



## TRADE MARKS ACT 1995

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

Re: Application 932275 in the name of Bourne Properties Pty Ltd and opposition thereto by ACP Masthead Nominees Pty Ltd.

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<b>DATE OF DECISION:</b>	<b>8 November 2004</b>
<b>DELEGATE:</b>	<b>Ian Thompson</b>
<b>REPRESENTATION:</b>	<b>Applicant</b> Written submissions by Malcolm Brown of Macpherson+Kelley, Solicitors
	<b>Opponent</b> Written submissions by Macek Rubetzki And Michael O'Connor of Dibbs Barker Gosling
<b>DECISION:</b>	<b>S52 Opposition:</b> ss42 and 60 – no evidence from opponent of its brand extension of trade mark in relation to goods; no evidence that this is an established practice in relation to magazines or journals; opposition not established.

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#### Background

1. The details of trade mark application 932275 are as follows:

Appn Number: 932275  
Owner: Bourne Properties Pty Ltd ('the owner')  
Priority Date: 28 October 2002  
Advertised: 20 March 2003, *Australian Official Journal of Trade Marks*  
Goods: **Class: 11** Domestic, commercial and industrial tapware, plumbing supplies, bathwares, shower recesses, spas, sinks, toilet suites  
Trade Mark: BELLE

2. On 21 May 2003, ACP Masthead Nominees Pty Limited ('the opponent') filed Notice of Opposition to the registration of the trade mark. The Notice claims most of the available grounds of opposition. Since then, the opponent has filed evidence in support of its opposition. The applicant has not served evidence in answer.

3. Neither party has requested a hearing and the matter has been allocated to me, as a delegate of the Registrar of Trade Marks, for my decision on the materials on the official file. Both parties have filed written submission by their attorneys.
4. The opponent pursues grounds in terms of sections 42 and 60 in its submissions and for the sake of completeness I now find that it has not established those other grounds enlisted in the Notice of Opposition.

### **Evidence**

5. The evidence shows that the opponent publishes a magazine under the trade mark BELLE. The subject matter of this magazine is design, with an emphasis on interior design, furnishing and fittings for houses. The advertising within the magazines in general reflects this emphasis, with goods similar to those of the opposed application being included amongst these.
6. The magazine has been published in Australia since the early seventies and has built a modest to medium circulation and revenues of which confidential details are provided. I am prepared to accept, for the purposes of these reasons and my decision, that it had a reputation within Australia at the date that this opposed application was filed (28 October 2002).
7. The evidence also shows that the opponent has licensed its BELLE trade mark to Belle Property Pty Ltd to use in relation to real estate services for which the opponent receives an annual licensing fee.

### **Reasons**

8. The opposition is in terms of section 52 the *Trade Practices Act 1974*, via section 42 of the *Trade Marks Act 1995* and section 60 of the *Trade Marks Act 1995*.
9. In the context of an opposition of this type, the 'bar' is potentially higher under section 52 of the *Trade Practices Act 1974* than it is under section 60 of the *Trade Marks Act*

1995. Section 52 of the *Trade Practices Act 1974* uses the expression, “likely to mislead or deceive” and section 60 utilises the expression, “likely to deceive or cause confusion”. As a mere state of confusion is not sufficient to trigger section 52 of the *Trade Practices Act 1974*, if the opponent does not, in the context of these proceedings, establish its opposition in terms of section 60, it cannot establish its grounds in terms of section 52 of the *Trade Practices Act 1974*. I will therefore first consider section 60 of the Act as it applies to the opponent’s evidence as, if this ground is not established, then neither could be the ground under section 52 of the *Trade Practices Act 1974*.

### **Section 60**

10. Section 60 of the Act provides:

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

**60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical 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.

11. In order to establish a section 60 ground of opposition the opponent must establish that the applied-for trade mark is substantially identical with, or deceptively similar to, another trade mark that enjoyed a reputation in Australia at the priority date of the applied-for mark and that as a result of that reputation, use of the applied-for trade mark would cause deception or confusion.
12. As the trade marks are identical, and the opponent’s trade mark enjoyed a reputation within Australia at the priority date, what I am to consider is whether because of that reputation the use of the applicant’s trade mark would be likely to cause deception or confusion.

13. The applicant, in its submissions, draws my attention to another registration – that of the trade mark COSMOPOLITAN for printed publications. It co-exists with a number of registrations of COSMOPOLITAN in the names of other traders. It is not, of course, obvious that the registrations are all being used or that the COSMOPOLITAN magazine had a reputation at the priority dates of the other registrations of the word.
14. The opponent draws my attention to its brand extension activities in relation to the trade mark in that it has licensed a real estate agency to use the trade mark in relation to its services. The brand extension activities are thus well known, says the opponent, in the relevant market.
15. Further, there is an association, claims the opponent, between the opposed services and the goods and services for which the opponent's trade mark has acquired a reputation.
16. In *Telstra Corporation Limited v Royal & Sun Alliance Insurance Australia Limited* [2003] FCA 786, ('the Goggomobil Case') Merkel J said at paragraph 57:

Secondary branding or suggestive brand advertising occurs when a word, character, symbol or image creates, on its own, instant recognition or association with a particular product or business. The adoption of such characters, symbols or images by another advertiser will usually raise the question of whether that advertiser is representing that it, or its goods or services, have an affiliation, association or connection they do not have.

