
Trade Marks Update

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Trade Marks Attorney Regulatory and Discipline Regimes

- As from 1 July 2008, amendments to Chapter 20 Patents Regulations 1991 and Part 20 of the TM Regulations 1995.
- New requirement for registered patent and TM attorneys to undertake compulsory CPD activities each year.
- See Official Notice issued 26 June 2008.
- See new Code of Conduct for Patent and TM Attorneys:
<http://www.psb.gov.au/pdfs/code.pdf>

Colorado Group Limited v Strandbags Group Pty Limited (2007)

164 FCR 506

- Colorado Group claimed use since 1988 of COLORADO on school backpacks
- Strandbags claimed use since 1990 of COLORADO on bags, travel goods, backpacks, wallets
- From 1993 Colorado Group opened a network of COLORADO stores selling a range of clothing, as well as bags and wallets
- From 2001 Colorado Group owned TM for COLORADO (plain word) for bags, wallets, purses and backpacks.
- Colorado Group sued Strandbags for TM infringement, passing off and s.52 TPA
- Strandbags cross-claimed for cancellation of Colorado Group's TM

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

S 41: capacity to distinguish?

- Finkelstein J (1st instance (2006) 67 IPR 628):
 - COLORADO not used in a geographical sense for backpacks or shoes.
 - Descriptiveness of COLORADO is the notion of trekking, ruggedness, fashion, Rocky Mountains etc, which concerns the image of the brand and does not describe the goods.
 - Thus COLORADO is inherently distinctive of these goods.

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

S 41(2) and (3): inherent capacity to distinguish?

- Full Federal Court (Kenny, Gyles and Allsop JJ):
 - COLORADO not a “fancy name” (eg North Pole for bananas) but a state of USA.
 - COLORADO not arbitrary, not like a made up word.
 - Not inherently adapted to distinguish for s 41(3).

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

S 41(5) and (6): acquired distinctiveness?

- Full Federal Court (Allsop J, Kenny and Gyles JJ agreeing):
 - Only s 41(6) really applies, but Strandbags had accepted there was some inherent distinctiveness, so s 41(5) considered.
 - Strandbags' concurrent use of COLORADO is relevant for determining distinctiveness of Colorado Group's TM, under s 41(5) and (6).
 - Insufficient distinctiveness for s 41(5) or (6).
- Colorado Group's TM for COLORADO cancelled: s 88.

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

Goods of the “same kind”?

(entitlement for registration, ownership)

Goods of the “same description”?

(s 44 opposition and infringement)

Kenny J on appeal:

- No bright line between “same kind” and “same description”.
- “Same kind” may well be narrower than “same description”.
- Registration system would be undermined if first use gave rise to ownership for a broad ill-defined set of goods.

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

Goods of the same kind (ownership)

- Are handbags goods of the “same kind” as wallets and purses?
 - Yes: Finkelstein J (1st instance); Kenny J (FFC)
 - No: Allsop and Gyles JJ (FFC)
- Are backpacks goods of the “same kind” as handbags, purses or wallets?
 - No: Finkelstein J (1st instance),
 - No: Kenny, Allsop & Gyles JJ (FFC)

Colorado Group Limited v Strandbags Group Pty Limited (2007)
164 FCR 506

Goods of the “same description” (infringement)

- Finkelstein J (1st instance):
 - handbags, purses or wallets are not goods of the “same description” as backpacks
- Allsop J (FFC) in *obiter*:
 - bags and handbags are goods of the “same description” as backpacks
 - bags and handbags are not goods of the “same description” as wallets and purses

Colorado Group Limited & Anor v Strandbags Group Pty Limited
[2008] HCATrans 200 (23 May 2008)

- Colorado Group's special leave to appeal point:
 - In determining distinctiveness of Colorado Group's TM under s41(5), FFC erred by considering the concurrent use of COLORADO by Strandbags.
 - Use of a TM by traders other than the TM applicant is not relevant as part of "any other circumstances" in s 41(5)(iii).
 - Strandbags' use of COLORADO was relevant only to s 60, not 41(5).

Colorado Group Limited & Anor v Strandbags Group Pty Limited
[2008] HCATrans 200 (23 May 2008)

- Kirby, Hayne and Crennan JJ, refusing special leave:
 - *“Whilst not to be taken to be agreeing with everything said by the Full Court (Kenny, Gyles and Allsop JJ) about section 41(5), we are nevertheless not persuaded that this is a suitable case for the grant of special leave.*
 - *The conclusions in the case turn to a significant extent on matters of fact unaffected by issues of construction of section 41(5).”*

When will the High Court consider the 1995 TM Act?

- No special leave to appeal:
 - *Colorado v Strandbags* (23 May 2008)
 - *BP v Woolworths* (25 May 2007)
 - *Koninklijke Philips v Remington* (6 April 2001)
- Last High Court TM case under 1955 TM Act:
 - *Campomar v Nike* (2000) 202 CLR 45

E & J Gallo Winery v Lion Nathan (2008) 77 IPR 69

- Gallo is a US winery business, world's 2nd largest
 - began the day Prohibition ended: 1 December 1933
 - 2005: purchased US business BAREFOOT CELLARS
 - became owner of Australian TM BAREFOOT for wines
- Lion Nathan sold BAREFOOT RADLER beers
 - RADLER is German for CYCLIST, and describes a traditional Bavarian beer flavoured with lemon and lime
- Gallo sued Lion Nathan for TM infringement
- Lion Nathan cross-claimed for removal of Gallo's TM
 - s 94(2)(b): 3 years non-use 2004-2007

