

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 200207695

MARK:


The logo consists of the word "SWISS" in a bold, sans-serif font above the word "COTTON" in a similar font. A horizontal line runs through the middle of the "O" in "COTTON".

CLASS: 23

APPLICANT: TEXTILVERBAND SCHWEIZ (TVS),
GESAMTVERBAND DER SCHWEIZERISCHEN
TEXTIL-UND BEKLEIDUNGSINDUSTRIE

STATEMENT OF REASONS FOR DECISION

Background

1. On 27 May 2002, Textilverband Schweiz (TVS), Gesamtverband der Schweizerischen Textil-Und Bekleidungsindustrie (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.43, now repealed) to register  (“the subject mark”) in class 23.
2. The goods sought for registration are: “yarns and threads, the produce of Switzerland”.
3. Upon the applicant’s request, the application was converted to examination under the provisions of the Trade Marks Ordinance (Cap.559)(“the Ordinance”) and was accorded the filing date of 4 April 2003.
4. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance as the subject mark consists exclusively of signs that designate the geographical origin and characteristics of goods and is devoid of any distinctive character.
5. The applicant requested a registrability hearing which took place before me on 2 August 2005. The applicant was represented by Ms. Sandra Gibbons of Lloyd Wise & Co. I reserved my decision at the end of the hearing.
6. The applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The Ordinance

7. The absolute grounds for refusal of an application for registration are provided in section 11 of the Ordinance which reads as follows:

Section 11(1):

“Subject to subsection (2), the following shall not be registered-

(a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);

(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) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.”

Decision

8. The subject mark consists of the words “swiss COTTON” as shown in the representation in paragraph 1. The meaning of the words “swiss” and “COTTON” are so obvious that I do not need to state their dictionary meanings.
9. Prior to the hearing, searches were conducted on the Internet on the usage of the term “Swiss cotton” by other traders. The searches indicate that “Swiss cotton” is commonly used by other traders to indicate a certain kind of fabric. The applicant acknowledged in its written submissions during the examination stage that the term “Swiss cotton” refers to a specific type of yarn or material. At the hearing, Ms. Gibbons conceded in her written submissions that the words “Swiss cotton” in plain letters are devoid of any distinctive character and consist exclusively of signs which designate the characteristics of goods. Ms. Gibbons informed me that the applicant has offered to disclaim exclusive rights to the use of the words “swiss COTTON”.
10. Ms. Gibbons submitted that the overall impression of the subject mark has distinctive character and that it consists of features in addition to the words “swiss COTTON” which do not designate the characteristics of goods. She also submitted that the subject mark is represented in a manner which is different and memorable.

11. Ms. Gibbons carefully analysed the various elements of the subject mark and argued that the representation is more than just representing the words in a different script form. She indicated that the word “swiss” is 'cropped both top and bottom'. I could hardly notice this until I was informed by Ms. Gibbons at the hearing. In my view, there is no stylisation in the word “swiss” and is simply the word “swiss” represented in ordinary lower case.
12. Ms. Gibbons submitted that the word “COTTON” is divided horizontally and vertically with parallel stripes and the stripes intersect to form a cross in the centre of the subject mark. She also indicated that the letters “o” in the word “COTTON” are smaller and are shown as “CoT ToN”.

Section 11(1)(b) of the Ordinance

13. On the meaning of 'devoid of any distinctive character', Ms. Gibbons referred me to the quotations from the following cases:

“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?” - per Jacob J in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 at page 306.

In “*Cycling IS...*” *Trade Mark Application* [2002] R.P.C. 37, Mr. Geoffrey Hobbs as the Appointed Person, stated that “It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings.”

14. In considering whether the subject mark is devoid of any distinctive character, I need to assess the subject mark's distinctiveness in relation to the goods for which registration is sought taking into account the perception of the relevant consumer.
15. It is well settled that a mark must be considered as a whole. The average consumer normally perceives a mark as a whole and does not proceed to analyse it in details. In accessing the registrability of a mark, the overall impression of the mark must be taken into consideration.
16. The goods sought for registration are “yarns and threads, the produce of

Switzerland” and I find that the relevant consumer of these goods are likely to be those involved in the trade and the general public.

17. On first impression, the words “swiss COTTON” stand out from the subject mark. The subject mark would no doubt be pronounced and referred to as the “swiss COTTON” mark. Given that the specified goods are “yarns and threads, the produce of Switzerland”, the subject mark directly conveys the immediate message that the goods sought for registration are made of cotton from Switzerland or a certain type of yarn or material known as Swiss cotton and not the trade origin.
18. Whilst I am willing to accept that there are some lines drawn across the word “COTTON”, the stylisation is minimal and carries no trade mark significance. I find that when the subject mark is considered in its entirety, the lines on the word “COTTON” and the way the subject mark is represented fail to outweigh the descriptiveness of the term “swiss COTTON”. I also find that they fail to alter the message conveyed by the term “swiss COTTON”.
19. Given that the relevant consumer does not analyse a trade mark in detail, it is unlikely that the relevant consumer would pick out the graphical features such as the lines on the word “COTTON” and be caused to consider the subject mark as a whole as having trade mark significance. The relevant consumer's overall impression of the subject mark is likely to be merely the words “swiss COTTON” and such impression is origin neutral rather than origin specific.
20. Ms. Gibbons argued that the subject mark is a complex pattern that would not be adopted by other traders without improper motive. She also added that consumers would not expect more than one trader to create such a unique design and that it would be more than mere coincidence that more than one trader would create the same representation.
21. I do not think the above submission assists the applicant's case as the appropriate test for determining the distinctiveness of a trade mark is *not* whether other traders would adopt the same 'complex pattern' as in the subject mark without improper motive. The test in determining whether a mark possesses the relevant distinctive character within the meaning of section 11(1)(b) of the Ordinance has been discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (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.”

