

TRADE MARKS ORDINANCE (CAP. 559)
APPLICATION NO.: 301007784

iD

MARK:

**APPLICANT: KABUSHIKI KAISHA NTT DoCoMo
(NTT DoCoMo, Inc.)**

CLASS: 36

STATEMENT OF REASONS FOR DECISION

Background

1. On 5 December 2007, KABUSHIKI KAISHA NTT DoCoMo (NTT DoCoMo, Inc.) (“applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“Ordinance”), to register the following mark (“subject mark”):

iD

2. Registration of the subject mark is sought in respect of the services in class 36 as set out in the Annex (“specification”).
3. At the examination stage, objections were raised against the application under sections 11(1)(b) and 11(1)(c) of the Ordinance on the grounds that the subject mark which consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied-for services is devoid of any distinctive character.
4. Pursuant to the applicant’s request for a hearing on the registrability of the subject mark, the hearing took place before me on 5 February 2010 at which the applicant was represented by Ms. Poorna Mysoor of Messrs. Vivien Chan & Co. (“agent”). Prior to the hearing, the agent submitted a written submission on 3 February 2010.
5. No evidence of use of the subject mark has been put before me. I therefore

have only the *prima facie* case to consider. I reserved my decision at the end of the hearing.

The Ordinance

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;
 - (d) ...”

Decision

7. In the Registrar’s opinion of 21 February 2008 and 21 November 2008, the examiner pointed out that the letters “ID” is an acronym that stands for “identity” and there is a kind of insurance called “identity insurance” that provides identity protection. The examiner also stated “id insurance” is usually associated with identity theft insurance as fortified by internet references which show “ID insurance” and “ID theft insurance”. As such, the examiner considered that the subject mark is descriptive of the applied-for services under section 11(1)(c) of the Ordinance, in particular “insurance services; insurance services relating to the theft of credit cards, insurance services relating to fraudulent or unauthorized use of cards used in financial transactions” and is also devoid of any distinctive character under section 11(1)(b) of the Ordinance.
8. On 13 February 2009, the applicant filed Form T5A requesting to amend the specification by:
- (a) deleting “Insurance services; insurance services relating to the theft of credit cards; insurance services relating to fraudulent or unauthorized use of cards used in financial transactions; insurance services relating

to purchase protection, price protection and extended warranty for goods purchased using credit cards; travel insurance services; insurance services relating to assistance for persons who get into difficulties while travelling, while away from home, while away from their permanent residence” (“objectionable services”); and

(b) adding “excluding insurances services” at the end of the specification.

9. By a letter of 25 May 2009, the Registrar informed the applicant to further restrict the specification, apart from deleting the objectionable services, by:

(a) deleting “payer authentication services; verification of financial information; data encryption and decryption of financial information; providing information of credit card statements; information management system for tracing and reporting expenses; transaction authorization; cheque verification services; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; financial information services relating to stolen credit cards; providing credit consultation and inquiry services; membership information relating to services included in this class as specified above, provided via the Internet, databases or other electronic means” (“excluded services”); and

(b) adding “none relating to identification of users” at the end of the specification.

10. In a letter of 24 July 2009, the Registrar explained that the excluded services as set out in paragraph 9(a) was considered to be relating to protection of user identity and preventive measures against identity theft or remedial measures relating to identity theft cases; and the inclusion of an exclusion clause as mentioned in paragraph 9(b) was to remove any reference that the applied-for services would make to identity or identification of users.

11. Having carefully considered all the relevant facts of the application, I take the view that the subject mark is not objectionable for registration under the Ordinance in respect of the applied-for services, with the *exception* of the objectionable services, of which the applicant has confirmed and agreed to delete at the hearing, and the “payer authentication services” as mentioned below. I do not consider the exclusion clause stated in either paragraph 8(b) or paragraph 9(b) is necessary to qualify the remaining services. Subject to compliance of the requirements set forth in paragraph 35 below, the subject

application insofar as it is in respect of the remaining services of the specification may proceed to registration.

12. I now turn to give my reasons for refusing the subject application insofar as it relates to “payer authentication services”.

Section 11(1)(c) of the Ordinance

13. Section 11(1)(c) of the Ordinance (“section 11(1)(c)”) excludes from registration of 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.
14. Section 11(1)(c) is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (“Regulation No. 40/94”). In *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) [2004] R.P.C. 18 (the “*DOUBLEMINT*” case), the European Court of Justice (“ECJ”) discussed the approach to Article 7(1)(c) of Regulation No. 40/94 and stated the relevant principles as follows:

“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.”

15. The legal principles demonstrate that, for the purpose of section 11(1)(c), it is sufficient if the mark could be used for the purpose of designating a characteristic of the goods or services in question, including the kind and intended purpose of the goods or services. It is not a requirement under section 11(1)(c) that the mark is the typical way of describing the goods or services. A mark is therefore precluded from registration if at least one of its possible meanings designates a characteristic of the goods or services in question.
16. The subject mark is composed solely of two English letters or characters “iD”, with “i” in lower case and “D” in upper case, which are presented in a slightly crooked manner. There is no other element in the subject mark.
17. Ms. Mysoor refers me to *Wrigley v. OHIM* [2001] E.T.M.R. 58, which was confirmed in *West (T/A Eastenders) v. Fuller Smith & Turner PLC* [2003] FSR 44 at 829, paragraph 27, setting forth the following principles:

“(i) Sections [11](1)(b), (c) and (d) are not designed to exclude from registration marks which merely possess an indirect descriptive connotation: the words ‘devoid of any’ in sub-section (b) and ‘exclusively’ in (c) and (d) are to be given effect to;
(ii) the fact that some mental activity is necessary in order to discern a reference to the quality of or a characteristic of the goods may assist in its registrability;
(iii) uncertainty as to the precise nature of the reference to the quality or character of the goods will also assist;
(iv) marks which can only refer directly to the quality or character of the goods (BITTER for beer would be an example) must be refused registration. This is because such a mark does not ‘differ from the usual way of designating the goods or their characteristics’ and because it may ‘serve in normal usage from a consumer’s point of view to designate either directly or by reference to one of their essential

characteristics' the relevant goods.'".

