

Application No. 1512/1981

IN THE MATTER of the Trade Marks
Ordinance (Chapter 43)

AND

IN THE MATTER of an Application No
1512 of 1981 by KYUSHIN SEIYAKU CO
Ltd to register the mark "救心"
Kyushin" in Class 5 in respect of
"Heart Tonic Pills" in Part B of
the Register.

D E C I S I O N

of

Miss A.C. Waters acting for the Registrar of Trade Marks at a Hearing
held on the 21st September 1984.

Mr Andrew Liao instructed by Messrs Hon. & Co. appeared on behalf of
the applicant.

On the 4th June 1981 Kyushin Seiyaku Co Ltd of No. 21-7,
1-chome, Wada, Suginami-ku, Tokyo, Japan ("the Applicants") applied
through their agents Messrs Wenping & Co. Patent & Trade Marks Agents
to the Registrar of Trade Marks ("the Registrar") for registration
under Application No. 1512/81 of the trade mark "救心" Kyushin" in Class
5 in respect of "Heart tonic pills" in Part B of the Register in the
following form -

救 心
KYUSHIN

On the 8th June 1981 the Applicants through their agents lodged a Statutory Declaration in support of the application in Part B made by Mr Mitsuri Hori Manager of the Business Affairs Department of the Applicants.

This Declaration included, inter alia, the following information :

1. Mr. Hori stated that the Applicants had used the trade mark Kyushin and its Chinese equivalent continuously since 1913 in respect of heart tonic pills manufactured and sold by them and had used the trade mark continuously in Hong Kong since the year 1954. The trade mark had been applied to the packages or containers of the said goods.

2. Details of the sales of the said goods in Hong Kong by the applicants for the years from 1954 to 1980 were given and sales figures for the five years to 1980, based on the number of boxes sold containing 20, 50, 100, 200 & 500 pieces respectively, are set out as follows.

<u>Year</u>	<u>Amount(US\$)</u>	<u>20pcs</u>	<u>50pcs</u>	<u>100pcs</u>	<u>200pcs</u>
1975	320,106	5,450	103,500	21,500	0
1976	301,263	10,900	79,950	32,500	0
1977	232,576	4,400	42,250	14,600	0
1978	727,595	6,100	78,000	64,460	0
1979	1,121,363	0	75,000	115,000	6,000
1980	1,252,681	0	44,200	86,700	19,800

These figures and those relating to the advertisements were given in US dollars on the basis of a rate of exchange from Japanese Yen into US dollars for the years 1978-1980 of Yen 220.- to one US\$ and for the years 1972-1977 of Yen 300 to one US\$.

3. Mr Hori stated that in Hong Kong the Applicants had advertised the goods sold under the said trade mark since 1969 and the evidence reveals that this advertising was mainly in the Chinese press but that there was also some cinema and other advertising during the years 1969-1972. In 1975 the sums expended were US\$16,100 which increased in 1979 to US\$39,500 and to US\$70,700 in 1980.

4. There were a number of exhibits to the Declaration which I deal with as follows.

(1) Exhibit B contained copies of a large number of purchase orders, probably in excess of 300 copies, dating from 1961-1980 showing export of the said goods by Nichibai Trading Co Ltd of Osaka, Japan for delivery to Hong Kong. The goods were described in the purchase orders as "KYUSHIN heart tonic pills" and were sold by boxes containing 20, 50 etc. pills. I could see no reference to the trade mark in Chinese characters in the description of the pills in those copies of the purchase orders which I actually examined in detail and in all cases the goods were described as "'KYUSHIN' Heart Tonic Pills".

(2) Exhibit C contained a large number of copies of examples of advertisements. These were unfortunately all in Chinese and none were translated, except that some dates were, before being copied, marked in and translated and these show dates from 1969 to 1980. It appears that there are approximately seven different types of advertisements but in most cases the advertisement included a copy of the boxes in which the pills are sold. From the exhibits I can see that these boxes usually contain the word KYUSHIN and the two characters "救心". I attach in the Appendix and numbered 1 an example of the mark taken from a copy marked as dated in 1979 which is, in fact, very similar to an advertisement marked 1969.

As can be seen from the example referred the mark is not used in the form applied for but rather with "KYUSHIN" at the top of the box and the characters "救心" in the middle. I also note from this same copy advertisement that the descriptive part contains the word "Kyushin" but I am reliably informed that there is no reference to the Chinese characters "救心" in that particular section and indeed I cannot see these characters myself, although they do appear on their own in other parts of the advertisement.

Another example of the advertisement is set out in the Appendix and Nod 2 and marked as dated 1976 and I have highlighted the various places where the Chinese characters appear.

