TRADE MARKS ACT 1995

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

Re: Opposition by Brenda Lomas to application under section 92 of the Act by WM Productions Pty Ltd to remove trade mark number 749100 (classes 29, 30, 31, 35 and 42) - **WALTZING MATILDA** - in the name of Brenda Lomas.

DELEGATE:	**Terry Williams**
REPRESENTATION:	**Removal Opponent: Sue Chrysanthou of counsel, instructed by Paul Nass, solicitor** **Applicant: Peter Fisher of Fisher Adams Kelly, patent attorneys**
DECISION:	**S 92 opposition: removal appn fails for lack of standing – general comments on evidence of intentions, effect of non-use, effect of court proceedings.**

Background

1. Ms Lomas is the owner of registered trade mark number 749100, for the trade mark WALTZING MATILDA. This trade mark is registered in classes 29, 30, 31, 35 and 42, as follows:

   (class 29) Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; foodstuffs and prepared foods included in this class.

   (class 30) Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; biscuits and cakes; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; foodstuffs and prepared foods included in this class.

   (class 31) Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

   (class 35) Services in class 35 namely, advertising; business management and administration; accountancy; franchising and licensing services including the appointment of franchises and licensees and the conduct and management of same; retail and wholesale services relating to acquisition, supply and sale of foodstuffs, beverages and groceries; statistical analysis; information surveys and marketing research; publicity press releases and supervision of promotional campaigns; consultancy services in regard to the above services.

   (class 42) Services in class 42 namely, the establishment, operation and conduct of outlets, venues and facilities for the supplying and provision of meals and refreshments, including restaurants, cafes, food outlets, meal

> rooms, dining venues, eateries, cafeterias, canteens, snack bars, takeaway stores and fast-food outlets; providing foodstuffs and beverages to the said outlets, venues and facilities; catering services; advisory and consultancy services pertaining to the said services.

2. WM Productions Pty Ltd -(WMP), for its part, is the owner of certain other registrations for the trade mark WALTZING MATILDA, two of which are prior to Ms Lomas' and which are in classes 32 and 33. WMP argues that those registrations give it standing as a person aggrieved by Ms Lomas's later registration. Reliant on that standing, WMP has applied to remove Ms Lomas's trade mark from the register. WMP has used the provisions of s 92(4)(a) and (b) to do this, alleging respectively that Ms Lomas's trade mark:
   - was registered without an intention to use it in trade in good faith, and that it has not been so used, up to 29 June 2004 ("the critical date") and
   - has not been used in trade in good faith in the three year period ("the critical period") ending 29 June 2004.

3. Ms Lomas has opposed removal of the trade mark and filed and served a copy of her evidence in support of the opposition. I was assigned to hear the parties and what follows is my decision.

4. At the hearing, WMP was represented by Peter Fisher, patent and trade mark attorney, of the attorney firm Fisher Adams Kelly. Ms Lomas was represented by Sue Chrysanthou of counsel, instructed by Paul Nass, solicitor.

Context of the dispute

5. Ms Lomas is the successful protagonist of *Lomas v Winton Shire Council*[1]. Ms Lomas was able to register the now-attacked trade mark only after an appeal to the Full Court of the Federal Court upheld the initial decision in the Trade Marks Office, allowing registration of her application in the face of an opposition by the Winton Shire Council. There was also a second unsuccessful opposition to registration, filed by a third party[2]. While Ms Lomas' registration has a priority date of 20 November 1997, reflecting the date of filing, it was not actually put onto the register until 9 May 2003, ie slightly more than a year before the critical date.

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[1] [2002] FCAFC 413; (2003) AIPC 91-839

[2] Jolly Swagmen Pty Ltd. This was the company that applied to register the now-registered trade marks on which WMP relies for standing. WMP is now registered as owner of these, by assignment.

6. WMP, for its part, has filed no evidence at all other than the declaration supporting the non-use application. There is no evidence about the nature, activities, interests or intentions of WMP. WMP, in written submissions supporting Mr Fisher's arguments, has said that it intends to rely "purely on the facts". The fact in question is that WMP owns two trade mark registrations, both prior to that of Ms Lomas, and one other that is subsequent in priority. The prior registrations cover goods as follows:
   - Trade mark registration 218783: "All goods in class 32". These include beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
   - Trade mark registration No 228232: "Wines, spirits and liqueurs".

