TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300210761

MARK :

CLASSES : **3, 21**

APPLICANT : 精工衞生紙業有限公司
(SEIKO TISSUE PAPER INDUSTRIAL COMPANY, LIMITED)

OPPONENT : **THE PROCTER & GAMBLE COMPANY**

STATEMENT OF REASONS FOR DECISION

Background

1. On 7 May 2004 ("Application Date"), 精工衞生紙業有限公司 (Seiko Tissue Paper Industrial Company, Limited) ("Applicant") filed an application ("subject application") under the Trade Marks Ordinance (Cap. 559) ("Ordinance") for registration of the following mark ("subject mark"):

Registration is sought in respect of the following goods ("subject goods"):

Class 3
牙膏、漱口水、洗髮水、護髮素、沐浴露、肥皂、潤手膏、化妝品、護膚品、清潔用啫喱、香料、精油、洗衣粉、洗手液、洗衣用漂白劑及其他物料、清潔、擦亮、去漬及研磨用製劑。
(Toothpastes; mouth wash; shampoos; conditioners; bath soaps; soaps; hand cream; cosmetics; skin care preparations; cleansing gel; perfumery; essential oils; laundry detergent powder; hand soaps; bleaching preparations and other

substances for laundry use; cleaning, polishing, scouring and abrasive preparations.)

Class 21
牙刷、牙線。
(Toothbrushes; dental floss.)

2. Particulars of the subject application were published on 18 June 2004. The Procter & Gamble Company ("Opponent") filed a notice of opposition to the subject application on 17 September 2004 ("Notice of Opposition") with a statement of the grounds of opposition ("Grounds of Opposition").

3. The Applicant filed a counter-statement on 16 December 2004 ("Counter-Statement") in response to the Notice of Opposition.

4. The Opponent's evidence consists of:-

(i) a statutory declaration of Carl J. Roof declared on 7 July 2006 ("Roof's Declaration"); and

(ii) a supplementary statutory declaration of Carl J. Roof declared on 6 September 2006.

5. The Applicant did not file any evidence before the end of the prescribed period under the Trade Marks Rules (Cap. 559 sub. leg.) ("TM Rules").

6. The opposition hearing took place before me on 12 December 2008 and 8 January 2009. Mr. Robin Gregory D'souza, Counsel, instructed by Messrs. Tam, Pun & Yipp appeared for the Applicant. Mr. Philips B. F. Wong, Counsel, instructed by Messrs. JSM appeared for the Opponent.

Preliminary issues

7. After notice of the opposition hearing under rule 21 of the TM Rules was issued on 13 October 2008, Messrs. Tam, Pun & Yipp for the Applicant indicated in their letter dated 24 October 2008 to Messrs. JSM (copied to the Registrar) that they would "in due course" seek leave from the Registrar to

amend the Counter-Statement and adduce evidence on behalf of the Applicant. No draft amendments to the Counter-Statement and no draft statutory declaration as to the evidence proposed to be adduced were provided.

8. By a letter dated 21 November 2008, the Applicant sought leave to:

   (i) amend the Counter-Statement in the manner shown in the draft attached to that letter ("Draft Amended counter-statement"); and

   (ii) file and serve evidence within three months from the date of the relevant direction.

   Both applications for leave were provisionally refused by the Registrar on 4 December 2008. The Applicant indicated that it would like to be heard on those two applications, which were dealt with as preliminary issues at the beginning of the hearing on 12 December 2008.

Application for leave to file evidence

9. The six-month period for the Applicant to file evidence under rule 19 of the TM Rules ended in March 2007. The Applicant did not file any evidence during the prescribed period. Rule 20(3) provides that except with the leave of the Registrar, no further evidence may be filed. The presumption, therefore, is that no further evidence shall be filed and that if an application is made pursuant to rule 20(3) to admit evidence, it must be sufficiently meritorious to discharge that presumption.

10. Even up till the date of the hearing on 12 December 2008, which was more than 20 months after the end of the prescribed period under rule 19 of the TM Rules, the Applicant still had not identified the evidence which it sought to adduce. There could be no justification at all for granting leave to the Applicant to file evidence which it had not even identified.

Application for leave to amend Counter-Statement

11. Rule 92 of the TM Rules provides that:

"Subject to any provisions of the Ordinance or these Rules relating to the amendment of applications for registration of trade marks and other documents, any document filed with the Registrar may, if the Registrar thinks fit, be amended on such terms as he may direct."

