



## TRADE MARKS ACT 1995

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

Re: Opposition by Australian Feed Company Pty Limited to registration of trade mark application 720314 (31) **AUSFEED AND DEVICE** and 748061 (31) - **AUSFEED - THE FARMER OWNED STOCKFEED CO AND DEVICE** - filed in the name of Ricegrower's Co-operative Limited .

#### Background

On 24 October 1996, Pivot Limited (Pivot) and Ricegrower's Co-operative Limited (RCL) lodged a joint application for registration of the following trade mark:



The application covered *foodstuffs and feed supplements for animals* in Class 31. On 3 October 2001, the application was assigned to Ricegrower's Co-operative Limited.

On 6 November 1997, the same parties lodged a joint application for a second trade mark:



This application also covered *foodstuffs and feed supplements for animals* in Class 31. Similarly, the application was assigned to Ricegrower's Co-operative Limited on 3 October 2001.

Both applications were accepted and advertised in the *Official Journal of Trade Marks*. The registrations are opposed by the Australian Feed Company Pty Limited (AFC). Notices of opposition were filed by AFC on 10 February 1998 and 29 May 1998 respectively. The grounds of opposition set out in the notices included grounds based on ss.41, 42, 43, 44, 58, 60 and 62 of the *Trade Marks Act 1995* (the Act). In due course the matters were set down for hearing and came before me as a delegate of the Registrar of Trade Marks in a single hearing on 20 November 2001 in Canberra. Mr Ryan of Counsel appeared for the applicant, instructed by Davies Collison Cave. Ms Baird of Counsel appeared on behalf of the opponent, instructed by Peter Maxwell & Associates.

At the hearing, the opponent principally relied on grounds pursuant to ss.41, 42, 43, 58 and 60 of the Act for both oppositions.

Shortly stated, the applicant is the operator of an animal feed mill in Cobden, Victoria. The applicant manufactures and sells its products in bulk and bagged forms. The opponent is the manufacturer of animal feeds which are sold commercially via distributors and retailers.

### **Evidence**

The opponent relies on the following evidence in support:

<b>Name</b>	<b>Date</b>	<b>Exhibits</b>	<b>Referred to as</b>
Linda Wareham	14 October 1998	LW1-LW7	Wareham(1)
Ron Major	14 October 1998		Major
Peter Aldrick	14 October 1998		Aldrick
Steve Rando	14 October 1998		Rando

Shortly stated, Ms Wareham is the administration manager of the opponent. Messrs. Major and Aldrick are respectively, the opponent's Queensland Sales Manager and Mill Manager. Mr Rando is a horse trainer and customer of the opponent.

The applicant relies on the following evidence in answer:

<b>Name</b>	<b>Date</b>	<b>Exhibits</b>	<b>Referred to as</b>
Trevor Gardner	19 April 1999	TG1-TG5	Gardner
Christopher Hibbert	23 July 1999		Hibbert
Sherrill Hinkley	1 August 1999		Hinkley
James Walsh	15 October 1999		Walsh
John Nugent	11 November 1999		Nugent

Mr Gardner is the sales representative for the Ausfeed Cobden Feed Mill, which Mr Gardner describes as a business jointly owned by Pivot and RCL. Mr Hibbert and Ms Hinkley are both involved in the farming industry in the areas surrounding the feed mill. Mr Walsh, now retired, was formally a farmer and farm machinery businessman, and has also been Chairperson of the Cobden Airport Committee which had dealings with the feed mill in relation to granting permission for its location. Mr Nugent is an agribusiness marketing consultant who was engaged by the applicant to make inquiries in relation to the opponent.

The opponent's evidence in reply was constituted by:

<b>Name</b>	<b>Date</b>	<b>Exhibits</b>	<b>Referred to as</b>
William Alexander	17 July 2001		Alexander
Douglas Booth	17 July 2001		Booth
Robin Mawhinney	18 July 2001		Mawhinney
Jennifer Spencer	20 July 2001		Spencer
Jennifer Deane	20 July 2001		Deane
Nonie Agresta	20 July 2001		Agresta
Linda Wareham	31 July 2001	LW8-LW22	Wareham (2)
Ian Hayes	31 July 2001		Hayes
Peter Lane	9 August 2001		Lane
Jim McFadden	13 August 2001		McFadden

Messrs. Alexander, Booth and Mawhinney are all customers of the opponent, located in South Australia, Queensland and Queensland respectively. Mss Spencer, Deane and Agresta are all employees of the opponent who, as part of their duties, answer

telephone inquiries on behalf of the opponent. Messrs. Hayes, Lane and McFadden are all sales representatives of the opponent. Mr Hayes' territory covers New South Wales. Mr Lane covers Queensland and Northern New South Wales. Mr McFadden is the sales representative for Victoria, South Australia and Tasmania.

