

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 200212625AA
MARK: FIRST CHOICE
APPLICANT: Dairyfarm Establishment
CLASS: 3, 5, 6, 9, 16, 20, 25, 26, 29, 30, 31 & 32

STATEMENT OF REASONS FOR DECISION

Background

1. The subject application resulted from the merger of 12 applications filed under the repealed Trade Marks Ordinance (Cap. 43). Particulars of the 12 applications are set out in the Schedule hereto.
2. Applications to register the mark “First Choice” were made by the Applicant, Dairyfarm Establishment (“Applicant”), under Cap. 43 on 13 August 2002. These applications covered goods in 17 classes.
3. Objections were raised against the applications under Cap. 43. On 23 June 2003, the Applicant, pursuant to section 11 of Schedule 5 of the Trade Marks Ordinance (Cap. 559) (“Ordinance”), converted these applications to applications under the Ordinance. The accorded filing dates were therefore 4 April 2003.
4. The applications were re-examined under the Ordinance. Objections were raised under sections 11(1)(b) and (c) of the Ordinance in the Registrar’s letters dated 9 October 2003.
5. On 26 March 2004, the Applicant filed two statutory declarations made by Dianne Edmunds and Claude Sorbello respectively with a view to establishing that the mark has acquired factual distinctiveness in respect of the goods. This was followed by further correspondence between the Registrar and the Applicant concerning the specification of goods and the evidence of use provided in support.

6. On 10 November 2004, the Applicant applied to merge 12 of the above applications on Trade Mark Form T4 (particulars of such applications are set out in the Schedule). The application for merger was accepted by the Registrar on 11 December 2004.
7. Based on the statutory declarations filed by the Applicant, the Registrar was satisfied that the mark has acquired factual distinctiveness for the purpose of section 11(2) of the Ordinance in respect of goods under classes 5, 6, 9, 20, 25, 29, 30, 31 and 32. In respect of classes 3, 16 and 26, the Registrar was satisfied that the mark has in fact acquires distinctive character in respect of only some of the applied-for goods.
8. On 17 December 2004, the Applicant requested a hearing to consider the outstanding issues under classes 3, 16 and 26. The hearing took place on 15 April 2005. The Applicant was represented by Mrs. Helen Hancock. I reserved my decision until after the hearing.
9. On the day of the hearing, the Applicant made a request on Trade Mark Form T3 to divide the application into two divisional applications. The first divisional application covers goods in classes 5, 6, 9, 20, 25, 29, 30, 31 and 32 (Application no. 200212625AB). The second application covers goods in classes 3, 16 and 26 (Application no. 200212625AC). Application no. 200212625AB will soon be published in the Official Journal. I am therefore left to consider the application in relation to classes 3, 16 and 26.
10. In addition to the request to divide the application, the Applicant also made a request to amend the specification of goods in classes 3, 16 and 26 on the day of the hearing.

Submissions made by the Applicant

11. During the hearing, Mrs. Hancock did not make any submissions on the registrability of the mark on a prima facie case. Her submissions were focused on the request to amend the specification of goods and the factual distinctiveness acquired by the mark in respect of the goods in classes 3, 16 and 26.

Class 3

12. The Applicant applied to amend, on Trade Mark Form T5A, the specification of goods

in class 3 to “bleaching preparations and other substances for laundry use; cleaning, scouring and abrasive preparations, soaps; hair lotions; cosmetics; *cotton sticks, wet wipes, impregnated tissues*”. The terms in italics were not contained in the specification of goods in the original application for registration filed under Cap. 43 (Application no. 200212625).

13. In respect of “bleaching preparations and other substances for laundry use; cleaning, scouring and abrasive preparations, soap; hair lotions”, the Registrar has confirmed in his letter dated 20 September 2004 that he was satisfied that the mark has acquired a distinctive character in relation to the above goods. I am therefore only required to consider the remaining parts of the specification.

