

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

**APPLICATION NO. : 300720134AB**

**MARK : CATHERINE ZETA-JONES**

**APPLICANT : CARIAD PROPERTIES LIMITED**

**CLASS : 41**

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**STATEMENT OF REASONS FOR DECISION**

*Background*

1. On 13 September 2006, Cariad Properties Limited (“the applicant”) filed an application for the registration of **CATHERINE ZETA-JONES** (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application was in respect of goods and services in Classes 3, 9, 14, 18, 25 and 41. The application was subsequently divided into two, one in respect of the goods in Classes 3, 9, 14, 18 and 25 and the other in respect of the services in Class 41. After having restricted the specification, the application in respect of goods in Classes 3, 9, 14, 18 and 25 has now been accepted for registration. The subject application concerns only the services in Class 41 which are “entertainment services, including personal appearances by an actress; providing entertainment, film information, biographical information and news for entertainment purposes via a website on the internet; fan clubs services”.
2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the ground that the subject mark consists exclusively of a sign which designates the characteristics of the services applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.
3. The applicant requested a hearing on the registrability of the subject mark. The

hearing was held before me on 7 April 2009. Mr. Anthony Tong of Messrs. Robin Bridge & John Liu 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. I therefore have only the *prima facie* case to consider.

#### ***Grounds of refusal under section 11***

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. Only subsection (1) is relevant here and it reads 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.

#### ***Decision***

Section 11(1)(c)

6. The subject mark is the name of an actress. The words forming the name are not represented in any stylized or fanciful manner, but merely appear in the form of plain capital letters. The actress Catherine Zeta-Jones won an Oscar for best supporting actress in 2002 for her appearance in the movie “Chicago”. She also starred in a number of other movies which were shown in Hong Kong and is a person who has made a name in the entertainment business.

7. The services applied for are “entertainment services, including personal appearances by an actress; providing entertainment, film information, biographical information and news for entertainment purposes via a website on the internet; fan clubs services”, all being concerned with entertainment. Entertainment is a part of life for the people in Hong Kong. Television viewing, film watching and attending concerts are things that people of Hong Kong enjoy doing. The relevant consumers of the services applied for are therefore members of the general public.
8. When the subject mark is applied on services like entertainment services, provision of film information and news for entertainment purposes via a website on the internet and fan clubs services, the direct and immediate message conveyed is that such services relate to the actress Catherine Zeta-Jones, that the news are about her or the fan club services are for her fans. The subject mark merely identifies the entertainer and is thus one that consists exclusively of signs that may serve to designate the characteristic of the services in question.
9. Such finding is in line with the decision of Mr. A. J. Pike, the Hearing Officer, in the case of *Linkin Park LLC’s Application* [2005] ETMR 17, a case among the authorities submitted by Mr. Tong for the hearing, although not referred to by him at the hearing. The case is concerned with the application for registration of “LINKIN PARK”, the name of a Californian music band formed in 1996 and which was well known in the United Kingdom. The application faced an objection under section 3(1)(c) of the UK Trade Marks Act 1994 (similar in effect to section 11(1)(c) of the Ordinance) in relation to “printed matter, posters and poster books” in Class 16.
10. The Hearing Officer found that the mark “LINKIN PARK”, when used as the subject matter of posters, etc., would do no more than represent a characteristic of such goods. He then quoted from the Opinion issued by A.G. Jacobs in the case of *OHIM v Zapf Creation AG* Case C-498/01 [2004] ETMR 67 (“the *New Born Baby* case”). In the *New Born Baby* case, an application to register the mark “NEW BORN BABY” in respect of dolls was refused under Article 7(1)(c) of Council Regulation (EC) No. 40/94 which is broadly similar to section 11(1)(c) of the Ordinance. The passage quoted reads as follows –

*“It is an essential characteristic of many toys, and of all those classed as dolls, that they represent something. The characteristics of a toy motorcycle differ from those of a toy giraffe, and are certain to be perceived immediately by potential purchasers as defining the nature of the toy (and as relevant to their purchasing choice). In trade, the terms ‘motorcycle’ and ‘giraffe’ (or ‘racing motorcycle’, ‘baby giraffe’ etc.) are important to both buyer and seller in identifying the class or subclass of toy in question. It would surely not be compatible with Article 7(1)(c) to register ‘Giraffe’ or ‘Motorcycle’ for the relevant class of toy. The situation is the same for a child’s doll representing a new-born baby, a princess, a soldier or any other kind of person.”*

11. Further, in paragraph 18 of the judgment in the **Linkin Park** case, the Hearing Officer had this to say –

*“...Third parties are, of course, entitled to take and exploit picture of celebrities – the copyright in a picture of LINKIN PARK belongs to the creator of it and not necessarily to the group itself. A party wishing to trade in a product which is essentially the embodiment of a work in which it owns the copyright – e.g. a poster – positively needs to use the name of the subject matter in order to conduct such a trade. The name is not therefore merely “capable” of designating a characteristic of the product – it is essential.”*

Similarly, it is essential for people providing entertainment services featuring Catherine Zeta-Jones to designate the services by using her name. The subject mark therefore fall foul of section 11(1)(c) of the Ordinance.

