



## **TRADE MARKS ACT 1955**

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

Re: Trade mark application number 562031 in the name of THE SUNRAYZIA NATURAL BEVERAGE COMPANY PTY LTD

Application number 562031 was lodged by THE SUNRAYZIA NATURAL BEVERAGE COMPANY PTY LTD (the applicant) on 22 August 1991 for the statement of goods, "Fruit juice; soft drink; mineral water and all other goods in this class", in Class 32, for the mark, FRUIT JUICE GOURMET.

An examiner's report of 18 November 1992 objected to the mark's registration under s.24(1)(c), (d) and (e) that the words in the mark referred directly to the character or quality of the goods of the application. An objection was also raised under s.33 that the mark was substantially identical to trade mark application number B547300 which has been accepted for the mark, FRUIT GOURMET. That application has since been registered with a disclaimer of the exclusive right to the word GOURMET and has been assigned to the present applicant. The objection under s.33 is therefore no longer valid. The applicant's attorney, Griffith Hack & Co, replied on 19 August 1993, requesting that the application be transferred to one in Part B of the Register and arguing that the application was registrable in that Part as it was at least capable of becoming distinctive of the applicant. The attorney further directed the examiner to the submissions made in relation to the cited application which was, by this time, owned by the present applicant. In that instance, the attorney had submitted that the words FRUIT GOURMET did not have any particular meaning which other traders would legitimately wish to use. The examiner, in her second report of 28

September 1994, advised that the present application had been amended to one in Part B. However, she then raised an objection under s.25 of the Act, saying that, despite the attorney's submissions made in respect of the earlier application, the reasons for the acceptance of that mark did not apply in the present instance. In that case, the mark applied for was FRUIT GOURMET which covered all goods in Class 32. That class included beverages and not whole fruit. However, the word GOURMET was disclaimed, as it was considered a non-distinctive part of the mark. The examiner said that, in the present instance, the mark directly described the quality of fruit juice which was included in the specification of goods. Hence, the mark was not capable of distinguishing the goods from those of other traders. The attorney replied on 22 October 1993 and offered, on the applicant's behalf, to disclaim the word GOURMET. He argued that the mark, as a whole, did not contain direct reference to the character or quality of the goods of the application. He said that the mark, if anything would describe a person, and not fruit juice. He further asserted that the words were not conventionally used in conjunction with fruit juice, as that item was not normally associated with gourmet dining. The examiner, in her third report, maintained the objection, saying that use of the word GOURMET could be considered as hyperbole which is commonly used to promote goods. It followed that its use in conjunction with fruit juice was considered a laudatory term and incapable of registration. The attorney then sought a decision on the written record, waiving the applicant's right to be heard in the matter.

## **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*, (1973) 128 CLR 417, (the *Whopper* case) 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 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 will generally be denied - see, for example, *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511, (the *Michigan* case).

The mark, FRUIT JUICE GOURMET, is a combination of the name of the goods and a word which the *Macquarie Dictionary* defines as: "*a connoisseur in the delicacies of the table; an epicure...*". The word GOURMET is also used, to my own knowledge, as an adjective to describe something as being as being of a high culinary standard, e.g. "gourmet wines", "gourmet platter" or "gourmet cheeses". The crux of the matter, then, is the degree of descriptiveness of the word GOURMET in relation to the goods of the application and whether its combination with the words FRUIT JUICE is sufficient to give the mark, as a whole, the capacity to become distinctive.

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 Class 32 goods as being of the high standard demanded by gourmets and would wish to use the combination of the words for their goods in conjunction with GOURMET as an advertising strategy. The public is used to such advertising puffery and would understand that kind of phrase as a colourful means of expressing the traders' desire to present the very best goods for sale. As to whether the word GOURMET can be applied to fruit juices, I note that the word is currently used in conjunction with many food items in advertisements on television, radio and in print - from cat food to sausages - so its use with food or drink items not usually associated with fine dining is fairly common. I cannot accept that, because a mark is hyperbolic it is not directly descriptive. A term does not fail to be descriptive merely because it exaggerates. It seems to me that a trader's claims about his goods or services, albeit fanciful, is a claim that others may wish to make and should be free to do so. I therefore find that the combination of the words FRUIT JUICE and GOURMET is not so unusual as not to be legitimately required by other traders to describe their own like goods.

In the case of the applicant's registered mark number 547300, FRUIT GOURMET, the application was accepted in Part B of the Register with a disclaimer of the exclusive use of the word GOURMET because it was considered that the word FRUIT did not *directly* refer to the Class 32 goods covered by the application. Therefore, the mark was capable of satisfying the less stringent requirements of Part B as this indirectness meant it was likely to become distinctive. In the present instance, the word GOURMET, which the applicant previously conceded as being non-distinctive and accordingly disclaimed in the case of FRUIT GOURMET, is combined with the name of the goods. I do not think that reversing the order of the words gives the mark any degree of distinctiveness and it is my opinion that the phrase FRUIT JUICE GOURMET is every bit as non-distinctive as GOURMET FRUIT JUICE. It is therefore, as a whole, incapable of becoming distinctive of the applicant's goods.

Turning to whether the mark's acceptance in Part B could be assisted by evidence of use, I note that no sales or advertising figures have been lodged in an attempt to show whether it might be capable of becoming distinctive. However, I think that any attempt to prove a case of acquired distinctiveness through use for such a non-distinctive term would be insufficient to overcome the mark's inherent non-adaptability to distinguish. I therefore am of the opinion that the mark would not qualify for Part B registration, even on the basis of evidence of use.

### **Conclusion**

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

Ian Forno  
Hearing Officer

20 April 1994