



## TRADE MARKS ACT 1955

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

Re: Opposition by GOLDEN CRUMPET CO A'SIA (EXTENDED) PTY LIMITED to registration of trade mark application number 596536 in the name of QUALITY BAKERS AUSTRALIA LIMITED

As provided for in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this opposition. Accordingly, unless otherwise specified, any reference to the Act in this decision is a reference to the *Trade Marks Act 1955*.

Trade mark application number 596536 was lodged, on 22nd February 1993, in the name of Quality Bakers Australia Limited (the applicant). The applicant sought registration of the mark GOLDFINGERS in respect of "bakery products including crumpets, pikelets and scones; all other goods in this class", being class 30.

Acceptance of the mark was advertised in the *Official Journal of Trade Marks* of 17th March 1994. On 17th June 1994, Golden Crumpet Co A'sia (Extended) Pty Limited (the opponent) lodged a notice of opposition to registration of the applicant's mark. The opposition was based on a number of grounds. At the hearing, however, the opponent chose to pursue only the grounds based on section 40, that the applicant was not the proprietor of the mark; and on section 33, that the applicant's mark was substantially identical or deceptively similar to the marks owned by the opponent and covered goods of the same description, or related goods.

**The evidence**

The service and lodgment of the evidence in support, answer and reply from the respective parties were completed by 3rd November 1995. The evidence in support comprises a statutory declaration by Robert James Kelly (first Kelly declaration), dated 5th December 1994, together with exhibits RJK-1 - RJK-8. A statutory declaration by Louise Belle Johnson, dated 5th May 1995, with exhibits LBJ-1 - LBJ-4 forms the evidence in answer. The evidence in reply comprises a statutory declaration by Robert James Kelly (second Kelly declaration), dated 3rd November 1995, and exhibits RJK-1 - RJK7.

Mr Kelly, the secretary of the opponent company, has affixed as exhibit RJK1 to his first declaration a copy of a declaration by Brian Robert Simpson, general manager of the opponent company, which had been prepared for the purposes of an earlier opposition to registration of the mark on application 345573, the mark being WYANDRA GOLDEN CRUMPETS. Mr Simpson's declaration sets out in detail the history of the opponent's "Golden" trade marks, which have been used in Australia since 1959. He provides details of the sales bearing the marks from 1965 to 1983, which are updated in Mr Kelly's declaration from February 1990 to July 1994.

Mr Kelly explains that in 1992 the opponent decided to manufacture and market rectangular shaped crumpets and therefore organized to have packages designed for the GOLDEN FINGERS products, which work was completed in early December 1992. A launch for the products was planned for early March 1993. Crumpets bearing the mark were presented to the trade on 25th February 1993 (in his second declaration, Mr Kelly corrects this date to 23rd February 1993). He refers to the extensive advertising and promotion of the "Golden" marks in Australia and draws attention to the expenditure on advertising in Mr Simpson's declaration, as well as the advertising figures for 1991 to 1994 in his declaration. Samples of promotional material are annexed to his declaration.

As a paralegal in the Office of the applicant's solicitors, Ms Johnson states in her declaration that she conducted separate searches of computer records of the Trade Marks Office for all the marks in class 30 which include the word "Gold" and the word "Golden". She annexes

to her declaration results of her searches, including a schedule of the opponent's marks which contain the word "Golden".

In his second declaration, Mr Kelly first declares that the presentation of the mark GOLDEN FINGERS occurred on 23rd February 1993, not on 25th February 1993, as he had indicated in his first declaration. Then he details the preparatory steps carried out by the opponent prior to the presentation. By 19th February 1993, the opponent had forwarded samples of the product for Australian product number symbol testing, and a verification report had issued on 23rd February 1993. Subsequently, submissions were made to Coles Supermarkets for the introduction of the goods onto the market: in Victoria, Queensland and in New South Wales on 1st March 1993, and in South Australia on 8th March 1993.

