

Trade Mark Application

No. 9988 of 2001

IN THE MATTER of the Trade Marks

Ordinance (Cap. 43)

AND

IN THE MATTER of an application for the
registration of the trade mark



in Part A in Class 9 by Kabushiki Kaisha Sony
Computer Entertainment (Sony Computer
Entertainment Inc.)

DECISION

OF

Mr Patrick Yeung acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's decision made by Messrs. Lovells on behalf of the applicant on 24 March 2006.

Background

1. On 20 June 2001, Kabushiki Kaisha Sony Computer Entertainment (Sony Computer Entertainment Inc.) (the “Applicant”) applied under the Trade Marks Ordinance (Cap.43) (“the Ordinance”) to register, in Part A of the Register of Trade Marks in Class 9, a three-dimensional mark which is represented below:



Top View



Back View



Bottom View



Left View



Front View



Right View

(the “subject mark”)

2. The goods for which registration is sought under Class 9 are as follows:

“apparatus for games adapted for use with television receivers; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; data carriers for use with computer; game consoles, analog controllers, memory cartridges and cards”.

3. At the examination stage, the Registrar objected to registration on the grounds that the subject mark consists exclusively of the shape of goods that is necessary to obtain a technical result, contrary to section 12(3)(b) of the Ordinance. In addition, the subject mark is considered neither inherently adapted to distinguish nor inherently capable of distinguishing the goods of the Applicant from those of other traders, contrary to sections 9 and 10 of the Ordinance.
4. The registrability of the subject mark was discussed informally with the Applicant’s agent, Messrs. Lovells, on 27 February 2006. After the informal discussion, on 23 March 2006 the Registrar issued a letter to the Applicant setting out the above objections to registration. Pursuant to section 13(4) of the Ordinance and Rule 20(2) of the Trade Marks Rules (Cap. 43 sub. leg. A), the Applicant requested the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at it.
5. Although the Trade Marks Ordinance Cap. 559 came into operation on 4 April 2003, this application for registration is a “pending” application according to paragraph 10(1), Schedule 5 of Cap. 559. It therefore remains to be dealt with under the provisions of the Trade Marks Ordinance Cap. 43.

Contrary to section 12(3)(b)

6. Section 12(3)(b) of the Ordinance provides:

A sign shall not be registered as a trade mark relating to goods if it consists exclusively of –

- (a) ...
- (b) the shape of goods that is necessary to obtain a technical result; or
- (c) ...

7. Section 12(3) of the Ordinance is couched in terms identical to section 3(2) of the UK Trade Marks Act of 1994 (the “UK Act”) and Article 3(1)(e) of the Council Directive 89/104/EEC of the Council of the European Communities (the

“Directive”).

8. Section 3(2)(b) of the UK Act (equivalent to section 12(3)(b) of the Ordinance) has been considered by Rimer J in *Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2005] F.S.R. 17 at paragraph 31:-

"31. ... it appears to me that it must in every case simply be a question of fact as to whether or not the shape in issue falls foul of the prohibition. The task involved in answering the question requires an assessment of the shape in issue and an identification of its essential characteristics or features. If they are attributable solely to the achieving of the intended technical result, it will not be registrable as a trade mark and it will make no difference that the shape may include non-essential features which are not so attributable ..."

9. Rimer J's approach was seen as a two-stage analysis by the Court of Appeal (Civil Division), as stated in paragraph 38 in *Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2006] EWCA Civ 16:

"The first step is to identify the "essential characteristics or features" of the shape of the goods in issue. Once they have been determined, the next step is to determine whether the essential characteristics or features consisting "solely" of the shape of goods are attributable only to the technical result."

10. Regarding the first step as to how an essential feature of a mark should be identified, the Court of Appeal found that the underlying principle is to consider the perception of an average consumer of the mark as a whole:

"As in other areas of trade mark law the important factor is the impact of the mark on the eye of the average customer. The perception of the average customer for the goods in question does not depend on the dissection of the mark and on an examination of each feature of the mark. It turns on the feature which contributes most to the overall impression created by the whole mark. We do not accept Mr Carr's contention that any feature which contributes to the overall impression is an essential feature of the mark. Not every feature of the mark has the same visual impact. The question of essential feature was one of fact and degree for the judge..." (*Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2006] EWCA Civ 16 at paragraph 52)

11. Concerning the second step about determining whether the essential features consisting *solely* of the shape of goods are attributable *only* to the technical result,

the Court of Appeal found that Rimer J was right in deciding that while each essential feature must be shown to perform a function attributable to the technical result, not every single part of every single essential feature must be shown to be doing so.

