

TRADE MARKS ORDINANCE (CAP 559)

APPLICATION FOR DECLARATION OF INVALIDITY OF TRADE MARK
REGISTRATION 200010561

MARK: CAT'S CLAW UÑA DE GATO 金貓爪

CLASS: 5

APPLICANT: GENERAL NUTRITION INVESTMENT COMPANY

OWNER: HO HENG TONG

STATEMENT OF REASONS FOR DECISION

1. On 8 November 2004, General Nutrition Investment Company ('the applicant') a company incorporated under the laws of Arizona, United States of America, applied to the Registrar of Trade Marks under the Trade Marks Ordinance (Cap 559) section 53(1) for a declaration of invalidity ('the application') of the registration of the trade mark CAT'S CLAW UÑA DE GATO 金貓爪. The trade mark, registration number 200010561, is registered in the name of Ho Heng Tong ('the owner') for goods in class 5.

2. The owner failed to file a counter-statement in the proceedings and as a result the application was treated as unopposed under Trade Marks Rule 41(3), as applied by rule 47. The applicant has filed evidence under rule 42 but has not called for a hearing, choosing instead to file written submissions. In the circumstances, rule 75 allows the registrar to decide a matter without a hearing and this decision is made on the applicant's pleadings, evidence and written submissions.

The registration

3. The trade mark:



is registered for 'natural drugs; all included in class 5'. The date of application and registration of the trade mark is 7 August 1999.

Application – grounds

4. The grounds for the application are that : under section 53(3) and section 11(1)(a) the trade mark should not have been registered as it was not a sign capable of distinguishing the goods; under section 53(3) and section 11(1)(b) the trade mark should not have been registered as it was devoid of any distinctive character; under section 53(3) and section 11(1)(c) the trade mark should not have been registered as it consisted exclusively of signs which may serve to designate characteristics of goods; under section 53(3) and section 11(1)(d) the trade mark should not have been registered as it consisted exclusively of signs which had become customary in the current language or in the trade.

Evidence

5. The applicant's evidence is the only evidence in the proceedings. It is in a statutory declaration made on 2 August 2005 by David J Sullivan, the applicant's

assistant secretary since 1999 who advises the business on regulatory developments regarding herbal supplement products.

6. Mr Sullivan states that the applicant is a wholly owned subsidiary of General Nutrition Centres Inc (GNC Inc) and was established for the purpose of holding title to the intellectual property of GNC Inc. Mr Sullivan gives details of GNC Inc's business as a leading provider of products, services and information for personal health care, worldwide. GNC Inc is engaged in the research, development, manufacture, marketing, sale and distribution of health and nutrition products, including herbal supplements, vitamins and minerals. It has two manufacturing plants and three distribution centres in the US.

7. The scale of GNC Inc's operations, the range of its products and its sales are substantial. Mr Sullivan exhibits a list of the products and a brief history of the business that grew from a small health food store established in Pittsburgh, Pennsylvania in 1935.

8. Mr Sullivan states that GNC Inc started manufacturing and selling herbal supplements containing cat's claw in about 1990. GNC Inc has sold herbal supplements containing cat's claw for over 15 years in the US, for more than 12 years worldwide and since 2003 in Hong Kong through franchising arrangements.

9. Cat's claw and *uña de gato*, the Spanish words for 'cat's nail', are common names for *uncaria tomentosa*, a plant or herb that originates from South America and that has been used by indigenous people there for a variety of health purposes.

10. Mr Sullivan states that the characters 貓爪 are a direct translation of the name cat's claw or *uña de gato* and they refer to and describe the herb. The character 金 means 'gold' or 'golden' and simply describes the colour of the herb.

11. GNC Inc produces cat's claw products in capsules packed in a plastic container with the words cat's claw shown prominently on the label. Cat's claw is used to describe the herb in the same way as the words ginger and cranberry, which appear prominently on the labels of GNC Inc's ginger and cranberry products, are used to describe the specification of those products. Mr Sullivan states that printing the common name of the herb on containers of herbal supplement products is common practice in the industry, as illustrated by container labels of herbal supplement products produced by another manufacturer.

