



TRADE MARKS ACT 1995

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

Re: Opposition by Twentieth Century Fox Film Corporation to registration of trade mark application 724090(9, 14, 28) - DIE HARD & CHEVRONS DEVICE- filed in the name of Die Hard.

Background

On 16 December 1996 an application was filed in the name of Die Hard to register the trade mark appearing below. The goods in respect of which the application now proceeds are listed hereunder:

Class: 9

Optical goods including sunglasses, sunglass cases, spectacles, spectacle cases

Class: 14

Jewellery, horological and chronometric instruments and apparatus including watches

Class: 28

Skateboards, in line skates, surfboards



I will note before proceeding any further that there apparently is no such person as Die Hard. Correspondence between the Trade Marks Office and the person who purports to be the applicant (and the evidence filed in relation to this opposition) has shown that person to be a company called Die Hard Pty Limited. This is an anomalous situation since section 6 of the *Trade Marks Act 1995* ('the Act') defines the words 'person' and 'applicant' in the following way:

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.

Section 27 of the Act provides:

27 Application—how made

- (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.

Note: For **use** see section 7.

I do not consider the problem to be that the application was made by a non-existent person; rather, that the person who made the application did not reflect their personality on the application form correctly. If the outcome of my deliberations is that this application may (subject to any appeal from my decision) proceed to registration, I will require that the applicant amend the application to fully reflect the applicant's status as a person.

For the sake of clarity, although this is technically incorrect as the application now stands, I will simply refer to Die Hard (or Die Hard Pty Limited) as 'the applicant' or 'Die Hard'.

During examination of the application, the specification of goods of the application in Class 28 of the *International (Nice) Classification of Goods and Services* was amended to that which appears above. Following examination, the application was accepted and advertised in the *Australian Official Journal of Trade Marks* of 23 October 1997.

On 23 January 1998, within the time allowed to do so, Twentieth Century Fox Film Corporation, ('Fox') filed Notice of Opposition to the registration of the trade mark. I will discuss the grounds on which Fox relied in their written submissions in my reasons, below.

The parties have filed evidence in support of the application, evidence in answer and evidence in reply in accordance with the Act and regulations. The declarations are as appears in tabular form, below:

Declarant	Known as	Date Made	Exhibits
Evidence in Support			
Melissa Gillies	Gillies	22 October 1999	MG1 – MG13
Evidence in Answer			
Peter Hill	Hill	21 July 2000	
Evidence in Reply			
Jamie Samson	Samson	23 Jan 2001	JS-1 & JS-2
Sue Dingas	Dingas	24 Jan 2001	

Both parties have been advised in writing of their right to be heard in this matter; however, neither party has elected to make submissions in person. The applicant has not filed written submissions while the solicitors for Fox, Allen Allen & Hemsley of Sydney, have filed written submissions.

The Evidence

The evidence shows that Fox is engaged in the production and distribution of theatrical films, video cassettes, video discs and television films and series. Fox also conducts promotion and merchandising campaigns associated with its various theatrical film and television productions. Ms Gillies is the Director of Marketing for Twentieth Century Fox Film Distributors Pty Ltd (Fox Distributors). Fox Distributors is an Australian registered company and is an entity related to Fox. Fox Distributors is generally responsible for the distribution and promotion throughout Australia of theatrical films produced by Fox. Ms Gillies avers that she has worked for Fox Distributors (or its predecessor) for over 10 years. She states that she has been involved in the distribution by Fox Distributors of approximately 185 films in Australia since May 1988 and been involved in all aspects of the promotion and marketing of theatrical films in

Australia. The theatrical films with which Ms Gillies has been involved are produced by Fox in Los Angeles, United States of America, and elsewhere, as well as films produced by producers other than Fox in Australia.

Ms Gillies attests that she has been responsible for many successful promotional and marketing campaigns. She says, all ten of the "Top Ten" films distributed by Fox Distributors in Australia, according to box office revenue for opening dates, have been released while she has been employed as Director of Marketing. These ten films include the highest revenue grossing theatrical film in Australia of all time, "Titanic", which has a cumulative gross box office revenue in Australia to date of over USD38,865,000, and "Independence Day" which holds the Australian box office record for revenue grossed on its opening day, on its opening weekend and in its opening week.

Ms Gillies refers to Fox's registration of the trade mark DIE HARD in Australia, brief detail of which are

Reg Number: 701725

Owner: Fox

Priority Date: 2 February 1996

Goods: **Class 9:**

computer games and computer game cassettes, cartridges and CD-ROM's;
video and computer game cassettes and cartridges adapted for use with
television receivers

Class 28:

hand-held computer games and computer game cassettes and cartridges.

Trade Mark: **DIE HARD**

Ms Gillies attests that Fox has produced (elsewhere) and released in Australia a series of three motion picture films called "Die Hard" or had titles which incorporate that term as the main element. These films are "Die Hard" (*DIE HARD One*); "Die Hard 2 (Die Harder)" (*DIE HARD Two*); and, "Die Hard With a Vengeance" (*DIE HARD Three*).

