



TRADE MARKS ACT 1955

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

Re: Opposition by MEADOW LEA FOODS LIMITED to the registration of trade mark application number 615958 in the name of PEERLESS HOLDINGS PTY LTD

As provided 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*.

This matter concerns trade mark application number 615958 which was lodged on 11th November 1993 in the name of Peerless Holdings Pty Ltd (the applicant). It sought registration of the trade mark OLIVE GOLD in class 29. Acceptance of the trade mark was advertised in the *Australian Official Journal of Trade Marks* on 26th October 1995 in respect of “edible oils and fats; margarine; all other goods in this class”. An endorsement has been entered on the application to read: “It is a condition of registration that the mark will only be used in relation to goods derived from or consisting of olives”.

On 23rd January 1996, Meadow Lea Foods Limited (the opponent) lodged a notice of opposition to registration of the applicant’s mark, under the provisions of s 49 of the Act. The notice of opposition contains various grounds of opposition. The evidence in support and the submissions at the hearing, however, focussed on the ground based on s 33, that registration or use of the opposed trade mark is likely to cause deception or confusion by reason of its close resemblance to one or more opponent’s trade marks used/or registered for the same or similar goods or description of goods.

The evidence

The evidence in support, lodged on 29th May 1996, consists of a statutory declaration by William Alexander Andrade, dated 23rd May 1996, together with annexures A, B and C and a statutory declaration by Sean Francis McManis, dated 23rd May 1996, with annexures A and B.

Mr Andrade, the accounting manager - statutory and commercial - of the opponent company refers to two of the opponent's trade mark registrations: number 610251 for the mark OLIVE GROVE and number 610249 for OLIVE GROVE and a device. The applicant commenced using the mark OLIVE GROVE in September 1993 on margarine, subsequently extending its use in relation to mayonnaise, olive oil, cooking spray, Italian salad dressing and French salad dressing. Mr Andrade provides details as to the sales and advertising of the products. He has annexed nineteen copies of letters from major retail buyers of products such as the opponent's, stating that they are not aware of the mark OLIVE GOLD being marketed or sold in the past or present, on margarine, olive oil, cooking oil, or salad dressing. Furthermore, they do not know of other two word trade marks having 'olive' as the first word used in relation to the same goods as those of the opponent.

Mr McManis, a solicitor of the firm of attorneys who are acting for the opponent, has attached to his declaration copies of two pages from the *Macquarie Dictionary* and copies of database search of the Trade Marks Office records of marks in classes 29 and 30 which include the word 'olive'.

A statutory declaration by Peter Norman Nicholls, dated 21st November 1996, with exhibit PNN1, forms the evidence in answer which was lodged on 22nd November 1996.

Mr Nicholls, a patent attorney of the firm of attorneys representing the applicant, states that his search of the Trade Marks Office records disclosed a number of trade marks consisting of or including a word commencing 'Oliv-' or 'Olive-' registered in the names other the

opponent's, for goods including olives and/or olive derivatives. Although none is a two word mark, he says, the distinction is artificial. The results of this search are exhibited to his declaration.

A hearing on the matter was held in Canberra on 20th May 1997. Mr Sean McManis of Spruson & Ferguson, patent and trade mark attorneys of Sydney, appeared on behalf of the opponent. The applicant was represented by telephone by Mr Robert Kelson of Callinan Lawrie, patent and trade mark attorneys of Melbourne.

Submissions

In commencing his submissions, Mr McManis said that the opponent considered the principal issue here to be whether the opponent's registered trade marks and the applicant's mark were deceptively similar in terms of s 33. In relation to comparison of marks, an element found to be non-distinctive in a mark must still be given due consideration in assessing whether marks are substantially identical or deceptively similar, he said, citing "*Granada*" Trade Mark [1979] RPC 303 at pp 308-309. Thus, one must consider the whole mark, including any disclaimed matter and assume use of the marks in a normal and fair manner. The opponent was not claiming monopoly in the word 'olive', he stressed, but in the two words OLIVE GROVE - *Broadhead's Appn* (1950) 67 RPC 209.

