

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300451601AB

MARK:




APPLICANT: OVERHEAD DOOR CORPORATION

CLASSES: 6, 9 and 19

STATEMENT OF REASONS FOR DECISION

Background

1. On 5 July 2005, OVERHEAD DOOR CORPORATION (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the mark  (“the subject mark”), *inter alia*, in relation to the following goods:

Class 6: goods of common metal not included in other classes; upward acting metal doors, particularly garage doors, rolling service doors, rolling fire doors, rolling counter doors, service counter doors, and rolling curtain doors.

Class 9: electric operators for opening and closing doors.

Class 19: non-metal upward acting doors.

2. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance in respect of the above applied-for goods.
3. The basis of the objection was that the subject mark is devoid of any distinctive character in respect of the goods.
4. On 4 August 2006, the Registry received a request for a hearing on the registrability of the subject mark.
5. The hearing took place before me on 15 February 2007. Ms. Elaine Cheung of Messrs. Stephenson Harwood & Lo appeared for the applicant.
6. The applicant did not file evidence of use of the subject mark and I therefore have only the *prima facie* case to consider. I reserved my decision at the conclusion of the hearing.

The Ordinance

7. 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) ...;
- (b) trade marks which are devoid of any distinctive character;
...”

Decision

Section 11(1)(b) of the Ordinance

8. Section 11(1)(b) of the Ordinance excludes from registration marks which are devoid of any distinctive character.
9. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (“*British Sugar*”), the approach in assessing distinctiveness was discussed. Jacob J said, on page 306 of *British Sugar*:

“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 European Court of Justice (“ECJ”) stated in *Linde AG, Winward Industries Inc., Rado Uhren AG* [2003] E.T.M.R. 78 (Joined Cases C-53/01 to C-55/01) (at paragraphs 40 and 41) that:

“40. For a mark to possess distinctive character within the meaning of [section 11(1)(b)] it must serve 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 products of other undertakings (see *Philips*, para. [35]).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect”

11. It is also established that marks possessing distinctive character must be able to guarantee the identity of a trade origin. In *Libertel Groep BV v Benelux-Merkenbureau* (Case C-104/01) [2003] E.T.M.R. 63, the ECJ held, at paragraph 62, the following:

“It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see Canon, para. [28], and Case C-517/99 Merz & Krell [2001] E.C.R. I-6959, para. [22]). A trade mark must distinguish the goods or services concerned as originating from a particular undertaking....”

12. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the goods for which the applicant seeks registration. I must also have regard to the perception of the average consumers who are reasonably well-informed and reasonably observant and circumspect.
13. In this application, the goods in question are essentially moving or rolling doors and the operators for these doors. The average consumers include the general public who are seeking these products. The subject mark will be applied to the products or their packaging and will be used in the advertisements, promotional materials or websites for promoting the goods.
14. The subject mark consists of the words “OVERHEAD DOOR” superimposed on a ribbon device. The words “OVERHEAD DOOR” have the dictionary meaning of “a door that rotates on a horizontal axis and is supported horizontally when open” (Collins English Dictionary, Third Edition). When used in relation to the applied-for goods, the overall impression of the subject mark on the average consumers is likely to be that the applicant’s goods belong to a particular type of moving or rotating doors as defined in the dictionary or that the goods are devices facilitating the operation of these doors. They are not likely to perceive it immediately as an indication of trade origin of such goods.
15. Relying on Kerly’s Law of Trade Marks and Trade Names (13th Edition) (paragraph 7-89), the cases *The Oilgear Company’s Application* [1999] E.T.M.R. 291 (Case R 36/1998-2), *Procter & Gamble Company v. OHIM* [2002] E.T.M.R. 3 (Case C-383/99 P) and *MGA ENTERTAINMENT Inc v Yokon International Limited and others* (HCA 4380/2003), Ms. Cheung submitted that only a minimum degree of distinctive character is required and the threshold of distinctiveness is low. She said that the ribbon device was not the usual way of designating the applied-for goods and was eye-catching.

The device therefore conferred distinctive character on the subject mark as a whole.

16. I am not persuaded by her submission. Whether the required degree of distinctiveness is described as “low” or otherwise, to be distinctive for registration, a mark must serve to identify the applied-for goods as originating from a particular undertaking and distinguish them from those of others. In this case, the dominant feature of the subject mark is the words “OVERHEAD DOOR”, the name of the particular kind of door. The subject mark merely informs the average consumers the type of the goods applied for. The ribbon device in the dark colour serves as the background to highlight the words in white. It is unlikely to outweigh the descriptive message conveyed by the words “OVERHEAD DOOR”. The average consumers are not likely to rely on the subject mark as a whole in the context of the applicant’s goods as an indication of trade origin.
17. Ms. Cheung further stated that the consumers of the applicant’s products were mostly professionals such as builders and architects who were sophisticated and were likely to perceive the subject mark as a trade mark. I do not agree. Even if the level of attention by professionals on a trade mark will be higher and they will be more careful in identifying the trade origin, I consider it unlikely for them to rely on the subject mark as an indication of trade origin unless they have been educated to do so. As discussed, they are likely to perceive it as the particular kind of doors or devices that facilitate the operation of these doors.
18. I note Ms. Cheung’s further submission that as the words “OVERHEAD DOOR” were not directly related to goods such as “goods of common metal not included in other classes” in class 6 and “electric operators for opening and closing doors” in class 9, the subject mark as a whole was distinctive and should be registrable. I disagree with her as “goods of common metal not included in other classes” in class 6 is broad and includes overhead doors. As for “electric operators for opening and closing doors” in class 9, they can be used for opening and closing overhead doors and the subject mark will be seen by the average consumers as electric operators for opening/closing such doors.
19. Ms. Cheung also said that the websites quoted at the examination stage relating to the use of the words “overhead door” were websites from the United States and Canada only and were hence not relevant to the instant application in Hong Kong. I disagree with her submission. To my mind even if the websites target at overseas clients, they serve to show that the words “overhead doors” have been used to designate a particular kind of door

and therefore lack any distinctive character so as to indicate trade origin.

20. Based on the reasons stated above, I consider that the average consumers are unlikely to perceive the subject mark as an indication of trade origin of all the applied-for goods, and the subject mark is therefore devoid of any distinctive character in respect of those goods. The subject mark is thus precluded from registration under section 11(1)(b) of the Ordinance in respect of those goods.

Reference to other registered marks

21. Ms. Cheung referred me to a number of registered marks in Hong Kong such as “MAGIC SLIDERS”, “CLEVER GRIP”, “海味街”, “CHEF”, “ServiceMASTER”, “MY CLASSROOM”, “Plenty” and “POPUPDVD” which she found to be descriptive of the goods/services registered and the device, if present, less distinctive than the ribbon device in the instant case. She also referred me to other device marks registered in Hong Kong. I have considered these quoted examples of registration but I am of the view that these marks are not on par with the present application as they have less direct reference to the goods/services registered. In any event I do not consider it appropriate to compare the subject mark with other registered marks. Each case must be considered on its own merits. As stated in *British Sugar*, “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* ([1966] R.P.C. 541) and the same must be true under the 1994 Act.”

Conclusion

22. In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application. On a *prima facie* basis, the subject mark is found to consist exclusively of a sign which is devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods applied for. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of all the applied-for goods in this application.

Sarah Li
for Registrar of Trade Marks
1 March 2007