

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300959923
MARK : Songsurfer
APPLICANT : Songsurfer Corporation
CLASSES : 35 and 41

STATEMENT OF REASONS FOR DECISION

Background

1. On 21 September 2007, Songsurfer Corporation (“the Applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:

Songsurfer

(“the subject mark”)

2. Registration of the subject mark is sought in respect of the following services in classes 35 and 41 (collectively, “the applied for services”):-

Class 35

Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the Internet.

Class 41

Provision of information for or relating to education, entertainment, cultural or recreational purposes, and entertainment services provided on-line from a computer database or the Internet.

3. At the examination stage, objections were raised under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark is devoid of any distinctive character and consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the services applied for.
4. The Applicant called for a hearing on the registrability of the subject mark which took place before me on 29 May 2009. Ms. Sandra Gibbons of Marks & Clerk appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.
5. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

Decision

6. The absolute grounds for refusal of an application for registration are contained 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 services, or other characteristics of goods or services; and
- (d) ...”

Section 11(1)(c) of the Ordinance

7. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the kind, intended purpose, or other characteristics of the goods and services in respect of which registration is sought. The public interest underlying section 11(1)(c) of the Ordinance is to ensure that descriptive signs or indications relating to the characteristics of goods and services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

8. The Applicant has referred me to the following principles as set out in *OHIM v WM Wrigley JR Company* ("the *DOUBLEMINT*" case) [2004] R.P.C. 18 and *Koninklijke KPN Nederland NV the Benelux-Merkenbureau* (Case C-363/99) [2004] ETMR 57 (the "*POSTKANTOOR*" case), which are not in dispute:-
 - (i) "29 Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of

such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

(the “*DOUBLEMINT*” case at paras. 29-32)

- (ii) “57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art.3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.”

“102. It is also irrelevant whether the characteristics of the goods or

services which may be the subject of the description are commercially essential or merely ancillary. The wording of Art.3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially”

(the "*POSTKANTOOR*" case at paras. 57 and 102)

9. In light of the legal principles above, to be precluded from registration under section 11(1)(c) of the Ordinance, a mark does not need to be in actual use at the time of the application for registration in a way that is descriptive of the goods or services applied for. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. It is sufficient if the mark could be used for the purpose of designating any characteristic of the goods or services, including the kind and intended purpose of the goods or services.
10. The subject mark is a combination of two ordinary English words “Song” and “surfer”. According to Merriam-Webster English Dictionary (11th Edition), the word “surf” could mean “to scan the offerings of (as television or the Internet) for something of interest”. According to Longman Dictionary of Contemporary English, “surfer” in the context of Net/Internet/Web means “someone who looks quickly through information on the Internet to find information that interests them”.

11. When the subject mark is used in relation to the applied for services, namely, providing a searchable online advertising guide on the Internet, and providing online information and entertainment services from a computer database or Internet, the subject mark “Songsurfer” as a whole conveys the immediate message that the applied for services allow customers to scan offerings of and to look for songs on the Internet. It conveys a direct and immediate message as to the kind and intended purpose of the applied for services. Furthermore, although the space between the words “song” and “surfer” is omitted, the subject mark consisting of those two words combined together does not create any impression which is any different from the words “song surfer”. Thus, the subject mark consists exclusively of a sign which may serve to designate the kind and intended purpose of the applied for services.

12. Ms Gibbons argued that the Registry scanned too broadly for hidden meanings. She submitted that the subject mark “Songsurfer” is a newly coined word which is unique; that it is not in actual use because of its uniqueness, and is not something that other traders would immediately think of; that it is not a common phrase, but is a very clever play on the phrase “surfing the Internet”; that there is no such thing as a “song surfer” and that the subject mark is merely suggestive.

13. In the first place, the word “may” in section 11(1)(c) of the Ordinance indicates that for a mark to be debarred from registration under section 11(1)(c), it is not essential for the mark to be actually in descriptive use at the time of the application for registration. For that section to apply, it is sufficient if the mark can be used for such a purpose. As explained earlier, the subject mark directly describes the kind and intended purpose of the applied for services, i.e. they allow users to scan offerings of and to look for songs on the Internet. The descriptive meaning of the subject mark is clear and direct,

rather than suggestive. Given that the subject mark consists exclusively of a sign which may serve to designate the characteristics of the applied-for services offered, it is debarred from registration under section 11(1)(c) of the Ordinance.

14. Ms. Gibbons also drew my attention to the *Re NAKED* case¹, and submitted that the Registry had cast its distinctiveness net too broadly. The Applicant submitted that the nexus between the words “song surfer” and the Applicant’s services is too broad, that the applied for services are not a “song surfer” nor could they be described as a “songsurfer”.
15. I do not agree with Ms. Gibbon’s submissions. As explained in paragraph 11 above, when the subject mark is used in relation to the applied for services, the subject mark as a whole conveys a direct and immediate message that the applied for services allow customers to scan offerings of and to look for songs on the Internet. The relationship between the subject mark and the applied for services is direct and specific, so as to enable the relevant public to immediately perceive, without further thought, the kind and intended purpose of the applied for services. As the subject matter consists of nothing more than a sign which may serve to designate the kind and intended purpose of the applied for services, it is precluded from registration under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

16. Section 11(1)(b) of the Ordinance operates as a separate and independent ground of objection from that of section 11(1)(c) of the Ordinance. Although I have found that the mark is precluded from registration under section 11(1)(c)

¹ [2009] 2 HKLRD 96.

and it is unnecessary for me to consider the other grounds for refusal, for the sake of completeness, I shall consider the registrability of the mark under section 11(1)(b) of the Ordinance.

