

TRADE MARKS ORDINANCE (Cap. 559)

**APPLICATION NOS: 300411489, 300442692, 300442719, 300442728, 300442737,
300442746, 300442773, 300442782**

MARK: DEVICES
CLASS: 25
APPLICANT: KABUSHIKI KAISHA RIGHT-ON (RIGHT-ON CO., LTD.)

STATEMENT OF REASONS FOR DECISION

Background

1. On 28 April 2005, Kabushiki Kaisha Right-On (Right-On Co., Ltd.) (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”), to register the following series of marks in Class 25.

Application Number

300411489

Applied-for Mark



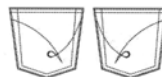
The applicant claims the colours navy blue and brown as elements of mark “A” in the series.

2. On 21 June 2005, the applicant made further applications, pursuant to the provisions of the Ordinance, to register the marks shown below in Class 25.

Application Number

300442692

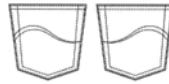
Applied-for Mark



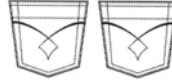
300442719



300442728



300442737



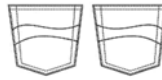
300442746



300442773



300442782



3. The subject applications are made in respect of the following goods in Class 25: “clothing; jeans; T-shirts; sweat shirts; sports jerseys; gloves; socks; belts; footwear; sports shoes; mountaineering boots; headgear; caps; hats.”
4. At the examination stage, objections were raised against the subject applications under section 11(1)(b) of the Ordinance and rule 8(1) of the Trade Marks Rules (Cap.559A) (“the Rules”).
5. The applicant requested a hearing on the registrability of the subject marks which took place before me on 27 September 2006. Ms. Ellen Wan of China Patent Agent (H.K.) Ltd. appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
6. The applicant did not file any evidence of use of the subject marks. I therefore have only the *prima facie* case to consider.

The Ordinance and the Rules

7. The relevant part of the Ordinance and the Rules under which the objections were taken are as follows:

Section 11(1) of the Ordinance:

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

(a) ...

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

Rule 8(1) of the Rules:

“The representation included with an application for registration of a trade mark shall depict the trade mark clearly and in sufficient detail to permit a proper examination to be made of the trade mark and shall be of a kind and quality that is suitable for reproduction and registration.”

Decision

8. In the subject applications, the subject marks are applied for in respect of the same specification of goods listed in paragraph 3 above. Although the subject marks are all different, the objections and issues involved in all of the subject applications are virtually the same. Ms. Wan’s submissions at the hearing also addressed the objections to the subject applications as a whole. I have considered the subject applications separately and independently each on its own merits, but as the issues are the same, I give reasons for my determination on the subject applications in a single decision.

Rule 8(1) of the Rules

9. Having considered Ms. Wan’s submissions, I waive the objection raised under Rule 8(1) of the Rules against all of the subject applications.

Section 11(1)(b) of the Ordinance

10. I now turn to consider the objection under section 11(1)(b) of the Ordinance, which precludes from registration signs which are devoid of any distinctive character.
11. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, page 306, Jacob J said :

“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?"

12. The European Court of Justice ("ECJ") stated in *Linde AG v Deutsches Patent-und Markenamt* [2003] RPC. 45, at paragraphs 40-41, that for a mark to possess distinctive character within the meaning of Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 (equivalent to section 11(1)(b) of the Ordinance), 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. This 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.

13. 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 marks than for others. For instance, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see *Henkel KGaA v OHIM* [2005] ETMR 44, paragraph 38, *Mag Instrument Inc. v OHIM* [2005] ETMR 46, paragraph 30, and *Deutsche SiSi-Werke GmbH & Co Betriebs KG v OHIM* [2006] ETMR 41, paragraph 28). That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product (*August Storck KG v OHIM*, Case C-25/05P, paragraph 29, a case where the applied for mark was a two-dimensional representation of a sweet in a

gold-coloured wrapper with twisted ends).

14. The subject marks are two-dimensional representations of two pocket devices with line stitching thereon such as wavy bands, curving lines or symmetrical curves. For those marks set out in paragraph 2 above, there is also double line stitching on the edges of the pocket devices.
15. In the subject applications, the goods applied for cover clothing, footwear and headgear. These goods are general merchandise and their relevant consumers are essentially members of the general public.
16. In my view, when the subject marks are applied to the goods applied for, on first impression, consumers would perceive the subject marks simply as stitched pockets or pocket-like stitching designs. Stitched pockets normally form part of the goods applied for, in particular clothing and jeans, mainly as decorative elements. Average consumers are not in the habit of making assumptions about the origin of goods on the basis of such stitched pockets. Instead, consumers are accustomed to looking at the brand name attached to the edge of the pockets or the brand name tag positioned at the back waist of jeans or shirts to identify the trade source of the goods. Additionally, in view of the fact that the goods applied for are fashion products, average consumers would be used to seeing the goods with different kinds of embellishments such as pockets or stitching decorations in order to make the goods more attractive to potential consumers. They are unlikely to rely on a decorative feature such as a pocket or stitching design to identify the origin of goods, as similar design feature may also appear on similar goods provided by other undertakings. Accordingly, I consider that consumers are likely to perceive the subject marks, when applied to the goods applied for, merely as decorative features of the goods rather than identifiers of commercial origin of the goods.
17. Ms. Wan argued that it was not common to have side-by-side pockets on jeans and pocket-like frame with sewing designs for the goods other than jeans. In respect of clothing and jeans, I consider that consumers expect to see pocket and stitching devices on those goods, so they are likely to perceive the subject marks as mere variations of fairly common features found on those goods. As average consumers would only perceive a pocket with stitching designs as pure decoration, it is unlikely that they would see two pockets positioned side-by-side with stitching designs as unusual and take them as trade marks.

