

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 200215619AA

MARK: "ICHAT"

CLASSES: 9 AND 38

APPLICANT: APPLE COMPUTER, INC.

STATEMENT OF REASONS FOR DECISION

Background

1. On 4 October 2002, Apple Computer, Inc. ("the applicant") applied, pursuant to the provisions of the repealed Trade Marks Ordinance (Cap.43), to register the mark, **ICHAT** ("the subject mark") in Classes 9 and 38 respectively.
2. Upon the applicant's request, the two applications were converted for the examination under the provisions of the Trade Marks Ordinance (Cap.559) ("the Ordinance") and were accorded the filing date of 4 April 2003. The two applications were then merged into a single application upon the applicant's request.
3. The goods and services for which registration is sought are as follows:

Class 9

computer operating system software; software for detecting, eradicating and preventing computer viruses; software for telecommunication and communication via local or global communications networks, including the Internet, intranets, extranets, television, cellular, and satellite networks; software for creating and delivering electronic greeting cards, messages, and electronic mail; instructional material relating to the foregoing, all recorded magnetically, optically or electronically; all included in Class 9.

Class 38

telecommunication services; electronic transmission and retrieval of images, audio, video, and documents, including text, cards, letters, messages, mail, and electronic mail, over local or global communications networks, including the Internet, intranets, extranets, television, cellular, and satellite networks; distribution of computer software over local or global communications networks, including the Internet, intranets, extranets, television, cellular and satellite networks; transmission of personalized digital greeting cards and animations; electronic mail services; facsimile transmission; web site portal services; providing access to local or global communications networks,

including the Internet, intranets, extranets, television, cellular, and satellite networks; Internet service provider services; all included in Class 38.

4. During the examination stage, objections were taken against the application under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the goods and services applied for.
5. The applicant requested a hearing which took place before me on 31 August 2005. Mr. John Slater of Messrs. Simmons & Simmons appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
6. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

Trade Marks Ordinance

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

Section 11(1):

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

- (a) ...
- (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) ...”

Decision

8. The subject mark comprises of a word “ICHAT” in plain block capitals.
9. Mr. Slater submitted that the relevant consumers would not immediately dissect the subject mark “ICHAT” into two constituent elements, i.e. the letter “I” and the word “CHAT”. However, I consider that when average consumer see the subject mark used in relation to the goods and services applied for, which all

related to the computing and telecommunication fields, and the word “CHAT” is just an ordinary English word, they would naturally break the subject mark into the letter “I” and the word “CHAT”. This is also the way they would pronounce the subject mark.

10. Mr. Slater asserted that the subject mark was an invented word and had no obvious meaning at all. It was inconceivable that consumers would see the subject mark and reduce it to “Internet chat” or “Interactive chat”. He also referred me to the search results at www.acronymfinder.com, Exhibit “JHS-1” of the Statutory Declaration of John Hearne Slater declared on 26 August 2005 (“Statutory Declaration”), to show that there are 43 possible meanings for the acronym “I” and the most common meanings are “Incomplete”, “Interest”, “Italic” and “One”. Therefore, he thought that there was no basis for the examiner to state that “I” stands for “Internet” or “Interactive” nor would customers perceive “I” as so.
11. I do not agree that the subject mark is an invented word or has no obvious meaning. Apparently, the subject mark is a mere association of two ordinary English words, i.e. “I” (as a pronoun) and “CHAT”. It is true that the letter “I” can have a number of different meanings depending on the context in which it is used. In the present context, i.e. in the fields of computer and telecommunication related goods and services, the obvious reference is, as the examiner stated, to “Internet” or “Interactive”. In fact, the search results produced by Mr. Slater indicate that the letter “I” could also stand for “Internet” or “Interactive”. The relevant public, who are users of those related goods and services, will instantly assume that the letter “I” stands for “Internet” or “Interactive” and not for any other possible abbreviation.
12. According to www.dictionary.com, “CHAT” means
intr.v.
 - (i) To converse in an easy, familiar manner; talk lightly and casually.
 - (ii) Computer Science. To participate in a synchronous exchange of remarks with one or more people over a computer network.*n.*
 - (i) An informal, light conversation.
 - (ii) Computer Science. A synchronous exchange of remarks over a computer network.

