

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 302125016AB



MARK:

CLASSES: 25 and 35

APPLICANT: Vans, Inc.

STATEMENT OF REASONS FOR DECISION

Background

1. On 28 December 2011, Vans, Inc. (the “Applicant”) applied to register the mark as shown in the Annex (the “Subject Mark”) under the Trade Marks Ordinance (Cap. 559) (the “Ordinance”).
2. The Applicant originally applied to register the Subject Mark in classes 18, 25 and 35. At the examination stage, the Applicant divided the application into application number 3021250106AB (the “Subject Application”) in respect of the following goods in classes 25 and 35:

Class 25

Footwear, boots, shoes, ski boots, snowboard boots, sports shoes, jogging shoes, slippers; socks and hosiery; nails for shoes

Class 35

Wholesale and retail services relating to footwear, shoes, ski boots, socks, slippers; retail services via a global computer network relating to footwear, shoes, ski boots, socks, slippers; online and in-store retail services featuring footwear

while the other application number 302125016AA of classes 18, 25 and 35 proceeded to registration.

3. Objection of the Subject Application was raised under sections 11(1)(b) and 11(1)(c) of the Ordinance on the basis that the Subject Mark is devoid of any distinctive character and consists exclusively of a sign which designates the characteristics of the goods and services.
4. The Applicant had in support of the Subject Application filed evidence with a view to showing that the Subject Mark has acquired distinctiveness as a result of its use by way of a statutory declaration of David Lin dated 3 April 2014 (the "Declaration"), but the objection was maintained by the Registrar.
5. The Applicant requested a hearing on the registrability of the Subject Mark. The hearing took place before me on 2 September 2015. Mr. David Allison of Messrs. Bird & Bird appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

The Ordinance

6. Section 11 of the Ordinance provides that:

“(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;*
- (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.”

Decision

Inherent Registrability

7. Section 11(1)(b) of the Ordinance precludes from registration marks which are devoid of any distinctive character.
8. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 (*British Sugar*), Jacob J (as he then was) set out the test for distinctiveness at 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?”

9. In *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2, how distinctiveness is to be considered was further discussed by Sir Andrew Morritt VC (as he then was) 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.”

10. According to the above principles, I have to assess the distinctiveness of the Subject Mark by reference to the goods and services applied for, and the presumed perception of the relevant consumers being reasonably well-informed, circumspect and observant. The issue to be considered is whether the Subject Mark, assuming no use has been made of it, can serve to identify the goods and services concerned as originating from a particular undertaking, and distinguish such goods and services from those of other undertakings.
11. Mr. Allison submitted that the relevant consumers of the applied for goods and services in classes 18 and 35 under the Subject Mark are “young people interested in skating, surfing and related sports”. Paragraph 24 of the Declaration shows the

sales figures of the goods alleged to be sold annually in Hong Kong from 2006 to 2013 under the Subject Mark. There is, however, no evidence to suggest that the goods were confined to those related to skating and surfing and were bought mainly by young people. Mr. Allison subsequently agreed that the relevant consumers should not be restricted to those “young people interested in skating, surfing and related sports”. In any event, the question must be considered in respect of the goods for which the Applicant seeks registration, rather than what it has sold in the past. In this light I consider that the relevant consumers are members of the general public in Hong Kong. Such consumers are expected to pay ordinary attention and care in selecting the applied for goods and services.

12. The Subject Mark consists of the representation of a shoe sole with a mesh pattern (see Annex). According to Mr. Allison’s submission, the pattern at the middle portion of the Subject Mark is not a standard mesh pattern, but further consists of vertical lines crossing the mesh pattern, and is a distinctive portion of the Subject Mark.
13. The mesh pattern of the Subject Mark appears to be a basic pattern with 2 sets of parallel lines crossing each other forming multiple rhombus shapes, with the middle portion thereof featuring additional vertical lines intercepting the basic rhombus shapes. Mr. Allison’s argument that this is not a standard mesh pattern given the vertical lines crossing the middle portion is, in my view, too far-fetched: at the ordinary level of attention of the relevant consumers, the difference between the middle portion and the lower and upper portions is hardly noticeable, or could only be recognized in a detailed or magnified view of the Subject Mark; even if it is noticed, it would be perceived as mere embellishment that would not make the whole pattern distinctive of the goods or services of a particular undertaking. It is therefore likely that the relevant consumers, without being educated that the Subject Mark is for distinguishing the trade origin, would regard the Subject Mark as nothing but a banal graphical representation of an ordinary mesh pattern of a shoe sole for describing the goods of shoes and footwear.
14. In light of the above, in respect of the goods and services applied for which are related mainly to shoes and footwear and the related wholesale and retail services, such a shoe sole representation as shown in Subject Mark, appears to be a common representation of the goods and services used in the trade. Without other additional memorable or eye-catching feature, and without educating the consumers its function as a trade mark, the Subject Mark can hardly serve to designate the trade

origin.

