

## TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300085761

A SHARPER IMAGE

B Sharper Image

C sharper image

MARK:

CLASSES: 7, 8, 9, 10, 11, 12, 14, 18, 20, 21, 28, 35

APPLICANT: SHARPER IMAGE CORPORATION

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### STATEMENT OF REASONS FOR DECISIONS

#### Background

1. On 29 September 2003, Sharper Image Corporation (the “applicant”) applied to register the subject mark under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”).
2. Registration is sought in classes 7, 8, 9, 10, 11, 12, 14, 18, 20, 21, 28 and 35. A full list of the specification is set out in the *Annex*.
3. At the examination stage, objections were raised against certain goods and services in classes 8, 9, 20 & 35 of the subject application under section 11(1)(b) and (c) of the Ordinance on the basis that the mark consists exclusively of a sign which may serve, in trade or business, to designate the quality, intended purpose and/or characteristics of the objectionable goods and services and it is also devoid of any distinctive character in respect of those objectionable goods and services.
4. The objectionable goods and services are:-  
Class 8: “electric nasal hair trimmer”, “electric manicure sets”, “electric shaver”, “hair remover”, “twin-blade razor”, “cuticle scissors”, “tweezers” and “razors”;  
Class 9: “combination DVD/CD player and sound generator”, “video camera”, “video player”, “TV”, “hand-held TV”, “automatic eyeglass cleaner”, “digital camera”, “electric hair straightener”, “wireless security camera and monitor”, “photographic, cinematographic, optical apparatus and instruments”, “apparatus for recording, transmission or reproduction of images”, “data processing equipment and computers” and “video games”;

Class 20: “mirror; magnified mirror”; and

Class 35: “advertising”

5. At the same time of making written submissions (respectively on 25 January 2005 and 24 October 2005), evidence of use of the mark was filed on 25 January 2005 with a view to overcome the objections. In reply, the Registrar of Trade Marks (the “Registrar”) commented on the evidence in her letter dated 27 April 2005, maintaining her objections on the basis that in its totality, the evidence did not show that the mark had in fact acquired a distinctive character through use in respect of the objectionable goods and services before the date of application for registration under section 11(2).
6. Thereafter, the applicant applied for an extension of time for a period of 3 months until 27 October 2005 with the reasons that it “needed more time to collect evidence of use to attend to the objections”. The extension was granted by the Registrar as requested. On 24 October 2005, the applicant filed further submissions (but no evidence) with the Registrar.
7. The Registrar in her first opinion (dated 6 August 2004) reminded the applicant that the application could proceed to registration if the objectionable goods and services were deleted from the specification. Additionally, in the Registrar’s further opinion (dated 27 April 2005), the applicant was again reminded that the outstanding objections only apply to certain goods and services in classes 8, 9, 20 and 35. As such, the applicant might divide the subject application into two divisional applications, one covering classes 7, 10, 11, 12, 14, 18, 21 and 28, and the other covering classes 8, 9, 20 and 35. Upon the division, the first divisional application could proceed to registration. However, prior to the expiry of the prescribed deadline, no request to amend the specification or to divide the subject application was filed.
8. On 23 December 2005, the Registrar issued a notice of her decision to refuse the subject application under rule 91(1) of the Trade Marks Rules (Cap. 559 sub. leg.). Pursuant to Rule 91(2) of the Rules, the applicant requested a statement of reasons for the Registrar’s decision. The statement of reasons is now given as follows.

### **The Ordinance**

9. The absolute grounds for refusal of an application for registration are contained

in section 11 of the Ordinance. Section 11(1) & (2) reads as follows:

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

(a) ...

(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) ...

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

10. In addition to arguing that the mark is *prima facie* acceptable, the applicant has also filed evidence of use of the mark. I therefore have to consider the *prima facie* case as well as the question whether the objections are overcome by the evidence filed.

