

TRADE MARKS ACT 1995

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

Re: Applications 765075(25) THE WIZARD OF OZ HEMP CO & DEVICE; 800208(31) THE WIZARD OF OZ PET FOOD COMPANY & DEVICE; 818213(16) THE WIZARD OF OZ CARD CO & DEVICE; and, 918093(43) THE WIZARD OF OZ HOLIDAY FARMS & DEVICE; to register trade marks by Yo-Merry Todd and opposition thereto by Turner Entertainment Company

And

Applications 927055(29, 30) THE WIZARD OF OZ FANTASTIC FOOD CO & DEVICE; 934712(32) THE WIZARD OF OZ DRINKS CO & DEVICE; 946065(5 & 31) THE WIZARD OF OZ; to register trade marks by Yo-Merry Todd and opposition thereto by Turner Entertainment Company

And




Applications 951800(39) THE WIZARD TOUR CO & DEVICE; 973832(33) THE WIZARD OF OZ DRINKS CO & DEVICE; 973833(18) WIZARD OF OZ TIMBER & LEATHER CO & DEVICE; and, 1006339(3, 4, 21, 22, 34) WIZARD OF OZ & DEVICE to register trade marks by Yo-Merry Todd and opposition thereto by Turner Entertainment Company.




DELEGATE:	Iain Thompson
REPRESENTATION:	Applicant. Was not represented, did not appear or file written submissions Opponent: Julia Baird of Counsel instructed by James Maxwell of Peter Maxwell & Associates
DECISION:	33 ATMO 2007 1. s52 proceedings – grounds under sections 42, 43 and 60 in relation to all oppositions; section 44 in relation to 918093(43), 934712(32) and 973832(33); section 58 in relation to 765075(25), 818213(16), 927055(29), 973833(18) and 1006339 (in Class 21 only). Outcomes as discussed in decisions. 2. No costs order.




Background


1. Yo-Merry Todd ('the applicant') of Sandgate, Queensland, has filed applications, as grouped above, to register eleven trade marks, current details of which are:


Yo-Merry Todd Application details		Notice of Opposition served and filed:
App No:	765075	30 Sep 1999
Priority Date:	17 Jun 1998	
Goods/Services:	Class 25: Clothing, headgear	

Yo-Merry Todd Application details	Notice of Opposition served and filed:
<p>Trade Mark:</p> 	
<p>App No: 800208 Priority Date: 14 Jul 1999 Goods/Services: Class 31: Range of pet foods Trade Mark:</p> 	1 Aug 2000
<p>App No: 818213 Priority Date: 23 Dec 1999 Goods/Services: Class 16: Paper, cardboard and goods made from these materials; printed matter; bookbinding material; photographs; stationery; playing cards; plastic materials for packaging; artist's materials; paint brushes; adhesives for stationery or household purposes Trade Mark:</p> 	11 Sep 2000
<p>App No: 918093 Priority Date: 1 Jul 2002 Goods/Services: Class 43: Holiday farms - providing food, drink and accommodation Trade Mark:</p>	22 Jan 2003

Yo-Merry Todd Application details	Notice of Opposition served and filed:
	
<p>App No: 927055 Priority Date: 16 Sep 2002 Goods/Services: Class 29: Jellies, jams, milk products, products made from dried and cooked fruit, vegetables and vegetable products, meat extracts other products including meat, fish, poultry and edible oils Class 30: Confectionery, ices, yeast products, products using baking powder, condiments, sauces, preparations using flour and cereals, breads, pastries, honey, treacle, coffee, tea, cocoa, sugar, rice, sago, tapioca and preparations made from these Trade Mark:</p> 	11 Apr 2003
<p>App No: 934712 Priority Date: 19 Nov 2002 Goods/Services: Class 32: Range of non-alcoholic drinks - including mineral waters - aerated waters and drinks, cordials, fruit juices, fruit drinks, soft drinks and syrups Trade Mark:</p> 	15 Apr 2003

Yo-Merry Todd Application details	Notice of Opposition served and filed:
<p>App No: 946065 Priority Date: 6 Mar 2003 Goods/Services: Class 5: Veterinary preparations; preparations for killing vermin; lotions, washes and repellents for animals, including shampoos and conditioners for dogs; additives to fodder for medical purposes; medicinal herbs; insect repellents Class 31: Foodstuffs for animals including dog biscuits; animal fattening preparations; products for animal litter; beverages for pets; fresh fruits and vegetables Trade Mark:</p> 	11 Sep 2003
<p>App No: 951800 Priority Date: 28 Apr 2003 Goods/Services: Class 39: Coach Tours Trade Mark:</p> 	5 Nov 2004
<p>App No: 973832 Priority Date: 13 Oct 2003 Goods/Services: Class 33: Alcoholic beverages Trade Mark:</p> 	24 Jun 2004

Yo-Merry Todd Application details	Notice of Opposition served and filed:
<p>App No: 973833 Priority Date: 13 Oct 2003 Goods/Services: Class 18: Goods made from leather, travelling bags, parasols, umbrellas, harness and saddlery, whips, walking sticks, animal skins, hides Trade Mark:</p> 	24 Jun 2004
<p>App No: 1006339 Priority Date: 11 June 2004 Goods/Services: Class: 3 Cleaning, polishing, scouring and abrasive preparations; bleaching preparations and other substances in this class for laundry use; hair care preparations, including shampoos and conditioners; hair colouring preparations; hair styling preparations; skin care preparations, including moisturizers; cosmetics and cosmetic kits in this class; soaps; perfumery; essential oils; ethereal essences and oils; bath salts in this class; shaving preparations, including after-shave lotions; shampoos for pets; false finger nails; dentifrices Class: 4 Greases in this class, including greases for lubricating machinery and greases for belts, boots, leather and shoes; industrial and lubricating oils; fuels including, petrol solidified gas and kerosene; candles and materials in this class for making candles, including wax and wicks; dust absorbing preparations; wetting and binding compositions Class: 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); combs including electric combs, combs for humans and combs for animals; articles in this class that may be used for cleaning purposes, including feather dusters, brooms, brushes, mops, rags and sponges; hand operated cleaning instruments; candle extinguishers; brushes for personal use; steel wool; glass in this class, including unworked or semi-worked glass; glassware, porcelain and earthenware Class: 22 Tents, awnings and tarpaulins, as well as bags for storing said articles therein; nets and twine for making nets; rope and string; packing and stuffing materials in this class, including feathers, straw and wool; padding materials in this class, including animal hair; bedding materials in this class, including feathers; carded, combed, fleece, raw and treated wool; sacks and bags in this class; sails; raw fibrous textile materials Class: 34 Tobacco and tobacco products including chewing tobacco, pipe tobacco, cigarettes, cigars, cigarillos and snuff; smoker's articles including ashtrays, cigar cases not of precious metal, cigar cutters, cigar</p>	5 Nov 2004

Yo-Merry Todd Application details	Notice of Opposition served and filed:
<p>holders, cigarette lighters, cigarette cases not of precious metal, cigarette filters, cigarette holders, cigarette papers, cigarette tips, machines for rolling cigarettes, gas containers for cigarette lighters, matches, pipe cleaners, tobacco pouches, snuffboxes, pipes and tobacco jars</p> <p>Trade Mark:</p> 	

2. Following advertisements of the acceptance of the trade marks for possible registration, Turner Entertainment Company, of Atlanta, Georgia, in the USA ('the opponent') served and filed Notices of Opposition ('the Notices') to registration of the trade marks on the dates recorded above. The opponent has served and filed evidence in support of its opposition in accordance with the *Trade Marks Act 1995* ('the Act') and regulations thereto. The applicant has served and filed evidence in answer. Details of the evidence are contained in Annex 1 to these decisions.
3. As a delegate of the Registrar of Trade Marks, I heard these matters at a hearing in Canberra at 10 o'clock on Monday, 5 February 2007. Julia Baird of Counsel, instructed by James Maxwell of Peter Maxwell & Associates, appeared for the opponent; the applicant did not appear at the hearings, nor did her legal representative, Ian Tannahill of Ahearn Fox, of Brisbane. The applicant or her legal representative did not file written submissions.
4. Shortly after the hearing, I received a facsimile letter from the applicant complaining that she had only one-week's notice of the hearing ('the notice') and requesting that the hearing be delayed until a later date – this facsimile letter was sent one hour before the hearing of the matter. A letter was subsequently sent to the applicant by Hearing Officer Williams who explained that the notice of the hearings was despatched from the Office some five weeks before the hearings, giving notice of the hearings to Mr Tannahill at Ahern Fox. The letter also advised that one-hour's notice of a request for a postponement of the hearings was insufficient, Counsel and her instructing solicitor had flown to Canberra from Sydney for the

hearing and were in Canberra at the time the facsimile letter was received, and the hearing officer had also invested time in preparing for the hearing of the matters.

