

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

**APPLICATION NO.: 300710810**

**MARK:** Touch Window

**CLASSES:** 9 and 17

**APPLICANT:** Nissha Printing Co., Ltd. (Nihon Shashin Insatsu Kabushiki Kaisha)

---

**STATEMENT OF REASONS FOR DECISIONS**

**Background**

1. On 30 August 2006, Nissha Printing Co., Ltd (Nihon Shashin Insatsu Kabushiki Kaisha) (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:

**Touch Window**

(“the subject mark”)

2. Registration is sought in respect of the following goods in Classes 9 and 17:-

Class 9

Data input / output devices including but not limited to touch panels, touch screens, liquid crystal display panels, electronic pens and their parts and electronic machines incorporating the foregoing; portable telephones, personal digital assistants, smartphones, laptop computers, computers, digital cameras; printed circuits; integrated circuits.

## Class 17

Plastic semi-worked products having data input / output devices; plastic films other than for wrapping; plastic substances, semi-processed.

(collectively “the applied for goods”)

3. At the examination stage, objections were raised against the subject application under section 11(1)(b) and (c) of the Ordinance on the basis that the mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied for goods and is also devoid of any distinctive character.
4. On 4 October 2007, the Applicant requested a hearing on the registrability of the subject mark. The hearing was scheduled to take place on 29 August 2008 but the Applicant did not file Form T12 under Rule 74(5) of the Rules by the deadline of 25 April 2008. A notice of the refusal of the registration of the subject mark was sent to the Applicant on 1 September 2008. On 29 September 2008, the Applicant requested for a statement of reasons.

### **The Ordinance**

5. Section 11(1) of the Ordinance is 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 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) ...

6. The Applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

## **Decision**

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

7. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the kind, intended purpose, or other characteristics of the goods and services in respect of which registration is sought. The public interest underlying section 11(1)(c) of the Ordinance is to ensure that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.
8. In *OHIM v WM Wrigley JR Company* (“the *DOUBLEMINT*” case) [2004] R.P.C. 18, the European Court of Justice (ECJ) stated the following in relation to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark, which is broadly similar in terms to section 11(1)(c) of the Ordinance:-

“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. In relation to the applied for goods, the relevant consumers are members of the general public in Hong Kong. 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.
10. The subject mark consists of the words “Touch” and “Window” in plain form. According to *Collins English Dictionary, Millennium Edition*, “Window” means “an area of a VDU display that may be manipulated separately from the rest of the display area; typically different files can be displayed simultaneously in different overlapping windows” and “Touch” means “a gentle push, tap or caress”. When the subject mark is used in the context of the applied for goods which are

input/output devices and electronic products, the word “touch” also refers to the technology which allows users to interact with software and device by human touching and the combined term “Touch Window” would convey the message to the average consumers that the goods are the “kind” of products which can be operated by touching the window display area or the products have a window display with touch input facility. Touch input facility is a kind of technique which enables users to interact with what is displayed on the screen directly by a finger rather than indirectly with a mouse or other pointing devices. I also consider that the term may serve to designate the “intended purpose” of the applied for goods and the desirable “quality” in such goods as compared to less sophisticated models which do not offer such window display with touch input facility. As the subject mark contains only the term “touch window”, I consider that the subject mark as a whole consists exclusively of words which may serve in trade to designate the kind, intended purpose and quality of the applied for goods.

11. Prior to the hearing, searches were conducted on the Internet on the usage of the term “Touch Window” in relation to input /output devices and electronic products. The search results indicate that the term “Touch Window” is indeed used by traders other than the Applicant as a reference to a device of the kind like mouses, intellikeys, pressure switches etc. that are hand-operated devices for computers. As such the term is designating the kind of goods offered as I have discussed. The internet references cited in the Notice of the Registrar’s opinion dated 29 November 2006 (“the internet references”) are now reproduced at Annex A to this Decision.
12. In the light of the above, when the words “Touch Window” are used in relation to the applied for goods such as touch screens, display panels, portable telephones, personal digital assistants, computers and digital cameras in Class 9 and plastic semi-worked products having data input / output devices in Class 17, the subject mark informs the consumers the kind, quality and intended purpose of the applied for goods, namely, that they consist of or relate to a window display with touch input facility.
13. In a letter dated 25 May 2007, the Agent submitted that the subject mark is a

convert and skillful allusion to the character and quality of the applied for goods and is not purely descriptive. They also explained that the word “WINDOW” has other meanings and it may at the most refer to something displayed on a computer screen but not anything to be touched in order to carry out a function. Therefore, the word “WINDOW” is not synonymous with SCREEN, PANEL or DISPLAY and it would not be used by a customer to describe the applied for goods.

