



TRADE MARKS ACT 1995

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

Re: Opposition by American Cyanamid Company to registration of trade mark application number 785004(5) - **CALPLATE**- filed in the name of Peter Vanas.

Background

Peter Vanas (the applicant) filed trade mark application for the word mark CALPLATE on 10 February 1999 in respect of 'vitamins' in class 5 of the International Classification of goods and services. The application proceeded to acceptance without objection from this Office. It was advertised as accepted in the *Australian Official Journal of Trade Marks* of 10 June 1999.

American Cyanamid Company (the opponent) filed a notice of opposition on 9 September 1999, within the time allowed to do so, that listed grounds of opposition under s.57 in relation to ss.41, 42(b), 43 and 44 and also under ss. 58, 59 and 60 of the *Trade Marks Act 1995*.

Following the service of the evidence in support and the expiration of the time allowed for the applicant's evidence in answer, the opponent requested to be heard in the matter and it came before me in Sydney on 16 November 2000.

The opponent is a company with a particular interest in supplying food supplements to the general population, and markets a calcium supplement under the CALTRATE mark, through its Australian subsidiary, Wyeth Australia Pty Limited. The sales figures, which the opponent has requested remain confidential, show strong sales from 1992 (the first year quoted) to more than double that figure by 1999. Until 1997, the opponent's goods were available only through pharmacy outlets but after that date, non-pharmacy trade channels, such as supermarkets and grocery stores, have also been opened up. The opponent also has three registered trade marks which either contain or consist of the word CALTRATE.

The Evidence

The opponent's evidence supporting its opposition is the single declaration by Stanley J Silverberg. Mr Silverberg is a Senior Trade Mark Attorney for the opponent, in the United States of America. He gives details of the opponent's Australian trade mark registrations and describes trade mark use of CALTRATE throughout Australia, in respect of a range of vitamin and mineral preparations and nutritional supplements. This use dates from 1985. He also provides sales figures for goods sold under the mark during calendar years 1992 to 1999 and advertising expenditure for 1994 to 1999.

Mr Silverberg says (at clause 8) that the trade mark CALTRATE has been 'extensively advertised and promoted throughout Australia in the form of leaflets, information cards, point of sale displays, trade journals (PS Post Script), message pads, book advertisements and magazine advertisements', and he exhibits samples of these under SJS-3.

The applicant did not serve any evidence in answer to the opposition.

Submissions and Discussion

At the hearing, the opponent was represented by Mr Gerard Skelly of Spruson & Ferguson, Patent and Trade Mark Attorneys of Sydney. The applicant chose not to be represented, nor did he provide any submissions in the matter.

At the outset of the hearing, Mr Skelly stated that the opponent only intended to pursue two grounds listed in the notice of opposition, those under s.44 and s.60. The other grounds of opposition, those taken under ss.41, 42(b), 43, 58 and 59 are not supported either in the evidence or in the submissions and, thus, in relation to those five grounds, I find the opposition to be unsuccessful.

(a) Section 44 - Identical etc. trade marks

The legislation relevant to this matter under s.44 reads:

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; ...

(ii) ...; 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.

Note 2: For *similar goods* see subsection 14(1).

Note 3: For *priority date* see section 12.

Subsections (3) and (4) have no application here and have not been cited.

Mr Skelly highlighted the opponent's three registered marks consisting of, or containing, the word CALTRATE, pointing out that all three encompassed 'vitamins' within their specified goods and also enjoyed priority dates earlier than the present application. The only matter that needed assessing concerned the similarity of the respective trade marks involved, he said.

Details of the opponent's three trade mark registrations are as follows.

