SHORT PARTICULARS OF CASES
APPEALS

CANBERRA
SEPTEMBER 2025

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TAYLOR v KILLER QUEEN LLC & ORS (S49/2025)

Court appealed from: Full Court of the Federal Court of Australia
[2024] FCAFC 149

Date of judgment: 22 November 2024

Special leave granted: 11 April 2025

The appellant is an Australian fashion designer who since 2007 has operated the 'Katie Perry' fashion label based on her birth name. The second respondent is an American singer who has performed under the stage name 'Katy Perry' since 2002. The first, third and fourth respondents are entities associated with the second respondent.

In 2007, the appellant took various steps to register the business name 'Katie Perry' and applied to register a trade mark on the Register of Trade Marks ("the Register"), using this name in the class of clothing and fashion designing. At this time, the appellant was unaware of the second respondent. This first registration application lapsed, but in late 2008 the appellant successfully made a second application to register a trade mark. At this time, the appellant knew of the second respondent.

An application can be made for amendment or cancellation of an entry on the Register (called rectification). Pursuant to section 60 of the *Trade Marks Act 1995* (Cth) ("the Act"), the registration of a trade mark may be opposed on the ground that its use may confuse or deceive because of another trade mark with a reputation in Australia. Under s 88(2) of the Act, a person may apply to have a trade mark cancelled on the ground that, at the time the application is filed, the use of the trade mark is likely to deceive or cause confusion. However, under s 89, a court has discretion not to cancel a trade mark if the ground has not arisen through any act or fault of the registered owner.

The second respondent became aware of the appellant's use of the trade mark 'Katie Perry' prior to her intended tour of Australia in 2009. She sought to either stop the appellant from using it or otherwise agree to 'co-exist' and both use their respective trade marks, but no agreement was reached. The second respondent then made trade mark applications in Australia in various classes for 'Katy Perry', but ultimately withdrew her application in relation to clothing due to the appellant's trade mark. Despite this, the respondents proceeded to sell 'Katy Perry' branded clothing in Australia during and after the second respondent's 2009 tour.

In 2019, the appellant commenced a proceeding against the respondents for trade mark infringement for selling 'Katy Perry' branded clothing, footwear and headwear. The respondents cross-claimed, challenging the registration of the 'Katie Perry' mark, and applied to have the appellant's mark cancelled pursuant to ss 60 and 88(2) of the Act, on the ground that its use may confuse or deceive because they had established a reputation in Australia in the trade mark 'Katy Perry' before the 'Katie Perry' trade mark was registered. The primary judge held that the second and third respondents had infringed the appellant's trade mark and rejected the respondents' application.

The respondents successfully appealed to the Full Court of the Federal Court (Yates, Burley and Rofe JJ), who held that the 'Katie Perry' registration was liable to be cancelled under s 88(2) of the Act. The Full Court accepted the respondents' argument that the appellant knew of the second respondent's reputation at the time she registered her mark in 2008 and that it was not uncommon for entertainers to merchandise their brands into clothing lines, thus finding that because of the reputation in the 'Katy Perry' trade mark, the 'Katie Perry' trade mark was invalid because it was likely to deceive or cause confusion. The Full Court also found that the discretion not to cancel the registration under s 89 of the Act was not enlivened, but that even if it was, it would not have exercised the discretion in the appellant's favour, as she had applied to register her trade mark with knowledge of the reputation of the 'Katy Perry' trade mark.

In this appeal, the issues are the application of ss 60, 88(2)(a), 88(2)(c) and 89 of the Act, including how to determine when a trade mark has acquired a reputation, what type of use of a similar mark will cause confusion, and what constitutes an 'act or fault' of a registered owner.

The appellant submits that the Full Court erred in finding that the personal reputation of the second respondent herself as an entertainer was the same as the reputation in the 'Katy Perry' trade mark, that the ground in s 88(2)(c) should be assessed having regard to the actual use of the trade mark, not its potential or notional use, and that the Full Court misconstrued the discretion in s 89, seriously undermining its purpose, arguing that the registration of a trade mark cannot itself be the relevant act.

