

TRADE MARKS ACT 1995



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

Re: Opposition by Law of the Jungle Pty Ltd to registration of trade mark applications 972972, 972974 & 1005201(35,42) - **JUNGLE, JUNGLE MANAGEMENT, JUNGLE MANAGEMENT & DEVICE** - filed in the name of Jungle Management Pty Ltd.

DELEGATE:	Deirdre O'Brien
REPRESENTATION:	Opponent Ian Wylie of counsel instructed by Surry Partners, Lawyers
	Applicant Ms Julia Baird of counsel
DECISION:	Section 52 opposition Section 42(b), 43, 44 and 60 grounds not made out. Registration may proceed. Costs awarded against opponent.

Background

1. Jungle Management Pty Ltd. ('the applicant') applied for registration of the following trade marks in classes 35 and 42.

Application	Trade Mark	Priority date
972972		3 October 2003
972974	JUNGLE MANAGEMENT	3 October 2003
1005201		4 June 2004

2. Registration is opposed by Law of the Jungle Pty Ltd ('the opponent'). After the parties had filed and served evidence the matter was heard by me in Sydney on 15 March 2006. The opponent was represented by Mr Ian Wylie of counsel, instructed by Surry Partners, Lawyers. The applicant was represented by Ms Julia Baird of counsel.

3. The evidence filed and served by the parties is as follows:

DECLARANT	MADE	EXHIBITS	KNOWN AS
Evidence in support Gregory San Miguel	29.03.2005	A to H, J to T	San Miguel
Evidence in answer Kim Tunbridge	28.06.2005	A to BB, BD to CW	Tunbridge
Evidence in reply Peter English	31.10.2005	A	English*
Trevor Barkway	31.10.2005		Barkway
Benjamin Evans	31.10.2005		Evans
Anne Robinson	31.10.2005		Robinson

*The English declaration is a means of bringing into evidence the Barkway, Evans and Robinson declarations.

Grounds of opposition

4. In its Notice of Opposition the opponent nominated all of the allowable grounds in the Trade Marks Act 1995, however the only grounds it pressed at the hearing were those pursuant to sections 42(b), 43, 44 and 60. In order for registration to be refused the onus is on the opponent to make out at least one of those grounds.

Section 44 and 60 grounds

5. In support of these grounds the opponent cited its registration 803589 which is for the trade mark LAW OF THE JUNGLE and has a priority date of 13 August 1999. It covers goods and services in classes 9, 16, 35, 41 and 42. The class 35 and 42 services are as follows:

Class: 35 Business management; business administration; business consulting services

Class: 42 Internet services in this class being internet application software design, programming, updating and consultancy including development and implementation of internet delivered quality assurance applications; operation of computerised chat rooms, on-line notice boards and search facilities; providing access to on-line applications; leasing access time to an on-line computer database; legal services in this class

6. The present applications are for services in classes 35 and 42. I will not list the services here as the applicant concedes some of its class 35 and 42 services overlap with the opponent's business services in class 35 and legal services in class 42. For

the purposes of paragraph(2)(ii) of section 44, I am satisfied the present applications and registration 803589 are for the same or similar services. Furthermore registration 803589 has an earlier priority date as required by paragraph 44(2)(b). The section 44 ground will therefore succeed if I am satisfied the present trade marks are at least deceptively similar with the trade mark of registration 803589 as required by paragraph 44(2)(a).¹

7. Mr San Miguel of the opponent has explained the care with which he chose the opponent's trade mark in registration 803589 and he believes it is a highly distinctive one. I agree with him. It is my experience that trade marks for legal services generally comprise the name of the legal firm or allude in some way to the nature of the legal services being provided. The opponent's LAW OF THE JUNGLE is an unusual and striking way of branding legal services. However registration of LAW OF THE JUNGLE does not give the opponent rights in the word JUNGLE per se. To succeed with the section 44 ground the opponent needs to show the present trade marks are deceptively similar to registered trade mark 803589.
8. The opponent is also relying on section 60. The threshold test for section 60 is that the present trade marks be deceptively similar to one or more of the trade marks cited by the opponent. The section 44 and 60 grounds thus turn on the issue of deceptive similarity.
9. Under section 60 the opponent's common law trade marks, if any, can be taken into account as well as registered trade mark 803589. The latter is the expression LAW OF THE JUNGLE in ordinary typeface. The opponent's evidence shows it also uses that expression in the following manner on stationery such as letterhead and business cards and as headings at the opponent's web site.



