

[HIGH COURT OF AUSTRALIA.]

JOSEPH BANCROFT & SONS CO. . . . APPELLANT ;

AND

REGISTRAR OF TRADE MARKS . . . . RESPONDENT.

*Trade Mark—Word mark—“ Miss America ”—Registration sought in respect of cotton and rayon fabrics—No direct reference to character or quality of goods—Not according to ordinary signification geographical name or surname—Entitlement to registration—Trade Marks Act 1905-1948 (No. 20 of 1905—No. 76 of 1948), s. 16 (1) (d).*

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*Held*, that the words “ Miss America ”, having no direct reference to the character or quality of textile products, particularly rayon fabrics, and not being according to their ordinary signification a geographical name or surname, fall within s. 16 (1) (d) of the *Trade Marks Act* 1905-1948 and are entitled to registration as a trade mark in class 24 in respect of such products.

Dec. 9.  
Williams,  
Kitto and  
Taylor JJ.

Decision of the Registrar of Trade Marks, reversed.

APPEALS from the Registrar of Trade Marks.

On 16th May 1952 Joseph Bancroft & Sons Co., an American company, made application under the *Trade Marks Act* 1905-1948 for the registration of the words “ Miss America ” as a trade mark in class 24 in respect of textile products, particularly cotton fabrics, fabrics made of mixed cotton and rayon in which cotton predominates included in class 24 and also in class 31 in respect of textile products, particularly rayon fabric, fabrics made of mixed rayon and cotton in which the rayon predominates and nylon treated fabrics included in class 31. The Deputy Registrar of Trade Marks refused both applications.

From this refusal the company brought the present appeals to the High Court.

The relevant facts appear fully in the judgment of the Court hereunder.



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*G. B. Thomas*, for the appellant. The mark is not descriptive of the goods covered by the application. Secondly, it has no direct reference to the character and quality of the goods. Thirdly, it is distinctive within s. 16 (2) and fourthly, there is no substantial reason why the mark should be refused registration. The claim for registration is made under s. 16 (1) (d) and the words "Miss America" are not according to their ordinary signification a geographical name or a surname. They do not signify a geographical name because they indicate a person not a place, and by surname is meant a name commonly or ordinarily used as a surname. The idea that anything worn by the lady bearing the title of "Miss America" takes her name is not a practical idea, and the fact that a notable person uses a particular article does not entitle the manufacturer or seller to call that article by that person's name or title. The registrar erred in that he failed to keep in the forefront of his mind that the goods to which it is sought to apply the mark are piecegoods. The matter may be tested by seeing what would be conveyed to the potential purchaser of the goods under this mark. If the words "Miss America" were used on a roll of cotton piecegoods it would not suggest that Miss America used it or patronised it. [He referred to *In re Holt & Co.'s Trade Mark* (1); *In re Imperial Tobacco Co. (of Great Britain & Ireland) Ltd.'s Trade Marks* (2).] Trade marks are chosen because of their appeal and the fact that there is a reference in them to a person holding any particular office is not sufficient to bar registration in the sense that either the goods were made, used or patronised by that person. The registration of this mark would not prevent a trader from describing his goods as suitable to be used by Miss America. The only monopoly granted by registration is the monopoly in the use of the word as a trade mark and to prohibit other persons from using the mark as a trade mark to indicate origin. [He referred to *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (3).] No trader would be embarrassed, if these marks were registered, in advertising his goods for what they are. He would merely be prevented from using the words as a trade mark. The application should be allowed to proceed.

*R. J. Ellicott*, for the respondent. The words "Miss America" have a direct reference to the character or quality of the goods. They are descriptive of the nature of the fabric to which they are applied and suggest either that the fabrics are fit for Miss America

(1) (1896) 13 R.P.C. 118, at p. 121.  
(2) (1915) 32 R.P.C. 40, at pp. 48,  
49, 50; (1915) 32 R.P.C. 361,  
at pp. 374, 375.

