

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

**APPLICATION NO.** : 300618895  
**MARK** : CHOCOLATE  
**APPLICANT** : LG Jeonja Joo-Sik-Hoi-Sa (LG Electronics Inc.)  
**CLASSES** : 9

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. This is an application of LG Jeonja Joo-Sik-Hoi-Sa (LG Electronics Inc.) of Seoul, Korea (“the applicant”). On 13 April 2006, the applicant applied to register the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

# CHOCOLATE

2. The registration of the subject mark is sought in respect of portable communications apparatus in Class 9 (“the goods applied for”).
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 was devoid of any distinctive character and consisted exclusively of a sign which might serve, in trade or business, to designate the characteristics of the goods applied for.
4. By a letter of 9 March 2007, the applicant requested a hearing on the registrability of the subject mark. The hearing was set down to take place before me on 11 September 2007, at which Mr. Dick Lee, Counsel, instructed by Ella Cheong (HK) appeared for the applicant. I reserved my decision at the end of the hearing.
5. No evidence of use of the subject mark has been filed in this application. I have, therefore, only the *prima facie* case to consider.

## **The Ordinance**

6. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 read 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 consists 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 goods or rendering of services, or other characteristics of goods or services; and
  - (d) ...”

## **Decision**

7. Following the sequence of submissions made by Mr. Lee at the hearing, I will consider the registrability of the subject mark in the context of section 11(1)(c) of the Ordinance first.

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

8. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve to designate the characteristics of the goods in respect of which registration is sought.
9. The subject mark consists of a common English word “CHOCOLATE” in plain block capitals without any stylization. It carries the obvious and ordinary meaning of “a moderate to deep brown colour” (*Collins English Dictionary, Third Edition updated 1994*). Also, “chocolate” is a commonly used word to describe a kind of food preparations or drinks made of cocoa.
10. Although Mr. Lee agreed that “chocolate” could refer to a dark brown colour, he asserted that rather than using it to describe the colour of any particular goods, the average consumer in Hong Kong would use the word “chocolate” to describe the food or snack.
11. It was also submitted by Mr. Lee that even if the people in Hong Kong used “chocolate” to describe the colour of the goods, they tended to use the phrase

“chocolate in colour” instead of the isolated word of “chocolate”. Mr. Lee concluded that the subject mark was not descriptive of the goods applied for.

12. Given that “chocolate” means “a dark brown colour”, which Mr. Lee did not dispute, I am unable to see the basis of Mr. Lee’s assertion that the relevant consumers would not use “chocolate” to refer to the colour of a product. In my view, it is not uncommon for people to describe colours by reference to edible products or produce. For example, “peach” and “salmon” are used to describe pink with an orange hue, and “cream” is used to refer to a yellowish-white colour. The mere fact that they are food sources does not prevent them from serving the purpose of designating a colour. Similarly, while “chocolate” may be used to refer to edibles, it is equally apt to be used to describe a dark brown colour.
13. When the subject mark is used in respect of the goods applied for, which are clearly inedible, it conveys a clear and direct message that the portable communications apparatus is wholly or partly in the colour of chocolate. I do not agree that to designate a dark brown colour, “chocolate” must be used in conjunction with other words such as “in colour” or “colour”. I have no doubt that “chocolate”, carrying the dictionary meaning of “a moderate to deep brown colour”, can be used to describe the colour in its own right.
14. Regarding Mr. Lee’s submission that the word “chocolate” carried more than one meaning and therefore the subject mark did not bear an unequivocal meaning of a dark brown colour, the European Court of Justice (“the ECJ”) in *Wm. Wrigley Jr. Company v OHIM* [2004] 1 W.L.R. 1728 (“the *DOUBLEMINT* case”) held that, at paragraph 32:

“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.”
15. For the purpose of section 11(1)(c) of the Ordinance, the relevant consideration is whether the mark carries a meaning which can be used for the purpose of describing the characteristics of the goods in question. It is of little relevance that the mark carries more than one meaning. To be precluded from registration under section 11(1)(c), it is sufficient if at least one of the mark’s possible meanings designates a

characteristic of the goods in question. Since it is indisputable that “chocolate” can be used to describe a dark brown colour and therefore designate the colour of the goods applied for, the mere fact that it also denotes a type of food preparation does not overcome the objection under section 11(1)(c).

16. I find little assistance from Mr. Lee’s submission that to describe the colour of goods, the average consumers in Hong Kong would use “brown” and “dark brown” instead of “chocolate”. 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.”

17. As illustrated in the *Postkantoor* case above, it is irrelevant if there are other, more usual words, for designating a particular characteristic of the goods. It is also irrelevant whether the same characteristic of the goods can be described by other terms. Section 11(1)(c) does not require that the word in question is the only way of designating the characteristic of the goods applied for.
18. It follows that even if “brown” or “dark brown” is more commonly used to describe the colour, the subject mark does not become less descriptive of the characteristic of the goods applied for. To my mind, the subject mark remains objectionable under section 11(1)(c) as it consists exclusively of a sign which may serve to designate the colour of portable communications apparatus, the goods applied for.
19. With reference to the Internet examples provided to the applicant during the examination stage, showing how other traders were using the word “chocolate” to describe the colour of their mobile phones, Mr. Lee observed that those examples related to overseas usage only. According to Mr. Lee, those examples could not serve as a general indication of how the subject mark would likely be used by the traders in Hong Kong or how the subject mark would be viewed by the relevant consumers in Hong Kong. Mr. Lee went on to submit that the subject mark was not commonly used in respect of the goods applied for in Hong Kong.
20. While current use of a mark to describe certain characteristics of the goods in question would be a clear indication that the mark can be so used, the lack of actual

