

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 303006170

MARK : 

APPLICANT : UNI-CHARM Kabushiki Kaisha (UNI-CHARM CORPORATION)

CLASS : 5

STATEMENT OF REASONS FOR DECISION

Background

1. On 23 May 2014 (“the application date”), UNI-CHARM Kabushiki Kaisha (UNI-CHARM CORPORATION) (“the Applicant”) filed an application for registration of the mark below (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”):



(“the subject mark”)

2. A request to amend the subject application was filed on 9 July 2014 to amend the specification of goods and was accepted by the Registrar of Trade Marks (“the Registrar”) on 10 July 2014.

3. At the examination stage, the Registrar raised objections under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and that it consists exclusively of a sign which may serve to designate the characteristics of the applied-for goods. Despite the submissions by Vivien Chan & Co., the agent for the Applicant (“the Applicant’s Agent”), made on behalf of the Applicant on 23 April 2015, the objection was maintained by the Registrar

in its opinion letter dated 22 June 2015. By its letter of 22 June 2016, the Applicant requested a hearing on the registrability of the subject mark. A hearing was scheduled to take place on 10 January 2017.

4. On 30 December 2016, the Applicant's Agent filed a statutory declaration by Mr. Keiichi Jibiki dated 27 December 2016 ("the Statutory Declaration") to the Registrar as evidence of use in support of the subject application.

5. The hearing took place before me on 10 January 2017, at which Ms. Anna-Mae Koo of the Applicant's Agent appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.

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 sections 11(1) and 11(2) 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) ...

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

Decision

7. Having carefully considered all the relevant facts, oral and written submissions of the Applicant's Agent and the circumstances of the subject application, I decide to allow registration of the subject mark in respect of the following applied-for goods in Class 5 on a prima facie basis (hereinafter referred to collectively as the "Accepted Goods"):

“Sanitary preparations; sanitary masks; bandages for dressings; adhesive plasters; absorbent cotton; gauze for dressings; oiled paper for medical purposes; ear bandages; wet tissues for medical purpose.”

8. Subject to compliance with the requirements as stipulated in paragraph 42 below, the subject mark, insofar as it is in respect of the Accepted Goods, may proceed to publication.

9. As the discussions below in this decision would show, in respect of the following applied-for goods in Class 5 (hereinafter referred to collectively as the “Objected Goods”), I find that the subject mark is precluded from registration under section 11(1)(b) of the Ordinance:

“Pharmaceutical, veterinary preparations; sanitary napkins; panty liners (sanitary); menstruation tampons; sanitary shorts; diapers; baby's diaper-pants; disposable diapers or nappies of paper or cellulose for babies; diapers or nappies of paper or cellulose in type of pants for babies; baby's napkins; training pants; incontinence diapers; incontinence diapers or nappies of paper or cellulose in type of pants; incontinence pads; incontinence liners; incontinence shorts; breast-nursing pads; incontinence trunks; pharmaceutical wafer; lactose (milk sugar); lacteal flour (for babies); eyepatches for medicated purposes.”

10. For the rest of this statement of reasons, therefore, I shall consider the subject application insofar as it is in respect of the Objected Goods.

A. Inherent distinctiveness

Section 11(1)(b) of the Ordinance

11. 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 Office for Harmonisation in the Internal Market* (Case C-173/04 P) [2006] E.T.M.R. 41 at paragraphs 60-61).

12. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* (HCMP 554/2009) [2010] 1 HKLRD 541, the Hon Sakhiani J cited with approval the following cases (paragraphs 17-18):

“17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, Jacob J (as he then was) said 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?”

18. In *Nestle SA’s Trade Mark Application (Have a Break)* [2004] F.S.R. 2, Sir Andrew Morritt V-C (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...”

13. Also, in “*Cycling IS...*” *Trade Mark Applications* [2002] R.P.C. 37, it was stated that:

“It was legitimate when assessing whether a sign was sufficiently distinctive to qualify for registration to consider whether it could indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons, or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically linked undertakings.”

14. According to the above legal principles, a mark’s distinctiveness shall be

assessed by reference to the goods and/or services applied for, and the perception of the relevant consumers, who are presumed to be reasonably well-informed, circumspect and observant. The question is whether the mark, assuming no use, serve to identify the applicant's goods and/or services as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. In other words, whether the perception and recollection in the subject mark would trigger in the mind of the average consumer of the applied-for goods would be origin specific or origin neutral.

