



TRADE MARKS ACT 1995

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

Re: Opposition by The Cosmetic, Toiletry and Fragrance Association Foundation to registration of trade mark application 852238(3, 25) - **LOOK GOOD + FEEL GOOD = ROOT GOOD** - filed in the name of Fanni Barns Pty Ltd.

Background

Trade mark application 852238 was filed by Fanni Barns Pty Ltd on 3 October 2000 in classes 3 and 25, for cosmetics and sexual hygiene products, and clothing, respectively. The trade mark is LOOK GOOD + FEEL GOOD = ROOT GOOD.

After examination, the application was advertised as having been accepted for registration. Such registration is now opposed by The Cosmetic, Toiletry and Fragrance Association Foundation (the opponent), an American association.

Two of the opponent's registered trade marks (the trade marks) consist of the words LOOK GOOD ... FEEL BETTER and those same words with a device, as follows:



The latter trade mark, with the device, is registered in class 41 under number 560210, in respect of:

Education services, namely, conducting classes and providing instructional materials on hair, make-up and skin care techniques for cancer patients and cosmetologists who provide such services to those patients

The plain word-mark is the subject of trade mark registration 883627. It was filed subsequent to the currently-opposed application, but is now registered for the previously listed services in class 41 and also in class 16 for:

Printed matter and publications relating to hair, make-up and skin care techniques for cancer patients, including such printed matter and publications being in relation to the conducting of classes on hair, make-up and skin care for cancer patients and cosmetologists who provide such services"

The opponent is an American organisation. One of its "affiliates" is said to be The Cosmetics Toiletry and Fragrance Association of Australia (CTFA). CTFA has established the Cancer Patients Foundation Limited (the Australian Foundation). The Australian Foundation, which is the authorised user of the opponent's two registered marks, runs a community service program called LOOK GOOD ... FEEL BETTER in Australia.

The applicant, Fanni Barns Pty Ltd, has not taken any role in the opposition, and routine correspondence sent to it by the Trade Marks Office has been returned unopened. Staff at the Trade Marks Office have attempted to contact the applicant but it moved some time ago and has since failed to retain an entry in the telephone directory.

After the opponent filed evidence to support its opposition and served a copy of this on the nominated address for service, neither side requested a hearing to decide the matter. Accordingly, I have been assigned to decide the opposition in the light of the opponent's evidence and the written submissions filed by its solicitor, Gail Hill of the attorney firm of FB Rice and Co.

Evidence

The evidence in this opposition comes not from the opponent but from John Arrowsmith, the Secretary and Public Officer of the Australian Foundation. The opponent itself, to judge from the evidence, acts as a combination of lobby group, self-regulator and information clearing house for the cosmetics industry in the United States. In Australia, the same role is carried out by CTFA. I turn now to the details of the use of the trade marks in Australia.

In this country, the trade marks of the opponent are used in conjunction with a scheme to assist cancer patients. The program was started at Westmead Hospital in 1990 and is now run in conjunction with 85 hospitals around Australia. It provides a free service to female cancer patients. Trained beauty advisors assist these women to use cosmetics to

overcome or conceal hair and eyebrow and eyelash loss and other undesirable changes resulting from cancer treatment. The scheme, according to unchallenged evidence, has expanded progressively and had assisted 20,000 patients in the ten years to May 2000. It appears that the program operates through workshops at hospitals, and through kits distributed by Amcal chemists.

Issues and decision

The opponent has relied on a total of six grounds of opposition, of which two can be dealt with jointly. I will deal with these in the order adopted by Ms Hill.

The applicant does not intend to use or authorise use of the opposed trade mark within the meaning of Section 27(1)(b)

Ms Hill's written submissions fall within the ambit of s 59 of the Act, and perhaps s 58 also, as lack of intention to use at the time of filing strikes at ownership. The submissions stress that the notice of opposition impugns the applicant's intention to use the trade mark. Ms Hill has argued:

Whilst the applicant has filed an application for registration of the opposed trade mark the mere fact of the application is not of itself sufficient to find that the applicant had the requisite intention to use or authorise use of the opposed trade mark at the date of filing.

The Notice of Opposition put into question the bona fides or lack of intention of the applicant with regard to use or authorisation of use of the opposed trade mark and the applicant has chosen not to answer that question. It would have been a simple matter for the applicant to have responded with a positive statement but it has chosen not to do so and in the circumstances, we submit that the only reasonable inference that can be drawn from the silence is admission of or concession to the opponent's claim that the applicant lacked the requisite intention to use or authorise use of the trade mark as at the relevant date.