Quotes for printing of the packaging film for the goods had been sought on 8th December 1992 and arrangements for the printing were finalized by 23rd December 1992. Internal factory orders were raised by the converters and printers for delivery of the printed packaging film on February 1993. Two invoices for the cost of printing the packaging, dated 24th and 25th February 1993, are attached to Mr Kelly's declaration. Sample packs of the product were despatched to New South Wales, Victoria, Queensland, Western Australia and South Australia by 19th February 1993 in preparation for the launches of the product.

The matter was set down for hearing in Sydney on 16th October 1996. Mr Michael Hall of Baker & McKenzie, solicitors and attorneys of Sydney, appeared for the opponent. Mr Brett Doyle of Blake Dawson Waldron, solicitors of Sydney, represented the applicant.

### **Submissions**

By citing *Shell Co (Aust) Ltd v Rohm Haas Co* (1949) 78 CLR 601, Mr Hall said that proprietorship can be established through authorship of the mark, combined with use of the mark in Australia. The opponent was claiming authorship as, at the latest, in August 1992, it had settled on the trade mark GOLDEN FINGERS and had determined to use it in relation to its goods. This submission was supported by statements in paras 9 and 10 and exhibit

RJK-4 of Mr Kelly's first declaration, and in paras 6-11 and exhibits RJK-1 - RJK-7 of his second declaration.

In relation to first user of the mark, Mr Hall relied on the above-mentioned evidence in both Mr Kelly's declarations. In deciding the proprietorship issue, he said, true preparatory steps, accompanied by a firm intention which resulted in use of the mark, had consistently been held to constitute trade mark use in the context of s 23 on non-use and in the relevant section of s 40 of the Act. And in that regard, Mr Hall referred to "*Hermes*" Trade Mark [1982] RPC 425, *Buying Systems (Australia) Pty Ltd v Studio Srl* 30 IPR 517, *New South Wales Dairy Corp v Murray Goulburn Co-op Co Ltd* 14 IPR 26; 16 IPR 289 and 17 IPR 269; and *Settef SpA v Riv-Oland Marble Co (Vic) Pty Ltd* 10 IPR 402 and 12 IPR 321. Notwithstanding the absence of sale of the product prior to the relevant date, the opponent's claim to proprietorship of the mark GOLDEN FINGERS for bakery and hot plate goods at the relevant date was established by the combination of having settled in advance on the trade mark, taking the preparatory steps which involved use of the trade mark directed towards placing the goods in trade, and then the actual selling of the goods, he asserted. In Mr Hall's opinion, this situation was analogous with that in *Buying Systems v Studio*.

On the relevant test of identity of the marks in relation to the proprietorship matter, Mr Hall submitted that the marks GOLDFINGERS and GOLDEN FINGERS were substantially identical. In support, he cited *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994) AIPC 91-049 and *Daimler Industries Pty Ltd v K K Daimaru* (1993) 27 IPR 124.

Turning to the ground based on section 33 of the Act, he said that the opponent did not have an application or registration at the relevant date for the mark GOLDEN FINGERS, and therefore the comparison related to any or all of the list of the prior "Golden" marks entered in Mr Kelly's first declaration. The declaration showed that the opponent had a long history of "Golden" marks in respect of the relevant goods, and in this connection Mr Hall directed my attention to *Re Hardings Manufactures* 8 IPR 147, where the mark had been opposed by the present opponent. In that case, he stated, the Chief Assistant

Registrar had examined the history of use of the marks by the opponent and had accepted that the opponent had achieved a degree of reputation and recognition of its “Golden” marks.

