



## TRADE MARKS ACT 1955

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

**Re:** Application number 563521 to register a trade mark in the name of S.C. JOHNSON & SON, INC.

Application number 563521 was lodged by S.C. JOHNSON & Son, INC. (the applicant) on 11th September, 1991 for the statement of goods "carpet and room deodorisers" in class 5. The applicant sought registration of the mark SHAKE 'N VAC.

In an examiner's report of 20th November, 1992, an objection to registrability of the mark was raised in terms of paragraphs 24(1)(c), (d) and (e) of the Act, because the words "are directly descriptive of powder room and carpet deodorisers which are shaken onto carpets and upholstery, any residue then being vacuumed up". The applicant responded by amending the application to Part B of the Register, lodging a statutory declaration by Ms. Debbie Schubert, senior product manager, of S.C. Johnson & Son Pty. Limited, the applicant for a registered user, concerning use of the mark, and by submitting that the mark was at least capable of becoming distinctive through use. In support of the argument, the applicant referred to *Joseph Crosfield & Sons Ltd's Appn.* (1909) 26 RPC 837 and *J. & P. Coats Ltd's Appn.* (1963) 53 RPC 355. On considering the evidence, the examiner issued a further report advising the applicant that the subject mark lacked inherent distinctiveness which could not be overcome by any amount of evidence of use. In his opinion, the case of *Joseph Crosfield*, supra, reinforced his argument, while that of *Coats*, supra, was not relevant in the particular instance. Subsequently, the applicant requested a hearing.

The hearing was conducted in Sydney on 6th July, 1994. Mr. Gerard Skelly of Spruson & Ferguson, patent and trade mark attorneys of Sydney, attended on the applicant's behalf.

Mr. Skelly commenced his submissions by expressing doubts that the applicant's mark had a direct reference to the character or quality of the specified goods. Given the value of the goods, being approx. \$2.00 to \$3.00 each item, and the number of units sold since the first use of the mark in November, 1991, the mark was adapted in fact to distinguish by virtue of its use, he contended. With reference to the proposition that the mark was used with the word GLADE, Mr. Skelly explained that the mark GLADE functioned as a house mark for a whole range of the applicant's similar products, which was not detrimental to the present case, because the members of the public were accustomed to seeing more than one mark on a label. He directed me to *Kenner Parker Toys Inc.* (1988) 13 IPR 29, asserting that the applicant was clearly using SHAKE 'N VAC as a trade mark in relation to the subject goods.

He then commented that in a decision on application No. 282761 for the mark SPRAY n' VAC, a mention had been made of the commonness of 'n' as an abbreviation for "and", and "vac" as being commonly used for the word "vacuum". This, according to Mr. Skelly, did not detract from the mark's distinctiveness as a whole, as evidenced by registration B487928 of the mark ULTRAVAC. Considering the dictionary definitions of the word SHAKE, he submitted that more apt words for describing any method of application or dispersal would be "scatter", "sprinkle", or "spray", and in this regard the applicant's mark could be distinguished from such cases as *"Wipe-On" Trade Mark* (1955) 25 AOJP 1630 and *Kimberley-Clark Corporation v. The Registrar of Trade Marks* [1962-1963] 109 CLR 526 (POP-UP). Furthermore, he said, the word SHAKE in the mark referred to the container, and only indirectly to the goods.

He believed that in view of the established valuable reputation of the mark SHAKE 'N VAC, the likelihood of other traders desiring to use the same words, which would infringe the

registration of the mark, would be extremely remote. The applicant would be prepared to consent to an appropriate form of a disclaimer, but he queried the necessity to disclaim the word SHAKE, given that other words for the same purpose were available to the traders, equating the applicant's mark with the marks CHUNKY and SHEEN considered in the cases "*Chunky*" Trade Mark [1978] FSR 322 and *J. and P. Coats*, supra.

