

BERLEI HESTIA INDUSTRIES LTD V BALI CO INC [1973] 129 CLR 353

High Court of Australia – 17 October 1973

FACTS

Berlei was the registered proprietor of the trademark Berlei in respect of clothing. Bali had registered a trademark Bali-Bra and Berlei sought to have the trademark removed from the register.

The ground for the application to deregister the Bali-Bra trademark was that the trademark could cause confusion and was not distinctive. Berlei was pronounced “burley” while Bali was pronounced “Barley”.

ISSUE

Was it possible that the use of Bali name would cause customers to confuse it with the Berlie trademark?

FINDING

The phonetic similarity could confuse customers and the Court could rectify the trademarks register to remove the offending Bali trademark.

QUOTE

Mason J said:

“The strength of the appellant’s case is in the finding made by his Honour that the two marks are “poetically alike” – the appellant’s mark is commonly pronounced “burley” and the respondent’s mark is commonly pronounced “barley”. The respondent’s mark includes the expression “BRA” which is descriptive of the goods to which it is applied. Its inclusion in the mark does not detract from phonetic similarity between “Berlei” and “Bali”.

According to the appellant, so strong is the phonetic likeness that when the two marks are applied to the same class of goods there is every likelihood that confusion will arise in the minds of the public, if not on the part of those engaged in the relevant trade, as to the origin of the goods which the respondent’s mark denotes. The appellant relies also on evidence of actual confusion stemming from the circumstances already mentioned. It is convenient to deal with that case before turning to the evidence of actual confusion.”

“Although the goods sold under the two marks are distinguishable, the appellant’s brasseries being mass-produced and inexpensive, the respondent’s being a specialty line and expensive, the question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark.

The issue is whether that use would give rise to a real danger of confusion. If it be supposed that the respondent were to apply its mark to brassieres of the kind manufactured by the appellant it would be difficult, in my view, to resist the conclusion that there would be real danger of confusion.”

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IMPACT

A trademark can be infringed if a trading name or symbol used by another business could cause confusion for customers of the trademarks, product or service.

The confusion can be caused by phonetic or visual similarities.

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