

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300196434AB

MARK: SAVE THE CHILDREN

CLASSES: 9, 16, 35, 36, 41, 42, 43, 44 and 45

APPLICANT: International Save the Children Alliance

STATEMENT OF REASONS FOR DECISION

Background

1. This is an application of International Save the Children Alliance (the “applicant”) made on 15 April 2004 to register the mark “SAVE THE CHILDREN” under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”). Registration is sought in classes 9, 16, 35, 36, 41, 42, 43, 44 and 45. A full list of the specification is set out in the *Annex* to this decision. It is a divisional application derived from an application bearing application number 300196434.
2. At the examination stage, objections were raised against the subject application under section 11(1)(b) of the Ordinance on the basis that the mark is devoid of any distinctive character.
3. On 27 May 2006, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 8 February 2007 at which Ms. Lucy Headington-Horton of Messrs. Baker & McKenzie appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.

The Ordinance

4. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 read 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) ...
- (d) ...

5. Notwithstanding the provisions in the preceding paragraph, section 11(2) provides that—

(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.”

6. At the hearing, Ms. Headington-Horton filed on behalf of the applicant evidence of use of the mark by way of a statutory declaration dated 6 February 2007 of one Mr. Simon Michael Cowell. Therefore, I have to determine, first whether the mark is devoid of any distinctive character for the purpose of section 11(1)(b), and if so, whether it has nevertheless in fact acquired a distinctive character as a result of the use made of it under section 11(2).

The applicant’s submissions

Inherent distinctiveness

7. Ms. Headington-Horton submits that the mark “Save the Children” is capable of distinguishing the applicant’s goods and services from those of other undertakings because the mark has no direct meaning in relation to the applied-for goods and services. The word “save” has many connotations and when used in relation to the applied-for goods (such as CDs or printed matters) and services, Ms. Headington-Horton contends that the mark is cryptic in nature as it does not literally convey the message of saving children’s lives. Therefore, in Ms. Headington-Horton’s view, the mark is merely allusive and would be seen as an appeal to help or save children. Leading authorities including *British Sugar Plc v James Robertson & Son Ltd. (‘Treat’)*¹, *Nestle SA’s Trade Mark Application (‘Have a Break’)*², and *“Cycling Is...” Trade Mark Applications*³ are referred to.

8. Ms. Headington-Horton puts forward that most charities choose a name that

¹ [1996] RPC 281

² [2004] FSR 2

³ [2002] RPC 37

alludes to their charitable cause for obvious reasons. For instance, the subject mark needs to be allusive in order for public attention to be drawn to the needs of children. Ms. Headington-Horton argues that before making contribution to charities, there will be some degree of thoughts or awareness on the part of the consumers for the charities, so that they can be donating to the cause of their choice.

9. Conceding that the mark may arguably be a weak mark, Ms. Headington-Horton points out that a trade mark is not necessarily a work of invention or is not necessarily founded on any elements of originality or imagination. A minimum degree of distinctive character is sufficient to render inapplicable the absolute grounds for refusal. According to Ms. Headington-Horton, while the mark does not reflect a particularly high degree of inventiveness, it does enable consumers to identify the origin of the applicant's goods and services. Ms. Headington-Horton stresses that it is the viewpoint of the relevant public that should be considered. Authorities including *Sat 1 Satelliten Fernsehen v OHIM ('Sat 2')*⁴ and *Eurocool Logistik GmbH v OHIM*⁵ are referred to.
10. Ms. Headington-Horton also relies on *Erpo Möbelwerk GmbH v OHIM ('Das Prinzip der Bequemlichkeit' (or 'The Principle of Comfort'))*⁶ to contend that the mark's capacity to communicate to consumers the trade origin of the applied-for goods and services should not be affected by its being a slogan or promotional statement or otherwise, because no stricter criteria should be imposed for assessing the distinctiveness of trade marks consisting of slogans. Ms. Headington-Horton submits that in any event, average consumers are nowadays more aware of slogans or promotional statements and would recognize them as trade marks.
11. Ms. Headington-Horton said a Google search has been conducted for the phrase "save the children", which indicates that the mark is predominantly used by the applicant. In any event, Ms. Headington-Horton cites *British Sugar Plc v James Robertson & Son Ltd.* and submits that the relevant test for assessing distinctiveness of a mark is no longer whether other traders are likely without improper motive to desire to use the mark in connection with their own goods, but rather can the mark itself distinguish one trader's goods from the goods of

⁴ [2005] ETMR 20

⁵ Case T-34/00

⁶ [2005] ETMR 58

others.