### **General Submissions**

The opponent provided general submissions on several points, and it is convenient to deal with these first.

(a) *The opponent's use of "Australian Feed Company" and its abbreviations and colloquial use*

The opponent asserts that it has used the company and trading name "Australian Feed Company" since the late 1980s. It uses the name as its house name or mark, and the name operates as an umbrella name for a variety of products. It is clear from advertising and packaging material that the "Australian Feed Company Pty Limited" name is applied in various ways, but virtually always in conjunction with product names such as "Mitavite" and "Breeda". The opponent also says that it has been referred to as "Aussie Feed", "Aust Feed" and "Aus Feed" by its customers and sales representatives.

On the other hand, the applicant submits that the assertions made by the opponent relating to the use of the "abbreviated names" are insufficient to satisfy me that the opponent is in fact known by those names, or that it has used them in a trade mark sense.

My assessment of the evidence is as follows:

*Ms Wareham*

In her first declaration, Ms Wareham refers to the following relevant exhibits:

- LW1 - an historical company extract which shows that the Australian Feed Company Pty Limited is a registered corporation;
- LW3 - is a table of trade mark registrations, applications and lapsed registrations for the Australian Feed Company. The registrations appear to cover product names such as "Mitavite", "Breeda", "Vitamite" and "Gum Nuts". "Australian Feed Company" does not appear as a trade mark in that list.

- LW4 - is a bundle of advertisements for various products. All but one example use the term "Mitavite" in conjunction with the actual product name such as "Breeda". The "Mitavite" logo is used in conjunction with a stylised representation of a horse's head. The first two advertisements state that the product is "*from Mitavite*", but, in a separate location, they also state that the product is "*manufactured by*" the "Australian Feed Company Pty Limited". Where the advertisements show the packaging of the various products, "Australian Feed Company Pty Limited" appears in font which is significantly smaller than "Mitavite", the horse logo or the product name. The last brochure in the bundle is for "Vitamite Omega 3". In that instance, consumers are asked to contact "The Australian Feed Company Pty Limited" for further information.
- LW5 - is a bundle of articles written by an employee of the opponent. They are referred to as "Mitavite News Bulletins". They include the corporate and contact details for the "Australian Feed Company Pty Limited" and copyright is claimed in the name "Australian Feed Company Pty Limited".
- LW6 - comprises some further advertising where "Australian Feed Company Pty Limited" is used in conjunction with "Mitavite", a newspaper article where the "Australian Feed Company" is referred to as the manufacturer of "Mitavite" products, and a single advertisement where the expression "Australian Food Company" is used.

In her second declaration, Ms Wareham provides copies of more recent advertisements. The advertisements are similar to those that I have already mentioned. However, they also include the first apparent use by a customer of the opponent's e-mail address [ausfeed@ozemail.com.au](mailto:ausfeed@ozemail.com.au) on 7 August 1998 (LW19 - an e-mail from a Mrs M Berry).

Ms Wareham also provides copies of correspondence which illustrates that the name "Australian Feed Company Pty Limited" has been used on corporate stationery since 1991. The stationery includes the abovementioned e-mail address, together with the webpage addresses [www.mitavite.com.au](http://www.mitavite.com.au) and [www.cyberhorse.net.au/mitavite](http://www.cyberhorse.net.au/mitavite) .

Finally, Ms Wareham states in paragraphs 25 and 26 that her company is "constantly" referred to by its proper and abbreviated names. However, despite such "constant" use, Ms Wareham did not provide any documents to support her assertion.

