

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO.: 300343197**

**MARK:** A life-changing media  
B life changing media

**CLASSES: 35, 36, 37, 38, 41 and 45**

**APPLICANT: MASTERWORK GLOBAL LIMITED**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 23 December 2004, Masterwork Global Limited (“the Applicant”) applied to register the series of two marks shown below (collectively referred to as “the subject mark”) in classes 35, 36, 37, 38, 41 and 45 pursuant to the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

A life-changing media  
B life changing media

A full list of the specification is set out in the **Annex A**.

2. At the examination stage, objection was raised under section 11(1)(b) of the Ordinance in respect of all the services applied for. Section 11(1)(b) reads as follows:

“Subject to subsection (2), the following shall not be registered-

- (a) ...
- (b) trade marks which are devoid of any distinctive character;
- (c) ...”

3. On 23 August 2006, the Applicant called for a hearing on the registrability of the subject mark. The hearing took place before me on 11 April 2007 at which Mr Barry Yen of Messrs So Keung Yip & Sin appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

4. The Applicant did not file any evidence of use of the subject mark and I therefore have only the *prima facie* case to consider.

### **Decision**

5. The interpretation of section 3(1)(b) of the UK Trade Marks Act 1994, which is equivalent to section 11(1)(b) of the Ordinance, was considered by Mr. Justice Jacob in *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 at page 306:

“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?”

6. 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.”

7. In assessing the distinctiveness of the subject mark, I must therefore have regard to the applied-for services for which registration is sought, and the perception of the average consumer who is deemed to be reasonably well-informed and reasonably observant and circumspect. On this assessment I must assume notional and fair use of the subject mark in relation to the applied-for services. The question I have to consider is whether the subject mark can serve to indicate that the services offered under it originate from a particular trader, and therefore can distinguish them from those of other traders.
8. The subject mark does not contain any graphic or semantic modification. It comprises the words “life-changing / life changing” and “media”, which are ordinary English words in common use and carry apparent and descriptive meaning. The word “media” can refer to “the main means of mass communication (esp. newspapers and broadcasting) regarded collectively” (Concise Oxford Dictionary of Current English (8<sup>th</sup> Edition)). It is also the plural form of “medium” which has a broad meaning. It can refer to “an intervening substance or agency for transmitting

or producing an effect” or “a means or agency for communicating or diffusing information, news, etc, to the public” (Collins Dictionary of the English Language (2<sup>nd</sup> Edition)). It can also generally refer to “an agency or means of doing something” (The Concise Oxford Dictionary (8<sup>th</sup> Edition)). As a whole the subject mark is likely to be understood as any kind of means or agencies, including the “mass media” or any means or channels for communication or diffusion of news or information, through which something is done for the purpose of bringing changes to life or with the intention to produce such an effect.

9. The subject mark is sought to be registered in respect of a variety of services. Some of these services are particularly related to mass media, such as radio advertising services (Class 35), providing information relating to charitable activities via radio broadcasting (Class 36), radio broadcasting, web casting over a global computer network, transmission of data and of information by radio, television, communications satellite or other communication means, provision and operation of radio, satellite and cable network communications system (Class 38), dissemination of education information by means of radio broadcasting and television broadcasting, production of radio and television programmes and recording studio services, publication of magazines and newspaper (Class 41). When the subject mark “life-changing media” or “life changing media” is used in respect of these applied-for services, consumers are likely to perceive it as merely indicating that these services relating to mass media would have life-changing effects. They are unlikely to perceive the phrase as indicating the trade origin of these services.
  
10. A lot of the applied-for services are related to general communication or dissemination of information. Some examples are: provision of advertising and promotional information through a global computer network (Class 35), computerized information services relating to charitable and fundraising activities (Class 36), telecommunication services (Class 38), providing courses of instruction, educational services and teaching services relating to religious affairs, health and social welfare, dissemination of education information by means of books and compact discs, library services, publication of books, and printed matter (Class 41), information and advisory services relating to religious services (Class 45). When the subject mark “life-changing media” or “life changing media” is used in relation to these services, it merely conveys the message that these means or information would be life-changing. The phrase would not be perceived as indicating the trade origin of these services.