“In summary, Philips' case was that, as all essential features of the mark must be attributable only to a technical result for section 3(2)(b) to apply and as parts of an essential feature are non-functional, then it could not be said that the essential features of that shape are attributable only to the technical result...

Like the judge we do not accept the submissions of Philips on this point. The judge was right to reject them... Fragmentation of a mark is not the proper approach, either with functionality or with distinctiveness. In order to decide whether the shape of the goods in question is necessary to obtain a technical result the court must consider the mark as a whole. That is how the relevant section of the purchasing public would perceive it. A trade mark is not treated by the public or by the court as a mere assembly of component parts. The individual parts may, of course, be looked at for the purpose of making the overall assessment of the impression created by the whole. Taking account of the essential elements of the mark, an assessment has to be made as to its functionality...”(*Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2006] EWCA Civ 16 at paragraphs 61-62)

12. In light of the above principles, I now proceed to consider the facts of the present case. As regards the first step of Rimer J’s analysis, namely, to decide what constitutes the essential features of the subject mark, I have taken into account the likely impact of the subject mark as a whole on the eye of the average customer. I find that the subject mark is essentially a shape of a flat rectangular box, which I consider to be the essential feature that contributes to the overall impression created by the whole mark.
13. I then proceed to the second step to consider whether the shape of a flat rectangular box is attributable solely to achieving the intended technical result. I find that the answer to the question must be in the positive. When used in relation to game consoles, the shape of a flat rectangular box is a regular and practical shape to provide room for housing all the parts and components of a game console as well as for storing an external object such as a memory card or a disc which needs to be inserted into the body of the game console. The flat shape with a broad rectangular

base also allows the game console to stand firmly and securely on a surface so that one could easily operate the game console by, for example, pressing a button on it or inserting a card or a disc into it. The shape is therefore primarily functional and is intended to achieve a technical result.

14. For the above reasons, I find that the subject mark, being essentially a flat rectangular box, consists exclusively of the shape of game consoles which is necessary to obtain a technical result. Therefore, the subject mark shall not be registered pursuant to section 12(3)(b) of the Ordinance.
15. The Applicant argued that the subject mark is not of a conventional rectangular block as it also contains other features such as round corners, a large circular lid at the top centre, two round buttons marked with symbols, two rows of dots on the circular lid, etc. The Applicant submitted that since the subject mark consists of these distinctive design features which do not serve any technical function, the mark cannot be said to be *solely* for achieving a technical result and the objection under section 12(3)(b) does not apply.
16. I do not find the Applicant's argument persuasive. As held in *Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2006] EWCA Civ 16 at paragraph 62 (see paragraph 11 above), in order to decide whether the shape of the goods is necessary to obtain a technical result, one must consider the mark *as a whole*. The fact that a shape consists of certain aesthetic or non-functional features does not preclude the operation of section 12(3)(b) if they are not the essential features or they are merely part of the essential features the totality of which is to perform a function attributable to a technical result.
17. Considering the subject mark in its entirety, I cannot accept that the features as mentioned by the Applicant are the essential features which contribute to the overall impression created by the whole mark. While the appearance of a piece of art may be closely examined by a consumer as every detail of its appearance may count, that is not the way how a consumer will perceive the subject mark on the applied-for goods which are electronic products used by the public at large. Taking into account the nature of the applied-for goods, I am of the view that the aesthetic features as mentioned by the Applicant are unlikely to be picked up by the relevant consumer as the essential features of the subject mark.
18. Furthermore, I am not persuaded that all those features as mentioned by the

Applicant serve no technical function at all. For instance, the lid serves as a cover for the aperture of the game console through which a card or a disc can be inserted. The two round buttons respectively for the functions of “power on/off” and “eject” are also necessary for the basic operation of the game console. The Applicant argued that the two buttons are “oversized” and that they did not have to be of that size or appearance to achieve the technical function of a game console, but I cannot agree with that. Greater ease and convenience in operating the product can in fact be achieved by pressing a bigger button.

