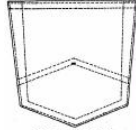


**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO.: 300364022**



**MARK:**

**CLASS: 25**

**APPLICANT: TEXWOOD LIMITED**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 31 January 2005, Texwood Limited (“the Applicant”) applied to register the



mark (“the subject mark”) in class 25 pursuant to the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

2. The subject application was made in respect of the following goods in Class 25 :

“Clothing, footwear, headgear; jeans, riveted heavy weight denim jeans, trousers, bib overalls, shorts, dresses, pants, overalls, overcoats, shirts, T-shirts, vests, skirts, jackets, coats, sport coats, sports wear, sweaters, sweatshirts, sweatpants, outer shirts, slacks, underwear, undershirts, undervests, blazers, pullovers, suits, blouses, blouson, windbreakers, brassieres, briefs, gloves, scarves, scarfs, waistcoats, chemises, golf shirts, tank tops, jerseys, turtle-necks, warm-up suits, parkas, ponchos, swimwear, bikinis, swim trunks, rainwear, raincoats, wind resistant jackets, sleepwear, pyjamas, robes, lingerie, hats, caps, wool hats, visors, headbands, ear muffs, wristbands, bathrobes, boxer shorts, cloth bibs, ties, belts, stockings, socks, hosiery, sneakers, shoes, boots, beach shoes, slippers, sandals, suspenders”

3. At the examination stage, objection was raised against the subject application under section 11(1)(b) of the Ordinance. Section 11(1)(b) reads as follows:

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

(a) ...

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

(c) ...”

4. On 29 January 2007, the Applicant filed a statutory declaration made by Ms Teresa Tam dated 29 January 2007 (“Ms Tam’s SD”) with a view to showing use of the subject mark in Hong Kong and thereby overcoming the objection. In reply, the Registrar of Trade Marks commented on the evidence in a letter dated 12 February 2007, maintaining objection on the basis that the evidence fails to demonstrate the subject mark has in fact acquired a distinctive character through use in respect of the applied-for goods before the date of application for registration under section 11(2) of the Ordinance.
5. The Applicant requested a hearing on the registrability of the subject mark which took place before me on 18 May 2007. Mr James Campbell instructed by Messrs. Baker & McKenzie appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.
6. In addition to arguing that the subject mark is *prima facie* registrable, the Applicant has relied on Ms Tam’s SD, and two statutory declarations made by Ms May Chan (“Ms Chan’s SD”) both dated 17 May 2007 and filed just on the day before the hearing. I therefore have to consider the *prima facie* case as well as the question on whether the objection is overcome by the evidence filed.

## **Decision**

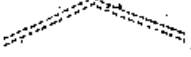
### *Prima facie case*

7. The interpretation of section 3(1)(b) of the UK Trade Marks Act 1994, which is equivalent to section 11(1)(b) of the Ordinance, was considered 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 assessing the distinctiveness of the subject mark, I must therefore have regard to the applied-for goods for which registration is sought, and the perception of the average consumer of the category of goods in question, who is deemed to be reasonably well-informed and reasonably observant and circumspect. The question I have to consider is whether the subject mark can serve to indicate that the goods offered under it originate from a particular trader, and therefore can distinguish them from those of other traders.
10. In the subject application, the goods applied for cover various items of clothing, footwear and headgear. These goods are general consumer merchandise and their relevant consumers are essentially members of the general public.
11. The subject mark is a two-dimensional representation of a stitched pocket with two slanting double-stitching lines meeting at an angle in the middle. The Applicant emphasized that the subject mark is more than a representation of a pocket as the two lines forms a distinctive device resembling an inverted “V”. The Applicant submitted that the element of the inverted “V”, i.e., , has been registered by them under Registration No. 199603883. The Applicant argued that since the inverted “V” element is distinctive, the subject mark which has incorporated this element should also be regarded as distinctive and acceptable for registration.
12. I do not agree that the Applicant’s above argument is correct. The above registered mark is only deemed to be distinctive in respect of “jeans, skirts, jackets, vests, shirts and shorts” pursuant to section 9(1)(e) of the Trade Marks Ordinance, Cap. 43. Even if an applied-for mark has incorporated a registered mark which is considered distinctive on *prima facie* basis, that does not necessarily mean the applied-for mark will also be considered distinctive as the overall visual impact of the mark as a whole can be different.
13. In my view, the subject mark in its entirety gives an overwhelming impression of a stitched pocket. Even taking into account the visual effect of the two straight lines of

stitching in the middle, I find that the subject mark as a whole is likely to be seen as nothing more than a stitched pocket with certain decoration.