E & J Gallo Winery v Lion Nathan (2008) 77 IPR 69

- Flick J:
 - Relevant sign used by Lion Nathan was BAREFOOT RADLER, not merely BAREFOOT
 - Would have found relevant sign as BAREFOOT RADLER plus logo, but not properly pleaded
 - BAREFOOT and BAREFOOT RADLER not substantially identical
 - But BAREFOOT and BAREFOOT RADLER are deceptively similar
 - Would not have found deceptively similarity if Lion Nathan had pleaded that it used BAREFOOT RADLER plus logo

E & J Gallo Winery v Lion Nathan (2008) 77 IPR 69

- Flick J:
- Beers are NOT “goods of the same description” as wine
 - Despite:
 - same major wholesale distributors and retailers
 - Lion Nathan beers marketed to wine drinkers
 - both products intended for summer consumption
 - Because:
 - different origins and ingredients
 - sold differently in restaurants and retail outlets
 - beer consumed to quench, wine to sip
 - wine and beer producers generally don’t overlap

E & J Gallo Winery v Lion Nathan (2008) 77 IPR 69

- Defence in concluding phrase of s 120(2) TMA:
 - *However, the person is not taken to have infringed the trade mark if the person establishes that using the sign as the person did is not likely to deceive or cause confusion.*
- Flick J:
 - Little guidance to date on this defence
 - Take into account the ways in which the respective products have actually been sold
 - Not just limited to comparison of trade marks
 - Defence established due to:
 - degree of segregation of wine and beer in retail context
 - manner BAREFOOT RADLER is stored, sold and consumed

E & J Gallo Winery v Lion Nathan (2008) 77 IPR 69

- Flick J, finding non-use of BAREFOOT for wine under s 94(2)(b):
 - There were sales of BAREFOOT wines during the 3 year period by an Australian retailer, so can infer offering for sale
 - Rejected an attempt to rely on brochures from archived webpage as business records under s 69 Evidence Act
 - BAREFOOT wines offered by the Australian retailer had been originally exported from US to Germany
 - TM owner had not “projected” goods into Australia
 - Any use of TM by TM owner had ended outside Australia
 - Discussions by TM owner with McWilliams to launch BAREFOOT wines were only preparatory
 - No reason to exercise discretion against removal

E & J Gallo Winery v Lion Nathan (No 2) [2008] FCA 1005

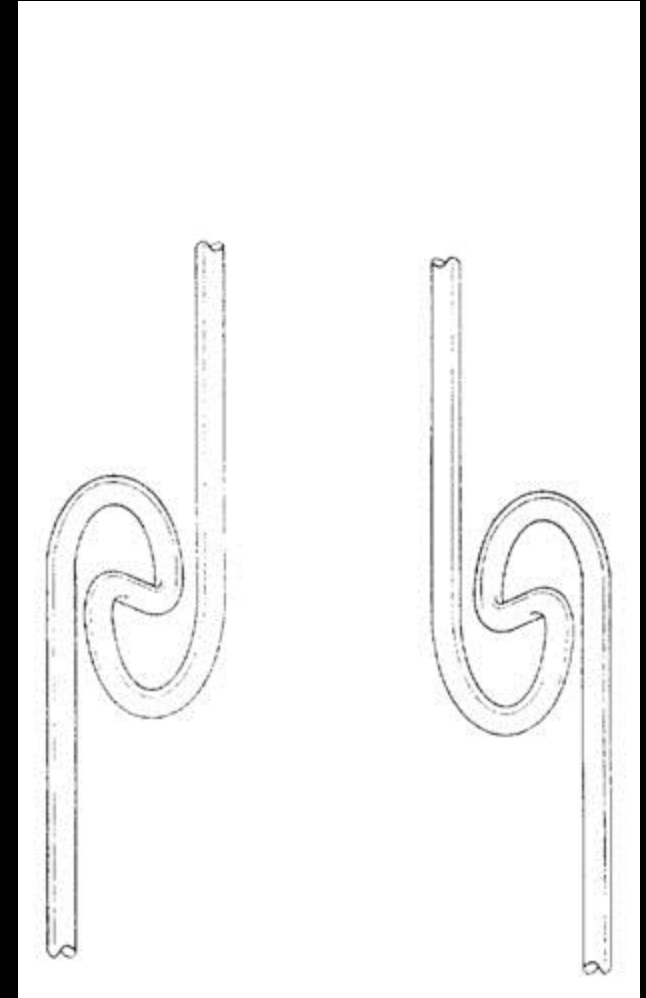
- Postscript – when does removal for non-use take effect?
- Lion Nathan: retrospectively, as from the conclusion of the 3 year non-use period of E & J Gallo's TM (8 May 2007).
- E & J Gallo: from date of Court order (27 June 2008).
- Flick J:
 - S 101(2) does not permit retrospective removal of TM.
 - Public interest in maintaining integrity of Register prejudiced by uncertainty if Courts can remove TMs retrospectively.
 - S 101(2) does not indicate retrospective effect, cf ss 79 and 98.

Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

- 1969: patent granted for an improved fence dropper with S shaped catch.
- S shaped catch central to functionality.
- Other shapes could also work, but S shape owed its shape precisely to the functional solution its shape served.
- From 1969, patent grantee manufactured and sold S shaped fence dropper.
- 1984: patent expired.
- 1993: Mayne acquired patent grantee's business.
- Fence dropper made and sold by patent grantee and Mayne became commonly known as the S dropper.

Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

- 2001: Mayne filed TM 876332 for registration of depicted shape, in respect of fence droppers.
- 2004: TM registered.
- 2003: AEG imported and sold fence droppers substantially identical with Mayne's TM.
- AEG sought to take advantage of demand for the precise S shaped dropper.
- Mayne sued AEG for TM infringement.



Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

Greenwood J:

- The extent of functionality of a 3D shape for the goods (or part of the goods) is important in determining whether use of 3D shape is:
 - distinctive of commercial origin; or
 - illustrative or descriptive of the embodied shape of the goods.
- Use of a TM must be use serving the primary function of a TM.
- Where a TM comprises a shape involving a substantial functional element in the goods, references to the shape are almost certainly:
 - references to the nature of the goods themselves;
 - not use of the shape as a TM.

Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

Greenwood J:

- *“Where the three-dimensional shape inheres in goods or a part of goods and the goods or that part perform a functional role (particularly where the shape derives from a novel and patented improvement to functionality) the use of the shape by importing and selling an article embodying the shape and promoting that article (and its shape) by graphic illustrations or photographs is not use of the sign as a trade mark but the expression of the essential feature of the goods.”*
- AEG did not use the shape as a TM, so no infringement.

Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

Greenwood J, in obiter:

- By enabling shape TMs, 1995 TM Act did not establish a regime for inventors to secure enduring exclusive rights for the shape of a functional manner of new manufacture formerly the subject of a patent.
- A shape essential to the very subject of the patent will almost always be largely functional as the invention must be novel and useful.
- If the shape is entirely incidental to the subject matter of the patent, it is unlikely to be functional. That is not this case.

Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd (2008) 166 FCR 312; 75 IPR 102

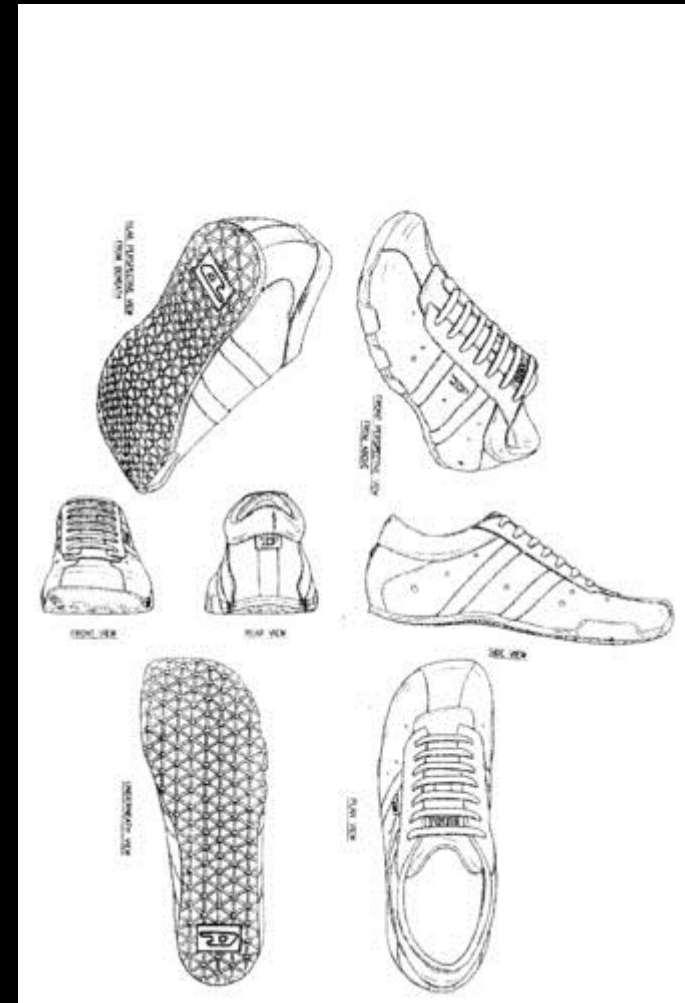
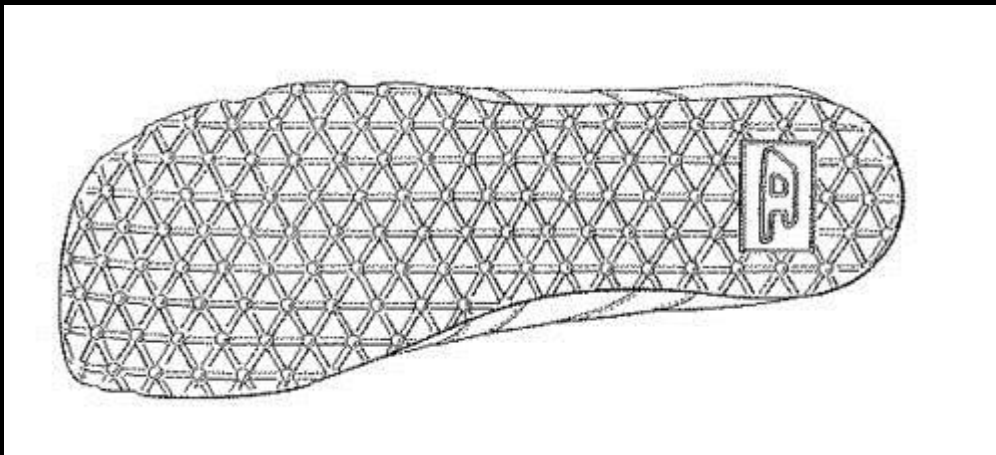
- S 25(2)(a) and (3)(a) TMA: 2 years after patent expiry, Mayne had no exclusive rights to TM which was the only commonly known way to describe or identify an article exploited under that patent.

Greenwood J, cancelling registration:

- A shape TM is capable of describing an article, and Mayne's TM described the fence dropper formerly exploited under the patent.
- "S" shape had become the only commonly known way to describe or identify the article.
- Mayne ceased to have exclusive patent rights in 1986.
- By registering 3D shape for a functional S shaped loop for fence droppers, Mayne sought to recreate monopoly under the expired patent, renewable every 10 years.

Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- 2nd Applicant: Diesel SpA
- Diesel's shape TM 986713 (right):
- Diesel's sole TM 986709 (below):
- Each registered for footwear.



Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- YD sold “Photon” shoes:



Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- YD also sold “Cube” shoes:



Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Diesel claimed infringement of shape TM and sole TM.
 - Key issues on infringement:
 - Did YD use its soles and overall shapes as TMs?
 - Deceptive similarity?
- YD cross-claimed that shape and sole TMs were invalid:
 - S 41: not distinguishing Diesel's goods.
 - S 58: Global not the TM owner at date of applications:
 - True owner was Diesel.
 - Global assigned the applications to Diesel prior to registration.

Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J on use as TM:
 - YD used sole pattern on its shoes as TM:
 - Shoes displayed out of box, inspected by “metro-shoppers”.
 - Patterns on soles are distinctive.
 - Functionality overwhelmed by non-descriptive aspects.
 - YD used shape of overall shoe as TM:
 - This case not as clear cut as *Kenman* (use of TM) or *Mayne* and *Remington* (no use of TM).
 - Non-functional and non-descriptive features overwhelm the functional features and features common in the trade.
 - Most important distinctive features: YD label, rounded piece on back of Cube shoe, stripe on Photon shoe.

Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- “Photon” below, “Cube” right:

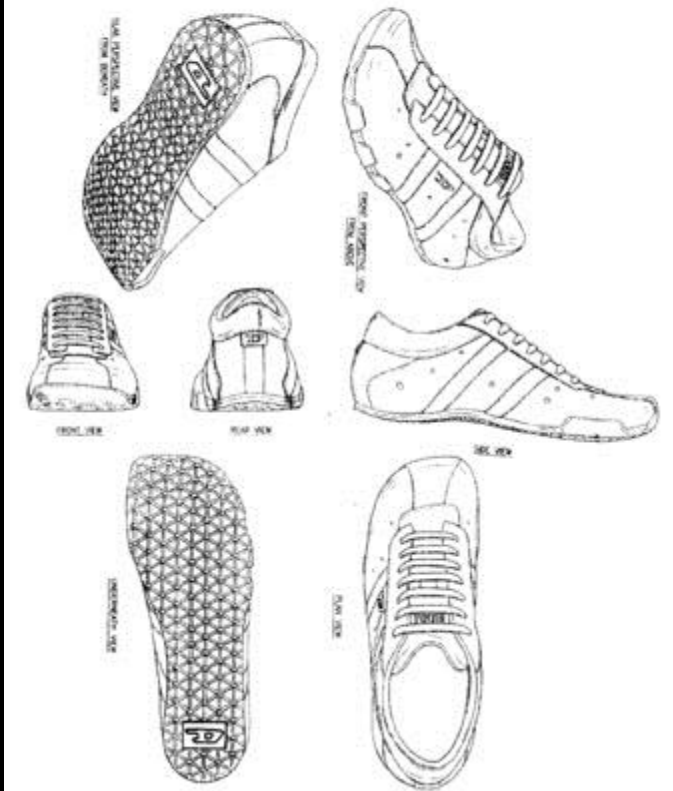


Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J:
- YD shoes not substantially identical to shape TM or sole TM.
- YD shoes not deceptively similar to shape TM:
 - Stylised D is most dominant feature of shape TM
 - Stylised D should not be discounted for infringement, given the endorsement on the registration, referring to D 3 times:
 - *The trade mark consists of a combination of the stylised letter D together with the shape of a SHOE including its features as depicted in the representations accompanying the application form. The stylised letter D appears on the rear and outer side of the shoe; the sole comprises a rubber cross-hatched pattern with a square containing the stylised letter D; and two oblique stripes on either side of the shoe and one vertical stripe on the rear.*

Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J:
 - Stripe at back of shape TM not present in the Cube shoe.
 - YD shoes labelled YD on inside sole.

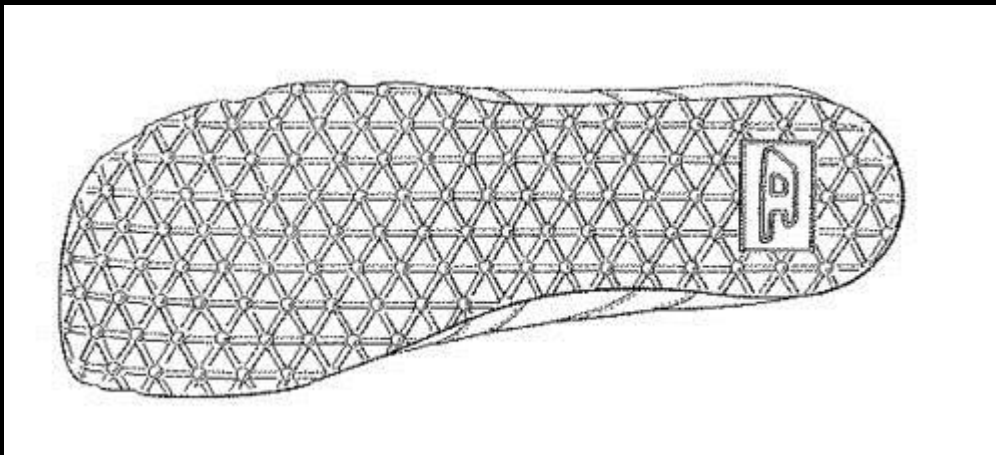


Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J:
 - Risk of confusion between shape TM and YD shoes mitigated by retail context:
 - “Metro-shoppers” are discerning and review labels.
 - YD shoes sold only in YD stores.
 - Expensive items, not impulse purchases.
 - No evidence of actual deception.

Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J:
- YD shoes not deceptively similar to sole TM:
 - YD Photon sole pattern closely resembles sole TM but does not contain stylised D.
 - Consumer purchases whole product, not just the sole.
 - Whole product must be examined.
 - Difficult to see how any consumer could miss the YD label inside sole.



