



TRADE MARKS ACT 1955

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

Re: Opposition by S.C. JOHNSON & SON, INC. to registration of trade mark application number 571256 in the name of RECKITT & COLMAN (OVERSEAS) LIMITED

Background

As set down in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this application. Accordingly, unless otherwise specified, the authority I refer to is the 1955 Act.

Application number 571256 was lodged, on 24 January 1992, in the name of RECKITT & COLMAN (OVERSEAS) LIMITED (the applicant). The application was for registration of the word mark WILD FLOWERS, for a statement of goods subsequently amended to read, "Air freshening preparations for hygiene purposes", in Class 5. The mark was advertised as accepted in the *Official Journal* of 10 March 1994.

Notice of opposition to the mark's registration was lodged, on 12 September 1994, by S.C. JOHNSON & SON, INC. (the opponent). The only ground of the opposition which was pursued at the hearing, was based on s.24 of the *Trade Marks Act 1955* that the mark WILD FLOWERS was descriptive and non-distinctive and was accordingly not suitable to function as a trade mark of the relevant goods.

The evidence

The service and lodgment of evidence in support and evidence in answer was completed by 12 February 1996. That evidence comprised:

Evidence in support

- * Statutory declaration by Kenneth James Douglas dated 9 January 1995 and exhibits A to D

Evidence in answer

- * Statutory declaration by Ross Pearson dated 21 July 1995 and exhibits RP.1 and RP2

In the declaration forming evidence in support, Mr Douglas, the managing director of the opponent, exhibited a brand file listing prepared by A.C. Nielsen Australia Pty Limited which he said listed many WILD FLOWER marks. He included, as exhibits, samples of the opponent's goods bearing, inter alia, the term, WILD FLOWERS used in a descriptive sense, and also particulars of a registration of those words in Australia, registration number A430073 in the name of Cussons Pty Limited for goods in Class 3.

The applicant's evidence in answer comprised the declaration by the marketing director of the applicant's licensee in Australia, Mr Pearson. He disputed the inference drawn from the Nielsen report, saying that many manufacturers used the term, WILD FLOWER descriptively and that the present registration would not preclude them from doing that. He also disputed several other claims made in the Douglas declaration. He included, as exhibits, details of foreign registrations of the words WILD FLOWERS and what, he said, was the co-existence of a number of Australian trade mark registrations and applications bearing those words.

The matter was set down before me, as the Registrar's delegate, for hearing in Sydney on 12 July 1996. The opponent was represented at the hearing by Ms Joanne Martin, of Spruson & Ferguson. Appearing on behalf of the applicant was Mr Paul Whenman of F.B. Rice & Co.

Submissions

Ms Martin said that the opponent wished to argue three points with respect to its opposition. These were, firstly, that the mark was a term in common use with a clear meaning in respect of the goods and was one which any trader might wish to use for like goods. Secondly, because of the suitability of the words WILD FLOWER to describe the scent of the goods, it was a term which others might wish to use and was thus not inherently distinctive and was not capable of becoming so. Lastly, the fact that there was an earlier registration of those words as a trade mark in Class 3 did not establish grounds for the acceptance of the present application in Class 5.

Ms Martin referred to dictionary listings of the words comprising the mark, saying that the mark described the goods as having the scent of a wild and uncultivated flower. She said that other traders might wish to use such a descriptive term for their own goods, referring here to *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511 - *Michigan* - and *Mark Foy's Ltd v Davies Coop & Co Ltd* (1956) 95 CLR 190 *Tub Happy* - cases for support. She said that the applicant should not be able to appropriate the words in the mark for its own use, thus impinging on the legitimate trading activities of others. She submitted that it was uncertain what rights the applicant would gain from the registration of such a descriptive term for the present goods.

Ms Martin said that the words WILD FLOWERS were descriptive and non-distinctive as at the time of application, and that it was untrue that there was no identifiable scent which could be attributed to wild flowers. She said that there were sophisticated methods for blending and defining scents available for precise identification. However, to the layperson, all references to scents or smells were subjective and in the present case, a reference to WILD FLOWERS would indicate some sense of the scent it was trying to convey. She said that, in this country, there was a move away from the "traditional" English floral scents to native Australian wild flowers for such goods as essential oils and air fresheners, and the words in the mark were thus very apt for description of the goods.

Ms Martin said that there was an overlap between goods contained in Class 3 and Class 5 and, for this reason, traders in Class 3 goods usually sought to gain acceptance for their marks in Class 5. She said that, accordingly, the acceptance of the present mark in Class 5 was surprising, given the presence of the same mark in Class 3 on the Register. She submitted that, despite the previous registration of WILD FLOWER for Class 3 goods, this was not conclusive of the registrability of the present application. She said that the Registrar was not bound by previous registrations of similar marks, relying here upon Office decisions in *Re: Courtaulds Textile (Holdings)* 1994 30 IPR 635 and *Re: Fischer Pharmaceuticals* 30 IPR 583 to support this proposition.

