



TRADE MARKS ACT 1995

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

Re: Opposition by Beecham Group Plc to registration of trade mark applications 921551 (1, 5, 29, 30), 940385 (5, 29) and 940443 (5, 29) - **ENOVA AND ENOVA LOGO** - filed in the name of ADM Kao LLC.

DELEGATE:	Claudia Murray
REPRESENTATION:	Opponent: Written submissions by Phillips Ormonde Fitzpatrick, Intellectual Property Attorneys, Lawyers and Researchers, Sydney. Applicant: Not represented at hearing, no written submissions. (Address for service, Freehills Patent and Trade Mark Attorneys, Melbourne)
DECISION:	2009 ATMO 61 Section 52 oppositions: sections 42(b), 44, 59 and 60 – opponent unsuccessful – trade marks to proceed to registration - costs awarded against opponent.

Background

1. This decision deals with three applications to register trade marks made by ADM Kao LLC ('the applicant'). Trade mark application number 921551 is for the plain word trade mark ENOVA. Trade mark application number 940385 is for the word ENOVA in stylized form, and 940443 is for ENOVA in stylized form together with device, as shown below:

(940385)



(940443)

2. Other relevant details of the applications are as follows:

TM No.	Filing Date	Priority Date	Goods
921551	30 Jul 02	4 Feb 02	<p>Class: 1 Chemical compounds used in industry</p> <p>Class: 5 Dietary preparations and ingredients for dietary preparations, nutritional supplements and meal replacers in class 5</p> <p>Class: 29 Cooking oils and fats; edible oils and fats; edible oils and fats for use as ingredients in the manufacture of foods, including, soups and frozen meals consisting primarily of meat, fish, poultry or vegetables; edible oils and fats used in the manufacture of food, drink mixes and beverages</p> <p>Class: 30 Potato, rice and corn-based snack chips, crackers and other snack foods; breads, pastries, cokies and other baked goods; frozen meals consisting primarily of pasta or rice; frozen pizzas, candies and candy bars; nutritional snack bars; and meal replacement foods</p>
940385	16 Jan 03	3 Sep 02	<p>Class: 5 Dietary aids and ingredients for dietary aids, nutritional supplements and meal replacers</p> <p>Class: 29 Cooking oils and fats; edible oils and fats; edible oils and fats for use as ingredients in the manufacture of foods</p>
940443	17 Jan 03	7 Oct 02	<p>Class: 5 Dietary aids and ingredients for dietary aids, nutritional supplements and meal replacers</p> <p>Class: 29 Cooking oils and fats; edible oils and fats; edible oils and fats for use as ingredients in the manufacture of foods</p>

3. No grounds for rejection under the *Trade Marks Act 1995* ('the Act') were raised against the applications during examination, the only issue being a minor amendment made to the statement of goods for trade mark number 921551. By the end of September 2003, all three applications had been advertised accepted for possible registration in the *Australian Official Journal of Trade Marks*.
4. Beecham Group Plc ('the opponent') opposed registration of the three trade marks. Numerous grounds of opposition were listed in the notices, including a ground under section 44 which referred in general terms to prior applications and registrations, and specifically identified trade mark number 33197, for the trade mark ENO in class 5.

5. The parties were apparently involved in settlement negotiations for a lengthy period. Several extensions of time were granted to the opponent before evidence in support was eventually served and filed in relation to the applications. No evidence in answer was forthcoming from the applicant, although it also requested extensions of time to serve and file its evidence. Finally, the opponent requested to be heard on all three oppositions. The matters were set down to be heard by me, as a delegate of the Registrar of Trade Marks, on Wednesday 27 May 2009. In the event, the hearing did not go ahead, as neither party elected to attend. However, written hearing submissions were filed on behalf of the opponent by Phillips Ormonde Fitzpatrick, Intellectual Property Attorneys, Lawyers and Researchers, Sydney.

Evidence

Evidence in Support

6. The opponent's evidence in support comprises a statutory declaration by Teresa H. Anzalone, dated 18 October 2007, together with Exhibits 1 to 6. Ms Anzalone declares herself to be the Assistant Secretary of SmithKline Beecham Corporation, based in Pennsylvania, USA. Her declaration explains that the opponent in this matter is a wholly owned subsidiary of GlaxoSmithKline Plc ('GSK Group'), which she describes as a 'global healthcare group engaged in the creation, discovery, development, manufacture and marketing of pharmaceutical products, vaccines, over-the-counter medicines and health related consumer products.' The group has '108 sites worldwide in 41 different countries and employs over 100,000 people.'
7. Ms Anzalone's declaration goes on to outline the history of the GSK Group's very popular 'family' of ENO antacid products in Australia and throughout the world. These products have been sold in Australia under the registered trade marks ENO, ENO FIBRECARE, ENO FIZZTAB, ENO'S FRUIT SALTS, ENO WINDEZE and ENO WIND RELIEF. The trade marks are owned in Australia by the opponent. Ms Anzalone declares (and this is supported by Exhibit 3) that the earliest history of the 'iconic' ENO trade mark in Australia can be traced back to records of 'crates of Eno's Fruit Salts, the great settler of British stomachs' being supplied by local merchants to Australian volunteer troops based in Sydney in 1856. The trade mark ENO'S FRUIT

SALTS was registered in Australia from 29 September 1909 and ENO solus (number 33197) from 11 May 1922.