17. Section 11(1)(b) precludes registration of trade marks which are devoid of any distinctive character. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60).
18. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Jacob J. stated:-

“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?”

19. Later in *Nestle SA's Trade Mark Application ("Have a Break")* [2004] F.S.R. 2 at 26, Sir Andrew Morritt remarked on the approach in assessing distinctiveness:-

“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.”

20. In view of the above legal principles, the distinctiveness of the subject mark must be assessed by reference to the services for which the Applicant seeks registration, and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant. To determine whether the subject mark has any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the mark, assuming no use, serves to identify the Applicant's applied for services as originating from a particular undertaking, and thus distinguishing them from those of the other undertakings.
21. In relation to the applied for services, the relevant consumers are members of the general public in Hong Kong who are looking for those services. Normal and fair use of the subject mark includes applying it in advertising materials such as leaflets and on websites to promote the applied for services.
22. As demonstrated above, the subject mark conveys a descriptive meaning as to the characteristics of the applied for services i.e. they allow users to scan offerings of and to look for songs on the Internet. The subject mark is apt to describe similar characteristics of the applied for services provided by other undertakings. As such, I consider that when it is used in respect of the applied for services, the relevant consumer would immediately perceive it, on first impression, as an indication that the services have those characteristics or function, rather than that they are services of a particular trader. I am not satisfied that without first educating the public that the subject mark is a trade mark, the consumers would perceive the subject mark as a badge of origin and rely on it to distinguish the Applicant's applied for services from those of other traders. Therefore, the mark is also considered to be devoid of any distinctive character under section 11(1)(b).

23. For the reasons stated above, I find that the subject mark is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Foreign registrations

24. The Applicant pointed out that the subject mark “Songsurfer” (Community Trade Mark No. 5975503) has been accepted for registration by the Office for Harmonization in the Internal Market (“OHIM”). The Applicant also argued that the Registry is very keen to quote the principles and tests set out by the European Court of Justice in the authorities referred to above, but then applies a different standard when assessing the distinctiveness of a mark. The Applicant essentially queries how the Hong Kong Trade Marks Registry can claim to apply the same tests as OHIM and yet come up with a different answer when applying those tests, as in the present case.
25. In *Telewest Communication Plc’s Trade Mark Application* [2003] R.P.C. 26, it is stated that:

“23 In para. 39 of its judgment in the COMPANYLINE case (above)² the ECJ held that nothing in the Community Trade Mark Regulation required the Community Trade Marks Office to come to the same conclusions as those arrived at by national authorities in similar circumstances. Directive 89/104 of December 21, 1988 similarly appears to permit the national authorities in the Member States to conclude that the outcome of an application for registration in the Community Trade Marks Office is not necessarily determinative of a parallel application for registration under the harmonised law of trade marks at the national level”.

² *DKV Deutsche Krankenversicherung AG v OHIM (COMPANYLINE)* (Case C-104/00 P) [2003] E.T.M.R. 20.

26. Similarly, it is stated in *Kerly's Law of Trade Marks and Trade Names* (14th Edition) at para. 8-150 that:

“Even if a national trade mark office has held a mark to be sufficiently distinctive to warrant registration, the Boards of Appeal have stated that the same finding does not necessarily have to be reached by the examiner "who must in each case make his own assessment as to the existence of absolute grounds of refusal." [Case R-34/1998-3 LASTING PERFORMANCE, July 27, 1998, para.17.] The Boards of Appeal have also pointed out that the CTM system runs in parallel with national systems and is not subordinate or ancillary to them, and that, despite harmonisation, one cannot expect that every trade mark office will invariably take the same view.”

27. Accordingly, even for the Community Trade Mark Office (OHIM) and the European national trade mark offices which apply laws implementing the same EC Directive, one cannot expect that these offices would invariably take the same view about the registrability of a particular mark. Likewise, one cannot expect that the Hong Kong Trade Marks Registry would invariably take the same view as OHIM in any particular case. Like the examiner referred to in the quotation from *Kerly's* at paragraph 26 above, I must in each case make my own assessment as to the existence or otherwise of absolute grounds of refusal. Since there are valid grounds for refusal in light of the reasons for objection stated above under the Ordinance, the subject mark should not be accepted for registration.

Conclusion

28. I have considered all the documents filed and the submissions made by the Applicant in relation to this application. For the reasons stated above, I find

that the subject mark is precluded from registration under sections 11(1)(c) and 11(1)(b) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Original signed

Connie FU

for Registrar of Trade Marks

25 June 2009