(3) Exhibit D included copies of a number of invoices addressed to Hori Kikaku Co Ltd of Tokyo for advertising fees during the years 1975-1980. I note that these invoices refer to "advertising for Kyushin in Hong Kong" and do not refer to the characters "救心".

(4) No sample of the actual boxes in which the pills were sold was exhibited.

(5) No explanation has been given as to the relationship between Nichibai Trading Co Ltd and Kikaku Co Ltd and the Applicants.

On the 29th August 1981 the Trade Marks Registry ("the Registry") wrote to the Applicants agents refusing registration of the mark in Part B giving the following reasons :

"The user evidence filed in support of the above mark has been considered. However, I regret to inform you that the mark is not capable of registration in Part B of the Register. The Chinese characters "救心" simply meaning "save the heart" have a very direct reference to the "heart tonic pills" sold thereunder in that they are capable of correcting any heart diseases thus restoring the proper function of the heart. I am of the opinion that the applicants are not entitled to a monopoly of such a descriptive epithet though by long user it may have become widely and closely associated with your clients' goods. It is pointed out by Lloyd-Jacob, J. in the "Torq-set" case (1959 RPC 344 at lines 37-39) that "Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders".

I note from a very early application No. 613 of 1957 made by your clients for registration of Trade Mark "救心" that they have already been informed of the fact that even on the strength of evidence of user over a period of time the characters could not be held to have developed a secondary meaning as indicating only the goods of the applicants."

On the 28th October 1981 the Applicants' agents replied in the following terms -

" In view of the difficulty that has arisen here, our clients are prepared to offer a disclaimer of "救心". On the strength of evidence of user over a very long period of time and in view of the surrounding circumstances, we believe that the application can be allowed to proceed with a disclaimer of "救心' ".

Our clients have two "KYUSHIN" marks registered in Hong Kong under Registration Nos. 64 of 1965 and 65 of 1965 and we should be grateful if you would consider accepting the subject mark as a mark in association with Trade Marks Nos. 64 and 65 of 1965."

On the 6th November 1981 the Registry replied as follows:

"Your proposal as to disclaim the Chinese characters "救心" has been carefully considered. However, I regret that the same being highly descriptive of the goods is not allowed to remain in the mark even subject to disclaimer. It is undesirable that the mark may be identified by some disclaimed element which is unregistrable."

On the 20th November 1981 the Applicants agents replied asking for reconsideration for the following reasons :

"We thank you for your letter of 6 November and regret to note that you are unprepared to allow a disclaimer of the Chinese characters "救心" in the application for registration of the trade mark "KYUSHIN". We would respectfully refer you to Section 16 of the Trade Marks Ordinance wherein the Registrar or the Court is empowered to enter a disclaimer of non-distinctive character of a Trade Mark. At PP. 9-02 in Kerly's, matter which is merely descriptive and is included in a label which is distinctive as a whole is clearly covered by the words "or otherwise of a non-distinctive character" in Section 14 (equivalent to our Section 16). In the present case, we see no reason why a disclaimer cannot be allowed. We appreciate that the two Chinese characters "救心" are laudatory but that we would refer you to a prior registration "FAB 快潔" in Part B of the Register. That registration was obtained with evidence of user and with a disclaimer of "快潔". Enclosed is photocopy of the Hong Kong Government Gazette containing the relevant application. You will recollect that in Class 3 of the Register, a number of trade marks are registered with appropriate disclaimer, for example, "REVLON BRUSH ON" (with disclaimer of "BRUSH ON") etc."

On the 10th March 1982 the Registry replied still maintaining that the Chinese characters could not remain in the mark subject to a disclaimer and gave the following reasons :

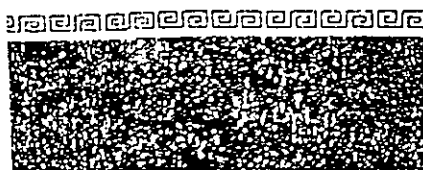
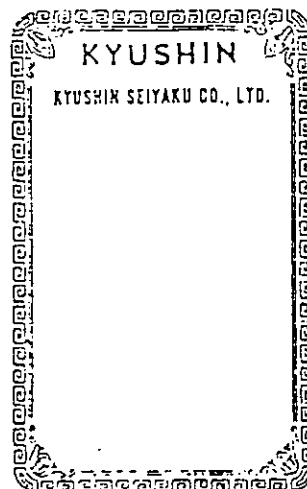
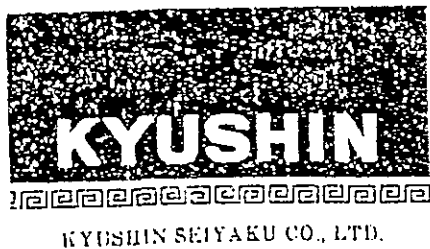
- " (i) the products sold under the mark would be ordered or known among the Chinese speaking purchasers only as "救心" which are totally non-distinctive, unregistrable and in fact a disclaimed element of the mark.
- (ii) The idea imparted by the characters "救心" i.e. save the heart is emphatically laudatory of the curable effects of the applicants' goods. Their presence in the mark would virtually amount to official approbation of their effectiveness, which is highly undesirable.