Grounds of opposition

8. In its written submissions for the hearing, the opponent pressed grounds of opposition under sections 44, 60, 42 and 59, in that order. For completeness, I find that none of the other grounds listed in the notices of opposition have been made out.

Section 44

9. Subsection 44(1), applied to the present circumstances, provides that an application for registration must be rejected if it is substantially identical, or deceptively similar, to another person's trade mark application or registration that has an earlier priority date, and covers goods that are similar to the applicant's goods. The definition of 'deceptively similar' in section 10 is that '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'. Section 14 defines 'similar goods' as goods which are 'the same', or 'of the same description'.
10. As mentioned previously, the notice of opposition, while referring generally to the existence of earlier applications and registrations for the purpose of the section 44 ground, had only provided a single specific trade mark number, 33197, for the trade mark ENO in class 5. The opponent's evidence went to its use of that trade mark, together with the other variations upon it, such as ENO FIZZTAB, which I have listed above. Then, at the end of proceedings, the opponent's written submissions raised two prior registrations in terms of section 44. The first was the ENO trade mark, number 33197, for a 'medicinal preparation' in class 5. The second was number 701971, registered from 7 February 1996, for the trade mark EUNOVA. That trade mark, owned by another subsidiary of the GSK Group, is in respect of 'Pharmaceutical and medicinal preparations for human use consisting of or containing vitamins; dietetics, infants, invalids foods' in class 5.
11. According to the opponent's written submissions, the main thrust of this opposition goes to the section 44 ground, and the likelihood of the public being deceived and confused by coexistence in the marketplace of the applicant's trade marks, and the

two prior trade marks registrations I have described above. However, the opponent's evidence does not deal with the actuality, or even possibility, of deception and confusion at all. Shanahan's 4th edition discusses the particular interplay between the presumption of registrability and the onus upon an opponent in cases such as this, where the ground of opposition relied upon was also potentially a ground of rejection, but was not raised during examination:

It is difficult to establish any ground for opposition without evidence and where the ground for opposition is a ground for rejection, which was not sufficient to prevent acceptance of the application, the difficulty is compounded. The opponent must by evidence or other means displace the presumption of registrability. The absence of evidence may of itself tell against an opponent.¹

12. And later:

In addition to the usual burden on an opponent, there are the problems that an examiner has already decided that an objection under s 44(1) or (2) could not be established and that evidence as to use or reputation of either the trade mark applied for or that on which the opposition is based is irrelevant. To persuade the Tribunal that the respective marks are at least deceptively similar and/or that the respective goods and services are similar or closely related is likely to require particularly cogent evidence.²

13. There is a further issue with the EUNOVA trade mark registration, the existence of which the opponent raised for the very first time in its written submissions. Hearing Officer Iain Thompson, in similar circumstances, has observed:

I note that, based on the evidence and Notice in these proceedings, the applicant is unlikely to be aware that the opponent is reliant on the above trade mark registration in relation to the ground under section 44. The inclusion of the above trade mark registration amongst those upon which the opponent wishes to rely as late as the hearing may thus (in the absence of the applicant at the hearing) constitute an unanswerable ambush and there exists a strong argument this registration should therefore be excluded from my considerations in order to afford the applicant procedural fairness. I am therefore reluctant to give this registration any weight.³

14. If I had unequivocally concluded, at this point, that the EUNOVA trade mark represented a valid barrier to registration of the applicant's ENOVA trade marks, it would have become necessary for me to adjourn proceedings while I formally drew

¹ *Shanahan's Australian Law of Trade Marks and Passing Off* 4th ed, Lawbook Co. 2008 at [50.2005]

² *Shanahan's Australian Law of Trade Marks and Passing Off* 4th ed, supra, at [50.2155].

