

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 200020794AA

MARK: “d-cinema”

CLASSES: 9, 38 AND 41

APPLICANT: YAMAHA KABUSHIKI KAISHA
(YAMAHA CORPORATION)

STATEMENT OF REASONS FOR DECISION

Background

1. On 16 September 2000, Yamaha Kabushiki Kaisha (Yamaha Corporation) (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.43, repealed), to register the following mark:

d-cinema

(“the subject mark”) in Classes 9, 38 and 41 respectively.

2. Upon the applicant’s request, the three applications were converted for examination under the provisions of the Trade Marks Ordinance (Cap.559)(“the Ordinance”) and were accorded the filing date of 4 April 2003. The three applications were subsequently merged into a single application upon the applicant’s request.
3. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance as the mark consists, exclusively of the word “d-cinema”, meaning “digital cinema”, the whole being devoid of any distinctive character and being a sign which may serve, in trade or business, to designate the characteristics of goods and services.
4. The applicant requested a registrability hearing which took place before me on 1 March 2005. The applicant was represented by Ms. Denise Novaes-Hingorani of Messrs. Johnson Stokes & Master. I reserved my decision at the end of the hearing.
5. On the day of the hearing, the applicant requested to amend the specification of

goods and services applied-for registration by deleting the entire specification of services in class 38 and restricting the specifications in classes 9 and 41 to the following:

Class 9

Loudspeakers, radio receivers, audio amplifiers, optical disc players, audio and/or video receivers; all included in Class 9
(hereinafter referred to as the "specified goods")

Class 41

Radio entertainment, organizing live shows; all included in Class 41

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

The law

7. The relevant part of the Ordinance under which the objections were taken is as follows:

Section 11(1):

“Subject to subsection (2), the following shall not be registered-

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");
- (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) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.”

The applicant’s submissions

8. Ms. Denise Novaes-Hingorani’s main submissions were as follows:
 - (a) In the absence of any dictionary definition of “d-cinema” as the synonym of “digital cinema”, the subject mark holds no ordinary significance other than being a sign applied on the applicant’s products to distinguish its products

from similar products of other undertakings.

- (b) The goods which are to be sold under the mark are not targeted at a specialist market and are essentially for use in the home and have no connection with “digital cinema”. The subject mark is neither directly descriptive nor commonly used in relation to the applicant’s services in class 41.
- (c) The subject mark has been accepted for registration in other countries. The foreign acceptances show that the subject mark is distinctive or capable of being distinctive of the applied for goods and services particularly in the English speaking country of Australia where the trade mark laws and practices are similar to those in Hong Kong.
- (d) There is sufficient stylization in the mark to warrant registration in respect of the applied-for goods and services.

9. No authorities were submitted to support the submissions.

Decision

- 10. The subject mark comprises the term “d-cinema” represented in the lower case with the letter “d” slightly slanted and larger than the word “cinema”. As a whole, I find that there is no stylisation in the mark and the mark will simply be referred to as “d-cinema”.
- 11. The letter “d” in "d-cinema" is the acronym for the word “digital”¹. Collins English Dictionary² provides the following definition of the word “cinema”:
 - a place designed for the exhibition of films; the art or business of making films; films collectively
- 12. According to TechEncyclopedia³, “d-cinema” means (1) the projection of movies in digital format using digital projectors such as the DLP units from TI and (2) refers to any aspect of movie making in the digital domain including capture, editing, distribution and presentation.

¹ www.acronymfinder.com

² Third Edition Updated 1994

³ www.techweb.com

13. According to Home Theater Glossary⁴, “D-cinema” is defined as follows:

“Digital cinema. Typically the process of using video at 1080/24p instead of film for production, post production and presentation.”

14. Prior to the hearing, searches were conducted on the Internet on the term “d-cinema” and the results of the searches were sent to the applicant. The searches indicate that “d-cinema” is the synonym of “digital cinema” and is commonly used to refer to “digital cinema”. The two terms are used interchangeably by other traders. In view of the above definitions and the Internet findings, I consider that “d-cinema” is the equivalent of “digital cinema”.

15. Based on the above definitions and results of the Internet findings, “d-cinema”/ “digital cinema” refers to the whole process of making, capturing, editing, distribution/delivery and presentation/showing of movies or programmes in the digital domain. The term "d-cinema" is not limited to the premise where films are shown and its meaning is broader than the conventional cinema. In relation to film making, digital cinema refers to the replacement of conventional 35mm film and projectors with digital files and high resolution digital projectors. It encompasses the process whereby images are captured and edited by using digital camera, digital recording technology and computer techniques and subsequently compressed into digital files. The digitalized movie or programme is then delivered to the theater or the designated viewing place by physical means such as a DVD disk or through electronic transmission via satellite, fiber optics or the Internet. After being delivered to the designated place which could be located anywhere such as theaters, outdoor screens or even the viewer’s home, the movie or programme is displayed by digital projectors and equipment. D-cinema does not only transmit movies, it also transmits non-movies programmes such as live concerts and sporting events in real time by satellite. A live concert can be transmitted via satellite to a theater located somewhere other than the concert venue and projected at the same time the concert is performed. As the whole process is digitalized, the quality of the picture and sound is greatly enhanced with high clarity, definition and resolution.

The specified goods in Class 9

16. Section 11(1)(c) of the Ordinance excludes registration of trade marks which may

⁴ www.hobbytheater.com/glossary

serve, in trade or business, to designate *inter alia*, the kind, quality, intended purpose or other characteristics of goods or services. Having determined that “d-cinema” means “digital cinema” and having regard to the meaning of "d-cinema" in paragraph 15 above, I need to consider if the subject mark consists exclusively of signs that designate the characteristics of the specified goods and is precluded from registration under section 11(1)(c) of the Ordinance.

