

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300567919

MARK : MOTHERHOOD

APPLICANT : CAVE SPRINGS, INC.

CLASS : 25

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 January 2006, Cave Springs, Inc. (“the applicant”) filed an application for the registration of **MOTHERHOOD** (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application is in respect of “clothing, footwear, headgear, and accessories of the aforesaid goods” in class 25. The applicant is represented by Messrs. Lovells (“the Agents”).
2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the grounds that the subject mark consists exclusively of signs which may serve to designate the characteristics of the goods applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.
3. The applicant requested a hearing on the registrability of the subject mark. The hearing was fixed to be held on 8 May 2008. The Agents filed Form T12 on 25 February 2008 and confirmed the applicant’s intention to attend at the hearing. On 5 May 2008, the Agents requested an adjournment of the hearing for two months to enable further evidence to be prepared and submitted in support of the application. The request was rejected and the Agents did not attend the hearing on 8 May 2008. Pursuant to rule 75(b) of the Trade Mark Rules (Cap.559, sub

leg), I now proceed to decide the matter without a hearing.

Grounds of refusal under section 11

4. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Subsections (1) and (2) are relevant here and they read as follows:

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

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
- (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; and
- (d) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Decision

5. The applicant has submitted a statutory declaration as evidence to establish that the subject mark has acquired distinctiveness through the use that has been made of it. I will deal with the *prima facie* case first before I turn to the evidence that has been filed. I will start off with the objection under section 11(1)(c).

Inherent registrability – Section 11(1)(c)

6. The subject mark is the word “MOTHERHOOD” in plain capital letters. As noted at the examination stage, the word “MOTHERHOOD” means “mothers considered as a group” (*The American Heritage Dictionary of the English*

Language Fourth Edition), “the state of being a mother” and “the qualities characteristic of a mother” (*Collins English Dictionary Millennium Edition*). When used in respect of clothing, footwear, headgear and accessories of such goods, the subject mark merely indicates that the goods are for mothers and/or maternity wear. As the subject mark consists exclusively of signs that may serve to designate the characteristic of the goods in question, it is precluded from registration by section 11(1)(c) of the Ordinance.

7. The Agents suggested that “motherhood” was not a common term used to describe the goods in question. It was argued that for a mark to be descriptive, it had to directly describe the products or services or their characteristics and that no one would relate the word “MOTHERHOOD” with clothing, footwear, headgear and accessories of such products. Further, according to the Agents, the term “MOTHERHOOD” is not used by traders to describe any of the goods applied for.
8. In addition, reliance was sought on the discussions of the effect of section 3(1)(c) of the UK Trade Marks Act 1994 (which is similar to section 11(1)(c) of the Ordinance) in the case of the opposition against the registration of “SUIT EXPRESS” in class 25 and the decision of the Third Board of Appeal of OHIM in the *NETMEETING* case (Case R 26/1998-3). In particular, attention of the Registrar was drawn to the distinction drawn between a “descriptive” mark and an “allusive” or “suggestive” mark in the *NETMEETING* case where an “allusive” mark was said to be one that made reference in an indirect way to certain characteristics of the products or services or when a mental effort was required from consumers in order to transform a suggestive or emotional message into a rational evaluation.
9. In the first place, whether other traders use the word “MOTHERHOOD” in relation to their own goods is not a determining factor. The use of the word “may” in section 11(1)(c) of the Ordinance should be noted and a mark may be precluded from registration even if it is not actually used by the trade in question. On this point, the decision in the case of *Wm. Wrigley Jr. Company v OHIM* (the “*DOUBLEMINT*” case) (Case-191/01 P) is relevant. The case concerns the interpretation of Article 7(1)(c) of Council Regulation (EC) No. 40/94 which is broadly similar to section 11(1)(c) of the Ordinance. The European Court of

Justice had this to say in the “*DOUBLEMINT*” case –

“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 provision itself indicates, that such signs and indications could be used for such purposes.”

Thus, so long as the mark may be perceived by the relevant class of persons as descriptive of one or more characteristics of the goods and services in question, it does not meet the requirements of section 11(1)(c).

