

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

**APPLICATION NO. : 300905922**

**MARK :**  
**AMAN**

**APPLICANT : AMANRESORTS LIMITED**

**CLASS : 9, 16 and 41**

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**STATEMENT OF REASONS FOR DECISION**

***Background***

1. On 5 July 2007, Amanresorts Limited (“the applicant”) filed an application for the registration of <sup>AMAN</sup> (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application is in respect of the goods and services in classes 9, 16 and 41 set out in Annex A. 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 that 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. To overcome the objections, the applicant requested the amendment of the specification of goods and services to exclude certain items. In its letter of 29 April 2008, the Registrar indicated that for overcoming the objections raised, further restriction of the specification would be required.
4. The applicant did not respond to the Registrar within the prescribed time and notice of the refusal of the registration of the subject mark was sent to the

applicant on 15 December 2008. The applicant filed a request for a statement of reasons for the decision of the Registrar pursuant to rule 91(2) of the Trade Marks Rules (Cap. 559, sub leg). This statement of reasons for decision is issued in response to this request.

5. The applicant has not filed any evidence of use to overcome the objections raised. There is therefore only the prima facie case to be considered.

***Grounds of refusal under section 11(1)***

6. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Only section 11(1) is relevant here and it reads 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.”

***Decision***

Section 11(1)(c)

7. The subject mark is the English word “AMAN” in plain capital letters. As noted at the examination stage, according to dictionary references on the Internet like [www.infoplease.com](http://www.infoplease.com) and [www.dictionary.com](http://www.dictionary.com), “AMAN” means “Douay Bible” which is an English translation of the Bible prepared by Roman Catholic scholars from a Latin version. When applied to the goods under application, such as downloadable electronic publication in Class 9, book, magazines and

other printed publication in Class 16 and the services applied for in Class 41 such as the provision of on-line electronic publication [not downloadable], the word “AMAN” merely conveys the message that the publications in question are related to the Douay Bible. The subject mark therefore consists exclusively of signs that may serve to designate a characteristic of the goods and services in question.

8. The case of the applicant was presented by the Agents in their letter of 9 January 2008. According to the Agents, the subject mark originates from the name of the applicant and has nothing to do with the Douay Bible. The applicant is merely adopting its company name which is a fanciful word as its trade mark. It is also the applicant’s suggestion that “AMAN” is solely adopted by the applicant.
9. The applicant also objected to the reliance of the Registrar on the meaning of the word “AMAN” found from the internet materials referred to. The applicant pointed to a search of the Hong Kong websites that was conducted on its behalf and which yielded nothing about the Douay Bible. On that basis, the applicant submitted that consumers of the goods and services applied for would unlikely know the meaning behind the word “AMAN”.
10. How the applicant came to adopt the subject mark has no bearing on its registrability. The perception of the consumers to be considered is that of the subject mark and not that of the subject mark with reference to the name of the party that applies it on the goods and services in question. So long as the mark may serve to designate a characteristic of the goods and services in question, it falls foul of section 11(1)(c) of the Ordinance.
11. It is also clear from the dictionary and internet references above referred to that the word “AMAN” is not a fanciful word, but a word with an ordinary dictionary meaning. Thus, the subject mark conveys a definite message when it is applied to the publication items or provision of publication services covered by this application and the consumers of such goods and services are not left to ponder or imagine what its meaning is.
12. As regards the submission that the subject mark is solely adopted by the

applicant, the principles laid down in the case of *Wm. Wrigley Jr. Company v OHIM* (the “*DOUBLEMINT*” case) (Case-191/01 P) are of relevance. That 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 provisions itself indicates, that such signs and indications could be used for such purposes.”*

13. It is therefore clear from the “*DOUBLEMINT*” case that whether any party is using the subject mark to describe its own goods or services is not of any importance. So long as the signs in question could be used for describing the goods and services under application, it is precluded from registration under section 11(1)(c) of the Ordinance.
14. As the subject mark is comprised solely of the word “AMAN”, I find the subject mark to consist exclusively of signs that may serve to designate the characteristics of the goods and services applied for. Registration of the subject mark is therefore refused under section 11(1)(c) of the Ordinance.

#### Section 11(1)(b)

15. Registration of the subject mark is also refused under section 11(1)(b) of the Ordinance. That section precludes from registration signs that are devoid of any distinctive character.
16. There are a number of judicial expressions on the applicable test for considering whether a mark has any distinctive character. The often quoted ones include those from the UK cases of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 and *Nestle SA’s Trade Mark Application (Have a Break)* [2004]

FSR 2. In the *British Sugar* case, the test as enunciated by Jacob J (supra, at 306) is 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?”*

17. The following discussions on the assessment of distinctiveness in the *Have a Break* case (supra, at paragraph 23) are also useful –

*“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.”*

18. It is clear therefore that although the assessment of distinctiveness is to be carried out in respect of the subject mark itself, it has to be done with reference to the goods and services of the class for which registration is sought, as well as the consumers of those goods and services. The goods and services covered by this application are of interest to the general public. I therefore find that the relevant consumers are members of the general public.
19. As noted above, the word “AMAN” means the Douay Bible. When used on the goods applied for, it merely conveys a message that the subject matter of the publications in Classes 9 and 16, whether in electronic format or hard copy, is related to the Douay Bible. Similarly, with the services in Class 41, the relevant consumers will merely perceive it to signify the subject matter of the on-line or hard copy publication being provided via the services. That being the immediate and foremost perception that consumers will have when they see the subject mark being used on such goods and services, they will not therefore regard the subject mark as an indicator of trade source. That being the case, the subject mark is devoid of any distinctive character when used in respect of such goods and services.