The acceptance of the "FAB 快救" in Part B of the Register with the characters disclaimed was based on very massive evidence of prior user. Moreover, the same being used onto "detergents" in Class 3 will not receive likewise consideration as to marks used on pharmaceutical preparations which have to be subject to more stringent examination in the interest of the health of the public at large."

There was no further correspondence until the 16th March 1984 when Messrs Hon. & Co requested a formal hearing before the Registrar on behalf of the Applicants.

On the 29th May 1984 an authorisation on Form TM-50 appointing Messrs Hon & Co, Solicitors, as agents for the Applicants to represent them at the Hearing was lodged and the Hearing was held on the 21st September 1984.

The Applicants are the registered proprietors of the trade mark No. 64 of 1965 "Kyushin & device" and No. 65 of 1965 "Kyushin & device" both in Class 5 in respect of "medicines and pharmaceutical preparations" and both in Part B of the Register. The marks are in the following forms :



As the Applicants have registration of the word "Kyushin" this part of the mark can be accepted for registration and the question for me to decide is whether the mark now applied for namely, "救心" Kyushin" can be accepted for registration in Part B of the Register in Class 5 in respect of "Heart Tonic Pills".

The primary submission made by Mr Liao at the Hearing was that the mark "救心" Kyushin" was registrable in Part B and only if that submission failed did he indicate that his clients would be prepared to accept registration of "Kyushin" with a disclaimer of the characters "救心".

S. 10 of the Trade Marks Ordinance ("the Ordinance") was amended by the Trade Marks Amendment Ordinance 1984 with effect from the 1st September 1986 but as at the date of the application namely 4th June 1981 S. 10(1) & (2) of the Ordinance provided as follows :-

"10(1) Where any mark has for not less than two years been bona fide used in the Colony upon or in connexion with any goods (whether for sale in the Colony or exportation abroad), for the purpose of indicating that they are goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, the person claiming to be the proprietor of the mark may apply in writing to the Registrar in the prescribed manner to have the mark entered as his registered trade mark in Part B of the register in respect of such goods.

(2) The Registrar shall consider every such application for registration of a trade mark in Part B of the register, and if it appears to him, after such search, if any, as he may deem necessary, that the application is inconsistent with the provisions of subsection (1) of section 12 or section 20, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application, or may accept it subject to conditions, amendments, or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application."

I will accordingly when referring to s. 10 of the Ordinance in this decision be referring to the former provisions.

Mr Liao submitted at the Hearing that for the purposes of s. 10 of the Ordinance if there is a minimum degree of capacity to distinguish then provided there is two years evidence of user the Registrar is not concerned with the extent of such user and is required to register the mark in Part B.

Mr Liao supported his submission by reference to a number of cases and to para. 8-72 of Kerly's Law of Trade Marks & Trade Names (11th Edition) ("Kerly 11th Edition") which refers to the position under s. 2 of the Trade Marks Act 1919 in the UK (the UK 1919 Act). A similar submission was made to the Assistant Registrar General

Mr Grindey in the Hong Kong case "Virginia Slims" Application No 646 of 1979 and was rejected by him in his decision dated the 28th March 1985. Mr Grindey considered the proposition at p. 6 of his decision in the following terms.

" There is no need to dwell on the advantages of a Part A over a Part B registration, and it will suffice to say that an applicant will prefer registration in Part A, but if that is not available he will normally try for registration in Part B. Under the Hong Kong provision evidence of at least two years user must be adduced, but provided that that is established it is argued that the Registrar then has less of a discretion whether or not to register the mark. There is no doubt that the Registrar still has some discretion because under Section 10(2) of the Ordinance he may refuse to register if it appears to him that the application is inconsistent with the provisions of Section 12(1) or Section 20 of the Ordinance, or if he is not satisfied that use in accordance with Section 10(1) has been established, or that it is capable of distinguishing the goods of the applicant. Those who argue that the discretionary power of the Registrar is less under this Section however point to the final words of Section 10(2) which indicate that unless the Registrar can point to a specific ground upon which he is not satisfied then he must accept the application. It is nevertheless perhaps pertinent to mention at this stage that Section 13(2) of the Ordinance does not differentiate between Part A or Part B of the Register and this states that subject to the provisions of the Ordinance the Registrar may refuse the application, or accept it absolutely or subject to such conditions, limitations etc. as he may think right."

