

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300190827



MARK:

CLASSES: 29, 30

APPLICANT: SHODA SHOYU KABUSHIKI KAISHA (SHODA SHOYU CO., LTD.)

STATEMENT OF REASONS FOR DECISIONS

Background

1. On 3 April 2004, Shoda Shoyu Kabushiki Kaisha (Shoda Shoyu Co., Ltd.) (the “applicant”) applied to register the mark “” under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”).
2. Registration is sought in Class 29 in respect of “soups; soup preparations” and in Class 30 in respect of “sauces; soy sauce; seasonings other than essential oil; salad dressings; mayonnaise”.
3. At the examination stage, objections were raised against the subject application under section 11(1)(b) and (c) of the Ordinance on the basis that the mark consists exclusively of a sign which may serve, in trade or business, to designate the kind, quality and characteristics of the applied-for goods and is devoid of any distinctive character.
4. On 24 March 2005, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 25 May 2005 at which Ms. Florence Lam of Messrs. Wilkinson & Grist appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.

The 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) ...
6. The applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The applicant's submissions

7. Ms. Lam's main submissions are summarized as follows:
- (a) The Chinese character “正” has many meanings, e.g. straight, upright, just, right and so on, so that it does not necessarily mean “正品” (certified products; quality products; certified goods) or “正貨” (unmixed / genuine goods), as raised by the examiner during examination. Ms. Lam seeks to rely on one registered trade mark no. 1999B08244 where the mark also consists of the character “正”, but on the register, the character is only translated as “upright”, but not “genuine” etc.
 - (b) The meaning of the character “正” would depend on the context. In the instant context of food products, the meaning of it would differ from person to person. To some persons, it may designate the characteristics of the goods, whereas to others, it may not.
 - (c) The transliteration of the applicant's name is “正田株式會社” so that the applicant has chosen the character “正” to incorporate into the mark so as to represent the applicant.

- (d) The Chinese character “正” in the mark is not represented in its ordinary typographical form, but in an artistic hand-written manner. In modern days, where goods are mass produced, descriptions on packaging or labels of goods are normally printed, but seldom hand-written as the character “正” in the mark is. When this artistically written character “正” is neatly encircled by the double-layered hexagonal frame, which consists of one thicker hexagon and another much thinner hexagon, the entire mark is far beyond a descriptive symbol and it does serve the essential function of assisting the relevant consumers to identify the trade origin of the applied-for goods.
- (e) Other traders in the field of soups and sauces will not naturally want to use the character “正” in relation to the applied-for goods, so that the acceptance of the subject mark for registration would not interfere with what other traders would reasonably want to do. The case of *‘I Can’t Believe It’s Yogurt’* [1992] RPC 533 is relied on. Furthermore, the word “正” is not the *most* natural word that people would want to use to describe the applied-for goods, including soups and sauces.
- (f) It has been a long practice all over the world for figures or letters to be used in combination with various kinds of “tortoise shell” to form new identities and therefore, registrable trade marks. The subject mark is one of the kinds.

8. The following decided cases were also cited in the written submissions:

- (a) *‘CHUNKY’* [1978] FSR 322; and
- (b) *‘ORANGE GROVE’* Re [1962] RPC 83

Decision

- 9. The mark consists of the Chinese character “正” centrally placed in an encircling “double-layered hexagonal frame” (in Ms. Lam’s words), the outer layer being thicker in black and the inner layer thinner in white.

Meaning of the word “正”

- 10. In the context of the applied-for goods, which are essentially food products, the

Chinese character “正” conveys the immediate message that those goods are of good quality, or are made with pure or quality ingredients. This is especially the case as the word “正” is commonly used in Hong Kong in the colloquial sense to mean “good” or “of quality. I find support from 廣洲話方言詞典 (商務印書局) (*Cantonese Dictionary (Commercial Press)*) where “正” in Cantonese is defined to mean “正斗”— 引申作好、美 (good); or “正嘢”— 好的東西; 質量高的東西 (good; of quality). The word “正” has indeed been commonly used either on its own (正) or in combination with other words (e.g. 正斗, 正嘢) in daily language to convey the message of “good” or “of quality”.