14. In relation to the applied-for goods, in particular clothing, stitched pockets normally form part of the goods mainly as decorative elements. In order to identify the trade origin of the goods, consumers are accustomed to relying on labels or tags bearing brand names or trade marks usually attached to the following positions of the goods, namely, the edge of a pocket, the back of the collar or the neck of any upper garments, and the back waist of trousers. In my view, average consumers are generally not in the habit of making assumptions about the trade origin of the applied-for goods on the basis of a stitched pocket design.
15. Furthermore, average consumers are used to seeing various kinds of embellishments including different pocket designs on different clothing items. These embellishments are intended to make the merchandise more attractive and fashionable so that they can be more appealing to potential consumers. Considering the subject mark as a whole, I find that it is more likely for average consumers to perceive it as a purely decorative stitched pocket design. It is unlikely that they would see it as an indicator of trade origin as similar kinds of decorative feature may also appear on similar goods provided by other undertakings.
16. I have not overlooked that the applied-for specification is cast in broad terms. It covers not only outer garment such as jeans, trousers, T-shirts and jackets of which the vast majority have pockets, but also other goods like underwear and ties and a range of footwear and headgear items such as socks, sandals and caps. I accept that for certain items under the applied-for specification, the practice of incorporating a pocket or a stitched pocket design may not be common at present. Nevertheless, there is no reason to suppose that on these other items consumers would react any differently to such markings like the subject mark, given their decorative function, without first being educated to any intended trade mark significance. I am therefore of the view that the objection is also relevant in relation to these other goods.
17. The Applicant referred me to various exhibits of Ms Chan's SD and argued that in view of the established trend of using stitching designs on pockets in the trade, consumers are well trained and would immediately be able to see such stitching designs as indications of trade origin. Whilst I accept that many traders have adopted the practice of putting stitching devices on the pockets of clothing items, the exhibits

reveal to me just that the stitching devices are attached to the clothing items as decorations or embellishments, not as trade marks. Moreover, in deciding whether a particular mark is distinctive for the purpose of registration, I must have regard to the consumer's perception specifically on that particular mark. The mere fact that traders employ decorative stitching patterns of their own and that consumers are used to seeing or may pay particular attention to different stitching designs on pockets does not decide the matter one way or the other. Where marks of this kind are perfectly capable of being seen as no more than decorative embellishments, the Applicant will have to demonstrate that in the case of his particular mark it has nevertheless come to function as a badge of origin.

18. I appreciate that a sign may serve more than one purpose (see *Arsenal Football Club Plc v Matthew Reed* [2003] ETMR 19 where the sign served as a trade mark as well as a badge of allegiance). Thus, there may be no reason in principle why the subject mark cannot serve as both a decoration and an indicator of trade origin. However, for the reasons given above, I am of the view that the applicant has not proved the case that the subject mark serves as an indication of trade origin and the subject mark is likely to be perceived by the average consumers as purely decorative without any trade mark significance.
19. I therefore conclude that the subject mark does not fulfill the essential function of identifying the origin of the goods applied-for and fails to distinguish the Applicant's goods from those of others. The subject mark as a whole is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.


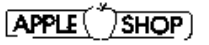
#### *Evidence of use*

20. I proceed to consider whether the subject mark has, as a result of the use made of it, acquired a distinctive character for the purpose of section 11(2) of the Ordinance. The relevant date is the filing date of the subject application, namely, 31 January 2005.
21. In assessing whether the subject mark has acquired a distinctive character, I will make an overall assessment of the evidence to see whether the mark has come 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 goods of other undertakings.

22. Having carefully considered the evidence, I am not satisfied that the evidence has in its totality established that the subject mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2). The reasons are set out below.

