

Application No. 1048 of 1995

IN THE MATTER of the Trade Marks  
Ordinance (Cap. 43)

AND

IN THE MATTER of application no. 1048  
of 1995 by New T & T Hong Kong  
Limited to register the trade mark  
“香港新電訊” in Class 38

**DECISION  
OF**

Ms Fanny Pang acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's Decision made by Messrs. Robin Bridge & John Liu on behalf of the applicants.

1. On 27 January 1995, New T & T Hong Kong Limited, a corporation organised and existing under the laws of Hong Kong (“the applicants”), applied to register, in Part A of the Register, the trade mark “香港新電訊” in Class 38 in respect of “asynchronous transfer mode data transmission services; cable television broadcasting; circuit leasing; communication services between computers; electronic communication services; telephone communication services; data services; digital cordless telephone services; digital data services; delivery of messages by electronic media; electronic mail services; electronic order-transmission; facsimile communication services; mobile radio communications; multimedia communication services; paging services; radio broadcasting; radio communication services; radio-paging services; subscription television broadcasting; telecommunication services; telegram communication services; telegraph services; telephone services; teleprinter communication services; teletext services; television broadcasting; telex services; videotext services; viewdata services; voice communication services; wireless communication services; wireless telephone services; rental of communication apparatus, electronic mail-boxes, signal decoders, signalling apparatus, telecommunication apparatus and telephones; transmission of information in relation to all the foregoing services; preparation of reports in relation to all the foregoing services; advisory services in relation to all the foregoing services; all included in Class 38.”

2. By a letter dated 9 January 1996, the Registrar of Trade Marks (“the Registrar”) objected to the application on the ground that the characters “香港” meaning “Hong Kong” carry a strong geographical signification and are not registrable under section 9(1)(d) of the Trade Marks Ordinance. The character “新” meaning “new” is totally indistinctive. The characters “電訊” referring to “communication by electronic means” is indistinctive in connection with telecommunication services. Therefore, the mark is not registrable under section 9(1)(d) and (e) of the Trade Marks Ordinance. Objection was also taken under section 10 of the Trade Marks Ordinance that the mark is not inherently capable of distinguishing the applicants’ services from similar services of others.

3. In response to the objection raised in the Registrar’s letter dated 9 January 1996, the applicants in their considered reply dated 22 October 1996 submitted, inter alia, that they do not agree with the Registrar that the mark directly refers to the character or quality of the services or that the mark is not distinctive. It was stated in **Burroughs Wellcome & Co.’s Trade Mark [1904] 21 RPC 217 at 226** that the mark need not be absolutely unsuggestive. It has also been said that “direct reference corresponds in effect, to aptness for normal description” (**American Screw Co.’s application [1959] RPC 344 at 346**). Furthermore, Dixon C. J. expressed the view in **Mark Foy’s Ltd v. Davies Coop & Co. Ltd. [1956] 95 CLR 190 at 194-195** that, “the test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess”. The applicants contended that based on the aforesaid

authorities, the relevant section of the public in Hong Kong would not associate the mark with the character or quality of the services in Class 38. They further submitted that even if part of the mark is considered objectionable, that would not automatically render the whole mark unregistrable. They are prepared to disclaim the right to the exclusive use separately of the characters “香港”, “新” and “電訊” and believe that this would not inhibit other traders in the legitimate promotion of their businesses and services.

4. What was submitted in paragraph 3 above was not agreed by the Registrar. In a letter dated 20 November 1996 the Registrar pointed out that “香港新電訊” can simply be translated as “Hong Kong new telecommunications”. The mark is plainly descriptive of the subject services which are mainly communication and telecommunication services. The mark indicates that there are new or innovative aspects in relation to these services compared to similar services offered in the market. The mark as a whole is descriptive and laudatory so that it is not registrable under section 9(1)(d) and (e) of the Trade Marks Ordinance.

5. In response to the Registrar’s letter dated 20 November 1996, the applicants filed a considered reply on 20 May 1997. The arguments contained therein are reproduced as follows :

“Under section 9(1)(d) of the Trade Marks Ordinance, the key test is whether the description is “direct”. We submit that the words in the above service mark is indirect. Arguably, almost every immediately (I think the word “attractive” is left out here) trade mark is in some sense, descriptive or laudatory. However, the words in the above service mark are not intended to convey a meaning with reference to telecommunication services. We would argue the use of the words is dramatic and intended to lure the public to the services without making any claim as to their character or quality.

