

H. C. OF A.
1916.
ROBINSON
v.
SANDS &
McDOUGALL
PROPRIETARY LTD.
Barton J.

It is not enough for him to swear that he was “not aware” that copyright existed, since from the face of the map he could hardly help suspecting its existence. The defence in question was really not supported by evidence at all, and as a matter of fact I find against it. See *per Bailhache J. in Byrne v. Statist Co.* (1).

In the result I think the plaintiff has substantiated his claim, and I grant the first, second, and third of his prayers, namely, an injunction, delivery up of all copies of infringing maps, and an account of profits. The plaintiff will have his costs, including the costs of the summons for directions which were reserved to the hearing. Further consideration and costs reserved. Liberty to apply.

Judgment for the plaintiff accordingly.

Solicitor for the plaintiff, *P. J. O'Donnell.*

Solicitors for the defendants, *Malleson, Stewart, Stawell & Nankivell*, Melbourne, by *Macnamara & Smith.*

B. L.

(1) (1914) 1 K.B., 622.

Appl
Chanel Ltd v
Chronogem
Ltd 19 IPR 21

Appl
Midas
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40 IPR 129

Appl
Midas
International
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40 IPR 129

[HIGH COURT OF AUSTRALIA.]

DON APPELLANT;
OPONENT,

AND

BURLEY RESPONDENT.
APPLICANT,

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1916.
MELBOURNE,
Sept. 19, 20.
Griffith C.J.,
Barton and
Rich JJ.

Trade Mark—Registration—Similarity to registered mark—Likelihood of deception—Condition—Trade Marks Act 1905-1912 (No. 20 of 1905—No. 19 of 1912), secs. 16, 25, 28, 114.

A trade mark of which registration was sought consisted substantially of a black swan, with the name “Burley” in white letters upon it, on a white ground of the shape of the continent of Australia. The application was

opposed by the owner of a registered trade mark for the same class of goods consisting substantially of a black block print of the shape of the continent of Australia divided by white lines into States, and having printed across it in large white letters extending to nearly the whole width the name "Don."

Held, by *Griffith C.J.* and *Barton J.* (*Rich J.* dissenting), that the applicant's mark was not so like that of the opponent as to be likely to deceive, and should, therefore, be registered.

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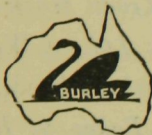
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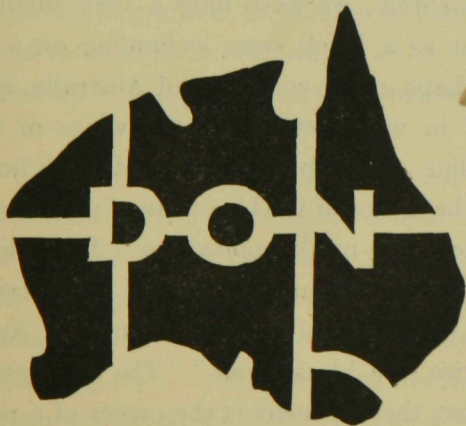
BURLEY.

APPEAL from the Registrar of Trade Marks.

Joseph Leonard Burley applied for the registration in respect of leather sporting goods of a trade mark of which the following is a copy :—



The application was opposed by Robert Somerville Don, who was the registered proprietor of a trade mark in respect of leather sporting goods of which the following is a copy :—



The applicant in his counter-statement stated that he was willing to undertake, if necessary, to use the words "J. L. Burley, Maker" prominently around his mark.

The Registrar of Trade Marks held that the applicant's trade mark was not calculated to deceive, and he dismissed the opposition. In view, however, of the applicant's undertaking, the Registrar made it a condition of registration that those words should always be used in conjunction with or as a part of the trade mark.

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From that decision the opponent now appealed to the High Court.

J. R. Macfarlan, for the appellant.

Latham, for the respondent.

[During argument reference was made to *Eno v. Dunn* (1); *Grand Hotel Co. of Caledonia Springs v. Wilson* (2); *Robert Harper & Co. Proprietary Ltd. v. A. Boake Roberts & Co. Ltd.* (3); *R. Johnston & Co. v. Orr Ewing & Co.* (4); *Payton & Co. Ltd. v. Snelling, Lampard & Co. Ltd.* (5); *In re Australian Wine Importers' Trade Mark* (6); *In re Worthington & Co.'s Trade Mark* (7); *In re Lyndon's Trade Mark* (8); *William Charlick Ltd. v. Wilkinson & Co. Proprietary Ltd.* (9); *Kerly on Trade Marks*, 4th ed., p. 287; *In re Albert Baker & Co.'s Application* (10); *Baker v. Rawson* (11); *Trade Marks Act 1905-1912*, secs. 16, 25, 28, 114.

GRIFFITH C.J. This was an application to register a trade mark, of which, unfortunately, we have only a very small specimen. I should describe it as a black swan swimming on a white ground which is of the shape of the continent of Australia, and having the name "Burley" in white letters on the wings of the swan just above the water line. The opponent himself in his notice of opposition speaks of "the device of the black swan" as one of the essential particulars of the trade mark applied for. His principal witness, Smith, evidently takes the same view, for he describes the mark applied for as "consisting of an outline map of Australia within which is the device of a black swan." The application is opposed on the ground that the opponent is the owner of a registered trade mark which is so much like that which is now sought to be registered that the latter is likely to deceive. His trade mark was registered in 1907. We have seen his original application, and it consists of a black print in block of the shape of the continent of Australia

(1) 15 App. Cas., 252.

