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IN THE MATTER of the Trade Marks
Ordinance

AND

IN THE MATTER of Applications by Cluett
Peabody & Co. Inc. to register the trade
marks "INTERNATIONALIST" and "INT" in
Class 25 in respect of Wearing apparel.

DECISION

of

Mr. P. Murphy, acting for the Registrar of Trade Marks.

Hearing on 14th December, 1973.

Mr. R.I. Campbell of Messrs. Johnson, Stokes & Master appeared for the
Applicants.

On 19th April 1972, Cluett Peabody & Co. Inc., a corporation
organised under the laws of the State of New York, United States of
America, whose trade or business address is 433 River Street, Troy, New
York, United States of America, (hereinafter referred to as "the
Applicants") submitted through their Agents Messrs. Johnson, Stokes &
Master, Solicitors, Hong Kong, two applications to the Registrar of Trade
Marks, Hong Kong, (hereinafter referred to as "the Registrar") for the
registration in Part A of the Register of the marks "INTERNATIONALIST" and
"INT" respectively, both in class 25 in respect of Wearing apparel.

The supporting statutory declaration in both cases was made
by Mr. Leo Fornero, Assistant Secretary of the Applicants, on 19th April
1972 and was in the same terms, i.e. it stated (a) that the mark had been
used by the Applicants in the United States in respect of the goods mentioned
in the application since January 1972; (b) that the mark had not hitherto been
used by the Applicants in Hong Kong in respect of the goods mentioned in the
application but that it was the Applicants' intention so to use it if and when

it is registered and (c) that the mark was at that time in the process of being registered in Korea, Japan, Taiwan and Singapore.

On 15th August 1972 the Registrar wrote to Messrs. Johnson, Stokes & Master with regard to the "INTERNATIONALIST" mark refusing registration on the ground that it was considered to have a direct reference to the character or quality of the goods and was therefore unregistrable under Section 9(1)(d) of the Trade Marks Ordinance, Cap.43, (hereinafter referred to as "the Ordinance"). In the same letter the Registrar also refused registration of the "INT" mark on the grounds (a) that it is an abbreviation of "INTERNATIONAL" and open to the same objections as the full word and (b) that it could also be treated as consisting of three letters of the alphabet "INT" which are indistinctive and prima facie not registrable.

Some correspondence followed in which Messrs. Johnson, Stokes & Master tried unsuccessfully to persuade the Registrar to withdraw his objections to both applications and eventually they asked for a Hearing under Section 74 of the Ordinance and Rule 18 of the Trade Marks Rules. This was duly held on 14th December 1973 and Mr. R.I. Campbell of Messrs. Johnson, Stokes & Master appeared for the Applicants.

Mr. Campbell referred to the terms of Section 9(1)(d) of the Ordinance and stated that if a mark is unregistrable under this provision then it must have a direct reference to the character or quality of the goods concerned. He said that his basic argument against the Registrar's refusal to register was that "INTERNATIONALIST" refers to a person and never to an object. He handed over a photocopy of page 1030 of the Shorter Oxford English Dictionary, 3rd Edition, which is reproduced as the Appendix hereto, and pointed out that all four meanings given refer to persons. He argued that one would never hear the word used in respect of

material objects. For example, one would never hear of "Internationalist Building". He stated that the adjective "cosmopolitan" would be used in respect of objects.

Mr. Campbell then submitted that, if it is accepted that the word "INTERNATIONALIST" can refer only to persons, he could not see how it could be held to have a direct reference to the character or quality of clothing. He said that the fact that a person is an internationalist does not form a basis for assuming the type of clothing he may wear. He did not agree that it could be assumed that an internationalist would wear clothes which carry on international flavour. He claimed that clothes are basically the same wherever purchased or designed. One cannot point to a shirt or pullover and say "This has an international flavour".

He then raised the possibility that the Registrar might feel that "INTERNATIONALIST" is too close to "International" but submitted that, if so, this view would be wrong because the "IST" at the end of the mark clearly differentiates between the two words.

Turning to the "INT" mark he said that the Applicants would have to rely on "INTERNATIONALIST" being acceptable and "INT" being registered in association with it. He recognised that if he claimed that it is not an abbreviation then the objection that it consists merely of letters of the alphabet and is therefore indistinctive would arise.