Request to amend the specification of goods

14. The Applicant sought to add “cotton sticks, wet wipes and impregnated tissues” to the specification of goods. Mrs. Hancock on behalf of the Applicant submitted that these goods were “cosmetics” and therefore they come within the original specification of goods.
15. The original specification of goods consists exclusively of goods appearing as class headings under the Nice Classification. The general remarks under the Nice Classification states:

“The indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong.”

It follows that class headings do not necessarily cover all the goods and services listed in the Nice Classification. This is also the view of the UK Patent Office.¹

16. I will now examine the individual items proposed to be added by the Applicant to determine whether they come within the term “cosmetics” as submitted by Mrs. Hancock.
17. “Cosmetics” is defined in Collins English Dictionary as “any preparation applied to the body, especially the face, with the intention of beautifying it.

¹ UK Patent Office – Classification current issues – November 2004

18. In support of her view that “cotton sticks, wet wipes and impregnated tissues” are cosmetics, Mrs. Hancock submitted extracts from Nice Classification – List of goods in class order (class 3) for my reference. “Cotton sticks for cosmetic purposes” and “tissues impregnated with cosmetic lotions” could be found under class 3. In addition, she produced a printout from the website of Aster which shows that the cosmetic set sold by Aster consists of, *inter alia*, cosmetic pads, cosmetic wet wipers and cotton cosmetic sticks.

Cotton sticks

19. I do not think that the above materials lend support to the Applicant’s submission that cotton sticks are cosmetics. Cotton sticks or cotton buds (as they are sometimes called) are generally used for cleaning purposes. They could also be used as applicators for applying cream or cosmetics onto our skin. The fact that they could be used for cosmetic purposes does not mean that they are cosmetics or cosmetic preparations.

Wet wipes and impregnated tissues

20. “Wet wipes and impregnated tissues” are similar products. “Wipes “ are commonly used to describe paper tissues or fibre “cloths” that are pre-moistened. “Impregnated tissues” are also pre-moistened tissues. “Tissues impregnated with cosmetic lotions” are classified under Class 3 of the Nice Classification. To the extent that “wet wipes and impregnated tissues” are pre-moistened with cosmetic lotions, I agree that they come within the ambit of “cosmetics”. However, “wet wipes and impregnated tissues” are wide enough to cover tissues impregnated with preparations for cleaning [non-medicated, for use on the person]². These types of products, also classified under class 3, are principally used for cleaning and not beautifying the skin. Based on the above observations, I conclude that only certain types of “wet wipes and impregnated tissues” could properly be classified as “cosmetics”.

Section 46 of the Ordinance

21. Putting aside the issue of whether the goods proposed to added fall within the original specification, the amendments sought to be made involve amendments to the subject application. Section 46 of the Ordinance sets out the circumstances under which an application may be amended. In brief, an application for registration may be

² Extracts of Classification descriptions of UK Patent Office submitted by Applicant during the hearing.

amended for the purpose of adding a registered trade mark (section 46(2)), restricting the goods or services covered by the application (section 46(3)(a)) or correcting any errors of wording or other obvious mistakes (section 46(4)). Section 46(3)(b) also allows amendments to be made for other purposes as may be prescribed by the Trade Marks Rules (Cap. 559A) (“Rules”). These additional purposes, which are set out in rule 23 of the Rules, are not relevant for the present purpose.

22. The Registry’s Work Manual on “Amendment of applications” explained the rationale for limiting the circumstances under which amendment of an application can be allowed as follows:

“The philosophy under the new law is that application details should be correct as from the time of filing of the application. It is not in the interest of the public at large that an applicant be allowed to subsequently change what he has applied for.”

