

---

# Trade Marks Update

**IPSANZ Seminar  
Sydney – 21 October 2013**

**Ed Heerey & Ben Gardiner**

**List G Barristers**

**Melbourne**

The logo for List G Barristers features the word "List" in a white, lowercase, sans-serif font, followed by a large, stylized yellow letter "G" that is partially enclosed by a thin white line. To the right of the "G" is the word "barristers" in a white, lowercase, sans-serif font.

List**G**barristers

## Melbourne Cup – fashion tips



## Melbourne Cup – fashion tips

---

Colourful?



## Melbourne Cup – fashion tips

---

Playful?



## Melbourne Cup – fashion tips

---

- You be the judge



# Intellectual Property Laws Amendment (Raising the Bar) Act 2012

---

- Amendments to Trade Marks Act took effect from

**15 April 2013**

# Intellectual Property Laws Amendment (Raising the Bar) Act 2012

---

- **Notice on ATMOSS web-page:**
  - Opposition period has been reduced to **2 months** for TMs advertised as accepted on or after 15 April 2013
  - Same for removal applications advertised on/after that date

# Intellectual Property Laws Amendment (Raising the Bar) Act 2012

---

- **Key amendments to TMA as from 15/4/03:**
  - s 41 reframed to clarify that presumption of registrability applies
    - tests reformulated in the negative
    - Applies only to TMs filed after 15 April 2013:
      - *Clearlight v Sandvik* [2013] ATMO 50
  - s 126(2) – additional damages
  - ss 52A and 54A – opposed TM application lapses if applicant does not file notice of intention to defend opposition within prescribed time
  - s 229 - TM and patent attorney's privilege extended to communications, records and documents made for the “*dominant purpose*” of providing intellectual property advice

## Intellectual Property Laws Amendment (Raising the Bar) Act 2012

---

- **Key amendments to TMA as from 15/4/03:**
  - ss 134-139 – more detailed procedure for Customs seizure
  - ss 35, 56, 67, 83(2), 83A(8), 84D and 104:
    - Federal Circuit Court (former Federal Magistrates Court) now has same jurisdiction as Federal Court in all TM matters

## ***Tivo Inc v Vivo Corporation [2012] FCA 252***

---

- TiVo had sold video recorders in US since 1999 with novel functions:
  - freezing and rewinding live TV
  - recommending shows on the basis of other show watched
- 1999: TiVo TM registered in Australia
- Significant sales and high profile in US
  - many references in popular culture, eg Sex and the City, Bee Movie
- Spillover reputation in Australia through press articles and popular culture?
- TiVo not launched in Australia until July 2008
- However, some Australian enthusiasts had already bought TiVo units from US and hacked them to work in Australia

## ***Tivo Inc v Vivo Corporation [2012] FCA 252***

---

- Vivo began selling VIVO televisions in Australia in 2007
- Vivo applied to register VIVO TM in February 2008
  - Prior to launch of TiVo in Australia in July 2008
- Tivo sued Vivo for revocation of VIVO TM, and infringement of TiVo TM
- Dodds-Streeton J:
  - Rejected Vivo's evidence of no prior knowledge of TiVo
  - Found reputation of TiVo in Australia before VIVO TM application
  - Found deliberate intention by VIVO to benefit from reputation in TiVo
  - Found VIVO deceptively similar to TiVo
  - Revoked VIVO TM under ss 44 and 60
  - Found infringement of TiVo upon revocation of VIVO TM

## ***Vivo Corporation v Tivo Inc* [2012] FCAFC 159**

---

Nicholas J (Dowsett J agreeing) finding error but dismissing appeal:

- Evidence of Vivo's expert linguist should have been given weight
  - But that evidence did not make allowance for imperfect recollection
- Evidence of confusion in this case should not have been given weight
  - Some other factor may explain confusion by sales staff
- Trial J's finding of no visual similarity not challenged on appeal
- But oral use of TM is significant in this case
- Real danger of confusion for consumers speaking with sales staff:
  - Strong phonetic similarity between TIVO and VIVO for consumers with imperfect recollection of TIVO
- S 44 decision upheld - unnecessary to consider s 60 and reputation in Australia

## ***Vivo Corporation v Tivo Inc* [2012] FCAFC 159**

---

Keane CJ, also finding error but dismissing appeal:

- Phonetic similarity of TIVO and VIVO is sufficient to give rise to a real danger of confusion
- Agreeing with Nicholas and Dowsett JJ:
  - The trial Judge erred in taking Vivo's intention into account on deceptive similarity – Tivo did not rely on such intention at trial
- Disagreeing with Nicholas and Dowsett JJ:
  - Great weight should be placed on the evidence of confusion of sales staff
  - If sales staff are confused, there is a reasonable probability of confusion by consumers
- Decision under s 44 upheld, no consideration of s 60

## ***Vivo Corporation v Tivo Inc* [2012] FCAFC 159**

---

Keane CJ, also finding error but dismissing appeal:

- Phonetic similarity of TIVO and VIVO is sufficient to give rise to a real danger of confusion
- Agreeing with Nicholas and Dowsett JJ:
  - The trial Judge erred in taking Vivo's intention into account on deceptive similarity – Tivo did not rely on such intention at trial
- Disagreeing with Nicholas and Dowsett JJ:
  - Great weight should be placed on the evidence of confusion of sales staff
  - If sales staff are confused, there is a reasonable probability of confusion by consumers
- Decision under s 44 upheld, no consideration of s 60

## ***Winnebago Industries, Inc v Knott Investments [2012]*** **FCA 785**

---

- Winnebago is name of a county, river and local Native American tribe in Iowa, USA
- Winnebago Inc making recreational vehicles (RVs) since 1960s
- 1972-3: Winnebago Inc registered WINNEBAGO TMs in USA
- Winnebago Inc has sold RVs in US, Canada and Europe
- Until 2010, Winnebago Inc had not exported RVs to Australia, but since then has expressed an interest in doing so
- Sometime between 1978 and 1982 (disputed), Knott began making WINNEBAGO RVs in Australia
- 1985: Winnebago Inc put on notice of Knott's use of WINNEBAGO
- 1992: "Settlement Agreement" between Winnebago Inc and Knott
- 1997: Knott registered WINNEBAGO TM in Australia

## ***Winnebago Industries, Inc v Knott Investments [2012]*** **FCA 785**

---

- 2010: Winnebago Inc demanded that Knott cease using WINNEBAGO
- Commenced infringement proceeding 25 years after knowledge of Knott's use of WINNEBAGO

Foster J, upholding Winnebago Inc's claim:

- Winnebago Inc enjoyed reputation in Australia as at 1982
  - Best evidence of reputation is that Knott chose to hijack it
- Knott has committed passing off and misleading conduct
- Knott's TM should be cancelled under s 60
- Rejected defences of consent, authorisation, estoppel, laches, acquiescence and delay
  - 1992 Settlement Agreement reserved Winnebago Inc's rights and left matters as they stood until Winnebago Inc wished to sue

## ***Knott Investments v Winnebago Industries, Inc* [2013] FCAFC 59**

---

- Knott appealed to Full Federal Court

Allsop CJ, Cowdroy and Jagot JJ:

- Relevant date to assess Winnebago Inc's reputation was 1978
- Winnebago Inc had a sufficient reputation in Australia at 1978 to found a passing off and misleading conduct claim
- No defence in estoppel, laches, acquiescence or delay
- However, Winnebago Inc stood by for 25 years, informed of Knott's conduct, while Knott expended money building a business, at least part of which was Knott's own reputation
- In such circumstances, it is unjust to require Knott to cease using the name if a clear distinction between Winnebago Inc and Knott can be made on the vehicles and all documents

## ***Knott Investments v Winnebago Industries, Inc* [2013] FCAFC 59**

---

Full Court upheld the cancellation of Knott's TM:

Allsop CJ and Cowdroy J: cancellation justified under s 43

- TM likely to deceive or cause confusion because of the existence of the reputation of Winnebago when TM applied for in 1997
  - *[cf Spender J in Winton Shire Council v Lomas 56 IPR 72:*
    - *s 43 TMA is directed to TM itself, not deception or confusion caused by reputation of some other TM*
    - *see also Gyles J in Pfizer v Karam 70 IPR 599]*
- Rejected submission that deception or confusion arose more from the informed and deliberate inaction of Winnebago Inc

## ***Knott Investments v Winnebago Industries, Inc (No 2)*** **[2013] FCAFC 117**

---

Allsop CJ, Cowdroy and Jagot JJ:

- Knott enjoined from using WINNEBAGO name or logo without stating clearly and prominently and reasonably proximate:
  - *“This vehicle was not manufactured by, or by anyone having any association with, Winnebago of the United States”*
- Knott enjoined from dealing in vehicles bearing the WINNEBAGO name without first requiring consumers to sign a form stating that they have been informed that those vehicles were not manufactured by, or by anyone having any association with, Winnebago of the United States.
- NB: TM rights not enforced in this litigation, only passing off and TPA
  - Will Winnebago now enforce TM monopoly, now that Knott’s TM is cancelled?

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

- Cantarella has imported Italian foodstuffs since 1947
- Cantarella owns TMs ORO and CINQUE STELLE for coffee
- ORO is Italian for GOLD
- CINQUE STELLE is Italian for FIVE STARS
- Cantarella has sold in Australia:
  - VITTORIA ORO branded coffee since 1996
  - VITTORIA CINQUE STELLE branded coffee since 2000
- Since 2009, Modena imported coffee supplied by Molinari SpA branded
  - CAFFÈ MOLINARI ORO and
  - CAFFÈ MOLINARI CINQUE STELLE
- Cantarella sued Modena for TM infringement

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

- Modena's defence:
  - ORO and CINQUE STELLE not used as TMs
  - ORO and CINQUE STELLE used in good faith to indicate the characteristics of the coffee products: s 122(1)(b)(i)
- Modena's cross-claim:
  - ORO and CINQUE STELLE not registrable under s 41
    - not inherently adapted to distinguish or in fact distinctive
  - ORO and CINQUE STELLE should be removed under s 92(4)(b)(i) because Cantarella has not used them as TMs for 3 years

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

Emmett J, finding ORO and CINQUE STELLE inherently adapted to distinguish:

- Distinctiveness of foreign word depends on whether the particular word is sufficiently well understood in Australia
- 2006 Census: 316,685 people in Australia spoke Italian
  - Second most used language in Australia
- Meaning of CINQUE STELLA and ORO may be clear enough to an Italian speaker
- But only a small minority of English-speaking people in Australia would understand the allusions made by those words
- CINQUE STELLA and ORO would not be generally understood in Australia as having laudatory meanings of FIVE STARS and GOLD

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

Modena argued that Cantarella had not used ORO or CINQUE as TMs:

- Cantarella has used VITTORIA as TM to distinguish its goods from other traders
- Cantarella has only used ORO and CINQUE STELLE to distinguish between products within Cantarella's own range
- Dozens of other coffee distributors in Australia use ORO

Emmett J, finding Cantarella used ORO and CINQUE STELLE as TMs:

- CINQUE STELLE and ORO used almost invariably in conjunction with TM VITTORIA, but conjunctive use does not indicate that CINQUE STELLE and ORO are used only to distinguish different categories of Cantarella's products

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

Emmett J, finding CINQUE STELLA and ORO used as TMs by Modena:

- Packaging and website include examples of use to designate origin:
  - *“Cinque Stelle is a coffee bar line specially [sic] for those wishing to serve coffee with unmistakable aroma in the Caffè Molinari tradition. The reasons for choosing Cinque Stelle are [that] the way the blends are selected guarantees the constant quality of the product”*
  - *“The blends carrying the Cinque Stelle name are the pinnacle of our craft, bringing together selected Arabica and Robusta beans from plantations around the world, then blending and roasting them to perfection for an exceptional coffee experience.”*
  - *“For those who are used to the best, Oro, Italian for gold, is an exquisite blend of select Arabica and Robusta beans. Enjoy Oro for a full body, rich crema and unmistakable aroma.”*

## ***Cantarella Bros PL v Modena Trading PL [2013] FCA 8***

---

Emmett J, rejecting defence for use in good faith to indicate the kind, quality or other characteristics of the goods (s 122(1)(b)):

- Not persuaded by evidence from Modena's managing director that he believed CINQUE STELLE and ORO were being used simply as an indication of quality
- It may be that he did not intend to make deliberate use of any goodwill arising from Cantarella's use of CINQUE STELLE and ORO
- Nevertheless, Modena used CINQUE STELLE and ORO as TMs, and is not entitled to defence under s 122(1)(b)
- Infringement found, no defence
- [NB – passing off and misleading conduct claims dismissed due to references to CAFFÈ MOLINARI on Modena's products.]

