

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

**APPLICATION NO. : 300603288**

**MARK :** 

**APPLICANT : HUGO BOSS TRADE MARK MANAGEMENT  
GMBH & CO. KG**

**CLASS : 25**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 20<sup>th</sup> March 2006, Hugo Boss Trade Mark Management GmbH & Co. KG (“the Applicant”) of Germany applied to register the mark shown below under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”). The Applicant claims priority from a German Trade Mark application no. 30564269 dated 26<sup>th</sup> October 2005.



2. Registration of the subject mark is sought in respect of the following goods in Class 25 (“the goods applied for”):-

Class 25

Articles of clothing for ladies, gentlemen and children; socks and stockings; headgear; underwear; nightwear; swimwear; bathrobes; belts; scarves and shawls; accessories, namely head scarves, neck scarves, shoulder scarves, pocket kerchiefs; ties; gloves, shoes and boots.

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. Upon the request of the Applicant, a hearing on the registrability of the subject mark took place before me on 25<sup>th</sup> July 2007, at which Ms. Jung Soo Lee, Counsel instructed by Twiggy MH Liu Law Office 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 in this application. I therefore have only the *prima facie* case to consider.

### **The Ordinance**

5. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 read 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. Under section 11(1)(b) of the Ordinance, a sign is precluded from registration if it is devoid of any distinctive character. To consider whether a mark is devoid of a distinctive character, Mr. Justice Jacob stated in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 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. Further to the above principle, in assessing the distinctive character of a sign under Article 3(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 (the provision of which is equivalent to section 11(1)(b) of the Ordinance), the Court of Justice of the European Communities (“ECJ”) in *Linde AG v. Deutsches Patent-und Markenamt* [2003] R.P.C. 45 stated that:

“40. For a mark to possess distinctive character within the meaning of [section 11(1)(b)] 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.

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 case law, 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.”

8. Referring to *British Sugar Plc v James Robertson & Sons Ltd* (supra) at the hearing, Ms. Lee submitted that to be “devoid of any distinctive character”, the mark in question must be incapable of distinguishing goods originating from one particular undertaking from those of other undertakings without first educating the public that it was a trade mark. In light of the comments of the ECJ above, Ms. Lee rightly pointed out that the distinctiveness of the mark must be assessed by reference to the goods for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.
9. To assess the distinctiveness of a mark, I further remind myself that the criteria for assessing the distinctive character of a sign which consists of a device in the form of a stitching pattern, such as the subject mark, are no different from those to be applied to other types of mark.
10. Having said that, however, as the ECJ has observed in *Henkel KGAA v Deutsches Patent –und Markenamt* [2005] ETMR 45, paragraph 52:

“The perception of the relevant public is not necessarily the same in the case of a three-dimensional mark, consisting of the packaging of a product, as it is in the case of a word or figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three-dimensional mark than in the case of a word or figurative mark.”

Although the comments of the ECJ above were in respect of a mark which consisted of a three-dimensional representation of the packaging of a product, I find the comments to be relevant in the subject application, in which the mark consists of a device in stitches. In respect of the goods applied for, which cover clothing, accessories, headgear and footwear, stitching is undoubtedly a staple feature which the consumers are used to seeing on the goods applied for.

11. According to Ms. Lee, the subject mark comprises of two semi-solid lines forming a pair of ducks or geese swimming side by side. To me, the subject mark consists of a device resembling the stitching outline of a duck with an open beak. Despite the different ways of describing the subject mark, I do not consider the difference to be of significance in assessing the distinctiveness of the mark in respect of the goods applied for.
12. To assess the distinctive character of the subject mark, I should consider it from the perspective of the average, relevant consumers of the goods applied

for, which cover a wide range of clothing articles including clothes, headgear and footwear. At the hearing, Ms. Lee submitted that because the Applicant intended to promote the subject mark as a fashionable brand under the brand of Hugo Boss, the relevant consumers would be those who were relatively sophisticated and fashion-conscious. In my mind, the goods for which registration is sought are general merchandises. Therefore, the relevant consumers are essentially members of the general public in Hong Kong. While I consider that the relevant consumers are reasonably well-informed, observant and circumspect, I do not find them to be any more “sophisticated and fashion-conscious” than the average members of the general public.

13. In terms of clothes and accessories such as those applied for, it is common to have patterns printed or stitched on the articles themselves as decorations or embellishments. The average, relevant consumers of the applied for goods would be accustomed to seeing such goods decorated with a wide variety of designs or patterns to make the goods attractive to potential customers. In my mind, the relevant consumers are generally not used to perceiving a pattern on the articles of clothing as an indication of trade origin. It is unlikely that they would rely on a decorative feature such as a stitching design to identify the origin of goods, as similar design feature may also appear on similar goods provided by other undertakings.
  