12. Mr. Tong suggested otherwise. He did not agree that the subject mark had any directly descriptive connotations about the characteristics of the services applied for. The case presented by Mr. Tong was premised on the inherent diversity of what “entertainment services” could encompass. Since all sorts of topics, themes and information can be the subject matter of entertainment services and the spectrum of subjects is so wide, Mr. Tong stressed that it would be unreasonable to deny registration of the subject mark simply because one of the thousands of topics for the services might be about the actress Catherine Zeta-Jones. Mr. Tong submitted that if such view was accepted, then nothing could ever be registered for provision of information services or for provision of

entertainment services.

13. I accept that in the case of entertainment services, the subject matter of the services can be any matter under the sun, or even above it or beyond. However, the width of the spectrum of topics that can be covered is not decisive in the assessment of the registrability of a mark. What matters is how the mark would be perceived by the relevant consumers of the goods or services in question. Thus, even though the subject matter of the services applied for may have nothing to do with Catherine Zeta-Jones, the subject mark is still precluded from registration when the direct and immediate message that it conveys to the consumers of the services is that they relate to Catherine Zeta-Jones, whether they are performed by her or they are about her performances or her life in general.
14. I also do not see any force in Mr. Tong's submission that if the above approach is adopted, then nothing can ever be registered for the provision of information services or for provision of entertainment services. There are many types of marks that have nothing to do with a characteristic of entertainment services: examples of these include invented words or combinations of words (whether invented or not) that do not convey any specific meaning and devices that do not depict any specific objects. Not all marks serve to designate the characteristics of entertainment services.
15. Since the subject mark is simply constituted by the name of a famous actress, it relates a message about the contents of the entertainment services. It consists exclusively of signs that may serve to designate a characteristic of the services applied for. The subject mark is therefore precluded from registration under section 11(1)(c) of the Ordinance.

#### Section 11(1)(b)

16. To be registrable as a trade mark, the sign has to serve to distinguish the goods or services of one undertaking from those of other undertakings. The relevant principles in assessing whether a mark has any distinctive character have been discussed in a number of UK cases. In the case of *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281, Jacob J (at page 306) set out the test

as follows –

*“What does devoid of 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 of *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 (at paragraph 23), the test is phrased as follows –

*“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.”*

18. In assessing the distinctiveness of a mark, the question to consider is whether the mark will be perceived as a badge of trade origin. The assessment is to be carried out in respect of the subject mark, with reference to the goods or services of the class for which registration is sought, as well as the consumers of those goods or services, who are reasonably well informed and circumspect.
19. As discussed earlier, the relevant consumers of the services applied for are members of the general public. They are reasonably well-informed and circumspect, but they cannot be expected to exercise more than an average level of care and attention.
20. When the subject mark is applied to the supply of the services under application, the first and foremost impression that the relevant consumers have is the message about the subject matter of the services. The message so transmitted is origin neutral and, without first having been educated, the relevant consumers will not regard the subject mark as a reliable indicator of the commercial origin of the services applied for. The subject mark is therefore devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

21. Mr. Tong took issue with such finding. In support of his submission that the subject mark should be considered sufficient in bestowing a distinctive character to distinguish the services of the applicant from those of other traders, Mr. Tong referred me to the cases of *Elvis Presley Trade Mark* [1999] RPC 567 and *Jane Austen Trade Mark* [2000] RPC 879. Both cases involve opposition to applications for registration of the name of a person in respect of toiletries items in Class 3 – the name of the famous rock and roll singer Elvis Presley in the *Elvis Presley* case and the name of the world famous 19<sup>th</sup> century authoress Jane Austen in the *Jane Austen* case.

