



Trade Marks Act 1955

Decision of a Delegate of the Registrar of Trade Marks

Re: Trade Mark Application 521327 in the name of Lam Soon Oil and Soap Mfg (S) Pty Ltd.

Trade mark application 521327 is in the name of Lam Soon Oil and Soap Mfg (S) Pty Ltd ("the applicant") and the goods specified in the application are "all goods in class 29 including vegetable oils". Material lodged by the applicant's solicitor makes it clear that the goods with which the applicant is primarily concerned are edible oils and fats, shortening and margarine. The trade mark is as shown below.



On examination, two prior registrations were raised as grounds of objection under section 33 of the Act. That section provides, at 33(1), that

Subject to this Act, a trade mark is not capable of registration by a person in respect of goods 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 ... 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.

Section 6(3) of the Act provides that a trade mark will be deemed to be deceptively similar to another trade mark if it so nearly resembles the other as to be likely to deceive or cause confusion.

The two registrations, both in the name of Pura Vegetable Oils (Aust) Pty Ltd ("the cited proprietor"), said to block the application, are:

1. Registration 39480, a mark as below, for salmon only.



2. Registration 446164, which consists of the words GOLD LEAF, for "edible oils and fats and salad dressings".

The applicant's solicitors have waived the right to a hearing and asked that the matter be decided on the written record.

The first of the marks said to block this application is in respect of salmon only. For reasons which are consistent with the decision which follows, I find that the applicant's trade mark is deceptively similar to that registered mark. Under other circumstances it would have been reasonable to allow the applicant time to restrict the goods covered by the application to overcome this objection.

There is, however, a direct overlap between the goods of particular interest to the applicant and those the subject of registration 446164, and nothing to suggest that this overlap can be overcome by negotiation and restriction of the claims of either party. I therefore turn to the question of deceptive similarity between the applicant's mark and that the subject of registration 446164 ("the cited mark").

That question is to be judged in the light of the cases surveyed in *Dial an Angel v Sagitaur Services* 19 IPR 171. From these the correct approach to the present circumstances is as per Lord Parker, in the matter of *Application by Pianotist Co Ltd* 23 RPC 774, approved by the High Court in *Cooper Engineering v Sigmund Pumps*, 86 CLR 536:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

Looked at in those terms it is inconceivable that there will not be widespread deception or confusion if the applicant's mark is used in this country in respect of goods covered by their application, including, inter alia, their goods of interest. The differences between competing marks pale into insignificance under the sheer weight of overall similarity.

The applicant's solicitor wrote to the cited proprietor and asked if it would have any objection to the applicant obtaining registration. While the cited proprietor has ignored all correspondence from the applicant, the objection is not so borderline in terms of similarity of goods or of marks that even the consent of the cited proprietor might tip the scales (Shanahan's *Australian Law of Trade Marks and Passing Off* at page 153).

Therefore, while I do not find the marks to be substantially identical, I find that the applicant's trade mark is deceptively similar to one the subject of a registration of earlier date and made in respect of the same goods. Section 33 stands as a block to its registration.

I note that there has been some export to Australia of goods under the present mark, but there is no suggestion that the applicant had, before the date of the present application, made the sort of extensive and honest concurrent use of its mark that might justify acceptance of the application under the provisions of section 34(1). The factors to be considered under those provisions are further analysed in Shanahan, *supra*, at pages 202 to 207.

Failing this, there is no evidence before me which would allow the applicant to show use before either the date of first use by the cited proprietor or of the making of the original application by that proprietor. The terms of section 34(2), however, are such that an applicant, to succeed there, must show use before both of those dates.

Application 521327 has failed under section 33(1) and is not saved by section 34. I therefore refuse the application.

T. Williams

Hearing Officer
28 October 1992