



TRADE MARKS ACT 1995
DECISION OF A DELEGATE OF THE REGISTRAR OF
TRADE MARKS, WITH REASONS

Re: Opposition by Unilever PLC to the registration of trade mark application number 639483 in the name of Paraloma Holdings Pty Ltd

Background:

After examination by the Trade Marks Office, trade mark application 639483 was advertised as having been accepted for registration. The applicant is proposing to register the trade mark FLORA PLANT FOOD for use on "soluble liquid or powder plant food for soil or hydroponics".

The company that originally filed the application, Soluble Solution Pty Ltd, was placed in liquidation some time before the application was advertised as accepted. The application has been assigned and is now in the name of Paraloma Holdings Pty Ltd. In terms of s 108(2), Paraloma Holdings Pty Ltd must, for the purposes of my decision, be taken to be the applicant. A reference in this decision to "the applicant" is thus a reference to that company.

Registration of the application is opposed by Unilever PLC ("the opponent") on various grounds set out under division 2 of part 5 of the 1995 act.

The opposition process has followed the course set out in the regulations. The opponent served evidence to support its position. This consists of a single declaration from Nicholas Goddard, Marketing Manager of the Florafoods Division of Unilever Australia, a wholly owned subsidiary of the opponent.

In due course the opposition came on for hearing and decision by me, as a delegate of the Registrar of Trade Marks. The applicant did not attend the hearing, nor did the opponent. However, the opponent's solicitor, Tracey Savage, of the firm of B. F. Jones, solicitors, relied on written submissions. From these, the opponent now pursues only two grounds of opposition, as follows:

1. Section 44

So far as is relevant, s 44(1), with relevant notes added, provides:

Identical etc. trade marks

44.(1) Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

- (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
 - (i) a trade mark registered by another person in respect of similar goods or closely related services; or
 - (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

Note 1: For *deceptively similar* see section 10: a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

Note 2: For *similar goods* see subsection 14(1): goods are *similar* to other goods if they are the same as the other goods; or if they are of the same description as that of the other goods

The opponent relies on several trade mark registrations that consist of or contain the word FLORA. Those registrations are all of an earlier priority date. For present purposes such dates are the filing dates of the relevant applications. The broadest of these is registration 296614, for the word FLORA, in respect of:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles

I will accept, without quoting relevant authority, that several of the registrations, including 296614, are identical to the applicant's mark. Therefore, I also accept Ms Savage's submission that, comparing the applicant's mark with the opponent's, they are also deceptively similar.

Where the opponent's case fails completely is on the question of "goods of the same description", the essential finding if s 44(1)(a)(ii) is to be triggered.

To quote Ms Savage:

The matters to be considered in deciding whether goods are of the same description were set out in *John Crowther & Sons (Milnsbridge) Ltds Appn* (1948) 65 RPC 369 at 372 and were summarised under three general heads in *Jellinek's Appn* (1946) 63 RPC 59 as:

- a) the nature of the goods;
- b) the uses thereof; and
- c) the trade channels through which they are bought and sold.

"None of these factors is determinative", she submits. Her submission continues: "and we submit that the overriding test is whether the public would consider the Opponent's and Applicant's goods as emanating from the same source".

It is here that I reject this ground of opposition. One of the elements set out in *John Crowther's* application, supra, is: "whether by those engaged in their manufacture and distribution they are regarded as belonging to the same trade". The decision continues, "No single consideration is conclusive in itself". There is nothing in the evidence or referred to in the written submission that suggests to me that there is anything in common in the natures, uses or trade channels of the goods, other than that they both end up on the shelves of a supermarket. On a reasonable application of the relevant tests, when not a single one of the three tests in *Jellinek*, supra, is in the opponent's favour, the goods cannot be of the same description. To argue that goods such as these are "of the same description" on the basis attempted here is to mistake the issue to be demonstrated under s 60 for one of the relevant factors under s 44.

2. Section 60

Without repeating the language of the *Trade Marks Act 1995*, I will simply accept Ms Savage's analysis, the source of which begins a long chain of relevant authorities:

In our submission, the relevant legal principles in relation to s60 are stated in *Smith Hayden & Co Ltd's Appn* (1946) 63 RPC 97 (Ch.D.) where Evershed J formulated that test relating to section 11 of the British Act (which corresponded to s60 of the current Act) as:

"Having regard to the reputation acquired by the name 'HOVIS', is the court satisfied that the mark applied for, if used in a normal or fair manner in connection with any of the goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

I have no doubts at all about the strength of the reputation in the opponent's FLORA trade mark. The evidence satisfies me that it is exceedingly well known in relation to foodstuffs, particularly margarines and cooking oils. I accept also the opponent's proposition that some reputation will have been built up by use of the trade mark FLORAfoods, rendered in mixed upper and lower case as shown, as a house mark in relation to goods as diverse as soups and croissants. Those goods are sold and heavily advertised under other trade marks, such as CONTINENTAL and VAN DEN BERGH'S. However, I think there is sufficient evidence that at least some buyers of these goods, those who diligently read the small print on labels and the informative back pages of promotional literature, will make the connection with FLORA.

Ms Savage has argued that householders who purchase FLORA goods from the opponent will, since they may also purchase FLORA plant food from the applicant, and since the opponent has an

extensive reputation, be caused to wonder about some sort of connection with the opponent. In support of this, she notes that the opponent's goods have "an association with plants and flowers". This is true, both of margarine in general and the opponent's promotion in particular. Having adopted a name like FLORA it would clearly find it difficult to do anything but emphasise such an association.

So far as I can see, there is no reasonable basis for such speculation. While "it is enough if the ordinary person entertains a reasonable doubt"¹, I see nothing here that would allow what might be, at most, idle speculation to rise to any significant level, let alone to that of a reasonable doubt.

I know, and I believe most of the population will also know, that the word "flora" means something or other to do with plants. The strict technical meaning according to the *Macquarie Dictionary* is "the plants of a particular region or period, listed by species" but the general sense of the meaning will be well known. I see no reason at all why any reasonable member of the public would suspect that such a word, used as a trade mark in respect of plant food, indicated a connection with the opponent, a trader in foodstuffs of particular sorts. A reasonable person would simply not anticipate such a link with the opponent, either as manufacturer, as having authorised the use of the mark in question or even as seeking to promote its food products.

That being so, the opponent fails also to establish the second and remaining ground on which it relies. In terms of s 55 therefore, my decision is that the application should be registered without further restriction. In the absence of any appeal from this decision, I direct that the application proceed to registration. I award costs, in accord with the official scale, to the applicant.

T. Williams
Hearing Officer
14 April 1999.

¹ Kitto J in *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 595.