

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 302125359



MARK:

CLASS: 25

APPLICANT: Vans, Inc.

STATEMENT OF REASONS FOR DECISION

Background

1. On 28 December 2011, Vans, Inc. (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the



figurative mark (“the subject mark”) in Class 25 for a wide variety of goods. By a request of 21 November 2012, the specification of goods was amended to “boots, shoes, ski boots, snowboard boots, sports shoes, jogging shoes” (“the applied for goods”) in order to overcome the objection of rule 7(4) of the Trade Marks Rules (Cap. 559A).

2. At the examination stage, objection was taken under section 11(1)(b) of the Ordinance on the basis that the mark is devoid of any distinctive character in respect of the applied for goods. Despite the submissions made by the applicant’s agent and the evidence of use filed by way of a statutory declaration of David Lin dated 30 April 2013 (“Apr 2013 SD”), the objection was maintained.
3. The applicant requested a registrability hearing which took place before me on 2 September 2014. Before the hearing, the applicant filed another statutory declaration of David Lin dated 28 August 2014 (“2014 SD”) in which it is stated, amongst others, that the evidence and exhibits attached to the statutory declaration of David Lin dated 14 November 2013 filed for application no. 302125214 (“Nov 2013

SD”) will be adopted in support of this application. At the hearing, the applicant was represented by Mr. Sebastian Hughes, Counsel instructed by Bird & Bird. I reserved my decision at the conclusion of the hearing.

Trade Marks Ordinance

4. 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)
- (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

5. The subject mark consists of the representation of a wavy stripe with description “The mark consists of a stylized stripe positioned on a shoe. The design of a shoe represented by dotted lines is not part of the mark and serves only to show the position of the mark on a shoe”. The applied for goods include boots, shoes, ski boots, snowboard boots, sports shoes and jogging shoes in class 25.

6. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the basis that the average consumer will just perceive the subject mark as a simple pattern for decorative purpose and the subject mark is devoid of any distinctive character.

7. The applicant filed various documents in support of the claims of both inherent and acquired distinctiveness. It is submitted that the mark is inherently distinctive and in the alternative, that it has acquired distinctive character through use under section 11(2) of the Ordinance. At the hearing, Mr. Hughes submitted that the evidence filed by the applicant is relevant to both inherent and acquired distinctiveness as in determining the distinctive character of a mark, the Registrar must have regard to all

the relevant facts and circumstances and in that context the question of inherent distinctiveness is not to be viewed in the abstract without considering the manner in which the mark is intended to be used, which will have an impact on the perception of members of the public. I will deal with the *prima facie* case first before I turn to the case of acquired distinctiveness.

Section 11(1)(b) of the Ordinance

8. Section 11(1)(b) precludes from registration signs which are devoid of any distinctive character.
9. The test for distinctiveness was laid down by Mr. Justice Jacob in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 (*British Sugar*) 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?”

10. The approach of assessing distinctiveness was further discussed in *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 at page 26:

“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.”

11. In view of the above legal principles, I must consider whether the subject mark, assuming no use of it for the purpose of section 11(2), would be capable of identifying the goods as originating from a particular undertaking, and therefore distinguishing them from those of other undertakings. The question must be considered in respect of the goods for which the applicant seeks registration and by reference to the presumed perception of the average consumer who is reasonably well-informed and reasonably observant and circumspect.
12. I consider that the consumers of the applied for goods are members of the general public and they may not pay more than ordinary attention and care in relation to the

purchase of the applied for goods.

