



TRIED, TESTED AND WON!

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CLARKEKANN'S RECENT SUCCESS FOR PACIFIC MAGAZINES IN TRADE MARK DISPUTE

Media giants, Pacific Magazines (*New Idea* and *That's Life!*) and Bauer Media (*Woman's Day* and *Australian Women's Weekly*) recently came face to face in a trade mark hearing regarding use of the phrase "Test Kitchen".

Both magazines have extensively used the phrase "Test Kitchen" in their respective publications for decades and both have registered trade marks for their respective brands (e.g. AUSTRALIAN WOMEN'S WEEKLY TEST KITCHEN and NEW IDEA TEST KITCHEN). Taking it one step further, in 2011, Bauer applied to register the phrase "TEST KITCHEN" as a trade mark, which would give them a monopoly over the term.

One essential principle when it comes to trade marks is that descriptive words, with ordinary meanings, cannot generally be registered as trade marks. Bauer persuaded IP Australia that its use of the phrase "Test Kitchen" in *Australian Women's Weekly* over time meant that the phrase was solely associated with Bauer. On this basis, IP Australia accepted and advertised the mark in the Official Journal of Trade Marks pending registration.

ClarkeKann, on Pacific's behalf, then filed opposition proceedings to prevent registration of the mark.

THE OPPOSITION

IP Australia's Hearing Officer handed down his decision on 5 August 2015 in Pacific's favour which determined

that the phrase "Test Kitchen" is descriptive and not capable of being registered as a trade mark in respect of publications, such as magazines and cookbooks. The decision was a result of a lengthy analysis of use of the phrase TEST KITCHEN by Bauer, Pacific and third parties. The nature of that use and, in particular, whether it might be characterised as "trade mark use", i.e. a badge of origin or sign intended to be associated with a particular trader, was the crux of the opposition.

Pacific's position in the opposition was simple. Essentially, they argued that TEST KITCHEN is not capable of distinguishing the relevant goods and services (magazines) from the goods and services of other persons. Further, other traders will want, or need to, use the phrase "test kitchen" in the course of providing those goods and services.

DESCRIPTIVE TRADE MARKS DIFFICULT TO REGISTER

The Hearing Officer found that TEST KITCHEN lacked any inherent adaptability to be registered as a trade mark. He considered that other persons in the publishing industry will think of the phrase TEST KITCHEN and want to use it connection with recipes and food, without improper motive. In other words, other traders are not trying to take advantage of an established brand or reputation, but rather want to use the phrase because it forms part of the common language in the industry.

Everyone can now rest assured knowing that the recipes they read in *New Idea* will have been tried and tested in the "Test Kitchen"... and you won't have to go to the *Women's Weekly* to find the only "Test Kitchen"!

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