

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300708769


MARK : A) 
B) 

APPLICANT : MARS, INCORPORATED

CLASSES : 31, 41 and 44

STATEMENT OF REASONS FOR DECISION

Background

1. On 25 August 2006, Mars, Incorporated (“the applicant”) filed an application for the registration of two marks in a series  (the subject marks”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application is in respect of the goods and services set out in Annex A. The applicant is represented by Messrs. Yu & partners (“the Agents”).
2. At the examination stage, an objection was raised against the application under section 11(1)(b) of the Ordinance on the ground that the subject marks are devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objection was maintained by the Registrar.
3. The applicant requested a hearing on the registrability of the subject marks. The hearing was fixed to be held on 17 March 2008. The Agents filed Form T12 and confirmed the applicant’s intention to attend at the hearing. On 14 March 2008 nevertheless, the Agents wrote to advise that they would not attend the hearing. They also filed written submissions as well as a statutory declaration of Chan Kit Ping, Wendy for showing that the subject marks had acquired a distinctive character through use. Pursuant to rule 75 of the Trade Mark Rules (Cap.559, sub leg), I now proceed to decide the matter without a hearing.

Grounds of refusal under section 11

4. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Subsections (1) and (2) are relevant here and they read as follows:

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

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
- (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) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Decision

Inherent registrability

5. The applicant has submitted evidence to establish that the subject marks have acquired distinctiveness through the use that has been made of them. I will deal with the *prima facie* case first before I turn to the evidence that has been filed. I will therefore consider the objection that has been raised under section 11(1)(b) of the Ordinance.
6. The subject marks are the two dimensional representation of the outline of a head of an animal against a rectangular background. The shape of the outline of the head and the background are in the same colour. In the case of mark “A” in the

series, the colour purple has been claimed as an element of the mark.

7. The relevant principles applicable in the assessment of the distinctiveness of a mark have been considered in a number of UK cases. In the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, Jacob J (at page 306) set out the test as follows –

“What does devoid of 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?”

8. The test is put forward in another way in the case of *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23) as follows –

“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.”

9. In assessing the distinctiveness of a mark, the question to consider is whether the mark will be perceived as a badge of trade origin. The assessment is to be carried out in respect of the subject marks, with reference to the goods and services of the class for which registration is sought, as well as the consumers of those goods and services, who are reasonably well informed and circumspect.
10. The goods under application are agricultural, horticultural and forestry products, live animals, bones for dogs, edible chews for animals, products for animal litter, fresh fruits and vegetables, foodstuffs and beverages for animals and so on in class 31. Consumers of these products are people who grow plants or keep animals, whether in a farm or at their homes. They are therefore members of the general public.
11. As for the services applied for, they cover educational, advisory, training in

connection with the selection, care, nutrition, training and showing of pets, organization of pet shows and pet competitions and the provision of relevant information and material, training in computer and data processing techniques and so on in class 41 and veterinary services, veterinary information services, animal breeding advice, provision of advice on the grooming and hygiene of animals, adoption and fostering agencies relating to pet animals and so on in class 44. Similarly, all members of the general public can be pet owners and hence they are the relevant consumers of such services.

12. Each of the subject marks has only the figure of the outline of an animal's head against a same colour background. The outline is a very simple one. There is no memorable feature to speak of, nor any outstanding element that will help one to remember it or to distinguish it from the great mass of designs that one is swarmed with in the normal daily life of the Hong Kong public. When either of the subject marks is applied to the goods and/or services under application, it will be regarded merely as a decorative element on the packaging of the goods or part of the design of the promotional materials used in relation to the goods and services. It will not be regarded as an indicator of commercial origin.
13. I am mindful of the colour claim in mark "A". As colours are often used in packaging and promotion, members of the general public are used to colours being employed to attract their attention. Without first having been educated of the intended function of the subject mark, they will not regard the simple outline of a head of an animal, whether represented in the purple colour claimed in mark "A" or in another colour, to be a sign that serves to distinguish the trade source of the goods and/or services in question.
14. In the written submissions filed by the Agents, they referred to the outline of an animal's head in the subject marks. In particular, they pointed to the different shades of purple in mark "A" which, with the outline in gold and white in colour, created a "glow" around the device. According to the Agents, the "glow" is also featured around the device in mark "B". Furthermore, since features like eyes, nose, mouth and whiskers are not shown in the device, the Agents considered the subject marks to be fanciful and arbitrary and would have the capacity to function as a badge of origin.