11. The dictionary meanings of “正” quoted by the examiner are in accord with my view. The quoted meanings are: “正品” (certified products; quality products; certified goods) and “正貨” (unmixed / genuine goods) (*Shanghai Jiaotong University Chinese-English Dictionary 上海交通大學漢英辭典*). In the context of the applied-for goods, therefore, the character “正” directly conveys a highly descriptive and laudatory message that those goods are good, of quality, or are certified products, quality products, or unmixed / genuine products.
12. Albeit “正” may have other meanings e.g. straight, upright..., *in the context of the applied-for goods*, the most direct, obvious and recognized meanings must be that those goods are good or of quality, or are high quality genuine products, as explained in paragraphs 10 & 11 above. In any event, the fact that the character “正” is also capable of having some other meanings is of little assistance. I borrow support from the ECJ case of ‘*DOUBLEMINT*’ (Case 191/01 P) where ECJ clarified the approach to Article 7(1)(c) of Council Regulation (EC) No. 40/94, which is broadly similar to section 11(1)(c) of the Ordinance. It was said at paragraph 32 of the decision: -

“In order for OHIM to refuse to register a trade mark... 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... 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” (emphasis added)

13. Ms. Lam’s submission in relation to the registered trade mark no. 1999B08244 has to be dismissed because the register does not intend to exhaustively list out all meanings that are capable to be borne by “正”.
14. Moreover, although the Chinese transliteration of the applicant’s name may be the reason behind the choice of word of “正” for the mark, given that the character “正” conveys such obvious meanings of “good”, “of quality” or “genuine” in respect of the applied-for goods as explained, the reason behind the choice of word averred cannot assist the subject application. Essentially, the assessment of registrability is not normally concerned with the reasons of choice of word or other elements in the trademark to be assessed.

The word “正” as an apt and appropriate word of description

15. In view of the aforesaid meanings of and the messages conveyed by the word “正”, I consider the word is an *apt and appropriate word* to describe and also to laud the quality of the applied-for goods. Being an apt and appropriate word of describing quality of goods, I take the view that other traders in the field of the applied-for goods may well desire to use it in describing the quality of their products. Therefore, contrary to Ms. Lam’s submissions, I do not find the word “正” is an “unnatural” word that other traders in the field would not reasonably want to use and the acceptance of the mark would not interfere with what they reasonably want to do with the word “正”.
16. In this regard, Ms. Lam argues that the internet references supplied to the applicant prior to the hearing cannot support that other traders are using the word “正” alone because they only show the use of the words “原廠正貨” or “正貨”, in respect of the applied-for goods, but not the word “正” on its own. Bearing in mind that the quoted internet references may not be exhaustive, I think the more crucial consideration is the effect of the word “正” alone. As previously discussed, the word “正” by itself can already convey the immediate message of good, of quality or genuine to the local population so that it remains in my view an apt word for use by other traders to describe their own products.
17. Ms. Lam further relies on the case of *‘I Can’t Believe It’s Yogurt’*. In this case, Robin Jacob, Esq., Q.C. held that the mark ‘I Can’t Believe It’s Yogurt’ was

marginally acceptable for “yogurt”, “yogurt products” etc., without evidence of use, because it was found that registration of the mark would not interfere with what other traders in yogurt would reasonably want to do. However, as explained in paragraph 15 above, the finding of no interference is absent from the instant case, and therefore, the case of *‘I Can’t Believe It’s Yogurt’* has to be distinguished. The case can further be distinguished on the connected basis that the mark ‘I Can’t Believe It’s Yogurt’ does not directly describe the quality of the relevant applied-for goods, whereas in the instant case, the reference of the word “IE” in the mark to the quality of the applied-for goods is most direct and as such, the word “IE” is apt for use by other traders.

18. As regards Ms Lam’s further argument that the word “IE” is not the *most* natural word that people would want to use to describe the applied-for goods, I take her as suggesting that there are in fact some other terms *more* apt for describing the applied-for goods. However, this does not assist the subject application either. The relevant principles are laid down in the *‘Postkantoor’* case (Case C-363/99), which concerns Article 3(1)(c) of the First Council Directive 89/104/EEC, broadly similar to section 11(1)(c) of the Ordinance. It was said at paragraph 104 of the decision: -

“For the purpose 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.” (*emphasis added*)

19. In the circumstances, I conclude that the word “IE” is an apt and appropriate word to describe the quality of the applied-for goods, and it is not an unnatural word that people or traders in the field would not wish to use to describe their goods. The fact that the word is apt to be used by people and traders in the field to describe the goods would certainly have a bearing on the consumers’ perception of the mark to which I will shortly turn.

Section 11(1)(b) of the Ordinance

20. This section precludes from registration marks which are devoid of any

distinctive character.

21. As Ms. Lam submits, the relevant principles relating to distinctive character was laid down in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281, where Jacob J said at 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?”

22. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at para. 23):

“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.”

23. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must serve as a badge of origin to identify the goods or services as originating from a single undertaking, and thus distinguishing them from those of other undertakings, and I must assess such distinctiveness in relation to the goods or services for which registration is sought taking into account the presumed perception of the relevant consumers.
24. In assessing the presumed perception of the relevant consumers, I have to take into account that average consumers normally perceive a mark as a whole and do not proceed to analyse its various details. In order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (*Mag Instrument Inc. v OHIM*, Case C-136/02).

