



TRADE MARKS ACT 1995

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

Re: Opposition by EFFEM FOODS PTY LTD to registration of trade mark application 720912(31) - MEATY BONE- filed in the name of STAR-KIST FOODS, INC.

BACKGROUND

The Trade Marks Office has advertised trade mark application number 720912 as having been accepted for registration. The trade mark is the following combination:



For convenience in this decision I will generally refer to this trade mark by the words it contains. However, in so doing I note and allow for the device element of the head of a dog, arguably a Border Collie.

The applicant is Star-Kist Foods Pty Ltd and the goods for which it seeks registration are animal foodstuffs and pet foods. These goods fall in international class 31.

Effem Foods Pty Ltd (the opponent) opposes registration of the application. It objects to registration for a variety of reasons. In simple terms, it argues that the trade mark MEATY BONE is too close to the opponent's well-known trade mark MEATY-BITES and that, in any case, MEATY BONE is either misdescriptive or, for some goods, so descriptive that it is not capable of distinguishing the applicant's goods.

In support of its opposition, the opponent has served and relied on evidence in support, the declarations of:

- Rhonda Steele, the Marketing Property Manager for Mars Inc. The opponent is part of the Mars Inc group.
- Celina Creek, a solicitor of the opponent's solicitor firm, Baker & McKenzie.

In answer to the opposition, the applicant has served a copy of the declaration of Gregory Nankin, company secretary of H.J Heinz Company Australia Ltd, of which the applicant is a wholly owned subsidiary.

At that point, the opponent requested a hearing, which I was delegated to conduct. Michael Kirov, solicitor, employed by Spruson & Ferguson, patent attorneys, represented the applicant. Julia Baird of counsel appeared on behalf of the opponent, on instruction from Baker & McKenzie, solicitors.

Issues and decision

Under the 1995 act, the opponent has a responsibility to establish, if it can, at least one ground of opposition. I will therefore adopt the headings under which the opponent's counsel, Julia Baird, argued the matter at the hearing.

Evidence in general

Ms Baird argued that the declaration of Mr Nankin, to which I have referred, should be given no weight on one issue, where Mr Nankin's personal opinion was being offered as evidence. She objected to Mr Nankin's assertion that the applicant's trade mark "is well known amongst the public and the pet food industry in relation to pet food".

Mr Nankin has declared to various matters for which, as company secretary of the applicant's parent company, he can be held to have taken responsibility for the veracity of his declaration. He declares that his declaration comes "from my own knowledge or from information provided to me by other employees of my Company or of my company's parent company H.J. Heinz Company in the United States" and I think this should suffice. On those matters, his testimony is unassailable. However, since his expertise in marketing is not clear, the accuracy of his opinions about the state of the public mind is not particularly relevant. I agree with Ms Baird that the inclusion of unsupported statements of opinion, by people whose views are not supported either by their qualifications or by other details in their

declaration, is undesirable. I of course accept the honesty of Mr Nankin's declaration, but the weight I can give to his personal opinion is just the weight that can ordinarily be given to the unsupported opinion of a citizen.

Ms Baird was also critical of the remoteness of the connection between Mr Nankin and the applicant. However, his corporate connection is at least as clearly stated as anything that Ms Steele has said, on behalf of the opponent, of her own affiliation with the opponent company.

Mr Nankin's declaration, in general, and allowing for some of the points made by Ms Baird, leaves me with the following picture:

The applicant's trade mark has been used in relation to bone-shaped dog biscuits, advertised under the house mark PET DELI TREATS. Ms Baird argued, and I accept, that this restricted use may well have contributed to the fact that, so far as Mr Nankin is aware, there has never been any confusion with the opponent's goods.

First use was in June 1996. Nearly all of the promotion of the applicant's goods has occurred after the filing date of the application. The spending of some \$964,000 on promotion and advertising in the period 1996-1998 (inclusive) is hard to ignore. However, Ms Baird argued that, very often, the samples of the advertisements that are in evidence emphasise that the MEATY BONE product is just one of a stable, if that is the right metaphor in such a context, of PET-DELI products. Other such products include PUP-ARONI, PORKY TREATS, SNAUSAGES, CHOW CHEWS and so forth.

