



TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 301095480

MARK : (A) 
Strawberry
(B) 
Strawberry

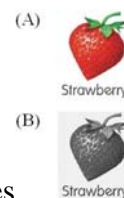
APPLICANT : STRAWBERRY COSMETICS (BRANDS) LIMITED

CLASSES : 3, 35

STATEMENT OF REASONS FOR DECISION

Background

1. On 17 April 2008, Strawberry Cosmetics (Brands) Limited (“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 goods and services in classes 3 and 35, details of which are set out in the Appendix 1 hereto. The applicant claims the colours red and green as elements of Mark A in the series.

2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the grounds that each of the subject marks consists exclusively of a sign which designates the characteristics of the goods and services applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.

3. The applicant requested a hearing on the registrability of the subject mark and

this was held before me on 24 November 2009. At the hearing, the applicant was represented by Mr. Andrew Chan of Messrs. Richards Butler, agents of the applicant. I reserved my decision until after the conclusion of the hearing. By a letter of 24 November 2009, Mr. Chan supplemented the submissions made at the hearing and sought to rely on the judgment of Reyes J in the case of *Re Creative Resources LLC* [2009] 1HKC 218. As the decision of Reyes J was overturned upon appeal to the Court of Appeal (CACV 15/2009), which was heard on 18 November 2009 but the decision of which was delivered on 15 December 2009, the applicant was given the opportunity to make written submissions in light of the judgment of the Court of Appeal. It did file written submissions on the matter in a letter from its agents dated 21 December 2009.

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

Grounds of refusal under section 11

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Only section 11(1) is relevant here and it reads 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.

Decision

6. My decision after the hearing is to allow registration of the subject marks in

respect of “compiling, arranging and publishing merchandise catalogues; compilation of mailing lists; direct mail advertising; on-line advertising; mail order promotions; sale promotion; advertising and business; business administration” in class 35. In respect of the goods applied for in class 3 (“Goods”) and the remaining services applied for in class 35 (“Services”), I maintain the objections raised and the reasons are set out below.

Section 11(1)(c)

7. Section 11(1)(c) precludes from registration trade marks that consist exclusively of signs which may serve, in trade or business, to designate a characteristic of the goods or services in respect of which registration is sought.
8. Each of the subject marks consists of two elements, the device of a strawberry and the word “Strawberry” beneath the device. Apart from the claim of the colours red and green in respect of Mark A, there are no other differences between the two marks forming the series. The word “Strawberry” appearing in the subject marks is presented in plain font with the letter “S” in capital and the rest of the letters in the lower case. The device of the strawberry is a common depiction of the fruit. Even with the colours claimed in respect of Mark A, they are the natural colours of a strawberry. There is nothing fanciful or stylistic in its representation.
9. The Goods are general cleaning and body care products like soap, cosmetics and toiletries while the Services are the sale of such products through different means. Fruits are often employed as ingredients of soap, cosmetics and toiletries products to give them a particular scent or flavour. This is supported by the findings on the Internet which have been drawn to the attention of the applicant during the examination stage. Details of these materials are set out in Appendix 2 hereto. The Services relate to the sale of the Goods by different channels such as retail, direct sale, mail catalogue and the internet.
10. The Goods are items used on a daily basis by everyone and so are the Services through which the Goods are purchased. The relevant consumers of the Goods and the Services are therefore members of the general public, who are reasonably well informed and circumspect. Upon seeing any one of the subject marks

being applied on the Goods and/or the Services, the impression they have of the mark will be the message that the skin care and cosmetics products being sold contain strawberry as ingredient or have the scent or flavour of strawberry. Thus, the subject marks consist exclusively of signs which may serve in trade or business to designate a characteristic of the Goods and Services.

11. Mr. Chan tried to convince me otherwise. He stressed that the subject marks would at most be suggestive. In his view, instead of perceiving the subject mark as an indication of the ingredient or flavour of the products being sold, relevant consumers of the Goods and the Services, being accustomed to the use of names and/or pictures of fruits being used as trade marks by different traders, would come up with the idea of vividness, cheer and bright-coloured. In support, he drew my attention to the registered marks referred to by the applicant during the examination stage, as well as a few other additional marks, whether registered in Hong Kong or in some other jurisdictions. All these marks have as their elements the names or devices of fruits or both and they are registered in respect of cosmetics and similar products or in respect of goods and services in other classes that are either similar or not similar to those applied for.
12. Reference was also made to the opinion of Advocate General Jacobs in the case of *OHIM v WM Wrigley JR Company* [2004] RPC 18 (“the *Doublemint* case”) where three points of view were expounded for distinguishing between terms that may be used to designate products or their characteristics and those that are merely suggestive of such characteristics. It is Mr. Chan’s submission that, following the approach of Reyes J in the case of *Re Creative Resources LLC*, *supra* in applying the principles of those three viewpoints, the subject marks are only suggestive of the Goods and Services and do not designate their characteristics. Although the decision of Reyes J has been reversed upon appeal to the Court of Appeal, it was pointed out on behalf of the applicant that neither the hearing officer nor the Court of Appeal in the *Re Creative Resources LLC* case suggested that the three viewpoints were wrong or irrelevant.
13. Mr. Chan also placed emphasis on the point that the subject marks are composite marks, being each comprised of a word and a device. By adopting the word “strawberry” and the device of a strawberry, the composite marks are, in his view, effectively “strawberry strawberry”. Mr. Chan put it to me that this would not

