

TRADE MARKS ACT 1995

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

Re: Opposition by Shirley Joan Smith to registration of trade mark application 884358(30,35) – **LAVENDER LADY** - filed in the name of Lavender Lady (Australia) Pty Ltd.

DELEGATE:	Alison Windsor
REPRESENTATION:	Opponent: Gregory Chambers and David Longmuir of Phillips, Ormonde & Fitzpatrick, Patent and Trade Mark attorneys Applicant: Louis Mamo, director of the applicant company
DECISION:	2007 ATMO 23 S52 opposition: grounds under ss59 and 60 established – opposition successful – costs awarded against applicant

Background

1. Lavender Lady (Australia) Pty Ltd (“the applicant”) applied to register a trade mark on 31 July 2001. The trade mark consisted of the words LAVENDER LADY, and the application was for goods and services in two classes as follows:

Class 30: Foodstuffs including condiments, sauces, chutney, honey, mustard, ice cream, cheese, flavourings, tea, chocolate, fudge and biscuits

Class 35: Wholesale and retail services associated with the sale of personal care, beauty and other body care products including: cosmetics, make-up powders, perfumery, soaps, creams, essential oils, preparations for the hair including shampoos, hair colorants, hair dyes, hair lotions and hair spray; scented preparations including scented waters and atmospheric perfuming preparations, sachets for perfuming articles and the atmosphere, air fresheners and potpourri; lavender and other oils for perfumes and scents; lavender water; foodstuffs including condiments, sauces, chutney, honey, mustard, ice cream, cheese, flavourings, tea, chocolate, fudge and biscuits

2. The application was examined as required by the legislation, no grounds for rejection were identified, and it was advertised as accepted for possible registration on 29 November 2001.
3. On 27 February 2002, Shirley Joan Smith (“the opponent”) filed a notice of opposition (“the notice”). The evidence submission stages allowed by the *Trade Mark Regulations 1995* followed. However, the process was extremely protracted.

The final evidence, the opponent's evidence in reply, was not served and filed until 10 July 2006, a period of over 4 years from filing the notice.

4. The opponent requested a hearing, and the matter eventually came before me, as a delegate of the Registrar, in Melbourne on 9 March 2007. The opponent was represented by Gregory Chambers and David Longmuir of Phillips Ormonde & Fitzpatrick, patent and trade mark attorneys. The applicant was represented by Mr Louis Mamo, one of the directors of the applicant company.

Notice of opposition

5. The notice nominated 11 grounds of opposition, covering most allowable matters. It is appropriate to refer to the ground numbered 10 early in this decision, as it deals with where the onus in an opposition lies. The ground reads as follows:

The onus is on the Applicant to show that the Opposed Trade Mark should be registered in relation to said Goods and said Services, but the applicant has not and cannot discharge that onus.

This comment about where the onus lies is simply not correct. Under the 1955 Act it was well established that the onus of proof in opposition proceedings lay with the applicant. The opponent needed only to establish that there were matters for the applicant to answer and if that was not done, the application was rejected. Under the 1995 Act, the onus of proof has been reversed. It is up to the opponent to establish at least one of the grounds of opposition on which it relies before it can be successful.

Evidence and submissions

6. The evidence received and considered is set out in the following table:

Declarant	Date declared	Exhibits	Known as
Evidence in Support			
David Bertram Fitzpatrick	10 February 2003	DBF 1 to DBF 12	
Shirley Joan Smith	4 August 2003	Exhibits 1 to 17	SJ Smith 1
Donald Howe Smith	15 September 2003	Exhibits A to D	
David Francis Stuart Longmuir	29 June 2004	DFSL-1 to DFSL-24	Longmuir 1
Evidence in Answer			
Jennifer Lillian Dewis	30 May 2005		
Richard Neal	06 June 2005		
Louis Charles Mamo	07 September 2005		LC Mamo
Frances Christine Mamo	07 September 2005		FC Mamo
Robyn Bond	15 November 2005		
Walter Douglas Pinkard	25 November 2005		
Clive Richard Larkman	06 December 2005		
Evidence in reply			
David Francis Stuart Longmuir	08 June 2006	DFSL-25 to DFSL-31	Longmuir 2
Christopher John Walder	06 July 2006		
Andrea Forsbrook	04 July 2006		
Garry Ross Cassidy	30 June 2006	GRC-1	
Shirley Joan Smith	03 July 2006	SJS-18 to SJS-22 and SJS-25	SJ Smith 2
Peter Sandor	07 June 2006		
Helena Taylor	04 July 2006	HTS-2 and HTS-3	
Judith Roberts	04 July 2006	JR-1	
David Francis Stuart Longmuir	07 July 2006	DFSL-32 to DFSL-33	Longmuir 3