(2) (1904) A.C., 103.

(3) 17 C.L.R., 514.

(4) 7 App. Cas., 219, at p. 225.

(5) 17 R.P.C., 48, at p. 57.

(6) 6 R.P.C., 311.

(7) 14 Ch. D., 8.

(8) 32 Ch. D., 109, at p. 119.

(9) 16 C.L.R., 370.

(10) (1908) 2 Ch., 86, at p. 110.

(11) 45 Ch. D., 519, at p. 535.

showing very roughly the division into five States, and having across it in large white capital letters extending to nearly the whole width the name "Don." A point was suggested that no notice should be taken of the colour, that is, that though the mark registered is a black block print he is at liberty to use a white ground with the name "Don" in black. I doubt it, but I do not think the point is material. From either point of view I do not think that the ordinary observer would confuse a black swan swimming on a white sea of the shape of the continent of Australia with the name "Don" printed upon a background representing that continent. I therefore think that the applicant has shown that there is no probability of deception. If there were any probability of which notice should be taken, it would certainly be removed by the offer made by the applicant in his counter-statement to use the words "J. L. Burley, Maker" printed prominently around the mark. That is not exactly the condition which the Registrar has imposed, but the applicant is willing to abide by his offer, and I think the condition should be modified in that way. With that modification the application should be granted, and this appeal should be dismissed.

Other points of interest have been raised which it is not necessary to determine, and upon which I express no opinion.

BARTON J. I am of the same opinion. I do not think that much value is to be attached to such declarations concerning the likelihood of deception as we have in this case, and, in fact, I think they are not evidence on that question. In reference to such documents a very useful passage occurs in the judgment of *Farwell J.* in *Bourne v. Swan & Edgar Ltd.* (1):—"It appears to me that there is also another reason against the admissibility" (that is, of expressions by witnesses of the opinion that a particular mark is or is not calculated to deceive the public), "and that is that I do not see how you can call any individual to give what is in truth expert evidence as to human nature, because what they are asked in this form of question is, not what would happen to them individually, but what they think the rest of the world would be likely to suppose or believe. They are not experts in human nature, nor can they be called to give such

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(1) (1903) 1 Ch., 211, at p. 224.

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evidence, and, apart from admissibility, one cannot help feeling that there is a certain proneness in the human mind to think that other people are perhaps more foolish than they really are. I do not think that Carlyle is alone in his estimate of the intelligence of the majority of the inhabitants of these islands. Therefore that is ruled out as a matter of evidence. It only remains, then, to call the evidence of people who can say that they themselves would be deceived. Now, it is obviously extremely difficult to get any such evidence. People are reluctant to admit that they are more foolish than their fellows. The result is that unless it is left to the eyesight of the Judge, to judge for himself, there is practically no evidence open to the plaintiff in an action of this sort.” I judge by my eyesight, and I think that there is no likelihood of deception arising out of the use of these two devices concurrently. I do not think that a person of ordinary intelligence—and that is really the hypothetical purchaser—would be likely to be deceived, or, as I put it in *William Charlick Ltd. v. Wilkinson & Co. Proprietary Ltd.* (1) :—“ Looking at these two labels not placed closely in juxtaposition, and putting oneself as nearly as possible in the position of an intending purchaser, it seems to me that a person having an ordinary recollection of one label would not be deceived into asking for a packet bearing the other label, seeing it in a shop. I am talking of a person of ordinary sense, not such a person as *Farwell J.* spoke of in the passage I have quoted.” Using my own observation and intelligence in the way I am called upon to do in a case of this sort, I do not think that a person of ordinary intelligence and memory would be deceived after first seeing one of these labels and then within a reasonable time seeing the other. He would not take one for the other.

I quite agree in what has been said as to the offer made by the respondent, and which he has put upon his counter-statement, although I do not think that a person of common reasonableness would be likely to be deceived. There is a common supposition that the criterion is, would an ignorant customer be deceived? That is not the criterion. But in order to make assurance doubly sure—in order to see that not only a person of ordinary observation, but even an ignorant customer, should not be deceived, it is as

well that the respondent's offer to place the name of his firm in a prominent position around the proposed label should be accepted.

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Rich J.

RICH J. I regret that I have formed a different conclusion from the majority of the Court. I confess to a feeling of scepticism in a case where there is evidence of a want of originality in the choice of a trade mark. Without going into details, the rival traders deal in the same class of goods. The prominent feature of the applicant's proposed trade mark is a map of Australia. This is also the design which gives to the appellant's registered trade mark its distinctiveness. The differences between the two marks are not such as to prevent its being likely that purchasers would be deceived. The matter is at least *in dubio*, and the applicant has not discharged the onus imposed on him, by showing affirmatively that the proposed trade mark is not calculated to deceive : *Eno v. Dunn* (1) ; *Robert Harper & Co. Proprietary Ltd. v. A. Boake Roberts & Co. Ltd.* (2).

In my opinion the appeal should be allowed.

*Subject to the variation of the condition so as to provide that the applicant's trade mark should always be used with the words "J. L. Burley, Maker" prominently around it, appeal dismissed with costs.*

Solicitors for the appellant, *Braham & Pirani*.

Solicitors for the respondent, *Proudfoot & Turner*.

B. L.

(1) 15 App. Cas., 252, at p. 257.

(2) 17 C.L.R., 514, at p. 520.