22. Mr. Tong specifically drew my attention to the following passage from the judgment of Walker L.J. in the *Elvis Presley* case (at page 585): –

*“In my judgment the judge was right to conclude that the **Elvis** mark has very little inherent distinctiveness. That conclusion was reached by a number of intermediate steps, one of which was the judge’s finding that members of the public purchase Elvis Presley merchandise not because it comes from a particular source, but because it carries the name or image of Elvis Presley. Indeed the judge came close to finding (although he did not in terms find) that for goods of the sort advertised by *Elvisly Yours* (or by *Enterprises in the United States*) the commemoration of the late Elvis Presley is the product, and the article on which his name or image appears (whether a poster, a pennant, a mug or a piece of soap) is little more than a vehicle.”*

23. In the *Jane Austen* case, Mr. Reynolds, the Hearing Officer, upheld the principle stated in the *Elvis Presley* case and concluded that if the name of a well known individual would likely result in a demand for memorabilia or commercial consumers items, then the general public would unlikely see that name as anything other than an indication of the content or character of goods rather than signifying trade origin. He then went on to list the following factors as having a bearing on how any given name of literary or artistic figures would be perceived and whether it would be required for descriptive purposes:

- (i) the nature and extent of the individual’s reputation;
- (ii) whether there are any surrounding reasons why a trade in souvenirs etc

- may have developed, for instance, because of any individual's strong association with an area or a particular style;
- (iii) whether, in the case of contemporary figures, the individual established any trade mark rights during his or her lifetime;
  - (iv) whether any existing trade in souvenirs, memorabilia etc exists or (in the case of someone recently deceased) can be expected to arise;
  - (v) whether descendants, the estate, trustees or other such body have, through use, established any rights in relation to the name of the individual (and, if so, whether to the exclusion of others);
  - (vi) the extent to which the life and works of the individual are kept alive either by general public interest or media coverage etc in such a way as to generate demand for commercial consumer items;
  - (vii) the nature of the goods in respect of which registration is sought.
24. Furthermore, Mr. Tong pointed me to another passage in the *Jane Austen* case where, after giving the example of the name of William Shakespeare as one that would unlikely be an indicator or trade origin for a broad range of souvenir type items, Mr. Reynolds said that – “...*the names of literary figures of somewhat lesser repute or whose memory is less well preserved may be capable of fulfilling the functions of a trade mark*”. It is Mr. Tong's submission that Catherine Zeta-Jones falls within the category of the “lesser repute” whose name may be capable of serving as an indicator of trade origin. According to Mr. Tong, there is hardly any level of demand for memorabilia or commercial consumer items resulting from the notoriety of Catherine Zeta-Jones.
25. Since the present case is not concerned with the sale of items in commemoration of a person and the name of the person that is now used as a mark is still alive, some of the factors stipulated in the *Jane Austen* case, like those about the establishment of trade mark rights during the lifetime of the person or after his or her death, the existence of a souvenir trade and the surrounding reasons for the development of such a trade, are of lesser concern here. The factors that have greater relevance to this application are the nature and extent of the individual's reputation and the nature of the goods in respect of which registration is sought.
26. Unlike the cases of *Elvis Presley* and *Jane Austen*, we are concerned here not with the sale of memorabilia items or commercial consumer goods which have

nothing to do with the individual whose name or image is being used on those goods. In both the two cases, there is no direct link between the individual and the toiletries items applied for. However, had the goods applied for been recordings of music in the *Elvis Presley* case and printed publication in the *Jane Austen* case, I have no doubt there would not be any need for the pronouncement of the principles above quoted at all. The lack of distinctiveness of the mark would have been apparent to all.

27. What we have before us is the use of the name of an individual in the field where she attains her fame. Consumers of entertainment services naturally expect a performance by Catherine Zeta-Jones when they see her name applied to the provision of such services. Similarly, people joining a fan club under the name of Catherine Zeta-Jones expect the club services to be for fans of Catherine Zeta-Jones. The relevant consumers of the services under consideration simply will not regard the subject mark to be an identifier of commercial origin of such services.
28. As regards the extent of notoriety, I agree with Mr. Tong that Catherine Zeta-Jones is not in the same league as Elvis Presley, Jane Austen and William Shakespeare. However, this is not a case of people buying toiletries items as a vehicle for the commemoration of an individual. Entertainment business thrives on reputation, especially with movie stars in the film industry, as it translates into box office appeal. The public as well as private lives of movie stars are reported in various media to address the insatiable needs of their aficionados and to whet the appetite of gossipmongers. Substantial amounts are spent in the promotion of movies and the fame of the cast is often emphasized.
29. Movie goers of Hong Kong are keen followers of foreign films, especially Hollywood motion pictures. Each year, the Annual Academy Awards show of the American Academy of Motion Picture Arts and Sciences is broadcast live in Hong Kong and many award winners, be it films, actors or other members of the production crew are very popular with the viewers of Hong Kong. To the relevant consumers, an actress who has starred in a number of Hollywood movies which had been shown in Hong Kong and who has won an Oscar for best supporting actress is pretty well known to them.