10. There is, however, one instance in evidence of the expression represented vertically as below:

¹ The present trade marks are clearly not substantially identical with the trade mark of registration 803589.



11. This use on what appears to be a placard is not explained by the opponent. There is nothing else in evidence to show the opponent's trade mark is regularly used in this manner or that it would form part of any impression created by the opponent's trade mark in the ordinary course of business. Thus, for the purposes of section 60 I only intend to take into account the trade mark in registration 803589 and the substantially identical trade mark used on the opponent's stationery.

Trade mark applications 972974 and 1005201

12. Applying the accepted tests for deceptive similarity² I find the trade marks in applications 972974 (JUNGLE MANAGEMENT) and 1005201 (JUNGLE MANAGEMENT device) are not deceptively similar to either of the opponent's trade marks. It is true all the trade marks have the word JUNGLE in common. The opponent argues the word MANAGEMENT in the applicant's trade marks merely describes the applicant's services and should be disregarded when evaluating the impression each trade mark is likely to create in the mind of a potential customer. However the law requires an assessment of the impressions created by the trade marks as wholes.³
13. The applicant's and opponent's trade marks are similar in that they conjure up images of a jungle, but they are not deceptively similar. The opponent's LAW OF THE JUNGLE is a well known expression, similar to 'dog eat dog' and 'everyone for himself'. It creates an impression of 'only the strong will survive'.⁴ JUNGLE

² *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407; *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641

³ *Clark v Sharp* (1898) 15 RPC 141 at 146

⁴ Exhibit L to San Miguel is an article from the Australian Financial Review. The author says, inter alia: 'The supplier calls itself Law of the Jungle, as a statement of empathy with business clients, who

MANAGEMENT, on the other hand, gives rise to an impression of ‘taming the jungle’, of making your way successfully through difficult territory. While the trade marks are superficially similar, they give rise to different impressions. I am not satisfied the trade marks in applications 972974 and 1005201 are deceptively similar to the opponent’s trade marks.

Trade mark application 972972

14. The trade mark in application 972972 is the word JUNGLE depicted as follows:

Jungle

JUNGLE describes a place, whether physical, as in a rainforest, or metaphorical. As previously noted LAW OF THE JUNGLE is another way of expressing the principle that ‘only the strong will survive’. Given these differences in meaning and in the way the trade marks are depicted I am not satisfied they are deceptively similar.

15. The opponent points to the issue of aural similarity. It says much of its trade mark use is aural with potential customers being contacted by phone.⁵ It says its principal, Mr San Miguel, was referred to in a newspaper caption as the “jungle lawyer”.⁶
16. The opponent has not said that it introduces itself in telephone conversations with potential customers in any way other than with the full expression LAW OF THE JUNGLE. LAW OF THE JUNGLE and JUNGLE do not sound the same. It is possible that some, on hearing LAW OF THE JUNGLE, will only remember the word JUNGLE but I do not think their number would be substantial. LAW OF THE JUNGLE has a well known meaning. Regardless of whether it is used aurally or visually, any impression formed of it must have some reference to that meaning. Given these differences in sound and meaning I am not satisfied JUNGLE and LAW OF THE JUNGLE are deceptively similar even if their only use is aural.

sometimes characterise trade practices law, product liability, occupational health and safety, fair trading, privacy and other compliance tasks as a battle for survival.’

