

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300106460
APPLICANT : HUDSON HIGHLAND GROUP, INC.
CLASS : 35
MARK : 2ND OPINION

STATEMENT OF REASONS FOR DECISION

Background

1. On 5 November 2003, Hudson Highland Group, Inc. of Chicago, U.S.A., applied to register the mark '2ND OPINION' in respect of 'employee skills assessment services' in Class 35 under the Trade Marks Ordinance ('the Ordinance').
2. During the examination stage, objections were raised under section 11(1)(b) and (c) of the Ordinance.
3. The applicant called for a hearing which took place on 24 January 2005. Mr Henry Wheare of Messrs Lovells appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
4. The applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The Trade Marks Ordinance

5. Section 11(1) of the Ordinance is 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) ...

The applicant's submissions

6. Mr Wheare made oral and written submissions (including a statutory declaration

dated 24 January 2005 ('the S.D.)) at the hearing. The following decided cases were cited:

- (a) 'EUROCOOL' (Case T-34/00) (Court of First Instance of the European Communities);
- (b) 'BABY-DRY' (Case C-383/99P) (European Court of Justice).

Decision

7. The subject mark is the combination of '2ND' and the word 'OPINION'. Although Mr Wheare argued that '2ND' could be seen as the combination of the numeral '2' and the capital letters 'ND', it is most likely to be perceived by the public as meaning '2ND' or 'SECOND'. The presence of the word 'OPINION' in the mark adds to the likelihood of such a perception as 'SECOND OPINION' is a recognisable term.
8. The term 'SECOND OPINION' refers to an opinion by another person. It is often used in the context of obtaining professional opinions, e.g. obtaining a second opinion from another medical or legal practitioner.
9. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate characteristics of the goods or services in respect of which registration is sought.
10. The applied for services are 'employee skills assessment services'. According to Mr Wheare, these are services to help employers select the right employees by assessing their skills, knowledge, abilities and personal attributes, and they involve evaluation of an employee's competence by means of testing. The first page of Exhibit D to the S.D., which is a printout from the applicant's website, also provides information on the services provided by the applicant. It indicates that these services include helping organizations make fully informed hiring, promotion and development decisions.
11. The term 'employee skills assessment services' is sufficiently wide to cover services that involve testing and evaluating employees or potential employees of their competence and suitability, and providing professional opinion to employers for the purpose of employee selection or human resources management. In situations where an employer has an initial opinion about an employee's competence or suitability, and it obtains a professional, independent opinion from another person, such an opinion can be aptly described as a 'second opinion'. 'Second opinion' is therefore an apt term to describe a characteristic of 'employee skills assessment services', i.e. the provision of a second opinion on an employee's competence or suitability.
12. Searches conducted on the Internet support the above assessment. Prior to the hearing the applicant's attention was drawn to a number of websites. These websites show descriptive use of the term 'second opinion' in the context of employment-related

services by undertakings other than the applicant.

13. Mr Wheare, relying on the '*BABY-DRY*' case, submitted that '2ND OPINION' was not the normal way of referring to employee skills assessment services or their essential characteristics in common parlance. In that case, the European Court of Justice ('ECJ') expressed its views on the interpretation of Article 7(1)(c) of Council Regulation (EC) No. 40/94 ('the Regulation'), which is broadly similar to section 11(1)(c) of the Ordinance.
14. Subsequent to the '*BABY-DRY*' case, the ECJ clarified the approach to Article 7(1)(c) of the Regulation in cases such as *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) (the '*DOUBLEMINT*' case) and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) (the '*Postkantoor*' case). The latter case is mainly concerned with Article 3(1)(c) of the First Council Directive 89/104/EEC but it is directly relevant as the two Articles are effectively identical. The relevant principles are as follows:

'In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.': the '*DOUBLEMINT*' case at paragraph 32.

'For the purposes of determining whether Article 3(1)(c) of the [First Council Directive 89/104/EEC] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.': the '*Postkantoor*' case at paragraph 104.

15. These principles indicate that marks that are objectionable under Article 7(1)(c) of the Regulation do not have to be the 'normal way' of describing the applied for goods or services, nor is it necessary for the relevant characteristic of the goods or services to be commercially essential. Mr Wheare's submissions therefore do not assist.
16. For the above reasons my assessment is that the subject mark consists exclusively of signs which may serve, in trade or business, to designate a characteristic of the applied for services, and the mark is therefore precluded from registration by section 11(1)(c) of the Ordinance.

17. Having found that the subject mark is precluded from registration by section 11(1)(c), it is not necessary for me to consider other grounds of refusal under the Ordinance. But for completeness I will go on to determine the application under section 11(1)(b) of the Ordinance.
18. Section 11(1)(b) precludes from registration signs which are devoid of any distinctive character. For a mark to possess the relevant distinctive character within the meaning of this provision it must serve to identify the applied for goods or services as originating from a particular undertaking. Such distinctive character is to be assessed by reference to the goods or services in respect of which registration is sought, and from the perspective of reasonably well informed and circumspect consumers of those goods or services (*Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2).
19. Mr Wheare submitted that a mark's allusion to certain features of the services in question is not sufficient to justify a refusal, and he referred to paragraph 43 of the '*EUROCOOL*' case in support of his argument. However, the Court's observations on 'allusive' marks must be read in conjunction with the rest of that paragraph, i.e. absolute ground for refusal under Article 7(1)(b) of the Regulation (which is equivalent to section 11(1)(b) of the Ordinance) would be justified if 'a sign, looked at as a whole, would not enable the section of the public targeted to distinguish the applicant's services from those of other competitors'. It is clear from '*EUROCOOL*' and '*Have a Break*' that the assessment of a mark's distinctive character is primarily concerned with the perception of the relevant consumers, rather than the 'allusiveness' of the mark. Mr Wheare's submission therefore does not add anything to the principles stated in '*Have a Break*'.
20. The relevant consumers of 'employee skills assessment services' are likely to be businesses or traders at large who employ people. Without first being educated that the subject mark is intended and used as a badge of trade origin, such consumers are likely to perceive it merely as a description of employee skills assessment services – that the applicant assesses skills of employees and gives second opinions to employers. As the mark is equally applicable as a description for similar services of other undertakings, it would not enable the relevant consumers to distinguish the applicant's services from other similar services.
21. My conclusion is that the subject mark is unlikely to be perceived by the relevant consumers as an indication of trade origin of the applied for services, and it is therefore devoid of any distinctive character.
22. Mr Wheare submitted that registration of the subject mark would not confer a monopoly to the applicant as third parties could continue to use the phrase 'second opinion' in a descriptive manner. This submission does not assist the applicant, as the 'existence of possible reasons for non-infringement does not have the positive effect of making it unnecessary to determine whether the conditions for registration are satisfied in the first place': '*Cycling Is ...*' *Trade Mark Applications* [2002] R.P.C. 37

at paragraph 41.

23. Mr Wheare referred to acceptances of the same mark in other jurisdictions such as Canada, United States, Australia and Singapore. I have considered these registrations but as I am not aware of the reasons for these acceptances and there are valid grounds of objections under the Ordinance, I am not persuaded that the subject mark should be accepted merely on the basis of these overseas acceptances.
24. Mr Wheare also referred to some registered marks in the UK and Hong Kong which are said to be similar. I do not find these marks comparable and in any event comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration: see *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 305.

Conclusion

25. In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application. For the reasons given I refuse the application under section 42(4)(b) as the mark is excluded from registration by section 11(1)(b) and (c) of the Ordinance.

Andy Lau
for Registrar of Trade Marks

20 April, 2005