



## **TRADE MARKS ACT 1955**

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

Re:- Application number 581434 to register a trade mark in the name of  
Evenglen Pty Limited t/a Mister Plywood

On 30 June, 1992 Evenglen Pty Limited t/as Mister Plywood (the applicant) lodged an application to register the word FLAMESAFE as a trade mark in part A of the Register. The application sought the registration in class 20 in respect of 'notice boards for school, home and office use; display boards and panels; decorative panels; building panels and all other goods included in this class;

In the first report on the application the examiner objected in terms of paragraphs (c), (d) and (e) of sub-section 24(1) of the Act that the mark was 'a combination of the words FLAME SAFE which refer directly to the character or quality of your goods describing them as fire-resistant or fire-proof'.

In response, the applicant's attorneys requested amendment to part B of the Register and amendment of the specification of goods to read: "Notice boards for school, home and office use; display boards and panels; and all other goods included in this class". The attorney submitted that the combination of the words FLAME and SAFE did not appear in any dictionary and although each word, separately, did have a distinct meaning, the combination FLAMESAFE had no apparent meaning.

The examiner amended the application as requested but maintained the objection in terms of s 25 of the Act, asserting that, to the average Australian consumer, the mark would immediately indicate that the manufacturer's goods were flame-proof or flame-retardant.

In answer, the attorney lodged evidence outlining use of the trade mark by the applicant; this use extended over a one year period. Again, the attorney submitted the combination of the words was not descriptive, although it may allude to the goods. The attorney maintained that the word was not an apt description of the goods and no other trader would, without improper motive, wish to use it in relation to similar goods.

Although the attorney requested the specification of goods to be amended to 'notice boards for school, home and office use; display boards and panels, all of the foregoing goods being made of or comprising flame retardant material', the examiner maintained the objection whereupon the attorney requested that the matter be set down for a hearing.

The matter was scheduled to be heard in Sydney on Monday, 4 July, 1994. As no one appeared for the applicant and no written submissions were lodged I, as the Registrar's delegate, must decide the matter from the material on file.

### **Considerations .**

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 (refer comment of Gibbs J in *Burger King Corp v. Registrar of Trade Marks* (1973) 128 CLR 417 at 424).

In relation to the question of whether a mark is adapted to distinguish, in *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511 at 514, Kitto J has pronounced the following criterion:

{the question is to} be tested by reference to the likelihood that other person trading in goods of the relevant kind and being actuated only by proper motives - in the exercise, that is to say, of the common right of the public to make honest use of the words forming part of the common heritage, for the sake of the signification which they ordinarily possess - will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

The mark in question is a combination of the words FLAME and SAFE. The word FLAME is defined in the Macquarie Dictionary as, inter alia, 'state or condition of blazing combustion; to burst into flames'; the word SAFE is defined as, inter alia, "secure from liability to harm,

injury, danger or risk". I cannot but agree with the examiner that, whether or not the words are run together to form one word, there is a direct meaning conveyed: that the goods in connection with which the mark is used are fire-resistant or flame-proof. I do not find any great invention in this combination and cannot agree with the attorney that 'no other trader without improper motive would want to use the mark to indicate goods'.

Having decided that the mark FLAMESAFE has a direct reference to the goods in question and is a combination of words which other traders would legitimately desire to use, I conclude that the mark fails the test of inherent distinctiveness.

Turning to the issue of distinctiveness in fact, I note from the Statutory Declaration made by James Donald Sutherland on 9 November 1993, submitted as evidence of use of the mark, that the mark was first applied to 'notice boards for school, home and office; display boards and panels; building panels' in November, 1992 approximately five months after the date of the trade mark application. Mr. Sutherland states that the annual sales of goods sold under the trade mark for the year 1992/93 amounted to \$49,100. Given the potential market for the type of goods it is difficult for me to conclude on the evidence that the mark might have a capacity through use of becoming distinctive. However, despite any evidence of use, because of its inherent non-distinctiveness, the mark is not capable of becoming distinctive within the meaning of s 25 of the Act (refer *Burger King* case, supra, at 426).

### **Decision**

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

Sharyn Sullivan  
Senior Examiner

8 August, 1994.