

IN THE HIGH COURT OF AUSTRALIA
SYDNEY REGISTRY

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No S202 of 201~~3~~4

10 ON APPEAL FROM THE FULL COURT OF THE FEDERAL COURT OF
AUSTRALIA

BETWEEN:

CANTARELLA BROS LIMITED

ACN 000 095 607

Appellant

and



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MODENA TRADING PTY LIMITED

ACN 140 018 015

Respondent

RESPONDENT'S SUBMISSIONS

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Part I: Suitable for Publication

- 10 1. The respondent certifies that this submission is in a form suitable for publication on the internet.

Part II: Statement of Issues

2. The test for answering the statutory enquiry as to whether a trade mark is inherently adapted to distinguish the designated goods from those of other traders within the meaning of ss 41(2) and (3) of *Trade Marks Act 1995* (Cth) (*Act*).

Part III: Section 78B of the Judiciary Act 1903

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3. The Respondent certifies that it has considered whether any notice should be given in compliance with s 78B of the *Judiciary Act 1903*, and, in its view, such notice is not required.

Part IV: Factual issues in contention (cf AS [6]-[23])

4. The respondent contests the appellant's narrative of facts in Part V of their submissions (AS) in the following respects.
5. Contrary to the suggestions in, for example, AS [13] and [43], the only factual finding challenged in the full court was the trial judge's finding that the marks were distinctive for the purposes of s 41(3) of the Act.
- 30 6. The trial judge found that ORO and CINQUE STELLE are Italian words meaning "gold" and "five stars", respectively, which signify the highest quality: TJ [83], [85], [89], [91]. These findings are contrary to AS [13]-[14].
7. The full court found that the appellant uses ORO and CINQUE STELLE to describe its highest quality blends: AJ [95]. The trial judge found that CINQUE STELLE is marketed, advertised, promoted and offered for sale as the respondent's premium coffee blend: TJ [49]. The appellant's ORO branded coffee is made entirely from arabica beans in circumstances where Australian coffee consumers consider that arabica beans are superior to robusta beans and coffee is regularly promoted in Australia as being made entirely from arabica beans: TJ [41] and [50].
- 40 8. The trial judge also found that there are *many* Italian speakers in Australia: TJ [114]-[116]. The full court found that in 2001 Italian was the second most utilised language in Australia after English in terms of the number of people who speak Italian at home: AJ [94]. The full court observed that this statistic does not take account of those people in Australia with some knowledge of Italian: AJ [94]. These findings are contrary to AS [43].

9. Further, the trial judge found that pure coffee in Australia is associated with Italy, with the result that it is obvious to use Italian words to describe the quality of a coffee blend. Australians drink predominantly instant coffee, however, there has been enormous growth in the pure coffee and café culture: TJ [39]. Increasing numbers of consumers order espresso or café-style coffee produced by espresso machines: TJ [39]. The Australian pure coffee market includes various imported coffee products that are roasted and packaged overseas and sold in Australia: TJ [42]. Various imported coffee products originate in Italy: TJ [43].
10. The full court found that ORO and CINQUE STELLE were known in the coffee trade as words descriptive of the quality of the coffee products and have been used in that sense for a significant period of time extending well before the appellant's registration of its marks and afterwards: AJ [97].
- 20 11. The full court's finding at AJ [97] is supported by the unchallenged findings of the trial judge as well as the evidence that was before the court at trial, the effect of which was recorded in a schedule that was before the full court and is reproduced as a schedule to these submissions. Contrary to AS [23], the analysis upon which this finding is based is set out in AJ [98]-[110].
- 30 12. The trial judge found that since July 1996 Caffè Molinari SpA (*Molinari*), which is based in Italy, has exported coffee products to Australia through various exclusive distribution agreements: TJ [67]; AJ [98]. Since 1965 Molinari has produced its CAFFÈ MOLINARI ORO, CAFFÈ MOLINARI ESPRESSO and CAFFÈ MOLINARI CLASSICO blends continuously: TJ [60]; AJ [98]. In 1997, Molinari introduced a new blend of coffee called CAFFÈ MOLINARI CINQUE STELLE as its premium blend: TJ [62]; AJ [98]. The respondent has been Molinari's exclusive distributor since November 2009: TJ [77]. Neither Molinari nor any of its distributors in the period from July 1996 to about November 2009 are parties to this proceeding, contrary to the suggestion in AS [19].
- 40 13. The trial judge found that ORO is frequently used in various places in Australia in relation to coffee products as an indication of coffee of the highest quality: TJ [92]-[99]; AJ [99]. In particular, a website for Lavazza coffee describes QUALITÀ ORO and LAVAZZA QUALITÀ ORO as "*the iconic product that made Lavazza famous worldwide*". It asserts that QUALITÀ ORO was the first product to be imported to Australia by the founders of Valcorp Fine Foods in 1955. See TJ [93]; AJ [99].
14. In addition to the CAFFÈ MOLINARI ORO product referred to in paragraph 12, the full court found that trade mark applications were filed for LAVAZZA QUALITA ORO and MEDAGLIA D'ORO in 1979 and 1996, respectively, well before the respondent filed its trade mark applications. See AJ [100]

