



20 December 2018



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## Notification of decision

**Adams Pluck**

Se4

L3

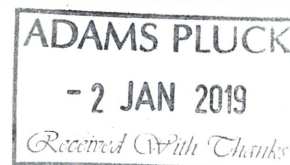
20 George St

HORNSBY NSW 2077

Australia



<b>Trade mark number:</b>	1743326
<b>Your reference:</b>	- 23380 Auto bhc
<b>Applicant name:</b>	Dennis Roy
<b>Opponent name:</b>	Augusta National, Inc.
<b>Dispute:</b>	Opposition to registration



Dear Customer

A decision on the disputed matter including written reasons is attached.

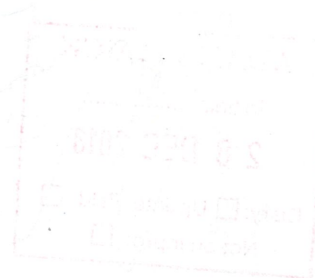
This decision may be appealed to the Federal Court or the Federal Circuit Court. Please note that irrespective of which Court proceedings are commenced, the procedural requirements (including forms and time limits for filing) are governed by Division 34.3 of the Federal Court Rules 2011. In particular:

- A party who wishes to appeal from a decision of the Registrar of Trade Marks must file a 'notice of appeal', in accordance with Federal Court 'Form 92', at either the Federal Court or Federal Circuit Court within 21 days of the date of this decision (rule 34.24(1)). If the 21 day period includes a day in the period starting 24 December and ending on 14 January of the following year, the day is not to be counted.
- That party must serve a copy of the notice on the Registrar of Trade Marks and each other party to the appeal within 5 days after filing the document at court (rule 34.24(3))

For more information on appeals, please contact the relevant court registry.

Yours Sincerely,

IP Australia





## TRADE MARKS ACT 1995

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

Re: Opposition by Augusta National Inc to registration of trade mark application 1743326(41) - **THE MASTERS PENNANT EST.1981 AND DEVICE** - in the name of Dennis Roy.

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DELEGATE:	M. Cooper
REPRESENTATION:	Opponent: Ms. Kate McHaffie of A J Park Law Applicant: Mr. Brian Elkington of Adams Pluck
DECISION:	<b>2018 ATMO 199</b> Opposition under s.52 of the <i>Trade Marks Act 1995</i> : s.60 and s.42(b) grounds pursued – s.42(b) ground established - registration refused.

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#### Background

1. This matter concerns an opposition by Augusta National Inc (“**the Opponent**”), under s.52 of the *Trade Marks Act 1995* (“**the Act**”), to registration of the trade mark detailed below in the name of Dennis Roy (“**the Applicant**”):

**Application Number:** 1743326

**Trade Mark:**



(“**the Trade Mark**”)

**Filing Date:** 23 December 2015

**Services**

**Class 41:** Providing information, including online, about education, training, entertainment, sporting and cultural activities.

**(“the Applicant’s Services”).**

2. The Trade Mark was examined and advertised as accepted for possible registration on 19 May 2016 in the *Australian Official Journal of Trade Marks*.
3. On 19 July 2016, Augusta National Inc. (“**the Opponent**”) filed a Notice of Intention to Oppose registration of the Trade Mark. On 19 August 2016, a Statement of Grounds and Particulars (“**SGP**”) was filed which cited opposition grounds under sections 42, 43, 44, 58, 60 and 62A of the Act.
4. On 15 September 2016 the Applicant filed a Notice of Intention to Defend.
5. On 6 April 2018 the Applicant requested a hearing. The matter was allocated to me as delegate of the Registrar and the hearing was held in Canberra on 20 September 2018.
6. Ms. Kate McHaffie appeared by video conference for the Opponent and the Applicant was represented by Mr. Brian Elkington who appeared by telephone. As directed, both parties also filed written submissions prior to the hearing.

