

## TRADE MARKS ACT 1995

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

Re: Opposition by Classic Media, Inc to registration of trade mark application 884780(1) - **MR MAGLOO** - filed in the name of Republic Chemical Industries, Inc.

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<b>DELEGATE:</b>	Mary Skivington
<b>REPRESENTATION:</b>	<b>Opponent:</b> Khajaque Kortian of Spruson & Ferguson, Patent and Trade Mark Attorneys. <b>Applicant:</b> Carmen Champion of counsel instructed by Hodgkinson McInnes Pappas, Patent and Trade Mark Attorneys.
<b>DECISION:</b>	Grounds of opposition under sections 42(b), 59 and 60 not established. Costs awarded against the opponent.

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#### Background

1. Dart D D Braeder, a resident of New South Wales, filed application number 884780 on 3 August 2001 to register the trade mark MR MAGLOO for goods described as:  
*Adhesives and glues; adhesive preparations and compositions including construction adhesives.*
2. Some two months after filing and prior to acceptance of the trade mark the application was assigned to Republic Chemical Industries, Inc who then became and will be referred to as 'the applicant' for registration of the trade mark. Acceptance for possible registration of the trade mark was advertised in the *Australian Official Journal of Trade Marks* on 6 December 2001.
3. Classic Media, Inc, ('the opponent'), filed notice of opposition to registration of the trade mark on 28 February 2002 citing a broad range of grounds of opposition under the *Trade Marks Act 1995*, ('the Act').
4. In due course the evidentiary phases of the opposition process were completed and both parties applied to be heard. As a delegate of the Registrar of Trade Marks I heard the matter in Sydney on 20 July 2005. The opponent was represented by Khajaque Kortian of Spruson & Ferguson, Patent and Trade Mark Attorneys. The applicant was represented by Carmen Champion of counsel instructed by Hodgkinson McInnes Pappas, Patent and Trade Mark Attorneys.

## The evidence

5. The evidence comprises the following statutory declarations and exhibits.

### *Evidence in support*

Date	Declarant	Exhibits
25 August 2003	Sonja Keith, General Counsel for Classic Media, Inc.	A-C
28 August 2003	Khajaque Kortian, a principal of Spruson & Ferguson Patent and Trade Mark Attorneys.	A-M
28 August 2003	Sean Bluett, a paralegal with Spruson & Ferguson Patent and Trade Mark Attorneys	-
28 August 2003	Chairat Khamphon an employee at Spruson & Ferguson Patent and Trade Mark Attorneys.	A -B
27 August 2003	David Andrew Gallen a film cataloguer.	A
27 August 2003	Debra Fay Cahill, an information technology liaison officer in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
27 August 2003	Rochelle Deborah Einfeld, a trade mark attorney in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
27 August 2003	Ricky Ryan, filing clerk in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
27 August 2003	Lubica Dimovska, an accountant in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
25 August 2003	Gavin Recchia, a patent attorney in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
22 August 2003	Rex Jacombs, an administrator in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
22 August 2003	Geralyn Smith, an accounting manager in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys.	A
28 August 2003	Frank Dogao, a business manager.	A
4 September 2003	Stuart Thomson, a research Scientist.	A

*Evidence in answer*

Date	Declarant	Exhibits
25 June 2004	Brian Ronald Edwards, Vice President of international sales for Republic Chemical Industries, Inc.	BRE-1 to BRE-4
29 September 2004	Ian Kennedy, Marketing Manager of stationery for Hunter Leisure Pty Ltd	IK-1 to IK-6

*Evidence in Reply*

Date	Declarant	Exhibits
5 January 2004	Khajaque Kortian, a principal of Spruson & Ferguson Patent and Trade Mark Attorneys.	KK-1
7 February 2005	Henry Tek Wah Sun, a paralegal in the employ of Spruson & Ferguson Patent and Trade Mark Attorneys	A

