

## **TRADE MARKS ORDINANCE (CAP. 559)**

**APPLICATION NO.: 200204928**



**MARK:**

**CLASS: 25**

**APPLICANT: VANS, INC.**

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### **STATEMENT OF REASONS FOR DECISIONS**

#### **Background**

1. On 10 April 2002, Vans, Inc. (the “applicant”) applied to register the subject mark under the now repealed Trade Marks Ordinance (Cap. 43) in respect of “footwear” in class 25.
2. After the applicant had given notice under section 11 (conversion of pending application), Schedule 5 to the Trade Marks Ordinance (Cap. 559, the “Ordinance”), the application was examined under the provisions of the Ordinance and was treated as if it were filed on 4 April 2003, the commencement date of the Ordinance.
3. At the examination stage, objections were raised against the application under section 11(1)(b) on the basis that the mark is devoid of any distinctive character in respect of footwear.
4. In response to the objection, the applicant filed evidence of use of the mark. After considering the evidence, the examiner maintained the objection on the basis that in its totality, the evidence did not show that the mark had in fact acquired a distinctive character through use in respect of the applied-for goods before the date of application for registration for the purpose of section 11(2).

5. The applicant requested a registrability hearing which took place before me on 17 March 2006. The applicant was represented by Ms. Angela Li of Simmons & Simmons. I reserved my decision until after the hearing.

## **The Decision**

### *Prima facie case, section 11(1)(b)*

6. The examiner objected to the application by virtue of section 11(1)(b) of the Ordinance and he maintained that the objection cannot be overcome under section 11(2). Section 11(1)(b) & (2) reads as follows:

“(1) Subject to subsection (2), the following shall not be registered—

(a) ...

(b) trade marks which are devoid of any distinctive character;

(c) ...

(d) ...

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

7. The relevant principles relating to distinctive character were laid down by Mr. Justice Jacob in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (at page 306): -

“What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

8. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at para. 23):

“The distinctiveness to be considered is that which identifies a product as originating from a particular undertaking. Such distinctiveness is to be considered by reference to goods of the class for which registration is sought and consumers of those goods. In relation to the consumers of those goods the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers.”

9. In summary, distinctive character means, for all trade marks, that the mark must serve as a badge of origin to identify the goods or services as originating from a single undertaking, and therefore distinguish them from those of other undertakings. The distinctiveness of the mark has to be assessed in relation to the goods or services for which registration is sought taking into account the presumed perception of the relevant consumers.
10. I agree with Ms. Li that in the present case, the relevant consumers are members of the general purchasing public in view of the fact that the applied-for goods, i.e. footwear, are everyday merchandise.
11. Ms. Li argued that under the relevant laws and principles, a minimum degree of distinctiveness would be sufficient for a mark to be registrable. She submitted that this minimum degree of distinctiveness is satisfied because the mark is an original and unique design of the applicant developed at least 30 years ago. It is unique as it features an extraordinary pattern of a waffle which is made of super California gum rubber and the shoes to which the mark is applied are known as “VANS off the wall”, “off the wall grip” or “waffle grip”.
12. Considering the mark as applied-for, I find it is a representation of a fairly ordinary shoe sole. I do not consider that the “waffle pattern” (the term as submitted) is extraordinary for shoe soles and shoes. By reference to “footwear” for which registration is sought, I find the overall impression the mark creates is that it is a shoe sole with the tread or grip made up of crossed lines. When the mark is applied onto footwear, on first impression, an average consumer is likely to perceive it simply as part of the shoe, or tread or grip. Similarly, if used in advertising, consumers would be likely to see it simply as an indication of a feature of the goods. Consumers will not, without first being educated, see the mark as a badge of origin denoting that the goods come from a single undertaking.
13. Ms. Li referred me to previous acceptances of shoe sole marks in our register and other registries’ registers (e.g. UK and Australia) with a view to showing that shoe sole marks are registrable, and the subject mark has at least a minimum degree of distinctiveness for registration.
14. I do not find the examples comparable with the subject mark because they consist of shoe soles that have other elements such as words (e.g. house mark of the registrants), strip/s or other devices rendering the marks distinctive of the goods.
15. Ms. Li placed particular reliance on Registration No. 1998B08105 accepted by

our registry. It was Ms. Li's contention that the Registrar had considered the device of a shoe sole is capable of distinguishing and she saw no reason why the subject mark should be treated any differently.

