

Application No. 200101385

IN THE MATTER of the Trade Marks
Ordinance (Cap. 43)

AND

IN THE MATTER of an application for the
registration of the mark "SO LONG" in
Part A in Class 3 by L'OREAL

**DECISION
OF**

Miss Finnie Quek acting for the Registrar of Trade Marks after a hearing on 24
February 2004.

Appearing : Ms. Peggy Cheung of Messrs. Baker & McKenzie on behalf of the
applicant L'OREAL.

Background

1. On 23 January 2001, L'OREAL (the "applicant") filed an application to register, in Part A of the Register, in Class 3 the mark "SO LONG" in plain block capitals (the "subject mark"). The goods in respect of which registration is sought are:

"Shampoos; gels, sprays, mousses and balms for the hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use."

2. Objection was raised by the Registrar under paragraph (d) of section 9(1) of the Trade Marks Ordinance (Cap. 43) that the mark is laudatory of the long-lasting effects of the applied-for goods. It was determined that the mark was neither inherently adapted to distinguish nor inherently capable of distinguishing the applicant's goods from similar goods of others (sections 9 and 10). It was therefore considered *prima facie* unacceptable for registration whether in Part A or Part B of the Register.

3. The objections were maintained in correspondence and in an "informal discussion" held on 6 September 2002. It was considered that the words "SO LONG" may be used by other traders in describing their products as long lasting or that they enable customers to say goodbye to undesirable conditions. Refusal of registration of the mark was maintained. The matter eventually became the subject of a hearing before me on 24 February 2004 at which Ms Peggy Cheung of Messrs. Baker & McKenzie appeared on behalf of the applicant.

Hearing

4. At the hearing, Ms Cheung indicated that the applicant would not pursue acceptance of the mark in Part A, and would only pursue registration of the mark in Part B of the Register.

5. Ms Cheung submitted that the question is whether the mark is capable of distinguishing within the meaning of section 10(1) and (2) of Cap. 43, and this depends on whether or not the words have a direct reference to the character or quality of the goods (*Verve's Records Inc.'s Application* [1958] R.P.C. 3 and *ROTOLOK Trade Mark* [1968] R.P.C. 227 relied on). One must consider what the public seeing the mark in conjunction with the goods is likely to see the mark to mean

(Mark Foy's Ltd.v Davies Coop & Co. Ltd. [1956] 95 C.L.R. 190 relied on). Ms Cheung referred me to *Tastee Freez International Ltd.'s Application [1960] R.P.C. 255* where Lloyd-Jacob, J. said at page 258 that “There may be cases where one can find a reference to the character or quality of the goods as an academic exercise, but where, using common sense, one can find that the reference is not so weighty that it removes the possibility that the mark in use will be recognised as capable of distinguishing.”

6. Ms Cheung submitted that the mark “SO LONG” being a colloquial term meaning “farewell, goodbye” was a fanciful expression with no direct meaning in relation to the Class 3 goods applied for. There may be a skilful allusion in using “SO LONG” to mean saying goodbye to greasy hair or dandruff, but the mark would not signify any particular character or quality of the products. She further submitted that “SO LONG” would not be taken to mean the products were designed solely for long hair. Using common sense, the products would not enable hair to grow long. She submitted that the words “SO LONG” had no sensible direct reference to the character of the products and that the mark should be considered capable of distinguishing within the meaning of section 10 of Cap. 43.

7. Ms Cheung also drew my attention to acceptance of the mark elsewhere, and the fact that the Registrar had accepted some other marks in Class 3 which the applicant considered to be comparable.

8. I was not persuaded by the arguments advanced, and by a letter dated 29 March 2004, I communicated my refusal of the application to the applicant. On 30 March 2004, the applicant filed a request for a statement of grounds of my decision and the materials used in arriving at it (section 13(4) of the Trade Marks Ordinance (Cap. 43) and rule 20(2) of the Trade Marks Rules (Cap. 43A)). These are provided as follows.

