



## TRADE MARKS ACT 1995

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

Re: Opposition by Ruralco Holdings Limited to registration of trade mark application 999724(44) - **THE LOCAL BLOKE AND LOGO** - filed in the name of Robert and Alison Kerr.

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<b>DELEGATE:</b>	Terrence Williams
<b>REPRESENTATION:</b>	<b>Opponent:</b> Stephen Burley of counsel; Katrina Osgerby, patent attorney, Halford & Co, patent attorneys <b>Applicant:</b> Carmen Champion of counsel, instructed by Hazan Hollander, solicitors
<b>DECISION:</b>	<b>S 52 opposition: Sections 44 and 60 not established: YOUR LOCAL BLOKE as variously used or registered by opponent would not give rise to deception or confusion by virtue of appearance of THE LOCAL BLOKE in applicants' trade mark. S 44: applicants' services not of same description or closely related to registered services and goods of opponent. S 43 not established. Registration proceeding.</b>

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### Background

1. Robert and Alison Kerr have filed application 999724, for the following trade mark:



2. Their application has been examined at the Trade Marks Office and accepted for possible registration in respect of "Lawn and garden maintenance".
3. Ruralco Holdings Limited ("the opponent") has opposed registration of the trade mark. Both parties have followed the process in the regulations to serve and file evidence to support their positions. At the conclusion of this, I was assigned to hear and decide the opposition under delegation from the Registrar of Trade Marks.

4. At the hearing, the opponent was represented by Stephen Burley of counsel, accompanied by Katrina Osgerby, solicitor. The applicants were represented by Carmen Champion, also of counsel.

*Preliminary matters*

5. At the hearing, Mr Burley indicated that the opponent would rely on grounds of opposition under sections 60, 44, and 43, which I will come to in order in what follows. Mr Burley also submitted that the threshold question for all of these grounds required the opponent to do no more than establish a ground on the balance of probabilities. He relied here on the decision of Gyles J in *Pfizer Products Inc v Karam* (2006) 70 IPR 599. As I said in *McDonald's Corporation v Future Enterprises Pte Ltd*, (2006) 70 IPR 409, this is also the view of delegates of the Registrar while still being a matter of debate in the lack of resolution in the Full Court of the Federal Court.
6. Mr Burley noted that the opponent's primary grounds were those under sections 60 and 44. Before dealing with them it will be necessary to consider what Mr Burley said was the amending effect of the *Trade Marks Amendment Act 2006*. However, Mr Burley made a similar submission to Hearing Officer Lyons in the matter of *Apple Computer Inc. v Todaytech Group Ltd*<sup>1</sup>, at about the same time as I heard the present matter. Mr Lyons has already dealt with that issue very thoroughly and I will simply adopt, without attempting to summarise, his analysis. The result is that, since the present application was filed in 2004, s 60 operates in the present matter in its unamended form.

**Grounds considered**

7. Both s 60 (in unamended form) and s44, the opponent's primary grounds, involve allegations about the alleged deceptive similarity as between the trade mark the applicants seek to register and any one of various trade marks used or registered by the opponent. Mr Burley noted that the opponent had registered trade marks that incorporated the words "your local bloke", and which I will reproduce and consider in

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<sup>1</sup> [2007] ATMO 40

greater detail below. Of the variations made over time, the opponent's trade mark, current since 1989, is as follows:



8. The words “your local bloke” were adopted in about 1984 when they apparently first began to be used in conjunction with an earlier version of the CRT logo.
9. Mr Burley pointed to evidence which he said showed that, in addition, the opponent has used a number of “local bloke” word marks, independently of the usage of the initials CRT. The usage of trade marks, registered or otherwise, is relevant to s 60. If the opponent can establish that it has usage of these words, solus, as a trade mark, I would need to apply the test of deceptive similarity to the marks as used, a comparison that would not be fettered by the presence of the initials CRT.

***Section 60***

10. The relevant provision, excluding any effect of the provisions of the *Trade Marks Amendment Act 2006*, reads:

**60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

11. The purported “local bloke” trade marks have been in use in one form or another, Mr Burley argued, since the opponent first adopted the slogans “a/the local bloke” and, subsequently, “your local bloke”. With this in mind Ms Champion, for the applicants, argued that there was no evidence that the slogans in question had acquired a reputation separate from the registered trade marks. I turn therefore to the evidence, about which Mr Burley made detailed submissions.

