

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300732104AB
MARK : *JAMES BOND 007[®]*
APPLICANT : DANJAQ, LLC
CLASSES : 9, 16, 28, 38, 41

STATEMENT OF REASONS FOR DECISION

Background

1. On 29 September 2006, Danjaq, LLC (“the Applicant”) filed an application for registration of the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

JAMES BOND 007[®]

2. Registration of the subject mark was sought in respect of various goods and services in Classes 3, 9, 14, 16, 25, 28, 38 and 41. The application was subsequently divided into two, one in respect of the goods in Classes 3, 14 and 25 and the other in respect of the goods and services in Classes 9, 16, 28, 38 and 41. The application in respect of the goods in Classes 3, 14 and 25 has now been accepted for registration. The subject application concerns only the goods and services in Classes 9, 16, 28, 38 and 41 as set out in the **Appendix** of this decision.
3. At the examination stage, objections were raised against the subject application under sections 11(1)(b) and (c) of the Ordinance on the basis that the subject mark is devoid of any distinctive character and it consists exclusively of signs which may serve, in trade or business, to designate the characteristics of the goods and services applied for. Despite submissions made on behalf of the Applicant, the objections were maintained by the Registrar.
4. The Applicant requested a registrability hearing which was postponed once at the Applicant’s request and eventually took place before me on 18 December 2009. At the

hearing, the Applicant was represented by Ms. Poorna Mysoor of Messrs. Vivien Chan & Co. I reserved my decision at the conclusion of the hearing.

5. In support of the subject application, the Applicant had filed the following statutory declarations 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 for the purpose of section 11(2) of the Ordinance :-

- (i) Statutory declaration of Mr. David Pope dated 12 March 2009 (“Pope Declaration”)
- (ii) Statutory declaration of Mr. Michael Moore dated 14 December 2009 (“Moore Declaration”)
- (iii) Statutory declaration of Mr. David Pope dated 17 December 2009 (“Pope Supplemental Declaration”)

(collectively, the “Declarations”)

Preliminary issue

6. As a preliminary issue dealt with in the hearing on 18 December 2009, Ms. Poorna Mysoor made an application for leave to file further evidence, namely the Pope Supplemental Declaration which was made on 17 December 2009 before a notary public in California, United States of America. Ms. Mysoor submitted that the original was under delivery and expected to arrive at Hong Kong within a few days. A scanned copy of the signed Pope Supplemental Declaration was handed to me at the hearing.

7. Having considered the relevant facts and circumstances, leave was granted to the Applicant to file the original of the Pope Supplemental Declaration in the exact form as the copy submitted by the Applicant at the hearing within 14 days from the date of the hearing. On 29 December 2009, the original of the Pope Supplemental Declaration was filed by the Applicant, which was found to be in order.

The Ordinance

8. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 read 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) 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 goods or rendering of services, or other characteristics of goods or services; and
 - (d) ...”

9. Notwithstanding the provisions in the preceding paragraph, section 11(2) of the Ordinance 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 use made of it.”

Decision

10. My decision after the hearing is to allow registration of the subject mark in respect of :-

- (a) (i) “scientific, nautical, surveying, photographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers and peripherals therefor included in this class; electronic games apparatus for use with television receivers or with video monitors; sunglasses, sunglasses frames; spectacle frames; cases for sunglasses and spectacles; encoded telephone cards; telephone ring tones and animations (downloadable); magnetic and encoded credit cards; parts and fittings for all the aforesaid goods” in Class 9;
- (ii) “bookbinding material; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; writing implements; gift wrap; paper party bags; paper party decorations; telephone cards; pens; pencils; credit cards (other than encoded or magnetic); data recorded in paper form from the

Internet or from any other communications network including wireless, cable or satellite” in Class 16;

(iii) “gymnastic and sporting articles not included in other classes; decorations for Christmas trees; paper party favors; paper party hats” in Class 28;