30. That being the case, people seeking entertainment services under the name of Catherine Zeta-Jones engage the services not because they come from a particular source, but because they expect the services to relate to Catherine Zeta-Jones. Without first having been educated of its function as an indicator of trade source, the relevant consumers of the services applied for will merely regard the name Catherine Zeta-Jones as a designation of the performer providing the entertainment or the services relate to her work or other aspects of her career or private life. They will not regard it as a badge of trade origin. The subject mark is therefore precluded from registration by section 11(1)(b) of the Ordinance in respect of the services applied for.

*Other matters*

31. In addition to the arguments mentioned above, Mr. Tong handed over to me a statutory declaration made by himself (“the Tong Declaration”), deposing to the registration of the subject mark in respect of services in Class 41 in various other jurisdictions, including the European Community, the United Kingdom, Argentina, British Virgin Islands, China, France, Germany, Japan, Korea, Mexico, New Zealand, Singapore and the USA. Mr. Tong urged me to follow the decisions of the registries of these other jurisdictions in accepting the registration of the subject mark for the services in question.
32. Mr. Tong was of course well aware of the principle enunciated in the case of *Automotive Network Exchange Trade Mark* [1998] RPC 885. On the persuasive authority of the acceptance for registration of a trade mark by foreign registries, it was said in that case that the bare fact of registration abroad was not sufficient to establish registrability in the United Kingdom and that national trade mark rights were territorially limited and granted independently of each other. In that case, Mr. Geoffrey Hobbs, Q.C., the appointed person, referred to the absence of evidence relating to the circumstances in which the registrations in the other countries were obtained. He also pointed to the possibility that, as a result of linguistic, cultural and social differences, the same mark could be too descriptive to be registrable in one place and yet sufficiently distinctive to be registrable elsewhere.
33. At the hearing, Mr. Tong passed over to me the searches he had conducted to

show that, in respect of the applications for registration in the United Kingdom and the European Communities, in view of the short time span between the filing of the application and the publication of the application in each case, no objections could have been raised against the two applications and that there had not been the submission of any evidence of use in support of the two applications. In particular, Mr. Tong submitted that the decision of the Registry of the United Kingdom in accepting the registration of the subject mark should be followed, since their laws are the same as ours.

34. The fact that a mark has been accepted for registration without calling for evidence of use does not of itself reveals the full reasons for its acceptance. As noted by Mr. Geoffrey Hobbs, Q.C. in the *Automotive Network Exchange Trade Mark* case, linguistic, cultural and social differences can account for the different results in the assessment of the registrability of a mark in different jurisdictions. In the absence of a statement of the reasons for the acceptance of the mark, the factors that are considered relevant and which can account for its acceptance in one place can only be a matter of conjecture on the part of a foreign registry. There are indeed some similarities between the legal systems on trade marks registration of Hong Kong on the one hand and the United Kingdom and the European Communities on the other hand. However, the perception of consumers of a particular mark is more likely than not determined by the linguistic, cultural and social characteristics of each place. There is simply no evidence or other justifiable basis for me to find that the perception of the subject mark by the relevant consumers in Hong Kong will be the same as that in any of the other places where the subject mark has secured registration.
35. Last but not least, Mr. Tong brought to my attention the registration of a few other marks in Hong Kong. One of these is the registration of “CELIN DION” for advertising in Class 35. The others are three marks which are plain representations of the names of persons who are famous in their respective fields, being “JACK NICKLAUS”, “KENNY G” and “SHAWN MICHAELS”. All three marks are registered in Class 41 in respect of services for which those persons are famous. The particulars of the registration of the three marks in Class 41 and materials about the notoriety of the persons involved have been included in the Tong Declaration as well.

36. It is well established by case law that comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration: see *British Sugar Plc v James Robertson & Sons Ltd* , supra at 305. The task I have before me is therefore not the reconciliation of these cases with the present application but the assessment of the registrability of the subject mark purely on the basis of its own merits. The registration of the marks referred to is therefore of no assistance to this application.

### ***Conclusion***

37. I have considered all the documents filed by the applicant together with all the written and oral submissions made in respect of the application. For the reasons stated above, I find that, in respect of the services applied for, the subject mark is, contrary to section 11(1)(b) and (c) of the Ordinance, devoid of any distinctive character and it consists exclusively of signs that may serve, in trade or business, to designate the characteristics of such services. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow  
for Registrar of Trade Marks  
24 June 2009