



TRADE MARKS ACT 1995

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

Re: Opposition by Hasbro Inc to registration of trade mark application 937827(28)(41) LIVE-OPOLY filed in the name of Imagination Holdings Pty Ltd.

DELEGATE:	Ian Thompson
REPRESENTATION:	Opponent Ron Webb of Counsel instructed by June Savage of Baker & McKenzie. Applicant Margaret Shearer of Banki Haddock Fiora.
DECISION:	1. Section 52 Opposition: sections 42, 43, 44 and 60 – grounds of opposition established under sections 43, 44 and 60 2. Costs awarded against applicant.

Background

1. Imagination Holdings Pty Ltd., ('the applicant') of Kent Town, South Australia, has filed application to register a trade mark, current details of which are:

App No: 937827
Priority Date: 13 December 2002
Goods/Services: **Class 28:** Toys, games and playthings; board games; computer and video games; all included in class 28
Class: 41 Entertainment and education services in the form of television and radio programs; entertainment and education services provided online or over the Internet; live events
Trade Mark: LIVE-OPOLY

2. No grounds for rejection under the *Trade Marks Act 1995* ('the Act') were raised against the application during examination and it was advertised as accepted for possible registration in the *Australian Official Journal of Trade Marks*, on 22 May 2003.

3. On 14 July 2003, Hasbro Inc of Rhode Island, USA, ('the opponent') filed Notice of Opposition ('the Notice') to registration of the trade mark. The Notice cites most grounds available under the Act – of these the opponent relied on grounds under sections 42, 43, 44 and 60 at the hearing.
4. The parties have served and filed evidence in support and evidence in answer in accordance with the Act and regulations thereto.
5. The hearing was held before me, as a delegate of the Registrar of Trade Marks, in Sydney, on 20 July 2005. Ron Webb of Counsel, instructed by June Savage of Baker & McKenzie, represented the opponent; and Margaret Shearer of Banki Haddock Fiora represented the applicant.

Evidence

Evidence in support

6. The evidence in support of the opposition comprises statutory declarations by Paul Normand Vanasse and Amanda Blackhall.
7. Mr Vannasse is Director of Intellectual Properties of the opponent and his declaration is made from an American and international perspective. He states that the opponent manufactures and sells the world's most popular board game, MONOPOLY. The opponent also owns the trade mark MONOPOLY by virtue of the merger of Tonka, Inc., the parent of Parker Brothers, Inc, into Hasbro on 1 January 1996.
8. The fame and reputation of the MONOPOLY trade mark is not in dispute in these proceedings – I will, however, give some indication of the history of the trade marks and indications of its fame to support my reasons and decision in this matter.

9. Mr Vannasse sets out a history of Parker Brothers adoption of the game in 1935 – it was sold to them by a Mr Charles Darrow. The object of the game is familiar to most people – it is to win and develop properties, create wealth, amass a ‘play’ fortune and (by bankrupting one’s fellow players) win the game.
10. The game is sold around the world in numerous editions with property names tailored for the major countries in which the game is sold – for instance, MONOPOLY games sold in South American countries have property names appropriate to those countries. There are editions sold in Braille and others sold to specific interest groups.
11. As well as the board game, the opponent produces, or has licensed, other goods bearing the MONOPOLY trade mark including a card game, a Sony Playstation game, a Nintendo 64 game, a CD-ROM, hand held electronic games and a three dimensional puzzle. The MONOPOLY trade mark is also licensed to be used on poker machines.
12. In addition, the opponent licenses, or has licensed, the use of the MONOPOLY trade mark on a range of goods including clothing, footwear, mugs, glasses, dishes, toothbrush holders, soap dishes, blankets, toys, watches, jewelry, desk accessories, confectionery, Christmas tree ornaments and picture frames.
13. It is not clear from this declaration which, if any, of these latter goods have been sold in Australia.
14. Mr Vanasse also attests to print and electronic media advertising of the opponent’s MONOPOLY game – however, again, it is not clear from this declaration to what extent the goods have been advertised in Australia, or to what extent the opponent’s websites have been accessed from Australia.

