

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

**APPLICATION NO. : 300781371**

**MARK :** 

**APPLICANT : DEUTSCHE LUFTHANSA AG**

**CLASSES : 35, 39 and 43**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 16 December 2006, Deutsche Lufthansa AG (“applicant”) applied, pursuant to the Trade Marks Ordinance (Cap. 559) (“Ordinance”), to register the following mark that consists of a sound (“subject mark”):



2. Registration of the subject mark is sought in respect of the following services in classes 35, 39 and 43:

Class 35

Arranging and monitoring of programs related to customer loyalty, sale, bonuses and sales promotion; advertising; procurement of newspaper subscriptions; advertising by means of a customer loyalty program for the use of airplanes, hotels, rental cars and credit cards.

Class 39

Transportation, transport of passengers and goods by automobiles, trains, ships and airplanes; transportation and storage of goods, courier services; storage of goods, transportation of money and valuables, transport of ill persons; rescuing of persons; mail-order delivery services, namely

purchase-order acceptance and shipments of goods; packing and shipment of goods; services of an airline company, travel bookings, arranging and organization of travels, organization of transportation services, rental of airplanes and automobiles, reservation of rental cars, organization of city tours, procurement of tourist guides.

Class 43

Providing of food and drink for guests, and temporary accommodation of guests; hotel reservation.

3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the ground that the subject mark is devoid of any distinctive character.
4. A hearing on the registrability of the subject mark took place before me on 12 August 2008. Mr. Thomas Tsang of Messrs. Wilkinson & Grist appeared on behalf of the applicant.
5. The applicant did not file evidence of use of the subject mark. I therefore have only the *prima facie* case to consider. I reserved my decision at the end of the hearing.

**The Ordinance**

6. Section 11 of the Ordinance sets out the absolute grounds for refusal of an application for registration and the relevant provisions are:

“(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**

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

7. Section 11(1)(b) of the Ordinance (“section 11(1)(b)”) precludes from

registration marks which are devoid of any distinctive character. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Jacob J (as he then was) stated as follows:

“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?”

8. The test of distinctiveness was further discussed in *Nestle SA's Trade Mark Application ("Have a Break")* [2004] F.S.R. 2, at paragraph 23:

“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. Applying the above legal principles, to determine the distinctiveness of the subject mark under section 11(1)(b), the relevant issue in question is whether the subject mark, assuming no use, is capable of distinguishing the applied for services as originating from one particular undertaking from those of others. The distinctiveness of the subject mark is not assessed in a vacuum but must be assessed by reference to the services sought for registration and the perception of the average consumers for those services, who are presumed to be reasonably well informed, circumspect and observant.
10. I further remind myself that section 11(1)(b) does not draw a distinction between different types of trade marks, and the criteria for assessing the distinctive character of a sign which consists of a sound do not differ from those applicable to other types of marks. The registrability of the subject mark must, like words, figurative or other types of marks, depend on whether the sound forming the subject mark serves to identify the trade source of the services in respect of which it is to be used.
11. It has been held, however, by the Court of Justice of the European Communities (“ECJ”) that the relevant consumer’s perception is not necessarily the same in respect of different categories of marks. Average consumers are not in the habit of making assumptions about the trade origin of some categories of marks, to the extent it may be more difficult to establish

distinctiveness in relation to those categories of marks than for others. For instance, the perception of the relevant public of a word or figurative mark may be different from that of a mark comprising a three-dimensional shape of product (*Develey Holding GmbH & Co Beteiligungs KG v. OHIM* [2008] E.T.M.R. 20, at paragraph 80), a three-dimensional shape of packaging of goods (*Deutsche SiSi-Werke GmbH & Co Betriebs KG v. OHIM* [2006] E.T.M.R. 41 at paragraph 28), a colour (*Libertel Groep BV v. Benelux-Merkenbureau* [2004] F.S.R. 4 at paragraph 65), an advertising slogan (*OHIM v. Erpo Möbelwerk GmbH (The Principle of Comfort)* [2005] E.T.M.R. 58 at paragraph 34) or a design applied to the surface of goods (*Glaverbel v. OHIM* [2005] E.T.M.R. 70 at paragraphs 22-23).

