

## TRADE MARKS ORDINANCE (CAP. 559)

**APPLICATION NO.:** 300111662AA, 300147915

**MARK:** MTV

**APPLICANT:** VIACOM INTERNATIONAL INC.

**CLASSES:** 9, 38 and 41

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### STATEMENT OF REASONS FOR DECISION

#### Background

1. Viacom International Inc. ("the applicant") has applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) ("the Ordinance"), to register the mark "MTV" ("the subject mark") in relation to the following goods:

*Application no.: 300111662AA (application date: 15 November 2003)*

#### Class 9

Apparatus for storing, recording, transmitting and reproducing sound and/or images; videotapes, video discs, video cassettes, laser discs and digital versatile discs ("DVD"), CD-ROMs and other media formats featuring motion pictures films, news, sports and television series, documentaries, game shows, variety shows, reality based television shows, animation, concerts and other performance; recorded magnetic tapes with sounds and/or images; sound recordings; phonograph records and compact discs; amusement apparatus for use with television receivers; computers; computer programs; interactive computer systems; magnetic cards containing encoded information; magnetic credit cards and/or encoded credit cards; computer games and computerized amusement programs; wireless mobile phone equipment and accessories, mobile phone face plates; downloadable ring tones, voice, music, MP3s, graphics, games, video images, information and news for wireless communication devices.

#### Class 38

Wireless mobile phone telecommunication services and mobile phone services; wireless transmission services relating to uploading and downloading of ring tones, voice, music, MP3's, graphics, games, video images, information and news via a global computer network to a wireless communication device; telecommunication services relating to voting and polling through a wireless communication device; sending and receiving voice and text messages between wireless communications; communication services, namely transmitting streamed sound and audio-visual recordings via the internet.

*Application no.: 300147915 (application date: 27 January 2004)*

#### Class 41

educational, teaching and training, entertainment, sporting and cultural services, including production of radio and television programs; production of films and live entertainment features; production of animated motion pictures and television features; services relating to cinema and television studios; services relating to motion picture entertainment, television entertainment and to live entertainment performances and shows, services relating to the

publication of books, magazines and periodicals; providing information on television programming services to multiple users via the world wide web or the internet or other on-line databases, including on-line voting system; production of dance shows, music shows and video award shows; comedy shows, game shows and sports events before live audiences which are broadcast live or taped for later broadcast; live musical concerts; tv news shows; organizing talent contests and music and television award events; organizing and presenting displays of entertainment relating to style and fashion; providing information in the field of entertainment by means of a global computer network; entertainment information; musical entertainment services; provision of information relating to TV programmes, shows and entertainment via the Internet or the world wide web or other on-line databases.

2. At the examination stage, objections were raised under sections 11(1)(c) and 11(1)(b) of the Ordinance in respect of the goods and services applied for on the basis that the subject mark consists exclusively of a sign that designates the characteristics of the applied-for goods and services and is devoid of any distinctive character in respect of the goods and services.
3. On 29 March 2006, the Registry received a request for hearing on the registrability of the subject mark from Messrs Robin Bridge & John Liu for the applicant.
4. On 30 March 2006, Messrs. Robin Bridge & John Liu filed on behalf of the applicant evidence of use of the subject mark by way of a statutory declaration (“SD”) of Mr. Christopher Robert Szpojnarowicz.
5. The hearing took place before me on 21 September 2006. Mr. Anthony C.D. Evans of Messrs. Robin Bridge & John Liu appeared for the applicant. I reserved my decision at the conclusion of the hearing.