16. Considering registration no. 1998B08105, I find that it incorporates a device on the sole of the shoes. However, I should mention that the mark is in fact no longer on the register. Moreover, as Ms. Li also noted, the mark was registered with a disclaimer of "a device of a sole of a shoe". This means that the registered owner shall have no right to the exclusive use of "a device of a sole of a shoe". It does not mean that an ordinary shoe sole without any element of distinctiveness could be registered.
17. In any event, it is well established that each case must be considered on its own merits and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 305). Therefore, the acceptances of the quoted example marks do not assist the subject application.
18. I have considered the overseas registration of the subject mark in various jurisdictions such as the US, Switzerland, Canada, Italy, Spain, Mexico, Taiwan etc. However, I find there are grounds of objection under the Ordinance and as such I cannot follow the decisions of other registries. This is especially so when the bases of acceptances in other jurisdictions are not available to me. In any event, trade mark rights are territorially limited and granted independently by each jurisdiction. The bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration in Hong Kong (*Automotive Network Exchange Trade Mark* [1998] R.P.C. at 885).
19. For the above reasons, assuming no use, I find the subject mark fails to function as a badge to identify that the applied-for goods are originating from a single undertaking, and therefore I find that it is devoid of any distinctive character under section 11(1)(b) of the Ordinance. I now turn to consider whether it has in fact acquired a distinctive character as a result of the use made of it.

*Evidence of use, section 11(2) of the Ordinance*

20. As correctly pointed out by Ms. Li, in assessing whether a mark has acquired a distinctive character as a result of the use made of it, the principles discussed in *Windsurfing Chiemsee* [1999] E.T.M.R. 585 (Joined Cases C-108/97 and C-109/97) are relevant. This case concerns the interpretation of Article 3(3)

of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which is broadly similar to section 11(2) of the Ordinance. At paragraph 54 of the case it is said that:-

*“a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings”*

It is also said that the competent authority must make an overall assessment of the evidence in determining the question.

21. Ms. Li also cited *Société des Produits Nestlé SA v Mars UK Ltd. (HAVE A BREAK)* [2006] F.S.R. 2 (Case C-353/03), where it is said in paragraphs 27 and 32 that in regard to acquisition of distinctive character through use, the mark in respect of which registration is sought need not necessarily have been used independently. Distinctive character may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.
22. The applicant filed evidence of use of the subject mark on 13 May 2005 by way of statutory declarations (each hereinafter referred to as “S/D”, collectively as “S/Ds”) of Steve James Van Doren and Wong Chi Keung (“Wong”). Having carefully considered the evidence, I am of the view that the evidence does not in its totality establish that the mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2). The reasons are as follows.
23. It was averred that the mark was first used in Hong Kong in around 1984. Despite this, only sales figures and advertising figures for the period of October 2000 – October 2003 are provided. As the date of the subject application is 4 April 2003, pre-application figures of only around 2.5 years were shown. Random copies of catalogues are provided in Exhibit 1, the earliest of which is in year 2002. In this light, despite the claim of first use is in 1984, the extent of use of the mark in respect of the applied-for goods is unclear. It follows that it is difficult to ascertain whether consumers are sufficiently educated by the use of the mark so as to recognize it as a badge of trade origin of the applied-for goods.

