

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. 300128529
MARK: Life made easier
APPLICANT: NEW YORK LIFE INSURANCE COMPANY
CLASS: 36

STATEMENT OF REASONS FOR DECISION

Background

1. Application to register the mark “Life made easier” in Class 36 under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) was received by the Registry on 17 December 2003. The applicant of the mark is New York Life Insurance Company.
2. The specification of services are: life and health insurance and annuity underwriting services; financial analysis and consultancy services; financial planning services; financial information services; insurance brokerage services; financial management services; insurance consulting services; investment advisory services; mutual fund investment services; mutual fund distribution; fund investment consultation; investment management.
3. The trade mark application was examined in accordance with the provisions of the Ordinance. Objection was raised by the Registrar under section 11(1)(b) of the Ordinance by his letter dated 27 January 2004.
4. The applicant maintained that the mark was inherently distinctive. At the same time, a statutory declaration made by Mr. Dennis Gagnon on behalf of the applicant was filed on 21 July 2004 with a view to showing that the mark had in fact acquired a distinctive character as a result of the use made of it for the purpose of section 11(2) of the Ordinance.
5. The Registrar was not satisfied from the evidence filed that the mark had acquired factual distinctiveness for the purpose of section 11(2). The mark was only used for a short period before the filing of the application for registration. Furthermore, it was invariably used with other more distinctive marks of the applicant and often, together with other advertising slogans. The Registrar considered that the mark had not been used in a manner that would educate the public to recognise it as a badge of origin.
6. The applicant requested a hearing which took place on 8 February 2005. The applicant was represented by Mr. Anthony Evans of Robin Bridge & John Liu. I reserved my decision at the end of the hearing.

The relevant laws

7. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1) provides:

“(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)”

8. Notwithstanding the prohibitions against registration set out in section 11(1)(b), (c) and (d), 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.”

The applicant’s submissions

9. At the hearing, Mr. Evans made submissions in relation to both the inherent distinctiveness and acquired distinctiveness of the mark. He took the stance that the mark was inherently distinctive. Evidence of use was filed by the applicant for the sake of completeness and not because it regarded the mark as indistinctive without use.

Inherent distinctiveness

10. Mr. Evans submitted that as no objection was raised under section 11(1)(c) of the Ordinance, he would only deal with the Registrar’s objection under section 11(1)(b).

11. The case put forward for registration based on inherent distinctiveness could be summarised as follows:

(a) In assessing distinctiveness, the Registrar should consider the mark from the perspective of the average consumer of the relevant services. The average consumer’s level of attention and circumspection must be necessarily higher when it comes to selection of insurance, financial and other monetary services. Therefore, it is unlikely that they would regard the mark as merely an advertising statement. Rather, they would pay close attention and would regard the mark as a badge of origin. Consumers would not be so gullible as to be swayed by the literal meaning of the mark into acquiring the services.

- (b) The distinctiveness of a mark must be presumed unless it is disapproved.¹
- (c) As no objection was raised under section 11(1)(c), the mark was not descriptive of or related to the applied-for services. Therefore, it should be regarded as inherently registrable.
- (d) Possessing a promotional function should be viewed as a positive property of a trade mark. The fact that a mark has promotional function does not make it non-distinctive.²
- (e) It would not be appropriate to apply to slogans criteria that were stricter than other types of mark. Slogans that were previously accepted for registration by the Registrar were cited in support of the subject application for registration.

Acquired distinctiveness

- 12. Mr. Evans submitted that the evidence filed showed substantial use of the mark and demonstrated that the mark has become even more distinctive through use. The mark has been used as a trade mark and not merely as some form of descriptive reference to insurance services in advertisements. It appeared in a different script and in a different size of lettering when compared with other words in the advertisements. An average consumer would be more likely to recognise the mark as denoting trade origin.
- 13. The fact that the mark was always used together with other marks of the applicant was not relevant in determining whether, in actual use, the mark was capable of carrying out a branding function.
- 14. The UK Court of Appeal in *Nestle SA's Trade Mark Application (Have a Break)*³ referred to the European Court of Justice the question as to whether factual distinctiveness might be acquired following or in consequence of the use of a mark as part of or in conjunction with another mark. Mr. Evans submitted that as long as the mark concerned has been used in a trade mark manner, it did not matter whether the mark was used with or without another trade mark or other matter.

Decision

Inherent distinctiveness

- 15. I will, first of all, consider the inherent distinctiveness of the mark. The mark "Life made easier" is a slogan consisting of ordinary English words. It means that a person's life is made easier and simpler and he will have less worries or

¹ Trade Mark Law: a practical anatomy by Jeremy Philips, Chapter 4, p.88

² Clinique Laboratories Inc.'s Application [1999] E.T.M.R. 750

³ [2004] FSR 2

stress.