After considering in some detail the case law and in particular the House of Lords decision in the "York" case "In Re York Trailer Holdings' Ltd"(1984 RPC 231) Mr Grindey at p. 21 of his decision concluded that -

"In view of the York decision extracts of which I have already quoted I think that this proposition is very doubtful as far as it concerns laudatory epithets and geographical names, and the geographical context of the Applicants' mark is to my mind predominant. In the context of this decision the burden is on the Applicants to prove that "Slims" is not a word which goes into the category of "laudatory epithets" and the like, which Lord Wilberforce mentioned when he referred to the accepted principle that "traders could not obtain a monopoly in the use of such words (however distinctive) to the detriment of the public"

The proposition put forward by Mr Grindey was accepted by Mr Justice Cruden in the appeal from Mr Grindey's decision (MP 1985 No. 2214).

I also note that in the 12th Edition of Kerly this question has been considered further in the light of the York case and para. 8-74 states as follows :

"After two years' use, however, any reasonable sort of mark ought to be more-or-less distinctive in fact, that is, have shown that it not merely could but did distinguish the goods of the applicant. So

virtually any mark in actual use should have been registrable. However, our courts had always taken the view that some words ought in no circumstances to be registered: words like "best", for instance. In the absence of any general discretion to refuse registration, these unsuitable marks were excluded by reading "capable of distinguishing" as meaning "capable of becoming fully distinctive" - adapted to distinguish, in the sense of section 9 - by further use. It followed that once a mark had become fully distinctive in fact, either it was registrable in Part A or it was not registrable at all. So "Liverpool Cables" decided; and "York" implies that it is still the law."

After considering the submissions and the case law I am of the view that the Applicant has to establish that the mark has been used for two years prior to the application and that the mark has some inherent capacity to distinguish but that if I consider that the Chinese characters "救心" do fall into the category of "laudatory epithets" or the like as envisaged by Lord Wilberforce then I do have a discretion to refuse registration of this mark even if it were established that the mark had become, in fact, 100% distinctive.

I turn first to a consideration of the mark applied for namely "救心 Kyushin" in Class 5 in respect of "heart tonic pills". As already stated the word "Kyushin" has already been registered in Part B and I propose to consider the meaning of the Chinese characters first before turning to a consideration of the mark as a whole.

Mr Liao at the Hearing submitted that the transliteration and translation of the characters in the mark are :

- characters	救	心
- transliteration	Gau	Sum
- translation	Safe	Heart

According to Mathew's Chinese-English dictionary the transliteration and translation is -

- characters	救	心
- transliteration	Chiu	Sum
- translation	To save	The heart

I am informed that "Gau" or "Kau" is the Cantonese transliteration/romanisation whereas "Chiu" is the Mandarin transliteration/romanisation. In this case the transliteration is not material to the point in question. The important aspect is the meaning given to the characters "救心".

Mr Liao submitted at the Hearing that these two characters used together were not a normal or customary usage of the two characters to describe the commodity in question nor was it a natural description of the character of the goods.

He submitted that the usual description of medicine is that it cures or heals and that it was unnatural to use the Chinese character "救" meaning "safe" relating to a disease. On questioning by me Mr Liao confirmed that although the combination of these two characters was unusual there was no meaning attributed to the two

characters together. From this I assume that the two characters together have no secondary meaning unrelated to the actual translations.

Mr Liao was most helpful in explaining to me the meanings of these words but in the absence of any independent evidence, I have taken note of the meanings attributed to these characters in two dictionaries namely Lin Yutang's Chinese-English Dictionary of Modern Usage ("Lin Yutang's") and Mathews' Chinese-English Dictionary ("Mathews").

In Lin Yutang's dictionary the following meanings for the character "救" are given namely -

- (1) To stop, prevent
- (2) To help, assist

In this dictionary this character is shown with other characters to give further meanings as follows:-

- | | | |
|-----|------|----------------------------------|
| (a) | 救治 | = to remedy (verb) |
| (b) | 救藥 | = a remedy (noun) |
| (c) | 不可救藥 | = (of sickness) incurable (noun) |
| (d) | 救命 | = to save someone's life |

In Mathews' dictionary the following meanings are given for the same character

- | | |
|----------------|----------------|
| (1) To save | (4) To relieve |
| (2) To deliver | (5) To aid |
| (3) To rescue | |

In Mathews' dictionary the combination with other characters reveals the following meanings -

- | | |
|----|---------------------------------|
| 救生 | - to save life |
| 救護 | - to save and protect, salvage. |

This dictionary also includes the same combination and meaning as given in Lin Yutang's Dictionary and as referred to in (c) & (d) above.

