STATEMENT OF REASONS FOR DECISION

Background

1. On 11 March 2008, Fantastic Natural Cosmetics Limited (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the series of marks (collectively, “the subject marks”) in Classes 5, 29, 30 & 32.

2. The goods for which registration is sought are as follows:

Class 5
Health food products for the purposes of improving digestion, metabolism and improving health quality; nutritional and dietetic food products for meal replacement and nutritional drinks in powder mix and liquid form; food supplement preparations in liquid form; food supplement preparations in powdered form; food supplements containing minerals; food supplements containing fiber; collagen based medicated supplements for food; nutritional supplements for pregnant and lactating women; pediatric milk-based nutritional supplements in powdered form for reconstitution into a beverage; complete therapeutic food; dietetic powder, beverages, foods and substances for medical uses; nutritional supplement milk drink, full cream milk drink containing vitamins and nutritional supplements; milk ferments for pharmaceutical purposes; milk sugar, lactose, dietetic substances and food adapted for medical use, medical preparations for slimming purposes, dietetic and other substances adapted for medical use; food for babies, infants' and invalids’ foods; health food supplements; vitamin supplements, vitamin preparations and substances; mineral preparations, iron tablets, iron drops, multi-vitamin and multi-mineral supplements; therapeutic vegetable oils, yeast for pharmaceutical purposes; complete liquid diet; elemental diet preparations providing high nitrogen balanced nutrition; medicinal herbs, medicinal roots, medicinal tea, medicines for human purposes, herbal oils, herbal powders, herbal tablets, herbal foods, herbal ointments, medicinal
herbs, herbal vitamins, herbal teas, herbal beverages, beverages adapted for medical purposes, herbal preparations; medicated preparations for hair, nails and skin; medicated toilet and bath preparations; medicated oils and creams; medicated washes; medicated eye washes and drops; medicated pads for the eyes; lotions, cream, ointments and tonics, all containing vitamins or minerals for slimming purposes; air freshening preparations; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; all included in Class 5.

Class 29
Dietary supplements, other than for medical use; dietetic substances, other than for medical use; nutritional supplements and nutritional dietetic food preparations, other than for medical use; dietary preparations for slimming purposes [cosmetic]; foodstuffs for use as aids to slimming [depending on ingredients]; slimming preparations and products, other than for medical use; milk powder for nutritional purposes [other than for babies]; nutritionally balanced low-calorie prepared meals; vitamin enriched foods; food preparations containing soya and milk proteins; preparations made from soya; soya bean milk; food supplements containing dietary fiber; soups, broth and preparations for making soups and broth; soup and broth concentrates; foods prepared from meat, fish, poultry and game; meat jellies; protein for human consumption; meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; food products containing vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; all included in Class 29.

Class 30
Nutritional drinks and powders not for medical purposes; royal jelly for human consumption [not for medical purposes]; dietary supplements principally of royal jelly [other than for medical use]; beverages containing soya; foodstuffs made from soybean; congee; rice, foodstuffs made of rice; food products consisting of cereals; snack foods; tea, milk tea and tea-based beverages; coffee and coffee-based beverages, artificial coffee; cocoa and cocoa-based beverages; sugar, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; all included in Class 30.

Class 32
Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; vegetable juices; syrups, natural extracts, essences and other preparations for making beverages; sports drinks, aloe vera drinks and juices; beverages for use as aids to slimming [not for medical purposes]; beverages containing added vitamins, minerals or dietary fiber; non-alcoholic low calorie content beverages; non-medicated beverages for use as part of a calorie controlled diet; powdered protein, amino acids, vitamins, minerals and herbs for making beverages; all included in Class 32.

3. At the examination stage, objections were taken under sections 11(1)(b) and (c) of the Ordinance as the subject marks are devoid of any distinctive character in respect of the applied for goods and consist exclusively of signs which may serve, in trade or business, to designate the characteristics of the applied for goods.
4. The applicant requested a hearing which took place before me on 8 September 2010. Mrs. Peggy Cheung of Jones Day appeared on behalf of the applicant. I reserved my decision at the end of the hearing.

5. The applicant did not file any evidence of use of the subject marks. I therefore have only the prima facie case to consider.

**Trade Marks Ordinance**

6. 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) ……………”

**Decision**

7. The subject marks consist of a series of two word marks, namely (A) “iFood” with “F” in upper case and the other letters in lower case, and (B) “IFOOD” in plain block capitals. The applied for goods include health food products, nutritional and dietetic food products, dietetic supplements and substances other than for medical use, nutritional drinks and powders not for medical purposes, congee, rice, foodstuffs made of rice, beers, mineral and aerated waters and other non-alcoholic drinks, etc. in Classes 5, 29, 30 and 32.

8. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance on the basis that the letter “i” or “I” is the abbreviation for the word “Internet” and each of the subject marks as a whole conveys the meaning of “food products provided or traded via the Internet”.

