

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300492020

**APPLICANT : OSRAM GESELLSCHAFT MIT BESCHRÄNKTER
HAFTUNG**

CLASS : 9

MARK : 倍亮

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 September 2005, OSRAM Gesellschaft mit beschränkter Haftung (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559), to register the following mark:

倍亮

(“the subject mark”) in class 9.

2. The goods in respect of which registration is sought are:

“Light emitting diodes, also organic light emitting diodes, especially power laser diodes, light conductors, optoelectronic couplers, optical sensors, light barriers, light emitting diode lamp modules (modules with lamp functions designed from light emitting diodes, also organic light emitting diodes), especially for lighting and signalling purposes, displays (also organic displays) in light emitting diode technology.”

3. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance on the basis that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied-for goods, and is devoid of any distinctive character.
4. A hearing on the registrability of the subject mark took place before me on 4 January 2007 at which Ms Gloria Chow of Messrs Deacons appeared on behalf of the applicant. I reserved my decision at the conclusion 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.

The Trade Marks Ordinance

6. Section 11 of the Ordinance is in the following terms:

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

...

(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;

...”

Decision

The goods in respect of which registration is sought

7. In the subject application, the goods applied for consist mainly of light emitting diodes, light conductors, optoelectronic couplers, optical sensors, light barriers, light emitting diode lamp modules, especially for lighting and signaling purposes, and displays in light emitting diode technology.
8. Ms Chow submits the goods are or are related to light emitting diodes. The Encyclopedia Britannica Online (www.britannica.com) defines light emitting diode (“LED”) as follows:

“Semiconductor diode that produces visible or infrared light when subjected to an electric current, as a result of electroluminescence.

Visible-light LEDs are used in many electronic devices as indicator lamps (e.g., an on/off indicator) and, when arranged in a matrix, to spell out letters or numbers on alphanumeric displays. Infrared LEDs are used in optoelectronics (e.g., in auto-focus cameras and television remote controls) and as light sources in some long-range fibre-optic communications systems. LEDs are formed by the so-called III-V compound semiconductors related to gallium arsenide. They consume little power and are long-lasting and inexpensive.”

9. LEDs are therefore light-emitting devices, which are capable of being used in a wide range of different applications.

10. Ms Chow submits that LEDs are tiny electronic components, which can be implemented with other electronic component in order to form some larger electronic ended-products. Ms Chow submits that LED technology has appeared for about 30 years, and LEDs have been used in various industrial applications from switches to measuring instruments, as well as consumer products such as Hi-fi, telephones, personal computers, traffic signals and other indoor or outdoor automatic lighting. Ms Chow points out that LEDs offer a number of technological advantages: low-energy consumption, extremely long life, very low failure rate, small dimensions, shock and vibration-resistant, low radiation, low voltage, almost no heat generation and high colour efficiency. Owing to these advantages, products using LEDs can have creative design options (since LEDs are multiple-coloured, and are small in dimensions and have flexible modules). Additionally, these products have high efficiency and will be highly reliable even under difficult conditions.

11. At the examination stage, the applicant has been referred to two websites, which are intended to illustrate that brightness is a desirable feature for LED. Extracts from the websites are reproduced below.

- <http://superbrightleds.com>

LEDs have already replaced light bulbs in virtually all indication applications and now with the advent of super bright LEDs, many illumination applications are being taken over by LEDs also.

- http://www.otherpower.com/otherpower_lighting_leds.html

Light Emitting Diodes (LEDs) have been around for years in red, yellow and green. New technological advances have given us incredibly bright blue and white versions--the white LEDs on our products page are state-of-the-art in brightness. The rated brightness varies by how wide the beam angle is. LEDs with a super-high brightness rating also have a very narrow beam angle. Wider-angle LEDs have a lower brightness rating, but may put out just as much light. It's important to choose the beam angle to suit your needs.

12. Ms Chow submits LEDs are not everyday item, and their relevant customers include professional manufacturers and people in the electronic industry. LEDs are not generally available to the ordinary public. I agree with Ms Chow and consider that relevant customers of the applied-for goods consist mainly of people in the manufacturing industry who would like to use LEDs in their manufacturing processes, including the incorporation of LEDs into their own products.

