

## TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300284544

MARK: Reach Easy

CLASS: 10

APPLICANT: MATSUSHITA DENKOU KABUSHIKI KAISHA  
(MATSUSHITA ELECTRIC WORKS, LTD.)

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### STATEMENT OF REASONS FOR DECISION

#### Background

1. On 11 September 2004, Matsushita Denkou Kabushiki Kaisha (Matsushita Electric Works, Ltd.) (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”), to register the mark, **Reach Easy** (“the subject mark”) in Class 10.
2. The goods for which registration is sought are “massage machines; massage machines for household use; massage machines for business use; massage machines for other use; massage armchair; bed vibrators; massage apparatus; vibromassage apparatus; electric massager for household use; electric massager for medical use; foot massage machines; all included in Class 10.”
3. Objections were taken against the application under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the goods applied for.
4. The applicant requested a hearing which took place before me on 27 January 2006. Mr. Andrew Chan of Messrs. So Keung Yip & Sin appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
5. The applicant did not file any evidence of use of the subject mark. I therefore have only the *prima facie* case to consider.

#### Trade Marks Ordinance

6. The relevant part of the Ordinance under which the objections were taken are as

follows:

Section 11(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) ...”

### Decision

7. The subject mark consists of two ordinary English words “Reach” and “Easy” which are presented at a slight incline to the right. As a whole, I find that there is no stylization in the subject mark: it will simply be seen and referred to as “Reach Easy”.
8. As stated by Mr. Chan, the word “Reach” is defined in the *Encarta online dictionary*<sup>1</sup> as “move toward something to touch it”. According to *Collins English Dictionary (Third Edition Updated 1994)*, “Reach” means “to arrive at or get to (a place, person, etc.) in the course of movement or action”; “to extend as far as (a point or place)”.
9. The meanings of “Easy” include:
  - “in a relaxed manner; or without hardship”; “with ease” – [www.onelook.com](http://www.onelook.com);
  - “with little effort; easily” – [www.dictionary.com](http://www.dictionary.com);
  - “without difficulty or effort” – *The New Oxford Dictionary of English (1998)*
10. Given the above dictionary meanings and in respect of the goods applied for, the subject mark “Reach Easy” conveys the idea that the goods are able to get to or to extend to target places without difficulty. Even without reference to dictionaries, there can be little doubt that the meaning of “Reach Easy” is obvious.

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

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<sup>1</sup> <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861727412>

11. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the intended purpose or other characteristics of the goods in respect of which registration is sought.
12. At the hearing, Mr. Chan referred me to paragraph 40 of *Procter & Gamble Company v OHIM* [2002] RPC 17 (the “*BABY-DRY*” case) in which the European Court of Justice stated that:

“As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”
13. He also made reference to paragraph 7.5 of Chapter 6 of the UK Trade Marks Registry Work Manual relating to section 3(1)(c) of the UK Trade Marks Act (which is closely similar to section 11(1)(c) of the Ordinance) where it states that:

“When examining marks consisting of unusually juxtaposed words and marks which consist of only part of a natural description for the goods/services, the court’s judgement in *Baby-Dry* (C-383/99 P) provides guidance. *Baby-Dry* also assists in an assessment of whether a trade mark consisting of two or more words consists *exclusively* of a descriptive term, when the words in question are juxtaposed in a manner which renders the mark resistant to natural descriptive uses.”
14. Based on the above, Mr. Chan submitted that the combination “Reach Easy” was not a term used in the common parlance of the average consumer for massage machines and apparatus. The subject mark, as opposed to phrases like “easy to adjust” or “convenient to use”, is not apt to describe massage machines and apparatus. The words in the subject mark are juxtaposed in a manner which renders the subject mark resistant to natural descriptive uses.
15. Whilst I have considered the principles set out by Mr. Chan, I also note that subsequent to the “*BABY-DRY*” case, the European Court of Justice clarified the approach to Article 7(1)(c) of the Council Regulation (EC) No 40/94 (which is closely similar to section 11(1)(c) of the Ordinance) in cases such as *OHIM v Wm. Wrigley Jr. Company*, Case-191/01P (the “*DOUBLEMINT*” case) and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*, Case C-363/99 (the “*Postkantoor*” case)<sup>2</sup>. The Court stated the guiding principles as follows:

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<sup>2</sup> This case is mainly concerned with Article 3(1)(c) of the First Council Directive 89/104/EEC but it is directly relevant as this Article is effectively identical to Article 7(1)(c) of the Council Regulation (EC) No 40/94.