### **The Ordinance**

6. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1) and section 11(2) read as follows:

“(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.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

## Decision

### *Section 11(1)(c) of the Ordinance*

7. Section 11(1)(c) of the Ordinance excludes registration of 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.
8. Section 11(1)(c) is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (“Regulation No. 40/94”). In *OHIM v Wm. Wrigley Jr. Company* (Case-191/01 P) [2004] R.P.C. 18 (the ‘*DOUBLEMINT*’ case), the European Court of Justice (“ECJ”) discussed the approach to Article 7(1)(c) of Regulation No. 40/94 and stated at paragraph 32 the relevant principles 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.”
9. These principles indicate that marks that are objectionable under section 11(1)(c) of the Ordinance do not have to be the typical way of describing the applied for goods or services. It is sufficient if at least one of the possible meanings of a mark designates a characteristic of the applied-for goods or services.
10. The subject mark consists of the letters “MTV”. The Oxford Dictionary of Abbreviations (Second Edition) includes the following entry: “**MTV** motor

torpedo vessel • (USA) music television”. Considered in the light of the goods and services applied for, “MTV” is an abbreviation for music television. I find support from the websites quoted by the Registry’s examiners at the examination stage (the websites and their extracts are listed in Appendix A) that the subject mark has been used to denote music television programmes or performances. There is no stylisation of the subject mark or any other additional element to consider. In relation to the applicant’s goods and services such as apparatus for storing, recording, transmitting and reproducing sound and/or images and DVDs featuring concerts and other performances in class 9, wireless transmission services relating to the uploading and downloading of music and communication services of transmitting streamed sound and audio-visual recordings via the Internet in class 38 and production of television programmes and services related to television entertainment in class 41, the subject mark describes goods and services that are for or related to the production, recording, transmission or playing of music television programmes or performances.

11. Mr. Evans submitted that the subject mark “MTV” did not necessarily mean “music television” and the Registrar should not equate “MTV” with “music television”. He said that according to dictionaries such as Longman Dictionary of English Language and Culture and the Collins English Dictionary, “MTV” refers to a music television channel in the United States. As such, he submitted that it was not appropriate for the Registrar to raise objections based on Internet findings. Furthermore he said that all Internet searches were conducted after the application dates and hence not representing the situation as at the respective application dates of the subject applications.
12. I am not persuaded by Mr. Evans’ submissions. The Registrar should reach his decision based on all the relevant circumstances of the case. In the instant applications I note that there are, amongst others, dictionary meanings of the subject mark which may refer to a music television channel in the US. However, I am also aware of the dictionary meaning of the subject mark as denoting music television. The Internet searches carried out by the Registry’s examiners show some of the many such references which I cannot ignore in the instant case. As the subject mark “MTV” has a dictionary meaning of music television and such use is supported by Internet searches, I find that it carries at least one possible meaning that designates a characteristic of the goods and services applied for and objection under section 11(1)(c) should be maintained. Additionally, I do not consider websites dated after the dates of the subject applications to be totally irrelevant. As stated in *DOUBLEMINT*, to be objectionable under section 11(1)(c), it is not necessary for the mark to be actually in descriptive use on the date of application. It is

sufficient if the mark could be used for such a purpose. In my view, the websites, although dated after the application dates of the subject application, are relevant as to the fact that the letters “MTV” could be used to designate a characteristic of the goods and services applied for in the subject applications.

13. Mr. Evans said that if the Registrar was correct in saying that the subject mark had generic use, objections under sections 11(1)(a) and 11(1)(d) of the Ordinance would have been raised. However, the Registrar had not apparently raised such objections.
14. Section 11(1)(c) differs from sections 11(1)(a) and 11(1)(d) and in any event, the inapplicability of one ground of objection does not preclude the applicability of other grounds. In the case *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57 (Case C-363/99) the ECJ discussed Article 3 of the First Council Directive 89/104/EEC (“Directive”) which is broadly similar to section 11 of the Ordinance and held that “each of the grounds for refusal listed in that provision [Article 3(1) of the Directive] is independent of the others and calls for a separate examination” (paragraph 67) and “It follows that the fact that a mark does not fall within one of those grounds does not mean that it cannot fall within another” (paragraph 69). A finding based on any one ground of section 11 is sufficient to refuse registration of the mark applied for.
15. I find that in respect of all the applied-for goods and services, the subject mark indicates that they are products or services that are for or related to music television. I therefore conclude that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristic of the goods and services applied for and is debarred from registration under section 11(1)(c) of the Ordinance for all the goods and services applied for in classes 9, 38 and 41.

