TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300392166

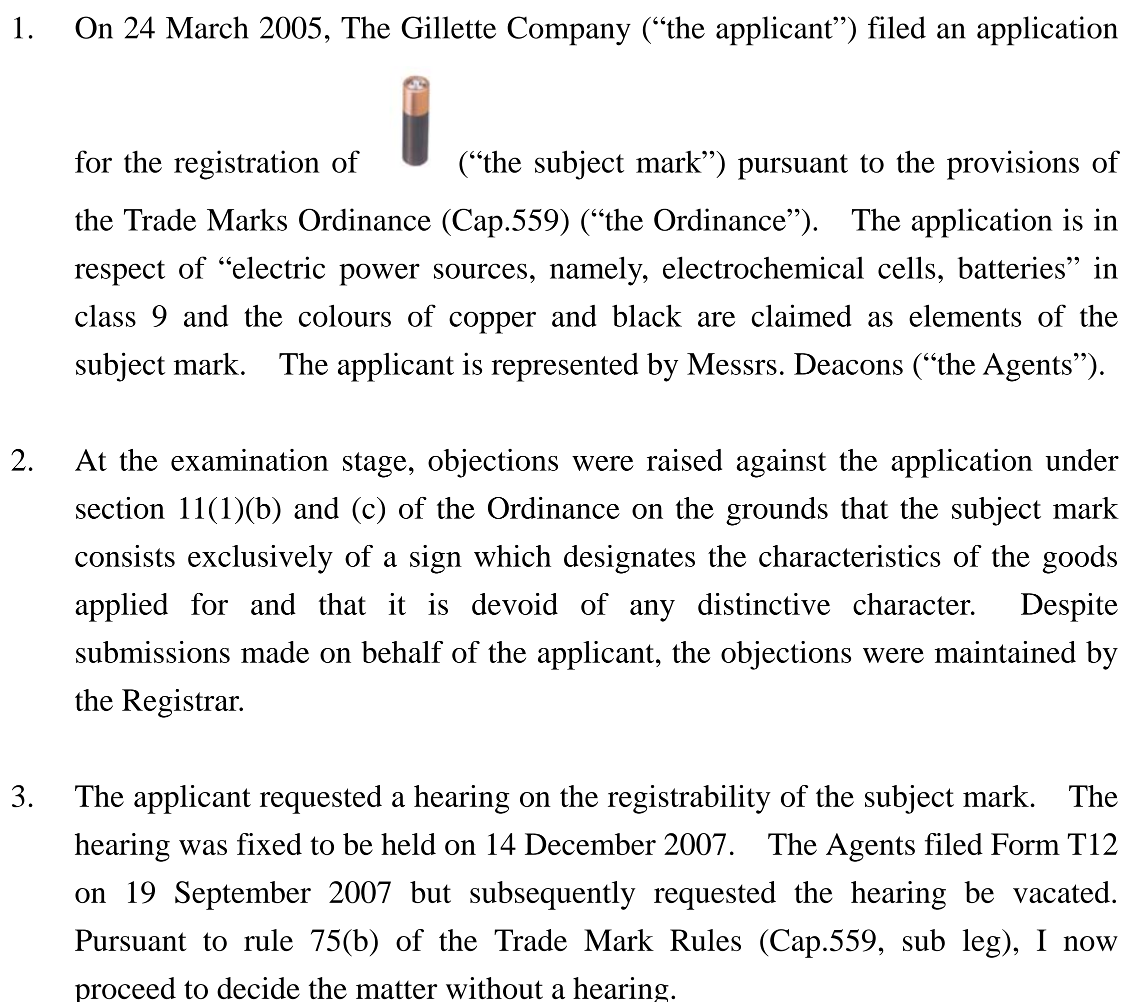
MARK :

APPLICANT : THE GILLETTE COMPANY

CLASS : 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 24 March 2005, The Gillette Company ("the applicant") filed an application for the registration of  ("the subject mark") pursuant to the provisions of the Trade Marks Ordinance (Cap.559) ("the Ordinance"). The application is in respect of "electric power sources, namely, electrochemical cells, batteries" in class 9 and the colours of copper and black are claimed as elements of the subject mark. The applicant is represented by Messrs. Deacons ("the Agents").

2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the grounds that the subject mark consists exclusively of a sign which designates the characteristics of the goods applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.

