

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 301700595

MARK: ^A 爱意萦绕
^B 愛意縈繞

CLASS: 14

APPLICANT: Diamintangibles International, Ltd.

STATEMENT OF REASONS FOR DECISION

Background

1. On 27 August 2010, Diamintangibles International, Ltd. (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559)

“the Ordinance”), to register the marks “^A 爱意萦绕
^B 愛意縈繞 ” (“the subject marks”) in Class 14 for “Jewelry; watches; diamonds and precious stones” (“the applied-for goods”).

2. At the examination stage, an objection was taken under section 11(1)(b) of the Ordinance on the basis that the subject marks are devoid of any distinctive character in respect of the applied-for goods.
3. The applicant requested a registrability hearing which took place before me on 6 January 2012. At the hearing, the applicant was represented by Ms. Miranda Chan of Hastings & Co. I reserved my decision at the conclusion of the hearing.
4. The applicant did not file any evidence of use of the subject marks. I therefore have only the *prima facie* case to consider.

Trade Marks Ordinance

5. The absolute grounds for refusal of an application for registration are set out in

section 11 of the Ordinance. Section 11(1) reads as follows:

“(1) Subject to subsection (2), the following shall not be registered-
...
(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) “爱意萦绕” in simplified Chinese characters, and (B) “愛意縈繞” in traditional Chinese characters. There is no stylization of the subject marks or any other additional element. “爱意萦绕” are ordinary common Chinese characters and the literal meaning of the phrase is very clear. The characters “爱意” mean “love” and the characters “萦绕” mean “to linger on, to hover or to encircle” (<http://www.mdbg.net/chindict/chindict.php>). Each of the subject marks as a whole means “love lingers on”.
10. The applied-for goods include jewelry, watches, diamonds and precious stones. Ms. Chan submitted that jewelry, diamonds and precious stones are expensive and luxurious and the relevant consumers would be more cautious in purchasing these goods. She said that the relevant consumers would also pay greater care in purchasing inexpensive costume jewelry items as they are ornaments available in different designs or outlooks for personal adornment, as well as in purchasing watches as they are durable goods which would not be purchased frequently. It is her submission that the relevant consumers will naturally rely on the brand names to distinguish the goods of one trader from those of another and therefore pay special care in identifying the relevant sign or mark as shown on or applied in relation to the applied-for goods, which is calculated to serve as an identifier of trade origin, and perceive the mark as origin specific.
11. I do not agree that the applied-for goods must be expensive or the relevant consumers must be 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. And watches are available under different price range for all kinds of customers. I therefore consider that the consumers of the applied-for goods include members of the general public. The applied-for goods, in particular jewelry, often appear 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 or precious stone, they may not necessarily pay more than ordinary attention and care in purchasing other less expensive jewelries or watches.
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 love lingers on. Without spending a lot of time in analyzing a mark, they would rely merely on the first impression that they have of it. I do not agree with Ms. Chan that each of the subject marks is an unusual combination of the characters “愛意” and “縈繞” that render the mark as a whole distinctive. The characters “愛意” in conjunction with the characters “縈繞” do not introduce any unusual variation or create any impression that is sufficiently far removed from the meaning lent by each of its elements.

13. 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 expressions apt for use by other traders in promoting the emotional meaning conveyed by similar goods. Ms. Chan argued that the term “愛意” or “縈繞” may be used separately by third parties for promoting similar goods but the internet findings quoted by the Registrar at the examination stage do not show how each of the subject marks as a whole is used by other traders to advertise or promote or in any way used in relation to the applied-for goods. It should be noted that the objections against the registration of the subject marks in respect of the applied-for goods are based squarely on the signification of the marks as perceived by the relevant consumers. Reference to internet findings was merely for illustration and does not form the basis of the objection raised against the application.
14. Ms. Chan also submitted that the fact that the marks consist of characters which may be used to express love or as an advertising expression symbolizing the meaning of love does not preclude them from registration as trade marks. In support of her submission, she cited a number of prior registered marks which also consist of words of emotional appeal for expressing love and can equally be regarded as advertising statements purely for promotional purpose.
15. 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.

16. 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

17. Ms. Chan has referred to a number of prior marks including “GIVE LOVE”, “GROW YOUR LOVE”, “made in Love”, “Love Therapy”, “EVER LOVE”, “爱是唯一” and “愛很美” 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.
18. 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

19. 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