13. "CHAT" also means:
- "informal conversation or talk conducted in an easy familiar manner"; "to talk an easy familiar way" - *Collins English Dictionary (Third Edition Updated 1994)*
 - "to have a real-time conversation online" – *High-Tech Dictionary on www.computeruser.com*
 - "real-time communication between two users via computer. Once a chat has been initiated, either user can enter text by typing on the keyboard and the entered text will appear on the other user's monitor. Most networks and online services offer a chat feature." - *Webopedia*¹
14. Given the meanings of the letter "I" and the word "CHAT" and in respect of the goods and services in question, it is likely that consumers will immediately perceive the subject mark "ICHAT" as an abbreviation of "INTERNET CHAT" or "INTERACTIVE CHAT". Alternatively, taking the word "CHAT" as a verb, consumers will consider that the subject mark simply means "I CHAT".

Section 11(1)(c) of the Ordinance

15. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the kind, intended purpose, or other characteristics of the goods or services in respect of which registration is sought.
16. Mr. Slater submitted that the goods and services applied for are high value software, highly technical IT and telecommunications services. The section of the public targeted are the tech-savvy, sophisticated part of the English speaking public, largely made up of businesses or computer-literate high net worth individuals. No evidence was produced in support of the argument.
17. In my view, the goods and services applied for cover a range of goods and services in computing and telecommunication sectors, and they are likely to be patronized by a wide section of the public ranging from the trade to the general public. Essentially, the computer software claimed in Class 9 is the basic tool for users to run a computer, to access the communication networks and to communicate with other users online. The services claimed in Class 38 are generally required by people who want to access online in office or at home or

¹ <http://www.pcwebopaedia.com/TERM/C/chat.html>

to exchange electronic mails and digital documents including images through the Internet or communication networks.

18. In any event, as explained above, I believe the meanings of the subject mark, i.e. “I CHAT”, “INTERNET CHAT” or “INTERACTIVE CHAT” are readily apparent to all relevant consumers, let alone people who are specialized in the fields of computing and telecommunications and thus familiar with terminologies in information technology.
19. In considering whether the subject mark is excluded by section 11(1)(c) of the Ordinance, Mr. Slater referred me to paragraphs 24, 25 and 26 of *Deutsche Post EURO EXPRESS GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”), Case T-334/03* (the “EUROPREMIUM” case) in which the Court ruled that:

“The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 [which is broadly similar to section 11(1)(c) of the Ordinance] are only those which may serve, in normal usage from the point of view of the target public, to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought”

“Consequently, for a sign to fall within the scope of the prohibition in that provision, it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the category of goods and services in question or of one of their characteristics”

“Accordingly, a sign’s descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public”

20. Mr. Slater argued that the subject mark did not make it clear to consumers the exact nature of the product or service of the applicant. Consumers would not perceive that the applicant must sell for example, computer operating system software, virus detection software or even software facilitating multi-way video and audio conferencing and text messaging applications. The term “ICHAT” or even “Internet chat” did not accurately describe the essential functions of the computer software claimed in Class 9 or encapsulate the services provided by the applicant in Class 38.
21. It should be noted that the “EUROPREMIUM” case, which is a decision of the Court of First Instance of the European Communities, must be read subject to and in the light of the decisions of the Court of Justice of the European

Communities (“European Court of Justice”). The correct approach to the application of Article 7(1)(c) of the Regulation has been explained by the European Court of Justice in *OHIM v Wm. Wrigley Jr. Company, Case-191/01P* (the “*DOUBLEMINT*” case) and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau, Case C-363/99* (the “*Postkantoor*” case). The latter case is mainly concerned with Article 3(1)(c) of the First Council Directive 89/104/EEC but it is directly relevant as the two Articles are effectively identical. The relevant principles are as follows:

“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.” (see paragraph 32 of the “*DOUBLEMINT*” case)

“For the purposes of determining whether Article 3(1)(c) of the [First Council Directive 89/104/EEC] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.” (see paragraph 104 of the “*Postkantoor*” case)

22. These principles indicate that marks that are objectionable under Article 7(1)(c) of the Regulation do not have to be the “normal way” of describing the applied for goods or services, nor is it necessary for the relevant characteristics of the goods or services to be commercially essential. Accordingly, contrary to Mr. Slater’s contention, for the subject mark to be barred from registration under section 11(1)(c) of the Ordinance, it is not necessary that it must give a description of details of the specified goods or conduct of specified services, or the essential functions or characteristics of the goods and services. It is sufficient to find that the subject mark could be used to designate any characteristics of the goods and services applied for.
23. In my judgment, when the subject mark is used in relation to the goods and services applied for, it directly tells the relevant consumers that the goods and services facilitate users to communicate with other users through the Internet or to have real-time conversation through the communication networks. Consequently, the subject mark could be used to designate, if not immediately designates, the kind and intended purpose of the goods and services applied for.

