

Application No. 16869/1998

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

AND

IN THE MATTER of an application by
Michael L. Pryce for the registration of the
trade mark **FLAT!FOOT** in Class 10

**DECISION
OF**

Mr. Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a request for
Statement of Grounds of the Registrar's decision made by Messrs. Robin Bridge &
John Liu on behalf of the applicant.

1. On 16 December 1998, Michael L. Pryce, a citizen of the United States of America (“the applicant”), applied, pursuant to the provisions of the Trade Marks Ordinance (“the Ordinance”), to register, in Part A of the Trade Marks Register (“the Register”), in Class 10, the mark, a representation of which appears below :



(“the suit mark”). The goods for which registration was sought were : “corrective shoe insoles”.

2. The Registrar of Trade Marks (“the Registrar”) determined that the words “FLATFOOT” contained a direct reference to the character or quality of the goods and further that the device of a foot was neither inherently adapted to distinguish nor inherently capable of distinguishing the applicant’s goods from similar goods of others. The suit mark was accordingly unacceptable for registration, *prima facie*, in either Part A or Part B of the Register.

3. The applicant did not contest the determination regarding Part A registration but argued that the suit mark qualified for registration in Part B of the Register. To facilitate a re-examination of the suit mark the applicant sought permission to amend the application by transferring it from Part A to Part B of the Register. The Registrar was not persuaded by the arguments that the suit mark was registrable in Part B.

4. The applicant then offered to separately disclaim the word “FLAT”; the word “FOOT” and the exclusive right to use a device of a foot. The Registrar determined that such disclaimers did not assist the application.

5. The impasse thus reached became the subject of an “informal discussion” between the applicant’s agent and the Registrar. The Registrar maintained her position with regard to the mark being *prima facie* unregistrable and it is from this decision that the

applicant has requested the Registrar to state in writing the grounds for her decision and the materials used by her in arriving at it. These are given as follows :

6. Section 9 of the Ordinance is a restrictive provision. Registration in Part A can only be achieved if the mark contains or consists of at least one of the essential particulars listed in paragraphs 1(a)-(e) inclusive.

7. The suit mark is not the name of a company, individual or firm represented in a special or particular manner within the meaning of section 9(1)(a) of the Ordinance; nor does it comprise the signature of the applicant for registration or of some predecessor in his business within the meaning of section 9(1)(b) of the Ordinance. Neither “FLAT”, “FOOT”, “FLATFOOT” nor “FLAT FOOT” are invented words within the meaning of section 9(1)(c). I turn to the question whether the word element of the suit mark satisfies the requirements of section 9(1)(d) as “a word or words having no direct reference to the character or quality of the goods ...”, the prohibition relating to the registration of geographical names or surnames not being relevant in the context of the suit mark.

8. A preliminary issue is whether the mark sought to be registered is properly “FLATFOOT” one word, or “FLAT” and “FOOT”. The applicant contends for the latter interpretation viz :

“The word element of the mark is not the single word “FLATFOOT” but the two separate and distinct words “FLAT” and “FOOT” clearly separated by the fanciful and distinctive representation of the device of a foot” – letter to Registrar dated 2 September 1999.

The significance of the distinction is that the Registrar based her objection upon the former spelling in saying :

“The word “flatfoot” refers to “a condition in which the entire sole of the foot is able to touch the ground because of the flattening of the instep arch.” It is thus indistinctive and of direct reference to corrective foot insoles for the treatment of flatfoot...”

9. I am of the view that ultimately this is a distinction without a difference.

10. Firstly, the spelling of the medical condition is not consistent, in fact, if INTERNET searches are indicative, the different spellings are interchangeable. I need refer to only three sites independent of the applicant, namely <http://www.ccmckids.org> “[Flat Foot – A complaint of significant pain is a warning signal and is often associated with peroneal muscle spasm and a rigid flatfoot]”; <http://www.footcaredirect.com> “[But people with a flat foot or the opposite condition, a highly arched foot, that are painful, are certainly in need of treatment]”; and <http://www.fc-foot.clinic.com> “[Flat foot, the opposite of high arch, is often misunderstood as fallen arches or broken arches.]”. A further site at <http://www.2ndwind.com> features the applicant as the inventor of the Flat Foot Insole. Throughout the site there is reference to the condition Flat feet and near the bottom of page 2, “click for Flat Foot Symptoms & Injuries”; and “click for why Arch Supports Don’t Stop Flat Foot Over-Pronation”.