9. Mrs. Cheung submitted that the combination of “IFOOD” is elliptical and resists intuitive
grammatical analysis. She asserted that although the letter “i” may sometimes refer to internet, it has a multiplicity of meanings which cannot be easily interpreted and each of the subject marks as a whole is just a fanciful name for the applied for goods. She did not agree that the subject marks convey the meaning of “food products provided or traded via the internet” although the applicant did not exclude the possibility of the applied for goods being available for sale online. She said that these days everything can be traded via the internet which serves as a channel of trade and for this reason, the consumers would not interpret the subject marks to have any meaning or to be in anyway related to food being provided or traded online. It is also her submission that given the nature and limited shelf life of food products, the consumers would like to see and check the condition and expiry date of the food products physically and online sale is only a very minor part of the applicant’s business.

10. I have considered Mrs. Cheung’s submissions above. Given the word “Food” is just an ordinary English word, I consider that when average consumer see the subject marks used in relation to the goods applied for, which all related to food, beverages and nutritional supplements etc., they would naturally break the subject marks into the letter “i” or “I” and the word “Food” or “FOOD”. This is also the way they would pronounce the subject marks. It would be apparent to the average consumer that each of the subject marks is a mere association of the prefix “i” or “I” and an ordinary English word “Food” or “FOOD”.

11. I note that apart from “Internet”, the letter “i” also has many other meanings. However, when the subject marks are used in relation to the applied for goods which can commonly be traded online, I consider that relevant consumers will immediately understand the letter “i” or “I” as denoting “Internet” and readily perceive the subject marks as the abbreviation of the full expression of “Internet Food”.

Section 11(1)(c) of the Ordinance

12. Section 11(1)(c) of the Ordinance excludes registration of 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 in respect of which registration is sought.
In Wm. Wrigley Jr. Company v OHIM [2004] 1 W.L.R. 1728 ("the DOUBLEMINT case"), the European Court of Justice ("ECJ") discussed the correct approach to the application of Article 7(1)(c) of Regulation No. 40/94 of 20 December 1993 on the Community Trade Mark (provisions of which are broadly similar to section 11(1)(c) of the Ordinance) and stated the relevant principles as follows:

"29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), Windsurfing Chiemsee, paragraph 25, and Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, 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, as the wording of that provision itself indicates, 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."

In light of the legal principles above, to be precluded from registration under section 11(1)(c) of the Ordinance, a mark does not need to inform the consumers what the relevant goods or services are, nor does it have to be the normal way of describing the goods or services in question. It is sufficient if the mark could be used for the purpose of designating the characteristics of the goods and services, including the kind and intended purpose of the goods and services. A mark is therefore objectionable if at least
one of its possible meanings designates a characteristic of the goods and services in question.

15. It is true that the letter “i” can have a number of different meanings depending on the context in which it is used. However, the possibility that the subject marks may have more than one meaning does not make the subject marks cease to be descriptive. It is plain from the use of the words “may serve” in section 11(1)(c) of the Ordinance and the decision in the DOUBLEMINT case that a sign is precluded from registration if at least one of its possible meanings designates a characteristic of the applied for goods. So long as at least one of the meanings serves to describe the goods in question, a sign that has multiple meanings does not escape the application of section 11(1)(c).

16. As submitted by Mrs. Cheung, internet shopping is very common these days and the applicant did not exclude the possibility of the applied for goods being available for sale via internet. I do not see any merit in the submission that for the reason that these days everything can be traded via the internet, the consumers would not interpret the subject marks to have any meaning or to be in anyway related to food being provided or traded online. Actually, due to the fact that everything including food products can be traded via internet these days, I consider that the relevant consumers will naturally interpret the letter “i” as standing for “internet”. In the mind of the average consumer, the subject marks are instantly associated with certain characteristics of the goods applied for, namely the goods are food products traded or available for sale via internet, so that the subject marks are necessarily descriptive and cannot serve as a badge of trade origin.

17. At the hearing, Mrs. Cheung submitted that a trade mark may be distinctive if it merely hints at the character of the goods or services, provided that it does not directly describe them. She also submitted that a mark is descriptive only if the descriptive element is immediately, clearly and unmistakably obvious from the application. It is also her submission that consumers do not engage in a conceptual analysis of trade marks made up of a combination of words, what matters according to case law is whether a mark is descriptive or merely suggestive or allusive. She referred me to a number of cases including *Rosenbluth International, Inc.’s Application* (Case R-190/1998-2) (“the Vision Direct case”) and *Keystone Knitting Mills Ltd’s Trade Mark* (1928) 45 RPC 421.

18. In the present application, the meaning conveyed by the subject marks about the characteristics of the applied for goods is not merely allusive or suggestive. Given the
meaning of “Internet” for the letter “i” and the word “Food”, in my judgment, when the subject marks are used in respect of the goods applied for, they directly tell the relevant consumers that the goods are food products traded or available for sale online. The descriptive message of the subject marks is so clear and direct that it will be immediately perceived by the relevant consumers without further thought. Accordingly, the subject marks consist exclusively of signs which may serve, in trade or business, to designate the characteristics of the applied for goods. The subject marks are therefore debarred from registration under section 11(1)(c) of the Ordinance.

