

Trade Marks Ordinance (Cap 43)

IN THE MATTER of an opposition by Orange Personal Communications Services Limited to the registration of trade mark applications 20021548 – 1551 by Gamania Digital Entertainment Co Ltd to register the trade mark 遊戲橘子 in classes 9, 35, 38 and 42

DECISION

of

Teresa Grant acting for the Registrar of Trade Marks after a hearing on 20 June 2006

Appearing : Ms Jo Chan of China.hk Intellectual Property Services Co Ltd for the applicant for registration

1. The parties to the opposition are Gamania Digital Entertainment Co Ltd ('the applicant') who has filed four applications for registration of a trade mark under the Trade Marks Ordinance (Cap 43) and Orange Personal Communications Services Limited ('the opponent') who opposes the applications for registration under the Trade Marks Ordinance (Cap 43) section 15.

2. The Trade Marks Ordinance (Cap 43) was repealed on 4 April 2003 but it continues to apply to oppositions pending immediately before that date (Trade Marks Ordinance (Cap 559) Schedule 5 (transitional matters) section 1(1), (4), section 10(1), (2)).

3. The opposition hearing took place on 20 June 2006. Only the applicant's agent attended. The opponent's solicitors had informed the registry that the opponent would not attend the hearing.

4. The applicant's four applications are to register the same mark in classes 9, 35, 38 and 42. Under the Trade Marks Ordinance (Cap 43) the applications are separate applications. However, the hearing was in respect of all four applications and as the issues to be considered are the same, this decision relates to the opposition to all four.

Grounds of opposition

5. The grounds of the opponent's opposition to registration of applicant's mark under the Trade Marks Ordinance are:

section 12(1) (applicant's mark likely to deceive or cause confusion in view of the reputation of the opponent's marks; alternatively, use of applicant's mark disentitled to protection in a court of justice); section 20 (applicant's mark identical with or nearly resembling opponent's registered mark for goods of the same description or services of the same description); section 23 (applicant's mark identical with or nearly

resembling opponent's marks registered in country of origin); section 2 (applicant's mark not used or proposed to be used in relation to goods or services so as to indicate a connection in the course of trade); sections 9 and 10 (applicant's mark not distinguishing the applicant's goods or services in the course of trade); section 13(1) (applicant not entitled to be registered as proprietor); and section 13(2) (applicant's application should be refused in exercise of registrar's discretion).

Applicant's mark

6. The applicant filed the four applications for registration of the mark on 2 February 2002. The trade marks registry examined the applications and accepted them subject to a disclaimer that 'registration shall give no right to the exclusive use of the Chinese characters 遊戲'. The applications for registration were advertised on 1 November 2002 and opposed on 2 January 2003. The mark and the applications are as follows:

遊戲橘子

application number 200201548 for 'magnetic tapes and disk for storing computer programs, credit cards, banking cards, computer software, recorded computer programs, floppy disk boxes; all included in class 9';

application number 200201549 for 'import-export agency services; all included in class 35';

application number 200201550 for 'electronic transmission of data and documents via facsimile machines, word processing machines, computer terminals and personal computers; communication services for accessing a data-base; telecommunication services provided in relation to the internet; all included in class 38';

application number 200201551 for 'design, maintenance, testing, analysis and consultancy of computer software and program; rental of computers; all included in class 42'.

Opponent's marks

7. The opponent relies on the registration, use and reputation of its trade marks already on the register or applied for at the date of the applicant's application for registration. The opponent's notice of opposition and evidence refers to its registrations for a wide range of goods and services in many classes. Of the many registrations referred to, the registrations relevant to this opposition, because they cover goods and services for which the applicant has applied, are as follows:

ORANGE

in classes 9, 16, 28, 35, 36, 37, 38, 39, 41 and 42, registration numbers 199910683, 200212249, 200310974, 200311682, 200300535, 200213693, 199702325, 200214911, 200315353, 200305992, respectively;



in class 9, registration number 199910684;



in classes 16, 28, and 36, registration numbers 199914105, 1999B13221, 199914103, respectively;



in class 38, registration number 199908262;



in classes 37 and 42, registration numbers 200003163, 200003741, respectively.

