

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300312056

MARK: ^A Ringsong
 ^B RINGSONG
 ^C ringsong

CLASSES: 9 & 38

APPLICANT: SMARTONE MOBILE COMMUNICATIONS LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 2 November 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 Ringsong
^B RINGSONG
^C ringsong

(“the subject mark”) in Classes 9 and 38.

2. The goods and services for which registration is sought are as follows:

Class 9

apparatus for storing, recording, transmitting and reproducing sounds and/or images; sound and video recordings; players for singing with pre-recorded background music; entertainment apparatus for singing with pre-recorded background music; audio receivers and video receivers, loudspeakers, speaker apparatus, microphones and microphone mixers; stereo headphones; computer programs, software linking digitized video and audio media to a global computer information network; apparatus and instruments for displaying and/or printing out data, information, pictures and/or images; voice mail system; telephone dialling apparatus by vocal synthesizer; answering machine; telephone answering apparatus; automatic answering apparatus for communications apparatus; computer programs; computer software supplied on the Internet; on-line electronic publications (downloadable from the Internet); scientific, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and teaching apparatus and instruments; apparatus and instruments for recording, receiving, transmitting and/or reproducing data, information, pictures, images, and/or sound; telephones, pagers, mobile phones, facsimile machines; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; video tapes, audio cassettes, compact discs, floppy discs, CD ROMS and DVD ROMS; data processing equipment and computers; computer software for searching of data; cards, wires, discs and semiconductor devices carrying computer programs; telecommunications apparatus, instruments, networks and circuitry; cables, cable installations, optical fibres, optical communication apparatus and circuitry, all for



telecommunication purposes; electronic and computer apparatus and instruments for debiting and/or crediting financial accounts and/or for paying for goods or services; machine-readable debit and/or credit and/or charge cards; electronic and computer apparatus, instruments and software for communicating with computer networks and the world-wide web; television, radio, video and audio apparatus, equipment and devices; digital music (downloadable) provided from the Internet; MP3 (Moving Picture Experts Group-1 audio layer 3) players; computer software for event scheduling and for managing, viewing and editing address books and personal and professional contact information; apparatus for coding and decoding signals; and parts and fittings for all the aforesaid goods; all included in Class 9.

Class 38

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, 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. Objections were taken against the application under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the goods and services applied for.
4. The applicant requested a hearing which took place before me on 20 December 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. The applicant did not file any evidence of use of the subject mark. I therefore have 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 two ordinary English words “RING” and “SONG” conjoined.
8. Mr. Chan submitted that the word “RING” may be used as a verb referring to the act of causing something to make a sound, such as “to ring a bell” or “to ring a fire alarm”. However, the word “SONG” means music intended to be sung and it is not capable of causing other thing to sound. He therefore believed that ordinary people would not be likely to use “RING” in association with “SONG”.
9. *The New Oxford Dictionary of English (1998)* defines “RING” as denoting, among other meanings: “make a clear resonant or vibrating sound”; “each of a series of resonant or vibrating sounds signalling an incoming telephone call”; “a loud clear sound or tone”.

The meanings of “SONG” include:

- “a poem or other set of words set to music”; “singing or vocal music” – *Compact Oxford English Dictionary*¹;
 - “a short musical composition with words” – www.onelook.com
10. According to the following Internet websites quoted by the examiner², the term

¹ http://www.askoxford.com/concise_oxd/song?view=uk

² excluding those whose web pages can no longer be located at the date of the hearing

“RINGSONG” has been used in the trade:

http://www.24x7updates.com/FullStory-News-Gracernote_Introduces_New_Mobile_Music_Offerings_to_Spur-ID-36517.html

“Building on Gracernote’s award-winning music recognition technology, wireless integrators can now seamlessly integrate related content and commerce offerings directly onto the handset using Gracernote Link(SM), enabling their customers to automatically purchase ringtones, **ringsongs** and more.”

<http://festive-mobile-ringsong.tinusi.com/index.php>

“We cover various aspects of festive mobile **ringsong** and even list many the related festive mobile **ringsong** searches on the left, making it easy for you to gather as much festive mobile **ringsong** info as possible.”

<http://www.sonymusic.co.jp/mobile/chakuuta/eng.html>

Chaku-uta(****ringsong****/Master-tone) is a service that users may download the master music to their mobile phones to set the music up as a ringtone. It is the first time that such service to be available in the world.

www.alfa-tech.com.hk/features01.html

ALFA

Do never pull out the phone and leave it as it is. X Live stop music automatically when you have a call and talk over X live. Moreover, You can use the X Live for telephone dialing. MP3 **Ring Song** You can select any MP3 song for incoming ...

