

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300397099

MARK: WONDER

CLASSES: 2, 5, 29, 30, 32, 35, 43

APPLICANT: GRUPO BIMBO S.A. DE C.V.

STATEMENT OF REASONS FOR DECISIONS

Background

1. On 4 April 2005, Grupo Bimbo S.A. de C.V. (the “applicant”) applied to register the mark “WONDER” under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”).
2. Registration is sought in classes 2, 5, 29, 30, 32, 35 and 43. A full list of the specification is set out in *Annex 1*.
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 also devoid of any distinctive character.
4. On 7 March 2006, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 4 October 2006 at which Mr. Felix H.M. Pao, counsel, 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. Mr. Pao's main submissions are summarized as follows:

- (a) It is wrong for the Registrar to recite selectively some of the possible meanings of the word "wonder" as the basis of objection, without due consideration of the principles of English usage. The word "wonder" in proper English usage cannot be used as an adjective so that it cannot be descriptive of the applied-for goods and services. The adjectival form of "wonder" is either "wonderful" or "wondrous".
- (b) If the word "wonder" is to be taken as referable to physical objects and to carry the alleged descriptive meanings, articles like "a", "an", "the" or "this" have to be added to precede the word; however, the mark "wonder" does not consist of such articles. As such, Mr. Pao said that the mark does not carry any descriptive meaning and it is not even suggestive of the applied-for goods and services (*OHIM v WM Wrigley JR Company (Doublemint)* [2004] RPC 18 relied on). Mr. Pao said he is not aware of any authority that permits the Registrar to add words or other matters to a mark in assessing its registrability.
- (c) The applicant has registered the mark in Singapore in respect of the same goods and services. Other "wonder" marks registered by other proprietors in the UK (class 28), European Community (classes 1, 2, 3, 9, 11, 16, 17, 28) and Australia (9, 16, 17, 28) are also referred to.

Decision

Section 11(1)(c) of the Ordinance

8. 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.
9. The established test is that a sign must be refused registration if at least *one of its possible meanings* designates a characteristic of the goods or services concerned (*Doublemint* (supra) at paragraph 32).
10. The mark consists of a single word “WONDER” in plain block letters. As with many other words, “wonder” bears a range of possible meanings according to dictionaries. In the context of the applied-for goods and services, which are mainly everyday merchandise and certain other services, the most obvious and natural meanings of the word “wonder” are: “something marvelous”, “a miracle” or “extraordinarily good” (*Online Encarta World English Dictionary*). According to *Collins English Dictionary*, “wonder” can also be used as a ‘modifier’ referring to exciting wonder by virtue of spectacular results achieved, for example, a wonder drug.
11. In relation to the applied-for goods and services *such as* “paints” (class 2), “pharmaceutical preparations” (class 5), “meat, fish, poultry and game” (class 29), “coffee and tea” (class 30), “agricultural, horticultural and forestry products” (class 31), “beers” (class 32), “advertising” (class 35) and “services for providing food and drink” (class 43), the mark “WONDER” immediately conveys the descriptive and laudatory message that the goods and services provided are marvelous, extraordinarily good or of superb quality; or they are wonder paints, wonder pharmaceutical preparations... and so on.
12. Mr. Pao argued that the mark cannot be descriptive of the applied-for goods and services because the word “wonder” is not an adjective. Mr. Pao said that in common English usage the word “wonder” is used either as a noun or as a verb to mean “the state of mind of curiosity” (as a noun) or “think over, ponder and reflect” (as a verb); and the word is not and cannot be used as an adjective.

Mr. Pao referred me to two online dictionaries, *WordReference.com* and *Dictionary.com*, wherein the word “wonder” is only referred to as either a noun or a verb, but not an adjective.

13. I am not convinced by Mr. Pao’s argument that because a mark is not an adjective, it cannot be descriptive. While usage principles may give guidance to people on how a word is to be used “most properly”, I do not consider it right that in assessing the registrability of a mark, one must construe the mark in accordance with strict usage principles. Beside the usage principles, one has to consider the context in which the mark is used and to also consider it from the point of linguistic communication. The word “wonder” in the context of the applied-for goods and services unequivocally conveys the messages that the goods and services are “marvelous”, “extraordinarily good” or “of superb quality”; or they are wonder goods or wonder services. In so far as such messages are conveyed, the word “wonder” is adjectival, descriptive and laudatory in nature, even though it may not be widely recorded as an orthodox adjective as such.
14. I also bear in mind the ‘modifier’ usage as mentioned in the *Collins English Dictionary*. Examples of such usage are shown by a number of Internet references, which were provided by the examiner to the applicant during the examination stage on 7 December 2005. A list of the examples is provided in *Annex 2*. By way of example, the internet references speak of “A true **wonder product**”; “to promote milk as a **wonder substance...**”; “this **wonder tea** is especially useful...”; “one might imagine... every marketing man to be pushing the product as a **wonder beer**”; “I have a **wonder house** in a fantastic location in Leawood Kansas for lease or sale.” All these examples support that the word “wonder” can be used in an adjectival and descriptive sense and point to the fact it is apt to be and is used by traders to laud and describe a wide range of products, be it tea, beer, or any other products or services.
15. As said, it is well established that a sign must be refused registration if at least *one of its possible meanings* designates a characteristic of the goods or services concerned (*Doublemint* (supra) at paragraph 32). The mark “WONDER” is capable of meaning “something marvelous”, “a miracle” and “extraordinarily good”. When used in relation to the applied-for goods and services, it will immediately designate that the goods and services are marvelous, extraordinarily good or of superb quality, or are wonder goods or services.

