

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NOS.: 300076077AA, 300076220AA, 300076202AA,
300076185AA, 300076158AA, 300076095AA,
300076121AA & 300082133AA

APPLICANT : GENERAL MOTORS CORPORATION

CLASS: 16

MARK: Devices (motor vehicles)

STATEMENT OF REASONS FOR DECISION

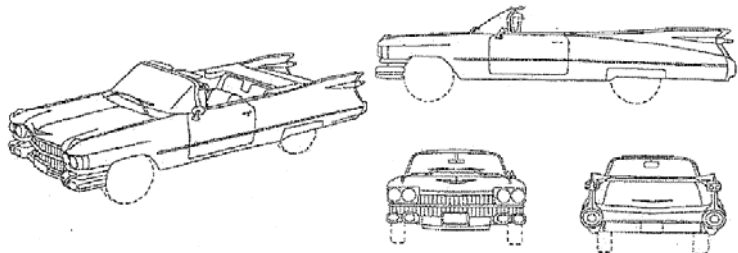
Background

1. On 9 September 2003, General Motors Corporation (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the marks shown below under classes 16 and 25.

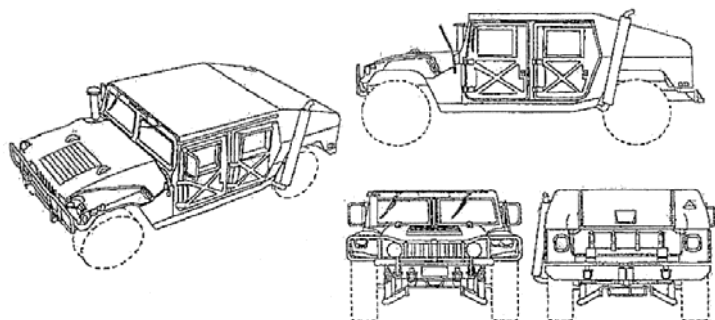
Application Number

Applied-for Mark

300076077



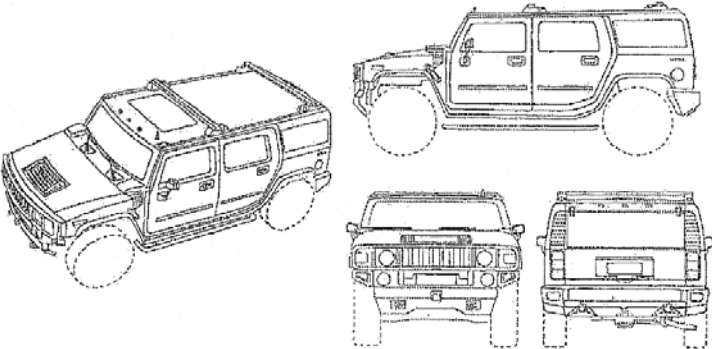
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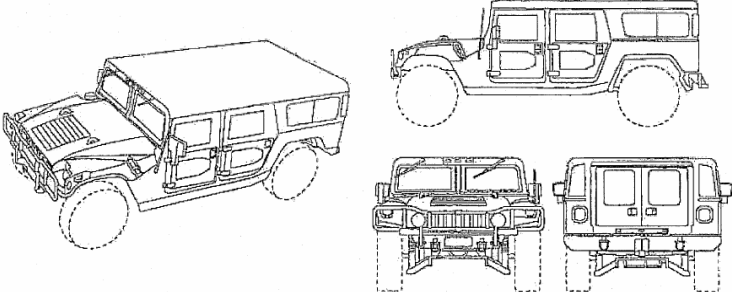
Application Number