23. The only ground applicable to the amendments sought to be made in this case is section 46(3)(a), namely amendments for the purpose of restricting the goods covered by the application.
24. Mrs. Hancock did not address me on section 46 during the hearing. However, in her letter dated 15 April 2005, she indicated that the request for amendment was made to *clarify* the specifications.
25. I have discussed in paragraph 19 above that “cotton sticks” do not come within the original specification. The proposed addition of “cotton stick” would therefore *enlarge* the scope of the original specification.
26. In relation to “wet wipes and impregnated tissues”, I do not agree that these items merely serve to clarify the term “cosmetics” in the original specification. I have discussed in paragraph 20 above that these items could include products that are not classified as “cosmetics”. Even assuming that the amendment sought comes within the ambit of “cosmetics”, such amendment would not be allowed by the Registrar. Section 46(3) of the Ordinance only allows amendments for the purpose of *restricting* the goods in question. Clarifying a general item in the specification by adding specific items as examples does not in any way restrict the goods covered by the application and therefore does not fall within section 46(3).

27. Mrs. Hancock mentioned during the hearing that amendments of a similar nature were allowed in other classes of the subject application during the examination stage. I believe that acceptance of such amendments might be caused by mere inadvertence.
28. For the reasons above, the Applicant's request for amendment of goods in the specification of class 3 is hereby refused.
29. I wish to mention at this junction that an applicant for registration is given an opportunity to clarify the goods or services contained in the specification at the "deficiency-checking" stage. Under rule 11 of the Rules, if it appears to the Registrar that the goods or services set out in the specification of an application for registration is not sufficiently clear and concise, he could require the applicant to remedy the deficiency within 2 months. The "deficiency-checking" stage takes place prior to formal examination under rule 12. In relation to the subject application, the Registrar was satisfied, after "deficiency-checking", that the specification was sufficiently clear and the application could proceed to formal examination. Once the application proceeds to the examination stage, there is no facility under the rules for an applicant to further refine or improve its specification. Amendments to an application are only allowed in circumstances set out in section 46 of the Ordinance.

Whether factual distinctiveness has been established for "cosmetics"?

30. Mrs. Hancock submitted that the mark has acquired a distinctive character in cosmetics through use of the mark in relation to cotton sticks, wet wipes and impregnated tissues. I have found in paragraph 19 above that cotton sticks could not be regarded as "cosmetics".
31. The only evidence submitted that are relevant for this purpose is baby wipes sold under the subject mark with an approximate launch date in September 2000. There is nothing in the evidence to show that these baby wipes are impregnated with cosmetic products. Furthermore, even assuming that they could be classified as a type of cosmetic product, I am not satisfied that factual distinctiveness of the mark has been established in relation to cosmetics merely by showing use of the mark on wet wipes for use on babies.

32. To conclude, I am not satisfied from the evidence submitted that the mark has acquired a distinctive character in relation to cosmetics for the purpose of section 11(2) of the Ordinance.

Class 16

33. On the day of the hearing, the Applicant applied to amend, on Trade Mark Form T5A, the specification of goods in class 16 to “paper, cardboard and goods made from these materials, not included in other classes; stationery; adhesives for stationery or household purpose; artists’ materials; office requisites (except furniture); plastic materials for packaging (not included in other classes); *cling film, diapers*”. The terms in italics were not contained in the specification of goods in the original application for registration filed under Cap. 43 (Application no. 200212631).
34. In respect of “paper, cardboard and goods made from these materials, not included in other classes; stationery; adhesives for stationery or household purpose; artists’ materials; office requisites (except furniture); plastic materials for packaging (not included in other classes)”, the Registrar has confirmed in his letter dated 20 September 2004 that he was satisfied that factual distinctiveness of the mark has been acquired in relation to the above goods. I am therefore only required to consider the remaining parts of the specification (i.e. cling film and diapers).

Request to amend the specification of goods

35. Mrs. Hancock submitted that “cling film” should come under “plastic materials for packaging” and “diapers” are “goods made from paper”. Therefore these terms fall within the ambit of the original specification of goods.