24. The possibility that the subject mark may be interpreted as “I CHAT”, “INTERNET CHAT” or “INTERACTIVE CHAT” and therefore have more than one meaning does not make the subject mark cease to be descriptive. In the mind of the average consumer, “ICHAT” is spontaneously associated with certain characteristics of the goods and services in question, namely online chatting and communication in real time through the communication networks, so that the subject mark is necessarily descriptive and cannot serve as a badge of trade origin.
25. Mr. Slater further submitted that the perceptible difference, between the subject mark “ICHAT” and the combination of Internet and chat, renders the subject mark distinctive. My attention was drawn to paragraphs 35 to 41 of *Campina Melkunie BV v Benelux-Merkenbureau, Case C-265/00*, in which, the European Court of Justice stated in paragraph 41 that:
- “...a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”
26. To my mind, the conjoining of “I” and “CHAT” simply produces a sign that is the sum of the two parts. Nothing fanciful emerges from it when viewed in its entirety nor have its descriptive meanings been removed. In respect of the goods and services applied for, the subject mark as a whole makes a clear and unambiguous reference to online chatting or the act of conversing through the Internet or communication networks. The subject mark is not an allusive mark as Mr. Slater argued. Consequently, an average consumer is likely to perceive the subject mark as a mere description of the characteristics or intended purpose of the goods and services applied for and not as an indication of commercial origin.
27. Furthermore, I consider that being a descriptive term, “ICHAT”, is an apt and appropriate term that other economic operators may legitimately wish to use in designating similar characteristics of their own goods and services.

28. Based on the above reasons, I must conclude that the subject mark as a whole consists exclusively of a sign which may serve, in trade or business, to designate the kind, intended purpose and characteristics of the goods and services applied for and is, therefore, excluded from registration by section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

29. I now turn to consider whether the subject mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance, which operates as a separate and independent ground of objection under section 11(1)(c) of the Ordinance.
30. In *British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281, page 306*, in which Jacob J said :

“What does *devoid of any distinctive character* means? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

31. 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.”

32. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. I must assess the mark’s distinctiveness in relation to the goods and services for which the applicant seeks registration taking into account the perception of the relevant consumers.
33. I agree with Mr. Slater that for assessing the distinctive character of a trade mark, the mark must be viewed as a whole by focusing on the overall impression it creates. The mere fact that each element of a mark, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (see *SAT.1 SatellitenFernsehen GmbH v OHIM*,

Case C-329/02 P).

34. Mr. Slater argued that the subject mark, which consists of the conjoining of the prefix “I” and the word “CHAT”, forms a word which is not commonly used in the English language. The subject mark is not a recognized word in English language dictionaries and is an invented word. Furthermore, it is not a generic term for identifying the goods and services in question but a combination of elements forming a memorable sign. Accordingly, the subject mark is able to distinguish the origin of the goods and services in question from those of other undertakings.
35. In the subject application, the goods and services applied for are essentially computer software, telecommunication and online services. As I have explained in paragraph 17, the relevant consumers of these goods and services comprise those in the trade and the general public.
36. In light of the popular use of computer networks for communication and the letter “I” being increasingly used as a general prefix relating to an action conducted through the Internet, I consider that, in the context of the goods and services applied for, the relevant consumers will readily see the subject mark as an abbreviation of “INTERNET CHAT” or ‘INTERACTIVE CHAT”. Some of them may simply treat the subject mark as “I (as a pronoun) CHAT”. As such, the subject mark conveys an immediate message to the relevant consumers that the goods and services applied for can help users to chat online or interact with people through the communication networks.
37. In my view, the relevant consumers’ overall impression on the subject mark will be that it is a descriptive designation, telling them the kind, intended purpose and characteristics of the goods and services applied for, rather than a badge of trade origin, which identifies the goods and services as originating from a single undertaking. Accordingly, I am not persuaded that the letter “I” in conjunction with the word “CHAT” is sufficient, in terms of bestowing distinctive character on the subject mark as a whole, to conclude that it would serve in trade or business to distinguish the goods and services of the applicant from those of other traders.
38. The fact that the word “ICHAT” is not found in English dictionaries or not commonly used by other traders to identify the goods and services in question

does not demonstrate that the subject mark possesses a distinctive character. To my mind, the subject mark will not be identified as a trade mark without first educating the public that it is a trade mark.