Ms Hill's client bears the onus of doing more than simply casting aspersions on the applicant's intention to use the trade mark. The applicant here has done no more than, perhaps, treat the opposition with disdain. That, in itself, does not expose it to any adverse finding about its intention to use the trade mark.

The opposed trade mark is not capable of distinguishing within the meaning of Section 41

Here, Ms Hill has argued that the trade mark is lacking, to some extent, inherent adaptation to distinguish such that, if it is to be found capable of distinguishing, it needs

the support of evidence of use. Ms Hill relies on the *Macquarie Dictionary* as showing that "root" can be used to mean "sexual intercourse" or "a sexual experience". This is actually only an abstraction from several related definitions. The Third Edition (1997) indicates that, whether used to mean "a sexual partner" or "to engage in sexual intercourse" or to mean frustrate, break or ruin, the word is colloquial. A ‡ symbol is added to indicate what page xxvi of the dictionary calls "a particularly crass and offensive meaning given to a usually neutral word"¹.

Ms Hill has argued:

We submit that the opposed trade mark is not so capable of distinguishing the applicant's goods because the trade mark consists of words and symbols which in combination must be construed as a description of or indicating the intended purpose or some characteristic of the claimed goods and in the circumstances it must be assumed that other traders in the market place would have a similar need (but hopefully not a desire) to use the words and symbols of the opposed trade mark in the ordinary course of their business.

We submit that the opposed trade mark clearly describes the goods claimed in both Classes 3 and 25 as making or assisting the user or wearer to LOOK GOOD and FEEL GOOD with the result that a pleasurable (GOOD) sexual experience is to be expected or will be forthcoming.

This argument is fallacious. The applicant's trade mark draws together a somewhat subjective factual statement (look good) and a sometimes-related state of mind (feel good). I will accept, for the purposes of argument, Ms Hill's claim that these two, if both are present, may perhaps be favorable auguries for a good sexual experience. However, to extract, from this, some sort of purported reference to the goods is in my view no more than an exercise in speculative analysis.

It will not always be fruitful to draw direct comparison between the previous standard for a Part A registration under the 1955 Act and the current standard under s 41, since the former was clearly more rigorous. None the less, the words of Dixon CJ in *Mark Foy's Ltd v Davies Coop & Co Ltd*, (1956) 95 CLR 190, are applicable to Ms Hill's analysis of the applicant's mark.

It is, I think, a mistake first to assume that words like "Tub Happy" do convey a meaning either to people in general or to a particular class of persons and then on that assumption to inquire what exactly the meaning is.

¹ This symbol indicates (emphasis added) that "the word itself **may** give offence essentially because of its taboo nature". The same symbol, doubled, is used to indicate "an extreme degree of restriction". An example from the latter category is the word "fuck".

Indeed to institute a search for a meaning almost necessarily implies that in ordinary English speech the words do not possess a connotation sufficiently definite to amount to a direct reference to the character or quality of the goods. And that is true even when to standard English usage is added all the figurative idiomatic and slang phraseology that may be currently in use. Once, however, the question is asked what do the words mean and there is started a search for a meaning, a process of analysis and of reasoning by exclusion of alternatives is begun. No doubt such a search may, without any sacrifice of logic, end in construing the words as meaning that the garments will emerge happily from the washtub. But if they are so interpreted, the interpretation is chiefly the consequence of failure to find another meaning. I venture to think, however, that a man, or for that matter a woman, hearing for the first time the words used in combination and in connection with cotton garments, would not so understand the words at once. Certainly such a person would not so understand them intuitively and without stopping to reflect and ask himself or herself what meaning the words could really possess.

The fallacy of asking what is the meaning of the phrase lies in the basal assumption that the words are intended to convey some definite meaning and perhaps the further assumption that the meaning has reference to the garments or the cottons. The assumption is fallacious because it overlooks the fact that language is not always used to convey an idea. Many uses of words are purely emotive. A word or words are often employed for no purpose but to evoke in the reader or hearer some feeling, some mood, some mental attitude. This is true of much advertising, which common experience shows to be full of meaningless but emotive expressions supposedly capable of inducing a generally favourable inclination in the almost subconscious thought of the passing auditor or hasty reader. Words put forward as trade marks are very likely indeed to be chosen in the same way.

...

The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess.

As I have said, these words are from quite old case law, relevant to a now-defunct, but clearly more rigorous, standard of registrability. They are a more directive guide than the one urged by Ms Hill, whose analysis, while correct in logic, is also an exercise, to some extent, in reading between the lines.

