



TRADE MARKS ACT 1995

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

Re: Opposition by Ministry of Dance (NSW) Pty Limited to registration of trade mark application 1252869, 1252870 (41) - **JASON COLEMAN'S MINISTRY OF DANCE** - filed in the name of Jason Coleman's Ministry of Dance Pty Ltd.

DELEGATE:	Heath Wilson
REPRESENTATION:	Opponent: Richard Arthur of counsel instructed by Bradfield & Scott, Lawyers. Applicant: Mark Goldblatt of counsel instructed by Tisher Liner & Co, Lawyers.
DECISION:	2011 ATMO 12 Section 52 opposition – grounds pressed under sections 58, 42(b) and 62A –substantial identity – misleading and deceptive conduct – bad faith – Grounds not made out and oppositions unsuccessful – Costs awarded against the opponent.

Background

1. Before addressing the nature of the opposition to the trade marks in this matter, I find it necessary to outline a brief chronology of relevant events that have led up to these trade mark opposition proceedings. The following description of events is made on the basis of the evidence submitted by both parties.
2. Ms Jaclyn Douglas, the director of Ministry of Dance (NSW) Pty Limited (“the opponent”), attests that she and her husband came up with the business name “Ministry of Dance” in January 2006, but on April 2006 could register only the business name “Ministry of Dance and Performing Arts”, as “Ministry of Dance” was unavailable at that time. According to Ms Douglas, the domain name www.ministryofdance.com.au was later registered in Mr. Douglas’ name on 19 July 2006. The opponent then began using “Ministry of Dance” as its trade mark in relation to a dance studio located in Penrith, Sydney. Subsequently, the opponent company was registered on 12 March 2008.

3. Mr Coleman is now a director of Jason Coleman’s Ministry of Dance Pty Ltd (“the applicant”). He attests that on 12 February 2008, he chose the name “Ministry of Dance” as the name of his upcoming dance studio. On 17 February, a newspaper article was published in the *Herald Sun* referring to Mr Coleman’s new dance studio as the “Ministry of Dance”. In early April 2008, Mr Coleman’s mother convinced him to add his name to the “Ministry of Dance” trade mark.
4. Subsequently, the applicant was incorporated on 3 June 2008 and trade mark applications nos. 1252869 “**Jason Coleman’s Ministry of Dance**” and



1252870: were filed on 23 July 2008, specifying the following services:

Class 41: Education relating to dance, dancing and performance; providing of training relating to dance, dancing and performance; entertainment relating to dance, dancing and performance; cultural activities relating to dance, dancing and performance; dance choreography; dance, dancing and performance hall services; providing dance, dancing and performance facilities; dance, dancing and performance instruction; organisation and conducting of dance, dancing and performance; entertainment festivals, functions and performances; organising of dance, dancing and performance competitions; arranging, presentation and production of performances

5. The trade mark applications were examined and advertised as accepted. The opponent filed notices of opposition on 18 February 2009 under section 52 of the *Trade Marks Act 1995* (“the Act”) nominating a number of available grounds of opposition.
6. Evidence was duly filed and served by both parties in this matter. I heard the opposition to the above trade marks in Canberra as a delegate of the Registrar of Trade Marks on 9 November 2010. Richard Arthur of counsel, instructed by Bradfield & Scott Lawyers appeared on the opponent’s behalf. Mark Goldblatt of counsel appeared for the applicant instructed by Tisher Liner & Co, Lawyers.

Evidence

Evidence in Support

- Statutory Declaration of Jaclyn Melissa Douglas dated 15 May 2009 with exhibits JMD-1 to JMD-285 (“the Douglas declaration”).

Evidence in Answer

- Statutory Declaration of Jason Lawrence Coleman dated 19 February 2010 with attached exhibits JC-1 to JC-34 (“the Coleman declaration”).
- Statutory Declarations of Kingi Marsh, Karen Sutherland, Leanne Cherny, Soe Than, Kelley Abbey, Caryn Shipp, Matthew Thornton, Marko Panzic and Matt Lee.

Evidence in Reply

- Statutory Declaration of Mitchell Alexander Varlow dated 8 October 2009 (“the Varlow declaration”).