Section 11(1)(c) of the Ordinance

13. 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 rendering of services, or other characteristics of the goods or services in respect of which registration is sought.
14. Ms Chow submits that descriptiveness should be determined not only in relation to each word taken separately, but the whole mark in question. I agree with Ms Chow. It is well established that in considering the registrability of a mark, the mark must be considered as a whole.
15. The subject mark consists of the Chinese characters “倍亮”. According to the Lin Yutang’s Chinese-English Dictionary of Modern Usage (<http://humanum.arts.cuhk.edu.hk/Lexis/Lindict/>), the character “倍”, as a noun, means fold or multiple times. As an adjective or adverb, the character means double or doubly. Regarding the character “亮”, two of its adjectival meanings are bright and shining. To my mind, the subject mark “倍亮”, as a whole, conveys the direct and immediate message of double or enhanced brightness. When used in relation to the applied-for goods, it will tell customers directly that the applied-for light-emitting diodes can emit brighter light, and that the related lighting devices such as

optoelectronic couplers, optical sensors, light barriers, etc can facilitate the emission of brighter light.

16. Ms Chow submits that in determining whether the subject mark is objectionable under section 11(1)(c), the Registrar should consider whether the subject mark may be viewed as the normal way of referring to the applied-for goods or their essential characteristics when used in common language. Ms Chow considers the answer must be negative because the subject mark does not have any concrete meaning. Ms Chow submits that the character “倍” means “fold, multiple times”, and the character “亮” means “brightness”. However she considers that there must be some kind of standard and reference to the extent of brightness mentioned in the mark in order to give some sense to it. Ms Chow elaborates that in Chinese, people will refer to the number of times by saying “一倍”, “兩倍”, or “三倍”..., instead of using the character “倍” in abstract. Ms Chow submits that there must be some kind of degree or extent of thing, or number of times to be emphasized, and without such reference, the subject mark “倍亮” does not have any descriptive meaning.

17. I am unable to agree with Ms Chow’s submissions. In the decision of the European Court of Justice (“the ECJ”) in *Wm. Wrigley Jr. Company v OHIM* [2004] 1 W.L.R. 1728 (“the *DOUBLEMINT* case”), it was held by the ECJ, at paragraph 32, that:

“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94 [*broadly similar in terms to section 11(1)(c) of the Ordinance*], 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.”

18. Additionally, in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2005] 3 W.L.R. 649 (“the *Postkantoor* case”), it was held by the ECJ, at paragraph 104, that:

“For the purposes of determining whether Article 3(1)(c) of the Directive [*First Council Directive 89/104/EEC - again broadly similar in terms to section 11(1)(c) of the Ordinance*] 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.”

19. The ECJ decisions indicate that marks objectionable under section 11(1)(c) of the Ordinance do not have to be the normal way of describing the goods or services in question. It is sufficient if the mark could be used for such a purpose. A mark is therefore objectionable if at least one of the possible meanings of the mark in question designates a characteristic of the goods or services concerned. Nor is it necessary for the relevant characteristics of the goods and services being described to be commercially essential.
20. With regard to Ms Chow’s submission that there must be some reference to the extent of brightness before the mark can give out sensible meaning, as shown in the Lin Yutang’s Chinese-English Dictionary of Modern Usage, the Chinese character “倍”, as an adjective and adverb, means double, or doubly. An example given in the dictionary is “倍增傷感”, meaning “doubly grieved”. More examples of this usage which I, as a Chinese speaker, can immediately think of include “倍覺”, “倍感”, “倍添”, “倍加”, etc. All these examples designate a double or an enhanced degree or extent with the first two terms referring particularly to a stronger feeling or sentiment. Accordingly, there is no need to have a particular reference as to the standard, extent or number of times in front of the character “倍” in order that the terms can have a meaning. To my mind, in the context of the above usage, the meaning of a double or an enhanced degree or extent is obvious. Similarly, the meaning of double or enhanced brightness is apparent from the subject mark “倍亮”, especially when it is used in relation to the applied-for LEDs and the related devices.
21. There is also Ms Chow’s submission that enhancing brightness is not necessarily one of the selling points of the applied-for goods. Ms Chow submits that apart from lighting purpose, LEDs also possess other advantages. For example, they can emit different colours, and they are shock-resistant and small in dimensions. As a result, they have been used in different innovative ways to form different kinds of products such as status indicators, remote controls for TV or VCR, optical fibre communication devices, movement sensors, etc. Ms Chow submits that although there may be light-emitting signals or buttons in these products, these signals or buttons are not the main features of the products, and in fact, brightness for them is not even necessary. Ms Chow therefore submits that the subject mark is not describing the essential characteristics of the goods. Ms Chow further submits that different products or end-users may require different degree of brightness, and there is no common standard or quantity of brightness that would give the best performance or can be said to be the best to the human eye.

