

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : **300280007**
MARK : **MANPOWER**
APPLICANT : **MANPOWER INC.**
CLASS : **35**

STATEMENT OF REASONS FOR DECISION

Background

1. This is an application of Manpower Inc. of Wisconsin, United States of America (“the Applicant”), represented by Messrs. Eccles & Lee (“the Agent”). On 3 September 2004, the Applicant applied to register the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

MANPOWER

2. The registration of the subject mark is sought in respect of the services in Class 35 (“the services applied for”):

provision of temporary help services to business; placement of temporary personnel; permanent placement services; placement of permanent personnel; personnel recruitment; employment agencies

3. In support of the subject application, the Applicant had filed the Statutory Declaration of Mr. Michael J. Lynch (“the Statutory Declaration”), declared on 2 March 2007, with a view to showing that the subject mark had in fact acquired a distinctive character as a result of the use made of it in Hong Kong prior to the date of application for the purpose of section 11(2) of the Ordinance..
4. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance on the basis that the subject mark is devoid of any distinctive character and it consists exclusively of signs which may serve, in trade or business, to designate the characteristics of the services applied for. The objections were maintained despite the submissions made on behalf of the Applicant and the Statutory Declaration. Notice of the refusal of the registration of the subject mark was issued on 26 November 2007. An extension of time was sought by and granted to the Applicant to request for a statement of reasons for the decision of the Registrar pursuant to rule 91(2) of the

Trade Marks Rules (Cap. 559, sub leg). The Applicant filed a request under rule 91(2) within the extended time limit and this statement of reasons for decision is issued in response to this request.

The Ordinance

5. 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) 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 goods or rendering of services, or other characteristics of goods or services; and
 - (d) ...”

6. Notwithstanding the prohibitions against registration set out in sections 11(1)(b), (c) and (d), 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.”

Decision

Inherent registrability

Section 11(1)(c) of the Ordinance

7. I will, first of all, consider the inherent registrability of the subject mark. Section 11(1)(c) of the Ordinance precludes from registration marks consisting 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 other characteristics of the goods in respect of which registration is sought.

8. The subject mark consists of the English word “MANPOWER”. According to *The Concise Oxford English Dictionary*, Tenth Edition (2001), “manpower” means “the number of people working or available for work or service”. In other words, “manpower” is the workforce available.

9. In a letter dated 4 June 2005, the Agent submitted that the word “manpower” on its own did not indicate the specific kind and nature of the services in question. According to the Agent, consumers seeing the subject mark would not readily appreciate that it was used in relation to recruitment and employment services.
10. The operation of section 11(1)(c), however, is not limited to situation in which the mark actually informs the consumers what the goods or services in question are. In *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) [2004] R.P.C. 18 (the “*DOUBLEMINT*” case), the European Court of Justice (“ECJ”) discussed the approach to Article 7(1)(c) of Regulation No. 40/94 of 20 December 1993 on the Community Trade Mark (provisions of which are broadly similar to section 11(1)(c) of the Ordinance) and stated the relevant principles as follows:
- “29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.
31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).
32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of 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 provision 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.”
11. In light of the legal principles above, to be precluded from registration under section 11(1)(c) of the Ordinance, a mark does not need to inform the consumers what the

relevant services are, nor does it have to be the normal way of describing the services in question. It is sufficient if the mark could be used for the purpose of designating the characteristics of the services, including the kind and intended purpose of the services. A mark is therefore objectionable if at least one of its possible meanings designates a characteristic of the services in question.

12. When used in relation to the services applied for in Class 35, which include a range of services relating to personnel placement, recruitment and employment services, the subject mark indicates that the services are related to the provision of manpower or workforce to the consumers. As the subject mark is made up of a word directly descriptive of the nature and intended purpose of the services applied for, it consists exclusively of a sign which may serve to designate the characteristics of the services applied for. The subject mark is therefore precluded from registration under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

13. Section 11(1)(b) of the Ordinance operates as a ground of objection separate and independent from that under section 11(1)(c). Although I have found that the mark is precluded from registration under section 11(1)(c) and it is unnecessary for me to consider the other grounds for refusal, for the sake of completeness, I shall consider the registrability of the mark under section 11(1)(b) of the Ordinance, which precludes from registration signs that are devoid of any distinctive character.

14. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Mr. Justice Jacob 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?”

15. Additionally, in assessing the distinctive character of a sign, Sir Andrew Morritt in *Nestle SA's Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2, at 26 stated that:

“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.”

16. It follows that the distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it for the purpose of section 11(2), must be capable of identifying the goods and services as originating from a particular

undertaking, and thus distinguishing these goods and services from those of other undertakings. The distinctiveness of the mark must be assessed by reference to the services for which registration is sought and the perception of the relevant consumers.

17. In relation to the services applied for, the relevant consumers are individuals and enterprises that are building up the workforce and recruiting staff, be it on a temporary or permanent basis.
18. When assessing the inherent distinctiveness of the subject mark, I must consider the context in which the mark is used in respect of the services applied for. The use of a mark in respect of the relevant services includes using it on the advertisements and promotional leaflets of the services in question.
19. Upon seeing the subject mark in relation to the services applied for, the relevant consumers, who are presumed to be reasonably well-informed, circumspect and observant, would perceive the subject mark as a descriptive indication that the services in question are related to the supply of manpower or the available workforce. I am not satisfied that without first educating the relevant consumers, the relevant consumers would regard the subject mark, being a direct description of the characteristic of the services applied for, as an indicator identifying a particular undertaking from which these services originate.
20. In *Deutsche SiSi-Werke GmbH & Co. Betriebs KG* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60, the essential function of a trade mark is described by the ECJ as:

“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”

21. Having considered the subject application carefully, I am not persuaded that when the relevant consumers view the subject mark in respect of the services applied for, they will perceive it as a guarantee of trade origin without any possibility of confusion. The subject mark is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance as well.

Foreign registrations of the subject mark

22. The Agent pointed out in the letter dated 4 June 2005 and in Exhibit I of the Statutory Declaration that the subject mark has been registered in many other jurisdictions. National trade mark rights are territorially limited and granted independently of each other. The bare fact of registrations in other countries is not

sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). The registrations of the subject mark in other jurisdictions do not serve to overcome the objections raised under sections 11(1)(b) and 11(1)(c) of the Ordinance as stated above.

Acquired distinctiveness

23. Although I have found that the subject mark is descriptive and has no inherent distinctive character and not registrable under sections 11(1)(b) and (c), if the subject mark has in fact acquired a distinctive character as a result of the use made of it in respect of the applied for services for the purpose of section 11(2), the application for registration of the subject mark should not be refused. I shall therefore proceed to consider whether the subject mark has in fact acquired a distinctive character with reference to the evidence of use filed by way of the Statutory Declaration.
24. To assess the acquired distinctiveness of a mark, the ECJ stated in *Windsurfing Chiemsee Produktions Und Vertriebs GmbH v. Boots-Und Segelzubehor Wlater Huber* (Joined Cases C-108 and 109/97), [2000] Ch. 523 at 556:

“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”
25. Although the above case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC, the provisions of the article are broadly similar to section 11(2) of the Ordinance and I find that the relevant principle is applicable to the subject application. I have also borne in mind that in determining the question of acquired distinctiveness, I must make an overall assessment of the evidence.
26. In the Statutory Declaration, the following matters, which are relevant for the purpose of showing the distinctiveness acquired by the subject mark through use in Hong Kong prior to the date of application, are averred:
 - (a) The subject mark has been used in Hong Kong in respect of the services applied for and other goods and services including computer software and database, personnel evaluation, training and management, consultancy services in the field of technology (“the Applicant’s goods and services”) since at least as early as 1964.
 - (b) The annual revenues of the services applied for together with the Applicant’s goods and services, sold or provided under the subject mark, in Hong Kong in

the years 2002, 2003 and 2004 are \$203,147,000, \$184,758,000 and \$272,974,000 respectively. While the annual revenues in the years 2005 and 2006 are provided in the Statutory Declaration, such sales happened after the application date of 3 September 2004, and thus they are irrelevant for the purpose of showing that the subject mark had in fact acquired distinctiveness through use prior to the date of application.

