



TRADE MARKS ACT 1995

DECISION OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by S.A. Jean Cassegrain to trade mark application numbers 665923(16) 665924(18) and 665927(25) filed in the name of Victoria Racing Club.

Trade mark application number 665923 (in class 16), 665924 (in class 18) and 665927 (in class 25) were filed on 6 July 1995 in the name of Victoria Racing Club, of Flemington, Victoria. . The examiner of trade marks raised no objection to these marks and, in the Official Journal of Trade Marks of 11 July 1996, the Registrar advertised that each mark was accepted for registration. The goods in each of the applications remain as originally claimed and read as follows:

665923 Paper, cardboard and goods made from these materials; printed matter; stationery; photographs; playing cards; plastic material and packing.

665924 Travelling bags; umbrellas, parasols.

665927 Clothing, headgear and footwear.

The trade mark, the subject of each of these applications, is the device mark shown below.



S. A. Jean Cassegrain, of rue Saint-fiacre 75002 Paris France (Jean Cassegrain), now opposes these trade marks in accordance with the provisions of Part 5 of the *Trade Marks Act 1995*.

In support of its opposition Jean Cassegrain relies on three declarations. These have been provided by:

- John Atlee Hunt, a director of Hunt Leather Pty Ltd of Pymont, New South Wales. This company, says Mr Hunt, has continuously since 1975 been the principal Australian retailer of goods manufactured in France by Jean Cassegrain;
- Andrew Maxwell Fewster, an employee of Davies Collison Cave, patent and trade mark attorney of Melbourne;
- Philippe Cassegrain, the president of Jean Cassegrain.

In answer to this evidence, Victoria Racing Club served three declarations. These are by:

- Christopher Payne, senior designer of CPT Design Pty Ltd of Queens Road, Melbourne;
- Gregory Clifton, legal counsel of the Victoria Racing Club;
- Daniel Thomas Curran, general manager (marketing) of Victoria Racing Club.

In reply, Jean Cassegrain served one further declaration. It is by:

- Brett Lewis, a solicitor of Davies Collison Cave.

On 12 February 1999, Davies Collison Cave applied for the opposition to be set down to be heard, and a hearing was scheduled for Melbourne on 4 June 1999. This took place before me. Mr Ben Fitzpatrick of Davies Collison Cave, assisted by Ms Fiona Symons represented the opponent, Jean Cassegrain. Mr David Shavin of counsel, instructed by Corrs Chambers Westgarth, lawyers of Melbourne, represented the applicant, Victoria Racing Club.

The Notices of Opposition spell out eight grounds. Mr Fitzpatrick, however, at the outset of proceedings, indicated that Jean Cassegrain abandoned all but two. The evidence only goes to these two grounds. They are stated in the Notices as follows:

- The registration of the trade mark(s) are prohibited by section 44 of the Act (particularly in light of the opponent's registrations No[s] 370098, 389743, 389744, 427188 and 438290);
- The use of the trade mark [s] will be likely to deceive or cause confusion contrary to section 60 of the Act.

I shall deal with these two grounds in turn.

The section 44 ground



The law




The provisions of section 44 lay down, *inter alia*, that grounds for rejection exist if an application trade mark is substantially identical or deceptively similar to an earlier trade mark and that earlier trade mark comprehends goods which are the same or similar to the goods nominated in the subject application.

Section 10 defines deceptive similarity. 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.

The facts

It is useful here, I think, to set out the application claims against the registered trade mark upon which Jean Cassegrain relies. There was no reliance on 438290(9).

Against	665923(16)		Paper, cardboard and goods made from these materials; printed matter; stationery; photographs; playing cards; plastic material and packing.
is	427188(16)		Articles for writing, including ball-point pens, fountain-pens, propelling pencils and pencils; stylographs, stylographic pens.

Against	665924(18)		Travelling bags; umbrellas, parasols
is	389743(18)		Leather and imitation of leather, articles not included in other classes made from these materials, skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; but excluding horse skins and horse hides; also excluding whips, harness and saddlery.
and also	389744(18)		Leather and imitation of leather, articles not included in other classes made from these materials, skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; but excluding horse skins and horse hides; also excluding whips, harness and saddlery.

Against	665927(25)		Clothing, headgear and footwear
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is 370098(25)



Jackets, jumpers, shirts, ties, scarves, boots, shoes, slippers, belts, being goods in this class but excluding clothing and footwear for horse riders

The application date of all three Victoria Racing Club applications is 6 July 1995. Registration dates for the trade marks cited by Jean Cassegrain range from 6 January 1982 to 21 May 1985. There is agreement that all of the citations are therefore earlier than the Victoria Racing Club applications. It is also common ground that, with the exception of the class 16 trade marks (427188(16) and 665923(16)), the goods claimed in the Victoria Racing Club applications overlap with the goods specified in the Jean Cassegrain citations. The broad item *stationery*, however, is included in the Victoria Racing Club's 665923 statement, and Mr Fitzpatrick refers me to *The Macquarie Dictionary*¹, where entry for *stationery* reads in part: *Writing materials, as pens, pencils, paper, etc.*

I accept Mr Fitzpatrick's submission, therefore, that the 665923 statement comprehends pens and pencils and, I hold, 665923 includes goods that are the same, or are similar, to the writing implements of 427188.