be the normal way of describing the flavour or smell of the cosmetic or toiletries products, nor would other traders wish to do so.

14. With regard to the Services in particular, Mr. Chan suggested that it was wrong to treat a characteristic of products as equivalent to a characteristic of the retailing services in relation to such products. He submitted that, unlike terms like “fixed location”, “online-retailing”, “business-to-consumer” which might be apt description of the act of selling product, it would not be appropriate to say that retailing services contain or use strawberry or are similar to strawberry. In his opinion, shoppers purchasing goods online or through mail, telephone, facsimile, e-mail or the Internet would not realistically consider the word “strawberry” as a description of the Services, but will understand that the subject marks have been put on the website or mail catalogue by the retailer, as opposed to the manufacture of the goods in question, to designate the identity of the retailer.
15. Mr. Chan added that even if strawberry could be used as the ingredients of some products sold under the Services, there was no immediately discernible link between the subject marks and the characteristics of the Services. He again referred to the registration of other marks which incorporate names and/or devices of fruits. In particular, he referred to the registration of the word “ORANGE” in Class 35 in respect of , inter alia, the bringing together, for the benefit of others, of cosmetics and personal care products enabling customers to conveniently view and purchase those goods.
16. Mr. Chan also challenged the relevance of the internet findings in Appendix 2 in relation to the Services. He pointed out that those findings showed the word “strawberry” being used to suggest that strawberry was used as ingredients of the products but they could not be used to suggest that the word as being capable of designating any characteristic of the Services.
17. I do not propose to set out the three viewpoints mentioned in the *Doublemint* case since I do not consider them to be relevant here. In the judgment of the Court of Appeal in the *Re Creative Resources LLC* case, the failure of the judge in the Court of First Instance to refer to the fact that the threefold test advocated by Advocate General Jacobs in the *Doublemint* case was not taken up in the

judgment of the court or to the observations of the hearing officer that the test, in particular the third viewpoint, was in contrast with the judgment of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) [2004] E.T.M.R. 57 was specifically criticised. I consider the approach adopted by the hearing officer in the *Re Creative Resources LLC* case to be the right one and it is time that the threefold test be put to rest.

18. As for the other submissions of the applicant, I agree that the subject marks are indeed composite marks formed in each case by depicting a strawberry above the word of the fruit itself. There is also the use of the colours as claimed in the case of Mark A. All these factors do not however mean that the relevant consumers will think of the marks as “strawberry strawberry”. Instead, the relevant consumers will not pay attention to the fact that the idea of a strawberry is presented in two ways, the literal form as well as the pictorial, and only one single combined message of strawberry will be conveyed.
19. Furthermore, to indicate the scent or flavour of the ingredients of cosmetics and toiletries products, the use of a picture of the origin of the scent together with the literal description is nothing other than a normal way to go about doing so. Adopting such way of describing the products can assist consumers to easily pick out a cosmetics or toiletries product of a particular scent or flavour from among the choices available and thus aid them in their selection of goods. I do not therefore agree that other traders would not wish to describe their goods in the same or a similar way. Thus, instead of being accustomed to the use of names and/or pictures of fruits as identifiers of trade source, the average consumers are used to regard such signs as indications of the particular scents or flavours of the merchandise.
20. I have difficulty in following Mr. Chan’s argument that it would be wrong to treat a characteristic of products as equivalent to a characteristic of the retailing services in relation to such products. With applications for registration of trade marks in class 35 for retailing services, applicants have to indicate the particular goods or the means of providing the services so that the specific scope of protection sought can be clearly ascertained. In the present case, the particular goods for which the various means of retailing services relate to are soaps, cleaning preparations, essential oils, cosmetic products, toiletries, perfumes, skin

care products, hair care preparations. Hence, the message denoted by the subject marks is directly related to the type of soaps, cosmetic products etc. that are the subject matter of the retail services, whether provided online or through mail, telephone, facsimile, e-mail or the Internet.

