

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO.: 301721286**

**MARK:** 一生。一心

**CLASS: 14**

**APPLICANT: Diamintangibles International, Ltd.**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 24 September 2010, Diamintangibles International, Ltd. (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the mark “ 一生。一心 ” (“the subject mark”) in Class 14 for “Jewelry and diamonds” (“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 mark is 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 mark. 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 the subject mark, 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 mark, not only on the goods or their packaging, but also in the context of advertising.
9. The subject mark consists of the Chinese characters “一生” and “一心” in plain font separated by a small circle “◦”. There is no stylization of the subject mark or any other additional element. “一生” and “一心” are ordinary

common Chinese characters and the literal meaning of the phrase is very clear. The Chinese characters “一生” mean “*the whole life*” and “一心” mean “*with all one’s heart*” (Lin Yutang’s Chinese-English Dictionary of Modern Usage at <http://humanum.arts.cuhk.edu.hk/Lexis/Lindict/>). The subject mark as a whole means “*(love) for the whole life with all one’s heart*”.

10. The applied-for goods include jewelry and diamonds. Ms. Chan submitted that the goods are expensive and luxurious and the relevant consumers would be more cautious in purchasing these goods. She also said that even for inexpensive costume jewelry items, the relevant consumers would pay more attention to the design or outlook of these goods and be more cautious and observant in purchasing as they are ornaments for personal adornment. 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. 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 the subject mark 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 of “loving for the whole life with all one’s heart”. 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 the subject mark is an unusual combination of the words “一生” and “一心”, and the small circle “◦” is a distinctive element, which renders the mark as a whole distinctive. The characters “一生” together with the characters “一心” do not

introduce any unusual variation or create any impression that is sufficiently far removed from the meaning lent by each of its elements. The small circle will immediately be perceived by consumers as a punctuation mark between the characters and does not add any distinctiveness to the mark as a whole.

13. While the subject mark 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 the subject mark 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 mark is an apt expression for use by other traders in promoting the emotional meaning conveyed by similar goods. The website quoted by the Registrar at the examination stage (the website and its extract is listed in Appendix A) also shows that the subject mark has been used by other traders to advertise or promote similar goods. Ms. Chan pointed out that the internet findings do not show how the subject mark is commonly used by other traders in relation to the applied-for goods and do not substantiate the Registrar's objection that the subject mark is commonly used in advertisements in relation to jewelry as there are very few internet hits showing the use of the subject mark in relation to the applied-for goods. She argued that there is no reasonable basis for the Registrar to conclude that the consumers would regard the subject mark in relation to the applied-for goods as an advertising statement. It should be noted that the objection against the registration of the subject mark in respect of the applied-for goods is based squarely on the signification of the mark 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 mark bears a literal meaning or consists of characters which may be used to express love or as an advertising expression symbolizing the meaning of love 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 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 the subject mark as nothing more than an emotional or advertising expression for promotional purpose. Therefore, the subject mark 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 mark is devoid of any distinctive character in respect of the applied-for goods and is 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 mark 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 mark. 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 mark 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 mark is devoid of any distinctive character and is 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

一生一心 追求完美的極致

鉑金是愛情的金屬，它純淨天然，如愛情般不含雜質；稀有珍貴，好比緣分的難能可貴；永不磨損，宛如真愛一生不變。牽手七十年才到鉑金婚，鉑金之恒久日月可鑒，守護於指間的鉑金縱然時光流逝，卻依舊淨白如初。

(<http://gold.hexun.com.tw/2010-01-12/122335479.html>)