The meanings for the character "心" are given in Lin Yutang's Dictionary as having two slightly different meanings namely -

- (1) The heart
being the primary meaning and with the secondary meaning of the
- (2) The mind, intelligence
- (3) Feeling, thinking
- (4) Affection, love

This character is also shown in the dictionary with other characters to give other meanings and further emphasise the two different meanings given to the character "心".

Thus for the meaning (1) "the heart" there are the following combinations

心臟 - the heart organ
心臟病 - the heart disease
心悸 - palpitation of the heart

and for meaning (2) "the mind, intelligence" there are

決心 - set one's mind to
細心 - carefully

The meanings given in Mathews' Dictionary also, shows these two different meanings namely -

- (1) The heart
and
(2) The moral nature
(3) The mind
(4) The affections
(5) The intention

In this dictionary also the meaning of this character in combination brings out these two meanings to the character.

Compare 心病 - heart disease with 心非 - false at heart

No meaning is given in either dictionary for these two characters together.

Taking the dictionary meaning as above the primary meaning given by both Dictionaries of the two characters can be said to be "to save, the heart". I have little doubt that persons who can read Chinese characters would give those meanings to these two characters. The goods in question are heart tonic pills and I consider that the characters are on the face of it descriptive of the purpose for which one assumes the pills to be used i.e. to save, aid, etc. the heart and/or that they will keep the heart safe from disease.

I turn now to consider the evidence of user submitted by the Applicants. This reveals that the sales of their heart tonic pills for the six years immediately prior to the date of application, namely 1975-1980 totalled US\$3.9 m. The sales for the years 1975-1977 totalled US\$853,945 i.e. less than US\$1 m and then increased substantially in the years 1978-1980 to total US\$3.1 m. If one takes the rate of exchange in 1980 as US\$1 = HK\$5 then sales for the years 1978-1980 being the three years immediately prior to the date of the application totalled approx HK\$15.5 m.

The trend revealed by the sales figures shows steadily increasing figures for the years 1970-1973 increasing further during the period 1974-1977 and then an even larger increase in the years 1978-1980. As can be seen the same trend is reflected in the amounts spent on advertising which doubled in the years between 1975 to 1979.

The sales figures for the two years prior to the date of application are undoubtedly very impressive. It is not however clear whether this use is in fact in respect of the mark in the form applied for.

On examining the evidence of use from the copies of the advertisements I would summarise my conclusions as follows :-

- 1) The evidence shows that in the purchase orders and advertising invoices the only mark which is used is the word "Kyushin".
- 2) The copies of the actual advertisements show the use of the word "Kyushin" and "救心" separately in various forms but I have not seen in the evidence any examples of the mark in the exact form applied for.
- 3) In the majority of the advertisements it is my view that the predominant trade mark is the word "Kyushin".
- 4) There are examples of the use of the Chinese characters separately from the word mark in what I would accept to be trade mark use although in some cases I consider that the two characters are not used in strictly trade mark fashion. I refer in particular to the advertisement shown in the Appendix and Nod 2 and the use of the characters in the following form

- 救心 救心
- 快服 救心

I am informed that this can be translated as

- to save Heart to save Heart -
- Quickly take save Heart -

Although in some cases the characters are quite prominent it seems that in all cases the advertisements contained the word "Kyushin" although in some cases the word "Kyushin" only appears on the packet which is included as part of the advertisement.

- 5) The great majority of the advertisements includes a copy of the packet or container in which the pills are sold.
- 6) The evidence shows no examples of the use of the mark "救心" Kyushin" in the form applied. The nearest form of use of the two parts together is the use shown on the boxes in a few of the advertisements all marked as made in 1975. I set out an example in the Appendix and numbered 3.

I consider in conclusion that the evidence does establish that the word "Kyushin" is extensively used but the evidence as to the use of the Chinese characters as a trade mark is not so conclusive and I conclude that whilst the sales evidence is most impressive it could not be said the combination of the word "Kyushin" and the characters "救心", in whatever combination, has become 100% distinctive in fact.

The evidence has not established that the mark in the form applied for namely "救心" Kyushin" has in fact been used for two years prior to the date of the application. I consider therefore that the fundamental requirement of s. 10(1) of the Ordinance, namely that the mark has been used for two years immediately prior to the

application, has not been established and for this reason the application for " 救心 Kyushin" in Part B in respect of "heart tonic pills" has to be refused.

