



## TRADE MARKS ACT 1995

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

Re: Opposition by Haw Par Corporation Limited to registration of trade mark applications 902630 and 902631(5) - **TIGER PLAST & device** and **TIGER PLAST** - filed in the name of The Thai Enterprises, Limited.

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|------------------------|---|
| <b>DELEGATE:</b>       | Mary Skivington   |
| <b>REPRESENTATION:</b> | Opponent: Martin Pollock of Spruson & Ferguson, Patent and Trade Mark Attorneys.<br>Applicant: Philip J Kerr of Allens Arthur Robinson, Patent & Trademark Attorneys. |
| <b>DECISION:</b>       | Section 52 opposition – grounds of opposition under sections 44 and 60 established – registration refused.  |

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#### Background

1. The Thai Enterprises, Limited, ('the applicant'), filed trade mark applications 902630 and 902631 on 6 February 2002. The applicant seeks registration of the plain word trade mark TIGER PLAST and the word and tiger device trade mark, shown below, for goods in class 5, namely, *bandages, wound dressings and adhesive plasters*.



902630

2. Acceptance of both trade marks was advertised in the *Australian Official Trade Marks* on 6 June 2002.
3. Haw Par Corporation Limited, ('the opponent'), filed notices of opposition to registration of both trade marks on 6 September 2004. The notices cited all of the available grounds of opposition under the *Trade Marks Act 1995*, ('the Act').

4. The opponent completed the filing and serving of its evidence in support on 6 August 2003. The applicant did not file any evidence in answer and on 5 May 2004 the opponent applied to be heard. I heard the matter, as a delegate of the Registrar of Trade Marks, in Sydney, on 21 July 2004. At the hearing Mr Martin Pollock of Spruson and Ferguson, Patent and Trade Mark Attorneys, appeared on behalf of the opponent and the applicant was represented by Mr Philip J Kerr of Allens Arthur Robinson, Patent and Trade Mark Attorneys.
5. The evidence in support comprises the following statutory declarations:

*Evidence in support*

| Date          | Declarant  | Known as -  | Exhibits    |
|---------------|--|-------------|-------------|
| 7 April 2003  | Bernard Yiu, Managing Director of Oriental Merchant Pty Limited. | Yiu (1)     | BY1 – BY3   |
| 30 June 2003  | Bernard Yiu, Managing Director of Oriental Merchant Pty Limited. | Yiu (2)     | A           |
| 7 July 2003   | Martin Pollock, solicitor with Spruson and Ferguson.             | Pollock (1) | A - G       |
| 6 August 2003 | Martin Pollock, solicitor with Spruson and Ferguson              | Pollock (2) | MHP1 – MHP7 |

*Yiu (1)*

6. Mr Yiu declares that he has been the Managing Director of Oriental Merchant Pty Limited for thirteen years and that from February 1992 to January 2003 his company was the Australian distributor of the opponent's products. He reports that the goods were sold throughout Australia under the TIGER BALM trade mark or the 'leaping tiger' logo. Mr Yiu provides the sales and advertising figures for three years from 2000 to 2002 which indicate that the goods have an established market in Australia. Exhibit BY1 is a selection of magazines published between 1996 and 2002 which contain advertisements for the opponent's goods. BY1 includes magazines such as, *Retail Pharmacy, Massage Australia, Australian Family Physician, Trade Talk, Better Health, Good Medicine, Food Ideas, and Women's Day.*

7. Exhibit BY2 comprises samples of advertising published by *Australian Pharmaceutical Industries*. Exhibit BY3 is a selection of promotional articles published in 1996 in *Australian Family Physician* and the *Sunday Age* newspaper.
8. Mr Yiu's second statutory declaration was made to correct an omission in his first declaration. This second declaration contains representations of registered trade marks 253874, 433316 and 470186 which were inadvertently omitted from the first declaration.

*Pollock (1)*

9. Mr Pollock declares that he was informed by the opponent's legal counsel that the opponent first used its tiger trade marks in Australia in 1974 and that it has continuously used them throughout Australia from that date. He reports that over the years the goods have been distributed by a number of different distributors and that the current distributor is Key Pharmaceuticals Pty Ltd. The goods are sold in supermarkets, pharmacies, health food stores, massage clinics and sports outlets. Mr Pollock reports that the goods are sold in numerous countries throughout the world. The opponent, declares Mr Pollock, is also associated with programs for the conservation of tigers, including one such program at the Melbourne Zoo.