**Evidence**

7. The Evidence in Support consisted of declarations made by Ms. Tania Paula Cresswell Weir, a litigation assistant with the Opponent’s legal representatives, made on 6 June 2017 with exhibits TPCW-1 to TPCW-16 (“**the first Weir declaration**”) and 3 October 2017 (“**the second Weir declaration**”) with exhibits TPCW-1 to 4.
8. The Evidence in Answer filed by the Applicant consists of a declaration by Mr. Dennis Roy, on 5 January 2018 (“**the Roy declaration**”) and which includes Annexures A to J; and the declaration of Mr. Brian Elkington, the Applicant’s legal representative, dated 5 January 2018 with Annexure A (“**the Elkington declaration**”).
9. No Evidence in Reply was filed.

***The Opponent’s evidence***

10. Ms. Weir’s first declaration attached various materials which included, among other things, printouts from the Opponent’s and other websites referring to the Opponent’s Masters golf tournament, several Australian magazine and newspaper articles referring to it, various promotions and tourism offers, merchandise associated with the Masters tournament, the Golf

Australia “Golf participation report 2014” and an ABS publication entitled “A sporting nation”.

11. In her second declaration, Ms. Weir exhibited a Fox Sports report prepared for the Opponent relating to the broadcast of “The Masters” in Australia from 2014 to 2017, the promotions schedule for the 2014 to 2017 (including social media), the programme schedules for 2016-2017, Adobe analytics results for unique Australian visits to the Opponent’s website from 2014 to 2017 and a 27 January 2014 article from The Australian newspaper discussing channel 7’s coverage of the US Masters and indicating that the event had been broadcast on Australian television since the 1980s.

*Applicant’s evidence*

12. In his declaration Mr. Roy described his role as the “Captain”, Secretary and Treasurer of a group of golfing enthusiasts operating under the name THE MASTERS PENNANT. He claimed that this group provided the “Committee control and functional operation and instruction in relation to the sport of golf and organises a number of annual golf tournaments, one of which is called The Masters Pennant tournament”. He annexed a 1995 letter from a former member of the group which outlined the history of the group and explained the origin and evolution of the competition which, it was claimed, commenced in 1980.
13. Mr. Roy claimed the Trade Mark had been in use since March 1990, the competition, for amateur older golfers who play at a high level, having previously been called the “Seniors Masters Pennant”. The word “Pennant” was claimed to be a reference to golfers who have played in a senior or major pennant. Mr. Roy asserted that the Trade Mark “is certainly associated exclusively with the Applicant, with the Services it provides and with the golfing tournaments operated in association with it.” He attached excerpts from the Applicant’s website, [www.masterspennant.com.au](http://www.masterspennant.com.au), which he claimed had gone “live” on 19 March 2009. He said the purpose of the website was to provide information about past competitions and the status of the current competition.
14. Mr. Roy also attached the following documents to his declaration:
  - Copies of (undated) business cards featuring the Trade Mark.
  - Publicity for the event and signage used at events bearing the Trade Mark.

- The pennant featuring the Trade Mark said to have been distributed to winning teams since 2007.
  - Photographs of trophies and awards distributed following the 2017 competition and the tournament schedule and results.
  - Drawings of pennants used in competitions in 2011 and 2012.
  - The draw for the 2018 event.
  - Printouts from the websites of three Australian golf associations which were said to show they also used the phrase “Masters Pennant” in connection with running, holding or sponsoring a “Masters Pennant” golf tournament.
  - Printout of Google search results for the phrase “Masters Pennant” which were said to demonstrate that the use of the phrase “Masters Pennant” is common in Australian golf.
15. Mr. Roy said he was unaware of any confusion between the Trade Mark and any of the Opponent’s marks. He claimed there are a number of other golf clubs or associations who also run “Masters Pennant” golf tournaments and referred to the annexed website printouts.
16. In conclusion Mr. Roy claimed that “the educational services and the golf tournaments associated with the Trade Mark have accrued a significant reputation and are certainly well-known among golfers in NSW and other States of Australia. It is apparent to me that no-one owns exclusive rights in the word MASTERS in relation to the sport of golf as it is commonly used by clubs everywhere.”
17. The Elkington declaration referred to and attached copies of a search of the Australian Trade Marks Register for trade marks which included the word “masters” and covered golf equipment, tournaments or other goods and services associated with golf.