15. In addition, the Agents noted that representations of animals were commonly used by traders in the field in their trade marks. They referred again to the examples they sought to rely on at the examination stage, namely, those mentioned in their letter of 19 April 2007. In those examples, the marks contain representations of cats or dogs. It was the Agents' case that since the subject marks simply comprised the outline of an animal's head, it was ambiguous in nature and would therefore leave a remarkable impression on the relevant consumers.
16. The Agents also made a point about the wide range of the goods and services covered by the application. They were of the view that the Registrar had only selected a number of items from the specification when concluding that the subject marks were devoid of any distinctive character and had ignored the great majority of other goods and services that were covered by the application.
17. The only colour claimed in respect of mark "A" is the colour purple. There is no mention of any claim for gold or white for the outline of the head of the animal in the subject marks. The outline is however clearly visible and the images submitted with the application form do show different shades of colour, with the lower right hand corner of the head in a darker shade in both mark "A" and mark "B". Also, as pointed out by the Agents, the device in each of the subject marks does not show the eyes, nose, mouth and whiskers of the animal. However, be that as it may, the overall impression that the average consumer of the goods and services in question will have of the subject marks is the same. That is, when used in relation to the goods and services applied for, the subject marks are decorative elements used as part of the packaging or in promotional items. Neither the outline of the head nor the different shades of colour (or the "glow" as referred to by the Agents) confer any distinctive character to the subject marks.
18. The fact that other traders commonly use representations of cats or dogs in their trade marks is of no assistance to the applicant. The distinctiveness of each mark has to be considered on its own merits. I also have difficulty in following the Agents' argument that the subject marks would leave a remarkable impression on consumers because of its ambiguous nature. In the examples quoted in the Agents' letter of 19 April 2007, the clear but specific way in which

the animal is represented in each particular trade mark attributes to the finding of the mark, when considered as a whole, as being distinctive, although it may not be a determining factor on its own. With the subject marks, the mere outline of the animal's head only gives the impression of a decorative element for use in the packaging or promotion of the goods and services in question.

19. On the other point made by the Agents, I stress that the objection under section 11(1)(b) of the Ordinance applies to the whole range of goods and services covered in the specification. There are indeed a few items of services in the specification which have made no specific reference to animals. They are the services of “organization of conferences and symposiums; production of cinefilms, films, DVDs, videos, records, posters, brochures and literature; training in computer and data processing techniques; sales training services” in class 41. Nonetheless, for the reasons stated above, when either of the subject marks is used in relation to any of such services, it will still be regarded merely as a design or decorative element adopted for the promotion of the services, and not as a guarantee of trade source.
20. In view of the perception that the relevant consumers of the goods and services applied for will have when they see either of the subject marks being used on such goods and services, it would not enable the relevant consumers to distinguish the goods and services of one undertaking from those of other undertakings. I therefore find the subject marks to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods and services applied for.

Acquired distinctiveness

21. According to section 11(2) of the Ordinance, a mark would not be refused registration under section 11(1)(b) if it has in fact acquired distinctiveness as a result of the use that has been made of it. The applicant has submitted a statutory declaration of Chan Kit Ping, Wendy (“Chan Declaration”). I shall consider whether the evidence shows that the subject marks have indeed acquired a distinctive character through use.
22. The relevant principle has been considered in the case of *Windsurfing Chiemsee*

Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger [1999] E.T.M.R. 585. The case is concerned with Article 3(3) of the First Council Directive 89/104/EEC which is broadly similar to section 11(2) of the Ordinance. The Court of Justice of the European Communities said in that case, at paragraph 54 –

“...a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings.”

