

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO.: 300521892**

**MARK:**   
**CLASS:** 2  
**APPLICANT:** ECKART GMBH & CO. KG

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 1 November 2005, ECKART GMBH & CO. KG (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:



(“the subject mark”) in class 2.

2. The goods in respect of which registration is sought are:  
  
“pigments; metal effect pigments, in particular aluminium pigments; pigments produced by a PVD (physical vapour deposition) process as a powder, paste, dispersion or concentrate for the production of paints, printing inks, lacquers, powder coatings, plastic materials and personal care products, in particular to be processed into manufactured preparations made from it, like semi-finished products, paint raw materials, concentrates and dispersions, in particular for use in the paint industry.”
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 25 July 2007 at which Ms Sandra Gibbons of Lloyd Wise & Co. appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.
5. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

### **The Ordinance**

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

“(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*

7. Section 11(1)(c) of the Ordinance excludes registration of trade 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.
8. 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:

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is

sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

9. Additionally, the ECJ stated in *Koninklijke KPN Nederland NV the Benelux-Merkenbureau* (Case C-363/99) [2004] ETMR 57 (the "POSTKANTOOR" case) that:

“96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word 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 to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements.”

10. As is clear from these authorities, I must, after all, consider the mark in its entirety, bearing in mind the meaning of each component which the mark is composed of in relation to the goods applied for.
11. The subject mark consists of the word “silvershine” in lower case with three radiant lines as shown in the representation in paragraph 1. In view of the bold face of the word “silver”, the word “silvershine” breaks naturally into the two words “silver shine”, and this is the way that the mark would be perceived by the average consumer.
12. According to the *Collins English Dictionary* (Third Edition updated 1994), “silver” means “a brilliant or light greyish-white colour; to become or cause to become silvery in colour” and “shine” means “to emit light; to glow or be bright with reflected light; the state or quality of shining; sheen; luster”. As a whole, the words carry the obvious meaning of shiny silver in colour or shiny silver in effect. Prior to the hearing, searches were conducted on the Internet on the usage of the term “silver shine” in relation to pigments. The search results indicate that the term “silver shine” are used by traders other than the applicant in a descriptive sense to describe pigments having a shiny silver colour or shiny silver effect. Excerpts of the Internet references are provided at *Annex A* to this decision. The Internet references confirm the overall descriptive message conveyed by the words “silver shine” as pointed out above.
13. In the instant case, I have not overlooked that the subject mark contains not only a word element, namely the words “silver” and “shine”, but also three radiant lines around the frontal part of the word “silver”. To my mind, it is commonplace to use radiant lines as a symbol or ornament to denote the shininess or shiny nature of something. The radiant lines, being synonymous with shining and brightness, are indicative and descriptive of the shiny characteristic of the goods applied for and they merely complement and strengthen the meaning conveyed by the words “silver shine” in the mark. The radiant lines are therefore descriptive of the applied for goods as well.

14. The meanings of each of the components have been explained above. In my view, each of the components in the mark is descriptive of the characteristics of the goods for which registration is sought. When the components are considered as a whole and in relation to the applied for “pigment; metal effect pigments, in particular aluminum pigments; pigments produced...for the production of paints, printing inks, lacquers, powder coatings” and so on, they convey a direct and immediate message that the applied for goods produce a shiny silver colour or shiny silver effect. I do not find the bringing together of all the components in the mark introduces any unusual variations, in particular as to syntax or meaning. The mere absence of a space between the words “silver” and “shine”, and the difference in the boldness of the characters used for the two words do not, in my view, give rise to an interpretation of their meaning that is different from one where the two words are separated. The three radiant lines in the mark, as explained, are indicative and descriptive of the shininess or shiny nature of the goods concerned and therefore serve to reinforce the overall descriptive connotation of the words “silver shine”. The mark as a whole merely indicates that the applied for goods produce a shiny silver colour or shiny silver effect. Thus, 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.
15. There is Ms Gibbons’ submission that despite the words “silver shine” do describe the characteristics of the goods, the unique features of the representation of the mark add something to the mark so that it does not solely function to describe the goods. I do not agree. A mark must be considered in its totality and it is the overall impression conveyed by the mark that matters. For the reasons given in paragraph 14 above, the mark as a whole merely indicates that the applied for goods produce a shiny silver colour or shiny silver effect. To borrow the words from the ECJ in the *POSTKANTOOR* case, I do not find that the mark in question as a whole creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. I therefore conclude that the subject mark is debarred from registration under section 11(1)(c) of the Ordinance.