It was necessary to consider the matter forming part of the mark which may be carried away and retained in the memory and also to consider the elements which would be relevant to a verbal description, as discussed in *Application by Hardings Manufactures Pty Ltd t/a Wyandra Industries* 8 IPR 147. Considering what was common to the trade, and in anticipation of an argument in relation to the word 'olive' being part of marks and common to the trade, Mr McManis submitted that what was common to the trade principally turned on use in the trade. This matter, he said, was considered in *Sterling Winthrop Pty Ltd v Stephen Hunter Pty Ltd* 32 IPR 105 and in *Cole v Australia Char Pty Ltd* 30 IPR 51. Mr Andrade's declaration that there was no other trader using 'olive' as the first word in a two word mark had therefore gone uncontested. Even if it were established that an element was common to the trade, there would still need to be a consideration whether the

conflicting marks were substantially identical or deceptively similar - *R & C Products Pty Ltd v Bathox Bathsalts Pty Ltd* 21 IPR 547. Similarly, for the purposes of deceptive similarity, one could not disregard an element in a mark if it has some relevance in relation to the goods as was noted in *Hardings* case, supra at p 154.

Turning further to Mr Andrade's declaration in the opponent's evidence, Mr McManis commented that the opponent's marks were broadly advertised and used prior to the date of the present application. It was therefore highly likely that the applicant would have been aware of the opponent's use of the marks. Referring to the statements of the retail buyers annexed to the declaration, he said that, although they were not sworn statements, the Registrar was entitled to take them into account, as proceedings before the Registrar were not strictly in accordance with rules of the Court.

With respect to the evidence in answer, Mr McManis submitted there was slight confusion in that evidence as to what was being claimed by the opponent. The opponent was not trying to establish that it had exclusive right to the trade marks consisting of two words, the first being 'olive', rather that the marks OLIVE GROVE and OLIVE GOLD were too similar, having regard to the whole of each mark in light of what he had said previously. As to the evidence of a number of marks on the Register, these were only a few considering the total number of marks which must be registered in class 29 in relation to the relevant goods. It was also obvious that none of the marks listed were two word marks. In fact, the identified marks were quite different in nature from the opponent's marks.

Viewing the trade marks in light of the established principles for comparing trade marks, notably *Pianotist Co's Appn* (1906) 23 RPC 774, Mr McManis first directed my attention to the importance of the first syllable considered in *London Lubricants (1920) Ltd's Appn* (1925) 42 RPC 264. He saw not only strong visual resemblance between the marks, but also pointed to their phonetic similarities, particularly noting the identical first word of each mark and the plosive letter 'g' at the beginning of the second word which was a hard sounding and more significant letter than some softer sounding ones. The 'o' sound in the marks was a diphthong - a sound like 'o' in the word 'hoe' - he said, which was the same

diphthong appearing in the words 'gold' and 'grove'. He further argued that, as the subject products were available in supermarkets to an 'every day purchaser' and were not high cost items, those products could be chosen without particular care and great attention to detail. Here he referred to *Australian Woollen Mills Ltd v F S Walton & Co* (1937) 58 CLR 641, arguing that in such situations the marks could be imperfectly remembered - *de Cordova v Vick Chemical Co* (1951) 68 RPC 106.

In relation to goods of the same description under s 33, Mr McManis submitted that the Registrar should exercise his discretion in refusing registration of the present application in respect of all the goods covered in the application. He argued that it would be an absurd result if, for example, a mark were to be removed from the Register for all the goods except goods of the same description derived from or containing olives despite the existing condition of registration. In such circumstances there could be a situation of a mark remaining on the Register for eggs, whereas the condition of registration stated that the mark was to be used only on olive products.