15. There are sales and advertising figures appended to this declaration from the USA, Canada and the UK. These are considerable.

16. The MONOPOLY trade mark is registered by the opponent in most countries around the world, including Australia. Details of its Australian registrations relevant to these reasons and decision are:

Reg Number 69538
Priority date: 14 January 1937
Goods/Services: Class: 28 Games of chance and/or skill
Trade Mark: MONOPOLY

Reg Number 404491
Priority date: 29 February 1984
Goods/Services: Class: 28 All goods in this class; including games and playthings, board games, electronic games in this class, electronic board games, digital electronic games in this class, battery powered games and electrically powered games in this class
Trade Mark: ANTI-MONOPOLY

Reg Number 764850
Priority date: 16 June 1998
Goods/Services: Class: 28 Games and playthings including board games
Trade Mark: MAKE YOUR OWN OPOLY

Reg Number 776612
Priority date: 26 October 1998
Goods/Services: Class: 9 Gaming, amusement and entertainment apparatus and equipment in this class including coin operated machines, poker machines, slot machines, gaming machines having video screen displays and wide area progressive gaming machines, computer software and parts, fittings and accessories in this class for all the aforesaid goods
Class: 41 Entertainment services relating to gaming and gambling; provision of gaming equipment and machines; conducting gaming services associated with wide area progressive gaming machines
Trade Mark: SLOTOPOLY

17. Some indication of both the MONOPOLY game's pervasiveness and notoriety is illustrated by the following facts: Parker Brothers, at the request of NASA, designed

MONOPOLY games to be played in space by astronauts. The (English) Great Train Robbers in 1967 played a game of MONOPOLY shortly after the robbery with real money. In 1972, outrage expressed by MONOPOLY players forced a back-down by city officials who proposed a change of street names in Atlantic City. The largest game of MONOPOLY took place in 1987 when American students commandeered a city block within the college campus. There have been over five billion little green houses 'built' since 1935. The *Guinness Book of Records* estimates that there are 500 million games of MONOPOLY played each year making it the world's most played board game.

18. Amanda Blackhall is Product Manager, Games and Puzzles of Hasbro Australia Pty Limited, ('HAPL'), a licensee of the opponent and makes her declaration from an Australian perspective. The following facts emerge from her declaration.
19. The game of MONOPOLY was, according to this declaration, first sold in Australia by the opponent in the 1950s (although I note that the *Musicopoly* decision, below, gives a date in the 1940s). Ms Blackhall gives revenue figures derived from the sale of the opponent's monopoly board games in Australia – these are substantial.
20. There is an Australian edition of the MONOPOLY game which features Australian street names such as Macquarie Street and Pitt Street, and which has a koala as one of the tokens. As well as the British and Australian editions which have been sold in Australia, the opponent has sold an Australian Rules Football League Edition which features football teams instead of streets.
21. Other editions of the opponent's MONOPOLY game which are, or have been, recently sold in Australia by the opponent include the Junior, Junior Toy Story, Simpsons, Disney, Nostalia, World Cup, Manchester United, Star Wars, Star Wars Episode One,

Millennium, AFL, Money, Pokemon, Pokemon Gold and Silver, and Stock Exchange. A number of specialty stores also import overseas editions of the opponent's MONOPOLY game into Australia and sell them. These games include the following editions of the opponent's MONOPOLY game: the Garfield 25th Anniversary, Justice League of America, Muppets, Peanuts, Scooby-Doo, Simpsons, Spider-Man, Astronomy, Aviation, Betty Boop, Cola-Cola, Corvette, Elvis 25th Anniversary, Ford 100th Anniversary, I Love Lucy, Mountaineering, National Parks, Dog Artist, Wizard of Oz, X-Men, Las Vegas, New York City, Golf, Harley-Davidson and US Space Program.