The section 44 ground therefore comes down to a comparison of the trade marks. Mr Fitzpatrick, on behalf of Jean Cassegrain, made no attempt to argue that the Victoria Racing Club sign is substantially identical to either of the Jean Cassegrain signs but he argues that they are deceptively similar. I will refer to trade marks numbers 370098, 389744 and 427188 as the LONGCHAMP signs; to 389743 as the CASSEGRAIN sign, and to the subject trade mark applications, 665923, 665924 and 665927 as the RACING VICTORIA signs.

¹ *The Macquarie Dictionary*, 3rd edition, 1998

The opponent's submissions

In support of Jean Cassegrain's claim that the RACING VICTORIA signs are deceptively similar to both the LONGCHAMP and CASSEGRAIN signs, Mr Fitzpatrick refers me to long established case law which lays down the following tests for deceptive similarity.

- The comparison to be made is not between the marks looked at side by side, but rather between the impression based on recollection of the trade marks that persons of ordinary intelligence and memory would have.² At 415 of the *Oil Drop* case, the words of Windeyer J, as adapted to present circumstances, read:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's [use of its mark].

- The likelihood of confusion or deception is not disproved by placing the two signs side by side and demonstrating how small is the chance of error ... it is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.³
- The idea of the respective signs must be taken into account.⁴

In comparing the signs, Mr Fitzpatrick submitted that on the following counts, the RACING VICTORIA signs are deceptively similar to both the CASSEGRAIN sign and the LONGCHAMP signs. He says, that in each case, these signs have two essential parts. First, is the device of a horse and jockey. Second is a word which is positioned directly below the device element. The appearance and stylisation of the Victoria Racing Club horse and jockey device is, says Mr Fitzpatrick, very similar to the Jean Cassegrain horse and jockey device. Both comprise what he describes as a classic 19th century representation of a horse in the full stride of a gallop. The

² *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd* (1963 - 1964) 109 CLR 407 – the *Oil Drop* case

³ *de Cordova v Vick Chemical Co* (1951) 68 RPC 103 at 106

⁴ *Jafferjee v Scarlet* (1937) 57 CLR 115

jockey in both signs is in almost identical pose. The general impression created by the signs, he says, is an impression of two very similar trade marks. To the casual viewer, Mr Fitzpatrick submits, this strong similarity would in itself be sufficient to cause deception and confusion. But further, LONGCHAMP is a famous French racecourse. The words RACING VICTORIA in the Victoria Racing Club signs will generate the ideas of racing and of racing horses as will the word LONGCHAMP. These common ideas further heighten the probability of deception and confusion.

The applicant's submissions

Mr Shavin counters with his view that there is a dramatic difference between the RACING VICTORIA signs and both the CASSEGRAIN and the LONGCHAMP signs. He points in particular to the words included in those signs. There is no hint, he says, of the word CASSEGRAIN or LONGCHAMP in the RACING VICTORIA signs. Nor, he says, does the RACING VICTORIA sign convey any hint of the meaning conveyed by either CASSEGRAIN or LONGCHAMP. He acknowledges LONGCHAMP as the name of a “well-known racetrack outside Paris” but says the words CASSEGRAIN and LONGCHAMP clearly and unambiguously refer to Jean Cassegrain’s goods. He also contends that while the horse and rider show certain stylistic similarities, there are, nevertheless, significant differences. In particular, the horse and rider face different directions, and the RACING VICTORIA sign is depicted in contrasting colours which first, bisect the sign, and second, establish two dominant adjacent block shapes behind the horse and rider. Mr Shavin submits the registration of the CASSEGRAIN sign and the LONGCHAMP sign does not entitle Jean Cassegrain to an exclusive claim for all 19th century style representations of a horse and rider; that the distinguishing feature of the Jean Cassegrain trade marks is the word *Longchamp* or (in the case of 389743) the word *Cassegrain*; and that in respect of these signs, I should not hold that the RACING VICTORIA signs are deceptively similar to either of the Jean Cassegrain signs.

