

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300637687

MARK



APPLICANT

: Boehringer Ingelheim Pharma GmbH & Co. KG

CLASS

: 5

STATEMENT OF REASONS FOR DECISION

Background

1. On 2nd June 2006, Boehringer Ingelheim Pharma GmbH & Co. KG (“the Applicant”) of Ingelheim, Germany applied to register the three-dimensional mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).



2. Registration of the subject mark is sought in respect of “pharmaceutical preparations” in Class 5.
3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance, on the basis that the subject mark was devoid of any distinctive character. Upon the request of the Applicant, a hearing on the registrability of the subject mark took place before me on 25th April 2008, at which Mr. Philips Wong, Counsel, instructed by Messrs. Deacons appeared for the Applicant. I reserved my decision at the conclusion of the hearing.
4. The Applicant did not file any evidence of use of the subject mark. I therefore have only the *prima facie* case to consider.

The Ordinance

5. 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) ...
- (d) ...”

Decision

6. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character. As regards whether a mark is devoid of distinctive character, Mr. Justice Jacob stated in *British Sugar Plc v James Robertson & 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?”

7. In *Nestle SA's Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2 at 26, Sir Andrew Morritt remarked on the approach in assessing distinctiveness:-

“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.”

8. In view of the above legal principles, distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it for the purpose of section 11(2), 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, who are presumed to be reasonably well informed, circumspect and observant.

9. Further to the above and referring to the decision of the European Court of First Instance in *Henkel KGAA v Deutsches Patent –und Markenamt* [2005] ETMR 56, paragraphs 30 to 42 and the decision of the German Supreme Court in *Likoerflasche (“Liqueur Bottle”) Trade Mark* [2002] E.T.M.R. 41, paragraphs 19 to 22, Mr. Wong submitted that the following principles were relevant to the examination of a three-dimensional mark:
 - (a) it is inappropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves or the shape of the packaging of those goods than in the case of other categories of mark;
 - (b) in order to ascertain whether the shape in question may be perceived by the public as an indication of origin, the overall impression produced by the appearance must be analyzed. A sign consisting of a combination of elements, each of which is devoid of any distinctive character, can be distinctive provided that the way in which the various elements are combined indicates that the sign is greater than the mere sum of its constituent parts;
 - (c) a mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character.

10. While I am in agreement with Mr. Wong that the criteria for assessing the distinctive character of three-dimensional trade marks such as the subject mark are no different from those to be applied to other categories of trade mark (*Koninklijke Philips Electronics NV v Remington Consumers Products Ltd.*, European Court of Justice [2003] Ch. 159 at 174, paragraph 48), I find what the European Court of Justice has observed in *Henkel KGAA v Office for Harmonisation in the Internal Market* [2005] ETMR 44, paragraphs 38, 39 to be relevant:

“The Court of First Instance was also correct in stating that the criteria for assessing the distinctive character of three-dimensional shape-of-products marks are no different from those applicable to other categories of trade mark.

It none the less observed that, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark.

In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purpose of Art. 7(1)(b) of Regulation No.40/94¹. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision.”

11. Additionally, in an appeal from the decision of the UK Intellectual Property Office (formerly known as the UK Patents Office), Laddie J stated in *Yakult Honsha KK's Trade Mark Application* [2001] R.P.C. 39 at paragraph 10 that just because the shape in question is unusual or uncommon or fancy, it does not mean that the shape is inherently distinctive in a trade mark sense:

“...the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether *by itself* its appearance would convey trade mark significance to the average customer. For the purpose of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense.”

¹ Council Regulation (EC) No.40/94 of 20 December 1993 on the Community Trade Mark, the provisions of which are broadly similar to section 11(1)(b) of the Ordinance.

12. At the hearing, Mr. Wong explained that the subject mark represented an inhaler the inside of which was a chamber where a capsule could be placed. The protruding piercing button on the side would then puncture the capsule, thereby releasing the medication inside the capsule. The user could then inhale the medication through the mouthpiece of the container. Mr. Wong also submitted that the subject mark, unlike the other traditional inhaling devices which normally came in cylindrical shape or an elongated “L” shape, was an unusual shape and carried some unique features, namely:
 - (a) the device is designed in an egg-shaped form (oval shape) with a relatively flat body;
 - (b) the device is opened in the middle of its flat oval shape body;
 - (c) there is a large piercing button protruding from the lower part of the oval shape body;
 - (d) there is an oval-shaped window in the lower part of the device;
 - (e) when opened, there is a mouthpiece device designed in a flat oval shape inside the container.

13. In spite of Mr. Wong’s explanation of the use of the subject mark as an inhaling device, the distinctiveness of the subject mark must be assessed on the basis of the representation as filed. The subject mark is a three-dimensional shape of a device resembling a stand alone egg that is slightly flattened, with a protruding clasp on one narrow side and a small circular or oval window on the flat side. The upper part of the device is opened, revealing an inverted “T” device which has a hole on top (Mr. Wong described this inverted “T” device as a mouthpiece). While the hole in the mouthpiece would allow the applied for pharmaceutical preparations in different forms including pills, lotion, fluid and powder to be poured out, it is not apparent from the representation that there is a piercing mechanism as Mr. Wong had described.

