

## TRADE MARKS ACT 1995

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

Re: Opposition by Television Food Network G.P. to registration of trade mark application 967804(16) – **FOOD CHANNEL and device** - filed in the name of Food Channel Network Pty Ltd.

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<b>DELEGATE:</b>	<b>Alison Windsor</b>
<b>REPRESENTATION:</b>	<b>Opponent:</b> Ian Tannahill of Ahearn Fox, Patent and Trade Mark Attorneys <b>Applicant:</b> Paul Lawrence, director of the applicant company
<b>DECISION:</b>	<b>S 52:</b> grounds of opposition under ss 59, 43 and 44 not established. Trade mark to proceed to registration

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#### Background

1. This opposition is in respect of the following trade mark application:

Trade Mark Number: 967804  
Owner: Food Channel Network Pty Ltd  
Filing date: 28 August 2003  
Acceptance advertised: 29 January 2004



Trade mark:  
Goods specification: **Class 16:** Printed matter, periodical publications, books and newspapers; paper and cardboard articles; posters, calendars; writing instruments, pencils, pens, stationery, writing pads, greeting cards; photographs

2. Notice of opposition was filed by Television Food Network G.P. (the opponent) on 29 April 2004. Evidence in support was completed and the date for serving evidence in answer was set at 11 July 2005. Paul Lawrence, on behalf of the applicant company, served and filed a letter on the due date, advising it constituted part evidence in answer. The letter was not in declaratory form. Thereafter followed correspondence between Mr Lawrence and the Office over a period of three months, but the evidence in answer was not put into declaratory form (as required by Regulation 21.17) and never appropriately served. Further official correspondence from the Office ensued,

eventually resulting in a request from the opponent for a hearing. The matter was set down for hearing in late May 2006. In late April, the opponent requested permission to serve further evidence, and because of time constraints, the hearing was postponed until the evidence matter was decided. Following some correspondence between the opponent and the office, permission to adduce this further evidence was denied.

3. The matter eventually came before me, as a delegate of the Registrar, on 11 August 2006 in Canberra. The opponent was represented by Ian Tannahill of Ahearn Fox , Patent and Trade Mark Attorneys of Brisbane who attended by telephone conference. Paul Lawrence, director of the applicant company, attended in person.

## **Evidence**

### *Evidence in support*

4. The opponent's evidence in support consists of a number of declarations made by Angeline Behan, a trade mark attorney of Ahearn Fox, Patent and Trade Mark Attorneys, the firm who represented the opponent in these proceedings. Ms Behan's declarations provide information from the opponent company attesting to its activities in its home jurisdiction, the United States of America, where it operates a television broadcaster called Food Network which began broadcasting in 1996. The broadcaster claims many millions of subscribers within its home jurisdiction.
5. The declarations also include references to the opponent's television shows being broadcast in Australia, commencing in late June 1999. Currently, various of the opponent's programs are aired in Australia on Lifestyle FOOD, a division of The Life Style Channel run by XYZ Networks Pty Ltd, the opponent's current Australian licensee. These programs are accessed via subscriptions to the network, they are not available on free-to-air television.
6. Much of the weight of the evidence is directed to a demonstration that the words "network" and "channel" are interchangeable when used in respect of television programs and broadcasting. In support of this contention, the evidence includes a statement from Richard William Allen, described by Ms Behan as a "brand design specialist" and by himself as a "corporate and brand identity consultant". Mr Allen advises that in his opinion, the words "channel" and "network" are used

interchangeably by the Australian television industry and media in general and therefore are synonymous in the context of the trade marks under consideration in this opposition.

### *Applicant's evidence*

7. The applicant did not properly serve any evidence in answer. On 11 July 2005, the Trade Marks Office received a letter from Paul Lawrence on behalf of the applicant, which he had served on the opponent and claimed as part evidence in answer. Mr Lawrence was advised that the evidence needed to be put into declaratory form, but, despite a certain amount of correspondence between the Office and the applicant on the matter, this was not done. The letter does not include any supportive information concerning the applicant's business and its trade mark use. However, it does point out that the application is for printed material and other class 16 goods, while the opponent in general has applied for goods and services in classes 9, 38, 41 and 42. Attached to the letter in support of this reminder was an example of a newsletter dated May 2, 2005 which shows the applicant's trade mark, in a slightly amended form, at the bottom of each page.