7. The trade marks office received the declaration known as SJ Smith 2 on 11 July 2006, with exhibits SJS-18 to SJS-25. On 17 July, the office was advised that the same declaration had been sent to the then agents for the applicant, Allens Arthur Robinson, (“AAR”) with a covering letter advising that two of the exhibits were confidential, and were not to be disclosed to the applicant. AAR advised that it did not consider this material to have been properly served, as it was of the opinion it could not advise its client in any meaningful way about the contents of the declaration because of the confidentiality request. AAR requested that SJ Smith 2 be either excluded from the evidence or that the office provide some alternative guidance with respect to its status within the evidence.

8. Following suggestions from a duty officer within the trade marks office about appropriate service of documents, the opponent advised it no longer sought to rely on exhibits SJS-23 and SJS-24. AAR objected again, but the duty officer advised the declaration, minus the two exhibits, would be allowed as evidence. Because of the uncertainty surrounding the particular declaration, additional time was allowed for AAR to consider its content, and to advise the applicant whether a hearing was appropriate.
9. The opponent requested a hearing on 27 September 2006. On 4 October 2006, the office received a letter and Statutory Declaration from Mr Louis Mamo, director of the applicant company. The letter advised that the declaration was a submission in reply to the evidence in answer (sic), and was filed because the applicant would not be present at the hearing. The letter also advised the applicant would prefer that the opponent did not receive a copy of the submissions.
10. A duty officer advised Mr Mamo that the submissions he had provided raised new issues, and because of this, would be regarded as evidence. He was given advice about the requirements for lodging further evidence in an opposition, including the requirement that the opponent be served with a copy of any information. Following a telephone conversation with the duty officer, Mr Mamo advised he did not intend to apply for permission to serve the material as further evidence, and requested the declaration be withdrawn from consideration. He did, however, file written submissions in support of his case on 16 November 2006. These submissions were not served on the opponent and Mr Mamo was advised by the duty officer that they would thus not be relied upon as formal evidence. Subsequently, the opponents requested access to both the declaration and the written submissions via Freedom of Information provisions, and copies of all the material was released to them shortly before the hearing.
11. Rather than describe the evidence from each party in detail, I shall refer to the relevant portions where required in my discussions. I have not included the declaration noted above which Mr Mamo requested be withdrawn from consideration in the evidence I have considered.

Discussion

12. At the hearing, the opponent did not press all grounds on the notice. It submitted:

“The Opponent does not abandon any ground and maintains its opposition on all of the above grounds. However, the Opponent considers that the matter can be principally disposed of by reference to the grounds under sections 44, 58, 59 and 60”.

While I note the comment that other grounds of opposition have not been abandoned, the opponent did not choose to lead any information in their support. As the onus is on the opponent to establish any ground of opposition, the failure to provide information results in the ground necessarily not being established. This, to my mind, is an effective abandonment of the ground. For completeness therefore, I note that none of the remaining grounds on the notice have been established, and I dismiss them.

13. It is obvious from the evidence filed that there is a good deal of ill feeling between the parties to this opposition. Much of the evidence provided by both parties appears to be aimed at discrediting the other side, rather than providing sound, relevant information about their separate businesses. This kind of evidence does not serve to assist me in making my decision, as what is required is hard information which goes to clearly showing the factual basis of the state of play within the market over the period when both parties are claiming ownership of the trade mark under consideration. While much of the evidence is opinion, there is sufficient hard information for me to consider the grounds the opponent addressed at the hearing.