#### *Section 11(1)(b) of the Ordinance*

16. Furthermore, I find that the subject mark is debarred from registration under section 11(1)(b) of the Ordinance. Section 11(1)(b) excludes from registration marks which are devoid of any distinctive character. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (“*British Sugar*”), the approach in assessing distinctiveness was discussed. Jacob J said, on page 306 of *British Sugar*:

“What does *devoid of any distinctive character* mean? 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?”

17. In the case *R v “Cycling IS...” Trade Mark Applications* [2002] R.P.C. 37, it was also stated, at paragraph 53 that:

“It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings.”

18. The test of registrability under the equivalent of section 11(1)(b) was further discussed in *Nestlé SA’s Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (at paragraph 23):

“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.”

19. Applying the above legal principles, I must assess the distinctiveness of the subject mark in relation to the applied-for goods and services. I must also have regard to the perception of the average consumers who are reasonably well-informed and reasonably observant and circumspect.
20. In the instant applications, the goods and services applied for include goods for storing, recording, transmitting and reproducing sound and/or images and DVDs featuring concerts in class 9, communication services related to the transmission of sound and images in class 38 and music shows, entertainment and television production services in class 41. The relevant customers include the general public who are seeking these products and services. The subject mark may be applied to the products, their packaging, the programmes/performances and the advertisements, promotional materials or websites for promoting the goods and services.
21. The subject mark consists of the letters “MTV”. As mentioned in paragraph 10, “MTV” is an abbreviation for “music television”. The Internet search results listed in Appendix A support this finding. There is no added element or stylisation to the mark. In the context of the goods and services applied

for, the overall impression of the subject mark on the average consumers is likely to be reference to music television programmes or performances. They are not likely to perceive it immediately as an indication of trade origin of such goods and services.

22. Mr. Evans submitted that the Registry has wrongly concluded that the subject mark is devoid of any distinctiveness merely because it is regarded as descriptive. He said that given the dictionary meanings of the subject mark as references to a music television channel in the United States, it will likely be perceived by the relevant consumers as a trade origin.
23. I am not convinced by Mr. Evans' submissions. In the light of the dictionary meaning of "MTV" as music television and the references of "MTV" to music television programmes as supported by the Internet searches, the other dictionary meanings of the subject mark as referring to a music television channel in the United States are not conclusive as to the perception of the average consumers on the subject mark. It is established that the essential function of a trade mark is to serve as a guarantee of the source of trade. Given the dictionary meaning of the subject mark as an abbreviation for "music television", I am not satisfied that at the time of filing of the present applications the subject mark "MTV" itself will be perceived by the average consumers as a guarantee of trade origin without any possibility of confusion to distinguish the applicant's goods and services from others. As the ECJ judgment of *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) states at paragraph 60:

"60. Article 7(1)(b) CTMR [equivalent to section 11(1)(b) of the Ordinance] is intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 Hoffmann-La Roche [1978] E.C.R. 1139 at [7]; Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] E.C.R. I-5475 at [30], and SAT.1 v OHIM at [23])."

24. I consider that the average consumers are unlikely to perceive the subject mark as an indication of trade origin of the applicant's applied-for goods and services, and the subject mark is therefore devoid of any distinctive character in respect of those goods and services. The subject mark is thus precluded from registration under section 11(1)(b) of the Ordinance in respect of the goods and services applied for.

*Section 11(2) of the Ordinance*

25. Section 11(2) of the Ordinance provides that a trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.
26. Distinctive character may be acquired through use of a mark if as a result of the actual use of the mark on the goods and services, the mark has come to identify the goods or services in question as originating from a particular undertaking and thus to distinguish the relevant goods and services from those of others. The assessment of the distinctive character of a mark was discussed in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots-und Segelzubehör Walter Huber and Franz Attenberger* [1999] E.T.M.R. 585 (C-108/97 and C-109/97), at paragraph 54 where the ECJ found that:

“ - a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings

...