## **Submissions**

### ***Opponent***

18. In its written submissions the Opponent only maintained its s.60 and s.42(b) grounds of opposition, and advised it did not rely on passing off as pleaded in its SGP.
19. In relation to s 60, it relied on the reputation of its trade mark “THE MASTERS” claiming that it had acquired a reputation such that use of the Trade Mark would be likely to deceive or

cause confusion. Relying on the evidence, it noted that “THE MASTERS” is one of four major championships in professional golf and is played on “the best known golf course in the world”. It has been organised by the Opponent and played annually at the Augusta National Golf Club in Augusta, Georgia since 1934 and has been known as THE MASTERS since 1939. The history of the tournament was outlined and the famous Australian golfers who had participated in it were noted. A well-known tradition of the Opponent’s Masters tournament was said to be the Green Jacket, presented to the winner of each tournament since 1949.

20. The Opponent submitted that, at the relevant date, the Opponent’s mark “The Masters” had clearly established the requisite reputation. It claimed that this “can be inferred from the evidenced exposure in television and print media since as early as 1956, the significant advertising campaigns, its worldwide reputation in the mark, and the response of the Australian sports tourism market.” Several exhibits evidenced substantial Australian media attention since the 1950s and the Australian broadcast of the tournament since the 1980s. Statistics also demonstrated the relatively large Australian viewing audience for the televised broadcasts. Evidence of various Australian tourism campaigns associated with “The Masters” was also provided.
21. In relation to the likelihood of deception or confusion, the Opponent recited the relevant principles and submitted that there is a real and tangible likelihood of deception or confusion because the publicity surrounding THE MASTERS tournament, its prestige, and the participation of high profile Australian players, has “created an awareness and recognition of the event amongst Australian consumers”.
22. The Opponent further submitted that the marks are similar, sharing the same dominant element, the words “The Masters”, and there is a clear overlap and nexus between the Applicant’s Services and those for which the Opponent has a reputation. In addition the use of the green colour, akin to the “well-known Green Jacket”, was claimed to increase the risk of deception or confusion. The Opponent submitted that its reputation in its mark was such that “consumers will be caused to wonder whether the Applicant’s services provided under the Trade Mark are associated with or endorsed by the Opponent.”
23. The Opponent noted that the relevant consideration in this regard was the notional use of the Trade Mark for the Applicant’s Services and in this context the Applicant’s statutory

declaration, describing the conduct of its tournaments, was irrelevant because running such events is not covered by the Applicant's Services.

24. In relation to its s.42(b) grounds, the Opponent submitted that use of the Trade Mark would constitute misleading and deceptive conduct contrary to s.18 of the Australian Consumer Law ("ACL") and misleading representations contrary to s.29(1)(g) and (h) of the ACL.
25. The Opponent claimed that it has "established a significant reputation in its the MASTERS mark in Australia and worldwide. This reputation is sufficiently extensive so as to create an exclusive association in the mind of consumers between THE MASTERS and the Opponent and its tournament." The Applicant's Services and the services for which the Opponent's THE MASTERS mark had acquired a reputation were said to overlap and would lead, or were capable of leading, "an ordinary and reasonable Australian consumer to believe that the Applicant's services or the Applicant, has the approval or sponsorship of the Opponent or is affiliated with the Opponent."
26. The Opponent also observed that the Roy declaration indicated the use of the Trade Mark related almost entirely to a small tournament in New South Wales and that amongst this "small group of consumers, it may be that there is no risk of confusion". Given the breadth of the Applicant's Services however the relevant consumer base was not limited to senior golfers in NSW. It was submitted that the Applicant's evidence did not support the proposition that there is no risk that consumers would be misled or deceived by its use of the Trade Mark.
27. Relying on various authorities, it was contended that that the evidence of the state of the Register is not a relevant consideration.