12. Similarly, the average consumers are not accustomed to making assumptions as to the origin of the applied for services on the basis of a mark that consists of a sound such as the subject mark. I find the above ECJ's comments on the public perceptions are also applicable in assessing the distinctive character of the subject mark.
13. The subject mark consists of a sound represented graphically by musical notation set out in paragraph 1 above in the key of F major which is a made up of musical notes, namely, f, e, f and 2 c notes, forming a short tune.
14. The services sought for registration encompass a broad range, such as, "arranging and monitoring of programs related to customer loyalty; advertising" in class 35, "transportation; services of an airline company; travel bookings" in class 39 and "providing of food or drinks for guest; temporary accommodation" in class 43. The applied for services are essentially advertising, transport and providing of food and drink. The average, relevant consumers are members of the general public who seek for these services.
15. Short pieces of music or tune consisting of a few notes similar to the subject mark have often been used in connection with advertising and promotion of the applied for services or in the course of providing the applied for services. Assuming normal and fair use of the subject mark in relation to the applied for services, it is likely to be used on board of the applicant's aircrafts, in relation to customers on hold with hotline operators or at any customer's contact point, and in advertising and promotion of the applied for services that may be launched via broadcasting on radio and television, at promotion booths in shopping centres, on the street, or on websites. In my view, the average,

relevant consumers will simply perceive such music or sound as background, entertainment music or part of the audio effects in commercials or jingles to appeal to consumers or to add incitement to purchase the services in question.

16. Considering the subject mark, I find it to be a short tune formed by a few notes that lasts for a few seconds. When the subject mark is used in the course of the provision, advertising and promotion of various classes of services applied for, the relevant consumers would, on first impression, regard such sound as background, entertainment music or as a means to attract consumers' attention to the provision, advertisement or promotion of the applied for services rather than to denote trade origin. The average consumers are not very attentive in the sense that if a sign does not instantly indicate to them the origin of the goods or services but merely gives them purely promotional or abstract information, they will not take the time to enquire into the sign's various possible functions or mentally register the sign as a trade mark (*Sykes Enterprises, Inc. v. OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2003] E.T.M.R. 57). To my mind, the average consumers are generally used to hearing similar sort of sound in the course of the provision, advertising and promotion of the applied for services and would not necessarily perceive the subject mark as an indication of commercial origin without first being educated that the specific sound is a trade mark.
17. Mr. Tsang submitted that the subject mark had satisfied both criteria for registration of a sound mark, namely, a sign which was capable of being represented graphically and which distinguished the services sought for registration without any risk of confusion (*Shield Mark BV v Kist* [2004] Ch. 97). Mr. Tsang disagreed with the Registrar's view that the subject mark had an acoustic impression of a rising sequence of 4 tones and there was nothing unusual or uncommon in the tune. According to Mr. Tsang, the subject mark was not derived from either one or two note(s) or a lengthy piece of musical notation (such as a complete song) which was generally regarded as difficult to be perceived as a trade mark and stated that a sound mark derived from a short piece of simple musical composition tended to have better qualification as a registrable trademark as illustrated by the following sound marks on the register, namely 300430677AB, 300663750 and 300241019. Mr. Tsang emphasized that those marks have at least two features in common with the subject mark in that each of them was composed of a few musical notes with tied notes which carried a simple but catchy tune or acoustic impression; and were registered in respect of services. Mr. Tsang contended that the subject

mark ought to be examined on par with these registered marks precedents.

