

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300702387AB



MARK:

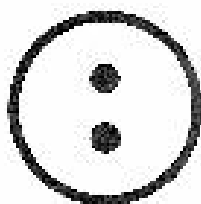
APPLICANT: ithk tm limited

CLASSES: 18, 24, 25 and 35

STATEMENT OF REASONS FOR DECISION

Background

1. On 16 August 2006, ithk tm limited (“applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“Ordinance”), to register the following mark (“subject mark”) :



2. Registration of the subject mark is sought in respect of the goods and services in classes 18, 24, 25 and 35 respectively as set out in the Annex.
3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the grounds that the subject mark consists of a sign that is devoid of any distinctive character in respect of the applied for goods and services.
4. A hearing on the registrability of the subject mark took place before me on 25 March 2008. Ms Milla Cheung of Messrs. Robin Bridge & John Liu appeared on behalf of the Applicant.
5. The applicant did not file evidence of use of the subject mark. I therefore have only the *prima facie* case to consider. I reserved my decision at the end of the hearing.

The Ordinance

6. The absolute grounds for refusal of an application for registration are contained 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

7. Section 11(1)(b) of the Ordinance (“section 11(1)(b)”) excludes from registration signs which are devoid of any distinctive character. The test for distinctiveness was discussed in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 where Jacob J said, 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?”

8. The approach of assessing distinctiveness was further discussed in *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 at para. 23:

“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 and services of the class for which registration is sought and consumers of those goods and services. In relation to the consumers of those goods and services the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers.”

9. With reference to the above legal principles, distinctive character under section 11(1)(b) means the mark, assuming no use of it, must be capable of identifying the goods and services as originating from a particular trade source, and thus distinguishing it from those of the others. The distinctiveness of the subject mark must be assessed in respect of the goods and services for which the applicant seeks registration and from the perspective of an average consumer who is reasonably well-informed, observant and circumspect.

10. The goods for which registration are sought cover a broad variety of goods in classes 18, 24 and 25, among them are clothing, headgear and footwear made of various materials and for different functional purposes (“objectionable goods”). The services sought for registration are retailing, wholesaling, ordering and distributorship services for or related to the objectionable goods, and other goods as well. The average, relevant consumers seeking these general merchandise and services are essentially members of the general public.
11. In assessing the distinctive character, I further remind myself that section 11(1)(b) does not distinguish between different categories of trade marks, and that the same test of distinctiveness applicable to other categories of trade marks should be applied to a figurative or device mark, such as the subject mark.
12. The subject mark is a two-dimensional representation of a circle with two circular dots in the middle, without any word on it.
13. Ms Cheung submitted that the subject mark involved an abstract, fanciful design and comprised an arbitrary combination of a circle and two dots. Ms Cheung contended that the examiner has extrapolated, by claiming that consumers would regard the subject mark as a button device, beyond a fair and normal view of the subject mark as a whole in the context of the applied for goods and services. Ms Cheung stated that the subject mark was particularly memorable and distinctive because of its strong, simple lines and the strikingly clear impression that it gave. Ms Cheung was of the view that the subject mark was an indication of commercial origin and thus be capable of distinguishing.
14. I do not concur with Ms Cheung’s submissions that the selection of the subject mark is abstract, fanciful or arbitrary. Considering the subject mark applied for, I find it to be nothing more than a simple representation of a fairly ordinary round button, which one may call it a button device. To my mind, the average consumers are generally accustomed to seeing similar sort of button device appearing on the objectionable goods as decorations and embellishments and are not used to regarding such sign as denoting trade origin. I consider the use of a button device in respect of the objectionable goods is not distinctive per se. Without first being educated, the average consumers are unlikely to rely on the subject mark alone as a badge of trade origin for identifying the objectionable goods as originating from a single undertaking.

