

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 301331865
MARK : **WORLD TRADE CENTER**
APPLICANT : World Trade Centers Association, Inc.
CLASS : 35, 38, 41, 42, 43

STATEMENT OF REASONS FOR DECISION

Background

1. On 27 April 2009, World Trade Centers Association, Inc. (the “Applicant”) filed an application for registration of the mark shown below (the “Subject Mark”) under the Trade Marks Ordinance (Cap. 559) (the “Ordinance”).

WORLD TRADE CENTER

2. The Subject Mark is sought to be registered in respect of the following services (the “Applied-for Services”):

Class 35

Advertising and promotional services; business management and organization advisory; business management assistance; business administration; arranging of trade fairs; organization of trade fairs for commercial or advertising purposes; arranging and organization of exhibitions, displays, conventions, and conferences for trade, commercial or advertising purposes; international business representation services; import-export agencies; business investigation; market research; business research; economic forecasting; office administration services; rental of office machines and equipments; secretarial; typing; word processing; photocopying; telephone answering (for other); provision of trade , advertising and business information; compilation of information into computer databases; dissemination of advertising or promotional matters; provision of a forum for posting trade opportunities; advertising the goods and services of others by means of providing an electronic sites at which such others can post notice of their goods and services and which can be accessed via a computer network or the Internet; information and consultancy services in relation to the aforesaid services; all included in Class 35.

Class 38

Telecommunication; transmission of telegrams, telegraphs, telexes and facsimiles; electronic mail services; communication by computer terminals; computer aided transmission of information, images and voices; electronic network communication; rental of telecommunication apparatus and equipments; transmission of information, images and voices for video conference; electronic bulletin board services; telecommunication services for accessing a database; information and consultancy services in relation to the aforesaid services; leasing access time to a computer database (other than by Internet service providers); all included in Class 38.

Class 41

Education services relating to trade, international trade, business, advertising, computers, information technology, telecommunication, traveling, hotel services, restaurant, and catering services; arranging, organization and conducting of exhibitions, displays, conventions, conferences, video-conferences; seminars, workshops for educational, cultural, training and entertainment purposes; club services (entertainment or education); publication of books, periodicals, journals and newsletters; publication of books, periodicals, journals and newsletter online; information and consultancy services in relation to the aforesaid services; translation and interpretation services; all included in Class 41.

Class 42

Creating, maintaining and hosting websites; computer services; information and consultancy services in relation to the aforesaid services; all included in Class 42.

Class 43

Providing facilities for trade fairs, exhibitions, displays, conventions, conferences, seminars and workshops; hotel services; provision and reservation of temporary accommodation; restaurant services; catering services; arranging for accommodation for travelers; all included in Class 43.

3. At the examination stage, an objection was raised under section 11(1)(b) of the Ordinance on the basis that the Subject Mark conveys the message of a place where activities and services relating to international trade are concentrated. Upon seeing the Subject Mark being used in relation to the Applied-for Services, the relevant consumers are likely to perceive it as an indistinctive statement that the services are provided by a centre engaging in international trade. It is devoid of any distinctive character and cannot serve as an indicator of trade origin. 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 Subject Mark. The hearing took place before me on 23 January 2013, at which Ms. Anna Mae Koo of Vivien Chan & Co. appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.

5. In support of the subject application, the Applicant had filed Statutory Declaration of Scott Richie, Esq. dated 14 January 2013 (the “Statutory Declaration”) with a view to showing that the Subject Mark had in fact acquired a distinctive character as a result of the use made of it for the purpose of section 11(2) of the Ordinance.

The Ordinance

6. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provisions under section 11 read 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)

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Decision

Inherent registrability

7. Section 11(1)(b) of the Ordinance precludes from registration trade marks which are devoid of any distinctive character.
8. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* (HCMP 554/2009), the Hon Sakhani J cited with approval the following cases at Paragraphs 17–18:

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

18. In *Nestle SA's Trade Mark Application (Have A Break)* [2004] FSR 2 Sir Andrew Morritt VC (as he then was) said 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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking.....”

