

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300408131

MARK: NANOLENS

APPLICANT: NANOMOTION LTD

CLASSES: 7,9

STATEMENT OF REASONS FOR DECISION

Background

1. On 22 April 2005, Nanomotion Ltd (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the mark “NANOLENS” (“the subject mark”) in relation to the following goods:

Class 7: Electric motors, piezoelectric motors, gears for electric motors, gearbox assemblies for piezoelectric motors, electric motor and gearbox assemblies, piezoelectric motor and gearbox assemblies for positioning a lens in a camera or video camera.

Class 9: Camera lens modules; cameras; digital cameras; camera lenses; cameras (camcorder); video telephones; video cameras; portable telephones with camera and/or video function; lenses; scientific, electric, photographic, cinematographic and optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; accessories for cameras, namely exchangeable lenses, electronic flashes; apparatus and instruments for duplication of exposed photographic films; audio and video disks; audio and video tapes; audio mixers and audio speakers, automatic machines for processing exposed graphic arts film, paper and plates; automatic machines for processing exposed-medical X-ray films; camera cases and accessories, namely bags and straps; cameras for identification photography; cameras for special photography; cameras to record images viewed on cathode ray tube (CRT) display; cinematographic films; computer hardware; computer software (recorded); computers; data processing equipment and computers; densitometers; disposable cameras; electronic data processing machines for use by photographic finishing laboratory; films (exposed); filters (photography); flash-bulbs (photography) and stroboscope units; industrial meters used in photography, namely exposure meters, TV color balance analyzers, illuminance meters, luminance meters, colorimeters, spectroradiometers, thermometers, chlorophyll meters, spectrophotometers, glossmeters, UV radiometers, cathode ray tube (CRT) focus meters, color display measuring instruments, non-contact three-dimensional digitizers; microfilm cameras; microfilm reader-printers;

microfilm reading and/or receiving apparatus; motion picture cameras; batteries; photographic prints making apparatus; supporting computer software for use in conjunction with photocopying machines, tripods for cameras; video monitors, DVD players and recorders, stereo tuners, speakers, headphones, signal converters; all included in Class 9.

2. At the examination stage, objection was raised under sections 11(1)(c) and 11(1)(b) of the Ordinance in respect of goods in classes 7 and 9, except the following in class 9:

“apparatus for recording, transmission or reproduction of sound; namely bags and straps; computer hardware; computer software (recorded); computers; data processing equipment and computer; batteries; photographic prints making apparatus; supporting computer software for use in conjunction with photocopying machines; tripods for cameras; stereo tuners, speakers, headphones, signal converters.”

3. The basis of the objection was that the subject mark consists exclusively of a sign that designates the characteristics of the applied-for goods and is devoid of any distinctive character in respect of the goods.
4. On 3 January 2006, the Registry received a request for a hearing on the registrability of the subject mark made by Messrs So Keung Yip & Sin for the applicant.
5. The hearing took place before me on 6 July 2006. Mr. Woo Hing Yip, Eric, of Messrs So Keung Yip & Sin appeared for the applicant.
6. The applicant did not file evidence of use of the subject mark and I therefore have only the *prima facie* case to consider. I reserved my decision at the conclusion of the hearing.

The Ordinance

7. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1) reads 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 services, or other characteristics of goods or services; and
- (d) ...”

Decision

Section 11(1)(c) of the Ordinance

8. Section 11(1)(c) of the Ordinance excludes registration of 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.
9. Section 11(1)(c) is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (“Regulation No. 40/94”). 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 and stated the relevant principles as follows:
- “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.”: the ‘*DOUBLEMINT*’ case at paragraph 32.
10. These principles indicate that marks that are objectionable under section 11(1)(c) of the Ordinance do not have to be the typical way of describing the applied-for goods or services. It is sufficient if at least one of the possible meanings of a mark designates a characteristic of the applied-for goods or services.
11. The subject mark consists of the word “NANOLENS”. “NANO” is a prefix

denoting 10^{-9} and indicates extreme smallness (Collins English Dictionary, Third Edition). The word “LENS” has the dictionary meaning of “*a piece of glass or other transparent material used to converge or diverge transmitted light and form optical images*” or “*a device that diverges or converges a beam of electromagnetic radiation, sound, or particles*” (Collins English Dictionary, Third Edition). There is no stylisation of the subject mark or any other additional element to consider.

