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# Trade Marks Update

**IPTA Annual Conference  
Perth 26 April 2017**

**Ed Heerey QC, Sydney & Melbourne**

**Ben Gardiner, Brisbane**

List  barristers

## ***Scoreboard – State of Origin***

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- Trade mark decisions in last 12 months
  - High Court appeals (including special leave applications): Nil
  - Full Federal Court appeal decisions: 3
    - NSW: 1
    - VIC: 1
    - QLD: 1
  - Federal Court trial decisions: 6
    - NSW: 3
    - VIC: 2
    - SA: 1 (plus 1 interlocutory injunction)

## ***Skyy Spirits LLC v Lodestar (2015) 112 IPR 328***

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- Latest bout in worldwide squabble between WILD TURKEY Bourbon and WILD GEESE Irish Whiskey
  - See, eg, *Austin, Nichols v Lodestar* [2012] 202 FCR 490
- Perram J:
  - *“The underlying antipathy seems driven by the possibility that not everyone might distinguish a wild goose from a wild turkey.”*
- “Wild geese” is a turn of phrase sometimes used to refer to the Irish diaspora

## ***Skyy Spirits LLC v Lodestar (2015) 112 IPR 328***

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- 2000: WG Irish Whiskey registered WILD GEESE
- Around 2000: small vineyard operated by Adelaide barrister Patrick O'Sullivan QC began selling WILD GEESE wines
- 2005: O'Sullivan applied to register WILD GEESE
  - obstacle: 2000 registration by WG Irish Whiskey
- O'Sullivan applied to remove WG Irish Whiskey's TM
  - S 92(b): 3 years non-use
- Discovered that WT Bourbon had also applied under s 92(b)
- 2007: O'Sullivan and WT Bourbon agreed:
  - O'Sullivan's WILD GEESE wine TMs assigned to WT Bourbon
  - WT Bourbon licensed TMs back to O'Sullivan for \$1 in perpetuity
  - WT Bourbon took over O'Sullivan's non-use removal application



## ***Skyy Spirits LLC v Lodestar (2015) 112 IPR 328***

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- 2012: WT Bourbon finally succeeded in removing WG Irish Whiskey's WILD GEESE TM for non-use: *Austin, Nichols v Lodestar* 202 FCR 490
- WT Bourbon then secured registration of WILD GEESE and WILD GEESE WINES
- Present litigation: WG Irish Whiskey applied to remove WT Bourbon's registrations of WILD GEESE and WILD GEESE WINES for 3 years non-use
- O'Sullivan was the only party using WILD GEESE in the relevant period
- Key question: was O'Sullivan's use "authorised" by WT Bourbon?
  - s 7(3): authorised use of TM is taken to be use of TM by owner
  - s 8: "authorised" use of TM is use under control of owner

## ***Skyy Spirits LLC v Lodestar (2015) 112 IPR 328***

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Perram J:

- O'Sullivan's sales of WILD GEESE wines totalling \$3,465, \$2,479 and \$5,538 in relevant 3 years were modest but nevertheless use of the TM
- On the facts, WT Bourbon exercised no actual control over O'Sullivan's use of the WILD GEESE TMs, or quality control over his wine:  
*"The licence agreement was not intended by the parties to it to deliver anything but the appearance of control to the Wild Turkey interests"*
- However, a mere theoretical possibility of contractual "control" is sufficient to constitute authorised use for purposes of s 8
  - Perram J disagrees strongly with this principle, should be "actual control" [detailed analysis set out for review on appeal?]
  - But, bound by Full Court: *Asia TV v Yau (No 2) (2000) 49 IPR 264*
  - WILD GEESE TM thus used; Court has no power to remove.

## ***Lodestar Anstalt v Campari America LLC (2016) 244 FCR 557***

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Appeal to Allsop CJ, Greenwood, Besanko, Nicholas and Katzmann JJ:

- 5-member Court convened in case it became necessary to consider whether Full Court decision in *Asia TV v Yau* was wrong
- Lead judgment by Besanko J – all other judges agreed
  - Greenwood, Nicholas and Katzmann JJ added further observations, generally focussed on the facts of the case

## ***Lodestar Anstalt v Campari America LLC (2016) 244 FCR 557***

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Besanko J, allowing the appeal:

- O’Sullivan’s use of WILD GEESE was not controlled by, and thus not “authorised” by, WT Bourbon
- There is no general rule that a mere ability or power to exercise control is sufficient to demonstrate control: *Holly Hobbie* [1984] RPC 329
- Use of TM under a bare licence is not sufficient to establish the necessary connection between the TM owner and the goods; some form of control had to be established and mere ability or power to control was probably insufficient: *McGregor Trade Mark* [1979] RPC 36
- Full Court in *Yau* did not actually hold that a mere theoretical possibility of contractual control was sufficient to constitute an authorised use
  - That case in fact involved a high degree of control by the TM owner

## ***Lodestar Anstalt v Campari America LLC (2016) 244 FCR 557***

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Besanko J, allowing the appeal:

- Meaning in s 8 of “under the control of” is informed by the principle that a TM must indicate a connection in the course of trade with the registered owner
- The connection may be slight, but that does not mean that the control may be slight
- Control in s 8 means actual control in relation to the use of the TM and actual control in relation to the TM from time to time
- Control involves questions of fact and degree
- There must be control as a matter of substance
- A licence agreement may contain such detailed quality standards with which the licensee may faithfully comply, without the need for the owner to give instructions from time to time

## ***Lodestar Anstalt v Campari America LLC (2016) 244 FCR 557***

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Besanko J, allowing the appeal:

- The Licence Agreement, in practical terms, had no effect on the way in which O'Sullivan conducted his business
- The quality control provision in the Agreement was that the wine be of a sufficient standard to obtain the AWBC's approval for export – a very low standard that had no effect on Mr O'Sullivan's wine making
- At no time in the 3-year period did the the TM owner contact O'Sullivan about his wine or exercise its rights under the Agreement to request samples or testing
- O'Sullivan's use was not an authorised use within s 8
- It follows that WT Bourbon made no use of its registered TM within the 3 year period

## ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2015) 115 IPR 246**

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- STG owns TMs CAFÉ CRÈME, HENRI WINTERMANS and LA PAZ for tobacco products
- STG makes cigars bearing these TMs in Holland and Belgium
- STG's cigars pre-destined for Australia are pre-packaged by STG to conform with Australian tobacco plain packaging laws
- Trojan imports into Australia cigars made by STG and bearing the TMs but in packaging for other markets, not compliant with Australian plain packaging laws
- Trojan removes the cigars from STG's original packaging and transfers them individually to retail plain packaging that it sources independently, bearing STG's TMs
- Trojan does not have STG's consent to place the TMs on the packaging

# ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2015) 115 IPR 246**

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Allsop CJ, rejecting Trojan's argument that it did not use or infringe the TMs:

- *“absent s 123 being engaged, the mere sale of goods already marked by the registered owner (a fortiori if a mark is applied by someone other than the registered owner) would be an infringing use of the mark by the importer”*
  - (citing 4 Full Court decisions: *Transport Tyres, E & J Gallo, Paul's v Sparte Leisure, Paul's v Lonsdale*)
- the process of re-packaging involved applying the TMs in relation to the cigars (on the boxes containing them) for the purposes of s 9(1)(b)(i)
- that process and sale to retailers were use of the TMs *“upon, or in physical or other relation to, the goods”* (s 7(4)), which is infringement unless s 123 applies

# ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2015) 115 IPR 246**

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Allsop CJ, on Trojan's defence under s 123:

- STG's argument: relevant application of the TMs was by Trojan, during its repackaging process, which had no consent of STG
- Trojan's argument: relevant application of the TMs was STG's original application during its manufacturing process, and Trojan's repackaging was merely to conform with plain packaging legislation
- Allsop CJ preferred Trojan's argument

# ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2016) 243 FCR 152**

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Besanko, Yates and Nicholas JJ, on use as a TM by a reseller:

- Trojan used the TMs as TMs on the repackaged goods it sold
- The position is as stated by the Full Court in *Transport Tyres, E & J Gallo, Paul's v Sporte Leisure, Paul's v Lonsdale*
  - Unless s 123 is engaged, the mere sale of goods already marked by the registered owner would be an infringing use of the mark by the reseller

# ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2016) 243 FCR 152**

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Besanko, Yates and Nicholas JJ, dismissing appeal re s 123 TMA:

- s 123 gives an express statutory footing for the *Champagne Heidsieck* principle - that principle has no broader operation beyond s 123
- Allsop CJ correctly accepted Trojan's construction of s 123 which directs attention to any prior application of the TM on or in relation to the goods that occurred by or with the consent of the registered owner
- If the registered owner has applied its TM to the goods, it will be open to another person to purchase the goods, remove the TM and then re-apply it for the purposes of resale

# ***Scandinavian Tobacco Group Eersel BV v Trojan Trading PL*** **(2016) 243 FCR 152**

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Besanko, Yates and Nicholas JJ, dismissing appeal re s 123 TMA:

- When interpreting s 123, it is important to keep in mind that a TM may be used in many different ways which do not involve physically applying the TM to goods, eg in advertising, invoices, conversations
- If s 123 is to operate to reflect the *Champagne Heidsieck* principle it must be interpreted in a manner allowing application to the wide variety of circumstances in which a TM may be used in relation to the goods
- If a retailer acquires packaged goods to which a TM has been applied by its registered owner at manufacture, s 123 provides a defence to infringement if it creates signage or advertising reproducing the TM
- S 121 allows TM owner to display on goods a notice prohibiting certain acts, including applying the TM after the packaging has been altered, so TM owner in STG's position has alternative protection

## ***Accor Australia & NZ Hospitality v Liv (2015) 112 IPR 494***

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- Applicants developed and manage letting of “Harbour Lights” residential/retail complex in Cairns
- Respondents let apartments in the same complex under business name “Harbour Lights Property Management and Sales”
- Applicants sued for infringement of registered marks HARBOUR LIGHTS and CAIRNS HARBOUR LIGHTS
- Respondents cross-claimed seeking cancellation of TMs:
  - s 58: on the basis that the TM owner was not the first user of the TM in respect of the relevant services
  - s 41: on the basis that TMs had no inherent or acquired adaption to distinguish

# ***Accor Australia & NZ Hospitality v Liv (2015) 112 IPR 494***

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Rangiah J, on the cross-claim to cancel the TMs:

- HARBOUR LIGHTS TM:
  - s 58: invalid in relation to some services because 3R made first use
  - s 41 cross-claim failed: HARBOUR LIGHTS is inherently adapted to distinguish – not directly descriptive, not a geographical description.
- CAIRNS HARBOUR LIGHTS TM:
  - s 41 cross-claim upheld: CAIRNS HARBOUR LIGHTS is only to some extent inherently adapted to distinguish
  - CAIRNS HARBOUR is a direct reference to the location of the accommodation services
  - addition of LIGHTS means that the TM is to some extent inherently adapted to distinguish, but use was insufficient to support registration under s 41(5)

## ***Accor Australia & NZ Hospitality v Liv* [2017] FCAFC 56**

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Greenwood, Besanko and Katzmann JJ, allowing appeal on s 58:

- The following TM is substantially identical to the word TM HARBOUR LIGHTS:



- The words HARBOUR LIGHTS form the “dominant cognitive cue” and the key feature which the viewer would take away and recognise as a way of connecting with the person providing the services
- The five gold stars and the further *de minimis* words “A NEW STAR SHINES” do not substantially affect the identity of the TM
- Thus, the appellants made first use of HARBOUR LIGHTS for all relevant services by way of an advertisement featuring the TM in this format

## ***Accor Australia & NZ Hospitality v Liv [2017] FCAFC 56***

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Greenwood, Besanko and Katzmann JJ, allowing appeal on s 58:

- The following format also constitutes use of a TM substantially identical to the word TM HARBOUR LIGHTS:



- The presence of the TM “THE SEBEL” simply tells the viewer that there is a relationship between the services badged “HARBOUR LIGHTS” in the advertisement, the developer and, in some way or other, an accommodation operator described by “THE SEBEL”

## ***Accor Australia & NZ Hospitality v Liv* [2017] FCAFC 56**

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Greenwood, Besanko and Katzmann JJ, allowing appeal on s 58:

- HARBOUR LIGHTS is substantially identical to CAIRNS HARBOUR LIGHTS
- Thus, prior use of HARBOUR LIGHTS establishes ownership also of CAIRNS HARBOUR LIGHTS

Greenwood, Besanko and Katzmann JJ, allowing appeal on s 41:

- HARBOUR LIGHTS is inherently adapted to distinguish
  - Those words are the name of a particular building complex and may be used by apartment owners to describe the location, but that does not mean that the words thus become part of the “common heritage”
- CAIRNS HARBOUR LIGHTS is inherently adapted to distinguish due to the presence of the dominant cognitive cue HARBOUR LIGHTS

## ***Accor Australia & NZ Hospitality v Liv* [2017] FCAFC 56**

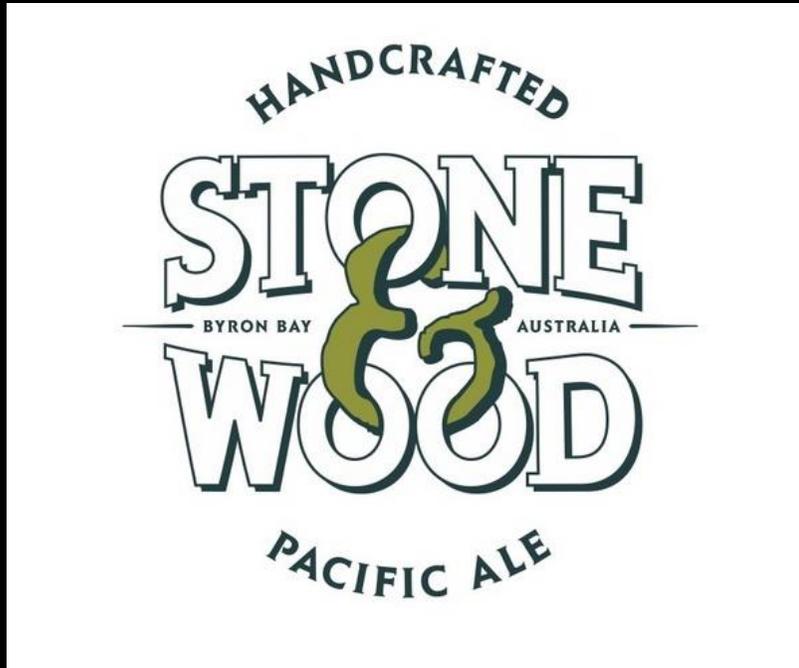
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Greenwood, Besanko and Katzmann JJ, upholding Rangiah J's findings of infringement by the use of:

- domain names: cairnsharbourlights.com.au, harbourlihgtscairns.com.au
- phrases on website, eg: "Harbour Lights Luxury Apartments"
- Google ads, eg: sponsored link "Cairns Harbour Lights" with link to domain [www.HarbourLightsCairns.com.au](http://www.HarbourLightsCairns.com.au)
- HARBOUR LIGHTS on statements of account, booking confirmations, park bench signs and advertising flyer for the letting services
- no defence of good faith descriptive use (s 122(1)(b)) – Rs chose to use a badge of origin of another person's services as a badge of origin of their own services, especially in using domain names to take inquirers to a website offering sales and letting services
- no defence of prior continuous use (s 124)

# *Stone & Wood Group PL v Intellectual Property Development Corporation PL (2016) 120 IPR 478*

- S&W's registered TM:



- IPDC's THUNDER ROAD PACIFIC ALE:
- S&W sued IPDC for TM infringement, misleading conduct and passing off



# ***Stone & Wood Group PL v Intellectual Property Development Corporation PL (2016) 120 IPR 478***

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Moshinsky J, dismissing TM infringement claim:

- PACIFIC and PACIFIC ALE are not deceptively similar to the reg TM
  - Dominant and essential feature of the reg TM is STONE & WOOD
  - Reg TM also features the & symbol and HANDCRAFTED on top
  - PACIFIC ALE is not an essential feature of the reg TM – smaller print and subsidiary size and positioning to STONE & WOOD



# ***Stone & Wood Group PL v Intellectual Property Development Corporation PL (2016) 120 IPR 478***

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Moshinsky J, upholding cross-claim for groundless threats:

- Insufficient for S&W to establish a bona fide belief that acts of the threatened person constituted infringement; it must establish infringement
- S&W did not begin a TM infringement action against the threatened person (Elixir) with due diligence within the meaning of s 129(5)
  - Threat made 26/2/15, cross-claim for groundless threats filed 18/6/15, infringement action brought thereafter
  - But for the cross-claim for groundless threats, it is doubtful whether the TM infringement claim would have been brought at all

## ***Qantas Airways Ltd v Edwards (2016) 119 IPR 271***

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- Edwards applied for logo TM for clothing, footwear, headwear, shirts and t-shirts:



- TMO rejected opposition by Qantas
- Qantas appealed to Federal Court

Yates J, rejecting opposition under s 44:

- Qantas's TM registered in respect of advertising, marketing and merchandising services:
- Those services not "closely related" to clothing goods
- There is nothing that makes (eg) merchandising services related to (eg) clothing beyond the fact that clothing is capable of being, along with a vast range of other goods, the subject of merchandising



## ***Qantas Airways Ltd v Edwards (2016) 119 IPR 271***

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Yates J, rejecting opposition under s 44:

- S 44 ground can be disposed simply on the finding that the goods and services are not closely related
- However, even without that finding, s 44 ground fails for lack of deceptive similarity
- The stylised kangaroo is a prominent element of each mark
- It would, however, be an error to focus on each kangaroo element to the exclusion of other elements of the respective marks
- Must take into account the important triangular element of Qantas' TM, which puts the kangaroo in a memorable visual setting
- The t-shirt element of Edwards' TM is a very important element and a significant point of distinction



## *Qantas Airways Ltd v Edwards (2016) 119 IPR 271*

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Yates J, rejecting opposition under s 60:

- Qantas argued that Edwards TM would be confused with either of on these TMs:



Edwards' TM:



- Qantas relied on widespread use, including sponsorship activities and the use of its TMs on team uniforms, t-shirts and other clothing
- Not persuaded of likelihood of confusion, even re Qantas' TMs without triangle element, due to important t-shirt element of Edwards' TM

## ***Qantas Airways Ltd v Edwards* (2016) 119 IPR 271**

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Yates J, rejecting opposition under s 60:

- Qantas relied on widespread use, including sponsorship activities and the use of its TMs on team uniforms, t-shirts and other clothing
- No significant role played by consumer awareness of brand evolution or extension
  - evidence of use of Qantas' TMs on clothing was plainly for endorsement purposes
  - not persuaded that Qantas' TMs have reputation for clothing etc goods in their own right

## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

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- 1999: DSI applied for OZEMITE for spreads, yeast extracts etc
  - 2003: registration achieved
- 2001: Ramsey applied for AUSSIE MITE, DSI opposed
  - 2006: opposition dismissed, registered under s 44(3)(b): 70 IPR 428
- 2011: Ramsey applied to have OZEMITE removed for 3 years non-use
  - no sales of any OZEMITE product by that time
  - DSI claimed an “obstacle” prevented use: difficulty in sourcing spent brewer’s yeast because Kraft had contracted all available supply from Australian brewers to make VEGEMITE
- 2012: DSI commenced selling OZEMITE product

## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

- 2014: TMO decided to remove OZEMITE for non-use: 105 IPR 452
- DSI appealed non-use removal decision to Federal Court
  - Ramsey also applied to cancel OZEMITE and DSI applied to cancel AUSSIE MITE
  - but both parties agreed to ask the Court to rule first on the appeal from the non-use removal decision



# *Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270*

Katzmann J, finding use as a TM in the statutory period:

- Despite no product being available for sale during the non-use period, DSI used OZEMITE as a TM in two instances of “pre-launch publicity”:
- First instance: Mr Smith’s appearance in August 2010 in a skit on the ABC’s “The Chaser” political comedy TV program
  - Wearing OZEMITE t-shirt
  - Surrounded by Dick Smith Foods products



## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

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Katzmann J, finding use as a TM in the statutory period:

- Second instance of TM use: interview of Mr Smith on Adelaide radio 5AA in March 2011 about Woolworths' decision to continue to stock Dick Smith Foods product, in which he said:  
*“ . . . We're also looking . . . You remember we were going to bring out Ozemite? . . . The Ozemite, to compete with Vegemite, because Vegemite should be called Yankeemite because it's owned in America, you know they try to make out its Australian . . . no it's American, and I've been trying to work on Ozemite well I am now committed, we are going to bring out Ozemite because, see, Vegemite has now changed: they've got Cheesy-Bite, . . . They're making all these changes, well I want to go back to the original taste.”*

## ***Dick Smith Investments Pty Ltd v Ramsey* (2016) 120 IPR 270**

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Katzmann J, finding use as a TM in the statutory period:

- Rejected Ramsey's argument that there can be no TM use unless there is an "occasion of trade" in respect of "vendible articles" involving at least a single act of sale
- High Court's reference in *Gallo* to "vendible goods" is not limited to goods actually sold, but extends to goods capable of being sold, or "marketable"
- High Court in *Estex*: use is not limited by any concept of the physical use of a tangible object
- The "course of trade" is not confined to sales but includes merchandising, advertising and promotion etc
- *Gallo* does not exclude from "use as a trade mark" all steps antecedent to a sale or the offering for sale of the goods

## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

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Katzmann J, finding use as a TM in the statutory period:

- Evidence went well beyond “preliminary investigations” and showed that DSI had “an objectively ascertainable commitment” to produce a “vendible” OZEMITE product
- OZEMITE product remained under development during the non-use period and DSI was intent on bringing it to market, notwithstanding various setbacks and frustration
- Considerable funds had been invested in its development, well over \$100,000
- What matters in the 2010 and 2011 broadcasts is that the TM was being used to distinguish the prospective product from the products of others

## ***Dick Smith Investments Pty Ltd v Ramsey* (2016) 120 IPR 270**

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- Katzmann J, *obiter*, if wrong about finding use of TM:
  - There was no “obstacle” to the use of the TM within s 101(3)(c) in
    - difficulty in sourcing spent brewer’s yeast; or
    - difficulty in developing formula to taste like Vegemite
  - [Note criticism of Drummond J’s reasoning in *Woolly Bull*]

## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

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- Katzmann J, *obiter*, if wrong about finding use of TM, would have exercised discretion not to remove TM, because:
  - DSI was not idle in the 8 year period since registration
  - The above difficulties provide a credible explanation for the delay
  - DSI had a genuine intention and commitment to use the TM
  - TM has residual reputation from long albeit sporadic promotion
  - Sales since 2012 have been substantial
  - DSI's interests favour the retention of the TM on the register
  - Mr Ramsey adopted AUSSIEMITE when he knew of DSI's OZEMITE application, to capitalise on consumer confusion
  - Removal would lead to confusion, and infringement by DSI
  - Consumers would mistake AUSSIEMITE for OZEMITE

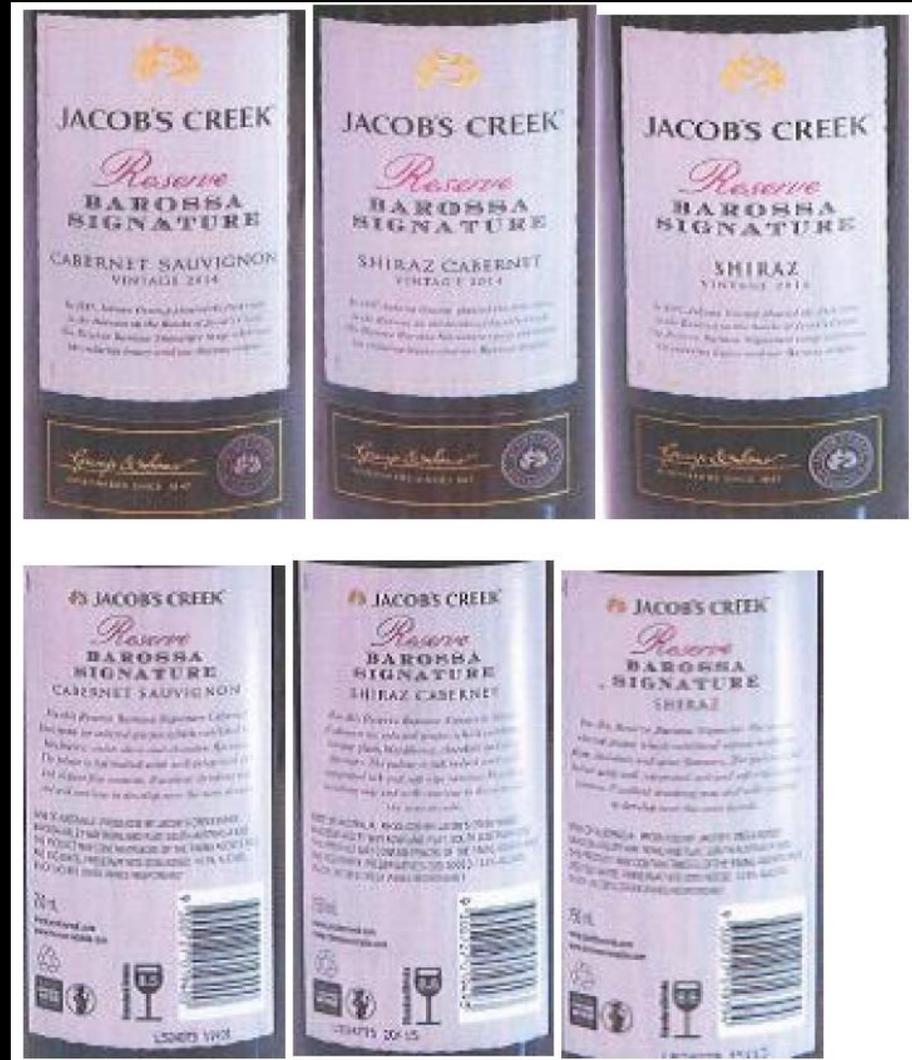
## ***Dick Smith Investments Pty Ltd v Ramsey (2016) 120 IPR 270***

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- Katzmann J, *obiter*.
- *There is likely to be less confusion if the ozemite mark remains on the Register, than if it is removed. The extent of publicity generated by Mr Smith over many years, including the extraordinary publicity given to the Ozemite name at the time of its conception, suggests that for many years to come a product which has the identical sound will be associated, at least in the minds of a not insignificant number of people, with Mr Smith. The best way of dispelling the notion that aussie mite is a Dick Smith product is to enable the two products to compete for attention on the supermarket shelves where consumers can see clearly which is the Dick Smith product and which the Ramsey one.*

# Samuel Smith and Son PL v Pernod Ricard Winemakers PL [2016] FCA 1515

- SSS owns registered TM THE SIGNATURE for wines
- PRW produced and sold wines with these labels:



# ***Samuel Smith and Son PL v Pernod Ricard Winemakers PL*** **[2016] FCA 1515**

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Charlesworth J, finding PRW used BAROSSA SIGNATURE as a TM