13. The subject mark is a representation of a simple wavy stripe positioned on the side of a shoe with no fanciful or memorable element that catches one's attention or leaves an impression in people's mind. At the hearing, Mr. Hughes submitted that the applicant's products are not cheap so that the average consumer is likely to closely examine all the relevant indicia on the products and will immediately recognize any such indicia as having trade mark significance. I do not agree with the submission, as the relevant consumers will not meticulously analyse the wavy stripe and perceive it to be a mark for distinguishing this goods from goods of other traders, rather they would just perceive it to be a decoration of the shoes.
14. By referring to *Scrannage's Trade Mark Application* [2008] E.T.M.R. 43 at paragraphs 20 and 27, and *X Technology Swiss GmbH v OHIM* Case T-547/08 at paragraph 57, Mr. Hughes submitted that it is appropriate to take account of practices in the marketplace in assessing the distinctive character of a trade mark, and the average consumer is in the habit of making assumptions as to the commercial origin of goods on the basis of lines, stripes or geometric shapes which are usually affixed or expected to be affixed to sports shoes. In order to support the claims that the side profile of footwear is the most important aspect for identifying a brand and that figurative designs in the form of a line, stripe or geometric shape placed on the side of footwear are used as primary indicator of trade source, he referred to photos and samples of the applicant's Old Skool and SK8-Hi shoes as well as extract printouts of various websites showing shoes of different brands and retailers. He asserted that, as illustrated by these materials, it is typically the side of footwear that is presented to consumers and lines, stripes or other geometrical patterns have been used by different brands to identify the commercial origin of their products such as shoes (see Exhibits 2014-DL-08 to 2014-DL-16). He is of the view that consumers are accustomed to immediately according signs such as the subject mark with trade mark significance in respect of leisure and sports footwear. Further, by referring to some of the applicant's advertisements, promotional materials and third party editorials, he said that the subject mark itself was used, with no other mark of the applicant, as an indicator of trade origin. He therefore submitted that the subject mark is far more than just an aspect of design and the average consumer will instantly recognize the subject mark itself, even without the use of any other word mark, logo mark and composite mark, as a trade mark of the applicant.
15. I do not agree with his submissions. In respect of the applied for goods which cover

footwear products in class 25, the wavy stripe is apparently a staple feature which consumers are used to seeing on the goods. It is usual and common to find a stripe or stripes, whether straight or curved, printed or sewn at the sides or other areas of the applied for goods as decorations or embellishments. Moreover, contrary to his submissions, I note from the sample shoes provided and evidence filed that the house mark Vans, with or without other elements, which serves to designate the trade origin of the applicant's goods, actually appeared always on the shoes and in nearly all promotional materials and the subject mark was not used alone as an indicator of origin.

16. I bear in mind that even if the subject mark serves a decorative purpose in respect of the applied for goods, I still have to consider whether it possesses a distinctive character to enable such goods to be distinguished from those of other undertakings. As stated in *The Smiley Company SPRL v OHIM* [2009] ECR II 3535 (*Smiley*) at paragraph 30:

“...whether or not a mark may serve a decorative or ornamental purpose is irrelevant for the purposes of assessing its distinctive character. A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94, however, if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin...”

17. Although a simple device is not necessarily indistinctive, it has been held in case law that a sign which is excessively simple and is constituted by a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (see *Smiley* at paragraph 26; *Vans, Inc.* Case T53/13 at paragraph 70; and *Vans, Inc.* Case R363/2013-2 at paragraph 10).

18. Having considered the way in which the subject mark is presented, I am of the view that unless and until the relevant consumers have been educated that the mark is and is intended to be the applicant's trade mark, they are unlikely to perceive the mark as a badge of trade origin which identifies the goods as originating from a particular undertaking. There is no aspect of the subject mark which is able to give an

impression on the part of the relevant consumers other than that as being a very simple design which merely serves a decorative function.

19. It must be pointed out that the mere fact that other marks, although equally simple, have been regarded as being capable of identifying the commercial origin of the goods in question without any possibility of confusion with those of a different origin and, therefore, as not being devoid of any distinctive character, is not conclusive for the purpose of establishing whether the mark at issue also has the minimum degree of distinctive character necessary for protection (*Vans, Inc.* Case T53/13 at paragraph 78; *Smiley* at paragraph 34).
20. Even accepting it is a common practice to place decorative elements, including geometric patterns of varied forms, on shoes, consumers would not consider those elements to be an indication of origin of the goods unless such have been fixed in their minds through intensive use as identifiers of commercial origin. The fact that some signs placed on shoes, which lack the inherent distinctiveness required of a mark, have acquired distinctive character as a result of the intensive use of the signs in the market, does not suggest that consumers would have learnt to establish a link between any sign placed on a shoe and a particular trader such that the link would confer any trade mark significance.
21. As said in paragraph 17 above, the subject mark, being an excessively simple device, is not in itself capable of conveying a message that enables the consumers to remember, with the result that they will not regard it as a trade mark without being so educated.
22. Consequently, the subject mark would not be perceived immediately as an indication of the trade origin of the applied for goods as it is a very simple wavy stripe with nothing which may be easily and instantly memorized by the relevant public. There is no basis to support that it will be perceived *prima facie*, without extensive use or marketing efforts of the applicant, as distinctive with the function of (or at least also) indicating trade origin. The subject mark therefore fails to perform the essential function of a trade mark by enabling the relevant consumers, who are reasonably well informed and reasonably observant and circumspect, to distinguish the goods under the subject mark as originating from a particular undertaking. For the aforesaid reasons, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(2) of the Ordinance

