



TRADE MARKS ACT 1995

DECISION OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Trade mark application number 740114 — BRAVEHEART THE MUSICAL — in the name of Michael F Durkan and opposition thereto in the name of Twentieth Century Fox Film Corporation

Trade mark application number 740114 is an application to register the words BRAVEHEART THE MUSICAL for *T-shirts* and *caps* in class 25, and for *Theatre musical production* in class 41. The application was filed on 28 July 1997 (the relevant date) by Micahel F Durkan of 102 The Esplanade, Sylvania, New South Wales. 740114 was then examined and, on 27 November 1997, the Registrar advertised, in the *Australian Official Journal of Trade Marks*, that he accepted this trade mark for registration.

On 22 December 1997, in accordance with the provisions of Part 5 of the *Trade Marks Act 1995*, Twentieth Century Fox Film Corporation, a Delaware corporation of 10201 West Pico Boulevard, Los Angeles, California, USA, (hereafter Fox Corporation) filed opposition to the registration of 740114 and, in its notice of opposition, nominates seven grounds. The first three of these grounds, which rely on sections 41 or 42, and the last which relies on the Registrar's discretion, are not pursued. The remaining substantive grounds are as follows:

- Due to the existence of Fox Corporation's trade marks the use of 740114 by Mr Durkan is likely to deceive or cause confusion, and therefore, the registration of 740114 would be contrary to section 43 of *Trade Marks Act 1995*;
- Mr Durkan is not the owner of 740114, and, therefore, the registration of 740114 would be contrary to the provisions of section 58 of the *Trade Marks Act 1995*;

- 740114 is substantially identical with, or deceptively similar to Fox Corporation's trade marks which have acquired a reputation in Australia, as a result of which the use of 740114 is likely to deceive or cause confusion contrary to section 60 of the *Trade Marks Act 1995*.

Fox Corporation served on Mr Durkan, and filed with the Trade Marks Office, a declaration by Ms Mellisa Gillies. This constitutes the evidence in support of the opposition.

Mr Durkan did not file or serve any evidence in answer.

As per the provisions of regulation 5.14, Fox Corporation applied to be heard, and the Registrar appointed a hearing for 11 October 1999, in Sydney. This hearing was before me. The opponent, Fox Corporation, was represented by Mr David Larcombe Yates, of Allen, Allen & Hemsley, solicitors of Sydney. Mr Thomas Bray, of Stephen Wawn and Associates, Lawyers, attended the hearing on behalf of the applicant, Mr Durkan. I cautioned Mr Bray that I had no record of the hearing fee being paid and that unless the prescribed fee of \$500 was located he could not be heard. I am now satisfied that the required \$500 was not paid. Consequently I am obliged to disregard any comments that Mr Bray put forward in the course of the hearing.

The Background.

The evidence provides, per Ms Gillies declaration, a picture of Fox Corporation's association with the term BRAVEHEART. As mentioned, there is no evidence from the applicant, Mr Durkan, and therefore, apart from the trade mark application itself, no evidence of the applicant's association with this word.

Ms Gillies asserts:

Fox [Fox Corporation] is the owner of the copyright in the BRAVEHEART film and trade mark rights in BRAVEHEART throughout the world, including Australia ... The BRAVEHEART film was set in, and was partly filmed in, Scotland and is a partly historical, partly dramatised account of the life of William Wallace, a Scottish commoner who fought for his country's freedom from the tyranny of the English King "Edward, the Longshank" at the end of the 13th century.

... From the time that the film was first released in the USA on 24 May 1995 and at all times thereafter, the film has been known as

BRAVEHEART appearing as one word. The name BRAVEHEART is a distinctive title coined specifically for the film.

Upon its release in the USA, the BRAVEHEART film was an immediate popular and critical success throughout the world. The film features and was directed by the well known Australian bred actor, Mel Gibson, who is internationally renowned for his acting and directing ability.

The renown of the BRAVEHEART film is reflected by the fact that it was nominated for nine, and won five Academy Awards in 1995: Best Picture, Best Director, Best Cinematography, Best Makeup and Best Sound Effects.

The BRAVEHEART film and/or its contributors also won seven other prestigious film awards, including the Golden Globe award for Best Director and the Writers' Guild award for Best Screenplay. Mel Gibson also won the Best Director award from the newly-formed Broadcast Film Critics' Association in the USA.

Ms Gillies continues with a further list of awards which include the British Academy of Film and Television Arts awards. She then describes what occurred when Fox Corporation released the film to the public.