15. The phrase Five Star is commonly used in business names in Australia: TJ [90]. There is the CAFFÈ MOLINARI CINQUE STELLE product referred to in paragraph 12, which was distributed in Australia before the respondent filed its trade mark application. CAFFÈ GUGLIELMO BAR 5 STELLE coffee is distributed in Australia by Gulli Food Distributors. SANTOS FIVE STAR ESPRESSO coffee is distributed in Australia by Santos Coffee Company Pty Limited. SANTOS MOCHA FIVE STAR ESPRESSO is also distributed in Australia by Santos Coffee Company Pty Limited. Coffee Works distributes online a blend of coffee called FIVE STAR. STELLAROSA FIVE STAR coffee is distributed in Australia at Stellarosa cafés, which operate from numerous locations in Queensland. CASINI SIX STAR coffee is distributed in Australia by Prestige Products online. FIVE STAR DAY coffee is distributed in Brisbane by a business trading as Cup Coffee. Information about those products is published on the internet on various websites. See TJ [100].
16. On the trial judge's findings, which the appellant did not challenge in the full court, the appellant's pre-filing use of ORO was non-existent and its pre-filing use of CINQUE STELLE inconsequential. The appellant filed its application for the ORO mark in March 2000 and its application for the CINQUE STELLE mark in June 2001. In mid 2000, the appellant began promoting for sale and selling to food service customers a "Special Bar Line" of products, which included VITTORIA ORO and VITTORIA CINQUE STELLE products. See TJ [110].
17. Until May 2003 when the appellant started selling VITTORIA ORO through supermarkets, sale of these products was confined to restaurants and similar establishments: TJ [51], [55]. Since VITTORIA CINQUE STELLE was launched, it has been sold to fine dining restaurants and esteemed foodservice establishments: TJ [51]. Similarly, the respondent generally sells CAFFE MOLINARI products to cafes, bars and restaurants in Australia: TJ [79].
18. Contrary to AS [15] and [21], in determining whether CINQUE STELLE and ORO were sufficiently inherently adapted to distinguish goods of the respondent from goods of other persons, the trial judge applied statements made by members of this Court in determining an entirely different statutory question of whether the trade mark is "*an invented word*", which existed under s 16(1)(c) of the *Trade Marks Act 1905-1936* (Cth). So much is clear from a comparison between TJ [26] and *Howard Auto-Cultivators Limited*. In so doing, the trial judge asked himself whether the Italian words were "*commonly understood*" or "*generally understood*" in Australia by "*ordinary English speaking persons*" as meaning five stars and gold respectively: TJ [107], [113], [117]-[118].
19. Contrary to the suggestion in AS [21], after considering each of the authorities in AJ [62]-[84], the full court held at AJ [84] that the expressions "*the common right of the public*" and "*common heritage*" employed by Kitto J in *Clark* are

fluid and their content will vary according to the particular case. The full court said at AJ [84] that the expressions refer to the knowledge base, primarily, of traders in the particular goods and services, but may extend to potential consumers.

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Part V: Applicable constitutional provisions, statutes and regulations

20. The respondent accepts the appellant's statement of applicable statutes.

Part VI: Respondent's argument

Introduction

21. In *The Registrar of Trade Marks v W & G Du Cros, Limited* [1913] AC 264 (*Du Cros*), in the context of assessing whether a mark was "adapted to distinguish" one trader's goods from those of another, Lord Parker stated:

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"... The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods."

22. In *Clark Equipment Company v The Registrar of Trade Marks* (1964) 111 CLR 511, Kitto J, who was sitting alone on an appeal from a determination of the Registrar for Trade Marks, recited that part of Lord Parker's speech, and went on to say:

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"... The interests of strangers and the public are thus bound up with the whole question, as Hamilton L.J. pointed out in the case of *R.J. Lea, Ltd* (1); but to say this is not to treat the question as depending on some vague notion of public policy: it is to insist that the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the signification which they ordinarily possess – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it."

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23. In this appeal, the appellant advances several arguments. The first two rely on what the appellant considers to be important differences between what Lord Parker said in *Du Cros* and what Kitto J said in *Clark Equipment*.

24. The appellant contends that, in order for a trader challenging registration to succeed, it is not sufficient for the trader to demonstrate that, at the time of registration, other traders would have wanted to use the same mark or a mark nearly resembling it in connexion with their goods. Instead, the appellant argues that it is, because of what Kitto J said in *Clark Equipment*, also

necessary for the trader to demonstrate that, at the time of registration, other traders would have wanted to use the relevant word:

- a. “for the sake of the signification which it ordinarily possesses”; and
 - 10 b. “in any manner which would infringe a registered trade mark granted in respect of it”.
25. The appellant asserts that the respondent has not demonstrated that, at the dates the appellant applied for registration of ORO and CINQUE STELLE, other traders would have wanted to use those words for “the signification which they ordinary possess”.
26. This argument is based on the following propositions:
- a. that what Lord Parker said in *Du Cros* is to be applied subject to what Kitto J said in *Clark Equipment*;
 - 20 b. that the parenthetical statement in Kitto J’s reasons in *Clark Equipment* is part of the test, not surplusage;
 - c. whether a word had a meaning or signification at the time of registration, and what that meaning or signification was, are questions which depend on whether the word was, at that time, commonly or generally understood by “the putative Australian buying public”, and, if so, what the word was then commonly or generally understood as meaning by “the putative Australian buying market”;
 - d. if the words were not generally or commonly understood by “the putative Australian buying public” at that time, it follows that, even if traders would have wanted to use those words, traders would not have wanted to use those words “for the sake of the signification which they ordinarily possess”; and
 - 30 e. the words ORO and CINQUE STELLE were not generally or commonly understood by “the putative Australian buying public” at the dates the appellant registered them.
27. The appellant’s *second* argument is that the respondent has not demonstrated that, at the dates the appellant applied for registration, other traders would have wanted to use the words ORO and CINQUE STELLE in a “manner which would infringe a registered trade mark granted in respect of it”.
- 40 28. Finally, borrowing the words of French J (as his Honour then was), the appellant asserts that the assessment of whether any given word is inherently adapted to distinguish one trader’s goods from another’s involves a “practical evaluative judgment about the effects of the relevant mark in the real word”, and that a practical evaluative judgment in this case would yield the conclusion that ORO and CINQUE STELLE were inherently adapted to distinguish the appellant’s goods from those of other traders.