## **Decision**

### *Prima facie case*

#### Section 11(1)(c) of the Ordinance

11. Section 11(1)(c) of the Ordinance excludes from registration trademarks 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.
12. This section is broadly similar to Article 7(1)(c) of Council Regulation (EC) No. 40/94 (the “Regulation”). Therefore, the disqualifying criteria as discussed in the European Court of Justice (ECJ) case of *Wm. Wrigley Jr. Company v. OHIM* (Case-191/01 P) (the ‘*Doublemint*’ case) which concerns Article 7(1)(c) of the Regulation are relevant. In ‘*Doublemint*’, the relevant principles are set out as follows:-

*“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of the Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned”*: the ‘Doublemint’ case at paragraph 32.

13. In the instant application, the subject mark consists of the words “Sharper Image”. According to dictionaries, “sharp” means “clear in outline or detail”, e.g. a sharp image (*Merriam-Webster’s Online dictionary*). It could also mean stylish, (too) smart, intelligent and outwitted (*Collins English Dictionary* and *Oxford English-Chinese Dictionary*). On the other hand, “image” means “a representation or likeness of a person or thing” or “the personality presented to the public by a person, organization, etc.” (*Collins English Dictionary*). Therefore, the term as a whole connotes a representation or image that is sharper, clearer or more distinct.
14. In the light of the above, when the words “Sharper Image” are used in relation to the applied-for goods such as “electric nasal hair trimmer”, “electric manicure sets”, “electric shaver”, “hair remover”, “twin-blade razor”, “cuticle scissors”, “tweezers” and “razors” in class 8 and “electric hair straightener” in class 9, the mark merely describes or lauds to consumers that such goods could bring about sharper or improved personal images of the users, and therefore it only designates the intended purpose and characteristics of the goods.
15. To this, the applicant argued that the mark is not descriptive of the aforesaid objectionable goods in classes 8 and 9 because people will not suddenly look intelligent and smart just because they have used the aforesaid products. To my mind, although users may not suddenly look more intelligent and smart just because they have used the aforesaid products, such products certainly could contribute to the users’ overall personal images. In my view, the words “Sharper Image” do convey the laudatory and descriptive message that use of the products would allow the users to have sharper and improved personal images. The mark merely lauds the function and the intended purposes of the

aforesaid goods.

16. In respect of the class 9 goods such as “combination DVD/CD player and sound generator”, “video camera”, “video player”, “TV”, “hand-held TV”, “automatic eyeglass cleaner”, “digital camera”, , “wireless security camera and monitor”, “photographic, cinematographic, optical apparatus and instruments”, “apparatus for recording, transmission or reproduction of images”, “data processing equipment and computers” and “video games”, the mark “Sharper Image” appears to me to merely denote that the goods could produce high quality image output or nice visual image display as all of the goods are closely concerned with the function of visual image display.
17. In this connection, the applicant argued that the mark does not describe the quality and effect of “data processing equipment” and “computer” in class 9, because first, they are not specified for processing or modifying images, and secondly, even if they are, it is the software that does the work but not the data processing equipment or the computer themselves.
18. I cannot agree to the submissions above. This is because the specified items “data processing equipment” and “computer” are wide enough to cover those specifically for the purpose of processing images. In fact, “data processing equipment” and certain other types of hardware do facilitate better visual quality. Computer as comprising both hardware and software certainly does the job also. Additionally, since computers do display visual images as one of their many functions, I consider “Sharper Image” only serves to describe their quality or characteristics, i.e. they are able to produce sharp or sharper image.
19. The applicant also argued that people do not sit to admire the sharpness of the images that the goods “video games” generate. To this, it is well established that it is not necessary for the characteristic being designated to be an essential characteristic. It is enough for it to be merely ancillary. The relevant authority is *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) (the ‘Postkantoor’ case), where it says:-

*“For the purpose of determining whether Article 3(1)(c) of the [First Council Directive 89/104/EEC] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the*

*characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.*”: the ‘Postkantoor’ case at paragraph 104.

(This case is relevant as Article 3(1)(c) of the First Council Directive 89/104/EEC (the “Directive”) is effectively identical to Article 7(1)(c) of the Regulation as mentioned in paragraph 12 above.) In any event, as video games involve visual image display, I am of the view that sharpness of images would also be one of the desirable characteristics of “video games”.