19. The Applicant also argued that the shape of the goods as represented by the subject mark is not “necessary” to obtain a technical result as it may equally be achieved by other shapes. However, I find that such an argument cannot overcome the objection under section 12(3)(b) of the Ordinance.
20. The question of whether the objection under Article 3(1)(e) second indent of the Directive (equivalent to section 3(2)(b) of the UK Act) can be overcome by establishing that there are other shapes which can obtain the same technical result has been considered by the Court of Justice of the European Communities in *Koninklijke Philips N.V. v Remington Consumer Products Ltd* [2003] R.P.C. 2 at paragraphs 80, 81 and 83:

“80. As Art.3(1)(e) of the Directive pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function and were chosen to fulfill that function may be freely used by all, that provision prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

81. As to the question whether the establishment that there are other shapes which could achieve the same technical result can overcome the ground for refusal or invalidity contained in Art.3(1)(e), second indent, there is nothing in the wording of that provision to allow such a conclusion.

...

83. Where the essential functional characteristics of the shape of a product are attributable solely to the technical result, Art.3(1)(e), second indent, precludes registration of a sign consisting of that shape, even if that technical result can be achieved by other shapes.”

21. Therefore, all that has to be shown is that the essential feature of the subject mark is necessary to obtain a technical result. The assertion that a game console can be in other shapes does not assist to overcome the objection against registration of the subject mark under section 12(3)(b).
22. The Applicant has submitted two statutory declarations, one from Miss Monique Woo dated 27 March 2003 and the other one from Mr Sumio Ogino dated 25 April 2003, with a view to establishing the factual distinctiveness of the subject mark. However, distinctiveness or the lack of it has no direct relevance to the objection under section 12(3)(b) which cannot be overcome by proving that the mark has acquired distinctiveness through use.


Contrary to sections 9 and 10

23. Having found that the subject mark is objectionable under section 12(3)(b), it is strictly not necessary to test registrability under sections 9 and 10 of the Ordinance. However, as the objections under these provisions were also maintained at the informal discussion, for completeness I shall deal with these provisions below.
24. To be registrable, the subject mark must satisfy the provisions of section 9(1) or 10(1) of the Ordinance. As the subject mark is of three-dimensional shape, it does not fall within any of the categories of registrable marks under section 9(1)(a) to (d). I therefore only need to consider whether the mark is registrable under section 9(1)(e) (for Part A of the register) or section 10(1) (for Part B).
25. To fall within these sections, the subject mark must be distinctive. Distinctiveness means a mark is adapted to or is capable of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade, from goods where no such connection subsists. In determining whether a trade mark is adapted to or capable of distinguishing as aforesaid, the tribunal must have regard to the extent to which the trade mark is inherently adapted to or capable of distinguishing; and to the extent to which, by reason of the use of the trade mark or other circumstances, the trade mark is in fact adapted to or capable of distinguishing as aforesaid (sections 9(2) and 10(2)). The burden lies with the Applicant to establish that the subject mark is adapted to or capable of distinguishing.
26. In *Smith, Kline & French Laboratories Ltd's Applications* [1976] RPC 511 at 538

Lord Diplock re-stated the test of distinctiveness as laid down by Lord Parker in *W & G Du Cros Ltd's Application* [1913] 30 RPC 660 at 671-673 where he said that:

“...the right to registration should 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.”

