

## TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300278299AA

MARK : 

APPLICANT : NOKIA CORPORATION

CLASSES : 9

### STATEMENT OF REASONS FOR DECISION

#### Background

1. On 1<sup>st</sup> September 2004, Nokia Corporation (“the Applicant”) of Finland applied to register the mark consisting of a sound shown below under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).



2. The subject application no. 300278299AA is made in respect of the following goods in Class 9 (“the goods applied for”):-

#### Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

3. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance, in particular, in respect of “apparatus for recording, transmission or reproduction of sound or images”.

4. Pursuant to the Applicant's request, a hearing on the registrability of the mark took place before me on 9<sup>th</sup> October 2006, at which Ms. Coral Toh of Ella Cheong (Hong Kong) Limited appeared on behalf of the Applicant. Prior to the hearing, the Applicant made no application to amend the specification of goods. At the hearing, Ms. Toh was reminded and she acknowledged that at the hearing stage, the subject application would be examined in respect of all of the goods applied for, not limited to "apparatus for recording, transmission or reproduction of sound or images". I reserved my decision at the end of the hearing.
5. At the hearing, Ms. Toh applied for leave for the Applicant to file evidence of use on or before the day after the hearing, 10<sup>th</sup> October 2006. Having considered the facts that the relevant statutory declaration had already been prepared pending the filing of the original copy, the short delay of one day and the purported nature of the statutory declaration, I granted the leave. In the afternoon of 9<sup>th</sup> October 2006, a statutory declaration made by Auli Luukkanen-Lääperi and Ulla James jointly on behalf of the Applicant ("the Statutory Declaration") was filed with a view to showing that the subject mark had in fact acquired a distinctive character as a result of the use made of it by the Applicant for the purpose of section 11(2) of the Ordinance.

### **The Ordinance**

6. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provision under section 11 reads as follows:-
  - “(1) Subject to subsection (2), the following shall not be registered –
    - (a) ...;
    - (b) trade marks which are devoid of any distinctive character;
    - (c) ...
    - (d) ...”
7. Notwithstanding the prohibitions against registration set out in section 11(1)(b), (c) and (d), section 11(2) provides that:-
  - “(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.”

## **The applicant's submissions and evidence of use**

### *Inherent registrability*

8. Ms. Toh claimed that the subject mark was inherently distinctive under the Ordinance. Referring to *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 and *Nestle SA's Trade Mark Application ("Have a Break")* [2004] F.S.R. 2, Ms. Toh submitted that the criteria for assessing the distinctive character of sound marks, such as the subject mark, are no different from those to be applied to marks which consist of words and/or devices. Ms. Toh emphasized that just because a mark consisted of a sound did not make it inherently unregistrable or indistinctive.
9. Ms. Toh further contended that the public in Hong Kong could recognize sound just as well as they could recognize devices as marks; just because some electronic devices made or emitted sounds did not mean that the subject mark was not registrable. Ms. Toh submitted that the subject mark was distinctive in respect of the goods applied for.

### *Acquired distinctiveness*

10. In the alternative, Ms. Toh submitted that the subject mark had acquired a distinctive character as a result of the use made of it in Hong Kong. Ms. Toh stated that the subject mark was embodied in all mobile phones sold in Hong Kong as a "wake-up" tune and it was the most well-known ring tone in the world. To substantiate this proposition, Ms. Toh invited me to take judicial notice of the information contained in seven internet websites<sup>1</sup>, contending that the information was common knowledge on the internet. According to Ms. Toh, as Hong Kong is part of the world, the subject mark being a well-known ring tone in the world, as claimed in one of the articles on the internet websites, would mean that it was well-known in Hong Kong.
11. In the Statutory Declaration, it was stated that the subject mark was some of the "first notes" of the Applicant's "Wake-up Tune embedded in all phones sold in Hong Kong and is always played when the phones are switched on". The subject mark constituted "a significant portion of the whole tune". Reliance was placed on the same seven internet websites that Ms. Toh quoted

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<sup>1</sup> The same seven internet websites were quoted in the Statutory Declaration, at paragraph 5.

at the hearing to show that the subject mark was “the most well-known ring tone” and “internationally recognized”. The Statutory Declaration, however, does not show the whole tune and how the subject mark forms “a significant portion” of the whole tune. No further evidence is provided to substantiate the claim that the subject mark is “the most well-known ring tone”.

12. It was further claimed in the Statutory Declaration that the goods embedded with the subject mark were advertised and promoted in Hong Kong. The Statutory Declaration, however, did not provide information such as the date of first use of the mark in Hong Kong in respect of the goods for which registration is sought, the sales figures of the goods sold under the subject mark or the relevant advertising or promoting expenses.

## **Decision**

### *Inherent registrability*

13. I will, first of all, consider the inherent registrability of the subject mark. Under section 11(1)(b) of the Ordinance, a sign is precluded from registration if it is devoid of any distinctive character. In *British Sugar Plc v James Robertson & Sons Ltd* (supra), Mr. Justice Jacob 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?”