Mr Kelson first commented that the voluntary statements of the retail buyers accompanying Mr Andrade's declaration were remarkable for their consistency and could not be words of the persons who signed those documents. As to the buyers' lack of awareness of other two word marks having the word 'olive' as the first word, Mr Kelson submitted that various meanings could be ascribed to the word 'olive', but in the context of OLIVE GROVE the term must be considered as a whole in which the word 'grove' may not be ignored. The words OLIVE GROVE brought to mind a grove of olive trees, therefore those words had only one meaning. The word 'gold', on the other hand, had a number of meanings, but none that bears any relationship to a concept of a grove of olives. The applicant's mark OLIVE GOLD did not convey a readily understood meaning, although it could be said to be somewhat descriptive of a colour, or of some other standard. As the marks under consideration conveyed different meanings, they would give different impressions to the ordinary purchaser and therefore could co-exist for the same goods. In support of this contention, Mr Kelson cited *Thomas A Smith Ltd's Appn* (1913) 30 RPC 363.

Mr Kelson perceived differences between the visual appearance of the marks, notwithstanding that the opponent's and the applicant's marks start with the word 'olive'. He argued that one should not overlook the letter 'r' after 'g' in OLIVE GROVE. And with respect to phonetics, the effect of the fricative 'r' behind a plosive 'g' in 'grove' gave quite a different sound to the diphthong behind 'g' in 'gold'. Even though 'grove' constitutes the second part of the mark, within a context of two word mark, it was a word in its own right with a definite sound in the letters 'gr'. It was not likely that the marks would be confused one with the other, despite the accepted tendency to slur latter parts of words.

Another point that must be taken into account, Mr Kelson continued, was that the Courts have been very careful against conferring on proprietor of a trade mark a wide monopoly, wider than what was justified. It mattered not whether anyone else has registered or used two word marks commencing with the word 'olive' in respect of the same goods. The same principle would apply whether the mark in question comprised two words or one word. The word 'olive' in the present trade mark or in the opponent's marks carried with it some descriptive nature, just as the term 'olive-' or 'olive-' did in the registered marks which had been referred to in the evidence in answer. When considering the marks under conditions of normal and fair use, they differed visually, phonetically and conceptually and those differentiations carried over to conditions of imperfect recollection. The monopoly in OLIVE GROVE did not extend as far as OLIVE GOLD, and whilst the ordinary consumers who purchase goods of the type set out in the respective statements of goods may not pay particular care, they would not be excessively stupid or inattentive.

Both parties sought costs.

Decision

Section 33 - substantially identical or deceptively similar

Sub-section 33(1) states:

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, or of 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 opponent's alleged conflicting marks are:

the word mark, GOLDEN GROVE of registration number 610251, and



the label mark of registration number 610249.

As both of these trade marks have been registered in respect of “margarine, edible oils and fats, all derived from olive oil, it is clear that the goods are embraced in the statement of goods sought to be registered by the present application.

It has not been challenged that the trade marks under consideration are substantially identical, therefore it is for me to decide whether they bear such close resemblance so as to be likely to deceive or cause confusion to the prospective purchasers of the relevant goods. In this regard, I am mindful of the tests on deceptive similarity of trade mark enunciated in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407 and *Australian Woollen Mills Ltd v Walton*, supra.

Both Mr McManis and Mr Kelson have taken me through the long established guidelines on comparison of marks outlined by Parker J in *Pianotist* case, supra, but for the sake of clarity I will quote his Honour's words, at p 777:

“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.”

In the composite mark of registration number 610249 there are sufficient device elements, such as the rectangle with the curved sides, the branch with fruit and a tree, to distinguish it visually from the applicant’s mark, the only shared element being the word ‘olive’. The visual similarities of the applicant’s mark with the other opponent’s mark are more obvious not only in the two words comprising each mark, the first of which is identical but also in the letter ‘g’ at the beginning of the second word. As the second word in the marks forms a recognizable word in the English language, however, the visual differences between the marks are not as pronounced as they would appear to be at the first glance. Concerning the meaning conveyed by the marks, OLIVE GROVE expresses a more definite and better understood connotation than OLIVE GOLD, as was argued by Mr Kelson, nonetheless, sufficiently clear and understood meaning to distinguish the two marks.

