

## TRADE MARKS ACT 1995

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

Re: Trade Mark Application no. 1612666 – **AUSTRALIAN PETTREATS** series  
– in the name of Aimmad Pty Ltd

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<b>DELEGATE:</b>	<b>Deirdre O'Brien</b>
<b>REPRESENTATION:</b>	<b>Mark Metzeling, IP Gateway Patent &amp; Trade Mark Attorneys</b>
<b>DECISION:</b>	<b>2015 ATMO 123</b> Section 33: application accepted or rejected – ground for rejection under s 41 – trade mark not inherently adapted to distinguish – evidence of use does not establish trade mark did distinguish the applicant's goods at the date of application – s 41(3) applies – application not made in accordance with s 51 – application rejected.

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#### **Background**

1. Aimmad Pty Ltd ('the applicant') is seeking registration under the *Trade Marks Act 1995* ('the Act') of what it claims to be a series of trade marks based on the expression AUSTRALIAN PETTREATS. The goods specified in its application are in class 31 and comprise:

Animal feed; animal foodstuffs; bedding for animals; bedding materials for animals; beverages for animals; chews for animals; food and food products or substances for animals; litter for animals; live animals and pet animals; vegetable protein foodstuffs for consumption by animals; pet food, including snack bar for animals, reward bar for animals, pig ears, pig chews, veggie ears, vegetable ears, veggie, pigs snouts, pigs trotters, pig trotter pieces, pigs ear strips, pork bone, pork, bones, beef, beef chews, beef ears, beef trainups, beef tendon, beef jerky, beef bully, beef hoofs, beef liver nibbles, beef liver, beef and cheese twiggy, beef and cheese, semi moist beef, braided tendons, turkey nibbles, turkey, tuna fillets, tuna, shark cartilage, shark, green lipped mussels, foods for animals with no additives, foods for animals with no preservatives, Australian fish, fish, whole fish, fish pieces, fish chips, kangaroo, kangaroo tails, kangaroo ribs, kangaroo rib rack, kangaroo tail small bites, kangaroo sticks, kangaroo tendons, kangaroo bone, kangaroo straps, kangaroo lami, kangaroo chips, kangaroo liver, kangaroo puff, kangaroo brisket, kangaroo chews, kangaroo trainups, chicken, chicken necks, chicken sticks, chicken nibbles, chicken and veal tender bites, semi moist chicken, chicken and veal tenders, chicken trainups, chicken straps,

chicken and veal bites, chicken lami, chicken chips, chicken breast, chicken and lamb trainups, lamb puffs, lamb, lamb cubes, semi moist lamb, lamb neck, lamb nibbles, lamb sticks, lamb ears, lamb shanks, lamb trainups, lamb tail, lamb liver chips, lamb liver, lamb chips, carob, carob drops, yoghurt, yoghurt drops, strawberry, strawberry drops, liver, treats, dental sticks, dog treats, cat treats, chicken baked bone biscuits, beef and marrowbone baked bone biscuits, liver brownie baked bone biscuits, kangaroo baked bone biscuits, charcoal baked bone biscuits, multi flavour baked bone biscuits, biscuits, dog bar and chews

2. The application was examined by a delegate of the Registrar as required by s 31 of the Act. The examiner reported to the applicant that the requirements of s 51 for a valid series had not been met and that the applicant needed to limit the application to one trade mark. He noted that there was ground for rejecting most of the trade marks under s 41.<sup>1</sup>
3. The applicant's legal representative provided submissions in answer to the examiner's report as well as evidence of the applicant's use of AUSTRALIAN PETTREATS as a trade mark but the examiner was not persuaded. The applicant then exercised its right to be heard pursuant to s 33(4). Section 33 relevantly provides:

**Application accepted or rejected**

- (1) The Registrar must, after the examination, accept the application unless he or she is satisfied that:
  - (a) the application has not been made in accordance with this Act; or
  - (b) there are grounds under this Act for rejecting it.
- (2) The Registrar may accept the application subject to conditions or limitations.
- (3) If the Registrar is satisfied that:
  - (a) the application has not been made in accordance with this Act; or
  - (b) there are grounds under this Act for rejecting it;
 the Registrar must reject the application.
- (4) The Registrar may not reject an application without giving the applicant an opportunity of being heard.

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<sup>1</sup> The examiner considered that the trade marks AUSTRALIAN PETTREATS CHICKEN TRAINUPS, AUSTRALIAN PETTREATS CHICKEN & LAMB TRAINUPS, AUSTRALIAN PETTREATS BEEF TRAINUPS, AUSTRALIAN PETTREATS BEEF & CHEESE TWIGGY, AUSTRALIAN PETTREATS ZERO, AUSTRALIAN PETTREATS LAMB TRAINUPS, AUSTRALIAN PETTREATS KANGAROO TRAINUPS, AUSTRALIAN PETTREATS NAKED and AUSTRALIAN PETTREATS LIVER BROWNIE BAKED BONE BISCUITS are capable of distinguishing.

4. The matter was heard by me, a delegate of the Registrar of Trade Marks, on 26 November 2015. Mark Metzeling of IP Gateway appeared for the applicant. I now have to decide whether to accept or to reject application no. 1612666.

## **Discussion**

### ***Ground for rejecting application***

5. In this matter the ground for rejecting the application is that pursuant to s 41 which provides:

#### **Trade mark not distinguishing applicant's goods or services**

(1) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the ***designated goods or services***) from the goods or services of other persons.

Note: For ***goods of a person*** and ***services of a person*** see section 6.

(2) A trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons only if either subsection (3) or (4) applies to the trade mark.

(3) This subsection applies to a trade mark if:

(a) the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and

(b) the applicant has not used the trade mark before the filing date in respect of the application to such an extent that the trade mark does in fact distinguish the designated goods or services as being those of the applicant.

(4) This subsection applies to a trade mark if:

(a) the trade mark is, to some extent, but not sufficiently, inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and

(b) the trade mark does not and will not distinguish the designated goods or services as being those of the applicant having regard to the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the goods or services from the goods or services of other persons;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

(b) the time of production of goods or of the rendering of services.

Note 2: For ***goods of a person*** and ***services of a person*** see section 6.



the majority of the High Court held in accordance with the principles established in *Clark Equipment Co v Registrar of Trade Marks*<sup>3</sup>, *Burger King Corp v Registrar of Trade Marks*<sup>4</sup> and other cases, that a determination of whether a trade mark is adapted to distinguish first requires consideration of the ‘ordinary signification’ of the words proposed as trade marks to any person in Australia concerned with the goods to which the proposed trade mark is to be applied.<sup>5</sup> Once the ‘ordinary signification’ is established an inquiry can then be made into whether other traders might legitimately need to use the words in relation to their goods.<sup>6</sup>

8. When used in relation to pet foods, AUSTRALIAN PETTREATS describes the goods and their origin. It indicates that the goods are pet treats from an Australian supplier. It is the kind of description that any Australian supplier of pet treats is likely to use in the ordinary course of business. It would not be perceived by persons concerned with pet foods as being a badge of origin. Rather it is the type of trade mark considered by Jacobs J in *British Sugar Plc v James Robertson & Sons Ltd* (‘*British Sugar*’):

Take a very descriptive or laudatory word. Suppose the proprietor can educate 10% of the public into recognising the word as his trade mark. Can that really be enough to say it has a distinctive character and so enough to let the proprietor lay claim to the word as a trade mark altogether? The character at this stage is part distinctive but mainly not. I do not think it would be fair to regard the character of the word as distinctive in that state of affairs. But if the matter were the other way round, so that to 90% of people it was taken as a trade mark, then I think it would be fair so to regard it. This all suggests that the question of factual distinctive character is one of degree. The proviso really means “has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark.” In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish this. And in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a

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<sup>3</sup> (1964) 111 CLR 511, 514.

<sup>4</sup> (1973) 1A IPR 504, 509.

<sup>5</sup> (2014) 109 IPR 154, 170 [70].

<sup>6</sup> *Ibid* [71].

substantial majority of persons as a trade mark – is or is almost a household word.<sup>7</sup>

9. I find that AUSTRALIAN PETTREATS is not to any extent adapted to distinguish the applicant's goods. Pursuant to s 41(3) the onus is on the applicant to establish that because of its use of the trade mark before this application was filed on 20 March 2014, AUSTRALIAN PETTREATS had come to distinguish the applicant's goods.
10. The applicant has filed evidence of its use of the expression AUSTRALIAN PETTREATS, and of the substantially identical expression AUSTRALIAN PET TREATS, as a trade mark. That evidence consists of declarations by Greg Minnikin, the applicant's director, and Craig Hindle, the applicant's accountant. Prior to the hearing the applicant also filed a declaration by its legal representative, Mark Metzeling of IP Gateway Patent and Trade Mark Attorneys.
11. Suffice it to say I am satisfied from the information contained in Mr Minnikin's declaration that the applicant has used the expressions AUSTRALIAN PETTREATS and AUSTRALIAN PET TREATS as trade marks in relation to pet foods since 2010. From small beginnings, the applicant's business has expanded steadily each year but it could not be said from the sales figures provided in Mr Hindle's declaration that it has a significant share of the pet food market. That market is a very large one with potential consumers in every Australian household with a pet cat or dog. Although Mr Minnikin states that that the applicant's goods are currently stocked in national retail outlets he does not say how long this has been the case.
12. Furthermore, as noted in *British Sugar*, even if the applicant had provided evidence of extensive use that may not have been sufficient to establish that a descriptive term has become a badge of origin in the relevant marketplace, capable of distinguishing the applicant's goods from those of other Australian pet food suppliers. In other words, notwithstanding its use by the applicant as a trade mark,

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<sup>7</sup> [1996] RPC 281.

I am not satisfied that for the majority of persons concerned with pet foods, AUSTRALIAN PETTREATS is anything other than an ordinary description.

13. I find that s 41(3) applies with respect to the trade mark AUSTRALIAN PETTREATS.
14. As noted at paragraph 2 of these reasons, the examiner considered that some of the trade marks in the alleged series are *prima facie* capable of distinguishing. I do not agree. The trade marks AUSTRALIAN PETTREATS ZERO and AUSTRALIAN PETTREATS NAKED are to some extent adapted to distinguish but I am not satisfied that they are capable of distinguishing on that basis alone. Nor is there evidence of any, or of any sufficient, use before me which would permit a more favourable assessment.

## Section 51

15. Section 51 provides:

### **Application – series of trade marks**

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark.

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks; he or she must register them as a series in one registration.

16. What are ‘material particulars’ was considered by the delegate in *Effem Foods Pty Ltd*:<sup>8</sup>

[B]y its construction, the words ‘if the trade marks resemble each other in material particulars’ within section 51(1) applies a threshold test that, if

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<sup>8</sup> [1999] ATMO 80.

satisfied, allows the application of subparagraphs (a) to (d).<sup>9</sup> At one level, the expression 'material particulars' denotes that portion of the trade mark in which other traders, the public and the courts will regard the trade mark rights as residing. In other words, that part of the sign which has trade mark significance. On another level, the words 'material particulars' denotes all of the component parts that contribute to the identity of the trade mark.

17. The applicant submits that the material particulars of each of the trade marks in the alleged series are the words AUSTRALIAN PETTREATS. It argues that consumers will regard those words as a trade mark and the other words as mere descriptions of the goods to which the trade marks are applied.

18. However in *Darrell Lea Chocolate Shops Pty Ltd v Cadbury Ltd* the delegate observed:

If it were said that to consider the words 'material particulars' is to view them as describing where the 'gestalt' of the trade mark lies, then those words indicate the essence of that from where the trade mark draws its identity as such. It would seem to be true of a trade mark which is established on a sign which lacks any inherent capacity to distinguish, that any change to that sign or indicia from which the trade mark is said to derive its gestalt must necessarily involve a major change to itself and hence its material particulars. Or, to state this another way, where a trade mark lacks any inherent capacity to distinguish, even minor variations must make a substantial difference to the 'material particulars' of the trade mark.<sup>10</sup>

19. I find that none of the applicant's trade marks draws its identity as a trade mark from the words AUSTRALIAN PETTREATS alone.<sup>11</sup> As noted earlier in these reasons AUSTRALIAN PETTREATS is an ordinary description. When it is combined with other words which are ordinary descriptions, the expression as a whole draws its identity from all the descriptive words. Thus the material particulars of AUSTRALIAN PETTREATS CAT TREATS are different from those of AUSTRALIAN PETTREATS PIG SNOOTS.

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<sup>9</sup> I note that section 51 was amended in 2006 and that there is now no equivalent provision to subparagraph (d). However the requirement under section 51 that the trade marks resemble each other in material particulars was not affected by the amendment.

<sup>10</sup> (2006) 69 IPR 386 at [46].

<sup>11</sup> Other than the expression AUSTRALIAN PETTREATS solus.

20. The evidence shows the applicant has used AUSTRALIAN PETTREATS as a trade mark and the applicant submits that because of that use at the date of application AUSTRALIAN PETTREATS did distinguish its goods so that consumers would regard its presence in each of the trade marks as an indication of trade origin. In that case, so the applicant submits, the remaining material in each trade mark falls into the category of ‘statements or representations as to the goods’ as specified by s 51(1)(a) of the Act.
21. I consider that submission has merit. When assessing whether an application has been made in accordance with s 51 the Registrar should not disregard information that goes to a relevant fact, namely whether or not consumers perceive AUSTRALIAN PETTREATS as a description or as an indicator of trade source. However the issue is moot as the applicant otherwise failed to establish that AUSTRALIAN PETTREATS has acquired a secondary meaning as a trade mark. Accordingly I find that the application has not been made in accordance with s 51 of the Act.

### **Decision**

22. Pursuant to s 33(3) I reject application no. 1612666.

Deirdre O’Brien  
Delegate of the Registrar of Trade Marks  
22 December 2015

2004-2005-2006

The Parliament of the  
Commonwealth of Australia

THE SENATE

*Presented and read a first time*

## **Trade Marks Amendment Bill 2006**

**No.     , 2006**

*(Industry, Tourism and Resources)*

**A Bill for an Act to amend the *Trade Marks Act 1995*, and for related purposes**

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1     **A Bill for an Act to amend the *Trade Marks Act***  
2     ***1995, and for related purposes***

3     The Parliament of Australia enacts:

4     **1 Short title**

5             This Act may be cited as the *Trade Marks Amendment Act 2006*.

6     **2 Commencement**

7             (1) Each provision of this Act specified in column 1 of the table  
8                 commences, or is taken to have commenced, in accordance with  
9                 column 2 of the table. Any other statement in column 2 has effect  
10                according to its terms.  
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**Commencement information**

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<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day on which this Act receives the Royal Assent.	
2. Schedule 1, Part 1	The day on which this Act receives the Royal Assent.	
3. Schedule 1, Part 2	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	
4. Schedule 1, Part 3	The day on which this Act receives the Royal Assent.	

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Note: This table relates only to the provisions of this Act as originally passed by the Parliament and assented to. It will not be expanded to deal with provisions inserted in this Act after assent.

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(2) Column 3 of the table contains additional information that is not part of this Act. Information in this column may be added to or edited in any published version of this Act.

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### **3 Schedule(s)**

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Each Act that is specified in a Schedule to this Act is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this Act has effect according to its terms.

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## **Schedule 1—Amendments**

### **Part 1—Amendments commencing on Royal Assent**

#### ***Trade Marks Act 1995***

##### **1 Readers guide (after the material relating to Parts 15, 16 and 17 in the summary of the Act)**

Insert:

Part 17A:	Enables the making of regulations to enable the performance of the obligations of Australia, or to obtain for Australia any advantage or benefit, under the Madrid Protocol. Those regulations prevail over this Act to the extent of any inconsistency.
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##### **2 Readers guide (list of terms defined in section 6)**

Insert the following terms in their appropriate alphabetical positions:

“month”  
“registered trade marks attorney”  
“working day”.

##### **3 Section 6**

Insert:

*month*: the end of a period with a length expressed in months is worked out under section 6A.

##### **4 After section 6**

Insert:

##### **6A Periods expressed in months**

For the purposes of this Act, a period expressed in months and dating from an event ends:

- (a) on the day, in the relevant subsequent month, which has the same number as the day of the event; or

1 (b) if the relevant subsequent month has no day with the same  
2 number—on the last day of the month.

3 Note: This provision displaces section 36 of the *Acts Interpretation Act*  
4 *1901*, and is in accordance with the Madrid Protocol. The difference  
5 between the two occurs when the initiating event is on the last day of a  
6 calendar month, which has fewer days than the month in which the  
7 period ends. For example, a period of 3 months from an event on  
8 30 September ends on 30 December under this rule; it would end on  
9 31 December under the *Acts Interpretation Act 1901* provision.

## 10 **5 Application**

11 The amendments made by items 3 and 4 apply to:

- 12 (a) periods starting after the day on which this Act receives the  
13 Royal Assent; and  
14 (b) periods that started on or before that day and that have not  
15 ended by that day.

## 16 **6 Paragraph 15(a)**

17 After “wine is made”, insert “from grapes grown”.

## 18 **7 Subsection 22(1)**

19 After “any rights”, insert “appearing in the Register to be”.

## 20 **8 Transitional**

21 The amendment made by item 7 does not apply to rights vested in  
22 another person but not appearing in the Register until the end of 6  
23 months after the day on which this Act receives the Royal Assent.

## 24 **9 At the end of section 22**

25 Add:

- 26 (3) Equities in relation to a registered trade mark may be enforced  
27 against the registered owner, except to the prejudice of a purchaser  
28 in good faith for value.

29 Note: For *registered owner* and *registered trade mark* see section 6.

## 30 **10 At the end of subsection 27(2)**

31 Add:

32 ; and (c) be made by a person or persons having legal personality.

## 33 **11 Application and saving**

- 1 (1) The amendment made by item 10 applies to applications for registration  
2 of trade marks made after the day on which this Act receives the Royal  
3 Assent.
- 4 (2) That amendment does not affect the validity of the registration of a  
5 trade mark:
- 6 (a) registered before the day on which this Act receives the  
7 Royal Assent; or
- 8 (b) registered on or after that day as a result of an application  
9 made before that day.

10 **12 After subsection 27(2)**

11 Insert:

- 12 (2A) Despite paragraph (2)(c), an application for registration of a  
13 collective trade mark need not be made by a person or persons  
14 having legal personality.

15 Note: For *collective trade mark* see section 162.

16 **13 Application**

17 The amendment made by item 12 applies to applications for registration  
18 of collective trade marks made after the day on which this Act receives  
19 the Royal Assent.

20 **14 Paragraph 31(b)**

21 Omit “under Division 2”, substitute “under this Act”.

22 **15 At the end of section 31**

23 Add:

24 Note: For *this Act* see section 6.

25 **16 Paragraph 33(1)(b)**

26 After “grounds”, insert “under this Act”.

27 **17 Subsection 33(1) (note)**

28 Repeal the note, substitute:

29 Note: For *this Act* see section 6.

30 **18 Paragraph 33(3)(b)**

1 After “grounds”, insert “under this Act”.

2 **19 At the end of subsection 33(3)**

3 Add:

4 Note: For *this Act* see section 6.

5 **20 Application**

6 The amendments made by items 16 to 19 apply to:

- 7 (a) applications for registration of trade marks made after the  
8 commencement of this item; and  
9 (b) applications for registration of trade marks pending at that  
10 commencement.

11 **21 Subsection 41(6)**

12 Omit “not inherently”, substitute “not to any extent inherently”.

13 **22 Subsection 52(4)**

14 Omit “Division 2”, substitute “this Act”.

15 **23 At the end of subsection 52(4)**

16 Add:

17 Note: For *this Act* see section 6.

18 **24 Section 55**

19 Before “Unless”, insert “(1)”.

20 **25 At the end of section 55**

21 Add:

- 22 (2) Without limiting subsection (1), if the application was opposed on  
23 the ground specified in paragraph 62(a) (that the application, or a  
24 document filed in support of the application, was amended contrary  
25 to this Act), the Registrar may revoke the acceptance of the  
26 application and examine the application again under section 31.

27 Note: For *examine* and *this Act* see section 6.

28 **26 Application**

29 The amendment made by item 25 applies to:

- 1 (a) applications for registration of trade marks made after the  
2 commencement of this item; and  
3 (b) applications for registration of trade marks pending but not  
4 accepted at that commencement.

5 **27 Section 57**

6 Omit “Division 2 of Part 4”, substitute “this Act”.

7 **28 At the end of section 57**

8 Add:

9 Note: For *this Act* see section 6.

10 **29 After section 58**

11 Insert:

12 **58A Opponent’s earlier use of similar trade mark**

- 13 (1) This section applies to a trade mark (*section 44 trade mark*) the  
14 application for registration of which has been accepted because of:  
15 (a) subsection 44(4); or  
16 (b) a similar provision of the regulations made for the purposes  
17 of Part 17A.

18 Note: Subsection 44(4) prevents rejection of an application for registration  
19 of a trade mark that is substantially identical with, or deceptively  
20 similar to, a registered trade mark or a trade mark whose registration  
21 is being sought where the first-mentioned trade mark has been  
22 continuously used since before the priority date of the other trade  
23 mark.

- 24 (2) The registration of the section 44 trade mark may be opposed on  
25 the ground that the owner of the substantially identical or  
26 deceptively similar trade mark (*similar trade mark*) or the  
27 predecessor in title:  
28 (a) first used the similar trade mark in respect of:  
29 (i) similar goods or closely related services; or  
30 (ii) similar services or closely related goods;  
31 before the owner of the section 44 trade mark or the  
32 predecessor in title in relation to the section 44 trade mark  
33 first used the section 44 trade mark; and  
34 (b) has continuously used the similar trade mark in respect of  
35 those goods or services since that first use.

1 Note: For *predecessor in title* see section 6.

2 **30 Application**

3 The amendment made by item 29 applies to:

- 4 (a) applications for registration of trade marks made after the  
5 commencement of this item; and  
6 (b) applications for registration of trade marks pending but not  
7 accepted at that commencement.

8 **31 Paragraph 60(a)**

9 Repeal the paragraph, substitute:

- 10 (a) another trade mark had, before the priority date for the  
11 registration of the first-mentioned trade mark in respect of  
12 those goods or services, acquired a reputation in Australia;  
13 and

14 **32 Section 60 (notes)**

15 Repeal the notes, substitute:

16 Note: For *priority date* see section 12.

17 **33 Paragraph 61(1)(b)**

18 Repeal the paragraph, substitute:

- 19 (b) a region or locality in the country in which the relevant goods  
20 originated other than the region or locality in which the  
21 relevant goods originated;  
22 if the relevant goods are similar to the designated goods or the use  
23 of a trade mark in respect of the relevant goods would be likely to  
24 deceive or cause confusion.

25 **34 Application**

26 The amendment made by item 33 applies to:

- 27 (a) applications for registration of trade marks made after the  
28 commencement of this item; and  
29 (b) applications for registration of trade marks pending but not  
30 accepted at that commencement.

31 **35 At the end of Division 2 of Part 5**

32 Add:

1       **62A Application made in bad faith**

2                       The registration of a trade mark may be opposed on the ground that  
3                       the application was made in bad faith.

4       **36 Application**

5                       The amendment made by item 35 applies to:

- 6                       (a) applications for registration of trade marks made after the  
7                       commencement of this item; and  
8                       (b) applications for registration of trade marks pending but not  
9                       accepted at that commencement.

10      **37 Section 86**

11                      After “person”, insert “or the Registrar”.

12      **38 Subsection 87(1)**

13                      After “person”, insert “or the Registrar”.

14      **39 Subsection 88(1)**

15                      After “person”, insert “or the Registrar”.

16      **40 Paragraph 88(2)(a)**

17                      Omit “Division 2 of Part 5”, substitute “this Act”.

18      **41 Paragraph 88(2)(c)**

19                      Omit all the words after “confusion”.

20      **42 Subsection 88(2) (note 2)**

21                      Repeal the note, substitute:

22                      Note 2:     For *file, registered owner* and *this Act* see section 6.

23      **43 After section 88**

24                      Insert:

25      **88A Applications by Registrar**

26                      The Registrar must not make an application under section 86, 87 or  
27                      88 unless he or she considers the application desirable in the public  
28                      interest.

1 **44 Subsection 90(1)**

2 Omit “A”, substitute “An aggrieved”.

3 **45 Subsections 90(2) and (3)**

4 Repeal the subsections, substitute:

5 (2) In relation to an application made by an aggrieved person, the  
6 Registrar may appear before the court and be heard at his or her  
7 discretion unless the court directs the Registrar to appear before the  
8 court.

9 (3) If the application is made by an aggrieved person, the applicant  
10 must give to the Registrar a copy of any order made by the court  
11 under this Division.

12 (4) The Registrar must comply with any order made by the court under  
13 this Division.

14 **46 Subsection 92(1)**

15 Repeal the subsection, substitute:

16 (1) Subject to subsection (3), a person may apply to the Registrar to  
17 have a trade mark that is or may be registered removed from the  
18 Register.

19 **47 Subsection 92(3)**

20 Omit “aggrieved”.

21 **48 Subsection 92(4) (note)**

22 Repeal the note, substitute:

23 Note 1: For *file* and *month* see section 6.

24 Note 2: If non-use of a trade mark has been established in a particular place or  
25 export market, then instead of the trade mark being removed from the  
26 Register, conditions or limitations may be imposed under section 102  
27 on the registration of the trade mark so that its registration does not  
28 extend to that place or export market.

29 **49 At the end of section 101**

30 Add:

31 (4) Without limiting the matters the Registrar may take into account in  
32 deciding under subsection (3) not to remove a trade mark from the

1 Register, the Registrar may take into account whether the trade  
2 mark has been used by its registered owner in respect of:  
3 (a) similar goods or closely related services; or  
4 (b) similar services or closely related goods;  
5 to those to which the application relates.  
6 Note 1: If the registered owner of the trade mark has authorised another  
7 person to use it, any authorised use of the trade mark by that person is  
8 taken to be a use of the trade mark by the registered owner (see  
9 subsection 7(3)).  
10 Note 2: For *registered owner* see section 6.

11 **50 Subsections 132(4) and (5)**

12 Omit “2 years”, substitute “4 years”.

13 **51 Application**

14 The amendments made by item 50 apply to notices given under  
15 section 132 of the *Trade Marks Act 1995* after the commencement of  
16 this item.

17 **52 Subsection 177(1) (note 3)**

18 Omit “the grounds”, substitute “the main grounds”.

19 **53 Subsection 181(1)**

20 Repeal the subsection.

21 **54 Subsection 181(2)**

22 Omit “(as affected by subsection (1))”.

23 **55 Section 187 (note)**

24 Repeal the note, substitute:

25 Note: Division 2 of Part 4 sets out the main grounds for rejecting an  
26 application but section 41 does not apply to defensive trade marks (see  
27 section 186). Division 2 of Part 5 sets out the main grounds for  
28 opposing registration.

29 **56 Section 188**

30 Repeal the section.

31 **57 Paragraph 197(a)**

32 Omit “further”.

1 **58 Subsection 226(1)**

2 After “issue”, insert “(electronically or otherwise)”.

3 **59 Subsection 226(2)**

4 Repeal the subsection.

5 **60 Subsection 226(3)**

6 After “publish”, insert “(electronically or otherwise)”.

7 **61 Before section 227**

8 Insert:

9 **226B Certain proceedings do not lie**

10 No criminal or civil action or proceeding lies against the Registrar,  
11 a Deputy Registrar or an employee for publishing, or otherwise  
12 making available, reasonably and in good faith, information  
13 required or permitted by this Act to be published or otherwise  
14 made available.

15 Note: For *employee* see section 6.

16 **62 Application**

17 The amendment made by item 61 applies to information published or  
18 otherwise made available after the commencement of this item.

1

2 **Part 2—Amendments commencing on Proclamation**

3 *Trade Marks Act 1995*

4 **63 Readers guide (list of terms defined in section 6)**

5 Omit the following term:

6 “association”.

7 **64 Section 6 (definition of *association*)**

8 Repeal the definition.

9 **65 Section 6 (definition of *date of registration*)**

10 Repeal the definition, substitute:

11 *date of registration* means:

- 12 (a) in relation to the registration of a trade mark in respect of  
13 particular goods or services other than a trade mark to which  
14 paragraph (b) applies—the day from which the registration of  
15 the trade mark in respect of those goods or services is taken  
16 to have had effect under subsection 72(1) or (2); or  
17 (b) in relation to a trade mark to which subsection 239A(3)  
18 applies—the day referred to in subsection 239A(4).

19 **66 Section 6 (paragraph (b) of the definition of *filing date*)**

20 Repeal the paragraph, substitute:

- 21 (b) in relation to a divisional application for the registration of a  
22 trade mark—the filing date of the application that is the  
23 parent application (within the meaning of section 45) in  
24 relation to the divisional application; or

25 **67 Subsection 27(5)**

26 Omit “(other than an application under section 51 for the registration of  
27 2 or more trade marks as a series)”.

28 **68 Division 3 of Part 4**

29 Repeal the Division, substitute:

1 **Division 3—Divisional applications**

2 **45 Divisional applications**

- 3 (1) If a single application for the registration of a trade mark in respect  
4 of certain goods and/or services is pending (*parent application*),  
5 the applicant may make another application (*divisional*  
6 *application*) for the registration of the trade mark in respect of  
7 some only of the goods and/or services in respect of which  
8 registration is sought under the parent application.

9 Note: For *applicant* and *pending* see section 6.

- 10 (2) To avoid doubt, the parent application may itself be a divisional  
11 application.

12 Note: A divisional application may be made by a person who has become  
13 the applicant in relation to the parent application because of  
14 subsection 108(2) (which deals with assignment and transmission).

15 **46 Rules relating to divisional applications**

- 16 (1) A divisional application must:  
17 (a) be for the registration of the trade mark to which the parent  
18 application relates; and  
19 (b) specify the goods and/or services to which it relates; and  
20 (c) specify the goods and/or services that are to remain in the  
21 parent application.

22 Note: For *divisional application* and *parent application* see section 45.

- 23 (2) When a divisional application is made, the Registrar must, unless  
24 the parent application has lapsed, amend the parent application by  
25 excluding the goods and/or services in respect of which the  
26 divisional application is made.

27 Note: Section 204 requires the Registrar, where no time or period is  
28 specified for doing a thing, to do the thing as soon as practicable.  
29 However, it is possible that a parent application will lapse before it is  
30 practicable for the Registrar to amend it under subsection (2) of this  
31 section.

32 **69 Application**

33 The amendments made by items 66 and 68 apply to applications made  
34 after the commencement of this item.

1 **70 Subsection 51(1)**

2 Omit “similar goods or similar services within a single class”, substitute  
3 “goods and/or services”.

4 **71 Paragraphs 51(1)(c) and (d)**

5 Repeal the paragraphs, substitute:

6 (c) the colour of any part of the trade mark.

7 **72 Application**

8 The amendments made by items 70 and 71 apply to applications for  
9 registration made after the commencement of this item.

10 **73 After section 51**

11 Insert:

12 **51A Linking series applications**

13 (1) Subsection (2) applies if:

14 (a) before the commencement of this section, 2 or more  
15 applications (*series applications*) were made each seeking  
16 the registration of the same 2 or more trade marks in respect  
17 of goods or services of different classes; and

18 (b) the filing date of each of the series applications is the same;  
19 and

20 (c) each of the trade marks has the same owner.

21 Note: For *filing date* see section 6.

22 (2) The owner of the trade marks may apply to the Registrar, in  
23 writing, to have:

24 (a) the series applications; or

25 (b) so many of the series applications as are identified in the  
26 application to the Registrar;

27 dealt with under this Act as if they were one application for the  
28 registration of the trade marks in respect of all goods and services  
29 specified in the series applications or the identified series  
30 applications.

31 Note: For *this Act* see section 6.

1                   (3) If an application is made under subsection (2), the Registrar must  
2                   deal with the series applications that are the subject of the  
3                   application under that subsection as if they were one application.

4                   **74 Subsection 63(1)**

5                   Omit “written”.

6                   **75 Subsection 63(1)**

7                   Omit “or 65”, substitute “, 65 or 65A”.

8                   **76 Paragraph 63(2)(b)**

9                   Omit “in writing”.

10                  **77 Section 65**

11                  Repeal the section, substitute:

12                  **65 Amendment after particulars of application have been**  
13                  **published—request for amendment not advertised**

14                  (1) If the particulars of the application have been published under  
15                  section 30, the application may be amended as provided in this  
16                  section.

17                  (2) An amendment may be made to the representation of the trade  
18                  mark if the amendment does not substantially affect the identity of  
19                  the trade mark as at the time when the particulars of the application  
20                  were published.

21                  (3) An amendment may be made to an application to which section 51  
22                  applies to remove one or more trade marks from the application.

23                  (4) An amendment may be made to correct an error in the  
24                  classification of goods or services specified in the application.

25                  (5) An amendment may be made to add to the class or classes of goods  
26                  or services specified in the application one or more other classes of  
27                  goods or services if the Registrar is of the opinion that it is fair and  
28                  reasonable in all the circumstances to do so.

29                  (6) An amendment may be made to change the type of registration  
30                  sought in the application (for example, an application for the  
31                  registration of a trade mark as a certification trade mark may be

1 amended to an application for registration as a collective trade  
2 mark).

3 (7) An amendment may be made to any other particular specified in  
4 the application unless the amendment would have the effect of  
5 extending the rights that (apart from the amendment) the applicant  
6 would have under the registration if it were granted.

7 **65A Amendment after particulars of application have been**  
8 **published—request for amendment advertised**

- 9 (1) This section applies if:  
10 (a) the particulars of the application have been published under  
11 section 30; and  
12 (b) the amendment requested is not an amendment which could  
13 be made under section 65.
- 14 (2) The application may be amended to correct a clerical error or an  
15 obvious mistake in the application if the Registrar is of the opinion  
16 that it is fair and reasonable in all the circumstances of the case to  
17 make the amendment under this section.
- 18 (3) Subject to subsection (5), the Registrar must advertise the request  
19 for the amendment in the *Official Journal*.
- 20 (4) Subject to subsection (5), a person may, as prescribed, oppose the  
21 granting of the request for the amendment.
- 22 (5) If the Registrar is satisfied that a request for an amendment would  
23 not be granted even in the absence of opposition under  
24 subsection (4):  
25 (a) the Registrar need not advertise the request in accordance  
26 with subsection (3); and  
27 (b) the request cannot be opposed, despite subsection (4); and  
28 (c) the Registrar must refuse to grant the request.

29 **78 Section 66**

30 Omit “written” (wherever occurring).

31 **79 After section 66**

32 Insert:

1       **66A Registrar may require certain requests to be in writing**

2                   The Registrar may require a request under section 63 or 66 to be in  
3                   writing if the Registrar is of the opinion that the amendment  
4                   requested is not minor.

5       **80 Paragraph 78(b)**

6                   Omit “12 months”, substitute “6 months”.

7       **81 Section 79**

8                   Omit “12 months”, substitute “6 months”.

9       Note:       The heading to section 79 is altered by omitting “12” and substituting “6”.

10      **82 Application**

11                   The amendments made by items 80 and 81 apply to trade marks whose  
12                   registration expires at least 12 months after the commencement of this  
13                   item.

14      **83 After section 82**

15                   Insert:

16      **82A Linking series registrations**

17                   (1) Subsection (2) applies if:

18                   (a) before the commencement of this section, 2 or more  
19                   applications were made each seeking the registration of the  
20                   same 2 or more trade marks in respect of goods or services of  
21                   different classes; and

22                   (b) the filing date of each of those applications is the same; and

23                   (c) the trade marks are registered trade marks for the purposes of  
24                   this Act with the same registered owner.

25       Note:       For *filing date*, *registered owner* and *registered trade mark* see  
26                   section 6.

27                   (2) The registered owner may apply to the Registrar, in writing, to  
28                   have those trade marks, or so many of those trade marks as are  
29                   identified in the application to the Registrar, dealt with under this  
30                   Act as if they were registered as a series in one registration in  
31                   respect of all goods and services in respect of which the trade  
32                   marks, or the identified trade marks, were registered.

1                   Note:     For *this Act* and *registered owner* see section 6.

2                   (3) If an application is made under subsection (2), the Registrar must  
3                   deal with the trade marks, or the identified trade marks, as if they  
4                   were one registration.

5                   **84 Subsection 128(1)**

6                   Omit “12 months”, substitute “6 months”.

7                   **85 Application**

8                   The amendment made by item 84 applies to trade marks whose  
9                   registration expires at least 12 months after the commencement of this  
10                  item.

11                  **86 Subsection 133(3)**

12                  Repeal the subsection, substitute.

13                  (3) Subject to subsection (3A), the Customs CEO may decide not to  
14                  seize the goods unless he or she has been given by the objector (or  
15                  by one or more of the objectors) a written undertaking acceptable  
16                  to the Customs CEO to repay to the Commonwealth the expenses  
17                  of seizing the goods.

18                  Note:     For *objector* see section 6.

19                  (3A) The Customs CEO may decide not to seize the goods unless he or  
20                  she has been given by the objector (or one or more of the  
21                  objectors), instead of an undertaking, security in an amount that the  
22                  Customs CEO considers sufficient to repay to the Commonwealth  
23                  the expenses of seizing the goods if:

24                         (a) an amount payable under an undertaking given by the  
25                         objector (or one or more of the objectors) in relation to other  
26                         goods has not been paid in accordance with the undertaking;  
27                         and

28                         (b) the Customs CEO considers it reasonable in all the  
29                         circumstances to require the security.

30                  (3B) An undertaking may be withdrawn or varied if the Customs CEO  
31                  consents in writing to a written request from the objector or  
32                  objectors to do so.

33                  **87 At the end of section 133**

34                  Add:

1 (5) In this section:

2 *expenses of seizing goods* means the expenses that may be  
3 incurred by the Commonwealth if the goods were seized.

4 **88 Section 141**

5 Omit “subsection 133(3)”, substitute “subsection 133(3A)”.

6 **89 After section 141**

7 Insert:

8 **141A Failure to comply with undertaking etc.**

9 (1) If an amount payable under an undertaking in relation to goods  
10 covered by a notice given under section 132 is not paid in  
11 accordance with the undertaking, the Customs CEO may decide  
12 not to seize goods covered by the notice until the amount owing is  
13 paid.

14 (2) An amount not paid under an undertaking:

15 (a) is a debt due by the objector, or by the objectors jointly or  
16 each of them separately, to the Commonwealth; and

17 (b) may be recovered by an action taken in a court of competent  
18 jurisdiction.

19 Note: For *objector* see section 6.

20 (3) If the amount paid under an undertaking in relation to goods  
21 covered by a notice given under section 132 is in accordance with  
22 the undertaking but is not sufficient to meet the expenses incurred  
23 by the Commonwealth as a result of the action taken by the  
24 Customs CEO under this Part because of the notice, the amount of  
25 the difference between those expenses and the amount paid:

26 (a) is a debt due by the objector, or by the objectors jointly or  
27 each of them separately, to the Commonwealth; and

28 (b) may be recovered by an action taken in a court of competent  
29 jurisdiction.

30 **90 Transitional provision**

31 (1) This item applies if:

- 1 (a) before the commencement of this item, a notice under  
2 section 132 of the unamended Trade Marks Act was in force  
3 in relation to goods; and  
4 (b) before the commencement of this item, a security under  
5 subsection 133(3) of that Act was given to the Customs CEO  
6 to be applied towards the expenses of the Commonwealth  
7 incurred in relation to the goods under Part 13 of that Act;  
8 and  
9 (c) after the commencement of this item, the Customs CEO has  
10 been given a written undertaking under subsection 133(3) of  
11 the amended Trade Marks Act to repay those expenses to the  
12 Commonwealth; and  
13 (d) the undertaking is in force.
- 14 (2) On application in writing to the Customs CEO by the objector or  
15 objectors concerned, the Customs CEO must:  
16 (a) if none of the security has been applied towards the expenses  
17 mentioned in paragraph (1)(b)—return the security to the  
18 person who gave it; or  
19 (b) otherwise—refund the amount of the balance of the security  
20 to the person who gave it.
- 21 (3) In this item:  
22 *amended Trade Marks Act* means the *Trade Marks Act 1995* as in force  
23 immediately after the commencement of this item.  
24 *unamended Trade Marks Act* means the *Trade Marks Act 1995* as in  
25 force immediately before the commencement of this item.

26 **91 Section 162 (note)**

27 Repeal the note.

28 **92 At the end of Division 2 of Part 22**

29 Add:

30 **239A Linked trade marks**

- 31 (1) Subsection (2) applies if:  
32 (a) the same trade mark was registered before 1 January 1996 in  
33 respect of goods or services of different classes; and

- 1 (b) all the applications for the trade marks were lodged (or were  
2 taken under the repealed Act to have been lodged) on the  
3 same day with the Trade Marks Office; and  
4 (c) the trade marks are registered trade marks for the purposes of  
5 this Act with the same registered owner.
- 6 Note: For *registered owner* and *registered trade mark* see section 6.
- 7 (2) The registered owner may apply to the Registrar, in writing, to  
8 have those trade marks, or so many of those trade marks as are  
9 identified in the application, dealt with under this Act as if they  
10 were one registered trade mark in relation to the goods or services  
11 in respect of which the trade marks, or the identified trade marks,  
12 were registered.
- 13 (3) If an application is made under subsection (2), the Registrar must  
14 deal with the trade marks, or the identified trade marks, as if they  
15 were a single trade mark.
- 16 (4) The date of registration of the single trade mark is taken to be the  
17 day on which the applications mentioned in paragraph (1)(b) were  
18 lodged, or were taken to have been lodged (as the case may be),  
19 with the Trade Marks Office under the repealed Act.

1

2 **Part 3—Minor and technical amendments**

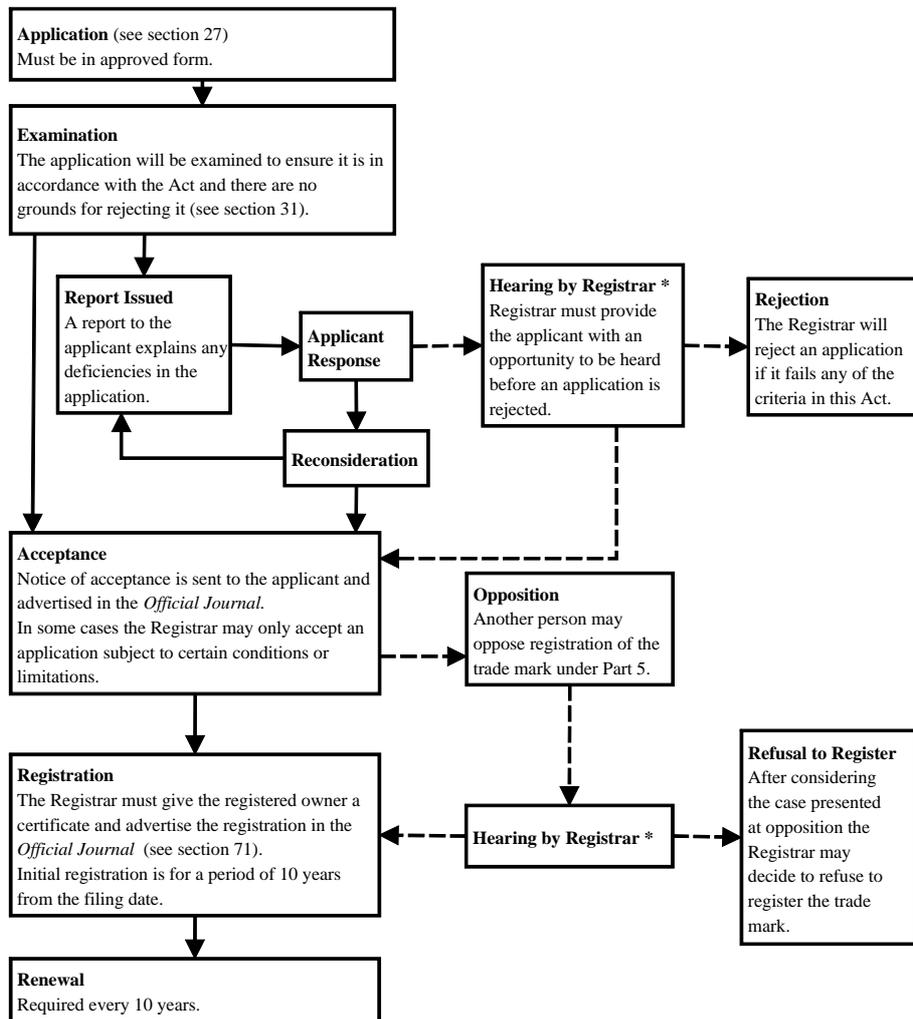
3 *Trade Marks Act 1995*

4 **93 Readers guide (appendix)**

5 Repeal the appendix, substitute:

6

**Appendix - Obtaining registration of a trade mark**



\* An Appeal may be made to the Federal Court against the decision of the Registrar.

← Unbroken lines signify the most likely course of events.

Note: Fees and time limits may apply at various stages of this process.

1  
2  
3  
4  
5

**94 At the end of subsection 29(1)**

Add:

Note: For *month* see section 6.

1 **95 Section 78 (note)**  
2 Before “*Register*”, insert “*month* and”.

3 **96 At the end of section 79**  
4 Add:  
5 Note: For *month* see section 6.

6 **97 At the end of section 80F**  
7 Add:  
8 Note: For *month* see section 6.

9 **98 At the end of subsection 80G(1)**  
10 Add:  
11 Note: For *month* see section 6.

12 **99 Subsection 100(1) (note 2)**  
13 After “*file*”, insert “, *month*”.

14 **100 At the end of section 128**  
15 Add:  
16 Note: For *month* see section 6.

17 **101 Subsection 143(2) (note)**  
18 Omit “Note”, substitute “Note 1”.

19 **102 At the end of subsection 143(2)**  
20 Add:  
21 Note 2: For *month* see section 6.

22 **103 At the end of subsection 224(5)**  
23 Add:  
24 Note: For *month* see section 6.  
25

2004–2005–2006

THE PARLIAMENT OF THE COMMONWEALTH OF AUSTRALIA

SENATE

TRADE MARKS AMENDMENT BILL 2006

EXPLANATORY MEMORANDUM

(Circulated by authority of  
the Parliamentary Secretary to the Minister for Industry, Tourism and Resources,  
the Hon Bob Baldwin MP)

# TRADE MARKS AMENDMENT BILL 2006

## 1 Outline

This Bill amends the *Trade Marks Act 1995* (the Act) to implement a number of changes subsequent to a review of the Act.

The Act commenced operation on 1 January 1996. IP Australia conducted a review to ensure the Act and supporting Regulations continue to meet the needs of Australian business, including users of the trade mark system.

The review identified a number of issues that had become apparent with experience since commencement of the Act. Some of these issues arose from decisions of the Registrar of Trade Marks and judicial comment which indicated that the original policy intent has not been captured by the Act in some instances. The review also considered practical problems in the administration of the Act, including a lack of clarity in some areas.

The amendments made by this Bill will clarify the operation of the Act where experience suggests there is some doubt as to how the Act operates, implement changes in policy settings due to experience since the Act commenced, and make a number of minor amendments.

The measures in the Bill increase the certainty of trade mark rights issued; increase predictability of the trade mark system and clarity of the Act; reduce the regulatory and administrative burden on trade mark applicants and owners; and improve transparency and align the Act with other intellectual property legislation.

### 1.1 Financial Impact Statement

No additional cost to the Government is expected to result from the amendments contained in this Bill.

# TRADE MARKS AMENDMENT BILL 2006

## 2 Notes on Clauses

### 2.1 Clause 1—Short title

1. Clause 1 is a formal provision specifying the short title of the Bill.

### 2.2 Clause 2—Commencement

1. Clause 2 provides for the commencement of the Act, setting out the commencement information in a table. Parts 1 and 3 of Schedule 1 commence on the day the Act receives Royal Assent. Part 2 of Schedule 1 commences on proclamation or within 6 months from Royal Assent.

### 2.3 Clause 3—Schedule

1. This clause provides that each Act specified in a Schedule is to be amended or repealed according to the relevant provisions of that Schedule. Any item in a Schedule has effect according to its terms.

## 3 SCHEDULE 1—Amendments

## 4 Part 1—Amendments Commencing On Royal Assent

### 4.1 READER'S GUIDE

#### Section 6

1. The Reader's Guide aims to give readers of the Act a general idea of the purpose of the Act and some information about its structure. It also explains briefly how the operation and interpretation of the Act is affected by other Acts.
2. The Reader's Guide contains a "list of terms defined in section 6". This list does not contain a number of terms that have either been added to the Act or been shown to need defining.
3. The Reader's Guide also contains a "Summary of this Act" in which the various parts of the Act are identified and a brief explanation of their subject matter given. The *Trade Marks Amendment (Madrid Protocol) Act 2000* introduced Part 17A into the Act to give effect to the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Madrid Protocol). Part 17A is not summarised in the Readers Guide.

#### 4.1.1 Item 1

1. This item inserts a summary of the provisions relating to international applications under the Madrid Protocol in Part 17A to the "Summary of this Act" in the Reader's Guide.

#### 4.1.2 Item 2

1. This item amends the "List of terms defined in section 6" that is found in the Reader's Guide to insert terms that have been added into section 6 of the Act but not included in the list.

### 4.2 PERIODS EXPRESSED IN MONTHS

#### Section 6A

1. There are currently two different methods of calculating time periods expressed in months relating to trade mark actions. The method found in the *Acts Interpretation Act 1901* (the AI Act) is applied to time periods found in the Act. The method found in the Madrid Protocol and in regulation 2.2 of the *Trade Marks Regulations 1995* (the Regulations) is applied to all other time periods. This causes confusion for users of the trade mark system as users may be unsure which method of calculation to use.

#### **4.2.1 Items 3 and 4**

1. These items insert a definition of “month” into section 6, and set out the method of calculating time periods expressed in months to be used in the Act in section 6A. This ensures that time periods are calculated consistently, regardless of whether the time period is set out in the Act, the Regulations or in the Madrid Protocol. The new method of calculation is in accordance with the method used under the Madrid Protocol. The note to section 6A gives an example of the different results of the two methods.

#### **4.2.2 Item 5**

1. This is an application provision. The amendment to section 6A will apply to all periods starting after Royal Assent and all time periods that started on or before that day that have not ended by that day.

### **4.3 DEFINITION OF “ORIGINATE” IN RELATION TO WINE**

#### **Paragraph 15(a)**

1. When the *Trade Marks Act 1995* commenced on 1 January 1996, the definition in section 15 of ‘originate’ in relation to wine was the same as the then definition in section 5D of the *Australian Wine and Brandy Corporation Act 1980* (the AWBC Act). Under paragraph 15(a) of the *Trade Marks Act 1995* the definition of ‘originate’ in relation to wine is: ‘a wine is taken to have originated in a foreign country or Australia only if the wine is made within the territory of that country or of Australia, as the case may be’. It is therefore possible that if grapes are imported into Australia or a foreign country, and made into wine in Australia or that country, the wine could qualify as originating in Australia or that country.

2. The definition in the AWBC Act has been amended for the purposes of clarification and the words ‘from grapes grown’ were inserted into paragraph 5D(a). Paragraph 5D(a) of the AWBC Act now provides that ‘a wine is taken to have originated in a foreign country or Australia only if the wine is made from grapes grown within the territory of that country or of Australia, as the case may be’.

#### **4.3.1 Item 6**

1. This item brings the definition in the Trade Marks Act into line with the definition in the AWBC Act. It clarifies that wine originates from a foreign country or Australia if and only if the wine is made from grapes grown in that country. The amendments will not have any labelling or production consequences for Australian wine producers as they must already comply with the requirements of the AWBC Act.

### **4.4 POWER OF REGISTERED OWNER TO DEAL WITH TRADE MARK**

#### **Section 22**

1. The power of the registered owner of a trade mark to deal with their trade mark is limited by any rights vested in another person. However, the power of a patentee (under section 189 of the *Patents Act 1990*) or registered owner of a registered design (under section 12 of the *Designs Act 2003*) to deal with their patent or design is limited by any rights vested in another person that

appear in the Register. The effect of this difference is that there is an incentive for people with an interest in a patent or registered design to register their interest and have it appear on the Register, because if they do not record their interest then the person recorded on the Register as the owner can continue to deal with the patent or registered design. As the ability of a trade mark owner to deal with their trade mark is limited by any right vested in another person, whether or not that right has been recorded, there is no incentive for a person with an interest in a trade mark to register their interest. This means potential purchasers of a trade mark do not know if the registered owner of the trade mark is the sole owner of the trade mark, or in what way the right may be encumbered.

2. Another difference is that there is no provision in the Act equivalent to subsection 189(3) of the Patents Act or subsection 12(3) of the Designs Act. These provisions provide that equities in relation to a right may be enforced against the right holder except to the prejudice of a purchaser in good faith.

#### **4.4.1 Item 7**

1. This item inserts a new phrase into subsection 22(1) which makes it clear that the power of a registered owner of a trade mark to deal with the trade mark is limited only by any rights appearing in the Register.

#### **4.4.2 Item 8**

1. This is a transitional item applying to the amendment to section 22 and gives people time to inform the Registrar of Trade Marks (the Registrar) of the details of any unregistered interest in their trade mark. The amendment does not apply to rights vested in another person but not appearing in the Register, until (six) 6 months after Royal Assent.

#### **4.4.3 Item 9**

1. This item inserts a provision at the end of section 22 which makes it clear that the equities in relation to a registered trade mark may be enforced against the trade mark owner except to the prejudice of a purchaser in good faith.

### **4.5 PERSONS WHO MAY OWN A TRADE MARK**

#### **Subsection 27(2)**

1. A trade mark is a valuable property right and it is important that the owner is properly recorded. Sections 27 and 58 of the Act work together to ensure that the person recorded as the owner of a trade mark is the owner. A person applying for a trade mark must claim to be the owner of the trade mark (paragraph 27(1)(a) of the Act). Another person can oppose the registration of a trade mark on the grounds the applicant is not the owner (section 58 of the Act).

2. Section 6 of the Act defines a person as a body of persons whether incorporated or not. However, groups such as trusts, business names, trading names and partnerships are not usually able to own property. Ownership of property is usually limited to persons who have legal personality. However, there has been some confusion as to who can own a trade mark, in particular in relation to trusts and business names.

3. There is an exception to the definition of persons able to own a trade mark. International agreements oblige Australia to allow an association to own a collective trade mark. The current definition of association in section 6 excludes incorporated associations. Item 64 will remove this restriction and allow incorporated associations to apply for collective trade marks. However, in making this change the rights of unincorporated associations to own collective trade marks are preserved.

#### **4.5.1 Item 10**

1. This item amends subsection 27(2) of the Act to make it clear that only a person with a legal personality can apply for a trade mark. This will make it clear that trusts, business names or any other entity that does not have a legal personality cannot apply for a trade mark.

#### **4.5.2 Item 11**

1. This item is a savings and application provision to make it clear that the amendment made to subsection 27(2) does not affect the validity of any registration that may have been registered before Royal Assent, or any trade mark registered on or after Royal Assent as a result of an application filed before that day.

#### **4.5.3 Items 12 and 13**

1. Item 12 sets out an exception to subsection 27(2) of the Act, which was amended by item 10. This exception provides that any association, whether incorporated or not, may apply for a collective trade mark. This change only applies to applications made after Royal Assent.

### **4.6 GROUNDS FOR REJECTION AND OPPOSITION ARE NOT ALL IN DIVISION 2 PART 4 AND 5**

#### **Numerous provisions**

1. Numerous provisions and notes in the Act refer to Division 2 of Part 4 when identifying the grounds on which a trade mark application may be rejected. Similarly numerous provisions refer to Division 2 of Part 5 when identifying the grounds on which registration of a trade mark may be opposed. For example, section 31 of the Act states that the Registrar must examine and report on whether there are any grounds under Division 2 of Part 4 for rejecting the application. However, there are other grounds for rejection and opposition set out in other parts of the Act, for example those in Part 16 relating to certification trade marks, Part 17 for defensive trade marks and Part 17A relating to applications received via the Madrid Protocol. Section 6 of the Act states that the Act includes the Regulations. Regulation 4.15A sets out grounds for rejection relating to applications that are identical or deceptively similar to trade marks protected under the Madrid Protocol.

2. The references to Division 2 of Part 4 and Division 2 of Part 5 could mislead the reader that the only grounds for rejection or opposition are in Division 2 of Part 4 or 5. All of those references wherever they appear in the Act are amended to refer to “the Act” rather than to any particular Division or Part of the Act.

#### **4.6.1 Items 14–20, 22, 23, 27, 28, 40, 52–56**

1. Items 14 to 19 amend paragraph 31(b), add a note to section 31, amend paragraph 33(1)(b) and the note to subsection 33(1), amend paragraph 33(3)(b) and add a note to subsection 33(3) to clarify that grounds for rejection may be found in places other than Division 2 of Part 4 of the Act.

2. Item 20 is an application provision. The amendments made by items 16–19 will apply to trade mark applications made after Royal Assent or pending but not accepted on that day.

3. Items 22, 23, 27 and 28 amend subsection 54(4), add a note at the end of subsection 52(4), amend section 57 and add a note to section 57 to clarify that grounds for opposition may be found in places other than Division 2 of Part 5 of the Act.

4. Item 40 amends paragraph 88(2)(a) to clarify that grounds for amendment or cancellation may be found in places other than Division 2 of Part 5.

5. Items 52, 54 and 55 amend the note to subsection 177(1), subsection 181(2) and the note to section 187 to clarify that grounds for rejecting or opposing certification trade marks and defensive trade marks may be found in places other than Division 2.

6. Items 53 and 56 repeal subsection 181(1) and section 188 as they have become redundant because of other amendments listed above. Paragraph 88(2)(a) has been amended to make it clear that all grounds under the Act apply, which includes the grounds applying to certification and defensive trade marks.

## **4.7 TRADE MARKS NOT DISTINGUISHING APPLICANT'S GOODS OR SERVICES**

### **Section 41(6)**

1. A trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services from the goods or services of another trader. The first consideration in deciding whether a trade mark is registrable requires an assessment of the degree to which the trade mark is inherently adapted to distinguish. Provisions relating to the possible differing degrees of inherent adaptation are separately addressed in subsections 41(5) and 41(6) with subsection 41(6) applying in those cases where the trade mark is totally lacking in inherent adaptation to distinguish.

#### **4.7.1 Item 21**

1. This item amends subsection 41(6) of the Act so the terminology used in subsection 41(5) of the Act is used to describe the extent to which a trade mark is inherently adapted to distinguish the goods and/or services of the trade mark applicant. This will clarify that subsections 41(5) and (6) of the Act refer to gradations of the same test, and that subsection 41(6) applies only where there is no inherent adaptation to distinguish.

## **4.8 AMENDMENTS CONTRARY TO THE ACT**

### **Section 55**

1. A person may oppose the registration of a trade mark where a trade mark application, or a document filed in support of the application, was amended contrary to the Act (paragraph 62(a) of the Act). Section 55 of the Act provides two outcomes for the opposition: the Registrar must either refuse to register the trade mark; or must register the trade mark. However, in some cases the offending amendment may be readily corrected, and even though an amendment contrary to the Act has been made, it may not be appropriate to refuse to register the trade mark. In this case, re-examination of the trade mark and re-advertisement of the changed details, to notify other parties, is a more equitable course.

#### **4.8.1 Items 24–25**

1. These items amend section 55 to give the Registrar the discretion to revoke the acceptance of an application and to re-examine an application where an application was amended contrary to the Act.

#### **4.8.2 Item 26**

1. This is an application provision. The amendment to section 55 will apply to applications made after Royal Assent and to applications pending but not accepted on that day.

## **4.9 OPPONENT’S EARLIER USE OF SIMILAR TRADE MARK**

### **Section 58A**

1. A person may obtain acceptance and registration for a trade mark under section 44(4) even though an earlier similar trade mark has been registered for similar goods and services. The person must be able to show that they have used the trade mark before the filing date of the earlier trade mark on those particular goods or services.
2. However the owner of the earlier trade mark may have used their trade mark before applying for trade mark registration and accrued common law rights. As it stands the owner of the earlier registered mark has no basis on which to oppose registration of a trade mark accepted under subsection 44(4), even where their use pre-dates that of the accepted application.
3. The new section will provide a basis for the Registrar to give consideration to these issues in opposition proceedings.

### **4.9.1 Item 29**

1. This item creates a new ground of opposition in section 58A to enable the owner of a registered trade mark to oppose registration of a similar mark accepted under the prior use provisions of subsection 44(4). While other grounds may be relevant in a proceeding, the owner of the registered mark will need to establish that their use of the mark predates the use of the accepted application for an opposition to succeed under the new ground.

### **4.9.2 Item 30**

1. This is an application provision. The amendment to section 58A will apply to trade marks applications made after Royal Assent and applications that are pending but not accepted on that day.

## **4.10 TRADE MARK SIMILAR TO TRADE MARK THAT HAS ACQUIRED A REPUTATION IN AUSTRALIA**

### **Section 60(a)**

1. The intention of section 60 of the Act is to implement Australia’s obligations to protect well-known marks under the Paris Convention for the Protection of Intellectual Property and the 1994 World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The provisions have not been written so as to establish a new class of trade marks (“well-known” marks) or to prescribe a particular threshold of how well-known a mark must be. Rather, the test has been written so that it can be applied to all marks. The test depends on the extent of the reputation in Australia that has been acquired by a sign. In light of that reputation, the question to be asked is whether the use of a subsequent trade mark would be likely to result in deception or confusion. Section 60 is a ground for opposition to a trade mark application for registration, which can also be used under section 88 as a basis for cancellation of a registration by the courts.
2. Under the current arrangements the provisions of section 60 require that the applied-for mark be substantially identical with, or deceptively similar to, the trade mark forming the basis of opposition *before* consideration of any deception or confusion, resulting from the reputation of the opponent’s trade mark, can take place. Substantial identity and deceptive similarity are tests undertaken in examination of an application before the opposition process, and have very well established scope.

3. There have been a number of instances where a trade mark has an established reputation in Australia, and use of a subsequently applied-for trade mark would deceive or cause confusion, even though the subsequent trade mark is not substantially identical with, or deceptively similar to the original trade mark. However, because of the way paragraph 60(a) of the Act is written it is not possible to currently use this provision to prevent registration of a mark which fails the tests for substantial identity or deceptive similarity, but which nevertheless will cause confusion or deception in relation to a well-known mark. The tests for deception and confusion are all well established in judicial authority, and hinge on the question of whether or not a reasonable number of people may be caused to wonder if a trade connection exists between the marks. By removing the requirement for substantial identity or deceptive similarity from section 60, the ground for opposition under section 60 can be used to oppose the registration of a trade mark because of the possible deception or confusion arising solely from the reputation of a trade mark.

4. Under the amended provisions the consideration of oppositions would take into account the extent of the reputation of the opposing mark at the time the opposed mark was applied for, and the likelihood of deception and confusion occurring in the marketplace because of this.

#### **4.10.1 Items 31–32**

1. New paragraph 60(a) of the Act provides that a trade mark may be opposed where another trade mark has a reputation, and the registration of the opposed mark will cause confusion or deception in the market place, whether or not the reputation is built on a mark that is identical or deceptively similar to the opposed mark.

### **4.11 TRADE MARK CONTAINING OR CONSISTING OF A FALSE GEOGRAPHICAL INDICATION**

#### **Section 61(1)**

1. The international definition of geographical indications is set out in Article 22 of the TRIPS Agreement. ‘Geographical indication’ is defined in section 6 of the Act. Geographical indications are recognised signs indicating that goods originating from a particular locality have a quality, reputation or other characteristic attributable to their geographical origin. Both geographical indications and trade marks are signs which denote the origin of particular, designated goods. Protection of the respective signs only extends to those goods, or closely related goods, or to situations where use is likely to deceive or cause confusion. The existing wording of the Act allows a person to oppose a trade mark that contains a geographical indication where the goods to which the trade mark is applied are different from the goods to which the geographical indication relates.

2. For example “Hilltops” is a geographical indication for wine produced around the town of Hilltops in Southern New South Wales. Under the terms of section 61 of the Act, it is possible to oppose a trade mark containing the word “Hilltops” for kites made in Perth, even where there is no association between the Hilltops wine region and kites, and even though kites and wine are unrelated goods.

3. This was never the intention of the Act. The intention was that it would be possible to oppose a trade mark that contains a geographical indication where use of the trade mark may lead consumers to believe the goods are associated with the geographical indication.

#### **4.11.1 Item 33**

1. This item adds a qualification to subsection 61(1) so that it is only possible to oppose a trade mark containing a geographical indication where the goods specified by the trade mark are

similar to those covered by the geographical indication or would otherwise be likely to deceive or cause confusion.

#### **4.11.2 Item 34**

1. This item is an application provision. The amendment to subsection 61(1) will apply to trade mark applications made after Royal Assent, and applications pending but not accepted on that day.

### **4.12 APPLICATION MADE IN BAD FAITH**

#### **Section 62A**

1. The Act allows removal of a trade mark on the basis that there was no intention in good faith to use, authorise use of, or assign the trade mark. However, current opposition grounds do not cover instances in which a person has deliberately set out to gain registration of a trade mark, or adopted a trade mark in bad faith. There have been several instances in which trade mark applicants have deliberately set out to gain registration of their trade marks, or have adopted trade marks, in bad faith. Some examples of these include:

- a person who monitors new property developments; registers the name of the new property development as a trade mark for a number of services; and then threatens the property developer with trade mark infringement unless they licence or buy the trade mark;
- a pattern of registering trade marks that are deliberate misspellings of other registered trade marks; and
- business people who identify a trade mark overseas which has no market penetration in Australia, and then register that trade mark with no intention to use it in the Australian market and for the express purpose of selling the mark to the overseas owner.

2. When such situations occur, there is very little third parties can do to prevent registration of this type of trade mark, because existing grounds for rejection and opposition do not allow the Registrar to take these facts into account.

#### **4.12.1 Item 35**

1. This item inserts section 62A into the Act. This provision enables a person to oppose the registration of a trade mark on the basis that the trade mark applicant set out to register their trade mark in bad faith.

#### **4.12.2 Item 36**

1. This is an application provision. The amendment to section 62A applies to trade mark applications made after Royal Assent, and applications pending but not accepted on that day.

### **4.13 THE REGISTRAR MAY INITIATE COURT ACTION**

#### **Sections 86, 87, and subsection 88(1)**

1. Sections 86, 87 and 88 of the Act each provide that an aggrieved person may apply to a prescribed court for certain actions to be taken. Under the *Trade Marks Act 1955* (the 1955 Act) it was possible for the Registrar to apply to a prescribed court for these actions to be taken. This was not included in the current Act as the Registrar had never made an application under the provisions of the 1955 Act. Since the commencement of the current Act, it has become apparent that there may be occasions where it is in the public interest for the Registrar to take court action to have the Register amended, or a trade mark removed from the Register. However, before making application to the court, the Registrar will need to be satisfied that an appropriate ground exists for doing so. The Registrar will review the facts of the matter, to the extent they are

available, and consider the existence or otherwise of aggrieved parties and their inclination or capacity to take action on their own behalf.

#### **4.13.1 Items 37–39, 43–45**

1. Items 37–39 amend sections 86–88 to allow the Registrar to take court action on his or her own initiative. There is a limiting factor to this discretion set out in section 88A (item 43).
2. Item 43 inserts a new provision, section 88A, that sets limits upon when the Registrar may initiate or partake in court action. The Registrar may only initiate court action if it is desirable in the public interest.
3. Items 44 and 45 are consequential to the amendments made by amendments to section 86 and subsections 87(1) and 88(1).

#### **4.14 AMENDMENT OR CANCELLATION — OTHER SPECIFIED GROUNDS**

##### **Section 88**

1. A trade mark can be removed from the Register due to grounds existing at the time the trade mark application was filed, or due to grounds arising after the trade mark was filed.
2. A trade mark right can be renewed in perpetuity. There are trade marks on the Register that were filed and registered under the *Trade Marks Act 1905* as well as under the 1955 Act. However, the continued existence of a trade mark relies upon the current Act irrespective of the Act under which it was registered.
3. Paragraph 88(2)(c) of the Act allows removal of a trade mark due to grounds that exist at the time the application to remove the trade mark is made. Paragraph 88(2)(c) of the Act is drafted so that it refers to sections of the Act on which an application could have been opposed or rejected. This style of drafting fails to recognise that some trade marks were registered under previous Acts and so could never have been opposed or rejected on grounds found in the current Act. Consequently, it is not clear that trade marks registered under a previous Act can be removed from the Register due to grounds that have arisen since they were registered.

##### **4.14.1 Item 41 and 42**

1. These items amend paragraph 88(2)(c) to make it clear that any trade mark may be removed from the register, irrespective of the Act under which it was registered, if it is likely to deceive or cause confusion to consumers at the time an application to remove it from the Register is made.

#### **4.15 REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE**

##### **Section 92**

1. A condition of registration of a trade mark is that it must be used or intended to be used. Where a trade mark has not been used for the required period, it can be removed from the Register so that other traders may use the trade mark. The current provisions require that a person must be aggrieved in order to seek removal of a trade mark from the Register due to non-use. In recent years there have been a number of instances where a trade mark has not been used for the required length of time, but the application for removal due to non-use has failed because the person who made the application did not, often because of ignorance or a procedural failure, show they were a person aggrieved. Any person concerned enough to make an application to remove a trade mark due to non-use should have standing to make that application.

#### **4.15.1 Items 46 and 47**

1. These items amend section 92 so that anyone, not just a person aggrieved, may make an application for a trade mark to be removed from the Register due to non-use.

#### **4.16 LOCALISED USE OF A TRADE MARK**

##### **Section 92(4)**

1. Part 9 of the Act deals with removal of a trade mark from the Register for non-use. A person may apply to the Registrar or to a court to have a trade mark removed because that trade mark has not been used in Australia. If there has been no use, the Registrar or the court may then decide to either remove the trade mark, or decide not to remove the trade mark, if it is reasonable to do so. A further possible outcome, where the trade mark has only been used in a restricted area, such as a particular city or state, is to limit the use of the trade mark to that place.

2. An example of this is where a registered trade mark for restaurant services has only been used in Western Australia with no intention to use the trade mark anywhere else. Another applicant may have, in good faith, begun using the same trade mark for a café in NSW. In order to gain protection, the NSW applicant may need to take non-use action against the Western Australian trade mark owner. Section 102 potentially allows the Registrar to restrict the two trade marks to their geographical locales, Western Australia and NSW or the East Coast respectively.

##### **4.16.1 Item 48**

1. This item adds a note to subsection 92(4) making it clear that where non-use of a trade mark has been established in a particular place or locale, it may not be necessary to remove the trade mark from the Register but merely restrict use of the trade mark to those places it is currently in use.

#### **4.17 USE OF TRADE MARK ON SIMILAR OR RELATED GOODS WOULD REBUT ALLEGATIONS OF NON-USE**

##### **Section 101**

1. When non-use action is taken, the owner of the trade mark may rebut those allegations by showing that their trade mark has been used on the goods and/or services for which it is registered. However, it is not uncommon for owners to use their trade mark on goods and/or services that whilst not those on the registration, nevertheless are closely related. Currently, it is not clear that the Registrar is able to take use on closely related goods or services into account, when deciding whether to exercise his or her discretion not to remove a trade mark from the Register.

##### **4.17.1 Item 49**

1. This item amends section 101 and makes it clear that the Registrar may take into account use of the trade mark on closely related goods and services, when deciding not to remove a trade mark from the register due to a non-use.

2. An example of this may be where a trade mark owner has a registration for computer software goods, but rather than developing computer software for commercial and retail sales, they have found instead their business has specialised in the provision of a custom development of software systems service. The new provision will clarify that the Registrar is able to take into account whether custom development of computer software and computer software are seen as closely related services and goods.

## **4.18 NOTICE OF OBJECTION TO IMPORTATION**

### **Section 132**

1. Part 13 of the Act sets out how a trade mark owner (or authorised user) may object to the importation of goods infringing their trade mark. The registered owner of the trade mark must give the Customs CEO a notice objecting to the importation of goods (notice of objection) that infringe the trade mark. Currently, notices of objection lodged with Customs must be re-lodged every two years (subsections 132(4) and (5)). Although there is no fee for lodging these notices, the cost to the objector of preparing and lodging the notices can be significant, particularly where the number of trade marks notified pursuant to a notice is large. There can be a significant administrative burden on objectors in re-submitting the required paperwork and evidence.

2. The *Olympic Insignia Protection Act 1987* also includes provisions relating to seizure of imported goods. That Act provides for a notice of objection to cease after four years. Costs to the trade mark owner or authorised user will be reduced by extending the period in subsections 132(4) and 132(5) of the Act from two to four years.

### **4.18.1 Items 50**

1. This item amends subsections 132(4) and 132(5) so that notices of objection remain in force for four years. This will ease the administrative burden upon and costs to trade mark owners utilising the Customs seizure provisions.

### **4.18.2 Item 51**

1. This is an application provision. The amendment to subsections 132(4) and 132(5) will apply only to notices of objection given under section 132 after Royal Assent.

## **4.19 POWERS OF FEDERAL COURT**

### **Section 197(a)**

1. When a person appeals a decision of the Registrar to the Federal Court, the Act allows the Federal Court to “admit further evidence”. As the Federal Court hears a case *de novo*, the inclusion of the word “further” is confusing. The Federal Court, in *Soncini v Registrar of Trade Marks* [2001] FCA 333 (30 March 2001), has expressed uncertainty about the meaning of “further”.

### **4.19.1 Item 57**

1. This item deletes the word “further” from paragraph 197(a) to make it clear that the Federal Court may admit any evidence on hearing an appeal against a decision of the Registrar, even if that evidence was not filed previously with the Registrar.

## **4.20 PUBLICATION OF OFFICIAL JOURNAL OF TRADE MARKS**

### **Section 226**

1. The Registrar of Trade Marks must issue, at regular intervals, an *Official Journal of Trade Marks*. Currently the Registrar must sell copies. In practice, the Registrar makes the Official Journal available free of charge on a web-site. The number of paid subscribers to the paper copy has diminished markedly and IP Australia wishes to discontinue the sale of paper copy and only provide a free on-line service.

#### **4.20.1 Items 58–60**

1. These items amend section 226 by inserting the words “electronically or otherwise” so that the Official Journal may be available in a format as determined by the Registrar and by removing the requirement that the Registrar must sell of copies of the Official Journal.

#### **4.21 CERTAIN PROCEEDINGS DO NOT LIE**

##### **Section 226B**

1. The Act requires that all trade mark applications be published on filing. Therefore if a person applies for a scandalous or defamatory trade mark, it will be published irrespective of its content. Only later when the application has been examined will the fact that it is for a scandalous or defamatory trade mark be identified and registration refused. It is not possible for the Registrar to remove a trade mark from the trade mark database or Official Journal once it has been published. Even if a trade mark application lapses or is refused, it will still be published. Increased usage of electronic media has made the publication of scandalous or defamatory marks more problematic.

##### **4.21.1 Item 61**

1. This item inserts a provision that confirms that the Registrar is not subject to civil or criminal liability in relation to publishing, communicating, or distributing any material as authorised by the Act or Regulations if that action is undertaken reasonably and in good faith. This provides protection from legal action for the Commonwealth for actions the Act mandates.

##### **4.21.2 Item 62**

1. This is an application provision. The new section 226B will apply to information published or otherwise made available after Royal Assent. This is to avoid any retrospective effect.

### **5 Part 2—Amendments Commencing on Proclamation**

#### **5.1 INCORPORATED ASSOCIATIONS MAY OWN A COLLECTIVE TRADE MARK**

##### **Section 6**

1. A Collective trade mark is a trade mark that is used, or intended to be used, by members of an association to distinguish the association’s goods or services from goods or services provided by other traders. The particular requirements of a collective trade mark are set out in Part 15 of the Act. Under the current provisions the definition of an association only includes unincorporated bodies (section 6). This means that many associations would not be able to own a collective trade mark because most associations are now incorporated.

##### **5.1.1 Items 63 and 64**

1. Item 63 omits the term “association” from the list of terms defined in section 6 in the Reader’s guide. Item 64 repeals the definition of association from section 6. This allows a broader meaning of association and enables any association, whether incorporated or not, to own a collective trade mark.

#### **5.2 CHANGE OF DEFINITION OF DATE OF REGISTRATION**

##### **Section 6**

1. Amendments to the Act in this Bill (item 92), provide owners of trade marks registered under the 1955 Act to link their registrations (section 239A). This simplifies the administration of trade mark rights by enabling owners to deal with a number of registrations as one. In order to accommodate these changes, the definition of date of registration in section 6 must be amended to include reference to the newly linked registrations.

### **5.2.1 Item 65**

1. This item repeals the definition of ‘date of registration’ in section 6 and replaces it with a new definition for the ‘date of registration’ of a trade mark that inserts a reference to the new provisions in section 239A to enable calculation of a date of registration to be made for those newly linked marks.

## **5.3 DEFINITION OF FILING DATE**

### **Section 6**

1. Amendments to the Act in this Bill (item 68) provide a new system for divisional applications. The filing date of divisional applications is dependant, not upon the date that the new application was filed but the date on which the parent application, or potentially the earliest application in a chain of divisional applications, was filed. This calculation is not taken into consideration in the current definition of filing date in section 6.

### **5.3.1 Item 66**

1. This item repeals the definition of filing date in paragraph 6(b) and replaces it with one that takes into consideration the calculation of filing dates for divisional applications. Where there is a chain of divisional applications, the filing date of any divisional application will be the filing date of the earliest application in the chain.

## **5.4 DIVISIONAL APPLICATIONS**

### **Sections 45 and 46**

1. Division 3 of Part 4 of the Act sets out a process whereby a trade mark applicant may file a new trade mark application (divisional application) as a continuation of their current application (parent application) under certain circumstances. This is allowable provided the goods or services of the divisional application are a sub-set of the parent application. The current provisions set out a number of different ways a sub-set can be formed based on parts of the trade mark and/or some of the goods and services. Each of these variations has different requirements and different time limitations. The current provisions are unnecessarily complex and have caused considerable confusion, leading to a number of divisional applications not being valid because they do not meet the criteria. A new system for divisional applications is required that meets the needs of customers and conforms to international treaty obligations.

2. The new system incorporates the most commonly used variation and the longest time frame currently available. An applicant may, whilst the parent application is pending, file a divisional application for the same trade mark as the parent application and thereby maintain the same filing date. The parent application may itself be a divisional of an earlier trade mark application.

3. The applicant must divide the goods and/or services of the parent application between the parent application and the divisional application by specifying clearly which goods or services the divisional application relates to, and which goods and services are to remain in the parent application. It is not possible to specify goods or services to be included in the divisional application that were not in the parent application.

4. The applicant needs to divide the goods or services between the two trade marks because it is not in the public interest to have the same trade mark in two different applications with the same filing date, and relating to the same goods and services. There is a potential for confusion in the marketplace should the owner at a later date choose to sell one of the trade marks to a third party. If however, the parent application lapses after the divisional application is filed but before the Registrar can amend it, this situation is avoided, and the Registrar need not amend the parent application.

#### **5.4.1 Item 68**

1. This provision repeals Division 3 of Part 4 and replaces it with a new section 45 and section 46. The new provisions set out the conditions that have to be met in order to file a valid divisional application. These are:

- the trade marks must be the same; and
- the divisional application must be made whilst the parent application is pending; and
- the parent application may itself be a divisional application; and
- the applicant must specify the goods and services to which the divisional application relates; and
- the applicant must specify the goods and services to remain in the parent application; and
- the Registrar must amend the goods or services of the parent application, unless it has already lapsed. The specification by the applicant of the goods and/or services in the divisional and the goods and/or services to remain in the parent will provide sufficient information for the Registrar to make the necessary amendment.

#### **5.4.2 Item 69**

1. This is an application provision. The amendments to section 45 and 46 apply only to divisional applications filed after commencement. This is to give time for education and for administrative details to be finalised.

### **5.5 APPLICATION FOR REGISTRATION OF SERIES OF TRADE MARKS**

#### **Section 27, Section 51, Section 51A and Section 82A**

1. Trade mark owners often use their trade mark in the course of trade with minor variations. When this occurs some trade mark owners want certainty that their trade mark is protected for every variation used. Series trade mark applications, which are defined in section 51 of the Act, provide this protection.

2. Paragraphs 51(1)(a)–(c) of the Act clearly identify what are acceptable variations in the trade mark in a series trade mark application. Acceptable variations are statements and representations of goods or services, number, price, quality, name of places and colour of the trade mark or part thereof. However, paragraph 51(1)(d) allows for any matter that is not inherently adapted to distinguish and does not substantially affect the identity of the trade mark to be an allowable variation. This creates uncertainty as to what a series application can include and is not consistent with the policy objective of allowing series applications only for minor and obvious variations. It also causes people to make many defective series trade mark applications as they do not understand the provisions.

3. Currently subsection 27(5) and subsection 51(1) work together to ensure that series trade mark applications can only be made for similar goods and/or services in a single class. This differs from normal trade marks which may be applied for in multiple classes (multi-class applications). In order to bring series trade marks into line with other trade marks, multi-class applications will now be allowable. This will reduce the administrative burden on series trade

mark owners who will only need to maintain one series application across multiple classes, rather than a separate series application for each class for which they wish protection.

4. As multi-class series trade marks will now be allowable, provision is made in items 73 and 83 for owners of trade mark applications or registrations to link their trade marks to form a single multi-class trade mark provided they are for the same series of trade marks and were filed on the same day.

### **5.5.1 Item 67**

1. This item is a consequential amendment to item 70. It amends subsection 27(5) by removing the exception to that provision and now allows series applications to be filed in multiple classes. Subsection 27(5) sets out that an application may be made in respect of goods and services in one or more classes provided for under the regulations.

### **5.5.2 Item 70**

1. This item amends subsection 51(1) by omitting the requirement that series trade mark applications be for “similar goods or similar services within a single class” This enables trade mark applicants to apply for multi-class series of trade marks.

### **5.5.3 Item 71**

1. This item repeals paragraph 51(1)(d), so that only minor and obvious variations are allowable in a series of trade marks.

### **5.5.4 Item 72**

1. This is an application provision setting out that the new provisions for series applications apply only to those filed after commencement.

### **5.5.5 Item 73**

1. This item adds a new provision, section 51A, that enables applicants to apply to link series applications made before the commencement of this provision provided they meet the conditions of linking. The conditions are that the applications must be for exactly the same series of trade marks and must have been filed on the same day. The trade mark applications will then be dealt with as if they were one trade mark application.

2. Example: Karen makes 2 applications. The first is for the registration of trade mark 1 and trade mark 2 in class 32. The second is for the registration of trade mark 1 and trade mark 2 in class 33. The filing date of each of those applications is the same. Karen can apply to the Registrar to have the applications dealt with as a single application for the registration of trade marks 1 and 2 in classes 32 and 33.

### **5.5.6 Item 83**

1. This item adds a new provision, section 82A, to enable trade mark owners who own series trade marks registered prior to commencement to apply to link their trade marks provided they meet the conditions of linking. These conditions are that the registrations must be for exactly the same series of trade marks and that the trade marks must have the same filing date. The trade mark registrations will then be dealt with as if they were one registration for a series.

## **5.6 CHANGE DETAILS BY TELEPHONE**

### **Section 63 and section 66**

1. Currently section 63 of the Act sets out which amendments to applications may be made and how they must be made. Section 63 states that the Registrar may, at the written request of an applicant or his or her agent, amend an application for the registration of a trade mark subject to section 64 and section 65. Sections 64 and 65 set out the amendments that may be made.

2. Section 66 sets out which amendments may be made to other documents. Both of these provisions state that the request must be made in writing. Amendments included in these sections include administrative amendments, such as correction of typographical errors or minor changes to personal details. This is a cumbersome process for both the applicant and the office as many of the amendments are simple and straightforward, and do not in any way affect the rights granted to the applicant. Many applicants request these amendments over the telephone, and become frustrated when informed that the request must be in writing.

3. It is anticipated, however, that not all of these requests will be able to be made by the Registrar on the authorisation of a telephone conversation. If the Registrar is of the opinion that the amendment is of a complex nature, he or she will still be able to specify that the amendment request be made in writing.

### **5.6.1 Item 74–76 and 78**

1. These items amend subsection 63(1) and subsection 63(2)(b) and section 66 by deleting the word “written”. This allows that requests for minor amendments, such as corrections of typographical errors or minor changes to personal particulars need not be in writing.

### **5.6.2 Item 79**

1. This item inserts new section 66A giving the Registrar the discretion to require a request be in writing if the requested amendment is not minor.

## **5.7 AMENDMENT AFTER PARTICULARS OF APPLICATION HAVE BEEN PUBLISHED**

### **Section 65 and section 65A**

1. Section 65 of the Act provides for the circumstances in which amendments to trade mark applications can be made after particulars of the application have been published.

Subsection 65(3) of the Act provides that an amendment may be made to correct a mistake of fact or an error in the classification of any goods or services specified in the application. The way in which these two circumstances have been defined in the Act confuses many trade mark applicants.

2. In particular, there are occasions where the applicant has nominated an incorrect class, or where the applicant has nominated goods in one class but clearly intended to seek protection in all the classes in which the goods of that kind are classified. For example, the applicant has applied for “blinds of all kinds” in class 20. The classification system for trade marks also lists blinds in classes 6, 22 and 24 depending upon their construction. This amendment clarifies that it is possible to add those extra classes.

3. An additional issue that has caused confusion is whether an amendment to a series trade mark can be made to delete inappropriate or invalid representations of the mark. Whilst section 65 of the Act provides for circumstances in which amendment to trade mark applications can be

made after publication, subsection 65(2) provides that an amendment may only be made if it does not substantially affect the identity of the trade mark. At present it is not clear that the amendment of “series” applications by deletion of one or more trade marks not part of a valid series is allowable. If the amendment is not allowable, it means that the application is not permitted to move forward to acceptance, as it cannot meet the requirements of section 51.

4. The Registrar has the discretion under section 66 to make amendments to correct a clerical error or an obvious mistake, or where the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so. However, section 66 specifically excludes amendments to applications for the registration of a trade mark. A provision is being added to allow applicants an opportunity to correct clerical errors or obvious mistakes in their application.

5. Some amendments to correct clerical errors or obvious mistakes may have more potential impact upon the rights of others, because they may expand the scope of protection of the trade mark. In order to alleviate any concerns that may be held about the scope of allowable amendments, the new provision section 65A includes some checks and balances. The Registrar may only make an amendment under this provision, if it is fair and reasonable to do so, taking into account the possible impact of the amendment on any third parties. Any amendment made under section 65A must also be advertised in the Official Journal and an opportunity provided for the amendment to be opposed.

### **5.7.1 Item 77**

1. This item amends section 65 of the Act. It maintains the current provisions and adds two more examples of errors or mistakes that should be allowable. These are:

- the ability to add a classes or classes of goods after publication if the Registrar is of the opinion that it is fair and reasonable to do so (new subsection 65(5)); and
- the ability to delete representations from a series application if they do not form part of a valid series (new subsection 65(3)).

2. This item also adds a new section 65A, allowing amendments to correct a clerical error or obvious mistake, but only if the Registrar believes that it is fair and reasonable in the circumstances of the case to make the amendment. Because these amendments may extend the right, third parties have the ability to oppose the amendment. However, it is not necessary to publish an application for amendment under section 65A, if the Registrar would not allow the amendment even if there was no opposition. This will prevent applicants and opponents expending resources unnecessarily on oppositions in cases where the amendments would not be allowed anyway.

## **5.8 RENEWAL WITHIN 6 MONTHS AFTER REGISTRATION EXPIRES**

### **Section 78 and section 79**

1. A trade mark is registered for 10 years (subsection 72(3) of the Act), and this term may be extended indefinitely in 10 year intervals upon renewal, which requires payment of renewal fees. If the renewal fee is not paid, the trade mark expires. Section 78 allows twelve months after the trade mark has expired before the trade mark is removed from the Register. This is inconsistent with the Patents Act, the Designs Act and the Madrid Protocol, which all allow six months after renewal is due, before removal from the relevant register. Such inconsistencies of approach can create confusion for users who own multiple types of intellectual property. Considerable uncertainty is also created as other trade mark owners must wait twelve months after the trade mark has expired to know whether the trade mark owner intends to renew the registration or whether the trade mark has been abandoned.

### **5.8.1 Items 80–81**

1. These items amend subsection 78(b) and section 79 by omitting twelve months and replacing it with six months, giving a trade mark owner six months after the trade mark expires in which to renew the registration, before the trade mark is removed from the register.

### **5.8.2 Item 82**

1. This is an application provision. The amendment to paragraph 78(b) and section 79 will apply to trade marks whose registration expires at least twelve months after commencement. This is designed to give trade mark owners plenty of notice, so that their renewals may be paid in a timely manner.

### **5.8.3 Item 84**

1. This is a consequential amendment to the changes made to paragraph 78(b) and section 79 (items 80 and 81). It amends subsection 128(1), replacing it with a provision giving a trade mark owner 6 months after the renewal fee is due in which to pay the fee before the trade mark is removed from the Register.

### **5.8.4 Item 85**

1. This is an application provision. The amendment to subsection 128(1) will apply to all trade marks whose registration expires at least twelve months after commencement. This is designed to give trade mark owners plenty of notice so that their renewals may be paid in a timely manner.

## **5.9 CUSTOMS CEO MAY SEIZE GOODS WHICH INFRINGE TRADE MARKS**

### **Part 13**

1. Part 13 of the Act sets out provisions allowing the Customs CEO to seize and deal with goods that are imported into Australia if the importation infringes, or appears to infringe, a registered trade mark. In order to gain protection under this part a trade mark owner (or an authorised user of the trade mark) must file a notice of objection to importation (notice of objection) with the Customs CEO (section 132 of the Act). The Customs CEO may then seize the goods unless he or she is satisfied that there are no reasonable grounds for believing the trade mark is infringed (section 133). Subsection 133(3) allows the Customs CEO to decide not to seize the goods if he or she has not been given by the objector security, in an amount that he or she considers sufficient to repay the Commonwealth any expenses that may be incurred.

2. In practice all objectors lodge the security at the time of applying for the notice of objection. The Customs CEO currently requires a security of \$10,000. The requirement for a security to be paid at the time of filing a notice of objection may discourage trade mark owners from lodging notices because of the financial and administrative burden placed on business, particularly small business.

3. Currently the Customs CEO holds a considerable amount in cash securities, far in excess of the amount recovered for expenses incurred in seizing the goods. Normally expenses recovered reflect storage of the goods at non-customs premises, transport, handling and disposal of goods. There is a considerable administrative burden on the Customs CEO to manage the cash and documentation of securities lodged under the Act.

### **5.9.1 Items 86–88**

1. These items repeal subsection 133(3) and replace it with new provisions whereby a written undertaking to repay an expense is provided to the Customs CEO, instead of a cash security. This will save businesses a significant expense at the time of lodging a Notice of Objection. New subsection 133(3A) allows the Customs CEO to require a security only in cases where the objector has previously defaulted on an undertaking to repay expenses. This is additional to any action taken under the provisions in item 89 to recover expenses.

### **5.9.2 Item 89**

1. This item adds section 141A, and sets out what actions are available to the Customs CEO if there is a failure by an objector to comply with an undertaking. It sets out that if a person signs an enforceable undertaking, and subsequently fails to make payment in accordance with the undertaking, the Customs CEO is not obliged to seize any further goods under the notice of objection until payment has been made in full. If the amount is not paid or is insufficient to meet the expenses incurred then the amount outstanding would be a debt due by the objector (or objectors jointly) and may be recovered by an action in a court of competent jurisdiction.

### **5.9.3 Item 90**

1. This item is a transitional provision that allows for a person who has previously lodged a notice of objection to be able to seek the return of their existing security, and provide an enforceable undertaking instead, without the need to file a new notice of objection. The Customs CEO will be able to call on the existing security until the enforceable undertaking is in place, and only then will return any unused portion of the security to the objector.

## **5.10 LINKING (AMALGAMATION) OF TRADE MARKS REGISTERED UNDER THE 1955 ACT**

### **Section 239A**

1. Section 27 states that an application may be made in respect of goods and services of one or more of the classes provided for in the regulations. The 1955 Act allowed for only single class applications. When the 1995 Act commenced, provision was made in section 243 for trade mark owners who had applications for the same trade mark filed on the same day and pending on 1 January 1996 to link their trade marks. The applications could then be dealt with as one multi-class trade mark application. This provision did not apply to trade marks registered before 1 January 1996.

2. It is administratively convenient for both the trade mark owner and the Registrar if those trade marks could be linked and dealt with as one registration. This is in line with the amendments to section 82A which provide for the linking of registered series trade marks.

### **5.10.1 Item 92**

1. This item amends Division 2 of Part 22 adding a new provision, section 239A, which allows the registered owner who owns more than one registration, lodged on the same day for the same trade mark prior to 1 January 1996, to link the registered trade marks so that they are treated as one trade mark registration.