Applied-for Mark

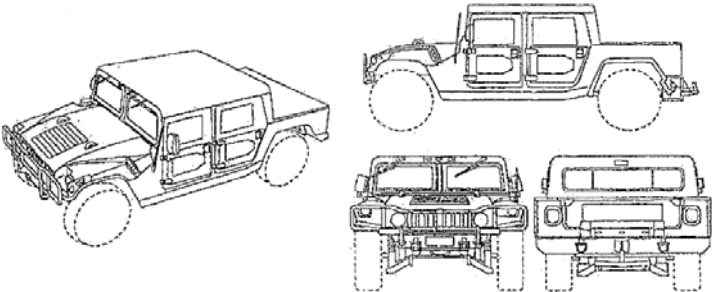
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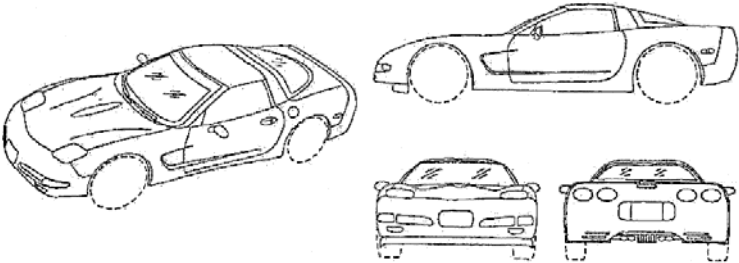
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300076158



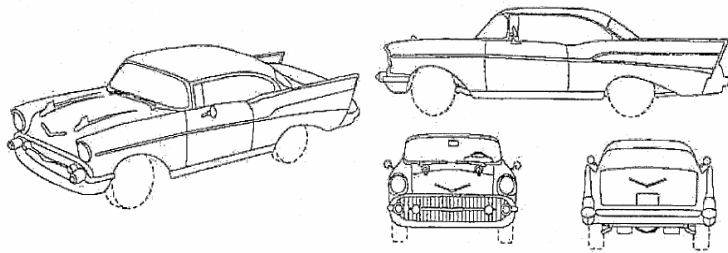
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Application Number

Applied-for Mark

300076121

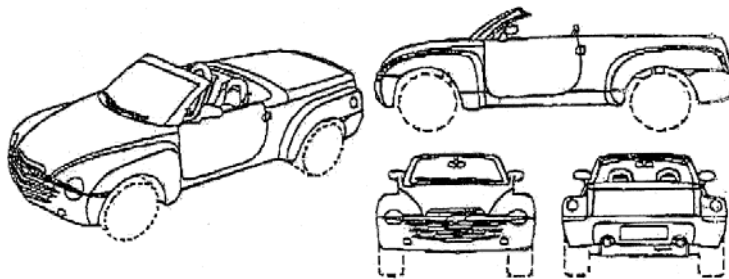


2. On 22 September 2003, the applicant made a further application to register the mark shown below, also under classes 16 and 25.

Application Number

Applied-for Mark

300082133



3. Pursuant to rule 27 of the Trade Marks Rules (Cap. 559 sub. leg. A) (“the Rules”), the applicant subsequently divided each of the above eight applications into two divisional applications: one in class 16, and the other in class 25. The applicant’s applications accordingly comprise two groups of divisional applications: one group of eight divisional applications in class 16, with the suffix “AA” assigned to their application numbers (“the subject applications”), and the other group of eight divisional applications in class 25, with the suffix “AB” assigned to their application numbers.
4. The divisional applications in class 25, i.e. the “AB” applications, were subsequently accepted for registration, whereas the “AA” applications, the subject applications, were subject to further examination.
5. The subject applications are made in respect of the following goods in class 16:

“printed materials; namely manuals, brochures, and catalogs pertaining to the features and controls, operation, maintenance, service and repair, and technical facts and specifications of motor vehicles; stationery, memo boards, bulletin boards, folders, files, packaging materials namely containers; advertising materials, signs and figures, printed periodicals, photographs, posters, printed reproductions, namely lithographs prints, pictures, paintings, books, catalogues, calendars, display albums, diaries, maps, writing and drawing instruments, namely pens, pencils, markers, erasers, rulers, compasses; stencils, instructional and teaching materials, namely books, pamphlets, brochures; gift tags; wastepapers baskets, gift-wrap, ribbons, bows, labels, and stickers, clipboards, memo or note pads, postcards, greeting cards, books to color and sew, paint sets, coloring books; paper napkins, paper table-covers, paper plates, paper cups; invitations, stickers, book ends, place mats.”

