

## TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300424719



MARK:

CLASSES: 7, 9, 16, 37, 42

APPLICANT: PLURITEC INDUSTRIES S.P.A.


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## STATEMENT OF REASONS FOR DECISIONS

### Background

1. On 23 May 2005, an Italian company Pluritec Industries S.P.A. (the “applicant”)



applied to register the mark “” under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”). Registration is sought in classes 7, 9, 16, 37 and 42. A full list of the specification is set out in the *Annex*.

2. The Registrar, on 4 June 2005, notified the applicant of a deficiency in the application, i.e. the application did not include a clear representation of the mark to permit a proper examination of it. The applicant was therefore given 2 months to remedy the deficiency in accordance with rule 11 of the Trade Marks Rules (Cap. 559 sub. leg.)(the “Rules”). In response, within time, the applicant filed a new representation for the application on 20 June 2005. The new representation is now reproduced as follows:-



3. After receipt of the new representation, on 24 June 2005, the Registrar notified the applicant that it was not satisfied that the new representation was a “clear specimen of the original mark”, but instead it was a different mark so that the

deficiency had not been remedied. As a result, Dibb Lupton Alsop (the applicant's solicitors) made submissions on 27 July 2005 requesting an amendment of the original representation of the mark under section 46 of the Ordinance. The Registrar declined the request on 29 July 2005 but waived the formalities objection and accepted the original representation of the mark for substantive examination of the application on 3 August 2005.

4. Shortly thereafter (on 8 August 2005), the Registrar purported to accept the application (with the original representation of the mark) for publication. However, due to the applicant's solicitors' objection, the publication was halted. On the next day (9 August 2005), the applicant called for a hearing on the Registrar's refusal of its amendment of mark request.
5. The hearing took place before me on 11 January 2006 at which Ms. Sandy Wong of the applicant's solicitors appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.

#### **The relevant provisions**

6. Section 46(4) of the Ordinance is as follows:-

*(4) An application for registration of a trade mark may be amended in other respects but only for the purpose of correcting-*

*(a) ... ;*

*(b) errors of wording or of copying; or*

*(c) obvious mistakes,*

*and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.*

7. The equivalent provision in the UK is section 39(2) of the Trade Marks Act 1994 (the "Act"), which is in broadly similar term.

#### **The applicant's submissions**

8. Ms. Wong's main submissions are summarized as follows:-

- (a) Section 46(4) of the Ordinance follows strictly the wording of the corresponding Clause 44(3) of the Trade Marks Bills. The section allows

an amendment of mark resulting from errors of wordings or of copying or obvious mistakes, *so long as* such amendment does not substantially affect the identity of the applied-for mark. In other words, Ms. Wong contends, where the amendment does not “substantially affect the identity of trade mark”, it should be allowed.

- (b) The original representation is a photocopy of a photocopy so that in its black background, there are some white dots; whereas the new representation is the clearer version of the copy, with the white dots seemingly removed.
- (c) The inclusion of the term “s.p.a.” (meaning “*societa per azioni*”, Italian for “limited company”) in the original representation is simply an error because no applicant should have exclusive use of the term “s.p.a.” and the term does not give a particular identity to the applied-for mark.
- (d) Both the removal of the white dots and the deletion of the term “s.p.a.” in the new representation *do not affect the identity of the applied-for mark*, which still contains the predominant elements “i s international supplies” and the strip in the background.
- (e) There is no case law in Hong Kong on the subject matter, although the Registry’s *Work Manual* does set out the philosophy under the new law concerning amendment of applications.
- (f) The Registry’s *Work Manual* provides some examples of amendment of applications that cannot be allowed. One of them is “replacing the representation of a mark with a clearer version such that *some features become apparent or recognizable for the first time*”. However, this example is not applicable to the present case because the example concerns *addition* of features, whereas the present case concerns the *taking away* of certain features not apparent in the original representation of the mark in the first place. As such, the *Work Manual* does not answer the question whether the removal of the white dots and the deletion of “s.p.a.” can be allowed. As Ms Wong contends, such amendments do not substantially affect the identity of the mark applied for and they should be allowed.

- (g) The UK registry’s case of *Swizzels Matlow Limited’s Application*, O/155/98 (24 July 1998) is not a case applicable to the present case as to what amount to changes that “substantially affect the identity of the applied-for mark”, because it only concerns changes made to the “*description* of the mark” instead of changes made to the *representation* of the mark itself.
- (h) According to the UK registry’s *Work Manual*, a camera ready copy (CRC) which improves the quality of a representation may be filed at a later date (after the date of filing the application) but this will only be accepted if the clearer representation merely removes minor imperfections. If the CRC looks substantially different it will not be used. Ms. Wong suggests the Registrar to adopt a sensible approach and to follow the UK practice. It is her submission that the white dots and the term “s.p.a.” in the original representation are minor imperfections, the removal of which does not result in substantial change of the applied-for mark’s identity.