15. The subject mark is comprised of three Chinese characters, namely “超”, “熟” and “睡”, in sequential order from left to right, and are written in plain font. The word “超” is white in colour, located within a red circle with blue border in the background. The words “熟” and “睡” are in golden yellow colour with blue border. The Applicant claims the colours red, white, gold and blue as elements of the subject mark.

16. As indicated to the Applicant at the examination stage, the meaning conveyed by the subject mark is “super, deeply or soundly asleep”. Also according to Lin Yutang's Chinese-English Dictionary of Modern Usage, “超” could also be used to indicate “extra”, “surpassing” or “exceeding”. The red circle with blue border behind the word “超” and the colours in the words “熟” and “睡” are considered merely as decorative and constitute a background for the mark only. As a whole, the subject mark denotes extra or exceedingly deep sleep, or sleeping very soundly.

17. The Objected Goods include goods such as “pharmaceutical, veterinary preparations”, “sanitary napkins”, “baby's diaper-pants”, “incontinence diapers”, “breast-nursing pads”, “lacteal flour (for babies)” and “eyepatches for medicated purposes”, etc.

18. The relevant consumers are therefore members of the public as well as medical or healthcare practitioners or service providers, who need to use or purchase for the use by others such goods for personal hygiene, healthcare or medical care. The general public, although reasonably well-informed, circumspect and observant, cannot be expected to exercise more than an average level of care and attention when selecting such goods. They normally perceive a mark as a whole and do not proceed to analyse the mark in detail.

19. When the subject mark is used on the Objected Goods such as “menstruation tampons”, “baby's diaper-pants”, “incontinence diapers” and “breast-nursing pads”, it conveys a clear message that when one uses the Applicant's products, the user or the

caregiver of the user will be able to rest well and sleep very soundly without having to worry about leakage of menstruation, excreta or breastmilk or to replace the used product during sleep. As it is a common concern among users or caregivers of users of incontinence items that the product may not be able to withhold excreta or body fluids after long hours of use, particularly during night time when the user or caregiver is unable or has difficulty or inconvenience to replace those incontinence items during sleep, and being able to sleep without worry and soundly is a desired outcome of using such goods; the subject mark will be perceived by the relevant consumers as a promotional statement which conveys the benefit or effectiveness of the goods being offered. The message of being able to sleep soundly is also commonly advertised by other manufacturers of or advertisers for incontinence items to promote products which are the same as or similar to the Objected Goods.

20. When the subject mark is used on other Objected Goods such as “pharmaceutical, veterinary preparations”, “lacteal flour (for babies)” and “eyepatches for medicated purposes”, the message conveyed to the relevant consumers would be the goods could give the user an exceptional deep sleep after usage, it would be perceived as a laudatory statement about the goods in question which is to enhance sleep quality or causes one to sleep soundly.

21. A mark must be capable of fulfilling its essential function of guaranteeing the identity of the origin of the marketed product, or in other words, the question is whether consumers would identify goods or services marketed under the trade mark as originating from a particular undertaking. In this respect, although it may be argued that medical practitioners or healthcare specialists would exercise more care and pay additional attention when choosing products compared with the general public, their awareness is liable to be relatively low, on the other hand, when it comes to purely promotional indications, which well-informed consumers do not see as decisive (see, for example, the discussion in *Sykes Enterprises, Inc. v Office for Harmonisation in the Internal Market* “REAL PEOPLE, REAL SOLUTIONS” [2003] E.T.M.R. 57, at paragraph 24), even if the Objected Goods are aimed at medical practitioners or healthcare specialists in particular.

22. As discussed above, the subject mark no doubt would be perceived by the relevant consumers as a promotional or advertising statement about the advantage of using the Objected Goods. As such, without first being educated that it is a trade mark, the relevant consumers would not regard the subject mark as an indicator of trade origin when the subject mark is being used on the Objected Goods.

23. The Applicant's Agent submitted that a mark does not need to be totally non-descriptive to be registrable, and even if the mark is suggestive of the goods and services, it does not preclude its registration. The Applicant's Agent also cited the factors to be considered for assessing whether a mark designates the characteristics of goods or is merely suggestive as laid down by Advocate General Jacobs in the DOUBLEMINT case (*Office for Harmonisation in the Internal Market v Wm. Wrigley Jr. Company* (Case C-191/01 P) [2004] R.P. C. 18), and that the distinctiveness of a mark must be assessed by reference to the goods applied for and the perception of the relevant consumers.

