

## TRADE MARKS ORDINANCE (Cap. 559)

**APPLICATION NO.:** 300204894

**MARK:**

A ISHOW  
B ishow  
C ĩshow

**CLASS:** 38

**APPLICANT:** SMARTONE MOBILE COMMUNICATIONS  
LIMITED

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### STATEMENT OF REASONS FOR DECISION

#### Background

1. On 27 April 2004, SmarTone Mobile Communications Limited (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”), to register the following series of three marks,

A ISHOW  
B ishow  
C ĩshow

(“the subject mark”) in Class 38.

2. The services for which registration is sought are as follows:  
telecommunication services; provision of telecommunication access and links to computer database and to the Internet; electronic communication services; interactive telecommunications services; telecommunication of information (web pages), computer programs and data; providing telecommunications connections to the Internet or data bases; telecommunication gateway services; computer network communication services; provision of telecommunication access to world-wide web facilities and structures; communication by computer terminals, communication by fibre optic networks, computer aided transmission of messages and images, facsimile transmission, message sending, paging services, rental of modems, data communication services by electronic means; telephone services, telegraph services, telex services; telegraphic-wire services; wire services; satellite communication services; electronic mail services; rental of telecommunication equipment; electronic message sending, receiving and forwarding services; collection, transmission and delivery of data by electronic means; collection, transmission and delivery of mail message, telegrams, information and data by mechanical means, electronic messaging, conferencing and order-transmission services; radio and television communication services; communication services between computers; provision of telecommunication access to signal coding and decoding apparatus; broadcasting and transmission of radio and television programmes; cable television broadcasting; preparation of reports in relation to the foregoing services; provision of telecommunication facilities for interactive discussion and conversation; issuance of telephone card services; providing telecommunication access to digital

music websites on the Internet; providing telecommunication access to MP3 (moving picture experts group-1 audio layer 3) web sites on the Internet; delivery of digital music by telecommunications; operating search engines; computerized consultation of telephone directories information; consultancy, information and advisory services in relation to the aforesaid services; all included in Class 38.

3. 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 services applied for.
4. The applicant requested a hearing which took place before me on 5 September 2005. Mr. Andrew Chan of Messrs. So Keung Yip & Sin appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
5. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

### **Trade Marks Ordinance**

6. 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**

7. The subject mark consists of a series of word marks, namely (A) “ISHOW” in plain block capitals, (B) “ishow” in lower cases, and (C) “ishow” in lower cases and in different font from that of mark (B).

8. Mr. Chan emphasized that the subject mark is a single word mark. There is no space between the letter “I” and the word “SHOW” nor is the subject mark presented in the form of “I-SHOW” or “I\_SHOW”. Therefore, a reasonable person hearing the subject mark “ISHOW” for the first time is not likely to dissect it into the letter “I” and the word “SHOW”. Even if the subject mark is dissected, it could alternatively be dissected into the words “IS HOW” or “I SHOW” (with the word “I” referring to the person reading the subject mark). Additionally, “I” does not only mean “Internet” but can also mean “I” (referring to a person), and the word “SHOW” has various meanings. Hence, the subject mark could be interpreted in different ways to that suggested by the Registrar.
9. In my view, when average consumers see the subject mark used in relation to the services applied for, which all related to telecommunication and broadcasting fields, and noting that the word “SHOW” is just an ordinary English word, they would naturally break the subject mark into the letter “I” and the word “SHOW”. This is also the way they would likely pronounce the subject mark.
10. I agree with Mr. Chan that the subject mark “ISHOW” may be perceived as an association of two ordinary English words, i.e. “I” (referring to the person reading the subject mark) and “SHOW”. It is also true that the letter “I” can have different meanings depending on the context in which it is used. However, in the present context, i.e. in the fields of telecommunication and broadcasting related services, I believe the obvious reference is, as supported by the examiner’s finding at [www.acronymfinder.com](http://www.acronymfinder.com), to “Internet”. Moreover, as the letter “I” being increasingly used as a general prefix relating to an action conducted through the Internet, the relevant public, who are users of those services, will instantly assume that “I” stands for “Internet” and not for any other possible meanings. In fact, Mr. Chan did not dispute that the letter “I” could stand for “Internet”.
11. The meanings of “SHOW” include the following:
- “to present to view”; “exhibit” – *Collins English Dictionary (Third Edition Updated 1994)*
  - “a public exhibition or entertainment”; “show or demonstrate something to an interested audience” – [www.onelook.com](http://www.onelook.com);
  - “exhibit or produce for inspection or viewing”; “a light entertainment programme on television or radio” – *Compact Oxford English Dictionary*<sup>1</sup>