*Mr Major and Mr Aldrick*

Both Mr Major and Mr Aldrick, who are employees of the opponent, state in their separate declarations, that:

- they have *always* referred to the opponent as "Australian Feed Company" or "Australian Feed";
- they have heard many other members of the horse trade describe the opponent and its products by those names;
- correspondence received from customers uses those names;
- they each *occasionally* refer to the opponent as "Aussie Feed"; and
- they have each heard others refer to the opponent by the name "Aussie Feed".

*(emphasis added)*

Neither Mr Major or Mr Aldrick provide any specific examples of such use. In particular, there are no examples of use of the terms in correspondence.

*Mr Rando*

Mr Rando makes virtually identical statements, although he makes them as a customer, rather than a sales representative. Again, he provides no actual examples of use of the abbreviated names.

*Mr Alexander, Mr Booth and Mr Mawhinney*

Each declarant says that he is aware that the opponent is often referred to as "Ausfeed", "Aust. Feed" and "Aussie Feed" by customers and the trade. Each states that he has used these names himself since 1990, 1999 and 1990 respectively. However, no specific examples are given.

*Ms Spencer, Ms Deane and Ms Agresta*

Each declarant is employed by the opponent and answers telephone calls on behalf of the opponent. Each uses the expression "Australian Feed Company" or "Australian Feed" when answering the phone or speaking with customers and clients.

*Mr Hayes, Mr Lane and Mr McFadden*

Each of the declarants are sales representatives of the opponents. They each state that they refer to the opponent as "Australian Feed Company" or "Australian Feed". They also state that one-third to one-half of their customers use the terms "Aussie Feed", "Aust Feed" or "Aus Feed". Each of the declarants provide the names of customers who have used those terms - Mr Hayes provides four names, Mr Lane four, and Mr McFadden two. There are no declarations from any of these customers, nor is there any indication which abbreviations were actually used or how regularly they are used.

On the basis of this evidence, I am satisfied that customers and members of the trade may refer to the opponent as "Aussie Feed", "Aust Feed" or "Aus Feed". However, and in the absence of any clear anecdotal or documentary evidence of such use, I am only prepared to find that it is used in this way *occasionally*. What use there has been, is, on the balance of probabilities, likely to have occurred prior to the priority dates. In this regard, I am placing reliance on the declarations of Mr Alexander and Mr Mawhinney. On the other hand, I am not satisfied that the abbreviated names have been used by anyone in a written form prior to the priority dates. Nor am I satisfied that any of these expressions are or have been used by representatives of the opponent in any formal sense, either orally or in writing. Accordingly, I am not satisfied that the opponent has used these abbreviations as their trade mark.

In relation to the use of the words "Australian Feed Company Pty Limited", the case is not so clear. It is clear that these words have been used on packaging and in advertising. However, they have always been used in conjunction with other, registered trade marks. The question therefore, is whether the evidence shows that the company name has, itself, been used as a trade mark.

Exhibit LW-14 is a an actual product shipping bag, the kind of which are shown in the advertisements. On the front, the words "Australian Feed Company Pty Ltd" are

shown in block letters that are 7 millimetres high and 9 millimetres wide. On the reverse, the contact details for the opponent are provided, and include the words "Australian Feed Company Pty Ltd". In most advertisements, the opponent's name is included only in the contact details, and there are a number of instances where the products are in fact described as being "from Mitavite". On corporate stationery, the company name is always accompanied by registered trade marks such as "Mitavite" or the horse's head. Finally, there are advertisements that feature measuring cups, which are described as "dippers". These dippers are embossed with the horse-head logo, "Mitavite", "1kg." and "Australian Feed Company".

Section 17 of the Act provides:

### **17 What is a trade mark?**

A *trade mark* is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

In other words, the trade mark must be used as a "badge of origin". In this respect, s.17 reflects the decision of Gummow J in *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* (1991) 21 IPR 1 at 25 where his Honour stated:

"... the primary function of a trade mark registered in Pt A or B of the register is that of distinguishing the commercial origin of goods or services sold under the mark. The registered mark serves to indicate, if not the actual origin of the goods or services, nor their quality as such, the origin of that quality in a particular business, whether known or unknown by name."

In the present case, I am not satisfied that the opponent has used "Australian Feed Company Pty Limited" or "Australian Feed Company" as trade marks when it has applied these terms to advertisements where the expression is used only as "contact details".