³ *Axis Communications AB v Action Electronics Co Ltd* [2008] ATMO 58, at para 14 and see also *Apple Computer Inc. v Gundy Computer Services Pty Ltd* [2008] ATMO 33 (20 May 2008) at para 17.

the applicant's attention to the opponent's intention to rely on that previously unidentified registration. Absent that identification in the evidence in support, the applicant was of course not alerted to any need, and therefore deprived of any opportunity to provide, its own evidence of prior use, honest concurrent use, or any other circumstances, which may have been available to it.⁴

15. In any event, I do not believe this to be necessary. The opponent's submissions alone have not persuaded me, according to the accepted tests to which it has referred,⁵ that the trade marks specified under section 44 are either substantially identical or deceptively similar to the applicant's three trade marks. Compared side by side, clearly ENO and ENOVA are not substantially identical. And, despite the opponent's submissions to the contrary, I find that neither are EUNOVA and ENOVA. Unlike the trade mark cases cited by the opponent, where differences of one letter between trade marks led to findings of deceptive similarity, in EUNOVA, the critical placement of the single letter 'U' creates a fundamental difference between that trade mark, and the ENOVA trade mark. The total impression, when the trade marks are compared side by side, is one not of resemblance, but of dissimilarity.
16. Further, applying the guidelines for assessing deceptive similarity, I believe that the significant differences, both visual and aural, between the ENO and ENOVA trade marks militate against the possibility that they would leave deceptively similar impressions in the minds of potential customers.⁶ And it seems to me that the opponent has diminished rather than strengthened its case around the ENO trade mark by raising the prospect that it has already coexisted for some considerable time with the EUNOVA trade mark, in the same 'medicinal preparations', class 5, marketplace.
17. The circumstances are different, however, between the EUNOVA and ENOVA trade marks. The ENO/EUNOVA status quo sheds very little light on how EUNOVA and ENOVA might (or might not) coexist. I have quoted above Shanahan's emphasis on 'cogent evidence' being required in an opposition such as this, where the ground relied upon could have been raised during examination, but was not. Here, absent both prior notice *and* supporting evidence relating to the EUNOVA trade mark, I am

⁴ See *Swatch AG v Christopher Gray* [2008] ATMO 48 (16 June 2008), paras 4-10.

⁵ *Shell Co. of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1961) 109 CLR 407 at 414-5

⁶ *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd*, (1937) 58 CLR 641 at 658.

prepared to lean against a finding of deceptive similarity with the applicant's ENOVA trade marks. To find otherwise would be to allow the opponent to succeed in what, at best, could perhaps be interpreted as an inadvertent, rather than deliberate exercise in procedural unfairness. I find that the opponent has not met the onus upon it, and the ground of opposition under section 44 has not been made out.

Section 60

18. The subject applications were filed before a significant amendment to section 60 came into force on 23 October 2006. Accordingly, the pre-amendment version of the section applies.⁷ As the opponent's submissions indicated, that earlier wording 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.

19. To satisfy these provisions, an opponent must demonstrate that, at the time of filing of the opposed applications, it had a reputation in a substantially identical or deceptively similar trade mark, such that use of the applicant's trade marks would likely cause the public to be deceived or confused. The opponent's trade mark need not be subject of an application or registration, in order to be able to be relied upon under this section.
20. The opponent relied only upon its ENO trade mark in relation to this ground, citing the reputation in that mark outlined in the evidence in support. However, I have already decided that the ENOVA trade marks are not deceptively similar to the ENO trade mark. So, under the applicable provisions of the (now amended) section 60, the opponent's case fails at the first hurdle and the ground cannot be made out.

Section 42(b)

21. The opponent made only very brief submissions in relation to its ground of opposition under section 42(b). That section of the Act provides:

⁷ *Apple Computer Inc. v Todaytech Group Pty Ltd*, 2007 ATMO 40

An application for the registration of a trade mark must be rejected if:

...

(b) its use would be contrary to law.

22. The relevant law, according to the opponent, was section 52 of the *Trade Practices Act 1974*. The provisions of subsection 52(1) specify that:

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

23. The opponent simply submitted that the applicant had chosen its trade mark to ‘take advantage of the goodwill and reputation of the Opponent or its related entities within the GSK Group’. It cited *Campomar Sociedad, Limitada v Nike International Ltd*:

[W]here there is such a finding of intention to deceive, the court may more readily infer that the intention has been or in all possibility will be effective.⁸

24. I have not found for the opponent upon the question of deception and confusion in terms of sections 44 or 60, so a positive finding at the higher threshold of section 42(b) would be a most unlikely outcome. For its part, the opponent has placed no evidence before me to support its claims about the intentions of the applicant. As Justice French has relevantly observed:

The trade mark law concept of confusion in the sense of mere wonderment as to common origin or connection has little part to play in the consumer protection statutes.⁹

25. I find that the ground of opposition in terms of section 42(b) has not been made out.

Section 59

26. Section 59 deals with an applicant’s intention to use its trade marks(s):

Applicant not intending to use trade mark

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;
- in relation to the goods and/or services specified in the application.

Note: For ***applicant*** see section 6.

⁸ (2000) 46 IPR 481 (High Court), 490

⁹ *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 at paragraph 47; (1999) 45 IPR 411.