12. By the proposed amendments marked in the Draft Amended counter-statement, the Applicant sought to:

(a) plead facts which had essentially been covered in the Counter-Statement, but in some case inconsistent with[1], and in others, with less precision than[2], what had already been pleaded in the Counter-Statement;

(b) make various submissions, which were not pleadings of facts;

(c) split up the denial in paragraph 9 of the Counter-Statement to the allegations in paragraphs 3 to 13 of the Grounds of Opposition essentially into separate denials in paragraphs 3 to 13 of the Draft Amended counter-statement; and

(d) include some irrelevant matters[3].

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[1] For example, it was stated in para. 1C of the Draft Amended counter-statement that "[d]uring the early 1980s, the Applicant created the [subject mark]"; this is inconsistent with para. 3 of the Counter-Statement where it was stated that "[t]he Applicant has adopted and used the [subject mark] … since 1978".

[2] Examples include:

(i) Whereas it was stated in para. 3 of the Counter-Statement that '[t]he Applicant has adopted and used the [subject mark] in respect of "toilet tissues, paper towels, pocket size tissue and handkerchief tissue" ("the said goods") in Hong Kong since 1978 and the Applicant has used the [subject mark] in a number of foreign countries, such as U.S.A., Taiwan, Australia, South Korea and Malaysia, on the said goods', para. 15(a) of the Draft Amended counter-statement merely stated that the subject mark "has been in use in Hong Kong and internationally since 1978 and is still being used" without stating in respect of what goods and in which foreign countries the mark had been used.

(ii) Whereas turnover figures of "the said goods" (defined as "toilet tissues, paper towels, pocket size tissue and handkerchief tissue") from 1.4.1999 to 31.3.2004 were given in para. 5 of the Counter-Statement, the same turnover figures appeared in para. 15(d) of the Draft Amended counter-statement but they were stated to relate to "the Applicant's products" which were not defined.
In any event, no evidence of use has been submitted by the Applicant to support any of these claims.

[3] For example, in para. 10(5) of the Draft Amended counter-statement, which purported to answer para. 10 of the Grounds of Opposition and the ground of refusal under section 11(4)(b) of the Ordinance, the Applicant stated, *inter alia*, that "there are no other conflicting trade marks that may cause likelihood of deception". Section 11(4)(b) of the Ordinance is, however, intended to apply where the deception alleged arises from the nature of the mark itself. It does not deal with the relative rights of an

13. The Applicant has filed no evidence in support of any of its claims in the Counter-Statement and the Draft Amended counter-statement.

14. Having carefully considered each of the proposed amendments in the Draft Amended counter-statement, I conclude that none of them would in any way assist in the determination of the real questions in controversy between the parties in this opposition. I also noted that leave to amend the Counter-Statement was applied for at a very late stage in the proceedings and after the substantive opposition hearing had been set down.

Orders

15. Having taken into account all the relevant circumstances, I considered that leave for the Applicant to amend the Counter-Statement in the manner proposed and to file evidence would not be justified. I ordered at the hearing on 12 December 2008 that:

    (1) the Applicant's application for leave under rule 92 of the TM Rules to amend the Counter-Statement be refused;

    (2) the Applicant's application for leave to file further evidence under rule 20(3) of the TM Rules be refused;

    (3) costs of both applications (1) and (2) above, including costs of the hearing on 12 December 2008 in respect of those applications, be to the Opponent, to be taxed if not agreed.

16. The Applicant sought to have the hearing on the substantive opposition adjourned, which the Opponent resisted. With some reluctance, I adjourned the hearing to 8 January 2009, and ordered that costs thrown away by the adjournment be borne by the Applicant, to be taxed if not agreed, to be paid forthwith.

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applicant and other parties (*QS by S. Oliver Trade Mark* [1999] R.P.C. 520 at 524). The claim that there are no conflicting trade marks, even if proved, is no answer to an objection under section 11(4)(b) of the Ordinance.

Opposition under section 11(1)(b) of the Ordinance

17. Section 11 of the Ordinance provides, *inter alia*, as follows:

> *"(1) Subject to subsection (2), the following shall not be registered –*
>
> *... (b) trade marks which are devoid of any distinctive character;*
>
> *... (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."*

18. The Applicant has filed no evidence of use in this case. I have, therefore, only the *prima faci*e case to consider.

19. In *British Sugar Plc v James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 306, Mr. Justice Jacob stated 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? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive inherently character."*

20. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a mark to possess a distinctive character, it must serve to identify the product or service in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product or service from those of other undertakings (*Eurohypo AG v OHIM* (Case C-304/06 P) [2008] E.T.M.R. 59). A mark's distinctiveness must be assessed, first, by reference to the products or services in respect of which registration has been applied for, and, secondly, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in

question (*Koninklijke KPN Nederland v Benelux Merkenburea* (Case C-363/99) (Postkantoor) [2006] Ch 1 at 27).

21. The subject mark consists of the numeral '7' and the word 'days' represented in the manner set out in paragraph 1 above.