(iv) “telecommunications services; mobile and wireless telephone communication services; Internet portal services; providing access to MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; providing access to digital music web sites on the Internet or from any other communications network including wireless, cable or satellite” in Class 38; and

(v) “education, providing of training; sporting and cultural activities; information, advisory and consultancy services relating to the provision of games by means of a computer based system, a computer network or via the Internet or from any other communications network including wireless, cable or satellite; providing temporary use of non-downloadable computer (game) software for computer games and video games and playing games by means of a computer based system, a computer network or the Internet or from any other communications network including wireless, cable or satellite; information relating to entertainment or education, provided on-line from a computer database or the Internet or from any other communications network including wireless, cable or satellite; ring tones (not downloadable) provided from the Internet or from any other communications network including wireless, cable or satellite; quiz and competition services provided by means of the Internet or on-line from a computer network or database or from any other communications network including wireless, cable or satellite” in Class 41 on a *prima facie* basis; and

(b) “cinematographic films” in Class 9 and “film services, namely the production, distribution and exhibition of motion pictures; production and development of film” in Class 41 on the ground that the subject mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2) of the Ordinance.

11. I maintain the objections raised in respect of the remaining goods and services applied for, namely:-

(a) “cinematographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers,

recording discs; computer software; downloadable software; computer games; floppy disks, CD's; DVD's; CD-ROMS, laser disks, video tapes; pre-recorded audio and video tapes and DVD's; electronic publications; downloadable publications; audio-tapes; video recordings; sound recordings; screensavers and screen backgrounds; computer games software supplied on-line from databases or provided through a global computer network or from any other communications network including wireless, cable or satellite; computer software downloaded from the Internet or from any other communications network including wireless, cable or satellite; data recorded electronically from the Internet or from any other communications network including wireless, cable or satellite; digital music (downloadable) from the Internet or from any other communications network including wireless, cable or satellite; digital music (downloadable) provided from MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; magnetic or optical data media" in Class 9;

- (b) "paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; books, brochures, magazines, comic books, periodicals; calendars; posters; postcards; greeting cards; trading cards; diaries; day planners; albums; stickers; decals; bookmarks" in Class 16;
- (c) "games, toys, puzzles and playthings; playing cards; toy action figures; toy vehicles; toy weapons; board games; toy telephones; toy model kits; electronic games machines [other than those adapted for use with television receivers only]; coin and/or token operated games and amusement apparatus" in Class 28;
- (d) "broadcasting of radio and television programmes; transmission of audio, cable television, digital television, network television, radio, and video programmes via a global computer network; computer aided transmission of information, messages, text, sound, images, data and radio, television programmes and films; the foregoing services provided on-line by means of computer databases or by means of web pages on the Internet" in Class 38; and
- (e) "entertainment; rental of films; electronic publishing; television services namely the production, distribution and exhibition of television programmes; radio services, namely the production, distribution and exhibition of radio programmes; rental of sound and video recordings; organization, production and presentation of live performances and exhibitions; provision of cinema and theatre facilities; publication of books and periodicals; publication of

electronic books and journals on-line; providing electronic games (not downloadable) via the Internet; provision of games by means of a computer based system, a computer network or via the Internet or from any other communications network including wireless, cable or satellite; Internet games (non-downloadable); digital music (not downloadable) provided from MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; digital music (not downloadable) provided from the Internet or from any other communications network including wireless, cable or satellite; production and development of television and radio programmes; production and development of video; providing videos and films via a wireless network for use with mobile telephones” in Class 41.

(collectively, the “Objected Goods and Services”)

12. The reasons for refusing registration of the subject mark in respect of the Objected Goods and Services are set out below.

Inherent registrability

Section 11(1)(b) of the Ordinance

13. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character. The test for distinctiveness was laid down by Mr. Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 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?”

