

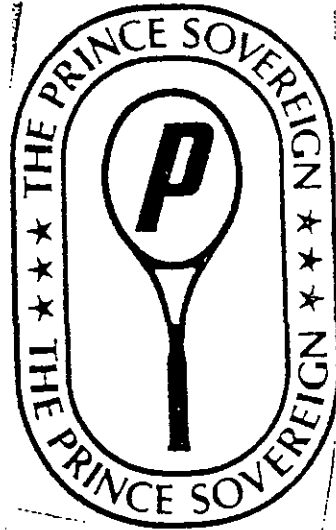
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APPLICATIONS NOS. 1832/86 and  
1832A/86

IN THE MATTER of the Trade  
Marks Ordinance

and

IN THE MATTER of applications  
for the registrations of  
Trade Marks



in Classes 25 and 28 of  
Part A of the Register by  
Prince Manufacturing Inc.

D E C I S I O N

of

Mr. M.W. Fox acting for the Registrar of Trade Marks

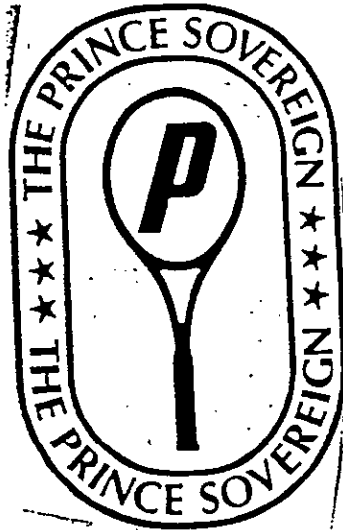
after

A hearing on Wednesday, 22nd June 1988

Appearing : Mr. Stephenson of Messrs. Deacons for Prince Manufacturing  
Inc.

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On 23rd May 1986 Prince Manufacturing Inc. (hereinafter called "the Applicant") a corporation organised and existing under the laws of the State of New Jersey, United States of America applied under the Trade Marks Ordinance for the registrations of Trade Marks in Part A of the Register in Class 25 in respect of : "Apparel and shoes" and in Class 28 in respect of : "Tennis strings, tennis racquets and bags specially adapted for carrying tennis equipment". A representation of the mark applied for in both classes appears below :



Objection was taken to the mark in both classes under paras. (c), (d) and (e) of S. 9(1) of the Ordinance on the grounds that it does not consist of invented words, that it has a direct reference to the character and quality of the goods and that it is not distinctive. In an attempt to overcome objections to the various component features of the mark the Applicant offered to disclaim the exclusive use separately of the words "Prince Sovereign" the device of stars, the letter "P", the device of a racquet and the border device. The Applicant also conceded the word "The" was unregistrable. Objection was nevertheless maintained to the mark, as a whole. Following a hearing the objection was upheld and the applications accordingly refused. I am now asked under S. 13(4) of the Ordinance and Rule 20 of the Trade Marks Rules to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use was put before me and no special circumstances were brought to my attention. I have therefore only the prima facie case to consider.

The Applicant argued that the mark as a whole was distinctive and thus qualified for registration under the provisions of S. 9(1)(e) of the Ordinance and indeed it is the impression created by the mark as a whole that I must consider. If I find the mark as a whole distinctive then it qualifies for registration and should be registered. It would seem this requirement is satisfied if the combination of the various component features of the mark give rise to a new idea, a fanciful conception such that the mark as a whole can be said to be greater than the sum of its individual parts.

What can be said about the mark as a whole is that there is nothing at all striking about it. It does not contain any one individual striking feature or element, the nearest, I suppose being the racquet with the letter "p" appearing where the strings would be, which is to some extent highlighted by the border device. The mark in fact consists of a device of a standard racquet (probably a tennis racquet) with an unembellished letter "p" appearing where the strings would be enclosed within an unexceptional border which could be described as either a very large "O" or maybe the device of an athletics track. Appearing within that border are 6 stars and the words "The Prince Sovereign" repeated.

The word "The" is not registrable. The border device is indistinctive or if indeed it could be described as an athletics track has a direct reference to the character of the goods covered in the application under Class 25 which, prima facie, would include athletics apparel and shoes. The words "Prince" and "Sovereign" both have laudatory meanings and as such have direct references to the quality of the goods covered in the applications in both classes. In addition "Prince" is a not uncommon surname and as such, on that consideration alone, would not be registerable without evidence of distinctiveness. The unembellished letter "p", being but a letter of the alphabet, is not distinctive. The device of a standard racquet too is also not distinctive. In addition it has a direct reference to the character of the goods in both Class 25 and Class 28; the Class 25 application covering, as it does, tennis apparel and shoes. By offering the various disclaimers the applicant recognized these inherent individual limitations to registration.

As indicated, at the hearing Mr. Stephenson argued that the mark as a whole with its component features taken in combination was sufficiently distinctive to be regarded as being inherently adapted to distinguish the Applicants goods and thus qualified for registration in Part A of the Register in both classes. Relying on "Diamond T Motor Company's Application" (1921) 38 RPC 373. He argued that I am not concerned

to have any evidence of distinctiveness by way of use established and that as no other traders would be likely in the ordinary course of business and without improper motive to desire to use the mark, or one resembling it, upon or in connection with their own goods then I must accept its distinctiveness for the Applicants goods in both classes. He drew my attention to the words of Lawrence J. in the "Diamond T" case appearing at the bottom of page 381 and the top of page 382

"No person seeing it (the mark) affixed to a motor car or motor lorry could, in my opinion, reasonably come to the conclusion that it was so affixed for any purpose other than to indicate that the car or lorry was manufactured by the proprietor of the mark and not by some other manufacturer. If I am right in this opinion, it goes, in my judgment, a long way towards proving that the mark is adapted to distinguish the vehicles of the applicants from those of other manufacturers".