12. Ms. Headington-Horton also refers to various overseas trade mark registrations obtained for the subject mark, including a community trade mark registration, and registrations in other places such as Ireland, Papua New Guinea, Nigeria, South Korea etc. The applicant has also obtained an International Registration for the subject mark which designates places such as Albania, Armenia, Azerbaijan, Benelux etc. Ms. Headington-Horton submits that these registrations ought to be taken into account.
13. *Bausch and Lomb Incorporated v. the Registrar of Trade Mark ('Soflens')*⁷ and *The Art of Living in Balance*⁸ are quoted and relied on. In the former case, it was said that the Registrar should not just turn a blind eye to the laws of trade marks of other friendly commonwealth countries with whom Hong Kong trade, such as New Zealand, Singapore and Malaysia. In the latter case, it was said that registration in the United Kingdom should serve as one indication in the overall assessment of a mark, particularly when the language in which the mark applied for is alleged to be descriptive is an official language of the jurisdiction in question.

Acquired distinctiveness

14. In the alternative, Ms. Headington-Horton submits that the subject mark has in fact acquired a distinctive character as a result of the use made of the mark in Hong Kong for the purpose of section 11(2) of the Ordinance. References are made, *inter alia*, to the first date of use of the mark in Hong Kong in 1997 and income figures dating back to 1999 as contained in the bulk of evidence filed.
15. Ms. Headington-Horton also contends that the evidence provides details of use of the mark in Hong Kong with copies of articles, leaflets, newsletters and other promotional materials dating back to 1997.

Decision

Inherent distinctiveness

⁷ [1979] HKLR 309

⁸ Case R 197/2001-2

Section 11(1)(b) of the Ordinance

16. This section precludes from registration marks which are devoid of any distinctive character. The relevant principles relating to distinctive character were laid down in *British Sugar Plc v James Robertson and Sons Ltd (supra)*, where 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?”⁹

17. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)(supra)*—

“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.”¹⁰

18. It is also established that marks possessing distinctive character must be able to guarantee the identity of a trade origin. In *Libertel Groep BV v Benelux-Merkenbureau*¹¹, the European Court of Justice held that—

“It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin... A trade mark must distinguish the goods or services concerned as originating from a particular undertaking...”¹²

19. It follows that I have to, by applying the above legal principles, assess the distinctiveness of the subject mark in relation to the goods and services for which the applicant seeks registration, having regard to the perception of the average consumers who are reasonably well-informed and circumspect.

20. The subject mark consists of the words “save the children”. They are ordinary English words that hardly require dictionary definitions. In any event, I note that “save” is defined to mean “to rescue, preserve, or guard (a person or thing)

⁹ [1996] RPC 281 at 306

¹⁰ [2004] FSR 2, at paragraph 23

¹¹ Case C-104/01 [2003] ETMR 63

¹² *Ditto*, paragraph 62

from danger or harm” (*Collins English Dictionary*). Read in its entirety, the mark carries the meaning of rescuing, preserving or guarding the children from danger or harm, or other plights or difficulties. There is no other added element or stylization in the mark.

21. On first impression, the mark is simply a general phrase of appeal for efforts or endeavours to help or save the children.
22. Specifically, when used in relation to the applied-for goods *such as* magnetic data carriers, recording discs, DVDs (class 9), printed matter, and newsletters (class 16) etc., the mark immediately communicates to consumers that the content or the subject matter of the goods are relating to helping or saving children. It is also likely to be perceived by consumers as meaning that the goods are offered in support of or provided in connection with some charitable cause relating to helping or saving children from harm or danger, or other plights or difficulties.
23. Similarly, when the mark is used in relation to the applied-for services *such as* business operation services relating to retail shops and on-line shops (class 35), charitable fundraising and support services relating to promotion of the welfare of children and humanitarian aid and development (class 36), education, training, entertainment, sports and cultural activities (class 41), brand licensing services (class 42), services for providing food and drinks including catering, temporary accommodation (class 43), counselling services (class 44), personal social services rendered by others to meet the needs of individuals and community services, and promoting the welfare of children and humanitarian aid and development (class 45) etc., consumers are likely to perceive the mark as conveying the message that those services are offered in support of (directly or indirectly) or provided in connection with some charitable cause relating to helping or saving children from harm or danger, or other plights or difficulties.
24. With the aforesaid connotations, I do not see that the mark is cryptic or merely allusive in nature in the context of the applied-for goods or services. Rather, it clearly communicates to consumers the objective and the charitable cause behind the provision of the applied-for goods and services, namely, to help or save the children. Such an expression of the relevant objective and charitable cause is origin-neutral. It remains a general phrase to call for efforts or endeavours to help or save the children only. That being the case, consumers will not without first being educated perceive the mark as identifying or guaranteeing without confusion that the applied-for goods and services are originating from a particular undertaking. It also means that they cannot simply rely on the mark to assure themselves that they are donating to *the* charitable body of their choice.