10. In the *SUIT EXPRESS* case referred to by the Agents, two messages that may be conveyed by the mark “SUIT EXPRESS” were considered. The message about finding the customer a suit to his or her requirements was considered at most allusive of a style of retail operation, whereas the possible designation of a characteristic of ‘made to measure’ suits was considered a description of tailoring services but not of tailored clothes. Since the application in that case was in respect of clothing in class 25 and not for retail operation services or tailoring services, the opposition on ground that the mark should not have been registered under section 3(1)(c) of the UK Act was held to be unsuccessful.
11. In the present case, the application for registration is in respect of goods in class 25. Unlike the “SUIT EXPRESS” mark which would be descriptive of services like the retailing of suits or tailoring services but not the suits being sold, the word “MOTHERHOOD” here is directly descriptive of the goods applied for, that is, clothing, footwear, headgear and accessories of such products, since it designates the characteristic that the goods are intended for pregnant women and mothers. I therefore do not find the *SUIT EXPRESS* case to be of assistance to the present application.
12. With the *NETMEETING* case, although the court in the case drew a distinction between “descriptive” marks and “allusive” marks, it clearly mentioned (at

paragraph 25) that allusive or suggestive marks were not always and *per se* eligible for registration. Furthermore, after taking note of the appellant's interpretation that the word "meeting" should be restricted to physical meetings as well as the examiner's interpretation that virtual meetings should also be included, the court found it not necessary to decide which should be the correct interpretation. It based its decision on the ground that the combination of the words "net" and "meeting" did not suggest a direct correlation with the specific goods of interest in that case which were computer programs for providing communications over computer networks. It is clear therefore that the court was of the view that since the goods were for general communication purpose rather than meeting, whether physically or in a virtual perspective, the mark was not descriptive.

13. The present application is not in the same league. The message conveyed by the subject mark is not merely allusive or suggestive of a characteristic of the goods applied for. The word "MOTHERHOOD" relates directly to mothers and is thus descriptive of goods intended for mothers or mothers-to-be. The message of the subject mark is loud and clear and it relates directly to the goods under application. The relevant consumers do not have to engage in any mental effort to decipher the meaning of the subject mark. They will immediately know that the goods on which the subject mark is applied are clothing, headgear, footwear and accessories of such goods for pregnant women and mothers.
14. Since there are no other elements apart from the word "MOTHERHOOD", for the reasons stated above, I find the subject mark to consist exclusively of a sign that may serve to designate a characteristic of the goods applied for. The subject mark is therefore precluded from registration by section 11(1)(c) of the Ordinance.

Inherent registrability – Section 11(1)(b)

15. The applicable test for considering whether a mark has any distinctive character has been considered in many UK cases. In the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, Jacob J (at 306) set out the test as follows -

“What does devoid of 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?”

16. The following discussion on the assessment of distinctiveness in the *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23) is also often relied on –

“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.”

17. In assessing the distinctiveness of a mark, the question to consider is whether the mark will be perceived as a badge of trade origin and not whether other traders would want to use it for their own goods. The assessment is to be carried out in respect of the subject mark, with reference to the goods of the class for which registration is sought, as well as the consumers of those goods, who are reasonably well informed and circumspect.
18. As pointed out in the above, upon seeing the subject mark being used on clothing, footwear, headwear, and accessories of the aforesaid goods, consumers of such goods will merely regard it as a designation of the kind of clothing, footwear, headgear and accessories. It is therefore not the sort of signs that can do the job of distinguishing the goods of the applicant from those of other suppliers without the consumers first being educated that it is a trade mark. The subject mark is hence also precluded from registration under section 11(1)(b) of the Ordinance.
19. Besides seeking reliance on the “*SUIT EXPRESS*” and “*NETMEETING*” cases, the Agents submitted that a mark should only be rejected as “devoid” of distinctiveness if it completely lacked distinctive character. This, they argued, was not the case with the subject mark. It was their suggestion that, taking into account the goods covered by the application, the subject mark could clearly

distinguish the applicant from the other traders in the market.

20. In view of the overall impression that consumers of the goods applied for will have of the subject mark, I cannot accept that the subject mark has the capability to distinguish the goods of the applicant from those of other traders. The message conveyed by the subject mark about the kind of clothing, footwear, headgear and accessories being supplied is clear and direct. Consumers of such goods will not realize that the subject mark is intended to identify the goods as originating from a particular undertaking, without their being first educated of its trade mark significance. I therefore find the subject mark to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods applied for.

Acquired distinctiveness

21. According to section 11(2) of the Ordinance, a mark would not be refused registration under section 11(1)(b) or (c) if it has in fact acquired distinctiveness as a result of the use that has been made of it. The applicant has submitted a statutory declaration of Ronald Masciantonio (“the RM Declaration”). I shall consider whether the subject mark is shown to have indeed acquired a distinctive character through use.
22. A statement of the relevant principle on acquired distinctiveness can be found in the case of *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger* [1999] E.T.M.R. 585. The case is concerned with Article 3(3) of the First Council Directive 89/104/EEC which is broadly similar to section 11(2) of the Ordinance. The Court of Justice of the European Communities said in that case, at paragraph 54 –

“...a trade mark acquires distinctive character following the use which has been made of it where 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.”

23. Thus, to establish the acquisition of distinctiveness, the applicant has to show that the subject mark has, because of the use made of it, come to identify the

goods applied for as originating from the applicant. Such use has to be carried out prior to the date of filing of this application, that is, 19 January 2006.