In the event that I am wrong in the interpretation of the provisions of s. 10(1) of the Ordinance I propose to consider further whether the mark could be accepted on the basis of the actual user of the two components of the mark as revealed by the evidence.

Mr Liao referred me to the Sheen case (13 RPC 1936 p. 355) and I note that in that case Mr Justice Luxmoore, in considering the appeal from the Registrar, referred to the "Perfection" case and set out at p. 367 the principles he determined should be taken into account when considering the registration of a non-invented word. That case dealt with an application in Part A but I believe the principles can apply to an application in Part B and I set these out in relation to this case as follows :

(1) If the word is not within paragraphs 9(1)(c) (an invented word) or (d) (having no direct reference to the character or quality of the goods) of the Ordinance then there must be a careful consideration of the merits of the particular case.

(2) The onus of satisfying the Registrar that the word is suitable is on the applicant.

(3) The applicant may discharge this onus by arguments based on the word itself and on the nature of the goods and by evidence sufficient to prove that by user the mark has become identified with the applicants goods and has acquired distinctiveness.

(4) The extent of proof required depends on the actual word to be registered. If the objections are not very strong then less evidence of use may be accepted.

(5) Certain words coming in the context of ordinary laudatory epithets such as "best" may not be capable of registration.

(6) The registration in question must not affect the use of other traders in any honest description of their goods.

To deal with the first of these principles it seems unlikely that the two Chinese characters even if they are an unusual combination can be considered as an invented word or words for the purposes of s.(9)(1)(c) of the Ordinance in the way for example that two words or parts of words in roman script could be telescoped together to become in some, but not all cases, an invented word such as "Ustikon".

It seems clear that I have to look at all the circumstances of this case and whilst I can look to the case law for guidance I have to decide, as a question of fact, whether the mark as applied for and as used is capable of distinguishing the goods in question. Mr Liao referred me to a number of cases all which I have noted and considered but I am faced with the fact that I have found no case law which deals with a mark in a form other than in the roman script.

Some of the points considered in the cases are therefore not entirely applicable to this case although they can be used as a guide. It is fairly well established for example that a mark which if it were in adjectival form would be directly descriptive does not become less descriptive merely because it is in a noun or a verb form.

Thus in the "Ustikon" case (In the Matter of Davis' Trade Mark (No 13 RPC 413)) Lord Hanworth states at p. 423 in relation to an invented word

"I do not think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form."

In the Sheen case Lord Wright refers to the word sheen as "... a word which is rather poetic and obsolete or in unfamiliar use and which is not customary in this particular connection."

On considering the various authorities therefore it seems that I should look at the overall impression given by the mark and not merely its literal construction and see how this would be viewed by the public and by other traders.

To consider this application in the light of these principles there is little doubt that the primary meaning given to the two characters " 救心 " is "to save, heart" and although this is not a normal usage it would seem that the primary impression of the two characters is of a description of the pills i.e. take these heart tonic pills to save or help your heart. Even though I am dealing with Chinese characters this must fall within the same general ambit as roman characters in adjectival rather than noun form and although not a usual form it has not been suggested that as a whole the two characters have any other meaning.

No evidence has been produced as to how members of the public would identify the goods and in the absence of any such evidence I have to conclude that on the face of it members of the public would consider and take note of the primary descriptive meaning.

The question I have to decide is whether the evidence has established that the use of the two characters " 救心 " together with the word "Kyushin" is such that a member of the public or other traders would consider the mark identified the applicants heart tonic pills and not be merely descriptive of the goods.

In considering this question I note that the Registry has always been of the view that the two characters are merely descriptive. I also note that the Applicants have produced no evidence either to show why such characters could not be used in normal usage or to confirm that it is an unusual combination although I accept that the lack of any dictionary meaning for the words together does give support

to the latter view. I note however that in the dictionaries each character is used with other characters to mean as shown above "heart disease" and more to the point "to save life".

I turn again to the evidence in this case. As I have already stated the evidence deals with the quantity of sales and the method of use in advertising. I am in considerable difficulty in that much of the evidence has not been translated but on the basis of the evidence I would consider that the main identifying trade mark is the word "Kyushin". The two characters are used but in no consistent fashion except that the most common use of the mark is on the package in the form referred to earlier in this decision. The onus on the Applicants is high as they have chosen two characters which are highly descriptive of their product and in many cases the use of their marks in advertising appears to emphasise its descriptive nature. Whilst the evidence of sales of their goods are very impressive I am not satisfied that the applicants have established 100% distinctiveness in fact in respect of any combination of "Kyushin" and the characters "救心".