*Evidence in support - Sonja Keith*

6. Ms Keith declares that she is a General Counsel for Classic Media, Inc, a position she has held since 2001. She reports that a cartoon character, MR MAGOO was created in 1949 by United Productions of America, a wholly owned subsidiary of the opponent. She avers that from 1949 to the 1960s fifty-two animated shorts featuring MR MAGOO were produced. Two of these shorts won Academy Awards the first being in 1954 and the second in 1956. Full-length animation features were produced in 1958 and 1962. These as well as the animated shorts were shown extensively in the United States in the 1960s and 1970s, reports Ms Keith. In 1997 Walt Disney, under licence, produced a movie, MR MAGOO, with actor Leslie Nielsen in the character role. The film was released in the United States and internationally including Australia. Ms Keith declares that the MR MAGOO trade mark is registered in a number of countries, (Exhibit B). I note, however, that there have been no applications to register MR MAGOO in Australia. Exhibit C is a list of American licensees for November 2002 and August 2003 licensed to produce MR MAGOO merchandise. Ms Keith declares that while she has been unable to obtain detailed archival records confirming the broadcasting of MR MAGOO animation features in Australia she is aware from her discussions with other Classic Media staff that the features were shown in Australia. Exhibits A and C show the words MR MAGOO used in conjunction with

the cartoon character in various poses and with different clothing but instantly recognizable by his distinctive facial characteristics.

*Khajaque Kortian*

7. Mr Kortian declares that he is a principal of Spruson & Ferguson, Patent and Trade Mark Attorneys. Mr Kortian reports that he has been informed by Andrew Stewart, Corporate Counsel of Nine Network Australia that its parent company, Publishing and Broadcasting Limited, obtained a licence to broadcast the MR MAGOO cartoon series from 1983 to 1990, (Exhibit D). Exhibit E comprises 'episode summaries' indicating the last date of play on the Nine Television Network. Most of these relate to 1987 and 1988. Exhibit F comprises print outs from a search of the ebay.com Internet auction website for MR MAGOO merchandise. Mr Kortian reports that from his observations as a consumer and from inquiries conducted on the Internet it is apparent that it is a common practice for the characters, and related trade marks associated with children's television programs and children's animated series, to be merchandised. However, he provides no evidence of merchandising of the MR MAGOO cartoon character in Australia.

*Sean Bluett*

8. Sean Bluett, a paralegal with Spruson & Ferguson Patent and Trade Mark Attorneys declares that he conducted telephone inquiries with Oztam Pty Ltd a commercial television ratings provider and was informed that the MR MAGOO movie starring Leslie Nielsen was broadcast on Channel 7 in about February 2001. Mr Bluett also declares that he telephoned ten franchisees of the Video Ezy video rental chain to make inquiries about the movie. He declares that he was informed by representatives at each of these stores that they stock at least one copy of the movie and that it has been 'rented out frequently' since it became available to each of these stores in October 1998. Mr Bluett also declares that he made the same inquiries of ten franchisees of the Civic Video rental chain all of whom advised that they stocked at least one copy of the movie. In the case of two of these establishment records showed that the movie had been rented out in the period 13 October 1998 to 1 August 2003, 210 and 336 times respectively. Mr Bluett made further inquiries with Village Road Show Limited who are licensed to oversee the distribution of the Mr Magoo movie in Australia. He reports that he was informed that the movie was released in Australia on

14 May 1998 and that it was estimated that 119,000 people in total saw the movie at cinemas throughout Australia.

9. I note here that I consider that if so few people bothered to visit a cinema to see the movie it can only be considered to be what is colloquially described as a 'flop'. This is further demonstrated by the information supplied by the various video hire chains that they stock 'at least one copy'. Clearly if only one or just a few copies are stocked there is little expectation of public interest in it and the figures for the number of hirings provided by some outlets show that in fact there has been negligible public interest in the movie.

*Chairat Khamphon*

10. Mr Khamphon reports that he is conversant with both the Thai and English languages. Exhibit A to his declaration is a document written in the Thai language which depicts the trade mark shown below:



Exhibit B is a translation of the document and shows that it is a trade mark application filed in Thailand by Republic Chemical Industries, Inc., on 28 April 2001.

*The remaining declarations in support.*

11. The declarants, Gallen, Cahill, Einfeld, Ryan, Dimovska, Recchia, Smith, Dogao, Jacombs and Thomson all attest to having watched the cartoon series as children, for varying periods and at various times, from the 1960s to the 1980s. Exhibited to each of these declarations is a representation of the cartoon character alongside the words MR MAGOO. In each of these representations the words and the character are equally prominent.

