

Burger King Corporation v Registrar of Trade Marks [1973] HCA 15

HIGH COURT OF AUSTRALIA

GIBBS J

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The applicant, Burger King Corporation, which is incorporated under the laws of Florida, one of the United States of America, made application for the registration of the word "**whopper**" as a trade mark in Pt B of the Register of Trade Marks in respect of "all goods in class 30 including sandwiches". The Registrar of Trade Marks refused the application and the present appeal is brought from his refusal.

Under the *Trade Marks Act 1955-1966 Cth* ("the Act") provision is made for the registration of trade marks in Pt B of the Register by s. 25 (1) which reads as follows:

A trade mark is registrable in Part B of the Register if it is distinctive, or is not distinctive but is capable of becoming distinctive, of goods in respect of which registration of the trade mark is sought and with which the applicant for registration is or may be connected in the course of trade.

The term "distinctive" as used, not only in this section, but also in s. 24, which deals with registrations under Pt A, is defined by s. 26 (1) and (2) which provide:

(1) For the purposes of this Act, a trade mark is not distinctive of the goods of a person unless it is adapted to distinguish goods with which that person is or may be connected in the course of trade from goods in respect of which no such connexion subsists, either generally or, where the trade mark is sought to be registered, or is registered, subject to conditions or limitations, in relation to use subject to those conditions or limitations.

(2) In determining whether a trade mark is distinctive, regard may be had to the extent to which—

- (a) the trade mark is inherently adapted so to distinguish; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark does so distinguish.

The applicant proposes that the word "**whopper**", if registered as a trade mark, will be used in Australia together with another expression, "**home of the whopper**", in connexion with restaurant services and particularly in connexion with hamburger sandwiches and the sale thereof. The word has not hitherto been used by the applicant in Australia. However, "**whopper**" is registered as a trade mark in the United States of America and certain other countries and has been extensively used in connexion with the sale of the applicant's products—

and particularly hamburger sandwiches—in the United States of America where, according to the evidence, the trade mark is widely known as indicating the hamburger sandwiches of the applicant only. According to one of the affidavits filed on behalf of the applicant, "the hamburger sandwiches marketed and to be marketed under the trade mark **"whopper"** have an element of distinctiveness by virtue of their size in that it is the largest sandwich of this type marketed by a major fast food franchising company". The applicant also uses in the United States of America and elsewhere the trade mark **"home of the whopper"**, but an application for the registration in Australia of that expression as a trade mark appears to have lapsed and no decision in relation to it is called for in the present proceedings.

In support of this appeal the applicant has filed an affidavit by Mr. D. J. O'Hearn, a lecturer in English at the University of Melbourne, who refers to a number of standard dictionaries in which discussions of the etymology of "whopper" and definitions of that word are to be found. The word is derived from the middle English "wap" (sometimes spelt "whop") meaning to beat or strike and according to the Oxford English Dictionary "whopper" still has the secondary meaning of "one who whops" (i.e. apparently, strikes). However, the dictionaries show that since the end of the eighteenth century the primary meaning of the word has been "something uncommonly large of its kind", and that it is also used specifically to mean "a great lie, a monstrous falsehood". Mr. O'Hearn asserts that it is at least arguable that the latter is now the primary meaning of the word. There does not seem to me to be a great deal of support for that argument but assuming it to be correct there is no doubt that the word is commonly used and understood in the sense of "something unusually large of its kind".