- SIGNATURE is a familiar word in wine parlance, synonym with “quintessential”, “defining”, “typical”; like “signature dish”
  - But could still be perceived by consumer as a wine product name
  - Not a descriptor for wine in the same sense as “red”, “white”, “shiraz”
  - Not commonly used in TMS for wine
- Fact that BAROSSA and SIGNATURE are descriptive words is relevant to but not determinative of whether they are used as a TM
- BAROSSA SIGNATURE would be seen as a sign separate from JACOB’S CREEK and RESERVE
- BAROSSA SIGNATURE conveys an impressionistic not literal meaning
- *“The unusual combination of words creates the impression of a softly spoken slogan.”*

# ***Samuel Smith and Son PL v Pernod Ricard Winemakers PL*** **[2016] FCA 1515**

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Charlesworth J finding BAROSSA SIGNATURE not deceptively similar to THE SIGNATURE:

- Definite article “THE” forms a necessary part of the registration
- Consumer would not loiter in a wineshop for long pondering the literal meaning of THE SIGNATURE, but nor would s/he give such fleeting or rushed consideration to the TM that the word THE would not register in the consumer’s conscious or unconscious mind
- “THE” causes “SIGNATURE” to convey its ordinary meaning as a noun not adjective, and assists in creating a subtle impression that the signature referred to is a signature of some particular importance
- That is the essential and memorable element of the registered TM, based on an imperfect recollection of an ordinary consumer

# ***Samuel Smith and Son PL v Pernod Ricard Winemakers PL*** **[2016] FCA 1515**

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Charlesworth J finding BAROSSA SIGNATURE not deceptively similar to THE SIGNATURE:

- General impression of BAROSSA SIGNATURE is that the wine is typical of a style of wine which is sourced from and characteristic of the Barossa region
- The unconventional combination of words creates a further and important difference from THE SIGNATURE
- “Thus, although I am satisfied that a distinctive part of THE SIGNATURE is used in BAROSSA SIGNATURE, it is not used in such a way and in such a context that its use would be likely to cause confusion”
- PRW did not subjectively intend to cause confusion or wrongfully exploit the goodwill residing in THE SIGNATURE

# ***Samuel Smith and Son PL v Pernod Ricard Winemakers PL*** **[2016] FCA 1515**

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Charlesworth J, obiter:

- If the TMs had been deceptively similar, PRW would not be entitled to defence of good faith descriptive use: s 122(1)(b)
  - PRW acted honestly, but did not use BAROSSA SIGNATURE purely for the purposes of description

## **Educational Broadcasters Adelaide Incorporated v Australian Broadcasting Commission [2016] FCA 1502**

- Applicant owned the mark 5UV RADIO ADELAIDE registered in respect of radio broadcasting services & broadcast under the name RADIO ADELAIDE since 2003



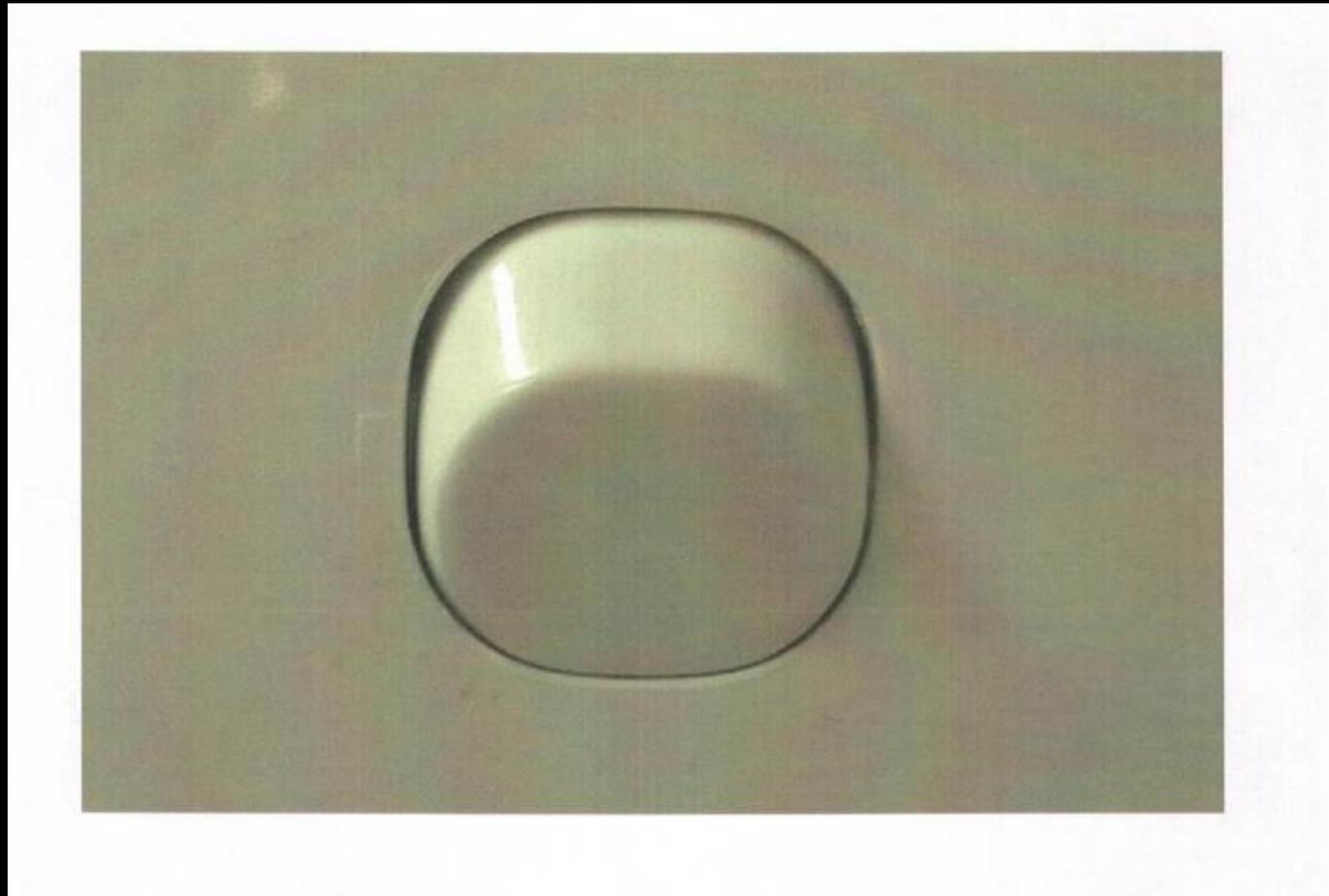
- ABC had broadcast under the name 891 ABC ADELAIDE but intended to change to ABC RADIO ADELAIDE
- EBA alleged TM infringement & breach of ACL - sought interlocutory injunction restraining the ABC from use of the words RADIO ADELAIDE in relation to radio broadcast services

## **Educational Broadcasters Adelaide Incorporated v Australian Broadcasting Commission [2016] FCA 1502**

- Charlesworth J, granting the injunction:
  - Applied test for interlocutory injunction as set out in *ABC v O'Neill*
  - Rejected ABC's contention that the Applicant must demonstrate irreparable harm that can not be compensated by damages
  - Accepted that there is at least a "*serious question to be tried*" as to whether:
    - 5UV RADIO ADELAIDE is deceptively similar to ABC RADIO ADELAIDE (TM infringement)
    - The use of the new ABC brand indicia was likely to breach ACL
  - Accepted that there is value in the ABC rolling out its rebranding strategy in a nationally consistent manner but...
  - Held that balance of convenience favoured grant of the injunction

## ***Clipsal Australia PL v Clipso Electrical PL [2017] FCA 60***

- Clipsal owns TM registrations for CLIPSAL and the following shape mark, for electric switches etc:



## ***Clipsal Australia PL v Clipso Electrical PL [2017] FCA 60***

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- Clipso registered and used the TM CLIPSO for switches, and sold switches with a similar shape as Clipsal's shape registration

Perram J:

- Clipso's director gave false evidence about how he chose CLIPSO name
- He was perfectly aware of Clipsal's products and brand at that time
- He selected CLIPSO because it resembled CLIPSAL, because he wished members of the public, electrical wholesalers and electrical contractors to think that there was some association between CLIPSO products and Clipsal's products

# *Clipsal Australia PL v Clipso Electrical PL [2017] FCA 60*

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Perram J:

- CLIPSO is not substantially identical with CLIPSAL
- But, CLIPSO is deceptively similar to CLIPSAL
  - CLIPSAL is famous within the electrical trade, but on the facts of this case, that fame does not prevent deceptive similarity: cf *Mars v Sweet Rewards*
  - An electrician gave evidence that he wondered whether CLIPSO was not perhaps a new discount line produced by CLIPSAL
  - Not necessary to resort to the fact that Clipso's director set out to trade off the reputation of CLIPSAL, but it strongly corroborates the conclusion of deceptive similarity
- CLIPSO TM registration should be cancelled under s 44 and 60

# *Clipsal Australia PL v Clipso Electrical PL [2017] FCA 60*

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Perram J:

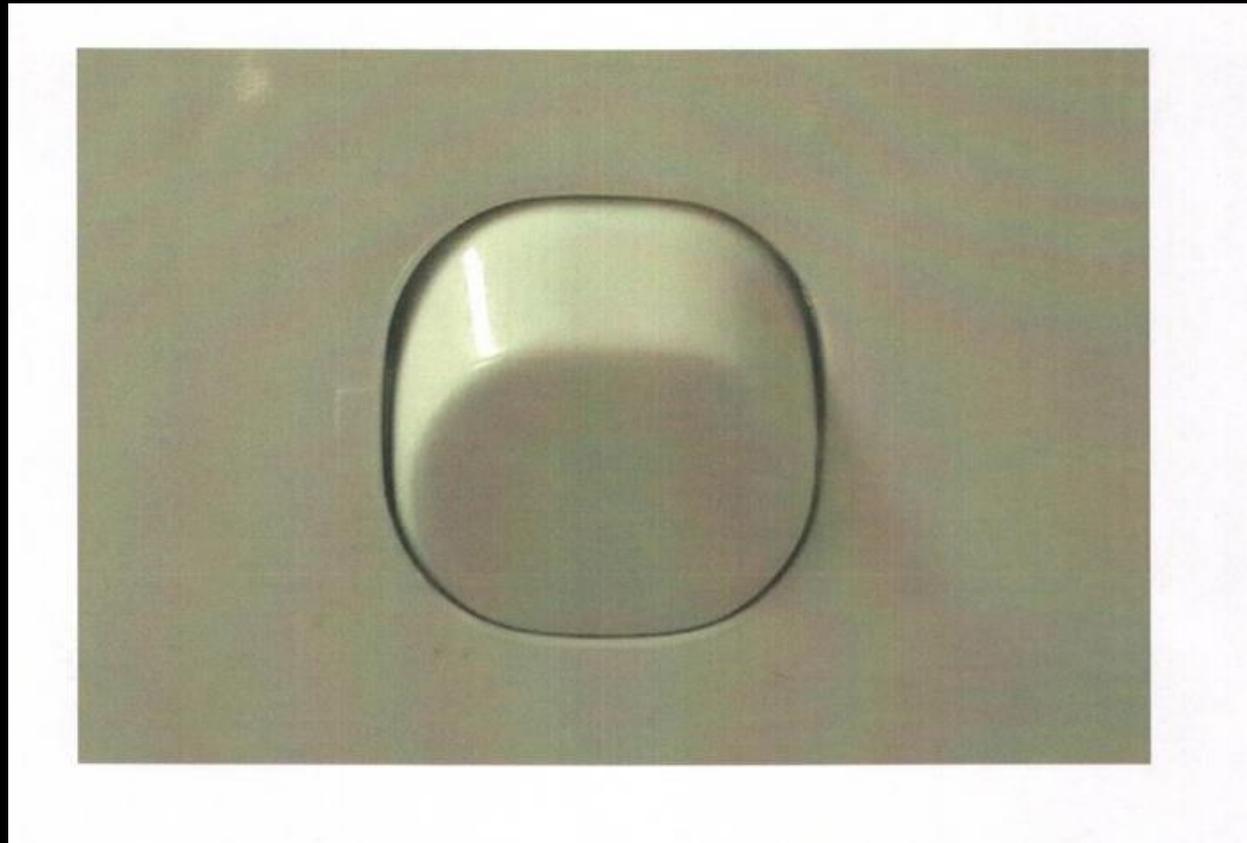
- CLIPSO TM also cancelled under s 62A - registered in bad faith:
  - subjective element: Clipso's director's conduct was dishonest
  - objective element: "It is not commercially appropriate behaviour to sell competing products into the market under a very similar name, with the actual intention of misleading consumers into thinking that they are buying a different product."
- CLIPSO TM also cancelled under s 88(2)(c) – at time of application for rectification its use is likely to deceive or cause confusion.
- Upon cancellation, Clipso will no longer have defence to infringement under s 122(1)(e)
- Clipso not entitled to defence for good faith use of own name (s 122(1)(a)), because name not chosen in good faith

## *Clipsal Australia PL v Clipso Electrical PL [2017] FCA 60*

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Perram J:

- Clipso did not use the shape of its switches as a TM
- Thus no infringement of Clipsal's shape TM:



# *Insight Radiology v Insight Clinical Imaging [2016] FCA 1406*

- Since 2008 ICI has been operating INSIGHT CLINICAL IMAGING clinics in WA
- Since 10 Oct 2012 ICI has been registered owner of TMs:
  - Word mark: InSight Clinical Imaging

- Composite mark:



- 7 Dec 2011: IR's director Mr Pham applied for TM:
- ICI opposed registration
- TMO refused registration



# *Insight Radiology v Insight Clinical Imaging* [2016] FCA 1406

- Since 2008 ICI has been operating INSIGHT CLINICAL IMAGING clinics in WA
- Since 10 Oct 2012 ICI has been registered owner of TMs:

- Word mark: InSight Clinical Imaging
- Composite mark:



- IR operated clinics in NSW from 2004

under other names, rebranded as INSIGHT RADIOLOGY in 2011

- 7 Dec 2011: IR's director Mr Pham applied for TM:
- ICI successfully opposed registration
- IR appealed TMO decision to Federal Court
- ICI sued IR: TM infringement, passing off and ACL
- IR cross-claimed to revoke ICI's TMs



# *Insight Radiology v Insight Clinical Imaging [2016] FCA 1406*

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Davies J rejecting ICI's opposition under s 58:

- not substantially identical:



## ***Insight Radiology v Insight Clinical Imaging [2016] FCA 1406***

---

Davies J rejecting second limb of ICI's opposition under s 58, and s 59:

- TM application filed by Mr Pham, assigned to IR after acceptance and during opposition
- The TM was designed for and used by the company for its business purposes
- The application was made in the wrong name, should have been made in the company's name
- Mr Pham never intended to use the TM himself, or license its use
- Rather, his intention always was for the company to use it
- However, Mr Pham validly assigned TM application to the company
- The company was thus the appropriate "applicant" during the application, for purposes of ss 27, 58 and 59: *Mobileworld; Global v YD*

# ***Insight Radiology v Insight Clinical Imaging* [2016] FCA 1406**

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Davies J, upholding ss 60 and 42(b) opposition:

- ICI has a reputation in Australia, not just WA
  - marketing extended beyond WA through ICI's website and promotions at national conferences
  - sufficient reputation despite having only 10 referrals from other states and 237 interstate patients
- Use of IR's composite mark would be likely to cause deception
- Thus s 60 ground made out
- Use would also be misleading or deceptive in breach of ss 18 and 29 ACL, thus contrary to law under s 42(b) TMA

## ***Insight Radiology v Insight Clinical Imaging [2016] FCA 1406***

---

Davies J, rejecting IR's cross-claim to revoke ICI's TMs:

- s 41: INSIGHT is inherently capable of distinguishing ICI's radiology services; ordinary signification is not directly descriptive
- grounds for cancellation under ss 42(b), 44, 60 and 88 also rejected

# ***Insight Radiology v Insight Clinical Imaging* [2016] FCA 1406**

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Davies J, finding TM infringement against IR:

- Deceptive similarity conceded
- No defence for good faith use of IR's own name (s 122(1)(a)(i))
  - Choice of IR's name was not in good faith
- No defence of exercise of a right to use a TM given to IR under the TMA (s 122(1)(e))
  - IR had never achieved registration
- No defence that IR would achieve registration (s 122(1)(fa))
  - determined as a hypothetical application filed now
  - s 44 would prevent registration; no honest concurrent use: s 44(3)
- Passing off and ss 18 and 29 ACL claims also upheld

Appeal hearing 2-3 May 2017 before Greenwood, Jagot and Beach JJ

## ***Titan Enterprises (Qld) Pty Ltd v Cross (2016) 119 IPR 468***

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- Titan sued Cross for TM and copyright infringement and breach of ss 18 & 29 ACL
- Titan issued a subpoena to Cross's TM attorneys for production of various documents including records of all instructions received from Cross relating to a domain name dispute
- The TM attorneys produced documents in redacted form
- Titan sought inspection of unredacted documents
- The TM attorneys asserted privilege against production: s 229 TMA
- Cross was invited to provide evidence in support of privilege claim, but did not

## ***Titan Enterprises (Qld) Pty Ltd v Cross (2016) 119 IPR 468***

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Logan J, rejecting the claim for privilege:

- The person asserting privilege must prove it applies in the particular circumstances, and that proof is not found in a “mere sworn assertion”.
- The essential issue on a claim for privilege is the purpose for which the document or communication in question was made.
- The best, though not the only sufficient, source of evidence is the direct evidence of the person whose purpose is in question.
- Court must be cautious about inspecting the documents in question, to ensure procedural fairness to other affected parties.

