



TRADE MARKS ACT 1995

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS

Re: Trade mark application number 618464 in the name of ELTHAM WOODWIND (IMPORTING) PTY LTD

Application number 618464 was lodged by ELTHAM WOODWIND (IMPORTING) PTY LTD (the applicant) on 14 December 1993 for the statement of goods “Musical instruments and such parts and accessories therefor as are included in this class”, in Class 15, for the

The Sound

trade mark as shown below:

An examiner of trade marks objected to the trade mark’s registration under paragraphs 24(1)(c), (d) and (e) of the *Trade Marks Act* 1955, on the grounds that the trade mark consisted of words which other traders might ordinarily wish to use to describe, “THE excellence of SOUND made by their musical instruments”. He said that the definite article, THE, qualified the noun, SOUND, as meaning the best known or most important sound emitted by a musical instrument. He said that the other elements in the trade mark - including that of the applicant’s prior registered trade mark 618465, which comprised a musical repeat device which would be seen as an S, and the quaver device - were minor in relation to the present trade mark and insufficient to render it distinctive as a whole. However, he offered to reconsider the objection if the applicant provided evidence that the

trade mark had become distinctive or was capable of becoming distinctive because of substantial commercial use.

The applicant's attorney submitted that there was no justification for the reference to "excellence", which imported a laudatory connotation which wasn't there. He argued that there were other aspects of the trade mark than just the words, THE SOUND. These included the device forming the letter S - which was actually a musical sign or mark indicating repetition, which had already been registered by the applicant - and the "tail" of the final letter resembling a quaver. He argued that the words, THE SOUND, also had geographical meanings and accordingly offered to disclaim rights to the word SOUND, together with the letter S.

The examiner maintained his objections and the attorney sought a hearing in the matter. That hearing was held before me, as the delegate of the Registrar, in Melbourne on 7 February 1996 and was attended by Mr Peter Nicholls, patent and trade mark attorney, on behalf of the applicant and Mr Donald Hobbs, a director of the applicant company.

Submissions

At the hearing, Mr Nicholls produced evidence of use of the subject trade mark in the form of a declaration by Mr Hobbs. In this declaration, Mr Hobbs stated that the trade mark had been continuously used on the subject goods since February 1994. Attached to the declaration were exhibits showing use of the trade mark in advertisements in trade journals and Yellow Pages entries, and a statement as to the value of sales of musical instruments and parts sold under the trade mark, together with details of expenditure on advertising and promotion.

Mr Nicholls also produced various musical instruments and cases bearing the subject trade mark engraved on, or attached to them, together with examples of point of sale advertising. He said that the applicant's registered trade mark 618465, consisting of a "segno" or musical sign indicating repetition, had been found to be distinctive in Part A of the Register, although subject to a disclaimer of the letter S. This element was also included in the present

trade mark as the letter S in the word SOUND, together with the addition of a quaver device forming the last letter, D. He submitted that the present trade mark, as a whole, was registrable, as it comprised the words THE SOUND especially rendered as having some distinctive musical references.

Mr Nicholls argued that, although it was true that musical instruments were capable of making sounds, it was the skill of the player and the ear of the listener which determined the quality produced. Thus, any inference that the trade mark was a reference to “the”, or “superlative”, sound was subjective, as it could say nothing about the instrument which produced it. He said that the word, THE, was listed as having 40 definitions in *Websters Third New International Dictionary*. Only one of these meanings referred to it as a function word meaning of, “one of a class which was the best...”. Meanwhile, the word SOUND had other meanings, other than in a musical context, and was far removed from such absolute and equivocal words as BEST or SUPERFINE.

Discussion

This application for registration of a trade mark is one which was made under the *Trade Marks Act 1955* and which was pending immediately before 1 January 1996. Under section 241 of *Trade Marks Act 1995*, which came into effect on 1 January 1996, I must now consider the matter of the trade mark’s registrability under Division 2 of Part 4 of the new Act.

