

Trade Mark Application

No. 1152 of 2003

IN THE MATTER of the Trade Marks

Ordinance (Cap. 43)

AND

IN THE MATTER of an application for the registration of the mark “無盡的任務” in Part A in Class 41 by Sony Computer Entertainment America Inc.

DECISION

OF

Miss Jessica Wing Shun Law 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 4 July 2005.

1. On 22 January 2003, Sony Computer Entertainment America Inc. (“the applicant”) lodged an application in Class 41 to register the Chinese characters 無盡的任務 as a trade mark in Part A of the Register. The services in respect of which registration is sought are:

“game services provided on-line from a computer network; provision of games by means of a computer based system; operating a real-time, role playing game for others over global and local area computer networks.”

2. An examination report issued on 24 February 2003 objected to the suit mark’s registrability under sections 9 and 10 of the Trade Marks Ordinance, Cap. 43 (“the Ordinance”) on the grounds that the mark as a whole is indistinctive and descriptive of the purpose of online games services which provide unlimited missions for users when they are playing the games provided online. Objection was also raised under section 2(1) of the Ordinance that the mark is not used or proposed to be used in relation to those services for the purpose of indicating a connection in the course of trade with the applicant. Therefore, the mark 無盡的任務 is neither inherently adapted to distinguish nor inherently capable of distinguishing the applicant’s services from similar services of others and is accordingly *prima facie* unacceptable for registration in either Part A or Part B of the Register.

3. In response, on 2 December 2003, the applicant filed a considered reply arguing, *inter alia*, that the mark is not directly descriptive of the services claimed and qualified for registration. That the mark is not a natural or common term used in relation to online game services and consumers do not refer to online game services as being 無盡的任務 or “an inexhaustible mission”. The applicant submitted that it has never heard of a computer game or computer game service described in that way and since other traders do not use those characters to describe similar services, the combination of those Chinese characters when used by the applicant in relation to its services is unique and functions to identify the applicant’s services from those of other

traders. The applicant also argued that the services claimed are limited to a single type of services and the applicant does in fact use its mark in relation to those services.

4. After considering the applicant's submissions, the objection raised under section 2(1) of the Ordinance is no longer pursued. However, the Registrar of Trade Marks ("the Registrar") maintained in its letter of 29 June 2004 that the mark purely indicates the content of the game services provided of which game players have unlimited missions when they are playing the online games. As the mark is merely a descriptive term for the game services provided online, refusal of registration of the mark in either Part A or Part B of the Register under sections 9 and 10 of the Ordinance is maintained.

5. On 19 November 2004, an informal discussion was held between the applicant's agent and the Registrar. At the informal discussion, the applicant's agent submitted that "endless missions" is just one of the possible translations of the mark and that the direct translation of the mark is "EverQuest". The applicant's agent further argued that there was nothing in the mark itself which is suggestive of the services claimed and the mark should at least be registrable in Part B of the Register. The Registrar's attention was also drawn to Trade Mark No. B11594 of 2001 ("無限網絡, 无限网络" (series) registered in Part B in Class 41, with separate disclaimers of the Chinese characters "無限/无限" and "網絡/网络") and Trade Mark No. B01230 of 1999 ("投資名策服務" registered in Part B in Class 36, with disclaimers of the Chinese characters "投資" and "服務").

6. Despite the further submissions made at the informal discussion, the Registrar maintained his position with regard to the mark as being *prima facie* unregistrable. The Registrar considered that the quoted marks are not on par with the suit mark as the combination of the characters 無盡的任務 is descriptive as a whole and there is no distinctiveness in the combination which warrants acceptance of the mark subject to separate disclaimers. Nonetheless, it was suggested to the applicant that it might

consider adding an applicable registered mark to the representation of the suit mark and to disclaim any right to the exclusive use of the characters 無盡的任務.

7. On 4 July 2005, the applicant requested for the issue of the formal decision of the Trade Marks Registry following the said informal discussion. Pursuant to section 13(4) of the Ordinance and rule 20(2) of the Trade Marks Rules (Cap. 43 sub. leg.), I now state in writing the grounds for the decision and the materials used in arriving at it.

