



TRADE MARKS ACT 1995

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

Re: Trade mark application number 966566 (41, 42) - **EFILM**- in the name of EFILM, LLC.

DELEGATE:	Tabatha Klippan
REPRESENTATION:	Mr Wayne Willis, F B Rice & Co
DECISION:	Section 41 - trade mark application rejected

Background

1. On 18 August 2003, Efilm, LLC, ('the applicant'), applied to register the trade mark EFILM. The services claimed are as follows:

Class 41: Digital laboratory services, being digital imaging services, and dubbing services, namely, digital colour timing, laser film recording of digital video and high definition images to film, digital mastery services, digital imaging, digital and electronic manipulation of images, tape to film transfer services and recording digital images onto film.

Class 42: Digital laboratory services, being conversion of data or documents from physical to electronic media, namely high-resolution scanning of film to electronic digital media.

2. The trade mark application was examined and a ground for rejection in terms of section 41 of the *Trade Marks Act 1995* ('the Act') was raised. The examiner found that the letter 'e' is a prefix generally understood to refer to "electronic", and the trade mark EFILM is

therefore descriptive of the services claimed. Three adverse reports were issued before the applicant applied to be heard in the matter.

3. As a delegate of the Registrar of Trade Marks, I heard the matter in Sydney on 18 March 2005. Mr Wayne Willis of F B Rice & Co represented the applicant. No evidence of use was provided either during the course of examination or at the hearing.

Submissions

4. Mr Willis referred to section 33 of the Act and submitted that the examiner's ground for rejection was not fully supported by evidence, for example, by a dictionary definition or examples where the word is in use in a descriptive sense. Mr Willis further submitted that an Internet search does not necessarily prove that a phrase is descriptive or that a phrase has become generic.
5. Regarding the Internet search results which were included in the first report, Mr Willis argued that this material shows use of EFILM in relation to digital cameras and memory cards only. He further said that even if the word EFILM has gone into general use as a descriptor of memory cards, that does not make EFILM descriptive for the services claimed by the subject application. Mr Willis said the applicant's services "involve the manipulation of the goods" and also that they relate to "digital imagery", not the production and sale of digital cameras or memory cards for digital cameras.
6. Mr Willis stated that the combination of the letter 'e' and an actual object generally relates to the electronic version or format of that object. However Mr Willis argued that the word 'film' has no meaning which can be applied to the services claimed. He said that "the notion of an 'electronic film' is quite meaningless".
7. It was submitted by Mr Willis that the applicant uses EFILM as a reference to itself, not a reference to its services, and that it is simply branding its services with its own name and as a means of indicating the source of its services.

8. Finally, Mr Willis stated that the connection between the services and the “coined phrase” EFILM is tenuous and that the trade mark possesses sufficient distinctive character to be regarded as inherently capable of distinguishing.

Discussion

9. Subsection 41(2) of the Act provides that 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 from those of other traders. Subsection 41(3) provides that in deciding the question, the Registrar must first consider the extent to which the trade mark is inherently adapted to distinguish. If the Registrar finds the trade mark is to no extent inherently adapted to distinguish, then it is to be considered under the provisions of subsection 41(6). If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish, but it is not capable of distinguishing on that basis alone, then it is to be considered under the provisions of subsection 41(5). If, after consideration under the provisions of subsections 41(5) or 41(6), the Registrar is still not satisfied the trade mark is capable of distinguishing at some future time, or does in fact distinguish, then the application must be rejected.
10. In determining whether or not a trade mark may be regarded as being adapted to distinguish, Kitto J, in *Clark Equipment Co v Registrar of Trade Marks*, (1964) 111 CLR 511 said:

That ultimate question must not be misunderstood. It is not whether the mark will be adapted to distinguish the registered owner's goods if it be registered and other persons consequently find themselves precluded from using it. The question is whether the mark, considered quite apart from the effects of registration, is such that by its use the applicant is likely to attain his object of thereby distinguishing the goods from the goods of others.

11. And in *Registrar of Trade Marks v W. & G. Du Cros Ltd*, (1913) 30 RPC 660, Lord Parker of Waddington, said in relation to whether or not a proposed trade mark is adapted to distinguish:

The applicant's chance at success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of business and without improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.

12. According to The Macquarie Dictionary, there are many definitions of the word 'film', including "to direct, make, or otherwise engage in the production of films", "the creative art of film-making", "to reproduce in the form of a film or films" and "a film strip containing consecutive pictures or photographs of objects in motion presented to the eye, especially by being thrown onto a screen by a projector so rapidly as to give the illusion that the objects or actors are moving".
13. I note it was held in the *Heavenly* case (1967) RPC 306 that the Registrar was entitled to rely on his general knowledge of the use of language, because dictionaries could not always be up-to-date, and it would be wrong to allow words to be registered as trade marks if they were in common use in a way which disqualified them for registration, although such meanings had not found their way into dictionaries. It is common knowledge that the letter 'e' is a well known prefix for "electronic".
14. The *Trade Marks Office Manual of Practice and Procedure* states that:

A trade mark consisting only of the prefix "e" and a word or phrase which has a direct reference to the goods or services claimed will be considered to have little or no inherent adaptation to distinguish.

15. The applicant provides digital laboratory services which include the conversion of data or documents from physical to electronic media, the electronic manipulation of images, tape to film transfer services, recording of digital images to film, and the scanning of film to electronic digital media. Clearly these services are electronic in nature and they are

services which can only take place in an electronic environment. The trade mark is wholly descriptive in that it directly refers to the manipulation and production of the film by electronic means. EFILM is a term that other traders are likely to need to use to describe their similar services. It is not therefore prima facie capable of distinguishing.

16. In the absence of evidence of substantial use, or indeed any use, that might have established that the trade mark is capable of distinguishing the applicant's services, I find that the section 41 ground for rejection was well taken and maintained.
17. On the basis of all material on file and the submissions made at the hearing, I am not satisfied that the subject trade mark does or will at any time in the future be capable of distinguishing the services claimed.

Decision

18. I hereby reject trade mark application number 966566.

A handwritten signature in black ink, appearing to read 'TKlippan', with a horizontal flourish extending to the right.

Tabatha Klippan
Senior Examiner
Trade Marks Hearings
28 June 2005