25. I also gain support for this finding from *Nestle SA's Trade Mark Application (Have a Break)(supra)*¹³, where it was said that a mark although not wholly descriptive may nevertheless lack any inherent trade mark character.
26. Additionally, given that the mark represents a charitable cause and is a general phraseology, the mark is apt to be used by others to appeal for help or efforts to be directed to children. In such event, the mark also fails to assist consumers to distinguish the applicant's goods and services from those of others.
27. The fact that most websites retrieved by Google search of "save the children" are related to the applicant does not necessarily mean that the mark has an inherent trade mark character. Internet searches are not determinative. Given my finding above as to the presumed consumers' perception of the mark, I do not consider that the Google search results can assist the subject application. In any event, I must have regard to the "interest of the public not only of today but of tomorrow and the day after" (*Colorcoat Trade Mark*¹⁴).
28. No different or stricter criteria must be imposed for assessing the distinctiveness of trade marks consisting of slogans. However, the objection for the subject mark is not founded on its being a slogan or otherwise, but on the relevant connotations it carries and its generality as explained above. Despite Ms. Headington-Horton's submission that nowadays consumers are more aware of the use of slogans or promotional statements as trade marks so that they would view them as indicators of trade origin, no evidence is produced to establish that consumers will necessarily and invariably behave in the way as submitted. In any event, as consumers are constantly exposed to advertising expressions and slogans for purely promotional purpose, they may not readily accept a slogan as an indication of trade source as they may in the case of a traditional indication of trade source, such as word brands, logos and figurative marks (*Nestle SA's Trade Mark Application (Have a Break)(supra)*)¹⁵.
29. I have considered the overseas registrations and the relevant legal authorities referred to by Ms. Headington-Horton. However, I do not find them to be of assistance to the subject application. It should be noted that national trade mark rights are territorially limited and granted independently of each other. It is also well established that the bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). In the instant case, as I have

¹³ [2004] FSR 2, at paragraph 21

¹⁴ [1990] RPC 511 at 517

¹⁵ [2004] FSR 2, at paragraph 22

found good reasons for refusing the subject application, I am not prepared to simply follow the decisions of other registries. This is especially so when the reasons and rationale behind the acceptances are not available before me. I should also add that on the information before me, the subject mark has not been registered in commonwealth countries such as the UK and Singapore.

30. In the premises, the mark is considered to be devoid of any distinctive character in respect of the applied-for goods and services for the purpose of section 11(1)(b) of the Ordinance. The mark is accordingly precluded from registration under the section.

Acquired distinctiveness

31. I now proceed to consider whether the mark has in fact, as a result of the use made of it, acquired a distinctive character for the purpose of section 11(2). The relevant date is the filing date of the subject application, that is, 15 April 2004.

32. In assessing whether a mark has acquired a distinctive character as a result of the use made of it, the principles laid down in the ‘*Windsurfing Chiemsee*’ Case¹⁶ 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.

Worldwide use of the mark

33. Evidence of use of the mark is filed on behalf of the applicant by way of a statutory declaration (“S/D”) dated 6 February 2007 by Mr. Simon Michael Cowell, in his capacity as the Director of Secretariat Services of the applicant. He says the applicant consists of 28 independent Save the Children organizations from around the world and it has started to use the mark “Save

¹⁶ Cases C-108/97 and C-109/97

the Children” in the 1920’s on an international scale, in respect of services in the areas of children’s education, helping children with HIV/AIDS, [prevention of] exploitation and abuse of children, helping children suffering from conflict and natural disasters, helping children in emergencies and long-term campaign for change of governmental policies and practices to improve children’s lives (paras. 5 & 8 of S/D).