### ***Applicant***

28. The Applicant referred to the Opponent's evidence and noted that the Weir declarations had been made by a "litigation assistant" who works with the Opponent's representatives. There was nothing that indicated she had any first-hand knowledge of the Opponent's tournament or its use of phrase "The Masters". In any event, the exhibits were "merely" printouts from a variety of media sources and most frequently referred to the tournament as the "US Masters" and various forms other than "The Masters". The Applicant submitted that the words "The Masters" "are never accompanied by any indication that they comprise a trade mark owned or

claimed by the Opponent. None of the news organizations or websites in the Opponent's evidence state that this phrase is owned by the Opponent and is being used under licence from the Opponent." It was further asserted that nothing in the evidence demonstrated that the Opponent "has ever claimed ownership of the phrase "The Masters" or has ever made clear to others that it is claiming such ownership".

29. The Applicant noted the difference between use as a trade mark and "an association in the mind of certain members of the public between that phrase and a particular company". Relying on several authorities, it was submitted that "The Masters" had not been used as a trade mark and therefore it "cannot claim a reputation in this phrase for the purpose of s.60."
30. Even if there was evidence of use as a trade mark, and relying on the decision of Kenny J in *McCormick & Co Inc v McCormick*<sup>1</sup>, the Applicant submitted there was no evidence of sales volumes or advertising figures or of a reputation amongst a significant number of people. Referring to the Opponent's Australian trade marks, it was noted that the Opponent has been unable to register "Masters Augusta Georgia" and therefore there is "no reason they should be able to claim exclusive ownership of "The Masters" or "Masters" now". The Opponent's evidence was said to be insufficient to support its s.60 ground.
31. Even if sufficient reputation was found, the Applicant contended that there was no meaningful possibility consumers would be confused by use of the Trade Mark. The Applicant claimed it has used the Trade Mark in its current form since 1990, delivering a number of services under the auspices of the NSW Golf Association for the benefit and entertainment of "senior" golfers from all around Australia. It was contended that "Masters" is commonly used in the sporting world "to refer to athletes who are perhaps beyond their prime" and there are "dozens of golf courses around the country which host an annual tournament called 'The Masters Pennant'". It was submitted that the people in Australia who see the Trade Mark will be golfers who know it is a reference to "older golfers", will be aware that golf courses have such a competition and are familiar with the US Masters Golf Tournament. In this context it was asserted that Australian golfers "have never mistaken the [Trade Mark] as an indication that the Applicant's golf tournament is somehow connected with the Opponent".

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<sup>1</sup> (2000) 51 IPR 102



32. Noting the presence of other “Masters” marks on the Australian Trade Mark Register covering goods and services related to golfing, it was submitted that the Opponent has no legitimate claim to exclusive use of the phrase. The Applicant also asserted that it was absurd to suggest that the examiners had made that many mistakes by allowing trade marks containing the word “masters” to be registered. The Applicant contended that the word “Masters” has been used by many other entities for several years and for this reason consumers will not be confused.
33. In relation to the section 42(b) grounds, noting that the Opponent must establish that the relevant conduct would breach existing law, the Applicant asserted that Australian consumers “are very accustomed to use of “The Masters” as part of the title of a tournament meant to include senior players”. It was also asserted that these same consumers are likely to be aware of the other “Masters” marks on the Register. Noting the Applicant’s use of the Trade Mark for 28 years, if it was going to give rise to confusion, the Opponent should be able to produce “numerous examples”. Mr. Roy said there had been none and the Opponent had not indicated any instances of confusion. In this context it was said to be “absurd for the Opponent to claim that it has exclusive rights in the phrase “The Masters” or that its reputation in the phrase is paramount.” On this basis it was contended that the Opponent had not established the s.42(b) ground of opposition.
34. The Applicant and Opponent’s representatives also provided submissions at the hearing. Where relevant they are referred to below.

### **Grounds, onus and standard of proof**

35. In respect of proceedings under s.52, the Opponent bears the onus of establishing one or more of the grounds of opposition in relation to the relevant goods and services of an opposed trade mark and the standard of proof required is on the balance of probabilities.<sup>2</sup> As mentioned, the Opponent only sought to rely on its opposition grounds s.42(b) and s.60.
36. The time at which a ground of opposition must be established is the date of filing of the application for registration<sup>3</sup> which, in this application, is 23 December 2015 (“the Relevant Date”), also referred to as the priority date for s.60 purposes.