17. His Honour went on to say, at paragraph 58:

*Twentieth Century Fox Film Corporation v South Australian Brewing Co Ltd* (1996) 66 FCR 451 ("the Duff Beer case") was concerned with the name "Duff", which had acquired a powerful secondary meaning in relation to "Duff Beer" as a result of the use of the name "Duff Beer" in the television program "The Simpsons". Tamberlin J concluded (at 470) that the use by the respondents of the term "Duff Beer" was misleading and deceptive as it is likely to lead to an assumption by consumers that permission had been given by "The Simpsons" to the respondents to produce "Duff Beer". His Honour found (at 467) that the respondents' intention was "to `sail as close as possible to the wind' in order to `cash in' on the reputation of `The Simpsons' without stepping over the line of passing off or deceit".

18. The cases show that not only does there generally exist a pattern of ‘secondary branding’ or ‘brand extension’ on the part of the plaintiff but also the goods or services complained of have such a connection with the trade mark that they create an expectation in the minds of the relevant public that they originate with, are endorsed by, licensed by or marketed with the permission of the plaintiff (Duff Beer). An exception to this appears to be when extensive advertising of a peculiarly idiosyncratic indicium has attached the sign to a particular trader (Goggomobile).
19. I do not think that there is any immediate or automatic association between either the opponent’s BELLE design magazine, or real estate services, and “Domestic, commercial and industrial tapware, plumbing supplies, bathwares, shower recesses, spas, sinks, toilet suites” such that it is likely to confuse or deceive in the relevant part of the public. Neither do I think that such a member of the public who might have read the opponent’s magazines, and be aware of the opponent’s sole brand extension of this trade mark into real estate services, would (when encountering the applicant’s goods bearing the trade mark) think of the opponent’s trade mark or magazine or believe that the goods of the applicant might originate from, or be manufactured under the license of, the opponent, or be connected with the opponent in any way at all.
20. The fact is, despite a plethora of magazines on the market, dealing with every conceivable subject, brand extension of trade marks from magazines into goods appears to be unusual. The opponent has stated that it has licensed the use of the trade marks DOLLY and THE AUSTRALIAN WOMEN’S WEEKLY for a range of goods but has not shown that goods have actually been produced under the licenses or, if they have, that the public realises this. The opponent has not shown that the public is actually aware that the real estate agency operates under the license of the opponent and there is nothing in the real estate agency’s website (or its two examples of advertising in evidence) which show this. Thus it is impossible for me to gauge public expectation of

the practice in relation to the BELLE trade mark in particular, or habituation of the public through the similar activities of the opponent in chief, or other publishers in general, in relation to other magazines.

21. The trade mark in question is an ordinary word of the English language, meaning ‘a beautiful or very attractive girl or woman’. While the word has no special meaning in relation to the goods or services of either party, neither is it a completely arbitrary, idiosyncratic, or invented word – it is a word which many traders use as either a trade mark or part of a trade mark: there are 75 records on the Trade Marks Office database of registered, pending and lapsed trade marks which comprise or include the word BELLE.
22. Idiosyncrasy might in part contribute to confusion or deception as in the Goggomobile case. However, a trade mark being somewhat idiosyncratic is, of course, no guarantee in itself that a person encountering goods or services will assume a connection in the course of trade between the ‘offending’ goods or services and an aggrieved party: *McIlhenny Co v Blue Yonder Holdings Pty Ltd formerly trading as Tabasco Design & Anor* [1997] 962 FCA (‘the Tabasco case’).
23. There is, in my opinion, nothing in the proposed use of the opposed trade mark which could connect it to the opponent if it is used in an ordinary manner.
24. The opponent has not established its opposition under section 60 of the Act. As such, it cannot establish its grounds under section 52 of the *Trade Practices Act 1974* as previously discussed.
25. The opponent has not established its opposition.

**Direction**

26. Subject to the opponent notifying the Registrar of an appeal against my decision within one month of the date of this decision, the application may proceed to registration. If

such appeal is notified and not withdrawn, the application should be dealt with as the Court directs.

**Costs**

27. The opponent sought its costs should it be successful in these proceedings. The applicant having been successful is entitled to its costs, which I so order.

Ian Thompson  
Hearing Officer

8 November 2004