### **Discussion**

8. The Notice of Opposition canvassed all possible grounds. However, submissions at the hearing dealt only with grounds under sections 43, 44 and 59 of the Act. The onus is on the opponent to make out at least one of these three ground of opposition if it is to be successful in these proceedings. As none of the other grounds on the notice were addressed, for completeness I note they have not been established.

### *Section 59 – applicant not intending to use trade mark*

9. The opponent's submissions in respect of section 59 are based on the premise that the applicant's actions (or lack thereof) in a number of instances clearly indicated there was no longer any intention to use the trade mark. These instances were, they said, the following:
  - the applicant's failure to properly serve its evidence in answer;
  - its failure to request a hearing following refusal of an application for an extension of time to serve this evidence;

- its filing of a similar but not identical application for a new trade mark for similar goods in October 2005<sup>1</sup>; and
- its failure to appoint a particular group of attorneys to act on its behalf in this action, despite the firm being engaged to do other work for the applicant company in respect of others of its trade marks.

10. The opponent submitted that all these actions should lead me to an inference that the applicant had no intention to use, or authorize use of, its trade mark on the claimed goods in Australia.

11. This information does not necessarily lead me to infer a lack of intention to use the trade mark, but it does explain to me the reasoning behind the submissions the applicant provided for the hearing. Just prior to the hearing Mr Lawrence sent several pages of submissions, which he reiterated at the hearing. His submissions related to the fact that the trade mark filed in respect of this application was a cut and paste montage, made up from parts of other material already in use, that it had been “tidied up” and was now used in a more professional-looking style. The original and amended versions of the trade mark Mr Lawrence referred to are shown here:



Original (967804)



Amended version

Mr Lawrence seemed concerned that an attack was being made on his right to amend the trade mark, despite not ever having requested of the Trade Marks Office that this be done. He concentrated on this aspect, rather than dealing with the more appropriate issues of use of the trade mark in relation to the claimed goods.

12. The opponent’s arguments here seem to me to be exaggerating the significance of the applicant’s actions. There are likely to be many reasons for an applicant neglecting to file evidence in answer. The failure may point to a lack of intention to use the trade mark but could as easily point to a misunderstanding of the requirements for filing evidence, or disorganization within the applicant company. There is no requirement for an applicant to ask to be heard when an extension of time request is denied, and

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<sup>1</sup> Application 1079247 for the following trade mark:



the applicant's non-action in this regard is a matter of choice. Similarly, appointing an agent to manage an opposition is a matter of choice, and I do not see anything suggestive of abandonment in the applicant not choosing to do so in this case. Filing additional applications is another choice, and need not point to a decision to cease using an earlier trade mark. Mr Lawrence, in failing to make his comments about his firm's intentions in declaratory form, cannot expect me to give them any great weight, but the information provided would be consistent with a credible and properly motivated (if utterly unsubstantiated) intention to use a trade mark which, under the provisions of Section 7 of the Act, could be considered use of the trade mark as applied for.

13. The opponent has provided nothing sufficient to satisfy me that it is appropriate to draw an inference that the applicant does not intend to use its trade mark. The fact that Mr Lawrence was prepared to attend a hearing to attempt to support his company's application would tend, to some degree, to counter such an inference. This ground of opposition is not established.

***Section 43 – Trade mark likely to deceive or cause confusion***

14. The opponent submitted that both the words CHANNEL and NETWORK connote an association with television, and therefore people are likely to confuse the goods provided under the applicant's trade mark with the services provided by the opponent under its trade marks. Specifically, having provided definitions of the two words from the *Macquarie Dictionary*<sup>2</sup>, the opponent submitted the word NETWORK could be considered the plural of CHANNEL, and therefore use of the word CHANNEL carries with it the same connotation as that of the word NETWORK. This contention was supported, they said, by the expert opinion of Richard William Allen, mentioned earlier in paragraph 6. Therefore, they submitted, the connotation carried by both "channel" and "network" and the perceived interchangeability of the words would lead people to believe that the goods bearing the applicant's trade mark would have "some sponsorship approval or connection with the opponent that does not exist"<sup>3</sup>.