- in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings

- if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied....”

27. In the case *Société des Produits Nestlé SA v Mars UK Ltd.* [2005] E.T.M.R. 96 (C-353/03) (“*Have a Break*”) where the mark in question was used as part of a registered mark, the ECJ has also stated the following:

“ 29 The expression "use of the mark as a trade mark" must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

31 The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that

assessment, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] E.C.R. I-2779, [49] and [51]).”

28. In application of the above principles, I must make an overall assessment of the evidence filed to determine whether a mark has acquired distinctive character as a result of its use. In my assessment the views of the relevant consumers must be taken into account. The crucial question to ask is whether consumers have been educated to recognise the subject mark as a badge of origin of the goods and services applied for. As I have mentioned in paragraph 20 above, the relevant consumers are the general public who are reasonably well-informed, reasonably observant and circumspect. If I consider that a significant proportion of the relevant class of consumers identifies the applied-for goods and services as originating from a particular undertaking because of the use made of the subject mark before the respective application dates, objections raised against the subject mark under sections 11(1)(c) and 11(1)(b) of the Ordinance would be overcome.
29. I now turn to consider the SD filed in support of the subject applications.

*Television programming services*

30. The applicant claimed to have provided television programming services relating to music and entertainment programmes (paragraph 3 on page 3 of the SD) and launched the MTV Mandarin and MTV Asia television channels in Hong Kong since 1995 (paragraph 4 of the SD). The applicant provided the breakdown of number of household subscribers in Hong Kong from 1998 to 2005 for various channels in Asia in the forms of tables (exhibit “B”). The applicant has also filed evidence in the form of agreements or contracts in support of such services including copy agreements relating to the purchases of broadcast time from a local television station for its television programmes (exhibit “C”) and copy distribution contracts for providing programming services to or via a local television station or telecommunication company (exhibits “D” and “E”).
31. I note that on average, except for 1998 and 1999 when the number of subscribers appears to be linked with that of a local television station, the number of household subscribers for the channels in Hong Kong amounts to at

least 300,000 households each year. These figures are not to be ignored but they alone are not conclusive when assessing whether the subject mark has acquired distinctiveness. I must also look at other parts of the evidence to determine if the use of the subject mark has any trade mark significance. As Morritt L.J. in the Court of Appeal stated in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 at paragraph 49, "... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality."

32. In order to decide whether the relevant customers have been educated of the trade mark significance of the subject mark, I have to look for evidence showing how the subject mark was actually presented to those customers. Such evidence should include the applicant's products, television programmes, advertisements and promotional materials such as video clips, leaflets and application brochures in which the subject mark may be used. However, there is insufficient evidence in this respect. Most of the evidences are copy agreements/contracts that are documentation between the applicant and a third party company only and not disclosed to the relevant public. There is no information on exactly what programmes are broadcast to the consumers and the extent of advertising of those services pursuant to the agreements/contracts. Similarly, it is not likely that the tables in exhibit "B" will be available to the public. As such, I cannot ascertain from the evidence whether the subject mark has actually been used in the form as applied for to identify the services concerned as originating from a particular undertaking and thus to distinguish the services from those of other undertakings.

33. In fact, the evidence shows that the stylised forms of "MTV" have been used

by the applicant in relation to its television programming services and were

presented in a way that they could have been perceived by the relevant

customers as trade marks. For instance, the logos



and are shown prominently on top of the tables in exhibit "B" and the



logo was used in the letterheads of the distribution contracts in exhibit “E”. It appears that the stylised forms of “MTV” were likely to have been promoted as a trade mark in respect of the applicant’s television programming services. Nevertheless use of the stylised forms is not relevant as section 11(2) of the Ordinance provides that a trade mark shall not be refused registration if it has acquired distinctive character as a result of the use made of “it”, which refers to the mark applied for. As such the use of the stylised forms of “MTV”, which is not in the form applied for, does not assist.

