



## Précis Paper

### RJB Wolfe Pty Ltd v Mornington Peninsula Eye Clinic Pty Ltd [2019] VSC 27

A consideration of the case *RJB Wolfe Pty Ltd v Mornington Peninsula Eye Clinic Pty Ltd [2019] VSC 27* which involved two eye clinics with similar names, raising various issues of misleading and deceptive conduct, and passing off, and whether the two businesses could co-exist.

#### Discussion Includes

- Facts of the case
- Witnesses
- Outcome of the case
- Costs

## Précis Paper

### RJB Wolfe Pty Ltd v Mornington Peninsula Eye Clinic Pty Ltd [2019] VSC 27

1. In this edition of BenchTV, James Samargis (Barrister, Owen Dixon Chambers, Melbourne) and Steven Griffiths (Director, BenchTV) discuss *RJB Wolfe Pty Ltd v Mornington Peninsula Eye Clinic Pty Ltd [2019] VSC 27*, which involved two eye clinics with similar names, raising various issues of misleading and deceptive conduct, and passing off, and whether the two businesses could co-exist.

#### Facts of the case

2. The plaintiff, Dr. Richard Wolfe, a leading ophthalmic surgeon, had established the Peninsula Eye Centre over 30 years ago in the Mornington Shire, Victoria.
3. The defendants had recently established a competing ophthalmic business known as Mornington Peninsula Eye Clinic.
4. Both practices were located on the Nepean Highway, Mornington, within a kilometre of each other.
5. Dr Wolfe complained that the names were similar and apt to confuse, and wanted the defendants to cease using the word 'Peninsula' in their trading name, and alleged that the defendants were engaging in misleading or deceptive conduct.

#### Witnesses

6. The witnesses were highly educated ophthalmologists.
7. One of the witnesses said that the name was chosen because it was similar to another business with which they were associated, the Armidale Eye Clinic, simply adopting a geographical location together with 'eye clinic'. The two businesses also had similar logos.
8. Dr. Banbury who was a witness for the plaintiff supported under cross examination the defendant's case that ophthalmologists were not likely to be confused as they were a small class of people and everybody knew each other.
9. GPs tended to refer to doctors rather than a geographic clinic.
10. Confusion was enough to be led into error
11. There was insufficient evidence to show that there was a likelihood of the general public being led into error.
12. Dr. Richard Wolfe had a celebrity status due to his association with the *Real Housewives of Melbourne* which decreased even further the likelihood of confusion.



### Outcome of the Case

13. The case fell in the defendants favour. It was found that there was no likelihood of confusion.

### Costs

14. When you are a plaintiff and you are thinking about whether or not to sue, you have to pay a lot of attention to the cost consequences of doing that.
15. Where you are the respondent to the threat of litigation and you are in a position where you can move away from the name, it is perhaps better to do so, as the case can go either way.

## **BIOGRAPHY**

### **James Samargis**

Barrister, Owen Dixon Chambers West, Melbourne

James Samargis practices in all areas of intellectual property and in matters concerning information technology and the internet.

James provides validity and infringement advice for patent, trademark, design and copyright rights as well as advice on unfair advertising and misleading and deceptive conduct in trade under Australian Consumer Law.

James practices mainly in the Federal Court, appearing in infringement of rights actions, seeking or resisting injunctions and other urgent relief and preparation of matters for trial. His practice also extends to general commercial disputes with emphasis on IP and IT contract and licensing disputes.

James is a member of the Intellectual Property Society of Australia and New Zealand. James is immediate past Chairman of the Board of Craft Victoria, the peak State Body for Designer/Makers.

### **Steven Griffiths**

Director, BenchTV, Sydney

Steven Griffiths graduated from the Queensland University of Technology (QUT) in 2003 obtaining a Bachelor of Laws. He had previously studied at University of New South Wales, obtaining a Degree in Sport Science. He was admitted as a solicitor in 2004 to the NSW Supreme Court and worked as a Government solicitor from 2004 to 2017 advising senior departmental staff and appearing in a wide variety of matters in the NSW court and tribunals including Supreme, District and Local courts as well as the State Parole Authority and Coroner's Court. He opened his own practice in 2017 specialising in criminal law and is currently the Director of Bench TV.

## **BIBLIOGRAPHY**

### **Focus Case**

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### **Benchmark Link**

[https://benchmarkinc.com.au/benchmark/weekly\\_business/benchmark\\_15-02-2019\\_weekly\\_business\\_law.pdf](https://benchmarkinc.com.au/benchmark/weekly_business/benchmark_15-02-2019_weekly_business_law.pdf)

### **Judgment Link**

<http://www.austlii.edu.au/cgi-bin/viewdoc/au/cases/vic/VSC/2019/27.html>

### **Cases**

*Hindmarsh Medical Clinic v Hindmarsh Family Practice Pty Ltd* (1997) 38 IPR 616  
*Hornsby Building Information Centre Pty Ltd v Sydney Building Information Centre Ltd* (1978) 140 CLR 216

*Re Bruce Ian Barry and Rebecca Barry v Lake Jindabyne Reservation Centre Pty Limited*  
(1985) 8 FCR 279  
*Kosciuszko Thredbo Pty Limited v ThredboNet Marketing Pty Limited* [2014] FCAFC 87  
*Sydney Medical Service Co-operative Limited v Lakemba Medical Services Pty Ltd (No 2) -*  
*[2016] FCA 1188*  
*Dodds Family Investments Pty Ltd v Lane Industries Pty Ltd* [1993] FCA 259  
*Shape Shopfitters Pty Ltd v Shape Australia Pty Ltd (No 3)* [2017] FCA 865  
*Sensis Pty Ltd v Senses Direct Mail and Fulfillment Pty Ltd* [2019] FCA 719

#### Legislation

*s 18 sch 2 Competition and Consumer Act 2010 (Cth)*