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<sup>2</sup> **Channel:** a television station (usually specified by a number)

**Network:** a group of affiliated radio or television stations sometimes commonly owned, and from which at times the same program may be broadcast.

<sup>3</sup> *Amalgamated Television Services Pty Ltd v Linda Cameron Pickard, Alexandra Cameron Pickard and Linda Louise Pickard* [1999] ATMO 103 (*Summer Bay*)

15. The opposition in the SUMMER BAY case<sup>4</sup> succeeded because the opponent was able to demonstrate such a reputation in its television program, “Home and Away”, that the fictitious geographical setting of Summer Bay, when used as a trade mark on clothing, carried a strong connotation of the program. There was a similar result for the same kind of reason in the BRAVEHEART decision<sup>5</sup>, where the delegate found the movie so well known and publicized, that the relevant word carried the connotation of the movie, and use by another party would cause confusion and deception.
16. SUMMER BAY and BRAVEHEART both turned on evidence that a particular perception or connotation existed in the minds of the general public. I am not satisfied a similar situation applies here. The evidence the opponent has provided certainly points to various programs originating in its home jurisdiction being available for viewing on pay TV in Australia. But there is simply no indication of when or how often these shows appear and no indication of how familiar the viewing public is with the opponent’s organization. There is no indication of the proportion of the Australian population who have access to these programs nor is there any other information which might clearly point to the opponent being a well known presence in the Australian television industry. Without this kind of reputation, there is no reason to presume the words FOOD NETWORK have the connotation the opponent relies upon. It is yet another step to say that the applicant’s trade mark carries a connotation because of the extent to which it resembles the opponent’s trade mark such that deception and confusion would occur. The ground of opposition under section 43 has not been established.

#### ***Section 44 – conflicting trade marks***

17. The final ground the opponent relied upon at the hearing was that of section 44. If a ground of opposition is to succeed under this section, the trade marks being compared must meet all of the following conditions:
- they must be substantially identical or deceptively similar
  - they must be in respect of similar goods or closely related services
  - the conflicting trade marks must have an earlier priority date than that of the applicant’s trade mark

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<sup>4</sup> Ibid.

<sup>5</sup> *Twentieth Century Fox Film Corporation v Michael F Durkan* [2000] ATMO 5

18. I note here that the opponent claims the applicant's trade mark conflicts with three of its own trade marks, all four marks being shown below:

<b>Applicant's trade mark</b>	<b>967804</b>	
<b>Opponent's trade marks</b>	<b>881666</b>	TELEVISION FOOD NETWORK
	<b>881667</b>	
	<b>938228</b>	

All three of the opponent's trade marks have earlier priority dates than that of the applicant. As the service specifications for these trade marks are quite lengthy, I have set out their full details as an appendix to this decision. Without going into any great detail, the opponent's services mainly cover a broad range of telecommunications services in class 38, a broad range of education and entertainment services in class 41 as well as various news and television services in that class. Trade marks 881666 and 881667 also include certain goods classified in class 9, being mainly pre-recorded cassettes, tapes and discs. The applicant claims a range of goods in class 16, set out previously in paragraph 1.

19. When comparing trade marks for the purposes of section 44, there are "rules of comparison" which are generally accepted as appropriate. Some of these were listed by Parker J in *Pianotist Co's Appn*<sup>6</sup> as follows:

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.

20. Further guidance has more recently been provided by French J who, in the *Woolworths*<sup>7</sup> case, restated propositions set out by Kitto J in *Southern Cross*:<sup>8</sup>

<sup>6</sup> (1906) 23 RPC 774 at 777

<sup>7</sup> *Registrar of Trade Marks v Woolworths Limited* 45 IPR 411

- 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 of 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 of 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 marks. 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 the registration is obtained.

In respect of the last proposition, Mason J observed in *Berlei Hestia Industries Ltd v Bali Co Inc*<sup>9</sup>:

The question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark. The issue is whether that use would give rise to a real danger of confusion.

21. As mentioned previously, the opponent submitted that the word NETWORK is understood by the relevant public as being the plural of CHANNEL, and therefore FOOD CHANNEL and FOOD NETWORK will not be distinguished in the marketplace. The opponent considered the applicant's and their own trade marks engendered the same idea, being the idea of television programs which have food as

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<sup>8</sup> *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-595

<sup>9</sup> (1973) 129 CLR 353 at 362

their central subject. They submitted that the applicant's goods were closely related goods to the opponent's range of services, referring to comments in respect of television programs and related merchandising, made in respect of the ground under section 43.

