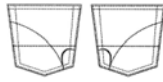


**TRADE MARKS ORDINANCE (CAP. 559)**

**APPLICATION NO.: 300536832**



**MARK:**

**CLASS: 25**

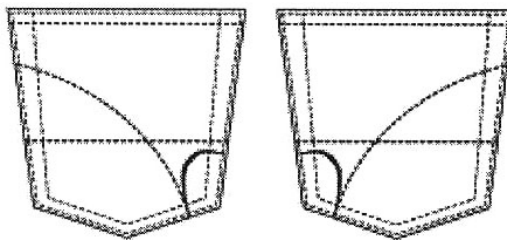
**APPLICANT: KABUSHIKI KAISHA RIGHT-ON (RIGHT-ON CO., LTD.)**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 25 November 2005, Kabushiki Kaisha Right-On (Right-On Co., Ltd.) (“the Applicant”) applied to register the mark shown below under the Trade Marks Ordinance (Cap.559) (“the Ordinance”).



2. Registration of the subject mark is sought in respect of the following goods in Class 25:

“clothing; jeans; T-shirts; polo shirts; sweat shirts; sweaters; sports jerseys; gloves; socks; belts; footwear; sports shoes; mountaineering boots; sandals; headgear; caps; hats.”

3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the basis that the subject mark was devoid of any distinctive character. The Applicant called for a hearing on the registrability of the subject mark which took place before me on 5 March 2008. 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.

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

### **The Ordinance**

5. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provision under section 11(1) reads as follows:

“(1) Subject to subsection (2), the following shall not be registered:-  
(a) ...;  
(b) trade marks which are devoid of any distinctive character;”  
...

### **Decision**

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

6. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character. The approach of assessing distinctiveness was discussed in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 where Mr. Justice Jacob stated, on 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?”

7. The European Court of Justice (“ECJ”) stated 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), 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 Tuský* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).”

8. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the goods for which the Applicant seeks registration. I must also have regard to how the subject mark is likely to be perceived by a consumer who is reasonably well-informed and reasonably observant and circumspect.
9. In the present case, the goods applied for cover various items of clothing, footwear and headgear. These goods are general merchandise. Therefore, their relevant consumers are essentially members of the general public in Hong Kong.
10. 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).

11. The subject mark consists of a two-dimensional representation of two side-by-side pockets with line stitching thereon. As shown in paragraph 1 above, the pocket stitching designs on the side-by-side pockets are mirror images.
  
12. When the subject mark is used in relation to the goods applied for, the average consumer is likely, upon first impression, to perceive the subject mark simply as stitched pockets or pocket-like stitching design. In relation to the applied for goods, in particular clothing, application of stitching designs to pockets is a usual and commonplace feature of them. On the market, there are a multitude of variations of arches, checks, swoops, waves and other linear stitching designs in use on pockets and to my mind, stitched pockets normally form part of the goods mainly as decorative or ornamental elements. This being so, in order to identify the trade origin of the goods, consumers are accustomed to relying on labels or tags bearing brand names of 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. The average consumers are not, in my view, in the habit of making assumptions about the trade origin of the applied-for goods on the basis of pocket stitching design.

13. Furthermore, the average consumers are used to seeing various kinds of embellishments including pocket stitching designs on different clothing items. These embellishments are intended to make the goods more appealing and attractive to potential consumers. Considering the subject mark in its totality, I find that it is more likely for the average consumer to perceive it merely as a decorative or ornamental feature of the goods. It is unlikely that the average consumer would see the subject mark as an indication of the origin of the goods in question, as similar kinds of decorative or ornamental feature may also appear on similar goods provided by other undertakings.
14. In the instant case, I have not overlooked that the applied-for specification is cast in broad terms. It covers not only outer garment such as jeans, T-shirts, polo shirts and sweat shirts of which the vast majority have pockets, but also other goods like gloves and belts 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 pockets and stitching patterns 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. Accordingly, I consider that the objection is also relevant in relation to these other goods.
15. Ms. Wan acknowledges 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 considers that stitching designs are more apparent and they more easily attract people's attention, as compared to labels, tags or packaging. Ms. Wan also contends that the stitching design in the subject mark is a distinctive part of the whole mark and that putting them on pockets does not undermine the registrability of the stitching design.

16. I am unable to accept Ms. Wan's submission. Even if the stitching design in the subject mark is eye-catching, it does not necessarily mean that it would be taken by consumers as an indication of trade origin. The crux of the matter is whether the stitching design would convey trade mark significance to the average consumers. For the reasons discussed above, I do not consider that the stitching design of the subject mark is distinctive in the sense that consumers would see it as a source identifier, i.e. indicating that goods bearing the mark originate from a particular undertaking. In my view, unless and until consumers are educated by use of the subject mark as trade mark, it is unlikely that they would attach trade mark significance to the subject mark.
  
17. Ms. Wan further submits 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 argues that those earlier registrations demonstrated the trend of using stitching designs on pockets as badges of trade origin. According to Ms. Wan, inasmuch as specially designed pocket devices can serve as a source identifier notwithstanding any decorative nature, consumers are conceivably well trained to check out these details to figure out the origin of goods.
  
18. 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.
  
19. I am, however, prepared to accept for the current purposes that many 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 mark in particular. In deciding whether a particular trade mark is distinctive for the purpose of registration, I must have regard to the consumers' 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 serve as a badge of origin.

20. And in saying this, I take note 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). 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 stated above, I am of the view that the Applicant has not made good 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 or ornamental feature of the goods applied for without any trade mark significance.
21. I therefore conclude that the subject mark does not fulfill the essential function of identifying the origin of the goods applied for and thus fail 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.

*Reference to other registered trade marks and foreign registration*

22. 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 mark was no less distinctive than the registered marks.
23. I have considered 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 fact, 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 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.

24. Ms. Wan further draws my attention to the fact that the subject mark has been accepted for registration in Japan, Laos, Mexico, Chile and Thailand.
  
25. However, 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 (*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 jurisdictions. As there are valid reasons for refusing the subject application, I should not simply follow the registration of other registries. This is especially so when the reasons and rationale behind the acceptance are not available before me.

## **Conclusion**

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

Jessica Law  
for the Registrar of Trade Marks  
14 August 2008