14. Further to the above principle, in assessing the distinctive character of a sign, Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* (supra), at 26 stated that:

“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.”

15. In view of the above legal principles, distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it for the purpose of section 11(2), must be capable of identifying the product as

originating from a particular undertaking, and thus distinguishing it from those of other undertakings. The distinctiveness of the mark must be assessed by reference to the goods for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.

16. I am in agreement with Ms. Toh that the criteria for assessing the distinctive character of a sign which consists of a sound, such as the subject mark, are no different from those to be applied to other types of mark. However, as the perception of the relevant consumers is not necessarily the same in respect of different types of marks, it may prove more difficult to establish inherent distinctiveness for some categories of marks than for others. For instance, a word or figurative mark which consists of a sign unrelated to the appearance of the products it denotes may be more readily perceived by the public as an indication of trade origin than a three-dimensional mark which consists of the appearance of the product itself. (See *Henkel KGaA v. OHIM* [2005] ETMR 44, paragraph 38, *Mag Instrument Inc. v. OHIM* [2005] ETMR 46, paragraph 30.) Although both cases are concerned with three-dimensional trade marks consisting of the appearance of the products themselves, I consider that the relevant principle is equally applicable to sound marks.
17. In the subject application, the mark consists of a sound represented by a musical score of thirteen musical notes in four bars with a treble clef, quavers, crotchets and a dotted minim. The goods applied for cover a wide variety of apparatus and instruments for different purposes, ranging from electrical and electronic products to computers, cash registers and fire extinguishing apparatus and so on. When assessing the inherent distinctiveness of the subject mark, I must consider the context in which the mark is used in respect of the goods applied for. The use of a mark in respect of the relevant goods includes embedding it into the goods, applying it on the goods or their packaging as well as using it in the course of advertising or promotion of the goods.
18. Most of the goods applied for, such as the different types of electrical or electronic apparatus or instruments, computers and fire extinguishing apparatus are general merchandise which a member of the general public would purchase and consume from time to time. As to the automatic vending machines, coin-operated apparatus and cash registers, they are ordinary

products which entrepreneurs and shop owners of different trades would require in connection with their businesses.

19. Owing to the nature of the subject mark, the goods into which the mark can be embedded must be products which can emit sounds, such as computers, coin-operated apparatus and the different types of electrical or electronic apparatus and instruments of the applied for goods. The sound emitted from these products can be a simple note or a series of musical notes. For example, a melody consisting of a string of musical notes is often emitted from a computer, coin-operated machines or mobile phones to signal that the product is functioning, when it is switched on and off, or when an application is started up or shut down.
20. Presuming that the relevant consumers of these applied for goods which may emit sound are reasonably well-informed and observant, they would be used to hearing a sound being emitted from these goods. On hearing the subject mark, however, the relevant consumers would only perceive it as a sound that signals that the goods are in operation but no more. I am not satisfied that without first educating the relevant consumers, the relevant consumers would regard the subject mark, being emitted from these sound-emitting goods, as an indicator identifying a particular undertaking from which these sound-emitting goods originate. In the context of embedding the mark into the sound-emitting products in Class 9 for which registration is sought, the subject mark fails to perform the essential function of a trade mark, which is to guarantee the identity of the origin of the marked products to the consumer by enabling him to distinguish the products from others which have another origin.
21. Apart from embedding the mark into the goods, the fair use of the mark would also include the use of the subject mark in advertising and promotion of the goods applied for. Use of the mark in this manner would be assessed in respect of all of the goods applied for, whether or not a sound can be emitted from the goods.
22. Advertising and promotion of the subject mark in respect of all of the goods applied for can be carried out generally through broadcasting or by using sound emitting apparatus at promotion booths. For example, the subject sound mark in respect of the goods applied for can be advertised or promoted

on television or radio, or from the promotion booths in the streets. I am of the view that when the subject sound mark is played in the course of promoting the goods applied for, the relevant consumers of these goods, upon hearing the sound, would perceive it as the background music or as a means to draw their attention to the advertisement or promotion.

23. The average consumers are not very attentive in the sense that if a sign does not immediately indicate to them the origin of the products but merely gives them purely promotional or abstract information, they will not take the time to enquire into the sign's various possible functions or mentally register the sign as a trade mark (see *REAL PEOPLE REAL SOLUTIONS*, European Court of Justice Case T130/01, 5 December 2002). As sounds or music of a sort similar to the subject mark are often used in advertising when a product is promoted, the relevant consumers are generally not accustomed to perceiving a sound emitted in the course of an advertisement or promotion as an indication of trade origin.
24. In the premises, the present application for registration of the subject mark in respect of the goods applied for is refused on a *prima facie* basis under section 11(1)(b) of the Ordinance.