Global Brand Marketing v YD Pty Ltd (2008) 76 IPR 161

- Sundberg J, dismissing cross-claim under s 41:
 - Shape and sole TM sufficiently distinctive for s 41(3).
 - Distinctive combination of features, especially the stylised D.
- Sundberg J, dismissing cross-claim under s 58:
 - Ownership not to be tested as at date of filing application, but during the application (following *Crazy Ron's*).
 - Global applied for TMs which included Diesel's stylised D TM.
 - TMs applications assigned by Global to Diesel, after which Diesel was the correct applicant under s 27 and 58.

Edwards v Liquid Engineering 2003 PL (2008) 77 IPR 115

- Edwards employed by Liquid Engineering Ltd (LEL)
- 3/2/03: Edwards applied to register 2 of LEL's product names
 - EXIT RUST and FUEL SET
- 5/2/03: LEL went into receivership
- March 2003 Edwards resigned from LEL
 - started own LIQUIDENG FARM SUPPLIES
- 8/4/03: LEL's business & TMs bought by Liquid Engineering 2003 PL (LE2003)
- LE2003 successfully applied to Registrar to remove Edwards' TM registrations under s 92(4)(a): no use in good faith because TM used in breach of fiduciary duties
- Edwards appealed to Federal Court
- LE2003 claimed ownership of FUEL SET and EXIT RUST, and infringement by Edwards of LIQUID ENGINEERING TM

Edwards v Liquid Engineering 2003 PL (2008) 77 IPR 115

- Gordon J, in obiter:
 - “Good faith” in s 92(4) requires no more than genuine intent to use TM for commercial purposes
 - “Good faith” does not involve any element of honesty or subjective good intentions
 - Would have upheld appeal from Registrar
 - Edwards used TMs in good faith even if in breach of fiduciary duties to his employer
 - But point now moot because LE2003 had subsequently established rectification of registrations because it was true owner of FUEL SET and EXIT RUST

Edwards v Liquid Engineering 2003 PL (2008) 77 IPR 115

- Gordon J:
 - LE2003 is owner of FUEL SET and EXIT RUST
 - Edwards' registrations held on constructive trust for LEL and then LE2003
 - Registrations to be rectified retrospectively
 - Edwards' LIQUIDENG FARM SUPPLIES deceptively similar to LIQUID ENGINEERING
 - Edwards intended to deceive
 - sold same goods to same customers as when employed by LEL
 - Account of profits granted against Edwards

Cadbury UK Ltd v Registrar of TMs [2008] FCA 1126

- Cadbury Ltd has various applications to register colour purple, opposed by Darrell Lea.
- Cadbury Ltd and Darrell Lea were involved in a passing off and TPA claim in the Federal Court.
- While Federal Court proceeding pending, Darrell Lea applied to suspend the opposition proceedings until the determination of the passing off action.
- 15 Jan 2008: Registrar's delegate suspended opposition
 - Cadbury Ltd v Darrell Lea (2008) 75 IPR 581
- Cadbury Ltd appealed suspension decision to Federal Court.

Cadbury UK Ltd v Registrar of TMs [2008] FCA 1126

- Finkelstein J, setting aside the delegate's decision to suspend:
 - TM Act and Regulations require the Registrar to deal with opposition proceedings as soon as practicable.
 - Merits of opposition are determined on the evidence before the Registrar and on the law as at hearing date.
 - Indefinite suspension of opposition amounts to a denial of justice and a refusal by the delegate to perform his or her duty.
 - To assume that the Registrar will likely follow the Court's findings indicates a real risk that the delegate would not make his or her own decision of the issues in the opposition.
 - Still sometimes appropriate to delay opposition proceedings to await Court decision - egs of considerations to take into account.

***Neumann v Sons of the Desert SL* [2008] FCA 1183**

- 1998: 3 parties in Spain agreed to incorporate a clothing company EL NINO.
- Parties agreed that each them would own TMs in equal shares.
- 2003: one party to contract applied in Australia for TM EL NINO TARIFA, another party to contract opposed.
- Registrar's delegate dismissed opposition.
- Ryan J, allowing appeal from delegate's decision:
 - Agreement meant that TM applicant was not owner for s 58.
 - Under s 42, use of TM would be contrary to law as:
 - breach of contract made in Spain;
 - Breach of Art 5 of the Spanish Unfair Competition Act.
 - Delegate wrongly allowed non-declaration evidence: reg 21.17(1)

***Rothbury Wines PL v Tyrrell* [2008] ATMO GI 1**

- Decision of the Deputy Registrar of TMs under Div 4 of *Australian Wine and Brandy Corporation Act* 1980
- Rothbury is an area in the Hunter Valley
- Tyrrell & ors applied to AWBC for determination of ROTHBURY as a Geographical Indication to describe a wine making area
- Rothbury Wines PL objected, claiming TM use of ROTHBURY for wines sourced from many areas
 - Registered TM: THE ROTHBURY ESTATE
 - Pending application for ROTHBURY
- Conflicting historical and expert evidence as to use of ROTHBURY

***Rothbury Wines PL v Tyrrell* [2008] ATMO GI 1**

- Key question under s 40RB AWBC Act:
 - Is proposed Geographical Indication “likely to deceive or cause confusion” with any of Rothbury Wines PL’s TMs
- Deputy Registrar Arblaster, rejecting Geographical Indication:
 - Evidence of use of ROTHBURY: more arbitrary (like NORTH POLE bananas) than descriptive (like MICHIGAN)
 - ROTHBURY referred to an ill-defined area
 - Most people described their address and source of wine as HUNTER VALLEY and/or POKOLBIN
 - ROTHBURY had developed 2nd meaning: Rothbury Wines PL
 - ESTATE lacks any capacity to distinguish winemakers’ goods

Insufficiently distinctive – s 41



Financial transaction devices including debit and credit cards and EFT cards

Cashcard Australia Ltd [2007] ATMO 70

TENNIS WAREHOUSE

Online retail services – tennis clothing & equipment

Fry Consulting Pty Ltd v Sports Warehouse Inc [2008] ATMO 21

Insufficiently distinctive – s 41

SMART HOME SOLUTIONS

Home automation and security systems

Complete Technology Integrations Pty Ltd v Smart Home Solutions Pty Ltd [2008] ATMO 39



Fish including cooked fish and chips.