Relevant consumers' perception

25. In the present case, the relevant consumers are members of the general purchasing public who are likely to buy everyday products such as the applied-for goods.
26. Although the Chinese character “正” may not be represented in a strictly typographical form, its representation is still only a plain and ordinary one.

It appears that it is hand-written by a Chinese writing brush. Given that there are currently a number of Chinese typefaces available for use in the marketplace which are in similar Chinese writing styles, such a representation does not appear to be uncommon or special. In any event, the character “正” can still be clearly seen and identified, falling short of fancifulness. It can still clearly convey the laudatory message of good, of quality or genuine in respect of the applied-for goods, such as soups and sauces.

27. As the word “正” is highly descriptive of the applied-for goods, thus pointing strongly away from the mark being a trademark, the double-layered hexagonal frame of the mark must point *strongly* towards the mark as a whole being a trademark before the mark can be regarded as a badge of origin. The question to consider is whether it gives the mark sufficient ‘surplus’ to outweigh the descriptiveness of the word “正” so that when the word is placed inside it and the mark considered as a whole, the mark is likely (or unlikely) to be taken as a badge of origin without first educating the public.
28. In my view, the double-layered hexagonal frame is not sufficiently embellished so as to give the mark sufficient ‘surplus’ to outweigh the highly descriptive connotation given by the word “正” for the mark to be taken as a badge of origin. In addition, the word “正” is centrally and prominently placed in the mark so that it becomes the immediately striking feature of the mark, instead of the double-layered hexagonal frame.
29. The relevant consumers, upon seeing the mark in relation to the applied-for goods on first impressions, are likely to have their attention immediately caught by the Chinese word “正”, which is a striking and prominent feature of the mark, and perceive it as conveying the direct laudatory message that the goods are good, of quality, or are high quality genuine goods. This is particularly the case as the word “正” is an apt and appropriate word for describing quality of goods. Although the hexagonal frame is also clearly visible, it cannot dilute the laudatory message conveyed by the word “正”. In any event, the consumers will not proceed to analyse the details of the mark. Their overall impression of the mark is likely to be “正” only and such impression is origin neutral. Without first being educated, they are unlikely to take the mark as a badge of origin of the applied-for goods. As the mark does not serve to assist the relevant consumers in distinguishing the applicant’s goods from those of others, it is considered to be devoid of any distinctive character.

“Tortoise shell”

30. For completeness’ sake, I should also mention that Ms. Lam submits that the double-layered hexagonal frame is a “tortoise shell” so that when combined

with the character “正”, a new identity is formed, which is registrable as a trademark. However, she concedes that there is no authority backing her submission. To my mind, whether or not the hexagonal frame can be taken as a tortoise shell by name, in the subject mark, it does not outweigh the descriptive and laudatory element of “正”, and it does not confer any distinctive character or trade mark significance on the mark as a whole.

Devoid of distinctive character

31. For the reasons above, the mark is devoid of any distinctive character in respect of the applied-for goods and is accordingly precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

32. This section precludes from registration 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 the applied-for goods or services.
33. In the subject application, the mark consists of the Chinese character “正” and the encircling double-layered hexagonal frame, and registration is sought for “soups; soup preparations” in Class 29 and “sauces; soy sauce; seasonings other than essential oil; salad dressings; mayonnaise” in Class 30.
34. There is no doubt that the Chinese character “正” in the mark has highly descriptive connotation as to the quality of the applied-for goods as discussed above. As the hexagonal frame is clearly visible and it may not be disparaged as a simple border like the more ordinary circular or oval ones, I have to also consider whether it also serves to designate the kind, quality... or other characteristics of the applied-for goods, and in my view, it does not. Since the wording of section 11(1)(c) requires the mark to consist *exclusively* of signs which may serve to designate the kind, quality... or other characteristics of the applied-for goods, taking the double-layered hexagonal frame into account, I have difficulty in concluding that the mark falls foul of section 11(1)(c) as well.
35. Therefore, I hereby waive the objection raised under section 11(1)(c) of the Ordinance.

Other authorities

36. At the hearing, Ms. Lam submits that ‘*CHUNKY*’ and ‘*ORANGE GROVE*’ cannot assist the subject application and she no longer relies on these cases. Therefore, I leave them for another day.

Overseas registrations

37. Ms. Lam explains that the subject mark is accepted for registration for similar goods in Classes 29 & 30 in Singapore on a *prima facie* basis. Copies of the registration certificates are produced at the hearing.
38. I have considered these overseas registrations. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other jurisdictions is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). In the instant case, as I have found valid reasons for refusing the subject application, I am not prepared to follow the decisions of another registry. This is especially so when the reasons and rationale behind the acceptances are not available before me.

Conclusion

39. In this decision, I have considered all the documents filed by the applicant, together with all oral and written submissions made in respect of the subject application. For the reasons stated above, I find that the subject mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.

Doreen Wan
For Registrar of Trade Marks
8 August, 2005