<sup>2</sup> *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2015] FCAFC 156 affirming the approach of Gyles J in *Pfizer Products Inc. v Karam* [2006] FCA 1663; (2006) 70 IPR 599, [6-26].

<sup>3</sup> *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, [595].

### Consideration and reasons

37. The Opponent's grounds of opposition are discussed below.

### Section 42(b)

38. Section 42(b) of the Act provides:

#### Trade mark scandalous or its use contrary to law

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

(a) ...; or

(b) its use would be contrary to law.

39. As was noted by Rangiah J in *Primary Health Care Limited v Commonwealth of Australia*, with whom Katzmann J and Greenwood J agreed on this point:

Section 42(b) of the [Act] requires that the use of a trade mark "would be" contrary to law. It is not enough for a party opposing registration to show that s 18 of the ACL or s 52 of the [*Trade Practices Act 1975* ("the TPA")] might be contravened. The opponent must prove, on the balance of probabilities, that the provision would be contravened by use of the trade mark.<sup>4</sup>

40. Therefore the onus is on the Opponent to establish, in Madgwick J's words,<sup>5</sup> that use of the Trade Mark would be, rather than could be, contrary to law on the balance of probabilities.

41. In its SGP the Opponent repeated its s.60 particulars and stated that use of the Trade Mark "would, in view of the reputation of the Opponent's THE MASTERS trade mark constitute misleading or deceptive conduct contrary to the Australian Consumer Laws; and/or involve passing off."

42. In its written submissions, and as confirmed at the hearing, the Opponent resiled from reliance on passing off. It maintained however that use of the Trade Mark would breach sections 18 and 29(1)(g) and (h) of the Australian Consumer Law ("ACL").

43. The written submissions are otherwise summarised above.

44. At the hearing, Ms. McHaffie noted that the Applicant's submissions made much of the absence of any confusion but, she submitted, the test is forward looking and is concerned with what the Applicant may be entitled to do and what might occur if the Trade Mark is used

<sup>4</sup> *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [411].

<sup>5</sup> *Advantage Rent-A-Car Inc v Advantage Car Rental Pty Ltd* (2001) 52 IPR 24, [28].

in respect of its designated services. That is, the relevant test is not the production of evidence of actual deception but its likelihood. In this context it is a broader group of people that must be considered and not just people who know of the Applicant's tournament. She contended that if the relevant group of consumers is limited to the small group who know of the Applicant's tournament there may be little risk of deception or confusion however, given that the Opponent also provides information services in relation to its tournament, there is an overlap of concerned consumers and the risk is consequently greater.

45. At the hearing, Mr. Elkington submitted that, in this regard, the current circumstances were unlike those in *Qantas*<sup>6</sup>, as the Opponent had not shown that its reputation was so large that the use of "Masters" will lead people to think of the Opponent. If that was the case he maintained there would be evidence of confusion. He claimed no reasonable Australian on seeing the Trade Mark is going to think of the Opponent. He maintained that the Applicant's golf tournament is relatively well-known and the fact that people have heard of the Opponent is not the point, it is necessary for the Opponent to show that because of its reputation, consumers will be misled or deceived.

### ***Discussion***

46. The relevant provisions of ss 18 and 29 of the *Australian Consumer Law* ("the ACL"), in Schedule 2 to the *Competition and Consumer Act 2010* (Cth) provide as follows:

#### **Section 18: Misleading or deceptive conduct**

A person must not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

..

#### **Section 29: False or misleading representations about goods or services**

(1) A person must not, in trade or commerce, in connection with the supply or possible supply of goods or services or in connection with the promotion by any means of the supply or use of goods or services:

...

(g) make a false or misleading representation that goods or services have sponsorship, approval, performance characteristics, accessories, uses or benefits.

(h) make a false or misleading representation that the person making the representation has a sponsorship, approval or affiliation.