9. Applying the above legal principles, for the Subject Mark to possess distinctive character, it must serve to identify the Applied-for Services as originating from a particular undertaking and therefore distinguish such services from those of the other traders. In assessing the distinctiveness of the Subject Mark, I must take into account the Applied-for Services as well as the perception of the average consumer of those services, who is presumed to be reasonably well informed and circumspect.
10. The Subject Mark is made up of three ordinary English words “WORLD”, “TRADE” and “CENTER” in plain font. The words are presented in capital letters of the same size. There are no other added elements or stylization.
11. Some of the Applied-for Services, such as “arranging and organization of exhibitions, displays, conventions, and conferences for trade, commercial or advertising purposes; transmission of information, images and voices for video conference; providing facilities for trade fairs, exhibitions, displays, conventions, conferences, seminars and workshops” etc., tend to target business consumers. Other Applied-for Services, such as “photocopying; advertising the goods and services of others by means of providing an electronic sites at which such others can post notice of their goods and services and which can be accessed via a computer network or the Internet; transmission of telegrams, telegraphs, telexes and facsimiles; electronic mail services; club services (entertainment or education); publication of books, periodicals, journals and newsletters; computer services; hotel services; restaurant services” etc., are widely used consumer services and target business consumers as well as members of the general public. The relevant consumers are therefore business consumers and ordinary members of the general public.
12. At the hearing, Ms. Koo submitted that although the Subject Mark is comprised of three ordinary English words, it is not an appropriate designation for the Applied-for Services. The ordinary meaning of the words contained in the Subject Mark does not directly relate to the Applied-for Services, and the Subject Mark can fulfill its purpose of identifying one trade origin from another.

13. In assessing the distinctiveness of a compound word mark, I note the decision of the European Court of Justice in Case C-304/06 P *Eurohypo v OHIM*. [2008] ECR I-3297, at Paragraph 41:

“As regards a compound trade mark, such as that at issue in the present case, the assessment of its distinctive character cannot be limited to an evaluation of each of its words or components, considered in isolation, but must, on any view, be based on the overall perception of that mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, have a distinctive character (see, to that effect, Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character (Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975, paragraph 29).”

14. I am also minded of the observations of the Court of First Instance (now known as the General Court) of the European Communities stated in *Robert Bosch GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHMI) (“Kit Pro”)* [2002] ECR II-04881 at Paragraph 29:

“Next, the fact that a compound trade mark consists only of components devoid of distinctive character as regards the goods or services concerned is evidence which generally justifies the conclusion that that trade mark, considered as a whole, is also devoid of distinctive character in relation to those goods or services. Such a conclusion can be dismissed only if concrete evidence, such as, for example, the way in which the various components are combined, indicates that the compound trade mark, considered as a whole, is greater than the sum of its parts.”

15. As mentioned in Paragraph 10 above, the Subject Mark consists of three ordinary English words. The word “WORLD” carries the meaning of the earth or public in general; whereas the word “TRADE” refers to the act or process of buying, selling or exchanging commodities and the word “CENTER” means the place at which some specified activity is concentrated or a platform which facilitates some specified activity.
16. When the Subject Mark is viewed as a whole, it gives a direct and immediate impression to the average consumer, irrespective of whether he/she is a business consumer or a member of the general public, of a centre that is engaged in international trade, a physical location or a virtual environment where activities and services relating to international trade take place, or a platform which facilitates international trade.
17. Upon seeing the Subject Mark being used in connection with the Applied-for Services, such as “advertising and promotional services; provision of a forum for posting trade opportunities; telecommunication; education services relating to trade, international trade, business, advertising, computers, information technology, telecommunication, traveling, hotel services, restaurant, and catering

services; publication of books, periodicals, journals and newsletter online; creating, maintaining and hosting websites; providing facilities for trade fairs, exhibitions, displays, conventions, conferences, seminars and workshops” etc., it simply conveys to the average consumer the message that such services are provided by a centre which is engaged in international trade or that such services are available at a place, be it a physical location or a virtual environment, where international trade takes place, or that such services are provided via a platform which facilitates international trade.

