

Application for registration of a trade mark consisting of a blue, white and gold bands design in Part A of the Register in Class 16 in respect of printed matter, printed cards and publications all relating to banking and credit services.

Decision of MR PIERS JACOBS, Assistant Registrar General, acting for the Registrar of Trade Marks.

On 8th April 1969 Messrs Deacons, the solicitors for the applicants, Bank of America National Trust and Savings Association, a corporation organized and existing under the federal laws of the United States of America, filed an application for the registration of a device or design consisting of three horizontal bands coloured blue, white and gold in respect of printed matter, printed forms, publications, credit and identification cards, application forms, sales and billing forms, information and instruction manuals, display signs, advertising mats, advertisements, computer programmes, notices, mailing folders, envelopes, agreements, deposit slips, imprints, plastic covers and holders, bulletin forms, periodicals, and all other goods, in class 16.

2. In support of the application an officer of the applicant company stated that the mark had been used by the Company in the United States of America in respect of the goods mentioned in the application since March 1960, and in Hong Kong since 1st January 1966.

3. The Registrar wrote to Messrs Deacons advising them that he doubted whether the mark fell within the definition of a trade mark within the meaning of section 2 of the Trade Marks Ordinance. In response the solicitors sent certain pamphlets to the Registrar showing the ways in which the mark had been used. It appeared from the information that the mark had been used on credit cards and promotional material relating to the credit card scheme; and, in fact, the mark consisted of a representation of the credit card without the word "BANKAMERICARD" appearing thereon.

4. On 27th May 1970, the Registrar advised the solicitors that the submitted mark was not considered to be inherently adapted to distinguish the Company's goods, and that it was also felt that limitation of the mark to the colours blue, white and gold would not assist registrability. It was pointed out that the word "BANKAMERICARD" was already the subject of a pending application, and it was confirmed that the device mark would be acceptable for registration if the word "BANKAMERICARD" appeared in the middle panel and the mark was registered in association with the other mark, the subject of the pending application.

5. The solicitors rejected the suggestion and argued that the mark as presented for registration was most distinctive. The attention of the Registrar was drawn to a similar mark already appearing on the register.

6. Upon further consideration being given to this matter the Registrar in a letter dated 12th October 1970 reiterated his objections, and in particular drew attention to the fact that from the advertising material submitted the mark had not been shown to be used as a trade mark in respect of goods in the course of trade, and said that unless the contrary was proved, he could not accept the mark for registration under the Trade Marks Ordinance.

7. There was further correspondence regarding the registrability of the mark and the solicitors whilst accepting that it was not possible to register a mark as a service mark argued that the mark in the present application had been used as a trade mark. They said that their clients sold printed material in that they parted with the same to customers and the customer received legal title to the goods. They indicated that their clients' customers paid both for the Company's services and for the printed material issued by the Company.

8. On 21st May 1973 the solicitors filed a request for the amendment of the specification of goods to "printed matter, printed cards and publications all relating to banking and credit services". In addition they supplied a statutory declaration from Mr John A. Holt, the Manager of the Company's Hong Kong Branch stating that the mark had been used as a trade mark in relation to the goods in the amended specification.

9. The statutory declaration indicated that in about 1966 the Bank adopted the mark as a trade mark and said that it had been "imprinted in the various forms or documentations, namely, 'printed matter, printed cards and publications all relating to banking and credit services' for exclusive use by the Bank". Mr Holt went on to declare: "These printed materials are distributed to Merchant Members of the Bank for use in allowing credit facilities to holders of the credit cards for goods sold. The Bank will honour all charges presented by the Merchant Members on a commission basis which commission includes the supply of the credit cards and other printed materials. Accordingly, I cannot give exact figures relating specifically to each item of goods as listed in the application. The Bank's commission covers the service supplied and also the goods supplied in one inclusive charge or price.". Copies of the mark in use were annexed to the statutory declaration. There are two points to note in relation to the use of the mark as evidenced by the statutory declaration:

- (a) It appears that the mark has not been used in the simple form in which it appears in the application. It is always used with words appearing thereon. For example, "Your BankAmericard welcome here" - "Thank you - call again" - "BankAmericard", with the name of the holder and his credit reference below.
- (b) On one of the examples of the mark the following words appear "Service Marks owned by BankAmerica Service Corp.". The significance of these words is not immediately apparent but it would appear that the mark has been accepted as being a service mark elsewhere, although it is not clear whether this was as a matter of law or practice.