Both parties have placed considerable emphasis on the pronunciation of the marks. Having the word ‘olive’ in common, any phonetic differences, of course, exist in the words ‘grove’ and ‘gold’. The similarities in pronouncing the plosive letter ‘g’ and the diphthong ‘o’ in those words are noted, but I do agree with Mr Kelson’s submission that the combination of the letter ‘g’ and ‘r’ creates a distinct sound before the diphthong ‘o’ in the word ‘grove’, which reduces the similarity between the initial sounds of the words ‘grove’ and ‘gold’. Be that as it may, in the present case I believe the phonetic aspect should be of less consequence than that of the visual comparison as the products in question would be found for sale as a packaged product in the frozen goods units or displayed on the shelves in supermarkets where the customer selects the products without requiring the assistance of sales personnel. In this regard, I refer to *Deeko Australia Pty Ltd v Decor Corp Pty Ltd* (1988) AIPC 90-479.

There is no dispute that conflicting marks must be compared in their entirety, including any disclaimed or non-distinctive part to determine whether the marks are deceptively similar. It is also well established that if an element in a mark occurs frequently in other marks in the trade, owned by various proprietors, that element should to some extent be disregarded

when deciding whether a mark is deceptively similar to another mark - see *Visco Sport Ltd v BTR Plc* (1989) AIPC 90-575. According to the applicant's evidence, five trade marks co-exist on the Register in different names for goods which include olive products, namely: OLIVIA, OLIVELLA, OLIVETO and a device, OLIVORO and OLIVINI. While these trade marks may suggest a descriptive element in 'oliv-' or 'olive-' in relation to the goods, in my opinion, the remaining parts of the marks differ from each other so as to be readily distinguishable. The applicant's mark and the opponent's mark, on the other hand, possess common features not only in the first word, but also in the first letter of the second word and both comprise two words. These characteristics are not found in other marks for the relevant products, as demonstrated in the lodged evidence.

In relation to comparing trade marks, it has been stated by Dixon and McTiernan JJ in *Australian Woollen Mills v F S Walton*, supra, at p 658:

“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 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.”

It seems to me that the opponent, in its submissions, has somewhat underestimated the intelligence of the prospective buyers of the products of the kind the opponent and the applicant are offering and their ability to select the exact product they intend to purchase, even if they are pressed for time to inspect the details of the product. An 'ordinary person' is to be regarded as a person of ordinary intelligence and perception, and one who has an ordinary recollection of marks (*Don v Burley* [1916] 22 CLR 136 at p 140). Given that I am to consider whether an ordinary purchaser is likely to be deceived by the existence of the opponent's and applicant's marks, rather than a person who is careless or in a hurry, I have come to the conclusion that the differences in the meanings conveyed by the marks are such as to impress those differences on one's memory so that, on encountering a product

bearing, say, the mark OLIVE GOLD, the potential customer would readily realize that the product sought was not the one he/she had in mind. Despite the fact that the applicant has chosen a mark which shares an number of common features with those of the opponent's marks, I do not envisage possibility of deception or confusion of the marks based on imperfect recollection, as suggested by the opponent.

Concerning the submissions that the present application should not proceed to registration in respect of all the goods claimed in the application, it is to be remembered that, contrary to the *Trade Marks Act 1995*, the Act of 1955 does not prohibit trade marks to be registered in respect of all the goods in a class even if conditions apply to the registration that the mark will only be used on certain goods.

Conclusion

As indicated previously, I have found that the applicant's trade mark is not likely to cause deception or confusion. The opponent has therefore failed in relation to the ground of opposition based on s 33. Consequently, I dismiss the opposition and, subject to any appeal from this decision, the mark should proceed to registration. I award costs to the applicant.

Vija Zars
Hearing Officer

24th July 1997