18. The Subject Mark, when considered as a whole, simply does not go beyond the sum of its parts. Without first being educated, the average consumer will not perceive the Subject Mark as a badge of trade origin.
19. For the reasons stated above, I find the Subject Mark inherently incapable of distinguishing the Applicant’s services from those of the other traders. The Subject Mark will not be regarded as an indicator of trade origin of the Applied-for Services by the relevant consumers. It is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Acquired distinctiveness

20. Although I have found that the Subject Mark has no inherent distinctive character and is not registrable under section 11(1)(b) of the Ordinance in respect of the Applied-for Services, if the Subject Mark has in fact acquired a distinctive character as a result of the use made of it in respect of those services for the purpose of section 11(2) of the Ordinance, the application for registration should not be refused. I shall therefore proceed to consider whether the Subject Mark has in fact acquired a distinctive character in respect of the Applied-for Services with reference to the evidence of use filed by way of the Statutory Declaration.
21. In *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v. Boots-und Segelzubehör Walter Huber and Another* [1999] E.T.M.R. 585 (Joined Cases C-108/97 and C-109/97), the European Court of Justice laid down its interpretation of Article 3(3) of the First Council Directive 89/104/EEC of 21 December 1988 (now replaced by Directive 2008/95/EC of 22 October 2008), which is broadly similar to section 11(2) of the Ordinance, at Paragraphs 49, 51–52 & 54:

“49. In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.

50.

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied ...

53.

54. ... a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings ...”

22. According to the Statutory Declaration, the Applicant was formed in 1968 and incorporated in 1969 in the State of Delaware, the United States of America. It is an association that owns and grants licenses to its members to use the Subject Mark and the mark  (the “World Map Device Mark”) in connection with trade-related services. Two Hong Kong members were mentioned in Paragraph 22 of the Statutory Declaration, namely the World Trade Centre Club Hong Kong (the “WTC-HK”) and the World Trade Centre – Hong Kong International Airport (the “WTC-Airport”).

Materials submitted for demonstrating use of the Subject Mark

23. Under section 11(2) of the Ordinance, the Applicant needs to prove that the Subject Mark has in fact acquired a distinctive character as a result of the use made of it in respect of the Applied-for Services in Hong Kong before the date of filing of the subject application, i.e. 27 April 2009.

24. There are eleven exhibits to the Statutory Declaration:

“SR-1” being a copy printout from <http://www.collinsdictionary.com> which provides a definition for the term “WORLD TRADE CENTER” and its acronym “WTC”;

“SR-2” being copies of a fact sheet regarding the Applicant dated 11 September 2011 and extract from a handbook which provides background details on the Applicant;

“SR-3” being a copy of the Applicant’s service quality standards development and certification guide which was valid for all certifications in 2012;

“SR-4” being a collection of materials including but not limited to copies of photos of signage, a registration brochure for the Applicant’s 28th general assembly that took place in Hong Kong in 1997, printouts from <http://www.wtcchk.com> and a pamphlet regarding a wedding banquet package;

“SR-5” being copies of the Applicant’s sales figures from Hong Kong and excerpts from the Applicant’s consolidated financial statements from 2003 to 2009 showing the Applicant’s worldwide revenue from its trade marks;

“SR-6” being a collection of materials including but not limited to copies of undated pamphlets of the WTC-Airport and newsletters published by the WTC-HK from 2005 to 2009;

“SR-7” being copies of excerpts from the Applicant’s consolidated financial statements from 2003 to 2009 showing the Applicant’s worldwide advertising and promotion expenses for that period of time;

“SR-8” being copies of articles from various databases which contain references to the Applicant and/or the terms “WORLD TRADE CENTER” and “WORLD TRADE CENTERS”;

“SR-9” being details on the registration of the Subject Mark in the United States of America;

“SR-10” being a list of jurisdictions in which the Subject Mark has obtained registration; and

“SR-11” being copies of trade mark registration certificates of the Subject Mark issued by various overseas trade mark offices.

25. Notwithstanding the fact that the Applicant is applying to register the Subject Mark in respect of a diversity of services, the materials submitted only relate to a limited range of services, for example “arranging of trade fairs; club services (entertainment or education); providing facilities for trade fairs, exhibitions, displays, conventions, conferences, seminars and workshops” etc..

26. Some materials submitted are undated or bear a date after the date of application.¹ Such materials are of little relevance, if any, to this application.

¹ “SR-3”, pages 4-1 to 4-2 and 4-16 to 4-18 of “SR-4” and pages 6-1 to 6-25 of “SR-6” are undated. Page 2-1 of “SR-2”, pages 4-14 to 4-15 of “SR-4”, pages 6-176 to 6-199 of “SR-6” and pages 8-78 to 8-88 of “SR-8” bear a date after the date of application.

