

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 302325807

(A) 嫩白絲滑

(B) 嫩白丝滑

MARK :

APPLICANT : UNILEVER N.V.

CLASS : 3

STATEMENT OF REASONS FOR DECISION

Background

1. On 25 July 2012, UNILEVER N.V. (“the Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for registration of the following two marks in series (“the subject marks”):

(A) 嫩白絲滑

(B) 嫩白丝滑

2. The subject marks are sought to be registered in respect of “Deodorants and anti-perspirants” in Class 3 (the “applied-for goods”).
3. At the examination stage, objection was raised against the subject application under section 11(1)(b) and (c) of the Ordinance on the basis that the subject marks are devoid of any distinctive character for they consist exclusively of signs which may serve, in trade or business, to designate the characteristics of the goods applied for. Despite submissions made on behalf of the Applicant, the objection was maintained by the Registrar.
4. The Applicant requested a hearing on the registrability of the subject marks and this was held before me on 15 July 2014. Mr. Philips B.F. Wong, instructed by

Messrs. Baker & McKenzie, appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.

5. The Applicant did not file any evidence of use of the subject marks to show that they have in fact acquired a distinctive character as a result of the use made of them under s.11(2) of the Ordinance. 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(1) are 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) 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) ...”

Decision

Section 11(1)(b) of the Ordinance

7. Section 11(1)(b) of the Ordinance 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 origin of the marked product or service 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* (Case C-173/04P) [2006] ETMR 41 at paragraphs 60-61).
8. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* [2010] 1 HKLRD 541, the Hon Sakhrani J cited with approval the following cases (paragraphs 17-18):

“17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J (as he

then was) said 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?”

18. In *Nestle SA's Trade Mark Application (Have A Break)* [2004] FSR 2 Sir Andrew Morritt VC (as he then was) said 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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking.....”

9. According to the principles as stated above, a mark has a distinctive character within the meaning of section 11(1)(b) of the Ordinance if the mark on its own, assuming no use, serves to identify the Applicant's goods as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. In other words, the question is whether the average consumer would perceive the subject marks as origin specific or origin neutral.¹ The distinctiveness of a mark must be assessed by reference to the goods applied for, and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.
10. The subject marks consist of a series of two marks in Chinese. Mark (A) consists of the Chinese characters “嫩白絲滑” in traditional Chinese font, and Mark (B) consists of the same Chinese characters “嫩白丝滑” in simplified Chinese font. Although traditional Chinese font and simplified Chinese font are used in the subject marks, the overall impression of each of the subject marks is the same. They are in plain font and without any device or element. For convenience, the subject marks would herein below be discussed collectively as “嫩白絲滑”.
11. Turning to the applied-for goods, the application is made in respect of “deodorants and anti-perspirants” in Class 3. They are ordinary consumer

¹ *CYCLING IS...* Trade Mark Applications [2002] R.P.C. 37 at paragraphs 66-69

products which the public would purchase and use on a daily basis. Therefore, I consider that the relevant consumers are ordinary members of the general public in Hong Kong. They are reasonably well-informed, observant and circumspect but they cannot be expected to exercise more than an average level of care and attention in their selection of such goods.

12. At the hearing, Mr. Wong argued that the ground of objection under section 11(1)(b) of the Ordinance was based on the alleged descriptive character of the subject marks in relation to the applied-for goods. He contended that the subject marks are not descriptive in respect of the essential characteristics and purpose of the applied-for goods and thus are distinctive. He submitted that the applied-for goods are personal hygiene products within Class 3, which is the same class as personal care products and beauty products, but goods of the same class can have different characteristics and purposes. In particular, he argued that the applied-for goods have different characteristics and purposes when compared with goods of the same class such as creams, masks, lotions, shower gels or hair removal cream.

13. According to the dictionaries, deodorants and anti-perspirants are defined as follows:-

Deodorant - “a substance which removes or conceals unpleasant smells, especially bodily odour;”² and “a substance that you put on your body to prevent or hide unpleasant smell”³

Anti-perspirant – “a substance that is applied to the skin, especially under the arms, to prevent or reduce perspiration;”⁴ and “a substance which is put on the skin, especially under the arms, in order to prevent or reduce sweating”⁵

14. In view of the above definitions, Mr. Wong submitted that in the minds of the relevant consumers, the purpose of deodorants is to naturalise bodily odour and anti-perspirants are used to prevent or reduce sweating. As such, Mr. Wong argued that the subject marks “嫩白絲滑” as a whole or each of their characters taken separately, i.e. “嫩”, “白”, “絲” and “滑” or the combinations of “嫩白” and “絲滑” would not be perceived by the relevant consumers as designating the characteristics or effects of the applied-for goods as the relevant consumers

² Oxford online dictionary

³ Cambridge online dictionary

⁴ Oxford online dictionary

⁵ Cambridge online dictionary

would not expect a deodorant to make one's skin more tender, more delicate, softer, whiter, or silky smooth. Similar arguments were also submitted in respect of anti-perspirants. Mr. Wong also argued that the unusual syntax used in the subject marks further supports his argument that the relevant consumers are unlikely to regard the subject marks as a whole as designating the characteristics of the applied-for goods. At most, the subject marks can only be considered as allusive or suggestive of the possible effects of using the applied-for goods.

