When can a ‘descriptive’ word be registered as a trade mark?

It seems that the answer depends on the factors which a decision maker may take into account.

If a word is to be registered as a trade mark, it must be distinctive. Distinctiveness must either be inherent (or inherently adapted to distinguish) or be acquired through demonstrating a sufficient amount of use.¹

The recent Federal Court decision of Mastronardi Produce Ltd v Registrar of Trade Marks² clarifies the approach to take under the Trade Marks Act 1995 (Cth) (the Act) when assessing whether a trade mark is inherently adapted to distinguish and, therefore, capable of registration in its own right.

Whilst the decision overturns the rejection of a trade mark application by the Registrar of Trade Marks (IP Australia) on the basis that IP Australia considered the mark to be a varietal name (and, therefore, lacking sufficient inherent distinctiveness), it has broader relevance. In particular, the decision provides useful guidance as to the factors which are required to be taken into account when considering whether any mark is, inherently registrable as a trade mark.

In essence, the decision confirms that actual past use or otherwise of a mark is not relevant when determining whether it is inherently registrable as a trade mark.

Factual background

The decision concerned an appeal to the Federal Court by the applicant (Mastronardi), a Canadian company which produces wholesale fruits and vegetables, against the rejection of a trade mark application by IP Australia.

Mastronardi filed an application to register the word ZIMA as a trade mark on 25 July 2011 in relation to tomatoes (the trade mark). IP Australia rejected the application on the basis that the trade mark had been used in respect of a single variety of tomato and that, at times, ZIMA had been used as the actual name of the variety (ie in a descriptive sense rather than as a trade mark) in marketing material.

In other words, the application was rejected on the basis that the trade mark had not been used as a trade mark in the past but had instead been used as a varietal name. This past use was cited as being a bar to registration.

Mastronardi’s appeal was successful. The Federal Court found that the trade mark was inherently registrable as a trade mark.

Issue

IP Australia’s rejection was on the basis that ‘ZIMA’ referred ‘to a single kind of tomato plant and its fruit’ and that it ‘lacks any inherent adaptation to distinguish the Applicant’s tomatoes as it appears to be an appropriate description of the goods in respect of which it is to be used’. In reaching this conclusion, IP Australia was influenced by its finding that the trade mark had been used in respect of a variety of tomato and that, at times, ZIMA had been used as the actual name of the variety (ie in a descriptive sense rather than as a trade mark) in marketing material.

The Federal Court, however, confirmed that the analysis in order to determine whether a trade mark is inherently distinctive under the TMA ought not involve considering the actual use of the trade mark or otherwise:

‘Inherent adaptability is something which depends on the nature of the trade mark itself…and therefore is not something that can be acquired; the inherent nature of the trade mark itself cannot be changed by use or otherwise’.³

As such, Justice Gordon considered the following two questions:

- How would ZIMA, at the time of application, be understood by ordinary Australians seeing it for the first time used in respect of tomatoes?
- How likely will other tomato traders think of the word ZIMA and want to apply it to their tomatoes?

Therefore, factors which are extraneous to the mark itself ought to be discarded when...
considering whether a mark is inherently adapted to distinguish (ie whether the mark is inherently capable of being registered as a trade mark).

Decision

In finding that ZIMA was inherently distinctive, Justice Gordon was influenced by the fact that there were a number of descriptors which other traders could use to describe the tomatoes, such as ‘golden snacking tomatoes’, and that other suppliers could apply their own brand name to those tomatoes.

What does it mean?

The decision is a useful reminder of the proper analysis which ought to be undertaken when assessing whether a mark is inherently registrable as a trade mark.

In particular, factors such as the actual use or otherwise ought to be discarded.

It may be prudent to review existing and previous key trade mark applications which have been objected to on this basis.

Further comments

Lawyer, Michelle Agromito, contributed to this article.

1 Section 41(1) of the Trade Marks Act 1995 provides that an application to register a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant’s goods and services from the goods or services of other traders. If the trade mark is insufficiently inherently adapted to distinguish (and therefore rejected under s 41(1)), registration is still possible by demonstrating sufficient use of the trade mark.

2 [2014] FCA 1021

3 Quoting Gibbs J in Burger King v Registrar of Trade Marks (1973) 128 CLR 417 at 424.

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Forward to a colleague