29. In answer to the appellant's first argument, the respondent says:
- a. the *Du Cros* test has been adopted on numerous occasions by Full Courts of this Court (before and after *Clark Equipment*);
 - 10 b. since Kitto J was sitting alone in *Clark Equipment*, it would not be appropriate to read the Full Court judgments subject to *Clarke Equipment*;
 - c. the *Du Cros* test does not require a trader who challenges the registration of a word mark to establish that, at the time it was registered, other traders would have wanted to use the relevant word for the sake of the signification which it ordinarily possesses;
 - d. in any event, the parenthetical statement in the passage from Kitto J's reasons in *Clark Equipment* quoted above is explanatory surplusage;
 - e. even if that were not the case, it does not matter because:
 - 20 i. one would not assess whether a word had a meaning and what that meaning was at the time of registration by asking whether and, if so, how that word was commonly or generally understood by "the putative Australian buying public" at that time;
 - ii. in assessing whether or not a word had a meaning and, if so, what its ordinary meaning was, it is permissible to consider whether the word was understood by an appreciable proportion of persons in the relevant trade or potential consumers and, if so, as what;
 - 30 iii. the Full Court correctly concluded (at [9]) that the words CINQUE STELLE and ORO were "known in the coffee trade according to their ordinary signification as words descriptive of the quality of coffee products and had been used in that sense ... for a significant period of time, extending well before the appellant's registration of its marks and afterwards"; and
 - iv. further, and in any event, the Full Court correctly observed (at [88]) that, since Italian was, at the registration date, "the second most spoken language in Australia", many consumers would have known that ORO and CINQUE STELLE meant "gold" and "five stars" in English.
30. In relation to the appellant's *second* argument, the respondent says:
- 40 a. the *du Cros* test does not require a party challenging the registration of a mark to establish that, at the time it was registered, other traders would have wanted to use that mark in connection with their goods in way that would infringe the mark;
 - b. it is sufficient if other traders would want to use the mark in connection with their goods; and

c. in any event, it does not matter because the evidence demonstrates that, at the registration dates, other traders may have wanted to use the words ORO and CINQUE STELLE in a way that infringed the appellant's trade marks.

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31. The respondent acknowledges that the question of whether a particular word is inherently adapted to distinguish one trader's goods from those of another does involve a "practical evaluative judgment", but it says, for the reasons described below, that a practical evaluative assessment in this case would see this court conclude that ORO and CINQUE STELLE were not, at the registration dates, inherently adapted to distinguish the appellant's goods from those of other traders.

The meaning of "inherently adapted"

32. This case is to be decided by reference to the *Trade Marks Act 1995 (Cth) (Act)* as it stood on 24 March 2000 and 6 June 2001.

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33. Relevantly, section 41 of the Act then stated:

"(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

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(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

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(a) the Registrar is to consider whether, because of the combined effect of the following;

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances;

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the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant’s goods or services from the goods or services of other persons; and

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(c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant’s goods or services from the goods or services of other persons.

(6) If the Registrar finds that the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

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(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

(b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.”

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34. The appellant’s appeal does not rely on section 41(5) or (6) of the Act in support of an argument section 41(2) has been engaged. It relies on section 41(3). Its case rests on the proposition that the words ORO and CINQUE STELLE were, at the dates the appellant applied for registration, “inherently adapted to distinguish” the appellant’s products from those of other traders.

35. The words “adapted to distinguish” have formed part of the legislation governing the registrability of trade marks in England and Australia since 1905. They have been the subject of consideration on numerous occasions by this Court.

36. The logical starting point is *Du Cros*, which was decided in 1913 by reference to the 1905 Act in England. Section 9 of that Act stated that:

10 “A registrable trade mark must contain or consist of at least one of the following particulars:

- (a) The name of a company, individual, or firm represented in a special or particular manner;
- (b) The signature of the applicant for registration or some predecessor in his business;
- (c) An invented word or invented words;
- (d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname;
- (e) Any other distinctive mark ...”

20 37. The expression “distinctive” was defined in the Act to mean “adapted to distinguish the goods of the proprietor of the trade mark from those of other persons”.

38. The issue in *Du Cros* was whether marks used by cab proprietors consisting of the letters “W & G” were distinctive within the meaning of the 1905 Act. In the course of finding that the marks were not distinctive, Lord Parker said:

30 “The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, “I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons,” and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant’s chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.”

40 39. Lord Parker’s speech was adopted by full courts of this Court in *Thomson v B. Seppelt and Sons Limited* (1925) 37 CLR 305, *Mangrovite Belting Limited v J.C. Ludowici and Son Limited* (1938) 61 CLR 149, *Eclipse Sleep Products Incorporated v The Registrar of Trade Marks* (1965) 112 CLR 300 (a case which was, in turn, followed by a full court of this Court in *Samuel Taylor Pty Ltd v The Registrar of Trade Marks* (1959) 102 CLR 650).

40. Then one comes to *Clark Equipment*. That was a decision of Kitto J, sitting alone on an appeal from a determination of the Registrar of Trade Marks. At issue was whether a geographical name, "Michigan", was distinctive, and thus registrable, under s25 of the 1955 Act, in respect of, amongst other things, tractor shovels and front-end loaders.

41. Section 26(1) of the 1955 Act then stated:

(1) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connexion subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations, in relation to use subject to those conditions or limitations.

(2) In determining whether a trade mark is distinctive, regard may be had to the extent to which: (a) the trade mark is inherently adapted so to distinguish; and (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish.

42. In the course of finding that "Michigan" was not distinctive for the purposes of section 25 of the Act, Kitto J said:

"That ultimate question must not be misunderstood. It is not whether the mark will be adapted to distinguish the registered owner's goods if it be registered and other persons consequently find themselves precluded from using it. The question is whether the mark, considered quite apart from the effects of registration, is such that by its use the applicant is likely to attain his object of thereby distinguishing his goods from the goods of others. In *Registrar of Trade Marks v. W. & G. Du Cros Ltd.* (1913) AC 624, at pp 634, 635 Lord Parker of Waddington, having remarked upon the difficulty of finding the right criterion by which to determine whether a proposed mark is or is not "adapted to distinguish" the applicant's goods, defined the crucial question practically as I have stated it, and added two sentences which have often been quoted but to which it is well to return for an understanding of the problem in a case such as the present. His Lordship said: "The applicant's chance of success in this respect (i.e. in distinguishing his goods by means of the mark, apart from the effects of registration) must, I think, largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connexion with their own goods. It is apparent from the history of trade marks in this country that both the

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Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Acts a monopoly in what others may legitimately desire to use." The interests of strangers and of the public are thus bound up with the whole question, as Hamilton L.J. pointed out in the case of *R.J. Lea, Ltd.* (1913) 1 Ch 446, at p 463; (1913) 30 RPC 216, at p 227; but to say this is not to treat the question as depending upon some vague notion of public policy: it is to insist that the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives - in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess - will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it. (our emphasis)

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43. For convenience, we have highlighted the wording in Kitto J's reasons relied upon by the appellant. In our submission, Kitto J was not seeking to add new requirements to Lord Parker's test. The parenthetical text is simply explanatory surplusage. It seeks to explain the circumstances in which one might find a trader had been actuated by improper motives. It comes as no surprise that Kitto J would make reference to the "signification" which geographical names "ordinarily possess": from 1905 the legislation governing trade marks in England and Australia had included provisions specifically dealing with geographical names which made it clear that any such name was not registrable if used "according to its ordinary signification" or "ordinary meaning": see section 16(1)(d) of the 1905-1948 Act and section 24(1)(d) of the 1955 Act.