7. At the hearing, Mr Goldblatt objected to the inclusion of the Varlow declaration that had been served by the opponent at the evidence in reply stage. He argued that, due to its content, it should have been served as evidence in support rather than as evidence in reply. Noting that objection, I found the applicant had the opportunity to respond to that declaration via an application for permission to serve and rely on further evidence if it had wished to do so. The applicant chose to object to this evidence only at a late stage in the process (i.e. at the hearing). As a result, I found the evidence was admissible and have given it appropriate consideration for this opposition.

Onus and Reasons

8. The grounds of opposition pressed by the opponent were sections 58, 42(b) and 62A of the Act. It is clear from Federal Court precedent that the opponent bears the onus of establishing at least one of the opposition grounds on the balance of probabilities.¹ As they have not been pressed by the opponent, I find the remaining grounds nominated by the opponent have not been made out. The following comprises the determination for the pursued grounds.

Section 58: Applicant not owner of trade mark

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Note: For *applicant* see section 6.

¹ *Pfizer Products Inc v Karam* (2006) 70 IPR 599, per Gyles J at [6] to [26]; *Chocolaterie Guylian N.V. v Registrar of Trade Marks* [2009] FCA 891 (18 August 2009) at [22] to [206].

9. The first issue, at least in Mr Goldblatt's view, was whether the earlier use of the opponent's trade mark "Ministry of Dance" by Jaclyn and Peter Douglas (trading under the business name Ministry of Dance and Performing Arts) from 12 April 2006 to 12 March 2008 would also constitute use by the later owner and opponent, Ministry of Dance (NSW) Pty Limited.
10. The opponent company did not exist before 12 March 2008, However, the essential point is that the opponent need only establish that the applicant is not the owner of the trade mark, which it may also accomplish by demonstrating use of a trade mark by a third party.
11. The applicant has not exhibited use of the trade marks prior to the filing date of the applicant, in July 2008. As a result, the opponent's evidence (including newsletters, newspaper advertisements, dance competitions, and promotional material prior to 2008) demonstrates that it has earlier use of the trade mark "Ministry of Dance" in Australia. The opponent's trade mark has been used on services which are the "same kind of thing" as the applicant has specified in its trade mark applications.
12. The deciding factor for this ground of opposition is whether the trade mark "Ministry of Dance" is substantially identical to the applicant's trade marks. For the opponent, Mr. Arthur made particular reference to the case of *Carnival Cruise Lines Inc v Sitmar Cruises Limited*² ("Funship") where Justice Gummow said:

When the decision is understood in this way, it does not supply any general authority for the proposition that in the case of disputed claims to proprietorship under the present statute anything less than substantial identity between the two marks will suffice. The phrase "substantially identical" as it appears in s. 62 (which is concerned with infringement) was discussed by Windeyer J in *The Shell Company of Australia Limited v Esso Standard Oil (Australia) Limited* [1963] HCA 66; (1963) 109 CLR 407 at 414. It requires a total impression of similarity to emerge from a comparison between the two marks. In a real sense a claim to proprietorship of the one extends to the other. But to go beyond this is, in my view, not possible. There is, as Mr Shanahan points out in his work, p. 158, real difficulty in assessing the broader notion of deceptive similarity in the absence of some notional user in Australia of the prior mark (something postulated by s. 33) or prior public recognition built up by user (Para. 28 (a)).

² *Carnival Cruise Lines Inc v Sitmar Cruises Limited* [1994] FCA 936; (1994) 120 ALR 495 (at 62).

In the present case there would, in my view, be no material distinction to be drawn between "Fun Ship" and "Funship" or between the addition of the definite article or the use of the plural. However, "Fun Ship" is for this purpose a substantially different trade mark to "Sitmar's Funship" and "Fairstar The Funship".

13. It has been noted in *Karu Pty Ltd v Jose*³ that Gummow J's comments regarding a "total impression of similarity" were *obiter*; however, they have since been affirmed and applied in numerous cases including *PB Foods Ltd v Malanda Dairy Foods*⁴ ("Choc Chill"). While it was not disputed in the current matter that the appropriate test for section 58 was that the trade marks must be substantially identical, the parties differed on the conclusions that could be reached after applying the established legal authorities. It could be argued that the consideration of trade marks "Jason Coleman's Ministry of Dance" and "Ministry of Dance" is analogous to "Sitmar's Funship" and "Funship". However, Mr Arthur attempted to differentiate the reasoning in "Funship" from the facts of this case by placing particular emphasis on the caution of Justice Allsop in *Colorado Group Limited v Strandbags Group Pty Limited*.⁵

Though **it is potentially dangerous to reason from other facts**, it is worth noting that in that case, while Gummow J said that there was no material distinction to be drawn between FUN SHIP and FUNSHIP, and that neither the use of the definite article nor of the plural created a material distinction, he concluded that FUN SHIP was for this purposes a different trade mark to SITMAR'S FUNSHIP and FAIRSTAR THE FUNSHIP.