The opponent's MEATY-BITE product, as Ms Baird points out, is a mixture of various shapes of dog biscuit, of which one shape is that of a bone. The product has been sold under a variety of trade marks over time since 1974: PAL MEATY-BITES, MEATY-BITES, PEDIGREE PAL MEATY-BITES, and these forms have all been registered for relevant goods.

I find Mr Kirov's argument that the reputation of the opponent subsists only in the combination, and not in the element MEATY-BITES, is out of step with the evidence. MEATY-BITES was used, as a trade mark, by itself, from 1984 to 1990. The overall tendency of the evidence, particularly the sales figures and the video sample of television advertising over a 20-year period ending March 1994, is to show that the trade mark

MEATY-BITES is well recognised in relation to dog food, and has been for some considerable time.

I also note that, through much of the opponent's advertising, there is a device element, a bounding, healthy dog. In some cases this dog is a Border Collie, but that is not always so. Overall, the impression is that, whatever dog or dogs appear in the opponent's add, they are bright-eyed, glossy-coated pictures of canine vitality.

It will be efficient if I leave further assessment of the evidence to a context of the specific issues raised by Ms Baird.

Conflicting trade marks

The relevant portion of section 44, which deals with conflicts with earlier applications or registrations, is as follows:

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 deceptively similar to another 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). (In this instance, the goods are the same goods)

Note 3: For *priority date* see section 12. (For present purposes, the priority date of the opponent's registrations is earlier than the applicant's)

For the purposes of the legislation Ms Baird, for the opponent, conceded that the competing marks are not substantially identical. However, she argued that the trade marks MEATY BONE and MEATY-BITES were deceptively similar. Under this heading, she marshalled a battery of relevant issues: imperfect recollection, sharing the same initial word MEATY, a second word beginning with a strong plosive consonant [b], similar inexpensive grocery lines sold in large or largish packages, both typically lettered and set out in a robust style and strong colours.

To this Ms Baird added that confusion need not persist up to the point of sale, and that, arguably, the confusion would not necessarily be that of an outright mistake. She referred here to the confusion that might arise if a buyer was to wrongly assume that the trade mark MEATY BONE simply "had to be" another product from the people who made MEATY-BITES, some sort of new but related product. One of the obvious and predictable things to be allowed for, she argued, was that both the applicant's and opponent's trade marks would be used in relation to bone-shaped dog biscuits.

Ms Baird also drew my attention to what she said was a paucity of trade marks containing the word MEATY, either on the register or in the sample of the packagings used by "other major competitors in the pet food market".

Mr Kirov replied to this with what seems to me a commonsense view. Nothing in the evidence suggests that the opponent has been able to commandeer the word MEATY as its personal property. MEATY remains an ordinary descriptive word.

Mr Kirov was critical of analysis of the results of a search of the register. Both search and analysis were contained in Ms Creek's declaration. Ms Creek had noted registrations for SPRATTS MOIST 'N MEATY, and for another trade mark containing the words ITS MEATY. Mr Kirov, however, noted that she had failed to comment on the significance of a registration for MEAT BITS. Mr Kirov also attempted to introduce from the bar table, as it were, details of another MEATY ... trade mark that had apparently once been registered. Introducing such late evidence is fraught with difficulties and I will disregard Mr Kirov's reference. If it really needed making, it should have been made either in answer to the opponent's evidence in support or, at worst, in a promptly-made request for permission to serve a copy of further evidence. Something that amounts to either the introduction of trivia or to a possible ambush at hearing is unacceptable.

Mr Kirov also suggested that the sample of packagings used by the opponent's competitors was not necessarily either relevant or representative. At least two of the bags in evidence seem to me to be aimed at Brazilian and Mexican markets. I do not think Mr Kirov was arguing that the opponent had been more successful in annexing "meaty" as an indication of trade origin overseas than here, so perhaps a sample that may be skewed towards a Spanish-speaking market is better than no sample at all. Either way, the opponent's own material shows that, somewhere or other, LUV TENDER CHUNKS are being marketed as "soft and

meaty". Similarly, Ms Creek's declaration shows these registered trade marks, one of which I have referred to previously:



I note that, in each instance, the registered owners have disclaimed right to the exclusive use of all of the words in the trade marks. Whatever the import of that in practice, I note Ms Baird's description of this sort of use as being use of "meaty" "in a longer, descriptive sense, as part of a complex mark".

