



TRADE MARKS ACT 1995

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

Re: Opposition by Mitsubishi Jidosha Kogyo Kabushiki Kaisha to registration of trade mark application 906318(28) - **LAPAJERO GOLF AND LOGO** - filed in the name of Jason International Inc.

DELEGATE:	Terry Williams
REPRESENTATION:	Opponent: Annette Freeman, solicitor, Spruson & Ferguson attorneys Applicant: no appearance
DECISION:	S 52 opposition. s 60: marks not deceptively similar, deception or confusion not likely, trade mark to be registered

Background

1. Trade mark application 906318 was filed by Jason International Inc., a South Korean company, on 14 March 2002. It is for goods in class 28 specified as follows: “Sporting equipment; equipment and apparatus in this class for golf; golf bags, golf balls, golf gloves, golf clubs, caddy bags, golf practice targets, golf training machines, golf tees”.
2. The trade mark is:



3. After examination, the application was advertised as having been accepted for registration. This, however, is opposed by Mitsubishi Jidosha Kogyo Kabushiki Kaisha (Mitsubishi). Mitsubishi has followed the process set out in the regulations for the service and filing of evidence in support of the opposition, following which, in the lack of evidence in answer to the opposition, it requested a hearing.

4. The applicant was not represented at the hearing and has made no written submissions. Mitsubishi's solicitor, Annette Freeman of the attorney firm Spruson & Ferguson, appeared. She said that the single ground of opposition on which Mitsubishi relied was that under s 60.

Ground of opposition – s 60

5. Section 60, in brief, allows registration of an applicant's mark to be refused if, because of the reputation of a competing and deceptively similar¹ trade mark as at the priority date of the applicant's mark, the use of the applied-for trade mark would be likely to deceive or cause confusion.

Threshold question – deceptive similarity

6. Ms Freeman accepted that, as a threshold question, she needed to establish the deceptive similarity of Mitsubishi's trade mark PAJERO to the trade mark now sought to be registered.
7. Ms Freeman relied on a number of precedent cases to support her position. Chief among these were the decisions in *Renaud Cointreau & Cie v Cordon Bleu International Ltee* [1997] ATMO 30 and *Le Cordon Bleu BV v Cordon Bleu International Ltee* [2000] FCA 1587. She also acknowledged the "classic tests" set out in *Automobiles Peugeot v Viva Time Corporation* (2001) 54 IPR 568.
8. Ms Freeman noted that in the first of these decisions, the applicant's trade mark:



was found to be deceptively similar to the opponent's trade mark, CORDON BLEU rendered in cursive font. The hearing officer, Mrs Zars, noted the differences between the marks. However, she decided that they were still deceptively similar and commented that:

¹ Section 10: A trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

... the words CORDON BLEU comprising the opponent's mark form a significant and recognizable feature in the applicant's mark, as these words are now in common usage designating at least a dish cooked with ham and cheese. As word components of device marks are used by customers to identify the goods of interest when ordering the goods, I believe those words are "likely to be the source of some name or verbal description by which buyers will express their desire to have the goods" (see *Australian Woollen Mills v Walton*², at p 658). Indeed, those words, with or without the definite article "Le" in French, are the only obvious verbal description that could be used for this purpose.

9. The second case involved, among other matters, an appeal from this decision. Mrs Zars's decision on this point was not overturned and, consistently, on appeal, Ms Freeman noted that Heerey J commented:

The use of "Le" would not, to a largely English-speaking public, in my opinion sufficiently distinguish the two marks. The Cordon mark takes the whole of the first word of the Canadian mark. In an alphabetical listing it would appear immediately adjacent to "cordon bleu" and purchasers were likely to assume that the goods were related.

10. This was not, Ms Freeman argued, a case comparable to *Clinique Laboratories Inc v Luxury Skin Care Brands Pty Ltd* [2003] FCA 1517. There, as Ms Freeman noted, the differences were more pronounced. The marks at issue were CLINIQUE and LA CLINICA (with an LC logo). Gyles J found the two not to be deceptively similar because:

The only similarity is between the first part of the words 'Clinique' and 'Clinica'. The ending of each is distinct. More importantly, 'Clinica' is used in conjunction with 'La' as a composite phrase. The layout and other features of the marks are different. In my view the look of the marks would not cause confusion even with imperfect memory.

