

FEDERAL CIRCUIT COURT OF AUSTRALIA

AUSTBAR PTY LTD v ABA AUSTRALIAN BAR
ASSOCIATION LTD (No 2)

[2018] FCCA 2091

Catchwords:

TRADE MARKS – appeal from decision of Registrar of Trade Marks – respondent makes application under s.17A of *Federal Circuit Court of Australia Act 1999* (Cth) for summary dismissal of appeal based on the pleas of *res judicata*, issue estoppel and Anshun estoppel arising by virtue of the decision in the Federal Court of Australia in *Selth v Australasian Barrister Chambers Pty Ltd (No 3)* [2017] FCA 649 which determined that the applicant had no right, title or interest in the words comprising the trade marks the subject of the decision of the Registrar of Trade Marks appealed from – pleas of issue estoppel and Anshun estoppel made good – proceeding dismissed under s.17A.

Legislation:

Federal Circuit Court of Australia Act 1999 (Cth), s.17A
Trade Marks Act 1995 (Cth)

Cases cited:

Agar v Hyde (2000) 201 CLR 552
Arnold v National Westminster Bank plc [1991] 2 A.C. 93
Blair v Curran (1939) 62 CLR 464
General Steel Industries Inc v Commissioner for Railways (NSW) (1964) 112 CLR 125
Port of Melbourne Authority v Anshun Pty Ltd (1981) 147 CLR 589
Selth v Australasian Barrister Chambers Pty Ltd (No 3) [2017] FCA 649
Spencer v The Commonwealth of Australia (2010) 241 CLR 118
Tomlinson v Ramsey Food Processing Pty Limited (2015-16) 256 CLR 507
Zetta Jet Pte Ltd v The Ship "Dragon Pearl" (No 2) [2018] FCA 1130

Applicant:	AUSTBAR PTY LTD
Respondent:	ABA AUSTRALIAN BAR ASSOCIATION LTD
File Number:	SYG 1363 of 2017
Judgment of:	Judge Dowdy
Hearing date:	31 July 2018
Delivered at:	Sydney
Delivered on:	31 July 2018

REPRESENTATION

Counsel for the Applicant: Mr D. Minus of Counsel

Counsel for the Respondent: Mr W. Covell

Solicitors for the Respondent: Worthy of the Name

THE ORDERS OF THE COURT ARE AS FOLLOWS:

- (1) Order that the Notice of Appeal filed by the Applicant in this Court on 4 May 2017 be dismissed pursuant to s.17A of the *Federal Circuit Court of Australia Act 1999* (Cth).
- (2) Order that the Applicant pay the Respondent's costs of the proceeding.
- (3) Order pursuant to Rule 36.03(b) of the *Federal Court Rules 2011* (Cth) that the Applicant have up to and including 3 September 2018 to file any application for leave to appeal or appeal from orders 1 and 2 above in the Federal Court of Australia.

**FEDERAL CIRCUIT COURT
OF AUSTRALIA
AT SYDNEY**

SYG 1363 of 2017

AUSTBAR PTY LTD
Applicant

And

ABA AUSTRALIAN BAR ASSOCIATION LTD
Respondent

REASONS FOR JUDGMENT

**EX TEMPORE
(Revised from Transcript)**

1. This proceeding was commenced by a Notice of Appeal (**Appeal**) filed on 4 May 2017, by which the Applicant appeals from a decision of the Registrar of Trade Marks of 6 April 2017 deciding to register two trade marks and not accepting the Respondent's opposition to such registration, the trade marks being *Austbar* and *Aust Bar*, for which the Respondent had applied in around June 2013. I note that the trade marks have not actually yet been registered because of the pendency of the Appeal.
2. By *Application in a Case* filed on 28 September 2017, the Respondent seeks an order that the Appeal be summarily dismissed under s.17A of the *Federal Circuit Court of Australia Act 1999* (Cth) on the basis that the Applicant has no reasonable prospect of successfully prosecuting the Appeal. Under s.17A(3), the Appeal does not have to be shown to be hopeless or bound to fail, as it would have under the well-known test in *General Steel Industries Inc v Commissioner for Railways (NSW)* (1964) 112 CLR 125, for it to have no reasonable prospect of success. However, the High Court in a number of cases, including *Agar v Hyde* (2000) 201

CLR 552 and *Spencer v The Commonwealth of Australia* (2010) 241 CLR 118, has stated that a Court, when exercising a power such as is granted by s.17A, must not exercise it lightly but, in particular, ought to have regard to the *prima facie* right of a litigant to have full recourse to the procedures of the Court and to have the benefit of a full consideration of all of the relevant evidence and a reasoned judgment based on that evidence after a final hearing.

