



TRADE MARKS ACT 1995

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

Re: Opposition by CITICORP to registration of trade mark application number 716812 in the name of CITY MARKETING CONCEPTS PTY LTD for the trade mark CITY-CARD Class 16

Background

Application number 716812 was filed on 9 September 1996 in the name CITY MARKETING CONCEPTS PTY LTD (the applicant). The application was for the registration of the mark **CITY-CARD** and covered the statement of goods, "Maps for use in tourism areas" in Class 16.

Following examination, the application for the trade mark was advertised as accepted in the *Australian Official Journal of Trade Marks* of 5 June 1997. A notice of opposition to the trade mark's registration was filed, following the allowance of an extension of the time to do so, by CITICORP (the opponent), on 5 December 1997.

The notice of opposition listed a number of grounds. However, the only matters which were relied upon by the opponent's attorney at the hearing were the allegations under: s.44, that the subject trade mark was substantially identical or deceptively similar to several prior registered trade marks owned by the opponent, which included the prefix CITI-, and covered goods which were closely related to the services under one registration and were similar to the goods under several others; s.43, that, because of some connotation contained in the mark, then its use would be likely to lead to deception and confusion; and under s.60, that the use of the trade mark would be likely to lead to deception and confusion because it was substantially identical or deceptively similar to the opponent's trade marks which had acquired a reputation in

Australia prior to the priority date for registration of the present mark; and that there was an onus on the applicant to show that the present trade mark qualified for registration, given the unanswered evidence in support of the opponent. Accordingly, those grounds are the subject of this decision and the reasons for it.

The opponent requested a hearing in the matter and it came before me, as a delegate of the Registrar, in Sydney on 16 October 1998. The opponent was represented by Mr Trevor Stevens, of Davies Collison Cave. The applicant advised by telephone that he would not be attending the hearing

The Evidence

The evidence in support comprised a declaration by Helen Danyo, the Assistant Secretary of the opponent, who gave the history of the opponent's trade marks, and also detailed the value of the services sold and the advertising expenses under those marks. In her declaration, she gave further details of those services, many of which were accessed through the use of a credit card, and included, as exhibits, brochures, extracts from the opponent's Internet home page, and a sample of the applicant's mark in use as a fold-out map, allegedly in the shape of a credit card. She further declared that her company provided travel information and services for tourists.

The applicant did not serve any evidence in answer.

Submissions

In relation to the ground that the mark was substantially identical to, or deceptively similar to one or more of the opponent's prior registered marks, Mr Stevens compared the present mark with the opponent's registrations for the word CITICARD in Class 36 for banking services, and also the words CITICORP, CITIPLAN and CITIBANK, in Class 16, for a wide variety of goods in that class. In relation to the Class 36 mark, he said that the marks were virtually identical and certainly deceptively similar, and that there was a close nexus between banking services and goods in Class 16. He referred for support here to the words of the Hearing Officer in *American Express Co v N.V. Anev* (1985) AIPC ¶90-258 at 36,472/3, where travel services and printed publications were found to be closely related. Mr Stevens said that any comparison should take into account the notional use of the goods and services involved - *Smith*

Hayden & Co Ltd's Appn (1946) 63 RPC. He said that the present mark was, at the least, deceptively similar to the opponent's family of Class 16 marks and covered the same goods. He cited the points of likeness of the competing marks and the established tests for assessing deceptive similarity. He also referred to the well known doctrine of "imperfect recollection" referred to in *Rysta Ltd's App'n* (1943) 60 RPC 87, and emphasised the importance of the first syllable in any comparison - *Johnson and Johnson Australia Pty Ltd v Kalnin* (1993) 26 IPR 435. This deception, he said, could well be exacerbated by the "family" of CITI- marks which had been developed by the opponent in relation to its banking and related services.

On the matter of whether, because of some connotation contained in the present mark, then its use would be likely to lead to deception and confusion, Mr Stevens alleged that the word CARD referred to a credit card and that the word CITY was a reference to CITIBANK. He said that the applicant's goods of interest - a map folded out from credit card sized covers was likely to deceive within the meaning of s.43.

In respect of the ground of opposition that, because of the reputation enjoyed by the opponent's marks, then use of the applicant's allegedly substantially identical or deceptively similar trade mark on its goods, would lead to deception or confusion, Mr Stevens said that the opponent's reputation was, from the evidence, considerable, as at the relevant date. He said that it was sufficient if an ordinary person was caused to wonder as to the origin of the goods - *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592. He alleged that this doubt would be in the minds of the relevant public, given that the opponent's evidence showed that it provided assistance to travellers and travel information, and attendant printed matter - in addition to its banking services. He said that this confusion would be compounded if the applicant used its mark on its goods of interest - city maps contained in the mock-up of a credit card.

