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Author

Wiseman, Leanne, Hall, Matthew

Published

2009

Book Title

Landmarks in Australian Intellectual Property Law

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Waiting for the 'Billy'^{®1} to boil: the *Waltzing Matilda* case

Leanne Wiseman and Matthew Hall

*Once a jolly swagman camped by a billabong,
Under the shade of a coolibah tree,
And he sang as he looked at the old billy boiling
'Who'll come a-Waltzing Matilda, with me?'*

*Waltzing Matilda, Waltzing Matilda
'You'll come a-Waltzing Matilda, with me'
And he sang as he watched and waited 'til his billy boiled,
'You'll come a-Waltzing Matilda, with me'.*

*Down came a jumbuck to drink at the billabong,
Up got the swagman and grabbed him with glee,
And he sang as he stowed that jumbuck in his tucker bag,
'You'll come a-Waltzing Matilda, with me'.*

*Waltzing Matilda, Waltzing Matilda
'You'll come a-Waltzing Matilda, with me'
And he sang as he stowed that jumbuck in his tucker bag,
'You'll come a-Waltzing Matilda, with me'.*

*Down came the squatter, mounted on his thoroughbred,
Up came the troopers, one, two, three,
'Where's that jolly jumbuck you've got in your tucker bag?'
'You'll come a-Waltzing Matilda, with me'.*

*Waltzing Matilda, Waltzing Matilda
'You'll come a-Waltzing Matilda, with me'
'Who's that jolly jumbuck you've got in your tucker bag?'
'You'll come a-Waltzing Matilda, with me'.*

¹ Trade mark registration no. 596575.

individual should be given exclusive rights to use the words as a trade mark? This is an issue that is broader than 'Waltzing Matilda'. It is a question that affects any symbol or sign that is part of Australia's national identity or is seen as a cultural icon.

'Waltzing Matilda' was written by Banjo Paterson in 1895. In essence it is a ballad about an itinerant worker (a swagman) who is camped at a billabong (or waterhole). While he is waiting for his billy to boil to make his tea, a sheep comes down to the billabong for a drink of water. As often happened at the time, the swagman kills the sheep. When the sheep's owner arrives with three police officers to arrest the swaggie, the swagman drowns himself in the billabong. There has been considerable debate about 'Waltzing Matilda', particularly about when and how it was written.⁸ As one commentator has noted, '[t]here are now more 'official' versions of "Waltzing Matilda" than there are unofficial versions of the plot that killed Kennedy'.⁹ There are three main versions of "Waltzing Matilda", each with their own history, melody and lyrics. These are the Macpherson/Paterson rendition which is based on the 1895 song;¹⁰ the popular version of the song which first appeared in print in an arrangement by Marie Cowan (c 1903)¹¹ (this has different tune and words to the Macpherson/Paterson version); and a third oral version, sometimes referred to as the Queensland version, which has Paterson's lyrics but to a different tune.¹²

While aspects of the song's legacy are disputed, there are some facts which are generally accepted. Most commentators agree that the words to 'Waltzing Matilda' were written by Banjo Paterson in 1895 when he visited Dagworth Station, a property about 100 km north-west of Winton (in western Queensland).¹³ On one version of events, when Paterson was at Dagworth Station, Christina Macpherson played him a tune that she had recently heard at a race meeting in Victoria. The melody played by Macpherson is thought to be an imperfect recollection of the Scottish folk tune 'Thou Bonnie Wood of Craigielea' or 'The Bold Fusilier'. After hearing the tune, Paterson decided to write lyrics to accompany the music. It has been suggested that the lyrics that Paterson wrote were based

⁸ For the background, see S May, *The Story of 'Waltzing Matilda'*, 2nd edn, WR Smith & Peterson, Brisbane, 1955); C Semmler, *The Banjo of the Bush: The Work, Life and Times and AB Paterson* (Lansdowne Press, Melbourne, 1966); R Maggoffin, *Fair Dinkum Matilda: The Story of a Song its People & Times*, Mimosa Press, Charters Towers, 1973; R Maggoffin, *The Provenance of Waltzing Matilda: A Definitive Exposition of the Song's Origins, Meanings and Evolution from a Pivotal Episode in Australia's History*, Matilda Expos Publishers, Kynuna, 2000; R Maggoffin, *Waltzing Matilda: The Story behind the Legend*, ABC Books, Sydney, 1987; C Roderick, *Banjo Paterson: Poet by Accident*, Allen & Unwin, St Leonards, 1993; M Richardson, *Once a Jolly Swagman: The Ballad of Waltzing Matilda*, Melbourne University Press, Melbourne, 2006; and T Radic, 'The Matilda Knot' (1995) *Victorian Journal of Music Education* 3.

⁹ J Marx, 'The Meaning of Waltzing Matilda', *Sydney Morning Herald*, 23 July 2007, available at http://blogs.smh.com.au/thedailytruth/archives/2007/07/the_meaning_of_waltzing_matild.html. See also Radic, op. cit., pp. 5–6.

¹⁰ See Figure 14.2 below. Maggoffin states that the Macpherson manuscripts were not found until the 1970s. Maggoffin, *The Provenance of Waltzing Matilda*, op. cit. n. 8.

¹¹ See Figure 14.1 below.

¹² 'Waltzing Matilda', The National Library of Australia, available at <http://www.nla.gov.au/epubs/waltzingmatilda/2-Versions.html>.

¹³ 'However other part of the opponents' evidence suggest that the town of Kyuna which is considerably closer to Dagworth than is Winton has also promoted itself as connected with the song': *Winton Shire Council v Lomas* (2000) 51 IPR 174, 176.

individual should be given exclusive rights to use the words as a trade mark? This is an issue that is broader than 'Waltzing Matilda'. It is a question that affects any symbol or sign that is part of Australia's national identity or is seen as a cultural icon.

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⁹ J Marx, 'The Meaning of Waltzing Matilda', *Sydney Morning Herald*, 23 July 2007, available at http://blogs.smh.com.au/thedailytruth/archives/2007/07/the_meaning_of_waltzing_matild.html. See also Radic, op. cit., pp. 5–6.

