TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO: 2131497
BY AUSTRALASIAN CONFERENCE ASSOCIATION LIMITED
T/A SANITARIUM HEALTH FOOD COMPANY
TO REGISTER A TRADE MARK
IN CLASS 29.

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DECISION AND GROUNDS OF DECISION

On the 2nd of May 1997 and claiming an International Convention priority date of the 8th of January 1997 from Australia, Australasian Conference Association Limited trading as Sanitarium Health Food Company of 148 Fox Valley Road, Wahroonga, New South Wales, 2076, Australia, applied under the Trade Marks Act 1994 for registration of the trade mark TODAY'S GOURMET in respect of:

> "Cooked, dried, frozen or preserved vegetables; vegetables; cooked, dried, frozen or preserved fruits; cooked, dried, frozen or preserved meals, including meals which contain vegetables or fruits; food products made from or containing vegetables or fruits; patties, including vegetable patties; soup, including vegetable soup; and all other goods in this class".

The words "and all other goods in this class" were subsequently deleted from the application and I need make no further mention of this point.

Objection was taken to the mark under paragraphs (b) and (c) of Section 3(1) of the Act, on the grounds that it consists of a sign which is devoid of any distinctive character and which may serve in trade to indicate, for example, foods prepared in an up to date style for people of today who enjoy good food.

At a Hearing at which the applicants were represented by Ms L Harland of Reddie & Grose their agents, the objections were maintained and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to provide a statement of the reasons for my decision. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The relevant parts of Section 3(1) of the Act read as follows:

"The following shall not be registered-

> (b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services."

The mark consists of the two common dictionary words "Today" (in its possessive form) and "Gourmet". The words are so well known as to require little further explanation. However, for the sake of completeness, Collins English Dictionary (third edition 1994) defines the words as follows:

TODAY: 1. this day, as distinct from yesterday or tomorrow. 2. the present age: children of today.

GOURMET: a person who cultivates a discriminating palate for the enjoyment of good food and drink.

At the Hearing and in subsequent correspondence, Ms Harland argued that the words when used on the goods were clearly meaningless. Ms Harland also argued that the mark did not offend Section 3(1)(c) of the Act because in her view, "the words Today's Gourmet do not convey any message or provide any indication as to any characteristic of the goods". In addition, Ms Harland concluded that the mark did not offend Section 3(1)(b) of the Act, as in her opinion, it was not devoid of any distinctive character.

In my view and when used either on, or in proximity to the goods for which registration is sought, the meaning the words "Today's Gourmet" are likely to convey to the general public are, here we have a range of contemporary or fashionable foodstuffs of superior quality,. i.e., fit for a gourmet. That being the case, the mark clearly offends Section 3(1)(c) of the Act, as it consists exclusively of words which may serve in trade to indicate the kind or quality of the goods. As the mark offends Section 3(1)(c) of the Act, it follows that I also consider the mark to be devoid of any distinctive character and as such also open to objection under Section 3(1)(b) of the Act. I would add here that at the Hearing, Ms Harland urged me to consider use of the mark on the goods. My view then (as now) is that one must also consider use of the mark in the context of advertising and promoting the goods, and in this respect, I referred Ms Harland to the decisions in the NEXT and ALWAYS cases (1992 RPC 455) and (1986 RPC 93) respectively, in which the use of a mark in an advertising context was specifically considered.

Also, and since the Hearing was held, Mr Simon Thorley QC acting in his capacity as the Appointed Person in the DAY BY DAY application No: 2068646, supported this general approach. When considering whether other traders would wish to use the words DAY BY DAY in relation to milk products, either on the goods or in an advertising context, Mr Thorley said:

> **"He suggested that it was not an expression which a trader would naturally wish to use on packaging for milk products. In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising milk products and both Mr James and I responded to Mr Onslow's challenge to consider a natural**

descriptive use of the expression Day by Day in the ordinary course of trade in relation to milk products.

Mr James suggested that it would be perfectly natural for other traders to wish to use the expression as part of a commendation of products delivered as opposed to purchased at the supermarket.

