



TRADE MARKS ACT 1955

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

Re: Application number 553869 to register a trade mark in the name of THE AUSTRALIAN POSTAL CORPORATION trading as AUSTRALIA POST

Application number 553869 was lodged by THE AUSTRALIAN POSTAL CORPORATION trading as AUSTRALIA POST (the applicant) on 16 April 1991. The application covered the statement of goods subsequently amended to "Mail services in this class including airmail services and delivery of mail by postmen," and was for the mark as shown below:



An examiner's report of 21 September 1992 objected to registration of the mark, under paragraph 24(1)(c),(d) and (e) of the *Trade Marks Act*, that the mark was not an invented word or words, referred directly to the services of the application and was not distinctive. This was because the main feature of the mark consisted of the words ECONOMY AIR, which referred directly to the services as being the delivery of correspondence at an economy rate and by air. The other material in the mark was deemed not sufficiently distinctive to meet the requirements of section 24. The applicant's attorneys, Griffith Hack & Co., patent and trade

mark attorneys, Melbourne, requested that the mark be transferred to Part B of the Register and proposed an endorsement disclaiming the exclusive use of the words ECONOMY AIR. The attorney then submitted that the mark was, when considered as a whole, at least capable of becoming distinctive and was registrable in Part B subject to the suggested disclaimer. The examiner responded to these submissions by raising an objection under section 25 of the Act, stating that the overwhelming and predominant feature of the mark was the words ECONOMY AIR, which were a perfectly apt and normal description of the applicant's services and would quite legitimately be required by other traders. The other material in the mark contributed little to the overall distinctiveness of the applicant's mark and was not sufficient to render the mark distinctive, or capable of becoming distinctive, of the services of any one trader. The applicant submitted evidence of use to show that the mark had the capability of becoming distinctive and asked for reconsideration of the matter. Following re-examination, the examiner advised that, although the evidence showed that the revenue derived from the applicant's services was substantial, the mark which was shown in that evidence had only been in use for six months prior to lodgment of the application. However, this mark differed from the mark as lodged. This meant that the version of the mark shown in the evidence alone could be considered capable of becoming distinctive. She said that the application was registrable in Part B but only if the mark was amended to accord with demonstrated use, and with endorsements which read:

Registration gives no right to the exclusive use of the words ECONOMY AIR

Registration is limited to the colours BLUE, GREEN AND WHITE, as depicted in the representation attached to the application form

The applicant's attorney replied, asking the examiner to withdraw the requirement for the colour endorsement as it was not in the public interest. He said that it was not required in the present situation as it was usual for trade marks to be presented in colour and only in special circumstances was it thought that colour would result in the distinctiveness of a trade mark. The attorney additionally dismissed any differences in the marks in evidence and as lodged, saying

that the differences were not significant. In her fourth report, the examiner maintained her requirement for a colour endorsement. She said that the mark as lodged was considered to be almost totally lacking in any inherent distinctiveness and, when shown in black and white, was dominated by the words ECONOMY AIR. However, it was shown by the evidence that, when depicted in colour, this added considerably to the inherent distinctiveness of the mark in that it clearly added a dimension or "idea" to the mark. She said further that, as the mark could be accepted only on the basis of the evidence of use and as this material showed the mark in the form of the words ECONOMY AIR and the arrow and line device alone, the applicant's consent was required to delete the additional material of the words AUSTRALIA POST and the P device. The applicant's attorney then sought a decision on the written record in the matter, making some further submissions and waiving the applicant's right to a hearing.

Discussion

Registrability of a mark in Part B of the Register depends upon whether it will, at some time in future, satisfy the requirements of sub-section 26(2), either by inherent distinctiveness, or by a combination of inherent adaptability and distinctiveness in fact (see *Burger King Corporation v. The Registrar of Trade Marks* (1974) 128 CLR 417) (the *Whopper* case). As Gibbs J explained at 424:

"...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 subsection requires two matters to be considered, inherent ability to distinguish and distinctiveness in fact acquired by use or otherwise.

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 should be denied - see, for example, *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511, (the *Michigan* case).

The mark comprises the words ECONOMY AIR, a line and arrow device, and the much smaller elements of the stylised letter P beside the words "Australia Post". I must agree with the examiner that, apart from any other considerations regarding the registrability of the major elements in the mark, those latter features are so small that they contribute little to the overall distinctiveness of the mark. This was conceded by the applicant in seeking their retention in spite of the examiner asking for their removal following her consideration of evidence to show distinctiveness in fact. Although they were included in the mark as lodged and not in the mark shown in the evidence, the applicant said that the evidence of use was clearly relevant to the mark applied for. However, as the Registrar has been asked to determine the mark's registrability on evidence of use which does not include such features, I think that such a deletion is warranted as it would make clear the facts on which the Registrar's discretion is exercised and would prevent any misunderstandings.

The mark featured in the evidence is in the colours of blue, green and white, and comprises the words ECONOMY AIR, in white, in the blue portion of a rectangle separated from the bottom green portion by a white line and arrow head device. When the mark is considered in its black and white version, as shown in the application form, I am of the opinion that it has minimal inherent distinctiveness. Any trader in like services should be able to describe them as "economy air" services and the only other material in the mark, being the line and arrow device, and the very small words "Australia Post" and the P device, does not add enough, in my opinion, to make the mark registrable. I consider that it has very little in the way of "getup" and is, prima facie, not registrable - even in Part B of the Register. However, the evidence does show that the mark, in the form shown there, has had very substantial use, both in revenue generated and in advertising expenditure - albeit only for around six months prior to lodgment. I take the attorney's point regarding the admissibility of evidence after lodgment in assessing the mark's registrability. However, it is well established that it is the state of play as at the date of

filing which is crucial to Part A eligibility, and any other material concerning use after lodgment can only be considered for Part B registration. In balancing any factual distinctiveness against the mark's inherent inadaptability to distinguish in its black and white form, I am swayed by the added dimension which the colours give the mark portrayed in the evidence. I am convinced that it is this element which tips the balance in making that mark at least capable of becoming distinctive.

Decision

As a consequence, of the foregoing, I am only prepared to accept the mark in Part B of the Register on the basis of evidence of use and only under the following conditions:

The applicant should consent to delete the material comprising the words "Australia Post" and the P device, and agree to following endorsements:

Registration gives no right to the exclusive use of the words ECONOMY AIR

Registration is limited to the colours BLUE, GREEN and WHITE, as depicted in the representation attached to the application form

I allow the applicant 21 days from the date of this decision to agree to these conditions or I will issue my final decision refusing the application.

Ian Forno
Hearing Officer

25 July 1994