



TRADE MARKS ACT 1995

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

Re: Application for amendment of the trade mark of registration 297378 in the name of Richard James Andrew Lawson

Background

Trade mark number 297378 was registered on 1 June 1976, the registered owner of the mark being Richard James Andrew Lawson. Representation of the mark is shown here:



On 25 November 1997, an application was filed by the attorneys for the registered owner of the mark to amend the mark, under the provisions of s.83(1)(a) of the Act, to the version as follows:

The examiner said that the sought amendment would constitute a substantial alteration to the mark, because it would not only significantly change the design of the device in the mark but also alter the prominence of the word within the device. Consequently, the proposed amendment was not allowable. This resulted in considerable correspondence between the examiners dealing with the matter and the registered owner's attorneys. The attorneys submitted that the examiners appeared to be approaching the question from the perspective of whether or not the two forms of the trade mark, in comparison, were either substantially identical or deceptively similar, which were irrelevant considerations. Further, it was stated that the Registrar should

consider more deeply what the official policy was behind the provisions of s.83. The attorneys said that the whole point of the section was to permit an amendment of a registered mark unless the effect of the amendment would be to extend the statutory rights beyond those previously enjoyed by the registered owner. In their view, it was incorrect to impose an official practice that only permitted an amendment where it was so trivial that there was no point in making the amendment. In relation to the requested amendment, it was submitted that all of the elements were exactly the same in both marks; although the device element in the new mark might look slightly different, nevertheless its description did not vary. The examiner responded by explaining that the differences noted in comparing the marks were merely intended to illustrate how the requested amendment would alter the identity of the original mark and reiterated that the amendment was not acceptable.

The attorneys applied to be heard on the matter. At the hearing, which was held in Sydney, Mr Wayne Willis of F.B. Rice & Co, patent and trade mark attorneys of Sydney, represented the registered owner of the mark.

Submissions

In commencing his submissions, Mr Willis explained that, although the present issue could have been resolved by filing a fresh application for the amended mark, the registered owner had a special reason for seeking the amendment. It had filed an application for registration of the amended mark in the United States of America, but there were difficulties with that application, because the owner of the mark had not used it there. If the present mark could be amended to correspond with the form of the mark on the United States application, registration of the mark in that country could be secured, based upon its registration in the home country.

However, Mr Willis continued, another reason for taking the matter to the hearing concerned the issue of the clarification of the expression "substantially affecting the identity of the trade mark", which occurs in four sections of the Act and the meaning of those words. Because the application of its meaning arose on a number of occasions, it would be helpful for legal practitioners, he said, to have at least some understanding of what kind of amendments or alterations would be regarded as

acceptable, adding that neither the practice notes nor any decisions of the courts offered any guidance. In Mr Willis' opinion, the practice in the Trade Marks Office regarding the present matter, which he termed as extraordinarily conservative, had evolved contrary to the plain meaning of the words in the expression itself, and without regard to the legislative intention and the policy considerations for allowing amendments or alterations. It appeared to him, he said, that the way in which the expression was actually applied to amendments of a trade mark would permit only very minor changes. In the present case, there had been an inability on the part of the examiners to actually focus in on the specific tests that needed to be applied to what was intended to be achieved by the legislation.

Mr Willis reminded me that the expression under consideration is exactly the same in sections 65.(2), 51.(1)(d), 83.(1)(a) and 100.(2) of the Act. Noting that, in *The Concise Oxford Dictionary* the word "substantial" is defined as "of real importance or value; of large size or amount" and, according to *The Oxford English Dictionary* "identity" is the quality or condition of being a specified person or thing, he submitted that the respective provisions allowed for quite a significant change. In assessing what degree of change was permitted, he said that some assistance could be sought from the decision in "*Pelican*" *Trade Mark* [1978] 424. Although, in that case, Falconer QC had not indicated what the relevant expression meant, from his statements it could be inferred that, in relation to applications to amend trade marks, one should look at various sections where the expression appeared, not in abstract terms, but in the way in which the proposed amendment would affect the rights of other parties. That would involve thought on how the proposed amendment would impact on the provision of section 44 and the acceptability, or otherwise, of somebody else's application for registration, how a search of records of the Trade Marks Office might change, and the consideration of the effect the amendment might have on other parties as to possible infringement. Mr Willis added that the examiners did not, of course, deal with infringement matters, but, he said, the tests that were applied in infringement actions under s.120 were exactly the same tests with respect to determining substantial identity or deceptive similarity of trade marks as were applied by examiners in the course of examination of the marks.

