


TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300933174


MARK : 

APPLICANT : KABUSHIKI KAISHA MAKITA (MAKITA CORPORATION)

CLASSES : 7, 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 13 August 2007, Kabushiki Kaisha Makita (Makita Corporation) (“the applicant”) filed an application for the registration of  (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application is in respect of the following goods in classes 7 and 9:-

Class 7

“Electrically powered tools, namely, bandsaws, sanders, grinders, chain saws, circular saws, cut-off machines, cutters, drills, grass cutters, groove cutters, hammer drills, hedge trimmers, jig saws, impact wrenches, lawn mowers, liquid mixers, miter saws, nibblers, percussion and demolition hammers, planers, polishers, reciprocating saws, rotary hammers, routers and trimmers, screwdrivers, shears, staplers, vacuum cleaners, wrenches, concrete vibrators, pumps, and parts and accessories therefor; woodworking machines, namely, bandsaws, jointers, planer-jointers, planers, table saws, chain mortisers, tenoning machines, and parts and accessories therefor; gasoline driven power tools, namely, blowers, chain saws, cutters, grass cutters, hedge trimmers, lawn

mowers, pumps, and parts and accessories therefor; pneumatic tools, namely, air compressors, air nailers, air staplers, and parts and accessories therefor; gasoline driven electricity generators, and parts and accessories therefor.”

Class 9

“Batteries, chargers, and parts and accessories therefor.”

The applicant claims the colours red and black as elements of the subject mark.

2. At the examination stage, objection was raised against the application under section 11(1)(b) of the Ordinance on the ground that the subject mark is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objection was maintained by the Registrar.
3. The applicant requested a hearing on the registrability of the subject mark and this was held before me on 3 March 2009. The applicant was represented by Ms Sandra Gibbons of Messrs. Marks & Clerk at the hearing on behalf of the applicant. I reserved my decision at the conclusion of the hearing.
4. The applicant has not filed any evidence of use of the subject mark. I therefore only have the *prima facie* case to consider.

Grounds of refusal under section 11

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Only subsection (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

6. The subject mark is constituted by a single device. The device is formed by two geometric quadrilaterals in different colours, red and black. The red one is superimposed on the black one and so only a portion of the black one is visible, giving it the impression of being the shadow of the red quadrilateral.
7. The applicable principles for considering whether a mark has any distinctive character have been discussed in many UK cases. In the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, Jacob J (at page 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?”

8. In the case of *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23), the test is formulated as follows –

“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.”

9. In assessing the distinctiveness of a mark, the question to consider is whether the mark will be perceived as a badge of trade origin. 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.

10. With the goods applied for in class 7, they are machines, equipment and tools for different sorts of works for carrying out interior decoration, landscaping and construction and repair. The scale of the works involved can vary between small home fixing and larger projects of maintenance of estates or parks. Thus, construction and interior decoration companies, property management companies as well as members of the general public can be the relevant consumers of such goods. As regards batteries and chargers, the goods applied for in class 9, they are merely items used by every household in their ordinary daily life. The relevant consumers of these goods are therefore the general public.
11. The subject mark is a simple device. That alone is not decisive since a very simple device can sometimes be highly distinctive. It can be a design that has particular aesthetic appeal. It can be a special way of arranging very simple shapes that entails the leaving of an impression in people's minds. The subject mark however does not belong to such categories. It has nothing that catches one's attention or any memorable feature to speak of.
12. Consumers today are a highly sophisticated species. They encounter numerous designs in their normal daily life as almost each piece of commodity is loaded with designs, many of which may not even be noticed by them at all, let alone be remembered. Without any outstanding element that will help one to remember it or to distinguish it from the numerous others that cross the paths of the relevant consumers each day, the subject mark is unlikely to leave any strong impression on them.
13. In taking such a view, I have borne in mind the colour claims made by the applicant in respect of the subject mark as well. Red is a colour often used for attracting attention and when used in conjunction with black, there is an effect of contrast. However, the black rim or the black quadrilateral in the device occupies only a very small portion. Furthermore, when viewed as a whole, the part in black looks like the shadow of the red quadrilateral when light is cast on it at a particular angle. The black portion does not trigger a different idea about the red tetragon. Despite the use of the particular combination in question, the subject mark as a whole remains a very simple device without any remarkable feature. Hence, the colour combination of the different parts of the subject

mark does not confer any distinctive character to it.

