

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300232532

MARK: FROM GREAT PEOPLE TO GREAT PERFORMANCE

APPLICANT: HUDSON HIGHLAND GROUP, INC.

CLASSES: 35, 41

STATEMENT OF REASONS FOR DECISION

Background

1. On 14 June 2004, Hudson Highland Group, Inc. (“the applicant”) applied to register the mark “FROM GREAT PEOPLE TO GREAT PERFORMANCE” in classes 35 and 41 (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) in relation to the following services:

Class 35: employment hiring, recruiting, placement, and staffing services; human resources consulting; business management consulting; business networking; employment and recruitment services including human resources consulting and personnel location, selection, recruitment, placement, hiring and administration; services relating to the collection of curriculum vitae; services relating to the provision of information to prospective employers on the worldwide web in relation to employment and recruitment; advertising and business services including advertising booking, production services, direct mail advertising; radio and television advertising; television commercials; management assistant services; appraisals in business, management and organisation; business research; market research services; market studies services; compilation, presentation and publication of statistical information; consultancy, advisory and information services related to the foregoing.

Class 41: educational services, namely, conducting training programs, seminars, lectures, conferences, and workshops in the field of diversity and distributing course materials in connection therewith; education and provision of training relating to employment and recruitment services including human resources consulting and personnel location, selection, recruitment, placement, hiring and administration; publication services relating to advertising, marketing and market research services; publication services relating to publication of printed matter in the fields of business

management, business networking, human resources, and employment hiring, recruiting, staffing, and placement; consultancy, advisory and information services related to the foregoing.

2. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance in respect of the entire classes of 35 and 41 on the basis that the subject mark consists of a sign that is devoid of any distinctive character in respect of the applied for services.
3. On 11 July 2005, the request for a hearing on the registrability of the subject mark made by Messrs Lovells on behalf of the applicant was received by the Registry.
4. The hearing took place before me on 6 September 2005 at which Mr. Andre Pohlmann of Messrs Lovells appeared on behalf of the applicant. The applicant did not file evidence of use of the subject mark and I therefore have only the *prima facie* case to consider. I reserved my decision at the conclusion of the hearing.

The Ordinance

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

Decision

Section 11(1)(b) of the Ordinance

6. The subject mark is a slogan comprising ordinary English words “FROM GREAT PEOPLE TO GREAT PERFORMANCE”. The words are so common that no dictionary definitions are necessary. There is no stylisation

of the subject mark or any other additional element. As a whole, the subject mark conveys the immediate message of great staff and great services in the context of the services applied for.

7. In this application I have to consider whether the subject mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance.
8. Section 11(1)(b) of the Ordinance excludes from registration marks which are devoid of any distinctive character.
9. The approach of assessing distinctiveness was discussed in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 where Jacob J said, on 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?”

10. The test of registrability under the equivalent of section 11(1)(b) of the Ordinance was further discussed in *Nestlé SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at paragraph 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.”

11. A slogan is not objectionable in itself as a trade mark. In addition, there is nothing in the Ordinance which suggests that slogans should be treated differently from other types of marks. I agree with Mr. Pohlmann's reference to the case “*Das Prinzip der Bequemlichkeit*” (Case C-64/02P) (European Court of Justice) and his submission that no different or stricter criterion must be imposed for assessing the distinctiveness of trade marks consisting of advertising slogans. Accordingly the same test for assessing distinctiveness applies to slogan marks as it does other types of marks. Each slogan will be assessed on its own merits in relation to the goods or services in question.
12. Applying the above legal principles, I must assess the distinctiveness of the

subject mark in relation to the specified services for which the applicant seeks registration in classes 35 and 41. I must also have regard to how the subject mark is likely to be perceived by a consumer who is reasonably well-informed and reasonably observant and circumspect. On this assessment I must assume fair and normal use of the subject mark in relation to the provision of services applied for.