20. As regards the goods “mirror; magnified mirror” in class 20, in my view, the mark only denotes that the goods could produce sharper visual image. As such, the mark merely designates the quality and characteristics of the goods.
21. The applicant submitted that the sharpness of an image in a mirror or magnified mirror depends only on the sharpness of the object, not the quality of the mirror so that the mark should not be descriptive of these goods. Again, I cannot agree as poor quality mirrors, e.g. mirrors with unsmooth surfaces or other defects may well produce blurred images.
22. In respect of the applied-for “advertising” services, the mark only indicates that the services could bring about distinct corporate or enterprise image for customers.
23. The applicant submitted that its “advertising” services only concern the sale of (the applicant’s) “existing products”, but not promoting brands or company image for others. According to this elaboration, I do not think what the applicant has in mind is something contemplated by the term “advertising” in class 35 of the Nice Classification, 8<sup>th</sup> Edition. The authentic meaning of “advertising services” should, in my view, concern the *services* of advertising for others instead of the act of promoting one self’s goods or services. In any event, the specified term “advertising” in the specification covers the advertising services of promoting and enhancing the images of others, e.g. corporate / enterprise image of corporate customers, or public image of individual entrepreneurs. In respect of such services, the mark “Sharper Image” faces the objection that it is descriptive of the services because the services seek to promote and enhance one’s image so that one could enjoy a “sharper image”.

24. In view of the above, I am of the view that the mark merely designates the quality, intended purpose or characteristics of the objectionable goods and services under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

25. This section precludes from registration trademarks which are devoid of any distinctive character. In the instant case, it operates as a separate and independent ground of objection from the objection under section 11(1)(c) of the Ordinance.

26. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 at page 306, Jacob J said: -

“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?”

27. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at para. 23):

“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.”

28. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must serve as a badge of origin to identify the goods or services as originating from a single undertaking, and thus distinguishing them from those of other undertakings, and I must assess such distinctiveness in relation to the goods or services for which registration is sought taking into account the presumed perception of the relevant consumers.

29. In the present case, the relevant consumers are members of the general purchasing public who are likely to buy the *goods* and individuals or bodies corporate who may want to engage the *services* as set out in the *Annex*.

30. As mentioned, the subject mark consists of the plain words “Sharper Image” without stylization or any added element. Also as traversed in paragraphs 11-24 above, the mark merely conveys certain descriptive meanings as to the quality and intended purpose of the objectionable goods and services. As such, I consider that upon viewing the mark in relation to the aforesaid goods and services, the relevant consumers will only immediately perceive the mark as a description of the quality and the intended purpose of the goods and services, i.e. they bring about or produce “sharper image”. Consumers will not, without first being educated, perceive the mark as identifying that the goods or services are originating from a particular undertaking. The overall impression the mark creates to consumers is likely to be a descriptive one and the mark does not serve to assist the consumers in distinguishing the applicant’s goods from those of others. Therefore, the mark is also considered to be devoid of any distinctive character under section 11(1)(b). Absent use, the mark does not satisfy the requirement of registration.

*Evidence of use, section 11(2) of the Ordinance*

31. In assessing whether a mark has acquired a distinctive character as a result of the use made of it, the principles as discussed in the ‘*Windsurfing Chiemsee*’ Case (Cases C-108/97 and C-109/97) are relevant. This case concerns the interpretation of Article 3(3) of the Directive, which is broadly similar to section 11(2) of the Ordinance. At paragraph 54 of the case it is said that:-

*“a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings”*

It is also said in the same paragraph that the competent authority must make an overall assessment of the evidence in determining the question.

32. The applicant filed evidence of use of the mark on 25 January 2005 by way of a statutory declaration of Andrew J. PARKER (S/D). Having carefully considered the evidence, I am of the view that the evidence does not in its totality establish that the mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2). The reasons are as follows.
33. The majority of the evidence does not show *Hong Kong* use of the mark in relation to the applied-for goods and services *before the date of application for*

*registration*. For instance, the “Sky Mall” in-flight catalogue in Exhibit A, being the Spring 2004 issue, post-dates the date of application. Other leaflets in Exhibit A do not bear a date of use and do not reveal Hong Kong use. Some of the sample invoices in Exhibit B are post-dated and most of the invoices are irrelevant because they relate to goods which are not objected to, e.g. air-purifiers and radios. Furthermore, no date of use of the products shown in Exhibit C is provided and again, the pictures of products do not indicate Hong Kong use.