Finally, Mr. Campbell asked whether, if the marks are not acceptable now, they would be acceptable at some future date on production of evidence of user in Hong Kong. He confirmed that the marks have not been registered elsewhere since the Applications were made.

I agree with Mr. Campbell's argument that if a mark is to be refused registration under Section 9(1)(d) of the Ordinance then it must have a direct reference to the character or quality of the goods on which it is used. The difficulty, of course, lies in deciding what amounts to a direct reference in any particular case. I am guided in this matter by the following excerpt from "Kerly's Law of Trade Marks and Trade Names", 10th Edition, pages 111 and 112 regarding decisions on the corresponding provisions in the United Kingdom Act:

"The various decisions are listed below. Few of them are of value as laying down any definite principle; nor would they seem to imply any very consistent practice. One reason may lie in this, that almost every immediately attractive trade mark is, in some sense, descriptive or laudatory of the goods and so in some degree has reference to their character or quality. The difficulty is to decide whether that reference is a direct reference: one that seriously affects the word's capacity for distinguishing goods from a particular source, as distinct from the sort of reference that can be found only as an academic exercise. This is at best a somewhat metaphorical question and one depending ultimately upon the reaction of the public to the chosen word. In these circumstances, the Registrar, who has a duty to maintain the purity of the Register, may well incline to rely upon possibilities of interpretation of a mark which later experience may show to be fanciful. Sometimes, he can be persuaded by argument; but in general, the applicant's proper course is to apply again when the mark has been tested by use. This is by no means to be regarded as a hardship upon applicants: it must not be forgotten that if the Registrar registers under Section 9(1)(d), without evidence of distinctiveness, a mark that is later held to be directly

descriptive, the mark may (until seven years have elapsed since registration) be struck off as wrongly registered."

With regard to the dictionary meanings of "INTERNATIONALIST" the Registrar pointed out to Messrs. Johnson, Stokes & Master in his letter of 18th November 1972 that according to Webster's Third New International Dictionary the word can also be used adjectivally as meaning "advocating or influenced by internationalism".

I take the view that anything involving the word international or its derivatives has a strong emotional appeal to the public nowadays. Internationalism is regarded by most people, and certainly by the great majority of the young, as a praiseworthy philosophy and the internationalist as a person to be admired and, if possible, emulated. It is a brave public figure who publicly, as distinct from privately, denounces internationalism and advocates nationalism. On the economic plane, the fact that a product is known to be sold successfully world-wide is generally accepted as evidence that it is the best of its type. The reasonable deduction is that if it can be sold in many countries against the locally-produced article then it must have inherent advantages which make it highly desirable.

I therefore agree with the Registrar's statement in his letter of 18th November 1972 to Messrs. Johnson, Stokes & Master that the mark when used on clothing would convey the idea that the goods have an international standing and would appeal to people of different nations. Also I agree with his statement that even if the mark must be taken to indicate the kind of persons who might wear the clothing it is still directly descriptive of the goods because it shows the purpose for which the clothing is made. I would go further and say that the mark is also

laudatory in such circumstances because of the general esteem in which the internationalist is held and the implication that such a person would tend to wear the most suitable clothing available.

As I consider that there is a direct reference to the character or quality of the goods I therefore have to refuse the application for "INTERNATIONALIST".

(I have considered the circumstances of National Cash Register's Application (1917) 34RPC in which "NATIONAL" was allowed in respect of cash registering machines and other goods but it seems to be that they were completely different from the circumstances applying in this case and do not consider that that case justifies me in departing from my view that "INTERNATIONALIST" must be refused in this case).

With regard to the application for "INT" I am not satisfied that it would be taken as an abbreviation of "International" by the public but, on the other hand, I consider that it must be refused because the mark consists merely of letters of the alphabet and is indistinctive.

There can be no question of a Part B registration under Section 10 of the Ordinance for either mark at present as there has not been two years bona fide user in Hong Kong in either case prior to the date of the applications.

As to whether the marks would be acceptable at a future date on evidence of user, this would of course depend on the nature of the evidence but my present view is that the marks are not ones which I personally would be prepared to approve except on evidence of massive user.


