



## TRADE MARKS ACT 1995

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

Re: Opposition by Vieri Restaurant (Darling Harbour) Pty Ltd & Vieri Restaurant (NSW) Pty Ltd to registration of trade mark application 915067(43) - **VIERI** - filed in the name of Steve Di Giorgio.

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<b>DELEGATE:</b>	<b>Jock McDonagh</b>
<b>REPRESENTATION:</b>	<b>Opponent:</b> Did not appear <b>Applicant:</b> Mr Mel Ciampa, agent, with Mr Di Giorgio
<b>DECISION:</b>	1. Section 52 opposition. Grounds of opposition under sections 41, 42, 43, 44, 58, 59 and 60 - section 58 ground established -registration refused 2. Costs awarded against applicant

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#### **Background**

1. Steve Di Giorgio (“the applicant”) has filed application to register the trade mark, details of which follow:

Application Number: 915067

Priority date: 3 June 2002

Goods: **Class 43:** Restaurant, wine bar, pizzeria, pub, tavern, cafe and brassiere [*sic*] services

Trade Mark: **VIERI**

Advertised: 24 October 2002

2. On 24 January 2003, Vieri Restaurant (Darling Harbour) Pty Ltd & Vieri Restaurant (NSW) Pty Ltd (“the opponent”) filed notice of opposition pursuant to section 52 of the *Trade Marks Act 1995* (“the Act”). The notice specified nine grounds of opposition.
3. The matter came before me, as a delegate of the Registrar of Trade Marks, for hearing in Sydney on 17 March 2004. The opponent was not represented and relied on

evidence filed in the proceedings. The applicant appeared in person, with Mr Mel Ciampa as his spokesman.

### **Evidence**

4. The evidence filed in this opposition was limited to a declaration by Attilio Labbozzetta dated 19 June 2003. This declaration included Annexures A to G.
5. At the hearing, the applicant wished to give evidence and tender written evidence in answer to the opponent's evidence. I explained that this would not be in accordance with the statutory regime detailed in *Trade Mark Regulations 1995*.
6. Various options open to the applicant were canvassed, including adjournment for the purposes of seeking approval to file further evidence. The applicant ultimately chose to make submissions limited to the law and the opponent's evidence.

### **Grounds 1 & 2: Section 41 - Trade mark not distinguishing applicant's services**

7. There was no evidence, nor were there submissions that would raise prima facie reasons to disturb the original examiner's decision that the applicant's mark distinguished the applicant's services.
8. Given that the opponent is seeking to register the same mark, it is perhaps disingenuous in raising these grounds. I formally dismiss the grounds.

### **Ground 3: Section 42 - Trade mark scandalous or its use contrary to law**

9. There was no evidence, nor were there submissions to support this ground and I dismiss it.

### **Ground 4: Section 43 - a connotation within the trade mark**

10. Section 43 provides:

#### **Trade mark likely to deceive or cause confusion**

**43.** An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade

mark in relation to those goods or services would be likely to deceive or cause confusion.

11. This section does not depend on the existence of a conflicting trade mark. Connotation refers to that which is implied within the mark itself, as a secondary implied or associated meaning: *Down to Earth (Victoria) Co-operative Society Ltd v Schmidt* (1998) 41 IPR 632 at 644 and confirmed in *Winton Shire Council v Lomas* (2002) 56 IPR 72.
12. In the absence of submissions by the opponent, it is not readily apparent what secondary implied or associated meaning is supposed to be connoted by the applicant's trade mark. It seems to me that the opponent is relying on the existence of its own VIERI mark, which is an issue to be considered under s.60 of the act rather than this ground. Accordingly, I dismiss this ground of opposition.

**Ground 5: section 44 - Identical etc Trade marks**

13. There was no evidence of any prior registration or application to which this section would apply. I dismiss this ground of opposition.