The evidence shows that the Die Hard films belong to the action thriller comedy genre in which the hero (John MacLane who is played by an American actor called Bruce Willis) is likely to be beaten up badly by a single villain in a fist fight, yet will prevail against a whole building full of villains armed with automatic weapons. Ms Gillies gives a brief plot synopsis of each of the Die Hard films. They are very similar: a synopsis of the first two might read, 'John MacLane must save his wife and family from their accidental ensnarement in the clutches of terrorists'.

These films have proven to be very popular. *DIE HARD One* was nominated, says Ms Gillies, for four Oscar Awards, including Best Effects, (Sound Effects Editing); Best Effects, (Visual Effects); Best Film Editing; and, Best Sound. The films performed very well at the box-office in Australia – Ms Gillies attests to receipts for *DIE HARD One* in the order of \$A3,000,000 and box office ticket sales of about 455,000 tickets. *DIE HARD Two* had accumulated box-office receipts of \$8,300,000 and tickets sales of 935,000. *Die Hard Three* had box-office receipts of \$13,143,000 and ticket sales of 1,675,000 tickets.

Ms Gillies appends to her declaration copies of a search of Australian newspapers conducted by Media Monitors Pty Ltd of articles published prior to the date of filing of the application which advertise, review or discuss the success and/or popularity of one or more of the DIE HARD Films.

Ms Gillies states that Twentieth Century Fox Home Entertainment Pty Limited (Fox Home Entertainment) is responsible for the distribution of Fox's theatrical films in video format to video rental outlets, and to retailers for sale, in Australia. Fox Home Entertainment was responsible for the duplication, release, distribution, promotion and marketing of the first two DIE HARD films on video cassette to video rental outlets and retailers in Australia. She says that a total of some 43,000 videos of these two films were distributed to video rental outlets and some 33,000 of these films were sold at retail prior to the filing of this application on 16 December 1996.

Attached to Ms Gillies declaration are various video box inserts showing the DIE HARD films and Australian newspaper articles reporting on the release of the DIE HARD films on video cassette in Australia. The first two DIE HARD films have been shown at least twelve times on pay and broadcast television in Australia and also appended to this declaration are printouts of material available on the Internet about the DIE HARD movies.

Ms Gillies then avers (and I will reproduce her words in full so that I may refer to them later):

It is my experience that film producers are increasingly developing the range of merchandise items and other goods which are given away and offered for sale in association with the release of a motion picture film. These merchandise items and other goods are used both to promote the film itself and also to generate further revenue, as people who see the film wish to purchase an item which reminds them of the film, acts as a means by which they may be identified with the film, or allows them to "re-live the film". Merchandise items, such as shirts and caps, may be offered for prizes for competitions which are conducted to promote the motion picture film when it is first released theatrically or on video

cassette, and then they may be sold afterwards. Other goods, such as computer games which themselves are based on the plot of the motion picture film, are offered for sale in their own right. Computer games are particularly attractive to viewers who wish to feel like they are "part of the film itself.

Examples of recent motion picture films for which an extensive range of merchandise and other goods were developed in association with the film are "Anastasia" and "Independence Day", which films the Opponent produced and Fox Distributors distributed in Australia. Exhibited to me at the time of declaring this Statutory Declaration and marked "MG10" is "Australian Licensee List" for the film "Anastasia". This list shows, under the heading "Articles", the extensive range of merchandise items of which the Opponent has licensed the production and distribution in Australia. In relation to "Independence Day", I am also aware that goods such as hats, caps, t-shirts, computer games and novelizations were distributed.

A range of merchandise has been distributed in Australia in conjunction with the DIE HARD Films, including t-shirts, caps and posters. Generally, these items have been produced by the Opponent's licensees in the United States of America, and then used by Fox Distributors (and its predecessors) as prizes in competitions conducted in Australia in association with the promotion of the DIE HARD Films. Exhibited to me at the time of declaring this Statutory Declaration and marked "MG11" are photographs of samples of these merchandise items.

Ms Gillies refers to the success and reputation of the movies and states her belief that this has been such that films reviewers and critics use the words 'Die Hard' as a touchstone – appended to her declaration are articles which include:

"Gridlock", *Newcastle Herald*, 17 October 1997 ("Die Hard style stunts and explosions");

"Trash with Panache", *Sydney Morning Herald*, 26 November 1992 ("might have been retitled Die Hard in the Navy");

"Confusing Plot is Under Siege", *Sun Herald*, 6 December 1992 ("a big budget bloodfest of the Die Hard Goes to Sea ilk");

"Top Ten", *Sydney Morning Herald*, 10 December 1992 ("variation on the Die Hard theme");

"A Ridiculous Flight of Fancy", *Sydney Morning Herald*, 25 March 1993 ("variation on the Die Hard formula"); and

"Film & Video", *Australian Financial Review*, 24 October 1998 ("in the style of the Die Hard series").

