



TRADE MARKS ACT 1995

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

Re: Proposed revocations of acceptance of trade mark applications 987983 and 970956
filed in the name of STM, Inc.

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| DELEGATE: | Ian Thompson |
| REPRESENTATION: | Applicant Michael Kirov, solicitor, Spruson & Ferguson |
| DECISION: | Section 38 – revocation – failure to search trade mark data base constitutes error and omission |

Background

1. The details of trade mark applications 987983 and 970956 are as follows:

Appn Number: 970956
Owner: STM, Inc
Priority Date: 18 September 2003
Goods: **Class: 29** Preserved, dried, frozen, tinned and cooked fruits and
vegetables; frozen vegetables; jellies, jams, fruit sauces and
compotes; eggs, milk and milk products; edible oils and fats;
preserves; prepared, tinned and frozen meals in this class; preserved
herbs; all prepared food products in this class
Trade Mark: BIRDS EYE STEAM FRESH

Appn Number: 987983
Owner: STM, Inc
Priority Date: 6 February 2004
Goods: **Class: 29** Preserved, dried, frozen, tinned and cooked fruits and
vegetables; frozen vegetables; jellies, jams, fruit sauces and
compotes; eggs, milk and milk products; edible oils and fats;
preserves; prepared, tinned and frozen meals in this class; preserved
herbs; all prepared food products in this class

Trade Mark:



2. A delegate has proposed revocation of the acceptance of the applications for registration. The applicant invoked its right to be heard in the matter of the proposed revocations in terms of section 203 of the *Trade Marks Act 1995* ('the Act'). As a delegate of the Registrar of Trade Marks, I heard the applicant's arguments in a hearing by teleconference in Canberra on 27 April 2004 - Mr Michael Kirov of Spruson & Ferguson of Sydney represented the applicant.

History

3. The application files show that, during the course of examination, the examiner performed searches for conflicting trade mark applications but only searched for prior potentially conflicting trade marks which include the words BIRDS EYE. The examiner did not search for prior potentially conflicting trade marks which comprise or include the words STEAM FRESH.
4. There is, however, a prior pending application (968990) by H J Heinz Company Australia Ltd which has been accepted for registration of the words STEAM FRESH in respect of, inter alia, the goods in respect of which the present applicant seeks registration.
5. This information should have been considered by the examiner before he accepted the applications and the revocations of acceptance have been proposed on the basis that the examiner's failure to conduct searches that would have located 968990 is an error or omission in terms of subsection 38(1)(a).

Submissions

6. The applicant filed Freedom of Information requests for these files and another application file and its submissions are based on what these FOI requests have revealed. The applicant argues that the only reason that the examiner could have had in not searching for conflicting registrations or applications which include or comprise the

words STEAM FRESH is that the examiner applied the reasoning in *Registrar of Trade Marks v Woolworths* [1999] FCA 1020 (29 July 1999) ('the Woolworths Metro Case').

Thus, the applicant argues, the examiner believed that the trade mark BIRDS EYE is notorious in relation to the goods and could be registered along with any other indicia such as STEAM FRESH in relation to the particular goods of the application.

7. The applicant argues that the examiner applied the same logic in relation to application 970836, also in the name of the applicant, which seeks registration of the words BIRDS EYE SIMPLY STEAM. An FOI by the applicant of that file reveals that the examiner searched only for conflicting trade marks in relation to that trade mark which comprise or contain the words BIRDS EYE and ignored the words SIMPLY STEAM.
8. Thus, argues the applicant, the examiner has consistently applied the same logic in relation to 987983(BIRDS EYE STEAM FRESH), 970956(BIRDS EYE STEAM FRESH) and 970836(BIRDS EYE SIMPLY STEAM), which obviously stems from the Woolworths Metro Case and this reveals that the acceptance of the applications for registration was as a result of a considered judgement and not as the result of an error or omission.

Reasons

9. Section 38 of the Act provides:

38 Revocation of acceptance

- (1) If, before a trade mark is registered, the Registrar is satisfied:
 - (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
 - (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;the Registrar may revoke the acceptance of the application.
Note: For limitations see section 6.
- (2) If the Registrar revokes the acceptance:
 - (a) the application is taken to have never been accepted; and

- (b) the Registrar must examine, and report on, the application as necessary under section 31; and
- (c) sections 33 and 34 again apply in relation to the application.

10. It is plain to me that the examiner should have searched for potentially conflicting trade marks which contain, or consist of, the words STEAM FRESH. I will discuss the reasons for this first in the context of the applicant's arguments. Then, I will discuss whether the examiner's approach to these applications constitutes an error or omission.