11. The relationship between the sponsor of the latter site and the applicant has not been clarified in the materials available to me but it seems reasonable to infer that the applicant is aware of the site that displays his photograph and is aware of the spelling adopted for the medical condition his invention is designed to alleviate. It is disingenuous to argue therefore that the words, as used in the suit mark, have no reference to the medical condition spelt in dictionaries as “flatfoot”. I hasten to add that all the above INTERNET addresses were advised to the applicant’s agents prior to the informal discussion.

12. Secondly, the principle to be drawn from *Minnesota Mining & Manufacturing Coy’s Appln.* 65 RPC 229 is that it is the effect of the mark on a person hearing or reading it that is important. The mark in that case was “Scotchlite” which the learned Judge considered would be construed “no more or less than the two words “Scotch” and “light” and conveying the same meaning as if written separately”. “FLAT” and “FOOT”, in the context of corrective shoe insoles, would be construed, in my mind, by a person hearing or seeing the mark, as no more or less than the single word “flatfoot”.

13. This is a convenient moment to dispose of another of the applicant’s arguments, namely that the word “flatfoot” had more than one meaning, it being accepted in ordinary English usage as a colloquial expression for a policeman. This argument has two flaws. Firstly, if the applicant maintains that his mark is FLAT and FOOT, it cannot mean a policeman for the correct spelling of the colloquial policeman is “flatfoot”.

14. More importantly, it has been authoritatively held by the English Court of Appeal in *CANNON Trade Mark* [1980] RPC 519, that where words have more than one

ordinary signification it is not necessary to determine which meaning is the paramount meaning. Though that case concerned surnominal signification, the principle that can be drawn from the case is that if one of the ordinary meanings of a word or words is objectionable, then the fact that another meaning might not be is of no consequence. Whether flatfoot may also ordinarily mean a policeman therefore does not save the application if it also ordinarily means the medical condition which the Registrar considered was directly referred to by the suit mark.

15. I return to the objection taken by the Registrar under section 9(1)(d). The test to be applied was succinctly stated by Dixon C.J. in *Mark Foy's Limited v Davies Coop and Company Limited* [1956] 95 C.L.R. 190.

“The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess” – p.195.

16. The ordinary person will most likely encounter the applicant's goods in that section of a pharmacy that displays lotions, powders, supports, plasters, pads and inner-soles for the treatment or alleviation of the discomfort associated with foot complaints. A person looking for some over-the-counter relief from the discomfort of flatfoot, upon seeing the suit mark applied to a pair of inner sole inserts, could only conclude that the attribute of the product is that it is designed for the treatment, or at least the alleviation of the discomfort associated with his condition. The reference could be no more direct than if a pain relief tablet bore the trade mark “Headache”. The applicant's counter-argument that flatfoot might connote that the goods would produce “flatfoot” is utterly untenable.

17. The onus of establishing that the mark has no direct reference to the character or quality of the goods lies with the applicant – Lloyd-Jacob J. in *American Screw Coy's Appln* [1959] 14 RPC 344. I am not satisfied that the applicant has discharged his onus of establishing that the mark has no direct reference to the character or quality of the goods.

18. This does not dispose of the Part A application, for even a word or words which fail to qualify under subsections (1)(a) to (d) may, in certain circumstances, nevertheless qualify under subsection (1)(e) if distinctive. Similarly, if the device of the foot or footprint were found to be distinctive within the meaning of sub-sections 9(2) and (3) then the mark might still be allowed with the disclaimer of the right to the exclusive use of the

word “FLATFOOT”.

