

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300781524
MARK : Restless Travellers
APPLICANT : Mr. STEFANO MANGINI
CLASSES : 16, 18, 22, 24, 25, 39

STATEMENT OF REASONS FOR DECISION

Background

1. On 18 December 2006 (“the Application Date”), Mr. Stefano Mangini (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:

Restless Travellers

(“the subject mark”)

2. Registration of the subject mark is sought in respect of the following goods and services in classes 16, 18, 22, 24, 25 and 39 (collectively, “the applied for goods and services”):-

Class 16

paper, cardboard and goods made from these materials, printed matters, book printing, book binding material, photographs, stationery or household purposes, artists' materials, paint brushes, office requisites, instructional and teaching, plastic materials for packaging printing blocks

Class 18

leather and imitations of leather, and goods made of these materials not included in other classes

Class 22

ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags, padding & stuffing materials, raw fibrous textile materials

Class 24

textiles and textile goods, not included in other classes; bed and towels

Class 25

clothing, footwear, headgear

Class 39

transport; packaging & storage goods, travel arrangement

3. At the examination stage, objections were raised under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the goods and services applied for. The Applicant called for a hearing on the registrability of the subject mark which took place before me on 19 June 2008. I reserved my decision at the end of the hearing.
4. 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;
 - (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) ...
 - (2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

5. In the subject application, the Applicant did not file any evidence of use of the subject mark. After the hearing the Applicant provided the following with his letter dated 19 June 2008:

- (i) details of certain marks applied for or registered at registries in other jurisdictions;
 - (ii) pages printed from the Applicant's website on 19 June 2008; and
 - (iii) extracts from books, materials in relation to exhibitions, and other promotional materials, all undated,
- (collectively, "the additional materials").

The additional materials, however, were not filed by way of a statutory declaration or affidavit as required under rule 79(1) of the Trade Marks Rules, Cap. 559 sub. leg. ("the Rules"). Therefore, I shall not treat them as evidence filed in support of the subject application. In any event, none of the additional materials show use of the subject mark in Hong Kong before the Application Date. They are not relevant in showing that the subject mark had, before the Application Date, in fact acquired a distinctive character as a result of the use that had been made of it for the purpose of section 11(2) of the Ordinance. I have therefore only the prima facie case to consider.

Decision

Section 11(1)(c) of the Ordinance

6. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the kind, intended purpose, or other characteristics of the goods and services in respect of which registration is sought. The public interest underlying section 11(1)(c) of the Ordinance is to ensure that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

7. In *OHIM v WM Wrigley JR Company* (“the *DOUBLEMINT*” case) [2004] R.P.C. 18, the European Court of Justice (ECJ) stated the following in relation to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark, which is broadly similar in terms to section 11(1)(c) of the Ordinance:-

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. 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 provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

8. In this application, the subject mark consists of two ordinary English words “Restless” and “Travellers” and there is no stylization or any other additional element. The word “Restless” means “ceaselessly active or moving” (*Collins English Dictionary - Millennium Edition*). The term “Restless Travellers” as a whole means constantly moving travellers.
9. In the light of the above, when the words “Restless Travellers” are used in relation to the applied for goods, including, inter alia, printed matter in Class 16, leather goods in Class 18, camping and outdoor equipment in Class 22, textile goods in Class 24, and clothing and footwear in Class 25, the subject mark informs consumers the characteristics of the applied for goods, namely, that they are designed or provided for constantly moving travellers, or in the case of printed matter, that they are about or for constantly moving travellers.
10. As regards the services applied for in Class 39, which include transport, packaging and storage of goods and travel arrangement, the subject mark also convey the message that these services are designed and catered for constantly moving travellers.
11. Accordingly, the subject mark is made up of words directly descriptive of the targeted consumers for the applied for goods and services, or, in the case of printed matter, the subject matter or target consumers thereof. It consists exclusively of a sign which may serve to designate the characteristics of the applied for goods and services. The subject mark is therefore precluded from registration under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

12. Section 11(1)(b) of the Ordinance operates as a separate and independent ground of objection from that of section 11(1)(c) of the Ordinance. Although I have found that the mark is precluded from registration under section 11(1)(c) and it is unnecessary for me to consider the other grounds for refusal, for the sake of completeness, I shall consider the registrability of the mark under

section 11(1)(b) of the Ordinance.

13. Section 11(1)(b) 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 marked product 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* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60).

14. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Jacob J. stated:-

“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?”