Nor is it used as a trade mark when used on the front of packaging, in the "Mitavite" news bulletins or as the letterhead on stationery which also carries a registered trade mark.

On the other hand, there is some limited trade mark use on the measuring cups. The trade mark use is achieved through the advertisements and the fact that the "dippers" were "available from all Mitavite suppliers" - Exhibit LW-4.

There is also a prima facie case that the expression "Ausfeed" as it has been used in the opponent's e-mail address, is sufficient to amount to trade mark use. I will deal with this further in due course.

Finally, I am not satisfied that the opponent's representatives' use of the expression "Australian Feed" to identify themselves is sufficient to find that the term is used as a trade mark of the opponent. In this respect, the expression was used to identify the agent, not the goods that they intended to sell. This is not trade mark usage. The evidence of Ms Wareham is that the expression "Australian Feed" has been used extensively, however there is no documentary support for this assertion. Again therefore, I am not satisfied that there has been trade mark usage of this particular expression.

*(b) Substantial identity and deceptive similarity*

The opponent asserts that the applied-for trade marks are substantially identical or deceptively similar to its own trade marks. In that sense, the opponent relies on "Australian Feed Company", "Aussie Feed", "Aust Feed", and "Aus Feed".

I have already indicated that I not prepared to find that "Aussie Feed", "Aust Feed" or "Aus Feed" are the trade marks of the opponent. Accordingly, any assessment of substantial identity or deceptive similarity must be limited to the applied-for trade marks:



and the applicant's unregistered trade marks "Australian Feed Company Pty Limited", "Australian Feed Company" "Australian Feed", and, potentially, "Ausfeed" as that term has been used in the opponent's email address.

## Grounds of Opposition and Findings

### Section 41

Section 41 states:

#### 41 Trade mark not distinguishing applicant's goods or services

- (1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For *applicant* and *predecessor in title* see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

- (2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

Note: For *goods of a person* and *services of a person* see section 6.

- (3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.
- (4) Then, if the Registrar is still unable to decide the question, the following provisions apply.
- (5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:
  - (a) the Registrar is to consider whether, because of the combined effect of the following:
    - (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;
    - (ii) the use, or intended use, of the trade mark by the applicant;
    - (iii) any other circumstances;the trade mark does or will distinguish the designated goods or services as being those of the applicant; and
  - (b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and
  - (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

Note 1: For *goods of a person* and *services of a person* see section 6.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

(6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

- (a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;
- (b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
- (b) the time of production of goods or of the rendering of services.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

The opponent asserts that the applied-for marks fall foul of s.41(2). In doing so, the opponent relies on the decisions in *W&G du Cross Ltd's Application* (1913) 30 RPC 216 at 227 and Kitto J in *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511 at 514. Specifically, the opponent asserts that the applicant's trade marks are a combination of a purely descriptive word element, "Ausfeed", and graphical elements which are, visually, "insignificant and non-distinctive" and, aurally, "irrelevant". In relation to the additional words "The farmer owned stock feed co" in 748061, the opponent asserts that these are merely descriptive, non-distinctive, carry no trade mark value and are unlikely to be used aurally. In other words, the word element "Ausfeed" is the prominent and central feature of the applied-for trade marks - the graphical and "subscript" elements should be ignored for the purposes of s.41, as they are non-distinctive, and have no relevance in aural use. In turn, the opponent submits that "Ausfeed" is merely a contraction of the words "Australian" and "Feed" - each of which are apt to describe the goods for which registration is sought - *Mark Foy's Limited v Davies Co-op & Company Limited* (1956) 95 CLR 190 - and the expression is one that other traders are likely to wish to use to describe their own goods.

I am not satisfied that the opponent's position is correct. I do not agree that, when assessing a trade mark pursuant to s.41, it is open to me to ignore or set aside the graphical elements of a graphical mark. If this were the correct approach, it would mean that the graphical portions of a trade mark would be irrelevant, or that an examination of the aural effect of a trade mark would be determinative of the matter. This cannot be the intention of s.41 and would be contrary to the principles laid down in cases such as *Diamond T Motor Co's Appn* (1921) 38 RPC 373.

