

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300676143
MARK : NSERIES
APPLICANT : NOKIA CORPORATION
CLASSES : 9, 38 and 41

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 July 2006, Nokia Corporation (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:

NSERIES

(“the subject mark”)

2. Registration of the subject mark is sought in respect of the following goods and services in classes 9, 38 and 41:-

Class 9

Telephones, mobile telephones; antennas, batteries, battery chargers, power supplies, housings or casings or covers, clips, carrying cases for mobile telephones, microphones, speakers, headsets, holders, desktop stands; car kits for the adaptation of portable communication apparatus and instruments for vehicular use, comprising of antennas, antenna transmission wires, antenna adapters, cables, earphones, hands free microphones, phone holders, speakers, car chargers, data cables and electrical wires; hand held unit for playing electronic games; computer game software and programs enabling users to play games with mobile phones; computer software and programs enabling

users of communication devices to simultaneously access databases and global computer networks; computer software enabling transfer of data between mobile communication apparatus; remote controls; calculators; MP3 players and radios.

Class 38

Telecommunication and wireless communication services, namely, satellite transmission, telephone communication, telegram transmission, teletext, facsimiles and electronic mail; recording, processing, storage and transmission of sound, voice, images, video and data by telephones.

Class 41

Education; providing of training; entertainment services, namely, providing music, videos, films, photographs, games and other multimedia materials by means of telephones; sporting and cultural activities.

(“the applied for goods and services”)

3. At the examination stage, objection was taken under section 11(1)(b) of the Ordinance on the ground that the subject mark is devoid of any distinctive character in relation to the applied-for goods and services.
4. The Applicant requested a hearing which took place before me on 18th June 2008. Mr. Ling Chun Wai, Counsel, instructed by Ella Cheong (Hong Kong) Limited appeared on behalf of the Applicant.
5. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

The Ordinance

6. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provisions under section 11(1) read as follows:-

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

...

(b) trade marks which are devoid of any distinctive character;

...”

Decision

7. Section 11(1)(b) precludes registration of trade marks which are devoid of any distinctive character. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is 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 (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60).
8. The terms of section 11(1)(b) of the Ordinance are broadly similar to section 3(1)(b) of the UK Trade Marks Act 1994, Article 7(1)(b) of Council Regulation (EC) No. 40/94 (“the Regulation”) and Article 3(1)(b) of the First Council Directive 89/104/EEC (“the Directive”).
9. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Mr. Justice Jacob stated as follow:-

“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?”
10. Later 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.”

11. In view of the above legal principles, the distinctiveness of the subject mark must be assessed by reference to the applied for goods and services for which the Applicant seeks registration, and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant. To determine whether the subject mark has any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the mark, assuming no use, serves to identify the Applicant’s products and services as originating from a particular undertaking, and thus distinguishing it from those of the other undertakings. In other words, the question is whether the perceptions and recollections the subject mark would trigger in the mind of the average consumer of the applied for goods and services would be origin specific (i.e. carry connotations of trade origin) or origin neutral (“*CYCLING IS ...*” *Trade Mark Applications* [2002] R.P.C. 37 at paras. 66-69).
12. In relation to the applied for goods and services, the relevant consumers are members of the general public in Hong Kong who are looking for consumers’ electronic products in Class 9, telecommunication or communication services in Class 38, or education or other services in Class 41. The normal and fair use of the subject mark includes applying it on the goods and their packaging or in advertising materials such as leaflets and websites to promote the applied for goods and services.
13. The subject mark consists of the word “NSERIES” in plain block capitals. The word “SERIES” means “a number of similar or related events or things coming one following another” (*Cambridge Dictionaries Online*¹); “a group or succession of related things” (*Collins Dictionaries Online*²). Given that the word “SERIES” is a common dictionary word, I consider that when customers come across the subject mark, they will naturally perceive it as a simple combination of the letter “N” and the word “SERIES”. I do not consider that

¹ <http://dictionary.cambridge.org/define.asp?key=71941&dict=CALD>

² <http://www.collinslanguage.com/results.aspx>

the absence of a space between “N” and “SERIES” in the subject mark would confer it a meaning or impression which is different from where the letter “N” and the word “SERIES” are separated by a space, a dash or a hyphen.

