



TRADE MARKS ACT 1995

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

Re: Opposition by LEVI STRAUSS to registration of trade mark applications 722439, 726420 and 726647 in the name of BON LEVI

Background

Application 722439 was lodged on 21 November 1996 and seeks registration of the words BON LEVI in fancy script as a trade mark in respect of a broad range of goods in Classes 3 and 34. Application 726420 was lodged on 28 Jan 1997 and seeks registration of the words BON LEVI GIORNO CAFÉ in fancy script as a trade mark in respect of a broad range of goods in Classes 7, 11, 21, and 30 with the goods being predominantly associated with coffee. Application 726647 was lodged on 29 Jan 1997 and seeks registration of registration of the words BON LEVI in fancy script in respect of a broad range of goods in Classes 32 and 33. Each of these applications is lodged in the name of "Bon Levi of 300 Murray Street, Perth, West Australia". The latter two applications state that Bon Levi is an Australian Citizen. For reasons that will become obvious, I will refer to Bon Levi as 'BL' hereinafter.

The trade marks were advertised as accepted in the Official Journal of 12 June 1997, 12 June 1997 and 26 June 1997 respectively.

Levi Strauss and Co ("the opponent") lodged notices of opposition on 12 September 1997. The notices of opposition were couched in several separate and broad-ranging grounds. However, as the issue can be decided on one of these grounds (and as only two grounds were argued at the Hearing), I will discuss only the evidence as it relates to that ground.

The Hearing

The Hearing was in Canberra on 12 February 1999. BL did not appear at the Hearing, neither was he represented, and the opponent was represented by Mr Ron Webb of Counsel appearing under instructions from Baker & McKenzie, Solicitors of Sydney. Mr Webb addressed the evidence both in terms of the general opposition headings under sections 58, 59 and 62(b) of the Act and section 60 of the Act concerning the opponent's very well known trade marks.

However, with Mr Webb's agreement - that, should I find that the opposition succeeds on the first argued ground, I give only my reasons as they relate to that ground - I shall confine my written reasons to that ground and discuss the evidence and the opponent's argument as it relates only to that ground. This approach is not detrimental to either of the parties should I not canvas all of the grounds that were put if they wish to appeal from this decision. It is after all true that, should either party appeal this decision, a Court would consider the 'appeal' *de novo*: *Jafferjee v Scarlett* (1937) 57 CLR 115 at 119.

Evidence

The evidence that forms the crux of the reason for my decision is in the form of a statutory declaration by Mr Ken Taylor who is the managing director of Trade Mark Investigation Services, a Queensland based firm that provides investigations services particularly as they relate to intellectual property matters.

Mr Taylor received instructions on 16 July 1997 to identify the person or business known as Bon Levi and determine whether these trade marks incorporating the word LEVI were being used by BL.

Mr Taylor declares that his investigations did not identify any natural person living in Australia, or business, named Bon Levi, nor did he identify any business using trade marks including the word LEVI (apart from the opponent) despite investigations that included:

- Searches of the Western Australian Electoral Roll

- Searches of the Electoral Rolls Australia-wide
- Searches of Telstra listings Australia- wide
- Attendance at 300 Murray Street, Perth, Western Australia
- Western Australian business name searches
- Internet searches

The results of these researches are appended to the Taylor Declaration.

The investigator's report to his client was also attached to his Statutory Declaration. Appended to this report are photographs of the premises at 300 Murray Street in Perth. These show a courtyard shopping precinct and Mr Taylor states the occupants *inter alia* to be the Wentworth Plaza Hotel, Bobby Dazzlers Bar & Restaurant, Horsefeathers Bar & Restaurant, the Moon & Sixpence, Royal Hotel and Toby's Cobblery. Mr Taylor states that there are some 35 stores in this shopping precinct.

Mr Taylor says that "we attended the premises of 300 Murray Street, Perth ... [and] made an extensive visual inspection of all the stores within this address and did not locate any shop, stores or signs which matched with the subject trade mark registrations. We also enquired with staff at a number of stores and at the Hotel itself, and no person had heard of 'Bon Levi', 'Joe Denim', [or] 'Bon Levi Giorno Café'".

Also appended to the Declaration is a letter dated 26 February 1999 from the solicitors for the opponent to Freehills Patent Attorneys ('Freehills') of Melbourne (then acting for BL) stating that their investigations had shown that their client was not, as BL had claimed to be, an Australian Citizen, nor could he be located as a person on the Electoral Roll , or other publicly available list of Australian lists of residents and citizens.

Freehills did not respond to this letter.

I also note that the Trade Marks Office has not been able to establish contact with BL.

The submissions

Mr Webb submitted that a number of grounds of this opposition depend on a fact that is unusual in the context of such proceeding. This fact is that the applicant (he submits) does not exist. Mr Webb drew my attention to the extensive investigations carried out by Mr Taylor which, he says, support the conclusion that the applicant does not exist. Mr Webb also made submissions drawing my attention to the various sections of the Act that allow who may be apply to register a trade mark and define the word 'person'.

Mr Webb also drew my attention to a letter from Freehills (who had then ceased to act for BL) to the Trade Marks Office stating that they no longer acted for BL and also adding:

We are in dispute with our client in relation to certain of the instructions our client has provided to us."