11. Given the dictionary meanings of the words “RING” and “SONG” and their usage in the trade, I consider that the term “RINGSONG” is used to indicate that a song or music will act as, or be substituted for, a ring tone, incoming call indicator or response signal. Contrary to Mr. Chan’s contention, the above Internet findings show that people have already used “RING” in association with “SONG” in respect of telecommunication goods and services.
12. At the hearing, Mr. Chan contended that it was not appropriate for the Registrar to raise a registrability objection based on the results of the Internet searches. He referred me to Chapter 6.10 of the UK Trade Marks Registry Work Manual in relation to the use of the Internet by examiners. The whole text of the relevant paragraph 10.1 is set out below:

Web-wide searches should not be carried out as a matter of routine. Searches may be justified either where the Examiner has identified a descriptive meaning from the usual references (i.e. technical dictionaries or subject-specific websites identified by the Registry as suitable reference sources) but is unclear about whether the word(s) are really apt for use in trade as a description, or because the Examiner has suspicions that an apparently non-descriptive word(s) has come to be used in trade as a description. The latter will usually only be justified in fast moving fields, such as information technology where it is often difficult to keep up with the current language of the trade. However, the same point could apply wherever the goods/services appear to be of a new type or are highly specialized.

13. Mr. Chan argued that there was no indication from the Registrar’s opinion that the

examiner identified any descriptive meaning for the word “RINGSONG” from her usual references before conducting the Internet searches. Therefore, it was not justified to conduct the Internet searches.

14. Nevertheless, Mr. Chan conceded that the Hong Kong Trade Marks Registry is not bound to follow the practice of the UK Trade Marks Registry. This practice is after all only for guidance and not binding in the UK, let alone Hong Kong. In particular, as regards conducting Internet searches in examining applications for registration, the Hong Kong Trade Marks Registry has its own practice, which is set out in the Chapter on “Search” of the Trade Marks Registry Work Manual. It provides, under the heading “Searches relating to absolute grounds for refusal”, that:

“We make dictionary, telephone directory and *Internet searches* [my emphasis] in considering our objections to an application for registration on the absolute grounds for refusal.”

As a result, I consider that carrying out Internet searches in the examination of the subject application has been consistent with the Registrar’s own practice.

15. It is appropriate for the examiner to conduct searches on the Internet in order to investigate emerging uses of language. Furthermore, the goods and services applied for are essentially related to telecommunication. This is a fast moving field and represents the sort of area of trade where it is difficult to keep abreast of developing technology and the associated trade terms without Internet research. Consequently, I am of the view that conducting Internet searches for the subject application does not appear to be inconsistent with the UK practice, if it be relevant.

Section 11(1)(c) of the Ordinance

16. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the intended purpose or other characteristics of the goods and services in respect of which registration is sought.
17. Mr. Chan pinpointed that the word “exclusively” means that a mark, to be objectionable under section 11(1)(c), must consist only of descriptive matter. He relied on 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.”

18. Mr. Chan submitted that the subject mark “RINGSONG” was a unique combination of the words “RING” and “SONG” and that it did not convey any meaningful information in relation to the claimed goods and services. Therefore, the subject mark as a whole is not apt to be used as a description of the claimed goods and services.

19. While I have considered the principles set out in paragraph 17, I also take note of the relevant principles laid down 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.”

20. The above principles indicate that for a mark to be caught by section 11(1)(c) of the Ordinance, it is not necessary that the mark is actually in descriptive use at the time of application. It is sufficient to find that the mark could be used to designate the characteristics of the specified goods or services.

21. I do not agree with Mr. Chan that the subject mark is not apt to be used as a description of the claimed goods and services. In respect of the goods applied for, the subject mark directly designates the ring tones, songs or sounds emitted or made by the goods, for example, “voice mail system”, “telephone dialling apparatus by vocal synthesizer”, “answering machine”, “telephones”, “mobile phones” and “digital music (downloadable) provided from the Internet”. When used in relation to “computer programs, software linking digitized video and audio media to a global computer information network”, “computer programs”, “computer software supplied on the Internet”, “electronic and computer apparatus,



instruments and software for communicating with computer networks and the world-wide web”, etc., the subject mark conveys an unequivocal message that those goods facilitate users to access, download or transmit songs from the Internet, computer networks or recordings in order to set them up as ring tones. In the context of the services applied for, the subject mark directly tells consumers that the services facilitate users to search for, access, download or use ring tones, songs or sound of music by telecommunication means. Consequently, in my view, the subject mark could be used to designate the intended purpose and characteristics of the goods and services applied for.