The BRAVEHEART film was released internationally in over 60 countries, and has been seen by millions of people. It has generated over USD200 million in gross revenue from worldwide box office receipts to date [September 1998] of which USD75 million was generated in the USA alone where the film was played in 2,337 theatres. The BRAVEHEART film has also been released on video, generating well over USD125 million in worldwide sales.

The Australian premiere of the BRAVEHEART film was shown to a full audience at the Hoyts Theatre in Sydney on 30 May 1995. The premiere was an "invitation only" event at which Mel Gibson and over 950 invited guests appeared. The invited guests included politicians, film and television stars, authors and business leaders.

The BRAVEHEART film was then released in Australia on 1 June 1995 and has been extremely successful in Australia in terms of gross revenue from box office receipts. Since its premiere, the BRAVEHEART film has played in 650 theatres in Australian cinemas and has generated over AUD12,226,648 in gross box office revenue in Australia. Approximately 1,580,000 people saw the film at an Australian theatre. This success was generated in part because Mel Gibson was, and continues to be, an actor who is very well known in Australia...

Fox Distributors [Twentieth Century Fox Film Distributors Pty Ltd - an Australian registered company related to Fox Corporation] conducted an extensive publicity campaign for the BRAVEHEART film

in Australia between 28 May 1995 and 6 June 1995, to coincide with the film's Australian release. During this publicity campaign, Mel Gibson promoted the film by participating in a number of interviews for Australian magazines, newspapers and television programs which featured him and his co-stars.

Ms Gillies exhibits numerous items to support her report of widespread and extensive publicity. There is, *inter alia*, a copy of Mr Gibson's tour schedule between 28 May and 6 June 1995 and a selection of Australian newspaper and magazine clippings which related to Mr Gibson, the publicity campaign, or to reviews of the film. These publications include:

<i>The Herald Sun Newspaper</i>	(Victoria)
<i>The Age Newspaper</i>	
<i>The Daily Telegraph Mirror Newspaper,</i>	(NSW)
<i>The Sun-Herald Newspaper</i>	
<i>The Sydney Morning Herald</i>	
<i>Beat Magazine</i>	
<i>The Australian Newspaper,</i>	(National)
<i>Who Weekly Magazine</i>	
<i>The New Weekly Magazine</i>	
<i>Time Magazine</i>	
<i>Insights Magazine</i>	
<i>TV Hits Magazine</i>	
<i>Star! Magazine</i>	
<i>The Courier Mail Newspaper</i>	(Queensland)
<i>The Sunday Mail Newspaper</i>	
<i>The Canberra Times</i>	(ACT)
<i>The West Australian Newspaper</i>	(WA)
<i>The Sunday Times Newspaper</i>	
<i>The Sunday Mail Newspaper</i>	(SA)

Subsequent to its release, says Ms Gillies, details about the BRAVEHEART film appeared in a number of magazines throughout the world. She exhibits examples and I note the item from *Playboy Magazine* (June 1995). She also exhibits a wealth of articles from Australian newspapers and magazines which report and comment on the release of the film and its success. Included amongst those are magazines well known for their wide national

circulation, such as *The Australian Woman's Weekly Magazine*, *New Idea Magazine*, *Woman's Day Magazine*, *TV Week Magazine*, *Who Weekly Magazine* and *The Australian Magazine*. The majority of the newspapers listed above are also well represented in this group.

At the same time as the newsworthy aspects of the film were being reported in the popular press, the concerted promotional campaign undertaken by Fox Corporation's Australian agents, continued. Ms Gillies explains that, commencing on 1 May 1995, a media campaign exposed the film through television, radio, newspaper and outdoor (bus-sides and 'supersites') advertising. Promotion was also directed through the merchandising of BRAVEHEART solid pewter tankard mugs, BRAVEHEART caps, BRAVEHEART letter openers and address books, BRAVEHEART backpacks and BRAVEHEART T-shirts and sweatshirts. BRAVEHEART competitions were run (with prizes such as a trip to the Golden Globe Awards, a trip to Scotland, or double passes to the film BRAVEHEART). Further promotion material was launched on the Internet. A separate marketing campaign was undertaken to promote the film on video cassette. Rental sales generated around AUD6 million. Over 130,000 video cassettes of the film have actually been sold.

Further evidence of widespread interest in the BRAVEHEART film is demonstrated by Ms Gillies' statement that, with the release of the film on video, Fox released a video version of a documentary entitled *The Making of BRAVEHEART*. This was distributed to rental outlets and was made available to the public free of charge. A book based on the script of the BRAVEHEART film, published in Australia by Penguin Australia, was released in August 1995. It was reprinted in May 1998 and, by September 1998, 6000 copies had been sold. The soundtrack of the film was released in Australia in June 1995 and, to September 1998, between 70,000 and 100,000 copies sold. The BRAVEHEART film itself was screened on television by *Seven Network Limited* on 1 March 1998 and has since played a number of times on pay television and other commercial channels.