As Dixon C.J. expressed in *Mark Foy’s Ltd v. Davies Coop & Co. Ltd.*, ‘The fallacy of asking what is the meaning of the phrase lies in basal assumptions that the words are intended to convey some definite meaning and perhaps the further assumption that the meaning has reference to the garments or cottons. The assumption is fallacious because it overlooks the fact that language is not always used to convey an idea. Many uses of words are purely emotive.’

Based on the above authority, we submit that the service mark “香港新電訊” should be seen only to be a label, a name without any value or meaning, and that the public would not associate the above mark as to the character or quality of the services in Class 38.”

6. At this point, there is a side issue which I need to mention. By a letter dated 14 October 1997, the Registrar informed the applicants in this application that we had received applications for the registration of the trade marks “Hong Kong Telecom” and

“香港電訊” of Pending Application Nos. 15532/95 and 15533/95 respectively. Although the applicants' present application is the earlier filed application, the later applicants for the marks “Hong Kong Telecom” and “香港電訊” claimed prior use of the mark. The present application and the two pending applications were then made co-pending and cited against each other under section 21 of the Trade Marks Ordinance. In response to that, Messrs. Robin Bridge & John Liu (“the agents”) sent in written submissions on behalf of the applicants by their letter dated 8 April 1998. Having considered the submissions of the agents, the Registrar decided to unlock the co-pendency of the present application together with the Pending Application Nos. 15532/95 and 15533/95. Therefore, the later filed pending application nos. 15532/95 and 15533/95 are not given priority over the present application. The later filed pending applications will be considered separately. Thus, the co-pending issue has been resolved and I do not intend to elaborate the details of the Trade Marks Registry's practice on applications made co-pending under section 21 of the Trade Marks Ordinance and the submissions of the applicants' agents in that regard in this decision.

7. Going back to the registrability of the mark, notwithstanding the further submissions made by the applicants in their letter dated 20 May 1997, the Registrar in his letter dated 11 February 1998 maintained the objections raised and maintained the refusal of the application. By a letter dated 8 April 1998, the applicants' agents further contended that the examiner's objections did not take account of the fact that the mark functions as a trade mark in respect of the applicants' services and, when used in relation to those services, indicates their origin. They said that the mark differentiates the applicants' services from those of others. For example, the presence of the character “新” meaning “new” gives the impression that the applicants' services are different and are set aside from other services. At worst, they argued, the mark is suggestive but it nevertheless retains the capacity to distinguish the applicants' services. In order to facilitate acceptance, the agents said that the applicants are prepared to transfer the application to Part B and to accept appropriate disclaimers of the more suggestive elements of the mark.

8. By a letter dated 27 January 1999, the Registrar maintained that the mark is not capable of distinguishing. The Registrar stated in his letter that the mark indicates plainly that the services provided are new kinds of telecommunication services in Hong Kong. In this context, the character “新” meaning “new” is not considered to be able to distinguish the applicants' services from those of others. The character “新” is commonly used by other traders in relation to new kinds of goods or services. As a whole, the mark has little or possibly no inherent distinctiveness. The application has to be refused registration in Part A or Part B. The Registrar's letter also touches upon the issue of co-pending applications which I have covered in paragraph 6 above.

9. It is in respect of the decision in the letter dated 27 January 1999 that I am now asked to state in writing the grounds of my decision and the materials used by me in arriving at it under Trade Marks Rule 20(2).

10. No evidence of user has been put before me and no special circumstances have been drawn to my attention. I have, therefore, only the prima facie case to consider. I shall elaborate this point later in paragraph 25 below.

11. The trade mark applied for consists of five Chinese characters “香港新電訊”. The characters “香港” clearly refer to “Hong Kong”. The 1987 New Lin Yu Tang Chinese-English Dictionary includes among the meanings of “新” “new”, “modern”, “novel” and “recent and fresh”. The characters “電訊” are defined in the dictionary as “1. Telecommunications. 2. (Telegraphic) dispatch.” The characters “香港新電訊” as a whole mean “Hong Kong New Telecommunications”.