"Don't rely on a weekly shop, have it delivered fresh day by day".

I do not believe this in unnatural. Likewise I suggested use of the expression "take day by day to provide the required daily in-take of vitamins" on the packaging of a vitamin enriched milk product"."

I think many of the same considerations mentioned in the DAY BY DAY case apply equally to this application. In my opinion, the words "Today's Gourmet" are likely to be legitimately required by others in trade in much the same way as the words DAY BY DAY. Examples of such use might be:

"Come to us for today's gourmet products".

"Today's gourmet products at everyday prices".

The possibilities are endless. Moreover, I have to consider what the likely impact would be on other businesses if the mark was registered. In the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

"**Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 551 at 517 in the following terms:**

"That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd's Trade Mark Application* [1954] RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence"."

And in the LAURA ASHLEY trade mark (1990) RPC 539, Robin Jacob QC (as he then was) said:

> **"What the Registrar has to have in mind is what monopoly is being created. He has to ask himself, as a guardian of the public interest, whether that monopoly will interfere with the legitimate rights of others, not only of today, but "tomorrow and the day after tomorrow", to use Viscount Simonds' vivid expression, YORKSHIRE Trade Mark (1953) 71 RPC."**

Ms Harland also drew my attention to a range of marks which had been accepted in the past which, in her view, were as distinctive as the applicant's mark. The marks referred to are shown below, together with the basis of their acceptance. Clearly some of the marks are quite different to this application, others have been accepted on the basis of acquired distinctiveness and others carry disclaimers to complete combinations of words (see 4 and 6 below), or, (I presume) where the Registrar felt the combination of words was sufficiently unusual, to the elements in the mark separately (see 3, 5, 8 9, and 10 below).

(1) 418724 "GOURMET" - Class 32.

(2) 730130 "GOURMET AND DEVICE" - Class 29.

Disclaimer of the device of a boar's head.

(3) 1340315/1340316 "GOURMET EXPRESS" - Classes 29 and 30.

Separate disclaimers of the words "Gourmet" and "Express".

(4) 1379922 HOME GOURMET AND DEVICE" - Class 30.

Disclaimer of the words "Home Gourmet"

(5) 1448230/1448231 "KID GOURMET" - Classes 29 and 30.

Separate disclaimers of the words "Kid" and "Gourmet".

(6) 1502195/1502196 "GOURMET PASTA AND DEVICE - Classes 29 and 30.

Disclaimer of the words "Gourmet Pasta".

(7) 1458628 "GOURMET DOG AND DEVICE" - Class 30.

Separate disclaimers of the words "Gourmet" and the device of a "knife, fork and plate".

(8) 1534367 "GLOBAL GOURMET" - Class 29.

Separate disclaimers of the words "Global" and "Gourmet",

(9) 1544160 "GOURMET THINS" - Class 30.

Evidence of use filed, separate disclaimers of the words "Gourmet" and "Thins".

(10) 1588792 "OCEAN GOURMET" - Class 29.

Separate disclaimers of the words "Ocean" and "Gourmet".

(11) 1551624 "GOURMET CUISINE AND DEVICE" - Class 30.

Evidence of use filed, application converted to 1994 Trade Marks Act.

(12) 2108019 "GOURMET HARVEST" - Class 29.

(13) 2019032 "GLOBAL GOURMET" - Class 30.

Irrespective of these prior acceptances, it is well settled that each mark must be considered on its own merits. Mr Justice Jacob said in the TREAT trade mark case (1996) RPC 281:

> **"In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."**

Ms Harland has also drawn to my attention the fact that the mark has been accepted for registration in Australia. While I note this acceptance, it does not assist me in accepting this application.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application, and, for the reasons given, it is refused under the terms of Section 37(4) of the Act, because it fails to qualify under paragraphs (b) and (c) of Section 3(1) of the Act.

Dated this 2 day of July 1998.

C J BOWEN
for the Registrar
the Comptroller General