Number	Trade Mark	Priority Date	Goods
405180	CALTRATE	14 March 1984	Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; vitamin and mineral preparations, including high potency calcium supplements; and all other goods in class
717616	IT'S NEVER TOO LATE FOR CALTRATE	17 September 1996	Pharmaceutical preparations; multimineral/multivitamin preparations and nutritional supplements
717617	CALTRATE, FOOD FOR BONES	17 September 1996	Pharmaceutical preparations; multimineral/multivitamin preparations and nutritional supplements

I agree with the above summing up of the relevant issues by Mr Skelly. The present trade mark application was filed on 10 February 1999 in respect of 'Vitamins'. Clearly the opponent's three registered marks have earlier priority dates and the goods are coincident. The only issue that remains to be considered under s.44 is the similarity of the marks themselves. Mr Skelly submitted that the applied for mark exhibits the most similarity to 405180, the opponent's mark for the word CALTRATE, solus. He stated that it was on that trade mark that the opponent particularly relied under this ground of opposition. I agree with Mr Skelly's view that the present mark exhibits the closest likeness to 405180 and it is with that mark that I intend to examine the issue of similarity.

Mr Skelly reminded me that the test for deceptive similarity did not require a side by side comparison¹ but is one of 'net impression or recollection' of the opponent's mark when faced with the present mark.

He also submitted that in assessing deceptive similarity of two trade marks, it is necessary to consider all of the surrounding circumstances² - the nature and kind of customers, the type of goods involved and the manner in which the goods may notionally be sold - together with allowance for an imperfect recollection of the opponent's mark. Mr Skelly also argued that the words of Gummow J from *Johnson & Johnson v Kalnin and Another* 26 IPR 435 at 441 (114 ALR 215) applied in this case, in relation to a consideration of deceptively similar marks. There, Justice Gummow stated:

Counsel for the respondents submitted that the Johnson & Johnson mark is so famous in Australia that the likelihood of any imperfect recollection should be discounted. The evidence does not admit any conclusions as to the precise mechanisms involved in cognitive processes. But it does suggest that the process of perception and recognition of a word involves not so much the reading of the entire word or, in this case, the compound expressions BAND-AID or BAND»»IT but the seeing and identification of certain features which are then matched to that which is contained in the memory, so that the word then is recognised. It is that process which is liable in the present situation to lead persons into error.

Mr Skelly submitted that, in the present instance, 'the seeing and identification of certain features which are then matched to that which is contained in the memory' would be likely to produce a confusion between the words CALTRATE and CALPLATE. He also provided argument concerning the 'surrounding circumstances' for purchase of vitamins - that the goods are not expensive, the goods can become disorganised on shelves where some customers move the containers, and that the goods can be purchased by all strata of society. Additionally, here the trade marks both consist of purely invented words and also that a hastily written order for CALTRATE or CALPLATE could be confused one for the other. Mr Skelly referred me to a number of cases where such circumstances had been considered³.

As Mr Skelly correctly pointed out, the comparison for deceptive similarity between trade marks is not to be done side by side. The test that is to be assessed is whether a person of

¹ *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407 at 415.

² *Re: Application by Pianotist Co Ltd* (1906) 23 RPC 774 at 777;
Australian Woollen Mills Ltd v F. S. Walton & Co Ltd 58 CLR 641 at 658.

³ *Aristoc Limited v Rysta Limited* 62 RPC 65;
Hugo Boss AG v World One Co Limited [2000] ATMO 88;
Re: ANA Laboratories Limited's Application for Registration of a Trade Mark (1952) 69 RPC 146;
Re: McDowell's Application for a Trade Mark (1927) 44 RPC 335 at 341.

normal intelligence and recall would retain the same impression based on a recollection of each of the respective party's marks, CALPLATE and CALTRATE.