("Panko" is a Japanese word used to specify a particular type of breadcrumb commonly used for deep frying.)

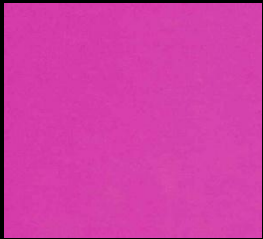
Pacific West Foods Australia Pty Ltd [2008] ATMO 47

Insufficiently distinctive – s 41

HELPS BABY BREATHE EASIER, NATURALLY

Saline preparations / nasal drops for babies

Valeant Pharmaceuticals International v Care Pharmaceuticals Pty Ltd [2008] ATMO 51



Pet food

Effen Foods v Nestle SA [2008] ATMO 55

Insufficiently distinctive – s 41

1800BLINDS

Sales of venetian blinds, other blinds, roller doors etc

1300 Australia Pty Ltd v 1800 Blinds Pty Ltd [2008] ATMO 57

CAMPARI

Fresh fruit and vegetables

Davide Campari-Milano SpA v Perfection Fresh Australia Pty Ltd [2008] ATMO 53

Sufficiently distinctive – s 41

ULTRA CREME

Building materials including pre-packed and bulk sand, cement

Cockburn Cement Ltd v BGC (Australia) Pty Ltd [2008] ATMO 13



Various classes including cosmetics; glasses/sunglasses; clothing for women & men

Quicksilver International Pty Ltd v s.Oliver Bernd Freier GmbH & Co KG [2008] ATMO 14

RED PAGES

Printed material; directory services relating to sexual health & lifestyle industry

Virgin Mobile (Aust) Pty Ltd v Camille Hardman [2008] ATMO 49

Substantially identical TMs



v

Palmlake Investments Pty Ltd v
Mister Rollershutter Pty Ltd
[2008] ATMO 5

The advertisement for Mr Rollershutter is a yellow rectangular banner. At the top left is a small cartoon character holding a shutter. To the right of the character, the text 'MR ROLLERSHUTTER' is written in a large, bold, red-outlined font. Below this, there are four small images: a residential shutter, a commercial building, a quality shutter, and a strength shutter. In the center, there is a list of bullet points: 'Protect Your Family & Business', 'Control Heat, Sound & Light', '100% Aluminium', 'Professional, Quality Trades People', '5 Year Full Service Warranty', and 'We Service & Repair All Makes of Shutters'. Below the list, there is a yellow oval with the text 'CALL FOR A FREE HOME DEMONSTRATION & QUOTE'. To the right of the oval, the text 'fax: 9302 5226' is written. Below the oval, the phone number '9362 1300' is written in a large, bold, black font. Below the phone number, the text 'WANGARA • OSBORNE PARK • FREMANTLE' is written. Below that, the text 'Showroom: 6 / 12 Paramount Dr, Wangara' is written. At the bottom, the website 'www.mrrollershutter.com.au' and the email 'email: mrrollershutter@bigpond.com' are written. The four small images are labeled: 'RESIDENTIAL' (top left), 'COMMERCIAL' (top right), 'QUALITY' (bottom left), and 'STRENGTH' (bottom right).

Not substantially identical TMs

- SAFE STEP v SAFETY STEP

Safety Step (NZ) Limited v Illinois Tool Works Inc [2007] ATMO 78

- HEALTHEWAY v HEALTHWAYS

Wyndella Pty Ltd v C. Sparkes-Carroll, C. Baffsky [2007] ATMO 79

- SOURCE v SOURCE HOMELOANS

Source Homeloans Pty Ltd v Coles Group Ltd [2008] ATMO 17

- BENCH v

Americana International Limited v Suyen Corporation [2008] ATMO 4



Deceptively similar TMs

- HUGGIE MUMMY v HUGGIES

Baby-toddler accessories

nappies etc

Kimberly-Clark Worldwide, Inc v Goulimis [2008] FCA 1415

- BBQ KING v Chatswood BBQ KING

Restaurant services etc

Anakin Pty Ltd v Chatswood BBQ King Pty Ltd [2008] FCA 1467



v



Entertainment services & Restaurant services

The Men's Gallery Australia Pty Ltd v Platinum 253 Pty Ltd [2008] ATMO 32

Deceptively similar TMs

•



v



&



Endoscopes & parts

Medical devices / pharmaceuticals

Bausch & Lomb Incorporated v Karl Storz & Ci KG [2008] ATMO 71

• **REBOVIR / REVOVIR v RETROVIR**

Anti-viral medications

Glaxo Wellcome Australia Ltd v Bukwang Pharm Co Ltd [2008] ATMO 12

Deceptively similar TMs



v

The Veritime logo, featuring a stylized checkmark icon above the word "Veritime" in a sans-serif font.

The Veriscan logo, featuring a stylized checkmark icon above the word "Veriscan" in a sans-serif font.

The Verilock logo, featuring a stylized checkmark icon above the word "Verilock" in a sans-serif font.

The Veriguard logo, featuring a stylized checkmark icon above the word "Veriguard" in a sans-serif font.