3. The Respondent relies upon the pleas of *res judicata*, issue estoppel and Anshun estoppel. The bases of the summary dismissal application brought by the Respondent are the orders made by Greenwood J in Federal Court proceeding NSD 975 of 2014 entitled *Selth v Australasian Barrister Chambers Pty Limited*, which were made by his Honour on 26 June 2017 (**the previous orders**) and his earlier Reasons for Judgment of 8 June 2017 (**Reasons for Judgment**) on which the previous orders were founded. The Reasons for Judgment are extensive and comprehensive, comprising some 360 paragraphs. I regard it is appropriate to reproduce below certain paragraphs of the Reasons for Judgment so as to set out the background for my determination of the *Application in a Case*, namely:

Selth v Australasian Barrister Chambers Pty Ltd (No 3) [2017] FCA 649

INTELLECTUAL PROPERTY — Consideration of an application by the Australian Bar Association in the form of the unincorporated association known as the Australian Bar Association and the company limited by guarantee called ABA Australian Bar Association Limited (“ABA Ltd) for declarations and injunctions in relation to the conduct of the respondents in registering the business name Australian Bar Association and the business name Australian Barristers Association — Consideration of contentions of infringement of registered trade marks now owned by ABA Ltd but formerly held by an individual on behalf of the ABA — Consideration of claims in relation to the use of the name “AustBar” in various configurations — Consideration of the use of domain names adopting austbar and austbaradr — Consideration of the use by the respondents in the proceedings commenced by the New South Wales Bar Association of the sign or mark “AustBar” — Consideration of the use of particular websites bearing particular domain names, in that context — Consideration of the accessorial liability of Mr Minus.

- [1] *These proceedings are concerned with two actions heard together. The first (NSD 975 of 2014) is a proceeding commenced by Mr Philip Selth in a representative capacity for the members of an unincorporated body (well-known amongst the relevant cohorts) described as The Australian Bar Association (the “ABA”). The inaugural general meeting of the ABA was held on 24 January 1963 at Theatre Royal, 29 Campbell Street, Hobart, Tasmania. It seems that the first draft of the Constitution for the ABA was prepared by the Hon Nigel Bowen QC and was settled at a meeting of representatives of the New South Wales Bar Association, the Victorian Bar Council and the Queensland Bar Association at the home of the Hon Nigel Bowen QC in Wahroonga in Sydney.*
- [2] *The ABA is said to consist of practising barristers who are members from time to time of the Australian Capital Territory Bar Association, the Bar Association of Queensland, the New South Wales Bar Association, the Northern Territory Bar Association, the South Australian Bar Association, the Tasmanian Independent Bar, the Victoria Bar Incorporated and the Western Australian Bar Association, and such other practising barristers who may from time to time be admitted to membership of the ABA according to the constitutional arrangements for that purpose.*
- [3] *A company limited by guarantee, ABA Australian Bar Association Limited (“ABA Ltd”) joined the proceeding as second applicant. That company was incorporated on 20 May 2015 for the purpose of assuming the role and function of the ABA. The origin of the ABA and the relationship between the ABA and ABA Ltd is described later in these reasons. It should be noted, however, that all references in these reasons to the “ABA” should be understood as a reference to the unincorporated body up to the point in time at which ABA Ltd assumed the role and function of the unincorporated body and thereafter a reference to ABA Ltd unless expressly otherwise indicated. Where a particular reference to the legal character of the earlier body is necessary, I describe it as “ABAU”.*

The respondents to the first proceeding

- [4] *The first respondent is Australasian Barrister Chambers Pty Ltd (in liq) (“Chambers”). A liquidator was appointed to Chambers on 8 December 2015. On 18 December 2015, the applicants were given leave to proceed against Chambers in liquidation.*
- [5] *The second respondent is Mr Derek Minus (“Mr Minus”). Mr Minus is a barrister. He was formerly a member of the New*

South Wales Bar Association and at the date of the trial was a member of the Victorian Bar Association. Until 1 October 2014, Mr Minus was the sole director of Chambers. He has been the Secretary of Chambers since its incorporation on 15 October 2008. Since 1 October 2014, the sole director of Chambers has been Ms Armine Minasian, the wife of Mr Minus. All of the issued 10 shares in Chambers have been held by ABCD Corporation Pty Ltd (“ABCD”) and the sole directors of, and shareholders in, ABCD are Mr Minus and Ms Minasian.

- [6] The third respondent is Dispute Resolution Associates Pty Ltd (“DRA”). It was incorporated on 9 December 1999. Mr Minus has been a director of that company since 9 December 1999 and its sole director since 19 July 2006. The 300 issued shares in DRA are held by Aplus Pty Ltd (“Aplus”). The directors of Aplus are Mr Minus, Ms Minasian and Sathenik Minus. Of the 10 issued shares in Aplus, one is beneficially held by Ms Minasian and nine are held beneficially by Mr Minus. Aplus is the owner of a registered business name Australian Dispute Resolvers.*
- [7] The fourth respondent is Austbar Pty Ltd (“Austbar PL”). That company was incorporated on 9 September 2015. The sole shareholder is Aplus. The sole director is Mr Minus.*
- [8] At the trial, Mr Minus appeared on his own behalf and on behalf of DRA and Austbar PL. Chambers was not represented at the trial although it was represented by Mr Minus up until the appointment of a liquidator to that company. Thus, a reference in these reasons to the contentions of the respondents is a reference to all respondents other than Chambers.*

