TRADE MARKS ACT 1995

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

Re: Opposition by the Coca-Cola Company to registration of trade mark application 1153953(32) - **NAUGHTY MOTHER** - filed in the name of Matthew Shea.

DELEGATE:	**Jock McDonagh**
REPRESENTATION:	**Opponent: Margaret Ryan of Phillips Ormonde Fitzpatrick, patent & trade mark attorneys** **Applicant: No appearance (Alfreds Attorneys)**
DECISION:	**2009 ATMO 49** **Section 52 opposition section 44 – marks deceptively similar - registration refused - costs awarded against applicant**

Background

1. Matthew Shea ('the applicant') is the applicant for registration of a trade mark, current details of which are:

Application No:	1153953
Priority Date:	24 December 2006
Goods:	**Class 32** Non-alcoholic beverages; drinking waters, flavoured waters, mineral and aerated waters; soft drinks, energy drinks and sports drinks; fruit drinks and juices; syrups, concentrates and powders for making beverages including syrups, concentrates and powders for making mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit drinks and juices
Trade Mark:	**NAUGHTY MOTHER**

2. Following examination, the application was accepted for possible registration and advertised as such in the *Official Journal of Trade Marks* on 3 May 2007.

3. On 1 August 2007, the Coca-Cola Company ('the opponent') filed a Notice of Opposition under section 52 of the *Trade Mark Act 1995* ('the Act'), objecting to the registration of the trade mark.

4. The parties served and filed evidence in support, evidence in answer and evidence in reply to the opposition That evidence is shown below:

Declarant	Status	Date, Known as	Exhibits
Evidence in Support			
Elizabeth Bromage	Brand manager of the opponent	28.09.07, Bromage 1	EB-1 to EB-9
Kristine Helen Baird	Researcher, IP Organisers Pty Ltd	22.01.08, Baird	KHB-1 & KHB-2
Evidence in Answer			
Matthew Shea	Applicant	24.04.08, Shea	
Evidence in Reply			
Elizabeth Bromage	Brand manager of the opponent	4.08.08, Bromage 2	
Kenneth Hamilton	Patent & trade mark attorney	4.08.08, Hamilton	KH-1

5. The opponent asked to be heard and the matter came before me as a delegate of the Registrar of Trade Marks, in Melbourne on 27 March 2009. The applicant was not represented at the hearing. The opponent was represented by Margaret Ryan of Phillips Ormonde Fitzpatrick, patent & trade mark attorneys.

6. The Notice of Opposition cited most grounds of opposition available to the opponent under the Act; however, at the hearing Ms Ryan limited her submissions to those grounds of opposition under section 44. For the sake of completeness, I treat the remaining grounds of opposition as having been abandoned.

7. The registrations relied upon by the opponent in support of the section 44 ground are as follows:

Registration number	Trade Mark	Goods	Priority Date
1106174		**Class 32:**Non-alcoholic beverages; drinking waters, flavoured waters, mineral and aerated waters; soft drinks, energy drinks and sports drinks; fruit drinks and juices; syrups, concentrates and powders for making beverages including syrups, concentrates and powders for making mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit drinks and juices	2803.06

1131430		**Class 32:** on-alcoholic beverages; drinking waters, flavoured waters, mineral and aerated waters; carbonated soft drinks, energy drinks and sports drinks; fruit drinks and juices; syrups, concentrates and powders for making beverages including syrups, concentrates and powders for making mineral and aerated waters, carbonated soft drinks, energy drinks, sports drinks, fruit drinks and juices	23.08.06
1140535		As above	11.10.06

Discussion

8. The relevant applicable legislation for the remaining ground is as follows:

Identical etc. trade marks

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; or

(ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; 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.

9. The definition of the term deceptively similarity is provided in the Act as follows:

Definition of *deceptively similar*

10. 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.

10. The trade marks cited by the opponent have earlier priority dates and are for virtually identical goods. The key issue in these proceedings is whether or not the applicant's mark is substantially identical with or deceptively similar to the cited marks.