34. Mr. Evans submitted that the channel names themselves such as “MTV Mandarin” and “MTV Asia” indicated trade mark use of the subject mark “MTV”. I do not agree with Mr Evans’ submission. In the first place there is little evidence that channel names like “MTV Mandarin” and “MTV Asia” have been presented in plain forms to the relevant customers, as there is not much evidence of the actual use of the mark as mentioned above. Even if the relevant customers have come across those names (in plain forms) in relation to the applicant’s television services, I am not convinced that the relevant customers would have relied on “MTV” as a badge of trade origin given the descriptive nature of “MTV”. The word “Mandarin” refers to a common form of spoken Chinese and the customers are likely to perceive “MTV Mandarin” as referring to music television programmes in Mandarin. For “MTV Asia” which is a combination of “MTV” and a geographical indication, it gives the impression of music television from Asia. These marks would not be perceived as different lines of products/services under the name of “MTV”, or otherwise indicate trade origin. I note the ECJ’s judgment in *Have a Break* that there is no bar on a mark acquiring a distinctive character as a result of its use as part of another trade mark. However, on the evidence before me, even if the relevant customers had been exposed to marks like

“MTV Mandarin” and “MTV Asia”, it is unlikely that the subject mark “MTV” itself would have been relied on by them as a trade mark.

35. Other evidences related to the applicant’s television programming services are not of assistance as they do not show use in Hong Kong or are dated after the application dates. For example the launch of the applicant’s services in the United States and the availability of the applicant’s programmes in other countries (paragraphs 3, 4 and 7 of the SD) are not use in Hong Kong. Similarly the number of subscribers in Asia (paragraphs 3 and 5 of the SD) is not useful as it provides no breakdown for Hong Kong. Furthermore, the list of programmes in paragraph 9 of the SD does not assist as there is no indication or supporting document showing that these programmes were broadcast in Hong Kong. The number of subscribers for the applicant’s television programming services in Asia as at September 2004 (paragraph 3 of the SD) is also not relevant as it is after the respective dates of applications.
36. In applying the legal principles set out above in paragraphs 26 and 27, I have made the overall assessment of the evidence of which I find little in support of how the subject mark has actually been presented to the relevant customers. As such I cannot ascertain whether consumers have been educated to recognise the subject mark as a badge of trade origin. For the reasons discussed above, on the basis of the evidence before me, I am not satisfied that a significant proportion of the relevant public has come to identify the applicant’s services related to television programming as originating from a particular undertaking as a result of the use made of the mark applied for.

#### *Sound recordings*

37. The applicant has licensed use of its trade marks to third parties for goods and services related to sound recordings. Exhibit “G” includes copy licence agreements under which MTV Networks, a division of the applicant, grants to music companies in Hong Kong the license to use trade names and logos such as “MTV: Music Television”, “MTV Fantastic Females”, “MTV Non Stop Hits”, “MTV Most Wanted”, “MTV HITLIST”, “MTV I Like” in relation to sound recordings of music in forms such as records, magnetic tapes, compact discs and mini discs. These trade names are all descriptive. I am not persuaded that when the relevant consumers view the above marks in relation to sound recordings, they would have identified “MTV” as an indication of trade origin.
38. In addition there is no evidence on how the licencees applied the marks. For example, samples of the licensed products and promotional materials for those

products were not provided. I disagree with Mr. Evans that the extent of use could be seen from the amounts of royalties payable to the applicant stated in the agreements. These figures are indicative largely of the values of the licensed marks/logos but not of the market share and the extent of the use of the marks, as the actual sales volume of the licensed products was not provided. The agreements produced therefore fail to establish acquired distinctiveness of the subject mark.

39. Having reviewed all the evidence I am therefore not satisfied that the relevant consumers have been educated that the subject mark has been used as a trade mark for the applicant's goods and services related to sound recordings.