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<sup>6</sup> *Qantas Airways Ltd v Daniel Amadio* [2011] ATMO 84

47. Sections 18 and 29(1)(g) and (h) of the ACL concern consideration as to whether the relevant consumers would be misled or deceived as to the true origin of the Applicant's goods and services and/or that they had some connection with the Opponent.
48. A person is said to engage in misleading conduct under s.18 (formerly s.52 of the *Trade Practices Act 1974 (Cth)* or "the TPA") if he or she (or it) engages in conduct that might lead a reasonable person in the position of the recipient of the information to be led into error. Conduct is not misleading or deceptive simply because it may cause the recipient(s) to be confused or to wonder about something.<sup>7</sup>
49. The Court also noted in *Puxu* that "conduct which merely causes some uncertainty in the minds of relevant members of the public does not breach s.52."<sup>8</sup>
50. The Opponent has relied on its reputation, the overlap in the Applicant's Services and those for which the Opponent has a reputation and the manner and markets in which the services are offered and delivered, to contend that the use of the Trade Mark is likely to mislead consumers into the belief that the services sold or offered for sale are the Opponent's services or are sponsored by or affiliated with it.
51. In *Equity Access Pty Ltd v Westpac Banking Corporation* Justice Hill summarised the relevant propositions in determining whether there had been a breach of (then) s.52 of the TPA. They are relevantly excerpted below:

While there remain many areas of difficulty in the application of s.52 of the Act to the facts of a decided case there have been established a number of propositions, relevant to the determination of the present case, which are no longer in dispute:

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 ...

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<sup>7</sup> *Parkdale Custom Built Furniture Pty Ltd v Puxu Pty Ltd* ("*Puxu*") (1982) 149 CLR 191 [199] (Gibbs CJ), 209 (Mason J); *Campomar v Nike International* (2000) 202 CLR 45 [87]; *Singtel Optus v Telstra* [2004] FCA 859 [76].

<sup>8</sup> *Puxu* [210] (Mason J).

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 whether it is less or more than 50%...[it] is an objective question which the Court must determine for itself. Hence evidence that persons in the relevant class have been misled will, although admissible, not be determinative...

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: *Puxu* at p 100; *Bridge Stock Brokers v. Bridges* (1984) 57 ALR 401 at p 413 per Lockhart J. 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... in some circumstances very slight activities may be found to be sufficient to establish that a name has become distinctive of a person's business in a particular country...

6. Section 52 is not confined to conduct which is intended to mislead or deceive.. a corporation which acts honestly and reasonably may none the less engage in conduct that is likely to mislead or deceive...<sup>9</sup>

52. Addressing the propositions in reverse order, and noting that s.18 of the ACL refers to "a person" and not "a corporation", there is no suggestion or indication of any intention on the part of Mr. Roy to mislead or deceive.
53. On the basis of the evidence attached to both Weir declarations<sup>10</sup>, in particular the evidence exhibited to the second Weir declaration, I am satisfied that the Opponent has established that

<sup>9</sup> *Re: Equity Access Pty Ltd v Westpac Banking Corporation* [1989] FCA 506 at [41]

<sup>10</sup> See in particular references to "The Masters" in exhibits to the first Weir declaration at pages 61-7, 69, 77-80, 84, 86, 89, 97-8, 102, 104-5, 107, 110, 116-7, 125-7, 130-4, 139, 145-6, 152, 160, 162, 165-6, 180, 208, 269-274, 281-2. In the second Weir declaration, see details of Fox Sports Australia (FSA) broadcasts of The Masters to Australian audiences since 1998 and claims that it reached several million Australian households; also the Adobe Analytics report detailing Australian visits to Opponent's website for 1 January 2014 - August 2017 showing several hundred thousand unique views from around Australia over the period.

it has acquired a significant reputation in Australia in the name “The Masters”, used in respect of its annual, prestigious golf tournament in the USA. That is, that it has become distinctive in Australia as the name of the Opponent’s golf tournament.