22. Other products that are made or licensed for sale in Australia by the opponent under the MONOPOLY trade mark include a card game, computer games for PC, a new edition game for PC, Junior game for PC, a tycoon game for PC, as well as editions for handheld games controllers.
23. HAPL has extensively advertised and promoted goods sold under the trade mark in Australia, examples of advertisements in print and electronic media are appended to Ms Blackhall's declaration. HAPL also displays goods sold under the trade mark at trade fairs and organizes the Australian heats of the World Monopoly Championships at which Australia has been represented since 1980. HAPL organizes a media 'blitz' in relation to this competition, when it occurs, in Australia.
24. The opponent and HAPL license use of the MONOPOLY trade mark in Australia by other entities to 'cross promote' their goods or services; such entities have in the past included the ANZ Bank, McDonald's Restaurants, the ATO, Raine & Horne Canberra (a real estate agency), the *Sydney Morning Herald*, Bon Bon Buddies, The Franklin Mint, Scratch Lotteries through Oberthur Gaming Technologies, WMS Gaming –

poker machines, and WT Wilson Desk Accessories. The declarant appends confidential details of substantial revenue derived from licensing use of the trade mark to these other entities.

25. Current licensing to third party traders include: educational books, Atari games, a Gold Coast edition of the game, mortgage promotions, banks promotions, boxer shorts, a food promotion and real estate.
26. Ms Blackhall attests that companies related to the applicant and opponent recently had a licensing agreement concerning the use of the trade mark MONOPOLY South Australian Charity Edition – however, this feature of the evidence was not strongly pushed at the hearing; the whole of the agreement is not in evidence; and, as far as the agreement is concerned, there are obvious problems with privity in as far as it might possibly relate to the parties before me. As far as it might relate to the good faith of the applicant, this evidence is not relevant.

Evidence in Answer

27. Shane Yeend is CEO of Imagination Entertainment Pty Ltd and Director and Secretary of Imagination Holdings Pty Ltd. The following facts relevant to these reasons are derived from his declaration.
28. The opponent's trade mark MONOPOLY is used by the opponent and its licensees in a very stable way. The opponent has a style guide which is used by it and its licensees to ensure that word MONOPOLY and the symbols connected with the game are used uniformly and consistently throughout the world.
29. Material exhibited to the Yeend declaration suggests that the game evolved from one called The Land-Lord's Game in the public domain in the second decade of the 20th

century within the United States of America and evolved into games which went by the names of MONOPOLY and FINANCE. Charles Darrow was introduced to the MONOPOLY game in the early 1930s and sold it to Parker Brothers in 1935.¹

30. There are, in the United States, avers Mr Yeend, many other -OPOLY suffixed games produced by other traders, which co-exist with the MONOPOLY trade mark of the opponent. Material appended to the declaration shows that others, apart from the opponent, market OPOLY suffixed games in the United States and Canada with one trader, Late for Sky Productions, Inc., which sells games based on 11 cities and 78 universities within the United States.
31. Mr Yeend lists some 104 'Opoly' suffixed games which are available via the Internet and thus could be purchased by the public in Australia. There is no evidence that such purchases have occurred and I think that it is unlikely that many of the Australian public would purchase games which are obviously designed with other specialty purchasers in mind, such as Arizonopoly, Irishopoly or NBA-opoly which occur in the list of games in Mr Yeend's evidence.
32. At least four specialty games stores in Australia sell American OPOLY suffixed games (ie Kiss-opoly, Mowtownopoly and Cat-in-the-Hat Opoly) which are unconnected with the opponent's MONOPOLY trade mark.
33. There are 15 trade mark applications or registrations of trade marks in the United States which include the 'suffix' 'opoly' which belong to persons other than the opponent.

¹ *Anti-Monopoly Inc v General Mills Fun Group Inc* No 81-4281, Supreme Court of the USA.