Section 58 – applicant not owner of trade mark

14. In order to establish its opposition under section 58 of the Act, an opponent must show that:
- the respective trade marks of applicant and opponent be either identical or substantially identical (*Carnival Cruise Lines Inc. v Sitmar Cruises Limited* (1994) 31 IPR 375, (1994) AIPC 91-049, (1994) 120 ALR 495), and,
 - the respective goods or services of the parties be the ‘same kind of thing’ (*Re: Hicks’s Trade Mark* (1897) 22 VLR 636, 3 ALR 75), and,
 - a person other than the applicant has the earlier claim to ownership based on use prior to both the present application to register and actual use of the trade mark by the applicant (*Settef SpA v Riv-Oland Marble Co (Vic.) Pty Limited* 10 IPR 402 at 413 and *Re: Hicks’s Trade Mark*, above, at 639).

15. The opponent's registered trade mark, nominated in the notice under the section 44 ground appears below:

Trade mark no.: 802774
 Owners: Shirley Joan Smith, Donald Howe Smith
 Goods/Class: Class 3: Soaps, perfumery, essential oils, cosmetics,
 hair lotions
 Priority date: 06 August 1999



Trade Mark:

16. The section 58 ground fails at the threshold because the two trade marks are neither identical nor substantially identical. According to the generally accepted tests¹, substantial identity is the result of a comparison of the trade marks side by side; noting their similarities and differences and assessing the importance of these taking into account the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.
17. Both trade marks contain or comprise the words LAVENDER LADY. However, the image of a lady in an long ruffled dress, picture hat and carrying a large bunch of something that could be construed as lavender is most prominent in the opponent's registered trade mark. The image is proportionately larger than the words LAVENDER LADY, and creates a significant difference between the two trade marks. There is no scope in this test to consider the idea of "imperfect recollection" as would be done when determining deceptive similarity. The differences between the trade marks when seen side by side are sufficient for them not to be substantially identical. Having failed at the threshold, this ground cannot be established.

Section 59 – Applicant not intending to use trade mark

18. This section of the Act reads as follows:

The registration of a trade mark may be opposed on the ground that the applicant does not intend:

- (a) to use, or authorise the use of, the trade mark in Australia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Australia;

¹ Windeyer J in *Shell Co. (Aust) Ltd v Esso Standard Oil (Aust) Ltd*, (1961) 109 CLR 407 at 414.

in relation to the goods and/or service specified in the application.

19. In order to be successful in an opposition, the onus is on the opponent to substantiate the grounds of opposition pursued. In the case of the section 59 ground, the opponent must effectively substantiate a negative. However, once they have called the applicant's intentions into question, it is up to the applicant to provide information in rebuttal.
20. It is accepted that the making of a trade mark application is prima facie indication of an intention to use.² According to section 27 of the Act, the requirements for a person to apply for a trade mark are that the person claims to be the owner of the trade mark, and there is either use already taking place, or an intention to use in the future, by the person himself or by another person under authorization. Section 59, however, is written in the present tense, and refers to a continuing intent to use, as set out in *Sapient Australia Pty Ltd and Sapient Corporation v SAP Aktiengesellschaft* [2002] ATMO 51 (20 June 2002) where Hearing Officer Mr Williams said:

This ground is also one where an applicant's intention to use is relevant. However, it is a ground written in the present tense and looks at the present state of the intention of the applicant. The introduction of such a ground is consistent with the creation of s 108, which had no counterpart under the 1955 legislation. Under s 108, a party defending an application may well be a different entity from the one who initially filed the application. Thus, section 59 deals with current defects in intention to use, interlocking with section 58, under which the intention and facts at the time of filing are the relevant elements.