In light of the test on s 33 by Evershed J in *Smith Hayden & Co Ltd's Appn* (1946) 63 RPC 97, Mr Hall said there was no doubt that the applicant's goods were the same goods, or, alternatively, goods of the same description, as the goods of the opponent's “Golden” marks listed in the evidence. Concerning the question of substantial identity or deceptive similarity of the marks, he pointed out that the comparison was not of the word GOLDFINGERS and GOLDEN FINGERS, but of the word “Golden” to GOLDFINGERS, or of any other of the opponent's registered composite marks containing the word “Golden” with GOLDFINGERS. Consequently, the “imperfect recollection” principle was to be applied here, as set out in *Rysta Ltd's Appn* (1943) 60 RPC 87. It was also important to take notice of the relevant parts of the marks, i.e. the fact that the applicant's mark, which incorporated the idea or the essential element of the opponent's mark, could be held to be substantially identical or deceptively similar to it, notwithstanding the presence of other material in the mark. In this case, he submitted, the “Gold” or “Golden” element constituted the idea of the opponent's marks, therefore less weight was to be afforded to the less distinctive element in the subject mark - the “Fingers” element, and more weight was to be given to the first part of the mark. As a series of “Golden” marks were associated with the opponent, a person encountering the subject mark would be led to believe the product bearing the mark was simply a new product in the established series.

Mr Doyle, on behalf of the applicant, submitted that use of the trade mark by the opponent occurred one day after the priority date of the present application, and that the test for establishing priority was based on commercial use or first lodgment of the application. Whatever preparatory steps might have been taken by the opponent, those steps would not have been sufficient to establish proprietorship until there was actual commercial use or lodgment of a trade mark application which would be consistent with the cases handed down by the High Court. Referring to *Buying Systems v Studio*, supra, Mr Doyle said that the facts in that case fitted in entirely with the position of the High Court decision in

*Moorgate Tobacco Co Ltd v Philip Morris Ltd* (1984) 156 CLR 414, as expounded by the Senior Assistant Registrar in an unpublished decision of 14th December 1988, on application number 404455 - *Alphapharm Pty Limited v Syntex Corporation*. The public user in *Buying Systems* was constituted by the various steps set out by Gummow J, including the printing of business cards and the soliciting of advertising so that the opponent was developing a reputation in the trade mark. Those were public acts as opposed to mere preparations for the launch of a product. That type of reputation, he submitted, was capable of being defended in a passing off action, as found in *Fletcher Challenger Ltd v Fletcher Pty Ltd* [1981] NSWLR 196, where it was held that an announcement in the press about an intended merger between two companies constituted sufficient reputation, even though the companies had not reserved the company name in time.

In distinguishing the opponent's position before the launch of the product, Mr Doyle referred to the absence of advertisements and the fact that an application for a bar code was not a necessary step for selling a product, nor was the ordering of material for packaging. It was the normal practice that until a launch of new products the products were in fact kept secret from competitors, he said, and therefore none of the activities set out in the opponent's evidence could be regarded as public use of the mark. He maintained that Gummow J in *Buying Systems v Studio*, supra, had reiterated the position taken by the High Court in *Moorgate Tobacco v Philip Morris*, also supra. Mr Hall, however, contested Mr Doyle's interpretation of the relevant words of Deane J in the latter case, asserting that two quite separate alternatives had been expressed by his Honour in relation to the relevant user to establish proprietorship: actual trade or offer to trade, or existing intention to offer or supply the goods in trade. The opponent's evidence showed public steps in the sense of communications with the parties, he explained, not something that was happening secretly. It seemed to him that the hearing officer was asked to find that there was an unspoken rule to be drawn from the discussed cases, that the use required for s 40 was not use of a trade mark as defined in the *Trade Marks Act 1955*, but some additional form of public use.

In relation to s 33 of the Act, Mr Doyle referred to Mr Hall's comments on *Hardings* case, supra, saying that there did not appear to be any reference on the extent of the reputation of

the word “Golden”, where the word was included in the marks under consideration. The hearing officer had drawn the conclusion that, in the context of comparing the registered trade marks GOLDEN CRUMPET with the mark WYANDRA GOLDEN CRUMPET, she could not disregard the word “golden” for the purpose of comparison of the marks. Notwithstanding that those registrations contained a disclaimer of the word, she needed to take the word into account in comparing the marks. The context of that case also showed, Mr Doyle remarked, that the trade marks in question basically had in common the element GOLDEN CRUMPETS, WYANDARA being a geographical name. He stressed the different nature of the marks, i.e the fact that the subject mark did not contain the word “golden”, and that there was no relevant comparison between GOLDFINGERS and any of the opponent’s prior marks.

