TRADE MARKS ORDINANCE (CAP. 559)
APPLICATION NO. : 300488908

MARK :
APPLICANT : PFIZER PRODUCTS INC.
CLASS : 5

STATEMENT OF REASONS FOR DECISION

Background

1. On 2 September 2005, Pfizer Products Inc. (“the Applicant”) applied to register the three-dimensional mark shown below in different perspectives (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

2. Registration of the subject mark is sought in respect of the following goods in Class 5:-

“Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.”
3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance on the basis that the subject mark was devoid of any distinctive character.

4. In support of the subject application, the Applicant filed the following statutory declarations of Tamera Angus, Vice President of the Applicant, with a view to showing that the subject mark had in fact acquired a distinctive character as a result of the use made of it in Hong Kong prior to the date of application for the purpose of section 11(2) of the Ordinance:

   (a) declaration of Tamera Angus of 13 December 2005 (“Angus First Declaration”); and

   (b) declaration of Tamera Angus of 5 September 2006 (“Angus Second Declaration”).

5. In Angus First Declaration and Angus Second Declaration, Ms Tamera Angus deposed that she would adopt the following statutory declarations, the originals of which are all contained in exhibit marked “TA-1” to Angus First Declaration and “Exhibit 1” to Angus Second Declaration, in support of the subject application:

   (c) declaration of Leung Stephen Kwok Keung, the Country Manager of Pfizer Corporation Hong Kong Limited, of 4 April 2005 (“the Leung Declaration”);

   (d) declaration of Cheung Wut Lung, the Legal Counsel of Pfizer Corporation Hong Kong Limited, of 24 August 2006 (“the Cheung Declaration”);

   (e) declaration of Rob Burrows, the Director of Pfizer Global Manufacturing at Pfizer Inc., of 30 March 2005 (“the Burrows Declaration”); and

   (f) nine statutory declarations from nine doctors in Hong Kong, all of
6. Upon the request of the Applicant, a hearing on the registrability of the subject mark took place before me on 15 October 2008, at which Mr Philips Wong, Counsel, instructed by Messrs. Deacons appeared for the Applicant. I reserved my decision at the conclusion of the hearing.

The Ordinance

7. 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) …”

8. Notwithstanding the provisions in the preceding paragraph, section 11(2) provides as follows:

“(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

Inherent registrability

9. In Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. & Another, supra, at 173, paragraph 30, the European Court of Justice stated what is considered to be the “essential function” of a trade mark:-
“…the essential function of the trade mark is to guarantee the identity of the origin of the marked product 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…”

10. For a three-dimensional shape to function as a trade mark it must be capable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (paragraph 31 of August Storck KG v OHIM (Case T-396/02), Court of First Instance of the European Communities, and cases cited therein).

11. The approach of assessing distinctiveness was discussed in British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281 where Mr. Justice Jacob stated, on 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?”


“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.”

13. In view of the above legal principles, 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 goods 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 for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.

14. While I am in agreement with Mr. Wong that the criteria for assessing the distinctive character of three-dimensional trade marks such as the subject mark are no different from those to be applied to other categories of trade mark (Koninklijke Philips Electronics NV v Remington Consumers Products Ltd., European Court of Justice [2003] Ch. 159 at 174, paragraph 48), I am mindful that a three-dimensional trade mark consisting of the shape of the goods themselves is not necessarily perceived by the relevant consumers in the same way as a word mark, a figurative mark or a three-dimensional mark which consists of a sign that is independent from the appearance of the goods it denotes. While these types of signs are normally regarded by the relevant consumers as directly indicating the origin of the goods, the same does not hold true when the trade mark coincides with the external appearance of the goods themselves. In Henkel KGAA v Office for Harmonisation in the Internal Market [2005] ETMR 44, the European Court of Justice has observed, in paragraphs 38, that:

“The Court of First Instance was also correct in stating that the criteria for assessing the distinctive character of three-dimensional shape-of-products marks are no different from those applicable to other categories of trade mark. It none the less observed that, for the purpose of applying those criteria, the relevant public’s perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark.

In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purpose of Art. 7(1)(b) of Regulation No.40/94. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision.”

1 Council Regulation (EC) No.40/94 of 20 December 1993 on the Community Trade Mark, the provisions of which are broadly similar to section 11(1)(b) of the Ordinance.
15. The goods for which registration is sought are essentially pharmaceutical and other preparations for medical purposes in class 5. Since the list of goods covered by the subject application is not restricted to items which would be available on prescription only, the relevant consumers thus include members of the general public and the medical professionals, such as doctors, nurses or pharmacists. The subject mark will be applied to the products and their packaging. It will also be used in the advertisements, promotional materials or websites for promoting the goods in question.