The respondents counter that in this case, the reputation of the second respondent as an entertainer could not logically be divorced from the reputation of the 'Katy Perry' trade mark, that the Full Court correctly concluded that as at 2019 the mark was likely to deceive or cause confusion, and that the registered owner has to satisfy the Court that their conduct has not contributed to the mark becoming liable for removal on the basis of deception or confusion.

The grounds of appeal are:

- The Full Court erred in finding that the Respondents had established the grounds in (i) ss 60 and 88(2)(a) and (ii) s 88(2)(c) of the *Trade Marks Act 1995* (Cth) ("the Act") in respect of the appellant's Australian trade mark 1264761 ("the Designer's Mark").

- The Full Court erred in finding that the discretion in s 89 of the Act was not enlivened in respect of the Respondents' application for rectification of the Register to cancel the Designer's Mark on the basis of (i) ss 60 and 88(2)(a) and (ii) s 88(2)(c) of the Act.

- The Full Court erred in refusing to exercise the discretion in s 89 of the Act in respect of the abovementioned application for rectification if that discretion was enlivened.

WHS v THE KING (S92/2025)

Court appealed from: Court of Criminal Appeal of the Supreme Court of New South Wales
[2024] NSWCCA 242

Date of judgment: 20 December 2024

Special leave granted: 12 June 2025

The appellant was first tried in 2014 on eight child sexual offences against MW, the foster child of his wife DB, when MW was aged between six and nine years old. He was found guilty of seven of the eight offences. However, an appeal against his conviction was allowed in 2020 and a new trial ordered. This was on the basis that the prosecution had not disclosed to the defence material tending to show prior sexual experience on the part of MW, which may have been potentially relevant to the defence of the appellant. The Crown had conceded on appeal that there had been a breach of the prosecutorial duty of disclosure.

Prior to the second trial in 2023, the Crown objected to the admissibility of this evidence, contending that it was inadmissible pursuant to section 293 of the *Criminal Procedure Act 1986* (NSW) ("the CPA"). In two pre-trial rulings, Traill DCJ upheld the objection and ruled that none of the evidence was admissible in the second trial. Traill DCJ rejected arguments by the appellant that the exception provided for in s 293(6) of the CPA (an exception regarding the scope of cross-examination of a complainant) could apply. The jury on the re-trial returned verdicts of guilty on four counts, and not guilty on two counts. The jury were then discharged without having been able to reach agreement on count 7.

The appellant sought to appeal his conviction on the four guilty counts, on five grounds:

1. Traill DCJ erred in excluding the evidence of the complainant's 'sexual experience';

1A. A miscarriage of justice resulted from the exclusion at trial of evidence of the complainant's 'sexual experience';

2. Traill DCJ erred in declining to permanently stay the trial of the appellant;

3. A miscarriage of justice resulted from the failure to permanently stay the trial of the appellant;

4. A miscarriage of justice resulted from the final address by the Crown Prosecutor;

5. The verdicts of guilty were unreasonable.

The Court of Criminal Appeal granted leave to appeal, dismissed the appeal on grounds 1 – 4, and upheld ground 5 with respect to two of the four guilty verdicts.

In this Court, the appellant submits that the exception under s 293(6) of the CPA applies where the evidence adduced by the prosecution is likely to lead the jury to draw an inference about lack of sexual experience (and not only where the prosecution in effect 'invites' the jury to draw that inference, as the Court of Criminal Appeal held). On that basis, the appellant submits that the evidence adduced by the prosecution was likely to lead the jury to draw that inference. The respondent submits that the mere fact of the age of a young complainant constitutes a disclosure or implication in the prosecution case that the complainant lacks sexual experience, so that s 293(6) is engaged. In the final address to the jury, the prosecution submitted that MW may have been hesitant to make a complaint of serious sexual misconduct against the appellant, the husband of her foster mother. The appellant submits that this was unfair when the prosecution knew that there were records of MW having complained earlier about sexual misconduct by various people.

The grounds of appeal are:

- The New South Wales Court of Criminal Appeal erred in holding that evidence of sexual experience was inadmissible.

- The New South Wales Court of Criminal Appeal erred in holding that a miscarriage of justice did not result from the final address by the Crown Prosecutor.