## ***Modena Trading v Cantarella Bros* [2013] FCAFC 110**

---

- Modena appealed to Full Federal Court:
  - S 41(2) and (3): that ORO and CINQUE STELLE are not capable of distinguishing
  - S 92: that Cantarella had not used ORO and CINQUE STELLE as TMs
- Appeal upheld by Mansfield, Jacobson & Gilmour JJ

## ***Modena Trading v Cantarella Bros* [2013] FCAFC 110**

---

Mansfield, Jacobson & Gilmour JJ on inherent adaption to distinguish:

- it was inappropriate to consider whether the Italian words were “commonly understood” or “generally understood” in Australia by “ordinary English speaking persons” as meaning five stars and gold.
- Even an English word may be descriptive despite being not “commonly understood”, eg EUTECTIC: (1980) 32 ALR 211

## ***Modena Trading v Cantarella Bros [2013] FCAFC 110***

---

Mansfield, Jacobson & Gilmour JJ on inherent adaptation to distinguish:

- *“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.”*
- The “common heritage” here included that of traders in coffee products sourced from Italy.
- Such traders may well be Italian or local importers, or 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.
- Coffee in Australia is often associated with Italy.

## ***Modena Trading v Cantarella Bros* [2013] FCAFC 110**

---

Mansfield, Jacobson & Gilmour JJ on inherent adaption to distinguish:

- It is relevant whether other traders have also used the words.
- However, it is not necessary to establish descriptiveness, that other traders have used the words as TMs.
- It is unnecessary that consumers know what the words mean in English.
- However, given that Italian is the second most spoken language in Australia, many people would in fact know what the words meant.
- Moreover, Cantarella explains on its packaging that “Oro” means “gold”.
- Many Italian speakers would have understood CINQUE STELLE and ORO as common Italian laudatory descriptive words.

## ***Modena Trading v Cantarella Bros* [2013] FCAFC 110**

---

Mansfield, Jacobson & Gilmour JJ on inherent adaption to distinguish:

- Other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use ORO and CINQUE STELLE in connection with their own coffee-related goods, because:
  - First, the words mean "gold" and "five stars", signifying high quality.
  - Secondly, coffee in Australia is often associated with Italy, thus it is obvious to use Italian words to describe the quality of a coffee blend.
  - Thirdly, Italian is the second most utilised language in Australia.
  - Fourthly, Cantarella uses the words to describe product quality.
  - Finally, and most importantly, other coffee traders have used the words ORO and CINQUE STELLE.

## ***Modena Trading v Cantarella Bros* [2013] FCAFC 110**

---

Mansfield, Jacobson & Gilmour JJ:

- S 41: ORO and CINQUE STELLE not inherently adapted to distinguish.
- S 92: Canterella has not used ORO and CINQUE STELLE as TMs.
- Canterella's TMs cancelled.
- Cantarella's TM claim dismissed.

## **SMA Solar Technology AG v Beyond Building Systems Pty Ltd (No 5) [2012] FCA 1483**

- SMA owns TM SUNNY BOY for energy supplying devices including inverters (used with solar electricity panels)
- BBS sold and installed complete solar energy systems, including solar inverters, under SUNNY ROO TM and variants

Perram J:

- Each of SUNNY ROO, SUNNY ROO PRODUCTS, SUNNY ROO FROM BYRON BAY and SUNNY ROO AUSTRALIA is deceptively similar to SUNNY BOY
- BBS's service of installing inverters was closely related to the inverters which were SMA's registered goods
- But, BBS's solar panels and accessories were not goods of the same description as inverters

## ***DC Comics v Cheqout PL [2013] FCA 478***

---

- Cheqout applied for SUPERMAN WORKOUT in respect of exercise classes, fitness clinics, health club services etc.
- Unsuccessfully opposed by DC, publisher of SUPERMAN comics

Bennett J, allowing appeal from Registrar's decision:

- S 60 opposition not made out – SUPERMAN WORKOUT not likely to be confused with unregistered SUPERMAN TM
- S 62A opposition made out – registration in bad faith
  - Clear inference that Cheqout intended to use SUPERMAN WORKOUT in combination with a BG shield device and red, white and blue colours in order to strengthen allusion to Superman
  - Design of BG shield device closely resembles Superman insignia

## *Louis Vuitton v Sonya Valentine PL [2013] FCA 933*

---

Jessup J:

- Louis Vuitton's flower logo TM infringed by logo on Respondent's sunglasses:



- However, Respondent's TM LOUIS V not deceptively similar to LOUIS VUITTON

## ***Louis Vuitton v Sonya Valentine PL [2013] FCA 933***

---

Jessup J:

- *“Particularly in a case such as the present in which the applicant’s name, repeated on the heading of every court document, includes the mark which it seeks to protect, it is tempting for a judge – and for counsel for that matter – to regard the mark as the centre of the universe, and thus readily to perceive a deceptive similarity in some other mark which has something in common with it. That temptation must be resisted.”*
- Evidence of reputation of LOUIS VUITTON (solicitor’s affidavit on instructions from client) was insufficient to establish that it is *“notoriously so ubiquitous and of such long standing that consumers generally must be taken to be familiar with it and its use in relation to particular goods”* so as to be relevant on infringement (*Henschke*)

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

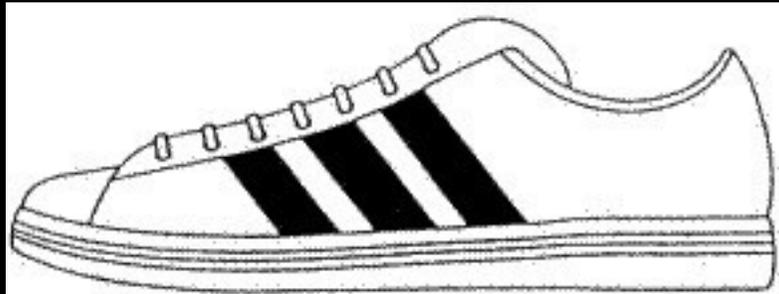
---

- Adidas's registered TMs for sports shoes ("3 Stripes" TM):

- Since 1957:



- Since 2002:



# ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

- Infringement alleged in respect of a series of shoes with 4 stripes:



## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J on use of the 4 stripes “as a TM”:

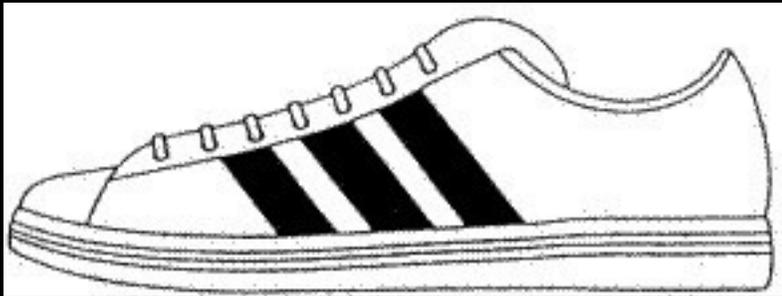
- In each case the 4 stripes on sides of footwear were used as a TM
- evidence was that identifying signs are generally placed on the side of sports footwear
- this indicates that the decorative element of the stripes or their indication that each shoe is a sports shoe would not be dominant
- “. . . the fact that that a company, such as the respondent company, does not invest in promoting brand elements or does not ensure their consistent application does not necessarily lead to consumers disassociating such elements from their existing understanding of the category, which is likely to include perceptions that sport shoes feature brand symbols on them.”

