

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO. : 301151289**

**MARK :**



**APPLICANT : PARAMOUNT INTERNATIONAL IP HOLDING  
COMPANY**

**CLASS : 29**

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**STATEMENT OF REASONS FOR DECISION**

***Background***

1. On 2 July 2008, Paramount International IP Holding Company (“the applicant”) filed an application for the registration of the mark  (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application is in respect of processed nuts in class 29.

2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the grounds that the subject mark consists exclusively of a sign which designates the characteristics of the goods applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.

3. The applicant requested a hearing on the registrability of the subject mark and this was held before me on 10 November 2011. At the hearing, the applicant was represented by Ms. Evelyn Yeung of Messrs. Stephenson Harwood, agents of the applicant. I reserved my decision until after the conclusion of the hearing.

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

### ***Grounds of refusal under section 11***

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. The relevant parts of section 11 are set out below:

*“(1) Subject to subsection (2), the following shall not be registered –*

*...*

*(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 ...”*

### ***Decision***

6. A number of UK cases have laid down principles on how the assessment of whether a mark has any distinctive character is to be carried out. According to Jacob J in the case of ***British Sugar Plc v James Robertson and Sons Ltd*** [1996] RPC 281,) the test is (at page 306) –

*“What does devoid of 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?”*

7. The test as stipulated in the case of ***Nestle SA’s Trade Mark Application (Have a Break)*** [2004] FSR 2 (at paragraph 23) is as follows –

*“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.”*

8. In assessing the distinctiveness of a mark, I have to consider whether the mark will be perceived as a badge of trade origin. The assessment is to be carried out in respect of the subject mark, with reference to the goods of the class for which registration is sought, as well as the consumers of those goods, who are reasonably well-informed and circumspect. Although the relevant consumers are reasonably well-informed and circumspect, they cannot be expected to exercise more than an average level of care and attention.

9. The subject mark consists of one single English word “Wonderful” set against a dark background. The letter “W” is depicted in the upper case while the rest of the letters are in the lower case. The letter “o” in the word is not a perfect round shape but is represented in the form of a heart. Apart from this, all the letters appear in mere plain font. There is no other stylization or additional element to the subject mark.

10. The goods applied for are processed nuts. Such goods are common snacks often consumed by the public and can be easily picked up from the shelves of a supermarket or other stores. The relevant consumers are therefore members of the general public. When purchasing general snack items, they are not too discerning and they do not pay too much attention to the details of the marks used on the goods.

11. As has been pointed out to the applicant at the examination stage, the word “wonderful” carries the dictionary meaning of “extremely good”. It is the sort of laudatory term which can be used in respect of a broad range of goods and services. When the subject mark is used on processed nuts, it clearly informs the consumers that the nuts are extremely good. Although the letter “o” is in the form of a heart, the letter is very small in size and the heart is not noticeable at first glance or if consumers’ attention is not deliberately drawn to it. The dark background also accentuates the prominence of the word itself. That being the case, the first impression that consumers of the goods applied for will have of the subject mark is that of a sign that lauds and describes the quality of such goods. The expression “wonderful” can be used in relation to the applied-for goods of any undertaking which wishes to promote its goods as of excellent quality. It will not therefore be regarded as a sign that indicates the origin of the goods.

12. Relying on the case of *Ford Motor Co. v. OHIM* Case T-67/07, Ms. Yeung

argued that the registration of the subject mark should not be objected to because it only confers a positive image on the goods applied for. In her view, the link between the word “Wonderful” and processed nuts is plainly too vague, uncertain and subjective to convey any descriptive character in relation to processed nuts.

13. I do not find the present case to be comparable to the *Ford Motor* case. In that case, the word “FUN”, when used on a land motor vehicle, was considered not to have gone beyond the suggestion of a positive image about the vehicle and that it did not inform the consumers of one of the qualities or specific characteristics of the goods. With the use of the word “wonderful” on processed nuts, the message about the quality of the goods is loud and clear. It does not only confer a positive image about the goods, but also tells the consumers that the nuts are extremely good. The link between the subject mark and processed nuts is direct, certain and immediate.

14. Ms. Yeung submitted that the heart shaped letter “o” would add distinctiveness to the subject mark. She referred to the case of *Eurocool Logistik GmbH v OHIM* Case T-343/00 where it was said that “*a trade mark is not necessarily a work of invention and is founded not on any element of originality or imagination but on its ability to distinguish goods or services on the market from goods or services of the same kind offered by competitors*”. Ms. Yeung put it to me that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal under section 11(1)(b) of the Ordinance. She also attempted to draw analogy with other marks on the register in support of her submissions that the subject mark should be accepted for registration.

15. In assessing registrability, the overall impression of the mark has to be considered. The letter “o” is of the same size as the other letters shown in the lower case in the subject mark. The first letter “W” in the subject mark is the largest in size and is depicted in the upper case. Its prominence overshadows the significance of the heart-shaped letter “o” next to it. Without paying particular attention, consumers will simply regard it as a letter “o” and the whole mark as the word “Wonderful”.

16. Ms. Yeung also asked me to allow the registration of the subject mark in view of the acceptance of various composite marks incorporating the word “WONDER” by the Registry. In addition, she drew my attention to the acceptance of the subject

mark in various English speaking countries, including Europe and the US.

17. It is well established that the registrability of each mark has to be considered on the basis of its own merits. As noted by Jacob J in the case of *British Sugar v James Robertson and Sons Ltd*, *supra*, at page 305 “*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.*”. The reference to other existing registered marks is thus of no assistance to this application. This is also the case with marks registered in other jurisdictions when the reasons for their acceptances are not known to me and there are valid grounds in the present case for raising the objections under the Ordinance.

18. From the perspective of the relevant consumers, the overall impression they have of the subject mark is that of a laudatory and descriptive word about the quality of the processed nuts, that is, they are excellent. Without their being first educated of its trade mark significance, they will not realize that the subject mark is intended to identify the goods as originating from a particular undertaking. I therefore find the subject mark to be devoid of any distinctive character under section 11(1)(b) of the Ordinance in respect of the goods applied for. Having so concluded, there is no further need for me to deal with the submissions of Ms. Yeung made in respect of the ground of refusal raised under section 11(1)(c) of the Ordinance.

### ***Conclusion***

19. I have considered all the documents filed by the applicant together with all the oral and written submissions made in respect of the application. For the reasons stated above, I find that the subject mark is, contrary to section 11(1)(b) of the Ordinance, devoid of any distinctive character in respect of the goods applied for. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow  
for Registrar of Trade Marks  
20 December 2011