10. On 18th June 1973 the Registrar wrote to the solicitors advising them that all the evidence submitted in support of the application served only to confirm the view that the mark was being used as a service mark, and that the mark in question did not fall within the definition of a trade mark. It was further said that the proposed mark was not distinctive. The application was accordingly refused.

11. On 23rd August 1973 the solicitors applied in terms of section 13(4) of the Trade Marks Ordinance and Rule 20 of the Trade Marks Rules requesting the Registrar to state in writing the grounds of his decision and the material used by him in arriving at the decision.

12. It is well established that a service mark cannot be registered within the terms of the Trade Marks Ordinance. A trade mark is defined in section 2 in the following terms:

" trade mark" means, except in relation to a defensive or a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a defensive trade mark, a mark registered under section 55, and, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 64.

This definition is similar to the definition contained in section 68 of the Trade Marks Act 1938. The mark must be used in relation to goods, so that there must be, at least, an intention to make available actual goods, in relation to which the mark is to be used. Furthermore, the mark must be used in order to indicate a connection "in the course of trade". It was held in *Aristoc Ltd. v. Rysta Ltd.* (1945) 62 R.P.C. 65 that the execution of repairs on socks made by manufacturers other than the repairers, the repaired socks being returned to their owners and not offered for sale, did not involve "a connection in the course of trade" between the socks and the repairer such as to enable the latter to register as a trade mark a mark applied to the socks to indicate that they were repaired by him. It was necessary that there should be association with the goods in the course of their production or preparation for the market. Lord Wright in the case cited at pages 82 and 83 described the necessary condition as being that the goods should be issued as vendible goods under the aegis of the proprietor. However, the word "vendible" does not exclude the case of goods

offered for hire and not for sale, and this description follows the Act in making no attempt to define the function performed by the proprietor, requiring only that it should be a real connection in the course of trade. The trade, must, however, be in the goods concerned. See "Hospital World" Trade Mark (1967) R.P.C. 595. The "Hospital World" case is somewhat similar to the present application in that the application was for registration in class 16 in respect of a specification of goods which was subsequently altered to periodical publications. The mark was initially rejected by the Registrar as being indistinctive. Evidence was filed, as in the present application, and it was from that evidence that it became apparent that the mark had not been used as a trade mark. The Registrar referred to the observations of Evershed J. in *Ferodo Ltd.*'s application (1945) 62 P.R.C. 111 in which it was held that the phrase "connection in the course of trade etc." did not cover advertising media of the kind used. In the present application it appears from the evidence contained in the statutory declaration referred to in para. 9 above that the mark has been used on printed materials distributed to merchant members of the Bank for use in allowing credit facilities to the holders of credit cards for goods sold. Apparently the mark is not used on any goods other than the credit cards themselves, promotional material and as a sign on shops and other places where the credit cards may be used. It cannot be said that the mark is used in relation to the goods or services purchased or obtained on credit through the credit scheme to which the card relates. Furthermore, the credit cards and other printed materials must, in my view, be regarded as no more than promotional or advertising material or mere adjuncts to the credit scheme - they are not goods purchased or traded.

13. As I have indicated above the application was originally rejected on the grounds that the mark was *prima facie* indistinctive. It has been suggested by the solicitors for the applicants that the mark consists of three colours in that the central band is white, and white is a colour. However, it is quite apparent from the evidence that the central band is used as a blank space, which is completed either by the signature of the holder of the credit card or the word "BANKAMERICARD", or promotional words of one sort or another. There is nothing distinctive about the shapes of the

bands, which consist of simple rectangles. It is true that pursuant to section 11 of the Trade Marks Ordinance the Registrar may take into consideration the colour or colours of a mark in deciding upon the distinctive character of the trade mark. Nevertheless, the device is one of extreme simplicity consisting as it does of two bands of colour, with a white band being a blank space between. I do not consider that the present mark, even if it fell within the definition of a trade mark as discussed above, could be regarded as distinctive for the purposes of section 9(1)(e) of the Ordinance. It is possible that it could acquire distinctiveness upon satisfactory evidence of user as a trade mark being adduced, but I need not reach that conclusion for the purposes of this decision. It is of interest to note that the mark has been accepted in the United Kingdom for registration in Part B and not Part A of the register.

14. Upon the grounds indicated above and on the basis of the decisions referred to I am refusing registration because

- (a) the mark has not been used as a trade mark within the definition contained in section 2 of the Ordinance; and
- (b) without evidence of such user the mark is not distinctive within the terms of section 9(1)(e) of the Ordinance.

26th November 1973