



TRADE MARKS ACT 1955
DECISION OF A DELEGATE OF THE REGISTRAR OF
TRADE MARKS, WITH REASONS

Re: Opposition by Chocosuisse Union Des Fabricants Suisses De Chocolat to the registration of trade mark application number 597696 in the name of Effem Foods Pty Limited.

Background:

After examination, trade mark application 597696 was advertised as having been accepted for registration. The applicant is Effem Foods Pty Limited, which I will refer to simply as “the applicant” from this point.

The mark in question is the word SUISSANDE and the goods specified in the application are:

Rice, pasta, cereal and cereal preparations; tea; coffee, cocoa, coffee essences and coffee extracts, mixtures of coffee and chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery, chocolate, chocolates; pastries, cakes, biscuits, bread, ices, ice cream, and frozen confections.

Registration of the application is opposed by Chocosuisse Union Des Fabricants Suisses De Chocolat (“the opponent”). The opposition process has followed the course set out in the regulations. Both sides served evidence to support their positions and the opposition came on for hearing and decision by me, as a delegate of the Registrar of Trade Marks.

At the hearing, the applicant was represented by Mr Gerard Skelly, solicitor, of the firm of Baker and McKenzie. The opponent was represented by Mr Andrew Lockhart, a solicitor of the attorney firm of Spruson and Ferguson.

Issues

The grounds of opposition on which the opponent relies can be summarised as: the applicant's mark is likely to deceive or cause confusion, would be contrary to law or otherwise not entitled to protection in a Court of Justice. Mr Lockhart also relied on a general ground, that the mark is not a registrable trade mark, and on the exercise of the Registrar's discretion.

Mr Lockhart did, however, stipulate that the opponent had concerns only about chocolate and "chocolate related" goods, ie those containing chocolate or cocoa or cocoa butter. His ultimate aim was to convince me that these goods should be excluded from the statement of goods. In the alternative, he argued that the trade mark should be registered only for such goods produced in Switzerland.

Before descending into the specifics of the opposition, let me note that, under the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* apply to this opposition. Accordingly, the provisions to which I will refer, below, are those of the 1955 act.

Under the terms of that legislation, Mr Lockhart pursued various arguments. The first of these was aimed at showing that the applicant's trade mark was not an invented word. This addressed the registrability test under s 24(1)c of the 1955 act.

Mr Lockhart argued that SUISSANDE is too close, in the senses proscribed by the legislation, to the word SUISSE. The latter is listed in the *Macquarie* and *Oxford* dictionaries as meaning either Switzerland or Swiss. Mr Lockhart also emphasised the opponent's evidence, which tends to show that Switzerland has a reputation as a source of chocolate. Mr Skelly conceded that such a reputation exists.

The hinges of Mr Lockhart's arguments are the look and sound of the mark.

As to the first of these, he argued that the element "suiss" in the mark would be immediately equated with the English word Swiss, or with Suisse, the French word for Swiss. Mr Lockhart

stressed, in his submissions at the hearing, the reason for this. He argued that the mark, “in having no meaning as a whole” (emphasis added in his written submissions), would form an immediate and initial impression of the prefix *suiss*. This was because the mark naturally divided into two elements.

On the question of the probable pronunciation of *SUISSANDE*, in the opponent’s view it was ‘*swee-sond*’. He did not accept the opinion of the applicant’s declarant, Ms Rhonda Steele, that “*swee-son-dee*” or “*swee-sond*” were options. In Mr Lockhart’s view, “*swiss-ond*” or “*swiss-and*” are the only likely outcomes.

Mr Lockhart was critical of the framing of Ms Steele’s declaration. He noted that she was the Marketing Property Manager of the applicant, yet she was somewhat equivocal about the possible pronunciation. However, my view is that there can be no criticism of this. The simple fact is that the mark is unused in Australia and therefore it is hard for anyone without expert qualifications to do more than argue about likely pronunciations. It would have been quite wrong for Ms Steele to be categorical about pronunciation of the word *SUISSANDE*. That word is a complete unknown in a country where there are two ways of pronouncing even known words such as “Newcastle”.