23. In paragraph 7 of the Chan Declaration, it was averred that use of the subject marks commenced in Hong Kong in 1991. However, the use referred to of the subject marks is that in relation to pet foods and pet care products. All the sales figures, promotional expenditure and exhibits also relate to such products only. The Chan Declaration has provided no information about use of the subject marks in relation to the services applied for in classes 41 and 44 at all or the other goods in class 31 that are included in the specification of this application. The applicant has thus failed to establish that the subject marks have acquired a distinctive character through use in respect of any of the services applied for or the goods in class 31 applied for that are not pet foods or pet care products. I shall turn to consider whether the use on goods, as supported by the evidence filed, shows the acquisition of a distinctive character in respect of pet foods and pet care products.
24. I should first point out that although the Chan Declaration purports to support use of the subject marks in respect of pet foods and pet care products in general, all evidence filed is in respect of pet foods and pet care products for cats only. From the samples of the products and advertising materials exhibited to the Chan Declaration, it is noted that the applicant does market pet foods and pet care products for dogs as well but that is done under another brand name. Further, apart from products for cats and dogs, the use shown by the Chan Declaration does not extend to products for any other types of pets.
25. As noted in the written submissions filed by the Agents, the evidence submitted shows that the subject marks have been used alongside with the word marks

“WHISKAS” and/or “偉嘉”. According to paragraph 14 of the written submissions of the Agents, the applicant has been using the marks “WHISKAS”, “偉嘉”, “Whiskas and Cat Mask Device” and the subject marks together with the colour purple consistently throughout the years as an indicator of trade origin, and there have been various uses of the subject marks alone.

26. From the many samples of the products filed, it is clearly the case that purple is the feature colour used by the applicant in the packaging of a particular line of products marketed under the main brand name of “WHISKAS”. A Chinese version of “偉嘉” has been adopted and often used on its own or in conjunction with “WHISKAS”. As regards the other composite marks used by the applicant for this line of products, there are two further versions, the “Whiskas and Cat Mask Device” and the “Whiskas 偉嘉 and Cat Mask Device”. The so-called Cat Mask Device is actually the subject marks and it either appears in red or in purple. These composite marks are shown below.



I note that each of the subject marks has been invariably used together with either or both of the word marks and I cannot find one case of use of the subject marks alone. This is not necessarily fatal.

27. The sales figures of pet foods and pet care products bearing the subject mark set forth in paragraph 9 of the Chan Declaration are for the period commencing from 1998 and extending beyond the date of filing of this application. The sales are substantial. The amounts of promotional expenditure for such products for the same period are set out in paragraph 15 of the Chan Declaration. The figures are considerable. It should be noted that the sales figures and

promotional expenditure provided relate to the composite marks and not the subject marks *per se*. I therefore do not have before me the sales turnover and advertising expenses relating to the use of the subject marks alone. This does not necessarily mean that such information cannot be taken into account.

28. The Agents referred me to the decision of the Court of Justice of the European Communities in the case of *Societe des Produits Nestle SA v Mars UK Ltd* [2006] FSR2. In the case, the court had to decide whether the distinctive character of a mark referred to in Article 3(3) of the Council Directive 89/104 (which is broadly similar to section 11(2) of the Ordinance) may be acquired in consequence of the use of that mark as part of or in conjunction with a registered mark. At paragraph 30 of the judgment, the court concluded that –

“...acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.”

What I have to find out is therefore whether the relevant consumers of the goods applied for actually perceive each of the subject marks, although it is used in conjunction with the word marks “WHISKAS” and/or “偉嘉”, as an indicator that the goods come from a given undertaking.

29. When used as an element in the composite mark of either “Whiskas and Cat Mask Device” or “Whiskas 偉嘉 and Cat Mask Device”, each of the subject marks (in purple or not) is always subsumed as a background. The words “Whiskas” and “偉嘉” are always prominently displayed. When used in relation to pet foods and pet care products, the words “Whiskas” and “偉嘉” are much more distinctive than the subject marks, being the mere outline of a head of an animal. The impression that the relevant consumers have of either of the subject marks is likely to be overshadowed by the distinctive word marks “Whiskas” and “偉嘉”. Furthermore, the ® sign appears in each case next to the word mark(s) used but there is no indication (like the use of a TM sign) whatsoever that the cat mask device is to be regarded on its own as an indicator

of trade source. In the actual forms of these composite marks as used by the applicant, there is nothing to educate the relevant consumers that each of the subject marks is, in its own right, used for the purpose of identifying the products as originating from the applicant, or that it serves to guarantee the identity of the supplier of the products.