The Applicant's Approach

11. From the file, it is not possible to ascertain with any certainty the reasoning of the examiner. However, if, as the opponent has argued, the examiner had taken the ratio of the Woolworths Metro Case to be that a notorious trade mark, sought to be registered in conjunction with any other indicia, does not need to be searched against that other indicia, he would have been mistaken.
12. The underlying philosophy of the *Trade Marks Act 1995* is that ANY sign, no matter how lacking in inherent distinctiveness, can become registered as a trade mark if the owner has used it to the extent that it has become distinctive in fact of the goods or services in respect of which it is used: *Blount Inc v Registrar of Trade Marks* (1998) 80 FCR 50. Trade marks such as WHOPPER (*Burger King Corporation v Registrar of Trade Marks* (1973) 128 CLR 417) (or, indeed, STEAM FRESH if the words in reality lack any inherent distinctiveness) may now, if they have been used to the extent that they distinguish the owner's goods or services, be registered as trade marks.
13. On this most fundamental level, the examiner's assumption (if it were such) that he should not have to search for the words STEAM FRESH is quite clearly wrong and flawed. It might well have been that, whatever the correctness of the examiner's perceptions of the

inherent qualities of the putative or nascent trade mark STEAM FRESH, another person had shown that the words had become distinctive in fact of their goods.

14. Moreover, if the examiner had thought that he was applying the ratio in the Woolworths Metro Case, he would have been wrong in this as well. The ratio in the Woolworths Metro Case was not that the owner of any notorious trade mark can subsume any other trade mark into his notorious trade mark and have it registered on the basis that the presence of notorious portion of the trade mark distinguishes the trade marks from each other. The ratio was that the notoriety of a trade mark can be taken into account in the comparison of trade marks. However, even at this level, the test implies that there is another trade mark present in the comparison - the examiner, for whatever reason, did not search for this other trade mark.

15. In *C A Henschke & Co v Rosemount Estates Pty Ltd* [2000] FCA 1539 (31 October 2000), the Full Bench of the Federal Court, at paragraph 52, restricted the operation of the principle in the Woolworths Metro Case to being a factor which may be considered in relation to the so-called "doctrine of imperfect recollection". The Court said:

Woolworths was not an infringement case and, of course, the notoriety taken into account was not any notoriety attaching to marks already registered (or marks applications for which had been lodged before the Woolworths application); the notoriety attached to an element of the mark for registration of which Woolworths had applied. Nevertheless, in our view, Woolworths suggests a proposition for which the cases on which the appellants rely may be taken as authority. It is that, in assessing the nature of a consumer's imperfect recollection of a mark, the fact that the mark, or perhaps an important element of it, is notoriously so ubiquitous and of such long standing that consumers generally must be taken to be familiar with it and with its use in relation to particular goods or services is a relevant consideration.

16. Thus, the examiner, if he thought that the Woolworths Metro Case lent support for his actions, would have been wrong. Again, the more limited test in *Henschke* implies that there is another trade mark present in the comparison and the relevance of the ratio in

Woolworths Metro is limited to the doctrine of imperfect recollection. The examiner had not searched for this other trade mark, or considered it.

17. I will add now that this decision makes no finding upon the issue of whether the trade mark BIRDS EYE is notorious or has a reputation.

Error or Omission

18. In *Re Application by Remington Products Inc* (1990) 18 IPR 251 (the Smooth and Silky case) (to which Mr Kirov drew my attention) Deputy Registrar Hardie reasoned that the reconsideration of acceptance, or the conclusion that the judgement to accept ought to have been exercised in a different way, does not warrant revocation on the basis of "error". If the objection is the result of nothing more than a difference in opinion between trade mark officers, or a change of mind on the part of a trade mark officer, then revocation of acceptance of the application is not possible.
19. Here, however, the examiner has not exercised his judgment in the comparison of trade marks since the comparison of trade marks never occurred. For a judgement to have been exercised in the acceptance of the application, all relevant potential citations should have been before the examiner. This decision concerning the proposed revocations, from this viewpoint, is not according to the merits of the appropriateness of the citation of the prior STEAM FRESH application, but stems the fact that the potential citation ought to have been considered as a part of the examiner's exercise of judgement in accepting the application.
20. I do not think that examiner's position (whatever its justification) in not searching for the words STEAM FRESH as a trade mark is open to argument- the acceptances are quite

plainly mistaken as to the facts on which they were based – these being incomplete as to the facts that should have been before the examiner.

21. The examiner made the decision to accept the applications without all of the material facts in front of him - in very much the same way that an examiner might have missed a dictionary definition: *Shop-Vac Corp's Appn* (1990) 19 IPR 65. Whether, as the applicant has suggested, the examiner made a conscious decision not to look for some of the relevant facts is irrelevant for the purposes of my decision here. A decision to accept an application in the absence of this relevant information is a mistake.
22. Thus I would add a qualifier to the remarks of the Deputy Registrar in the Smooth and Silky Case, to the effect that where an acceptance occurs, absent the basic principles of research and examination such that proper examination has not occurred and the necessary information upon which judgement might be exercised is not before a delegate, an error or omission (or both) has occurred.

Decision

23. I therefore direct that if there is no appeal from these reasons and decision notified within one month of the date of these reasons, acceptance of applications 970956 and 987983 be revoked one month from the date of the decision.

Ian Thompson
Hearing Officer

28 May 2004