22. The subject goods are everyday items related to hygiene and cleanliness. They are aimed at all consumers, and accordingly, the relevant public consists of ordinary members of the public, who are reasonably well informed and reasonably observant and circumspect.

23. "7 days" is a familiar expression in its normal grammatical form which designates a period of time, namely seven days, or a week. It can be used, *inter alia*, on the packaging of goods, in advertising and promotion of goods, and in instructions for use, to designate that time period for a variety of purposes, including the period over which a product should be used to achieve certain desired result, the period during which a product or certain effects of it will last, the delivery period for the product, the period for special offers, that usage of the product should follow a 7-day plan, or the period during which a product may be returned for refund if the customer is dissatisfied with it, to name a few.

24. Some examples (which are not exhaustive) of how "7 days" can be used are found in the advertisements and promotional materials of various traders included in Exhibits 2 and 3 to Roof's Declaration. I will just set out a few by way of illustration:

- "VISIBLE WHITENING in 7 DAYS" in relation to whitestrips for teeth:

- “Longer, Stronger Nails in 7 Days” in relation to nail varnish
- “7-Day Whitening Magic” in relation to skin whitening preparations
- “Colgate Simply White Advanced 7 Days Formula … CLINICALLY PROVEN TO SAFELY & EFFECTIVELY WHITEN TEETH IN 7 DAYS” in relation to teeth whitening gel
- “A NEW Line Eliminator Dual Retinol Facial Treatment … See a younger-looking you in 7 days” in relation to facial care preparations
- “VICHY Body Care … Cream deodorant treatment, lasts 7 days” in relation to deodorant cream
- “Micro Pearl Abrasion Resurfacing Treatment, with Micronized Pearl …

  Directions:

  … For maximum results use daily for 7 days then skip 5 days to let skin rejuvenate….”

  in relation to facial care preparations.
- “BRAUN ORAL-B PRODUCT QUESTIONS

  … Q. How do I correctly charge my Braun Oral-B power toothbrush?

  A.... A full charge takes 16 hours and allow you to brush for more than 7 days for the Plak Control Power toothbrush …”

  in relation to electric toothbrushes[4].

25. The expression “7 days” is commonly used in everyday language as well as in trade to designate the period of “seven days” or “a week”. When the subject mark is used in relation to the subject goods, average consumers would perceive the mark as indicating that period of time, rather than as an identifier of commercial origin of the subject goods. Since the subject mark can designate the period of “seven days” or “a week” in relation to any traders’ goods of the kind applied for, it cannot serve to distinguish the Applicant’s subject goods from those of other undertakings. Without having been educated through use to recognize the subject mark as a trade mark, the

[4] Contrary to the Applicant’s submission that electric toothbrushes belong to another Class, both electric and non-electric toothbrushes are proper for Class 21.

average consumer would not perceive the subject mark as a badge of origin enabling the consumer who acquired the goods provided under the subject mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition. The subject mark is therefore devoid of any distinctive character.

26. In relation to the representation of the subject mark, Mr. D'souza submitted that:

- the numeral '7', which is very prominent in the subject mark, is followed by the word 'days', and both are in a curvy font;
- the numeral '7' is in a much larger font size than the word 'days';
- the '7' is curved in such a way that it 'complements' the 'circle' in the letter 'd' in the word 'days';
- the numeral '7' has a thin neck, a heavy head, and a very wide trunk which gives a very heavy impression;
- the letters 'd', 'a' and 'y' in the subject mark are connected together but separated from the letter 's';
- the letter 'd' and the letter 'a' have the same 'circles' in them;
- overall, the subject mark is slightly slanted; and
- if the subject mark is turned upside down, one can see the word 'shop'.

27. The average consumer normally perceives a mark as a whole and does not proceed to analyze its details. The subject goods are everyday consumer items. I consider that the average consumer would pay no more than average attention when selecting these goods. He would not notice that the letters 'd', 'a' and 'y' in the subject mark are joined together whereas the letter 's' is separated from 'day', or that the letter 'd' and the letter 'a' have the same 'circles' in them. He also would not turn the subject mark upside down and read the word "shop" from the subject mark. Despite the way it is represented, the subject mark would be perceived as a whole and comprehended as "7 days". The subject mark as whole in the form represented would not be perceived by the average consumer as an identifier of trade origin distinguishing the Applicant's subject goods from those of

another trade origin. The presentation of the numeral ‘7’ and the word ‘days’ in the subject mark does not endow the mark as a whole with any distinctive character.

28. Mr. D’souza submitted that in a lot of the examples given in the Opponent’s evidence, “7 days” or other time expressions appeared not on the actual goods themselves, but rather in the “surrounding description” in advertisements. I note, however, that in assessing the distinctiveness of a mark applied for, I should have regard not only to natural use on packaging but also to natural use in the context of advertising the relevant goods (*Besnier SA's Trade Mark Application* [2002] R.P.C. 7).

