



TRADE MARKS ACT 1955

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS

Re: Trade mark application number 527976 in the name of DR. ING H.C.F. PORSCHE AKTIENGESELLSCHAFT

Application number 527976 was lodged by DR. ING H.C.F. PORSCHE AKTIENGESELLSCHAFT (the applicant) on 1 February 1990 for the statement of goods subsequently amended to read: "Motor vehicles", in Class 12, for the mark, TARGA.

An examiner's report of 31 May 1991 requested, inter alia, that the applicant provide an English translation of the foreign word TARGA appearing in the mark. The applicant's attorney, Phillips Ormonde & Fitzpatrick, advised on 6 July 1993 that the applicant was not aware of any foreign meaning of that word and lodged a Statutory Declaration by Adrian Smith, of Porsche Cars Australia Pty Ltd, and exhibits setting out use of the applicant's trade mark since 1970. On 5 August 1993, the examiner raised a substantive objection to the mark's registration on the ground that the mark was not distinctive, as it was a mark which other traders in like goods were entitled to use on their goods. The examiner based the objection on three factors:

1. the entry of the word TARGA in the *Macquarie Dictionary of Motoring* which described the word as a "general term",
2. the descriptive use of that word by the applicant as a motor vehicle body type in the evidence submitted, and
3. the evidence of the use of the word TARGA by journalists, as a general description of a motor vehicle body type, in material located in an online data base search.

The attorney disputed these allegations in his letter of 13 September 1993 and also advised that the word TARGA had been discovered to have a meaning in Italian as being "plate, plaque or sign". The examiner clarified his position in the third report of 21 September 1993 and the attorney sought a hearing to determine the matter.

The matter came before me, as the Registrar's delegate, in Canberra on 13 December 1993. Appearing on behalf of the applicant was Mr Malcolm Royal of Phillips Ormonde & Fitzpatrick.

Mr Royal said that no copy of the dictionary reference on which, inter alia, the objection had been based had been supplied to the applicant and that, in any case, a mark could not be determined as being generic simply because it was referred to as such in a publication. He said that the main *Macquarie Dictionary* carried an endorsement regarding words which could owe their origin to trade marks. This disclaimer said that no assumptions should be made about a word's legal status if such an indication of derivation was absent. He said that this should also be the case in that dictionary's specialist publications. He referred to a letter from the Nissan Motor Company in Japan to the applicant in Germany stating that Nissan were "...convinced that your trademark 'Targa' to designate your Porsche's open-top model with a roll bar has established so dominant popularity among the public, and is also the registered trademark in many countries." Nissan said in the letter that it would instruct its Swiss company to stop using the word TARGA in advertising. Mr Royal said that this showed that others in the trade realised that the word TARGA was the property of the applicant. He argued that the applicant's use in its own publications was as a kind of "sub" trade mark to refer to a particular model or style of Porsche motor vehicle. This was common in the motor vehicle trade and other car companies also used their "house" mark followed by the model of the vehicle, e.g. Ford Falcon or Toyota Landcruiser. These "sub" trade marks could also be used independently of the "house" mark to denote a particular car, e.g. a Sierra is made by the Suzuki company.

With respect to a comment by the examiner that the applicant's evidence refers to the "Targa concept", he said that this could be likened to the use of such a term by other car manufacturers, e.g. the "Range Rover concept" which merely indicated a kind of vehicle made by that maker and which was still trade mark use. Mr Royal also attacked the objection as it was based upon the online "Dialog" search conducted on the examiner's behalf. He said that it was a denial of natural justice to an applicant if the material on which an objection is based cannot be supplied to that party for consideration.

Decision

For a word, not being a signature or name, to be registrable in Part A without evidence, it should qualify in terms of one of paragraphs (a) to (d) of sub-section 24 (1) of the Trade Marks Act. However, the basic requirement for the registration of any trade mark in Part A is that it is distinctive, i.e. adapted to distinguish the goods of its owner from the similar goods of other traders. The mark may also be considered, as allowed by sub-section 44(2), for its registrability in Part B of the Register.