16. It should be made clear at the outset that a slogan is not objectionable in itself as a trade mark. I agree with Mr. Evans that the criteria for registration of a slogan are no stricter than other types of marks. Each slogan has to be assessed on its own merits in relation to the goods or services in question.
17. The mark has to be examined, *inter alia*, against the absolute grounds for refusal in section 11(1) of the Ordinance. The objection raised by the Registrar was that the mark was “devoid of any distinctive character” under section 11(1)(b).
18. The phrase “devoid of any distinctive character” has been subject to interpretation in a number of cases. In *British Sugar Plc v. James Robertson & Sons Ltd*⁴ Jacob. J. succinctly explained the phrase as follows:

“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?”
19. The meaning of “distinctiveness” was further explained by the Court of Appeal in the *Nestle SA’s Trade Mark Application (Have a Break)* after reviewing a number of recent authorities in UK and Europe. The test of “distinctiveness” was explained by the Vice-Chancellor in the following manner:

“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.”
20. Furthermore, the Court of Appeal agreed with the observation made by the hearing officer of the UK Registry that the reaction of the average consumer to a mark has to be assessed on the basis of normal and fair use of the mark in advertising the goods as well as on packaging.
21. Applying the above principles to the present application, I should consider the subject mark from the perspective of an average consumer of insurance and financial services who is reasonably well-informed, reasonably observant and circumspect. Such a consumer would be exposed to a wide range of advertising techniques used by service providers in promoting their products and services. He would be aware that catchy and exaggerated expressions are commonly employed by traders for advertising purposes. The question to ask for the purpose of the subject application is: would such a consumer perceive the subject mark as identifying that the relevant services originate from a particular undertaking? Putting the issue in a slightly different way, whether the

⁴ [1996] RPC 281

perception and recollections that the subject mark would trigger in the mind of consumers are likely to be origin specific or origin neutral⁵?

22. The phrase “Life made easier” conveys the message that the services provided could take care of consumers’ needs and make their lives easier. It is the kind of phrase that is apt for use in promoting a wide range of goods and services, especially those relating to the everyday lives of consumers.
23. In the context of the applied-for services, the phrase conveys a message to consumers that the applicant could take care of their financial needs. Through using the applicant’s services, consumers could lead easier lives. The phrase is apt for use by any financial services provider for promoting its services since it is a common desire of consumers to be able to lead easier lives through the use of such professional services.
24. In view of the above, I do not think that an average consumer with the qualities mentioned in paragraph 21 above would, on seeing the mark, regard it as identifying that the relevant services originate from a particular undertaking. Rather, upon seeing the mark, he would consider it as a mere promotional statement used for advertising purposes. In other words, the perceptions and recollections that the phrase would trigger in his mind are likely to be origin neutral. Using the words of Jacob J. in *British Sugar Plc v. James Robertson & Sons Ltd.*, the subject mark cannot do the job of distinguishing without first educating the public that it is a trade mark.
25. I agree with Mr. Evans there are marks which could serve as badges of origin and at the same time could be used for promotional purposes. These two characteristics are not mutually exclusive. The subject mark is certainly apt for use for advertising purposes. However, for the reasons discussed above, I do not consider that it would be perceived by consumers as a guarantee of trade origin based on the prima facie case.
26. Mr. Evans submitted that since no objection was raised under section 11(1)(c), the mark was non-descriptive or unrelated to the services concerned and therefore should be regarded as inherently registrable. He appeared to suggest that if no objection was raised by the Registrar under section 11(1)(c), the mark should not be regarded as devoid of any distinctive character under section 11(1)(b).
27. A similar argument was advanced by counsel for Nestle in *Nestle SA’s Trade Mark Application*. The Vice-Chancellor rejected the argument in the following terms:

“The two grounds, although they no doubt overlap to some extent, are independent grounds for refusing registration. They have to be separately examined and considered. A mark may not be exclusively descriptive of the relevant goods or services and so not fall foul of [section 11(1)(c)], but it may nevertheless be “devoid of any distinctive character” and so fall foul

⁵ Telewest Communication Plc’s Trade Mark Application [2003] RPC 26, at p. 496

of [section 11(1)(b)].”