8. Even though the new Trade Marks Ordinance Cap. 559 came into operation on 4 April 2003, this application is a “pending” application according to paragraph 10(1), Schedule 5 of the new Ordinance. It therefore remains to be dealt with under the provisions of the Ordinance Cap. 43.

9. As there was no evidence filed in relation to use of the mark in Hong Kong to support a finding of distinctiveness in fact, I have only to decide the *prima facie* case for registrability i.e. whether it is inherently adapted to or inherently capable of distinguishing the applicant’s services.

10. To be registrable in Part A of the Register, the suit mark must contain or consist of at least one of the essential particulars listed in paragraphs (a) to (e) of section 9(1) of the Ordinance.

11. The suit mark does not fall within any of paragraphs (a), (b), or (c) of section 9(1). I turn therefore to the question whether the characters 無盡的任務 satisfy the requirements of section 9(1)(d) as “...words having no direct reference to the character or quality of the services”, the prohibition relating to the registration of geographical names or surnames not being relevant in the context of the mark applied for.

12. The test to be applied was succinctly stated by Dixon C.J. in **Mark Foy’s Ltd. v Davies Coop & Co. Ltd. [1956] 95 C.L.R. 190 at 195,**

“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”.

13. The mark comprises the Chinese characters 無盡的任務. According to *The Pinyin Chinese-English Dictionary (10th edition)*, the characters 任務 mean “assignment; mission; task; job”. And the characters 無盡, according to *The Contemporary Chinese Dictionary (Chinese-English Edition)* (《現代漢語詞典》(2002年增補本)), mean “endless; inexhaustible; infinite; limitless”.

14. The services of this application are “*game services provided on-line from a computer network; provision of games by means of a computer based system; operating a real-time, role playing game for others over global and local area computer networks.*”

Real-time and role-playing games are categories of computer games. It is not unusual in computer games (including online games) to use the characters 任務 or the word “mission” to denote the virtual tasks or assignments to be accomplished and undertaken by the game players in an imaginary world. Computer games commonly incorporate a series of and a variety of virtual missions or tasks for the players to accomplish and undertake. It is perfectly possible and natural to stress the large number of and/or great variety of missions, tasks or assignments provided in computer games by use of the characters 無盡的 meaning endless or inexhaustible. Together, the characters 無盡的任務 in their application to the services claimed, might well be understood by the ordinary persons as describing or indicating that the applied for services provide online games containing or consisting of a large number of and/or a great variety of missions, tasks or assignments for the players. The mark 無盡的任務 describes or indicates or calls to the mind of the ordinary persons such nature or attribute the applicant’s services possess and aptly describes them.

15. In determining whether a word or words has direct reference to the character or quality of the services, the question is not answered by asking whether one can tell

from the mark what the applicant's services are. It also matters not whether the direct translation of the mark is intended to be "EverQuest". Rather, the word or words have to be considered in the light of the services to which the mark is to be applied. As I have said above, the ordinary persons, upon seeing or hearing the characters 無盡的任務 used in relation to the services claimed, might well understand them to be describing or indicating or calling to their mind that the applicant provides online games services containing or consisting of a large number of and/or a great variety of virtual missions, tasks or assignments for the players. I am not satisfied that the mark does not have a direct reference to the character of the services. Therefore, the mark does not qualify for acceptance under section 9(1)(d) of the Ordinance.

16. Section 9(1)(e) allows otherwise distinctive marks to be registrable in Part A of the register upon evidence of distinctiveness. As there is no evidence filed for consideration of the mark under section 9(1)(e), the mark accordingly fails to qualify for registration in Part A.

17. I turn therefore to the question whether the mark 無盡的任務 is one capable of distinguishing the applied-for services from those of other traders under section 10(1) so as to be registrable in Part B of the Register. This provision calls for a consideration of the inherent capacity of the mark to distinguish and whether, by reason of use of the mark or of any other circumstances, it is in fact capable of distinguishing.