14. When the subject mark is used in relation to the applied for goods in Class 9, which are essentially consumers’ electronic products including telephones, mobile phones, personal digital assistants, computers and MP3 players, the relevant consumers would perceive the subject mark, on first impression, as an indication that the goods are of a particular product line of any trader, rather than the goods of a particular trader.
15. I refer to the internet references cited in the Notice of the Registrar’s opinion dated 12 September 2006 and the Notice of the Registrar’s further opinion dated 5 June 2007 (“the internet references”), which are now reproduced at the Annex to this Decision. The internet references show that the term “N SERIES” is apt to indicate a product line of any trader. Each of the proprietors referred to in the Annex has a product line called “N Series”. The internet references reinforce my view that when used in relation to the Class 9 goods applied for, the average consumer would perceive the subject mark as merely indicating that the goods are from a product line of any trader. The average consumer would not assume that different products provided under the subject mark come from the same or economically-linked undertakings. The message conveyed by the subject mark is therefore origin neutral, rather than origin specific.
16. Similarly, when the subject mark is used in relation to the Class 38 and Class 41 services applied for, the average consumer would perceive it as indicating that the services are part of a series provided by any trader, and not a particular trader. In relation to some of the Class 38 services, the subject mark may also convey the message that the services are designed or provided for a particular series of products of any trader. The average consumer would not assume that different services in Classes 38 and 41 provided under the subject mark all come from the same or economically-linked undertakings. In relation to the applied for services also, the message conveyed by the subject mark is origin neutral, and not origin specific. In the other words, the subject mark fails to perform the essential function of a trade mark, which is to

guarantee the identity of the origin of the applied for goods and services to the consumers by enabling them to distinguish the products and services from others which have another origin.

17. At the hearing, Mr. Ling referred me to paragraphs 40 to 44 of *Procter & Gamble Company v OHIM* [2002] RPC 17 (“*BABY-DRY*”). For completeness, I set out below the relevant paragraphs, starting from paragraph 39 of the judgment:-

“39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

41. It is true that Article 7(2) of Regulation 40/94 states that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. That provision, which was rightly cited at paragraph 24 of the contested judgment, implies that, if a combination of words is purely descriptive in one of the languages used in trade within the Community, that is sufficient to render it ineligible for registration as a Community trade mark.

42. In order to assess whether a word combination such as "BABY-DRY" is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies' nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.

43. As it is, that word combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria set forth in paragraphs 39 to 42 of this judgment. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.

44. Word combinations like "BABY-DRY" cannot therefore be regarded as exhibiting, as a whole, descriptive character; they are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration under Article 7(1)(c) of Regulation 40/94³."

18. Mr. Ling relied on the *BABY DRY* case and argued that the subject mark "NSERIES" is not immediately and obviously a combination of the letter "N" and the word "SERIES". He submitted that without any separation by a space or hyphen, the subject mark "may be" a lexical invention without any ordinary meaning bestowing distinctive power on the mark.
19. I do not agree with Mr. Ling's submissions. The first point to note is that the Court in the *BABY DRY* case was not seized of any question directed to the provisions of Article 7(1)(b) of the Regulation (similar to section 11(1)(b) of the Ordinance). The question it had to decide was whether the contested decision of the Court of First Instance should be annulled in so far as it upheld the decision of OHIM's first Board of Appeal to refuse registration of the designation *BABY DRY* on the basis of the provisions found in Article 7(1)(c)

³ which is broadly similar in terms to section 11(1)(c) of the Ordinance

of the Regulation (similar to section 11(1)(c) of the Ordinance) (*BABY DRY* case paragraph 11; “*CYCLING IS ...*” *Trade Mark Applications* [2002] R.P.C 37, paragraph 44(ii)). In the present case, the sole objection raised against the subject application is under section 11(1)(b) of the Ordinance. No objection is raised under section 11(1)(c) of the Ordinance. Whilst there is a degree of overlap between the respective scope of the absolute grounds of refusal listed in section 11(1) of the Ordinance, each of them is independent of the others and requires separate examination (*Deutsche Si-Si-Werke GmbH & Co Betriebs KG v OHIM* (supra), at paragraph 59).