**Ground 6: Section 58 - Applicant not owner of Trade Mark**

14. Section 58 provides that the registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark. In order to establish this ground, it is incumbent upon an opponent to show that 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 or services: *Re Hicks' Trade Mark* (1897) 22 VLR 636 at 640.
15. The opponent provided evidence that the opponent commenced operation of a restaurant called *Vieri* in June 1999. The evidence is a statement to that effect in the *Labbozzetta* declaration, and supported by an article in *The Australian* newspaper of 11 June 1999, and an article in *Nine to Five* magazine of November 2002.
16. I am satisfied that the restaurant name functioned as a public use of a trade mark in Australia. I am also satisfied that the opponent was using the same mark as the

applicant's for the same kind of services. This use pre-dates the priority date of the applicant's trademark.

17. Accordingly, I find that the opponent has established that it is owner of the trade mark.

**Ground 7: Section 59 - Applicant not intending to use trade mark**

18. Apart from an assertion in the Labbozzetta declaration, there is no evidence that the applicant did not intend to use the mark. The act of filing an application is prima facie an expression of the requisite intention. The article exhibited as Annexure A to the Labbozzetta declaration contains a comment that raises an implication that the applicant was to use the mark with the opponent. I dismiss this ground.

**Ground 8: s 60 - Reputation**

19. To satisfy section 60 of the Act, the opponent has the burden of establishing the following elements:
  - (a) a pre-existing trade mark;
  - (b) substantial identity or deceptive similarity between the applied for trade mark and the pre-existing trade mark;
  - (c) the acquisition of a reputation in Australia by the pre-existing trade mark; and
  - (d) a likelihood that, because of that reputation, use of the applied for trade mark would be likely to deceive or cause confusion.
20. The evidence, and discussion for the previous ground, shows that the opponent has a pre-existing trade mark that is identical to that of the applicant. Thus the issues to be determined are those relating to paragraphs (c) and (d) above.
21. Reputation can be inferred from a high volume of sales along with substantial advertising and promotional expenditures: *McCormick & Co Inc v McCormick* (2000) 51 IPR 102, at 127. The reputation must be more than minimal, and a substantial or

significant number of persons must be likely to be deceived or confused: *Re Smith Hayden & Co Ltd's Appn* (1946) 63 RPC 97 (Ch D).

22. The evidence that the opponent has provided to support its claim regarding reputation is problematic. The applicant submitted that the turnover stated by the opponent in evidence would appear to be very small for a restaurant of its size and purported reputation. By my calculations, based on the figures provided by the opponent, during the period leading up to the applicant's priority date, the opponent was turning over an average of about \$700 per day. Without further information, it is very difficult to infer from the turnover figures that the restaurant had requisite reputation, indeed it would be difficult to infer that the opponent was a going concern.
23. The advertising figures quoted are in the order of 10 to 20 thousands of dollars per year. Obviously, these are not insignificant sums of money; however, without more information to provide a frame of reference, I am not satisfied that I can draw the inference that this evidences requisite reputation.
24. Of the various newspaper and magazine material exhibited with the Labbozzetta declaration, only two items pre-date the priority date. An article in the sports section of *The Australian* newspaper reports that a Sydney-raised Italian soccer player, Christian Vieri, is a partner in the eponymous restaurant run by the opponent to be officially opened the week after the article. The other exhibit is an advertisement that lists the opponent's restaurant as one of a number of Sydney restaurants serving wines from a vineyard from the Orange region of NSW.
25. The opponent has the burden of establishing its grounds of opposition. The opponent was not represented at the hearing and submissions were not filed. It is not the function of a hearing officer to act as advocate for absent parties.
26. I am not satisfied that the opponent has established a sufficient reputation, such that there is a real and tangible chance that a substantial number of persons finding the applicant's mark used on the relevant goods would be confused or deceived. I find that the opponent has not established this ground of opposition.

**Ground 9: Section 55 “Registrar’s Discretion”**

27. The opponent did not provide evidence or submissions to show whether or not s.55 supports the inference of any discretion to refuse registration. I dismiss this ground.

**Decision and Costs**

28. The opponent has established grounds of opposition on which it relied so that the opposition as a whole has been successful. Pursuant to section 55, I refuse to register Application No. 915067 VIERI.

29. As the opponent has been successful in its opposition, I award costs against the applicant and direct that the applicant pay the costs of the opponent in accordance with the official scale.

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
25 June 2004