

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300289927

MARK : ◁ ◻

APPLICANT : SONY KABUSHIKI KAISHA (SONY CORPORATION)

CLASS : 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 22nd September 2004, Sony Kabushiki Kaisha (Sony Corporation) (“the Applicant”) of Tokyo, Japan applied to register the mark shown below, application no. 300289927, under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”). On the same day, the Applicant applied to register two other marks similar to the subject mark. I deal with the applications nos. 300289918 and 300289945 in separate decisions of the same date.



2. Registration of the subject mark is sought in respect of the following goods in Class 9:-

“Digital still cameras; video cameras; parts and fittings for the aforesaid goods, namely, rechargeable battery packs, battery chargers, AC adapters, shoulder straps, AV cables, battery cases and remote controllers.”

3. Objection was raised under section 11(1)(b) of the Ordinance. The Applicant requested a registrability hearing which was postponed twice at the Applicant’s request and eventually scheduled to take place on 12th July 2006. Despite having filed a notice of intention to attend, neither the Applicant nor its agent, Messrs. Wilkinson & Grist, appeared at the hearing.
4. On 11th July 2006, Messrs. Wilkinson & Grist had filed on behalf of the Applicant evidence of use of the mark by way of a statutory declaration of Takashi Kotoyori.

The Ordinance

5. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provisions under section 11(1) read 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) ...”

6. Notwithstanding the prohibitions against registration set out in section 11(1)(b), (c) and (d), section 11(2) provides that:-

“(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.”

Decision

Inherent registrability

7. I will, first of all, consider the inherent registrability of the mark under section 11(1)(b) of the Ordinance. The mark consists of a triangle on the far left and a round-corner square on the far right, as shown in paragraph 1 above.
8. To consider whether a mark is devoid of distinctive character, Mr. Justice Jacob stated in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 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?”

9. In *Nestle SA's Trade Mark Application* (“*Have a Break*”) [2004] F.S.R. 2 at 26, Sir Andrew Morritt remarked on the approach in assessing distinctiveness:-

“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.”

10. In view of the above legal principles, distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it for the purpose of section 11(2), must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. The distinctiveness of the mark must be assessed by reference to the goods for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.
11. It has been submitted by the Applicant’s agent that the mark comprises an arbitrary combination of geometric shapes and the combination of the shapes in the mark has distinctive character.
12. Under section 11(1)(b) of the Ordinance, as explained in paragraph 10 above, distinctiveness of a mark is assessed by reference to the goods for which registration is sought. In the present application, the goods in respect of which registration is sought (“the applied for goods”) are digital cameras, video cameras and parts and fittings including batteries *et cetera*. The average, relevant consumers of the goods are essentially members of the general public who use digital and video cameras. An average consumer of the applied for goods, who is reasonably informed and observant would perceive the mark, upon first impressions as a representation of buttons or indicators of the sort that usually appear on goods of the type applied for. The mark is apt to be used by other traders in respect of their goods that are of a type similar to the applied for goods.
13. The Applicant’s agent has argued that no other traders use the mark in respect of their goods and therefore the mark can serve to distinguish the Applicant’s goods. I do not consider that this argument is of any assistance to the Applicant in the present application. Even if other traders do not use buttons

or indicators in the precise form of the mark applied for, this does not mean that the mark is distinctive in the sense that the relevant consumers would perceive it as an identifier that goods bearing the mark originate from a particular undertaking.

14. Having considered the relevant facts and circumstances, I am not satisfied that upon seeing the mark in respect of digital still cameras, video cameras and parts and fittings for digital still cameras and video cameras, consumers would see it as a badge of origin, indicating that the applied for goods originate from a particular undertaking.
15. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117 at 133, the European Court of Justice stated what is considered to be the “essential function” of a trade mark:-

“...the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.”