Decision

9. Although the hearing took place after the commencement on 4 April 2003 of the Trade Marks Ordinance (Cap. 559), the application is a pending application for the purpose of section 10(1), Schedule 5 of Cap. 559. It therefore remains to be dealt with under the provisions of Cap. 43.

10. No evidence has been filed to show that the mark has become distinctive in

fact by reason of use or of any other circumstances. I therefore need only consider the prima facie case.

11. The onus is on the applicant to justify registration.

12. A word or words which have a very direct reference to the character or quality of the goods concerned and which are therefore apt to describe such characteristic or quality would not be capable of distinguishing one trader's goods from similar goods of others. This is because words that are apt to describe the goods of A are likely to be apt to describe similar goods of B. However, it does not follow that if certain words are not directly descriptive of the character or quality of the relevant goods, they would necessarily qualify for registration. The question is whether those words can perform the function of indicating origin, and therefore capable of distinguishing the applicant's goods from the goods of other traders.

13. The applicant has referred me to *Verve's Records Inc.'s Application* [1958] R.P.C. 3. There the Hearing Officer concluded that as the mark consisted of an ordinary word ("verve") with a well understood meaning, which meaning he thought had a very direct and close reference to the character or quality of the goods, the mark was not inherently capable of distinguishing. On appeal, Lloyd-Jacob, J. considered and did not disturb this finding. Similarly in *ROTOLOK Trade Mark* [1968] R.P.C. 227 at 229 lines 40-46, it was held that if a word is of a descriptive character and in that character has a direct reference to the character or quality of the goods of the person seeking to use it as a trade mark, it must follow that it would be equally appropriate to describe the character or quality of the goods of any other person dealing in a similar article, and the necessary consequence of that must be, that in the absence of some special circumstance, the word is not appropriate to distinguish the goods of one maker or trader from the goods of another. Also in *Tastee-Freeze International Ltd.'s Application* [1960] R.P.C. 255 at 259, the Assistant-Comptroller, with whom Lloyd-Jacob, J. was in complete agreement, held that by reason of their "direct and close reference", which was the proper conclusion under section 9, the mark applied for was not "inherently capable of distinguishing" the goods of the applicant.

14. These cases, however, do not say that a word which is not directly descriptive of the character or quality of the goods applied for would necessarily be capable of distinguishing the applicant's goods from those of other traders.

15. In *Mark Foy's Ltd. v Davies Coop & Co. Ltd.* [1956] 95 C.L.R. 190 at 195, when Dixon C.J. said,

“The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess”

he was there construing the meaning of “*direct reference to the character or quality of the goods*” in section 16(1)(d) of the Australian Trade Marks Act 1905-1948, which was the equivalent of section 9(1)(d) of Cap. 43. Dixon C.J. went on to decide at page 201 that since the words “Tub Happy” contained at most a “covert and skilful allusion” to the quality and washability which is characteristic of articles of clothing made of some kinds of material including cotton; that at most they create an impression that this is what they are intended to convey; they do not trespass upon the rights of other traders to use any ordinary English words or phrases referring to the washable qualities of the goods. Those words do not attempt to “enclose and appropriate as private property certain little strips of the great open common of the English language”. It can be seen from that case that it is necessary to consider whether registration of a mark would trespass upon the legitimate interests of other traders in using ordinary words of the English language.

16. Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders (per Lloyd Jacob J. in *TORQ-SET Trade Mark* [1959] R.P.C. 344 at 346 lines 34-39). The question is therefore whether other traders (at present and in the future) are likely to legitimately wish to use the subject mark, or some mark nearly resembling it, in connection with or to describe their own goods.

17. In *ALWAYS Trade Mark* [1986] R.P.C. 93, the mark consisting essentially of the word “Always” was applied for in relation to goods in Classes 3, 5 and 21. Registration of the mark whether in Part A or Part B of the Register was refused. The Registrar’s hearing officer held that,

“It is too narrow a view to look at the mark in isolation --- it must be looked at in the context of the goods and it seems to me that it is one of those words which would facilitate use in advertising slogans and the like. “Always the best”, “Always absorbent”, “Always good for your skin”, “Always perfect” spring easily to mind as descriptive slogans or laudatory puffs in relation to the goods claimed.”