13. In the present case, the application covers mainly a range of services in relation to human resources, advertising and marketing research in class 35 and education/training and publication services in relation to human resources, advertising and marketing research in class 41.
14. The relevant customers of the applicant may include clients seeking human resources services, staff training, advertising, or other business services. They are likely to come across the subject mark in advertisements, promotional materials or websites for promoting the services of the applicant. They would be aware that catchy and exaggerated expressions are commonly employed by traders for advertising purposes.
15. The slogan “FROM GREAT PEOPLE TO GREAT PERFORMANCE” is composed of commonplace words. On first impression, the words “GREAT PEOPLE” and “GREAT PERFORMANCE” stand out from the subject mark. The element “GREAT” is laudatory for the sake of advertising. The subject mark as a whole is likely to be seen immediately by the relevant customers as meaning great staff and great performance of the applicant. The use of the phrase “from..... to.....” merely reinforces the idea that the applicant has great staff and hence is able to deliver great services. The subject mark is the kind of phrase that is apt for use in the promotion of a wide variety of services. In the context of services such as human resources in class 35, the phrase conveys the immediate message that the applicant is able to recruit good employees for the better performance of their customers. Furthermore, in relation to the services in class 41 such as educational and training services, the subject mark is likely to be perceived by the average consumers as meaning that the applicant’s services will enable people of high calibre to achieve great performances or that the great staff of the applicant will be able to help people to achieve great performances.
16. I also note Mr. Pohlmann’s submission on the possible meanings of the subject mark. For instance, the subject mark could be interpreted, in respect of class 35 services, to mean that the applicant would provide people of high calibre who would lead the employer to perform well or that the applicant will provide candidates of high calibre who will perform well. He also submitted that in respect of class 41 services the subject mark could be interpreted as

meaning that the applicant's employees are of high calibre and would deliver high quality services or that people utilising the applicant's services are of a high calibre and would be able to perform well through the applicant's services.

17. It is apparent from the above that even though different customers may perceive slightly different meanings for the subject mark, their overall impression on the subject mark is a laudatory statement rather than an indication of trade origin. In other words, the subject mark is likely to be immediately perceived by the relevant consumers as an indistinctive promotional statement of the services offered, not as a mark indicating the undertaking from which they come. The subject mark is one that an average consumer is likely to see as an origin neutral promotional statement in respect of the applied for services, without first being educated that the mark is intended to be a badge of trade origin. The subject mark is therefore devoid of any distinctive character and would not perform the essential function of indicating the trade origin of the services in question.
18. Relying on paragraphs 13-17 in the case of "*VALUE THROUGH PEOPLE*" (Case R 853/1999-3) (Office for Harmonization in the Internal Market (Third Board of Appeal), Mr. Pohlmann submitted that the subject mark is registrable as its meaning is vague, ambiguous and is open for interpretation. Mr. Pohlmann pointed out that the connection between "great people" and "great performance" is not clear and there is no definite meaning of the subject mark. He further claimed that the subject mark could be unconnected with the applicant's services. For example it could be used to refer to a man in the street or people of one country, race or community only. Mr. Pohlmann argued that any meaning of the subject mark could only be perceived by the customers with mental effort and the subject mark is not likely to be perceived by the customers easily as a promotional statement.
19. I disagree with Mr. Pohlmann's arguments. The crux of the test under section 11(1)(b) of the Ordinance is whether the relevant consumers will perceive the subject mark as a badge of trade origin. Although the subject mark may carry more than one meaning, the overall impression is that the subject mark is laudatory in respect of the applicant's services as explained in paragraphs 15 to 17 above. Taking into account the laudatory meanings of the slogan and the nature of the services at issue, I therefore consider the message conveyed by the subject mark to be readily apparent to the average customers of such services as one for mere promotional purposes only, and not as a sign indicating an origin of trade. The mere vagueness of its meaning is not sufficient to confer a distinctive character on the subject mark.