The applicants’ claims in the first proceeding

- [9] The applicants seek the following relief.*
- [10] First, a declaration that Chambers, by using the names and marks Australian Bar Association and Australian Barristers Association in connection with the conduct of an association, organisation or business concerned with representing or promoting the interests of Australian barristers (a collection of services described by the applicants as the “relevant services”), has infringed two Registered Trade Marks owned, since 27 July 2015, by ABA Ltd Prior to that, they are said to have been owned by ABAU.*
- [11] The two Registered Trade Marks are these:*

- (1) *Trade Mark 1587902, “AUSTRALIAN BAR ASSOCIATION”, registered in Classes 9, 16, 35, 41 and 45 (TM 902); and*
- (2) *Trade Mark 1558252 (the “device mark” or “TM 252”) as set out below, registered in Classes 9, 14, 16, 25, 35, 41 and 45.*



[12] The applicants describe the device mark as the “ABA Logo Mark”.

[13] The applicants contend that each such use or proposed use by Chambers is use or proposed use of a name or mark (that is, a “sign”) substantially identical with, or deceptively similar to, each registered trade mark in respect of services for which each trade mark is registered: s 120(1), Trade Marks Act 1995 (Cth) (the “TM Act”).

[14] The applicants also seek a declaration that Chambers, by use of the following names and marks:

- Australian Barrister Chambers;*
- AustBar Chambers; and*
- Australian Barrister,*

in conjunction with, or in close proximity to, an image of the scales of justice “similar to” the scales forming part of the logo comprising the device mark (being use in conjunction with the relevant services), has infringed the device mark (TM 252) on the footing that such use is use of a sign substantially identical with, or deceptively similar to, TM 252 in respect of services for which the mark is registered: s 120(1), TM Act; Declaration 1A, Second Further Amended Originating Application (“SFAOA”).

[15] The origin of the use of the marks by the applicants and the services for which they are registered is discussed later in these reasons. However, it should be noted at this point that none of the respondents have cross-claimed for revocation of either mark and Mr Minus expressly disavowed any such claim on behalf of any of

the respondents including Chambers (in the period up to the point at which a liquidator was appointed to that company).

[16] Nevertheless, in answer to the claims of infringement, the respondents contend that ABAU is “unable to own any Australian trade mark” and ABAU has “no members” who have “formally applied” to join it or “authorised” an application to be made to it for membership for which a trade mark registration could be held on trust. Apart from that contention, the respondents say that the “ownership” of each registered trade mark is held on trust “as indivisible joint trustees on behalf of the members of the association” by those 12 identified members of the Australian Bar Council (the “AB Council”, being the management organ of ABAU under its Constitution) who applied for registration of each trade mark. They also contend that the assignment of ownership of each trade mark from those persons to those members constituting the AB Council on 17 April 2014 was invalid. The new Council was comprised of 11 members. The new members were Mr William Alstergren SC and Mr Peter Davis QC. The outgoing members were Mr Colbran QC, Mr Traves QC and Mr Walker. Those outgoing members assigned their “joint ownership” of each registered trade mark to the incoming members. That assignment is said, by the respondents, to be invalid. The respondents also contend that the assignment on 27 June 2015 of the trade marks to ABA Ltd was invalid because ABAU did not own and could not pass a valid title to ABA Ltd.

[17] Second, the applicants seek a declaration that Chambers by use, in connection with the relevant services, of:

- Australian Bar Association;*
- Australian Barristers Association;*
- Australasian Barrister Chambers;*
- Australian Barrister; and*
- Australian Barristers Chambers, AustBar Chambers, and Australian Barrister, each in conjunction with, or in proximity to, the scales of justice forming part of the logo comprising the ABA logo,*

engaged in conduct in contravention of s 18(1) of the Australian Consumer Law (“ACL”) and made representations in contravention of ss 29(1)(g) and 29(1)(h) of the ACL.

[18] Third, they seek a declaration that Chambers by use, in connection with the relevant services, of the mark or name AustBar engaged in conduct in contravention of s 18(1) of the ACL and made representations in contravention of ss 29(1)(g) and 29(1)(h) of the ACL.

[19] Fourth, they seek a declaration that Chambers by use, in connection with the relevant services, of each of:

- URL <www.austbar.com.au>;*
- the name AustBar Chambers;*
- the name AustBar ADR; and*
- the tweet identifier <Australian Barrister@AustBar>;*
- the URLs, names and marks above, and the name and mark “AustBar”, each in conjunction with, or in proximity to, the scales forming part of the logo comprising the ABA logo,*

engaged in conduct in contravention of s 18(1) of the ACL and made representations in contravention of ss 29(1)(g) and 29(1)(h) of the ACL.

[20] Fifth, they seek a declaration that Mr Minus is liable as a joint tortfeasor in respect of the infringement of TM 902 and TM 252 by Chambers; that Mr Minus has aided and abetted, counselled or procured, the contraventions by Chambers of the ACL falling within declarations 2, 3 and 4 above; and that Mr Minus has aided and abetted, counselled or procured, the contraventions by Austbar PL described below in these reasons.