*Organisation of music/entertainment events*

40. The applicant has filed evidence in relation to the music and entertainment events it organised. Exhibit "G" includes a copy agreement under which a local telecommunication company was to provide access telephone numbers for events such as the "MTV Asia Music award voting" and exhibit "F" includes a television programme schedule and several newspaper/magazine articles on the "1996 MTV Movies Awards". There is little evidence as to the actual use of the subject mark in these events. Information on the scale and extent of advertising of these programmes was not provided. Based on the evidence filed I do not find that trade mark use of "MTV" has been established. "MTV Asia Music award voting" is likely to be seen as meaning Asian music television programmes/videos award voting and "1996 MTV Movies Awards" is likely to be perceived as the MTV or music television movies awards for the year 1996.
41. The applicant has also filed copy press releases on the "MTV-Billboard Asian Music Conference" held in May 1998 (exhibit "H"). In the press release of 6 March 1998 with the heading "MTV and Billboard Host Asian Music Conference" it is quoted that "MTV and Billboard believe it is important to take the initiative to provide a platform for ...". In this press release I find that the word "MTV" has been used to indicate an undertaking organising the conference. However, the conference appears more like a trade event and not directly related to any services applied-for.
42. The applicant has organised other events such as the "MTV Asia Awards" in Singapore (paragraph 11 of the SD), "Video Music Awards" (paragraph 10 of the SD) and the "CCTV-MTV Music Honours 2003" in the Mainland (paragraph 12 of the SD). Most of these events appear to be held outside Hong Kong. I do not consider that these are relevant to establish use of the

subject mark in Hong Kong.

43. In conclusion I do not find that the evidence has shown that the relevant customers have been educated that the subject mark has been used or promoted as a trade mark of the applicant in respect of services related to organising music/entertainment events.

*Awards/rankings of the applicant*

44. The applicant also relied on awards or rankings it received to illustrate the extent of use of the subject mark. “MTV: MUSIC TELEVISION” operated by the applicant was named Cable & Satellite Channel of the Year at the 2002 Asian Television Awards (paragraph 6 of the SD). Exhibit “H” also shows a magazine article which reports that “MTV” was the 47<sup>th</sup> of the 100 top brands in the world for the year 2004. However, these awards or rankings do not establish acquired distinctiveness of the subject mark in relation to any specific goods or services in Hong Kong as they do not provide details as to how the subject mark was applied in relation to the applicant’s goods and services.

*Others*

45. There is no evidence of use of the subject mark in relation to any of the other applied-for goods and services such as computers and computer programs, mobile phone services and services relating to publication of books, magazines and periodicals.

*Acquired distinctiveness*

46. I have made an overall assessment of the evidence and have considered the legal principles laid down by the ECJ as set out in paragraphs 26 and 27 above. In summary there is little evidence of use indicating how the subject mark was actually presented to the public. I am not satisfied that the evidence filed is sufficient to show that the subject mark has come to be identified by a significant portion of the relevant consumers as an indication of trade origin distinguishing the applicant’s goods and services from those of others. Since the subject mark is descriptive as standing for “music television” in respect of the applied-for goods and services, more compelling evidence is necessary. In *British Sugar* Jacob J. said the following:

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader is taken by the public as a badge of trade origin...” (at page 286)

“...I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark...” (at page 302)

47. Based on the evidence filed, I consider that the applicant has not demonstrated that before the respective dates of applications for registration, the subject mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2) of the Ordinance in respect of all the goods and services applied for. The objections under sections 11(1)(c) and 11(1)(b) must be maintained accordingly.

#### *Foreign registrations*

48. I take note that the subject mark was accepted for registration in other jurisdictions such as the United States, Japan, Australia, Singapore and Europe (as Community Trade Mark) but I do not find them of assistance to the subject applications. It must be borne in mind that domestic 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). Since there are valid grounds of objection in the instant applications I will not accept the subject mark merely because of its overseas registrations in which the reasons for acceptance are not known to me.