14. The approach of assessing distinctiveness was further discussed by Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2, at page 26:

“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. It follows that the 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 or service 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 or services for which registration is sought and the perception of the relevant consumers who are presumed to be reasonably well-informed and circumspect. On this assessment, I must assume fair and normal use of the subject mark in relation to the provision of the goods and services applied for.
16. In the present application, the Objected Goods and Services cover a wide range of goods and services in Classes 9, 16, 28, 38 and 41. The goods in Class 9 consist mainly of apparatus and instruments for recording and storage of sound and images in various forms, such as CDs, DVDs, video tapes, electronic publications etc. The goods in Class 16 cover written materials and printed matter in which textual and graphical information can be recorded and displayed. The goods in Class 28 include various games, toys and playthings. Most of these items could be conveniently purchased by members of the general public in Hong Kong. The services in Classes 38 and 41 comprise a broad range of services in mainly communication and entertainment fields. Consumers for these services would range from individuals to large corporations. In relation to the Objected Goods and Services as a whole, I consider that the relevant consumers include ordinary members of the general public in Hong Kong as well as people in business who are seeking or interested in those goods and services. They are likely to come across the subject mark in advertisements, promotional materials or websites for promoting the goods and services in question or on the goods themselves and their packaging.
17. The subject mark consists of the words “JAMES BOND”, the number “007” and a gun-like device. “JAMES BOND” is the name of a famous fictional character who is widely known to bear, for his identity as a secret agent, the code number “007”. According to *The Oxford English Dictionary (Second Edition)*, “JAMES BOND” is “the name of the hero of a series of novels by the British writer Ian Fleming (1908-64), used allusively (freq. *attrib.* or as *adj.*) of adventurous, sophisticated men resembling the hero, or of situations similar to those in the novels”. From the website information (<http://www.who2.com/jamesbond.html>) referred to by the examiner in the Registry’s letter of 22 March 2007, the code number “007” indicates that James Bond has a “licence to kill” in line of his duty. The name “JAMES BOND” and the combination “JAMES BOND 007” are so long established and well-known that they have passed into the language. A gun-like device is positioned at the edge of the numeral “7” in the code number “007” and is of a relatively insignificant size comparing with the mark as a whole. The gun-like device is likely to be perceived by the consumers as part of or parasitic to the code number “007”, as such, if it ever captures the attention of the consumers at all, it would just have the

effect of reinforcing the imagery of the fictional character conveyed by the code number “007” as well as the words “JAMES BOND” in that the fictional character, taking the identity of a secret agent, is well-known for his likes and use of exotic and deadly weapons (such as a gun) for defeating enemies and accomplishing missions. The gun-like device therefore does not confer distinctive character on the mark which, as a whole, conveys the message that all this has to do with the well-known fictional character “JAMES BOND 007”.

18. When the subject mark is used in relation to the Objected Goods and Services, it conveys a direct and immediate message that these goods and services portray or relate to the fictional character “JAMES BOND 007”, or are products or merchandise centred on the character. As such, the relevant consumers are likely to perceive the subject mark, on first impression, as an indication that the content of the Objected Goods and Services is about that famous fictional character, as opposed to denoting the commercial origin of the goods and services in question. Without first being so educated, a reasonably well-informed and circumspect consumer who is looking for or interested in the Objected Goods and Services would not immediately or automatically recognise the trade mark significance of the subject mark. Hence, the subject mark is devoid of any distinctive character under section 11(1)(b) of the Ordinance in relation to the Objected Goods and Services.
19. Ms. Mysoor argues at the hearing that the objection of the Registry is misplaced. She submits that the Applicant’s predecessors acquired its rights to the mark “JAMES BOND 007” from the creator of the fictitious character, Mr. Ian Fleming. In other words, the character James Bond and all his attributes were the original creation of the Applicant through its predecessors. By drawing an analogy with the character “Spider Man” created by Mr. Stan Lee of Marvel Comics, Ms. Mysoor avers that the very reason why fictitious characters are created is because they are meant to be commercially exploited on goods and services that pertain to them. In her view, if an applicant is denied the trademark rights to its own intellectual creation, the entire purpose of trademark law will be defeated. Further, she submits that the fact that the general public perceives an association of the subject mark with the character James Bond shows the efforts that the Applicant has spent in gaining popularity of the name and character James Bond, which is certainly worth protecting as a trademark.
20. I do not concur with Ms. Mysoor’s view. Characters of fiction may be trade marks, but this would depend on the ability of the public to identify them as indicators of trade origin, and not simply to see them as indicating the content of the goods or services in question. In this respect, I think there is a distinction between a fictional character which is newly invented by the author and a character which has become so famous and popular that passed into the language.