22. Of course, the fact that trade marks convey the same idea is not conclusive as to the deceptive similarity of the trade marks: "*Frigiking*" Trade Mark [1973] RPC 739; and see *Cooper Engineering Company Pty Ltd, v Sigmund Pumps Limited* (1952) 86 CLR 536 (RAIN KING/RAINMASTER). And, the fact shared elements of the trade marks under comparison are common to the trade or lack capacity in themselves to distinguish ought also to be taken into account within the comparison: *Coca Cola Co of Canada v Pepsi Cola Co of Canada* (1940) 59 RPC 127 becomes relevant.<sup>10</sup> It is difficult to establish deceptive similarity based on indicia which lack inherent distinctiveness and are innocently required by other traders to describe the origin or characteristics of the relevant goods or services.
23. I am aware that there are various entities in the television industry within Australia who use a naming convention for both the overall television network (*Seven Network* or *Network 7*) and individual channels within that network (*Channel 7*). However, I am satisfied from my own knowledge of the Australian television market that the public understanding of the relationship between the names is as a result of exposure over time to the naming convention, rather than the result of an inherent equivalence in terminology. It is my understanding that most television networks in the Australian market involve several related channels – separate broadcasting stations operating under the umbrella of the parent organization, designed to broadcast a certain range of programs over a broad geographical area. If the public had been educated, as is the case with the *Network 7* example referred to earlier, there might be an expectation of a relationship. But at this stage, and failing this kind of an educative process, I am not satisfied the terms are the same. I do not consider the trade marks, when viewed as wholes (as is the requirement), are deceptively similar.

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<sup>10</sup> See also *Conde Nast Publications Pty Ltd v Virginia Taylor* [1998] 864 FCA (VOGUE/EUROVOGUE) and *Sports Cafe Ltd v Registrar of Trade Marks* [1998] 1614 FCA (SPORTS CAFÉ & DEVICE/THE CIRCUIT SPORTS CAFÉ)

24. I am satisfied the market for “printed matter, periodical publications, books and newspapers; paper and cardboard articles; posters, calendars; writing instruments, pencils, pens, stationery, writing pads, greeting cards; photographs”, the goods the applicant is claiming, is separate from that of the television broadcasting and television entertainment markets. Any connection between these markets is, to my mind, only perceived as a result of a reputation developed by entities in the industries, and reputation is not a consideration here.
25. There is, however, another matter in respect of the service claims that needs mentioning. Buried within the opponent’s lengthy service claims in class 41 (for registrations 881666 and 881667) is the item “publication of printed publications”. In *Caterpillar Loader Hire (Holdings) v Caterpillar Tractor Co<sup>11</sup>*, Lockart J (quoted and discussed by Justice French in *Woolworths*) considered that service marks potentially gave rise to problems of confusion with goods marks and other service marks “of greater difficulty and subtlety than has previously been experienced in the case of goods marks alone.” His Honour observed that:
- Confusion is more likely to arise where services protected by service marks necessarily involve the use or sale of goods or where services (for example, consultancy services) involve goods but can be provided either with or without the sale or promotion of goods.
26. Publication services are, in line with Lockhart J’s comments above, closely related to the results of those services – printed publications, be they books, leaflets, newspapers or newsletters. While the opponent has not provided evidence to support use of its trade marks on the broad range of services it claims, it is inherent in an application for registration that the owner intends to use the trade mark in respect of that range of services. The presence of these services within the specification is sufficient to trigger that particular provision of section 44 which deals with the goods and services. I am satisfied that some of the opponent’s claimed services, namely the “publication of printed publications” are closely related to some of the applicant’s goods – “printed publications, periodical publications, books and newspapers”.
27. That said, I am satisfied the trade marks are not deceptively similar, even for these particular goods and services. If the opponent was to use its FOOD NETWORK trade mark in respect of publishing services, as it is entitled to do, I am not satisfied the

applicant's FOOD CHANNEL trade mark appearing on published material would result in a real tangible danger of confusion amongst a significant number of people purchasing those items. Once outside the realm of television broadcasting and television entertainment, the terms "channel" and "network" lose much of their common significance, and any perceived connection is much reduced. I am satisfied the trade marks under consideration do not meet the requirements of section 44, and therefore the opponent has not established that ground of opposition.