## **6 Part 3 – Minor and technical amendments**

### **6.1.1 Items 93-103**

1. These items make a number of minor and technical amendments consequential upon other amendments made in the Bill.

# HIGH COURT OF AUSTRALIA

FRENCH CJ,  
HAYNE, CRENNAN, KIEFEL AND GAGELER JJ

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CANTARELLA BROS PTY LIMITED

APPELLANT

AND

MODENA TRADING PTY LIMITED

RESPONDENT

*Cantarella Bros Pty Limited v Modena Trading Pty Limited*  
[2014] HCA 48  
3 December 2014  
S67/2014

## ORDER

1. *Appeal allowed with costs.*
2. *Set aside the orders of the Full Court of the Federal Court of Australia made on 30 September 2013 and, in their place, order that the appeal to that Court be dismissed with costs.*

On appeal from the Federal Court of Australia

### Representation

A J L Bannon SC with M Green for the appellant (instructed by Clayton Utz Lawyers)

I M Jackman SC with C L Cochrane for the respondent (instructed by Corrs Chambers Westgarth Lawyers)

Notice: This copy of the Court's Reasons for Judgment is subject to formal revision prior to publication in the Commonwealth Law Reports.



## **CATCHWORDS**

### **Cantarella Bros Pty Limited v Modena Trading Pty Limited**

Intellectual property – Trade marks – Foreign words – Appellant was registered owner of trade marks "ORO" and "CINQUE STELLE" in respect of products including coffee – Respondent sought cancellation of appellant's trade marks – Whether trade marks inherently adapted to distinguish appellant's goods from goods of other persons.

Words and phrases – "covert and skilful allusion", "directly descriptive", "inherently adapted to distinguish", "ordinary signification".

*Trade Marks Act 1995 (Cth)*, s 41.



1 FRENCH CJ, HAYNE, CRENNAN AND KIEFEL JJ. In this appeal from a decision of the Full Court of the Federal Court of Australia the appellant, Cantarella Bros Pty Limited ("Cantarella"), seeks to restore to the Register of Trade Marks ("the Register") two of its registered trade marks ordered to be cancelled by the Full Court.

2 The appeal turns upon the provisions of the *Trade Marks Act* 1995 (Cth) ("the Act"), and the question of whether the two trade marks are "inherently adapted to distinguish" the goods for which they were registered from the goods of other persons. The question arose on a cross-claim of the respondent, Modena Trading Pty Limited ("Modena"), claiming as an "aggrieved person"<sup>1</sup> that the two trade marks were liable to be cancelled because they were not "inherently adapted to distinguish" Cantarella's goods.

3 In proceedings in the Federal Court seeking declaratory and injunctive relief and damages, Cantarella claimed that Modena had infringed two of its registered trade marks<sup>2</sup>. The first is Australian trade mark registration No 829098 for the trade mark "ORO", registered since 24 March 2000 in class 30 in respect of "Coffee; beverages made with a base of coffee, espresso; ready-to-drink coffee; coffee based beverages". The second is Australian trade mark registration No 878231 for the trade mark "CINQUE STELLE", registered since 6 June 2001 in class 30 in respect of "Coffee, coffee essences and coffee extracts; coffee substitutes and extracts of coffee substitutes; coffee-based drinks; tea, tea extracts and tea-based drinks; cocoa, cocoa-based preparations and drinks".

4 Before the primary judge, Cantarella succeeded in establishing infringement. Modena failed in its defence that it had merely used the marks as an indication of quality, and in its cross-claim that the trade marks were not "inherently adapted to distinguish" Cantarella's goods. Modena did not appeal from the primary judge's findings concerning infringement. As to the cross-claim, the primary judge found that, although an Italian speaker would appreciate that "oro" signifies some connection with gold, and that "cinque stelle" signifies five stars, it could not be concluded that "oro" and "cinque stelle" would generally be understood in Australia as having those meanings<sup>3</sup>. Those

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1 Within the meaning of the Act, s 88(1).

2 Contrary to the Act, s 120(2).

3 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 776 [117].

French CJ  
Hayne J  
Crennan J  
Kiefel J

2.

findings were not disturbed on appeal. Rather, the Full Court said that the test of whether a mark was "inherently adapted to distinguish" certain goods turned not on what a word constituting the mark was generally understood to mean, but on whether other traders would want to use the word in connection with the same goods.

5 In setting aside orders made by the primary judge and ordering rectification of the Register, the Full Court purported to apply a test stated by Kitto J in *Clark Equipment Co v Registrar of Trade Marks*<sup>4</sup> ("*Clark Equipment*"). A panel constituted by French CJ and Crennan J granted special leave to appeal from the whole of the judgment and orders made by the Full Court.

6 The only question on the appeal in this Court is whether Cantarella's trade marks "ORO" and "CINQUE STELLE" are "inherently adapted to distinguish" Cantarella's goods within the meaning of s 41(3) of the Act.

7 For the reasons which follow, the appeal to this Court should be allowed and the orders made by the Full Court, including the order for rectification of the Register, should be set aside.

#### The facts

8 Both Cantarella and Modena advertise, offer for sale and sell coffee products in the Australian coffee industry.

#### *Cantarella*

9 Cantarella has, since 1958, imported raw coffee beans sourced globally, which are then roasted, ground, and packaged under the registered trade marks "VITTORIA", "AURORA", "DELTA" and "CHICCO D'ORO". Evidence of the state of the Register on 25 May 2011 showed that Cantarella was the registered proprietor of the trade mark "ORO NERO", registered in class 30 in respect of goods which included "coffee", and the composite trade marks "MEDAGLIA D'ORO", registered in classes 29, 30 and 32 for a variety of foodstuffs and beverages, and "CHICCO D'ORO", registered in class 30 in respect of "coffee". Each of these registrations preceded the registration for "ORO" on its own.

10 The trade marks "ORO" and "CINQUE STELLE" are used by Cantarella in relation to specific coffee blends. There was no issue at trial that the trade marks "ORO" and "CINQUE STELLE" are in fact distinctive of Cantarella's

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4 (1964) 111 CLR 511 at 514; [1964] HCA 55.

3.

goods. Each registered trade mark is used by Cantarella not only in Australia, but also in other countries, and Cantarella's trade marks are registered in many of those countries.

*Modena*

- 11 Modena imports coffee from Molinari, a company based in central northern Italy. Molinari has, since 1965, produced a blend of coffee using the marks "CAFFÈ MOLINARI" and "ORO". Molinari exports globally, and began exporting products to Australia in about July 1996. From 1996 to 2009, various businesses distributed Molinari products in Australia, using the marks "CAFFÈ MOLINARI" together with "ORO" (from 1996) and "CAFFÈ MOLINARI" together with "CINQUE STELLE" (from 1998). In November 2009, Modena was appointed as Molinari's exclusive Australian distributor. During the period December 2009 to June 2011, Modena distributed various Molinari products, under and by reference to the abovementioned marks used by Molinari. Approximately 18 months before the trial Molinari ceased using the mark "ORO" on its own on its coffee products and substituted the phrase "QUALITÀ ORO", about which Cantarella has no complaint<sup>5</sup>. Further, "CINQUE STELLE" has come to be used by Molinari in respect of its premium blend of coffee.

Other matters

- 12 There was evidence at trial that coffee products were advertised, offered for sale and sold by companies operating in the coffee industry other than Cantarella and Modena, under and by reference to composite marks which included the Italian word "oro" or the form "d'oro" or the expression "five star" and, in one instance, the word "stelle". That included evidence of the state of the Register led by Cantarella, and evidence of screen shots and packaging samples relied on by Modena.
- 13 Only Cantarella and Modena used "cinque stelle" in respect of their coffee products. However, Modena attached significance to the circumstance that the expression "five star" was commonly employed in Australia in relation to a variety of businesses including businesses providing accommodation and hospitality services.

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5 It was noted in the primary judge's orders that nothing in them should be taken to prevent Modena from using the phrase "QUALITÀ ORO" in respect of its products.

French CJ  
Hayne J  
Crennan J  
Kiefel J

4.

14 The proceedings were conducted on the basis that the word "oro" is an Italian word meaning "gold" and that the words "cinque stelle" are Italian words meaning "five stars". As it happens, the word "oro" is also a Spanish word meaning "gold"; Italian and Spanish are Romance languages deriving the word "oro" from the Latin noun "aurum", meaning gold.

15 As in English, "gold" is used in Italian as a noun and has adjectival forms. Therefore, both the word "oro" and the form "d'oro" readily combine with other words to form composite trade marks, as in Cantarella's registered trade marks "MEDAGLIA D'ORO" and "CHICCO D'ORO". This can also be seen in examples of registered trade marks of numerous other registered proprietors in evidence at trial – "LAVAZZA QUALITA ORO plus device", "CDO CASA DEL ORO plus device", "PIAZZA D'ORO plus device", "TAZZA D'ORO plus device", "STELLA D'ORO" and "CREMA D'ORO plus device" – which are registered in respect of a variety of goods, including coffee. It was not contended that these registered composite marks, which included foreign words, were deceptively similar, whether visually, aurally or semantically.

16 It should also be noted that the entry in the Register for Cantarella's trade mark "CINQUE STELLE" recorded that the English translation is "five star", although "cinque stelle" means "five stars" in Italian. The expression "five star" is defined in the *Macquarie Dictionary* as an adjective meaning excellent quality owing to its derivation from the highest rating in a system of grading hotels, restaurants and the like<sup>6</sup>.

### The Act

17 Section 17 of the Act relevantly defines a trade mark as a "sign" to distinguish one trader's goods from those of another, and "sign" is defined in s 6 to include a word, or a word plus a device. Although the Act does not set out the kinds of trade marks which are registrable, s 17 reflects the objects and policy of all Commonwealth trade marks legislation: (1) that the Register will protect distinctive trade marks<sup>7</sup>; (2) that the monopoly following registration is a sufficient basis upon which to seek relief from infringement; and (3) that the likelihood of deception and confusion between trade marks should be avoided.

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<sup>6</sup> *Macquarie Dictionary*, 5th ed (2009) at 628. See also *The Oxford English Dictionary*, 2nd ed (1989), vol 5 at 978-979, "five", sense C2.

<sup>7</sup> *E & J Gallo Winery v Lion Nathan Aust Pty Ltd* (2010) 241 CLR 144 at 162-163 [41]-[42] per French CJ, Gummow, Crennan and Bell JJ; [2010] HCA 15.

5.

18 Sections 27, 31 and 33 of the Act govern the administrative steps required for the registration of a trade mark. Section 27 provides that a person may apply for the registration of a trade mark in respect of goods if the person claims to be the owner of the trade mark and the person is using, or intends to use, the trade mark in relation to the goods. Section 31 provides that the Registrar of Trade Marks ("the Registrar") must examine and report on whether the application has been made in accordance with the Act and whether there are grounds for rejecting it. Section 33 provides that the Registrar must, after the examination, accept the application, unless satisfied that the application has not been made in accordance with the Act or that there are grounds for rejecting the application.

19 Division 2 of Pt 4 of the Act (ss 39-44) specifies the grounds upon which an application to register a trade mark must be rejected. Section 41 relevantly covers one of these grounds<sup>8</sup>. At the time relevant to these proceedings, s 41(2) provided that an application for registration must be rejected if the trade mark "is not capable of distinguishing the applicant's goods ... in respect of which the trade mark is sought to be registered ... from the goods ... of other persons"<sup>9</sup>.

20 Section 41(3), which is central to this appeal, stated that in deciding whether s 41(2) applies to an application the Registrar must first take into account the extent to which the trade mark "is inherently adapted to distinguish the designated goods ... from the goods ... of other persons".

21 Section 41(6) provided that a trade mark which lacks "inherent adaption to distinguish" may nevertheless be registered if it can be established that the extent of use before the date of application was such that factual distinctiveness could be established.

22 The Act effected significant changes to Australian trade mark law: earlier legislation had specified the kinds of trade marks which were registrable; for the first time in Australia, the Act only specified the kinds of trade marks which were *not* registrable. However, it was common ground that the provisions of the Act which specify the applications for registration which must be rejected cannot be understood fully without some reference to the interpretation of provisions in the

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8 Amendments brought about by the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth), s 3, Sched 6, item 113 (which substituted a new s 41) commenced after any material date in these proceedings.

9 The concept of a mark being "capable of distinguishing" a trader's goods derives from s 25 of the *Trade Marks Act 1955* (Cth) and the institution of Part B of the Register, explained briefly below.

French CJ  
Hayne J  
Crennan J  
Kiefel J

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*Trade Marks Act 1905* (Cth) ("the 1905 Act") and the *Trade Marks Act 1955* (Cth) ("the 1955 Act") which specified the kinds of trade marks which were registrable. This is because the statutory language which gives rise to the question on this appeal has a well-understood provenance.

23 Before turning to that provenance, it is worth briefly noting some additional relevant provisions. Section 88 of the Act provides for the cancelling of trade mark registrations. Section 92 provides grounds for their removal for "non-use". A trader who uses a description of goods in good faith has a defence under s 122(1)(b) to infringement proceedings brought pursuant to s 120.

"Inherently adapted to distinguish" – s 41(3)

24 The Full Court recognised, correctly, that settled principles of trade mark law concerning trade marks which are registrable apply to s 41(3) of the Act, much as they applied to earlier provisions<sup>10</sup>. The language of s 41(2) and (3) derives from earlier Australian trade marks legislation, which followed in many respects statutory language used in trade marks legislation in the United Kingdom.

25 It is convenient to start with s 26 of the 1955 Act, which relevantly provided:

- "(1) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connexion subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations, in relation to use subject to those conditions or limitations.
- (2) In determining whether a trade mark is distinctive, regard may be had to the extent to which –
- (a) the trade mark is inherently adapted so to distinguish; and
  - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish."

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<sup>10</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 26 [59]-[60].

7.

Plainly s 41(3) of the Act derives from s 26(2)(a) of the 1955 Act. Equally plainly, the concept of a trade mark acquiring distinctiveness through use, deployed in s 41(5) and (6) of the Act, was expressed in s 26(2)(b).

26 In considering s 26 of the 1955 Act in *Clark Equipment*, Kitto J explained that whether a trade mark consisting of a word<sup>11</sup> is "adapted to distinguish" certain goods is to be tested<sup>12</sup>:

"by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – *in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess* – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it." (emphasis added)

27 The purport of the emphasised parenthesis was a particular focus of dispute before the Full Court, which dispute was reiterated in this Court.

28 Cantarella relied on the emphasised passage to support the proposition that the inherent adaptability of a trade mark consisting of a word (including a foreign word) is to be tested by checking the ordinary meaning (that is, the "ordinary signification") of the word to anyone ordinarily purchasing, consuming or trading in the relevant goods, characterised by Cantarella as "the target audience".

29 Modena asserted that the emphasised language was not essential to the test because Lord Parker of Waddington in *Registrar of Trade Marks v W & G Du Cros Ltd*<sup>13</sup> ("*Du Cros*") stated the test in terms of the likelihood that other traders might legitimately desire to use the word in connection with their goods.

30 The debate makes it necessary to refer to some historical matters which inform and explain the test stated by Kitto J. A consideration of those matters and relevant authorities shows that Cantarella's submissions are correct and must be accepted.

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11 The word in question was the geographical name "Michigan", which was proposed for registration in Part B of the Register: see ss 25 and 26 of the 1955 Act.

12 (1964) 111 CLR 511 at 514.

13 [1913] AC 624 at 635.

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### Some historical matters

31 In response to public pressure, the *Trade Marks Registration Act 1875* (UK) first instituted a register of trade marks to overcome the limitations of passing-off actions, which depended, for their success, on proof of reputation with the public<sup>14</sup>. A grant of a monopoly under the statute simplified the costs and processes needed to protect a mark. However, significant concerns about granting a monopoly of the use of a word meant that trade marks were first admitted to registration in respect of goods in the United Kingdom on the strict condition that they consist of one or more "essential particulars"<sup>15</sup>. It quickly became clear that the "essential particulars", which confined the kinds of trade marks which were registrable, also operated to exclude certain distinctive marks from being properly included on the Register<sup>16</sup>. This led to substantial amendment and consolidation in the *Trade Marks Act 1905* (UK). Of particular relevance in that consolidation was a new s 9(5), which provided that distinctive marks other than those listed by reference to "essential particulars" could be deemed "distinctive" by the Board of Trade or the courts, provided that they satisfied a new condition – drawn from a new statutory definition of distinctiveness – that they be marks "adapted to distinguish". There was no reference to "inherent adaption" in s 9(5).

32 The 1905 Act, which was modelled on the *Patents, Designs, and Trade Marks Act 1883* (UK) (as amended by the *Patents, Designs, and Trade Marks Act 1888* (UK)), was amended in 1912<sup>17</sup> to follow the consolidation of trade mark law effected by the *Trade Marks Act 1905* (UK).

33 Following s 9 of the *Trade Marks Act 1905* (UK), s 16(1) of the 1905 Act<sup>18</sup> relevantly provided that a registrable trade mark must consist of:

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14 Underhay, *Kerly on Trade Marks*, 4th ed (1913) at 4-7. See also Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 2nd ed (1989) at 393-396 [15-002]-[15-006].

15 *Trade Marks Registration Act 1875* (UK), ss 2 and 10. Section 10 provided, among other things, that "essential particulars" included a "name of an individual" and "special and distinctive" words.

16 Underhay, *Kerly on Trade Marks*, 4th ed (1913) at 10.

17 By the *Trade Marks Act 1912* (Cth).

18 Later, s 24 of the 1955 Act.

9.

- "(a) ...
- (b) ...
- (c) An invented word or invented words<sup>[19]</sup>;
- (d) A word or words having no *direct* reference to the character or quality of the goods, and not being *according to its ordinary signification* a geographical name or a surname;
- (e) Any other distinctive mark [other than those which fell within the preceding paragraphs, if deemed distinctive by the Registrar, Law Officer or court]." (emphasis added)

34 Section 16(2) provided that "'distinctive' means adapted to distinguish the goods of the proprietor of the trade mark from those of other persons"<sup>20</sup>. To the extent that the meaning of a word needed to be determined for the purposes of registration, enquiries were conducted on the basis that Australia is an English speaking nation.

#### Relevant authorities

35 In the United Kingdom a trio of cases concerning the scope of the new s 9(5) of the *Trade Marks Act* 1905 (UK)<sup>21</sup> soon came before the Court of Appeal<sup>22</sup>. The enlargement of the category of registrable marks by reference to

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19 It is convenient to note that an "invented word" was considered registrable at the time, not as a reward to the proprietor, but because "its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases": *Eastman Photographic Materials Company v Comptroller-General of Patents, Designs, and Trade-marks* [1898] AC 571 at 581 per Lord Herschell ("the *Solio Case*").

20 Following s 9(5) of the *Trade Marks Act* 1905 (UK). In the 1955 Act the cognate provision was s 24(2).

21 Section 16(1) in the 1905 Act.

22 *In re Joseph Crosfield & Sons Ltd* [1910] 1 Ch 130 ("the *Perfection Case*"); *In re California Fig Syrup Company* [1910] 1 Ch 130 ("the *California Syrup of Figs Case*"); *In re H N Brock & Co Ltd* [1910] 1 Ch 130 ("the *Orlwoola Case*"). The Court of Appeal heard and determined the three cases together. In this judgment (Footnote continues on next page)

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the new statutory definition of distinctiveness stirred afresh familiar anxiety about the grant of a monopoly of the use of a word. Prefacing their statements as to the legal principles to apply to the new provisions, members of the Court of Appeal confirmed that the word "direct" had been added to the provisions governing registrability in order to permit the entry on the Register of words containing a skilful, covert or allusive reference to goods<sup>23</sup>. That addition gave statutory force to what had been said by Lord Macnaghten in the *Solio Case*<sup>24</sup>. It was also explained that the words "according to its ordinary signification" had been added to deal with the difficulty that a word may have an "ordinary signification" other than as a geographical name, even though it is also the name of a place somewhere<sup>25</sup>. Deeming a word having a direct reference to goods or a geographical name to be distinctive – a task now permitted under the new s 9(5) – was not to affect the bona fide use by other traders of a description of their goods or to cause confusion in view of their rights. The nature of the words or past use of them were the factors which "limited the possibility of other traders safely or honestly using the words"<sup>26</sup>.

36 After stating that "[w]ealthy traders are habitually eager to enclose part of the great common of the English language"<sup>27</sup> (which echoed their Lordships in the *Solio Case*), Cozens-Hardy MR explained why no monopoly could be granted under s 9(5) for laudatory epithets used as adjectives. Words such as "good" or "best" are incapable of developing a secondary meaning as indicating

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they are collectively referred to as "the *Perfection, California Syrup of Figs and Orwoola Cases*".

23 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 141 per Cozens-Hardy MR, 144-146 per Fletcher Moulton LJ.

24 [1898] AC 571 at 583. This was echoed later by Dixon CJ in *Mark Foy's Ltd v Davies Coop & Co Ltd* (1956) 95 CLR 190 at 195 ("*Mark Foy's*"); [1956] HCA 41.

25 As with the trade mark "MAGNOLIA": see *In re Magnolia Metal Company's Trade-marks* [1897] 2 Ch 371.

26 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 148 per Fletcher Moulton LJ.

27 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 141 per Cozens-Hardy MR.

only an applicant's goods<sup>28</sup>. Accordingly "Perfection" was not registrable as a trade mark for soap as it was a word which should be open to use by both other traders and members of the public<sup>29</sup>.

37 Equally, no monopoly could be granted to words consisting of geographical names if their "ordinary signification" described the place of the manufacture or sale of goods<sup>30</sup>. If, however, a geographical name was part of a composite mark, identified by long use as associated only with the goods of an applicant, it could be registered (as exemplified by "California Syrup of Figs" for an aperient medicine<sup>31</sup>).

38 No monopoly could be granted to trade marks which were merely phonetic equivalents of directly descriptive words, such as "Orlwoola" for textile fabrics<sup>32</sup>.

39 In explaining those disparate circumstances in which the "ordinary signification" of a word affected a grant of a monopoly of its use, their Lordships recognised that any word in English could *prima facie* be used as a trade mark but would not necessarily qualify to be registered as one. In drawing their conclusions in respect of the three trade marks under consideration, their Lordships indicated that the determination of whether a word has "direct reference" to goods (*prima facie* precluding a monopoly of its use) depends critically on the goods themselves, because a word containing a direct reference to goods in one trade may not convey any such direct reference to goods in

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28 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 141-142 per Cozens-Hardy MR.

29 *Perfection Case* [1910] 1 Ch 130 at 143 per Cozens-Hardy MR, 149 per Fletcher Moulton LJ, 153-154 per Farwell LJ.

30 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 141 per Cozens-Hardy MR. See also the *Solio Case* [1898] AC 571 at 574-575 per Earl of Halsbury LC.

31 *California Syrup of Figs Case* [1910] 1 Ch 130 at 143 per Cozens-Hardy MR, 150 per Fletcher Moulton LJ, 154 per Farwell LJ.

32 *Orwoola Case* [1910] 1 Ch 130 at 143-144 per Cozens-Hardy MR, 150 per Fletcher Moulton LJ, 154-155 per Farwell LJ.

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another trade<sup>33</sup>. An example given later was the use of the words "North Pole" for bananas<sup>34</sup>.

40 It was thus established early in the development of trade mark law in the United Kingdom that the "ordinary signification" of any word, or words, constituting a trade mark is important, whether a challenge to the registrability of a trade mark is based on the word having a laudatory or directly descriptive meaning, or on the word being, according to its "ordinary signification", a geographical name (or, in those times, a surname).

41 In *Du Cros*, Lord Parker's speech was also directed to s 9(5) of the *Trade Marks Act* 1905 (UK)<sup>35</sup>. Lord Parker was not dealing with a word but with two applications for registration of a trade mark consisting of two letters of the alphabet joined by an ampersand. The question was whether those marks were registrable under s 9(5), being "adapted to distinguish" certain goods, as letters of the alphabet were not included in the "essential particulars" in sub-ss (1), (2), (3) or (4) of s 9. Lord Parker said that the registrability of a trade mark as "distinctive" should<sup>36</sup>:

"largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods."

42 As Lord Parker explained when applying the principle (since much relied upon), even though a mark may have acquired some distinctiveness through use, a person should not be given a monopoly of letters of the alphabet, which other traders may legitimately desire to use because they have the same initials<sup>37</sup>.

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33 *Perfection, California Syrup of Figs and Orwoola Cases* [1910] 1 Ch 130 at 144, 150 per Fletcher Moulton LJ, 151, 154 per Farwell LJ.

34 *A Baily & Co Ltd v Clark, Son & Morland* [1938] AC 557 at 562 per Lord Maugham LC.

35 As already mentioned, like s 16(2) of the 1905 Act, s 9(5) did not speak of "inherent" adaption to distinguish but used only the phrase "adapted to distinguish".

36 *Du Cros* [1913] AC 624 at 635.

37 *Du Cros* [1913] AC 624 at 635-636. Another trader will not legitimately and honestly desire to use letters of the alphabet to describe their goods if the letters of  
(Footnote continues on next page)

43 Earlier that same year, a similar point had been made in respect of s 9(5) and the distinctiveness of a surname, which others may share and wish to use. In *In re R J Lea Ltd's Application*<sup>38</sup> ("*R J Lea*") Hamilton LJ said<sup>39</sup>:

"Further the Act says 'adapted to distinguish'; the mere proof or admission that a mark does in fact distinguish does not ipso facto compel the judge to deem that mark to be distinctive. It must be further 'adapted to distinguish,' which brings within the purview of his discretion the wider field of the interests of strangers and of the public."

44 The requirement that a proposed trade mark be examined from the point of view of the possible impairment of the rights of honest traders to do that which, apart from the grant of a monopoly, would be their natural mode of conducting business (Lord Parker), and from the wider point of view of the public (Hamilton LJ), has been applied to words proposed as trade marks for at least a century, irrespective of whether the words are English or foreign. The requirement has been adopted in numerous decisions of this Court dealing with words as trade marks under the 1905 Act and the 1955 Act<sup>40</sup>. Those decisions show that assessing the distinctiveness of a word commonly calls for an enquiry into the word's ordinary signification and whether or not it has acquired a secondary meaning.

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the alphabet have, through long use, come to distinguish only an applicant's goods, as occurred in *British Petroleum Co Ltd v European Petroleum Distributors Ltd* [1968] RPC 54.

38 [1913] 1 Ch 446.

39 [1913] 1 Ch 446 at 463.

40 *Thomson v B Seppelt & Sons Ltd* (1925) 37 CLR 305 at 312-313 per Isaacs J, 315 per Rich J; [1925] HCA 40; *Mangrovite Belting Ltd v J C Ludowici & Son Ltd* (1938) 61 CLR 149 at 160-161 per Rich J; [1938] HCA 67; *Mark Foy's* (1956) 95 CLR 190 at 201 per Williams J; *Clark Equipment* (1964) 111 CLR 511 at 513-515 per Kitto J; *F H Faulding & Co Ltd v Imperial Chemical Industries Ltd* (1965) 112 CLR 537 at 555-557 per Kitto J ("*Faulding*"); [1965] HCA 72; *Burger King Corporation v Registrar of Trade Marks* (1973) 128 CLR 417 at 425 per Gibbs J ("*Burger King*"); [1973] HCA 15.

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### Foreign words

45 Establishing the "ordinary signification" of a trade mark consisting of a word is just as critical if the word is to be found in a dictionary of a foreign language. This is particularly so when an objection to registrability is based on an assertion that the mark is not an invented word because it makes direct reference to the character or quality of the goods in question. The *Solio Case* concerned the registrability of "SOLIO" for photographic papers. It had been contended that "solio" (a word in Italian and Latin) was not an invented word and moreover was a word containing a "reference" to the goods<sup>41</sup>. Lord Macnaghten stated the principle to be applied to a word put forward as an invented word<sup>42</sup>:

"If [a word] is an invented word, if it is 'new and freshly coined' (to adapt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless."

46 That was followed by Parker J (as his Lordship then was) in *Philippart v William Whiteley Ltd*<sup>43</sup> ("the *Diabolo Case*") when he found a trade mark consisting of the Italian word "diabolo" unregistrable, because it applied to a well-known game in England called "the devil on two sticks", for which reason it could not be treated as an "invented word". Parker J explained<sup>44</sup>:

"To be an invented word, within the meaning of the Act, a word must not only be newly coined in the sense of not being already current in the English language, but must be such as not to convey any meaning, or at any rate any obvious meaning, to ordinary Englishmen."

47 In *Howard Auto-Cultivators Ltd v Webb Industries Pty Ltd*<sup>45</sup> ("Howard"), Dixon J stated what was required for a word to qualify as an invented word.

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41 *Solio Case* [1898] AC 571 at 572-573.

42 *Solio Case* [1898] AC 571 at 583.

43 [1908] 2 Ch 274.

44 [1908] 2 Ch 274 at 279.

45 (1946) 72 CLR 175; [1946] HCA 15.

Citing Lord Macnaghten in the *Solio Case*, his Honour said that although a word should be<sup>46</sup>:

"substantially different from any word in ordinary and common use ... [it] need not be wholly meaningless and it is not a disqualification 'that it may be traced to a foreign source or that it may contain a covert and skilful allusion to the character or quality of the goods.'"

48 These authorities show that it is not the meaning of a foreign word as translated which is critical, although it might be relevant. What is critical is the meaning conveyed by a foreign word to those who will be concerned with the relevant goods.

49 In *Kiku Trade Mark*<sup>47</sup>, the Supreme Court of Ireland approved Parker J's speech in the *Diabolo Case* and held that the Japanese word "kiku", meaning chrysanthemum, was registrable for perfume because the word had no "direct reference" to the character or quality of the goods<sup>48</sup>. The Court considered that a word which required translation could not be said to have any signification to ordinary people living in Ireland who see and hear it. That approach accords with Dixon J's statement of principle in *Howard*.

#### Words containing a reference to goods

50 The practical difference between a word making some "covert and skilful allusion" to the goods (prima facie registrable) and a word having a "direct reference" to goods (prima facie not registrable) is well illustrated in two Australian cases decided under the 1905 Act. Understanding the distinction is the key to resolving this appeal.

51 In *Howard*, this Court was considering whether a trade mark consisting of the word "rohoe" was registrable as an invented word in respect of agricultural implements<sup>49</sup>. Parker J's reference in the *Diabolo Case* to a word (in that case a foreign word) having an "obvious meaning" to "ordinary Englishmen" was

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46 (1946) 72 CLR 175 at 181. See also the examples from English authorities given by his Honour at 183.

47 [1978] FSR 246.

48 [1978] FSR 246 at 249-250.

49 Section 16(1)(c) of the 1905 Act.

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considered by Dixon J<sup>50</sup>. Because of the special nature of the goods to which "rohoe" was to be applied, Dixon J said the question was whether the word "rohoe" would appear as an obvious contraction of "rotary hoe" and be so understood by "a farmer, a horticulturist, a trader in agricultural and horticultural implements or a person otherwise concerned with them"<sup>51</sup>.

52 By comparison, in *Mark Foy's*, the trade mark "TUB HAPPY" was found registrable by a majority in this Court as a trade mark having no direct reference to the character or quality of cotton garments. In agreeing with Williams J, Dixon CJ described the test for a word having "direct reference to the character or quality of the goods"<sup>52</sup> as lying "in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess"<sup>53</sup>. His Honour considered "TUB HAPPY" to be allusive such that it did not convey a meaning or idea "sufficiently tangible" to amount to a "direct reference" to the character or quality of the goods<sup>54</sup>. Citing with approval Lord Macnaghten in the *Solio Case* and Parker J in the *Diabolo Case*, Williams J illustrated why a covert and skilful allusive reference to goods does not render a word directly descriptive of goods as that expression is used in trade mark law<sup>55</sup>. His Honour said the registration of "TUB HAPPY" for cotton goods did not prevent others from describing their cotton goods as having the characteristics or qualities of "washability, freshness and cheapness"<sup>56</sup>.

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50 (1946) 72 CLR 175 at 183.

51 (1946) 72 CLR 175 at 185.

52 1905 Act, s 16(1)(d) (subsequently the 1955 Act, s 24(1)(d)).

53 (1956) 95 CLR 190 at 195.

54 (1956) 95 CLR 190 at 195.

55 (1956) 95 CLR 190 at 201.

56 (1956) 95 CLR 190 at 201-202.

The provenance of "inherently adapted to distinguish" – s 41(3)

*United Kingdom*

53 In the United Kingdom the statutory conditions for registration of a trade mark were further liberalised by the introduction of Part B of the Register in 1919<sup>57</sup>. In essence, Part B was reserved for marks not considered registrable in Part A as "adapted to distinguish", but which were nevertheless "capable of distinguishing" an applicant's goods from those of other traders. At first the British courts struggled to articulate the difference<sup>58</sup>. The notion that a mark fully distinctive in fact might nevertheless not be "capable of distinguishing" in law was not easy to apply<sup>59</sup>. This led to an amended and more expansive statutory definition of "distinctiveness" by reference to whether a mark was "inherently adapted to distinguish", and by reference to whether a mark had acquired distinctiveness "by reason of ... use"<sup>60</sup>.

54 In *Smith Kline & French Laboratories Ltd v Sterling-Winthrop Group Ltd*<sup>61</sup>, Lord Diplock referred to that first appearance of the term "inherently adapted to distinguish" in s 9(3) of the *Trade Marks Act* 1938 (UK) (which influenced s 26(2) of the 1955 Act and which in turn influenced s 41(3) of the Act)<sup>62</sup>:

"[L]ong before the reference to inherent adaptability had been incorporated in the current statutes dealing with trade marks, it had been held upon grounds of public policy that a trader ought not to be allowed to obtain by registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use. The classic statement of this

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57 *Trade Marks Act* 1919 (UK).

58 See "*Weldmesh*" *Trade Mark* [1966] RPC 220 at 227 per Wilmer LJ. See also White and Jacob, *Kerly's Law of Trade Marks and Trade Names*, 11th ed (1983) at 120-122 [8-73]-[8-74].

59 See *In the Matter of an Application by Hans Lauritzen for the Registration of a Trade Mark* (1931) 48 RPC 392 at 397 per Eve J.

60 *Trade Marks Act* 1938 (UK), s 9(3).

61 [1975] 1 WLR 914; [1975] 2 All ER 578.

62 [1975] 1 WLR 914 at 921-922; [1975] 2 All ER 578 at 585-586.

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doctrine is to be found in the speech of Lord Parker in [*Du Cros*] ... The reference to 'inherently adapted' in s 9(3) of the Consolidation Act of 1938, which was first enacted in 1937, has always been treated as giving statutory expression to the doctrine as previously stated by Lord Parker."

#### *Australia*

55 In Australia, the 1955 Act again followed legislation in the United Kingdom by instituting a Part B of the Register for marks "capable of becoming distinctive" of an applicant's goods (being the provisions of immediate concern in *Clark Equipment* and *Burger King*). The institution of Part B provided the context for the inclusion of the expanded definition of "distinctiveness" in s 26(1) and (2) extracted above. As explained by Gibbs J in *Burger King*, although the concepts and statutory language concerning Part B followed the United Kingdom, the drafting of those provisions differed<sup>63</sup>.

#### *"Ordinary signification" and "inherently adapted to distinguish"*

56 In *Faulding*, this Court considered whether the registered trade mark "BARRIER", for skin creams which protected against industrial dermatitis, should be removed from the Register because the word directly described the character or quality of the goods. In the context of the general principle stated by Lord Parker in *Du Cros*, Kitto J said that, but for the evidence, it might have been supposed that the word "barrier" was not a word which others might wish to use in respect of the goods. However, the evidence showed that persons concerned with skin creams – persons in industry, pharmacists and other persons (ie not just rival traders) – were all persons who might have a "need for a word ['barrier'] to describe succinctly and yet exactly the essential characteristic of protection which distinguishes the whole of the relevant class of creams"<sup>64</sup>. Kitto J went on to explain the facts and the relevance of an enquiry into the ordinary signification of a word when deciding whether a monopoly of the use of a word granted under trade marks legislation should be withdrawn<sup>65</sup>:

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<sup>63</sup> (1973) 128 CLR 417 at 424-425. See also *Chancellor, Masters and Scholars of the University of Oxford v Registrar of Trade Marks* (1990) 24 FCR 1 at 22-25 per Gummow J.

<sup>64</sup> (1965) 112 CLR 537 at 555.

<sup>65</sup> (1965) 112 CLR 537 at 556-557.

"[A]t least by the year of the initial registration of the appellant's trade mark (1943) the word Barrier had caught on as a word peculiarly apt, according to its ordinary signification, for descriptive use in connexion with skin protective creams, so that any trader in such creams would be very likely indeed, in the ordinary course of business and without any improper motive, to desire to use the word in order to distinguish such creams in general from creams intended for other purposes ... What matters is that at all material times the word has had such a place in the vocabulary of persons concerned with skin protective creams that according to the principle which must be applied under the *Trade Marks Acts* the appellant cannot be allowed a monopoly of its use in connexion with such creams."

57 In *Clark Equipment*, Kitto J considered for the purposes of registration in Part B the word "Michigan", which had acquired distinctiveness through 20 years of use in respect of the applicant's goods despite the fact that it was a geographical name of a State in America. After approving Lord Parker's test in *Du Cros* and Hamilton LJ's observation in *R J Lea*, his Honour explained that directly descriptive words, like geographical names, are not prima facie suitable for the grant of a monopoly because use of them as trade marks will rarely eclipse their "primary" (that is, ordinary) signification<sup>66</sup>. Such a word, his Honour said, "is plainly not inherently, ie in its own nature, adapted to distinguish the applicant's goods"<sup>67</sup>. Traders may legitimately want to use such words in connection with their goods because of the reference they are "inherently adapted to make" to those goods<sup>68</sup>. Kitto J's elaboration of the principle, derived from Lord Parker's speech in *Du Cros*, applies with as much force to directly descriptive words as it does to words which are, according to their ordinary signification, geographical names.

58 In *Burger King*, Gibbs J applied Kitto J's test to a directly descriptive word when his Honour declined to find "WHOPPER" registrable in Part B in respect of hamburgers. His Honour explained that "whopper" is not "inherently adapted" to distinguish hamburgers because it is an ordinary English word, apt to describe a characteristic of hamburgers, namely their size, and moreover could be used in a laudatory sense<sup>69</sup>. It is because of the ordinary signification or meaning

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66 (1964) 111 CLR 511 at 515.

67 (1964) 111 CLR 511 at 515.

68 (1964) 111 CLR 511 at 515.

69 (1973) 128 CLR 417 at 425.

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of the word "whopper" to anyone concerned with hamburgers that a rival trader might, without improper motive, desire to use "whopper" to describe that trader's hamburgers.

59 The principles settled by this Court (and the United Kingdom authorities found in this Court to be persuasive) require that a foreign word be examined from the point of view of the possible impairment of the rights of honest traders and from the point of view of the public. It is the "ordinary signification" of the word, in Australia, to persons who will purchase, consume or trade in the goods which permits a conclusion to be drawn as to whether the word contains a "direct reference" to the relevant goods (prima facie not registrable) or makes a "covert and skilful allusion" to the relevant goods (prima facie registrable). When the "other traders" test from *Du Cros* is applied to a word (other than a geographical name or a surname), the test refers to the legitimate desire of other traders to use a word which is directly descriptive in respect of the same or similar goods. The test does not encompass the desire of other traders to use words which in relation to the goods are allusive or metaphorical. In relation to a word mark, English or foreign, "inherent adaption to distinguish" requires examination of the word itself, in the context of its proposed application to particular goods in Australia.

The proceedings below

*The primary judge*

60 Before the primary judge, in reliance on s 41(3) of the Act, Modena contended that "oro" and "cinque stelle" were words that other traders might, without improper motive, wish to use as "varietal indicators on their Italian-style coffee products", and that the word "oro" was already used in Australia in relation to coffee by other traders<sup>70</sup>. It was submitted that the words were not distinctive at their respective filing dates, and that the evidence indicated the words were commonplace in marketing generally, and particularly in relation to Italian-style coffee, in Australia. Thus it was said that the words were directly descriptive of characteristics of Cantarella's goods and that they had acquired no secondary meaning – that is, distinctiveness – in respect of Cantarella's goods.

61 In rejecting those arguments, the primary judge held that Cantarella's trade marks were distinctive, following authorities in this Court. The primary judge then considered the number of Italian speakers in Australia, and the degree to

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<sup>70</sup> *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 773 [103].

which the words "oro" and "cinque stelle" are understood in Australia. His Honour concluded that only a "very small minority" of English speakers in Australia would understand the meaning of the words, and that the Italian language is not "so widely spread" that the words would be generally understood as meaning "gold" and "five stars" respectively<sup>71</sup>. His Honour concluded that Cantarella's trade marks "ORO" and "CINQUE STELLE" are sufficiently inherently adapted to distinguish the goods of Cantarella from the goods of other persons<sup>72</sup>. The primary judge found that Modena had infringed Cantarella's trade marks, made orders to that effect, and dismissed Modena's cross-claim<sup>73</sup>.

*Full Court*

62 The Full Court overturned the decision of the primary judge, holding that Cantarella's trade marks "ORO" and "CINQUE STELLE" should be cancelled and removed from the Register pursuant to s 88 of the Act<sup>74</sup>.

63 The Full Court considered, correctly, that the applicable principle to apply, in interpreting s 41(3), had been stated by Kitto J in *Clark Equipment*. However, their Honours considered that the passage italicised above was a broad guiding principle, "not to be applied as though it were a statute"<sup>75</sup>. The Full Court considered that, in interpreting s 41(3), the primary judge had not applied the correct test and had fallen into error<sup>76</sup>. Their Honours said that Kitto J's references in *Clark Equipment* to the "common right of the public" and the "common heritage" are "fluid and their content will vary according to the

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71 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 776 [117].

72 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 776 [118].

73 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 790 [196]-[198].

74 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 33-34 [106].

75 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 28 [71]-[72].

76 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 24 [49].

French CJ  
Hayne J  
Crennan J  
Kiefel J

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particular case"<sup>77</sup> and interpreted Kitto J's reference to the "common right of the public" as referring to "members of the public who are or may become traders"<sup>78</sup>. Rejecting an "Anglocentric perspective" and having considered *Clark Equipment* as explained, the Full Court said of Cantarella's trade marks "ORO" and "CINQUE STELLE" that "[t]he words in Italian are entirely descriptive of their quality as premium coffee products"<sup>79</sup> and that it was "unnecessary ... that consumers know what the words mean in English" because the "common heritage" included "traders in coffee products sourced from Italy"<sup>80</sup>.

64 Then the Full Court turned to the factual issue of "distinctiveness" and stated that "in judging the likelihood of what traders may wish to do, it is relevant to know whether or not other traders have also used the words"<sup>81</sup>. As to the evidence, the Full Court considered that "oro" and "cinque stelle" were Italian words signifying the highest quality, that other coffee traders had used the words "according to their ordinary signification as words descriptive of the quality of the coffee products" and that they "have been used in that sense, although not as trade marks, for a significant period of time extending well before Cantarella's registration of its marks and afterwards"<sup>82</sup>.

### Submissions

#### *Cantarella*

65 On the appeal in this Court, Cantarella submitted that the primary judge approached the question of the meaning of Cantarella's trade marks "ORO" and "CINQUE STELLE" correctly, in the light of settled authority in which this

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77 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 30-31 [84].

78 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 29-30 [80].

79 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 31 [85], [87].

80 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 31 [85], [88].

81 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 31 [87].

82 *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 32 [97].

Court has approved Lord Parker's speech in *Du Cros* and interpreted relevant provisions (prior to s 41(3))<sup>83</sup>.

66 It was also submitted that the Full Court erred in assessing the inherent adaptability to distinguish of "ORO" and "CINQUE STELLE" by focussing on them as Italian words, as they occurred in disparate composite marks in the relevant trade (including two prior registered trade marks, one of which belonged to Cantarella), rather than determining how the words would be understood in Australia by the target audience.

67 Cantarella submitted that assessing whether a foreign word is inherently adapted to distinguish is no different from assessing any word in English, including invented words, for the same purpose. The first step is to ask what is the ordinary signification (ie the ordinary meaning) of a word. The second step is to test the likelihood that honest traders may wish to use the word in connection with their goods because of its ordinary meaning.

#### *Modena*

68 Modena sought to uphold the Full Court's reasoning by contending that the "inherent adaptability to distinguish" of a word, proposed as a trade mark, is not to be tested by whether the word has an "ordinary signification" or "ordinary meaning" or "a meaning to ordinary people". Relying particularly on Lord Parker's speech in *Du Cros*, Modena contended that the test is confined to whether other traders would be at least likely, in the ordinary course of their business and without any improper motive, to desire to use the word in connection with a particular product.

69 It was submitted that the evidence available at trial proved that it was not just likely but certain that rival traders would want to use "oro" and "cinque stelle" in connection with coffee. This was said to reflect the circumstance that Australia has large ethnic populations such that rival traders will readily want to use "oro" and "cinque stelle" in connection with coffee products because they understand Italian or because they may be importers of Italian coffee, or because they routinely use those words in connection with such products.

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83 *Clark Equipment* (1964) 111 CLR 511 at 513-515 per Kitto J. See also *Mark Foy's* (1956) 95 CLR 190 at 194-195 per Dixon CJ; *Faulding* (1965) 112 CLR 537 at 554-556 per Kitto J; *Burger King* (1973) 128 CLR 417 at 424-425 per Gibbs J.

French CJ  
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Kiefel J

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Interpretation of s 41(3)

70 In accordance with the principles established in *Mark Foy's* and restated in *Clark Equipment, Faulding* and *Burger King*, determining whether a trade mark is "inherently adapted to distinguish", as required by s 41(3), requires consideration of the "ordinary signification" of the words proposed as trade marks to any person in Australia concerned with the goods to which the proposed trade mark is to be applied.

71 As shown by the authorities in this Court, the consideration of the "ordinary signification" of any word or words (English or foreign) which constitute a trade mark is crucial, whether (as here) a trade mark consisting of such a word or words is alleged not to be registrable because it is not an invented word and it has "direct" reference to the character and quality of goods<sup>84</sup>, or because it is a laudatory epithet<sup>85</sup> or a geographical name<sup>86</sup>, or because it is a surname<sup>87</sup>, or because it has lost its distinctiveness<sup>88</sup>, or because it never had the requisite distinctiveness to start with<sup>89</sup>. Once the "ordinary signification" of a word, English or foreign, is established an enquiry can then be made into whether other traders might legitimately need to use the word in respect of their goods. If a foreign word contains an allusive reference to the relevant goods it is prima facie qualified for the grant of a monopoly<sup>90</sup>. However, if the foreign word is understood by the target audience as having a directly descriptive meaning in relation to the relevant goods, then prima facie the proprietor is not entitled to a

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84 *Howard* (1946) 72 CLR 175; *Faulding* (1965) 112 CLR 537.

85 *Burger King* (1973) 128 CLR 417.

86 *Thomson v B Seppelt & Sons Ltd* (1925) 37 CLR 305; *Clark Equipment* (1964) 111 CLR 511. See also *Chancellor, Masters and Scholars of the University of Oxford v Registrar of Trade Marks* (1990) 24 FCR 1.

87 *Mangrovite Belting Ltd v J C Ludowici & Son Ltd* (1938) 61 CLR 149.

88 *James A Jobling & Co Ltd v James McEwan & Co Pty Ltd* [1933] VLR 168.

89 *Faulding* (1965) 112 CLR 537.

90 *Howard* (1946) 72 CLR 175 and *Mark Foy's* (1956) 95 CLR 190 approving the *Solio Case* [1898] AC 571.

monopoly of it<sup>91</sup>. Speaking generally, words which are prima facie entitled to a monopoly secured by registration are inherently adapted to distinguish.

Application of s 41(3)

72 Because coffee is a commodity and a familiar beverage consumed by many, the consideration of the "ordinary signification" of the words "oro" and "cinque stelle" in Australia undertaken by the primary judge accorded with settled principles. The Full Court's rejection of what it called an "Anglocentric" approach revealed a misunderstanding of the expression "ordinary signification" as it has been used in Australia (and the United Kingdom) since at least 1905 to test the registrability of a trade mark consisting of a word or words, English or foreign.

73 Both Modena in argument and the Full Court in its reasons misunderstood Lord Parker's reference in *Du Cros* to the desire of other traders to use the same or similar mark in respect of their goods. Lord Parker was not referring to the desire of traders to use words, English or foreign, which convey an allusive or metaphorical meaning in respect of certain goods. What Lord Parker's "other traders" test means in practice is well illustrated by the fate of the marks considered in *Faulding*, *Clark Equipment* and *Burger King*. Like "TUB HAPPY" in respect of cotton goods, "ORO" and "CINQUE STELLE" were not shown to convey a meaning or idea sufficiently tangible to anyone in Australia concerned with coffee goods as to be words having a direct reference to the character or quality of the goods.

74 The evidence, relied on by Modena at trial, did not show that "ORO" and "CINQUE STELLE" should not be registered as trade marks (and should be removed from the Register as trade marks) because their registration would preclude honest rival traders from having words available to describe their coffee products either as Italian coffee products or as premium coffee products or as premium blend coffee products.

75 The evidence led by Modena purporting to show that rival traders used (or desired to use) the word "oro" to directly describe their coffee products showed no more than that the word "oro" or the form "d'oro" had been employed on internet sites and coffee product packaging in respect of coffee products in a range of composite marks featuring Italian words which ostensibly were

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91 *Howard* (1946) 72 CLR 175 and *Mark Foy's* (1956) 95 CLR 190 approving the *Diabolo Case* [1908] 2 Ch 274.

*French CJ*  
*Hayne J*  
*Crennan J*  
*Kiefel J*

26.

distinguishable aurally, visually and semantically. Further, the presence on the Register, before Cantarella's trade mark "ORO" was registered, of another proprietor's composite mark "LAVAZZA QUALITA ORO plus device" and Cantarella's own composite mark "MEDAGLIA D'ORO" in respect of coffee products fell well short of proving that the word "oro", standing alone, is understood in Australia by persons concerned with coffee products to be directly descriptive of the character or quality of such goods.

76 The evidence led by Modena to show that some traders in Australia used the expression "five star" on packaging of coffee and many traders used "five star" in respect of a range of services including restaurant and accommodation services also fell well short of proving that "cinque stelle" is understood in Australia by persons concerned with coffee products to be directly descriptive of the character or quality of such goods.

77 Modena's complaint that the primary judge insufficiently considered the desires of rival traders to use the words "oro" or "cinque stelle" to directly describe their coffee goods was premised on a misconception that such was demonstrated by the evidence. The primary judge was right to reject Modena's submission, based on the evidence, that honest traders might legitimately wish to use the words to directly describe, or indicate, the character or quality of their goods.

### Conclusion

78 For the reasons given, Cantarella's registered trade marks "ORO" and "CINQUE STELLE" are inherently adapted to distinguish the goods for which they are registered from the goods of other persons.

### Orders

79 Orders should be made as follows:

1. Appeal allowed with costs.
2. Set aside the orders of the Full Court of the Federal Court of Australia made on 30 September 2013 and, in their place, order that the appeal to that Court be dismissed with costs.

80 GAGELER J. Agreeing with the Full Court of the Federal Court's construction and application of s 41 of the *Trade Marks Act 1995* (Cth) ("the Act"), I would dismiss the appeal.

### Construction

81 Part of the design of the Act was to implement Australia's obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS"), which forms Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization ("the WTO"), done at Marrakesh on 15 April 1994. Article 15.1 of TRIPS provides:

"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs ... shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use."

Article 1.1 of TRIPS provides that Members of the WTO "shall be free to determine the appropriate method of implementing the provisions of [TRIPS] within their own legal system and practice".

82 The Act tracks the language of Art 15.1 of TRIPS in defining a "trade mark", in s 17, in terms of a "sign" and requiring, in s 41, rejection of an application for a trade mark that is not "capable of distinguishing" the applicant's goods or services from the goods or services of other persons.

83 Giving content to the expression "capable of distinguishing", however, the Act departs from the language of Art 15.1 of TRIPS in favour of language drawn from earlier Australian trade mark legislation. That departure is deliberate. The language chosen has a long history and long before 1995 had acquired a stable meaning. The Working Party, acceptance of whose recommendation by the Australian Government led to the introduction of s 41<sup>92</sup>, stated that it had "no intention of changing the current concept of distinctiveness as measured by existing provisions"<sup>93</sup>.

84 The extent to which a trade mark is "inherently adapted to distinguish" – the language of s 41 – is the language of s 26(2)(a) of the *Trade Marks Act 1955*

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92 Australia, House of Representatives, *Parliamentary Debates* (Hansard), 27 September 1995 at 1910.

93 Working Party to Review the Trade Marks Legislation, *Recommended Changes to the Australian Trade Marks Legislation*, (1992) at 43.

(Cth) ("the 1955 Act"). That language of the 1955 Act originated in s 9(3) of the *Trade Marks Act 1938* (UK) ("the 1938 UK Act"). There it had "always been treated as giving statutory expression" to the "public policy" "that a trader ought not to be allowed to obtain by registration ... a monopoly in what other traders may legitimately desire to use"<sup>94</sup>.

85 The public policy expressed in the speech of Lord Parker of Waddington in *Registrar of Trade Marks v W & G Du Cros Ltd*<sup>95</sup> was articulated in the context of addressing the meaning of "adapted to distinguish" in s 9(5) of the *Trade Marks Act 1905* (UK). It was captured by Isaacs J addressing, in *Thomson v B Seppelt & Sons Ltd*, the meaning of the same words in s 16(2) of the *Trade Marks Act 1905* (Cth) ("the 1905 Act")<sup>96</sup>:

"The statutory criterion looks wholly to the future, and seeks to know 'What will be the effect of the mark after registration?' Is it adapted in future trade to distinguish the proprietor's goods from those of other persons? That, however, does not mean 'is the word adapted to acquire distinctiveness?' but 'is the word instantly adapted to distinguish the proprietor's goods in his future trade?' ... That must in all fairness be so, because otherwise it would be enlisting registration itself as an aid in making a mark actually distinctive, and so preventing partly by statutory assistance other traders from using the mark if they so desired."

86 The public policy gave rise to a legal discrimen which was given succinct authoritative expression in *F H Faulding & Co Ltd v Imperial Chemical Industries Ltd*<sup>97</sup>. Again addressing the meaning of the words "adapted to distinguish" in s 16(2) of the 1905 Act, Kitto J (with whom Barwick CJ and Windeyer J agreed) said<sup>98</sup>:

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94 *Chancellor, Masters and Scholars of the University of Oxford (trading as Oxford University Press) v Registrar of Trade Marks* (1990) 24 FCR 1 at 17, quoting *Smith Kline & French Laboratories Ltd v Sterling-Winthrop Group Ltd* [1975] 1 WLR 914 at 921-922; [1975] 2 All ER 578 at 585-586.

95 [1913] AC 624 at 634-635.

96 (1925) 37 CLR 305 at 312; [1925] HCA 40. See also *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285 at 332-333; [1965] HCA 71.

97 (1965) 112 CLR 537; [1965] HCA 72.

98 (1965) 112 CLR 537 at 555.

"[T]he question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one which other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use upon or in connexion with their goods".

His Honour's reasoning in that case demonstrated that actual use of the word by other traders before and after registration may be logically probative of that question<sup>99</sup>. Yet it also emphasised that application of the test was separate from and anterior to any question as to whether or not another particular trader may have begun to use the word with a view to appropriating an applicant's reputation<sup>100</sup>.

87 The content of the test expressed in *F H Faulding* is illustrated by three decisions of individual judges upholding decisions of the Registrar of Trade Marks to refuse registration of a word as a trade mark in the application of s 26(2)(a) of the 1955 Act.

88 The first decision, of Kitto J in *Clark Equipment Co v Registrar of Trade Marks*<sup>101</sup>, is that with which the test has come commonly to be associated. Kitto J upheld a decision to refuse registration of "MICHIGAN" as a trade mark in respect of earth-moving equipment. Whether a trade mark was to any extent "inherently adapted to distinguish", Kitto J explained, was to be tested by reference to<sup>102</sup>:

"the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it."

There was no evidence in *Clark Equipment* that any other manufacturer produced similar goods in Michigan. There was evidence that the applicant had registered the word as a trade mark in the United States. The effect of that registration, Kitto J was prepared to assume, was that no other manufacturer of earth-moving

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99 (1965) 112 CLR 537 at 555-556.

100 (1965) 112 CLR 537 at 556-557.

101 (1964) 111 CLR 511; [1964] HCA 55.

102 (1964) 111 CLR 511 at 514.

equipment was free to use the word as a trade mark for its goods in that country<sup>103</sup>. Yet Kitto J found it "impossible to conclude that there [was] no likelihood of other traders, in the ordinary course of their businesses and without any desire to get for themselves a benefit from the [applicant's] reputation, wishing in advertisements and otherwise to describe (eg) their power cranes from Michigan as Michigan power cranes"<sup>104</sup>. Traders "may well wish by such means to take legitimate advantage of a reputation which they believe or hope that the State of Michigan possesses among Australians for the quality of its manufacturing products, and it would be contrary to fundamental principle to grant a registration which would have the effect of denying them the right to do so by using the name of the State"<sup>105</sup>.

89 The fundamental principle to which Kitto J referred was later articulated by Gummow J when he said<sup>106</sup>:

"The point is if goods of the kind in question are produced at the particular place or in the area, or if it is reasonable to suppose that such goods in the future will be produced there, other traders have a legitimate interest in using the geographical name to identify their goods, and it is this interest which is not to be supplanted by permitting any one trader to effect trade mark registration".

90 The second decision was that of Gibbs J in *Burger King Corporation v Registrar of Trade Marks*<sup>107</sup>, upholding a decision to refuse registration of "WHOPPER" as a trade mark in respect of goods described as a "hamburger sandwich". Citing *Clark Equipment*, Gibbs J said that "[i]nherent adaptability is something which depends on the nature of the trade mark itself" and which "cannot be changed by use or otherwise"<sup>108</sup>. "Whopper", Gibbs J found, was not inherently adapted to distinguish the goods of a particular trader. It was rather a word "which a person selling a hamburger sandwich which he claimed to be

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103 (1964) 111 CLR 511 at 516.

104 (1964) 111 CLR 511 at 516-517.

105 (1964) 111 CLR 511 at 517.

106 *Chancellor, Masters and Scholars of the University of Oxford (trading as Oxford University Press) v Registrar of Trade Marks* (1990) 24 FCR 1 at 23.

107 (1973) 128 CLR 417; [1973] HCA 15.

108 (1973) 128 CLR 417 at 424.

larger than that normally sold might use in the ordinary course of business and without any improper motive"<sup>109</sup>.

91 The third decision was that of Rogers J in the Supreme Court of New South Wales in *Eutectic Corporation v Registrar of Trade Marks*<sup>110</sup>, upholding decisions to refuse registration of "Eutectic" in respect of goods (comprising chemical substances, metals and alloys, machines and tools, and electrical apparatus and instruments) for welding, soldering and brazing. "Eutectic" is an English word meaning "melting at low temperature" or "melting readily". It was not in ordinary use by members of the community; most users of the applicant's goods did not know, or had forgotten, its meaning; and there was no evidence of its use by other traders. It was, however, "a basic term used in metallurgy"<sup>111</sup>, peculiarly appropriate to convey readiness to melt as a basic property of an alloy<sup>112</sup>. Refusing to conclude that "eutectic" was inherently adapted to distinguish the applicant's goods, and citing *Clark Equipment*, Rogers J said that "[w]hilstsoever there remains a need and use for that word by other traders in an honest description of their goods and the word retains its primary and technical meaning, it should remain free in the public domain"<sup>113</sup>.

92 The decisions together illustrate that the focus of the test imported by the words "inherently adapted to distinguish", now in s 41 of the Act, is on the extent to which the monopoly granted on registration of a trade mark would foreclose options otherwise available to rival traders acting in the ordinary course of their businesses without any desire to benefit from the applicant's reputation. The monopoly, relevantly, is that now granted to the registered owner of a trade mark by s 20(1) of the Act: the exclusive rights to use the trade mark and to authorise other persons to use the trade mark in relation to the goods or services in respect of which the trade mark is registered. Neither the test nor its application is affected by s 122(1)(b) of the Act, which provides a defence to an action for infringement of the trade mark to a person who uses a sign in good faith to indicate either "the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services" or "the time of production of goods or of the rendering of services". That is made clear by a Note to s 41, which states that "[t]rade marks that are not inherently adapted to distinguish goods or services are *mostly* trade marks that consist wholly of a sign

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109 (1973) 128 CLR 417 at 425.

110 (1980) 32 ALR 211.

111 (1980) 32 ALR 211 at 214.

112 (1980) 32 ALR 211 at 219.

113 (1980) 32 ALR 211 at 220.

that is ordinarily used to indicate" the precise indications to which s 122(1)(b) refers (emphasis added).

93 None of the three decisions concerned an attempt to register a mark comprising a word shown to have an ordinary meaning in a language other than English. There is no reason, however, why the test should operate differently in relation to a mark of that kind. The parenthetic reference by Kitto J in *Clark Equipment* to a trader acting in the exercise of "the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess" must in that respect be understood in the context of that case, dealing as it did with a foreign place name. Plainly, his Honour's attention was not confined to traders located in Australia. Equally plainly, his Honour's reference to words forming part of the common heritage was not confined to ordinary English words.

94 The three decisions also illustrate that the *FH Faulding* test is not exhausted by an inquiry into the intrinsic capacity of a word or other sign to acquire connotations which would in fact distinguish the goods or services of an applicant for registration from the goods or services of rival traders. *Eutectic Corporation*, in particular, illustrates that the test is not exhausted by an inquiry into how the mark might be expected to be understood in Australia by "ordinary persons" or by actual or potential purchasers of goods or services of the relevant kind. The relevant perspective is, rather, that of another trader, located in Australia or elsewhere, who might desire to use the word or other sign in the ordinary course of its business.

95 To place the *FH Faulding* test in context as applied in those cases, it is necessary to recognise that distinctiveness (of which inherent adaptedness to distinguish was made an element by s 26(2)(a)) was prescribed as one of a number of criteria qualifying a mark for registration as a trade mark under the 1955 Act. Another criterion, stated in s 24(1)(d), was that a mark consisted of "a word not having direct reference to the character or quality of the goods in respect of which registration [was] sought and not being, according to its ordinary meaning, a geographical name or a surname". That other criterion, as then appearing in substantially identical terms in s 16(1)(d) of the 1905 Act, was considered in *Mark Foy's Ltd v Davies Coop & Co Ltd* ("*Tub Happy*")<sup>114</sup>. Dixon CJ in *Tub Happy* explained that the test for determining whether or not a word had direct reference to the character or quality of goods "must lie in the probability of ordinary persons understanding the words, in their application to

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114 (1956) 95 CLR 190; [1956] HCA 41.

the goods, as describing or indicating or calling to mind either their nature or some attribute they possess"<sup>115</sup>.

96 *Tub Happy* was in turn considered in *Registrar of Trade Marks v Muller*<sup>116</sup>. The Full Court of the High Court there construed s 24(1)(d) of the 1955 Act to "connote that which is distinctive" as an additional requirement for registration<sup>117</sup>. On that basis, "LESS" was held properly to have been refused registration under s 24(1)(d) as a trade mark in respect of pharmaceutical products for two distinct reasons: first (the Full Court expressly applying the *Tub Happy* test) because it would be understood by the public as a representation about the ingredients or strength of those products<sup>118</sup>; and secondly (the Full Court accepting a submission which implicitly applied the *F H Faulding* test) because it was not adapted to distinguish the applicant's products<sup>119</sup>, in that other traders would foreseeably wish to use the word in association with their own products in a perfectly legitimate way<sup>120</sup>.

97 How the *Tub Happy* test might have applied under the 1955 Act to a word shown to have an ordinary meaning in a language other than English does not appear to have arisen for consideration in any Australian court, and need not now be considered. Nor is it necessary to consider the accuracy of a suggestion that judicial application of the same criterion under the 1938 UK Act implicitly adopted principles similar to the United States' "doctrine of foreign equivalents", under which words from common modern languages were translated into English in order to determine whether a mark was disqualified from registration because it was generic or descriptive<sup>121</sup>.

98 What is significant for present purposes is that a conclusion, based on the application of the *Tub Happy* test, that a word does not have direct reference to

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115 (1956) 95 CLR 190 at 195.

116 (1980) 144 CLR 37; [1980] HCA 35.

117 (1980) 144 CLR 37 at 44, approving *In re Fanfold Ltd's Application* (1928) 45 RPC 199 at 203-204.

118 (1980) 144 CLR 37 at 40-41.

119 (1980) 144 CLR 37 at 41-44.

120 (1980) 144 CLR 37 at 38. See also *Eutectic Corporation v Registrar of Trade Marks* (1980) 32 ALR 211 at 218.

121 Gredley, "Foreign-language Words as Trade Marks", in Dawson and Firth (eds), *Trade Marks Retrospective*, (2000) 85 at 85.

the character or quality of goods or services, is not itself a conclusion that the word is inherently adapted to distinguish the goods or services of the applicant from the goods or services of other persons. In the case of an ordinary English word, the considerations affecting each conclusion will often be similar. In the case of a technical word or a word in another language, other considerations will almost certainly arise.

99 Here the primary judge, citing *F H Faulding*, said<sup>122</sup>:

"The question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one that other traders are likely, in the ordinary course of their businesses, and without any improper motive, to desire to use upon or in connection with their goods".

Later, citing *Tub Happy*, his Honour said<sup>123</sup>:

"The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing, indicating or calling to mind either their nature or some attribute they possess".

His Honour was not persuaded "that the Italian language is so widely spread that the conclusion should be drawn that *Cinque Stelle* and *Oro* would be generally understood in Australia" to mean "five stars" and "gold" respectively<sup>124</sup>. His conclusion, expressed in terms of the *Tub Happy* test, was that "the Italian words are not so obvious to ordinary English speaking persons in Australia that *Cinque Stelle* and *Oro* have a specific meaning"<sup>125</sup>.

100 The Full Court held that his Honour erred in equating the *F H Faulding* test with the *Tub Happy* test, and in applying the latter to the exclusion of the

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122 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 761 [28].

123 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 774 [107].

124 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 776 [117].

125 *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 776 [118].

former<sup>126</sup>. That conclusion was correct. The central contention of the appellant ("Cantarella") in this Court is that the two tests are the same. They are not.

### Application

101 The Full Court went on itself to apply the *FH Faulding* test. Foreshadowing the analysis in which it engaged, the Full Court explained<sup>127</sup>:

"There is no necessity to approach the enquiry from an Anglocentric perspective in the Australian context which has rich cultural and ethnic diversities within its population. Adopting the language of Kitto J, to accommodate this reality in the marketplace, one may consider the relevant words against the collective diverse heritage. Viewed in that way, the 'common heritage' here included that of traders in coffee products sourced from Italy. Such traders may well be Italian or local importers. They may be local distributors who have in mind the large Italian speaking population in Australia as well as other Australians who, when it comes to coffee, want something with an Italian look and feel. Much of this country's coffee heritage in its language has its provenance in the Italian language eg caffè latte; cappuccino; affogato; caffè machiatto and espresso. It is evident that pure coffee in Australia is often associated with Italy and Italian coffee products."

102 The Full Court stated its conclusion to be that "other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the *Oro* and *Cinque Stelle* marks, or some mark nearly resembling them, upon or in connection with their own coffee-related goods". That conclusion, the Full Court explained, was based on the cumulative effect of a number of considerations which it went on to enumerate<sup>128</sup>.

103 The first consideration which the Full Court identified as underlying its conclusion was that the words, in Italian, signify quality. Another was that pure coffee in Australia is associated with Italy, with the result that it is obvious to use Italian words to describe the quality of coffee. Another was that the Australian pure coffee market includes imported coffee products that are roasted and packaged in Italy and sold in Australia. Another was that there are many Italian speakers in Australia. Indeed, the 2001 census revealed that Italian was then the second most spoken language in Australia, spoken at home by more than 350,000

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<sup>126</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 24 [44]-[49].

<sup>127</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 31 [85].

<sup>128</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 32 [91].

people. Another was that Cantarella itself used the words according to their ordinary significance to describe its highest quality coffee blends<sup>129</sup>.

104 "Finally, and most importantly", said the Full Court, "other coffee traders" had used *Oro* and *Cinque Stelle* before Cantarella applied to have them registered as trade marks on 24 March 2000 and on 6 June 2001 respectively. The findings of the primary judge, it said, supported the conclusion that "these Italian words were known in the coffee trade according to their ordinary signification as words descriptive of the quality of the coffee products and have been used in that sense, although not as trade marks, for a significant period of time extending well before Cantarella's registration of its marks and afterwards". The fact that other coffee traders had so used the words in the past was an indication that other coffee traders might wish to make similar use of the words in the future<sup>130</sup>.

105 Having found that *Oro* and *Cinque Stelle* were not inherently adapted to distinguish the goods of one coffee trader from the goods of another, the Full Court went on to find that the use of those words by Cantarella was not use as a trade mark<sup>131</sup>.

106 Cantarella's challenge to the conclusion of the Full Court is not limited to challenging the correctness of the test applied by the Full Court.

107 Cantarella criticises the Full Court for giving consideration to Cantarella's own post-registration use of its trade marks. There is no force in that criticism. The primary judge found that Cantarella's own use of *Oro* and *Cinque Stelle* was almost invariably in conjunction with its trade mark *Vittoria* to describe its highest quality coffee blends<sup>132</sup>. The Full Court's only point was that use of *Oro* and *Cinque Stelle* in that manner was in accordance with the ordinary signification of those words in Italian.

108 Cantarella also calls into question the evidentiary basis for what the Full Court described as the most important consideration on which it relied: that before Cantarella's applications for registration other coffee traders had used *Oro* and *Cinque Stelle*, not as trade marks, but as words descriptive of the quality of the coffee products. There is force in some of Cantarella's criticisms. The Full

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**129** *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 32 [92]-[96].

**130** *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 32 [97].

**131** *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 33 [105].

**132** *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 778 [129].

Court referred to Cantarella's own application for trade mark registration of the words *Medaglia D'oro* in 1996, and to the earlier registration by the Italian company Luigi Lavazza SpA in 1979 of a composite trade mark which included the words *Qualità Oro* subject to an endorsement on the register which stated that registration "shall give no right to the exclusive use of the Italian words 'QUALITA ORO', which may be translated into English as 'GOLD QUALITY'"<sup>133</sup>. Cantarella points out that both were different marks and that evidence of trade mark registration, or of the making of an application for registration, is not evidence of use. The Full Court also referred in that respect to a website for Lavazza coffee, which describes *Qualità Oro* as "the iconic product that made Lavazza famous worldwide" and states that *Qualità Oro* was first imported into Australia in 1955<sup>134</sup>. Cantarella points out that the website was not admitted in evidence at trial to prove the truth of that fact. But these are points of detail.

109 The structure of the Full Court's reasons for judgment shows that it relied for what it described as the most important consideration principally on findings made by the primary judge about the conduct of Molinari and of various Australian distributors of coffee products exported to Australia by Molinari<sup>135</sup>. Those findings were that Molinari had produced *Caffè Molinari Oro* in Italy continuously since 1965 and had introduced *Caffè Molinari Cinque Stelle* as its premium blend in 1997. Molinari began exporting from Italy in 1994 and began exporting to Australia in 1996. Australian distributors of Molinari's coffee products began distributing *Caffè Molinari Oro* in December 1999 and had done so since then. Australian distributors of Molinari's coffee products began distributing *Caffè Molinari Cinque Stelle* in May 2000, and had done so since then. The results of a search of the trade marks register conducted in 2011 for trade marks or pending applications which included *Oro* and *Cinque Stelle* were in evidence before the primary judge. That evidence made no reference to either *Caffè Molinari Oro* or *Caffè Molinari Cinque Stelle*.

110 Cantarella points out that the primary judge made no findings as to the form of packaging of Molinari products or as to the nature of any use of *Caffè Molinari Oro* or *Caffè Molinari Cinque Stelle* by Molinari or its Australian distributors before 2009. That is so. But it takes no imagination to infer, as the Full Court implicitly did, that Italian words were used by an Italian company in Italy in accordance with their Italian signification, and that *Caffè Molinari Oro* (relevantly between December 1999 and March 2000) and *Caffè Molinari*

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<sup>133</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 33 [100].

<sup>134</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 33 [99].

<sup>135</sup> *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 20-21 [18]-[26], 32 [98].

*Cinque Stelle* (relevantly between May 2000 and June 2001) were exported from Italy and distributed in Australia in packaging which bore those words.

111 The significance which the Full Court attached to that prior use by Molinari and its Australian distributors is also to be evaluated in the light of the primary judge's findings of contemporary use in Australia to which the Full Court also referred<sup>136</sup>. Those findings were that, as at 2011, dozens of coffee distributors in Australia used *Oro* or *D'oro* to denote products within their ranges or to denote their house brands<sup>137</sup>. The findings were also that there was use at that time by a number of coffee distributors of *5 Stelle* and *Five Star*<sup>138</sup>, and that hundreds of Australian businesses have *Five Star* in their names<sup>139</sup>.

112 *Gold* and *Five Star* are ordinary English words. Used in respect of goods or services, they signify quality. They always have. No authority is necessary to establish that, used alone, they are not inherently adapted to distinguish goods or services of one person from goods or services of another. They are words which any person in the ordinary course of business might legitimately seek to use.

113 The Full Court's conclusion was that the Italian equivalents of those words were not, on 24 March 2000 and on 6 June 2001 respectively, inherently adapted to distinguish the goods of one person from the goods of another when applied in Australia to goods of a kind commonly associated with Italy, often enough imported from Italy and often enough sold to Italian speakers. That conclusion, and the analysis of the Full Court which led to it, are, in my view, sound.

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**136** *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 215 FCR 16 at 22-23 [34]-[42].

**137** *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 777 [125].

**138** *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 773 [100].

**139** *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 299 ALR 752 at 771 [90].



# FEDERAL COURT OF AUSTRALIA

## Primary Health Care Limited v Commonwealth of Australia [2017] FCAFC 174

Appeal from: *Primary Health Care Limited v Commonwealth of Australia* [2016] FCA 313

File numbers: NSD 542 of 2016

Judges: **GREENWOOD, KATZMANN AND RANGIAH JJ**

Date of judgment: 9 November 2017

Catchwords: **TRADE MARKS** – application for leave to appeal – Registrar of Trade Marks refused registration of trade marks – primary judge dismissed appeal – whether relevant services were indivisible or indistinguishable from the provision of clinical care to patients – whether trade mark inherently adapted to distinguish the services – ordinary signification of phrase ‘primary health care’ – identification of target audience for a trade mark – whether trade marks used to distinguish the relevant services – whether trade mark not capable of distinguishing appellant’s goods or services – whether trade marks likely to deceive or cause confusion – whether trade marks contrary to law – appeal dismissed

Legislation: *Competition and Consumer Act 2010* (Cth) Sch 2, s 18 of Australian Consumer Law  
*Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth)  
*The Trade Marks Registration Act 1876* (Vic), s 8  
*Trade Marks Act 1905* (Cth), s 114  
*Trade Marks Act 1955* (Cth), s 28  
*Trade Marks Act 1994* (Cth), s 42  
*Trade Marks Act 1995* (Cth), ss 6, 12, 17, 20, 27, 28, 32, 33, 39-44, 51, 55, 56, 72, 74, 120, 195  
*Trade Marks Bill 1994* (Cth), cl 42  
*Trade Marks Bill 1995* (Cth), cl 43  
*Trade Marks Regulation 1995* (Cth), reg 3.1 and Sch 1  
Explanatory Memorandum, Trade Marks Bill 1995 (Cth)  
*Trade Practices Act 1974* (Cth), s 52  
*Medical Practice Regulation 2008* (NSW), regs 4, 6, 8  
*Registration of Trade Marks Act 1875* (UK), s 6  
*Trade Marks Act 1905* (UK), s 11

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*Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd* [2017] FCAFC 56  
*Adam P Brown Male Fashions Pty Ltd v Philip Morris Inc* (1981) 148 CLR 170  
*Allesch v Mauntz* (2000) 203 CLR 172  
*Apple Inc v Registrar of Trade Marks* (2014) 227 FCR 511  
*Austereo Pty Ltd v DMG Radio (Australia) Pty Ltd* (2004) 209 ALR 93  
*Australian Competition and Consumer Commission v Coles Supermarkets Australia Pty Ltd* (2014) 317 ALR 73  
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*FH Faulding & Co Ltd v Imperial Chemical Industries of Australia & New Zealand Ltd* (1965) 112 CLR 537

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*Recommended changes to the Australian trade marks  
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# ORDERS

NSD 542 of 2016

**BETWEEN:**            **PRIMARY HEALTH CARE LIMITED**  
Applicant

**AND:**                **THE CROWN IN THE RIGHT OF THE COMMONWEALTH  
OF AUSTRALIA**  
First Respondent

**THE CROWN IN THE RIGHT OF THE AUSTRALIAN  
CAPITAL TERRITORY**  
Second Respondent

**THE CROWN IN THE RIGHT OF THE STATE OF NEW  
SOUTH WALES** (and others named in the Schedule)  
Third Respondent

**JUDGES:**            **GREENWOOD, KATZMANN AND RANGIAH JJ**

**DATE OF ORDER:**   **9 NOVEMBER 2017**

## **THE COURT ORDERS THAT:**

1.     The application for leave to appeal is granted.
2.     The appeal is dismissed.

## **BY CONSENT THE COURT ORDERS THAT:**

3.     The applicant pay the respondents' costs of this proceeding (NSD 542 of 2016) on a party and party basis, as agreed or failing agreement, as taxed.

Note: Entry of orders is dealt with in Rule 39.32 of the *Federal Court Rules 2011*.

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<b>SUMMARY</b>	[435]

## REASONS FOR JUDGMENT

### GREENWOOD J:

1 I have had the benefit of reading the draft reasons for judgment of Rangiah J and the draft reasons of Katzmann J.

2 I agree with the reasons of Rangiah J in relation to the matters going to ss 41 and 42 of the *Trade Marks Act 1995* (Cth) (the “TM Act”). I also agree with the observations of Katzmann J concerning the s 41 issues.

3 I simply wish to add some observations on three topics. The *first* concerns, as a matter of essential principle, s 43 of the TM Act having regard to the focus of the analysis in the course of argument by the parties on the notion of identifying, for the purposes of s 43, “some connotation” the trade mark (or a sign contained in the trade mark) has and the corresponding need to isolate the so-called “denotation” of the trade mark as a perceived necessary element in identifying a relevant connotation so as to test whether *use* of the trade mark, having such a connotation, in relation to the “particular services” in respect of which registration of the mark is sought, “would be likely to deceive or cause confusion”.

4 The *second* matter concerns the dominant and fundamental challenge to the entire analysis of the Primary Judge (“PJ”) concerning the question of: to whom are the applicant’s “Services” provided?: I will refer to the applicant for leave to appeal as the “appellant”.

5 The *third* concerns the “proposed condition” to limit the scope of the use of the trade marks.

6 Section 43 of the TM Act is in these terms:

43 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.

[emphasis added]

7 Section 43 falls within Div 2 of the TM Act (which addresses the topic of “Grounds for Rejecting an Application”), of Pt 4 (which concerns “Application[s] for Registration”). In order to **be** a “trade mark” for the purposes of the TM Act, each trade mark in these proceedings, like all candidate trade marks for registration, must be a sign used, or intended to be used, *to distinguish*, relevantly here, the identified *Services* “dealt with or provided in

the course of trade” by the applicant from the services so dealt with or provided by any **other person**: s 17.

- 8 The very essence of a trade mark proposed for registration under the TM Act is that it is capable of operating as a “badge of origin” by being capable of distinguishing the goods or services of the applicant dealt with or provided in the course of trade by the applicant from the goods or services of others. The all too familiar rights conferred upon the owner by registration of the trade mark are set out at ss 20, 21, 22 and Pt 12 of the TM Act.
- 9 The statutory essence of a candidate trade mark is that it means and says (that is, distinguishes or is capable of distinguishing), no more and no less than that the *applicant owner* is the *source* of the identified goods or services the subject of the application, rather than someone else.
- 10 This, for want of a better non-statutory descriptive term, is the “denotation” of the trade mark because it is what the trade mark **must be** for the purposes of the TM Act. If the trade mark proposed for registration is simply not capable of distinguishing the applicant’s designated goods or services from those of others, the application for registration *must* be rejected because it fails at the threshold and s 41(1), symmetrically, brings about that result having regard to the imperative of s 17.
- 11 Section 41(2) goes on to identify the only circumstances (that is, those circumstances falling within s 41(3) or s 41(4) depending upon their application) in which a trade mark is *taken* not to be capable of distinguishing the designated goods or services from the goods or services of other persons.
- 12 Although a trade mark sought to be registered might be capable of operating as a badge of origin in the sense contemplated by the statutory text of s 17 (and survive a s 41 analysis), such a trade mark *must* nevertheless be rejected, according to s 43, if, because of some connotation it has, use of the trade mark in relation to the designated goods or services would be likely to deceive or cause confusion.
- 13 The trade mark might not, of course, in any event, be capable of distinguishing the applicant’s goods or services from those of others having regard to the operation of s 41 but assuming a trade mark is otherwise entitled to registration, it *must* be rejected if it has an identified connotation and because of it, use in relation to particular goods or services the subject of the application would be likely to deceive or cause confusion.

14 So, the first s 43 question always is whether the trade mark, sought to be registered, has “some connotation”. If not, s 43 is simply not engaged. The second s 43 question, if s 43 is engaged, is whether “because of [that connotation]”, use of the trade mark, in relation to the relevant goods or services, in a forward-looking way, “would be likely to deceive or cause confusion”.

15 The Primary Judge found at [164] that each trade mark sought to be registered has (and had at the priority date) a “clear connotation”.

16 The clear connotation so found is that the word mark “Primary Health Care” and the logo device prominently adopting “PRIMARY” in conjunction with “Health Care Limited” connote “first level or first contact health care”: PJ at [164]. That connotation is a shorthand phrase for signifying the provision of services which form part of “that part of the Australian health care system which provides *first level* health care, being the health care received as a result of the *first contact* between an individual and a health care system” [original emphasis]: PJ at [99]. Thus, each trade mark is said to contain within it or “include” or “imply” a meaning “besides what it primarily denotes”. Each trade mark primarily denotes a contended distinguishing connection between the *applicant* and the suite of identified *Services* to be provided by reference to each mark (the subject of the application). The *Oxford English Dictionary*, 2<sup>nd</sup> Ed, Vol 3, attributes the following meanings to the noun “connotation” and the verb “to connote”:

Connotation     the signifying in addition; inclusion of something in the meaning of a word besides what it primarily denotes; implication

Connote           to mark along with, to mark (a thing) with or in addition to (another); to signify secondarily or in addition; to include or imply along with the primary or essential meaning

17 In *Pfizer Products v Karam* (2006) 219 FCR 585, Gyles J said that the term “connotation” in s 43 is a reference to “a secondary meaning implied by the mark” and thus an analysis of whether s 43 is engaged has sometimes tended to centre upon examining the “primary meaning” of the trade mark with a view to then identifying whether the trade mark has an implied “secondary meaning”. This has resulted in a search for a “first order” *meaning* to be attributed to the words (or words and a device), comprising the trade mark (the so-called “denotation”) and a search for a “second order” *meaning* (the “secondary connotation”). The Primary Judge, correctly in my view, said that the phrase “primary health care” adopted in

the trade marks has a “clear connotation”, being, “*not the applicant as the source of the Services, but first level or first contact health care*” [emphasis added]: PJ at [164].

- 18 In that short rolled-up sentence, the Primary Judge is, correctly, saying that the role of the trade mark (that is, that which it “primarily denotes” although the term “denotation” does not appear in s 43) is to *distinguish* the *applicant as the source* of the relevant “Services” from the (like) services of others. This is the true denotation. The Primary Judge is also saying that, upon analysis, the phrase “primary health care” does not distinguish the applicant as the source of the Services but has a “clear connotation” that the *character* of the “Services” (or the *kind* of “Services”) provided by the applicant is the provision of “first level or first contact health care”.
- 19 The Primary Judge found that use of either mark, having such a connotation, would be likely to deceive or cause confusion because the applicant is not, in fact, the provider of, nor responsible for, the *clinical* care provided by the General Practitioner practising at any one of the applicant’s 71 medical centres (medical services) nor the *clinical* care provided by any other health professional actually providing his or her services (professional clinical health services) at any one of the applicant’s medical centres.
- 20 In the principal proceedings, the Primary Judge found that each trade mark failed as a trade mark for the purposes of the TM Act at the threshold because neither trade mark adopting the phrase “primary health care” was capable of distinguishing the identified “Services” of the applicant from the services of others (s 41(1)) and thus, the essential role of the trade mark as a badge of origin denoting the applicant as the source of the identified “Services” failed. The Primary Judge then proceeded, in any event, to consider the questions raised by the possible application of s 41(2), (3) and (4). The Primary Judge described each trade mark as having the “core meaning” described at [117].
- 21 Assuming that the appellant has applied for registration of something which is a “trade mark” for the purposes of the TM Act (and thus an application for the purposes of s 43), the application must be rejected on the s 43 ground because the connotation (so found) would be likely to deceive or cause confusion (as found). If, however, the appellant’s trade marks fail at the threshold because neither trade mark is capable of distinguishing the appellant’s identified Services the subject of the application (the “designated services”) from the services of others, the trade mark simply has no denotation.

22 Each ground of objection has, however, an independent operation. In deciding whether a ground of opposition is made out under s 43, the process of analysis necessarily assumes, for that purpose, that the trade mark is comprised of a sign used or intended to be used to distinguish the identified goods or services dealt with or provided by the applicant in the course of trade from the goods or services of others and asks whether such a sign has some connotation signifying something “besides what it primarily denotes” (to use the Oxford English Dictionary meaning) and, if so, whether use of such a sign, having such a connotation, would be likely to deceive or cause confusion.

23 The question is, does the trade mark have “some connotation” going beyond its *only role* as a badge of origin of the applicant as the source or origin of the identified goods or services described in the application, from the services of others?

24 These things should be noted. At [99], the Primary Judge said this:

99 Having regard to these matters, I do not accept that the applicant’s submission, that there is no “singular or clear meaning” of the descriptive phrase “primary health care”, is correct. It is and for many decades has been clear to those involved in public health policy, that “primary health care” means (at least) *first level health care or the health care received as a result of the first contact* between an individual and a health care system. The fact that the phrase also means more than this is immaterial. The phrase has an ordinary signification to those involved in public health policy in Australia and that signification is that part of the Australian health care system which provides first level health care, being the health care received as a result of the first contact between an individual and a health care system (or, in shorthand, first level or first contact health care). This was (and is) understood to include, but not be limited to, the health care provided to people by GPs. In other words, there has never been any doubt that, to those involved in public health policy in Australia, GPs provide primary health care.

[emphasis added]

25 At [102], the Primary Judge said this:

102 In any event, a number of the witnesses referred to above have been GPs (such as Dr Hobbs) or frequently interact with GPs as part of their work. Moreover, these witnesses did not consider their understanding of primary health care to be one which applied *only* within the area of public health policy. Their experience of the use of the phrase extended beyond that into both *academic* and *clinical* settings. While I accept that a person cannot generally give evidence about another person’s state of mind, the evidence of these witnesses, the overall effect of which was that they frequently heard the term used in these contexts and in a way which accorded with their understanding of the term, indicates that the applicant’s contention that “primary health care” is a recent invention confined to those involved in public health policy is a *fallacy*.

[emphasis added]

26 At [115] and [116], the Primary Judge said this:

115 *Insofar as members of the public are concerned*, the applicant relied on various statements in government policy documents to the effect of the statement in the 2009 *Report to Support Australia's First Primary Health Care Strategy* that:

[P]rimary health care is a term that is not widely used or even understood with most people simply distinguishing between the health care they receive in the community and the health care they receive in hospital.

While there are a number of definitions available, including from the World Health Organisation and the Australian Primary Health Care Research Institute, in practice there is no absolute or consistent view about whether particular settings and services are part of primary health care or not.

116 Again, when read in context it is apparent that there is *no suggestion* here that “primary health care” *does not mean first level or first contact health care*. Nor is it suggested that a member of the public, confronted with the phrase, would not understand this *core meaning* as a result of the *ordinary meaning of each of the words*. The health care which people receive in the community is primary health care so the distinction which the report says most people draw in fact accurately reflects the health policy meaning of the phrase. The points being made are first that members of the public, in contrast to those involved in health care, do not think in terms of primary, secondary and tertiary health care and, second, that there is room for debate amongst those involved in health care about whether any particular activity involves primary health care or some other level of care. What reading the documents in context also makes plain is that, whatever the bounds of that potential for debate, the provision of medical services by GPs is a setting involving the provision of primary health care. It is an unequivocal example of the provision of what a substantial number of those involved in the health sector would know involved primary health care.

[emphasis added]

27 At [117], the Primary Judge said some things about the “core meaning” of “first level or first contact health care”. The Primary Judge said this:

117 I also consider that this core meaning, of first level or first contact health care, would be understood by a substantial number of people seeking to access health care as at the priority date. That is, if a person saw “primary health care” in the context of seeking health care for themselves or a family member or associate, *they would understand the reference to be to a form of health care, being first level/first contact health care. They would do so because of the ordinary meaning of each word which makes up the phrase*. While such a person may not distinguish between primary, secondary and tertiary levels of health care, or think of primary health care as an approach to health care in the extended sense of the term as used in the health policy context, they would understand the ordinary signification of the phrase to be first level/first contact health care. Such a person, moreover, would be very

unlikely to associate the phrase with the applicant because the applicant's marketing is targeted at GPs, not members of the public. One exception to this would be those with an interest in publicly listed companies operating in the health care sector (about which Mr Symons gave evidence) but people within this class could not be assumed to be a substantial proportion of the general public.

[emphasis added]

28 The Primary Judge found that the "Services" are integral to the provision by GPs (and other health professionals within the medical centres owned and operated by the appellant) of primary health care services to patients who attend the centres: [118].

29 The Primary Judge found that the "core meaning" of each trade mark *is* the connotation conveyed by each mark as found. In other words, the Primary Judge found (having regard to the rolled up sentence at [164] of the Primary Judge's reasons, as mentioned earlier, taken together with the other findings), that each trade mark failed as a trade mark as neither trade mark was capable of distinguishing the appellant's "Services" (in respect of which each trade mark was sought to be registered), from the services of others. However, even assuming, for the sake of the s 43 question, that each trade mark was capable of discharging its statutory function as a trade mark, the trade marks comprising the signs "Primary Health Care" contain within them a meaning going beyond the contended primary (and *only*) role of each mark as a badge of origin by implying, in addition, a meaning of, *not the appellant* as the *source* of the identified "Services", but rather, the appellant as a provider of *first level* or *first contact health care*. It was uncontroversial that the appellant does not supply *any* clinical care or other professional health care services (which, of course, form no part of the identified Services in any event).

30 Section 43, in order to be engaged, did not require the Primary Judge to find *another* or *secondary* meaning going beyond "first level or first contact health care" provider and ask whether such other meaning, through use of each trade mark, gave rise to the statutory consequences contemplated by s 43. The two questions under s 43 were: whether each trade mark contains "some connotation" (going beyond the *appellant* as the *source* of the "Services"), implying that the appellant is a provider of "first level or first contact health care"; and, whether use of each trade mark, having such a connotation, would be likely to deceive or cause confusion.

31 The Primary Judge did not fall into error in the way in which her Honour approached the questions to be answered under s 43 of the TM Act. I will return later in these reasons to the

question of whether use of each trade mark having such a connotation would be likely to deceive or cause confusion. Before doing so, it is necessary to turn to the second issue which concerns the question of whether the Primary Judge fell into error in the way in which her Honour analysed the appellant's services and found that they were provided more broadly than that contended for by the appellant. This contention goes to Ground 3 of the notice of appeal. However, the appellant says that the approach of the Primary Judge *affected everything* because her Honour's approach caused the analysis of the legal questions in issue to miscarry.

32 By Ground 3 of the grounds of appeal, the appellant contends that the Primary Judge erred in finding at [60]–[68], [80], [118]–[199], [124], [143] and [153], that the “Services” provided by the appellant “are not separate from other activities engaged in by the appellant in the operation of its medical centres and [in finding that the Services], are indivisible or indistinguishable from, or integral to, the provision of clinical care to patients who attend the appellant’s medical centres”.

33 Put simply, the appellant contends that the Services are “back office services” provided to the addressees of those services, namely, medical and allied health practitioners. In that sense, it is said that medical and allied health practitioners are provided with a suite of support services which enable them to provide clinical services. In effect, all necessary services to enable them to provide clinical services are outsourced to the appellant as a service provider. The appellant says that the proper way to view these structural and institutional arrangements with medical and other health professionals is in an entirely bilateral or binary way. The appellant, it is said, has configured a suite of services (the “Services”) which are addressed to, and provided to, the medical practitioner or the related health professional to enable that person to provide clinical services. The appellant says it has *no relationship* with the patients or persons who deal with the medical practitioner or related health professional.

34 The “Services” identified in the application for registration of each trade mark (Class 35 services) are described in this way:

Medical centre business management; medical centre business administration; service provider to medical professionals, namely provider of: administrative support services, billing and invoicing services, reception and telephone answering services, patient booking services, patient file management services including management of access to patient files, typing services, account-keeping and book-keeping services, preparation of business reports, systemisation of information into computer databases, professional business consultancy, computerised file management, business and information management services, ordering services,

processing of purchase orders.