For my own part, I find no particular reason to dispute any of the options put up.. However, since it does not affect the decision to which I have come, I will assume that Mr Lockhart is correct and test the applicant’s mark against the *Trade Marks Act 1955* on the assumption that it will be pronounced “*swiss-ond*” or “*swiss-and*”.

Mr Lockhart noted that, as per *London Lubricants (1920) application*, (1925) 42 RPC 279, the beginning of a word is commonly accentuated and the ending slurred. From this, he argued that the addition of *ANDE* was trifling.

To this he added the reminder that the goods in question were often low-cost consumable items. Initial perception was thus very important, with “*Suiss*”, or *Swiss*, emerging very strongly as the dominant element. The last letter was either silent or slurred.

He went further, contending that, in the view of the opponent, the net result of this was a mark that, to the ear, was very close to “swiss er lond”.

In some respects, I agree with Mr Lockhart. So, in part, did Mr Skelly.

Mr Lockhart stipulated, firstly, that:

To be an invented word, within the meaning of the Act, a word must not only be newly coined, in the sense of not being already current in the English language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning, to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it.

Here he relied on *Philippart v. William Whitely Ltd.* - the DIABOLO case - 25 RPC 565 at p.569. He then fortified his argument by reference to other long-standing case law. He argued that the importance of considering whether a trade mark conveys any meaning, in assessing whether it is an invented word, has been confirmed in the Australian High Court cases of *Schweppes Ltd v Rowlands Pty Ltd (1930)* 16 CLR 162 and the ROHOE case - *Howard Auto-Cultivators Ltd v Webb Industries Pty Ltd (1946)* 72 CLR 175.

In the former case, he noted that the High Court found that SARILLA was merely a colourable variation of the word sarsaparilla and was therefore not an invented word in respect of mineral and aerated waters. The SARILLA case, he asserted, is much like the present case. In SARILLA there was evidence that "sar" was a well-known abbreviation for sarsaparilla, as is Swiss for Switzerland. Secondly, SARILLA was found to be a mere contraction of the known word sarsaparilla.

From this, Mr Lockhart went on to assert that it could similarly be argued that SUISSANDE is formed from “swiss er lande” (pronounced “lond”). This was on the basis that the French word “lande” (pronounced “lond”) is French for moor or land. I note that, according to the *Oxford English Dictionary* (second edition), the word “lande” is known in English: “A tract of wild land, a moor. Used by Eng. writers chiefly with reference to S. W. France. √

As Mr Lockhart argued, the word is also French and is used to derive words such as *Irelande* or *Hollande*. There are, as he noted, many French-speaking people in Australia.

Decision

I must say that I can follow Mr Lockhart's argument no further. It stretches relevant case law and common sense to say that *SUISSANDE* has any obvious meaning to the ordinary Australian. I have allowed, as I said, for the opponent's claimed pronunciation. Even given this, it will not do to analyse to the abnormal extent that Mr Lockhart has done. The relevant test is to be applied to the mark as a whole, in the context of the goods, as seen and bought by the relevant buyers.

It oversimplifies the matter to claim that the ending *ANDE* is just a short and meaningless syllable. It is far from meaningless, in my opinion, if it is sufficient to bridge the gap between *SUISSANDE* and what the opponent alleges will be the perception of *SWISS ER LANDE*. Equally, it is far from meaningless if the end result is, as I hold it to be, a word with no obvious meaning to the ordinary buyer. It results in an odd-looking word, somewhat difficult to pronounce and memorable for its lack of meaning. At most, "something to do with Swiss things" might emerge.