16. According to Mr Wong, the subject mark has two distinguishing features, namely, the shape and colour. Mr Wong submits that the subject mark consists of the distinctive colour blue together with a specific configuration, namely, an elongated diamond-shaped 3-dimensional tablet with round corners. He argues that the shape sought to be registered is not common in respect of pharmaceutical products and it departs from the usual shape of tablets which are mostly circular or cylindrical in shape. It is also Mr Wong’s submission that the inherent capability of the subject mark to serve as a trade mark is further reinforced by the colour blue.

17. In order to ascertain whether the combination of the shape and colour of the product in question may be perceived by the relevant consumers referred to in paragraph 15 above as an indication of origin, the overall impression produced by that combination must be analyzed. That is not incompatible with an examination of each of the product’s individual features in turn, namely the shape and colour claimed (paragraph 38 of August Storck KG v OHIM, supra).

18. The subject mark is the three dimensional shape of a tablet in colour blue. The relevant consumers, who are reasonably well-informed and observant, would be used to seeing a wide variety of medicine tablets in different shapes, sizes and colours. When the subject mark is used in relation to the goods applied for which are essentially pharmaceutical and other preparations for medical purposes, the relevant consumer is likely, upon first impression, to perceive the subject mark as a simple representation of a fairly ordinary tablet.
19. Tablets often come in different geometric shapes, namely, circular, oval, elliptical, cylindrical, rhombus, square or rectangular. Tablets with round or no hard edges are also commonplace and standard features in medicine tablets because they significantly facilitate the swallowing process. As for the colour blue, I do not think for myself that it is an unusual colour for medicine tablets. The relevant consumer is accustomed to finding that colour in medicine tablets. When the subject mark is considered in its entirety, it represents nothing more than an ordinary shape and colour of a medicine tablet. I am not convinced by Mr Wong’s submission that the combination of all the features in the subject mark departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin. When the subject mark is used in relation to pharmaceutical and other preparations for medical purposes, the relevant consumer is likely to see the subject mark simply as the appearance of the product itself or a representation of a medicine tablet found on the packaging of the product.

20. Owing to the grave if not fatal consequences of taking the wrong pharmaceutical and other preparations for medical purposes, I agree with Mr Wong that the relevant consumers would exercise a higher level of care in picking them than in buying other products such as skincare preparations. But I also consider that when it comes to choosing pharmaceutical and other preparations for medical purposes, the relevant consumers are not generally in the habit of making assumptions about the trade origin of those goods on the basis of their shape and/or colour in the absence of any graphic or word element. I am not satisfied that without first educating the relevant consumers, the relevant consumers would rely solely on the subject mark, being no more than the representation of the three-dimensional shape of a tablet in colour blue, to identify a particular undertaking from which the pharmaceutical and other preparations for medical purposes in question originate.

21. At the hearing, Mr Wong makes the submission that the colour and shape adopted in the subject mark were specifically and carefully chosen in order to ensure that they can serve to distinguish the Applicant's products from other pharmaceutical products. However, neither novelty nor originality is a relevant criterion in the assessment of distinctive character of a mark. For a
three-dimensional mark to be registered, it does not suffice that it is original, but it must differ substantially from the basic shapes of the goods in question, commonly used in the trade, and not look like a mere variant of those shapes (paragraph 38 of *Wim Dw Waele v OHIM* (Case T-15/05), Court of First Instance of the European Communities). As I have found in paragraphs 19 above, the subject mark as a whole represents no more than an ordinary shape and colour of a medicine tablet. I do not consider that the subject mark departs significantly from the norm or customs of the sector.

22. For the reasons stated above, I find that the subject mark is the sort of mark which on its own, assuming no use, cannot do the job of distinguishing without first educating the public that it is a trade mark. It is therefore devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

*Aquired distinctiveness*

23. Section 11(2) of the Ordinance provides that 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.

24. Distinctive character may be acquired through use of a mark if as a result of the actual use of the mark on the goods and services, the mark has come to identify the goods or services in question as originating from a particular undertaking and thus to distinguish the relevant goods and services from those of others. The assessment of the distinctive character of a mark was discussed in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots-und Segelzubehör Walter Huber and Franz Attenberger* [1999] E.T.M.R. 585 (C-108/97 and C-109/97), at paragraph 54 where the ECJ found that:

“- 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

... - in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings

- if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied....”