19. Section 9(1)(e) provides however that, in respect of a word that does not qualify under sub-sections (1)(a) – (d), it shall not be registrable except upon evidence of its distinctiveness. The applicant has filed no evidence to show that by reason of use, it is in fact adapted to distinguish. In the circumstances, insofar as the word element is concerned, the mark does not qualify under section 9(1)(e).

20. The device of a foot or a footprint, in my mind, does not possess an inherent ability to distinguish the goods of the applicant from the same or similar goods of others. Whether the print is consistent with the print that would be made by a sufferer of flatfoot or by one relieved of the complaint is not material. The device merely reinforces the words graphically. The fact that a footprint device is not unique to the applicant in the context of foot care products and thereby be capable of indicating origin can be seen from revisiting the INTERNET site <http://www.fc-foot-clinic.com> where a footprint is found in the heading of the article on high arches and flat feet. As the applicant has filed no evidence that use of the device element has made the mark adapted to distinguish in fact, I find that the suit mark as a whole lacks distinctiveness and cannot be accepted for Registration in Part A of the Registrar.

21. I turn to the question of whether the suit mark could be regarded as “capable, in relation to corrective shoe insoles, of distinguishing” within the meaning of section 10. The distinctiveness addressed by the section is still the capacity of the mark of distinguishing goods with which the proprietor is or may be connected in the course of trade from goods in which no such connection subsists.

22. It has often been stated that this capability can be tested by asking whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods and this is to be determined quite apart from the effects of registration – see *Registrar of Trade Marks v W&G Du Cros Ltd* [1913] AC 624 at 634-5.

23. It is difficult to conceive how another producer of inner soles intended for the correction or the alleviation of the discomfort associated with flatfoot could adequately describe the intended use of his product without using the word flatfoot descriptively. To paraphrase what Robin Jacob QC stated in *COLORCOAT Trade Mark* [1990] RPC 511 at 516 –517, when considering registration, one is not concerned to look too closely at what

would constitute infringement or a defence thereto. The privilege of a monopoly should not be conferred where it might require honest men to look for a defence.

24. In my judgment, the word element of the suit mark, having as it does a very direct and close reference to the character or quality of the goods, in that it indicates their intended purpose, is an element that is likely to be required by other honest traders and therefore cannot possess the capacity of distinguishing the applicant's goods inherently within the meaning of section 10(2)(a).

25. In the absence of evidence of use or other circumstances the word element of the suit mark has not been shown to be in fact capable of distinguishing within the meaning of section 10(2)(b). I am accordingly bound to conclude that the applicant has failed to establish that the mark could properly be placed upon the Register in Part B.

26. I wish also to refer to the case of *CHIROPRACTIC Trade Mark* [1971] RPC 133 where the word "chiropractic" was sought to be registered for mattresses. It had been argued for the applicants that the word was not descriptive of mattresses since the latter do not perform any chiropractic or manipulative treatment (first instance); and, alternatively, that the word cannot be referable to a mattress and therefore cannot be apt to describe any character or quality of a mattress (on appeal). The hearing officer dealt with the argument in this way :

"But to my mind, in the light of the dictionary definition, the words "chiropractic mattress" connote immediately and very directly a mattress suitable, adapted, or adaptable for the needs, either in the course of treatment or for the purposes of subsequent relief or rest, of a person undergoing chiropractic treatment or for whom such treatment might be appropriate. It is, I think, a matter of common knowledge, that to persons suffering from or being treated for various conditions of the body, particular kinds of bed or mattress are desirable and often essential – e.g. persons with certain spinal conditions find it beneficial to sleep on beds and mattress with a high degree of rigidity. It might indeed be a difficult matter to decide whether a particular bed or mattress selected by or for a person undergoing chiropractic treatment was a bed or mattress primarily for sleeping (class 20), but chosen, for example, for its degree of hardness, or was a bed or mattress for surgical or curative purposes (class 10), being special constructed, or adapted for these purposes, in which latter case repose in a particular position, constrained by the shape of the mattress, might afford a remedial adjustment of the body structure. But it seems to me quite

clear that for mattresses in general (whether or not specifically intended for surgical or curative purposes) the word CHIROPRACTIC is highly and directly descriptive, connoting mattresses for persons undergoing chiropractic treatment or for whom such treatment would appear to be appropriate, either constructed or adapted for their treatment or relief or suitable for their rest.