21. In *TARZAN Trade Mark* [1970] F.S.R. 245 (“the *TARZAN* case”), an American company which was exclusively entitled to produce films, records and merchandise centred on the character Tarzan, applied to register the word *TARZAN* in respect of films and magnetic tape recordings in Class 9 and games, toys, playthings, gymnastics and sporting articles in Class 28. The Registrar refused to register the mark on the ground (*inter alia*) that *TARZAN* had a direct reference to the character and quality of goods and it was not distinctive. The applicant appealed to the Court of Appeal. In dismissing the appeal, Salmon LJ said at pages 247-248 of the judgment that: -

“Undoubtedly, many years before November 1965, an author called Edgar Rice Burroughs did invent the word and wrote many stories about a fictitious character whom he called *TARZAN*. The question is however whether in November 1965, *TARZAN* could be correctly described as an invented word.

The case against the applicant was that, although Mr. Burroughs had originally invented the word, by November 1965, it had passed into the language and had indeed become a household word.

We have been referred to Webster's International Dictionary. In the second edition, 'Tarzan' is described as a character of a series of stories by Edgar Rice Burroughs. He is described as “a white man of prodigious strength and chivalrous instincts reared by African apes.” In the third and latest edition he is described as “a hero of adventure stories of Edgar Rice Burroughs, a strong agile person of heroic proportions and bearing”.

In my view, the learned judge's conclusion that the word 'Tarzan' had passed into the language and was well-known by every adult, and indeed by most children, is quite incapable of attack. Mr. Burrell has argued that the word had not passed into the language. Having regard to the various definitions in Webster's Dictionary, and to its common usage, of which I think we are entitled to take judicial notice, I cannot myself find that there is any real foundation for the argument which Mr. Burrell has pressed upon us on this question.”

22. Salmon LJ went on to say, at page 250 of the judgment, that: -

“In the present case, there is nothing at all in the word *TARZAN* which would suggest to the public or to the trade that a film or magnetic tape recording had anything to do with the applicant or with anyone else. The word *TARZAN* when used in connection with a film suggests—and suggests only—that the film has

something to do with the well-known fictional person, Tarzan, a man of great strength and agility.”