- (c) Use of the subject mark in respect of the services applied for includes the distribution of seminar, training materials, surveys and literature bearing the subject mark.
 - (d) Promotion of the subject mark includes advertisements in newspapers and magazines, leaflets and brochures, circulars to the trade and on the Internet. The annual advertising and promotional expenditures of the subject mark in respect of the services applied for together with the Applicant's goods and services in the years 2002, 2003 and 2004 are \$873,544, \$1,479,271 and \$1,656,335 respectively. Again, while the expenditures in the years 2005 and 2006 are provided in the Statutory Declaration, such figures are disregarded as they do not relate to the promotion of the subject mark prior to the date of application.
27. Not all of the materials exhibited to the Statutory Declaration show use of the subject mark in Hong Kong. Where the materials appear to be related to Hong Kong prior to the date of application, namely Exhibits F and G, they contain the following main features:
- (a) Paragraph 17 of the Statutory Declaration states that samples of the subject mark "as appeared on the Applicant's Goods and seminar and other training materials, surveys, and literature distributed in the course of provision of the Applicant's Services in Hong Kong" are provided at Exhibit F. Exhibit F consists of copies of survey reports, research reports and white papers covering a period from mid 2004 to late 2006. Most of the materials in Exhibit F are either undated or bear a date that is after the date of application in September 2004. The only material that appears to be prepared before the date of application is the "3rd Quarter 2004 Manpower Employment Outlook Survey Hong Kong" ("the Survey"). The Survey is essentially an analysis of the expected increase and decrease of workforce of the interviewees in different sectors. Nothing in the Survey is related to the provision of services applied for.
 - (b) According to paragraph 18 of the Statutory Declaration, "samples of the advertising and promotional materials used in Hong Kong" are provided at Exhibit G. Exhibit G consists of a bulk of photocopies of recruitment

advertisements, most of which are undated. Amongst these recruitment classifieds, a handful of them were published in late 2002, as reflected on the papers which show the particulars of facsimile transmission and on which these recruitment classifieds are shown.

- (c) In Exhibit G, there is a copy of “AiAP AMERICA in ASIS PACIFIC” dated 2004 which essentially provides a brief description of the “guiding principles that inspire and support Manpower Hong Kong”.
- (d) Also in Exhibit G is a copy of the “Manpower CSR newsletter” for April to June 2004. According to the newsletter, CSR stands for “Corporate Social Responsibility”. Nothing in this newsletter is related to the services applied for.

28. From the evidence adduced by the Applicant, it is observed that:

- (a) It is averred in the Statutory Declaration that the subject mark was first used in Hong Kong in 1964. However, there is nothing in the evidence adduced to support the claim.
- (b) Amongst the copies of recruitment classifieds (Exhibit G), the earliest of which was published in late 2002. As there is nothing to show use of the subject mark in respect of any of the services applied for in 2003, it is not entirely clear if such use of the subject mark had been continuous up to the date of application in September 2004. Even assuming that the use of the subject mark had been continuous, use of the subject mark in Hong Kong before the date of application was for a limited period of two (2) years at most. Furthermore, there were only a handful of these recruitment classifieds which were published in late 2002. For the rest, either they are undated, or bear a date that is after the date of application. I should also mention that handwritten dates are disregarded for the purpose of ascertaining the date of the advertisements. In the circumstances, use of the subject mark in relation to recruitment services or employment services prior to the date of application is minimal at most.
- (c) As regards the Survey in Exhibit F and the various printed matters showing the subject mark in Exhibit G such as the “AiAP AMERICA in ASIA PACIFIC” and the “Manpower CSR newsletter”, it is not entirely clear to whom in Hong Kong these printed matters were distributed, how frequently they were distributed or what the scale of distribution was prior to the date of application.
- (d) In short, in so far as the asserted use of the subject mark in respect of the services applied for is concerned, the materials provided at various Exhibits

only show minimal use of the subject mark in Hong Kong prior to the date of application in the Survey for the 3rd Quarter of 2004 (Exhibit F) and the recruitment classifieds in 2002 (Exhibit G).

