

TRADE MARKS ACT 1995

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

Re: Opposition by Torrag Pty Ltd to registration of trade mark application 958099
- **PETS AT HOME, WITH DOG AND CAT DEVICE** - filed in the name of
PAH Pty Ltd.

DELEGATE:	Terry Williams
REPRESENTATION:	Opponent: Torrag Pty Ltd Applicant: PAH Pty Ltd
DECISION:	S52 opposition: S44 and 60 – deceptive similarity not established. S42 ground similarly fails. S59 – ground not established. Registration proceeding

Background

1. PAH Pty Ltd has applied to register a trade mark in relation to a wide range of goods, mostly with direct application to pets or animals, in classes 5, 9, 11, 16, 18, 19, 20, 21, 28 and 31. The application also includes services in class 44, specified as “Veterinary services; hygienic and beauty care and grooming services for animals”.
2. Torrag Pty Ltd (“Torrag”) has opposed registration of the trade mark. Torrag’s primary ground relies on “deceptively similar” trade marks (for purposes of grounds of opposition under sections 44 and 60). Its other grounds are under s 42, “contrary to law” and s 59, “lack of intention to use”.
3. I will not catalogue the evidence filed and served, and will refer to it only where it is relevant to the arguments put to me at the hearing. At that hearing, which I conducted under delegation from the Registrar of Trade Marks, the applicant was represented by Ed Heerey of counsel, instructed by Herbert Geer & Rundle, solicitors. Geoffrey Davidson, patent attorney, of Halford & Co Patent Attorneys, appeared for Torrag.

Grounds considered

Deceptive similarity: sections 10, 44 and 60

4. Section 10 provides that

For the purposes of this Act, 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.

While there is no need to set out the full provisions of sections 44 and 60, their terms are such that deceptive similarity is the key issue in Torrag's grounds of opposition under those provisions.

5. I set out, firstly, the applicant's and Torrag's trade marks. Those are shown in the forms as sought to be registered, and as registered, respectively:



Applicant's trade mark



Torrag's trade mark

6. Mr Davidson, in his written submissions and as somewhat elaborated at the hearing, listed the similarities as follows:

- the silhouette of the head and neck of a stylised, plain, dark-coloured cat; superimposed over a silhouette of the head and neck of a stylised, plain, light-coloured dog;
- set against a generally rectangular dark coloured background;
- in which both animals are looking straight forward, in an alert and confident pose. This impression of alertness and confidence is reinforced by showing the dog with its ears raised. The dog and cat's eyes are not shown.
- the word PET(S) is located in the vicinity of the logo;
- the word "PETS" is rendered in a similar font
- the relative sizes of the heads and of the word "PET(S)" are substantially the same, with similar proportionality of words and devices in the competing marks
- The presence of a rectangular border in both trade marks

7. Of particular concern to Torrag is the fact that, within the ambit of notional fair use of the mark sought to be registered, the applicant contemplates the use of the trade mark in different embodiments (see exhibit DLH-11, the declaration by David Herman¹.) One of the embodiments shows the silhouette logo and the words "pets at home" arranged horizontally in a lay-out virtually identical to the positioning of components

¹ Mr Herman is the managing director of the exclusive licensee of the applicant's trade mark in Australia and is, moreover, authorised to make a declaration on behalf of the applicant itself.

in the registered trade mark of Torrag. This embodiment is widely used by the applicant (see DLH-6, 9, 10, 12, 13, 15, 17).

8. I have to agree that Mr Davidson has a point here, at least to the extent that the variation complained of is common in the applicant's material. Having looked at this, such usage seems entirely legitimate and would very arguably be an ordinary adaptation of the applied-for mark to differing label shapes, signage needs etc. Accordingly, to set Torrag's argument on its strongest possible base, I will proceed as though the applicant seeks rights for a trade mark to be used as follows:



9. This is an unusual step. It would possibly be unwarranted except that, for reasons which follow, it does not affect the outcome. This step will also make it abundantly clear that I have not given undue weight to the effect of the positioning of the various elements of the applicant's mark as set out on the form of application. To reinforce the suggestion that their position is of no great weight to the applicant, I note the evidence which shows that the relevant variant appears on the databases of the Intellectual Property Office of New Zealand, and of the Patent Office of the United Kingdom. In both places, the trade mark was registered by the applicant as one of a series of trade marks, roughly comparable to a series under s 51 of the Australian *Trade Marks Act 1995*. In both instances, all that is varied within the series is the positioning of the elements. In the applicant's view, and in the declaration of Mr Herman on the applicant's behalf, it is still essentially the same trade mark.
10. Mr Heerey, for the applicant, did not dispute the authorities relied on by Torrag in approaching these issues. In essence, he invited me to compare the marks as wholes, giving due weight to the essential or distinguishing features. Again, he was in agreement with Mr Davidson's approach – but not, unsurprisingly, his conclusion.
11. Mr Heerey attempted to argue that the “only” distinguishing feature of these competing marks is the word elements. He relied heavily on evidence that Torrag's customers refer to the business as PetVets. He did, however, acknowledge some unsworn and questionable evidence from Torrag suggesting that the logo had, in one instance, resulted in confusion. Mr Heerey made much of the unsworn nature of the

evidence, a simple letter handwritten on Torrag's own letterhead. He argued that the failure to bring in sworn evidence allows me to infer that, had the evidence been properly sworn it would not have assisted Torrag. However, I do not go that far and I doubt it would be appropriate to do so. I will give the exhibit due weight, but Mr Heerey is not, overall, correct in his primary thesis, which is simply too extreme.