She concluded her submissions by seeking costs in the matter in favour of the opponent.

In his submissions in reply, Mr Whenman said that he had prepared a case in answer to all of the points listed in the notice of opposition but would limit his responses at the hearing to only the matters raised by Ms Martin - principally the alleged lack of distinctiveness under s.24. He said that the brand file listing of the term, WILD FLOWERS, in use in the market place, was not of any assistance to the opponent's argument as it did not show if the products listed were offered for sale prior to the filing date of the present application. He said that, in any case, even if a word could be used in a descriptive fashion, this did not prevent that word functioning as a trade mark, or being distinctive of a proprietor's goods. He said that traders in like goods, making proper and honest descriptive use of the words WILD FLOWERS, would not be prevented from their continued use if the present mark was registered. Indeed, the opponent, by its own admission, had not been obstructed in using the words descriptively and this use was still continuing.

He said that there was a number of responses to the question, "What is a wild flower scent?" He said that, to Australians, the answer could be any number of smells. There was no clearly identified wild flower smell, making any answer extremely subjective.

With respect to the acceptance of the present mark in the face of a Class 3 registration, Mr Whenman said that this question had been fully argued during examination. He said that,

once the statement of goods of the present application had been restricted, as per the examiner's suggestion, the possibility of confusion between the two marks had been negated. In any case, the registrability of both marks had been decided separately. The goods of the present application and those of the Class 3 mark were not displayed or sold together and they were different in the minds of consumers.

Mr Whenman further said that the opponent had not submitted any evidence to support its contention that the mark, when applied to the present goods, was not sufficiently distinctive to qualify for registration.

He concluded his submissions by seeking costs in favour of the applicant.

Discussion

Section 24 - Distinctiveness

Section 24 (1) of the Act reads:

A trade mark is registrable in Part A of the Register if it contains or consists of-

- (a) the name of a person represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his business;
- (c) an invented word;
- (d) a word not having direct reference to the character or quality of the goods or services in respect of which registration is sought and not being, according to its ordinary meaning, a geographical name or a surname; or
- (e) any other distinctive mark.

Under the 1955 Act, the basic requirement for the registration of any trade mark in Part A is that it is distinctive, i.e. adapted to distinguish the goods of its owner from the similar goods of other traders. 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 - *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511.

The mark applied for here is the words WILD FLOWERS. I agree with Ms Martin that the evidence shows that the term is one which has been used in a descriptive sense by other traders - although when they first started doing so is unclear. However, I would not agree that it is a commonly used combination. This could be because of the imprecise nature of the term, which allows each user to draw a different meaning from the words. It is not, in my opinion, apt for normal description. There are other, less-ambiguous, terms which could be used - such as BORONIA, STURT'S DESERT PEA or WATTLE. As Ms Martin quoted from Dixon C.J. in the *Tub Happy* case, supra:

The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess

I do not think that "ordinary persons" would be able to say what, particularly, was a wild flower smell. Indeed, to my own untutored nose, the WILD FLOWER and WILD BOUQUET scents of the two exhibits attached to the opponent's evidence are quite different. Wild flowers might well have a variety and combination of smells. I am sure that Australian wild flowers have different aromatic attributes than do English or American ones. However, there is no particular scent, that I am aware of, which one could, without equivocation, identify as being the one derived from wild flowers.

As I have said, despite that the fact that other traders might use the words, WILD FLOWERS as a descriptor, I think that is only an allusion and not an accurate or easily defined way of referring to the goods. Such use is, in my estimation, not fatal to the present application for registration. I do not think that the present mark's registration would deprive other traders of the right to use those words in a suggestive way. I think that no tangible meaning can be inferred from the mark and traders who wish to suggest that their goods have a WILD FLOWERS scent will continue to have the right to do so. What they will not be able to do, if the mark proceeds to registration, is to use those words as a trade mark for the relevant goods.

I agree with Ms Martin that the Registrar is not bound to follow earlier registrations in deciding the registrability of a particular mark. The fact that the phrase WILD FLOWERS

has been previously registered as a trade mark in Class 3 has not influenced me in deciding that the present mark is a registrable one in its own right. Each case should, of course, be considered on its own merits and, in the present instance, I must agree with the examiner that the mark is registrable under s.24 of the 1955 Act. As I have previously said, there being no identifiable wild flower scent, those words are suggestive only in relation to the present goods.

Decision

The opponent did not produce evidence with respect to the other grounds listed in the notice of opposition and Ms Martin did not pursue them at the hearing. I have therefore not considered them in coming to a decision in the matter. However, I have decided that the opponent has failed in its opposition under s.24, that the mark is not distinctive of the applicant. I therefore dismiss the opposition in total and, subject to any appeal from this decision, direct that the mark should proceed to registration. I can see no reason why costs should not follow the result and I accordingly award costs in the matter to the applicant.

Ian Forno
Hearing Officer

2 August 1996