Cling film

36. I agree that “cling film” could be regarded as a type of plastic materials used for packaging. However, the amendment sought does not restrict the specification of goods and therefore does not fall within section ~~43-46~~ of the Ordinance. The amendment sought is not allowed.

Diapers

37. Diapers made of linen are classified under class 24 while baby diapers of paper and cellulose [disposable] are classified under class 16 of the Nice Classification. Mrs. Hancock submitted that diapers (other than those made of textile) should be included under the class heading “goods made from paper”. I do not agree with the Applicant’s submission.
38. I have explained the significance of class headings in paragraph 15 above.
39. Modern disposable diapers (commonly referred to as “paper diapers”) are typically composed of liners made of plastic and non-woven materials. The absorbent core is made of highly absorbent polymer or wood-pulp. Pulp is a mixture of cellulose materials ground up and moistened to make paper. All diapers have adhesive-tape tabs attached to the outer liner for fastening purpose.
40. On the other hand, “paper” is a substance made from cellulose fibres derived from rags, wood, etc. often with other additives, and formed into flat thin sheets suitable for writing on, decorating walls, wrapping etc.³
41. Looking at the typical composition of modern disposable diapers, the paper content is insignificant (to say the least). Given the difference between paper and pulp/cellulose, the fact that the absorbent core could be made of, *inter alia*, pulp or cellulose does not turn diapers into a paper product. Nor should they be regarded as goods made of paper simply because they are commonly referred to as “paper diapers”.
42. In any event, the proposed amendment to the specification of goods sought by the Applicant does not restrict the specification of goods and therefore does not come within the ambit of section 46 of the Ordinance. I would not allow the amendments sought.
43. As amendments to the specification are not allowed, there is no need for me to consider whether factual distinctiveness has been established for cling film and diapers.

³ Extracted from Collins English Dictionary

Class 26

44. The original specification of goods in the application is “lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers”.
45. The Registrar was not satisfied that factual distinctiveness of the mark was established in respect of the above goods during the examination stage.

Request to amend the specification of goods

46. On the day of the hearing, the Applicant applied to amend the specification to “ribbons and braid; pins, *hair clips*”. “Hair clips” is not contained in the original specification.

Hair clips.

47. Mrs. Hancock submitted that “pin” means “to fasten or secure” while “clip” is defined as “any of various devices for gripping or holding things together; a clasp or fastener”. She took the view that hair clip is a type of pin and the amendment was sought to clarify the term “pins”.
48. Hair clips are classified under class 26 in the Nice Classification.
49. The original specification of goods consists exclusively of items specified as class headings under class 26. However, as I have discussed in paragraph 15 above, class headings do not necessarily cover all the goods or services classified under that particular class.
50. “Hooks and eyes, pins and needles;” are represented as one group of items in the original specification. Each of the above items is capable of having more than one meaning. However, when these items are represented as a group, they should be interpreted in the context and with reference to other items in the same group.
51. “Hooks and eyes, pins and needles” are items used in relation to sewing or needlework. A “pin” is short stiff straight piece of wire pointed at one end and either rounded or having a flattened head at the other; used mainly for fastening pieces of cloth especially temporarily.⁴

⁴ Extracted from Collins English Dictionary

52. Given the above meaning of “pins”, I do not consider that the term covers “hair clips”.
53. In any event, the addition of “hair clips” does not restrict the specification of goods and therefore does not fall within section 46 of the Ordinance. The proposed addition of “hair clips” to the specification is therefore disallowed.