Mr Willis said that, in considering an amendment of a mark under s.83.(1)(a), it may be of assistance to look at the issue from the perspective s.100.(2), whether or not evidence of use of the trade mark in the proposed amended form would protect the registration of the mark in its existing form from removal of the mark for non-use, because the issue would then be seen in a particular context. As an example, Mr Willis referred to a hypothetical situation where the Registrar would not allow an application to amend a mark requested earlier by the registered owner on the grounds that it was using an altered mark and wished to amend the registration accordingly, but, if subsequently a third party applied to have the registration removed for non-use of the mark, the Registrar would refuse the application, because the two marks were not considered sufficiently different to justify the removal action. In such circumstances, he said, it would be illogical to produce opposite results.

Mr Willis submitted that, when one applied what he had stated previously to the marks under consideration, he could see no additions to the altered mark. All the elements present in the original mark had been retained. In his opinion, if the device in the proposed amended version were to be stretched, it would result in exactly the same original form - as if the earlier form had simply been squashed in a fatter and thicker form. Looking at the amendment from the perspective of searching, in his view, it would be possible to find the proposed amended mark in exactly the same way as the original mark. One would therefore come to the same conclusion about the essential elements of the mark in terms of deceptive similarity, and also infringement. Members of the public accepted that trade marks evolved in their appearance and were used to seeing modernised versions of marks; that was what the new form represented. If an application was filed for removal of the mark from the Register and the registered owner was able to show use of the new mark, then, in his opinion, the application would fail.

If the Trade Marks Office personnel, in order to comply with the legislation, needed to be conservative in respect of amending a mark under s.83.1(a), then the Registrar should consider the four sections mentioned earlier with a view to amending the legislation so that, in the case of s.83, a proposed amendment could proceed, provided it was immaterial, or that it did not alter the identity of the trade mark, Mr Willis

submitted. If the word "substantial" was retained in the respective sections, in view of the meaning of the word found in the Oxford dictionary, a distinction needed to be drawn between an expression where the word appears and where it does not appear. As matters stood at present, Mr Willis said, the very liberal wording in the legislation was matched with a very conservative interpretation of those words by the examiners in the Trade Marks Office.

Discussion and analysis

The relevant provisions of the Act applicable to amendments of particulars of trade marks entered in the Register are encompassed in section 83. This section reads:

83.(1) Subject to Part 11, the Registrar may, at the written request of the registered owner of a registered trade mark:

- (a) amend the representation of the trade mark as entered in the Register if the amendment does not substantially affect the identity of the trade mark as at the time when the particulars of the application for the registration of the trade mark were published under section 30;
or
- (b) amend any particulars entered in the Register relating to any goods or services in respect of which the trade mark is registered if the amendment does not have the effect of extending the rights that (apart from the amendment) the owner has under the registration;
or
- (c) amend, or enter in the Register, any other particular in respect of the trade mark if the amendment or entry does not have the effect of extending the rights that (apart from the amendment or entry) the owner has under the registration.

These provisions stipulate that an amendment to the mark sought by its registered owner may be considered in terms of para (a) of subsection 83(1). However, the amendment to the mark may be contemplated only if it does not substantially affect the nature of the mark as it existed at the time of publishing the particulars of the application when it was filed. These provisions envisage only a narrow scope for an amendment of a mark so as to avoid extending the scope afforded its registration. A more liberal approach to amendments is allowed pursuant to s.64, which provides for amendments to applications for registration of a mark to correct a clerical error or an obvious mistake. Such amendments are entertained only before the particulars of an application are published.

That an amendment of a registered mark may be allowed, provided that it does not substantially affect the identity of the mark also occurred in s.21 of the repealed Act, the *Trade Marks Act 1955*. The precedent cases, based on the equivalent section in the *Trade Marks Act 1938* (United Kingdom), show that, in the past, a strict approach has been taken by the Registrar in relation to amendments of a mark in terms of s.21 under the repealed Act, because even a minor alteration in a mark will, to some degree, affect the scope of its registration, as I indicated earlier.

In "*Otrivin*" Trade Mark [1967] RPC 613, where the Registrar's decision was upheld that the addition of the letter "e" to the registered mark OTRIVIN might change the pronunciation and appearance of the mark, Tookey Q.C., on behalf of the British Board of Trade, explained, at 615:

In seeking the answer to this question the Registrar is entitled and indeed bound to have regard to his general knowledge and experience, and, bearing in mind that he is dealing with a word which is a registered trade mark, he should consider whether the alteration is of such a nature that it would have affected the scope of investigations for conflict with other registered marks under section 2(1) (sic). That is one of the matters referred to in the Registrar's decision. I think that the Registrar was right to decide that the addition of the letter "e" to OTRIVIN might effectively change the look and pronunciation of the word, and that a section 12(1) investigation on OTRIVIN could not be regarded as covering OTRIVINE just as well. The Registrar has also expressed concern that the rights of third parties using unregistered marks might be affected by OTRIVINE although not affected by OTRIVIN. In my view these doubts are justified. These are all considerations which the Registrar may legitimately take into account, and I would regard it as unsafe, as the Registrar has thought, to assume that the alteration would raise no difficulties. It may be so, but it is not apparent on the face of the application.