8. The opponent has registrations for other marks, ORANGE WORLD, ORANGE POWER, 'THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE', ORANGEVENTURES, AND ORANGE FUTURES, that cover goods and services for which the applicant has applied but they offer the opponent no stronger case than the marks ORANGE and ORANGE and device, listed above.

Opponent

9. The opponent is a limited liability company incorporated in England and Wales and is part of the Orange Plc group of companies.

10. The opponent first used its marks ORANGE and ORANGE and device in April 1994 in the United Kingdom on launching its ORANGE mobile phone network in the UK. Since that time the opponent has developed a wide range of business interests in the provision of goods and services under the marks in many countries worldwide. By March 2004, ORANGE mobile phone networks were operating in nineteen countries. The opponent has trade mark registrations and applications for its marks in many countries worldwide.

11. The first use of the opponent's marks in Hong Kong was in September 1998 when Hutchison Telecommunications (Hong Kong) Limited launched a mobile telephone network in Hong Kong under the ORANGE and ORANGE and device marks under licence from the opponent.

12. Since the launch of the ORANGE mobile phone network in Hong Kong in 1998, the opponent has used its marks in Hong Kong for a wide variety of goods and services specified in its trade mark registrations in Hong Kong and exemplified in the evidence filed in these proceedings.

13. The opponent has continuously and extensively promoted its goods and services under the marks ORANGE and ORANGE and device internationally and in Hong Kong and has acquired a substantial reputation connected with its goods and services in Hong Kong and elsewhere.

Applicant

14. The applicant is a Taiwan company, incorporated in 1995 and engaged in the online game business since 1999. The applicant was listed on the Taiwan Stock Exchange in May 2002.

15. The applicant develops and provides online interactive entertainment content under the marks GAMANIA and 遊戲橘子 to over 8.61 million customers in Greater China, Japan and Korea. The business operates a system of 'membership' with customers making payment online through what the applicant calls its 'virtual currency bank model'.

16. The applicant created its marks in 1999. GAMANIA is coined from the words GAME and MANIA. The mark 遊戲橘子 combines the characters 遊戲 meaning 'game' with the characters 橘子, pronounced GA-MA in the Taiwanese dialect and intended to reflect the first two syllables of GAMANIA.

17. The applicant produces printouts of search results from search engines including search.hk.yahoo.com, search.msn.com.hk and www.google.com.hk showing that nearly all web sites containing references to 遊戲橘子 are references to the applicant.

18. In June 2000 the applicant established a subsidiary company Gamania Digital Entertainment (HK) Co Ltd (香港遊戲橘子數位科技股份有限公司) in Hong Kong. In November 2002 the applicant introduced a Hong Kong version of its game 'Convenience Store 2' (便利商店 2) to customers in Hong Kong.

19. The applicant has promoted its marks on its web sites, through printed publications and press publicity in Hong Kong.

Section 12(1) – whether likely to deceive and confuse

20. Under section 12(1) ‘it shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive’. The opponent’s evidence emphasises its widespread use of the marks ORANGE and ORANGE and device in Hong Kong and internationally. In its notice of opposition the opponent claims that by reason of the reputation of its marks, the use of the applicant’s mark in Hong Kong would be likely to deceive.

21. To oppose under section 12(1) the opponent must establish a reputation in Hong Kong by the relevant date, the date of the applicant’s application for registration (*Hong Kong Caterers Ltd v Maxim’s Ltd [1983] HKLR 287 at 296* and *Omega [1995] 2 HKC 473 at 477*).

22. The extent of the reputation of the opponent’s marks and the goods or services for which the reputation have been achieved are factors in determining whether there is a likelihood of deception or confusion. The classic expression of the question to be decided is in *Smith Hayden & Co’s Application (1946) 63 RPC 97 at 101*. Adapted to this application, it is: ‘having regard to the reputation of the mark ORANGE and ORANGE and device is the registrar satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods or services covered by the registration proposed, will not be likely to cause deception and confusion amongst a substantial number of persons?’