14. Mr Arthur argued that the name "Jason Coleman's" as opposed to "Ministry of Dance" is a descriptor, which does not alter the identity of the trade mark, Ministry of Dance. In the "Choc Chill" case, Justice Carr, in deciding that the trade marks CHOC CHILL and CHILL were substantially identical, said:⁶

...I consider that the essential feature of the trade mark is the word CHILL. When one considers the basic policy of the 1955 Act, it is the word CHILL which serves to denote the trade origin of the goods.

The word CHOC has, almost exclusively, different work to do. It describes the flavour of the goods. Registration is sought on the basis that that description will change with the flavour to COFFEE, VANILLA, STRAWBERRY and the like. Those words are (to borrow from a decision cited below) utterly descriptive.

³ *Karu Pty Ltd v Jose* [1994] FCA 1350; AIPC 91-101 (1994).

⁴ *PB Foods Ltd v Malanda Dairy Foods Ltd* [1999] FCA 1602.

⁵ *Colorado Group Limited v Strandbags Group Pty Limited* [2007] FCAFC 184[at 107]

⁶ *PB Foods Ltd (supra)* (at 31-32):

15. Mr Arthur argued that the present case was within the class of exceptions to the general principle. Finkelstein J referred to these exceptions at first instance in *Colorado Group Limited v Strandbags Group Pty Limited*⁷:

There is an exception to the general rule. In *BP plc v Woolworths* [2004] FCA 1362; (2004) 62 IPR 545 I held that in very limited situations it was possible to dissect a total image to obtain proprietorship (and trade mark registration) of only one component of the total image. The test I adopted was whether the component created "a separate and distinct commercial impression" from the other components, so that it might be said of the distinct component that it performs a trade mark function. Another way of putting it is to determine whether the individual component for which registration is sought comprises a separate and distinct trade mark. In other words, although two or more elements (words, devices or both) may be used in combination and constitute a combination mark for which registration may be obtained that does not deny absolutely the possibility that one or more of those elements is an individual mark for which registration can also be obtained. Admittedly the cases where this will occur are rare.

16. That class of exceptions does not appear to extend to situations where, as here, it is the applicant's trade mark that is the composite, unless the applied for trade mark is analogous with the Choc Chill case. While both expressions "Ministry of Dance" and "Jason Coleman's" may be able to operate as trade marks in their own right, they are not the trade marks for which registration is being sought. The consideration should be of the potential uses of the trade mark as *applied for*.
17. Ultimately, each trade mark must be considered on its own merits and according to its particular circumstances. For the opposed trade marks, the addition of the name "Jason Coleman's" constitutes a material difference in the comparison between the opponent's trade mark and the two trade marks of the applicant. Mr Arthur placed greater emphasis on the originality of the expression "Ministry of Dance" in an attempt to downplay the significance of the name Jason Coleman in the opponent's trade marks. Despite this argument, I remain unconvinced that "Jason Coleman's" is not an essential feature of the applicant's trade marks. The name "Jason Coleman" may be inherently capable of distinguishing as a trade mark in its own right and would *prima facie* denote the origin of the services. For these reasons, this matter can be distinguished from "Choc Chill" where "Choc" was seen as utterly descriptive. The inclusion of the name "Jason Coleman's" therefore precludes a finding of

⁷ *Colorado Group Limited v Strandbags Group Pty Limited* (No. 2) (2006) 69 IPR 281[at 8].

substantial identity between the two trade marks, even considering the presentation and comparative sizes of the words “Jason Coleman’s” with “Ministry of Dance” as they appear in the composite trade mark (no. 1252870).

18. It is clearly evident that the opponent’s trade marks and the applicant’s mark are deceptively similar, but this is not the accepted and established test to show prior trade mark use under section 58. After giving due consideration to the opponent’s and applicant’s trade marks and the submissions from both sides, I find that the trade marks are not substantially identical. That being the case, a ground of opposition under section 58 of the Act has not been established.