5. I have also responded to the applicant's subsequent telephone call complaining that she has been denied natural justice. I stated that I am satisfied that the issue of the late receipt by the applicant of the notice is not one occasioned by the Office and her late receipt of notice of the hearings is an issue between herself and her legal representative. I will also state that, from a delegate's standpoint, a party and his/her/its legal advisor are people who stand in each other's shoes and tardiness on the part of the one in relation to such matters must be regarded as tardiness on the part of the other unless there has been some supervening event or circumstance outside of the control of those people. Such is not the case here – the applicant's legal representative has explained to me that he received the notices shortly after their dispatch by IP Australia, put them on a shelf in his office, became distracted by the Christmas break, and did not action them.
6. The applicant may take consolation from the fact that it is apparent from her evidence what her (or her legal representative's) arguments should have been and I will discuss these in my reasons as fully as I can without actively advocating for her.
7. The oppositions to the applications are grouped because the evidence in support served and filed by the opponent over the effulgence of time relates to the trade marks that occur within these groups. The evidence in answer has also naturally followed this pattern.

Evidence

8. A list of the statutory declarations served and filed in relation to these proceedings is appended at Annex 1 to these reasons.
9. *The Wizard of Oz* is the name of a motion picture musical made in 1939 by Metro-Goldwyn-Mayer Inc. It is closely based on the book *The Wonderful Wizard of Oz* written by L Frank Baum in 1900 which is regarded by many as an American classic and features such characters as Dorothy, her dog Toto, the Tin Man, the Scarecrow, and the Cowardly Lion.
10. In 1986, the opponent acquired all rights in the motion picture and its related trade marks and copyrights. The opponent has some dozen registrations of the trade mark THE WIZARD OF OZ in the USA and has a pending application (885337) in Australia, filed on 2 August 2001,

to register the trade mark THE WIZARD OF OZ in Classes 9, 16, 25, 28 and 41 of the *International (Nice) Classification of Goods and Services* for the goods and services:

Class: 9 Computer games, electronic games and educational games; computer software; apparatus for recording, transmission or reproduction of sound and images; sound and/or video recordings including records, tapes, video tapes, discs, compact discs, video discs, DVD's and CD-ROMs; magnets

Class: 16 Printed matter; instructional, teaching and educational materials; stationery; playing cards; pens; photographs; decalcomanias; stickers; coasters; trading cards; books including children's books and activity books

Class: 25 Clothing, footwear and headgear

Class: 28 Games including electronic and educational games; toys and soft toys including stuffed toys, gymnastic and sporting articles in this class; Christmas decorations; games and playthings

Class: 41 Entertainment services, being production and distribution of motion pictures and television productions; video, radio, television and film entertainment; production of video, radio, television and film programmes; provision, production, development, presentation, networking and rental of interactive television, interactive games, interactive entertainment and interactive competition services, television, radio and telephone programmes, films, sound and video recordings; organisation, production and presentation of competitions, contests, games and quizzes, studio entertainment and audience entertainment; publication of books; presentation of live performances; amusement parks; cinema facilities; exhibitions; movie studios

11. The opponent, or its predecessor in business, MGM, has licensed broadcast rights for the motion picture within Australia, as well as related entertainments such as an animated television series called *The Wizard of Oz*. In 1996, a show called *The Wizard of Oz on Ice* toured Australia under the opponent's aegis. Additionally, the soundtrack of the songs from the musical motion picture have been sold in Australia.
12. As well as licensing or producing entertainments and recordings taken from, or derived from, the motion picture *The Wizard of Oz*, the opponent has sold or licensed a number of goods in Australia under the trade mark THE WIZARD OF OZ. The opponent is the franchisor of the 'Warner Bros Studio Stores' in Australia. These stores are located at Sydney, Melbourne, and at Warner Bros Movie World – a theme park on the Gold Coast.
13. The opponent has sold mouse pads, figurines, soft toys, drinking glasses, drinking mugs, keyrings, and Christmas ornaments under the trade mark THE WIZARD OF OZ through its

franchised stores and licensed the sale of dolls and clothing bearing the trade mark THE WIZARD OF OZ. It is not clear when these sales started – the opponent attests that its predecessor in business used a licensing agency that now cannot locate its records. However, I am satisfied that sales of merchandise of the general character of those referred to above under the trade mark THE WIZARD OF OZ did occur within Australia before the priority date of the opposed applications.

14. The opponent also provides a service at its theme park whereby people can purchase a photograph in which their digital image is superimposed onto the ‘yellow brick road’ behind some of the characters of the motion picture under the trade mark THE WIZARD OF OZ.
15. I will further refer to the opponent’s evidence as is required in the course of my decisions.
16. The applicant states that she achieved some fame in the past for her activities as an interior decorator. My understanding is that the applicant’s business, ‘Flying Interiors’ flew workmen and materials in a DC-3 around outback Australia to renovate houses.
17. The applicant states that she arrived at the words THE WIZARD OF OZ by use of the jocular reference to OZ as indicating Australia, and her thought that the people of Australia, in particular the past clients of her ‘Flying Interiors’ business, are its ‘wizards’. The applicant states that the words were not coined with the motion picture in mind. I observe, however, that the words within the opposed trade marks are not THE WIZARDS OF OZ.
18. The applicant’s evidence shows some licensed use of the trade marks 765075(25) THE WIZARD OF OZ HEMP CO & DEVICE; and, 800208(31) THE WIZARD OF OZ PET FOOD COMPANY & DEVICE – however, the actual extent of this use as regards volume, geographical area or duration cannot be readily determined or inferred from the applicant’s evidence.
19. It is the applicant’s intent that some of the proceeds from the sales of goods under the trade marks go to establishing a holiday farm for disadvantaged children – the trade marks under 918093(43) THE WIZARD OF OZ HOLIDAY FARMS & DEVICE and 951800(39) THE WIZARD OF OZ TOUR CO & DEVICE relate to this intention.
20. I will further refer to the applicant’s evidence as is necessary in the course of my decisions.

Grounds

21. The opponent pursued grounds under sections 42, 43 and 60 of the Act in relation to all oppositions; grounds under section 44 in relation to 918093(43), 934712(32) and 973832(33); and section 58 in relation to 765075(25), 818213(16), 927055(29)(30), 973833(18) and 1006339 (in Class 21 only). For the sake of completeness, I note that other grounds mentioned in the notices of opposition have not been established.
22. It is convenient to start my reasoning with decisions under section 44 of the Act, then move to a discussion of the issues under section 58, then end with my reasons under sections 42, 43 and 60 of the Act.

Section 44

23. Section 44 of the Act relevantly provides:

44 Identical etc. trade marks

(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.

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

- (a) it is substantially identical with, or deceptively similar to:
 - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
 - (ii) a trade mark whose registration in respect of similar services or closely related goods 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 services is not earlier than the priority date for the

registration of the other trade mark in respect of the similar services or closely related goods.

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

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

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

24. To establish this ground the opponent must show to my satisfaction that it has registered or pending trade marks which:

- have earlier priority dates than those opposed ones of the applicant;
- are substantially identical or are deceptively similar to those of the applicant
- have specifications of goods or services which are similar or closely related to those in respect of which the opposed applications are made.

25. The opponent bases its opposition here upon its application 885337 filed on 2 August 2001 (detailed above) which is earlier than the priority date of applications 918093(43), 934712(32) and 973832(33), details of which appear below.

Appn No: 918093
Priority Date: 1 July 2002
Goods/Services: **Class: 43** Holiday farms - providing food, drink and accommodation
Trade Mark:



Appn No: 934712
Priority Date: 19 November 2002
Goods/Services: **Class: 32** Range of non-alcoholic drinks - including mineral waters - aerated waters and drinks, cordials, fruit juices, fruit drinks, soft drinks and syrups

Trade Mark:



Appn No: 973832
Priority Date: 13 October 2003
Goods/Services: Class: 33 Alcoholic beverages
Trade Mark:



26. It is appropriate to first discuss whether the goods and services of the opponent's application are similar or closely related to those in respect of which the opposed applications are made – see, for example, *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 where French J said:

Apposite to the present case is the question whether a retailer of various classes of goods provides a service to customers which warrants the description of the goods for sale as "closely related goods" in respect of that service. The characterisation of the relationship between services and goods in this way is evaluative. 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.

27. This logic also applies to subsection 44(1).

28. Section 14 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 goods.
- (2) For the purposes of this Act, services are *similar* to other services:
 - (a) if they are the same as the other services; or
 - (b) if they are of the same description as that of the other services.

29. There is no definition of 'closely related' goods and services.

Similar Goods

30. In relation to the consideration whether the goods of the opposed application are similar to the goods of the opponent's application, the principles enunciated in *Southern Cross Refrigerating Co. v. Toowoomba Foundry Pty. Ltd.* (1954) 91 CLR 592 by Dixon CJ at paragraph 5 of his decision:

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* (1946) 63 RPC 59 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* (1946) 63 RPC 59 , 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."