## ***Titan Enterprises (Qld) Pty Ltd v Cross (2016) 119 IPR 468***

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Logan J, rejecting the claim for privilege:

- Client legal privilege protects communications made in connection with:
  - giving or obtaining legal advice;
  - providing legal services, including representation in Court.
- S 229 privilege is not completely the same as client legal privilege:
  - limited to first limb, providing advice, and limited again to IP advice;
  - does not extend to other documents generated by a TM attorney in the course of representing a client in Court or arbitral proceedings.
- Explanatory Memo to *Raising the Bar* Act: “Attorneys do not have the same rights as lawyers do to initiate and represent parties in court.”
- Advice from a TM attorney about the contents of a statutory declaration or a submission may be privileged, but the mere drafting of those documents by a TM attorney would not attract s 229 privilege.

**ATMO Decisions**

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**Trade Marks Office decisions**

**Insufficiently distinctive – s 41**

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# **SUPER SLICES**

Cheese and cheese products.

*Bega Cheese Limited* [2016] ATMO 13

## Insufficiently distinctive – s 41

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# FAIRFIELD

Advertising services, franchise services, hotel services, restaurant services etc.

*Marriott Worldwide Corporation* [2016] ATMO 1.

# SANREMO

Remote controls for mining equipment etc

*Clearlight Investments Pty Ltd v Sandvik Mining and Construction Oy*  
[2016] ATMO 7.

## Insufficiently distinctive – s 41

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# MCQUEEN

Several classes incl perfumes, eyewear, watches, clothing, footwear etc

*Metropolitan Investment Group Pty Ltd v Autumnpaper Ltd* [2016] ATMO 115

# ODDS BOOST

Wagering services

*Ladbrokes Digital Australia Pty Ltd* [2016] ATMO 116

**Insufficiently distinctive – s 41**

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# **SYDNEY BUSINESS SCHOOL**

Various goods & services related to educational & advisory services

*The University of Sydney v The University of Wollongong* [2016] ATMO 17

(pre-RTB s 41(6) TMA applied – evidence of use insufficient to support reg'n).

# **LOCALFITNESS**

Various goods & services related to fitness services, advertising, promotion etc

*Localfitness IP Pty Ltd* [2016] ATMO 23.

**Insufficiently distinctive – s 41**

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**CRADLE MOUNTAIN BEEF**

**CRADLE MOUNTAIN LAMB**

Fresh meat.

*Bellevue Consultancy Services Pty Ltd [2016] ATMO 33.*

## Insufficiently distinctive – s 41

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# BHUJA

Various foodstuffs in classes 29 & 30.

*Majans Pty Ltd* [2016] ATMO 47.

# HOME SHOW

Organising, arranging, conducting & managing exhibitions, trade shows and trade fairs etc.

*Exhibitions and Events Australia Pty Ltd* [2016] ATMO 71

**Insufficiently distinctive – s 41**

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# **MELBOURNE CITY FOOTBALL CLUB**

Several classes including entertainment, sporting and cultural activities.

*MHFC Holdings Pty Ltd [2016] ATMO 96.*

## Insufficiently distinctive – s 41

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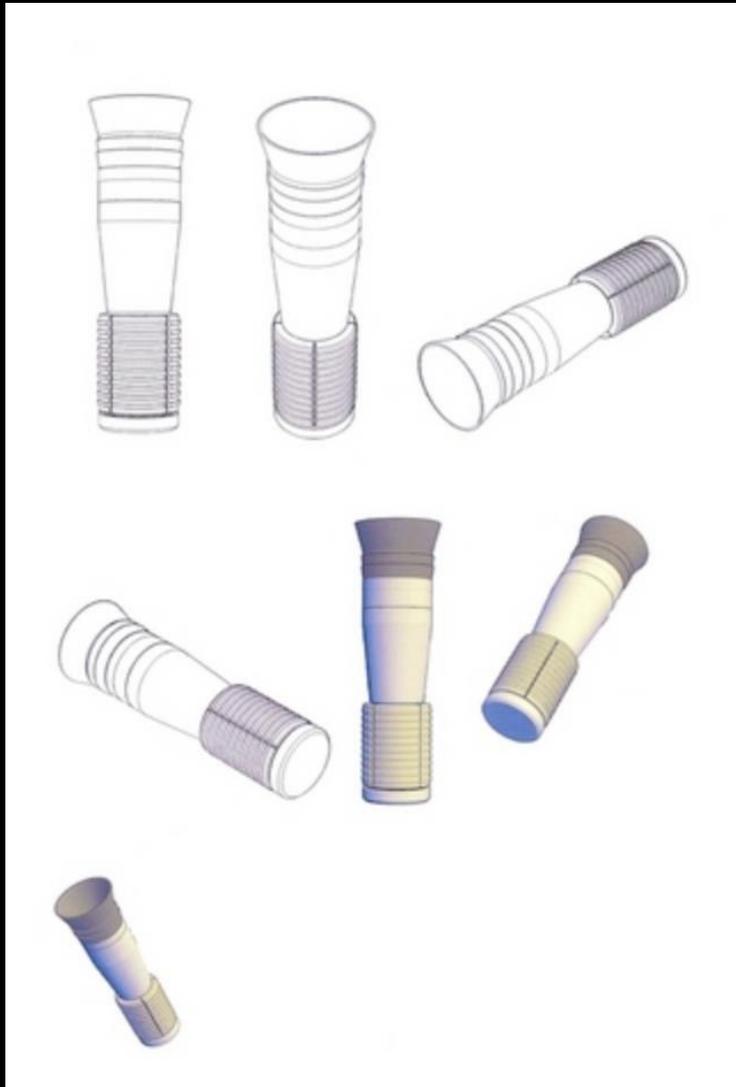


*Many classes – largely relating to food, medicines and animal products*

*Ferngrove Pharmaceuticals Australia Pty Ltd [2016] ATMO 74.*

## Insufficiently distinctive – s 41

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**Shape mark – mark consists of 3D design**

*Registration sought in relation to bore hole plugs for use in earth drilling etc*

*Van Ruth Pty Ltd [2016] ATMO 60*

## Insufficiently distinctive – s 41

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Energy drinks

*The Coca-Cola Company v Frucor Beverages Limited* [2016] ATMO 38

**Sufficiently distinctive – s 41**

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# **BROCKBEAUTY**

Non-medicated skin preparations, creams, lotions etc

*Brock Beauty Inc [2016] ATMO 44*

# **MY POST**

Computer software & hardware, retail services, electronic banking and many other classes.

*Jason Bosco Elvis Soares v Australian Postal Corporation [2016] ATMO 10.*

**Sufficiently distinctive – s 41**

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**REALESTATE.COM.AU**

Advertising of real estate services, Real estate property services

*First National Group of Independent Real Estate Agents Limited v REA Group Ltd [2016] ATMO 102*

Section 41(6) applied as per Bromberg J's analysis in *REA Group Ltd v Real Estate 1 Ltd*

## Sufficiently distinctive – s 41

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# W WATCH

Various goods including phones, medical apparatus, watches, tablet computers

*Swatch AG v LG Electronics Inc* [2016] ATMO 121.

# FOX

Medical and vet products, pharmaceutical preparations etc

*Vectura GmbH* [2016] ATMO 77

Sufficiently distinctive – s 41

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# BLACK DOG

Charitable services, charitable fundraising, education and training services in relation to mental health, provision of mental health services incl counselling and psychological care.

*Black Dog Institute v Black Dog Ride Pty Ltd* [2016] ATMO 66

H.O. Irgang (relying on *Cantarella*): "...the term is common within the mental health industry, [but] I am not satisfied that other traders are likely to require to use the expression BLACK DOG ... They may 'want' to use it but they do not require use of the expression."

## Sufficiently distinctive – s 41

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Television receivers, monitors, LCD panels etc

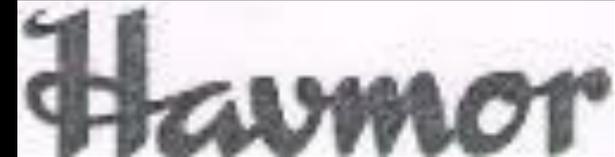
*My Brilliance Pty Ltd v Samsung Electronics Co Ltd* {2016} ATMO 84

# Contrary to law: s 42(b) – contrary to *Copyright Act 1968*

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v



Applicant sought to register mark (left) incorporating a substantial part of the Opponent's copyright works (right)

## Deceptively similar TMs

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**DERMERA** v **DERMIRA**

Body & beauty care, cosmetics v pharmaceutical preparations incl rel to skin care

*Brock Beauty Inc. [2016] ATMO 57*

**NABI** v **NAB**  
**NABI CLOUD** v **NAB GROUP**

Handheld digital devices etc v computer programs used in banking services (inter alia)

*National Australia Bank Limited v Mattel, Inc [2016] ATMO 59*

## Deceptively similar TMs

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**REVOLVO** v **VOLVO**

Bearings for various uses incl vehicles v car engines and motor parts

*Volvo Trademark Holding AB v Timken UK Limited* [2016] ATMO 91

## Deceptively similar TMs

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**MR. PINK**

v



Energy drinks

v

sports drinks & energy drinks

*Pink energy Beverages Pty Ltd v Mr. Pink Collections, LLC. [2016] ATMO 20*

# Deceptively similar TMs

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v



Restaurant services etc v providing food and drink, takeaway food etc

Note that Applicant's mark held NOT deceptively similar to opponent's other registered mark for the plain words BING BOY in the same classes.