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¹³ 'However other part of the opponents' evidence suggest that the town of Kyuna which is considerably closer to Dagworth than is Winton has also promoted itself as connected with the song': *Winton Shire Council v Lomas* (2000) 51 IPR 174, 176.

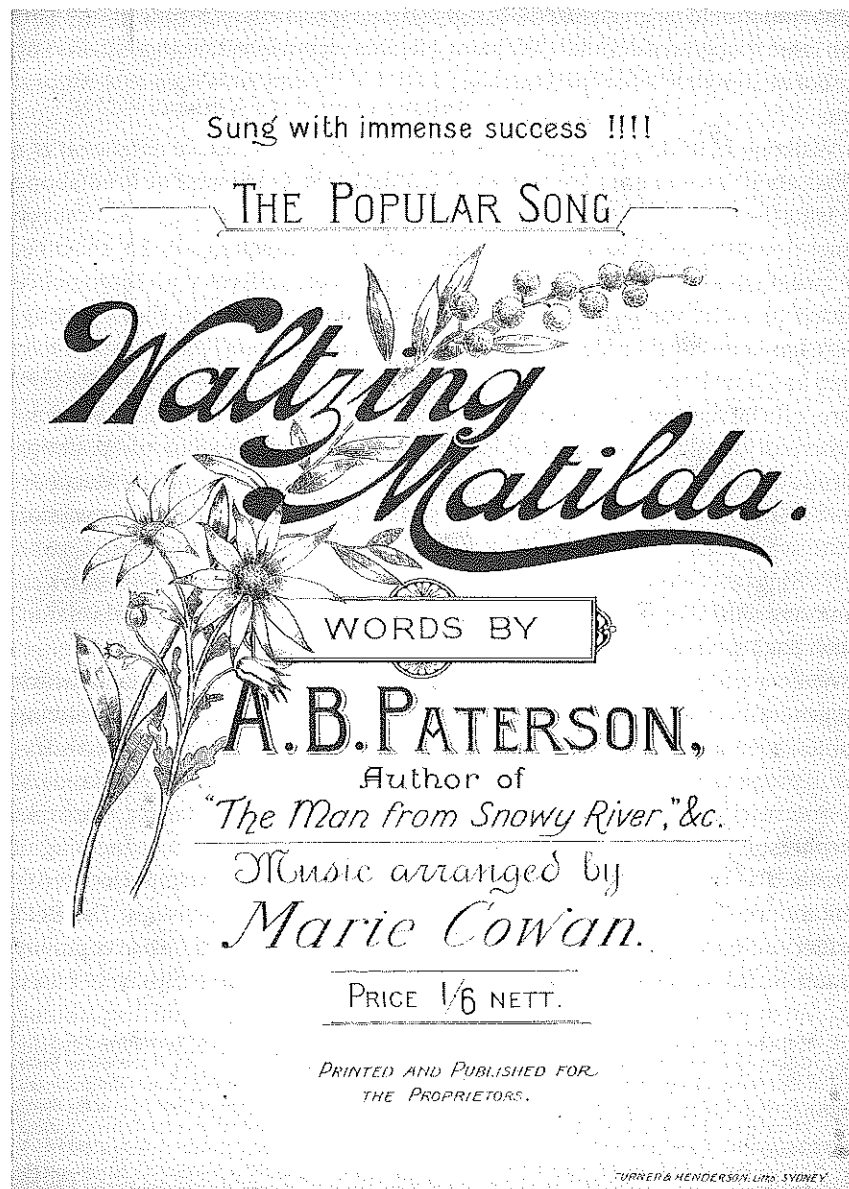


Figure 14.1 Cover of Marie Cowan's 1903 arrangement of 'Waltzing Matilda' nla.mus-an7412026-s1-v, National Library of Australia

on a shearers' strike that had taken place at Dagworth Station in 1894. After the striking shearers had set fire to a woolshed and fired guns in the air, three policemen chased a man named Samuel Hoffmeister. However, rather than letting himself be captured by the police, Hoffmeister committed suicide by shooting himself at a waterhole on the station.

Waltzing Matilda

Once was a swag-man camped in the billabong, Under the shade of a Coolibah tree, And he sang as he looked at the old billabong, Who'd come a waltzing Matilda with me. Who'll come a waltzing Matilda with me, My dar, who'll come a waltzing Matilda with me, And lead up a waltz, who'll come a waltzing Matilda with me.

2nd Verse
Down came a grumbuck to drink at the billabong, He jumped the swagman & grabbed him with a plea, And he said as he put him away in the tucker bag "You'll come a waltzing Matilda with me."

3rd Verse
Down came the squatter a-riding his thoroughbred, Down came policemen, one, two and three, Whose is the grumbuck you've got in the tucker bag? You'll come a waltzing Matilda with me.

4th Verse
But the swagman he up & he jumped in the water-hole, Growing himself by the Coolibah tree, And his story may be heard as it sings by the billabong, Who'll come a waltzing Matilda with me.

Chorus: Who'll come

Figure 14.2 Christina Macpherson's transcription of 'Waltzing Matilda', c. 1895, NLA MS 9065, National Library of Australia

While the provenance of the song may be unclear, its subsequent popularity cannot be disputed. In addition to its widespread popular appeal, the song also has also had some influential supporters. For example, Sir Winston Churchill is reported to have played the song to General de Gaulle, describing it as 'one of the finest songs in the world'.¹⁴ For good or bad, 'Waltzing Matilda' is often seen as being quintessentially Australian. As one commentator noted, 'Waltzing Matilda has become known throughout the world, or at least a large portion of it, as the

Song of Australia'.¹⁵ This is reflected in the fact that when 'Waltzing Matilda' was wrongly played in the victory celebrations for the Australian sprinter Marjorie Jackson at the Helsinki Olympics in 1952, the Finnish Government said that it thought 'Waltzing Matilda' would be recognised by everyone as an Australian song, whereas 'Advance Australia Fair' and 'God Save the Queen' would not.¹⁶