Whether factual distinctiveness of the mark has been established for “ribbons and braid; pins”

54. The Applicant submitted photographs (and some samples during the hearing) of certain hair accessories sold under the subject mark with a view to showing that the mark has acquired factual distinctiveness in respect of “ribbons and braid”. The launch date of these items dated back to July 2001. The hair accessories produced are commonly referred to as “scrunchie”. As a matter of fact, this is also the description used in the product category annexed as “Exhibit C” to the Statutory Declaration of Claude Sorbello.
55. “Ribbon” is defined as a narrow strip of fine material, especially silk used for trimming, tying etc. “Braid” is defined as a length of hair, fabric, etc. that has been braided. To “braid” is to interweave several strands of hair or threads etc.⁵
56. Scrunchie is a type of hair accessory. It is an elasticized fabric ring used chiefly by ladies for gathering or fastening the hair.
57. Ribbons and scrunchie can both be used as hair accessories but they are different in appearance and presentation. I am not satisfied that factual distinctiveness of the subject mark has been established for “ribbons” based on the evidence submitted.
58. However, as some of the hair accessories are in the form of interwoven strands, I am satisfied that factual distinctiveness of the mark has been established for “braid”.
59. In relation to “pins”⁶, I could not find any evidence showing use of the mark in respect of this item. Factual distinctiveness of the mark has not been established for “pins”.

⁵ Extracted from Collins English Dictionary

⁶ The meaning of the term is set out in paragraph 51 above.

Conclusion

60. On a prima facie case, the subject mark was found to consist exclusively of a sign which served to designate the characteristics of goods and was devoid of any distinctive character under section 11(1)(b) and (c) of the Ordinance in relation to goods proposed to be registered in classes 3, 16 and 26.

Class 3

61. The application for amendment of specification of goods insofar as it seeks to add “cotton stick, wet wipes, impregnated tissues” to the original specification is hereby disallowed.
62. I am not satisfied from the evidence available that the mark has in fact acquired a distinctiveness character for the purpose of section 11(2) of the Ordinance in respect of “cosmetics”. The requirements for registration are not met and I therefore refuse this application in respect of “cosmetics” under section 42(4)(b) of the Ordinance
63. However, the Applicant was able to show that the mark has acquired a distinctive character in respect of “bleaching preparations and other substances for laundry use; cleaning, scouring and abrasive preparations, soaps, hair lotions”. I am satisfied that the requirements for registration are met in respect of these goods.

Class 16

64. The application for amendment of specification of goods insofar as it seeks to add “cling film and diapers” to the original specification is hereby disallowed.
65. However, the Applicant was able to show that the mark has acquired a distinctive character in respect of “paper, cardboard and goods made from these materials, not included in other classes; stationery; adhesives for stationery or household purpose; artists’ materials; office requisites (except furniture); plastic materials for packaging (not included in other classes)”. Therefore, the requirements for registration are met in respect of these goods.

Class 26

66. The application for amendment of specification of goods insofar as it seeks to add “hair clips” to the original specification is hereby disallowed.
67. I am not satisfied from the evidence available that the mark has acquired a distinctive character for the purpose of section 11(2) of the Ordinance in respect of “ribbons” and “pins”. The requirements for registration are not met and I therefore refuse this application in respect of “ribbons” and “pins” under section 42(4)(b) of the Ordinance
68. However, the Applicant was able to show that the mark has acquired a distinctive character in respect of “braid”. The requirements for registration are met for this item of goods.

Amendments to specification of goods required

69. The application in classes 3, 16 and 26 in respect of goods set out in paragraphs 63, 65 and 68 could proceed to publication provided that the Applicant files, on or before 13 June 2005, an amendment on Form T5A to amend the specification of goods in each of the above classes. The amended specification should only contain goods in respect of which the requirements for registration are satisfied (see paragraphs 63, 65 and 68 above). If the Applicant fails to do so on or before the above date, it shall be deemed to have abandoned this application.

Maria K. Ng
For Registrar of Trade Marks

12 May 2005

Schedule

<u>Application No.</u>	<u>Trade Mark</u>	<u>Class</u>
12625/2002		3
12626/2002		5
12627/2002		6
12628/2002		9
12631/2002		16
12633/2002		20
12635/2002		25
12636/2002		26
12638/2002		29
12639/2002		30
12640/2002		31
12641/2002		32