6. At the examination stage, objections were raised against the subject applications under sections 11(1)(b) and 11(1)(c) of the Ordinance on the basis that each of the applied-for marks (“the subject marks”) consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied-for goods and is devoid of any distinctive character.
7. Additionally, objection was raised under rule 8 of the Rules on the basis that the representations of the subject marks filed do not permit a proper examination to be made of the subject marks and that the representations are not of a kind and quality that is suitable for registration.
8. A hearing on the registrability of the subject marks took place before me on 25 October 2005 at which Mr Anthony Evans of Messrs Robin Bridge & John Liu appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.
9. The applicant did not file any evidence of use of the subject marks. I therefore have only the *prima facie* case to consider.

The Ordinance and the Rules

10. It is convenient for me to first set out the main provisions of the Ordinance and the Rules relevant for my consideration of the subject applications.
11. Section 11(1) of the Ordinance provides that:

- “(1) Subject to subsection (2), the following shall not be registered –
- (a) ...
 - (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; and
 - (d) ...”

12. Rule 8 of the Rules provides that:

- “(1) The representation included with an application for registration of a trade mark shall depict the trade mark clearly and in sufficient detail to permit a proper examination to be made of the trade mark and shall be of a kind and quality that is suitable for reproduction and registration.”
- (2) The Registrar may at any time require the applicant to file additional copies of the representation.”

13. Rule 97(1) of the Rules further provides that:

“The owner of a series consisting of not more than 4 trade marks may file an application on the specified form to register them as a series in a single registration.”

14. A series of trade mark is defined in section 51(3) of the Ordinance as:

“a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

Decision

15. In the subject applications, a total of eight marks are applied for, in respect of the same specification of goods listed in paragraph 5 above. Although the subject marks are all different, the objections and issues involved in all of the subject applications are the same. Mr Evans' submissions at the hearing also addressed the objections to the subject applications as a whole. I have considered the subject applications separately and independently each on its own merits, but as the issues are the same, I give reasons for my determination on the subject applications in a single decision. I shall deal with the objections under rule 8 of the Rules first.

Rule 8 of the Rules

16. Rule 8(1) of the Rules requires that the representation included with an application for registration of a trade mark shall depict the trade mark clearly and in sufficient detail to permit a proper examination to be made of the trade mark and shall be of a kind and quality that is suitable for reproduction and registration.
17. In the subject applications, each of the subject marks consists of four separate devices of a motor vehicle. By letters of 4 August 2005, the Examiner examining the subject applications pointed out that the four devices in each of the subject marks do not qualify as a series of trade marks. The devices do not qualify for registration as a series of trade marks under rule 97(1) of the Rules. Nor is there indication that the four devices are intended to be used and to be considered as a totality to form a single composite mark. Additionally, it appears from the applicant's submissions during the examination stage that in each of the applications, the applicant is applying for registration of a two-dimensional mark as opposed to a three-dimensional mark showing different views of a motor vehicle. In light of the above, the Examiner raised an objection that the applicant is trying to register four different marks in a single application, and considered that the representations do not permit a proper examination to be made of the subject marks, and that they are not of a kind and quality that is suitable for registration falling foul of the requirement under rule 8(1) of the Rules.
18. In response to the objection above, Mr Evans submits at the hearing that the subject marks as shown in the representations, namely two-dimensional marks each consisting of four different views of the applicant's motor vehicle, are exactly what the applicant intends to register and use in respect of the applied-for goods. According to Mr Evans, the four views of the motor vehicle in each of the subject marks form a unified whole and the applicant has no intention to apply for registration of a

three-dimensional mark, or a series of trade marks. Mr Evans further elaborated that the subject applications are part of the applicant's "complete filing program" in Hong Kong and in other parts of the world whereby the applicant has made a conscious decision to file applications for registration of two-dimensional marks in classes 16 and 25, and three-dimensional marks in classes 12 and 28.