#### *Acquired distinctiveness*

25. Although I have found that the subject mark has no inherent distinctive character as a trade mark, if the subject mark has in fact acquired a distinctive character as a result of the use made of it in respect of the applied for goods for the purpose of section 11(2), the application for registration of the subject mark should not be refused. I shall therefore proceed to consider whether the subject mark has actually acquired a distinctive character with reference to the evidence of use filed by way of the Statutory Declaration.
26. To assess the acquired distinctiveness, the Court of Justice of the European Communities stated in *Windsurfing Chiemsee Produktions Und Vertriebs GmbH v. Boots-Und Segelzubehor Wlater Huber* (Joined Cases C-108 and 109/97), [2000] Ch. 523 at 556:

“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”

27. Although the above case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC (of 21 December 1988 to approximate the laws of the Member States relating to trade marks), the provisions of the article are broadly similar to section 11(2) of the Ordinance and I find that the relevant principle is applicable to the subject application.
28. In the Statutory Declaration, it is asserted that the subject mark is “embedded in all phones sold in Hong Kong and is always played when the phones are switched on”. The Statutory Declaration, however, does not provide information as to when the first use of the subject mark in Hong Kong was or how many phones in which the subject mark is embedded have been sold. Although it is claimed that advertising and promotion of goods embedded with the subject mark have been conducted, it is unknown whether the advertising and promotion were carried out in Hong Kong, when they were conducted, their scales and the expenses incurred. No documentary evidence has been provided to substantiate these claims. In the circumstances, I do not consider that these assertions carry any weight in the subject application for the purpose of establishing acquired distinctiveness under section 11(2) of the Ordinance.
29. The Applicant also sought to rely on the information contained in various internet websites. Extracts of these internet websites are marked as Exhibits B to H to the Statutory Declaration.
30. These internet websites, however, do not show that the subject mark has been used in Hong Kong. Ms. Toh argued that whenever a reference to “the world” was made, it should be taken as including Hong Kong. I do not agree. “The world” in these websites is used in a general sense. I am not convinced that whenever “the world” is used, it actually means all countries or places in the world. Furthermore, the contents of these internet websites are not verified or substantiated by statistics or figures to show that there is indeed use or sales in Hong Kong prior to the application date and none of these internet websites seems to relate to the conditions or otherwise connected to the relevant markets in Hong Kong. I am not satisfied that the information contained in these internet websites serves to establish that the subject mark has acquired a distinctive character as a result of the use made of it in Hong Kong, let alone at a time prior to the application date.

31. Moreover, all of the internet websites are about the “Nokia Tune” in mobile phones only. I am not persuaded that the use of the subject mark in respect of the goods applied for generally has been verified by the evidence filed. In any event, for reasons explained in the preceding paragraph, I am not prepared to accept the information contained in the internet websites as evidence of use in Hong Kong even in respect of mobile phones for the purpose of section 11(2) of the Ordinance.
32. Invoices, sales figures, sales volumes, promotional materials or advertising expenses incurred in relation to the use of a sign as a trade mark are not the only forms of evidence that an applicant of the trade mark application may submit in order to establish that a sign has acquired a distinctive character as a result of the use made of it in Hong Kong. However, in the absence of these materials and the lack of other substantial evidence showing use of the subject mark in respect of the applied for goods in Hong Kong prior to the application date, I am unable to find that the subject mark has acquired a distinctive character in respect of any of the applied for goods for the purpose of section 11(2) of the Ordinance.
33. Ms. Toh also invited me to take judicial notice of the information as contained in the internet websites. Suffice it to say that as the contents of the internet websites are not verified or shown to be accurate, and such matters are far short of being notorious, I decline to take any judicial notice of the information contained in these internet websites. In any event, for reasons stated above, the information contained in these internet websites does not show use of the subject mark in respect of the goods applied for in Hong Kong.
34. In the premises, I am not persuaded that the evidence filed by the Applicant shows that the subject mark has come to identify any of the applied for goods as originating from a particular undertaking before the application date. The evidence does not show that the mark has in fact acquired a distinctive character in Hong Kong as a result of the use made of it for the purpose of section 11(2) of the Ordinance.

*Other registered marks on the register*

35. Ms. Toh had referred me to a number of marks that have been registered or

accepted for registration in Hong Kong on a *prima facie* basis. In Ms. Toh's view, these registered marks are comparable to the subject mark. I have reviewed the registrations of these marks but I consider that none of the quoted examples is on par with the subject application. In any event, I do not think that it is appropriate to make direct comparison between different marks on the register. Each case must be considered on its own merits. This issue has been discussed in *British Sugar Plc* (supra):-

“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, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

36. There are valid grounds for refusal and I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the Applicant in overcoming the objection in the subject application.

### **Conclusion**

37. I have considered all the evidence and submissions filed by or on behalf of the Applicant in relation to this application and the relevant provisions of the Ordinance. For the reasons stated above, I find that the mark is precluded from registration under section 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Margaret K.W. YU  
for Registrar of Trade Marks  
3<sup>rd</sup> April 2007