Summing up the evidence, I think it can fairly be said that Fox Corporation has been responsible for a film entitled BRAVEHEART and that film has been a runaway success. It has achieved a high level of critical acclaim, a large number of awards and an exceptional amount of publicity. Furthermore, it seems quite clear that BRAVEHEART is a particularly popular film, and that it has been seen nationwide by very large audiences in theatres, on television or on video. Marketing of BRAVEHEART merchandise has been successful and extends beyond

the soundtracks and T-shirts to publications and films on how the epic was produced. As the press express it, the movie BRAVEHEART has been a very big hit.

Against the background provided by this evidence, I turn to the grounds of the opposition, and the submissions made at hearing by Mr Yates.

Section 43

The law

Section 43 reads:

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.

Fox Corporation oppose the application on the ground that, due to the existence of Fox Corporation's trade marks, the use of 740114 by Mr Durkan is likely to deceive or cause confusion. The operation of section 43 does not, however, depend on the existence of a conflicting trade mark. The purpose of the section is to exclude from registration any trade mark which, in respect of the nominated goods or services, conveys a meaning which, in respect of those goods or services, is likely to deceive or confuse. This does not require the existence of a conflicting trade mark.

I have been shown no evidence that Fox Corporation used the word BRAVEHEART as a trade mark. This point I intend to deal with in some greater detail in respect of the section 58 and 60 grounds. For the purpose of the section 43 ground, however, this finding is of no great consequence. What I need to consider for the purpose of section 43 is simply the question of whether, as a consequence of some connotation conveyed by the words BRAVEHEART THE MUSICAL, that trade mark, when used in relation of *T-shirts* and *caps* (in class 25), and *theatre musical productions* (in class 41) is likely to deceive or cause confusion.

Submission, evidence, and consideration

Mr Yates constructed his submissions on the presumption of Fox Corporation's trade mark use of the word BRAVEHEART. That line of argument, I think, fails on the basis that so far as the evidence shows, Fox Corporation has no trade mark use of that word.

The facts in evidence are, however, that the term BRAVEHEART was coined as a fictional sobriquet for the historical figure of William Wallace. The expression *brave heart* is an

ordinarily descriptive term used as a salute to an heroic attitude. The “coining” claimed by Fox Corporation is therefore nothing more than the conjunction of two ordinary words which, in their normal usage, constitute a laudatory and well recognised expression. Nevertheless, before Fox Corporation merged these two words into one, there is no evidence that the word BRAVEHEART had any currency, any presence in English dictionaries, or any attachment to the Scottish hero, William Wallace. I do note, under Ms Gillies’ exhibit MG-2, a cutting from *The Sunday Mail Newspaper*, Adelaide, 28 May 1995, which headlines an article about a football team, the “Adelaide Crows”, with the words

Week of trauma ends in triumph as the Crows go from being ‘No-Hearts’ to ... BRAVEHEARTS.

I treat this, however, as an article which merely reflects and picks up on the publicity which at that time was surrounding the first release of the film in Australia.

Since the release of the BRAVEHEART film, however, the word BRAVEHEART no longer remains unknown. On the undisputed evidence, BRAVEHEART now has significant currency as the name of one of the most successful films of late 1990s. That film has had exceptional critical and popular success and the publicity associated with its acclaim has also been exceptional. On this basis, I think it is very clear that the trade mark BRAVEHEART THE MUSICAL, dominated as it is by the word BRAVEHEART, will openly give rise to a connotation of the film BRAVEHEART. The remaining words — THE MUSICAL — do not detract from that connotation. On the contrary, it seems to me that the overall connotation likely to be imparted to a substantial portion of the Australian public by the trade mark BRAVEHEART THE MUSICAL is that the makers of the film BRAVEHEART are now presenting (by way of a musical production) or promoting (by way of T-shirts or caps) a musical version of the story previously unfolded in the film.

The test for deception or confusion is recently dealt with in the judgement of French J in *Registrar of Trade Marks v Woolworths*, (1999) AIPC 91-499 at 39,695 (paragraph 43) the *Metro* case. In considering the phrase *likely to deceive or cause confusion*, his Honour says:

The use of the word “likely” in this context does not import a requirement that it be more probable than not that the mark has that effect. The probability of deception or confusion must be finite and non-trivial. There must be a “real tangible danger of its occurring”.