54. Given this reputation, notwithstanding the absence of any evidence of deception to date in respect of use of the Trade Mark, I accept the Opponent’s submissions that, because of the breadth of the Applicant’s Services, the relevant class of persons concerned is much broader than those senior persons who play pennant golf as identified by the Applicant. That is, the absence of any evidence of past deception is of little weight in a context in which the Applicant has designated services much broader than its activities as described in the Roy declaration.
55. In this context, I have had regard to the Applicant’s submissions that Australian consumers are “very accustomed to the use of “The Masters” as part of a title of a tournament which is meant to include only “senior” players” however, unlike the Opponent’s evidence, there is little evidence to support this claim. The Applicant has also noted other trade marks on the Register which incorporate the word “masters” and are related to golf and submitted that this is a “very obvious reason why the relevant group of consumers would not be confused or misled by the [Trade Mark]”. As the Opponent submitted, and as many other decisions have found, the fact that other registered marks may use the word “Masters” is largely irrelevant to this inquiry.<sup>11</sup> While I accept the Applicant’s contention that it would be absurd to assume the examiners have made a series of mistakes in this respect, it is also important to note that there is no evidence before me as to the use of those other marks in the market and it follows that their relevance to this opposition is not established.
56. Therefore, looking forward<sup>12</sup>, the audience base for “providing information online, about education, training, entertainment, sporting and cultural activities” clearly encompasses a broad and significant number of potential consumers, not just those concerned with a NSW golf tournament or golf in general. Consequently, I am satisfied, for the further reasons below, that a reasonably significant number of persons would likely be misled or deceived.

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<sup>11</sup> *Automobile Club De L’Oeust v Gardiakos* [2005] ATMO 19 at [48]; *Ocean Spray Cranberries Inc v Registrar of Trade Marks* [2000] FCA 177; (2000) 47 IPR 579 at [35]- [36]; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281; *McDonalds Corporation v David Bellamy* [2004] ATMO 26 at [6].

<sup>12</sup> *Time Warner Entertainment Co LP v Stepsam Investments Pty Ltd* [2003] FCA 1502; [2004] 59 IPR 343 at [353].

57. The likelihood of error or misconception would not be the result of circumstances outside the Applicant's control but from its use of its Trade Mark for the Applicant's Services.
58. On an objective assessment therefore, given the strength of the Opponent's reputation in "The Masters" which, the evidence establishes, is clearly familiar to many Australians<sup>13</sup>, I consider the effect of the combined features of the Trade Mark, particularly the device which incorporates:
- the golfer;
  - the golfer's placement between the words "The Masters" and "Pennant" thereby giving an impression of two separate concepts, that is, of a pennant competition sponsored or run by The Masters; and
  - the green background with its accompanying suggestion of the famous Green Jacket, presented each year to the winner of The Masters golf tournament

is such that there would be a real chance it would convey the misrepresentation to a person accessing the Applicant's Services that they were sponsored by, or being delivered by or under the auspices of, the Opponent. I consider that this representation arising from use of the Trade Mark would cause more than mere confusion or uncertainty and is appropriately characterised as a misrepresentation such as is contemplated by s 18 of the ACL.

59. For the above reasons, I am therefore satisfied that the Applicant's use of the Trade Mark would be likely to mislead or deceive contrary to s.18 of the ACL and therefore the Opponent has established its opposition under s.42(b) of the Act.
60. As the Opponent has established one ground of opposition in relation to the Trade Mark, there is no requirement for me to consider the remaining grounds particularised in the SGP. In the event of an appeal to this decision, it will be open to the Opponent to additionally pursue those grounds and any others available under the Act.

### **Decision**

61. Section 55 of the Act relevantly provides:

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<sup>13</sup> See above at footnote 14.

### **Decision**

(1) Unless subsection (3) applies to the proceedings, 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.

62. Subsection (3) does not apply to these proceedings.

63. The Opponent has established the ground of opposition under s.42(b) of the Act.

64. Accordingly, I refuse to register trade mark application 1743326.

### **Costs**

65. Both parties sought costs. I see no reason to depart from the general rule that costs follow the event. As the Opponent has established a ground of opposition, I award costs against the Applicant as per Schedule 8 of the Regulations.

Mary-Ann Cooper  
Hearing Officer  
Trade Marks Hearings  
19 December 2018