15. At the hearing, Ms Cheung emphasized that the Registrar has not raised objection under section 11(1)(c) of the Ordinance and therefore the subject mark had no directly descriptive connotations that are capable of preventing it from being registered and stressed that the goods and services applied for did not include buttons under class 26. Ms Cheung added that the subject mark would not be adopted by other traders without improper motive and that it was not required for use by other traders.
16. I am not persuaded by Ms Cheung's submissions. Even if the subject mark is not descriptive and not required for use by other traders, this does not mean that the mark is distinctive. The crux of the test in considering distinctive character under section 11(1)(b) is whether the relevant consumers will perceive the subject mark first and foremost as an identifier of the goods originating from a particular undertaking.
17. Ms Cheung referred me to *Eurocool Logistik v OHIM (Eurocool) (Case T-34/00 [2002] ECR II-683, paragraph 39* and stated that a mark only has to possess a "minimum" degree of distinctiveness to render it to be free from an objection under section 11(1)(b). Ms Cheung further quoted 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.”.
18. I have considered the cited cases and the above passage quoted by Ms Cheung but I do find that they are of assistance to the subject application. It is well established that whether the required degree of distinctiveness is described as minimal or otherwise, a sign must as a whole perform the essential function of distinguishing the applicant's goods or services “from those having a different

commercial origin” (see *Eurocool, paragraph 51*). As concluded in paragraph 14 above, the subject mark as a whole is nothing more than a simple representation of a button. The subject mark would be perceived by the relevant consumers as a button device: the sort of decoration or embellishment which they usually see on the objectionable goods. The use of a device in the form of a button in the context of the objectionable goods does not create any distinctive character in the sense that it would enable the relevant consumers to identify the objectionable goods. The subject mark fails to perform the essential function of a trade mark, in relation to the objectionable goods, in guaranteeing the identity of the origin by enabling the relevant consumers, without any possibility of confusion, to distinguish the objectionable goods from those of the others.

19. Based on the reasons stated above, I consider the subject mark is devoid of any distinctive character and is thus precluded from registration in respect of the objectionable goods in classes 18 and 25 under section 11(1)(b). Goods set out in the specification of the subject application which fall into the categories of the objectionable goods as discussed above are listed below:

Class 18

Clothing for pets.

Class 25

Clothing, headgear, footwear, articles of outerclothing and underclothing, suits, stockings, tights, pantyhose, shirts, T-shirts, tank tops, blouses, trousers, skirts, articles of fancy dress, dresses, dressing gowns, evening gowns, jackets, overalls, waistcoats, fur coats, leather coats, raincoats, sports coats, suit coats, top coats, knitted articles of clothing and articles of clothing made from knitted materials, ties, bath robes, articles of sports clothing, sleepwear, hats, socks, belts, scarves, gloves, caps, aprons, jeans, neckwear, swimwear, belts (clothing), athletic footwear, athletic shoes, golf shoes, clogs, slippers; all included in Class 25.

Reference to other overseas registrations

20. Ms Cheung drew my attention to the acceptance of the subject mark for registration in classes 18, 25 and 35 in South Korea and Australia respectively. I have considered these overseas registrations. 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

21. In this decision, I have carefully considered all the written and oral submissions made in relation to this application. On a *prima facie* basis, I find that the subject mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the objectionable goods. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of the objectionable goods.

22. I do not take objection to items other than the objectionable goods as set out in paragraph 19, nor do I take objection to the services sought for registration. The application for registration in respect of those goods and services can proceed to publication provided that the applicant files, on or before **4 September 2008**, a request for amendment of the subject application on Form T5A to restrict the specification to those goods and services. If the applicant fails to do so on or before the stipulated date, it shall be deemed to have abandoned the application.

Vivien LUK
for Registrar of Trade Marks
4 August 2008

Class 18

Clothing for pets, collars and covers for animals, accessories for pets including leather leads, tethering articles of leather or imitations of leather; collars of leather and its imitations; leather chews and bits; harnesses; leather and imitations of leather and goods made of these materials, animal skins, trunks and travelling bags, umbrellas, parasols, walking sticks, luggage, bags, cases, vanity cases, suitcases, handbags, shoulder bags, purses, clutch bags, shoulder bags, tote bags, backpacks, rucksacks, shooting sticks, briefcases, attache cases, document holders and cases made of leather or imitations of leathers, holdalls, pochettes, suit carriers, credit card cases and holders, key cases, coin purses, passport holders made of leather or imitations of leather, cheque book holders, spectacle cases (not adapted) made of leather or imitations of leather, pen pouches, diary covers made of leather or imitations of leather, travel organisers made of leather or imitations of leather, tie holders made of leather or imitations of leather, key fobs made of leather or imitations of leather, wallets, parts and fittings for all the aforesaid goods; all included in Class 18.