[21] Sixth, they seek a declaration that DRA has aided and abetted, counselled or procured, the contraventions by Chambers of the ACL falling within the scope of the fourth declaration sought by the applicants described above.

[22] As to Austbar PL, the applicants seek a declaration that that company has, by the use of the name and mark “AustBar” and the name “AustBar Chambers”, in connection with the relevant services, engaged in conduct in contravention of s 18(1) of the ACL and has made representations in contravention of ss 29(1)(g) and 29(1)(h) of the ACL.

[23] The applicants also seek injunctions against the respondents. They seek by para 7 of the SFAOA an order that the respondents be

restrained from using, in trade or commerce in Australia, in respect of the relevant services:

- the name and mark Australian Bar Association or any name deceptively similar to that name;*
- the name and mark Australian Barristers Association or any name deceptively similar to that name;*
- the name and mark Australasian Barrister Chambers or any name deceptively similar to that name;*
- the name and marks Austbar and AustBar Chambers or any name deceptively similar to those names;*
- the name AustBar ADR or any name deceptively similar to that name;*
- the tweet identifier <Australian Barrister@AustBar> or any identifier deceptively similar to that identifier;*
- the URLs, names and marks referred to above, each in conjunction with, or in proximity to, the scales forming part of the logo comprising the ABA logo.*

[24] *The applicants also seek an order by para 8 of the SFAOA that the respondents be restrained from representing, in trade or commerce in Australia, in respect of the relevant services, by use of:*

- the name and mark Australian Bar Association or any name deceptively similar to that name;*
- the name and mark Australian Barristers Association or any name deceptively similar to that name;*
- the name and mark Australasian Barrister Chambers or any name deceptively similar to that name;*
- the name and marks Austbar and AustBar Chambers or any name deceptively similar to those names;*
- the name AustBar ADR or any name deceptively similar to that name;*
- the tweet identifier <Australian Barrister@AustBar> or any identifier deceptively similar to that identifier;*

- the URLs, names and marks referred to above, each in conjunction with, or in proximity to, the scales forming part of the logo comprising the ABA logo,

that any association, organisation and business set up by the respondents or any of them to provide services to Australian barristers is sponsored by, approved of or affiliated with, the applicants.

[25] The applicants then seek a range of other orders consequential upon the earlier orders. It is not necessary to identify the full scope of those orders. It should be noted, however, that the claim for damages is not pressed by the applicants against any of the respondents.

[171] As to [the names] Austbar and AUSTBAR, I am satisfied that over a reasonably long period of time the Australian Bar Association has come to be known and identified, to a material and significant degree, as Aust.Bar Association and Aust.Bar both in the press and, more broadly, amongst professional bodies such as bar associations, the Law Council of Australia, law societies, university law schools and departments of Crown Law. Perhaps more importantly, I am satisfied that in the modern electronic world of almost universal engagement between persons, companies, bodies and users and providers of services online, the use by the ABA of the electronic descriptor Austbar in its domain address of <www.austbar.asn.au> has reinforced and greatly extended the recognition and identity of the Australian Bar Association with the name, term or descriptor austbar or Austbar. Austbar is a signification of “Australian Bar” and the particular embodiment of that signification is an association between austbar and Austbar and AustBar and the Australian Bar Association. The number of unique visitors and the broader statistics at [54] of these reasons, which are uncontested, are compelling.

[173] Mr Minus says he has a right to adopt austbar or AustBar or Aust Bar because, in his view, the term is not associated solely with the ABA but, more particularly, his use and registration complies with the “Eligibility criteria” and “Guidelines” for domain name registrations and, by reason of the “ccTLD” and “gTLD” each domain name occupies a unique domain space or address and thus one unique address cannot overlap with another.

[174] Mr Minus says that therefore, there can be no confusion. He also says his version of AustBar or austbar derives from the name Australasian Barristers as earlier described.

[175] The circumstance that a domain name registration might or might not meet the eligibility criteria for registration is no answer to the question of whether use of such a domain name is either confusing or misleading or constitutes infringement of a registered trade mark, in Australia. Prior to the introduction of the dispute resolution protocols governing domain name registrations, it had become something of an art form for registrants to register, as domain names, the names of traders who had developed a reputation for a name or mark within a jurisdiction and often internationally. Processes were adopted as a result of that practice to try and address that conduct. Whatever the perceived “validity” might be of the domain name registration <www.austbar.com.au> within the confines of that system and its protocols, austbar and AustBar are terms, names or indicia associated, particularly electronically, with the ABA.

[176] I am satisfied that Chambers and Mr Minus sought to aggregate to themselves on 7 July 2011 the attractive force of the dominant part of the domain name identifier austbar for their own purposes when engaging with visitors to their site even though austbar since 2001 had begun to signify the ABA’s presence on the internet and from 2001 was ultimately the subject of a large number of visitations resulting in the statistics to be seen at [54] of these reasons.

[177] In truth, this is conduct very much along the lines of the registration by Chambers and Mr Minus of the business names Australian Bar Association and Australian Barristers Association, although the names are different.