I fully agree with Mr Skelly's counter argument. It is, as Mr Skelly argued, a word with some overall fanciful overtones, a "fanciful suggestion of Switzerland". He also argued that there is some scope for marks which resemble geographical names. *STANWAL* was not too close to *STANWELL*, see *Standard Woven Fabric Co's application*, (1918) 35 RPC 53. Overall, his submission was that any suggested connection with Switzerland was remote.

That of course is the hub of the argument - the extent of the suggestion. In my view it is minimal. In some way a Swiss style? For people who cannot afford Swiss products? Something even more fanciful? The possibilities are endless and none of them are anything more than speculations. The fact that such a search for meaning is possible is consistent with the trade mark being an invented word.

Mr Lockhart stressed the Swiss reputation as a source of chocolate. I accept that the reputation is established and I accept that, to the average consumer, Swiss chocolate is known to be

chocolate that is made in Switzerland. However, I simply cannot make the leap from SUISSANDE to “it must be Swiss”, let alone to “Swiss er londe”.

Mr Lockhart did not rely on a full quotation from the decision in DIABOLO, supra. Parker J, in the case in question, continued:

I use the expression "obvious meaning" and refer to "ordinary Englishmen" because to prevent a newly coined word from being an invented word, it is not enough that it might suggest some meaning to a few scholars.

I think it would require a particularly scholarly bent to get the word Switzerland from the trade mark SUISSANDE.

I am not convinced by Mr Lockhart's subsequent argument. This was based on cases such as PORTALTO *Trade Mark*, [1967] RPC 617. PORTALTO shows that an invented word will not always avoid being deceptive or confusing. On the facts of that case, it was held that a substantial number of people would be deceived or confused into expecting the goods to be port from Portugal. Under UK merchandising law at the time, Portugal was the legitimate source of port. Therefore, the trade mark failed under s 11 of the UK legislation, the equivalent of s 28 of the 1955 act.

The 12th (1986) edition of *Kerly's Law of Trade Marks and Trade Names* refers to a “now abandoned” practice of the UK registry. The UK office has in the past objected to words in trade marks which “have the appearance of being” a foreign word. See TONINO *Trade Mark*, [1973] RPC 568, Tonino being no more than a very rare Italian surname and the diminutive form of the Christian name Antonio. I can see why such a practice was abandoned: the TONINO decision seems to have been based on a somewhat patronising view of the gullibility of the average English wine buyer. I do not give the average buyer of confectionery any great credit as a careful or cynical consumer. However, neither do I take the ordinary range of such buyers of such goods to be overly credulous.

Were it the case that the present mark was deceptive to the extent of actually suggesting, or giving rise to reasonable doubts about, a Swiss origin, it would be within the proscription of s 28(a) of

the act. However, it is not. Even when I take the opponent's contention - "swiss-ond" or 'swiss-and" - as appropriate, I do not think that the conclusion of PORTALTO is justified here. There is, in my view, and paraphrasing Assistant Registrar Moorby of the UK Patent Office, no "danger that a substantial number of people will be deceived that it is a brand of Swiss goods". There is nothing in the present case but a remote suggestion of some sort of Swiss connection with the goods. Even this requires a prospective purchaser to suspend judgement to a degree that is quite unlikely. Any meaning that can be ordinarily be extracted from the mark is so unclear, and so forced, that it can provide no basis for any claim of deception or confusion.

It follows that I do not need to consider Mr Lockhart's further arguments about the contingencies in the conjunctive reading of s 28, or Mr Skelly's answers to these. As matters now stand, the Registrar's practice in such matters is set out in the *Official Journal* of 12.9.91. Had I been convinced that the trade mark was inherently deceptive, I would have required some sort of correction of the application. However, that is far from being the case and I will leave that matter to be resolved elsewhere.

All being as it is, the applicant's mark is, in my view, entirely registrable. Accordingly, I dismiss the opposition and award costs to the applicant.

T. Williams
Hearing Officer
24 September 1997.