*Bing Boy IP Pty Ltd v Bing Go Street Food [2016] ATMO 55*

## Deceptively similar TMs

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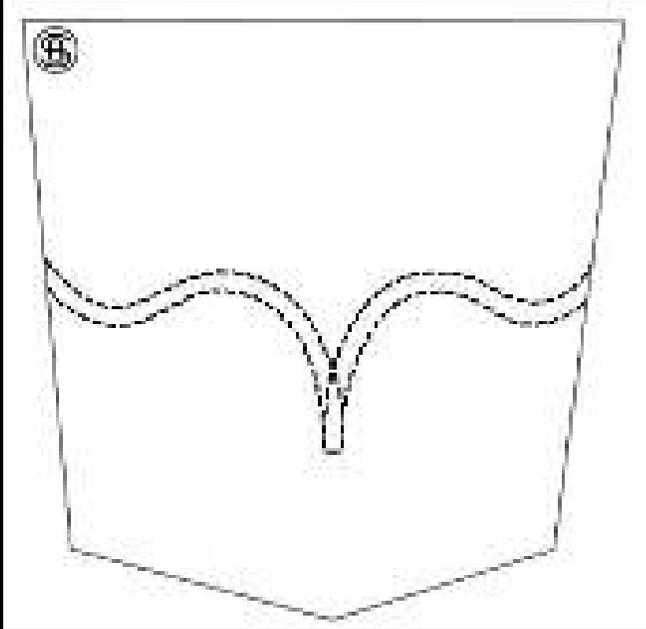
v



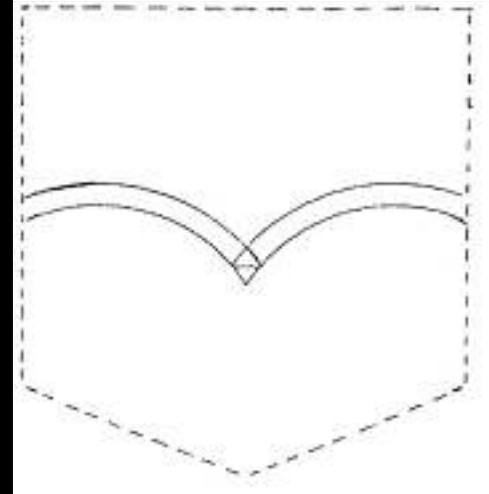
Componentry for electrical devices v computers, computer programs etc

*Karen Lee* [2016] ATMO 19

# Deceptively similar TMs



v



Clothing – trousers, jeans etc

v Various classes incl clothing

*Levi Strauss & Co v Yugen Kaisha Shimura (Shimura, Ltd.)* [2016] ATMO 67

## Deceptively similar TMs

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v



Electric food processors

v Electric food blenders

*BlendTec Inc. v Healthy Foods LLC* [2016] ATMO 69

But s 44(4) TMA (prior use) applied & mark proceeded to registration.

## Deceptively similar TMs

---



v

**SAMURAI**

Fishing tackle

Fishing reels and fishing lines

*Teraglow Pty Ltd* [2016] ATMO 32

## Deceptively similar TMs

---

**UNIVERSAL GYM** v



Clothing for gymnastics, gymwear etc v pyjamas, t-shirts, other clothes etc

*Universal Protein Supplements Corporation v Universal Gym Australia Pty Ltd*  
[2016] ATMO 24

## Deceptively similar TMs

---



v

**NUTRA-LIFE**



Dietary supplements etc

v vitamin and mineral supplements etc

*Health Foods International Limited v Healthyby Pty Ltd [2016] ATMO 97*

## Deceptively similar TMs

---

**DESIGN HUNTER**

v



the  
design hunter

Arranging & conducting seminars v retailing services, interior design services

*The Design Hunter Pty Ltd v Indesign Publishing Pty Ltd [2016] ATMO 111*

## Deceptively similar TMs

---

**MELBOURNE CITY  
FOOTBALL CLUB** v



Entertainment, sporting and cultural activities

*MHFC Holdings Pty Ltd* [2016] ATMO 96.

## Deceptively similar TMs

---



v



And 2 other similar marks

Skin preparations

v Various classes including skin preparations

*Retail Royalty Company v Aloe Vera of America, Inc* [2017] ATMO 7

## Deceptively similar TMs

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# ATOMA SUSHI TRAIN v SUSHI TRAIN



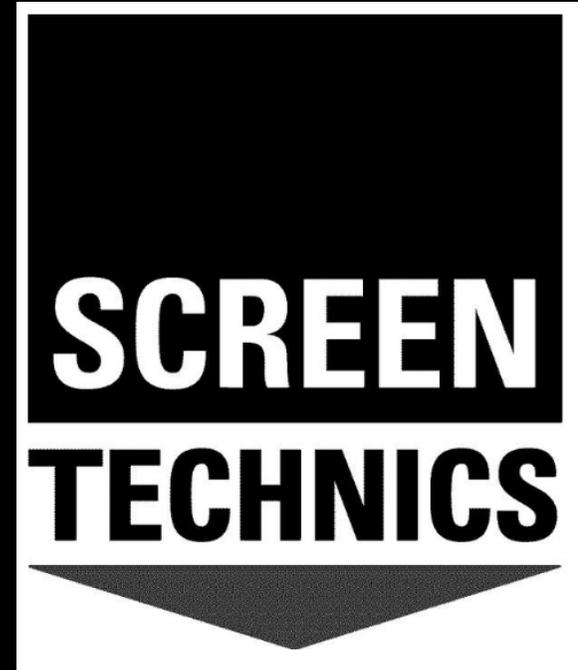
Sushi, snack foods, retail services v Restaurant services etc

*Sushi Train (Australia) Pty Ltd v RGR Norman Pty Ltd as trustee for the Norman Family Trust [2016] ATMO 76*

## Deceptively similar TMs

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**SCREENTECH v**



Electronic displays and signs v Projection screens, flat panel displays etc

*Screen Technics Pty Limited v S-TECH Holdings Pty Ltd* [2017] ATMO 1

(Mark proceeded to registration on application of ss 44(3) and 44(4) TMA – ss 42(b), 58, 58A and 60 grounds also unsuccessful).

## Not deceptively similar TMs - words

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**OPTUM v OPTUS**

*Multiple service classes  
relating to health*

*v Multiple classes rel to telecommunications*

*Singtel Optus Pty Ltd v Optum, Inc [2016] ATMO 11.*

(ss 42(b), 58 and 60 grounds also unsuccessful)

## Not deceptively similar TMs

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**The 2<sup>nd</sup> Hand Crown v CROWN**

**(& 66 other marks  
including the word  
CROWN)**

Pawn brokerage v Registrations in many different classes

*Crown Melbourne Limited v Steven Tintor* [2016] ATMO 75

(ss 42(b), 59 and 60 grounds also unsuccessful).

## Not deceptively similar TMs

---

**PLATINUM LOGISTICS v**



Customs brokerage, courier &  
transport services

v Postal services etc

*Platinum Logistics Pty Ltd v Platinum Freight Management Pty Ltd* [2016] ATMO 18

(ss 58 and 60 grounds also unsuccessful).

## Not deceptively similar TMs

---

**W WATCH v**

The Swatch logo is displayed in a white rectangular box. It features the word "swatch" in a bold, lowercase, sans-serif font. The letters are black and have a slightly irregular, hand-drawn appearance.

Phones, watches, jewellery, etc

*Swatch AG v LG Electronics Inc* [2016] ATMO 121

## Not deceptively similar TMs

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v

**NEXT**

*Retailing services rel to newsagencies*

v

*Retail services*

*Next Group Plc v Nexcorp Australia Proprietary Limited [2016] ATMO 34*

(ss 58, 59, 60 and 62A grounds also unsuccessful).

## Not deceptively similar TMs

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v **MY BRILLANCE**

and other marks incorporating  
“Brilliance” alone & w other words

*Television monitors etc* v

*Various classes*

*My Brilliance Pty Ltd v Samsung Electronics Co Ltd* [2016] ATMO 84

(ss 41, 42(b), 43, 58 and 60 grounds also unsuccessful).

## Not deceptively similar TMs

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v

**CHIAHH**

*Snack bars, fruit drinks etc*

v

*Non-alcoholic beverages etc*

*Bickfords Trading Pty Ltd v Chia Limited [2016] ATMO 90*

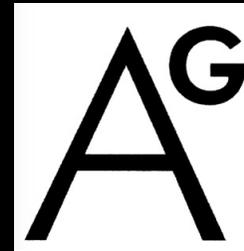
*(ss 42(b), 43, 60 grounds also unsuccessful).*

## Not deceptively similar TMs - words

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**AG ADRIANO  
GOLDSCHMIED**

v



*Clothing, footwear, headgear*

v

*Clothing, footwear, headgear*

*Grew Holdings Pty Ltd v Adriano Goldschmied LLC [2016] ATMO 65*

(ss 42, 58A & 60 grounds also unsuccessful)

## Not deceptively similar TMs

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*Energy drinks*

v **UNLEASH  
THE BEAST!**



v *Non-alcoholic beverages*

*Monster Energy Company v Ox Group Global Pty Ltd [2016] ATMO 105*

## Not deceptively similar TMs

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v **SIMPLY SMARTER INSURANCE**



*Various services incl insurance* v *Insurance services etc*

*A & G Insurance Services Pty Ltd v Stratton Finance Pty Ltd [2016] ATMO 106*

## Not deceptively similar TMs

---

DELINTE

v

**DELIUM**

Vehicle tyres etc

Tyres & tubes for various vehicles

*PT Industri Karet Deli v Qingdao Sentury Tire Co Ltd* [2016] ATMO 27

Grounds based on sections 42, 60 and 62A also unsuccessful.