Having considered the evidence and the submissions I am not satisfied that members of the public viewing the two characters would see any other meaning than that conveyed by the primary meaning i.e. to save, heart and, even if I had concluded that 100% distinctive had in fact been established, I consider that these two characters fall within the ambit of those marks which are too laudatory or descriptive to be allowed to be registered in either Part A or Part B of the Register.

In considering this case I have also taken some account of the fact that the mark includes the character "救" being "to save" and have noted Mr Liao's arguments in regard to this. I am dealing here with pharmaceutical preparations and I have to be particularly careful in allowing onto the Register marks which could imply that the goods are "safe" for example to use for the goods in question and this is particularly so in the case of pharmaceuticals.

I would refer to para. 10-35 of Kerly (11th) which refers to the "Vitasafe" case (1903 RPC 256) where Vitasafe was refused for vitamin preparations on the ground that registration of a mark containing the suffix "safe" might suggest some official guarantee that the goods were in all cases safe.

In considering whether a mark is capable of distinguishing I have to consider also whether other traders would wish to use the mark in describing their goods. Mr Liao contended that, as it was not normal usage to use these two characters together, then other traders could not legitimately use this in describing their goods but the use of "救心" for "to save life" does seem to me to leave open the possibility that these two characters could be used by other traders to denote their own similar goods.

Having considered all the evidence and the submissions I would refuse registration of the combination of "Kyushin" and "救心", in the various combinations shown by the evidence, to have been used, in both Part A and Part B of the Register in respect of "heart tonic pills" in Class 5.

Mr Liao at the Hearing indicated that if I refused the application then the Applicants would be prepared to accept registration of the mark with a disclaimer of the characters "救心".

Under the provisions of s. 16 of the Ordinance the Registrar may, in deciding whether to allow a trade mark to be entered in the Register, require any non-distinctive matter to be disclaimed.

Mr Justice Lloyd-Jacob's statements in the case in the Matter of Ford-Werke AG's application (1955 RPC 191), on the subject of disclaimers is relevant and the principles to be considered can apply to this application. At lines 30 to 38 on p. 193 Mr Justice Lloyd-Jacob states: "Nor would the position be any different were the Applicants' offer to enter a disclaimer to the exclusive right to the use of these letters be accepted. Such a disclaimer, while affecting the scope of the monopoly conferred by the registration, could not affect the significance which the mark conveys to others when used in the course of trade. If it be right to conclude that it is the letters "F" and "K" which constitute the feature of the mark which would strike the eye and fix in the recollection, this cannot be affected by what is or is not entered upon the Register housed at the Patent Office. Attention must, therefore, be focused upon the content of the mark, and not upon the content of the protection sought for the mark".

In this case there is no evidence of use of the mark in the form applied for and I consider therefore that I cannot allow the mark to be registered in Part B under the former provisions of s. 10 of the Ordinance even with a disclaimer of the characters "救心". In the event that I was permitted to do so I note that the characters "救心" in the actual form applied for dominate the word "Kyushin", the only registrable element, and members of the public could be led to believe that the characters which are so dominant were registered particularly as the mark in that form has not been tested by use. In view of the highly descriptive nature of the characters this would give an unwarranted advantage to the Applicants. I have noted the Trade Mark "Fab 快活" No B535 of 1975 to which I was referred by Mr Liao but the decision to allow registration in that case was decided on its own special circumstances and whilst I can take note of it I have to consider each case on its merits. Thus considering the mark "救心" Kyushin" in the form applied for I would still refuse registration of the mark in that form in Part B in Class 5 in respect of "heart tonic pills" even with a disclaimer of the characters "救心".

I have in reaching this decision considered the evidence of use and as a result I see that the mark has mainly been used on the packet as shown in Appendix and Nod 1. In view of the existing registration of the label under trade mark No 64 of 1965 the very extensive evidence of use of the mark in that form and the fact that the two characters are an unusual combination I would be prepared to consider favourably an application in Part B, if such application were to be made by the applicants, to register the label mark in the form already registered under TM No 64 of 1965 including the characters " 救心 " but with a total disclaimer of those characters in Class 5 in respect of "heart tonic pills".