12. Mr Sullivan exhibits information about cat's claw products and about the herb and its uses, which I refer to below.

Section 53(3) and section 11(1)(c) – mark exclusively designates goods

13. Under section 53(3) and section 11(1)(c) the applicant contends that the trade mark should not have been registered because at the date of the application for registration, it consisted 'exclusively of signs which may serve in trade or business to designate the kind, quality or other characteristics of the goods'.

14. The basis of the contention is that at the date of the application for registration of the trade mark, the terms cat's claw and uña de gato were common names of the South American plant or herb from which the goods, 'natural drugs', are produced.

15. The applicant's evidence refers to a number of publications that show the use of the names cat's claw and uña de gato as common names for the herb which has, or is believed to have, a beneficial effect in the treatment of a variety of diseases or disorders in humans (Exhibit JSS-3). References to the name cat's claw appear in extracts from publications dating from 1995, before the date of the applicant's

application for registration, which indicates that the name was already in use at that time as a common name for the herb (Exhibit JSS-3).

16. Extracts from the publications refer to uña de gato as a name for the herb (Exhibit JSS-3). The indications are that the name has been long used. The references to uña de gato as a name for the herb are as follows: ‘the Ashanika Indians of Peru have long regarded uña de gato tea as a sacred beverage: it is used as a cleansing and tonic herb for the immune, intestinal and structural systems’; ‘in traditional medicine of Peru, uña de gato is categorised as a ‘warm plant’ or more accurately, for warm conditions (inflammations)’; ‘in Peru, uña de gato tea is used as a medicinal herb’; ‘Urarina tribesman of Peru tell stories of uña de gato curing tumors’; ‘traditional wisdom shows that using the whole plant [uña de gato from the Peruvian rain forest] can be far more powerful than any one isolated ingredient’.

17. The evidence shows that the applicant has used the name cat’s claw to describe herbal supplement products containing the herb cat’s claw. The applicant has manufactured and sold cat’s claw herbal supplement products under the description cat’s claw since around 1990. By way of example, the evidence also shows how another manufacturer of cat’s claw herbal supplement products uses the name cat’s claw to describe its products.

18. The evidence does not relate to use of the name cat’s claw in Hong Kong, at least not before the date of the application for registration. The applicant only began selling products containing cat’s claw in Hong Kong since 2003, which is after the date of the application for registration. However, the lack of evidence of descriptive use of the name cat’s claw or uña de gato in Hong Kong, before the date of the application for registration, does not necessarily affect the applicant’s case. Under section 11(1)(c) it is enough that a sign ‘may’ serve to designate the kind or other characteristics of the goods. At the date of the application for registration, cat’s claw and uña de gato were common names for the herb. The words were therefore likely to be used in Hong Kong as the name of the herb or of a product derived from it.

19. The applicant's written submissions refer to *Windsurfing Chiemsee Produktions v Boots* [2000] 2 WLR 226 a judgment of the European Court of Justice on Article 3(1)(c) of the European Council Directive 89/104/EEC, which our section 11(1)(c) mirrors. The principle stated there (*at 231*) is that 'article 3(1)(c) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods and services in respect of which registration is applied for may be freely used by all Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks'.

20. Although *Windsurfing Chiemsee* was concerned directly with a mark designating geographical origin, the principles are applicable by analogy here. The court said there (*at 231*) that 'it is clear from the actual wording of article 3(1)(c), which refers to "indications which may serve to designate geographical origin', that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned. Thus, under article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.'

21. The use of cat's claw or uña de gato as a medicinal herb on any scale outside South America is fairly recent. The evidence indicates that research into the medicinal effects of the herb began only in the 1970's. If the herb or the product derived from it was little known or unknown in Hong Kong at the date of the application for registration, it was nevertheless likely that, as soon as there was a demand for the herb or the product here, there would be use of the names to describe it.

