

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

**APPLICATION NO.: 300473887**

**MARK:**                   A SIMPLICITY  
                              B Simplicity  
                              C simplicity

**CLASS:**                **19**

**APPLICANT:**       **E.I. DU PONT DE NEMOURS AND COMPANY**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 10 August 2005, E.I. DU PONT DE NEMOURS AND COMPANY (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following series of three marks:

A SIMPLICITY  
B Simplicity  
C simplicity

(“the subject mark”) in Class 19.

2. The goods in respect of which registration is sought are:

“nonstructural building materials, namely resin-based solid surface counter tops and vanity tops.”

3. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance on the basis that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied for goods, and is devoid of any distinctive character.
4. A hearing on the registrability of the subject mark took place before me on 7 March 2007 at which Ms Ellen Wan of China Patent Agent (H.K.) Ltd. appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.

5. The applicant did not file any evidence of use of the subject mark. I therefore have only the *prima facie* case to consider.

### **The Trade Marks Ordinance**

6. Section 11 of the Ordinance is in the following terms:-

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

...

(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;

...”

### **Decision**

#### *Section 11(1)(c) of the Ordinance*

7. Section 11(1)(c) of the Ordinance excludes registration of 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.
8. Section 11(1)(c) is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (“Regulation No. 40/94”). In *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) [2004] R.P.C. 18 (the “*DOUBLEMINT*” case), the European Court of Justice (“ECJ”) discussed the approach to Article 7(1)(c) of Regulation No. 40/94 and stated in paragraph 32 the relevant principles as follows:

“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

9. The subject mark consists of a single word “SIMPLICITY”. The use of upper or lower case for the letters in the three marks in the series applied for makes no difference to the meaning of the word or to its impact on the perception of the average consumer. “Simplicity”, as a noun, has the dictionary meaning of “the quality or condition of being simple” (*Collins English Dictionary, Third Edition*). According to the same dictionary, “simple” includes the meaning of “not involved or complicated; plain; unadorned; without additions or modifications.” In relation to the applied for “nonstructural building materials, namely resin-based solid surface counter tops and vanity tops”, the mark “SIMPLICITY” conveys an immediate message that the goods provided are of the quality or condition of being simple. The mark simply describes the characteristics of the goods applied for, that is, they are plain and simple, and are not complicated in design.
10. Ms Wan submits that the mark is not descriptive because “there is no evidence that the word ‘simplicity’ is particularly common to the related industry or used on the applied for goods”.
11. For a mark to be objectionable under section 11(1)(c) of the Ordinance, it is not necessary to be particularly common in the relevant industry. It is established that it is irrelevant whether there are other, more usual, signs or indications for designating the same characteristic of the goods (see Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57, paragraph 57). It is also not necessary that the mark is actually in use at the time of the application for registration. It is sufficient that it could be used for such a purpose (*DOUBLEMINT* (supra), at paragraph 32). In any event, the Internet references provided by the

examiner to the applicant during the examination stage on 13 October 2005 and 13 October 2006 show that “simplicity” is indeed a word used to describe different nonstructural building materials including counter tops and vanity tops that are simple in design or appearance. Excerpts of those Internet references are provided at *Annex A* to this decision. Those Internet references are in line with my finding in paragraph 9 that the mark “SIMPLICITY” is descriptive in respect of the applied for goods. As such, I am satisfied that the subject mark may serve to designate the characteristics of the goods applied for.

12. There is also Ms Wan’s submission that the mark is not descriptive because it does not describe specifically what the goods are nor the function of the goods. She further argues that the mark does not indicate any industry in which the applicant is engaged.
13. I cannot accept this submission, either. Section 11(1)(c) provides that trade marks which consist exclusively of signs which may serve, in trade or business, to designate “*the kind, ... intended purpose ... or other characteristics of goods or services*” shall not be registered. Even though the subject mark does not describe what the goods are, their function, or which industry the applicant is engaged in, it would fall within the prohibition under section 11(1)(c) if it designates any one or more characteristic of the applied for goods.
14. When used in relation to the applied for goods, the mark “SIMPLICITY” indicates the characteristics that the goods provided are plain and simple, and are not complicated in design. In view of the descriptive message conveyed by the word “simplicity” and the fact that there is no other element or stylization in the mark, I conclude that the subject mark consists exclusively of a sign which may serve in trade or business to designate the characteristics of the applied for goods. The subject mark is therefore debarred from registration under section 11(1)(c) of the Ordinance.

