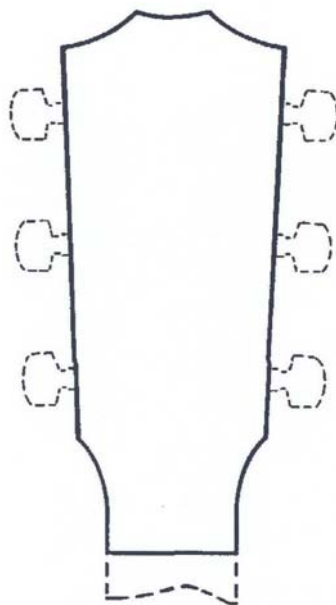


TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300020654
APPLICANT: TAYLOR-LISTUG, INC.
CLASS: 15



MARK:

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 May 2003, Taylor-Listug, Inc. the ('Applicant') of California, United States of America applied to register the mark shown above (the 'subject mark') under the Trade Marks Ordinance (Cap. 559) ('Ordinance').
2. Registration is sought in respect of the following goods in Class 15:

'Musical instruments, guitars'.
3. Objections were raised under sections 11(1)(b), 11(1)(c) and 11(3)(b) of the Ordinance.
4. The Applicant called for a hearing on the registrability of the subject mark which took place on 14 February 2005.
5. On 7 February 2005, the Applicant filed skeleton arguments together with a statutory declaration of Ms Wong Wai Man Deanna declared on 7 February 2005 (the "SD"). The SD included information concerning the Applicant's

certain foreign registrations, examples of other marks on the Register and copies of website pages showing some guitars by other makers.

6. Ms. Deanna Wong of Lovells appeared on behalf of the Applicant at the hearing on 14 February 2005.
7. The following cases were referred to at the hearing:
 - (a) *EUROCOOL* (Case T-34/00) (Court of First Instance of the European Communities) (27 February 2002);
 - (b) *Mag Instrument Inc. v OHIM* (Case C-136/02) (European Court of Justice) (7 October 2004);
 - (c) *Henkel KGaA v OHIM* (Joined Cases C-456/01 P and C-457/01 P) (European Court of Justice) (29 April 2004);
 - (d) *Philips v Remington* (Case C-299/99) (European Court of Justice) (18 June 2002);
 - (e) *Philips v Remington* [1999] R.P.C. 809 (CA) (5 May 1999); and
 - (f) *Jeryl Lynn Trade Mark* [1999] F.S.R. 491 (Ch. D.)
8. I reserved my decision at the end of hearing.
9. The Applicant did not file any evidence of acquired distinctiveness under section 11(2) of the Ordinance. I therefore have only the *prima facie* case to consider.

The relevant provisions

10. Section 11 of the Ordinance provides that:

“(1) Subject to subsection (2), the following shall not be registered ---
 (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
 (b) trade marks which are devoid of any distinctive character;
 (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services;
 ...”

“(3) A sign shall not be registered as a trade mark in relation to goods if it consists exclusively of ---
 (a) ...
 (b) the shape of goods that is necessary to obtain a technical result;
 ...”

Decision

Section 11(3)(b)

11. The subject mark is shown on page 1. It is described in the application form as follows:

‘The trade mark consists of the shape of the peghead of a guitar as shown in solid lines in the representation affixed hereto. The dotted lines are for showing the location of the turning keys on the peghead of the guitar and for showing the connection of the peghead with the neck of the guitar. The dotted lines are not part of the trade mark.’
12. I do not consider that all the essential features of the shape constituting the subject mark are attributable solely to some technical result. The subject mark therefore does not consist exclusively of the shape of goods that is necessary to obtain a technical result. Objection under section 11(3)(b) is hereby waived.

Section 11(1)(b)

13. Under section 3 of the Ordinance, the shape of goods may constitute a trade mark, provided, first, that it is capable of being represented graphically and, second, that it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.
14. For a trade mark to possess distinctive character for the purposes of section 11(1)(b), it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish the goods or services from those of other undertakings (*Henkel*, supra, paragraph 34; *Mag Instrument*, paragraph 29). It must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (*Philips v Remington* (ECJ), supra, paragraph 30).
15. The Applicant relies on the *EUROCOOL* case, in particular paragraph 39, and submits that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in section 11(1)(b).
16. It is clear that whether the required degree of distinctiveness is described as minimal or otherwise, a mark must as a whole perform the essential function of distinguishing the Applicant’s goods or services from those having a different commercial origin (*EUROCOOL*, paragraph 51).
17. The distinctive character of a trade mark within the meaning of section 11(1)(b) must be assessed by reference, first, to the goods or services in respect of which registration is sought and, secondly, to the perception of the relevant public. That means the presumed expectations of an average

consumer who is reasonably well informed and reasonably observant and circumspect (*Philips* (ECJ), paragraph 63; *Henkel*, paragraph 35; *Mag Instrument*, paragraph 19).

18. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (*Mag Instrument*, paragraph 20).