14. Upon seeing the subject mark in respect of the goods applied for, an average consumer would perceive the subject mark merely as a decorative stitching design on the article of clothing. The relevant consumers are often exposed to the use of designs similar to the subject mark by different undertakings on their products as decorations or embellishments that do not indicate a particular trade origin. I do not find it likely that, without first being educated, the relevant consumers would rely on the mark alone to identify a particular undertaking from which the goods originate. Indeed, as Ms. Lee stated in paragraph 12 of her written submissions, “the Applicant intends to place the [subject mark] on items of clothing and marketed as a fashionable brand, under the brand Hugo Boss”. Ms. Lee’s submission and the Applicant’s intended promotion of the subject mark under the distinctive mark Hugo Boss reinforced my view that the subject mark, in its own right, does not fulfil the essential function of a trade mark, which is succinctly stated by the ECJ in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. & Another* [2003] Ch. 159 at 173 as:-

“...the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin...”

15. At the hearing, Ms. Lee submitted that the subject mark was unique, simple and easily recognisable and therefore the mark was capable of identifying the Applicant’s goods. I do not consider this argument to be of much force. In assessing the distinctiveness of a mark, the critical consideration is whether the relevant consumers would perceive it as an identifier of goods originating from a particular undertaking. A unique, simple and easily recognisable mark is not necessarily distinctive in the sense that the relevant consumers would rely on it alone to distinguish goods of one particular undertaking from those of other origins. For reasons stated in paragraphs 13 and 14 above, I do not consider that the relevant consumers, upon seeing the mark on the applied for articles of clothing, would perceive the mark as a badge of origin, guaranteeing that the goods originate from a particular trade source.

16. In support of her submission that the distinctiveness required of a mark to be registrable was minimal, Ms. Lee quoted from the decision of the Court of Appeal in *West (t/a Eastender) v Fuller Smith & Turner Plc.* [2003] F.S.R. 44, paragraph 27, at which Pumfrey J. commented on the principles summarized by the judge in *Wrigley (Wm) v OHIM (“DOUBLEMINT”)* [2001] E.T.M.R. 58:

“(i) Sections [11](1)(b), (c) and (d) are not designed to exclude from registration marks which merely possess an indirect descriptive connotation: the words ‘devoid of any’ in sub-section (b) and ‘exclusively’ in (c) and (d) are to be given effect to;  
(ii) the fact that some mental activity is necessary in order to discern a reference to the quality of or a characteristic of the goods may assist in its registrability;  
(iii) uncertainty as to the precise nature of the reference to the quality or character of the goods will also assist;  
(iv) marks which can only refer directly to the quality or character of the goods (BITTER for beer would be an example) must be refused registration. This is because such a mark does not ‘differ from the usual way of designating the goods or their characteristics’ and because it may ‘serve in normal usage from a consumer’s point of view to designate either directly or by reference to one of their essential characteristics’ the relevant goods.”

17. I have considered the above passage quoted by Ms. Lee but I do not consider that it assists the Applicant in the subject application. Although the subject mark makes no direct reference to the quality or other descriptive connotations

of the goods applied for, it does not mean that the mark has a distinctive character. As explained in paragraphs 13 and 14 above, the relevant consumers would perceive the mark, which is essentially a pattern in stitches, as a decorative design on the articles of clothing, headgear, footwear and accessories. Without first educating the public of the trade mark significance, the mark is not the sort of sign that the average, relevant consumers would rely on alone to identify a particular undertaking from which the goods originate. The subject mark is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

*Other registered marks on the register*

18. Ms. Lee referred me to a couple of marks comprising dotted lines as well as numerous marks consisting of device only that had been registered in respect of clothing in Hong Kong on a *prima facie* basis. In her view, the registered marks comprising dotted lines (registration nos. 300115073 and 300374274) were comparable to the subject mark. I have reviewed the registrations quoted by Ms. Lee but I consider that they are different from the subject mark and are not on par with the subject application. It should be noted that there is no provision under the Ordinance, nor is there any general principle that precludes devices in stitching form from being registered. To this end, I would add that a sign may indeed serve more than one purpose. That is to say, a sign can serve the purposes of being a decoration and an indication of trade origin at the same time. However, as explained above, I consider that the subject mark in respect of the goods applied for is perceived by the relevant consumers as nothing more than decorative embellishment or design. It is for the Applicant to demonstrate that on top of the decorative purpose, the subject mark has come to serve as a badge of origin, something which the Applicant has failed to show. In any event, I do not think that it is appropriate to make direct comparison between different marks on the register. Each case must be considered on its own merits. This issue has been discussed in *British Sugar Plc* (supra):-

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

19. There are valid reasons for refusal and I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the

Applicant in overcoming the objection raised under section 11(1)(b) of the Ordinance.

### **Conclusion**

20. I have considered all the documents filed by the Applicant and all the submissions advanced in relation to the subject application. For the reasons given, I find that the mark is precluded from registration under section 11(1)(b) of the Ordinance, the subject application is therefore refused under section 42(4)(b) of the Ordinance.

Margaret K.W. YU  
for Registrar of Trade Marks  
7<sup>th</sup> November 2007