Apart from paragraphs (c) and (d) of section 9(1), the mark is in my view non-distinctive for the purpose of paragraph (e). The word CHIROPRACTIC is I think so obviously and necessarily required for descriptive use in relation to mattresses having characteristics desired or needed by persons undergoing or interested in chiropractic treatment as to render it wholly non-distinctive as a trade mark, and it would consequently be an intolerable embarrassment for traders in such mattresses if their ordinary descriptive use of the word CHIROPRACTIC in the course of trade were to be confused, as it almost inevitably would be, with a trade mark consisting of that word and registered in respect of mattresses.

I have carefully considered whether the mark could be regarded as suitable for entry in Part B of the register under provisions of section 10, but for the reasons I have already given, I conclude that the mark is so highly descriptive of certain types of mattress and so lacking in distinctiveness that it cannot be capable of distinguishing the mattress of any one trader from those of another.”

27. On appeal, Falconer, Q.C. said (p. 136) :

“I agree with the hearing officer that for mattresses the word CHIROPRACTIC is highly and directly descriptive, connoting mattresses for person undergoing chiropractic treatment or for whom such treatment would appear to be appropriate, or being either constructed or adapted for their treatment or relief or suitable for their rest.”

And later with regard to registrability under s.10:

“... I agree with the conclusion of the hearing officer that this mark is so highly descriptive of certain types of mattresses that it cannot be capable of distinguishing the mattress of any one trader from those of another.”

28. As regards the word element of the suit mark, as the facts are on all fours with the present application I propose to follow the reasoning of the hearing officer.

29. There remains the device element. As I have earlier stated, in my view the foot or footprint merely reinforces graphically, the words. It is not unique to the applicant and is in use by at least another provider of footcare products. As such it cannot be said to be inherently capable of distinguishing the corrective shoe insoles produced by the applicant from similar goods of others. That is not to say that the mark will always be incapable of distinguishing, but without the aid of evidence of factual distinctiveness, the whole is no more inherently capable than the words alone.

30. The final matter for my consideration is whether the offer to disclaim the three separate elements of the mark would overcome the Registrar's objections. For the reason that follows the answer is no.

31. With regard to the footprint device, as an indistinctive element, incapable of registration as a mark in its own right, a disclaimer is properly offered.

32. The objectionable element of the mark is not the separate words FLAT and FOOT but the word "FLATFOOT" for the reason that no other producer of a remedy for the condition could adequately describe the remedial purpose of his goods without trespassing upon the applicant's monopoly in the word. This cannot be permitted. The only form of disclaimer that could be accepted therefore is of the whole word "FLATFOOT", but this has not been offered.

33. In so saying I am not suggesting that an offer to disclaim any right to the exclusive use of the word FLATFOOT and a device of a footprint would make the mark acceptable for registration, rather that the applicant's offer misses the crux of the Registrar's objection.

34. To place the matter beyond doubt, it is the Registrar's view that an offer of a total disclaimer of elements which are totally descriptive of the character or attributes of the goods and which are neither inherently adapted to nor capable of distinguishing the goods of the applicant, does not cure the defect for the purposes of registrability. As stated by Lloyd-Jacob J in *Ford-Werke AG's Appln* (1955) 72 RPC 191 at 195, attention must be focused upon the content of the mark and not upon the content of the protection sought for the mark.

35. In arriving at my decision I have considered the written arguments made by the applicant's agents by letters dated 2 September 1999 and 30 March 2000; the written record made of the arguments raised in the informal discussion held on 8 September 2000; the Trade Mark Ordinance; The Trade Marks Rules; the authorities cited herein and the INTERNET searches identified herein made on the 2nd and 4th September 2000.

(K.S. Kripas)
p. Registrar of Trade Marks
9 April 2001