*Pollock (2)*

10. Mr Pollock declares that the opponent is the owner of numerous registrations throughout the world for its tiger trade marks. Exhibit MHP1 is a list of more than eight hundred registrations in more than one hundred countries.
11. Exhibit MHP2 is a copy of an affidavit sworn by Aw It Haw, son of one of the founders of the opponent, on 3 November 1977 in relation to trade mark proceedings in South Africa. Mr Haw avers that the company was founded in or about 1900 and that by 1971 the company was selling its products in fifty-four countries, (including Australia). These included an ointment or balm, an oil for external application and headache and general analgesic powders. The origin of the goods has always been identified by the word TIGER with and without the device of a leaping tiger. Mr Haw provided the worldwide sales figures for the goods for the years 1972 to 1976 and

these amounted to many millions of dollars. Mr Haw claims that in Asian circles the TIGER trade marks are as well known as VICKS or ASPRO are in the West.

12. Exhibit MHP3 is a copy of an affidavit sworn on 14 November 1984 by Edward Geoffrey Hall, Secretary of Haw Par Brothers International Limited, in relation to trade mark opposition proceedings in India. He provides the total sales figures for the opponent's products in sixty-seven countries, for the years 1976 to 1983. These figures are even more substantial.
13. Mr Pollock declares that the opponent's sales have continued to grow and the five year statistical record showing the worldwide sales figures for the years 1998 to 2002 are also impressive.


### **Grounds of opposition**


14. At the hearing Mr Pollock pressed grounds of opposition under the provisions of sections 42, 44 and 60. The remaining grounds nominated in the notices of opposition were not supported by evidence and I now find that they have been unsuccessful.

### **Submissions and the law**

#### *Section 44*

15. In order to establish a ground of opposition under the provisions of section 44 of the Act, the opponent must establish there is a substantially identical or deceptively similar trade mark application or registration, with an earlier priority date, in respect of similar goods or closely related services, in the name of a person other than the applicant. Section 10 of the Act provides that a deceptively similar trade mark is one that so nearly resembles the other trade mark that it is likely to deceive or cause confusion.
16. The trade marks on which the opponent relied are set out in the following table:

| Trade Mark | Priority Date    | Trade Mark  | Goods                                |
|------------|------------------|---|--------------------------------------|
| 253874     | 24 November 1971 |  | Medicinal preparations for human use |

|        |                   |   |   |
|--------|-------------------|---|---|
| 433316 | 17 September 1985 |  | Medicinal and medicated preparations for human use. |
| 470186 | 3 August 1987     | <b>TIGER BALM</b>   | Medicinal and medicated preparations for human use. |

17. The opponent's registrations have earlier priority dates than that of the subject application.
18. It cannot be disputed that the goods of both parties are similar. Wound dressings and plasters may be medicated to relieve pain and aid in the healing process and thus fall squarely within the description of 'medicinal and medicated preparations' claimed by the opponent in its registrations.
19. An application of the side by side test used for determining if trade marks are substantial identical: *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd*, (1963) 109 CLR 407, shows obvious differences between the applicant's device trade mark and the device trade marks numbered 253874 and 433316 so that it cannot be said that they are substantially identical. However the same cannot be said for the applicant's trade mark number 902631 and the opponent's trade mark number 470186. Here the comparison is between TIGER BALM and TIGER PLAST.
20. A balm is an ointment often with medicinal properties that soothes, heals or mitigates pain and is thus the name of the good bearing the trade mark TIGER BALM. PLAST in relation to the goods for which the TIGER PLAST trade mark is used is an obvious shortening of the word PLASTER, devised perhaps to provide a balance in the trade mark; both words contain five letters and the mark begins and ends with the letter 'T'. PLAST contains almost all of the letters of the word 'plaster' and retains all of its meaning when used in respect of the goods claimed. The essential feature, denoting the origin of the goods, in each of these trade marks is the word TIGER. In *PB Foods Ltd v Malanda Dairy Foods Ltd*, [1999] FCA 1602, where the comparison was between the marks CHOC and CHOC CHILL, Carr J found that the marks were substantially identical because CHOC was utterly descriptive. Its presence in the trade

mark was not to indicate the origin of the goods but to identify their flavour. Likewise, BALM and PLAST do not indicate the origin of the goods but serve instead to identify the names of the goods and thus, in accordance with the CHOC CHILL case, I find that TIGER BALM and TIGER PLAST are substantially identical. The section 44 ground of opposition is established in respect of trade mark 902631.

