

## TRADE MARKS ACT 1995

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

Re: Opposition by Griffin Pastoral Company Pty Ltd to registration of trade mark application 971580(33) FROG ISLAND proceeding in the name of Ralph Fowler Wines Pty Ltd.

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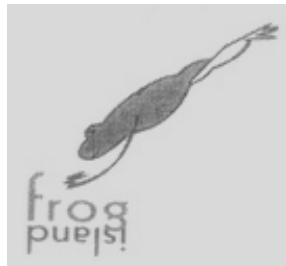
<b>DELEGATE:</b>	<b>Ian Thompson</b>
<b>REPRESENTATION:</b>	<b>Applicant</b> Richard Catt of Madderns. <b>Opponent</b> Dr David Woods of Griffin Pastoral Company Pty Ltd.
<b>DECISION:</b>	1. Section 43 – deceptive connotation within opposed trade mark – registration refused – costs ordered against applicant.

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### Background

1. Ralph Fowler Wines Pty Ltd ('the applicant') of Mount Benson, South Australia, has filed application to register a trade mark, current details of which are:

App No: 971580  
Filing Date: 24 September 2003  
Acceptance Date: 19 February 2004  
Goods: **Class: 33** Wines  
Trade Mark:



2. On 24 February 2004 Griffin Pastoral Company Pty  
Ltd of Liberman Close, Adelaide ('the opponent'), filed Notice of Opposition ('the Notice') to the registration of the trade mark. The Notice includes grounds under

sections 41, 43, 60, and 61 of the *Trade Marks Act 1995* ('the Act') which were pursued at hearing.

3. Evidence in support was served and filed – as was evidence in answer and evidence in reply.
4. A hearing was held before me, as a delegate of the Registrar of Trade Marks, in Adelaide, on 15 August 2005. Dr David Woods, of the Griffin Pastoral Company Pty Ltd represented the opponent. Richard Catt of Madderns represented the applicant.

### **Evidence**

5. The major declarations are by:

Dr Woods, director of the opponent, in support and by Sarah Fowler, director of the applicant, in answer. There is a declaration by Margaret Woods, who is a director of the opponent, in reply.

6. There are also a number of other supporting declarations from both parties which I will refer to if necessary in my discussion of the issues.
7. I think that it is fair to summarize the opponent's evidence and arguments as being that the term 'Frog Island' refers uniquely to both its property name and a geographical feature on that property which is named for the frogs that breed there.
8. Sarah Fowler, of the applicant company, saw the name 'Frog Island' when driving past either the opponent's property, or a road called Frog Island Road which is named for the property and leads to it, and thought that the name would be a good one for a wine that her company planned to put onto the market.
9. The applicant's property is some 35 kilometres distance from the Frog Island geographical feature and property.
10. The opponent already produces wine under the trade mark KARATTA and states that it has plans to produce wines at its 'Frog Island' property and that time and

resources have been expended investigating white wine varieties suitable for its 'Frog Island' property. Dr Woods in his declaration states that the first production of wines at the 'Frog Island' property could be during 2005.

11. The 'Frog Island' property name appears prominently on the opponent's invoices, stationery and farm gate and Dr Woods avers that it is the opponent's intention to use it in relation to both its wine label and cellar door sales.
12. The applicant produces wines in the Mount Benson wine sub-region; the opponent produces its KARATTA wines in the Robe wine sub-region. These areas are adjacent sub-regions in the Limestone Coast geographical region.

### **Observations**

13. Having considered the evidence and submissions of the parties, I think that it is obvious that the ground under section 43 of the Act should succeed and, for brevity's sake, I will decide this matter only under that ground – however, I consider that it is unlikely that the other grounds pursued would have been established but that grounds under section 42 might have succeeded if they had been pursued.

### **Section 43 – Discussion**

14. 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.

15. It is the opponent's contention that the sign, FROG ISLAND, contained in the opposed trade mark, connotes its 'Frog Island' property and, that as they already produce wine elsewhere and plan to do so on the 'Frog Island' property, the use of the opposed trade mark by the applicant would be likely to confuse or deceive as it

indicates a wine from a place, 'Frog Island', that is uniquely identified with the opponent.

16. The applicant submits that the majority of the general public are unlikely to have heard of the opponent's property, that the opponent's evidence of knowledge of 'Frog Island' is restricted to people who know the opponent or its directors and that the property 'Frog Island' has not been advertised or promoted to the public at large in relation to wines or otherwise.

17. In *Big Country Developments Pty Ltd v TGI Friday's Inc*, [2000] FCA 720, 48 IPR 513 at 521, it was observed that:

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.

18. I do not consider that the words FROG ISLAND in the opposed trade mark could connote anything else but the farming property of the opponent and/or the geographical feature on it. It is, I consider, a fallacy to hold that words only hold a particular meaning if that meaning is known to Australians at large. By analogy with the proceedings in *Eutectic Corporation v Registrar of Trade Marks* (1980) 1A IPR 550, it was there shown by the 'appellant' that the relevant trade and (presumably) the public at large were unaware of the technical meaning of the word EUTECTIC in relation to welding rods.<sup>1</sup> However, this fact did not detract from the technical meaning of the word and its forensic relevance to the Act.

19. Here the situation is somewhat similar; the opponent has adduced evidence that the term FROG ISLAND refers uniquely to its farming property and a geographical

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<sup>1</sup> See also *Powell v Glow Zone Products Pty Ltd* (1997) 39 IPR 506

feature on it – it is reflected on maps, invoices, stationery and a photograph of a farm gate in evidence. The words do not appear to refer to anything else. For instance, a search for the words FROG ISLAND on the website [www.placenames.sa.gov.au](http://www.placenames.sa.gov.au)<sup>2</sup> leads only to the opponent's property or a feature on it. The applicant has not suggested in evidence that the words indicate anything else but the opponent's property, a geographical feature on it or a road leading to it.

20. The applicant produces its wines some 35 kilometers from this property.
21. The words 'Frog Island' have the flavour of being a geographical location – it is a term which would lead ordinary people to believe that the words used within the opposed trade mark refer to an actual place where the grapes might be grown or the wine produced. The words are not, for example, of the same ilk as are the words POOH CORNER, or HILL OF BEANS, or NORTH POLE.
22. The words FROG ISLAND within the opposed trade mark are, in short, ones which would readily suggest to people that the wines are produced at a property called 'Frog Island' – this property is, in fact, uniquely associated with the opponent who produces wines.
23. The use of the words FROG ISLAND by the applicant is, hence, obviously a misstatement as to the source of the goods – thus, the use of the opposed trade mark by the applicant is likely to deceive or cause confusion.
24. The opposed trade mark therefore contains a connotation which is likely to mislead or deceive.
25. The opponent has established its grounds under section 43 of the Act.

### **Decision**

26. Section 55 of the Act provides:

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<sup>2</sup> This is a searchable and comprehensive listing of place names in South Australia

55. 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.

27. I refuse to register application 971580.

### **Costs**

28. Should the opponent have incurred recoverable expenditure in relation to this matter,

I order costs, as per the schedule to the regulations, against the applicant.

Ian Thompson  
Hearing Officer  
Trade Marks Hearings

24 November 2005