Section 42(b): Trade mark use contrary to law

An application for the registration of a trade mark must be rejected if:

- (b) its use would be contrary to law.

19. The opponent has alleged that the use of the opposed trade mark would be contrary to law as it would contravene the provisions of section 52 of the *Trade Practices Act 1974* (“the TPA”) which reads:

Misleading or deceptive conduct

(1) A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

(2) Nothing in the succeeding provisions of this Division shall be taken as limiting by implication the generality of subsection (1).

20. The opponent must demonstrate that the use of the above trademarks “would, not could” be contrary to law⁸ under the above provisions. In *Equity Access Pty Ltd v Westpac Banking Corp*⁹ Justice Hill set out the following propositions relevant for determining section 52 of the TPA (absent the case references):

1. For conduct to be misleading or deceptive the conduct must convey in all the circumstances of the case a misrepresentation.
2. There will however be no contravention of s.52 (1) of the Act unless error or misconception results from the conduct of the corporation and not from other circumstances for which the corporation is not responsible.
3. Conduct will be likely to mislead or deceive if there is a "real or not remote chance or possibility" of misleading or deception regardless of

⁸ *Advantage Rent-A-Car Inc v Advantage Car Rental Pty Ltd* (2001) 52 IPR 24 at 32.

⁹ *Equity Access Pty Ltd v Westpac Banking Corp* 1989] FCA 506; (1989) 16 IPR 431 at 41.

whether it is less or more than 50%.

4. Conduct of a corporation causing mere confusion or uncertainty in the minds of the public in the sense that they may be caused to wonder whether two products may have come from the same source is not necessarily coextensive with misleading or deceptive conduct. Since actual deception need not be shown the Court must consider whether a reasonably significant number of potential purchasers would be likely to be misled or deceived.

5. In a case such as the present the applicant must establish that it has acquired the relevant reputation in the name, that is to say that the name had become distinctive of the applicant's business in a particular country or geographical area.

6. Section 52 is not confined to conduct which is intended to mislead or deceive and a corporation which acts honestly and reasonably may none the less engage in conduct that is likely to mislead or deceive.

21. On the applicant's behalf, Mr. Goldblatt argued that as the opponent has not suffered financial detriment or damage as a result of confusion between the trade marks, misleading or deceptive conduct cannot be established. However, an opponent does not need to have suffered financial detriment for misleading or deceptive conduct to be established. The presence of a likelihood of injury to business is a requirement for establishing the tort of "passing off"¹⁰ but not for section 52. As Barwick CJ observed in *Hornsby Information Centre*¹¹:

When, as in s.52(1), the focus is upon the misleading of others rather than upon the injury to a competitor, it becomes of particular importance to identify the respect in which there is said to be any misleading or deception.

22. Whether the conduct is likely to mislead or deceive is a question of fact to be determined in the context of the evidence of the alleged conduct and the relevant surrounding facts and circumstances.

Actual Instances of Confusion

23. Demonstrated instances of confusion between the trade marks may be of significance in establishing misleading and deceptive conduct (especially if clearly demonstrated by evidence) however, they are not necessary to establish a breach of section 52. In this matter, confusion in the Australian marketplace has clearly occurred.

The question of whether conduct is misleading or deceptive or likely to mislead or deceive is an objective question which the Court must

¹⁰ *Taco Company of Australia Inc & Anor v Taco Bell Pty Ltd* (1982) 149 CLR 191.

¹¹ *Hornsby Information Centre Pty Ltd v Sydney Building Information Centre Ltd* (1978) 140 CLR 216.

determine for itself. Hence, evidence that persons in the relevant class have been misled will, although admissible, not be determinative. In some cases however such evidence will be very persuasive.¹²

24. On 17 February 2008, an article was published in the *Herald Sun* referring to Jason Coleman's new dance studio called "Ministry of Dance." As mentioned previously, Jason Coleman's name was later added to the trade mark. From June until December 2008, the opponent had to respond to a large number of emails and phone calls from prospective consumers¹³ looking for information regarding Mr Coleman and his new dance studio. As a result of the high profile of the Melbourne-based applicant, most of these consumers either mistakenly believed the opponent and the applicant to be the same entity, or assumed a business connection between them – until any perceived connection was refuted by the opponent.
25. The exhibited instances of confusion arose from a combination of the applicant's conduct and the recognition of the applicant's name in the industry, rather than the strength of the opponent's reputation. However, it is still necessary to assess the extent of the reputation in the opponent's trade mark.