23. The evidence covers only some of the applied-for items such as jeans, pants, shirts, T-shirts and jackets. There is simply no evidence of use submitted in relation to some items covered by the specification of the subject mark. For those submitted evidence, some of the exhibits fail to reveal the use of the subject mark on the items. For instance, except on a small area on one advertisement, the use of the subject mark was not shown on any of the copies of promotional materials as provided in Exhibit “MTMC-7” of Ms Chan’s SD. For those exhibits in which the subject mark can be found, they fail to demonstrate the promotion and the use of the mark *on its own* because the subject mark always appear alongside other logos which are more likely to be perceived as trade marks. For example, from the catalogue provided in Exhibit “TT-3” and in the copies of advertisements and promotional materials in Exhibit “TT-4” of Ms Tam’s SD, I notice that a label bearing the mark “TEXWOOD” is attached on the edge of the subject mark which appears as a patch pocket or a pocket design on the jeans, pants, T-shirts or shirts. On various pages of these promotional materials, at least one of the distinctive marks, namely,



“TEXWOOD”, “萍果牌”, “ (“the apple device mark”) and “ (“the Apple Shop mark”) is prominently displayed. I appreciate that the use of a particular mark in conjunction with other registered marks does not necessarily preclude that particular mark from acquiring factual distinctiveness. However, from the evidence in the present case, I am not satisfied that there had been any promotion which emphasized to the public the intended use of the subject mark as a badge of origin.

24. The copy invoices provided in Exhibit “TT-1” of Ms Tam’s SD and in Exhibit “MTMC-8” of Ms Chan’s SD may help indicate sales of certain applied-for goods in Hong Kong, but they cannot show the use of the subject mark on those goods. The subject mark is not shown on the copy invoices. On the contrary, I notice that the apple device mark and the Apple Shop mark are conspicuously displayed on many of the copy invoices in Exhibit “TT-1”.

25. Neither can the printouts from the Applicant’s website as provided in “TT-6” of Ms

Tam's SD bear any relevance as they appear to demonstrate the use of the marks "texwood" and "萍果牌" only. The Applicant drew my attention to the first page of "TT-6" where, beside a picture showing a rear patch pocket which looks like the subject mark, it is stated that "設計特色在於色彩豐富及閃爍耀眼的細節裝飾,尤其表現在後袋上,以特色金屬車線". To my mind, instead of emphasizing to the public that the subject mark is intended to be used as an indication of trade origin, the statement seems to suggest that the stitched pocket is merely a design characteristic ("設計特色") or a decoration ("裝飾").

26. I agree with the Applicant that, in determining whether the subject mark has acquired distinctive character following the use made of it, the evidence must be assessed globally. Factors such as the market share of an applicant, the period and the extent of use of a mark, the amount invested in promoting the mark, etc, may be relevant. I also take note of the Applicant's submissions, among other things, that the subject mark has been used since 1972, that the sales of goods bearing the mark and the annual advertising expenditure are substantial, that the Applicant had many outlets, etc. Nevertheless, there is no evidence before me to show the use and promotion of the subject mark *on its own* on the applied-for goods so as to demonstrate that the average consumers have been educated to treat the subject mark as an indication of trade origin.
27. In view of all the foregoing, I conclude that the evidence filed in support of the application fails to show that the mark has, prior to the date of application, in fact acquired a distinctive character in Hong Kong as a result of the use made of it in respect of the objectionable goods under section 11(2). Accordingly, the objection under section 11(1)(b) cannot be overcome and has to be maintained.

*Reference to other registered trade marks on the register*

28. The Applicant referred me to a number of registered marks consisting of stitched pocket devices or stitching devices and submitted that the subject mark should likewise be accepted for registration.
29. I have considered the registered trade marks quoted by the Applicant. Many of them are accepted on use. Some marks which were accepted for registration on *prima facie* basis consist not only of a stitched pocket device but also a distinctive word element. In any event, 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). Therefore, I am not prepared to accept the subject mark merely because of the acceptance of the marks referred to by the Applicant, particularly where the subject mark has been found unregistrable under a valid ground of objection.

*Reference to overseas registration*

30. The Applicant has also referred me to various stitched pocket devices or stitching devices which have been accepted for registration in other jurisdictions. I do not find these foreign registrations of any relevance to the present application. Trade mark rights are territorially limited and granted independently of each other. Even if a sign identical to the subject mark has been registered in other jurisdictions, the bare fact of foreign registration is not sufficient to establish that the sign is eligible for registration in Hong Kong (*Automotive Network Exchange Trade Mark* [1998] RPC 885).

**Conclusion**

31. In this decision, I have considered all the documents filed by the Applicant, Mr. Campbell's written and oral submissions and the relevant authorities. For the reasons given above, I find that the subject mark as a whole is devoid of any distinctive character and is therefore precluded from registration under section 11(1)(b) of the Ordinance. The objection has not been successfully overcome by evidence of use in accordance with section 11(2). The present application is therefore refused under section 42(4)(b) of the Ordinance.

Patrick Yeung  
for Registrar of Trade Marks  
7 November 2007