22. I am not persuaded that the subject mark “RINGSONG” is a unique combination of the words “RING” and “SONG”. In *Campina Melkunie BV v Benelux-Merkenbureau*, Case C-265/00, paragraph 41, the European Court of Justice indicated that a mark consisting of a neologism composed of elements descriptive of characteristics of the goods or services was itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the First Council Directive 89/104/EEC, unless there was a perceptible difference between the neologism and the mere sum of its parts.
23. To my mind, the conjoining of “RING” and “SONG” simply produces a sign that is the sum of the two parts in the same way that “ringtone” is the sum of its parts. Nothing fanciful emerges from it when viewed in its entirety nor has its descriptive meaning been removed. Furthermore, as evidenced by the Internet findings of the examiner, the term “RINGSONG” already appears to be in descriptive use in the trade. Accordingly, I consider that the subject mark as a whole represents, in the mind of average consumers, a mere description of the characteristics of the goods and services in question, and not an indication of commercial origin.
24. Mr. Chan argued that there were over one hundred million websites on the Internet, so several isolated examples of website using the term “RINGSONG” as a description would not be sufficient to support the objection against the subject mark. Moreover, as most of the Internet websites quoted by the examiner are overseas websites, they do not necessarily reflect the position of Hong Kong market. It may be the case that the word “RINGSONG” is meaningful in other countries but not meaningful in Hong Kong.
25. As I have explained in paragraphs 19 and 20, to be objectionable under section 11(1)(c) of the Ordinance, it is not necessary for the mark in question to be

actually in descriptive use. The words “*may serve...to designate*” in section 11(1)(c) allow for a degree of foreseeability that the mark may be perceived by the relevant consumers as a new form of descriptive expression (see paragraphs 31 and 32 of “*Cycling IS... Trade Mark Applications*”).

26. The Internet references quoted by the examiner support my assessment that the term “RINGSONG” could be used to designate the intended purpose and characteristics of the goods and services applied for. In addition, Hong Kong is receptive to new technologies from elsewhere, and the goods and services of the subject application are related to telecommunication which could be provided to consumers without national boundaries. Consequently, I consider that the term “RINGSONG”, being a meaningful term in overseas countries (as conceded by Mr. Chan) or a form of description, would be likely to be used by traders in Hong Kong to designate similar characteristics of their goods and services.
27. Furthermore, as quoted by Mr. Chan, it was held 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.”

28. 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 intended purpose and characteristics of the goods and services applied for and is, therefore, excluded from registration by section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

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

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



31. 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.”

32. 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.”

33. 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 goods and services for which the applicant seeks registration, which include telecommunication goods and services. I must also have regard to the perception of the relevant consumers of these goods and services, who in my view are the general public and business users.

34. Mr. Chan asserted that the subject mark was a unique combination and had no meaningful information in relation to telecommunication goods and services. Hence, the vast majority of normal consumers of the applicant’s products and services, who are to be regarded as reasonably well-informed and reasonably observant and circumspect, would regard the products and services identified by the subject mark as originating from one and the same undertaking.

35. In my judgment, when the relevant consumers encounter the term “RINGSONG” used in relation to the goods and services applied for, they will merely perceive it as a description of the ring tones or sounds emitted by the goods, or of the facilities or services that help them access, download or use songs as ring tones, and not an identifier of trade origin. “Ringtone” is a term commonly used to describe the sounds or tones emitted by electronic devices in particular mobile phones. It is also popular for wireless operators to provide services and ancillary facilities for their customers to download songs as ring tones. It seems to me,

therefore that the relevant consumers would see the word “RINGSONG”, on first impression, as a description of a characteristic of the goods and services applied for, i.e. using songs as ringtones, and would not place any trade mark significance on the word.

36. Accordingly, in my view, the relevant consumers’ overall impression on the subject mark will be that it is a descriptive designation, telling them the intended purpose or characteristics of the goods and services applied for, rather than a badge of trade origin identifying the goods and services as originating from a particular undertaking. The mere bringing together of the two words “RING” and “SONG” is not sufficient to bestow distinctive character on the subject mark as a whole.
37. Finally, as the subject mark is equally applicable as a description of similar characteristics of the goods and services provided by other undertakings, it would not enable the relevant consumers to distinguish the applicant’s goods and services from those of other undertakings. 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.
38. For the reasons stated above, I conclude that the subject mark cannot fulfill the essential function of identifying the source of the goods and services applied for, and thus distinguishing the applicant’s goods and services from those of others. Therefore, the subject mark as a whole is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Reference to other registered trade marks on the register

39. Mr. Chan drew my attention to some registered trade marks on the register, such as “INTERACTIVE INTELLIGENCE”, “BODY CONTROL”, “WRIST TECHNOLOGY” and “GAMEBOY”, and submitted that they were no more distinctive than the subject mark.
40. I have considered those registered trade marks but found that they are more distinctive than the subject mark. 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

41. 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
28 February 2006