27. Some of the exhibits dated before the date of application do not bear the Subject Mark.² Amongst those that bear the Subject Mark, copies of excerpts from the Applicant's handbooks,³ registration brochures and other similar information pamphlets for general assemblies of the Applicant⁴ depict the Subject Mark but as part of the Applicant's full name and with the word "CENTER" presented in plural form: "WORLD TRADE CENTERS ASSOCIATION". The question here is whether use of the phrase "WORLD TRADE CENTERS ASSOCIATION" constitutes use of the Subject Mark as a trade mark. It is my view that the average consumer will only view the phrase "WORLD TRADE CENTERS ASSOCIATION" as a whole as the name of an association. It is not used as a trade mark in relation to the Applied-for Services.

28. Apart from the materials mentioned in Paragraph 27 above, copies of newsletters issued by the WTC-HK⁵ also depict the Subject Mark but as part of the WTC-HK's full name, with the word "CENTER" spelt differently and in conjunction with other elements, such as



"WORLD TRADE CENTRE CLUB HONG KONG". The question here is whether use of the above representation constitutes use of the Subject Mark as a trade mark. It is my view that the phrase "WORLD TRADE CENTRE CLUB HONG

KONG" in the representation  is likely to be perceived by the average consumer as a whole as the name of a club. I am not convinced that use of such representation in the newsletters constitutes use of the Subject Mark as a trade mark. Further, the newsletters also present the Subject Mark as part of an address in Hong Kong: "38/F World Trade Centre, Causeway Bay, Hong Kong". Upon seeing the Subject Mark in this context, the average consumer will only perceive it as part of an address in Hong Kong instead of a trade mark. Accordingly, the newsletters cannot assist this application.

29. Despite averring in Paragraph 20 of the Statutory Declaration that the Applicant first used the Subject Mark in Hong Kong in 1976, none of the evidence submitted in the Statutory Declaration can substantiate this claim.

Sales of the Applied-for Services under the Subject Mark in Hong Kong

30. According to Paragraph 18 of the Statutory Declaration, members of the Applicant are required to pay joining fees and annual fees in exchange for the right to enjoy the privileges and prestige of the membership, including a right to use the Subject Mark and the World Map Device Mark. The total membership fees collected worldwide by the Applicant since 1968 amounted to more than US\$73 million. A breakdown of the annual fees collected from the WTC-HK and the WTC-Airport per year between 2003 and 2009 was provided in Paragraph 21 of the Statutory Declaration, supported by page 5-1 of "SR-5". As it was claimed in Paragraph 22 of the Statutory Declaration that the vast majority of services

² Pages 4-3 to 4-4 of "SR-4" do not bear the Subject Mark.

³ Pages 2-2 to 2-10 of "SR-2" are excerpts from the Applicant's handbook.

⁴ Pages 4-5 to 4-13 and 4-19 to 4-22 of "SR-4" are copies of registration brochures and other similar information pamphlets for general assemblies of the Applicant.

⁵ Pages 6-26 to 6-175 of "SR-6" are copies of newsletters issued by the WTC-HK.

provided in Hong Kong bearing the Subject Mark and the World Map Device Mark are provided by the Applicant's members in Hong Kong rather than the Applicant, for the purpose of determining whether the Subject Mark has acquired a distinctive character, the revenue generated from use of the Subject Mark by the WTC-HK and the WTC-Airport are more important and relevant than the amount paid by them for a right to enjoy the benefits of being members of the Applicant, including a right to use the Subject Mark and the World Map Device Mark.

31. According to Paragraph 22 of the Statutory Declaration, due to confidentiality concerns, revenue figures for the Applicant's members in Hong Kong, namely the WTC-HK and the WTC-Airport, were not included in the Statutory Declaration. Instead, the Statutory Declaration only provided information such as the amount charged by the WTC-HK for provision of conference facilities for business meetings and business banquet facilities, membership fees as well as fees for using the aforesaid facilities by non-members charged by the WTC-Airport. I am unable to assess the extent of sale of the Applied-for Services under the Subject Mark in Hong Kong based on such incomplete information.

