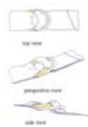


## TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300354483



MARK :

APPLICANT : CARTIER INTERNATIONAL B.V.

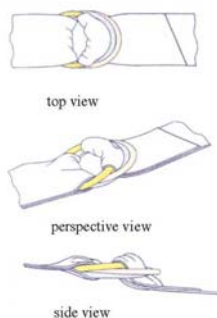
CLASSES : 14, 18

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### STATEMENT OF REASONS FOR DECISION

#### Background

1. On 14<sup>th</sup> January 2005, Cartier International B.V. (“the Applicant”) of Amsterdam, Netherlands applied to register the three-dimensional mark shown below, application no. 300354483 under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”). The Applicant claims priority from a European Community Trade Mark application no. 003958451 dated 28<sup>th</sup> July 2004.



2. Registration of the subject mark is sought in respect of the following goods in Classes 14 and 18 (“the goods applied for”):-

#### Class 14

Jewellery articles, rings, earrings, brooches, precious metal clasps, bracelets, watch straps and bracelets, necklaces.

#### Class 18

Leather and imitation leather, leather goods, key holders (leather), handbags, travel bags, backpacks, bags on wheels, briefcases (leather), travel sets

(leather), toilet and makeup bags (without fittings), suitcases, trunks, clutch bags, purses (not in precious metals), card cases, wallets, document holders, pouches, leather straps; umbrellas, parasols and walking sticks; whips and saddlery.

3. Objections were raised under sections 11(1)(b), 11(1)(c) and 11(3)(b) of the Ordinance. The Applicant called for a hearing on the registrability of the mark, which was then postponed at the Applicant's request and was eventually scheduled to take place on 18<sup>th</sup> 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 18<sup>th</sup> July 2006, Messrs. Wilkinson & Grist filed written submissions on behalf of the Applicant by way of a letter dated 17<sup>th</sup> July 2006. Although copies of photographs of handbags and purses were attached to the written submissions, they were not filed by way of statutory declaration or affidavit as required by rule 79 of the Trade Marks Rules (Cap. 559 sub. leg. A). No evidence of use has been filed in this application for the purpose of section 11(2) of the Ordinance. I therefore have only the *prima facie* case to consider and I shall decide the matter based on the written submissions filed in the application.

### **The Ordinance**

5. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 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) 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) ...”

“(3) A sign shall not be registered as a trade mark in relation to goods if it

consists exclusively of –

- (a) ...
- (b) the shape of goods that is necessary to obtain a technical result;
- (c) ...”

## **Decision**

### Section 11(1)(b) of the Ordinance

6. I will, first of all, consider the inherent registrability of the mark under section 11(1)(b) of the Ordinance. 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?”

7. 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.”

8. 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.

9. The criteria for assessing distinctive character of three-dimensional trade marks, such as the subject mark, are no different from those to be applied to other categories of trade mark (*Koninklijke Philips Electronics NV v Remington Consumers Products Ltd.*, European Court of Justice [2003] Ch. 159 at 174, paragraph 48). However, as the European Court of Justice has observed in *Henkel KGAA v Deutsches Patent –und Markenamt* [2005] ETMR 45, paragraph 52:

“The perception of the relevant public is not necessarily the same in the case of a three-dimensional mark, consisting of the packaging of a product, as it is in the case of a word or figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three-dimensional mark than in the case of a word or figurative mark.”

10. Although the comments of the European Court of Justice above were in respect of a mark which consisted of the packaging of a product, I find the comments equally applicable in the case of a mark which represents the shape or part of the shape of the goods applied for, as in the subject application.
11. The subject mark is the three-dimensional shape of a buckle or clasp consisting of three rings through which straps are passed. The three rings are coloured yellow gold, white gold and rose gold respectively. The Applicant’s agent argues that the mark is unique, unusual and distinctive as it is a combination of distinctive elements, namely, three clasps of different colours with two of the three clasps soldered to each other and the leather straps interweaving into the third clasp.
12. The goods applied for are general consumer goods such as jewellery, accessories, leather and imitation leather goods, bags, umbrellas, and saddlery *et cetera*. The average, relevant consumers of the goods are essentially members of the general public in Hong Kong. An average consumer of the goods applied for, who is reasonably informed and observant would perceive the mark upon first impression as a buckle or clasp of a sort that usually appears on goods of the type applied for, to fasten or adjust straps. Buckles

