



TRADE MARKS ACT 1955

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

Re:Application number 615099 to register a trade mark in the name of PENNEYS PTY LIMITED - Proposal to withdraw acceptance

Application number 615099, in the name of PENNEYS PTY LIMITED, was lodged on 29th October 1993 for the trade mark STRATHSPEY in respect of "all goods in class 33". The mark was advertised as accepted in Part A of the Register in the *Official Journal* of 1st September 1994.

The applicant was subsequently advised, in an official letter of 13th October 1994, that the present application had been accepted in error in view of information which had come to the attention of the examiner after acceptance. This information was based on the word STRATHSPEY being a name of a valley of the river Spey in Scotland, which is well known as a major producer of whisky. It was implied that, had that information been brought to the notice of the acceptance officer and taken into account, an objection to registration of the trade mark of this application would have been raised, in terms of paragraph 24(1)(d) of the Act, that the mark was a geographical name.

The applicant applied to be heard on the matter as to whether acceptance of the application should be withdrawn under paragraph 44(3)(a) of the Act, and it became the subject of a hearing before me in Melbourne on 9th February 1995. The applicant was represented by Mr Colin Oberin.

Mr Oberin submitted that the acceptance officer was aware of the information relating to the meaning of the word comprising the subject mark and had considered the appropriate documents at the time of its acceptance. The acceptance officer had accepted the subject mark based on the information that the single word STRATHSPEY had a recognized meaning, which appears in the standard English language dictionaries. The geographical name, on the other hand, to which the acceptance officer's attention had been directed, consists of two words. In Mr Oberin's opinion, the alternative meanings of the word had been before the acceptance officer, who had accordingly considered those two different meanings. He argued further that geographical names consisting of two words may be registered as one word, as illustrated by the mark STRATHCONON of registration A237238. In light of the findings in *Re Remington Products, Inc* (1990) AIPC 90-680, therefore, an error had not been made on the part of the acceptance officer. He also reminded me that the provisions of para 44(3)(a) do not allow the Registrar to apply the section to a reconstruction of the acceptance, as considered in *Re Shop-Vac Corporation* (1991) AIPC 90-730.

Discussing the matter of how the information relating to the geographical meaning of the mark was conveyed to the examiner, Mr Oberin referred to D R Shanahan's *Australian Law of Trade Marks and Passing Off*, pp 61-62, saying that, while in withdrawing acceptance of a mark, the Registrar may act on information supplied by members of the public, the proper course for the persons who wished to object to the application would be to lodge opposition to registration of the mark. In the present case, however, rather than lodge opposition, the informant had chosen an informal approach. He advanced the view that, since no opposition or other complaint had been lodged to registration of the applicant's mark, this factor should strengthen the applicant's case and dispel any doubts that the public interest would be harmed if the mark proceeded to registration. In support of this contention, Mr Oberin cited *Re Pacific Access Pty Ltd* (1993) AIPC 91-002.

Continuing his submissions, Mr Oberin said that in the event of my finding an error in acceptance of the subject mark, i. e. that some new information had come to light which had not been available to the acceptance officer, then I should consider a number of factors in the applicant's favour. The word SHRATHSPEY, he stressed, was not a geographical name according to its ordinary significance; small obscure place names could achieve registration, even if the goods concerned were manufactured there, as was found in *Re Jonsered Motor Aktiebolag* (1993) AIPC 90-978. Moreover, and of great significance, the organization which oversees the scotch whisky traders interests, The Scotch Whisky Association, had consented to the mark being registered by the applicant.

Decision

Para 44(3)(a) states:

Where, after acceptance of an application for registration of a trade mark but before the registration of the trade mark, the Registrar is satisfied -

(a) that the application has been accepted in error ...

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted.

For the purpose of this decision, I am required to determine two issues: whether the application for the mark was accepted in error, and if so, whether the Registrar's discretion may be exercised to withdraw acceptance. I should mention at this point that I will not be able to consider fully Mr Oberin's submissions on registrability of the mark except as they relate to the finding of an error or otherwise, these should be made in response to an examiner's report containing details of the objection, or be made the subject of a hearing on the registrability aspect.

Based on comments by the Deputy Commissioner of Patents in relation to a patent case and on the High Court's interpretation of the word "mistake", the hearing officer has formulated what constitutes an error on the part of the Registrar, under para 44(3)(a), in the *Remington* case, supra, at p 36,343:

"...'accepted in error' must thus be restricted to mean acceptance of a trade mark where the acceptance officer is either mistaken as to the facts or in ignorance of the facts. It cannot be extended however to the reversal of a decision to accept when there is no more than a change of opinion as to the way the facts should be interpreted."

In relation to the Registrar's discretion to withdraw acceptance, Mr Shanahan, in *Australian Law of Trade Marks*, supra, says at p 62:

"This power is used infrequently, but the Registrar will withdraw acceptance where it is found, for example, that the Examiner has missed a relevant dictionary meaning or an earlier registration that is clearly in conflict. The Registrar may also act on information supplied by members of the public, but the proper course for a person who has an objection to an application is the lodging of opposition."