Promotion of the Applied-for Services under the Subject Mark in Hong Kong

32. Scott Richie, Esq. provided in Paragraph 23 of the Statutory Declaration the Applicant's worldwide expenses in connection with advertising and promoting the Applied-for Services bearing its three core trade marks, namely the Subject Mark, the World Map Device Mark and the mark "WTC". Although it was stated that the figures were directed equally towards promoting the three trade marks, they were not broken down to show the proportion attributable to promotion of the Applied-for Services under the Subject Mark to Hong Kong consumers. The same paragraph provided that the WTC-HK spent a total of HK\$150,000 on advertising and promoting services bearing the Subject Mark from 2003 to 2007, i.e. HK\$30,000 per year on average. Similar information in relation to promotion of the Applied-for Services under the Subject Mark by the WTC-Airport was not provided.
33. Paragraph 27 of the Statutory Declaration provided the average annual amount spent by the Applicant on advertising, promoting and rendering services in connection with the Applicant's trade marks, including the Subject Mark and the World Map Device Mark, on an international scale over the past 10 years. However, the figure was not broken down to show the proportion attributable to advertising and promoting the Applied-for Services (which cover a diversity of services) in connection with the Subject Mark in Hong Kong. The amount spent by the Applicant on rendering services in connection with the Applicant's trade marks is not directly relevant to the subject application as it does not reflect the amount of effort spent by the Applicant on advertising and promoting the Applied-for Services under the Subject Mark in Hong Kong.
34. In the absence of any information regarding the amount spent by the Applicant and the WTC-Airport on advertising and promoting the Applied-for Services bearing the Subject Mark in Hong Kong, I can only rely on the advertising and promotion expenditure spent by the WTC-HK mentioned in Paragraph 32 above, i.e. HK\$30,000 per year on average, which, in my mind, is a relatively low figure.

Based on the limited information submitted, I am not satisfied that the Applicant and its licensees have spent sufficient effort in educating the relevant consumers in Hong Kong of the trade mark significance of the Subject Mark in respect of the Applied-for Services.

Other materials submitted in the Statutory Declaration

35. The copies of articles submitted under “SR-8” were published outside of Hong Kong. It is unknown whether such articles have been circulated in Hong Kong. They cannot illustrate that Hong Kong consumers are aware of the trade mark significance of the Subject Mark.
36. Although the Subject Mark has obtained registration in various jurisdictions as supported by details of such registrations submitted under “SR-9”, “SR-10” and “SR-11”, the reasons for these foreign registrations are unknown. Since there are valid grounds for rejecting the subject application, I am not persuaded to accept the Subject Mark for registration based on those foreign registrations.
37. Paragraphs 8 and 28 of the Statutory Declaration mentioned the destruction of the two towers of the World Trade Center in New York, the United States of America on 11 September 2001. The Applicant was of the view that as a result of the incident, the Subject Mark has become internationally recognized. I do not concur with this view. Although the incident might have rendered the World Trade Center in New York well-known to the public as a building in the United States of America, it did not mean that the Subject Mark has become recognized as a trade mark in relation to the Applied-for Services in Hong Kong.
38. Based on the evidence presented and for the reasons discussed in Paragraphs 23 to 37 above, I cannot conclude that the relevant consumers have been adequately educated to recognize that the Subject Mark functions as a trade mark in relation to the Applied-for Services. I therefore find the Applicant has failed to overcome the objection raised under section 11(1)(b) of the Ordinance.

Reference to a prior registered trade mark on the register

39. At the hearing, Ms. Koo referred to a prior registration of the mark  “世界貿易指南” “WORLD TRADE DIRECTORY” registered under Trade Mark No. 300244836 in respect of goods in Class 16. She contested that in light of the prior registered mark, which consists of the English words “WORLD TRADE”, the Subject Mark should also be considered distinctive and acceptable for registration.
40. I have considered the prior mark referred to but I do not find it of assistance to the Applicant in overcoming the objections in the present application. 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. Although there is a prior registration of a trade mark consisting of the term “WORLD TRADE”, as there are valid grounds for refusal in the subject application, I am not prepared to

accept the Subject Mark for registration solely on the basis of this prior registered mark.

Conclusion

41. I have carefully considered all the documents filed by the Applicant together with all the oral and written submissions made in respect of the subject application. For the reasons given, I find that the Subject Mark is precluded from registration in respect of the Applied-for Services under section 11(1)(b) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Janette SHAM
for Registrar of Trade Marks
19 July 2013