7. WMP has a third registration, 799002. That registration is mentioned from time to time in Mr Fisher's written submissions. It has a later priority date than the one now attacked.

8. Ms Chrysanthou has not at any stage objected to Mr Fisher's reliance on these registrations, though disputing that WMP has standing. I will proceed on the basis that the existence of the registrations is established.

Ms Lomas' Evidence in Support.

9. In her evidence in support of the present opposition, Ms Lomas has declared that at the time of filing she intended to use the trade mark for "establishing restaurants to serve wholesome Australian food … (and) … to licence out the trade mark to manufacturers of Australian products that reflect Australian culture". Again, she has declared to the drawing up of plans for a restaurant. However "my plans for the use of the mark were hindered as a result of the opposition proceedings that did not finalise until 2003". Ms Lomas commissioned a consultant, Dredge & Bell, to finalise the plans for a themed restaurant, as part of a Waltzing Matilda Tourist and Recreation Centre. Dredge and Bell wrote to confirm, in October 2004, instructions to work towards early commencement of this centre.

10. Confusingly, Ms Lomas asserts that in 2000 a "builder" (Total Project Services) had been engaged "to begin working on the buildings". However, the invoices from the firm in question relate to feasibility studies and the relocation of a business from Sydney. They do not appear to have anything to do with construction.

11. The Council-approved development permit for the site is in evidence. It dates from 1999. The development permit describes the then-proposed use as “college, natural remedies processing and distribution centre”. Ms Lomas declares that “the proposed location for the WALTZING MATILDA restaurant is marked 3” on the Council-approved building plan, which is also in evidence and shows an approval date of 6 April 2001. While a portion of the plan is so marked, this is done in pencil and felt-tipped marker, and the numeral 3 is on a portion of the plan indicated (at the time the plan was drawn) to be “future urban zone”. The only buildings shown are marked “training”, “administration”, “distribution”, “manufacturing”, “warehousing” and “student accommodation”.

12. Be that as it may, more recently, in November 2004, Maccheroni Contructions Pty Ltd wrote to Ms Lomas, confirming that it was currently engaged to complete the construction of, apparently, “a new $8,500,000.00 corporate centre which will house the head quarters of some five different companies of which the Waltzing Matilda company is one. The new corporate centre should be completed by mid 2005.”

13. Overall, Ms Lomas’s declaration does not show that any more than planning and discussions had taken place up until the critical date. A certain amount of discussion has gone on as to the mock-up labelling of tea, and the sourcing of other products from Australian-owned companies. There was a mock-up for the menu for the restaurant etc. Clearly, ideas were shared between Ms Lomas, those of her family involved in her project and others. However, the evidence does not show me anything that amounts to the offer for sale of any goods or services under the trade mark. There is no sense of a definite offer to trade in anything, so much as of a person seeking advice and assistance and preparing options for, at some future time, using a trade mark.

14. This is reflected in some of the contradictory elements in the evidence that I have noted above. Mr Fisher was also critical of the evidence of Steve Lomas, a web-site designer. Mr Lomas has created “simple menus for restaurants” and attests that the designs annexed to his declaration were created in 1998 and 1999. However, as Mr Fisher noted, the company name ascribed to the designs contradicts this, as there is other evidence that shows that this company did not exist until late 2003. Ms Chrysanthou argued that the two details were not incompatible, in that the later

company name was (perhaps) simply an addendum to the original design. She may well be right but Mr Lomas' language is quite plain and the need to apply such a gloss to what is ostensibly a plain statement about a simple document does not reassure me about the accuracy of the material before me. Be that as it may, the creation of a menu is a long way from the operation of a restaurant.

Issues

Standing

15. For WMP, the first hurdle is its standing as a person aggrieved. If WMP has not shown that it is so qualified, the application must be refused.

16. Mr Fisher's argument is that WMP has standing by virtue of being the registered owner of trade mark registrations 218783 and 228232. He noted relevant authorities and agreed that his client must be "appreciably disadvantaged in a legal or practical sense". He conceded that standing needs to be extant at the time the application is made, see *Kraft Foods Inc v Gaines Pet Foods Corp*[3]. Also *The Ritz Hotel Ltd v Charles of the Ritz Ltd*[4]. The importance of standing has been emphasized in *Kowa Company Ltd v N V Organon*[5].