34. Mr. Cowell states that the aim of the applicant is to make education and health care available to all children, and the applicant has been involved in many education projects around the world and other charitable projects, e.g. in Ethiopia, Northern Iraq and lately, in Asia, in the incident of the devastating earthquake and tsunami occurred on 26 December 2004. The applicant’s worldwide annual income figures between 2001 and 2005 range from US\$432 to 991 million (para. 14 of S/D).

Use of the mark in Hong Kong

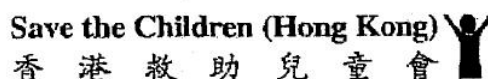
35. As to the use of the subject mark in Hong Kong, according to Ms. Headington-Horton at the hearing, the use is made via the applicant’s licensee in Hong Kong, or in Mr. Cowell’s words in the S/D, via the applicant’s Hong Kong member organization known as “Save the Children Hong Kong” (“SCHK”). First use of the subject mark in Hong Kong was made in 1996. Mr. Cowell states that there has been continuous use of the mark since 1996. Between 1999 and 2005, the annual income figures derived from Hong Kong range from US\$ 714,000 to around US\$ 1 million (para. 31 of S/D).
36. The relationship between the applicant and SCHK was terminated, however, in April 2006. In the relevant Termination Agreement, all rights in the name “Save the Children” in English have been assigned back to the applicant. A copy of the Termination Agreement is provided in exhibit 5 of the S/D.
37. Mr. Cowell deposes that the subject mark has been used in Hong Kong on services that are related to children’s welfare, including but not limited to charitable fund-raising services, providing training, entertainment, sports and cultural activities to children, and providing aid in material and financial form and providing counseling to children and their families. Specifically, the mark is used in charitable activities such as “Drawing Angels Near”, “Slam Dunk Basketball Challenge”, “Hallowalk” etc. Mr. Cowell exhibits certain relevant

materials purporting to show use of the subject mark in respect of the applied-for goods and services.

38. Upon reviewing the evidence, I find that some of the materials exhibited are not materials concerning Hong Kong, e.g. the list of multi-national corporations with which the applicant is a partner in exhibit 1, and printouts from the websites of American Express, Microsoft, BP and Pepsi Co. in exhibit 2 etc.
39. Meanwhile, some materials are post-dating the date of application and hence cannot be taken into account. Examples are the donation flyer for the Asian earthquake and tsunami (which occurred in December 2004) distributed in Hong Kong, as contained in exhibit 3; the copy registration form for “Hallowalk” for year 2004 (held on 31 October 2004) in exhibit 8. The printouts of web-pages of the Hong Kong International Airport (dated 2 December 2004) and Kids’ Gallery (dated 2005) in exhibit 13 also postdate the date of application for registration of the subject mark.
40. The pre-application date evidence shows that in actual use, the subject mark appears in the following formats for most of the time—



(1)





(2)



(3)

(the “composite marks”)

41. It is noted that the subject mark is predominantly used in conjunction with “Hong Kong”, “Fund (Hong Kong)”, “香港救助兒童會”, and the device “” or “”.

42. I reckon from the ECJ's judgment of *Nestle SA's Trade Mark Application (Have a Break)* (*supra*) that there is no bar to a mark acquiring a distinctive character as a result of its use as part of another trade mark. However, on the evidence before me, despite that the relevant consumers might have been exposed to the composite marks, I find it unlikely that the subject mark itself would have been relied on by the relevant consumers as a trade mark.
43. It appears from the body of evidence that it is the composite marks, rather than the subject mark, that have been promoted as trade marks. The overall impression of the subject mark is also very different from the whole of any of the composite marks. Despite the use of the composite marks, when the phrase "save the children", which constitutes the entirety of the subject mark, is used alone, it remains a mere simple and ordinary phraseology which is apt to be used by many as a general appeal for help or endeavours to address children's needs. I therefore do not find that by virtue of the use of the composite marks, the relevant consumers have come to regard or rely on the subject mark as identifying or guaranteeing that the applied-for goods and services are originating from a given undertaking. I borrow support from *British Sugar Plc v James Robertson and Sons Ltd (supra)*, where Jacob J. said—

"Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin..."¹⁷

"There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark... It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader..."¹⁸

44. So far as the subject mark as exactly applied for is concerned, only meager use

¹⁷ [1996] RPC 281 at 286

¹⁸ *Ditto*, at 302

can be identified in the exhibits, which is mainly restricted in headings or lines of texts of the exhibited materials. Usually, such use does not appear to constitute trade mark use. In totality, the evidence leaves much to be desired.