The applicant sought by evidence to establish three propositions: (1) that the word "whopper" cannot be said to be descriptive of goods in class 30 and, in particular, of hamburger sandwiches; (2) that the word, if used in respect of the applicant's goods, is capable of becoming distinctive of them as indicating a connexion in the course of trade between those goods and the applicant; and (3) even if "whopper" refers only to size or bulk, it does not have any direct reference to the character or quality of the goods to which it is applied. Opinions as to these matters were expressed in the affidavit of Mr. O'Hearn and also in the affidavits of six other persons, three of whom are grocers who carry on business in Victoria and three of whom are scientists, experienced in the field of food technology or food standards. The evidence on the third of these matters, as to whether the word directly refers to the character or quality of the goods, was irrelevant. It was directed to an issue that might have arisen under s. 24 (1) (d) of

the Act if the registration of the word had been sought under Pt A of the Register, but that provision has no application where the registration is sought under Pt B. However, the evidence of the opinions of the witnesses on all these matters was clearly inadmissible. It was put forward as expert evidence. The rules relating to the admissibility of the testimony of experts was stated in the following passage from Smith's Leading Cases, which was adopted by Dixon C.J. in *Clark v. Ryan*:¹

On the one hand, it appears to be admitted that the opinion of witnesses possessing peculiar skill is admissible whenever the subject-matter of inquiry is such that inexperienced persons are unlikely to prove capable of forming a correct judgment upon it without such assistance, in other words, when it so far partakes of the nature of a science as to require a course of previous habit, or study, in order to the attainment of a knowledge of it; while, on the other hand, it does not seem to be contended that the opinions of witnesses can be received when the inquiry is into a subject-matter, the nature of which is not such as to require any peculiar habits or study in order to qualify a man to understand it.

The matters of inquiry in the present case, whether the word "whopper" was descriptive or whether it was capable of becoming distinctive, or, if that had been relevant, whether it directly referred to the character or quality of the goods, were not those upon which only a person possessing special skill or knowledge would be competent to hold an opinion. The evidence tendered was not designed to show that "whopper" has any technical or scientific meaning which needs to be explained by an expert, nor was it directed to show the conditions in the trade in the course of which hamburger sandwiches are sold to the public. It was simply evidence of the conclusions drawn by the witnesses on matters on which the Court is equally qualified to draw an opinion and in one instance on the very question which the Court is called upon to decide. I reject this evidence.

A question of admissibility also arises in relation to the evidence as to the applicant's trade outside Australia. In my opinion the evidence that "**whopper**" was registered as a trade mark in other jurisdictions is irrelevant because the fact that a registrar or some other official, in some other jurisdiction, and governed by another system of law, concluded that the word is registrable is no evidence that the word has the characteristics that would entitle it to registration under s. 25 of the Act: cf. *Re Ford-Werke AG.'s Application*.² On the other hand,

¹ (1960) 103 C.L.R. 486, at p. 491.

² (1955) 72 R.P.C. 191, at p. 195.

the evidence that the word has been extensively used in the United States of America and has there become widely known as indicating the goods of the applicant only, is in my opinion in a different situation. On this point counsel for the Registrar referred me to certain authorities whose effect is summed up in the following passage from the judgment of Tomlin J. (as he then was) in Impex Electrical Ltd. v. Weinbaum,³ which has been accepted, by this Court as well as in the United Kingdom, as a correct statement of the law (see *Re Notox Ltd.'s Application*;⁴ *Re Gaines Animal Foods Ltd.'s Application*;⁵ *de Cordova v. Vick Chemical Co.*,⁶ and *The Seven Up Co. v. O.T. Ltd.*⁷):

For the purpose of seeing whether the mark is distinctive, it is to the market of this country alone that one has to have regard. For that purpose foreign markets are wholly irrelevant, unless it be shown by evidence that in fact goods have been sold in this country with a foreign mark on them, and that the mark so used has thereby become identified with the manufacturer of the goods.