## **Decision**

### *Approach to assessment*

9. For a request of amendment of application (including amendment of mark) to be allowed under section 46(4) of the Ordinance, an applicant must, to put it simply, satisfy the Registrar of two things: (i) there have been some errors of wording or of copying, or obvious mistakes in the application, *and* (ii) the amendment sought does not substantially affect the identity of the applied-for mark.
10. The philosophy behind this section is stated in the Registry’s *Work Manual*, *Chapter on Amendment of Applications*, which reads:

*“under Cap. 559 and the Rules, there are only very limited circumstances under which amendment of an application can be allowed. The philosophy under the new law is that application details should be correct as from the time of filing the application. It is not in the interest of the public at large that an applicant be allowed to subsequently change what he has applied for. It is always open to him to make a fresh application of a slightly different mark.”*

11. As rightly pointed out by Ms. Wong, there has been no case law in Hong Kong directly on the subject matter. Yet, I find useful guidance of assessment from the case *Swizzels Matlow Limited's Application* (the *Swizzels' case*) [1999] R.P.C. 879, which discusses section 39(2) of the Act– the equivalent of our section 46(4) as said. This case is actually the case heard on appeal on the UK registry's case that Ms. Wong has referred me to.

12. In this case, registration was sought of a 3-dimensional mark with a description solely in words but without any visual image, in respect of sweets called “love hearts”. With regard to 3-dimensional marks, at that time, the UK registrar's practice did not exclude the possibility of acceptance of a description in words alone if the description was sufficiently precise. The mark was refused by the UK registry on the basis that the description was not sufficiently precise. On appeal before Mr. Simon Thorley Q.C. sitting as the Appointed Person, the applicant sought (*inter alia*) to amend the description of the mark by inserting the precise dimensions of the diameter and depth of the sweet tablets by way of a limitation. Mr. Thorley Q.C. refused the amendment request in that case and said:-

*“I cannot accept that section 13(1) [broadly similar to section 15 of the Ordinance, concerning disclaimers and limitations] is a provision by which a coach and horses could be driven through the restrictive provisions of section 39... Section 39 is, in my judgment, intended to restrict the ability of an applicant during the course of prosecution to change the application in any significant way so as to retain the priority date of the application and yet achieve registration of a mark of a different character. I do not believe that the amendment sought to limit the diameter and depth of the tablet is an amendment which is permissible under the Act. I therefore refuse to allow the amendment.”*

13. Despite Ms. Wong's submission that this case is not applicable, I consider it will be artificial to distinguish between the two types of changes mentioned in paragraph 8(g) above, when the applied-for mark in the *Swizzels' application* was filed with a description *solely* in words but without any visual image. More importantly, the assessment approach for section 39 of the Act does not strictly hinge on this point.

14. This assessment approach was adopted in *Robert Mc Bride Ltd's Trade Mark*

*Application* (the ‘*Mc Bride’s* case’) [2003] R.P.C. 19, a decision of Mr. Geoffrey Hobbs Q.C. as the Appointed Person. He stated the importance of the applicant declaring at the outset what his mark is and that under the new law, it will not be possible to make amendment of a trade mark after registration has been applied for so that if a mark as filed is unregistrable it will be necessary to file a fresh application in order to register any amended version of the mark.

15. Both the *Swizzels’* case and the *Mc Bride’s* case were referred to and approved in *Nestle SA’s Trade Mark Application* [2005] R.P.C. 5, an English Court of Appeal case concerning “POLO” mint flavoured compressed confectionery.
16. Bearing the foregoing in mind, I now turn to consider whether or not the requirements as laid down in section 46(4) are satisfied in the instant case so that the requested amendments should be allowed or otherwise.

*Obvious mistakes & errors of wording or of copying*

17. Ms. Wong argued that the filing of the original representation is an *obvious mistake* because it is only a photocopy of a photocopy, so that it should not have been used for the purpose of filing the subject application in the first place. Rather, the new representation, being the “clearer version” should have been filed.
18. Despite Ms. Wong’s submissions, I fail to see that there exists an obvious mistake in the application as originally filed. This is because the term “obvious mistake” in my view must concern a mistake *apparent* on the face of the application such that the mistake would have been obvious to the Registrar or a third party inspecting the application. For example, if the specification sets out goods or services by reference to a class or classes under which the goods or services do not fall, the mistake would then be an obvious one and the applicant may request an amendment of the application accordingly. However, the applicant may *not* do so if the goods or services as set out can actually also fall into the wrongly claimed class or classes, because in such event, the mistake would not then be an obvious one. An example would be for “valves” to be wrongly filed in Class 7 when it was meant to be filed in Class 11. This was held *not* to be an obvious mistake in *Altecnic Ltd’s Trade Mark Application* [2002] R.P.C. 34.