3. The applicant requested a hearing on the registrability of the subject mark. The hearing was fixed to be held on 14 December 2007. The Agents filed Form T12 on 19 September 2007 but subsequently requested the hearing be vacated. Pursuant to rule 75(b) of the Trade Mark Rules (Cap.559, sub leg), I now proceed to decide the matter without a hearing.

Grounds of refusal under section 11

4. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Subsections (1) and (2) are relevant here and they read as follows:

"(1) Subject to subsection (2), the following shall not be registered –

(a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");

(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) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

(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)

5. The applicant has submitted two sets of evidence to establish that the subject mark has acquired distinctiveness through the use that has been made of it. I will deal with the *prima facie* case first before I turn to the evidence that has been filed. I will start off with the objection under section 11(1)(c).

6. The subject mark is the two dimensional representation of a battery in copper and black colours. When the subject mark is applied to "electric power sources, namely, electrochemical cells, batteries", it only designates the kind of the goods applied for. I am mindful of the colours claimed by the applicant. The colour features are only part of the representation and the representation in colour is as a whole descriptive of the goods applied for.

7. At the examination stage, the Agents queried how the colours copper and black on a battery jacket could be considered as indicating the kind of goods sold which are electrochemical cells and batteries. They submitted that there was nothing inherent in the colours black and copper which would bring to the mind of consumers electrochemical cells and batteries. Further, according to the Agents, they could not find other battery suppliers who also used the colours black and copper together or a similar colour combination.

8. This argument has given undue weight to the colours used in the subject mark. Assessment of the distinctiveness of a mark has to be carried out of the mark as a whole. Thus, with the subject mark, the question to ask is what is the message conveyed by the representation of a battery with a jacket in the colours copper and black. The answer to this question is simple. Consumers of the goods in question will not consider the colours used in vacuum, but as part of the representation of the battery.

9. The matter can be considered by regarding the colour features as a component part of the subject mark in addition to the mere representation of the battery. In adopting such an approach, the principle stated in the case of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ("the *POSTKANTOOR* case") (Case C-363/99) [2004] E.T.M.R. 57 should be noted. In that case, the European Court of Justice considered Article 3(1)(c) of the First Council Directive 89/104/EEC (which is broadly similar to section 11(1)(c) of the Ordinance). The court remarked, at paragraph 100 –

> *"…Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the words and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components…".*

10. The *POSTKANTOOR* case is concerned with the conjoining of words, but I consider the principle to be equally applicable to a mark that is composed of more than one component, and such components can be words, figurative or other elements or any combination of such elements. The subject mark is a composite of a representation and particular colour features applied on the representation. Both the representation of the battery and the colour features applied on it are descriptive of the characteristics of the goods applied for, the representation being descriptive of the outlook of the goods and the colour features being descriptive of the colour of such goods. Their combination has not created an impression that is different from that of the sum of these elements, nor has the combination acquired a new or different signification that is independent of its components.

11. The fact that other battery suppliers do not use the same colour combination as the applicant is also of no assistance to the applicant. A sign that is not actually in use by other traders to designate the characteristics of the goods applied for is still precluded from registration under section 11(1)(c) if it could be used for such purposes. Support for this can be found from the principles laid down in the case of *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) ('the *DOUBLEMINT* case"). In paragraph 32 of the judgment of the *DOUBLEMINT* case, the European Court of Justice considered the effect of Article 7(1)(c) of the Council Regulation (EC) No. 40/94 (which is also broadly similar to section 11(1)(c) of the Ordinance) and stated –

    "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."

12. Hence, whether other battery suppliers use a colour combination as that of the subject mark does not have a bearing on the message being conveyed to the consumers of the goods applied for. Further, although the colour black or

copper or their combination may not of itself refer the relevant consumers to "electric power sources, namely, electrochemical cells, batteries", the use of the colours black and copper on the representation of a battery has such an effect.

13. The subject mark has no other elements apart from the representation of the battery in copper and black colours. That being the case, the subject mark consists exclusively of signs that may serve to designate the kind of goods, that is, they are "electric power sources, namely, electrochemical cells, batteries". The subject mark is therefore precluded from registration by section 11(1)(c) of the Ordinance.

Inherent registrability – Section 11(1)(b)

14. Objection is also raised against the subject mark under section 11(1)(b) on the ground that, as the public is used to seeing different colour features on the jackets of batteries, it will not be perceived as having any trade mark significance by the average consumer.

