

Phillips Ormonde & Fitzpatrick  
367 Collins Street  
Melbourne VIC 3000

Re: Opposition by Calvin Klein Trademark Trust C/- Calvin Klein Inc to registration of 966033 – CALVIN KLEIN trade mark - filed in the name of Michael McNulty.

Your ref: 966033

Dear Opponent,

I refer to the above matter.

I have now had the opportunity to review all of the relevant material and decide this matter. Below is my decision, including written reasons, made as the delegate of the Registrar, in relation to the above matter, dated **Friday 11 March 2005**.

Should you intend to appeal this decision, please note the provisions of the Federal Court Rules Order 58, Rule 4 (2) and (2A) which read, respectively:

*(2) An appeal must be instituted within 21 days after the date of the decision appealed from or within such further time as the Court, on application, fixes, unless a law of the Commonwealth provides otherwise.*

*(2A) The notice of appeal must be served on the Commissioner (in this case, the Registrar) and all other parties to the appeal within 5 days of the day on which the notice of appeal is filed.*

### **Background**

1. In this matter, Michael McNulty, (“the applicant”), has filed application to register a trade mark, current details of which appear below.

Appn Number:	966033
Priority Date:	08 January 2004
Goods/Services:	<b>Class: 33.</b> Alcoholic beverages except beer
Trade Mark:	Calvin Klein

2. On 20 February 2004, Notice of Opposition ('the Notice') was filed by Calvin Klein Trademark Trust C/- Calvin Klein Inc ('the opponent') to the registration of the trade mark. The Notice claims most available grounds under the *Trade Marks Act 1995*.
3. The opponent has filed and served evidence in support of the opposition as allowed by the Act. The applicant has not served and filed evidence in answer. Neither party has requested a hearing and the matter has been given to me for my written decision and reasons therefore as a delegate of the Registrar of Trade Marks.
4. The opponent has made written submissions which I have read and considered.

### **Evidence**

5. There are two statutory declarations in support of the opposition – they are by Russell John Waters with exhibits RJW1 to RJW3 and by Deirdre Miles-Graeter with exhibits A to J.
6. Put in brief, the evidence shows that the opponent is the owner of a trade mark, **Calvin Klein**, which has an established reputation and which the opponent either uses or has licensed in relation a range of goods which include clothing, fragrances, watches, home furnishing and related goods. The opponent, or its associated companies, has or have extensive use of its trade mark around the world, including Australia.
7. The evidence shows that the applicant has also filed applications to register to register the trade marks Armani, Gucci and FCUK – a declarant, Mr Waters, attests to his knowledge of these trade marks in the clothing industry and, from my personal observations of the world, I accept that these trade marks are very well-known in at least the clothing industry.

### **Section 59**

Section 59 of the *Trade Marks Act 1995* provides:

#### **Applicant not intending to use trade mark**

59. The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Australia;

in relation to the goods and/or services specified in the application.

Note: For *applicant* see section 6.

8. The evidence led in these proceedings goes directly to the applicant's bona fides in the filing of the application and its intention to use the trade mark in good faith. The evidence shows that the application is one of four, made on the same day, which are all of trade marks which have a major reputation in the clothing industry.
9. The applicant has not addressed the inferences which might be drawn from its behaviour in evidence of its own. In terms of the principle in *Jones v Dunkel* (1959) 101 CLR 298 at 312:

"... evidence which might have been contradicted by the [applicant] can be accepted the more readily if the [applicant] fails to give evidence; [And] that where an inference is open from facts proved by direct evidence and the question is whether it should be drawn, the circumstance that the [applicant] disputing it might have proved the contrary had he chosen to give evidence is properly to be taken into account as a circumstance in favour of drawing the inference"  
[Parenthetical material adjusted]
10. I therefore accept that the applicant does not have an intention to use the trade mark in good faith.
11. 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.

12. I refuse to register the opposed trade mark.

**Costs**

13. The opponent has requested its costs in these proceedings and it is usual for costs to be ordered against the unsuccessful party.

14. I order costs against the applicant at the official scale.



Ian Thompson  
Hearing Officer  
Trade Marks Hearings

**Friday 11 March 2005**