

**TRADE MARKS ORDINANCE (Cap. 559)**


**APPLICATION NO.: 300295489**

**MARK:**   
**CLASS:** 36  
**APPLICANT:** The Professionals Group Council Ltd

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 4 October 2004, The Professionals Group Council Ltd (“the Applicant”) applied to register the mark  (“the subject mark”) in Class 36.
2. The services for which registration is sought under Class 36 are as follows:

“services in this class provided by real estate brokers and real estate agencies inclusive of real estate management and appraisal, real estate leasing and rental services, financial evaluation and services in this class provided by accommodation bureaus and housing agents; real estate services in this class associated with the acquisition and disposal of commercial, industrial and domestic properties and businesses; professional real estate consultation services.”
3. At the examination stage, objection was taken under section 11(1)(b) of the Trade Marks Ordinance (Cap.559) because the subject mark consisting of a non-distinctive device of a star and a laudatory word “Professionals” is devoid of any distinctive character in relation to the applied-for services.
4. The Applicant requested a hearing which took place on 10 February 2006. Mr. Andrew Chan of Messrs. So Keung Yip & Sin appeared on behalf of the Applicant. I

reserved my decision at the end of the hearing.

5. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

## **Decision**

6. The Registrar objects to the registration of the subject mark pursuant to section 11(1)(b) of the Trade Marks Ordinance (Cap.559) which reads as

“Subject to subsection (2), the following shall not be registered-

(a) ...

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

(c) ...”

7. The test for distinctiveness was laid down by Mr. Justice Jacob in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 at page 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?”

8. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] FSR 2:

“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.”

9. In summary, distinctive character means, for all trade marks, that the mark must be capable of identifying the goods or services as originating from a particular undertaking, and therefore distinguishing it from those of other undertakings. The distinctiveness of the mark has to be assessed in relation to the goods or services for which the applicant seeks registration, taking into account the presumed perception of the relevant consumers.
10. In order to assess the impact of a mark on the relevant consumers, it is proper to consider the various integers separately and then to consider whether as a whole the possible descriptive or other objectionable indication of the individual components is subsumed into the totality (*BONUS GOLD Trade Mark* [1998] RPC 859).
11. The subject mark consists of an underlined word “Professionals” with a star device above in the middle. Cambridge Advanced Learner’s Dictionary (Second Edition) defines “professional” (noun) as

“a person who has the type of job that needs a high level of education and training; someone who has worked hard in the same type of job for a long time and has become skilled at dealing with any problem that might happen”

I find that “Professionals” is an ordinary English word, of which the above dictionary meaning is direct and obvious and is well understood by the public. I also consider that the public are accustomed to seeing an ordinary sign of a star being commonly used as a symbol or ornament to denote merit and excellence.

12. Mr. Chan argued that the graphical design of the star device is stylized and is sufficiently distinctive to render the subject mark registrable. I accept that distinctiveness may be established in circumstances other than where the mark or its elements are novel or particularly striking. However, the representation of the star device here is not such as to induce consumers to believe that it is being used to indicate trade origin. Rather, it appears to me that the device simply serves to reinforce the idea that the Applicant’s services are of a high professional standard. In other words it complements and strengthens the meaning of the word element of the

mark.

13. In the context of the applied-for services, the subject mark conveys a message to consumers that the services to be provided are quality services delivered by professionals. As the mark is apt at describing the real estate services provided by other undertakings, it would not enable the relevant consumers to rely on it to distinguish the Applicant's services from those of other undertakings unless the consumers have been educated of its trade mark function.
14. Furthermore, it is unlikely that an average consumer who is reasonably well-informed, reasonably observant and circumspect would, on seeing it in the field of real estate agency, regard it as identifying that the relevant services originate from a particular undertaking. Upon seeing the mark, he would rather perceive it as a laudatory description of the relevant services. In other words, the perceptions and recollections that the subject mark would trigger in his mind are likely to be origin neutral.
15. I agree with Mr. Chan that a mark must be examined as a whole before deciding whether it is devoid of any distinctive character. Since an average consumer normally perceives a mark as a whole and does not proceed to analyze it in detail, it is the overall impression given by the mark which must be taken into account. I must consider whether the combination of the components of the mark and the way of presentation would give the mark distinctive character in respect of the specified services.
16. Mr. Chan submitted that the subject mark is registrable because the combination of its elements is unique and distinctive. That I cannot agree to. Having considered the subject mark in its totality in respect of the applied-for services, I find that the mere conjoining of the components and the way of presentation do not create a fanciful or striking combination; nor can they outweigh the laudatory connotation of the word "Professionals" and the star device. In other words, when viewed as a whole, the mark is no more than the mere sum of its individual laudatory components.

17. Mr. Chan argued that consumers would see the word “Professionals” as a reference to those persons with extensive education and specialized training. Since the representation of the star, which on its own will not be taken as denoting the quality of training or education, has no association with the word “Professionals”, the combination of the word “Professionals” and the star device is unique and forms a distinctive trade mark. I am, however, not persuaded by this argument. A combination of unconnected descriptive features does not necessarily create an overall impression that causes the mark to be regarded as distinctive. Furthermore, in the present application, the star device, being a sign for merits and quality, merely reinforces the message conveyed by the word “Professionals”, namely, that the expert services are of high quality. All the components of the subject mark, whether taken individually or collectively, are unlikely to cause an average consumer to perceive that the subject mark in its entirety has any trade mark significance.
18. Applying the legal principles set out in paragraphs 7 and 8 and for the reasons stated above, I cannot be satisfied that the subject mark as a whole can perform the essential function of identifying the trade origin before the public is educated that it is so used for that purpose. As the subject mark is devoid of any distinctive character, the subject application shall be refused pursuant to section 11(1)(b) of the Ordinance.
19. I take note of Mr. Chan’s submission and the printouts in relation to some registered marks which consist of either a star device or a word element “star”. I do not find that the prior acceptance of other registered marks can take the present application any further as it has been well established that each case has to be considered on its own facts and merits and not by reference to other marks that were judged registrable on other occasions. 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 and Sons Ltd* [1996] RPC 281 at page 305). I therefore disregard the evidence concerning the state of the register.
20. I also note that the subject mark has been accepted for registration in Australia and

New Zealand. 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 in Hong Kong (*Automotive Network Exchange Trade Mark* [1998] RPC 885). Where there are valid grounds for refusing the application, I am not prepared to follow the decisions of other registries when reasons for those foreign acceptances are not available.

### **Conclusion**

21. In this decision, I have considered all the documents filed by the Applicant, Mr. Chan's written and oral submission and the relevant authorities. For the reasons given above, I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance and the present application is thereupon refused under section 42(4)(b) of the Ordinance.

Patrick Yeung  
for the Registrar of Trade Marks  
15 March 2006