



## TRADE MARKS ACT 1955

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

**Re:** Application number 561839 to register a trade mark in the name of BARKER HARLE ENGINEERS PTY. LTD.

Application number 561839 was lodged by BARKER HARLE ENGINEERS PTY. LTD. (the applicant) on 16th August, 1991 for the statement of services: "services relating to building inspections and reporting thereon" in class 42.

The series of marks of this application is shown below:



I will refer to the series of the applicant's marks as the mark.

In an examiner's report of 11th November, 1992, an objection was raised to registrability of the applicant's mark in terms of paragraph 24(1)(e) of the Act based on the mark consisting of a "correct" symbol which other traders were equally entitled to use to indicate their similar services; the fact that the mark also contains an outline of a house was not sufficient to render

the mark in its entirety distinctive. The application was amended to Part B of the Register following a request, accompanied by some examples of the mark in use, from the applicant's attorneys, Spruson & Ferguson, patent and trade mark attorneys, Sydney. This amendment attracted an objection in terms of section 25 that the mark was not capable of becoming distinctive, and a comment that from the examples provided the mark did not appear to have trade mark significance. Responding to the examiner's objection, the attorneys provided further material concerning use of the mark, arguing that the mark was not common to the trade, and that other traders would not be entitled to its use in view of the applicant's extensive use of the mark. They further submitted that the use of the mark in proximity to the name of the applicant's business or other trade marks of the applicant was irrelevant as to whether the mark was entitled to registration. In the examiner's opinion, these submissions with the evidence, failed to overcome the objection. She reiterated that the mark did not have any trade mark significance in its own right and referred to the "tick" device being non-distinctive which, surrounded by the outline of a house or a building, made the mark totally non-distinctive in relation to the nominated services. Subsequently, the applicant's attorneys waived the applicant's right to a hearing and requested a decision on the written record. They also lodged further submissions and a statutory declaration of Mr. Robert Bruce Barker on use of the mark, stating that the mark was not only distinctive, but also served to distinguish the applicant's services from those of other traders. By referring to D.R. Shanahan's *Australian Law of Trade Marks and Passing Off* and *Re Application by Kenner Parker Toys Inc.* (1988) 13 IPR 29, the attorneys stated that although the applicant's mark was used together with words, such as "Pink Slip Building Reports", or other marks, this factor did not detract from its ability to function as a trade mark in establishing a connection in the course of trade between the applicant and the services offered under the mark. The examiner's contention that the mark was descriptive, was also unsupportable, they further submitted, because in light of *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (1956) 95 CLR 190, the mark contained only some "cloudy suggestion" of some characteristic or attribute of the applicant's services.

It is well established that for a mark to be suitable for registration in Part B, the mark's inherent distinctiveness must be weighed against factual distinctiveness. In *Burger King Corporation v. Registrar of Trade Marks* (1973) 128 CLR 417, referring to sub-section 26(2) Gibbs J. explained at p. 424:

"That subsection requires two matters to be considered, inherent adaptability to distinguish and distinctiveness in fact acquired by use or otherwise. When the question is whether the trade mark is capable of becoming distinctive, no difficulty arises about the nature of the inquiry so far as concerns the second of these matters; the inquiry becomes whether the trade mark is capable in fact of distinguishing the goods by reason of future use or other circumstances. However, as to the first matter the inquiry remains the same as that which is to be made when the issue is whether the trade mark is distinctive, that is, whether the trade mark is inherently adapted to distinguish the goods. Inherent adaptability is something which depends on the nature of the trade mark itself (see *Clark Equipment Co v. Registrar of Trade Marks* (1964) 111 CLR 511 at 515) and therefore is not something that can be acquired; the inherent nature of the trade mark itself cannot be changed by use or otherwise."

To determine whether a mark is adapted to distinguish, I must consider whether or not the mark is of such nature that other traders are likely to desire to use it, without improper motive, in connection with similar goods "in any manner which would infringe a registered trade mark granted in respect of it" - *Clark Equipment v. Registrar*, supra, at p. 514.

In *The Macquarie Dictionary*, a tick is described, inter alia, as a "small mark ... serving to indicate that an item on a list, etc. has been noted or checked, or to indicate the correctness of something". Indeed, I think no one will deny that a tick device has acquired a universal significance of indicating approval, correctness or agreement with something. In the mark under consideration this well recognized symbol occupies a prominent part in the centre of an unmistakable contour of a house or a building. When used in conjunction with building inspection services and reporting services following such inspections, the combination of a tick device - the tick indicating some attribute or characteristic which the services possess - together

with an outline of a house or a building, cannot be regarded as a distinctive mark, nor one which is capable of becoming distinctive under the provisions of section 25 of the Act. Being of such nature, the mark is ideally suited to the particular services the applicant is offering, and is a device which other traders are likely to wish to adopt for use in connection with similar services. In light of *Clark Equipment v. Registrar* case, supra, therefore, the mark is devoid of any adaptation to distinguish. Consequently, the applicant's mark is one which neither belongs to the category of marks which, although comprising two non-distinctive elements when those elements are combined, the combination thereof would render the mark distinctive as a whole (see *Diamond T. Motor Car Company's Appn.* (1921) 38 RPC 373), nor is it analogous to the mark TUB HAPPY in *Mark Foy's v. Davies Coop*, supra, referred to by the attorneys, which was found not to "convey any meaning or idea sufficiently tangible to amount to a direct reference to the character of quality of the goods" as per Dixon J. at p. 195.

Turning to the applicant's evidence in form of a statutory declaration, with exhibits, by Robert Bruce Barker, a director of the applicant company, I note that the subject mark was first used in Australia in respect of the nominated services in 1990, the value of the services totalling approx. \$172,481 and the expenditure for advertising amounting to approx. \$10,506. The descriptive and non-distinctive nature of the mark is clearly illustrated in exhibit "A" of Mr. Barker's declaration confirming the examiner's contention that the mark appears together with the words "Pink Slip BUILDING REPORTS", the device of a tick serving to indicate that certain features of a building are to be checked, or have been checked in order to prepare a comprehensive inspection report relating to any defects and positive aspects of the building.

Being mindful of the principles enunciated in *Burger King* and *Clark Equipment* cases, both supra, as well as my earlier conclusions concerning the non-distinctive nature of the applicant's mark, I believe the amount of use demonstrated by the applicant to be insufficient to establish

that the mark has been rendered distinctive in fact of the services in question. I have also commented that the manner of the mark's use even enhances the descriptive nature of the mark.

I find, therefore, that the mark fails to qualify in terms of section 25 of the Act. Consequently, the mark is not registrable in Part B of the Register, and I refuse this application.

Vija Zars

Acting Hearing Officer

8 August 1994