

File No. : 2538/1988

IN THE MATTER of the Trade  
Marks Ordinance (Cap. 43)

IN THE MATTER of application  
No. 2538 of 1988 by E. Gluck  
Corporation for registration  
of trade mark 'AWATCH' in  
Class 14 in Part B of the  
register

GROUNDS OF DECISION

of

Teresa Grant acting for the Registrar of Trade Marks

On 3rd May 1988, E. Gluck Corporation, a corporation organised and existing under the laws of the State of New York, United States of America, of 29-10 Thomson Avenue, Long Island City, New York 11101, United States of America, applied under the Trade Marks Ordinance (Cap. 43) for registration of a trade mark in Part B of the register in Class 14 in respect of 'watches'.

The mark to be registered consisted of the word 'AWATCH' in plain block capitals.

The registrability of the mark was first considered under both S. 9 and S. 10(2)(a) of the Ordinance and the mark was considered indistinctive for registration in Part A and Part B of the register.

Consideration under S. 9 was unnecessary as the application was for registration in Part B of the register only. Therefore the application need only have been considered under S. 10. The Registrar's letter dated 28th February 1989 objected to the mark under S. 9(1)(d) and (e) on the grounds that the word 'AWATCH' had direct reference to the character or quality of the goods and that it was not distinctive. The Registrar did not make it clear to the applicant that objection to the mark was taken under S. 10 until later when evidence of use was submitted and considered.

The application form had indicated that the mark was in use at the date of application and in June 1990 the applicant filed evidence showing use of the mark in support of the application.

The evidence, in the form of a statutory declaration by Bernard Fernandez, a vice president of E. Gluck Corporation, is of use of the mark from 1984 with sales in Hong Kong or value of exports from Hong Kong in the two years prior to the application averaging HK\$93 million a year and advertising expenditure in the same period averaging HK\$24 million a year. Attached to this declaration as exhibits are copy invoices, samples of paper tags and watch dials displaying the mark, and advertisements. In his declaration Mr. Fernandez stated that registration of the mark had been applied for all over the world and had been registered in the United States of America and in Switzerland. Copies of the certificates of registration were exhibited.

Notwithstanding a consideration of the evidence, the application was refused by official letter dated 29th January 1991. This letter made it clear that the mark was not capable of distinguishing and was refused registration (under S. 10) in Part B of the register.

I am now asked, in accordance with S. 13(4) and Rule 20(1), to state in writing the grounds of my decision and the materials I used in arriving at it. These are as follows.

In order for a trade mark to be registerable in Part B of the register S. 10(1) of the Ordinance provides that a trade marks, 'must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations in relation to the use with in the extent of the registration'.

In considering whether the mark is acceptable for registration in Part B of the register I am required by S. 10(2) of the Ordinance to have regard to the extent to which the mark is inherently capable of distinguishing the applicant's goods, and the extent to which, by reason of the use of the mark or of any other circumstances, it is in fact capable of distinguishing.

I have relied on the decision in *Electrix Ld.'s Application for Trade Marks* (1958) RPC 176, CA a decision which was upheld on appeal to the House of Lords and which is mentioned in *Kerly* (para. 8-50). In the Court of Appeal, at 192 it was said :-

'Quite obviously, the word "Electric" could never be registered in respect of electrical goods or appliances. It is an ordinary descriptive word which, however much it was used by any particular trader, could never be or become adapted to distinguish or capable of distinguishing the trader's electrical goods or appliances from those of any other trader.

As a potential trade mark in respect of electrical goods or appliances "Electrics" which is simply the word "electric" with an "s" added, or in other words a plural form of "electric", would in our opinion necessarily be regarded as meaning "electrical goods or appliances" . . . . . We cannot accept the view that the mere addition of the "s" would convert "Electric" into a fancy word as distinct from a purely descriptive one. It has not been, and in our view could not be, seriously disputed that "Electrics" could not be registered in respect of electrical goods or appliances in view of its close resemblance to "electric". That resemblance is, in our judgment such that no amount of user by any particular trader of the word "Electrics" in relation to his electrical goods or appliances could cause that word to be or

become adapted to distinguish his electrical goods or appliances from the general run of electrical goods or appliances all of which would naturally and inevitably be described as "electric".'

'Distinctiveness in fact is not conclusive in favour of a person seeking to register a descriptive mark. Even if the word in question has by use come to be identified with the applicant's goods in the eyes of substantial sections of the trade and the public, it may nevertheless be so inherently descriptive of goods of the particular kind, irrespective of origin, as to be incapable of being or becoming adapted to distinguish the applicant's goods from the goods of other traders' (page 181, 47-52). 'It is well settled that registration should not be granted in respect of any word the registration of which as a trade mark would give the applicant a monopoly of, or hamper or embarrass other traders in their use of descriptive words or expression of which they might reasonably and properly wish to make use in the ordinary course of their business' (page 182, 3-8).

The mark now seeking registration is a combination of the words 'a' and 'watch'. It describes precisely what the goods are and on the authority of the 'Electrix' case it is inherently incapable of distinguishing the applicant's watches from watches of other traders. No amount of user could make the word capable of distinguishing the applicant's goods.

I therefore consider I must exercise my discretion under S. 13(2) of the Ordinance adversely to the applicant the mark failing to satisfy the provisions of S. 10 of the Ordinance for registration in Part B of the register. The application is therefore refused.



(Teresa Grant)

Date : 20th May 1991