## Not deceptively similar TMs

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v



& other similar marks

Cheese (Manchego)

Dairy products including cheese

*Bega Cheese Limited v Quesos Vega Soltuelamos SL* [2016] ATMO 81

Section 60 opposition also unsuccessful.

**Confusion likely: s 60**

---

**Mini Models v MINI**

*Various classes incl computer games v automotive industry & rel merchandise*

*Bayerische Motoren Werke AG v Home Focus Development Limited [2016] ATMO*

110

# Confusion likely: s 60

---



v



*Financial advice & related services*

v

tax refund services

*Tax Tips Pty Ltd v Xact Taxation Pty Ltd [2016] ATMO 25.*

**Confusion likely: s 60**

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**v SKYY BLUE**



*Alcoholic beers* v brewed, malt-based alcoholic beverage

*Skyy Spirits, LLC v Blue Sky Brewery Holdings Pty Ltd [2016] ATMO 21*

**Confusion likely: s 60**

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***QuadBeat***

v BEATBOX  
BEATS

***QuadBeat3***

BEATS BY DR DRE  
CLUB BEATS  
POWER BEATS etc

*Earphones, headphones etc*

v Earphones, headphones etc

## Confusion likely: s 60

---

**McKosher**

v

**McFeast**

**McChicken**

**McBreakfast**

**McPavlova**

**McGrilled**

**McCafe**

**etc**

*Multiple goods & services rel to food*

v

*Multiple classes rel to food*

*McDonald's Corporation v Glaser [2016] ATMO 22.*

**Confusion likely: s 60**

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**CLIMATE MASTERS  
OF SEELEY  
INTERNATIONAL v CLIMATE MASTER**

*Advertising, education services etc v Air conditioning systems, installation, repair*

*Climate Master (Australia) Pty Ltd v Seeley International Pty Ltd and FF Seeley  
Nominees Pty Ltd [2016] ATMO 68*

**Confusion likely: s 60**

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**THE DRIFTERS**

**v**



*Various services relating to music and live entertainment*

*Treadwell Original Drifters LLC v WL Trout Promotions Pty Ltd [2016] ATMO 80*

**Confusion likely – s 60**

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**FUNERAL SERVICES  
ALLIANCE  
CENTRAL VICTORIA**      v      **FUNERAL  
ALLIANCE  
SOLUTIONS**

Funeral services, related services

*Catholic Metropolitan Cemeteries Trust v Bendigo Cemeteries Trust [2016] ATMO 30*

**Confusion likely – s 60**

---

**STORAGE WARS v STORAGE WARS**

Auctioneering services

v

US TV series based on auctions of  
contents of storage lockers

*A&E Television Networks LLC v Storage Wars Pty Ltd [2016] ATMO 12*

**Confusion likely – s 60**

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**ATOMIC BEATS v BEATBOX  
BEATS  
BEATS BY DR DRE  
CLUB BEATS  
POWER BEATS etc**

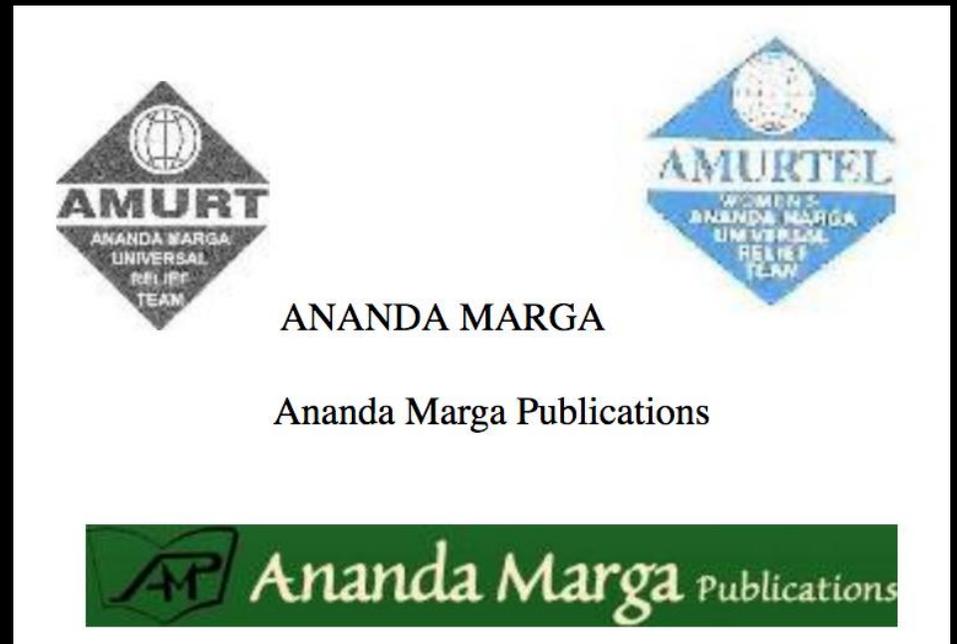
Audio speakers etc v Ear phones, headphones etc

*Beats Electronics LLC v Strategies Unleashed Pty Limited [2017] ATMO 6*

# Confusion likely – s 60



v



Book clubs, retailing, wholesaling etc  
Charity services

v

Fund raising; book sales

*Ananda Marga Pracaraka Samgha Ltd v Seva Dharma Mission (Australia) Limited*  
[2016] ATMO 79

# Confusion NOT likely: s 60

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v



Display apparatus etc

v LED screens etc

*Big Screen Video Pty Ltd v Pyramid Circle Holdings Pty Ltd [2016] ATMO 16*

# Confusion NOT likely: s 60

---

**Black Dog Ride**

v



Charitable fundraising etc

v Charitable services etc

*Black Dog Institute v Black Dog Ride Pty Ltd* [2016] ATMO 66

**Confusion NOT likely: s 60**

---

**MONSTERS  
UNIVERSITY**

v

**MONSTER**

**MONSTER ENERGY**

Multiple classes

v primarily energy drinks, clothing, headgear etc

*Monster Energy Company v Disney Enterprises, Inc [2017] ATMO 2*

**Confusion NOT likely: s 60**

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**BEAST MODE** v **UNLEASH THE BEAST!**  
**REHAB THE BEAST!**  
**UNLEASH THE NITRO BEAST!**  
**UNLEASH THE ULTRA BEAST!**  
**PUMP UP THE BEAST!**

Apparel v primarily energy drinks, clothing, headgear etc

*Monster Energy Company v Nathan Darma [2017] ATMO 4*

**False geographical indication: s 61**

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**MATUSALEM THE SPIRIT OF CUBA LIBRE**

**MATUSALEM EL ESPIRITU DE CUBA**

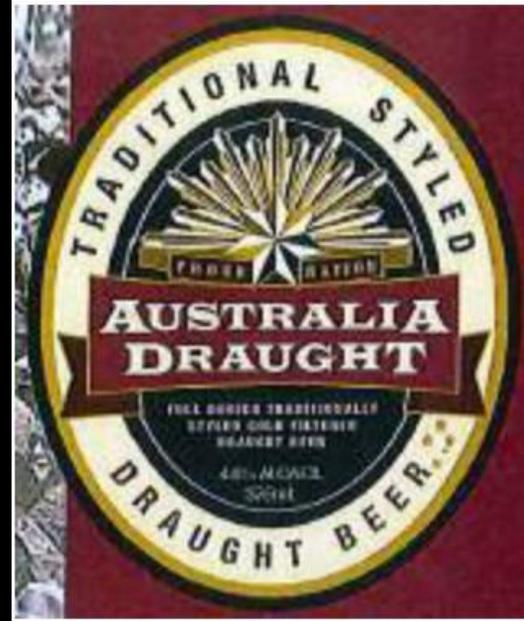
**MATUSALEM EL ESPIRITU DE CUBA LIBRE**

Alcoholic beverages (excluding beer)

*Havana Club Holding SA and Corporacion Cuba Ron S.A. v 1872 Holdings, V.O.F.  
[2016] ATMO 37*

Applicant's rum has not been produced in Cuba for at least 50 years.

## Bad faith: s 62A



Applicant sought to register mark (on left above) in respect of alcoholic beverages including beer...

There was evidence that officers of the Applicant had seen the Opponent's mark (on the right). Application was made on the day after the Opponent's launch.

*Broo Ltd v Independent Brewery Pty Ltd* [2016] ATMO 61

## Bad faith: s 62A

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# CALICO

Applicant sought to register mark in circumstances where it had knowledge of the Opponent's use of the same mark in the United States, an intention to use the mark in Australia and had had actual dealings with the Opponent.

*Calico LLC v Calico Global Pty Ltd* [2016] ATMO 98.

**That's all folks**

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