30. It is the Agents' suggestion that, as a result of the use demonstrated, the relevant consumers like pet owners and pet shop retailers would come to recognize that "WHISKAS" and the subject marks are associated with one another such that, when goods bearing only the subject marks are sold without reference to "WHISKAS", they would clearly identify those goods as originating from the applicant. Fairly strong evidence is required to show that there is indeed such association and the evidence submitted falls short of doing so. There is no evidence of any actual case of such association being made in the minds of the relevant consumers, nor is there any evidence which will justify the drawing of such an inference. In the absence of such evidence, the association suggested is unlikely to be made given that the subject marks are always subsumed as a background and they are wholly indistinctive of pet foods and pet care products. Furthermore, even if the relevant consumers do actually associate "WHISKAS" with the subject marks, the mere association of an element of a composite mark with the composite mark as a whole is not sufficient to establish the acquisition of a distinctive character by that element where the relevant consumers do not come to recognize that the element, when used on its own without reference to the word mark(s) of the applicant, serves as a badge of trade origin.

31. In the case of *Philips Electronics NV v Remington Consumer Products Ltd* [2003] RPC 2, the question of whether association of the mark with the trader is sufficient to give the sign a distinctive character for the purposes of Article 3(3) of the Council Directive 89/104 was considered. The mark in question was the shape of a shaver and the trader had been the only supplier of goods in that shape for many years. In paragraphs 64 and 65 of the decision of the Court of Justice of the European Community, it was stated –

“ 64. *Finally, the identification by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature*

and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings.

65. *In the light of those considerations, the answer to the third question must be that, where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character for the purposes of Art. 3(3) of the Directive in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking or believes that goods of that shape come from that trader. However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark.”*

It is clear that mere association is not sufficient. As noted in the *Philips* case, the expectations of trade origin have to be established by specific and reliable data. As pointed out in paragraph 29 above, the relevant consumers have not been educated of the trade mark significance of the subject marks. Thus, even if the evidence submitted had shown that the relevant consumers would associate the subject marks with “WHISKAS”, such association would not have justified a finding of the acquisition of a distinctive character by the subject marks on the basis of the use that has been made of them.

32. The purpose of filing evidence is to show that through the use that has been made of the subject marks, the relevant consumers have been educated of the trade mark significance of the subject marks. Instead of so educating the relevant consumers, the use so far, as can be gleaned from the evidence filed, does not support a case of either of the subject marks alone being intended to serve as a trade mark on its own. Thus, where designated exclusively by any of the subject marks, the consumers will not actually perceive the products as

originating from a given undertaking.

33. A fair analysis of the exhibits filed would require me to say a few words about the few items that are actually produced or shown in the advertisements of the applicant's products and which are in the shape of the cat mask device. There is a mat that is in the shape of the head of a cat but it is only shown in advertising materials used in 2007, that is, prior to the application date. Thus, the use of the subject marks on such mats has not been taken into consideration. Apart from the mats, I note that the applicant did make some other promotional items as souvenirs, gifts or as collectors' items in the shape of the cat mask device. These include feeding bowls and pendants attached to collars for pets. The shape of the cat mask device has also been adopted for use as the display panels and in racks or boards during promotional events.
34. There is no evidence about the extent of distribution of such items and in most cases, the word marks "WHISKAS" and/or "偉嘉" were also prominently displayed on the items. More importantly, those items are not the goods applied for, the use of the subject marks on them merely for advertising and promotional purposes offers little assistance for showing that the subject marks have acquired a distinctive character in respect of pet foods and pet care products. Such use merely reinforces the impression that the subject marks are decorative elements used on the packaging of such products or on promotional materials for such goods.
35. I note also that some of the applicant's products are sold in containers that are in the shape of the cat mask device. Such products are shown in the materials downloaded from the website of the applicant in Exhibit 13 of the Chan Declaration as well as samples of the products of the applicant in Exhibit 2 of that declaration. The website materials were downloaded in March 2008 and the copyright notice on it refers to the year of 2007. According to the description in the website materials, those products were then newly introduced by the applicant. There is no evidence that any of such products were sold in Hong Kong prior to the application date. Moreover, with these products that are packed in containers in the shape of the subject marks, there is invariably a label on the lid of each such containers which shows the composite mark of "Whiskas & Cat Head Device" in a prominent position together with other

information about the product in question. In such instances, the subject marks will merely be perceived as the shape of the containers. From the evidence submitted, there is nothing that shows that the perception of the relevant consumers about the shape of the containers has been displaced through the use of the subject marks in such manner.