⁵ Although I note from the opponent’s evidence that the first contact is generally by letter which is followed up by a telephone call.

⁶ H to San Miguel

17. The opponent says confusion is already occurring.⁷ Deceptive similarity requires an assessment of the effect of the notional fair use of the trade marks.⁸ It seems to me most of the instances of confusion reported by the opponent are due to the combination of the alleged similarities in the colour of the parties' promotional material and in the common use of the word JUNGLE rather than a result of the trade marks per se being deceptively similar.⁹ There are two cases, however, where the use of similar colours seems to have played no role.¹⁰
18. In the first case the declarant, Mr Barkway, received a telephone call from a representative of the opponent who identified herself as coming from LAW OF THE JUNGLE.¹¹ Mr Barkway confused the caller with the applicant on the basis of a meeting he had had with the applicant earlier that year. He did not mistake LAW OF THE JUNGLE for JUNGLE MANAGEMENT but thought they denoted the same company.
19. Mr Barkway's declaration may have had more weight if he had given some details about his meeting with the applicant. Was it a face to face meeting between him and one of the applicant's representatives for the purpose of soliciting his, Mr Barkway's, business? Or was it a meeting held for another purpose entirely at which the applicant and Mr Barkway were merely attendees? At such meetings the attendees may identify him or herself as representing a certain firm but it is unlikely other attendees will take particular note of the name of the firm unless they want to contact that person later on.
20. A finding of deceptive similarity requires me to be satisfied there is a real, tangible danger of a substantial number of persons being confused and/or deceived. The persons to be considered are potential customers for the services offered by the applicant and/or opponent and who will have more than just a vague awareness of at least one party's trade mark. The services in question are not the equivalent of the proverbial 'bag of sweets' and the potential customer is likely to take some care in selecting a service provider. Although Mr Barkway can be considered a potential

⁷ Paragraphs 67, 73, 79, 80, 83 and 84 of San Miguel; Barkway, Evans and Robinson declarations

⁸ *Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353 at 362

⁹ For example Mr San Miguel reports at paragraph 73 a call from client who had received a brochure in the mail from the applicant 'with your [the opponent's] name and in your [the opponent's] colours'.

¹⁰ Barkway and Evans declarations

¹¹ Mr Barkway says he did not receive the letter the opponent sends prior to making such telephone contact.

customer, the lack of information about the nature and extent of his contact with the applicant means I give little weight to this instance of confusion.

21. In the Evans declaration there is no mention of colours. Mr Evans is not a potential customer but an executive recruiter who has had dealings with the opponent. He noted an advertisement for staff placed by an employment agency on behalf of Jungle Management Pty Ltd.¹² Mr Evans believed the advertisement was placed on behalf of the opponent. In other words Mr Evans was not a potential customer who had formed an impression of a trade mark. His misreading of another party's advertisement does not go to establishing there is a real tangible danger of confusion based on trade mark use.
22. For these reasons I am not satisfied any of the present trade marks are deceptively similar to either of the opponent's trade marks and accordingly the section 44 and 60 grounds are not made out.

Section 42(b) ground

23. The opponent contends use of the present trade marks would be contrary to section 52 of the *Trade Practices Act 1974*. Section 52 prohibits misleading or deceptive conduct by a corporation and allows 'a trader having a distinctive reputation in a name [to] enjoin another from engaging in misleading and deceptive conduct by the use of that name'.¹³
24. In the present case the opponent is relying on a name that is, of itself, distinctive and is using it in relation to the provision of compliance solutions for large companies. The evidence required to establish that a distinctive name has a reputation is much less than that required for a more 'descriptive' name¹⁴. I am satisfied from the evidence that the opponent's name has a reputation in the provision of compliance solutions. The opponent alleges that the applicant, by using as a trade mark the word that the opponent considers to be the essential feature of its name and by using similar