24. To show use of the mark in respect of footwear, the applicant produced certain catalogues in exhibit 1 to Wong's SD, i.e. Footwear Catalogues of Spring 2002, Fall 2002 and Spring 2003. However, there is no indication whether the catalogues were circulated in Hong Kong, and if so, the scope and extent of the circulation.
25. More importantly, the catalogues show that the mark is always placed beside other pictorial illustrations of the side view of shoes. The mark usually appears in a relatively smaller size as compared with the side views. Beside the pictorial illustrations are descriptive texts describing the materials made of the "upper", "midsole" and "outsole" etc. In this context, I consider the mark would be seen by the average consumers of footwear as an illustration of one of the features of the shoes, that is, the structure or appearance of the sole. It is there to give information to consumers about the characteristics of the shoes.
26. The catalogues also show some other shoe soles that are different from the subject mark, e.g. shoe soles made up of contrasting materials (for shoe model "EXACERBATE II"), or of an entirely different design (for "WALLOWS" and "GRAPH V"). The use of different representations of shoe soles in the catalogues point to the fact that the mark and the other shoe soles would be seen by consumers simply as illustrations of the characteristics of the footwear being sold.
27. In addition to showing the mark and the shoes, the catalogues show, prominently, the mark "VANS". Also, there are some shoe soles that incorporate the word "VANS". Bearing in mind the "*Have a Break*" case, referred to in paragraph 21 above, I consider that while a mark may acquire a distinctive character in consequence of the use of that mark as part of or in conjunction with another trade mark, the manner of the actual use of the mark must be considered, that is, whether it in fact independently serves to denote the trade origin of the goods concerned. In view of the manner of actual use of the subject mark as considered in the preceding two paragraphs, I do not find the subject mark serves to denote the trade origin of the applied-for footwear or has in fact acquired a distinctive character.
28. Similarly, in the Hong Kong advertising materials in Exhibit 7 to Wong's SD, the mark appears among a number of other pictorial depictions of footwear.

Presented in this way, the mark appears simply as one of the illustrations of the product. In this context, I do not consider that consumers would come to recognize that the mark is a badge of trade origin. There is nothing in the materials to indicate to consumers that the mark is used to denote the trade origin of the footwear advertised.

29. Similar to the situation of catalogues, the house mark “VANS” is used prominently in the Hong Kong advertising materials. Although this does not necessarily preclude the acquisition of distinctive character in the subject mark, for reasons I have given above, I find the subject mark has not in fact acquired a distinctive character.
30. The Hong Kong advertising materials also show that other traders such as Nike and Converse advertise their shoes as having soles with certain characteristics. Ms. Li argued that these advertising materials show that other traders are designing shoe soles to indicate their brands and to distinguish their products from others’. Ms. Li also contended that it is becoming more and more popular for footwear traders to do this.
31. However, even if other traders and the applicant design shoe soles with the intention of using them to denote the trade origin of their goods, the crucial question is whether the average consumers would perceive them as such.
32. In this connection, I refer to *Henkel v OHIM* [2004] E.C.R. I-0000 (Joined Cases C-456/01P and C-457/01P) where it was said at paragraph 38 that “average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark”. Besides, at paragraph 39, it was said that “in such circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulations No. 40/94 (which is broadly similar to section 11(1)(b) of the Ordinance)”. Bearing in mind these principles and having considered the materials submitted before me, I am not convinced that consumers would perceive shoe soles in general as badges of trade origin. I also find that the evidence in this case does not indicate that the applicant has

been successful in educating the relevant consumers that the mark applied for serves as an indicator of origin.

33. Other advertising materials are provided in Exhibit 6 to Wong's SD. However, they are overseas materials, e.g. sample advertisements in the US, Japan and Taiwan and as such, they are of little assistance in showing that the mark has acquired a distinctive character as a result of use in Hong Kong.
34. In view of the foregoing, I find that the evidence does not show that the mark has, prior to the date of the application, come to identify the applied-for goods as originating from a particular undertaking. The evidence does not show that the mark has in fact acquired a distinctive character in Hong Kong as a result of the use made of it for the purpose of section 11(2).

### **Conclusion**

35. For the reasons given, I conclude that the subject mark must be refused under section 11(1)(b) and section 42(4)(b) of the Ordinance. In this decision, I have considered all the submissions made and evidence filed by the applicant in respect of the subject application.

Doreen Wan  
for Registrar of Trade Marks  
29 June, 2006