I do not regard the sound of the words as likely to cause confusion. The presence of 'La' and the hard second 'c' in 'Clinica' is quite a different sound from the 'ique' ending of 'Clinique'. 'La Clinica' would be perceived as an Italian or Spanish phrase whereas 'Clinique' would be perceived as a French word.

11. Ms Feeman argued that the present matter was one where the applicant was seeking to register something as blatant as LACOCA COLA. What was present here was a far stronger case, she asserted, than in *BULOVA ACCUTRON* TM [1969] RPC 102, although she conceded that, conversely, the applicant here is entitled to its registration unless I am satisfied that a ground of opposition has been established, based on, inter

² (1937) 58 CLR 641

alia, deceptive similarity. Absent a case for the existence of such a ground, it is no longer necessary for the applicant to establish registrability.³

12. In the present matter, Ms Freeman noted that the word PAJERO, the trade mark of Mitsubishi, has no other significance that would be likely to be familiar to an ordinary Australian. While it is a Spanish word meaning “straw dealer” I agree that this meaning would not be known by most Australians. To such people, PAJERO is not at all analogous to a word such as clinic, apparently rendered in either Spanish or French and used in relation to goods sold through beauty clinics.
13. It might be argued that the first word element of the applicant’s trade mark would be perceived as “La Pajero”. To the extent that this might happen, the above comments of Heerey J would be apposite. I think that this possible cause of confusion would only be a real possibility if, for some reason, consumers were to conduct an analysis of the trade mark to a level that is, in my view, unlikely under ordinary circumstances. Here are the words PAJERO on the one hand and LAPAJERO GOLF on the other. There are, no doubt, a number of views about the possibly coincidental similarities. However, it remains for an opponent to establish that, despite the obvious differences to the eye and to the ear, the end result will be either deception or confusion.
14. To appropriately recast what was said in *BULOVA*, supra⁴, in my view the element PAJERO would not, without more, appear to emerge with sufficient force as to raise a reasonable risk of deception or confusion. The words in the applicant’s mark are LAPAJERO GOLF. The former is one of eight letters and is followed by the word GOLF. I see no reason why consumers would (ordinarily) be led into error, or confused by any misguided analysis of the mark into LA PAJERO, followed by an imputation of some sort of French or Spanish reference to a known trade mark. The stress of pronunciation is normally on the initial syllable, here LA, or perhaps even LAPA. Similarly, the marks do not look particularly alike.
15. Simple human fallibility may intervene and allow some consumers to mistake LAPAJERO GOLF for PAJERO, through imperfect recollection, carelessness per se or through over-reliance on the element PAJERO as being (somehow) at the heart of

³ See French J in *Registrar of Trade Marks v Woolworths*, (1999) 45 IPR 411 at 45. Compare *Sym Choon & Co Ltd v Gordon Choons Nuts Ltd* (1949) 80 CLR 65 at 78.

⁴ Stamp J, approving at p 109 the approach of the Assistant Registrar, which Ms Freeman quoted.

both trade marks. None the less, the prospect of these errors is, prima facie, remote, and the central idea that emerges from the element LAPAJERO GOLF is of, perhaps, a golfing event at some (apparently nonexistent) place called LAPAJERO. This is an idea that gives some effect to the word GOLF even in relation to golfing goods. I do not, however, overlook the fact that the word golf is, on those goods, not capable of distinguishing.

16. Finally, the comparison that I am to make must be of both marks as wholes. Just as the word GOLF cannot be overlooked, I do not think that consumers, in looking at the applicant's mark, would overlook the letter P that forms a very prominent part of the applicant's trade mark. The P logo highlights the fact that the word element of the present application is at least amenable to analysis as laPAJERO GOLF.
17. I note too, that this P, and the logo of which it is part, is also a prominent part of another and earlier application, 895796, filed by the applicant in the current matter. In that earlier application, the present applicant sought to register a trade mark of which the only word element was PAJERO. That earlier application was opposed by Mitsubishi and was subsequently withdrawn without a decision being required. Its existence, and the light it might shed on the current matter, is not something that would normally be considered by an examiner of trade marks but is, I think, quite relevant in the opposition context.
18. The fact that the applicant has seen fit to carry over the logo element into the present application causes me some uncertainty. I think I am entitled to put due emphasis on the logo element, when augmented as it is with the letter P, as being likely to attract attention to the existence, and possible significance, of the element PAJERO, at least in the minds of those sporting-goods buyers who might be already inclined to conduct an elaborate analysis. However, even with this additional proviso, I still do not agree that the prospect of confusion, or of deception, amounts to any significant level. My conclusion is that the opposition fails at the threshold.

