

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300782046
MARK : ESERIES
APPLICANT : NOKIA CORPORATION
CLASSES : 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 18 December 2006, Nokia Corporation (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:

ESERIES

(“the subject mark”)

2. Registration of the subject mark is sought in respect of the following goods in classes 9:-

Class 9

Telephones, mobile telephones, personal digital assistants; handheld electronic devices for sending and retrieving e-mail, faxes, accessing open computer networks and dedicated computer networks; hand held units for playing electronic games; computer software enabling transfer of data between mobile communication apparatus; calculators; MP3 players and radios; mobile televisions; antennas, microphones; speakers, headsets, headphones, earphones, batteries, battery chargers, power supplies, covers for mobile telephones; computers; computer software; computer games; cameras, digital cameras, video cameras; personal and car navigation devices and equipment; digital maps; digital map displays; GPS (Global Positioning System) receivers; handheld electronic devices for recording, organizing, transmitting, playing and reviewing text, data, video and audio files, memory cards

and electronic cards; electrical wires and cables; CD-ROMs and DVDs (“the applied for goods”).

3. At the examination stage, objection was taken under section 11(1)(b) of the Ordinance on the ground that the subject mark is devoid of any distinctive character in relation to the applied for goods.
4. The Applicant requested a hearing which took place on 29 May 2008. Mr. Joerg Sosna of Ella Cheong (Hong Kong) Limited appeared on behalf of the Applicant.
5. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

The Ordinance

6. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provision under section 11(1) read as follows:-

“(1) Subject to subsection (2), the following shall not be registered:-

...

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

...”

Decision

7. Section 11(1)(b) precludes registration of trade marks which are devoid of any distinctive character. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60).

8. The terms of section 11(1)(b) of the Ordinance are broadly similar to section 3(1)(b) of the UK Trade Marks Act 1994, Article 7(1)(b) of Council Regulation (EC) No. 40/94 (“the Regulation”) and Article 3(1)(b) of the First Council Directive 89/104/EEC (“the Directive”).

9. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Mr. Justice Jacob stated as follow:-

“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. Later in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2 at 26, Sir Andrew Morritt remarked on the approach in assessing distinctiveness:-

“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.”

11. In view of the above legal principles, the distinctiveness of the subject mark must be assessed by reference to the applied for goods for which the Applicant seeks registration, and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant. To determine whether the subject mark has any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the mark, assuming no use, serves to identify the Applicant’s products as originating from a particular undertaking, and thus distinguishing it from those of the other undertakings. In other words, the question is whether the perceptions and recollections the subject mark would trigger in the mind of the average consumer of the applied for goods would be origin specific (i.e. carry connotations of trade origin) or origin neutral (“*CYCLING IS ...*” *Trade Mark*

Applications [2002] R.P.C. 37 at paras. 66-69).

12. By nature of the applied for goods, there is no dispute that they are essentially consumers' electronic products and the relevant consumers are members of the general public in Hong Kong who will buy those goods.
13. When assessing the distinctiveness of the subject mark, I must consider the context in which the mark is used in respect of the applied for goods. The normal and fair use of the subject mark includes applying it on the goods and their packaging as well as using it in the course of advertising and promotion of the goods.
14. Mr. Sosna submits that the question of whether a trade mark has distinctive character should be posed in relation to the trade mark as a whole, and it is therefore incorrect for the Registry to dissect it into its component parts in assessing its distinctiveness.
15. Whilst I have no dispute with this principle, given that the subject mark consists of the word "ESERIES" in plain block capitals and the word "SERIES" is a common dictionary word, I consider when customers come across the subject mark, they will naturally perceive it as a simple combination of the letter "E" and the word "SERIES". I do not consider that the absence of the space between "E" and "SERIES" in the subject mark would confer it a meaning or impression which is different from where the letter "E" and the word "SERIES" are separated by a space, a dash or a hyphen.
16. Mr. Sosna further submits that if a trade mark does not refer directly to the designated goods or services, and the relevant consumers have to go further and dissect the trade mark before deriving some applicable meanings for the designated goods or services, the trade mark should be deemed distinctive and registrable.
17. As I have explained above, the distinctiveness of the subject mark must be assessed by reference to the applied for goods for which the Applicant seeks registration, and the perception of the relevant consumers. Turning to the subject mark itself, the word "SERIES" means "a number of similar or related

events or things, one following another” (*Cambridge Dictionaries Online*¹). For the letter “E”, it is true that it can have a number of different meanings depending on the context in which it is used. In the present context, i.e. in the field of consumers’ electronic products in Class 9, I consider customers will instantly assume the letter “E” stands for “Electronic” and will be very likely to perceive the subject mark as standing for “Electronic Series”.

18. In the light of the above, when the subject mark is used in relation to the applied for goods in Class 9, which are essentially consumers’ electronic products including mobile telephones, personal digital assistants, computers, MP3 players and cameras, the relevant consumers would immediately perceive the subject mark, on first impression, as “E SERIES” or “Electronic Series”, which is an indication that the goods are of a particular product line of any trader, rather than the goods of a particular trader. Therefore, I consider that the average consumers are unlikely to perceive the subject mark as an indication of trade origin of the Applicant’s applied for goods.
19. Mr. Sosna further argues that a minimum degree of distinctiveness is sufficient to prevent a sign from being deemed “devoid of distinctiveness” and it is appropriate to examine whether there appeared to be no possibility that the sign may be capable of distinguishing, in the eyes of the relevant public, the designated goods or services of a different origin. He also submits that it is settled case law that a sign’s lack of distinctive character cannot arise from the finding that the same does not look unusual or striking or there is no specific level of creativity or imaginativeness. Mr. Sosna further argues that the sign, though without an immediately perceivable meaning, can be easily and instantly memorized by the relevant public and can enable a positive purchasing experience.
20. I note Mr. Sosna’s submissions, but when considering whether a mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance, the Registrar is under no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness (*Case C-104/00P DKV Deutsche Krankenversicherung AG v OHIM (Companyline)* [2002] ECR I-7561

¹ <http://dictionary.cambridge.org/define.asp?key=71941&dict=CALD>

para. 20). Whether the required degree of distinctiveness is described as minimal or otherwise, a mark must as a whole perform the essential function of distinguishing the Applicant's applied for goods from those having a different commercial origin (*Case T-34/00 Eurocool Logistik GmbH v OHIM* [2002] E.C.R. II-683 para. 51).

