

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : **301006415**
MARK : **Back2Life**
APPLICANT : **BACK IN FIVE, LLC**
CLASS : **10**

STATEMENT OF REASONS FOR DECISION

Background

1. On 4 December 2007, Back In Five, LLC (“the Applicant”) filed an application for registration of the mark shown below (“the Mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

Back2Life

2. The Mark is sought to be registered in respect of “device for preventing or relieving pain in the lower back, namely, equipment for movement and stretching of the lower back for medical and/or therapeutic purposes” in Class 10.
3. At the examination stage, an objection was raised under section 11(1)(b) of the Ordinance on the basis that the Mark is devoid of any distinctive character. Despite submissions made on behalf of the Applicant, the objection was maintained by the Registrar.
4. The Applicant requested a hearing on the registrability of the Mark. The hearing took place before me on 29 November 2010, at which Ms. Sandra Gibbons, authorized representative of Messrs. Freshfields Bruckhaus Deringer, appeared for the Applicant. I reserved my decision at the conclusion of the hearing.
5. The Applicant has not filed any evidence of use of the Mark to show that the Mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2) of the Ordinance. I have, therefore, only the *prima facie* case to consider.

The Ordinance

6. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provision under section 11 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) ...
(d) ...”

Decision

7. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character.
8. In *Host Hotels & Resorts, L.P. v. Registrar of Trade Marks* [2010] 1 HKLRD 541, the Hon Sakhrani J referred to the following principles in deciding whether a mark is devoid of any distinctive character (at paragraphs 17 and 18):

“17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, Jacob J (as he then was) said at p.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?

18. In *Societe des Produits Nestle SA v Mars UK Ltd* [2004] FSR 2, Sir Andrew Morritt V-C (as he then was) said 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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking...”

9. According to the above principles, I have to assess the distinctiveness of a mark by reference to the goods for which registration is sought and the perception of the relevant consumers of those goods who are presumed to be reasonably well-informed and circumspect. To determine whether a mark has any distinctive character under section 11(1)(b) of the Ordinance, the relevant question is whether

the mark, assuming no use of it for the purpose of section 11(2) of the Ordinance, serves to identify the applied-for products as originating from a particular undertaking, and thus distinguishing them from those of other undertakings.

10. The Mark consists of the word “Back”, the numeral “2” and the word “Life”. “Back” and “Life” are common English words with obvious meanings. The numeral “2” is an abbreviation of the word “to” (<http://www.acronymfinder.com/2.html>). There is no stylization or adoption of a particular script form in the presentation of those words and numeral. As a whole, the mark “Back2Life” will be pronounced as and understood to be the equivalent of the expression “Back to Life”, which carries the meaning of returning to a normal state and condition of living.
11. By nature of the applied-for goods which are essentially medical or therapeutic equipment for preventing or relieving pain in the lower back, the relevant consumers are likely to be users of those equipment and professionals of the medical and healthcare sector in Hong Kong.
12. When assessing the distinctiveness of the Mark, I must consider the context in which the Mark is used in respect of the goods applied for. The fair use of a mark in respect of the goods applied for includes applying it on the goods as well as using it in the course of advertising or promotion of the goods in question.
13. When the Mark is used in respect of device for preventing or relieving pain in the lower back in Class 10, it conveys a loud and clear message that the goods concerned can help users suffering from back pain to get back to normal life by having a better state of wellness and health. To the relevant consumers of those goods, the Mark is likely to be perceived as a laudatory promotional statement which commends the benefits or value of the goods being offered. As such, without first being educated that it is a trade mark, the relevant consumers would not regard the Mark as an indicator of trade origin when they come across the Mark on the goods in question or their marketing materials. The Mark therefore fails to perform the essential function of a trade mark in guaranteeing the identity of the origin by enabling the relevant consumers to distinguish the goods offered by the Applicant from those provided by other traders. On this basis, the Mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance.
14. At the hearing, Ms. Gibbons referred me to *Norma Lebensmittelfilialbetrieb GmbH & Co. v OHIM* (Case T-281/02) [2005] E.T.M.R. 49 (in which the German equivalent of the English slogan “MORE FOR YOUR MONEY” was found to be devoid of any distinctive character) and submitted that unlike the mark considered in that case, the Mark will not be immediately recognised as a common and customary advertising slogan with respect to the applied-for goods. In her view, the relevant

consumers would not immediately perceive the mark “Back2Life” as having any reference to the goods in question, either descriptively or as an advertising hyperbole.