21. The opponent provided evidence which calls into question the applicant's ongoing intention to use the trade mark for which he has applied. Exhibit 15 to SJ Smith 1 is a copy of a letter from the applicant, signed by Louis Mamo, to the Department of Justice and Industrial Relations, Consumer Affairs and Fair Trading in Hobart, Tasmania. It is dated 8 October 2002. Mr Mamo appears to have written the letter as a response to correspondence from the department following their receipt of a letter of complaint from the opponent. The letter of complaint is not in evidence.
22. Mr Mamo wrote, in part, the following:

We are a duly registered company *Lavender Lady (Australia) Pty Ltd*. The details as may be seen on our letterhead above, appear solely on our invoices and our pricelists. As we have effectively been trading as

² *Aston v Harlee Manufacturing Co* (1960) 103 CLR 391

Lavender House, only the name of either *Lavender House* and/or *Tasmanian Lavender Gardens* appear on all our product information, product labels, display material, general information sheets etc., that would be sighted by the general public.

23. Exhibit 14 to the same declaration consists of a document³ submitted by Mr Mamo to the trade marks office as part of his submissions in respect of his company's opposition to the opponent's now registered trade mark, 802774. In this document, Mr Mamo made the following comments:

... The words Lavender Lady is (sic) a generic term that has been and is still being consistently used by various parties for a considerable number of years and is synonymous with the growing and marketing of lavender and lavender products. As such, we have no requirement to limit its use by the Applicants or anyone else for that matter. We do however, strongly object to anyone attempting to secure the term Lavender Lady for their own exclusive use. ...

It must also be noted that the title Lavender Lady (Australia) Pty Ltd has only appeared on letterheads and price-lists, never on product to avoid confusion as well as any suggestion of unethical conduct on our part.

24. It is clear that Mr and Mrs Mamo did at one time use the trade mark LAVENDER LADY, as shown by exhibits LCM-1, LCM-2 and LCM-3 to Louis Mamo's declaration. Only the latter is dated, annotated with a market date of 25 April 1993. However, at some time around this date, it appears the labeling changed. It is not at all clear from the applicant's declarations when this happened but the FC Mamo declaration states a business name "Lavender House" was applied for and registered in August 1992. The same declaration also refers to a "logo" consisting of a picture of a woman wearing a hat and carrying a basket, which Mrs Mamo calls "the lavender lady logo". This picture, she says, has been in uninterrupted use since 1990. The picture appears below, as part of the applicant's registered trade mark 884357:



25. Both Mr and Mrs Mamo place heavy emphasis on use of their registered business name - Lavender House - and their registered company name - Lavender Lady

³ Also forms part of Exhibit DBF 10 to the Fitzpatrick declaration

(Australia) Pty Ltd. Similarly, the Mamos emphasise that Mrs Mamo was known at the community markets she frequented as “the Lavender Lady”. I understand the reasoning behind this emphasis, but it is necessary to point out that use of business names, company names or indeed the verbal identification of the holder of a craft stall is not necessarily proof of trade mark use.

26. In *Shahin Enterprises Pty Ltd v Exxonmobil Oil Corporation* [2005] FCA 1278, Lander J made the following comments:

Trade mark use is not any use. It must be public use in the course of trade so as to distinguish one trader’s goods from another. ...

There is a clear distinction, in my opinion, between conducting a business under a particular name and using a mark in respect of goods or services. The intention which the applicant needed to establish was an intention to use a mark to distinguish goods or services in the course of the applicant’s trade from goods or services provided by any other person. Because it has established that it intended to use the name to brand its businesses, that does not mean, however, it has established that it has used a mark or a sign to distinguish goods or services in the course of trade.