28. It may be true that the average consumer’s level of attention and circumspection would be higher when it comes to selection of insurance, investment and financial services (paragraph 11(a) above). Even if that is the case, I do not agree that as a result of the caution taken, consumers would regard the subject mark as a badge of origin. On the contrary, being a statement that is apt for promotion of a wide variety of services, it is likely that consumers would perceive the phrase as a mere promotional statement. When considering an objection under section 11(1)(b), it is irrelevant whether consumers would be swayed by the mark into acquiring the services concerned.
29. Mr. Evans submitted that the distinctiveness of a mark is presumed unless it is disapproved. However, he did not go further to elaborate on this statement or its ramifications in relation to the present application. I note from the authorities submitted during the hearing that the statement was extracted from the heading of a paragraph in *Trade Mark Law: a Practical Anatomy*. To understand the rationale and principles involved, I need to read the statement with reference to the paragraph that follows. The relevant paragraph is extracted below:

The modern trade mark registry operates more efficiently if decision-making and the exercise of discretion are limited to only those situations in which they are absolutely necessary and it should not therefore be necessary for trade mark applicants to vouch for the distinctive nature of their trade marks if that distinctive nature has not first been challenged. Ideally, an application to register a mark should be the first leg of a journey on an administrative conveyor belt which leads automatically from filing to grant unless some fault is detected in the application.”
30. The above paragraph appears to suggest that an applicant should not be required to prove the distinctive nature of its mark when it files an application for registration unless and until distinctiveness of the mark is challenged. This is in fact the position under the Ordinance. An applicant is only required to provide a representation of the mark together with certain prescribed particulars in its application for registration. The Registrar will then examine whether the application satisfies the requirements for registration under the Ordinance (including the prohibitions against registration in section 11). If it appears to the Registrar that the requirements for registration are met, he shall accept the application. On the other hand, if it appears to him that any of such requirements are not met, he will inform the applicant who could then file submissions to satisfy the Registrar that the requirements for registration are met. If the applicant fails to do that, the Registrar is required to refuse to accept the application under section 42(4) of the Ordinance.
31. In the present case, an objection was raised by the Registrar under section 11(1)(b) of the Ordinance. The applicant is now required to satisfy the Registrar that the requirements for registration are met before the application could proceed to registration.

32. Mr. Evans also mentioned a number of slogan marks that were accepted by the Registrar. He submitted that the subject mark should be in the same category as those marks that were previously accepted. I consider that some of the examples quoted are not on par with the subject mark. Furthermore, I do not think that it is appropriate to make direct comparisons between different marks on the register. Each case has to be considered on its merits. This issue has been discussed in *British Sugar Plc v. James Robertson & Sons Ltd* where Jacob. J. said:

“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, e.g. *MADAME Trade Mark* ([1966] RPC 541) and the same must be true under the 1994 Act.”

33. For the reasons discussed above, I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance based on the prima facie case.

Acquired distinctiveness

34. The applicant filed a statutory declaration made by Mr. Dennis Gagnon, its associate general counsel, with a view to showing that the subject mark has acquired distinctiveness as a result of the use made of it. The following points in the statutory declaration are relevant for the present purpose:

- (a) Use of the subject mark in Hong Kong commenced on 1st March 2003, less than 10 months before the date of filing of the application for registration. Such use has been maintained in Hong Kong since the above date.
- (b) Use of the mark was effected in Hong Kong through wholly-owned subsidiaries of the applicant. New York Life Worldwide Ltd. (“NYLW”) was the subsidiary which actually rendered services to the public in Hong Kong under the subject mark.
- (c) In the year 2003, NYLW issued 26,970 policies with total face value amounting to US\$ 2,465,000,000. This means that the average value of each policy is approximately US\$ 91,400 or HK\$ 713,000.
- (d) The applicant has promoted the subject mark primarily by means of advertisements. These consist of advertisements/billboards which appeared in the following places: (i) publications in Hong Kong; (ii) transportation vehicles including buses and trams; and (iii) rooftops of bus and tram stations. Samples of such advertisements were attached to the statutory declaration as exhibits.

35. The exhibits show that the advertisements contain the following main features:

- (a) The advertisements generally appeared against a white elongated rectangular background. The rectangular shape fits the exterior panels of trams as well as the rooftops of public transport stations. Advertisements

displayed on the exterior panels of buses were in T-shape.