14. I do not accept the Applicant’s submissions. It is well established that a sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned (paragraph 32 of the *DOUBLEMINT* case). As with many other words, “Window” and “Touch” bear a range of possible meanings according to dictionaries. When they are combined together and used in relation to the applied for goods, they will immediately designate that the goods consist of or relate to a window display with touch input facility. In view of the descriptive message conveyed by the subject mark and the fact that there is no other element or stylization in the mark, 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 and therefore falls foul of section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

15. 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 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 (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60).
16. Section 11(1)(b) of the Ordinance is 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 and Article 3(1)(b) of the First Council Directive 89/104/EEC.

17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Jacob J. stated:-

“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. 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.”

19. 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 perception and recollection 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).

20. The relevant consumers who purchase the applied for goods are members of the general public. The subject mark may be applied on the packaging of the goods or

in advertising materials including websites for promoting the goods.

21. As demonstrated above, the subject mark conveys a descriptive meaning as to the kind, intended purpose and quality of the applied for goods. As such, I consider that when it is used in respect of the applied for goods, the relevant consumer would immediately perceive it, on first impression, as an indication that the goods consist of or relate to a window display with touch input facility, rather than that they are the goods of a particular trader. I am not satisfied that without first educating the public that the subject mark is a trade mark, the consumers would perceive the subject mark as a badge of origin and rely on it to distinguish the Applicant's goods from those of other traders. Therefore, the mark is also considered to be devoid of any distinctive character under section 11(1)(b).
22. The Agent pointed out in the letter dated 4 October 2007 that the examiner's reliance on the internet references is ill-founded since all of them are US based websites. In my view, the internet references quoted at the examination stage confirm the examiner's objection that the term "touch window" is used in a descriptive sense by the other traders. They do not form the basis of my decision but serve to reinforce my finding above that the subject mark is descriptive of the kind of goods offered and the average consumer would perceive the subject mark as a mere indication that the goods consist of or relate to a window display with touch input facility. The average consumer are unlikely to rely on the subject mark as a badge of trade origin for identifying the applied for goods as originating from a particular undertaking. The message conveyed by the subject mark is therefore origin neutral, rather than origin specific.
23. For the reasons stated above, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

*Overseas registrations*

24. The Agent also submitted in his letter dated 25 May 2007 that the mark "TOUCH WINDOW" was registered in Japan by the Applicant and by a third party in the US.

25. I have considered those overseas registrations. However, it should be noted that national trade mark rights are territorially limited and granted independently of each other. It is established that the bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). In the instant case, as I have found good reasons for refusing the subject application, I am not prepared to simply follow the decisions of other registries. This is especially so when the reasons and rationale behind the acceptances are not available before me.

### **Conclusion**

26. In this decision, I have considered all the documents and written submissions filed by the Applicant in respect of the subject application. For the reasons stated above, I find that the subject mark is objectionable under section 11(1)(b) and (c) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.



(Connie Fu)

for Registrar of Trade Marks

18 March 2009

1. <http://atto.buffalo.edu/registered/ATBasics/AdaptingComputers/MouseOptions/touchscreens.php>

The transparent **touch window**/screen mounted on or integrated into the computer monitor is another pointing alternative. It's a pressure-sensitive screen detecting your touch for cursor movement, clicking, and dragging. The student simply touches the area on the screen to select it. This is the most direct input, as all of the student's visual, physical and cognitive abilities are focused on a single target. Many bank and grocery market kiosks use this technology. Touch screens are available for most computer platforms, even for laptops.

2. [http://www.judylynn.com/prog\\_desc.php?PROG\\_NUM=801](http://www.judylynn.com/prog_desc.php?PROG_NUM=801)

Sample activity of arranging the steps in the task "Eating Cereal."

The student moves the pictures with a switch, mouse or **touch window** to the chronological position.

3. [http://www.bridgeview.spps.org/Assistive\\_Technology.html](http://www.bridgeview.spps.org/Assistive_Technology.html)

Bridge View uses assistive technology to meet the learning needs of students with disabilities to optimize student achievement and participation. Assistive technology is used throughout the school in various settings, ie speech, home ec, music etc. Each classroom has internet access. Most classrooms have 2-3 computers and a computer lab equipped with **touch windows**, intellikeys and pressure switches to access educational software. A SmartBoard is also available for student use. The SmartBoard is an interactive whiteboard. By projecting the computer images onto the SmartBoard, students are able to press on the touch-sensitive surface to access any computer application. A **touch window** allows students to use software by pointing to and touching the computer monitor. The students are able to select and move objects with the touch of a finger. The intellikeys is an alternative keyboard with a wide range of standard and custom overlays to provide student learning. Also available for classroom use is a cart equipped with a projector, powerbook and VCR to project lessons onto screens for maximum visual attending.