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44. The High Court next considered the meaning of the expression "inherently adapted to distinguish" in *F.H. Faulding and Co. Limited v Imperial Chemical Industries of Australia and New Zealand Limited* (1965) 112 CLR 537. Kitto J, with whom Barwick CJ and Windeyer J agreed, said that:

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"...the question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one which other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use upon or in connexion with their goods: *Registrar of Trade Marks v. W. & G. Du Cros Ltd.* (1913) AC 624, at pp 634, 635 ; *Eclipse Sleep Products Inc. v. The Registrar of Trade Marks* [1957] HCA 86; [1957] HCA 86; (1957) 99 CLR 300, at p 310 ; *Clark Equipment Co. v. Registrar of Trade Marks* [1964] HCA 55; (1964) 111 CLR 511."

- 10 45. In *Re Chancellor, Masters and Scholars of the University of Oxford T/A Oxford University Press v The Registrar of Trade Marks* (1990) 24 FCR 1, Gummow J held that “the effect” of the authorities pre-dating *Faulding* (as well as *Burger King*, considered below) had been accurately captured by that passage.
- 20 46. The final High Court case to consider *Burger King Corporation v The Registrar of Trade Marks* (1973) 128 CLR 417. That was a decision of Gibbs J, sitting alone on an appeal from a determination of the Registrar of Trade Marks. The case concerned whether the word “Whopper” was distinctive within the meaning of the 1955 Act. Gibbs J said referred to what Kitto J had said in *Clark Equipment*, before concluding that “[t]he word “whopper” is not inherently adapted to distinguish the goods of a particular trader, but is a word which a trader might, without any improper motive, want to use to describe his goods if they were of unusual size.”
- 30 47. The foregoing analysis demonstrates that:
- a. the Full Court of this Court has, on numerous occasions, before and after *Clark Equipment*, adopted the speech Lord Parker’s speech in *Du Cros* without qualification;
 - b. that part of Kitto J’s reasons upon which the appellant’s first two arguments in this appeal are based has never been adopted by a Full Court of this Court;
 - c. it is, therefore, inappropriate to read Lord Parker’s speech subject to what Kitto J said in *Clark Equipment*; and
 - d. in any event, properly characterised, the parenthetical text in Kitto J’s judgment is, no more than explanatory surplusage, intended to explicate the meaning of “improper motives” in Lord Parker’s test.

The appellant’s first argument: ordinary signification

- 40 48. The appellant contends that ORO and CINQUE STELLE are not inherently adapted to distinguish the appellant’s goods from those of other traders because the respondent has not shown that, at the dates the appellant applied for registration, other traders would have wanted to use the words ORO and CINQUE STELLE for the “sake of the signification they ordinarily possess”. That argument should be rejected because it is based on assumptions that:
- a. the parenthetical text in Kitto’s reasons in *Clark Equipment* are part of the test, and not surplusage; and
 - b. the decisions of the Full Court of this Court described above are to be read subject to a decision of a judge of this Court sitting alone.

- 10 49. In any event, the appellant's argument fails for several other reasons. At the heart of the appellant's argument is the assertion that, in finding that CINQUE STELLE and ORO were not generally understood by English-speaking Australians, the trial judge had concluded that "the words had no ordinary signification amongst the putative Australian buying public of the relevant goods" [AS 34]. The appellant also contends that the Full Court assessed the meaning of the words ORO and CINQUE STELLE by reference to how those terms were understood by traders, rather than "the relevant market", an approach said to be odds with *Clark Equipment* and inconsistent with *Mark Foy v Davies Coop & Co Ltd* (1965) 95 CLR 190 [AS 55].
50. The following points may be made about these contentions.
- 20 51. *First*, the trial judge did not turn his mind to what Kitto J had meant by the words "for the sake of the signification which they ordinarily possess" in *Clark Equipment*. Indeed, contrary to what is suggested in AS 15, in a judgment which runs for 202 paragraphs, the trial judge did not once refer to *Clark Equipment*. Instead, in his analysis of the applicable legal principles, conformably with the respondent's submissions in this appeal, at [28] the trial judge recited the *Du Cros* test as adopted by the full High Court in *Faulding*.
- 30 52. *Second*, the mere fact that a word may not be generally understood by traders or consumers does not mean that it does not have a signification (or an ordinary signification). As Chitty J observed in *Davis v Stribolt; In the Matter of Davis, Bergendahl & Co's Trade Marks* (1889) 6 RPC 207, "there are many good English words descriptive of articles which are unknown to the average Englishman". The word "eutectic", which means "of a nature to melt early", is an example (as to which, see *Eutectic Corporation v Register of Trade Marks* (1980) 32 ALR 211).
53. *Third*, in assessing what the ordinary meaning of a given word is at a given time, the law does not ask, as the trial judge did, "What is the word generally or commonly understood to mean by 'English-speaking persons in Australia'?", or, as the appellant asserts on this appeal, "What is the word generally or commonly understood to mean by the putative Australian buying public of the relevant goods?".
- 40 54. If it is necessary to examine the ordinary signification or meaning of a word before determining whether that word is inherently adapted to distinguish one trader's goods from those of another, then it is entirely appropriate to consider whether that word is understood by an appreciable proportion of traders in the relevant market; and, if so, how. In any given case, it may also be appropriate to consider whether the word is understood by an appreciable proportion of consumers; and, if so, how. But it is a nonsense to suggest, as the appellant does, that a word, which is understood by traders, has no ordinary meaning because the party opposing registration has not demonstrated the word was

generally understood by the many millions who constitute the “putative Australian buying public”.