[178] Mr Minus caused the term AustBar Chambers to be adopted on the AustBar website, the AustBarADR website and the Twitter page under the handle <@AustBar>, under the name “Australian Barrister”.

[179] I accept that use of the sign AustBar Chambers by Mr Minus or companies under his influence, is use of a sign deceptively similar to TM 902 because use of the sign engages, by cognitive cues, the creation of an incorrect belief or impression that the services for which the sign is used or to which the services are connected, come from the ABA or are associated with the ABA. Visitors to the “AustBar Chambers” are likely to be confused about whether that might not be the case: Coco-Cola Co v All-Fect Distributors Ltd(1999) 96 FCR 107 at [39]. I therefore accept that the use of AustBar or Aust Bar as a badge of identification of virtual chambers services provided by Mr Minus and the entity Chambers, even though followed by the word “Chambers” is likely to cause

those persons visiting and interrogating the offering to be caused to wonder whether the services offered under that sign or mark are those of, or associated with, the ABA.

[180] As to the use of the Twitter handle <@AustBar> together with “Australian Barrister”, I also accept that persons engaging communications by means of “tweets” under that handle linked to “Australian Barrister” are also likely to be caused to wonder by reason of the cognitive cues associated with the conjunction of <@AustBar> and “Australian Barrister” whether the services provided by the organisation operating the Twitter account are the services of the ABA or have an association with the ABA. I am satisfied that use of <@AustBar> in this way is use of a mark or sign deceptively similar to TM 902.

[206] As already mentioned, I am satisfied that the conduct of adopting the descriptor austbar and AustBar and Aust Bar by the respondents is conduct very much along the lines of the attempt to take advantage of the reputation of the Australian Bar Association by registering the business names Australian Bar Association and Australian Barristers Association.

[207] Subject to the question of the disclaimer, I am satisfied that Chambers and later Austbar PL engaged in contraventions of s 18(1) of the ACL. Sections 29(1)(g) and 29(1)(h) are in these terms:

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

...

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

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

[211] I am satisfied that the conduct of Chambers (and the respondents) of adopting the two domain names incorporating austbar and the Twitter account engaging AustBar as it does related to Australian Barrister conveys a representation that each of those websites has an affiliation with the ABA or the approval of the ABA in the sense

that it suggests that the services have the sponsorship and approval of the ABA and the operator of the site has the sponsorship, or approval of the ABA or an affiliation with the ABA. That representation is strengthened when one examines the structure, configuration and layout of the website which, I accept, conveys the “look and feel” of a quasi-official site as though the operator were an authoritative source of national “institutional” information about barristers which one might expect to find on a site operated by a nationally organised association of barristers and bar associations which has been in existence for a long period of time performing such a role.

[212] Again, subject to the question of the disclaimer, I am satisfied that the conduct otherwise engages a contravention of s 29(1)(g) and (h) of the ACL.

[252] As to the relief, I propose to make the declarations and injunctions and related orders sought by the applicants conditioned by the findings and observations in these reasons. I accept that neither Mr Minus nor any of the entities associated with him have exhibited any conduct since 1 November 2015 which suggests that there is a present threat to use the name Australian Bar Association. Mr Minus has not provided any undertaking not to use that name. That, no doubt, follows because he says that he has no intention to use it (and, of course, has asserted that he never had any intention to use it). I have made findings about that conduct. As to the future, I would ordinarily regard it as a proper exercise of the discretion to grant an injunction in respect of that name in circumstances where the evidence shows that Mr Minus had no standing to apply for the business name when he did and preserved in the retention of that business name for quite a long period of time (from 14 June 2013 to 1 November 2015). Should Mr Minus proffer an unconditional undertaking to the Court, unreservedly, not to use that business name, I would not exercise the discretion to make an injunctive order. Having regard to the conduct, I will exercise the discretion to make an injunctive order in the absence of such an undertaking.

4. The previous orders made by Greenwood J were as follows, with orders 7 to 12 and 15, being particularly applicable to the position of the Applicant in this proceeding:

*No: (P)NSD975/2014
Federal Court of Australia
District Registry: New South Wales
Division: General*

PHILIP SELTH IN A REPRESENTATIVE CAPACITY FOR THE MEMBERS OF THE AUSTRALIAN BAR ASSOCIATION and another named in the schedule

Applicants

AUSTRALASIAN BARRISTER CHAMBERS PTY LIMITED ABN 80 133 736 848 and others named in the schedule

Respondents

ORDER

JUDGE: Justice Greenwood

DATE OF ORDER: 26 June 2017

WHERE MADE: Brisbane

THE COURT ORDERS THAT:

1. The First Respondent, Australasian Barrister Chambers Pty Limited (in liquidation) has by use of the names and marks:

- (a) “Australian Bar Association”; and
- (b) “Australian Barristers Association”;

in connection with the conduct of an association, organization or business concerned with the representation and promotion of the interests of Australian barristers (Relevant Services) infringed each of Trade Mark Registration 1587902 and Trade Mark Registration 1558252.