(3) (1956) 95 C.L.R. 190, at pp. 202,  
203.



to wear or that she patronises or uses them. The words are suggestive of high quality, the only reasonable inference to be drawn by a member of the public from their use being that this lady would only patronise goods of high quality. The words are further used in a geographical sense in that they suggest a miss from America and constitute a geographical name within s. 16 (1) (d) in that they refer directly to a place and seek to use that reference in relation to goods. Alternatively, the words in the circumstance of their use are a surname. The mark is not distinctive in the sense that it distinguishes or is adapted to distinguish the appellant's goods. The words are the title given to the winner of a widely publicised beauty contest and because of their nature they have a direct nexus in the public mind with goods of the type in respect of which registration is sought. There is no evidence of use of the mark by the appellant, nor is there any suggestion that the appellant has any connexion in America with the sponsoring of Miss America. If they have no direct reference they have an indirect one and that is a circumstance which calls for consideration in determining distinctiveness. There is material before the Court to suggest that other traders have used the words "Miss America" in relation to similar types of goods and might leave it open to the inference that other traders may be using it in relation to the exact type of goods. In all the circumstances the Court will regard the words as nothing more than another name for high quality.

[WILLIAMS J. Is there any case where the word being within s. 16 (1) (d) registration has been refused on the ground that being a pseudonym they might nevertheless be not adapted to distinguish?]

There are *dicta* to that effect in *In re National Cash Register Co.'s Application* (1) and *In re Boots Pure Drug Co. Ltd.'s Application* (2). The mark is deceptive within s. 114 of the *Trade Marks Act* 1905-1948 and registration should be refused on that ground. [He referred to *Southern Cross Refrigerating Co. v. Toowoomba Foundry Pty. Ltd.* (3).] There may be deception because the mark is similar to that used by another on goods of the same description or because the mark leads the public, to whose protection s. 114 is directed, to think that something is true which is in fact untrue. The deception here is of the latter kind. Registration of the words "Miss America" would lead to the public being deceived into thinking (a) that the name "Miss America" is being used with the consent of the holder for the time being of the title, or (b) with the

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(1) (1917) 34 R.P.C. 273, at p. 281.  
(2) (1937) 54 R.P.C. 327, at p. 336.

(3) (1954) 91 C.L.R. 592, at pp. 607,  
608.



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consent of the sponsor of the contest, or (c) that the goods in question were used or patronised by Miss America for the time being. [He referred to *Radio Corporation Pty. Ltd. v. Disney* (1).]

[KITTO J. referred to *Radio Corporation Pty. Ltd. v. Disney* (2). There is no such evidence here.]

There is evidence that there is one Miss America at any particular time and the use of the words in question would lead an ordinary member of the public to believe that she had granted her patronage to any goods to which her title was attached. The user of this mark would lead to a reasonable belief that the goods were used or patronised by Miss America. As this is not the case the Court will protect the public and not permit the registration of the mark.

*G. B. Thomas*, in reply.

*Cur. adv. vult.*

Dec. 9.

THE COURT delivered the following written judgment:—

On 16th May 1952 the appellant applied under the *Trade Marks Act* 1905-1948 to register the words "Miss America" as a trade mark in class 24 in respect of textile products, particularly cotton fabrics, fabrics made of mixed cotton and rayon in which cotton predominates included in class 24 (application No. 109908) and also in class 31 in respect of textile products, particularly rayon fabrics, fabrics made of mixed rayon and cotton in which the rayon predominates, and nylon treated fabrics included in class 31 (application No. 109909). The Deputy Registrar of Trade Marks refused both applications.

He refused application 109908 on 26th November 1956 but the appeal was not instituted until 1st February 1957. Under reg. 75 of the *Trade Mark Regulations* an appeal to this Court may be instituted within twenty-one days after the date of the decision appealed against, or such further time as the Court, on application made within such twenty-one days, allows. No application was made within the twenty-one days to extend the time for instituting the appeal so that this appeal is incompetent and an order was made for its dismissal.

The deputy registrar gave his decision refusing application 109908 on 16th January 1957. The appeal from this decision was instituted on 1st February 1957 and therefore within time and the hearing of this appeal has been proceeded with. It is an appeal direct from the registrar to the Court without any appeal to the law

(1) (1937) 57 C.L.R. 448, at pp. 454, 456, 457, 458, 459. (2) (1937) 57 C.L.R., at p. 453.



officer under s. 35 of the Act. The duty of the Court upon such an appeal has been discussed on many occasions, the last of which is *Eclipse Sleep Products Inc. v. Registrar of Trade Marks* (1), judgment in which was delivered on 3rd December 1957. Briefly stated the Court is under a duty upon the appeal to decide the question whether the application should be refused or accepted for itself although in doing so it will attach very considerable importance to the opinion of such an experienced officer as the registrar or deputy registrar.