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

16. Section 11(1)(b) of the Ordinance precludes from registration signs which are

devoid of any distinctive character. It operates as a separate ground independent of the objection under section 11(1)(c) of the Ordinance.

17. The relevant principles relating to distinctive character was laid down in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 (“*British Sugar*”), where Jacob J said at page 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?”

18. On the meaning of “devoid of distinctive character”, Ms Gibbons refers me to the following quotation from “*Cycling IS...*” *Trade Mark Application* [2002] R.P.C. 37, where Mr Geoffrey Hobbs Q.C. as the Appointed Person, 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.”

19. I refer further 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.”

20. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the applied-for goods. I must also have regard to the perception of an average consumer who is reasonably well-informed and reasonably observant and circumspect.

21. In the subject application, the goods in question essentially comprise of pigments in class 2. The average consumers for the goods at issue include trade purchasers and industrial users who have a need for pigments or who require pigments for the production of paints, printing inks, lacquers, powder coatings, plastic materials and personal care products etc.
22. Ms Gibbons has not disputed that the words “silver shine” in plain letters are devoid of any distinctive character and consist exclusively of signs which designate the characteristics of the goods, relying instead on the argument that the overall representation of the mark gives it distinctive character. Ms Gibbons submits that the mark is a creative design and contains a distinctive device which draws the attention of the consumers to the mark, and adds that the representation of the mark is more than just representing the words in a different script form.
23. I have considered Ms Gibbons’ submission above. However, in assessing the distinctiveness of a mark, the mark must be considered in its entirety rather than be dissected. The average consumer normally perceives a mark as a whole and does not proceed to analyze it in various details. It is the overall impression given by the mark which must be considered. I must consider whether the combination of the components of the mark and the way of presentation would give the mark distinctive character in respect of the specified goods.
24. As explained in paragraph 14 above, I consider that when the average consumer sees the subject mark used in relation to the applied for goods, it will convey to them the direct and immediate message that the goods applied for produce a shiny silver colour or shiny silver effect. The overall impression of the mark on the average consumers is likely to be a descriptive designation, telling them the characteristics of the applied for goods, rather than as a badge of the trade origin which identifies the applied for goods as originating from a single undertaking.
25. I have not failed to notice that there are three radiant lines in the mark, but for the reasons given in paragraph 13 above, I find that the radiant lines merely serve to reinforce the descriptive message conveyed by the words “silver shine” and do not bestow any distinctive character upon the subject mark as a whole. As regards the words “silver” and “shine”, for the reasons given in paragraph 14 above, I do not find the bringing together of these words and their difference in the boldness of characters would alter or otherwise diminish the descriptive connotation of the

mark.

26. Having considered the subject mark in its totality in respect of the applied for goods, I do not find that the mere combination of the components and the way of representation create a distinctive whole nor does it overcome the descriptive meaning of each of the components. After all, the mark as a whole merely indicates that the applied for goods produce a shiny silver colour or shiny silver effect. Consumers are therefore likely to perceive the mark as a sign which does no more than depict and describe a characteristic of the goods applied for, as opposed to a badge of trade origin identifying the goods as originating from a particular undertaking.
27. There is also Ms Gibbons' submission that the subject mark is a pattern that would not be adopted by other traders without improper motive. She argues that the mark is represented in a manner which is different and memorable. Ms Gibbons submits that consumers would not expect more than one trader to create such a unique design and it would be more than coincidence that more than one trader would create the same representation.
28. I am not persuaded by Ms Gibbons' submission. The crux of the matter is whether the mark would be seen by the average consumers as a badge of origin. For the reasons explained, I consider that the relevant consumers will merely perceive the subject mark as a descriptive designation, telling them that the goods produce a shiny silver colour or shiny silver effect. As the mark is apt for describing similar goods provided by other traders, it would not enable the relevant consumers to distinguish the applicant's goods from those of other undertakings unless and until they have been educated of its trade mark significance.
29. Accordingly, the subject mark cannot fulfill the essential function of identifying the trade origin of the goods applied for so as to distinguish them from those of other undertakings. I conclude that the mark is devoid of any distinctive character and is debarred from registration under section 11(1)(b) of the Ordinance.