2. The First Respondent, Australasian Barrister Chambers Pty Limited (in liquidation) has by use of the names and marks:

- (a) “AustBar Chambers”; and
- (b) “Australian Barrister”;

in conjunction with, or in close proximity to an image of the scales of justice similar to the scales forming part of the logo comprising Trade Mark Registration 1558252 (ABA Logo) in connection with the Relevant Services, infringed Trade Mark Registration 1558252.

3. *The Second Respondent, Derek Michael Minus, is liable as a joint tortfeasor in respect of the infringements of Trade Mark Registration 1587902 and Trade Mark Registration 1558252 by the First Respondent set out in orders 1 and 2 above.*
4. *The First Respondent, Australasian Barrister Chambers Pty Limited (in liquidation), by use of each of:*
 - (a) *the name and mark “Australian Bar Association”;*
 - (b) *the name “Australian Barristers Association”;*
 - (c) *the name and mark “AustBar”;*
 - (d) *the name and mark “AustBar Chambers”;*
 - (e) *the name and mark “AustBar ADR”;*
 - (f) *the URL www.austbar.com.au;*
 - (g) *the tweet identifier “Australian Barrister @AustBar”;*
 - (h) *the names and marks “AustBar Chambers”, “AustBar ADR”, “Australian Barrister”, the URL www.austbar.com.au, the tweet identifier “Australian Barrister @AustBar” each in conjunction with, or in proximity to, the scale forming part of the logo comprising the ABA Logo;*

in connection with the Relevant Services:

 - (i) *engaged in conduct that is misleading or deceptive, or likely to mislead or deceive, in contravention of section 18 of the Australian Consumer Law (ACL) which is Schedule 2 to the Competition and Consumer Act 2010 (Cth); and*
 - (j) *made false or misleading representations about services in contravention of section 29(1)(g) and section 29(1)(h) of the ACL.*
5. *The Second Respondent, Derek Michael Minus has aided and abetted, counselled or procured the contraventions by the First Respondent of the ACL set out in order 4 above.*
6. *The Third Respondent, Dispute Resolution Associates Pty Ltd, has aided and abetted, counselled or procured the contraventions by the First Respondent of the ACL set out in order 4(f) above.*

7. *The Fourth Respondent, Austbar Pty Ltd, has by the use of the name and mark “AustBar” and the name and mark “AustBar Chambers” in connection with the Relevant Services:*
 - (a) *engaged in conduct that is misleading or deceptive, or likely to mislead or deceive, in contravention of section 18 of the ACL; and*
 - (b) *made false or misleading representations about services in contravention of section 29(1)(g) and section 29(1)(h) of the ACL.*
8. *The Second Respondent, Derek Michael Minus, has aided and abetted, counselled or procured the contraventions by the Fourth Respondent of the ACL set out in order 7 above.*
9. *The First Respondent, Australasian Barrister Chambers Pty Limited (in liquidation), the Second Respondent, Derek Michael Minus, the Third Respondent, Dispute Resolution Associates Pty Ltd and the Fourth Respondent, Austbar Pty Ltd, whether by themselves, their servants and/or agents be permanently restrained and an order is hereby made restraining them and each of them from using, in the conduct of the activities of any association, organisation or business concerned with the Relevant Services or being involved in any way directly or indirectly in the use by any other person in the conduct of the Relevant Services:*
 - (a) *the name and mark “Australian Bar Association” or any name that is substantially identical or deceptively similar thereto;*
 - (b) *the name and mark “Australian Barristers Association” or any name that is substantially identical or deceptively similar thereto;*
 - (c) *the names and marks “Austbar”, “Aust Bar”, “AustBar ADR” and “AustBar Chambers” or any name or mark that is substantially identical or deceptively similar thereto;*
 - (d) *the URL www.austbar.com.au or any URL that is substantially identical or deceptively similar thereto;*
 - (e) *the tweet identifier “Australian Barrister @AustBar” or any identifier substantially identical or deceptively similar thereto; and*
 - (f) *the names, marks, URLs and tweet identifiers referred to in paragraphs (a) to (e) above, and the name and mark*

“Australian Barrister”, each in conjunction with, or in proximity to, the scales forming part of the logo comprising the ABA Logo.

10. *The First Respondent, Australasian Barrister Chambers Pty Limited (in liquidation), the Second Respondent, Derek Michael Minus, the Third Respondent, Dispute Resolution Associates Pty Ltd and the Fourth Respondent, Austbar Pty Ltd, whether by themselves, their servants and/or agents be permanently restrained and an order is hereby made restraining them and each of them from, representing, by the use of, or being involved in any way directly or indirectly with any other person representing by the use of:*

- (a) the name “Australian Bar Association” or a name that is substantially identical or deceptively similar thereto;*
- (b) the name “Australian Barristers Association” or a name that is substantially identical or deceptively similar thereto;*
- (c) the names and marks “Austbar”, “Aust Bar”, “AustBar ADR” and “AustBar Chambers” or any name or mark that is substantially identical or deceptively similar thereto;*
- (d) the URL www.austbar.com.au or any URL that is substantially identical or deceptively similar thereto;*
- (e) the tweet identifier “Australian Barrister @AustBar” or any identifier substantially identical or deceptively similar thereto; and*
- (f) the names, marks, URLs and tweet identifiers referred to in paragraphs (a) to (e) above, and the name and mark “Australian Barrister”, each in conjunction with, or in proximity to, the scales forming part of the logo comprising the ABA Logo,*

that any association, organisation and business set up by the Respondents or any of them to provide services to Australian barristers is sponsored by, approved of or affiliated with the Applicants.