35 The Primary Judge conducted an examination of the evidence concerning the way in which the appellant has gone about operating its 71 medical centres. The Primary Judge made the following observations in the paragraphs of the primary judgment now under challenge. I will start with [60] to [68]:

60 Reality dictates that the applicant's attempts to characterise the Services as services provided *only* to medical professionals cannot be accepted. The attempts reflect a *misconception* which affects the entirety of the applicant's case.

61 Another misconception in the applicant's case is apparent. It is the notion that the applicant is *in the business* of providing the Services to health professionals. This is inaccurate. The applicant is *in the business of operating medical centres* to which it recruits GPs and, as part of a much larger set of activities, it also provides the Services to the health professionals who have contracted to work from such a centre. No health professional can simply purchase the Services from the applicant. As part of the applicant's overall activity, but not otherwise, the applicant provides the Services which of their very nature and in many respects are services to not only the GPs and allied health professionals, *but also to members of the public and to others involved in the health system*.

62 As noted, the applicant, on the evidence, does not offer any GP or allied health professional the Services *in isolation*. The applicant, for example, does not offer the Services to every GP or allied health professional. The Services are only available to a GP or allied health professional at the medical centre to which the GP or allied health professional has been recruited. Consistent with this, the applicant does not market the Services per se to GPs and allied health professionals. Rather, it markets to GPs and allied health professionals a *form of practice* from one of its *medical centres*. The form of practice is to work from a room in one of the applicant's medical centres (GPs are recruited to specific centres and must practice from that centre) which will be fully equipped and supplied by the applicant, with all staff and services necessary for the operation of a medical centre being provided by the applicant in exchange for a fee which is calculated as a percentage of the money earned by the GP from providing clinical services to patients.

63 Against this background, I do not accept the attempted characterisation of the applicant as having provided the Services to GPs and health professionals and having done so using the marks to brand the Services. It might be different if, for example, the applicant was in the business of providing the Services to all GPs and health professionals and marketed the Services in that way. But this is not what the applicant does or has ever done.

64 As such, the *focus* of the applicant's case is *off target* and *at odds with the evidence*. The consequences of this disconnect run through every aspect of the case. *First*, the Services cannot be considered as if they exist in isolation because that is not how the Services are provided. *Second*, no matter how often the applicant repeats it, I am unable to accept that the Services are directed only to GPs and health professionals; the public and other participants in the health care sector are provided with some of the Services

and are potentially concerned with all of the Services. *Third*, this in turn affects the question of whether the marks are inherently adapted to distinguish when the Services are provided in and from a medical centre which, as discussed below, involves the quintessential form of primary health care. *Fourth*, this has led to the proposed amendments which, as discussed below, involve a form of self-negating description of the Services. *Fifth*, the applicant has tried to establish acquired distinctiveness by use of the marks in respect of the Services when the applicant does not market the Services at all in and of themselves, but markets to GPs and allied health professionals a particular form of practice in which, amongst many other things (including the basic requirements of rooms, equipment, medical supplies, cleaning and maintenance), the applicant also provides the Services.

- 65 To return to the immediate issue, *the reality is that*, at least insofar as the Services are concerned, *the applicant is providing services to medical professionals within its centres, to patients of those centres, and to all other participants in health care who interact with any medical professional in one of its centres*. The fact that the applicant (or Idameneo) receives payment for the provision of the Services directly from the medical professional does not mean that the Services are provided only to the medical professional. Nor does the fact that medical professionals understand that they alone provide clinical or medical services to patients mean that the Services are not provided to patients. The reasoning involved seems to involve a false syllogism: (i) only medical professionals provide clinical services to patients, (ii) the Services are not clinical services, (iii) therefore, the Services are necessarily not services to patients. Propositions (i) and (ii) may be accepted, but they do not lead to proposition (iii).
- 66 Moreover, the fact that the Services are not clinical services does not mean that they are irrelevant to the provision of clinical services. If the applicant (or Idameneo) did not provide the Services to a medical professional then, in the Australian health care system at least (which is highly regulated), someone else would have to provide those services (including the medical professional personally if they so wished) to enable the clinical services to be provided. Even a medical professional who did not wish to charge for their services would be bound by ethical (and presumably statutory) obligations to ensure that proper records of treatments, prescriptions and referrals are made and maintained. The existence of, and ability to access, those records is very closely related to, indeed part of, the provision of clinical services.
- 67 While there is a *factual dispute* between the parties about the *extent* to which the applicant (or Idameneo) has *used* the words “Primary Health Care” to *brand* its medical centres in some way or another (three centres according to the applicant and seven centres according to the respondent), it is not in issue that the applicant’s particular business model involves the *marketing to and recruiting of GPs to work from its medical centres*. The applicant, in substance, sells to GPs a form of practice. The *thrust of the marketing is* (and has been) that it may pay GPs for their practice and, for a fee calculated as a percentage from patient billings, will provide them with *rooms within a large-scale multi-disciplinary centre from which to work, with all “nurses, receptionists, supervisors, accountants and administrative staff” provided as part of the centre, the patient benefits being identified as accessible health care when needed, no appointments necessary, Medicare services bulk-billed, comprehensive family practice with GP of choice and range of practitioners to choose from, continuity of care with availability of records and service by principal doctors, and “comprehensive one site health care*

*for most services found outside major hospitals”.*

68 Contrary to the respondents’ case, I have no doubt that the *thrust* of the applicant’s marketing has been and is intended to be *to GPs and allied health professionals, not to the public*. The occasional references to itself in its dealings with the public seem relatively few and far between compared to its continuing activity of recruitment of GPs to its centres. *But by focusing on the Services which occur within the medical centres at which patients receive clinical care the applicant has created specifications in which many of the Services are services to more than merely the GP or other health professional, and are indivisible from or integral to the provision of clinical care by the GP or other health professional.*

[emphasis added]

36 The appellant also challenges the findings in the following paragraphs:

80 To take billing services as an example, the applicant (or Idameneo) is providing those services directly to medical professionals. However, irrespective of the applicant’s conception of its activities, it is *also providing those billing services directly to patients*. The proposed amendments attempt, on the one hand, to give the applicant a right of exclusive use of the marks insofar as the medical professionals are concerned, yet on the other hand to deny the applicant any right of exclusive use insofar as members of the public are concerned. The *service*, however, is the *one service*. In providing a service to medical professionals, the applicant is *also* providing a service to patients. In providing a service to patients, the applicant is *also* providing a service to medical professionals. Billing services necessarily “entail dealing with patients”, so are those services within or outside the scope of the registration? The applicant, by the *amendments*, is trying to divide a service into segments which do not exist. For the same reason, the applicant’s invitation to attempt to re-write the specifications must also be *declined*.

...

118 As discussed, I accept the respondents’ submission that the Services are *integral* to the provision *by GPs* (and other health professionals within the medical centres owned and operated by the applicant) of *primary health care services to patients who attend the centres*.

119 As the respondents submitted, there is an *unreal distinction* at the *heart* of the applicant’s case between the provision of the Services and the provision of clinical or medical care. The distinction is unreal because the Services are *part* of the *overall service* a patient receives when attending a medical centre and, to some extent, are also part of the medical or clinical care a patient receives. It is part of medical care that a GP be able to access clinical records for a patient. It is part of medical care to ensure new records are accessible in the future. It is part of medical care for a patient’s referral to be properly recorded, stored and managed. It is part of medical care for the centre to have available necessary medical supplies. Otherwise, from the moment a patient makes a booking or attends a centre, they are receiving aspects of the Services.

...

124 In this context, if the question is posed whether, at the priority date, other

persons involved in the Australian health care system, in the ordinary course and without improper motive, might wish to use the phrase “primary health care” in connection with the Services; the answer *must be* “yes”. Every GP and every medical centre is providing primary health care and, in so doing and in one way or another, is performing or having performed the Services to enable that provision. The phrase was at the priority date, and remains, a direct description of the activity of which the Services form part. The phrase does not have an inherent capacity to distinguish the Services as offered by the applicant from the same services however and by whomever they might be performed. The phrase is not a skilful allusion to the clinical services that GPs provide in asserted distinction from the administrative and managerial character of the Services. Because the distinction is artificial, the phrase is directly descriptive of the Services. The other persons who might legitimately wish to use the phrase “primary health care” in connection with services the same as the Services include all government departments involved in the health care system, all providers of primary health care, all businesses like that of the applicant involved in the provision of primary health care, and all members of the public.

...

- 143 Given these matters, care is required in respect of the evidence for and submissions of the applicant. For example, it was submitted that:

Primary Health Care’s sales approaches and negotiations with potential customers of the Services, as at October 2009 and continuing today, are conducted under and by reference to the Trade Marks, and involve careful explanation of its Services.

...

- 153 These conclusions also answer the inquiry under s 41(6). As discussed I consider that the marks are not to any extent inherently adapted to distinguish the applicant’s Services from the same services offered by others. Further, I am not satisfied that because of the extent to which the applicant has used the marks before the priority date the marks distinguish the Services as being those of the applicant. This is because, as I have explained, the use of the marks before the priority date (which I accept has occurred for the word mark, but not the logo mark) relates to the recruitment of GPs to work at the applicant’s medical centres and the operation of the medical centres as a whole and not the Services.

[emphasis added]

- 37 The appellant challenges all of these findings of fact. Before interfering with any of the Primary Judge’s findings of fact, a court of appeal conducting an appeal by way of rehearing, must be satisfied that the challenged findings are “glaringly improbable” or “contrary to compelling inferences” or shown to be wrong by “incontrovertible facts” or “uncontested testimony”. The possibility that another Judge or more particularly any one of the Judges constituting the appeal court, might or might well have, formed a different view of the contested evidence or might, or might well have, reached different findings open on the evidence to those findings of the Primary Judge also open on the evidence, does not provide a

*principled basis* for interfering with the findings of fact of the Primary Judge. So much is made clear from the observations of the Court (French CJ, Bell, Keane, Nettle and Gordon JJ) in *Robinson Helicopter Company Inc v McDermott* (2016) 90 ALJR 679; 331 ALR 550 at [43].

38 In this context, two further observations from the authorities should be noted. *First*, in *Whittaker v Child Support Registrar* [2010] FCAFC 112 at [2], Keane CJ (as his Honour then was), Moore and Perram JJ said:

On the appeal to this Court, the appellants' submissions on issues of fact proceed, in large part, on the assumption that the issues between the parties remain at large as if they had not been determined by the findings of the learned trial judge. It is not open to this Court to determine issues of fact, *as if* the findings of the learned trial judge had not been made. While this appeal is an appeal by way of rehearing, the Court's function is to *correct errors* in the decision below.

[emphasis added]

39 *Second*, in *Warren v Coombes* (1979) 142 CLR 531, Gibbs ACJ, Jacobs and Murphy JJ; Stephen and Aickin JJ dissenting, set out the relevant principles, which were those discussed by Barwick CJ and Windeyer J in *Da Costa v Cockburn Salvage & Trading Pty Ltd* (1970) 124 CLR 192 (and subsequently in *Edwards v Noble* (1971) 125 CLR 296). The relevant passages are as follows:

The question is not whether the appellate court *can* substitute its view of the facts which, of course, it is empowered to do: but whether it *should* do so. In any appeal against a *finding of fact*, whether or not by way of rehearing, however much the appellate court may be in an equal position with the trial judge as to the drawing of the inferences, in my opinion, the appellate court *ought not to reverse the finding of fact unless it is convinced that it is wrong*. If that finding is a view reasonably open on the evidence, it is *not enough* in my opinion *to warrant its reversal that the appellate court would not have been prepared on that evidence to make the same finding*".

...

But, in any case, the appellate court in my opinion is *not bound to reverse* the primary judge's finding of fact *merely because it held a different opinion* to that of the primary judge.

[emphasis added]

40 The point of almost complete departure between the appellant's own view of the target audience to whom it promotes the "Services" (and those within that target audience to whom it ultimately supplies the Services) and its view of the evidence on that topic, on the one hand, and the assessment by the Primary Judge of the evidence on that topic, on the other hand, can be seen in the Primary Judge's observation at [64] (quoted at [35] of these reasons)

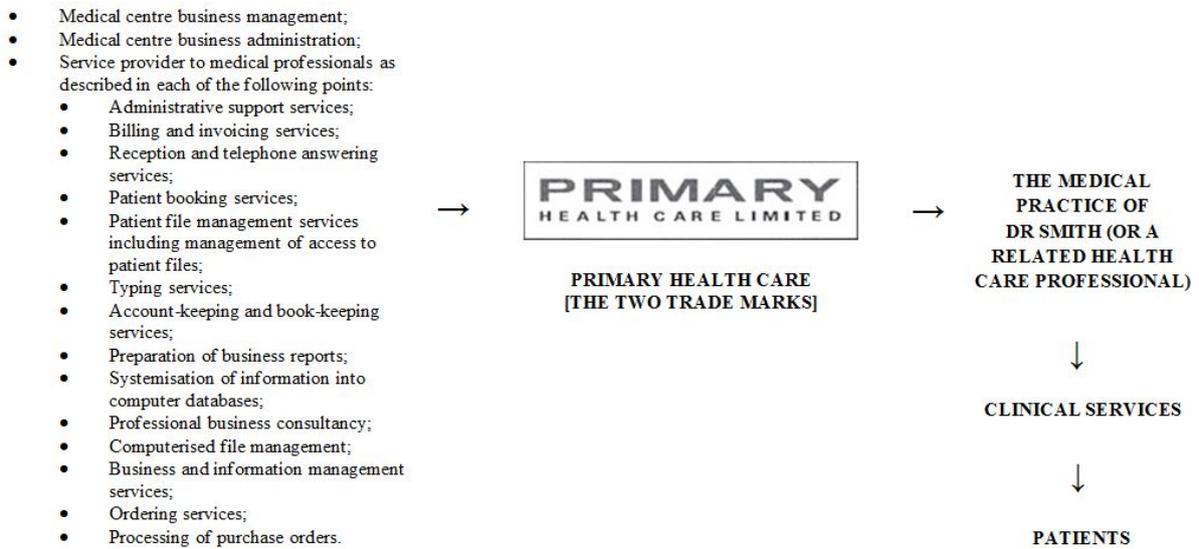
that "... no matter how often the applicant repeats it, I am unable to accept that the Services are directed only to GPs and health professionals".

41 I have attributed emphasis to many aspects of the observations of the Primary Judge on this topic quoted at [35] and [36] of these reasons and thus it is not necessary to repeat the detail of the findings of fact in the text of these reasons. It should be noted that the Primary Judge has made a very careful assessment of the evidence said to support the appellant's characterisation of the Services and the other evidence going to that question. I agree with the analysis of the findings undertaken by Rangiah J and his Honour's analysis of the appellant's grounds of appeal in relation to those findings. However, the essence of the appellant's contention is that it says (remembering that this is not the trial) that the Primary Judge fell into error by rejecting the appellant's characterisation of its Services as services provided only to medical professionals and other related health professionals. The appellant says that the Primary Judge was simply wrong to treat the appellant's characterisation of its Services as a *misconception* affecting the entirety of the appellant's case at trial.

42 At [61], the Primary Judge found that one aspect of the appellant's misconception of its case is the notion that the appellant is in the *business* of "providing the Services to health professionals". The Primary Judge found that the evidence supported a conclusion that the appellant, in fact, is in the *business* "of operating medical centres" to which it recruits General Practitioners and, as part of a set of activities forming part of that business, it provides the Services to health professionals (General Practitioners and other health professionals) who have contracted to work from one of the appellant's medical centres. The Primary Judge accepted that it was not in issue at the trial that the appellant's particular business model involves marketing to, and recruiting of, General Practitioners to work in any one of its 71 medical centres and that, in substance, the appellant "sells a form of practice", according to the appellant's business model, to General Practitioners. Also, the Primary Judge accepted that the *thrust* of the appellant's marketing is that it pays General Practitioners for their practice and then provides those practitioners with a suite of services in consideration of being paid a fee calculated as a percentage of the patient billings. Moreover, the Primary Judge observed that she had no doubt that the *thrust* of the applicant's "marketing" had been, and was intended to be, directed to General Practitioners and allied health professionals rather than the public. The Primary Judge accepted that the references by the appellant, to itself, in its dealings with "the public" seemed to be "relatively few and far between" compared to the thrust of its continuing activity to recruit General Practitioners

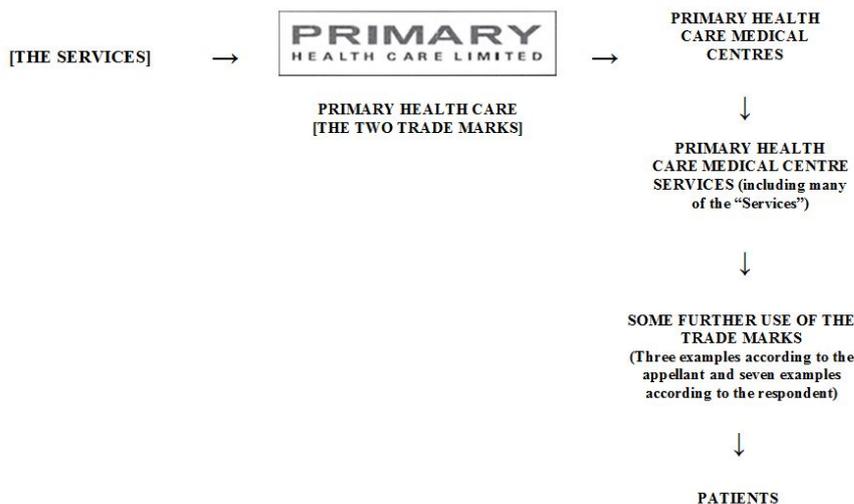
to its medical centres. Nevertheless, the Primary Judge concluded that by focusing on the Services occurring within each of the medical centres at which patients receive clinical care, the appellant has “created specifications” in which many of the Services are services provided to, not merely the General Practitioner, or relevant health care professional, but are “indivisible from or integral to” the provision of clinical care by the GP or other health professional: PJ at [67], [68] and [118].

43 The way in which, put simply, the appellant structurally views what it does, so far as patients/members of the public are concerned, is illustrated in the diagram below:



[THE SERVICES]

44 The Primary Judge, put simply, found that the provision of the Services was along the following lines:



45 Under the model at [43] of these reasons, there is a bilateral relationship between the appellant and Dr Smith in which the appellant provides the suite of Services to Dr Smith so as to enable Dr Smith to provide (his or her) clinical services to patients. The trade marks are said to be used in the course of that bilateral relationship as a badge of origin to distinguish the identified Services dealt with or provided in the course of trade in the Services by the appellant from, put simply, back office enabling services provided by any other provider of such services. In other words, the appellant contends that the evidence demonstrates that there is discrete separation between the Services provided by the appellant to the medical practitioner under and by reference to the trade marks, on the one hand, and the provision of clinical services by Dr Smith to patients of Dr Smith, on the other hand.

46 Under the model at [44], the Primary Judge found, on the facts, that the appellant *operates* 71 medical centres. Those Primary Health Care medical centres are places at which patients can and do access a range of Primary Health Care services provided by each of the medical centres, that is, provided by the appellant. Some at least of the medical centres (maybe three, maybe seven) are badged “Primary Health Care”. At these medical centres, the patients can and do obtain clinical services from a General Practitioner. Other health care professionals can and do provide their services to patients attending some or all of the appellant’s medical centres. Under the model at [44], the patients engage with the medical centre operated by the appellant. They engage with the appellant because the appellant is in the business of operating each medical centre. In order to operate a medical centre with clinical officers and other staff, it is essential to have a General Practitioner onsite to provide diagnostic and other clinical medical services. Otherwise, there is no point to being in the business of operating medical centres and trying to engage with citizens in the operation of a Primary Health Care facility or centre or clinic. Some or all of the centres have a related health care professional onsite.

47 The appellant, however, does not provide the professional services to patients of each medical centre. The patients engage with and are treated by the General Practitioner and so too patients engage with and are treated by the related health care professional. In other words, the business model and manner of operation of each medical centre contemplates a direct relationship between the General Practitioner or other health care professional and the patient, in the provision of *clinical* services.

48 In order to both operate each medical centre and support the clinicians working at each centre, the appellant deploys the Services at each medical centre. Some of the Services are essential to the operation of a medical centre. Others are more enabling of the work of the clinicians operating out of each medical centre. In the model at [44], as found, all of the Services are deployed by the appellant in and in connection with the operation of each medical centre. Each medical centre provides services to patients attending each of the appellant's medical centres. Some of the services provided to a patient attending one of the appellant's medical centres, or seeking to attend one of its medical centres (having conducted a search online of "Primary Health Care" to identify a location for one of the 71 medical centres or otherwise having contacted one of the Primary Health Care medical centres), includes these services:

- Reception and telephone answering services;
- Patient booking services;
- Patient file management services including management of access to a patient's files;
- Billing and invoicing services;
- Typing services.

49 However, as well, in order to operate a medical centre, the appellant deploys administrative support services; all of the services described at [48]; account-keeping and book-keeping services; preparation of business reports; systemisation of information into computer databases; computerised file management; business and information management services; ordering services; and processing purchase orders. It necessarily undertakes medical centre business management and medical centre business administration. Some of these services are provided to the General Practitioner and any other health care professional providing clinical services at one of the centres. Most of the services are integral to the business of operating 71 medical centres. Other parts of the services are more directly provided to the patients of each medical centre as well as the General Practitioner and the related health care professional. Each patient, however, is also the beneficiary of what would, no doubt, be said to be the efficient operation of the business of conducting 71 medical centres.

50 It can be seen from this description of the services and aspects of the segmentation of those services that all of them fall within the scope of the Services the subject of the application for registration of each trade mark in issue.

- 51 There can be no doubt that the findings of the Primary Judge were open on the evidence.
- 52 The appellant, in effect, seeks to set aside the findings of the Primary Judge and have them replaced with fresh findings undertaken by the Court in the exercise of the appellate jurisdiction. The findings of the Primary Judge are neither glaringly improbable nor contrary to compelling inferences nor shown to be wrong by incontrovertible facts or uncontested testimony.
- 53 A particular difficulty is that the appellant has failed to maintain any analytical integrity in the *discrete role* to be played by each trade mark in respect of each of the Services. The appellant wants to say that it only provides bilateral Services, as described, to General Practitioners and other health care professionals by reference to the badge of origin of those Services in the form of each trade mark. However, the appellant, in fact, operates 71 Primary Health Care medical centres and in doing so the appellant associates, in part at least, the trade marks with its business of operating the medical centres.
- 54 Thus, the trade marks do not, in fact, distinguish the appellant as the provider of the Services to a General Practitioner or other health care provider, from the services of others. By the manner in which the appellant conducts its 71 medical centres, each trade mark has lost its essential bilateral role. In addition, use of each trade mark conveys the impression, due to the connotation earlier described, that the appellant is the *provider of first level or first contact health care* when, in fact, the one service that Primary Health Care Limited does not provide to patients of its 71 Primary Health Care medical centres is clinical services.
- 55 Ground 3 of the appeal is not made out.
- 56 Returning to s 43, use of the trade marks, having the connotation earlier described, in relation to the Services, would be likely to deceive or cause confusion for the reasons indicated at [54] of these reasons.
- 57 Apart from the observations I have expressed in relation to s 43; my concurrence with the views expressed by Rangiah J concerning ss 41 and 42; the observations I have expressed concerning Ground 3 of the appeal, I otherwise agree with the observations of Rangiah J on all other issues including his Honour's more detailed observations concerning Ground 3.
- 58 On the final day of the hearing of the appeal, the applicant/appellant handed up a "drafting option" setting out how the Court might go about limiting, if the Court was minded to do so, the appellant's mode of use of the trade marks. On the final day of the hearing the appellant

was directed to put on submissions identifying the basis upon which the Court ought to take into account the proposed limitation. In those submissions, the appellant said that it had, on reflection, framed a “more appropriate form of limitation on user” so as to “make plain” the restriction on the mode of user of the trade marks at the appellant’s 71 medical centres.

59 The proposed condition is in these terms:

The applicant will not use the mark[s] at the applicant’s medical centres in respect of the services in the specification in any way that may be seen or heard by patients, members of the general public, or other persons in the health sector who are not medical professionals.

60 The appellant says that the proposed condition would limit not only the monopoly sought by it but also its permitted use of the marks. The appellant says that the proposed condition restricting its use of each trade mark is capable of removing any reasonable possibility that the applicant’s use of either mark would be likely to deceive or cause confusion or be misleading or deceptive. The appellant says that the grounds of opposition under s 42(b) and s 43 of the TM Act would then no longer present an obstacle to registration. The applicant submits the proposed condition for the Court’s consideration and says that it would be within the Court’s power to impose a differently worded condition.

61 A similar set of circumstances emerged at the hearing before the Primary Judge.

62 At [72], the Primary Judge observes that on the last day of the hearing the applicant proposed an amendment to the specification of the Services so as to provide that the medical centre business management services and the medical centre business administration services would each have the words “to medical professionals” added to those phrases. In addition, the applicant before the Primary Judge suggested that the following words would also be adopted in the specification of the Services: “none of the aforementioned services being medical care by medical professionals to patients”.

63 After the hearing before the Primary Judge, pursuant to leave, the applicant proposed two further amendments to the specification of the Services and in each of the new options (Option B and Option C), the applicant recited further words of qualification and, as to Option B, an endorsement containing a limitation on the provision of the services and, as to Option C, a disclaimer reflecting a particular form of limitation.

64 All of this seems to have come at the last minute (and after the last minute) before the Primary Judge.

65 At [79], the Primary Judge said this:

79 It will be apparent that the intention of the amendments is to prevent the applicant from having any exclusive right to use the marks in a manner which will be seen by any member of the public attending one of the applicant's medical centres. There are a number of difficulties with the proposed amendments.

66 At [80], the Primary Judge explained some aspects of the difficulties contemplated at [79].

67 At [81], the Primary Judge said this:

81 The amendments, accordingly, make *no material difference* to the *actual nature* of the Services as they in fact *exist* and are *performed*. If the amendments do anything, it is to introduce an unacceptable ambiguity into the definition of the Services which cannot be assumed to *confine* the Services in the way the applicant wishes.

[emphasis added]

68 The appellant says that once the Primary Judge found that the grounds of opposition under ss 42(b) and 43 were established, her Honour erred in failing to consider whether the marks could nevertheless proceed to registration with conditions or limitations as proposed to the Primary Judge. This contention is Ground 4 of the grounds of appeal.

69 Now, the appellant has formulated and submitted on the last day of the appeal a proposed condition of limitation. The Court has also now received as part of the supplementary submissions another version of a proposed condition as set out at [59] of these reasons. The appellant says that the Full Court has power under s 197(e) of the TM Act and under s 28(1)(b) of the *Federal Court of Australia Act 1976* (Cth), to “make such order, as, in all the circumstances, it thinks fit, or refuse to make an order”.

70 The difficulty is that Ground 4 of the grounds of appeal is concerned with whether the Primary Judge erred in concluding that none of the proposed three options made any material difference to the “actual nature” of the Services as they were found to “exist” and found to be “performed”, particularly having regard to the findings at [61] to [68], and the “unreal distinction at the heart of the applicant’s case” as described at [119] of the Primary Judge’s reasons: see also the remarks at [166]. None of options A, B or C put to the Primary Judge would alter the fact, as found, that the appellant was not and is not in the business of providing discrete bilateral Services, as specified, to General Practitioners and related health care professionals under and by reference to the trade marks, but rather, the appellant is in the business of operating medical centres at which the Services are deployed in the way earlier

described which directly engages patients and members of the public who may or may not become patients of one of the appellant's 71 medical centres. In other words, none of options A, B or C would make any material difference once the business model was that reflected at [44] of these reasons.

71 Moreover, because each trade mark failed to satisfy the elements of s 17 and s 41, none of options A, B or C could have saved the trade marks from the statutory imperative of rejection. There is no error in the treatment by the Primary Judge of the options put to her.

72 Now, the Full Court is invited to consider the curative possibilities in the newly proposed limitation.

73 The new limitation provides for non-use of each trade mark *at* the appellant's medical centres, in respect of the Services, in any way that may be *seen* or *heard* by patients or members of the public or other persons in the health sector who are not medical professionals. The proposed limitation does not address the fundamental difficulty, as found, that the services are integral to the appellant's operation of the 71 Primary Health Care medical centres and that, as found, the distinction sought to be made by the appellant that it uses the trade marks as a badge of origin of the appellant's Services in the bilateral provision of those Services to General Practitioners and other health care professionals, was *misconceived* and *unreal*. Rather, as found, the appellant provides the Services in a multilateral way as a bundle of services provided to General Practitioners, other health care professionals, patients, members of the public (potential patients) and other medical practitioners in the overall conduct and operation of 71 Primary Health Care medical centres.

74 In any event, the limitation does not postulate any non-use in relation to websites, electronic communications or other mechanisms by which the appellant as operator of 71 medical centres would seek to engage with General Practitioners, other health care professionals, patients, members of the public (potential patients) and other medical practitioners from time to time.

75 It is not at all clear to me that adopting the proposed restrictions on non-use would bring about the result that the connotation the marks have would no longer be likely to deceive or cause confusion amongst reasonable members of the cohort engaging with the appellant in the multilateral way described. Thus, I am not satisfied that the difficulties arising under s 43

are addressed by the proposed restriction. Nor am I satisfied that the proposed restriction would answer the difficulties arising under s 42.

76 Therefore, for my part, I would not be willing to exercise any power to impose the proposed condition.

77 Accordingly, the application for leave to appeal ought to be granted, as proposed by Rangiah J and the appeal ought to be dismissed with an order that the appellant pay the respondents' costs of the application for leave to appeal and the appeal.

I certify that the preceding seventy-seven (77) numbered paragraphs are a true copy of the Reasons for Judgment herein of the Honourable Justice Greenwood.

Associate:

Dated: 9 November 2017

## REASONS FOR JUDGMENT

### KATZMANN J:

78 I have had the benefit of reading the reasons of Rangiah J. I agree with the orders his Honour proposes. I also agree with his Honour that the challenges to the judgment covered by grounds 3–10 and 14 of the notice of appeal, capturing the findings with respect to the grounds of opposition under ss 41 and 42 of the *Trade Marks Act 1995* (Cth), must fail. In these respects, broadly speaking, I agree with his Honour’s reasons. I wish to make some additional observations, however, first about the s 41 ground, specifically in relation to the appeal against the primary judge’s approach to s 41(3), and secondly in relation to the applicant’s proposed limitation to restrict the mode of use of the trade marks.

79 I respectfully disagree with his Honour’s conclusion concerning the s 43 ground of opposition.

### **The ordinary signification of “primary health care”**

80 This is the subject of grounds 5 and 6 of the notice of appeal. It relates to the s 41 ground of opposition.

81 The question with which s 41(3) is concerned is the extent to which the trade mark is inherently adapted to distinguish the goods or services in respect of which the trade mark is sought to be registered with the goods or services of another person. The answer depends on “the ordinary signification” of the mark at the time the applicant filed its application for registration of the mark, that is to say, what the mark would have meant to “anyone ordinarily purchasing, consuming or trading in the relevant goods”: *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2014) 254 CLR 337 at [28], [30], [70], [71].

82 The applicant submitted that the expression “primary health care” has no ordinary meaning or, at least, that it had no ordinary meaning at the priority date (6 October 2009). Its general manager, Henry Bateman, deposed that he was unaware at that time that it had the meaning for which the respondents contended, had never heard the term used in this way, and had caused searches to be conducted of three “Standard English” dictionaries — the Macquarie, the Collins, and the Oxford — and none of them defined “primary health care”.

83 It does not appear that issue was taken with this latter proposition. The fact is, however, that both “primary health care” and “primary care”, which are listed as synonyms, have appeared

in one of the Oxford dictionaries (the Oxford Dictionary of English, second edition, revised) since at least 2005 and their meaning conforms to the meaning given to “primary health care” by the primary judge. The definition of “primary care” is:

**primary care** (also **primary health care**)

noun [mass noun] health care provided in the community for people making an initial approach to a medical practitioner or clinic for advice or treatment.

84 Even if Mr Bateman’s evidence is taken at face value, it is of no consequence. The term “health check” does not appear in the dictionary. Nor, for that matter, does “ham sandwich”. Each term, however, has an ordinary meaning. “Primary health care” is a composite expression. Like “health check” and “ham sandwich”, the ordinary meaning of the composite expression “primary health care” is derived from the meaning of its component parts.

85 The applicant further submitted that evidence to the effect that the expression was not widely understood by the public meant that it had no ordinary meaning. This submission must also be rejected. It is a non sequitur. That an expression may not be widely understood does not mean that it has no ordinary meaning. In *Eutectic Corporation v The Registrar of Trade Marks* (1980) 32 ALR 211; 1A IPR 550, cited with apparent approval by Gageler J in *Cantarella* at [91], Rogers J accepted that the word “eutectic” was not in ordinary use by members of the community, that most users of the applicant’s goods did not know or had forgotten its meaning, and there was no evidence of its use by other traders. Nevertheless, he found that it was an English word and a basic term in metallurgy, meaning melting at low temperature or melting readily. He concluded at 220 that as long as “there remains a need and use for that word by other traders in an honest description of their goods and the word retains its primary and technical meaning, it should remain free in the public domain”, citing *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511 at 514. Accordingly, he dismissed an appeal from a decision refusing to register the word as a trade mark in respect of certain goods for welding, soldering and brazing.

86 In the present case there was, in any event, evidence to the effect that medical practitioners understood that “primary health care” was, as her Honour found, “first level” or “first contact” health care. Despite the professed ignorance of his son, the evidence indicated that the name was chosen by the applicant’s founder, Dr Edmund Bateman, because it “reflected the services that would be available to patients attending the centres” (see the primary judge’s reasons at [44]).

- 87 The applicant contended, however, that it was important to have regard to the context in which the expression was being used. In other words, “primary health care” could mean first level or first contact health care but not when used to refer to the applicant’s business. I accept that there are many words with multiple ordinary meanings in which context will determine which meaning is apposite. Here, however, we are not concerned with a term that has multiple ordinary meanings but with the appropriation of an expression with an ordinary meaning for an extraordinary application: as a trade mark in respect of the designated services. As the primary judge observed (at [103]), the fact that a number of medical practitioners testified that, depending on the context, they would understand that the expression “primary health care” referred to the applicant as a corporate entity, does not affect its ordinary signification. Rather, the evidence indicates that, by repute, “primary health care” has acquired a secondary meaning. In the same way, there is only one ordinary meaning of “dove”, even though the word has been appropriated as a brand name for soap and related goods, and “poison” does not ordinarily mean perfume even though it may be known as a brand (or sub-brand) of perfume. The fact that a term has acquired a secondary meaning through use or by repute is not relevant to the question of whether it is inherently adapted to distinguish an applicant’s goods or services. “Inherent adaptability” “depends on the nature of the trade mark itself” and “cannot be changed by use or otherwise”: *Burger King Corporation v Registrar of Trade Marks* (1973) 128 CLR 417 at 424 (Gibbs J).
- 88 The applicant also submitted that the primary judge fell into error by approaching the question of the ordinary signification of “primary health care” by first considering what the expression meant to those involved in public policy. I agree with Rangiah J that it was not an error to take this matter into account. Further, although the primary judge first considered what the expression would signify to doctors and others involved in public policy, I do not accept that the primary judge gave the matter any greater consideration than it warranted.
- 89 Her Honour began in this way in order to dispose of an argument she understood the applicant to have made, based on a Commonwealth Department of Health publication. Moreover, she did not stop there. It is clear from her Honour’s reasons that she was concerned to determine what the expression would mean to all purchasers and consumers of the applicant’s services, including general practitioners.
- 90 There appear to have been two limbs to the applicant’s argument. The first was that, as at the date of the Department of Health publication (which was shortly before the priority date),

“primary health care is a term that [was] not widely used or even understood”. The second was that the meaning of “first level” or “first contact” care was restricted to those involved in public policy.

91 The primary judge rejected the first limb of the argument (at [92]) and pointed out (at [93]) that the evidence upon which the applicant relied contained “consistent references to the core meaning of first level or first contact health care”. Her Honour certainly referred to evidence from doctors involved in public health policy. But that evidence included evidence from one doctor (Dr Hobbs, Principal Medical Adviser to the Commonwealth Department of Health), the effect of which was that he had long understood that primary health care means “first level care”. He said that he knew it from his time as an undergraduate medical student in the 1970s, during the 23 years he spent in general practice, and while he worked in hospitals and for government. Another witness was Professor Harris, Foundation Professor of General Practice (since 1990) and (since 2003) Executive Director of the Centre for Primary Health Care and Equity at the University of New South Wales. The following extract from his affidavit appears in her Honour’s reasons:

Based on my qualifications, experience and expertise outlined above and in my curriculum vitae...and my review of the literature from the relevant time period referred to above, by 1994, I am of the opinion that “Primary Health Care” was a broad term which was used in the literature to denote **a segment or level of health care which most people use** and a broad approach towards equity of access, prevention and health promotion and community participation and engagement.

...

As a result of my qualifications, experience and expertise referred to above and my review of the literature during the relevant time period referred to above, **I understood the term “primary health care” as at 6 October 2009 to mean a segment or level of health care which most people use** and a broad approach towards equity of access, prevention and health promotion and community participation and engagement. This reflects my understanding of the literature and its common use by researchers and practitioners in Australia and internationally. It is my view that the opinions expressed in the literature and my view were also held by general practitioners and others in the health sector as at 6 October 2009. This is based on the publication of the terms in journals and other documents widely read by health professionals in Australia and promoted by governments.

(Emphasis added.)

92 Her Honour proceeded to dismiss the applicant’s submission that (as at the priority date) there was no singular or clear meaning of the phrase “primary health care” to those involved in public health policy. She explained why at [100]:

Thus far I have confined my observations to the area of public health policy. The applicant's case appeared to rest on a belief that there exists a clear dividing line between what it characterised as the "narrow" area of public health policy and the broader provision of clinical services. I do not consider that this distinction will bear too much weight. Although I am prepared to accept that some people working within health care have a focus on public health policy issues, in one sense, all GPs in Australia (if not all nurses, physiotherapists and others providing the first level of health care) work within the public health sector and thus are, to some extent at least, concerned with public health policy. To take GPs as the most prominent example (it being the case that the medical centres operated by the applicant or Idameneo [a subsidiary of the applicant] are centres from which GPs work), the other health professionals being allied to or supportive of that central service, it is plain that to describe a GP as being in "private practice" is an incomplete description because the Australian health care system means all GPs are trained within, regulated by and routinely interact with the national (that is, public) health care system.

- 93 Dealing with the second limb of the applicant's argument, her Honour emphasised (at [102]) that the understanding of the respondents' witnesses was informed by "their experience of the use of the phrase" in "both academic and clinical settings". She described as fallacious the applicant's contention that "primary health care" is a recent invention confined to those involved in public health policy. Indeed, as her Honour went on to observe, only one of 12 general practitioners who gave evidence for the applicant claimed to be unaware of the "first level health care" meaning of "primary health care" before the priority date. Furthermore, she pointed out that the applicant's own prospectus (from May 1998) referred to "the primary care industry", that the founder of the company adopted the corporate name because, amongst other things, it "reflected the services that would be available to patients attending the centres", and that the General Practitioner Conference and Exhibition, which the applicant sponsors, is "consistently described as Australia's 'primary health care event of the year'".
- 94 Having disposed of the applicant's argument and having concluded that general practitioners (the alleged target audience of the designated services) would have understood the expression "primary health care" to mean "first level" or "first contact" care, her Honour went on to find that, having regard to the ordinary meaning of the words making up the expression, a substantial number of people seeking access to health care at the priority date would have had a similar understanding.
- 95 The applicant maintained that the target audience does not include patients because the designated services are only marketed to medical professionals. For the reasons given by Rangiah J, I see no error in the primary judge's conclusion that the designated services are provided to both medical professionals and patients.

96 The last matter upon which I wish to comment is the proposition advanced by the applicant that the expression “primary health care” was not a direct reference to the designated services but an allusion (to services provided by the health care professionals working in the centres where the designated services are provided) and the corresponding argument that the primary judge erred by treating it as a direct reference. The significance of the proposition and its derivation can be gleaned from the judgment of the plurality in *Cantarella* at [35]–[44]. Referring to *In re Joseph Crosfield & Sons Ltd*; *In re California Fig Syrup Co*; *In re H N Brock & Co Ltd* [1910] 1 Ch 130 (CA) (dealing, respectively, with three word marks — “PERFECTION”, “CALIFORNIA SYRUP OF FIGS”, and “ORLWOOLA”), the plurality in *Cantarella* observed at [39]:

In explaining those disparate circumstances in which the “ordinary signification” of a word affected a grant of a monopoly of its use, their Lordships recognised that any word in English could *prima facie* be used as a trade mark but would not necessarily qualify to be registered as one. In drawing their conclusions in respect of the three trade marks under consideration, their Lordships indicated that the determination of whether a word has “direct reference” to goods (*prima facie* precluding a monopoly of its use) depends critically on the goods themselves, because a word containing a direct reference to goods in one trade may not convey any such direct reference to goods in another trade. An example given later was the use of the words “North Pole” for bananas.

(Citations omitted.)

97 The use of the words “North Pole” for bananas was suggested by counsel for the respondents in *A Baily & Co v Clark, Son and Morland* [1938] AC 557, a case about the registrability as a trade mark of the word “Glastonburys” in connection with sheepskin goods made by a business conducted in the town of Glastonbury. Picking up on that suggestion, Lord Maugham LC said that using the words “North Pole” as a trade mark in connection with bananas would be using a geographical name dislocated or disconnected from the origin of the goods so that, in effect, it is not a geographical name but a fancy name.

98 The primary judge did not find that the expression “primary health care” was a direct reference to the designated services. Her Honour found that it was (and is) “a direct description of the activity of which the Services form part”. She said that “every GP and every medical centre is providing primary health care and, in so doing and in one way or another, is performing or having performed the Services to enable that provision”. That at least some of the designated services are part of primary health care is illustrated by the fact that medical practitioners have a legal obligation to keep medical records which, as one of the

witnesses, Dr O'Donoghue, testified, "would require a sophisticated administrative system and the ability to store and retain records for a long period of time".

99 At the priority date, the *Medical Practice Regulation 2008* (NSW), for example, required that (with certain exceptions which are presently irrelevant) a registered medical practitioner or medical corporation engaged in the provision of medical services must, in accordance with Pt 2 and Sch 1, make and keep a record, or ensure that a record is made and kept, for each patient of the practitioner or corporation: reg 4(1). The record had to be kept for at least seven years from the date of the last entry or, in the case of a patient who was a minor at that date, until the patient reached (or would have reached) the age of 25: reg 6. All reasonable steps had to be taken to ensure that the records were kept "in such a manner as to preserve the confidentiality of the information that is contained in them and to prevent them from being damaged, lost or stolen": reg 8.

100 The primary judge held that "the existence of, and ability to access", "proper records of treatments, prescriptions and referrals" is "very closely related to, indeed part of, the provision of clinical services". Of that there can be no doubt.

101 In any case, having regard to the close connection between "primary health care" and the designated services, it could not be said that the expression is dislocated or disconnected from the services so as to be capable of distinguishing them. This is not at all like the application of "North Pole" to bananas.

### **The s 43 issues: connotation and likelihood of deception or confusion**

102 Section 43, it will be recalled, reads:

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.

103 There was no dispute that "connotation" signifies a secondary meaning: see *Pfizer Products Inc v Karam* (2006) 219 FCR 585 at [53]. A "connotation" in the proposed trade mark must be identified before the section is engaged: *McCorquodale v Masterson* [2004] FCA 1247; (2004) 63 IPR 582 at [25] (Kenny J) citing *T.G.I. Friday's Australia Pty Ltd v TGI Friday's Inc* (2000) 100 FCR 358 at 365.

104 The applicant argued that “primary health care” had no secondary meaning (and therefore no connotation) because its ordinary meaning is the applicant as a supplier of the designated services. Alternatively, the applicant argued, since the primary judge found (at [85] and [99]) (in connection with the s 41 ground of opposition) that the ordinary meaning of the expression “primary health care” was “first level or first contact health care”, then that must be the *denotation* of the mark; it could not be a *connotation* for the purposes of s 43. It follows, so the argument ran, that the connotation must be of an association with the applicant as an operator of medical centres and as a provider of the designated services. In that event, there could be no likelihood of deception or confusion.

105 I reject both arguments. As to the first, for the reasons given by Rangiah J and the additional reasons set out above, I am not persuaded that the primary judge erred in holding that the ordinary signification of “primary health care” was “first level or first contact health care”. The alternative argument is flawed for two reasons.

106 First, the applicant relies on the primary judge’s finding as to the ordinary signification of the words comprising the trade mark. That finding was made for the discrete purpose of answering the question posed by s 41(3). That question is anterior to the ultimate question posed by s 41 (whether the mark is capable of distinguishing the applicant’s goods or services). Sections 41 and 43 serve two different, though not unrelated, purposes. It is a mistake to deploy a finding made in answering one statutory question to answer an altogether different statutory question.

107 Second, the effect of the applicant’s argument is that the ordinary meaning of a trade mark or a sign within it cannot be a “connotation” for the purposes of s 43. If that were so, then a mark which is inherently deceptive by reason of its ordinary meaning (or one of several ordinary meanings) could be accepted for registration. Despite the change of language, having regard to the legislative history and purpose, the extrinsic material, and considering the Act as a whole, it is highly unlikely that Parliament intended such a result.

108 The first definition of “connotation” in the Oxford English Dictionary is: “the signifying in addition; inclusion of something in the meaning of a word besides what it primarily denotes; implication”; “that which is implied in a word in addition to its essential or primary meaning”. This is the meaning adopted by Kenny J in *McCorquodale* at [26]. Her Honour did not refer to the definition in the Macquarie Dictionary but the definition is similar.

109 The first meaning the Macquarie Dictionary gives to the verb “connote” is “to denote secondarily, signify in addition to the primary meaning; imply”. The noun “connotation”, however, is given a broader meaning:

1. the act or fact of connoting.
2. that which is connoted; secondary implied or associated meanings (distinguished from denotation): the word ‘bum’ has connotations of vulgarity.

110 A “denotation”, according to the Macquarie Dictionary is:

1. the meaning of a term when it identifies something by naming it (distinguished from *connotation*).
  2. the act or fact of denoting; indication.
  3. **something that denotes; a mark; symbol.**
- ...  
(Emphasis added.)

111 Plainly, if “connotation” in s 43 is to bear its ordinary meaning (and the respondents did not argue otherwise), then a distinction is to be made between the denotation of the mark and its connotation. The applicant contended that the primary judge failed to make the distinction because she failed to identify the denotation of the mark in her analysis under s 43. That contention is wrong. While her Honour determined that the ordinary signification of “primary health care” was “first level or first contact health care”, she did not adopt this as the denotation for the purpose of s 43 and treat it as the connotation, too. At [163] of her reasons, the primary judge expressly approved of the approach taken by the Registrar’s delegate, that the denotation of “Primary Health Care” in this context is as a trade mark denoting a connection between the applicant and its medical centres. In my respectful opinion, subject to the qualification that “Primary Health Care” denotes a connection between the applicant and the designated services (rather than a connection between the applicant and its medical centres), her Honour was correct to do so. Her Honour went on to hold (at [164]) that the connotation in the marks is that the applicant provides “first level or first contact health care”.

112 The same approach has been taken in a number of other decisions in the Trade Marks Office: see, for example, *Westchester Media Company, LP v Australian Polo Magazine Pty Ltd* [2000] ATMO 100; *Griffin Pastoral Co Pty Ltd v Ralph Fowler Wines Pty Ltd* [2005] ATMO 71; (2005) 68 IPR 171; *Spagnuolo v Mantra IP Pty Ltd* [2010] ATMO 110; (2010) 90 IPR

413; and *Mount Everest Mineral Water Limited v Himalayan Spring Mineral Water Pty Ltd* [2010] ATMO 85; (2010) 89 IPR 419. Although there was a successful appeal in *Spagnuolo (Mantra IP Pty Ltd v Spagnuolo (2012) 205 FCR 241)*, the delegate's interpretation of the section was not criticised or called into question. Certainly there is nothing in the judgments to which the Court was taken (*McCorquodale* and *Pfizer*) to suggest that this was an erroneous approach to the section.

113 The connotation with which s 43 is concerned is a meaning secondary to that which is denoted by the subject of the application to the Registrar. In other words, the section is concerned with whether the mark the subject of the application (or a sign contained in the mark) connotes something other than a connection in the course of trade between the relevant goods or services and the person who applied (or intended to apply) it to those goods or services.

114 This construction of s 43 is supported by contextual considerations.

115 I begin with the legislative history.

116 Gyles J observed in *Pfizer* at [52] that s 43 does not have a long pedigree. It is true that neither the *Trade Marks Act 1955* (Cth) nor the *Trade Marks Act 1905* (Cth) contained a provision in the same terms. Indeed, the word "connotation" did not appear in Australian trade mark law before the 1995 Act. Nevertheless, I respectfully disagree with his Honour's observation. The ancestral line, so to speak, of s 43 can be traced back to the 1905 Act, if not earlier.

117 The Registration of Trade Marks Act 1875 (UK), which established a register of trade marks in the United Kingdom, declared it to be unlawful to "register as part of or in combination with a trade mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a court of equity, or any scandalous design" (s 6).

118 The following year the Victorian Parliament passed *The Trade Marks Registration Act 1876* (Vic), s 8 of which included the following statement:

It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would not by reason of their being calculated to deceive or otherwise be deemed entitled to protection in a court of equity; or any scandalous designs.

119 In *Dunn's Trade Mark* (1890) 7 RPC 311 at 318 (HL) Lord Macnaghten observed that:

Ever since courts of equity have interfered to protect traders in the exclusive use of marks and words, which they have lawfully appropriated for the purpose of distinguishing their goods, it has been an established principle that this protection is not to be extended "to persons whose case is not founded in truth".

120 His Lordship held that registration should not be granted to "words which involve a misleading allusion or a suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood".

121 Section 11 of the Trade Marks Act 1905 (UK) provided that:

**It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.**

(Emphasis added.)

122 Thus, in *In re H N Brock & Co Ltd (Orlwoola)*, Fletcher Moulton LJ, referring to the trade mark "ORLWOOLA" (which was registered under the 1875 Act with respect to woollen goods) held on an application to remove the mark from the register that, because "all wool" could not be registered according to s 11 of the 1905 Act, neither could "ORLWOOLA", containing as it did the homophone "orlwool". His Lordship held, in a passage cited by the delegate in *Mount Everest* at [9]:

If the goods are wholly made of wool, the words are the natural and almost necessary description of them. If they are not wholly made of wool, it is a misdescription which is so certain to deceive that its use can hardly be otherwise than fraudulent. In either case the words are utterly unfit for registration as a trade mark.

123 In *In re Joseph Crosfield & Sons Ltd* the Court dismissed an appeal from a judgment in which registration of the word mark "PERFECTION" was refused: Farewell LJ said at 153 that the trade mark PERFECTION was calculated to deceive because the registration of "a mere laudatory word" could well mislead thousands of poor people who buy the soap into thinking that the Board of Trade had inquired into the merits of the soap and was satisfied that it was perfection. In the *Orlwoola* case at 155, Farewell LJ, like Fletcher Moulton LJ, held that, as spoken, not only was the mark not adapted to distinguish woollen goods of the trade mark owner but it was also calculated to deceive and for this reason, too, should be removed from the register.

124 Section 114 of the *Trade Marks Act 1905* (Cth) was in similar terms to the UK Act of the same year:

No scandalous design, and **no mark the use of which would by reason it its being likely to deceive** or otherwise be deemed disentitled to protection in a court of justice, or the use of which would be contrary to law or morality, **shall be used or registered as, a trade mark or part of a trade mark.**

(Emphasis added.)

125 This became s 28 of the *Trade Marks Act 1955* (Cth). It provided that:

**A mark:**

- (a) **the use of which would be likely to deceive or cause confusion;**
  - (b) the use of which would be contrary to law;
  - (c) which comprises or contains scandalous matter; or
  - (d) which would otherwise be not entitled to protection in a court of justice;
- shall not be registered as a trade mark.**

(Emphasis added.)

126 The substance of paras (b) and (c) now appear in s 42 of the 1995 Act. Paragraph (a) is captured by ss 43 and 60, as Branson J observed in *Registrar of Trade Marks v Woolworths* (1999) 93 FCR 365 at [79]:

The broad provision contained in s 28(a) of the 1955 Act is now reflected in two separate sections of the Act ss 43 and 60. Section 43, which is a ground for the rejection of an application for registration of a trade mark, looks to the inherent qualities of the trade mark of which registration is sought for the purpose of identifying whether the use of the trade mark would be likely to deceive or cause confusion. Section 60, which is a ground of opposition to registration, is concerned with whether the use of the trade mark of which registration is sought would be likely to deceive or cause confusion by reason of the reputation in Australia of another trade mark.

127 Section 42 of the *Trade Marks Act 1994* (Cth), which was never proclaimed, read as follows:

- (1) An application for the registration of a trade mark must be rejected if:
  - (a) the trade mark contains or consists of scandalous matter; or
  - (b) its use would be contrary to law or would not be entitled to protection in a court;
- (2) An application for the registration of a trade mark in respect of particular goods or services must be rejected if the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion

regarding:

- (a) the nature, quality, origin, intended purpose, or some other characteristic, of the goods or services; or
- (b) any connection or relationship that they may have with any particular person.

128 In *Pfizer* at [52] Gyles J expressed the opinion that the final form of s 43 in the 1995 Act is “a wider version” of s 42(2) but “with a similar purpose”. I respectfully agree.

129 The background to the introduction to the current Act is summarised in the Explanatory Memorandum to the *Trade Marks Bill 1995* (Cth):

The Bill derives from an exposure draft of the Trade Marks Bill 1994 which the Government released and invited public comment on in February 1994. The 1994 Bill incorporated changes to the trade marks legislation implementing the Government’s response to the July 1992 report of the Working Party to Review the Trade Marks Legislation, *Recommended Changes to the Australian Trade Marks Legislation*. Before the results of public consultation could be incorporated into the legislation, the Trade Marks Bill 1994 was introduced into the House of Representatives on 21 September 1994 as part of the legislation package necessary for Australia to accept the Agreement Establishing the World Trade Organization. The Trade Marks Act 1994 was enacted on 13 December 1994 but has not yet come into force.

130 The Working Party mentioned in this passage was convened in 1989 to review and streamline the trade marks legislation. In its report, it noted that international developments, including the Uruguay Round of the General Agreement on Tariffs and Trade (known as GATT) and the associated Agreement on Trade-Related Aspects of Intellectual Property Rights (commonly referred to as TRIPS), as well as other international ventures including discussions conducted by the World Intellectual Property Organisation (WIPO) on the harmonisation of trade mark laws, broadened the scope of its activities.

131 The relevant recommendation of the Working Party is to be found in §6A:

The following shall not be registered:

...

- (3) signs which, inherently, are likely in use to be deceptive or confusing;

...

132 Clause 43 of the Trade Marks Bill 1995 is in the same form as the enactment. Yet its Explanatory Memorandum states that cl 43 provides that an application for registration

must be rejected if the trade mark “because of some signification inherent to it, would be likely to deceive or cause confusion regarding a characteristic of the goods or services”. The origin of the reference to a “connotation” in s 43 is obscure. Not only is it not in the 1994 Bill, it is not mentioned by the Working Party and it does not appear in the TRIPS Agreement. Perhaps the legislative draftsman thought it was synonymous with “signification”. Regardless, I see no reason to conclude that the intention of the Parliament was any different from that suggested by the Explanatory Memorandum.

133 The principal object of statutory construction is to construe the relevant provision so that it is consistent with the language and purpose of all the provisions of the enactment: *Project Blue Sky Inc v Australian Broadcasting Authority* (1998) 194 CLR 355 at [69].

134 As French CJ, Gummow, Heydon and Bell JJ observed in *Health World Ltd v Shin-Sun Australia Pty Ltd* (2010) 240 CLR 590 at [22], the concern of the legislative scheme is with the purity of the Register:

It is a “public mischief” if the Register is not pure, for there is “public interest in [its] purity”. The concern and the public interest, viewed from the angle of consumers, is to ensure that the Register is maintained as an accurate record of marks which perform their statutory function – to indicate the trade origins of the goods to which it is intended that they be applied.

(Footnotes omitted.)

135 Section 43 — like its statutory predecessors — is particularly concerned with that function: ensuring that the mark indicates the trade origins of the goods or services to which it is intended that it be applied, and does not connote something else so as to be likely to deceive or cause confusion.

136 In sum, the “connotation” mentioned in s 43 means a “signification inherent to [the trade mark or a sign contained in the mark]”, secondary to what is denoted by the application, namely, that the mark is a badge of origin of the applicant’s goods or services. It follows that in the present case the denotation is the deployment of the mark to distinguish the designated services of the applicant from those of other traders and its connotation is the provision of first level or first contact health care. It follows that her Honour did not err as alleged.

137 The next question is whether the primary judge erred in holding that, because of this connotation, the use of the marks is likely to deceive or cause confusion.

138 The applicant argued that there could be no risk of confusion *first*, because her Honour had already found that the meaning of “primary health care” amongst health professionals and members of the public depended on the context of its use, *secondly*, because the evidence was that “primary health care is a term that is not widely used or even understood” by most members of the public, and *thirdly* because her Honour found that the applicant does in fact provide primary health care.

139 The first proposition ignores the primary judge’s finding (at [171]) that “the use of the mark in connection with the Services is likely to deceive and cause confusion to any person who is not privy to the applicant’s particular business model”. True it is that the applicant challenges that finding, but there was ample evidence to support it. Moreover, the finding about context was concerned only with the understanding of medical practitioners and only then with those who had given evidence. Even in that case her Honour found (at [105]) (and this finding is not challenged) that all but one of the general practitioners who had given evidence testified that they understood the expression “primary health care” (when not used to refer to first level or first contact health care) to refer to the corporate entity that owns, operates or runs the medical centres and not to the applicant (merely) as a provider of the designated services. She returned to the point at [114].

140 More importantly, s 43 is concerned with a connotation inherent in the mark itself (see above and also *Pfizer* at [53]). Consequently, reputation is irrelevant.

141 The second proposition takes the evidence out of context, as her Honour pointed out at [116] of her reasons. The evidence, which appeared in government policy documents, was to this effect:

[P]rimary health care is a term that is not widely used or even understood with most people simply distinguishing between the health care they receive in the community and the health care they receive in hospital.

While there are a number of definitions available, including from the World Health Organisation and the Australian Primary Health Care Research Institute, in practice there is no absolute or consistent view about whether particular settings and services are part of primary health care or not.

142 Her Honour observed at [116]:

[W]hen read in context it is apparent that there is no suggestion here that “primary health care” does not mean first level or first contact health care. Nor is it suggested that a member of the public, confronted with the phrase, would not understand this core meaning as a result of the ordinary meaning of each of the words. The health

care which people receive in the community is primary health care so the distinction which the report says most people draw in fact accurately reflects the health policy meaning of the phrase. The points being made are first that members of the public, in contrast to those involved in health care, do not think in terms of primary, secondary and tertiary health care and, second, that there is room for debate amongst those involved in health care about whether any particular activity involves primary health care or some other level of care. What reading the documents in context also makes plain is that, whatever the bounds of that potential for debate, the provision of medical services by GPs is a setting involving the provision of primary health care. It is an unequivocal example of the provision of what a substantial number of those involved in the health sector would know involved primary health care.

143 The third proposition must also be rejected. The question at hand is whether the use of the trade mark “*in relation to the ... services*” is likely to deceive or cause confusion. While, as her Honour found, some of the services are integral to the provision of primary health care, so, too, is clinical care, which is outside the scope of the registration. Her Honour disposed of a similar proposition at [174] of her reasons:

I do not accept that there is an “irreconcilable tension” in the respondents’ case. The tension was said to arise because the respondents contend, on the one hand, that the services are part of the provision of primary health care and, on the other hand, that the applicant does not actually provide first level health care. As the applicant put it, the respondents “cannot have it both ways”. The tension, on examination, does not exist. The point the respondents make is that the Services are an indispensable part of the provision of primary health care but are not, in and of themselves, clinical or medical care. As clinical care is itself an indispensable part of the provision of primary health care, any use of the trade marks in respect of the Services will create confusion on the part of any person not acculturated to the applicant’s particular business model. The confusion will arise because the unacculturated person (be it a GP, a person working in the health system or a member of the public) will assume (wrongly) that the applicant is in fact providing or is otherwise responsible for the clinical or medical care component of the primary health care offered at the applicant’s medical centres, and is not providing merely the Services. In my view, for such a person, this confusion is not merely a real or tangible danger, but almost inevitable given: (i) the ordinary meaning of primary health care, (ii) the close, indeed, essential connection between the Services and the clinical care provided at the applicant’s medical centres, (iii) the artificiality of the distinctions the applicant relies upon, and (iv) the fact that, on the evidence, the Services are but one part of what the applicant actually does at its medical centres (for example, according to the evidence, the applicant provides all equipment used in the provision of health care, as well as nurses who, I infer, would themselves be providing clinical care).

144 It was common ground that the applicant has never provided health care. In the absence of error as to the identification of the consumers of the designated services, the conclusion her Honour reached was inevitable. It is important to remember that the question of whether there is a likelihood of confusion is to be answered, not by reference to the way in which the mark has been used, but by reference to the way in which (following registration) it could

lawfully be used (*Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353 at 362). As her Honour remarked (at [69]), if the marks were registered, the applicant would be entitled to exclusive use of the marks, including the expression “primary health care” in any form including, for example, on patient records and, subject to the existence of a prohibition in law or any limitation placed on registration, on patient accounts, and during interactions (both oral and in writing) with members of the public and other participants in the health care sector. In those circumstances, there is at least a “real tangible danger” that a not insignificant number of consumers would wonder whether the applicant offered primary health care through, for example, doctors in its employ. That is enough to make out the respondents’ case: see, for example, *Woolworths* at [49]–[50] (French J).

145 The applicant submitted, however, that the market for the designated services was a specialised one, and therefore a finding to this effect could not be made in the absence of evidence from persons in that market. It contended there was no such evidence. The primary judge rejected a similar submission.

146 The applicant relied on *GE Trademark* [1973] RPC 297 at 321–322, *Interlego AG v Croner Trading Pty Ltd* (1992) 39 FCR 348 at 387–8 and *Idameneo (No 789) Ltd v Symbion Pharmacy Services Pty Ltd* [2011] FCAFC 164; (2011) 94 IPR 442 at [61] (which concerned a company related to the applicant).

147 In *GE*, a case concerning the sale of electrical machinery, at 321 Lord Diplock said:

[W]here goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence, is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused.

148 His Lordship proceeded to contrast the position with situations in which goods are sold to the general public.

149 In *Interlego* at 387–8, Gummow J (Black CJ and Lockhart J agreeing) observed by way of *obiter dicta* that evidence of consumers and retailers as to the likelihood of deception is critical if a specialised market is involved (citing *GE*).

150 The primary judge considered that evidence was not required in this case, holding that the designated services do not constitute “a highly specialised or technical field”. The applicant argued that her Honour’s focus was wrong. That submission must be accepted. Whether a market is specialised or not does not depend on whether the relevant services are specialised. Still, there are several difficulties with the applicant’s submission.

151 *First*, the primary judge found (at [176]), that the applicant did not establish that the market for the applicant’s services is a specialised market. That finding is not affected by appealable error because, as her Honour also found, the market for the applicant’s services was broader than health professionals. Unless the latter finding is set aside for error, the principle in *GE* does not apply.

152 *Secondly*, *Idameneo* does not assist. In that case it was common ground that the marks in question were applied to services supplied only to a specialised market: see *Idameneo* at [57].

153 *Thirdly*, despite the submission, the applicant conceded at the hearing of the appeal that the absence of evidence of confusion was not decisive.

154 *Finally*, the primary judge held (at [166]), in any event, that there was evidence of likely confusion amongst health professionals, a finding the applicant appears to have overlooked. Perhaps the clearest example appears in the affidavit of Dr Stephen Moore, who was not only a general practitioner but also a shareholder in the applicant. He said that he understood at the time that the applicant ran a business operating a chain of medical centres at which it “provided support services to GPs and medical services to the public”. Since it is uncontroversial that the applicant has never provided medical services to the public, this is evidence of actual confusion.

155 For these reasons I would dismiss grounds 11 to 13 of the notice of appeal.

### **The proposed limitation**

156 On the last day of the hearing, the applicant handed up a “proposed condition” which it invited the Court to impose on the registration of the trade marks to limit the mode of use of the marks. It argued in the alternative that the Court could exercise its power to impose a differently worded condition. In its supplementary written submissions, filed after the hearing, the applicant amended (without leave) the terms of its proposal “to indicate what [it] consider[ed] on reflection to be the more appropriate form of limitation on user”.

157 I agree with Rangiah J that the respondents' submissions should be accepted and that leave should not be granted to the applicant to raise this new argument on appeal. For the reasons given by his Honour, and for the additional reason that the proposal would not preclude use of the marks outside the confines of the applicant's medical centres, the proposed condition does not overcome the obstacles to registration imposed by ss 42 and 43 of the Act. Moreover, on the assumption that this Court has the power to impose some other condition or limitation, I would not be disposed to do so. The applicant has had five attempts at drafting a suitable one. As these successive failures demonstrate, it is no simple task. Certainly, one does not readily come to mind.

I certify that the preceding eighty (80) numbered paragraphs are a true copy of the Reasons for Judgment herein of the Honourable Justice Katzmann.

Associate:

Dated: 9 November 2017

## REASONS FOR JUDGMENT

### RANGIAH J:

158 The applicant has applied, pursuant to s 195(2) of the *Trade Marks Act 1995* (Cth) (**the TMA**), for leave to appeal against a judgment of a single judge of this Court.

159 By that judgment, the primary judge dismissed the applicant's appeal against a decision of a delegate of the Registrar of Trade Marks to refuse the applicant's application for registration of two trade marks. Her Honour held that the respondents had established grounds for rejection of the application under each of ss 41, 42 and 43 of the TMA.

160 For the reasons that follow, there should be a grant of leave to appeal, but the appeal should be dismissed. As leave to appeal shall be granted, it is convenient to refer to the applicant as "the appellant" throughout these reasons.

### BACKGROUND

161 The appellant is named "Primary Health Care Limited". Its business consists of a medical centre division, a diagnostic pathology and medical imaging division, and a medical software division. It uses "Primary Health Care" as a brand for the business as a whole and, in particular, for its medical centre division.

162 On 6 October 2009, the appellant applied for the registration of two trade marks (**the trade marks**) for services. The first is a word mark, PRIMARY HEALTH CARE. The second is a logo as follows:



163 The application initially sought registration of the trade marks in relation to services within classes 35, 42 and 44 (which includes medical services) under reg 3.1 and Sch 1 of the *Trade Marks Regulation 1995* (Cth). The application was subsequently confined to class 35. The services (**the Services**) are specified in the application as follows:

Class 35: Medical centre business management; medical centre business administration; service provider to medical professionals, namely provider of: administrative support services, billing and invoicing services, reception and telephone answering services, patient booking services, patient file management services including management of access to patient files, typing services, account-keeping and book-keeping services, preparation of business reports, systemisation of information into computer databases, professional business consultancy,

computerised file management, business and information management services, ordering services, processing of purchase orders.

164 The appellant describes the Services as “back office services” for medical and allied health practitioners.

165 The respondents, the Crown in the right of the Commonwealth and the Crown in the right of each State and Territory, opposed registration of the trade marks. On 24 September 2014, the registrar’s delegate decided that the respondents had established their ground of rejection under s 43 of the TMA, which prohibits registration of a trade mark which is likely to deceive or cause confusion because of a connotation it contains: see *Commonwealth v Primary Health Care Ltd* [2014] ATMO 92. The delegate did not decide whether the grounds under ss 41 and 42 of the TMA were also established.

166 The appellant then appealed to this Court pursuant to s 56 of the TMA. The appeal was by way of hearing de novo, requiring determination of the application for registration on its merits: see *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 365 at 376 – 377. The parties led substantial further evidence. The primary judge accepted that the respondents had established grounds for rejection under each of ss 41, 42 and 43 of the TMA, with the consequence that the appeal was dismissed.

167 Dr Edmund Bateman commenced a business which involved opening and managing a medical centre in Sydney in 1985. He opened a second medical centre in 1990. In May 1994, Dr Bateman incorporated a company through which the two medical centres were to be managed. In December 1994, the company’s name was changed to “Primary Health Care Pty Ltd”. The business operated under the name “Primary Health Care”.

168 Thomas Bateman, the son of Dr Edmund Bateman and the present general manager of the appellant’s medical centre division, deposed that:

I recall from discussions with Dr Bateman in late 1994 that he chose the name PRIMARY HEALTH CARE because he considered it to be unique and memorable, and reflected the services that would be available to patients attending the centres.

169 The appellant listed on the Australian Stock Exchange on 3 July 1998. It continued to operate its business as “Primary Health Care”.

170 The appellant currently operates and manages 71 medical centres and provides services to over 1,200 health care professionals in Australia. It is the largest provider of medical centre management and administration support services in Australia.

- 171 The appellant has a number of direct competitors, including Sonic Health Care, Alpha Health Care, Health Scope Medical Centres, Foundation Health Care, Alpha Health Care, Endeavour Health Care and Immediate Health Care.
- 172 The establishment of a medical centre by the appellant typically commences with identification of a suitable site for a medical practice and negotiation of a long-term lease. The site is refurbished for use as a medical practice supporting between 10 and 30 general practitioners (**GPs**). The appellant then recruits GPs, medical specialists, physiotherapists, dentists and other health professionals (collectively, **health practitioners**). A wholly owned subsidiary of the appellant, Idameneo Pty Ltd (**Idameneo**), owns and operates the centres and enters into contracts with the health practitioners. The appellant also recruits employees, including receptionists, accounts staff, clerical staff, practice managers, operational staff and nurses.
- 173 The recruited health practitioners conduct their practices at the appellant's medical centre. The appellant provides them with consultation rooms and the equipment and services required for their practices. The services provided by the appellant include medical centre management and support services, such as reception and telephone answering services, secretarial services, patient management services, bulk billing and invoicing, and patient file management. The appellant also provides business management services, including provision of necessary supplies and equipment, professional accreditation and regulatory reporting requirements, bookkeeping, accounting, business reporting, information technology, human resources management, occupational health and safety and property management services. The appellant charges each health practitioner a service fee based on a percentage of the gross income he or she generates.
- 174 Typically, patients will attend the centre and register with the centre receptionist. The patient has the option of waiting for the doctor or other health provider of their choice to become available or waiting for the first available practitioner. After the consultation, the patient deals with the reception staff to organise any follow up appointments. The appellant's staff also deal with all necessary administrative tasks, such as updating patients' records, processing Medicare payments and the like.
- 175 The primary judge found that the appellant does everything necessary to provide and operate the medical centres, and that the only thing the appellant does not do and is not responsible

for is the provision of clinical or medical care. The health practitioners alone provide clinical care.

### **THE PRIMARY JUDGMENT**

176 It will be necessary to describe the reasons of the primary judge in detail later in these reasons. For the moment, it is enough to give an overview of her Honour's reasons.

177 The primary judge identified the issues in the case as:

- (1) The scope of the proposed registration.
- (2) Whether the trade marks are inherently adapted to distinguish the appellant's Services: s 41(3) of the TMA.
- (3) Whether the trade marks do, or will, distinguish the appellant's Services: s 41(5) and 41(6) of the TMA.
- (4) Whether the trade marks are likely to deceive or cause confusion because of a connotation they have: s 43 of the TMA.
- (5) Whether use of the trade marks would be contrary to law: s 42 of the TMA.

#### **The First Issue: The scope of the proposed registration**

178 The primary judge identified the first issue as "the scope of the proposed registration". By this, the primary judge was referring to the nature of the Services and to whom and how they are provided by the appellant.

179 Her Honour noted that there was a fundamental difference between the parties about the nature of the Services. As 41(3) of the TMA requires consideration of the ordinary signification of the trade marks to the "target audience" for the designated goods or services, it is necessary to identify that audience. The appellant contended that it provides the Services only to health practitioners and they are solely the target audience. The respondents argued that the Services are also provided to patients and people involved in public health care and that they are also part of the target audience.

180 The primary judge held that the persons paying for the Services, the health practitioners, are not the only persons who receive the Services, or, at least, are not the only persons "concerned with" the Services. Her Honour found that many of the Services are also provided by the appellant to patients. Accordingly, patients are part of the target audience.

181 The scope of the Services was also relevant to the application of s 41(5) of the TMA. The appellant submitted that it is in the business of providing the Services to health practitioners. Her Honour found that the appellant is instead in the business of *operating medical centres*. It is as part of that business, and not otherwise, that the appellant provides the Services. Her Honour found that the appellant is not in the business of providing the Services themselves.

182 The primary judge considered that the appellant's misconceptions affected the entirety of the appellant's case, concluding at [64]:

As such, the focus of the applicant's case is off target and at odds with the evidence. The consequences of this disconnect run through every aspect of the case. First, the Services cannot be considered as if they exist in isolation because that is not how the Services are provided. Second, no matter how often the applicant repeats it, I am unable to accept that the Services are directed only to GPs and health professionals; the public and other participants in the health care sector are provided with some of the Services and are potentially concerned with all of the Services. Third, this in turn affects the question of whether the marks are inherently adapted to distinguish when the Services are provided in and from a medical centre which, as discussed below, involves the quintessential form of primary health care. Fourth, this has led to the proposed amendments which, as discussed below, involve a form of self-negating description of the Services. Fifth, the applicant has tried to establish acquired distinctiveness by use of the marks in respect of the Services when the applicant does not market the Services at all in and of themselves, but markets to GPs and allied health professionals a particular form of practice in which, amongst many other things (including the basic requirements of rooms, equipment, medical supplies, cleaning and maintenance), the applicant also provides the Services.

183 Her Honour found that the appellant provides many of the Services to health practitioners, to patients and to all other participants in health care who interact with the health practitioners in the medical centres. Her Honour also found that many of the Services are "indivisible from or integral" to the provision of clinical care by the health practitioners at the centres.

184 The primary judge then concluded that it is the ordinary signification of the words "Primary Health Care" to all health professionals, other participants in the health care system in Australia, and the Australian public as potential patients at the medical centres which is relevant for s 41(3) of the TMA. That finding was also relevant to issues arising under ss 42 and 43 of the TMA.

185 Her Honour considered three possible amendments to the specifications proposed by the appellant, but rejected those amendments as having no utility because they made no material difference to the nature of the Services, to whom they are provided and how they are performed.

**The Second Issue: Whether the trade marks are inherently adapted to distinguish the Services**

186 The primary judge then turned to the second issue, whether the trade marks are inherently adapted to distinguish the Services for the purposes of s 41(3) of the TMA.

187 The respondents submitted that the ordinary signification of “primary health care” is “first level” or “first contact health care”. They argued that the trade marks are not inherently adapted to distinguish the Services as being provided by the appellant to any extent because they merely *describe* the kind of services of which the Services form part (ie primary health care).

188 The appellant submitted that there is no ordinary or plain meaning in the English language for the phrase “primary health care”. It argued that the word “primary” is not commonly used or understood to describe medical services or sections of the health care system. It submitted that it does not provide primary health care, so the phrase is not descriptive of the Services. It argued that the phrase instead alludes to clinical services provided by health practitioners at the centres.

189 The primary judge first considered the ordinary signification of the phrase to people involved in public health policy in Australia. Her Honour concluded that to that class, “primary health care” means “first level or first contact health care”.

190 The primary judge then examined the evidence called by the appellant from twelve GPs as to the meaning of “primary health care”, finding, relevantly, that five were aware of the meaning of the phrase as “first level or first contact health care” before the priority date. Her Honour also found that before the priority date the appellant had itself used the phrase “primary health care” to refer to first level or first contact health care in Australia.

191 Her Honour concluded that as at the priority date, the ordinary signification of the phrase “primary health care” to a substantial number of persons involved in the provision of health care in Australia was the first level of health care available in the health system, incorporating GPs, but also other health professionals, who would be the first point of contact between an individual and the health care system (or, in her Honour’s shorthand, “first level/first contact health care”).

192 The primary judge then considered how members of the general public, or patients, would understand the phrase “Primary Health Care”. Her Honour concluded that a substantial

number of people seeking to access health care would also understand the reference to be to a form of health care, being “first level/first contact health care”. They would do so because of the ordinary meaning of each word which makes up the phrase.

193 Her Honour found that the ordinary signification of “primary health care” to the target audience is “first level/first contact medical care”. Her Honour reasoned that, as the provision of the services is indivisible or indistinguishable from the provision of clinical care, the phrase describes the Services. It followed that other traders may wish to use the marks for their ordinary signification.

194 Her Honour found that the inclusion of the logo did not confer any additional inherent adaptability upon the mark PRIMARY HEALTH CARE. Her Honour concluded that the trade marks are not inherently adapted to distinguish the Services from the services of others of the same kind to any extent.

### **The Third Issue: Whether the trade marks do or will distinguish the Services**

195 The primary judge then turned to the third issue, namely whether the trade marks do, or will, distinguish the Services. Section 41(5) of the TMA had no application in light of her Honour’s finding that the trade marks are not inherently adapted to distinguish the Services to any extent. However, in case that finding was wrong, her Honour proceeded to consider s 41(5) on the assumed basis that the trade marks distinguish the Services to some extent.

196 Her Honour accepted that the appellant had used the word mark PRIMARY HEALTH CARE before the priority date to identify the appellant as the source of its business of providing medical centres. However, her Honour found that the trade marks had not been used by the appellant to distinguish *the Services themselves*, and that the marks did not in fact distinguish the Services. Further, the logo mark had not been used before the priority date.

197 The primary judge found that other organisations involved in similar activities may, without improper motive, wish to use the phrase “primary health care” to describe their activities.

198 Her Honour concluded that the combined effect of the matters set out in s 41(5)(a)(i)–(iii) of the TMA did not mean that the marks do, or will, distinguish the appellant’s Services from the same services offered by others.

199 The primary judge held that her conclusions in respect of s 41(5) of the TMA also answered the enquiry under s 41(6). Her Honour was not satisfied that because of the extent to which

the appellant had used the marks before the priority date, the marks distinguished the Services as being those of the appellant. The trade marks were taken to not be capable of distinguishing the Services and, therefore, could not be registered

**The Fourth Issue: Whether the trade marks are likely to deceive or cause confusion**

200 The primary judge then turned to the question of whether the marks were likely to deceive or cause confusion within s 43 of the TMA. Her Honour held that the phrase “Primary Health Care” has a clear connotation, that connotation being, not the appellant as the source of the Services, but the source of first level or first contact health care.

201 Her Honour held that the use of the marks conveyed a false impression that the appellant is providing or is responsible for the clinical components of primary health care. Her Honour held that the marks are likely to deceive or cause confusion and that the respondents had established the ground under s 43 of the TMA.

**The Fifth Issue: Whether the use of the trade marks could be contrary to law**

202 Finally, the primary judge considered whether, under s 42(b) of the TMA, use of the trade marks in respect of the Services would be contrary to law, namely s 18 of the *Australian Consumer Law* (Schedule 2 to the *Competition and Consumer Act 2010 (Cth)*) (**the ACL**). That section prohibits conduct in trade or commerce that is misleading or deceptive or is likely to mislead or deceive.

203 Her Honour held that use of the trade marks would misrepresent that the appellant provides primary health services and is responsible for the health and medical services provided by the practitioners within the appellant’s medical centres.

204 Her Honour held that the respondents had established grounds for rejection of registration of the trade marks under ss 41, 42 and 43 of the TMA and that registration should be refused.

**THE APPLICATION FOR LEAVE TO APPEAL**

205 The appellant is required, under s 195(2) of the TMA, to seek leave to appeal against the judgment of the primary judge.

206 There are no exhaustive or rigid rules of practice or criteria governing the grant of leave to appeal: *Adam P Brown Male Fashions Pty Ltd v Philip Morris Inc* (1981) 148 CLR 170 at 177. However, two important factors are whether the judgment is attended by sufficient doubt to warrant it being reconsidered by the Full Court, and whether substantial injustice would

result if leave were refused, supposing the judgment to be wrong: *Decor Corporation Pty Ltd v Dart Industries Inc* (1991) 33 FCR 397 at 398-399; *Samsung Electronics Company Ltd v Apple Inc* (2011) 217 FCR 238 at [26]. These factors are interconnected.

207 It is necessary to say something about the nature of the proposed appeal and the appellant's presentation of its case.

208 An appeal against a judgment of a single judge of this Court is by way of rehearing. In *Allesch v Maunz* (2000) 203 CLR 172 at [23], the High Court confirmed that in an appeal by way of rehearing, "the powers of the appellate court are exercisable only where the appellant can demonstrate that, having regard to all the evidence now before the appellate court, the order that is the subject of the appeal is the result of some legal, factual or discretionary error".

209 The appellant's draft notice of appeal superficially recognises the necessity to demonstrate error on the part of the primary judge. However, as will be seen, most of the grounds and their particulars assert merely that the primary judge erred in making certain findings without identifying what the error was. Accordingly, it is necessary to turn to the appellant's written and oral submissions to try to understand what errors the appellant asserts. But much of the appellant's submissions consist of merely asserting propositions of law and fact rather than identifying error and, even where errors are identified, the submissions fail to correlate the errors with the grounds of appeal.

210 Further, the appellant complains repeatedly and emphatically in its submissions about the primary judge's "approach" to various issues. For example, the appellant's written submissions assert error in her Honour's "approach to the classification of services". In oral submissions, the appellant's senior counsel said "But it's really about approach". The appellant's complaints "about approach" tend to mask a lack of specificity in identifying the errors said to have been made by the primary judge.

211 These difficulties with the draft notice of appeal and written and oral submissions have meant that the appellant's case in its entirety cannot easily be identified, understood or encapsulated.

212 However, as will be seen, the appellant is able to demonstrate error on the part of the primary judge in two respects. Although those errors do not ultimately affect the outcome of the case, the appellant should be granted leave to appeal and to file the draft notice of appeal.

## THE APPEAL

213 The appellant's notice of appeal is structured to first deal with asserted errors in the primary judge's findings concerning "General" matters and then sequentially with findings relevant to ss 41(3), 41(5), 41(6), 43 and 42 of the TMA.

214 The "General" grounds are concerned with the primary judge's analysis of the scope of the Services specified in the application for registration. That analysis fed into her Honour's consideration of each ground for rejection of the trade marks. In order to give the "General" grounds context, it is convenient to consider the primary judge's findings concerning the scope of the Services together with the legislation and principles relevant to s 41(3) of the TMA.

### **The legislation and the principles relevant to s 41(3) of the *Trade Marks Act 1995* (Cth) ("TMA")**

215 Section 17 of the TMA defines the expression "trade mark". That section provides:

#### **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.

216 Section 20 of the TMA describes the rights given to the registered owner of a registered trade mark:

#### **20 Rights given by registration of trade mark**

(1) If a trade mark is registered, the registered owner of the trade mark has, subject to this Part, the exclusive rights:

(a) to use the trade mark; and

(b) to authorise other persons to use the trade mark;

in relation to the goods and/or services in respect of which the trade mark is registered.

...

(2) The registered owner of a trade mark has also the right to obtain relief under this Act if the trade mark has been infringed.

...

217 Section 27(1) of the TMA provides that a person may apply for the registration of a trade mark in respect of goods and/or services if certain conditions are met. Section 33(1) of the TMA requires the Registrar of Trade Marks (**the Registrar**), after examining the application,

to accept the application unless he or she is satisfied that the application has not been made in accordance with the TMA or there are grounds under the TMA for rejecting it.

218 Division 2 of Pt 4 of the TMA (ss 39 - 44) is headed, “Grounds for rejecting an application”. Section 41 was amended by the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth). However, the amendments do not apply in the present case, where the priority date precedes the amendments. Section 41 in its form prior to the amendments was as follows:

**41 Trade mark not distinguishing applicant’s goods or services**

(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

...

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant’s goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

...

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

(a) the Registrar is to consider whether, because of the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances;

the trade mark does or will distinguish the designated goods

or services as being those of the applicant; and

- (b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services - the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and
- (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services - the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

...

- (6) If the Registrar finds that the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:
  - (a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant - the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;
  - (b) in any other case - the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

...

219 An essential characteristic of a trade mark is that it is used to distinguish the goods or services of a trader from the goods or services of other traders: s 17 of the TMA; *E & J Gallo Winery v Lion Nathan Pty Ltd* (2010) 241 CLR 144 at [42]. A trade mark may in fact distinguish goods and services, or it may not. If a trade mark is not capable of distinguishing designated goods or services, then it may be used but cannot be registered. If it is not registered, the owner does not acquire the monopoly on the use of the trade mark conferred under s 20 of the TMA.

220 Section 41(2) of the TMA in its form prior to the amendments was central to the Registrar's decision as to whether or not a trade mark is to be registered. That provision required the Registrar to reject an application for a trade mark *if the trade mark is not capable of distinguishing the applicant's goods or services* in respect of which the trade mark is sought to be registered from the goods or services of other persons.

221 Sections 41(3) - (6) then prescribed how the Registrar was to decide whether the trade mark satisfies the requirements of s 41(2). Under s 41(3), the first step was to consider *the extent to which the trade mark is inherently adapted to distinguish* the designated goods or services from the goods or services of other persons. If the Registrar could not decide the question posed under s 41(2) on the basis of inherent adaptation to distinguish, s 41(4) required the Registrar to then apply s 41(5) or s 41(6).

222 There are a number of well-established principles concerning the interpretation and application of s 41(3) of the TMA. In *Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd* [2017] FCAFC 56 at [236], the Full Court summarised the principles as follows:

- (1) In deciding whether or not a trade mark is capable of distinguishing the designated services from the service of others, the first question is the extent to which the trade mark is inherently adapted to distinguish the designated services from those of others: s 41(2) and (3).
- (2) In determining whether a trade mark is inherently adapted to distinguish the services of a trader, the answer largely depends upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their goods: *Clark Equipment Co v Registrar of Trade Marks* (“*Clark Equipment*”) (1964) 111 CLR 511 per Kitto J at 514.
- (3) The question of whether a trade mark is adapted to distinguish the services of the applicant is to be tested by reference to the *likelihood* that other persons, trading in goods of the relevant kind and being actuated only by proper motives (in the exercise of the common right of the public to make honest use of words forming part of the common heritage for the sake of the signification which the words *ordinarily possess*) will think of the word and want to use it in connection with similar goods in any manner which would infringe the trade mark once registered: *Clark Equipment* at 514.
- (4) Directly descriptive words, like geographical names, are not *prima facie* suitable for the grant of a monopoly conferred by registration of a trade mark because use of them, as trade marks, will “rarely eclipse” their “primary” (that is, their ordinary) signification. Such words (or a word) are unlikely to be inherently, that is to say, “in [their] own nature”, adapted to distinguish the applicant’s goods. Traders may legitimately want to use such words in connection with their goods or services “because of the reference they are ‘inherently adapted to make’ to those goods”: *Cantarella Bros Pty Limited v Modena Trading Pty Limited* (“*Cantarella*”) (2014) 254 CLR 337 at [57] per French CJ, Hayne, Crennan and Kiefel JJ.
- (5) The principles derived from the observations of Kitto J in *Clark Equipment* apply with as much force to directly descriptive words as they do to words which are, according to their ordinary signification, geographical names: *Cantarella* at [57].
- (6) In determining whether a word is (or words are) inherently adapted to distinguish the goods or services of an applicant, the question is to be

examined from the point of view of the “possible impairment” of the rights of “honest traders” and from the “point of view of the public”: *Cantarella* at [59].

- (7) In determining whether a word contains (or words contain) a “direct reference” to the relevant goods or services (and thus prima facie not registrable as a trade mark) or whether the word (or words) makes a “covert and skilful allusion” to the relevant goods or services (and thus prima facie registrable as a trade mark), the “ordinary signification” of the word or words to persons who will purchase, consume or trade in the goods or services, must be considered: *Cantarella* at [59].
- (8) Where the question is whether there are other traders who may legitimately want to use or apply a word or words in connection with their goods or services (other than a geographical name or a surname), the test refers to the “legitimate desire of other traders to use a word which is directly descriptive in respect of the same or similar goods”: *Cantarella* at [59].
- (9) Consistent with the proposition at (7), the test described at (8) does not encompass the desire of other traders to use a word or words which in relation to the goods or services are “allusive or metaphorical”: *Cantarella* at [59].
- (10) In determining whether a trade mark is inherently adapted to distinguish the designated goods or services for the purposes of s 41(3), the ordinary signification of the word or words are to be considered from the perspective of “any person in Australia concerned with the goods or services to which the trade mark is to be applied”: *Cantarella* at [70].
- (11) Consideration of the “ordinary signification” of any word or words said to constitute a trade mark is “crucial”: *Cantarella* at [71]. That is so whether the word (or words) is said not to be registrable because: it is not an invented word and has direct reference to the character or quality of the goods or services; or, the word is laudatory; or, the word is a geographical name; or, the word has either lost its distinctiveness or it never had the requisite distinctiveness from the outset: *Cantarella* at [71].
- (12) The process of reasoning in addressing s 41(3) of the Act involves first identifying the “ordinary signification” of the word in question and then undertaking an enquiry into whether other traders might legitimately need to use the word in respect of their goods: *Cantarella* at [71]. If a word contains an allusive reference to goods or services it is, prima facie, qualified for the grant of a monopoly as a trade mark under the Act. If, on the other hand, the word is understood, by the target audience, as having a directly descriptive meaning in relation to relevant goods or services then, prima facie, the proprietor is not entitled to a monopoly in respect of the word. As a general proposition, a word or words which are prima facie entitled to a monopoly secured by registration as a trade mark under the Act, according to this method, are inherently adapted to distinguish: *Cantarella* at [71].

223 Some of these principles will require elaboration later in these reasons in the context of this case. In particular, it will be necessary to consider: what is meant by “inherently adapted” in s 41(3) of the TMA; the relevance of nature of the designated services and way the services

are intended to be used; and from whose perspective it is to be judged whether the mark is adapted to distinguish.

224 For the moment, two further matters should be mentioned. Firstly, the capacity to distinguish required under s 41(3) and (5) of the TMA must be possessed by the trade mark at the priority date: *Austereo Pty Ltd v DMG Radio (Australia) Pty Ltd* (2004) 209 ALR 93 at [30]. The priority date is, pursuant to s 12(b) of the TMA, the day that would be the date of registration of the trade mark if the trade mark were registered. Under s 72(1) of the TMA, the registration of a trade mark is taken to have had effect from and including the filing date in respect of the application for registration. Under s 6 of the TMA, the filing date is the day on which the application was filed. That date, and therefore the priority date, was 6 October 2009.

225 Secondly, prior to the amendments, a party opposing registration of a trade mark carried the onus of proving that the mark is not inherently adapted to distinguish under s 41(3) of the TMA, but if that onus was discharged, the applicant for registration bore the onus of proving that ss 41(5) or (6) applied: see *Food Channel Network Pty Ltd v Television Food Network GP* (2010) 185 FCR 9 at 25-30; *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* (2002) 122 FCR 494 at [22]; *Sports Warehouse Inc v Fry Consulting Pty Ltd* (2010) 186 FCR 519 at [29]-[40]; *Mantra IP Pty Ltd v Spagnuolo* (2012) 205 FCR 241 at [32]-[38]; *Apple Inc v Registrar of Trade Marks* (2014) 227 FCR 511 at [10]. The 2012 amendments have altered the position so that the onus remains on the opponent throughout the assessment under s 41 of the TMA. Those amendments do not affect this case.

### **The “General” grounds of appeal**

226 The appellant’s “General” grounds are:

#### **General**

- 1 The primary judge erred in dismissing the appeal from the Decision of the Delegate (at J [7], [163] and order 1).
- 2 The primary judge erred in finding (at J [7], [126], [151]-[152], [160], [163], [188], [190], [191]) that the respondents had established the grounds of opposition under ss 41, 42 and 43 of the *Trade Marks Act 1995* (the Act) and that registration of the Trade Marks should be refused.
- 3 The primary judge erred in finding (at J [60]-[68], [80], [118]-[119], [124], [143], [153]) that the Services provided by the appellant are not separate from other activities engaged in by the appellant in the operation of its medical centres, and are indivisible or indistinguishable from, or integral to, the provision of clinical care to patients who attend the appellant’s medical

centres.

- 4 The primary judge erred in finding (at J [55], [74], [80], [81]) that it is not possible to control the scope of the registration of the Trade Marks in the manner proposed by the appellant.

227 The first two grounds in the notice of appeal are so vague as to be meaningless and will not be further considered.

228 The third ground of appeal challenges two findings which the appellant asserts were made by the primary judge, namely that:

- (1) the Services provided by the appellant are not separate from other activities engaged in by the appellant in the operation of its medical centres;
- (2) the Services are indivisible or indistinguishable from, or integral to, the provision of clinical care to patients who attend the appellant's medical centres.

229 Ground 4 of the notice of appeal asserts that the primary judge erred in finding that it is not possible to control the scope of the registration of the trade marks in accordance with three amendments to the specifications proposed by the appellant.

***The primary judge's findings relevant to the "General" grounds***

230 It is convenient to start with the second of the asserted findings in Ground 3 of the notice of appeal, that the Services are indivisible or indistinguishable from, or integral to, the provision of clinical care. It is necessary to discuss the competing submissions in order to give context to that finding.

