

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

Decision

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

7. 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.”

8. Applying the above legal principles, I must consider whether each of the subject marks, assuming no use of it for the purpose of section 11(2), would be capable of identifying the applied-for goods as originating from the applicant, and therefore distinguishing them from those of other undertakings. The question must be considered in respect of the applied-for goods, and by reference to the presumed perception of the relevant consumers who are reasonably well-informed and reasonably observant and circumspect. I should also have regard to the natural use of the subject marks, not only on the goods or their packaging, but also in the context of advertising.
9. The subject marks consist of a series of two word marks, namely (A) “爱的承

诺” in simplified Chinese characters, and (B) “愛的承諾” in traditional Chinese characters. There is no stylization of the subject marks or any other additional element. “愛的承諾” are ordinary common Chinese characters and the literal meaning of the phrase is very clear. “承諾” means “*effort; undertaking; promise (to do something)*” (<http://www.mandarintools.com/>). Each of the subject marks as a whole refers to a promise of love or an undertaking given by one to love another.

10. The applied-for goods include jewelry and diamonds. Ms. Chan submitted that the relevant consumers are those who can afford to purchase these expensive goods or have luxurious tastes and they will naturally rely on the brand names to distinguish the goods of one trader from those of another. It is her submission that as the applied-for goods are luxurious ornaments for personal adornment, the relevant consumers would pay attention to the design or outlook appearance of these goods. The consumers would also be more cautious in purchasing these goods and pay greater attention to details such as the marks or words as shown on or applied in relation to these goods. She submitted that it is therefore reasonable to deduce that every single mark as appeared or used on the design of these luxurious goods, being an important feature which would not simply be ignored by the relevant consumers, is calculated to identify the origin of a particular trader and would be perceived by the relevant consumers as origin specific.
11. I do not agree that the applied-for goods must be expensive or the relevant consumers must be rich or sophisticated. Jewelry means items worn as ornaments which may include both expensive items like diamonds and inexpensive items such as costume jewelry that is made of imitation jewels. I therefore consider that the consumers of the applied-for goods include members of the general public. Jewelry often appears in different designs and outlooks. Accordingly, consumers of the applied-for goods are used to seeing different designs. While the relevant consumers may be more cautious when purchasing particular expensive item like diamond, they may not necessarily pay more than ordinary attention and care in purchasing other less expensive jewelries.
12. To my mind, when each of the subject marks is used in relation to the applied-for goods, either by affixing the mark on the goods themselves or in the context of packaging or advertising, it sounds like a slogan and immediately conveys to consumers the message that the goods signify a promise of love from

one person to another. Without spending a lot of time in analyzing a mark, they would rely merely on the first impression that they have of it. While each of the subject marks is affixed on the applied-for goods, it is unlikely to be perceived as an indicator of trade origin by the relevant consumers, but rather as an expression about the emotional meaning signified by the goods. When used in advertising or marketing, consumers are likely to perceive each of the subject marks as purely an indistinctive advertising expression used for promoting the applied-for goods, as opposed to a badge of trade origin identifying the goods as originating from a particular undertaking. The subject marks are commonly used expressions that are apt for use by other traders in promoting the emotional meaning conveyed by similar goods. Excluding those whose web pages can no longer be located at the date of the hearing, the websites quoted by the Registrar at the examination stage (the websites and their extracts are listed in Appendix A) also show that the subject marks have been used by other traders to advertise or promote their goods. I do not agree with Ms. Chan's argument that the websites quoted are totally irrelevant as none of these findings show how the subject marks are used by other traders in relation to the applied-for goods themselves. On the contrary, I consider it apparent from the said websites that the subject marks are actually used by other traders in conveying the message that the goods signify a promise of love.

13. Ms. Chan also submitted that the fact that the mark bears a literal meaning which can be used as an advertising expression or is made of characters of emotional appeal for promotional purpose does not preclude it from registration as a trade mark. In support of her submission, she cited a number of prior registered marks which also consist of words of emotional appeal.
14. A slogan of emotional appeal or an advertising expression is not objectionable in itself as a trade mark. A mark can serve the dual purposes of a slogan or an advertising expression as well as an indicator of trade source, so long as it will be perceived as a sign that guarantees trade provenance. In addition, there is nothing in the Ordinance which suggests that slogans or advertising expressions should be treated differently from other types of marks. Accordingly the same test for assessing distinctiveness applies to slogan marks as it does to other types of marks and the criteria for the registrability of a slogan or an advertising expression is no stricter than for other types of marks. Each mark will be assessed on its own merits in relation to the goods or services in question. However, in the instant case, without first having been educated of its function

as a badge of trade origin, the relevant consumers of the applied-for goods will regard each of the subject marks as nothing more than an emotional or advertising expression for promotional purpose. Therefore, each of the subject marks fails to perform the essential function of a trade mark by enabling the relevant consumers to distinguish the goods bearing the mark as originating from a particular undertaking.

15. For the reasons stated above, I find that the subject marks are devoid of any distinctive character in respect of the applied-for goods and are precluded from registration under section 11(1)(b) of the Ordinance.

Other registered marks on the register

16. Ms. Chan has referred to a number of prior marks including “GIVE LOVE”, “GROW YOUR LOVE”, “made in Love”, “爱是唯一”, “愛很美”, “Love Therapy” and “EVER LOVE” that have been registered in Hong Kong on a *prima facie* basis. She submitted that the prior registered marks also use words of emotional appeal and can equally be regarded as advertising statements purely for promotional purpose. She also argued that the meanings of these prior marks, with reference to the relevant goods registered, are as direct and descriptive as that of the subject marks and the Registrar should adopt the same standard in assessing registrability of trade marks.
17. I have considered these prior registrations but do not find them of assistance to this application. The registration of other marks does not necessarily confer any distinctive character on the subject marks. 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 Plc v James Robertson & Sons Ltd* [1996] RPC 281 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.” As there is valid ground of objection in this application, I am not prepared to accept the subject marks merely on the basis of registrations of other marks.

Conclusion

18. I have considered all the documents 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 marks are devoid of any distinctive character and are 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

30 March 2012

1. 閃爍戒指愛的承諾

近日在「面書」看到新婚的同事分享了她的蜜月旅行照，其中一張和丈夫恩愛晒婚戒，真的讓人羨慕又妒忌。結婚對戒象徵了對愛情的承諾，再配合代表恆久不變的鑽石，寓意愛情永恒長存。

(http://the-sun.on.cc/cnt/lifestyle/20100531/00481_007.html)

2. 卡地亞愛的承諾 Set For You

每對愛侶都可以撰寫屬於自己的愛情故事，為心愛的人度身訂造合適的鑽戒。有見及此，卡地亞推出「Set for You」服務，讓您可在 0.18 克拉至 1.99 克拉的圓鑽中揀選最喜愛的鑽石，然後在五款獨一無二的設計中，打造愛的專屬鑽戒。優雅的 Declaration、以花環般烘托的 Ballerine；又或是簡約永恆的 Solitaire 1895...每枚精心挑選的單顆鑽石指環，只需數星期即可完成鑲嵌，締造一隻夢寐以求的鑽戒。

(<http://www.eladies.hk/cgi-bin/nw/show.cgi/2342/4/1/403208/1.html>)

3. 18K 钻石耳钉----爱的承诺

爱的承诺--喜欢你的思绪，即便我无法触及你，闭上双眼，幻想着我俩已展翅飞舞,许下爱的誓言,朝梦的国度继续飞翔

(<http://www.aimeizuan.com/goods.php?id=253>)