12. Given the dictionary definitions, the subject mark as a whole has the meaning of “extremely small lens”. In relation to the applicant’s goods in class 7, which comprise motors and gearbox assemblies, including those used for positioning a lens in a camera or video camera, the subject mark describes goods that are for positioning extremely small lenses. In respect of the applied-for goods in class 9 relating to imaging (such as cameras, photographic apparatus and apparatus for recording, transmission or reproduction of images) and scientific and optical apparatus, the subject mark carries the obvious message that they comprise or are related to extremely small lenses.
13. Websites quoted by the Registry’s examiners at the examination stage (the websites and their extracts are listed in Appendix A to this statement of reasons) show that the subject mark is used to denote extremely small lenses in relation to imaging. As such I am satisfied that the subject mark carries at least one possible meaning that designates a characteristic of the goods applied for.
14. Mr. Woo submitted that there was no definition of “NANOLENS” as a whole and the subject mark was a unique combination of words and not an expression of every day speech in Hong Kong or of technical terminology. He said that the subject mark was not capable of being used by other traders to designate a characteristic of their goods and there was no possible descriptive meaning of the subject mark.
15. I am not persuaded by Mr. Woo’s submission. The dictionary meanings of “NANO” and “LENS” and the results of the Internet searches support that in the context of the goods applied for the subject mark as a whole is apt to denote to the average customers the meaning of “extremely small lens”.
16. Mr. Woo drew my attention to *Campina Melkunie BV v Benelux-Merkenbureau* (Case C-265/00) [2004] E.C.R. I-1699 at paragraph 41 in which the ECJ discusses the registrability of marks consisting of a neologism in relation to Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988, the equivalent of section 11(1)(c) of the

Ordinance:

“.....a mark consisting of a neologism 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 within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes 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.”

17. Mr. Woo said that the combination of “NANO” and “LENS” was more than the mere sum of its parts. Mr. Woo submitted that the subject mark deviated from the normal linguistic usage, as “NANO” was usually used in connection with units of measurement such as “meter” and not with words such as “lens”. He submitted that the subject mark merely evoked a sense of high technology or precision but did not indicate any characteristic of the goods applied for.
18. As the prefix “NANO” denotes extreme smallness, I am not satisfied that the use of “NANO” is limited to units of measurement. There is the word “nanotechnology” and the examples at Appendix A refer to “nanospheres”, “nanoparticle” and “nanoshells” showing that the use of “nano” is not limited to units of measurement. Given the dictionary meaning of the prefix “NANO” and the word “LENS”, I do not find that the combination of “NANO” and “LENS” introduces any unusual variation as to syntax or meaning or deviates from the lexical rules of the English language. The same combination “nanolens” is used in the examples referred to in Appendix A to denote extremely small lenses. I am therefore not convinced that the subject mark is more than the mere sum of its parts. The mark as a whole does not create any impression other than the mere combination of the meanings of “NANO” and “LENS”.
19. I also note Mr. Woo’s query as to why certain goods could be accepted while others could not. He disagreed that for the motor products in class 7 the subject mark would refer to motors for moving small lenses. He suggested that if the same approach were adopted by the Registrar, the subject mark would also indicate that computer software could be used to control movement of small lenses or that photographic print making apparatus might contain small lenses. However, the Registrar had not apparently raised objections against such products.

