

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. 300217638
MARK: Device
CLASSES: 18 and 25
APPLICANT: GUCCIO GUCCI S.p.A.

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 May 2004, Guccio Gucci S.p.A of Firenze, Italy (“the applicant”), applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:



(“the subject mark”) in classes 18 and 25.

2. The specification of goods is as follows:

Class 18

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25

clothing, footwear, headgear.

3. During the examination stage, objections were raised under section 11(1)(b) of the Ordinance.

4. A hearing on the registrability of the subject mark took place before me on 25 April 2006. Ms Rebecca Lo of Messrs Rebecca Lo & Co. appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
5. The applicant did not file evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The Trade Marks Ordinance

6. Section 11(1)(b) of the Ordinance is as follows:
 - (1) Subject to subsection (2), the following shall not be registered –

...

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

...

Decision

7. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character.
8. Ms Lo refers me to *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] E.W.C.A. Civ 48 and submits that a mark is barred from registration only if it does not possess any trace of distinctive character.
9. What does “devoid of any distinctive character” mean? In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, Jacob J. said:

“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?”
10. The European Court of Justice (“ECJ”) stated in *Linde AG v Deutsches Patent-und Markenamt* [2003] R.P.C. 45, at paragraph 40, that for a mark to possess distinctive character within the meaning of Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 (equivalent to section

11(1)(b) of the Ordinance), it must serve 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 products of other undertakings. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. This means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect.

11. While section 11(1)(b) makes no distinction between different types of marks for the purpose of assessing their distinctiveness, it has been held by the ECJ that the perception of the public is not necessarily the same in respect of different types of marks, and it may prove more difficult to establish distinctiveness for some categories of marks than for others. For instance, public perception of a word or figurative mark may be different from that of a mark consisting solely of a colour (*Libertel Groep BV v Benelux-Merkenbureau* [2003] E.T.M.R. 63), an advertising slogan (*OHIM v Erpo Mobelwerk* [2005] E.T.M.R. 58), or a surface decoration (*Glaverbel v OHIM* [2005] E.T.M.R. 70), and it is legitimate to take that perception into account in assessing a mark's distinctive character.
12. In *Glaverbel v OHIM*, the ECJ found that the perception amongst the target market is not necessarily the same in the case of a sign composed of a design applied to the surface of goods as it is in the case of a word or figurative mark comprising a sign that bears no relation to the appearance of the goods it identifies. The ECJ further held that whilst the public is accustomed to perceiving word or figurative marks instantly as identifying the trade origin of the goods, the same is not necessarily true where the sign forms part of the appearance of the goods for which it is claimed.
13. The subject mark consists of three vertical stripes in green, beige and green. The applicant claims the colours beige (Patone 468C) and green (Patone 357C) as elements of the subject mark. The subject mark is sought to be registered in respect of leather goods, clothing and footwear, etc in classes 18 and 25. These goods are general merchandise and the average, relevant consumers are essentially members of the general public.
14. The applied-for goods often come with different patterns or stripes applied on their surface for decorative purposes. The subject mark, being a combination of three vertical colour stripes, is apt to be applied on the surface of the

applied-for goods. To my mind, when used in relation to the goods, customers are likely to perceive the subject mark as coloured stripes or a pattern applied to the goods. Although colour combinations are not necessarily indistinctive, having considered the way in which the subject mark is presented and how it would be applied on the goods, I am of the view that unless and until customers have been educated that the mark is and intended to be the applicant's trade mark, they are unlikely to perceive the mark as a badge of trade origin which identifies the goods as originating from a particular undertaking.

15. Ms Lo submits that the Registrar has failed to consider all fair usage of the subject mark. In particular, she submits that the subject mark is distinctive when it is affixed on a tag, or applied on the goods in the form of a rectangular logo or device. She relies on *Cycling IS... Trade Mark Application* [2002] R.P.C. 37 and submits that when the subject mark is used in such a manner, it will prompt customers to believe that goods bearing the mark come from a single undertaking. She therefore considers that the subject mark is not devoid of any distinctive character.
16. I have considered Ms Lo's submissions. However, there is no border to the subject mark that defines it as a rectangular device or logo. Nor is there a description of the mark in the application which confines the subject mark to such a form. Applying the subject mark onto the surface of the applied-for goods is a use that is apt to be made of it at least in relation to goods of the type applied for and in such use, I am of the view that customers will merely perceive the mark as decorative colour stripes or a pattern applied to the goods, as opposed to a badge of trade origin.
17. Ms Lo further submits that combinations of colours, in particular colour stripes, have long been used as signs to distinguish different parties or undertakings, examples of which are national flags and the uniforms of football clubs comprising of horizontal and vertical stripes in several colours. Ms Lo concludes that the subject mark is registrable, on a *prima facie* basis, because customers have been educated to perceive combinations of colours as indications of trade source and will similarly perceive the subject mark as a badge of trade origin.
18. I cannot agree with Ms Lo's conclusion. The use of colour combinations in national flags has little bearing on the use of colours as trade marks. Furthermore, the public may, by reason of the use of particular combinations of colours by particular traders, perceive the combinations as distinctive, but it