Mr Hill, in his evidence in answer, states that he and the other director of the applicant are also the only Directors of Hardcore Enterprises Pty Ltd, which company has since 1989 been registered as the owner of the Trade Mark "DIE HARD" No 505245 in Class 25. Brief details of this registration are:

Reg Number: 505245
Owner: Hardcore Enterprises Pty Ltd
Priority Date: 21/02/1989
Goods: Clothing, footwear and all other goods
Trade Mark:



Mr Hill says that Hardcore Enterprises Pty Ltd ('Hardcore') has used its Trade Mark "DIE HARD" in relation to the manufacture and distribution of clothing and accessories and has consented to "the application by the Applicant for the Applicant's Trade Mark". Apart from Mr Hill's assertion, there is no documentary support for any link between the companies, the purported consent, nor any concrete details of sales figures or labels showing the trade mark in use. Additionally, I do not think that (if it had been established) the fact that a person other than the applicant, or a predecessor in business, had used the trade mark on items other than those of this application is pertinent to the grounds of opposition. Notably, Mr Hill does not assert that Hardcore has used the trade mark in relation to goods. Further, if the consent by Hardcore Enterprises Pty Ltd were relevant, I would think it a more pertinent question whether Hardcore has consented to the use and registration of the instant trade mark by Die Hard.

The declarant states that Die Hard is a Melbourne based company. It was incorporated on 8 September 1989 and has since that date published the mark or words "DIE HARD" in Australia on invoices, receipts, statements and various other items used by it in the course of its carrying on its business. Mr Hill says that his company specialises in products that appeal to the "youth culture market". Die Hard, together with Hardcore, is, claims Mr Hill, a driving force behind skateboarding, snowboarding, and street-wear and other clothing (including footwear) and accessories thereto including watches, jewellery and sunglasses directed towards the youth culture market and in particular generation Y (the children of baby boomers).

Mr Hill also claims that Die Hard "conducts business as a manufacturer, distributor and/or licensee of various well known nationally and internationally recognised brands and fashion labels, and under those brands and labels, manufactures and/or distributes inter alia, skateboards, snowboards, clothing, footwear, sunglasses, jewellery watches and other

products". Mr Hill does not, however, support these claims (or, indeed, any of his other statements, with exhibits to his declaration).

Further, Mr Hill states that Die Hard has developed and acquired a substantial and distinctive goodwill and reputation in relation to its business. It has, he attests, an extensive distribution chain and its products are distributed to over 1000 predominantly surfwear, street-wear and clubwear. retailers in Australia. Mr Hill does not say, however, where the goodwill resides nor does he provide supporting evidence either in relation to the claimed goodwill and reputation or the distribution of the products. In the absence of supporting evidence, I have no way of objectively testing the validity of these claims or the extent and duration of the claimed goodwill and reputation.

I do not consider the balance of Mr Hill's declaration to be material in that he specifies the grounds listed in the Notice of Opposition and then addresses them with argument. I will not detail those arguments in full here but will address those which are relevant under the heading **Reasons**, below.

As some of Mr Hill's argument led to evidence in reply from Fox, I will summarise that argument as being an observation that none of the evidence submitted by Fox shows Fox's reputation of the trade mark DIE HARD (or any other trade mark) in relation to the goods specified on the application. The Samson and Dingas declarations purport to address Mr Hill's observation.

Jamie Samson is a resident of California, United States of America, and she states that she is Senior Vice-President of Legal and Business Affairs for Twentieth Century Fox Licensing and Merchandising (Fox Merchandising). Fox Merchandising is a United States registered company and is an entity related to Fox. Fox Merchandising is responsible for the production; arranging for production by third party licensees of the Opponent; distribution; and, advertising of merchandise goods offered for sale and sold worldwide, including in Australia, in conjunction with the distribution of, and for the promotion of motion picture films and television programs produced by Fox and released around the world and in Australia. Such activities are carried out under licence from Fox.

Ms Samson states that she disagrees with Mr Hill's observations because of the extremely wide range of goods now offered for sale and sold as merchandise in conjunction with motion picture films and television programs distributed in Australia, and, in particular, in conjunction with motion picture films for which Fox is the owner and/or distributor. Such goods, she says, include the goods for which Die Hard seeks registration of its application, such as watches and skateboards.

Ms Samson avers that she is aware of three different motion picture films and/or television productions distributed and/or broadcast in Australia, of which Fox is the owner and/or distributor, which have had watches and other chronometric instruments offered for sale and sold in conjunction with their advertisement, marketing and distribution in Australia. These are "Titanic"; "The Simpsons"; and "The X-Files". Exhibited to Ms Samson's declaration are copies of photographs of chronometric instruments bearing trade marks relating to the productions, "Titanic", "The Simpsons" and "The X-Files". Ms Samson also says that she is aware of one television programme distributed and/or broadcast in Australia, of which Fox is the owner, which has had skateboards offered for sale and sold in conjunction with its marketing and distribution in Australia. This is "The Simpsons". Ms Samson exhibits to her declaration copies of photographs of skateboards bearing trade marks relating to the television programme, "The Simpsons".

Ms Dingas is retail manager for Fox Studios. Fox Studios is an Australian registered company and is an entity related to Fox. The merchandise stores owned and operated by Fox Studios, for she is responsible as Retail Manager, are located in the "Back Lot" section of the Fox Studios premises in Moore Park

After referring to the details of these proceedings, Ms Dingas refers to Mr Hill's observations and states that, based on her knowledge of and experience with the offering for sale and selling of merchandise items in conjunction with, and for the promotion of motion picture films and television programs, the statement made by Mr Hill in paragraph 15 of his statutory declaration is incorrect.