Interestingly, particularly for a song widely seen as reflecting the independent Australian spirit, the international popularity of 'Waltzing Matilda' has been attributed to the decision of the English author Thomas Wood to publish the song in his *Cobbers* book.¹⁷ Wood's version of 'Waltzing Matilda', along with his many subsequent arrangements for combinations of voices and instruments, were regularly used by schools, piano and voice classes, glee clubs, choral societies and orchestras. As well as helping to make the song a hit outside of Australia, Wood also earned substantial royalties.¹⁸

Despite, or possibly because of, the anti-authoritarian nature of the lyrics, the song is said to represent the 'official spirit' of Australia, or at least a version thereof.¹⁹ For many years, the song was closely associated with the Australian national identity. It was linked to the Diggers in World War I, used in ceremonial military parades, and played at official functions.²⁰ Along with Ned Kelly, the swagman of 'Waltzing Matilda' is seen as 'an outcast of both urban and rural society' who is celebrated 'as a national icon'.²¹ While the song's popularity may have waned, it still occupies a special place in Australian culture. This can be seen in the failed attempts by various (Labor) governments to have 'Waltzing Matilda' recognised as the Australian national anthem. Although the song has never received the ultimate imprimatur of being officially recognised as Australia's national anthem (although 'Waltzing Matilda' was played at the Montreal Olympic Games), as Prime Minister Paul Keating said at the 'Waltzing Matilda' centenary dinner held in Winton in 1995, 'Waltzing Matilda' was Australia's official 'unofficial' national song.²²

Given the enduring popularity of the song, it is not surprising that it has been appropriated for a variety of purposes including as the name of sporting teams (the Matildas), as a mascot for the 1988 Commonwealth Games, and as a name of the highway that spans between Barrington on the New South Wales border to Normanton in the Gulf of Carpentaria. The name and associated imagery have

also been used to promote a variety of goods and services including service stations, internet service providers, film production companies, boat cruises, wine estates and luxury motorhomes. Many of these names have been registered as trade marks. The enduring power of the Matilda brand has also been used as a way of luring tourists to western Queensland. Indeed this was one of the motives for the establishment of the Waltzing Matilda Centre at Winton in 1998.²³ In 1995, to celebrate the centenary of the first performance of the song, the Queensland Government with the Winton Shire Council staged a centenary celebration in Winton.²⁴ As a result of the success of that celebration, the council subsequently established the Waltzing Matilda Centre in Winton as a permanent celebration of the song and the history that surrounds it and the region. The centre, which was the idea of 'Queensland Events' and funded by the Queensland Government, aims to promote and celebrate the centenary of the first public performance of the song.²⁵ Described as the 'only centre in the world dedicated to a song',²⁶ it is said to show the song's continuing relevance and centrality in Australian culture.²⁷ It is also testament to the ongoing commercial appeal of the song, a theme to which we will return to below.

The Waltzing Matilda litigation

In the mid-1990s, Tasmanian woman Brenda Lomas decided to set up a nation-wide franchised chain of restaurants. One of the main characteristics of the restaurants was that they were to have an Australian theme. To highlight the Australian theme, Lomas decided that the restaurants should operate under the name WALTZING MATILDA. Lomas sought to register the mark WALTZING MATILDA in classes 29, 30, 31, 35 and 42 for a variety of foodstuffs, franchising and restaurant services. The application was filed on 20 November 1997.

Winton Shire Council and the Waltzing Matilda Centre opposed Lomas' application on the grounds that the trade mark would be likely to deceive or cause confusion (s 43), the applicant was not the owner of the trade mark (s 58) and the trade mark was similar to a trade mark that had already acquired a reputation in Australia (s 60). The trade marks officer, Terry Williams, found that the song 'Waltzing Matilda' belonged to and indicated Australia as a whole. He also found that the song was part of the heritage of all Australians. This did not prevent him, however, from finding that the words could function as a trade mark. It also did not prevent him from finding that the opposition failed on all grounds.

Before the Trade Marks Office, the council and the centre argued that given the reputation of Winton and the centre as representatives and custodians of the

¹⁵ *ibid.*, p. 24.

¹⁶ Radic, *op. cit.*, p. 9.

¹⁷ *Cobbers: A Personal Record of a Journey from Essex in England, to Australia, Tasmania and Some of the Reefs in the Coral Sea, Made in the Years 1930, 1931, and 1932*, Oxford University Press, London, 1934.

¹⁸ *The Mirror* in Sydney reported in February 1971: 'The widow of the musician [Wood] who made 'Waltzing Matilda' a hit left a personal estate valued at \$799 835'. See 'Waltzing Matilda Widow's \$799 000', *Mirror* (Sydney), 10 February 1971.

¹⁹ B West, 'Crime, Suicide and the Anti-hero: "Waltzing Matilda" in Australia' (2001) 35 *Journal of Popular Culture* 127.

²⁰ See May, *op. cit.*, p. 12: 'So national a symbol has it become that it is used in the Navy, Army and Air Force at their ceremonial parades all over the world and not the least, by any means, was when the Coronation Contingent of Australian troops mounted guard at Buckingham Palace during the week prior to the Coronation of her Majesty the Queen Elizabeth II.'

²¹ West, *op. cit.*, p. 137.

²² Radic, *op. cit.*

²³ For a history of the centre see *Winton Shire Council v Lomas* (2002) 56 IPR 72, 76.

²⁴ The first public performance of 'Waltzing Matilda' was at a banquet for the Premier of Queensland held at the North Gregory Hotel in Winton in April 1895.

²⁵ *Winton Shire Council v Lomas* (2000) 51 IPR 174, 176.

²⁶ Waltzing Matilda Centre, <http://www.matildacentre.com.au/InteractiveTour.html>.