Section 16 (1) of the Act provides that "A registrable trade mark must contain or consist of at least one of the following essential particulars". Five paragraphs follow setting out these particulars, one being that included in par. (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". The appellant contends that the words "Miss America" fulfil the conditions of this paragraph. They are words which have no direct reference to the character or quality of the goods and are not according to their ordinary signification a geographical name or a surname. The deputy registrar, however, as we understand his reasons, thought that the words were outside the paragraph because they were descriptive words which had a direct reference to the character or quality of the goods. He also held that they were likely to deceive within the meaning of s. 114 of the Act and should not be registered on this ground. It was also contended before us that, even if the words were *prima facie* registrable because they complied with s. 16 (1) (d), they were nevertheless not adapted to distinguish the goods of the applicant from those of other persons and that the registrar has a discretion not to register a proposed trade mark even though it contains one of the essential particulars set out in pars. (a), (b), (c) and (d) of s. 16 (1) of the Act if he is of opinion that it is still not distinctive. In his reasons the deputy registrar commenced by upholding the opinion of an examiner in a letter of 3rd November 1955 that "the registration of this mark would be tantamount to granting to one trader the monopoly of a term which should be freely open to any trader to use in its descriptive sense for purposes of advertising his goods." He then said: "It is, I think, obvious that the mark sought is not one which is capable of serving to distinguish the goods of any one trader . . . . It is quite obvious in my opinion that persons are given the appellation 'Miss America' for some particular purposes varied though those purposes might be. One of these

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obvious purposes of course is for the purpose of exploiting female glamour, deportment, grace and beauty in order to enhance trade and the business of traders. That fact is well known and I have no doubts whatever that the purchasing public appreciates the fact that a trader who is able to claim that a person who has been named as 'Miss America' used his goods and yet retains her loveliness, is a most fortunate trader because his goods vicariously achieve a hall-mark of quality and become famous . . . . I had little doubt that there are many instances where traders have claimed the distinction of furnishing material worn by a person entitled to call herself 'Miss America' and I have no doubts whatever that in the future many other traders will strive to achieve the same distinction. As I see it, every trader has the right to claim or aspire to claim that his goods have been patronised by Miss America and I think that such traders should have the right to make that claim in respect of their goods and that they should not be put in a position of defending their rights to claim this hall-mark. I can only regard this application as one which is an attempt by one trader to expropriate the use of a term which should be open to all traders qualified to use it . . . . I find that the applicant's mark is incapable of distinguishing the applicant's goods from those of other traders entitled to claim that their goods had been patronised by a person entitled to call herself 'Miss America'. Furthermore, I am satisfied that the applicant's mark is not entitled to registration as a trade mark because it would put some traders in the position of defending their use of that which it is their right to use."

It appears that there is an annual competition held in the United States of America in order to choose from those young ladies who compete that one who in the opinion of the judges is endowed with the most glamour, grace, deportment and beauty. Upon the winner is conferred the title for the year of "Miss America". It also appears that similar competitions are held annually in other countries and that the respective winners or as many of them as are able to make the journey to some chosen venue compete for the title of "Miss Universe". In Australia there appears to be an annual competition in each State and a competition between the winners in each State for the title of "Miss Australia". "Miss Australia" then competes for the title of "Miss Universe". The words "Miss Australia" have been already registered as a trade mark in class 31. No doubt the words "Miss America", just like the words "Miss Australia", and the corresponding titles in other countries, when used in connexion with female apparel would be capable of suggesting in a vague and indefinable way to likely