11. As regards the rest of the applied-for services such as retail and wholesale services relating to books, magazines, newspapers, compact disc and clothing (Class 35), charitable fundraising and support services, providing educational sponsorship, financial arrangements to facilitate charitable giving (Class 36), religious services and missionary services (Class 45), when the subject mark is used in relation to these services, it merely conveys the message that these means or services would have life-changing effects. The phrase would not be perceived as indicating the trade origin of these services.
12. As shown above, when the subject mark is used in respect of various applied-for services, consumers are, on first impression, likely to perceive it as a directly descriptive term. Without first being educated that the mark is used and intended to be used as an indicator of trade origin, the relevant consumers' perception of the mark is likely to be origin neutral. Furthermore, as the subject mark is apt to be used by other traders to promote the same or similar services, it would not enable the relevant consumers to distinguish the Applicant's services from those of other undertakings.
13. Mr Yen submits that the subject mark as a whole has a "fanciful and totally arbitrary visual appearance" when applied to the specified services. He argues that even if the individual elements of the subject mark may not be distinctive, the unusual combination of them constitutes an invented mark. Mr Yen also submits that the combination was created by the Applicant and has not been used in the public domain in Hong Kong by third parties to designate the services applied for, and therefore the originality contributes to create a distinctive character of the subject mark.
14. I cannot agree with Mr Yen's above submission as I do not find that the mere conjoining of the words "life-changing / life changing" and "media" creates a fanciful or distinctive combination. When viewed as a whole, the mark is no more than the mere sum of its individual descriptive components. Even if the subject mark was invented by the Applicant and no one else in the trade has used the mark, that does not necessarily mean the mark must be distinctive and capable of identifying trade origin. In fact, as shown in the Internet references provided to the Applicant during the examination stage on 11 March 2005 and 24 May 2006, "life changing media" or "life-changing media" is a term used to promote and describe other traders' services similar to those applied for. Excerpts of the Internet references

showing how the term is used are provided in **Annex B**.

15. Mr Yen submits that the consumers, when seeing the word “media” in the subject mark, are likely to perceive it as referring to “mass media” such as television or radio broadcasting, and since many of the applied-for services are unrelated to mass media, consumers would have to wonder what the subject mark means. Mr Yen argues that the subject mark is at most suggestive because it does not indicate the quality or characteristics of the services or refer directly to the results from which the users would benefit.
16. As explained in paragraph 8 the meaning of “media” is not confined to “mass media” only. It should also be emphasized that the distinctiveness of the subject mark in its entirety is not assessed in a vacuum but in relation to the applied-for services. When “media” is read together with the words “life-changing / life changing” in relation to the applied-for services, the message is clearly descriptive of the life-changing effects of the various applied-for services and therefore consumers are unlikely to perceive the subject mark as an indication of trade origin.
17. Mr Yen submits that a very limited degree of distinctiveness of a mark is sufficient in order to satisfy the requirement of distinctiveness. He submits that the subject mark has attained the minimum degree of distinctiveness as required under the Ordinance. I cannot agree with the above. In my view, the crux of the test to determine whether or not a mark is distinctive is whether the relevant consumers will perceive it first and foremost as a badge of origin. In this connection, I have already found that consumers’ immediate perception of the subject mark in its entirety is likely to be origin-neutral.
18. Mr Yen refers me to a number of registered marks containing the word “media” and submits that some of them, such as “MEDIA FACTORY”, “GENERIC MEDIA” and “NOW MEDIA”, have no stylization or device but were nonetheless accepted for registration. The prior acceptance of other registered marks cannot assist the present application. It has been well established that each case has to be considered on its own facts and merits and not by reference to other marks that were judged registrable on other occasions. 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 and Sons Ltd* [1996] RPC 281 at page 305). Therefore, I am not prepared to accept the subject mark merely because of the

acceptance of the marks referred to by Mr Yen, particularly where the subject mark has been found unregistrable under a valid ground of objection.

19. In summary, I find that the subject mark does not serve to identify the applied-for services as originating from a particular undertaking and thus fails to distinguish them from those of other undertakings. Applying the test of distinctiveness illustrated above, I therefore conclude that the subject mark is devoid of any distinctive character and it is excluded from prima facie acceptance pursuant to section 11(1)(b) of the Ordinance.

### **Conclusion**

20. In this decision, I have considered all the documents filed by the Applicant, Mr. Yen's written and oral submissions and the relevant authorities. For the reasons given above, I find that the subject mark as a whole is devoid of any distinctive character and is therefore precluded from registration under section 11(1)(b) of the Ordinance. The present application is thereupon refused under section 42(4)(b) of the Ordinance.

Patrick Yeung  
for Registrar of Trade Marks  
13 September 2007

## **Annex A**

### Class 35

publication of publicity materials; advertising and promotion services and information services relating thereto; radio advertising services; business information services; dissemination of advertising materials, updating of advertising materials, business appraisals, business consultancy, marketing research, public relations, advertising and promotions, business professional consultancy; commercial and/or administrative (business) representational services; marketing and promotional services (to promote the works of the association to encourage and extend the ideal of service as a basis of worthy enterprise); compilation of advertisements for use as web pages on the Internet; computer data processing; personnel management; provision of sales, business, advertising and promotional information through a global computer network; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site and a wholesale outlet; retail and wholesale services relating to radios, communication apparatus and instruments, computers, computer hardware, computer software, electronic equipment, compact discs, digital video discs, audio cassettes, magnetic storage media, data carriers, cine-films, books, magazines, newspapers, brochures, motion picture films, slides, video and/or audio tapes, films, disks, mini discs, pre-recorded audio or video tapes, compact disc read only memories, digital video disc read only memories, laser discs, printed matter, mouse pads, calendars, key chains, cups, textile materials, clothing, headgear, stationery; consultancy, information, management and advisory services relating to the foregoing; all included in Class 35.