²⁷ West, *op. cit.*

history of the song, the use of the trade mark by Lomas would be likely to deceive or cause confusion and thus fall foul of s 43.²⁸ It was argued that at the filing date, the public would have expected that 'Waltzing Matilda' was affiliated with Winton in some way or another. It was also argued that the connotation between Winton and 'Waltzing Matilda' was inherent in the mark because of the strong and widely known historical links between the town and the song. The delegate of the Registrar did not agree. It was accepted that a significant number of people were familiar with the history of the song and that the council and the centre had built on this in promoting the bush or Australian aspects of their activities in relation to accommodation, food and drink; nonetheless, the Registrar held that the song had outgrown both its origins and any possible exclusive links with either opponent. As a song, it belonged to and indicated Australia as a whole.²⁹ While the song may have belonged to Australia, this did not mean that the title of the words WALTZING MATILDA could not function as a trade mark. That is, there was no reason why WALTZING MATILDA could not distinguish a trader's goods or services that had no connection with either the song or the Winton area. It was held that there was nothing that suggested that when Lomas used the words WALTZING MATILDA as a trade mark for the specified goods or services this inherently denoted any sort of affiliation between Lomas' goods or services and the town of Winton, the council or the centre. Therefore, the opposition under s 43 failed.³⁰

The council and the centre also opposed the application under s 58, which provides that a trade mark may be opposed on the basis that the applicant is not the owner of the mark in question. This was based on the fact that at the filing date of the application, the council had already held the centenary celebrations for the song and also begun construction of the centre. In promoting the yet-to-be-opened centre, the council had a clear intention that the centre would operate as a tourist attraction dedicated to the song. Winton Shire Council also had a very definite intention to put on a unique cultural event. The council had sought extensive sponsorship for the event and the centre from a wide range of companies and government agencies. Despite this, it was held that the connections between the opponents and those funding or sponsoring bodies, and between the opponents and the public who saw the promotion of the to-be-opened centre, were not relationships involving the use of a trade mark for either goods or relevant services. Instead, the words WALTZING MATILDA were used as the name of the upcoming centre, not as an indication of an offer to trade in, or to designate the origin of, goods or relevant services either then on offer or to be offered. On this basis it was held that if there was trade mark use by the centre prior to the priority date, that the use was limited to use as a cultural centre,

which was 'a far cry from any commerce under a trade mark used in relation to food or to any of the services specified in the current application'.³¹

The council and the centre also relied on s 60 of the *Trade Marks Act* to oppose Lomas' application. This provides that a trade mark may be opposed on the basis that another trade mark had acquired a reputation in the mark before the priority date, such that if the first mark was registered it would be likely to deceive or cause confusion. Because of the finding that WALTZING MATILDA belongs to and is part of the heritage of all Australians, however, it was unlikely that anyone would think that there was an affiliation between either the applicant or her goods and services and the opponents. This was the case even if the applicant opened a restaurant in Winton (whether franchised or not) or if stores in Winton sold Lomas' goods. Any speculation that arose about Lomas' marks causing confusion would primarily be due to the proximity or other circumstances of trade, not to the trade marks at issue.³²

The council and the centre appealed the decision to the Federal Court.³³ Again, the council and the centre relied on s 43 to argue that the proposed use of WALTZING MATILDA was likely to deceive or cause confusion. As before the office, this argument was rejected by the court. Spender J held that the respondent's proposed use of the mark WALTZING MATILDA on or in respect of any of the goods or services only brought to mind the 'Waltzing Matilda' song. At most, the use of the mark was only likely to convey to the reasonable member of the public the Australian nature of those goods and services. On this basis Spender J held that there was no connotation of a connection with the centre at Winton, the town of Winton or the council. As such, he held that there was no deception or confusion.³⁴

While Spender J rejected the arguments made in relation to s 43, he did accept the council's opposition in relation to ownership of the mark in respect of prepared foodstuffs in classes 29 and 30 and in respect of all services claimed in class 42 (restaurant services). Although the council and the centre had not coined the term 'Waltzing Matilda', it was held that they had better rights to ownership of the trade mark in respect of those goods and services than Lomas. The council and the centre established that they had used the mark 'Waltzing Matilda' in relation to the tourist centre in Winton from March 1998 and in respect of the centenary celebrations in 1995. In this context, the question was not whether there had been use of the mark 'Waltzing Matilda' by the applicants. Rather the question was whether there had been any use prior to the priority date in respect of any of the goods or services the subject of the opposed application. In response to this question, the council and the centre were able to provide evidence of

²⁸ This provides that an application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

²⁹ (2001) 51 IPR 174, 179.

³⁰ *ibid.*

³¹ *ibid.*, p. 179.

³² *ibid.*, p. 180.

³³ (2002) 56 IPR 72. The hearing is a complete re-hearing of the matter, with each party entitled to rely on new evidence and is not, strictly speaking, an appeal. See s 197 of the *Trade Marks Act 1995*. On appeal, the Winton Shire Council and the Waltzing Matilda Centre relied on each of the grounds before the office, and also that fact that it was an identical trade mark (s 44).

³⁴ (2002) 56 IPR 72, 78.

their intent to use 'Waltzing Matilda' prior to the priority date of the trade mark application.

In October 1997 – which was prior to both the opening of the centre and the priority date of Lomas' application – the council had produced and circulated a brochure calling attention to 'The Waltzing Matilda Centre'. Relevantly, the brochure referred to an aspect of the proposed activities at the centre: 'Savour old fashioned, home baked bush fare at the Country Kitchen'. The council also placed an advertisement in the RACQ travel and accommodation guide, which was headed 'THE WALTZING MATILDA CENTRE' and showed a rural scene. The advertisement included the caption: 'Visit the Waltzing Matilda General Store for unique souvenirs and the Waltzing Matilda Country Kitchen for a traditional homestead meal'. Spender J held that this was evidence of use, 19 days prior to the priority date, that was sufficient to establish that Lomas was not the first user of the trade mark (and therefore not the owner) in connection with prepared foodstuffs and restaurant services.

Lomas sought leave to appeal Spender J's decision to the Full Court of the Federal Court.³⁵ On appeal, the council and the centre only pursued the arguments in relation to proprietorship. The other grounds, including arguments about deception and confusion under s 43, were not pursued.³⁶ As a result, the main issue argued on appeal was in relation to the ownership of the mark. More specifically, the issue that was addressed on appeal related to the question of what constitutes a use of a trade mark prior to registration.