55. As the Full Court observed at [85]:

10 “There is no necessity to approach the enquiry from an Anglocentric
perspective in the Australian context which has rich cultural and ethnic
diversities within its population. Adopting the language of Kitto J, to
accommodate this reality in the marketplace, one may consider the
relevant words against the collective diverse heritage. Viewed in that
way, the “common heritage” here included that of traders in coffee
products sourced from Italy. Such traders may well be Italian or local
importers. They may be local distributors who have in mind the large
Italian speaking population in Australia as well as other Australians
who, when it comes to coffee, want something with an Italian look and
20 feel. Much of this country’s coffee heritage in its language has its
provenance in the Italian language e.g. caffè latte; cappuccino;
affogato; caffè machiatto and espresso. It is evident that pure coffee in
Australia is often associated with Italy and Italian coffee products.”

56. If accepted, the appellant’s argument would allow traders in ethnic
communities to obtain, by registration under the Act, a monopoly in what
other traders in that community may legitimately desire to use because the
word is not commonly understood by the majority of English-speaking
Australians. Understandably, a different approach was taken by Heerey J in
Wong v Du (2006) 68 IPR 553. His Honour held at [9]-[11] that there was not
30 a serious question to be tried when the owner of a registered logo mark
comprising six Chinese characters meaning “Professional Driving School”
sought to enjoin another trader using another sign comprising nine Chinese
characters meaning “Melbourne Professional Driving School”.

57. *Fourth*, the Full Court did not hold that one must assess the ordinary meaning
of words by reference to how they are understood by traders in, rather than
consumers of, the relevant goods. The Full Court was at pains to do
otherwise. At [74], the Full Court observed that the “enquiry may also have
regard to the knowledge and practices of consumers as a relevant
consideration”. At [80], the Full Court observed that “an appreciation of the
40 words used, beyond the class of traders and extending to consumers of the
relevant goods and services, may also inform the answer to the inquiry”. At
[84], the Full Court observed that the enquiry “may extend to potential
consumers”.

58. *Fifth*, as the Full Court pointed out at [97], “[t]he findings of the primary judge
support a conclusion that these Italian words were known in the coffee trade
according to their ordinary signification as words descriptive of the quality of
the coffee products and have been used in that sense ... for a significant period
of time extending well before the appellant’s registration of its marks and

afterwards”. *However*, as the Full Court observed at [88], as Italian was “the second most spoken language in Australia”, it is self-evident that many consumers in this country would have known what the words meant in English.

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59. *Sixth*, The appellant relies heavily on the reasoning of Dixon CJ in *Mark Foy's* (see AS [2], [15], [30] and [55]). However, that was not a case dealing with the issue of inherent adaptability to distinguish. The only issue in that case was whether the words were disqualified from being a registrable trade mark under s 16(1)(d) of the 1905-1948 Act because they directly referred to the character or quality of the goods. The reference by Dixon CJ at p 195 to “the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature of some attribute they possess” was concerned with the construction of s 16(1)(d) of the 1905-1948 Act, and particularly with the introduction of the word “direct” into that provision.

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The appellant’s second argument: “...which would infringe a registered trade mark ...”

60. The appellant’s second argument is that a mark will not be inherently adapted to distinguish unless the court is satisfied that it is likely that traders would have, at the registration date, desired to use the word “in a manner which would infringe a registered trade mark in respect of it”. The appellant says [AS 49] that, contrary to this supposed requirement, the Full Court found that none of the many examples the respondent gave of other traders using the words ORO or CINQUE STELLE (or variants thereof) in connection with their coffee products, constituted trade mark uses.

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61. Again, there are fundamental problems with the appellant’s argument.

62. *First*, it is based on the proposition that the decisions of this Court adopting Lord Parker’s test in *Du Cros* ought to be read down by Kitto J’s observations in *Clark Equipment*.

63. *Second*, if it be the case that other traders have not used descriptive words as marks, it does not follow that they would not wish to. An opponent does not need to prove that another trader has, in fact, used the relevant mark in order to make out its opposition.

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64. Moreover, in *Oxford* at 18 to 19 Gummow J made it clear that, on the question of whether a mark is inherently adapted to distinguish, the statute is looking forward to the consequences of a grant of registration, with the result that the question is not to be determined solely by having regard to the past user of the trade mark.

65. As Kitto J went on to explain in *Clark Equipment*, “the more apt a word is to describe the goods, the less inherently apt it is to distinguish them as the goods

of a particular manufacturer”. Moreover, as the Full Court observed at [97], the fact that other traders may have used the word in the past, albeit not as a trade mark, is “relevant to the enquiry as to whether other traders, prospectively, might wish to use the words in question”.

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66. As the trial judge found, the respondent was able to demonstrate that numerous other traders had, prior to the trial, used the words ORO or CINQUE STELLE (or variants thereof) as names of their coffee products. The list was long: *Lavazza Qualita Oro*; *Caffe Incas Oro*; *Coffee Mio Brazil Oro*; *Coffee Mio Mio D’Oro*; *Caffe Trombetta Oro*; *Caffe Mauro Oro*; *Café El Mundo Oro*; *La Zumba Oro*; *Costa D’Oro*; *Prima Caffe Tazza D’Oro*; *Caffe Aurora Medaglia D’Oro*; *Delta Chicco D’Oro*; *Piazza D’Oro*; *El Premio D’Oro*; *Miscela D’Oro*; *Mokador Oro*; *Café Carmado Espresso Oro*; *Goccia D’Oro*; *Caffe Guglielmo Espresso Oro*; *Caffe Molinari Oro*; *Caffe Guglielmo Bar 5 Stelle*; *Caffe Molinari Cinque Stelle*.

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67. If it be correct that, except in the case of the respondent, none of these manufacturers were using the words ORO or CINQUE STELLE as marks, the sheer weight of usage militates very strongly in favour of the argument that other traders might wish to use those words as marks.

68. The appellant’s second argument would also lead to the anomaly that it is not an infringing use if the mark is used descriptively (see s 122(1)(b)), but descriptiveness should point away from, not towards, registrability.