Fingerprint capture terminals etc

Verisign Inc v Vericorp Pty Ltd [2008] ATMO 30

Deceptively similar TMs

- SHARPLINE v SHARP

Dishwashers

Washing machines

Sharp Kabushiki Kaisha v Sharpline Stainless Steel Pty Ltd [2008] ATMO 62

- BOSE v BASE

Music systems etc

TVs, CD players etc

Bose Corporation v Target Australia Pty Ltd [2008] ATMO 54

- LUCKY DRAW, v LUCKIES
LUCKY DREAM

Cigarettes

British American Tobacco Australia Services Ltd v NV Sumatra Tobacco Trading Company [2008]
ATMO 68

Deceptively similar TMs

- HAFT v TAFT

Cosmetics etc

Hans Schwarzkopf & Henkel GmbH & Co KG v Tars International Limited [2008] ATMO 72

- SMARTMONEY v SMART MONEY ED

Financial services

Magazines, other media, computer programs

Hearst Corporation v FinancialCare Group Pty Ltd [2008] ATMO 75

Deceptively similar TMs

- **googlebay**

Information services

v



Computer hardware & software, telco services

Google, Inc v Dimitri Rytsk [2008] ATMO 40

- **DIRTY KUSTOMS INDUSTRIES** v **KUSTOM**

Apparel and skateboard accessories

Pineapple Trademarks Pty Ltd v Brent Lloyd Morely & Emma Kathleen Clancy [2007] ATMO 81

- **VALIUM**

v



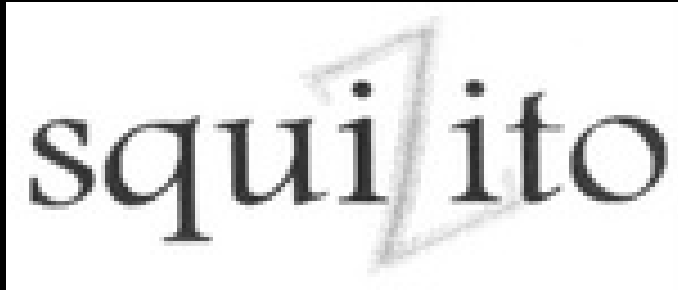
Pharmaceuticals

Clothing

Roche Products Limited v Hylebut Pty Limited [2007] ATMO 74

Deceptively similar TMs

•



v



Coffee, tea, basic cooking ingredients

Aceto Balsamico Del Duca di Adriano Grosoli S.r.l [2008] ATMO 2

• **BRIVIS PROFILER** v **PROFILE**

Evaporative air conditioners

Carrier Air Conditioning P/L v Climate Technologies P/L [2008] ATMO 9

• **DOULTON** v **ROYAL DOULTON**

Chocolate etc

Royal Doulton (UK) Pty Ltd v Confectionery Importers of Australia Pty Ltd [2008] ATMO 28

Deceptively similar TMs




(Pronounced WEI TA LEI in Cantonese)

...and...



Soy milk products

Not deceptively similar TMs

-  v VITASOY

...and...

-  v VITASOY

Soy milk products

Not deceptively similar TMs

- HEALTHPLUS v INNER HEALTH PLUS

Natural medicines etc

Health World Ltd v Shin-Sun Australia Pty Ltd (2008) 75 IPR 478

- STATSPOD v IPOD, IPODCAST

Computer hardware, business services etc

Apple Computer Inc v Gundy Computer Services Pty Ltd [2008] ATMO 33

- VIVENTI v AVANTI

Bicycles

Sheppard Industries Ltd v Gemini Bicycle Centres Pty Ltd [2008] ATMO 42

Not deceptively similar TMs

• DYNASPEC v DYNAPAC

Construction machines etc

Electric generators etc

Dynapac International Adtiebolag v Kobelco Construction Machinery Co, Ltd [2008] ATMO 59

• TRIPMATE v TRIPP

Travel goods, suitcases etc

Luggage

Tripp Limited v Import Manteau Pty Ltd [2008] ATMO 66

• AXION v AXIS

Video recorders etc

Axis Communications AB v Action Electronics Co Ltd [2008] ATMO 58

Not deceptively similar TMs

- POP PARFUM v POPSCENT, POP BEAUTY

Perfumes, cosmetics

Pop Beauty Ltd Cofinlux v Cofinlux Pop Beauty Ltd [2008] ATMO 10.

- ULTRA CRÈME v COCKBURN CREME
BRICKIE'S CREME

Building materials including cement

Cockburn Cement Ltd v BGC (Australia) Pty Ltd [2008] ATMO 13.

- ARGETA v VEGETA

Food items

Podravka Prehrambena Industrija d.d v Droga Kolinska Zivilska Industrija d.d [2008] ATMO 74

Not deceptively similar TMs

- **SIX IN THE CITY** v **SEX AND THE CITY**

Personal introduction services etc

TV series, movie

Home Box Office, Inc v Susan Stigwood Pty Ltd [2008] ATMO 31

“ . . . leaving aside the slight risk of confusion involving the well-known tendency of New Zealanders to pronounce “six” in a way that resembles “sex”, no realistic likelihood of actual mistake, or of confusion, exists.”