21. I also do not find Mr. Chan's suggestion that other terms would be more appropriate to serve as description of retail services to be of assistance. We are not concerned here with deciding on the term that best describes the services in question. We need only consider whether the subject marks may serve to describe such services. When any one of the subject marks is used in respect of services relating to the sale of the Goods, whether by way of retail store services, mail-order catalog services or online retail services, it merely indicates that the services relate to the sale of such products that have strawberry as ingredients or are strawberry-scented or flavoured. Contrary to what Mr. Chan suggested, I find the message to be immediately discernible, without any need to resort to imagination or other mental exercise.
22. With the registered marks referred to by Mr. Chan, it is well established that the registrability of each mark has to be considered on the basis of its own merits. As noted by Jacob J in the case of *British Sugar v James Robertson and Sons Ltd*, *supra*, at page 305 "*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, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act.*". The task I have before me is therefore not the reconciliation of these cases with the present application but the assessment of the registrability of the subject mark purely on the basis of its own merits. The reference to other existing registered marks is thus of no assistance to this application. This is also the case with marks registered in other jurisdictions when the reasons for their acceptances are not known to me and there are valid grounds for raising the objections under the Ordinance.
23. As for the internet findings, they were cited for illustration only. The objections against the registration of the subject marks in respect of the Services, as well as the Goods, are based squarely on the signification of the marks as perceived by the relevant consumers. In view of the clear message conveyed by the subject marks, they merely consist of signs that may serve to designate the characteristic

of the Goods and Services. That being the case, they are precluded from registration under section 11(1)(c) of the Ordinance.

Section 11(1)(b)

24. Principles on how the assessment of whether a mark has any distinctive character is to be carried out can be found in a number of UK cases. According to Jacob J in the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, the test is (at page 306) –

“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?”

25. The test as stipulated in the case of *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23) is 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.”

26. In assessing the distinctiveness of a mark, I have to consider 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. Although the relevant consumers are reasonably well-informed and circumspect, they cannot be expected to exercise more than an average level of care and attention.
27. When any one of the subject marks is used on the Goods and/or the Services, the first and foremost impression that the relevant consumers will have is its descriptive message about the ingredient or flavour of the cleaning preparations,

cosmetic products, perfumes etc. being sold or of the subject matter being offered by the retail or other sale services being provided. The subject marks are therefore not the sort of signs that can do the job of distinguishing the goods and services of the applicant from those of other undertakings without the consumers first being educated that they are trade marks. The subject marks are hence also precluded from registration under section 11(1)(b) of the Ordinance.

28. Apart from the arguments made in relation to the objection under section 11(1)(c) of the Ordinance, Mr. Chan stressed that the combination of a device of a strawberry and the word “Strawberry” gave the subject marks additional distinctiveness as opposed to a single word mark. Comparison was again drawn with other registered marks consisting merely of words that were the names of fruits.
29. I have duly considered the effect of the combination that forms the subject mark, including the colour claims in the case of Mark A. I have also explained why I do not find the registered marks referred to to be of relevance. As noted in the above, the overall impression that consumers of the Goods and Services will have of the subject marks is merely that of a designation of a characteristic of the Goods and Services. The relevant consumers will not realize that the subject marks are intended to identify the Goods and/or Services as originating from a particular undertaking, without their being first educated of their trade mark significance. 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.

Conclusion

30. I have considered all the documents filed by the applicant together with all the oral and written submissions made in respect of the application. For the reasons stated above, I find that, in respect of the “soaps, cleaning preparations, essential oils, cosmetics products, toiletries, perfumes, skin care products and hair care preparations” in Class 3 and “retailing services, direct selling, online retailing services and mail catalogue services in relation to soaps, cleaning preparations, essential oils, cosmetic products, toiletries, perfumes, skin care products, hair care preparations; direct selling through telephone, facsimile, e-mail and through

the Internet” in Class 35, the subject marks are, contrary to section 11(1)(b) and (c) of the Ordinance, devoid of any distinctive character and they consist exclusively of signs that may serve, in trade or business, to designate the characteristics of the particular goods and services. The application is accordingly refused under section 42(4)(b) of the Ordinance.

31. As I find that the registration of the subject marks can be accepted in respect of “compiling, arranging and publishing merchandise catalogues; compilation of mailing lists; direct mail advertising; on-line advertising; mail order promotions; sale promotions; advertising and business; business administration” in Class 35, this application can proceed to publication provided that the Applicant files, on or before 22 February 2010, a Form T5A to restrict the specification to “compiling, arranging and publishing merchandise catalogues; compilation of mailing lists; direct mail advertising; on-line advertising; mail order promotions; sale promotions; advertising and business; business administration”.