17. Mr Fisher went on to argue that the registration of 749100 in the face of WMP's registrations offends against s 44(1) and (2). All of the necessary elements were established, he said: priority of application, substantially identical trade marks and, in his view, similar goods and/or closely related services. Consistently, he argued that, but for the protection granted her by the terms of her registration, Ms Lomas would be infringing WMP's registrations. As regards the earliest of WMP's registrations, I take this to be no more than another aspect of the question that arises under s 44(1) and (2).

18. 799002 becomes something of an issue here. It too is owned by WMP. It covers a disparate range of goods and services: goods in classes 2, 3, 5, 12, 14, 15, 18, 22, 23, 28, 32, 33 and 34 and services in class 42 including, inter alia, accommodation services. However, since it has a later priority date than the trade mark registered by Ms Lomas, it can raise no question of potential s 44 conflict against Ms Lomas' trade

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[3] (1996) 34 IPR 198 at 206
[4] (1987) 88 ALR 217 at 255
[5] [2005] FCA 1282

mark. Mr Fisher did not press the infringement argument in relation to 799002, but mentioned it in his oral submissions.

19. Ms Chrysanthou argued that history was against WMP. Its opposition[6] to the registration of 749100 had failed. The state of the register and the outcome of various opposition proceedings do not show any conflict at all, she said.

20. Mr Fisher's written arguments focus on the prospect of use of WALTZING MATILDA by Ms Lomas in relation to restaurants and bottle shops trading under the WALTZING MATILDA banner. This, he said, would be likely to give rise to a tangible likelihood of consumer deception occurring, vis a vis the products of WMP. He said that this was a real and significant issue, not a mere possibility.

21. At the hearing, he noted the decision of Spender J in *Winton Shire Council v Lomas*[7] did not fully consider the issue of a conflict between restaurant services and beverages. To quote, however:

> [55] (after noting the earlier authority of *Registrar of Trade Marks v Woolworths*[8])
>
> The only services of relevance in this context are those relating to the conduct of outlets for the supply and provision of meals and refreshments. The registered goods are beverages, purchased for domestic or restaurant use. Outlets for the supply of meals and refreshments are a catering service where food is prepared and beverages are made available to be consumed on the premises of the outlet. Are beverages goods which are "closely related" to a catering service, where food and beverages are made available to be consumed on the premises? The goods and the relevant services have different trade channels.
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> [56] The question is not without difficulty but, on balance, I am not satisfied that the operational outlets for the supply and provision of meals and refreshments should be considered as being "closely related" to the registered goods, namely beverages.
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> [57] I should note also that the only submission on s 44 of the Act in the written submissions of the applicants is "The goods sought to be registered under the opposed application are similar or closely related goods to the goods sought to be registered under the [Jolly Swagmen] application". In my opinion, the goods sought to be registered under the opposed application being those set out in classes 29 and 30 are not similar or closely related to the goods in the "Jolly Swagmen" marks, being goods in class 33, and class 36.

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[6] Strictly, the opposition was not filed by WMP.

[7] (2002) 56 IPR 72

[8] (1999) 93 FCR 365 at 378; 45 IPR 411 at 424, at [38]

22. The reference to Jolly Swagmen *application* is difficult to understand[9] and should, I think, be a reference to the registrations to which Spender J had already referred. Those two trade mark registrations, 218783 and 228832, are now owned by WMP.

23. It may be true that, as Mr Fisher argued, the matter was not thoroughly argued before Spender J. However, his comments must carry due weight. Again, as Ms Chrysanthou noted, the matter was subsequently argued before Hearing Officer Iain Thompson, when a third party failed in its attempt to oppose registration of Ms Lomas' application.

24. Hearing Officer Thompson said:

> The Jolly Swagmen goods can be generally categorised as being alcoholic beverages. Such goods are not made by the same traders as those who make the meat, fish, poultry and game, etc products as those in Class 29 of the opposed application. Neither are what could be categorised as general groceries in Class 30 normally made in the same places as the alcoholic beverages of Jolly Swagmen. The same can be said of the Class 31 goods of the opposed application which, by and large, have their origins in plant nurseries, market gardens and the like whereas alcoholic beverages look to their genesis in distilleries, breweries or at a winery. Alcoholic beverages are sold over different counters to the opposed goods: indeed, in some Australian Sates, they cannot legally be sold through the same premises.
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> Turning to the services of the opposed application, it is difficult to view the services performed in cafes and the like as being usually viewed as being seen by the normal person as directly connected with, or as a trade source for, alcoholic beverages. Whilst it is true that eateries such as cafes might provide alcoholic beverages with a meal, such establishments do not, normally, function as a source for such goods. Were it to be argued that a person might well view a wine bearing the trade mark WALTZING MATILDA as being the house-wine of an eatery called WALTZING MATILDA, such argument could be countered with the observation that it is not normal for eateries and cafes to present house-wines for consumption in the establishment in labelled bottles nor to have wines made for them. The logic of such argument appears to be more appropriate to section 60 of the Act and to depend in large part on the reputation of the wine or the eatery in question. Thus, the goods of the opponent and the services of the applicant are not closely related.