“practical evaluative judgment”

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69. At AS 46, borrowing the words of French J (as he then was in *Kenman Kandy Australia Pty Limited v Registrar of Trade Marks* (2002) 122 FCR 494), the appellant submits that as a “practical evaluative judgment about the effects of the relevant mark in the real world”, the marks had an inherent capacity to distinguish.

70. That argument is said to be based on:

- a. “the absence of any ordinary English meaning of the relevant words”;
- b. “the fact that they are to be used in the Australian market”;
- c. “the speculative nature of any assessment of the likelihood of translation by a few as opposed to simply seeing the words as marks”; and
- d. “the fact that even if translated the words are metaphorical in any event”.

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71. The following points may be made about that submission.

72. *First*, as we say above, the appellant’s contention that the words ORO and CINQUE STELLE do not have an ordinary English signification is based on a

misunderstanding as to how one would go about assessing whether a word has a meaning; and, if so, what it is.

73. *Second*, the Australian market is comprised of traders and consumers. The Full Court rightly concluded that traders understood the ordinary meaning of ORO and CINQUE STELLE, and that an appreciable proportion of consumers would have.
74. *Third*, as the Full Court observed at [85], there is “no necessity to approach the enquiry from an Anglocentric perspective” and “it is unnecessary ... that consumers know what the words mean in English”.
75. *Fourth*, if the words are metaphorical, they are not difficult to understand. The trial judge was disposed to conclude that the English translation of the words (“gold” and “five stars”) would not be distinctive and, therefore, could not have been registered by the appellant in 2000 and 2001 (TJ [111]).
76. Finally, if doubt remains as to the registrability of a mark, the application should be refused: *Oxford* at 7 (Lockhart J), 21 and 25 (Gummow J), citing *Eclipse Sleep* (1957) 99 CLR 300 at 314.

Policy considerations

77. The appellant contends at AS 45-47 that the approach it advocates would be consistent with “international practice in at least the United States and the European Union”.
78. The appellant has misquoted the European Manual. Contrary to the final sentence of AS [47], the Manual treats the relevant parties as “the relevant trade in the UK **or** ... the relevant average UK customer” (our emphasis). Moreover, it goes on to explain, consistently with the approach adopted by the Full Federal Court:
- “The relevant trade in the UK consists of those in the UK who trade in the goods or services in question. A pharmacist may recognise the descriptive meaning of a Latin name even though an average consumer of pharmaceuticals may not. Similarly, a trader in wines is likely to have a better understanding of French wine than the average end consumer of those goods. Further, traders in computing goods and services are likely to be more aware of the names used elsewhere to designate characteristics of new products, even if the product is not yet available on the UK market.”
79. The appellant does not mention the *Guidelines For Examination in the Office of Harmonization in the Internal Market (Trade Marks and Designs)*, relating to community trade marks in EU, part 2.3.1.2 of which states that a sign “must be refused if it is descriptive in any of the official languages of the European Union”; and also that a sign “must also be refused if it is in a language which

has official status in a member state, although that language is not an official language of the European Union”.

- 10 80. There are, of course, important issues of trade policy in play here. If Australia allows traders to monopolise the right to use descriptive words in foreign languages as marks, there is risk of dis-incentivising the importation of foreign-made goods for sale in Australia. Equally, there is a risk of reprisal by foreign countries. Moreover, there is a risk that Australian traders will be disadvantaged relative to international traders. Australian traders would not be able to use the foreign descriptive words as marks, but traders based overseas, who sell direct to Australian consumers over the internet, would have no such restriction.

Non use

- 20 81. The appellant failed to challenge the trial judge's finding that it uses CINQUE STELLE and ORO almost invariably in conjunction with its trade mark VITTORIA: TJ [129]. The appellant describes VITTORIA, AURORA, DELTA and CHICCO D'ORO as house marks, while ORO and CINQUE STELLE are used on, and in relation to, specific blends of coffee: TJ [45]. The Full Court found that the appellant uses ORO and CINQUE STELLE to describe its highest quality blends: AJ [95].
- 30 82. The Full Court rightly found that, given the lack of distinctiveness of ORO and CINQUE STELLE alone, it is only with the addition of the word VITTORIA that the respondent is able to distinguish its goods from those of other traders.
83. In these circumstances, the Full Court rightly found that the appellant had failed to establish that it has used ORO and CINQUE STELLE as trade marks, with the result that both trade marks should be removed under s 92 of the Act.

Conclusion

84. For the foregoing reasons, the appeal should be dismissed with costs.

Part VII: Authorities, legislation or other material

- 40 1. *Burger King Corporation v Registrar of Trade Marks* [1973] HCA 15; (1973) 128 CLR 417 (*Burger King*) at 421-6
2. *Chancellor, Masters and Scholars of the University of Oxford (trading as Oxford University Press) v Registrar of Trade Marks* (1990) 24 FCR 1 (*Oxford*) at 14, 17-19, 23
3. *Clark Equipment Company v Registrar of Trade Marks* [1964] HCA 55; (1964) 111 CLR 511 (*Clark*) at 513-7

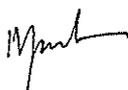
4. *Davis v Stribolt; In the Matter of Davis, Bergendahl & Co's Trade Marks* (1889) 6 RPC 207 (**Davis v Stribolt**) at 212.47-49
- 10 5. *Eclipse Sleep Products Incorporated v Registrar of Trade Marks* [1957] HCA 86; (1957) 99 CLR 300 (**Eclipse**) at 310-13
6. *Eutectic Corporation v Register of Trade Marks* (1980) 32 ALR 211(**Eutectic**)
7. *F.H. Faulding & Co Limited v Imperial Chemical Industries of Australia and New Zealand Limited* [1965] HCA 72; (1964) 112 CLR 537 (**Faulding**) at 555
8. *Howard Auto-Cultivators Limited v Webb Industries Pty Limited* [1946] HCA 15; (1946) 72 CLR 175 (**Howard Auto-Cultivators**) at 181-3
9. *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* [2002] FCAFC 273; (2002) 122 FCR 494 (**Kenman Kandy**) at [47]
10. *Mark Foys Ltd v Davies Coop & Co Ltd* (1956) 95 CLR 190 (**Mark Foys**) at 194, 195
- 20 11. *Registrar of Trade Marks v W & G Du Cros Ltd* [1913] AC 624 (**Du Cros**) at 635
12. *T.G.I. Friday's Australia Pty Ltd v TGI Friday's Inc* [2000] FCA 720; (2000) 100 FCR 358 (**TGI Friday's**) at [45]-[48]
13. *Wellness Pty Ltd v Pro Bio Living Waters Pty Ltd* (2004) 61 IPR 242 (**Wellness**) at [2]-[28]
14. *Wong v Du* (2006) 68 IPR 553 (**Wong v Du**) at [9]-[11]
15. *Trade Marks Act 1995* (Cth), ss 17, 41, 88 and 92 (compilation prepared on 5 December 1999, incorporating amendments up to Act No. 146 of 1999)
16. *Trade Marks Act 1905-1936* (Cth) ss16(1)(c) and 16(1)(d).
- 30 17. *Trade Marks Act 1955* (Cth) ss 24, 25 and 26