12. I would hesitate to ever approach a matter such as this on the basis that such a logo is not relevant. What is critical is the weight I would give it but, in balancing the similar and dissimilar elements and allowing for their memorable (or otherwise) natures, I would hesitate to set the logo element at zero when the other elements are also not all that strong.
13. My comment about the dubious strength and weighting of the word elements does not mean that I fully subscribe to Torrag's argument. Before going any further with those arguments, it will assist the reader to understand some of Mr Davidson's references to earlier decisions at the Trade Marks Office if I set out some aspects of Torrag's history. Torrag is no stranger to the opposition forum. Registration of the trade mark on which it relies in the present matter was previously opposed by two separate and unrelated parties, neither of whom, fairly obviously, succeeded. Torrag, for its part, successfully opposed the registration of a trade mark by one of those parties and now, in this current matter, again presents itself in the role of an opponent.
14. Mr Davidson noted the decision in one of the failed oppositions, *Effem Foods Pty Ltd v Torrag Pty Ltd* [2002] ATMO 54 (28 June 2002). In that matter, I dismissed an opposition based on, among others, the following trade mark owned by Effem:



15. There, I made a brief reference to a well-known textbook:

This, (the word element PetVets, being the subject of the gaze of the animals in Torrag's trade mark) in my view, reinforces the weight that would ordinarily be given to distinguishing words that appear in trade marks. As Shanahan, *supra*, notes at p 178:

Where a trade mark combines a device with a word, customers will more naturally refer to the word when ordering the product. Where... the verbal features can be readily distinguished, this may greatly reduce the risk of confusion through similarities in other features of the mark.

16. In that decision, I noted, of the device, “To the extent that the contested device, as part of Torrag's mark, is memorable at all, this visual linking with the word element renders it memorable in very different terms to the Effem mark”. Mr Davidson was keen to distinguish this from the present situation. He argued that Torrag’s trade mark is “sufficiently ‘unique’”. Here he referred to the decision of the other failed opposition. This was the decision in *Lydia Brichta on behalf of the Pet Vet Woodpark Animal Hospital v Torrag Pty Ltd*². Hearing Officer Forno, in that case, was at no stage called on to decide the deceptive similarity or otherwise of Torrag’s trade mark with that of the opponent in that matter, which was as follows:



17. In that decision, Mr Forno expressed the view that the words “pet vets” were common to the trade. He none the less concluded that the juxtaposition of the device elements in Torrag’s trade mark was “a relatively unique getup” such that the combination of words and devices was capable of distinguishing. The sole grounds were ownership (which hinges on a conflict over substantially identical trade marks) and capability of the applied-for mark to distinguish. I do not think I should give that comment particular weight in the more subtle debate around issues of deceptive similarity, at issue here and now. Mr Forno’s use of the word ‘unique’ therefore does not greatly assist Torrag in the present matter.
18. Later still, in *Torrag Pty Ltd v Lydboots Pty Ltd and Petcure Pty Ltd*³, Torrag was the opponent, seeking to prevent registration of the device with the heart shape shown above. In that case Hearing Officer Thompson found that Torrag had established common law trade mark rights existed in the word “petvets”, used in telephone directories and so on. However, his decision was only to the effect that PETVETS, a

² [2001] ATMO 13

³ [2002] ATMO 6

trade mark to which common law rights had attached, was deceptively similar to the trade mark incorporating a heart device. Again, the issues there do not shed much light on the present matter.

19. Mr Davidson noted a proposition put long ago by Romer J:

[W]hen one person has used certain leading features, though common to the trade, if another person is going to put goods on the market, having the same leading features, he should take extra care by the distinguishing features he is going to put on his goods, to see that the goods can be really distinguished.

Mr Davidson was strongly of the view that, while dog and cat devices of various sorts may be common to the trade, the applicant has not distinguished the composition or idea of its mark from Torrag's.