Ms Baird argued that I should not judge too much from the state of the register. I accept this: the register is not decisive. From that, I also agree that not too much should be read into a trade mark as follows:



This trade mark has been, as Ms Baird pointed out, registered since 1954; that is, long prior to when the opponent in the present matter began to accrue trade mark reputation in the MEATY-BITES trade mark. Accordingly, while I believe that the state of the register, when tempered with argument and analysis, may well suggest the standards that prevail in the relevant trade, I completely agree that the study of the register in meticulous detail is not a substitute for the proper application of the relevant tests.

Mr Kirov pointed to one aspect of this opposition that Ms Baird had initially passed over: the changed onus under the 1995 legislation. It is no longer the case that registration will be denied unless the registrar is satisfied, positively, that there will be no reasonable likelihood

of deception or confusion arising from normal and fair use of the applicant's trade mark for any of the goods specified in the application. Under the 1995 legislation, during examination, s 44 will not preclude acceptance unless the registrar is satisfied that there is a significant risk of deception or confusion. This was clearly set out in *Registrar of Trade Marks v Woolworths* [1999] FCA 1020. French J, delivering the majority decision, affirmed that:

The question ... is not whether consumers might be confused (in the sense of wondering about a common origin or connection) but whether there is a reasonable likelihood that they will be confused.

There follows, at para 50, a significant revision of the standard test arising from older law. French J realigned the test under *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 to reflect the situation as it now exists, "absent the imposition of an onus on the applicant".

The present matter, of course, is an opposition one. Section 57 provides that:

The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Division 2 of Part 4...

Ms Baird conceded that, in the light of the change wrought by s 33, the opposition provisions must also work differently. She categorised the legislation, even so, as "evolution not revolution" and suggested that, in the adversarial forum of an opposition, the issues to be canvassed at acceptance can be looked at afresh. And so they can. However, the question that confronts me is one of fact: has a ground of opposition been established? As a consequence, and given the terms of sections 55, the applicant was under an onus only to the extent that the opponent could initially establish a ground of opposition.

To put an end to this matter, I am not convinced that the marks in question are deceptively similar. I will now explain this.

In the case of *Cooper Engineering Co. Pty. Ltd. v. Sigmund Pumps Ltd.* 86 CLR 536 what was at issue was the conflict of two trade marks, RAINMASTER and RAINKING, said to have the same idea. In the present case, I reject the idea that the present marks have the same idea. "Idea" has to be something more sophisticated than "meaty followed by a plosive consonant". Strictly speaking, therefore, the issue of "same idea" is not of concern. None the

less, given the opponent's apparent belief that it has rights in the word "meaty", I note the following, at p.539:

"But it is obvious that trademarks, especially word marks, could be quite unlike and yet convey the same idea ... To refuse an application for registration on this ground would be to give the proprietor of a registered trademark a complete monopoly of all the words conveying the same idea as his trademark. The fact that two marks convey the same idea is not sufficient in itself to create a deceptive resemblance between them, although this fact could be taken into account in deciding whether two marks which really looked alike or sounded alike were likely to deceive."

Are the marks, then, likely to deceive or cause confusion, given that they do not have a similar idea? Allowance must be made for the things Ms Baird canvassed, and for such things as heavy accents, bad telephone connections, imperfections of hearing and so forth, canvassed in Ms Steele's declaration. The latter are very marginal in this case, as pet food is primarily a self-serve, supermarket product.

I have allowed for potential similarities in colours used. This has, in practice, already come to pass. However, there is no suggestion that the applicant is attempting to pass its goods off as the opponent's. The similarities are limited to the strong colours that are characteristic of most of the packagings brought into evidence by the opponent. Ms Baird characterised these as "heavy", and emphasising the meaty content. That, however, is very much a matter of opinion and conjecture. Suffice it to say that pastels are not in great favour with dog-biscuit manufacturers at the moment.

There is also the fact that both competing marks are rendered with similar fonts. They feature exaggerated serifs and, overall, have a fairly chunky look. That, however, is not unusual. Without more, it does not make for deceptive similarity of trade marks.

