



TRADE MARKS ACT 1955

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

Re: Application number 588766 to register a trade mark in the name of FISCHER PHARMACEUTICALS LTD.

Application No. 588766 was lodged by FISCHER PHARMACEUTICALS LTD. (the applicant) on 20th October 1992, for the trade mark comprising the letters and words A.P.S. AGE PROTECTION SYSTEM in respect of "medicated skin care preparations", in class 5.

The examiner raised objections to registration of the mark in terms of paragraphs 24(1)(c), (d) and (e) of the Act, stating that the words AGE PROTECTION SYSTEM refer directly to the character or quality of the applicant's goods by describing them as preparations which provide a system of protecting the skin against the effects of aging, and that other traders are equally entitled to use the remaining particulars in the mark, the letters A.P.S. Considering registrability of the mark as a whole, he saw nothing unusual in the way the mark was represented, therefore it was considered to be not distinctive.

By relying on the words of Dixon CJ in *Mark Foys Limited v Davies Coop & Co Limited* (1956) 95 CLR 190, at p 195, the attorneys for the applicant considered the words AGE PROTECTION SYSTEM to be purely emotive and, at best, merely alluding to the character or quality of the goods. In their belief, the mark was registrable with a disclaimer of the letters

A.P.S. Referring to the same test, the examiner argued, however, that the meaning of the words in relation to cosmetics could be only one, namely, that stated by him in the original report.

The attorneys submitted that a mark need not be totally devoid of meaning, nor that it contain no reference whatsoever to the goods claimed, and that only direct reference corresponded to aptness for normal description, as propounded in *American Screw Co's Appn* (1959) RPC 344 at p 346. Ordinary persons would see nothing more in the mark than its trade mark significance. The attorneys further emphasized that the applicant's mark consisted of not only words but also letters, and that the subject mark as a whole was not apt for normal description of the specified goods. Moreover, in their opinion, no other trader, acting without improper motive, would require the unusual combination of the mark to describe their similar goods. In maintaining the initial objection, the examiner said that in the context of the goods, an average Australian would see the cosmetic products as those indicated in the previous reports, and that the words in the mark, being normal English words with normal meaning, were indeed most appropriate for normal description. By relying on *Diamond T Motor Co's Appn* (1921) 38 RPC 373 and *Hillier Parker May & Rowden* (1993) AIPC 90-996, the attorneys argued that the subject mark was acceptable for registration in Part B on condition to the effect that the letters A.P.S. and the words AGE PROTECTION SYSTEM were disclaimed separately. They also reminded the examiner that trade marks must not be refused registration "on grounds which were fanciful and which, in business sense, were unsubstantial" (*Application by the Standard Woven Fabric Company to register a Trade Mark* (1918) 35 RPC 53). The attorneys' proposal was rejected by the examiner on the ground that the separate elements in the mark as well as the whole mark were non distinctive, and that the mark was not considered as one which was capable of acquiring distinctiveness through use. Subsequently, the attorneys waived the right to a hearing on the applicant's behalf and requested a decision on the written record.

For the purpose of my decision, I will consider first whether the applicant's mark is registrable in terms of section 24 of the Act, and also contemplate the question of its registrability in Part B of the Register, in accordance with the provisions of sub-section 44(2) of the Act. Registrability of the mark in Part B will depend on the test as to whether the mark would, at some time in future, satisfy the requirements of sub-section 26(2) based on inherent distinctiveness and distinctiveness in fact.

For a mark to qualify for registration in Part A of the Register, it must satisfy the requirements set out in section 24 of the Act. Paragraphs (a), (b) and (c) of sub-section 24(1) do not apply to the applicant's mark, because the mark does not comprise the name of a person represented in a special or particular manner; it is not the signature of the applicant for registration or of some predecessor in the business; nor does it consist of invented words. There remains for me to consider whether the examiner was correct in viewing the mark as not equipped for registration in terms of paragraphs 24(1)(d) and (e) of the Act. As no evidence has been lodged by the applicant, I am not required to consider the mark's acquired distinctiveness under the provisions of sub-section 24(2).

I do not dispute the attorneys' contention that a mark need not be totally unsuggestive, but, as stated by Bowen CJ, Woodward and Lockhart JJ in *Advanced Hair Studio (America) Pty Ltd v Registrar of Trade Marks* (1988) 12 IPR 1 at p 6:

"It is a question of degree in every case whether a mark trespasses across the line between an indirect and a direct reference to character or quality, as the division of opinion in the *Tub Happy* case illustrates. That case involved the term "happy" which the majority felt to be such a vague and emotive word, containing merely a "cloudy suggestion" of meaning rather than a "definite or actual" meaning, as to deprive "tub happy" of any direct reference. The same could not be said in this case of 'hairfusion'. While "fusion" is far from precise, it is not so vague as to lack a definite meaning."