22. Applying the above legal principles, I am of the view that the relevant consumer is likely to perceive the subject mark merely as a description of the applied-for goods as made of cotton from Switzerland or a type of material known as Swiss cotton and not as an indicator of the trade origin. I therefore conclude that the subject mark is devoid of any distinctive character and cannot be accepted for registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

23. As I have found that the subject mark to be debarred from registration under section 11(1)(b) of the Ordinance, it is unnecessary for me to consider the objection under section 11(1)(c) of the Ordinance. However, as objection was raised under this section during the examination stage and for the sake of completeness, I proceed to consider the objection raised under section 11(1)(c) of the Ordinance.
24. Under section 11(1)(c) of the Ordinance, I need to consider the subject mark in its totality in the context of the applied-for goods and determine whether the subject mark consists *exclusively* (my emphasis) 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.
25. Apart from the words “swiss COTTON”, the subject mark also consists of other graphical features such as the lines across the word “COTTON”, I do not find the graphical features descriptive of the specified goods. I therefore find that the subject mark does not consist *exclusively* of descriptive signs under the wording of section 11(1)(c) of the Ordinance. Accordingly, the objection raised under section 11(1)(c) of the Ordinance is hereby waived.

Offer of disclaimer

26. I now turn to the applicant's offer to disclaim exclusive rights to the use of the words "swiss COTTON". This is merely stating that the applicant is willing to give up its rights over the use of the term "swiss COTTON" if the subject mark is accepted for registration and cannot assist in making the subject mark distinctive. It also highlights the fact that the applicant accepts the term "swiss COTTON" to be descriptive and devoid of any distinctive character in relation to the goods concerned.
27. In considering the distinctiveness of a mark, the mark has to be considered as a whole in the context of the goods sought for registration bearing in mind the absolute grounds of refusal provided in section 11 of the Ordinance. As I have already found the subject mark as a whole to be devoid of any distinctive character, the offer of the disclaimer does not assist.

Comparison with other marks

28. Ms. Gibbons drew my attention to Chapter 6 of the U.K. Trade Marks Registry Work Manual in relation to "Trade Marks including prominent descriptive or non-distinctive signs or get-up and/or combined with other distinctive signs ("Surplus")" and compared the subject mark with the examples used in that chapter. Some of the examples referred to in that chapter contain additional features that render the marks distinctive and were considered registrable for different goods or services. I do not find the subject mark comparable with the said examples. Each case must turn on its own facts.
29. Ms. Gibbons also sought to distinguish the subject mark from "The Game Des!gners Studio" (decision of Ms. Sandra Hui acting for the Registrar of Trade Marks, dated 21 February 2005) by claiming that in that mark a simple script form which other traders may select is used. As I indicated earlier, this is not the correct approach in assessing distinctiveness of a mark. In the "The Game Des!gners Studio" decision, the presentation of the mark was merely one of the factors considered and the mark, in its totality, was found to be devoid of any distinctive character.
30. Ms. Gibbons also referred to some registered marks on the Hong Kong register and urged to me to use them as a comparison with the subject mark. I decline to draw the comparison as it has been well established that comparison with other marks on the register is in principle irrelevant when considering a particular mark

for registration (*British Sugar Plc v James Robertson & Sons Ltd.* [1996] R.P.C. 281).

Foreign registration

31. The subject mark has been registered in the E.U. as a Community collective trade mark in classes 23, 24 and 25. Ms. Gibbons submitted that the level of distinctiveness required by the Office for Harmonization in the Internal Market in relation to a Community collective mark is comparable to that of an ordinary trade mark in Hong Kong. She submitted in her written submissions that 'the test is whether the collective mark is capable of distinguishing the goods of an undertaking from those of the other undertakings'.
32. I cannot agree with the above submission. The essential function and nature of a trade mark in Hong Kong are different to that of a Community collective mark. Article 64(1) of Council Regulation (EC) No.40/94 of 20 December 1993 on the Community trade mark ("the Council Regulations") defines a Community collective trade mark as "a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the *members of the association* which is the proprietor of the mark from those of other undertakings".
33. I have already indicated the test for distinctiveness in relation to a trade mark in Hong Kong and I do not wish to repeat it. I note that Article 64(2) of the Council Regulations provides that "In derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks.." This indicates that the requirements for registration of a Community collective mark are different and more lenient than that of an ordinary trade mark in Hong Kong. Thus, the level of distinctiveness required for a trade mark and that of a Community collective trade mark cannot be considered on the same basis.
34. Given the differences in the nature and requirements for registration of a Community collective trade mark and that of a trade mark in Hong Kong, the subject mark cannot be accepted on the basis of its registration as a Community collective mark in the E.U.

Conclusion

35. In this decision I have considered all the documents filed by the applicant and the arguments submitted in relation to the application. For the reasons stated above, I refuse this application under section 42(4)(b) of the Ordinance as the subject mark is debarred from registration by section 11(1)(b) of the Ordinance.

Theresa S.Y. Mak
for Registrar of Trade Marks
31 August 2005