*Evidence in answer – Brian Ronald Edwards*

12. Mr Edwards declares that he is the Vice President Sales for the opponent, a position that he has held since 1998. He reports that the MR MAGLOO trade mark was first created and adopted in the Philippines in 1999. Mr Edwards provides an account of the etymology of the word MAGLOO which he claims is derived from a combination

of Tagalog and English. The spelling of the word was chosen so that the word would be correctly pronounced by both Tagalog and English speakers. Mr Edwards avers that subsequently a cartoon character was developed by making the 'OO' in the trade mark a pair of eyes over a bulbous nose and rosy cheeks, reminiscent of a clown, (see ¶ 10 above). The trade mark has been applied to adhesives for stationery purposes declares Mr Edwards and is intended to appeal to boys and girls in the four to thirteen years age group. The goods have been exported to Singapore, Malaysia, Thailand and Hong Kong since 2000 and to New Zealand and Australia since 2002. Mr Edwards declares that posters and leaflets printed in the Philippines have been supplied to the applicant's distributor. In Australia the goods have been sold through The Warehouse, Crazy Clarks/Go-Lo, Metcash/IGA, NCD, Lincraft, Kmart, Big W, Woolworths/Safeways, the Reject Shop and other independent office suppliers. Mr Edwards declares that he is not aware of any instances of confusion in the marketplace. He further declares that so far as he is aware the cartoon character MR MAGOO is not well known in the Philippines now and never has been and the airing of the character in America and elsewhere was unknown at the date of creation of the applicant's trade mark, MR MAGLOO. Mr Edwards reports that goods for sale may be seen on the applicant's website [www.repchem.com](http://www.repchem.com).

*Ian Kennedy*

13. Mr Kennedy declares that he is the Marketing Manager of stationery for Hunter Leisure Pty Ltd. He reports that in 2002 he met Mr Edwards in Frankfurt, Germany, at the Paperworld Fair and that subsequently arrangements were made for Hunter Leisure to import MR MAGLOO trade marked glues and adhesives from the applicant. Mr Kennedy avers that the products have been distributed to a wide range of retail establishments through Hunter Leisure's agents in Victoria, New South Wales, Western Australia, South Australia and Queensland. Mr Kennedy declares that that sales have increased since the goods were first imported and that he is unaware of any objections being raised to the sale of the MR MAGLOO products.

*Evidence in reply – Khajaque Kortian*

14. Mr Kortian's evidence in reply took issue with statements made in Mr Edwards' declaration where he detailed the history of the creation and development of the trade mark in 1999. Exhibit KK-1 comprises printouts from the applicant's website, dated 5

January 2005, including one headed 'NEW!' and showing various MR MAGLOO products.

15. Without any knowledge of when this material first appeared on the Internet I cannot find that this material conflicts with Mr Edwards' sworn statement that the trade mark MR MAGLOO was created and adopted in 1999.

*Henry Tek Wah Sun*

16. Mr Sun declares that he is a paralegal in the employ of Spruson & Ferguson. He declares that in late December 2004 he conducted a telephone survey with a number of retail outlets referred to in the Edwards declaration. Exhibit A to this declaration is a table setting out the findings of this survey. The interviewees were asked three questions,

- Do you sell MR MAGLOO adhesives or glues?
- [If yes] How long have you sold MR MAGLOO products?
- Is the MR MAGLOO character related to the MR MAGOO television cartoon character, who is the near blind man?

17. I place little weight on this evidence which was more in the nature of a straw poll than an independent survey. The final question effectively directed the participants to make a connection between MR MAGLOO and MR MAGOO, a connection that may not have been made at all if Mr Sun had not brought the character and his characteristic myopia, directly to their attention.

### **Grounds of opposition**

18. At the hearing Mr Kortian pressed grounds of opposition under sections 59, 60 and 42(b) of the Act. The remaining grounds were not pressed and for the sake of completeness I now find that they have not been established.

### **Submissions and the law**

#### *Section 59*

Section 59 of the Act states,

The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or

(b) to assign the trade mark to a body corporate for use by the body corporate in Australia; in relation to the goods and/or services specified in the application.