25. Mr Fisher addressed this by a survey of decisions – mostly of delegates of the Registrar of Trade Marks - that tended in the other direction. However, now is not the

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[9] The reference came about by way of a corrigenda to the original decision. The subsequent reference to class 36 is inexplicable.

time to redress what Mr Fisher might see as a fault in the state of the register. At the hearing, he argued that the present matter should not be seen as an attempt to revisit past opposition issues. However, I think that is precisely what WMP is attempting to do. It has served no evidence showing that it intends to use the trade mark WALTZING MATILDA at all. WMP then proceeds to argue that it is aggrieved because, were it not for the existence of her own registration, Ms Lomas would be an infringer. This is circular reasoning. The actions of Ms Lomas, either within or outside the scope of her trade mark registration, can only cause WMP to be aggrieved if there is some real and practical conflict of action. Were it correct to say that the mere existence of the rights given by a registration could establish some other person as a person aggrieved then *Gaines*, supra, would probably not have been decided as it was. In *Gaines*, Sackville J delivered the decision of the Full Court of the Federal Court, upholding the decision of Hill J on the same issue. Sackville J noted, at p 210:

> It may be that, for practical reasons, examiners are unable, at the stage of report, to go behind an application to probe whether the applicant in truth has used or intends to use the mark. But that is a very different matter from suggesting that the TM Act intends to confer the status of a person aggrieved upon an applicant for registration, regardless of whether the applicant has shown that it has used or intended to use the mark. Other sections of the Act reinforce the point that an applicant for registration, or a registered proprietor who does not intend to use a mark, is liable to have registration defeated or expunged: TM Act ss 49(1), 23(1).

26. The reference there to a registered proprietor who does not intend to use his mark suggests to me that I should read the plain words directed at applicants for registration as being also applicable to registered owners. The view on the former subject could not be clearer:

> It follows that the only evidence from which it might be inferred that Kraft intended to use the mark in June 1989 was the filing of its application for registration on 22 June 1989. The filing of the application, of itself, does not necessarily require an inference to be drawn that the applicant intended to use the mark. If the application had been accompanied by a clear statement of such an intention, the position is likely to have been different. But Kraft's application was accompanied by a statement of user that carried no probative weight in the present proceedings on the issue of intention to use. The evidentiary significance of the filing of Kraft's application must be assessed by reference to the totality of the evidence (or lack of it) before the trial judge. Having regard to the matters to which I have referred, Hill J was, with respect, plainly right in concluding that the evidence fell well short of establishing that in June 1989 Kraft had used or intended to use the mark. Such a finding

> precludes Kraft from establishing that it is a person aggrieved by the registration of Gaines' mark on the ground that it had used or intended to use an identical or similar mark.

27. Accordingly, the removal application must fail because WMP has not established that it has the necessary standing. I regret that the weight of established cases leaves me no alternative but to refuse to consider the application further.

General comments on substantive matters

28. This removal application must fail at the threshold, in relation to both s 92(4)(a) and (b). However, in the hope that the parties and others will gain some benefit from my opinions on the other aspects, I will note my views on the substantive matters.

Grounds under s 92(4)(a)

29. To successfully establish a ground of opposition here, Ms Lomas must validate both her intention to use the trade mark when she made application to use it, and establish bona fide use before the critical date.