16. Since the mark would be perceived by the relevant consumers as simply buttons or indicators of the sort that are found on goods of the type applied for, I consider that the mark fails to perform the essential function of a trade mark by enabling the relevant consumers, without possibility of confusion, to distinguish goods of a particular undertaking from those of others.
17. With reference to some registered marks in different geometric shapes or combinations of such shapes on the register, the Applicant’s agent has submitted that even simple geometric shapes are registrable and similarly the mark should be registrable. However, the registered marks to which the Applicant refers, are not comparable to the subject mark. For example, Trade Mark Registration No. 2000B12136 is a sign which is a combination of various shapes registered in respect of recordable compact discs, recordable and rewritable compact discs. Unlike the mark of the subject application, the registered mark does not resemble any feature of the goods in question. As a whole, the registered mark has a distinctive character. In any event, I do not think that it is appropriate to make direct comparisons to marks on the register. Each case must be considered on its own merits. This issue has been

discussed in *British Sugar Plc* (supra):-

“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, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

18. For the reasons stated above, I find that the mark is devoid of distinctive character and is precluded under section 11(1)(b) of the Ordinance.

Acquired distinctiveness

19. A statutory declaration of Takashi Kotoyori (“the Statutory Declaration”) was filed to establish that the mark has acquired distinctiveness for the purpose of section 11(2) of the Ordinance.
20. Distinctive character may be acquired through use of a mark, if as a result of the actual use of the mark on the goods, the mark has come to identify the goods in question as originating from a particular undertaking and thus to distinguish the relevant goods from those of others. To determine whether a mark has acquired distinctive character as a result of the use which has been made use of it, I must make an overall assessment of the evidence filed. If I consider that a significant proportion of the relevant class of consumers identifies the applied for goods as originating from a particular undertaking because of the use of the mark, the mark would overcome the objection raised under section 11(1)(b) of the Ordinance.
21. In the Statutory Declaration, it is asserted that the Applicant has been using the mark continuously since 1996 in Hong Kong by affixing it on the applied for goods and their packaging. Promotions or advertisement of the applied for goods bearing the mark are carried out through different channels such as the press, television broadcasting, circulars, exhibitions and posters. Two exhibits, A and B, are exhibited to the Statutory Declaration in support of the contentions made in the Statutory Declaration.

Exhibit A

22. Exhibit A consists of copies of catalogues which purportedly show the

batteries bearing the mark. One or two copies may show the mark or something similar to the mark on flat batteries, although the depictions are very small and it is hard to see the mark with any degree of clarity or to determine whether the mark as applied to the batteries in the catalogues is precisely the form of the mark applied for in the subject application. However, even if I accept that the copy catalogues show the mark on batteries, for reasons I have given, I do not think that the relevant consumers would perceive the mark as an indicator of trade origin.

23. Furthermore, Sony Corporation of Hong Kong Ltd. and not the Applicant is identified in the copies of the catalogues. The relationship between Sony Corporation Hong Kong Ltd. and the Applicant has not been explained in the Statutory Declaration. Even if there were use of the mark by Sony Corporation of Hong Kong Ltd. by means of the catalogues, it would not necessarily constitute use by the Applicant.

Exhibit B

24. According to the Statutory Declaration, Exhibit B consists of samples of sales invoices or shipping papers verifying sales of the applied for goods in Hong Kong and/or exports of the applied for goods from Hong Kong showing the mark. However, the invoices and shipping papers are in respect of rechargeable battery packs only. Even if they, read together with the catalogues at Exhibit A, support use of the mark for batteries, I do not think that consumers would perceive the mark as an indicator of trade origin.
25. I also note that none of the invoices and shipping papers was issued by the Applicant but Sony Marketing Asia Pacific Pte Ltd. of Singapore. The relationship between Sony Marketing Asia Pacific Pte Ltd. of Singapore and the Applicant has not been explained. As in relation to the catalogues, even if there were use of the mark by Sony Marketing Asia Pacific Pte Ltd., such use would not necessarily constitute use of the mark by the Applicant.
26. Additionally, some of the invoices and shipping papers filed were issued after the application date of 22nd September 2004, which is not relevant for the purpose of section 11(2) of the Ordinance.

27. Having carefully considered the evidence filed, I am not satisfied that the mark has in fact acquired distinctive character through use in respect of the applied for goods in Hong Kong prior to the date of the application.

Conclusion

28. I have considered all the submissions and evidence filed by the Applicant and its agent in relation to this application. For the reasons stated above, I find that the mark is precluded from registration under section 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Margaret K.W. YU
for Registrar of Trade Marks
14th August 2006