12. It can be seen that the opponent is the organisation that controls the franchised operation of a group of (currently) 300 rural stores. This group was first established, in central New South Wales in 1971 under the name COMBINED RURAL TRADERS. Operations extended to Queensland in 1972 and Victoria in 1975. From the evidence, it is difficult to see if or when the slogans or descriptors “a/your/the local bloke” crossed the line and became what Mr Burley called “sub-brands of the Combined Rural Traders mark”. The latter, as Mr Burley noted, is reduced to CRT in much of the advertising but, intertwined with this, is and was the fact that the opponent had built up its reputation by trading on the fact that its member stores are operated by “local blokes”. There has been revision, over time, of the CRT trade mark but the theme of “a local bloke”, “the local bloke” or “your local bloke” is recurrent. I have paid particular attention to the historical footage of advertisements shown in the DVD that the opponent produced to promote its 35<sup>th</sup> anniversary in 2005 and in annexure B to the declaration of Cameron Beamish in the opponent’s evidence in support, an extract from *CRT Your Local Bloke 25 Years 1970-1995*.
13. However, all of this material relies on what Jacob J called “an unspoken and illogical assumption that ‘use equals distinctiveness’”<sup>2</sup>. Of course, the opponent’s success under s 60 does not depend on establishing that the words in question are “distinctive” of it to the exclusion of others. Nor is my purpose to decide if other rural stores would still (to paraphrase the classic formulation from *Clark Equipment Co v Registrar of Trade Marks*<sup>3</sup>) be likely to use those words without improper motive for the sake of their ordinary significance. None the less, it is clear from the evidence that the opponent’s *modus operandi* is to stress that an advantage of dealing with a CRT store is that behind the storefront stands “a local bloke” who is, not doubt “your local bloke”. The opponent thereby stresses that each of its stores is a local firm “not a branch of some big firm”. Even so, it is fairly clear that nothing in what the opponent has done would preclude the local plumber, electrician - or gynaecologist, for that matter – using the same words in the same sense.
14. Perhaps, however, a finding adverse to the opponent can safely be rested on a degree of equivocation: to the extent that the opponent has used the words in question as a trade mark, they are inherently words of such a character that their use by others is not

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<sup>2</sup> *British Sugar PLC v James Robertson & Sons Ltd*, 1996 RPC 281 at p303

<sup>3</sup> (1964) 111 CLR 511 at 514

likely to cause deception or confusion. This was one of many issues relevant to the provisions of s 114 of the older 1905 legislation. That provision has no direct analogue in the current legislation, but relevant issues can be compared to the operation of s 60 of the current Act. For better understanding of that aspect, I quote, with my own emphasis and parenthetical material added<sup>4</sup>:

The question whether it is likely that deception will result from the use of a mark which is the same as, or which closely resembles, a trade mark already in use may, and frequently will, require the consideration of matters additional to and distinct from those which are relevant to an inquiry under s 25 [*the direct analogue of s44(1) and (2) in the current Act*]. **It may be of importance to see whether the registered mark is general or special in character** and to ascertain the extent of its reputation. Again, it may be important to see whether the goods in respect of which it is registered constitute a narrow class or a wide variety of goods as also will be the question whether the goods of both the applicant and the opponent will be likely to find markets substantially in common areas and among the same classes of people.

15. I have allowed for the fact that there are stores affiliated with the opponent in areas near the applicants. I have allowed for the fact that rural stores in general may well, and the opponent does, produce its own seed mixes under the trade mark the subject of registrations 499924 and 733188.
16. The theme that emerges from the seed packages is that the “local bloke” in question is a manifestation of the opponent. The same theme is carried over to store frontages: the clear message is that the particular store, be it Bungendore Rural Services, Riverina Co-op or some other, is affiliated with CRT and is run and owned by a local bloke. This was so with strident emphasis in 1971 and the pattern has not shifted over time though, as Mr Burley noted, the get-up or font applied to the initials CRT has changed.
17. Observably, the force of the local bloke theme can sometimes be blunted, as it is on seed packaging. A typical packaging for 25 kg of seed mix, for instance, uses the prominent words PASTURE SOLUTIONS with, above them, the triangular device that I have just reproduced and, below them, a trade mark of a form such as PERSISTA 20 or MULTI MIX. It is probably just coincidence that, in the form that these are reproduced in the opponent’s material, the words below CRT - presumably