19. On the basis of Mr Evans' submission, I am satisfied that in the subject applications, the applicant is not attempting to apply for registration of four different marks in a single application. I accordingly waive the objection under rule 8 of the Rules against all of the subject applications, and proceed to examine the registrability of the subject marks on the basis that each of them is a two-dimensional composite mark consisting of four different views of a motor vehicle.

Section 11(1)(b) of the Ordinance

20. I now turn to consider the objection under section 11(1)(b) of the Ordinance, which precludes from registration signs which are devoid of any distinctive character.
21. At the hearing, Mr Evans submits that the fact that the subject marks show four views of a vehicle is not a reason for applying different standards of test for distinctiveness. I agree with Mr Evans' submission. Irrespective of which category of marks the subject marks belong to, the same test for distinctiveness should apply. No different standard of test for distinctiveness should be applied to the subject applications.
22. There is also Mr Evans' submission that for a mark to be free from an objection under section 11(1)(b), it only has to possess a "minimum" degree of distinctiveness. However, whether the required degree of distinctiveness is described as minimal or otherwise, the mark has to satisfy the test for distinctiveness as laid down in the relevant case authorities.
23. I refer to *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281, in which Mr Justice Jacob said, at page 306, that:

"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?"

24. At the hearing, Mr Evans also refers me to *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 and "*Cycling IS...*" *Trade Mark Applications* [2002] R.P.C. 37, in which the test for distinctiveness has been discussed.
25. In "*Cycling IS...*" *Trade Mark Applications* [2002] R.P.C. 37 at paragraph 69, Mr Geoffrey Hobbs Q.C. as the Appointed Person, stated the test of registrability under the U.K. equivalent of section 11(1)(b) resides in the question "whether the perceptions and recollections that the sign in issue would trigger in the mind of the average consumer of the specified goods and services are likely to be origin specific or origin neutral?"
26. In *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2, it was stated at paragraph 23, that:

"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."
27. At the hearing, Mr Evans has also referred me to various passages in *Kerly's Law of Trade Marks and Trade Names, fourteenth edition*, which set out the principles to be applied in assessing a mark's distinctiveness. However, I consider that those principles have essentially been covered by the above cases.
28. In the subject applications, since no evidence of use has been filed, I must assume that no use has been made of the subject marks. The distinctiveness of the subject marks is to be assessed on a *prima facie* basis, on the assumption that the marks are used normally and fairly in relation to the goods sought to be registered in the subject applications.
29. The applied-for specification includes a wide range of goods including manuals, brochures and catalogs pertaining to motor vehicles, and some general printed materials or reproductions including periodicals, books and catalogues, as well as various other products such as stationery, posters, gift-wrap and postcards, etc. These goods are general merchandise and their average, relevant consumers are essentially members of the general public.