In the applicant’s submission, he continued, the comparison was not one which could be done in isolation, but it had to be a comparison in the context of the state of the Register and in the context of previous decisions from Courts and the Registrar. He commented that Mr Hall had described the opponent’s marks as a family of marks. Many of these marks were, in fact, revisions of the same mark, having increased the prominence of the word “Golden” in those marks. Applying the criteria considered in *Hardings* case, supra, Mr Doyle argued that the exhibits affixed to Ms Johnson’s declaration showed that, in addition to the “Golden Crumpet” marks, most of which disclaimed the word “Golden”, there were also marks incorporating the word “Golden” owned by George Weston Foods Limited, which covered goods of the same description, or the same goods. Moreover, given that there were so many other marks containing the word “Golden”, it was not open to the opponent to allege that nobody else can register a trade mark incorporating the word “Golden”, if that trade mark also contained additional material to distinguish the opponent’s registered trade marks. He posed the question: if that was the case in respect of marks consisting of the word “Golden” plus something else, how much more so must it be for the present trade mark, which did not contain the word “Golden” but the word “Gold”, particularly when the present trade mark had a completely different connotation to it which was much more likely to occur to the purchaser? He also reminded me that the applicant had a registration for the mark GOLDEN BAKE and a pending application for the same mark.

In responding briefly to Mr Doyle's submissions, Mr Hall said that in *Hardings* case, supra, the hearing officer had found the word "Golden" to be the prominent feature, the feature that would be carried away and retained and, more importantly, it would be used in identifying the goods the purchasers desired to obtain. She had expressed the view that the goods on which the mark appeared would be known by the simple and obvious name "golden". In light of these conclusions, Mr Hall believed the reputation of the word "golden" and the importance of the "golden" element could not be ignored for the purpose of comparing the marks.

Both parties sought costs.

## **Decision**

### *Proprietorship - section 40*

In disputes concerning rights to proprietorship, the parties must be claiming the same mark, or one which is almost the same - see *Tavefar Pty Ltd v Life Savers (A'asia)* (1988) 12 IPR 159; *Carnival Cruise Lines v Sitmar Cruises*, supra, and *Karu Pty Ltd v Jose* (1994) AIPC 91-101. When comparing the present marks side by side (see *Shell Co [Aust] Ltd v Esso Standard Oil [Aust] Ltd*, [1961] 109 CLR 407), only minor differences emerge between the marks: one word GOLDFINGERS as opposed to two words GOLDEN FINGERS. Given that both prefixes in the marks, "Gold" and "Golden", inter alia, convey the meaning of being or consisting of gold, or coloured like gold, and the other element FINGERS being identical, I consider the marks to be substantially the same.

The concept of proprietorship of a trade mark has been explained by McGarvie J in *Settef v Riv-Oland* 10, supra, IPR 402, at p 413:

"Acquiring proprietorship

...

The basic common law principle is that the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark there: *Re Registered Trade Mark "Yanx"*; *Ex parte Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at 203; *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at 603; *Moorgate Tobacco Co Ltd v*

*Philip Morris Ltd (No 2)* ALJR 77 at 83. A person who becomes proprietor of a trade mark in this way is entitled at common law to restrain a person who later commences to use the trade mark.

In considering who, within s.40(1) of the Act, was at the time of Settef's application for registration the proprietor of the trade mark, one considers who at common law was the proprietor in Australia: *The Shell Co of Australia Ltd v Rohm & Haas* (1949) 78 CLR 601 at 625 and 627. Settef claims to be the first person to have used the trade mark in Australia and therefore to have been proprietor at common law in Australia."

The right to claim proprietorship of a mark within the meaning of sub-section 40(1) therefore depends on first use of the mark in Australia.

