

Is it the distinctiveness of the essential feature that really matters?

Posted on 09/06/2009 by [Kate Duckworth](#)

Another decision of the Intellectual Property Office of New Zealand (IPONZ) further indicates that the essential feature test, as set out in *De Cordova v Vick* (1951) 68 RPC 103, is on its way out in relation to assessing the similarity of marks.

As discussed in an earlier article dated 7 November 2008, the decisions of the hearings officer of IPONZ relating to *PUREBABY v BABY* T19/2008 and *ULTRA v ULTRA LAMP* T10/2007 indicate that even if a mark is wholly contained within another mark, it may still be possible to argue that the marks are not confusingly similar, at least in cases before IPONZ.

In the recent decision of TIMARU BLUESTONE and a Stonehenge type device in class 19 in the name of Timaru Bluestone Industries Limited, IPONZ objected to registration on the basis that the mark was confusingly similar to the series word mark BLUE STONE; BLUESTONE also in class 19 and 37. IPONZ stated that the element of the applicant's mark that predominated both visually and phonetically is the word "bluestone" and that this is the main idea behind the mark. Further, IPONZ contended that the Stonehenge device simply reinforces the concept of "blue stone" and the word "Timaru" simply refers to the origin of the goods (Timaru being a town in New Zealand).

The applicant sought a hearing and the hearings officer, in denying that TIMARU BLUESTONE device was similar to the word mark BLUE STONE; BLUESTONE, said that the marks looked and sounded different and as such conveyed an entirely different idea.

The hearings officer concluded that the Stonehenge device, was the dominant part of the applicant's mark, that the presence of TIMARU ensured that the marks were phonetically different, and as such the idea conveyed was different.

Despite the cited series mark, BLUESTONE; BLUE STONE, being subsumed within the applicant's mark, the hearings officer considered that IPONZ had not given an appropriate weighting to the descriptiveness of the words "bluestone" and "blue stone." In reaching his decision, the hearings office placed significant weight on the fact that he considered the subsumed mark lacked inherent distinctiveness as the dictionary defines "blue stone" as inter alia, a bluish-grey stone used for building. There did not appear to be any evidence that blue stone was a common term in trade in New Zealand.

The lack of inherent distinctiveness of the subsumed mark was a point much laboured by the hearings officer. This argument is hard to reconcile with the fact that the subsumed mark was registered in the first instance, and a registered trade mark is prima facie evidence of the validity of the trade mark. While the hearings officer is entitled to consider whether the term is common to the trade, the hearings officer has in effect ruled the trade mark invalid, without being asked to determine its validity.

This developing body of case law suggests that owners of registered trade marks may be unable to prevent their competitors from registering a trade mark which wholly contains their registered trade mark.

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