25. In the case Société des Produits Nestlé SA v Mars UK Ltd. [2005] E.T.M.R. 96 (C-353/03) (”Have a Break”) where the mark in question was used as part of a registered mark, the ECJ has also stated the following:

“29 The expression "use of the mark as a trade mark" must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

31 The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: 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 (judgment in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] E.C.R. I-2779, [49] and [51]).”

26. Applying the above principles, I must make an overall assessment of the evidence filed to determine whether the subject mark has acquired distinctive character as a result of its use. In my assessment the views of the relevant consumers must be taken into account. The crucial question to ask is whether the relevant consumers referred to in paragraph 15 above have been educated to recognize the subject mark as a badge of origin of the goods applied for. If I
consider that a significant proportion of the relevant class of consumers identifies
the applied-for goods as originating from a particular undertaking because of the
use made of the subject mark before the application date, the objection raised
against the subject mark under section 11(1)(b) of the Ordinance would be
overcome.

27. I now turn to consider the various statutory declarations filed in support of the
subject application.

28. According to paragraphs 4 and 5 of the Leung Declaration, the Applicant only
claimed use of the subject mark in Hong Kong in respect of “pharmaceutical
preparations” in class 5. The Declarations provide no information on the use of
the subject mark in relation to the rest of the goods in class 5, namely,
“veterinary and sanitary preparations; dietetic substances adapted for medical
use, food for babies; plasters, materials for dressings; material for stopping teeth,
dental wax; disinfectants; preparations for destroying vermin; fungicides,
herbicides” (“unclaimed goods”) The Applicant has thus failed to establish that
the subject mark has acquired a distinctive character through use in respect of the
unclaimed goods. For the rest of this decision, I shall focus on considering
whether the evidence filed shows the acquisition of a distinctive character in
respect of “pharmaceutical preparations”.

29. The Applicant claims to have used the subject mark continuously and
extensively in relation to pharmaceutical preparations in class 5 in Hong Kong
since 8 February 1999. According to the Applicant, the subject mark, which is
a blue, diamond shaped tablet, has been in constant use to identify the
Applicant’s VIAGRA ® brand sildenafil citrate in Hong Kong since 8 February
1999 (paragraphs 3 and 4 of the Leung Declaration and paragraph 3 of the
Cheung Declaration). The Applicant provided the sales figures of
pharmaceutical preparations bearing the subject mark in Hong Kong from 1999
to 2004 in paragraph 6 of the Leung Declaration.

30. I note that the sales figures are quite substantial. These figures, if they actually
relate to use of the subject mark on the goods i.e. pharmaceutical preparations
are not to be ignored but they alone are not conclusive when assessing whether
the subject mark has acquired distinctiveness. I must also look at other parts of
the evidence to determine if the use of the subject mark has any trade mark
significance. As Morritt L.J. in the Court of Appeal stated in Bach and Bach
Flower Remedies Trade Marks [2000] RPC 513 at paragraph 49, “... use of a
mark does not prove that the mark is distinctive. Increased use, of itself, does
not do so either. The use and increased use must be in a distinctive sense to
have any materiality.”

31. In order to decide whether the relevant customer has been educated of the trade
mark significance of the subject mark, I have to look for evidence showing how
the subject mark was actually presented to those customers. In order to assess
whether a mark has acquired distinctive character through use, all the
circumstances in which the relevant consumer may see that mark must be borne
in mind, and that means not only when the decision to purchase is made but also
before that point, for example, as a result of advertising, and when the product is
consumed (paragraph 71 of August Storck KG v OHIM [2006] ECR I-5677 (Case
C-24/05 P)).

32. Copies of invoices purport to show use of the subject mark since 1999 are
provided in Exhibit TA-2 to the Angus First Declaration and Exhibit CWL-1 to
the Cheung Declaration. The earliest invoice bears a date in 1999. However,
out of a total of nineteen invoices, I find not even one single piece of invoice
which shows use of the subject mark. Rather, all the invoices make reference to
the word mark “VIAGRA”. The invoices therefore fail to substantiate the
claim that the subject mark has been used in Hong Kong since February 1999.