Ms Dingas states that she holds this view because of the extremely wide range of goods now offered for sale and sold as merchandise in conjunction with motion picture films and television programs distributed in Australia, and, in particular, in conjunction with motion picture films for which Fox is the owner and/or distributor. Ms Dingas exhibits to her declaration copies of photographs of, *inter alia*, jewellery, watches and other chronometric instruments and apparatus for sale as merchandise, toys, sunglasses, spectacle cases, caps, diaries, jewellery, confectionery, sticking plaster, pool chairs, key-rings, bath infusions and salts, shower gels, t-shirts, mugs, backpacks and calculators. All of these goods bear trade marks associated with well-known movies and television programs associated with Fox.

The Submissions

Fox relies on written submissions by its solicitors, Allen Allen and Hemsley of Sydney. Die Hard has not made submissions, except insofar as they are contained in Mr Hill's declaration.

I will address the latter inasmuch as they are in the grounds relied on in Fox's submissions. I will regard the grounds specified in the Notice of Opposition and not mentioned in the submissions as having been formally abandoned with the exception of that under section 44. In the Notice of Opposition there is an apparent mistake within that ground which addresses the provisions of section 44. Inasmuch as Fox corrected this mistake at the same time as making its submissions, and the applicant has by implication addressed this in the Hill declaration, I will consider this first.

Reasons

Section 44

Absent any demonstrated use by the applicant of the opposed trade mark, section 44 of the Act relevantly provides:

Identical etc. trade marks

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.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar goods* see subsection 14(1).

Note 3: For *priority date* see section 12.

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Section 10 of the Act provides:

Definition of *deceptively similar*

10. For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

Section 14(1) of the Act provides:

14 Definition of *similar goods* and *similar services*

- (1) For the purposes of this Act, goods are similar to other goods:
 - (a) if they are the same as the other goods; or

- (b) if they are of the same description as that of the other good

As observed by French J of section 44 of the *Trade Marks Act 1995* in *Registrar Of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411, supra, at para 39:

The logic of subs 44(2) suggests that the determination whether goods are closely related to the services in question is logically antecedent to the determination whether the trade mark in respect of the services is deceptively similar to that in respect of the goods. Wilcox J at first instance in this case saw the questions as "conceptually distinct" but accepted that one could not be addressed in isolation from the second ...

The same logic applies to the comparison of goods with goods under the *Trade Marks Act 1995*.

Accordingly, what I am to consider in relation to this issue is whether the applicant's goods are the same goods or goods of the same description as the goods in respect of which Fox has its trade mark registration 701725. If I consider the goods in question to be of the same description, I will then go on and consider whether the trade marks are substantially identical or deceptively similar. If I consider the goods in question to be dissimilar, then the opposition fails under this heading.

Goods of the same description

The question of 'goods of the same description' was considered recently by Kenny J in *McCormick & Company Inc v McCormick* [2000] FCA 1335 at para 17. Her Honour said:

Whether the relevant goods are of the same description is essentially a question of fact.

The authorities establish that there are three principal factors to be considered in this regard. They are: (1) the nature of the goods, including their origin and characteristics; (2) the uses made of them, including their purpose; and (3) the trade channels through which the goods are bought and sold. As to the last-mentioned matter, it may be relevant to consider whether the goods being compared are produced by the same manufacturer or distributed through the same channels; whether they are sold in the same shops; whether they are sold to the same sort of customers; and whether those engaged in the manufacture and distribution of the goods are considered as belonging to the same trade: see *In Re Jellinek's Application* (1946) 63 RPC 59 at 70-72; *In Re John Crowther & Sons (Milnsbridge) Ltd's Application* (1948) 65 RPC 369 ("Crowther's Application") at 372; *In Re Frank George Whiting's Application* (1952) 69 RPC 219 at 221; and *Reckitt & Colman (Australia) Ltd v Boden* (1945) 70 CLR 84 at 94. As the High Court stated in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 ("Southern Cross") at 606-607:

The fact that examination of the nature of the applicant's goods may, by itself, induce an observer to conclude that they are different in character from those of an opponent, and designed to serve different purposes, is by no means conclusive. Nor is the fact that the applicant's goods are not specified by the regulations as being within the same class of goods: see *In re The Australian Wine Importers Ltd* (1889) 41 Ch D 278, at p 291 and *Reckitt & Colman (Australia) Ltd v Boden* (1945) 70 CLR 84, at p 90 per Latham CJ. There may be many matters to be considered apart from the inherent character of the goods in respect of which the application is made and some indication of what matters are relevant to this inquiry was given by Romer J in *In re Jellinek's Application* (1946) 63 RPC 59. Romer J thought it necessary to look beyond the nature of the goods in question and to compare not only their respective uses but also to examine the trade channels through which the commodities in question were bought and sold. Shortly after the decision in *Jellinek's Case* the Assistant-Comptroller elaborated on the observations of Romer J in the following manner: 'In arriving at a decision upon this issue the reported cases show that I have to take account of a number of factors, including in particular the nature and characteristics of the goods, their origin, their purpose, whether they are usually produced by one and the same manufacturer or distributed by the same wholesale houses, whether they are sold in the same shops over the same counters during the same seasons and to the same class or classes of customers, and whether by those engaged in their manufacture and distribution they are regarded as belonging to the same trade. In the case of *Jellinek's Application*, Romer J classified these various factors under three heads, viz., the nature of the goods, the uses thereof, and the trade channels through which they are bought and sold. No single consideration is conclusive in itself, and it has further been emphasized that the classifications contained in the schedules to the Trade Marks Rules are not a decisive criterion as to whether or not two sets of goods are "of the same description": *In re an Application by John Crowther & Sons (Milnsbridge) Ltd* (1948) 65 RPC 369, at p 372. Much the same considerations are evident in the observation of Dixon J (as he then was) in *Reckitt & Colman (Australia) Ltd v Boden* (1945) 70 CLR 84 when he said: 'What forms the same description of goods must be discovered from a consideration of the course of trade or business. One factor is the use to which the two sets of goods are put. Another is whether they are commonly dealt with in the same course of trade or business. In the present case, the goods are quite different, their uses are widely separated and they are not commonly sold in the same kinds of shops or departments' (1945) 70 CLR, at p 94.