23. The opponent’s reputation is substantial. The applicant does not dispute it, although it doubts the opponent has used its marks for all goods and services specified in its registrations. Nevertheless in these proceedings the applicant concedes that the opponent’s reputation extends to all goods and services for which its marks are registered. Additionally, the overlap of the opponent’s and applicant’s goods and services is not disputed. The applicant’s contention is simply that its mark is sufficiently different from the opponent’s that it would not be likely to deceive or confuse.

24. The test as to whether the applicant's mark is sufficiently similar to the opponent's as to be likely to deceive or confuse is stated in *Pianotist Co Ltd's Application (1906) 23 RPC 774 at 777*: 'To gauge the possibility of confusion between the two marks, you must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. You must consider all the surrounding circumstances. You must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.'

25. The opponent's marks are ORANGE and ORANGE and device. The applicant's mark is the characters 遊戲橘子 (pronounced 'Yau Hei Gwut Tzi' in Cantonese). The argument that the marks are confusingly similar depends on the fact that the characters 橘子 in the applicant's mark mean 'orange'. The characters 橘子 are undoubtedly the part of the mark on which customers would focus because 遊戲 is indistinctive for the goods and services applied for. However, the comparison for assessing deceptive resemblance is not based merely on the idea that the marks convey. The fact that two marks convey the same idea is not sufficient in itself to create a deceptive resemblance between them (*Montres Tudor SA v Concord Watch Co SA unreported decision of Sakhrani J HCMP 5789/2000 at page 18 paragraph 31*).

26. The particular words or characters used to express an idea are part of the make up of the mark and cannot be discounted. The immediate impression of the applicant's mark is not the same as the opponent's marks. The characters and their pronunciation are as important as the idea in the overall impression that the applicant's mark creates. Equally, the look and sound of the word ORANGE and the look of the orange coloured square in the ORANGE and device mark contribute to the immediate impression of the opponent's marks. On first impression the applicant's and the opponent's marks are different.

27. The comparison of marks is made on the basis that purchasers do not recall or remember marks by careful analysis of their details. However, the

differences between the applicant's marks and the opponent's are not simply in the details. They are fundamental differences between Chinese characters on the one hand and words and devices on the other, that create different impressions of the marks respectively, even allowing for imperfect recollection.

28. Purchasers are unlikely to analyse marks or translate words or characters comprising them. They would of course recognise what a word or character means but they would not take the additional mental step of translating the word from English to Chinese or the character from Chinese to English and on this basis equate or associate one mark with the other. The fact that the characters 橘子 in the applicant's mark mean 'orange' is unlikely to deceive purchasers or to cause them to wonder whether the goods were made or the services provided by the opponent.

29. Additionally, the applicant points to the fact that 橘子 can also mean Mandarin orange or tangerine and that in Hong Kong the character 橙, referring to the fruit or the colour, is the usual translation of the word 'orange'. I think these are additional factors that make deception and confusion unlikely.

30. The applicant argues that there are no instances of actual confusion between the applicant's mark and the opponent's in Hong Kong or anywhere in the world where the marks are used. However, the opponent has challenged the applicant's claim to have used the mark in Hong Kong. In this respect, I find the applicant has made some use of its mark, as evidenced by its website www.gamania.com.hk and the Hong Kong version of its game 'Convenience Store 2' (便利商店 2). But actual confusion or the lack of it does not decide the question of whether deception and confusion is likely.

31. The difference between the applicant's mark and the opponent's is such that although the applicant's mark is intended for use for goods and services to which the opponent's reputation extends, I can find no real tangible danger of confusion if the applicant's mark is used for the goods and services applied for. The applicant has

discharged the onus of proving that there is no reasonable probability of deception and the opposition on this ground fails.