27. The opponent's written submissions made the following observations about the applicant's business activities, in support of this ground:

- A search of the Internet using the Google® search engine for the search term "ENOVA" locates the Applicant's website www.enovaoil.com. Attached to these submissions are some pages printed from this website. All of the literature on the website www.enovaoil.com refers to DAG-rich cooking oil sold under the brand ENOVA.
- While the website www.enovaoil.com states that cooking oil sold under the trade mark ENOVA is available in the USA, it is not clear whether ENOVA cooking oil can be purchased in Australia.
- The search of the Internet did not locate any other dietary, nutritional or food preparations being sold under the trade mark ENOVA.
- The Opposed Applications were all filed in 2002 or early 2003. Thus, the Applicant has had over six (6) years to extend its use of ENOVA to goods other than "cooking oil". However, we cannot locate any evidence that this has occurred.
- The Applicant has not submitted any evidence that it is using, or intends to use, the trade mark ENOVA, in Australia.

28. Given the above, the opponent continued, while the applicant may have an intention to use its trade marks in Australia in respect of 'cooking oil', it clearly did not have an intention to use them in respect of any other goods. At the very least, therefore, the goods of the opposed applications should be limited to 'cooking oils'.

29. At the outset, the onus is upon the opponent to make its case under section 59, as for any other ground of opposition. This requires much more than an unserved, unsworn suggestion that an opening exists for the Registrar to draw an inference founded essentially upon the applicant's own omission of evidence. Evidence before the Registrar is required to be given in writing in the form of a declaration, and/or orally on oath or affirmation.¹⁰ In relation to this ground of opposition, the opponent has no evidence at all on which it is able to rely.

30. An opponent's case under section 59 can differ somewhat from a case made under other grounds of opposition, in that an opponent's evidence *may* prove sufficient to cause the onus to be shifted away from it, and onto the applicant. Hearing Officer

¹⁰ Regulation 21.17, *Trade Marks Regulations 1995*.

Michael Kirov, in *Apple Inc v Artistic Licence International*¹¹, has recently described the potential shifting of onus from opponent to applicant under section 59 thus:

[T]he High Court's decision in *Aston v Harlee Manufacturing Co* [1960] HCA 47; (1960) 103 CLR 391 is longstanding authority that applying to register a trade mark is prima facie evidence of intention to use. Subsequent decisions indicate this prima facie presumption may be rebutted where the evidence readily gives rise to the drawing of an adverse inference and that evidence remains unchallenged and unrebutted by the applicant.¹² The onus does not however shift to an applicant merely because an opponent *questions* the applicant's intention in its Notice of Opposition or submissions.¹³

31. The opponent's investigations may indeed have suggested that the applicant has not yet commenced use of its trade marks in Australia, in relation to the goods specified in its applications. However, the opponent has fallen far short of making a persuasive case for the applicant's lack of either an intention to use at the time of filing, or of a genuine intention to use the marks in the future. An applicant is entitled to wait for the conclusion of an opposition process, and subsequent registration, before using its trade mark(s). It is also entitled to expect that an opponent would declare in evidence the results of its enquiries in terms of section 59, thereby providing an opportunity for consideration and possible response. Instead, as with its section 44 ground, the opponent has apparently preferred a course of ambush rather than evidence in its quest for success.
32. Had the opponent been able to shift the onus under section 59, the applicant might then have been required to substantiate its intention to use the ENOVA trade marks, already implicit in the initial filing of the applications for registration. However, the opponent has not met its initial burden, and so the ground of opposition under section 59 has not been established.

Decision

33. Subsection 55(1) of the Act provides:

(1) Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

¹¹ [2009] ATMO 15, para 21.

¹² See for example *Phillip Morris Products SA v Sean Ngu* [2002] ATMO 96; *Sapient Australia Pty Ltd and Sapient Corporation v SAP*.

¹³ See for example *Medley Distilling Company v Croakers Gully Australia* (2000) 53 IPR 430; *Wal-Mart Stores Inc v Ozark-London Ltd* (2004) 62 IPR 165.

- (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.

Note: For *limitations* see section 6.

34. The onus is upon the opponent to establish one or more of its grounds of opposition. Gyles J has referred to the standard of proof required in terms of a ‘balance of probabilities’.¹⁴ I find that the opponent has not met the onus upon it, in terms of any of the grounds of opposition it pursued. Trade marks numbered 921551, 940385 and 940443 may therefore proceed to registration one month from the date of this decision. If the Registrar is served with a notice of appeal before that time, I direct that registration shall not occur unless the appeal is decided in favour of registration, or discontinued.

Costs

35. The opponent has sought its costs in this matter. However, 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 opponent, Beecham Group Plc.

Claudia Murray
Hearing Officer
Trade Marks Hearings
10 August 2009

¹⁴ *Pfizer Products Inc v Karam* [2006] FCA 1663; (2006) 70 IPR 599