TRADE MARKS ACT 1955

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS

Re: Trade mark application number 582820 in the name of MCCAIN FOODS (AUST) PTY LTD

Application number 582820 was lodged by MCCAIN FOODS (AUST) PTY LTD (the applicant) on 22 July 1992 for the statement of goods subsequently amended to read: "Frozen vegetables including frozen potato products", in Class 29, for the mark, MCCAIN FREEZE CHILL.

An examiner's report of 25 September 1992 requested, inter alia, that the applicant agree to the following endorsement as a condition of registration:

> Registration gives no right to the exclusive use of FREEZE CHILL

The examiner explained that he had requested the endorsement because the words FREEZE CHILL formed a descriptive term meaning frozen foods that could be kept in a chilled state rather than frozen. Accordingly, it was not distinctive and should be available for all traders to use in relation to their own similar goods or services. The applicant's attorney, A.Tatlock & Associates, advised that the applicant did not agree to disclaim the words in combination as they were, at most, indirectly descriptive of the applicant's goods and because they were not a combination which others in the industry would wish to use. The attorney said that the expression had not been used by other manufacturers since 1989, when the applicant first commenced use and included a Statutory Declaration by David Boyle, Managing Director of the applicant, to support the claim that the term FREEZE CHILL had become associated

with the applicant. In his second report of 24 June 1993, the examiner advised that he had considered the evidence submitted but still felt that the words in question referred to two methods by which the goods could be stored and so were an apt description of the goods which other traders would wish to use. The examiner then repeated that he would be willing to recommend acceptance only on the condition that the applicant disclaim the words in combination. The attorney then sought a hearing in the matter.

The matter came before me, as the Registrar's delegate, on 9 February 1994. Appearing on behalf of the applicant was Mr Alfred Tatlock. Mr Tatlock said that the applicant was prepared to disclaim the words FREEZE CHILL, separately, as it did acknowledge that those words could have a reference to some characteristic of the goods. However, he said that, when the applicant used the words together in the mark, they were a clever combination and merely allusory. He pointed to the evidence lodged in support of the application which he said showed that the term was used in a trade mark sense by the applicant and that sales of goods under the mark totalled around 23 million dollars. He said that the finding in *Diamond T Motor Co's Appn* (1921) 38 RPC 373 supported his submission that the combination of words was distinctive though the individual elements were common to the trade. The applicant had no objection to others using the words separately to describe their goods but questioned whether anyone would wish to use the combination FREEZE CHILL without improper motive. Mr Tatlock said that the goods of the application were not available for retail but were sold only on the commercial market to restaurants and canteens. Buyers in this specialised market were more aware of such terms than the ordinary buying public. If it was absolutely necessary to gain acceptance of the application without consenting to the endorsement of the words in combination, the applicant would be willing to agree to restrict the goods of the application to those for use in the food service market only.

Decision

For a mark to be registrable in Part A, without evidence, it should qualify in terms of one of paragraphs (a) to (d) of sub-section 24 (1) of the Trade Marks Act. The basic requirement for the registration of any trade in Part A is that it is distinctive, ie. adapted to distinguish the goods of its owner from the similar goods of other traders. Therefore, a mark that appears to satisfy the requirements of one of these paragraphs may still be regarded as non-distinctive.

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 present mark comprises the words MCCAIN FREEZE CHILL. The applicant has achieved acceptance and/or registration for the word MCCAIN in Part A, albeit in stylised form, for the same goods as the present application. However, in these instances, other words which have been considered descriptive of the goods, eg VEGETABLES FOR ALL SEASONS, HEALTHY CHOICE, and SUPERSPIRALS, have all been disclaimed. I am of the opinion that the printed word MCCAIN in the present instance is shown by the evidence to be distinctive of the goods. However, I cannot agree that the combination of the words FREEZE and CHILL is so special as to be likewise distinctive. The applicant's own evidence refers to the goods as being "Dual Storage" which I take to mean that the vegetables in question can be kept ready for consumption in either a frozen or chilled state. I am not convinced that the applicant is the only producer of vegetables in this class which can claim these attributes. Both words are commonly used in the trade to describe the goods of the application. With respect to the degree of invention of their use 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 therefore find that the words in combination have an easily defined meaning and that the combination is not so unusual as not to be legitimately required by other traders to describe their own vegetables which can be stored either frozen or chilled. I therefore conclude that those words fail the test of inherent distinctiveness.

Turning to whether the evidence is sufficient to show distinctiveness in fact of the subject combination, I have taken into consideration the evidence lodged showing sales under the mark. Whilst I agree that the sales figures under the mark are impressive, they only commenced in 1989. I think that, to attempt to prove a case of acquired distinctiveness through use for such a descriptive term, the period of use and revenue generated would need to be considerable. However, despite the consideration of any evidence of use, I feel that the words are so inherently non-distinctive as to disqualify them for registration under s.24 the Act. With respect to the offer to restrict the statement of goods to those available only to the wholesale trade, I am further of the opinion that such a restriction would not assist in rendering the words any more registrable. The words FREEZE CHILL would be equally as descriptive and non-distinctive to those in the trade as to the general public, especially if those qualities were possessed in combination by the similar goods of other traders.

I was not asked to consider the registrability of the words in Part B of the Register but, for the sake of completeness, I find that they also do not qualify for that Part as being likely to become distinctive. 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, 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 sub-section requires two matters to be considered, inherent ability to distinguish and distinctiveness in fact acquired by use or other wise.

I have already found that the words, when used together, lack inherent distinctiveness and therefore, despite any evidence of use, I also find that the combination is not capable of becoming distinctive within the meaning of s.25 of the Act.

Conclusion

Given the foregoing, I find that the words FREEZE CHILL, in combination, are descriptive of the goods, could be required for use by other traders and are, therefore, non-distinctive. Accordingly, I am only willing to accept the application for the mark, as a whole, in Part A or Part B of the Register if the applicant consents to the following endorsement as a condition of registration:

> Registration gives no right to the exclusive use of the words FREEZE CHILL

I allow the applicant 21 days from the date of this decision to agree to the above endorsement, failing which I will issue my final decision refusing the application.

Ian Forno
Hearing Officer

25 February 1994