24. Putting aside the fact that what Advocate General Jacobs said in the DOUBLEMINT case was in the context of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to section 11(1)(c) of the Ordinance) whereas I am here discussing section 11(1)(b), I wish to say that even if the subject mark is non-descriptive or is merely suggestive of the goods or the characteristics of the goods applied for, it does not necessarily follow that the mark is distinctive. The critical question is whether the average consumer would perceive the mark as a badge of trade origin without the need to be educated, or in other words, whether the mark is in itself devoid of a distinctive character.

25. The Applicant's Agent argued that the subject mark is a coined expression and is not a usual Chinese phrase, as it is very rare for people to describe "extremely deep sleep" in Chinese slang as "超熟睡". The expression in the subject mark would be understood by average consumer as "a new level of enjoyment in the goods applied-for".

26. I do not agree with the above submission. The Chinese phrase "超熟睡" comprises an easy to understand and grammatically correct, if slightly elliptical, narrative that simply states a laudable objective of having a "very deep sleep" ("超級熟睡"). On the other hand, the placing of the character "超" as an adverb in front of the adjective "熟睡" is also not an unusual or peculiar syntax of Chinese. As the Applicant's Agent has pointed out, the applied-for goods (which include the Objected Goods) provide "a new level of enjoyment", but this I consider is in itself merely a laudatory promotional or advertising message as far as the Objected Goods are concerned. The mark simply possesses no imaginative, inventive or idiosyncratic elements which may endow the phrase "超熟睡" with any distinctive character. Even assuming that it is unusual for consumers to use the phrase "超熟睡" in their daily lives,

or even if the Chinese phrase is a coined expression, in the light of the discussion above, I do not see that the combination would give rise to another meaning or impression which can render the subject mark distinctive or give it the capacity to function as a trade mark. Without spending a lot of time in analyzing the subject mark, the phrase as a whole would be perceived simply as a promotional or advertising message of the benefit of using the Objected Goods and nothing more.

27. The Applicant's Agent also submitted that the adverb “超” in red background adds a special effect to the subject mark as a whole as an emphasis to the adjective “熟睡” that follows. However, as the Registrar has pointed out at examination stage and reiterated in paragraph 16 above, the colours in the words “熟睡” are considered as decorative element only, the red circle background behind “超” simply emphasized the word itself and reinforced the meaning of the Chinese word “超”, which is “very” or “super”. There is nothing unusual in respect of the colour combination in the subject mark. The colour combination is unlikely to strike the relevant consumers as an indication of trade source, and it did not alter the overall impression brought by the subject mark and could not provide any additional distinctiveness to the subject mark other than its decorative function.

28. The Applicant's Agent also submitted that there are no other members of trade who use this term and the term is not commonly used in the industry. However, the fact that a particular mark or expression in the mark is not commonly used by other players in the trade could not demonstrate that such a mark possesses a distinctive character. As mentioned before, the question is whether the mark can serve as a badge of trade origin. For the reasons discussed above, I do not find the subject mark could serve this purpose without the relevant consumers being first educated that the subject mark is the Applicant's trade mark.

Section 11(1)(c) of the Ordinance

29. As the subject mark is precluded from registration in respect of the Objected Goods under section 11(1)(b) of the Ordinance, there is no need for me to consider the remaining objection under section 11(1)(c) of the Ordinance, and I will just leave it at that.

B. Acquired distinctiveness

30. Although I have found that the subject mark lacks inherent distinctive

character and is not registrable under section 11(1)(b) of the Ordinance, in light of section 11(2), if the subject mark has in fact acquired a distinctive character as a result of the use made of it, the subject application should not be refused. I would next consider the Applicant's evidence of use made of the subject mark in light of the established principles.

31. In *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Another* (Joined Cases C-108/97 and 109/97) [1999] E.T.M.R. 585, the Court of Justice of the European Communities laid down its principles of interpretation of Article 3(3) of the First Council Directive 89/104/EEC of 21 December 1988 (now replaced by Directive 2008/95/EC of 22 October 2008), which is broadly similar to section 11(2) of the Ordinance, at paragraphs 51-52 and 54:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied...

54. ... a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings...”