Assessment and Findings on the section 44 ground

As I concluded above, this section 44 ground hangs (as is so often the case) on the question of deceptive similarity. Here, it is the question of whether the RACING VICTORIA signs are deceptively similar to the CASSEGRAIN sign, or to the LONGCHAMP signs, or to both. In

dealing with these questions it is of course necessary for me to consider the signs as whole entities. However, I can only come to that point if I first weigh up the significance and importance of the principal constituent particulars. I shall then first consider and compare the two horse and rider devices. Second I shall consider the impact of the words RACING VICTORIA as opposed to CASSEGRAIN and LONGCHAMP. Then, looking at the trade marks each as a whole, I shall apply the tests as per the directions of *Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd*⁵, *de Cordova v Vick Chemical Co*⁶ and *Jafferjee v Scarlett*⁷. These are the cases to which Mr Fitzpatrick directs my attention (see above).

As is immediately apparent from an inspection of the trade marks, the common feature of all the signs is the device of a galloping horse ridden by a jockey. Mr Fitzpatrick says the figures are representations in the style of the 19th century. Mr Shavin, however, attributes the figures in the RACING VICTORIA sign to more contemporary style. I am inclined to agree with Mr Fitzpatrick so far as the Jean Cassegrain signs are concerned. That horse has a cropped tail, and horse and rider, overall, have an air of outmoded elegance – 19th century or possibly even earlier. I am inclined to agree with Mr Shavin however, that horse and rider in the Victoria Racing Club sign appears to be a 20th century style of representation. The horse's tail flows full and free and animal and rider give an overall impression of contemporary design. That being said, however, the respective horse and jockey components of these two families of trade marks have a great deal in common. On less than close inspection, the respective shapes (though pointing in opposite directions) might well be taken as identical. The greatest point of difference comes, I think, from the two-tone effect which overlays the RACING VICTORIA signs and produces a strongly defined block shape. The chequered effect achieved by the contrast in colours adds a significant and distinctly different appearance to the applicant's trade marks, and, in my view, this shift contributes further to the 20th century feel of the Victoria Racing Club trade marks. I acknowledge the submission from Mr Fitzpatrick that there is no colour restriction on any of the signs and therefore, in use, the division so clearly apparent in the application representations of the

⁵ (1963 - 1964) 109 CLR 407

⁶ (1951) 68 RPC 103

⁷ (1937) 57 CLR 115

trade mark may not be so obvious when colours, rather than black and white, are used. Mr Fitzpatrick then reminds me that I must consider the prospect of deception not only as per the representations on file and on the Register, but as per the scope of the registration once it is obtained.⁸ I do not agree with him, however, that I can simply put aside the fact of the contrasting colours. The contrasting colours are a feature of the application representations and to my mind contribute a significant and important element to the identity of the RACING VICTORIA signs. Furthermore, there is not merely a variation of colours – there is a reversal of negatives and positives. This, in my opinion, adds a significant third element to the application trade marks and, should the sign be used without that clear dichotomy, it would raise the question of whether that use was use of the mark as applied for. The Victoria Racing Club signs are not, as Mr Fitzpatrick submits, signs which comprise simply the two components of first a rider on a galloping horse and second some words. They are signs in which these elements are sharply and somewhat dramatically transposed from negative figures on a positive block background, to positive figures on a negative ground. The total effect of the vertical dissection is, I think, to virtually eliminate all semblance of 19th century style from the Victoria Racing Club signs.

Turning now to the words in the three signs – CASSEGRAIN and LONGCHAMP on the one hand and RACING VICTORIA on the other. CASSEGRAIN and RACING VICTORIA, so far as I have been shown, have nothing in common. LONGCHAMP and RACING VICTORIA are completely different words and, clearly, their meanings too are very different. There is, however, a similarity of ideas ... LONGCHAMP is a famous race track, so famous perhaps that it could be taken as a metaphor for *horse racing*. But whether speaking geographically or metaphorically, the distance between VICTORIA and LONGCHAMP is undoubtedly very great and I do not think that I can find, on the coincidence of the racing connection, that the respective terms RACING VICTORIA and LONGCHAMP are likely to be confused. There is certainly nothing in evidence to suggest that there is a connection between the Australian and the French racing authorities, nor that any public information would lead the public to assume such a connection. On the contrary, on the evidence

⁸ *Smith Hayden & Co Ltd's Application* (1946) 63 RPC 97.

and submissions, it is my view that the terms RACING VICTORIA and LONGCHAMP (despite any horse racing ideas they engender) are not at all likely to be confused, one with the other.