22. I note Ms Chow's submissions but as explained, to be objectionable under section 11(1)(c), it is not necessary for the characteristic being described be commercially essential. It is sufficient if the characteristic is merely ancillary. In any event, the goods applied for in the subject application are not the status indicators, remote controls and communication devices, etc referred to by Ms Chow, to which brightness may not be an important or necessary attribute. The goods for which registration is sought are LEDs and related devices. The subject mark, which conveys the direct message of double or enhanced brightness, is apt to designate the characteristics of these LEDs and the related devices, which facilitate the emission of brighter light.
23. Given that apart from the characters “倍亮”, the subject mark does not contain other stylization or elements, the mark is considered to consist exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied-for goods. The subject mark is therefore objectionable under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

24. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character. It operates as a separate and independent ground of objection under section 11(1)(c) of the Ordinance
25. Ms Chow refers to the following passage given by Mr Justice Jacob in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 at 306:

“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. I further refer to *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2, in which Sir Andrew Morritt, the Vice-Chancellor stated, at paragraph 23, 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.”

27. Ms Chow submits that when considering whether the subject mark is devoid of any distinctive character, it must be considered as a whole and with reference to the applied-for goods. I agree with Ms Chow. As mentioned, a mark must be considered as a whole when considering its registrability. Additionally, as stated in *Have a Break, supra*, in assessing distinctiveness, the mark must be considered in relation to the goods for which registration is sought, taking into account the presumed expectation of the relevant customers.
28. Ms Chow submits that relevant customers of the goods applied for are professional manufacturers who, unlike consumers of everyday products, are expected to be more careful and ready in identifying the trade mark of various undertakings. Ms Chow submits the subject mark is not an ordinary dictionary word but an unusual combination of two Chinese characters. Ms Chow submits that when seeing the subject mark, relevant customers will be able to identify and understand that goods bearing the same are produced by one particular undertaking. Ms Chow therefore considers that the subject mark is not incapable of distinguishing the goods of one undertaking from those of other undertakings.
29. I cannot agree with Ms Chow's submission that customers will perceive the subject mark as a badge of trade origin which identifies the applied-for goods as originating from a single undertaking. As explained, the subject mark “倍亮” conveys the direct message of double or enhanced brightness. When used in relation to the applied-for goods, it will immediately tell customers that the applied-for LEDs emit brighter light, and that the related devices such as optoelectronic couplers, optical sensors, light barriers, etc facilitate the emission of double or enhanced brightness. Even though as submitted by Ms Chow, customers of the applied-for products may consist only of professional manufacturers, to my mind, when the subject mark is used in relation to the goods, they will merely perceive it as a descriptive designation, as opposed to an indication of the trade origin, which identifies the goods as originating from a particular undertaking. Without first being educated through use that the subject mark is the applicant's trade mark, I consider it unlikely that customers will perceive it as a badge of trade origin.
30. On the above basis, the subject mark is devoid of any distinctive character and is excluded from registration under section 11(1)(b) of the Ordinance as well.

Conclusion

31. In this decision, I have carefully considered all documents filed, together with all written and oral submissions made by 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.

Simon Chan
for Registrar of Trade Marks
21 March 2007