Section 12(1) - whether disentitled to protection in a court of justice

32. Under section 12(1) 'it shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be disentitled to protection in a court of justice'. The opponent's notice of opposition pleads this limb of section 12(1) in the alternative to the likelihood of deception and confusion. The notice of opposition does not particularise the ground but the opponent pleads that the registration of the applicant's mark will 'dilute the goodwill of the opponent established under the opponent's marks and would interfere with and unfairly prejudice the status and prestige of the opponent's marks'. Additionally, the opponent pleads that the applicant's mark 'takes advantage of the opponent's reputation and registration of the opponent's marks' and that registration of the applicant's mark 'would unfairly prejudice the legitimate business interest of the opponent'. I assume this is a pleading to the effect that the use of the applicant's mark would amount to passing off and therefore, would be disentitled to protection under section 12(1).

33. The basis of the opposition on this ground is that the use by the applicant of the mark 遊戲橘子, in connection with the goods and services applied for, represents the goods and services to be goods and services of the opponent, or goods and services connected with the opponent. In a case such as this, there can hardly be passing off unless there is a resemblance between the applicant's mark and the opponent's. For reasons I have given, I have found that the applicant's mark is not similar to the opponent's. It follows that use by the applicant of the mark 遊戲橘子, for the goods and services applied for, would not give rise to an actual probability of deception leading to passing off. Accordingly, the applicant's mark is not disentitled to protection in a court of justice and the alternative ground of opposition under section 12(1) fails.

Section 20

34. Under section 20 ‘no trade mark shall be registered that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of the same goods, the same description of goods the same services or the same description of services’. Under section 2(4) ‘references to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion’.

35. The question to be decided under section 20 is essentially the same as under section 12(1) (*Smith Hayden & Co’s Application (1946) 63 RPC 97 at 101*): ‘assuming user by the opponent of its mark ORANGE or ORANGE and device, in a normal and fair manner for any of the goods or services covered by the registration of the mark, is the registrar satisfied that there will be no reasonable likelihood of deception or confusion among a substantial number of persons if the applicant also uses its mark 遊戲橘子 normally and fairly in respect of any goods or services covered by its proposed registrations?’

36. *Kerly’s Law of Trade Marks and Trade Names 12 edition at 10-03* notes that ‘in an opposition based upon a registered mark, the enquiry under section 12 (our section 20) embracing as it does notional use upon any of the goods [or for any of the services] concerned, is wider than that under section 11 (our section 12(1)). However, in the present opposition there is no practical difference in the enquiry under section 20 and section 12(1). For the purposes of both sections, the opponent relies on its registered marks and in relation to section 12(1) the applicant does not dispute the opponent’s claim to reputation or use for all goods and services for which the opponent’s marks are registered.

37. In notional use, the applicant’s mark and the opponent’s marks would appear on the same type of goods available through the same trade channels and bought by the same customers or in relation to the same type of services provided to the same customers. However, as I find the applicant’s mark does not resemble the opponent’s marks and there is no reasonable probability of deception or confusion

under section 12(1), it follows that there is no reasonable likelihood of deception or confusion under section 20. The opposition under section 20 therefore fails.

Section 23

38. Under section 23, ‘the registrar may refuse to register any trade mark if it is proved to his satisfaction by the person opposing the application for registration that such mark is identical with or nearly resembles a trade mark which is already registered in a country or place from which such goods originate’. The opponent opposes under section 23 on the basis that its trade mark registrations in many countries internationally, including the United Kingdom from which the opponent’s goods and services originate, should prevent the applicant’s mark from becoming registered in Hong Kong.

39. Section 23 was authoritatively interpreted in the High Court judgment *Hong Kong Caterers Ltd v Maxim’s Ltd [1983] HKLR 287*. The section is intended to prevent an applicant from registering a mark already registered elsewhere. It is to prevent piracy. As Hunter J expressed it: ‘The section can be paraphrased as: ‘the Registrar may refuse to register a copied mark’ (*Maxim’s at 301*).