Part VIII: Oral argument

1. The Respondent estimates that approximately 2 hours will be required for its presentation of its oral argument.

Dated: 13 May 2014

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Counsel for the Respondent

SCHEDULE: EXAMPLES IN THE EVIDENCE OF COFFEE TRADERS USING "ORO", "CINQUE STELLE" AND "5 STAR" (INCL. VARIATIONS) IN AUSTRALIA

Oro

	Trader	Coffee Brand	Words Used	Dates in Evidence	Evidence References	High Court appeal book reference
1	Luigi Lavazza S.p.A (Valcorp Fine Food)	Lavazza	Lavazza Qualita Oro	<ul style="list-style-type: none"> TM application filed 4 December 1979 Advertised 8 June 2009 Purchased 29 March 2011 	<ul style="list-style-type: none"> Doyle, Ex BCD1, p 59 (TM registration for coffee) Abrahams, Ex DBA1, p139A Page 1, [3]-[10], Ex CJP 2 and CJP 3 	<ul style="list-style-type: none"> 291 129 317 [3]-[10], 393-396, 397-400
2	Various, incl. appellant	Caffè Molinari	Oro	July 1996 to June 2011 (changed to "Qualita Oro")	Molinari, [27]-[32]	<ul style="list-style-type: none"> 505 [27-32]
3	Respondent (Cosmos Foods)	Caffè Aurora (since at least 28 February 2001)	Medaglia D'Oro	<ul style="list-style-type: none"> TM application filed 19 August 1996 Advertised 28 February 2001, 23 May 2003, 2005, March 2009 Purchased March 2011 	<ul style="list-style-type: none"> Doyle, Ex BCD1, p 57 (TM registration for coffee) Abrahams, Ex DBA1, pp 29, 64, 100, 150, 137, 138 Page 1, [50]-[58], Ex CJP 15 to 20 	<ul style="list-style-type: none"> 289 96, 119, 121, 131, 123, 124 317 [50]-[58], 445-448, 449-452, 457-460, 461-464, 465-469
4	Respondent (Cosmos Foods)	Delta (since at least 29 March 2011)	Chicco D'Oro	<ul style="list-style-type: none"> TM application filed 7 May 1998 Purchased by Mr Chris Page 1 on 29 March 2011 	<ul style="list-style-type: none"> Doyle, Ex BCD1, p 58 (TM registration for coffee) Page 1, [60]-[63] Ex CJP 21 	<ul style="list-style-type: none"> 290 317 [60]-[63], 469-472
5	Respondent	Vittoria	Oro			
6	Coreco (Aust)		Stella D'Oro	TM application filed 20 November 2002	Doyle, Ex BCD1, p 7 (TM registration for coffee)	<ul style="list-style-type: none"> 239
7	Sara Lee		L'Oro	TM application filed 27 August 2010	Doyle, Ex BCD1, p 62 (TM registration for coffee)	<ul style="list-style-type: none"> 294
8	Sara Lee	Piazza D'oro	Piazza D'Oro	Purchased 26 March 2011	<ul style="list-style-type: none"> Page 1, [64]-[69] Ex CJP 22 Doyle, Ex BCD1, p 18, 21, 22 and 29 (undated TM registrations for coffee) 	<ul style="list-style-type: none"> 317 [64]-[69], 473-476 250, 253, 254, 261 (undated TM registration for coffee)
9	Sara Lee		Espresso di Manfredi Piazza D'Oro	Purchased 30 March 2011	Page 1, [64]-[69] Ex CJP 23	<ul style="list-style-type: none"> 317 [64]-[69], 477-480
10	Sara Lee		L'Oro Espresso	Exhibited to affidavit dated 27 May 2011	Doyle, Ex BCD1, p 29 (undated TM application for coffee)	<ul style="list-style-type: none"> 261 (undated TM application for coffee)
11	Sara Lee		Tazza D'Oro	Exhibited to affidavit dated 27 May 2011	Doyle, Ex BCD1, p 38 (undated TM application for coffee)	<ul style="list-style-type: none"> 270 (undated TM application for coffee)
12	Various distributors	Crema D'Oro	Crema D'Oro	Purchased 28 March 2011	<ul style="list-style-type: none"> Page 1, [43]-[46], Ex CJP 13 Doyle, Ex BCD1, p22 (undated TM registration for coffee) 	<ul style="list-style-type: none"> 317 [43]-[46], 437-440 254 (undated TM registration for coffee)
13	Casa Italia	Incas Caffè	Oro	<ul style="list-style-type: none"> Purchased 30 March 2011 Website checked 17 September 2012, product renamed "Gold Blend" 	<ul style="list-style-type: none"> Page 1, [11]-[14], Ex CJP 4 Gerakiteys, [3] 	<ul style="list-style-type: none"> 317 [11]-[14], 401-404 296 [3]
14	Coffee Mio	Coffee Mio	Brazil Oro	Purchased 28 March 2011	Page 1, [15]-[19], Ex CJP 5	<ul style="list-style-type: none"> 317 [15]-[19], 405-408
15	Coffee Mio	Coffee Mio	Mio D'Oro	Purchased 28 March 2011	Page 1, [20]-[21], Ex CJP 6	<ul style="list-style-type: none"> 317 [20]-[21], 409-412
16	Caffè Trombetta	Caffè Trombetta	Oro	<ul style="list-style-type: none"> Purchased 12 April 2011 Website checked 17 September 2012, and product renamed "Gold" 	<ul style="list-style-type: none"> Page 1, [23]-[26], Ex CJP 7 and 8 Gerakiteys, [4] 	<ul style="list-style-type: none"> 317 [23]-[26], 413-416, 417-420 296 [4]
17	Caffè D'Italia	Caffè Mauro	Oro	Purchased 28 March 2011	Page 1, [27]-[30], Ex CJP 9	<ul style="list-style-type: none"> 317 [27]-[30], 424-424
18	Crown Coffee	Cafè "El Mundo"	Moka Oro	Purchased 28 March 2011	Page 1, [31]-[34], Ex CJP 10	<ul style="list-style-type: none"> 317 [31]-[34], 425-428
19	Global Coffee	Lá Zumba	Zumba Oro	Purchased 28 March 2011	Page 1, [35]-[38], Ex CJP 11	<ul style="list-style-type: none"> 317 [35]-[38], 429-432
20	Boswell Trust	Coffee Lovers	Costa D'Oro	Purchased 28 March 2011	Page 1, [39]-[42], Ex CJP 12	<ul style="list-style-type: none"> 317 [39]-[42], 433-436
21	JB Distributors	Prima Caffè	Tazza D'Oro	<ul style="list-style-type: none"> Purchased 31 March 2011 Website checked on 17 September 2012, and no longer available 	<ul style="list-style-type: none"> Page 1, [47]-[49], Ex CJP 14 Gerakiteys, [5] 	<ul style="list-style-type: none"> 317 [47]-[49], 441-444 296 [5]
22	Espresso Essential	Espresso Essential	El Premio D'Oro	Web snapshot 28 April 2011	Page 1, [70]	<ul style="list-style-type: none"> 317 [70]
23	Cadonite (Miscela D'Oro S.P.A)	Miscela D'Oro	Miscela D'Oro	Web snapshot 28 April 2011	<ul style="list-style-type: none"> Page 1, [71]-[75] Doyle, Ex BCD1, p 27 (undated TM registration for coffee) 	<ul style="list-style-type: none"> 317 [71]-[75] 259 (undated TM registration for coffee)
24	Mokador Direct	Mokador	Oro	<ul style="list-style-type: none"> Purchased 28 April 2011 Website checked on 17 September 2012, product renamed "Mokador Ora" 	<ul style="list-style-type: none"> Page 1, [76]-[77], Ex CJP 24 Gerakiteys, [6] 	<ul style="list-style-type: none"> 317 [76]-[77], 481-484 296 [6]
25	BasileImports	Caffè Carmado	Espresso Oro	Snapshot 28 April 2011	Page 1, [78]-[80]	<ul style="list-style-type: none"> 317 [78]-[80]
26	Arte Antica International	Caffè Per Bar	Goccia D'Oro	Snapshot 28 April 2011	Page 1, [81]	<ul style="list-style-type: none"> 317 [81]
27	Gulli Food Distributors	Caffè Guglielmo	Espresso Oro	24 May 2011 affidavit	Page 1, [82]	<ul style="list-style-type: none"> 317 [82]
28	Various distributors	Allegro Caffè	Oro	From at least June to October 2010	Abrahams, [81], Ex DBA-1, pp 404-423	<ul style="list-style-type: none"> 40 [81], 167-188
29	Conga Foods		Aquila D'Oro	Exhibited to affidavit dated 27 May 2011	Doyle, Ex BCD1, p 17 (undated TM registration for coffee)	<ul style="list-style-type: none"> 249 (undated TM registration for coffee)
30	PFD Food Services		D'Oro	Exhibited to affidavit dated 27 May 2011	Doyle, Ex BCD1, p 29 (undated TM application for coffee)	<ul style="list-style-type: none"> 261 (undated TM registration for coffee)

