

## TRADE MARKS ACT 1995

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by Citigroup Inc to registration of trade mark application 1138173(36) - **CF CITY FINANCE LOANS & CASH SOLUTIONS** - filed in the name of Lou Pozzebon.

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<b>DELEGATE:</b>	<b>Jock McDonagh</b>
<b>REPRESENTATION:</b>	<b>Opponent: Trevor Stevens, Davies Collison Cave Patent &amp; Trade Marks Attorneys</b> <b>Applicant: Lou Pozzebon, applicant in person</b>
<b>DECISION:</b>	<b>2009 ATMO 04</b> <b>Section 52 opposition: sections 43, 44 and 60 not established, registration proceeding. Costs awarded against opponent</b>

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#### Background

1. Mr Lou Pozzebon ('the applicant') filed an application to register a trade mark, current details of which appear below:

**Application number:** 1138173  
**Filing date:** 26 September 2006  
**Specifications:** Class: 36 Monetary affairs  
**Trade mark:**



2. The trade mark was accepted for possible registration, under the provisions of the *Trade Marks Act 1995* ('the Act'), and advertised for opposition purposes. Citigroup Inc ('the opponent') filed a Notice of Opposition under section 52 of the Act, objecting to the registration of the trade mark. The opponent served and filed evidence in accordance with the *Trade Marks Regulations 1995* after which the matter was set down before me, a delegate of the Registrar of Trade Marks, for a hearing on 16 October 2008, in Sydney.

#### Evidence

3. The following evidence was filed and served pursuant to the Act:

<b>Declarant</b>	<b>Status</b>	<b>Date, Known as</b>	<b>Exhibits</b>
<i>Evidence in Support</i>			
Sara Blotner	Assistant Secretary of opponent	4 March 2008, Blotner	A to H

### **The Hearing**

4. The applicant appeared in person, assisted by his wife. The opponent was represented by Trevor Stevens of Davies Collison Cave Patent and Trade Marks Attorneys.
5. The Notice of Opposition cited most grounds of opposition available to the opponent under the Act; however, in his submissions Mr Stevens, for the opponent, only relied upon the grounds of opposition under sections 43, 44 and 60. For the sake of completeness, my reading of the evidence indicates that none of the other grounds of opposition are supported and I find that they have not been established.

### **Discussion**

6. The opponent argued its case in the order of sections 44, 60 and 43 of the Act, so I shall follow that order in this decision.

#### ***Section 44***

7. Section 44(2) of the Act states:

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of services (*applicant's services*) must be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
  - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
  - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar services* see subsection 14(2).

Note 3: For *priority date* see section 12.

Note 4: The regulations may provide that an application must also be rejected if the trade mark is substantially identical with, or deceptively similar to, a protected international trade mark or a trade mark for which there is a request to extend international registration to Australia: see Part 17A.

8. To establish this ground the opponent must show to my satisfaction that it (or indeed, a third party) owns a registered or pending trade mark that:
  - has an earlier priority date than the application;
  - is substantially identical or deceptively similar to the trade mark of the application; and which

- has a specification of services which are similar, or goods closely related, to the services of the application.
9. The opponent cited trade mark registration 981838 – CITIFINANCIAL – registered from 12 December 2003 in class 36 for “Financial services; namely consumer lending; mortgage brokerage; credit and financing services; credit insurance services”.
  10. The cited trade mark has an earlier priority date than the application, and the specification of services in class 36 is similar to those of the application. Therefore the key issue to be decided is whether or not the competing marks are either substantially identical or deceptively similar.
  11. The opponent conceded that the competing trade marks were not substantially identical and that the issue was one of deceptive similarity.
  12. Mr Stevens for the opponent drew my attention to *Australian Woollen Mills Limited v F S Walton and Company Limited* [1937] HCA 51; (1937) 58 CLR 641, Dixon and McTeirnan, JJ, concerning the comparison of trade marks:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard.

13. Mr Stevens also considered the following passage from Windeyer J in *Shell Co (Australia) Limited v Esso Standard Oil (Australia) Limited* (1963) 109 CLR 407 at 416 of particular significance:

The deceptiveness that is contemplated must result from similarity; but the likelihood of deception must be judged not by the degree of similarity alone, but by the effect of that similarity in all the circumstances.