Given that it is settled law that it is not necessary that there be an actual dealing in goods bearing a trade mark before there can be said to be use of that mark as a trade mark, the issue in the case was whether the brochure and the advertisement constituted use of the trade mark. The Full Court rejected Spender J's analysis and conclusions. In deciding that there had not been any use prior to registration, the court highlighted the fact that in talking about the Country Kitchen the brochure did not mention 'Waltzing Matilda'. The court also noted that when the Country Kitchen commenced operations in April 1998 it was called the 'Coolibah Country Kitchen'. On this basis the court held that the reference to 'Waltzing Matilda' in connection with the Country Kitchen in the advertisement was no more than a reference to the proposed facility within the centre. The court also held that the lack of consistency in the way the council used 'Country Kitchen' gave rise to an inference that the council had taken some time to decide the name which the restaurant would trade under.³⁷ The fact that in the advertisement Winton had separated the proposed facilities such as the 'country kitchen' and the 'souvenir shop' and then subsequently named the country kitchen the 'Coolibah Country Kitchen' suggested that the 'Waltzing Matilda' name applied to the centre rather than to every component within it.³⁸

³⁵ (2003) AIPC 35,165.

³⁶ *ibid.*, p. 35,167, para. 5.

³⁷ *ibid.*, p. 35,173, para. 42.

³⁸ *ibid.*, p. 35,173, para. 43.

Protection of icons

On one level *Lomas v Winton Shire Council* is a straightforward application of trade mark principles. Except for the question of whether permission should be granted to appeal a decision of a single judge on appeal from a registrar's decision on opposition proceedings,³⁹ there is little that is doctrinally interesting about the decision. When we look at the decision more generally, however, it offers a number of insights both into the legal and political processes that regulate the use of signs, words and images, as well as how intellectual property law deals with objects of cultural heritage more generally.

In Australia, a range of different names, images, symbols and logos are deemed to be so important, whether for cultural, social or political reasons, that they are not able to be appropriated for private use.⁴⁰ In some cases public outcry against the use of a name has ensured that the symbols are not appropriated for private ends.⁴¹ A number of more formal mechanisms have also been used to ensure that culturally significant signs are not appropriated for private use. In addition to general causes of action such as passing off or those provided by the *Trade Practices Act*, specific provisions have also been used to protect specific signifiers. One of the ways this has been done is by limiting the types of marks that are able to be registered. This includes the arms, flag or seal of the Commonwealth or of a state or territory; and the arms or emblem of a city or town in Australia or of a public authority or public institution in Australia. A number of specific words are also unable to be registered including Austrade, CES, Olympic Champion, Repatriation, Returned Airman, Returned Sailor, Returned Soldier⁴² and ANZAC.⁴³

In some cases, non-trade mark mechanisms have also been used to protect specific items of cultural heritage. Perhaps the most well-known example is the special protection given to Donald Bradman, primarily as a result of the intervention of the then Prime Minister John Howard. The controversy over the

³⁹ See *Special Effects Ltd v L'Oréal SA* [2007] EWCA Civ 1 (CA), para. 57.

⁴⁰ There is specific protection in New Zealand for culturally significant words and symbols. See O Morgan, *Protecting Indigenous Signs and Trade Marks under the New Zealand Trade Marks Act 2002*, University of Melbourne Legal Studies Research Paper No. 80, 2004.

⁴¹ An example includes the 2002 decision of Athletics Australia to call the national athletics team 'The Diggers'. The ensuing public outcry led Athletics Australia to issue an apology and drop the name. Similar problems arose with the playing of the 'The Last Post' on the last Ansett flight and the naming of ANZAC Bridge in Sydney. Advisory Council on Intellectual Property, *The Protection of National Icons*, 2002, p. 3.

⁴² *Trade Marks Act 1995*, s 39(2) provides that certain signs may not be registered; reg 4.15 prescribes the relevant signs. The signs are specified in Sch 2 of the *Trade Mark Regulations 1995*, Sch 2(f). See Advisory Council on Intellectual Property, *ibid.*, p. 19.

⁴³ ANZAC is protected by the *Protection of the Word 'ANZAC' Regulations* which prevent the Registrar of Trade Marks and the Registrar of Designs from registering trade marks and designs, respectively, which include the word ANZAC. The word ANZAC is also prohibited from being the name or part of a name of a registered corporation unless permission is granted by the Minister for Veterans' Affairs under s 147 of the *Corporations Act 2001* and regs 2B.6.01, 2B.6.02, 5B.3.01, 5B.3.02 and Sch 6 of the *Corporations Regulations 2001*. The word ANZAC is also protected under the *Customs (Prohibited Imports) Regulations 1956*. Item 13 of Sch 1 of those regulations prohibits absolutely the importation of 'Goods the description of which includes the word ANZAC or bearing the word ANZAC or a word so nearly resembling the word ANZAC as to be likely to deceive.' Advisory Council on Intellectual Property, *op. cit.*, p. 18.

use of the Bradman name arose in 2001 after a road in Adelaide was renamed Sir Donald Bradman Drive in recognition of Bradman's cricketing achievements. Unsurprisingly, businesses on the renamed road started to use the Bradman name in relation to their businesses. While the use of the Bradman name to promote private commercial ends created a degree of public controversy, it was the renaming of a sex shop 'Erotica on Bradman' that caused the greatest concern. To prevent this from continuing, the *Corporations Regulations 2001* were amended to ensure that no company name is able to be registered if, in the context in which it is proposed to be used, it suggests a connection with Sir Donald Bradman that does not exist.⁴⁴