20. I have considered Mr. Woo's submission carefully. In respect of class 7 goods, the specification includes "piezoelectric motor and gearbox assemblies for positioning a lens in a camera or video camera". When the subject mark is used in relation to these motors and assemblies, it indicates that these goods are for positioning extremely small lenses. In relation to the other class 7 goods listed in the specification, namely, "electric motors, piezoelectric motors, gears for electric motors, gearbox assemblies for piezoelectric motors, electric motor and gearbox assemblies", they are merely a broader description within which the goods "piezoelectric motor and gearbox assemblies for positioning a lens in a camera or video camera" fall. When the mark "NANOLENS" is used in relation to those goods, it similarly indicates that the goods are for positioning extremely small lenses. Therefore, I have to maintain objection against all the goods in class 7.
21. In relation to "computer software (recorded)" in class 9, I agree that the term would include products with the specific function of controlling the movement of extremely small lenses. Additionally I find that "supporting computer software for use in conjunction with photocopying machines" as well as the goods "computer hardware; computers; data processing equipment and computers" would include products that are used to control the movement of extremely small lenses. I also consider that "photographic prints making apparatus" can contain extremely small lenses. When used in relation to these goods, the mark "NANOLENS" indicates that these goods comprise or include, or are for controlling the movement of, extremely small lenses. As such, objection must also be maintained in respect of these goods in class 9.
22. On the other hand, I do not find that the subject mark is descriptive of "apparatus for recording, transmission or reproduction of sound; audio mixers and audio speakers; camera cases and accessories, namely bags and straps; batteries; tripods for cameras; stereo tuners, speakers, headphones and signal converters" ("acceptable goods") in class 9, as lenses are not directly related to their compositions or functions. As such I do not consider that the subject mark designates a characteristic of these products.
23. On the basis of my finding that in respect of all the applied-for goods other than the acceptable goods (collectively, the "objectionable goods"), the subject mark indicates that they are products that comprise or are related to extremely small lenses, or are for moving or controlling the movement of extremely small lenses, I conclude that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristic of the objectionable goods. The subject mark is therefore debarred from

registration under section 11(1)(c) of the Ordinance for the objectionable goods in classes 7 and 9.

Section 11(1)(b) of the Ordinance

24. Section 11(1)(b) of the Ordinance excludes from registration marks which are devoid of any distinctive character.

25. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (“*British Sugar*”), the approach in assessing distinctiveness was discussed. Jacob J said, on page 306 of *British Sugar*:

“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 the case *R v “Cycling IS...” Trade Mark Applications* [2002] R.P.C. 37, it was also stated (at paragraph 53) 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 test of registrability under the equivalent of section 11(1)(b) was further discussed in *Nestlé SA’s Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at paragraph 23):

“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. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the applied-for goods for which the applicant seeks registration. I must also have regard to the perception of a consumer who is reasonably well-informed and reasonably observant and circumspect.
29. In this application, the goods in question are essentially motors for moving lenses in class 7 and goods largely related to imaging in class 9. The relevant customers include the general public and professionals who are seeking these products. The subject mark will be applied to the products or their packaging. It is likely that the subject mark will be used in advertisements, promotional materials or websites for promoting the goods.
30. In this application, the subject mark consists of the word “NANOLENS” which is a term apt to denote extremely small lenses. There is no added element or stylisation to the mark. The overall impression of it on customers is likely to be that the applicant’s goods are for moving extremely small lenses or the goods consist of or are related to extremely small lenses. They are not likely to perceive it immediately as an indication of trade origin of such goods.
31. Relying on the above cases, Mr. Woo submitted that the essential function of a trade mark was to guarantee the identity of the origin of the products. He also submitted that in light of the unusual juxtaposition of the subject mark, the average consumers were not likely to perceive the subject mark as a whole as a characteristic of the goods. He referred me to the case of *Sat.1 SatellitenFernsehen GmbH v OHIM* [2005] E.T.M.R. 20 (C-329/02P) and quoted the passage at paragraph 28 of the case as follows:
- “Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character”.
32. I agree with Mr. Woo that a trade mark should serve as a guarantee of trade origin and should enable consumers to distinguish goods from one undertaking from another without any possibility of confusion. I also agree that in assessing the distinctiveness of a mark, it must be considered in its entirety.
33. However, for the reasons mentioned above, I do not find that the subject mark has any unusual juxtaposition. When the average consumers view the subject

mark as a whole and in light of the objectionable goods, they are likely to regard it as indicating goods for moving extremely small lenses, or goods consisting of or related to extremely small lenses. They are not likely to perceive it as a badge of trade origin.

