



## **TRADE MARKS ACT 1955**

### **DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS**

Re: Trade mark application number 544446 in the name of NORTHERN TELECOM LIMITED

Application number 544446 was lodged by NORTHERN TELECOM LIMITED (the applicant) on 24 October 1990 for the statement of goods "Telecommunications switching equipment", in Class 9, for the mark, SUPERNODE.

An examiner's report of 28 February 1992 objected to the mark's registration under s.24(1)(c), (d) and (e) that the mark was a combination of the words SUPER and NODE which referred directly to the character or quality of the goods of the application. The applicant's attorney, Griffith Hack & Co, argued that the word NODE had no meaning in the telecommunications industry but, in the electrical industry, a NODE was literally a point of intersection of different electrical branches on an electrical diagram. Furthermore, the attorney submitted that the mark had become distinctive through use in Australia and submitted a Statutory Declaration by Philip Torry Erickson, Vice-President, Patents and Licences of the applicant, to support this contention. The examiner maintained the objection in the second report, referring to a letter by Assistant Registrar Farquhar in relation to a previous application, number 476412, to register the same mark for the same goods. In that letter, Mrs Farquhar had said that, having found on primary inquiry that the mark was not inherently adapted to distinguish the goods of any one trader, evidence that the mark may have become distinctive in fact could not render it registrable - even in Part B of the Register. In reply, the attorney sought to have the mark transferred to one in Part B and

argued that the *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511 (MICHIGAN) and *Burger King Corp. v Registrar of Trade Marks* (1973) 128 CLR 417 (WHOPPER) cases made it clear that marks which have zero degree of inherent adaptability to distinguish are either geographical names, completely normal descriptions of a product or ordinarily laudatory epithets. The attorney contended that the mark SUPERNODE was not in any of these categories and that it could not be said that the juxtaposition of the two words into a combined word had zero degree of adaptability to distinguish. The attorney further pointed to the registration of two other marks in Part B, B419246 (ULTRANODE) and B458194 (PowerNode), which covered goods related to the applicant's saying that those marks had no greater degree of adaptability to distinguish than the present mark. The examiner again maintained the objection in the third report quoting the *Howard Auto-Cultivators Ltd v Webb Industries Pty Ltd* (1946) 72 CLR 175 (ROHOE) case and the words of Dixon J. He alleged an analogy between that mark and the present case, in that the derivation and meaning of the word SUPERNODE were both obvious and that the word applied to the goods was both a laudatory and descriptive epithet. The attorney then sought a hearing in the matter.

The matter came before me, as the Registrar's delegate, in Melbourne on 7 February 1994. Appearing on behalf of the applicant was Mr John Hawker of Griffith Hack & Co. In his submissions, Mr Hawker outlined the events so far, emphasising particularly that the evidence lodged showed a turnover of at least 20 million dollars in 1992. This, he said, went a long way towards showing the mark was capable, through use, of becoming distinctive. He agreed that the word SUPER could be seen to be descriptive in relation to the goods. However, he maintained that the mark was not that word but one formed by its conjunction with NODE. This combination was at least capable of becoming distinctive. He said that it was not obvious which quality of the goods could be said to be referred to. In reference to the letter by Mrs Farquhar referred to by the examiner in his second report, Mr Hawker said that, although Mrs Farquhar had said, *inter alia*, that the word in question was not being used in a trade mark sense, the mark was being used in such a way in its

promotional material, albeit preceded by the letters DMS. He said that the combination of letters DMS was used as a trade mark followed by a number of "sub-marks". The word SUPERNODE was one of these sub-marks and its employment, in combination with DMS, on brochures and the like was still trade mark use which would be sufficient to overcome any action to remove the mark for non-use. He referred here to the provisions of s.38 of the Act. He closed his submissions by saying that there were many marks on the Register which contained the word SUPER and the present mark was at least comparable to some of these in its capacity to become distinctive.

### **Decision**

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*, supra, 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.

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*, supra, (the *Michigan* case).

The mark SUPERNODE is clearly a combination of the words SUPER and NODE. The word SUPER, as conceded by Mr Hawker, is descriptive in relation to the goods. The crux of the matter, then, is the degree of descriptiveness of the word NODE and whether its combination with SUPER is sufficient to give the mark, as a whole, the capacity to become

distinctive of the applicant's goods. The word NODE has, in relation to the telecommunications industry, a general descriptive meaning - that of a terminal of any branch of a network, or a terminal common to two or more branches of a network. It also has several specific meanings dependent upon the situation in which it is used.

With respect to the degree of invention of the two words in combination, I turn to the words of Lord Shand in *Eastman Photographic Material Co's App'n* (the *Solio* case) (1898) 15 RPC 476:

There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words I think should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it **or a mere combination of two known words** would not be "invented"... (my emphasis)

I think it highly probable that other traders might wish to extol the virtues of their "super nodes" and would wish to use the combination of the words as an advertising strategy. I therefore find that the combination of the two words SUPER and NODE is not so unusual as not to be legitimately required by other traders to describe their own like goods.. The word SUPERNODE would have an obvious meaning to purchasers of telecommunications switching equipment as meaning a node of a superior nature.

Turning to whether the evidence shows that the use of the combination is sufficient to render the mark distinctive, I have considered the evidence lodged showing sales of goods under the mark. I note that the sales figures under the mark are impressive, particularly those in 1992. However, I think that, to attempt to prove a case of acquired distinctiveness through use for such a descriptive term, the period of use and revenue generated would need to be very considerable. Whilst I concede that the evidence shows an increasingly large volume of sales, I cannot agree that this is sufficient to overcome the inherent non-distinctiveness of the mark. I therefore am unable to find that the mark qualifies for Part B registration, even on the basis of evidence of use.

**Conclusion**

Given the foregoing, I find that the word SUPERNODE is descriptive of the applicant's goods, could be required for use by other traders, is non-distinctive and incapable of becoming distinctive. The mark therefore does not meet the requirements of s.25 of the Act and I am not willing to accept the mark in Part B of the Register. Accordingly, I refuse the application.

Ian Forno  
Hearing Officer

11 April 1994