The opponent has based its claims to proprietorship on its decision to market rectangular shaped crumpets under the mark GOLDEN FINGERS and the preparatory work carried out before the actual presentation of the mark to the public, on 23rd February 1993 - a day after the present application was lodged. This preparatory work primarily comprised organizing the artwork for the packaging and printing of the packaging film. Mr Hall has argued that this preparatory work involved use of the mark directed towards placing the goods in trade and therefore constituted use of the opponent's mark. The opponent itself had originated the mark and through the preparatory steps it had acquired prior right in the mark in Australia.

It has been established that use of the mark within the meaning of section 6 of the Act may occur before the commercial launch of the product. Guidance on what constitutes use may be found in *Moorgate Tobacco v Philip Morris* and *Settef v Riv-Oland*, both supra. In the former case, Deane J, speaking for the High Court, said, at pp 433-434:

"The cases establish that it is not necessary that there be an actual dealing in goods bearing the trade mark before there can be a local use of the mark as a trade mark. It may suffice that imported goods which have not actually reached Australia have been offered for sale in Australia under the mark (*Re Registered Trade Mark "Yanx"*; *Ex parte Amalgamated Tobacco Corporation Ltd* [(1951) 82 CLR 199 at 204] or that the mark has been used in an advertisement of the goods in the course of trade: *Shell Co. of Australia v. Esso Standard Oil (Australia) Ltd.* [(1963) 109 CLR 407 at 422]. In such cases, however, it is possible to identify an actual trade or offer to trade in the goods bearing the mark or an existing intention to offer or supply goods

bearing the mark in trade. In the present case, there was not, at any relevant time, any actual trade or offer to trade in goods bearing the mark in Australia or any existing intention to offer or supply such goods in trade. There was no local use of the mark as a trade mark at all; there were merely preliminary discussions and negotiations about whether the mark would be so used.”

In *Buying Systems v Studio*, supra, subsequent to deciding on a need for a new magazine in Australia, the opponent had arranged the printing of business cards and letterheads. The opponent had then approached potential advertisers with a view to obtaining subscriptions and placing advertisements in its publication. It was able to demonstrate that some potentially interested parties had been informed of the planned new fashion magazine before the relevant date by personal contacts, a business card bearing the mark, and a letter stating the launching date of the first edition of the magazine, which was to be preceded by an extensive promotion. Taking into account all those activities, Gummow J found that the opponent had adequately established relevant use of the mark in Australia for the purpose of indicating or so as to indicate a connection in the course of trade between it and the new magazine.

Turning again to *Moorgate Tobacco v Philip Morris*, supra, Deane J enunciated, at p 432:

“The prior use of a trade mark which may suffice, at least if combined with local authorship, to establish that a person has acquired in Australia the statutory status of “proprietor” of the mark, is public use in Australia of the mark as a trade mark, that is to say, a use of the mark in relation to goods for the purpose of indicating or so as to indicate a connexion in the course of trade between the goods with respect to which the mark is used and that person.”

The prior use of the mark must therefore be public commercial use. By obtaining the approval of the bar code, arranging and completing the artwork for packaging of the product and its actual printing, as evidenced in Mr Kelly’s declarations and the supporting exhibits, the opponent has demonstrated that it was engaged in a careful planning and preparation before releasing the product on the market. In this process, the opponent’s mark was exposed only to the persons involved in the allocation of the product number symbol and designing and printing of the packaging of the product. The mark was not in any manner revealed to members of the purchasing public so as to attract sale of the goods. Thus, while the opponent has established an intention to use the mark, it has failed to take

that additional step which is necessary to demonstrate “an existing intention to offer or supply goods bearing the mark in trade”, i.e. use of the mark in the course of trade, as was successfully done in *Buying Systems v Studio*, supra, where, before the date in question, the mark had actually been introduced to some persons for the purpose of soliciting trade.