Over time, many different types of words, names, logos and symbols have been deemed to be too important to allow them to be reserved to the exclusive use of a single trader by trade mark registration. This has not been the case, however, with 'Waltzing Matilda'. The fact that 'Waltzing Matilda' has not been signalled out for special treatment means that it

remains, a ready tool for anyone who cares to exploit it, whether it's the tourist industry reaching for dollars in desperate country towns, or earnest nationalists intent on installing the swaggie as a hero of the working class, or the winner of the recent Spirit of Matilda poetry competition who has Matilda walking not a few tortuous miles, or God help us all, those who now want to harness it to the Sydney Olympics and the Federal Centenary celebrations.⁴⁵

That is certainly the position in Australia, having regard to the reasoning of the trade marks office and the court, in the *Lomas* case. What those decisions also suggest, however, is that use of the name on or in connection with goods or services that are not Australian would be misleading. As Spender J recognised, the words WALTZING MATILDA are likely to convey to the reasonable member of the public the Australian nature of goods and services. This raises a question of whether an application by a trader who is not Australian, or in respect of goods or services that are not Australian, whether in Australia or overseas, would be able to be successfully opposed. It also raises the issue of if so, who has standing to be able to bring the opposition proceedings and argue that the words belong to and indicated Australia as a whole and are part of the heritage of all Australians.

The fate of 'Waltzing Matilda', particularly when compared to the approach that has been taken to other iconic names and figures such as Bradman and ANZAC, can be attributed to the song's anti-authoritarian sentiment. There is also a sense in which the fate of the song has been affected by its strong class

association. In this context it is important to note that Paterson wrote 'Waltzing Matilda' in a period where there was high level of class conflict between pastoralists, who were attempting to secure their hold on grazing land, and the growing underclass of farm labourers and itinerant workers, who were struggling to survive. This was a time where for 'a swagman or rural labourer at the time, killing one of the squatter's numerous sheep for food was thought of as a natural and a legitimate activity'.⁴⁶ The approach that has been taken towards 'Waltzing Matilda' is captured in Peter Carey's comment that Australians' attitudes to Ned Kelly tend to divide along class lines:

I would think that the people who call him simply a horse thief and a murderer are in an absolute minority . . . By and large, they're the genteel types who care what the British think about them – the same people who won't have Waltzing Matilda as their national song.⁴⁷

The fact that 'Waltzing Matilda' has not been given any special protection has not been overlooked. For example, in its 2002 report *The Protection of National Icons* the Advisory Council on Intellectual Property said that 'Waltzing Matilda' meets even the most stringent example of possible for classification as a national icon.⁴⁸ The council recommended that in recognition of its special status as an Australian cultural term, 'Waltzing Matilda' should be declared a non-exclusive trade mark under the *Trade Marks Act 1995*. This provision was meant to be similar to s 18 of the *Trade Marks Act* that prohibits the registration or use of a trade mark while preserving any rights in trade marks that were registered or used in good faith before the date of commencement of the regulations.⁴⁹

There are a number of reasons that might be given to justify why trade mark law should be amended to ensure that 'Waltzing Matilda' is not able to be appropriated for commercial ends. The concerns that have been raised about the negative impact of allowing registration of national icons such as 'Waltzing Matilda' is part of a wider concern that 'the law [is moving] more and more of our culture's basic semiotic and symbolic resources out of the public domain and into private hands'.⁵⁰ The main concern here is that culturally important words, names and songs may be the property of a few who have secured exclusive rights, rather than available to all to whom those words, names and songs have meaning and are important.

Another argument that is made against allowing trade mark protection for icons such as 'Waltzing Matilda' is that it undermines the values that these icons

⁴⁴ Sir Donald Bradman granted all rights to his name, likeness and image to the Bradman Foundation, a not-for-profit charitable trust. 'In this case what was required was the limitation of the commercial use of the name *Bradman* to use by those associated with Sir Donald Bradman, e.g., the Bradman Foundation wished to continue to exploit the name to raise money for its activities . . . Inclusion in the *Corporations Regulations* gives much broader protection but would not, e.g., prevent further trade mark registrations or its use as a business or trading name. Similar issues have arisen in relation to commercial use of the name May Gibbs.' Advisory Council on Intellectual Property, *ibid.*, p. 2.

⁴⁵ Radic, *op. cit.*, p. 9: 'only a marriage to the great Australia God of sport saved it from getting stuck with the leftist intellectuals of the folk music revivals of the 1950s.'

⁴⁶ West, *op. cit.*, p. 131.

⁴⁷ N O'Reilly, 'The Influence of Peter Carey's True History of the Kelly Gang: Repositioning the Ned Kelly Narrative in Australian Popular Culture' (2007) *Journal of Popular Culture* 488, 494.

⁴⁸ Advisory Council on Intellectual Property, *op. cit.*, p. 8.

⁴⁹ *ibid.*

⁵⁰ M Madow, 'Private Ownership of Public Image: Popular Culture and Publicity Rights' (1993) 81 *California Law Review* 127, 142. See also D Lange, 'Recognizing the Public Domain' (1981) 44 *Law & Contemporary Problems* 147; R Cooper Dreyfuss, 'We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity' (1995–6) 20 *Columbia VLA J L* 123.

embody. Here the fear is that inappropriate use of the icon may dilute, diminish, or bring the word, name, tune or image, along with the reputation of anyone related to it, into disrepute. In some cases the disrespectful treatment of national icons, because of their close association with national history, traditions and values, has provoked reactions of outrage and distress. In the same way in which allowing a sex shop to be called 'Erotica on Bradman' discredits the Bradman legacy, so too allowing a restaurant or fast food outlet to name itself after a national icon undermines and trivialises the legacy of the song.⁵¹

While a number of arguments can be made in favour of ensuring that trade mark law should be changed so that cases such as *Lomas v Winton Shire Council* do not arise again, there are a number of counter-arguments that need to be taken into account. In this context it may be helpful to heed the salutary advice that has been given about the protection of icons.