15. The applicable test for considering whether a mark has any distinctive character has been considered in many UK cases. In the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, Jacob J (at page 306) set out the test as follows –

    "What does devoid of 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?"

16. In the case of *Nestle SA's Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23), the test is phrased as follows –

    "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."

17. In assessing the distinctiveness of a mark, the question to consider is whether the mark will be perceived as a badge of trade origin and not whether other traders would want to use it for their own goods. The assessment is to be carried out in respect of the subject mark, with reference to the goods of the class for which registration is sought, as well as the consumers of those goods, who are reasonably well informed and circumspect.

18. The goods in question are "electric power sources, namely, electrochemical cells, batteries". The relevant consumers are members of the general public. Colours are invariably used on jackets of batteries. They are often used to appeal to the eye, for attracting attention and to entice consumers to purchase the goods. Unlike goods which come in their natural colours, the jackets of batteries can come in all sorts of colours. Members of the public are used to colours being employed on such goods for attracting their attention and will not regard a colour representation of a battery as anything other than a description of the goods itself. They will not regard it as a sign that indicates the commercial origin of the goods without first having been educated of such function of the sign. The subject mark is therefore devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

19. The Agents suggested a similar test. As indicated in their letter of 20 June 2007, the correct issue should be whether the mark as applied for would be taken as having trade mark significance. However, in applying the test to the subject mark, the Agents submitted that the question to ask was whether the precise colours copper and black would be taken as having trade mark significance. They also sought to rely on the following passage in the chapter on "Colour marks" of the Trade Marks Registry Work Manual ("the Work Manual") –

"Two or more colours combined and presented as a trade mark may be prima facie registrable, but this would depend on the circumstances."

20. Although the Agents went on to refer to the remaining passages in the Work Manual about the factors that would be taken into account in assessing the registrability of colour marks, on the basis of the passage quoted in the preceding paragraph, they said that the subject mark should be presumed to be sufficiently distinctive on the basis of the two colours claimed. They stressed that the

assessment had to be made in respect of the colours as applied for and that there was no reason why the colours copper and black would not be perceived as a badge of origin when those colours were not in common use at all in the battery market. They also mentioned their view that the intention of battery companies selecting different colours for their batteries was in fact to assist the public in recognizing their business and only their business.

21. I have difficulty in following the arguments of the Agents. The subject mark is not a mere colour mark. It is a colour representation of a battery. I also cannot see how a presumption of registrability can arise on the basis of a mere claim of two or more colours. The passage in the Work Manual that was quoted by the Agents has a clear qualification about the outcome of the assessment of registrability being dependent on the circumstances. In addition, the Work Manual gives a number of examples where the combination of two or more colours will not be considered as *prima facie* registrable. In particular, it refers to the situations where colours are commonly used because of their appeal, in order to advertise and market goods and services, and also where the colours serve in the trade or business to designate the kind, quality, intended purpose or other characteristics of the goods or services in question.

22. As pointed out in the above, the subject mark is a colour representation of a battery and it may serve in trade or business to designate the kind of goods in question. Thus, the assessment of distinctiveness is to be carried out in respect of such a representation and not merely the colours copper and black. In view of the signification of the subject mark, it will not be perceived as an indicator of trade origin. The relevant consumers will only regard it, as a whole, as a description of the goods applied for, the colours being a feature to appeal to them.

23. Without first being educated that the subject mark is intended and used as a badge of origin, consumers of the goods applied for are likely to perceive the subject mark as a mere description of the kind of goods in question. The subject mark is equally applicable to the same goods of other undertakings as such an indication. It would not enable the relevant consumers to distinguish goods of the applicant from those of other undertakings. I therefore find the subject mark to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods applied for.

Acquired distinctiveness

24. According to section 11(2) of the Ordinance, a mark would not be refused registration if it has in fact acquired distinctiveness as a result of the use that has been made of it. The applicant has submitted two sets of evidence, a statutory declaration of Nicholas Ming Lai Mak ("First Statutory Declaration") and a statutory declaration of David M Moyer ("Second Statutory Declaration). I shall consider whether they show that the subject mark has indeed acquired a distinctive character through use.