21. Mr Pollock argued that the opponent's trade marks are deceptively similar to the subject applications. He submitted that the marks look and sound alike because they all contain the word TIGER and 902630 also contains the device of a tiger so that it closely resembles the opponent's device trade marks. Mr Pollock noted that in relation to the goods the word and device are unusual. In support of his submissions Mr Pollock cited the following authorities: *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd*, (1954) 91 CLR 592, *Re: Dial-An-Angel Pty Limited v Sagitaur Services Systems Pty Limited*, 19 IPR 171, *Torpedoes Sportswear Pty limited v Thorpedo Enterprises Pty Limited*, (2003) 59 IPR 318 and *Re: John Fitton & Co Ltd's Application*, (1949) 66 RPC 110.
  
22. Mr Kerr argued that the trade marks are not deceptively similar and drew my attention to the differences in the trade marks:
  - The applicant's trade mark is a caricature/cartoon whereas the opponent's device marks are pictorial representations of tigers;
  - the applicant's tiger is standing upright and the opponent's tigers are leaping tigers;
  - the applicant's tiger is holding a piece of paper whereas the opponent's do not;
  - the paper carries the words TIGER PLAST and the opponent's do not; and
  - the opponent's mark numbered 433316 contains a circle and a Chinese character which are elements not contained with in the subject trade mark.
  
23. In support of his claim that the trade marks are not deceptively similar Mr Kerr cited a number of authorities including *Pianotist Co Ltd's Application*, (1906) 23 RPC 774, *Australian Woollen Mills Ltd v F S Walton & Co Ltd*, (1937) 58 CLR 641, *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd*, (1952) 86 CLR 536, *Southern Cross*

*Refrigerating Co v Toowoomba Foundry Pty Ltd*, (1954) 91 CLR 536 and *CA Henschke & Co and Another v Rosemount Estates Pty Ltd*, (2000) 52 IPR 42. Mr Kerr referred particularly to *Torpedoes*, above, where Bennett J summarized most of the accepted authorities in respect of the question of deceptive similarity.

24. The test to determine whether trade marks are deceptively similar is set out in *Shell*, above, where Windeyer J said,

The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impression that such persons would get from the defendant's [trade mark].

and,

[The] deceptiveness that is contemplated must result from similarity; but the likelihood of deception must be judged not by the degree of similarity alone, but by the effect of that similarity in all the circumstances.'

The 'idea' of a trade mark was considered in *Jafferjee v Scarlett*, (1937) 57 CLR 115, where Latham CJ cited from Lord Herschall's Committee's report at pages 121 and 122,

Two marks, when placed side by side, may exhibit many and various differences, yet the idea left upon the mind by both may be the same, so that a person acquainted with a mark first registered and not having the two side by side for comparison, might well be deceived if goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show the players in a different dress and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon the marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

25. I acknowledge that there are differences in the parties' device trade marks but nonetheless, they share a common idea in that each contains the device of a tiger and the word TIGER, as essential elements. In *Austrac Holdings Pty Ltd v Asseta*, (2002) 59 IPR 551, the Registrar's Delegate said that 'it is apparent from the cases that the

trade marks may be non-identical and yet for the purposes of the Act be considered to share an identity.’

26. In *Re: John Fitton & Co Ltd's Application*, above, it was held that the words ‘likely to deceive or cause confusion’ place ‘no limitation upon the nature of the confusion or deception so envisaged’. In that case the marks were *Jest* and *Easyjest* and although visually and orally they might not be confused, in the context of a shared significant element, consumers might be deceived or confused into a belief that the goods shared a common origin.

27. The goods of both parties are bought in supermarkets, pharmacies and some speciality outlets where the purchase is not one which is closely considered and is frequently dictated by impression. In *The Kettle Chip Company Pty Ltd v Apand Pty Ltd* (1993) 46 FCR 152, Burchett J said,

In general, and more particularly in the case of an item likely to be purchased for a small price without long consideration, the comparison which must be made is between the impression of the applicant's goods retained in a customer's mind and the impression made by the sort of consideration he is likely to give to the respondent's product before purchasing it.