33. Various copies of advertisements, promotional materials, press coverage,
newspaper and magazine articles et cetera are produced under Exhibits LSKK-1
and LSKK-2 to the Leung Declaration, Exhibit TA-2 to the Angus First
Declaration and Exhibit CWL-2 to the Cheung Declaration. As illustrated by
the evidence, the subject mark has been invariably used with distinctive elements
such as the words “Pfizer”, “Viagra” or the Chinese characters “威而鋼”. I am
mindful of the ECJ’s judgment of *Nestle SA’S Trade Mark Application (Have a Break)* (supra) that there is no bar to a mark acquiring a distinctive character as a result of its use as part of another trade mark. However, as mentioned in paragraph 14 above, whilst the public is used to recognizing a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product instantly as signs identifying the product, it is not necessarily so where the sign is indistinguishable from the appearance of the product itself. The words “Pfizer”, “Viagra” and the Chinese characters “威而鋼” are always prominently displayed in the materials. When used in relation to pharmaceutical products, the words “Pfizer”, “Viagra” and the Chinese characters “威而鋼” are much more distinctive than the subject mark, being a three-dimensional shape of a tablet in colour blue. In my judgment, the subject mark would be seen by the relevant consumer simply as illustration of the appearance of the pharmaceutical products being sold. The relevant consumer is very likely to perceive the distinctive word marks “Pfizer”, “Viagra” and “威而鋼” as the indicators of trade origin to identify the pharmaceutical products concerned.

34. The Applicant averred in paragraph 10 of the Leung Declaration that it had operated a websites at www.pfizer.com.hk since June 2001 which provides information regarding VIAGRA ®. According to the Applicant, the image of blue, diamond shaped tablets receives a high profile on the website and is prominently depicted on almost every page. Extracts of materials downloaded from the said website are provided in Exhibit LSKK-5 to the Leung Declaration. At page 32 of Exhibit LSKK-5 to the Leung Declaration, I note that the Applicant itself states that the Applicant’s VIAGRA ® brand sildenafil citrate is not sold loose but in a box of four tablets. A picture showing a representation of the packing is provided at pages 54 and 55 of Exhibit LSKK-5 to the Leung Declaration and is reproduced in the Annex to this decision. From the picture presented, I observe that the subject mark does not appear on the box. Accordingly, in making the decision to purchase, the relevant consumer is not in a position to see directly the shape and/or colour of the tablet in question enabling that person to attribute to that shape and/or colour the function of indicating the product’s origin.
35. In view of the manner of actual use of the subject mark as shown in the evidence, I do not consider that the Applicant has used and promoted the three-dimensional shape of the tablet in colour blue, i.e. the subject mark, as having any trade mark significance. I am not satisfied that the Applicant has educated the relevant consumers that the subject mark is, in its own right, used for the purpose of identifying the products as originating from the Applicant, or that it serves to guarantee the identity of the supplier of the products.

36. Mr Wong submits that various gift items featuring the shape of the pills (i.e. the subject mark) have been distributed among the trade and/or the public. He refers me to Exhibits LSKK-3 and LSKK-4 to the Leung Declaration and Exhibits CWL-3 and CWL-4 to the Cheung Declaration, which consist of copies of photographs showing a “Viagra” watch and the giveaways (including an eye-pad, a pen holder, a paper-clip holder and a strip of stickers).

37. Notwithstanding that the distribution numbers of those gift items were stated in paragraph 8 of the Cheung Declaration, the Applicant did not file any evidence to corroborate the distribution numbers. Apart from filing several pages of photographs showing a “Viagra” watch and the giveaways, the Applicant adduces no other evidence on the scale or extent of distribution of those gift items. In any event, I note from those pages of photographs that in most cases, the word “VIAGRA” is prominently displayed on the gift items which take the shape of the subject mark. While consumers are likely to remember the subject mark as the shape of the gift items themselves, I cannot perceive how that could assist the Applicant’s case that the subject mark has acquired a distinctive character in respect of pharmaceutical preparations. The gift items do not, in my view, serve to prove that the subject mark would be relied upon as a guarantee of origin.

38. The Applicant averred in paragraph 11 of the Leung Declaration and paragraph 10 of the Cheung Declaration that it and its Pfizer affiliates have participated in numerous medical conventions and congresses around the world. According to the Applicant, the subject mark has been prominently displayed at the Applicant’s booth. Copies of materials, pictures and photographs giving details
on those medical conventions and congresses are provided under Exhibits LSKK-6 and LSKK-7 to the Leung Declaration and Exhibit CWL-5 to the Cheung Declaration.