20. Furthermore, I cannot agree with Mr. Ling that without any separation by a space or hyphen between the letter “N” and the word “SERIES”, the subject mark is a lexical invention without any ordinary meaning bestowing distinctive power on the subject mark. As stated in paragraph 13 above, I consider that notwithstanding the absence of a space between the letter “N” and the word “SERIES”, the subject mark as a whole would naturally be perceived by the average consumer to be a combination of the letter “N” and the word “SERIES”. The subject mark as a whole does not give a meaning or impression which is different from where there is a space or a dash between the letter “N” and the word “SERIES”. The absence of a space or hyphen does not confer on the subject mark as a whole any distinctive character. Furthermore, as traversed in paragraphs 14 to 16 above, the message the mark creates to consumers is an indication that the product or service is of a particular product line, rather than that it is the product or service of a particular trader. Therefore, I am not satisfied that without first being educated through use, the relevant consumers would regard the subject mark as a guarantee of trade origin.
21. Mr. Ling further argued that it is incorrect for the Registry to regard any mark which is a combination of something with the word “SERIES” would necessarily give rise to objection on the basis that consumers would perceive the mark as an indication that the goods and services in question belong to a “series” of products. He submitted that it is possible for a mark with the word “SERIES” to have distinctiveness, and referred to examples such as “NOKIA SERIES” and “NORTHY SERIES”.

22. The distinctiveness of each mark tendered for registration must be considered on its own merits by reference to the goods and services applied for and the perception of the average consumer for those goods and services. The examples referred to by Mr. Ling are not comparable to the subject mark. Neither of them consists of the combination of a single letter and the word “series”. The average consumer’s perception of those marks would be very different from that of the subject mark. I do not find those examples to be of any assistance to the Applicant’s case.
23. For the reasons stated above and without any evidence of use of the subject mark in respect of the applied for goods and services, I am not satisfied that without first being educated through use, the relevant consumers would regard the subject mark as a guarantee of trade origin of the applied for goods and services. Therefore, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Conclusion

24. I have considered all the documents and submissions filed by the Applicant and its agent in relation to this application. For the reasons stated above, I find that the subject mark is precluded from registration under section 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Original signed

Connie FU
for Registrar of Trade Marks
13 October 2008

1. www.enterasys.com/products/switching/7C10x/
Delivering the ease of deployment, predictable service, and forward migration required in today's networked environments, the Matrix **N-Series** is ideal for premium edge, collapsed backbone, distribution switching and server farm aggregation implementations.
2. www.redbooks.ibm.com/abstracts/sg247129.html/
The IBM System Storage **N Series**
This Redbook is an easy-to-follow guide that describes the market segment at which the IBM Network Attached Storage is aimed, and explains the IBM **N series** installation, ease-of-use, remote management, high availability (clustering), backup and recovery techniques, and software such as FlexVol..
3. www.photo.net/equipment/nikon/comparison-chart/
Nikon **N-series** Cameras Comparison Chart
In response to ongoing queries about which SLR is a good choice for beginners, I've compiled data on the Nikon N-series cameras into a pair of charts. The first chart compares the N70, N6006, N60 and N50 bodies.
4. [www.lenovo.com/shop/asiapacific/webapp/wcs/stores/servlet/CategoryDisplay?categoryId=4611686018425042855&Lenovo 3000 N Series Notebooks 3000 N Series](http://www.lenovo.com/shop/asiapacific/webapp/wcs/stores/servlet/CategoryDisplay?categoryId=4611686018425042855&Lenovo%203000%20N%20Series%20Notebooks%203000%20N%20Series)
Stylish widescreen notebooks combining popular features at a great price.
5. [www.1st-comms.com/1st communications nortel phones norstar nseries.htm/](http://www.1st-comms.com/1st%20communications%20nortel%20phones%20norstar%20nseries.htm/)
1st Communications are Nortel Accredited Experts who supply, install and maintain the Nortel Norstar **N Series** of phones. This includes the Nortel Norstar M7100N, Nortel Norstar M7208N, Nortel Norstar M7310N
6. [www.superwarehouse.com/Buffalo N-Series Connector \(M\) Antenna Cable \(33 ft\)/WLE-CC10/p/115728](http://www.superwarehouse.com/Buffalo%20N-Series%20Connector%20(M)%20Antenna%20Cable%20(33%20ft)/WLE-CC10/p/115728)
Buffalo **N-Series** Connector (M) Antenna Cable (33 ft) Sealed LMR-400 cables attach to AirStation Access Points to outdoor antennas. N-type Male connectors on each end
7. [www.alibaba.com/catalog/11628138/NEC Lavie N Series Battery Pack.html/](http://www.alibaba.com/catalog/11628138/NEC%20Lavie%20N%20Series%20Battery%20Pack.html/)
NEC Lavie **N Series** Battery PackLaptop Model: NEC: Lavie **N Series** Lavie N LN300/9DB Lavie N LN300/9DW; Lavie N LN500/9DB Lavie N LN500/9DW; Lavie N PC-LN3009DB ...