18. My above observations are based on consideration of the subject marks in the context for which, as I understand it, they are primarily intended, that is to say jeans and related clothing items. The specification is, however, cast in broader terms and includes a range of footwear and headgear as well as belts and gloves. Although pockets are less commonly associated with such goods, it is certainly not unknown for hats and boots etc to have pockets, say, to accommodate small items. Even if the practice of incorporating pockets and stitching patterns is not yet established in relation to these goods, there is no reason to suppose that consumers would react any differently to such markings on these other clothing items without first being educated to any intended trade mark significance. Accordingly I conclude that the objection is also relevant in relation to these goods.
19. Ms. Wan acknowledged that for clothing, footwear, caps etc., trade marks more often appear on labels or swing tags or on the packaging of the products. However, she considered that sewing designs are more apparent and they more easily attract people's attention, as compared to labels, tags or packaging. She also contended that the sewing designs in the subject marks are a distinctive part of the whole marks and that putting them on pockets does not undermine the registrability of the sewing designs.
20. To my mind, even if the stitching designs in the subject marks are eye-catching, it does not necessarily mean that they would be taken by consumers as an indication of trade origin. The critical question is whether the stitching designs would convey trade mark significance to the average consumers. For the reasons discussed above, I do not consider that the stitching designs of the subject marks are distinctive in the sense that consumers would see them as identifiers, indicating that goods bearing them originate from a particular undertaking. In my view, unless and until consumers are educated by use of the subject marks as trade marks, it is unlikely that they would attach trade mark significance to the subject marks.
21. Ms. Wan further submitted that the earlier registrations of stitched pocket devices and stitching devices evidence the wide adoption of pockets and stitching devices by traders in the relevant industry. On that basis, she argued that those earlier registrations demonstrated the trend of using stitching designs on pockets as badges of trade origin, and that consumers were conceivably well trained to

check out these details to figure out the origin of goods.

22. In principle, the state of the register tells me nothing about circumstances in the marketplace. It is, moreover, well accepted that past acceptances are not binding on the Registrar who has to assess each application on its own merits.
23. I am, however, prepared to accept for current purposes that other traders have adopted the practice of putting stitching devices on the pockets of clothing items. What is lacking is any evidence on how consumers see such marks in general or the subject marks in particular. The mere fact that other traders employ decorative stitching patterns of their own does not decide the matter one way or the other and fails to address the issue of consumer perception in relation to such practices at the relevant date.
24. It seems to me that where marks of this kind are perfectly capable of being seen as no more than decorative embellishments, it is for the applicant to demonstrate that in the case of his particular mark it has nevertheless come to serve as a badge of origin.
25. In saying that I accept that a sign may serve more than one purpose (see *Arsenal Football Club Plc v Matthew Reed* [2003] ETMR 19 where the sign both served as a trade mark and a badge of allegiance). In this case, there may be no reason in principle why the signs in question should not serve as both decoration and origin indicators. But it is for the applicant to make good the case that in the perception and recollection of consumers the subject marks have come to unambiguously indicate the goods of a single trader.
26. Based on the reasons stated above, I conclude that the subject marks cannot fulfill the essential function of identifying the origin of the goods applied for, and thus distinguishing the applicant's goods from those of others. Therefore, the subject marks as a whole are devoid of any distinctive character and are precluded from registration under section 11(1)(b) of the Ordinance.

Reference to other registered trade marks on the register

27. Ms. Wan referred me to a number of marks consisting of stitched pocket devices or stitching devices which were accepted for registration, and submitted that the subject marks were no less distinctive than the registered marks.

28. I have considered the registered trade marks quoted by Ms. Wan. However, I find that most of the registered marks are accepted on use or by reason of special circumstances, and some of them are more distinctive. In any event, it is well established that each case must be considered on its own 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 & Sons Ltd* [1996] RPC 281 at 305). Therefore, the acceptances of the quoted marks do not assist the subject applications. In particular, where there is valid ground of objection in these applications, I cannot accept the subject marks solely on the basis of the earlier registered trade marks.

Conclusion

29. In this decision, I have considered all the documents filed by the applicant and all the arguments submitted in relation to the subject applications. For the reasons given, the subject marks are precluded from registration by section 11(1)(b) of the Ordinance, and the subject applications are accordingly refused under section 42(4)(b) of the Ordinance.

Sandra Hui
for the Registrar of Trade Marks
23 March 2007