15. Later in *Nestle SA's Trade Mark Application ("Have a Break")* [2004] F.S.R. 2 at 26, Sir Andrew Morritt remarked on the approach in assessing distinctiveness:-

“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.”

16. In view of the above legal principles, the distinctiveness of the subject mark must be assessed by reference to the goods and services for which the Applicant seeks registration, 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 and services as originating from a particular undertaking, and thus distinguishing

them from those of the other undertakings. In other words, the question is whether the perceptions and recollections the subject mark would trigger in the mind of the average consumer of the applied for goods and services 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 paras. 66-69).

17. In relation to the applied for goods and services, the relevant consumers are members of the general public in Hong Kong who are looking for those applied for goods and services. The normal and fair use of the subject mark includes applying it on the goods and their packaging, and in advertising materials such as leaflets and websites to promote the applied for goods and services.
18. As demonstrated above, the subject mark conveys a descriptive meaning as to the targeted consumers for the applied for goods and services i.e. constantly moving travellers, or in the case of printed matter, the subject matter or targeted consumers thereof. As such, I consider that when it is used in respect of the applied for goods and services, the relevant consumer would immediately perceive it, on first impression, as an indication that the goods and services are designed or provided for constantly moving travellers, or about them (in the case of printed matter), rather than that they are the goods or services of a particular trader. I am not satisfied that without first educating the public that the subject mark is a trade mark, the consumers would perceive the subject mark as a badge of origin and rely on it to distinguish the Applicant’s goods and services from those of other traders. Therefore, the mark is also considered to be devoid of any distinctive character under section 11(1)(b).
19. The Applicant argues that although the subject mark is a combination of two words, it is not proper for the Registry to consider the components of the mark separately. The applicant says that the subject mark “Restless Travellers” is a concept as a whole, representing the philosophy or way of living of having the desire and being able to adapt to live in the always changing environment. He also submits that the subject mark itself has a strong “sound” impact, and when the members of the general public see the mark, it creates images of adventures and travel in the minds of the consumers. The Applicant therefore considers the subject mark to be distinctive.

20. Even if the subject matter is considered by some consumers to denote a way of living or a philosophy, or that it creates in consumers' minds images of adventures and travel, it does not follow that the subject mark is distinctive. The subject mark does not convey a message about the trade origin of the applied for goods and services. The perception which the subject mark would trigger in the mind of the average consumer is origin neutral, rather than origin specific. It fails to perform the essential function of a trade mark, which is to guarantee the identity of the marked product 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.
21. For the reasons stated above, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Other registered marks on the register and foreign registrations

22. The Applicant also contends that other marks with simple English meanings, such as 'Diesel' and 'Replay', have been registered by the Registrar. In the Applicant's view, these registered marks are similar to the subject mark. I have reviewed the registrations quoted by the agent but I consider they are not on par with the present application. In any event, it is not meaningful to compare the subject mark with marks already on the register. The distinctiveness of each mark tendered for registration must be considered on its own merits by reference to the goods and services applied for and the perception of the average consumer for those goods and services. As Mr. Justice Jacob stated in *British Sugar Plc* (supra) at 305:-

“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.”

Therefore, I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the Applicant in overcoming the objections.

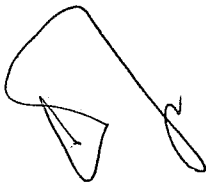
23. It has been asserted by the Applicant that the subject mark has been registered for similar goods and services in Italy, Mainland China and the European

Community. Details of certain applications and registration were provided with the Applicant's letter dated 19 June 2008.

24. Copies of documents submitted in relation to an application for registration in Italy are in Italian, and not accompanied by a verified translation as required under rule 120(1) of the Rules. The marks applied for in Italy and in Mainland China appear not to be identical with the subject mark. The document submitted in relation to the application for registration of the subject mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) does not indicate that the mark has matured to registration. In any event, national trade mark rights are territorially limited and granted independently of each other. Even if a mark is registered in other countries, this does not necessarily mean that it is eligible for registration here, especially where there are valid grounds for refusal under the Ordinance. I do not consider that the subject mark should be accepted for registration in light of the reasons for the objections stated above.

Conclusion

25. I have considered all the documents and submissions filed by the Applicant in relation to this application. For the reasons stated above, I find that the subject mark is precluded from registration under sections 11(1)(c) and 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.



Connie FU
for Registrar of Trade Marks
21 November 2008