15. Mr. Wong's arguments are basically that the subject marks as a whole, or each of its Chinese characters “嫩”, “白”, “絲” and “滑” or the combinations “嫩白” and “絲滑” respectively are not the usual or common way of describing the applied-for goods or are only allusive or suggestive rather than descriptive of the characteristics of the applied-for goods.
16. Mr. Wong's submissions also specifically referred to the Chinese character “絲” in the subject marks and contended that it cannot be descriptive of the characteristics and effect of the applied-for goods. The said character is used metaphorically to invoke the imagination of the relevant consumers and it can at most be said that the term alludes to the characteristics of the goods. In support, he cited the Australian case *Re Application by Remington Products Inc* (1990) 18 IPR 251-255. The mark in question is “SMOOTH AND SILKY” (for electrical devices for cutting and removing hair) and the Hearing Officer held that “SILKY” only has a metaphorical characteristic and need not be disclaimed.
17. I do not agree with Mr. Wong's submissions. As indicated to the Applicant at the examination stage, “嫩” means “tender, delicate, soft, light-coloured”; “白” means “white in colour, clean, pure”; “絲” means “silk” and “滑” means “smooth” (Lin Yu Tang's Dictionary of Modern Chinese Usage). As a whole, the subject marks carry the meaning of “tender, soft, white and silky smooth”. “嫩白” and “絲滑” are common terms with plain meanings of “tender, soft and white” and “silky smooth” respectively. Also, it is a well established principle that in considering the registrability of a mark, a mark must be considered as a whole. Therefore, in determining the registrability of the subject marks, the subject marks must be considered as a whole as “嫩白絲滑” instead of by each individual Chinese character.
18. When the subject marks are used in relation to the applied-for goods, i.e. deodorants and anti-perspirants, the subject marks convey the immediate message that the applied-for goods would make one's skin tender, soft, white and silky smooth. Smooth and fair skin is highly desired by women all around the world, particularly women in Asia. Such skin qualities are desired not just for

the skin on the face but also other parts of the body. Thus, personal care goods with whitening and smoothening properties are popular in the market. In addition, some products may have several functions. For example, soaps and bath products are for cleaning the skin (hygiene purpose) but they can also serve other purposes, e.g. beauty purpose when they are used to beautify the skin or they are perfumed. Another example would be dentrifices which are primarily used to clean the teeth but they can also have the purpose of making the teeth whiter. Thus, beautification is not obtained only by the use of traditional means, such as creams or masks, but also through the use of products which, in addition to their primary purpose, can serve a beauty purpose as well.⁶

19. The Internet references cited in the Registrar's letter dated 19 May 2014 provide examples of personal care products which serve more than one purpose. Indeed, from the references, there are various personal care products having whitening and smoothening properties including products in respect of which their primary purpose is not beauty related, such as hair removal cream or shower gel. The primary purposes of hair removal cream and shower gel are to remove hair and to clean the skin respectively. Nonetheless, they can also beautify the skin by making the skin whiter and smoother.
20. In light of the above, although the applied-for goods are primarily for naturalizing bodily odour and prevent or reduce sweating, these goods can have other purposes such as beauty purpose of whitening and smoothening the skin. Therefore, I do not agree that the message conveyed by the subject marks are merely allusive or suggestive of the characteristics or effects of the applied-for goods. When the subject marks are used in relation to the applied-for goods, the relevant consumers would merely perceive it as an indication that the applied-for goods could produce the desired whitening and smoothening effects on the skin after application. For the above reason, I am not satisfied that without first educating the public, the consumers would perceive the subject marks as badges of origin so as to distinguish the Applicant's deodorants and anti-perspirants from those of other traders.
21. The subject marks are composed of the Chinese characters “嫩白” and “絲滑” or “嫩”, “白”, “絲” and “滑” and they carry the plain meanings as mentioned in paragraph 17 above. As such, the subject marks are just mere combinations of words or terms denoting skin qualities that are highly desired by consumers. They cannot serve to distinguish the Applicant's goods from those of other traders as goods of other traders may equally produce whitening and smoothening effect. The message conveyed by the subject marks is origin