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<sup>1</sup> [http://www.askoxford.com/concise\\_oed/show?view=uk](http://www.askoxford.com/concise_oed/show?view=uk)

- “to make it possible for something to be seen”; “an event at which a group of related things are available for the public to look at”; “a theatrical performance or a television or radio programme which is entertaining rather than serious” – *Cambridge Dictionaries Online*<sup>2</sup>

12. Given the meanings of the letter “I” and the word “SHOW” above and in respect of the services in question, I consider that consumers will readily perceive the subject mark “ISHOW” as an abbreviation of the full expression “INTERNET SHOW”.

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

13. 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 services in respect of which registration is sought.

14. Mr. Chan pinpointed that the word “exclusively” means that a mark, to be objectionable under section 11(1)(c), must consist only of descriptive matters. He made reference to the following passage from “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37:

“I do not think that the signs as a whole are caught by the exclusion from registration contained in Article 3(1)(c) [of the First Council Directive 89/104/EEC] /section 3(1)(c) [of the Trade Marks Act 1994] [which are broadly similar to section 11(1)(c) of the Ordinance] because I do not think that they can be said to consist “*exclusively*” (*i.e.* simply and solely, as contemplated by the ECJ in *BABY-DRY*) of matter that is descriptive of the kind or characteristics of the goods and services for which registration has been requested.”

15. Mr. Chan submitted that the subject mark did not consist exclusively of descriptive signs, as some of the people would interpret the subject mark in a different way. For example, the subject mark should be considered as a whole as “ISHOW” or, alternatively, could be dissected into the words “IS HOW” or “I (referring to the person reading the subject mark) SHOW”. All such interpretations possessed distinctive character.

16. He argued that even if the subject mark “ISHOW” was dissected into “I” and “SHOW”, the subject mark did not contain any descriptive meanings. Firstly,

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<sup>2</sup> <http://dictionary.cambridge.org/results.asp?dict=B&searchword=show>

“I” does not only mean “Internet” but can also mean “I” (referring to a person). Secondly, the word “SHOW” is not descriptive of the services applied for, which are essentially telecommunication services not entertainment services, nobody would associate them with the word “SHOW”. Therefore, the subject mark could not be objected that it consists exclusively of descriptive signs. He, relying on *Mark Foy’s Limited v Davies Coop And Company Limited* [1956] 95 CLR 190, contended that in so objecting to the separate parts “I” and “SHOW”, the Registrar had instituted a search for a meaning of the subject mark.

17. While I accept that “exclusively” in section 11(1)(c) of the Ordinance means simply and solely as affirmed in *“Cycling IS...” Trade Mark Applications*, I also take note of the relevant principles set out in *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) v Wm. Wrigley Jr. Company*, Case C-191/01P (the “*DOUBLEMINT*” case), in which the European Court of Justice has explained the correct approach to the application of Article 7(1)(c) of the Council Regulation (EC) No 40/94 (which is broadly similar to section 11(1)(c) of the Ordinance). At paragraph 32 of the “*DOUBLEMINT*” case, it was stated that:

“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.”

18. The above principles indicate that for a mark to be caught by section 11(1)(c) of the Ordinance, it is sufficient to find that the mark could be used to designate the characteristics of the specified goods or services, and the mark must be refused for registration if at least one of its possible meanings designates a characteristic of the goods or services. Accordingly, in my view, the word “exclusively” in section 11(1)(c) of the Ordinance does not mean that section 11(1)(c) only applies when the only meaning that can be given to the mark is the descriptive one.
19. The meaning of the subject mark, including each of its components, has been explained above. In the present application, the services applied for cover a wide range of telecommunication and broadcasting services, and they are likely

to be patronized by the public in general.