Those cases are authority for the proposition that in deciding whether a mark is distinctive, user within the jurisdiction only is to be taken into account. However, in the present case the question is a different one, namely, whether evidence of user overseas is admissible on the issue whether a trade mark is capable of becoming distinctive. On principle it would seem to me that evidence that a trade mark has in fact become distinctive in one market tends to show that it is capable of becoming distinctive in another market, at least if conditions in the two markets are similar. In *Re Ford-Werke AG.'s Application*,⁸ Lloyd-Jacob J., in dealing with an appeal from the Registrar's refusal to enter a trade mark in Pt B of the Register, said that the words "capable of distinguishing" in s. 10 (2) of the *Trade Marks Act 1938 UK* mean in the United Kingdom market, and went on to say:⁹

The fact that in a number of overseas markets in which the applicants have introduced their mark, no other traders have sought to use one confusingly similar does not and cannot establish that in this country, where the applicants have not used their mark, some other trader does not use, or may not desire to use, these or two resembling letters.

Similarly, I consider that "capable of becoming distinctive" in s. 25 (1) means in the Australian market, but I see nothing in his Lordship's remarks to cause me to depart from the view that

³ (1927) 44 R.P.C. 405, at p. 410.

⁴ (1930) 48 R.P.C. 168, at p. 178.

⁵ (1951) 68 R.P.C. 178, at p. 179.

⁶ (1951) 68 R.P.C. 103, at p. 107.

⁷ (1947) 75 C.L.R. 203, at pp. 215, 216.

⁸ (1955) 72 R.P.C. 191.

⁹ (1955) 72 R.P.C., at p. 196.

evidence that a mark has become distinctive in an overseas market will be admissible as tending to show that the mark is capable of becoming distinctive in Australia, provided at least, as I have said, that there is some similarity in the conditions of the two markets. In the present case there was no evidence as to the similarity or otherwise of conditions in the trade relating to hamburger sandwiches in the United States of America and in Australia, but the evidence was not objected to on this ground and it may perhaps be assumed that some similarity does exist. The evidence tendered as to the distinctiveness of the mark in the United States of America is somewhat uninformative and lacking in detail but it does in my opinion provide some basis on which I can conclude that the trade mark is capable in fact of distinguishing the applicant's goods in Australia.

Section 25 (1) of the Act permits registration in Pt B of the Register of a trade mark if it is distinctive, or is capable of becoming distinctive, of goods in respect of which the registration is sought and with which the applicant is or may be connected in the course of trade. Since, on the evidence, "**whopper**" is not in fact distinctive in Australia the question for decision is whether it is capable of becoming distinctive of goods—particularly hamburger sandwiches—in respect of which the registration of the trade mark is sought and with which the applicant may be connected in the course of trade. The Act does not provide an express statement, similar to that contained in s. 10 (2) of the *United Kingdom Act*, of the factors to be considered in deciding whether a trade mark is capable of becoming distinctive. It does however state, in s. 26 (2), the two matters that fall for consideration in deciding whether a trade mark is distinctive, and in deciding whether a trade mark is capable of becoming distinctive it becomes necessary to consider whether the trade mark is capable of meeting in the future the tests stated in s. 26 (2). That sub-section requires two matters to be considered, inherent adaptability to distinguish and distinctiveness in fact acquired by use or otherwise. When the question is whether the trade mark is capable of becoming distinctive, no difficulty arises about the nature of the inquiry so far as concerns the second of these matters; the inquiry becomes whether the trade mark is capable in fact of distinguishing the goods, by reason of future use or other circumstances. However, as to the first matter the inquiry remains the same as that which is to be made when the issue is whether the trade mark is distinctive, that is, whether the trade mark is inherently adapted to distinguish the goods. Inherent adaptability is something which depends on the

nature of the trade mark itself—see *Clark Equipment Co. v. Registrar of Trade Marks*¹⁰ —and therefore is not something that can be acquired; the inherent nature of the trade mark itself cannot be changed by use or otherwise. Under the *United Kingdom Act* the question whether the trade mark is inherently adapted to distinguish arises only on applications under Pt A of the Register and the question that arises under Pt B is whether the mark is "inherently capable of distinguishing". In a passage approved by the Court of Appeal in "*Weldmesh*" Trade Mark,¹¹ Lloyd-Jacob J.¹² expressed the difference between the two ideas as follows:

It is, therefore, not unreasonable to regard the two expressions "adapted to distinguish" and "capable of distinguishing" as being deliberately chosen so as to direct the particular inquiry aright, the former emphasising that it is because of the presence of a sufficient distinguishing characteristic in the mark itself that distinctiveness is to be expected to result, whatever the type and scale of the user, and thus secure an estimation of a positive quality in the mark; and the second that, in spite of the absence of a sufficient distinguishing characteristic in the mark itself, distinctiveness can be acquired by appropriate user, thereby overcoming a negative quality in the mark.

I am not concerned with the difficulties that arise under s. 10 (2) of the *United Kingdom Act* but would point out that in Australia, where the Act is significantly different, an inquiry as to the inherent adaptability of the trade mark must be made where the question is whether the trade mark is capable of becoming distinctive as well as when the question is whether it is in fact distinctive.

In the present case, on the basis of the evidence already mentioned, I am prepared to conclude that "**whopper**" is capable, by reason of use, of distinguishing the applicant's goods. On the other hand, I hold that the word is not inherently adapted to distinguish them. "Whopper" is an ordinary English word. Although, as I have said, it can be used in a number of different senses, when applied to a hamburger sandwich it can naturally only be understood as having one meaning, namely, that the hamburger sandwich is uncommonly large. That would not be a peculiar or unfamiliar use of the word and it would indeed appear on the evidence that it is the meaning in which the applicant wishes it to be understood. The word so applied would clearly, in my opinion, be descriptive; it would not give a complete description of the goods but would describe one of their characteristics, namely, their size. Moreover, it would, I think, be used in

¹⁰ (1964) 111 C.L.R. 511, at p. 515.

¹¹ [1966] R.P.C. 220, at p. 227.

¹² [1965] R.P.C. 590, at p. 595.

a laudatory sense since, in general, a person buying a hamburger sandwich might be expected to feel that he would get more satisfaction or better value for his money from a large rather than a small one. It is in any case a word which a person selling a hamburger sandwich which he claimed to be larger than that normally sold might use in the ordinary course of business and without any improper motive. In *Clark Equipment Co. v. Registrar of Trade Marks*,¹³ Kitto J. said that the question whether a mark is adapted to distinguish is to

be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives—in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess—will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

The word "whopper" is not inherently adapted to distinguish the goods of a particular trader, but is a word which a trader might, without any improper motive, want to use to describe his goods if they were of unusual size.

The effect of s. 26 (2) is that the two factors mentioned must both be weighed but the authorities show that the primary inquiry is whether the word is inherently adapted to distinguish the goods in respect of which registration is sought, and that if it is simply a laudatory or descriptive epithet, registration will generally be refused even if there is evidence of such user as has in fact rendered the word distinctive of the applicant's goods: *Yorkshire Copper Works Ltd.'s Application*;¹⁴ *Samuel Taylor Pty. Ltd. v. Registrar of Trade Marks*.¹⁵ In accordance with this approach, registration under Pt B was refused in respect of a word which was not inherently adapted to distinguish the goods, notwithstanding that it had been extensively used: *Clark Equipment Co. v. Registrar of Trade Marks*.¹⁶ The words there had a geographical signification but Kitto J. pointed out,¹⁷ that a descriptive word would be in like case. In the present case, where there has been no user whatever in Australia and the word for which registration is sought is simply descriptive, and not inherently adapted to distinguish the applicant's goods, the conclusion is inevitable that the Registrar was right in refusing registration.

¹³ (1964) 111 C.L.R., at p. 514.

¹⁴ (1953) 71 R.P.C. 150.

¹⁵ (1959) 102 C.L.R. 650, at pp. 657-658.

¹⁶ (1964) 111 C.L.R. 511.

¹⁷ (1964) 111 C.L.R., at p. 515.

The appeal will be dismissed with costs.