15. Based on the above reasons, I found that according to the principles set out in paragraphs 8 and 9, the Subject Mark is devoid of any distinctive character regarding the applied for goods and services and is precluded from registration under section 11(1)(b) of the Ordinance.
16. As the scope of section 11(1)(b) of the Ordinance is broader than that of section 11(1)(c), and I have found that the Subject Mark is devoid of any distinctive character under section 11(1)(b), there is no need for me to consider the absolute ground for refusal under section 11(1)(c) of the Ordinance separately.

Acquired distinctiveness

17. Under section 11(2) of the Ordinance, 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.
18. The legal principle for assessing whether a mark has acquired distinctiveness is set out in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Another* [2000] Ch. 523 as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied...

54. ... a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings.”

19. The above case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC (now replaced by Directive 2008/95/EEC), which is broadly similar to section 11(2) of the Ordinance. I will apply the principle stated therein to the Subject Application. According to the above principle, I must make an overall assessment of the evidence in determining whether the Subject Mark has acquired distinctiveness. If I am satisfied that the relevant consumers have been educated by the use of the Subject Mark to recognize the Subject Mark as a badge of trade origin such that a significant proportion of the relevant class of consumers can identify the goods and services applied for as originating from a particular undertaking, the objections raised against the Subject Mark under sections 11(1)(b) and 11(1)(c) of the Ordinance would be overcome.
20. With the above principle in mind, I would now consider the Applicant's evidence of the use of the Subject Mark submitted by way of the Declaration to determine if a distinctive character has been acquired.
21. The relevant date for determining whether the Subject Mark has in fact acquired a distinctive character is 28 December 2011, the application date.
22. In the Declaration, it is stated that the Applicant first used the Subject Mark in relation to shoes in Hong Kong in the 1990's. Copies or extract copies of the Applicant's catalogues used in Hong Kong including the catalogues from 2007 to 2011 are shown in Exhibits DL-13 to 17. At the hearing, Mr. Allison invited me to look at the Subject Mark shown on the catalogues used in Hong Kong which was only shown in the form of the sole of the shoe products featured on the catalogues.
23. I am aware that besides the Subject Mark, the shoe products are almost always featured with other marks of the Applicant or marks that appear to be the Applicant's marks, for example, "VANS OFF THE WALL", "VANS" and "VAULT" on the same page. When the shoe sole (the Subject Mark) is shown on the catalogues, it is usually shown in photographs containing a pair of the Applicant shoes, with one shoe showing its vamp in the upright position and another shoe putting sideways behind it showing the shoe sole (the Subject Mark).

24. I also notice that in most of these photographs, part of the shoe sole including the alleged distinctive mesh pattern in the middle portion of one shoe is covered by the other shoe showing the vamp in its front, or the mesh pattern in the middle portion is barely distinguishable from the mesh pattern in the upper and lower portions.
25. I perceive the presentation of the shoe sole in the photographs serves more the purpose of featuring the shoes in an artistic manner or informing the readers the overall design of the shoe including the shoe sole, than serving as a trade mark for identifying the Applicant.
26. Even on the page Mr. Allison indicated that the entire page consisted of the mesh pattern of the Subject Mark, I note that the Applicant's "VANS" mark is also present on the page. It appears to me that the use of such mesh pattern on the page serves an artistic purpose rather than as a function of a trade mark for identifying the Applicant. The featuring of the whole Subject Mark without any other marks of the Applicant found in the evidence related to the use of the Subject Mark in Hong Kong is extremely rare.
27. The European Court of Justice has stated in the case *Société des Produits Nestlé SA v Mars UK Ltd. [2005] E.T.M.R. 96 (C-353/03) (Have a Break)* regarding the mark in question being used as part of a registered mark:
- "29 The expression "use of the mark as a trade mark" must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking."*
28. I do not consider that the above use of the Subject Mark is sufficient to show that the Subject Mark can in fact independently serve to denote the trade origin of the goods and services applied for.
29. At the hearing, I was invited by Mr. Allison to consider the sales figures of the shoe products of the Applicant as stated in paragraph 24 of the Declaration. I was also referred to the invoices shown in Exhibits DL-20 and 21. As pointed out by Mr. Allison, the actual Subject Mark was not shown on the invoices.
30. Mr. Allison further referred me to paragraph 27 of the Declaration which stated

*“The invoices in the above Exhibit DL-20 do not show the Trade Mark. But, as mentioned above, the design can be found on **all** the Applicant’s past and current shoes [emphasis added].”*, and suggested that a substantial amount of shoe products featuring the Subject Mark on the shoe soles had in fact been sold in Hong Kong before the application date.

31. Even if I accepted that all the shoes on the invoices bear the design of the Subject Mark, the evidence proved, at its best, that a substantial amount of shoe products featuring the Subject Mark have been sold in Hong Kong. As discussed at paragraph 49 of *Bach Flower Remedies [2000] R.P.C. 513*:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

32. As discussed above, the shoe products referred to in the invoices of Exhibits DL-20 and 21 and the catalogues of Exhibits DL-13 to 17 also bear the Applicant’s other marks. Such evidence does not help establish the fact that a significant proportion of the relevant consumers can merely by looking at the Subject Mark identify the goods and services applied for as originating from the Applicant.