20. I do not agree with Mr. Chan's submissions that the subject mark does not contain any descriptive meanings. In the context of the services applied for, the subject mark directly tells the relevant consumers that the services facilitate users to present or exhibit something on the Internet for public viewing, or to present or view radio or television programmes or other events through the Internet. Contrary to Mr. Chan's contention, in relation to "radio and television communication services", "broadcasting and transmission of radio and television programmes", "cable television broadcasting", "providing telecommunication access to digital music websites on the Internet", "providing telecommunication access to MP3 web sites on the Internet", and "delivery of digital music by telecommunications", etc., the subject mark conveys an unequivocal message that the radio or television programmes or songs are made available through the Internet. Consequently, the subject mark could be used to designate the kind and intended purpose of the services applied for.
21. The word "ISHOW" does not cease to be descriptive simply because it can have more than one meaning. In the mind of the average consumer, "ISHOW" is spontaneously associated with certain characteristics of the services in question, namely presenting something on the Internet for viewing, or viewing entertainments through the Internet. Therefore, the subject mark is necessarily descriptive and cannot serve as an indicator of trade origin.
22. To my mind, the word "ISHOW" is also capable of being used by other service providers to designate similar characteristics of their own services. As quoted by Mr. Chan, it was stated in *AD2000 Trade Mark* [1997] RPC 168 that:

"...there is nothing for such protection to attach to or bite upon when a sign serves only to designate characteristics other than origin. Signs and indications of that kind can be used with equal truth by traders whose goods or services are possessed of the relevant characteristics."
23. Based on the above reasons, I 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 services applied for and is, therefore, excluded from registration by section 11(1)(c) of the Ordinance.

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

24. 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.

25. 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* 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?”

26. In “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37, it was stated 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.”

27. 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.”

28. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must be capable of identifying the products or services as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. I must assess the mark’s distinctiveness in relation to the services for which the applicant seeks registration, which include telecommunication and broadcasting services. I must also have regard to the perception of the relevant consumers of these services, who in my view are the general public.

29. Mr. Chan submitted that the subject mark “ISHOW”, viewing as a whole, is a coined or invented word and is not found in the English dictionary. Alternatively, the subject mark could be dissected into the words “IS HOW” or

“I SHOW” (with the word “I” referring to the person reading the subject mark), both of which should be regarded as being distinctive.

30. I agree with Mr. Chan that in assessing the distinctiveness of a mark, the mark must be considered as a whole. As explained above, I consider that, in connection with the services applied for, the relevant consumers will see the subject mark, on first impression, as an abbreviation for “INTERNET SHOW”. Consequently, the subject mark clearly conveys a message to the relevant consumers that the services applied for allow them to publish or exhibit something on the Internet, or to present or see entertainments through the Internet.
31. In my judgment, 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 services applied for, rather than a badge of trade origin identifying the services as originating from a particular undertaking. Accordingly, the conjoining of “I” with “SHOW” is not sufficient to bestow distinctive character on the subject mark as a whole so that it may serve in trade or business to distinguish the services of the applicant from those of other traders.
32. The fact that the word “ISHOW” is not cited in English dictionaries does not necessarily mean that the subject mark possesses a distinctive character. The crux of the matter is whether the subject mark would be seen by the relevant consumers as an indication of trade origin of the services applied for. In my opinion, the subject mark will not be identified as a trade mark without first educating the public that it is a trade mark.
33. Additionally, as the subject mark is equally applicable as a description of similar characteristics of the services provided by other undertakings, it would not enable the relevant consumers to distinguish the applicant’s services from those of other undertakings.
34. For the reasons stated above, I take the view that the subject mark cannot fulfill the essential function of identifying the source of the services applied for so as to distinguish the applicant’s 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.

*Reference to registered trade marks on the register*

35. Mr. Chan drew my attention to three registered trade marks on the register, namely “IMOVIE” in Class 9, “E-TICKET” in Class 39 and “E-SPEAK” in Class 9, and submitted that they were no more distinctive than the subject mark.
36. However, I consider that those registered marks are not so directly descriptive of the claimed goods or services. In any event, it is well established that each case must be considered on its own merits and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305). Therefore, I do not find that the acceptances of the quoted marks can assist the subject application. In particular, where there are valid grounds of objections under the Ordinance, I do not consider that the subject application can be accepted solely on the basis of the earlier registered trade marks.

**Conclusion**

37. In this decision, I have considered all the documents filed by the applicant and all the arguments submitted in relation to the subject application. 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  
20 January 2006