“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 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.” (see paragraph 32 of the “*DOUBLEMINT*” case)

“For the purposes 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.” (see paragraph 104 of the “*Postkantoor*” case)

16. These principles indicate that for a mark to be caught by section 11(1)(c) of the Ordinance, it is not necessary that the mark is actually in descriptive use at the time of application. In addition, the mark does not have to be the “normal way” of describing the applied for goods or services, nor is it necessary for the relevant characteristics of the goods or services to be commercially essential. It is sufficient to find that the mark could be used to designate the characteristics of the specified goods or services.
17. I disagree with Mr. Chan that the subject mark is not apt to describe the characteristics of the claimed goods. According to the Internet websites quoted as examples by the examiner and the leaflet shown to Mr. Chan at the hearing, traders often promote their massage apparatus as equipped with long or adjustable handles for, or special functions for, reaching hard-to-reach areas such as the neck, back or shoulders. When the subject mark is used in connection with the goods applied for, it immediately conveys the message that the goods can reach any part of a user’s body easily. “Reach Easy” is apt to designate the intended purpose and characteristics of the goods applied for.
18. I am not convinced that the words “Reach Easy” are “juxtaposed in a manner which renders the subject mark resistant to natural descriptive uses”. The average consumer normally perceives a mark as a whole and does not proceed to analyse it in detail and to assess its grammatical accuracy. It is the overall impression created by the mark which must be assessed. I consider that in the mind of the average consumer, the words “Reach Easy” would be immediately associated with certain characteristics of the goods in question, that is, reaching areas of the body easily. The mere juxtaposition of the words “Reach” and

“Easy” is not sufficiently unusual to remove their descriptive meaning or for consumers to accord trade mark, as opposed to descriptive, significance to the words.

19. Mr. Chan contended that the Internet websites quoted by the examiner did not show use of the exact phrase “Reach Easy” in the trade. At the hearing, he produced a print-out obtained from a website to demonstrate the sort of words used to refer to massage machines. Mr. Chan asserted that no words similar to “Reach Easy” have been used by traders or consumers to describe the goods applied for.
20. I note that the print-out produced by Mr. Chan is not adduced in the form of a statutory declaration or affidavit as required by rule 79(1) of the Trade Marks Rules (Cap.559, sub. leg.). Moreover, I do not see the relevance of the print-out in the present case, as the contents only refer to the benefits of massage rather than to massage machines or apparatus.
21. Furthermore, as I have explained in paragraphs 15 and 16, it is not necessary for the mark in question to be in current use as a description before the mark is susceptible to an objection under section 11(1)(c) of the Ordinance. The words “*may serve...to designate*” in section 11(1)(c) allow for a degree of foreseeability that the mark may be perceived by consumers as a new form of descriptive expression (see paragraphs 31 and 32 of “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37).
22. As shown in the examiner’s Internet findings, I find that it is common for traders to commend their massage products as having special features or functions for massaging hard-to-reach areas, with ease. The words “Reach Easy” are a pithy and apt expression to convey this message. The words are descriptive and are capable of being used and would be likely to be used by other commercial undertakings to designate similar characteristics of their goods.
23. For the above reasons, I conclude that the subject mark as a whole consists exclusively of a sign which may serve, in trade or business, to designate the intended purpose and characteristics of the goods applied for and is, therefore, excluded from registration by section 11(1)(c) of the Ordinance.