12. The 1991 Edition of Collins English Dictionary includes among the meanings of “new” the following meanings which I consider are the most relevant for the purpose of this application :

“recently made or brought into being ...; of a kind never before existing; novel ...; markedly different from what was before ...; up-to-date; fashionable ...”

13. The 1991 Edition of Collins English Dictionary defines “telecommunication” as “the telegraphic or telephonic communication of audio or video information over a distance by means of radio waves, optical signals, etc. or along a transmission line.” “Telecommunications” is defined as “(functioning as sing.) the science and technology of communications by telephony, radio, television, etc.”

14. The characters “香港” meaning “Hong Kong”, according to their ordinary signification, are a geographical name and thus not registrable under section 9(1)(d) of the Trade Marks Ordinance. The characters “電訊” meaning “Telecommunication(s)” have a direct reference to the character of the specified telecommunications services. The character “新” meaning “new, novel and up-to-date” has a direct reference to the quality of the specified telecommunications services. The characters “香港”, “新” and “電訊” used in combination clearly refer to new, novel and up-to-date telecommunications services in Hong Kong. Therefore, the characters “香港新電訊” have a direct and close reference to both the character and quality of services relating to telecommunications and are not registrable under section 9(1)(d) of the Trade Marks Ordinance.

15. I am not convinced by the applicants' agents' submissions that the mark differentiates the applicants' services from those of others. I do not find the presence of the character “新” meaning “new” identifies the services as being the applicants' services. The character “新” meaning “new” is both laudatory and descriptive. Its presence in the mark indicates that the telecommunications service provider, or the telecommunications service itself, is new, novel and up-to-date.

16. In deciding this matter, I am guided by what Lord Hanworth M.R. said in the **Charm Case [1945] RPC 421 at 426, lines 20-23** :

“I think one has to look at the word which is registered, not in its strict grammatical significance, but as it would represent itself to the public at large who are to look at it and to form an opinion as to what it connotes.”

Even if the position of “新” in the mark is grammatically unusual, there is no variation in the meaning of the whole mark as a result thereof.

17. The applicants have in their considered replies quoted some passages from the case of **Mark Foy's Ltd.** (paragraphs 3 and 5 above refer). In that case, one of the questions before the court was whether the words “Tub Happy” are words having no direct reference to the character or quality or the goods which are articles of clothing. At page 194, lines 8-29, Dixon C. J. said :

“It is, I think, a mistake first to assume that words like “Tub Happy” do convey a meaning either to people in general or to a particular class of persons and then on that assumption to inquire what exactly the meaning is. Indeed to institute a search for a meaning almost necessarily implies that in ordinary English speech the words do not possess a connotation sufficiently definite to amount to a direct reference to the character or quality of the goods. And that is true even when to standard English usage is added all the figurative idiomatic and slang phraseology that may be currently in use. Once, however, the question is asked what do the words mean and there is started a search for a meaning, a process of analysis and of reasoning by exclusion of alternatives is begun. No doubt such a search may, without any sacrifice of logic, and in construing the words as meaning that the garments will emerge happily from the washtub. But if they are so interpreted, the interpretation is chiefly the consequence of failure to find another meaning. I venture to think, however, that a man, or for that matter a woman, hearing for the first time the words used in combination in connection with cotton garments, would not so understand the words at once. Certainly such a person would not so understand them intuitively and without stopping to reflect and ask himself or herself what meaning the words could really possess.”

It was held by the court that “the words ‘Tub Happy’ being in the nature of a coined phrase with but the remotest reference to the character or quality of articles of clothing were validly registered as a trade mark in respect of such articles”.

18. The applicants apply the reasoning and test in the **Mark Foy’s Ltd.’s** case and conclude that the mark is only suggestive and that the public would not associate the mark with the character or quality of the telecommunications services. However, having applied the reasoning and test in **Mark Foy’s Ltd.’s** case to this application, I draw an entirely different conclusion. I am in no doubt that the majority of ordinary people in Hong Kong seeing or hearing the characters “香港新電訊” would understand them to be describing the nature of the specified services, that is telecommunications services, and to be describing an attribute the services possess, that is, being new, novel, and up-to-date. I conclude that the characters are wholly descriptive. I cannot conclude that the characters indicate the trade origin of the services. Unlike the “**Tub Happy**” case, the characters “香港新電訊”, when used in combination, do convey a meaning on first impression. The meaning of the characters is directly descriptive. There is no need to institute a search for the meaning or to go through a process of analysis and reasoning to determine the meaning the mark conveys.