Observations

34. I consider that Mr Yeend's evidence about the history of the opponent's trade mark in the United States and Canada (and the suffix 'Opoly's consequent generic nature in those countries) has little or no application in the matter before me. There is no evidence that the games of Land-Lord, FINANCE or MONOPOLY were ever in the public domain in Australia. Further, the wide range of 'OPOLY' games generally available in the United States and Canada are not generally widespread and available for immediate purchase in Australia. Consequently, any conclusion that the Australian public has been habituated to regard the 'suffix' OPOLY as being 'generic' would be unsound – particularly when the weight of the evidence tends to the opposite conclusion. Caution needs to be exercised in extrapolating from the American market to that in Australia in the consideration of what is, and what is not, a 'generic'. For example, the words Yellow Pages are regarded as generic within the United States in respect of telephone directories but yet are a registered trade mark in Australia² because of the differing ways that trade has evolved in the respective countries.³
35. Similar caution should be exercised concerning any notional transfer to Australia of the habituation of the public within the United States and Canada to the number of – OPOLY games in the marketplace in the names of different traders. There is very limited evidence that the Australian public is similarly habituated and the other games which incorporate the suffix OPOLY are few and sold through a very limited number of specialist retailers to what is, as a consequence, a very limited market.

² See for example, Australian trade mark registration No. 820729 in the name of Telstra Corporation.

³ And see, for example, the similar issues in the line of cases such as *Apan Pty Limited v. The Kettle Chip Company Pty Limited* (1994) ATPR 41-353 (1994) 30 IPR 337

36. Without evidence that Internet sales of other traders' OPOLY suffixed games have occurred into Australia, the fact that such trade marks are on the Internet does not lead to a conclusion that they have been used in Australia. A trade mark is a sign that is used in trade (or intended to be used, via an application for trade mark registration) – it follows that without evidence of use or intended use in trade under that trade mark in Australia, it does not qualify to be considered as such under the statutory definition.⁴ An exception to this rule is found where a foreign trade mark has built a reputation within Australia: *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302. However, there is no evidence of weight that the North American OPOLY suffixed trade marks have, individually or collectively, established a reputation in Australia.

Issues

37. As it is not alleged that the trade marks are substantially identical, the nub of this matter lies in questions of the deceptive similarity (in terms of sections 44 and 60) of the trade marks or whether the use of the opposed trade mark by the applicant would mislead or deceive: (In considering grounds under section 42(b), argued at the hearing, I must consider whether the use of the opposed trade mark would trigger section 52 of the *Trade Practices Act 1992*). The remaining ground, which I will address first, lies within section 43 and is whether, because of a connotation within the opposed trade mark, it would in use confuse or deceive.

⁴ 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.

Section 43

38. 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.

39. By the language of section 43, my considerations of the issues involved are limited to connotations arising from the opposed trade mark itself and not through similarities to another trade mark. This approach has been affirmed by the Court in *Big Country Developments Pty Ltd v TGI Friday's Inc*, [2000] FCA 720, 48 IPR 513 at 521:

The case on deception and confusion sought to be made by Big Country and Friday's Australia in the present proceedings is one that falls outside the reasons specified in [section 43]. It does not depend upon some connotation in the registered mark, but upon its similarity to a name used by Big Country and others. So the alleged deception or confusion is not for a reason covered by s 43.

40. The question is, hence: 'given the connotations (if any) in the trade mark LIVE-OPOLY, would the use of the opposed trade mark in relation to the nominated goods and services by the applicant be likely to deceive or confuse'?

41. The trade mark LIVE-OPOLY, considered as a whole, has, as Ms Shearer observed at the hearing, no ascribable meaning. However, the suffix '-OPOLY', is contained within the trade mark as a distinct element and it is this, argues Mr Webb, which gives rise to the connotation.

42. The trade mark MONOPOLY has passed into language; it is contained in *Collins English Dictionary* (1981):

n Trademark a board game for two to six players who throw dice to advance their tokens around a board, the object being to acquire the property on which their tokens land.

43. The *Macquarie Dictionary* supplies:

noun a game played with counters, cards, etc., with the object of one player gaining monopoly controls over the others.

[trademark]

44. However, the question which confronts me is whether the element 'OPOLY' itself has a connotation. The word MONOPOLY is not contained in the opposed trade mark.