23. Section 11(2) of the Ordinance provides that 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.
24. 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; if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied (*Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger* [1999] E.T.M.R. 585, at paragraph 54, on the interpretation of Article 3(3) of the First Council Directive 89/104/EEC of 21 December 1988, which is broadly similar to section 11(2) of the Ordinance).
25. With the principles in mind, I turn to consider the evidence of use submitted by way of the Apr 2013 SD, Nov 2013 SD and 2014 SD (collectively “SDs”) in support of the subject application. As the applicant has used the same numbering for the exhibits filed under the different SDs, in order to avoid confusion, I will add a prefix “N-” and “2014-” to the exhibits filed under the Nov 2013 SD and 2014 SD respectively.
26. In the SDs, Mr. Lin, the Vice President and Chief Financial Officer of the applicant, introduced the background of the applicant, including the facts that the applicant is engaged in the design, manufacture, export, distribution and sale of sports footwear, apparel and accessories, its variety of products and worldwide distribution network, and that the subject mark has been used on its Old Skool and SK8-Hi shoes which have been advertised, promoted and sold in Hong Kong continuously since 1984. At the hearing, Mr. Hughes pointed out that the subject mark has also been used on some other styles of shoes, by referring to the applicant’s catalogues. Copies or extract copies of the applicant’s catalogues are exhibited at DL-1, N-DL-13 to N-DL-17, N-DL-22 and 2014-DL-02 to 2014-DL-06, some of which pre-dated the application and showed the sales contact in Hong Kong. Mr. Lin indicated that

almost all catalogues of the applicant circulated since at least 1984 were printed with the statement “VANS, the Vans logos, designs and model names herein are trademarks of Vans, Inc.” and such catalogues have been used and circulated in Hong Kong educating consumers that the subject mark is a trade mark of the applicant.

27. Extract printouts of the applicant’s and third parties’ websites, including www.vans.com, www.vans.com.hk and www.vans.com.cn are exhibited at DL-2, N-DL-01 and N-DL-03, some of which are related to Hong Kong but post-dated the application. Mr. Lin said that the applicant’s products have been sold online at its website www.vans.com which was accessible to consumers in Hong Kong, but the extract copies exhibited at N-DL-23 showing online sales information are either undated or post-dated the application and they do not show any purchase actually made by consumers in Hong Kong.
28. It is deposed that the applicant’s goods under the subject mark have been available for sale in Hong Kong in its six concept stores, opened since 2009, and other retail stores. Store lists and photos etc. are exhibited at DL-3, DL-4, DL-6 and N-DL-19. I note that the name of the concept stores is Vans whereas the subject mark is hardly noticeable as it is only found on the shoes displayed in the stores in a few photos.
29. Mr. Lin set out the sales figures of the applicant’s goods under the subject mark in Hong Kong for years 2000 to 2003 and 2006 to 2013. Copies of sample sales invoices, packing lists and shipment documents etc. for years 2000 to 2003 and 2008 to 2011 are exhibited at DL-5, DL-7 to DL-9, N-DL-20 and N-DL-21. While I note from some invoices that the goods sold were mostly footwear, I do not find the subject mark on any of the invoices or packing lists etc. and I cannot tell whether all the goods sold actually bore the subject mark save and except those shoes with the description of “Old Skool”, “Sk8-Hi” etc. Mr. Lin also said that the goods under the subject mark were not inexpensive and exhibited a copy of the applicant’s price lists for 2011 and 2014 in relation to its footwear products at 2014-DL-01A.
30. Mr. Lin said that the applicant has been promoting its products through sponsorship of action sports, entertainment events and venues, professional and amateur athletes, skateboarding parks and advertising in printed and television media etc. He set out the marketing and advertising expenses in relation to the subject mark for years 2000 to 2003 and 2009 to 2011 in Hong Kong. He also provided separately the marketing and advertising expenses for worldwide and Asian markets as a whole for years 2006 to 2012.