45. On the whole, I am not satisfied that the evidence filed is sufficient to show that the subject mark has come to be identified by a significant proportion of the relevant consumers as an indication of trade origin distinguishing the applicant's goods and services from those of others for the purpose of section 11(2). It follows that the objection raised under section 11(1)(b) against the subject application cannot be overcome pursuant to section 11(2).

Conclusion

46. In this decision, I have considered all the documents filed by the applicant, together with all oral and written submissions made in respect of the subject application. For the reasons stated above, I find that the subject mark is objectionable in respect of the applied-for goods and services under section 11(1)(b) of the Ordinance, which objection has not been successfully overcome by evidence of use in accordance with section 11(2). Accordingly, this application is refused under section 42(4)(b) of the Ordinance.

Doreen Wan
For Registrar of Trade Marks
13 July, 2007

Annex

Class 9

apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; data processing equipment and computers; sound, video and data recordings and carriers, audio cassette tapes, video tapes, DVD's, compact discs, records, tapes, cartridges, digital audio and video compression files, jpegs, images and cards; pre-recorded motion picture films and sound films prepared for exhibition; computer software, software for use in delivering and receiving video on demand services, downloading an audio/video stream from a global computer network, word processing, organisation of data, accessing the Internet; downloadable electronic publications, including audio and video streaming provided on line from a database or the Internet; computer and video games programmes and equipment; electronic games video game machines for use with televisions; interactive computer game discs; mouse mats; CD-ROM's; electrically, magnetically and optically recorded data recorded on optical discs for computers; electronic instructional and teaching apparatus and instruments; sound, video and data recording and reproducing apparatus; virtual reality game software and video game machines for playing the software; television and radio signal transmitters and receivers; audio and video streaming via the Internet; audio and video on demand services; and parts for all the aforesaid goods.

Class 16

paper, cardboard, and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; plastic materials for packaging (included in this class); adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); printers' type; printing blocks; playing cards; pens; envelopes; greeting cards; plastic bags; writing paper; note books; calendars; banners; badges; letterheads; newsletters; brochures; leaflets; tickets; invitations; raffle tickets; lapel stickers; programmes; newsletters; promotional materials all in relation to the national and international relief of distress and hardship, promoting the welfare of children and humanitarian aid and development.

Class 35

the organisation, operation and supervision of loyalty and incentive schemes; advertising and promotional services; provision of business information; all in relation to the national and international relief of distress and hardship; business operation services relating to retail shops and on-line shops; providing information relating to socially responsible

business practice; information and consultancy services in relation to the aforesaid services; brand management services.

Class 36

insurance; financial affairs; monetary affairs; real estate affairs; financial services in relation to the national and international relief of distress and hardship, charitable fundraising and support services relating to promotion of the welfare of children and humanitarian aid and development; including charitable fundraising and support services; charitable collections; charitable fund raising; food, clothing and medical charity donations; child sponsorship services; sponsoring international student exchange programs; managing and monitoring of charitable funds; distribution and allocation of charitable funds; credit cards and charge card services; financial arrangements to facilitate charitable giving; providing of information regarding corporate donations and payroll donations by employees; information and consultancy services in relation to the aforesaid services; providing financial aid to children and their families.

Class 41

education; training; entertainment; sports and cultural activities; including educational and instructional services relating to international humanitarian aid and development; publication of books, texts, leaflets, reports and magazines, all in relation to the national and international relief of distress and hardship; education and training in relation to promoting the welfare of children and humanitarian aid and development; information and consultancy services in relation to the aforesaid services.

Class 42

brand licensing services.

Class 43

services for providing food and drinks, including catering; temporary accommodation; information and consultancy services in relation to the aforesaid services.

Class 44

medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; counselling services; midwife services; hospital and health care services; information and consultancy services in relation to the aforesaid services.

Class 45

all forms of services in connection with international humanitarian aid and development and all forms of services for advancing the rights of children in accordance with the United Nations Declaration on the rights of the child; providing aid in material form (non-financial) to children and their families; personal and social services rendered by others to meet the needs of individuals and community services; promoting the welfare of children and humanitarian aid and development.