

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300619498

MARK : A INSIDE
B Inside
: C inside

**APPLICANT : YOKOHAMA GOMU KABUSHIKI KAISHA (THE
YOKOHAMA RUBBER COMPANY LIMITED)**

CLASS : 28

STATEMENT OF REASONS FOR DECISION

Background

1. On 13th April 2006, Yokohama Gomu Kabushiki Kaisha (The Yokohama Rubber Company Limited) (“the Applicant”) of Tokyo, Japan applied, pursuant to the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register a series of three marks shown below (collectively referred to as “the subject marks”):-

A INSIDE
B Inside
C inside

2. Registration of the subject marks in series is sought in respect of “golf clubs” in Class 28.
3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance, on the basis that the subject marks were devoid of any distinctive character. By a letter dated 30 August 2007, the Applicant requested a hearing on the registrability of the subject marks. The hearing was scheduled to take place before me on 15th February 2008. Ms. Ellen Wan of China Patent Agent (H.K.) Ltd. appeared for the Applicant at the hearing.

4. Although Ms. Wan submitted printouts of pages in the magazine “China Golf” at the hearing, such materials were not filed by way of a statutory declaration or affidavit and thus they were not filed in accordance with the requirement of rule 79 of the Trade Marks Rules, Cap.559A¹. As there has been no evidence of use put before me in support of the subject application, I have, therefore, 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 provisions under section 11(1) 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;
 - (c) ...;
 - (d) ...”

Decision

6. Under section 11(1)(b) of the Ordinance, a sign is precluded from registration if it is devoid of any distinctive character. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, Mr. Justice Jacob said:

“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, Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2 , at 26 stated that:

“The distinctiveness to be considered is that which identifies a product

¹ Rule 79 of the Trade Marks Rules provides:

“(1) Where under the Ordinance or these Rules evidence may be admitted by the Registrar in any proceedings before him, the evidence shall be filed by way of a statutory declaration or affidavit.”

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.”

8. In interpreting Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, to which section 11(1)(b) of the Ordinance is similar, the European Court of Justice stated in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch.1 at 11, paragraph 34:-

“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect.”

9. In view of the above legal principles, distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it in Hong Kong prior to the date of application, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. 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.
10. Additionally, when assessing the distinctiveness of the subject marks, I must consider the context in which the subject marks are used in respect of the goods applied for. The use of a mark in respect of the relevant goods includes applying it on the goods or their packaging.
11. The goods for which registration is sought are golf clubs. The relevant consumers are thus members of the general public in Hong Kong who are looking for golf clubs, either for themselves or for others. Broadly speaking, golf clubs come in many different types with a great variety of materials and

designs for the shafts and putters to cater for the specific needs and shot range of different players. In the circumstances, those who are not into golf, or who know very little about the game would find it very difficult to choose and purchase suitable golf clubs. Furthermore, golf clubs are often expensive. People who know very little about the game or the different types of golf clubs are thus less likely to purchase them, seeing the risk of picking the unsuitable but pricey golf clubs. In the premises, I consider the relevant consumers to be people who are themselves golf players or into the golf, and reasonably familiar with the game, its rules and jargons.

12. The subject marks consist of the word “inside”. In golf games, “inside” is a term that is “descriptive of the ball closest from the hole, or of the golfer whose ball it is”². At the hearing, Ms. Wan did not dispute such meanings of “inside” in relation to golf games, but she submitted that “inside” was not a generic term or common for golf clubs. According to Ms. Wan, “inside” was a commonly used word in many industries which would not remind people of any characteristic or purpose of the goods for which registration is sought.
13. I find Ms. Wan’s submissions to be of little assistance. As the distinctiveness of a sign must be assessed by reference to the goods for which registration is sought and the perception of the relevant consumers, the fact that the subject marks are widely used or carry other meanings in other industries or context bears no relevance to how the subject marks would be perceived by the relevant consumers in relation to golf clubs. Ultimately, a mark with a distinctive character is the sort of sign that allows the relevant consumers to identify a particular undertaking from which the goods in question originate. A sign which does not “remind the people of the characteristics or purpose” of the goods in question is not necessarily distinctive as a trade mark.
14. Upon seeing the subject marks being applied on golf clubs, their packaging or promotional materials such as advertisements or leaflets, the relevant consumers, whom I consider to be reasonably familiar with the jargons of golf games, would perceive the subject marks as a reference to the preferred or favourable condition of having the ball closest to the hole. Beyond this obvious meaning, there is nothing about the word “inside” that might enable the relevant consumers to memorize the sign easily and instantly as a distinctive trade mark for the goods designated.

² *Hickok Sports Glossaries* at <http://www.hickoksports.com/glossary/ggolf.shtml>

15. Where a sign does not immediately indicate the origin of products, but merely give out some abstract information, the average consumers are not very attentive in the sense that they will not take the time to enquire into the sign's various possible functions or mentally register the sign as a trade mark (see *Sykes Enterprises Inc. v Office for Harmonisation in the Internal Market (REAL PEOPLE, REAL SOLUTIONS)*, European Union Case T-130/01, judgement of the Court of First Instance of 5 December 2002, [2002] E.C.R. II-5179).
16. On first impression, the subject marks convey the abstract concept of having the ball closest to the hole. I am not satisfied that without first educating the relevant consumers, the relevant consumers would regard the subject marks as an indicator identifying a particular undertaking from which the golf clubs originate. In the context of golf clubs for which registration is sought, the subject marks fail to perform the essential function of a trade mark, which is to guarantee the identity of the origin of the marked products to the consumer by enabling him to distinguish the products from others which have another origin.
17. For the reasons stated above, I find that each of the subject marks is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Another registered mark on the register and foreign registrations

18. At the hearing, Ms. Wan pointed out that the same word "INSIDE" has been registered in Class 5 on a *prima facie* basis in Hong Kong, which shows that the subject marks are inherently registrable. I have considered the registration in Class 5 (registration no. 300381311), which is registered in respect of:-

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

19. Unlike the subject application, "INSIDE" does not carry any specific meaning in respect of the goods covered by the registration and I do not find the

registration to be comparable to the subject application. 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.”

20. In the subject application, there is a valid ground for refusal and I am not convinced that the registration of another mark in Hong Kong is of any assistance to the Applicant in overcoming the objection.
21. Ms. Wan also submitted that the subject marks had been registered in two other jurisdictions in Asia, asserting that the subject marks were equally registrable in Hong Kong. It must be noted that 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, where there is a valid ground for refusal under the Ordinance. Despite the foreign registrations of the subject marks, I am not convinced that the subject marks should be accepted for registration in light of the reasons for the objection stated above.

Conclusion

22. In this decision, I have carefully considered all of the submissions, both oral and written, made by and on behalf of the Applicant. For the reasons given above, I consider the subject marks are 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.

Margaret K.W. YU
for Registrar of Trade Marks
5th August 2008