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

15. Section 11(1)(b) of the Ordinance precludes from registration signs which are

devoid of any distinctive character. It operates as a separate ground independent of the objection under section 11(1)(c) of the Ordinance.

16. The relevant principles relating to distinctive character was laid down in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 (“*British Sugar*”), where Jacob J said 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?”

17. In *Linde AG, Windward Industries Inc and Rado Uhren AG* [2003] E.T.M.R. 78 (Joined Cases C-53/01 to C-55/01), the ECJ stated at paragraphs 40 and 41 that:

“40. For a mark to possess distinctive character within the meaning of that provision 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 (see *Philips*, paragraph 35).

41. 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. According to the Court’s caselaw, that 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 (*see Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).”

18. It is also established that marks possessing distinctive character must be able to guarantee the identity of a trade origin. In *Libertel Groep BV v Benelux-Merkenbureau* (Case C-104/01) [2003] E.T.M.R. 63 the ECJ held the following:

“62 It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have

another origin (see Canon, para. [28], and Case C-517/99 Merz & Krell [2001] E.C.R. I-6959, para. [22]). A trade mark must distinguish the goods or services concerned as originating from a particular undertaking...”

19. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the applied-for goods. I must also have regard to the perception of an average consumer who is reasonably well-informed and reasonably observant and circumspect.
20. The subject mark consists of the word “SIMPLICITY”. There is no added element or stylization to the mark. When used in relation to the applied for nonstructural building materials, namely, counter tops and vanity tops, the average consumers are likely to perceive the mark “SIMPLICITY” as indicating that the applied for goods are plain and simple, and are not complicated in design. Without first being educated, consumers are likely to perceive the mark as merely indicating the characteristics of the goods, as opposed to an indication of their trade origin.
21. Ms Wan submits that a reasonably observant and cautious consumer does not need to proceed to analyse any details or underlying meaning to recognize the mark as an indication of trade origin. She argues that the mark functions to indicate the origin of goods because no one except the applicant uses the mark for the same or similar goods.
22. I am not persuaded by Ms Wan’s submissions that the subject mark is distinctive for registration. In assessing the distinctiveness of marks tendered for registration, the critical question is whether the consumers would perceive the mark as a badge of trade origin, i.e. a mark that performs the essential function of a trade mark referred to in paragraph 18 above, when the mark is used in relation to the applied for goods and services.
23. Even if a particular mark is not already used by other traders in the relevant trade, it does not necessarily mean that the mark possesses any distinctive character in respect of the applicant’s goods. In any event, Ms Wan’s contention that no one except the applicant uses the mark for the same or similar goods is not supported by evidence, and runs contrary to the Internet findings at *Annex A*. As explained, these examples of use of the word

“simplicity” from the Internet support my finding that the mark “SIMPLICITY” is descriptive in respect of the applied for goods. As the subject mark is equally applicable as a description of similar characteristics of the goods provided by other undertakings, it would not enable the relevant consumers to distinguish the applicant’s goods from those of other undertakings. The subject mark therefore fails to perform the essential function of a trade mark in guaranteeing the identity of the origin by enabling the relevant consumers, without any possibility of confusion, to distinguish the applicant’s goods from others.

24. For the above reasons, I consider the subject mark to be devoid of any distinctive character, and is thus precluded from registration under section 11(1)(b) of the Ordinance.

*Reference to other registered trade marks and foreign registration*

25. At the hearing, Ms Wan draws my attention to a number of registered marks such as “SIMPLICITY” in class 16, “SIMPLICITY PLUS” in class 31 and “SIMPLICITY CONSULTANTS” in classes 35 and 36. Ms Wan submits that those registrations show that “simplicity” is a registrable word; therefore the subject mark should be considered distinctive and acceptable for registration as well.
26. I note the registrations to which Ms Wan refers but I consider that the grounds of objection to the present application are valid and I ought not to ignore them simply on the basis of some earlier acceptance. In any event, it is well established that each case must be considered on its own facts and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar* (supra), at page 305). Ms Wan’s reference to other registered marks therefore cannot assist the applicant in the subject application.
27. Ms Wan further draws my attention to the fact that the subject mark has been accepted for registration in the United States. She submits that since English is the official language and the mother tongue of the majority of consumers in the US, the registration of the subject mark in the US should have much

reference value.