⁶ La Mer Technology Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (Case T-418/03) [2008] E.T.M.R. 9

neutral and thus the subject marks do not inform the consumers of the commercial origin of the applied-for goods. The Internet references cited in the Registrar's letter dated 19 May 2014 also provide examples that many traders have used combinations of Chinese characters that are the same as the subject marks for similar goods of the same class (e.g. personal care, hygiene or beauty goods). This also illustrates that the combination of “嫩白” and “絲滑” or “嫩”, “白”, “絲” and “滑” does not introduce any unusual variation as to the syntax or meaning in respect of those goods of the same class. Such combination of the Chinese characters as a whole is apt to convey the desired effects or characteristics of those goods. Therefore, I do not find that the subject marks, having identical combination of Chinese characters, in respect of the applied-for goods, involve any syntactically unusual juxtaposition of words which would confer distinctiveness on the subject marks as a whole.

22. Mr. Wong also referred me to *Eurocool Logistik GmbH v OHIM* [2003] ETMR 4 (the “EUROCOOL” case) and submitted that a “minimum” degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in section 11(1)(b) of the Ordinance.
23. I note that a mark does not need to be highly distinctive for it to be registrable. However, it must as a whole perform the essential function of distinguishing the Applicant's goods or services from those having a different commercial origin (see *EUROCOOL*, paragraph 46). In view that the subject marks merely indicate some of the effects produced by the applied-for goods after application on the skin, the subject marks fail to perform the essential function of a trade mark in guaranteeing the identity of the trade origin of the applied-for goods by enabling the relevant consumers to distinguish the applied-for goods from those of other traders. Hence, I find that the subject marks are devoid of any distinctive character and are precluded from registration in respect of the applied-for goods under section 11(1)(b) of the Ordinance.

The registered mark “SILK DRY”

24. Mr. Wong referred me to what he described as the English translation of the subject marks which was filed in Hong Kong on the same date and was allowed for registration, No. 302325816 “SILK DRY” for the same goods in Class 3. In his view, the said mark is a direct English translation of the subject marks which should be considered to be of a similar degree of descriptiveness when comparing with the subject marks. He argued that, if “SILK DRY” is allowed to be registered in respect of the same goods, the subject marks should also be allowed.

25. I have considered the mark “SILK DRY” but do not find it comparable with the subject application. The mark “SILK DRY” is comprised of the two words “SILK” and “DRY”. “SILK” refers to “the very fine soft lustrous fibre produced by a silkworm to make its cocoon” (Collins Dictionary Online) and it has the characteristics of smooth and soft. On the other hand, “DRY” refers to “lack of moisture, not wet or damp” (Collins Dictionary Online) and it is not a characteristics of silk. The combination of those two words appears to be sufficiently distinctive in respect of the goods applied for in Class 3. In any case, each mark should be considered on the basis of its own merits but not by reference to other registered mark(s). As stated in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration. In view of the above, I do not find the registration of the mark “SILK DRY” in Hong Kong is of assistance to the subject marks.

Internet references

26. In respect of the Internet references cited in the Registrar’s letter dated 19 May 2014, Mr. Wong contended that they are of little value since they are non-Hong Kong websites and hence none of them shows the position in Hong Kong. He also submitted that the websites are irrelevant since the relevant date to determine should be the date of the application of the subject marks.
27. In examining trade mark applications filed in Hong Kong, I do not agree that Internet references that originate from overseas websites should be excluded as Hong Kong is an international city and that overseas websites are readily accessible by the general public in Hong Kong. I also do not consider websites which are found at a date later than the application date to be entirely irrelevant. The Internet references cited by the Registrar are merely used for illustration purposes. They provide examples that the combination of the Chinese characters identical to the subject marks are commonly used by many traders in relation to personal care products, and that personal care products with a hygiene purpose can also serve a beauty purpose.

Section 11(1)(c) of the Ordinance

28. Having found the subject marks are precluded from registration in respect of the applied-for goods under section 11(1)(b) of the Ordinance, it is not necessary for me to consider the remaining objection under section 11(1)(c).

Conclusion

29. I have carefully considered all the documents filed by the Applicant together with all the oral and written submissions made in respect of the subject application. For the reasons given, I find that the subject marks are precluded from registration by section 11(1)(b) of the Ordinance in respect of the applied-for goods. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of the applied-for goods.

Irene Ip
for Registrar of Trade Marks
13 January 2015