33. I note in Exhibit DL-28, the Applicant has included some copies of media reports on the Applicant’s shoes featuring the shoe sole (the Subject Mark). At the same time, I note that the media reports also show the shoe sole of a competitor’s shoe of another brand side by side, together with the side by side pictures of other parts of the shoes under the two brands, for comparison.

34. At the hearing, Mr. Allison also invited me to look at some printout of third parties’ websites in Hong Kong in Exhibit DL-29, in which some pictures featuring the shoe sole of the Applicant’s shoes (the Subject Mark) were shown. I note that a lot of these websites are related to the reporting of fashion and trendy goods. The pictures of the Applicant’s shoe sole are shown with pictures showing other parts of the same shoes. The Applicant’s other marks such as “VANS” are also featured in the pictures.

35. The Applicant has also shown in Exhibit DL-23 print-out of its website which sells its goods in Hong Kong featuring the photographs of the shoe sole of the Applicant’s shoes (the Subject Mark). I note that for each model of the Applicant’s

shoe for sale, the photograph of the shoe sole is shown together with other photographs displaying the other views of the shoe, for example the top view, the left view, the right view and the perspective view, while the Applicant's other mark can be seen on some of such other views.

36. It occurs to me that the above media reports and websites shown in Exhibits DL-23, 28, 29 featuring the Applicant's shoe sole (the Subject Mark) serve to inform the readers the design of the various part of the Applicant's shoes including the shoe sole rather than for identifying the Applicant.
37. I note that there are other advertising and promotion materials of the Applicant used in Hong Kong being shown in Exhibits DL-24 to 27. Such materials feature the use of the other marks of the Applicant rather than the Subject Mark.
38. The Applicant has shown photographs of shops selling the Applicant's goods and the Applicant's shops in Hong Kong in Exhibits DL-12, 18 and 19. It appears to me from such evidence that the marks commonly used in the shops for the consumers to distinguish the Applicant are its other marks such as "VANS" and "VANS OFF THE WALL" rather than the Subject Mark.
39. I note that the Applicant has included in paragraph 29 of the Declaration its promoting expenses on goods and services bearing the Subject Mark in Hong Kong from 2009 to 2011. However, I was not informed how much expenses actually contributed to the Subject Mark apart from the other trade marks of the Applicant.
40. The Declaration also contains evidence of use of the Subject Mark in the US, the PRC and other countries as shown in Exhibits DL-08, 10, 11, 30 to 34. I agree with Mr. Allison that such use outside Hong Kong can only contribute to a limited spill-over effect in educating the consumers in Hong Kong in relation to the Subject Mark.
41. I am reminded to take an overall assessment of all the evidence filed to determine whether the Subject Mark has acquired distinctive character from its use. I have considered all the evidence filed in relation to the use of the Subject Mark, but I am not convinced that the evidence is sufficient to show that the relevant consumers in Hong Kong have been educated to establish a link between the Subject Mark and its trade origin. There is extremely rare evidence showing the independent use of the Subject Mark on the goods or services applied for without the use of the other

more prominent marks of the Applicant at the same time. I am not presented with the evidence that shows a significant proportion of the relevant consumers in Hong Kong can distinguish the Applicant from other undertakings by the recognition of the Subject Mark.

42. The Applicant has not been successful in demonstrating that the Subject Mark has been used to the extent that the relevant consumers can identify it as indicating a particular trade origin, and therefore has in fact acquired a distinctive character. As such, the objection under section 11(1)(b) of the Ordinance must be maintained.

Foreign registrations

43. It is stated in paragraph 15 of the Declaration that the Subject Mark or a portion of the design of the Subject mark has been registered in other jurisdictions outside Hong Kong (also see Exhibit DL-9). National trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration here in Hong Kong. The reasons behind those acceptances are not known to me. Since I have found valid grounds under the Ordinance for refusing the Subject Application, the above registrations related to the Subject Mark do not serve to overcome the objection raised under section 11(1)(b) of the Ordinance.

Proposed amendments to specification of goods and services

44. At the hearing, Mr. Allison informed me that the Applicant was ready to amend the specification of goods and services by deleting certain items as follows:

Class 25

Footwear, boots, shoes, ~~ski boots, snowboard boots~~, sports shoes, jogging shoes, slippers; socks and hosiery; nails for shoes

Class 35

Wholesale and retail services relating to footwear, shoes, ~~ski boots, socks, slippers~~; retail services via a global computer network relating to footwear, shoes, ~~ski boots, socks, slippers~~; online and in-store retail services featuring footwear

45. I have considered the above proposed amendments to the specification of goods and services, and determined that it will not assist the present case. My decision and

reasoning apply equally to both the original specification of goods and services, and the above specification of goods and services subsequently proposed.

Conclusion

46. I have considered all the documents filed by the Applicant including the Declaration, together with all the oral and written submissions made in respect of the Subject Application. For the reasons stated above, I find that the Subject Mark is devoid of any distinctive character and is objectionable under section 11(1)(b) of the Ordinance in respect of the applied for goods and services. The Subject Application is accordingly refused under section 42(4)(b) of the Ordinance.

Derek Lau
for Registrar of Trade Marks
28 October 2015