31. Having considered the goods of the applicant and those of the opponent, I am satisfied that they are not goods of the same description. They are not goods which normally originate in the same factories, nor are they distributed through the same channels, nor to the same class of customer or for the same purpose.

Closely Related Services and Goods

32. In *Aussat Pty Ltd, Re* [1993] ATMO 55, I suggested some tests which could be applied to goods and services:

In consideration of the latter point some guide-lines might be suggested and I stress that these are not in any particular order of priority:

- . are the goods and services of matching technical complexity?
- . is the technical training of the people who make the goods or provide the services the same?
- . do the people who make the goods or provide the services belong to the same unions or associations?
- . are there personnel who are implicit in the provision of the service, or a necessary ancillary to the provision of it, who are viewed by the ordinary person as having the essential expertise in common to the provision of either the goods or services? (For example, in "vehicle hire services" and the goods "cars", there are the ancillary personnel common to both, such as car detailers, mechanics, salespersons, credit checkers, and so on which give both the same flavour).
- . do the goods usually have this service as a related service agreement or package? For instance, it would be most unusual for a person buying a very expensive piece of machinery not to enter some sort of service agreement. Conversely, are the goods usually offered as part of a service agreement?
- . is the nature of the goods or the service such that they would cease to exist without each other, thus creating an expectation of a common source? (Such as "transportation services" *and* "vehicles"; or, "vehicle hire services" *and* "vehicles"; or "restaurant and take-away food services" *and* "food").
- . does the service consist of altering, matching and/or installing the goods to a customer's or client's requirements? (Such as "curtains and furnishings" *and* "the sewing of furnishings"). It must be observed that the person doing the service of sewing the furnishings is also exercising the same or very similar skills as were involved in making the curtains. Also, the installers of domestic and industrial equipment are often employed either directly or indirectly by the manufacturer.

- . are the goods and services commonly offered by the one company or organisation? (For example, "retail sales" *and* the equivalent "goods"; or, "telephone communication services" *and* "telephones").
- . are the goods a necessary adjunct to a particular service or the only tangible result of it? (For example, "advertising services" *and* "directories", or "publications"; or, "travel agency services" *and* "publications"; or "telephony services" *and* "directories").

This list of criteria is not exhaustive, neither, I think, is it necessary that all considerations be satisfied, nor do I think that any single criterion is of necessity conclusive although it may be. However, taken as a general guide these criteria build up a picture of the total of the considerations involved in assessing what are closely related goods and services. In complex cases such as oppositions, the issue may only become clear on the provision of evidence that addresses factors such as those above.

33. Although alcohol and soft drinks might be served at amusement parks, cinema facilities and exhibitions, it is not normal for traders that run such facilities to be in the business of making and distributing alcoholic or soft drinks. The personnel involved in the running of amusement parks, cinema facilities and exhibitions are different from those who are involved in the manufacture and distribution of soft drinks and alcoholic beverages. Although the drinks and entertainments might be provided at the same place, the goods and services arrived there in quite different ways.
34. I would conclude that the goods and services involved here are not 'closely related'.

Similar services

35. In *Mid Sydney Pty Ltd v Australian Tourism Co Ltd & Ors* [1998] 1616 FCA the Full Bench of the Federal Court said:

Are, then, services to be provided by Touraust services of the same description as that of services in respect of which MID's mark is registered (s 120(2)(c))? That expression in the context of services seems to have received no reported judicial consideration. This is partly because the statutory protection for trade marks used in relation to goods has been extended to trade marks in relation to services only relatively recently: see F J Smith, *"The Trade Marks Amendment Act 1978"* (1979) 53 ALJ 118. It is also a consequence of the fact that s 120(2)(c) of the Act had no precise equivalent in the *Trade Marks Act 1955 (Cth)* ("TM Act 1955"), although the expression "services of the same description as [services in respect of which the trade mark is registered]" was used in the earlier legislation: see TM Act 1955, ss 33(2), 36(1A). The question whether two sets of goods are "of the same description" has, however, been considered in a number of decisions. Thus, for example, in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 606 the High Court said this:

"There may be many matters to be considered apart from 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 or distribution they are regarded as belonging to the same trade ...'."

Similarly (in a passage cited by Burchett J in *Polo Textile Industries Pty Ltd v Domestic Textile Corporation Pty Ltd* (1993) 42 FCR 227 at 240) Lord Evershed MR said in *Re J Lyons & Co Ltd's Application* [1959] RPC 120 at 128:

"In all cases of this kind regard will be had to such matters as the nature and composition of the goods, to their respective uses and functions, and to the trade channels through which respectively they are marketed or sold; and in different cases ... one (but not always the same one) of these characteristics may have greater significance or emphasis than the others. The matter falls to be judged ... 'in a business sense'; and this is to my mind made clear by considering the legislative background against which the problem has to be judged. By the Trade Marks legislation Parliament has provided that a registered proprietor of a mark, to be used by him in the course of his trade, has a monopoly right to that mark as an indication of the trade source or origin of the goods The question whether goods are or not goods of the same description must therefore (I think) be one to be answered in the context of that purpose; and having regard to that context, the cases cited ... lend some support to the view that the phrase 'goods of the same description' ought not to be given too restrictive a construction - not, at all events, so as to be limited to goods substantially analogous in kind, or commonly used as mere substitutes or alternatives the one for the other."

We accept that these principles, subject to any necessary modification, apply in relation to services. But they do not advance MID's argument.

For reasons that have already been given, the services involved in managing an hotel have different characteristics than property management services. If, as we have held, particular incidental services take their character from the whole, the position is not altered by the fact that managing an hotel may involve the performance of incidental services akin to those carried out by property managers.

36. As I noted in *United Parcel Services of America, Inc v UTS Europe BV* [2003] ATMO 33 at paragraph 26:

Thus, what I am to consider is the intrinsic nature of the services and the trade channels through which they are delivered. I am not to be distracted by the fact that the services of the parties might have some features in common which are incidental to their essential nature

37. After close consideration of the issues involved, I consider that ‘Holiday farms - providing food, drink and accommodation’ in opposed application 918093 is intrinsically a service of the same description as the opponent’s amusement parks services. What the applicant seeks registration for is not ‘farm stay services’ but the ‘provision of food drink and accommodation,’ which I must read at their widest. The ‘market’ or potential customer, particularly in relation to amusement parks (but also in relation to exhibitions where animals are involved) is often children. The personnel involved in running holiday farms and those who run amusement parks for children are likely to be similarly trained and doing essentially the same thing for the same purpose – providing entertainments and diversions, food and drink, for their clientele.
38. However, this is not the end of the consideration – it remains to be considered whether the trade mark of 885337 is either substantially identical or deceptively similar to that of opposed application 918093.

Substantial Identity/Deceptive Similarity

39. **Substantial identity** is to be assessed by a side-by-side comparison of the trade marks. In the words of Windeyer J in *The Shell Co. Of Australia Ltd. v. Esso Standard Oil (Australia) Ltd.* [1961] HCA 75; (1963) 109 CLR 407 at paragraph 12 of his judgment:

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 identification of an essential feature depends", it has been said, "partly on the Court's own judgment and partly on the burden of the evidence that is placed before it": *de Cordova v. Vick Chemical Co.* (1951) 68 RPC 103, at p 106 . Whether there is substantial identity is a question of fact: see *Fraser Henleins Pty Ltd v. Cody* (1945) 70 CLR 100 , per Latham C.J. (1945) 70 CLR, at pp 114, 115 , and *Ex parte O'Sullivan; Re Craig* (1944) 44 SR (NSW) 291 , per Jordan C.J. (1944) 44 SR (NSW), at p 298 , where the meaning of the expression was considered.

40. I will note here that Ms Baird argued in terms of the opposition under section 58 of the Act that the trade marks are substantially identical. I consider, for reasons that will become apparent, her argument to potentially have more potency in relation to considerations under section 58. In terms of section 44, what I am to consider is the effects of the fair 'notional' use of the trade marks by the parties of the trade marks on all of the services for which registration is sought: *Re Smith Hayden and Co's Application* (1946) 63 RPC 97 at 101.8:

Assuming a use by the proprietor of each of the cited trade marks in a normal and fair manner in respect of any of the goods covered by those registrations, is the court satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if the applicant for registration (the respondent to this application) also uses its mark normally and fairly in respect of goods covered by the proposed registration.

41. One of these 'fair and normal' uses to which the parties can put their trade marks is use in advertising on television, radio, on DVDs or video tapes, or on the Internet. In these forms, the trade marks are likely to be spoken.
42. Ms Baird argued that any verbal reference to the opposed trade marks must be spoken as THE WIZARD OF OZ – thus, in speech the device component of the trade marks effectively 'disappears' and the trade marks become identical. However, this argument has limits placed upon it by section 7 of the Act which provides:

7 Use of trade mark

(1) If the Registrar or a prescribed court, having regard to the circumstances of a particular case, thinks fit, the Registrar or the court may decide that a person has used a trade mark if it is established that the person has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark.