40. The ground must be based in some way on an assertion of copying. The opponent’s notice of opposition pleads that ‘the applicant, in the choice of the mark, is taking advantage of the opponent’s reputation and registration of the opponent’s mark’. If this is an assertion that the applicant copied the opponent’s marks, it has not been substantiated as the opponent has not shown that the applicant’s mark is identical with or nearly resembles the opponent’s marks. The opposition under this ground fails.

Section 13(1)

41. Under section 13(1) an application for registration may be made by ‘any person claiming to be entitled to be registered as the proprietor of a trade mark used or proposed to be used by him’. The opponent in its notice of opposition asserts that the applicant’s application does not comply with section 13(1) as the applicant cannot claim to be the proprietor of the mark 遊戲橘子.

42. The basis of the assertion is unexplained. If the opponent contends that as proprietor of the marks ORANGE and ORANGE and device it is entitled to be registered as the proprietor of the mark 遊戲橘子, the opponent’s claim must fail. On the authority of *Re Wowi and device [1998] 3 HKC 221* a claim to proprietorship arises only if the respective marks are identical or virtually identical.

43. Unlike section 12(1) and section 20 where the applicant’s and opponent’s marks are to be compared successively, under section 13(1) the comparison is with the marks placed side by side. Under section 12(1) and section 20 I have found that the applicant’s mark 遊戲橘子 is not sufficiently similar to the opponent’s marks ORANGE and ORANGE and device as to deceive and confuse. It follows that in comparing the applicant’s and the opponent’s marks side by side under section 13(1) I do not find them virtually identical.

Sections 2, 9 and 10 - distinctiveness

44. The opponent in its notice of opposition claims that the applicant’s mark is not distinctive and is not registrable under section 2 (applicant’s mark not indicating a connection in the course of trade or in the course of business); section 9 (applicant’s mark not inherently adapted to distinguish); or section 10 (applicant’s mark not inherently capable of distinguishing).

45. The applicant shows little use of the mark in Hong Kong before the relevant date, the date of the application for registration. As a result, the registrability of the applicant's mark is to be assessed *prima facie*, as it appears in the application for registration.

46. A word or words having no direct reference to the character or quality of the goods is distinctive for registration (section 9(d)). The applicant's mark includes the characters 遊戲 that are descriptive of and have direct reference to goods and services in relation to games. However, the applicant's mark also includes the characters 橘子 that are not descriptive of and have no direct reference to the goods and services. As a whole the mark is distinctive.

47. The applicant's mark is inherently adapted to distinguish and qualifies for registration under section 9, subject to a disclaimer of 遊戲 in accordance with the registrar's practice on disclaimers. As I find that the applicant's mark is inherently adapted to distinguish the applicant's goods or services, it follows that the mark is capable of use under section 2 as indicating a connection in the course of trade in the goods or in the course of business in providing the services.

48. Alternatively, if the opponent contends that the applicant's mark is not distinctive because it is similar to the opponent's marks and indicates a connection with the opponent's goods or services as opposed to the applicant's, the argument fails as I have found that the applicant's mark is not confusingly similar to the opponent's marks.

Exercise of discretion

49. The registrar has a general discretion under section 13(2) to refuse an application for registration. The registrar is bound to consider the exercise of the discretion and must exercise it judicially, considering all the circumstances of the case

(Hong Kong Caterers Ltd v Maxim's Ltd [1983] HKLR 287 at 301 referring to Kerly's Law of Trade Marks and Trade Names 12th edition paragraphs 4-07 to 4-09).

50. However, for the reasons I have given in comparing the applicant's and the opponent's marks, I find there is no reasonable likelihood of confusion between them. The other grounds of opposition have failed and there is no other reason to refuse the registration of the applicant's mark in the exercise of the discretion under section 13(2).

Costs

51. As the opposition has failed, I award the applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap 4) as applied to trade mark matters, unless otherwise agreed between the parties.

Original Signed

(Teresa Grant)
for Registrar of Trade Marks
21 July 2006