19. The wording of this section shows that it is concerned with the applicant's present intentions in relation to the mark. Thus the relevant date is not the priority date of the application, but the date on which the application was opposed.
20. Mr Kortian submitted that although it may be inferred that the filing of an application *prima facie* may constitute evidence that the applicant had, at the time of filing, an intention to use the mark in respect of the goods claimed, any such inference may in the circumstances of the case be displaced. He observed that the goods specified fall in class 1 and that the applicant's own evidence shows that the mark is intended for use, and is in fact used, in respect of stationery adhesives which fall in class 16. Mr Kortian strongly argued that any *prima facie* inference in favour of the applicant must be displaced and that an inference could now be drawn that at the priority date and at the time of the opposition, the applicant had no reasonable intention of using the trade mark in relation to any of the goods nominated in the application.
21. Goods are classified in classes 1 to 34 and services in classes 35 to 45. The dividing of goods and services into various classes is a somewhat arbitrary administrative tool which allows searching for similar trade marks to be more closely focused than would be the case if all 45 classes had to be searched. The *International Classification of Goods and Services, (Nice)*, allocates the class into which the various categories of goods and services fall and is the official guide used by IP Australia. It is a far from perfect tool. More important than the nomination of the class is a clear and concise specification of goods. If the exact nature of the goods or services is clear the correct class/es may be determined and if necessary the application can be amended by changing the class number or adding or deleting a class or classes.
22. The nominated goods are:  
*Adhesives and glues; adhesive preparations and compositions including construction adhesives.*

The nominated class is 1 and without further information that could be the correct class. However, adhesives and glues depending on their nature or the uses to which they are put fall in classes 1, 3, 5 or 16. When an application is filed and the specified

goods could fall in the nominated class the goods will not be queried. It is assumed that the applicant knows the correct class. It is only when the applicant provides further information about the goods or services, such as through the filing of evidence, that it may be found that the goods are incorrectly classified.

23. In this case the applicant's evidence shows that the goods of interest are properly classified in class 16. I informed the applicant that in accordance with section 65(3) of the Act I would be prepared to amend the goods to *Adhesives and glues for stationery and craft purposes* and the class to 16, if it so wished. The specification of goods uses the term 'construction adhesives'. Children at pre-schools and childcare centres are frequently occupied in the construction of fantastic structures from recycled household materials for which adhesives are used. However, I consider the words 'craft' more clearly identifies the type of adhesive used than the word 'construction' although such would not be incorrect. I allowed both parties additional time in which to file and serve written submissions on the proposed amendment.
24. In his written submissions, Mr Kortian submitted that the application was at all times represented by a firm of trade mark attorneys and not a misinformed self-filer. He noted that at no time was an application made by the applicant to address a mistake of fact or error in the classification. I think at this point it should be noted that classification of goods and services is difficult and even trade mark specialists more than occasionally file applications with specifications that do not in fact accurately reflect the goods of interest to the applicant. Mr Kortian submitted that as the applicant had previously applied to register the trade mark MR MAGLOO and device for goods in class 16 it therefore at all times knew the difference between adhesives for use in industry in class 1 and adhesives for stationery purposes in class 16. He argued strongly that at no time did the applicant have an intention to use the trade mark in relation to class 1 goods and that in consequence the ground of opposition under section 59 should be found.
25. It is true that the applicant filed an earlier application, 820875, in class 16 for goods that clearly fall in that class and that application lapsed. Subsequently a third party, well known for its adhesives, filed an application, 879470, in class 1 for goods identical to those specified in the subject application. The subject application was filed some two months later by Dart D D Braeder. Trade mark 879470 was withdrawn

shortly after filing and the subject application, 884780, was assigned to the applicant, Republic Chemical Industries, Inc, approximately two months after it was filed. It is difficult to understand why Mr Braeder chose to file his application for the identical mark and identical specification of goods while trade mark 879470 was still current. I think it is safe to infer however, that Republic Chemical Industries, Inc, made it known to both parties that it had created and used the trade mark and had an ongoing interest in using MR MAGLOO for adhesives and glues.

26. On the day that the notice of opposition was filed and served the applicant had a present and ongoing intention to use the trade mark in respect of adhesives and glues and has in fact used the trade mark in respect of those goods. In the light of the evidence of use and Mr Edwards' declaration the class nominated is clearly incorrect. The goods specified in the application are not qualified in any way that clearly puts them in class 1 or class 16. Not until the evidence in answer was filed by the applicant was it apparent that the wrong class had been nominated. The applicant promptly filed a fresh application in class 16 and chose, for whatever reason, to await the outcome of the opposition process in respect of the subject application.
27. Section 59 makes no mention of the class into which the goods may fall, merely referring to the goods and/or services specified in the application. I find that at the relevant date the applicant had an intention to use the trade mark and in fact was using it for the specified goods. The specified goods are wrongly classified as being in class 1 and that error in the classification should be corrected to show the class as class 16.
28. The section 59 ground of opposition has not been established.