22. The fact that there are alternative names for the herb, including the botanical name *uncaria tomentosa*, cannot affect the issue. Under section 11(1)(c) it is

enough that a sign ‘may’ serve to designate the kind or other characteristics of the goods.

23. The evidence does not include use of the characters 貓爪 or 金貓爪. There is therefore no evidence at the date of the application for registration or shortly afterwards, that the characters were in use to describe the plant, herb or the product derived from it. Nonetheless, the question is whether the characters may serve, or in other words, are capable of serving as a descriptive indication in the future. Cat’s claw or uña de gato is a plant or herb that originates from the rain forests of South America. The use of cat’s claw as a medicinal herb on any scale outside South America is fairly recent. In the circumstances, it is reasonable to assume that the herb is not used in Chinese traditional herbal remedies and would not have acquired a name in Chinese independently of the English name cat’s claw as a result of any use of the herb in Mainland China or Hong Kong. At the date of the application for registration, it was therefore likely, at least in Hong Kong, given the use of English and Chinese here, that 貓爪, reflecting the English words, cat’s claw, would serve to designate the goods.

24. The applicant contends, rightly, that 金 simply describes the colour of the herb, which is a yellowish or golden colour, as the applicant’s evidence shows. The character 金 can also indicate goods or products of superior quality.

25. Given that cat’s claw and uña de gato are common names for the herb and that 金 describes its colour or quality, the likelihood that the characters 金貓爪 may serve as a description of the herb or the product derived from it is illustrated by the fact that, in the mark, the three terms cat’s claw, uña de gato and 金貓爪 are presented one after another, apparently as equivalent terms in three languages.

26. There is no graphic component to the mark. The presentation of the words: cat’s claw in large capital letters, uña de gato in small type and 金貓爪 in large type, all on a dark, square background: does not alter the fact that the mark consists of

nothing more than the three terms, cat's claw, uña de gato and 金貓爪. There is nothing fanciful that might give the mark, as a whole, a distinctive character.

27. For these reasons I find that cat's claw, uña de gato and 金貓爪 are terms that may serve to designate the herb and products derived from it. The mark consists exclusively of signs that, considered at the date of the application for registration, 'may' serve to designate the kind or other characteristics of the goods.

Section 53(3) and section 11(1)(b) – mark devoid of any distinctive character

28. Under section 53(3) and section 11(1)(b) the applicant contends that the trade mark should not have been registered as it was devoid of any distinctive character at the date of the application for registration.

29. The applicant succeeds under this ground as the mark consists exclusively of signs that may serve to designate the goods, for reasons I give above. As a result, the mark did not serve to identify the goods as originating from the owner and was devoid of any distinctive character at the date of the application for registration.

Invalidity

30. For these reasons, the registration of the trade mark 金貓爪 is declared invalid under sections 53(3) and 11(1)(b) and (c) in respect of all the goods for which the trade mark is registered.

31. I have decided the application under sections 53(3) and 11(1)(b) and (c) and I therefore do not need to consider the grounds under section 53(3) and sections

11(1)(a) and (d). However, I note that as a ground for invalidity, section 11(1)(d) similarly requires the position to be assessed at the date of application for the registration of the mark. It additionally requires that the ‘generic terms must actually be in current use, as opposed to being capable of being used in the future’ (*Kerly’s Law of Trade Marks and Trade Names 14th edition 8-113*). In this respect, the applicant’s evidence, which does not show actual use of the characters 金貓爪, may be insufficient to establish the ground.

Costs

32. As the invalidation has succeeded, I award the applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either the applicant or the owner makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap 4) as applied to trade mark matters, unless otherwise agreed.

Original Signed

(Teresa Grant)
for Registrar of Trade Marks
27 September 2006