As to whether a mark is registrable in Part B of the Register, one must decide whether it is capable of meeting in the future the tests stipulated in sub-section 26(2) concerning inherent adaptability to distinguish and distinctiveness in fact (see *Burger King Corporation v. Registrar of Trade Marks* (1973) 128 CLR 417). If a mark lacks inherent distinctiveness, then no amount of distinctiveness in fact will render the mark registrable, because as stated by Gibbs J. in *Burger King*, supra, at p. 424:

"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 - 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 decide the mark's adaptability to distinguish, it will be necessary to consider whether other persons "trading in goods of the relevant kind and being actuated only by proper motives ... will ... want to use [the mark] in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it", in the words of Kitto J. in *Clark Equipment* case, supra, at p. 514.

Mr. Skelly did not dispute the non-distinctive nature of the abbreviations 'N and VAC in the subject mark. The main thrust of his argument concentrated on the word SHAKE which, he submitted, did not have a direct reference to the goods in question. By quoting one of the definitions of the word from *The Macquarie Dictionary*: "1. to move or sway with short, quick, irregular vibratory movements", he observed that to shake something would hardly be a desirable way of applying something with force or vibration, and that other words would more adequately describe the dispersal of the contents from a container. By consulting two other standard dictionaries, however, I note, inter alia, the following meanings of the word:

"11. to dislodge or dispense (something) by short, quick forcible movements of its support or container" (*The Random House Dictionary of the English Language*, 2nd ed.) and "2b: to cause to be moved briskly in order to remove what adheres or is contained"; "8a: to distribute with or as if with a shake; sprinkle"; "8b: scatter" (*Webster's Third New International Dictionary*). Having regard to these definitions of the word "shake" and considering the mark SHAKE 'N VAC in light of the principles enunciated in *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (1956) 95 CLR 190 on what constitutes direct reference, I do not hesitate in asserting that the prospective purchasers of the goods in suit would understand them to be instructions for shaking the carpet and room deodorisers onto a carpet and then vacuuming the surface of the carpet. The contention that the word SHAKE is descriptive of the container, but not of the goods does not weigh in the applicant's favour, because in *Samuel Taylor Proprietary Limited v. The Registrar of Trade Marks* (1959) 102 CLR 650 it was found that, if a mark is considered to be directly descriptive of the manner in which the goods are dispensed, then the mark is equally descriptive of the goods contained therein.

In light of my previous comments, I am unable to agree with Mr. Skelly's submissions in relation to the word SHAKE, and conclude that the subject mark is on par with the directly descriptive marks WIPE-ON and POP-UP, *supra*, which failed to qualify for registration.

The applicant's evidence in the statutory declaration by Debbie Schubert, *supra*, discloses use of the mark in Australia since the date of lodgment of the application, and the sales value of the goods during the period from 1990 to 1992, being \$10,039,000.00 (4,681,920 units). At the hearing, Mr. Skelly advised that the sales of the goods for the period 1993/94 had amounted to \$3.042 million and advertising expenditure had been estimated as \$24,000.00. To Ms. Schubert's declaration, under exhibit "MS1" are annexed three containers showing labels for different scents of the deodoriser and a prominent rendering of the subject mark. Directions on the containers instruct the user to "1. Shake lightly over the carpet; it is not necessary to

cover carpet completely. 2. Ensure you always vacuum with an empty dust collection chamber"; these two steps are also graphically illustrated by depicting a hand shaking the powder out of the container and a vacuum cleaner vacuuming the powder off a carpet. In this regard, I note that the purpose and use of the room and carpet deodorisers reaffirms the examiner's contention concerning the highly descriptive nature of the words SHAKE 'N VAC.

While I concede that the applicant's mark has experienced significant exposure in the market place, given the small unit price of the goods, I must conclude that the subject mark is most appropriate for normal description and as such will be required for use by other traders in connection with their similar goods. Being mindful of the principle that if the mark is simply a descriptive epithet, registration of it must be refused, despite evidence of use establishing distinctiveness in fact of the mark in respect of the applicant's goods (see *Burger King*, supra), I find that the mark is not registrable in Part B of the Register.

Accordingly, I am obliged to refuse this application.

Vija Zars  
Senior Examiner  
9 September, 1994