34. Evidence on the sales figures declared in paragraph 10 of the S/D does not specify the *currency*, and *no advertising figures* are supplied to indicate whether the mark has been sufficiently put before the public so as to educate them to recognize it as a badge of trade origin of the applied-for goods and services. The advertising flyers in Exhibit D do not state the date of advertisement. In any event, these advertisements only concern air-purifiers, which are not objected to. Also, the appointment of STL Electronics Ltd. which apparently only sells air-purifiers on behalf of the applicant does not assist.
35. Use of the mark in relation to various goods and services cannot be verified from the exhibits to the S/D filed:
  - (a) The objectionable goods in class 8 cannot be verified. Although there is a picture showing a “Traveler’s Personal Care Kit” in Exhibit C, which may include the goods, there is no indication that it actually consists of the specific items of the objectionable goods. In any event, there is no indication of pre-application Hong Kong use.
  - (b) Similarly, the objectionable goods in class 9 cannot be verified. The pictures marked as “apparatus for recording transmission or reproduction of images; photographic apparatus and instruments” only show a picture album and a photo-frame respectively. Besides, the one marked as “optical apparatus and instrument” only shows a swimming mask. Although applicant’s goods such as “hand held TV”, “video games” and “binocular” are shown in Exhibit C to the S/D, there is no indication that these relate to pre-application Hong Kong use.
  - (c) Certain invoices exhibited in the S/D show that “DVD Power Tower” and “CD Power Tower” bearing the subject mark were sold to consumers in Hong Kong at certain pre-application times. However, it is uncertain whether these

goods are the same as the applied-for goods “combination DVD/CD player and sound generator” in class 9.

(d) Despite that “mirror” and “magnified mirrors” in class 20 are shown to be the applicant’s products in Exhibit C of the S/D, again, the relevant catalogues do not bear the date and place of use. There is no indication that the goods were subject to pre-application Hong Kong use.

(e) “Advertising” services cannot be verified from the evidence of use filed.

36. In fact, the comments given in paragraphs 31 – 34 above were already provided to the applicant by the Registrar in her letter of 27 April 2005. The applicant was also invited to file further evidence to show pre-application Hong Kong use of the mark in relation to the objectionable goods and services. However, prior to the expiry of the prescribed period, no further evidence was provided. Also, in the applicant’s further submission made on 24 October 2005, the applicant did not address the Registrar’s various concerns on the evidence as raised in her letter of 27 April 2005, e.g. in respect of the currency and the advertising figures.

37. In view of all of the foregoing, I conclude that the evidence filed in support of the application does not show that the mark has, prior to the date of application, in fact acquired a distinctive character in Hong Kong, as a result of the use made of it in respect of the objectionable goods and services under section 11(2). Accordingly, the objections under section 11(1)(b) & (c) cannot be overcome and have to be maintained.

#### *Overseas registrations*

38. In Exhibit E to the S/D, information on certain overseas registrations together with other Hong Kong registrations was provided. However, the UK registration in class 25 concerns a different mark. As regards the Singaporean registrations in Classes 9 & 28 and the French registration, the mark(s) registered and the corresponding specifications are not shown or provided. For the US, European Community and Hong Kong registrations, the specifications are not the same as that in the present application. For the Japanese registration, the specifications are not accompanied by its English/Chinese translation. In view of all these, the quoted overseas and the Hong Kong registrations are of little assistance to the

subject application.

39. I would add that trade mark rights are territorially limited and granted independently by each jurisdiction. The bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration in Hong Kong (*Automotive Network Exchange Trade Mark* [1998] RPC 885).

