicant had failed to rebut the allegation of a lack of intention to use the mark and had also not explicitly stated such an intention. However, the applicant, by applying for the trade mark, has made the claim that at that time, she was using, or intended to use, the trade mark on the nominated goods or services - see s.27(1)(b) of the Act, as laid out earlier in the reasons for this decision. It follows that the Registrar, by accepting the application for a trade mark under s33 of the Act, was prima facie satisfied that there existed such an intention to use the trade mark on the goods applied to be covered. For an opposition to be successful on this ground, the Registrar must be convinced that the applicant did not have an intention to use the trade mark as at the date of opposition.

The opponent has not done anything to show the applicant's intentions were other than to use its mark, as at the date of opposition, and I therefore must find that the opposition does not succeed under this section.

Section 60

This section reads:

60. The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

I have already found that the respective trade marks are substantially identical with each other. That being the case, it now remains to be determined whether deception or confusion would be caused if the presently applied for mark is used on the goods in the specification, in the light of the opponent's reputation in the trade mark in Australia. In assessing that reputation, the relevant date is that of the filing of the opposed application - *Southern Cross*, supra - here 9 August 1996. As Ms Freeman argued, the barest possibility of confusion is not enough. There must be a real and tangible danger of its occurring. It is also accepted law that the risk of deception and confusion must extend to a substantial number of people likely to be concerned in the purchasing of the particular goods or services - *Kendall Co v Mulsyn Paint and Chemicals* (1963) 109 CLR 300. There is no change in the law from the *Trade Marks Act 1955* that there is an evidentiary onus on the opponent, in the first instance, to

establish the extent of its reputation in Australia - as per the words of Heery J., when referring to s.28 of that Act, in *Nettlefold Advertising Pty Ltd v Nettlefold Signs Pty Ltd* (1997) 38 IPR 495 at 501.

I have no doubt, from the evidence and from my own knowledge, that the opponent's television series is extremely well known in Australia. The evidence does show that the trade mark HOME AND AWAY had been used, in Australia and internationally, in relation to t-shirts, caps, umbrellas and key rings since 1993. The opponent released a compact disc in June 1996, and chambre shirts, polo shirts, sweat shirts, shirts, tops and shorts were sold from July 1996. All of these items would be particularly bought by younger persons in the 13 to 25 year age group, who appear to be the target audience for the show. I agree with Ms Freeman that the compact disc and latter clothing items can be removed from consideration because their release was immediately before the applicant's priority date and could not have contributed to any of the opponent's reputation. This leaves the opponent's use of the mark on t-shirts, caps, umbrellas and key rings to be considered, in relation to showing whether that party had an established reputation for its mark in Australia. This is where, in my opinion, the opponent's argument on this ground fails.

As Ms Freeman observed at the hearing, there is little in the evidence to show that the opponent had a substantial merchandising campaign in place in this country, as at the priority date of this application - 9 August 1996. The opponent does provide sales figures for goods under the mark in 1996/97 totalling AU\$450,000. However, the full breakdown of this figure is not given, the only claim of sales in Australia being clothing to the value of AU\$30,500. I can only assume that the balance of sales were made overseas. Additionally, there are no surveys in evidence relating to the public's awareness of the words HOME AND AWAY as a trade mark, no advertising or marketing figures supplied, nor are there any supporting declarations from the industry attesting to the opponent's established reputation for its trade mark as at the critical time.

I find myself in the same position as Hearing Officer Thompson in as-yet unpublished, Office decision, *Amalgamated Television Services v Linda Cameron Pickard, Alexandra Cameron Pickard and Linda Louise Pickard* (the SUMMER BAY case) of 11 October 1999, where he said:

Even allowing for the fact that character merchandising takes advantage of a pre-existing reputation to launch trade marks into, I find it impossible to conclude that, at the priority date of the opposed applications, enough of that reputation had attached itself to the trade marks to allow me to resolve that the trade marks had acquired sufficient reputation as trade marks in Australia such that the use of the trade marks by the applicants would be likely to confuse or deceive. If the sales of clothing under the aegis of the opponent had been demonstrated to be more significant, I may have been able to conclude that a notable proportion of the existing reputation of the indicium SUMMER BAY had attached itself to the trade mark. However, the sales by the opponent are either so slight, or so indefinitely stated, that this appears to be either unlikely or a most unsafe conclusion.

All this leads me to a conclusion that the opponent's reputation in its mark was not sufficient, as at the critical date, to indicate that the use of the present mark would be likely to lead to deception and confusion. Accordingly, I find that the opponent is not successful on this ground of its opposition.

