

DECEPTIVE MARKS

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This Work Manual Chapter (Version 4.1) has been updated on 11 November 2022. This update seeks to ensure that the cited legislation and corresponding references in the chapter are current, as a result of the legislative amendments and fee updates implemented on 29 April 2022. There are no substantive amendments made to the previous Version 4, November/2020.

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1 INTRODUCTION

An objection under section 7(4)(b) will be raised if because of some connotation or sign contained in the mark, the use of the trade mark in relation to the goods or services claimed in the application would be likely to deceive the public.

Considerations under this subsection relate to the matter within the trade mark that could deceive the relevant buying public. The deception could arise in regard to:

- a characteristic of the goods or services such as their composition, nature or other properties;
- the quality or quantity of the goods or services;
- the geographical origin of the goods or services;
- the intended use or purpose of the goods or services; or
- the endorsement or licence of the goods or services by a person or organization.

An objection may be raised under this subsection even if the mark does not consist exclusively of the deceptive element.

2 RELEVANT LEGISLATION

Trade Marks Act 1998 (2020 Rev. Ed.)

Absolute grounds for refusal of registration

7 —(4) A trade mark must not be registered if it is —

...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

3 THE TEST FOR DECEPTIVENESS

In deciding whether an objection under section 7(4)(b) should be raised, the Registrar will look at the following factors:

(a) Is there a false implication?

A trade mark may be deceptive if it includes a word or sign which is descriptive of any of the characteristics of the goods or services but the characteristic is not in fact present. The following are some scenarios in which a characteristic of the goods or services may be implied.

- (i) Descriptive words or devices conjoined with another word or device. For example, STEELSCREWS for metal hardware will suggest that the screws are made of steel.
- (ii) A word which is phonetically similar to a descriptive word may also suggest a property of the goods or services. For example, ORLWOOLA for suits would suggest that the suits are made of all wool.
- (iii) Marks which consist of a geographical name may cause consumers to associate the mark with the geographical origin of goods. This is especially so if the place concerned has a reputation for the particular goods, for example FRANCE or PARIS for perfumery or SRI LANKA for tea.

However, where the geographical name in a trade mark only has a fanciful association, (for example MISS AMERICA for textiles), the mark will be registrable.

Where the words "Made in XYZ" or "Product of XYZ" appear in the trade mark, it is a clear indication that the geographical origin of the goods is XYZ. However, there are trading standards governing the use of this kind of indication in the marketplace, and therefore, the Registrar will not question the veracity of that indication unless it appears from the specification or the evidence of use lodged that the goods are made elsewhere.

- (iv) The presence of a geographical name in a trade mark to be used in respect of services is much less likely to be taken as an indication of the origin of the services. But there may be occasions when the appearance of a geographical name in a trade mark to be used in respect of services suggests that the services are of a particular nature, for example, SWEDISH for massage services.

(b) Are prospective purchasers likely to believe in the false statement?

There must be a real tangible danger of the buying public being deceived by the misrepresentation. However, if there is no realistic possibility of deception, the objection need not be raised.

In *Imperial Tobacco Co. (of Great Britain & Ireland) (1915) 32 RPC 361*, Warrington L.J. said:

“I ask myself first of all without knowing anything more about the case, but treating myself as I think that I am entitled to do, as a man who knows something about the ways of the world and the ways of trades people, and the ways of people who buy goods, whether if I saw the Prince of Wales Feathers used as a trade mark on a packet of goods, it would suggest to me that that meant to represent, or was calculated to lead to the belief that the person who has put that trade mark on the goods held some special warrant of authority from the Prince of Wales? I do not think that it would be for a moment. What it would suggest to me would be, that the man thought that it was an attractive trade mark which would make his goods not only attractive, but more than that, would distinguish his goods from those of other people in the same trade, being used as a trade mark.”

There are a number of factors to take into consideration when assessing whether the use of a trade mark is likely to be deceptive when used in respect of goods. These include:

(i) The nature of the goods.

Are they:

- readily inspectable? If they are then this lessens the likelihood of deception occurring.
- of an immediately apparent composition? If they are, then this also lessens the likelihood of deception.
- very cheap and therefore likely to be casually inspected prior to purchase?
- expensive and hence carefully inspected prior to purchase?

(ii) The nature of the ordinary persons purchasing the goods.

Are they:

- persons with some special training, such as doctors, engineers or scientists?
- likely to be some social group? For example, children will have limited consumer education in respect of some goods and/or services (e.g. financial services) but in others, such as electronic games and other playthings, they may

have very specific knowledge of products constituting the market and may constitute the majority of actual purchasers, or at least will have a large input into such purchases.

(iii) The likely nature of the transaction. For example, some transactions may offer less opportunity to inspect goods.

These include:

- mail-order
- television vending
- goods ordered by telephone
- over-the-counter, as opposed to supermarket, sales

4 REGISTRAR'S PRACTICE

(a) Descriptions of goods/services

If a trade mark as a whole is distinctive, the mere fact that the trade mark contains a sign describing a particular type of goods in the specification, does not mean that the trade mark will encounter an objection under section 7(4)(b) or a bad faith objection for a broad specification. For example, GRAHAMS OLIVE OIL for “cooking oil” is acceptable. The Registrar will not request that the specification be restricted. This is because there is no apparent contradiction in the mark and the specification and the Registrar will assume that the applicant will either use the mark on olive oils or he will vary the mark in use.

However, if there is an apparent contradiction between the mark and the goods claimed in the specification, for example, GRAHAMS OLIVE OIL for “vinegar”, a section 7(4)(b) objection may be raised.

(b) Packaging sizes

The Registrar will not question the veracity of references to packaging sizes in a trade mark, if the mark as a whole is distinctive. Such references are dealt with by other commercial practices in the marketplace.

(c) Other desirable quality of the goods

The Registrar will raise an objection in the following cases as the marks indicate a particular desirable quality of the goods:

CUDDLY LAMB deceptive for “bags” if the bags were not made of lambskin

SILK JOY deceptive for “clothing” if the clothing is not made of silk

5 OVERCOMING SECTION 7(4)(b) OBJECTIONS

Section 7(4)(b) objections may be overcome by:

- **Limiting the specification of goods or services**

The applicant may amend the application to limit the goods or services covered by the application so that the goods or services for which the mark would be deceptive are no longer claimed. For example, the limitation may be to include the words "...; all made of lambskin." or "...all manufactured in ...".