29. Mr. D’souza also submitted that the examples of use of “7 days” given by the Applicant in its evidence did not cover all of the subject goods. In other words, the Opponent has not shown in its evidence that the expression “7 days” is in actual use in relation to each of the subject goods.

30. As stated in paragraph 20 above, the distinctiveness of a mark must be assessed, first, by reference to the products or services in respect of which registration has been applied for, and, secondly, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question. The specific evaluation of the impact of a trade mark on the average consumer is a question of fact for the Registrar to determine (see to that effect, *BioID v OHIM* (Case C-37/03P) [2005] ECR I-7975, paragraphs 39, 42). The examples found in the Opponent’s evidence, which are not exhaustive, reinforce my view that in relation to each of the subject goods, when the subject mark is used in relation to any of them, the average consumer would not perceive the subject mark as an identifier of trade origin distinguishing the Applicant’s subject goods from those of another trade origin.

31. The Applicant submitted that even if the subject mark were devoid of distinctive character in relation to some of the subject goods (which the Applicant denied), pursuant to section 11(8) of the Ordinance, registration of the subject mark should be refused only in relation to those goods.

32. Section 11(8) of the Ordinance provides that:

“Where the grounds for the refusal of registration exist in respect of only some of the

goods or services for which the application for registration is made, the refusal shall apply to those goods or services only."

33. I have considered each of the subject goods in turn. I have considered the perception of the average consumer when the subject mark is used in relation to each of the subject goods. I consider that when the subject mark is used in relation to any of the subject goods, the average consumer would not perceive it as an identifier of trade origin of the goods distinguishing the Applicant's goods from those of other undertakings. As the subject mark is devoid of distinctive character and, therefore, objectionable under section 11(1)(b) of the Ordinance in relation to all of the subject goods, section 11(8) of the Ordinance does not assist the Applicant.

34. The Applicant submitted that it considered the "device" rather than the words in the subject mark as "an important aspect of representing its goodwill and get-up", and offered the following disclaimer:

"Registration of this trade mark shall give no right to the exclusive use of the numeral '7' and the word 'days'.

35. Section 15(1) of the Ordinance provides, inter alia, that:

"An applicant for registration of a trade mark, or the owner of a registered trade mark, may-

(a) disclaim any right to the exclusive use of any specified element of the trade mark;".

36. For the provision to apply, at least one of the elements of which the mark consists must be distinctive[5]. As analyzed above, the presentation of the numeral '7' and the word 'days' in the subject mark does not endow the mark with any distinctive character. There is nothing in the mark which serves to

[5] See to that effect *Imagination Technologies Ltd. v OHIM* (Case T-461/04) [2008] E.T.M.R.10, a case in relation to Art. 38(2) of Council Regulation 40/94 on the Community trade mark, which provides, *inter alia*, as follows:

"Where the trade mark contains an element which is not distinctive, and where the inclusion of said element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element…."

Although that provision is not in identical terms as section 15(1)(a) of the Ordinance, the same principle, namely that for the provision to apply at least one of the elements of which the mark consists must be distinctive, is equally applicable.

distinguish the subject goods supplied under the subject mark from those of another trade origin. The subject mark as a whole is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance. The Applicant's offer of a disclaimer cannot render the unregistrable subject mark a registrable one.

37. The Applicant included as "Annex B" to its skeleton arguments extracts from the online trade marks register showing details of three registered marks. These marks are either registered in relation to goods other than the subject goods, or contain other elements in addition to the numeral and the word '7 days'. Relying on these registrations, the Applicant submitted that "[t]here are indeed, cases where registrations of marks regarding '7 Days' that have been approved."

38. The Applicant has filed no evidence during the prescribed period, and has not been granted leave to file further evidence. That issue aside, I do not consider that the three registrations referred to by the Applicant are of any assistance to the Applicant's case. As stated in *British Sugar*:

> *"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, see e.g. MADAME Trade Mark*[6] *and the same must be true under the 1994 Act. I disregard the state of the register evidence."*

Conclusion

39. For the reasons stated above, I find that the subject mark is devoid of any distinctive character. The ground of opposition under section 11(1)(b) of the Ordinance is made out. The subject application is therefore refused.

40. As I have found in favour of the Opponent on the ground of opposition under section 11(1)(b) of the Ordinance, it is not necessary for me to consider the other grounds of opposition.

[6] [1966] R.P.C. 541.

41. As the opposition has succeeded, I award the Opponent costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party 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. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

(Finnie Quek)
for Registrar of Trade Marks
6 March 2009