### Class 36

charitable fundraising and support services; philanthropic services (monetary affairs) concerning monetary donations; providing financial sponsorship and educational sponsorship; online charitable fundraising services; providing information relating to philanthropic (monetary affairs), charitable and fundraising activities and events via radio broadcasting and the internet; computerized information services relating to philanthropic (monetary affairs), charitable and fundraising activities; managing and monitoring of charitable funds; distribution and allocation of charitable funds; financial arrangements to facilitate charitable giving; providing of information regarding corporate donations and payroll donations by employees; estate planning; consultancy, information and advisory services relating to the foregoing; all included in Class 36.

### Class 37

building and construction services; construction, renovation, refurbishment, repair, installation and maintenance of radio or television sets, radio receivers, radio transmitters, portable radio communication machines and apparatus, single or multiple channel radio communication machines and apparatus for fixed stations, computers, machinery; consultancy, information and advisory services relating to the foregoing; all included in Class 37.

### Class 38

radio broadcasting; web casting over a global computer network; transmission of data and of information by electronic, computer, cable, radio, radiopaging, telephone, teleprinter, teleletter, electronic mail, fax machine, television, microwave, laser beam, communications satellite or other communications means; computer aided transmission of messages and images; multi-media communication services; videotext services; viewdata services; communication services between computers; electronic communication services; provision of communication facilities for the interchange of data by electronic means; provision and operation of radio, telephone, satellite and of cable network communications systems; delivery of messages by electronic media; electronic mail services; mobile radio communication services; paging services; radio communication services; radio-paging services; telecommunication services; consultancy, information and advisory services relating to the foregoing; all included in Class 38.

### Class 41

providing courses of instruction, educational services and teaching services relating to Christian religion, religious affairs, singing evangelizing, missions, church planting, church and ministry development, physical and mental health, community development, social welfare, management, meditation, self-awareness, God realization, spiritual development and development of the mind, the body and the soul; providing training facilities; arranging and conducting classes, seminars, lectures, interest classes, assemblies, conferences, educational programs conventions, training courses, exhibitions, outdoor recreational activities, sporting and cultural activities and individual instructions; dissemination of education information by means of radio broadcasting, television broadcasting, cine-films, books, magazines, newspapers, instructions, brochures, lectures, drama and public performance, motion picture films, slides, video and/or audio tapes, films, disks, mini discs, pre-recorded audio or video tapes, cassettes, compact discs, compact disc read only memories, digital video discs, digital video disc read only memories, laser discs; lending library services, library services; publication of magazines, newspaper, books, printed matter, texts; mobile library services, production of cine-films, video and/or audio tapes, films, disks, mini discs, pre-recorded audio or video tapes, cassettes, compact discs, compact disc read only memories, digital video discs, digital video disc read only memories, laser discs; production of radio and television programmes, recording studio services; rental of films, disks, mini discs, pre-recorded audio or video tapes, cassettes, compact discs, compact disc read only memories, digital video discs, digital video disc read only memories, laser discs, video tapes, cine-films, audio tapes, books, magazines, newspaper, printed matter, texts; editorial and publication services for books and texts; consultancy, information and advisory services relating to the foregoing; translation services; all included in Class 41.

### Class 45

religious services; ministerial services; missionary services, evangelistic services; administrative and representational services, religious community services, religious ministry and counseling; consultancy, information and advisory services relating to the foregoing; all included in Class 45.

## Annex B

### Family Life Network

Description - Family Life Network is a multi-cultural team of Christian communicators dedicated to creating **life-changing media**. FLN distributes radio/TV programs to more than 900 media outlets worldwide and partners with local churches on every continent in live events.

<http://crosscanadasearch.com/Media/Broadcasting/>

### NET500 Cybermedia Group

(NET500.CG) has been involved in the Web and Internet since it began its morphological change from a 'blip, barely seen on the radar screens of the technology ' in early 1990, to the **life changing media**, communication and commerce tool it has become...

<http://www.net500.com/aboutus.htm>

The long-term benefit of this programme cannot be overestimated. MEM has a history of **life-changing media** production, which takes the Gospel effectively to Arab people through commercial media outlets...

<http://www.mem.org/projects/default.html>

### VIDEO PRODUCTION CORPORATION

AQUARIES MEDIA CORPORATION... Aquaries Media=**life-changing media**! Award winning full services multimedia production from concept to completion. Certified as a small women-owned business...

<http://www.mnfilmandtv.com/guide/PostProduction.pdf>