

1.5.88

I held a registrability hearing on the 18th of April 1989 regarding the mark "Superflexan" which has been applied for in Classes 24 and 25. In Class 25 the specification for goods is "soles, innersoles and parts and fittings for footwear". In Class 24 the specification of goods is "woven and non-woven fabrics included in Class 25".

I refer to the letter dated the 29th of March 1988 written to Deacons and it will be noted that our view is that the mark is highly descriptive and laudatory of the goods sold and cannot be accepted for registration pursuant to Section 9(1)(d) of the Trade Marks Ordinance.

Additionally I refer to the letter dated the 12th September 1988 to Messrs. Deacons where the Trade Marks Registry has rejected the marks for Part A and Part B and said the following :-

"The mark in Class 25 is considered to be visually and phonetically close to superflex connoting that the goods sold thereunder are exceptionally pliable and are apt to be parts of footwear. As

regards the mark in Class 24, it is considered to be phonetically and visually close to "superflaxen" connoting that the goods sold thereunder are made of or from flax of outstanding nature. Should it be otherwise, the mark is deceptive of the nature of the goods. In view of the circumstances, the mark cannot be considered to be inherently adapted to distinguish or capable of distinguishing the applicants goods to qualify for prima facie registration.

The application is therefore refused".

At the hearing Mr. Stephenson conceded that there was no promotional material and that the mark had not been used in Hong Kong or anywhere else.

Mr. Stephenson's basic thesis was that the mark for both classes was acceptable because it was either an invented word under Section 9(1)(c) of the Trade Marks Ordinance, and under Section 9(1)(d) of the Trade Marks Ordinance, because it had no direct reference to the character or quality of the goods.

Mr. Stephenson's main point was that the word "Superflexan" was an invented word and he referred me to the Yourt Trade Mark (1985) R.P.C. (at page 363); he referred to page 369 and the criteria for invented words referred to by Mr. Myall.

Mr. Stephenson said that the first criterion was that the invented word must be newly coined and asked who had heard of "Superflexan" before. As regards Myall's second point i.e. that the word must not be a word which convey some obvious meaning to an ordinary English speaking citizen, Stephenson said that the word "Superflexan" had no obvious meaning. Stephenson ^{went} to the third point of Myall which was that it must not be a mere combination of English words although it might be a compound word. His point was that "Superflexan" was not a mere combination of two English words. As regards the fourth point he said that this was not relevant because it was not a foreign source of word. As regards the fifth point Stephenson said that he was unable to see any covert and skilful illusion to the character and quality of the goods in this mark and as to the sixth point i.e. that the invented word should not be a word which undergone a mere variation of its orthography or termination, Stephenson said he did not know what English word the Registrar was saying that "Superflexan" was a variation of.

Stephenson referred to the letter of the 12th September 1988 from the Registrar of Trade Marks to Deacons and said that no trader would use an abbreviation meaning flexible if he meant pliable. Stephenson said that the trader would use the word pliable for some variation of pliable. As regards the objection in Class 24 Stephenson said that the word i.e. "Superflexan" was not a variation of the word "flax". "Flax" and "flex" were

different words, but the suffix of the mark was "flexan" which was not a dictionary word. Stephenson said that the Registrar must not break down a mark by the direct reference. He said that though "flex" is short for "flexible", it was meaningless when joined to "flexan". Stephenson said that could not describe a fabric as flexible or sole as flexible. Flexible is not apt to describe fabrics or soles. Stephenson then referred to para. 8-19 of Kerly (12th Edition) and went on to say that if "Superflexan" is meaningless the word "super" need not detract from its distinctiveness. "Super" was laudatory when used on its own or used with other non-distinctive or descriptive letter. He said that an invented word could not be rendered laudatory. Stephenson referred to the quote from Lord Macnaghten from the Solio Case (to be found at pages 80 and 81 of Kerly) and said that "Superflexan" was wholly meaningless, although it was not necessary that it should be wholly meaningless.

I have considered all the submissions made by Mr. Stephenson. It is apparently the case that the word "flex" is noted in the dictionary of slang as a abbreviation for "flexible". However I can find no meaning attributable to the word "flexan". The question is whether the Trade Marks Registry was right to its objections in its letter dated the 29th March 1988 and its letter dated the 12th September 1988 that the mark can be said to fall foul of Section 9(1)(d) of the Ordinance. I believe that the question of whether there is a direct reference

was dealt with in greater detail in the letter dated the 12th September 1988 to Deacons and I take them in order. As regards the Class 25 category the objection really is that the goods are exceptionally pliable and I think to get this view one must go to the abbreviation of "flex" as meaning "flexible" and then see that "flexible" is to be found in the dictionary as meaning pliable (see Concise Oxford Dictionary 7th Edition at page 373). I think, with respect that this is to go too far in breaking down the mark. I agree that "flexan" is undoubtedly an invented word because I can see no meaning attributable to it in the dictionaries.

I think that "Superflexan" in Class 25 therefore creeps in as a word which has no direct reference to the character and quality of the goods and may indeed be acceptable even as an invented word. Then one comes to the objection in Class 24 for that particular specification of goods where the directly descriptive quality of the mark apparently is that because it is close to "Superflaxen". Here I think the Trade Marks Registry is in difficulties in attributing two different sorts of meaning to the word "Superflexan" in accordance to whether these specifications is Class 24 or in Class 25. I agree with Mr. Stephenson that the word "flaxen" is different from "flexan" and that it really is too far-fetched to say that the mark connotes of the goods sold thereunder are made of or from "flax" of outstanding nature. I agree with Mr. Stephenson that this objection

under Class 24 is not a very satisfactory one. I also think it will be rather odd for us to take two different types of descriptive objections one relating to Class 25 and that the other to Class 24.

Overall I have to come to the conclusion that this trade mark is registrable in Part A Class 24 and Class 25.

R.J. Perera

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