Note: For *prescribed court* see section 190.

(2) To avoid any doubt, it is stated that, if a trade mark consists of the following, or any combination of the following, namely, any letter, word, name or numeral, any aural representation of the trade mark is, for the purposes of this Act, a use of the trade mark.

43. However, subsection 7(2) contrasts with the definitions found in sections 6 and 17 of the Act:

sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.

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.

44. The word ‘device’ is included amongst the signs in section 6 that may be trade marks in terms of section 17. However, the opposed trade mark does not consist of any letter, word, name or numeral – it consists of words and a device. ‘Device’ is not a word mentioned in subsection 7(2). So, effectively, as soon as a device (or, seemingly, any signature, brand, label ticket, aspect of packaging, shape, colour, sound, or scent) appears in a trade mark, the provisions of subsection 7(2) do not apply to it.
45. Thus, I may not consider whether the trade marks are aurally identical.
46. With those comments out of the way, it is obvious that, on any visual inspection, the trade marks of the parties are not substantially identical.
47. **Deceptive similarity** is defined within section 10 of the Act which provides:

10 Definition of *deceptively similar*

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.

48. As regards ‘deceptive similarity’, French J said in *Registrar of Trade Marks v Woolworths* [1999] FCA 1020, at paragraph 50:

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."

49. The test is not to be applied to the trade marks side by side but rather from the impression of the trade marks which is likely to be formed by the public. In the words of Dixon and McTiernan JJ in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd*, (1937) 58 CLR 641 at page 658:

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. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, their similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected.

50. All of the surrounds circumstances are to be taken into consideration, including the market context. In *Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777), Parker J 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.

51. It is pertinent to observe that it is difficult to divorce the opponent's trade mark from the renown of the motion picture THE WIZARD OF OZ. This obviously presents some difficulties for a decision maker when the test to be applied is 'the fair and normal use' of the opponent's trade mark, in terms of *Smith Hayden*, quoted above. Some consolation lies in the words of the Full Bench of the Federal Court in *C A Henschke & Co v Rosemount Estates Pty Ltd* [2000] FCA 1539 at paragraph 52:

Nevertheless, in our view, *Woolworths* suggests a proposition for which the cases on which the appellants rely may be taken as authority. It is that, in assessing the nature of a consumer's imperfect recollection of a mark, the fact that the mark, or perhaps an important element of it, is notoriously so ubiquitous and of such long standing that consumers generally must be taken to be familiar with it and with its use in relation to particular goods or services is a relevant consideration.

52. It is, I consider, practically impossible to discuss the similarities of the trade marks without reference to the motion picture THE WIZARD OF OZ, and the effects of the similarities of the trade marks to the name of the motion picture on the minds of the public.
53. Any verbal reference to the opposed trade mark will be by use of the words THE WIZARD OF OZ. The words are the only way in which the trade mark will be referred to and the prominent device of the wizard's hat reinforces the words' impact and memorability. This leads me to a consideration of the significance of the device of the map of Australia which appears in the opposed trade mark. If I understand the applicant's evidence correctly, it is the applicant's thesis that the presence of the map of Australia changes the force of the trade

mark to one which will strike people as being akin to a visual pun or rebus in which the impact of the words within the trade mark will be more akin to the words THE WIZARD OF AUSTRALIA. This could be sufficient to distinguish the opposed trade mark from the opponent's trade mark which consists only of the words THE WIZARD OF OZ and thus can only refer to the motion picture.

54. The problem with this hypothesis is that, without the motion picture as a point of reference for the applicant's trade mark, the visual play on the words becomes meaningless. The visual pun or rebus, if it is comprehended as such at all, only becomes apparent once the connection with the motion picture is established in the mind.
55. The instance before me thus has much in common with the so-called 'parody' cases. In *Southcorp Limited v Morris McKeeman* [2006] ATMO 48, I observed at paragraph 20:

The approach of the Courts in cases where parody is claimed is to consider each instance on its facts.

In *Pacific Dunlop Ltd v Hogan* (1989) 14 IPR 398; 87 ALR 14, Burchett J stated at IPR 430:

The suggestion in the present case, as his Honour found the facts, was of an endorsement of the appellant's shoes by Mr Hogan's almost universally appreciated Crocodile Dundee personality, and through that of an association between Mr Hogan and the product so endorsed. The television audience would accordingly hold the shoes in higher regard. On the evidence, some evocation of Crocodile Dundee was admittedly both intended and achieved; I do not see any basis for disturbing Gummow J's view of its true effect. That view owed much to the special nature and circumstances of Mr Hogan's portrayal of a character really indistinguishable from his own public image. It is, too, consistent with the concession made by the advertisement's author, as noted by his Honour (ALR at 410; IPR at 232), "that the intention of the advertisement was that viewers should get an impression of Crocodile Dundee in connection with Grosby shoes". I reject the appellant's attempt to avoid, by miscalling its advertisement a parody, the consequences of representing Crocodile Dundee (actually addressed in the advertisement by his name Mick) as endorsing its shoes. The essence of Mr Hogan's performance is parody, which can hardly itself be parodied, at least by what would be more accurately described as a parasitic copy -- parasitic because its vitality is drawn entirely from the audience's memory of the original. As well might an attempt to imitate "HMS Pinafore" be called a parody of Gilbert and Sullivan!

Thus, the parody, if it be such, must be of a nature that it is immediately and principally recognizable as both parody and distinct from the original and not imply some endorsement by the its owner, or a connection with the original or its

owner such that the goods would be seen by the public as originating from the owner of the original.

In *Coca-Cola Company v All-Fect Distributors Ltd (T/as Millers Distributing Company)* (1998) 43 IPR 47 Merkel J observed

An analogous commercial use, which has also been held to fall short of representing a trade or commercial connection, can arise when an imitation product is created as a parody. In *Nike Inc v "Just Did It" Enterprises* 6 F 3d 1225 (7th Cir 1993 at 1227–8 the United States Court of Appeals for the Seventh Circuit said:

Parodies date back as far as Greek antiquity ... "Parody or satire, as we understand it, is when one artist, for comic effect or social commentary, closely imitates the style of another artist and in so doing creates a new art work that makes ridiculous the style and expression of the original" ... But parodies have a legal hurdle to overcome. Federal law prohibits copies or imitations that confuse consumers ... This protects trademarks as a form of intellectual property ... and guards against confusion, deception or mistake by the consuming public ... Whether a customer is confused is the ultimate question. If the defendant employs a successful parody, the customer would not be confused, but amused ... Thus, we agree with the district court that parody is not an affirmative defence but an additional factor in the analysis. "[T]he keystone of parody is imitation. It is hard to imagine, for example, a successful parody of Time magazine that did not reproduce Time's trade marked red border. A parody must convey two simultaneous -- and contradictory -- messages: that it is the original, but also that is not the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody, but also vulnerable under trade mark law, since the customer will be confused" ... Thus the parody has to be a take-off, not a rip-off.

Merkel J continued with the caution that:

However, as was said by Lehane J in *McIlhenny*[3] (citing authority at 195–6) many cases are illustrative of circumstances:

... where in the public mind the association between a particular image and a particular source is so strong that the evocation of the image in the get-up or marketing of a wide range of disparate goods or services will lead people to conclude that there is a commercial connection of some kind between the goods or services and the originator (or "owner") of the image.

The authorities demonstrate that in the final analysis each case will turn on its own facts.

56. With the above principles in mind, I consider the conclusion that the trade marks are deceptively similar is unavoidable. The potential impact of the device elements of the opposed trade mark is not sufficient to readily distinguish it from the opponent's THE

WIZARD OF OZ trade mark which will instantaneously be recognized by the public as being the title of the motion picture which the opponent owns and distributes or licenses in Australia. As I have observed, the opponent's trade mark starts from a position where public recognition is instantaneous. The wizard's hat tends, to my mind, to reinforce the recognition within the opposed trade mark and the force of the device of the map of Australia is of secondary significance, if it is carried away from the trade mark in the minds of the public at all. This recognition will apply with equal force to the opposed trade mark and the surrounding elements of the opposed trade mark are not of a nature that it is immediately and principally recognizable as both parody or a play on meaning and distinct from the original.

57. The opponent has thus established its ground of opposition under section 44 in relation to opposed application 918093.

Section 58

58. This ground relates to opposed applications 765075(25), 818213(16), 927055(29),(30) 973833(18) and 1006339 (in Class 21 only).

59. Section 58 of the Act provides:

58 Applicant not owner of trade mark

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

Note: For *applicant* see section 6.

60. In *Computer Business Works Inc v Dylan Mark Johnston* [2005] ATMO 14, Hearing Officer Jock McDonough observed:

In order to establish this ground, it is incumbent upon an opponent to show that, in the time before filing, the applicant is not the first user in trade in Australia of the applied-for trade mark. To do so, the opponent must show, at a minimum, that not only is the applied-for trade mark substantially identical to the older trade mark, but that it is applied to the same kind of goods: *Re Hicks' Trade Mark* (1897) 22 VLR 636 at 640.