11. It is obvious that the applicant's mark is not substantially identical with the cited marks and the opponent does not submit that it is. The opponent does submit that the applicant's mark is deceptively similar to each of the cited marks.

12. Counsel for the opponent referred to most of the "standard" tests applied to "deceptively similar", commencing with the observation that the statutory definition in section 10, shown above, encompasses not only visual or phonetic similarity but also the "definite likelihood that a substantial number of persons would assume that the two sets of goods sold under the marks emanated from the same trade source" if used on identical goods as is the case here: *Re John Fitton and Company's Application* (1949) 23 RPC 110 at 114.

13. The opponent highlighted the difference in considering deceptive similarity rather that substantial identity by reference to *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641 at 658:

> In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard. Evidence of actual cases of deception, if forthcoming, is of great weight.

14. In applying the relevant tests to the actual marks in question, the opponent submitted that persons seeking the opponent's product would ask for a "MOTHER", This being the only word in Trade Mark 1106174 and the prominent word in the remaining marks cited.

15. The opponent submitted that the word MOTHER was the essential feature of the opponent's cited trade marks. Further, the opponent submitted, MOTHER is a highly memorable and distinctive word, particularly in the context of the goods covered by the competing trade marks.

16. The opponent further submitted that the distinctiveness of the word MOTHER is reinforced by the unexpected contradiction introduced – in the cases of Trade Marks 1131430 and 1140535 - by the graphic features such as a monster, a Venus fly-trap and thorny flowers.

17. Likewise, suggests the opponent, the applicant's mark also introduces a shocking and unexpected contradiction by the addition of the descriptive term in the words NAUGHTY MOTHER. Naughtiness being the antithesis of the stereotypical kind, loving mother. The opponent submits that NAUGHTY MOTHER would be seen as a new, more exciting form of the MOTHER drink.

18. Counsel for the opponent provided examples of numerous hypothetical scenarios to illustrate a real, tangible risk of actual confusion in the marketplace. These were bolstered by the evidence in Bromage 1 based on the declarant's extensive experience in the soft drink industry.

19. Judicial assistance in approaching a comparison has been provided in cases such as *Southern Cross Refrigerating Co. v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407 and *Australian Woollen Mills Ltd v F S Walker & Co Ltd* (1937) 58 CLR 641.

20. Although the applicant did not appear and did not file written submissions, the evidence in Shea was more a set of submissions than actual evidence. However, Shea did annex examples of the applicant's other NAUGHTY trade mark in use.

21. In considering the similarity or otherwise of the opposing marks, I have taken the statutory definition into account as well as the judicial authorities cited by the parties, including those I have mentioned above.

22. Having also considered the evidence filed and served by both parties, I am satisfied that the applicant's trade mark is deceptively similar to the opponent's cited marks. I

consider that there is a real risk that a number of persons will be caused to wonder whether it might not be the case that NAUGHTY MOTHER and MOTHER drinks come from the same source: *Southern Cross Refrigerating Co*, supra, at 608.

23. I accept the opponent's submissions regarding the dominant feature of each of the marks, both the applicant's and the opponent's, being MOTHER and that dominant feature is in a context of an unexpected, even shocking, contradiction. As well as sharing the same dominant word, the applicant's goods are identical to those of the opponent and directed at the same market. There is a real, tangible risk of actual confusion in the marketplace.

Decision

24. Section 55 of the Act provides:

> **Decision**
> **55.** Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:
> (a) to refuse to register the trade mark; or
> (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;
> having regard to the extent (if any) to which any ground on which the application was opposed has been established.

25. The onus is upon the opponent to establish its ground of opposition. I find that the opponent has met the onus upon it, in terms of the ground of opposition under section 44 argued at the hearing. Accordingly, and subject to a successful appeal from my decision, I refuse to register trade mark application 1153953.

Costs

26. It is usual for costs to follow the event, and I see no reason to depart from that principle here. I award costs, according to the official scale set out in Schedule 8 of the *Trade Marks Regulations 1995*, against the unsuccessful trade mark applicant.

Jock McDonagh
Hearing Officer
Trade Marks Hearings
30 June 2009