231 The appellant submitted before the primary judge that the Services are "back office" services which are only provided to health practitioners at the medical centres. It argued that, therefore, only the understanding of health practitioners should be considered when determining the ordinary signification of the trade mark PRIMARY HEALTH CARE. The appellant submitted that to health practitioners, the mark would refer to the appellant and to the appellant's Services, and that the mark distinguished the Services from similar services provided by the appellant's competitors.

232 The appellant also submitted that the Services do not involve the provision of clinical care and that only the health practitioners provide clinical care to patients. The health practitioners to whom the Services are marketed are, or become, aware of this. The appellant argued that,

thus, the words PRIMARY HEALTH CARE allude to the clinical care provided by the health professionals, but do not describe the Services.

233 The respondents submitted that the appellant provides the Services both to the contracted health practitioners and to patients. They also submitted that provision of the Services is a critical enabler, and an incident of, the provision of clinical care by the contracted health professionals. They submitted that by providing the Services, the appellant (through its subsidiary, Idameneo) provides primary health care to members of the public. They submitted that the mark PRIMARY HEALTH CARE is therefore descriptive of the services provided by the appellant.

234 It was in the context of these competing submissions that the primary judge proceeded to analyse the nature of the Services, the manner of provision of the Services and to whom the services are provided.

235 The primary judge held (at Judgment (**J**) [55]) that the persons paying for the Services, the health practitioners, are not the only persons who receive the Services, or, at least, are not the only persons “concerned with” the Services. The Services include reception and telephone answering services, patient booking services, patient file management services, information management services, billing and invoicing services, computerised file management and ordering services. Her Honour found (at J [55-57]) that each of these services is provided by the appellant, not only to medical professionals, but to patients. For example, by answering a telephone call, making a record of an appointment and sending a reminder to a patient, the receptionist provides a service to both the GP and the patient. After the patient receives clinical care, the receptionist prepares an invoice and takes payment and may arrange for the patient to receive a Medicare or health cover rebate; and these are services provided to both the GP and the patient.

236 The primary judge (at J [60]) rejected the appellant’s characterisation of the Services as services provided only to medical professionals. As has already been noted (at [25]), her Honour considered that such a characterisation reflected a misconception which affected the entirety of the appellant’s case.

237 The primary judge found (at J [65]):

To return to the immediate issue, the reality is that, at least insofar as the Services are concerned, the applicant is providing services to medical professionals within its centres, to patients of those centres, and to all other participants in health care who

interact with any medical professional in one of its centres. The fact that the applicant (or Idameneo) receives payment for the provision of the Services directly from the medical professional does not mean that the Services are provided only to the medical professional. Nor does the fact that medical professionals understand that they alone provide clinical or medical services to patients mean that the Services are not provided to patients. The reasoning involved seems to involve a false syllogism: (i) only medical professionals provide clinical services to patients, (ii) the Services are not clinical services, (iii) therefore, the Services are necessarily not services to patients. Propositions (i) and (ii) may be accepted, but they do not lead to proposition (iii).

(Emphasis added.)

238 Her Honour continued (at J [68]):

But by focusing on the Services which occur within the medical centres at which patients receive clinical care the applicant has created specifications in which many of the Services are services to more than merely the GP or other health professional, and are indivisible from or integral to the provision of clinical care by the GP or other health professional.

(Emphasis added.)

239 Her Honour then concluded (at J [71]):

It follows that, given the terms of the specifications and the nature of the Services, it is not merely the ordinary signification of the words “primary health care” to health professionals in private practice and available for recruitment by the applicant which is relevant. It is the ordinary signification of those words to all health professionals, other participants in the health care system in Australia, and the Australian public who are potential patients at the medical centres which is relevant. To the extent that the applicant’s case depends on the Services being confined to health professionals in private practice who had been or were available to be recruited to one of the applicant’s medical centres, and that therefore such health professionals are the only persons concerned with the Services, the case should not be accepted.

(Emphasis added.)

### ***Consideration of “General” grounds***

240 The second aspect of Ground 3 asserts that her Honour erred in finding that the Services are indivisible or indistinguishable from, or integral to, the provision of clinical care to patients.

241 Her Honour rejected the appellant’s characterisation of the Services as services provided *only* to health practitioners. Her Honour found (at J [55]-[57], [68]) that while the appellant provides the Services to, and receives payment for the services directly from, the health professionals, the appellant also provides many of the Services to patients. That is because many of the Services are “integral to and indivisible from” the clinical care provided to the health practitioners’ patients. These findings formed the foundation for much of her Honour’s subsequent reasoning.

- 242 In finding that the Services are “indivisible from” clinical care to patients, her Honour made no finding that the appellant provides clinical care to patients. Rather, her Honour’s reasons must be construed as indicating that the Services provided by the appellant are so closely interlinked with (“integral to”) the clinical care provided by health practitioners, that the Services cannot practically be regarded as being provided only to health practitioners.
- 243 In the appeal, the appellant submits that some of the Services are quintessentially back office services that the primary judge could not reasonably have interpreted as being provided directly or indirectly to patients. In that category, the appellant lists “administrative support services...account keeping and bookkeeping services, preparation of business reports, systemisation of information into computer databases, professional business consultancy, computerised file management, business and information management services, ordering services, processing of purchase orders.” The appellant also submits that there is no authority supporting her Honour’s approach to the indivisibility of the Services.
- 244 The appellant further submits that the fact that patients may be exposed to or indirectly benefit from some of the Services does not change their character as services provided to health practitioners. Two things may immediately be said about this submission. Firstly, contrary to the suggestion implied in the submission, her Honour *did* accept that the Services are provided to health practitioners. Her Honour’s findings were concerned with whether the services were *also* provided to patients. Secondly, the submission acknowledges that patients may receive a benefit from some of the Services.
- 245 The primary judge’s findings that the appellant provides many of the Services to patients and that those Services are indivisible from, or integral to, the provision of clinical care to patients were findings of fact. It will be seen from the notice of appeal that the appellant also challenges other findings of fact. At one point in the course of his submissions, the appellant’s senior counsel seemed to disclaim any challenge to findings of fact made by the primary judge, but it is apparent that the appellant does take issue with some such findings. At this stage, it is relevant to note the following observations made in *Robinson Helicopter Company Inc v McDermott* (2016) 331 ALR 550 at [43] about the role of an intermediate appellate court of appeal in reviewing findings of fact made by a judge at first instance:

The fact that the judge and the majority of the Court of Appeal came to different conclusions is in itself unremarkable. A court of appeal conducting an appeal by way of rehearing is bound to conduct a “real review” of the evidence given at first instance and of the judge’s reasons for judgment to determine whether the judge has

erred in fact or law. If the court of appeal concludes that the judge has erred in fact, it is required to make its own findings of fact and to formulate its own reasoning based on those findings. But a court of appeal should not interfere with a judge's findings of fact unless they are demonstrated to be wrong by "incontrovertible facts or uncontested testimony", or they are "glaringly improbable" or "contrary to compelling inferences". In this case, they were not.

(Citations omitted.)

- 246 The specification of the Services in the application for registration of the trade marks divides the Services into three categories. The first is "Medical centre business management". The second is "medical centre business administration". The third is "service provider to medical professionals", with particular services then specified. The appellant's submissions in the appeal do not distinguish between the three categories and, from their descriptions in the application, no practical distinction is evident. The primary judge seems to have treated the appellant's case for registration as effectively based on the third category. The appellant has made no complaint about that approach.
- 247 Within the third category, the primary judge expressly considered the Services described as "billing and invoicing services, reception and telephone answering services, patient booking services, patient file management services including management of access to patient files...billing and information management services, ordering services". Her Honour found that those services are provided to patients, as well as health practitioners. The only services in the third category that her Honour did not expressly discuss are "administrative support services", "typing services", "preparation of business reports", "professional business consultancy" and "processing of purchase orders". Her Honour appears to have inadvertently overlooked "typing services", but her Honour's reasoning concerning other services which involve typing, such as "patient booking services" and "billing and invoicing services", must apply equally to "typing services".
- 248 The appellant submits that her Honour could not reasonably have regarded the Services described as "administrative support services", "account keeping and bookkeeping services", "systemisation of information into computer databases", "computerised file management", "business and information management services", and "ordering services" as being provided directly or indirectly to patients. Leaving aside "administrative support services" for the moment, her Honour's explanation (at J [55]) as to how, by providing each of these services to health practitioners, the appellant also provides such services to patients is persuasive. The appellant's submission that her Honour could not reasonably have regarded these services as being provided to patients cannot be accepted. While her Honour did not expressly consider

“administrative support services”, those services appear to be no more than a general description of the other services particularised in the third category.

249 The appellant’s submission that the Services consisting of “preparation of business reports”, “professional business consultancy” and “processing of purchase orders” are provided only to medical practitioners can be accepted. But, her Honour did not rule that these particular services are provided to patients. Those services were not mentioned by her Honour. Her Honour’s conclusion (at J [68]) was that *many* of the Services are provided to patients and *many* of the Services are indivisible from, and integral to, the provision of clinical care. That finding responded to, and rejected, the appellant’s contention that the Services as a whole were provided *only* to health practitioners.

250 The appellant asserts in Ground 3 of the notice of appeal that the primary judge found that “the Services...are indivisible or indistinguishable from, or integral to, the provision of clinical care to patients”. The premise is not established as her Honour made such a finding only in relation to *many* of the services, not all. The consequence was that her Honour rejected the appellant’s submission that only the ordinary signification of the marks to health practitioners should be considered when applying s 41(3) of the TMA.

251 The appellant submits that there is no authority supporting her Honour’s approach to the indivisibility of the Services. In *Cantarella Bros Pty Limited v Modena Trading Pty Limited* (2014) 254 CLR 337 at [71], the majority judgment explained that in applying s 41(3) of the TMA, it is necessary to determine the ordinary signification of a trade mark to the “target audience” for the trade mark. Her Honour’s finding that many of the Services are indivisible from, or integral to, clinical care was a step along the way to identifying the “target audience”. The finding was one of fact and was relevant and no specific authority was required in order for it to be made. There is, in any event, authority supporting her Honour’s approach of conducting a practical evaluation of the Services, which led to the finding as to indivisibility.

252 In *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks*, French J observed at [47] that the ultimate question under s 41(2) of the TMA requires “a practical evaluative judgment about the effects of the relevant mark in the real world”. Lindgren J said at [113] that the question for decision “is not a metaphysical one, but a practical one and requires attention to be given to the perceptions and motivations of consumers in the circumstances of each particular case.” These comments underline the need for a practical evaluation of the capacity

of the trade mark to distinguish by consideration of consumers' perceptions in the "real world" and by reference to matters such as the nature of the goods or services and the way they will be provided. The primary judge's approach of beginning by examining the nature of the Services, how they are provided and to whom they are provided was amply justified. It follows that the second aspect of Ground 3 should be rejected.

253 The first aspect of Ground 3 asserts that the primary judge erred in finding that the Services provided by the appellant are not separate from other activities engaged in by the appellant in the operation of its medical centres. That finding was made in the course of ruling upon the appellant's submission that it provided the Services to health professionals using the trade marks to brand *the Services*. That submission was relevant to s 41(5) of the TMA. The appellant also claimed that it was relevant to s 41(3).

254 Her Honour found (at J [122]) the appellant's submission that it is in the business of providing *the Services* to health professionals to be inaccurate. Her Honour found that the appellant is (relevantly) in the business of operating medical centres and that it is as part of the appellant's operation of the centres, and not otherwise, that the appellant provides the Services to health practitioners. Her Honour found that the appellant markets to health practitioners a form of practice, involving provision of a fully equipped room at a medical centre and provision of the Services in exchange for a fee calculated as a percentage of the money earned by the medical practitioners from providing clinical services to patients. The Services are only available to health practitioners who have been contracted to work at the appellant's medical centres.

255 Those findings led to the rejection of the submission that the appellant used the trade marks to brand *the Services* (rather than its business of operating medical centres). Her Honour said (at J [63]) that the position might have been different if the appellant was in the business of providing the Services to all health professionals and marketed the services in that way, but that is not what the appellant has ever done. Her Honour found that the Services cannot be considered as if they exist in isolation, because that is not how the Services have been provided.

256 The appellant submits that the primary judge's finding that the appellant did not market the Services "per se" or "in and of themselves" was irrelevant to the case. However, those findings were relevant to consideration of the appellant's use of the trade marks when applying s 41(5) and (6) of the TMA. Those issues will be discussed later in these reasons in

the context of the grounds of appeal specifically dealing with findings relevant to those sections. The finding that accommodation and the Services are provided in exchange for a fee calculated as a percentage of the money earned by the medical practitioners from providing clinical services to patients was also relevant to her Honour's conclusion that many of the Services are integral to, and indivisible from, the clinical care provided by health practitioners.

257 Ground 4 of the draft notice of appeal is that the primary judge erred in finding that it is not possible to control the scope of the registration of the trade marks in the manner proposed by the appellant.

258 On the last day of the hearing before the primary judge, the appellant proposed three possible amendments to the specifications for the Services, which it described as "options".

259 The first option proposed to amend the specifications to expressly state that the Services are "services to medical professionals" and that none of the Services are "medical care by medical professionals to patients". Her Honour held that these amendments achieved nothing because the Services are in fact provided to patients and other participants in the health care system.

260 The appellant's second option described the Services as being "services provided directly to medical professionals but not including medical services or any services that entail dealing with patients or any other members of the general public attending medical centres". That option also expressly excluded "medical services or services that entail dealing with patients or any other members of the general public attending the medical centres". That option also contained an endorsement to the effect that registration of the trade mark "is limited to the provision of the aforementioned services to medical professionals and does not extend to exclusive rights in any use that may be seen by patients or any other members of the general public attending medical centres". The endorsement sought to engage ss 33(2) and 55(1)(b) of the TMA.

261 Section 33(2) of the TMA provides that the Registrar may accept an application subject to conditions or limitations. Under s 6(1), "limitations" means "limitations of the exclusive right to use a trade mark given by the registration of the trade mark, including limitations of that right as to...mode of use". Section 55(1) of the TMA provides that the Registrar must decide

to either register a trade mark “with or without conditions or limitations”, or to refuse to register a trade mark.

262 The appellant’s third option was similar to the second, except that it contained a “disclaimer”, in place of the endorsement, saying:

Registration of this trade mark shall neither confer nor recognise any exclusive right to use that may be seen by patients or any other members of the general public attending medical centres, including but not limited to signage on or in medical centres, signage on medical centre staff uniforms, and on documentation generated in the course of interacting with patients or any other members of the general public attending medical centres.

263 The disclaimer relied on s 74 of the TMA. That section provides that an applicant for registration may disclaim any exclusive right to use “a specified part of the trade mark”. Her Honour held that this provision was inapplicable as the disclaimer purported to disclaim an exclusive right to use the trade marks in a particular way, rather than disclaiming an exclusive right to use a specified part of the trade marks. The appellant’s grounds of appeal do not challenge this aspect of her Honour’s reasons.

264 The primary judge noted that the intention of the amendments proposed under the second and third options was to prevent the appellant from having an exclusive right to use the marks in such a manner that the marks will be seen by members of the public attending the appellant’s medical centres. Her Honour considered (at J [79]-[80]) that these options would not overcome the problem of indivisibility of the Services. For example, if the appellant provides billing services directly to medical professionals, irrespective of the appellant’s characterisation of its activities, it also provides billing services directly to patients. The proposed amendments would, on one hand, attempt to give the appellant a right of exclusive use to the marks insofar as medical professionals are concerned, but deny to the appellant any right of exclusive use insofar as members of the public were concerned. However, the Service was one service being provided both to medical professionals and patients. Her Honour held that by the amendments the appellant was trying to divide a service into segments which did not exist. The amendments made no material difference to the actual nature of the Services as they exist and are performed and, if they do anything, it is to introduce an unacceptable ambiguity into the specifications which cannot be assumed to confine the Services in the way that the appellant wishes.

265 The appellant submits that the primary judge erred in considering that no effective limitation could be placed on the specifications to achieve registration of the marks, arising from her

Honour's treatment of the Services as being indivisible from a wider class of services provided at the medical centres which is not claimed by the appellant. The appellant submits that the marks are not invalidated merely because the scope of the Services in respect of which registration is sought is *narrower* than the intended use of the mark by the appellant.

266 The appellant's submission suggests that the primary judge found that the appellant's marks could not be registered *because* their intended use was wider than the scope of the Services in respect of which registration was sought. Her Honour made no such finding. Her Honour's conclusion that the Services were integral to and indivisible from the clinical care provided to patients at the appellant's centres did not, of itself, mean that the marks could not be registered. Rather, that conclusion demonstrated that the appellant provided the Services to patients, as well as health practitioners. This meant that patients were "concerned with" the Services and the ordinary signification of the marks to patients was relevant under s 41(3) of the TMA.

267 Her Honour's conclusion as to the indivisibility of the Services from clinical care led to the conclusion that the proposed amendments would not assist to make the trade marks distinctive of the Services. That is because amending the specifications did not affect the nature of the Services or to whom they are to be provided. Therefore, for s 41(3) of the TMA, the amendments would not affect the identification of the "target audience", or the ordinary signification of the marks. The primary judge's reasoning as to the lack of utility of the proposed amendments was logical and has not been demonstrated to contain error.

268 Her Honour also found (at J [81]) that the amendments would introduce unacceptable ambiguity into the specifications. The appellant's submissions do not challenge that finding.

269 At the end of the appellant's oral submissions in reply in the appeal, counsel for the appellant handed up a draft condition which they said could be attached to the registration, to the effect that the appellant must not use the marks in any way that may be seen by anyone other than medical professionals. The Court directed that the appellant provide supplementary written submissions identifying the basis on which the appellant contended that the Court should take the further draft condition into account. The appellant subsequently filed submissions attaching, without leave, a different version of the condition it contended should be imposed.

270 The respondents submit that the appellant requires leave to advance any new condition in the appeal and that leave should be refused. They argue that the new condition was not one

advanced before the primary judge, that it does not arise out of any ground of appeal and that the condition lacks merit in any event. Those submissions should be accepted.

271 An appellate Court will not usually allow an appellant to raise a new argument which, whether deliberately or by inadvertence, it failed to put during the hearing when it had an opportunity to do so: *Metwally v University of Wollongong* (1985) 60 ALR 68 at 71; *Vella v Minister for Immigration and Border Protection* (2015) 326 ALR 391 at [18]. As a general rule a party is bound by the conduct of its case: *Park v Brothers* (2005) 222 ALR 421 at [34].

272 However, there may be circumstances in which the interests of justice may lead an appellate court to permit a party to raise a point that was not taken at trial: *Park v Brothers* at [34]. In *VUAX v Minister for Immigration and Multicultural and Indigenous Affairs* (2004) 238 FCR 588, the Full Court said at [48].

The Court may grant leave if some point that was not taken below, but which clearly has merit, is advanced, and there is no real prejudice to the respondent in permitting it to be agitated. Where, however, there is no adequate explanation for the failure to take the point, and it seems to be of doubtful merit, leave should generally be refused.

273 The appellant has offered no explanation for why it failed to advance its argument concerning the new condition before the primary judge. Further, the argument is of doubtful merit. The appellant submits that the condition would ensure that the appellant's use of the trade marks would not be likely to deceive or cause confusion within s 43 of the TMA or be misleading or deceptive within s 42(b) of the TMA, taken with s 18 of the ACL. However, the new condition would permit misleading or deceptive use of the trade marks directed to medical professionals who are not familiar with the appellant's business model, the primary judge having found (at J [172]) that the vast bulk of GPs in Australia are not acculturated to the appellant's business model. The appellant should not be permitted to advance its new argument in the appeal.

274 Grounds 3 and 4 of the notice of appeal must be rejected.

### **The appellant's grounds of appeal concerning s 41(3) of the TMA**

275 The appellant's notice of appeal raises three grounds challenging the primary judge's findings relevant to s 41(3) of the TMA:

5 The primary judge erred in finding (at J [99], [103], [106], [113]) that the descriptive meaning of the words "primary health care" is "first level or first contact health care" and that meaning was and is the only ordinary signification of the words.

- 6 The primary judge ought to have found on the evidence that the meaning of the words “primary health care” depends on the context in which the words are used, and that when used in connexion with the Services the words mean the appellant, including its Services.
- 7 The primary judge erred in finding (at J [126]) that the phrase “primary health care” does not have an inherent capacity to distinguish the appellant’s Services from those of other persons.

*Particulars*

The primary judge erred:

- (i) in finding (at J [124]) that as at the Priority Date (and to date) the meaning of the phrase “primary health care” directly described the Services, having found (at J [165], [174]) that clinical care is a “key component” or “indispensable part” of primary health care and that the appellant does not provide clinical care.
- (ii) in finding (at J [71]) that the relevant class of persons for determining the ordinary signification of the words “primary health care” in the context of Services includes not only health care professionals but other participants in the health care system and the public who are potential patients at the appellant’s medical centres;
- (iii) in finding (at J [117]) that the meaning of “primary health care” (as “first level or first contact” health care) would have been understood by a substantial number of people seeking access to health care as at the Priority Date.

***The primary judge’s findings relevant to the s 41(3) TMA grounds***

- 276 The respondents argued before the primary judge that the marks are not inherently adapted to distinguish the Services to any extent because the marks merely describe the kind of services of which the Services form part (ie primary health care), or the sector of health care in which the Services are performed (ie the primary health care sector). They submitted that the phrase “primary health care” derives its meaning from the ordinary meaning of its constituent parts, that meaning being “first level” or “first contact” health care.
- 277 The respondents argued that the Services are integral to the provision of primary health care in Australia. They argued that the Services are supplied in the primary health care sector of the health care system. They submitted that the phrase “primary health care” is thus merely descriptive of the Services or the sector in which they are supplied and is not inherently adapted to distinguish the Services.
- 278 The appellant submitted that there is no ordinary or plain meaning in the English language for the phrase “primary health care”. In particular, the appellant submitted that the adjective

“primary” is not commonly used or understood to describe medical services or sections of the health care system. It submitted that even amongst health professionals, the evidence showed that the phrase has a meaning only in the narrow government public health policy arena, but, even in that arena, the phrase has no single ordinary descriptive meaning. Further, when the phrase is used in connection with the appellant, to GPs the phrase means the appellant and its Services.

279 The appellant submitted that it does not provide any health services and the trade marks are merely allusive of the clinical services provided by health practitioners.

280 The primary judge commenced by examining a number of public health policy documents and the evidence of seven witnesses involved in the public health sector regarding the meaning of the phrase “primary health care”. Her Honour found (at J [99]) that to those involved in public health policy in Australia, the ordinary signification of the phrase is “...that part of the Australian health care system which provides first level health care, being the health care received as a result of the first contact between an individual and a health care system (or, in shorthand, first level or first contact health care)” (which her Honour described as the “**core meaning**”). Her Honour continued that “primary health care” was, and is, understood by those involved in public health policy to include the health care provided by GPs.

281 Her Honour said (at J [100]) that the appellant’s case appeared to rest on a belief that there is a clear dividing line between what the appellant characterised as the “narrow” area of public health policy and the broader provision of clinical services in Australia. Her Honour did not consider that such a distinction would bear too much weight. Her Honour said that, in one sense, all GPs in Australia work within the public health sector, as they are trained within, regulated by and interact with the public health care system. Accordingly, all GPs are, to some extent, concerned with public health policy.

282 Her Honour noted that the respondents’ witnesses who worked in the public health sector had also heard of the appellant and understood the appellant to operate medical centres. The effect of their evidence was that, depending on the context, they would understand when the words “primary health care” took their core meaning and when they were intended to refer to the appellant. Her Honour concluded that nonetheless this did not affect the core meaning.

283 The primary judge then turned (at J [104]) to examine the evidence called by the appellant from twelve GPs as to the meaning of “primary health care”. Her Honour summarised that evidence as follows. Five GPs were aware of the core meaning of the phrase (as first level or first contact health care) before the priority date. Two GPs were aware of the core meaning before the priority date, but considered it was confined to the public health policy context. Four GPs did not say whether they knew of any meaning of the phrase other than as a reference to the appellant as an entity operating medical centres. All the GPs described their understanding of the phrase as a reference to the corporate entity which owns, operates or runs medical centres. Only one GP also described her understanding of the phrase as a reference to the corporate entity providing the Services.

284 Her Honour pointed to other evidence which supported the conclusion that, since before the priority date, “primary health care” meant first level or first contact health care in Australia, of which GPs formed a critical part. Her Honour noted (at J [106]) that the appellant’s prospectus had referred to “the size of the primary health care industry”. Her Honour referred to the appellant’s sponsorship of a conference which it described as Australia’s “primary health care event of the year”. Her Honour also referred (at J [108]) to evidence that Dr Bateman had adopted the corporate name because he considered that it “reflected the services that would be available to patients attending the centres”. Her Honour said that, in other words, the founder of the company must be taken to have known that GPs were providing primary health care services to patients.

285 The primary judge (at J [109]) addressed the appellant’s submission that it was a consistent theme in public health literature that the phrase “primary health care” does not have any clearly defined scope of meaning. Her Honour said that, understood in context, those statements convey that the phrase is a broad term that can be used in different contexts to mean *more than* the core meaning. Her Honour said that there is no suggestion in that material that the core meaning is in dispute, unclear or ambiguous, or that GPs are not providing primary health care.

286 Her Honour concluded (at J [113]-[114]):

[T]he weight of the evidence supports the conclusion that as at the priority date the ordinary signification of the phrase “primary health care” to a substantial number of persons involved in the provision of health care in Australia was the first level of health care available in the health system incorporating GPs but also other health professionals who would be the first point of contact between an individual and the health care system or, in shorthand, first level/first contact health care.

The fact that the phrase also meant an approach to health care in which that first level of care was integrated with the national health system and, as part of that integration, incorporated other socio-economic objectives (not all of which a substantial number of people involved in health care would necessarily agree about) does not mean that the phrase had or has no ordinary signification. Nor does the fact that, at the priority date, a number of people involved in the health care system also knew that the phrase was the name of a corporation which owned, operated and/or ran medical centres. In respect of this last observation, it will be noted that the applicant's evidence was weighted in favour of GPs who had either been recruited by the applicant or had been in discussions with the applicant for that purpose or had some specific reason for having known about the applicant. Further, even when the GP did have reason to know of the applicant's business model, no-one but Dr Gabriel described it as involving the provision of the Services to GPs and health professionals.

(Emphasis added.)

287 The primary judge then turned to consider how members of the public, or patients, would understand the phrase "primary health care". The appellant submitted that the public would have no understanding of the phrase, relying, in particular, on a Commonwealth government 2009 *Report to Support Australia's First Primary Health Care Strategy* which stated that "primary health care is a term that is not widely used or even understood". Her Honour found that, when read in context, the document made no suggestion that "primary health care" does not mean first level or first contact health care.

288 Her Honour concluded (at J [117]):

I also consider that this core meaning, of first level or first contact health care, would be understood by a substantial number of people seeking to access health care as at the priority date. That is, if a person saw "primary health care" in the context of seeking health care for themselves or a family member or associate, they would understand the reference to be to a form of health care, being first level/first contact health care. They would do so because of the ordinary meaning of each word which makes up the phrase. While such a person may not distinguish between primary, secondary and tertiary levels of health care, or think of primary health care as an approach to health care in the extended sense of the term as used in the health policy context, they would understand the ordinary signification of the phrase to be first level/first contact health care. Such a person, moreover, would be very unlikely to associate the phrase with the applicant because the applicant's marketing is targeted at GPs, not members of the public.

(Emphasis added.)

289 The primary judge turned to the question of whether "primary health care" has a descriptive or an allusive meaning. Her Honour stated that the Services are integral to the provision by the health practitioners of primary health care services to patients who attend the centres. Her Honour found that the distinction sought to be drawn by the appellant between the provision of the Services and the provision of clinical care was unreal because the Services are part of the overall service a patient receives when attending the medical centre, and, to some extent,

are also part of the medical or clinical care the patient receives. For example, it is part of the medical care of a patient that a GP be able to access the patient's clinical records and for the centre to have any necessary medical supplies available. Her Honour considered that from the moment a patient makes a booking or attends a centre, they are receiving aspects of the Services. Her Honour accepted the respondents' submission that in a real world context, the Services are inextricably bound up with the provision of medical and clinical services by GPs and allied health care professionals through the medical centres, and are part and parcel of the provision of primary health care.

290 The primary judge held (at J [122]) that once it is recognised that the Services are provided as part of the operation of medical centres, "it is apparent that the applicant is in the business of providing primary health care".

291 Her Honour concluded at (at J [124]):

In this context, if the question is posed whether, at the priority date, other persons involved in the Australian health care system, in the ordinary course and without improper motive, might wish to use the phrase "primary health care" in connection with the Services; the answer must be "yes". Every GP and every medical centre is providing primary health care and, in so doing and in one way or another, is performing or having performed the Services to enable that provision. The phrase was at the priority date, and remains, a direct description of the activity of which the Services form part. The phrase does not have an inherent capacity to distinguish the Services as offered by the applicant from the same services however and by whomever they might be performed. The phrase is not a skilful allusion to the clinical services that GPs provide in asserted distinction from the administrative and managerial character of the Services. Because the distinction is artificial, the phrase is directly descriptive of the Services. The other persons who might legitimately wish to use the phrase "primary health care" in connection with services the same as the Services include all government departments involved in the health care system, all providers of primary health care, all businesses like that of the applicant involved in the provision of primary health care, and all members of the public.

(Underlining added.)

292 Her Honour decided that the addition of the logo to the mark PRIMARY HEALTH CARE did not give the mark any additional inherent adaptability to distinguish. Her Honour concluded that the marks are not inherently adapted to distinguish the Services from the services of others of the same kind to any extent.

### ***Consideration of s 41(3) TMA grounds***

293 The appellant's written submissions assert that there are three errors in the primary judge's "approach" to s 41(3) of the TMA. These asserted errors are not stated with precision, nor do they identify which grounds of appeal the errors relate to. For example, the written

submissions describe the first error being that the primary judge's approach "treats as a direct reference an allusion". Thus, the asserted error seems to be simply that her Honour erred by finding that the phrase "primary health care" is directly descriptive of the services. It is cast at a level of generality that is quite unhelpful.

294 The appellant's written submissions as to the first error in her Honour's approach say that her Honour determined the core meaning of "primary health care" to be either "first level" or "first contact" health care and criticise a lack of precision in that determination. The submissions then say that the eleven volumes of documents tendered by the respondents contradict the respondents' proposition that there is only one ordinary meaning of the term. That material is said to include the 2009 *Report to Support Australia's First Primary Health Care Strategy* which stated that the term "is not widely used or even understood". None of these submissions identify the errors that are said to have been made by the primary judge. The appellant's oral submissions have not clarified or expanded upon these aspects of the written submissions. However, it may be inferred that these submissions are intended to support Grounds 5 and 6 of the notice of appeal.

295 The appellant's written submissions identify the second asserted error in the primary judge's approach to s 41(3) of the TMA with greater particularity. They state that her Honour's identification of a meaning of "primary health care" to participants in public health policy, as a first step, was irrelevant to s 41(3) of the TMA as such persons are not consumers of the services. The appellant submits that the Services are provided in a specialised market and what was relevant was the ordinary signification of the phrase for health professionals consuming or likely to consume those services (and even, on her Honour's reasoning to the indivisibility of services, members of the public). The submissions argue that her Honour's approach in first determining the ordinary signification of the phrase in the public health sector, and then applying that determination to the relevant market, without evidence that such an extrapolation was appropriate, was erroneous. The submissions continue that the extension of the "core meaning" of the phrase to a "substantial number of people seeking access to health care as at the priority date" was not supported by any evidence. The appellant submits that the respondents made no attempt to discharge their onus of proving any understanding of members of the public, let alone substantial numbers of the public. It also criticises the finding as internally inconsistent, her Honour having found that while members of the public may not "distinguish between primary, secondary and tertiary levels of health care or think of it as an approach to health care", they would understand that "ordinary

signification of the phrase” as “first level/first contact health care”. These submissions appear to be intended to support Ground 7 of the notice of appeal.

296 The appellant’s written submissions identify the third asserted error in the primary judge’s approach as that by searching for and determining there to be but one ordinary meaning of the phrase “primary health care”, irrespective of the context in which it is used, her Honour disregarded much of the evidence and the significance of other findings that had been made by her Honour. The submissions continue that the evidence demonstrates that the meaning of the phrase is understood according to the context in which it is used, and when used in relation to the operation of the medical centres it is understood by people in the health sector to mean “Primary Health Care Limited”. These submissions appear to correlate with Ground 6 of the notice of appeal.

297 The respondents’ submissions criticise the appellant’s lack of precision in identifying the errors said to have been made by the primary judge and articulating why the findings challenged by the appellant are erroneous. That criticism is justified. However, it lies within the province of the Court to attempt to reconcile the grounds set out in the notice of appeal with the appellant’s written and oral submissions (including a list of “Propositions” produced by the appellant during argument) in order to understand the appellant’s case.

298 The appellant’s case can be understood as asserting that the primary judge made the following errors in applying s 41(3) of the TMA:

- (1) Her Honour erred in finding that the target audience for the trade marks includes:
  - (a) patients; and
  - (b) persons involved in the public health care sector;when those groups are irrelevant to the inquiry; and her Honour should have instead found that the target audience for the Services is limited to health practitioners.
- (2) Alternatively, her Honour erred by making the dominant focus of the enquiry the ordinary signification of “primary health care” to classes of people who are only indirectly or incidentally concerned with the Services (patients and persons in the public health sector), rather than the persons who are directly concerned with the Services as purchasers (health practitioners).

- (3) Her Honour’s approach in first determining the ordinary signification of the phrase in the public health sector, and then applying that determination to the relevant market, without evidence that such an extrapolation was appropriate, was erroneous.
- (4) Her Honour erred in finding that the ordinary signification of “primary health care” is “first level or first contact” health care, because:
  - (a) her Honour should have found on the evidence that there is no ordinary signification of that phrase;
  - (b) her Honour should not have found that there is only one ordinary signification of the phrase;
  - (c) her Honour’s identification of the ordinary signification is uncertain and ambiguous;
  - (d) there was no evidence proving any understanding of members of the public, let alone substantial numbers of the public;
  - (e) alternatively, her Honour ought to have found that the meaning of the phrase is to be understood according to the context in which it is used;
  - (f) her Honour ought to have found on the evidence that when the phrase is used in relation to the appellant’s operation of medical centres, its ordinary signification to health practitioners is the appellant and the Services;
  - (g) her Honour ought to have found that even if the ordinary signification of the trade marks is “first level/first contact health care”, the marks distinguish the Services to some extent.

299 In addressing the appellant’s submissions, it will be necessary to consider what is meant by “inherently adapted” in s 41(3) of the TMA, from whose perspective it is to be judged whether the mark is adapted to distinguish, and the relevance of the nature of the designated services and the way the services are intended to be used.

300 Under s 41(3) of TMA, the capacity of the mark to distinguish the designated goods or services depends on the “ordinary signification” of the mark, which must be determined from the perspective of the “target audience”, which in turn depends on the nature of the goods or services and their intended use. The intended use of the goods or services may be assessed by reference to past and present use. As Lindgren J said in *Kenman Kandy*:

84 While inherent adaptation to distinguish requires attention to be focused on the mark itself, and is intended to stand in sharp contrast to a mark’s capacity

to distinguish arising from use, the notion of “the mark itself” does not exclude from consideration the nature of the range of goods within the class or classes in respect of which registration is sought, or the various ways in which the mark might, within the terms of the registration, be used in relation to those goods. Indeed, those matters must be taken into account.

301 In *Cantarella Bros Pty Limited v Modena Trading Pty Limited*, the majority judgment of the High Court of Australia explained the relevance of the “ordinary signification” of the words of a trade mark to the enquiry under s 41(3) of the TMA and the “target audience” whose understanding is relevant:

59 The principles settled by this Court (and the United Kingdom authorities found in this Court to be persuasive) require that a foreign word be examined from the point of view of the possible impairment of the rights of honest traders and from the point of view of the public. It is the “ordinary signification” of the word, in Australia, to persons who will purchase, consume or trade in the goods which permits a conclusion to be drawn as to whether the word contains a “direct reference” to the relevant goods (prima facie not registrable) or makes a “covert and skilful allusion” to the relevant goods (prima facie registrable)...

...

70 ...[D]etermining whether a trade mark is “inherently adapted to distinguish”, as required by s 41(3), requires consideration of the “ordinary signification” of the words proposed as trade marks to any person in Australia concerned with the goods to which the proposed trade mark is to be applied.

71 As shown by the authorities in this Court, the consideration of the “ordinary signification” of any word or words (English or foreign) which constitute a trade mark is crucial, whether (as here) a trade mark consisting of such a word or words is alleged not to be registrable because it is not an invented word and it has “direct” reference to the character and quality of goods, or because it is a laudatory epithet or a geographical name, or because it is a surname, or because it has lost its distinctiveness, or because it never had the requisite distinctiveness to start with. Once the “ordinary signification” of a word, English or foreign, is established an enquiry can then be made into whether other traders might legitimately need to use the word in respect of their goods. If a foreign word contains an allusive reference to the relevant goods it is prima facie qualified for the grant of a monopoly. However, if the foreign word is understood by the target audience as having a directly descriptive meaning in relation to the relevant goods, then prima facie the proprietor is not entitled to a monopoly of it. Speaking generally, words which are prima facie entitled to a monopoly secured by registration are inherently adapted to distinguish.

(Citations omitted, emphasis added.)

302 It may be seen from *Cantarella* that the enquiry under s 43(1) of the TMA required consideration of persons in the “target audience” for the trade marks. Although the majority in *Cantarella* described that audience as “persons who will purchase, consume or trade in the goods”, that was not an exhaustive description. The majority went on to say that the ordinary

signification of the trade mark to “any person in Australia concerned with the goods” is to be considered. However, the majority cannot be taken to suggest that any class of persons with some interest in the goods or services, no matter how remote, is to be considered.

303 The first step under s 41(3) of the TMA was to determine the ordinary signification of the trade mark to purchasers, consumers, traders and any other persons in Australia sufficiently concerned with the designated goods or services. The next step was to consider whether other traders might legitimately need to use the mark in respect of their own goods or services. That step was necessary because as Kitto J explained in *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511 at 513 - 514:

The question is whether the mark, considered quite apart from the effects of registration, is such that by its use the applicant is likely to attain his object of thereby distinguishing his goods from the goods of others. In *Registrar of Trade Marks v. W. & G. Du eros Ltd. Lord Parker of Waddington ...* said: “The applicant’s chance of success in this respect [i.e. in distinguishing his goods by means of the mark, apart from the effects of registration] must, I think, largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connexion with their own goods. It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the *Trade Marks Acts* a monopoly in what others may legitimately desire to use.” The interests of strangers and of the public are thus bound up with the whole question, as *Hamilton L.J.* pointed out in the case of *R. J. Lea, Ltd.*; but to say this is not to treat the question as depending upon some vague notion of public policy: it is to insist that the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

(Citations omitted, emphasis added.)

304 In *Telstra Corporation Ltd v Phone Directories Company Australia Pty Ltd* (2015) 237 FCR 388, the Full Court said:

[126] If a word mark is taken as an example, the ordinary signification of the mark, and the question of “whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods” (*W & G Du Cros* at 635 per Lord Parker) ...are closely related questions...

[127] A consideration of what persons in the trade or other traders might want to do includes, at least in the ordinary case, a consideration of the views of consumers of the relevant goods or services because the perceptions of

traders in goods and services will be based on, or strongly influenced by, the perceptions of the consumers of those goods and services.

305 The primary judge commenced her consideration of s 41(3) of the TMA with the ordinary signification of “primary health care” to persons in the public health sector. The appellant submits that the understanding of those persons was irrelevant as they are not part of the target audience. Her Honour’s reasons do not expressly explain why the understanding of those persons was relevant.

306 However, her Honour’s reasoning may be inferred from several passages that appear later in the reasons. Her Honour said (at J [124]) that the persons who might legitimately want to use the phrase “primary health care” in connection with the Services include all government departments involved in the provision of primary health care. That finding seems connected with references later in the reasons to proceedings issued by the appellant against Australian General Practice Network Limited (**AGPN**) and several Divisions of General Practice in 2010. The Divisions of General Practice were voluntary associations of GPs which received public funding. AGPN was an umbrella entity for those Divisions. AGPN had applied to register a business name and trade mark AUSTRALIAN PRIMARY HEALTH CARE NETWORK in connection with health services. The proceeding was settled when AGPN agreed not to use the trade mark. Her Honour found (at J [150]) that the Divisions had ample legitimate reason to wish to rebrand themselves as organisations involved in primary health care, being connected with Commonwealth Government policy initiatives about primary health care. Her Honour held that the actions of the Divisions are good evidence of other organisations (including government funded clinics or public/private partnerships) involved in primary health care wishing, without improper motive, to use the phrase to describe their services of the same nature as the Services.

307 Accordingly, her Honour regarded Commonwealth and State government departments or instrumentalities and others involved in the provision of public health care as potentially wishing to make use of the words “primary health care” for their ordinary signification in connection with their own services. Her Honour seems to have regarded these entities as “rival traders” who are “concerned with” the Services.

308 One possible difficulty with her Honour’s analysis is that a mark is only used as a trade mark if it is used in the course of trade. In *E & J Gallo Winery v Lion Nathan Pty Ltd* the plurality stated at [44]:

It can also be noted that the reference in s 17 to “the course of trade” encompasses the idea that use of a trade mark is use in respect of “vendible articles”. A mark is used only if it is used “in the course of trade”.

(Footnotes omitted.)

309 The expression “rival traders” requires that the rival engage in trade. Her Honour said (at J [151]) that government departments or instrumentalities may provide public funding for clinics or engage in public/private partnerships involving provision of primary health care. Her Honour found that such clinics or partnerships may well wish to use the trade marks “because they are in the *business* of providing primary health care”. That finding has not been challenged in the appeal. Her Honour considered that government departments or instrumentalities may wish to use the trade marks for their ordinary signification in the course of trade.

310 For these reasons, the appellant has not demonstrated that her Honour erred in finding that the understanding of “primary health care” to those involved in the public health sector was relevant to the enquiry under s 41(3) of the TMA.

311 The appellant’s submission that the target audience for the Services does not include patients must also be rejected. Her Honour found that the appellant provides many of the Services to patients and, as has been explained, there is no basis to set aside that finding. It is true that patients do not directly pay for the Services (and there was no explicit finding that they pay indirectly), but a person may consume a product without purchasing it. For example, in *Telstra Corporation Ltd v Phone Directories Company Australia Pty Ltd* on appeal (and at first instance (2014) 316 ALR 590), where businesses paid to advertise in paper and online telephone directories, but the directories were made available to the public without charge, the public were regarded as consumers. In *Canteralla*, in the phrase “persons who will purchase, consume or trade in the goods” at [59], a distinction was drawn between purchasers and consumers. In this case, the patients are consumers of many of the Services. The appellant has not shown that her Honour erred by treating patients as a class of persons concerned with the Services and part of the target audience to be considered when determining the ordinary signification of “primary health care”.

312 The appellant next submits that her Honour erred by making the dominant focus of the enquiry the ordinary signification of “primary health care” to patients and persons in the public health sector when those classes are only indirectly or incidentally concerned with the Services. The appellants submit that the focus should have been on health practitioners as the

purchasers of the Services and, therefore, the class of persons most directly concerned with the Services.

313 There may be various classes of persons “concerned with” the designated goods or services. The nature, extent and degree of such concern may vary from class to class. In particular, some classes, such as traders and purchasers, may have a greater interest than others in distinguishing the goods or services of one trader from another. It is also possible that different classes will have different understandings of what is conveyed by the trade mark. It is logical that in determining the ordinary signification of the trade mark, the greatest attention would usually be given to the understanding of the classes with the closest and most direct concern with the designated goods or services (leaving aside the applicant for registration). This will often be rival traders or direct purchasers. It is also logical that the more remote the concern of a class, the less relevant will be the understanding of that class. Having said that, the ordinary signification of a trade mark is a question of fact for the Registrar (and the judge hearing an appeal against the Registrar’s decision).

314 In this case, the primary judge commenced with consideration of the ordinary signification or understanding of the phrase “primary health care” to people in the public health system. As has been discussed, her Honour regarded government departments and instrumentalities as potential traders. Her Honour then moved to consideration of the perceptions of health practitioners, particularly GPs. Then her Honour considered the signification of the phrase to patients. The order in which her Honour addressed the various classes does not say anything about the weight accorded to the perceptions of those classes. Nor is it otherwise discernible from the reasons that her Honour focused on patients and persons in the public health sector to a greater extent than health practitioners. The appellant has not demonstrated the premise of the asserted error, namely that her Honour made persons involved in the public health system and patients the dominant focus of the enquiry. In any event, her Honour determined that the ordinary signification of the phrase to *each* class is “first level/first contact health services”. Therefore, even if her Honour made the asserted error, it made no difference to the outcome of the enquiry.

315 The appellant’s next submission is that the primary judge’s approach in first determining the ordinary signification of the phrase “primary health care” to those in the public health sector, and then applying that determination to the market for the Services without evidence that such an extrapolation was appropriate, was erroneous. Her Honour first decided, on the

evidence, that the ordinary signification to people in the public health sector when used in relation to the Services was “first level/first contact care”. Then her Honour decided, by reference to the evidence of the GPs called by the appellant and evidence as to the appellant’s own use of the phrase, that the ordinary signification was the same to health practitioners. Her Honour then reached the same conclusion in respect of patients by reference to the ordinary meaning of the trade marks to patients. Contrary to the appellant’s submission, her Honour did not merely extrapolate the outcome of the enquiry for the public health sector to the other relevant classes of persons. Rather, her Honour separately considered each class and reached a separate, but consistent, conclusion in relation to each class.

316 The appellant’s next tranche of submissions asserts errors by the primary judge in finding that the ordinary signification of “primary health care” in relation to the Services was “first level/first contact health care”.

317 The appellants submit that the primary judge’s identification of the ordinary signification of “primary health care” as “first level” or “first contact” health care is uncertain and ambiguous because it begs the question as to which of the two options it is. However, her Honour held (at J [113]) that the ordinary signification of the phrase is “...that part of the Australian health care system which provides *first level* health care, being the health care received as a result of the *first contact* between an individual and a health care system (or, in shorthand, first level or first contact health care)”. Although her Honour’s shorthand for that signification of “first level or first contact health care” (and later “first level/first contact health care”) may suggest some uncertainty or ambiguity, the finding admits of no uncertainty or ambiguity when considered in full. Her Honour found that there was a single relevant signification.

318 The appellant submits that the primary judge’s finding as to the ordinary signification of the phrase “primary health care” to patients was unsupported by evidence. Her Honour found that a substantial number of people seeing the phrase in the context of seeking health care would understand the reference to be to a form of health care, being “first level/first contact health care”, because of the ordinary meaning of each word which makes up the phrase.

319 It is well established that evidence as to the ordinary meaning of English words is not required. In *Joske v Dental Cash Order Company Pty Ltd* (1916) 21 CLR 172, Issacs J said at 178:

And as the ordinary meaning of English words is notorious and of public knowledge, we must take judicial notice of it, refreshing our minds with dictionaries and

generally accepted works if necessary.

320 In *Brisbane City Council v Attorney-General* [1979] AC 411, the Privy Council said at 423:

“Showground” is a word of normal parlance; not a term of art requiring interpretation with expert assistance. It is a word to be interpreted by the judge, using his knowledge of the language, and his acquaintance with accepted applications of the word to situations arising in the normal life of the community in which he lives. Judicial knowledge is the knowledge of the ordinary wide-awake man, used by one who is trained to express it in terms of precision.

321 The class of people (patients) who may seek access to medical care at the appellant’s medical centres, and therefore use the Services, cannot be described more narrowly than “the general public”. The issue for her Honour was the meaning of the phrase “primary health care” to the general public. That depended on the ordinary meaning of the phrase having regard to each of the words in the phrase, in the context of the services the phrase was applied to.

322 Each of the words comprising the phrase “primary health care” is an ordinary English word. The word “primary”, like a great many ordinary English words, has more than one meaning. Its meaning varies with the context. For example, there may be a “primary colour” or a “primary meaning”, while references in these reasons to “the primary judge” are to the “first level judge”. Her Honour was entitled to take judicial notice of the meaning of the individual words comprising the phrase and the meaning of the combination of words in their context. Her Honour held that the meaning in the context of the provision of the Services was “first level/first contact health care”. It was not necessary for evidence to be led to prove the meaning of the phrase to the general public.

323 Evidence is admissible to demonstrate the ordinary signification of a word or combination of words to a class of persons, or to demonstrate that, in the context, words do not have their ordinary meaning: see *FH Faulding & Co Ltd v Imperial Chemical Industries of Australia & New Zealand Ltd* (1965) 112 CLR 537 at 555, *Telstra Corporation Ltd v Phone Directories Company Australia Pty Ltd* (on appeal) at [126]. The appellant submits that the eleven volumes of documents tendered by the respondents contradicted the respondents’ proposition that there is only one ordinary meaning of the term. This appears to be a submission that her Honour’s finding that the “core meaning” of “primary health care” was “first level/first contact health care” was against the weight of evidence.

324 However, in their written and oral submissions in the appeal, the only document referred to by the appellant in support of that submission is the 2009 *Report to Support Australia’s First Primary Health Care Strategy (the Report)*. The Report states that:

[P]rimary health care is a term that is not widely used or even understood with most people simply distinguishing between the health care they receive in the community and health care they receive in hospital.

While there are a number of definitions available, including from the World Health Organisation and the Australian Primary Health Care Research Institute, in practice there is no absolute or consistent view about whether particular settings and services are part of primary health care or not.

325 The primary judge understood the points being made in the Report to be that, firstly, members of the public, in contrast to people involved in health care, do not think in terms of primary, secondary and tertiary health care, and secondly, there is room for debate between those involved in health care about whether a particular activity involves primary health care or some other level of care. Her Honour pointed out that the health care people receive in the community is primary health care, so the distinction the Report says most people draw in fact reflects the health policy meaning of the phrase. Her Honour concluded (at J [116]) that, when read in context, the Report does not suggest that a member of the public confronted with the phrase would not understand the phrase to mean “first level/first contact health care” as a result of the ordinary meaning of each of the words.

326 The primary judge’s analysis of the Report must be seen in the context of the other evidence considered by her Honour in the course of determining that the phrase has the core meaning of “first level/first contact health care”. That evidence included the evidence of seven witnesses involved in public health policy, a number of public health policy documents, the evidence of GPs called by the appellant and the appellant’s own documents using the phrase consistently with the core meaning.

327 The primary judge’s construction of the Report involved findings of fact which, together with other findings of fact, went towards the determination of the understanding of the phrase by people involved in the public health care sector and health practitioners. No error in her Honour’s analysis of that document has been demonstrated.

328 The appellant submits that the primary judge’s reasons are internally inconsistent in dealing with the understanding of members of the public. Her Honour, construing the Report, said (at J [116]), “The points being made are first that members of the public, in contrast to those involved in health care, do not think in terms of primary, secondary and tertiary health care...” Later her Honour said at [117]:

I also consider that this core meaning, of first level or first contact health care, would be understood by a substantial number of people seeking to access health care as at the priority date. That is, if a person sought “primary health care” in the context of

seeking health care for themselves or a family member or associate, they would understand the reference to be a form of health care, being first level/first contact health care.

329 Her Honour seems to have accepted that members of the public would not usually think of themselves as receiving primary, secondary, or tertiary health care. However, that is not to say that “primary health care” would not have an ordinary signification to members of the public when they are confronted with the phrase. Understood in context, there is no inconsistency between the quoted passages.

330 The appellant submits that the primary judge found that there was only one meaning of the phrase “Primary Health Care”, but ought instead to have found that its meaning is to be understood according to the context in which it is used. However, her Honour did not find that the phrase has only one meaning. Her Honour considered (at J [109]) that the phrase could have a different meaning in different contexts. Her Honour accepted that health practitioners recruited by or exposed to marketing by the respondent would understand the phrase to also refer to the corporate entity which owns and operates medical centres. Her Honour found (at J [117]) that persons with an interest in publically listed companies operating in the health care sector would also have such an understanding, but that “people within this class could not be assumed to be a substantial proportion of the general public”. Her Honour found that the phrase also has its core meaning of “first level/first contact”, which is the ordinary signification to a substantial number of people in Australia, including those in the public health sector, patients and health practitioners who had not been exposed to the appellant’s marketing. Therefore, the appellant’s submission that the primary judge found that “primary health care” has only one meaning and failed to find that its meaning could vary with the context is incorrect.

331 The appellant submits that the primary judge ought to have found on the evidence that when the phrase is *used* in relation to the appellant’s operation of medical centres, its ordinary signification to GPs is the appellant and the Services. Her Honour found (at J [105]) that the evidence of the GPs (other than one) called by the appellant was that they were aware of the appellant as the corporate entity which operates medical centres to which it recruits GPs. Her Honour found that the GPs (other than one) did not describe their understanding of the phrase as a reference to the appellant providing the Services.

332 There is a fundamental difficulty with the appellant’s submission. The inquiry under s 41(3) of the TMA is narrower than the inquiry under s 41(2). The former requires that the Registrar

take into account only the extent to which the trade mark is “inherently adapted” to distinguish the designated goods or services from the goods and services of other persons. As to what is meant by “inherently adapted”, in *Burger King Corporation v Registrar of Trade Marks* (1973) 128 CLR 417, Gibbs J said at 424:

Inherent adaptability is something which depends on the nature of the trade mark itself...and therefore is not something that can be acquired; the inherent nature of the trade mark itself cannot be changed by use or otherwise.

333 The capacity of a trade mark to distinguish arising from its *use* cannot be considered under s 41(3) of the TMA. The position is different under s 41(5)(a)(ii) and (6) of the TMA.

334 The evidence of Thomas Bateman showed that the appellant had operated its business under the name “Primary Health Care” since its incorporation in 1998. The twelve GPs who gave evidence had an association with the appellant in various ways. Some had discussions with the appellant about practicing from one of the appellant’s medical centres and, of these, some were in fact recruited. One worked for a competitor of the appellant. One has a friend who was recruited by the appellant. Two provide services to the appellant. Two are employed by the appellant. Each of these GPs became aware of the name “Primary Health Care” as a result of the use of that name by the appellant in connection with the operation of medical centres. The appellant therefore relies on the capacity of the phrase to distinguish the Services arising from its *use*. But that is not a matter that can be considered under s 41(3) of the TMA.

335 However, the appellant’s submission that the primary judge ought to have found that the ordinary signification of the phrase to GPs is the appellant and the Services is relevant to the grounds concerning s 41(5) and (6) of the Act and will be considered in that context later in these reasons.

336 The primary judge found (at J [105]) that all the GPs who gave evidence (other than one) described their understanding of the phrase in connection with the appellant as referring to the appellant as a corporate entity which *owns, operates or runs medical centres*, not as an entity providing the *Services* to health practitioners. Her Honour found that the GPs (other than one) did not understand the appellant to be in the business of providing the *Services* to health practitioners. Her Honour found that once this is recognised, it is apparent that the appellant is in the business of providing primary health care (ie first level/first contact medical care) through its operation of medical centres. Thus, the phrase is a direct description of the activity of which the Services form part.

337 The appellant asserts in its “Propositions” document provided during the hearing of the appeal that if the ordinary signification of the trade marks is only “first level/first contact care”, it is in any event allusive of the Services and is therefore to some extent inherently adapted to distinguish the Services. If that proposition is correct, it would mean that her Honour was required to apply s 41(5), rather than s 41(6) of the TMA. However, the appellant did not develop the proposition in its submissions and the substance of its argument is unknown. Therefore, the proposition cannot be accepted.

338 For these reasons, Grounds 5, 6 and 7 of the notice of appeal must be rejected.

### **The appellant’s ground of appeal concerning s 41(5) of the TMA**

339 The notice of appeal contains a single ground which alleges several errors in the primary judge’s findings concerning s 41(5) of the TMA.

8. The primary judge erred in failing to find that the Trade Marks do or will distinguish the Services as being those of the appellant and are registrable under s 41 (5) of the Act (J [151], [152]).

#### *Particulars*

The primary judge erred:

- (i) in finding (at J [127]) that it is impossible to assume that the Trade Marks are inherently adapted to distinguish the Services to any great extent;
- (ii) in finding (at J [137], [141], [144]) that the Trade Marks were not used by the appellant to any material extent to distinguish the Services in its marketing to health care professionals for recruitment purposes before the Priority Date;
- (iii) in finding (at J [131]) that the Services were “part and parcel” with the operation of a medical centre having found (at J [137], [141], [144]) that marketing in relation to the operation of a medical centre was not use in relation to the Services.
- (iv) in finding (at J [51]) that the combined effect of the matters in s 41 (5)(a)(i)-(iii) does not mean that the Trade Marks do or will distinguish the appellant’s Services from the same services offered by others.

#### ***The primary judge’s findings relevant to the s 41(5) TMA ground***

340 Section 41(5) and (6) of the TMA were alternatives. If the Registrar, applying s 41(3) of the TMA, found that the trade marks are not inherently adapted to distinguish the goods or services to any extent, the next stage of the enquiry bypassed s 41(5) and moved to s 41(6).

However, the primary judge proceeded to consider s 41(5) in case her finding that the trade marks did not distinguish the Services to any extent was wrong.

341 Although the appellant has not demonstrated any error in the primary judge's findings upon s 41(3) of the TMA, it is necessary to consider the appellant's grounds of appeal concerning s 41(5). That is because her Honour's reasoning concerning s 41(5) is closely connected to her reasoning upon s 41(6).

342 Her Honour commenced with s 41(5)(a)(i) of the TMA, which required the Registrar to consider the extent to which the trade mark is inherently adapted to distinguish the designated goods or services. Her Honour said (at J [128]) that she would assume that the trade marks have some inherent capacity to distinguish the Services.

343 The primary judge then turned to s 41(5)(a)(ii) of the TMA, which required consideration of the use, or intended use, of the trade marks by the appellant. Her Honour noted that the respondents argued that the appellant (or Idameneo) had not used (and had not demonstrated any intention to use) the phrase "primary health care" as a trade mark for the Services, but only in respect of a type of medical practice.

344 Her Honour had found earlier at:

61 Another misconception in the applicant's case is apparent. It is the notion that the applicant is in the business of providing the Services to health professionals. This is inaccurate. The applicant is in the business of operating medical centres to which it recruits GPs and, as part of a much larger set of activities, it also provides the Services to the health professionals who have contracted to work from such a centre. No health professional can simply purchase the Services from the applicant. As part of the applicant's overall activity, but not otherwise, the applicant provides the Services which of their very nature and in many respects are services to not only the GPs and allied health professionals, but also to members of the public and to others involved in the health system.

62 As noted, the applicant, on the evidence, does not offer any GP or allied health professional the Services in isolation. The applicant, for example, does not offer the Services to every GP or allied health professional. The Services are only available to a GP or allied health professional at the medical centre to which the GP or allied health professional has been recruited. Consistent with this, the applicant does not market the Services per se to GPs and allied health professionals. Rather, it markets to GPs and allied health professionals a form of practice from one of its medical centres. The form of practice is to work from a room in one of the applicant's medical centres (GPs are recruited to specific centres and must practice from that centre) which will be fully equipped and supplied by the applicant, with all staff and services necessary for the operation of a medical centre being provided by the applicant in exchange for a fee which is calculated as a percentage of the

money earned by the GP from providing clinical services to patients.

(Emphasis added.)

345 As has been noted, her Honour also found (at J [64]):

...Fifth, the applicant has tried to establish acquired distinctiveness by use of the marks in respect of the Services when the applicant does not market the Services at all in and of themselves, but markets to GPs and allied health professionals a particular form of practice in which, amongst many other things (including the basic requirements of rooms, equipment, medical supplies, cleaning and maintenance), the applicant also provides the Services.

346 The primary judge accepted (at J [130]) that the appellant has a reputation as a company whose name is “Primary Health Care Limited” and that it is known by the medical profession as the owner and operator of a large corporate chain of medical centres in most of the States and Territories of Australia. Her Honour said that this does not mean, however, that a substantial number of members of the medical profession would know of the appellant’s particular business model or the part the provision of the Services plays within that model. Only a health professional who had some particular reason to know of these matters (such as having negotiated with or been recruited by the appellant or having discussed the model with a colleague) would be aware of the appellant’s particular business model.

347 Her Honour referred (at J [131]) to the affidavits of GPs relied on by the appellant and observed that these affidavits tended to focus on the witnesses’ knowledge of the appellant under the name “Primary Health Care” as an entity which operates and/or owns medical centres, and not as a provider of the Services. Her Honour said that this was unsurprising because the Services are “part and parcel” of the operation of a medical centre and the appellant is in the business of recruiting GPs and others to practice from medical centres it operates, of which the Services form but one essential component.

348 The primary judge then considered the use of the trade marks in the appellant’s advertisements and brochures for recruitment of health practitioners, documents concerning training of staff and “Brand Style Guidelines”. Her Honour accepted (at [138]), contrary to the respondents’ submission, that the appellant had used the word mark PRIMARY HEALTH CARE (but not the logo mark) before the priority date to identify the appellant as the source of its business. This was done by using the appellant’s corporate name as a brand to identify the appellant as the source of its business of recruiting GPs to medical centres it operates and by using the word mark in correspondence with GPs as part of the recruitment process.

349 Her Honour concluded (at J [141]):

As discussed, the applicant does not market the Services. It markets a form of practice for the purpose of recruiting GPs and others to one of its medical centres. I do not think it can be said that the evidence supports the conclusion that the marks have been used by the applicant to distinguish the Services or, in fact, do distinguish the Services.

350 Her Honour found (at J [142]) that the intended use of the marks by the appellant is consistent with its past use.

351 Her Honour said she was unaware of any use of the marks by the appellant which focusses on the Services as opposed to the overall form of practice which the appellant offers to GPs and other health practitioners.

352 The primary judge then turned (at J [145]) to whether there were “any other circumstances” under s 41(5)(a)(iii) of the TMA that were relevant. Her Honour accepted the appellant’s submission that no-one else had traded under the name “Primary Health Care” in connection with the Services. However, her Honour noted that the words “health care” are commonly used by other corporate medical service providers which compete with the appellant.

353 Her Honour also observed (at J [147]) that in 2010, the appellant had commenced proceedings for misleading or deceptive conduct in respect of the proposed use of the name “Australian Primary Health Care Network” by AGPN and the Divisions of General Practice. Her Honour said that it was apparent that the Divisions of General Practice had ample legitimate reason to wish to rebrand themselves as organisations involved in primary health care. Her Honour found that, not only is general practice the fundamental component of primary health care in Australia, but it is obvious that the Divisions of General Practice had sought to align themselves with Commonwealth government policy initiatives about primary health care. Her Honour held that because the Services are part of the provision of primary health care, the actions of the Divisions of General Practice provided good evidence of other organisations involved in the same activity, without improper motive, wishing to use the phrase “primary health care” to describe their activities.

354 Her Honour concluded (at [151]):

The combined effect of the matters set out in s 41(5)(a)(i)-(iii) does not mean that the marks do or will distinguish the applicant’s Services from the same services offered by others. To the contrary, the Services are part of the provision of primary health care in Australia. They are not capable of being separated out from a wider range of activities which the applicant (and others) perform, the applicant through being the

operator of medical centres to which it recruits GPs to practice in exchange for a fee (the fee, I note, being calculated by reference to payments from patients, that is from the provision of the clinical services by the GP). Other persons involved in the provision of primary health care, be they corporate service providers, individual GPs or government funded clinics or public/private partnerships, may well wish to use the phrase “primary health care” in connection with their services of the same nature as the Services. They may well wish to do so because they are in the business of providing primary health care. The fact that Dr Bateman believed when he selected the name “primary health care” in 1994 that the name reflected the nature of the service provided from the medical centre is perhaps the best evidence of the descriptive character of the phrase.

(Emphasis added.)

355 Her Honour concluded that the appellant had not discharged its onus under s 41(5) of the TMA.

### ***Consideration of the s 41(5) TMA ground***

356 The question under s 41(5) was whether the trade mark does, or will, distinguish the designated goods or services as being those of the appellant. That question was to be answered not only by reference to the extent to which the trade mark is inherently adapted to distinguish the designated goods or services (s 41(5)(a)(i)), but also the use, or intended use, of the trade mark by the appellant (s 41(5)(a)(ii)) and any other circumstances (s 41(5)(a)(iii)).

357 In *Johnson & Johnson Australia Pty Limited v Sterling Pharmaceuticals Pty Limited* (1991) 30 FCR 326, Lockhart J explained how a descriptive word may acquire distinctiveness through use at 335-336:

If a word is prima facie descriptive the difficulty of establishing that it is distinctive of the plaintiff's goods is considerably increased. Also, if the plaintiff has not used the word simply for the purpose of distinguishing his own goods from those of others but primarily for the purpose of describing the particular kind of article to which he has applied it and only secondarily, if at all, for the purpose of distinguishing his own goods, it will be more difficult for him to establish that it is distinctive of them.

A word may be so totally descriptive of the goods concerned as to be unregistrable, for example, ELECTRICS for electrical apparatus. In less extreme cases the question is one of degree. There must be a sufficient degree of distinctiveness to counterbalance the descriptive character of the word. A word which is prima facie descriptive may become distinctive in connection with particular goods and yet retain its descriptive meaning. But the word must, in order to become distinctive, have a new and secondary meaning different from its primary descriptive one and thus cease to be purely descriptive.

Distinctive means distinctive in the sense that the mark distinguishes the registered proprietor's goods from others of the same type in that market, though it does not mean that the goods must specifically identify the plaintiff as the source of those goods. Often the identity of the supplier will be unknown, but what is important is

that a significant number of consumers in the relevant market identify the plaintiff's goods as coming from one trade source.

(Citations omitted.)

358 The primary judge assumed in the appellant's favour that the trade marks are inherently adapted to distinguish the Services to some limited extent (s 41(5)(a)(i)). Her Honour then considered the use (and intended use) of the trade marks, finding that the marks had not been used by the appellant to distinguish the Services themselves and that the marks did not, in fact, distinguish the Services (s 41(5)(a)(ii)). Her Honour then considered other relevant circumstances, concluding that other organisations might wish without improper motive to use the phrase "primary health care" in connection with their services (s 41(5)(a)(iii)). Her Honour found that when considered in combination, these factors do not, and will not, distinguish the Services as being those of the appellant.

359 The appellant's submissions focus on the second of these findings, namely that the word mark PRIMARY HEALTH CARE had not been used by the appellant to distinguish the Services. The appellant submits that the primary judge's finding that the appellant has a reputation amongst the medical profession as an owner and operator of a large corporate chain of medical centres ought to have resulted in a conclusion that the word mark had acquired distinctiveness through use. The appellant argues that her Honour's finding that the use of the marks did not focus on the Services themselves was irrelevant because provision of the Services is an integral part of the appellant's business model.

360 The appellant also points to the evidence of a number of GPs to the effect that they understand the appellant to provide administrative and managerial services as part of the operation of the medical centres. For example, Dr Kosterich, who was previously employed by a competitor of the appellant, gave evidence that:

When I say "corporate medicine provider" I mean it runs the centres and that those centres provide doctors with administrative and managerial assistance.

361 The appellant's point is that Dr Kosterich's evidence was to the effect that he understands the appellant to both run medical centres and provide the Services to doctors. Dr Kosterich's evidence, and the evidence of other GPs to that effect can be accepted.

362 The appellant submits that the fact that its business model includes features other than the Services and that it emphasises some of those features does not disentitle it to registration of the trade marks in respect of the Services. The appellant argues that her Honour's findings

that it does not offer health practitioners “in isolation” and that it does not market the Services “per se” and “in and of themselves” were irrelevant. It submits that s 41(5) of the TMA does not require that an applicant prove use in relation to the designated services of themselves and that it is no less the use of a mark in relation to the designated services that the mark is used in relation to a broader class of services. The appellant submits that her Honour identified no aspect of the statutory language or authority to support her approach.

363 The appellant applied for registration of both the word mark PRIMARY HEALTH CARE and a logo mark. The primary judge found that the appellant had not used the logo mark before the priority date. The appellant has not challenged this aspect of her Honour’s findings. Accordingly, the appellant’s submissions must be taken to refer only to her Honour’s finding that the use of the word mark does not distinguish the Services.

364 The primary judge found that the appellant had used the word mark to identify itself as the source of its business of operating medical centres to health practitioners. It did so by using the word mark in advertisements and brochures used to recruit health practitioners and in correspondence with GPs as part of the recruitment process.

365 Her Honour also found (at J [131]) that the Services are “part and parcel of” and an “essential component” of the appellant’s operation of its medical centres. However, her Honour found that the operation of the centres also encompasses, inter alia, the provision of premises from which the health practitioners operate, and plant, equipment, apparatus and instruments, staff and cleaning and maintenance. Her Honour concluded that the Services are only one component of the overall operation of the centres. Her Honour held that the marketing of the centres had not focussed on the Services and that the word mark had not been used by the appellant to distinguish the Services themselves and did not, in fact, distinguish the Services.

366 As the appellant points out, the primary judge did not analyse the statutory language or refer to authority to support the distinction her Honour made between use of the marks to distinguish the appellant’s operation of medical centres and use of the trade marks to distinguish the Services themselves. It is necessary to conduct that exercise in order to determine whether the outcome reflects error.

367 Section 41(5)(a)(ii) of the TMA required the Registrar to consider the effect of “the use, or intended use, of the trade mark” in the course of deciding whether “the trade mark does or will distinguish the designated goods or services as being those of the applicant”.

368 In *E & J Gallo Winery v Lion Nathan Pty Ltd*, the plurality observed at [41] that the concept of “use” of a trade mark in the TMA must be understood in the context of s 17. That section defines a trade mark as a sign used or intended to be used to “distinguish the goods or services” of one trader from the goods or services of others. The “use, or intended use” of the trade mark described in s 41(5)(a)(ii) must be use as a trade mark, that is to say, for the purpose of distinguishing the designated goods or services.

369 Section 27(1) of the TMA sets out conditions for the making of an application for registration of a trade mark. Section 27(1)(b) requires an intention to use the trade mark “in relation to the goods and/or services”. Section 20(1) provides that if a trade mark is registered, the registered owner has exclusive rights to use or authorise the use of the trade mark “in relation to the goods and/or services”: see also s 120(1) of the TMA. These provisions suggest that the “use” of a trade mark described in s 41(5)(a)(ii) must be use of a trade mark “in relation to” the goods or services designated in the application.

370 It follows that, for the purposes of s 41(5)(a)(ii) of the TMA, once the appellant’s use of the trade mark was identified, the first question was whether the use, or intended use, of the trade mark was “in relation to” the designated goods or services. If not, then s 41(5)(a)(ii) would not be engaged. The second question was whether the trade mark has been, or will be, used to distinguish the appellant’s designated goods or services from the goods or services of other traders. The third question was as to the extent to which such use does or will distinguish the designated goods or services. The ultimate issue under s 41(5) was whether such use (combined with the mark’s inherent adaptation to distinguish and any other circumstances) does or will distinguish the goods or services.

371 The appellant submits that:

The appellant had used the Mark in relation to the Support Services before the priority date by using it in relation to all the applicant’s services provided as part of operating medical centres. The use of the Mark by the applicant in relation to the operation of the medical centres does achieve the requisite distinctiveness.

(Emphasis added.)

372 This submission confuses the first two questions arising under s 41(5)(a)(ii) of the TMA outlined above. The expression “in relation to” is “of broad import” and “requires no more than a relationship, whether direct or indirect, between two subject matters”: *O’Grady v Northern Queensland Co Ltd* (1990) 92 ALR 213 at 226, 228. In this case, where the primary judge found that the appellant had used the word mark to distinguish its operation of

the medical centres, and where an essential component of such operation is the Services, the use of the word mark was “in relation to” the Services. The primary judge can be taken to have assumed that issue in favour of the appellant because her Honour proceeded to consider whether the appellant’s use of the word mark was to distinguish the Services from the services provided by others.

373 As Yates J observed in *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* [2015] FCA 756 at [34], mere evidence of use of a sign does not establish its distinctiveness for trade mark purposes. Whether the appellant used the word mark to distinguish the Services, and the extent to which it achieved distinctiveness, involved an evaluative judgment. The primary judge found that the appellant had used the word mark to distinguish its operation of its medical centres, but had not used the mark to distinguish the Services.

374 The appellant’s principal argument, in substance, is that the primary judge’s finding that the appellant had not used the word mark to distinguish the Services was illogical or plainly wrong in light of her Honour’s finding that the Services are an essential component of the operation of the medical centres. The judgment of the Full Court in *MID Sydney Pty Ltd v Australian Tourism Co Ltd* (1998) 90 FCR 236 at 242 provides, by analogy, support for her Honour’s reasoning. It was held that where a company conducted a hotel business and, as a relatively small but integral part of that business, provided property management services, the company could not be said to provide a “property management service” such as to infringe a registered trade mark. In this case, her Honour considered that where the appellant had used the word mark to market its business of operating medical centres, and the Services are only a single, although essential, component of that business, the appellant did not use the mark to market the Services themselves.

375 It can be accepted that in some circumstances use of a trade mark to distinguish a broader class of services encompassing the designated services may operate to distinguish the designated services themselves. It may be, for example, that the designated services are so integral to, and such a large part of, the broader class that marketing the broader services also amounts to marketing the designated services themselves. Whether the trade mark use is used to distinguish the designated services, and whether it does distinguish the services, involves matters of fact and degree.

376 The primary judge found that the appellant’s use of the word mark to distinguish the operation of the medical centres did not distinguish the Services. Her Honour was influenced

by the fact that provision of the Services, while essential to the operation of the medical centres, is only a limited part of their operation. Other essential components include the provision of premises, equipment and staff. The appellant's use of the word mark did not focus on the Services, just as it did not focus on any of these other individual components. The appellant cannot be said to have used the word mark in its marketing to distinguish the Services any more than it used the word mark to distinguish its provision of premises or equipment. Her Honour concluded that the word mark was used to market and distinguish the operation of the centres as a whole and not any of the individual components. The appellant has not shown that the primary judge's reasoning on this issue is illogical or otherwise wrong.

377 Even if the appellant had been able to demonstrate that the appellant used the word mark to market the Services to health practitioners, it faced another significant obstacle. The primary judge rejected a submission that a substantial number of the members of the medical profession would know of the appellant's business model or the part that the provision of the Services plays within that model. Her Honour found that only a health practitioner who had some particular reason to know of these matters (such as having been recruited by or negotiated with the appellant or having discussed the model with a colleague) would be aware of the business model. In light of that finding, the evidence of Dr Kosterich and other GPs of their understanding that the appellant provides the Services was of limited utility to the appellant. Even if the appellant had been able to show that it used the word mark to market the Services to health practitioners, it did not show that a substantial number of health practitioners were aware of such use in relation to the Services.

378 Further, there is no suggestion that the appellant used the word mark to market the Services to the general public. There was no evidence that, for patients, the word mark distinguishes the appellant's services.

379 There is also the difficulty for the appellant of her Honour's finding, in relation to AGPN's attempt to register a similar trade mark, that there is good evidence that other organisations involved in the provision of primary health care may, without improper motive, wish to use the trade marks to describe their activities.

380 There was no error in the primary judge's conclusion that the appellant failed to discharge its onus of proving that the use or intended use of the word mark, in combination with the inherent adaptation of the word mark to distinguish and any other circumstances, does or will

distinguish the Services as being those of the appellant to a significant number of persons concerned with the Services.

381 For these reasons, Ground 8 of the notice of appeal must be rejected.

**The appellant's ground of appeal concerning s 41(6) of the TMA**

382 The notice of appeal contains the following grounds alleging error in the primary judge's findings concerning s 41(6) of the TMA:

- 9 The primary judge erred in failing to find that because of the extent of the use of the Trade Marks before the Priority Date, the Trade Marks distinguish the Services as being those of the appellant and are registrable under s 41 (6) of the Act (J [153], [160]).

*Particulars*

The primary judge erred:

- (i) in finding (at J [137], [153]) that the Trade Marks were not used by the appellant to any material extent to distinguish the Services in its marketing to health care professionals for recruitment purposes before the Priority Date;
- (ii) in finding (at J [160]) that the Trade Marks do not distinguish the appellant's Services from the same services offered by others.

- 10 The primary judge erred in finding (at J [155], [158]) that the phrase "primary health care" has not acquired a secondary meaning in respect of the appellant's activity in providing the Services, and that the only secondary meaning which the phrase has obtained by reason of the appellant is as a corporate entity which recruits GPs and other allied health care professional to the medical centres it operates.

383 The primary judge's conclusions in respect of s 41(5) of the TMA also answered the enquiry under s 41(6). Her Honour was not satisfied that because of the extent to which the appellant had used the marks before the filing date, the marks distinguished the Services as being those of the appellant. That was because the use of the word mark before the filing date related to the operation of the medical centres as a whole, and not to the Services. Further, the logo mark had not been used before the filing date.

384 Her Honour observed (at J [154]) that for a trade mark which is prima facie descriptive to become distinctive, it must acquire a new and secondary meaning different from its primary descriptive meaning. Her Honour found that the phrase "Primary Health Care" has obtained a secondary meaning by reason of the appellant's use, referring to the appellant as a corporate entity which recruits GPs to the medical centres it operates. However, her Honour found that

the secondary meaning is not in connection with the Services. Her Honour said that the difficulty comes back to the artificial construct which the appellant had sought to create. In the appellant's business model, the Services are part of and subsidiary to the operation of the medical centres and have no existence other than in that context.

385 Her Honour held (at J [158]) that the appellant failed to prove, as required by s 41(6) of the TMA, that because of the extent of its use of the trade marks before the filing date in respect of the application, the marks distinguish the Services as being those of the appellant. Her Honour held that the marks are not taken to be capable of distinguishing the Services from the Services of other persons, and the application for registration must be refused on that basis.

386 The appellant's grounds in respect of s 41(6) of the TMA are substantially the same as those in respect of s 41(5). The appellant alleges that her Honour erred in distinguishing between use of the word mark to market the appellant's business of provision of medical centres and use to market the Services. As that submission has been rejected in respect of s 41(5) of the TMA, it must also be rejected in respect of s 41(6).

387 Accordingly, Grounds 9 and 10 of the notice of appeal cannot succeed.

### **The appellant's grounds of appeal concerning s 43 of the TMA**

388 The appellant's grounds dealing with the primary judge's findings concerning s 43 of the TMA are as follows:

#### **s.43 Connotation and likelihood of Deception or Confusion**

11 The primary judge erred in finding (at J [164]) that the phrase "primary health care" has a clear connotation of "first level or first contact health care", and did so as at the Priority Date.

12 The primary judge erred in finding (at J [165], [167], [169], [171]-[172], [174], [182], [183], [187]) that there is a real likelihood of deception and confusion arising out of the use of the phrase "primary health care" in connexion with the provision of the Services where the provider, here the appellant, does not also provide clinical care.

#### *Particulars*

The primary judge erred:

- (i) in finding (at J [165], [166], [171], [174]) that persons not privy to or "acculturated" to the appellant's business model would be deceived or confused when the Trade Marks were used in the respect of the Services;

- (ii) in finding (at J [175]) that the number of health care professionals who would not have knowledge of the appellant's business model must be substantial;
- (iii) in finding (at J [168], [169], [172], [177]), in the absence of any evidence, that members of the public, health care professionals and others involved in the health sector exposed to the Services are likely to be confused.

13 The primary judge erred in finding (at J [175], [176]) that the Services are not sold in a specialised market consisting of persons engaged in a particular trade, and that on that basis, evidence of confusion from health care professionals was not required before drawing the inference of likely confusion.

389 Section 43 of the TMA provides:

**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.

390 The primary judge found that there was a relevant connotation, holding (at J [164]):

The phrase "primary health care", as it appears in the applicant's marks, has a clear connotation (and did so at the priority date), the connotation being not the applicant as the source of the Services, but first level or first contact health care.

391 Having found that the trade marks carry that connotation, her Honour found that the use of the marks in relation to the Services would be likely to deceive or cause confusion. That risk arose because the marks refer to "primary health care" generally, but the appellant's particular business model ensures that the appellant is not the provider of, nor responsible for, the clinical care provided by the contracted GPs. The Services provided by the appellant are a component of primary health care, but so too is clinical or medical care. Her Honour considered that no one other than a person familiar with details of the appellant's business model could avoid confusion about the nature of the services the appellant in fact provides and the responsibility for clinical care provided from the appellant's medical centres.

392 Her Honour held (at J [172]) that the persons who had not become acculturated to the appellant's business model and would be confused include the bulk of medical professionals in Australia, (given that no more than 5% of GPs and a far smaller percentage of allied health professionals in Australia practice at one of the appellant's medical centres), members of the public and people in the public health sector.

393 As may be seen from Ground 11 of the notice of appeal, the appellant's principal submission is that the primary judge erred in finding that the trade marks carry a connotation of "first level/first contact health care". The appellant submits that what her Honour identified as a connotation is in fact, on her Honour's earlier reasoning, the denotation of the phrase "primary health care". The argument continues that, as no relevant connotation had been identified, s 43 of the TMA has no application.

394 The application of s 43 of the TMA requires identification of "some connotation that the trade mark or a sign contained in the trade mark has". There is a distinction between a denotation and a connotation. The *Oxford English Dictionary* defines "denotation" as the "meaning or signification of a term", while the *Macquarie Dictionary* defines that term, relevantly, as "the meaning of a term when it identifies something by naming it (distinguished from *connotation*)". The *Oxford English Dictionary* defines "connotation" as, relevantly, "[t]hat which is implied in a word in addition to its essential or primary meaning", while the *Macquarie Dictionary* defines that term as "secondary implied or associated meanings (distinguished from *denotation*)". To identify the connotation of a word, it is usually necessary to begin by identifying its denotation, or in other words, its essential or primary meaning. An exception is that a made-up word may have no primary meaning, but still have a connotation.

395 In this case, the primary judge found (at J [164]) that the trade mark PRIMARY HEALTH CARE has a relevant connotation, namely "first level or first contact health care". However, her Honour's identification of the trade mark's denotation is unclear. Her Honour described the connotation as being "not the applicant as the source of the Services, but first level or first contact health care." In that passage, her Honour seems to have decided that the denotation (essential or primary meaning) of PRIMARY HEALTH CARE is "the applicant as the source of the Services" and the connotation (implied or secondary meaning) is "first level or first contact health care".

396 Where s 43 of the TMA refers to a "connotation", it refers to an implied or secondary meaning that is *inherent* in the trade mark. There is ample authority for that proposition. In *TGI Friday's Australia Pty Ltd v TGI Friday's Inc* (2000) 100 FCR 358, the Full Court said at [43]:

The case on deception and confusion sought to be made by Big Country and Friday's Australia in the present proceedings...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.

397 In *McCorquodale v Masterson* (2004) 63 IPR 582, where the trade mark included the words “Diana’s Legacy in Roses”, together with pictures of roses, Kenny J held that the mark carried a connotation of the late Princess Diana. Her Honour observed at [26]:

In order for s43 to apply, the court must be satisfied that there is a reasonable likelihood of deception or confusion arising because of the connotation within the mark, having regard to the nature of the goods or services to which it is to apply and other relevant considerations.

398 In *Pfizer Products Inc v Karam* (2006) 219 FCR 585, the issue was whether HERBAGRA carried a connotation of a sponsorship or association with VIAGRA. Justice Gyles held that it did not. His Honour noted at [52] that the explanatory memorandum for the Bill introducing s 43 to the TMA stated:

That an application for registration must be rejected if the trade mark ... because of some signification inherent to it, would be likely to deceive or cause confusion regarding a characteristic of the goods or services.

His Honour continued:

[53] “Connotation” is a secondary meaning implied by the mark. The likelihood of deception or confusion must flow from the secondary meaning inherent in the mark itself. It is apparent that the underlying purpose of s 43 is a similar purpose to that lying behind ss 52, 53 and 55 of the *Trade Practices Act 1974* (Cth). It is to prevent the public being deceived or confused as to the nature of the goods offered by reason of a secondary meaning connoted by the mark in question, rather than, for example, deception by reason of similarity with other marks.

...

[55] In my opinion, there is no relevant secondary meaning connoted by the mark HERBAGRA. An implication of sponsorship or association might qualify as such a secondary meaning or connotation, but I am not persuaded that the mark itself has that secondary meaning here.

See also *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 365 at 388-389, *Winton Shire Council v Lomas* (2002) 119 FCR 416 at 421.

399 Section 43 of the TMA applies to a connotation inherent in a trade mark. It is necessary to identify “some connotation that the trade mark or a sign contained in the trade mark has”. Registration must be rejected if, because of that connotation, “the use of the trade mark in relation to the relevant goods or services would be likely to deceive or cause confusion”. It is only after the connotation is identified, that the use of the trade mark falls to be considered. The use of the trade mark is not relevant to the identification of any connotation. There is a

parallel with s 41(3) of the TMA where the inherent adaptability of the trade mark to distinguish could not be determined by reference to the use of the trade mark: see *Burger King Corporation v Registrar of Trade Marks* at 424.

400 As has been mentioned, in *E & J Gallo Winery v Lion Nathan Pty Ltd*, the plurality observed at [41] that the concept of “use” of a trade mark in the TMA must be understood in the context of the definition of “trade mark” in s 17. The “use of the trade mark” that s 43 of the TMA refers to is use to distinguish the goods or services as those of the applicant for registration.

401 Just as a connotation, or secondary meaning, of a trade mark must be found within the mark itself, so too must its denotation, or primary meaning, for the purposes of s 43 of the TMA. Further, just as use of the trade mark cannot be considered in identifying a connotation, use of the mark cannot be considered in identifying its denotation. It would be inconsistent and incongruous to construe s 43 otherwise.

402 The difficulty with her Honour’s identification of the denotation of PRIMARY HEALTH CARE as “the applicant as the source of the Services” is that it relies upon the use of the trade mark, not merely its inherent meaning. The trade mark can be regarded as having the inherent denotation of “first level or first contact health care”. However, there is no inherent meaning of the phrase which identifies the appellant as the source of the services. The connection between the appellant and the Services can only emerge from the appellant’s use of the trade mark to distinguish its Services from services provided by others or, in other words, to identify itself as the source of the Services. If the trade mark means “the appellant as the source of the Services”, that meaning can only come from the appellant’s reputation as that source. However, the appellant’s reputation is not a matter that can be considered in identifying the denotation. It was an error for the primary judge to identify the denotation, or primary meaning, of the trade mark as “the applicant as the source of the Services”.

403 This conclusion does not suggest that a trade mark can be registered where the mark’s denotation would make its use deceptive. Section 42(b) of the TMA, taken with s 18 of the ACL and equivalent State legislation, requires that registration of a trade mark must be refused where the use of a trade mark is misleading or deceptive, or likely to mislead or deceive. That provision allows for use of the trade mark, even in the absence of any relevant connotation, to be taken into account. Where s 43 applies, the test is a less exacting one than

under s 42(b), as “confusion” is enough to require refusal of registration. The two provisions have different, but overlapping, fields of operation.

404 Her Honour found (at J [113]) that the ordinary signification of PRIMARY HEALTH CARE for the purposes of s 41(3) of the Act was “first level/first contact health care” That was a meaning inherent in the trade mark. That was the relevant denotation for the purposes of s 43. Her Honour should have started with that denotation and then determined whether there was a relevant secondary, implied meaning. What her Honour found to be the connotation of the phrase was in fact its denotation. That was an error.

405 Ground 11 should succeed. In view of this conclusion, it is unnecessary to consider Grounds 12 and 13.

406 The error makes no difference to the outcome of the appeal as her Honour correctly refused registration of the trade marks under s 41 of the TMA. In addition, as will be seen, her Honour’s conclusion that registration should be refused under s 42 (b) as the use of the trade marks would misleading or deceptive, or likely to mislead or deceive, should be upheld.

### **The appellant’s grounds of appeal concerning s 42 of the TMA**

407 The notice of appeal contains one ground challenging the primary judge’s findings concerning s 42 of the TMA:

#### **s.42 Contrary to Law**

14 The primary judge erred in finding (at J [190]) that use of the phrase “primary health care” as a trade mark in respect of the Services would be contrary to s 18 of the *Australian Consumer Law*, and was so as at the Priority Date.

408 Section 42 of the TMA provides:

#### **Trade mark scandalous or its use contrary to law**

An application for the registration of a trade mark must be rejected if:

...

(b) its use would be contrary to law.

409 Section 18 of the ACL prohibits a corporation from engaging in conduct in trade or commerce that is misleading or deceptive or likely to mislead or deceive. Her Honour held, relying upon findings made earlier concerning s 43 of the TMA, that use of the trade marks in respect of the Services would contravene that provision.

- 410 The primary judge correctly identified (at J [189]) that the question of whether the use of the trade marks would be contrary to law was to be considered at the priority date. Section 18 of the ACL was not in force at the priority date, 6 October 2009. Accordingly, as the appellant points out, her Honour ought to have instead considered the ground of objection under s 42(b) of the TMA by reference to s 52 of the *Trade Practices Act 1974* (Cth) (**the TPA**). This was a slip by the primary judge, but it was not one that was material given that s 18 of the ACL replaced s 52 of the TPA and the provisions are in identical terms.
- 411 Section 42(b) of the TMA requires that the use of a trade mark “would be” contrary to law. It is not enough for a party opposing registration to show that s 18 of the ACL or s 52 of the TPA *might* be contravened. The opponent must prove, on the balance of probabilities, that the provision *would* be contravened by use of the trade mark.
- 412 The principles concerning contravention of s 18 of the ACL and s 52 of the TPA are well known and include the following.
- 413 The question of whether conduct is misleading or deceptive or likely to mislead or deceive must be considered by reference to the class of consumers likely to be affected by the conduct: *Parkdale Custom Built Furniture Proprietary Ltd v Puxu Pty Ltd* (1982) 149 CLR 191 at 199, 209.
- 414 No conduct can mislead or deceive unless the person to whom the representation is made labours under some erroneous assumption: *Taco Company of Australia Inc v Taco Bell Pty Ltd* (1982) 42 ALR 177 at 200. It must be determined what misconceptions or deceptions alleged to arise are properly to be attributed to ordinary and reasonable members of the classes of prospective consumers: *Campomar Sociedad, Limitada v Nike International Limited* (2000) 202 CLR 45 at [105].
- 415 The question is whether a not insignificant number of reasonable persons within the class are likely to be misled or deceived by the conduct, whether in fact or by inference: *Hansen Beverage Company v Bickfords (Australia) Pty Ltd* (2008) 171 FCR 579 at [46], [66]; *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302 at 380-381; *Bodum v DKSH Australia Pty Ltd* (2011) 280 ALR 639 at [205].
- 416 Conduct is misleading or deceptive or likely to mislead or deceive if it has a tendency to lead into error: there must be a sufficient causal link between the conduct and error on the part of

the person exposed to the conduct: *Australian Competition and Consumer Commission v TPG Internet Pty Ltd* (2013) 250 CLR 640 at [39].

417 The question of what is the natural and ordinary meaning conveyed by a publication or conduct is to be ascertained by the Court applying an objective test of what ordinary or reasonable consumers in the relevant class would understand as the meaning: *Bodum* at [203]; *Parkdale v Puxu* at 199, 204-5.

418 The representations relied on by the opponent for the purposes of s 42(b) of the TMA must be representations that will be made by the appellant by using the trade marks *as trade marks*, that is to distinguish the appellant's goods or services from those provided by another trader.

419 The question for the primary judge was whether, by the appellant's use of the trade marks as trade marks, a not insignificant number of ordinary persons in the relevant class were likely to be misled or deceived.

420 Her Honour identified the relevant class as consisting of health practitioners, people working in the public health sector and the general public, as patients. The appellant submits that the only members of the class who should have been considered are health professionals, relying on *Campomar Sociedad, Limitada v Nike International Limited* at [102] where it was said that it is necessary to assess the reactions of ordinary or reasonable members of the "class of prospective purchasers". However, that statement was made in the context of the case, which involved mass marketing of retail products. There are other authorities which refer, not to purchasers, but consumers. For example, in *Parkdale v Puxu* it was held at 199 that "consideration must be given to the class of consumers likely affected by the conduct". In *Concrete Construction (NSW) v Nelson* (1990) 169 CLR 594 it was held that at 604:

What the section is concerned with is the conduct of a corporation towards persons, be they consumers or not, with whom it (or those whose interests it represents or is seeking to promote) has or may have dealings.

421 Her Honour found that use of the trade marks in respect of the Services would represent that:

- (1) the appellant provides primary health services; and
- (2) the appellant is responsible for the health and medical services provided by the practitioners within the appellant's medical centres.