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Deceptively similar:



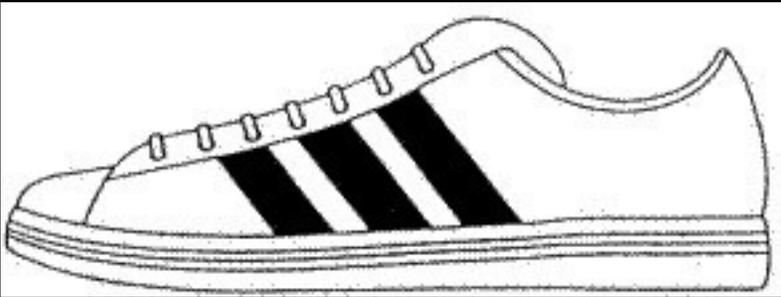
- parallel equidistant stripes of equal width (with blue edgings) in a different or contrasting colour to the footwear, running from the lacing area to the instep area of the shoes

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Not deceptively similar:



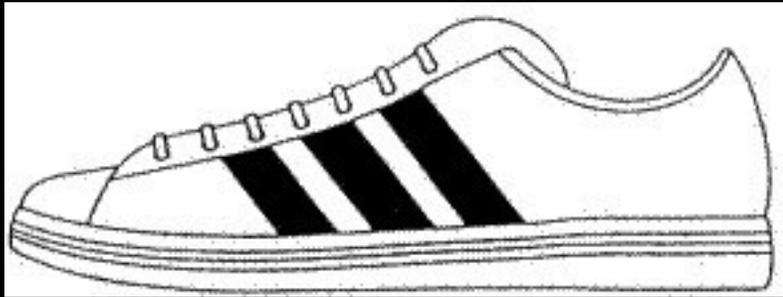
- 4 stripes with an obvious slightly wider gap between 2<sup>nd</sup> and 3<sup>rd</sup> stripes
- the inclusion of panels in the shoe of a similar colour to the stripes and the stitched-in element of contrasting colour (white) extending behind the stripes, mean that as a matter of impression there is no deceptive similarity with the 3-stripe TM.
- no sufficiently clear impression of the stripes forming a contrast to the basic colour of the shoes

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Not deceptively similar:



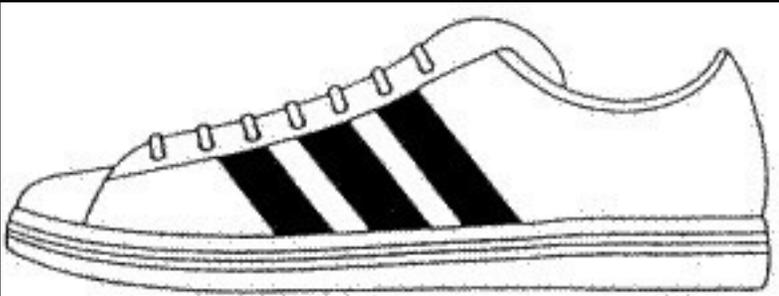
- Same reasoning as previous exhibit.

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Not deceptively similar



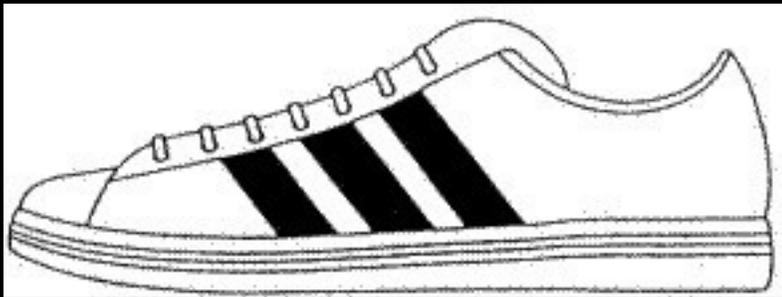
- 4 stripes with a slightly wider gap between 2<sup>nd</sup> and 3<sup>rd</sup> stripes which is readily noticeable
- a tab, being a bridging strip running horizontally between the two pairs of stripes, which is immediately noticeable
- these features substantially modify what a person in the market place would take from the impression based on recollection of Adidas's TMs and the features of them when considering this shoe

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Not deceptively similar:



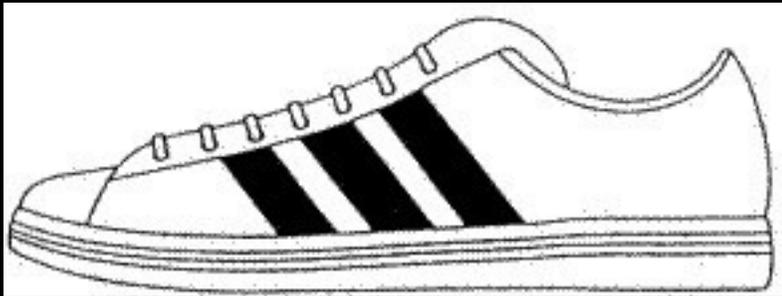
- four stripes, but a wider gap between the two central stripes
- the result is two groups of two parallel stripes
- in any event, there are not three, or four, equidistant stripes

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Deceptively similar:



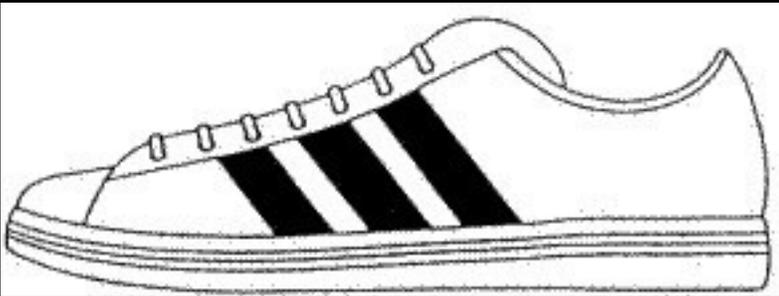
- the greater distance between 2nd and 3rd stripes was very slight and, only noticeable upon a close inspection
- the background design does not remove any contrast between the stripes and the remainder of the shoe
- Accordingly, TM used retained memorable elements of 3-Stripe TMs

## ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Deceptively similar:



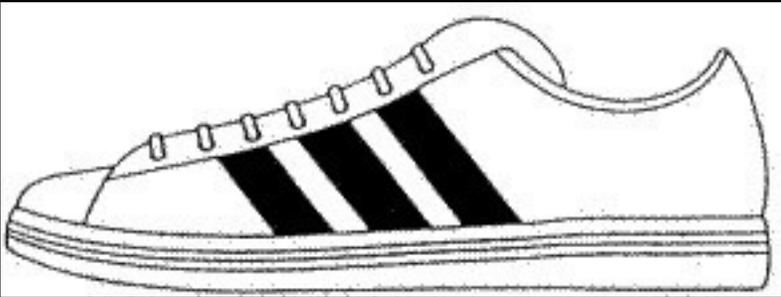
- Same reasoning as previous exhibit

# *Adidas AG v Pacific Brands Footwear [2013] FCA 905*

---

Robertson J:

- Not deceptively similar:



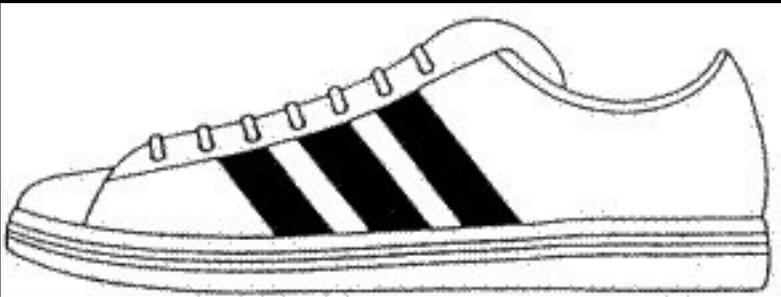
- obvious wider gap between 2<sup>nd</sup> and 3<sup>rd</sup> stripes
- also a short horizontal strip connecting the second and third stripes
- inclusion of panels of a similar pink colour of stripes, and the stitched-in element of contrasting white colour
- no sufficiently clear impression of the stripes forming a contrast to the basic colour of the shoes

# ***Adidas AG v Pacific Brands Footwear [2013] FCA 905***

---

Robertson J:

- Not deceptively similar:



- 4 stripes taper to narrower bottom end, therefore not of equal width
- gaps between the stripes are not equal and taper towards the top
- 4 stripes have a curved element and are therefore not parallel
- this shoe does not create the visual impression of three parallel equidistant stripes of equal width

## ***Lift Shop PL v Easy Living Home Elevators PL [2013]*** **FCA 900**

---

- Applicant's registered TM: LIFTSHOP for elevators

Buchanan J, dismissing TM infringement claim:

- Respondent did not use LIFT SHOP as a TM in its webpage title as displayed in internet search results:

Easy Living Lifts | Home Elevators | Lift Shop – Lift Shop  
[www.easy-living.com.au](http://www.easy-living.com.au)

## ***REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559***

---

- REA operates [www.realestate.com.au](http://www.realestate.com.au) and [www.realcommercial.com.au](http://www.realcommercial.com.au)
- Real Estate 1 operates [www.realestate1.com.au](http://www.realestate1.com.au) and [www.realcommercial1.com.au](http://www.realcommercial1.com.au)
- All these webpages used as portals listing properties for sale or rent
- REA sued Real Estate 1 for misleading conduct (s 52 TPA), passing off and infringement of registered TMs

Bromberg J:

- TPA and passing off claims dismissed

# ***REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559***

- REA's registered TMs and alleged infringing TMs:

 <b>realestate.com.au</b>	 <b>realEstate1.com.au</b>
	realestate1.com.au or realEstate1.com.au
	www.realestate1.com.au
 <b>realcommercial.com.au</b>	 <b>realCommercial1.com.au</b>
	realcommercial1.com.au or realCommercial1.com.au
	www.realcommercial1.com.au

## ***REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559***

---

Bromberg J:

- Not deceptively similar:



- Essential or distinguishing feature of registered TM is domain name in its entirety
- No real danger of confusion:
  - logo differentiated by capital “E”, colour used, and use of “1”
  - placement of house device in the middle of the logo sidelines “.com.au” and projects “realEstate1” as the dominant element

## *REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559*

---

Bromberg J:

- Deceptively similar:



- Essential feature of registered TM is concocted words “realcommercial”
- Same concocted words are prominent in Real Estate 1’s logo, and are the strongest element in that logo
- Follows that each of Real Estate 1’s other uses of [www.realcommercial1.com.au](http://www.realcommercial1.com.au) also infringe

## ***REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559***

---

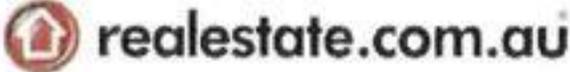
Bromberg J:

- Deceptively similar, each of:
    - [realestate1.com.au](http://realestate1.com.au)
    - [realEstate1.com.au](http://realEstate1.com.au)
    - [www.realestate1.com.au](http://www.realestate1.com.au) and
- 
- “realestate.com.au” is both a brand and a domain name at the same time, and “realestate1.com.au” took that precise idea
  - Consumers likely to scan the whole domain name, and “1” is likely to be missed by some consumers
  - Suffix “.com.au” is essential to brand recognition, given the highly descriptive nature of “realestate” – consumers are likely to look beyond “realestate” to the entire domain name to establish identity

# ***REA Group Ltd v Real Estate 1 Ltd [2013] FCA 559***

Bromberg J, conclusion on TM infringement:

- All but first logo infringe REA's TMs

	
	realestate1.com.au or realEstate1.com.au
	www.realestate1.com.au
	
	realcommercial1.com.au or realCommercial1.com.au
	www.realcommercial1.com.au

## ATMO Decisions

---

Trade Marks Office decisions

**Insufficiently distinctive – s 41**

---

**YOU'RE LOCAL, WE'RE LOCAL**

Various classes relating to telephone directories & associated goods  
and services

*Telstra Corporation Limited v Phone Directories Company Australia  
Pty Ltd [2012] ATMO 114*

# Insufficiently distinctive – s 41

---

## APR

Pharmaceutical preparations etc

*Celgene Corporation* [2012] ATMO 119

Insufficiently distinctive – s 41

---

# SAN REMO

Remote controls & related devices; technological consultancy

*Clearlight Investments Pty Ltd v Sandvik Mining and Construction Oy*  
[2013] ATMO 50

**Insufficiently distinctive – s 41**

---

# **REMISSION POSSIBLE**

Pharmaceutical preparations, medical information services

*Wyeth LLC* [2013] ATMO 59

**Insufficiently distinctive – s 41**

---

# **RITE PRICE**

Heating and cooling systems: retail sales, installation, maintenance & repair.