On the one hand, goods are not necessarily of the same description simply because they are sold for human consumption and in common trade channels: see, for example, *In Re J & J Colman Ltd's Application* (1929) 46 RPC 126, where mustard and semolina were held not to be goods of the same description. See also *G Wood, Son & Co Ltd v McVitty & Co Pty Ltd* (1964) 34 AOJP 2601 and *In Re Chan Li Chai Medical Factory (HK) Ltd's Application* (1990) 19 IPR 140 at 144. On the other hand, the expression "goods of the same description" is not construed restrictively and regard is paid to the commercial context in which the goods in question are bought and sold: see *Rowntree plc v Rollbits Pty Ltd* (1988)

10 IPR 539 at 546 and *Dinning v New Balance Athletic Shoe Inc* (1992) AIPC 38,719 at 38,725.

I do not consider the goods in question here to be of the same description. The goods for which Fox is registered can be generally described as computer games – whether hand-held, cartridges for hand-held machines, programmes on CD-ROMS for PCs and so forth. I think it very likely that these goods will be sold from different shops than those within which the applicant's goods are sold – or from quite different areas within department stores although it is possible that skateboards and some computer games will be sold from within the same 'toys' section. However, the trade sources of such goods are, from my experience, quite different. One does not normally expect computer games to emanate from the same factory, or manufacturer, as (for example) sunglasses, jewellery or skates-boards.

The opposition under section 44 is therefore unsuccessful.

Section 43

Section 43 of the Act provides:

Trade mark likely to deceive or cause confusion

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.

In its submissions, Fox argues that it is artificial to suggest that the 'connotation' must be something, and I paraphrase, 'inherent to the trademark itself (per Branson J in *Woolworths*, above).' The passage to which the submission refers is, I presume, that at para 79 where Her Honour observes:

The broad provision contained in s 28(a) of the 1955 Act is now reflected in two separate sections of the Act - ss 43 and 60. Section 43, which is a ground for the rejection of an application for registration of a trade mark, looks to the inherent qualities of the trade mark of which registration is sought for the purpose of identifying whether the use of the trade mark would be likely to deceive or cause confusion.

This approach was more recently affirmed by the Full Court in *T.G.I. Friday's Australia Pty Ltd v TGI Friday's Inc* [2000] FCA 720 at para 43 by Wilcox, Kiefel & Emmett JJ where they said:

The case on deception and confusion sought to be made by Big Country and Friday's Australia in the present proceedings is one that falls outside the reasons

specified in those sections. It does not depend upon some connotation in the registered mark, but upon its similarity to a name used by Big Country and others. So the alleged deception or confusion is not for a reason covered by section 43.

I therefore do not agree with the Fox submissions. However, I believe I may consider the connotation of the words DIE HARD, divorced from any consideration of the comparison of the trade marks and in the light of the marketing activities of Fox in promoting goods sold as ‘spin-offs’ from these or other films. I think this is an approach consistent with *Woolworths* and *TGI Fridays*, above, and with the general thrust of the decisions of delegates of this office in reasons such as *Amalagamated Television Services Pty Ltd v Linda Cameron Pickard, Alexandra Cameron Pickard and Linda Louise Pickard* [1999] ATMO 103 (11 October 1999); *Twentieth Century Fox Film Corporation v Michael F Durkan* [2000] ATMO 5 (19 January 2000); and, *RS Components Limited v Holophane Corporation* [1999] ATMO 67 (23 June 1999).

The questions could be posed as, ‘to what extent has a connotation of the term DIE HARD established itself in Australian parlance as a result of exposure of Australians to the Die Hard movies?’ And, if there is a connotation, ‘is that connotation such that the use of the trade mark in relation to the goods of the opposed application would be likely to deceive or cause confusion?’

Fox has pointed to the use of the term ‘Die Hard’ by movie reviewers and critics as a ‘touchstone’ in the comparison of subsequent movies in the same genre. Among such people, movie reviewers and critics, it would seem that the term Die Hard has some parlance and that such people believe that, if they use the term in articles that they write, it will be readily understood amongst a broader audience. However, I do not believe that such usage establishes that the wider Australian public understands and uses the term in the same way or, that if they did, this usage is such that the use of the trade mark in relation to the goods of the opposed application would be likely to deceive or cause confusion.