422 Her Honour found that these representations were misrepresentations.

- 423 The appellant submits that the first of the representations is inconsistent with her Honour's earlier finding for the purposes of s 41(3) of the TMA that "primary health care" signifies "first level/first contact health care". The appellant submits that the same words cannot convey a different and more specific representation that the appellant "provides" first level/first contact health care. However, the enquiry under s 41(3) depends upon the *inherent* signification of the trade marks, and excludes *use* of the trade mark. The enquiry in respect of s 42(b) is based upon *use* of a trade mark and, in addition, when considered in the context of s 18 of the ACL or s 52 of the TPA, its inherent signification. In light of that distinction, there was no inconsistency in her Honour's finding that the appellant's use of the marks as trade marks would represent that the appellant provides primary health care.
- 424 The primary judge had earlier decided (at J [122]) that the appellant "is in the business of providing primary health care". The appellant submits that her Honour could not then logically find the representation that the appellant provides primary health care to be false. It is the case that if the first representation is construed literally, then, according to her Honour's earlier findings, the first representation must true. However, her Honour expressly relied on the findings she had made earlier, including those concerning s 43 of the TMA, and the description of the first representation must be understood in the context of those findings. Her Honour had found that use of the trade marks in respect of the Services would deceive or confuse people unfamiliar with the appellant's business model into thinking that the appellant provides clinical or medical care when the appellant does not provide such care. The first representation found by her Honour must be understood as being that the use of the trade marks in respect of the Services would represent that the appellant provides all aspects of primary health services, including clinical care. When the representation is construed in that way, the representation is misleading or deceptive, or likely to mislead or deceive, since the appellant does not provide clinical care.
- 425 The appellant submits that it is unclear what the primary judge meant by use of the word "responsible" in the second representation. The appellant submits that it could mean legal responsibility, professional responsibility or responsibility for the cost of the services provided at the medical centres. The appellant submits that it is not apparent why a member of the target audience would make any assumption about who is responsible for such services. The appellant also argues that there was no analysis by her Honour as to whether any "responsibility" rests with the appellant alone or with the health practitioners or both, so there was no basis for concluding that the representation was false.

426 The primary judge found that second representation arising from the use of the trade marks is that the appellant is responsible for the health and medical services provided by the practitioners within the appellant's medical centres. That begs the question of what was meant by "responsible for". Early in the reasons, her Honour found (at J [27]) that, "The only thing the applicant does not do and is not responsible for is the provision of the clinical care which the contracting GPs provide to patients who attend the centre". Her Honour seems to distinguish there between "responsible for" and "provide". Once that distinction is made, it is unclear whether the "responsibility" is legal responsibility or some other type of responsibility. There is force in the appellant's submission that there is a lack of clarity or ambiguity in the formulation of the second representation. That lack of clarity means that it could not be decided whether the representation was true or false. It should have resulted in a finding that the respondent had not proved that the second representation was misleading or deceptive.

427 The appellant argues that the primary judge's conclusion that use of the trade marks would contravene s 18 of the ACL relied on the findings made pursuant to s 43 of the TMA and those findings were only that use of the mark would cause "confusion". The appellant submits that her Honour did not separately consider, or find, that the use of the trade marks would amount to misleading or deceptive conduct, rather than mere confusion.

428 In *REA Group Ltd v Real Estate 1 Ltd* (2013) 217 FCR 327, Bromberg J succinctly summarised the authorities dealing with this issue at [79]:

Conduct which causes confusion or wonderment will not necessarily be misleading or deceptive. If the conduct of a corporation gives rise to confusion and uncertainty in the minds of the public about whether two products or services might have come from the same source, the corporation does not necessarily contravene s 52. However, if the conduct of a corporation causes more than mere confusion and causes consumers to actually conclude that two products do come from the same source, such conduct is likely to be misleading and deceptive. The representee must be led into error and labour under an erroneous assumption.

(Citations omitted.)

429 It is true that establishing confusion may not be enough to prove a contravention of s 18 of the ACL. However, her Honour's findings concerning s 43 of the TMA went beyond merely finding that the use of the trade marks would cause confusion. For example, her Honour found (at J [171]) that "use of the mark in connection with the Services is likely to *deceive* and cause confusion" and that (at J [172]) persons "would be likely to be *misled* and confused by their use in respect of the Services"(emphasis added). Her Honour did find that the use of

the trade marks would amount to conduct that was misleading or deceptive, or likely to mislead or deceive, as well as causing confusion. Her Honour did not make the error alleged by the appellant.

430 The appellant submits that the evidence that the appellant had used the word mark widely and continuously for 15 years without complaint ought to have resulted in a finding that its use was not misleading or deceptive. However, evidence that consumers have been misled is not essential. In *Australian Competition and Consumer Commission v Coles Supermarkets Australia Pty Ltd* (2014) 317 ALR 73, Allsop CJ said at [45]:

Evidence that someone was actually misled or deceived may be given weight. The presence or absence of such evidence is relevant to an evaluation of all the circumstances relating to the impugned conduct. Where the conduct and representations are to the public generally and concern a body of simple direct advertising, the absence of individuals saying they were misled may not be of great significance...The objective assessment of advertising using ordinary English words in an attempt to persuade can be undertaken without the lengthening of a trial by the bringing of witnesses of indeterminate numbers. Language, especially advertising, seeking to raise intuitive senses and associations, can have its ambiguities and subtleties. The task of evaluating the objective character and meaning of the language in the minds of reasonable members of the public is not necessarily one that will be assisted in any cost-effective manner by calling members of the public. The question is one for the court.

(Citations omitted.)

431 The issue for the primary judge was whether use of the trade marks in relation to the Services was misleading or deceptive or likely to mislead or deceive. The question of whether anyone was in fact misled, while relevant, was not decisive.

432 The appellant argues that her Honour took a shortcut to the determination of the ground under s 42(b) of the TMA, failing to direct attention to the principles identified in the relevant authorities and failing to provide adequate reasons. Her Honour's consideration of s 42(b) was succinct, but the analysis relied heavily on the detailed findings already made in respect of other issues in the case, particularly s 43. Her Honour had also referred to a recent case, *Accor Australia & New Zealand Hospitality Pty Ltd v Liv Pty Ltd* [2015] FCA 554, which set out many of the principles concerning s 52 of the TPA described above. It cannot be said that her Honour was unaware of the principles. Nor do the appellant's generalised criticisms assist to reveal any misunderstanding of the principles in her Honour's analysis, at least in respect of the first representation.

433 The appellant's contention that the second representation found by her Honour to be made by the use of the trade marks should not have been found to be misleading or deceptive should be accepted.

434 However, the appellant's submissions concerning the first representation should be rejected. It follows that her Honour was correct in deciding that the ground of objection under s 42(b) of the TMA was made out.

### **SUMMARY**

435 The primary judge held that the respondents had established the grounds for rejection of registration of the trade marks under each of ss 41, 42 and 43 of the TMA.

436 In the appeal, the appellant has demonstrated error in her Honour's finding that, for s 42(b) of the TMA, use of the trade marks would misrepresent that the appellant is responsible for the medical services provided by health practitioners within the appellant's medical centres. However, no error has been demonstrated in her Honour's further finding that use of the services would misrepresent that the appellant provides clinical care to patients, and so would contravene s 18 of the ACL (and s 52 of the TPA). Therefore, the error is not material as it does not ultimately affect her Honour's conclusion that the ground under s 42(b) was established.

437 The appellant has also demonstrated error in her Honour's finding that the respondents had established the ground under s 43 of the TMA. However, the appellant has failed to establish any material error in her Honour's conclusion that registration of the trade marks must be refused under ss 41 and 42. Therefore, the error in respect of s 43 cannot affect the outcome of the appeal.

438 The appeal should be dismissed. The appellant should pay the respondents' costs of the application for leave to appeal and the appeal.

I certify that the preceding two hundred and eighty-one (281) numbered paragraphs are a true copy of the Reasons for Judgment herein of the Honourable Justice Rangiah.

Associate:

Dated: 9 November 2017

## **SCHEDULE OF PARTIES**

**NSD 542 of 2016**

### **Respondents**

Fourth Respondent:	THE CROWN IN THE RIGHT OF THE NORTHERN TERRITORY
Fifth Respondent:	THE CROWN IN THE RIGHT OF THE STATE OF QUEENSLAND
Sixth Respondent:	THE CROWN IN THE RIGHT OF THE STATE OF SOUTH AUSTRALIA
Seventh Respondent:	THE CROWN IN THE RIGHT OF THE STATE OF TASMANIA
Eighth Respondent:	THE CROWN IN THE RIGHT OF THE STATE OF VICTORIA
Ninth Respondent:	THE CROWN IN THE RIGHT OF THE STATE OF WESTERN AUSTRALIA

**From:** [Michael Yoon](#)  
**To:** [Bogdan Mitic](#)  
**Subject:** FW: Clarification as to Part 13.6.1 of Manual [SEC=OFFICIAL]  
**Date:** Monday, 8 November 2021 4:15:43 PM  
**Attachments:** [image001.gif](#)  
[image010.jpg](#)  
[image011.jpg](#)  
[image012.jpg](#)  
[image013.jpg](#)

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## OFFICIAL

Hi Bogdan,

As discussed, here is the email chain with me and the then-Tech Hub in relation to s51(1)(a). It appears that this “clarification” was given 7 years ago, so revisiting this would definitely be useful.

Cheers,

Michael

---

**From:** MDB-Technical Hub <MDB-TechnicalHub@ipaaustralia.gov.au>  
**Sent:** Monday, 15 December 2014 1:00 PM  
**To:** Michael Yoon <michael.yoon@ipaaustralia.gov.au>  
**Cc:** MDB-Technical Hub <MDB-TechnicalHub@ipaaustralia.gov.au>  
**Subject:** RE: Clarification as to Part 13.6.1 of Manual [SEC=UNCLASSIFIED]

Hi Michael,

Apologies for the delay. Following careful consideration and consultation with various examiners with series expertise, I can confirm that the distinction between the two examples you have raised is based on the relevant area of the goods/services claimed. While in the first example, the Applicant has claimed both footwear and headgear, these goods are related and in the same Class. This is not the case with the second example, with footwear and financial services being too different for the trade mark IDAK FOOTWEAR to be considered a statement of services for financial services and vice versa.

The use of commas or semi-colons does not change the question. If an applicant claims clothing, footwear and headgear they may still choose to only use IDAK footwear on headgear in practical use. Example 3 in “Examples of Invalid Series Trade Marks” give guidance as to what type of use on different goods and services would make the series invalid and this is our practice.

The determination requires individual assessment of each application as there is no definitive rule identifying the line between related goods/services in the same area and unrelated goods/services. However, in difficult cases, consultation between series examiners would be advisable. If you would like to propose a new or amended approach, please feel free to draft a proposed practice for consideration. It may also be useful to canvass opinions from present and past series examiners during this process.

Please free to contact me if you would like any further clarification.

Kind regards,

**Janette Yeung**

Trade Marks & Designs  
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**From:** Michael Yoon

**Sent:** Friday, 28 November 2014 2:59 PM

**To:** MDB-Technical Hub

**Subject:** RE: Clarification as to Part 13.6.1 of Manual [SEC=UNCLASSIFIED]

Hi Janette,

Thanks for getting back to me.

To clarify, suppose there is a series application for the following:

IDAK FOOTWEAR

IDAK HEADGEAR

Class 25: *Footwear; headgear*

If this application is deemed to be valid, that means that the Office is allowing for all the goods/services claimed to be considered as a whole as opposed to assessing each individual item (for the purposes of s51(1)(a) of the TMA), since one cannot argue that HEADGEAR is a statement or representation for *footwear* alone.

Consider, then, the next example:

IDAK FOOTWEAR

IDAK LOANS

Class 25: *Footwear*

Class 36: *Financial services*

If the previous example is deemed to be valid, then this example should logically also be deemed valid, as the goods/services are looked upon as a whole. If this is the case, then the examples provided in the Manual are inconsistent and incorrect.

My understanding is that each individual item is considered when determining whether the differences are mere statements or representations for the purposes of s51(1)(a).

Let me know what you think.

Thanks

Michael

---

**From:** MDB-Technical Hub  
**Sent:** Friday, 28 November 2014 2:21 PM  
**To:** Michael Yoon  
**Cc:** MDB-Technical Hub  
**Subject:** RE: Clarification as to Part 13.6.1 of Manual [SEC=UNCLASSIFIED]

Hi Michael,

Apologies for the delayed response. I'm not quite sure I fully understand the nature of your query. Example 1 in the Manual Part 13.6.1 is a valid series trade mark as the series IDAK CLOTHING; IDAK FOOTWEAR; IDAK HEADGEAR is a statement as to the claim for "*Clothing, footwear, headgear*" whether or not the goods are separated by a comma or semi-colon.

In other words, both the following examples are examples of valid series trade marks:

Example 1     Class 25 claim for *Clothing, footwear, headgear*.

                  IDAK CLOTHING  
                  IDAK FOOTWEAR  
                  IDAK HEADGEAR

Example 2     Class 25 claim for *Clothing; footwear; headgear*.

                  IDAK CLOTHING  
                  IDAK FOOTWEAR  
                  IDAK HEADGEAR

Example 3 in Part 13.7.2 under 51(1)(a) is an invalid series as it involves claims for unrelated goods and services in different Classes, namely Class 25 and Class 36. There may be a question of validity where an application has claimed only one specific category of apparel along with the series IDAK CLOTHING; IDAK FOOTWEAR; IDAK HEADGEAR. However, as *Clothing, footwear, headgear* have all been claimed in the above example, the series satisfies s51(1)(a) of the Act as a statement as to the goods in which the trade mark are to be used.

I hope this helps and please feel free to contact me if you would like any clarification.

Kind regards,

**Janette Yeung**

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**From:** Michael Yoon  
**Sent:** Wednesday, 19 November 2014 11:54 AM  
**To:** MDB-Technical Hub  
**Subject:** Clarification as to Part 13.6.1 of Manual [SEC=UNCLASSIFIED]

Hi there,

I am seeking clarification as to the example provided on the Manual in regards to a valid series where the differences pertains to statements or representations as to the goods or services in relation to which the trade marks are to be used.

Presently, the Manual provides this example as being valid:

Example 1    Class 25 claim for *Clothing, footwear, headgear.*  
                  IDAK CLOTHING  
                  IDAK FOOTWEAR  
                  IDAK HEADGEAR

I agree with this example being valid under s51(1)(a). However, would this example be valid if the claims were *clothing; footwear; headgear?* ie. if there were three separate claims, could one argue that a claim for *footwear* alone is a statement or representation for 'HEADGEAR'?

If we allow the above example to proceed as a valid series, then the example provided in Part 13.7.2 Example 3 would not be correct.

I only raise this because I have been receiving a lot of comments from applicants and attorneys about the example provide in Part 13.6.1, and the fact that just because a semi-colon was used rather than a comma, their series applications have been deemed invalid.

Your views and comments would be greatly appreciated.

Cheers

**Michael Yoon**  
Trade Mark Examination  
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**From:** [John Braybrooks](#)  
**To:** [Cristy Condon](#)  
**Cc:** [Bogdan Mitic](#)  
**Subject:** FW: Series Practice [SEC=OFFICIAL]  
**Date:** Monday, 8 November 2021 3:06:39 PM  
**Attachments:** [image001.png](#)

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Hi Cristy

I hope everything is well. One of the things on my Achieve plan is closer relations with Hearings - especially between Policy Officers and Hearings Officers.

Bogdan is raising something that is worthy of us getting together and discussing practice to settle a few questions.

I was thinking of Bogdan + Michael Yoon (Series Manager) + a couple of Hearing officers – maybe Tim Brown and or Adrian?

Any views?

John

John Braybrooks  
Deputy Registrar  
Trade Marks & Designs Office  
IP Australia



Ph: 02 6283 2857 E [john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)

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**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:38 PM  
**To:** John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** Series Practice [SEC=OFFICIAL]

**OFFICIAL**

Hi John,

A recent series application has raised some questions regarding our practice for the examination of series trade marks, both in terms of s51 and when terms that are descriptive of only some of the claims become material particulars, but also how section 43 applies.

I think it would be advisable to arrange a meeting with the Oppositions and Hearings section, along with the SMEs, to discuss what is the correct approach.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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**User Name:** MDB Library 1

**Date and Time:** Friday, 3 December 2021 4:07:00 PM AEDT

**Job Number:** 159090718

## Document (1)

1. [Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications](#)

**Client/Matter:** -None-

**Search Terms:** series trade mark

**Search Type:** Natural Language

**Narrowed by:**

**Content Type**  
AU Secondary Materials

**Narrowed by**  
-None-

## [Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications](#)

Patents, Trade Marks & Related Rights

Last updated: June 2020

Ann Dufty LLB (Hons) (Melb) LLM (Monash)

[Patents, Trade Marks & Related Rights](#) > [Trade Marks Commentary](#) > [Chapter 5 Applications for Registration of a Trade Mark](#)

### Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications

#### [48,405] Convention applications

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##### **L** Legislation cited in this paragraph

(CTH) Trade Marks Act 1995 s 29, s 29(1), s 6, s 6(1), Section 6(3).

(CTH) Trade Marks Regulations 1995 Regulation 21.29(1), reg 4.6, reg 4.11(2), reg 4.6(1), reg 4.6.3, reg 4.6.4.

Australia is a signatory to the Paris Convention for the Protection of Industrial Property<sup>1</sup> and it is required to allow the nationals of other member countries a right of priority<sup>2</sup> for the filing of trade mark applications. Any filing equivalent to a regular national filing under the domestic legislation of a member country, or under a bi-lateral or multi-lateral treaty concluded between member countries, is to be recognised as giving rise to a right to priority.<sup>3</sup> In the case of a trade mark application the priority period is 6 months.<sup>4</sup>

[Section 29](#) of the 1995 Act implements Australia's obligations under Art 4. It provides that if a person has made an application to register a trade mark in one or more Convention Countries that person, or his or her successor in title,<sup>5</sup> may file an application in Australia claiming a right of priority in respect of all or any of the goods or services nominated.

Convention country is defined in [s 6\(1\)](#) of the 1995 Act as a foreign country of a kind prescribed by the regulations. In order to ensure that the regulations are able to bring in material from sources other than Australian legislative material a subsection has been added to the end of [s 6](#) of the 1995 Act. [Section 6\(3\)](#) provides that despite s 14(2) of the Legislative Instruments Act 2003 regulations for the purposes of the definition of Convention

Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications

country in [s 6\(1\)](#) may make provision in relation to a matter by applying, adopting or incorporating, with or without modification, any matter contained in any instrument or other writing as in force or existing from time to time.

Regulation 21.29(1) of the *Trade Marks* Regulations 1995 states that the countries prescribed for the purposes of [s 6\(1\)](#) of the Act are

- (a) A foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
- (b) A foreign country that is a full member of the World *Trade* Organisation.

The notes to reg 21.29(1) state that the signatories to the Paris Convention can be found at [www.wipo.int](http://www.wipo.int) while a list of the full members of the World *trade* Organisation is to be found at [www.wto.org](http://www.wto.org).

### Claiming Convention priority

A person wishing to claim convention priority must comply with the minimum filing requirements and must give notice<sup>6</sup> that convention priority is claimed at the time the application for registration is made or within 2 working days of the date of filing.<sup>7</sup> The notice claiming convention priority must specify the convention country or countries in which the earlier application(s) was made, the date of the application(s) and the number of the earlier application(s) allocated in the *trade marks* office, or its equivalent, of the Convention country.<sup>8</sup>

It is not uncommon for an Australian application to be part of an international registration programme and it is possible that it may be desirable for the Australian application to rely on more than one earlier priority date. For example an earlier application may have been made in the United States on 11 June 2016 in respect of goods in class 3 and the date of that application will provide the priority date for an Australian application for the goods, or part of them, in class 3. An application to register the same *mark* in class 35 in respect of wholesale or retail services in respect of the class 3 goods may not have been made until 25 June 2016 in Japan. Assuming that the Australian application is in respect of both classes 3 and 35 it will be necessary to claim two priority dates. In such a case the Australian application must specify the goods/services to which each priority date relates.<sup>9</sup>

- 
1. The Convention appears at [\[183,295\]](#).
  2. Paris Convention for the Protection of Industrial Property [Art 4A\(1\)](#).
  3. Paris Convention for the Protection of Industrial Property [Art 4A\(2\)](#).
  4. Paris Convention for the Protection of Industrial Property [Art 4C\(1\)](#).

## Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications

- 5 Trade Marks Act 1995 (Cth) [s 29\(1\)](#). In the case of a successor in title it should be noted that the registrar may require proof of title: see Trade Marks Regulations 1995 reg 4.11(2).
- 6 Trade Marks Regulations 1995 reg 4.6(1).
- 7 Trade Marks Act 1995 (Cth) [s 29\(1\)](#); Trade Marks Regulations 1995 reg 4.6.
- 8 Trade Marks Regulations 1995 reg 4.6.4.
- 9 Trade Marks Regulations 1995 reg 4.6.3.

### [48,410] Priority based on more than one application

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#### **L** Legislation cited in this paragraph

(CTH) Trade Marks Act 1995 s 29.

(CTH) Trade Marks Regulations 1995 reg 4.6(2), (3).

Convention priority depends on the first application filed to register the trade mark in respect of specified goods or services. If a number of applications were made to register the same mark for the same goods/services in a number of different countries the priority date under [s 29](#) would be based on the country of first filing. It is, however, often the case that a trade mark owner will use different statements of goods/services in different countries and it may therefore be possible to file an application in Australia which takes the benefit of more than one earlier filing.<sup>1</sup>

If, for example, an application was filed on 1 February in the United Kingdom to register a trade mark in respect of cakes and biscuits and a second application was filed in the United States on 25 February for the same trade mark but the statement of goods was for snack foods, an application filed in Australia on or before 1 August could claim a convention priority date of 1 February in respect of the cakes and biscuits and 25 February in respect of snack foods. The applicant is required to specify the goods and/or services which are claimed in respect of each priority date.<sup>2</sup> The Manual cautions that the onus is on the applicant to ensure that the right date is claimed in relation to the relevant goods/services. If a claim to priority is incorrectly made the application and/or the registration may be open to dispute.<sup>3</sup>

It is also possible for an applicant for registration in Australia to combine a convention application with new material. In addition to cakes, biscuits and snack foods the applicant may wish to obtain registration for preparations made from cereal. The trade mark would, if registered, have three priority dates, 1 February, 25 February and the date on which the application was filed at the Trade Marks Office for preparations made from cereal. It should of course be

### Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications

emphasised that the application must be made within the convention period. This means that if the applicant wishes to claim all of the goods mentioned, an application must either be filed to register cakes, biscuits (and preparations made from cereal) by 1 August, that is 6 months from 1 February not including that day, and a second application to register the mark in respect of snack foods at the slightly later date or an application combining all of the goods with preparations made from cereal may be filed on or by 1 August.

- 
- 1 [Trade Marks Regulations 1995 reg 4.6\(2\)–\(3\)](#).
  - 2 [Trade Marks Regulations 1995 reg 4.6\(3\)](#).
  - 3 [Trade Marks Office Manual of Practice and Procedure](#) , Pt 11.7.3.

#### **[48,415] The same or substantially the same trade mark**

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Art 4(2)(c) of the Paris Convention (see [183,310]) states that trade mark protection must not be denied merely because the application mark differs from the mark as first filed in a manner which does not alter its distinctive identity. This means that as long as the trade mark application filed in Australia is in respect of the same trade mark as that filed overseas, or it differs from that mark in a way which does not substantially affect the identity of the original mark, the owner should be entitled to claim priority.<sup>1</sup>

- 
- 1 See contra [Trade Marks Office Manual of Practice and Procedure](#) , Pt 11.1.5.

#### **[48,420] Goods and services**

---

An application will only be entitled to convention priority if at least one of the goods or services is the same as the original. As we have already seen, an application may claim a number of convention priority dates in respect of different goods or services, but each claim to priority must be able to rely on goods or services claimed for the first time in the application specified.

#### **[48,425] Proof of entitlement to claim priority**

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Part 3 — Special Kinds Of Trade Mark Application: Convention Applications, Series Applications, Divisional Applications

**L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 s 44.

(CTH) *Trade Marks* Regulations 1995 reg 4.11(1), regs 4.11(2), regs 4.13, 4.14, reg 5.5(2), 5.5(3).

The Australian *Trade Marks* Office does not normally require the provision of documentation in support of a claim to convention priority<sup>1</sup> but it will do so<sup>2</sup> if:

- a convention application is raised as a citation against another application under [s 44](#) of the 1995 Act because of the claim to priority. For example Application A is filed in Australia on 11 June 2001. In the course of examination the examiner identifies Application B as a potential citation under s 44 of the *Trade Marks* Act 1995 (Cth). Application B was filed in Australia on 6 December 2001 but the applicant has claimed a convention priority date of 8 June 2001. If the convention priority date is allowed Application B will take priority over Application A and in such cases the owner of application B may be required to provide documentation which will allow the *Trade Marks* Office to verify the claim to convention priority.<sup>3</sup>
- If an opponent requests a copy of the original application on which the priority claim is based in opposition proceedings, and there is no copy on the file, the registrar must require the applicant to provide a copy of the earlier application with, if necessary, a translation of it into English and a certificate of verification of the translation.<sup>4</sup> If the applicant is the successor in title of the person who filed the original application the registrar may require the applicant to provide documentary proof of title.<sup>5</sup>

While the registrar must require the applicant to provide documentation if an opponent requests a copy of the original certificate, and may require proof of title, there is no sanction in either case if the applicant does not comply.

- 
1. [The Trade Marks Office Manual of Practice and Procedure](#)  Pt 11.4.
  2. Documentation may be required under reg 4.11(1).
  3. [The Trade Marks Office Manual of Practice and Procedure](#)  Pt 11.4.1 states that the examiner should advise the owner of Application A of the citation and explain the possibility of deferring acceptance of the application under regs 4.13 or 4.14.
  4. *Trade Marks* Regulations 1995 reg 5.5(2).
  5. *Trade Marks* Regulations 1995 regs 4.11(2) and 5.5(3).

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## [48,430] *Series* applications

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### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 Pt 9, s 27(5), s 51, s 51(d), s 51A.

It is not unusual for a person to use a *trade mark* with a number of minor variations and, while it is recognised that the use of a *trade mark* with additions or alterations which do not substantially affect its identity is use in good faith for the purposes of [Pt 9](#) of the 1995 Act,<sup>1</sup> many people prefer to have the protection of the Act for all *trade marks* used. Registration of a *series trade mark* serves this need.

Registration of a *series trade mark* under the 1995 Act was initially restricted to registration of two or more *trade marks* in one class. This imposed considerable hardship on an applicant who wished to register a *series trade mark* and who wished to achieve protection in more than one class. The only way to do so was to file multiple applications to register the *series* in the desired classes. The *Trade Marks* Amendment Act 2006 amended [s 27\(5\)](#) of the 1995 Act to allow an application for a *series* to be made in more than one class and the registrar is now required to register a *series* in one registration if the application meets all of the requirements of the Act. Provision was also made to allow existing *series* applications to be linked.<sup>2</sup>

In addition to the amendments allowing an applicant to file an application to register a *series* in more than one class, s 51(d) of the 1995 Act was deleted.

An application to register a *series trade mark* may now be made in respect of goods and/or services, in more than one class as long as the restrictions imposed by [s 51](#) are met. Those restrictions are that the *trade marks* must resemble each other in material particulars and they may only differ from each other in respect of one or more of the following:

- (a) statements or representations as to the goods or services in relation to which the *trade marks* are used or intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the *trade mark*.

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1. *Trade Marks* Act 1995 (Cth) [Pt 9](#)— Removal of *trade mark* from Register for non-use.
2. See now *Trade Marks* Act 1995 (Cth) [s 51A](#).

## [48,435] Resemblance in material particulars

**L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 s 51, s 51(a), (c), s 51(1)(b), s 51(1)(c).

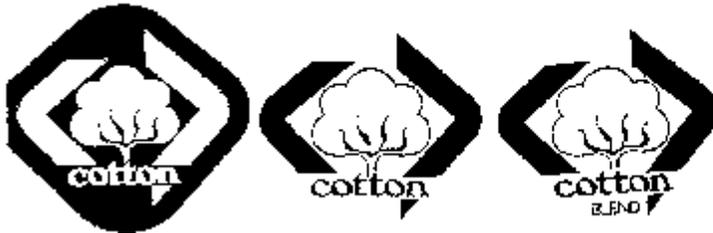
The test for determining whether a number of *trade marks* can be registered as a *series* turns on whether the *trade marks* differ so significantly or in such important detail that each of them might be regarded as registrable in its own right. It has been suggested that the idea of the *marks* must remain the same<sup>1</sup> and that where the constituent parts of the *marks* are altered, for example if a device is added to a word or different devices are combined, the *marks* are unlikely to be accepted as a *series*. This is well illustrated in the *Magic Carpet* case<sup>2</sup> where an application was made to register the words “Magic Carpet” and those words with the addition of a device:



This can be compared with the cotton certification *mark*

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430010



and the Australia fresh mark



which are both series registrations for certification marks. The “Magic Carpet” application was rejected; the Cotton Certification mark and the Australia Fresh marks were accepted.

The appearance and sound of the marks are important in determining whether the differences between them are material and where the differences lie in the changed spelling of a word, or in punctuation, these factors are likely to be particularly important.

These statements of principle can be readily applied to straightforward cases where it is comparatively easy to decide if the trade marks form a series. It is not surprising to find that FASTFOTO and FAST-FOTO are considered to be registrable as a series as are SUPATONE and SUPERTONE, where there is a change in the spelling but the sound, appearance and “idea” of the marks is very close.<sup>3</sup>

It is, however, the marginal cases which demonstrate how difficult it can be to decide if a number of trade marks can be claimed as a series and the elusive quality of a series can be illustrated by reference to the examples provided in the Manual.<sup>4</sup>

The meaning of “resemblance in material particulars” has been considered in a number of Office decisions.<sup>5</sup> It has been suggested that the words provide a threshold test preliminary to the application of s 51(a)–(c) of the 1995 Act and that the expression “material particular” denotes that portion of the trade mark which will be regarded as being the part of the sign which has trade mark significance.<sup>6</sup>

In *Re Ecospecifier Pty Ltd*<sup>7</sup> the applicant had applied to register a number of representations of a sign in a variety of colour combinations and with the addition of different words. The application was rejected and the applicant applied to be heard. For the applicant it was argued that the identifying feature of all the trade marks was “...clearly the circular medallion device which dominates in size and presentation, sitting front and centre” of all the trade marks. The identification of the trade marks was completed by the words “ecospecifier global GREEN TAG

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CERTIFIED”. The hearing officer agreed that these features form the “material particulars” of the trade marks, shown below in grayscale.

ecospecifier global  
GREEN TAG  
CERTIFIED



She was of the opinion, contrary to that expressed by the examiner, that the colours within the trade marks were not material particulars of the trade marks, even though the representations on the application were coloured. Even when shown in grayscale, the hearing officer thought that it was clear that the words and the medallion device formed the memorable portion of the trade mark, and were the material particulars.<sup>8</sup> The hearing officer also found that the variation in the colours used in the trade marks came within the exception provided by [s 51\(1\)\(c\)](#) and did not constitute a change to the material particulars of the trade mark.

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The more difficult aspect of this case was raised by [s 51\(1\)\(b\)](#), the exception which deals with representations or statements as to number, price, quality, or names of places. The application mark was varied by the inclusion of the words bronze, or silver, or gold, or platinum and the examiner had queried whether the words were a statement as to the quality of all of the goods and services claimed. The amendment to [s 51](#) which allows an applicant to make a multi-class application for registration of a series has meant that the requirement that the application be restricted to goods/services which are similar to each other no longer applies. However the variation in the goods and services which may now be the subject of an application to register a series trade mark raises the issue as to whether the application is validly made. The Manual states that:

Series applications can be filed for a wide range of goods/services within a single class, or across multiple classes (Section 27). The nature of the goods/services claimed in these class(es) may have a bearing on the validity of the series claim.

In deciding whether the material particulars of the trade marks in a claimed series resemble each other, it is important to consider the nature of the goods/services to which the trade marks are to be applied. For example, the trade marks IDAK TV and IDAK TELEVISION would represent a series in classes 9 and 38 if the goods and services claimed were items such as “televisions” and “television broadcasting”. In this example, the words TV and TELEVISION are statements as to the goods and services as provided for under paragraph 51(1)(a). However, the same could not be said if the goods also included items with which the words TV or TELEVISION had no connection, such as “fire extinguishers” or “facsimile transmission services”. Then the differences between the trade marks, namely the words TV and TELEVISION, would not be statements as to those goods or services. It should also be noted that if the trade marks were to be used on fire extinguishers or facsimile services, the difference between IDAK TV and IDAK TELEVISION would be a substantial variation in material particulars.

This type of consideration is highly likely to be relevant to many multiclass series applications because they provide the greatest potential for an applicant to claim a diverse range of goods and services. Such diversity reduces the likelihood of a valid series application where the trade marks differ in statements as to the goods or services. In such cases, applicants will usually have to amend their goods or services to conform to the description within the trade marks in order to satisfy section 51.9

The application in the *Ecospecifier* case was for a certification mark which meant that there was the potential for the mark to be applied to a very wide range of goods and services. The hearing officer therefore considered the various quality accreditation criteria contained within the various versions of the mark and concluded that some of them constituted a particular which fell outside the range of additions allowable in creating a series of trade marks.<sup>10</sup>

#### Series registrations for colour

In the *Darrell Lea* case,<sup>11</sup> the hearing officer acknowledged that colour applications must be treated like other applications. He also accepted that a series registration for colour is possible under [s 51](#) if the trade marks are

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capable of distinguishing and are comprised of more than one colour. The example given is of an application “... where the goods are tractors and the **trade mark** is the colour pink applied to the visible surface of the goods on which is superimposed yellow stripes which might vary in width in use. The **series** claim is then in the similar, but different, proportions of the yellow stripes relative to the pink ground which do not affect the identity of the **trade mark**.”<sup>12</sup> Where, however, the claim is in respect of a single colour which lacks any inherent adaptability to distinguish, a **series** application is not possible because any variation in the colour must necessarily be a variation in a material particular.

1. *Lynson Australia Pty Ltd's Application* ([1987](#)) [9 IPR 350](#); (1987) AIPC 90-393 .
2. *Re Application by Cogs Marketing Services Pty Ltd* ([1988](#)) [14 IPR 657](#).
3. *Trade Marks Office Manual of Practice and Procedure*  Pt 13.2.
4. *Trade Marks Office Manual of Practice and Procedure* , Pt 13.6 and 13.7.
5. See for example *Total Rubber Services (Aust) Pty Ltd v Mooney* [2001] ATMO 56; ([2001](#)) [51 IPR 601](#); (2001) AIPC 91-738 ; *Re Application By Dualit Ltd (Toaster Shapes)* ([2001](#)) [52 IPR 593](#) .
6. Application by *Effem Foods Pty Ltd* (2000) AIPC 91-548; (1999) ATMO 80.
7. *Re Ecospecifier Pty Ltd* ([2011](#)) [94 IPR 156](#); [2011] ATMO 63 .
8. *Re Ecospecifier Pty Ltd* ([2011](#)) [94 IPR 156](#); [2011] ATMO 63 at [14] .
9. *Trade Marks Office Manual of Practice and Procedure* , Pt 13.5.
10. *Re Ecospecifier Pty Ltd* ([2011](#)) [94 IPR 156](#); [2011] ATMO 63 at [31]–[32] .
11. *Darrell Lea Chocolate Shops Australia Pty Ltd v Cadbury Ltd* ([2006](#)) [69 IPR 386](#); [2006] ATMO .
12. *Darrell Lea Chocolate Shops Australia Pty Ltd v Cadbury Ltd* ([2006](#)) [69 IPR 386](#); [2006] ATMO at [50] .

### [48,440] Cartoon figures

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A **series** application which portrays a cartoon figure in a variety of poses with a variety of accessories will be tested by much the same criteria as any **series** application. It has, however, been suggested that one must assess the extent to which the accessories, or props, dominate the character. If they differ widely, as for example a koala in a swim suit on a bicycle and a koala in a business suit leaning on a bar,<sup>1</sup> the character may be the same but the context or trappings are so different that the two are unlikely to be accepted as a **series**.

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1. Example given by hearing officer T Williams in *Re Application by Johnson & Johnson (1993) 28 IPR 167* .

### [48,445] Formalities in relation to series applications

#### **L** Legislation cited in this paragraph

(CTH) Trade Marks Act 1995 s 239A, s 51, subs 51(1), s 51A, subs 51A(1)(a), (b), (c), subs 51A(2), subs 51A(3), s 82A.

(CTH) Trade Marks Regulations 1995 reg 4.3(2).

It has already been seen that, prior to the amendments to [s 51](#) of the 1995 Act introduced by the Trade Marks Amendment Act 2006, it was not possible to file a series application as a multi-class application. The amendment to [subs 51\(1\)](#) removes the barrier to such applications with effect from 26 March 2007. An application to register a series trade mark must meet the minimum filing requirements and reg 4.3(2) provides that in a series application the representation of each of the trade marks in the series must if practicable not exceed 8cms × 8cms.

#### Linking series applications

Provision has been made to allow series applications pending when the amending legislation came into force to be linked so as to enable them to be treated as one application.<sup>1</sup> In order for applications to be linked, the original applications must have been owned by the same person and have been made:<sup>2</sup>

- in respect of the same trade mark, and
- on the same day.

If these requirements are met, the owner may make a written application to the registrar to have all of the applications, or some of them, treated as if they were one application<sup>3</sup> and the registrar must accede to the request.<sup>4</sup>

#### Linking series registrations

Provision was also made to enable the owner of an existing series of registrations to link those registrations. Where the same trade mark was registered in two or more classes with the same priority date and in the name of the same person, the registered owner may make a written application to the registrar to have the registrations treated as if they were registered as a series in one registration in respect of all of the goods and services in respect of which the mark was registered, or such of the goods/services as are covered by the registrations in respect of which the

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application is made. **Series** registrations made under the 1995 Act are covered by the new [s 82A](#), while registrations made under earlier legislation are covered by the new [s 239A](#).

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1. *Trade Marks* Act 1995 [s 51A](#) (as amended).
  2. *Trade Marks* Act 1995 [subs 51A\(1\)\(a\)](#), [\(b\)](#) and [\(c\)](#).
  3. *Trade Marks* Act 1995 [subs 51A\(2\)](#).
  4. *Trade Marks* Act 1995 [subs 51A\(3\)](#).

### [48,450] Divisional applications from a **series** application

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One or more divisional applications may be made from a valid **series** application but if the initial application is rejected, in whole or in part, it may not be possible to divide out the **trade mark(s)** which are held not to form part of the **series**, as that would involve a divisional application for part of a **trade mark**.<sup>1</sup>

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1. Which is contrary to the provisions of the amended s 45. See also *Cogs Marketing Services Pty Ltd's Application (1989) 14 IPR 657* , where an application was made to register two **marks** as a **series**. When the examiner objected that they did not constitute a **series**, the applicant agreed to amend the application by deleting one of the **marks** but a claim was then made for divisional status for the deleted **mark** in respect of the identical goods.

### [48,455] Blank space endorsement

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An alternative to registration of a **series** may be to seek registration of a **trade mark** with a blank space and an endorsement that in use the blank space will be occupied by non distinctive material which is varied according to the nature of the product. *Trade Mark* registration 745890 is for a shape **mark** which includes the labels and other markings shown in the application form. The registration carries the endorsement that “When the **trade mark** is used for items in the specification (alcoholic beverages) other than Tequila’ the word Tequila in the **trade mark** will be changed to accord with those other items”.

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## [48,470] Divisional applications

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### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 Pt 4 Div 3, Pt 6, s 45, subs 45(1), subs 45(2).

(CTH) *Trade Marks* Regulations 1995 Regulations 4.16, 4.17, reg 4.2AA.

After an application for registration of a *trade mark* has been filed the applicant may decide that the application does not meet his/her business needs in relation to the goods/services claimed. The right to amend an application after publication is very limited<sup>1</sup> and the applicant may find that a better option is to file a divisional application under [Pt 4 Div 3](#) of the 1995 Act. A divisional application may also be appropriate where goods or services are excluded from the application in the course of examination or where some of the goods or services are in conflict with a cited *mark* or are the subject of an adverse report.

As the name suggests a divisional application is divided out of an existing application, referred to as the “parent” application. The parent application may either be the original application<sup>2</sup> or, a divisional application which has already been filed.<sup>3</sup>

The provisions of [Div 3](#) of Pt 4 of the 1995 Act were repealed in 2006<sup>4</sup> and were replaced by new provisions which have substantially changed the law. It is now clear that a subsequent owner of an application may make a divisional application and the amendments to [s 45](#) also confirm that the parent application may itself be a divisional application so that it is now clear that a divisional application may be made from a divisional application.

1. *Trade Marks* Act 1995 (Cth) [Pt 6](#).
2. *Trade Marks* Act 1995 [subs 45\(1\)](#), as amended.
3. *Trade Marks* Act 1995 [subs 45\(2\)](#).
4. The new provisions took effect from 27 March 2007, the date fixed by Proclamation as the day on which Pt 2 of Sch 1 *Trade Marks* Amendment Act 2006 came into force. Regulations 4.16 and 4.17, which dealt with divisional applications, were also repealed and they were replaced by reg 4.2AA.

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### [48,475] The application

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#### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Regulations 1995 reg 4.2AA.

A divisional application is, in most respects, the same as a standard application but in addition to the minimum filing requirements for other applications, a divisional application must also contain:

- a statement that the application is a divisional application and
- a statement identifying the parent application.<sup>1</sup>

Where the parent application is a multi-class application, and the applicant wishes to maintain all of the original classes claimed, the divisional application must involve a reduction of the goods/services claimed in at least one class.

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1. *Trade Marks* Regulations 1995 reg 4.2AA.

### [48,480] Who may apply for a divisional application?

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#### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 s 108(2), Subs 45(1), s 6.

[Subsection 45\(1\)](#) of the 1995 Act, as originally drafted, stated that “...a person who has made an application for registration... may... make another application...” These words were interpreted by the *Trade Marks* Office as meaning that a divisional application could only be filed by “the person” who filed the initial application.

That interpretation was inconsistent with other provisions of the Act, particularly [s 108\(2\)](#), and an amendment made in 2001 recognised that an assignee should have standing to make a divisional application.

The changes to s 45 made by the *Trade Marks* Amendment Act 2006 confirm that the applicant, defined in [s 6](#) of

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the 1995 Act as “*the person in whose name the application is for the time being proceeding*”, may make a divisional application. A note to s 45 states that, for the avoidance of doubt, a divisional application may be made by a person who has become the applicant in relation to the parent application by virtue of [s 108\(2\)](#).

### [48,485] When may a divisional application be made?

#### **L** Legislation cited in this paragraph

(CTH) [Trade Marks](#) Act 1995 s 224, s 41, s 41(3), s 44, s 44(3), (4), subs 45(1), subs 46(1)(a), (b), (c), subs 46(2).

(CTH) [Trade Marks](#) Regulations 1995 reg 4.12, regs 4.13, 4.14.

Prior to the amendments, there were three different kinds of divisional application:

- (i) Part of a *trade mark*
- (ii) Some of the goods or services; and
- (iii) Applications made in the course of examination.

A divisional application may now only be made<sup>1</sup> in respect of some of the goods or services covered by the parent application. The registrar is required to amend the parent application by excluding goods/services claimed in a divisional application, except where the parent application has lapsed before an amendment can be made.<sup>2</sup>

This is a major change, but one of the most common uses for a divisional application is where delay in the examination process makes it likely that the statutory period will expire<sup>3</sup> before the application is accepted. The cost of obtaining extensions of time under [s 224](#) and reg 4.12 will often exceed the cost of a new application and it may be preferable for the applicant to file a divisional application for part of the goods or services claimed in the initial application. Care should, however, be taken to ensure that the change does not increase the scope of the initial application. If, for example, the initial application claimed electronic communications the deletion of electronic would not operate as a reduction of the initial application but as an extension of it. The divisional application would not be allowed.

A divisional application in respect of some of the goods/services may also be made where the examiner raises an objection under [s 44](#) of the 1995 Act. If the applicant wishes to retain the priority date of the initial application and to have it accepted as quickly as possible, a divisional application might be made in respect of the contested goods and/or services and those items would then be deleted from the parent application.<sup>4</sup> The parent application should

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then proceed to acceptance and the applicant has additional time, presently at least 15 months from the date of the first report on the divisional application, in which to try to overcome the objections raised by the examiner.<sup>5</sup>

This technique may be particularly valuable if, for some reason, the status of the cited *mark* is not clear but deferment of the initial application is not possible under regs 4.13 and 4.14. The *Trade Marks* Office Manual of Practice and Procedure, at Pt 12.7, notes that applicants sometimes file a divisional application in order to maintain the earlier filing date thus allowing themselves more time to prosecute an earlier application. The Manual acknowledges that this may be a useful technique where the applicant is attempting to show that the application *mark* is capable of acceptance under [s 41](#) or [s 44\(3\)](#) or [\(4\)](#) of the 1995 Act. However the Manual goes on to say that this practice is unlikely to be of much assistance where the application *mark* has no inherent adaptation to distinguish. That is because [s 41\(3\)](#) requires the applicant to show that the *mark* was distinctive at the date of filing before it can be accepted under that sub. A further use for a divisional application for part of the goods/services suggested by the Manual<sup>6</sup> is where opposition to registration is threatened and conflicting goods or services are deleted from the parent application to satisfy the concerns of the opponent. It is possible that the use of a divisional application in this kind of case will provide an attractive alternative to the applicant because it will allow him/her to overcome the opponent's objections, while at the same time retaining the contested goods/services in a divisional application.

A divisional application in such a case is not, however, necessarily a good commercial outcome for the opponent who will almost certainly find that the need to oppose registration is simply postponed. A far better settlement from the opponent's perspective would be to require the applicant to delete the contested goods/services from the application and to provide an undertaking that no subsequent application will be made to register the *trade mark*, or one substantially identical or deceptively similar to it, in respect of those

#### **Scope of a Divisional application**

A divisional application may only be made in respect of the *trade mark* to which the parent application relates and it must specify the goods/services which are to be covered by the divisional application and those which are to remain in the parent application.<sup>7</sup> As noted above, once a divisional application is made, the registrar must amend the parent application to remove the goods/services claimed in the divisional application.<sup>8</sup> This means that the previous practice of allowing the parent and the divisional to proceed together is no longer possible.

#### **Time for Filing**

A divisional application in respect of some of the goods/services covered by the parent application may be filed while the parent application is pending.<sup>9</sup> It should be noted that the period is not extendible, as reg 21.28(1)(c) makes a divisional application a prescribed act for the purposes of [s 224](#) of the 1995 Act.

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1. *Trade Marks* Act 1995 (Cth) [subs 45\(1\)](#).
2. *Trade Marks* Act 1995 [subs 46\(2\)](#).
3. *Trade Marks* Regulations 1995 reg 4.12 sets out the times within which an application for registration will lapse.
4. [Subsection 46\(2\)](#) requires the registrar to amend the parent application by excluding goods/services claimed in a divisional application, except where the parent application has lapsed before an amendment can be made.
5. It should be noted that the *Trade Marks* Office has indicated that it may seek to introduce a different regime for the examination of applications. One suggestion has been to change the trigger for responses to an examiner's report from a date for acceptance to a date for response. This would involve a change from the present 15 months for acceptance to a much shorter period for the initial response to the first examiner's report.
6. [Trade Marks Office Manual of Practice and Procedure](#) , Pt 12.2.
7. *Trade Marks* Act 1995 [subs 46\(1\)\(a\)](#), [\(b\)](#) and [\(c\)](#). This should mean that the dubious practice, adopted by many practitioners, of filing a divisional application in respect of a meaningless change to the goods/services (for eg, biscuits but not biscuits in the shape of a tea cup) is no longer possible, as the goods/service specified in the divisional application must have been claimed in the parent application.
8. *Trade Marks* Act 1995 [subs 46\(2\)](#).
9. *Trade Marks* Act 1995 [subs 45\(1\)](#).

### [48,490] Priority date of a divisional application

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#### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Act 1995 s 12, s 43, subs 45(2), s 6.

The principal benefit of a divisional application is that the applicant is able to undertake a variety of actions which may assist in achieving registration of the **trade mark** without losing the priority date of the initial application.

Under the *Trade Marks* Act 1955 it was accepted practice to allow a number of divisional applications to be divided off an initial application and for each divisional to take the priority date of the initial application as long as the provisions of [s 43](#) were met. When the *Trade Marks* Act 1995 came into force there were some minor alterations but there was no suggestion that this practice would change.

The decision of the registrar, through his delegate, in *Re Application by Arista Enterprises Inc*<sup>1</sup> was, however, interpreted as having introduced a major change in Office practice<sup>2</sup> and it was not until the amendments made by

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the *Trade Marks* Amendment Act 2006 that the issue of what constituted the priority date of a divisional application was finally resolved.

Whatever the rights or wrongs of the *Arista* case, the amendments made by the *Trade Marks* Amendment Act largely re-instate earlier practice. A divisional application now takes the priority date of its parent application and the Act specifically provides that a divisional application may itself be a parent application.<sup>3</sup> As long as a divisional application is filed while its parent application is pending, and it is in respect of some of the goods/services covered by the parent application, it is immaterial that the application is not the first divisional made, it will still be entitled to take the priority date of its parent application and that will be the date of the original application.<sup>4</sup>

1. *Re Application by Arista Enterprises Inc* (2000) 49 IPR 99<sup>CB</sup>.
2. There was some suggestion that the decision in the *Arista* case meant that where more than one divisional application was filed, each divisional must take the priority date of the divisional which preceded it. This appears to be the effect of the Official Notice (unnumbered and undated) entitled “Practice Note Divisional Application and Convention Claims” published by the *Trade Marks* Office. In that notice no account is taken of the fact that the second divisional TM 3, which is described as a divisional of TM 2, might well have been filed while TM 1 was on foot. In fact, the Deputy Registrar was careful to point out that, if the first PC Docs application had still been pending when the latest application was filed, that divisional could have claimed a priority date based on the original application, always assuming that convention priority had been properly claimed.
3. *Trade Marks* Act 1995 *subs 45(2)*.
4. See the definition of priority date in [s 12](#) and the definition of filing date in relation to a divisional application in [s 6](#).

## [48,495] Convention Applications

### **L** Legislation cited in this paragraph

(CTH) *Trade Marks* Regulations 1995 Pt 12.5, reg 4.5.

If an applicant wishes to make a divisional application claiming a convention priority date the Manual.<sup>1</sup> states that the convention priority date must be claimed at the time the divisional application is made or within 2 working days of that date.<sup>2</sup> Where an applicant wishes to claim convention priority it will be necessary for him/her to meet the

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requirements of s 29 of the 1995 Act. Examples of the way in which convention priority requirements apply to divisional applications are provided in the Manual.<sup>3</sup>

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1. [Trade Marks Office Manual of Practice and Procedure](#) , Pt 12.5.
2. [Trade Marks Regulations 1995](#) reg 4.5.
3. [Trade Marks Office Manual of Practice and Procedure](#) , Pt 12.5.

### [48,500] Series applications

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A divisional application may be made in respect of some of the goods/services specified in a series application. This is discussed in the Manual.<sup>1</sup>

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1. [Trade Marks Office Manual of Practice and Procedure](#) , Pt 12.3.1.

### [48,505] International applications

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Applications for international registration under the Madrid Protocol where Australia is the country of origin and where Australia is nominated in an application filed with the International Bureau are discussed in the chapter on The Madrid Protocol at [\[71,000\]](#) ff. The Manual<sup>1</sup> notes that a divisional may not be filed for International Registrations Designating Australia [IRDAs] because an IRDA is a request for registration rather than an application within the meaning of s 45(1).

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1. [Trade Marks Office Manual of Practice and Procedure](#) , Pt 12.3.4.

## 13.1. Section 51 - Series of trade marks

Published 05/11/2021

Section 51 of the *Trade Marks Act 1995* (Cth):

### Application--series of trade marks

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark.

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks;

he or she must register them as a series in one registration.

## 13.2. Material Particulars

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The trade marks in a series application must resemble each other in material particulars. The term "material particulars" is not defined in the Act, however, the meaning of this term has been considered in *Effem Foods Pty Ltd* [1999] ATMO 80 where Delegate Thompson stated 'material particulars':

...denotes that portion of the trade mark in which other traders, the public and the courts will regard the trade mark rights as residing. In other words, that part of the sign which has trade mark significance. On another level, the words 'material particulars' denotes all of the component parts that contribute to the identity of the trade mark.

The material particulars, ~~being the identifying feature or features,~~ in each trade mark in a series must be essentially the same and any variation between the series of marks must not contribute to the identity of the trade mark/s or otherwise serve to distinguish any goods or services specified. In many cases the identifying feature/s entirely comprises the distinctive elements of the trade mark. However, it should be noted that in some cases descriptive/non-distinctive material can form part of the material particulars of a trade mark – particularly if its size and presentation within the trade mark are dominating features. Any differences between the material particulars must be such that they do not substantially affect the identity of the trade marks when each member of the series is compared to each of the others.

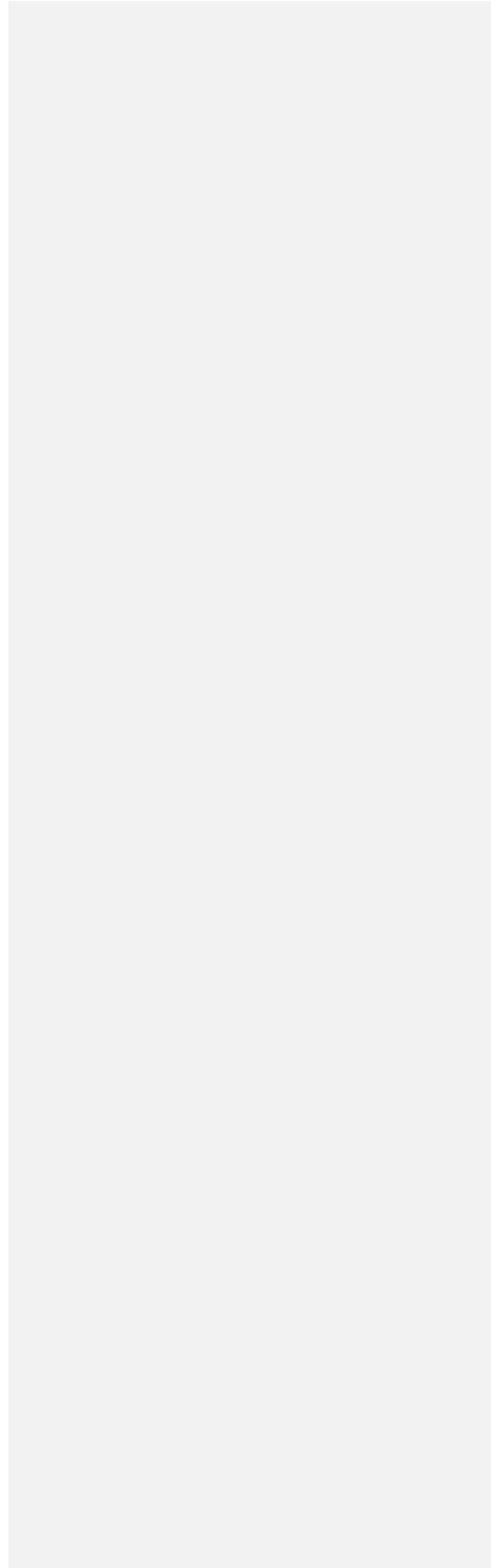
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13.2. Material Particulars

<https://ipagov.sharepoint.com/sites/TMManual/SitePages/2.-Material-Particulars.aspx>

1/1



## 13.3. Provisions of Paragraphs 51(1)(a),(b) and (c)

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[Subsection 51\(1\)](#) provides the second consideration in determining the validity of a series.

The wording of [subsection 51\(1\)](#) emphasises that the trade marks in the series must differ **only** in respect of **one or more** of the ways specified in paragraphs (a), (b) and (c).

[Subsection 51\(1\)](#) places substantial restrictions on what sort of trade marks can form a valid series. It does this by specifying in paragraphs (a), (b) and (c) a narrow range of ways in which the trade marks can differ. It also requires that series trade marks differ **only** in respect of the ways specified. It does however allow the trade marks to differ in **one or more** of these ways.

This means that even if the material particulars resemble each other, the validity of a series will be determined on the basis of whether differences between the trade marks are within those specified in the three paragraphs of subsection 51(1).

## 13.4. Applying Requirements for Material Particulars and Provisions of Paragraphs 51(1)(a...

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[Section 51](#) requires that both considerations mentioned above be made to determine the validity of a series application. There are three outcomes:

1. The material particulars resemble each other and the trade marks differ **only** in the ways specified in paragraphs 51(1)(a),(b),(c) (ie a valid series).
2. The material particulars do not resemble each other and the trade marks differ **only** in the ways specified in paragraphs 51(1)(a),(b),(c) (ie an invalid series).
3. The material particulars resemble each other but the trade marks do not differ **only** in the ways specified in paragraphs 51(1)(a),(b),(c). There are two variations of this possible outcome: Firstly, the trade marks differ in ways not specified in provisions of paragraphs 51(1)(a),(b),(c). Secondly, the trade marks differ in one or more of the ways specified in paragraphs 51(1)(a),(b),(c), but also incorporate a further change. (ie an invalid series).

By way of example, trade marks can resemble each other in material particulars in combinations such as:

LYN SON

The logo for 'Lynson' features the word 'lynson' in a bold, lowercase, sans-serif font. The letter 'y' is stylized with a horizontal bar that extends to the left and underlines the 'l'. The 'n' and 's' are also bold and connected.

But, they do not qualify as a series because the ways in which they differ are not specified in any of [paragraphs 51\(1\)\(a\), \(b\) or \(c\)](#).

Similarly, applications filed for a series of non-traditional signs, such as variations of a sound trade mark, variations of a shape trade mark or a colour trade mark, do not qualify under these provisions. Differences in the sound/shape/colour of these trade marks may impact on the material particulars of these trade marks and may prevent them from resembling each other. It should also be noted that such differences in these trade marks may not comply with the differences specified by [paragraphs 51\(1\)\(a\), \(b\) and \(c\)](#). However, a composite trade mark

consisting of a non-traditional sign and a word may form a valid series provided the only differences between the trade marks are those specified by [paragraphs 51\(1\)\(a\), \(b\) and \(c\)](#).

## 13.5. Restrict to Accord

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Series applications can be filed for a wide range of goods/services within a single class, or across multiple classes ([Section 27](#)). The nature of the goods/services claimed in these class/es may have a bearing on the validity of the series claim.

In deciding whether the material particulars of the trade marks in a claimed series resemble each other, it is important to consider the nature of the goods/services to which the trade marks are to be applied. For example, the trade marks IDAK TV and IDAK TELEVISION would represent a series in classes 9 and 38 if the goods and services claimed were items such as “televisions” and “television broadcasting”. In this example, the words TV and TELEVISION are statements as to the goods and services as provided for under [paragraph 51\(1\)\(a\)](#). However, the same could not be said if the goods also included items with which the words TV or TELEVISION had no connection, such as “fire extinguishers” or “facsimile transmission services”. These differences between the trade marks, namely the words TV and TELEVISION, would not be statements as to those goods or services.

Chief Assistant Registrar Farquhar provided the following guidance on statements and representations as to the goods or services in *Re Lynson Australia Pty Ltd* (1987) 9 IPR 350:

(T)he statements or representations...must be such that they do not contribute to the function that the mark has in distinguishing the proprietor’s goods from those of other traders. They must be clearly and unambiguously separate from those features of the mark by which it, and the goods or services which it identifies, will be known.

This type of consideration is likely to be relevant to series applications where a diverse range of goods and/or services is claimed. Such diversity reduces the likelihood of a valid series application where the trade marks differ in statements as to the goods or services. It should also be noted that where an element has no connection to some of the claims, this element becomes a material particular in respect of those claims. In such cases, applicants will usually have to amend their goods or services or remove representations to satisfy [section 51](#).

**Series applications and section 43.**

Commented [BM 1]: fix wording

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Section 43 states that an application for a trade mark must be rejected if use of the trade mark in respect of the goods and services claimed would cause confusion or deception. There is no discretion that can be applied in these circumstances. Given this, in addition to the issues discussed above, the following example would attract an objection under section 43 as the trade marks would be likely to deceive or cause confusion if used for one of the goods claimed:

Class 29 claim for Beef, lamb

IDAK BEEF

IDAK LAMB

If the applicant were to use the IDAK BEEF mark on lamb products it is likely that consumers would be confused or deceived about the type of meat they are purchasing.

## 13.6. Examples of Valid Series Trade Marks

Published 05/11/2021

### 6.1 51(1)(a) statements or representations as to the goods or services in relation to which the trade marks are to be used

Example 1	<p>Class 9 claim for Televisions.</p> <p>IDAK TV IDAK TELEVISION</p>
Example 2	<p>Class 25 claim for Clothing Class 35 claim for Retailing of clothing Class 40 claim for Custom manufacturing of clothing</p> <p>IDAK SHIRTS IDAK HATS IDAK SLIPPERS</p>

### 6.2 51(1)(b) statements or representations as to number, price, quality or names of places

#### Number

Example 1	IDAK 1
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	IDAK 2
Example 2	IDAK FIRST IDAK 1ST
Example 3	IDAK 2 IDAKTWO
Example 4	IDAK ONE IDAK TWO
Example 5	IDAK 6 PACK IDAK 6
Example 6	IDAK one IDAKTWO

[Example 6 is a valid series regardless of the differences in upper and lower case letters. It is considered that one and TWO are different statements or representations as to number as allowed under [paragraph 51\(1\)\(b\)](#)]

### Price

Example 1	IDAK \$2.00 IDAK \$10.00
Example 2	IDAK £2.00 IDAK \$10.00 IDAK ¥500

### Quality

When considering quality the goods and services must be taken into account and research undertaken to ascertain whether the terms are ordinarily used to indicate quality in the relevant industry.

Example 1	IDAK STANDARD IDAK DELUXE
Example 2	IDAK SUPREME IDAK DELUXE IDAK PREMIER
<del>Example 3</del>	<del>IDAK SUPERIOR</del> <del>IDAK DELUXE</del>

IDAK PREMIER!

[Example 3 is a valid series, regardless of the additional punctuation in the third trade mark. It is considered that the exclamation mark is part of the reference to quality]

**Commented [BM 2]:** Thoughts re IDAK PREMIER! and the reasoning?

Example 4	Class 43 claim for Hotel accommodation, Class 36 claim for Credit card services, and Class 37 claim for Vehicle road service.  IDAK GOLD IDAK SILVER IDAK BRONZE
-----------	--

[Example 4 is a valid series because it is considered that the words gold, silver and bronze are normally used to describe levels of quality in relation to hotel accommodation, credit card services and vehicle road service]

**Names of Places**

Example 1	IDAK PERTH IDAK SYDNEY
Example 2	IDAK IDAK SYDNEY
Example 3	PERTH IDAK SYDNEY IDAK
Example 4	IDAK NSW IDAK NEW SOUTH WALES
Example 5	IDAK MELBOURNE IDAK

**6.3 51(1)(c) the colour of any part of the trade mark**

Example 1	IDAK IDAK [note: entire representation is red in colour]
Example 2	IDAK IDAK [note: the letter A is red in colour]

## 6.4 Trade marks differing only in respect of one or more of the ways specified in paragraphs 51(1)(a), (b) and (c)

Example	Class 43 claim for Hotel accommodation.  IDAK SYDNEY STANDARD 1 IDAK MELBOURNE DELUXE 2
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[this example is a valid series where the representations differ in reference to place, quality and number]

## 13.7. Examples of Invalid Series Trade Marks

Published 05/11/2021

### 7.1 Examples of trade marks that do not resemble each other in material particulars

Example 1

IDAK MELBOURNE  
IDAK MELBOURNE

Example 2

IDAK MELBOURNE  
IDAK GALAXY

Example 3

IDAK Television  
IDAK 1  
IDAK \$2.00  
IDAK STANDARD  
IDAK SYDNEY

Example 4

Class 25 claim for Clothing

SYDNEY CLOTHING  
MELBOURNE CLOTHING

Each of the examples above are invalid series as they do not resemble each other in material particulars. The differences are such that they affect the identity of the trade marks when each member of the series is compared to each of the others.

Example 5

Class 25 claim for Clothing, footwear, headgear

IDAK SHIRTS  
IDAK HATS  
IDAK SLIPPERS

[Example 5 include words that are not descriptive of each good claimed. These words become material particulars in respect for those goods for which they have no descriptive meaning. As a result, when compared to each other the trade marks do not resemble each other in material particulars]

## 7.2 Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)

Example 1



Example 2

IDAKS  
IDAKZ

Example 3

IDAK VIEW  
IDAKVIEW

Example 4

IDAKS  
IDACS

Example 5

IDAK  
I.D.A.K.

Example 6

IDAK  
*IDAK*

Example 7

IDAK  
I-DAK

Although all of the above trade marks may resemble each other in material particulars, their differences are not as specified in [paragraph 51\(1\)\(a\),\(b\) or \(c\)](#).

**51(1) (a)** The following are examples of series made invalid under [paragraph 51\(1\)\(a\)](#) because they do not incorporate statements or representations as to the goods or services in relation to which the trade marks are to be used.

Example 1

Class 35 claim for Accounting

IDAK ACCOUNTING  
IDAK MEDICAL

Example 2

Class 11 claim for Refrigerators

IDAK REPAIRS  
IDAK REFRIGERATORS

[Examples 1 and 2 include words that do not indicate the goods/services in relation to which the trade marks are to be used - medical and repairs]

Example 3

Class 25 claim for Clothing, footwear, headgear

IDAK SHIRTS  
IDAK HATS  
IDAK SLIPPERS

[Examples 4 include words that do not indicate all the goods for which the trade marks are to be used. As such the trade marks do not differ only in respect of statements as to the goods or services because the word is not a statement as to each good.]

**51(1) (b)** The following are examples of series made invalid under paragraph 51(1)(b) because they do not incorporate statements or representations as to number, price, quality or names of places.

**Number**

Example 1

IDAK 2  
IDAK TWICE

[twice is not a direct reference to number]

Example 2

IDAK 6 pack  
IDAK Unlimited

[unlimited is not a direct reference to number]

**Price**

Example 1

IDAK £  
IDAK \$  
IDAK ¥

[the symbols refer to currency rather than price]

**Quality**

Example 1

IDAK DELUXE  
IDAK BEGINNING

[beginning is not a reference to quality]

Example 2

Goods/Services- Class 30: Tea/coffee

IDAK PREMIUM  
IDAK WEATHER PROOF

[weather proof is not a reference to quality in relation to tea/coffee]

Example 3

Goods/services- Class 31: Alfalfa sprouts

IDAK GOLD  
IDAK SILVER  
IDAK BRONZE

[gold, silver and bronze are not references to quality in relation to alfalfa sprouts]

#### **Names of Places**

Example 1

IDAK MELBOURNE  
IDAK EAST

[east is not the name of a place]

Example 2

IDAK GOLD COAST  
IDAK REGIONAL

[regional is not the name of a place]

#### **51(1)(c)- the colour of any part of the trade mark**

Example

Class 12 claim for Clutches for vehicles

IDAK BLUE  
IDAK RED

[red and blue here are not the colour of any part of the trade mark. They are also not statement as to the goods, which are not ordinarily described in terms of colour]

### 7.3 Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.

#### Example 1

IDAK TV  
**IDAK** TELEVISION

[made invalid by enlarged script]

#### Example 2

IDAK 1  
IDAKS 2

[made invalid by differences in spelling]

#### Example 3

IDAK CLOTHING  
idak FOOTWEAR

[made invalid by use of upper and lower case letters]

#### Example 4

IDAK PERTH  
PERTH IDAK

[made invalid by different order of words]

#### Example 5

IDAK 1  
IDAK 2

[made invalid by underline]

#### Example 6

IDAK \$2.00  
IDAC \$10.00

[made invalid by differences in spelling]

Example 7

IDAK STANDARD  
I DAK DELUXE

[made invalid by separation of word]

## Re APPLICATION BY COGS MARKETING SERVICES PTY LTD

### 5 Claim for divisional status for a trade mark application

M A HOMANN (Assistant Registrar of Trade Marks)

9 May 1989

10 Trade Marks — Application — Series of trade marks — Division of application —  
Trade Marks Office practice — Registrar's discretion — Trade Marks Act 1955  
(Cth) ss 39, 43.

15 An initial composite trade mark application was lodged as a claimed series  
pursuant to s 39 consisting of the words "Magic Carpet" in block letters (first mark)  
and the words "Magic Carpet" in script form with a carpet device (second mark).  
On objection by the examiner that the application did not constitute a series of trade  
marks pursuant to s 39, the applicant consented to amendment of the original  
application by deletion of the script words and device (second mark) which were  
then lodged as a divisional application pursuant to s 43 with the same specification  
of goods as in the initial application. The first mark proceeded to acceptance.

20 Objection was taken against the claimed divisional application. The applicant  
contended that the application was comprehended by s 43(3) and on that basis that  
the Registrar had no discretion to refuse registration.

**Held,** maintaining the objection:

25 (i) The original trade mark application was valid for one or the other but not both  
of the trade marks sought. Once one of those trade marks was deleted, the  
application became valid for the remaining trade mark and only then could form the  
basis of a further divisional application for specified goods as it proceeded to  
acceptance.

30 (ii) The deleted mark could not itself form the divisional application pursuant to  
s 43 because s 43 required that the divisional application should be in respect of the  
same mark or series of marks with the only variation contemplated by division  
being in the specification of goods. The present purported divisional application was  
for a trade mark different from that of the initial application but was for exactly the  
same specification of goods and, on that basis, was not acceptable as a divisional  
application pursuant to s 43.

35 (iii) In view of the above, it was unnecessary to decide the issue of the Registrar's  
discretion in considering divisional applications.

40 *Sportsgirl Pty Ltd's Application* (1969) 39 AOJP 2516; *Macdougall v*  
*Paterson* (1851) 11 CB 755; *Julius v Lord Bishop of Oxford* (1880) 5 App Cas  
214; *Metropolitan Coal Co of Sydney Ltd v Australian Coal and Shale*  
*Employees' Federation* (1917) 24 CLR 85; *Finance Facilities Pty Ltd v Federal*  
*Commissioner of Taxation* (1971) 2 ATR 573, referred to.

[Note: The decision sets out an Office Practice Note concerning applications for  
series of trade marks under s 39 of the Trade Marks Act 1955 (Cth).]

### 45 Decision on application

This was a decision of the Assistant Registrar of Trade Marks refusing a  
claim for divisional status for a trade mark application. The facts and  
reasons in support appear sufficiently in the decision.

50 P N Nicholls for the applicant

**M A Homann** (Assistant Registrar of Trade Marks). Application No 449102 was lodged on 25 July 1986 in the name of Cogs Marketing Services Pty Ltd, the applicant, a Victorian company of Suite 4, 2nd Floor, 10A Atherton Road, Oakleigh, 3166, Victoria. The application purported to be made pursuant to the provisions of s 43 of the Trade Marks Act 1955 (Cth) which is in the following terms:

“Division of application

“43(1) Where a part of a trade mark which is the subject of an application for registration is separately registrable as a trade mark, the applicant may, before the application has been accepted or refused, make a further application for the registration of that part in respect of goods or services in relation to which the first-mentioned application was made.

“(2) A further application so made shall, if the Registrar so directs, be deemed to have been lodged on the date on which the first-mentioned application was lodged.

“(3) Where an application has been made for registration of a trade mark in respect of certain goods or services and, before the application has been accepted or refused, the applicant has made a further application for the registration of that trade mark in respect of goods or services included in the description of goods or services in respect of which the first-mentioned application was made, the Registrar may direct that the further application shall be deemed to have been lodged on the date on which the first-mentioned application was lodged.

“(4) An appeal lies to the Federal Court from a direction of the Registrar under either of the last 2 preceding sub-sections.

The “parent” application on which the applicant relied in invoking the provisions of s 43 was No 407435 which was advertised accepted on 18 September 1986, that is, after the lodgment of No 449102 as required by s 43. The former application was lodged in respect of what was claimed to be a series of marks pursuant to s 39 which is in the following terms:

“Series of trade marks

“39(1) Where a person who claims to be the proprietor of several trade marks for the same goods, for goods of the same description within a single class, for the same services or for services of the same description within a single class seeks to register those trade marks and the trade marks, although they resemble each other in material particulars, differ in respect of —

- (a) statements or representations as to the goods or services in respect of which the trade marks are used or proposed to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
- (d) colour,

or in respect of any 2 or more of those matters, the trade marks may be registered as a series in 1 registration.

“(2) All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks ”

The claimed series was in respect of the following two marks:



MAGIC CARPET

15 Following objection by the examiner that the two marks did not constitute a series in accordance with s 39 the applicant consented to amend the application by deleting the first of the two marks, which is now the subject of the present application and to the claim to divisional status under s 43.

20 In her first report on the subject application the examiner objected to the claim for divisional status on the ground that it was Office practice "that marks lodged as a series which do not constitute a series will not be accorded divisional status". In response the attorney for the applicant, Mr Peter Nicholls, stated that he did not understand the objection and asked for a precise statement of the official practice on which the objection was based. The examiner replied that the mark of the present application was not part of the trade mark the subject of the parent application, that is, in effect, that the application did not come within the provisions of s 43(1). Mr Nicholls, however, stated that the applicant did not rely on sub-s (1) but on sub-s (3) of the section. To this the examiner replied that s 43(3) was also not applicable because it was concerned with applications in which the classification of goods or services was unclear at the time of application. The classification of the goods of this application had never been queried. Mr Nicholls took issue with this statement of the purpose of s 43(3) and also made submissions with respect to the use of the word "may" in s 43 arguing that the Registrar had no discretion to refuse divisional status to an application if all the conditions prescribed had been fulfilled. However, as the objection was not withdrawn Mr Nicholls requested a decision of the Registrar.

35  
40 Mr Nicholls' attention was drawn to a practice note which was published in the *Official Journal* of 4 August 1988 which sets out the Office practice in relation to series applications. That notice is reproduced in full below. The last paragraph in particular refers to the applicability of s 43(1) to applications for series which do not meet the requirements of s 39:

45 "OFFICE PRACTICE IN RELATION TO APPLICATIONS FOR SERIES OF TRADE MARKS UNDER S 39(1) OF THE TRADE MARKS ACT 1955

50 "Sub-section 39(1) of the Trade Marks Act 1955 allows an applicant to apply for registration of a series of trade marks within one application. To qualify as a series, the marks must resemble each other in material particulars and differ only in the manner prescribed by one or more of

paras (a), (b), (c) or (d) of the sub-section. Trade marks which constitute a series may be registered in one registration and, if so registered, are deemed to be associated trade marks.

“A high percentage of recent series applications fail to satisfy the criteria listed in sub-s 39(1) and particularly those of s 39(1)(c). The purpose of this notice is to provide guidelines on what constitutes an acceptable series of trade marks and to advise of Office practice dealing with series applications which do not qualify under the section.

“(1) *Guidelines*

“To qualify as a series, the trade marks must resemble each other in material particulars, that is the trade mark feature (or features) in each mark of the series must be essentially the same. The differences between the marks must be such that they *do not substantially affect the identity of the trade mark*. This form of words, used to delimit the allowable differences between members of a series, is the same as that used in ss 21, 42 and 127 to indicate allowable amendments to trade marks. The case law dealing with permissible amendments may therefore be applied to the interpretation of s 39 and particularly sub-s 39(1)(c).

“The general requirements for qualification as a series of trade marks have been summarised in a recent decision of the Registrar of Trade Marks *Re Lynson Australia Pty Ltd* (1987) 9 IPR 350; AIPC 90-393.

“(2) *Practice in examination*

“For searching purposes, the constituent particulars of all the marks claimed as a series of trade marks must be entered in the CPI at lodgment. If the marks do in fact constitute a series they will ‘resemble each other in material particulars’ and the index entries will be essentially the same for each mark of the series.

“When a series application is lodged for a number of trade marks which do not qualify as a series under s 39 all the marks must still be indexed for the purpose of searching. The existence of entries for a number of different marks under one application number creates problems in searching, both for the Office and for external users of the index.

“In order to remove redundant entries from the CPI as soon as possible, series applications which do not qualify under s 39 may be directed to early examination and will be dealt with as follows. The first report will require amendment of the application by deletion of those marks not constituting a series. A further report on the registrability of the remaining trade mark(s) will be issued following amendment of the application, although prima facie registrability objections which would apply to all of the marks of the application may be raised in the first report. Applicants will be requested to respond promptly to the notification of an objection under s 39. In any event the time provided by s 48 will run from the date of issue of the first report.

“It should also be noted that the provisions of sub-s 43(1) do not generally apply to the separate marks claimed as a series. Therefore, applications lodged for marks which do not form part of a series and which are deleted under s 39, are not automatically entitled to the priority date accorded to “further applications” under sub-s 43(2). Applications for divisional status will only be accepted if the provisions of s 43(1) are met ”

As I have said, however, Mr Nicholls relies not on s 43(1) but on s 43(3). I must agree with him that there is no basis for the examiner's contention that the purpose of s 43(3) is to allow divisional status to a further application where the classification of goods of the parent application was unclear. Having said that, however, it must also be said that the Dean Committee, which was appointed by the Attorney-General to consider what alterations were desirable in the trade marks law of the Commonwealth, in its report of 1954 had this to say of what subsequently became s 43 of the Trade Marks Act 1955:

"75 Clause 43 is new; it provides for the division of applications. It enables part of a trade mark to form the subject of a fresh application which may be registered as of the date of the original application. It also enables a fresh application to be made, and registered as of the date of the original application, in respect of portion of the goods comprised in the original application. The clause is in effect equivalent to the divisional provisions of the Patents Act 1952."

The committee was, in the penultimate sentence which refers to s 43(3), at least directing its attention to the *goods* of the application and in most instances the only reason an applicant would have for lodging a further application in respect of the same mark for a *portion* of the goods of the original application would be if those goods had been incorrectly included in the specification of the original application. Another situation which could arise, however, is where the trade mark of the parent application is found to be registrable in Pt A in respect of some only of the specified goods and in Pt B in respect of others: *Sportsgirl Pty Ltd's Application* (1969) 39 AOJP 2516 at 2519. The assistant registrar held in that case: "It is open to the applicant to utilise the provisions of s 43 of the Act, to divide from application 191,015 (*sic*) the goods in respect of which I am not prepared to register the mark in Pt A of the register, so that it can lodge an application, before application 192015 is accepted or refused in order to claim a lodgment date of 24 December 1964 in respect of goods which I have indicated the applicant can claim for registration of its mark in Pt B of the register."

But that situation is also far removed from the circumstances of the present case where s 43(3) is being called in aid of a claim for divisional status for an application to register a different *mark* which was included in the parent application and then deleted as a result of an examiner's objection.

Mr Nicholls' argument is, in essence, that the present application meets all the conditions specified in s 43(3) and that therefore the Registrar has no discretion to refuse to accord divisional status to the application. To use his own words: "The requirements of that sub-section are demonstrably satisfied, that is to say, an application (407435) has been made for registration of a trade mark (ie the present trade mark which was a part of that application at the relevant time) in respect of certain goods, and before the application has been accepted, the present application for registration of that trade mark was lodged in respect of goods included in the parent specification "

This argument necessarily involves the proposition that the parent application, 407435, was at the same time a valid application for both the words "Magic Carpet" in plain block capital letters (mark 1) and for the words "Magic Carpet" in script form with the device of a flying carpet (mark 2) which mark is the subject of the present application. But the only way that a single valid application can be lodged for the registration of more than one trade mark is if the provisions of s 39 can be invoked. The requirements of s 39 were not met in the case of application No 407435 which is the reason that the present mark was deleted from the application. To hold that the present application should nevertheless be deemed to have been lodged on the date on which the parent application was lodged would be, it seems to me, to subvert the operation of s 39.

Application No 407435 was not in my opinion a valid application in respect of both mark 1 and mark 2 but rather a valid application in respect of either mark 1 or mark 2. When mark 2 was subsequently deleted it remained a valid application in respect of mark 1 and it was as such that it proceeded to acceptance. A valid divisional claim within the meaning of s 43 could therefore only be based on the application in respect of mark 1.

Furthermore, in my view the words "a trade mark" and "that trade mark" in s 43(3) must necessarily be extended to read "a trade mark or a series of trade marks" and "that trade mark or that series of trade marks". An application to come within the provisions of s 43(3) therefore must be in respect of the same trade mark or the same series of trade marks as the original application, the only variation contemplated being in the specification of goods. This application is neither in respect of the same trade mark or the same series of trade marks as the parent application and therefore s 43(3) is inapplicable. Moreover, it is in respect of the same specification of goods as the parent application. The words "included in the description of goods or services in respect of which the first-mentioned application was made" must, in my opinion, and having regard to the words of the Dean Committee quoted above, which I think I am entitled to do by virtue of s 15AB of the Acts Interpretation Act 1901 (Cth) mean that an application to come within the terms of s 43(3) must be in respect of part only of the specification of goods of the original application and not the complete specification.

In regard to the Registrar's discretion Mr Nicholls relied on the statement of Lord Cairns in *Julius v Lord Bishop of Oxford* (1880) 5 App Cas 214 (at 225):

"Where a power is deposited with a public officer for the purpose of being used for the benefit of persons who are specifically pointed out, and with regard to whom a definition is supplied by the legislature of the conditions upon which they are entitled to call for its exercise, that power ought to be exercised, and the court will require it to be exercised", and to the statement of Lord Blackburn in the same case (at 244): "Enabling words are construed as compulsory whenever the object of the power is to effectuate a legal right" and (at 243): "if the object of giving the power is to enable the donee to effectuate a right, then it is the *duty* of the donee of the powers to exercise the power when those who have the right call upon him so to do "

He also referred to an earlier case, *Macdougall v Paterson* (1851) 11 CB 755, in which Jervis CJ said: "The word 'may' is merely used to convey the authority and the authority must be exercised; if the circumstances are such as to call for its exercise." The learned Chief Justice also said: "We are of  
5 the opinion that the word 'may' is not used to give a discretion, but to confer a power upon the court and judges; and that the exercise of such power depends, not upon the discretion of the court or judge, but upon the proof of the particular case out of which such power arises."

But as the High Court of Australia observed in *Metropolitan Coal Co of Sydney Ltd v Australian Coal and Shale Employees' Federation* (1917) 24  
10 CLR 85 at 96-7:

"The rule in *Julius v Bishop of Oxford* is not that wherever the word 'may' is used in connection with a public office it means 'shall'. Nor, if the legislature confers a right by the same word and states certain conditions,  
15 does it necessarily follow that the word imposes a duty on the proper officer, irrespective of all other considerations. The true rule is thus stated by Lindley MR in *Southwark and Vauxhall Water Co v Wandsworth District Board of Works* speaking of the words 'it shall be lawful': 'These words may, no doubt, under certain circumstances impose a duty as well as confer  
20 a power, but it is for those who contend that they do both to make good their contention. Nothing can be clearer on this point than the judgment of Lord Cairns in *Julius v Bishop of Oxford*.'

"The Privy Council, in *Delhi and London Bank Ltd v Orchard* said that in interpreting Statutes the words 'must' and 'shall' may in some cases be  
25 substituted for the word 'may', but 'only for the purpose of giving effect to the intention of the legislature; but, in the absence of proof of such intention, the word "may" must be taken to be used in its natural, and therefore in a permissive, and not in an obligatory sense'."

Mr Nicholls also referred to *Finance Facilities Pty Ltd v Federal Commissioner of Taxation* (1971) 127 CLR 106; 2 ATR 573 and in  
30 particular to the words of Windeyer J in reference to the passage cited by Mr Nicholls: "I consider that to be directly applicable to the present case". However, Windeyer J also said in the same case (1971) 127 CLR 106 at 134:

"The question, which comes back to the words 'may allow', is not to be  
35 solved by concentrating on the word 'may' apart from its context. Still less is the question answered by saying that 'may' here means 'shall'. While Parliament uses the English language the word 'may' in a statute means may. Used of a person having an official position, it is a word of permission, an authority to do something which otherwise he could not lawfully do. If  
40 the scope of the permission be not circumscribed by context or circumstances it enables the doing, or abstaining from doing, at discretion, of the thing so authorised. But the discretion must be exercised bona fide, having regard to the policy and purpose of the statute conferring the authority and the duties of the officer to whom it was given: it may not be  
45 exercised for the promotion of some end foreign to that policy and purpose or those duties. However, that general proposition is irrelevant in this case. Here the scope of the permission or power given is circumscribed."

If I am right, however, in the view that I have formed that this application does not meet the conditions laid down by s 43(3) it is not necessary to  
50 decide whether the Registrar does have a residual discretion to refuse an application under s 43(3)

In view of my conclusion that the claim under s 43(3) fails I will allow the applicant one month from the date of this decision to withdraw the claim and consent to the deletion of the endorsement from the application form. If this is not done I will refuse the application.

Patent Attorneys for the applicant: *P N Nicholls*.

B J HESS  
BARRISTER

**Re APPLICATION BY DUALIT LTD (TOASTER SHAPES)**

5

**Registration of a trade mark**

I THOMPSON (Hearing Officer)

10

19 January 2001

15 **Trade marks — Application to register — Shape mark — Inherent adaptability to distinguish — (CTH) Trade Marks Act 1995 s 41.**

Dualit filed two applications, Nos 769783 and 769784, to register the shape of two bread toasters.

The applications were filed pursuant to s 51 as series applications and each showed a number of representations of the toasters illustrating different aspects of them.

20

The examiner raised the objection that the trade marks were not capable of distinguishing the applicant's goods from those of other traders.

Evidence in support of the applications was submitted but the examiners objections were maintained. The examiner referred the matter to the hearings section.

25

**Held:**

(i) The evidence did not show that the shapes were distinctive of the applicant or ever will be distinctive of it.

(ii) The registrations should be rejected.

30

**Application**

This was a hearing in relation to a disputed application to register two shape marks.

35

*Phillips Ormonde & Fitzpatrick*, attorneys, for the applicant.

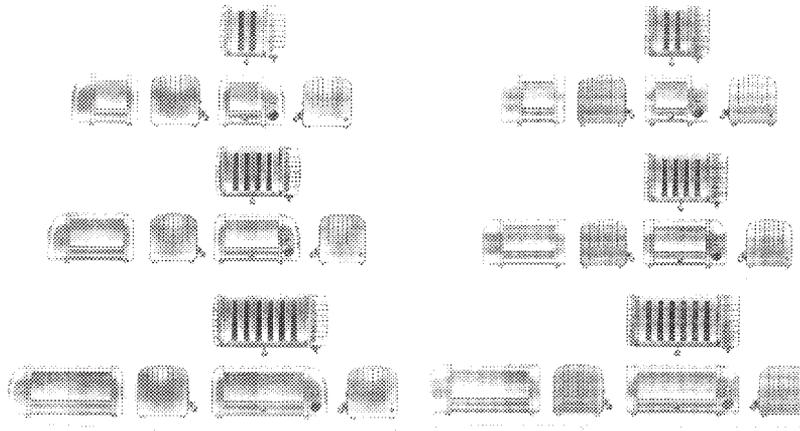
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**I Thompson** (Hearing Officer).

**Background**

45 These issues arise out the filing on 11 August 1998 of two applications by Dualit Ltd (the applicant) to register the shapes, as shown below, of bread toasters in respect of goods specified as "toasters". The applications are made under the provisions of s 51 of the Trade Marks Act 1995 (the Act) — these provisions prescribe the conditions under which the registration of a series of trade marks may occur.

50



No 769783 — Rounded-end

No 769784 — Angled-end

The examiner's first reports issued on 4 November 1998. The examiner objected under the provisions of s 41(5) that the trade marks were not capable of distinguishing the applicant's goods from those of other traders and invited the applicant to submit evidence of use of the trade marks addressing the provisions of s 41(5). Following the elapse of some 15 months, the applicant sought, and received, extensions of time till 4 May 2000 in which to make a response to the examiner's reports. On 28 March 2000, Phillips Ormonde & Fitzpatrick, the attorneys for the applicant, responded to the examiner's first reports, enclosing two statutory declarations. The first is by Lesley Alexander Gore-Barten, managing director of Dualit Ltd, of England, and the second by John Ryan, managing director of ET Miller Pty Ltd — Australian importer and distributor for the applicant's goods. The attorney's accompanying letter argued briefly that "the evidence shows that as a result of the extensive use of the trade marks in Australia and overseas, the shapes have become design icons and are synonymous with the applicant Dualit Ltd". The examiner's responses to the submission focused on the lack of capacity in the trade marks to distinguish, the shortcomings of the evidence and were supported by general observations concerning some toasters that the examiner had seen for sale in some shops.

The applicant responded by leading evidence from a number of people who are involved in the sale of electrical appliances or kitchenwares — I will term these declarations the "pro forma" declarations when referring to them as a group and individually as follows:

<i>Declarant</i>	<i>Declaration known as:</i>	<i>Made</i>	<i>Exhibits</i>
Susan E Jenkins	Jenkins	26 June 2000	1
Peter Gialouris	Gialouris	23 June 2000	1

	Susan Fiona Loudon	Loudon	22 June 2000	1
	Stephen Panui	Panui	26 June 2000	1
5	Jill Braslin	Braslin	21 June 2000	1
	Karen Lea Gubb	Gubb	23 June 2000	1

(I will note now that there are a number of problems with the pro forma declarations both regarding their prima facie provenance and reg 21.6 which provides how declarations are to be made. The Jenkins declaration refers to the declarant as both Susan E Jenkins and as Susan Anne Jenkins and bears no signature — only a hand printed name. The Panui declaration merely identifies the place of execution of the declaration as the name of his employer. The Braslin declaration has consistently identified the manufacturer of the toaster as being “Duralit”; somebody has crossed out the letter “r” but it is not clear whom since the correction is not signed or initialled. Further, the Braslin declaration, in response to questions which request the declarant to delete either the word “yes” or “no” to answer the question, has consistently circled the word “yes” and left the word “no” alone. Thus, it is not clear whether Braslin intended to delete the word “yes” or was answering affirmatively — although the latter seems to be more likely. Finally, the Gubb declaration does not state the name of the person before whom it was made or the address of the declarant.)

There followed an exchange of submission and response by attorney and examiner, the examiner’s culminating with the observation that,

It seems that we have reached an impasse and no further progress can be made at the examination level. The only avenue open to the applicant for finalising this matter seems to be to present any further argument at a hearing. I therefore advise that I intend to refer any further submissions to the hearings section where the matter will be set down for a hearing.

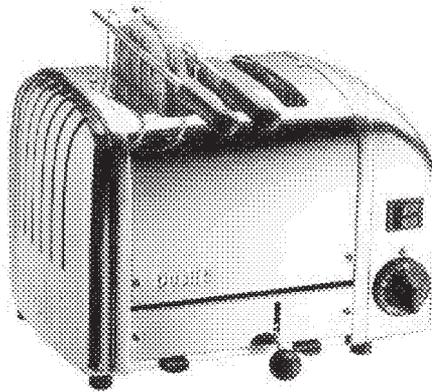
On the attorney’s further submission, the matter was set down to be heard. The hearing was by video-conference on 26 October 2000 — the applicant being represented by Mr Russell J Waters of Phillips Ormonde & Fitzpatrick. I heard the matter as a delegate of the Registrar of Trade Marks.

Some days prior to the hearing, I brought a decision of the British courts to the attention of Mr Waters and advised him that it would be appropriate that he address the observations of the court in his submissions. The decision of the British court is of the High Court of Justice — Chancery Division and is reported as *Dualit Ltd’s (Toaster Shapes) Trade Mark Applications* [1999] RPC 890 (the *Toasters* case).

#### 45 **The evidence**

It is convenient for me to include here a perspective picture of the round-ended toaster since it will enable my discussion of the issues to be more easily followed:

50



The Gore-Barten declaration attests that the declarant has been managing director of the applicant since 1980. Mr Gore-Barten attests that the toasters the subject of application No 769784 have been sold extensively throughout North America, Europe, Australia, New Zealand, Hong Kong, Singapore, other Asian countries and South America since 1986. The round-ended toaster, the subject of application No 769783, has been sold in the above countries since early 1995. Mr Gore-Barten continues by stating that both shapes have a number of features in common which distinguish them from other toasters on sale for the last 20 years. These are claimed to be: that they are of heavy solid construction, have a rounded upper profile as seen in end view, substantial end cast sections each banded at the base at its joint with the central section, an operating lever extending through a slit in a separate lower part of the central section, and a series of vertical parallel slots in each of the end faces. The central sections, avers Mr Gore-Barten, of each of the models are exactly the same but the end castings have slightly different shapes, those of application No 769783 having a rounded top in side view while those of No 769784 have a more angled, or chamfered, shape.

I gather, from the evidence, that the toasters are primarily designed with a commercial application in mind but have become a desirable kitchen accessory for some cognoscenti.

The declaration elaborates on the development of these toaster shapes from the design developed in 1948 by Mr Gore-Barten's father.

The declaration draws my attention to the amounts in pounds sterling charged by Dualit to its Australian distributor for supply of the toaster. The amount ranges from some \$22,000 in 1989–90 to a yearly average of some \$120,000 till 1995–96 for the angle-ended toaster. If I understand the figures correctly, Australian sales of the angle-ended toaster, the subject of application No 769784, ceased in 1995–96 since the figures for that year are low and no subsequent figures are given in either of the main declarations. Sales of the round-ended toaster, the subject of trade mark application No 769783, started in 1995–96 and averaged some \$250,000 a year in charges by Dualit to its Australian distributor in the two subsequent financial years. The exhibits to the declaration suggest that, in Britain, the toaster retailed at this time for around the equivalent of \$240 — (the figures in this paragraph assume an exchange rate at the time of A\$2 / £) — however, an advertisement attached to the Ryan declaration gives an Australian retail price of \$595 for the round-ended toaster.