Reputation of the Opponent's "Ministry of Dance"

26. The question is whether a reasonably significant number of potential purchasers would be likely to be misled¹⁴ as a result of the opponent's reputation in the trade mark. This reputation is assessed, like all grounds of opposition, at the filing date of the opposed applications (being 23 July 2008).
27. The opponent began using the trade mark "Ministry of Dance" in April 2006. The opponent's website was launched in August 2007, and dance clothing was printed with the trade mark from September 2007-2008. In addition, a number of local newspaper articles were published and an impressive number of flyers/brochures were locally distributed in 2007 and 2008. Both the newspaper articles and the flyers were targeted to Penrith, NSW.

¹² *Parkdale Custom Built Furniture Pty Ltd v Puxu Pty Ltd* (1982) 149 CLR 191 per Gibbs CJ at pp 198-9.

¹³ Exhibits JMD-229 to JMD-276 to the Douglas declaration.

¹⁴ *Weitmann v Katies Ltd* (1977) 29 FLR 336, 343.

28. The opponent won a Penrith Local Business Award for Outstanding Health and Fitness in October 2008, second prize in an event at the 2008 Sydney Eisteddfod, a certificate of outstanding achievement at the Showcase State Dance Championships 2008 and also won certain categories at the National Dance Championships in 2009. While some of these awards are dated **after** the priority date 23 July 2008, the remainder indicates a reputation in the industry. The trade mark has been in use for around 2 years, both the income and advertising expenditure for the opponent's trade mark are moderate, and the activities have been predominately confined to Sydney.
29. As mentioned above, I find that the opponent's and the applicant's trade marks are deceptively similar and the opponent has demonstrated a reputation existing in the dance industry at the priority date. While I believe that there is the possibility of confusion between the trade marks as a result of the opponent's reputation, a finding of misleading or deceptive conduct requires more than a mere possibility of confusion.
30. Considering the facts of this matter, I am not satisfied that the conduct complained of amounts to misleading or deceptive conduct. The ground of opposition under section 42(b) of the Act has not been made out.

Section 62A: Application made in bad faith

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

31. To date, there have been a number of decisions made by delegates of the Registrar dealing with section 62A and the issue of bad faith. In the absence of any Federal court authority on 62A, some guidance can be received from the UK case of *Harrison's Trade Mark Application*¹⁵:

The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his *decision to apply for registration would be regarded as bad faith* by persons adopting proper standards.

¹⁵ [2004] EWCA Civ 213; [2005] FSR 10 [at 26]

32. Ms Douglas attended an audition for the Australian version of the reality television program “So You Think You Can Dance” in November 2007. She provided a summary of her background to the television producers. This summary included the fact that she owned and ran a dance studio called “Ministry of Dance.” Mr Coleman was one of three judges on this popular television program. It is unclear whether the summary form handed to the judges included the opponent’s studio name “Ministry of Dance”, but the evidence does confirm that aspects of Ms Douglas’ school were discussed by the judges following the audition. This was recalled by another of the judges present (Matthew Lee) as attested to in his declaration. From this evidence, the applicant sought to create an inference that Mr. Coleman, having announced his new dance studio as “Ministry of Dance” a few months later, appropriated the name of the opponent’s own dance studio.

33. In response to the above allegation, Mr Coleman stated that¹⁶:

As a judge I do receive some paperwork regarding contestants, and in some instances photographs with that paperwork. However, I do not read the materials provided to me and did not read any paperwork in relation to Ms Douglas that I recall. I certainly did not read any material referring to the name “Ministry of Dance” associated with Ms Douglas.

and:

At no time during the audition process, during the filming or at any time did I read any information on Ms Douglas nor was I aware that she operated a dance studio called “Ministry of Dance.”

34. This is a clear denial by the applicant of the basis for any inference created by the opponent. However, the opponent’s case for bad faith does not end there. A further inference sought to be adduced is that Mr. Coleman became aware of the opponent’s dance studio at some point prior to applying for the opposed trade marks on 23 July 2008. Mr Coleman states that:

As at 23 July 2008 I had never heard of the Opponent Company or the name of the Opponent’s dance school in New South Wales.