39. All the events mentioned in Exhibits LSKK-6 and LSKK-7 were held outside Hong Kong. I do not consider that these are relevant to establish use of the subject mark in Hong Kong. For the events mentioned in Exhibit CWL-5, although they appeared to be held in Hong Kong, I cannot ascertain on the face of those materials whether, and if so, how the subject mark was applied in relation to any of the goods applied for, let alone they were held prior to the application date. I find those materials too, of no relevance.

40. Finally, I turn to the nine statutory declarations from nine doctors in Hong Kong which are produced under Exhibit TA-1 of the Angus First Declaration. From the nine statutory declarations, it appears that some kind of survey has been conducted. These nine doctors were asked, in April 2005, the following questions:

(c) are you familiar with use of this shape and colour combination as a pharmaceutical tablet? [A representation of the subject mark is placed next to the question] (hereinafter called “Blue Diamond Tablet Shape”)

(d) what does the "Blue Diamond Tablet Shape” refer to?

(e) do you associate the use of the “Blue Diamond Tablet Shape” with goods produced by a particular organization?
If your answer to question (e) was that you do associate the "Blue Diamond Tablet Shape" with the goods produced by a particular organization, please answer questions (f), (g) and (h)

(f) what organization produces those goods?

(g) does your practice deal in those goods? If so, for how long have you done so?

(h) for how long have you known that the “Blue Diamond Tablet Shape” was associated with those goods?
41. In the nine statutory declarations, all the doctors said that they associated the “Blue Diamond Tablet Shape” with Pfizer. However, in my judgment, it is not possible to place any real weight on the survey, for the following reasons.

i. First of all, as far as the survey is concerned, it is not entirely clear to me how the interviewees were selected, how many people were invited to take part in the survey, what were the responses of each of the interviewees, at what place and over which period of time was the survey conducted, the exact instructions given to interviewees, and what relationship, if any, the deponents have with the Applicant, including whether they are the Applicant’s clients.

ii. Leaving aside the formal defects above, the doctors are evidently specialists in the field and so it is not surprising that they recognize the Applicant’s products.

iii. The nine statutory declarations merely show that the nine doctors being surveyed associated the “Blue Diamond Tablet Shape” with Pfizer. Mere product recognition and association with one trader is not enough – it must be shown that the relevant consumer has come to recognize the shape as a badge of origin (Unilever plc’s Trade Mark Application [2002] EWHC 2709, [2003] RPC 35). However, the nine statutory declarations do not show that the doctors perceive the combination of the shape and colour of the tablet, i.e. the subject mark, as a trade mark or rely on the subject mark alone as an indicator of origin.

iv. More importantly, what must be shown is that a significant proportion of the relevant class of persons relies upon the sign in question on its own as indicating the origin of the goods. As said in paragraph 15 above, the relevant consumer in the present application is not just limited to the medical professionals but also includes the general public. The survey contains only a small number of specialist customers (i.e. nine doctors) for the Applicant’s products. In the result, the survey does not establish that the subject mark has come to distinguish the pharmaceutical products of a particular undertaking in the perception of a significant proportion of the relevant class or persons. There is almost complete lack of any evidence from the end users.
42. Having thus considered the totality of the evidence filed, I am not satisfied that the subject mark has indeed, before the date of application for registration, acquired a distinctive character in respect of any of the applied for goods as a result of the use made of it in Hong Kong for the purpose of section 11(2) of the Ordinance. The evidence filed fails to overcome the objection under section 11(1)(b) of the Ordinance.

Foreign registrations

43. Mr. Wong also refers to the acceptance of the subject mark for registration in, namely, the United Kingdom, European Community, New Zealand, Australia, China, Japan and Ireland.

44. National trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here, where there are valid grounds for refusal under the Ordinance. In the subject application, I am not convinced that the subject mark should be accepted for registration in light of the reasons for objections stated above. I should further add that the acceptance of the subject mark in the United Kingdom is of no relevance because the UK Trade Mark Office has actually accepted the application of the subject mark “because of distinctiveness acquired through use and trade evidence” in that country. The overseas evidence cannot assist the subject application as they relate only to the United Kingdom and could not be considered sufficient to show that the subject mark has been extensively used as a trade mark throughout Hong Kong.

Conclusion

45. In this decision, I have carefully considered all of the materials filed, including the written and oral submissions 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.

Jessica Law
for Registrar of Trade Marks
28 November 2008
生活與健康

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