The Gore-Barten declaration draws my attention to two features in publications, one in the British *Daily Mail* newspaper dated 8 August 1997 and the other in *Best* magazine. These magazines have short articles about two different toasters, the first a Littlewoods and the second a La Cuisine. These articles both compare the toaster design being publicised to the Dualit toaster design, to which they both have a marked similarity. The inference is, states the declarant, that the Dualit design is well known and recognised by the “advertiser” who uses it to describe the other toaster. I would, however, take these writers to be journalists who either specialise in the kitchen or home-wares area or are writing with reference to copy provided to them by the makers of the toasters. One would expect such persons to know of the Dualit toasters since this is their job or they are working from information provided to them. Moreover, the journalists were writing in Britain, where the articles were circulated. I do not believe that these articles succeed in showing any awareness of the Australian public of the shapes of the toasters.

The Gore-Barten declaration attaches a copy of a declaration made by a Mr Bryan Whittaker of the (British) Association of Catering Equipment Manufacturers and Importers. Mr Whittaker affirms that he associates the shape with Dualit and that he is not aware of any other company selling toasters of a similar shape to that in question.

I will interpose here to observe that Mr Whittaker had been replying to a question from the British trade mark firm prosecuting the corresponding shapes before the United Kingdom (UK) Trade Mark Office. I find his references to the two different trade marks as being the one shape quite confusing and I cannot be certain to which sign he is referring, if he is referring to both or whether, indeed, he has actually realised that he has two different signs before him. While it could be argued that the features in common to both signs have led to his observations, I am not at all sure whether it might not be the case that Mr Whittaker’s conclusions have arisen from observing the functional features of the toaster which are in common between the two differing shapes, (the placement of the light, knobs, levers and dials) on their own or in combination with the general shapes of the toasters. Additionally, Mr Whittaker would be expected, in his position, to know of the products of his association’s members — thus his knowledge of the toasters cannot be seen as indicating any wider knowledge or recognition of the toaster shape by the public. Further, he is attesting of his knowledge of the shapes in Britain — not Australia. Accordingly, I view this declaration as being of low relevance to these issues.

The Gore-Barten declaration then goes on to detail at some length the advertising, promotion and publicity surrounding the toasters. This consists of material published in the UK, details of British trade shows, British mail-order catalogues and the like. This does not appear to be relevant to Australia and it is not shown that any of this material actually carried to Australia. The toaster has also appeared in films and television: in 1994, the angle-ended toaster appeared in *Star Trek: Generations* within the kitchen in Captain Kirk’s retirement cabin. The same toaster appeared in a film called *Shallow Grave* in 1994 where it “was the blunt instrument with which the villain was eventually despatched”. However, this is the toaster that appears, from the evidence, to be no longer sold in Australia. The toasters have also been props in the series *Coronation Street*, *Eastenders*, *AbFab*, *Friends* and an episode of *Bread*. I think that for the shape of a prop in a television show or cinema film to be significant in issues such as these before me, the viewer would need to recognise its significance. The

argument that such exposure results in a shape which is unknown to Australians becoming well-known appears to be founded on a false premise since the significance of the shape of the prop may only be apparent when it is explained during the show, is previously known, or subsequently explained.

I thus regard the content of the Gore-Barten declaration as being of relevance only in so far as it shows some of the background to these applications — apart from confirmation of export of goods to Australia and some figures to support this, the declaration is of negligible relevance to the Australia marketplace.

The Ryan declaration is by John Ryan who is managing director of ET Miller Pty Ltd, the Australian importer and distributor of the applicant's toasters. He says that the Dualit toasters' shape and design render them worldwide traditional icons. A Dualit toaster, avers Mr Ryan, "is easily recognised by its all metal finish and moulded slot ends. The Dualit toasters' robust design and long-term life expectancy stands them apart from all other toasters".

Consistent with the Gore-Barten declaration, the sales figures given in the Ryan declaration for the angle-ended toasters (application No 769784) come to an end in 1995–96. However, Ryan's figure for sales of this toaster in this year is so at variance with that of the Gore-Barten declaration that it can only be a mistake: in the Gore-Barten declaration, the figure given for the 1995–96 year is under one third the amount charged by the applicant to the distributor during the year 1994–95 and yet the figure given in the Ryan declaration for 1995–96 is nearly double that of 1994–95 — the mismatch is thus by a factor of six. The samples of the advertising of the toaster distributed in Australia all feature the round-ended toaster. It could be safe to conclude on this evidence that the angle-ended toaster has not been distributed in Australia since 1995. However, the Ryan declaration is at odds with this evidence, he attests that "toasters in accordance with application No 769784 [the angle ended toasters] have been distributed in Australia since early 1986 and toasters in accordance with application No 769783 [the round-ended toaster] have been distributed in Australia since 1995 (hereinafter Dualit toasters)". [Parenthetical material adjusted.]

Subsequently, the Ryan declaration makes statements using the defined term, "Dualit toasters", such as "Dualit toasters are sold in two different markets", or, "The company has exhibited Dualit toasters at commercial trade shows". There follows the details of a trade show in 1997 and another in 1998 — both well after the import of the angle-ended toaster had apparently ceased. This evidence is confusing since it suggests both a continuing sale of the angle-ended toaster and that the angle-ended toaster remained on sale and display in Australia after importation had seemingly ceased in 1995 — it invites conclusions which a more detailed consideration of the evidence suggests are not based in reality. Accordingly, I am not inclined to put much reliance on the Ryan declaration. It appears to contain a factual error concerning sales figures. It tends to confuse the use of the two trade marks and to telescope the use of the two different trade marks into an amalgam. Further, it might alternatively be viewed as being poorly drafted or less than fully frank.

I would estimate, to judge by the retail price of the toasters and the stated annual sales totals, that some 300–400 of the round-ended toasters are sold within Australia each year. I have some hesitation about this figure since this estimation relies on the figures supplied in the Ryan declaration that — as I have indicated — appear to be wrong for the 1995–96 year. The sales of the toasters

occur through some 149 outlets. If I am correct in my extrapolation from the figures supplied, each of these outlets might on average sell some three or four of the round-ended toasters a year.

5 There has been no information supplied by Dualit about the size of the toaster market in Australia or the proportion of the market that it occupies.

Mr Ryan states that his company has advertised in *Galley Magazine* — 1996; *Table and Kitchen Magazine* — 1996; *Vogue Entertaining* — 1997; *Info-Link Magazine* — 1997 (3 times); *Galley Magazine* — 1997. Copies of some of the advertisements are exhibited to his declaration and all show the round-ended  
10 toaster.

Mr Ryan avers that the Dualit toasters have been provided and promoted as prizes on two prime time Australian quiz shows, *The Price is Right* and *Concentration*. It is not stated whether the toasters were provided to these shows on an ongoing or once off basis. The dates of these shows are not provided;  
15 neither is it stated which shape of toaster was provided to these shows.

I return now to the pro forma declarations. The questions that the declarants are answering are not well framed and the answers confusing — for example, in response to a question about the angle-ended toaster “when [did] you first become aware of toasters having this shape (year)” the Gialouris declaration  
20 states “5+ years”. The Jenkins declaration (which I must regard as being informally made for the reasons stated above) states that the declarant was aware of the angle-ended toaster in 1980 — this is well before 1986 when this model went on sale in Britain or Australia. The Gubb declaration states that the declarant became aware of the angle-ended toaster 2 years ago (in 1998) — after  
25 the import of the angle-ended toaster had apparently ceased — she then indicates that she does not associate that shape with any particular manufacturer, whom she next indicates is Dualit. As noted above, Ms Braslin, who has 10 years experience in household appliances, has indicated that she believes that the manufacturer is “Duralit” — which has subsequently been corrected to “Dualit”. As the evidence  
30 shows that the word “Dualit” appears prominently on the toasters made by the applicant, it might be inferred that the name of the toaster (by which it would presumably be known) was not well-known to this declarant. Further, as the declarants all own, or are employed by, shops that specialise in kitchenware, they  
35 might be expected to know of the toaster shapes — as I have earlier mentioned, these shops sell three or four of the toasters each year. Their statements, such of them as are validly brought into evidence, show nothing of the knowledge of the shape in the wider population. These declarants are not the market for the toasters — they are part of the conduit to it.

I note the British attorneys who contacted Mr Whittaker for his declaration  
40 were careful not to indicate to him that they acted for Dualit. Copies of their correspondence with him prior to his making his declaration are in evidence — they are careful to avoid any mention of their client. There is no such evidence before me concerning the correspondence of the Australian attorneys with the pro forma declarants prior to their making these declarations. I have no way of  
45 knowing, therefore, whether the declarations were made with the knowledge that they were being asked about Dualit products: if this was so, this knowledge may have materially affected their responses to the questions asked of them.

It is not clear to me whether the six declarations are a sample batch of people selected from the list of 149 distributors who all responded to the questionnaire  
50 or whether a wider group, or even all, were questioned and the “declarations” which have been submitted is the extent of the response.

In summary, I find that the pro forma declarations are not helpful to me. Of these declarations, the only one that has been made both in accordance with the regulations and is unambiguous is the Loudon declaration. However, as I have indicated, the circumstances under which it was made are not clear.

### **The submissions**

Much of Mr Waters' submission was sharply critical of the course of the administration of these applications. I understand that these concerns are being addressed in correspondence between Mr Waters and the office; I will not address these concerns here since I do not believe that this is an appropriate forum — what I must rather address is the registrability of these signs.

Waters drew my attention to the statutory and case law framework that should guide my decision and drew my attention to the distinctions between the British and Australian Trade Marks Acts. This distinction, he said, should allow registration of the trade marks in Australia whereas the British court in the *Toasters* case, above, had found the signs not to be registrable. I will discuss the detail of the submissions, and the evidence, as they relate to my reasons, below.

### **Reasons**

Sections 17 and 6 of the Act define:

#### *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 6 of the Act provides the definition of sign:

“sign” includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.

Section 41 of the Act provides:

#### *41. Trade mark not distinguishing applicant's goods or services*

(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For “applicant” and “predecessor in title” see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (designated goods or services) from the goods or services of other persons.

Note: For “goods of a person” and “services of a person” see section 6.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

5 (a) the Registrar is to consider whether, because of the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use, of the trade mark by the applicant;

10 (iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services — the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and

15 (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services — the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

20 Note 1: For "goods of a person" and "services of a person" see section 6.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

25 (6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

30 (b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

35 (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

(b) the time of production of goods or of the rendering of services.

40 Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

The approach to the application of s 41 was discussed by Branson in *Blount Inc v Registrar of Trade Marks* (1998) 83 FCR 50; 40 IPR 498; (1998) AIPC 91-408 (*The Oregon Case*).

45 In deciding whether a trade mark is capable of distinguishing, the Registrar has three options, says Branson J. The Registrar may conclude:

(a) that the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons and capable, on that basis alone, of so distinguishing the designated goods or services; or

50 (b) that the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; or

- (c) that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons, but there is uncertainty, on that basis alone, that the trade mark is actually capable of distinguishing the designated goods or services.

Branson J says:

The structure of s 41 of the Act dictates that if the Registrar reaches conclusion (a) above, then he or she will decide the question whether or not the trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons by reaching the answer that it is so capable by reason of its inherent adaptability to distinguish: s 41(2) and (3). The Registrar will, in such circumstances, be required, by reason of the terms of s 33(1) of the Act, to accept the application unless he or she is satisfied that the application has not been made in accordance with the Act, or that there are grounds, independent of capacity to distinguish, for rejecting the application.

If the Registrar reaches conclusion (b) or (c) above, he or she is, within the meaning of s 41(4) “unable to decide the question”. That is, he or she is unable, simply by taking into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services, to answer the question whether or not the trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons.

If the Registrar reaches conclusion (b) above, then the provisions of paras (a) and (b) of s 41(6) are brought into operation. If the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date of the application, the trade mark does distinguish the designated goods or services as being those of the applicant, the Registrar will not reject the application pursuant to s 41(2). The Registrar will, in such circumstances, accept the application unless he or she is satisfied that the application has not been made in accordance with the Act, or that there are grounds, independent of capacity to distinguish, for rejecting the application: s 33(1). If the applicant fails to establish that because of the extent to which the applicant has used the trade mark before the filing date of the application, the trade mark does distinguish the designated goods or services as being those of the applicant, the Registrar must reject the application pursuant to s 41(2).

If the Registrar reaches conclusion (c) above, then the provisions of paras (a), (b) and (c) of s 41(5) are brought into operation. If the Registrar, having considered the combined effect of the matters listed in subparagraphs (i), (ii) and (iii) of s 41(5)(a), is satisfied that the trade mark does or will distinguish the designated goods or services as being those of the applicant, he or she will not reject the application pursuant to s 41(2). The Registrar will, in such circumstances, accept the application unless he or she is satisfied that the application has not been made in accordance with the Act, or that there are grounds, independent of capacity to distinguish, for rejecting the application: s 33(1). If the Registrar, having considered the combined effect of the matter listed in subparagraphs (i), (ii) and (iii) of s 41(5), is not satisfied that the trade mark does or will distinguish the designated goods as being those of the applicant, the Registrar must reject the application: s 41(2).

In determining the issues of s 41, Branson J directs that the first step is:

... to take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods from the goods of other persons.

Her Honour then addresses the question of inherent adaptation and comments both in respect of the repealed Trade Marks Act 1955 (Cth) and the current law. In respect of word trade marks (and specifically geographic words) Branson J says:

The notion of a trade mark being inherently adapted to distinguish the designated goods was of primary significance under the 1955 Act. There is no reason to think that

the phrase “inherently adapted to distinguish the designated goods from the goods of other persons” appearing in s 41(3) of the Act is not intended to be understood in the light of decisions under the 1955 Act, and comparable UK legislation which includes references to inherent adaptability.

5 Further, prior to the application of the above principles to the instant signs, it is appropriate to note that they are both shapes and to incorporate some of the reasoning that is relevant in such instances.

10 In *Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd* (2000) 100 FCR 90; 177 ALR 167; 48 IPR 257, Burchett J, with whom Branson and Hill JJ agreed, observed:

[13] The nearest the appellants came, in argument, to finding an instance of a use of the goods as the trade mark, which could be supported by existing authority, was not the *The Coca-Cola Company* (for there the mark was something added by being impressed on goods that already had their identity as sweets of a particular flavour and texture, which remained unchanged); rather, it was in the example suggested by Branson J of a bottle of perfume. But in the case of a perfume or a drink, it is just because the bottle is only a container for the product the purchaser is going to apply or consume, that features of its shape are sufficiently variable to be capable of being made distinctive (see *Philips Electronics NV v Remington Consumer Products* (1997) 40 IPR 279 at 290), and may therefore be used as a mark, though not if the capacity for distinctiveness is not exploited: *Re Procter & Gamble Ltd's Trade Mark Applications* [1999] RPC 673 at 680–1, per Robert Walker LJ (with whom Peter Gibson and Tuckey LJ agreed). The point may be illustrated by imagining a case where the bottle became the essence of the commodity sold, being an expensive imitation gourd or reproduction of a particularly beautiful Grecian urn. In such a case, other traders might legitimately wish to produce like imitations or reproductions, and the use of the shape could not in itself distinguish the products of one person: cf the passage from the judgment of Kitto J in *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511 at 514; [1965] ALR 344; (1964) 38 ALJR 215 which Branson J cited in *Blount Inc v Registrar of Trade Marks* (1998) 83 FCR 50 at 55; 40 IPR 498 at 503; (1998) AIPC 91-408. Whether the question of fact under s 41(6)(a) of the Trade Marks Act 1995, which is discussed in the last mentioned decision, could ever properly be answered in favour of the manufacturer of a gourd or urn of the kind I have postulated, if he sought to register its shape as a trade mark, does not need to be determined in this case. But when it does come up for determination, consideration will need to be given to the meaning of the expression “it does distinguish” in s 41(6)(a). The word “distinguish”, as a glance at the *Shorter Oxford English Dictionary* will confirm, implies something other from which a differentiation is, or is to be, made. Where, therefore, a sole manufacturer uses a particular name or shape for a product no one else produces, how do we say whether it does in fact distinguish? Is it relevant that, if anyone else were to produce the same product, the name or shape could not differentiate between the two? Does that mean it never did distinguish, though it may have named or embodied a kind of product of which there was but one example? Despite the differences between the 1995 Act and the English legislation, it may be that some light will be found to be cast on the matter by the reasoning of Aldous LJ in *Philips Electronics NV v Remington Consumer Products Ltd* [1999] RPC 809 at 817–20; and of Jacob J at first instance in *Philips Electronics NV v Remington Consumer Products* (1997) 40 IPR 279 at 292–3.

45 Further, Burchett J stated:

[16] It does not follow that a shape can never be registered as a trade mark if it is the shape of the whole or a part of the relevant goods, so long as the goods remain distinct from the mark. Some special shape of a container for a liquid may, subject to the matters already discussed, be used as a trade mark, just as the shape of a medallion attached to goods might be so used. A shape may be applied, as has been said, in relation to goods,

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perhaps by moulding or impressing, so that it becomes a feature of their shape, though it may be irrelevant to their function. Just as a special word may be coined, a special shape may be created as a badge of origin. But that is not to say that the 1995 Act has invalidated what Windeyer J said in *Smith Kline*. The special cases where a shape of the goods may be a mark are cases falling within, not without, the principle he expounded. For they are cases where the shape that is a mark is “extra”, added to the inherent form of the particular goods as something distinct which can denote origin. The goods can still be seen as having, in Windeyer J’s words, “an existence independently of the mark” which is imposed upon them.

And:

[20] Although the relevant Canadian statutory provisions are significantly different from the provisions of our Act, in terms of the general principles relating to trade marks, similar conclusions were stated by MacGuigan JA, speaking for the Federal Court of Appeal, in *Remington Rand Corp v Philips Electronics NV* (1995) 64 CPR (3d) 467. That case involved a Canadian registration of Philips’ so-called three dimensional trade mark. MacGuigan J said (at 477):

“It is clear that every form of trade mark . . . characterised by its distinctiveness.”

He went on to refer (at 478) to “the public policy basis [of trade marks] . . . to distinguish wares from those of competitors, by monopolising, not the wares, but the mark as used in relation to them”. And he concluded (ibid):

“A mark which goes beyond distinguishing the wares of its owner to the functional structure of the wares themselves is transgressing the legitimate bounds of a trade mark.”

In *Re trade mark application No 757596 (5, 11) — BOTTLE SHAPE — in the name of Saramar, LLC*, unreported, I noted that:

It is apparent to me that the relevant principles I am to apply to this sign are:

- The bottle shape should only be a container for the product — not a product in itself;
- The trade mark should be something extra which is added to the inherent form of the particular goods;
- The goods should have an existence independent of the trade mark;
- The features of its shape should be sufficiently variable to be capable of being made distinctive;
- The capacity for distinctiveness should have been exploited;
- The bottle should not be or become the essence of the commodity being sold (if so, the meaning of the phrase “it does distinguish” should be considered); and,
- Any functional features transgress the bounds of what is a trade mark.

I believe that a shape may pass any of the above criteria yet fail to be assessed as having any inherent adaptation if it fails one or more of the others. However, having one or more functional features does not detract from the possibility that a shape trade mark does have inherent adaptation to distinguish provided that those features are not the “something extra”<sup>1</sup> which is added to the goods or such that their prominence overwhelms the something extra which is added to the goods.

The question of whether a trade mark is adapted to distinguish the goods of one trader from those of another was considered by Kitto J in *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511 at 513; [1965] ALR 344; (1964) 38 ALJR 215:

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1. Distinct from the trade mark itself in the sense of *In the Matter of James Trade Mark* (1886) 3 RPC 340 at 344 or in *Re Coca-Cola Company’s Trade Marks* (1986) 6 IPR 275 at 276–7; RPC 421 at 457.

... the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives — in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess — will think of the word and want to use it in connection with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

And:

... the applicant's chance of success ... must, I think, largely depend on whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.

The shapes here are what might be called “retro” or “art deco” styling or design — such designs are popular, in my experience, among traders who wish to dress or embellish their goods in a way that is going to appeal to fashion conscious consumers. It is plain from the evidence that Dualit has always made toasters in this style — however, fashion has come round in a circle and these designs are popular again. Having said that, I must also keep in mind that the round-ended toaster has only been imported into Australia since 1995 and the angle-ended toaster was apparently imported from 1986 till 1995.

Mr Ryan, in his declaration, calls attention to the toasters' shape and design [which] “render them worldwide traditional icons”. A Dualit toaster, says Mr Ryan, “is easily recognised by its all metal finish and moulded slot ends. The Dualit toasters' robust design and long-term life expectancy stands them apart from all other toasters.” Mr Gore-Barten also calls attention to the iconic status of the toasters and says that they are of heavy solid construction, have a rounded upper profile as seen in end view, substantial end cast sections each banded at the base at its joint with the central section, an operating lever extending through a slit in a separate lower part of the central section, and a series of vertical parallel slots in each of the end faces. The central sections, says Mr Gore-Barten, of each of the models is exactly the same but the end castings have slightly different shapes. Viewed in the light of the comments of the court in *Remington*, above, an all-metal finish, robust design, long-term life expectancy, iconic status, heavy solid construction, operating levers and substantial end cast sections, are irrelevant to the question of the shapes' inherent adaptation to distinguish the goods of the applicant.

I think that what we are left with when considering the signs' inherent adaptation to distinguish the goods are the facts that, in end-on profile the toasters are rounded; in side-on profile they have one rounded end and are either asymmetrically rounded at the other end or have an angle cut in the asymmetrically rounded part. There is a set of seven lines, ridges, slots or grooves set into either end of each toaster. I do not believe that the other functional elements contribute to the shapes' inherent adaptation in any way at all. I note that the more pronounced end of the toaster is that with the controls built into it and I have some concern, which I have set to one side, that the form of the asymmetry was thus dictated by function.

I am aware that there are many toasters on the market with rounded ends; in manufacture, ribbing or grooving is often used to impart structural strength to pressed metals. If these ribs are, in fact, slots, it may also be that they have a function in cooling the toasters. However, I am here prepared to accept that the

ribbing here is a part of the shape. I also note that the retro design of the toaster is one which, as I have observed, is very popular.

It is, of course, immaterial to considerations here that a toaster has been nominated or displayed in London by an organisation as being a design icon or classic. I note that the same organisation also nominated the Russian AK47 assault rifle and a particular design of baby's fold-up pushchair. I would not expect the Australian public to have any familiarity with either of these particular products and do not consider that they should have any additional familiarity with a toaster on this basis.

I therefore conclude that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

I am certain that it does not matter in the end whether I decide the matters under s 41(5) or (6) as the evidence led by the applicant is wholly inadequate for either task. However, I am prepared to accept the view of the examiner and the attorney that the grounds for rejection here are those under s 41(5). The shapes have a marginal degree of adaptation to distinguish.

Accordingly, in terms of s 41(5), what I am now to consider is whether, because of the combined effect of the extent to which the trade mark is inherently adapted to distinguish the toasters; and the use, or intended use, of the trade mark by the applicant; and, any other circumstances, the trade mark does or will distinguish the designated goods or services as being those of the applicant.

I would assess the inherent adaptation of the toasters as being very low. The shapes are not large deviations from that of any other retro-styled toaster. Indeed the applicant's own evidence shows at least two other manufacturers make toasters that are quite similar to the shapes here in question. This accords with my own experience that tells me such styling is not uncommon.

On the basis of the evidence led by the applicant, I am not satisfied that the shapes do, or ever will, distinguish the goods of the applicant from those of other traders. The angle-ended trade mark can be discounted from consideration immediately since I think that it is fair to infer from the evidence that this toaster has not been sold in Australia for some 5 years and might indeed be a model superseded by the round-ended toaster. If this is not the case, the evidence is framed so vaguely that it is impossible to assess what the prospects are that the angle-ended shape ever could distinguish the goods of the applicant. There is apparently no current commercial exposure of this product to assess.

Mr Waters argued that the pro forma declarations were relevant since the declarants, in effect, constitute the market to which the goods are sold. I do not accept this. It is quite apparent that the stores stand in the supply chain to the market but are not the ultimate consumers of the goods. Mr Waters' approach reduces the ultimate purchasers of the goods to a nullity — without somebody to purchase and use the goods, the shops would not stock them. This approach ignores the problem that such declarations show nothing more than the fact that shopkeepers know their goods. However, if I were to accept this argument, it does not appear to help in any case since the applicant's evidence shows that it supplies only 149 shops in Australia with no demonstrated growth of these outlets. If I were to accept that this evidence demonstrates that 149 salespersons in Australia know of the applicant's goods, this is not a basis for a conclusion that the trade mark does or will distinguish the goods of the applicant among the wider population of appliance salespeople, of whom there must be many thousands. Additionally, as I have said, the declarations are such that only one of

them can be accepted as being properly made and having any credence; and, further, it is not clear under what circumstances any of the declarations were made.

5 The declaration of Mr Gore-Barten is confined in a large part to the circumstances prevalent in the British Isles — the home market of the goods. I note that, in the *Toasters* case, above, the High Court found that the evidence did not show that the shape of either model had become distinctive through use in the UK. Under the UK Trade Marks Act, marks which are found to lack inherent  
10 distinctiveness must be made distinctive through use before becoming registrable. Under the provisions of s 41(5) of the Australian Act, a lower hurdle applies: I need only be satisfied that trade mark does or *will* “so distinguish the designated goods”. I think that the term “will distinguish” looks forward to a time when, through the use of the trade mark, it will be distinctive of the goods. That is, that there will be a sufficient recognition of the shape among substantial  
15 numbers of the relevant public in the marketplace as designating the goods as being those of Dualit.

I am not satisfied that this will occur in relation to the applicant’s shape marks. With the angle-ended toaster, this appears to be a serious practical difficulty because, apparently, it is not on the market. With the round-ended toaster, there  
20 is no evidence that would support the proposition that a substantial number of relevant potential customers will identify the goods as originating from Dualit because of the shape alone. There is no evidence that the toaster shape is now recognised among the Australian public; the pro forma declarations are no assistance for the reasons stated above. I believe that if the British court in the  
25 *Toasters* case had found that the trade marks had become distinctive, it would be open to me to find that the trade marks might at some time in the future be distinctive in Australia if it were shown that the markets for toasters in Australia and Britain were comparable.

The sales volume are low, there are only some 300 or 400 sold in Australia  
30 each year — this amount does not, on the figures supplied in evidence, appear to be increasing. Thus, there is no basis in the evidence on which I can be satisfied that I could safely extrapolate forward to a time when the round-ended toaster shape mark will distinguish the goods.

Hence, I am not satisfied that either of these trade marks does, or will,  
35 distinguish the applicant’s toasters from those of other traders.

#### **Decision**

Accordingly, I reject applications Nos 769783 and 769784.

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ANN DUFTY  
SOLICITOR

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**Re ECOSPECIFIER PTY LTD**

IP AUSTRALIA

A WINDSOR (Hearing Officer)

23 June, 15 July 2011 — Canberra

**Trade marks — Certification marks — Series application — Differences within series — Denotation of quality — Applicant sought to register 32 separate marks as one series — Examiner refused to allow registration on basis that distinguishing feature did not necessarily pertain to quality of classified goods — Whether separate classifications did pertain to quality — Whether representations contained other distinguishing features — Whether 32 marks did comprise a single series of marks.**

In July 2010, Ecospecifier Pty Ltd (the applicant) applied for a certification trade mark in relation to a series of 32 separate marks pursuant to s 51 of the Trade Marks Act 1995 (Cth) (the Act). The full series was based on four main marks which comprised “green tags” denoting the ecological friendliness of specified building goods and services. More specifically, the marks were made up of separate platinum, gold, silver and bronze tags to allow consumers to differentiate between goods and services in the building industry. After the application was examined, the applicant was informed that the series of trade marks applied for did not meet the requirements of s 51 of the Act. In that regard, the examiner accepted that the words platinum, gold, silver and bronze could be used to indicate levels of quality in relation to some services and products (as contemplated by s 51(1)(b) of the Act). However, on the evidence, the examiner found it impossible to determine that those words were quality statements in respect of the goods and services claimed. The applicant then sought a hearing of its application.

**Held**, opposition upheld, application dismissed:

(i) It was important to remember that the application was for a series of certification trade marks. For that reason, the trade marks were to be applied to quite a broad range of goods and services when they met the requirements of the relevant certification process: at [19].

(ii) It was clear on the evidence that the metal words were indicators of different tiers of a rating system for the goods concerned. It followed that four of the trade marks met the requirements of s 51 of the Act because they differed only in colour and in reference to a quality standard for the goods: at [22], [23].

(iii) Those four trade marks were, however, only four out of 32 representations for which the applicant had claimed a series. The remaining 28 representations contained material additional to those features already considered. It was thus not clear that those 28 representations complied with the requirements of s 51 of the Act: at [23].

(iv) The additional material in the other 28 representations meant that, in total, the 32 trade marks claimed on the application did not form a valid series as provided for by s 51. In order for the application to proceed, the applicant thus had to agree to amend its application to include a valid series: at [37].

(v) The applicant was to be allowed one month from the date of the decision to request amendment of its application so that it consisted of only one series. If the applicant failed to request amendment within the month allowed, the application was to be rejected: at [38].

*S Creighton and K Crow of Buchanan Law* for the applicant.

A Windsor (Hearing Officer).

### Background

[1] This matter concerns an application by Ecospecifier Pty Ltd (the applicant) for a certification trade mark filed under the provisions of the Trade Marks Act 1995 (the Act). The application was filed on 29 July 2010 for a broad range of goods and services in a total of 12 classes. It is for a series of trade marks, as provided for by s 51 of the Act, and the original application includes 32 separate trade marks. These trade marks are shown in full at the Annexure to this decision. However, the four trade marks upon which the full series is based are shown below:



[2] The application was examined as required by s 31 of the Act and the first official report advised the applicant that the series of trade marks applied for did not meet the requirements of s 51 of the Act. The examiner requested that the applicant restrict the application to a single trade mark and remove all reference to a series. She did point out that the words “platinum”, “gold”, “silver” and “bronze” can be used to indicate levels of quality in relation to some services. As the applicant has not provided the certification rules, she said, she was unable to determine whether these words were quality statements in respect of the goods and services claimed.

[3] The applicant responded providing detailed submissions in rebuttal and submitted a document entitled “Global Green Building Product LCA Rating Certification Program Standard” (the Program Standard).<sup>1</sup> The examiner reiterated that the trade marks applied for did not meet the requirements of s 51 as they did not resemble each other in material particulars and differed in ways not provided for by s 51. She made suggestions as to which combinations of trade marks would meet the legislative requirements and advised that in any event the application would be subject to a colour endorsement which specified the colours relevant to the chosen combination.

[4] The applicant asked to be heard and I was delegated to hear the matter in Canberra on 23 June 2011. The applicant was represented by Shaun Creighton and Kim Crow of Buchanan Law.

### Legislative framework

[5] Section 51 of the Act provides:

*Section 51. Application — series of trade marks*

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade

1. While this document sets out the program standards relevant to application of the certification trade marks, it does not appear to include the formal rules for use. Requirements for these rules may be found in para 3 of Pt 35 of the *Trade Marks Office Manual of Practice and Procedure*.

marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark.

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks;

he or she must register them as a series in one registration.

[6] Section 51 was amended in 2007 on proclamation of the Trade Marks Amendment Act 2006. The amendment made allowance for series applications to become multi-class applications and clarified the matter which would constitute an allowable series application. For comparison, the previous provisions were as follows:

*51 Application — series of trade marks*

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark;
- (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks;

he or she must register them as a series in one registration.

[7] Note that para 51(1)(d) did not transfer into the amended section. The matter allowable in a series since the amendment is thus arguably more restricted than it was previously.

### **Trade Marks Office practice**

[8] Office practice in determining the validity of a series of trade marks is set out in Pt 13 of the *Trade Marks Office Manual of Practice and Procedure* (the Manual). The following paragraphs from the relevant part of the Manual set the scene for the decision which I must make.

#### *2. Material Particulars*

Section 51 presents two areas for consideration in determining the validity of a series. Resemblance of material particulars is the first of the two considerations in determining the validity of a series application. The other consideration is whether the provisions of paragraphs 51(1)(a), (b) and (c) have also been met.

To qualify as a series the trade marks must first resemble each other in material particulars. That is, the identifying feature or features in each trade mark of the series must be essentially the same and any differences minor. In many cases the identifying feature/s entirely comprises the distinctive elements of the trade mark. However, it should be noted that in some cases descriptive/non-distinctive material can form part of the material particulars of a trade mark — particularly if its size and presentation within the trade mark are dominating features. Any differences between the material particulars must be such that they do not substantially affect the identity of the trade marks when each member of the series is compared to each of the others.

3. *Provisions of paragraphs 51(1)(a)(b) and (c)*

Subsection 51(1) provides the second consideration in determining the validity of a series.

The wording of subsection 51(1) emphasises that the trade marks in the series must differ only in respect of one or more of the ways specified in paragraphs (a), (b) and (c).

Subsection 51(1) places substantial restrictions on what sort of trade marks can form a valid series. It does this by specifying in paragraphs (a), (b) and (c) a narrow range of ways in which the trade marks can differ. It also requires that series trade marks differ only in respect of the ways specified. It does however allow the trade marks to differ in one or more of these ways.

This means that even if the material particulars resemble each other, the validity of a series will be quickly determined on the basis of whether differences between the trade marks are within those specified in the three paragraphs of subsection 51(1).

### Discussion and reasons

#### Material particulars

[9] This matter will largely be decided by a determination as to what constitutes the “material particulars” of the trade marks. The term “material particulars” is not defined in the Act, and finding a definition specific to trade mark practice presents some challenges.

[10] In criminal law a “material particular”, in relation an allegation that a statement is false or misleading, is a particular which is of significance and not trivial or inconsequential.<sup>2</sup> In respect of obtaining financial advantage via a false statement, the same source defines a “material particular” as an important particular or detail. The word “material” is defined as meaning important, essential or relevant.<sup>3</sup>

[11] The registrar’s delegate, in the *Swarmees* decision<sup>4</sup> discussed the meaning of “material particulars” and said:

I think, by its construction, the words “if the trade marks resemble each other in material particulars” within section 51(1) applies a threshold test that, if satisfied, allows the application of subparagraphs (a) to (d). At one level, the expression “material particulars” denotes that portion of the trade mark in which other traders, the public and the courts will regard the trade mark rights as residing. In other words, that part of the sign which has trade mark significance. On another level, the words “material particulars” denotes all of the component parts that contribute to the identity of the trade mark.

[12] A “material particular” in respect of a trade mark must therefore be a feature which is important, essential and non-trivial and which is also that portion of the trade mark likely to be recalled as being a trade mark. Paragraph 2 of Pt 13 of the Manual (quoted previously in [8] of this decision) defines “material particular” as the identifying feature or features of the trade mark. Deciding exactly what these features are is crucial to determining whether the series claimed in this matter is a valid series.

[13] Mr Creighton argued that the identifying feature of all the trade marks is “clearly the circular medallion device which dominates in size and presentation, sitting front and centre” of all the trade marks. Added to that, he said, to complete the identification of the trade marks are the words “ecospecifier global GREEN

2. *Encyclopaedic Australian Legal Dictionary*, provided online via LexisNexis.AU.

3. *Butterworths Concise Australian Legal Dictionary*, 1997, eds Dr Peter Nygh and Peter Butt.

4. *Application by Effem Foods Pty Ltd* [1999] ATMO 80.

TAG CERTIFIED”. I agree with Mr Creighton that these features form the “material particulars” of the trade marks, shown below in grayscale:



[14] I am of the opinion, contrary to that expressed by the examiner, that the colours within the trade marks are not material particulars of the trade marks, even though the representations on the application are coloured. Even when shown in grayscale, it is clear that the words and the medallion device form the memorable portion of the trade mark, and thus are the material particulars.<sup>5</sup>

***Paragraph 51(1)(c) — Colour***

[15] The next question to be answered is whether the various changes and additions to the material particulars of the trade mark meet the requirements of s 51 as it now exists. Paragraph 51(1)(c) specifies that the trade marks within a series may differ in respect of the colour of any part of the trade mark. The medallion devices in these trade marks contain two segments which are always shown in two different shades of green. Which segments are coloured green does not appear to have any effect on the overall recognition of the medallion device, and thus the material particulars of the trade mark. Therefore, the four versions of the trade marks where the remaining two sections of the trade marks shown at [1] (and appearing as pale grey in the image immediately above) are altered to a bronze, gold, silver or platinum colour do form an allowable series. The only change to the appearance of the trade mark is a change in the colour of two of the four divisions of the medallion device. **The material particulars of the trade mark have not been changed.**

***Paragraph 51(1)(b) — Representations as to quality***

[16] Paragraph 51(1)(b) makes allowance for the trade marks within a series to differ in respect of one or more of the following: statements or representations as to number, price, quality or names of places. The examiner queried the addition of the words BRONZE, SILVER, GOLD and PLATINUM (the metal words) stating that without seeing the rules for use of the certification trade marks, she could not determine if the words were statements as to quality in respect of all the goods and services claimed.

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5. This situation differs from that which would occur if the subject of the trade mark application consists of a colour or colour combination. In those cases, the colour/s claimed form the material particulars of the trade mark, and a change to the colour/s would mean there is a change to the material particulars of the trade mark.

[17] The question as to whether the quality statements are relevant to all the goods and services claimed has arisen as a result of the amendments to s 51. The previous version of the section allowed applications for series in a single class only, and within that class the goods/services were restricted to those regarded as similar to each other. As series applications may now be made in multiple classes, the reference to similar goods/services no longer exists. However, this may create another problem for the applicant.

[18] Paragraph 5 of Pt 3 of the Manual raises this matter and reads as follows:

5. *Restrict to Accord*

Series applications can be filed for a wide range of goods/services within a single class, or across multiple classes (Section 27). The nature of the goods/services claimed in these class/es may have a bearing on the validity of the series claim.

In deciding whether the material particulars of the trade marks in a claimed series resemble each other, it is important to consider the nature of the goods/services to which the trade marks are to be applied. For example, the trade marks IDAK TV and IDAK TELEVISION would represent a series in classes 9 and 38 if the goods and services claimed were items such as “televisions” and “television broadcasting”. In this example, the words TV and TELEVISION are statements as to the goods and services as provided for under paragraph 51(1)(a). However, the same could not be said if the goods also included items with which the words TV or TELEVISION had no connection, such as “fire extinguishers” or “facsimile transmission services”. Then the differences between the trade marks, namely the words TV and TELEVISION, would not be statements as to those goods or services. It should also be noted that if the trade marks were to be used on fire extinguishers or facsimile services, the difference between IDAK TV and IDAK TELEVISION would be a substantial variation in material particulars.

This type of consideration is highly likely to be relevant to many multiclass series applications because they provide the greatest potential for an applicant to claim a diverse range of goods and services. Such diversity reduces the likelihood of a valid series application where the trade marks differ in statements as to the goods or services.

In such cases, applicants will usually have to amend their goods or services to conform to the description within the trade marks in order to satisfy section 51.

[19] It is important to remember that this application is for a series of *certification* trade marks. The trade marks will be applied to quite a broad range of goods when they meet the requirements of the relevant certification process. How the certification process will function is set out in the Program Standard which the applicant provided to IP Australia after it had received the first official report.

[20] The relevant part of the document abstract reads as follows:

This Standard specifies environmental performance requirements of products under the ecospecifier Global Green Tag Ecolabel Program. The Global Green Tag Ecolabel program complies [with] ISO 14024: “Environmental labels and declarations — Guiding principles” which requires environmental labelling specifications to include criteria that are objective, reasonable and verifiable. All GreenRate Assessments also comply with AS NZS ISO 14021:2000, “Environmental labels and declarations — Type II Self declared environmental claims”.

[21] The scope of the document is described as follows:

This standard sets out essential rules under which the ecospecifier Global Green Tag Ecolabel Program will assess and certify products and its various elements in Australia and Internationally. This standard also establishes the sustainability indicators and procedures in awarding the label.

[22] It is clear from the document that the metal words are indicators of different tiers of a rating system for the goods concerned. They can thus be seen as an indicator of quality in that they identify the level of compliance with the certification standard applicable to any particular item in the goods/service specification. I am satisfied that the four trade marks shown in the first paragraph of this decision meet the requirements of s 51 of the Act as they differ only in colour and in reference to a quality standard for the goods.

[23] These four trade marks are, however, four out of 32 representations which the applicant has claimed as a series. The remaining 28 representations contain material additional to those features already considered. It is necessary now to determine whether any or all of this material meets the requirements of s 51.

*Is the word PLUS a reference to quality?*

[24] A number of the representations include the word PLUS and four of these are shown below:



[25] Paragraph 3.03 of the Program Standard describes the rating system as follows:

*Label Rating Tiers*

The 4 rating tiers from lowest to highest are Bronze, Silver, Gold and Platinum ....

PLUS: where the product has undergone a site-based, third party audited assessment process, by ecospecifier and an accredited third party agent, the Tier Award level achieved will be modified by the issuing of a Licence to use the "PLUS" recognition in addition to the Tier Award recognition on the label.

[26] Paragraph 4.9 further explains the PLUS level assessment:

*PLUS ratings*

PLUS level Assessment requires manufacturer and product specific audited life cycle inventory.<sup>6</sup> The LCI is required to be relevant to the applicant procedure and processes,

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6. Life cycle inventory — quantifying the energy and raw material inputs and environmental releases associated with each stage of production.

manufacturing plant/s, administrative procedures and/or supply chain as required by the Program Director to determine the compliance with this standard, the designator PLUS will be included in the rating award.

5 [27] The meaning of the preceding paragraph is not entirely clear, but it is sufficiently certain that I am able to see that the PLUS rating is a reference to another level of quality certification, in this instance to do with life cycle inventory. This further level appears to be additional to the metal word ratings, and appears to be an optional rating. Its presence in the representations does not have any effect on the material particulars of the trade marks or the identity of the trade marks. Under those circumstances I am satisfied that the four representations including the word PLUS form a series when added to the four representations shown in [1] of this decision.

*The GreenRate trade marks*

15 [28] The remaining 24 representations in the claimed series all contain additional features to those in the trade marks already discussed. These additional features are the expression “GreenRate” and the terms “Level A”, “Level B” and “Level C”.

20 [29] Mr Creighton submitted that the GreenRate level in the applicant’s trade marks is a specific indication of quality unique to the building industry. He said that it refers to the Ecospecifier product assessment which assesses a product’s compatibility to various Green Building Rating schemes, specifically the Green Star <sup>TM</sup> scheme in Australia and New Zealand. He said that the purpose of the GreenRate level ratings (levels A, B and C) is to describe the quality of the product to which the GreenTag will attach, and that they are descriptive of the product’s quality level.

25 [30] Paragraph 2 of the Program Standard explains the GreenTag program as follows:

30 Ecospecifier Global Green Tag is a voluntary, multi-criteria, tiered award, product rating conformance certification process and label that includes two components: an “LCARate component that assesses products using life cycle assessment processes and a “GreenRate” Assessment process directed at Certification within Green Building Rating Schemes in Australia and Internationally.

35 ...  
GreenTag is assessed using 2 pathways ...:  
a) The LCA Rate program is used for all product assessments to award the Green Tag Label;  
b) The GreenRate program is used in parallel to the LCA Rate pathway for products relevant to green building rating systems and is displayed independently within the GreenTag label.

40 [31] I can see that the GreenRate system is indeed a quality accreditation or certification system. But the word GreenRate is not a mere statement as to the quality of the goods. It is not a recognised quality indicator, such as the metal words or indeed the levels A, B and C which are added to it in the 24 trade mark representations. It is a reference to another quality assessment program quite apart from the basic systems already considered. It is thus a particular which falls outside the range of additions allowable in creating a series of trade mark.

50 [32] In addition, once Green Rate is added to the basic trade mark its material particulars change. They change from “Green Tag Certified + medallion” to “Green Tag Certified + medallion + GreenRate”. This change occurs because

GreenRate is arguably a registrable particular in its own right and has no obvious connection, without educating the public as to its purpose, with the other quality indicia which are applied to the certification services. While the addition of the metal words and the word “plus” can be seen as additions allowed for by the provisions of para 51(1)(b), the same cannot be said for GreenRate.

[33] This reasoning then brings me to the issue of which trade marks among the 32 provided on the application form can be regarded as valid series.

#### **Valid series**

[34] There are a number of valid series contained within the 32 representations provided with the application. The four representations shown in [1] of this decision form a valid series (SERIES 1). I have already defined a series of eight trade marks out of the 32 provided as forming a valid series. I will refer to these as SERIES 2, and they are as follows:



[35] The remaining 24 trade marks, all of which include the word GreenRate may be identified as SERIES 3. Rather than show them here, they may be found in the Annexure under the heading “GreenRate trade marks”.

[36] The separate series I have identified all include the four metal words as the basic quality indicators. It would be possible to form other groups of trade marks into series, but none of them would include all four metal words, and I make the assumption that these options would be even less likely to meet the applicant’s requirements than are the valid series I have identified.

[37] I have therefore found that the 32 trade marks claimed on the application do not form a valid series as provided for by s 51 of the Act. In order for the application to proceed, the applicant must agree to amend its application to include a valid series.

#### **Decision**

[38] I will allow the applicant 1 month from the date of this decision to request amendment of its application so that it consists of *one only* of SERIES 1, SERIES 2 or SERIES 3 as described above and to delete all other representations from the application. If the applicant fails to request amendment within the month allowed, I will reject the application.

[39] If the registrar is notified of an appeal from this decision before that time, any actions on the application shall not proceed until the appeal is discontinued, or in the case of orders issuing from the court, the registration will be subject to those orders.

5

**Annex 1**



**GreenRate trade marks**





ALEX DE COSTA  
SOLICITOR

**TRADE MARKS ACT 1995****DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS**

Re: Applications by Effem Foods Pty Ltd. For registration of applications 764121 and 720256.

*Background*

The above mentioned trade mark applications were filed on 5 June 1998 by Effem Foods Pty Ltd (the applicant) for registration of the proposed series of trade marks SWARMIES and SWARMEES in Classes 30 and 28, respectively, for the goods:

Rice, pasta; cereal and cereal preparations; tea, coffee, cocoa; coffee essences, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery; pastries, cakes, biscuits, ices, ice cream, ice cream products; frozen confections; chilled desserts, mousses, sorbets (ices); bread; pastry; sweet spreads, savoury spreads, snack foods, prepared meals, chocolate, chocolates, chocolate products, sauces; pizzas, pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise; dips; all included in class 30

Games, toys and playthings all being goods in class 28

The examiner objected that the trade marks SWARMIES and SWARMEES do not constitute a series in terms of section 51 of the *Trade Marks Act 1995*. Thereafter, the legal representatives of the applicant made submissions that the trade marks do constitute a series. After several exchanges of correspondence, and following a review of the applications, the Trade Marks Office wrote to the applicants in the following terms:

In view of the impasse that has been reached in the examination of this trade mark, the Deputy Registrar, as per the provisions of Regulation 21.15(3), will be setting these two trade mark applications down for hearing in Sydney at the July session.

Your attention is respectfully directed to item 20 of the fees schedule. This specifies that attendance at a hearing requires a fee of \$300.

The hearing was on 13 July 1999 - the applicant was represented by Mr Brett Doyle of solicitors Baker & McKenzie.

*The submissions*

As Mr Doyle's submissions centred on the correct interpretation of section 51, it is convenient to copy that section into my reasons here:

**Application—series of trade marks**

**51.(1)** A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark;
- (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.

**(2)** If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required (under section 68) to register the trade marks; he or she must register them as a series in one registration.

Mr Doyle's submissions focussed on the correct interpretation of the words 'material particulars' in subsection 51(1) and the linguistic approach to the assessment of the trade marks as series by the examiner.

Mr Doyle proposed that there are two tests under section 51: the first test is whether the two trade marks resemble each other in material particulars and secondly, whether the two trade marks differ under any matter apprehended by subparagraphs (a) to (d) - here, Mr Doyle submitted, the relevant subparagraph is (d). Mr Doyle submitted that frequently the considerations as to what constitutes a "material particular" and assessment of "any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks" under subparagraph (d) have wrongly become conflated. Thus, he argued, the tests of the latter have become wrongly applied to the former, or a conclusion as to the latter becomes exported to the former.

Mr Doyle observed that he is not aware of any case-law that has considered the correct interpretation of the expression "material particular". Mr Doyle suggested that it would be illogical for the two expressions to mean the same thing and that therefore it is illogical to

state that because the two trade marks have differing identities, they can't resemble each other in their material particulars.

Mr Doyle submitted that, in his opinion, what constitutes a material particular is those separately identifiable parts of a trade mark which contribute to its overall look and distinctiveness. This is most true, he says, when the trade mark is composed of a number of different components such as a word and device and other part, all contributing to the trade mark's look. In this instance, Mr Doyle said, there is only one "material particular" - that is the word SWARMIES, however it might be spelt.

As I understand Mr Doyle's submission, he believes the expression "material particular" to embrace all of the essential elements of the trade mark as are likely to be recalled by members of the public and other traders. Accordingly, the way in which trade marks are indexed by the Trade Marks Office for the purposes of the Constituent Particulars Index (CPI) might offer some guidance.

Applying these submissions to his client's case, Mr Doyle argued that his client's trade marks consist of the one material particular - the word SWARMIES - however it is spelled. Mr Doyle referred me to the *Lynson* case - *Re Lynson Australia Pty Ltd* (1987) 9 IPR 350 where the delegate moved straight to her reasons under subparagraph 39(1)(c) of the *Trade Marks Act 1955*, the equivalent of subparagraph 51(1)(d) of the *Trade Marks Act 1995*. This approach, Mr Doyle suggested, is not the correct one since the delegate assumed that the two material particulars were the same.

Mr Doyle stressed that the use of the word "resemble" in section 51(1) leads to a conclusion that there does not need to be a shared identity between the trade marks being considered as a series. Accordingly, the Act allows for some difference between the trade marks.

Mr Doyle went on to give an example of a series application that had been allowed as such, but he thought did not properly qualify as a series. In deference to his client, I use the example UNICORN and UNICORN MUSICAL for which the services are specified as being entertainment in Class 41. Mr Doyle said that he regards the two trade marks as not being a proper series since the word MUSICAL was a material particular that contributed to the identity of the trade mark.

Mr Doyle finalised his submissions by arguing that if I were to apply subparagraph 51(1)(d), his client's trade marks, according to the usual tests, still qualified as a series.

### *Reasons*

I initially observe that the trade marks on the two applications do not constitute a series as the goods of each application fail the basal test under section 51(1) of being 'similar goods'. For example, the expression 'games, toys and playthings' in the Class 28 application comprehend both 'hand-held electronic games' and 'ride-on toys for children' -these are not similar goods. Similarly, the Class 30 specification includes both confectionary chocolates and savoury spreads, which are not similar goods. While it has been the Registrar's practice to allow some latitude at examination as regards the strict application of this provision, I feel that a delegate of the Registrar at a hearing of a matter is in a position where that delegate is expected to observe the provisions of the Act very closely.

### *Material Particulars*

I think, by its construction, the words "*if the trade marks resemble each other in material particulars*" within section 51(1) applies a threshold test that, if satisfied, allows the application of subparagraphs (a) to (d). At one level, the expression 'material particulars' denotes that portion of the trade mark in which other traders, the public and the courts will regard the trade mark rights as residing. In other words, that part of the sign which has trade mark significance. On another level, the words 'material particulars' denotes all of the component parts that contribute to the identity of the trade mark. In the example given above, UNICORN MUSICAL, the rights of a registered proprietor are obviously strongest in the word UNICORN - this is the word on which most of the focus will lie in a comparison of the trade mark with pre-existing registrations, the purchase of the services in the market-place, consideration of an (allegedly) potentially infringing trade mark, an examination for registrability, or the results of a search of the Register. This interpretation of section 51 allows a resemblance between the material particular, UNICORN, and for the trade marks to differ only in respect of descriptive matter falling within that referred to by subparagraph 51(1)(a) - that descriptive matter being here the word MUSICAL. However, again following the above example, an application for the registration of the series UNICORN and UNICORN STARQUEST in Class 41 should meet an objection that the marks are different in their material particulars as the word STARQUEST has trade mark

potential. As the word has trade mark potential, it has become a material particular for the purposes of the Act and the application therefore fails the threshold test imposed within section 51. In that instance, it therefore fails that, although the application may otherwise qualify as a series under subparagraph 51(1)(a), because of the descriptive flavour of the word STARQUEST, it has failed the threshold test under subsection 51(1) in that the word STARQUEST has trade mark potential and is therefore a material particular.

In the words of the Chief Assistant Registrar in *Re Lynson Australia Pty Ltd* (1987) 9 IPR 350 (regarding section 39 of the *Trade Marks Act 1955* - the equivalent of section 51 of the *Trade Marks Act 1955*):

(T)he statements or representations referred to by s 39 (1) (a) and (b) must be such that they do not contribute to the function that the mark has in distinguishing the proprietor's goods from those of other traders. They must be clearly and unambiguously separate from those features of the mark by which it, and the goods or services which it identifies, will be known.

It is unstated in her decision, but effect of a contribution to the function that the trade mark has in distinguishing the owners goods or services from those of other traders, is that the trade marks no longer resemble each other in their material particulars.

This threshold test, while it is straightforward to apply in the above example, is somewhat more complex in relation to postulated series that are composed of single word trade marks. To explain the problems involved with these trade marks, it is necessary to approach the problem in a somewhat oblique manner.

Section 41 of the *Trade Marks Act 1995* allows a different standard of registrability to that imposed by section 24 or 25 of the *Trade Marks Act 1955*. As explained by Justice Branson in *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, the assessment of combined effects of inherent adaptation and the extent of use of a trade mark has changed - this allows the registration of trade marks which may have previously been viewed as being unregistrable. Accordingly, what might be viewed as being registrable as a trade mark has been broadened. It follows that what might be regarded as being a material particular for the purposes of section 51(1) of the Act has also broadened.

To give some examples. Although generic words might encounter the same difficulties as being regarded as trade marks under both the *Trade Marks Act 1995* and the *Trade Marks Act 1955*, the phonetic equivalents of those words do not. The words TRACTOR and TRACTA are phonetic equivalents of each other; both the former and the latter would encounter very similar difficulties being registered under the Old Act for agricultural machinery. However, under the New Act, grounds for rejection of the word TRACTOR would lie in subsection 41(6) and to the word TRACTA in subsection 41(5). As the difference between the words is such that rejection would occur under different subsections of the Act, it must follow that the words TRACTOR and TRACTA do not resemble each other in material particulars.

Over and above the principles expressed by Lloyd-Jacob J in *Re Morny Ltd's Trade Marks* [1951] 68 RPC 55 (where the rendering of a word is sufficient to alter the identity of the trade mark), it is possible that the particular get-up of a trade mark may also result in an objection existing under subsection 41(5) rather than under subsection 41(6) and that therefore the trade marks involved are different in their material particulars. This observation accords with the views of the Chief Assistant Registrar in *Re Lynson Australia Pty Ltd* (1987) 9 IPR 350 where she remarked:

The typescript may be varied, but only between known, conventional scripts, not fanciful get-up.

Similar caution should be sounded concerning 'the names of places' as these are more readily viewed as being registrable under the New Act and hence qualifying as a material particular. If the name of a place has potential trade mark significance (such as OXFORD, MICHIGAN or OREGON), its presence as the variable in a series application should result in the application meeting an objection that the trade marks are different in their material particulars. If such an objection is not reached during the course of examination, it is because the geographical indicia has been viewed as having no potential trade mark significance and that the trade marks otherwise resemble each other in their material particulars - hence passing the threshold test and subsequently qualifying under section 51(1)(b).

Again, if any part of a trade mark assumes such dominance in one of a proposed series of trade marks that it achieves the status of being a material particular, it should fail the threshold test, irrespective of whether the element qualifies under subsections 51(1)(a) to (d).



Under the above referred to sections of the relevant Acts, cases where substantial identity has been found include: *Kendall Co v Mulsyn Paint & Chemicals* (1963) 109 CLR (POLYKIN and POLYKEN); *Seven Up Company v O.T. Ltd* (1947) 75 CLR 203 ('7UP in a circle' and '8UP in a square'); *Pelican Trade Mark* [1978] RPC 424 (PELICAN and PELIKAN); *Pelikan International Handelsgesellschaft Mbh & Co Kg v Lifinia Pty Ltd* (1994) 30 IPR 615 (PELICAN and PELIKAN); *Shachihata Industrial Co Ltd v Magic Marker Corp* (1984) 3 IPR 519 (LIQUID CRAYON and LIQUID CRAYONS); *Re Applications By Stratco Metal Pty Ltd* (1984) 4 IPR 48 (CLICKFAST and KCLICK-FAST); *Michael Sharwood & Partners Pty Ltd And Others v Fuddruckers Inc* (1989) 15 IPR 188 (FUDRUKKERS and FUDDRUCKERS); *Re Application By Jacuzzi Inc* (1990) 17 IPR 414 (AERO and AEROSPA - on spa equipment); *Re Application By Fastrack Racing Pty Ltd* (1994) 29 IPR 193 (FASTRACK and FAST TRACK); *Sportcraft Consolidated Pty Ltd v General Sportcraft Co Ltd* (1993) 27 IPR 74 (SPORTCRAFT and SPORTSCRAFT); *Alexander v Tait-Jamison* (1993) 28 IPR 103 (ECO-FARM and ECO-FARMS); *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994) 120 ALR 495 (FUNSHIP and FUN SHIP); *Warner-Lambert Co v Harel* (1995) 32 IPR (DERMOFILM and DERMAFILM); and *Bull SA v Micro Controls Ltd* (1990) 19 IPR 299 (MICROL and MICRAL). In these decisions, the trade marks involved have been found to be 'substantially the same mark' to quote D.R. Shanahan in *Australian Law of Trade Marks and Passing Off*, or, as Justice Gummow referred to it, 'substantially identical' in *Carnival Cruise Lines*, supra.

To contrast the above decisions, the following trade marks have been found to be neither 'substantially the same mark' or 'substantially identical': "*Otrivin*" Trade Mark [1967] RPC 613, (OTRIVIN and OTRIVINE); *Lonza Ltd v Kantfield Pty Ltd (T/A Martogg & Co)* (1995) 33 IPR 396 (FORTEX and FOREX); *Photo Disc Inc v Gibson And Another* (1998) 42 IPR 473 ('PHOTO-DISK' - with descriptive phrase and arabesques and PHOTODISC), although in the latter decision, the delegate observed that if the trade marks had been PHOTO-DISK and PHOTODISC, solus, she would have found that the trade marks were substantially identical.

#### *Phonetics of material particulars where there are no other variables*

In trade marks where there are single words which are proposed as a series, they most obviously will be a series if these are recognised in English dictionaries as being alternative spellings of English words having the same meaning. Examples of such words are DISC

and DISK, SULFUR and SULPHUR, CIPHER and CYPHER, PHANTASM and FANTASM, PROGRAM and PROGRAMME.

Most American spellings, which are recognised in American dictionaries, of English words, such as COLOR, CENTER, or SYMPATHISE would also qualify as being a series. However, more informal Americanisms such as THRO (for THROUGH) or SOX (for SOCKS) should not. This is because the immediate connection of the informal phonetic to the word from which it is derived may not be apparent, thus, a mental step is needed to conclude that the words could be equivalents, and so the identity is not shared.

Some other phonetic equivalents may be allowed as series where the material particular is a single word, but the variation (both visual and aural) should be so trifling as not to affect the identity of the material particular. Thus, the shared identity must be both immediately apparent and follow normal rules of English construction. In regard to the aural identity of the trade marks, I note that the *Trade Marks Act 1995* incorporates a definition which provides:

7(2) To avoid any doubt, it is stated that, if a trade mark consists of the following, or any combination of the following, namely, any letter, word, name or numeral, any aural representation of the trade mark is, for the purposes of this Act, a use of the trade mark.

I believe that while the provision obviously has implications concerning the aural use of phonetically similar or identical trade marks, its impact on my considerations is limited by the fact that the Registrar, or his delegates, considers the graphical representations of trade marks.

*Subparagraph 51(1)(d)*

This subparagraph deals with one of the categories of variables allowed under section 51 and provides for the variable:

(d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.

While Mr Doyle argued that the tests under this subparagraph had been conflated to that of what might constitute a material particular, and that as the two provisions could not mean the same thing, 'material particular' should be read broadly, I consider this not to be so. I think

that the subparagraphs must all be read as allowing for a variable, or variables, within a series of trade marks in matter other than the material particular itself. In the *Lynson* decision, *supra*, the variable fell under this heading as it was the underscoring of the word LYNSON by a line. Thus, if the material particular is a single word and there is no other variable word or feature in the trade mark, one does not go on and apply the provisions of subparagraph 51(1)(d) - however, as it turns out, the tests that are applied are identical to those within that subparagraph. In effect, then, subparagraph 51(1)(d) operates as a catch-all to encompass matter extraneous to the material particular that is not caught by subparagraphs 51(1)(a) to (c).

### *Swarmees and Swarmies*

I think that these words are very much at the *Otrivine*, *supra*, end of the scale as far as substantial identity is concerned. I acknowledge Mr Doyle's concerns as far as a linguistic or academic approach to the assessment of these trade marks, however perceptions of these trade marks are to be governed by an application and understanding of the English language and how it functions.

I can put it now more simply than the fact that the word SWARMIES appears to be a pluralisation of the word SWARMY and the word SWARMEES does not. SWARMEES immediately suggests to me 'someone who, or something that, has been swarmed' (even though this is nonsensical). While I acknowledge that the use of the word SWARMY is rare, even if both it and the instant trade marks were to be regarded as invented words, it is appropriate to assess them in the light of the usual construction and normal rules of the English language since this is what governs our perceptions and discourse.

Another view is that if the words SWARMIES and SWARMEES are regarded as being invented words, both (although having a close similarity) have been invented differently and are of different construction. They do not therefore share a substantial identity and therefore are different in their material particulars.

In the event that I am wrong in my application of section 51 and in my assessment that these marks as being different in their material particulars, they fail for the same reasons under subparagraph 51(1)(d).

*Decision*

I thus find that the trade marks SWARMIES and SWARMEES are not a series of trade marks as they are not substantially identical. They also fail in their claim since the specifications are not for similar goods. I therefore allow the applicant one month from the date of this decision to delete a mark from both applications in order to put them in order for acceptance. If no such request is forthcoming, I will refuse the applications.

Ian Thompson  
A/Hearing Officer

26 July 1999

## Re LYNSON AUSTRALIA PTY LTD

### Trade mark application — LYNSON

S FARQUHAR (Chief Assistant Registrar)

24 February 1987

### Trade marks — Application to register a series of marks — What constitutes — Trade Marks Act 1955 (Cth) s 39(1)(c).

The applicant sought registration of a series of two marks, the word “Lynson” in plain type and the word “Lynson” in a fancy design. The examiner objected to acceptance of the applications on the grounds that the marks did not constitute a series of marks within the meaning of s 39(1) of the Trade Marks Act 1955 as they were substantially different marks.

The applicant argued that the variation in the get-up of the marks did not render them distinctive and did not substantially affect the identity of the marks.

**Held:** (i) The essential element of each mark was the word “Lynson” and the variations were not distinctive nor did they add anything extra to the identity of the mark.

(ii) The applications were therefore clear to proceed to acceptance under s 39.

### Application

The examiner objected to an application for registration of a series of marks and the applicant requested a decision on the written record.

**S Farquhar** (Chief Assistant Registrar). These applications were lodged by Lynson Australia Pty Ltd, a Victorian company, on 9 August 1984. They seek to register a series of two trade marks in Pt A of the register in respect of all goods in Class 28 (413212) and all goods in Class 25 (413213). The only outstanding objection to registration is one taken in terms of s 39(1) of the Act, to the effect that the two marks do not constitute a series, being substantially different marks. In the face of the examiner’s refusal to withdraw this objection, the applicant’s attorney requested a decision on the written record.

Section 39 provides for a single registration of several marks in the following terms:

“(1) Where a person who claims to be the proprietor of several trade marks for the same goods, for goods of the same description within a single class, for the same services or for services of the same description within a single class seeks to register those trade marks and the trade marks, although they resemble each other in material particulars, differ in respect of —

- (a) statements or representations as to the goods or services in respect of which the trade marks are used or proposed to be used;
- (b) statements or representations as to number, price, quality or names of places;

- (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
- (d) colour,

5 or in respect of any 2 or more of those matters, the trade marks may be registered as a series in 1 registration."

The series of marks here under consideration consists of the word "Lynson" rendered as shown below:

10 

15 As there is nothing in either form of the mark coming within s 39(1)(a), (b) or (d), the applicant's claim is based on the provisions of s 39(1)(c). The variation in get-up of the marks is, in the applicant's submission, not distinctive and does not substantially affect the identity of the marks.

20 There is little or nothing in the way of precedent case law related directly to the interpretation of s 39. However, ss 21, 42 and 127 contain the same form of words relating to substantial alteration of the identity of the mark, and, particularly in relation to s 21, there is a substantial amount of relevant law. The treatment of this topic by D R Shanahan in his *Australian Trade Mark Law and Practice*, at p 220, is also useful.

25 Consideration of the principles enunciated in cases such as *British Hoist and Crane Co Ltd's Trade Mark* (1965) 72 RPC 66, "*Otrivin*" *Trade Mark* (1967) 84 RPC 613, "*Pelican*" *Trade Mark* [1978] RPC 424 and *Morny Ltd's Trade Marks* (1951) 68 RPC 55 enable some general guidelines to be defined for the assessment of what constitutes a substantial alteration of the identity of a mark. These may then be used to decide what may or may not constitute a series of marks in terms of s 39(1)(c).

30 Briefly, and only in general terms, the variation between members of a series must be such that no additional element or dimension is contributed thereby to the overall identity of the marks; the "idea" of the mark must remain the same. If the marks consist of a word, then that word must be the only element in the identity of each member of the series. The typescript may be varied, but only between known, conventional scripts, not fanciful get-up. The spelling may be varied, but only if the pronunciation and meaning remain unaffected. The separation of one word into two, or the running together of two words would be governed by the same considerations: the sound and meaning must remain the same. The appearance of the word or words must also be taken into account when the spelling or physical arrangement of the letter is varied. Minor changes (such as "pelican" and "pelikan" or "fastfoto" and "fast-foto", will be acceptable where more extensive ones will not (eg "tablet" and "tabblett" or "tab-let", "ta-blet" and "tabl-et").

45 It is obvious that the addition of a device element to a word mark would, in almost all cases, constitute a substantial alteration to its identity, the only exception being the simplest of conventional embellishments, contributing nothing of distinction to the mark as a whole.

Similarly, the statements or representations referred to by s 39(1)(a) and (b) must be such that they do not contribute to the function that the mark has in distinguishing the proprietor's goods from those of other traders. They must be clearly and unambiguously separate from those features of the mark by which it, and the goods or services which it identifies, will be known. It is of no assistance that the additional matter is disclaimed, since disclaimed matter may still contribute to the overall identity or "idea" of the mark.

It is appropriate to note in this connection that a test based on whether or not association of marks the subject of a series application would be required if they were separate applications is not conclusive for qualification as a series. The possession of a common distinctive feature may warrant association between marks which nevertheless are not substantially identical, but which, if used by a person other than the proprietor, would be likely to deceive or cause confusion.

Returning now to the series of marks being considered here, and applying the above guidelines, I am of the opinion that the two marks do indeed satisfy the requirements of s 39(1)(c). The essential element of each mark is the word "Lynson"; the variation in typescript is not distinctive, being from ordinary block capitals to a thicker and slightly rounded lower case script with an incomplete underline which contributes to the overall "chunkier" effect of this printing. I do not consider that this variation contributes anything extra to the identity of the mark. The applications are therefore clear to proceed to acceptance in Pt A of the Register under the provisions of s 39 of the Act.

Patent Attorneys for the applicant: *Phillips, Ormonde & Fitzpatrick.*

ANN DUFTY  
SOLICITOR

**From:** [Tony Lolis](#)  
**To:** [Bogdan Mitic](#)  
**Cc:** [John Braybrooks; TMDG Quality Practice & Customers](#)  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL]  
**Date:** Wednesday, 24 November 2021 5:14:56 PM  
**Attachments:** [image001.png](#)  
[image002.jpg](#)  
[image003.png](#)  
[image004.png](#)  
[image005.png](#)  
[image006.jpg](#)  
[image007.jpg](#)  
[image008.png](#)  
[image009.png](#)  
[image010.png](#)

---

Dear Bogdan,

My contact number is 0401 055 044.

Thank you.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Wednesday, 24 November 2021 4:35 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]

**OFFICIAL**

Dear Tony,

The interpretation and application of Section 51 I have outlined is the conclusion we have reached after deliberating the wording of the legislation and the commentary available on series trade marks. If you disagree with this interpretation, I invite you to provide submissions with references to relevant court cases or hearings decisions to support your view.

I realise you believe some series SMEs may have taken a more lenient approach in the past. I am not sure whether this is true or not, but our practice needs to be based on a proper understanding and interpretation of the law. To this end, as previously mentioned, we are currently in the process of reviewing chapter 13 of the Manual and will be working with our series SMEs to create content that will clearly explain what constitutes a valid series and what examiners need to assess in terms of both material particulars and differences in statements of goods.

Regarding your request for consideration from an SME, I passed on your contact information to an SME who attempted to contact you but was unable to reach you. You should however be aware, while you are welcome to speak to an SME, any progress with this application will need to be in accordance with the interpretation of section 51 I have detailed in our previous correspondence.

Alternatively, if you are seeking an avenue for further escalation, you are welcome to request to be heard on this matter.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



P 02 6283 2600 | E [Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)  
Visit us at <http://www.ipaustrialia.gov.au>

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**From:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Sent:** Wednesday, 24 November 2021 11:10 AM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

Thank you for your email.

Your comments seem to represent a significant departure from long standing Office practice. Moreover your logic seems difficult to follow and your "valid" example difficult to reconcile noting that the relevant legislation remains unchanged.

Can I please reiterate my earlier request, namely that the subject application be considered by a series trade mark SME and that the SME call me to discuss the this application further.

Kind regards

Tony

**Tony Lolis**  
Senior Trade Mark Counsel



Davies Collison Cave Pty Ltd  
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---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Thursday, 11 November 2021 5:51 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]

**OFFICIAL**

Dear Tony,

Thank you for getting in touch.

**Subject matter expertise**

I work in the Quality, Practice, and Customers section. This section is responsible for setting examination practice, including examination of series applications. This section is also responsible for the subject matter expert program and escalations from examiners and subject matter experts are directed to our section to resolve when questions about the correct interpretation and application of law arise.

**The Manual**

We are in the process of reviewing Part 13 and will be addressing the content, including the examples in your email, to ensure no such misunderstandings occur in future.

**Subsection 51(1)(a) of the *Trade Marks Act 1995 (Cth)* and the validity of a series applications**

About the interpretation of subsection 51(1)(a), I am happy to provide further clarification regarding our conversation. For something to be a statement as to the goods or services it must be a reference for the gamut of goods and/or services claimed. If this is not the case, this element becomes a material particular and is not a statement as to the goods for the claims where it has no relevant meaning. As a result the material particulars across representations would not resemble one another, nor would the differences fall within those provided for by subsection 51(1)(a). To illustrate this point, consider the following example:

Invalid

Example 1	Class 29 claim for <i>beef</i> Class 30 claim for <i>ice cream</i> IDAK BEEF IDAK ICE CREAM
-----------	--

Ice cream is a statement of goods for ice cream but has no meaning relevant to beef, and in turn:

- a) forms a material particular not present in the IDAK BEEF representation, resulting in a situation where the representations do not resemble each other in material particulars; AND
- b) is not a statement as to the goods and therefore differs in a way not provided for by

subsection 51(1)(a).

As such, example 1 would not constitute a valid series even though both may be food products.

#### Valid

An example of a valid series as per subsection 51(1)(a) would be as follows:

Example 2	Class 29 claim for <i>meat</i> IDAK BEEF IDAK LAMB
-----------	--

As beef and lamb are both meats, they:

- a) are not material particulars; AND
- b) are statements as to the goods and differ as provided for by subsection 51(1)(a).

In example 2 the series application is valid because the representations resemble each other in materials particulars and differ only as to the statements of goods.

The effect of subsection 51(1)(a) when applied correctly is that as the number of representations and claims in the specification increase, so too does the likelihood that the application will not constitute a valid series unless great care is taken in the way the application is drafted.

#### **Prior registrations and series examination practice**

As for what you have coined as the “Cranberry statement”, when IP Australia identifies issues, especially issues in the interpretation and application of law, we ensure those issues are corrected so that we can provide applicants with valid and robust IP rights. The correct assessment of whether a series application is valid depends on the language of section 51 of the *Trade Marks Act 1995* (Cth), not on what has been done previously, nor what the manual says. The Manual is a guide to practice and procedure and it does not override legislation or case law that comes to a contrary decision. I refer you to the Federal Court’s comments in *Beling v Sixty International S.A.* [2015] FCA 250 (20 March 2015):

*“References were made by both parties in submissions to the Trade Marks Office Manual of Practice and Procedure, and what was said in that manual about the award of costs. There does not appear to be any statutory power in the Act to issue such a manual and it is clearly no more than a set of administrative guidelines.”*

The above interpretation of section 51 has been confirmed with the Oppositions and Hearings section and with senior colleagues. Should you still have concerns or feel the need for further escalation you are welcome to request to be heard regarding this application. Alternatively, I am happy to assist you in coming up with an amendment that would allow for this application to proceed to acceptance.

Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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Visit us at <http://www.ipaaustralia.gov.au>

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**From:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Sent:** Wednesday, 10 November 2021 12:53 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

At the outset, thank you for taking the time to discuss this application and series trade marks with me.

I acknowledge your position within the Office but I ask if you are also a Subject Matter Expert (SME) as it pertains to series trade marks. I have asked for a reconsideration by an SME. I believe that I am entitled to do so, and note that typically series trade marks are assigned to an appropriate SME. I have filed several over the years and these have been considered by a select group of examiners.

If you are an SME in this space, I assume that you have experience in dealing with series trade marks. If so can you please point out which series trade mark applications you have examined previously?

I ask this because during the course of our discussions various statements were made which for lack of a better term "was news to me".

As far as I understand it, and please correct me if I am wrong, you indicated that an Applicant is required to use every iteration of the series trade mark on all claimed goods. I have never come across this concept before and find it completely illogical in the context of series trade marks that are linked by a **statement or representation as to the goods or services in relation to which the trade marks are to be used**. For example, even looking at the guidance provided in the Manual and the examples of valid series trade marks (I set these out below) why would a trader use IDAK SLIPPERS in relation to shirts and why are they required to do so?

This then leads me to the second statement which I was quite frankly surprised with and more so the logic behind it. If I understand it correctly, your concern is that at some point in a series trade mark application, the statement or representation as to the goods becomes distinctive of some of the claimed goods. If this is the case, why would the Manual list the following as examples of valid series trade marks. Surely you must concur that the word HATS is distinctive of say shirts or FOOTWAER of clothing yet these are clearly examples of valid series trade marks. Following your logic through, an argument could be made that a series trade mark can never be based as on a **statement or representation as to the goods** because at some point and probably beyond the point of the actual product itself, the descriptor becomes distinctive (ie Hats on Shirts).



I have already raised my concerns with the wine variety example we discussed. As I have mentioned, this type of series trade mark application where the statement is directed to a well-known type of wine (ie shiraz, riesling, rose etc) has always been allowed. You have indicated to me that this is wrong because shiraz is descriptive of a type of red wine but distinctive of a white wine so this is should not be a valid series. If I follow your logic through to its conclusion, shiraz is arguably distinctive when used in the context of a merlot, pinot or cabernet sauvignon also.

In essence your logic, at least as I understand it, seems to erode the applicability of section 51(1)(a) entirely.

I am also concerned with what I will call the "Cranberry Statement": "just because the Office has done it previously doesn't mean that it is right". With the greatest of respect, it seems to me, at least based on previous outcomes and having regard to the commentary in the Manual that you are perhaps reimagining the applicability of section 51(1)(a).

I now return to my initial request, that this application be considered by an SME familiar with series trade marks. If you are not an SME can you please direct my request to an appropriate examiner so I can progress this further.

I am more than happy to discuss this with you.

Kind regards,

**Tony Lolis**

Senior Trade Mark Counsel



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---

**From:** Tony Lolis  
**Sent:** Monday, 8 November 2021 3:15 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

Here is a recent registration which supports my arguments:  
<https://search.ipaustralia.gov.au/trademarks/search/view/2012061?s=2104d02a-2ee1-4005-8cec-1ef898be4366&p=4> .

This in my experience has always been a valid type of "series applications".

Kind regards

Tony

**Tony Lolis**  
Senior Trade Mark Counsel



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1 Nicholson Street  
Melbourne, VIC 3000 AUSTRALIA

T +61 3 9254 2777  
E [TLolis@dcc.com](mailto:TLolis@dcc.com)



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---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 12:34 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Subject:** 2208391 MUM'S [SEC=OFFICIAL]

**OFFICIAL**

Hello Mr. Lolis,

I am informed you would like to discuss the objections raised on this application.

I am more than happy to discuss these with you.

You can reach me on (02) 6283 2600 at your earliest convenience.

Regards,

Bogdan Mitic

Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



P 02 6283 2600 | E [Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)  
Visit us at <http://www.ipaustralia.gov.au>

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**From:** [Bogdan Mitic](#)  
**To:** [Tony Lolis](#)  
**Cc:** [John Braybrooks](#); [TMDG Quality Practice & Customers](#)  
**Subject:** RE: 2208391 MUM"S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]  
**Date:** Thursday, 11 November 2021 5:50:00 PM  
**Attachments:** [image005.png](#)  
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[image012.png](#)  
[image013.png](#)  
[image014.png](#)

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**OFFICIAL**

Dear Tony,

Thank you for getting in touch.

**Subject matter expertise**

I work in the Quality, Practice, and Customers section. This section is responsible for setting examination practice, including examination of series applications. This section is also responsible for the subject matter expert program and escalations from examiners and subject matter experts are directed to our section to resolve when questions about the correct interpretation and application of law arise.

**The Manual**

We are in the process of reviewing Part 13 and will be addressing the content, including the examples in your email, to ensure no such misunderstandings occur in future.

**Subsection 51(1)(a) of the *Trade Marks Act 1995 (Cth)* and the validity of a series applications**

About the interpretation of subsection 51(1)(a), I am happy to provide further clarification regarding our conversation. For something to be a statement as to the goods or services it must be a reference for the gamut of goods and/or services claimed. If this is not the case, this element becomes a material particular and is not a statement as to the goods for the claims where it has no relevant meaning. As a result the material particulars across representations would not resemble one another, nor would the differences fall within those provided for by subsection 51(1)(a). To illustrate this point, consider the following example:

Invalid

Example 1	Class 29 claim for <i>beef</i> Class 30 claim for <i>ice cream</i> IDAK BEEF IDAK ICE CREAM
-----------	--

Ice cream is a statement of goods for ice cream but has no meaning relevant to beef, and in turn:

- a. forms a material particular not present in the IDAK BEEF representation, resulting in a

situation where the representations do not resemble each other in material particulars; AND

- b. is not a statement as to the goods and therefore differs in a way not provided for by subsection 51(1)(a).

As such, example 1 would not constitute a valid series even though both may be food products.

#### Valid

An example of a valid series as per subsection 51(1)(a) would be as follows:

Example 2	Class 29 claim for <i>meat</i> IDAK BEEF IDAK LAMB
-----------	--

As beef and lamb are both meats, they:

- a. are not material particulars; AND
- b. are statements as to the goods and differ as provided for by subsection 51(1)(a).

In example 2 the series application is valid because the representations resemble each other in materials particulars and differ only as to the statements of goods.

The effect of subsection 51(1)(a) when applied correctly is that as the number of representations and claims in the specification increase, so too does the likelihood that the application will not constitute a valid series unless great care is taken in the way the application is drafted.

#### **Prior registrations and series examination practice**

As for what you have coined as the “Cranberry statement”, when IP Australia identifies issues, especially issues in the interpretation and application of law, we ensure those issues are corrected so that we can provide applicants with valid and robust IP rights. The correct assessment of whether a series application is valid depends on the language of section 51 of the *Trade Marks Act* 1995 (Cth), not on what has been done previously, nor what the manual says. The Manual is a guide to practice and procedure and it does not override legislation or case law that comes to a contrary decision. I refer you to the Federal Court’s comments in *Beling v Sixty International S.A.* [2015] FCA 250 (20 March 2015):

*“References were made by both parties in submissions to the Trade Marks Office Manual of Practice and Procedure, and what was said in that manual about the award of costs. There does not appear to be any statutory power in the Act to issue such a manual and it is clearly no more than a set of administrative guidelines.”*

The above interpretation of section 51 has been confirmed with the Oppositions and Hearings section and with senior colleagues. Should you still have concerns or feel the need for further escalation you are welcome to request to be heard regarding this application. Alternatively, I am happy to assist you in coming up with an amendment that would allow for this application to proceed to acceptance.

Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group

IP Australia



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Visit us at <http://www.ipaustrialia.gov.au>

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**From:** Tony Lolis <TLolis@dcc.com>  
**Sent:** Wednesday, 10 November 2021 12:53 PM  
**To:** Bogdan Mitic <Bogdan.Mitic@ipaustrialia.gov.au>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

At the outset, thank you for taking the time to discuss this application and series trade marks with me.

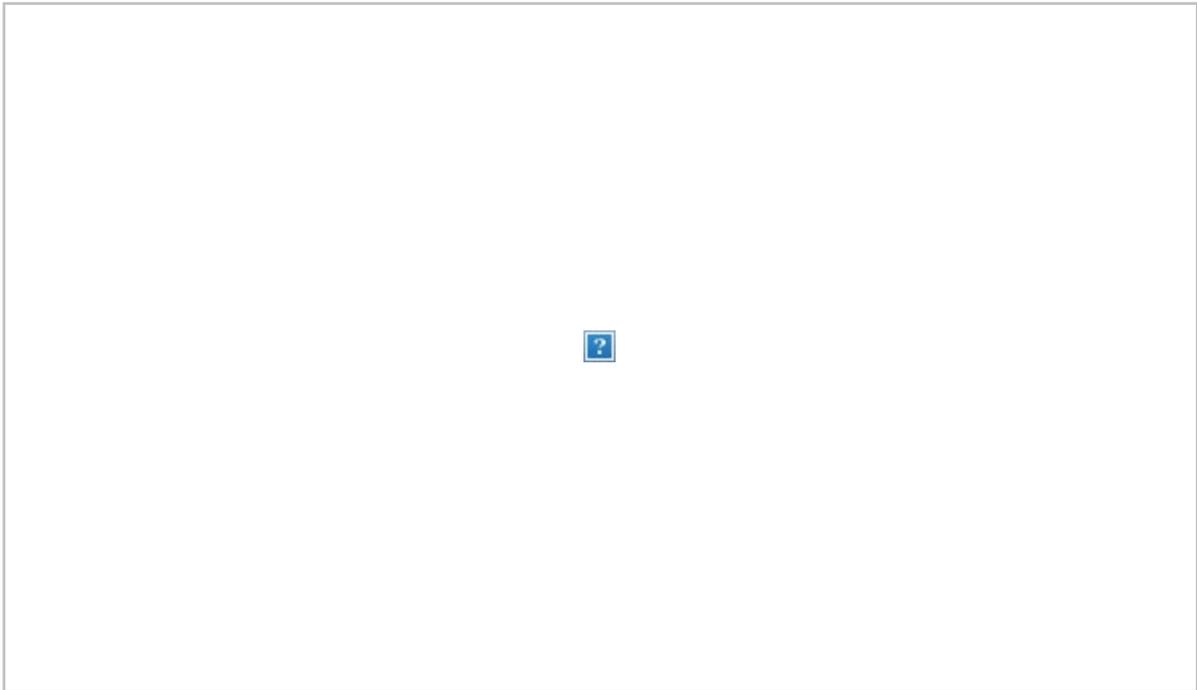
I acknowledge your position within the Office but I ask if you are also a Subject Matter Expert (SME) as it pertains to series trade marks. I have asked for a reconsideration by an SME. I believe that I am entitled to do so, and note that typically series trade marks are assigned to an appropriate SME. I have filed several over the years and these have been considered by a select group of examiners.

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This then leads me to the second statement which I was quite frankly surprised with and more so the logic behind it. If I understand it correctly, your concern is that at some point in a series trade mark application, the statement or representation as to the goods becomes distinctive of some of the claimed goods. If this is the case, why would the Manual list the following as examples of valid series trade marks. Surely you must concur that the word HATS is distinctive of say shirts or FOOTWAER of clothing yet these are clearly examples of valid series trade marks. Following your logic through, an argument could be made that a series trade mark can never be based as on a **statement or representation as to the goods** because at some point and probably beyond the point of the actual product itself, the descriptor becomes distinctive (ie Hats on Shirts).



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**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

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**To:** [Bogdan Mitic](#)  
**Cc:** [John Braybrooks](#); [TMDG Quality Practice & Customers](#)  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]  
**Date:** Wednesday, 24 November 2021 11:10:35 AM  
**Attachments:** [image001.png](#)  
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[image013.png](#)  
[image014.png](#)

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Dear Bogdan,

Thank you for your email.

Your comments seem to represent a significant departure from long standing Office practice. Moreover your logic seems difficult to follow and your "valid" example difficult to reconcile noting that the relevant legislation remains unchanged.

Can I please reiterate my earlier request, namely that the subject application be considered by a series trade mark SME and that the SME call me to discuss the this application further.

Kind regards

Tony

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Senior Trade Mark Counsel



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**Sent:** Thursday, 11 November 2021 5:51 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>; [TMDG Quality Practice & Customers](#) <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]

**OFFICIAL**

Dear Tony,

Thank you for getting in touch.

### Subject matter expertise

I work in the Quality, Practice, and Customers section. This section is responsible for setting examination practice, including examination of series applications. This section is also responsible for the subject matter expert program and escalations from examiners and subject matter experts are directed to our section to resolve when questions about the correct interpretation and application of law arise.

### The Manual

We are in the process of reviewing Part 13 and will be addressing the content, including the examples in your email, to ensure no such misunderstandings occur in future.

### Subsection 51(1)(a) of the *Trade Marks Act 1995 (Cth)* and the validity of a series applications

About the interpretation of subsection 51(1)(a), I am happy to provide further clarification regarding our conversation. For something to be a statement as to the goods or services it must be a reference for the gamut of goods and/or services claimed. If this is not the case, this element becomes a material particular and is not a statement as to the goods for the claims where it has no relevant meaning. As a result the material particulars across representations would not resemble one another, nor would the differences fall within those provided for by subsection 51(1)(a). To illustrate this point, consider the following example:

#### Invalid

Example 1	Class 29 claim for <i>beef</i> Class 30 claim for <i>ice cream</i> IDAK BEEF IDAK ICE CREAM
-----------	--

Ice cream is a statement of goods for ice cream but has no meaning relevant to beef, and in turn:

- a) forms a material particular not present in the IDAK BEEF representation, resulting in a situation where the representations do not resemble each other in material particulars; AND
- b) is not a statement as to the goods and therefore differs in a way not provided for by subsection 51(1)(a).

As such, example 1 would not constitute a valid series even though both may be food products.

#### Valid

An example of a valid series as per subsection 51(1)(a) would be as follows:

Example 2	Class 29 claim for <i>meat</i> IDAK BEEF IDAK LAMB
-----------	--

As beef and lamb are both meats, they:

- a) are not material particulars; AND
- b) are statements as to the goods and differ as provided for by subsection 51(1)(a).

In example 2 the series application is valid because the representations resemble each other in materials particulars and differ only as to the statements of goods.

The effect of subsection 51(1)(a) when applied correctly is that as the number of representations and claims in the specification increase, so too does the likelihood that the application will not constitute a valid series unless great care is taken in the way the application is drafted.

### **Prior registrations and series examination practice**

As for what you have coined as the “Cranberry statement”, when IP Australia identifies issues, especially issues in the interpretation and application of law, we ensure those issues are corrected so that we can provide applicants with valid and robust IP rights. The correct assessment of whether a series application is valid depends on the language of section 51 of the *Trade Marks Act 1995* (Cth), not on what has been done previously, nor what the manual says. The Manual is a guide to practice and procedure and it does not override legislation or case law that comes to a contrary decision. I refer you to the Federal Court’s comments in *Beling v Sixty International S.A.* [2015] FCA 250 (20 March 2015):

*“References were made by both parties in submissions to the Trade Marks Office Manual of Practice and Procedure, and what was said in that manual about the award of costs. There does not appear to be any statutory power in the Act to issue such a manual and it is clearly no more than a set of administrative guidelines.”*

The above interpretation of section 51 has been confirmed with the Oppositions and Hearings section and with senior colleagues. Should you still have concerns or feel the need for further escalation you are welcome to request to be heard regarding this application. Alternatively, I am happy to assist you in coming up with an amendment that would allow for this application to proceed to acceptance.

Kind regards,

Bogdan Mitic  
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Trade Marks and Designs Group  
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**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)>  
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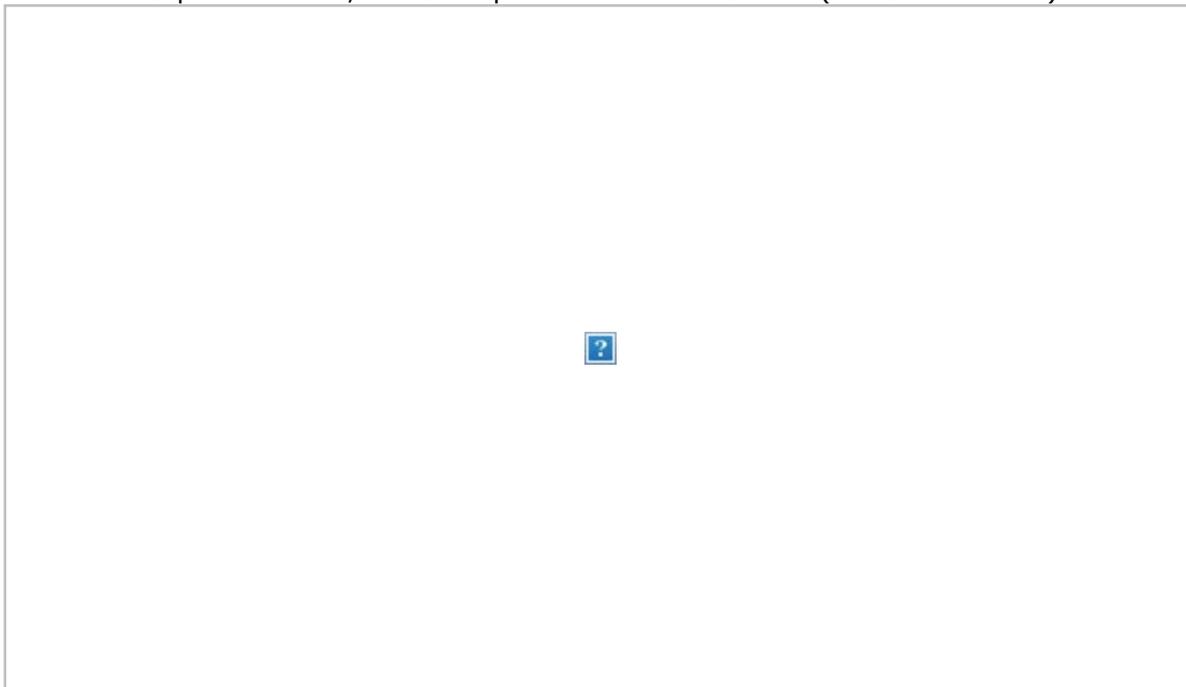
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**Date:** Monday, 8 November 2021 3:14:54 PM  
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[image004.png](#)  
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**Date:** Wednesday, 10 November 2021 12:52:57 PM  
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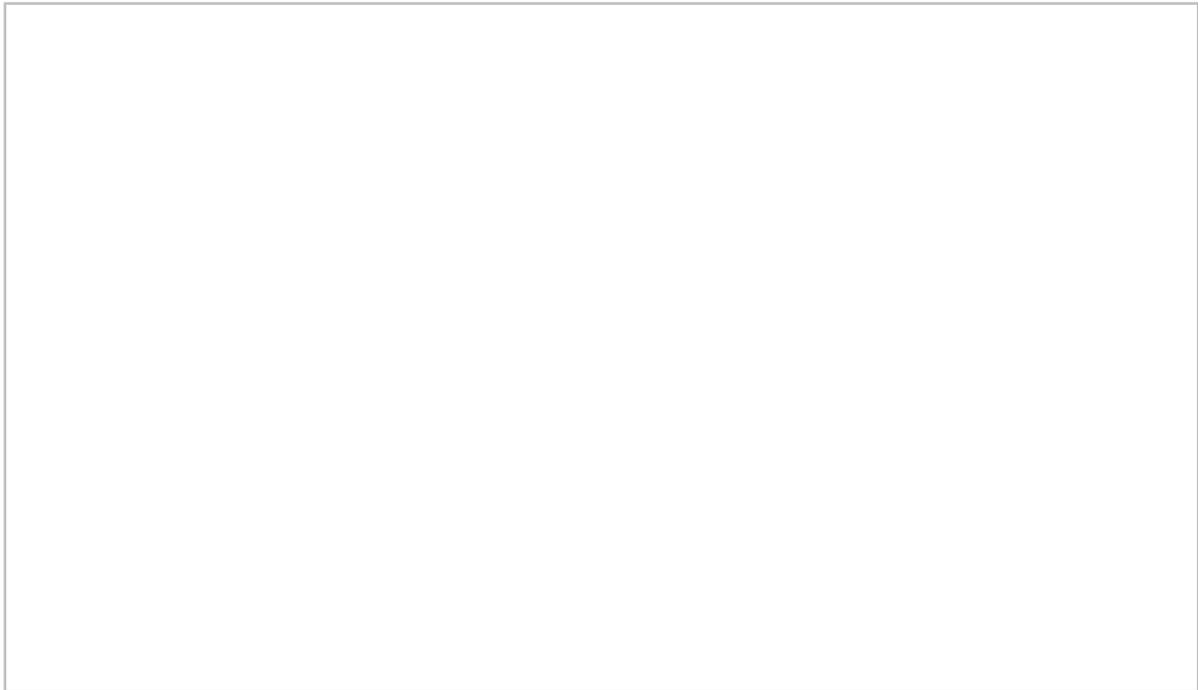
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Trade Marks and Designs Group  
IP Australia



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**From:** [Michael Yoon](#)  
**To:** [Bogdan Mitic](#)  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL]  
**Date:** Thursday, 25 November 2021 11:43:22 AM  
**Attachments:** [image001.png](#)  
[image002.jpg](#)  
[image003.png](#)  
[image004.png](#)  
[image005.png](#)  
[image006.jpg](#)  
[image007.jpg](#)  
[image008.png](#)  
[image009.png](#)  
[image010.png](#)

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OFFICIAL

Hi Bogdan,

I called Tony today but he didn't answer. I have left a voice message to give me a call back.