- (e) In a letter dated 27 February 2008, the Agent asserted that substantial sales and advertising expenses in Hong Kong were established through the figures provided in the Statutory Declaration. Although sales figures from 2002 to 2006 and advertising expenses from 2002 to 2006 are provided in the Statutory Declaration, such figures relate to the services applied for as well as the Applicant's goods and services. The figures provided are not broken down to reflect the sales generated from the provision of the services applied for or the promotion expenses in respect of the services applied for. Moreover, the figures provided in the Statutory Declaration are not substantiated by any documentary evidence. How the subject mark is used in the course of the provision of the services applied for remains unknown. Indeed, the Applicant did not provide any copies of invoices to substantiate the claim regarding the provision of the services applied for. The only samples of invoices adduced are provided in Exhibit H, which are invoices for the placement of the recruitment classifieds in various newspapers and online websites. Amongst those invoices that are dated before the date of application, not only the subject mark is not shown, the kind of services being advertised or promoted cannot be ascertained. I do not see the relevance of the samples of invoices to the subject application.
- (f) For completeness, I should also mention that the materials provided at Exhibit B, which consist of a few pages of the FORTUNE magazine and identify the Applicant as one of the "America's most admired companies", do not assist the Applicant in establishing that the subject mark has in fact acquired a distinctive character as a result of the use made of it in Hong Kong. The various pages of the FORTUNE magazine do not show the kind of services provided by the Applicant under the subject mark, and as the pages do not seem to relate to the Hong Kong edition of the magazines, it is unclear how widely the pages had been distributed to the relevant consumers in Hong Kong. As to Exhibits C and D, it is noted that they were prepared at a time after the date of application and therefore I would not take them into account when assessing the acquired distinctiveness of the subject mark.
- (g) Exhibits A and I provide information of the registrations of the subject mark in other jurisdictions including the United States of America. National trade mark rights are territorially limited and granted independently by reference to the law and practice of the jurisdiction. The mere fact of registration in another jurisdiction does not serve to show that the subject mark has acquired

a distinctive character as a result of the use made of it in Hong Kong prior to the date of application.

29. In determining whether a mark has acquired a distinctive character, the crucial question is whether the relevant consumers have been educated to recognise the subject mark as a badge of trade origin of the services applied for through the use made of it. For the relevant consumers in Hong Kong or at least a significant proportion of them to be educated of the significance of the subject mark as a badge of trade origin, the use of the subject mark in Hong Kong prior to the date of application must be more than just minimal. While the Agent sought to rely on the “spilling over” effect from the “overseas promotion” of the subject mark, the evidence adduced which shows the “overseas promotion” of the subject mark is extremely limited. As I have explained in paragraph 28(f) above, the copy of the FORTUNE magazine does not show the use of the subject mark in relation to any of the services applied for. To put it in another way, being one of the “America’s most admired companies” does not equate to use of the subject mark in respect of the services in question.
30. Upon careful consideration of the evidence filed, I am not persuaded that the subject mark has indeed, before the date of application, acquired a distinctive character in respect of recruitment services or any other services applied for as a result of the use made of it in Hong Kong for the purpose of section 11(2) of the Ordinance. The evidence filed fails to overcome the objections raised under section 11(1)(b) and (c) of the Ordinance.

Conclusion

31. In this decision, I have carefully considered all of the materials filed, together with the written submissions made by and on behalf of the Applicant. For the reasons given above, I consider that the subject mark is precluded from registration by sections 11(1)(b) and 11(1)(c) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Margaret K.W. YU
for Registrar of Trade Marks
15 August 2008