¹² A to Evans

¹³ *Equity Access Pty Ltd v Westpac Banking Corporation* (1989) 16 IPR 431 at 439

¹⁴ Supra note 14 at 448

colours for its advertising material, has engaged in misleading and deceptive conduct. In support it points to instances of actual confusion in the marketplace.¹⁵

25. The first question is whether all those instances of confusion were truly 'in the marketplace'. For the most part they seem to be instances of friends and/or acquaintances of Mr San Miguel warning him about another trader whom they perceived to be moving into Mr San Miguel's 'turf'.¹⁶ Mr San Miguel appears to be very well known within the Sydney legal community, having been a partner in several prominent legal firms. With respect to Mr Barkway, who definitely does fall into the 'potential customer' category, it is too much to say that he was misled or deceived but he was certainly 'caused to wonder' whether the opponent and the applicant were from the same business. However, as already noted, Mr Barkway's lack of detail lessens the weight to be placed on his declaration.
26. The opponent has emphasised the applicant's use of what it says are its, the opponent's, colours. Closer scrutiny shows that the promotional material used by the applicant in 2003 and 2004 can easily be distinguished from that of the opponent. The opponent says its advertising is targeted to a specific market and when it identifies a potential customer, it sends an initial contact letter which it follows up with a telephone call. There is no such letter in evidence but there is a coloured folder.¹⁷ Although the opponent has not said so, I assume the initial letter would be accompanied by that folder containing information about the opponent as well as the opponent's business card.
27. The outside cover of the folder is black with the words LAW OF THE JUNGLE in white. The inside cover is unadorned lime green. The business card is as follows and shows a restrained use of colour in the form of lime green footprints.



¹⁵ Supra note 8

¹⁶ There are two exceptions to this. Paragraph 73 of San Miguel reports a call from a client and, as already discussed, the Barkway declaration is from a potential customer.

¹⁷ O to San Miguel

28. Use of colour at the opponent's home page is similarly restrained with a lime green banner at the top of the page.¹⁸ The text in the banner changes until it finally stops with the words WELCOME TO LAW OF THE JUNGLE accompanied by three black footprints. Other than the footprints, there are no graphics which immediately stand out.
29. The applicant's advertising material of which the opponent and its supporting declarants speak is depicted below.¹⁹



30. I find it to be easily distinguishable from the opponent's material. Firstly the applicant uses not one but many different shades of green. Secondly there is a plethora of graphics giving the whole a somewhat 'hectic' appearance. To put it in other terms, the opponent's promotional material gives an impression of sobriety and solidity whereas the applicant's material has an energetic and somewhat chaotic appearance.
31. Taking all this into account I am not satisfied that the applicant's conduct in using various shades of green in its advertising material and adopting a trade mark that has a word in common with that of the opponent is misleading or deceptive. Accordingly I find that the section 42(b) ground has not been made out.

Section 43 ground

32. In *Big Country Developments Pty Ltd v TGI Friday's Inc*²⁰ the court found that the connotation referred to in section 43 must be something inherent to the trade mark in

¹⁸ The web site is in evidence at E to San Miguel but only in black and white. I therefore informed myself about the colours used as allowed by reg 21.15(8) and visited the opponent's current web site www.lawofthejungle.com.au.

¹⁹ Q to San Miguel

²⁰ (2000) 48 IPR 513 at 521

question. It cannot be based on the trade mark's similarity to another trade mark however famous that other trade mark may be. The opponent has provided evidence as to the reputation of its trade mark but has failed to demonstrate that the applicant's trade marks, or a sign contained within those trade marks, connotes the opponent or has any other connotation which would be likely to deceive or cause confusion. I find the section 43 ground has not been made out.

Decision

33. As none of the grounds of opposition has been made out, my decision is that trade mark applications 972972, 972974 and 1005201 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 decided or discontinued.

Costs

34. I award costs against the opponent according to the official scale.

Deirdre O'Brien
Trade Marks Hearings
30 June 2006