I will let you know if and when he calls back.

Cheers,

Michael

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Thursday, 25 November 2021 9:05 AM  
**To:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>  
**Subject:** FW: 2208391 MUM'S [SEC=OFFICIAL]

OFFICIAL

Hi Michael,

Mr Lolis would still like to speak to an SME. Could you please give him a call on the number below?

I have provided the email chain of our conversation thus far and am happy to provide additional context if that would help.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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**From:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Sent:** Wednesday, 24 November 2021 5:13 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustralia.gov.au](mailto:john.braybrooks@ipaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustralia.gov.au](mailto:MDB-TechnicalHub@ipaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL]

Dear Bogdan,

My contact number is 0401 055 044.

Thank you.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)>  
**Sent:** Wednesday, 24 November 2021 4:35 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustralia.gov.au](mailto:john.braybrooks@ipaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustralia.gov.au](mailto:MDB-TechnicalHub@ipaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]

**OFFICIAL**

Dear Tony,

The interpretation and application of Section 51 I have outlined is the conclusion we have reached after deliberating the wording of the legislation and the commentary available on series trade marks. If you disagree with this interpretation, I invite you to provide submissions with references to relevant court cases or hearings decisions to support your view.

I realise you believe some series SMEs may have taken a more lenient approach in the past. I am not sure whether this is true or not, but our practice needs to be based on a proper understanding and interpretation of the law. To this end, as previously mentioned, we are currently in the process of reviewing chapter 13 of the Manual and will be working with our series SMEs to create content that will clearly explain what constitutes a valid series and what examiners need to assess in terms of both material particulars and differences in statements of goods.

Regarding your request for consideration from an SME, I passed on your contact information to an SME who attempted to contact you but was unable to reach you. You should however be aware, while you are welcome to speak to an SME, any progress with this application will need to be in accordance with the interpretation of section 51 I have detailed in our previous correspondence.

Alternatively, if you are seeking an avenue for further escalation, you are welcome to request to be heard on this matter.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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**From:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Sent:** Wednesday, 24 November 2021 11:10 AM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustralia.gov.au](mailto:john.braybrooks@ipaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustralia.gov.au](mailto:MDB-TechnicalHub@ipaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

Thank you for your email.

Your comments seem to represent a significant departure from long standing Office practice. Moreover your logic seems difficult to follow and your "valid" example difficult to reconcile noting that the relevant legislation remains unchanged.

Can I please reiterate my earlier request, namely that the subject application be considered by a series trade mark SME and that the SME call me to discuss the this application further.

Kind regards

Tony

**Tony Lolis**  
Senior Trade Mark Counsel



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---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)>  
**Sent:** Thursday, 11 November 2021 5:51 PM  
**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Cc:** John Braybrooks <[john.braybrooks@ipaustralia.gov.au](mailto:john.braybrooks@ipaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustralia.gov.au](mailto:MDB-TechnicalHub@ipaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [ITUSEONLY-DCC.FID380059] [SEC=OFFICIAL]

**OFFICIAL**

Dear Tony,

Thank you for getting in touch.

**Subject matter expertise**

I work in the Quality, Practice, and Customers section. This section is responsible for setting examination practice, including examination of series applications. This section is also responsible for the subject matter expert program and escalations from examiners and subject matter experts are directed to our section to resolve when questions about the correct interpretation and application of law arise.

**The Manual**

We are in the process of reviewing Part 13 and will be addressing the content, including the examples in your email, to ensure no such misunderstandings occur in future.

**Subsection 51(1)(a) of the *Trade Marks Act 1995 (Cth)* and the validity of a series applications**

About the interpretation of subsection 51(1)(a), I am happy to provide further clarification regarding our conversation. For something to be a statement as to the goods or services it must be a reference for the gamut of goods and/or services claimed. If this is not the case, this element becomes a material particular and is not a statement as to the goods for the claims where it has no relevant meaning. As a result the material particulars across representations would not resemble one another, nor would the differences fall within those provided for by subsection 51(1)(a). To illustrate this point, consider the following example:

Invalid

Example 1	Class 29 claim for <i>beef</i> Class 30 claim for <i>ice cream</i> IDAK BEEF IDAK ICE CREAM
-----------	--

Ice cream is a statement of goods for ice cream but has no meaning relevant to beef, and in turn:

- a. forms a material particular not present in the IDAK BEEF representation, resulting in a situation where the representations do not resemble each other in material particulars; AND

- b. is not a statement as to the goods and therefore differs in a way not provided for by subsection 51(1)(a).

As such, example 1 would not constitute a valid series even though both may be food products.

Valid

An example of a valid series as per subsection 51(1)(a) would be as follows:

Example 2	Class 29 claim for <i>meat</i> IDAK BEEF IDAK LAMB
-----------	--

As beef and lamb are both meats, they:

- a. are not material particulars; AND
- b. are statements as to the goods and differ as provided for by subsection 51(1)(a).

In example 2 the series application is valid because the representations resemble each other in materials particulars and differ only as to the statements of goods.

The effect of subsection 51(1)(a) when applied correctly is that as the number of representations and claims in the specification increase, so too does the likelihood that the application will not constitute a valid series unless great care is taken in the way the application is drafted.

**Prior registrations and series examination practice**

As for what you have coined as the “Cranberry statement”, when IP Australia identifies issues, especially issues in the interpretation and application of law, we ensure those issues are corrected so that we can provide applicants with valid and robust IP rights. The correct assessment of whether a series application is valid depends on the language of section 51 of the *Trade Marks Act 1995 (Cth)*, not on what has been done previously, nor what the manual says. The Manual is a guide to practice and procedure and it does not override legislation or case law that comes to a contrary decision. I refer you to the Federal Court’s comments in *Beling v Sixty International S.A.* [2015] FCA 250 (20 March 2015):

*“References were made by both parties in submissions to the Trade Marks Office Manual of Practice and Procedure, and what was said in that manual about the award of costs. There does not appear to be any statutory power in the Act to issue such a manual and it is clearly no more than a set of administrative guidelines.”*

The above interpretation of section 51 has been confirmed with the Oppositions and Hearings section and with senior colleagues. Should you still have concerns or feel the need for further escalation you are welcome to request to be heard regarding this application. Alternatively, I am happy to assist you in coming up with an amendment that would allow for this application to proceed to acceptance.

Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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**From:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>  
**Sent:** Wednesday, 10 November 2021 12:53 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

At the outset, thank you for taking the time to discuss this application and series trade marks with me.

I acknowledge your position within the Office but I ask if you are also a Subject Matter Expert (SME) as it pertains to series trade marks. I have asked for a reconsideration by an SME. I believe that I am entitled to do so, and note that typically series trade marks are assigned to an appropriate SME. I have filed several over the years and these have been considered by a select group of examiners.

If you are an SME in this space, I assume that you have experience in dealing with series trade marks. If so can you please point out which series trade mark applications you have examined previously?

I ask this because during the course of our discussions various statements were made which for lack of a better term "was news to me".

As far as I understand it, and please correct me if I am wrong, you indicated that an Applicant is required to use every iteration of the series trade mark on all claimed goods. I have never come across this concept before and find it completely illogical in the context of series trade marks that are linked by a **statement or representation as to the goods or services in relation to which the trade marks are to be used**. For example, even looking at the guidance provided in the Manual and the examples of valid series trade marks (I set these out below) why would a trader use IDAK SLIPPERS in relation to shirts and why are they required to do so?

This then leads me to the second statement which I was quite frankly surprised with and more so the logic behind it. If I understand it correctly, your concern is that at some point in a series trade mark application, the statement or representation as to the goods becomes distinctive of some of the claimed goods. If this is the case, why would the Manual list the following as examples of valid series trade marks. Surely you must concur that the word HATS is distinctive of say shirts or FOOTWAER of clothing yet these are clearly examples of valid series trade marks. Following your logic through, an argument could be made that a series trade mark can never be based as on a **statement or representation as to the goods** because at some point and probably beyond the point of the actual product itself, the descriptor becomes distinctive (ie Hats on Shirts).



I have already raised my concerns with the wine variety example we discussed. As I have mentioned, this type of series trade mark application where the statement is directed to a well-known type of wine (ie shiraz, riesling, rose etc) has always been allowed. You have indicated to me that this is wrong because shiraz is descriptive of a type of red wine but distinctive of a white wine so this is should not be a valid series. If I follow your logic through to its conclusion, shiraz is arguably distinctive when used in the context of a merlot, pinot or cabernet sauvignon also.

In essence your logic, at least as I understand it, seems to a erode the applicability of section 51(1)(a) entirely.

I am also concerned with what I will call the "Cranberry Statement": "just because the Office has done it previously doesn't mean that it is right". With the greatest of respect, it seems to me, at least based on previous outcomes and having regard to the commentary in the Manual that you are perhaps reimagining the applicability of section 51(1)(a).

I now return to my initial request, that this application be considered by an SME familiar with series trade marks. If you are not an SME can you please direct my request to an appropriate examiner so I can progress this further.

I am more than happy to discuss this with you.

Kind regards,

**Tony Lolis**

Senior Trade Mark Counsel



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---

**From:** Tony Lolis

**Sent:** Monday, 8 November 2021 3:15 PM

**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>

**Subject:** RE: 2208391 MUM'S [SEC=OFFICIAL] [ITUSEONLY-DCC.FID380059]

Dear Bogdan,

Here is a recent registration which supports my arguments:

<https://search.ipaustralia.gov.au/trademarks/search/view/2012061?s=2104d02a-2ee1-4005-8cec-1ef898be4366&p=4> .

This in my experience has always been a valid type of "series applications".

Kind regards

Tony

**Tony Lolis**

Senior Trade Mark Counsel



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Melbourne, VIC 3000 AUSTRALIA

T +61 3 9254 2777  
E [TLolis@dcc.com](mailto:TLolis@dcc.com)



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---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>

**Sent:** Monday, 8 November 2021 12:34 PM

**To:** Tony Lolis <[TLolis@dcc.com](mailto:TLolis@dcc.com)>

**Subject:** 2208391 MUM'S [SEC=OFFICIAL]

**OFFICIAL**

Hello Mr. Lolis,

I am informed you would like to discuss the objections raised on this application.

I am more than happy to discuss these with you.

You can reach me on (02) 6283 2600 at your earliest convenience.

Regards,

Bogdan Mitic

Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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**From:** [Michael Yoon](#)  
**To:** [Daria Sigma](#); [Bogdan Mitic](#); [Sarah Jonic](#)  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]  
**Date:** Thursday, 25 November 2021 11:41:40 AM  
**Attachments:** [image001.png](#)  
[image005.jpg](#)  
[image006.jpg](#)  
[image007.jpg](#)  
[image008.jpg](#)  
[image009.png](#)  
[image010.png](#)  
[image011.png](#)

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OFFICIAL

Hi Daria,

I have conversed with Bogdan and we are of the consensus that you should proceed with what Bogdan has previously advised.

I would also suggest to have a read of Diedre's decision in *Aimmad Pty Ltd* [2015] 123 and refer to it where appropriate in your response, given that your file also deals with issues pertaining to distinctiveness and material particulars.

Kind regards,

**Michael Yoon**

Trade Mark Examination  
Trade Mark and Designs  
IP Australia



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**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Thursday, 25 November 2021 11:08 AM  
**To:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Sorry, I was off. But in that time the file's turned red. So, unless that conversation with you, Michael, has happened, I'll reply in the spirit of 'I understand that you have been in contact with those people

as requested, the objection remains this, the reasons remain that, etc'? Unless I've missed a step that has a significant reason why I shouldn't?

---

**From:** Daria Sigma  
**Sent:** Thursday, 18 November 2021 5:13 PM  
**To:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

OK, thanks for that. Just making sure we know where we're at.

---

**From:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Sent:** Thursday, 18 November 2021 5:12 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Hey Daria, so I did call Tony but he was not in at the time so I asked his secretary to give me a call back. He has yet to do so, and I think that was about two weeks ago.

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Thursday, 18 November 2021 3:48 PM  
**To:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Michael, I'm just cleaning up the bits of series marks in my inbox and this one is amongst them. Did you and the attorney end up talking?

---

**From:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 3:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

I am happy to speak with the attorney in question, however it seems like a futile exercise given that the office has already made a decision in relation to the validity of the series.

Cheers,

Michael

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:36 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>; John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Thank you, Bogdan. Very informative! I'll keep watch for further developments.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:31 PM  
**To:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>; John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

I understand there has been confusion over the best way to handle complex series applications. The Quality, Practice, and Customers Section is responsible for setting practice and providing guidance in those situations where examiners are having difficulty. With that in mind I have spoken to the attorney in this instance and relayed the following:

#### **Section 43**

The vegan and meat example was intended to demonstrate multiple similar issues in this file that exist as a result of the numerous claims and representations that the applicant has applied for. In addition to this the options you offered in the report listed goods outside of those I provided (such as various specific meat products as allowable for all the meat related representations). This was not in the example I provided because one can imagine a scenario such as MUM'S BEEF on lamb products and other similar instances understandably causing confusion. There are numerous issues in this application where the term following the word MUM'S is likely to deceive or cause confusion on several goods specified and this is one of the reasons the examples I provided were so narrow.

As for the attorney's point about vegan meats, this does not actually address whether the representations are likely to deceive or cause confusion. Meat is the flesh of an animal, and Vegan refers to item which are not derived from animals. This is in itself a contradiction, but more importantly, no qualification of vegan or anything of a similar effect precedes the meat reference in any of these representations. Given this we are satisfied that if a representation containing a reference to a meat (e.g. MUM'S BEEF) is used vegan products consumers are likely to be deceived or confused.

## Section 51

Where a term is not descriptive, it becomes adapted to at least some extent, and in turn becomes a material particular. Given this, the representations do not resemble each other in material particulars and the application does not constitute a valid series. If the manual says otherwise, we are happy to investigate it, but this alone does not support that the mark should be registered. While we do our best to ensure the content is correct, the manual is not infallible, nor is it a source of law. If the attorney feels that the objection is legally unsound, then they need to articulate why that is the case with rationale, rather than pointing to some inconsistency in the manual.

### Precedent and the state of the register

The attorney also stated that we have accepted similar applications before. While this may be true this does not mean that was the correct course of action, and again, what he needs to do is provide rationale that demonstrates the application of the relevant considerations should lead us to a conclusion that this application is acceptable.

### Summary

The attorney requested to speak to a series SME as he did not agree with the above. I did inform him that quality and practice is responsible for setting practice but he was insistent that he wanted to speak to a series SME. Michael I imagine this will be you?

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Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



P 02 6283 2600 | E [Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)

Visit us at <http://www.ipaustrialia.gov.au>

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---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>

**Sent:** Wednesday, 3 November 2021 2:27 PM

**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

So, short version – attorney wants to chase this up the ladder, ‘past’ me to an SME - the source(s) of

the consultation, if you will. Who can take this on?

Tony Lolis the attorney is on [tlolis@dcc.com](mailto:tlolis@dcc.com) or 03 9254 2777.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Friday, 29 October 2021 1:47 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

No I had not discussed it with the series managers. The escalation process typically goes as follows TL->SME->QPC, so my assumption was that you had discussed it with them prior to raising the issue with QP&C.

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If you and the series team have come up with an acceptable option that would overcome any issues regarding the validity of the series and the risk for confusion I'm more than happy for you to provide that option to the applicant.

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Thursday, 28 October 2021 4:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

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Did you get to chat to the head of series while you were looking through this one? It turns out they're thinking of a slightly broader approach. That maybe we would divide out the MUM'S [any meat description] and MUM'S [any pastry/confectionery/condiment descriptions] and give them class 29 or 30 depending on the description. Which is along the same lines as yours – they still aren't getting a complete series – but it means they aren't losing as *much* of the series to make it valid.

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there may be strongly-felt reasons as to why to take either approach.

---

**From:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 5:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaustrialia.gov.au](mailto:Sam.Gilkes@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

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I would also note that MUM'S in respect of food is likely to attract an objection under section 41 which further complicates the above considerations.

There are also issues relating to s43 that need to be considered (meat vs vegan meat and other similar situations where confusion is likely).

Our suggestion would be to provide a very narrow option regarding any valid series due to the issues above e.g.

<b>MUM'S MUM'S FISH MUM'S ROAST BEEF MUM'S ROAST CHICKEN  MUM'S ROAST LAMB MUM'S ROAST PORK</b>	For meat
---	----------

Or

<b>MUM'S MUM'S CAKE MUM'S CARROT CAKE</b>	For cakes
---	-----------

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 11:21 AM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaaustralia.gov.au](mailto:Sam.Gilkes@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Good morning.

Is there any update on this one as yet, have you been able to consider the matter?

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**From:** Daria Sigma  
**Sent:** Tuesday, 5 October 2021 12:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Subject:** 2208391 series approach [SEC=OFFICIAL]

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However, according to the series criteria, this is only valid if all of those goods are in the same class. As you can see, here they are not.

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We're content to 'on balance of all factors' see this an exception that proves the rule, practice discretion, and accept under these circumstances. But, as I said, thought we should run in past you.

Regards,

**Daria Sigma** (she/her)  
Trade Marks Examiner  
Trade Marks Examination Section A  
IP Australia



Ph 02 6283 2852 E [daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)

Visit us at <http://www.ipaustralia.gov.au>

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acknowledgement-to-country[1]



**From:** [Daria Sigma](#)  
**To:** [Michael Yoon](#); [Bogdan Mitic](#); [TMDG Quality Practice & Customers](#)  
**Cc:** [Sarah Jonic](#); [John Braybrooks](#)  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]  
**Date:** Thursday, 18 November 2021 3:47:47 PM  
**Attachments:** [image001.png](#)  
[image002.png](#)  
[image003.png](#)  
[image004.png](#)

---

OFFICIAL

Michael, I'm just cleaning up the bits of series marks in my inbox and this one is amongst them. Did you and the attorney end up talking?

---

**From:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 3:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

I am happy to speak with the attorney in question, however it seems like a futile exercise given that the office has already made a decision in relation to the validity of the series.

Cheers,

Michael

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:36 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Thank you, Bogdan. Very informative! I'll keep watch for further developments.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:31 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Hi Daria,

I understand there has been confusion over the best way to handle complex series applications. The Quality, Practice, and Customers Section is responsible for setting practice and providing guidance in those situations where examiners are having difficulty. With that in mind I have spoken to the attorney in this instance and relayed the following:

### **Section 43**

The vegan and meat example was intended to demonstrate multiple similar issues in this file that exist as a result of the numerous claims and representations that the applicant has applied for. In addition to this the options you offered in the report listed goods outside of those I provided (such as various specific meat products as allowable for all the meat related representations). This was not in the example I provided because one can imagine a scenario such as MUM'S BEEF on lamb products and other similar instances understandably causing confusion. There are numerous issues in this application where the term following the word MUM'S is likely to deceive or cause confusion on several goods specified and this is one of the reasons the examples I provided were so narrow.

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### **Section 51**

Where a term is not descriptive, it becomes adapted to at least some extent, and in turn becomes a material particular. Given this, the representations do not resemble each other in material particulars and the application does not constitute a valid series. If the manual says otherwise, we are happy to investigate it, but this alone does not support that the mark should be registered. While we do our best to ensure the content is correct, the manual is not infallible, nor is it a source of law. If the attorney feels that the objection is legally unsound, then they need to articulate why that is the case with rationale, rather than pointing to some inconsistency in the manual.

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The attorney also stated that we have accepted similar applications before. While this may be true this does not mean that was the correct course of action, and again, what he needs to do is provide rationale that demonstrates the application of the relevant considerations should lead us to a conclusion that this application is acceptable.

### **Summary**

The attorney requested to speak to a series SME as he did not agree with the above. I did inform him that quality and practice is responsible for setting practice but he was insistent that he wanted to speak to a series SME. Michael I imagine this will be you?

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approach, but we will also arrange a meeting with the Oppositions and Hearings section to confirm and align the practice in the office with regards to the examination of series.

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Trade Marks and Designs Group  
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**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Wednesday, 3 November 2021 2:27 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

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Tony Lolis the attorney is on [tlolis@dcc.com](mailto:tlolis@dcc.com) or 03 9254 2777.

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**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Friday, 29 October 2021 1:47 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

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Regards,

Bogdan

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**Sent:** Thursday, 28 October 2021 4:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
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**Sent:** Tuesday, 12 October 2021 5:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaustrialia.gov.au](mailto:Sam.Gilkes@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

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Regards,

Bogdan

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Trade Marks Examination Section A  
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**From:** [Daria Sigma](#)  
**To:** [Bogdan Mitic](#); [TMDG Quality Practice & Customers](#)  
**Cc:** [Michael Yoon](#); [Sarah Jonic](#); [John Braybrooks](#)  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]  
**Date:** Monday, 8 November 2021 2:36:21 PM  
**Attachments:** [image001.png](#)  
[image003.png](#)  
[image004.png](#)  
[image005.png](#)

---

## OFFICIAL

Thank you, Bogdan. Very informative! I'll keep watch for further developments.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
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**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

## OFFICIAL

Hi Daria,

I understand there has been confusion over the best way to handle complex series applications. The Quality, Practice, and Customers Section is responsible for setting practice and providing guidance in those situations where examiners are having difficulty. With that in mind I have spoken to the attorney in this instance and relayed the following:

### Section 43

The vegan and meat example was intended to demonstrate multiple similar issues in this file that exist as a result of the numerous claims and representations that the applicant has applied for. In addition to this the options you offered in the report listed goods outside of those I provided (such as various specific meat products as allowable for all the meat related representations). This was not in the example I provided because one can imagine a scenario such as MUM'S BEEF on lamb products and other similar instances understandably causing confusion. There are numerous issues in this application where the term following the word MUM'S is likely to deceive or cause confusion on several goods specified and this is one of the reasons the examples I provided were so narrow.

As for the attorney's point about vegan meats, this does not actually address whether the representations are likely to deceive or cause confusion. Meat is the flesh of an animal, and Vegan refers to item which are not derived from animals. This is in itself a contradiction, but more importantly, no qualification of vegan or anything of a similar effect precedes the meat reference in any of these representations. Given this we are satisfied that if a representation containing a reference to a meat (e.g. MUM'S BEEF) is used vegan products consumers are likely to be deceived or confused.

### Section 51

Where a term is not descriptive, it becomes adapted to at least some extent, and in turn becomes a

material particular. Given this, the representations do not resemble each other in material particulars and the application does not constitute a valid series. If the manual says otherwise, we are happy to investigate it, but this alone does not support that the mark should be registered. While we do our best to ensure the content is correct, the manual is not infallible, nor is it a source of law. If the attorney feels that the objection is legally unsound, then they need to articulate why that is the case with rationale, rather than pointing to some inconsistency in the manual.

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The attorney also stated that we have accepted similar applications before. While this may be true this does not mean that was the correct course of action, and again, what he needs to do is provide rationale that demonstrates the application of the relevant considerations should lead us to a conclusion that this application is acceptable.

### **Summary**

The attorney requested to speak to a series SME as he did not agree with the above. I did inform him that quality and practice is responsible for setting practice but he was insistent that he wanted to speak to a series SME. Michael I imagine this will be you?

As a follow up, I have already spoken informally to a hearing officer who agreed with the above approach, but we will also arrange a meeting with the Oppositions and Hearings section to confirm and align the practice in the office with regards to the examination of series.

Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



P 02 6283 2600 | E [Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)

Visit us at <http://www.ipaustrialia.gov.au>

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---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>

**Sent:** Wednesday, 3 November 2021 2:27 PM

**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

So, short version – attorney wants to chase this up the ladder, ‘past’ me to an SME - the source(s) of the consultation, if you will. Who can take this on?

Tony Lolis the attorney is on [tlolis@dcc.com](mailto:tlolis@dcc.com) or 03 9254 2777.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>  
**Sent:** Friday, 29 October 2021 1:47 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

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If you and the series team have come up with an acceptable option that would overcome any issues regarding the validity of the series and the risk for confusion I'm more than happy for you to provide that option to the applicant.

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Thursday, 28 October 2021 4:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

Good afternoon, Bogdan.

Did you get to chat to the head of series while you were looking through this one? It turns out they're thinking of a slightly broader approach. That maybe we would divide out the MUM'S [any meat description] and MUM'S [any pastry/confectionery/condiment descriptions] and give them class 29 or 30 depending on the description. Which is along the same lines as yours – they still aren't getting a complete series – but it means they aren't losing as *much* of the series to make it valid.

I've already mentioned to what I made of all this, but I'm neither a Q&P-er nor a head of series, so there may be strongly-felt reasons as to why to take either approach.

---

**From:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 5:50 PM

**To:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaaustralia.gov.au](mailto:Sam.Gilkes@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

We would be inclined to say that even within the classes there are issues regarding the validity of this series application. Where a term is descriptive of one good and not another, that term becomes a material particular.

Here, there are various words following MUM'S that would not be direct references for all the goods claimed and as a result would become material particulars for some of the representations e.g. CURRY or LASAGNA is not for *chocolate based spreads containing nuts*.

I would also note that MUM'S in respect of food is likely to attract an objection under section 41 which further complicates the above considerations.

There are also issues relating to s43 that need to be considered (meat vs vegan meat and other similar situations where confusion is likely).

Our suggestion would be to provide a very narrow option regarding any valid series due to the issues above e.g.

<b>MUM'S MUM'S FISH MUM'S ROAST BEEF MUM'S ROAST CHICKEN  MUM'S ROAST LAMB MUM'S ROAST PORK</b>	For meat
---	----------

Or

<b>MUM'S MUM'S CAKE MUM'S CARROT CAKE</b>	For cakes
---	-----------

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 11:21 AM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaaustralia.gov.au](mailto:Sam.Gilkes@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Good morning.

Is there any update on this one as yet, have you been able to consider the matter?

---

**From:** Daria Sigma

**Sent:** Tuesday, 5 October 2021 12:17 PM

**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustralia.gov.au](mailto:MDB-TechnicalHub@ipaustralia.gov.au)>

**Subject:** 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Good afternoon.

This is one we the series trademark examiners chewed over and eventually decided to flag with you.

On first blush, the series seems acceptable, because all of the goods in each member of the series are direct references to goods the mark has claimed.

However, according to the series criteria, this is only valid if all of those goods are in the same class. As you can see, here they are not.

This seems a somewhat arbitrary difference, not least when we are talking about Classes 29 and 30, classes that go very closely together.

And, we are forever telling ourselves and the clients that the classes are merely organisational tools, so having them be the difference between a valid and invalid series (that is, something we can accept or not) doesn't seem in keeping with that.

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We're content to 'on balance of all factors' see this an exception that proves the rule, practice discretion, and accept under these circumstances. But, as I said, thought we should run in past you.

Regards,

**Daria Sigma** (she/her)  
Trade Marks Examiner  
Trade Marks Examination Section A  
IP Australia



Ph 02 6283 2852 E [daria.sigma@ipaustralia.gov.au](mailto:daria.sigma@ipaustralia.gov.au)  
Visit us at <http://www.ipaustralia.gov.au>

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acknowledgement-to-country[1]



**From:** [Michael Yoon](#)  
**To:** [Daria Sigma](#); [Bogdan Mitic](#); [TMDG Quality Practice & Customers](#)  
**Cc:** [Sarah Jonic](#); [John Braybrooks](#)  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]  
**Date:** Monday, 8 November 2021 3:49:47 PM  
**Attachments:** [image001.png](#)  
[image002.png](#)  
[image003.png](#)  
[image004.png](#)

---

**OFFICIAL**

I am happy to speak with the attorney in question, however it seems like a futile exercise given that the office has already made a decision in relation to the validity of the series.

Cheers,

Michael

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:36 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>; John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Thank you, Bogdan. Very informative! I'll keep watch for further developments.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:31 PM  
**To:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>; John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>  
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Visit us at <http://www.ipaustrialia.gov.au>

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**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Wednesday, 3 November 2021 2:27 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

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Tony Lolis the attorney is on [tlolis@dcc.com](mailto:tlolis@dcc.com) or 03 9254 2777.

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**Sent:** Friday, 29 October 2021 1:47 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

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Bogdan

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**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Thursday, 28 October 2021 4:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>  
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**Sent:** Tuesday, 12 October 2021 5:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaustrialia.gov.au](mailto:Sam.Gilkes@ipaustrialia.gov.au)>  
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Bogdan

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**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 11:21 AM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaaustralia.gov.au](mailto:Sam.Gilkes@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

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**From:** Daria Sigma  
**Sent:** Tuesday, 5 October 2021 12:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
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Regards,

**Daria Sigma** (she/her)  
Trade Marks Examiner  
Trade Marks Examination Section A  
IP Australia



Ph 02 6283 2852 E [daria.sigma@ipaustralia.gov.au](mailto:daria.sigma@ipaustralia.gov.au)  
Visit us at <http://www.ipaustralia.gov.au>

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acknowledgement-to-country[1]



**From:** [Daria Sigma](#)  
**To:** [Michael Yoon](#); [Bogdan Mitic](#); [Sarah Jonic](#)  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]  
**Date:** Thursday, 25 November 2021 11:08:10 AM  
**Attachments:** [image001.png](#)  
[image002.png](#)  
[image003.png](#)  
[image004.png](#)

---

OFFICIAL

Sorry, I was off. But in that time the file's turned red. So, unless that conversation with you, Michael, has happened, I'll reply in the spirit of 'I understand that you have been in contact with those people as requested, the objection remains this, the reasons remain that, etc'? Unless I've missed a step that has a significant reason why I shouldn't?

---

**From:** Daria Sigma  
**Sent:** Thursday, 18 November 2021 5:13 PM  
**To:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

OK, thanks for that. Just making sure we know where we're at.

---

**From:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Sent:** Thursday, 18 November 2021 5:12 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Hey Daria, so I did call Tony but he was not in at the time so I asked his secretary to give me a call back. He has yet to do so, and I think that was about two weeks ago.

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>  
**Sent:** Thursday, 18 November 2021 3:48 PM  
**To:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

OFFICIAL

Michael, I'm just cleaning up the bits of series marks in my inbox and this one is amongst them. Did you and the attorney end up talking?

---

**From:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>  
**Sent:** Monday, 8 November 2021 3:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>;

TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

I am happy to speak with the attorney in question, however it seems like a futile exercise given that the office has already made a decision in relation to the validity of the series.

Cheers,

Michael

---

**From:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>

**Sent:** Monday, 8 November 2021 2:36 PM

**To:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Thank you, Bogdan. Very informative! I'll keep watch for further developments.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>

**Sent:** Monday, 8 November 2021 2:31 PM

**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>

**Cc:** Michael Yoon <[michael.yoon@ipaustrialia.gov.au](mailto:michael.yoon@ipaustrialia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaustrialia.gov.au](mailto:sarah.jonic@ipaustrialia.gov.au)>; John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

I understand there has been confusion over the best way to handle complex series applications. The Quality, Practice, and Customers Section is responsible for setting practice and providing guidance in those situations where examiners are having difficulty. With that in mind I have spoken to the attorney in this instance and relayed the following:

#### **Section 43**

The vegan and meat example was intended to demonstrate multiple similar issues in this file that exist as a result of the numerous claims and representations that the applicant has applied for. In addition to this the options you offered in the report listed goods outside of those I provided (such as various specific meat products as allowable for all the meat related representations). This was not in the example I provided because one can imagine a scenario such as MUM'S BEEF on lamb products

and other similar instances understandably causing confusion. There are numerous issues in this application where the term following the word MUM'S is likely to deceive or cause confusion on several goods specified and this is one of the reasons the examples I provided were so narrow.

As for the attorney's point about vegan meats, this does not actually address whether the representations are likely to deceive or cause confusion. Meat is the flesh of an animal, and Vegan refers to items which are not derived from animals. This is in itself a contradiction, but more importantly, no qualification of vegan or anything of a similar effect precedes the meat reference in any of these representations. Given this we are satisfied that if a representation containing a reference to a meat (e.g. MUM'S BEEF) is used on vegan products consumers are likely to be deceived or confused.

## **Section 51**

Where a term is not descriptive, it becomes adapted to at least some extent, and in turn becomes a material particular. Given this, the representations do not resemble each other in material particulars and the application does not constitute a valid series. If the manual says otherwise, we are happy to investigate it, but this alone does not support that the mark should be registered. While we do our best to ensure the content is correct, the manual is not infallible, nor is it a source of law. If the attorney feels that the objection is legally unsound, then they need to articulate why that is the case with rationale, rather than pointing to some inconsistency in the manual.

## **Precedent and the state of the register**

The attorney also stated that we have accepted similar applications before. While this may be true this does not mean that was the correct course of action, and again, what he needs to do is provide rationale that demonstrates the application of the relevant considerations should lead us to a conclusion that this application is acceptable.

## **Summary**

The attorney requested to speak to a series SME as he did not agree with the above. I did inform him that quality and practice is responsible for setting practice but he was insistent that he wanted to speak to a series SME. Michael I imagine this will be you?

As a follow up, I have already spoken informally to a hearing officer who agreed with the above approach, but we will also arrange a meeting with the Oppositions and Hearings section to confirm and align the practice in the office with regards to the examination of series.

Kind regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



P 02 6283 2600 | E [Bogdan.Mitic@ipaustralia.gov.au](mailto:Bogdan.Mitic@ipaustralia.gov.au)  
Visit us at <http://www.ipaustralia.gov.au>

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---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Wednesday, 3 November 2021 2:27 PM  
**To:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

So, short version – attorney wants to chase this up the ladder, ‘past’ me to an SME - the source(s) of the consultation, if you will. Who can take this on?

Tony Lolis the attorney is on [tlolis@dcc.com](mailto:tlolis@dcc.com) or 03 9254 2777.

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Friday, 29 October 2021 1:47 PM  
**To:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

No I had not discussed it with the series managers. The escalation process typically goes as follows TL->SME->QPC, so my assumption was that you had discussed it with them prior to raising the issue with QP&C.

Regarding the approach for this file, there might be other combinations of representations that would be a valid series (though again this depends on the specific claims and representations), but you would likely still face the same problems with section 43. This is why narrow examples were provided that would address both issues.

If you and the series team have come up with an acceptable option that would overcome any issues regarding the validity of the series and the risk for confusion I’m more than happy for you to provide that option to the applicant.

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Thursday, 28 October 2021 4:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>; Michael Yoon <[michael.yoon@ipaaustralia.gov.au](mailto:michael.yoon@ipaaustralia.gov.au)>; Sarah Jonic <[sarah.jonic@ipaaustralia.gov.au](mailto:sarah.jonic@ipaaustralia.gov.au)>

**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

Good afternoon, Bogdan.

Did you get to chat to the head of series while you were looking through this one? It turns out they're thinking of a slightly broader approach. That maybe we would divide out the MUM'S [any meat description] and MUM'S [any pastry/confectionery/condiment descriptions] and give them class 29 or 30 depending on the description. Which is along the same lines as yours – they still aren't getting a complete series – but it means they aren't losing as *much* of the series to make it valid.

I've already mentioned to what I made of all this, but I'm neither a Q&P-er nor a head of series, so there may be strongly-felt reasons as to why to take either approach.

---

**From:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 5:50 PM  
**To:** Daria Sigma <[daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)>; TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaustrialia.gov.au](mailto:MDB-TechnicalHub@ipaustrialia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaustrialia.gov.au](mailto:Sam.Gilkes@ipaustrialia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Hi Daria,

We would be inclined to say that even within the classes there are issues regarding the validity of this series application. Where a term is descriptive of one good and not another, that term becomes a material particular.

Here, there are various words following MUM'S that would not be direct references for all the goods claimed and as a result would become material particulars for some of the representations e.g. CURRY or LASAGNA is not for *chocolate based spreads containing nuts*.

I would also note that MUM'S in respect of food is likely to attract an objection under section 41 which further complicates the above considerations.

There are also issues relating to s43 that need to be considered (meat vs vegan meat and other similar situations where confusion is likely).

Our suggestion would be to provide a very narrow option regarding any valid series due to the issues above e.g.

<b>MUM'S MUM'S FISH MUM'S ROAST BEEF MUM'S ROAST CHICKEN  MUM'S ROAST LAMB MUM'S ROAST PORK</b>	For meat
---	----------

**Or**

--	--

**MUM'S  
MUM'S CAKE  
MUM'S CARROT CAKE**

For cakes

Regards,

Bogdan

---

**From:** Daria Sigma <[daria.sigma@ipaaustralia.gov.au](mailto:daria.sigma@ipaaustralia.gov.au)>  
**Sent:** Tuesday, 12 October 2021 11:21 AM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Cc:** Sam Gilkes <[Sam.Gilkes@ipaaustralia.gov.au](mailto:Sam.Gilkes@ipaaustralia.gov.au)>  
**Subject:** RE: 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Good morning.

Is there any update on this one as yet, have you been able to consider the matter?

---

**From:** Daria Sigma  
**Sent:** Tuesday, 5 October 2021 12:17 PM  
**To:** TMDG Quality Practice & Customers <[MDB-TechnicalHub@ipaaustralia.gov.au](mailto:MDB-TechnicalHub@ipaaustralia.gov.au)>  
**Subject:** 2208391 series approach [SEC=OFFICIAL]

**OFFICIAL**

Good afternoon.

This is one we the series trademark examiners chewed over and eventually decided to flag with you.

On first blush, the series seems acceptable, because all of the goods in each member of the series are direct references to goods the mark has claimed.

However, according to the series criteria, this is only valid if all of those goods are in the same class. As you can see, here they are not.

This seems a somewhat arbitrary difference, not least when we are talking about Classes 29 and 30, classes that go very closely together.

And, we are forever telling ourselves and the clients that the classes are merely organisational tools, so having them be the difference between a valid and invalid series (that is, something we can accept or not) doesn't seem in keeping with that.

The 'only in the same class' example in the manual refers to very different goods, which we don't think applies here – they are, after all, all foods and drink in these two classes. It's not like they're trying to claim soap and camshafts in the same series.

We're content to 'on balance of all factors' see this an exception that proves the rule, practice discretion, and accept under these circumstances. But, as I said, thought we should run in past you.

Regards,

**Daria Sigma** (she/her)  
Trade Marks Examiner  
Trade Marks Examination Section A  
IP Australia



Ph 02 6283 2852 E [daria.sigma@ipaustrialia.gov.au](mailto:daria.sigma@ipaustrialia.gov.au)  
Visit us at <http://www.ipaustrialia.gov.au>

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acknowledgement-to-country[1]



**From:** [Bogdan Mitic](#)  
**To:** [John Braybrooks](#)  
**Subject:** RE: Series manual part updates [SEC=OFFICIAL]  
**Date:** Tuesday, 23 November 2021 3:17:00 PM  
**Attachments:** [image001.png](#)

---

## OFFICIAL

Bogdan

A couple of questions

Example 5	IDAK 6 PACK IDAK 6
-----------	-----------------------

The expression 6 PACK has a meaning in relation to a healthy abdomen – which means in relation to muscle building products - its more than just a number

Example 2	IDAK SUPREME IDAK DELUXE IDAK PREMIER
-----------	---

The word SUPREME is a type of Pizza - so is not just a statement of quality –

Both of the above regarding issues of potential meaning depend on the context – the effect of a term will depend on the claims. Most terms can have meanings in specific industries (e.g. premier on movies) but the question will always depend on the application at hand, though generally SUPREME would be taken as a statement of quality. I do take your point about “pack”. Potentially this would fall within the ambit of a representation about the number of products.

### Names of places

Would we allow

- IDAK PERTH
- IDAK SCOTLAND

Yes. Both are statements as to names of places.

### Colours

Would we allow

IDAK

IDAK

In relation to “service stations”

If the size changes, no, however if the fonts were the same size yes. The font size change would not fall within the differences allowed for by 51(1)(a,b,c) while the colour change would.

IDAK BEEF

IDAK LAMB

|

If the applicant were to use the IDAK BEEF mark on lamb products it is likely that consumers would be confused or deceived about the type of meat they are purchasing.

I think we should have a reference to say that if an applicant is interested in getting coverage for IDAK on “beef and lamb:” they should apply for IDAK on its own with a specification reading “BEEF and LAMB” or “MEAT”

Happy to come up with something to this effect.

Is this a series?

1. IDAK MELBOURNE
2. MELBOURNE IDAK

The practice thus far has been no. While I am not entirely sure this was the intent of the provision, one could argue that the difference in arrangement influences the “trade mark potential” of the constituent elements and thus they do not resemble each other in material particulars and the difference in the arrangement might cause an element to constitute more than simply a statement or representation of a place name.

Is this a series

1. IDAK VIEW

## 2. IdAk view

The change would not fall within the differences allowed for by 51(1)(a,b,c).

### Example 1

IDAK TV

**IDAK** TELEVISION

[made invalid by enlarged script]

In terms of rights - what is the difference between IDAK in the same script size in both reps in the series and IDAK in a slightly bigger size?

I suppose your answer will be - that's irrelevant as that's got nothing to do with section 51 (correct haha – similar reasons to the above, that difference is not allowed for by s51. The effect is a 2 fold limitation, firstly they must resemble in material particulars, and also only differ as provided.)

John

---

**From:** Bogdan

Mitic <[Bogdan.Mitic@ipaustrialia.gov.au](mailto:Bogdan.Mitic@ipaustrialia.gov.au)>

**Sent:** Monday, 22 November 2021 3:48 PM

**To:** John Braybrooks <[john.braybrooks@ipaustrialia.gov.au](mailto:john.braybrooks@ipaustrialia.gov.au)>

**Subject:** Series manual part updates [SEC=OFFICIAL]

**OFFICIAL**

|  
| [Part 13.docx](#) |

|  
| Hi John,

|  
| The content in yellow is either new or reworded. If you want to  
| compare/contrast to the original content you can look at the manual.

|  
| Cheers,

|  
| Bogdan  
|

**From:** [Cristy Condon](#)  
**To:** [John Braybrooks](#)  
**Cc:** [Bogdan Mitic](#)  
**Subject:** RE: Series Practice [SEC=OFFICIAL]  
**Date:** Monday, 8 November 2021 3:38:45 PM  
**Attachments:** [image002.png](#)  
[image003.jpg](#)  
[image004.jpg](#)  
[image005.jpg](#)  
[image006.jpg](#)  
[image007.png](#)  
[image008.gif](#)  
[image009.png](#)

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**OFFICIAL**

Hi John,

Sounds like a good idea. We are stretched for resources with retirements, the 5 DRSP workstreams and 2 new HO's on the horizon but if this isn't a big patch of work I'm sure Tim and Nick B could join you all for a meeting.

Adrian isn't available for any other supernumeraries at the moment.

That sound ok?

Cheers  
Cristy

**Cristy Condon**

Assistant General Manager A/g  
Oppositions and Hearings  
Trade Marks and Designs  
IP Australia

Please note that I work part-time Monday-Thursday. For urgent matters please contact Adrian Richards on P (02) 62 83 2231.



P 02 6283 2595 | E [cristy.condon@ipaustalia.gov.au](mailto:cristy.condon@ipaustalia.gov.au)

Visit us at <https://www.ipaustalia.gov.au/>



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---

**From:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>

**Sent:** Monday, 8 November 2021 3:07 PM

**To:** Cristy Condon <[Cristy.Condon@ipaaustralia.gov.au](mailto:Cristy.Condon@ipaaustralia.gov.au)>

**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>

**Subject:** FW: Series Practice [SEC=OFFICIAL]

Hi Cristy

I hope everything is well. One of the things on my Achieve plan is closer relations with Hearings - especially between Policy Officers and Hearings Officers.

Bogdan is raising something that is worthy of us getting together and discussing practice to settle a few questions.

I was thinking of Bogdan + Michael Yoon (Series Manager) + a couple of Hearing officers – maybe Tim Brown and or Adrian?

Any views?

John

John Braybrooks  
Deputy Registrar  
Trade Marks & Designs Office  
IP Australia



Ph: 02 6283 2857 E [john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>

**Sent:** Monday, 8 November 2021 2:38 PM

**To:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>

**Subject:** Series Practice [SEC=OFFICIAL]

**OFFICIAL**

Hi John,

A recent series application has raised some questions regarding our practice for the examination of

series trade marks, both in terms of s51 and when terms that are descriptive of only some of the claims become material particulars, but also how section 43 applies.

I think it would be advisable to arrange a meeting with the Oppositions and Hearings section, along with the SMEs, to discuss what is the correct approach.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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Visit us at <http://www.ipaustrialia.gov.au>

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**From:** [John Braybrooks](#)  
**To:** [Cristy Condon](#)  
**Cc:** [Bogdan Mitic](#)  
**Subject:** RE: Series Practice [SEC=OFFICIAL]  
**Date:** Tuesday, 9 November 2021 10:05:00 AM  
**Attachments:** [image001.png](#)  
[image002.jpg](#)  
[image003.jpg](#)  
[image004.jpg](#)  
[image005.jpg](#)  
[image006.png](#)  
[image007.gif](#)  
[image008.png](#)

---

OFFICIAL

Thanks Cristy – sounds good.

John

---

**From:** Cristy Condon <Cristy.Condon@ipaustrialia.gov.au>  
**Sent:** Monday, 8 November 2021 3:39 PM  
**To:** John Braybrooks <john.braybrooks@ipaustrialia.gov.au>  
**Cc:** Bogdan Mitic <Bogdan.Mitic@ipaustrialia.gov.au>  
**Subject:** RE: Series Practice [SEC=OFFICIAL]

OFFICIAL

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Sounds like a good idea. We are stretched for resources with retirements, the 5 DRSP workstreams and 2 new HO's on the horizon but if this isn't a big patch of work I'm sure Tim and Nick B could join you all for a meeting.

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Cheers  
Cristy

**Cristy Condon**  
Assistant General Manager A/g  
Oppositions and Hearings  
Trade Marks and Designs  
IP Australia

Please note that I work part-time Monday-Thursday. For urgent matters please contact Adrian Richards on P (02) 62 83 2231.



P 02 6283 2595 | E [cristy.condon@ipaaustralia.gov.au](mailto:cristy.condon@ipaaustralia.gov.au)

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---

**From:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>

**Sent:** Monday, 8 November 2021 3:07 PM

**To:** Cristy Condon <[Cristy.Condon@ipaaustralia.gov.au](mailto:Cristy.Condon@ipaaustralia.gov.au)>

**Cc:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>

**Subject:** FW: Series Practice [SEC=OFFICIAL]

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John

John Braybrooks  
Deputy Registrar  
Trade Marks & Designs Office  
IP Australia



Ph: 02 6283 2857 E [john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)

---

**From:** Bogdan Mitic <[Bogdan.Mitic@ipaaustralia.gov.au](mailto:Bogdan.Mitic@ipaaustralia.gov.au)>  
**Sent:** Monday, 8 November 2021 2:38 PM  
**To:** John Braybrooks <[john.braybrooks@ipaaustralia.gov.au](mailto:john.braybrooks@ipaaustralia.gov.au)>  
**Subject:** Series Practice [SEC=OFFICIAL]

**OFFICIAL**

Hi John,

A recent series application has raised some questions regarding our practice for the examination of series trade marks, both in terms of s51 and when terms that are descriptive of only some of the claims become material particulars, but also how section 43 applies.

I think it would be advisable to arrange a meeting with the Oppositions and Hearings section, along with the SMEs, to discuss what is the correct approach.

Regards,

Bogdan Mitic  
Quality, Practice and Customers  
Trade Marks and Designs Group  
IP Australia



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Project Name SERIES EXAMINATION TRAINING	Slide Number	Developer: KEIR DICKSON	Date: MAY 2018
<p>Introduction</p> <p>In this module you will cover:</p> <ul style="list-style-type: none"> <li>- What a series application is and how it functions within the parameters of section 51.</li> </ul> <p>Links</p> <ul style="list-style-type: none"> <li>- Trade Marks Act (1995)</li> <li>- Part 13 of the Manual</li> </ul> <p>Expected learning outcomes: to be a confident, competent examiner of series trade marks.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
<p>Developer Notes:</p> <p>First four slides are usually: title slide, navigation guide, introduction and menu</p>			Navigation
			<ul style="list-style-type: none"> <li>• TM Act</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>- <b>What is a Series Application</b></p> <p>A series application allows applicants to apply for multiple trade mark representations in a single application, as long as the trade marks comply with the provisions of section 51 of the Trade Marks Act. It is a convenient way to apply for very similar trade marks and may serve as a cost-effective method as opposed to applying for multiple stand-alone applications.</p> <p>Note: Series applications are not available as Headstarts.</p>		<p>Slide Audio</p> <ul style="list-style-type: none"> <li>•</li> </ul>	
<p>- <b>What is Section 51</b></p> <p>Series applications are governed almost entirely by the provisions of section 51.</p> <p>Under section 51 of the Act a person may make a single application under subsection 27(1) of the Act for two or more trade marks:</p> <p><b>if</b> the trade marks resemble each other in material particulars</p> <p><b>and</b> the trade marks <b>differ only</b> in respect of one or more of the following:</p> <p>statements or representations as to the goods or services in relation to which the trade marks are to be used;</p> <p>statements or representations as to number, price, quality or names of places;</p> <p>the colour of any part of the trade mark.</p> <p>If:</p> <p>the application meets all the requirements of this Act; and</p> <p>the Registrar is required (under section 68) to register the trade marks;</p> <p>he or she must register them as a series in one registration.</p> <p>In effect, section 51 provides a two-tier test to determine the validity of a series application.</p>		<p>Media</p> <ul style="list-style-type: none"> <li>•</li> </ul>	
<p>- <b>First Tier: Material particulars</b></p> <p>To qualify as a series the trade marks must first resemble each other in material particulars. That is, the identifying feature or features in each trade mark of the series must be essentially the same and any differences minor. In many cases the identifying feature/s entirely comprise the distinctive elements of the trade mark. However, it should be noted that in some cases descriptive/non-distinctive material can form part of the material particulars of a trade mark – particularly if its size and presentation within the trade mark are dominating features. Any differences between the material particulars must be such that they do not substantially affect the identity of the trade marks when each member of the series is compared to each of the others.</p>		<p>Navigation</p> <ul style="list-style-type: none"> <li>• HYPERLINKS for subsections</li> <li>• Show/hide for the actual text of section 51?</li> <li>• Show/hide for the First Tier and Second Tier. Must look at all show/hides before Next button appears.</li> </ul>	

- **Second Tier: Subsection 51(1)**

Subsection 51(1) provides the second consideration in determining the validity of a series.

This subsection places substantial restrictions on what sort of trade marks can form a valid series. It does this by specifying in paragraphs (a), (b) and (c) a narrow range of ways in which the trade marks can differ. It also requires that series trade marks differ **only** in respect of the ways specified. It does however allow the trade marks to differ in **one or more** of these ways.

This means that even if the material particulars resemble each other, the validity of a series will be quickly determined on the basis of whether differences between the trade marks are within those specified in the three paragraphs of subsection 51(1). Any aspect or feature of the trade marks that do not comply with what is expressly provided in paragraphs (a), (b) and (c), however minor or insignificant, will render the series application as invalid.

**Paragraph 51(1)(a), (b), (c)**

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of goods and/or services if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark.

Developer Notes:

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)</p> <ul style="list-style-type: none"> <li>- Paragraph 51(1)(a) with examples</li> </ul> <p><b>Statements or representations as to the goods or services in relation to which the trade marks are to be used.</b></p> <p>The following are all examples of a <u>valid series</u> application:</p> <p>Example 1: Class 25 claim for Clothing, footwear, headgear.</p> <p style="padding-left: 40px;">IDAK CLOTHING IDAK FOOTWEAR IDAK HEADGEAR</p> <p>Example 2: Class 9 claim for Televisions.</p> <p style="padding-left: 40px;">IDAK TV IDAK TELEVISION</p> <p>Example 3 Class 25 claim for Clothing, footwear, headgear, and a Class 35 claim for Retailing of clothing, footwear and headgear</p> <p style="padding-left: 40px;">IDAK SHIRTS IDAK HATS IDAK SLIPPERS</p> <p>Example 4 Class 9 claim for Computer software</p> <p style="padding-left: 40px;">IDAK IDAK SOFTWARE</p> <p>(Note: This example is a valid series because the difference between the two trade marks is the word 'SOFTWARE' which is a statement as to the goods being claimed).</p> <p>The four examples provided show that, in effect, <u>descriptive</u> terms for the goods and/or services claimed will constitute being “statements or representations as to the goods or services” for the purposes of paragraph 51(1)(a). The statement or representation <u>must</u> be an obvious one</p>			<p>Slide Audio</p> <ul style="list-style-type: none"> <li>•</li> </ul>
			<p>Media</p> <ul style="list-style-type: none"> <li>•</li> </ul>
			<p>Navigation</p> <ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

whereby it is clear and apparent that there is a link between the statement/representation and the goods and/or services claimed. For example, a series application with the trade marks 'IDAK' and 'IDAK ORBITAL' for Class 44 Medical services would not comply since, despite the fact that the term 'ORBITAL' may have a reference to the orbital bone, it is not directly descriptive of the services claimed.

Developer Notes:

For the examples, I might use a graphic or animation to highlight the link between the wording of the specs and the allowed differences in the trade marks.

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)  - Paragraph 51(1)(b) with examples</p> <p><b><i>51(1)(b) statements or representations as to number, price, quality or names of places</i></b></p> <p><b>Number:</b></p> <p>Example 1  IDAK 1  IDAK 2</p> <p>Example 2  IDAK FIRST  IDAK 1ST</p> <p>Example 3  IDAK 2  IDAK TWO</p> <p>Example 4  IDAK ONE  IDAK TWO</p> <p>Example 5  IDAK 6 PACK  IDAK 6</p> <p>Example 6  IDAK one  IDAK TWO</p> <p>Note in the examples above, It does not matter in what manner the number is represented as long as it is a clear representation of a number.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>
Developer Notes:			

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)</p> <ul style="list-style-type: none"> <li>- Paragraph 51(1)(b) with examples – CONTINUED</li> </ul> <p><b>51(1)(b) statements or representations as to number, price, quality or names of places</b></p> <p><b>Price:</b></p> <p>Example 1</p> <ul style="list-style-type: none"> <li>IDAK \$2.00</li> <li>IDAK \$10.00</li> </ul> <p>Example 2</p> <ul style="list-style-type: none"> <li>IDAK £2.00</li> <li>IDAK \$10.00</li> <li>IDAK ¥500</li> </ul> <p>Note: For trade marks to comply in respect of representations as to price, only real currency and actual price can be used.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Navigation
Developer Notes:			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)</p> <ul style="list-style-type: none"> <li>- Paragraph 51(1)(b) with examples – CONTINUED</li> </ul> <p><b>51(1)(b) statements or representations as to number, price, quality or names of places</b></p> <p><b>Quality</b></p> <p>When considering quality the goods and services must be taken into account and research undertaken to ascertain whether the terms are ordinarily used to indicate quality in the relevant industry.</p> <p>Example 1</p> <ul style="list-style-type: none"> <li>IDAK STANDARD</li> <li>IDAK DELUXE</li> </ul> <p>Example 2</p> <ul style="list-style-type: none"> <li>IDAK SUPREME</li> <li>IDAK DELUXE</li> <li>IDAK PREMIER</li> </ul> <p>Example 3</p> <ul style="list-style-type: none"> <li>IDAK SUPERIOR</li> <li>IDAK DELUXE</li> <li>IDAK PREMIER!</li> </ul>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Navigation
Developer Notes:	<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>		

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)  - Paragraph 51(1)(b) with examples – CONTINUED</p> <p><b>51(1)(b) statements or representations as to number, price, quality or names of places</b></p> <p><b>Quality (cont'd)</b></p> <p>Example 4  Class 43 claim for Hotel accommodation,  Class 36 claim for Credit card services, and  Class 37 claim for Vehicle road service.</p> <p>    IDAK GOLD  IDAK SILVER  IDAK BRONZE</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>•</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)</p> <ul style="list-style-type: none"> <li>- Paragraph 51(1)(b) with examples – CONTINUED</li> </ul> <p><b>51(1)(b) statements or representations as to number, price, quality or names of places</b></p> <p><b>Names of places</b></p> <p>Example 1</p> <p>    IDAK PERTH     IDAK SYDNEY</p> <p>Example 2</p> <p>    IDAK     IDAK SYDNEY</p> <p>Example 3</p> <p>    PERTH IDAK     SYDNEY IDAK</p> <p>Example 4</p> <p>    IDAK NSW     IDAK NEW SOUTH WALES</p> <p>Example 5</p> <p>    IDAK     MELBOURNE IDAK</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Navigation
Developer Notes:	<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>		

Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)</p> <ul style="list-style-type: none"> <li>- Paragraph 51(1)(c) with examples</li> </ul> <p><b>51(1)(c) the colour of any part of the trade mark</b></p> <p>Example 1</p> <p>IDAK</p> <p><b>IDAK</b> [note: entire representation is red in colour]</p> <p>Example 2</p> <p>IDAK</p> <p><b>IDAK</b> [note: the letter A is red in colour]</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Navigation
Developer Notes:			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

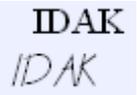
Project Name	Slide Number	Developer:	Date:
<p>Paragraph 51(1)  - Paragraph 51(1)(c) with examples – CONTINUED</p> <p>For trade marks that differ in respect of colours that are BLACK AND WHITE, consider the following three trade mark representations:</p>  <p>In this example, only the FIRST and SECOND trade marks constitute a valid series. This is because the <u>main outline or border</u> of a black and white representation in a series application which differs in respect of colour is allowable – this is to cater for the fact that, without the outline or border, the main identifying feature of the mark would not be visible. However, minor outlines as featured in the circular shapes within the third trade mark will not be considered as differences in respect of colour only. Discretion and common sense is to be used as to what constitutes the main outline of a black and white representation as determinations can often differ on a case-by-case basis. For complex matters, consultation with other series examiners is recommended.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>•</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b><i>Trade marks differing only in respect of one or more of the ways specified in paragraphs 51(1)(a), (b) and (c)</i></b></li> </ul> <p>Class 43 claim for Hotel accommodation.</p> <p>IDAK SYDNEY STANDARD 1 IDAK MELBOURNE DELUXE 2</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>•</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <i>Examples of trade marks that do <u>not</u> resemble each other in material particulars</i></li> </ul> <p>Example 1</p>  <p>Example 2</p> 		Slide Audio	
		<ul style="list-style-type: none"> <li>•</li> </ul>	
		Media	
		<ul style="list-style-type: none"> <li>•</li> </ul>	
Developer Notes:		Navigation	
		<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>	

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b><i>Examples of trade marks that do not resemble each other in material particulars</i></b> – CONTINUED</li> </ul> <p>Example 3</p> <p>IDAK Television  IDAK 1  IDAK \$2.00  IDAK STANDARD  IDAK SYDNEY</p> <p>Example 4: Class 25 claim for Clothing</p> <p>SYDNEY CLOTHING  MELBOURNE CLOTHING</p> <p>Note that in Example 4, the common word between the two trade marks is CLOTHING, which is a direct description of the goods claimed and does not have any prominent or distinctive qualities – thus the word does not constitute as a material particular.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)</b></li> </ul> <p>Example 1</p>  <p>Example 2</p> <p>IDAKS IDAKZ</p> <p>Example 3</p> <p>IDAK VIEW IDAKVIEW</p> <p>Example 4</p> <p>IDAKS IDACS</p> <p>Note in particular for Example 3, even the most trivial difference such as a space between the words would still not render the two trade marks as a valid series. A difference in word spacing is not expressly stated as being allowable under paragraphs 51(1)(a), (b) or (c).</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
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Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c) – CONTINUED</b></li> </ul> <p>Example 5 IDAK I.D.A.K</p> <p>Example 6  </p> <p>Example 7 IDAK I-DAK</p> <p>Note again in these examples, although the differences are minor, they are nonetheless differences that are not expressly allowable under paragraphs (a), (b) and (c).</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c) – CONTINUED</b></li> <li>- Examples under 51(1)(a)</li> </ul> <p>Example 1: Class 35 claim for Accounting</p> <p>IDAK ACCOUNTING IDAK MEDICAL</p> <p>The term ‘MEDICAL’ is not descriptive of accounting services.</p> <p>Example 2: Class 11 claim for Refrigerators</p> <p>IDAK REPAIRS IDAK REFRIGERATORS</p> <p>The term ‘REPAIRS’ is not descriptive of refrigerators and thus not a statement or representation of the goods claimed.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c) – CONTINUED</b></li> <li>- Examples under 51(1)(a)</li> </ul> <p>Example 3: Class 25 claim for Clothing, footwear, headgear Class 36 claim for Financial services</p> <p>IDAK SHIRTS IDAK HATS IDAK SLIPPERS IDAK LOANS IDAK HOME LOANS IDAK MORTGAGES</p> <p>In this example, while the terms ‘SHIRTS’, ‘HATS’ and ‘SLIPPERS’ are descriptive of the Class 25 claims, they are not so for the Class 36 claims. Likewise the terms ‘LOANS’, ‘HOME LOANS’ and ‘MORTGAGES’ are descriptive of the Class 36 claims, they are not for the Class 25 claims, and thus as a whole does not comply with paragraph 51(1)(a).</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <i>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)</i> – CONTINUED</li> <li>- Examples under 51(1)(b)</li> </ul> <p><b>Number</b></p> <p>Example 1            IDAK 2            IDAK TWICE</p> <p>'TWICE' is not a direct reference to number.</p> <p>Example 2            IDAK 6 pack            IDAK Unlimited</p> <p>'Unlimited' is not a direct reference to number.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <i>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)</i> – CONTINUED</li> <li>- Examples under 51(1)(b)</li> </ul> <p><b>Number</b></p> <p><b>Price</b></p> <p>Example 1</p> <p>    IDAK £</p> <p>    IDAK \$</p> <p>    IDAK ¥</p> <p>The symbols refer to currency rather than price.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c) – CONTINUED</b></li> <li>- Examples under 51(1)(b)</li> </ul> <p><b>Quality</b></p> <p>Example 1            IDAK DELUXE            IDAK BEGINNING</p> <p>‘BEGINNING’ is not a reference to quality.</p> <p>Example 2            Goods/Services-Class 30: Tea/coffee</p> <p>          IDAK PREMIUM            IDAK WEATHER PROOF</p> <p>‘WEATHER PROOF’ is not a reference to quality in relation to tea/coffee.</p> <p>Example 3            Goods/services- Class 31: Alfalfa sprouts</p> <p>          IDAK GOLD            IDAK SILVER            IDAK BRONZE</p> <p>‘GOLD’, ‘SILVER’ and ‘BRONZE’ are not references to quality in relation to alfalfa sprouts.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <i>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c)</i> – CONTINUED</li> <li>- Examples under 51(1)(b)</li> </ul> <p><b>Names of Places</b></p> <p>Example 1 IDAK MELBOURNE IDAK EAST</p> <p>'EAST' is not the name of a place.</p> <p>Example 2 IDAK GOLD COAST IDAK REGIONAL</p> <p>'REGIONAL' is not the name of a place.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Examples of trade marks that do not meet the provisions of 51(1)(a),(b) or (c) – CONTINUED</b></li> <li>- Examples under 51(1)(c)</li> <li>-</li> </ul> <p>51(1)(c)- the colour of any part of the trade mark</p> <p>Example Class 12 claim for Clutches for vehicles IDAK BLUE IDAK RED</p> <p>In this example, red and blue here are not the colour of any part of the trade mark. They are also not statement as to the goods, which are not ordinarily described in terms of colour.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples</p> <ul style="list-style-type: none"> <li>- <b>Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.</b></li> </ul> <p>Example 1 IDAK TV <b>IDAK</b> TELEVISION</p> <p>Made invalid by the enlarged script.</p> <p>Example 2 IDAK 1 IDAKS 2</p> <p>Made invalid by the differences in spelling.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples – CONTINUED from previous slide</p> <ul style="list-style-type: none"> <li>- <b>Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.</b></li> </ul> <p>Example 3            IDAK CLOTHING            idak FOOTWEAR</p> <p>Made invalid by the use of upper and lower case letters.</p> <p>Example 4            IDAK PERTH            PERTH IDAK</p> <p>Made invalid by the different order of words.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples – CONTINUED from previous slide</p> <ul style="list-style-type: none"> <li>- <b><i>Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.</i></b></li> </ul> <p>Example 5            IDAK 1  <u>IDAK 2</u></p> <p>Made invalid by the underline in the second trade mark.</p> <p>Example 6            IDAK \$2.00            IDAC \$10.00</p> <p>Made invalid by the differences in spelling.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Further examples – CONTINUED from previous slide</p> <ul style="list-style-type: none"> <li>- <b><i>Trade marks which resemble each other in material particulars, differ in one or more of the ways specified in paragraphs 51(1)(a),(b) or (c) but incorporate a further change that render them invalid series.</i></b></li> </ul> <p>Example 7</p> <p>IDAK STANDARD I DAK DELUXE</p> <p>Made invalid by the separation of the word IDAK in the second trade mark.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Click and reveal for each example.</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p><b><i>Divisional applications from series</i></b></p> <p>Where the series on the parent application is a valid series, divisional applications may be made in respect of the goods and/or services claimed in accordance with the general divisional provisions. The key point to remember is that the trade mark representations <u>must be the same</u> in respect of the parent and the divisional applications.</p>			Slide Audio
			•
			Media
			•
Developer Notes:			Navigation
			•

Project Name	Slide Number	Developer:	Date:
<p><b><i>Colour endorsements</i></b></p> <p>For series applications that differ in respect of colour, the Trade Marks Office had previously required the applicant to provide an endorsement describing the various colours that have been used on each trade mark representation. Colour endorsements written in acceptable format were provided as follows:</p> <p><i>The (first/second/coloured etc.) trade mark in the series of trade marks is depicted in the colour(s) ..... as shown in the representation attached to the application form.</i></p> <p>This requirement is no longer applicable to series applications.</p> <p>Where a series application is filed for trade marks which differ in respect of colour, a colour endorsement <u>will not be required</u>.</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>•</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Colour endorsements – CONTINUED</p> <p>Where a colour endorsement has been included, and the endorsement is unclear as to the nature of the trade marks being claimed and is not in a format that has been previously accepted, clarification will be sought by the examiner. If the colour endorsement does not restrict or limit the use of the trade mark to particular colours, deletion or amendment may be available. If however the colour endorsement does restrict or limit the use of the trade mark to particular colours, deletion of the endorsement is not available as this would expand the scope of the applicant's trade mark rights (s65(7)).</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>•</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p>Colour endorsements – CONTINUED</p> <p>Where a colour endorsement is present and does serve to restrict or limit the use of the trade mark to a particular colour or colours, an acceptable format is as follows:</p> <p><i>The trade mark registration is limited to the colours ..... and ..... as shown in the representation of the trade mark attached to the application form.</i></p> <p>Example 1                      Trade Mark : 1749951</p> <p>Example 2                      Trade Mark : 1763656</p> <p>Example 3                      Trade Mark : 1750992</p>			Slide Audio
			<ul style="list-style-type: none"> <li>•</li> </ul>
			Media
			<ul style="list-style-type: none"> <li>•</li> </ul>
Developer Notes:			Navigation
			<ul style="list-style-type: none"> <li>• Show examples as show/hides</li> </ul>

Project Name	Slide Number	Developer:	Date:
<p><b><i>So you've determined that a series application is invalid...</i></b></p> <p>It's not all doom and gloom for the applicant! Subsection 65(3) provides the following:</p> <p>(3) An amendment may be made to an application to which section 51 applies to remove one or more trade marks from the application.</p> <p>Accordingly, the applicant has the option to remove one or more trade marks not complying with the provisions of section 51. If there are no trade marks that comply with section 51, the applicant is given the option to select one trade mark to proceed as a standard application.</p> <p>In circumstances where the series is invalid due to the goods and/or services claimed, the applicant has the option to delete the 'offending' claim or claims in order for the series to be valid.</p> <p>For instance, if an application is made for IDAK CLOTHING and IDAK FOOTWEAR for Class 25 apparel and Class 36 accounting, the applicant has both these options available to them. They could delete Class 36 in order to keep the two trade marks as a series or to delete one of the two trade marks and continue with both Class 25 and Class 36 claims.</p> <p>Note: The applicant does <u>not</u> have the ability to rely upon subsection 65(2) to amend a trade mark or trade marks to render them as a valid series.</p>			Slide Audio
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Developer Notes:			Navigation
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**From:** [Timothy Brown](#)  
**To:** [Bogdan Mitic](#)  
**Subject:** Timothy Brown shared the folder "Cases" with you.  
**Date:** Wednesday, 10 November 2021 11:53:50 AM  
**Attachments:** [AttachedImage](#)  
[AttachedImage](#)  
[AttachedImage](#)  
[AttachedImage](#)  
[AttachedImage](#)



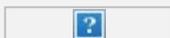
## Timothy Brown shared a folder with you

Here's the folder that Timothy Brown shared with you.

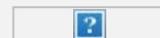


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# TRADE MARKS.

## No. 20 of 1955.

### An Act relating to Trade Marks.

[Assented to 15th June, 1955.]

**B**E it enacted by the Queen's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows :—

#### PART I.—PRELIMINARY.

1. This Act may be cited as the *Trade Marks Act 1955*. Short title.
  
2. This Act shall come into operation on a date to be fixed by Proclamation. Commencement.
  
3. This Act is divided into Parts, as follows :— Parts.
  - Part I.—Preliminary (Sections 1–9).
  - Part II.—Administration (Sections 10–13).
  - Part III.—The Register of Trade Marks (Sections 14–23).
  - Part IV.—Registrable Trade Marks (Sections 24–39).
  - Part V.—Applications for Registration (Sections 40–48).
  - Part VI.—Opposition to Registration (Sections 49–52).
  - Part VII.—Registration and Effect of Registration (Sections 53–68).
  - Part VIII.—Renewal of Registration (Sections 69–72).
  - Part IX.—Registered Users (Sections 73–81).
  - Part X.—Assignment of Trade Marks (Section 82).
  - Part XI.—Certification Trade Marks (Sections 83–92).
  - Part XII.—Defensive Trade Marks (Sections 93–97).
  - Part XIII.—Protection of Trade Marks (Sections 98–107).
  - Part XIV.—International Arrangements (Sections 108–110).
  - Part XV.—The Appeal Tribunal (Sections 111–116).
  - Part XVI.—Miscellaneous (Sections 117–147).
  
4. The Acts specified in the first column of the Schedule to this Act are repealed to the extent respectively specified in the second column of that Schedule. Repeal.

**Application of Act.**

5.—(1.) This Act applies to and in relation to applications for the registration of trade marks made after the commencement of this Act and to and in relation to trade marks registered on those applications.

(2.) Subject to section ninety of this Act, this Act also applies to and in relation to trade marks registered under the repealed Acts and those trade marks shall, subject to the next succeeding sub-section, be deemed to be registered in Part A of the Register.

(3.) The Registrar may, on the application of the registered proprietor of a trade mark referred to in the last preceding sub-section, transfer the trade mark from Part A to Part B of the Register.

(4.) Subject to section ninety of this Act, the repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of trade marks made before the commencement of this Act and to and in relation to the registration of trade marks on those applications, but this Act applies to and in relation to trade marks so registered and those trade marks shall, subject to the next succeeding sub-section, be deemed to be registered in Part A of the Register.

(5.) Before the acceptance of an application for the registration of a trade mark made before the commencement of this Act, the Registrar may, upon the request of the applicant, treat the application as an application for registration in Part B of the Register and deal with the application accordingly.

(6.) The repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of a person as the registered user of a trade mark made before the commencement of this Act and to and in relation to the registration of persons as registered users on those applications, but this Act applies to and in relation to persons so registered.

**Definitions.**

6.—(1.) In this Act, unless the contrary intention appears—

“assignment” means assignment by act of the parties concerned;

“Australia” includes the Territories of the Commonwealth to which this Act extends;

“Convention country” means a country in respect of which there is in force for the time being a Proclamation declaring that country to be a Convention country for the purposes of this Act;

“legal practitioner” means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory of the Commonwealth;

- “limitations” means limitations of the right to the exclusive use of a trade mark given by the registration of the trade mark, including limitations of that right as to—
- (a) mode of use ;
  - (b) use within a territorial area within Australia ; or
  - (c) use in relation to goods to be exported to a market outside Australia ;
- “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral, or any combination thereof ;
- “permitted use”, in relation to a registered trade mark, means the use of the trade mark—
- (a) by a registered user of the trade mark in relation to goods—
    - (i) with which he is connected in the course of trade ;
    - (ii) in respect of which the trade mark remains registered ; and
    - (iii) for which he is registered as a registered user ;and
  - (b) which complies with any conditions or restrictions to which his registration is subject ;
- “person” includes a body politic and a body of persons, whether corporate or unincorporate ;
- “registered proprietor”, in relation to a trade mark, means the person for the time being entered in the Register as proprietor of the trade mark ;
- “registered trade mark” means a trade mark which is registered under this Act ;
- “registered user” means a person who is registered as such under section seventy-four of this Act ;
- “the Deputy Registrar” means the Deputy Registrar of Trade Marks holding office under this Act ;
- “the expiration of the last registration”, in relation to a registered trade mark, means the date of the expiration of the original registration of the trade mark or of the last renewal of registration, as the case may be ;
- “the *Official Journal*” means the Official Journal referred to in section one hundred and seventy-five of the *Patents Act 1952-1955* ;

“ the Register ” means the Register of Trade Marks under this Act ;

“ the Registrar ” means the Registrar of Trade Marks holding office under this Act ;

“ the repealed Acts ” means the Acts repealed by this Act ;

“ this Act ” includes the regulations ;

“ trade mark ” means --

(a) except in relation to Part XI., a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the goods and a person who has the right, either as proprietor or as registered user, to use the mark, whether with or without an indication of the identity of that person ; and

(b) in relation to Part XI., a mark registrable, or registered, in Part C of the Register ;

“ transmission ” means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment ;

“ word ” includes an abbreviation of a word.

(2.) In this Act—

(a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark ; and

(b) references to the use of a mark in relation to goods shall be construed as references to the use of the mark upon, or in physical or other relation to, goods.

(3.) For the purposes of this Act, a trade mark shall be deemed to be deceptively similar to another trade mark if it so nearly resembles that other trade mark as to be likely to deceive or cause confusion.

**Crown to  
be bound.**

7. This Act binds the Crown in right of the Commonwealth and of the several States.

**Extension to  
Territories.**

8. This Act extends to Norfolk Island, the Territory of Papua and the Territory of New Guinea, as if each of those Territories were part of the Commonwealth, and no application for the registration of a trade mark is receivable under a law (other than this Act) in force in any of those Territories.

**No new  
application to  
be made under  
State Acts.**

9. An application for the registration of a trade mark under a State Act relating to the registration of trade marks is not receivable.

## PART II.—ADMINISTRATION.

**10.—(1.)** There shall be a Registrar of Trade Marks, who shall, under the Attorney-General, have the chief control of the Trade Marks Office. Registrar and other officers.

(2.) Until the Governor-General otherwise determines, the Commissioner of Patents shall be the Registrar of Trade Marks.

(3.) There shall be a Deputy Registrar of Trade Marks, who shall, subject to the control of the Registrar of Trade Marks, have all the powers and functions of the Registrar of Trade Marks under this Act, other than the powers of the Registrar under the next succeeding section.

(4.) Where, under this Act, the exercise of a power or function by the Registrar, or the operation of a provision of this Act, is dependent upon the opinion, belief or state of mind of the Registrar in relation to a matter, that power or function may be exercised by the Deputy Registrar, or that provision may operate, as the case may be, upon the opinion, belief or state of mind of the Deputy Registrar in relation to that matter.

(5.) There shall be one or more Assistant Registrars of Trade Marks.

(6.) There shall be so many Examiners of Trade Marks as are necessary.

(7.) Persons holding office as Examiners of Trade Marks at the commencement of this Act shall continue to hold that office.

**11.—(1.)** The Registrar of Trade Marks may, in relation to a particular matter or class of matters, by writing under his hand, delegate all or any of his powers or functions under this Act (except this power of delegation) to an Assistant Registrar of Trade Marks, so that the delegated powers and functions may be exercised by the delegate with respect to the matter or class of matters specified in the instrument of delegation. Delegation by Registrar.

(2.) A delegation under this section is revocable at will and does not prevent the exercise of a power or function by the Registrar of Trade Marks or by the Deputy Registrar of Trade Marks.

**12.—(1.)** For the purposes of this Act, there shall be an office which shall be known as the Trade Marks Office. Trade Marks Office and sub-offices.

(2.) There shall be a sub-office of the Trade Marks Office in each State.

(3.) A document required or permitted by this Act to be lodged at the Trade Marks Office may be lodged at a sub-office of the Trade Marks Office and a reference in this Act to lodgment at the Trade Marks Office includes a reference to lodgment at a sub-office of the Trade Marks Office.

**13.** There shall be a seal of the Trade Marks Office and impressions of the seal shall be judicially noticed. Seal of Trade Marks Office.

## PART III.—THE REGISTER OF TRADE MARKS.

Register of  
Trade Marks.

14.—(1.) There shall be kept at the Trade Marks Office a Register of Trade Marks, in which shall be entered—

- (a) particulars of registered trade marks ; and
- (b) such other matters as are prescribed.

(2.) The Register shall be divided into four parts, which shall be known as Part A, Part B, Part C and Part D, respectively.

(3.) Subject to the next succeeding sub-section, the Register of Trade Marks existing at the commencement of this Act shall be incorporated with and form part of Part A of the Register under this Act.

(4.) The Registrar shall transfer from Part A of the Register to Part C of the Register marks registered as standardization trade marks under the repealed Acts.

Trusts not  
to be  
noticed.

15. Notice of a trust, expressed, implied or constructive, shall not be entered in the Register or be received by the Registrar.

Inspection of  
Register.

16. The Register shall be open to the inspection of the public at all convenient times.

Register and  
certified  
copies to be  
evidence.

17.—(1.) The Register is evidence of all matters required or authorized by this Act to be entered in the Register.

(2.) The Registrar may, subject to this Act, supply copies of or extracts from the Register, or of or from a document or publication in the Trade Marks Office, certified by writing under his hand and the seal of the Trade Marks Office and a copy or extract so certified and sealed is admissible in evidence in all courts and proceedings without further proof or production of the original.

(3.) The Registrar may, subject to this Act, certify, by writing under his hand and the seal of the Trade Marks Office—

- (a) that an entry, matter or thing required by or under this Act or the repealed Acts to be made or done, or not to be made or done, has, or has not, as the case may be, been made or done ; or
- (b) that a book, document or publication in the Trade Marks Office was made available for public inspection in the Trade Marks Office on the date specified in the certificate,

and such a certificate is evidence of the statements contained in the certificate.

False entries  
in Register.

18. A person shall not wilfully—

- (a) make or cause to be made a false entry in the Register ; or
- (b) produce or tender in evidence a document falsely purporting to be a copy of or extract from an entry in the Register or of or from a document in the Trade Marks Office.

Penalty : Imprisonment for three years.

19.—(1.) The Registrar may, on application by the registered proprietor of a trade mark, amend or alter the Register by— Correction of Register.

- (a) correcting an error in the entry of a trade mark in the Register ;
- (b) entering a change in the name, address or description of the registered proprietor ;
- (c) cancelling the entry of a trade mark in the Register ;
- (d) amending the specification of the goods in respect of which the trade mark is registered but so that the amendment does not in any way extend the rights given by the registration of the trade mark ; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark,

and may make any consequential amendment or alteration in the certificate of registration, and for that purpose may require the certificate of registration to be produced to him.

(2.) The Registrar may, on request made by a registered user of a trade mark, correct an error, or enter a change, in the name, address or description of the registered user.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under sub-section (1.) of this section.

20.—(1.) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and of proof of title to his satisfaction, register that person as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect and cause particulars of the assignment or transmission to be entered in the Register. Registration of assignment.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) Except in the case of an appeal under this section or of an application under section twenty-two of this Act, a document or instrument in respect of which no entry has been made in the Register in accordance with the provisions of sub-section (1.) of this section is not, unless the court otherwise directs, admissible in evidence in a court in proof of a title to a registered trade mark.

21.—(1.) The registered proprietor of a trade mark may apply to the Registrar for leave to alter the trade mark in a manner not substantially affecting its identity and the Registrar may refuse the leave or grant it on such terms and subject to such conditions and limitations as he thinks fit. Alteration of registered trade mark.

(2.) The Registrar may cause an application under this section to be advertised in the *Official Journal* where it appears to him that it is desirable to do so.

(3.) A person may, within the prescribed time, give notice to the Registrar of opposition to the application and shall serve a copy of the notice on the applicant.

(4.) The Registrar shall, after hearing the parties, if desirous of being heard, decide the matter.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(6.) Where leave is granted, notice of leave having been granted shall be advertised in the *Official Journal* and the advertisement shall include the trade mark as altered unless the trade mark has already been advertised in the form to which it has been altered in an advertisement under sub-section (2.) of this section.

**Rectification  
of Register.**

**22.—(1.)** Subject to this Act, the High Court may, on the application of a person aggrieved or of the Registrar, order the rectification of the Register—

- (a) by the making of an entry wrongly omitted to be made in the Register ;
- (b) by the expunging or amendment of an entry wrongly made in or remaining in the Register ;
- (c) by the insertion in the Register of a condition or limitation affecting the registration of a trade mark which ought to be inserted ; or
- (d) by the correction of an error or defect in the Register.

(2.) On application to the High Court by a person aggrieved or by the Registrar, the High Court may make such order as it thinks fit for expunging or varying the registration of a trade mark, on the ground of a contravention of, or failure to observe, a condition or limitation entered in the Register in relation to the trade mark.

(3.) The power to order the rectification of the Register conferred by this section includes power to order the removal of a registration in Part A of the Register to Part B of the Register.

(4.) The Registrar shall not make application to the High Court under this section unless he considers the application desirable in the public interest.

(5.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(6.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

**23.**—(1.) Subject to this section and to section ninety-three of this Act, the High Court or the Registrar may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods in respect of which it is registered, on the ground—

Provisions as  
to non-use of  
trade mark.

- (a) that the trade mark was registered without an intention in good faith on the part of the applicant for registration that it should be used in relation to those goods by him or, if it was registered under sub-section (1.) of section forty-five of this Act, by the body corporate or registered user concerned, and that there has, in fact, been no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being earlier than one month before the application ; or
- (b) that, up to one month before the date of the application, a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods by the registered proprietor or a registered user of the trade mark for the time being.

(2.) Except where an applicant has been permitted under section thirty-four of this Act to register a substantially identical or deceptively similar trade mark in respect of the goods to which the application relates, or the High Court or the Registrar is of opinion that the applicant can properly be permitted to register such a trade mark, the High Court or the Registrar may refuse an application made under the last preceding sub-section in relation to any goods if there has been, before the relevant date or during the relevant period, as the case may be, use in good faith of the trade mark by the registered proprietor or a registered user of the trade mark for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(3.) Where, in relation to goods in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of sub-section (1.) of this section are shown as far as regards failure to use the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Australia (otherwise than for export from Australia), or in relation to goods to be exported to a particular market outside Australia ; and
- (b) a person has been permitted under section thirty-four of this Act to register a substantially identical or deceptively similar trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Australia), or in relation to goods to be

exported to that market, or the High Court or the Registrar is of opinion that that person might properly be permitted to register such a trade mark,

the High Court or the Registrar may, on application by that person, direct that the registration of the first-mentioned trade mark shall be subject to such conditions or limitations as the High Court or the Registrar thinks proper for securing that that registration shall cease to extend to use of the trade mark in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Australia), or in relation to goods to be exported to that market.

(4.) An applicant is not entitled to rely, for the purposes of paragraph (b) of sub-section (1.), or for the purposes of sub-section (3.), of this section, on failure to use a trade mark if the failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

(5.) Where proceedings concerning a trade mark are pending in a court, an application under this section shall not be made except to the High Court.

(6.) If the Registrar considers that an application made to him under this section ought to be decided by the High Court, he may refer the application to the High Court and the High Court may hear and determine the application as though it had been made to the High Court in the first instance.

(7.) An appeal lies to the Appeal Tribunal from an order or direction of the Registrar under this section.

(8.) An application to the High Court under this section shall be made as prescribed by Rules of Court and an application to the Registrar shall be made as prescribed by the regulations.

(9.) An office copy of an order of the High Court under this section shall be served on the Registrar who shall take such steps as are necessary to give effect to the order.

#### PART IV.—REGISTRABLE TRADE MARKS.

Registrable  
trade marks—  
Part A.

24.—(1.) A trade mark is registrable in Part A of the Register if it contains or consists of—

- (a) the name of a person represented in a special or particular manner ;
- (b) the signature of the applicant for registration or of some predecessor in his business ;
- (c) an invented word ;
- (d) a word not having direct reference to the character or quality of the goods in respect of which registration is sought and not being, according to its ordinary meaning, a geographical name or a surname ; or
- (e) any other distinctive mark.

(2.) A name, signature or word (not being a name, signature or word described in paragraph (a), (b), (c) or (d) of the last preceding sub-section) is not registrable in Part A of the Register unless it is, by evidence, shown to be distinctive.

(3.) A trade mark may be registered in Part A of the Register in respect of any goods notwithstanding the registration of the trade mark or of a part or parts of the trade mark in Part B of the Register, in the name of the same person, in respect of the same or different goods.

25.—(1.) A trade mark is registrable in Part B of the Register if it is distinctive, or is not distinctive but is capable of becoming distinctive, of goods in respect of which registration of the trade mark is sought and with which the applicant for registration is or may be connected in the course of trade.

Registrable  
trade marks—  
Part B.

(2.) A trade mark may be registered in Part B of the Register in respect of any goods notwithstanding the registration of the trade mark or of a part or parts of the trade mark in Part A of the Register, in the name of the same person, in respect of the same or different goods.

26.—(1.) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connexion subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations, in relation to use subject to those conditions or limitations.

Distinctiveness.

(2.) In determining whether a trade mark is distinctive, regard may be had to the extent to which—

- (a) the trade mark is inherently adapted so to distinguish ; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish.

(3.) Where—

- (a) an application for registration of a trade mark has been made by a person ;
- (b) before the date of the application, the trade mark was used by a person other than the applicant under the control of, and with the consent and authority of, the applicant ;
- (c) an application has been made by the applicant and that other person for the registration of that other person as a registered user of the trade mark ; and
- (d) the Registrar is satisfied that that other person is entitled to be registered as a registered user of the trade mark immediately after the registration of the trade mark,

the Registrar may, for the purpose of determining whether the trade mark is distinctive of the goods of the applicant, treat use of the trade mark by that other person as equivalent to use of the trade mark by

the applicant and may make an order that the trade mark is so distinctive.

(4.) An appeal lies to the Appeal Tribunal from an order of the Registrar under the last preceding sub-section.

(5.) Where an order is made under sub-section (3.) of this section that the trade mark is distinctive of the goods of the applicant, the registration of the trade mark shall cease to have effect if, at the expiration of the prescribed period or such further period, not exceeding six months, as the Registrar allows, that other person has not become registered as the registered user of the trade mark.

Trade marks  
in colour.

27.—(1.) A trade mark may be limited in whole or in part to one or more colours and, in that case, the fact that the trade mark is so limited shall be taken into consideration for the purpose of determining whether the trade mark is distinctive.

(2.) In so far as a trade mark is registered without limitation as to colour it shall be deemed to be registered for all colours.

Scandalous  
and improper  
marks.

28. A mark—

- (a) the use of which would be likely to deceive or cause confusion ;
- (b) the use of which would be contrary to law ;
- (c) which comprises or contains scandalous matter ; or
- (d) which would otherwise be not entitled to protection in a court of justice,

shall not be registered as a trade mark.

Registration  
may be  
refused of  
certain words,  
&c., in trade  
marks.

29.—(1.) The Registrar may refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as to be likely to be taken for that mark :—

- (a) the word or words “ Patent ”, “ Patented ”, “ By Royal Letters Patent ”, “ Registered ”, “ Registered Design ”, “ Copyright ”, “ To counterfeit this is a forgery ”, or a word or words to the like effect ;
- (b) a representation of the Sovereign or of a member of the Royal Family ;
- (c) a representation of—
  - (i) the Royal Arms, crests, armorial bearings, insignia or devices ;
  - (ii) any of the Royal crowns ; or
  - (iii) the national flag of a part of the Queen’s dominions ;
- (d) the word “ Royal ” or any other word, or any letters or device, likely to lead persons to think that the applicant has or has had Royal or Government patronage or authority ;
- (e) a representation of the Arms, or of any flag or seal, of the Commonwealth or of a State or Territory of the Commonwealth ;

- (f) a representation of the Arms or emblem of a city or town in Australia or of a public authority or public institution in Australia ;
- (g) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements ; or
- (h) a mark which is specified in the regulations as being, for the purposes of this section, a prohibited mark.

(2.) The regulations may provide that a mark in relation to which the last preceding sub-section applies (not being a registered trade mark or a mark in use in good faith as a trade mark) shall not be used as a trade mark or as part of a trade mark, either at all or after a date specified in the regulations.

**30.—(1.)** Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a living person or of a person believed by the Registrar to be living, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

Names, &c.,  
of living  
persons.

(2.) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a person recently dead, or of a person believed by the Registrar to be recently dead, the Registrar may require the applicant to furnish him with the consent of the legal representative of the deceased person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under either of the last two preceding sub-sections.

**31.—(1.)** A trade mark shall be registered in respect of any or all of the goods comprised in a prescribed class of goods.

Trade marks to  
be registered  
for particular  
goods.

(2.) If a question arises as to the class in which goods are comprised, that question shall be decided by the Registrar and the decision of the Registrar is not subject to appeal and shall not be called in question in an appeal or other proceedings under this Act.

**32.—(1.)** If a trade mark—

Disclaimer.

(a) contains parts—

- (i) which are not the subject of separate applications by the proprietor for registration as trade marks ; or
- (ii) which are not separately registered by the proprietor as trade marks ; or

(b) contains matter which is common to the trade or is otherwise not distinctive,

the Registrar, the Appeal Tribunal or the High Court, in deciding whether the trade mark shall be registered or shall remain upon the Register, may, in his or its discretion, require as a condition

that the proprietor shall disclaim any right to the exclusive use of any of those parts, or of that matter, to the exclusive use of which the Registrar, the Appeal Tribunal or the High Court holds the proprietor not to be entitled or that the proprietor shall make such other disclaimer as the Registrar, the Appeal Tribunal or the High Court considers to be proper for the purpose of defining the rights of the proprietor under the registration.

(2.) No such disclaimer affects the rights of the proprietor of the trade mark which do not arise out of the registration of the trade mark.

Identical  
marks.

**33.**—(1.) Subject to this Act, a trade mark is not capable of registration by a person in respect of goods if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same goods or of goods of the same description, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

(2.) The Registrar may defer acceptance of the application for registration of the first-mentioned trade mark until the second-mentioned trade mark has been registered.

Concurrent  
use.

**34.**—(1.) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, the Registrar may permit the registration of trade marks which are substantially identical or deceptively similar, or, but for the honest concurrent use or other special circumstances would be deceptively similar, for the same or different goods, by more than one proprietor subject to such conditions and limitations (if any) as the Registrar imposes.

(2.) Where a person has, by himself or his predecessors in business, continuously used a trade mark before the use, or before the date of registration, whichever is the earlier, of another registered trade mark by the registered proprietor of that other trade mark, by his predecessors in business or by a registered user of that other trade mark, the Registrar shall not refuse to register the first-mentioned trade mark by reason of the registration of that other trade mark.

Jointly  
owned trade  
marks.

**35.**—(1.) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others to use the trade mark except—

(a) on behalf of both or all of them ; or

(b) in relation to goods with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act has effect in relation to any rights of those persons to the use of the trade mark as if those rights were rights of a single person.

(2.) Subject to the last preceding sub-section, nothing in this Act authorizes the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

**36.—(1.)** Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods—

Association of  
trade marks.

