

TRADE MARKS ACT 1995

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

Re: Trade mark application number 958420 (35, 36 and 41) -
CONNECTEDTHINKING- in the name of PricewaterhouseCoopers LLP.

DELEGATE:	Rachel Dunn
REPRESENTATION:	Applicant Written submissions by Tim Clarke of Mallesons Stephen Jaques
DECISION:	Application rejected – section 41(5)

Background

1. Trade mark application number 958420 was filed on 19 June 2003 in the name of PricewaterhouseCoopers LLP (the applicant). The application was for registration of the term CONNECTEDTHINKING for the following services;

Class 35: Accounting and auditing services; tax advisory and consulting services; dispute analysis and investigation services; business recovery services; outsourcing services in the field of non-core business processes; human resources services; regulatory advisory services; business advisory services regarding corporate transactions, restructuring and consolidation; business and asset valuation advisory services; attestation services for non-financial data; provision of data and information on-line in the fields of accounting, auditing, tax, dispute resolution, business recovery, business process outsourcing, corporate transactions and business and asset valuation

Class 36: Financial advisory services; corporate finance advisory services; attestation services for financial data; provision of data and information on-line in the field of corporate finance

Class 41: Provision of data and information on-line in the field of corporate training; corporate training services

2. The application was duly examined under the *Trade Marks Act 1995* (the Act), three reports being issued in total. In each report the examiner held that the term

CONNECTEDTHINKING was not capable of distinguishing the applicant's services in terms of section 41(5). The ground for rejection was based on the contention that the term 'connected thinking' was in current use in the fields of business, finance and training and that the term was required to be used by other traders. The applicant provided submissions on several occasions and evidence of use, however the arguments advanced by the applicant were not found to be persuasive. The section 41(5) ground for rejection was subsequently maintained and the applicant requested a decision on the written record.

Submissions

3. Accompanying the request for a decision on the written record were further submissions from the applicant, and confirmation that the applicant sought to rely upon the evidence previously provided to the examiner. The cases of *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511; *Eastman Photographic Materials Co Ltd v Comptroller-General of Patents, Designs and Trade Marks* [1898]; *Big Country Developments Pty Ltd v TGI Friday's Inc* (2000) 100 FCR 358; *Chunky Trade Mark* [1978] FSR 322 and *Blount Inc v Registrar of Trade Marks* (1998) 83 FCR 50, among several others, were cited. Also, the state of the Register and the precedent formed by prima facie acceptance of earlier trade marks was noted. It was shown that the subject trade mark has achieved registration in many other jurisdictions. Finally, the submissions drew my attention to the presumption of registrability under section 33 of the Trade Marks Act 1995 and how I may have some reservations in the matter but still decide that the mark is capable of distinguishing.

The Law

4. Section 41 requires that a trade mark application must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services from the goods and/or services of other traders. A trade mark is capable of distinguishing if it passes the test of not being a trade mark that other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their own goods or services.

If the trade mark is only to some extent inherently adapted the Registrar may decide that it is not prima facie acceptable. However, a trade mark with some inherent adaptability may still be acceptable when the combination of its inherent adaptability and/or evidence of its use or intended use and/or any other circumstances are taken into account under the provisions of section 41(5). If the Registrar is satisfied that the trade mark is capable of distinguishing, section 33(1) binds the Registrar to accept the trade mark, provided there are no other grounds for rejecting it and that the application was made in accordance with the Act. If the Registrar is not satisfied that the trade mark is capable of distinguishing, and the applicant fails to show otherwise, the Registrar must reject the application in terms of section 41(2) and section 33(3).

5. The operation of section 41 was considered by Branson J in *Blount Inc v Registrar of Trade Marks* 40 IPR 498 (the *Oregon* case). Her Honour said that, in applying the provisions of section 41, and in deciding whether a trade mark is capable of distinguishing, it is open for the Registrar to conclude that the trade mark is to some extent inherently adapted to distinguish. However, there may be uncertainty on that basis alone, that the trade mark is actually capable of distinguishing the designated goods or services, and use or other circumstances will be needed to show the trade mark is capable of distinguishing. This is the case with the subject application as discussed below.

Discussion

6. The inherent adaptation of a trade mark to distinguish the goods of a trader is to be assessed with reference to the question of Kitto J in *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511, at 514, which may be summarised as follows:

The question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods.