45. It is apparent that a sign contained within a trade mark might contain a deceptive or confusing connotation if it resembles or signifies a particular sign which is so ubiquitous, of longstanding, or notorious that it has entered Australian parlance or is shown to have become accepted generally in Australia as connoting a particular person, entity or event or connoting a particular meaning (whether or not that particular sign has trade mark significance). For example, a picture of the face of a woman who resembles the late Princess Diana, the Princess of Wales, is likely to contain a confusing or deceptive connotation within a trade mark proposed to be used for charitable fundraising.

46. It is clear that the opponent's trade mark MONOPOLY has entered Australian parlance. It is a word (albeit with noted trade mark origins) found within dictionaries which are published within Australia. It is possible, hence, to examine the suffix OPOLY in the context of the opposed trade mark, and in the context that it is proposed to be used in relation to games, and pose the question whether it connotes, to Australians, the word MONOPOLY.

47. And, it is relevant to note here that, as MONOPOLY (in the sense that it refers to the opponent's game) is a word in dictionaries and language, whatever rules are contained in the opponent's Style-Guide binding it or its licensees as to the commercial use of the word do not apply in this public use.

48. In my estimation, the element OPOLY within the opposed trade mark will connote to most Australians that the applicant's game is one that is similar to the opponent's game because (in the context of the nominated goods and services) the word MONOPOLY is the word which instantly impresses itself as the only logical and immediate start point for recognition of the significance of the OPOLY suffix within the opposed trade mark. This is not necessarily confusing or deceptive in itself if there is a genus of OPOLY suffixed property games which are widely known by Australians to immediately negate or dispel any misapprehension, mistake or wonderment. In that sense, and if the suffix OPOLY were to only connote a genus of games, the connotation of the OPOLY suffix would only be deceptive or confusing if the applicant's goods and services were not a property game.

49. I think that the problem for the applicant is that, to most Australians, in the context of the nominated goods, the only game that the suffix OPOLY could connote is the MONOPOLY game of the opponent. In that the suffix OPOLY, within the opposed trade mark, is confusing rather than deceptive because most Australians will initially be caused to wonder whether the opponent is marketing, or has licensed, a variant on its game (or that in some way the opposed trade mark should be related to the opponent's MONOPOLY games or activities). Explaining the differences between deception and confusion, Richards J in *Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty. Ltd.* [1979] RPC 410 at 423 says

'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.

50. And in *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 (29 July 1999) at paragraph 47 French J says:

The policy of the 1995 Act can be said to some extent to have shifted the balance of the objectives of trade mark law more towards the identification and protection of commercial products and services than the protection of consumers, although the latter remains an objective. In respect of deceptive trade marks the interests of consumers are also protected by comprehensive Federal and State laws relating to conduct which is misleading or deceptive or likely to mislead or deceive. The trade mark law concept of confusion in the sense of mere wonderment as to common origin or connection has little part to play in the consumer protection statutes. That, no doubt, is because "confusion" used in that sense, does not of itself lead into error or affect choices at the point of sale. It is perhaps best described in trade mark law as effecting a prophylactic support for commercial distinctiveness.

51. The distinctions here are fine ones, but the connotation within the opposed trade mark is such that the connection in the minds of the Australian public is, in my estimation of the evidence before me, immediate and inevitable with inescapable consequences of confusion as an outcome. This may not persist to the point of sale or lead into error, but the likelihood of an immediate wonderment as to a common commercial origin is, in my consideration of the evidence, unavoidable.

52. The opponent has established its opposition under section 43 to my satisfaction.

Sections 44 and 60

53. As the application is made in respect of goods and services, both subsections 44(1) and (2) are relevant.

54. Section 44(1) of the *Trade Marks Act 1995* 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.

55. Section 44(2) provides similarly for an application made in respect of services.

56. 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.

57. The parties, in their submissions, both directed me to the relevant case-law and presented me with good and cogent argument to support their respective positions.

Ultimately, the start point is at section 10(1) which defines the expression 'deceptively similar' which is common to both sections 44 and 60:

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.

58. Given the similarities of the goods and services, the reputation of the opponent's trade mark and the priority dates of the opponent's registrations⁵ (which predate that of this application), the question ultimately resolves itself to one concerning the similarity of the trade marks of the parties: are they deceptively similar?