The obvious fact here is that "meaty" is a descriptive element. In MEATY-BITES and MEATY BONE the common descriptor is part of two quite readily and reasonably distinguishable wholes. As Mr Kirov argued, the doctrine of imperfect recollection must be sensibly applied - see the Master of the Rolls' speech in *Application by Rysta Ltd*, 60 RPC at 105-106. He cautioned:

It is true that the possibility of imperfect recollection must be taken into account; but, with all respect to those who think otherwise, I cannot attach any real weight to this possibility in view of the distinctive features to which I have referred. The doctrine of imperfect recollection must not be carried too far. In considering its application, not only must the class of person likely to be affected be considered,

but no more than ordinary possibilities of bad elocution, careless hearing or defective memory ought to be assumed.

The finding that the trade marks MEATY-BITES and MEATY BONE are not deceptively similar also forecloses the opposition as it arises under s 60. That section allows an additional ground of opposition to a party that can point to a conflict with a substantially identical or deceptively similar trade mark (registered or otherwise) that has a sufficient reputation. While the reputation of the opponent's trade mark is clearly beyond question, the issue, because of my conclusion as to the comparison of marks, simply does not arise.

Descriptive/ Misdescriptive trade mark

Under this heading, Ms Baird argued that the trade mark MEATY BONE, with or without the picture of a dog, was so strongly descriptive of certain dog foods that it was not capable of distinguishing the goods of any one trader. If, on the other hand, the goods were not meaty bones, Ms Baird argued that the trade mark was caught by s 43, which deals with misleading trade marks:

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.

Ms Baird had two strands to this argument. Firstly she said that, on a plain reading of the words "meaty" and "bone", in the context of dog food in particular, the trade mark would be deceptive on goods that were either not meaty or not bones.

Mr Kirov, for his part, conceded that the meanings of the two words were of some relevance. However, he argued that, as a whole, the mark was simply an allusion. The average consumer would, he agreed, doubtless accept that there was some reason for the mark's adoption, but it would not be clear what that reason was. The goods, at the outset, were clearly not bones and would not be expected to be bones, though they would, given the common significance of the word "bone" in trade marks in class 31, be expected to have something to do with bones: shape, perhaps. He argued that, even in relation to shape, a bone could be a wide range of shapes. Otherwise, the word could refer in some way to something to do with flavour, or components. As a whole, therefore, he argued that the mark was no more than an allusion to the fact that the goods, whatever they were, were something that a dog would appreciate.

The goods covered by this application, at the time of filing, were quite generalised. During the course of examination, the question of misdescriptiveness was canvassed. The result was that the applicant restricted the goods to the current, more specific "animal foodstuffs and pet foods". It is less than clear that these extend to what the International Classification of Services describes as edible chews for animals. The opponent did not explicitly argue that these goods were included and I think the point is thoroughly moot. However, it must be dealt with, as I need to chart the extent of the problem, or perceived problem, to which the opponent is pointing. Therefore, I will say that I do not consider that simply being edible qualifies an object as a foodstuff when it is intended primarily for chewing, as distinct from ingestion.

As to the sort of bones traditionally sold by butchers as "dog bones", the position is a little clearer. Though the classification index is silent on the question, they would, if said to be for animal feeding purposes, be classified in class 31. They are, of course, essentially butchers waste products, virtually stripped of the meat which the butcher sells either whole or minced. None the less, they start life as a meat product and are sold to be, eventually, chewed up and swallowed for the benefit they bring, or are believed to bring, to the diet of the animal in question.

In another sense, bones are not so much a foodstuff as a dietary adjunct. They fall on a continuum, a line that stretches from meat, at one end, through cereal products, to, at the far end, edible dog chews and rubber bones. However, I think that the natural meaning of the words "foods" and "foodstuffs" is sufficiently broad as to include goods that are in the relevant class and that are deliberately fed to a dog, to be ingested for reasons that are at least partly dietary. I conclude, therefore, that animal bones are within the scope of the current application.