19. I have relied also on the test for registration in Part A as stated in **Smith, Kline & French Laboratories Ltd’s Trade Mark** (applying **W&G Case [1913] 30 RPC 660 [1976] RPC 511 at 538, 539, H.L.**, where it was said the question whether a mark is inherently adapted to distinguish “must largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods”. In the present case, for reasons I have given, I find that the mark is clearly and directly descriptive of new telecommunications services provided in Hong Kong; that it is apt for use by other traders to describe their services, and attributes of their services in telecommunications; and that it is not inherently adapted to distinguish.

20. Given the descriptiveness of the mark “香港新電訊”, as mentioned above, it cannot be distinctive within the terms of section 9(1)(e) of the Trade Marks Ordinance.

21. The applicants have indicated that they would be content to convert the application to one for Part B of the Register and have offered to disclaim the right to the exclusive use, separately, of the characters “香港”, “新” and “電訊”.

22. As to the possibility of registration in Part B of the Register under the terms of section 10 of the Trade Mark Ordinance, I take the view that the objections which preclude acceptance in Part A apply equally to Part B. As Lloyd Jacob J. remarked in the **TORQ-SET Trade Mark [1959] RPC 344 at 346, lines 37-39** :

“Part B of the register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders.”

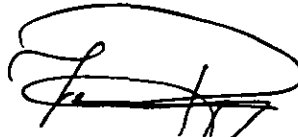
23. The characters “香港”, “新” and “電訊” in combination are an apt term to describe new, novel and up-to-date telecommunication services in Hong Kong. Other traders setting up a new telecommunication company in Hong Kong or an existing telecommunication company providing a new type of telecommunication service in Hong Kong should be entitled to draw the public’s attention to the nature and novelty of the service by use of the term “香港新電訊”. I consider that the registration of the mark even in Part B of the register is likely to inconvenience other traders who provide the same or similar services and who might legitimately wish to use the term “香港新電訊”, or a term nearly resembling “香港新電訊” in the descriptive sense in relation to their services or in advertising their services.

24. So far as the disclaimers offered by the applicants are concerned, I will borrow the words of Mr. Myall in the case of **Phillip Morris Inc’s Trade Mark Application [1980] RPC 527 at 533** that “the public have no notice of disclaimers, except in so far as they are entered on a register open to public inspection, and a disclaimer is not to be regarded as a means of getting mark registered that is clearly not registrable per se without a disclaimer”. I consider that the proposed separate disclaimers of the characters “香港”, “新” and “電訊” do not assist this application. The joinder of the characters “香港”, “新” and “電訊” are not a sufficient difference from the characters used separately. The combination of “香港”, “新” and “電訊” does not create a fanciful whole. I am not satisfied that the joinder renders the mark inherently capable of distinguishing any more than use of the Chinese characters “香港”, “新” and “電訊” separately could be held to do so.

25. Evidence of distinctiveness is needed to register a highly descriptive or laudatory mark. However, some marks are so highly descriptive or laudatory that distinctiveness in fact, proved by user evidence, cannot establish a capability to distinguish. In such cases, registration, even in Part B, must be refused as the inherent incapability of the mark is such that even 100 per cent factual distinctiveness cannot counterbalance it (see **Burger King Corp. v. Registrar of Trade Marks [1973] 128 CLR 417** and **YORK Trade Mark [1984] RPC 231, H.L.**). Having said that, no evidence has been filed by the applicants so that I need not go into the issue as to whether the mark has any inherent distinctiveness as to be registrable on evidence of use. In the present case I find the mark is highly descriptive and laudatory and as there has been no user evidence, I have no doubt that registration has to be refused.

26. I therefore conclude that, prima facie, the mark is not capable of distinguishing the applicants' services and that it thus fails to satisfy the requirements of section 10 of the Trade Marks Ordinance.

27. In this decision I have considered all the material available before me and all the arguments submitted by the applicants in relation to this application and, for the reasons given, the application is refused under the terms of section 13(2) of the Trade Marks Ordinance because it fails to qualify under sections 9 and 10 of the Trade Marks Ordinance.



(Ms Fanny Pang)

p. Registrar of Trade Marks  
30 October 1999