20. The Agents suggested that the question of whether the subject mark has distinctive character should be considered in relation to the mark itself. They also submitted that since the subject mark was solely adopted by the applicant, it would serve to distinguish the goods and services of the applicant from those of others in the market.
21. As pointed out in the above, the question of whether a mark is distinctive has to be assessed with reference to the goods and services concerned and the consumers of such goods and services. In view of the signification of the word “AMAN” , without first being educated that the subject mark is intended and used as a badge of origin, consumers of the goods and services applied for are likely to perceive the subject mark as a mere indication of the characteristics of such goods and services. The subject mark is equally applicable to the same goods of other undertakings as such an indication. It would not enable the relevant consumers to distinguish goods of the applicant from those of other undertakings. I therefore find that the subject mark to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods and services applied for.
22. The applicant did not file any evidence of use of the subject mark. I therefore do not have to consider whether the subject mark has in fact acquired a distinctive character as a result of the use that has been made of it.

***Restriction of specification***

23. The applicant had made an attempt to overcome the objections raised by restricting the goods and services covered by the application. A Form T5A was filed on 9 January 2008 for the purpose. The proposal of the applicant was to add the phrase “all the foregoing not including Douay Bibles” at the end of the specification of the goods and services in each of class 9, 16 and 41.
24. The proposed amendment can only address the objections raised if the message conveyed by the subject mark is that the publications involved are Douay Bibles. Such is an overly restrictive view of the perception that consumers will have when they encounter the subject mark being applied to the goods and services in

question.

25. As noted in paragraph 7 above, the message transmitted by the use of the subject mark is that the publications in question are related to the Douay Bible, as opposed to the publications being the actual Douay Bibles. In view of the underlying religious themes and principles contained in the Douay Bible and its importance to the Catholic Church, with other publications on topics like the preaching found in the Douay Bible, the ideological basis of Catholicism, the development of different versions of the Bible and the comparison of the teachings in the Douay Bible and the sacred books or teachings of other religions etc., the subject mark is still apt for designating a characteristic of such items. In light of the much wider concept that the Douay Bible encompasses, the mere exclusion of Douay Bibles from the specification of this application is not sufficient to overcome the objections raised.

*Other matters*

26. The subject mark is registered in the name of the applicant in respect of goods and services in Classes 3, 36, 39, 43 and 44 (Trade Mark No. 300892819). The applicant is of the view that the subject mark should also be considered distinctive for the purpose of this application.
27. Assessment of the distinctiveness of a mark has to be carried out with reference to the specific goods or services in question. In relation to goods like soaps and cosmetics in Class 3 and services like real estate services in Class 36, travel agency services in Class 39, hotel accommodation and restaurant services in Class 43 and health care and beauty treatment services in Class 44, the subject mark does not designate the characteristic of such goods and services. In any event, it is well established by case law that comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration: see *British Sugar Plc v James Robertson & Song Ltd* [1996] RPC 281 at 305.
28. The applicant has also referred to the registration of the subject mark in Australia, New Zealand, Singapore, the European Union, Malaysia, India and the USA. Except for Singapore and India, the registration in those other places is in respect

of goods and services in classes other than 9, 16 and 41. With the registration in India, there is no registration of the subject mark in respect of goods in Class 9 and with the copy certificate of registration in respect of Class 41, the services covered are not shown.

29. More importantly, trade mark rights are territorial in nature and granted in each jurisdiction independently of each other. As the reasons for their acceptance in the other places are not known to me, I do not consider these registrations to be of assistance to this application.

***Conclusion***

30. I have considered all the documents filed by the applicant together with all the written submissions made in respect of the application. For the reasons stated above, I find that, in respect of the goods and services 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 and services. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow  
for Registrar of Trade Marks  
9 March 2009

## **Annex A**

### Class 9

Electronic publications [downloadable]; printed publications in electronically readable form; publications in machine readable form.

### Class 16

Printed matter; printed publications; periodical publications; periodical publications relating to travel; pamphlets; books; magazines [printed publications]; travel magazines; guide books, guide leaflets, guide magazines, guide pamphlets; tour books and tour guides [printed matter].

### Class 41

Providing on-line electronic publications [not downloadable]; publication of magazines; providing on-line electronic publications [not downloadable] relating to travel.