Section 41(2)

This part of s.41 section reads:

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

The opponent's attorney has argued that the present mark could not be distinctive of the applicant because the words HOME AND AWAY are so well known in relation to the opponent and its television series. However, I cannot agree with Ms Moore Chrysiliou that the mark is not capable of distinguishing the applicant's goods under this section of the Act. This is because s.41 defines the basic tests for the mark to be registered by the *applicant*, and makes no reference to marks owned by other persons, which may be in conflict with the applicant's mark.

Ms Clissold, in her declaration, has said that she chose the phrase because the goods could be used while at home or while away travelling. While this could be said to be, *prima facie*, an admission that the mark alludes directly to the goods, I feel that the reference is, at best, oblique. There are other connotations to home and away - apart from a reference to the television show. Accordingly, I feel that there is enough ambiguity in the phrase to render it inherently adapted to distinguish

Given the foregoing, I dismiss the ground of opposition based on s.41.

Section 42(b)

This part of s.42 reads:

- 42.** An application for the registration of a trade mark must be rejected if:
 ...
 (b) its use would be contrary to law.

Despite any inferences which might be drawn from the applicant's adoption of a substantially identical mark to that owned by the opponent, I have not been presented with any evidence which might show me that anything unlawful has occurred in relation to the present application for registration of the opposed mark.

Ms Moore Chrysiliou argued that the mark was contrary to law because its use by the applicant would be contrary to the provisions of the *Fair Trading Act 1997 (New South Wales)*. However, the Registrar has no competence with respect to that Act and I cannot make any findings in relation to it. She also said that it offended under s.120(3) of the present Act, which deals with the infringement of trade marks. However, there is no evidence before me to show that the applicant has yet used the mark on the applied for goods and so it cannot be established that any infringement has taken place - if in fact that could be the case.

I therefore find that the opponent is not successful on this ground of its opposition.

Section 44

The relevant part of this section reads:

44.(1) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

- (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
 (i) a trade mark registered by another person in respect of similar goods or closely related services; or
 (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
 (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

There is no argument between the parties that the competing marks are substantially identical and that all of the opponent's registrations referred to in the evidence, in

relation to this ground, predate the applicant's mark. The opponent's prior registered trade marks comprising the words HOME AND AWAY cover a wide range of goods and services. These marks consist of registration numbers:

494508 - Entertainment services in the nature of live and recorded shows; services in this class relating to films, videos; production of television programmes, television entertainment.

494509 - Toys, games, and all other goods in this class.

494510 - Clothing, footwear, headgear.

494511 - Albums, books, magazines, calendars, cards, pictures, posters, stationery, table covers/napkins/mats in this class and all other goods in this class.

504137 - Confectionery inclusive of frozen confections and bubble gum; ices, ice cream, cereal preparations; beverages and preparations for making beverages in this class; bakery products in this class; condiments in this class.

504138 - Apparatus for recording, transmission or reproduction of sound or images; pre-recorded videos, records, tapes and discs; films in this class; computer goods in this class; games in this class; magnets; eyeglasses inclusive of sunglasses and cases, frames, chains and cords therefor; eyeshades; photographic goods in this class.

Ms Moore Chrysiliou argued that the clothing covered by registration number 494510 comprised similar goods to those in the present statement for goods in Class 3 because they could all be used in relation to merchandising and the promotion of entertainment. However, I feel that this is not a valid argument, when comparing goods under this section of the Act. I must here agree with Ms Freeman that, when the appropriate tests laid down in the case, *Jellinek's App'n*, supra, - the nature of the goods, the uses of the goods and the trade channels through which they are bought and sold - are applied, then it is obvious that none of the goods covered by the opponent's marks could be considered as being similar to those contained in the present statement.

The opponent must therefore fail on this ground of its opposition

Section 43

This section reads:

43. An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

The operation of s.43 does not depend upon the existence of a conflicting trade mark. The word "connotation", in this context, refers to that which is implied within a trade mark itself - in addition to its essential or primary meaning. It is possible, as is shown in such Office decisions as the EARTHAVEN CONFEST case, supra, the SUMMER BAY case, supra, and the also as-yet unpublished *Twentieth Century Fox Film Corporation v Michael F Durkan* (the BRAVEHEART THE MUSICAL case) of 19 January 2000, that evidence can reveal such a connotation. This can occur when it is convincingly shown that there is a perception, among people in an intended market, that a mark is so related to one party that use of the same mark by another will be deceptive and confusing because purchasers might incorrectly infer some sort of endorsement or relationship.