It is evident from the case file that in the present instance the examiner consulted the relevant reference material available in the Trade Marks Library, including the standard dictionaries, *The Random House Dictionary*, *The Macquarie Dictionary of New Words*, *A Dictionary of Australian Colloquialisms*, and more specialized reference books: the *Webster's New Geographical Dictionary*, *Encyclopedia of Wines and Spirits* by A Lichine and *Wines and Spirits* by William E Masee. From these sources he had noted the meaning of the word STRATHSPEY defined in the *Random House* as a Scottish dance and music for this dance "after Strath Spey, the valley of the river Spey in Scotland". This single definition has been attached to the case file as a photocopy. Subsequently, the trade mark was accepted by the acceptance officer on the basis of this information.

In a letter dated 8th September 1994 from the firm of Carter Smith & Beadle, patent and trade mark attorneys, and signed by Mr J Roger Green, this Office was notified that STATHSPEY is an area well known for the production of fine scotch whisky and, according to the personal knowledge of Mr Andrew Cowie, a consultant in the firm, "there are 47 whisky distilleries in the valley of the river Spey, which is known as Strathspey". This advice was accompanied by photocopies from *The Compact Edition of the Oxford English Dictionary* and *The International Geographic Encyclopaedia and Atlas - The World Gazetteer*. As a consequence of this information, the examiner has located a reference to STRATHSPEY in

The Whiskies of Scotland by R J S McDowall as being a centre of the whisky industry and had also noted that in *The Times Atlas of the World*, the place name was rendered as two words "Strath Spey".

Having perused the reference material before the acceptance officer at the acceptance stage, the information conveyed by Mr Green and that subsequently found by the examiner, I believe that the acceptance officer did not have all the relevant information. To my mind, the application was accepted in error within the meaning of para 44(3)(a), because the acceptance officer was not in possession of all the facts at the time of acceptance. In the reference books checked by the examiner, there is no mention of STRATHSPEY as being of any significance in relation to whisky or any other products. An examiner cannot be expected to have an extensive knowledge of all the facts to be taken into account during examination of a variety of different applications and must therefore rely on reference sources. In this particular instance, the examiner would have needed the special knowledge that the river Spey is associated with the production of whisky, as neither the word STRATHSPEY nor the words STRATH SPEY are included in the index of *The Whiskies of Scotland*, supra. The reference to STRATHSPEY in that book may be found under "Spey, River". Information supplied by a person who is in possession of some facts which are pertinent to the matter in suit and of which the acceptance officer was not aware, should not be ignored. If the Registrar finds that, based on those facts, the acceptance of the application must be withdrawn, then such a situation cannot be seen as reconsideration of the acceptance or change of opinion regarding an interpretation of those facts, as discussed in *Shop-Vac* case, supra. The lodgement of opposition, as suggested by Mr Oberin, would not be necessary in the present situation where the informant's sole purpose was to direct to the attention of the officers concerned some important facts which might not have been previously available to them.

Having concluded that the subject mark was accepted without the acceptance officer being in possession of all the facts, and that the application was accepted in error, I will consider whether the Registrar's discretion should not be adversely applied. As indicated earlier, whilst a known meaning of the word STRATHSPEY may be that of a national dance, it does not alter the fact that a place by that name is also a well known centre of the whisky industry. Since whisky is embraced in the specification of goods of the application, I believe that a prima facie objection in terms of para 24(1)(d) should have been raised by the examiner, which would have provided an opportunity to the applicant to present submissions on the assertion that the place in question is not sufficiently important to be a geographical name according to its ordinary meaning, or to establish that the applicant has the right to appropriate the word STRATHSPEY for its own exclusive use.

Concerning Mr Oberin's contention that only the two words STRATH SPEY have a geographical significance, I refer to *Re Application by Cedarapids Inc* 13 IPR 297, where it was found that the conjoining of two constituent words of the place name and the elision of one letter, i.e. the word CEDARAPIDS, was no better qualified to distinguish the applicant's goods than CEDAR RAPIDS, the normal rendering of the geographical name. I emphasize, however, that it is clear from the previous considerations that the single word STRATHSPEY has a geographical significance.

The fact that no opposition has been lodged during the opposition period is not the determining factor in deciding the issue, since it is not unlikely that other traders may desire to use the subject place name some time in the future to indicate the origin of similar products to those of the present applicant. The undertaking of The Scotch Whisky Association not to oppose the application, as evidenced in copies of the letters from the applicant and the association tendered at the hearing, is binding only on those two parties, not on other producers concerned with using the word STRATHSPEY in their normal business activities. In this regard, the present situation may be distinguished from the findings in the *Pacific Access*

case, supra, where the hearing officer exercised his discretion in favour of the applicant, having regard to the absence of opposition which indicated to the hearing officer that the possible objections did not constitute strong objections to acceptance of the respective mark, and therefore the public interest would not be affected.

Conclusion

In view of the foregoing considerations, I have found that application number 615099 for the trade mark STRATHSPEY has been accepted in error, and that the Registrar's discretion should be exercised by withdrawing its acceptance. I therefore withdraw acceptance and direct that the application be referred to the examiner for re-examination.

Vija Zars
Senior Examiner
6 March 1995