23. As discussed in paragraph 17 above, the name “JAMES BOND” and “JAMES BOND 007” are so long established and well-known that they have passed into the language as at the date of the subject application, as evidenced by its entry in *The Oxford English Dictionary (Second Edition)* which was published on 1989. Even according to paragraph 11 of the Pope Declaration filed by the Applicant itself, the deponent averred that “the results of a 2001 commissioned survey... indicated that 99 percent of U.S. consumers and nearly 100 percent of consumers surveyed in the U.K., Germany, and France had seen or had heard of James Bond.” Although the survey was not carried out in Hong Kong, I have little doubt that a significant proportion of Hong Kong consumers must have seen or at least heard of the name of “JAMES BOND 007”, given the long history of the character and the popularity of foreign movies in Hong Kong. In light of the fame and notoriety of “JAMES BOND” or “JAMES BOND 007” *as a character*, at the date of the application, the average consumer who was reasonably well-informed and circumspect would not have expected that all goods and services bearing the name and code number of James Bond to be commercialised under the control of a single undertaking. Instead, they would perceive the subject mark, on first impression, as denoting the subject matter of the goods and services in question.
24. I must also assess the distinctiveness of the subject mark with reference to the Objected Goods and Services and the perception of the relevant consumers of those goods and services. When the subject mark is used in relation to recording discs, video tapes, audio-tapes, computer software and the like in Class 9, the relevant consumers are likely to perceive it as an indication that the literary, musical or artistic content of those goods (e.g. movies and songs) is about the fictional character “JAMES BOND 007”. When the subject mark is applied to books, magazines, posters and photographs in Class 16, the relevant consumers will likely expect those printed materials to contain the image or information about that character. In respect of toy vehicles and toy weapons in Class 28, the subject mark will likely be understood by the relevant consumers as describing those toys and playthings resemble those appearing in the James Bond movies. When the subject mark is used in respect of the services relating to broadcasting and entertainment in Classes 38 and 41, the relevant consumers would merely recognise it as a designation that those services are related to the production, development and broadcasting of James Bond films and related programmes. Thus, in the context of the Objected Goods and Services, the subject mark fails to perform the essential function of a trade mark in guaranteeing the identity of the origin by enabling the relevant consumers to distinguish the goods and services offered by the Applicant from those provided by others.

25. Based on the above reasons, I find that the subject mark is devoid of any distinctive character in respect of the Objected Goods and Services. The subject mark is therefore precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

26. Having found that the subject mark is precluded from registration in respect of the Objected Goods and Services by section 11(1)(b), it is not necessary for me to consider the objection under section 11(1)(c) of the Ordinance.

Acquired distinctiveness

27. Although I have found that the subject mark has no inherent distinctive character and not registrable under section 11(1)(b) in respect of the Objected Goods and Services, if the subject mark has in fact acquired a distinctive character as a result of the use made of it in respect of those goods and services 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 in fact acquired a distinctive character in respect of the Objected Goods and Services with reference to the evidence of use filed under the Declarations.

28. To assess the acquired distinctiveness of a mark, the ECJ 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.”

29. Although the above case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC¹, 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. Further to the principle above, the competent authority must make an overall assessment of the evidence in determining the question.

30. The relevant date in determining whether the subject mark has in fact acquired a distinctive character is 29 September 2006, the filing date of the subject application. No fixed rule can be laid down as to the minimum period of use necessary, although


¹ That Directive has now been replaced by Directive EEC/95/2008, but the relevant provisions remain essentially the same.


the Registrar looks for a reasonable period of use, usually about five years prior to the application date. Extensive use over a shorter period may well be sufficient, although use for less than two years prior to the date of application would very unlikely be regarded as sufficient.

31. The overall picture presented by the Declarations can be summarized as follows – the subject mark was used by the Applicant and its predecessors since 1962 in connection with the production and promotion of 22 films featuring James Bond throughout the world including Hong Kong; the Applicant also used and licensed the use of the subject mark in connection with a large variety of merchandise, products and services over the years.
32. As indicated in paragraph 10(b) above, I was satisfied from the evidence filed that the subject mark has in fact acquired a distinctive character in respect of “cinematographic films” in Class 9 and “film services, namely the production, distribution and exhibition of motion pictures; production and development of film” in Class 41 as a result of the use made of it under section 11(2) of the Ordinance. I will now explain why acquired distinctiveness has not been established in respect of the Objected Goods and Services.
33. In the first place, no information has been given to show the scale or extent of use of the subject mark in respect of each category of the Objected Goods and Services. There is no breakdown of the sales turnover in respect of the each individual item of the Objected Goods and Services. Although the revenue figures generated by all James Bond films in Hong Kong were provided in Exhibit 3 of the Pope Declaration, the figures were only divided into three broad categories of “theatrical”, “home video” and “television”, from which I cannot ascertain the extent of sales or turnovers attributable to different types of goods and services involved. For example, I cannot tell what proportion of the revenues under “television” is derived from the broadcasting of television programmes in Class 38 and how much of them are from the production, distribution and exhibition of television programmes in Class 41. There is no mention of the quantity of CDs and audio-tapes sold under the subject mark. This deficiency was not remedied by the supplemental figures provided in Exhibits MGM2 – MGM5 of the Moore Declaration, which only shed light on the total revenue generated by all James Bond films from inception to 2005 without a year-to-year breakdown. As such, I cannot form a view on the real extent of use that has been made of the subject mark in Hong Kong in respect of each type of the Objected Goods and Services.
34. Despite the Applicant’s claim that substantial revenues were generated from the sales of home video in paragraph 9 of the Pope Declaration, not even a single invoice has been produced to substantiate the sales recorded. The reason for not