The proper comparison for substantial identity is side by side, as described in *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, per Windeyer J, at 414:

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.

61. The owner of a trade mark in Australia is thus either the first to publicly use it in trade, or the first to apply to register it as a trade mark, whichever is the earlier.
62. As discussed above, the trade marks of the parties are not substantially identical. I believe that the establishment of the argument run by Ms Baird would be dependent on neither the opponent's trade mark nor the opposed trade mark incorporation of a device element (else subsection 7(2) operates so that this does not potentially qualify as aural use) and evidence of the actual aural use of the opponent's trade mark.
63. There is no evidence of the aural use of the opponent's trade mark in advertising or promotion of its goods or services sold or provided under the trade mark. Moreover, as I have previously intimated, section 7(2) operates to limit the scope of the inquiry so that it does not apply to the opposed trade marks.
64. Accordingly, the opponent has not established its grounds under section 58 in relation to 765075(25), 818213(16), 927055(29)(30), 973833(18) and 1006339 (in Class 21 only).

Discussion of 'reputation' and connotation.

65. The establishment of the grounds under sections 42, 43 and 60 of the Act each rely to some extent on public appreciation of the expression THE WIZARD OF OZ and public reactions to, or perceptions of, the opposed trade marks in the light of that appreciation. Much of the parties' evidence goes to what those appreciations and perceptions are likely to be.
66. For the sake of brevity, a useful start-point in a discussion of the issues in terms to sections 42, 43 and 60 of the Act is thus to set out what I think that the evidence before me shows in general, discuss the legal principles, and then bring that discussion down to the particular of each ground as it relates to the opposed applications.
67. As previously discussed, THE WIZARD OF OZ is the title of a motion picture musical. It famously starred Judy Garland as young Dorothy who was transported with her dog Toto from Kansas to The Land of Oz by a tornado. The motion picture is based on a short, about 50 pages, children's story by L Frank Baum, illustrated by William Wallace Denslow, titled *The Wonderful Wizard of Oz*. In total, there are some forty books in the 'Oz' series of books,

the last 19 of which were written by Ruth Thompson. In the titles of the books in this series, the expression THE WIZARD OF OZ does not appear. The closest the book titles come to this expression is *The Wonderful Wizard of Oz* and *Dorothy and the Wizard in Oz*.

68. Evidence from the applicant, which attempts to show that the expression THE WIZARD OF OZ is associated in the minds of Australians with the book or series of books by L Frank Baume and Ruth Thompson and not the motion picture, is thus unconvincing.
69. I am thus satisfied that the primary association brought to the minds of Australians by the expression THE WIZARD OF OZ is with the motion picture.
70. The opponent argues that there is another association in the minds of the Australian public – that of its marketing under the trade mark THE WIZARD OF OZ. This marketing, the opponent states, is of the ilk (and invokes the principles of law) referred to in *Pacific Dunlop Ltd v Hogan* (1989) 23 FCR 553 ('the Crocodile Dundee case'); or *Hogan v Koala Dundee Pty Ltd* (1988) 12 IPR 508; ('the Koala Dundee case'); or *Twentieth Century Fox Film Corp & anor v The South Australian Brewing Co Ltd & anor* [1996] 480 FCA 1 ('the Duff case').
71. Against this, the applicant's evidence points to the use of the word OZ as a jocular shortform for the word 'Australia' and that in the context of the opposed trade marks the term THE WIZARD OF OZ denotes, in effect, THE WIZARD OF AUSTRALIA. This, as I apprehend the argument from the evidence before me, is reinforced by the presence of the map of Australia.
72. Many of the declarations in the opponent's evidence are from people within the Australian film industry who state they believe that the public would be confused or deceived by the applicant's use of the words THE WIZARD OF OZ within her trade marks. It must be observed, however, that what amounts to, in effect, as being a survey of people within the film industry might be naturally biased – the declarants have a cinema-centric view of the world – and most of the respondents will quite possibly because of their positions or expertise have different views of the issue than would members of the general public. There are, however, two declarations from people who are engaged
73. I am unconvinced that the evidence satisfactorily establishes that there is a public expectation that there is or could be widespread marketing directly associated with the motion picture *The Wizard of Oz*. This kind of marketing is a relatively modern occurrence,

which, in my experience, started markedly occurring in relation to motion pictures from about the time of *Star Wars* in around the mid nineteen seventies. While it is probable that the general public does not make the distinction between pre and post *Star Wars* motion pictures, there is a perception or appreciation that this type of marketing is a relatively modern phenomenon and that this did not occur in relation to motion pictures of the vintage of *The Wizard of Oz*. The situation is different, of course with the theme park and shops operated by the opponent or under its aegis.

74. Additionally, *The Wizard of Oz* is also available in DVD, video tape and CD (as relates to the musical sound track) formats and the opponent has shown that its sales in relation to these goods within Australia have been respectable. The opponent has also demonstrated that, since at least before the priority date of the first opposed application, it has actually engaged in the marketing of goods under the trade mark THE WIZARD OF OZ in Australia as discussed above. The motion picture (in DVD, video tape and CD formats) is promoted through the opponent's theme park and retail stores and these goods are generally available for sale throughout Australia. It is to some extent more probable that the public may see a trade mark containing, or consisting of, the words THE WIZARD OF OZ as relating to these activities rather than as being connected with the motion picture itself.
75. It is also possible that, although the public is aware that this kind of marketing did not happen in relation to motion pictures of this vintage, the opponent may have started such marketing in relation to the motion picture.
76. The applicant has submitted quite extensive evidence which shows that the expression 'The Wizard of Oz' has gained some public acceptance in contexts divorced from the motion picture. There are many press articles in the evidence that (for instance) refer to some sporting star or other public figure as being 'The Wizard of Oz' in which the word 'Oz' refers to Australia. However, these instances must be viewed as being journalistic license which depend on the fame of the motion picture for their effect. If there were no such motion picture, the journalistic witticism would be pointless.
77. The same, it must be stated, is also true of the applicant's explanation of her adoption of the words within her trade marks. While it may be observed that many Australians might be perceived as being 'wizards' and the land that they live in may be jokingly referred to as being 'Oz', the expression in the context of the trade marks relies entirely on the motion

picture of the same name for its effect. This is, of course, not fatal to the applications if the use of the words will not either mislead or deceive (section 52 of the *Trade Practices Act 1972* or section 42 of the State's *Fair Trading Acts*) or confuse and deceive in terms of sections 43 or 60 of the Act. As I have previously indicated, however, I do not consider that most Australians would immediately see the opposed trade marks as being parodies or plays on words.

78. And, as with other marketing of this nature (exemplified, for example, in the *Crocodile Dundee*, *Koala Dundee* and *Duff* situations referred to above), this marketing by motion picture companies is successful and the trade marks achieve a reputation very quickly because the success of the movie translates to a guarantee that the trade mark starts its life in the marketplace as being already well-known.
79. I will finally, in this part of the decision, observe that the Courts have found that this marketing or cross promotion might be seen by the public to be in relation to goods which are quite outside those that are traditionally looked to for endorsement by television or movie companies such as fast foods, stationery or soft drinks. In the *Crocodile Dundee* case it was shoes and in the *Duff* case, it was beer.

Conclusions

80. Accordingly, it appears to me that the expression THE WIZARD OF OZ has permeated the Australian language to the extent that it connotes the motion picture of the same name.
81. Additionally, I consider it more likely than not that at the priority date of the first opposed application the opponent's trade mark had a reputation in Australia in relation to mouse pads, figurines, soft toys, drinking glasses, drinking mugs, key rings, Christmas ornaments, dolls and clothing and that the context of this is in part in relation to a theme park where all but the latter two items of these goods have been for sale.
82. I also observe that the theme of the motion picture *The Wizard of Oz* is very well known. It is strongly child-oriented and this theme to an extent runs in the marketing associated with the motion picture under the trade mark THE WIZARD OF OZ by the opponent in its goods which are mouse pads, figurines, soft toys, drinking glasses, drinking mugs, keyrings, and Christmas ornaments, and the licensed sale of dolls and clothing bearing the trade mark THE WIZARD OF OZ.

Legal Principles

Section 42

83. Section 42 of the Act provides:

42 Trade mark scandalous or its use contrary to law

An application for the registration of a trade mark must be rejected if:

- (a) the trade mark contains or consists of scandalous matter; or
- (b) its use would be contrary to law.