(P. Murphy)

Senior Solicitor

7th February 1974

Hence Internality, the quality or fact of being i.
 Internally (int̄'mali), adv. 1597. [f. prec. + -LY.] 1. In, on, or with respect to the inside or interior. 2. With respect to the inner nature or relations of anything, esp. the internal affairs of a country, etc. 1791. 3. Mentally, spiritually 1646.
 Interna-sal, a. 1866. [f. INTER-II. 2 a + L. nasus.] = intranasal (see INTRA-).
 International (int̄'ɔnʃənəl), 1780. [INTER-II. 2.] A. adj. Existing, constituted, or carried on between different nations; pertaining to the relations between nations. b. (with capital I.) Belonging to the International Working Men's Association, a society of workmen founded in London in 1864 (and dissolved in 1874), the objects of which were identified with those of the socialism of Marx. The great science of law, the determining authority in questions of right between independent states HALLAM. An I. Exhibition 1861, yacht race 1888.
 B. sb. a. A person belonging to two different nations (e.g. native of one and resident in another) 1870; one who takes part in an international contest 1895. b. (with capital I.) and sometimes in Fr. form -ale) = International Working Men's Association (see A. b.); also, a member or adherent of this.
 b. First I., that of 1864-74; Second I., formed in 1874 at Paris and having later its seat in Brussels; Third I., formed in 1919 by the Russian communists (Bolsheviks) on a revolutionary basis.
 ||Internationale (-nɑːʃənəl, ||ɪnt̄'ma-sjənəl), [Fr. (sc. chanson song).] A revolutionary hymn composed by Eugene Pottier in 1871 and adopted by French socialists and later by others. (See also prec. B. b.)
 Interna-tionalism. 1877. [f. INTERNA-TIONAL + -ISM.] International character or spirit; the principle of community of interests or action between different nations; spec. (with capital I.) the doctrine or principles of the International Working Men's Association.
 Internationalist. 1864. [f. as prec. + -IST.] a. An advocate of or believer in internationalism; spec. a member of or sympathizer with the International Working Men's Association. b. One versed in international law. c. One who takes part in an international contest.
 Internationality. 1864. [See -ITY.] International quality, condition, or character.
 Interna-tionalize, v. 1864. [See -IZE.] trans. To render international in character or use; spec. to bring (a country, territory, etc.) under the combined government or protection of two or more different nations. Hence Internationalization.
 Interna-tionally, adv. 1864. [See -LY 2.] In an international manner; between or among different nations.
 Interne: see INTERN.
 Internecine (int̄'ɔniːsɪn), a. 1663. [ad. L. internecinus, f. internecium slaughter, destruction, f. internecare; see next. The etym. pronunc. would be internecine.] 1. org. Deadly, destructive, characterized by great slaughter. 2. esp. (In mod. use.) Mutually destructive, aiming at the slaughter or destruction of each other 1755.
 1. I. war, war for the sake of slaughter, war to the death. 2. Eight thousand Zealots, who stabbed each other in I. massacre FARAR.
 Internecion (int̄'ɔniːʃən), rare. 1610. [ad. L. internecionem massacre, etc., f. internecare to kill, destroy, f. inter (as in interficere) + necare to kill.] Destruction, massacre.
 Internecive (int̄'ɔnʃɪv), a. rare. 1819. [ad. L. internecivus, (scribal) var. of internecinus.] = INTERNECINE 2.
 +Interne-ct, v. 1694. [ad. L. internectere to bind to each other, f. inter +nectere.] trans. To interconnect. So +Internec-tion, -nec-tion, mutual connexion 1654.
 Internee. 1920. [f. INTERN v. 2 + -EE 1.] An interned person.
 Sion Fein internea. Newspaper.
 Internodal (int̄'nɔdəl), a. (sb.) 1846. [f. INTER-II. 2 a + Gr. νῆδος nerve; see NEURAL] Anat. and Zool. Situated between nerves, or between neural spines or arches; applied spec. to the dermal spines or bones