Mr. Stephenson also urged me not to be persuaded by the decision in the "Ford-Werke A.G.'s Applications" (1955) 72 RPC 191 on the basis that case was decided adversely to that applicant because the only way one could possibly refer to the device in question was as a "F" and "K" mark", in other words by its disclaimed matter. Very different from the mark here in question, Mr. Stephenson argued, which has no individual striking feature or element by which it could be described, though interestingly on this point the Applicant itself refers to the mark as "Prince Sovereign Logo", in other words by would be disclaimed matter "Prince Sovereign" being the subject of an offered disclaimer. The "F" and "K" mark was found to be non-distinctive, initials in common trade use, not represented in a special way. Finally Mr. Stephenson drew my attention to United Kingdom Trade Marks Registry practice which acknowledges the concept of multiple disclaimers.

This concept too is I am sure recognized by the Hong Kong Trade Marks Registry provided there is at least one undisclaimed component feature of sufficient distinctiveness or the mark as a whole is distinctive. Here all the component features are the subject of offered disclaimers or are not registrable. I accept the "Diamond T" mark was found to be inherently adapted to distinguish and user was not an issue. It was found to be distinctive as a whole, a novel combination of three features. The passage from the "Diamond T" case extracted above talks in terms of a "long way" towards proving the mark is adapted to distinguish, rather than proposing a conclusive standard. Similarly actual distinctiveness largely depends on the proper motives and desires of other traders in the ordinary course of business. Again it is not conclusive.

I cannot believe the intention is for and I do not think the "Diamond T" case supports the proposition that a mark automatically becomes inherently adapted to distinguish if it includes a sufficient number (whatever that number is) of disclaimed component features. The impression as a whole must be greater than the sum of the parts, as it was in the "Diamond T" case and as it was not in the "Ford-Werke" case. A novel idea must be created.

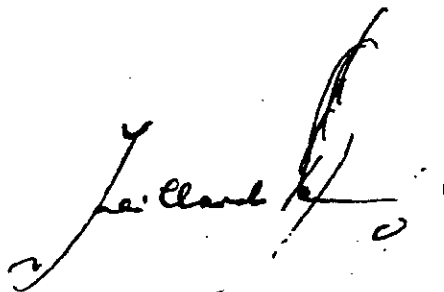
Here there is no such novel idea. I can see other traders genuinely and without improper motive in the course of business wishing to use a similar mark on their goods. There is nothing distinctive about the mark. I believe the device of a racquet with a letter of the alphabet where the strings would be is in use. The device of stars is fairly commonplace, as is a border in or resembling the shape here. The use of the laudatory epithets "Sovereign" and, to a lesser extent, "Prince", also a not uncommon surname, are and should be open for use by traders. A combination similar to the mark in question here could well be the subject of genuinely desired, properly motivated trade use, throwing, as it does, together, in no special way, various generally used components. Even if this is not accepted, the test, it was suggested I should apply, is not a conclusive one. It is the impression created by the mark as a whole that is paramount. Does it suggest a new idea? Is it fanciful? The answer in this case is "No".

I find here the non-distinctive elements yield only a non-distinctive whole being but the sum of the component parts and no more. There is nothing striking about the mark. There is no actual, physical or even imaginary physical interrelationship or interconnection between or integration of any of the disclaimed features. They all remain separate, isolated. No new idea is conveyed. The mark remains the sum of its indistinctive parts. I find the mark, without any evidence of its distinctiveness acquired by use, is not as a whole inherently adapted to distinguish the Applicants goods and as a whole is so not a distinctive mark qualifying for registration under the Trade Marks Ordinance in Part A of the Register.

I therefore consider I must exercise my discretion under S. 13(2) of the Ordinance adversely to the Applicant, the mark in both classes failing to satisfy the provisions of S. 9 of the Ordinance for registrations in Part A of the Register. The applications are therefore refused in both classes.

Before I close, for completeness, I wish to dispose of two small points. The Applicant offered to disclaim the exclusive use separately of the words "Prince Sovereign". I do not know whether the Applicant perceives a difference between this and a disclaimer of the exclusive use separately of the words "Prince" and "Sovereign". I do not. Neither "Prince" nor "Sovereign" are registrable either in combination or separately for reasons before explained. Secondly the applicant described his device as "Prince Sovereign Logo". "Logo", an abbreviation of logogram, logograph or logotype has acquired, possibly incorrectly, a personal, connective meaning. One talks in terms of "a company's logo", generally indicating a particular device with special significance or attachment to that company. The mark here may well be considered by the company to be its logo but with no use indicated preceding the application the reference to "Logo" could not and did not have any influence on me in considering the matter before me.

Dated 14th December 1988



(M.W. Fox)  
p. Registrar General  
(Registrar of Trade Marks)