31. Copies of sample advertisements and promotional materials are exhibited at DL-10, N-DL-04 to N-DL-08 and N-DL-10 to N-DL-11 which however concerned only the United States and other overseas markets, except a few undated photos of Mongkok stores. The design story of the subject mark was mentioned in some of the articles¹ and Mr. Lin averred that the design story and the fact that the media and consumers referred to the applicant's products by the name "sidestripe" has endowed the subject mark with a very distinctive identity, which not only served as an ordinary decorative design on the product, but also pointed to the applicant. The similar design story was also mentioned in some Hong Kong advertising materials at Exhibit N-DL-27.²
32. For Hong Kong market, Mr. Lin averred that the applicant's goods under the subject mark have been very popular and frequently reported in media and third parties' websites. Copies of advertisements, editorials, promotional events, websites, store displays and other promotional materials dated 1996, 2000 to 2003, 2007 to 2009 and 2011 to 2013 are exhibited at DL-11 and DL-12, N-DL-12, N-DL-18, N-DL-24 to N-DL-29. I note that some of the materials are undated or post-dated the application. Mr. Hughes highlighted at the hearing a number of comments or remarks made in some third party media and by a celebrity in a feature story of Vans, which in his view were independent evidence, to prove that the subject mark had been recognized

¹ In some of the articles, it was mentioned that "the designers felt it needed an identifiable logo such as a racing strip. After many discussions, an idea emerged: As a California company with a casual, comfortable attitude about living, the side strip should reflect this feeling – not a racing strip, but a wave... and it's distinctive side strip has reflected an identifiable attitude for 20 years" and "My dad always doodled and he kept a pad on his desk. One day he drew the stripe he wanted for our shoes and went to our patent guy, an old cobbler from Boston, and showed it to him. He called it the Jazz Stripe and they liked it so he put it on the Old Skool, style 36. That was our first skate shoe that had leather on it and first came out in 77 – Steve Van Doren on the birth of the Vans Sidestripe".

² "SK8-Hi 是 Old Skool 延身的高筒版本, 鞋側同樣有 Sidestripe 標記, 令鞋身更富象徵性的線條美..." (English translation: "SK8-Hi is the extended boot version of Old Skool, also with the Sidestripe logo on the side, which beautifies the shoes with the symbolic lines); "出現於 VANS 鞋側的 Sidestripe 線條, 又稱為 "Jazz Stripe", 是創辦人 Paul Van Doren 某天隨意於筆記本起的草圖。其後, 此 Sidestripe 首次用於 1977 年登場的 Old Skool 上, 當時更先選用皮料將 Sidestripe 縫在鞋側兩邊。" (English translation: "The sidestripe on the side of Vans shoes is also named "Jazz Stripe", which was doodled by the founder Paul Van Doren one day on a notebook. Subsequently, the Sidestripe was first used on the Old Skool which came out in 1977, at that time the Sidestripe was sewn in leather on both sides of the shoe"); "鞋側以 VANS 經典 sidestripe 線條打造" (English translation: "the shoe side is made with the classic sidestripe of Vans"); "...而為了注入更明顯的代表性設計, Paul Van Doren 便嘗試把早年隨手畫下的草圖, 轉化為經典的 Sidestripe 標記, 並首度打造在鞋身兩側" (English translation: "...for a more visible signature design, Paul Van Doren tried to convert his earlier doodle into the classic Sidestripe logo and apply it to both sides of the shoe")。

as the trade mark of the applicant.³ Further, Mr. Hughes referred to photos of some co-branded shoes with third parties at DL-11 and N-DL-29 on which the marks of the third parties and the subject mark, but not other Vans marks, are shown. He argued that these could prove that the subject mark itself was taken as an identifier of the applicant. However, I note from the photos that the house mark Vans, in addition to the subject mark, was actually featured on some of the co-branded shoes, for example those with Mastermind Japan, Disney Store and Supreme.