30. The evidence before me, were I able to consider it, would tend to support findings that Ms Lomas might perhaps have intended to use the trade mark for some, as distinct from most, of the goods specified in classes 29 and 30. As Mr Fisher argued, the evidence is somewhat vague. Ms Lomas' attitude to, inter alia, vinegar or rice or salt is completely unknowable. Did she really intend to trade in cocoa? What resolve and settled purpose had she in relation to artificial coffee? She has declared that she "intended to licence out the trade mark to manufacturers of Australian products that reflect Australian culture". But, aside from this, she says little. Ms Lomas is under an onus to establish her intentions more clearly than this. The onus itself is not high[10] but Ms Lomas' evidence is well short of the necessary standard. Her application for registration nominated a wide variety of foodstuffs and she has not addressed the details of any of them. It is hard to see what she has in mind by a reference to "Australian products that reflect Australian culture". I am left with the overall impression that Ms Lomas had a main focus on her proposed restaurant or restaurants, and filed her application in a number of goods classes, covering a wide range of

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[10] See *Structureco Inc v Starite Distributors Pty Ltd* (2000)ATMO 31; *Lifinia Pty Ltd v Zero International Holding GmbH* (2001) ATMO 106. Also my own preparedness to infer intention where there was actual use shortly after filing: *Camiceria Pancaldi & B Srl v Le Cravatte Di Pancaldi Srl* [1999] ATMO 12.

foodstuffs of very diverse natures, in nothing more than the hope that, if things went well, someone *else* might intend to use "her" mark.

31. Steve Lomas gives evidence about a proposed website that is "designed to address the use and/or licencing of all products in all Mrs Lomas's categories and is pending release". This dates from 2005 and was still not released at the time of his declaration. It can shed little light on Ms Lomas' intentions at the time she filed her application to register the trade mark. Mr Lomas declares that he made his first telephone calls researching possible trade mark use in the meat industry in "early 2004". The same comments apply.

32. Ms Natalie Lomas, the third declarant to give evidence, also gives evidence that, while credible, is not directly to the point. She has worked in various roles in companies owned by Ms Brenda Lomas, her grandmother, since 1999. This, of course, is two years after her grandmother filed the application to register the WALTZING MATILDA trade mark. Be that as it may, Natalie Lomas gives evidence of engaging a designer to create the Waltzing Matilda logo in 2000. She refers to an intention to market "our product" BILLY TEA. However, when she discovered later that year that the trade mark BILLY TEA was already registered, plans – whatever they may have been - were changed, apparently forthwith. The trade mark usage in evidence is no more than early drafts of possible prototypes. It appears that matters have still not advanced beyond that point.

33. Consistently, I see no evidence that would show that Ms Brenda Lomas had ever turned her mind to any particular goods in class 31. Her registration in that class is in the most general terms. It is a particularly long bow to suggest that a registration in respect of foodstuffs for animals could be supported by this evidence, let alone a registration in respect of live animals.

34. I have a similar doubt as to the intentions of Ms Lomas in regard to class 35. For example, Ms Lomas has evinced no intention to trade as an accountant – as opposed to keeping accounts for her own purposes. Similarly, while she appears to have intended to franchise her restaurant's trade mark, this does not show any intention to trade in "franchising and licencing services". The evidence is, as I have noted, vague

at the best about any intentions Ms Lomas might have had to otherwise act as a retailer or wholesaler. Similar comments apply to class 42.

35. Ms Chrysanthou relied on some very general remarks from Fullagar J in *Aston v Harlee Manufacturing Company*[11]:

> A manufacturer of (say) confectionary would, I should suppose, be entitled to register three trade marks in relation to confectionery, though he intended only to use two of them and had not made up his mind as to which two he would use. If he in fact does not use any of them for the period specified in s72 the unused mark or marks may be expunged under that section.

36. I do not think that this is necessarily an absolute guide in relation to the allowable width of an application. Even if it were, Ms Lomas' application covers a range of goods far wider than a possible "two out of three rule" might imply.

37. As to actual use, there has been none. Ms Chrysanthou, at the hearing, argued that most of the activities referred to by Brenda, Natalie and Steve Lomas amounted to use of a trade mark. However, I do not accept this. There was none of the certainty referred to in *Woolly Bull Enterprises Pty Ltd v Reynolds*[12]. In that case, Drummond J drew a distinction between discussions with a potential user of the trade mark and actual use of the mark in question. Mr Burmingham, the owner of the trade mark registration in *Woolly Bull*, had got to a point that appears to have been more advanced than anything mentioned in the Lomas declarations. In *Woolly Bull*, Drummond J first noted the decision of Deane J in *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)*[13]: (my own emphasis added)

> The cases establish that it is not necessary that there be an actual dealing in goods bearing the trade mark before there can be a local use of the mark as a trade mark. It may suffice that imported goods which have not actually reached Australia have been offered for sale in Australia under the mark... or that the mark has been used in an advertisement of the goods in the course of trade:... In such cases, however, it is possible to identify an actual trade *or offer to trade in the goods bearing the mark or an existing intention to offer or supply goods bearing the mark in trade*."

