



## **TRADE MARKS ACT 1995**

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

**Re:** Trade mark application number 638555 to register a trade mark in the name of EVENGLLEN PTY LIMITED trading as MISTER PLYWOOD

On 23rd August 1994, EVENGLLEN PTY LIMITED trading as MISTER PLYWOOD (the applicant) lodged an application to register the word FLAMESAFE as a trade mark in part A of the Register. The application sought the registration in class 20 for 'notice boards for school, home and office use; display boards and panels; and all other goods included in this class.'

#### **BACKGROUND**

In the first report on the application, the examiner objected in terms of paragraphs (c), (d) and (e) of sub-section 24(1) of the Trade Marks Act, 1955 that the mark referred directly to the character or quality of the goods as being safe against, or resistant to, fire or heat. The examiner maintained the section 24 objection in four reports. Following the fourth report from the examiner, the attorney requested that the matter be set down for hearing.

The matter was heard, before me as a delegate of the Registrar, in Canberra on 26th October 1995. Mr. James Maxwell, from Peter Maxwell and Associates, patent and trade mark attorneys of Sydney, appeared for the applicant.

#### **SUBMISSIONS**

As the hearing was held prior to the introduction of the Trade Marks Act 1995, (the new Act), Mr. Maxwell's submissions were directed towards the examiner's objections as they pertained to the Trade Marks Act 1955 (the old Act).

Mr. Maxwell opened his submissions by stating that the word FLAMESAFE was a mark that while it was inherently adapted to distinguish, was also capable of becoming distinctive through long and extensive use, following the principles set out in the *Burger King Corp. v Registrar of Trade Marks* (1973) 128 CLR 417, (the *Whopper* case). He also maintained that it was highly unlikely that any other trader would desire to use the words FLAMESAFE on their similar goods and referred me to the *Clark Equipment Co v Registrar of Trade Marks*, 111 CLR 511, (the *Michigan* case). He then made extensive submissions on the varied dictionary definitions of the separate components of the mark, the words FLAME and SAFE. He conceded that, while there is some meaning entwined in the mark, the meaning is secondary and that there are many other combinations of words that are more appropriate to describe similar goods. Mr. Maxwell alleged that, given that no other trader has desired to use the words FLAMESAFE, that the mark does possess some inherent distinctiveness. He claimed that the mark was one that was appropriate to be registered in Part B of the Register. This is because it fell into one of the categories envisaged in the *WHOPPER* case, supra, as being a mark that, while it was not inherently adapted to distinguish, by reason of long and extensive use had become distinctive in fact. He submitted that the evidence of use of the mark established that the mark had the capacity to become distinctive in terms of Section 25 of the Trade Marks Act, 1955 and that this outweighs any meaning entwined in the words. He concluded his submission by noting the state of the Register regarding marks that incorporate the word SAFE, or the word GUARD or its phonetic equivalent.

### **DISCUSSION**

Although the hearing on this matter was based on the provisions of acceptability of the mark in Part B of the Register, under the provisions of the old Act, as this application for registration of a trade mark is one which was pending immediately before 1 January 1996. I must now consider it under the provisions of the new Act.

Under section 241 of the new Act, 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.

The mark in question is a combination of the words FLAME and SAFE. The word FLAME is defined in the Macquarie Dictionary as, inter alia, ‘state or condition of blazing combustion; to burst into flames’; the word SAFE is defined as, inter alia, “secure from liability to harm, injury, danger or risk”. I cannot but agree with the examiner that the mark does have some meaning when used on , or in connection with, these goods as it implies that they are fire-resistant or flame-proof. I do not find any great invention in this combination and cannot agree with the attorney that, ‘no other trader without improper motive would want to use the mark to indicate their 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.

The combination of words, the subject of this trade mark, in my opinion, have a low level of inherent adaptation to distinguish.

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

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. I have already indicated that I believe that the trade mark FLAMESAFE contains only a low level of inherent distinctiveness. I must therefore place significant weight upon the second and third criteria outlined above.

The second criterion relates to "the use, or intended use of the trade mark by the applicant". The Trade Marks Office *Draft Manual of Practice and Procedure* discusses, at Part 23.6, the value of evidence of use, or intended use, for the purpose of showing that, at some future date, a trade mark will distinguish one trader's goods from those of another.

I also note that, in order for the evidence to meet the requirements of section 41(5), it must be considered whether, as at the date of lodgement of the trade mark application - 23 August 1994 the trade mark was inherently adapted to distinguish the designated goods. In this regard the evidence of use provided by the applicant indicates that the mark has been used since 1992. Sales are limited to New South Wales and one location in Queensland and the value of goods

totals \$150,412 for the period November, 1992 to September, 1995. It is not clear how many units have been sold but the maximum would be less than 5,000. Advertising figures provided show that just over \$22,000 was spent in advertising the products in this period. The only items sold are fire retardant panels. Given the limited sales and advertising figures, I do not consider that the applicant has demonstrated that the mark has become capable of distinguishing their goods through use of the trade mark.

I turn now to the third and final criterion provided in subsection 41(5), “any other circumstances”. Mr. Maxwell did not raise and I am not aware of any other circumstances that should prevail in this case.

### **Decision**

I have already indicated that I am of the opinion that the word FLAMESAFE has a low level of inherent adaptability to distinguish the applicant’s, ‘fire retardant panels’. I am not convinced that the word is one that other traders are *not* likely, in the ordinary course of their business, and without any improper motive, to desire to use the same mark or very similar mark in relation to their own goods. The evidence lodged indicates only minimal use, in a restricted area for a limited range of goods. It therefore seems to me more than likely that many competitors in the applicant’s trade will, either now or in the future, require to use the term in connection with their goods.

Having assessed this trade mark against all three criteria offered by subsection 41(5), I find that, in terms of paragraph 41(5)(c), I am not satisfied that the trade mark does or will distinguish the applicant’s goods. Therefore, under the provisions of subsection 33(3) and (4) of the Act, I must reject the application.

Sandra Jarvis  
Senior Examiner

8 May 1996