*Section 60*

29. In order to satisfy a ground of opposition under the provisions of section 60 of the Act, the opponent must establish that the applied for trade mark is substantially identical with or deceptively similar to another trade mark or trade marks that have acquired a reputation in Australia before the priority date of the applied for trade mark and, because of that reputation, use by the applicant of its trade mark, would be likely to deceive or cause confusion. Section 60 does not require the trade mark on which the opponent relies to be registered or the subject of an application for registration.

30. Mr Kortian did not argue that the trade marks are substantially identical

*Deceptive similarity*

31. Section 10 of the Act provides that 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.
32. Mr Kortian submitted that the tests for determining deceptive similarity are identified in *Shell Co of Australia v Esso Standard Oil*, (1963) 109 CLR 407 and in *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641, where their Honours Dixon and McTiernan JJ said,

An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark .... The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark ... 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, then similarities both of sound and of meaning play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution..... The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard.

33. French J. in *Registrar of Trade Marks v Woolworths* 45 IPR 411 re-stated the propositions of Kitto J. in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 on the issue of deceptive similarity 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.

34. In support of his claim that the marks are deceptively similar Mr Kortian also referred to other well known authorities on the matter such as *Re Application by The Pianotist Co Ltd* (1906) 23 RPC 774, *Re Bali Trade Mark* [1969] RPC 472 as well as *Woolworths*, above. Mr Kortian noted that ‘in most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impression or by some significant detail’ per *de Cordova v Vick Chemical Co* (1951) 68 RPC 103. Mr Kortian submitted that in both marks the important first elements are identical and that both marks end in a visually and phonetically similar ‘OO’. He submitted that the target market for the applicant’s goods are children and their parents, and as the goods are relatively cheap and readily purchased in a supermarket or stationery store they are likely to be the subject of an impulse purchase. In these circumstances of trade, Mr Kortian argued that there is a real tangible danger that consumers may be confused into thinking that the applicant’s goods come from, or are licensed by, the producers of the MR MAGOO animated cartoon series.
35. Ms Champion did not agree. She observed that in Australia the MR MAGOO mark has only been used in the context of the MR MAGOO cartoon series and the MR MAGOO movie. She said MR MAGOO serves to identify a cartoon character rather than as an identifier of a particular product and its manufacturer. Ms Champion submitted that all the evidence shows use of the words MR MAGOO in close association with the character MR MAGOO and that accordingly, an inextricable link

has been created in the minds of consumers between the name and the character. She argued that any transient association between MR MAGOO and MR MAGLOO would be immediately dispelled by the failure to locate the MR MAGOO character.

36. Ms Champion argued that consumers are unlikely to be confused between the trade marks and noted that Kenny J in *Fyna Foods Australia Pty Ltd v Cobannah Holding Pty Ltd* [2004] FCA 1151(9 September 2004) took into consideration the evidence of a Mr Klein of The Klein Partnership, a market research firm where he said,

Children and adults have, in my experience, proven themselves to be extremely savvy and discerning when it comes to packaging, packaging graphics, brand names, brand personalities and overall get-up of a product. They can readily identify differences between products and brands. In my opinion, consumer shopping behaviour today is selective and discerning. In the rush to complete a shopping/buying task, consumers are skilled at quickly and readily detecting differences between products and brands, no matter how similar.

37. I think it is very likely that adult consumers, who may remember the cartoon series, on seeing MR MAGLOO products, will be reminded of the character MR MAGOO and given that the goods are adhesives and glues it may occur to them that MR MAGLOO is a somewhat impertinent reference to MR MAGOO and his propensity for finding himself in sticky situations. However, making reference to another trade mark is allowable providing it does not result in consumer deception or confusion. I do not think that consumers will be confused into a belief that the goods have any connection at all with the producers of the cartoon character. Younger consumers are unlikely to know of MR MAGOO but even if they were it is likely, I think, because of the nature of the applicant's goods they will discern the difference in the suffixes and not mistake GOO and GLOO.