Cinque Stelle and 5 Star (including variations)

	Trader	Brand	Words Used	Dates in Evidence	Evidence References	High Court appeal book reference
1	Various, incl appellant	Caffè Molinari	Cinque Stelle	From October 1998	<i>Molinari</i> , [27]-[32], Ex GM-1, tab 32, invoice 14 October 1998	• 505 [27]-[32], 537
2	Applicant	Vittoria	Cinque Stelle			
3	Gulli Food	Caffè Guglielmo	Bar 5 Stelle	Purchased 3 May 2011	<i>Pagent 1</i> , [83]-[84], Ex CJP 25	• 317 [83]-[84]
4	Santos Coffee Company	Santos	Five Star Espresso	Purchased 29 April 2011	<i>Pagent 1</i> , [85]-[87], Ex CJP 27	• 317 [85]-[87], 489-492
5		Santos	Mocha Five Star Espresso	Purchased 29 April 2011	<i>Pagent 1</i> , [88]-[90], Ex CJP 28	• 317 [88]-[90], 493-496
6	Coffee Works	Coffee Works	Five Star	Purchased 29 April 2011	<i>Pagent 1</i> , [91]-[92], Ex CJP 29	• 317 [91]-[92], 497-500
7	Stellarosa	Stellarossa	5 Star	Snapshot 29 April 2011	<i>Pagent 1</i> , [93]-[94]	• 317 [93]-[94]
8	Stellarosa	Stellarosa	6 Star	Snapshot 29 April 2011	<i>Pagent 1</i> , [93]-[94]	• 317 [93]-[94]
9	Prestige Products	Casini	Six Star	Purchased 27 March 2011	<i>Pagent 1</i> , [95]-[97] Ex CJP 30	• 317 [95]-[97], 501-504
10	Cup Coffee	Cup	Five Star Day	Snapshot 1 May 2011	<i>Pagent 1</i> , [98]-[100]	• 317 [98]-[100]
11	Brenda and Mark Robinson		Constellation Five Star	27 May 2011 affidavit	<i>Doyle</i> , Ex BCD1, p 6 (undated TM registration for coffee)	• 238 (undated TM registration for coffee)