27. Mr Mamo has made it clear that he was not using LAVENDER LADY on or in physical relation to his goods in and around 2002. He said this was because he wished to avoid confusion. I consider it safe for me to infer that this comment still applies, especially given the repeated references in Mr Mamo’s material to his business, professional and personal ethics.
28. Given these comments, and acknowledging there is ill feeling between the parties, I accept the possibility that filing this application is a tactical ploy on the applicant’s part, of the kind referred to in *Wal-Mart Stores, Inc v Ozark-London td* [2004] ATMO 33 (21 June 2004). The Delegate made the following comments:

Taken in totality, an inference could be drawn from the opponent’s evidence before Mr Williams that the applicant had filed the application for tactical or strategic reasons as a part of its dispute with the opponent. The applicant did not present evidence or argument to refute that inference. Mr Williams said:

The evidence of use that has been filed will thus support an inference that SAP Ag's past use will continue and, further, that the present application was filed for tactical reasons only and not supported by any genuine intention to commence bona fide commercial use. I do not say that Sapien has proved its case - it does not have the unenviable job of "proving a negative" - but if

"slight evidence will suffice"⁴ then it has done sufficient to shift the onus onto SAP Ag, requiring it to validate its intention.

29. Mr Mamo did not rise to the challenge and validate his intention to use his trade mark. If I am correct in inferring that Mr Mamo, and through him the applicant company, did not wish to cause confusion within the market in which he operates, I think I am safe in inferring that he did not, at the time this opposition was mounted on 27 February 2002, intend to use, as a trade mark, the plain words LAVENDER LADY. This inference establishes the section 59 ground of opposition.
30. An opposition may be successful if a single ground is established. However, in case I have drawn an incorrect inference here, rather than decide the matter on the basis of this ground of opposition alone, I shall consider the remaining grounds pursued at the hearing.

Section 60 – trade mark similar to one with a reputation in Australia

31. Section 60 of the Act provides:

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.

32. I have determined that the two trade marks under consideration here are not substantially identical. However, the test for deceptive similarity does not involve a side by side comparison, but an assessment of the likely effect of the trade marks on the purchaser if they are seen in isolation from one another. The comparison of a trade mark must take place in the context of the particular market in which the traders operate. In *Re Application by the Pianotist Co Ltd* (1906) 1A IPR 379 at 380; 23 RPC 774 at 777, above, Parker J, as he then was, said:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of

⁴ *Estex Clothing Manufacturers Pty. Limited v. Ellis and Goldstein Limited*, 116 CLR 254 at 258

customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

33. The applicant is claiming the words LAVENDER LADY as its trade mark. In the situation envisaged by Windeyer J, that is, “the impression based on recollection of [one trader’s mark] that persons of ordinary intelligence and memory would have; and, on the other hand, the impression that such persons would get from [the other trader’s mark]”, confusion between these two trade marks is a strong possibility.
34. Most literate people are likely to remember a trade mark consisting of pictures and words by the words rather than by the picture. The applicant’s trade mark consists of the two words contained within the opponent’s trade mark which are most likely to remain in a purchaser’s mind. If the two sets of goods are not side by side on the shelf where they can be directly compared, I consider there to be a real tangible danger that purchasers will confuse their trade source. The trade marks are thus deceptively similar, and I am able to continue to assess the situation under section 60.
35. The matter of reputation was discussed in *McCormick & Company Inc v McCormick* [2000] FCA 1335 where Kenny J said at paragraph 81:

What is intended by the word "reputation" in s 60? The word is defined in The Macquarie Dictionary as follows:

reputation ... 1. the estimation in which a person or thing is held, esp. by the community or the public generally; repute ... 2. favourable repute; good name ... 3. A favourable and publicly recognised name or standing for merit, achievement, etc. ... 4. The estimation or name of being, having done, etc, something specified.

Cf. The Oxford English Dictionary. In s 60, the word is, I think, apt to refer to "the recognition of the McCormick & Co marks by the public generally".

36. Reputation in Australia cannot be assumed - it must still be established as a question of fact - per Lockhart J in *Conagra Inc v McCain Foods (Aust) Pty Ltd*, (1992) 23 FCR 302. It is not necessary to prove reputation by direct evidence of consumer appreciation; it is commonplace to infer reputation from a high volume of sales, together with substantial advertising and other promotions: *McCormick & Co Inc v McCormick* (supra) at 129. The reputation may be set up in the broader community,

or within a reasonably specialized market – *Pioneer Hi-Bred Corn Corp v Hy-Line Chicks Pty Ltd* [1979] RPC 410.