He also says:¹⁷

Until November 2008 when Ms Douglas’ solicitors contacted me I had never heard of the Opponent for (sic) its dance studio.

¹⁶ Coleman declaration, paragraphs 90 and 93.

¹⁷ Coleman declaration, Paragraph 81.

35. The second statement (and also possibly the first) is at odds with the statutory declaration of Marko Panzic (a dancer and choreographer) submitted on the applicant's behalf. He says (with my emphasis):

On about mid July 2008 I saw some kids with "Ministry of Dance" written on their T-shirts at a dance workshop at Sydney Dance Company I had a conversation with one of the students who was wearing one of the T-shirts. I said words to the effect that I did not know that Jason Coleman's Ministry of Dance was opened yet. The student replied that it was not Jason Coleman's dance school but a school in Sydney.

I was surprised that there was another school in Australia with the name of "Ministry of Dance" as I had not ever heard of the school. **I had a conversation with Jason Coleman a few days later and asked him whether he was away (sic) of this school in Sydney with the name "Ministry of Dance". He replied that he was not aware of the school.**

36. The domain name ministryofdance.com.au has been registered by the opponent since 19 July 2006. In early (February) 2008, Mitchell Varlow a pastor at Mr Douglas' church received a phone call on his church number from a person identifying himself as "Jason Coleman" and "trying to get in touch with Peter Douglas because he had registered a website called ministryofdance.com.au." Mr Varlow further states that:

I believe that the reason Mr Coleman contacted me at the Church is because Peter had probably listed the Church's general phone number down as his contact phone number...

37. Left unanswered, the contents of the Varlow declaration may support the drawing of the inference that Mr. Coleman at the very least knew of the prior existence of the opponent's website, if not the trade mark. However, Mr. Coleman refutes the incident in a particular way¹⁸:

I refer to paragraph 71 of Ms Douglas' Statutory Declaration and deny that I called Mitchell Varlow. I do not know who Mitchell Varlow is and to the best of my recollection have never spoken to a Mitchell Varlow.

38. It is worth noting that the above statement carefully avoids an outright denial that Mr Coleman attempted to contact Mr Douglas in relation to his Australian domain name registration prior to applying for the opposed trade marks. Despite this discrepancy, there is an element of doubt such that the balance remains in favour of the applicant. The main reason for this is the fact that Mr. Coleman also attests to the process undertaken to come up with the name "Ministry of Dance" for his dance studio.

¹⁸ Coleman declaration, paragraph 98.

39. Mr Coleman declares that on 12 February 2008 he selected “Ministry of Dance” from various names suggested by friends and business partners. This is confirmed in a number of third party declarations provided by the applicant. It wasn’t until early April 2008 that Mr. Coleman included his own name on a suggestion from his mother¹⁹ to form the trade mark “Jason Coleman’s Ministry of Dance”.
40. A finding of bad faith is one which should not be lightly made.²⁰ In *Eicher Ltd Royal Enfield Motor Units v Matthew Scott Holder*²¹ the Appointed Person commented that:
- An allegation that a trade mark has been made in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not be lightly made...
41. While the applicant in the present matter has not directly denied the inferences sought to be established by the opponent it has provided sufficient explanation to effectively refute the allegation of bad faith. Consequently, I am not satisfied that the opposed trade mark applications have been made in bad faith and the ground of opposition under section 62A is not made out.

Decision

Section 55: Decision

(1) Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

42. The opponent has not established a ground of opposition under the Act. As a result, the oppositions fail. Trade mark applications 1252869 and 1252870 may then proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that the registrations shall not

¹⁹ Coleman declaration, paragraph 34.

²⁰ See *Hard Coffee Pty Ltd v Hard Coffee Main Beach Pty Ltd* [2009] ATMO 26.

²¹ (BL O-363-01).

occur until the appeal has been discontinued or in the event of a decision from the court that the applications be subject to that order.

Costs

43. In trade mark opposition matters, costs ordinarily follow the event and I find no reason to depart from that practice here. The applicant has been successful and I award costs against the opponent to the extent allowed under Schedule 8 of the *Trade Marks Regulations 1995*. The second opposition will be taxed in accordance with the practice set out by the Registrar's delegate in *Hume Industries (Malaysia) Berhad v James Hardie & Coy Pty Ltd* (2001) 53 IPR 591.

Heath Wilson
Hearing Officer
Trade Marks Hearings
3 February 2011