84. Ms Baird referred me to the principles in the decision by Madgwick J in *Advantage-Rent-A-Car Inc v Advantage Car Rental Pty Ltd* [2001] FCA 683 at paragraph 28 to my attention:

I acknowledge the claim made by counsel for the Registrar that such an approach requires the Registrar to look at questions of law outside his or her expertise and that this can be difficult and may place a large and onerous responsibility upon the Registrar. However, the Registrar has the comfort that the criterion is that the use "would" not "could" be contrary to law. Further, there is no reason why the Registrar could not seek legal advice before forming his/her opinion. It should also be noted that what is required is that the Registrar form a view as to whether the use of a trade mark would be contrary to law. Such opinion does not have a similar effect to say, a judicial conclusion of law as to breach of copyright in copyright proceedings; the effect is limited to the refusal of registration. In any case, an appeal de novo lies from the Registrar's decision to this Court where any error of the Registrar may be corrected.

85. Under section 42 of the Act, Ms Baird also referred me to section 52 of the *Trade Practices Act 1974*, which provides:

52 Misleading or deceptive conduct

(1) A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

(2) Nothing in the succeeding provisions of this Division shall be taken as limiting by implication the generality of subsection (1).

Note: For rules relating to representations as to the country of origin of goods, see Division 1AA (sections 65AA to 65AN).

86. Of course, the applicant, Ms Todd, is not a corporation so, strictly speaking, it is the analogues of section 52 of the *Trade Practices Act 1974* under the respective sections 42 of the States' Fair Trading Acts which here apply, such as the *Fair Trading Act 1989* (Qld) or the *Fair Trading Act 1987* (NSW). The principles of law that apply are, of course, identical.

87. In *Equity Access Pty Ltd v Westpac Banking Corporation* (1989) 16 IPR 431 at 440-442, Hill J set out the following principles, concerning section 52 of the *Trade Practices Act 1974* (which are also applicable to section 42 of the Fair Trading Acts as they apply to individuals, rather than companies):

1. For conduct to be misleading or deceptive the conduct must convey in all the circumstances of the case a misrepresentation:
2. There will however be no contravention of s.52(1) of the Act unless error or misconception results from the conduct of the corporation and not from other circumstances for which the corporation is not responsible:
3. Conduct will be likely to mislead or deceive if there is a "real or not remote chance or possibility" of misleading or deception regardless of whether it is less or more than 50%. The question of whether conduct is misleading or deceptive or likely to mislead or deceive is an objective question which the Court must determine for itself. Hence evidence that persons in the relevant class have been misled will, although admissible, not be determinative. In some cases however such evidence will be very persuasive.
4. Conduct of a corporation causing mere confusion or uncertainty in the minds of the public in the sense that they may be caused to wonder whether two products may have come from the same source is not necessarily coextensive with misleading or deceptive conduct: Since actual deception need not be shown the Court must consider whether a reasonably significant number of potential purchasers would be likely to be misled or deceived: The test in passing off cases is usually expressed as being whether a "substantial number of persons likely to become purchasers ... are liable to be deceived by the defendant's use of the name. On the other hand it is not necessary to show that all, or substantially all, persons in the market associate the name with the plaintiff's goods, if this can be shown of a substantial proportion of persons who are probably purchasers of the goods of the kind in question."
5. In a case such as the present the applicant must establish that it has acquired the relevant reputation in the name, that is to say that the name had become distinctive of the applicant's business in a particular country or geographical area. However at least in some circumstances very slight activities may be found to be sufficient to establish that a name has become distinctive of a person's business in a particular country.
6. Section 52 is not confined to conduct which is intended to mislead or deceive and a corporation which acts honestly and reasonably may none the less engage in conduct that is likely to mislead or deceive.

88. It is necessary to stress that the above quoted passage refers to the question of being misled or deceived by the 'name'. It is thus not only the trade mark use of the name THE WIZARD OF OZ by the opponent which I am to consider here – I am also to consider the previously discussed reputation of the name of the motion picture and its 'spin-offs' such as the ice-

skating show of the same name, and the name of the videos, DVDs and music CDs of the motion picture.

89. Any conclusion other than that the opponent has an extensive reputation in the expression or name THE WIZARD OF OZ in Australia is unavoidable. To this must be added the fact that the opponent has actually engaged in marketing goods under the trade mark THE WIZARD OF OZ in Australia. For the reasons stated above, I accord a low weight to the applicant's evidence that the opposed trade mark might denote something else to Australians.
90. However, there must, I consider, be something inherent both in the opposed trade marks and their respective goods or services which would lead the public to connect them with the reputation of the opponent's 'name' or trade mark THE WIZARD OF OZ before I would be satisfied that the use of the opposed trade marks would be contrary to law in terms of the decision in *Advantage Rent-A-Car*, above. Reviewing the *Koala Dundee*, *Crocodile Dundee*, and *Duff* cases, reveals that in each there was some logical connection between the themes, activities, action, or plot of the motion pictures or television cartoons which would connect the defendant's goods in the public mind with the applicants/appellant in those cases. In the *Koala Dundee* case, it was a representation of a Koala Bear dressed as the character Mick Dundee with his accoutrements such as a leather vest, hat with crocodile teeth, the words Koala Dundee, the establishment in the motion picture of a character who was exaggeratedly Australian who was similarly dressed, connected to retail stores which sold Australian souvenirs. In the *Crocodile Dundee* case, it was the similar theme, set against a scene in the film in which the central character, Mick Dundee, 'sees off' knife wielding muggers with the words 'That's not a knife', and then producing a formidable hunting knife with the words 'That's a knife'. A similar setting, character, and words, were used to connect the shoes of the appellant with the motion picture. And in the *Duff* case, the cartoon character Homer Simpson and his predilection for Duff Beer, and the marketing of the applicant, was the connection between the television programme of the applicant and the goods of the defendant.
91. It thus appears to me that if I am to be satisfied that these hypothetical cases under section 42 of the States' Fair Trading Acts would succeed, I should be satisfied that:
 - there is a logical notional link between the themes, characters, settings, activities, action, or plot of the motion picture and the goods or services of the opposed trade

marks that would be readily apparent to the public such that it would mislead or deceive them; or,

- the goods or services are those which are normally regarded by the public as being those which are associated with motion picture promotions such as fast foods, stationery or soft drinks; or,
- the opponent's trade mark has a reputation in relation to the goods and services in respect of which it has been used such that the use of the opposed trade marks would mislead or deceive in respect of the goods or services in respect of which they are used, or intended to be used..

92. The above-mentioned considerations might obviously be subject to some modification if an opponent demonstrated elements of bad faith in the application for registration. Such is not the case here.

93. The relevant date is the priority dates of the opposed applications.

765075(25)

94. This application seeks registration of the trade mark THE WIZARD OF OZ HEMP CO & DEVICE, detailed above, for 'clothing and headgear'.

95. I have already found that the opponent had a reputation in this trade mark for clothing at the priority date of this opposed application. Any aural reference to goods under the parties' trade marks is identical. It follows, as a consequence, that the applicant's use of this trade mark on the nominated goods would mislead or deceive.

96. 100. The opponent has thus established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 765075(25).

800208(31)

97. This application seeks registration of the trade mark THE WIZARD OF OZ PET FOOD COMPANY & DEVICE, detailed above, for a 'range of pets foods'.

98. A major theme of the motion picture The Wizard of Oz is the relationship of Dorothy and her dog Toto who is, effectively, a character in the motion picture. This theme and the character Toto is a natural and logical connection between the motion picture and the trade

mark of the applicant use, or intended to be used, on pet foods. On balance, I am satisfied that the use of the opposed trade mark on pet foods, particularly dog foods, would lead the ordinary person to conclude that there is some form of connection between the motion picture, or the opponent's sales of video tapes, DVDs or musical sound track on CDs, and the pet foods sold under the trade mark which have the words THE WIZARD OF OZ appearing prominently at the top of it.

99. The opponent has thus established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 800208(31)..

818213(16)

100. This application seeks registration of the trade mark THE WIZARD OF OZ CARD CO & DEVICE, detailed above, for a range of paper, stationery and arts goods in Class 16.

101. With the exception of artists' materials and paint brushes, the goods listed in the specification of 818213(16) are the types of goods that are commonly endorsed or licensed by the makers of motion pictures, DVDs, videos, etc to promote and exploit their productions. This is a widespread practice which is well recognised and accepted both amongst the public and within the industry. The 'trade' declarations support this viewpoint.

102. Additionally, the opponent has, before the priority date of this opposed application, sold photographs to attendees at its theme park of themselves superimposed upon the yellow brick road, behind some of the characters of the motion picture and under the trade mark THE WIZARD OF OZ. And, key rings, figurines and soft toys, which were also sold by the opponent, are sold in souvenir shops in close association with post cards, stationery and the like. The use of the trade mark by the applicant is thus likely to mislead or deceive because of the reputation in the name or trade mark THE WIZARD OF OZ established by the opponent in relation to these goods.

103. The opponent has thus established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 818213(16) for all of the goods for which registration is sought except artists' materials and paint brushes.

918093(43)

104. This application seeks registration of the trade mark THE WIZARD OF OZ HOLIDAY FARMS 7 DEVICE, detailed above, for 'holiday farms - providing food, drink and accommodation' in Class 43.