14. The goods for which registration is sought are pharmaceutical preparations, the uses or types of which are not specified. The relevant consumers are thus members of the general public in Hong Kong looking for medications which treat different types of medical conditions. Presuming that the relevant consumers of the applied for pharmaceutical preparations are reasonably well-informed and observant, they would be used to seeing a wide variety of medicine containers in different sizes and shapes.

15. According to Mr. Wong, the features as stated in paragraph 12 above contributed to the distinctiveness of the subject mark. It should be noted at the outset that the mere fact that a shape is a variant of a common shape of the product concerned is not sufficient to establish that the shape is not devoid of any distinctive character. Ultimately, a trade mark is the kind of sign which permits the average consumer, who is presumed to be reasonably well-informed, observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention to the details.
16. To my mind, the slightly flattened egg-shape device and the fact that it is opened in the middle of the oval shape are features that are common to containers containing pharmaceutical preparations, which often come in many different shapes and sizes.
17. The features of the three-dimensional shape forming the subject mark which arguably differ from the most usual shapes of pharmaceutical preparations containers are the oval or circular shape window in the lower part of the device, the protruding clasp and the inverted “T” mouthpiece. Despite the suggestion that these features might not always be found in pharmaceutical preparations containers, they are not shown to be so uncommon in relation to pharmaceutical preparations containers such that they fulfil the essential function of indicating trade origin. For example, the oval or circular shape window would allow the user to see the contents inside the container and to decide how much of the medication is left, the protruding clasp is to open the lid of the container or to dispense the pharmaceutical preparations contained in the container and the inverted “T” mouthpiece would allow the user to get the pharmaceutical preparations out of the container.
18. To my mind, the combination of all the features of the three-dimensional shape concerned is not sufficient to influence the overall impression given by the subject mark to such an extent that it departs significantly from the norm or customs of pharmaceutical preparations containers. The relevant consumers would only perceive the subject mark on first impression as a container that carries the applied for pharmaceutical preparations but nothing more.

19. Additionally, I do not consider Mr. Wong's submissions that the subject mark did not contain any descriptive indication of its content and it was not a simple or common shape employed by other traders in the field to be of any assistance to the Applicant in the present application. Even if the subject mark is not descriptive of the applied for pharmaceutical preparations and other traders do not adopt a three-dimensional shape device or an inhaling device identical or similar to the subject mark, these propositions do not mean that the subject mark is distinctive in the sense that the relevant consumers would perceive it as an identifier that the pharmaceutical preparations bearing the subject mark originate from a particular undertaking
20. While I agree to Mr. Wong's submission that consumers would generally be more attentive in purchasing the applied for pharmaceutical preparations, it does not mean that the relevant consumers would perceive the subject mark as a badge of trade origin guaranteeing that the pharmaceutical preparations originate from a particular undertaking.
21. Owing to the grave if not fatal consequences of taking the wrong pharmaceutical preparations, I am of the view that the relevant consumers would indeed exercise a higher level of care in picking pharmaceutical preparations and in choosing a reliable source of the pharmaceutical preparations than in buying other products such as skincare preparations. When it comes to choosing pharmaceutical preparations, consumers generally are not in the habit of identifying the manufacturer or distributor by reference to the shape of the container in which such preparations are contained. I am not satisfied that without first educating the relevant consumers, the relevant consumers would rely solely on the subject mark, which consists of a three-dimensional shape of a container with an open lid, to identify a particular undertaking from which the pharmaceutical preparations originate.
22. In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. & Another*, supra, at 173, paragraph 30, the European Court of Justice stated what is considered to be the "essential function" of a trade mark:-

"...the essential function of the trade mark is to guarantee the identity of the origin of the marked product 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..."

23. In the subject application, the subject mark is essentially a three-dimensional shape of a container with an open lid. It would be perceived by the relevant consumers as a medicine container carrying the applied for pharmaceutical preparations which can be poured out or obtained through the mouthpiece but nothing more. The subject mark fails to perform the essential function of a trade mark by enabling the relevant consumers, without possibility of confusion, to distinguish pharmaceutical preparations of a particular undertaking from those of others.
24. For the reasons stated above, I find that the mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Foreign registrations

25. Mr. Wong drew my attention to the acceptance of the subject mark for registration as a Community Trade Mark and with the World Intellectual Property Organization designating different jurisdictions. It must 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, where there are valid grounds for refusal under the Ordinance. In the subject application, I am not convinced that the mark should be accepted for registration in light of the reasons for objections stated above.

Conclusion

26. In this decision, I have carefully considered all of the materials filed, including the written and oral submissions made by and on behalf of the Applicant. For the reasons given above, I consider that the subject mark is precluded from registration by section 11(1)(b) 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
6th October 2008