does not follow that customers will perceive the subject mark as a badge of trade origin. No evidence has been put before me to show that customers have been educated to perceive the subject mark as a badge of trade origin. In the absence of evidence showing that customers have been educated to perceive the subject mark as the applicant's trade mark, I consider that customers will merely perceive the subject mark as coloured stripes or a pattern rather than a badge of trade origin.

19. There is Ms Lo's submission that the subject mark is distinguishable from the mark that is found objectionable by the ECJ in *Libertel Groep BV v Benelux-Merkenbureau* [2003] E.T.M.R. 63. Ms Lo also refers me to the ECJ judgment *Heidelberger Bauchemie GmbH's Trade Mark Application* [2004] E.T.M.R. 99 and submits that registration of the subject mark will not unduly restrict the availability of colours for other traders who market goods of the same type as those in respect of which registration is sought.
20. I note Ms Lo's submissions, but the critical question remains whether the subject mark will be perceived by customers as an indication of trade origin which identifies the applied-for goods as originating from a particular undertaking. As explained, I consider that customers will merely perceive the subject mark as decorative colour stripes or a pattern applied to the goods, rather than an indication of trade origin. The mark is not therefore distinctive for registration on a *prima facie* basis. I borrow support from *Heidelberger Bauchemie GmbH's Trade Mark Application* [2004] E.T.M.R. 99 in which it is stated, at paragraphs 38 to 39, that:

“It follows from paragraphs 40, 41 and 65 to 67 of *Libertel* that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message.

Save in exceptional cases, colours do not initially have a distinctive character, but may be capable of acquiring such character as a result of the use made of them in relation to the goods and services claimed.”

21. In the subject application, there is no evidence showing that customers have been educated to perceive the subject mark as the applicant's trade mark. For the reasons given, I do not consider that customers will perceive the subject mark as an indication of trade origin.

22. Ms Lo draws my attention to the fact that the subject mark has been registered in OHIM and U.K. on a prima facie basis. I note the OHIM and U.K. registrations, but 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 (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885 at 887). I must examine the registrability of the subject mark against the registration requirements laid down in the Ordinance and against the principles established in case law, and not simply rely on the bare fact of acceptances in other jurisdictions. Since there are valid reasons for refusing the subject application, I should not simply follow the acceptances of other overseas registries.
23. Ms Lo has also referred me to a few marks on the trade marks register which consist of colour stripes in geometric shapes and are registered in respect of goods including class 18 or 25 products. Ms Lo argues that the subject mark should similarly be accepted for registration. I note the registrations referred to by Ms Lo, but it is well established that 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). I cannot accept a mark simply because the Registry has accepted a few marks that appear to be equally indistinctive.
24. For the above reasons, I find that the subject mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance.
25. Ms Lo submits that if the Registrar raises an objection to registration of a mark, the onus is on him to justify the objection. She relies on the *Celltech R&D Ltd v OHIM* (Case T-260/03), a judgment of the Court of First Instance of the European Communities in this respect. I note Ms Lo's submissions, but the position in relation to the applications under the Ordinance is neutral and there is no presumption in favour of or against registration. There is nothing in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse an application (*EUROLAMB Trade Mark* [1997] R.P.C. 279). In this application, I have given the reasons for maintaining the objection against the subject application under section 11(1)(b), and after having carefully considered the applicant's submissions, I remain unconvinced that the mark meets the requirements of the Ordinance.

Conclusion

26. In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application. For the reasons given I refuse the application under section 42(4)(b) as the mark is excluded from registration by section 11(1)(b) of the Ordinance.

Simon Chan
for Registrar of Trade Marks
14 September 2006