*Section 11(1)(b) of the Ordinance*

24. I now turn to consider whether the subject mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance, which operates as a separate and independent ground of objection under section 11(1)(c) of the Ordinance.

25. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, page 306, in which 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?”

26. In “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37, it was stated that:

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

27. The approach of assessing “distinctiveness” was further discussed in *Nestle SA’s Trade Mark Application (Have A Break)* [2004] FSR 2:

“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 be capable of identifying the products as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. I must assess the mark’s distinctiveness in relation to the goods for which the applicant seeks registration, which are massage apparatus and machines. I must also have regard to the perception of the relevant consumers of these goods, who for these types of goods would be the general public.

29. Mr. Chan submitted that given the unusual juxtaposition of the words in the subject mark, the average consumer for massage machines and apparatus would be likely to perceive the mark not as serving to describe a characteristic of the goods but as an identifier of the origin of the goods.

30. In my view, when consumers encounter the subject mark in relation to the goods applied for, they would see it, on first impression, as a description of the intended purpose and characteristics of goods that enable them to reach easily target areas or hard-to-reach areas of their bodies. They are unlikely to perceive the subject mark as an indication of trade origin.
31. To my mind, as the predominant language in Hong Kong is Chinese, Hong Kong people are likely to perceive the words “Reach Easy” literally. They are unlikely to perceive the phrase as syntactically unusual. Additionally, in view of the modern, relaxed standards and use of grammar, consumers would not regard the phrase “Reach Easy” as unusual. Promotional messages printed on products or their packaging are not written in ordinary, grammatically correct prose. Short, punchy messages are in any case more likely to attract the attention of the consumer, who may not have the time or the inclination to read long texts. In light of the above, I consider that consumers would not perceive the juxtaposition of the words “Reach” and “Easy” to be unusual.
32. Furthermore, as indicated above, the words “Reach Easy” would be readily perceived by consumers as a statement that the goods can reach target areas easily. As a result, the combination of the words “Reach” and “Easy” fails to give any distinctive character to the subject mark as a whole.
33. Since the subject mark is equally applicable as a description of similar characteristics of the goods provided by other undertakings, it would not enable consumers to distinguish the applicant’s goods from those of other undertakings. Unless the public has been educated by use of the subject mark as a trade mark, it is unlikely that they would attach trade mark significance to the subject mark.
34. For the reasons stated above, I conclude that the subject mark cannot fulfill the essential function of identifying the origin of the goods applied for, and thus distinguishing the applicant’s goods from those of others. Therefore, the subject mark as a whole is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

*Reference to other registered trade marks and overseas registrations*

35. Mr. Chan drew my attention to the registered trade marks, “WORLDREACH”,

“REACHING NEW HORIZONS”, “INTERACTIVE INTELLIGENCE”, “ACTION REQUEST SYSTEM”, and “BODY CONTROL”, and submitted that they were no more distinctive than the subject mark. He added that the subject mark had also been registered in the USA, Canada, Germany and Taiwan, and these acceptances indicated that the registries in those countries considered the subject mark to be distinctive.

36. I have considered the registered trade marks but do not find them to be analogous to the subject mark as their references to the goods or services registered are less direct. In any event, it is well established that each case must be considered on its own merits and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305). Therefore, the acceptances of the quoted marks do not assist the subject application.
37. Regarding the overseas registrations of the subject mark, as pointed out by Mr. Chan, the language of law and the examination standards in those countries may be different from those in Hong Kong. In addition, national trade mark rights are territorially limited and granted independently of each other; the bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). In particular, where there are valid grounds of objections under the Ordinance, I cannot accept the subject mark solely on the basis of overseas registrations.

### **Conclusion**

38. In this decision, I have considered all the documents filed by the applicant and all the arguments submitted in relation to the subject application. For the reasons given, the subject mark is precluded from registration by section 11(1)(b) and (c) of the Ordinance, and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Sandra Hui  
for the Registrar of Trade Marks  
15 May 2006