25. There is a statement of the relevant principle in the case of *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger* [1999] E.T.M.R. 585. The case is concerned with Article 3(3) of the First Council Directive 89/104/EEC which is broadly similar to section 11(2) of the Ordinance. The Court of Justice of the European Communities said in that case, at paragraph 54 –

"…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."

26. The First Statutory Declaration shows the results of a survey conducted by the Agents among their own staff. In the case of *Imperial Group plc v Philip Morris Limited* [1984] RPC 293, the judge set out a number of factors that a survey has to satisfy if it is to have validity. They are -
    (a) The interviewees must be selected so as to represent a relevant cross-section of the public;
    (b) The survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;
    (c) All the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved;
    (d) The totality of all answers given to all surveys must be disclosed;
    (e) The questions must not be leading or direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;

(f) The exact answers and not only some abbreviation or digest must be recorded;

(g) The instructions given to the interviewers on how to carry out the survey must be disclosed;

(h) Where the answers are coded for computer input, the coding instructions must be disclosed.

Some of the principles set forth in the *Imperial Group* case are not applicable in the present case but quite a few are.

27. As shown in the First Statutory Declaration, the question asked in the survey is "Which brand is the item sold under?" and 100 out of the 128 responses received stated that the battery was sold in relation to the Duracell business. In asking the brand that the battery shown is sold under, the question posed presupposes, in the first place, recognition of the item and secondly, its association with a brand. The parties surveyed are more likely to try to find an answer to fit the question than would have been the case had there been no such presupposition. They might have tried to find out more before sending out their answers. Their recognition of the subject mark and their association of the subject mark with a brand may not therefore come spontaneously from themselves, but may be induced by the way the question was put to them and the way the survey results were collected.

28. This is of particular importance in the present case since the subject mark is a representation of the goods applied for. The parties surveyed would have no difficulty in recognizing that the item in question was a battery. In responding to the question, they might simply put in a brand of battery products that they knew about instead of saying they did not know. The association may thus be an induced and speculated one. A conclusion that the subject mark would be perceived as a badge of trade origin rather than a mere signification of the kind of goods in question is, when based on such an induced association, inherently unreliable.

29. Another concern on the relevance of the survey results is the sampling covered by the survey. The survey was conducted in house among the members of the Agents' firm. Many factors could have affected the impartiality of the responses. Firstly, how many of the respondents handle trade mark matters as

their usual responsibilities is not known. Such parties are likely to surmise or know the significance of the survey. Those in the firm that normally handle the business of the applicant and companies within its group will also likely have some knowledge about the applicant's modus operandi in respect of "electric power sources, namely, electrochemical cells, batteries". As indicated in the First Statutory Declaration, all staff of the Agents were sent an e-mail with the question referred to in paragraph 27 above and that would include those working on this application. There is no mention that, in the analysis of the results of the survey, their responses had been discounted. Simply judging from what is deposed in the First Statutory Declaration, I am not satisfied that these factors have been appropriately addressed.

30. In their letter of 20 June 2007, the Agents took issue with the above view on the impartiality of the survey. They pointed to the case of *Neutrogena Corporation v Golden Limited* [1996] RPC 473 where the results of an in house survey by the solicitors of the plaintiff were accepted. They also referred to a trade mark application case that they handled around 2002 where, it was alleged, a survey conducted by their firm was accepted. The case relates to the application of the mark "GALBE" in class 14.

31. The *Neutrogena* case was concerned with trade mark infringement and the issue in question was whether there was confusion in the co-existence of the two marks "NEUTROGENA" and "NEUTRALIA". My attention is drawn to the remarks of the trial judge about the question being asked which is "Have you heard of or do you use Neutralia products?" The trial judge, as quoted by Morritt L.J. at page 498 in the case, said that "The message was innocuous". The examination by the trial judge of seven witnesses from the solicitors' firm in question was also referred to, as well as the judge's finding that nearly all of those witnesses had no idea that the firm was involved in a case about the two marks, until they responded to the e-mail which posed the question of the survey to them.

32. The present application is distinguishable from the *Neutrogena* case referred to by the Agents. The question posed is not itself innocuous. I have pointed out the factors that may affect the innocuousness of the question being asked and the way in which the answers were collected. There is nothing before me to dispel the effect of such factors, whether through examination of the respondents to the

survey or the contents of the First Statutory Declaration.