14. Ms. Gibbons submitted to the contrary. She suggested that the subject mark was a strong bold geometric shape constituting two overlapping quadrilaterals in different colours. She pointed to the strong bold colours in which the subject mark was represented and referred to the 3-dimensional aspect that it possessed. In her view, the subject mark would not be one easily forgotten but would remain in the consciousness of the consumers. She also stressed that it was for the very reason of product identification that the applicant had chosen the subject mark to apply on its goods.
15. Ms. Gibbons also made submissions on who should be regarded as the relevant consumers of the goods applied for. She argued that the goods were not those that would be bought quickly off supermarket shelves and rather, not being cheap items, customers would take notice of the packaging and remember the logos used by the manufacturers.
16. As noted in the above, I have taken into account the particular shape of the two quadrilaterals that constitute the subject mark, the colours in which different parts are represented and the so-called 3-dimensional aspect that is present because of the impression of a shadow that the black rim or the black tetragon in the background gives rise to. Contrary to the suggestion of Ms. Gibbons, I do not find these factors capable of capturing the attention of the relevant consumers or to render the subject mark to remain in their consciousness. Despite having all these aspects, the overall image of the subject mark remains that of a simple device with no particular memorable feature. The impression that consumers have of the subject mark as a whole is not a strong one and it will not be perceived by the consumers as an indicator of trade source.
17. In these days and ages when each and every single commodity is the result of the many aspects of products design, a device like that of the subject mark will unlikely be remembered by consumers who have been exposed to numerous sorts of logos and signs adopted for distinguishing the trade origin of various goods and services available in the market, let alone be regarded as an identifier of trade source. It is important to note that whether the applicant selected the subject mark in the belief that it could serve to distinguish its goods from the

goods of other undertakings is immaterial. What matters is whether such intended function would be perceived by the relevant consumers without their first having been educated of it.

18. I also have reservations about Ms. Gibbons' suggestion that the goods are not those that can be bought off the shelves in a supermarket. In relation to batteries and chargers in class 9, such goods can be found on sale in a supermarket. With some of the goods in class 7 like electric powered screwdrivers and wrenches, they are common hardware items that are not particularly expensive and it is not uncommon for households to be equipped with such tools. When questioned on this point, Ms. Gibbons agreed to qualify this submission of hers as applicable only to the hard core items such as lawnmowers, chain saws, pneumatic air compressors and the like.
19. I agree with Ms. Gibbons that quite a number of the goods applied for in class 7 are not daily use items or things that one purchases in a supermarket, but are specific machines, tools and equipment designed for performing a particular task in gardening, woodworking and other building and interior decoration activities. Purchasers of these items would pay more care and attention in their selection of such goods than when they pick their grocery from supermarket shelves. Be that as it may, given the lack of any memorable features, the subject mark will likely be passed over as a design of the packaging or a decorative design rather than being perceived and recalled as an identifier of trade provenance.
20. Without first having been educated that the subject mark is intended and used as a badge of origin, it is unlikely for consumers of the goods applied for to perceive it as serving such function. It would not enable the relevant consumers to distinguish goods of the applicant from those of other undertakings. 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.
21. At the examination stage as well as at the hearing, the applicant referred to other registered marks in Hong Kong which are constituted by devices only and which the applicant would consider to be comparable to the subject mark. It is well established by case law that each case has to be assessed on the basis of its own merits and 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 & Sons Ltd* [1996] RPC 281 at 305. Reference to other marks on the register does not therefore assist.

22. Ms. Gibbons also drew my attention to the acceptance of the subject mark for registration in other jurisdictions including Australia and the EU. I have considered these foreign registrations but as I am not aware of the reasons for its acceptance there and there are valid grounds of objection under the Ordinance, I am not persuaded that the subject mark should be accepted merely on the basis of the overseas acceptances.

Conclusion

23. I have considered all the documents filed by the applicant together with all the oral and 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) of the Ordinance, devoid of any distinctive character. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow
for Registrar of Trade Marks
15 April 2009