Paramedics are reporting a marked increase in the amount of people collapsing from icon overload, and several major population centers are now in danger of becoming engulfed by what a leaked government report describes as a 'national icon epidemic' . . . The icon glut is due chiefly to the definition of the term now being so loose that it will sleep with absolutely anybody.⁵²

One issue that was raised but not clarified by the decision, which is relevant to both the applicant and the opponents in the case, is whether the term 'Waltzing Matilda' could operate as an indicator of origin or of particular qualities of a product or service. The claim made by the council and the centre to 'Waltzing Matilda' was based on a kind of geographical indication: Winton was close to the place where the song was written and where it was first publicly performed. As the Trade Mark Registrar said, however, most Australians would not recognise that Winton had any better claim to 'Waltzing Matilda' than other places in Australia. This was because 'the association of Waltzing Matilda with the town of Winton is not known by the public at large. Reports of the Winton Waltzing Matilda centenary celebrations in the press would have been quickly forgotten'.⁵³ Questions could also be asked about whether Lomas was able to overcome the fact that the song, both its words and tune, is instantly recognisable as Australian. Its themes appeal to a romantic notion of the Australian outback; it is arguably part of the Australian identity, a marker of our social and cultural attitudes, part of our nation's cultural heritage, and a clear cultural signature. With this cultural baggage, does this mean that it is impossible for 'Waltzing Matilda' to denote a particular trader's goods or services? That is, is 'Waltzing Matilda' so closely connected to the Australian identity that it is not able to operate as an indicator of a particular trader or origin or an indicator of quality? In a sense, the question

is, is it possible for a sign to become geographically generic? While the trade marks officer found that the song 'Waltzing Matilda' belongs to and indicates Australia as a whole, this did not prevent him from finding that the words could function as a trade mark. While he held that it was possible for 'Waltzing Matilda' to operate as a trade mark, the issue was not addressed on appeal. It is, however, an issue that goes to the heart of the question as to whether iconic signs are able to be protected as trade marks.

Many of the arguments made against allowing trade mark protection for cultural icons such as 'Waltzing Matilda' are based on the romantic belief that the song was not only written at a time when you could leave your back door unlocked, but also that it was written when the malign influence of commerce had not yet had a chance to influence our cultural practices. As with many of the arguments made about the negative impact of commercial practices on our cultural heritage, the argument that we need to protect 'Waltzing Matilda' from commercial ends presupposes that until recently the song has been untouched by financial considerations. One of the interesting things about 'Waltzing Matilda' is the fact that it has long been connected with commercial interests.

The fact that Paterson sold copyright in 'Waltzing Matilda' to Angus & Robertson for £5 shortly after it was published ensured that the story was treated as an object of trade and commerce.⁵⁴ More importantly, commercial ends have also played a role in shaping the modern version of the song. Following his appointment as an Indian representative to the Melbourne International Exhibition of 1880–81, the Scottish merchant James Inglis set up a company to import Indian tea into Australia. The tea was sold as 'The Billy Tea' (which was subsequently registered as a trade mark) and marketed using an image of a swagman boiling his billy. In 1902, Inglis asked the librarian of the Sydney Book Club if he knew of a verse which the company could use to market The Billy Tea. The librarian replied: 'There's some stuff of Banjo Paterson's in Mr Robertson's office that nobody seems to bother about'. These included 'Waltzing Matilda' which Inglis felt was well suited to advertise The Billy Tea.⁵⁵ In 1903 Inglis & Co paid Angus & Robertson five guineas for copyright in 'Waltzing Matilda'. In order to enhance the advertising appeal of the song, Marie Cowan, wife of the manager of Inglis & Co, was asked to alter the lyrics of 'Waltzing Matilda' so that they better promoted The Billy Tea.⁵⁶ As well as changing the lyrics and music of the song written by Paterson in 1895, to help with brand identification 'billy' was capitalised and placed in inverted commas to become 'Billy'.⁵⁷ Cowan's revised lyrics, which form the basis of the popular contemporary version of the song, are as follows:

⁵⁴ C Roderick, *Banjo Patterson: Poet by Accident*, Allen & Unwin, St Leonards, 1993, p. 87.

⁵⁵ Maggoffin, *Fair Dinkum Matilda*, op. cit. n. 8, p. 119.

⁵⁶ Roderick, op. cit., p. 87; Richardson, op. cit. n. 8, p. 85.

⁵⁷ The 1903 sheet music clearly shows 'Billy', not only with a capital B, but also in inverted commas to signify its product status. J Safran, 'Waltzing Matilda, Courtesy of a Tea-leaf Near You', Age, 20 December 2002, available at <http://www.johnsafran.com/pdf/waltzingmatilda.pdf>.

⁵¹ It also has been suggested that the use of the word 'Diggers' in relation to a sports team was not accepted by the Australian community because the use of the word, in association with sport, served to 'dilute or trivialise the horrendous sacrifice and loss suffered by Australian and New Zealand Defence Force personnel in the First and Second World Wars.' Advisory Council on Intellectual Property, op. cit., pp. 2–3.

⁵² J Schembri, 'The Age of Icon Overload', Age, 5 August 2005, available at <http://www.theage.com.au/news/opinion/the-age-of-icon-overload/2005/08/04/1123125852965.html>.

⁵³ *Waltzing Matilda Centre Ltd v Jolly Swagmen Pty Ltd* (2002) 58 IPR 499.

Once a jolly swagman camped by a billabong
Under the shade of a coolibah tree
and he sang as he watched and waited till his 'Billy' boiled
Who'll come a waltzing Matilda with me?

This is in contrast to the original lyrics which read:

Once a jolly swagman camped by a billabong
Under the shade of a coolibah tree
and he sang as he looked at the old billy boiling
Who'll come a waltzing Matilda with me?

The revised words and music, replete with one of the earliest examples of product placement in Australia,⁵⁸ were printed by Allan and Co, the music printer and publisher, and distributed with packages of The Billy Tea.⁵⁹

Another argument that may be made against treating 'Waltzing Matilda' as a special case draws upon arguments made in other contexts about the creative role that traders play in popular culture. For example it has been suggested that '[t]raders who seek to negotiate the line between expressive meaning and trade marks should not be penalised for the contribution to popular culture'.⁶⁰ Whatever merits these arguments have in other contexts, they have little to say about the fate of 'Waltzing Matilda'. The reason for this is that the *Waltzing Matilda* case is not an instance where the trader's proposed use of the name as a trade mark would add to popular culture; so much as the trader is parasitic on popular culture, they are merely appropriating the sign and associated imagery for their own commercial ends.