At this point, I must also emphasize that the tests for proprietorship under the provisions of s 40 are not the same as those applied to s 23, as acknowledged by Mr Doyle, therefore the present matter can be distinguished from use of the marks considered in *New South Wales Dairy v Murray Goulburn*, supra (see *Syntex v Alphapharm*, supra).

As a result of my above consideration, I find the opponent has failed to establish a case for proprietorship of the mark.

### *Section 33*

In the absence of a prior application or registration for a substantially identical or deceptively similar mark for the same goods or goods of the same description, for the purpose of the grounds based on section 33, the opponent has relied on registrations of its family of “Golden” marks in respect of the same goods or goods of the same description as those of the present application, all of which consist of or contain the word “Golden”. On the other hand, the applicant has made submissions, supported by evidence, that the word “Golden” is included in other proprietors’ marks which are registered for the same goods or goods of the same description.

The marks under consideration must be viewed in their entirety (see *Clark v Sharp* [1898] 15 RPC 141). Of the seven opponent’s relevant registrations, five trade marks also include a device of a grotesque chef in addition to the word “Golden”, whereas the remaining two marks simply comprise the word “Golden”. Whilst the word “Golden” is the common and essential element in all those trade marks, I do not concede that the applicant’s mark is substantially identical or deceptively similar to any of those marks, having regard to the same idea conveyed by the prefix “Gold” appearing in the mark, which must bear more weight than the remaining part of the mark, as argued by Mr Hall. The subject mark forms one

word GOLDFINGERS which, and here I agree with Mr Doyle's view, is likely to be associated in the minds of the potential buyers with the villain "Goldfinger" of Ian Fleming's 1959 thriller, made popular through the James Bond film in the 1960's. I am also aware of the word "gold-finger" as denoting a person's third or ring finger (*Oxford English Dictionary*, 2nd edition). In light of these circumstances, and contrary to the opponent's submissions, the significance of the principles of deception or confusion of the marks based on similar ideas engendered by the marks as considered, for example, in *Jafferjee v Scarlett* (1937) 57 CLR 115, on essential or distinguishing feature being incorporated in the conflicting marks - *De Cordova v Vick Chemical Co* (1951) 68 RPC 103, or on vague recollection as to the exact nature of the marks - *Rysta Appn*, supra, are, in my opinion, of little consequence. Even though, the word "Golden" might be "carried away and retained" and could be "the source of some name or verbal description by which buyers will express their desire to have the goods" (*Australian Woollen Mills Ltd v F S Walton & Co Ltd* [1937] 58 CLR 641, at p 658), as concluded in the *Hardings* case, supra, there are sufficient structural, aural and conceptual differences between the marks under consideration to extinguish any likelihood of deception or confusion.

In *Australian Law of Trade Marks and Passing Off*, 2nd edition, by D R Shanahan, the author states, at pp 178-179, that, if the same element in a mark occurs frequently in other marks in the trade, then, for the purposes of comparison to determine whether the marks are deceptively similar, that element in the marks must be to some extent disregarded. In support of this proposition, the author refers to *Holmes v Finn Blinds* (1987) AIPC 90-454 and many other cases. In Ms Johnson's exhibits LBJ-2 and LBJ-4, the applicant has provided details of thirty-four registrations in class 30 for marks which contain the word "Golden" and which are owned by twenty-three different proprietors. The word has been disclaimed in respect of a number of these registrations. I note that these marks have been registered in face of the opponent's marks, which, the opponent asserts, are in conflict with the applicant's mark.

Given the commonality of the word "Golden" in the trade, the connotation of the word "Goldfinger" which, I believe, would be recognized in the relevant circles of the purchasing

public and the dissimilarities between the marks, as discussed previously, I therefore conclude the applicant's mark does not offend against the provisions of s 33 of the Act.

**Conclusion**

I find that the opponent has not succeeded in respect of the grounds argued at the hearing. I therefore dismiss the opposition. Subject to any appeal from my decision, the mark of this application should proceed to registration.

I award costs in the matter of these proceedings to the applicant.

Vija Zars  
Hearing Officer  
14th February 1997