- (b) Pictures of children with happy smiling faces appeared in most of the advertisements. These pictures occupied a prominent position in the advertisements.
 - (c) Advertising slogans were used in all the advertisements. These slogans include: “Shouldn’t life always be this worry-free?” and “Have you got a roadmap for life?”. These slogans were printed in blue and orange. They were printed in large fonts and were displayed horizontally across the centre of the advertisements.
 - (d) The logo of New York Life generally appeared at one end and sometimes at both ends of the advertisements. The logo consisted of a blue square with the words “New York Life” printed in white within the bounds of the square. The Chinese name of the applicant “紐約人壽” always appeared besides the logo.
 - (e) The subject mark was printed in orange and in considerably smaller font when compared with other slogans appearing in the advertisements. Its positioning in the advertisements was not consistent. In most cases, the mark appeared between the slogans and the logo of New York Life. Sometimes it was placed next to the applicant’s logo. On other occasions, it was placed close to the other slogans.
36. In addition, I would like to make the following observations from the evidence adduced by the applicant:
- (a) The evidence provided shows that the subject mark was used only on advertisements. However, such advertisements did not contain any information on the type or nature of services provided by the applicant. Putting the applicant’s case at its highest, one could imply from the logo of “New York Life” and “紐約人壽” that the applicant’s services relate to life insurance.
 - (b) Insofar as life insurance services are concerned, it is noted from Mr. Gagnon’s declaration that nearly 27,000 policies were written by NYLW in 2003. However, apart from the advertisements, there is no other documentary support to show that the subject mark was applied on insurance services. Evidence such as insurance policies, insurance proposals, letterheads, brochures or business cards were not produced in support.
 - (c) Information on the scale and extent of the advertising activities was not provided. Such information could include, for example, the amount spent on advertising, the length of time during which the advertisements were displayed.
37. In determining whether a mark has acquired factual distinctiveness, the crucial question is whether consumers have been educated to recognise the subject mark

as a badge of origin of the services concerned through the use made of it. As I have mentioned in paragraph 21 above, the consumers concerned are consumers of insurance and financial services who are reasonably well-informed, reasonably observant and circumspect.

38. Evidence submitted by the applicant showed that the subject mark always appeared in the same advertisement as the logo and the Chinese name of the applicant. This fact alone would not be conclusive when assessing whether the mark has acquired factual distinctiveness. Nevertheless, it is generally true that where a mark which is devoid of any distinctive character is always used together with other more distinctive housemarks, its impact on consumers would inevitably be diluted.
39. Considering the evidence as a whole, I am not satisfied that the relevant class of consumers have been sufficiently educated to recognise the subject mark as a guarantee of origin of the services set out in the specification for the following reasons.
 - (a) No evidence was adduced to show that the mark was applied on the services covered in the specification except, to a limited degree, life insurance services.
 - (b) Regarding use of the mark on life insurance services, the evidence submitted was indirect and inadequate.
 - (c) Information on the scale and extent of the advertising activities was not available.
 - (d) In a cosmopolitan city like Hong Kong where there is over-flooding of advertisements, consumers would inevitably pay attention only to the more prominent features in an advertisement. This is particularly the case where the advertisements are displayed on transportation vehicles which are travelling on the road most of the time. From samples of the advertisements provided, the more prominent features would include the pictures of the children, the advertising slogans in larger font as well as the distinctive logo of New York Life. It is likely that a substantial segment of the public would not notice the subject mark which was printed in smaller font and occupied a less conspicuous position in relation to the advertisement as a whole.
 - (e) Even assuming that consumers do make the effort of going through all the details in the advertisement, it is unlikely that they would regard the subject mark as an indicator of trade origin. Each of the advertisements started with a question which asked consumers whether they wish to lead a worry-free life or whether they have a direction in life. It then goes on to convey the message that consumers could lead an easier life if they choose the services of the applicant. Reading the subject mark in the context of the advertisements, it is likely that consumers would consider it as part of the slogans used in the advertisement. It would appear to consumers as a conjunction which connects the question to the provider of the services,

namely New York Life. The above impression would be even stronger in those advertisements where the subject mark was placed just next to the question or between the question and the logo of New York Life.

- (f) Notwithstanding that the number of policies written by NYLW over the 10-month period was fairly substantial, the mark has only been put on the market for a short period of time and was therefore unable to create sufficient impact on a significant proportion of consumers.
40. For the reasons discussed above, I am not satisfied that the subject mark has in fact acquired a distinctive character for the purpose of section 11(2) of the Ordinance based on the evidence provided by the applicant.

Conclusion

41. I have considered all documents filed by the applicant and the submissions made by Mr. Evans and the authorities submitted by him during the hearing. For the reasons stated above, I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance based on the prima facie case. Furthermore, I am not satisfied from the evidence filed by the applicant that the mark has in fact acquired a distinctive character for the purpose of section 11(2). I therefore refuse this application under section 42(4)(b) of the Ordinance.

Maria K. Ng
for Registrar of Trade Marks

10th March 2005