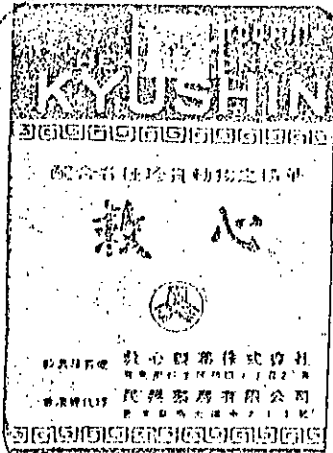
(A.C. Waters)(Miss)
Deputy Principal Solicitor

3/5 May 1988

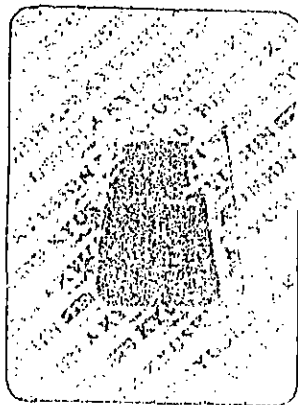
Appendix

1. Copy of Advertisement dated 1979
2. Copy of Advertisement dated 1976
3. Copy of Advertisement dated 1975

新藥 救心丸 購買 黃色封條 小心



圖A 外盒正面



圖B 盒內包裝

正貨黃色封條，印刷非常精美，其人像及線條精細清晰。紙質特別，絕對不能整張撕下，甚至極小心從其角邊輕輕挑起，此封條亦會支離折斷。

盒面上下花邊採用燙金印刷，色澤光亮。盒背中英文字體，清楚玲瓏。

謹防假冒

深啡色玻璃藥瓶均被光面鋁箔及透明塑膠啤壓封牢，其光面鋁箔印有紅色KYUSHIN，藥廠及總代理之商標

閣下如購買，委託郵購或代寄，請小心查察所收到之救心是否與上述要點不符，請逕向香港總代理洽詢。

包裝分：50粒，100粒，200粒

救心之三大主要作用：

- (1) 擴大冠狀動脈，使血液量充份達到心臟。
- (2) 解除心肌疲勞，改善自律神經能力。
- (3) 提高新陳代謝作用，而使面部筋脈旺盛。

主治：

- 神經衰弱，心氣氣滿，
- 年咳，盜汗，腦筋痛，
- 腸胃不潔，安心定神。

1913年面世

成份珍貴·功效超卓

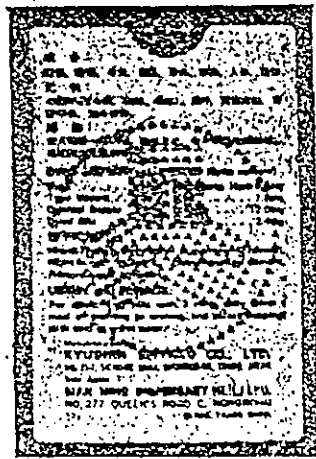


總代理：



KYUSHIN

救心 救心 快服救心!



正面 提防假冒影射 背面

為杜絕假冒影射，特在藥盒背面精印
無數細小暗黃色人字商標再組成一大人字
徽章(見圖)，以資辨別。

胸部沉悶·血脈紊亂·關節疼痛·腸胃病
心悸·心跳·氣喘·暈眩·盜汗·

特徵：

- 吸收快捷·功效神速·藥丸細小
- 攜帶方便·可以長服·無習慣性

凡通風報信而使違法假冒者落網定罪後
當即致酬一仟大元。

日本救心製藥株式會社出品

民興藥房有限公司

香港大馬路277號 電話：5-439712

KYUSHIN

提防假冒

EXPORT STANDARD 100 PILLS
HEART TONIC
KYUSHIN

配合各種珍貴動物之精華
心臟靈藥

救心

日本救心製藥株式會社
香港總代理 民興藥房有限公司
香港大道中277號

50 PILLS
HEART TONIC
KYUSHIN

配合各種珍貴動物之精華
心臟靈藥

救心

日本救心製藥株式會社
香港總代理 民興藥房有限公司
香港大道中277號

為圖杜絕假冒起見，特在盒背加印廠徽章——人字形底紋，並於盒面臨時貼上「新裝救心」字樣標誌，以資辨別。

100粒新裝“救心”開始發售

EXPORT STANDARD 100 PILLS
HEART TONIC
KYUSHIN

配合各種珍貴動物之精華
心臟靈藥

救心

日本救心製藥株式會社
香港總代理 民興藥房有限公司
香港大道中277號

茲為酬答廣大用家期待，製成100粒裝大盒“救心”發售，並將原有10粒裝小盒停止販賣，至於20粒及50粒裝則照常供應，敬請用家各位留意。

心悸・氣結・暈眩・盜汗
關節疼痛・胃腸不妥・定心安神。

特 徵

- ☆吸收快捷
- ☆藥丸細小
- ☆可以長服
- ☆功效神速
- ☆攜帶方便
- ☆無習慣性

香港總代理
民興藥房有限公司
日本救心製藥株式會社出品
香港大道中277號 電話：439712