or clasps often come in metallic colours, including gold, silver or bronze. Without first educating the relevant consumers, the colours of the buckles or clasps or the combinations of colours do not serve to distinguish a particular undertaking from others. In the subject application, the use of yellow gold, white gold and rose gold on the three rings which form the clasp does not contribute any distinctive character to the mark as a whole. The mark is devoid of distinctive character as a whole. I am not satisfied that upon seeing the mark in respect of the goods applied for, the relevant consumers would see it as a badge of origin which identifies a particular undertaking from which the goods originate.

13. The Applicant's agent has argued that the mark is not commonly found in the trades of jewellery and leather 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 buckles or clasps in the precise form of the mark applied for, or in a very similar form, or in the colours 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. In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. & Another* [2003] Ch. 159 at 173, paragraph 30, 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..."

15. To my mind, the mark is essentially a clasp which allows straps to be adjusted or fastened. It would be perceived by the relevant consumers as a clasp consisting of three rings: the sort of clasp that can be found on goods of the type applied for. 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.

16. The Applicant's agent says that the mark is named by the Applicant as the "Trinity buckle" and the Applicant has a long history of using three intertwined rings as a trade mark for a variety of its products. However, no evidence has been filed to show that the Applicant has used or promoted the mark in Hong Kong in respect of the applied for goods, nor is there evidence to show that the relevant consumers would perceive the "Trinity buckle" as a trade mark. In any event, the name given to the mark by the Applicant or the Applicant's intention in adopting the mark does not affect the relevant consumers' perception of the mark as the shape of a buckle or clasp which enables straps to be adjusted and fastened, not as a badge of origin.
17. The Applicant's agent also states that because the Applicant's goods are in the luxury or high-end of the market, consumers would be discerning and brand conscious and are sufficiently sophisticated that they would appreciate the mark as an indication of origin. No evidence has been filed to show that the mark is only used in respect of the applied for goods in the high-end of the market and the relevant consumers of the applied for goods would perceive the mark as an indication of origin. Despite the agent's submission that the Applicant's goods are in the high-end market only, the goods applied for are of a general nature and are not limited to those in the high-end market only. In the circumstances, I do not consider that these contentions carry any force in the subject application.
18. For the reasons stated above, I find that the mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

19. In general, the ambit of section 11(1)(b) is wider than that of section 11(1)(c). As I have found that the mark is devoid of distinctive character under section 11(1)(b) of the Ordinance, the specific terms of section 11(1)(c) add nothing of relevance in the present application and there is no need for me to consider separately the absolute ground for refusal under section 11(1)(c) of the Ordinance.

### Section 11(3)(b) of the Ordinance

20. Section 11(3)(b) of the Ordinance operates as a ground of objection separate and independent from that under section 11(1)(b). Although I have found that the mark is precluded from registration under section 11(1)(b) and it is unnecessary for me to consider the ground for refusal under section 11(3), for the sake of completeness, I shall consider the registrability of the mark for the purpose of section 11(3)(b) of the Ordinance.
21. The purpose of section 11(3)(b) of the Ordinance is to exclude from registration shapes which are merely functional in the sense that they are the result of technical considerations, which should not be monopolized for an unlimited period by reason of trade mark registration.
22. Section 11(3)(b) of the Ordinance is broadly similar to section 3(2)(b) of the UK Trade Marks Act 1994. In considering the scope and meaning of section 3(2)(b) of the Trade Marks Act 1994, the Court of Appeal adopted a two-stage approach in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. & Another* [2006] EWCA Civ 16, at paragraph 38:

“The first step is to identify the ‘essential characteristics or features’ of the shape of the goods in issue. Once they have been determined, the next step is to determine whether the essential characteristics or features consisting ‘solely’ of the shape of goods are attributable only to the technical result.”
23. At paragraph 62, the Court of Appeal stated that one should not dissect the mark and analyze each part of the mark in order to determine to what extent the role of that part is wholly or partially functional. Functionality must be assessed against the mark as a whole, taking into account the essential characteristics or features of the mark. The use of the word “essential” and the principle that a mark must be assessed as a whole clearly indicate that an objection under section 11(3)(b) would not be overcome by incorporating some trivial embellishments that have no technical function.
24. In the subject application, the mark is described by the Applicant as follows:

“The trade mark consists in the three-dimensional representation of three metallic rings of different colours (yellow gold, white gold, rose gold),

through which leather or imitation leather straps are passed. The rings in white gold and rose gold are welded together and entwined; the third ring of yellow gold colour is independent from the others.”

25. The essential characteristics or features of the mark are the three rings that make up the clasp, which is the shape of part of the goods. When used in respect of the goods applied for, the clasp serves the technical function of allowing a strap or straps to be adjusted or fastened. From the representation of the mark from three perspectives: top view, perspective view and side view, it is unclear whether two of the rings are welded together or intertwined but it is clear that the three rings allow the straps that pass through them to be adjusted or fastened. I am of the view that the shape of the mark as a whole is necessary to obtain the technical function of fastening or holding together the straps on the goods applied for.
26. Further to my finding that the essential feature of the mark is the shape of the three-ring clasp, I consider that the colours of yellow gold, white gold and rose gold are trivial embellishments or variants. As explained above, buckles or clasps often come in metallic colours, including gold, silver or bronze; there is nothing special about the colours in the mark. The colours are not the essential features of the mark and they do not contribute to the overall assessment of the mark for the purpose of section 11(3)(b) of the Ordinance.
27. I am not persuaded by the arguments that the “special design” of the clasp has appeal to the eye, is intended to be a sign to identify the Applicant’s goods and is not intended to allow adjustment of straps. Although it has been argued that the clasp is not intended to allow adjustment of straps, as illustrated in the copies of photographs of handbags submitted by the Applicant, the clasp is capable of serving and in fact serves the function of adjusting or fastening straps of the goods applied for. In any event, regardless of any intentions that the Applicant may have in adopting the mark in respect of the goods applied for, signs which consist of the essential features that are necessary to obtain a technical result is barred from registration. I find that the mark as a whole is, in substance, functional.
28. Having considered all the relevant facts and circumstances, I find that the mark consists exclusively of the shape of goods that is necessary to obtain a

technical result, namely to hold together or fasten straps on goods of the sort applied for. Registration of the mark is precluded under section 11(3)(b) of the Ordinance.

*Other registered marks on the register and foreign registrations*

29. The Applicant's agent has referred me to a number of marks that have been registered or accepted for registration in Hong Kong on a *prima facie* basis. In the agent's view, these registered marks are comparable to the subject mark. I have reviewed the registrations quoted by the agent but I consider that none of the quoted examples is on par with the subject application. For example, the horsebit marks (registration or application numbers 300257030, 300518436 and 300587467), which the agent seeks to rely on to overcome the objection under section 11(1)(b) of the Ordinance, are devices of a horsebit, an article in a horse's mouth for controlling the horse on a bridle. The marks are therefore considered to be distinctive in respect of the goods in question, which do not include horsebits, bridles or harness. The toothbrush marks (registration numbers 199808051, 1999B16426, 200501012 and 200501013), which the agent has quoted to overcome the objection under section 11(3)(b) of the Ordinance, consist of features in the handles of toothbrushes that are not necessary to obtain technical results and therefore are not objected to under the Ordinance. In any event, I do not think that it is appropriate to make direct comparison between different 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.”

30. There are valid grounds for refusal and I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the Applicant in overcoming the objections in the subject application.
31. The Applicant's agent drew my attention to the acceptance of the mark for registration as a Community Trade Mark. It must be noted that national trade mark rights are territorially limited and granted independently of each other.

The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here, where there are valid grounds for refusal under the Ordinance. Despite the foreign registration or acceptance for registration of the mark, I am not convinced that the mark should be accepted for registration in light of the reasons for objections stated above.

### **Conclusion**

32. I have considered all the documents 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 sections 11(1)(b) and 11(3)(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  
30<sup>th</sup> August 2006