105. I consider that there would be an expectation amongst most Australians that a holiday farm run for children under the opposed trade mark would be themed around THE WIZARD OF OZ motion picture as these words appear prominently in the opposed trade mark. There is a very close logical connection between Dorothy on a Kansas farm and the services of holiday farms. If the holiday farm was so themed, it would imply a connection with, or endorsement or license from, the opponent that does not exist and thus mislead or deceive. If the holiday farm was not themed around the motion picture, THE WIZARD OF OZ, it would again be deceptive to the applicant's prospective customers who would naturally have an expectation that a holiday on the farm would be around this theme.

106. The opponent has thus established its grounds under section 42 of the Fair Trading Acts and section 42 of the Act to the registration of application 918093(43).

927055(29)(30)

107. This application seeks registration of the trade mark THE WIZARD OF OZ FANTASTIC FOOD CO & DEVICE, detailed above, for various fresh and processed foodstuffs in Classes 29 and 30. The full lists of these goods appear above, under paragraph 1 of these decisions.

108. I do not think that there is any obvious logical connection or correlation between the reputation of the opponent's name or trade mark THE WIZARD OF OZ and the goods sold or proposed to be sold under the opposed trade mark such that would be a public expectation that there was some form of connection between the public use of the opposed trade mark and the opponent. It is quite likely, I consider that people would be caused to wonder about such a connection; however, in terms of the dicta in *Equity Access*, above, this sense of wonderment is not necessarily co-extensive with being misled or deceived.

109. The opponent has not established its opposition in relation to application 927055(29)(30).

934712(32)

110. This application seeks registration of the trade mark THE WIZARD OF OZ DRINKS CO & DEVICE, detailed above, for various soft drinks in Class 32. The full list of these goods appear above, under paragraph 1 of these decisions.
111. As I have previously indicated, above, soft drinks are one of the products where there is a public awareness that motion picture owners license use of the names of their motion pictures, videos, and DVDs for use on such goods. As mentioned above, the opponent's sign also has a reputation in respect of various souvenir items and clothing. On balance, I am satisfied that a substantial portion of the public would, when viewing the opposed trade mark on the specified soft drinks, would believe that the opposed trade mark denoted an endorsement or license by the opponent.
112. The opponent has thus established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 934712(32).

946065(5)(31)

113. This application seeks registration of the trade mark THE WIZARD OF OZ & DEVICE, detailed above, for veterinary preparations and animal foodstuffs, fresh fruits and vegetables. The full lists of these goods appear above, under paragraph 1 of these decisions.
114. As I have indicated, above, the opponent succeeds under section 42 of the Act in relation to pet foods, the same observations obviously apply to foodstuff for animals, which includes including dog biscuits and also beverages for pets. However, any logical link between the balance of the goods and the reputation of the opponent's name and trade mark appears to me to be tenuous. Neither are these goods ones which a usually associated with the marketing or licensing of motion picture names.
115. The opponent has thus established its grounds under the analogues of section 52 of the Trade Practices within the Fair Trading Acts and section 42 of the Act to the registration of application 946065(5)(31) in relation to foodstuffs for animals including dog biscuits and beverages for pets. The opponent has not established this ground in relation to the balance of the goods which is the entirety of the Class 5 goods, and, "Animal fattening preparations, products for animal litter; fresh fruits and vegetables," in Class 31.

951800(39)

116. This application seeks registration of the trade mark THE WIZARD OF OZ TOUR CO & DEVICE, detailed above, for coach tours.
117. I am not satisfied that the opponent has established that there is a logical connection or association between the reputation of its name and trade mark THE WIZARD OF OZ or its reputation in relation to its marketing of its name and trade mark such that the use of the opposed trade mark by the applicant in relation to coach tours would mislead or deceive. Nor are 'coach tours' normally associated by the public with the marketing and promotion of motion pictures.
118. The opponent has not established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 973800(39).

973832(33)

119. This application seeks registration of the trade mark THE WIZARD OF OZ DRINKS CO & DEVICE, detailed above, for alcoholic beverages.
120. In the *Duff* case, the proposed use of the trade mark DUFF BEER by the defendant was found to be likely to mislead or deceive because of references within the television cartoon programme *The Simpsons* to Homer Simpson's predilection for Duff Beer and associated marketing by the applicants, Twentieth Century Fox Film Corporation and Matt Groening Productions Inc on t-shirts, etc. There is, as far as I am aware, no similar reference to alcoholic beverages within the motion picture THE WIZARD OF OZ, nor has such reference been brought to my attention in evidence or submissions. Alcoholic beverages are not amongst the goods looked to by motion picture producers to endorse or license use of names or images associated with their productions, nor is there any public expectation that this might be so. The opponent has made no use of its trade mark THE WIZARD OF OZ in relation to such goods before the priority date of the opposed application.
121. Obviously, there may be perceived to be strong doubts about the advisability of placing onto the market of alcoholic beverages with a trade mark which suggests that the product is made for children. However, it is not the Registrar's role to become involved in discussions of public morality: *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 at paragraph 25.

122. The opponent has not established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and section 42 of the Act to the registration of application 973832(33).

973833(18)

123. This application seeks registration of the trade mark THE WIZARD OF OZ TIMBER & LEATHER CO & DEVICE, detailed above, for goods made from leather in Class 18.

124. I am not satisfied that the opponent has established that there is a logical connection or association between the reputation of its name and trade mark THE WIZARD OF OZ Timber & Leather Co or its reputation in relation to its marketing of its name and trade mark such that the use of the opposed trade mark by the applicant in relation to leather goods in Class 18 would mislead or deceive. Nor are 'leather goods' normally associated by the public with the marketing and promotion of motion pictures.

125. The opponent has not established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 973833(18)..

1006339(3)(4)(21)(22)(34)

126. This application seeks registration of the trade mark THE WIZARD OF OZ, detailed above, for goods in the nominated classes specified at paragraph 1 of these decisions.

127. With the exception of Class 21 goods, the goods in respect of which registration of the trade mark is opposed are not those normally associated in the public mind with the marketing or licensing of names associated with motion pictures, nor has the opponent actually marketed goods associated with the goods which are here in question. The goods other than those within Class 21 appear to me to be unconnected with the themes and characters within the motion picture *The Wizard of Oz*. However, the evidence shows that motion picture producers regularly license the use of their trade marks on cups, tumblers, plastic flatware, lunchboxes, cutlery, and so forth made for children.

128. The opponent has not established its grounds under the analogues of section 52 of the Trade Practices Act within the Fair Trading Acts and thus section 42 of the Act to the registration of application 1006339 in classes (3)(4)(22) and (34) but has established its opposition in relation to class 21 goods.

Section 43 Connotation

129. Section 43 of the Act provides:

43 Trade mark likely to deceive or cause confusion

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.

130. I have already decided, above, that the sign within the opposed trade marks THE WIZARD OF OZ, in the context of the opposed trade marks, connotes to most Australians the motion picture of the same name.

131. However, I do not consider that the fact that the expression connotes the motion picture takes the position of the parties beyond that discussed under my considerations of section 42 of the Act at paragraphs 94 to 128 of these decisions, above. The reactions or assumptions of the public who are aware of the connotation (when confronted by the applicant's trade marks) are, or will be, circumscribed by their expectations as to what is normal licensing and marketing behaviour on the part of motion picture producers, as well as their observations of the actual licensing and marketing in relation to that particular motion picture.

132. In short, any detailed consideration of this ground under the circumstances of these opposed applications would come, in my consideration, to the same outcomes as my conclusions under section 42, above.

Section 60

133. Section 60 of the Act provides:

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

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.

134. Here I am to consider the use of the opponent's sign THE WIZARD OF OZ as a trade mark in respect of the goods mouse pads, figurines, soft toys, drinking glasses, drinking mugs, keyrings, and Christmas ornaments, as well as its service of selling photographs of people superimposed upon the 'yellow brick road' and decide whether because of any reputation that it has in relation to its trade mark, the use of any of the opposed trade marks would confuse or deceive.

135. I have already decided that the trade mark the subject of the opponent's application and that of opposed application 918093 are deceptively similar. The opponent's actual use of its trade mark is substantially in the same form as that in which it has applied to register it. Thus the same logic should apply to each of the opposed trade marks and they are each deceptively similar to the opponent's trade mark.

136. The word 'reputation' came under judicial consideration in *McCormick & Company Inc v McCormick* [2000] FCA 1335. Kenny J, having found that the trade marks in question were substantially identical or deceptively similar, posed the question this way at paragraph 81:

What is intended by the word "reputation" in s 60? The word is defined in The Macquarie Dictionary as follows:

reputation ... 1. the estimation in which a person or thing is held, esp. by the community or the public generally; repute ... 2. favourable repute; good name ... 3. A favourable and publicly recognised name or standing for merit, achievement, etc. ... 4. The estimation or name of being, having done, etc, something specified.