15. I do not find *Norma Lebensmittelfilialbetrieb GmbH & Co. v OHIM* to be of assistance to the Applicant’s case. The approach adopted by the European Court of Justice (“ECJ”) in that case was not much different in substance from the principles that I have referred to in paragraphs 8 and 9 above, namely, that a sign’s distinctiveness is to be assessed by reference to the goods or services in respect of which registration is sought and on the basis of the perception of that sign by the relevant public¹. The test was not qualified by such criterion as whether the sign in question is a common or customary advertising slogan or not. It was also held² that the mere fact that the consumer is told nothing about the nature or content of the goods in question is irrelevant. On the other hand, in assessing the distinctive character of a mark comprising of an advertising slogan, the ECJ stated in paragraph 25 of the judgment:

“However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (see, by analogy, *Merz & Krell*, cited above, paragraph 40). A *sign* which fulfils functions other than that of a trade mark in the traditional sense of the term *is only distinctive* for the purposes of Article 7(1)(b) of Regulation No 40/94 however *if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (BEST BUY, cited above, paragraph 21).*” (*emphasis added*)

16. Just as the slogan “MORE FOR YOUR MONEY” was considered by the ECJ as a mere promotional formula that highlights the positive qualities of the goods offered and not as a mark indicating the undertaking from which they come, I find that the Mark “Back2Life” will be immediately understood by the relevant consumers as a mere promotional statement which projects the desirable effects and consequences brought by the products concerned by evoking the aspiration of speedy recovery. As apparent from the internet examples provided to the Applicant at the examination stage (now reproduced in the **Annex**), “back to life” is the sort of expression being used by other traders in the healthcare sector to denote the message that a patient can return to a normal state and condition of living. Hence, the Mark will not be perceived immediately as an indication of the commercial origin of the applied-for

¹ See paragraph 26 of the judgment.

² See paragraph 31 of the judgment.

goods, so as to enable the relevant consumers to distinguish, without any possibility of confusion, the goods of the Applicant from those of a different commercial origin.

17. Regarding the internet examples showing how other traders were using the phrase “back to life” in relation to relief of back pain, Ms. Gibbons argued that in view of the huge number of websites dedicated to the relief of back pain, the location of seven websites in an internet search was not a significant finding. Further, these websites were aimed at the US market and had no significance in Hong Kong. In her view, the phrase “back to life” is not one which is commonly used or recognized by the Hong Kong public in relation to the goods claimed, and those websites are not proper reflection as to whether the Mark is distinctive.
18. I would first point out that whether the phrase “back to life” has been commonly used by other traders is not the test to be applied in determining whether a mark is distinctive. What is important is whether the phrase serves to distinguish the goods offered by the Applicant from those provided by other businesses. The website references *per se* do not form the basis of my objection. The objection is based on an assessment of how the Mark would be perceived by the relevant consumers of the goods sought to be registered. As those website materials illustrate how the expression “back to life” is being used in the relevant trade, they serve to affirm my analysis in paragraph 13 above that the Mark would be readily understood by the relevant consumers as a mere promotional slogan. The number and proportion of websites involved are therefore matters beside the point. Further, consumers in Hong Kong surfing the Internet to look for medical or therapeutic equipment will not restrict their search to materials hosted on Hong Kong websites only. They will have regard to all materials that may help them in relieving back pain, irrespective of whether the websites in question are Hong Kong-based or not. Hence, I do not find the Applicant’s attack on the Internet references to be a valid one.
19. For the perception of the relevant consumers, Ms. Gibbons averred that therapeutic apparatus of the kinds covered by the subject application were not ones that consumers would take lightly, and the relevant consumers would be particularly careful when selecting such goods for the purpose of relieving their back pain.
20. While I accept that consumers may be expected to exercise a higher level of care and attention in choosing a reliable source of the medical or therapeutic apparatus than in buying household items in the supermarkets, it does not automatically follow that the relevant consumers would instantly perceive the Mark as a badge of trade origin. Every person suffering with back pain would wish that his or her discomfort can be effectively cured or at least alleviated so that he or she can quickly resume working and enjoy normal social life. Medical practitioners are dedicated to assist their patients in retrieving their health and well-being. Thus, from the perspective of