supporting the dorsal fin-rays in fishes (cf. INTERSPINAL). b. as sb. (pl.) = Interneural spines 1880.
 +Internody. rare. 1760. [f. L. internody + -ITY.] The quality of being internal, inwardness; something internal. H. BROOKE.
 Internodum (int̄'nɔdʊm), 1870. [f. INTERN v. 2 + -MENT.] The action of internoding; conning within prescribed limits.
 Internod-, comb. advb. form of L. internody.
 INTERNAL; as in Interno-medial, -median adj., Eutom. situated within the median line or nerve, or between the internal and median nerves, of the wing 1826.
 Internodal (int̄'nɔdəl), a. 1835. [f. INTER-II. 2 a + L. nodus; cf. nodal.] Bot. and Zool. Situated between nodes; belonging to or constituting an internode.
 Internode (int̄'nɔd), 1667. [ad. L. internodium (see below).] 1. Bot. That part of a stem or branch intervening between two of the nodes or knots from which the leaves arise. 2. Zool. and Anat. A slender part intervening between two nodes or joints; each bone of a finger or toe 1722.
 +Internodial, a. [f. next + -AL.] = INTERNODAL SIR T. BROWNE.
 ||Internodium (int̄'nɔdɪəm), Pl. -ia. Now rare. 1644. [L. f. inter + nodus; see INTER-II. 2.] = INTERNODE. (erron. A joint).
 +Internonce. Also -nonce. 1647. [a. F. internonce, ad. L. internuntius (nuntius); see INTERNUNCIUS.] = INTERNUNCIO. -1847.
 Internuncial (int̄'nʊnʃjəl), a. 1845. [f. L. internuntius (see below) + -AL.] Having the function of conveying messages between two parties, etc.; used fig. of the nerves.
 +Internunciess. rare. [irreg. f. INTERNUNCIO + -ESS.] A female internuncio or messenger. CHAPMAN.
 Internuncio (int̄'nʊnʃjo), Also +tio. 1641. [ad. It. internuncio, ad. L. internuntius (-nuntius); see next.] 1. A messenger between two parties. 2. A representative or ambassador of the Pope at a foreign court while there is no nuncio, or at a minor court while there is no nuncio. 3. A minister representing a government, esp. that of Austria, at the Ottoman Porte 1700. Hence Internunciship, the office or function of an i. or go-between.
 ||Internuncius. 1675. [L. in med. spelling, for cl. L. internuntius, f. inter between + nuntius a messenger.] = prec. 1.
 Internuptial (int̄'nʊptʃjəl), a. 1850. [f. INTER-I. 2 or II. 2 + L. nuptiz; cf. nuptial.] 1. Pertaining to intermarriage. 2. Intervening between two marriages or married states 1885.
 Interoceanic (int̄'ɔʃiːnɪk), a. 1855. [INTER-II. 2 b.] Situated between oceans; connecting two oceans, as a strait or canal.
 Interocular, etc.: see INTER- pref.
 Interopercular (int̄'ɔp̄'ɔkɪləɹ), a. 1854. [f. next + -AR; cf. opercular.] Ichthyol. Belonging to, or of the nature of, an interoperculum; chiefly in i. bone = next.
 ||Interoperculum (int̄'ɔp̄'ɔkɪləɹəm), 1834. [INTER-I. 2 b.] Ichthyol. One of the bones forming the gill-cover; usually situated below the preoperculum, and partly between this and the operculum and suboperculum.
 Interorbital (int̄'ɔrɪbɪtəl), a. 1852. [INTER-II. 2 a.] Anat. Situated between the eye-sockets.
 Interosculant (int̄'ɔskɪlənt), a. 1855. [INTER-I. 2 a; cf. next.] Interosculating; forming a connecting link.
 An i. group, a party of genera and species which connect families scientifically far apart KINGSLAY.
 Interosculate (int̄'ɔskɪlənt), v. 1882. [f. INTER-I. 1 b + OSCULATE.] intr. a. To interpenetrate or insosculate with each other. b. To form a connecting link between two groups. Hence Interoscultation.
 Intero-seal, a. 1805. [f. as next + -AL.] = next.
 Interosseous (int̄'ɔsiːs), a. 1745. [f. INTER-II. 2 a + L. os, ossis bone, ossis bony + -OUS.] Anat. Situated between bones;