19. The subject mark consists of the shape of the peghead of a guitar as shown on page 1, without any word or device on it. In the representation of the subject mark included in the application form, six turning keys are shown in dotted lines to show their location on the peghead. At the hearing, Ms Wong drew my attention to the following entry in the Concise Oxford Dictionary:

“**guitar** *n.* a usu. six-stringed musical instrument with a fretted finger-board, played by plucking with the fingers or a plectrum.”

This accords with our everyday experience that a guitar is usually six-stringed.

20. The subject mark is essentially in the shape of a quadrilateral, with three curved scallops at the top, and tapering towards one end to join the neck of the guitar. As the subject mark consists only of the shape, in order not to be precluded from registration by section 11(1)(b) of the Ordinance, the shape by itself must serve to identify the musical instruments applied for as originating from a particular undertaking, and thus to distinguish them from those of other undertakings.

21. At the hearing, Ms Wong drew my attention to the fact that there are guitars without pegheads. Turning keys (or tuners) can be located elsewhere in the guitar, e.g. along the neck or near the base of the guitar. There is no need to have a peghead in a guitar, and therefore there is no need for a peghead in the shape applied for in order to obtain the necessary technical result. The Applicant submits that since pegheads are not necessary, they are there for some other reasons: the different shapes of pegheads are intended to be used to differentiate between different brands of guitars.

22. The fact that there are guitars without pegheads does not mean that all pegheads are there without any useful purpose. A peghead provides a platform through which the tuners (or turning keys, as they are called in the application form) are mounted. Lining up the six tuners for the six strings in a guitar three by three on both sides of the peghead is a practical arrangement. Spacing out the tuners allow easy tuning by the hand. Despite the fact that there could be other arrangements, this arrangement of the tuners is a simple and practical one.

23. It is not necessary, however, for pegheads to have three curved scallops at the top in order to achieve the spacing out of tuners as described above. On the

other hand, the fact that a certain part the shape is not entirely functional does not necessarily mean that it performs the function of a trade mark.

24. The Applicant submits that:
 - (a) pegheads are intended to be recognised and if the relevant public are shown the peghead shapes they will recognise them as those of particular brands;
 - (b) on seeing the shape constituting the subject mark as a whole, the average consumers of musical instruments are likely to assume that the goods come from a specific source;
 - (c) the subject mark therefore does indicate who the product comes from.
25. The criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of product itself are no different from those applicable to other categories of trade marks (*Philips* (ECJ), paragraph 48). Nonetheless, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark consisting of the shape of the product itself as it is in the case of a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. 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. In those circumstance, 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 the shape being devoid of any distinctive character for the purposes of Section 11(1)(b) of the Ordinance. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision (*Henkel*, paragraph 38-39; *Mag Instrument*, paragraph 30-31).
26. Where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a 'variant' of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purpose of section 11(1)(b). It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well-informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (*Mag Instrument*, paragraph 32).
27. The Registry has in its letter dated 30 December 2004 provided some examples of similar pegheads of guitars by various makers. These examples have been incorporated into attachment "D" to the SD. The

Applicant submits that there are significant differences between those pegheads and the subject mark.

28. A few of such examples are now reproduced at the *Annex*. The Applicant submits that the peghead with the word “GUILD” on it has three fan-like curves at the top, whilst the peghead with the word “Gibson” on it has two curves joined to form almost an inverted “V” at the top. The sides of the GUILD peghead are curved, whilst the sides of the Gibson peghead are completely straight.
29. A common shape of pegheads is an essentially quadrilateral shape. Pegheads often bear the maker’s name or logo. Viewed as a whole, the subject mark is a mere variant of a common shape of peghead and does not depart significantly from the norm. Although there are three curved scallops at the top end of the subject mark, given that there are limited design choices for the top of the peghead and the fact that pegheads often bear the maker’s name or logo, the average consumer would not rely on the shape alone as an indicator of origin. On seeing the shape constituting the subject mark, the average consumer would not come to the conclusion that “by this shape I know I can rely upon getting goods from the same maker as before” (*Bongrain SA v Trade Mark Registry* [2004] All ER (D) 295 (Dec), paragraph 28). The subject mark is therefore devoid of any distinctive character.
30. The Applicant drew my attention to the acceptance of the subject mark in New Zealand and the acceptance of a similar mark in the United States of America. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885 at 887).
31. The Applicant also referred me to various three-dimensional marks registered in Hong Kong.
32. Each case must be considered on its own merits and not by reference to other marks. As stated in *British Sugar Plc v James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 305, “It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g.* *MADAME Trade Mark*¹ and the same must be true under the 1994 Act.”
33. For the above reasons I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance.

Section 11(1)(c)

34. As I have found that the subject mark is devoid of any distinctive character, registration of the subject mark must be refused. It is therefore unnecessary

¹ [1966] R.P.C. 541

for me to consider the objection under section 11(1)(c).

Conclusion

35. Having considered all the documents duly filed by the Applicant and all the arguments submitted in relation to this application, I find that the subject mark as a whole is devoid of any distinctive character, and is precluded from registration by section 11(1)(b) of the Ordinance. Accordingly, I refuse the application under section 42(4)(b) of the Ordinance.

Finnie Quek
for Registrar of Trade Marks

4 May 2005