11. *Within 7 days of the date of these orders, the First Respondent, the Second Respondent, the Third Respondent and the Fourth Respondent at their own cost, delete, destroy or deliver up to the Applicants or their nominated agents for destruction, all documents, packaging, advertising and promotional material and*

all other printed matter, in their possession, custody or control, that bear:

- (a) the name and mark “Australian Bar Association”;*
- (b) the name “Australian Barristers Association”;*
- (c) the name and mark “AustBar”;*
- (d) the name and mark “AustBar Chambers”;*
- (e) the name and mark “AustBar ADR”;*
- (f) the URL www.austbar.com.au;*
- (g) the tweet identifier “Australian Barrister @AustBar”;*

or any name or mark or domain name substantially identical with or deceptively similar thereto.

12. *Within 7 days of the date of these orders, the First Respondent, the Second Respondent, the Third Respondent and the Fourth Respondent, at their own cost, take immediate steps to prevent publication by each and every person and corporation with whom the Respondents have a contract, arrangement or understanding in relation to the publication or further publication in any media:*

- (a) the name and mark “Australian Bar Association”;*
- (b) the name “Australian Barristers Association”;*
- (c) the name and mark “AustBar”;*
- (d) the name and mark “AustBar Chambers”;*
- (e) the name and mark “AustBar ADR”;*
- (f) the URL www.austbar.com.au;*
- (g) the tweet identifier “Australian Barrister @AustBar”;*

or any name or mark or domain name substantially identical with or deceptively similar thereto.

13. *Within 7 days of the date of these orders the First Respondent take all necessary steps to transfer the Business Name Registration for “Australian Barristers Association” to the Second Applicant or if that is not possible, cause the registration of that Business Name Registration to be cancelled.*

14. *Within 7 days of the date of these orders, the Second Respondent and the Third Respondent take all necessary steps to transfer the URL www.austbar.com.au to the Second Applicant or if that is not possible, cause the registration of that domain name to be cancelled.*
 15. *Within 10 days of the date of these orders, the Second Respondent and the Fourth Respondent either:*
 - (a) *take all necessary steps to deregister the Fourth Respondent; or*
 - (b) *take all necessary steps to change the registered name of the Fourth Respondent to a name other than “AUSTBAR”, “AUST BAR or any other name that is substantially identical or deceptively similar to “AUSTBAR” or “AUST BAR”.*
 16. *Within 14 days of the date of these orders, the Second Respondent file and serve an affidavit verifying compliance with orders 11, 12, 14 and 15 above.*
 17. *Costs reserved.*
5. As I have said earlier the Respondent, in support of its summary dismissal application, relies on the forms of estoppel known as, respectively, *res judicata*, issue estoppel, and Anshun estoppel. The principles relating to those forms of estoppel have been stated in the High Court as follows:
- a) *Res judicata* and issue estoppel were described by Gibbs CJ, Mason and Aickin JJ in *Port of Melbourne Authority v Anshun Pty Ltd* (1981) 147 CLR 589 at 597 in the following terms:

The distinction between res judicata (in England called “cause of action estoppel”) and issue estoppel was expressed by Dixon J in Blair v Curran (1939) 62 CLR 464 at 532 in these terms: “In the first the very right or cause of action claimed or put in suit has in the former proceedings passed into judgment, so that it is merged and has no longer an independent existence, while in the second, for the purpose of some other claim or cause of action, a state of fact or law is alleged or denied the existence of which is a matter necessarily decided by the prior judgment, decree or order”.
 - b) The following was said of Anshun estoppel, issue estoppel and *res judicata* in *Tomlinson v Ramsey Food Processing Pty Limited*

(2015-16) 256 CLR 507 by French CJ, Bell, Gageler and Keane JJ at 517-518 [22]:

Three forms of estoppel have now been recognised by the common law of Australia as having the potential to result from the rendering of a final judgment in an adversarial proceeding. The first is sometimes referred to as “cause of action estoppel”. Estoppel in that form operates to preclude assertion in a subsequent proceeding of a claim to a right or obligation which was asserted in the proceeding and which was determined by the judgment. It is largely redundant where the final judgment was rendered in the exercise of judicial power, and where res judicata in the strict sense therefore applies to result in the merger of the right or obligation in the judgment. The second form of estoppel is almost always now referred to as “issue estoppel”. Estoppel in that form operates to preclude the raising in a subsequent proceeding of an ultimate issue of fact or law which was necessarily resolved as a step in reaching the determination made in the judgment. The classic expression of the primary consequence of its operation is that a “judicial determination directly involving an issue of fact or of law disposes once for all of the issue, so that it cannot afterwards be raised between the same parties or their privies”. The third form of estoppel is now most often referred to as “Anshun estoppel”, although it is still sometimes referred to as the “extended principle” in Henderson v Henderson. That third form of estoppel is an extension of the first and of the second. Estoppel in that extended form operates to preclude the assertion of a claim, or the raising of an issue of fact or law, if that claim or issue was so connected with the subject matter of the first proceeding as to have made it unreasonable in the context of that first proceeding for the claim not to have been made or the issue not to have been raised in that proceeding. The extended form has been treated in Australia as a “true estoppel” and not as a form of res judicata in the strict sense. Considerations similar to those which underpin this form of estoppel may support a preclusive abuse of process argument.