Coming now to considering the signs as a whole. Had the signs comprised nothing more than the pictorial elements, the impressions generated by the similar horse and rider devices, there may well have been reason enough to hold those signs deceptively similar. But that is not the case. Nor is it the case that the whole of one party's sign is contained within the other's sign. On the contrary, the singular words CASSEGRAIN and LONGCHAMP are prominent features in the Jean Cassegrain signs while the very different words RACING VICTORIA are prominent features in the Victoria Racing Club signs. In my view, persons of ordinary intelligence and memory who have a recollection of the Jean Cassegrain trade marks will recall these singular words, and will not be misled when they are confronted by a trade mark prominently displaying the very different words RACING VICTORIA. Much of the visual detail discussed above is the kind of detail that the person of average intelligence would not be expected to recall. Certainly I would not expect the average purchaser to have the time or inclination to note and remember the fact that the Jean Cassegrain horse has a cropped tail, and the Victoria Racing Club horse has its tail intact. But I consider that the general impression that persons of normal intelligence would be likely to maintain of the Jean Cassegrain signs is of a pre 20th century presentation of a rider and horse, together with the words CASSEGRAIN and LONGCHAMP. The general impression that I would expect such persons to recall about the Victoria Racing Club signs is that of a contemporary representation of rider and horse and the words RACING VICTORIA. But, as I have mentioned above, the further difference brought about by the two tone overlay, in my opinion bestows a character which is quite foreign to the character of the Jean Cassegrain signs. Contrary to Mr Fitzpatrick's submissions, in view of the fact that the distinctive contrast is part of the application representations, I do not think the resultant chequered effect can simply be disregarded on the principles laid down in the *Smith Hayden*⁹ test. Despite the similarity brought about by the commonality of the horses and riders in these two families of signs, I do not think that the general impressions they create is likely to bring about deception and confusion. Lastly, there is the matter of the ideas. In compound marks of

⁹ (1946) 63 RPC 97

this nature, the idea is not simply the idea created by the common features. I have at length commented on the difference in styles, the difference in the words and terms used in the signs, and the effect of the dichotomy brought about by the reversal of colours in the Victoria Racing Club signs. Although these signs all clearly share a common idea of a galloping horse and rider, I do not think, when the other features are taken together, and the marks are considered as wholes, that the common idea of a galloping horse is sufficient for me to find the RACING VICTORIA signs deceptively similar to either the CASSEGRAIN sign or the LONGCHAMP sign.

I therefore dismiss the section 44 ground.

The section 60 ground

The law

Section 60 reads:

- 60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:
- (a) it is substantially identical or deceptively similar to a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
 - (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

The facts

Jean Cassegrain commenced use of its CASSEGRAIN and LONGCHAMP signs in 1948. These signs are now, apparently, used on a range of goods including luggage, bags, small leather goods, briefcases, belts, clothing, ties, scarves and clothing accessories. Use is throughout the world. In 1995 the value of these goods exceeded \$56.6 m. In Australia, the trade marks have been in continuous use since 1975. Between 1990 to 1995 the value of Australian retail sales was in the range of \$1m to \$1.6m. The goods are sold in department stores, duty free stores and Hunt Leather and Longchamp boutiques. The goods have been advertised.

There is no evidence of any deception or confusion having occurred.

Deceptive similarity

In respect of the section 44 ground I have decided (above) that the RACING VICTORIA signs are not deceptively similar to either the CASSEGRAIN sign or to the LONGCHAMP sign. I find that there is nothing in the context of the Australian use of these marks which cause me to find otherwise. Subsection 60(a) requires a finding of substantial identity or deceptive similarity as a threshold test for a section 60 ground. Jean Cassegrain has failed on both counts, and consequently the section 60 ground fails.

However I will comment that, had I found otherwise, the evidence of Jean Cassegrain's reputation seems short of satisfy subsection 60(b) in respect of all the goods nominated by Victoria Racing Club. Particularly, I think, the reputation demonstrated is not likely to have upheld the cause of deception and confusion for various class 16 articles claimed under 665923. I also doubt that it would have sustained the claim against all of the class 25 goods under 665927.

Findings on the section 60 ground

On the finding, however, that the application trade marks are not deceptively similar to any of the Jean Cassegrain signs, I find that the section 60 ground is not made out.

The decision

The two grounds relied on by the opponent have failed. Consequently I dismiss the opposition. The Victoria Racing Club trade mark applications, subject to any appeal, may therefore proceed to registration.

The costs

The applicant is entitled to its costs which I accordingly award. On request, and as per the provisions of regulation 21.13, the costs shall be taxed and certified by an officer appointed by the Registrar for that purpose.

Mr Shavin complained that the grounds of opposition set out in the notice of opposition were extensive and he had no warning that there was no intention to pursue them until the hearing was under way. The applicant was obliged to respond and prepare a defence to all of the grounds. In the end, however, only two of eight grounds were argued. Mr Shavin submitted that if the

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opponent was to succeed, the applicant should stand entitled to compensation for the effort in preparing for the abandoned grounds. I have some sympathy with this view. Proceeding to the point of the hearing before pronouncing to the other side (and the Registrar) that certain grounds are abandoned, causes a general inconvenience which is likely to involve costs. Therefore, had the opposition been successful, I would not have been inclined to award Jean Cassegrain its full costs.

Helen R. Hardie
Deputy Registrar

28 July 1999