

Article Information

Authors: Tim O’Callaghan, Travis Shueard, Sahar Al-Dulaimi

Service: Corporate & Commercial, Dispute Resolution & Litigation, Intellectual Property, Intellectual Property & Technology, Intellectual Property Litigation, Trade Marks

Composite trade marks: Are they F[y]re-proof?

***In Trafalgar Group Pty Ltd v Boss Fire & Safety Pty Ltd*,^[1] the Federal Court explained the operation of a “mark within a mark”, holding that Trafalgar’s use of the FYRE Device Mark within its various composite marks sufficed in evidencing use as a separate operative trade mark during the alleged non-use period.**

Background

On 7 August 2009, the appellant, Trafalgar Group Pty Ltd (**Trafalgar**) applied to register Australian Trade Mark No. 1313971:



(FYRE Device Mark).^[2]

The trade mark was accepted for registration on 2 November 2009 and entered onto the Register of Trade Marks on 18 March 2010, making Trafalgar the registered owner of the Fyre Device Mark.^[3]

The Respondent, Boss Fire & Safety Pty Ltd (**Boss Fire**), filed a non-use removal application under on 22 February 2019 pursuant to section 92(4)(b) of the *Trade Marks Act 1995* (Cth) (**TMA**), alleging that Trafalgar Group had not used the FYRE Device Mark with respect to the registered goods for a continuous three-year period between January 2016 and January 2019 (**Non-Use Period**).^[4] These registered goods were passive fire protection products.^[5]

Trafalgar opposed the application but the Delegate of the Registrar of Trade Marks found against Trafalgar,^[6] ordering a removal of the FYRE Device Mark. Trafalgar appealed to the Federal Court. Boss Fire also brought a registration cancellation action under s 88 of the *TMA*, which was heard together with the appeal.

Key Findings

“Use” of a Trade Mark within a Composite Mark

A central issue in this case was the meaning of “use” when a registered mark only appears within composite marks. This issue arose because Trafalgar did not use the FYRE Device Mark on its own during the Non-Use Period. Instead, Trafalgar used composite word-device marks such as FYREFLEX, FYREPLUG, FYRESET, and FYRECLAMP, each containing the FYRE Device Mark as the first element.^[7] Needham J observed that a single instance of *bona fide* use during the Non-Use Period can be sufficient to defeat a removal application.^[8] The use must be as a trade mark (a badge of origin),^[9] and must be genuine commercial use.^[10]

Crucially, Trafalgar relied on the High Court’s joint judgment in *Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd*,^[11] where the Court confirmed that when multiple words or signs appear on a product label, the presence of a dominant component does not prevent other parts of the label from also operating as trade marks.^[12] Trafalgar emphasised this principle to argue that each composite sign incorporated two trade marks: the FYRE Device Mark and a suffix (including FLEX, PLUG, SET, CLAMP), each performing distinct functions.^[13]

Needham J also acknowledged Bennett J's reasoning in *Wellness Pty Ltd v Pro Bio Living Waters*,^[14] where PRO-BIO and LIVING WATERS operated as separate trade marks within one composite sign. In that decision, Bennett J held that PRO-BIO denoted the company responsible for the products while LIVING WATERS identified the product range. Trafalgar argued its use of the FYRE Device Mark worked the same way:^[15] FYRE indicated the company of origin, whilst the suffixes identified individual goods.

Boss Fire, however, contended that FYRE could not be separated from the suffix to constitute separate "use" of the FYRE Device Mark.^[16]

Is it a "Trade Mark"?

The Court considered Allsop J's analysis in *Anheuser-Busch Inc v Budejovický Budvar*,^[17] wherein his Honour explained that even if one element of a mark appears prominent or dominant, other elements may still perform a trade mark function.^[18]

The question of whether a sign is used "as a trade mark" is determined objectively from the perspective of the notional consumer, considering the context of use and applying "common sense".^[19] Applying that test, Needham J accepted Trafalgar's submission that the FYRE Device Mark played an independent role within each composite mark.