Another point highlighted by the fate of 'Waltzing Matilda', which is not so much a counter-argument to the push to deny trade mark protection for 'Waltzing Matilda' so much as a call for additional considerations, is that while trade mark protection does have the potential to undermine the iconic sign, on reflection, it seems that we should be as worried about the use that is made of copyright and the role that it might play in restricting the way that we interact with our national icons as with trade marks. The reason for this is that copyright owners have the potential to censor use of the song. For example, an author of a book written about 'Waltzing Matilda' in 1955 complained that the copyright owners in the lyrics refused to allow him to reprint the words of 'Waltzing Matilda'.⁶¹

Similar problems have also arisen in relation to 'Advance Australia Fair'⁶² and 'Happy Birthday'.⁶³

Conclusion

The central question at the heart of *Lomas v Winton Shire Council* is the extent to which a cultural sign can function as a trade mark. That is, to what extent can 'Waltzing Matilda' be the subject of exclusive rights granted to a registered owner? It is this issue which the Winton Council and Waltzing Matilda Centre sought to resolve through the trade mark oppositions and various court proceedings. Underpinning the opposition was a desire to protect the words so that they would remain available for all Australians, to prevent them from being reserved for use for a select few. Ultimately those efforts met with no success, as the words are clearly distinctive and capable of distinguishing goods or services. It was clear that there was no legislative basis on which it could be said that the words could not operate as a trade mark. The centre also lobbied the federal government to obtain protection similar to that afforded to other cultural icons, such as ANZAC⁶⁴ and DON BRADMAN.⁶⁵ Again, those efforts met with no success.

While, as we said before, there is little doctrinally interesting about the case, nonetheless it is still interesting in what it tells us about Australian law and the machinations involved in the effort to protect culturally significant signs. In this context, trade mark law pulls in a number of different directions. The ability of the public to use and adapt cultural items needs to be juxtaposed with the need to ensure that the sign and the stories that have developed alongside it are respected, preserved and not tarnished by inappropriate use.

One of the things highlighted by the treatment of 'Waltzing Matilda' is that legal protection is not only about ensuring that a sign is not undermined and discredited. It is also about receiving official imprimatur; the establishment's sign of approval. This can be seen in the comments made in relation to the decision to protect Bradman's name. For example, it was said that adding Bradman's name to the hallowed list assures his status as an icon in the development of a unique Australian identity along with the Queen and the 'Aussie Digger'.⁶⁶

⁵⁸ *ibid.*

⁵⁹ Richardson, *op. cit.* n. 8, p. 134.

⁶⁰ Richardson notes 'the expressive power of the law, its capacity as a kind of prestige dialect to foster desirable social attitudes and behaviour, could work better in promoting a healthy relationship between trade marks and language.' M Richardson, 'Trade Marks and Language' (2004) *Sydney Law Review* 193, 220.

⁶¹ May, *op. cit.* See also J Greenway, 'Folklore in Australia' (1957) 70 *The Journal of American Folklore* 202, 203. The SA Film Commission made a nine-minute animated film using 'Waltzing Matilda' – paying royalties to a NY company if it were played in the US as rights were assigned over. Radic, *op. cit.* n. 8, 9.

⁶² For discussion of some of the copyright-related problems in relation to 'Advance Australia Fair' and 'Australia Land of Ours', see M Minell, *A Nation's Imagination: Australia's Copyright Records, 1854–1968*, National Archives of Australia, Canberra, 2003, pp. 132–3. Minell refers to a Hansard report from 30 April 1942 in which a 'member of the House of Representatives expressed concern that APRA was collecting royalties for broadcasting *Advance Australia Fair*'. The Prime Minister, Mr Curtin, responded that the claim for copyright had been reviewed and reported on by a parliamentary committee but that the report had not been presented to the Parliament, which was occupied with the war. However, a memo dated 29 November 1942 indicates that Hon Arthur Calwell (then Minister for Information) had arranged that *Advance Australia Fair* and, in some cases, the British and American national anthems would be played in picture theatres.

⁶³ On the copyright in 'Happy Birthday', see K McLeod, *Owning Culture: Authorship, Ownership and Intellectual Property Law*, Lang Publishers, New York, 2001, p. 50.

⁶⁴ See n. 43 above.

⁶⁵ See n. 44 above.

⁶⁶ H Black, 'Corporations Law Goes into Bat for Bradman' (2000) 4 *Telemedia* 97.

In a similar vein it was also said that the amendments to the *Corporations Law* in 2000 ‘confirms Bradman’s unique status among his diehard Australian fans and elevates the protection of his name to a statutory level.’⁶⁷ Given the anti-authoritarian sentiment of ‘Waltzing Matilda’, in many ways it is perhaps fitting that it has not been given any special protection. Is it better that ‘Waltzing Matilda’ gains the legal imprimatur, like Bradman and ANZAC, or is it better to be left to the vagaries of the public domain where it is free to be used by anyone? What would Paterson have found worse: the fact that the song was being used to sell food to tourists in a remote Queensland town,⁶⁸ or the fact that for a small fee you can get a Slim Dusty rendition of ‘Waltzing Matilda’ as a ringtone for your mobile phone?⁶⁹ As in the case itself, the key question here is who is entitled to own and control the sign. Should it be Paterson as author of the original song? If so, what stake does Marie Cowan have in the revised lyrics? What of Winton as the place where the song was first performed? Should the name ‘Waltzing Matilda’ be controlled by those who spend the time and effort adapting the sign to promote their specific trading ends? Or should it be the Australian public?

⁶⁷ *ibid.*

⁶⁸ According to one report, Paterson was not overscrupulous about what and where he published. Greenway, *op. cit.*

⁶⁹ Or that Paterson’s creation has been merged with Qantas, which was founded in Winton, to create the Qantilda Museum?