

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION No.: 300029169

MARK: I'M LOVIN' IT

APPLICANT: McDonald's Corporation

CLASS: 29, 30, 32, 43

STATEMENT OF REASONS FOR DECISION

Background

1. Application to register the mark "I'M LOVIN' IT" in Classes 29, 30, 32 and 43 under the Trade Marks Ordinance (Cap. 559) ("Ordinance") was received by the Registry on 6 June 2003. The applicant of the mark was Global Restaurant Operations of Ireland Limited.
2. Application to register a registrable transaction (on Trade Mark Form T10) was subsequently received by the Registry in respect of the assignment of the subject application from Global Restaurant Operations of Ireland Limited to McDonald's Corporation. Particulars of the assignment were recorded on the Register on 20 November 2003.
3. The trade mark application was examined in accordance with the provisions of the Ordinance. Objection was raised under section 11(1)(b) of the Ordinance.
4. The applicant requested a hearing which took place on 23 August 2004. The applicant was represented by Mr. Kim Nicholson of Marks and Clerk. I reserved my decision at the end of the hearing.

The Ordinance

5. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1) provides:
 - "(1) Subject to subsection (2), the following shall not be registered-
 - (a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");
 - (b) trade marks which are devoid of any distinctive character;
 - (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; and
 - (d) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade."

6. The applicant did not file evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The applicant's submissions

7. Mr. Nicholson's submissions covered two areas - (a) the registrability of the mark based on a *prima facie* case; and (b) the relevance of overseas registrations to the present application.
8. Concerning the registrability of the mark, Mr. Nicholson's main submissions were as follows:
 - (a) Although the mark may be laudatory, it is not a phrase that people would normally employ in relation to these goods and services as it is couched in the present continuous tense.
 - (b) The degree of sentiment conveyed by the expression is excessive. It is the superabundance of laudatory sentiment that makes the mark distinctive.
 - (c) There is no evidence to show that the mark is commonly used by other traders. A search of the mark on the internet shows that most of the hits refer to the applicant.
 - (d) The phrase is an expression more likely to be uttered by consumers to describe their feelings towards a particular product. It is not likely that other traders would wish to use this mark in relation to their products.
 - (e) Slogans that are more descriptive and generic than the subject mark have been registered by the Registrar based on a *prima facie* case. Examples of slogans previously accepted for registration were quoted for comparison.
9. On the relevance of foreign registrations, Mr. Nicholson made the following submissions:
 - (a) It has been the practice of the Hong Kong Registrar to quote decisions of the UK courts and UK Trade Marks Registry that supported his views. However, the Registrar never took account of equally relevant registrations or decisions that did not suit his purpose.
 - (b) The subject mark was accepted for registration in Australia and New Zealand in the same classes based on a *prima facie* case. The relevant legislative provisions governing registrability of trade marks in Australia (sections 17 and 41 of Trade Marks Act 1995) and New Zealand (sections 5 and 18 of Trade Marks Act 2002) are effectively identical to sections 3 and 11 of our Ordinance.
 - (c) The Australian and New Zealand registrations are highly relevant to the present case and the Registrar should take account of these registrations when considering the registrability of the mark.

10. Copies of the certificates showing registration of the subject mark in the above-mentioned jurisdictions and extracts of the relevant legislative provisions were provided to me for reference.
11. In further support of his submission that the Registrar should take into account overseas acceptances of the mark, Mr. Nicholson quoted the following authorities:
 - (a) *Re Bausch & Lomb Incorporated*¹ ; and
 - (b) The following comment from Kerly's Law of Trade Marks and Trade Names²:

“The Examination Guidelines take a sensible approach, suggesting that weight may be given to registration in countries which are known to operate reasonably rigorous examination of applications, such as the United Kingdom, and this does occur in practice.”

Decision

Registrability of the mark based on a prima facie case

12. The mark “I’M LOVIN’ IT” is the abbreviated equivalent of the expression “I’M LOVING IT”. It is a slogan consisting of ordinary English words. The statement expresses a person’s passion or strong liking, desire or feeling for something.
13. It should be made clear at the outset that a slogan is not objectionable in itself as a trade mark. Furthermore, the criteria for the registrability of a slogan is no stricter than for other types of marks. Each slogan will be assessed on its own merits in relation to the goods or services in question.
14. The mark has to be examined, first of all, against the absolute grounds for refusal in section 11(1) of the Ordinance. The objection raised by the Registrar is that mark is “devoid of any distinctive character” under section 11(1)(b).
15. The phrase “devoid of distinctive character” has been subject to interpretation in a number of cases. In *British Sugar Plc v. James Robertson & Sons Ltd*³ Jacob. J. succinctly explained as follows:

“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?”