Her Honour found that the FYRE Device Mark operated as a "mark within a mark":^[20] although not used alone, it functioned separately within the composite signs. Several factors supported this conclusion. First, the FYRE Device Mark was reproduced in full, with all stylistic elements intact, namely the flame device and the elongated orange tail on the "Y".^[21] Second, the Trafalgar marks consistently displayed FYRE in orange and the suffix in black, signalling to consumers that FYRE was the unifying source indicator, while the suffix identified the particular good.^[22] Third, while the suffixes were not strictly descriptive, they nonetheless related to product functionality; "FLEX" (flexible joint products), "PLUG" (barrier pillow products), "SET" (mortar products), "CLAMP" (intumescent clamp products), reinforcing their role as secondary identifiers.^[23] Fourth, Needham J accepted that, as Trafalgar submitted, consumers familiar with passive fire products (supported by the evidence of Mr Bury) would perceive "FYRE" and the suffix as separate signifiers.^[24]

Taken together, these factors established that the FYRE Device Mark functioned as a separate badge of origin within each composite sign. Needham J therefore concluded that Trafalgar had used the FYRE Device Mark as a trade mark during the Non-Use Period.^[25] Accordingly, Needham J allowed Trafalgar's appeal and set aside the Delegate's decision, holding that the FYRE Device Mark should remain registered for the relevant goods.

Obiter

Although unnecessary to decide, her Honour also addressed, in *obiter*, the second issue: whether Trafalgar's composite marks constituted use of the FYRE Device Mark with additions or alterations not substantially affecting its identity under s 100(3)(a).^[26] The Court noted that this inquiry is essentially the same as the "substantial identity" test familiar from section 44 jurisprudence.

However, her Honour's reasoning in *obiter* demonstrates that the Court will not readily accept that a composite mark is substantially identical to its constituent elements, particularly where suffixes or additions form integral parts of a product-family branding structure.^[27]

In other words, FYRE Device Mark during the Non-Use Period by way of its incorporation in the Trafalgar marks was sufficient to satisfy the Court of its use as a separately performing trade mark.^[28]

Takeaways

This decision serves as a reminder that a registered mark may be used "within" a composite mark, and this can, in certain circumstances, still constitute "use" for the purposes of defeating removal application for non-use.

It is also an excellent example of where a primary trade mark (in this case, the FYRE Device Mark) can be used to create additional sub-brands or product descriptors, and still expand the parent brand's profile.

Piper Alderman has a nationally recognised intellectual property and technology team, with experience in trade mark litigation, including composite trade marks, spanning multiple jurisdictions. Please contact Tim O'Callaghan and his team if you require intellectual property advice.

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- [1] [2026] FCA 202 (*Trafalgar Group Pty Ltd v Boss Fire*).
- [2] Ibid [3] - [4].
- [3] Ibid [5].
- [4] Ibid [6].
- [5] Ibid [67].
- [6] Ibid [7].
- [7] Ibid [70]-[72].
- [8] Ibid [69], citing *Woolly Bull Enterprises Pty Ltd v Reynolds* [2001] FCA 261; 107 FCR 166, [17].
- [9] *E&J Gallo Winery v Lion Nathan Australia Pty Ltd* [2010] HCA 15; 241 CLR 144, [41]-[43].
- [10] See *Imperial Group Ltd v Philip Morris & Co* [1982] FSR 72.
- [11] (2023) 277 CLR 186.
- [12] *Trafalgar Group Pty Ltd v Boss Fire* (n 1) [74].
- [13] Ibid [77].
- [14] [2004] FCA 438; 61 IPR 424.
- [15] *Trafalgar Group Pty Ltd v Boss Fire* (n 1) [76], [77].
- [16] Ibid [84], [85].
- [17] (2002) 56 IPR 182.
- [18] *Trafalgar Group Pty Ltd v Boss Fire* (n 1) [78], [79].
- [19] Ibid [73], citing *Seven Network (Operations) Limited v 7-Eleven Inc* [2023] FCA 608, [42].
- [20] *Trafalgar Group Pty Ltd v Boss Fire* (n 1) [88]; *Rowntree plc v Rollbits Pty Ltd* (1988) 90 FLR 398, 405.
- [21] *Trafalgar Group Pty Ltd v Boss Fire* (n 1) [89].
- [22] Ibid.
- [23] Ibid.
- [24] Ibid.
- [25] Ibid [91].
- [26] Ibid [92].
- [27] Ibid [94], [95], [111], [112].
- [28] Ibid [87].