Sub-sections 41(2) and (3) of the Act read, respectively:

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant’s goods or services in respect of which the trade mark is sought to be registered (designated goods or services) from the goods or services of other persons.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

It is true that the word SOUND can be said to have a reference to a musical instrument's auditory effect. It is also possible, in the context in which it is used in the trade mark, that the addition of the definite article, THE, could lead to an inference being drawn that the combination meant, "the best sound" or, "the ultimate sound" which could be produced from musical instruments. Thus, it is not inconceivable that other dealers in musical instruments might wish to use the combination to extol the superior nature of their own goods.

As Lord Parker stated in the case of *Du Cros (W&G) Ltd's Appn* (1913) 30 RPC 660 and as quoted by Kitto J. in *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511 (the *Michigan* case):

The applicant's chance of success in this respect (i.e. in distinguishing his goods by means of the mark, apart from the effects of registration) must, I think, largely depend on whether other traders are likely, in the ordinary course of their business, and without any improper motive, to desire to use the same mark or some mark nearly resembling it, upon or in connection to their own goods.

Trade marks that are not inherently adapted to distinguish one trader's goods from those of other traders are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic of goods or services; or
- (b) the time of production of goods or of the rendering of services.

Such signs may be required for use by other traders and as a result, are not inherently adapted to distinguish.

However, despite the foregoing, I do agree with Mr Nicholls' argument that the present combination of words is not in the same class as laudatory words, or combinations of words, such as BEST, SUPERFINE, SUPERIOR or NUMBER ONE. The combination of words, the subject of this trade mark, does have a degree of descriptiveness but does, in my opinion, have a low level of inherent adaptation to distinguish. However, such trade marks are not, *prima facie*, capable of distinguishing and evidence in terms of sub-section 41(5) is needed to enable registration.

Sub-section 41(5) Of the Act reads:

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

(a) The Registrar is to consider whether, because of the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use of the trade mark by the applicant;

(iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will distinguish the designated goods or services - the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; and

(c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services - the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

This means that I must assess the combined effect of sub-paras (i), (ii) and (iii) of para (a) in order to determine the trade mark's registrability. As I have said, I think that the trade mark has a degree of inherent adaptation to distinguish. Despite the descriptiveness of the combination, there are a plethora of other word combinations available to like traders to commend their own goods.

The applicant has submitted evidence of use of the trade mark which indicates that there has been a fair degree of activity in sales and advertising of goods bearing the trade mark in a two year period since its adoption. Additionally, the combination is shown in use as a trade mark in promotional brochures, newspaper advertising, Yellow Pages entries, point of sale material, and on the instruments and cases themselves, sufficiently styled to differentiate it from a mere accidental combination of the two words used in relation to musical instruments.

The trade mark does have some degree of “getup”, evident from the “segno” device forming the S in the word SOUND, the quaver device forming the letter D in that word and the curlicues in the type face in which the trade mark is presented. The “segno” device is also separately registered in Part A of the *Trade Marks Act 1955*, albeit only forming a small portion of the present trade mark. There does not appear, at this time, to have been any problems with other traders in like goods over use of the trade mark by the present applicant - despite its use in advertisements circulated in the trade. Mr Hobbs, although obviously an interested party, has declared that he is not aware of any other entity using THE SOUND, or any other similar trade mark, in relation to musical instruments or suchlike goods or related services.

Decision

Given the foregoing, I have come to the conclusion that the trade mark is now acceptable under the provisions of subsection 41(5). This is because of the combined effect of the extent to which the trade mark is inherently adapted to distinguish the designated goods, the evidence lodged at the hearing showing the use of the mark by the applicant, and the other circumstances surrounding its use which I have mentioned.

I therefore accept this application for registration of the subject trade mark with an endorsement to be entered on the Register which reads:

Provisions of subsection 41(5) applied

Ian Forno
Hearing Officer

16 February 1996