



TRADE MARKS ACT 1995

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

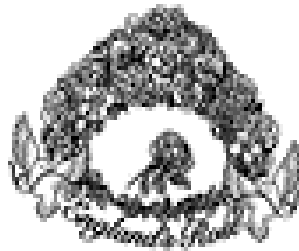
Re: Opposition by the Executors of the Estate of Diana, Princess of Wales to registration of trade mark applications 789279 and 812789 – **England's Rose** and **England's Rose Logo** - filed in the name of Bonnie Masterson.

Background

In this matter, Bonnie Masterson, (“Ms Masterson” or “the applicant”), of the United States of America has filed application to register the trade marks, details of which appear below:

Appn Number: 789279
Priority Date: 21 Jan 1999 (Based on USA Appn 75/624934)
Goods: **Class: 31** Live roses
Trade Mark: **ENGLAND'S ROSE**
Advertised: 25 January 2001

Appn Number: 812789
Priority Date: 16 June 1999 (Based on USA Appn 75/730823)
Services: **Class: 31** Horticultural products; seeds, natural plants and flowers; live roses



Trade Mark:
Advertised: 6 July 2000

On 14 Jul 2000 and 6 February 2001, the Executors of the Estate of Diana, Princess of Wales, of the United Kingdom (“EED” or “the opponent”) filed Notices of Opposition (“the Notices”) to the registration of the trade mark. The Notices claim most of the available grounds of opposition under the *Trade Marks Act 1995* (‘the

Act’); however, for the sake of brevity, I will decide these proceedings under the provisions of sections 41 and 43 of the Act.

As a delegate of the Registrar of Trade Marks, I heard the matters in Melbourne on 17 June 2003 and Dr Ricketson of Counsel represented the opponent. The applicant was not represented, did not appear, nor does she now have a functional address for service in Australia.

The Evidence

There are a number of declarations served and filed as evidence in support, evidence in answer and further evidence. However, I will not discuss this evidence since it is irrelevant to my reasoning of the grounds under section 41 and 43 under which I will decide these oppositions.

Section 41

This section allows for the immediate acceptance for registration of those trade marks which have some inherent distinctiveness and provides a scheme by which some trade marks which lack inherent distinctive might, under certain circumstances, be accepted for registration. The operation of the section, and inter-relationship of its provisions, is described by Branson J in *Blount Inc v Registrar of Trade Marks* 40 IPR 498.

Subsection 41(3) provides:

- (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.

Whether a trade mark is “adapted to distinguish” may be gauged according to the classic test in *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511.

Kitto J noted:

“... the question whether a mark is adapted to distinguish [is to] be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – will think of the word and

want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it”.

As Dr Ricketson observed at the hearing, the word trade mark ENGLAND’S ROSE was accepted on submission to the examiner from the applicant’s solicitor that there were other obvious ways for traders to denote that their live roses are English or from England. Suggestions such as ‘British roses’ and ‘United Kingdom roses’ were mooted by the applicant’s then solicitor. However, I agree with Dr Ricketson that, if one wishes to say, quite specifically, that the live roses that one produces are from England, there are, in fact, only two choices of the way in which one might state this. The first is being ‘English rose (or roses)’ and the second is ‘England’s rose (or roses)’. Accordingly, there is a very high likelihood that other traders will think of the words that form the word trade mark to use in relation to their English roses and “being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – [...] and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it”. In respect of the last line of this quotation, it is plain that the words ENGLAND’S ROSE are substantially identical to the words ENGLAND’S ROSES.

Accordingly, the trade mark ENGLAND’S ROSE is one which is not *prima facie* registrable under the permissive provisions of section 41(3) and could only be registrable under the more prescriptive provisions of either subsections 41(5) or 41(6). As the applicant has not evidenced any use of the trade mark ENGLAND’S ROSE, it is not necessary for me to decide which subsection applies as the trade mark presently cannot achieve registration under either. The opponent has established its opposition in relation to 789279 – ENGLAND’S ROSE.

Section 43

Section 43 provides:

43 Trade mark likely to deceive or cause confusion

An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

The device trade mark, application 812789, incorporates the words ENGLAND'S ROSE. I have already commented that these words used in relation to the goods may be understood to quite specifically signify that the goods are roses from England. The specification of goods of 812789 is, "Horticultural products; seeds, natural plants and flowers; live roses" and is hence a misstatement in respect of any goods which are not English roses. There *might* be a valid argument that, as it is plain to all purchasers that, for example, an iris is not a rose, the use of the trade marks on irises would not be deceptive. However, this usage in relation to irises would, in my opinion, be confusing: confusion is an indefiniteness of mind¹, which might not conclude in actual deception. To use my earlier example, a person inquiring of a salesperson concerning England's roses might be presented with irises bearing the trade mark ENGLAND'S ROSE and thus be confused yet not deceived².

Moreover, the use of the trade mark on roses from elsewhere in the world, which *are* included in the specification as it includes all plants and flowers, would be deceptive. Additionally, because of the connotation in the trade mark, its use would be, *prima facie*, deceptive and confusing in respect of plants which, when sold, look similar to roses but which are not - for example, hips, briars, boysenberries, loganberries, blackberries and raspberries amongst others.

The opponent has established this leg of its opposition in relation to both applications.

Conclusion/Decision

Section 55 of the Act provides:

55 Decision

Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or

¹ *Pioneer Hi-Bred Corn Co v Highline Chicks Pty Ltd* [1979] RPC 410, at 423; *Radio Corp Pty Ltd v Disney* (1937) 57 CLR 448 (the Mickey Mouse case) per Rich J, at 454.

² *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 (29 July 1999) at paragraph 47: "That, no doubt, is because "confusion" used in that sense, does not of itself lead into error or affect choices at the point of sale. It is perhaps best described in trade mark law as effecting a prophylactic support for commercial distinctiveness."

(b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application;

having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

I refuse to register applications 789279 and 812789. I have given some thought to whether application 812789 to register the logo might proceed to registration, subject to a restriction of its specification of goods to “English roses”. There was no representative at the hearing to indicate whether or not Ms Masterson would be amenable to the restriction of 812789. Moreover, as the applicant has no representative in Australia to whom I might communicate this fact, or who could request an amendment on Ms Masterson’s behalf, any offer of such an amendment would appear to be redundant and impractical.

Costs

The opponent has succeeded in establishing its opposition; I therefore order costs against Ms Masterson. I note that Ms Masterson has previously successfully requested that the hearing of these matters be postponed. These postponements have typically been requested at short notice and have caused some inconvenience to the opponent. It is not obvious to me that the postponements have occasioned the opponent any costs which may be claimed under the regulations, however, if it has incurred such costs related to the postponements which may be recovered under the regulations, these may be included in its claim.



Ian Thompson
Hearing Officer
Trade Marks Hearings

12 August 2003