Mr Stevens closed his submissions by saying that the opponent had not discharged its onus in relation to the application and that the Registrar should exercise his discretion to refuse to register the trade mark. He said that it was significant that no evidence or submissions had been made by the applicant to counter those of the opponent. He sought costs in the matter in favour of the opponent.

As I have previously indicated, the applicant did not put forward any submissions on the matter for the Registrar's consideration.

Analysis

I will deal, in this part of the reasons for my decision, with each ground in turn which Mr Stevens relied upon in the making of his submissions.

Section 44 - substantially identical or deceptively similar trade mark

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.

In deciding whether or not competing trade marks are substantially identical, or deceptively similar in relation to each other, the tests are conveniently laid out in such cases as *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641, and *Shell Co of Australia v Esso Standard Oil (Australia) Ltd*, (1961) 109 CLR 407, where Windeyer J said, at 414-415:

(in relation to substantial identity)...(the marks should) be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison,

and,

(in relation to deceptively similarity) 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 television exhibitions.

When the applicant's mark, CITY-CARD, is compared with the trade mark, CITICARD, covered by the opponent's prior registration, number 482523, in Class 36, I think that it is obvious that the marks are substantially identical. The essential elements of both marks are the words CITY, and its phonetic equivalent CITI-, and the common element CARD. There is a slight difference, in that marks are spelt differently, and also that the applicant's mark is joined by a hyphen and the opponent's mark is one word. However, the total impression of the marks is the same - being merely different spellings of the same word, or words. Having so determined, I must now look at whether the opponent's services are closely related to the goods covered by the present application. The services of 482523 are: "Banking services in this class including electronic transfer and access of funds". Mr Stevens has argued that there is a general nexus between Classes 16 and 36, and that the notional use of both sets of goods or services should be considered - especially given that banking services encompass a broad range of printed matter.

Although I do agree that a wide claim of goods in Class 16 could be said to bear some relationship to services in Class 36, I must note here that the present statement of goods comprises specific items, viz: "Maps for use in tourism areas". Despite Mr Stevens' submissions that banking services now go far beyond the mere handling of money and can include the provision of various "services" for travellers, I cannot agree that this would stretch to cover the provision of maps. I have yet to be offered a map in a bank and, even if I were to be given one, I would regard it as being a promotional vehicle rather than the bank's move into the tourism business. I concede that some banks do provide travel services but these are run as separate businesses to

the banks' primary role of making their profits through their manipulation of other people's money. For the foregoing reasons, I can only conclude that, while the competing marks might be substantially identical, the goods and services of the respective parties are not closely related.

I now move to the question of whether the opponent's Class 16 marks are deceptively similar to that covered by the present application. I think that it is obvious that the marks CITICORP (285587), CITIPLAN (219259) and CITIBANK (293574) cannot be considered substantially identical to the present mark because of the differing suffixes. However, the goods covered by registration numbers 285587 and 219259 are, in my opinion, similar goods to the present mark's goods, given their wide description in Class 16. However, those covered by number 293754 are quite specific, viz: "Printed publications dealing with finance and economics". These are not related to "Maps for use in tourism areas" covered by the present application, and they are not, to my mind, similar. I therefore rule out any consideration of 285587 in terms of the present ground under s.44, despite both covering goods in the same class.

Therefore, I must now consider whether the applicant's mark, CITY-CARD, on one hand, and the opponent's marks, CITICORP and CITIPLAN are deceptively similar. Section 10 of the Act defines a trade mark as being deceptively similar to another trade mark if it so nearly resembles that mark that it is likely to deceive or cause confusion. In this regard, and given the tests outlined in the relevant case law, consideration should be given to a normal person's impression based on a recollection of the opponent's marks. As Mr Stevens has submitted, deception or confusion can well ensue if that person retains an "imperfect recollection" of the opponent's marks, especially if it was inferred by users that the opponent was developing a series of CITI- marks. However, I am of the opinion that, in this instance, the misspelling of the prefix CITI-, followed by other material, in the opponent's marks is a relatively distinctive and memorable integer. This would serve to differentiate those marks from the correctly spelt first word CITY, joined by a hyphen to the word CARD, in the applicant's mark - especially given the use of the latter mark on its quite specific

and limited statement of goods. I think that a person of ordinary intelligence would easily make the distinction between the marks owned by the respective parties in the present case.

For these reasons, I do not find the opponent's prior registered trade marks to be deceptively similar to the mark covered by the present application. The opposition, as it is based upon this ground, must therefore fail.

Section 43 Trade mark likely to deceive or cause confusion

43. An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

In determining the s.43 ground, I note that the word “connotation” is a new term in Australian trade mark legislation. The following are two dictionary definitions which interpret the ordinary meaning:

Macquarie Dictionary:

1. the act or fact of connoting. 2. that which is connoted; secondary implied or associated meanings (as distinguished from denotation): for example the word "bum" has connotations of vulgarity.