During the course of his submissions, Mr Skelly advocated that the coincident goods of both parties here are not expensive and could be quite hastily self-selected. I do think, however, that there are some other factors at work here that need to be considered. The actual coincident goods are vitamins. I believe that such goods, for the present health conscious generation, are not chosen without some measure of thought - the matter of health food supplements, and wellbeing issues generally, occupying a central place in the minds of many purchasers of such food supplements. Moreover, although the goods may not be described as 'expensive' I am of the opinion that neither would they be considered as 'inexpensive' for the majority of Australian households. As I have previously alluded, these types of goods, because of their very nature, are normally purchased with greater care than their cost would indicate. Both of the marks here begin with the same prefix of three letters CAL-, and end with the same three letter suffix -ATE. However, the consonants 'PL' and 'TR', respectively, in the central part of these words have very different pronunciations. The plosive consonant P, in CALPLATE, produces a 'division' in pronouncing that word which assists in highlighting the part word -PLATE. This same effect, to a slightly lesser extent, occurs with the 'hard' consonant T in CALTRATE. The emphasis produced on these part words by these effects will assist some to differentiate between the marks. In addition, possible conceptual confusion produced by any similarity of ideas in these marks is reduced because the part word 'PLATE' in the applicant's mark has a general dictionary meaning whereas the part word 'TRATE' in the opponent's mark, although used in several chemical names, does not. The combined effects of the differences in pronunciation of, and the phonetic emphasis on, the respective part words, -PLATE and -TRATE, is sufficient, in my view, to negate any likelihood of phonetic or conceptual confusion.

I am also of the view that the general purchasing public do have a much greater cognisance of trade marks themselves than the same public of 30 or 40 years ago. People are now more aware of trade marks, and their influence on the general population through mass marketing. The sale of pharmaceutical goods such as vitamins and other health food supplements is one area impacted by this greater awareness.

Some of the factors that I have outlined above, are not only important for the aural comparison but are also relevant to the visual comparison of the respective marks. Such factors as the importance of health related goods to the present Australian population, the cost

of these goods in relation to the benefit derived and the greater awareness of trade marks themselves, are all relevant surrounding circumstances for a visual comparison of the selection of goods, under the respective trade marks.

In relation to the possibility of deception and confusion occurring Mr Skelly also submitted that for the present circumstances, there is a real, tangible likelihood⁴ of this occurring among a substantial number of prospective purchasers.

Although the initial part of both marks is the same three letters, CAL-, the letters that are different (-PL- and -TR- respectively) in the central part of each word are very unlike in appearance. In order to find that these marks are deceptively similar I would need to be 'satisfied'⁵ that there was a reasonable likelihood of deception or confusion' occurring if the mark of the present application were used in the face of the opponent's mark. I am not satisfied that this is the case. Although there is some similarity between these words, for the above reasons, I am not satisfied that, visually, CALPLATE will be reasonably likely to be confused with CALTRATE by customers for both parties' goods.

Mr Skelly also commented that, in relation to the s.44 ground, the notional use of the respective marks for all goods claimed should be considered. He submitted that it is not a matter of what the applicant is presently doing with its mark that must be considered, but what it can do if registration is obtained⁶. Notwithstanding, in the present instance, the applicant has only nominated one item in the specification of goods, being 'vitamins'. This is, therefore, the full extent of coverage if registration is obtained. Throughout these reasons the full weight of the possible rights in relation to these goods have been considered and I cannot agree that any notional consideration of the goods would mean that any deception or confusion would be likely to occur.

From the foregoing, I do not believe that there is 'a reasonable likelihood of deception or confusion among a substantial number of persons'⁷ or 'a real tangible danger' of deception or confusion occurring⁸ among 'a number of persons' visually, aurally or contextually for the applicant's and the opponent's respective marks.

⁴ *Registrar of Trade Marks v Woolworths Limited* 45 IPR 411 at 428;

Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd (1954) 91 CLR 592 at 594, 595.

⁵ *Registrar v Woolworths*, supra, at 426.

⁶ *Registrar v Woolworths*, supra, at 428;

Berlei Hestia Industries Ltd v Bali Co Inc (1973) 129 CLR 353, at 362; 1 ALR 443, at 450.

⁷ *Smith Hayden & Co Limited's Application*, (1946) 63 RPC 97 at 101.