*Offer of disclaimer*

30. Ms Gibbons submits that the applicant acknowledges that the words “silver shine” may in some unusual cases be used to refer to pigments in class 2 and does not claim exclusive rights in those words. She informs me that the applicant has offered to disclaim exclusive rights to the use of the words “silver shine”.
31. To my mind, the offer is merely stating that the applicant is willing to give up its rights over the use of the term “silver shine” if the subject mark is accepted for registration. This, however, cannot assist in making the subject mark distinctive. It also highlights the fact that the applicant accepts the term “silver shine” to be descriptive and devoid of any distinctive character in relation to the goods concerned.
32. In considering the distinctiveness of a mark, the mark has to be considered as a whole in the context of the goods sought for registration bearing in mind the absolute grounds of refusal provided in section 11 of the Ordinance. As I have already found the subject mark as a whole serves to designate the characteristics of the applied for goods and is devoid of any distinctive character, the offer of the disclaimer does not assist.

*Reference to other registered trade marks and foreign registrations*

33. At the hearing, Ms Gibbons draws my attention to a number of registered marks which comprise either of the words “silver” or “shine” on the Hong Kong trade marks register, and submits that the subject mark should likewise be considered distinctive and acceptable for registration. She also refers to Chapter 3 at Part 30 of the U.K. Trade Marks Registry Work Manual in relation to “Trade marks including prominent descriptive or non-distinctive signs with get-up and/or combined with other distinctive signs (“Surplus”)” and compare the subject mark with two trade marks quoted in that chapter.
34. I note the registrations to which Ms Gibbons refers but I consider that the grounds of objection to the present application are valid and I ought not to ignore them simply on the basis of some earlier acceptance. 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* (supra), at page 305).
35. Ms Gibbons further submits that the subject mark has been accepted as a Community Trade Mark in the European Communities in class 2. She submits that the level of distinctiveness required by the Office for Harmonization in the Internal Market in relation to a Community Trade Mark is comparable to that of an ordinary trade mark in Hong Kong.
36. I have considered the overseas registration. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other country is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). I must examine the registrability of the subject mark against the registration requirements laid down in the Ordinance and against the principles established in case law. As there are valid reasons for refusing the subject application, I should not simply follow the registration of another registry. This is especially so when the reasons and rationale behind the acceptance are not available before me.

### **Conclusion**

37. In this decision, I have carefully considered all the documents filed by the applicant, 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 under 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.

(Jessica Law)  
For Registrar of Trade Marks  
29 November 2007

## Annex A

1. [www.costenoble.de/seiten/perlglanE.html](http://www.costenoble.de/seiten/perlglanE.html)

Mearlite® pearl lustre pigments are made of bismuth oxide chloride and can be supplied either in paste form, dispersed in various water-based or solvent-based systems. They produce a high shine and very good coverage. The optical effects range from a soft satin sheen to a metallic **silver shine** for three-dimensional objects, coatings and printing inks.

2. [www.polyone.com/news/prodpr/wilflex%20textile%20screen%20printers.html](http://www.polyone.com/news/prodpr/wilflex%20textile%20screen%20printers.html)

Wilflex liquid silver is an opaque **silver shine** ink, and Wilflex bubble stretch is an ink base that creates an opaque, ... The liquid silver ink and bubble-stretch base can be used alone or with pigment concentrates to create textured, ...