



TRADE MARKS ACT 1955
DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS

Re Opposition by Richard and Jo-Anne Meldrum and Hot Tuna Pty Ltd to
Registration of Application number 481688 in the name of Frank Grego

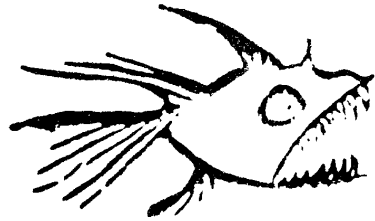
Background

On 30.11.89, trade mark application 481688 was advertised accepted for registration. The application is in the name of Frank Grego, whom I will identify from this point simply as "the applicant", and the goods specified in the application are "casual clothing, including beachwear, including T-shirts, singlets, sweatshirts, shorts, shirts and tracksuits". The trade mark the subject of the application, which was lodged on 17.2.88, is as below



Registration of that application has been opposed, as provided for by sub-section 49(1) of the Trade Marks Act 1955, by Richard and Jo-Anne Meldrum and Hot Tuna Pty Ltd, whom I will refer to collectively as "the opponent" from this point, on grounds which are generalised and which I will not recite at length as they were not all pursued. Suffice it for the moment to say that the opponent now claims that the application is blocked by a deceptively similar

mark (number 437143) registered to Richard and Jo-Anne Meldrum as of 28.11.85 in respect of all goods in the clothing class. The mark thus relied on is as below:



The opponent also claims in general terms that the application should be refused in any case as use of the applicant's mark would be likely to deceive or cause confusion - the registration of such marks being, the opponent argues, proscribed by section 28 of the Act.

After the service of the opponent's evidence in support, the applicant failed to serve evidence in answer to the opposition and the matter was set down for hearing on 29.10.91. Neither the applicant nor the opponent was represented, but the opponent lodged written submissions prepared by its patent attorney, Spruson and Ferguson.

Opponent's evidence in support.

This consists of three trade declarations from traders in surf clothing. I will quote the respective declarations, to the effect that:

"I have known the HOT TUNA brand for surf clothing for approximately 6 years and have known their FISH LOGO for the same length of time. In the surf industry the word PIRANHA is very much accepted as belonging to HOT TUNA surfwear."

"I have been aware of HOT TUNA and their FISH Design ever since I began my business" (6 years). "In fact I was aware of HOT TUNA and their FISH Design for many years before that. The HOT TUNA fish is always called PIRANHA by the trade and by customers. If I saw the word PIRANHA or PIRANHA BEACH on surf clothing it would make me think of HOT TUNA."

"I always refer to the HOT TUNA Fish Logo as a PIRANHA. I have some HOT TUNA stock which uses the PIRANHA Fish Logo alone.

Decision

I will say at the outset that I have no evidence of trade mark use of the registration owned by Richard and Jo-Anne Meldrum, and I will not infer that this is the fish logo to which the opponent's declarants refer. If the opponent wishes to claim that its business activities are

such that buyers of their goods are now of a particular belief, there should be clear evidence as to exactly what trade mark or marks is involved. Nor is there evidence before me that would impugn the applicant's claim to proprietorship.

In the final outcome I am able to decide the application under section 33 of the Trade Marks Act, of which sub-section 33(1) provides that:

Subject to this Act, a trade mark is not capable of registration by a person if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same goods, of goods of the same description as those goods or services that are closely related to those goods, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

The goods of the present application are simply a subset of the larger range covered by registration 437143, and so the question under section 33 hinges on the similarity of the two marks. In the interests of brevity I will simply say that the two marks are not substantially identical and turn to the question of deceptive similarity.

Section 6(3) of the Act provides that:

For the purposes of this act, a trade mark shall be deceptively similar to another trade mark if it so nearly resembles that other trade mark as to be likely to deceive or cause confusion.

The Act itself is silent on just what sorts of deception or confusion are such as would prevent registration under section 33, but cases such as *De Cordova v Vick Chemical Co* (the VAPORUB case) (1951) 68 RPC 271 show that adopting the essential or distinguishing feature of an earlier trade mark is such a situation.

In that case, Lord Radcliffe noted that

in most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole.

In the recent case of *Dial An Angel Pty Ltd v Sagitaur Services Systems Pty Ltd* (1990) AIPC 90-687 Wilcox J reviewed the relevant authorities, including *De Cordova v Vick* (supra). At p36,401 of the report Wilcox J concludes that marks may be deceptively similar if one mark seizes an essential feature or idea of another. He goes on to caution that this is "subject to the qualification that the similarity of an essential feature may be negated by another feature that

tellingly distinguishes the two marks. But that will be difficult, for reasons spelled out in *Jafferjee (Jafferjee v Scarlett (1937) 57 CLR 115)*"

In the present case the two competing marks both comprise an aggressive and grotesquely drawn cartoon fish, depicted swimming left to right, oversize mouth open and displaying a remarkable number of teeth. There are minor differences between the two fish but when I approach the matter in the terms used by Lord Radcliffe (as quoted above) the general impression that will be carried away from either mark is the same. The impression is not, in point of fact, the impression that will be gained from an accurate depiction of a real piranha, but is in both cases consistent with the aggressive nature and savage eating habits these fish are reputed to have.

The general nature of the fish depicted in the earlier mark is only emphasised by the inclusion of the word "piranha" in the applicant's mark, and it is not decisive, because of this, that the word is not actually part of the earlier mark. I note that the words in the applicant's mark place the piranha in the context of, perhaps, a fictional place-name (PIRANHA BEACH) but that is not sufficient to avoid the deception that will arise when the essential idea of a savage fish of the same general nature as the earlier mark is made the centre-piece of the applicant's mark. It may be that deception could be avoided had other words directed the attention of the viewer away from the grotesque and savage fish. Such a view was left open by Wilcox J. in *Dial An Angel*, supra, but that conclusion is not open to me on the two renditions here in question.

I am therefore required to refuse the applicant's mark in the lack of any evidence that might support a claim under section 34 of the Trade Marks Act. In so doing I will however note that if I were required to decide the case under section 28 of the Trade Marks Act on the more general ground of deception or confusion I would find against the opponent in the light of *NSW Dairy Corporation v Murray Goulburn Co-operative Company Ltd* 18 IPR 385 particularly as that case relates to blameworthy conduct.

No submissions were made as to costs and I make no award.

T. Williams
Hearing Officer
24 February 1992