28. In speciality outlets it is likely that the goods will be purchased by oral request for the TIGER brand, thus increasing the likelihood of deception and confusion particularly where the customer has only retained an imperfect recollection of the known trade mark.

29. Taking into account that the trade marks share a common idea, that the essential feature of each is the word TIGER and the device of a tiger, the risks of contextual confusion and the imperfect recollection of consumers I find that there is a real risk of consumers being deceived and confused as to the origin of the applicant's goods. The opponent has established its ground of opposition under section 44 of the Act in respect of trade mark number 902630.

#### *Section 60*

30. In order to satisfy its ground of opposition under the provisions of section 60 of the Act, the opponent must establish that the applied for trade marks are substantially identical with or deceptively similar to another trade mark or trade marks that have

acquired a reputation in Australia before the priority date of the applications and, because of that reputation, use by the applicant of its trade marks, would be likely to deceive or cause confusion. Section 60 does not require the relevant goods to be the same nor does it require the trade marks relied on by the opponent to be registered or the subject of applications for registration. However, in this case the goods are the same and the trade marks on which the opponent relies are all registered trade marks.

31. I have already found that trade mark number 902631, TIGER PLAST is substantially identical with the opponent's trade mark number 470186, TIGER BALM and that device trade mark number 902630, is deceptively similar to trade marks 253874 and 433316, so that the threshold requirement for this ground of opposition has been met. I must now determine if, at the priority date of the subject applications, 6 February 2002, the opponent had acquired the requisite reputation.
32. Mr Pollock submitted that through the continuous promotion of its goods and the extent of the sales made the opponent had established a leading reputation in the market for its balm products, sufficient to meet the requirements of section 60 of the Act.
33. While the range of goods claimed is not extensive they are goods for which most consumers would have a need from time to time. The opponent claims to have first used its leaping tiger trade mark in Australia in 1974 and to have continuously used it since that date. The opponent's goods are sold in more than 1500 supermarkets throughout Australia as well as in approximately 3000 pharmacies and more than 500 Asian retail outlets. The goods are extensively promoted in a wide range of magazines. I am prepared to accept that the opponent has an established reputation in its trade marks based on its extensive use and promotion over a long period of time, its significant sales and advertising figures and its active role in conservation programs. I am satisfied that use by the applicant of its trade mark is likely to deceive and confuse consumers. This ground of opposition is established.

*Section 42(b)*

34. Subsection 42(b) of the Act provides that an application for the registration of a trade mark must be rejected if its use would be contrary to law. Mr Pollock submitted that the applicant's use of its trade mark on the goods in its application would be contrary

to law under section 42, because such use would contravene section 52 of the *Trade Practices Act 1974*, (TPA), which provides that:

(1) A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

35. *Shanahan's Australian Law of Trade Marks and Passing Off*, 3<sup>rd</sup> Edition, 2003 at page 598 states: 'Misleading conduct does not merely cause confusion; it actually directs a person towards the wrong choice'.
36. The TPA has a higher standard than does the *Trade Marks Act 1995* so that confusion in the sense of wonderment, is not within the meaning of the words 'misleading or deceptive': *Parkdale Custom Built Furniture Pty Ltd v Puxa Pty Ltd*, (1982) 149 CLR 191.
37. I have no independent evidence before me of consumers having been misled or deceived which might have assisted the opponent's case, nor any declarations from consumers attesting to any conduct on the part of the applicant that would cause them to be misled or deceived. I find the opponent's evidence is not sufficient to meet the higher threshold of misleading or deceiving conduct. I am not satisfied that a case *could*, let alone *would*, be made out under section 52. This ground of opposition has not been established.

### **Decision**

38. The opponent has succeeded in establishing its grounds of opposition under the provisions of section 44 and 60 of the Act. Therefore pursuant to section 55 of the Act, I refuse to register trade marks 902630 and 902631.

### **Costs**

39. Both parties sought their costs. I see no reason why costs should not follow the general rule that costs are usually awarded against the unsuccessful party. I award costs against the applicant and direct that the applicant pay the costs of the opponent

in accordance with the Official Scale set down in Schedule 8 of the *Trade Marks Regulations 1995*.

Mary Skivington  
Hearing Officer  
Trade Marks Hearings  
26 October 2004