Similarly, in the "*Pelican*" case, supra, cited and discussed by Mr Willis, Falconer QC, in deciding an appeal to the Board of Trade from a decision of the Registrar, indicated that, when considering amendments to trade marks one must have regard to the question of conflict in terms of s.12 of the Act, which would be equivalent to s.44 of the current Australian Trade Marks Act, and to ascertain whether further investigation of the effect on others would be necessary. Mr Falconer allowed the proposed amendment of the mark there, because the alteration of the mark PELICAN

in italic script to PELIKAN in a similar script was considered to constitute no change in meaning or pronunciation. In that regard, Mr Falconer's words, at 427, read:

The mark now registered, being an ordinary dictionary word, conveys a definite meaning. Although the proposed alteration would result in a change in the visual appearance to the limited extent already mentioned, it would not result in any change in the meaning conveyed by the mark.

The hearing officer had refused the amendment on the grounds that it would change the mark from a recognisable English word to a word which some persons might see as a German word with the same meaning "pelican", while to others it would appear to be a mere misspelling of this word.

In view of these precedent cases and being mindful of the fact that s.35(1) of the 1938 Trade Marks Act in the United Kingdom is couched in similar language to s.83.(1)(a) of the current Australian Act, I think I am justified in drawing guidance as to the accepted meaning of the expression "substantial identity" from *Seaforth Maritime Ltd's Trade Mark* [1993] RPC 72, where the hearing officer, Mr N.A. Harkness, appropriately encapsulated it, at 74, in the following words:

... that the word "Substantially" is not to be interpreted merely in quantitative sense but in section 35 it is intended to permit only an alteration of a registered mark which does not in substance affect the identity of the mark itself, and that by the identity of the mark is meant those features by which the mark will be recognised (either by its meaning, or phonetically or visually) and which serve to distinguish the goods of the proprietor of the mark from the similar goods of other traders.

The registered mark here depicts a discernible device of a propeller and the word SPACEPEDAL rendered in lower case script letters. In the new mark, while the word is retained in almost the same lettering and position, it is submerged by the thick curved stripes forming the device element, thus diminishing its significance. However, it is in the device of the amended mark, where the major changes occur, altering the shape and appearance of a device which, in the registered mark, is readily recognisable as an outline of a propeller. The enlarging of the circle, the reduction in size of the curves at its sides and the heavy stripes alter the device to a degree where it is no longer seen as an obvious outline of a propeller, but one that attracts a number of different descriptions. In my view, it is very doubtful that the descriptions "a propeller" or "a two-blade impeller device", presently assigned to the original mark

for the purposes of searching the Trade Marks Office records for any substantially identical or deceptively similar marks in terms of s.44, would be carried to the new version of the mark. The device in the mark has become a different identity. It would not be easily recognised as a propeller device, but something that eludes a precise description. Some descriptions of this device element that come to mind might be an incomplete infinity symbol and a concentric circle broken by a wavy stripe, but, in whatever manner this device would be identified, the amendment would, unquestionably, require re-indexing of the new constituent particulars and a fresh search. It follows, of course, that the altered mark could be in conflict with other marks on the Register or those awaiting registration. These factors are sufficient in deciding that the requested amendment of the registered mark ought not to be allowed.

While I appreciate Mr Willis' submissions in relation to the s.83 issue being considered in light of s.100(2), in the absence of clear directives from the courts known to me on this question, I must rely on Mr Tookey's (in the Board of Trade) opinion expressed in "*Otrivin*" case, *supra*, at 615:

No alteration to a mark should be allowed unless the tribunal is satisfied that it cannot substantially affect the identity of the mark. If the tribunal is so satisfied, the alteration can be allowed. If the tribunal is not so satisfied, it does not appear to me to be helpful to make any assumptions as to what a tribunal might decide under section 26 or section 30 [which closely equates to s.100(2)(a)] on the basis of evidence which is not before the tribunal considering an application under section 35.

Decision

Applying the tests set out in the "*Otrivin*" and "*Pelican*" cases, both *supra*, to the matter in suit, I do not think that the examiner erred in maintaining that the differences between the two marks are substantial and go beyond those permitted by section 83 of the Act. I find therefore that the application to amend the registered mark in the manner proposed is not allowable.

Vija Zars
Hearing Officer
12 January 2000