19. In the instant case, I do not think the inclusion of the white dots and the term “s.p.a.” in the original representation of the mark constitutes an obvious mistake, apparent from the application as and when it was first filed. In my view, the white dots are regularly arranged in a neat matrix pattern and the term “s.p.a.” located at the bottom of the mark in such a way as to reveal no obvious mistake at all in the original representation of the mark.
20. Additionally, Ms. Wong submitted that the inclusion of the term “s.p.a.” in the original representation of the mark is simply an error, *because* no applicant should have exclusive use of the term “s.p.a.” and the term does not give a particular identity to the applied-for mark.
21. I cannot agree that the reasons given by Ms. Wong explain and support the alleged error. The fact that no trader should have exclusive use of the term “s.p.a.” does not prevent it from being validly claimed as a constituent element of a mark seeking registration. Also, an element might in itself be indistinctive but yet when combined with other elements, adds to the distinctive character of a mark, e.g. when the combination conveys something more than the sum of its parts or conveys a different impression. In this case the effect of the removal of “s.p.a.” was to abandon the reference to a corporate entity. Therefore, I do not consider the reasons offered could explain an “error” for requesting an amendment of mark.
22. More importantly, I do not think what is in mind of Ms. Wong is something contemplated by section 46(4)(b) of the Ordinance, because the section indeed envisages “errors of wording or of copying”, but not simply “an error” of any kind. To my mind, the “error” asserted by Ms. Wong is certainly not an error of wording or of copying. In any event, there has been no pre-existing information before me that supports or bears out the fact that there has been any error, not to mention “an error of wording or of copying”.
23. As such, I conclude that the requirements of an obvious mistake and/or error of wording or of copying are not satisfied in the instant case.

*Substantially affect the identity of the trade mark*

24. Ms. Wong placed much emphasis on this requirement such as to nearly suggest

that where the requested amendment does not affect the identity of the trade mark, the amendment should be allowed. In my view, it would not be sufficient but that both the requirements as discussed in paragraph 9 above must be satisfied. This is because such requirements are not couched as independent grounds for amendment of application under section 46(4).

25. Ms. Wong referred me to the Registry's *Work Manual* where it is stated that "replacing the representation of a mark with a clearer version such that some features become apparent or recognizable for the first time" cannot be allowed. However, she argued the *Work Manual* does not mention the situation where the clearer version *takes away* some features which are not apparent or recognizable in the first place.
26. I cannot see how this argument could assist the subject application. First of all, the examples provided by the *Work Manual* are not meant to be exhaustive. Secondly, I cannot see how a meaningful distinction can be drawn between introducing a new feature or element to the original representation and taking away such a feature or element. Either way, strictly speaking, the mark is altered. Despite Ms. Wong's submission that the features being taken away in the instant case are not apparent or recognizable in the first place, in my view, they are readily appreciable features. To my mind, in the case where any originally appreciable features are deleted, the identity of the mark would be as much substantially affected as in the case where some features are apparent or recognizable in the mark for the first time. Thirdly, the "addition" argument can, interestingly, actually be conceived in relation to the white dots: one may say that in the new representation of the mark, the solid black background is recognizable for the first time. It evinces that the argument for a distinction between the addition and deletion of features can be an artificial one and is therefore of little strength.
27. Ms. Wong also contends that the seeming removal of the white dots and the deletion of "s.p.a." are minor imperfections so that if the Registry is to follow the UK registry's approach as set out in their *Work Manual*, the requested amendments should be acceded to. In the light of my findings as explained in the preceding paragraph, I do not agree that the requested amendments are just relating to mere "minor imperfections". As indicated above, the removal of an element which places the accompanying words in the context of a corporate name is more than simply a minor imperfection. The requested amendments

are appreciable amendments which in my view will substantially affect the identity of the mark applied for.

### **Conclusion**

28. For the reasons given above, I find that the requirements for amending the original representation of the applied-for mark are not satisfied and I therefore refuse this application for amendment of mark under section 46(4) of the Ordinance. Yet, there is nothing to prevent the applicant from filing an application afresh for the new representation of the mark. In this decision, I have considered all the documents filed by the applicant, together with all oral and written submissions made in respect of the subject application.

Doreen Wan  
For Registrar of Trade Marks

22 February, 2006

Class 7

machines and machines tools; drilling and routing machines; stack preparation machines; machines for drilling, pinning, taping and stacking; brushing machines for printed circuits; scrubbing and deburring machines; coating machines; machines for stripping coatings.

Class 9

X ray machines; X ray drilling and routing machines.

Class 16

paper; printed matters; stationery.

Class 37

machinery installation, maintenance and repair.

Class 42

computer software design; computer system design; installation and maintenance of computer software and computer system; engineering; industrial design; services for the design of machinery, plants, tools, including application software, and of accessories for manufacturing printed circuit and electronic components.