



## TRADE MARKS ACT 1955

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

RE: Trade Mark Application 619317 in the name of Goldwell AG

#### **Background**

On 22nd December, 1993 the abovenamed applicant lodged an application to register the words COLOR COLLECTION as a trade mark in Part A of the Register in respect of: "all goods including compositions for skin and beauty care, particularly decorative cosmetics, such as make-up preparations, foundations, lipsticks, mascara, face-powders, nail polishes, nail polish removers " in class 3.

In the first report on the application the examiner of trade marks objected in terms of paragraphs (c), (d) and (e) of sub-section 24(1) of the Act that the mark consists of the words COLOR COLLECTION which refer directly to the character or quality of the goods by describing them as a collection of colored cosmetics or beauty preparations.

Responses from the applicant's attorneys argued that, at most, the trade mark suggested an indirect reference to cosmetics and beauty products in class 3. The attorney also advised that the applicant consented to disclaim the exclusive use to the words 'COLOR' and 'COLLECTION'. The examiner maintained the objection in the 2nd report on the basis that the words were directly descriptive of the goods in the application and that the average Australian would see the mark as describing a collection of variously coloured cosmetics. He said that the proffered disclaimer did not overcome the objection as the mark as a whole was descriptive and non-distinctive. The Attorney requested that the mark be transferred to Part B of the Register and also made submissions concerning the state of the Register in relation to various trade marks that incorporate the word COLLECTION. When an

objection was then taken under section 25 and was maintained, the applicant waived its right to be heard and requested a decision on the written record.

## **Discussion**

As the mark COLOR COLLECTION is now one which seeks registration in Part B of the Register I must consider it under s. 25 of the Act.

Sub-section 25(1) of the Act reads:

(1) A trade mark is registrable in Part B of the Register, if it is distinctive, or is not distinctive but is capable of becoming distinctive, of goods or services in respect of which registration of the trade mark is sought and with which the applicant for registration is or may be connected in the course of trade.

For a mark to be registrable in Part B of the Register it must be determined whether it will, at some time in future, meet the requirements of sub-section 26(2), namely, 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, where Gibbs J. explained at p. 424:

"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 future the tests stated in s. 26(2). That sub-section requires two matters to be considered, inherent adaptability to distinguish and distinctiveness in fact acquired by use or otherwise."

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).

I note that the word COLOR in the applicant's mark, is defined in *Webster's Third New International Dictionary* as , *inter alia*, '(1) (d) a hue as contrasted to black, white or gray' and "3. complexion tint' . The word COLOR is also commonly used in relation to cosmetics as described in '*FaceFacts - a guide to cosmetics, skin and hair care*' by Alison Haynes, published by Choice Books, Australian Consumers Association, N.S.W. in

1994. The word COLLECTION is defined in *Webster's Third New International Dictionary* as 'a number of objects that has been collected often according to some unifying principle or orderly arrangement '. According to these dictionary meanings the words COLOR COLLECTION in the mark could be adopted by other traders for the purpose of describing certain attributes of any of the goods claimed by the present application .

Thus, the condition that the mark be registered subject to a disclaimer that the registration gives no right to the separate exclusive use of the words, which was suggested by the attorney, is not appropriate, and would not permit registration of a mark which has been found to be unregistrable. Consequently, I have found that the applicant's mark is not adapted to distinguish the applicant's goods from those of other traders.

As the applicant has not lodged any evidence concerning use of the mark in question, I am not required to assess the mark in light of the second factor for consideration, that of distinctiveness in fact.

### **Decision**

Given the foregoing, I find that the words COLOR COLLECTION are non-distinctive and are incapable of becoming distinctive, and could be required for use by other traders. The mark does not meet the requirements of s.25 of the Act and I am therefore not willing to accept the mark in Part B of the Register. Accordingly, I refuse the application.

Michael Homann  
Hearing Officer  
1 August, 1995