- (a) is substantially identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or goods of the same description ; or
- (b) so nearly resembles such a trade mark as to be likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may, at any time, require that the trade marks shall be entered in the Register as associated trade marks.

(2.) On application made by the registered proprietor of two or more associated trade marks, the Registrar may, if he is satisfied that there would be no likelihood of deception or confusion being caused, dissolve the association with respect to one or more of those trade marks and amend the Register accordingly.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under either of the last two preceding sub-sections.

**37.** Associated trade marks are assignable or transmissible only as a whole and not separately, but, subject to this Act, they shall for all other purposes be deemed to have been registered as separate trade marks.

Assignment of  
associated  
trade marks.

**38.—(1.)** Where, under this Act, use of a trade mark is required to be proved for any purpose, the Registrar, the Appeal Tribunal or the High Court may, if and so far as he or it thinks right, accept use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting the identity of the trade mark, as an equivalent for the use required to be proved.

Use of  
trade marks  
whether  
associated or  
otherwise.

(2.) The use of the whole of a registered trade mark shall, for the purposes of this Act, be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor.

**39.—(1.)** Where a person who claims to be the proprietor of several trade marks for the same goods or for goods of the same description within a single class seeks to register those trade marks and the trade marks, although they resemble each other in material particulars, differ in respect of—

Series of  
trade marks.

- (a) statements or representations as to the goods in respect of which the trade marks are used or proposed to be used ;
- (b) statements or representations as to number, price, quality or names of places ;

(c) other matter which is not distinctive and does not substantially affect the identity of the trade marks ; or

(d) colour,

or in respect of any two or more of those matters, the trade marks may be registered as a series in one registration.

(2.) All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

#### PART V.—APPLICATIONS FOR REGISTRATION.

Application for registration.

40.—(1.) A person who claims to be the proprietor of a trade mark may make application to the Registrar for the registration of that trade mark in Part A or Part B of the Register.

(2.) The application—

(a) shall specify the goods in respect of which registration is sought ; and

(b) shall be lodged by being left at, or delivered by post to, the Trade Marks Office.

(3.) An application shall not be made in respect of goods comprised in more than one class.

Applications to be examined.

41. An Examiner shall, in respect of each application, ascertain and report whether—

(a) the application is as prescribed ; and

(b) the trade mark is capable of registration under this Act.

Action on Examiner's report.

42.—(1.) If the Examiner reports adversely to an application under the last preceding section, the applicant may amend the application so as to remove the grounds of objection and the amended application shall be again reported on in like manner as the original application.

(2.) If the applicant does not amend the application to the satisfaction of the Registrar, the Registrar may direct that the application be amended to his satisfaction within such time as the Registrar allows.

(3.) An amendment shall not be made or directed under either of the last two preceding sub-sections if the amendment would substantially affect the identity of the trade mark before amendment.

(4.) An appeal lies to the Appeal Tribunal from a direction of the Registrar under sub-section (2.) of this section.

Division of application.

43.—(1.) Where a part of a trade mark which is the subject of an application for registration is separately registrable as a trade mark, the applicant may, before the application has been accepted or refused, make a further application for the registration of that part in respect of goods in relation to which the first-mentioned application was made.

(2.) A further application so made shall, if the Registrar so directs, be deemed to have been lodged on the date on which the first-mentioned application was lodged.

(3.) Where an application has been made for registration of a trade mark in respect of certain goods and, before the application has been accepted or refused, the applicant has made a further application for the registration of that trade mark in respect of goods included in the description of goods in respect of which the first-mentioned application was made, the Registrar may direct that the further application shall be deemed to have been lodged on the date on which the first-mentioned application was lodged.

(4.) An appeal lies to the Appeal Tribunal from a direction of the Registrar under either of the last two preceding sub-sections.

44.—(1.) If the Registrar is satisfied that there is no lawful ground of objection to an application, or that the grounds of objection to an application have been removed, the Registrar shall accept the application without conditions or limitations or subject to such conditions or limitations as he thinks fit; if he is not so satisfied, he may refuse to accept the application.

Acceptance of application.

(2.) In the case of an application for registration of a trade mark in Part A of the Register, the Registrar may, with the consent of the applicant, instead of refusing to accept the application, treat the application as an application for registration in Part B of the Register and deal with the application accordingly.

(3.) Where, after the acceptance of an application for registration of a trade mark but before the registration of the trade mark, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations,

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted.

45.—(1.) An application for the registration of a trade mark may be accepted, and the trade mark may be registered, notwithstanding that the applicant does not use or propose to use the trade mark—

Application of may be accepted where trade mark is to be used by assignee or registered user.

- (a) if the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the body corporate with a view to the use by the body corporate of the trade mark in relation to the goods in respect of which registration is sought; or
- (b) if an application has been made for the registration of a person as a registered user of the trade mark and the Registrar is satisfied that the proprietor intends the trade mark to be

used by that person in relation to those goods and is also satisfied that that person will be registered as a registered user of the trade mark immediately after registration of the trade mark.

(2.) Where a trade mark is registered under the last preceding sub-section in the name of an applicant who relies on an intention to assign to a body corporate, then, unless within such period as is prescribed or within such further period, not exceeding six months, as the Registrar allows, the body corporate has been registered as the proprietor of the trade mark in respect of the goods in respect of which the trade mark is registered, the registration shall cease to have effect at the expiration of that period and the Registrar shall amend the Register accordingly.

**Appeals.**

46.—(1.) An appeal lies to the Appeal Tribunal from a refusal by the Registrar to accept an application or from the acceptance by the Registrar of an application subject to conditions or limitations.

(2.) The Registrar is entitled to appear and be heard upon the hearing of the appeal and shall appear if so directed by the Appeal Tribunal.

**Advertisement of acceptance.**

47. Where an application has been accepted, the Registrar shall give notice in writing of the acceptance to the applicant and shall advertise the acceptance in the *Official Journal*.

**Limit of time for proceeding with application.**

48.—(1.) Subject to this section, where an application has not been accepted within twelve months after the date on which the first report of the Examiner was sent to the applicant, the Registrar shall give notice of the non-acceptance to the applicant and if, at the expiration of one month from the date of the notice or at the expiration of such further time as the Registrar allows, the application has not been accepted, the application shall lapse.

(2.) Where an appeal under any of the provisions of this Act has been instituted in respect of an application, the Registrar shall not give notice of the non-acceptance of the application until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Appeal Tribunal allows.

(3.) Where—

- (a) the time within which an appeal mentioned in the last preceding sub-section may be instituted has not expired ; or
- (b) the applicant has died,

the Registrar shall not give notice of the non-acceptance of the application until such time as he determines.

(4.) Where acceptance of an application has been deferred under sub-section (2.) of section thirty-three of this Act, the Registrar shall not give notice of the non-acceptance of the application until the expiration of three months after the registration of the second-mentioned trade mark referred to in that sub-section.

## PART VI.—OPPOSITION TO REGISTRATION.

49.—(1.) A person may, within three months after the date of the advertisement of the acceptance of an application, or within such further period, not exceeding three months, as the Registrar, on application made to him within the first-mentioned period, allows, by notice in writing specifying the grounds of opposition and lodged at the Trade Marks Office, oppose the registration of the trade mark. Notice of opposition.

(2.) The opponent shall serve a copy of the notice on the applicant.

50.—(1.) The Registrar shall, after giving to the applicant and the opponent an opportunity of being heard, decide— Hearing of opposition.

(a) to refuse to register the trade mark;

(b) to register the trade mark subject to such conditions or limitations as he thinks fit; or

(c) to register the trade mark without conditions or limitations.

(2.) In determining the opposition the Registrar may take into account a ground of objection whether relied upon by the opponent or not.

51. The applicant or an opponent may appeal to the Appeal Tribunal from a decision of the Registrar under the last preceding section. Appeal to the Appeal Tribunal.

52. If a person giving notice of opposition neither resides nor carries on business in Australia, the Registrar may order him to give security for costs within a specified time and, if the order is not complied with, the opposition shall lapse. Security for costs.

## PART VII.—REGISTRATION AND EFFECT OF REGISTRATION.

53.—(1.) If there is no opposition to the registration of a trade mark, or, in the case of opposition, if the Registrar's decision, or the decision on appeal from that decision, is that the trade mark should be registered, the Registrar shall register the trade mark, in the name of the proprietor, in the appropriate part of the Register. Registration of trade mark.

(2.) Subject to this Act, a trade mark shall be registered as of the date of the lodging of the application for registration and that date shall be deemed for the purposes of this Act to be the date of registration.

54.—(1.) Subject to this section, a trade mark shall not be registered after twelve months from the date of the advertisement of the acceptance of the application. Time for registration.

(2.) Where the Registrar has allowed an extension of time within which notice of opposition to the registration of a trade mark may be given and notice of opposition has not been given, an extension of

time for the same period, or the aggregate of the periods, if more than one, after the period of twelve months referred to in the last preceding sub-section shall be allowed for the registration of the trade mark.

(3.) Where the registration of a trade mark is delayed by—

- (a) opposition to the registration of the trade mark ; or
- (b) an appeal to the Appeal Tribunal,

that trade mark may be registered within such time as—

- (c) in a case to which paragraph (a) of this sub-section applies— the Registrar directs ; or
- (d) in a case to which paragraph (b) of this sub-section applies— the Appeal Tribunal directs.

(4.) Where the applicant dies before the expiration of the time which would otherwise be allowed for registering a trade mark, the trade mark may be registered at any time within twelve months after his death or within such further period as the Registrar directs.

(5.) Where a trade mark cannot be registered within the time allowed by or under this section, that time may, on application made to the Registrar within the prescribed time, but subject to the regulations, be extended for such further time as is prescribed.

(6.) Where a trade mark has not been registered within the time which is applicable to it under this section the application shall lapse.

Duration of registration.

55.—(1.) Subject to the next succeeding sub-section, the registration of a trade mark as of a date after the commencement of this Act shall be for a period of seven years.

(2.) The registration of a trade mark as of a date before the commencement of this Act shall be for a period of fourteen years.

(3.) The registration of a trade mark may be renewed from time to time in accordance with Part VIII. of this Act.

Words used as name or description of an article or substance.

56.—(1.) Subject to this section, the registration of a trade mark does not become invalid by reason only of the use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance.

(2.) The succeeding sub-sections of this section have effect where—

- (a) there is a well-known and established use of a word as the name or description of an article or substance by a person or persons carrying on a trade in that article or substance, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or, in the case of a certification trade mark, in relation to goods certified by the proprietor ; or

(b) the article or substance was formerly manufactured under a patent, a period of two years or more after the patent has ceased has elapsed, and the word is the only practicable name or description of the article or substance.

(3.) If the trade mark consists solely of that word, the registration of the trade mark, so far as regards registration in respect of the article or substance or of any goods of the same description, shall be deemed for the purposes of section twenty-two of this Act to be an entry wrongly remaining in the Register.

(4.) If the trade mark contains that word and other matter, the High Court, in deciding whether the trade mark shall remain in the Register, so far as regards registration in respect of the article or substance or of any goods of the same description, may, in the case of a decision in favour of the trade mark remaining in the Register, require as a condition that the proprietor shall disclaim any right to the exclusive use of that word in relation to that article or substance or to any goods of the same description, but no such disclaimer affects any rights of the proprietor of the trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

(5.) For the purposes of any other legal proceedings relating to the trade mark—

(a) if the trade mark consists solely of that word, all rights of the registered proprietor to the exclusive use of the trade mark; or

(b) if the trade mark contains that word and other matter, all rights of the registered proprietor to the exclusive use of that word,

in relation to the article or substance or to any goods of the same description, shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of sub-section (2.) of this section first became well-known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that sub-section.

57.—(1.) Subject to this Act, the registered proprietor of a trade mark has, subject to any rights appearing from the Register to be vested in some other person, power to assign the trade mark and to give good discharges for any consideration for the assignment.

Powers of  
registered  
proprietor.

(2.) Equities in respect of a trade mark may be enforced in like manner as in respect of other personal property.

58.—(1.) Subject to this Act, the registration of a trade mark in Part A or Part B of the Register, if valid, gives to the registered proprietor of the trade mark the right to the exclusive use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

Rights given by  
registration.

(2.) The rights acquired by the registration of a trade mark are subject to any conditions or limitations to which the registration is subject.

(3.) Where two or more persons are proprietors of registered trade marks which are substantially identical or deceptively similar, whether for the same or different goods, rights of exclusive use of either of those trade marks are not (except so far as their respective rights have been defined by the Registrar, the Appeal Tribunal or a court) acquired by any one of those persons as against any other of those persons by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users) as he would have if he were the sole registered proprietor.

Registration  
evidence of  
validity.

59. In legal proceedings relating to a registered trade mark (including applications under section twenty-two of this Act), the original registration of the trade mark and the registration of any assignment or transmission of the trade mark shall be deemed to be valid unless the contrary is shown.

Limitation on  
removal of  
trade mark  
after three  
years.

60. In legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section twenty-two of this Act) instituted after the expiration of three years from the date of registration, the trade mark shall not be removed from the Register or be held invalid on the ground that it was not a registrable trade mark under section twenty-four of this Act, unless it is proved that it was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

Registration  
conclusive  
after seven  
years.

61. (1.) In legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section twenty-two of this Act), the original registration of the trade mark under this Act shall, after the expiration of seven years from the date of the original registration, be taken to be valid in all respects, unless it is shown—

- (a) that the original registration was obtained by fraud ;
- (b) that the trade mark offends against the provisions of section twenty-eight of this Act ; or
- (c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

(2.) Paragraph (c) of the last preceding sub-section does not apply to a trade mark registered before the commencement of this Act until after the expiration of three years from the commencement of this Act.

Infringement  
of trade marks.

62.—(1.) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user of the trade mark using by way of permitted use, uses a mark which is

substantially identical with, or deceptively similar to, the trade mark, in the course of trade, in relation to goods in respect of which the trade mark is registered.

(2.) In an action for infringement of a trade mark registered in Part B of the Register (not being an infringement occurring by reason of an act referred to in the next succeeding section), an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connexion in the course of trade between the goods in respect of which the trade mark is registered and a person having the right, either as registered proprietor or as registered user, to use the trade mark.

63.—(1.) Where, by notice upon goods or upon the container of goods, the registered proprietor or a registered user of a trade mark registered in Part A or Part B of the Register makes a statement prohibiting the doing of an act to which this section applies, a person who, being the owner for the time being of the goods, does that act, or authorizes it to be done in relation to the goods in the course of trade or with a view to a dealing with the goods in the course of trade, infringes the trade mark unless—

*Infringement  
of trade mark  
by breach of  
certain  
restrictions.*

- (a) at the time when that person agreed to buy the goods he acted in good faith without notice that the statement appeared on the goods; or
- (b) he became the owner of the goods by virtue of a title derived from another person who had so agreed to buy the goods.

(2.) The acts to which this section applies are—

- (a) the application of the trade mark upon goods after they have suffered alteration to their state, condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, partial removal or partial obliteration of the trade mark;
- (c) in the case in which the trade mark is upon the goods and there is also other matter upon the goods, being matter indicating a connexion in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partially, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of some other trade mark to the goods; and
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of other matter, in writing or otherwise, that is likely to injure the reputation of the trade mark.

(3.) In this section, references, in relation to goods, to the registered proprietor, to a registered user and to the registration of a trade mark shall be construed, respectively, as references to the registered proprietor of the trade mark, to a registered user of the trade mark and to the registration of the trade mark, in respect of those goods, and the expression "upon" includes, in relation to goods, a reference to physical relation to the goods.

Acts not  
constituting  
infringement.

64.—(1.) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of a trade mark :—

- (a) the use in good faith by a person of his own name or the name of his place of business or the name, or the name of the place of business, of any of his predecessors in business ;
- (b) the use in good faith by a person of a description of the character or quality of his goods ;
- (c) the use by a person of a trade mark in relation to goods in relation to which that person has, by himself or his predecessors in business, continuously used the trade mark from a date before—
  - (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark ; or
  - (ii) the registration of the trade mark, whichever is the earlier ;
- (d) the use of the trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the facts, a connexion in the course of trade between any person and the goods ; and
- (e) the use of a trade mark, being one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by this Act.

(2.) Where a trade mark is registered subject to conditions or limitations, the trade mark is not infringed by the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

Relief in  
infringement  
actions.

65. The relief which a court may grant in an action or proceeding for infringement of a registered trade mark includes an injunction (subject to such terms, if any, as the court thinks fit) and, except in the case of a trade mark registered in Part C of the Register, at the option of the plaintiff, either damages or an account of profits.

66. In an action or proceeding relating to a trade mark, evidence is admissible of the usages of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.

Evidence of  
trade usage

67. Jurisdiction is, by this section, conferred on the High Court to hear and determine an action or proceeding for the infringement of a trade mark, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding.

High Court, to  
have  
jurisdiction in  
infringement  
actions.

68. In an action for passing off arising out of the use by the defendant of a registered trade mark of which he is the registered proprietor or a registered user, being a trade mark substantially identical with, or deceptively similar to, the trade mark of the plaintiff, damages shall not be awarded against the defendant if he satisfies the court—

Passing off  
actions.

- (a) that at the time he commenced to use the trade mark he was unaware and had no reasonable means of ascertaining that the trade mark of the plaintiff was in use; and
- (b) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark in relation to goods in relation to which it was used by the plaintiff.

#### PART VIII.—RENEWAL OF REGISTRATION.

69. The Registrar shall, on application made by the registered proprietor of a trade mark within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the expiration of the last registration of the trade mark.

Renewal of  
registration.

70.—(1.) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice to the registered proprietor or his agent in Australia of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of the registration may be obtained.

Procedure on  
expiry of  
period of  
registration.

(2.) If, at the expiration of the time prescribed in that behalf, those conditions have not been complied with, the Registrar may remove the trade mark from the Register.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

71.—(1.) Where a trade mark has been removed from the Register for non-payment of the prescribed fee, the Registrar may, within twelve months from the date of expiration of the registration of the trade mark, if satisfied that it is just so to do, restore the trade mark to the Register, and renew the registration of the trade mark, either

Restoration of  
trade mark  
removed for  
non-payment  
of renewal fee.

generally or subject to such conditions or limitations as he sees fit to impose, for a period of fourteen years from the expiration of the last registration.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) Section one hundred and thirty of this Act does not apply in relation to sub-section (1.) of this section.

Status of  
un-renewed  
trade mark.

72. Where a trade mark has been removed from the Register for non-payment of the fee for renewal, the trade mark shall, for the purpose of an application for registration by another person lodged not later than twelve months next after the expiration of the last registration, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that—

(a) there has been no use in good faith of the trade mark during the two years immediately preceding the expiration of the last registration ; or

(b) no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

#### PART IX.—REGISTERED USERS.

Application  
of Part.

73. This Part applies only in relation to trade marks registered in Part A or Part B of the Register.

Registered  
users.

74.—(1.) Subject to this section, a person other than the registered proprietor of a trade mark may be registered as a registered user of that trade mark for all or any of the goods in respect of which the trade mark is registered.

(2.) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall apply in writing to the Registrar and shall furnish him with a statutory declaration made by the registered proprietor, or by some person authorized to act on his behalf and approved by the Registrar—

(a) giving particulars of the relationship, existing or proposed, between the registered proprietor and the proposed registered user, including particulars showing the degree of control by the registered proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user will be the sole registered user or that there will be any other restriction as to persons for whose registration as registered users application may be made ;

(b) stating the goods for which registration is proposed ;

(c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use or to any other matter ; and

(d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration of the period,

and with such further documents, information or evidence as is required under the regulations or by the Registrar.

(3.) Where the requirements of the last preceding sub-section have been complied with and the Registrar, after considering the documents, information and evidence furnished to him under that sub-section, is satisfied that, in all the circumstances, the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to conditions or restrictions which the Registrar thinks appropriate, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user for the goods as to which he is so satisfied, subject to those conditions or restrictions.

(4.) The Registrar shall not register a person as a registered user of a trade mark if it appears to him that the registration would tend to facilitate trafficking in the trade mark.

(5.) The Registrar may determine that the registration of a person as a registered user of a trade mark shall be for such period as, having regard to the information referred to in paragraph (d) of sub-section (2.) of this section, the Registrar thinks fit.

(6.) The Registrar may determine that the period of the registration of a person as a registered user of a trade mark shall commence on the date on which the application by that person for registration as a registered user was made.

(7.) The Registrar shall, if so required by an applicant under sub-section (2.) of this section, ensure that any document, information or evidence furnished for the purpose of that application (other than matter entered in the Register) is not disclosed to any other person except by order of the High Court.

75. Without affecting the operation of section twenty-two of this Act, the registration of a person as a registered user—

Variation, &c.,  
of registration.

(a) may be varied by the Registrar, on the application in writing of the registered proprietor, with respect to the goods for which, or with respect to any conditions or restrictions subject to which, the registration has effect ;

(b) may be extended by the Registrar, on the application in writing of the registered proprietor, for such period as the Registrar thinks fit ;

(c) may be cancelled by the Registrar on the application of the registered proprietor or of the registered user or of any other registered user of the trade mark : or

(d) may be cancelled by the Registrar on the application of a person on the ground—

- (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion ;
- (ii) that the registered proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration ; or
- (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

Cancellation  
of registration.

76. The Registrar may at any time cancel the registration of a person as a registered user of a trade mark for any goods in respect of which the trade mark is no longer registered.

Effect of  
permitted user.

77.—(1.) The permitted use of a registered trade mark shall be deemed to be use by the registered proprietor of the trade mark and shall be deemed not to be use by a person other than the registered proprietor, for the purposes of section twenty-three of this Act and for any other purpose for which use by the registered proprietor of the trade mark is material under this Act.

(2.) Where—

- (a) a person is registered as a registered user of a trade mark ;
- (b) there has been previous use (whether before or after the commencement of this Act) of the trade mark by that person ;  
and
- (c) that use is in relation to goods in respect of which that person is registered and, where he is registered subject to conditions or restrictions—
  - (i) that use complied substantially with those conditions or restrictions ; or
  - (ii) did not so comply but was not such as to be contrary to the public interest,

the last preceding sub-section has effect as if that previous use had been permitted use.

(3.) Neither the registration of a person as a registered user of a trade mark, nor the use by that person of the trade mark as a registered user, prejudices any of the rights arising at common law of the person who is the registered proprietor of the trade mark.

(4.) For the purpose of determining the rights arising at common law of the person who is the registered proprietor of a trade mark, the use of the trade mark by a registered user shall be deemed to

be use by that person and shall be deemed not to be use by a person other than that person.

78.—(1.) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call upon the registered proprietor to take proceedings for infringement of the trade mark, and, if the registered proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the registered proprietor and shall make the registered proprietor a defendant.

Infringement  
proceedings.

(2.) A registered proprietor so added as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

79. This Part does not confer on the registered user of a trade mark an assignable or transmissible right to the use of that trade mark.

Rights of  
registered user  
not assignable.

80. The Registrar shall not exercise a discretionary power under this Part adversely to a person without, if so required, giving to each person who will be affected by the exercise of the power an opportunity of being heard.

Hearing by  
Registrar.

81. An appeal lies to the Appeal Tribunal from a decision of the Registrar under this Part.

Appeals.

#### PART X.—ASSIGNMENT OF TRADE MARKS.

82.—(1.) Subject to this section, a registered trade mark may be assigned and transmitted with or without the goodwill of the business concerned in the goods in respect of which the trade mark is registered or of some of those goods.

Assignment  
and  
transmission of  
trade marks.

(2.) Subject to the next three succeeding sub-sections, an assignment of a registered trade mark without goodwill, whether before or after the commencement of this Act, is invalid if—

- (a) the trade mark was not at any time in use in good faith in Australia by the assignor or his predecessor in title ; or
- (b) a substantially identical or deceptively similar trade mark continues to be used by the assignor, after the assignment, in relation to other goods, where there exists a connexion in the course of trade between those goods and the assignor and where those goods are of the same description as those in respect of which the trade mark has been assigned, or of such a description that the public is likely to be deceived by the use of the trade mark by the assignor and assignee upon their respective goods.

(3.) Paragraph (a) of the last preceding sub-section does not apply where—

(a) the trade mark was registered with the intention that it should be assigned to a body corporate to be formed and the trade mark has been so assigned ; or

(b) the trade mark was registered with the intention that a person should be permitted to use it as a registered user and a registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used the trade mark within that period.

(4.) An assignment of a trade mark is not invalid if, at the date of the institution of the proceedings in which the validity of the assignment is called in question, the trade mark has come to denote to the public a connexion in the course of trade between the goods and the assignee to the exclusion of all other persons, or, if the registration is limited to a territory, to the exclusion of all other persons within that territory.

(5.) An assignment of a trade mark shall not be held to be invalid except in proceedings instituted within three years after the registration of the assignment.

(6.) If goods bearing a registered trade mark are purchased or acquired by a person, the sale of or other dealing in those goods by that person, or by a person claiming under or through him, is not an infringement of the trade mark by reason only of the trade mark having been assigned by the registered proprietor to some other person after the purchase or acquisition of those goods.

(7.) All rights subsisting in a trade mark (being a registered trade mark), whether under this Act or otherwise, shall be deemed to be assigned upon the registration of the assignment of the trade mark.

#### PART XI.—CERTIFICATION TRADE MARKS.

Certification  
trade marks.

83.—(1.) Where a mark is adapted in relation to goods to distinguish in the course of trade goods certified by a person, or by another person authorized by the first-mentioned person, in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified, the mark may, upon the application of the first-mentioned person, be registered in Part C of the Register, in the name of the applicant as proprietor, as a certification trade mark in respect of those goods.

(2.) A mark is not so registrable upon the application of a person who carries on a trade in goods of the kind certified.

(3.) In determining whether a mark is adapted so to distinguish in relation to goods, regard may be had to the extent to which—

(a) the mark is inherently adapted so to distinguish ; and

(b) by reason of the use of the mark or of any other circumstances, the mark has become adapted so to distinguish.

84.—(1.) Subject to this Act, the registration of a certification trade mark in Part C of the Register, if valid, gives to the registered proprietor the right to the exclusive use of the mark in relation to the goods in respect of which the mark is registered and to obtain relief in respect of infringement of the mark in the manner provided by this Act. Rights given by registration.

(2.) The right to the exclusive use of a certification trade mark given by registration is subject to any conditions or limitations entered in the Register and is not infringed by the use of the mark in relation to goods to be sold or otherwise traded in in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend.

(3.) The right to the exclusive use of a certification trade mark given by registration is not infringed by the use of the mark by a person in relation to goods certified by the registered proprietor of the certification trade mark if—

- (a) as to those goods or a bulk of which they form part, the registered proprietor, or another person in accordance with his authority under the rules governing the use of the mark, has applied the mark and has not subsequently removed or obliterated it; or
- (b) the registered proprietor has expressly or impliedly consented to the use of the mark.

(4.) The last preceding sub-section does not have effect in the case of use consisting of the application of a certification trade mark to goods, notwithstanding that they are such goods as are mentioned in that sub-section, if the application of the mark is contrary to the rules governing the use of the mark.

85.—(1.) An application for the registration of a mark as a certification trade mark under this Part shall be accompanied by draft rules for governing the use of the mark. Rules governing the use of certification trade marks.

(2.) The rules shall include provisions as to the cases in which the goods are to be certified and use of the certification trade mark authorized and may contain any other provisions which the Registrar requires or permits to be inserted in the rules (including provisions referring to a right of appeal to the Registrar against a refusal to certify goods or to authorize the use of the mark in accordance with the rules).

86.—(1.) Before accepting an application under this Part, the Registrar shall consider— Matters to be considered before acceptance.

- (a) whether the applicant or person authorized by him is competent to certify the goods in respect of which the mark is to be registered;

- (b) whether the draft rules are satisfactory ; and
- (c) whether the registration applied for would be to the public advantage.

(2.) Before accepting the application, the Registrar may require the applicant to make such amendments or modifications of the draft rules as he thinks proper.

(3.) An appeal lies to an Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

Alteration of rules.

**87.**—(1.) The rules governing the use of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(2.) An application under the last preceding sub-section shall be advertised as prescribed and is subject to opposition as prescribed.

Rectification of Register.

**88.**—(1.) The power to order the rectification of the Register conferred by section twenty-two of this Act extends, in relation to a certification trade mark, to rectification on the ground—

- (a) that the registered proprietor or person authorized by him is no longer competent, in relation to any of the goods in respect of which the mark is registered, to certify those goods ;
- (b) that it is no longer to the public advantage that the mark should be registered as a certification trade mark ;
- (c) that the registered proprietor has failed to observe a provision of the rules governing the use of the mark which he is required to observe ; or
- (d) that it is necessary, for the public advantage, that if the mark remains registered as a certification trade mark, the rules governing the use of the mark should be varied.

(2.) The High Court may, on the application of a person aggrieved or of the Registrar, make such order as it thinks fit for varying the rules governing the use of a certification trade mark.

(3.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(4.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

Certification trade marks not assignable.

**89.** A certification trade mark may be assigned or transmitted with the consent of the Registrar.

**90.—(1.)** The repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of standardization trade marks made before the commencement of this Act. Transitional provisions.

(2.) A mark registered on such an application shall be registered as a certification trade mark in Part C of the Register and this Act applies to and in relation to a certification trade mark so registered.

(3.) The Registrar may require an applicant under an application referred to in sub-section (1.) of this section to lodge at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(4.) Marks which, immediately before the commencement of this Act, were registered under the repealed Acts as standardization trade marks shall be deemed to be registered as certification trade marks in Part C of the Register.

(5.) The registered proprietor of such a mark may lodge, or may be required by the Registrar as a condition of the continuance of the registration to lodge, at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(6.) Where no rules have been lodged at the Trade Marks Office in respect of a certification trade mark registered under this section, this Part has effect in relation to that mark as if references in this Part to rules had been omitted.

**91.** Rules governing the use of certification trade marks shall be open to inspection in like manner as the Register. Rules to be open for inspection.

**92.** The provisions of this Act (other than sections twenty-three, twenty-four, twenty-five, twenty-six, thirty-six, thirty-seven and thirty-eight, sub-section (1.) of section forty, sections forty-five, fifty-eight, sixty and sixty-one, sub-section (2.) of section sixty-two, section sixty-three and Parts IX., X. and XII.) apply in relation to the registration of a mark as a certification trade mark under this Part and to a mark registered as a certification trade mark. Application of Act to certification trade mark.

#### PART XII.—DEFENSIVE TRADE MARKS.

**93.—(1.)** Where a trade mark registered in Part A of the Register has been used to such an extent in relation to all or any of the goods in respect of which it is registered that the use of the trade mark in relation to other goods would be likely to be taken as indicating a connexion between those other goods and the registered proprietor, the trade mark may, upon the application of the registered proprietor of the trade mark, be registered as a defensive trade mark in Part D of the Register, in the name of the applicant as proprietor, in respect of all or any of those other goods notwithstanding that he does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section twenty-three of this Act. Defensive registration of well-known trade marks.

(2.) A trade mark registered as a defensive trade mark in respect of goods is not liable to be removed from the Register under section twenty-three of this Act in respect of those goods.

(3.) A trade mark may be registered as a defensive trade mark in respect of goods notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods otherwise than as a defensive trade mark or may be registered in respect of goods otherwise than as a defensive trade mark notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods as a defensive trade mark.

(4.) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same person shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

Rectification  
of Register.

94.—(1.) The High Court may, on the application of a person aggrieved or of the Registrar, cancel the registration of a defensive trade mark in respect of all or any of the goods in respect of which it is registered, on the ground that the requirements of sub-section (1.) of the last preceding section are no longer satisfied.

(2.) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(3.) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

(4.) The powers conferred on the High Court by this section are in addition to the powers conferred by section twenty-two of this Act.

Cancellation  
by Registrar.

95. The Registrar may cancel the registration of a defensive trade mark where there is no longer a registration in the name of the registered proprietor of the defensive trade mark otherwise than as a defensive trade mark.

Rights given  
by registration.

96. Subject to this Act, the registration of a defensive trade mark in Part D of the Register, if valid, gives to the registered proprietor of the mark the right to obtain relief in respect of infringement of the mark in the manner provided by this Act.

Application  
of Act.

97. Subject to this Part, the provisions of this Act apply in relation to the registration of a trade mark as a defensive trade mark and to a trade mark registered as a defensive trade mark but it is not necessary for the registered proprietor of a defensive trade mark to prove use of the trade mark for the purpose of obtaining renewal of the registration.

## PART XIII.—PROTECTION OF TRADE MARKS.

98.—(1.) A person shall not—

Forgery, &c.,  
of trade marks.

- (a) forge a registered trade mark ;
- (b) falsely apply a registered trade mark to goods ;
- (c) make a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark ; or
- (d) dispose of or have in his possession a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark.

Penalty : Imprisonment for three years.

(2.) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

99.—(1.) A person shall not sell or expose for sale, or have in his possession for sale or for the purpose of trade or manufacture, goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Selling, &c.,  
goods with  
false marks.

Penalty : One hundred pounds.

(2.) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

100. A person shall not knowingly import into Australia goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Importing  
goods with  
false marks.

Penalty : One hundred pounds.

101. A person convicted of an offence against any of the last three preceding sections is liable, in addition to the punishment provided by those sections, to forfeit to the Commonwealth all goods by means of which, or in relation to which, the offence was committed.

Forfeiture of  
articles, &c.,  
on conviction.

102.—(1.) A person shall not aid, abet, counsel or procure, or be in any way, directly or indirectly, knowingly concerned in or party to the commission of an act outside Australia which, if it were committed in Australia, would be an offence against this Act.

Aiding and  
abetting  
offences.

Penalty : One hundred pounds.

(2.) The last preceding sub-section does not affect the operation of section five of the *Crimes Act* 1914–1955.

103.—(1.) Goods manufactured outside Australia and having applied to them a trade mark, being, or being substantially identical with, a registered trade mark the registered proprietor or a registered user of which is a manufacturer, dealer or trader in Australia, are,

Prohibition of  
importation of  
goods bearing  
Australian  
trade marks.

if the registered proprietor or registered user notifies the Comptroller-General of Customs in writing that he objects to the importation of the goods, prohibited to be imported and, if imported, may be seized as forfeited to the Commonwealth.

(2.) Subject to the regulations, the Comptroller-General of Customs, or on appeal from him the Minister of State for Trade and Customs, may, if in his opinion the contravention has not occurred either knowingly or negligently, permit goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General—

- (a) that the improper marks will be effectually removed from the goods ;
- (b) that such additions will be made as will render unobjectionable any mark applied to the goods ; or
- (c) that the goods will be forthwith exported.

(3.) The provisions of the *Customs Act* 1901–1954 apply to the seizure and forfeiture of goods under this section as if the goods were prohibited imports under that Act.

(4.) Before taking action under this section or permitting an officer to take action under this section, the Comptroller-General of Customs may require the person requesting the action to give security in accordance with the regulations.

Power to  
require  
information in  
respect of  
imported goods  
bearing  
fraudulent  
marks.

**104.**—(1.) Where goods which are liable to forfeiture under the last preceding section are imported into Australia and the Comptroller-General of Customs is, upon representations made to him, satisfied that the use of the trade mark is fraudulent, an officer of Customs may require the importer of the goods, or his agent, to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to Australia and the name and address of the person to whom the goods were sent in Australia.

(2.) The importer or his agent shall, within fourteen days, comply with the requirement.

Penalty : One hundred pounds.

(3.) Information obtained from the importer of the goods or his agent under this section, or from any other source, may be communicated by the Comptroller-General to the registered proprietor or registered user of the trade mark which is alleged to have been used or infringed.

Modification  
in relation to  
Territories.

**105.** The regulations may provide for the modification or adaptation of the provisions of the last two preceding sections in relation to a Territory of the Commonwealth to which the *Customs Act* 1901–1954 does not apply.

**106.**—(1.) A person shall be deemed to forge a registered trade mark—

**What deemed  
forgery of trade  
mark.**

- (a) if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, he makes the trade mark or a mark substantially identical with it ; or
- (b) if he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

(2.) In a prosecution for forging a trade mark, the burden of proving the assent of the registered proprietor or registered user lies on the defendant.

**107.**—(1.) A trade mark shall be deemed to be applied to goods if it is woven in, impressed on, worked into, or annexed or affixed to, the goods.

**When trade  
mark deemed  
applied.**

(2.) A trade mark shall be deemed to be applied to goods if—

- (a) it is applied to the goods themselves ;
- (b) it is applied to a covering, label, reel or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture ;
- (c) it is used in a manner likely to lead to the belief that it refers to or describes or designates the goods ; or
- (d) it is used in a sign, advertisement, invoice, wine list, catalogue, business letter, business paper, price list or other commercial document and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark as so used.

(3.) For the purposes of this section, “covering” includes a stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper, and “label” includes a band or ticket.

(4.) A registered trade mark shall be deemed to be falsely applied to goods if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, the trade mark or a mark substantially identical with it is applied to the goods.

(5.) In a prosecution for falsely applying a registered trade mark to goods, the burden of proving the assent of the registered proprietor or a registered user lies on the defendant.

#### PART XIV.—INTERNATIONAL ARRANGEMENTS.

**108.**—(1.) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement or engagement between the Commonwealth and another country, by Proclamation, declare that a country specified in the Proclamation is a Convention country for the purposes of this Act.

**Convention  
countries.**

(2.) The Governor-General may, by Proclamation, declare a part of the Queen's dominions which has made satisfactory provision for the protection, in that part, of trade marks to be a Convention country for the purposes of this Act.

(3.) Where the Governor-General, by Proclamation, declares that an application for the registration of a trade mark—

(a) is, in accordance with the terms of a treaty subsisting between two or more Convention countries, equivalent to an application made in one of those Convention countries, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country; or

(b) is, in accordance with the law of a Convention country, equivalent to an application made in that Convention country, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country.

Applications  
under  
International  
Conventions.

**109.**—(1.) Where a person has made an application for the registration of a trade mark in a Convention country and that person, or his legal representative or assignee, makes an application for the registration of the trade mark within six months after the date on which the application was made in the Convention country, the trade mark shall, if registered, be registered as of the date on which the application was made in the Convention country and that date shall, subject to sub-section (3.) of this section, be deemed for the purposes of this Act to be the date of registration.

(2.) Where applications have been made for the registration of a trade mark in two or more Convention countries, the period of six months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.

(3.) For the purposes of determining the period of registration of the trade mark, the date of registration of the trade mark shall be deemed to be the date on which the application for registration under this Act was made.

Manner of  
application  
under this  
Part.

**110.** An application for the registration of a trade mark under this Part shall be made and dealt with in the same manner as an application otherwise than under this Part.

#### PART XV.—THE APPEAL TRIBUNAL.

Appeal  
Tribunal.

**111.**—(1.) The High Court is the Appeal Tribunal for the purposes of this Act.

(2.) The High Court has jurisdiction to hear and determine appeals which lie to the Appeal Tribunal under this Act.

Jurisdiction to  
be exercised by  
single Justices.

**112.** The jurisdiction of the High Court as the Appeal Tribunal shall be exercised by a single Justice.

Intervention by  
Registrar.

**113.** The Appeal Tribunal may grant to the Registrar leave to intervene in an appeal to the Appeal Tribunal.

- 114.** Upon the hearing of an appeal, the Appeal Tribunal may— Powers of Appeal Tribunal.
- (a) admit further evidence, either orally or upon affidavit or otherwise ;
  - (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or upon affidavit or otherwise at the hearing before the Registrar ;
  - (c) order an issue of fact to be tried in such manner as it directs ;
  - (d) affirm, reverse or modify the decision, determination or direction appealed from ;
  - (e) give such judgment, or make such order, as in all the circumstances it thinks fit, or refuse to make an order ; and
  - (f) order a party to pay costs to another party.

**115.**—(1.) The Appeal Tribunal may state a case or reserve a question for the consideration of a Full Court of the High Court, or may direct a case or question to be argued before a Full Court of the High Court. Special case.

(2.) A Full Court of the High Court has jurisdiction to hear and determine the case or question.

**116.** A Full Court of the High Court has jurisdiction to hear and determine appeals from a judgment or order of the Appeal Tribunal with respect to which a Full Court of the High Court grants leave to appeal. Appeals.

#### PART XVI.—MISCELLANEOUS.

**117.**—(1.) The application in Australia of a trade mark to goods to be exported from Australia and any other act done in Australia in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Australia, would constitute use of a trade mark in Australia, shall, for the purposes of this Act, be deemed to constitute use of the trade mark in relation to those goods. Use of trade mark for export trade.

(2.) The last preceding sub-section shall be deemed to have had effect in relation to an act done before the date of the commencement of this Act as it has effect in relation to an act done after that date, but does not affect a determination of a court which has been made before that date or the determination of an appeal from a determination so made.

**118.** The use of a registered trade mark in relation to goods between which and the person using the trade mark a form of connexion in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of that person a different form of connexion in the course of trade subsisted or subsists. Trade mark not to be deemed to be deceptive or confusing in certain cases.

Powers of Registrar.

**119.** The Registrar may, for the purposes of this Act—

- (a) summon witnesses ;
- (b) receive evidence on oath, whether orally or otherwise ;
- (c) require the production of documents or articles ; and
- (d) award costs against a party to proceedings before him.

Disobedience to summons an offence.

**120.**—(1.) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons.

(2.) A person who has been required by the Registrar to produce a document or article shall not, without lawful excuse, and after tender of reasonable expenses, fail to produce the document or article.

Penalty : Fifty pounds.

Refusal to give evidence an offence.

**121.** A person who appears before the Registrar as a witness shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

Penalty : Fifty pounds.

Recovery of costs.

**122.** Costs awarded by the Registrar may, in default of payment, be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were awarded to the person in whose favour they were awarded.

Certificate of validity.

**123.** In an action or proceeding in which the validity of the registration of a trade mark is unsuccessfully disputed, the court may certify that the validity of the registration of the trade mark came in question and, if the court so certifies, then, in a subsequent action or proceeding in which the validity of the registration of the trade mark is disputed, the registered proprietor of the trade mark, on obtaining a final order or judgment in his favour, is entitled, unless the court trying the action or proceeding otherwise directs, to have his full costs, charges and expenses as between solicitor and client.

Groundless threats of legal proceedings.

**124.**—(1.) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a trade mark which is registered, or alleged by the first-mentioned person to be registered, or some other like proceeding, a person aggrieved may, whether the person making the threats is or is not the registered proprietor or the registered user of the trade mark, bring an action against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the trade mark is registered

and that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute, an infringement of the trade mark.

(2.) The last preceding sub-section does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of sub-section (1.) of section seventy-eight of this Act, with due diligence commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3.) Nothing in this section renders a legal practitioner or a patent attorney liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4.) Jurisdiction is, by this section, conferred on the High Court to hear and determine an action under this section, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action.

**125.** The defendant in an action or proceeding under the last preceding section may apply, by way of counter-claim, for relief to which he would be entitled in a separate action in respect of an infringement by the plaintiff of the trade mark to which the threats relate and in that case the provisions of this Act with respect to an action for infringement of a trade mark are, *mutatis mutandis*, applicable in relation to that action.

Counter-claim  
by defendant  
for  
infringement.

**126.** In an indictment, information, pleading or proceeding in relation to a registered trade mark, it is not necessary to set out a copy or facsimile of the trade mark or a description of it, but the trade mark may be referred to as a registered trade mark and identified by its registered number.

Description  
of trade marks  
in pleadings.

**127.—(1.)** The Registrar may, on such terms as to costs or otherwise as he thinks just—

Power of  
amendment.

- (a) whether for the purpose of correcting a clerical error or an obvious mistake or otherwise, permit the amendment of an application for the registration of a trade mark, a notice of opposition or other document lodged at the Trade Marks Office; or
- (b) for the purpose of correcting a clerical error or an obvious mistake, amend the Register or a certificate of registration of a trade mark.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3.) An amendment of an application shall not be permitted under this section if the amendment would substantially affect the identity of the trade mark as specified in the application before amendment.

Exercise of  
discretionary  
power by  
Registrar.

**128.** Where a discretionary power is, by this Act, given to the Registrar, he shall not exercise that power adversely to a person applying for the exercise of that power without (if so required by that person within such time as is specified by the Registrar) giving to that person an opportunity of being heard.

Fees.

**129.**—(1.) There shall be paid to the Registrar such fees as are prescribed.

(2.) Where—

- (a) a fee is payable in respect of the doing of an act by the Registrar, the Registrar shall not do that act until the fee has been paid ;
- (b) a fee is payable in respect of the doing of an act by a person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid ; or
- (c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

Extension of  
time.

**130.** Where, by this Act, a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

Power to extend  
times by reason  
of errors in  
Trade Marks  
Office, &c.

**131.**—(1.) Where, by reason of—

- (a) circumstances beyond the control of the person concerned ; or
- (b) an error or action on the part of an officer or person employed in the Trade Marks Office,

an act or step in relation to an application for the registration of a trade mark or in proceedings under this Act (not being proceedings in a court) required to be done or taken within a certain time has not been so done or taken, the Registrar may extend the time for doing the act or taking the step and permit the act to be done or the step to be taken.

(2.) The time required for doing an act or taking a step may be extended under this section although that time has expired.

Address for  
service.

**132.**—(1.) An address for service stated in an application or notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or opponent, as the case may be.

(2.) An address for service may be changed by notice in writing to the Registrar.

(3.) The registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in his address, and request him to enter the change in the Register, and the Registrar shall alter the Register accordingly.

(4.) The address of the registered proprietor of a trade mark, as appearing for the time being in the Register, shall for all purposes under this Act be deemed to be the address of the registered proprietor.

**133.** If a person is, by reason of infancy, lunacy or other disability, incapable of making a declaration or doing anything required or permitted by this Act, the guardian or committee of the incapable person, or if there is no such guardian or committee, a person appointed by a court, or a Justice or Judge of a court, of the Commonwealth or of a State or Territory of the Commonwealth possessing jurisdiction in respect of the property of incapable persons, upon the petition of a person on behalf of the incapable person, or of some other person interested in the making of the declaration or the doing of the thing, may make the declaration (or a declaration as nearly corresponding to the declaration as the circumstances permit) and may do that thing, in the name and on behalf of the incapable person and all acts so done are, for the purposes of this Act, as effectually done as if they had been done by the incapable person and that person had not been incapable at the time of the making of the declaration or the doing of the thing.

Declaration  
by Infant,  
lunatic, &c.

**134.** If a person who is party to a proceeding under this Act (not being a proceeding in a court) dies pending the proceeding, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

Death of  
party to a  
proceeding.

**135.—(1.)** Subject to section one hundred and thirty-eight of this Act, a person shall not, for gain—

- (a) apply for or obtain the registration of a trade mark ;
- (b) prepare, or cause to be lodged at the Trade Marks Office, or at a sub-office of the Trade Marks Office, a document necessary for obtaining or opposing the registration of a trade mark ;
- (c) give advice as to the validity of the registration of a trade mark or as to the infringement of a trade mark,

Unauthorized  
persons not to  
act in trade  
mark matters.

unless he is—

- (d) a legal practitioner ;
- (e) a registered patent attorney ;
- (f) the applicant or the opponent concerned ;
- (g) a person in the sole and permanent employment of the applicant or the opponent concerned ;
- (h) a person who, within one year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of two years immediately before the first day of January, One thousand nine hundred and fifty-five, he was practising as a trade marks agent in Australia ; or

(i) a person who—

(i) within one year after the commencement of this Act, has satisfied the Registrar that, for a continuous period of two years immediately before the first day of January, One thousand nine hundred and fifty-five, he was employed by a registered patent attorney in Australia and his duties related solely or principally to the lodging, prosecuting and opposing of applications for the registration of trade marks ; and

(ii) unless the Registrar otherwise directs, has, within one year after the commencement of this Act or within such further time as the Registrar allows, passed the prescribed examination.

Penalty : One hundred pounds.

(2.) For the purpose of paragraph (h) of the last preceding subsection, a person shall not be deemed to have practised as a trade marks agent unless the only or the principal business carried on by him was the business of lodging, prosecuting and opposing, for gain, applications for the registration of trade marks in Australia on behalf of applicants or opponents.

Privileges of  
patent  
attorneys.

**136.**—(1.) A patent attorney—

(a) is entitled to prepare documents, transact business and conduct proceedings for the purposes of this Act ; and

(b) has such other rights and privileges as are prescribed.

(2.) Nothing in this section authorizes a patent attorney to prepare a document which is to be issued from or filed in a court or to transact business or to conduct proceedings in a court.

Unregistered  
persons not to  
describe  
themselves as  
trade marks  
agents.

**137.**—(1.) Subject to the next succeeding section—

(a) a person shall not describe himself or hold himself out, or permit himself to be described or held out, as a trade marks attorney, trade marks agent or agent for obtaining the registration of trade marks, unless he is a legal practitioner, registered as a patent attorney or a person referred to in paragraph (h) or (i) of sub-section (1.) of section one hundred and thirty-five of this Act ; or

(b) the members of a partnership shall not describe themselves or hold themselves out, or permit themselves to be described or held out, as trade marks attorneys, trade marks agents or agents for obtaining the registration of trade marks, unless each member of the partnership is so registered, is a legal practitioner or is a person referred to in paragraph (h) or (i) of sub-section (1.) of section one hundred and thirty-five of this Act.

Penalty : One hundred pounds.

(2.) A company shall not describe itself or hold itself out, or permit itself to be described or held out, as a trade marks attorney, trade marks agent or agent for obtaining the registration of trade marks.

Penalty : One hundred pounds.

(3.) A director, manager, secretary or other officer of a company which is guilty of an offence against the last preceding sub-section who is knowingly a party to the offence is guilty of an offence punishable, upon conviction, by a fine not exceeding One hundred pounds.

**138.** It is not an offence against section one hundred and thirty-five or section one hundred and thirty-seven of this Act if the legal representative of a deceased patent attorney carries on the business or practice of that deceased patent attorney for a period not exceeding three years from the death of the patent attorney, or, in the case of a patent attorney who died before the date of commencement of the *Patents Act 1952*, for a period of three years from that date, or, in either case, for such further period (if any) as the High Court allows, and is himself a patent attorney or a person entitled to practise as a patent attorney, or employs a patent attorney, or a person entitled to practise as a patent attorney, to manage that business or practice on his behalf.

Carrying on  
business of  
deceased  
patent  
attorney

**139.—(1.)** The regulations may make provision for the amendment of the Register, whether by making, expunging or varying entries in the Register, for the purpose of adapting the designation in the Register of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification of goods which is prescribed.

Adaptation of  
classification.

(2.) An amendment for the purpose referred to in the last preceding sub-section shall not be made if it would have the effect of adding goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of goods.

(3.) The last preceding sub-section does not have effect in relation to goods as to which the Registrar is satisfied—

- (a) that compliance with that sub-section in relation to those goods would involve undue complexity ; and
- (b) that the addition or antedating, as the case may be, would not affect a substantial quantity of goods and would not substantially prejudice the rights of any person.

(4.) A proposal for the amendment of the Register for the purpose referred to in sub-section (1.) of this section—

- (a) shall be notified to the registered proprietor of the trade mark affected ;
- (b) shall be advertised in the *Official Journal* ; and

(c) may be opposed before the Registrar by a person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1.) of this section.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Registrar under this section.

Making and signing of applications.

**140.** Where, by this Act, an application or notice is required or permitted to be made or signed by a person, that application or notice may be made or signed, on behalf of that person, by a patent attorney, legal practitioner or person entitled to practise as a trade marks agent.

Examiners' reports to be communicated.

**141.** A copy of each report of an Examiner under this Act shall be sent to the applicant or registered proprietor of the trade mark concerned, as the case requires.

Security for costs.

**142.** If a person who appeals to the Appeal Tribunal neither resides nor carries on business in Australia, the Appeal Tribunal may require that person to give security for the costs of the appeal, and in default of security being given to the satisfaction of the Appeal Tribunal, the appeal may be dismissed.

Costs of attendance of patent attorney.

**143.** Where, at the hearing of an action or proceeding under this Act, a patent attorney attends in court for the purpose of assisting a party in the conduct of the hearing and an order is made for payment of the costs of that party, those costs may include an allowance in respect of that attendance.

Service of orders on appeal.

**144.**—(1.) Where by this Act provision is made for the service on the Registrar of a judgment or order of a court, and an order is made by the Queen in Council, or by a court, on appeal from such a judgment or order, a person in whose favour the order on appeal is made is not entitled to enforce the order until he has served on the Registrar an office copy of the order.

(2.) Upon the service on him of such an order, the Registrar shall make such entries (if any) in the Register, or take such other action (if any), as the case requires.

Improperly describing an office as the Trade Marks Office.

**145.**—(1.) A person shall not use, in connexion with his business, words which would reasonably lead to the belief that his office is, or is officially connected with, the Trade Marks Office.

Penalty : Twenty pounds.

(2.) Without limiting the effect or application of the last preceding sub-section, a person who—

(a) places, or suffers or permits to be placed, on the building in which his office is situated ;

(b) uses in advertising his office or business ; or

(c) places on a document, as a description of his office or business, the words " Trade Marks Office ", the words " Office for registering trade marks ", or words of similar import, whether alone or in conjunction with other words, shall be deemed to use, in connexion with

his business, words which would reasonably lead to the belief that his office is the Trade Marks Office.

**146.**—(1.) A person shall not make a representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark ;
- (b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark, to the effect that it is so registered ;
- (c) to the effect that a registered trade mark is registered in respect of goods in respect of which it is not registered ; or
- (d) to the effect that the registration of a trade mark gives a right to the exclusive use of the trade mark in circumstances in which, having regard to conditions or limitations entered on the Register, the registration does not give that right.

Falsely  
representing  
a trade mark  
as registered  
an offence.

Penalty : Fifty pounds.

(2.) For the purposes of this section, the use in Australia, in relation to a trade mark, of the word “ registered ”, or of some other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration under this Act, except—

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated, and indicating that the reference is to registration as a trade mark under the law of a country outside Australia, being a country under the law of which the registration referred to is in force ;
- (b) where that word (being a word other than the word “ registered ”) is of itself such as to indicate that the reference is to such registration as is referred to in the last preceding paragraph ; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Australia and in relation to goods to be exported to that country.

**147.** The Governor-General may make regulations, not inconsistent with this Act, prescribing all matters which by this Act are required or permitted to be prescribed, or which are necessary or convenient to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the Trade Marks Office, and in particular—

Regulations.

- (a) for providing for the destruction of documents relating to trade marks the registration of which has ceased not less than twenty-five years before the time of destruction ; and
- (b) for prescribing penalties not exceeding a fine of Fifty pounds or imprisonment for six months for offences against the regulations.

## THE SCHEDULE.

Section 4.

FIRST COLUMN. Acts Repealed.	SECOND COLUMN. Extent of Repeal.
<i>Trade Marks Act 1905</i> .. .. .	The whole
<i>Patents Trade Marks and Designs Act 1910</i> .. .. .	Section 4
<i>Trade Marks Act 1912</i> .. .. .	The whole
<i>Trade Marks Act 1919</i> .. .. .	The whole
<i>Trade Marks Act 1922</i> .. .. .	The whole
<i>Trade Marks Act 1936</i> .. .. .	The whole
<i>Trade Marks Act 1948</i> .. .. .	The whole

**TOTAL RUBBER SERVICES (AUST) PTY LTD v MOONEY**

5 **Opposition by Total Rubber Services (Aust) Pty Ltd to registration of trade mark application No 739458 TOTAL HOSE — THE HOSE TECHNICIAN logo**

T WILLIAMS (Hearing Officer)

10 29 June 2001 — Canberra

**Trade marks — Application — Opposition — Registration — Citation — Deceptively similar — Prior use — Confusion — Reputation — Evidence — (CTH) Trade Marks Act 1995 ss 44, 51, 60.**

15 Diana Beth Mooney (the applicant) applied to register as a trade mark a logo which consisted of the words TOTAL HOSE — THE HOSE TECHNICIAN surrounded by a hose device. The services covered by the application were repair, installation and maintenance services for all kinds of hoses. The examiner objected to the application on the ground that it was deceptively similar to a prior trade mark registered for rubber and PVC hose. The registration was for the words “Total Hose” and was owned by Total Rubber Services (Aust) Pty Ltd. The applicant provided evidence which showed that it had used its logo continuously from a date earlier than the priority date of the cited registration. Following acceptance of the mark under s 44(4) on the basis of prior use, the owner of the cited mark (the opponent) filed an opposition. Opposition was based largely on the application being deceptively similar to a prior registration for closely related goods, and to a mark which had acquired a reputation in Australia prior to the application’s filing date..

25 **Held**, directing that the application be registered:

(i) While the applicant’s device mark and the registered mark TOTAL HOSE were deceptively similar and covered closely related goods and services, s 44(4) had been properly applied. The applicant’s evidence showed that it had continuously used its device mark from a date earlier than the priority date of the prior registration for TOTAL HOSE.

30 (ii) The applicant’s device mark was deceptively similar to both the opponent’s unregistered word mark TOTAL and to the opponent’s prior registered word mark TOTAL HOSE.

35 *Sports Café Ltd v Registrar of Trade Marks* (1998) 42 IPR 552, followed.

*Registrar of Trade Marks v Woolworths* (1999) 45 IPR 411, distinguished.

(iii) While the opponent’s sales and advertising expenditure for hoses was impressive, not all those hoses were sold under the TOTAL or TOTAL HOSE marks.

40 (iv) While the opponent’s declarants’ evidence showed it had a reputation in the trade mark TOTAL in 1999 when they made their declarations, the evidence said nothing about reputation in July 1997, the filing date for the applicant’s mark.

(v) The mark primarily used by the opponent for retailing of hoses was not TOTAL or TOTAL HOSE, but TOTAL RUBBER SERVICES or its company name Total Rubber Services (Aust) Pty Ltd.

45 (vi) Accordingly, the opponent had not established a reputation in the marks TOTAL or TOTAL HOSE at the applicant’s priority date with the required degree of clarity.

(vii) While “Total” could be used descriptively, it was a word that was inherently adapted to distinguish. Although the opponent had sometimes used it descriptively to create a play on words, the opponent had also used TOTAL as a trade mark.

50 (viii) Section 60 was not merely a recasting of s 44 without stipulations as to the registration of the allegedly conflicting mark or the overlap of the competing goods or services.

(ix) To succeed under s 60, in addition to the possibilities for conflict inherent where there had been acceptance on the basis of prior continuous use, deception or confusion had to be not only possible but sufficiently likely, and it had to be attributable to a reputation in the conflicting mark.

(x) There was not a significant risk of deception or confusion attributable to the reputation of the TOTAL or TOTAL HOSE marks at the priority date of the applicant's mark.

(xi) In deciding deceptive similarity under s 60, a mark's reputation was not to be taken into account. However, the fact it was used in a slightly different activity was a relevant surrounding circumstance that could be considered.

*Re Application by Pianotist Co Ltd (1906) 23 RPC 774; Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd (1952) 86 CLR 536, applied.*

(xii) The opponent's mark TOTAL RUBBER SERVICES was not deceptively similar to the applicant's device mark.

(xiii) Costs awarded to the applicant.

### Opposition

This was a hearing of an opposition to registration of a trade mark application. The facts appear in the decision.

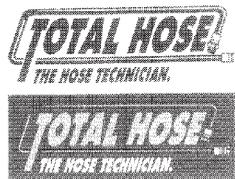
*S Thompson* instructed by *W Chandler of Pipers, Trade Mark Attorneys* for the opponent.

*B Fitzpatrick* instructed by *L Meston-Watson of Minter Ellison* for the applicant.

**T Williams** (Hearing Officer).

### Background

Total Hose (Aust) Pty Ltd filed trade mark application No 739458 on 17 July 1997. Registration is sought for two trade marks, to be registered as a series under s 51 of the Trade Marks Act 1995 (Cth) (the Act). The second trade mark is essentially a version of the first, limited to specific colours, yellow and red on a blue background. In black and white, the two trade marks are depicted:



Since the difference is immaterial for present purposes I will, in what follows, deal with the marks as though they were one.

The services specified, in class 37 of the International (Nice) Classification of Goods and Services, are: "Repair, installation and maintenance services, being repair, installation and maintenance services in connection with hoses of all kinds, functions and materials."

The Trade Marks Office (the TMO) examined the application and objected that it was, in simple terms, too close to an earlier trade mark, TOTAL HOSE, registered by another person, Total Rubber Services (Aust) Pty Ltd. The conflicting

trademark is registered as No 676460. It is registered in class 17, for rubber and PVC hose, and has a priority date of 30 October 1995.

5 The applicant for registration provided evidence that it had used its trade mark continuously from a date earlier than the priority date of the conflicting registration. This, the applicant argued, triggered the provisions of s 44(4) of the act and authorised acceptance of the application.

A delegate of the Registrar of Trade Marks, after considering the evidence put in by the applicant, accepted the application for registration. The TMO advertised the pending registration and, as is usual in such cases, advised the earlier registration's owner of this fact. That owner, Total Rubber Services (Aust) Pty Ltd (the opponent), opposes registration and has filed a notice of opposition.

10 The parties followed the evidence process set out in Pt 5 of the regulations. During this time, the trade mark application changed hands and, once this information was recorded at the TMO, the new owner became, for all current purposes, the applicant. That person is Diana Beth Mooney, and I will refer to her as "the applicant" in the remainder of this decision. The application was originally filed by Total Hose (Aust) Pty Ltd. That company is now the sole authorised user of the trade mark under licence from the applicant, and I will refer to it as "the licensee" in what follows.

15 The applicant requested that the matter be heard. I conducted that hearing and am to decide the opposition under delegation from the Registrar of Trade Marks. At the hearing, the applicant was represented by Ben Fitzpatrick of counsel, instructed by Lyn Meston-Watson, a solicitor of the firm of Minter Ellison. The opponent was represented by Susan Thompson, also of counsel and instructed by Warren Chandler, a trade mark attorney of the firm of Pipers, Trade Mark Attorneys.

### **Evidence**

20 The opponent filed and served copies of declarations by John Keays and Reginald Roberts to support its opposition. The Keays declaration incorporates annexures JK1, JK2 and JK4–33. These annexures include an earlier declaration by Mr Keays and a number of supporting declarations that I will come to in due course, including one by Keith Whitbourne.

25 In answer, the applicant relies on declarations by Charles Mooney, with supplementing trade declarations by John Haynes, E J Mullins, Tony Avard, Graeme Smith, Arthur Squires, Chris Pailthorpe and Graham Hart.

In reply, the opponent relies on three more declarations made over time by John Keays, and a second one by Keith Whitbourne.

### **General observations**

40 With the assistance of the comments of counsel at the hearing, I will set down the basic elements of the evidence that bears on this matter. I will leave more detailed consideration until I deal with the specific issues raised by the opponent.

### ***The opponent's evidence in support***

45 The basis of the opponent's case is in the declarations of Mr Keays, with annexures, some of which are declarations by other traders. Mr Keays is the managing director of the opponent, which he initially refers to as being Total Rubber Services Pty Ltd. The opponent is a retailer of a wide range of industrial and automotive hoses, ranging from radiator hoses to welding hose, steel reinforced steam hose and milk tanker hose. It has operated since 1985. At least some of its hoses are branded with the words "Total" or "Total Hose". The

majority of the opponent's price lists and brochures are prominently marked with a logo consisting of the letters "TRS" beside the words "Total Rubber Services".

It would appear from Ex JK6, part of the opponent's evidence, that the applicant's licensee originally traded as Kwickfix the Hose Man. On 6 October 1995, the licensee wrote, apparently to at least one of its customers, to advise of this change of name. The letter states that "This is a name change only, and reflects more our activities with our mobile on-site units". From imprints at the top of this letter, it was either sent to, or otherwise came into the possession of, HIS Hose Pty Ltd on 11 October 1995, but there is no evidence at all about how widely the letter was distributed by the licensee.

HIS Hose Pty Ltd is the employer of Reginald Roberts, one of the other people who made a declaration in support of the opposition. Mr Roberts states that his business competes directly with the opponent. Mr Roberts confirms that the opponent has a reputation for its trade in "Total" branded hoses. He says that employees of his company refer to the opponent's products as Total Hose. He sets out his reaction when he learned that Kwickfix had changed its name to Total Hose the Hose Technician: "I believed that the change of name had been initiated as a result of some form of association or merger with the opponent, leading to the opponent providing a newly formed mobile technical service." Mr Roberts says that he learned that this was incorrect when he raised the matter with Mr Keays.

Mr Keays also refers to the conversation with Mr Roberts. He refers to a similar conversation with Bob Smart, the managing director of Pirtek Pty Ltd, which company he describes as another hose supplier and repairer. However, there is no evidence from Mr Smart.

### ***The applicant's evidence***

The principal declaration of the applicant is that of Mr Mooney. Mr Mooney is the managing director of the company that filed the trade mark application and is now the exclusive licensee of the applicant. According to his evidence, the trade mark was first used in connection with the services specified in this application in September 1995. He has exhibited, as part of his declaration, an earlier declaration that he relied on during examination of the application by the TMO. Taking the two declarations together, he states that at the date of adoption of the trade mark, September 1995, his company "was not aware of any of the cited marks". These are identified specifically by number. The earliest of these is No 676460, to which I have already referred, which was filed on 30 October 1995. The remaining applications, filed later, are not overly relevant to this proceeding and Ms Thompson did not rely on them at the hearing.

The applicant, through her licensee, provides an on-site plant maintenance and repair service. The licensee, a Victorian company, specialises in servicing and replacement of hose assemblies and fittings for industry in general. The licensee, as shown in Ex CWM2 of the Mooney declaration, routinely refers to itself as Total Hose. Its brochure asserts that it provides services to businesses in over 200 industries including aluminium, chemicals, agriculture, beverages, construction and earthmoving. Mr Mooney asserts that applicant's trade mark has a high profile within the relevant trade and that, to the best of his knowledge, there has been "no confusion arising with the goods provided by the opponent under its brand name". It is not entirely clear just where the applicant provides its services,

but its supporting declarations come mostly from traders in New South Wales and Victoria, with one from Queensland. Mr Mooney has not said why the trade mark in question was adopted.

5 The applicant's evidence includes seven declarations that go to the issue of possible confusion of the applicant's marks with those of others. The declarations of Messrs Mullins, Smith, Pailthorpe follow a common pattern. The declarants "are not aware of the use of the trade mark TOTAL HOSE on hoses and (are) therefore not aware of the name of the company who may use this trade mark".

10 The declarations of Messrs Avard and Squires and Hart are similar, but declare that they are only aware of the use of the words "Total Hose" by Total Hose (Aust) Pty Ltd. In Mr Haynes' declaration, the relevant portion (including the text that has been struck out, apparently before signing) reads:

15 I am not aware of the use of the trade mark TOTAL HOSE on hoses, and ~~am therefore not aware of the name of the company who may use this trade mark.~~

*Opponent's evidence in reply*

20 The opponent relies here on three more declarations by Mr Keays. Mr Keays begins by noting that his earlier declaration refers to the opponent as being Total Rubber Services Pty Ltd. He notes in the evidence in reply that this is not strictly correct but declares that "the opponent refers to itself and is frequently recognised by its clients" in those terms.

25 The Keays declaration of 21 August 2000 has not been properly witnessed. This is not fatal, as the substance of it is essentially argument, not fact. Mr Keays asserts, and I accept, that various sorts of engineering and machinery sales businesses require the supply, installation and maintenance of hydraulic and other hoses.

The opponent has also shown, in its evidence in reply, that in fact the firms by which Messrs Avard, Mullins and Haynes are employed have all bought hose from the opponent at some stage in the year 2000, as has the applicant's licensee.

30 The final part of the evidence in reply is the second Whitbourne declaration. This goes to the issue of possible confusion. Mr Whitbourne is the managing director of a firm that supplies hand and power tools and engineering and material handling supplies. He declares (underlining present in original):

35 His company requires the supply of hoses for its activities.  
It buys these, generally, from the opponent.

40 "I understand that the types of services provided by the applicant in this matter are services that (my company) often requires to be performed upon or by means of hoses(s) supplied by Total Rubber Service (Aust) P/L. I have stated in my previous declaration that I understand hoses supplied by Total Rubber Service (Aust) P/L bearing the TOTAL brand to mean TOTAL HOSE and that Total Rubber Services (Aust) P/L is the source of origin of such hoses

45 While I am/am not fully aware in this instance of the applicant I believe that not only there is an overlap between the applicants and opponents client base because the goods and services are interrelated, but it is my opinion that if I was to see the trade mark TOTAL HOSE THE HOSE TECHNICIAN I would be caused to wonder whether it might be the case that there is a connection between services provided by the applicant and goods provided by Total Rubber Services (Aust) P/L."

50 I note, however, that the declaration of Mr Whitbourne is not fully executed. While it has been witnessed, the qualification of the witness has not been stated. Perhaps more significantly, I think the substance of the declaration is open to

question. It is incomplete, and so is something on which it would be unwise for me to put great weight. The declaration seems to me to have been drafted in words that are not necessarily the true mind of the declarant. Mr Whitbourne, when presented with it for signing, was not sufficiently au fait with its substance as to see the need to strike out either “am” or “am not” at the critical and underlined place.

I will also note that nowhere in the opponent’s evidence is there any suggestion that it has at any stage suggested to the applicant that it objects to the use, by the applicant, of the trade mark in question.

### Issues and decision

The opposition was originally based on a wide range of grounds. However, the matter was finally argued under the headings of ss 44 and 60. Section 44, in so far as it is relevant, reads as follows:

#### *Identical etc trade marks*

44(2) Subject to subsections (3) and (4), an application for the registration of a trade mark (applicant’s trade mark) in respect of services (applicant’s services) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods 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 services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

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.

(3) If the Registrar in either case is satisfied:

- (a) that there has been honest concurrent use of the 2 trade marks; or
- (b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant’s trade mark subject to any conditions or limitations that the Registrar thinks fit to impose. If the applicant’s trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

Note: For “limitations” see section 6.

(4) If the Registrar in either case is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant’s trade mark for a period:

- (a) beginning before the priority date for the registration of the other trade mark in respect of:
  - (i) the similar goods or closely related services; or
  - (ii) the similar services or closely related goods; and
- (b) ending on the priority date for the registration of the applicant’s trade mark;

the Registrar may not reject the application because of the existence of the other trade mark.

Note 1: An authorised use of the trade mark by a person is taken to be a use of the trade mark by the owner of the trade mark (see subsection 7(3)).

Note 2: For “predecessor in title” see section 6.

Note 3: For “priority date” see section 12.

At the hearing, Ms Thompson based her client's opposition, as it arises from s 44, on trade mark registration No 676460. This registration is for the trade mark TOTAL HOSE, in respect of "rubber and PVC hoses". This is the trade mark to which I have already referred. Its priority date is 30 October 1995.

5 Mr Fitzpatrick conceded, when I put the matter to him at the hearing, that the provisions of s 44(2) are triggered, ie that the marks are, at least prima facie, deceptively similar and the goods and services "closely related" for the purposes of s 44(2). On the evidence before me, which suggests that there is some degree of overlap at both the selling and servicing ends of the applicant's maintenance services, any other conclusions would be difficult to justify.

10 The evidence from the applicant shows that it has continuously used the subject trade marks from at least as early as 11 October 1995. This is before the priority date of the earliest of the opponent's registered trade marks. I therefore find that the provisions of s 44(4) were properly applied. No ground of opposition has therefore been established under s 44.

15 Perhaps anticipating such a conclusion, Ms Thompson pressed an argument under the terms of s 60. For reasons that follow, it will be efficient to deal with the s 60 issue without going into the applicability of s 44(3).

20 **Section 60**

*Trade mark similar to trade mark that has acquired a reputation in Australia*

60 The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- 25 (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.

30 Note 1: For "deceptively similar" see section 10.

Note 2: For "priority date" see section 12.

The questions under s 60 are distinct:

- 35 (1) Is there a substantially identical or deceptively similar trade mark?  
(2) Had that trade mark acquired a reputation in Australia at the priority date?  
(3) Will use of the applied-for trade mark result in deception or confusion because of the reputation of that trade mark?

40 The opponent can rely on any trade mark, registered or unregistered, for any goods or services. In this case it has used and can rely on three trade marks: the unregistered trade marks TOTAL and TOTAL RUBBER SERVICE and the registered trade mark TOTAL HOSE. I must therefore evaluate the s 60 ground for each of these trade marks.

45 It will be convenient to start with the unregistered trade mark TOTAL and the very similar registered trade mark TOTAL HOSE. It is appropriate to take these two together because of their obvious similarity and because it is not always clear from the evidence, to which I will come below, just which trade mark is being used at any given time. Accordingly, for the purposes of this aspect of the decision, I will deal with those two of the opponent's trade marks as though they were one. Any reference to the single trade mark TOTAL in what follows should be seen as a reference to either or both of those trade marks.

### ***Deceptively similar trade mark?***

Ms Thompson submitted that all of the case law relevant to the comparison of marks under s 44 carries over into s 60. As to the opponent's (unregistered) trade mark TOTAL, the one-word mark that is branded onto hoses, the answer to the first question is "yes", it is deceptively similar to the applicant's mark. Similarly with regard to the registered trade mark TOTAL HOSE. I agree with Ms Thompson's simple submission that the trimmings that differ do not sufficiently distinguish either of the opponent's trade marks from that of the applicant. The word "Total" is present in both marks and will strongly impress itself on the recollection as the distinguishing element. She noted the decision of the Full Federal Court in *Sports Café Ltd v Registrar of Trade Marks* (1998) 42 IPR 552. The court agreed with the decision that the plain word mark THE SPORTS CAFÉ was deceptively similar to a device mark in which the elements "Sports Café" were a significant, but not a dominant, element. This, she said, was not a case where the elements not in common were enough to differentiate the competing trade marks. This case, she argued, and I accept, can be distinguished from *Registrar of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411 where the differing element (Woolworths) tellingly distinguished one trader's mark from the other's.

### ***Reputation?***

I set out the relevant definition of "reputation" for the purposes of s 60. According to Kenny J, in *McCormick & Co Inc v McCormick* (2000) 50 IPR 102 at 129, [85]:

[I]t is true that the assessment of the reputation of a trade mark goes far beyond mere examination of sales or turnover of goods sold under that trade mark and contemplation of the advertising and promotional figures. As regards a trade mark, its reputation derives both from the quantum of sales under that mark and also the esteem, or image, projected by that trade mark. The quantum of sales, advertising and promotion contributes to the "recognition" component of the trade mark's reputation. The credit, image and values projected by a trade mark attaches to the "esteem" component of the reputation as do the public events and other trader's marks with which [the] owner of the trade marks in question chooses to associate the trade marks via sponsorships, cross-promotions, "contra deals" and so forth.

It follows that a trade mark used in relation to goods with comparatively low sales may have a high and strong reputation by virtue of the high credit or esteem in which it is held or, conversely, that a trade mark which has very high sales may have a strong reputation notwithstanding the lack of esteem that attaches to it. The particular popular images, or sets of values, that attach to the trade mark are also, therefore, important parts of the reputation of the trade mark and may be as strong an associative force in the minds of the public as the association of the trade marks with the goods or services themselves.

In practice, it is commonplace to infer reputation from a high volume of sales, together with substantial advertising expenditures and other promotions, without any direct evidence of consumer appreciation of the mark, as opposed to the product: see, eg, *Isuzu-General Motors Australia Ltd v Jackeroo World Pty Ltd* (1999) 47 IPR 198; *Marks & Spencer Plc v Effem Foods Pty Ltd* (2000) AIPC 91–560; *Photo Disc Inc v Gibson* (1998) 42 IPR 473; and *RS Components Ltd v Holophane Corp* (1999) 46 IPR 451.

I now turn to the evidence in detail, starting with the Keays declaration. Mr Keays is the managing director of the opponent. He has, in his first declaration, set out sales and advertising expenditure for "hoses under the trade mark 'TOTAL'". Those figures are impressive. Without being too specific, the

stated sales figures first rose above \$1m in 1987 and above \$3m per year in 1996. However, I am not entirely satisfied, for reasons to which I will come, that all of the hoses referred to by Mr Keays were sold under that trade mark (TOTAL) or by reference to the trade mark TOTAL HOSE.

5 It is not clear just when the opponent started to supply hoses that were unambiguously branded either TOTAL or TOTAL HOSE. Exhibits JK4 and JK5 are relevant here. As Mr Keays describes them:

10 Exhibited hereto as Ex JK4 is a copy of a letter sent from HSR & A Co Ltd, a rubber and automotive company in Korea indicating their knowledge of first use of the "TOTAL" brand on or in relation to hoses commencing on March 1990.

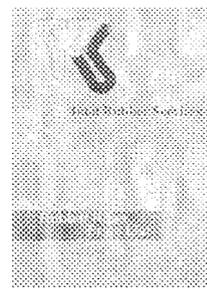
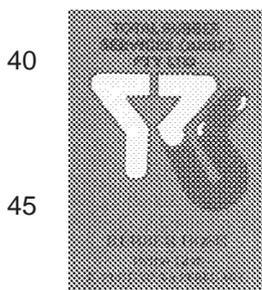
Exhibited hereto as exhibit JK5 is a copy of a letter from HSR & A Co Ltd, a rubber and automotive company in Korea indicating that they have been supplying rubber hoses to Total Rubber Services Pty Ltd. bearing the brand "TOTAL" at both ends (excluding water suction hoses, water discharge hoses).

15 Those letters are not written to Mr Keays or his company and, were it not for Mr Keays' strong assertion, they would appear to have little connection with this matter. The writer is identified only as Charlie, of HSR & A Co Ltd, a rubber and automotive component company in Korea. The letter is written to Mr Don Moon, the managing director of a company called Sunmoon Pty Ltd, a company whose  
20 location and connection with the matter are not clear to me. The letters say that the Korean company has supplied hoses, with the exceptions specified, "branded TOTAL HOSE at both ends" since March 1990.

Similarly, Ex JK20 shows that the supply to the opponent of rubber layflat hose branded TOTAL LAYFLAT probably commenced in January 1993.

25 Consistent with this, I note that a price list (JK18) dated February 1990 does not distinguish between hoses marked either TOTAL or TOTAL HOSE and those that are not. Exhibit JK19 is similar but undated. The only trade marks on the price lists are the name of the opponent and its TRS logo. The document lists a wide  
30 range of applications and includes a reference to "Goodyear Ortac Hose". I find it curious that neither the trade mark TOTAL nor TOTAL HOSE is mentioned. It is at least as likely that the exhibit is simply a catalogue of various hoses that are for sale from the opponent in its role as a retailer using, as a trade mark, the name of the opponent company, sometimes shortened to TOTAL RUBBER SERVICE. I  
35 infer that the goods may have been unbranded or sourced from a variety of manufacturers and thus bearing the trade marks of those manufacturers.

I reproduce here the cover pages of JK18 and JK19:



50 Exhibit JK25 is a promotional brochure, apparently a current one since it refers to an event in 1981 as being of 20 years past. It confirms that the opponent sells

products bearing a number of trade marks that are clearly not the opponent's. Mr Keays asserts, despite this, that this is an exhibit "wherein the TOTAL brand name is displayed prominently in close relation with sub-headings such as Rubber Hose, PVC hose, Irrigator Hose". However, where the word "Total" is used it is typically, as on the cover, an emphasised part of the words "*Total Rubber Services*" together with the TRS logo. Inside the brochure, in expressions like "the *Total* Commitment to Growth", it is used in a context where Total Rubber Service is already clearly understood.

I therefore think that Mr Keays, while speaking honestly, is not speaking with precise legal accuracy when he asserts that this is a use of the trade mark TOTAL in relation to hoses, either for a trade in goods or in relation to retail services. I think that, when Mr Keays set out "the value of sales of hoses under the mark TOTAL", he may have set out figures for the sale, by the opponent, of hoses in general. This may have been under the broad banner of Total Rubber Service or some similar trade mark that contains the word "Total" but such actions do not amount to the use of TOTAL as a badge of origin of either goods or services.

I am, however, prepared to leave this aside for the moment. I accept, from the evidence in general, that the opponent does and has supplied a reasonable amount of hose that is in fact branded TOTAL. Second, the opponent's supporting declarations attest to a reputation in the trade mark TOTAL. As Mr Clifford puts it, in Ex JK1, dated "23rd day of 1999 [sic] 1999":

We have certainly and distinctively come to associate the brand "TOTAL" with hoses supplied by Total Rubber Services Pty Ltd (the opponent). It is quite natural and automatic for me to think of "Total" and industrial "hose" conjunctively and in direct association with supply from Total Rubber Services Pty Ltd.

In other words, the reputations of the trade marks TOTAL and TOTAL HOSE were, by some time in 1999, when the declarations were made, enhanced by the knowledge that this trade mark denotes goods from the opponent. The opponent is a long-established firm that trades under the trade mark TOTAL RUBBER SERVICE, a firm with which the various declarants had been doing business since roughly 1989. This knowledge, that the opponent firm is the source of the goods, is an integral part of the reputation of the opponent's trade marks TOTAL and TOTAL HOSE, when used for a trade in goods. The other declarants to whom Mr Keays has referred, and on whom the opponent relies, similarly attest to a flow of the opponent's reputation into that of the trade mark TOTAL.

This flow, however, can only achieve so much. The opponent's declarants attest to a reputation reinforced, both now and in 1999 when they made their declarations, by knowledge of the business of the opponent. No matter how solidly they do this, they have not sufficiently addressed the reputation of the trade marks TOTAL and TOTAL HOSE as at the priority date in July 1997. What the reputation of these trade marks was, jointly or separately, at that time, is a matter of guesswork. My uncertainty about just how extensively those actual trade marks had been used, and over what time, exacerbates this. The weight of the evidence is that, while customers may identify TOTAL hoses with the opponent, the trade mark that has been primarily used for the retailing of hoses is not TOTAL but TOTAL RUBBER SERVICES or TOTAL RUBBER SERVICES (AUST) PTY LTD or some similar variation such as the TOTAL RUBBER SERVICES PTY LTD referred to by Mr Keays.

Therefore I find that the opponent has not established a reputation in the trade marks TOTAL and TOTAL HOSE, at the priority date, with any degree of clarity.

However, despite the sketchy picture painted by the evidence, and my doubts about the extent of the reputation that such evidence can establish, it is necessary to complete the third leg of this analysis.

5 ***Likelihood of deception?***

Mr Fitzpatrick, for his part, argued that the opponent had simply not met its evidentiary onus. There was no convincing survey evidence, for example. There was no evidence that anyone who was a customer of either the applicant or the opponent had been deceived. This was, he said, remarkable because the evidence showed that the applicant's mark had been in use since September 1995 — here, he referred to the changing of name of the Kwickfix business — and the opponent had been aware of this since about that time.

Mr Fitzpatrick argued that the adoption of the mark by the applicant had been open and honest, and widely communicated to the trade. Despite this, the only clear first-hand evidence that anyone had been confused was, he said, in the Roberts declaration, but Mr Roberts was not, in fact, a customer of either firm so much as a competitor of the opponent's.

He also argued that, although there was clear evidence that the opponent was aware of the use, it had taken no action to stop it and, indeed, had been content to sell TOTAL hoses to the applicant. Such acquiescence argued strongly, he said, that there was little practical risk of deception or confusion.

He said that one likely reason for this was that the opponent accepted that it could not assert a monopoly in the word "total". He pointed to the way the opponent itself had used "total" in what he said was a descriptive way: JK25 to the Keays declaration, to which I have already referred. Mr Fitzpatrick drew my attention to examples such as (emphasis and capitalisation present in original): "The *Total* Source for all your Industrial Rubber Needs", "allowing us to offer a complete Total Hose Service" etc.

Ms Thompson was dismissive of this. It did not, she said, prove that "total" was a directly descriptive word. She noted the emphasis and capitalisation used by the opponent and argued that to see the usage in evidence as descriptive was to miss the entire point of the purpose for which the words were being used. It seems to me that, while the word "total" can be bent to suit a descriptive purpose, Ms Thompson is right. "Total" is a word that is inherently adapted to distinguish and I accept that it has sometimes been so used. I have already said that the relevant use of words as a trade mark for hoses in JK25 is TOTAL RUBBER SERVICE, but there is, in other exhibits, use of the word "Total" alone. The fact that the opponent can also create a play on words in JK25 does not refute the trade mark function, in other places, of the word in question.

Ms Thompson noted that there is no requirement in law that an opponent produce actual instances of deception or confusion, though such evidence existed here. As to acquiescence, it was true that the opponent had not taken court action to stop the applicant using its trade mark. However, she noted that this should not, in principle, have a bearing on an opposition conducted at the TMO. The opponent was vigorously prosecuting the opposition and was entitled to have it decided on its merits.

Mr Fitzpatrick stressed the weight that should be put on the evidence of the applicant's declarants. This, he said, would go some way to negating the possibility that there was, in practice, deception or confusion. Concerning these, Mr Keays has implied in his evidence, and Ms Thompson argued at hearing, that there is something contrived, or deliberately careful, in the what she said was the

applicant's reliance on declarations that postulate the (non-existent) TOTAL HOSE as a conflicting brand. She argued that this was very questionable when the opponent's mark, according to Mr Keays, is TOTAL, solus.

It would be surprising, Mr Fitzpatrick said, if I concluded that those declarations were carefully worded: the charge normally levelled at evidence that was to be devalued by a deciding officer was that it was carelessly prepared. I agree with him to an extent. I do not conclude that the declarations are artfully worded so as to divert the matter onto the recognition of another trade mark. I have already said that I do not share Mr Keays's view that the opponent consistently uses the trade mark TOTAL, solus. There is clear evidence in JK4 and JK5 that at least some of the opponent's hose was branded TOTAL HOSE or TOTAL LAYFLAT. Therefore, I believe I can give the applicant's supporting declarations some weight, though obviously they are not tendered as a representative sample.

On the other hand, the firms that employ Messrs Avard, Mullins and Haynes have, at least in recent times, been customers of the opponent. I could give their declarations more weight if they went to the perceptions of the declarants now that they are aware, or have some chance of being aware, of the allegedly conflicting mark. As matters stood at the time they made their declarations, the fact that they were unaware of the opponent's trade mark, and therefore unlikely to be deceived or confused, is far from reassuring about the likelihood of deception or confusion among others who might encounter one trade mark while knowing of the other.

Ms Thompson noted the evidence that, in fact, there was deception or confusion (Roberts declaration, second Whitbourne declaration and the alleged conversation with Bob Smart of Pirtek). She noted that there was no onus on an opponent to prove that there had been actual instances of confusion. She said that I could rely on the extent of the opponent's use, in a specialised industry, to have generated a reputation in the trade mark and to have so prepared the ground as to make deception or confusion sufficiently likely.

### ***Conclusions re s 60***

On balance, I am not satisfied that there was, at the priority date of the opposed application, a significant risk of deception or confusion attributable to the reputation of the trade marks TOTAL or TOTAL HOSE.

I appreciate Mr Fitzpatrick's argument that I should set the s 60 bar high in this case, so as not to allow the opponent to claim too broad a monopoly in a word that is capable of uses other than trade mark use: *Hornsby Building Information Centre Pty Ltd v Sydney Building Information Centre Ltd* (1978) 140 CLR 216; 18 ALR 639. I have done this to the limited extent necessary for a word such as "Total". However, I think it is also important that the height of the bar for s 60 should reflect that it is a ground of opposition based on likelihood, not simply on inferences and speculations.

In *Registrar of Trade Marks v Woolworths* (1999) 45 IPR 411 at 428, French J restated the tests for deceptive similarity which stem from *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592. Of particular relevance is this:

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.

5 This reflects, of course, the changed onus under s 44, which initially applies in  
ex parte matters, prior to the acceptance of an application for registration. I do not  
believe that French J was suggesting, in referring to “some people”, that it would  
be sufficient if a mere handful of people would be left in doubt. First, I do not  
10 believe that he was attempting to modify his previous stipulation, for which there  
is long-standing authority in a case to which he had just referred, that the doubt  
that must afflict the “ordinary” person must be a “reasonable” one. Second, the  
formulation requiring that the number of people affected by doubt or confusion  
be “substantial” has been repeatedly endorsed. The only thing that has shifted is  
15 the onus, not the benchmark. The benchmark comes from *Re Smith Hayden & Co  
Ltd’s Application* (1946) 63 RPC 97 and *Kendall Co v Mulsyn Paint & Chemicals*  
(1963) 109 CLR 300 at 305, where Kitto J repeated and expanded what he said  
in *Southern Cross*. He added the reference to “substantial” as an express adoption  
of that formula from comparable UK decisions subsequent to *Smith Hayden*.

20 I consider that there is a similar issue under Pt 5 of the Act, where an opponent  
carries a responsibility of establishing, to the necessary extent, a ground of  
opposition.

I do not think that s 60 can be seen merely as some sort of recasting of s 44  
25 without stipulations as to either the registration of the allegedly conflicting mark  
or the overlap or otherwise of the competing goods or services. Section 60 is a  
ground of opposition, and a powerful one. The Federal Court has said,  
McCormick, above, that s 44(3) is not a shield against the application of s 60. I  
presume, therefore, that the same conclusion should apply to s 44(4). Notionally,  
30 if either s 44(3) or (4) applies then, in terms of s 44(2), there must already be a  
conflict. In the present case it is between the applicant’s trade mark and the  
opponent’s registered mark, TOTAL HOSE. I cannot therefore accept that, to win  
an opposition, all that the opponent needs to do is point to a reputation in a (very  
similar but unregistered) trade mark and to the possibilities that are already  
35 inherent in any s 44(4) acceptance. There must, in addition, be sufficient ground  
for a belief on my part that deception or confusion is:

- not only possible but also sufficiently likely; and
- attributable to a reputation in the conflicting trade mark.

40 I do not rule out all possibility of confusion, but I am far from satisfied that  
there is any significant likelihood of this, or that, if it exists, it is attributable to  
a reputation in the trade marks TOTAL or TOTAL HOSE extant at the date the  
present application was filed. I therefore find that no ground of opposition has  
been established under s 60 in relation to the trade marks TOTAL and TOTAL HOSE.

#### 45 ***Remaining trade mark: Total Rubber Services***

Here the threshold question is the deceptive similarity of the trade mark TOTAL  
RUBBER SERVICES, which I find has been used as a trade mark on at least some  
of the opponent’s material. I note, however, that Ms Thompson did not press this  
trade mark as giving rise to a ground of opposition. It is one to which I turn  
50 simply to fully consider the matter. The applicant’s trade mark is, in black and  
white:



I do not believe, in deciding the question of the deceptive similarity of these two allegedly conflicting trade marks, that I can take any account of the reputation of the opponent under its trade mark. The comparison of the marks is an abstract one. It may well make good sense for people such as Mr Roberts, whose evidence is on file, to think that expansion into the delivery and installation of hoses is a logical move for a large business such as the opponent. That, however, is not part of the threshold question posed by s 60 and does not render the two marks deceptively similar.

The proper abstract question requires me to allow for the ordinary levels of imperfect recollection of the opponent's trade mark TOTAL RUBBER SERVICES when comparing that mark with the applicant's, or vice versa. I think I should also allow for the fact that one trade is used for the retailing of hoses, the other for a slightly different activity, the installation and maintenance of them. This as one of the "surrounding circumstances" referred to in *Re Application by Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777. Though not a feature of the marks, it certainly intrudes directly on their comparison. The relevance of *Pianotist* formulation was endorsed by the High Court in *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd* (1952) 86 CLR 536 at 539.

Even if I exclude that factor, the two trade marks are visually and conceptually sufficiently different to an extent that no ordinary person could incorrectly take one for the other or be left in any doubt as to their differences. The differences also outweigh the commonality of the word "Total" to the point where, once the question of the opponent's reputation is deliberately excluded, nobody would expect that the mere presence of the word "Total" in both marks was likely to be an indication of some connection or common source. Without more, I see no reason why any ordinary person would expect any connection at all between the source of the Total Hose Service, under the mark as applied for, and the opponent's Total Rubber Service business.

Therefore, there can be no question of this trade mark of the opponent giving rise to a ground of opposition under s 60.

#### **Decision and costs**

I have not found that any ground has been established under s 60. In addition, I have found that the application was rightly accepted under the provisions of s 44(4). My decision, therefore, is that:

- The application should be registered unless, within 1 month of the date of this decision, the opponent serves on the Registrar a copy of a notice of appeal. If such a copy is served, I direct that registration not occur until the appeal is either dismissed or discontinued.
- The opponent pay the costs of the applicant to the extent of the official scale.

DACE JOHANSONS  
SOLICITOR

Timothy Brown · 09/11/2021 11:22 AM

what does this mean? 'The material particulars do not resemble each other and the trade marks differ only in the ways specified in paragraphs 51(1)(a),(b),(c) (ie an invalid series).'

09/11/2021 11:23 AM

if the reps dont resemble each other in material particulars it isnt valid

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i see

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material particulars are the distinctive elements that form the identity of the mark

from a hearing

let me see if i saved that anywhere

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the lyson one?

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<https://jade.io/article/592036>

should be in here somewhere from memory

so they considered resemble each other in material particulars by comparing to SI considerations from cases

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if the goods also included items with which the words TV or TELEVISION had no connection, such as "fire extinguishers" or "facsimile transmission services". Then the differences between the trade marks, namely the words TV and TELEVISION, would not be statements as to those goods or services. It should also be noted that if the trade marks were to be used on fire extinguishers or facsimile services, the difference between IDAK TV and IDAK TELEVISION would be a substantial variation in material particulars.

done