59. The test for deceptive similarity was posited thus by Windeyer J in *The Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1961) 109 CLR 407 at 415:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions.

60. And as expressed by 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.

61. What I am to consider is not only the similarity, if any, between the trade marks. What I am to consider is the effect of the similarity in all of the circumstances – according to the particular trade and the potential buyers of the goods and my estimate of their perceptions of the world. Lord Parker (then Parker J) put this aspect of the consideration thus in *Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777, where he said:

⁵ See list under the heading 'Evidence'

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.

62. A further decision brought to my attention by the opponent in this matter is that of the Deputy Registrar, Mrs Hardie, in *Alan Chong v Tonka Corporation* [1994] ATMO 27 (5 April 1994). That case proceeded under the *Trade Marks Act 1955*, ('the 1955 Act') the precursor of the current Act. In opposition proceedings under the 1955 Act, the onus was on the applicant to show that the trade mark was not likely to confuse or deceive. However, as observed by Mrs Hardie in her decision:

I have no argument with this proposition. It is well established law dating back to the directives of *Eno v Dunn* (1890) 7 RPC 311 and *Jafferjee v Scarlett* (1937) 57 CLR 115.

The onus that lies with the opponent, however, is to establish that deception and confusion are likely.

63. The level of the 'high bar' thus remains at the same level as regards deceptive similarity and the likelihood of deception and confusion-- albeit the way in which it is approached as regards 'onus' has obviously changed.
64. However Mrs Hardie concluded that MUSICOPOLY and the MONOPOLY group of trade marks are deceptively similar and I believe that the outcome under the current Act should be the same. I have reached the same conclusion about the opposed trade mark LIVE-OPOLY and the opponent's MONOPOLY group of trade marks which comprise MONOPOLY, MAKE YOUR OWN OPOLY, ANTI-MONOPOLY and SLOTOPOLY, albeit for slightly wider reasons, which I will now explain.

65. In *C A Henschke & Co v Rosemount Estates Pty Ltd* [2000] FCA 1539, the Full Bench of the Federal Court said:

His Honour's reference to the familiarity of the name 'Woolworths' in Australia was appropriate. Where an element of a trade mark has a degree of notoriety or familiarity of which judicial notice can be taken, as in the present case, it would be artificial to separate out the physical features of the mark from the viewer's perception of them. For in the end the question of resemblance is about how the mark is perceived. In the instant case the visual impact of the name 'Woolworths' cannot be assessed without a recognition of its notorious familiarity to consumers."

Woolworths was not an infringement case and, of course, the notoriety taken into account was not any notoriety attaching to marks already registered (or marks applications for which had been lodged before the *Woolworths* application); the notoriety attached to an element of the mark for registration of which *Woolworths* had applied. 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. It is unnecessary to consider whether the cases are authority for precisely that proposition. All that is necessary for present purposes is to hold, as we would, that they are authority for no wider proposition in relation to the relevance, on a question of deceptive similarity in proceedings where it is alleged under s 120(1) that a registered mark has been infringed, of evidence as to the reputation attaching to the mark. A wider proposition would not, in our view, be consistent with the earlier, and binding, authority to which we have referred. It is unnecessary, in order to decide this case, to go further.

66. It would, in this matter, be unrealistic to avoid the consideration of the notoriety and connotation of the word MONOPOLY in the comparison of the trade marks for the purposes of section 44 and 60. The applicant's evidence tends to somewhat colorfully paint the opponent as being a huge trader that is prepared to sit on smaller traders – such factors, of course, do not have a part in the consideration of whether the trade marks in question are deceptively similar and it is perhaps inevitable that some of the trade marks of major traders have gained a notoriety which they are at pains to protect.