- **ALDI** v

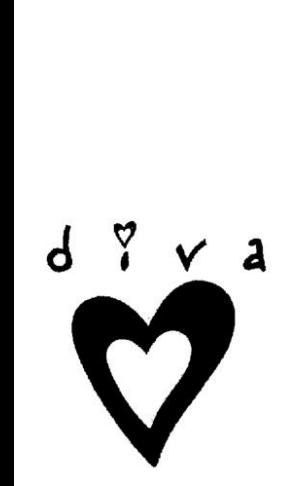



Coffee, tea sugar etc

Aldi Stores v Kaldi Coffee Pty Ltd [2008] ATMO 29

Not deceptively similar TMs

-  & “DIVA DOLLS” v “DIVA” &



-  v “SASS” and “SASSI”

(Words: SASS DIVA)

Not deceptively similar TMs

- LUMIE v



Alarm clock

Swatch AG v Christopher Gray [2008] ATMO 48

-  v

CONTOURA

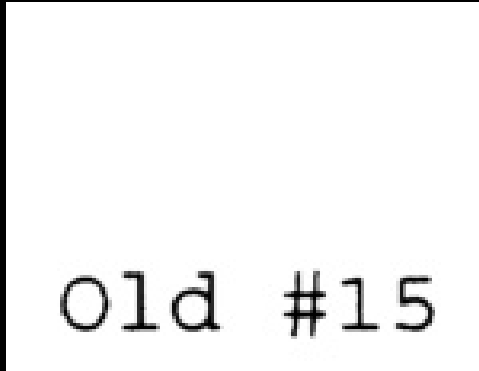
Beds – mattress & base

Hospital beds

Huntleigh Technology plc v Bedshed Franchising Pty Ltd [2008] ATMO 50

Not deceptively similar TMs

-



v



Wines, spirits, liqueurs

Jack Daniel's Properties Inc v Boondy Pty Ltd [2008] ATMO 52

- **STALINSKAYA v STOLICHNAYA**

Alcoholic beverages etc

Spirits International B.V v SC Prodal '94 SRL [2008] ATMO 22

Not deceptively similar TMs

•



v

Various “-B-GON” Trademarks
including “BUG-B-GON” and
“FLEA-B-GON”

Insect repelling devices

OMS Investments Inc v Gone Enterprises Pty Ltd [2008] ATMO 1

• FERRARI SHOP v

and



DIANA FERRARI

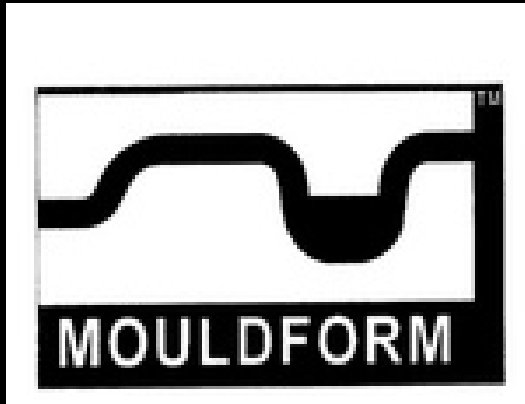
Clothing, footwear & accessories

Retail services , including clothing and footwear

Diana Ferrari (Australia) Pty Ltd v Ferrari SpA [2008] ATMO 73

Not deceptively similar TMs

-



v



Machines & machine tools for moulding. Computer-aided design services for moulds
Moldflow Corporation v Advanced Moulding Technologies Pty Ltd [2008] ATMO 15



v

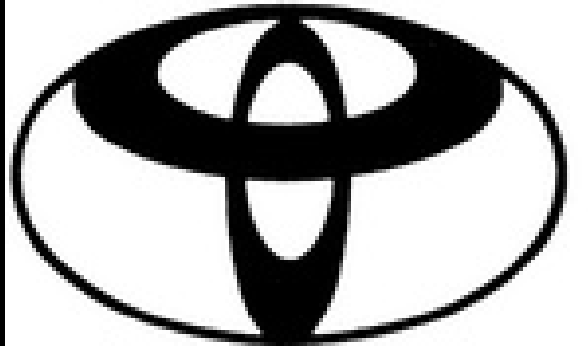


Buttons, studs, other fasteners

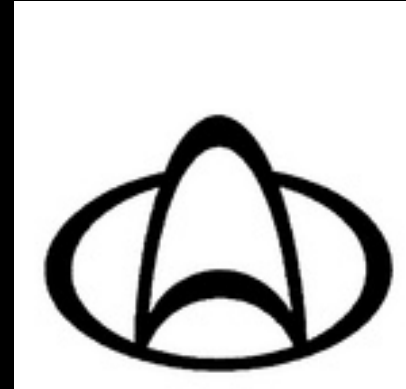
Velcro Industries B.V v SSS Pty Ltd [2008] ATMO 19

Not deceptively similar TMs

-



v



Automobiles

Toyota Motor Corporation v Changan Automobile (Group) Liability Corp Limited [2008] ATMO 27

-



v



Clothing etc

Rocket Trademarks Pty Ltd v Coolibar, Inc [2008] ATMO 67

Similar goods/services

- Dishwashers v Stoves, washing machines and refrigerators

Sharp Kabushiki Kaisha v Sharpline Stainless Steel Pty Ltd [2008] ATMO 62

- Real estate agents, sales, leasing and management v

Business management, leasing of access time to telecommunications networks, auction services

Christian Dior Couture v Dior Investments Pty Ltd [2008] ATMO 18

Sufficient reputation for s 60

- GREENJOYS v



5,800 pairs of golf shoes since 1994

Golf equipment

Acushnet Company v Shenzhen Hi-Thch Golf Corporation [2007] ATMO 73

- BIG DAY OUT/
BIG DAY IN v



Clothing / business administration

Big Day Films Pty Ltd v Big Day Enterprises [2008] ATMO 63

Insufficient reputation for s 60

- THE PARTY BUS v



Agency services: arranging tours, sightseeing tours etc.

Action Tours Pty Ltd v Dreamscape Tours Pty Ltd [2008] ATMO 65

- IN FOCUS / INFOCUS v



Reseller of DVD movies, games, music

Electronic display devices

Infocus Corporation v In Focus DVD Pty Limited [2007] ATMO 76

Stay tuned . . .

- What is “bad faith” for purposes of opposition or rectification under s 62A (for TMs accepted after 23 October 2006)?
 - S 62A: *The registration of a trade mark may be opposed on the ground that the application was made in bad faith.*