

Names and images of buildings, companies, clubs, etc.

Names of well-known buildings in Hong Kong

Occasionally registrations are sought for the name or pictorial image of well-known buildings in Hong Kong for real estate activities. These may be registrable *prima facie* subject to the usual test of capacity to distinguish, and the restrictions as to use of geographical names, *viz.* that the particular name of a building does not have an association with the goods or services, either as being well-known for the goods or the services, or as the likely source of location for the sale of such goods.

Examiners are expected to draw on their general knowledge in deciding whether a building is well known.

Names which consist wholly of descriptive or indistinctive words are not registrable *prima facie*. For example “White Goods Mall” would be objectionable under section 11(1)(c) on the basis that, it consists exclusively of signs which designate the kind and intended purpose of the goods or services offered, or under section 11(1)(b) for being devoid of distinctive character.

Proprietorship

We need to be satisfied as to the proprietorship of the mark. If there are doubts whether the applicant for registration of the name of a well-known building is the owner/developer of that building, we need to check whether the application has been made with the consent in writing of the owner/developer of that building. If not, we may enquire to see if there is a sufficient nexus or connection between the applicant and the owner/developer. For example, the applicant may be a subsidiary or an associated company of the property owner/developer of the building, or it may be the parent company of the property owner/developer of the building.

If the applicant cannot satisfy us as to the legitimacy of his application and entitlement to use the mark, we have to refuse the application on the ground of bad faith (section 11(5)(b)).

The same considerations apply to an application for registration of the names of companies, clubs, institutions, universities and similar organisations.

Where a mark appears to be the name of a university, but the relevant institution does not award any recognised qualification, see the section on “Section 11(4)(b) – marks that are likely to deceive” in the chapter on [Absolute grounds for refusal](#).

Commemorative use of well-known buildings, clubs, organisations, etc.

If the name or image of a well-known building or landmark is one which is likely to generate demand for memorabilia, the public are much more likely to see that name or image as an indication of the content or character of the goods rather than one signifying trade origin, for example, a pictorial representation of The Peak Tower printed on wallets and coin purses is likely to be taken as commemorative rather than as an indication of trade source. The applicant will need to file evidence to show that the name or image of the well-known building does in fact denote a connection with the applicant in relation to the goods or services claimed.

The same considerations apply to an application for registration of the names of companies, clubs, institutions and similar organisations.

The names of organisations which are associated with certain well-known persons should be distinguished from the names of those persons. For example, PRINCESS DIANA MEMORIAL FUND is registrable as it is source-specific and indicates a trade/charitable connection rather than a characteristic of the goods, but the name DIANA, PRINCESS OF WALES is not (see also chapter on Registrability of surnames, personal names, signatures and images of individuals).

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