39. Additionally, as the subject mark is equally applicable as a description of similar characteristics of the goods and services provided by other undertakings, it would not enable the relevant consumer to distinguish the applicant's goods and services from those of other undertakings.
40. For the reasons stated above, I conclude that the subject mark cannot fulfill the essential function of identifying the source of the goods and services applied for so as to distinguish the applicant's goods and services from those of others. Therefore, the subject mark as a whole is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(8) of the Ordinance

41. Mr. Slater reminded me of section 11(8) of the Ordinance and pointed out that the applicant claimed a range of goods and services some associated with communication over computer networks and others which are not so associated. Therefore, the objections could only apply to some of the goods and services applied for, namely "software for communication via local or global communications networks, including the Internet, intranets, extranets, television, cellular, and satellite networks" in Class 9 and "electronic transmission and retrieval of images, audio, video, and documents, including text, cards, letters, messages, mail, and electronic mail, over local or global communications networks, including the Internet, intranets, extranets, television, cellular, and satellite networks" in Class 38.
42. Section 11(8) of the Ordinance reads as follows:
"Where the grounds for the refusal of registration exist in respect of only some of the goods or services for which the application for registration is made, the refusal shall apply to those goods or services only".
43. For the goods in Class 9, I find that "software for telecommunication and communication via local or global communications networks", "software for creating and delivering electronic greeting cards, messages, and electronic mail" and "instructional material relating to the foregoing" (which teaches users how to use the relevant software) are clearly associated with communication over the

networks and thus are objectionable. The remaining items, namely “computer operating system software” and “software for detecting, eradicating and preventing computer viruses” are closely connected items of commerce. For example, “computer operating system software” may provide a suitable or preferred platform to run the application software allowing online chatting. “Virus detection software” may serve the purpose of online security in order to streamline online chatting. Therefore, the subject mark is descriptive of the characteristics or purpose of the remaining items. Upon seeing the subject mark used in connection with the remaining items, average consumer will not consider it to denote trade origin.

44. Regarding the services in Class 38, I consider that “telecommunication services” and “Internet service provider services” are broad enough to cover the Internet chat services or interactive chat services. “Electronic transmission and retrieval of images, audio, video, and documents”, “transmission of personalized digital greeting cards and animations”, “electronic mail services” and “providing access to local or global communications networks” are directly associated with online communication. “Distribution of computer software over local or global communications networks”, “facsimile transmission” and “web site portal services” are closely connected items of commerce or ancillary to the provision of Internet chat services or interactive chat services. In my view, “distribution of computer software over local or global communications networks” could cover the provision of compatible software online so as to facilitate users to chat with other users over the communication networks. “Web site portal services” may provide a place for users to chat online. “Facsimile transmission”, which may be provided through a facsimile system to enable high speed transmission of data over internal or external networks, is part and parcel of online communication. Consequently, in respect of these closely related services, the descriptive meaning of the subject mark has not been removed. Average consumer will not regard the subject mark as denoting the trade origin.
45. I therefore maintain the objections under section 11(1)(b) and (c) of the Ordinance in respect of all of the goods and services applied for.

Reference to other registered marks on our register and foreign registration

46. Mr. Slater added that the applicant had obtained registrations for a number of similar trade marks in Hong Kong including ILIFE, IWRITE, IBOOK, ITUNES,

ISYNC, ICAL, ICALC, IMIX, IMOVIE, IDVD, ISCHOOL, IDEV, ISIGHT, IWORK, IMAC and IPOD, and the particulars of registrations can be found at Exhibit “JHS-3” of the Statutory Declaration. As the subject mark forms part of this family of marks owned by the applicant, the Registry should likewise regard the subject mark as distinctive of the goods and services applied for.

47. I find most of the above registered marks are more distinctive than the subject mark. In any event, each case must be considered on its own merits. Comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (see *British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 at 305*). I disregard the state of the register in my consideration of the subject application accordingly.
48. Mr. Slater also informed me that the subject mark had been registered as a Community Trade Mark in Classes 9, 38 and 42. The registration was accepted on prima facie basis and without the need to file evidence of use. A copy of the letter from the applicant’s overseas agent with supporting documentation, Exhibit “JHS-2” of the Statutory Declaration, was produced for my reference. It must be noted 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] RPC 885*). As there are valid grounds of objections under the Ordinance, I am not prepared to accept the subject mark solely based on the foreign registration.

Conclusion

49. In this decision, I have considered all documents filed and submissions made by the applicant. For the reasons given, the subject mark is precluded from registration by section 11(1)(b) and (c) of the Ordinance, and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Sandra Hui
for the Registrar of Trade Marks
7 December 2005