Caroline Chow
for Registrar of Trade Marks
22 January 2010

Appendix 1

Class 3

Soaps, cleaning preparations, essential oils, cosmetics products, toiletries, perfumes, skin care products and hair care preparations

Class 35

Retailing services, direct selling, online retailing services and mail catalogue services in relation to soaps, cleaning preparations, essential oils, cosmetic products, toiletries, perfumes, skin care products, hair care preparations; direct selling through telephone, facsimile, e-mail and through the Internet; compiling, arranging and publishing merchandise catalogues; compilation of mailing lists; direct mail advertising; on-line advertising; mail order promotions; sale promotions; advertising and business; business administration

Appendix 2

1. **STRAWBERRY SCENTS SOAP SET**- Home Gift Supplies Wholesale Store - **STRAWBERRY SCENTS SOAP SET**. The sweet **strawberry** sent of this soap set creates a serene mood in your morning shower.

www.homegiftsupplies.com/stscsset.html

2. Sweet **Strawberry Skin Care Products**-If you crave the sweet smell of **strawberries**, you'll love this head-to-toe list of sweet **strawberry skin care products**.

skincare.about.com/od/bath/tp/Sweet-Strawberry-Skin-Care-.htm

3. Lip Care **Strawberry Skin Care Products** - Health & Beauty Supplies ...- Compare prices on lip care **strawberry Skin Care Products**. Online shopping for Health & Beauty Supplies at BizRate.

www.bizrate.com/skincareproducts/products__keyword--lip+care+strawberry.html

4. **Strawberry Body Polish: Scrubs: Body** - The Body Shop- Have good, clean fun and smooth skin at the same time thanks to this fragrance foaming gel-based scrub that's gentle enough to use every day.

www.thebodyshop.com/bodyshop/jump/Body/Scrubs/Strawberry+Body+Polish/prod3650055/cat20081

5. Perlier Milk and Fruit Wild **Strawberry 4-piece Bath and Body Kit** ..

Welcome to Perlier's pampering land of milk and fruit! Our Milk and Fruit Wild Strawberry Bath and Body Kit includes all your skin care essentials infused with the sweetly scintillating scent of Wild Strawberry. Cleansing and moisturizing has never smelled so delicious!

http://beauty.hsn.com/perlier-milk-and-fruit-wild-strawberry-4-piece-bath-and-body-kit_p-4137411_xp.aspx

6. **Strawberry Perfumes** Perfume and Cologne - Health & Beauty Supplies ...- Compare prices on **strawberry** perfumes Perfume and Cologne. Online shopping for Health & Beauty Supplies at BizRate.

www.bizrate.com/perfumeandcologne/products__keyword--strawberry+perfumes.htm

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7. The masque has tiny delicate **strawberry** particles - massage into your skin and relax ... Ingredient:Aqua (Purified water), Glycerin, PEG-7 Glyceryl Cocoate, Propylene Glycol, Dimethicone ...

alibaba.com/product-gs/.../Strawberry_AHA_Gel_Masque_Facial_Mud.html

8. **Strawberry** seed oil product description and ordering ... Strawberry Seed Oil is an ideal ingredient for inclusion in anti-aging formulations and products intended for dry or damaged skin. ...

www.enbeau.com/hydrating.htm

9. ... skin and is a popular ingredient in anti-cellulite products. **Strawberry** Leaves ... **Strawberry** leaves have been touted for their cosmetic benefits such as smoothing and softening skin ...

www.newenglandmoonsoap.com/soap_ingredients.htm

10. **Strawberry** Fragrance Oil Loved by children, eaten by everyone...but not the soap! ... MSDS/Ingredient/Allergen Information. Links & Recipes. Cosmetic Fragrance Oils. Price : £1.49 (ex. VAT) ...

www.justasoap.co.uk/catalog/strawberry-fragrance-oil-p-44.html

11. L'Oreal Lipstick Colour Juice "**Strawberry** Fields" RRP: \$22.95 ... There is a subtle shimmer and a little glossiness, but it's a very moist lipstick - not a gloss. ...

[smartpoppy.com.au/products/L'Oreal-Lipstick-Colour-Juice-\"Strawberr...](http://smartpoppy.com.au/products/L'Oreal-Lipstick-Colour-Juice-\)

12. Smackers Strawberry Bath and Body Shampoo, Conditioner and Shower Gel. ... and Lotion in **Strawberry** fragrances. Smackers Strawberry. Hair Care. Collection. Bath & Body Home. Smackers

www.smackers.com/bath/smackers_strawberry.html