Concerning the question of directly descriptive words, in *Mark Foy's v Davies Coop*, supra, Dixon CJ said at p 195:

"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."

"Ordinary persons", as explained by his Honour in *Howard Auto-Cultivators Ltd v Webb Industries Pty Ltd* (1946) 72 CLR 175 at p 184, would be that "section of the community following a particular pursuit or possessing special vocation or technical interest, or ... the public at large ...".

The word "protection", according to the *Macquarie Dictionary*, means, inter alia:

- "n. 3. preservation from injury or harm;
- 4. something that protects".

In the same dictionary, the word "system" is listed, inter alia, as:

- "n. a coordinated body of methods, or a complex scheme or plan of procedure;
- 5. due method, or orderly manner of arrangement or procedure".

Considering the subject mark in light of the above criteria and dictionary definitions, I believe that, on encountering the mark in conjunction with the specified goods, persons even without any specialized knowledge in the pharmaceutical field would interpret the words AGE PROTECTION SYSTEM as being medical preparations which offer one a methodical procedure for the protection of the skin against aging. By planned and regular application, for example, every day, in the morning and at night, a user of such a product would expect the fine wrinkles of the face and neck to become softer and more supple, thus reducing the visible signs of the natural aging process. Moreover, as Australians are very conscious of the damaging effects on the skin caused by ultraviolet light which result in the aging of the skin, words in the mark promising protection against the strong rays of the sun and consequently slowing down the effects of aging, would be readily understood and appreciated by the consumers interested in purchasing a product which offers such benefits.

By conveying a clear and unambiguous statement to an ordinary Australian, the words AGE PROTECTION SYSTEM, in the context of the goods, possess a definite meaning belonging to that group of words which have direct reference to the character or quality of the goods - as per *Advanced Hair Studio*, supra - and are therefore unsuitable for registration in terms of paragraph 24(1)(d). The upper case letters A.P.S. separated by a full stop, presumably intended to form an abbreviation for the words AGE PROTECTION SYSTEM, constitute non-registrable particulars, and contrary to the attorney's contention add nothing to registrability of the entire mark.

A mark qualified for registration in Part B of the Register must be of such nature that it would, at some time in future, meet the requirements of sub-section 26(2), by inherent distinctiveness, or by a combination of inherent adaptability to distinguish and distinctiveness in fact. These criteria were set out in *Burger King Corporation v The Registrar of Trade Marks* (1974) 128 CLR 417. To decide a mark's adaptability to distinguish, it is necessary to decide whether or not the mark is one which other traders are likely to use, without improper motive, upon or in connection with similar goods (*Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511).

Having regard to the precise meaning of the words AGE PROTECTION SYSTEM, as discussed earlier, I am in agreement with the examiner that these words most suitably describe the characteristics of the goods to which the words are to be applied and consequently should not be appropriated by any one particular trader for his own exclusive use. Unlike the mark considered in *Diamond T*, supra, where at p 381 Lawrence J said of the mark:

"It is in no sense a mark which would convey to the eye or ear of a purchaser that it is being used in a descriptive or laudatory sense, nor is it one which might reasonably be supposed to apply to motor vehicles generally",

the descriptive words in the subject mark, together with non-distinctive letters, lack any adaptability to distinguish the applicant's goods. Similarly, the mark cannot be regarded as analogous to the criteria applied in *Hillier Parker*, supra, where the application was accepted with disclaimer of the words, the surnames HILLIER and PARKER, separately, based on the proposition that, although the two surnames occur frequently on their own, the use of these surnames together is infrequent. Thus, whilst the unusual manner of a combination of non-distinctive elements consisting of a capital letter "T" with the words DIAMOND written across it and surrounded by a diamond shaped border device was found to be distinctive as a total entity in *Diamond T*, supra, as was the combination of common surnames in *Hillier Parker*, also supra, the same principle cannot be applied to the subject mark. Accordingly, the mark A.P.S. AGE PROTECTION SYSTEM may not proceed to acceptance in Part B of the Register, subject to separate disclaimers of the letters and the words, as suggested by the attorneys. Indeed, I will venture to say that in my estimation the mark is inherently unadapted to distinguish to such an extent that it could never become distinctive by virtue of its use, should the applicant decide to demonstrate it.

In view of my foregoing findings then, I refuse to accept application 588766 in either Part A or Part B of the Register.

Vija Zars
Senior Examiner

13 January 1995