said of various ligaments, muscles, nerves, and vessels.
 +Interpale, v. 1553. [f. INTER-I. 1 + PALE v.] 1. trans. To divide by pales, as in Heraldry; to alternate in vertical divisions. BRENDÉ. 2. = IMPALE v. 2. LOVELACE.
 Interparietal (-pəriːtɪəl), a. (sb.) 1835. [INTER-II. 2 a.] Anat. 1. Situated between the parietal bones of the skull. 2. sb. The interparietal bone.
 +Interpause, v. 1534. [f. INTER-I. 1 + PAUSE v.] intr. To pause in the midst of something. MORE. So +Interpause it, a pause between or in the course of something 1599.
 Interpel (int̄'ɔpəl), v. Now only in Sc. Law. ME. [ad. L. interpellare, f. inter + pellare, secondary form of pellere to drive. Cf. F. interpellier.] +1. trans. To appeal to; to petition -1591. 2. To interrupt (a person) speaking; to break in on or disturb -1647. 3. Sc. Law. To intercept, cut off, prevent 1722. 4. No more now, for I am interpell'd by many business HOWELL.
 Interpellant (int̄'ɔpələnt), 1869. [a. F. interpellant, pr. pple. of interpellare, ad. L. interpellare; see prec.] One who addresses an interpellation (e.g. in the French Chamber).
 Interpellate (int̄'ɔpələt), v. 1599. [L. ppl. stem of L. interpellare.] +1. trans. To interrupt or break in upon. 2. To address an interpellation to (a minister in the French or other Chamber) 1874.
 Interpellation (int̄'ɔpələʃən), 1526. [ad. L. interpellationem. Re-introduced from Fr. in sense 5 in 19th c.] +1. The action of appealing to or entreating; intercession -1770. 2. A summons, citation -1726. 3. The action of breaking in upon; interruption -1834. 4. Sc. Law. Prevention, hindrance 1814. 5. The action of interrupting the order of the day (in a foreign legislative Chamber) by asking from a minister an explanation of some matter belonging to his department 1837.
 1. By the impertinence of her I. Becom. 2. Strange reasonings, and sarcastic interpellations LASTON. 3. An incessant fire of questions, interpellations, interrogations CARLYLE.
 Interpenetrate (int̄'ɔpənɪtɪreɪt), v. 1809. [INTER-I. 1.] 1. trans. To penetrate between the parts or particles of (anything); to pass through and through, permeate, pervade 1818. Also intr. 2. intr. To penetrate each other; to unite or mingle by mutual penetration 1809. b. trans. To penetrate reciprocally 1843. 3. Arch. (trans. and intr.) To appear as if penetrating or passing through a moulding, etc. 1840.
 1. The water is everywhere interpenetrated by air, which the fishes breathe MEWIK. 2. Law and religion thus interpenetrating neutralized each other COLEBRIDGE. 3. Their shafts interpenetrating the mouldings of the panels and tracery BOYDALL.
 Interpenetration (int̄'ɔpənɪtɪreɪʃən), 1809. [INTER-I. 2 a.] 1. The action of penetrating between or among; thorough penetration 1822. 2. Mutual penetration 1809. 3. Arch. The intersection of two forms; spec. an independent continuation of mouldings or other members past their intersection, so that the identity of a member is preserved after it has partly coincided with another or has been swallowed up in it 1840.
 Interpenetrative, a. 1860. [INTER-I. 2 a.] Intimately or reciprocally penetrative. Hence Interpenetratively adv. 1834.
 Interpetiolar (int̄'ɔpɪtɪɔləɹ), a. 1830. [INTER-II. 2 a; see PETIOLAR.] Bot. Situated between petioles, or between a petiole and the axis. Also Interpetiolarly a.
 Interphalangeal; see INTER- pref.
 Interpilar (int̄'ɔpɪləɹ), 1823. [INTER-II. 1.] Arch. The space between two pilasters.
 +Interplace, v. 1548. [INTER-I. 1 a, b.] trans. a. To place between or in the midst of. b. To place between each other or alternately. (Only in Sc.) -1678.
 Interplait (int̄'ɔplɪt), v. Also -plait. 1822. [INTER-I. 1 b.] trans. To plait together to intertwine, interweave.
 Interplanetary (-plɪnɪtəri), a. 1622. [INTER-II. 2 a.] Situated between the planets

z (man). a (pass). au (loud). o (cut). s (Fr. chef). e (ever). oi (I, eye). o (Fr. can de vie). i (sit). i (Psyche). q (what). p (out)