

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 301172565

MARK :



APPLICANT : RADIANT GROUP (PROPRIETARY) LIMITED

CLASS : 11

STATEMENT OF REASONS FOR DECISION

Background

1. On 31 July 2008, Radiant Group (Proprietary) Limited (“the applicant”) filed an application (“the application”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”) for the registration of the following mark (“the subject mark”):



The application is in respect of “apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes” in class 11.

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 a sign which designates 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. The applicant requested a hearing on the registrability of the subject mark and this was held before me on 6 January 2010. Mr. K. Leung of Wenping & Co. represented the applicant at the hearing. I reserved my decision until after 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.

The Ordinance

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. The relevant provisions of 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;
- (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) ...”

Decision

6. Having considered all the relevant facts, I consider that the subject mark is acceptable for registration in respect of “apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes” in Class 11 (the “unobjectionable goods”). Subject to meeting the requirements stipulated in paragraph 19 below, the subject mark in so far as it is in respect of the unobjectionable goods may proceed to registration.
7. For the rest of this statement of reasons, therefore, I shall consider the subject application in so far as it is in respect of “apparatus for lighting” in Class 11 (the

“objectionable goods”).

Section 11(1)(b) of the Ordinance

8. Section 11(1)(b) of the Ordinance precludes registration of trade marks which are devoid of any distinctive character. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service 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 (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* (Case C-173/04P) [2006] E.T.M.R. 41 at paragraphs 60-61).
9. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* (HCMP 554/2009), the Hon Sakhrani J cited with approval the following cases (paras 17-18):

“17. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 Jacob J as he then was) said at page 306:

“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?”

18. In *Nestle SA's Trade Mark Application (Have a Break)* [2004] FSR 2 Sir Andrew Morritt VC (as he then was) said at paragraph 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 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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking.....”

10. According to the above legal principles, I have to assess a mark's distinctiveness by reference to the goods applied for, and the perception of the relevant consumers, who are presumed to be reasonably well-informed, circumspect and observant. To determine whether the subject mark has any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the mark, assuming no use, serves to identify the applicant's products as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. In other words, the question is whether the perception and recollection the subject mark would trigger in the mind of the average consumer of the applied-for goods would be origin specific (i.e. carry connotations of trade origin) or origin neutral ("*CYCLING IS...*" *Trade Mark Applications* [2002] R.P.C. 37 at paragraphs 66-69). By virtue of the nature of the objectionable goods, the relevant consumers are mainly members of the general public in Hong Kong who would purchase or look for apparatus for lighting.
11. Turning to the subject mark itself, the subject mark is constructed of two elements. It consists of a simple English word "RADIANT" in upper case with a device featuring radiating rays above the word. The word "RADIANT" means "sending out rays of light; bright; shining" (Collins English Dictionary and The Oxford English Dictionary). The device above the word would be seen by the average consumer as radiating rays, which reinforces the meaning of the word "RADIANT". When the subject mark is used in respect of the objectionable goods, i.e. apparatus for lighting, the mark as a whole conveys the direct message that such apparatus emits rays of light. As lighting apparatus originating from other traders would also emit rays of light, the subject mark as a whole does not serve to distinguish the applicant's lighting apparatus from those of other traders. In other words, the subject mark does not inform the consumers of the commercial origin of those goods, and the message conveyed by the subject mark is origin neutral.
12. At the hearing, Mr. Leung avers that the device in the subject mark is not a symbol of radiating waves but simply a distinctive and eye-catching feature in the subject mark. Even if it symbolizes radiating waves, Mr. Leung is of the view that no consumer would perceive the device as such. He further raises an argument that the black spot appearing at the centre of the subject mark has the

effect of allowing the consumers to perceive the alphabet “I” in the word “RADIANT” either as a capital or small letter.

13. I do not agree. The subject mark is made up of the word “RADIANT” in capital letters and a device featuring radiating rays. The black spot appearing at the centre of the subject mark forms part of the device of radiating light rays and indicates the source of light. Even if, which I do not agree, the black spot enables the consumers to perceive the alphabet “I” in either capital or small letter, the consumers would still perceive the word as an ordinary English word, i.e. “RADIANT”. In the context of the mark as a whole, the device, featuring radiating rays, conveys the same meaning as the word “RADIANT”. It builds upon and reinforces the origin neutral message conveyed by the word “RADIANT”, and does not endow the subject mark as a whole with any distinctive character. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin.
14. Without first educating the relevant consumers that the subject mark is a trade mark, the subject mark would be perceived by the average consumer of lighting apparatus as a mere indication that such apparatus emits rays of light.
15. In view of the message conveyed by the subject mark in the context of the objectionable goods, the subject mark fails to perform the essential function of a trade mark in guaranteeing the identity of the origin of those goods by enabling the relevant consumers to distinguish those goods from those of other traders. In reaching this conclusion I have considered the subject mark in its totality placing due weight on the word and the device and the overall presentation of the mark. I conclude that the subject mark is devoid of any distinctive character in respect of the objectionable goods and is thus precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

16. Having found that the subject mark is precluded from registration in respect of the objectionable goods by section 11(1)(b), it is not necessary for me to consider the objection under section 11(1)(c) of the Ordinance.

Overseas registrations

17. Mr. Leung submits that the subject mark has been accepted for registration in South Africa. It should 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 (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As valid reasons for refusal have been found, I am not persuaded that the subject mark should be accepted merely by following the decision of another registry, in particular, when I am not aware of the reasons behind the acceptance.

Conclusion

18. In this decision, I have carefully 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 the subject mark is precluded from registration by section 11(1)(b) in respect of the objectionable goods. The application is accordingly refused under section 42(4)(b) of the Ordinance in respect of these goods.

19. As I find that the registration of the subject mark can be accepted in respect of the unobjectionable goods indicated in paragraph 6 above, the application for registration in respect of such goods can proceed to publication, provided that the applicant files, on or before **25 June 2010**, a Form T5A to restrict the specification by deleting the objectionable goods. If the applicant fails to do so on or before **25 June 2010**, it will be deemed to have abandoned the application.

Karine Lai
for Registrar of Trade Marks
25 May 2010