Rather, I must assess each of the applied-for trade marks and ask whether, as a whole, other traders are likely to need or wish to use the trade marks as they have been applied-for. In relation to 720314 which is represented as:



the font used is generally unremarkable. However, the representation of the "f" does have a significant degree of adaptation. There is nothing before me to suggest that other traders are likely to wish to use this graphical device to describe their goods. Certainly, there is nothing before me to indicate that it is a device which is common to the trade. Accordingly, when taken as a whole, I am satisfied that the graphical mark does have the necessary inherent capacity to distinguish.

I am similarly satisfied in relation to 748061. That mark, it will be recalled, is as follows:



The trade mark has the additional elements of a subscript contained within a solid line, and a replication of the "grain" motif inside a dark circle - both of which add to the mark's inherent capacity to distinguish.

Accordingly, I am satisfied that the applied-for trade marks do satisfy the requirements of s.41.

As I have found that the applied-for trade marks satisfy s.41(2), it is not necessary to consider ss.41(3)-(6).

For these reasons I am not satisfied that the ground of opposition has been made out, and it must fail.

#### **Section 42**

The opponent asserts that the applicant's use of the expression "Ausfeed" may contravene s.52 of the *Trade Practices Act 1974* (TPA). Section 52 provides that *a corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.*

As a result of the decision in *Advantage-Rent-a-Car Inc v Advantage Car Rental Pty Ltd* 52 IPR 24, the Registrar needs to consider the effects of the *Trade Practices Act 1974* when it is raised in opposition proceedings.

The opponent states that the applicant's marks are, in essence, contractions of the opponent's corporate name. As such, use of the marks will suggest a connection or association between the applicant and the opponent or some other sponsorship, licence, approval or common origin that does not exist. It makes this submission on the basis that the opponent's name is "commonly" contracted to "Ausfeed" or very similar variations on that word.

I have already found that clients of the opponent may use the expression *occasionally*. I am not satisfied on the evidence before me that it is the *common* occurrence that the opponent suggests. Similarly, there is no evidence before me which indicates that there has been, or that there is, a reasonable likelihood of deception or confusion occurring.

[14]

As such, I am not satisfied on the evidence or argument that has been put to me that the opponent *would* make out its case pursuant to s.52 or that the applicant is currently or would in the future be in breach of s.52.

Therefore, I am not satisfied that registration of the applied-for trade mark would be contrary to law.

### **Section 43**

Section 43 states:

#### **43 Trade mark likely to deceive or cause confusion**

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.

Section 43, when used in opposition to registration, requires an opponent to show that:

- (a) there is a connotation in the proposed mark or one of its parts; and
- (b) because of this, the trade mark is likely, when in use, to deceive or cause confusion.

*T.G.I. Friday's Australia Pty Limited v TGI Friday's Inc.* [2000] FCA 720, confirms that the connotation must be in the mark itself, and cannot be determined as the result of external considerations, such as reputation.

The standard to be applied when testing for deception or confusion was set down by French J in *Registrar of Trade Marks v Woolworths* (1999) AIPC 91-499 at 39,695 (paragraph 43). In considering the phrase "likely to deceive or cause confusion", his Honour said:

The use of the word 'likely' in this context does not import a requirement that it be more probable than not that the mark has that effect. The probability of deception or confusion must be finite and non-trivial. There must be a 'real tangible danger of it occurring'.

The Trade Marks Office *Manual of Practice and Procedure* Part 29 Paragraph 4 states:

If the inclusion of the name or representation is likely to lead the ordinary buying public to the conclusion that the person whose name or representation appears in the trademark, has endorsed the product or services in some way, then a ground for rejection exists unless the applicant has permission to use the name or representation in the trade mark upon the product or in relation to the services specified in the application.

In *George Schmidt v Down to Earth (Victoria) Co-Operative Society Limited* 41 IPR 632, Hearing Officer Forno found that deception or confusion might arise by virtue of an implied endorsement or licence of services by a person or organisation. In *Twentieth Century Fox Film Corporation v Durkan* 47 IPR 651 - BRAVEHEART, Deputy Registrar Hardie confirmed that it is not necessary for the purposes of s.43 for there to be a competing trade mark in the name of the opponent or at all.

In the present case, the opponent asserts that the connotation which arises from the proposed marks is one of association with, or endorsement by, the opponent.