17. The goods in the class 9 specification are “loudspeakers, radio receivers, audio amplifiers, optical disc players audio and/or video receivers”. These are all indispensable equipment for the display of movies or audio-visual products used in the theatre, exhibition hall, outdoor screens or the home. When the mark is applied to the specified goods, it designates the intended purpose of the said goods as being goods that can be used to receive and show digital cinema movies or programmes that have been produced and distributed by the digital cinema process as explained in paragraph 15.
18. Apart from designating the intended purpose of the specified goods, in my view, the subject mark also designates the quality or characteristics of the specified goods as goods capable of producing sounds or images with quality that is of high clarity, definition and resolution. Even if the applicant’s goods are intended for use in the home as submitted by Ms. Noveas-Hingaroni and are not related to the digital cinema technology, the subject mark would still be considered descriptive of the quality or characteristics of the goods in question. Given the popularity of home theaters, the mark conveys the immediate message that the specified goods employ high-end technology that is capable of bringing the digital cinema experience to consumers in their homes. The mark therefore designates the high quality audio and visual effects produced by the specified goods.
19. For the above reasons, I also consider that "d-cinema" is a descriptive term that other traders may wish to use in designating the relevant characteristics, quality or intended purpose of similar goods. I am not satisfied that the applicant should be conferred a monopoly on the use of such a descriptive term in relation to the goods in question.
20. Based on the aforesaid, I conclude that the mark consists exclusively of a sign which may serve, in trade or business, to designate the intended purpose, quality or characteristics of the specified goods. As such, the mark is debarred from registration in respect of the specified goods under section 11(1)(c) of the Ordinance.
21. Having found that the subject mark is debarred from registration by section 11(1)(c)

of the Ordinance in relation to the specified goods, I now consider whether the mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance.

22. In “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37, Mr. Geoffrey Hobbs as the Appointed Person, stated that the test of registrability under section 11(1)(b) resides in the question "whether the perception and recollections that the sign in issue would trigger in the mind of the average consumer of the specified goods or services are likely to be origin-specific or origin-neutral".
23. 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.”

24. Applying the above legal principles, I must assess the distinctiveness of the mark in relation to the specified goods for which the applicant seeks registration. I must also have regard to the perception of an average, relevant consumer of the specified goods who is reasonably informed and observant.
25. As I had stated earlier in paragraph 10, the subject mark does not have any stylization nor does it consists of any element to bestow it with distinctiveness.
26. To my mind, the relevant consumer of the specified goods would be consumers of audio and visual equipment. For the same reasons that I have found the subject mark to be excluded from registration under section 11(1)(c) of the Ordinance, I also conclude that the relevant consumer would not perceive the subject mark as denoting the trade origin of the specified goods. The relevant consumer will, upon seeing the subject mark in relation to the specified goods, perceive it as merely descriptive of the intended purpose, quality or characteristics of the specified goods. Descriptive terms of this nature may equally be applied by other traders on goods of similar nature. Therefore, consumers would not regard it as identifying goods as originating from a particular undertaking. In other words, the perception and recollections that the subject mark would trigger in the minds of the average consumer are likely to be origin neutral.

27. Based on the above reasons, I find that the mark is devoid of any distinctive character and is precluded from registration in respect of the specified goods under section 11(1)(b) of the Ordinance.

Services in Class 41

28. In relation to live shows, digital cinema could mean the simultaneous transmission of live shows to other places. However, the services in class 41 are "radio entertainment and organizing live shows" and not the transmission or broadcasting of live shows. Accordingly, the subject mark is not descriptive of the applied-for services or the characteristics of such services. The objection under section 11(1)(c) of the Ordinance is therefore not applicable to the applied-for services in class 41.

29. As stated in the foregoing paragraph, I do not consider the subject mark to be descriptive of the services in class 41. Furthermore, I do not consider that the subject mark is a term that is apt for use by other traders. Hence, I find that the mark is not devoid of any distinctive character and the objection under section 11(1)(b) of the Ordinance is not applicable to the applied-for services in class 41.

Acceptance of the subject mark in other jurisdictions

30. Ms. Novaes-Hingorani argued that the fact that the mark has been accepted for registration in other jurisdictions show that the mark is distinctive particularly in English speaking countries such as Australia. I do not agree with her argument. The fact that the subject mark is registered in other jurisdictions does not necessarily mean that it is distinctive. It must be borne in mind that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885).

31. I have noted the acceptances of the subject mark in other jurisdictions but as the reasons and circumstances for the said acceptances were not provided to me and in view of the reasons for refusal, I am not prepared to accept the mark for registration on the basis of the foreign registrations.

Conclusion

32. The subject application is a multi-class application covering both the specified goods

in class 9 and services in class 41. For the reasons stated above, objections are raised against the subject mark in relation to the goods in class 9 under sections 11(1)(b) and (c) of the Ordinance. As I am not satisfied that the requirements for registration are met in relation to the goods in class 9, the application in relation to class 9 is refused under section 42(4)(b) of the Ordinance.

33. In relation to the services in class 41, I am satisfied that the requirements for registration are met based on the reasons stated in paragraphs 28 and 29. The application in respect of class 41 can proceed to publication provided that an application (on Form T3) to divide the application into two, one in respect of class 9 and the other in respect of class 41, is filed on or before **30 May 2005**, failing which the application in respect of the services in class 41 is deemed abandoned by the applicant.

Theresa S.Y. Mak
for the Registrar of Trade Marks
28 April 2005