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ALBERTO-CULVER COMPANY

v.

ADMINISTRATOR-GENERAL

B

[SUPREME COURT, 1972 (Goudie J.), 7th, 19th April]

Appellate Jurisdiction

Trade marks—refusal of registration—whether words had “direct reference” to character of goods—burden of proof—Trade Marks Ordinance (Cap. 212) s.8(1) (d).

C

The Registrar of Trade Marks refused registration of a mark consisting of the words “THE NATURAL ONE” in respect of “cosmetics and toiletry products, including hair sprays”, on the ground that the mark had direct reference to the character of the goods, contrary to paragraph (d) of subsection (1) of section 8 of the Trade Marks Ordinance. On appeal to the Supreme Court —

D

Held: 1. Whether the words “direct reference” in section 8(1) (d) of the Trade Marks Ordinance apply to a mark is largely a question of fact in each case and in deciding this question the mark must be examined, not in its strict grammatical significance but as it would represent itself to the public at large.

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2. The words “THE NATURAL ONE”, were not meaningless but would lead the public to believe (or were so intended) that the particular product would give a woman “the natural look” and that any other product would make a woman look less natural, and therefore less beautiful.

Per curiam: If the case were a borderline one (which it was not) having regard to the burden of proof the court would not be prepared to disturb the decision of the Registrar.

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Cases referred to:

Bestform Foundations Incorporated v. Commissioner of Trade Marks [1957] N.Z.L.R.574.

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Re J. & P. Coats Limited's Application [1936] 2 All E.R.975; 155 L.T.127.

Yorkshire Copper Works Ltd. v. Registrar of Trade Marks [1954] 1 All E.R.570; [1954] 1 W.L.R.554.

Re Keystone Knitting Mills Trade Mark [1929] 1 Ch. 92: 140 L.T.9.

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Appeal to the Supreme Court from the refusal of the Registrar of Trade Marks to register a trade mark.

R. L. Munro for the appellant.

A D. I. Jones for the respondent.

The facts sufficiently appear from the judgment.

19th April 1972

GOUDIE J.:

B The appellant Company is appealing from the decision of the Registrar of Trade Marks refusing registration of a mark consisting of the words "THE NATURAL ONE" in respect of "Cosmetics and toiletry products, including hair sprays." The Registrar held that the mark was "not a registrable one as it has direct reference to the character of the goods." He then referred to "paragraph (d) of subsection (1) of Section 8 of the Trade Marks Ordinance. (Cap. 212 Laws of Fiji, 1967 Revised Edition.)

C Section 8(1) (d) of this Ordinance reads as follows:—

"8(1) A registrable trade-mark must contain or consist of at least one of the following essential particulars:—

.....

D (d) a word or words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname."

In the instant case no geographical name arises, nor was the objection that the mark referred to the "quality" of the goods.

E The sole issue is, therefore, whether the appellant has shown that the words "THE NATURAL ONE" have no direct reference to the character of the goods.

On the question of the burden of proof I refer to *Bestform Foundations Incorporated v. Commissioner of Trade Marks* [1957] N.Z.L.R.574, in which McCarthy J. used these words:—

F "It will be seen from what I have said above that I have formed a definite view. If I were in doubt, I would resolve that doubt by supporting the Commissioner's decision. The nature and scope of a decision of a Commissioner of Trade Marks have been the subject of numerous judicial dicta, and it is well established that such a decision should not be lightly disturbed. Lord Wright, when Master of Rolls, in *Re J. & P. Coats Limited's Application* [1936] 2 All E.R. 975, 980, says "prima facie the registrar's decision will be regarded as correct"; and Lord Simonds L.C. in *Re Yorkshire Copper Works Limited's Application* [1954] 1 All E.R.570; says in relation to an appeal on the issue of distinctiveness: "And, if it were a borderline case, which it is not, I think that a Court, to which an appeal is brought from the Registrar, though, no doubt, it must exercise its own discretion in the matter, should be slow to differ from the experienced official whose constant duty it is to protect the interests of the public not only of today but of tomorrow and the day after. In uttering this warning I only repeat what has been said more than once in this House."

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The word "character" may be used in numerous differing ways but (inter alia) the Shorter Oxford English Dictionary defines it as meaning "a feature, trait, characteristic". Consulting the meaning of these synonyms it will be found that word "feature" has special reference to form or shape, particularly of the body and face; the word "trait" means (inter alia) a line or lineament of the face; the word "characteristic" means a distinctive mark; a distinguishing peculiarity or quality.

I have carefully considered the effect of the words "direct reference" as explained in *Halsbury*, 3rd Edition, Volume 38 at page 521 paragraph 864, "whether a word has such a direct reference is largely a question of fact in each case. In deciding this question the tribunal has to examine the mark not in its strict grammatical significance but as it would represent itself to the public at large who are to look at it and to form a view as to what it connotes." (*Re Keystone Knitting Mills Trade Mark* (1929) 1 Ch. 92, C.A.).

It is to be noted that the word "Charm" in relation to "ladies hosiery, stockings, and other similar goods" was held in the aforementioned case to have a direct reference to the character of the goods. In that case the mark had been registered but the Court was moved to expunge it from the Register on this ground, the Court did so, and the trial Judge was upheld on appeal.

I have carefully considered all the cases cited for and against registration, and the examples of words held to have no direct reference and words held to have direct reference at paragraphs 865 and 866 of *Halsbury* (supra).

I am unable to accept the submission of learned Counsel for the appellant that the words "THE NATURAL ONE", as applied to cosmetics, toiletries, and hair spray are "in themselves quite meaningless." If they were, I do not consider that the appellant would be going to all this trouble to have them registered and, when refused registration, to appeal against such refusal.

I must look at this matter from the point of view of the "public at large" to decide what they would think the words connoted. Unfortunately, the "public at large" in this instance must mean ladies of the public generally since they are the persons to whom the words in the mark are obviously directed. It is not a simple matter for a man to decide what "most women" would think was the meaning to be attached to a particular phrase. However I must do my best.

I think they would be led to believe, or at least a direct attempt is being made to lead them to believe, that this particular product professes to give a woman "the natural look" and that any other product would make a woman look less natural, and therefore, in the case of most women, less beautiful. It seems to me to be a clear case of the appellant Company attempting to characterize its product. But, if it were in any sense a border-line case, which I do not think it is, I would not be prepared to disturb the Registrar's decision since I am unable to conclude either in fact or in law that his decision was necessarily wrong.

The appeal is dismissed with costs.

Appeal dismissed.