Mr Webb suggested that, in the circumstances, acceptance of the applications should be revoked in terms pursuant to subsection 38(1)(b) of the Act.

In the alternative, Mr Webb argued, since the applicant does not exist, the application should be refused on the following grounds:

- Section 58. The applicant is not the owner of the trade mark
- Section 59. The applicant did not intend to use the trade mark.
- Section 62. The application is defective etc

The Act

Status of Applicant

Section 27 of the Trade Marks Act 1995 allows that:

Application—how made

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.

It follows that if an application is to be properly made under the Act, it must be made by a "person". For the purposes of this Act, the words "applicant" and "person" are defined within section 6 in the following terms:

applicant, in relation to an application, means the person in whose name the application is for the time being proceeding

person includes a body of persons, whether incorporated or not.

It logically follows from these considerations that, if it can be shown that BL is not a person, the status of BL as an applicant is in jeopardy since the term "applicant" is defined as being a "person". It would follow then that there would be no "applicant" as far as the pertinent provisions of Part 5 - Division 2 of the Act provide - those allowing for the grounds under which an application may be opposed. If there is no applicant, the conclusion must be that this non-entity cannot own the trade marks in question in terms of section 58 of the Act; neither could either a non-existent applicant or person have the requisite intention to use the trade marks in terms of section 59 of the Act.

Further, it is apparent that subsection 62(b) is designed as a catch-all which puts an onus on the applicant and their legal representatives to be honest in their application and the prosecution of it to acceptance for registration. The relevant portion of subsection 62(b) provides:

False representations

Application etc. defective etc.

62. The registration of a trade mark may be opposed on any of the following grounds:

....

- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

At first flush, it would appear that, if the opponent can show, prima facie, that the applicant did not exist at the moments of making the applications, it must necessarily follow that I must find that (as the representation that the applicant was Bon Levi was false) the applications were false in a material particular. However, I think that the true situation is that while the opponent has the onus of establishing a prima facie case regarding the status of BL; this prima facie case could be negated by BL. There could be some rational and simple explanation for BL's apparent present lack of status that could be explained.

I also note that whereas both sections 58 ('applicant not owner of mark') and 59 ('applicant not intending to use trade mark') are couched in the present tense, section 62 employs the past tense concerning the representation or evidence that is allegedly false. Accordingly, section 62 appears to be limited to the veracity of the representation at the time that it was made.

Thus, I think, that while I could find that the opponent has established a prima facie case that BL does not now exist, (and lead to a presumption that BL did not exist at the times of making the applications) this falls short of establishing that, at the times of making the applications, BL conclusively did not exist and that the representations were therefore false in their material particulars.

Revocation

Section 38 of the Act allows:

Revocation of acceptance

38.(1) If, before a trade mark is registered, the Registrar is satisfied:

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;

the Registrar may revoke the acceptance of the application.

Note: For *limitations* see section 6.

(2) If the Registrar revokes the acceptance:

- (a) the application is taken to have never been accepted; and

- (b) the Registrar must examine, and report on, the application as necessary under section 31; and
- (c) sections 33 and 34 again apply in relation to the application.

As I see it, the operation of section 38 is of no assistance to the opponent if it establishes its case that BL does not exist. If BL does not exist, who is the examiner to report to after revocation has occurred? It is therefore not appropriate to decide the issue under this head. In general, it is also better administration of the Register to determine applications in the swiftest possible way: revocation entails allowing the applicant a fifteen month extension of time in which to put its application in order for acceptance.

Discussion

I believe that the opponent has established a prima facie case that BL does not exist for the purposes of this Act. There are some minor problems with the investigator's report. For example, the report consistently uses the third person to refer to the person who carried out the investigation, whereas it might carry more authority if it was couched in the first person. The investigation may have been more decisive if the investigator had also checked the records of the Australian Securities Commission to see if Bon Levi was registered there.

However, taken as a whole, the investigator's report very strongly suggests that BL does not now exist. The report is very thorough and on its own establishes a prima facie case that BL does not exist.

This conclusion is reinforced by the somewhat cryptic comment from Freehills (in their letter to this office of 16 June 1998) that 'they were in dispute with their client over instructions they had received'. As observed by Mr Webb in the Hearing, this dispute apparently goes beyond fees or the appropriate manner in which to progress the applications. Such disputes, although uncommon in legal practices, do not warrant comment to this office. I think that it is reasonable in the circumstances to conclude that information had come to Freehills (probably as a result of a letter dated 26 February 1998 from the opponent) concerning the status of BL as a person and that they took exception to continuing to perpetuate a myth.

However, I think this evidence does not demonstrate that, at the times of making the applications, the representations that the applicant was Bon Levi were false in their material particulars. The evidence relates to times after the applications were lodged and the representations were made. I think for a conclusion that, in terms of subsection 62(b), the representations that the applicant is Bon Levi (and the claim to Australian citizenship), were false, a more conclusive demonstration via evidence is required.

Decision

I accordingly find that, as BL does not exist:

- in terms of section 58 of the Act, BL cannot be the owner of the trade marks
- in terms of section 59 of the Act, BL cannot have the requisite intention to use the trade marks

I therefore refuse to register applications 722439, 726420 and 726647

Mr Hill, very realistically, made no submission as to costs and in the circumstances I make no award.

Ian Thompson
Acting Hearing Officer

19 February 1999