Oxford English Dictionary

1. The signifying in addition; inclusion of something in the meaning of a word besides what it primarily denotes; implication.

Therefore it can be said that the word connotation refers to that which is implied in a trade mark - in addition to its essential or primary meaning. A connotation can result from the trade mark as a whole, or can result from a sign contained within the trade mark. The prominence and context of the potentially deceptive or confusing element in the trade mark is important in deciding whether the trade mark is likely to deceive or cause confusion. I note the *Explanatory Memorandum* which spells out the meaning of this section. This section, it says, provides that an application for registration must be rejected if the trade mark:

...because of some signification inherent to it, would be likely to deceive or cause confusion regarding a characteristic of the goods.

Considerations under s.43 must therefore concentrate on the matter within the trade mark that could cause deception or confusion in the mind of the relevant buying public.

The trade mark here is CITY-CARD. It is necessary, for the purposes of s.43, to look at the mark in the context of the goods, which are maps used by tourists. There is little, so far as I can see, in the meaning of the words CITY-CARD which has any direct reference to these goods. There is, I concede, an allusion to a map which may be of a city and perhaps may be on a card of some sort. However, there is nothing here which, to my mind, comes within the scope of deception and confusion.

I therefore find that the opposition, so far as it relies upon s.43, is not made out.

Section 60 - Trade mark similar to trade mark that has acquired a reputation in Australia

This section 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 with, 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.

I have already found that the applicant's mark is substantially identical to the opponent's Class 36 mark, CITICARD, but not substantially identical or deceptively similar to its Class 16 marks, CITICORP, CITIPLAN and CITIBANK. It remains to be determined then whether the opponent's reputation in CITICARD was sufficient, as at the filing date of the present application, so that deception or confusion would be caused if the mark CITY-CARD was used on tourist maps.

It would appear from the opponent's undisputed evidence, that that party has enjoyed a wide reputation for its CITICARD mark for some time and certainly as at the

relevant date. Mr Stevens has submitted that a great number of people would be caused to wonder as to whether the marks shared a common origin.

The applicant's goods are, "Maps for use in tourism areas". I have considered a sample of these goods, which was included in the opponent's evidence, in the light of Mr Stevens' submissions that deception or confusion could ensue because of its similarity in size and appearance to credit cards - goods used in relation to the opponent's services. However, I cannot infer any ulterior motive in the appearance of the goods. The size and shape of the map, contained within its cover, as shown in the evidence, could equally be considered as being similar to a business card and ideal, in that format, for carrying in pocket or purse.

Although it is true that the onus is on the applicant to satisfy the Registrar that there is no reasonable probability of confusion - as per Kitto J in the *Southern Cross* decision, supra, at pp.594-5, a mere possibility of confusion is not enough. There must be a real, tangible danger of its occurring. It is accepted law that the risk of deception and confusion must extend to a substantial number of people likely to be concerned in the purchasing of the particular goods or services - *Kendall Co v Mulsyn Paint and Chemicals* (1963) 109 CLR 300.

Given the foregoing, I think that it is the case here that, although the marks are deceptively similar, having regard to the opponents' reputation in the world of finance, very few people would consider that it was also in the business of providing tourists with maps. Therefore, I do not believe that the use of the subject trade mark on the goods would be likely to deceive or cause confusion to the appropriate public, as at the relevant date.

Accordingly, I must find that the opponent has not been successful on this ground of its opposition.

Onus on the applicant

It is the case that the applicant did not file any evidence in answer to the opponent's evidence, nor did it make any submissions, either in writing or in person, at the hearing. It is also true, as Mr Stevens pointed out, that the onus is on the applicant to

show that here is no reasonable probability of confusion - as per Kitto J in the *Southern Cross* decision, supra, at pp.594-5 and in *Johnson and Johnson Australia Pty Ltd v Kalnin* (supra) at 439. However, there must be a *reasonable probability* (my emphasis) of confusion. A mere possibility of confusion is not enough - there must be a real, tangible danger of its occurring. While the onus is on the applicant at all times to show that it is entitled to registration, there is an evidentiary onus on the opponent to make a prima facie case for the applicant to answer. This, I believe, the opponent has not done. It should not be fatal to an application if the applicant is silent in response to an opposition where no reasons are convincingly shown as to why the mark should not be placed on the Register.

Conclusion

Given the foregoing, I find that the opponent has not been successful on any of the grounds relied upon at the hearing. Accordingly, I can see no reason why the Registrar's discretion should be exercised in favour of the opponent in denying registration of the present mark. I therefore dismiss the opposition and, subject to any appeal from this decision and all of the appropriate fees being paid, direct that the trade mark, the subject of this application, should proceed to registration.

Costs

The applicant did not make any submissions with respect to costs and, given its non-service of evidence or appearance at the hearing, would not appear to have incurred any. I therefore will not make any award in this regard.

Ian Forno
Hearing Officer

26 February 1999