### **Decision**

28. The opponent has not met the onus upon it to establish any of the grounds of opposition pursued at the hearing. The opposition therefore fails. The application may proceed to registration one month from the date of this decision. 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 discontinued or registration is otherwise ordered by the court.

Alison Windsor  
Hearings Officer  
Trade Marks Hearings  
IP Australia

29 November 2006


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<sup>11</sup> (1983) 48 ALR 511

## Appendix:

### Opponent's conflicting trade marks

Trademark number	Trade mark	Goods/services
<p>881666</p> <p><b>Status:</b> Accepted – provisions of 41(5) applied</p> <p>(Now opposed.)</p>	<p>TELEVISION FOOD NETWORK</p> <p><b>Priority date:</b> 9 April 1999 (divisional of lapsed application 790732)</p>	<p><b>Class 9:</b> Pre-recorded video cassettes, video discs, laser discs, pre-recorded audio tape, discs, CD-ROMS, cassettes and records, digital analogue and micro-chipped based storage and/or retrieval devices</p> <p><b>Class 38:</b> Telecommunications services; communication services; broadcasting services; television broadcasting services; wireless transmission and broadcasting of television programs; cable, satellite and direct to home transmission and distribution of television programs including programs relating to food or cooking; on-line transmission and distribution through computer networks and video servers of television programs; news distribution and news agency services; gathering and dissemination of news; teletext services; consultancy, information and advisory services relating to telecommunications</p> <p><b>Class 41:</b> Education and entertainment services in the television and broadcasting industry including such services relating to food or cooking; television programming and production services; news program services; television news and information shows; production and syndication of television and video programs; production, recording, syndication, distribution and presentation of cine-films, video and television programs; news programs, interactive video entertainment; syndication of news; publication of printed publications; consultancy, information and advisory services relating to the foregoing services; information services in this class concerning education and entertainment, particularly in relation to food or cooking; arranging and conducting food festivals, and cooking and cooking products demonstrations in connection therewith, but not including any services in this class relating to the sport of polo</p>
<p>881667</p> <p><b>Status:</b> Accepted – provisions of 41(5) applied</p> <p>(Now opposed.)</p>	 <p><b>Priority date:</b> 9 April 1999 (divisional of lapsed application 790731)</p>	<p><b>Class 9:</b> Pre-recorded video cassettes, video discs, laser discs, pre-recorded audio tapes, discs, CD-ROMS, cassettes and records, digital, analogue and micro-chipped storage and/or retrieval devices</p> <p><b>Class 38:</b> Telecommunications services; communication services; broadcasting services; television broadcasting services; wireless transmission and broadcasting of television programs; cable, satellite and direct to home transmission and distribution of television programs including programs relating to food or cooking; on-line transmission and distribution through computer networks and video servers of television programs; news distribution and news agency services; gathering and dissemination of news; teletext services; consultancy, information and advisory services relating to telecommunications</p> <p><b>Class 41:</b> Education and entertainment services in the television and broadcasting industry including such services relating to food or cooking; television programming and production services; news program services; television news and information shows; production and syndication of</p>

		<p>television and video programs; production, recording, syndication, distribution and presentation of cine-films, video and television programs; news programs, interactive video entertainment; syndication of news; publication of printed publications; consultancy, information and advisory services relating to the foregoing services; information services in this class concerning education and entertainment, particularly in relation to food or cooking; arranging and conducting food festivals, and cooking and cooking products demonstrations in connection therewith</p> <p><b>Class 42:</b> Providing technical information and assistance about electronic commerce; information services relating to food and cooking; database services; technical services, and research and development services in relation to the television industry;</p>
<p>938228</p> <p><b>Status:</b> Accepted – provisions of 41(5) applied</p> <p>(Now opposed.)</p>	 <p><b>Priority date:</b> 18 December 2002</p>	<p><b>Class 41:</b> Entertainment services namely production and distribution of television programming; and all other entertainment services included in this class</p>