On appeal, Falconer J. considered that the hearing officer was right in so looking at the matter.

18. In *NEXT Trade Mark* [1992] R.P.C. 455, application to register the word NEXT as a trade mark in Class 34 was refused by the UK Registrar. On appeal before Robin Jacob, Q.C., he stated that the applicable principles under sections 9 and 10 of the Trade Marks Act 1938 were as stated by Falconer J. in *ALWAYS Trade Mark* [1986] R.P.C. 63. The mere fact that the mark has no direct reference to the character or quality of the goods is not conclusive. Falconer J. in *ALWAYS* approved the test of the Registrar's hearing officer, namely, is this "one of those words which would facilitate use in advertising slogans and the like?" Applying that test, registration of the mark "NEXT" in Part A was refused. Robin-Jacob, Q.C. further held that, once it appears that the question is whether registration of the mark might trespass upon the legitimate freedom of other traders, *TORQ-SET Trade Mark* [1959] R.P.C. 344 at 346, per Lloyd-Jacob J., the reasons for refusal in Part A apply also to refusal in Part B. He concluded that the appeal could not succeed even for Part B.

19. In this case, the mark "SO LONG" is applied for in respect of "shampoos; gels, sprays, mousses and balms for the hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use". The words "SO LONG" would facilitate use in advertising and promoting the goods, e.g. to say that the hair care products "last so long", "hold so long", and allow you to "say so long to dandruff, tangles and knots". Products like gels, sprays and mousses that hold long in the sense that they maintain the stylised state of hair for long are clearly desirable; as are hair colouring and curling preparations which make coloured or curled hair remain in such a state for long. Hair care products that are economical to use such that a bottle can last long is also desirable. "SO LONG" in the sense of bidding farewell may also be used to indicate in a lively but still a direct way the characteristic of ridding the user of undesirable conditions, e.g. say "SO LONG" to dandruff. The words "SO LONG" are therefore likely to be desired to be used by traders in their ordinary course of business and without improper motive in advertising or promoting their goods. Examples of use in advertising given in the Registry's letter dated 19 November 2003 before the hearing (see *Annex* hereto) confirm the view that the words "SO LONG" are likely to be desired by traders as a descriptive phrase in advertising or promoting similar goods. They are therefore not inherently capable of distinguishing the applicant's applied-for goods from those of other traders. I am

mindful of the fact that a trade mark registration grants a potentially perpetual monopoly. The privilege of a monopoly should not be conferred where it might require honest men to look for a defence when they use ordinary descriptive words (*COLORCOAT* Trade Mark [1990] R.P.C. 511 at 517).

20. The applicant has drawn my attention to the acceptance of the subject mark in the Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”).

21. I refer to the following passage in *NEEDLE-TIP Trade Mark* [1973] RPC 113 at 118 :

“It seems to me that the mere fact that a mark has been registered in a foreign country has little or no bearing on whether the mark is capable of distinguishing the goods of the applicant in this country. Registration in the foreign country will have been allowed according to the law and practice in that country which may differ from that of this country and may have been allowed in the light of particular circumstances and trading conditions in that country and which may be very different to those obtaining in this country. It may be that, in a case where a mark applied for here has already been registered in a foreign country with a system of trade mark law similar to our own, if a written decision of the foreign tribunal allowing registration in the foreign country and which showed the grounds of the decision and the matters taken into consideration were to be adduced on the application here, it might be persuasive as a piece of reasoning as to whether the mark should be registered here, if, but only if, similar considerations applied in this country, but that, it seems to me is as far as registration in a foreign country could be relevant to registrability here ... On the present appeal, however, all that has been relied upon is the mere fact of registration in the countries mentioned and that mere fact ... is of little or no bearing on whether the mark is capable of distinguishing the applicant’s goods in this country.”

22. In this case, I have only been referred to the mere fact of registration of the subject mark in OHIM. No written grounds of decision of any foreign tribunal have been provided. I do not consider that the mere fact of such registration afford a special circumstance which makes it any easier to say that the subject mark is capable of distinguishing the applicant’s applied-for goods from those of other traders.