Ms Hill also argued that, if evidence of use was necessary to support her client's trade marks to acceptance under s 41(5), then the same standard should apply to the opponent's mark. Since her client's trade marks are not, for a variety of reasons, at all analogous, I prefer and adopt the examiner's conclusion, that the present mark is capable of distinguishing without the support of evidence of use.

The opposed trade mark consists of or contains scandalous matter within the meaning of Section 42(a)

This provision is short and to the point. It reads:

42. An application for the registration of a trade mark must be rejected if:
(a) the trade mark contains or consists of scandalous matter;

In dealing with this issue, I note that the *Trade Marks Act 1995*, like the previous legislation, gives no indication of intending anything other than an ordinary meaning of the word "scandalous". The *Macquarie Dictionary*, Third Edition (1997) indicates that the word scandalous means:

1. disgraceful to reputation; shameful or shocking.
2. defamatory or libellous, as a speech or writing.

The more fulsome *Oxford Dictionary*, Second Edition is replete with historical examples but does not add anything new to the discussion.

I think it is correct to read the two dictionaries as both indicating that scandalous indicates the causing of a significant degree of disgrace, shock or outrage. This, I think, goes beyond merely giving offence. Words such as "the English cricket team is the best" can, depending on time and circumstances, give rise to either offence or laughter, yet are not in themselves scandalous.

Moreover, under the current legislation, the terms of s 33 are fully operative. The relevant portions of this section are as follows:

Application accepted or rejected

33.(1) The Registrar must, after the examination, accept the application unless he or she is satisfied that:

- (a) the application has not been made in accordance with this Act; or
- (b) there are grounds for rejecting it.

Note: For the grounds on which an application may be rejected see Division 2.

(3) If the Registrar is satisfied that:

- (a) the application has not been made in accordance with this Act; or
 - (b) there are grounds for rejecting it;
- the Registrar must reject the application.

These apply to the acceptance of the application. They are equally applicable to my decision (under s 55) about "the extent (if any) to which any ground on which the

application was opposed" has been established. Accordingly, in applying s 42, I think I need to clearly distinguish between terms that may have a tendency to be scandalous, and those that are.

What was said in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd*, (1937) 58 CLR 641 at 658 can be lifted from its ordinary context. Ideally, therefore, "the habits and observation of men considered in the mass affords the standard" though without recourse to any sort of definitive survey such matters must be dealt with on the basis of subjective impressions.

S 33 requires that the probability of deception or confusion must be finite and non-trivial. There must be a "real tangible danger of its occurring" but this "does not import a requirement that it be more probable than not that the mark has that effect". Here I draw analogy with the words of French J in *Registrar of Trade Marks v Woolworths*, (1999) AIPC 91-499 at 39,695 (paragraph 43). French J was at that point addressing the effect of s 33 on s 44 and I believe that this result is mirrored in its effects on s 42.

I am required to consider the effects of the trade mark in any situation where it may be encountered. Those affected may not be the actual buyers of the goods so marked, nor need they encounter the trade mark at the point of sale. Conversely, I must be careful to allow only for the affront caused by the trade mark, not by, for instance, any exaggerated brashness of those who choose to display it inappropriately. That distinction is both critical and difficult to draw. It is, of course, possible to imagine situations where deliberately inappropriate use of this trade mark might cause offence. Indeed, those bent on causing offence may manage to do so despite the inoffensive nature of any trade mark they may care to display. As I have said, however, I think that more than this is required if s 42 is to be triggered.

Secondly, my consideration should be confined to the use of the sign (s6) in question as a trade mark. Offence potentially caused by, for instance, those who adopt it as a slogan or as some sort of club motto is not at issue here.

As a trade mark, the applicant's mark does not represent a high point in skilled allusion but I think there can also be little argument that contemporary language, both spoken

and written, is more robust than it was even 10 years ago. I think that to most minds the applicant's mark will be seen as crude, both in sentiment and in grammatical construction. However, I am not satisfied that it has, quite, transgressed the standard of s 42. The trade mark is, I think, no more than an explicit use of colloquial language. It may be bad taste, but in ordinary circumstances it is not, in itself, likely to cause any significant degree of shock.

The opposed trade mark would be contrary to law within the meaning of Section 42(b)

In simple terms, this provision would catch any use of the trade mark, for any of the goods specified, if I was satisfied that this use would be contrary to law. However, I do not agree that the trade marks of the applicant and opponent are deceptively similar, and will deal with that issue separately, below. There is no evidence that would satisfy me that that, over and above this, the use of the applicant's mark might, let alone "would", be contrary to either the *Trade Practices Act 1974* or the law of passing off, both of which Ms Hill cited.

The registration of the opposed trade mark is prevented by the operation of Sections 44 and 60.

