

# PROOF OF DISTINCTIVENESS IN AUSTRALIA AND EVIDENCE BEFORE AUSTRALIAN TRADE MARKS OFFICE AND COURTS

## Is it necessary to walk on your head in the Antipodes?

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# WHAT IS THE AUSTRALIAN DEFINITION OF A TRADE MARK?

Under Australian law, the definition of a trade mark is a sign used, or intended to be used, **to distinguish goods or services** dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person

# APPLICATION FOR REGISTRATION & EXAMINATION

- One of the grounds on which an application can be rejected is that the mark **lacks distinctiveness**
- If a trade mark lacks distinctiveness, that is also a basis for removal of a trade mark after registration

# WHAT IS DISTINCTIVENESS?

- Distinctiveness is the capacity of a trade mark to distinguish the goods or services of one trader from those of another
- Consideration is given to the question of ***“whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same trade mark, or some trade mark so nearly resembling it, upon or in connection with their own goods”***

# WHAT IS DISTINCTIVENESS

- Concept of Inherent Adaptation – it is necessary to consider the extent to which the trade mark is inherently adapted to distinguish the goods or services for which registration is sought

# WHAT IS DISTINCTIVENESS

All trade marks the subject of trade mark applications will fall into one of three categories:

1. trade marks that are sufficiently inherently adapted to distinguish and are therefore prima facie capable of distinguishing;
2. trade marks that have some limited inherent adaptation to distinguish but are not prima facie capable of distinguishing; or
3. trade marks that have no inherent adaptation to distinguish.

# WHAT IS DISTINCTIVENESS – MARKS WITH INHERENT DISTINCTIVENESS

Trade marks that are sufficiently inherently adapted to distinguish include:

- SURNAMES that are not commonplace
- SUPERSEDED GEOGRAPHIC NAMES that have no connection with the goods such as BYBLOS
- MOST COINED WORDS such as KODAK, SURELOCK (Class 12), CLICKFAST (Class 6), TRAKGRIP (Class 12)
- EXPRESSIONS not in common use in respect of the goods and/or services: OFF THE WALL (Class 25), CHOOKEY POOH (Class 1), THE COOL CONDITIONERS (Class 31), MUSCLE MACHINE (Class 28), PORKY BITS (Class 29)



# WHAT IS DISTINCTIVENESS

Trade marks that are sufficiently inherently adapted to distinguish include:

- UNLIKELY GRAMMATICAL CONSTRUCTIONS particularly those that incorporate a misspelling such as SHOPRITE (Class 42), BESAFE (Class 9), BEEF GRO (Class 5), GROWOOL (Class 1), SAFEVUE (Class 12), BI-LO (Class 42)
- SLOGANS with only indirect reference such as COLOUR ME BEAUTIFUL (Class 3), PARDON OUR SCAFFOLDING (Class 6)
- Logos and artistic works and logos and designs



# WHAT IS DISTINCTIVENESS – MARKS WITH SOME LIMITED CAPACITY TO DISTINGUISH

Trade marks that have some limited inherent adaptation to distinguish but are not prima facie capable of distinguishing are registrable.

Examples include:

- CHUNKY for dog food
- SHEEN applied to cotton

# WHAT IS DISTINCTIVENESS – MARKS WITH NO INHERENT DISTINCTIVENESS

Trade marks that are considered **not to any extent** inherently adapted to distinguish the designated goods/services from the goods or services of other persons include those that:

- are presently in common use and serve directly to designate the goods or services; or
- are otherwise clearly required by other traders in the ordinary course of their business.

Single colours are considered to have no inherent adaptability to distinguish.

# WHAT IS DISTINCTIVENESS

Trade marks that have no inherent adaptation to distinguish the goods or services of one trader from those of other traders include words which are:

- major geographical names like OREGON, MICHIGAN and OXFORD;
- highly laudatory words like PERFECTION and BEAUTIFUL;
- words which are apt for normal description of the goods or services concerned as WHOPPER for hamburgers

# WHAT IS DISTINCTIVENESS

Guidance in determining capacity to distinguish:

*“trade marks that are not inherently adapted to distinguish are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or the time or production of goods or rendering or services”.*

# WHAT IS DISTINCTIVENESS

- Virtually all trade marks are nonetheless potentially registrable under Australian legislation. Even trade marks with no inherent adaptation to distinguish can be registered
- It is even possible to register a single colour.

