

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300931644



MARK :

APPLICANT : S. MARTINELLI & COMPANY

CLASS : 32

STATEMENT OF REASONS FOR DECISION

Background

1. On 9 August 2007, S. Martinelli & Company (“the Applicant”) applied to register the 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 “fruit juices, aerated fruit juices and sweet cider” in Class 32.
3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the basis that the subject mark is devoid of any distinctive character.
4. The Applicant requested a registrability hearing which was postponed once at the Applicant’s request and eventually took place before me on 6 July 2009. At the hearing, the Applicant was represented by Mr. Joerg Sosna of Ella Cheong (Hong Kong) Limited. I reserved my decision at the conclusion of the hearing.
5. No evidence of use of the subject mark has been filed in this application. I have, therefore, only the *prima facie* case to consider.

The Ordinance

6. 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

Section 11(1)(b) of the Ordinance

7. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character. The test for distinctiveness was laid down by Mr. Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 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?”

8. The approach of assessing distinctiveness was further discussed by Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2, at page 26:

“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. It follows that the 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 or service 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 or services for which registration is sought and the perception of the relevant consumers who are presumed to be reasonably well-informed, observant and circumspect.

10. The goods for which registration are sought include “fruit juices, aerated fruit juices and sweet cider” in Class 32, which are fruit beverages that people regularly buy in supermarkets and convenience stores. The relevant consumers of the goods applied-for are therefore members of the general public.
11. The subject mark is a two-dimensional representation of a simple container decorated with some leaves and bands, without any word on it.
12. Mr. Sosna submitted that the subject mark is a creative work consisting of a short and round bottle which shape is itself unusual, and which is further decorated with leaves and bands protruding from its neck. He averred that the unusual proportions of the bottle, combined with the surpluses and embellishments on it, give rise to a novel and unique overall get-up of the Applicant’s products. For these reasons, Mr. Sosna concluded that the subject mark has the requisite distinctive character to qualify for registration.
13. I do not concur with Mr. Sosna’s view that the subject mark involves an unusual and novel design of a bottle that would leave a unique and distinctive impression in the mind of the customers. Taking a fair and normal view of the subject mark, I find it to be nothing more than a mere representation of a fairly ordinary round bottle. As bottles are commonly used for holding drinks and beverages, when the subject mark is used in relation to fruit juices, aerated fruit juices and sweet cider, the relevant consumers are unlikely to perceive such an ordinary bottle as a badge of trade origin upon first impression. Even if the short, round bottle is decorated or embellished with leaves and bands, the overall impression given by the subject mark remains as a device of an ordinary bottle that carries and contains the applied for goods. If the leaves add anything at all, they just indicate that the bottle may be used to contain something that is natural, which in relation to the applied-for goods has no trade mark significance. Without first being educated, the average consumers will not be able to rely on the subject mark alone as an indicator of origin for distinguishing the goods of the Applicant from those of other traders. This is particular so when the applied-for goods are daily items which the relevant consumers will not exercise special care and attention in their selection and purchase.
14. The facts of the present application are analogous to those in *Yakult Honsha KK’s Trade Mark Application* [2001] R.P.C. 39. The applicant in that case, a well-known Japanese manufacturer of probiotic milk drink, applied to register as a trade mark in

Classes 29 and 32 the shape of its bottle, which was refused by the UK Intellectual Property Office (formerly known as the UK Patents Office) on the ground that it was devoid of any distinctive character. The applicant appealed and argued that the Yakult bottle was of an unusual distinctive shape because of the presence and positioning of an indentation running around the circumference of the bottle. On appeal, the UK High Court of Justice upheld the decision of the hearing officer and concluded that the sign in question was indistinctive in the trade mark sense. In his judgement, Laddie J stated, in paragraph 10, as follows: -

“Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. As Mr. Thorley rightly conceded, 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.”

15. Even in the above *Yakult* case where the bottle shape in question was found to be novel and visually distinctive, the court has decided that the shape was devoid of distinctive character. In the present case, the merit of the application is even less given that the subject mark is, in my view, a mere representation of a fairly ordinary bottle which has nothing unusual or fanciful to speak of. I am not satisfied that without first being educated, the relevant consumers will regard the subject mark as being used to distinguish the Applicant’s goods from those of other traders.
16. Based on the above reasons, I find that the subject mark is devoid of any distinctive character in respect of the applied-for goods. The subject mark is thus precluded from registration under section 11(1)(b) of the Ordinance.

Another registered mark on the register

17. In addition, Mr. Sosna argued that a number of marks consisting of leaf devices had been accepted for registration in Hong Kong, and he saw no reason why the subject mark which consists of not only leaves and bands but also the shape of a bottle should not be allowed. He drew my attention to the leaf device under Trade Mark

No.199910986AA which has been registered in respect of teas in Class 30 and non-medicated beverages in Class 32.

18. I have considered the mark referred to by Mr. Sosna but I am of the view that it is not on par with the present application as the subject mark is a representation of a bottle decorated with leaves whereas the quoted example is a stylized representation of leaves devices. In any event, I do not think that it is appropriate to make direct comparison between different marks on the register. Each case must be considered on its own merits. This issue has been discussed in *British Sugar Plc* (supra): -

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

19. In the subject application, there are valid grounds for refusal and I am not convinced that the registration of another mark in Hong Kong is of any assistance to the Applicant in overcoming the objection.

Conclusion

20. I have carefully considered all of the submissions, both written and oral, 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.

Ryan Ng
for Registrar of Trade Marks
23 October 2009