*Prior registrations*

40. By letter of 24 October 2005, the applicant put forward two examples of prior registrations, i.e. QUICKWORD (for alphanumeric message entry units for radio pagers) and SMARTWARE (for computer programmes) both in class 9. The applicant argued that as these marks describe the quality and effect of the respective registrants' goods, they should stand no chance of registering at all. Google search of the term "SMARTWARE" to show its common use was provided.
41. I have considered these quoted examples of registration. However, I am of the view that these marks are not comparable with the subject mark because first, the registered goods are different from the applied-for goods and services of the subject application, and secondly, they consist of other distinctive elements rendering them overall registrable. In any event, it should be appreciated that each case must be considered on its own merits and facts but not by reference to other marks that were judged registrable on other occasions. As I have found good grounds for refusing the subject application, I do not believe the example registrations can assist the subject application.

*Others*

42. The applicant also argued that Hong Kong consumers are exposed to the US products/services (and likewise, the applicant's goods and services) via mass media (e.g. US magazines available locally and TV programs like "Sex and the City") and the Internet on a daily basis. Yet, without any evidence, I cannot ascertain whether Hong Kong consumers have come to recognize the subject mark as a badge of trade origin in relation to the applied-for goods and services due to these factors.

**Conclusion**

43. For the reasons given, I conclude that the subject mark is precluded from

registration by sections 11(1)(b) and 11(1)(c) of the Ordinance, and the subject application is accordingly refused registration under section 42(4)(b) of the Ordinance. In this decision, I have considered all the submissions made and evidence filed by the application in respect of the subject application.

Doreen Wan  
for Registrar of Trade Marks  
14 February, 2006

## Annex

### Class 7

vacuum cleaner; robot vacuum cleaner; electric can opener; electric grinder for household use; electric food processor; machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; ultrasonic jewelry cleaner.

### Class 8

electric nasal hair trimmer; electric manicure sets; electric shaver; hair remover; twin-blade razor; cuticle scissors; tweezers; hand tools and implements (hand-operated); cutlery; side arms; razors.

### Class 9

combination DVD/CD player and sound generator; combination CD/radio and sound generator; combination clock/radio and sound generator; sound generator; video camera, video player, CD stereo, radio, TV; hand-held TV; wireless weather information apparatus with atomic clock; two-way rechargeable radios; wireless electronic locator; automatic eyeglass cleaner; digital camera, digital alcohol breath analyzer; electric hair straightener; electronic insect-trapping device; electric insect-trapping device; kitchen scale; electronic scales; wireless indoor/outdoor thermometer; wireless security camera and monitor; electronic dog training device; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; motorized CD holder; motorized DVD holder; video games.

### Class 10

massage chair; blood pressure measurer; heart rate and calorie monitor wristwatch, nausea treatment wristwatch; foot massager; hand-held percussion massager; body fat analyzer scale; motorized pill dispenser; surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

### Class 11

air purifier; air cleaner; automobile air purifier; hair dryer; color-changing night light; flashlight; booklight; electric fan; mini electric fan; nail-care blow-dryer equipment; refrigerating containers; ice box; lamp; combined TV/radio and lantern; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; toaster.

#### Class 12

scooters; electric scooters; bicycles; electric bicycles; vehicles; apparatus for locomotion by land, air or water.

#### Class 14

digital alarm clocks; alarm clocks; LCD screen alarm clocks; watches; wireless atomic clock with weather information apparatus; precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

#### Class 18

leather travel case; wallets; traveling bag; luggage; carry-on bag, umbrellas; leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

#### Class 20

mirror; magnified mirror; motorized tie organizer; inflatable beds; foam mattress topper; pillows; sleeping bag; furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

#### Class 21

wine opener; corkscrew; wine agitator; foil cutter; coffee maker; electric toothbrush; comb; ion-generating hair brush; ion-generating pet brush; warm/cold cup holder; household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

#### Class 28

games and playthings; toy cars; toy planes; toy robots; electronic toy musical instruments; portable mini exercise cycle; mini exercise stepper; foldable elliptical strider; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

#### Class 35

sales for others via on-line; office work relating to mail order selling; online office work for receiving orders for goods by computers for others; business management; store management; advertising; marketing research; provision of information about sale of goods; retail store and on-line retail store services in the fields of home, yard, automobile, electronics, entertainment, sports, personal care, office and travel products; business administration; office functions.