38. I agree with Ms Champion that the words MR MAGOO are inextricably linked with the cartoon character MR MAGOO. The MR MAGOO film produced in 1997 and starring Leslie Nielsen as MR MAGOO was clearly unsuccessful at the box office and has since enjoyed little success in the video hire market, (Bluett declaration). It is doubtful if the film succeeded in reviving interest in the cartoon or that it in any way contributed to the reputation of MR MAGOO. It is clear that in the United States Mr MAGOO products have been merchandised but there is no evidence that MR MAGOO merchandise has ever been produced for or sold in the Australian market.

Exhibit F to the first Kortian declaration shows a range of MR MAGOO merchandise advertised online on Ebay but there is no evidence that any of these products have been purchased by consumers in Australia. The advertising appears to be directed generally to the American market. For example prices appear only in US\$. There is no indication that the goods are being specifically directed towards Australian consumers.

39. The comparison of trade marks takes place in the context of the goods and services of the parties. As noted by French J in *Woolworths*, above, at paragraph 40,

In the end there is one practical judgment to be made. Whether any resemblance between different trade marks for goods and services renders them deceptively similar will depend upon the nature and degree of that resemblance and the closeness of the relationship between the services and the goods in question. It will not always be necessary to dissect that judgment into discrete and independent conclusions about the resemblance of marks and the relationship of goods and services. Consistently with that proposition, the Registrar or a judge on appeal from the Registrar could determine in a particular case that, given the limited degree of resemblance between the relevant marks he or she could not be satisfied, no matter how closely related the goods and services concerned, that the use of the applicant's marks would be likely to deceive or to cause confusion.

40. Even if the words MR MAGOO and MR MAGLOO do closely resemble each other there must be some reasonable basis in the minds of consumers for a belief that a similarity in the trade marks denotes a common origin or that the goods and services of the parties are in some way connected. Here there is no obvious connection between the opponent's cartoon entertainment services and the applicant's adhesives and glues. While it is a modern day common practice for the characters in children's films and television series to be merchandised, take for example Big Bird, Ernie and Bert from Sesame Street, Harry Potter and Shrek, it was not such a common practice in Australia when the MR MAGOO series was seen on television. There is no evidence of brand extension or merchandising of the MR MAGOO character in Australia. The likelihood therefore, of consumers believing that a connection exists between the applicant's trade mark and the opponent's cartoon character is fanciful.
41. I find that in the context of the respective parties' goods and services these trade marks are not deceptively similar. The section 60 ground is not established.

*Section 42*

42. So far as it is relevant to this application section 42(b) of the Act provides that an application for the registration of a trade mark must be rejected if its use would be contrary to law. The test to be satisfied is that use *would*, rather than *could*, be contrary to law per, *Advantage Rent-a-Car Inc v Advantage Car Rental Pty Ltd* [2001] FCA 683.
43. Mr Kortian alleged that use by the applicant of its trade mark would contravene sections 52 and 53 of the *Trade Practices Act 1974*, (TPA) because, he said, its use would lead consumers into a belief that the applicant's goods were in some way connected with the opponent.
44. The relevant standard to be applied is that there must be a 'real or not remote chance or possibility' of a reasonably significant number of people being misled or deceived per *Equity Access Pty Limited v Westpac Banking Corporation* (1989) 16 IPR 431. In *Australian Law of Trade Marks and Passing Off*, 1990, at page 456, D R Shanahan says,
- 'Misleading conduct does not merely cause confusion; it actually directs a person towards the wrong choice'.
45. On the basis of the evidence before me and the submissions made at the hearing I am not convinced that use of the applicant's trade mark would contravene the TPA and thus also be contrary to law in terms of section 42(b) of the Act. This ground of opposition is not established.

**Decision**

46. The opposition to registration of this trade mark has been unsuccessful as the opponent has not established any of the grounds of opposition on which it relied. Therefore, I direct that trade mark application number 884780 shall be amended to class 16 and that the goods shall be amended to *Adhesives and glues for stationery and craft purposes*. One month from the date of this decision the application may then proceed to registration. If the Registrar has been served with a notice of appeal before

that time, I direct that registration shall not occur until the appeal has been decided or discontinued.

**Costs**

47. Both parties applied for costs. As the applicant has been successful in these proceedings, I order costs against the opponent and direct that the opponent pay the costs of the applicant in accordance with the Official Scale set down in Schedule 8 of the *Trade Marks Regulations 1995*.

Mary Skivington  
Hearing Officer  
Trade Marks Hearings  
2 November 2005