Class 24

Textiles and textile goods, not included in other classes; bed and table covers; all included in Class 24.

Class 25

Clothing, headgear, footwear, articles of outerclothing and underclothing, suits, stockings, tights, pantyhose, shirts, T-shirts, tank tops, blouses, trousers, skirts, articles of fancy dress, dresses, dressing gowns, evening gowns, jackets, overalls, waistcoats, fur coats, leather coats, raincoats, sports coats, suit coats, top coats, knitted articles of clothing and articles of clothing made from knitted materials, ties, bath robes, articles of sports clothing, sleepwear, hats, socks, belts, scarves, gloves, caps, aprons, jeans, neckwear, swimwear, belts (clothing), athletic footwear, athletic shoes, golf shoes, clogs, slippers; all included in Class 25.

Class 35

Retailing, wholesaling and mail order services, telephone, Internet and computerized on-line ordering, retailing and distributorship services; all the aforesaid relating to metallic accessories for pets including collars, chains, bells, buckles, leads, hooks, chokers, identity tags, doors and door flaps of metal for use with pet animals, common metals and their alloys, small items of metal hardware, pipes and tubes of metal, safes, goods of common metal, eyewear, spectacles, sunglasses, spectacle frames, magnifying glasses, cases for spectacles and sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, earrings, rings, chains, bracelets, pendants, brooches, horological and chronometric instruments, watches, clocks, absorbent diapers of paper or cellulose for pets, paper, cardboard and goods made from these materials, printed matter, bookbinding materials, photographs, stationery, adhesives for stationery or household purposes,

artists' materials, paint brushes, typewriters and office requisites, instructional and teaching material, plastic materials for packaging, printers' type, printing blocks, writing instruments, pouches for writing instruments, gift cases for writing instruments, ink and refills, writing cases, personal organizers, desk sets, fountain pens, ball-point pens and pencils, pen and pencil holders, paperweights, diaries, inkwells and ink stands, passport holders, cheque book holders, cheque book covers, Clothing for pets, collars and covers for animals, accessories for pets including leather leads, tethering articles of leather or imitations of leather, collars of leather and its imitations, leather chews and bits, harnesses, leather and imitations of leather and goods made of these materials, animal skins, trunks and travelling bags, umbrellas, parasols, walking sticks, luggage, bags, cases, vanity cases, suitcases, handbags, shoulder bags, purses, clutch bags, shoulder bags, tote bags, backpacks, rucksacks, shooting sticks, briefcases, attache cases, document holders and cases made of leather or imitations of leathers, holdalls, pochettes, suit carriers, credit card cases and holders, key cases, coin purses, passport holders made of leather or imitations of leather, cheque book holders, spectacle cases (not adapted) made of leather or imitations of leather, pen pouches, diary covers made of leather or imitations of leather, travel organisers made of leather or imitations of leather, tie holders made of leather or imitations of leather, key fobs made of leather or imitations of leather, wallets, cages for household pets, litter boxes or trays for pets, plastic containers for dispensing drink and food to pets, combs for animals, household or kitchen utensils and containers, combs and sponges, brushes, brush-making materials; articles for cleaning purposes, steelwool; unworked or semi-worked glass, glassware, porcelain and earthenware, textiles and textile goods, bed and table covers, clothing, headgear, footwear, articles of outerclothing and underclothing, suits, stockings, tights, pantyhose, shirts, T-shirts, tank tops, blouses, trousers, skirts, articles of fancy dress, dresses, dressing gowns, evening gowns, jackets, overalls, waistcoats, fur coats, leather coats, raincoats, sports coats, suit coats, top coats, knitted articles of clothing and articles of clothing made from knitted materials, ties, bath robes, articles of sports clothing, sleepwear, hats, socks, belts, scarves, gloves, caps, aprons, jeans, neckwear, swimwear, belts (clothing), athletic footwear, athletic shoes, golf shoes, clogs, slippers, toys for domestic pets, games and playthings, gymnastic and sporting articles, decorations for Christmas trees.