The term ‘Die Hard’ has a definite dictionary meaning, that being, according to *Collins English Dictionary*:

Die-hard: n **1.** a person who resists change or who holds onto an untenable position or outdated attitude. **2.** (*modifier*) obstinately resistant to change

The movie title, Die Hard, is undoubtedly a play on the dictionary meaning of the expression - in the context of the movies, the title is likely to be seen as referring to an un-killable hero who will not give up despite an apparently untenable position.

This issue is, I consider, different from that in *Twentieth Century Fox Film Corporation v Michael F Durkan* [2000] ATMO 5 (19 January 2000). In that instance, the applicant sought registration of the trade mark BRAVEHEART THE MUSICAL in relation to some entertainment services. There the word 'braveheart' was a conjoined, arbitrary but meaningful expression not to be found in a dictionary and the Deputy Registrar found from the usages provided in the evidence that the expression had taken on a connotation and the Australian public would only understand the expression as referring to the opponent's film.

Here this is not the case.

Accordingly, I am not satisfied that 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.

Section 60

Section 60 of the Act provides

Trade mark similar to trade mark that has acquired a reputation in Australia

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.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

Fox argues that the expression DIE HARD is, in itself, a trade mark that it uses in respect of certain of its motion pictures and that, because of the reputation that this trade mark has in relation to the motion pictures, its use on the goods specified on this application by the applicant will be likely to deceive or cause confusion.

Pivotal to this line of argument is the question of whether the words DIE HARD are being used as a trade mark by Fox in respect of some of its motion pictures. I will consider this question first. If the words DIE HARD are a trade mark in respect of motion pictures, I am

then to consider, in terms of section 60, whether the trade marks in question are substantially identical or deceptively similar, the reputation of the Fox DIE HARD trade mark and if, because of that reputation, the use of the applicant's trade mark would be likely to deceive or cause confusion.

Use as a Trade Mark

In its written submissions, Fox refers me to the definition of a trade mark at section 17 of the Act:

17 What is a trade mark?

A ***trade mark*** is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Note: For *sign* see section 6.

The submissions refer me to the statement by Gummow J in the case *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* (1991) 30 FCR 326:

...the primary function of a trade mark is that of distinguishing the commercial origin of goods or services sold under the mark. The registered mark serves to indicate, if not the actual origin of the goods or services, nor their quality as such, the origin of that quality in a particular business, whether known or unknown by name.

Fox submits:

In *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407, Kitto J stated the kind of response to the presentation of a symbol that would indicate that there had been a trade mark use of a symbol: "There I see something that that Shell people are showing me as being a mark by which I may know that any petrol in relation to which I see it used is theirs". The question in that case was whether the oil drop figures projected on the viewer's television screen, some of which resembled Esso's trade mark, "appear[ed] to be thrown onto the screen as being marks for distinguishing Shell petrol from other petrol in the course of trade", whether they were being placed before the viewer as "a trade mark for Shell petrol", or as "being a mark which has been chosen to serve the specific purpose of branding petrol in reference to its origin." See the judgment of Burchett J in *Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd* [2000] FCA 876; 48 IPR 257.

For the reasons set out below, I accept Fox' submissions that, in respect of the motion pictures and video recordings in question, the words DIE HARD have been used by Fox as a trade mark. In the appeal, *Musidor BV v. Robert William Tansing* (1994) 123 ALR 593; (1994) AIPC 91-083; (1994) 29 IPR 203, the trial Judge in the Lower Court had held that the

name on a CD insert and on the CD, "The Rolling Stones", was not used as a trademark. Davey J observed, in overturning that decision:

In my opinion, the words "The Rolling Stones" stated prominently on the insert of the covers and on the CDs, exhibit ASF3, are typical examples of the manner in which one would expect the trademark to be applied. *In Re Polar Music International* AB 714 F 2d 1567 (1983), Circuit Judges Baldwin and Kashiwa, Circuit Judge Smith dissenting, held that the letters "ABBA" should be registered as a trademark. Judge Kashiwa, delivering the opinion of the majority, said at 1571-2:-

"(1) A trademark 'includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.' 15 U.S.C. section 1127. A trademark informs the public of a source of the goods and assures them of its quality. A trademark need not be the name of the manufacturer of the goods and the public need not know the name of the owner of the mark. See *Coca-Cola Co v. Koke Co of America*, 254 US 143, 146, 41 S Ct 113, 114, 65 LEd 189 (1920); *Saalfield Publishing Co. v. Merriam Co.*, 288 F 1, 8 (6th Cir.), cert. denied, 243 US 651, 37 S Ct 478, 61 LEd 947 (1917).

(2) Appellant submitted a license evidencing its right to control the quality of the sound recordings. Since appellant controls the quality of the goods, it is the source of the goods. Any trademark for the sound recordings can therefore only indicate source in appellant since no other entity is the source. The source of the goods does not depend on the public's perception; the public need not know appellant's role. Thus, the board's holding that 'ABBA' cannot function as a trademark for recordings because the public would not know that appellant owns the rights in 'ABBA' and that it exercises quality control over the records must be rejected. *E.I. Du Pont de Nemours and Co. v. Celanese Corp.*, 35 CCPA 1061, 167 F 2d 484, 77 USPQ 364 (1948). ...

