



Friday, 29 March 2024

## **Weekly Intellectual Property Law** **A Weekly Bulletin listing Decisions** **of Superior Courts of Australia covering Intellectual Property** **Law**

### Search Engine

[Click here](#) to access our search engine facility to search legal issues, case names, courts and judges. Simply type in a keyword or phrase and all relevant cases that we have reported in Benchmark since its inception in June 2007 will be available with links to each case.

### Executive Summary (One Minute Read)

**Societe Civile et Agricole du Vieux Chateau Certan v Kreglinger (Australia) Pty Ltd (FCA)**  
- cheaper Tasmanian wine producer had not engaged in misleading or deceptive conduct or the tort of passing off due to similarities with particular expensive French wine, and its trade mark also should not be cancelled

## HABEAS CANEM

The scent on the breeze





## Summaries With Link (Five Minute Read)

### **Societe Civile et Agricole du Vieux Chateau Certan v Kreglinger (Australia) Pty Ltd [2024] FCA 248**

Federal Court of Australia

Beach J

Misleading and deceptive conduct, passing off, and trade marks - VCC owns a Bordeaux wine estate and produces two expensive French red wines involving various up-market grape types - the respondents produce wine in Tasmania, and sell a wine known as New Certan, a much cheaper pinot noir - VCC brought claims for contraventions of s18 and s29(1)(g) and (h) of the *Australian Consumer Law* and for passing off, and it sought the cancellation of the respondents' NEW CERTAIN trade mark - held: the use of an image of a stately house or château on a wine label is common, particularly amongst Bordeaux wines - the words "Grand Vin" ("great wine") and "Mis En Bouteille Au Château" ("bottled at the estate") are mere descriptors and are used on wines other than VCC's - even the use of a pink capsule in Bordeaux is not unique to VCC or its products - in assessing the existence of any reputation in the combination of the VCC features and VCC itself, it is relevant to have regard to the manner in which the VCC wines are sold in Australia - there was no evidence that VCC had ever promoted or sold either of the VCC wines under or by reference to Certan alone - there are other French wines which include Certan as part of their name - whether conduct has a tendency to lead a person into error is an objective question of fact to be determined on the basis of the conduct of the respondent as a whole viewed in the context of all relevant surrounding facts and circumstances - conduct which merely causes confusion or uncertainty in the sense that members of the public might have cause to wonder whether the two products might have come from the same source is not misleading and deceptive conduct - on the evidence, members of the fine wine trade being part of the relevant consumer class were likely to have been misled or deceived into thinking that the New Certan wine had some association with VCC - however, there was no evidence that VCC has suffered any loss or damage at all, and there was no basis to infer that it would - therefore, no damages should be awarded nor any injunction made - the lack of damage also meant that the tort of passing off had not been established - as to cancellation of the respondents' trade mark, the evidence did not establish that VCC had any sufficient reputation of the type relied upon by VCC, particularly when assessed against the target audience defined by the scope of the registration, which specifies all "alcoholic beverages including wines" across Australia, rather than any particular segment of that market - the claim for cancellation under s88(1) and s88(2)(a) of the *Trade Marks Act 1995* (Cth), when based upon s42(b), must fail, and claim under s60 must also fail - in any event, the Court would have exercised its discretion under s88(1) not to cancel or remove the mark.

[Societe Civile et Agricole du Vieux Chateau Certan](#)

[From Benchmark Tuesday, 26 March 2024]



## INTERNATIONAL LAW

### Executive Summary and (One Minute Read)

**Lifestyle Equities v Amazon UK Services Ltd (UKSC)** - In a cross-border sale of merchandise where the same trade mark was owned by different entities in USA and UK, Amazon was liable for trade mark infringement where UK customers were targeted by Amazon's US website

### Summaries With Link (Five Minute Read)

**Lifestyle Equities v Amazon UK Services Ltd [2024] UKSC 8,**

Supreme Court of the United Kingdom

Lord Hodge, Lord Briggs, Lord Hamblen, Lord Burrows, & Lord Kitchin

The trade mark at issue was the 'Beverly Hills Polo Club' brand. The holder of the mark in the EU/UK was Lifestyle Equities which is unrelated to the brand owner in the USA. A UK resident ordered US sourced goods bearing the trade mark through Amazon's US website. The owner of the EU trade mark contended that Amazon was liable for trade mark infringement because it targeted consumers in the UK/EU. This matter concerned conduct that occurred before Brexit. Applying EU law, the Supreme Court said that Amazon could only be liable for trade mark infringement in a cross-border sale if it in fact targeted consumers in the UK. The mere fact that a foreign website is accessible to a UK resident is insufficient to establish targeting of a UK consumer. The question for the court was whether an average consumer within the UK, who is reasonably well-informed and observant, would consider the website targeted at that consumer. The Court found that targeting had occurred because Amazon offered to deliver to the UK, in a dialog box Amazon specified which goods could be shipped to the UK, and specified UK delivery times and featured the option to pay in British currency. The Supreme Court also stated that Amazon's subjective intent was not the key issue. Rather, the question was one of objective fact taken from the perspective of the average consumer. Intent may, however, be taken into account to the extent it is relevant to the objective assessment made by the court.

[Lifestyle Equities](#)

## Poem for Friday

### The Nightingale

**By:** Sara Coleridge (1802-1852)

In April comes the Nightingale,  
That sings when day's departed;  
The poets call her Philomel,  
And vow she's broken-hearted.

To them her soft, sweet, ling'ring note  
Is like the sound of sorrow;  
But some aver, no need hath she  
The voice of grief to borrow.

No, 'tis the merry Nightingale,  
Her pipe is clear and thrilling;  
No anxious care, no keen regret,  
Her little breast is filling.

She grieves when boys have robb'd her nest,  
But so would Stork or Starling;  
What mother would not weep and cry  
To lose her precious darling?

[Click Here to access our Benchmark Search Engine](#)