32. According to the principles above, the competent authority must make an overall assessment of the evidence in determining the question on acquired distinctiveness. The crucial question to ask is whether the relevant consumers in Hong Kong have been educated to recognize the subject mark as a badge of trade origin of the Objected Goods. If I consider that a significant portion of the relevant class of

consumers identifies those goods as originating from the Applicant because of the use made of the subject mark before the applicant date, the objection raised against the subject mark under section 11(1)(b) of the Ordinance would be overcome.

33. The Applicant's Agent referred to the Statutory Declaration and submitted that the subject mark has been widely promoted and used by the Applicant in Hong Kong. The Statutory Declaration contains two exhibits, namely Exhibit 1 – "Current Store Coverage" and Exhibit 2 – "Manner of Display".

34. Before I continue to examine the Statutory Declaration and the exhibits in detail, I note that the exhibits are either dated after the application date (for example, Exhibit 1 which is dated November 2016, page 5 of Exhibit 2 which referred to the period from 29 September to 5 October 2016, and page 23 of Exhibit 2 which referred to the period from 31 October to 14 November 2016), or are undated; the resolutions of the photographs provided in Exhibit 2 are also very low and the subject mark is not visible in any of those photographs. The exhibits do not assist the subject application.

35. In assessing whether the trade marks have acquired a distinctive character under section 11(2) of the Ordinance, no fixed rule can be laid down as to the minimum period of use necessary. The Registrar will look for a reasonable period of use, usually about five years prior to the application date. Extensive use over a shorter period may well be sufficient, although use for less than two years prior to the date of application would very unlikely be regarded as sufficient.

36. In the present case, according to the Statutory Declaration, the Applicant declared that the subject mark was first used in Hong Kong in May 2014, and has since been used by the Applicant continuously in Hong Kong, and the subject mark has been used on "sanitary napkins" of Class 5 since 2014. In other words, the subject mark has only been put to use in Hong Kong in the same month as the application date. I do not consider such period of use being sufficient.

37. The evidence adduced also failed to show that the subject mark has been used in respect of all the Objected Goods sought to be protected. The Statutory Declaration mentioned that the subject mark has been used on only one of the many Objected Goods under Class 5, which is "sanitary napkins". The information in the exhibits also seemed to relate to "sanitary napkins" only, for example, the cover page of Exhibit 1 mentioned of "Sofy Napkin Store Situation" and the words adjacent to the photograph on page 23 of Exhibit 2 referred to "UC007 – BODY FIT NAPKIN WITHOUT WINGS

26CM (12 PCS)” and “UC008 – BODY FIT NAPKIN WITHOUT WINGS 29CM (10 PCS)”. The rest of the photographs produced in Exhibit 2, although rather unclear and are either undated or dated after the application date, seemed to be showing sanitary napkins, panty liners or other menstruation sanitary products only.

38. Furthermore, no information was provided in respect of the amount invested by the Applicant in promoting the subject mark or the amount generated by the sale of the Objected Goods bearing the subject mark. I am unable to assess the market share or the promotion and advertising effort of the Applicant in the Hong Kong market.

39. On the whole, the evidence adduced is insufficient to show extensive use of the subject mark in respect of the applied-for goods, needless to say the Objected Goods, in Hong Kong prior to the application date. I am not satisfied that the subject mark has come to be identified by the relevant consumers as a badge of trade origin to distinguish the Applicant’s goods and those of others for the purpose of section 11(2) of the Ordinance. The objection raised under section 11(1)(b) of the Ordinance therefore could not be overcome pursuant to section 11(2) of the Ordinance.

C. Other registered trade marks

40. The Applicant’s Agent raised several other trade marks that were being accepted for publication and registration in Class 5 which claimed to be in similar fashion as the subject mark. I have considered the marks referred to but I do not think that they are comparable with the present application. However, in any event, it is well established that each application for registration of trade mark should be considered on a case by case basis, and to be assessed on the basis of its own merits. Comparison with other marks on the register is in principle irrelevant when considering a particular mark under registration (*British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, at page 305).

Conclusion

41. 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 mark is precluded from registration in respect of the Objected Goods under section 11(1)(b) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of those goods.

42. As I find that registration of the subject mark can be accepted in respect of the Accepted Goods as indicated in paragraph 7 above, the subject application in respect of those goods can proceed to publication, provided that the Applicant files, on or before 14 July 2017, a Form T5A to restrict the specification by deleting the Objected Goods. If the Applicant fails to do so on or before 14 July 2017, it will be deemed to have abandoned the subject application.

(Janice Yip)
for Registrar of Trade Marks
14 June 2017