

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300045170

MARK: A LOCK ON SECURITY

APPLICANT: SARGENT & GREENLEAF, INC.

CLASSES: 6 & 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 9 July 2003, Sargent & Greenleaf, Inc. (“the applicant”) applied to register the mark “A LOCK ON SECURITY” in classes 6 and 9 under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).
2. Registration is sought in respect of the following goods:

Class 6
Metal locks; all included in class 6.

Class 9
Electronic locks and associated software; all included in class 9.
3. At examination stage, objections were raised against the subject application under sections 11(1)(b) and 11(1)(c) of the Ordinance on the basis that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the kind and the intended purpose of the specified goods, and is devoid of any distinctive character.
4. On 18 January 2005, the Registrar of Trade Marks (“the Registrar”) issued a notice of his decision to refuse the subject application under rule 91(1) of the Trade Marks Rules (Cap. 559 sub. leg.) (“the Rules”). Pursuant to rule 91(2) of the Rules, the applicant requested a statement of reasons for the Registrar’s decision. The statement of reasons is now given as follows.

The Ordinance

5. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1) reads as follows:

“(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.”
6. The applicant did not file evidence of use of the subject mark. I therefore have only the *prima facie* case to consider.

Decision

Section 11(1)(c) of the Ordinance

7. Section 11(1)(c) of the Ordinance excludes registration of 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.
8. In the subject application, the subject mark consists of the words “A LOCK ON SECURITY”, and is sought to be registered in respect of metal locks (class 6), electronic locks and their associate software (class 9). These metal locks and electronic locks are devices fitted to a gate, door or cabinet, etc in order to prevent unauthorised access or theft, and thus keeping the relevant premises, or the objects stored inside the cabinet secure. In other words, the specified goods serve the purpose of ensuring security. Customers of the specified goods will be those who need locks to keep their premises or properties locked and protected.
9. On first impression, the words “LOCK” and “SECURITY” stand out from the subject mark. Given that the specified goods are locks which serve the purpose of ensuring security, and owing to the prominence of the words “LOCK” and “SECURITY” in relation to the phrase, when consumers see the subject mark applied to the goods, they will immediately perceive the subject mark as a designation of the kind and the intended purpose of the goods, namely, they are locks for ensuring security. I therefore consider that the subject mark directly designates the kind and the intended purpose of the goods applied for

in the subject application.

10. By letter dated 19 April 2004, the applicant submitted that the words “A LOCK ON” were commonly used in English to refer to “having something in sight”, and the word “SECURITY” in the subject mark therefore gave the impression that “SECURITY” was an object, rather than an abstract concept. On this basis, the applicant submitted that the subject mark was a “playing of word and novel” and was not directly descriptive of the specified goods.
11. I cannot agree with the applicant’s submission above. The reason is that average consumer normally perceives a mark as a whole and does not proceed to analyse it in various details. In assessing the registrability of the mark, it is the overall impression given by the mark which must be considered. As explained, I consider that on first impression and when the subject mark is used in relation to the specified goods, the subject mark directly designates the kind and the intended purpose of the goods.
12. In this application, the subject mark merely consists of the plain words “A LOCK ON SECURITY” and does not contain any added element or stylisation. On the basis of my finding that the words directly designate the kind and the intended purpose of the specified goods, I must conclude that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the kind and the intended purpose of the goods. The subject mark is therefore debarred from registration under section 11(1)(c) of the Ordinance.
13. I turn to consider whether the subject mark is devoid of any distinctive character under section 11(1)(b), which operates as a separate and independent ground of objection from section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

14. Section 11(1)(b) of the Ordinance excludes from registration marks which are devoid of any distinctive character.
15. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 at page 306, Jacob J said :

“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?”

16. The approach of assessing distinctiveness was further 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.”

17. As I have stated in paragraph 12 above, the subject mark consists merely of the plain words “A LOCK ON SECURITY” without any added element or stylisation.
18. As also explained, the relevant customers of the specified goods are those who need locks to keep their premises or properties locked and protected.
19. In view of the prominence of the words “LOCK” and “SECURITY” in the subject mark, and the fact that the specified goods are locks for ensuring security, when customers see the subject mark used in relation to the goods, they will immediately perceive the subject mark as a description of the kind and the intended purpose of the goods, i.e. they are locks for ensuring security. They will not, however, perceive the subject mark as an indication of trade origin identifying the goods as originating from a single undertaking. In this connection, although I notice that the subject mark consists of the words “A LOCK ON SECURITY” rather than “A LOCK FOR SECURITY”, I do not consider that this will alter customers’ perception on the subject mark as explained because on first impression, customers are unlikely to spot, let alone give regard to such a minor grammatical deviation.
20. On the basis of my finding that customers will merely perceive the mark as a designation of the kind and intended purpose of the specified goods rather than an indication of trade origin of the same, I find the subject mark to be devoid of any distinctive character and is precluded from registration of the specified goods under section 11(1)(b) of the Ordinance as well.

Reference to registrations in other jurisdictions

21. In its letter dated 30 December 2004, the applicant drew the Registrar’s attention to the fact that the subject mark has been accepted for registration in other jurisdictions, namely, Australia, Canada, Japan, Norway, Singapore,

Switzerland, Taiwan and the European Community. The applicant submitted that amongst the above registrations, the Australian and Singaporean acceptances were of the most persuasive value because both Australia and Singapore were English speaking countries and their examination criteria and standards for trade mark applications were virtually the same as that of the Hong Kong Trade Marks Registry. Certificates of registrations of the above registrations were enclosed in the applicant's letter.

22. I have noted the registrations in other jurisdictions and the applicant's submission above. 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 (See *Automotive Network Exchange Trade Mark* [1998] R.P.C. 885 at 887). In the present case, as I have found valid reasons for refusing the subject application, I am not prepared to follow the decisions of other registries, especially when the reasons for those acceptances are not available before me.

Conclusion

23. For the reasons given, I conclude that the subject mark is precluded from registration by sections 11(1)(b) and 11(1)(c) of the Ordinance, and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Simon Chan
for Registrar of Trade Marks
24 May 2005