The test as to whether, or not, a mark is adapted to distinguish is well established. If the mark is one which other traders would desire to use, without improper motive, upon or in connection with their own goods, then registration will generally be denied - see, for example, *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511 (the *Michigan case*).

The present mark comprises the word TARGA. That word is Italian and can mean "number plate, tablet or shield". The word appears to have been adopted by the applicant in the late 1960s to indicate a particular body style, where a folding roof can be removed to create an open-top car for touring. It would also appear from the applicant's evidence that the word was used by the applicant in advertisements and other promotional activity in respect of its range of motor vehicles in Australia since at least 1970. However, the material uncovered

by the examiner also seems to show increasing use of the term in a purely descriptive sense by motoring journalists and some lexicographers. Further, the advertising brochures distributed by the applicant also use the term "Targa" in a descriptive sense in company with "Cabriolet" and "Coupe" to denote a particular body style - the two latter terms being recognised dictionary terms widely used in the industry. I believe that what I have to decide here is whether the word TARGA is now common to the trade because the owner has used it in a descriptive manner, and also because it failed to restrain the word's use by those who write about motoring and so influence public perceptions about what are common terms for description

Certainly, in the material assembled by the examiner, the word TARGA seems to have been used in a descriptive sense by journalists in relation to makes of motor vehicle other than Porsche, e.g Ferrari, Toyota, and Volkswagen. The word also appears in the *Macquarie Dictionary of Motoring*, edited by Pedr Davis, at page 472 viz:

Targa roof has become a general term for a design midway between a true convertible and a closed coupe, incorporating a roll bar for passenger protection and a detachable roof panel

The fact that none of this material was physically supplied upon request for the applicant's consideration does not detract from the objections taken. I agree that, if possible, material that is not readily accessible to an applicant and on which an objection is based, should be made available. However, in the present case, the dictionary in question is available from major libraries and may be borrowed on inter-library loan. Additionally, the "Dialog" search results relied on by the examiner, which were supplied to the applicant, were only in abstract form but contained the bibliographic details of the various articles. The full text of the articles listed could also be obtained from the same searching service.

In all of this, there has not been any evidence submitted which shows that the applicant actively sought to discourage use of the word in a descriptive sense by others in Australia.

Certainly, the letter submitted by the applicant, from Nissan in Japan to Porsche in Germany, is an indication that the applicant may have made some approach to Nissan to have that company's Swiss dealer desist from using the term. However, that does not appear to represent the state of play in this country. The *Macquarie Dictionary of Motoring* was published in 1986 and there is no evidence that there have been any approaches made to the publishers since then to have the reference to "a general term" rectified. Certainly, as Mr Royal said, the entry of the word in a dictionary without some mention of it being the applicant's exclusive trade mark is not the absolute determinant of the mark being generic. However, I would have thought that the entry would have warranted some sort of rebuttal to the labelling of the word being "a general term" if the applicant was serious about protecting its valuable trade mark.

The applicant seems to have been especially successful in developing a new body style which incorporates a removable roof panel and roll bar. This innovation appears to have been imitated by other manufacturers. Indeed, with the growth in the number of car makers who produce this type of open top style, it is difficult to imagine another word which succinctly describes its characteristics. Unfortunately for the applicant, it appears to have developed an article for which there was previously no briefly descriptive word, or words. My own knowledge of the motor vehicle market, albeit comparatively limited, is that private traders advertise vehicles for sale with "targa" roofs and that motoring articles frequently refer the word in a generic sense. Some articles which I have personally seen include the words: "removable targa roof panels" - *Canberra Times*, 24 September 1993, "a new generic term 'targa top'" - *Autocar & Motor*, 28 July 1993, and "the coupe and targa top 348ts" - *Autocar & Motor*, 3 March 1993. All of these references are to makes of motor vehicles other than Porsche.