supplying copies of real invoices has not been given in any of the Declarations. The data contained in Exhibit 3 of the Pope Declaration is generated by computer, unsupported by any copy of receipt or invoice. It is doubtful whether all the revenues result from the sales of goods or provision of services bearing the subject mark, but not other marks.

35. For the advertising figures provided in Exhibit 4 of the Pope Declaration (as supplemented by the table in page 5 of the Moore Declaration), no information was available on the amount of advertising expenditure incurred for the promotion of the subject mark in respect of each category of the Objected Goods and Services. It appears to me that all the advertising materials of the Applicant were used for the promotion of James Bond films rather than the subject mark. Further, there is no breakdown of the amount of promotional expenditure incurred by the Applicant on a year-to-year basis. In the absence of such crucial information, I cannot ascertain how much advertising effort has been spent by the Applicant on each year to educate the relevant consumers of the trade mark significance of the subject mark in respect of all the different groups of the Objected Goods and Services.


36. I note that the subject mark did not appear in the vast majority of the materials filed. Instead, other marks of the Applicant were used. For instance, the mark used in the USB mini drive in Exhibit 6 and USB key in Exhibit 7 of the Pope Declaration is  (which was registered by the Applicant under Trade Mark No.300061965). The mark used by the Applicant's licensee in computer games (as

shown in Exhibit 13 of the Pope Declaration) is , whereas the mark used in the DVD cover (in Exhibit 2 of the Pope Declaration) is



In some cases, a mark consisting of similar elements of the



subject mark is used (such as  in Exhibit MGM-1 of the Moore Declaration), but the overall impression created by such mark is very different from that of the subject mark due to their different configurations, and such use is not regarded as a relevant use for the purpose of this application. These examples are by no means exhaustive. Given that so many marks have been used by the Applicant in relation to the Objected Goods and Services, it is doubtful whether, or to what extent, the alleged use and promotion is made in respect of the subject mark, as opposed to other marks of the Applicant.

37. Even in the few instances where the elements of “JAMES BOND”, “007” and the gun-like device are all present, I fail to see that there is any use of the subject mark as a trade mark for the purpose of identification of the Objected Goods and Services as originating from a given undertaking. For example, the small row of text “IAN FLEMING’S JAMES BOND *007[™]*” as depicted in the upper edge of the movie poster and the DVD cover of Exhibit 2 of the Pope Declaration is considered a use of the text in a descriptive manner and does not constitute use of the subject mark for the purpose of section 11(2) of the Ordinance. Similarly, in Exhibit 16 of the Pope Declaration, the Applicant adduced some advertisements, reviews and commentary about James Bond movies which were published in newspapers and magazines and claimed that the subject mark has acquired a distinctive character on the goods in Class 16. Apparently, the mark appearing in those articles and advertisements was used to promote the films featuring the character of “JAMES BOND 007”. It did not serve to identify that the newspapers, magazines and printed materials were produced or manufactured by a particular undertaking. In other words, the subject mark was not being relied upon on its own as a badge of trade origin in respect of those goods in Class 16. I borrow support from *British Sugar Plc v James Robertson & Sons Ltd (supra)*, where Jacob J. said, at page 286: -