In relation to dog bones, I agree that Ms Baird has a point; the term "meaty bone" is a powerful description and, conversely, potentially misdescriptive where the goods are not meaty bones. As to any such apparent misdescriptive or confusing aspect to the trade mark, my comments about the shift in the onus under s 44 are equally appropriate to section 43. To intervene, I would need to be satisfied, to the necessary extent, not just that deception was a possibility, but that there was a sufficient likelihood of either deception or confusion, in terms as reformulated by French J in *Registrar of Trade Marks v Woolworths*, supra. It is not enough that, if I infer an unreasonable intention to completely mislead the public about the

nature of the goods, the applicant might be able to cause confusion by selling goods that are not meaty bones. Nor is it enough for me to speculate that, if the applicant is less than vigilant about packaging, a number of people will be confused or caused to wonder. If I am to intervene, I must be satisfied that, in all the surrounding circumstances, there is a reasonable risk of deception or confusion.

I am not so satisfied. The ordinary sorts of dog foods, be they biscuits or otherwise, could not reasonably be mistaken for any sort of actual dog bones, with or without attached fragments of meat. The different lines have different physical forms and storage requirements and their natures will be obvious even when packaged. The applicant's goods of interest will therefore not be at all likely to be confused with any sort of real dog bones, with or without meat, under any reasonable assumptions about current or likely future packaging possibilities. No reasonable consumer, under those circumstances, will be likely to encounter a pack or bag of the applicant's dog or other pet food and expect it to be a pack of real animal bones. Therefore, the opponent has failed to establish this aspect of its ground of opposition.

However, Ms Baird also argued that there was a second aspect to the s 43 issue. She argued that the meaning of "meaty" is not just a matter of dictionary entries, but of the factual situation. She argued that, for these goods, "meaty" had what she called an acculturated meaning, in which "meaty" connotes, ie means or implies, a connection with the opponent.

I also reject that argument in this case. Over time, decisions of the Trade Marks Office have reflected the various delegates' understandings of the intention of the legislation, seen in the Explanatory Memorandum at the time the legislation was before parliament. The connotation with which s 43 is concerned is one that is "inherent" to the mark.

New connotations can arise, of course, and will eventually make their way into dictionaries. Decisions of the Trade Marks Office have found that trade marks as diverse as CONFEST, RSL, SUMMER BAY and BRAVEHEART have acquired a relevant connotation. However, I do not consider that the word "meaty", in relation to dry dog food, with or without an image of a bounding, healthy dog, means or implies anything other than meaty. I do not consider that it has what Ms Baird called a "meaning by implication" beyond what the dictionary can tell.

There is, however, another side to this entire argument. The trade mark is not, in any practical sense, ever likely to be misdescriptive of any goods within the range now specified since, as I have said, it will deceive or confuse nobody. However, that finding almost invites a question under s 41, on which Ms Baird also touched.

In the simplest possible terms, section 41 deals with marks that are to be rejected on the ground that they are not capable, for one reason or another, of distinguishing the applicant's goods from those bearing similar trade marks that have been legitimately applied by others. There are different reasons why such a fact may be. Typically, the sorts of elements of trade marks that may sometimes be legitimately applied by more than one person are names or surnames, major geographical names and ordinary descriptions of the goods in question.

I have already said that the words "meaty bone" are a powerful description of dog foods when those foods are animal bones. I do not see that the words MEATY BONE, coupled with a picture of the head of a dog, results in a trade mark that will distinguish the applicant's (entirely hypothetical) dog bones from the meaty dog bones sold by any other pet food manufacturer.

Equally, however, I have said that this situation arises almost by accident, and that dog bones per se are not any part of the applicant's goods of actual interest. I believe that the appropriate outcome, these things being so, is for the scope of the application to be narrowed slightly. I will refer to this in my conclusion, which follows.

Conclusion

I have found that, when used in relation to the ordinary range of "animal foodstuffs and pet foods", there is not sufficient likelihood of deception or confusion between the applicant's goods and either the opponent's registered trade marks or the opponent's business under its trade marks. Secondly, I have found that the trade mark, for the same range of goods, is not inherently likely to deceive or confuse.

However, I have also found that the application is sufficiently broad in scope as to include goods that would be expected to be nothing but meaty dog bones, and that, for such goods, the trade mark is not capable of distinguishing, an essential requirement under s 41.

[13]

Therefore, in terms of s 55, the fate of the application cannot be fully decided at this time. If within the next 21 days the application is restricted to exclude animal bones, I will register it. If the application is not so restricted, I will refuse to register it. I reserve my decision on costs until the fate of the application is determined.

T.E. Williams
Hearing Officer
11 May 2000