# PROVING DISTINCTIVENESS

## HOW TO OVERCOME “LACK OF DISTINCTIVENESS” OBJECTION

Where a trade mark has a “limited inherent adaptation to distinguish” but is not prima facie capable of distinguishing, then it may be able to be registered if there is proof filed at the Trade Marks Office of the applicant’s use or intended use of the trade mark in Australia

The evidence can relate to use before or after the trade mark application was filed

# PROVING DISTINCTIVENESS

## HOW TO OVERCOME “LACK OF DISTINCTIVENESS” OBJECTION

Where a trade mark has “no inherent adaptation to distinguish” then it may be able to be registered where there is proof filed of the applicant’s use of the trade mark in Australia

All use relied upon must have occurred prior to the filing date of the application

A number of years of use of the trade mark (at least 5 or more) in Australia are usually required for there to be a sufficient level of use or if the use has been over a shorter period then there must have been a very high level of use and promotion



# PROVING DISTINCTIVENESS

## HOW TO OVERCOME “LACK OF DISTINCTIVENESS” OBJECTION

The Examiners may consider the following criteria when determining if the evidence of use filed at the Trade marks Office is sufficient to establish a claim of acquired distinctiveness by the applicant:

- Sales, volume, or revenue from services
- Length and scope of use prior to filing
- Geographical area of sales of goods or provision of services under or by reference to the mark
- Extent of advertising featuring the mark

# PROVING DISTINCTIVENESS

## HOW TO OVERCOME “LACK OF DISTINCTIVENESS” OBJECTION

The Examiners may also consider the following criteria of acceptance of a claim of acquired distinctiveness by the applicant:

- Degrees of popular awareness of the mark among the consuming public (by survey(s), statements by customers, retailers, competitors etc); and
- Ownership of prior registrations for the same mark in connection with the same or similar goods or services

# PROVING DISTINCTIVENESS - EVIDENCE

## ADMISSIBILITY OF EVIDENCE

In the Australian common law legal system, there are two different levels of proof in trade marks matters:

1. At the Trade Marks Office (“TMO”) level, the TMO is not bound by the rules of evidence, and can accept evidence in almost any form. It may even accept hearsay evidence.
2. The Trade Marks Office has a very wide discretion as to what evidence to accept.
3. Where an application has been refused and an appeal is taken to a court, or where an opposition is appealed to a Court, the strict rules of evidence bind the Courts. By way of example, hearsay evidence is not acceptable.

# PROVING DISTINCTIVENESS - EVIDENCE

4. In Court cases, the evidence must be direct evidence from persons with direct knowledge.
5. Opinion evidence from experts who prove their expertise is also admissible in Courts
6. Opinion evidence from non-experts is not admissible
7. Survey evidence can be useful but rarely is determinative

# MARKS INHERENTLY ADAPTED TO DISTINGUISH

- TGI FRIDAY'S Class 43: Food and beverage
- CRUSH Class 33: Wine
- KODAK Class 9: Cameras
- FERMI Class 9: Cyclotrons
- PRADA Class 25: Clothing
- ROMEO Y JULIETTA Class 34 - Cigars

# MARKS WITH SOME ABILITY TO DISTINGUISH

- Levi's red tab Class 25: Jeans
- CAREERBUILDER Class 35: Employment agency services

# MARKS WITH NO INHERENT ABILITY TO DISTINGUISH, BUT REGISTRABLE ON PROOF OF USE

- Colour marks
  - Veuve Clicquot's "Yellow" for wines
  - Cadbury's purple colour for chocolates
- Shape marks
  - Weber kettle-shaped barbecue



# DISTINCTIVE TRADE MARKS



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