*Knowles Airconditioning & Plumbing Pty Ltd [2013] ATMO 42*

Insufficiently distinctive – s 41

---

# SEADWARF PASPALUM SDX-1

Natural turf, turf grasses etc

Mark is the name of a particular plant of the genus Paspalum

*SFR Holdings Inc* [2013] ATMO 77

**Insufficiently distinctive – s 41**

---

# **PAVEWAY**

**Laser-guided bomb kits**

Wikipedia: *PAVEWAY* is a generic term for laser guided bombs



***Lockheed Martin Corporation v Raytheon Company [2012] ATMO 102***

**Insufficiently distinctive – s 41**

---

# **AERO SPORTS CARS**

Motor vehicles in assembled form

*Morgan Motor Company Ltd v Aero Investments Pty Ltd* [2012] ATMO 91

## Insufficiently distinctive – s 41

---



TM sought for barcode commencing with “93-” for supply chain management solutions, data synchronisation systems and bar coding etc

*GS1 Australia Ltd* [2012] ATMO 123

## Insufficiently distinctive – s 41

---

# EXTRA DRY

Beers and ales

*Michael Harvey v Lion-Beer, Spirits & Wine Pty Ltd* [2013] ATMO 5

S41(6) applied but no use of the mark prior to the filing date.

**Insufficiently distinctive – s 41**

---

# **MACKAY AIRPORT**

Tourism promotions, real estate leasing, property development, aeroplane maintenance, air transport etc

*Mackay Airport Pty. Limited* [2013] ATMO 17

S41(6) considered but acquired distinctiveness not established

## Insufficiently distinctive – s 41

---

# APP STORE

Retail store services featuring computer software provided via the Internet; Telco services; maintenance, repair and updating of computer software.

*Apple Inc.* [2013] ATMO 13

S41(5) considered but acquired distinctiveness not established

## Insufficiently distinctive – s 41

---

A green striplight (neon, LED or similar) affixed to the edge of the canopy over the petrol pumps at vehicle service stations as shown in the representation attached to the application form.



*Fuels, retail of fuels, vehicle refuelling etc, take away food services etc*

*Woolworths Limited v BP p.l.c. [2013] ATMO 61*

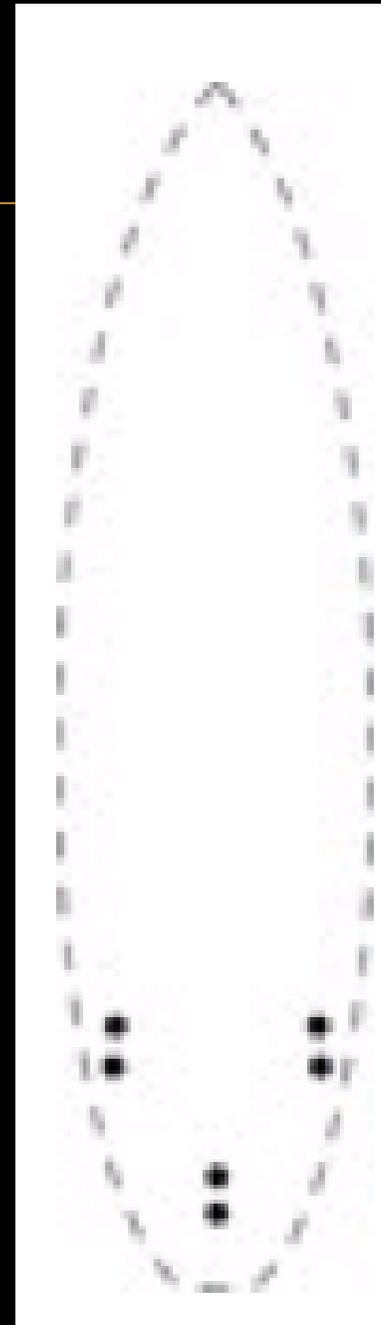
## Insufficiently distinctive – s 41

---

**Pairs of dots on a surfboard –  
the outline of the board  
does not form part  
of the mark**

*Surfboards etc*

*Fin Control Systems Pty Ltd [2013] ATMO 75*



## Sufficiently distinctive – s 41

---



Firearms

*Lockheed Martin Corporation v Raytheon Company* [2012] ATMO 103

## Sufficiently distinctive – s 41

---



Sportscars in assembled form

*Morgan Motor Company Ltd v Aero Investments Pty Ltd* [2012] ATMO 91

## Sufficiently distinctive – s 41

---



Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles

*Philip Morris Products S.A. v British American Tobacco Australia Services Limited* [2013] ATMO 26

## Sufficiently distinctive – s 41

---



Optical apparatus and instruments; lenses for spectacles etc, retail services

*Specsavers Pty Ltd v Luxottica Group S.p.A.* [2013] ATMO 24

**Sufficiently distinctive – s 41**

---

# **CLICK & ROLL**

Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles

*Philip Morris Products S.A. v British American Tobacco (Brands) Limited.* [2013]

ATMO 22

**Sufficiently distinctive – s 41**

---

# **MOROCCAN MAGIC**

Colouring lotions for the hair etc

*Moroccanoil Israel Ltd v Karan Gogna* [2013] ATMO 62

## Sufficiently distinctive – s 41

---



Travel agency services

*Denise Monk v Travel Leaders Franchise Group LLC [2013] ATMO 57*

**Contrary to law: s 42(b)**

---

# ZIG ZAG

Beer

“I consider that use of the Trade Mark by the Applicant would mislead or deceive (or be false or misleading as to origin) because the beer the Applicant proposes to brew under the Trade Mark is not from the Zig Zag area where beers have been made and is widely recognized by the public as being the Zig Zag Brewery.”

*Malina Schindler and Adrian Schindler v Intellectual Property Development Corporation Pty Ltd.* [2013] ATMO 36

**Not substantially identical**

---

**MINDSTORE**

**v**



Computer controlled training apparatus for therapeutic use & retail sales

*Mindstore International Limited v Biofeedback International Pty Ltd and Jeremy Fitzpatrick* [2013] ATMO 45

## Deceptively similar TMs

---



**Business consulting; real estate**

**v**



**Real estate services**

*Match Investments Pty Ltd v Match Realty Limited [2012] ATMO 90*

## Deceptively similar TMs



v



Retail services relating to cooking & kitchenware

*Retailing and wholesaling*

*At-Sunrice Academy Pte Ltd [2013] ATMO 23*

## Deceptively similar TMs

---



v

**BIG HAND**

*Lollipops, lollies, candy etc*

*Lollipops*

*Linecrest Pty Ltd v Cobannah Holdings Pty Ltd as trustee for the Lollymania Trust  
[2013] ATMO 2*