14. The opponent submitted that the following matters should be taken into account when assessing all the circumstances:
  - The central feature of the applicant's mark is the words CITY and FINANCE.
  - The words CITY and CITI are phonetically identical.
  - The words CITY FINANCE and CITIFINANCIAL are substantially identical.
  - The words LOANS & CASH SOLUTIONS do not diminish the degree of similarity between the applicant's and opponent's cited marks.
  - The single distinguishing feature of the applicant's mark is the CF initials and circle logo.
15. The opponent highlighted the renown of the opponent within the identical services as for the applicant's mark. It was submitted that a wide range of the Australian public constituted the relevant market for financial services and that there would be a likelihood that a large number of persons would be caused to wonder whether it might not be the case that the two products came from the same source.
16. The applicant submitted that the renown of the opponent would militate against confusion, as the market was familiar with the CITI prefix to the opponent's various products. The different get up and wording of the applicant's trade mark would distinguish the trade mark from that of the opponent.
17. In assessing the question of deceptive similarity I have considered the relevant tests, including comparing the opposing trade marks by their look and sound, with due allowance for imperfect recollection.
18. Despite some superficial similarities between the opposing marks, there are other factors that would militate against confusion. The application includes a device element unique to its mark and fancy script quite different to the stark and business-like script of the opponent's cited mark and family of trade marks. Additionally, unlike the CITIFINANCIAL trade mark (and notwithstanding the ordinary English

word CITY is phonetically identical to the made-up prefix CITI-), the applicant's trade mark contains the word CITY in its correct spelling.

19. Consequently, I find I am not satisfied there is a real tangible risk that a number of persons would be caused to wonder whether the relevant services dealt with under the two trade marks came from the same source. I thus conclude that the opposed trade mark is not deceptively similar to the registered CITIFINANCIAL mark and the section 44 ground of opposition based on registration 981838 is accordingly not established.

### **Section 60**

20. Section 60 of the Act (as it stood at the date the opposed trade mark applications were filed<sup>1</sup>) is reproduced below:

The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

21. It is for the opponent to point to a trade mark, whether registered or in common law use, which:
- is either substantially identical with, or deceptively similar to, the trade mark of the application
  - before the priority date, had acquired a reputation in Australia; such that
  - use of the applicant's trade mark would lead to deception or confusion.
22. I have already determined that the application is not deceptively similar to the opponent's trade mark. The opponent has conceded, and I agree, that the marks are not substantially identical. Therefore, this ground of opposition cannot be established.

### **Section 43**

23. Section 43 of the Act provides:

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

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<sup>1</sup> See *Apple Computer Inc v Todaytech Group Ltd* [2007] ATMO 80

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.

24. The opponent referred to the relevant authorities to submit that connotation, or secondary meaning, must exist within the trade mark under consideration and not by comparison with another trade mark.
25. The opponent contended that the words CITY FINANCE stand out in the application and carry a connotation that the applicant's services originate with or are connected in some way in the course of trade with the opponent, Citigroup Inc.
26. Section 43 looks to the inherent qualities of the trade mark of which registration is sought for the purposes of identifying whether the use of the trade mark would be likely to deceive or cause confusion: *Big Country Developments Pty Ltd v TGI Friday's Inc* (2000) 48 IPR 513.
27. As I noted in *Playboy Enterprises International v Auszan Pty Ltd* (2006) 68 IPR 332:

It is apparent that a sign contained within a trade mark might contain a deceptive or confusing connotation if it resembles or signifies a particular sign which is so ubiquitous, of longstanding, or notorious that it has entered Australian parlance or is shown to have become accepted generally in Australia as connoting a particular person, entity or event or connoting a particular meaning (whether or not that particular sign has trade mark significance).

28. I am not satisfied that the use of the words CITY FINANCE connote any deceptive suggestion that the mark has any connection with Citigroup Inc or its products. In my opinion, most ordinary persons encountering the applicant's trade mark would merely note the primary meaning, that being the business name and the fact that it lent money. This ground of opposition is not established.

### **Decision**

29. Section 55 of the Act provides:

#### ***Decision***

**55.** Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

30. No ground of opposition has been established and so I direct that the application be registered one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been discontinued, or in the event of a decision from the Court, that the application be subject to its orders.

### **Costs**

31. Both parties requested their costs in the matter. The opposition having not been established, I order that the opponent pay the applicant's costs according to the official scale.

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
19 January 2009