To my mind, the initial connotation which arises from each of the applied-for marks is one of animal feed grown in Australia. There is no deception or confusion that would arise from this.

Subjectively, there is nothing in the marks which suggests or connotes an association with the opponent. In other words, I do not believe that the term "Ausfeed" has achieved the currency in language that the term "Braveheart" had done in BRAVEHEART. Nor am I satisfied, on the evidence, that the term is associated with the opponent in the minds of the "considerable proportion of the public involved in the purchase and use of foodstuffs and feed supplements for animals" that the opponent claims.

In these circumstances, the ground must fail.

## **Section 58**

The opponent submits that the applicant is not the owner or first owner of the trade mark for the following reasons:

- (a) there is no authorship or invention in the mere contraction or variation of common English words which are descriptively apt for the goods in question - therefore, the applicant cannot be the owner; or, alternatively
- (b) if there is authorship, the applicant is not the first owner as the opponent was the first user of substantially identical trade marks for the applied-for goods, and such use occurred before the priority date.

In relation to the first submission, I am satisfied, when the marks are taken as a whole and in their graphical form, there is sufficient authorship or invention. I am not prepared to assess them on the basis that their essential element is merely "Ausfeed" - I must look at the whole of the mark and compare it with that claimed by the opponent - *Carnival Cruise Lines Inc v Sitmar Cruises Ltd* (1994) 31 IPR 375.

In relation to the second submission, I am not satisfied that the opponent was the first user of the relevant trade marks. As I have already indicated, I do not believe that the opponent has ever used the expressions "Aus Feed", "Aussie Feed" or "Aust Feed" to describe itself. These are words that have been used by customers and clients, not by the opponent. As such, it is hard to see how any claim to ownership of the trade mark could be sustained by such people. If the opponent seeks to rely on its use of [ausfeed@ozemail.com.au](mailto:ausfeed@ozemail.com.au), Ms Wareham confirms at paragraphs 26 and 27 of her second declaration that the address was chosen and operated from July 1997. This is clearly after the first priority date.

Therefore, this ground fails.

## **Section 60**

Section 60 states:

### **60 Trade mark similar to trade mark that has acquired a reputation in Australia**

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.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

To satisfy section 60, the opponent has the burden of establishing the following elements:

- (i) a pre-existing trade mark;
- (ii) substantial identity or deceptive similarity between the applied-for trade mark and the pre-existing trade mark;
- (iii) the acquisition of a reputation in Australia by the pre-existing trade mark; and
- (iv) a likelihood that, because of that reputation, use of the applied-for trade mark would be likely to deceive or cause confusion.

The opponent's position is that :

- the applied-for trade marks are deceptively similar to the opponent's trade marks;
- the opponent's trade marks had acquired the requisite reputation as at the priority dates; and
- as a result of the reputation, if the applicant were to use the applied-for trade marks, deception or confusion would arise.

In making its submissions, the opponent asserted that its trade marks were "Australian Feed Company", "Aussie Feed", "Aust Feed" and "Aus Feed". However, I have already found that the only trade marks on which the opponent can rely on are "Australian Feed Company" as used on the measuring cups, and, potentially, "Ausfeed" as that term has been used as an e-mail address.

In relation to "Ausfeed", Ms Wareham concedes that the e-mail address was not chosen or used until July 1997. This is subsequent to the first priority date. Accordingly, as a trade mark, it cannot have achieved the requisite reputation *prior* to the first priority date. In relation to the second application, for 748061, I am not satisfied on the evidence, which is discussed further below, that the requisite

reputation was garnered by the second priority date, 6 November 1997. Therefore, "Ausfeed" as an email address needs not be dealt with further.

*Is there deceptive similarity between the relevant trade marks?*

Deceptive similarity, pursuant to s.10 of the Act, requires consideration of whether the trade marks so nearly resemble each other as to be likely to deceive or cause confusion. The consideration should, according to Dixon and McTiernan JJ in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641 at 658, take account of the following matters:

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 effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. 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.

In *John Fitton & Co. Ltd's Application* 66 RPC 110 at 113, the Assistant-Comptroller, commented:

With reference to the nature of the confusion alleged, the evidence furnished on behalf of the Opponents by their trade declarants is directed not so much towards showing that the two marks 'Jests' and 'Easyjests' might themselves be confused either visually or orally, as towards establishing that confusion would result, owing to the presence of the common element 'Jest' in each mark, in traders and the public being induced to believe that the two sets of goods sold under the marks emanated from one and the same trade source.