37. I am satisfied that the opponent has a reputation for goods containing lavender within its rather limited market. The market appears to include the whole of the state of Tasmania and extends outside the state via sales on the ferries which run between Tasmania and the Australian mainland. For a cottage industry, the opponent's sales appear quite reasonable, and the evidence provided points to the goods being sold in a variety of venues. But more to the point, the opponent has demonstrated use of its registered trade mark, a trade mark which is deceptively similar to that which the applicant wishes to register, within the market they both trade in, on or in close relationship to its goods, for a period of at least five years prior to the filing date of the notice of opposition. The applicant, however, has clearly stated it did not use the trade mark for which it applying on its own goods during that same time frame.
38. I am satisfied that, because of the reputation acquired by the opponent's trade mark, use of the applicant's deceptively similar mark within the same market on any lavender goods would be likely to deceive or cause confusion. This being so, the opponent has been successful in establishing this ground of opposition.

Section 44 – identical etc trade marks

39. Having decided the opponent has established grounds under sections 59 and 60, it is strictly not necessary for me to consider this ground. However, for completeness, I shall comment in respect of this ground.
40. Three matters are required for a ground to be established under section 44. The opponent must be able to point to a trade mark on the trade marks register which has an earlier priority date, is substantially identical or deceptively similar, and is claiming similar goods or closely related services. The opponent pointed to its registered trade mark noted above, 802774.
41. I have decided the trade marks under consideration are deceptively similar to each other and the opponent has the earlier priority date. The remaining matter for consideration in respect of section 44 is a comparison of the goods and service specifications, noting that both parties appear to operate in the same market.

42. The opponent submitted that the applicant's claim for services of retailing and wholesaling various goods in class 3 were services closely related to the goods claimed in the opponent's registration. The two Longmuir declarations go to providing information to support this contention. Even without this information, I am of the opinion that, in the specific market of personal care goods, the goods themselves and the services of retailing and wholesaling them are closely connected.
43. In support of this opinion, I refer to a decision of a delegate of the Registrar in *Warnaco US Inc v Estee Lauder Cosmetics Ltd* (2000) 50 IPR 43. This was an opposition case which involved the same issue in contention here. One party was claiming various goods in class 3, whilst the other party had, as part of a multi-class claim, the services of retailing those same goods in class 35.
44. In discussing retail services, the delegate said the following:

In terms of subsection 44(2), the question posed is whether those services above are closely related to the Estee Lauder goods. In *Registrar Of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411 at 424, French J observed:

[037] The concept of "closely related goods" in respect of a service mark was introduced into the 1955 Act by the 1978 amendment. It was not defined in the 1955 Act nor is it defined in the 1995 Act. It is also used in s 44 (1) to prevent registration of a trade mark in respect of goods which is substantially identical with or deceptively similar to a registered or priority trade mark in respect of "similar goods or closely related services". The term "closely related" recognises that goods and services are different things. There will be classes of goods which are similar to each other. There will also be classes of services which are similar to each other. But the word "similar" does not apply as between goods and services. So there must be some other form of relationship between the services covered by one mark and the goods covered by another to enable the goods or services in question to be described as "closely related". As its use in the Mathys Committee report indicated, however, it is a term of wider import than "similar" and can apply to the relationships between competing services as well as between goods and services: Cmnd 5601 para 70.

[038] The range of relationships between goods and services which may support the designation "closely related" will be limited by the requirement in s 44 (2) that there be a substantial identity or deceptive similarity between the potentially conflicting trade marks which attach to them. The relationships may, and perhaps in most cases will, be defined by the function of the service with respect to the goods. Services which provide for the installation, operation,

maintenance or repair of goods are likely to be treated as closely related to them. Television repair services in this sense are closely related to television sets as a class of goods. A trade mark used by a television repair service which resembles (to use the language of s 10) the trade mark used on a prominent brand of television sets could be deceptively similar for suggesting an association between the provider of the service and the manufacturer of the sets. Similar examples were suggested in *Caterpillar Loader Hire (Holdings) v Caterpillar Tractor Co* (1983) 1 IPR 265; 48 ALR 511 by Lockhart J who saw service marks as potentially giving rise to problems of confusion with goods marks and other service marks "... of greater difficulty and subtlety than has previously been experienced in the case of goods marks alone". His Honour observed (at IPR 276; ALR 522) that:

Confusion is more likely to arise where services protected by service marks necessarily involve the use or sale of goods or where services (for example, consultancy services) involve goods but can be provided either with or without the sale or promotion of goods.