the relevant consumers of the applied for products, the Mark “Back2Life” will naturally be seen as an inspiring and motivational statement which appeal to the relevant consumers that the goods concerned will help them to return to the optimal state of health and wellness. As such, the relevant consumers would not rely on the Mark to identify the applied-for goods as originating from a particular undertaking, and thus distinguishing them from those of other undertakings.

21. It is also the Applicant’s submission that while the mark “Back2Life” is equivalent to the phrase “back to life”, the inclusion of the numeral “2” rather than the word “to” is a strong indicator to the public that the mark functions as a badge of origin. Represented in this way, the public would have little doubt that the Mark is functioning as a trade mark rather than mere advertising hype. Ms. Gibbons added that the numeral “2” in the Mark was in fact intended to refer to the second version of the Applicant’s products (the first of which being named “Back Life”).

22. While it may be the Applicant’s intention to use the Mark as a reference to its second line of products, it does not necessarily mean that the Mark possesses any distinctive character in respect of the goods in question. As explained, what matters is the perception of the relevant consumers, not the intention of the Applicant. Moreover, when considering whether a mark is registrable, it is not appropriate to break down a mark into separate parts and consider each part in isolation. The proper approach is to evaluate a mark as a whole rather than its individual component parts. As explained by the Hon Sakhrani J in *Host Hotels & Resorts, L.P. v. Registrar of Trade Marks* (supra) (at paragraphs 23 and 24):
 - “23. Ultimately, what must be considered is what the Mark *as a whole* conveys to the relevant public. ...

 24. Does the Mark *as a whole* convey to the relevant public that the Mark originates from a particular undertaking? If it does not, it is not inherently distinctive.” (*emphasis added*)

23. Looking at the Mark as a whole, the message conveyed by the Mark to the relevant public is nothing more than an origin neutral expression which signifies that the goods bearing the Mark can help users to get back to a normal condition of health and wellness. The use of the numeral “2” in place of the word “to” does not alter the overall impression brought by the Mark to the relevant consumers. Therefore, the Mark will not enable the relevant consumers to distinguish, without any possibility of confusion, the goods of the owner of the Mark from those of a different commercial origin.

24. For the above reasons, I find that the Mark is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Other registered marks and foreign registrations

25. At the hearing, Ms. Gibbons drew my attention to a few examples of other registered marks³ in Hong Kong which, in her view, carried the same amount of distinctiveness as the Mark and had been accepted for registration on a *prima facie* basis. I have considered the marks referred to but I do not think that they are comparable with the present application. In any event, it is a well-established principle that each case has to be assessed on the basis of its own merits and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar Plc* (supra), at page 305). As there are valid grounds for refusal in the subject application, I am not persuaded that the registration of other marks is of any assistance to the Applicant in overcoming the objection.
26. Ms. Gibbons also referred me to the acceptance of the Mark for registration in other jurisdictions such as the United States and the European Community. It should be noted that national trade mark rights are territorially limited and granted independently of each other, and one cannot expect that every trade mark office will invariably take the same view. The bare fact of registration in other countries is therefore not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As I have found that the Mark is precluded from registration under the Ordinance, and the reasons behind those acceptances in other jurisdictions are not known to me, registration of the Mark in those jurisdictions do not serve to overcome the objection raised under section 11(1)(b) as stated above.