33. Further, unlike the question in the *Neutrogena* case which is a merely factual one, the question posed in this case has a legal aspect to it. Legally trained people would have a better appreciation of the purpose of conducting such surveys and they are thus not a properly representative sample of the public at large in Hong Kong. In any event, in the *Neutrogena* case, the survey conducted within the law firm merely identified parties actually confused by the use of the two marks and it was their testimonies, upon examination by the trial judge, that were taken into account. There were also other types of evidence collected from different sectors of the public. Having considered all the above, I do not find the survey carried out by the Agents to be of assistance to this application.

34. I have also had a look at the file for the application of "GALBE" in class 14. The mark is now registered with the number 2004B07321. Contrary to what has been suggested by the Agents, the survey had not been accepted by the Registrar. The examiner in that case stated that "I am afraid that I cannot take account of the survey because it is clearly not sufficiently wide as to be representative of the Hong Kong consumers nor is it carried out by an independent entity". The mark in that case was accepted on some other basis.

35. The Second Statutory Declaration was made by the Assistant Secretary of the applicant. In all of the materials exhibited in the Second Statutory Declaration regarding actual use or promotion, the subject mark is invariably used with the prominent word mark "DURACELL", and in most cases the Chinese word mark "金霸王" is also used in conjunction.

36. In the case of *Societe des Produits Nestle SA v Mars UK Ltd* [2006] FSR2, the Court of Justice of the European Communities had to decide whether the distinctive character of a mark referred to in Article 3(3) of the Council Directive 98/104 (which is broadly similar to section 11(2) of the Ordinance) may be acquired in consequence of the use of that mark as part of or in conjunction with a registered mark. The court concluded, at paragraph 30 of the judgment, that –

"…acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient

that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.'

37. The relevant question here is therefore whether the relevant consumers of the goods applied for actually perceive the subject mark, although it is used in conjunction with the word marks "DURACELL" and/or "金霸王", to designate that the goods come from a given undertaking. I am not satisfied that this is the case.

38. The message about the subject mark being a signification of the type of product is a strong one. Nothing has been done to educate the relevant consumers about the trade mark significance of the subject mark. In the photographs showing the point of sale and the packaging, the advertising boards or posters, the subject mark appears only as an indication of what the actual products look like. There is nothing to suggest that the primary message conveyed by the subject mark has been displaced.

39. Further, one particular page in Exhibit DM-5 shows a one hour charger and some rechargeable batteries. The batteries that appear on that page are in shades of white and green and not, as in the case of the subject mark, in two distant parts, with the colour copper used in the shorter positive terminal part and the colour black used in the longer negative terminal part. This shows that the applicant does in fact use other colour combinations on the goods applied for. Instead of educating the relevant consumers that the representation of the battery in copper and black colours is meant to serve the purpose of distinguishing the goods of the applicant from those of other undertakings, the message that the subject mark as a whole conveys is merely that of a description of the kind of products sold.

40. In addition, although the Agents, in their letter of 20 June 2007, referred to sales figures for Hong Kong deposed to in the Second Statutory Declaration, it is not actually clear whether the sales figures set out in paragraph 7 of the Second Statutory Declaration concern sales in Hong Kong alone or they represent worldwide figures. Further, the dates of many of the materials contained in Exhibits DM-3, DM-4 and DM-5 are either not shown or are posterior to the date of the filing of this application.

41. For the reasons stated above and applying the principle in the *Windsurfing Chiemsee* case referred to in paragraph 25 above, I find the evidence submitted under the two Statutory Declarations fails to establish that the subject mark has come to identify "electric power sources, namely, electrochemical cells, batteries" as originating from a particular undertaking.

Other matters

42. In the Second Statutory Declaration, the applicant referred to the registration of the subject mark in many places around the world. Copies of the registration certificates of the subject mark in Australia, New Zealand, Thailand and Taiwan were exhibited. The reasons for the acceptance of the subject mark in those places are not known to me. I therefore do not consider these registrations to be of assistance to this application.

Conclusion

43. I have considered all the documents and evidence filed by the applicant together with all the written submissions made in respect of the application. For the reasons stated above, I find that, in respect of the goods applied for, the subject mark is, contrary to section 11(1)(b) and (c) of the Ordinance, devoid of any distinctive character and it consists exclusively of signs that may serve, in trade or business, to designate the characteristics of such goods. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow
for Registrar of Trade Marks
21 February 2008