As D.R. Shanahan says at page 406 of his book, *Australian Law of Trade Marks and Passing Off* (Second Edition):

The trade mark of a newly conceived product is often in danger of supplying the name for that product, particularly where the originator has had a monopoly so that the public has seen no other mark: *Argyllshire Weavers Ltd v A. Macaulay Tweeds Ltd* (1964) RPC 477...What a trade mark signifies is a question of fact, and whether a mark becomes descriptive will depend in practice on the nature of the mark, the way it is used, and whether some other name is available to describe the product.

As I have previously observed, the applicant itself has used the mark descriptively to indicate an alternative to a coupe or cabriolet body style and there does not appear to be any other previously used word to describe that kind of motor vehicle. I think that the use in the applicant's publications can be distinguished from the use as a "sub" trade mark to which Mr Royal referred, e.g. Ford "Falcon". In all of those examples of such use by other manufacturers, the "sub" mark indicates an entirely different model of the make of vehicle. In contrast, Porsche's use of the word TARGA appears to indicate a body style which is available in a range of models and is, therefore, not a model of its own.

Another factor which I have had to consider is that, although the applicant has claimed to have first used the word in Australia since at least 1970, this application was not made until 1990. That period represents a 20 year time delay in seeking the protection afforded by registration. During this time it would appear that, in this country, the metaphorical horse has bolted. Mr Royal has claimed that the word TARGA is a mark coined by the applicant and that other traders should not be allowed to use it for their own purposes. However, the present application for registration appears to be the first assertion of rights in that word made by the applicant in Australia. This would not seem to be the action of a trader anxious to prevent the unauthorised use of its valuable mark by others and, in my opinion, amounts to acquiescence.

In my opinion, the word TARGA has become descriptive in Australia of a type of motor vehicle body style made by the applicant and also of those of a similar appearance manufactured by other traders. Given the foregoing, I find that the mark has become

generic in this country by virtue of its use by the applicant in a descriptive sense and the applicant's failure to adequately protect it from unauthorised use by others since adoption. It is therefore not adapted to distinguish the goods of the applicant from those of other traders and consequently fails the test of distinctiveness.

Turning to whether the evidence is sufficient to show the distinctiveness in fact of the subject mark, I have taken into consideration the material lodged showing sales by the applicant under the word TARGA. Whilst I do agree that the sales figures under the mark indicate a reasonable degree of use in a luxury market, the manner of that use is still descriptive in indicating various models available as a "Targa" body style. However, despite the consideration of any evidence of use, I feel that the word is now generic and is thus so inherently non-distinctive that it does not qualify for registration under s.24 the Act.

I was not asked to consider the registrability of the mark in Part B of the Register but, for the sake of completeness, I find that it also does not qualify for that Part as being likely to become distinctive. Registrability of a mark in Part B depends upon determining whether a mark will, at some time in the future, satisfy the requirements of sub-section 26(2) concerning inherent distinctiveness and distinctiveness in fact. In *Burger King Corp. v Registrar of Trade Marks* (1973) 128 CLR 417, Gibbs J explained at 424:

"...the two matters that fall for consideration in deciding whether a trade mark is distinctive, and in deciding whether a trade mark is capable of becoming distinctive it becomes necessary to consider whether the trade mark is capable of meeting in the future the tests stated in s.26(2). That sub-section requires two matters to be considered, inherent ability to distinguish and distinctiveness in fact acquired by use or other wise.

I have already found that the word TARGA lacks inherent distinctiveness and therefore, despite the evidence of use, I also find that the mark is not capable of becoming distinctive within the meaning of s.25 of the Act.

Conclusion

Given the foregoing, I find that the word has become generic, could be required for use by other traders and is, therefore, non-distinctive. Accordingly, I refuse the application as I am not willing to accept it the mark in Part A or Part B of the Register.

Ian Forno
Hearing Officer

14 March 1994