As I said, as the Registrar's delegate, in the EARTHAVEN CONFEST decision, supra:

Considerations under s.43 concentrate on the matter within the trade mark that could cause deception or confusion in the mind of the relevant buying public. For example, deception or confusion could arise in regard to the character of the services, or the implied endorsement or licence of services by a person or organisation.

Here, the opponent has said that, because both its mark and television show are so well known, then there is a connotation in the mark that the opponent has, in some way, given approval for, or has a connection with its use on goods specified in the present application. Although I have already found, in relation to the s.60 ground, that the opponent's reputation was not sufficient, *on its own*, to lead to deception and confusion, it has been shown to my satisfaction that the opponent has been sufficiently involved in the merchandising of goods bearing its mark, in relation to its television show so that the public might expect it to further develop this involvement along with current character merchandising practices. I believe that there is a widespread knowledge in the community of these practices and this has been acknowledged by the courts in such cases as the DUFF BEER case, supra, - a 'character merchandising' passing off case, where Tamberlin J said at 237:

The name or word under consideration does not have to be associated with goods manufactured by the trader. In *Radio Corp Pty Ltd v Disney* (1937) 57 CLR 448 (the Mickey Mouse case) at 453, Latham CJ in relation to the names "Mickey Mouse" and "Minnie Mouse" considered that these were:

“... so closely associated in the public mind, with ... Walter E Disney and his activities, that the use of either the names or the figures in connection with any goods at once suggests that the goods are “in some way or other” connected with ... Disney.”

So that, a name without an image may be sufficient to suggest an “association”.
In the same case, RichJ at 454 said:

“In matters such as this we are dealing with the vague and indefinite impressions of the great mass of the public who neither are required nor desire to refine upon distinctions of this sort. To them it is shown that the name “Walt Disney” summons up a picture of “Mickey Mouse” and the picture of Mickey Mouse reminds them of “Walt Disney”. The foundation of this is authorship no doubt. But somehow or other, how, it is fruitless to inquire, they connect the appearance on an article of the name or form of “Mickey Mouse” with “Walt Disney”. This being so, it is, I think, impossible for the appellant to negative all likelihood of confusion. It is no part of our duty to state in definite terms precisely how the public will be misled or what kind of connection they will impute. Confusion involves indefiniteness of ideas.”

Also, as was said by Hearing Officer Thompson in the SUMMER BAY case, supra:

Of course, these comments beg the observation that where there is any existing public knowledge of an opponent's demonstrated merchandising, Tamberlin J's statement must apply with a greater force.

I think that the situation here is analogous to the above case in that the evidence shows a history of the opponent marketing goods bearing that mark HOME AND AWAY to a public which expects such activity to be the norm. Additionally, those words are very well known, from my own knowledge, as the title of one of Australia's most successful and long-lived television series. Given this, I am convinced that any use by the applicant on her Class 3 goods would incorrectly imply, to those who watch the opponent's television show, that the opponent somehow endorsed the products sold by the applicant - which it obviously does not.

Accordingly, I find that the opponent is successful on this ground of its opposition.

Section 55

This section reads:

55. Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Ms Moore Chrysiliou, for the opponent, submitted that the Registrar should exercise the above discretion against the applicant by refusing to register the subject mark for a number of reasons - particularly because the words HOME AND AWAY are extremely well known in this country, leading to some financial harm to the opponent if the mark is registered. On the applicant's part, Ms Freeman said that the applicant did not want to relate her goods to the opponent's television show, had adopted the mark honestly and would be financially disadvantaged if the mark is refused.

On balance, I think that the mark, if allowed to be registered, could generate a degree of confusion in the marketplace which, despite the applicant's honourable intentions with respect to the use of the mark on her products, could lead to significant financial disadvantage to the opponent. I therefore think that the best course here is to refuse to register the mark.

Conclusion

I have found that the opponent has not succeeded on the grounds of its opposition related to ss.58, 59, 41, 42, 44 and 60. However, I have also found that it has been successful on the ground based on s.43. It follows that the opposition as a whole is successful and, accordingly, as the delegate of the Registrar, I refuse to register the trade mark, the subject of this application.

Costs

In respect of costs, I can see no reason why they should not follow the result. Accordingly, I order that the applicant pay the opponent's costs in the matter, in accordance with the Official scale.

Ian Forno
Hearing Officer

7 February 2000