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader – is taken by the public as an indication of trade origin...” (at p.286)

“There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark... It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader...” (at p.302)

38. I reckon from the ECJ’s judgment of *Societe des Produits Nestlé SA v Mars UK Ltd.* [2006] F.S.R. 2 (Case C-353/03) that the distinctive character of a trade mark may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark. However, in considering whether the subject mark has acquired a distinctive character as a result of use made of it, the critical consideration is whether the subject mark will independently be relied on by customers as a badge of trade origin which identifies the goods or services as originating from a single undertaking. On the evidence before me, I am not satisfied

that the subject mark will on its own be relied upon as a badge of trade origin in respect of the Objected Goods and Services.

39. According to paragraph 10 of the Pope Declaration, the Applicant has used and licensed the use of the subject mark in connection with various goods and services in Classes 9, 16, 28, 38 and 41. Copies of some licence agreements made by the Applicant and its licensees in relation to those goods and services were attached in the Pope Declaration.
40. Upon review, I find that the licence agreements are of little assistance in establishing that the subject mark has in fact acquired a distinctive character through use in Hong Kong. As the trade marks licensed are described literally in the agreements, I do not know whether the subject mark is covered. No sales figures generated by those licence agreements have been produced. Even with those few agreements which are accompanied by corresponding sales data, the volume of sales are not substantial. In any event, as the licence agreements merely give the licensees the right to use the Applicant's marks in respect of certain goods and services, I do not consider that those agreements illustrate how the consumers are educated about the use of the subject mark as a badge of trade origin in relation to the Objected Goods and Services.
41. On the whole, I am not satisfied that the evidence filed is sufficient to show that the subject mark has come to be identified by a significant proportion of the relevant consumers as an indication of trade origin distinguishing the Objected Goods and Services of the Applicant from those of others for the purpose of section 11(2) of the Ordinance. It follows that the objections raised under sections 11(1)(b) and 11(1)(c) of the Ordinance against the subject application cannot be overcome pursuant to section 11(2).

Other matter

42. In paragraph 6 of the Pope Declaration and paragraph 13 of the Pope Supplemental Declaration, reference was made to the registration of the subject mark as well as other Applicant's marks in other places, including Australia, Benelux, Japan, the United Kingdom and the United States. I note that some of those applications were filed more than 20 years ago, at which time the character "JAMES BOND 007" may not have attained its fame and reputation as a household name. In any event, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As I have found that the subject mark is precluded from registration under the Ordinance, and the reasons behind those acceptances are not

known to me, the registrations of the subject mark in overseas jurisdictions do not serve to overcome the objections raised under sections 11(1)(b) and (c) as stated above.

Conclusion

43. I have carefully considered all of the submissions, both written and oral, made by and on behalf of the Applicant. For the reasons given above, I consider that the subject mark is precluded from registration by sections 11(1)(b) and 11(1)(c) of the Ordinance in relation to the Objected Goods and Services. The subject application insofar as it is in respect of the Objected Goods and Services is accordingly refused under section 42(4)(b) of the Ordinance.
44. As I find that the registration of the subject mark can be accepted in respect of the goods and services set out in paragraph 10 above, the application for registration in respect of such goods and services can proceed to publication provided that the Applicant files, on or before 19 July 2010, a Form T5A to restrict the specification by deleting the Objected Goods and Services and a Form T3 to divide the amended application into two separate applications as follows: -
- (1) an application in respect of the goods and services set out in paragraph 10(a) of this decision, which can be accepted for registration on a *prima facie* basis; and
 - (2) an application in respect of the goods and services set out in paragraph 10(b) of this decision, which can be accepted on the ground that the subject mark has in fact acquired a distinctive character as a result of the use made of it under section 11(2) of the Ordinance.

If the Applicant fails to do so on or before 19 July 2010, the subject application in respect of those goods and services is deemed to be abandoned.