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<sup>4</sup> See *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at p.607-8

“the local bloke” - are completely indiscernible. A similar comment applies to the device in the form on which it appears on exhibit G, the DVD to which Mr Burley referred me. The stronger part of the trade mark, the initials CRT, survives this unfortunate treatment and is still clearly visible. This illustrates that the descriptive words in question at the foot of the triangle are not always particularly prominent, though when the registered trade mark is reproduced under other circumstances the yellow on green colouring often used is quite striking and most emphatic. More generally, the words are, inherently, such as to lend themselves to this subservient and descriptive use. It is in such a context that they will have come to the attention of rural consumers over the course of time, a perfectly logical description of that which is at the core of CRT, the working embodiment of the opponent.

18. It will therefore not be necessary to test Ms Champion’s argument that there is *no* separable reputation resident in the words in question. Her reference to *Pepsico Australia Pty Ltd v Kettle Chip Company Pty Ltd* 33 IPR 161, concerning the use of the word KETTLE in a descriptive context, is none the less apposite<sup>5</sup>. Such reputation as there is in the alleged trade mark presently at issue appears to be very firmly tied to the stronger trade mark CRT in particular, and COMBINED RURAL TRADERS in earlier times. To the extent that the local bloke slogan, in its various forms, *might* be a trade mark, and that such a separable reputation *might* exist, it is still hard to see that the latter can be the cause of deception or confusion.
19. Consistently, viewing the opponent’s trade marks as wholes, in the form in which they are both used and registered, and were I to accept that the applicants’ trade mark is deceptively similar thereto, I would still find that, despite the reputation in the opponent’s trade marks, there is no reasonable likelihood of deception or confusion. For the sake of completeness, I will say that I do not accept that, as wholes, the competing trade marks are deceptively similar. However, it will not be necessary to set out reasons for this since the finding is not critical to either the s 60 ground or, as will be seen, the s 44 matter.

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<sup>5</sup> Ms Champion noted p 168, where there is extensive reference to the similar problem that manifested in assessing the usage of CAPLETS, at issue in *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* (1991) 21 IPR 1 at 24-25

20. I do not accept that the evidence to date could support the finding that the ground has been established with respect to the proposed use by the applicant of their trade mark in respect of “lawn and garden maintenance”. The s 60 ground is not established.

#### **Section 44**

21. Sub-section 2 reads:

#### **Identical etc. trade marks**

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
- (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.


Note 1: For deceptively *similar* see section 10.


Note 2: For *similar services* see subsection 14(2): “For the purposes of this Act, services are similar to other services:

- (a) if they are the same as the other services; or
- (b) if they are of the same description as that of the other services.” ‘Of the same description’ is well understood from existing law under current and earlier legislation.

Note 3: For *priority date* see section 12.

22. Under this heading, the opponent relies on a number of registrations for trade marks identical to that which I have already set out, and one other, a trifling variant. The relevant registrations are as shown in full below:

Trade Mark	Registration numbers and Goods/Services specified
	<p>499924 (Class 42): Wholesaling and retailing of rural merchandise;</p> <p>733188 (Class 1): Chemicals used in industry, science and agriculture, horticulture and forestry, including fertilisers</p> <p>Class 5: Pesticides</p> <p>Class 31: Agricultural, horticultural and forestry products and grains not included in other classes, seed, and natural plants</p> <p>911879 (Class 36): Real estate and real estate agency services; banking and financial services</p>

	<p>732924:  (classes 1, 5 and 31) as above  (class 35): Retailing, wholesaling and merchandising of rural and agricultural products including advisory services in relation to these products; business development, but excluding business development and advisory services for transportation, haulage, freighting, storage, packaging and handling</p>
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23. The applicants' trade mark, for convenient reference, is as follows:



24. In terms of the strict reading of the provisions of s 44, it may first of all be desirable to decide if the registrations relied on by the opponent<sup>6</sup> do indeed involve services that are “similar” to those of the applicants, or goods that are “closely related” to the applicants’ services. The latter are “lawn and garden maintenance”
25. The closest that the opponent’s registrations (all of which pre-date the priority date of the opposed application) come to specifying either closely related goods, or services similar to “lawn and garden maintenance”, the applicants’ services, would be seeds and agricultural chemicals and the retailing of those things in the context of a rural store<sup>7</sup>. On the question of similar services, Mr Burley noted that the opponent’s primary and oldest trade mark registration, 499924, was in class 42. He further submitted that the Trade Marks Office's cross-class searching list for conflicting goods and services links class 44 (the class in which the applicant’s services fall)

<sup>6</sup> *Registrar of Trade Marks v Woolworths Ltd* - (1999) 45 IPR 411 at 39.

<sup>7</sup> Over time, the opponent’s wholesale and retail rural store service has been variously classified in classes 35 and 42, reflecting changes in the *International (Niece) Classification of Goods and Services*.

with, inter alia, class 42. Mr Burley went on to argue that a conflict existed also with respect to classes 1, 5, 31 and 35.

26. I am not at all convinced of the similarity of any of the services in question. There is nothing that suggests that the operation of a lawn and garden maintenance business is akin, in any sense, to the operation of a wholesale or retail business that trades in goods of a rural nature. The fact that people engaged in lawn or garden maintenance would buy consumable items, such as seeds and fertilisers, and equipment such as tools and hoses, from a rural store sheds very little light on the issue. The most that can be said is that staff at a rural store would typically be familiar with agricultural and horticultural matters. Thus, they may well be able to provide informed advice on topics as diverse as establishing a lawn and putting in an irrigation system. Those advisory facets, however, are incidental services provided in the operation of a rural store, a retailing business that is the interface between a manufacturer and the ultimate consumer. A rural store is a business aimed primarily at buying and on-selling rural supplies. Of the weight to be given to such incidental overlaps, the Full Bench of the Federal Court said, in considering the similarity of managing an hotel, on one hand, and property management services, on the other<sup>8</sup>:

If, as we have held, particular incidental services take their character from the whole, the position is not altered by the fact that managing an hotel may involve the performance of incidental services akin to those carried out by property managers.

27. As to the alleged relevance of the cross-class searching list provided at the Trade Marks Office, to which Mr Burley referred, the list is neither exhaustive nor definitive. It is a guide in only the most general terms. It aims to select, from among the (presently) 45 classes of goods and services, those classes which might most usefully be searched. It takes as its starting point nothing more precise than the class into which the services specified in a particular application are classified. In the case of the applicants' services, class 44 would include, as well as gardening services, things as diverse as Turkish baths and veterinary services. Likewise, it can be seen that the classification of the opponent's services is of no guide at all, when it is considered that, at present, class 42 includes services as diverse as analysis of aerial

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<sup>8</sup> *Mid Sydney Pty Ltd v Australian Tourism Co Ltd & Ors* [1998] 1616 FCA

photographs and cosmetic research. Thus, the mere classification of goods or services is not decisive; and never has been<sup>9</sup>.

28. On the question of the applicants' services being "closely related" to goods specified in the opponent's registrations, Mr Burley noted the decision of French J in *Registrar of Trade Marks v Woolworths Limited*<sup>10</sup> as follows:

The relationships may, and perhaps in most cases will, be defined by the function of the service with respect to the goods. Services which provide for the installation, operation, maintenance or repair of goods are likely to be treated as closely related to them. Television repair services in this sense are closely related to television sets as a class of goods.