20. He argued that the visual cue of the dog and cat device might cause confusion in supermarkets, particularly where the competing word elements of the applicant's mark are likely – so he argued – to be abridged to “pets”. This latter is a somewhat unusual proposition. However, it finds support in the applicant's evidence (DLH-12, wherein there is a document where the device in question is used with the words ‘New to Pets’) but I do not give it great weight. I simply do not see that the conceptual similarities that might be found in the superimposed dog and cat devices emerge with sufficient force as to give rise to any apprehension of a significant level of deception or confusion.
21. True it may be that the applicant has also, in one instance, elected to use the device by itself. That would be for it and its legal advisers to consider. However, neither that possibility nor the deliberate abstraction of the applicant's word elements down to ‘pets’ can determine the issue of potential confusion of the present trade mark with that of Torrag.
22. I appreciate Mr Davidson's concern with the risk that, despite the differences, consumers might apprehend that the logo, misperceived to be common to the two trade marks, denoted a common trade source. I think this goes too far, however. The common element does not bear comparison with the striking and aggressive fish

device I considered, for use on clothing, in another matter⁴. Nor is the dog and cat device as memorable as the angel devices (quite distinguishable, yet part of deceptively similar trade marks) in *Dial an Angel v Sagitaur Systems*.

23. In the latter case, Wilcox J was considering the importance of common features and their balance with distinguishable features. He noted that "the similarity of an essential feature may be negated by another feature that tellingly distinguishes the two marks. But that will be difficult, for reasons spelled out in *Jafferjee*⁵." This of course was in the time of the former legislation, which had no presumption of registrability, as it is sometimes called, under s 33 of the current legislation. The question now is not one of "has the similarity been negated" but "does the similarity complained of rise to the level of deceptive similarity"?

24. Mr Davidson reminded me that in *Effem v Torrag*, I said:

I think that the existence of registration ... is a good example of how elements of one trade mark may safely consist of some that are in common with another mark, provided that they are safely defused and buried in a new composite. Indeed, those latter words...which I used in relation to the matter of *Stokely-Van Camp, Inc v Alexander Hutton* [1999] ATMO 123, now need recasting in the light of the caution sounded by French J in *Woolworths*, supra: no problem exists under s44 unless the shared elements are seen to be sufficiently prominent and memorable and to be serving a trade mark function in the later application.

25. Put simply, I disagree with Mr Davidson as to the existence of a problem for the applicant in the present matter. The device of the dog and cat is part of a whole. Dogs and cats, and devices of dogs and cats, are commonplace in the relevant trade. I think the composite dog and cat device does not emerge with sufficient force to imperil the applicant's trade mark. The relevant grounds of opposition have not been established.

Contrary to law - Section 42

26. Mr Davidson submitted that the use of the applicant's trade mark would be contrary to the *Trade Practices Act 1974* and similar State fair trading legislation. This ground must hinge on a positive finding that the use of the applicant's trade mark would be likely either to mislead or to deceive.

⁴*Meldrum v Grego* (1992) 24 IPR 201

⁵*Jafferjee v Scarlett* (1937) 57 CLR 115

27. I have already set out my reasons for finding that the trade marks are not deceptively similar for the purposes of sections 10, 44 and 60 of the *Trade Marks Act*. My finding, in total, was that the trade marks do not resemble each other to the point of causing mere confusion. The laws on which Mr Davidson relies under the present heading trigger at a higher level, that of being misleading or deceptive⁶. Therefore, I do not consider that the use of the applicant's mark would be contrary to the laws relied on by Mr Davidson. The ground of opposition is not made out.

Intention to use – s 59

28. Here, Mr Davidson argued that the applicant's own evidence makes it clear that it is primarily a retailer, not a trader in goods. Therefore, he argued, the registration of the trade mark for goods, as opposed to services, ought not to proceed.

29. Now it may be that Mr Davidson is correct in a general way. There is, as he says, no evidence at all that the applicant intends to arrange the supply of "own brand" products. However, the applicant is under no onus to demonstrate such an intention unless and until Torrag brings in evidence to support the ground in the first place.

30. To quote Fullagar J, in *Aston v Harlee*⁷:

There is nothing in the Act or the regulations which requires (an applicant) to state such an intention at the time of application, and the making of the application itself is, I think, to be regarded as prima facie evidence of intention to use. I cannot think that the registrar is called upon to institute an inquiry as to the intention of any applicant, and I think that, on an opposition or on a motion to expunge, the burden must rest on the opponent, or the person aggrieved, of proving the absence of intention.

While it would be idle to pretend that the applicant has addressed this issue, there was no obligation on it to do so. Mr Davidson noted that *Nikken Wellness Pty Ltd v van Voorst* [2003] FCA 816 stressed the importance of proper identification of goods and services. I agree with him. However, the importance would only arise in the event that, at some future time, the trade mark was registered and the registered owner was called on to show use of the trade mark on goods for which it is registered. For the moment, taking the evidence as a whole, the best that can be said is that there is no evidence of a positive intent to use. However, and fatally for Torrag under this

⁶ See *Shanahan's Australian Law of Trade Marks and Passing Off*, 3rd Edition, at 22.70

⁷ (1960) 103 CLR 391

ground, this is not sufficient to support an inference of lack of intent. This ground of opposition is not established.

Conclusion

31. No ground of opposition has been established. The trade mark application may proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until either the appeal has been discontinued or it is otherwise ordered by a court.



Terry Williams
Hearing Officer
Trade Marks Hearings
13 July 2006