67. It is the applicant's thesis that the element OPOLY in the opposed trade mark indicates a genus of property games. The use of this element in the context of such goods is (or should be), the argument goes, open to all as it does not indicate the goods of any particular trader.
68. However, the evidence which goes to support this thesis relates, in the main, to the marketplace in the United States of America and in Canada. There is very limited evidence before me of three games which incorporate the suffix OPOLY other than those of the opponent available through some four specialist retailers within Australia and no evidence of whether these games have actually been sold and, if so, the level of such sales. There is, on the other hand, evidence of the opponent's substantial sales of its many different MONOPOLY trade marked games and of recognition of its trade mark in Australian dictionaries. There is also evidence of the opponent's maintenance of its monopoly in games which include the suffix OPOLY in Australia via oppositions such as the *Musicopoly* opposition, above, and its licensing of non-core OPOLY suffixed trade marks (such as SLOTOPOLY and ANTI-MONOPOLY) to third parties.
69. Such third party usage, through authorized user agreements is, of course, use by the owner of the trade marks⁶ and the argument that such trade marks have been acquired through aggressive opposition actions is of no relevance. The prior owners of these trade marks have recognized a business and marketplace verity and, subsequently, the opponent's ownership of the trade marks. The opponent has, effectively, built a family of trade marks in Australia in much the same way as the players of its games acquire groups of related properties and with similar outcomes or consequences.

⁶ See subsection 7(3) and section 8 of the Act

70. Additionally, the opponent has extensively licensed its MONOPOLY trade mark to others in cross promotions by such traders as banks, fast food restaurants and real estate agents.
71. And, of course, as discussed above, MONOPOLY is a dictionary word as connoting the game of the opponent and there are few other words which have the suffix 'OPOLY'. The words 'oligopoly' and 'duopoly' are not in common use, as is the word 'monopoly' which is familiar to most people. While the word MONOPOLY, both in its trade mark and ordinary meanings, might refer to an outcome of the game, it is one which in the context of the relevant goods and services is associated in the minds of Australians with the opponent's game and hence its trade marks.
72. The evidence of the parties thus shows that the Australian public has not been habituated to the element -OPOLY as being generic and indicating a property game. There is a 'recognition' factor at work here in that most people in Australia on first seeing the opposed trade mark will immediately perceive it as somehow referring to the opponent's game and, hence, trade mark.
73. I believe, as a consequence, that the 'suffix' OPOLY in the opposed trade mark will lead most potential purchasers in Australia to an immediate and inevitable conclusion that the opposed trade mark must have some form of connection with the opponent's MONOPOLY game and thus with the opponent.
74. As I have observed, it is probable that the opposed trade mark was coined specifically to refer to property games of the type marketed by the opponent in Australia rather than to the trade mark MONOPOLY. The problem for the applicant is that, in my estimation, in Australia the OPOLY suffix in the context of the nominated goods and services is so immediately connected with the opponent's game and its MONOPOLY

trade mark as to be likely to suggest to most people that the opposed trade mark must be connected in some way with the opponent.

75. If the species of deception or confusion here were to be categorized, it would be akin to that in *In Re John Fitton & Co Ltd's Application* (1949) 66 RPC 110 as being a contextual confusion. I have already referred to the differences between confusion and deception discussed by Richards J in *Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty. Ltd*, above.
76. The likelihood of confusion is, in my estimation, immediate and palpable.
77. I am satisfied that the opponent has established its opposition under section 44 and 60 as the opposed trade mark is deceptively similar to the opponent's trade marks.

Section 42

78. As the opponent has established its opposition under sections 44 and 60, there is no need for me to consider the opposition under this ground. However, I will observe that, as I have concluded that the trade marks would 'confuse' rather than 'deceive', the use of the opposed trade mark would, consistently with these reasons, not be contrary to the law in section 52 of the *Trade Practices Act 1972* in which the words 'likely to mislead or deceive' are used. As observed by French J., in *Woolworths*, above, 'the trade mark law concept of confusion in the sense of mere wonderment as to common origin or connection has little part to play in the consumer protection statutes'. 'Confusion', in this sense, is a concept not caught by the words 'likely to mislead or deceive'.

Conclusion

79. Section 55 of the Act provides:

55 Decision

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.

80. I refuse to register application 937827.

81. The opponent, having been successful, is entitled to its costs which I order at the official scale against the applicant.



Ian Thompson
Hearing Officer
Trade Marks Hearings
12 August 2005