34. Mr. Woo further submitted that Internet search shows that in Hong Kong the term “NANOLENS” referred mostly to the applicant. Meanwhile, the websites quoted by the Registry at the examination stage showed overseas and not local use of the subject mark. In particular, he said that the applicant was in the motor industry but the overseas websites quoted did not show that the subject mark was used by traders in that industry.
35. I am not persuaded by Mr. Woo’s submissions. The fact that a particular mark is not already used by other traders in the motor industry in Hong Kong does not necessarily demonstrate that the mark possesses any distinctive character in respect of the applicant’s goods. The crux of the matter is whether the mark would be seen by the average consumers as a badge of origin. The descriptive meaning of the subject mark is clear in respect of the objectionable goods. Furthermore the Internet search carried out by the Registry’s examiners shows that the subject mark is used as a term to indicate extremely small lenses for goods related to imaging. For the reasons discussed above, I do not consider that the subject mark could serve to distinguish the applicant’s goods from those of others unless consumers are first educated of its function through the use of the mark as a badge of trade origin.
36. Notwithstanding the above, I find that when the subject mark is used in relation to the acceptable goods in class 9, it will be perceived by the average consumers as a badge of trade origin. As such, I will not maintain objections under section 11(1)(b) of the Ordinance for the acceptable goods.
37. Based on the reasons stated above, I consider that the relevant consumers are unlikely to perceive the subject mark as an indication of trade origin of the objectionable goods, and the subject mark is therefore devoid of any distinctive character in respect of those goods. The subject mark is thus precluded from registration under section 11(1)(b) of the Ordinance in respect of the objectionable goods.

Reference to other registered marks

38. Mr. Woo referred me to a number of registered marks in Hong Kong such as “Microbeam”, “MICROTEL”, “TINYSWITCH”, “DISPOSALENS” and “MEMORYLENS” in relation to classes 7 and 9 goods. I do not consider it

appropriate to compare the subject mark with other registered marks. Each case must be considered on its own merits. 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* ([1966] R.P.C. 541) and the same must be true under the 1994 Act.”

39. Mr. Woo further submitted that the subject mark was accepted for registration in Canada and Taiwan but I do not find them of assistance to this application. It must be borne in mind that 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] R.P.C. 885).

Conclusion

40. In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application. On a *prima facie* basis, the subject mark is found to consist exclusively of a sign which may serve to designate the characteristics of the objectionable goods and to be devoid of any distinctive character under sections 11(1)(c) and 11(1)(b) of the Ordinance in respect of those goods. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of the objectionable goods.
41. The application for registration in respect of the acceptable goods can proceed to publication provided that the applicant files, on or before **29 December 2006**, a request for amendment of the subject application on Form T5A to restrict the specification to the acceptable goods (as set out in paragraph 22). If the applicant fails to do so on or before the above date, it shall be deemed to have abandoned the application in respect of those acceptable goods.

Sarah Li
for Registrar of Trade Marks
29 November 2006

Appendix A

1. http://www.eurekalert.org/pub_releases/2002-03/uoc--ubr_1031302.php

Equipped with a microlens about 300 microns in diameter, the microscopic scanner Lee tested is a square of about 1 millimeter on each side and can move a distance of 50 to 100 microns. Lee is also testing a **nanolens** as small as 500 nanometers in diameter, or 200 times thinner than a strand of human hair, and smaller than the average red blood cell...To make the scanner and lens, Lee employed technology similar to that used to manufacture microchips. The lens is made of a tiny drop of polymer shaped by surface tension and hardened by exposure to ultraviolet light. To focus the lens, Lee and Kwon adjusted the distance between the lens and sample.

2. <http://www.azonano.com/details.asp?ArticleID=274>

The team have designed a simple model of their **nanolens** process using a row of three successively smaller nanospheres from 50 to 5 nanometers in diameter.

3. <http://www.weizmann.ac.il/home/feyaron/microscope/microscope.htm>

When plasmons, which are excitations of surface modes on the nanoparticle, are excited, the nanoparticle acts as a **nanolens**, focusing the laser light to sub diffraction-limited spots. This results in significant enhancement of nonlinear processes such as THG. By controlling the surface chemistry of the nanoparticles it is possible to selectively attach them to different sites within the cell.

4. <http://www.pbs.org/wgbh/nova/sciencenow/3209/03-nanoshells.html>

NOVA scienceNOW: How, then, do nanoshells react to light?

Halas: Nanoshells are essentially a **nanolens**. They capture light and they focus the light around themselves. That gives them this beautiful sort of shimmery quality when we look at them in a beaker. And that is responsible for the very interesting color effects, namely, that when we look at them under illumination they have a different color [when seen] from one side [versus] the other. The color effects are also responsible for some of the more important properties that we use and exploit in biomedical applications, for example.