The descriptive message is obvious even though as submitted by Mr. Pao, articles such as “a”, “an”, or “the” do not appear before the word “wonder”. In view of the descriptive message conveyed by the word “wonder” and the fact that there is no other element or stylization in the mark, the mark is considered to consist exclusively of a sign which may serve in trade or business to designate the quality and characteristics of the applied-for goods and services. The mark therefore falls foul of section 11(1)(c) of the Ordinance and must be refused registration.

Section 11(1)(b) of the Ordinance

16. This section precludes from registration marks which are devoid of any distinctive character. 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?”

17. 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.”

18. Bearing the above principles in mind, I find that “wonder” is a word that has very strong laudatory connotations. In relation to the applied-for goods and services, as said, the mark “WONDER” immediately conveys to consumers the message that the goods and services provided are marvelous, extraordinarily good or of superb quality; or they are wonder goods or wonder services. As a laudatory word of general use, “wonder” would facilitate use in advertising and promotional statements. It is also the kind of words that could easily spring to mind laudatory puffs.

19. That being the case, on first impression, average consumers are likely to simply

perceive the mark as lauding and describing the quality and characteristics of the applied-for goods and services, i.e. they are marvelous, extraordinarily good, of superb quality or are wonder goods and wonder services. Without first being educated that the mark is the applicant's trade mark, they are unlikely to perceive the same as identifying that such goods and services are originating from a particular undertaking.

20. Since the word "wonder" is also apt to be used by others to laud and describe a wide range of products, the mark also fails to assist consumers to distinguish the applicant's goods and services from those of others. Consumers cannot therefore rely on the mark to identify the applicant's goods and services among those of other traders.
21. Therefore, the mark is also considered to be devoid of any distinctive character in respect of the applied-for goods and services for the purpose of section 11(1)(b) of the Ordinance. The mark is accordingly precluded from registration also under this section.

Overseas registrations

22. Mr. Pao said the mark was accepted for registration for the same goods and services in Singapore on a *prima facie* basis. Copies of the registration certificates were provided by the applicant. Mr. Pao also referred me to "wonder" marks registered by other proprietors in the UK (class 28), European Community (classes 1, 2, 3, 9, 11, 16, 17, 28) and Australia (9, 16, 17, 28).
23. I have considered those overseas registrations. However, it should be noted that national trade mark rights are territorially limited and granted independently of each other. It is established that 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 good reasons for refusing the subject application, I am not prepared to simply follow the decisions of another registry. This is especially so when the reasons and rationale behind the acceptances are not available before me.

Conclusion

24. 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 objectionable under section 11(1)(b) and (c) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.

Doreen Wan
For Registrar of Trade Marks
14 February, 2007

Annex 1

Class 2

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants, mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists

Class 5

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice

Class 31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt

Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

Class 35

Advertising; business management; business administration; office functions

Class 43

Services for providing food and drink; temporary accommodation

1. http://www.boonepaint.com/additional_stains.htm
Flood Solid Color Deck and Siding stain comes with a proven 5 year guarantee on decks and a 15 year guarantee on siding. This is an oil based primer and acrylic stain in one product. A true **wonder** product that utilizes Flood's Emulsa-bond for superior adhesion to your deck and siding. Available in a wide range of colors, Flood Solid Color Stain is the perfect solution for applying solid color to decks, wood siding, T1-11, fences and fiber-cement board.
2. <http://www.directgardening.com/detail.asp?nav=sup&pid=8393>
Fruit Spray is complete and ready to use. It contains such insecticides as Malathion and Sevin, as well as, the new **wonder** fungicide Captan, which have been so heartily recommended by most experimental stations.
3. <http://sfgate.com/cgi-bin/article.cgi?f=/c/a/2005/10/22/BUGEMFCB8J1.DTL>
When the board decided to concentrate on the nutritional value of milk, the question of how to advertise it went to copywriter Patrick McKay and art director Feh Tarty at Goodby, Silverstein. They came up with five or six ideas, one of which was to play off the steroids scandal to promote milk as a **wonder** substance.
4. <http://www.savannahimports.com/health.htm>
Rooibos contains alpha hydroxy acid and zinc for healthy, smooth skin. This **wonder** tea is especially useful when applied to skin irritations like itchy skin, eczema, sunburns, diaper rash and acne.
5. http://www.mindful-things.com/newsletter_archive/04-02_02_newsletter.html
Grapefruit, the **wonder** fruit
During a pilot study of 100 obese patients at the Scripps Clinic in San Diego, people who ate half a grapefruit with each meal lost an average of 3.6 pounds (1.6 kg) over 12 weeks.
6. <http://www.beerhunter.com/documents/19133-001520.html>
On the foundation of such a wisdom, one might imagine every brewery in the land to treasure its Mild, every marketing man to be pushing the product as a **wonder** beer.
7. <http://shop.store.yahoo.com/bells/colkooz1.html>
Ideal for mailings our Collapsible Koozie ® can holder is also a **wonder** advertising giveaway with your logo and imprint added... Available in eight great eye-catching

colors.....

8. <http://stlouis.craigslist.org/rfs/112069579.html>

I have a **wonder** house in a fantastic location in Leawood Kansas for lease or sale.
Nearby elementary school and grocery store.