38. Drummond J continued, again with my emphasis added:

[11] (1960) 103 CLR 391 at 401
[12] [2001] FCA 261
[13] (1984) 156 CLR 414; 56 ALR 193; 3 IPR 545

The applicants, in my opinion, misunderstand what Deane J said. **…** Where an overseas trader has in some way committed goods for export to Australia, eg, by actually shipping them or by earmarking them for export in some other way, there will be actual trade in the marked goods in Australia sufficient to show use of the mark here where the foreign goods have been offered for sale in Australia under the mark, though none have yet arrived here. Further, where such a commitment of the goods has occurred, there will be "an existing intention etc", sufficient to show use of the mark in Australia where the mark has been used, in advertising in this country their future availability for purchase here, though none of the goods earmarked for export to Australia have yet arrived. *Deane J did not say that a subjective intention of the owner of the mark to use the mark in trade at some time in the future was, without more, sufficient to show use of a mark. What he said was that such an intention, if accompanied by objective proofs of that intention in the form of evidence of action by the mark owner to commit goods bearing the mark to actual trade in Australia, would suffice to show use of the mark here at the time in question, though no marked goods had yet been offered for sale in this country.*

[21] McGarvie J[14] understood Deane J's dictum as being to this effect in *Settef*. One issue there was whether an Italian company, Settef, had used its "Riv-Oland" word mark in Australia before 1978 so as to become the proprietor of the mark here and thus entitled to the registration of the mark which it obtained in 1978. McGarvie J said at 417–18:

"I consider that it follows from the authorities that a mark is used as a trade mark *only if it is used with a view to facilitating or promoting the operation of a trading channel which in a business sense had already been opened to Australia*. The mark must be used for the purpose of trade... The forwarding of samples and brochures [in 1967] is not sufficient to indicate that Settef was ready and willing to fulfil such orders as it received from Australia. The purpose of these items may well have been to ascertain whether there was a market in Australia sufficient for it to be worthwhile for Settef to export here. Use of the mark in such preliminary activities would not be a use in the course of trade: *Moorgate Tobacco Co Ltd v Philip Morris Ltd*" (supra)

39. Drummond J went on to note, and with my own italics added for emphasis:

In *Buying Systems (Aust) Pty Ltd v Studio Srl*[15], the question was whether Buying Systems had used the mark (the word "Studio" in relation to fashion and hairdressing magazines) prior to the use of that mark by Studio SRL so as to defeat the latter's claim to registration as proprietor of the mark within s 40 of the 1955 Act. The critical date was 8 December 1983. In the period September to November 1983, Grand, the principal of Buying Systems, decided to set about publishing a new fashion magazine under the name "Studio Collections". He had business cards and

[14] *Settef SpA v Riv-Oland Marble Co (Vic) Pty Ltd* (1987) 10 IPR 402; AIPC 90-516

[15] (1995) 30 IPR 517; (1995) AIPC 91-119

letterheads with the word "Studio" printed. He contacted potential advertisers and solicited advertisements for the new magazine. Two of the organisations approached in this period ultimately took up advertising space in the first issue, which appeared in mid-1984. Gummow J concluded at 520:

[27] These steps amount to sufficient activity by the opponent to produce the result that [Studio SRL] the applicant for registration at the date of its application on 8 December 1983 could not accurately put itself forward as claiming to be proprietor of the relevant mark. The activities of the opponent were sufficient to constitute a relevant use of the mark in Australia for the purpose of indicating or so as to indicate a connection in the course of trade between it and the new magazine. This is not a case where those activities occurred without any existing intention to offer or supply the magazine in trade. The case is quite different from activities of the nature discussed in *Moorgate*.