21. As demonstrated above, the objection is based on an assessment of how the subject mark is perceived by the relevant consumers of the goods in question. It is not based on any finding that the subject mark does not look unusual or striking or whether the subject mark can be easily and instantly memorized by the relevant public. As I have explained in paragraph 18 above, the relevant consumers would perceive the subject mark as an indication that the goods are of a particular product line of any trader rather than the goods of a particular trader. The conjoining of "E" with "SERIES" is not sufficient to bestow distinctive character on the mark as a whole.
22. The internet references cited in the Notice of the Registrar's Opinion dated 22 March 2007 ("the internet references") are now reproduced at the Annex to this Decision. They show that the term "E SERIES" is apt to indicate a product line of any trader. Each of the proprietors referred to in the Annex has a product line called "E Series". The internet references do not form the basis of my decision. The objection is based on an assessment of how the subject mark is perceived by the relevant consumers of the goods in question. The internet references serve to reinforce my view that when used in relation to the applied for goods in Class 9, the average consumer would perceive the subject mark as merely indicating that the goods are from a product line of any trader. The average consumer would not assume that different products provided under the subject mark come from the same or economically-linked undertakings. The message conveyed by the subject mark is therefore origin neutral, rather than origin specific.
23. For the reasons stated above and without any evidence of use of the subject mark in respect of the applied for goods, I am not satisfied that without first being educated through use, the relevant consumers would regard the subject mark as a guarantee of trade origin of the applied for goods. Therefore, I find that the subject mark is devoid of distinctive character and is precluded

from registration under section 11(1)(b) of the Ordinance.

Other registered marks on the register and foreign registrations

24. Mr. Sosna submits that some similar trade marks designating similar goods in Class 9 have been previously accepted by the Registry for registration and has referred me to a number of examples like “JETSERIES” (Registration No. 1995B02781), “HI SERIES” (Registration No. 1997B00043) and “CEF SERIES” (Registration No. 300749719). In the agent’s view, these registered marks are similar to the subject mark for goods in Class 9. I have reviewed the registrations quoted by the agent but I consider most of the quoted examples are not on par with the present application. In any event, I do not think that it is appropriate to make direct comparison between different marks on the register. Each case must be considered on its own merits. This issue has been discussed in *British Sugar Plc* (supra):-

“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, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

25. There are valid grounds for refusal and I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the Applicant in overcoming the objections.
26. It has been asserted by Mr. Sosna that the subject mark has been registered in the European Community on a prima facie basis. It must be noted that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in the European Community is not sufficient to establish that a sign is eligible for registration here, where there are valid grounds for refusal under the Ordinance. Despite the foreign registration of the subject mark, I am not convinced that the subject mark should be accepted for registration in light of the reasons for the objections stated above.

Conclusion

27. I have considered all the documents and submissions filed by the Applicant and its agent in relation to this application. For the reasons stated above, I find that the subject mark is precluded from registration under section 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

(Original signed)

Connie FU
for Registrar of Trade Marks
6 November 2008

1. http://www.olympusamerica.com/cpg_section/cpg_digital_eseries.asp
Olympus®
Choose an **E-Series** camera:
2. <http://www.fujifilm.com.hk/index.php?id=67>
FinePix **E Series** Digital Camera
3. http://www.scpda.com/Palm/Toshiba_GENIO_e550g.htm
With the GENIO **e series**, Toshiba draws on the cutting-edge technologies the company has pioneered in the development of portable PCs and cellular phones, including high-density mounting technology for multi-layer circuit boards.
4. <http://www.academicssuperstore.com/item/?tname=249760&title=Tungsten+E+Series+HandheldsPalm>
Tungsten **E Series** Handhelds
Get the power you need to perform at the top of your game with a sharp, high-resolution color screen, 32MB memory, and a fast ARM processor – all at an affordable price.
5. <http://www.shopping.com/xPF-IBM-Aptiva-E-2170-2170802~r-1~CLT-INTR~RFR-www.google.com.hk>
In the current range of IBM Aptiva **E Series** computers you will find many innovative features
6. <http://www.pinnaclemicro.com/hp1000.htm>
Hewlett Packard HP 1000 Series A, E, M and F

HP 1000 / E-M-F Series			
PROCESSORS		DISC DRIVES	
2109B/E	E-Series Computer	7907A	40 MB Disc Drive

7. <http://en.red-dot.org/317+M58a5d3b12cf.html>
Acer Aspire **E-Series** Desktop Computer
The Acer Aspire E-series is an expression of a new era in user-friendly multimedia desktop PCs,...
8. http://www.campustech.com/c/campust/title.html?mv_arg=SAND117
SanDisk Sansa **E Series** MP3 Players
9. http://www.mp3newswire.net/stories/6002/Sony_E.html
Sony **e-Series** MP3 Player