33. In order to prove that the subject mark has been promoted as a trade mark, Mr. Hughes referred to colour printouts from the applicant's Hong Kong website and photos exhibited at 2014-DL-07, which featured promoters wearing an outsized Old Skool shoe and a large cut-out model shoe bearing the subject mark, being used in promotional events in Hong Kong. However, such materials all post-dated the application and actually I could not see the subject mark clearly on the outsized shoe and note that another Vans mark was shown prominently next to the large cut-out model shoe in the promotional events. Mr. Hughes also referred to some large outdoor and in-store lighting displays which featured the applicant's shoes with the subject mark prominently, in conjunction with other Vans marks at the bottom or side (Exhibit N-DL-19) and submitted that the subject mark has been promoted, either standalone or in conjunction with other Vans marks, as an indicator of trade origin.
34. It is also declared that the applicant entered the Mainland China market in 2008 and has in 2013 over 27 major stores and the relevant public in Hong Kong would very likely get into contact with the applicant's stores and products under the subject mark in Mainland China. Copies of materials showing the applicant's stores and other promotional materials in Mainland China are exhibited at N-DL-30 to N-DL-33, some of which are said to be accessible in Hong Kong. Even accepting that a number of stores were already operating and some promotional materials were used in Mainland China to promote the applicant's goods or services at the date of application, there is no actual evidence to show such access by consumers in Hong Kong or that the reputation of the subject mark, if any, in Mainland China has been spilled over to the Hong Kong market.

³ The said comments or remarks include: “最喜愛的 VANS 系列? SK8-Hi。最喜歡它的原汁原味, 經典的 Sidestripe 設計一直不變…” (English translation: “The favourite Vans series? SK8-Hi. I like its originality the most, its classic Sidestripe design remains unchanged…”); “…同時保留了 Vans 那條間條標記” (English translation: “…at the same time keeps the stripe logo of Vans”); “還保留 Vans 那條招牌間條” (English translation: “…still keeps the signature stripe of Vans”); “而且鞋側兩邊有斜邊標記” (English translation: “the stripe logo is also on both sides of shoe”); “出自 Paul Van Doren 手筆的 Sidestripe 設計” (English translation: “the Sidestripe design originated from Paul Van Doren's drawing”).

35. Further, Mr. Lin said that the subject mark is well-known in Hong Kong and Mainland China, and infringers have been manufacturing and selling goods under the subject mark in Hong Kong and on e-commerce websites to the public in Hong Kong. A copy of an article teaching readers how to differentiate genuine product of the applicant from the counterfeit goods is exhibited at N-DL-28. Extract pages showing infringing shoes under the subject mark seized in raid actions are exhibited at 2014-DL-17. It is stated that infringers have invariably applied the subject mark on the counterfeit goods as the subject mark was perceived by consumers as the distinctive feature of the applicant's products and not merely as a design or decoration. However, I cannot tell whether the subject mark was perceived by the relevant consumers as an indicator of trade origin from the mere fact that the subject mark was applied on the counterfeit shoes. In fact, I also note the house mark Vans on some of the counterfeit shoes.
36. On the basis of the above evidence, Mr. Lin averred that the applicant has endeavoured to educate the relevant public that the subject mark is a badge of origin and endowed the subject mark with a very distinctive identity. He said that the applicant has acquired significant goodwill and reputation over the subject mark before the application date, and upon seeing the subject mark, the relevant public or at least a significant proportion of the relevant public would identify the goods under the subject mark as originating from the applicant.
37. As stated in paragraph 24 above, section 11(2) requires that the use of the sign must have resulted in the relevant public, or at least a significant proportion of it, identifies the product as originating from a given undertaking. Therefore, in assessing whether the subject mark has acquired distinctiveness as a result of its use in the market, I must emphasize that it is the perception of consumers instead of the intention of the applicant that really matters.
38. By referring to some of the applicant's catalogues, advertising and promotional materials, Mr. Hughes submitted at the hearing that the relevant consumers would identify the subject mark as the applicant's trade mark since the only indicia on the shoes shown was the subject mark without any other word, sign or logo. He said it is also the applicant's common practice to promote the subject mark by using photos of models and celebrities wearing the applicant's shoes with the subject mark as the only visible trade mark. However, I note from those materials that the house mark Vans, with or without other elements, which serves to designate the trade origin of the applicant's products, always appeared, and those photos which merely showed the