29. There is nothing about the nature of seeds, live plants or fertilisers that suggests to me that they are closely related to lawn and garden maintenance in the sense required by the courts in application of the legislation. The "natural affinity" between them, to which Mr Burley referred, is an illusion. True it is that a gardener cannot establish a hedge or garden without seeds or seedlings, as Mr Burley suggested. But that is the end of the matter. There is no ordinary or normal linkage of which I am aware, and certainly nothing in the evidence, that suggests that the people who ordinarily undertake the maintenance of lawns and gardens have anything to do with the cultivation and, more specifically, the selection for resale, of seed-stock and seedlings. Those goods are the stock-in-trade of a nurseryman, not a gardener. While both occupations no doubt share a common fund of knowledge about the germination and cultivation of plants, the former provides no more than the raw material for the work of the latter. The latter is, moreover, engaged primarily in the maintenance of gardens and lawns belonging to others, and upon which he or she would work. Thus, the gardener or maintainer of lawns is performing labour, either under a fixed price contract or for an hourly rate, aimed at the ongoing cultivation of property. As Ms Champion argued, the services do not involve any particular function provided with respect to the goods. There had, she said, to be more than the simple use of fertilisers or pesticides as part of the performance of the applicants' services. The connection is thus unlike the direct and focused connection between the television repair and the television set, to which French J referred.

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<sup>9</sup> *Jellinek's Appn* (1946) 63 RPC 59, noted in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd*, reproduced at 1A IPR 465

<sup>10</sup> (1999) 45 IPR 411 at 424

30. It might be said that there is as much nexus between seeds and live plants, on one hand, and garden maintenance on the other as might be seen to exist between television sets and television repairs in *Woolworths*, supra. However, that is only superficial. The nurseryman, I think it is well understood, provides live plants for sale to a customer, who is then responsible for their planting and cultivation. Indeed, the sale may well be to a garden centre or some other retailer, perhaps a department or hardware store, with the nurseryman and the ultimate buyer of seedlings never even making direct contact. The person engaged in garden maintenance, on the other hand, might typically be engaged in maintaining an existing garden. This largely entails maintaining what is already there, as by weeding, edge trimming, pruning and lawn-mowing. If the gardener's work is to include the provision of seedlings, as opposed to simply planting those supplied by the customer, the customer would, I expect, be aware that this would entail, firstly, the payment for such goods and, in consequence, the knowledge that these came from a third-party source. I think the ultimate customer would always retain a clear view of the fact that the person maintaining the garden was essentially providing skilled labour in tending plants belonging to the customer, even if supplied by some third-party nurseryman. When the matter is approached in those terms, the applicant's services are one level removed from the relationship at issue in French J's example of television sets and repair thereof.
31. Accordingly, the applicants' services are neither "similar" to the services nor "closely related" to the goods for which the opponent has registrations and the s 44 ground cannot be established. The s 44 ground of opposition is not established.

### ***Section 43***

32. This reads:

#### **Trade mark likely to deceive or cause confusion**

An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

33. Mr Burley noted the case law on the meaning of connotation, for this purpose. In *Pfizer Products Inc v Karam*<sup>11</sup>, Gyles J said:

‘Connotation’ is a secondary meaning implied by the mark. The likelihood of deception or confusion must flow from the secondary meaning inherent in the mark itself. It is apparent that the underlying purpose of s 43 is a similar purpose to that lying behind ss 52, 53 and 55 of the *Trade Practices Act 1974* (Cth). It is to prevent the public being deceived or confused as to the nature of the goods offered by reason of a secondary meaning connoted by the mark in question, rather than, for example, deception by reason of similarity with other marks (*TGI Friday’s Australia Pty Ltd v TGI Friday’s Inc* (2000) 100 FCR 358 at [43]; *McCorquodale v Masterson* [2004] FCA 1247; (2004) 63 IPR 582; at [25]–[26]).

34. The opponent’s reputation is no doubt extensive, and there is doubtless a familiarity with the connotation of “your local bloke” when used in close association with the trade mark CRT. However, that is a far cry from the sort of secondary meaning that would establish that the words used by the opponent have a connotation that would support a ground of opposition under s 43 purposes. Those words, as used by the opponent, connote exactly what they would connote if used by a plumber or any other trader. For reasons consistent with my finding under s 60, I am not at all convinced that the words “the local bloke” contained in the applicants’ trade mark have a connotation such that they would be the cause of deception or confusion. The s 43 ground is not established.

### **Conclusion**

35. I find that the opponent has not established any ground of opposition. The trade mark application may therefore 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 registration shall not occur until the appeal has been discontinued or registration is otherwise ordered by the Court. I award costs against the opponent to the extent of the scale in the regulations.



T.E. Williams  
Hearing Officer  
28 September 2007

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<sup>11</sup> [2006] FCA 163)