⁸ *Registrar v Woolworths*, supra, at 426.

As I have found the respective trade marks of the applicant and opponent not to be deceptively similar, I accordingly find that the ground of opposition under s.44 is not successful.

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

The legislation, in relation to this ground of opposition, allows:

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.

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

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

In terms of the s.60 ground of opposition, Mr Skelly reiterated that the applicant's mark is deceptively similar to the opponent's CALTRATE mark. He added that the opponent's mark had acquired a reputation before the present application date of 10 February 1999. The reputation, he said, was supported by the uncontroverted figures in the Silverberg declaration and the other evidence, to show that the opponent's goods are sold through both pharmacy and non-pharmacy outlets. Because of the size of this reputation, he claimed, a significant proportion of the Australian population would have been aware of the opponent's mark, as at the relevant date, so that the use of the applicant's mark would be likely to deceive or cause confusion. Mr Skelly also submitted that the applicant and the opponent marketed the same goods, through the same trade channels, and catered for the same classes of customers.

The issue of deceptive similarity of the applicant's CALPLATE mark and the opponent's CALTRATE mark has been explored under s.44 above. I found there that the marks were not deceptively similar. There is no need to repeat that finding here, although there is one further aspect to add under the terms of s.60.

Notwithstanding the foregoing, this section of the Act requires it to be shown that there exists a reputation for the opponent in its mark and that, because of that reputation, the use of the applicant's trade mark would be likely to deceive or cause confusion. The most usual way for an opponent to demonstrate such a reputation is by evidence of the use of its mark in Australia. In the present matter, the opponent has shown that the use of its mark is in respect

of food supplements containing calcium. This circumstance, in my opinion, leads to a lesser likelihood of deception or confusion between the respective trade marks. I note from the publication *Acronyms, Initialisms & Abbreviations Dictionary* (1991) 15th Edition edited by Jennifer Mossman, that CAL is a recognised abbreviation for 'Calcium'. Thus, I believe that the relevant purchasing public will receive a cue, in the opponent's trade mark for which the reputation is shown, that the CAL- prefix is a descriptive element acting as a guide to more quickly identify the opponent's calcium supplements. This type of marketing is often used by trade mark owners for goods, which are self-selected in a competitive market, and purchasers have come to expect such indicia. This is especially so in the present circumstances, where the full technical chemical name may not be one that they would readily remember. A reference to a constituent of the goods, such as by the CAL- prefix, would assist prospective purchasers to locate the goods quickly in, for instance, a supermarket. I am accordingly of the opinion that, the existence of a CAL- prefix in a mark for calcium supplements will be used by purchasers, more particularly, as an identifier of the goods - whereas the remainder of the mark will be used, more particularly, as an identifier of the trade source.

Thus, a prospective purchaser, either scanning the shelves of a supermarket or requesting an item from a shop assistant, would be more likely to give greater than the usual attention to the rest of the trade mark, beyond the prefix CAL-, when selecting calcium supplements by means of the mark. This is one further aspect to enable differentiation of the respective marks in terms of s.60, beyond the issues that I have already mentioned under s.44 above.

Thus, I find that opposition in terms of the s.60 ground is not successful because the applied for mark is neither substantially identical with, nor deceptively similar to, the opponent's CALTRATE mark.

Conclusion

From the foregoing, I have found that the opposition is not successful under any of the grounds taken in the notice of opposition. Thus, in my capacity as the delegate of the Registrar in this matter, I dismiss this opposition and direct that, on payment of the registration fee, this application may proceed to registration.

Costs

Mr Skelly sought costs on behalf of the opponent during his submissions.

I note that the applicant neither submitted any evidence for this proceeding, nor did he attend the hearing or provide submissions in the matter. In the circumstances of this particular opposition action, I believe that it is appropriate that the parties bear their own costs. Thus, I make no award.

Don Nancarrow
Hearing Officer

12 February 2001