16. The meaning of “distinctiveness” was elaborated by the Court of Appeal in the

¹ HCMP 000203/1979

² Page 144 of Kerly's Law of Trade Marks and Trade Names 13th Edition

³ [1996] RPC 281

*Nestle SA's Trade Mark Application (Have a Break)*⁴, a case also concerning the registrability of a slogan. The test of "distinctiveness" was explained by the Vice Chancellor in the following manner:

"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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking."

17. Further, the Court of Appeal in *Nestle SA's Trade Mark Application* agreed with the conclusion of the hearing officer at the UK Trade Marks Registry and the matters considered by him in arriving at such conclusion. Of particular relevance to the present application is the observation made by the hearing officer that the reaction of the average consumer to a mark has to be assessed on the basis of normal and fair use of the mark in advertising the goods as well as on packaging.
18. In addition to the above cases, the meaning of "distinctiveness" was also discussed by Mr. Geoffrey Hobbs Q.C., acting as the Appointed Person in "*Cycling IS...*" *Trade Mark Applications*⁵ as follows:

"It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings."

19. Applying the above principles to the present application, I should consider the subject mark from the perspective of an average consumer of the applied-for goods and services who is reasonably well-informed and observant. Such a consumer would be exposed to a wide range of packaging and advertising techniques used by today's traders in promoting their products and services. He would be aware that catchy expressions and slogans are commonly employed by traders for advertising purpose. On the above basis, I need to ask myself either of the following questions:
 - (a) Would the average consumer perceive the subject mark as identifying the relevant goods and services as originating from a particular undertaking?
 - (b) Assuming that the subject mark were independently used by different suppliers of goods or services of the kind specified in the subject application

⁴ [2004] FSR 2

⁵ [2002] RPC 37

for registration, would the average consumer believe that the goods or services on offer to him came from the same undertaking?

20. In the context of food products and drinks in classes 29, 30 and 31 and restaurant services in class 43, the mark is a direct statement that describes, from a consumer's point of view, his strong liking for the relevant goods and services. It conveys an immediate and direct message that the products and services appeal to consumers. It is a laudatory statement that expresses a consumer's positive feelings towards certain products or services.
21. With respect to the first question referred to in paragraph 19 above, I do not think that an average consumer with the qualities mentioned in that paragraph would, on seeing the mark, regard it as identifying that the relevant goods or services originate from a particular undertaking. Rather, upon seeing the mark being used on packaging or in advertising the goods and services concerned, it is likely that he would consider it as a mere promotional statement used for advertising purposes. Applying the principles in *British Sugar Plc v. James Robertson & Sons Ltd*⁶, consumers would have to be educated, through use of the mark, before they would regard it as a trade mark which serves to guarantee the origin of the goods and services.
22. With regard to the second question, since the subject statement will merely be perceived by the average consumer as an advertising slogan and not having the function of identifying the origin of the goods or services concerned, it follows that independent use of the statement by different suppliers in relation to their goods or services is unlikely to cause such consumer to believe that the goods or services come from the same undertaking.
23. Mr. Nicholson submitted that it is the superabundance of laudatory sentiment that makes the mark distinctive. He also submitted that the mark is an expression that is uttered by a consumer and therefore, it is unlikely that other traders would wish to use it in the course of their business.
24. I do not agree with Mr. Nicholson's submissions. Highly laudatory and exaggerated statements are often used in advertising. Moreover, it is a common technique for advertisers to present their products and services as seen from the perspective of users as it would have a more direct impact on the target consumers.
25. Mr. Nicholson mentioned that consumers would normally use the expression "I LOVE IT" to describe their liking for certain things. It is unlikely that they will express the statement in the present continuous tense.
26. Even assuming that it is more usual for consumers to express their feelings by "I LOVE IT" rather than "I'M LOVIN' IT", I do not consider that the grammatical difference is sufficient to confer distinctive character on the subject mark. From the point of linguistic communication, both expressions convey the same basic information namely, consumers are fond of the goods or services in question.

⁶ Paragraph 15 above

Expressing the statement in the present continuous tense would not alter the average consumer's perception that the subject mark is a mere promotional statement and does not serve as a guarantee of the origin of the goods and services in question.