18. 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 on the legitimate freedom of other traders (per Lloyd Jacob J. in **TORQ-SET Trade Mark [1959] R.P.C. 344 at 346 lines 38-39**). The question to ask is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the services of the persons so using it, disregarding the effects of registration. In Lord Parker's words,

"[that] must, ...largely depend upon 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.” (**W. & G. du Cros Ltd.’s Application (1913) 30 RPC 660 at 671-672**)

19. Notwithstanding that the applicant cannot, at this point of time, find a trader in the relevant trade using the subject characters to describe their services, it does not necessarily mean that traders in the field are not likely, in the ordinary course of their business and without any improper motive, to desire to use them in connection with their services in future. Even if no one other than the applicant has used the combination of the characters 無盡的任務 in relation to online game services before, this alone does not decide the question of registrability of the mark. It has been said that the Registrar must have regard to “the interests of the public not only of today, but of tomorrow and the day after” (**Yorkshire Copper Works Ltd’s Application (1954) 71 RPC 150 at 154**). I must therefore also have regard to whether in future, other honest traders are likely to want to use a similar mark in relation to their own services (**Smith, Kline & French Laboratories Ltd’s Trade Mark (applying W&G Case [1913] 30 RPC 660) [1976] RPC 511 at 538, 539, H.L.**).

20. The burden lies with the applicant to establish that the mark is inherently capable of distinguishing, and a mark cannot be looked at in isolation from the services for which it is to be registered. In the field of computer games, the number and variety of missions, tasks or assignments provided in a computer game are important ingredients in determining its popularity and success. Computer games are for amusement and entertainment. To players, the more the missions or tasks provided in computer games, the more the adventures to be experienced and so the more fun and enjoyment of the games. Computer games that give more enjoyment to players are desirable. The mark 無盡的任務 as a whole has direct reference to the character of the applied for services and is apt to describe the services at issue. I do not see why other traders would not, in the ordinary course of their business and without improper motive, desire to use the same mark or a mark nearly resembling the applicant’s to advertise or promote their similar game services which contain or consist of large numbers of and/or great varieties of

missions, tasks or assignments for players. I am not satisfied that the mark is inherently capable of distinguishing the applicant's services from those of other traders. I am mindful of the fact that a trade mark registration grants a potentially perpetual monopoly. The privilege of a monopoly should not be conferred where it might require honest men to look for a defence when they use ordinary descriptive words (**COLORCOAT Trade Mark [1990] RPC 511 at 517**)

21. As there is no relevant user evidence, it remains to consider any other circumstances which the applicant is entitled to pray in aid. The applicant sought to rely on the existing registration of Trade Mark No. B11594 of 2001 (“無限網絡, 无限网络” (series)) and Trade Mark No. B01230 of 1999 (“投資名策服務”). I do not find those earlier acceptances in the Registry particularly helpful as the combination of the characters 無盡的任務 is descriptive as a whole and there is no distinctiveness in the combination which warrants acceptance of the mark subject to separate disclaimers. In any event, those earlier acceptances does not constitute “any other circumstances” under section 10(2) of the Ordinance. I refer to the observations of Buckley, J. in of **ROTOLOK Trade Mark [1968] RPC 227 at 230**, “I do not think that they can really be of assistance, because I cannot tell what special circumstances there may have been to justify registration of those marks, and I do not for myself think that the fact that these other registrations already exist affords a special circumstance which makes it any easier to say that the mark now sought to be registered is capable of distinguishing the appellant's goods”. Moreover, it is well established that each case must be considered on its own merits (**COLORCOAT Trade Mark [1990] R.P.C. 511 at 517**; **Madame Trade Mark [1966] R.P.C. 541 at 545**). In **British Sugar Plc. v James Robertson & Sons Ltd. [1996] R.P.C. 281 at 305**, Jacob J. stated that, “It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see. e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

22. For the above reasons, the mark is not capable of distinguishing within the

meaning of section 10 of the Ordinance and therefore cannot be accepted for registration in Part B of the Register.

23. Having found that the mark 無盡的任務 fails to qualify for registration under sections 9 and 10 of the Ordinance, I am bound to conclude that the application for the registration of the mark is refused under section 13(2) of the Ordinance.

24. In arriving at my decision, I have considered the written arguments made by the applicant's agent by letter dated 2 December 2003; the record of the arguments raised in the informal discussion held on 19 November 2004; the Trade Marks Ordinance (Cap. 43); the Trade Marks Rules Cap. 43 sub. leg.) and the authorities cited herein.

(Jessica Law)

p. Registrar of Trade Marks

18 October 2005