20. Mr. Pohlmann also referred me to Internet searches of the subject mark showing that there is no indication that the mark is used by someone else other than the applicant. Mr. Pohlmann went on to claim that the subject mark is therefore unique and has distinctive character. No doubt, Internet searches could assist in ascertaining whether a mark/an expression is commonly used in the trade. However, the fact that a particular mark is not currently used by other traders does not necessarily demonstrate that the mark possesses distinctive character. The crux of the matter is whether the mark would be seen by the average consumers as a badge of origin in the context of the goods or services. For the reasons discussed above, I do not consider that the subject mark could serve this purpose unless consumers are first educated of its function through the use of the mark.
21. Based on the reasons stated above, I am of the view that the relevant consumers are unlikely to perceive immediately the subject mark as an indication of trade origin of the applied for services and the subject mark is therefore devoid of any distinctive character in the services applied for. The subject mark is thus precluded from registration under section 11(1)(b) of the Ordinance.

Other issues

22. Mr. Pohlmann referred me to a number of slogans that were accepted for registration by the Registrar based on a *prima facie* case such as “SEARCH PERFORMANCE”, “THE PEOPLE BEHIND THE PROMISE” and “UNITING PEOPLE WITH POSSIBILITIES”. He also relied on the acceptance of the subject mark in other jurisdictions such as the USA, Canada and the European Union. He found the fact that OHIM, which he claimed to have a conservative approach regarding registrability of slogans, considered the subject mark as inherently distinctive supported the view that the subject mark should be regarded apt for registration in Hong Kong. Mr. Pohlmann further quoted the registration of other slogan marks in other jurisdictions. For example, he relied on the result of the case “*Das Prinzip der Bequemlichkeit*” (Case T-138/00) (Court of First Instance of the European Communities) and claimed that the mark in that case was also vague but was not considered to be devoid of any distinctive character under the equivalent of section 11(1)(b) of the Ordinance.

23. I have considered these local and overseas registrations but do not find them of assistance to this application. The fact that a mark is registered in other jurisdictions does not necessarily mean that it is distinctive. It must be borne in mind that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885).
24. I also do not consider it appropriate to compare the subject mark with other slogan marks registered in Hong Kong or overseas. The registration of other slogan marks does not necessarily render the subject mark registrable. As mentioned in paragraph 11 above, each slogan must be dealt with on its own merits and the individual circumstances of each application are of paramount importance in deciding the registrability of a mark. In this application, I have found that the subject mark as a whole is likely to be perceived by the customers as an indistinctive advertising statement of the applicant's services and not as a sign indicating the applicant as the origin of trade. As there are valid grounds of objection under the Ordinance, I am not prepared to accept the subject mark merely on the basis of registrations of other slogan marks, especially when most of the other marks quoted are not laudatory and I am not aware of the circumstances surrounding their acceptance.
25. In respect of the Hong Kong registrations quoted, Mr. Pohlmann particularly submitted that Internet searches show more than 7,000 hits with the mark "UNITING PEOPLE WITH POSSIBILITIES" and more than 200 hits for the mark "THE PEOPLE BEHIND THE PROMISE". He was of the view that marks that have more hits in Internet searches are less unique and distinctive. Compared with the subject mark which has less than 200 hits in Internet searches, these two registered marks are considered by him as being less distinctive and unique than the subject mark. Mr. Pohlmann then claimed that if marks less unique and distinctive were accepted, the subject mark should also be registrable. I am not persuaded by this argument. As mentioned in paragraph 24 above, each case must be assessed on its own merits in any event. Furthermore, as mentioned in paragraph 20 in this decision, Internet searches are not conclusive as to whether a mark is distinctive. Comparison of the number of hits per se is therefore not of assistance.

Conclusion

26. In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application. On a *prima facie* basis, the subject mark as a whole was found to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the applied for services in class 35 and 41. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Sarah Li
for Registrar of Trade Marks
28 December 2005