## Deceptively similar TMs

---



v

**CASHIES**

Retail & financial services (sale of second hand goods and personal loans)

*Cash Converters Pty Ltd v Margo Chaille Webber* [2013] ATMO 34

## Deceptively similar TMs

---



Taps & plumbing

v

**GE**

Various classes incl plumbing supplies  
(and nuclear reactors)

*General Electric v Galvin Engineering Pty Ltd [2013] ATMO 32*

# Deceptively similar TMs - words

---

**VOLTEX**

**v**

**VOLEX**

Electrical switchgear, electrical plugs  
assemblies etc

Electrical, electronic  
and fibre optic

*Volex Group plc v TH & EE Tunley Pty [2012] ATMO 86*

## Deceptively similar TMs

---

**ODYSSEUS** v **ODYSSEY**

Alcoholic beverages (except beers) v Wines

*Wingara Wine Group Pty Ltd v T' Gallant Winemakers Pty Ltd* [2012]  
ATMO 93

## Deceptively similar TMs

---



v iPhone

VOIP services

Various classes incl class 9.

*Apple Inc. v Cleaar Marketing Australia Pty Ltd* [2012] ATMO 94

## Deceptively similar TMs

---



v



Clothing + non-alcoholic drinks  
energy drinks

Shirts, jeans etc + non-alcoholic incl  
drinks incl energy drinks

*Red Bull GmbH v Bull Riders Incorporation (Thailand) Limited [2012] ATMO 115*

## Deceptively similar TMs

---



**GS CUSTODYPLUS**

v



Financial services etc

Many classes incl advertising

*Goldman, Sachs & Co.* [2012] ATMO 108

## Not deceptively similar TMs - words

---

**TOOHEY'S  
EXTRA DRY**

v

**TOSSEY'S  
EXTRA DRY**

Several classes incl beer, waters etc

**Beer etc**

*Lion-Beer, Spirits & Wine Pty Ltd v Michael Harvey [2013] ATMO 6*

## Not deceptively similar TMs - words

---

**CLIP AND HIT** v **CLIP**

Printed matter, coupons etc

Class 35: advertising

*Valecom AG [2012] ATMO 101*



v

**YOGO**

*Advertising; business management*

*Food products incl yoghurt*

*LD&D Foods Pty Ltd v Fantasyonice Limited. [2012] ATMO 105*

## Not deceptively similar TMs - words

---

**TRADIEBAY**      **v**      **EBAY**

*Classified advertising etc*

*v 14 registrations, various classes related  
to online trading*

*eBay Inc. v Tradiebay Pty. Limited [2013] ATMO 58*

# Not deceptively similar TMs - words

---

**STARIBA**

v

**SPIRIVA**

and

**ABIRIBA**

*Pharmaceutical preparations*

*Boehringer Ingleheim Pharma GmbH & Co . Kg v Johnson & Johnson [2013]*

ATMO 72

## Not deceptively similar TMs

---



v

**RIDERS**

**LEE RIDERS**



Women's apparel; protective apparel worn by motorcyclists.

*The H.D. Lee Company, Inc. v Tracey Taylor* [2013] ATMO 49

## Not deceptively similar TMs

---



v **HIRE A HUBBY**

Handyman repair, maintenance and installation services

*Highdawn Pty Ltd v John Howard* [2013] ATMO 48

## Not deceptively similar TMs

---



v



Various foods & beverages

v

Crumpets, pikelets etc

*George Weston Foods Limited v Golden Circle Limited [2013] ATMO 41*

**Confusion likely: s 60**

---

**PATAGONIA  
SUNGLASSES**

v

**PATAGONIA**



*Sunglasses/eyewear*

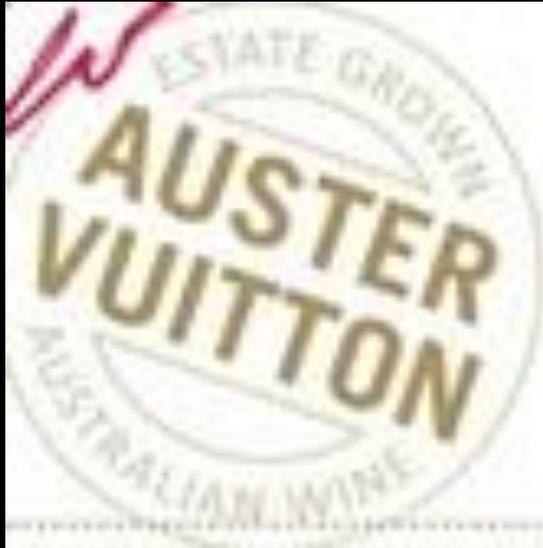
v

Various classes incl clothing, headwear etc

*Patagonia, Inc. v John Thatcher Pty Ltd [2012] ATMO 121*

## Confusion likely: s 60

---



v **LOUIS VUITTON**  
and other related marks

*Wine, wine based beverages* v luxury goods

*Louis Vuitton Malletier v WinWorld Australia Pty Ltd [2013] ATMO 46*

## Confusion likely: s 60

---



WORLD'S NEXT  
top model

v



AMERICA'S NEXT  
top model

*Advertising, telecommunications v Used in reality TV program & merchandise*

*Pottle Productions Inc v Rute Ithalat Ve Ihracat Anonim Sirketi [2012] ATMO 124*