In the instant case we find certain factors determinative that 'ABBA' functions as a trademark and is not just an identification of the singers. It is well settled that the title to a series of records or books is able to function as and be registered as a trademark. *In re Cooper*, 45 CCPA 923, 254 F 2d 611, 615, 117 USPQ 396, 400 (1958); *In re First National City Bank*, 168 USPQ 180 (TTAB 1970). The reason for this is that

(T)he name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title. A series name is comparable to a title of a periodical publication such as a magazine or newspaper. While it may be indicative either specifically or by association in the public mind, of the general nature of the contents of the publication, it is not the name or title of anything contained in it. *In re Cooper*, 254 F 2d at 615, 117 USPQ at 400.

We find the present situation analogous. Every 'ABBA' album and single and tape has the word 'ABBA' on it in addition to its title. See, e.g., 'Arrival,' 'Dancing Queen and That's Me,' and 'Greatest Hits.' The public has come to expect and associate a certain quality, not just of sounds but of how the sounds are produced on the record and the physical qualities of the record itself, with the mark 'ABBA.' Thus the mark 'ABBA' indicates not just the source of the performance but a source of the records and tapes and the sound recorded thereon. Furthermore, the contract between appellant and Atlantic permitted Atlantic to use the name 'ABBA' and other marks of 'ABBA' for only the term of the contract and recognized them as valuable assets owned by appellant."

I think that motion pictures, if there is a series of them, fall into the same genus of publication as the newspapers, sound recordings, magazines and newspapers referred to above. By analogy, therefore, the titles of motion picture films should also be capable of functioning as trade marks. Whether particular movie titles do function as trade marks, will, naturally, depend on the evidence how such indicia have been used and whether such indicia have, in fact, developed trade mark significance. Here the evidence shows that there is a DIE HARD series of films and that the series is only associated with Fox – it is difficult, for example, to see how the word DRACULA could be a trade mark in respect of motion pictures since the word is associated with the motion pictures of many different people. The evidence shows that the public have come to expect a certain 'action movie' content, style and level of production value, violence, graphical stunt and propensity to use swear words within the DIE HARD movies – I refer again to the evidence that movie critics use the words DIE HARD as a touchstone. The public, thus, understands the words as indicating the character, quality and source of the goods. The Gillies declaration refers to a possible future Die Hard motion picture. The name of the series of motion pictures is not descriptive of their content and each motion picture, while incorporating the words in its title, and (the evidence shows) being generally referred to by the public as *Die Hard I*, *Die Hard II* and *Die Hard III*, has its own title.

I therefore accept that the evidence supports Fox's submission that the words DIE HARD, as used by Fox in respect of certain of its movie pictures, function as a trade mark.

Similarity of the trade marks

The classic test of what constitutes substantial identity is that set out by Windeyer J in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 at 414–15:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance

of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison ...

The device component of the applicant's trade mark is a major part of the trade mark and, in the application of the above test, I find that the trade marks are not substantially identical.

As regards deceptive similarity, in *The Shell Co*, above, at 415, Windeyer J said:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions. To quote Lord Radcliffe again: "The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole": *de Cordova v. Vick Chemical Co* (1951) 68 RPC, at p 106. And in *Australian Woollen Mills Ltd v.F.S. Walton & Co. Ltd.* (1937) 58 CLR 641 Dixon and McTiernan JJ. said: "In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same" (1937) 58 CLR, at p 658.

Further, Lord Parker (then Parker J) in *Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777), suggested some guidelines for the comparison of trade marks.

He said:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion — that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods — then you may refuse the registration, or, rather, you must refuse the registration in that case.

The prominence of the words DIE HARD in the applicant's trade mark, and the probability that those words will be used in any spoken request for goods sold under the trademark, lead me to conclude that the trade marks are deceptively similar. Further the goods are, Mr Hill states in his declaration, marketed to the children of 'baby boomers'. While there is no evidence as to the age of this market, I presume this is the teen market which is not as mature, sophisticated or discriminating as older consumers. I believe this strengthens the conclusion that the trade marks are deceptively similar.

Reputation of the Fox Trade Marks

There is no doubt that the DIE HARD trade mark, used in relation to the series of motion pictures is very well known. Each movie release was, the evidence shows, preceded by intense publicity and advertising costing many thousands of dollars. Each movie has done very well in box-office receipts, video rentals and sales and through the visual broadcast media. The first movie in the DIE HARD series was nominated for four Oscar Awards.