24. In paragraphs 4-8 of the RM Declaration, the applicant sought to explain its background, the founding of a retail catalog business and the line of products being offered via the online and telephone purchase services provided, as well as the retail stores in USA, Puerto Rico and Canada. Materials in support were submitted as exhibits RM-1, RM-2, RM-3, RM-4, RM-5, RM-6 and RM-7. All these exhibits show materials dated after the filing date and hence cannot be taken into account in assessing whether the subject mark has acquired distinctiveness.
25. One thing to note is that the RM Declaration has made no mention about the advertising expenditure incurred for the promotion of the subject mark at all, whether in Hong Kong or worldwide. Also significant is the lack of any materials that pre-date the date of filing of this application which show actual use of the subject mark on any of the goods applied for. Nonetheless, I still have to consider whether the applicant has made out a case of acquired distinctiveness from the limited information that is contained in the RM Declaration.
26. Sales figures are available. According to paragraph 9 of the RM Declaration, "Motherhood" is a well known brand name for maternity fashion in Hong Kong and customers in Hong Kong have been purchasing "Motherhood" products online since February 2001. A list of the orders placed by customers in Hong Kong for "Motherhood" products since February 2001 can be found in exhibit RM-8 while the details of the customers who have purchased "Motherhood" products as of 8 January 2007 can be found in exhibit RM-9.
27. The subject mark is not actually shown in the two lists in exhibits RM-8 and RM-9. They cannot therefore support use of the subject mark as applied for on the goods in question. More importantly, even if the two lists do actually relate to the sale of the applied-for goods under the subject mark, the sales recorded by them can hardly be considered extensive. The currency of the sale figures shown in the list in exhibit RM-8 is not indicated. Even if the amounts are in US dollars, the number of orders received from customers in Hong Kong from February 2001 to 19 January 2006, the date of filing, is only 231 and the total of

such sales is around US\$43,000. That means an average of less than US\$9,000 a year. As regards the number of customers in Hong Kong, since the list in exhibit RM-9 is made up to 8 January 2007 and there is no indication of the date when each customer first placed an order with the applicant, the number of Hong Kong customers as at the date of filing cannot be ascertained. Nevertheless, even assuming that all the customers included in the list became customers prior to the date of filing, the number is only 61.

28. In paragraph 10 of the RM Declaration, reference is made to the sale of “Motherhood” products in Hong Kong from Ebay Hong Kong. Exhibit RM-10 with printouts from <http://www/ebay.com.hk> showing “Motherhood” products available for online purchase in Hong Kong is presented in support. There is no information about the number of customers who have accessed the website and materials in the exhibit RM-10 are dated after the filing date of this application. The materials therefore do not show that there had been use of the subject mark in relation to the goods applied for in Hong Kong on or before the date of the filing of this application.
29. One other exhibit mentioned in paragraph 10 of the RM Declaration is exhibit RM-11, which is meant to show the name of the Hong Kong company that handles manufacturing of garments for the “Mothers Work” brand. The materials were downloaded from the website of the Trade Development Council. These materials are dated after the filing date of this application and they do not show the use of the subject mark on the goods applied for. I do not find such materials to be relevant.
30. After a review of all the materials in the RM Declaration, including the exhibits, regarding the sales turnover, it is clear that, taken at its highest, the sales generated by the applicant from the sale of clothing, footwear, headgear and accessories of the aforesaid goods in Hong Kong are insubstantial. The extent of sales can hardly be sufficient for establishing that the relevant consumers in Hong Kong have been educated that the subject mark is intended to show the trade provenance of the goods applied for.
31. The only other matters covered by the RM Declaration are the registration of the subject mark in other jurisdictions including USA, Canada, France and Italy.

Details of these foreign registrations are set out in paragraph 12 of the RM Declaration and the various exhibits referred to. As some of the documents in the exhibits are not in English or Chinese, details about some of the registrations are not fully available. In any event, the reasons for the acceptance of the marks in those places are not known to me. I therefore do not consider these registrations to be of assistance to this application.

32. Having considered all the evidence filed, I am not satisfied that the subject mark has, as at the date of the filing of this application, come to identify “clothing, footwear, headgear, and accessories of the aforesaid goods” as originating from a particular undertaking. The applicant therefore has failed to establish that the subject mark has acquired a distinctive character through the use that has been made of it.

Conclusion

33. I have considered all the documents filed by the applicant, including the evidence filed and all written submissions made in respect of the application. For the reasons stated above, I find that, in respect of the goods applied for, the subject mark is, contrary to section 11(1)(b) and (c) of the Ordinance, devoid of any distinctive character and it consists exclusively of signs that may serve, in trade or business, to designate the characteristics of such goods. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow
for Registrar of Trade Marks
08 August 2008