use of the mark as a description does not mean that the mark cannot serve such purpose. Indeed, as stated in the *DOUBLEMINT* case, *supra*, to be precluded from registration under section 11(1)(c), it is not necessary for the mark to be in actual use at the time of the application for registration in a way that is descriptive of the goods in question. Whether the subject mark is currently used to describe the colour of the goods applied for is therefore irrelevant. It is sufficient that the subject mark could be used to designate a characteristic of the goods applied for. As the subject mark is capable of designating a colour, it consists exclusively of a sign which may serve to designate the dark brown colour of the goods applied for. Accordingly, the subject mark is precluded from registration under section 11(1)(c) of the Ordinance.

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

21. Regarding the distinctiveness of the subject mark, Mr. Lee reiterated that the word “chocolate” was not commonly used in connection with the goods applied for, which were technological devices as opposed to snacks or food. Mr. Lee also asserted that the applicant did not intend to use the subject mark to describe the colour of the goods applied for. To elaborate his submissions, Mr. Lee explained that upon seeing the subject mark in respect of the goods applied for, which could be of any colour, the relevant consumers would perceive the subject mark as referring to a brand or model or an indication of a particular trade origin without first being educated. According to Mr. Lee, therefore, the subject mark was sufficiently distinctive as a trade mark.

22. Section 11(1)(b) of the Ordinance, operating as a ground of objection separate and independent from that under section 11(1)(c), precludes from registration signs which are devoid of any distinctive character. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Mr. Justice Jacob said:

“What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

23. Further to the above principle, in assessing the distinctive character of a sign, Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2, at 26 stated 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.”


24. It follows that the distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. The distinctiveness of the mark must be assessed by reference to the goods for which registration is sought and the perception of the relevant consumers.
25. By nature of the goods applied for, which are essentially electronic apparatus for communication purpose, the relevant consumers are the members of the general public in Hong Kong who purchase or are looking for portable communications apparatus such as mobile phones. While it might be the applicant’s intention to use the mark to indicate origin, whether the relevant consumers would perceive the mark as a badge of origin in respect of the goods in question is a separate matter.
26. When assessing the distinctiveness of the subject mark, I must consider the context in which the mark is used in respect of the goods applied for. The fair use of a mark in respect of the relevant goods includes applying it on the goods or their packaging as well as using it in the course of advertising or promotion of the goods.
27. On seeing the subject mark on the packaging or promotional leaflets of the portable communications apparatus, the relevant consumers would perceive the subject mark as an indication that the product is chocolate in colour, or chocolate is one of the available colours. I am not satisfied that without first being educated, the relevant consumers would regard the subject mark, being a direct description of the colour of the goods applied for, as a guarantee of a particular trade origin.
28. I am not persuaded by Mr. Lee that by having the subject mark in capital letters, the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant, would perceive the mark in its entirety as something different from where the letters are in lower case. I do not consider that the relevant consumers would regard the mark as a badge of trade origin simply because it is presented in capital letters.
29. In *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v. OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60, the essential function of a trade mark is described by the ECJ as:

“to guarantee the identity of the origin of the marked product or service to the

consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin”

30. Having considered the subject application carefully, I am not persuaded that the relevant consumers would rely on the subject mark alone, without any possibility of confusion, to identify a particular undertaking from which the goods originate. The subject mark is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

*Other registered trade marks*

31. In support of the subject application, Mr. Lee pointed out that another mark of the applicant, , had been registered in respect of goods similar to those applied for, namely, “handsets; wireless telephones, satellite telephones; digital cellular phones; mobile phones; MP3 players; personal digital assistants”. According to Mr. Lee, both the registered trade mark and the subject mark conveyed a similar impression, the phrase “BLACK LABEL SERIES” in the registered trade mark should not make any difference and the subject mark should be allowed for registration.
32. The registrability of a mark must be assessed by reference to the mark in its entirety. I do not agree that the registered trade mark of the applicant conveys the same impression as that of the subject mark. The phrase “BLACK LABEL SERIES” in the applicant’s registered trade mark, as well as the respective positions of the words cannot be disregarded. In its entirety, the applicant’s registered trade mark carries a certain degree of distinctive character.
33. Additionally, Mr. Lee drew my attention to two other registered trade marks, “ORANGE” and “Ruby”. I have considered these registered trade marks but do not find them to be comparable to the subject mark. Each case must be considered on its own merits. The state of the register is of little relevance when there are valid grounds for refusal against the subject application.

*Foreign registrations of the subject mark*

34. In support of the subject application, Mr. Lee sought to rely on the registrations of the subject mark in Colombia, Denmark, Iran, Japan, Mexico, Norway, Singapore and Taiwan. It should be noted 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). The registrations of the subject mark in overseas jurisdictions do not serve to overcome the objections raised under section 11(1)(b) and (c) as stated above.

## **Conclusion**

35. In this decision, I have carefully considered all of the submissions, both written and oral, made by and on behalf of 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.

Margaret K.W. YU  
for Registrar of Trade Marks  
25 January 2008