27. Mr Nicholson further submitted that the mark was not commonly used by other traders. Internet search for the mark shows that most of the hits refer to the applicant. No doubt, internet search could assist in ascertaining whether a mark/an expression is now commonly used in the trade. However, the fact that a particular mark is not currently used by other traders could not demonstrate that the mark possess distinctive character. The crux of the matter is whether the mark would be seen by the average consumer as a badge of origin. For the reasons discussed above, I do not consider that the subject mark could serve this purpose unless consumers are first educated of its function through the use of the mark.
28. For the reasons stated above, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Relevance of previous acceptances by the Registrar

29. Mr. Nicholson referred me to a number of slogans that were accepted for registration by the Registrar based on a *prima facie* case. In his view, those slogans are more descriptive or generic than the subject mark. I have reviewed the registrations quoted by Mr. Nicholson. I consider that most of the quoted examples are not on par with the present application. Furthermore, I do not think it appropriate to make direct comparisons between different marks on the register. Each case has to be considered on its merits. This issue has been discussed in *British Sugar Plc v. James Robertson & Sons Ltd* where Jacob. J. said:

“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* ([1966] RPC 541) and the same must be true under the 1994 Act.”

Relevance of foreign registrations

30. Mr. Nicholson explained that as the mark was accepted for registration in Australia and New Zealand based on a *prima facie* case, there was no written decision explaining the reasons for the acceptances. He drew my attention to the Trade Mark History in IP Australia's website that showed the prosecution history of each trade mark application.
31. My attention was also drawn to the comments made by Zimmern, J. in *Bausch and Lomb Incorporated (Soflens)* to the effect that the Hong Kong Trade Marks Registry should not turn a blind eye to the trade mark laws of other Commonwealth countries. I was therefore asked to take into account registrations of the subject mark in Australia and New Zealand.

32. In administering our trade mark laws, it is common for the Registrar to make reference to court decisions as well as registries' decisions in other jurisdictions. This was the practice under the repealed Trade Marks Ordinance (Cap. 43) and is still the case under the current Ordinance. Having said that, it is important to note that the reference value of different practices and decisions might differ. The Registrar has an obligation to administer the trade mark laws in accordance with the Ordinance and in a fair and reasonable manner. He should not simply follow an overseas decision without due regard to the issues considered by the overseas authorities as well as the rationale behind such decision. For this reason, the Registrar would place more weight on those decisions in respect of which written grounds of the decisions are available to him.
33. The relevance of foreign registrations to trade mark examination was also discussed by the Appointed Person, Mr. Geoffrey Hobbs Q.C., in *Automotive Network Exchange Trade Mark*⁷, where he said:
- “National trade mark rights are territorially limited and granted independently of each other in accordance with the principles stated in Article 6 of the Paris Convention. When a sign is presented for registration under the 1994 Act, the question for consideration is whether it is capable of functioning satisfactorily as a trade mark in relation to goods or services supplied or to be supplied in or from within the United Kingdom: The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here.”
34. I agree with Mr. Nicholson that the subject mark appeared to sail through to acceptance in Australia without objection. Like Mr. Nicholson, I also have no doubt that the Australian Trade Marks Registry maintains a rigorous examination process. However, the fact remains that the information available merely shows that the subject mark was accepted based on a *prima facie* case. I am unable to ascertain the reasons and rationale behind the acceptances.
35. Mr. Nicholson quoted an observation in Kerly's to support his submission that the Hong Kong Registrar should take into account decisions of registries with rigorous examination procedures. However, it is important to read the observation in the context of the relevant paragraph concerning Community Trade Marks. In paragraph 7-18, the authors discuss the relevance of registrations of the same mark in other EU countries in the following manner:

“The [*OHIM*] Examination Guidelines take a sensible approach, suggesting that weight may be given to registration in countries which are known to operate reasonably rigorous examination of applications, such as the United Kingdom, and this does occur in practice. More often than not, the existence of registrations in other countries is treated as insufficient to overcome the reasoning already expressed, particularly where no information is supplied concerning the circumstances or criteria taken into account which lead to the registrations in question. Even if a national trade mark office has held a

⁷ [1998] RPC 885

mark to be sufficiently distinctive to warrant registration, the Boards of Appeal have stated that the same finding does not necessarily have to be reached by the examiner 'who must in each case make his own assessment as to the existence of absolute grounds for refusal.'"

36. To conclude on this issue, I have taken account of the acceptances of the subject mark in Australia and New Zealand in assessing the present application. However, the bare fact of registrations, without more, is of limited assistance to this case. The Registrar is under an obligation to make his own assessment on the registrability of a mark submitted for registration. Where there are strong reasons for refusal of a mark under the provisions of the Ordinance, it would not be right for me to simply follow the decisions of other registries especially where reasons for such acceptances are not available.

Conclusion

37. I have considered all documents filed by the applicant, the submissions made by Mr. Nicholson during the hearing and the documents provided on behalf of the Applicant in relation to this application. For the reasons stated above, I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.

Maria K. Ng
for Registrar of Trade Marks

21 December 2004