19. Having found that the subject marks are precluded from registration by section 11(1)(c), it is not necessary for me to consider other grounds of refusal under the Ordinance. But for completeness, I will go on to consider the application under section 11(1)(b) of the Ordinance. The objection under section 11(1)(b) of the Ordinance operates as a ground for refusal separate and independent from that under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

20. Section 11(1)(b) precludes from registration signs which are devoid of any distinctive character. The issue is whether the mark, when used in relation to the goods for which registration are sought, serves to indicate the trade origin of the goods.

21. The test for distinctiveness was laid down by Mr. Justice Jacob in British Sugar Plc v James Robertson and Sons Ltd [1996] RPC 281 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] FSR 2:

“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. At the hearing, Mrs. Cheung referred me to *Eurocool Logistik GmbH v OHIM* [2002] ECR II-683 (“the Eurocool case”) and submitted that a minimum degree of distinctiveness is sufficient to render inapplicable the grounds of refusal under section 11(1)(b) of the Ordinance. She further relied on *SAT.1 SatellitenFernsehen GmbH v OHIM* (Case C-329/02 P) (“the SAT2 case”) and submitted that in order to achieve registration there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness.

24. However, it appears from the quoted paragraphs in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 and *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 above, and also the *Eurocool* and *SAT2* cases themselves that the test for distinctiveness depends ultimately on the ability of the mark in question to identify the trade origin of the goods in question, thus enabling consumers to distinguish the applicant’s goods from those of others.

25. It is also well established that in assessing a mark, the mark must be considered in its entirety. In view of the above legal principles, I must consider the combination of the letter “i” or “I” and the word “Food” or “FOOD”, as represented in the subject marks, by reference to the presumed perception of the relevant consumers, who for these types of goods would be the general public. The relevant question is whether the subject marks would be capable of identifying the goods applied for as originating from a particular undertaking, and thereby distinguishing the goods of the applicant from those of other undertakings.

26. Given the increasing popularity of internet trading and the use of letter “i” in association with activity conducted through the internet, I consider that the overall impression projected by each of the subject marks is the letter “i” which stands for “Internet” and the ordinary English word “Food”. By reference to the applied for goods, the subject marks convey an immediate message to the relevant consumers that the goods applied for are food products traded or available for sale via internet.

27. Accordingly, the subject marks will give the relevant consumers an overall impression as a descriptive designation, indicating the characteristics of the goods applied for. The letter “i” or “I” in conjunction with the word “Food” or “FOOD” does not introduce any unusual variation or create any impression that is sufficiently far removed from the combination of meaning lent by each of its elements. The composition is not sufficient
to bestow distinctive character on any of the subject marks as a whole as it does not result in anything more than a mere sum of its parts. There is nothing about the subject marks that may enable the relevant consumers to memorize the marks easily and instantly as distinctive trade marks for the applied for goods. Each of the subject marks as a whole lacks the minimum degree of distinctive character required for it to indicate to the consumers the commercial origin of the applied for goods.

28. The subject marks are equally applicable for promoting similar goods from other undertakings. The perceptions and recollections that the subject marks would trigger in a consumer’s mind are likely to be origin neutral. Without being first educated through use, the subject marks would not serve as a badge of trade origin which enables consumers to distinguish the applicant’s goods from those of others.

29. For the reasons stated above, I find that neither of the subject marks would be perceived by consumers as an indication of trade origin of the applied for goods, and they are therefore devoid of any distinctive character under section 11(1)(b) of the Ordinance.

Reference to other registered marks on the register

30. Mrs. Cheung referred to various registered marks all having the prefix “i” or “I” such as iPhone, IFUN, iFit, iMarket, iRice, iPatch, iSecure, I-MATE, iLuv, ISKIN, iJacket, etc. and submitted that they are no more distinctive than the subject marks. She submitted that it is quite clear from these prior acceptances that various “i” or “I” marks have been considered registrable by the Registrar and it has become fashionable to use the letter “i” or “I” which may no longer be objectionable. Mrs. Cheung submitted that as with those registered marks, the subject marks should be considered distinctive and acceptable for registration as well.

31. I have considered the registered marks referred to by Mrs. Cheung and I find them to be more distinctive than the subject marks. In any event, it is well established that each case must be considered on its own merits and not by reference to other registered marks. In British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 at 305, Jacob J said that “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, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”
32. I therefore find that the acceptances of the registered marks referred to by Mrs. Cheung do not assist the subject application. In particular, where there are valid grounds of objections under the Ordinance, I do not consider that the subject application can be accepted solely on the basis of the earlier registered trade marks.

**Conclusion**

33. I have considered all documents filed and submissions made by the applicant in relation to this application. For the reasons stated above, I find that the subject marks are precluded from registration by section 11(1)(c) and (b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Connie Law

for Registrar of Trade Marks

1 March 2011