FEDERAL COURT OF AUSTRALIA

Hungry Spirit Pty Ltd ATF The Hungry Spirit Trust v Fit n Fast Australia Pty Ltd [2019] FCA 1277

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| File number: |  |
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| Judge: | **BURLEY J** |
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| Date of judgment: | 9 August 2019 |
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| Catchwords: | **TRADE MARKS** – appeal under s 56 of the *Trade Marks Act 1995* (Cth) – where opponent filed submitting notice and the Registrar of Trade Marks not taking an active part in the proceedings – no evidence to support grounds of opposition – appeal allowed |
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| Legislation: | *Patents Act 1990* (Cth)  *Trade Marks Act 1995* (Cth) ss 56, 68 |
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| Cases cited: | *Cadbury Schweppes Plc v Effem Foods Pty Ltd* [2006] FCA 1267; 69 IPR 584  *Food Channel Network Pty Ltd v Television Food Network GP* [2010] FCAFC 58; 185 FCR 1  *Raytheon Company v Lockheed Martin Corporation* [2014] FCA 1063  *Sankyo Company, Limited v Alethia Biotherapuetics Inc.* [2016] FCA 1540  *Societe Des Produits Nestle S.A. v Aldi Stores (A Limited Partnership)* [2010] FCA 218  *Suyen Corporation* v *Americana International Limited* [2011] FCA 300 |
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| Date of hearing: | 9 August 2019 | |
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| Registry: | New South Wales | |
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| Division: |  | |
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| National Practice Area: |  | |
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| Sub-area: |  | |
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| Category: | Catchwords | |
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| Number of paragraphs: | 8 | |
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| Counsel for the Appellant: | Mr D. Larish | |
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| Solicitor for the Appellant: | Norton Rose Fulbright Australia | |
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| Solicitor for the Respondent: | The Respondent filed a submitting notice, save as to costs. | |

ORDERS

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|  | | NSD 1064 of 2019 |
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| BETWEEN: | HUNGRY SPIRIT PTY LTD ATF THE HUNGRY SPIRIT TRUST  Appellant | |
| AND: | FIT N FAST AUSTRALIA PTY LTD  Respondent | |

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| JUDGE: | BURLEY J |
| DATE OF ORDER: | 9 August 2019 |

THE COURT ORDERS THAT:

1. The appeal from the decision of the delegate of the Registrar of Trade Marks given on 13 June 2019 be allowed.
2. The decision of the delegate be set aside.
3. The Registrar allow Australian Trade Mark Application numbers 1813479 and 1813480 to proceed to registration.
4. The Registrar have leave to apply to the Court to set aside or vary Orders 1 to 3 within 14 days.
5. There be no order as to costs.
6. The appellant is directed to provide these Orders to the Registrar of Trade Marks forthwith.

Note: Entry of orders is dealt with in Rule 39.32 of the *Federal Court Rules 2011*.

REVISED FROM TRANSCRIPT

BURLEY J:

1. This is an appeal brought pursuant to s 56 of the *Trade Marks* ***Act*** *1995* (Cth) from a decision of the **delegate** of the **Registrar** of Trade Marks made on 13 June 2019. The appellant, Hungry Spirit Pty Limited, is the applicant for two trade marks, numbered 1813479 and 1813480, for “MOVE Training” and “MOVE Coaching” respectively, in classes 9, 16 and 41 of the Trade Mark Register. The applications were accepted by the Registrar and advertised in the Australian Official Journal of Trade Marks, and subsequently opposed by **Fit n Fast** Australia Pty Ltd, the respondent to the present proceedings. After evidence was filed, the delegate conducted a hearing and subsequently determined that the opposition should succeed, and the trade mark applications were refused.
2. Hungry Spirit then filed a Notice of Appeal from the decision pursuant to s 56 of the Act. Fit n Fast filed a submitting appearance, thereby signifying that it would submit to any order that the Court may make and otherwise not participate in the conduct of the appeal, other than in relation to the question of costs. The consequence is that the opponent will not be filing any evidence in support of its opposition to the registration of the trade mark. Furthermore, the Registrar, having been informed that Fit n Fast does not intend to participate in the proceedings, has indicated that she also does not wish or intend to participate in the conduct of the proceedings either. To that should be added one caveat. In correspondence, Hungry Spirit has indicated to the Registrar that it will seek orders that the appeal be allowed at the first return date of the proceedings. The Registrar responded that should draft consent orders be arrived at, particularly if they go to allowing the appeal, she requests to be made aware of the orders before they are made official. Hungry Spirit has at the first case management hearing of the proceedings submitted that the appeal should be allowed, the opposition dismissed, and the decision of the delegate set aside. For the reasons set out below, subject to slight variation, I consider that these are the appropriate orders to be made.
3. The relevant approach in circumstances such as the present has been considered in a number of decisions in this Court, including *Cadbury Schweppes Plc v Effem Foods Pty Ltd* [2006] FCA 1267; 69 IPR 584 (Lindgren J), *Suyen Corporation* v *Americana International Limited* [2011] FCA 300 (Dodds-Streeton J), *Raytheon Company v Lockheed Martin Corporation* [2014] FCA 1063 (Perram J) and *Daiichi Sankyo Company, Limited v Alethia Biotherapuetics Inc.* [2016] FCA 1540 (Burley J). In this regard, the position in relation to oppositions brought pursuant to the *Patents Act* *1990* (Cth) is analogous to the position under the present Act. An appeal brought pursuant to s 56 of the Act is considered *de novo* by this Court as the first judicial determination of the controversy. The opponent, as the party propounding the ineligibility of the trade mark for registration, is the effective moving party in the proceedings. It bears the onus of establishing any nominated grounds of opposition advanced, both before the delegate and on appeal: *Food Channel Network Pty Ltd v Television Food Network GP* [2010] FCAFC 58; 185 FCR 1 at [32] (Keane, Stone and Jagot JJ).
4. Section 68 of the Act provides:

(1) The Registrar must, within the period provided under the regulations, register a trade mark that has been accepted for registration:

(a) if there has been no opposition to the registration; or

(b) in a case where there has been an opposition:

(i) if the Registrar’s decision, or (in the case of an appeal against the Registrar’s decision) the decision on appeal, is that the trade mark should be registered; or

(ii) if the opposition has been withdrawn; or

(iii) if the opposition has been dismissed under section 222 or the regulations (if any) made for the purposes of subsection 54(2).

Otherwise, the application for the registration of the trade mark lapses.

Note: Applications may also lapse if an application for registration is opposed and a notice to defend the application is not filed: see section 54A.

(2) On registering the trade mark, the Registrar must give it a number by which it may be identified.

1. The trade mark applications the subject of the present appeal were accepted for registration. They would have proceeded to registration were it not for the opposition lodged by the respondent. In circumstances where the opponent plays no role in the appeal, absent the indication that the Registrar wishes to intervene to oppose the grant of the trade mark, the likely outcome will be the appeal should be allowed.
2. In this regard, adopting the approach taken by Nicholas J in *Societe Des Produits Nestle S.A. v Aldi Stores (A Limited Partnership)* [2010] FCA 218 at [9], I consider that it is not self-evident that the mark the subject of the appeal should not be registered. In this regard, I have been taken carefully through the decision of the delegate by Mr David Larish, counsel appearing for the applicant. Nor is there any evidence before the court which would lead me to the conclusion that it should not be registered.
3. In the result, the orders that I will make are as follows:
4. The appeal from the decision of the delegate of the Registrar of Trade Marks given on 13 June 2019 be allowed;
5. The decision of the delegate be set aside;
6. The Registrar allow Australian Trade Mark Application numbers 1813479 and 1813480 to proceed to registration;
7. There be no order as to costs.
8. However, I consider it appropriate, having regard to the Registrar’s letter, to allow her a short period in which to contact the Court and indicate, if she thinks it fit to do so, that she wish to make submissions as to the form of the orders. Accordingly, I will also grant leave to the Registrar to apply to vary or set aside these orders within 14 days.

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| I certify that the preceding eight (8) numbered paragraphs are a true copy of the Reasons for Judgment herein of the Honourable Justice Burley. |

Associate:

Dated: 14 August 2019