subject mark were only part of those materials instead of standalone advertisements. He added that novelty item such as key chains featuring shoes with the subject mark have also been used for promoting the subject mark. But I only note from the catalogues a few photos of key chains in the shape of shoes bearing the subject mark.

39. Mr. Hughes emphasized that there has been concerted effort of the applicant for decades to educate the consumers that the subject mark is an indicator of trade origin by printing or sewing it on the applicant's shoes and featuring it prominently and persistently, either standalone or in conjunction with other Vans marks, in catalogues, websites, advertising and promotional materials. He submitted that the use of the subject mark in conjunction with other Vans marks, usually featuring in the centre the shoes bearing the subject mark, in promotional materials, is part of the education process to promote the subject mark as an indicator of trade origin and there are more standalone uses of the subject mark in recent years. He asserted that consumers' attention has been drawn to recognize the subject mark with trade mark significance.
40. Mr. Hughes contended that the fact that the subject mark is often used in conjunction with other marks of the applicant does not lead to the conclusion that, from the perspective of the average consumer, the subject mark does not function as an indicator of trade source. He submitted that the subject mark is intended to function as a trade mark and has become one of the applicant's most iconic emblems, as shown in the evidence filed.
41. While a mark may acquire a distinctive character in consequence of the use of that mark as part of or in conjunction with another trade mark, the manner of the actual use of the mark must be considered, that is, whether it in fact independently serves to denote the trade origin of the goods in question. In the case *Société des Produits Nestlé SA v Mars UK Ltd.* [2005] E.T.M.R. 96 (C-353/03) (*Have a Break*) where the mark in question was used as part of a registered mark, the European Court of Justice has stated the following:

“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.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and

of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

31 The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: 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 (judgment in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] E.C.R. I-2779, [49] and [51]).”

42. Applying the above principles, I must make an overall assessment of the evidence filed to determine whether the subject mark has acquired distinctive character as a result of its use. I must take into account views of the relevant consumers. The crucial question to ask is whether the relevant consumers have been educated to recognize the subject mark independently as a badge of origin of the applied for goods with the result that a significant proportion of the relevant consumers being capable of identifying the applied for goods as originating from the applicant because of the use made of the subject mark before the application date.
43. From the evidence of use of the subject mark, which include the sales, advertising and promotional figures and materials for Hong Kong market, I accept that the applicant has been using the subject mark in Hong Kong quite extensively for sports and leisure shoes before the application date. But I do not accept that such use demonstrates that a significant proportion of relevant consumers in Hong Kong actually understood the wavy stripe to be a sign of origin as opposed to an attractive decoration on shoes which the applicant may have been the only supplier. As suggested by the Appointed Person in *Vibe* [2009] E.T.M.R. 12, consumers recognizing a sign as one which they associate with a particular manufacturer is not sufficient for the sign to have acquired a distinctive character.
44. In this respect, it should be shown that the identification by the relevant consumers of the products as originating from the applicant is as a result of the use of the subject

mark as a trade mark. However, the evidence filed says very little, if at all, about the actual perception by the relevant public of the subject mark in respect of the footwear goods in class 25. Most of the evidence furnished are sales, advertising and promotional materials of the applicant's sports and leisure shoes, which at most show how the applicant wishes its goods to be perceived but there is no evidence as to the actual perception by the relevant consumers. The design story of the subject mark and the applicant's statement in relation to its logos and designs of the subject mark only indicate the applicant's intention but not the consumers' perception.