23. The applicant has also referred me to Trade Mark No. 2000B01305

("SO ...?" registered in Class 3), Trade Mark No. 200208883 ("NOT SO FAST" registered in Class 3) and Trade Mark No. 2002B14098 ("SO YOU" registered in Class 3).

24. To borrow the words of Buckley, J. in *ROTOLOK Trade Mark* [1968] RPC 227, I do not think existing registrations can really be of assistance, because I cannot tell what special circumstances there may have been to justify registration of those marks, and the fact that these other registrations already exist does not afford a special circumstance which makes it any easier to say that the suit mark now sought to be registered is capable of distinguishing the Applicant's goods. Moreover, it is well-established that each case must be considered on its own merits (*Colorcoat Trade Mark* [1990] R.P.C. 511 at 517; *Madame Trade Mark* [1966] R.P.C. 541 at 545). In *British Sugar Plc. v James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 305, Jacob J. stated that, "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. I disregard the state of the register evidence." The existing registrations referred to in paragraph 23 do not therefore assist the Applicant.

25. For the above reasons, I maintain that the mark is not capable of distinguishing within the meaning of section 10 of Cap. 43, and therefore cannot be accepted for registration even in Part B of the Register.

26. In arriving at my decision, I have considered the written arguments made by the applicant's agents by letter dated 2 August 2001; the record of the arguments raised in the informal discussion held on 6 September 2002; the written arguments by letter dated 18 March 2003 (with enclosures); the Trade Marks Ordinance (Cap. 43); the Trade Marks Rules (Cap. 43A); the authorities cited herein and the examples of use taken from the INTERNET in the *Annex* based on searches made on 28 October 2003 and 17 November 2003.

(Finnie Quek)
p. Registrar of Trade Marks
19 April 2004

Examples from the INTERNET

http://www.lalooks.com/products_straight_spray.html :

“L.A. LOOKS

STRAIGHT LOOK

STRAIGHTENING STPRAY

... This high performance, fine mist straightening spray is definitely not for amateurs - use it on wet and dry hair for a professional-grade straight and sleek look. It works so well and holds **so long**, even your flat iron will be jealous.”

http://www.makeupalley.com/product/showreview.asp/ItemID=4954/Conditioner/Aveda/Sap_Moss_Conditioning_Detangler/ :

“Conditioner -> Aveda -> Sap Moss Conditioning Detangler

... Reviewed by Chandler5

Quite expensive for conditioner, I'd say. But that's my only big complaint about this product. ... Since the products last **so long** in my case, it offsets the price.”

<http://www.cosmeticconnection.com/090803.html> :

“THE COSMETIC REPORT

... This week I am pleased to share my review of Kenra Haircare....

Moisturizing Conditioner (\$12 for 10.1oz)

I LOVE this conditioner! It's rich with a consistency like buttery honey, and does it ever detangle! In an instant, dry hair starts transforming and you can say "**so long**" to any tangles or knots that so often come with dry or heat-styled hair.”

<http://hairproductstogo.com/roffler.htm> :

“Roffler Protein Normalizing Lotion

...

Normalizing lotion is both a LEAVE IN CONDITIONER and a STYLING AID. The hidden surprise is PNL is economical to use because it lasts **so long**.”

http://www.aubrey-organics.com/product1.cfm?product_id=102A&cat=14 :

“Aubrey Organics

Customer Reviews about Natural Baby and Kids Bath Soap

... I began using the Natural Baby and Kids Bath Soap on my daughter when she was first born. It keeps her skin wonderfully soft.... As a bonus, the bottle lasts **SO long** (great value for the \$\$).”

<http://www.greatskin.com/product/zirh/zirhprod.htm> :

“Zirh Restore

Say **so long** to under eye sacks and circles. In an instant, caffeine shrinks puffiness and darkness fades. Moisture and chamomile wipe out the tight, tired feeling. Cucumber cools like a splash of icy water. Fights lines and age signs.”