7. The research shows a number of organisations in Australia using the term CONNECTED THINKING in relation to business and education services. The amount of organisations currently using the term in the marketplace in a descriptive fashion increases if wider searches are conducted showing the term has relevance both in the Australian market and overseas. CONNECTED THINKING is shown as a buzzword in the business industry to describe a method of working – one that fosters cooperative collective thought to the ultimate benefit of the company or organisation. Thus, traders are at the moment using the term in the ordinary course of their business without any evidence of improper motive and the trade mark is indeed caught by the provisions of section 41. That said though, clearly section 41(6) does not apply, as general business, financial, information provision and training services are not usually directly described by the method of synergistic collective thought that is CONNECTED THINKING. The trade mark falls under the provisions of section 41(5) and may still be acceptable when the combination of its inherent adaptability, evidence of its use, and worldwide registrations are taken into account.

Evidence and use and other circumstances

8. Significant evidence of use has been presented to support the term CONNECTED THINKING and its application in the marketplace as a trade mark. I make little of the fact that the term in use is generally CONNECTED THINKING whilst the trade mark as applied for is CONNECTEDTHINKING. The difference is minimal and does not impact upon the final decision due to the fact that the trade mark consists of two common English words that are in use at the moment as a business buzzword. Additionally, at times the term is used by the applicant as CONNECTED THINKING through the body of the evidence, for example:

We use our network, experience, industry knowledge and business understanding to build trust and create value for clients – we call this Connected Thinking.¹

9. Similarly, I place little emphasis on the fact that the vast majority of the evidence shows the term CONNECTED THINKING used in conjunction or near the house mark of

PRICEWATERHOUSECOOPERS or PwC or any other indicia of the applicant. It is common business practice now to utilise a trade mark in conjunction with a house mark of the company, and in this case it is quite clear that CONNECTED THINKING does not limp behind PRICEWATERHOUSECOOPERS.

10. However, there is little use by the applicant of the term in a trade mark sense. The term appears on the front page of many publications, and on the back page of some of these publications the applicant claims the term as a trade mark². There is minimal use of the trade mark to indicate any services, let alone to indicate the services claimed by the applicant as originating from the applicant. The evidence is also lacking information traditionally provided to show that the term does or will distinguish the services of the applicant from those of other traders. Evidence such as marketing expenditure on, and revenue gained from, the trade mark has not been provided, and whilst of course this is not automatically fatal to the application, it may be an indication of the difficulty faced by the applicant of showing use in trade for the term CONNECTEDTHINKING in connection with the services claimed. On the basis of the evidence provided I am not satisfied that the trade mark does or will distinguish the applicant's services of those of other traders.

11. Other circumstances in this case arise from the numerous overseas registrations that the applicant has obtained for CONNECTED THINKING. The subject trade mark has achieved registration for similar or the exact services as claimed in jurisdictions including New Zealand, the USA, Japan and Singapore. However in the UK the subject trade mark was withdrawn after a hearing, and a new application showing the trade mark as *connectedthinking has been examined but has yet to be finalised. Whilst this history of the trade mark indicates that the applicant is serious about protecting, and presumably, using the trade mark both here and overseas, in this case I still hold significant doubt about

¹ Annexure 28 to the declaration of James Collins dated 2 February 2006.

² See for example Annexure 18 to the declaration of James Collins dated 2 February 2006, wherein it states “*connectedthinking is a trade mark of PricewaterhouseCoopers LLP. Designed by studio ec4.”

CONNECTED THINKING's capacity to distinguish the claimed services in the Australian marketplace.

Presumption of registrability

12. I note the submissions made regarding the presumption of registrability under section 33 of the Trade Marks Act 1995 and how I do not need to be convinced beyond doubt of the application's capacity to distinguish before I can accept it for registration. In this case however I have serious reservations in the matter and I am not satisfied to any extent that the trade mark does or will in the future hold the capacity to distinguish.

Conclusion

13. I am not satisfied CONNECTEDTHINKING does or will distinguish the designated services. Therefore, I must reject the application under the provisions of section 33(3) and section 41(2) of the Act and hereby do so.

Rachel Dunn
Hearing Officer
Trade Marks Hearings
28 July 2006