45. Although it is submitted that consumers are usually presented with the side profile of the shoes and accustomed to immediately according signs such as the subject mark with trade mark significance, as mentioned in paragraph 20 above, the fact that some signs placed on shoes or associated goods, which lack the inherent distinctiveness required of a mark, have acquired distinctive character as a result of the intensive use of the signs in the market, does not suggest that consumers would have learnt to establish a link between any sign placed on a shoe and a particular trader such that the link would confer trade mark significance. There is nothing in the evidence furnished which substantiates the subject mark has been perceived as a means to distinguish the goods of the applicant from those of another undertaking. The catalogues, articles, advertisements, photographs or invoices do not show that the subject mark has been promoted independently or consumers' attention has been drawn to the subject mark itself as an identifier of the trade origin of the goods. Almost all of the advertisements and promotional materials include other Vans marks and the subject mark is always printed or sewn on the side of shoes but never featured on its own, save and except in a single page in one of the catalogues. These support the view that the subject mark is likely to be perceived as merely decorative instead of designating trade origin.

46. As to the actual perception by the relevant public of the subject mark, Mr. Hughes relied on a few comments (see paragraph 32 above) as proof to show that the subject mark has been recognized as a trade mark of the applicant. However, I doubt if the mere descriptions of the sidestripe as the applicant's sign or mark in a few articles by a few consumers or some magazine editors, who have researched the subject in preparing the articles on sports and leisure shoes, are sufficient to prove that the subject mark has become fixed in the minds of the relevant consumers, or at least a significant proportion of them, by virtue of its use by the applicant in the market, as an identifier of trade origin.

47. The applicant did not provide any survey evidence or declaration from the consumers or trade, such as a chamber of commerce or other professional association, that could prove that a significant proportion of the relevant public have actually perceived the subject mark as an indicator of trade origin, as opposed to a mere design feature. In the circumstances, there is lack of any objective evidence on the consumer perception to assist the applicant to establish acquired distinctiveness of the subject mark at the relevant time.
48. Considering all the evidence including but not limited to the sales, advertising and promotional figures and materials, I am not convinced that the applicant has been successful in proving that the subject mark was used to the extent that the consumers would be able to identify it as indicating a particular trade origin. The evidence submitted as a whole cannot support a conclusion that a significant proportion of the relevant public would, because of the subject mark, identify the goods in question. Consequently, it cannot be inferred that the subject mark has acquired distinctiveness through use in Hong Kong.
49. As the applicant has not demonstrated that before the date of application for registration, the subject mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2) of the Ordinance, the objection under section 11(1)(b) must be maintained.

Other registered marks on the register and foreign registrations

50. The applicant submitted that the acceptance by the Registrar of a number of similar figurative trade marks which are no more distinctive than the subject mark provides strong support for the acceptance of the subject mark on a *prima facie* basis. Mr. Hughes also pointed out that different trade marks of the applicant have been accepted by the Registrar on the basis of inherent distinctiveness. However, I find that those registered marks are not comparable with the subject mark because they are more complex than the very simple wavy stripe is and can leave an impression in the mind of consumers which is capable of designating trade origin. Moreover, as pointed out in paragraph 19 above, the mere fact that other marks, although equally simple, have been regarded as not being devoid of any distinctive character, is not conclusive for the purpose of establishing whether the mark at issue also has the minimum degree of distinctive character necessary for protection in Hong Kong.

51. In any event, it is well established that each case must be considered on its own merits and not by reference to other registered marks. In *British Sugar* at 305, Jacob J said that “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, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”
52. As there are valid reasons for objecting to the subject application, I find that the reference to other registered marks do not assist the applicant.
53. It is also submitted that the subject mark has been registered in many other jurisdictions including Australia, United States, Singapore, New Zealand, etc (see Exhibits DL-13, N-DL-09 and 2014-DL-01). However, 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, where there are valid grounds for refusal under the Ordinance. Since I have found valid reasons for refusing the subject application, I should not simply follow the acceptances of other overseas registries.

Conclusion

54. I have considered all the documents and statutory declarations 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 devoid of any distinctive character and is objectionable under section 11(1)(b) of the Ordinance in respect of the applied for goods. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Connie Law
for Registrar of Trade Marks

23 February 2015