[28] Buying Systems not only had an existing intention to trade in the magazine, it had gone beyond making preliminary arrangements to use the mark by December 1983. It had an objectively ascertainable commitment to offering to supply the magazine in trade demonstrated by its having purchased and used appropriate business cards and letterheads in connection with the proposed offering of the magazine and by having solicited advertisers for the magazine. *(In the absence of evidence as to the subsequent publication of the magazine, however, it may well have been difficult for Buying Systems to satisfy the court that, by December 1983, it then had an intention to offer or supply goods bearing the mark in trade and had done things sufficiently unambiguous to objectively show that it had that intention.)*

40. In relation to the sale of goods, I regard all of the activities set out in the Lomas declarations as being no more than hypothetical speculations, very far short of the actions considered in *Buying Systems*, supra, and well short of the standard set by Deane and Drummond JJ.

41. Steve Lomas has attended some meetings with government representatives, and "shared his ideas at length". He has had discussions with meat suppliers. Natalie Lomas has designed a label for tea, and "discussed production of products for the Waltzing Matilda Brand. The products included canned fruits, tea, biscuits and health bars". She then lists nine suppliers to whom she spoke in or about June and July of 2001. It could not be said, from the limited details available, that any of these discussions were an attempt to persuade a supplier to provide products, or to interest it in the provision of products. Nor, critically, is it apparent from the evidence that there was any serious preparedness on the part of Ms Lomas or her relatives to progress the

matter at that time – rather, because of Ms Lomas' attitude to the opposition that was on foot, it would seem just the opposite.

42. Overall, there is a conspicuous lack of clarity of the dealings and intentions in regard to the goods and services. It is also clear that the trade mark has not been used, at all, in the sense required by the decisions from which I have quoted. In view of that, the registration would, in my view, have been liable to be removed if WMP had established its standing, but subject to the comments that I will make, later, under the heading of "other".

Ground under s 92(4) (b)

43. The critical three-year period for s 92(4)(b) ended on 29 June 2004. As I have already explained, I do not think that Ms Lomas can rely on any of the actions set out in the evidence as being actual use of the trade mark.

Other

44. I do not need to consider if the litigation involving Winton Shire Council and, separately, a third-party opposition to registration are circumstances within s 100(3)(c). I am inclined to think that, while not necessarily within the limits specified in *Woolly Bull*, supra, they may be an example of a similar species. Certainly, they go to circumstances of a trading nature since what was at issue was a claim by a third party that Ms Lomas was not entitled to register her trade mark because that other party had a superior title. It would be insufficient, in a context of litigation that goes as far as an appeal to the Full Court of the Federal Court, to say that a trade mark need not be registered to be used. That is obvious but stands beside the point. I think that the existence of such protracted and hard-fought litigation would be, "in a practical business sense", a powerful incentive for a party that had not yet ventured to use its trade mark to put off such action. At the very least, such circumstances might comprise a sufficient case for my exercising my discretion to leave the mark on the register in respect of restaurant services. However, it is not at all clear from the evidence that, to quote from *Woolly Bull*, supra, "the mark would have been used during that part of the three year period but for the existence then of the obstacle." Ms Lomas' evidence is perhaps suggestive, without being overly convincing. It would not be safe to venture a finding on the basis of the unclear material that I have before me.

45. However, that alone is not the end of the matter. The opposition proceedings reached an end in May 2003, slightly more than a year before the critical date. The evidence, on the other hand, shows that the trade mark still remained unused up until at least as late as January 2005, when Ms Lomas made her declaration. This is a considerable period of time and it has passed without any evidence of use at all, on any goods or services. This fact would tend to weigh against any favourable inference under s 100(3)(c). Similarly, it does not suggest that, per s 101(3) it "would be reasonable" to leave an otherwise unused mark on the register. While I note the caution sounded by Lander J, in *Kowa*, supra, that the circumstances in question need not be exceptional, Ms Lomas has been aware of the removal application at all material times and is under a clear onus to better justify retaining her trade mark.

46. Ms Chrysanthou argued that at least some of the delay was due to the third-party opposition, with the trade marks in question now being the property of WMP. On that basis, she argued that there was a public interest in not allowing WMP to profit from the failure, when the direct result of the opposition had been to frustrate Ms Lomas' plans. This argument would be more readily supported if there was a better explanation as to why the time since May 2003 has not resulted in use.

Conclusion

47. Despite the views I have expressed on the arguable substantive merit of the application, it must fail at the threshold. I refuse to remove the trade mark for any goods or services. I direct that WMP pay the costs of Brenda Lomas up to the amounts set in the scale.

Terry Williams
Hearing Officer
Trade Marks Hearings
31 October 2005