Ms Hill addressed these two provisions separately because of their very different structures and actions. However, they share one common element among their differences: neither section can be triggered unless there are conflicting, deceptively similar trade marks, either registered (s44) or in use (s60). "Deceptively similar" is defined by s 10:

For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

Ms Hill argued, in her submissions, that this is so.

I must allow for the ordinary possibilities of imperfect recollection of one trade mark when, hypothetically, it is encountered in the absence of the other. I note that Ms Hill has added a useful caution here, from *The Shell Company Ltd v Esso Standard Oil (Australia) Ltd* (1961) 109 CLR 407, which I repeat:

"... (the) deceptiveness that is contemplated must result from similarities; but the likelihood of deception must be judged not by the degree of similarity alone but by the effect of that similarity in all the circumstances".

While the authorities Ms Hill has listed to support her case are well recognised and appropriate, I disagree with Ms Hill as to a conclusion.

Ms Hill has argued:

In this case both trade marks are what might be termed slogans or expressions. This adds to the likelihood of confusion. Both trade marks begin with the same words LOOK GOOD and both continue with the same word FEEL. In the case of the opponent's trade mark the word BETTER follows whereas in the case of the opposed trade mark the word is GOOD. Clearly the words BETTER and GOOD are not the same but the words have a somewhat similar although not interchangeable meaning. Taken together in the context of the remainder of the respective trade marks, however, the effect is to convey substantially the same net impression or meaning LOOK GOOD ... FEEL BETTER compared with LOOK GOOD + FEEL GOOD. We submit that the grammatical symbols ... and + do not add anything of substance or real identity and so do not materially aid in distinguishing between the respective marks.

It is also well accepted that for the purpose of trade mark comparison the beginning of trade marks is often more important given the tendency to slur the ending of words or expressions. In this case the first three substantial elements of each trade mark are identical LOOK, GOOD and FEEL. In each case, the first and second segments of the trade marks are co-joined by ordinary and non-distinctive grammatical configurations. In the case of the opponent's trade mark three stops and in the case of the opposed trade mark the plus sign (+).

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Whilst the opposed trade mark does feature the additional element (ROOT GOOD) it is a very easy matter to imagine that a consumer knowing the opponent's trade mark LOOK GOOD ... FEEL BETTER would be confused by imperfect recollection and would erroneously believe that the opposed trade mark LOOK GOOD + FEEL GOOD = ROOT GOOD was merely an extension of, or in some other way connected with the opponent's trade mark and the opponent's business and activities. The reason for this is, as we have stated, due to the very substantial and overriding visual, phonetic and conceptual similarities in the words and structure of the trade marks. The likely impression that the beginning and substantial part of each trade mark would make upon a consumer, would be the same.

However, I think that the error in her argument is to ignore the considerable weight that the expression ROOT GOOD will have in the applicant's trade mark. I have already considered the impact of this expression, with respect to s 42, and concluded that, as a

whole, the mark is not far short of scandalous. The applicant's mark is therefore unlikely, in my opinion, to be seen as an "extension" of the known trade mark LOOK GOOD ... FEEL BETTER. The latter presents a polished summary of how the opponent's program will operate, with a focus on the state of mind of the user. It will be seen as a smooth but somewhat indirect precis of the action and effects of the cosmetics or services in question, and/or recognised as the opponent's trade mark. The applicant's mark, on the other hand, has a very different overall impact. It is far from smooth and is evocative of either mathematical precision or, perhaps, of some possible language of our cave-dwelling ancestors. Either way, Ms Hill's second argument, about the significance, as a co-joiner, of the three dots between LOOK GOOD and FEEL BETTER ignores the bluntness of the applicant's A+B=C format.

If the opponent is to establish a ground of opposition under either s 44 or 60 - and it has the responsibility of doing so under s 55 - I would need to be satisfied that there is a significant risk of deception or confusion. (See the *Woolworths* decision previously cited.) Far from this, my conclusion is to the opposite.

Also, for the purposes of s 44 alone:

- no obstruction can arise from conflict with trade mark registration 883627, which has a priority date that is later than that of the applicant's trade mark
- nor am I satisfied that the applicant's goods in either class 3 or 25 are closely related to the class 41 education services for which 560210 is registered.

Conclusion;

No ground of opposition has been established. The application may proceed to registration on payment of the necessary fee unless, within one month of the date of this decision, the Registrar of Trade Marks is served with a copy of a notice of appeal. In the event of such an appeal, registration shall not occur until the appeal is either decided or discontinued. The applicant has taken no part in this opposition and is not entitled to an award of costs.

Terry Williams
Hearing Officer
Trade Marks Hearings