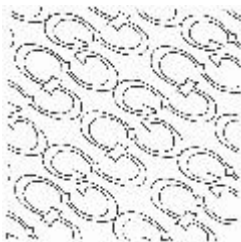


TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. **300254844**



MARK:

CLASSES:

APPLICANT:

18 and 25

GUCCIO GUCCI S.p.A.

STATEMENT OF REASONS FOR DECISION

Background

1. On 23 July 2004, Guccio Gucci S.p.A of Firenze, Italy, applied to register the above mark in Classes 18 and 25 under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).
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. The applicant called for a hearing which took place on 27 October 2005. Ms Rebecca Lo of 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 any 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. The subject mark consists of a device, and the only relevant objection under the Ordinance is section 11(1)(b).
8. Section 11(1)(b) precludes from registration signs which, even though not caught by sections 11(1)(c) and (d) are nevertheless incapable of distinguishing the goods and services of one undertaking from those of other undertakings.
9. What does “devoid of any distinctive character” mean? In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, Jacob J. explains the enquiry that this ground of prohibition entails:

“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* (Joined Cases C-53/01 to C-55/01) (at paragraph 40) that “for a mark to possess distinctive character within the meaning of [section 11(1)(b)], 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. According to the Court’s case-law, that 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 mark 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* (Case C-104/01), an advertising slogan (“*The Principle of Comfort*” [2005] ETMR 58), or a surface decoration (*Glaverbel v OHIM* [2005] ETMR 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. It 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. In assessing the distinctive character of the subject mark, I should consider it from the perspective of average, relevant consumers of the applied for goods who are reasonably informed and observant. The applied for goods are general merchandise and the average, relevant consumers are essentially members of the general public.
14. In this application the subject mark is, on first impression, a representation of a pattern of curved, thickened lines placed at an angle. The idea of a pattern is readily apparent, as each line has the same bends repeated, and there are at least 3 rows of such lines placed next to each other. Further, the mark appears to be a part taken out of a larger pattern. Upon closer inspection of the mark, it is also possible to see the mark as a pattern of inverted “S”s closely placed together, or as a pattern of “G”s linked with “inverted G”s. However, such interpretation is not readily apparent and requires close analysis of the mark. As consumers generally do not examine a mark in such details, they are likely to simply perceive the mark as a pattern of lines rather than inverted “S”s or “G”s.
15. The applied for goods, such as leather goods, bags, clothing and footwear, often have different kinds of patterns applied on their surface for decorative purposes. The subject mark, being a pattern of lines, is likely to be applied on the surface of the applied for goods. The average, relevant consumers of the applied for goods would be used to seeing such goods decorated with different kinds of patterns and designs to make the goods attractive to potential customers. They are, however, generally not accustomed to perceiving a pattern on the surface of the goods as an indication of trade origin. They are likely to perceive the subject mark, when applied onto the surface of the goods, merely as a decorative feature of the goods rather than a badge of trade origin, unless they have first been educated that the mark is and intended to be an indication of trade origin. Accordingly the mark is incapable of distinguishing the goods of the applicant from similar goods of other traders.

16. At the hearing the applicant submitted that the Registrar should not confine the possible use of the mark to just one form, i.e. use as a pattern on goods, without regard to other possible manners of use of the mark. I have considered other possible means of using the subject mark. However, it remains the fact that the subject mark is a representation of a pattern, and in respect of the applied for goods, it is most likely to be used by being applied as a pattern onto the surface of the goods.
17. The applicant further submitted that “consumers are aware that the pattern of goods may be a possible indicator of trade origin”. It is not clear to me the basis of the applicant’s claim. No survey evidence was filed by the applicant to support its argument that an average consumer for the applied for goods, in particular luxury brands comparable to the applicant, would take the patterns of the goods as one of the indications of trade source. There is also no evidence to support the claim that the practice in the trade has been “evolved to use patterns on the goods to distinguish one’s products from its rivalry”. At the hearing Ms Lo provided some printouts from the Internet of certain bags and shoes. However, there is nothing in the printouts to suggest that consumers would in fact take the design or pattern on the goods as indication of trade origin. In the absence of proper supporting evidence I am unable to accept the applicant’s argument in this regard.
18. The applicant also submitted that the Registrar was wrong to conclude that a pattern cannot or does not serve as an indicator of origin. It is clear that there is no provision under the Ordinance, nor is there any general principle that excludes patterns as registrable trade marks. However, the question is whether the pattern under consideration possesses the necessary distinctive character for it to be registered. A finding that the subject mark lacks distinctive character does not mean that the Registrar regards all patterns as unregistrable under the Ordinance.
19. It was also submitted that the subject mark comprises a number of “G”s written in an artistic manner, arranged in the “G” and “reverse G” format interlocking and sloping down from right to left. While it is possible to see the mark as interlocking “G”s and “reverse G”s, this is hardly obvious on first impression and can only be observed upon close examination of the subject mark. An average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. It is therefore unlikely for an average consumer to perceive the mark as interlocking “G”s and “reverse G”s as suggested by the applicant.
20. At the hearing Ms Lo drew my attention to the fact that the same mark had been registered by OHIM on a *prima facie* basis. While I appreciate that the provisions governing distinctiveness in the Ordinance and the relevant EC Regulation are couched in similar terms, I do not know what materials were put before OHIM for consideration, and I am not aware of OHIM’s reasons for accepting the subject mark. As there are valid reasons for raising objections

under section 11(1)(b) of the Ordinance, I am not prepared to accept the mark simply on the basis of OHIM's acceptance.

21. At the hearing some marks (which were claimed to be similar to the subject mark) on the Trade Marks Register were cited in support of the applicant's case. It has been held 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*). I am not prepared to waive the objections on the basis of the other registered marks.
22. 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.

Conclusion

23. 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.

Andy Lau
for Registrar of Trade Marks
20 January 2006