Ryan Ng
for Registrar of Trade Marks
17 June 2010

Appendix

Specification of the applied-for goods and services

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, 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; computer software; downloadable software; computer games; floppy disks, CD's; DVD's; CD-ROMS, laser disks, video tapes; pre-recorded audio and video tapes and DVD's; electronic publications; downloadable publications; audio-tapes; video recordings; sound recordings; screensavers and screen backgrounds; computers and peripherals therefor included in this class; electronic games apparatus for use with television receivers or with video monitors; computer games software supplied on-line from databases or provided through a global computer network or from any other communications network including wireless, cable or satellite; computer software downloaded from the Internet or from any other communications network including wireless, cable or satellite; data recorded electronically from the Internet or from any other communications network including wireless, cable or satellite; digital music (downloadable) from the Internet or from any other communications network including wireless, cable or satellite; digital music (downloadable) provided from MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; magnetic or optical data media; cinematographic films; sunglasses, sunglasses frames, spectacle frames; cases for sunglasses and spectacles; encoded telephone cards; telephone ring tones and animations (downloadable); magnetic and encoded credit cards; parts and fittings for all the aforesaid goods.

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; writing implements; books, brochures, magazines, comic books, periodicals; calendars; posters;

postcards; greeting cards; trading cards; diaries; day planners; albums; stickers; decals; bookmarks; gift wrap; paper party bags; paper party decorations; telephone cards; pens; pencils; credit cards (other than encoded or magnetic); data recorded in paper form from the Internet or from any other communications network including wireless, cable or satellite.

Class 28

Games, toys, puzzles and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; playing cards; toy action figures; toy vehicles; toy weapons; board games; toy telephones; toy model kits; electronic games machines [other than those adapted for use with television receivers only; coin and/or token operated games and amusement apparatus; paper party favors; paper party hats.

Class 38

Telecommunications services; broadcasting of radio and television programmes; transmission of audio, cable television, digital television, network television, radio, and video programmes via a global computer network; computer aided transmission of information, messages, text, sound, images, data and radio, television programmes and films; the foregoing services provided on-line by means of computer databases or by means of web pages on the Internet; mobile and wireless telephone communication services; Internet portal services; providing access to MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; providing access to digital music web sites on the Internet or from any other communications network including wireless, cable or satellite.

Class 41

Education, providing of training; entertainment; sporting and cultural activities; film services, namely the production, distribution and exhibition of motion pictures; rental of films; electronic publishing; television services namely the production, distribution and exhibition of television programmes; radio services, namely the production, distribution and exhibition of radio programmes; rental of sound and video recordings; organization, production and presentation of live performances and exhibitions; provision of cinema and theatre facilities; publication of books and periodicals; publication of electronic books and journals on-line; providing electronic games (not downloadable) via the Internet; provision of games by means of a computer based system, a computer network or via the Internet or from any other communications network including wireless, cable or satellite; information, advisory and consultancy services relating to the provision of games by means of a computer based system, a computer network or via the Internet or from any other communications network including wireless, cable or satellite; providing temporary use of

non-downloadable computer (game) software for computer games and video games and playing games by means of a computer based system, a computer network or the Internet or from any other communications network including wireless, cable or satellite; Internet games (non-downloadable); information relating to entertainment or education, provided on-line from a computer database or the Internet or from any other communications network including wireless, cable or satellite; digital music (not downloadable) provided from MP3 or MP4 web sites on the Internet or from any other communications network including wireless, cable or satellite; digital music (not downloadable) provided from the Internet or from any other communications network including wireless, cable or satellite; ring tones (not downloadable) provided from the Internet or from any other communications network including wireless, cable or satellite; production and development of television and radio programmes; production and development of film and video; quiz and competition services provided by means of the Internet or on-line from a computer network or database or from any other communications network including wireless, cable or satellite; providing videos and films via a wireless network for use with mobile telephones.