30. Assuming normal and fair use of the subject marks in relation to the applied-for periodicals, books and catalogues, etc, the subject marks may be applied to the cover of these periodicals, books and catalogues. In such use, the subject marks, consisting of different views of a motor vehicle, are likely to be perceived by customers simply as line drawings of motor vehicles. In my view, the immediate message conveyed by the subject marks to customers will likely to be that the periodicals, books and catalogues are about or have some relation with motor vehicles. Customers will simply perceive the subject marks as line drawings appearing on the periodicals, books and catalogues, as an indication of the subject matter of the publications but are unlikely to perceive the subject marks as trade marks, i.e. badges of trade origin, which identify the periodicals, books and catalogues as originating from a single undertaking. In the words of Mr Geoffrey Hobbs Q.C. in "*Cycling IS...*" *Trade Mark Applications*, the perception and recollections that the subject marks would trigger in the mind of the consumers of the goods are likely to be origin neutral rather than origin specific. Without first educating the public that the subject marks are intended to be trade marks, I consider it unlikely that the customers will perceive the subject marks as badges of trade origin and rely on them to distinguish the applicant's goods from those of other traders.
31. As regards the goods such as stationery, posters, gift-wrap and postcards, etc, these goods often come with various decorative features appearing on the surface of the products. To my mind, when the subject marks are applied onto these goods, customers are likely to see the marks simply as a feature of the goods, as opposed to a badge of their trade origin which identifies the goods as originating from a particular undertaking. The message conveyed by the subject marks to customers is again origin neutral rather than specific.
32. At the hearing, Mr Evans submits that the subject marks do not consist of ordinary depictions of motor vehicles but instead, they show different views of specific models of motor vehicles designed and made by the applicant. It is Mr Evans' submission that the designs will not be used by other traders without improper motive, and that customers' impression will likely to be that the subject marks are composed of a set of pictures showing specific models of cars designed and made by the applicant. Mr Evans accordingly submits that customers are likely to recognise the subject marks as badges of trade origin and are able to distinguish the applicant's goods from those of other undertakings.
33. I have considered Mr Evan's submissions above. However, his claim that customers will recognise the subject marks as representations of the applicant's motor vehicles and will perceive them as indications of trade origin of the applied-for goods has not

been substantiated by evidence. I am unable to make the assumption that consumers will recognise the subject marks simply because the vehicles shown in the representations may differ in some respects from other vehicles of the type. As mentioned earlier, in the absence of evidence of use, I must assume that no use has been made of the subject marks, and I must assess their distinctiveness by assuming that they are to be used normally and fairly in relation to the specified goods. On this assessment, my finding, as explained, is that consumers would most likely see the subject marks as drawings or representations of motor vehicles indicating that the goods are about or to do with motor vehicles, or as features of the goods, rather than perceiving them as indications of their trade origin.

34. For the reasons above, I must conclude that the subject marks are devoid of any distinctive character, and are excluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

35. Mr Evans has made submissions under section 11(1)(c) which, as submitted, operates as a separate and independent objection to section 11(1)(b) of the Ordinance. In the subject applications, I find the main objection against the subject applications is under section 11(1)(b) and as I have found the subject applications objectionable under that section, I do not consider it necessary to consider whether an objection under section 11(1)(c) is also applicable to the subject applications.

Reference to other registered marks and overseas registrations

36. At the hearing, Mr Evans submits that the Registry has previously registered or accepted for registration other shapes of vehicles in class 16 including trade mark application no. 200202264 and registration nos. 200209893 and 20302665. Mr Evans further refers me to trade mark no. 300114795 “CARGO” and submits that despite the fact that the mark is descriptive of printed materials relating to the cargo business, it has been accepted for registration by the Registry for books, magazines, and printed materials in class 16. He submits that the previous acceptances are indicative of the Registry’s principle and practice in applying the law on sections 11(1)(b) and (c), and that if the above marks can be accepted for registration, there is no reason why the subject marks are not acceptable.
37. I have considered Mr Evan’s submissions above, but 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). Mr Evan's submission cannot accordingly assist the applicant.

38. Mr Evans has further provided me with a list of acceptances of the subject marks in other jurisdictions including Algeria, Chile and Taiwan, etc. He, however, concedes that since these overseas registrations are not from common law jurisdictions, he will not place too much reliance on them.
39. The reference to the overseas registrations above has also been noted. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration here (See *Automotive Network Exchange Trade Mark* [1998] R.P.C. 885 at 887). Since I have found valid reasons for refusing the subject application, I am not prepared to follow the decisions of other registries, especially when the reasons for those acceptances are not available before me.

Conclusion

40. In this decision I have carefully considered all documents filed and submissions made by the applicant, and I find the subject marks to be precluded from registration by section 11(1)(b) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Simon Chan
for Registrar of Trade Marks
23 February 2006