In *McCormick*, above, Kenny J referred to the Hearing Officer's reasons in *Hugo Boss AG v Jackson International Trading Co Kurt D Bruhl GmbH & Co KG* (1999) 47 IPR 423 ("Hugo Boss") at 436:

[I]t is true that the assessment of the reputation of a trade mark goes far beyond mere examination of sales or turnover of goods sold under that trade mark and contemplation of the advertising and promotional figures. As regards a trade mark, its reputation derives both from the quantum of sales under that mark and also the esteem, or image, projected by that trade mark. The quantum of sales, advertising and promotion contributes to the 'recognition' component of the trade mark's reputation. The credit, image and values projected by a trade mark attaches to the 'esteem' component of the reputation as do the public events and other trader's marks with which [the] owner of the trade marks in question chooses to associate the trade marks via sponsorships, cross-promotions, 'contra deals' and so forth. It follows that a trade mark used in relation to goods with comparatively low sales may have a high and strong reputation by virtue of the high credit or esteem in which it is held or, conversely, that a trade mark which has very high sales may have a strong reputation notwithstanding the lack of esteem that attaches to it. The particular popular images, or sets of values, that attach to the trade mark are also, therefore, important parts of the reputation of the trade mark and may be as strong an associative force in the minds of the public as the association of the trade marks with the goods or services themselves.

There are a number of factors in the evidence which suggest to me that the strong reputation of the trade mark is demonstrated by the evidence not only by the high degree of sales and advertising in relation to the trade mark. These include the use of the term Die Hard by movie reviewers and critics in their reviews of films other than the Die hard series – the

reviewers demonstrably believe that the term immediately brings to mind the character and quality of the particular movies; the number of interviews with Mr Bruce Willis published in Australian newspapers and magazines in which his role in the series of films is discussed.

Likely to deceive or cause confusion

In *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 (29 July 1999), at para 50, French J said:

In *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-5, which concerned the 1905 Act, Kitto J set out a number of propositions which have frequently been quoted and applied to the 1955 Act. The essential elements of those propositions continue to apply to the issue of deceptive similarity under the 1995 Act. Applied also to service marks and absent the imposition of an onus upon the applicant they may be restated as follows:

(i) To show that a trade mark is deceptively similar to another it is necessary to show a real tangible danger of deception or confusion occurring. A mere possibility is not sufficient.

(ii) A trade mark is likely to cause confusion if the result of its use will be that a number of persons are caused to wonder whether it might not be the case that the two products or closely related products and services come from the same source. It is enough if the ordinary person entertains a reasonable doubt. It may be interpolated that this is another way of expressing the proposition that the trade mark is likely to cause confusion if there is a real likelihood that some people will wonder or be left in doubt about whether the two sets of products or the products and services in question come from the same source.

(iii) In considering whether there is a likelihood of deception or confusion all surrounding circumstances have to be taken into consideration. These include the circumstances in which the marks will be used, the circumstances in which the goods or services will be bought and sold and the character of the probable acquirers of the goods and services.

(iv) The rights of the parties are to be determined as at the date of the application.

(v) The question of deceptive similarity must be considered in respect of all goods or services coming within the specification in the application and in respect of which registration is desired, not only in respect of those goods or services on which it is proposed to immediately use the mark. The question is not limited to whether a particular use will give rise to deception or confusion. It must be based upon what the applicant can do if registration is obtained. In respect of the last proposition, Mason J observed in *Berlei Hestia Industries Ltd v The Bali Company Inc* (1973) 129 CLR 353 at 362:

"...the question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark. The issue is whether that use would give rise to a real danger of confusion."

Further, the question whether the use of a mark is likely to deceive or cause confusion is in the end a question of impression and common sense; it is a "jury question" in which the judge is entitled to give effect to his or her own opinion as to the likelihood of deception or confusion: *Murray Goulburn Co-operative Ltd v New South Wales Dairy Corp* (1990) 24 FCR 370; at 377; 16 IPR 289

The evidence in support of the opposition relates to the period before this application was filed: 16 December 1996. Ms Gillies has averred, in that part of her declaration I have quoted in full, that it is, in her experience, common for the makers and promoters of motion pictures to produce a range of merchandise that is either sold, or used as prizes to promote the moving picture production with which it is associated¹. This accords with my own observations and experience. The range of goods for which such activities occur is reflected in Fox's evidence taken as a whole and includes the goods in respect of which the applicant seeks registration. Fox has not marketed the particular goods under the trade mark DIE HARD; however, this not essential for their argument to succeed². The more relevant question is whether, because of the reputation of Fox trade mark, the use of the applicant's trade mark would be likely to deceive or cause confusion.

It is my conclusion that the reputation of Fox's DIE HARD trade mark in relation to the series of Die Hard movies (and videos, both at rental and sale), is such that a person seeing (or being offered) any of the nominated goods for sale is likely to immediately conclude that they are offered for sale under the aegis of Fox and thus the use of the applicant's trade mark would be likely to deceive or cause confusion.

Thus the opposition to registration of the trade mark succeeds in relation to the ground under section 60.

Decision

I refuse to register trade mark application 724090.

¹ And see *Pacific Dunlop Ltd v Hogan* (1989) 23 FCR 553; *Twentieth Century Fox Film Corporation v South Australian Brewing Co Ltd* (1996) 66 FCR 457; *Britt Allcroft (Thomas) LLC v Miller* [2000] FCA 699

² *Twentieth Century Fox Film Corporation And Matt Groening Productions Inc v. The South Australian Brewing Co Ltd And Lion Nathan Australia Pty Ltd No. Ng 155 of 1996 Fed No. 365/96*

Costs

Fox, having been successful, is entitled to (and has requested) its costs in this matter and I award costs at the official scale against the applicant.

Ian Thompson
Hearing Officer

Friday, 25 May 2001