The question is therefore to be determined on the basis of the recollection or impression taken away from an encounter with the marks. This encounter may be aural and visual. One must also have regard to the common elements of the marks.

In the present case, I believe that the impression taken away from the applied-for trade marks is one of "Ausfeed" supported by a sheaf of wheat or other grain with a long stalk. In my mind, this then leads to an impression that the goods are Australian animal feed, possibly based on a grain product. In relation to 748061, there is the additional elements of "The farmer owned stockfeed co" and the circular image in the

top left corner. The circular image reinforces the grain aspect. The additional words draw attention to the ownership base of the organisation. This latter aspect is something that is likely to affect the impression taken away.

In terms of the opponent's trade marks, there is little for me to go on visually. Any use of the trade marks has been in plain font, without any graphical embellishments. The impression therefore is also one of an Australian-owned or Australian-based feed company. This is largely the same as 720314, but different to 748061. I am therefore satisfied that there is a *degree* of deceptive similarity in both 720314 and 748061 to the opponent's trade marks and that generally, the trade marks convey a *common idea*. This is to some degree lessened in 748061 by the additional words, but I do not believe that this fundamentally or substantially changes the *common idea*.

In terms of aural similarity, I believe that there is little similarity between "Ausfeed" and "Australian Feed Company". For trade marks purposes however, the expression "Australian Feed Company" is, practically, reduced to its essential elements - "Australian Feed". This is the element that is likely to be used when spoken, or recalled later. When this is taken into account, there is a much higher degree of similarity - particularly when one takes into account the habit of Australians to slur and contract longer names, and the concept of a *common idea* is considered.

Therefore, I find that the applicant's "Ausfeed" is deceptively similar to the opponent's "Australian Feed Company".

*Did the opponent's trade mark have the requisite reputation at the priority date?*

Ms Wareham states that the opponent undertook significant advertising using the trade marks "Australian Feed Company" and "Australian Feed" in the period 1989-1990 though February 2001 (Wareham (1) at paragraph 10 and Wareham (2) at paragraph 7). In support of this, she relies on a number of different brochures and magazine advertisements. However, and for the reasons I have already discussed, this material does not amount to trade mark use. In each case, and with the exception of advertisements containing the measuring cups, the expressions were not used as trade marks. Therefore, they are of little assistance in terms of s.60.

There is no evidence before me as to when the material which did include the trade mark was released to the public. Specifically, there is no indication that any of the brochures featuring the measuring cup were released before the priority dates. Nor is there any indication of when the cups were actually made available through Mitavite distributors.

Accordingly, there is no evidence before me which establishes trade mark usage before the priority date. As a result, s.60 cannot be made out.

For the sake of completeness, I also note that *if* the letter of 3 May 1991 (Exhibit LW-12) is evidence of trade mark use of the corporate name before the priority dates, I am not satisfied that this single example is sufficient to assist the opponent in establishing its reputation at the relevant time. Similarly, if the use of the corporate name on packaging and in advertisements *did* amount to trade mark use, I was not taken to any documentary evidence which established that the material was released to the public prior to the first priority date, nor which satisfied me that a reputation had arisen in that trade mark prior to the second priority date. Specifically, the Mitavite news bulletins which are dated 1997 were not, in my opinion, sufficient to make out that a reputation had been earned in the alleged trade marks "Australian Feed Company" or "Australian Feed Company Pty Limited".

As I have found that the requisite reputation did not exist at the priority dates, there is no need for me to consider whether deception or confusion would arise. This ground must fail.

### **Conclusion**

I have found that none of the opponent's grounds of opposition relied on at the hearing have been made out. I am not satisfied that the remaining grounds of opposition which were raised in the notice of opposition have been made out. Accordingly, the opposition must fail. Subject to the expiry of any relevant appeal period and the payment of any outstanding fees, the applications may proceed to registration.

[21]

In relation to the question of costs, I direct that the opponent pay the applicant's costs in these proceedings.

Geoff Purvis-Smith  
Hearings Officer  
28 February 2002