Cf. *The Oxford English Dictionary*. In s 60, the word is, I think, apt to refer to "the recognition of the McCormick & Co marks by the public generally".

Does the evidence establish that in Australia before 9 March 1992 the McCormick & Co marks were recognised by the public generally and, because of that, the use by Mary McCormick of her marks would be likely to cause the public confusion, as for example, by the public's mistakenly attributing a business connection between the two or attributing her product to the company?

137. The opponent's trade mark starts from a position that it is well known as the title of its motion picture and the reputation of its trade mark should have been quickly established in relation to the goods mentioned above.

138. I have previously intimated in relation to opposed application 927055(29)(30) which seeks registration of THE WIZARD OF OZ FANTASTIC FOOD CO trade mark for various processed and unprocessed foodstuffs that it was likely that the public would wonder whether it might

not be the case whether there was a connection between the opponent's trade mark and its marketing activities and the opposed trade mark.

139. This wonderment equates to 'confusion' in terms of the words 'confuse or deceive' within section 60 of the Act. Richards J in *Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty. Ltd.* [1979] RPC 410 at 423 said:

'Deceived' implies the creation of an incorrect belief or mental impression and causing 'confusion' may go no further than perplexing or mixing up the minds of the purchasing public..... Where the deception or confusion alleged is as to the source of the goods, deceived is equivalent to being misled into thinking that the goods bearing the applicant's mark come from some other source and confused to being caused to wonder whether that might not be the case.

140. I consider that there are many goods within the specifications of application 927055 within Classes 29 and 30 where a member of the public would be caused to wonder if the trade mark denoted some licensing or endorsement because of the marketing and reputation of the opponent's trade mark THE WIZARD OF OZ. Such goods would include (but not be restricted to) ices and potato crisps.

141. The opponent has thus established its opposition under section 60 in relation application 927055.

Decision

142. Section 55 of the Act provides:

Decision

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

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application; having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

143. The opponent has established one or more of its grounds in relation to applications 765075, 800208, 818213, 918093, 927055, 934712, 946065 and 1006339. I refuse to register these trade marks.

144. The latter trade marks (946065 and 1006339) may, however, proceed to registration if, within one month of the date of this decision, the applicant requests amendments to the

[41]

specification of goods that removes the goods, 'Food stuffs for animals including dog biscuits, beverages for pets' from the specification in Class 31 of 946065 and deletes class 21 from application 1006139. However, if the Registrar has been served with notice of appeal before that time, I direct that the disposition of the applications be in accordance with the Court's direction or order.

145. The opponent has not established its opposition in relation to applications 951800, 973832, and 973833.

146. Trade mark application numbers 951800, 973832, and 973833, may therefore proceed to registration one month from the date of this decision. If the Registrar has been served with notice of appeal before that time, I direct that the disposition of the applications be in accordance with the Court's direction or order.

Costs

147. Both parties may be viewed as having had a degree of success in these proceedings. In all of the circumstances, I make no order as to costs.

Ian Thompson
Hearing Officer
Trade Marks Hearings
13 June 2007

Annex 1

The following evidence has been served and filed in relation to 765075, 800208 and 818213:

Declarant	Short name Comments	Date made	Exhibits
Evidence in Support			
Louise Sams	Sams 1 General Counsel of Opponent	21 Sept 2001	LS-1 to LS-30
Matthew Tucker	Proforma Site Facilities Manager of Film Australia	5 June 2001	
Rudy Lukman	Proforma Disbursement Co- ordinator of Film Australia	5 June 2001	
Linda Seeto	Proforma Administrative Assistant of Film Australia	5 June 2001	
Jacqueline North	Proforma Production Manager of Chili Films	5 June 2001	
Vanessa Sulman	Supporting Production Manager of Chili Films	17 Sept 2001	
Penelope McDonald	Supporting Managing Director of Chili Films	18 Sept 2001	
Josie Cabral	Receptionist of Film Australia	18 Sept 2001	
Barbara Maria Grummonds	Supporting Site Coordinator of Film Australia	18 Sept 2001	
Peter Liton	Supporting Video Transfer Operator of Film Australia	18 Sept 2001	

Declarant	Short name Comments	Date made	Exhibits
Donald Joseph Tanner	Supporting Projectionist of Film Australia	18 Sept 2001	
Jorge R Richter	Supporting Technical Supervisor of Film Australia	18 Sept 2001	
Campbell Hogg	Trade MD of Adcall Promotional Products Pty Ltd	8 Nov 2001	
Robynne Lyndsay Sanders	Technical Assistant of Peter Maxwell & Associates	16 Nov 2001	
Gregory Robertson	Vice President and GM of Warner Bros (Australia) Pty Ltd	27 Nov 2001	GR-1 to GR-2
Graeme Holland	Trade MD Tresdex Pty Ltd	22 Nov 2001	
Josephine Rosman	Trade Company Director of Paper to Paper International	22 Nov 2001	
Marc Gareton	Gareton MD Warner Home Video Pty Limited	11 Dec 2001	MG-1 to MG-4
Evidence in Answer			
Yo-Merry Todd	Todd 1 Applicant	11 June 2002	YT-1 to YT-17
Ian Tannahill	Tannahill 1 Solicitor for Applicant	11 September 2002	IRT-1 to IRT-3
Yo-Merry Todd	Todd 2 Applicant	9 Sep 2002	YMT-1 to YMT- 5

Declarant	Short name Comments	Date made	Exhibits
Yo-Merry Todd	Todd 3 Applicant	9 Sep 2002	YMT-1 to YMT-5
Ian Robert Tannahill	Tannahill 2 As above	10 Oct 2002	IRT-1 to IRT-27
Ian Robert Tannahill	Tannahill 3	9 December 2002	IRT-1 to IRT-3
Evidence in Reply			
Janet Kobrin	Kobrin VP & Intellectual Property Counsel for opponent.	25 June 2004	
Kenneth James Taylor	Taylor 2 Private inquiry agent	24 June 2004	
James Vernon Maxwell	Maxwell Solicitor for applicant	29 June 2004	JVM-1
Mario Sopena	Sopena Retail Manager of Warner Village Theme Parks	28 June 2004	MS-1 to MS-4
John Vernon Mutton	Trade Company Director of Kokako Corporation Pty Ltd	29 June 2004	JVM-1
Declarant	Short name Comments	Date made	Exhibits
Simone Yvette Bushby	Trade Business owner	29 Jun 2004	SB-1
Sarah Calvert	Trade Fashion Buyer	25 Jun 2001	SC-1
Lisa Sutton	Trade Owner of TSQ Design - greeting card makers	29 Jun 2004	LS-1
Louise Sams	Sams 2 VP & Secretary of opponent	28 Jun 2004	LS-31 to LS-50

The following declarations have been served and filed in relation to oppositions 918093, 927055, 934712 & 946065

Declarant	Short name Comments	Date made	Exhibits
Evidence in Support			
Stephen Nickerson	Nickerson MD of Warner Home Video Pty Ltd	4 July 2003	SN-1 to SN-4
James Vernon Maxwell	Maxwell 2 Solicitor for opponent	29 April 2004	JVM-1
Gregary Robertson	Robertson 2 VP & GM of Warner Bros (Australia) Pty Ltd	29 Jan 2004	GR-1
Louise Sams	Sams 3 ¹ VP & Secretary of opponent	30 June 2004	LS-A to LS-I
Louise Sams	Sams 4 VP & Secretary of opponent	28 June 2004	LS-31 – LS-50
Evidence in answer			
Ian Robert Tannahill	Tannahill 4 Solicitor for applicant	14 Feb 2005	IRT-1 to IRT-3
Iain Robert Tannahill	Tannahill 5 Solicitor for applicant	14 Mar 2005	IRT-1
Rebecca Jane Baldwin	Baldwin Owner of Eye Spy Trade Mark Investigation Services	1 Feb 2006	RJB-1
Simone Yvette Kingston (nee Bushby)	Kingston Director of Dogue Industries Pty Ltd	9 Feb 2006	SB-1 to SB-2
Caroline Keys	Keys Director of Honey Pot Pets Pty Ltd (Pet product designers)	8 February 2006	Exhibit 1

¹ Reserves and refiles all of the opponent's evidence served and filed in relation to 765075, 800208 and 818213

Declarant	Short name Comments	Date made	Exhibits
Linda Wareham	Wareham Admin Manager of Inghams (animal feeds)	10 Feb 2006	
Mario Sopena	Sopena 2 Retail Manager of Warner Village Theme Parks	13 Feb 2006	MS-3 to MS-5

Annex 1 Cont'd

The following declarations have been served and filed in relation to opposition to applications 951800, 973832, 973833 and 1006339:

Declarant	Short name Comments	Date made	Exhibits
Evidence in Support			
James Vernon Maxwell	Maxwell 3 ² Solicitor for opponent	24 Mar 2005	JVM-1

² Refers to all evidence previously served and filed in support and reply up to 24 Mar 2005