Deception or confusion?

19. It is possible that the opponent may both disagree with the foregoing and wish to take this decision elsewhere on appeal. Therefore, in case I am wrong in my previous finding, I will also set out, briefly, why I would conclude that Mitsubishi's s 60

ground is not ultimately established by its evidence, despite the no-doubt enviable reputation of the PAJERO trade mark.

20. Mitsubishi has, and has had for many years, a very extensive reputation in its PAJERO vehicle, a four-wheel drive vehicle that comes in variants ranging from utilitarian workhorse to luxury off-road cruiser. Mitsubishi has promoted its vehicles by way of merchandising, under both the trade marks MITSUBISHI and PAJERO. Such promotion is, as Ms Freeman pointed out, common in the automotive trade, as the hearing officer noted in the *Automobiles Peugeot*⁵ to which she referred. Most of the promotional items offered by Mitsubishi do not appear to bear the trade mark PAJERO⁶. I acknowledge that there has been promotional use of the trade mark PAJERO on promotional clothing, prints and posters, waist purses, watches, cooler bags, pocket knives and windscreen blinds. However, items identified as “Pajero” make up very small parts of closely printed four-page catalogues. No such golfing items are specified. Significantly, the extent of this use has not been quantified other than in relation to clothing, where the figure is confidential but significant.
21. Mitsubishi produces promotional goods relevant to the various models in its range though it would seem that the main emphasis is on the promotion of the name of the company. This might well reflect the fact that model names, even of flagships like PAJERO, may come and go over time or may vary from market to market.
22. What I am left with is this: a typical consumer of relevant sporting goods, in Australia, as at the priority date of the opposed application, would have been aware of the opponent. The consumer would almost certainly have been aware of Mitsubishi’s PAJERO vehicles, and of the inclination of manufacturers such as Mitsubishi to promote their trade marks. The evidence establishes that Mitsubishi’s reputation in its PAJERO trade mark is very strong in relation to four-wheel drive vehicles, though nowhere near as strong in relation to any promotional goods of any sort. Ms Freeman’s attempt to establish any reputation in relation to promotional goods other than clothing was based as much on reference to the norms of the industry as on established fact. There is little apparent likelihood that a typical sporting-goods

⁵ (2001) 54 IPR 568

⁶ Exhibit MSC-6 to the declaration of Mark Clarke.

consumer would have encountered any actual use of the trade mark PAJERO on relevant promotional goods other than, at most, clothing.

23. Against this, I am required to consider all of the surrounding circumstances including the fact that the applicant's goods are sporting equipment, where the look and the visual impact of the trade mark count for much, and where the goods are relatively carefully selected. Moreover, any consumer making a comparison of one mark with another will be aware of the considerable gap between the applicant's goods and the core business of the opponent. Finally, it appears from the evidence that Mitsubishi's promotional goods are available only through Mitsubishi dealers. Those goods are not available from general retailers or the local sporting-goods shop.
24. These factors will all, I think, heighten the perceptiveness of consumers when it comes to visually obvious disparities. Such disparities of mark were not present in *Nissan Jidosha Kabushiki Kaisha v Woolworths Ltd* (1999) 45 IPR 649 or in *General Motors Corp v Nicholls* [2003] ATMO 59; (2004) AIPC 91-944. Again, in *Automobiles Peugeot*, supra, the difference between PEUGEOT and PAUL PEUGEOT invited a contextual confusion that, in the present instance, is no more than an abstract and entirely hypothetical possibility. All of the circumstances mitigate the risk of the sort of perceived brand extension present in *Campomar v Nike*⁷, to which Ms Freeman referred.
25. Accordingly, my decision is that, given the differences in competing trade marks, the huge extent of the reputation of the trade mark PAJERO cannot, alone, produce a finding under s 60 that is adverse to the applicant. The practical likelihood of deception or confusion is, in my estimation, very small indeed.

⁷ *Campomar Sociedad Limitada v Nike International Ltd* (2000) 46 IPR 481.

Conclusion

26. The opponent, Mitsubishi, has not established the ground relied on under s 60 of the Act. Accordingly, in the absence of any appeal from this decision, I direct that registration proceed after one month from the date of this decision. In the event of an appeal, registration will not proceed until the appeal is decided or discontinued. I direct that Mitsubishi pay the applicant's costs in terms of the scale.

T. E. Williams

T. E. Williams
Hearing Officer
25 November 2004