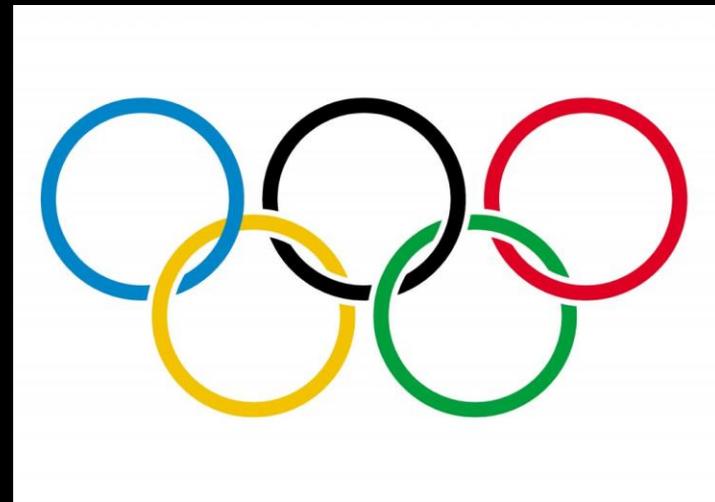
## Confusion likely: s 60

---



*Clothing, footwear and headwear*

v **OLYMPIC** and



*ComitÃ© International Olympique v Calçados Az aleia S/A [2013] ATMO 44*

**Confusion likely: s 60**

---

**SLATERS INTELLECTUAL  
PROPERTY LAWYERS**

**v**

**SLATER & GORDON**

Legal services

*Slater & Gordon Pty Ltd v Ann Rosa Mary Slater* [2013] ATMO 39

## Confusion likely: s 60

---



v

**mobileciti**



Retail services of mobile phones etc

*Mobileciti Pty Ltd v Glotech Services Limited* [2013] ATMO 67

## Confusion likely: s 60

---



v



and other similar marks

*Insurance, financial affairs etc v Class 36 (amongst others\_*

*Peet Limited v Feldbay Pty Ltd [2012] ATMO 87*

**Confusion likely: s 60**

---



**v MIND YOUR OWN  
BUSINESS**

*Business training & consultancy etc*

*Scott Ford v MYOB Technology Pty Ltd [2013] ATMO 37*

## Confusion likely: s 60

---



v

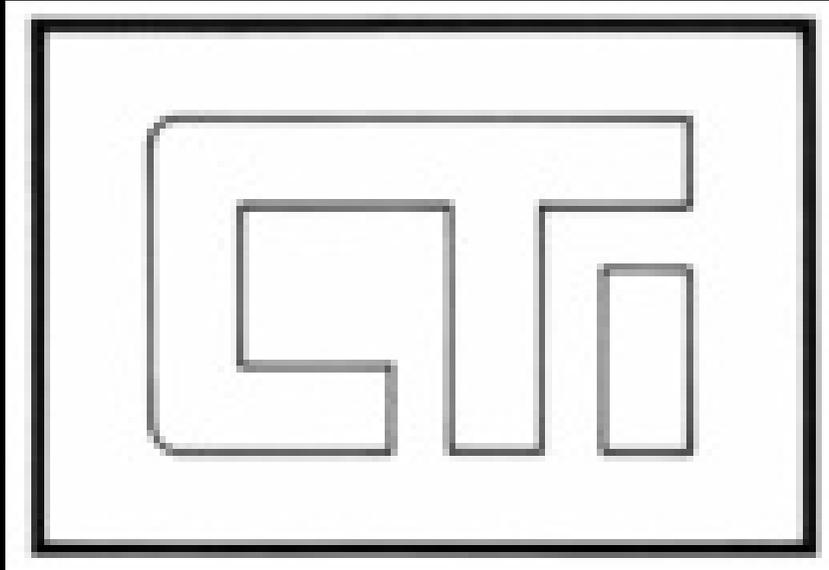


*Mineral water, spring water etc v Energy drinks*

*Red Bull GmbH v Altanea Gida Anonim Sirketi [2012] ATMO 120*

# Confusion likely: s 60

---



v CTI

*Computers, electronic devices etc*

*v Electrical & automation systems*

*Complete Technology Integrations Pty Ltd v Control Technology Inc*  
[2013] ATMO 16

## Confusion likely: s 60

---



v **NAPLAN**

*Application software etc*

*v Educational materials etc*

*Australian Curriculum, Assessment and Reporting Authority v Ogawie Pty Ltd*  
[2013] ATMO 14

**Confusion likely: s 60**

---

**GLOBALG.A.P.** v **GLOBAL GAS**

*Advertising, business management etc*

*v Certification services*

*FoodPLUS GmbH v George Sokol [2013] ATMO 54*

**Confusion likely: s 60**

---

**MOROCCAN MAGIC**

**v MOROCCANOIL**

*Colouring lotions for the hair etc*

*v Haircare products*

*Moroccanoil Israel Ltd v Karan Gogna [2013] ATMO 62*

**Confusion likely: s 60**

---

**TRADIEBAY v EBAY**

*Classified advertising etc*

*v 14 registrations, various classes related  
to online trading*

*eBay Inc. v Tradiebay Pty. Limited [2013] ATMO 58*

**Confusion likely: s 60**

---

# **VIRGIN GREEN v VIRGIN**

*Several classes relating to carbon offset v Various registrations in many classes*

*S 60 opposition established in relation to carbon trading services and some other services as a result of Opponent's reputation in relation to financial services – applicant permitted to amend to delete these services.*

*Virgin Enterprises Ltd v Agripower Australia Ltd [2013] ATMO 79*

**Confusion NOT likely: s 60**

---

**CISCO**                      v                      **SCISCO**

*Business & telco products*                      v                      *Apparel*

*Cisco Technology, Inc v Rob Fairway [2012] ATMO 112*

**Confusion NOT likely: s 60**

---

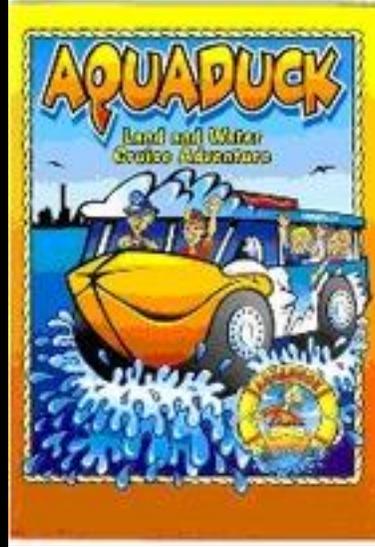
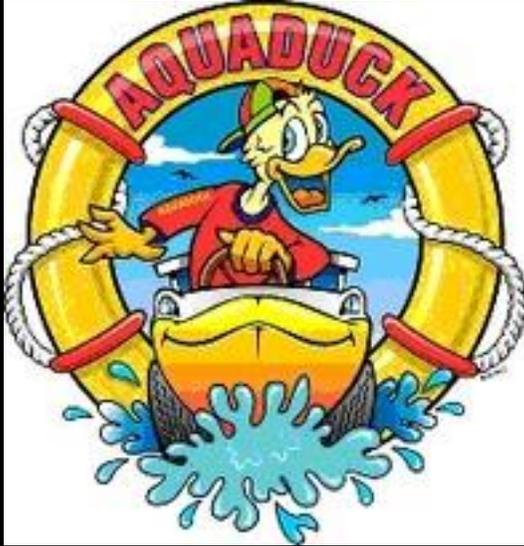
# **DOCUMATICS v DOCUMATRIX**

*Computer software etc* v Software related to discovery / litigation

Insufficient reputation.

*Epiq Systems, Inc v Documatics Australia Pty Ltd* [2013] ATMO 76

# Confusion NOT likely: s 60



v



*Arranging & conducting amphibious  
vehicle sightseeing tours*

v *Transport services incl  
amphibious vehicles*

*John McIntyre v Cooley Investments Pty Ltd [2012] ATMO 116*

**That's all folks . . .**

---