6. I note that in considering a plea of *res judicata* that consideration is confined to an examination of the pleadings and the orders of the Court in the previous case, whereas in considering issue estoppel and Anshun estoppel any material may be looked at which will show what issues were raised and decided in the earlier case, including pleadings, applications, affidavits and reasons: see the decision of Perram J in *Zetta*

Jet Pte Ltd v The Ship "Dragon Pearl" (No 2) [2018] FCA 1130 at [31] – [33].

7. In my view, in light of the previous orders and Reasons for Judgment of Greenwood J the present proceeding should be summarily dismissed because the Applicant has no reasonable prospect of successfully prosecuting the whole of the proceeding. The simple fact of the matter is that the previous orders and the Reasons for Judgment of Greenwood J have finally determined that the Applicant in this proceeding has no right, title or interest in or to the use of the trade marks or names, being *Austbar* and *Aust Bar*. The Applicant is not entitled, as a result of the previous orders and Reasons for Judgment of Greenwood J, to impeach or attack the decision of the Registrar of Trade Marks, because that decision is in accord with the findings and the previous orders of Greenwood J, which have quelled the controversy about the use and ownership of the words comprising the two trade marks the subject of the Registrar of Trade Marks' decision adversely to the Applicant.
8. In my view, the appropriate legal bases for this conclusion are those of issue estoppel and Anshun estoppel, rather than *res judicata* or cause of action estoppel in the strict sense. This is because the two proceedings are not strictly identical and strict identity appears to be a prerequisite for the application of *res judicata* in its strict sense. In *Arnold v National Westminster Bank plc* [1991] 2 A.C. 93 Lord Keith of Kinkel stated the distinction between cause of action estoppel and issue estoppel at 104 – 105 as follows:

It is appropriate to commence by noticing the distinction between cause of action estoppel and issue estoppel. Cause of action estoppel arises where the cause of action in the later proceedings is identical to that in the earlier proceedings, the latter having been between the same parties or their privies and having involved the same subject matter. In such a case the bar is absolute in relation to all points decided unless fraud or collusion is alleged, such as to justify setting aside the earlier judgment. The discovery of new factual matter which could not have been found out by reasonable diligence for use in the earlier proceedings does not, according to the law of England, permit the latter to be re-opened....

Issue estoppel may arise where a particular issue forming a necessary ingredient in a cause of action has been litigated and

decided and in subsequent proceedings between the same parties involving a different cause of action to which the same issue is relevant one of the parties seeks to re-open that issue. This form of estoppel seems first to have appeared in Duchess of Kingston's Case (1776) 20 St.Tr. 355. A later instance is Reg. v. Inhabitants of the Township of Hartington Middle Quarter (1855) 4 E. & B. 780. The name "issue estoppel" was first attributed to it by Higgins J. in the High Court of Australia in Hoysted v. Federal Commissioner of Taxation (1921) 29 C.L.R. 537, 561.

(emphasis added)

The present proceeding is an appeal from a decision of the Registrar of Trade Marks in relation to the words *Austbar* and *Aust Bar*, whereas the proceeding heard and determined by Greenwood J in connection with the Applicant related to claims of misleading and deceptive conduct and passing off in connection with those names.

9. However, that is not to say that because of the lack of strict identity the decision and orders of Greenwood J do not have applicability to this case. In my view, by reason of issue estoppel, the Applicant in this proceeding is precluded from raising any claim to entitlement to use the terms or words *Austbar* or *Aust Bar*, either by way of trade mark or otherwise, because the orders of Greenwood J have determined and required that it not use them for the reasons given in the Reasons for Judgment. Further, the present proceeding must fail because of Anshun estoppel, in that the Applicant is here asserting rights in relation to the *Austbar* or *Aust Bar* names, which Greenwood J, although not in the same statutory context of the *Trade Marks Act 1995* (Cth), has already considered in the case determined by him, and where he determined that the Applicant was not entitled to any rights to use either name.
10. Accordingly, in my view, notwithstanding that the Court should be careful when asked to invoke the power under s.17A to summarily dismiss a proceeding, the Respondent has established that the Applicant has no reasonable prospect of successfully prosecuting the whole of the present proceeding. Accordingly, I order, pursuant to s.17A of the *Federal Circuit Court of Australia Act 1999* (Cth), that the Notice of Appeal filed in this Court on 4 May 2017 be dismissed.

I certify that the preceding ten (10) paragraphs are a true copy of the reasons for judgment of Judge Dowdy

Associate:

Date: 1 August 2018