36. Another case which the Agents sought to rely on is the passing off case of *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341. The Agents suggested that, despite a finding that the two word marks “JIF” and “REAL LEMON” were dissimilar, the House of Lords held in that case that there would be passing off in the sale of lemon juice by the defendants in plastic lemon-shaped containers which were similar in size, shape and colour as the containers of the plaintiff. According to the Agents, the case supports their argument that a “non verbal mark” can be used alongside a verbal mark and be equally capable of functioning as a trade mark in its own right.
37. I do not think the *Reckitt* case is of any particular relevance here. It is clear from the analysis in paragraphs 24-29 above that I do not rule out the possibility of a secondary mark, whether “verbal” or “non verbal”, to acquire a distinctive character through the use that has been made of it, which can be use of the secondary mark as a component part of a registered trade mark or in conjunction with a registered trade mark. However, as noted in paragraph 29 above, the evidence filed by the applicant fails to establish that the relevant consumers have been educated to regard the subject marks as an identifier of the trade source.
38. For the reasons stated above and applying the principle in the *Windsurfing Chiemsee* case referred to in paragraph 22 above, I find the evidence submitted under the Chan Declaration fails to establish that the subject marks have come to identify the goods and services applied for as originating from a particular undertaking or to distinguish the goods and services of the applicant from those of other undertakings.

Other matters

39. As noted in paragraph 15 above, at the examination stage, the Agents referred to

other registered marks in Hong Kong which incorporate figures of animals and which they considered to be similar to the present application. I have commented on their relevance in paragraph 18 above. The Agents had also referred to two other marks registered in the name of the applicant. One of these is the “Whiskas and Cat Mask Device” (300700118) and the other is the same mark with the word “Whiskas” omitted and the space left blank (300736632). I do not find the subject marks to be comparable to these two registered marks which are, on the whole, distinctive. Furthermore, it is well established by case law that comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration: see *British Sugar Plc v James Robertson & Song Ltd* [1996] RPC 281 at 305.

40. The Agents also referred to the registration of the subject marks in many places around the world, including Australia, the United Kingdom and USA. The reasons for the acceptance of the subject marks in those places are not known to me. I therefore do not consider these registrations to be of assistance to this application.

Conclusion

41. I have considered all the documents and evidence filed by the applicant together with all the written submissions made in respect of the application, whether at the examination stage or after the filing of Form T12. For the reasons stated above, I find that, in respect of the goods and services applied for, the subject mark is, contrary to section 11(1)(b) of the Ordinance, devoid of any distinctive character. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow
for Registrar of Trade Marks
30 July 2008

Class 31

Agricultural, horticultural and forestry products, grains and seeds; live animals, birds and fish; cuttlefish bone, bones for dogs, edible chews for animals, products for animal litter; fresh fruits and vegetables; foodstuffs and beverages for animals, birds and fish and additives for such foodstuffs.

Class 41

Educational, advisory, training in connection with the selection, care, nutrition, training and showing of pets; advisory and consulting services which educate owners and promote responsible pet ownership including advice on the selection, care and nutrition of pets and fish; animal training services; organisation of pet shows and pet competitions and the provision of relevant information and material; organisation of conferences and symposiums; production of cinefilms, films, DVD's, videos, records, posters, brochures and literature; training in computer and data processing techniques; sales training services; publishing of texts related to pet animals; pet and human photo studios; children's pet play centres; production of pet care TV programs, magazine, newsletter and internet sites; pet care education; the aforesaid services also being available from a computer database or from facilities on the internet.

Class 44

Veterinary services; veterinary information services; hospitals for animals, veterinary care clinics; animal breeding advice; provision of advice on the grooming and hygiene of animals; on-line advisory services relating to the feeding and nutritional requirements of animals; adoption and fostering agencies relating to pet animals; grooming salon service, relating to pet animals; breeding of animals.