#### *Other marks*

49. Mr. Evans referred me to a number of other registered marks in Hong Kong such as “BBC”, “ATV” and “CNN”. Additionally he referred to the examples such as “M.G.S.”, “AA AUTOMOBILE ASSOCIATION” and “BBFB Best Bank For Business”, “BWC Beyond World Class”, and “BCIB BEST COLA IN BRITAIN” quoted from paragraph 19.2.4 of the Trademarks Work Manual issued by the Trade Marks Registry of the UK Patent Office on registrability of two or more letters presented as a descriptive abbreviation. As there are valid grounds of objection in the subject applications, I am not prepared to accept the subject mark on the basis of these marks or examples. In any event, I do not consider it appropriate to compare the subject mark with other marks. Each case must be considered on its own merits. As stated in *British Sugar*, “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* ([1966] R.P.C. 541) and the same must be true under the 1994 Act.”

### **Conclusion**

50. In this decision I have considered all the evidence filed by the applicant, the submissions of the applicant’s agent and all the relevant facts and circumstances of the case. The subject mark is found to consist exclusively of a sign which may serve, in trade or business, to designate the characteristics of goods and services and to be devoid of any distinctive character under sections 11(1)(c) and 11(1)(b) of the Ordinance in respect of the goods and services applied for. The subject applications are accordingly refused under section 42(4)(b) of the Ordinance.

Sarah Li  
for Registrar of Trade Marks  
14 March 2007

## Appendix A

1. **MTV** 在新加坡、香港、台灣等華語地區廣泛地代表了 "音樂短片"。我們專業製作高質素的 Flash 動畫 **MTV**，作推廣宣傳和音樂短片用途。歡迎參考以下作品。  
<http://www.mtv.net/>
2. 目前在卡拉 OK 廳播放的伴唱帶差不多全是盜版，畫面質量和音效一般。為使聽眾聽到、感受到王啓文正版《老鼠愛大米》的魅力，公司決定向卡拉 OK 廳免費提供《老鼠愛大米》的正版 **MTV**。  
[http://ent.sina.com.hk/cgi-bin/news/show\\_news.cgi?ct=music&type=pop&date=2005-02-07&id=65849](http://ent.sina.com.hk/cgi-bin/news/show_news.cgi?ct=music&type=pop&date=2005-02-07&id=65849)
3. 2005 年電影錄影短片比賽  
短片可以是劇情片、紀錄片、動畫片形式或音樂 **MTV** 形式參加比賽，長度請盡量在 15 分鐘以內。  
<http://www.hkfilm.com/shortfm.htm>
4. **Feel So Good Sammi** - 鄭秀文的照片、歌詞、電影、**MTV**、real audio 及 MP3 歌曲下載。  
[http://timway.com/hk/Stars/Female/Cheng\\_Sammi/](http://timway.com/hk/Stars/Female/Cheng_Sammi/)
5. THE VERY BEST OF **MTV** UNPLUGGED VOL . 3 ( WITH BONUS DVD )  
[http://www7.cd-wow.com.hk/detail\\_results.php?product\\_code=13853](http://www7.cd-wow.com.hk/detail_results.php?product_code=13853)  
*[not available on the Internet as at the date of this decision]*
6. Wedding Video Service  
Including Wages for video-man  
25pcs Photos **MTV**-for whole day only  
Computer editing  
Background music  
One set of DVD  
<http://www.eden.com.hk/Servies%20Price%20List.htm>  
*[not available on the Internet as at the date of this decision]*
7. The most attractive function is the **MTV** play function, which can be displayed various format files of **MTV** on the screen. The AIGO have fulfilled to transfer the common video files, such as AVI, RM, MPEG, ASF, WMV, to the unitive format files, **MTV** through a new transfer software. Therefore, no matter where you are, you could enjoy the exciting ball match moment, or humor advertisement, DV video film and so on. This Function will become the mainstream of the MP3 new style, which is quickly popular in the public.  
<http://www.etexpo.com/DispArticle.aspx?id=8214>  
*[not available on the Internet as at the date of this decision]*