

# Unregistered Trade Mark

Trade mark is a sign which can be a word or words (including personal names), designs, letters, numerals, figurative elements, colors, sounds, smells, shape of the goods or their packaging or any combination the of these. In most parts of the world including Hong Kong, the basic requirement for a trade mark to be registrable is that the mark must possess some element of distinctiveness which serves to distinguish goods and/or services sold and/or provided under the mark of one trader from those of others. It would be unlikely to register a trade mark which is devoid of any distinctive character, or, descriptive of the goods/services, or, a geographical name, or, contrary to law or morality, or national or regional flag.

The following decision of the Hong Kong Trade Marks Office on distinctiveness of mark reveals that a trade mark, which is considered devoid of any distinctive character and descriptive of goods/services will very likely be refused.

2008  
December

## Trade Mark "NAKED"

Hong Kong Trade Mark  
Application No. 300765009  
Class 10

The applicant, Creative Resources LLC, applied to register the mark "NAKED" for goods "condom" in Class 10. At the examination stage, registration of this mark was refused on grounds that (i) the mark was devoid of any distinctive character; and (ii) the mark consisted exclusively of a sign which might serve, in trade or business, to designate the characteristics of the applied for goods. Therefore, the applicant requested for a hearing on the registrability of the mark to be held. Since no evidence of use of the mark prior to the date of application could be adduced, the Registrar had to consider the case only on prima facie basis during the hearing.

At the hearing, the applicant argued that the term "NAKED" did not directly describe/refer to condoms or of the sensation experienced by the user of a condom and that it was not commonly used by other traders to describe such goods. In support, the applicant submitted that the corresponding mark had been accepted for registration in the U.S., European Community, Japan, South Korea and Mexico. However, the Registrar still considered that the mark "NAKED", having a meaning "having no covering", conveyed a direct and immediate message that the goods would make the users feel "naked" or nearly-naked as if the condom was not even there. Further, the Registrar drew the applicant's attention to the Internet searches that the term "naked" had indeed been commonly used by traders to describe and designate the characteristics of the goods "condoms". The consumers would therefore perceive the mark "NAKED" as merely describing a characteristic of the applied for goods, as opposed to denoting the trade origin. As the Registrar found there were valid reasons for refusing the application for registration, he was not prepared to give any weight on the acceptance of the correspondence mark in other countries.

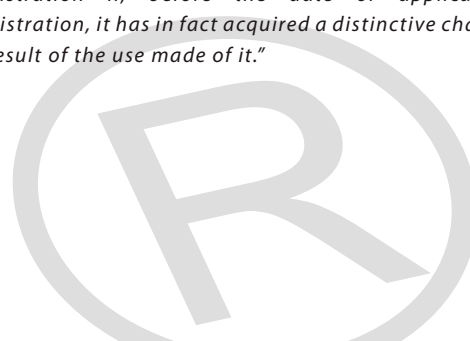


In conclusion, the Registrar upheld that application of the mark "NAKED" in Class 10 was precluded from registration and refused due to it being descriptive of the goods and devoid of any distinctive character.

Of the above case, we may observe that it is a trend for the Examiner to search the Internet to find out whether or not the applied for mark is commonly used by traders to describe the same goods and/or services as claimed under the application. If your trade mark is found to be commonly used by traders to describe the goods and/or services as applied for in the same field of business, it would be very difficult for your trade mark application to be allowed for registration.

Nevertheless, it may still be possible for a trade mark which is devoid of distinctive or descriptive of goods/services to be allowed for registration if that trade mark has, before the date of filing the application, acquired distinctiveness through long and extensive use by the applicant.

*"Under the Hong Kong Trade Marks Ordinance (Cap.559), Section 11(2) - that a trade mark shall not be refused registration 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."*



## 不獲註冊的商標

商標是一種標誌，它可以是文字(包括個人姓名、設計式樣、字母、數字、圖形要素、顏色、聲音、氣味、商品的形狀或其包裝或者前述項的任意組合。在世界上大部分地區包括香港，商標可註冊的基本要求是商標本身必須擁有某些顯著性的要素，從而可以將某一企業的商品或服務與其他企業的商品或服務作出識別。一些欠缺顯著特性的、對商品或服務具有描述性的、地理名稱、或是違反道德原則、又或是國旗/區旗等等的商標都難以獲准註冊。

下文為香港商標註冊處對一個商標的顯著性作出的判決案例，由此案例反映出一個被認為欠缺顯著性以及對商品/服務具有描述性的商標是很可能會被註冊處拒絕註冊的。

2008  
December

### 商標“NAKED”

香港商標申請號：300765009  
第10類商品

申請人Creative Resources LLC，對其標誌“NAKED”以第10類商品“保險套”提出商標註冊申請。在審查申請的階段，該商標申請被註冊處拒絕註冊，理由是：(i)申請標誌欠缺顯著性；及(ii)申請標誌純粹由可在行業或業務中用作指明商品的特性的標誌構成。於是，申請人要求商標註冊處就申請商標的可註冊性進行聆訊。由於申請人未提交任何在申請日期前就該商標的使用證明，所以，在聆訊期間，註冊官只基於表面證據就該商標的本身可註冊性作出考慮。

申請人提出辯駁指：“NAKED”一字並沒有直接描述/涉及保險套，或是直接描述/涉及使用者對保險套用後的感覺；再者，它並不是廣泛地被其他商戶用作對同類商品的描述。為得到支持，申請人提交證明顯示，相應的商標已分別在美國、歐共體、日本、南韓及墨西哥獲准註冊。但註冊官堅持認為，“NAKED”一字含義為“沒有遮掩”，傳達了一種直接及即時的訊息，以致消費者認為該商品會令使用者感到“無遮掩”或是近乎無遮掩的，如同沒有配帶保險套一樣。另外，從網絡搜查得到的結果顯示：“NAKED”一字實際上已廣泛地被其他商人用來描述及指明商品“保險套”的特性。所以，有關消費者只能辨識到商標“NAKED”是用來形容商品的特性，而非用來顯示該申請註冊的商品是源自某一企業。由於註冊官認為有令人信服的理據支持拒絕該商標申請註冊，因此，申請人的同等商標在其他國家獲得註冊的證明不予以考慮。

結論，註冊官最後認定該申請標誌欠缺顯著性以及對商品具有描述性，因此，“NAKED”在第10類的商標申請案被予以駁回並不獲准註冊。

從上述的案例，我們可察覺到現今註冊官在對商標註冊申請案作出審查時，往往趨向於從網絡上檢索



查證該申請標誌是否已廣泛地被相同行業的其他商人用來描述申請標記的商品。如果你的商標在網絡上已被同行業其他商人廣泛地用來描述所申請標記的商品或服務，那麼，你申請該商標註冊將會存在一定的困難。

然而，該欠缺顯著性或對商品具有描述性的商標仍然有機會能獲准註冊，只要該等商標在註冊申請日之前已被申請人通過長期及大量使用而變成實際上具有顯著性。

*“商標條例第11條第2款 - 如任何商標在註冊申請日期前已因其付諸使用而實際上具有顯著性，則不得拒絕註冊該商標”*