[039] In *Rowntree plc v Rollbits Pty Ltd*⁵, above, registration was sought for a trade mark in respect of foods which included biscuits, cakes and pastry goods. The same applicant also sought registration of a service mark with respect to services rendered or associated with restaurants, takeaway food stores and other retail food outlets which sell and promote prepared food and drinks for consumption. Both applications were accepted but opposed. On appeal by the opponent from the decision of the registrar, Needham J found the applicant's mark in respect of goods to be deceptively similar to the opponent's registered mark as covering goods "of the same description" under s 33 (1). His Honour also concluded that the goods covered by the opponent's registered mark were "closely related" to the services in respect of which registration of the applicant's service mark was sought. While accepting that it was not a logical necessity that the relevant question under s 33 (2) of the 1955 Act must be answered in the same way as the question under s 33 (1), his Honour said at 546:

... I think, in the present case, that the conclusion that the goods are goods of the same description requires a conclusion that the services contemplated by the defendant, which would feature the goods already held to be goods of the same description as those of the plaintiff, are services closely related to the plaintiff's goods.

In the light of the above, I consider the services 'Retail store services for the sale of fragrances, toiletries and related accessories' to be closely related to the Estee Lauder goods. I note that there is a high degree of consultation in relation to the sale of perfumery and toiletries which is a specialised retail service and that such services are provided in direct

⁵ *Rowntree plc v Rollbits Pty Ltd* (1988) 10 IPR 539

relation to the goods as they enter the market. Sales consultants at perfume counters regularly wear the badges, scarves or some other identifier of the perfume houses for whom they work. And the signage of the perfumes or perfumer appear in close proximity to the salesperson.

45. I am thus satisfied that the applicant's retailing services, in so far as they cover similar goods to those of the opponent in class 3, are closely related services.
46. The applicant, however, is also claiming a range of foodstuffs in class 30⁶, and wholesaling and retailing services related to those goods as well. The opponent has submitted that the goods claimed are goods of the same description as the opponent's class 3 goods. The reasons for this are, they said, "that it is common for business specializing in lavender goods to sell both cosmetic goods containing lavender and also lavender based foodstuffs under the same trade mark and from the same outlet".
47. I do not agree that foodstuffs in class 30 and personal care goods such as soaps, perfumery, essential oils, cosmetics, and hair lotions are goods of the same description. Their purposes are quite different – one being eaten, largely for nutritional purposes and the other being applied to the external parts of the body, for cleansing, improving the quality of the skin or simply for olfactory pleasure via the perfume. Whilst use of either set of goods may result in feelings of pleasure, there the similarity ends. The goods may have some ingredients in common, such as scented leaves, oils or flowers, but use of a common component does not always result in a similar product. Shampoo containing lavender, for example, is simply not a similar product to lavender flavoured chutney.
48. This ground of opposition is thus not established in respect of the goods claimed in class 30, and the retailing services related to them. However, this is scant consolation for the applicant, as the opponent has been successful in respect of other grounds and is thus successful overall.

Decision

49. The opponent has established grounds of opposition under sections 59 and 60. It is thus successful in this opposition. I refuse to register trade mark application 884358.

⁶ Foodstuffs including condiments, sauces, chutney, honey, mustard, ice cream, cheese, flavourings, tea, chocolate, fudge and biscuits. I note here that the item "cheese" is wrongly classified – it should be in class 29.

Costs

50. The opponent has requested its costs. Having been successful, it is so entitled. I award costs against the applicant at the official scale.

Alison Windsor
Hearings Officer
Trade Marks Hearings
IP Australia

26 April 2007