female purchasers that the goods were suitable in quality to be fashioned for such glamorous beauties, but such vague and indefinable suggestions, emotive as they might be, could hardly be said to refer directly to the character or quality of the goods. Nor could the words "Miss America" according to their ordinary signification be considered to be a geographical name or a surname. They do not signify that the goods have their origin in the United States of America, and although a surname can include a title, added to a person's name derived from some achievement, the words "Miss America" could not be considered to be a surname even in this sense. They simply refer to an annual title conferred upon the winner for the year of a beauty competition under this designation and are in essence indistinguishable from the titles conferred upon winners of musical, artistic, sporting and other competitions. They are quite unlike words such as "Charm" in *In re Keystone Knitting Mills Ltd.'s Application* (1); "Perfection" in *In re Joseph Crosfield & Sons Ltd.'s Application* (2) and "Brisk" in *In re Colgate-Palmolive Co.'s Application* (3), which have been held to describe in a direct laudatory sense a character or quality of the goods and therefore to be words which are necessarily open to all the world and incapable of being registered. See the discussion in *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (4). Any reference that the words "Miss America" have to the character or quality of the goods in respect of which registration is sought or indeed to the character or quality of any goods is remote and indirect. Registration could not possibly trespass upon the rights of other traders to use ordinary English words or phrases to inform possible purchasers that the fabrics that they were offering for sale were similar to fabrics that had been worn by "Miss America" or which had in some way received her approval or patronage. Nor would registration of the words as a trade mark be likely to deceive the purchasing public into the belief that "Miss America" had ordered some of the fabrics or had otherwise approved of them. They would at most create the impression that the fabrics were suitable to be worn by a person who desired to be dressed in the same style as such a publicised, attractive, glamorous and popular lady.

As to the final contention, there are statements in the judgments in *National Cash Register Co.* (5); (on appeal (6)); *In the Matter of an Application by National Galvanizers Ltd.* (7) and *In the Matter of Boots Pure Drug Co. Ltd.'s Application* (8) to the effect that even if

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- (1) (1928) 45 R.P.C. 421.
- (2) (1909) 26 R.P.C. 837.
- (3) (1957) R.P.C. 25.
- (4) (1956) 95 C.L.R. 190.

- (5) (1917) 34 R.P.C. 273.
- (6) (1917) 34 R.P.C. 354.
- (7) (1920) 37 R.P.C. 202.
- (8) (1937) 54 R.P.C. 327, at p. 336.



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a word fulfils the conditions prescribed by s. 16 (1) (d), it nevertheless ought not to be registered if it is otherwise objectionable. But the other grounds, if they exist, are not specified. In one only of these three cases, that is in the second, did the application fail and there it failed because, although the word "National" was held to contain no direct reference to the character or quality of the goods (certain metal hollow-ware goods), it was tantamount to describing them as British goods or made under some national aegis in Britain and therefore deceptive within the meaning of s. 11 of the *Trade Marks Act* 1905 (*Imp.*) which corresponded to s. 114 of the Commonwealth Act. This is, of course, an objection to any proposed mark just as a further objection is that it is within the meaning of s. 25 of the Act "... identical with one belonging to a different proprietor which is already on the register in respect of the same goods or description of goods or so nearly resembling such a trade mark as to be likely to deceive". *Mutatis mutandis* the words of Warrington L.J., as he then was, in *In the Matter of the Registered Trade Marks, Nos. 538, 1807, and 158,839, of the Imperial Tobacco Co. (of Great Britain & Ireland) Ltd.* (1), seem to be not inappropriate: "I ask myself first of all, without knowing anything more about the case, but treating myself, as I think I am entitled to do, as a man who knows something about the ways of the world and the ways of tradespeople, 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 put that mark upon the goods held some special warrant or authority from the Prince of Wales? I do not think that it would for a moment. What it would suggest to me would be, that the man thought it was an attractive mark connected with a popular person, and that it was a mark which would make his goods not only attractive, but more than that, would distinguish his goods from the goods of other people in the same trade, being used as a Trade Mark" (2).

It is unnecessary to decide whether a proposed trade mark which consists simply of one of the essential particulars prescribed by pars. (a), (b), (c) or (d) of s. 16 (1) of the *Trade Marks Act* and is not obnoxious to s. 25 or s. 114 of that Act can still be objectionable on some other ground; one ground of objection suggested by Mr. *Ellicott* being that it is nevertheless not adapted to distinguish the applicant's goods from those of other persons. It is difficult to see how such an objection could be raised except under ss. 25 and 114

(1) (1915) 32 R.P.C. 361.

(2) (1915) 32 R.P.C., at p. 375.



of the Act but, assuming that it could, it would not appear to derive support from anything before the Court in the present case.

The appeal should be allowed and the registrar directed to accept the application.

*Application No. 109908 :—*

*Appeal dismissed as incompetent.*

*Application No. 109909 :—*

*Appeal allowed. Direct the Registrar of Trade  
Marks to accept the application No. 109909  
by Joseph Bancroft & Sons Co.*

Solicitors for the appellant, *T. J. Purcell & Clapin.*

Solicitor for the respondent, *H. E. Renfree*, Crown Solicitor for the Commonwealth.

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