In my view a real and tangible danger of deception and confusion does attach to use of the trade mark BRAVEHEART THE MUSICAL, by Mr Durkan, in respect of theatre musical productions and T-shirts and caps. Use of this sign, dominated as it is by the name BRAVEHEART, will connote the celebrated BRAVEHEART film and therefore give rise to expectations that the theatre musical productions and the T-shirts and caps are associated with the maker of the BRAVEHEART film.

In respect of the section 43 ground, I find in favour of the opponent, Fox Corporation.

Section 58

The law

Section 58 of the Act 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.*

Mr Yates directs me to the principle that prior use displaces an applicant's claim to statutory proprietorship, as laid down in *Settef S.p.A. v Riv-Oland Marble Co (Vic) Pty Ltd* 10 IPR 402 at page 413:

The basic common law principle is that the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark there: *Re Registered Trade Mark "Yanx"; Ex parte Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at 203; *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at 603; *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* 59 ALJR 77 at 83.

There is no evidence, apart from the filing of application 740114, that Mr Durkan has made any use of its trade mark BRAVEHEART THE MUSICAL. In accordance with the findings in *The Shell Co of Australia Ltd v Rohm & Haas Co* (1949) 78 CLR 601 at 625 and 627, and *Carnival Cruise Lines Inc v Sitmar Cruises Ltd*, (1994) AIPC 91-049, the proprietorship claim vested in 740114, may be upset by Fox Corporation if that corporation succeeds in showing that it has an earlier use of a trade mark substantially the same as BRAVEHEART THE MUSICAL and that use is for the same kind of goods and services nominated in 740114.

A trade mark is defined under section 17 of the Act:

17. *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.*

Submission, evidence, and consideration

Ms Gillies' evidence unquestionably establishes that Fox Corporation has brought to prominence the word BRAVEHEART. I have no doubt that it is, at present, a word that most Australians will know, and they will understand it to refer to the film produced by Fox Corporation recounting the adventures of a hero called BRAVEHEART. Fewer, perhaps, will have the name William Wallace at their fingertips. This, however, is not trade mark use. Fox Corporation has not used the word BRAVEHEART for the purpose of showing connections between it and its products. It has not used the term as a sign to indicate the trade source. It has used BRAVEHEART as the title of a film, and as the title of the main character in that film. It has used it in the title of a book about the film, and it is used to name the soundtrack of that film. BRAVEHEART has, to be sure, been featured on souvenir items (solid pewter tankard mugs, letter openers with leather cases, T-shirt, backpacks) but rather than use intended to distinguish these goods from like goods provided by other persons, Ms Gillies says that this was merchandise ... *used to promote the BRAVEHEART film at the time that it was released in theatres.* BRAVEHEART, as is usually the case with merchandising, was used on these souvenir items to capitalise upon and promote the successful principal product. Nowhere, however, in the Fox Corporation evidence, do I find BRAVEHEART employed as a badge of origin.

In sum, I have found no evidence that Fox Corporation has used the word BRAVEHEART as a trade mark, and I therefore find that it has no supportable claim under section 58 of the Act.

I dismiss the section 58 ground.

Section 60

The Law

Section 60 of the Act reads as follows:

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 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.

To support this ground, the opponent, Fox Corporation, must first be able to point to a trade mark which, prior to the relevant date (28 July 1997), had an established reputation. Once that has been shown, the question of deception or confusion may be assessed.

Fox Corporation here fails at the threshold. It has shown, as I discussed under the section 58 ground, that it produced a famous film called BRAVEHEART and that it used the name of that film in extensive promotional activities. Fox Corporation's evidence, however, has not shown the existence of any trade mark comprising the word BRAVEHEART or any use of such a trade mark either before or after the relevant date.

As Fox Corporation cannot point to a trade mark which has acquired a reputation, I find that the section 60 ground cannot be made out.

Decision

I have found that one of the grounds, the section 43 ground, has been established. Consequently I find that the opposition to trade mark application 740114, the words BRAVEHEART THE MUSICAL in classes 25 and 41, should not proceed to registration. I refuse to register this trade mark.

Costs

Fox Corporation has succeeded in its opposition, and there is no reason why it should not be awarded costs. I therefore order that Mr Durkan pay the costs of the opponent. Payment will be in accordance with the Official Scale (Schedule 8 of the *Trade Marks Regulations* 1995). On application the costs will be taxed and allowed by an officer of the Trade Marks Office, appointed for that purpose.

Helen R. Hardie
Deputy Registrar

19 January 2000