Conclusion

27. I have carefully considered all of the submissions, both written and oral, made by and on behalf of the Applicant. For the reasons given above, I consider that the Mark is precluded from registration by section 11(1)(b) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Ryan Ng
for Registrar of Trade Marks
3 May 2011

³The examples are “MY KNEE. MY LIFE.”(300949401), “LIFE IS NOW” (2002B11383) and “LIFE INSPIRING” (2004B07626), which were all registered in respect of (*inter alia*) goods in Class 10.

Annex

1. <http://www.conqueringstress.com/links/painrelief.html>

Low Back Supports for Lower Back Pain Relief ...

JeevanHealth.com offers low back supports for proper posture and low back pain relief! Specializing in Industrial Back Belts, Lower back supports, and back rests and other orthopaedic products for health and well being. Let us help you get **BACK to life!** ...

2. http://www.coordinatedhealth.com/medical_careers.html

Work with an impressive group of physicians and therapists in specialty areas and locations. Become part of a physician led team that gets your patients **back to life.**

We have an immediate opening for a certified, licensed Physician Assistant with Orthopedic surgical experience. Work with an impressive group of physicians, who provide excellent service and care to our patients on their way back to life. This position includes surgical ...'

3. http://www.roberttobys.com/files/CC_Brochure.pdf

CEDAR CHIROPRACTIC physicians, llc

CHIROPRACTIC . MASSAGE. PHYSICAL THERAPY.

Helping you get **back to life**

...help our patients achieve optimal level of health and wellness

4. <http://www.buzzle.com/editorials/3-17-2005-67211.asp>

20 Minutes Relaxation Guide!

20 minutes guide to help you in fighting stress and tension after a hectic working day. Mild Drink OR Something Light To Eat: Relaxing, massage and bath will bring you **back to life**, but you surely can go for a mild drink or something that makes your heart jump with joy. Food/mild drink will take your energy level to the peak and also will keep you active till the time you go to your bed!

5. <http://www.news-medical.net/news/20100506/Southeast-Pain-Care-offers-non-addictive-alternatives-to-pain-relief.aspx>

Southeast Pain Care offers non-addictive alternatives to pain relief

The untimely death of Michael Jackson has brought the issue of pain medication addiction to the forefront of American media recently. The good news for people suffering with pain is that there are several non-addictive alternatives to pain relief.

One of those options is called radiofrequency thermocoagulation therapy. Used to treat pain caused from a variety of conditions, one of the most common types of pain treated with this procedure is neck or back pain from facet arthrosis.

"This procedure can change lives," Dr. Park reiterates. "People can get **back to life** very quickly."

6. <http://www.spineteamtexas.com/get-back-to-life.aspx>

Get **Back To Life**

Who says you can't be a kid again? With help from Spine Team Texas, you're one step closer to relief.

Whether you're looking to alleviate back and neck pain, improve movement or simply participate in everyday activities, we're here to help – from an initial assessment to a customized treatment plan that's right for you. At Spine Team Texas, it's our mission to help you get back to what's important, and ensure that your back and neck pain treatment integrates seamlessly into your everyday life. Our state-of-the-art facilities offer all the necessary diagnosis and treatment equipment in one place, including diagnostic testing, physical therapy and injection suites — eliminating the need for multiple referrals and time-consuming travel. And with a staff dedicated to personal service and comfort, you'll feel at ease from the moment you arrive.

7. http://www.texasback.com/about_us/our_doctors_and_staff

Our Doctors and Staff

Texas Back Institute's world-renowned specialists deliver exceptional patient care with a holistic approach to back and neck pain. The Texas Back Institute medical team comprises board-certified orthopedic spine surgeons, medical physicians, internists, physiatrists, pain specialists, exercise physiologists and a team of physical and occupational therapists who are dedicated to helping patients get **back to life**.