18. While the requirement of graphical representation of the subject mark is met for it is capable of represented graphically as shown in paragraph 1 above, I do not concur with the above remaining submissions of Mr. Tsang. In the first place, distinctiveness of a mark is not determined by the number of notes, the length of the tune or the impression generated by a piece of music. The crux of the test in assessing distinctive character under section 11(1)(b) is whether the relevant consumers will perceive the subject mark first and foremost as an identifier of the services applied for as originating from a particular undertaking. As mentioned in paragraph 16, upon hearing the subject mark in the context of the applied for services, the relevant consumers would not naturally think that the sound comprising the subject mark is an indicator of trade origin. I am not persuaded that the subject mark has anything unusual or uncommon such that the relevant consumers would rely on it alone as a badge of origin. With regard to the three sound marks as referred to by Mr. Tsang, as a general rule, each case must be considered on its own merits and comparison with other marks is not of assistance to the applicant (*British Sugar Plc v James Robertson & Sons Ltd* (supra) at 305). As there are valid reasons for refusal, I should not accept the registration of the subject mark merely on the basis of these earlier registrations in Hong Kong.
19. Mr. Tsang claimed that due to the unique nature of a sound mark, namely it cannot be perceived visually, every sound mark in reality inevitably conveyed such impression to the consumers as background music for advertising or promotion, particularly when the mark is applied for or used in the course of provision of services. Mr. Tsang contended that the Registrar's view on the subject mark was not real because its tune was not lengthy or apt enough to serve as a piece of decent background music for advertisement or promotion.
20. I must point out that it is in principle possible for a trade mark to serve dual purposes as a badge of origin as well as a promotional formula or slogan (*Best Buy Concepts Inc. v. OHIM* [2004] E.T.M.R. 19). That said, the crucial question is whether the subject mark indeed performs the function of an indicator of trade source, i.e. whether the subject mark which consists of a sound would be perceived immediately as an indication of the commercial origin of the services in question, so as to enable the relevant consumers to distinguish, without any possibility of confusion, the applied for services from

those of a different commercial origin.

21. Mr. Tsang asserted that the subject mark did not have a straightforward or typical tune that was widely known or used in relation to the applicant's applied for services. Mr. Tsang claimed that there was no evidence or suggestion before the Registrar that subject mark was known to be identical or confusingly similar to any other sound mark (i) in which another trader had prior rights; (ii) which had been commonly used in relation to the applied for services; and (iii) which had been widely known to be related to or associated with the kind, quality, function or other characteristics of such services. Mr. Tsang added that there was no indication that registration of the subject mark would unfairly prejudice or embarrass other traders in the same industry of the applied for services.
22. This submission does not assist the applicant, either. The fact that a sign or a mark is not widely or commonly known or used by traders in the same industry of the applied for services does not necessarily mean that it possesses any distinctive character. Nor the proposition that the subject mark is not identical or confusingly similar to any other sound mark a decisive factor. Given that it is prevalent for a sound or music of a sort similar to the subject mark to be heard in the course of the provision, advertising and promotion of the applied for services, the relevant consumers would simply perceive the subject mark as background, entertainment music or as a means to draw their attention to the services concerned. The perceptions that would trigger in the mind of the relevant consumer of the applied for services is that the subject mark is origin neutral instead of origin specific (Geoffrey Hobbs Q.C., the Appointed Person in "*Cycling IS ...*" [2002] R.P.C. 37 at paragraph 74). Unless and until the relevant consumers are educated that the subject mark is intended to be a trade mark, I consider that it is unlikely that the relevant consumers will perceive the subject mark as denoting trade source. The subject mark fails to perform the essential function of a trade mark by enabling the relevant consumers, on hearing the sound of the subject mark, to distinguish the applied for services from those of other traders.
23. On the above basis, the subject mark is devoid of any distinctive character and is debarred from registration under section 11(1)(b).

### *Reference to overseas registrations*

24. Mr. Tsang drew my attention to the fact that the subject mark had been accepted for registration for the same services applied for in Germany, the USA, and in the European Community as Community Trade Mark (“CTM”). Mr. Tsang stated that whilst he fully understood that the Registrar was not bound to follow these overseas registrations as trade marks law was territorial, such registrations, (in particular those registrations that were in English speaking countries, and since CTM registrations have effect in the UK) ought not be lightly disregarded when examining the subject application because they at least illustrated that the subject mark had been recognized as inherently distinctive in the UK and the international community.
25. I have considered those overseas registrations. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registrations in other jurisdictions is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). I must examine the registrability of the subject mark against the requirements under the Ordinance and the legal principles established in case law, instead of relying on the mere fact of overseas acceptances. As I have found valid reasons for rejecting the subject application for registration, I should not simply follow the decisions of other registries, particularly since the reasons and rationale behind these acceptances are not available before me. Those overseas registrations do not assist the applicant in overcoming the objection.

### **Conclusion**

26. In this decision, I have carefully considered all the oral and written submissions filed by or on behalf of the applicant in respect of the subject application. Based on the reasons stated above, I find that the subject mark is precluded from registration under section 11(1)(b) of the Ordinance and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Vivien LUK

For Registrar of Trade Marks

17 October 2008