28. I have noted the US registration. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other country is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). I must examine the registrability of the subject mark against the registration requirements laid down in the Ordinance and against the principles established in case law, but not simply on the bare fact of acceptance in other jurisdiction. As there are valid reasons for refusing the subject application, I should not simply follow the registration of another registry. This is especially so when the reasons and rationale behind the acceptance are not available before me.

### **Conclusion**

29. In this decision, I have carefully considered all the documents filed by the applicant, together with all written and oral submissions made by the applicant. For the reasons given above, I consider that the mark is precluded from registration by sections 11(1)(b) and 11(1)(c) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

*Original signed*

Jessica Law  
for the Registrar of Trade Marks  
13 June 2007

## Annex A

1. <http://www.tdctrade.com/imn/04082604/homedec016.htm>

Kitchen furnishing for modern homes in Chengdu

**Simplicity** and convenience are the key words in design, and care is taken to highlight personality, as required by the client.

2. [http://www.furniturefind.com/design/1\\_030\\_styleguide.aspx](http://www.furniturefind.com/design/1_030_styleguide.aspx)

Furniture Style Guide

Transitional

Simpler lines than those found in more traditional styles, but not all lines as simple as contemporary. Transitional furniture is about melding comfort and more **simplicity** with the graceful styling of traditional furniture. Sub-styles include: Casual and Eclectic.

3. <http://www.europebynet.com/modern.html>

MINIMALIST AND MODERN FURNITURE

Inspired by pure **simplicity**, the modern, minimal look derives its feel from clean living and the absence of clutter. More often than not some of the most effective examples are a result of considered design and top craftsmanship, although producing the simplest end result.

4. [http://www.hardwood.org/display\\_article.asp?ID=390](http://www.hardwood.org/display_article.asp?ID=390)

Furniture looks, elegant **simplicity** mark new styles in kitchen cabinetry

5. [http://www.contemporaryfurniture.com/Catalog/Products/product\\_00002644\\_33.asp](http://www.contemporaryfurniture.com/Catalog/Products/product_00002644_33.asp)

Sub-Category: Contemporary Bar Units - Modern Bars

Description : The Julia Ocean bar is an architectural approach to contemporary furniture styling. With it's sculptural **simplicity**, textural interest, and creative design this item sets itself apart from a crowd.

6. <http://www.counter-tops-edu.info/simplicity-counter-tops.html>

The **simplicity** and elegance of these 18” tops make them ideal for everything from breakfast to entertaining. A beautiful way to top off a functional space.

7. [www.counter-tops-edu.info/simplicity-counter-tops.html](http://www.counter-tops-edu.info/simplicity-counter-tops.html)

**simplicity** counter tops. kitchen, sinks, cooking, cabinets, counter,tops ... Cork Flooring. Counter Tops. Cupolas. Curtains ... Built for speed and **simplicity**, ...

8. [concrete-counter-tops-edge-mold.exixehi.info/](http://concrete-counter-tops-edge-mold.exixehi.info/)

... kitchen counter tops counter tops seattle structured into 6 **simplicity** counter tops granite counter tops march 9 martin luther king jr blvd categories. ...

9. [www.beautycraft.ca/products.htm](http://www.beautycraft.ca/products.htm)

We can produce vanity tops any shape, size and color you need. ... The elegant **simplicity** of a drop in bowl can add that special touch to any bathroom. ...

10. [www.netnewsdesk.com/.../index.cfm?fuseaction=ShowIssue&PID=850&ID=2945\\_10398,10224,3120,17947](http://www.netnewsdesk.com/.../index.cfm?fuseaction=ShowIssue&PID=850&ID=2945_10398,10224,3120,17947)

... with an emphasis on the **simplicity** and fluidity of design, as well as the ... The bathrooms are fitted with marble countertops, polished vanity tops and ...