27. The applied-for specification of the subject application consists of, inter alia, game consoles. The subject mark primarily indicates the shape of a flat rectangular box which represents a very common shape of game consoles. The answer to the question of whether other traders would legitimately desire to use a shape which is essentially similar or identical to the subject mark upon their goods must undoubtedly be in the positive. If the subject mark were to be registered, other manufacturers of game consoles would not be able to produce their products in this shape or a shape similar to it. That being the case, the subject mark is not inherently adapted to distinguish or capable of distinguishing the Applicant's goods from the goods of others.
28. In considering an application to register a mark, I must consider both its inherent adaptability to distinguish and also the extent to which it is shown by evidence to be distinctive: so that if the mark is inherently ill-adapted to distinguish the goods of any one trader, I must balance the one against the other. In extreme cases, the inherent unsuitability could be so strong that no degree of distinctiveness in fact can counter-balance it and in those cases, the marks are unregistrable (*Yorkshire Copper Works Ltd v Registrar of Trade Marks* [1954] 71 R.P.C. 150). In any event, in the present application I do not consider that factual distinctiveness of the mark has been proved to any extent on the basis of the two statutory declarations submitted by the Applicant.
29. Miss Monique Woo's statutory declaration has little relevance in demonstrating the factual distinctiveness of the subject mark since it merely shows the legal fees incurred on the protection of the Applicant's trade marks in Hong Kong and the number of counterfeit products bearing the Applicant's trade mark seized in Hong Kong between 1996 and 2001.
30. In Mr Sumio Ogino's statutory declaration, although the subject mark has been shown to be used in respect of game consoles (but not any of the other applied-for

goods), there is no evidence of use of the subject mark for game consoles *on its own* and none that would satisfy me that it has acquired recognition on its own as a badge of origin, assuming that it has at least some inherent adaptability to distinguish or capability of distinguishing. Copies of advertising and promotional materials attached to the statutory declaration show that the subject mark was not used on its own for game consoles but used with other distinctive marks such as  , **PlayStation** and SONY. These marks are more readily recognizable as a trade mark because the public is more inclined to recognize a word mark or a device as an indication of trade origin of the product. The public is less likely to view a mark as a sign to designate trade origin where the mark is the appearance of the product itself. Even though it was declared that the Applicant's sales of products in Hong Kong were significant and that the Applicant had spent millions of dollars on promoting the products, without any evidence showing the use of the subject mark on its own, there is no evidence showing the use of the subject mark on its own. I am not convinced that the subject mark has in fact become distinctive in that it would be perceived as a badge of origin. Consumers would simply see it as the shape of the product and nothing more.

31. Having considered the evidence as a whole, I cannot be satisfied that the subject mark would be perceived as having any trade mark significance. I accept that sometimes a non-distinctive sign used together with a distinctive mark on the same product can come to be regarded as a second trade mark capable by itself of distinguishing an applicant's goods, but that has not been shown to be the case here.
32. For the reasons given above, I find that the subject mark is neither inherently adapted to nor capable of distinguishing the Applicant's goods from those of other manufacturers, and has not been shown to do so in fact. No other circumstances have been placed before me. The subject mark is therefore found to be unregistrable pursuant to sections 9(1)(e) and 10(1) of the Ordinance.

Conclusion

33. Having found that the subject mark fails to qualify for registration under sections 9, 10 and 12(3)(b), I am bound to come to the conclusion that the application for registration of the subject mark is refused under section 13(2) of the Ordinance.

34. For completeness, I would like to point out that whilst the grounds of objection against registration of the subject mark stated herein were in respect of game consoles which are a type of apparatus for games adapted for use with television receivers and the applied-for goods in this application consist of other items as well, I consider that the Applicant, for practical purposes, has no intention to use the subject mark on other applied-for goods such as analog controllers and memory cards. In fact, there has been no submission or materials before me to show that the Applicant does or is intended to use the subject mark on goods other than game consoles. Therefore, in my opinion, the fact that the applied-for specification consists of not only game consoles but also other goods does not in any way affect my above conclusion that the subject application shall be refused.
35. In arriving at this decision, I have considered the application filed, the written submissions of the Applicant's agent dated 25 September 2002, 26 March 2003, 6 February 2004 and 4 February 2005 and the materials accompanying them, the arguments raised in the informal discussion held on 27 February 2006, Miss Monique Woo's and Mr Sumio Ogino's statutory declaration and the materials exhibited, the Trade Marks Ordinance (Cap.43), the Trade Marks Rules (Cap.43 sub. leg.) and the authorities cited herein.

Patrick Yeung
for the Registrar of Trade Marks
13 September 2006