18. Ms. Mysoor considers the subject mark has a remote relationship with the excluded services. She claims that even though the excluded services as set out in paragraph 9(a) may have a distant and long chain of correlation to "identity", the subject mark by no means directly designates the excluded services. In support of her contention, Ms. Mysoor draws my attention to the nature of each of the excluded services as illustrated in the agent's written submission.
19. I have considered the cited cases and the above passage quoted by Ms. Mysoor but I do not find them to be of much assistance. As pointed out by the examiner in paragraph 7 above, the two letters "ID" is an acronym of the noun "identity" (www.acronymfinder.com). According to the *Collins English Dictionary Millennium Edition*, "identity" means "the state of having unique identifying characteristics held by no other person or thing" or "the individual characteristics by which a person or thing is recognised". The use of lower case for the letter "i" and upper case for the letter "D" does not alter the perception of the subject mark as a shortened form for "identity". Notwithstanding the slight stylization, the presentation of the letters is so simple that the subject mark is clearly seen and read as "iD" without any mental effort at all. In my view, the crooked typeface or the way in which the letters are presented did nothing to make the mark as a whole more distinctive than if it were in plain letters. As the overall impression produced by the subject mark is "iD", the subject mark as a whole informs the consumers that the services are about the identification or verification of certain individuals.
20. In order to thwart identity fraud or theft, banks and merchants are taking continuous measures to bolster the security of their network transactions and internet banking. User authentication or verification service is essentially a security procedure to check or confirm the identity of a customer or user, instances include authenticating a credit card holder's identity that he is the actual person using the card during online processing before authorizing a purchase or electronic transaction real-time.
21. In my view, when used in relation to payer authentication services, the subject mark "iD" conveys an obvious and immediate message that these services involve identification or would enable the identity of the payer or user to be authenticated, verified, checked or established or that they are suitable for that

purpose. The subject mark simply designates the kind or intended purpose of the payer authentication services, namely they are related to or provided for the purpose of identification or verification of the user's identity. In fact, as Ms. Mysoor stated in paragraph 11 of her written submission, in relation to payer authentication services, the identity of the payer is one of the aspects that has to be checked or established. Ms. Mysoor's submission fortified my view that the subject mark designates the kind or intended purpose of the payer authentication services.

22. Ms. Mysoor asserts that the identity of an individual is present in or at the core of all banking and financial services for all sorts of reasons including prevention of fraud and emphasises that the establishment of a customer's identity is required before one can proceed with receiving any banking services. Ms. Mysoor argues that it is inexplicable to see why the examiner is prepared not to regard "iD", in the sense of identification or identity, as describing the characteristics of certain services in the specification, such as "banking, payment, debit, cash disbursement and stored value deposit access services", whilst on the other hand considers that "iD" is objectionable to the excluded services as set out in paragraph 9(a), e.g. "providing information of credit card statements". She submits that the consumer will not regard the subject mark as a description of any aspect of the banking services and that there is no direct designation of the services applied for.
23. I have considered Ms. Mysoor's submissions carefully. Given the meaning denoted by the mark as examined in paragraph 19, the subject mark merely indicates that the payer authentication services enabled the identity of the user to be checked or that such services offered could be provided in relation to identification or verification of the identity of the user. Indeed, as stated in *DOUBLEMINT*, supra, it is sufficient that the subject mark could be used to designate a characteristic of the payer authentication services.
24. On the other hand, as stated in paragraph 11, after exclusion of the objectionable services and the payer authentication services, I do not find that the subject mark is descriptive of the remaining services of the specification, which cover and include general banking, financial and credit card services and so on, and is therefore not objectionable under section 11(1)(c).
25. In light of the above, I find that the subject mark consists exclusively of a sign that may serve to designate the characteristics of the payer authentication

services. The subject mark is precluded from registration under section 11(1)(c) in respect of payer authentication services.

Section 11(1)(b) of the Ordinance

26. Section 11(1)(b) of the Ordinance (“section 11(1)(b)”), operating as a ground of objection separate and independent from that under section 11(1)(c), precludes from registration of signs which are devoid of any distinctive character. The public interest underlying section 11(1)(b) 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* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraphs 60-61).

27. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* (HCMP 554/2009), the Hon Sakhrani J cited with approval the following cases at paragraphs 17-18:

“17. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 Jacob J as he then was) said at page 306:

“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?”

18. In *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2 Sir Andrew Morritt VC (as he then was) said at paragraph 23:

“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. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking.....”

28. It follows that, according to section 11(1)(b), the distinctive character of a mark is assessed, assuming no use, by reference to the goods and services for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, circumspect and observant.
29. The nature of the payer authentication services is intended for the prevention of identity theft or reducing the risk of fraud. Whilst the general public, which comprises of people making payment by credit cards particularly via the internet, is the targeted persons where his or her identity is checked or verified, banks and merchants who implement means or mechanisms to authenticate or verify the identity of the payer or user to increase payment security, especially where online payment is allowed, may also be users of the payer authentication services.
30. Ms. Mysoor contends that the subject mark has a stylized font which is quite unique to the subject mark and is by no means an ordinary typeface. She considers such unique font style is one of the distinctive features of the subject mark and hence the subject mark is inherently distinctive.
31. As I have already stated in paragraph 19 above, the subject mark consists of nothing to endow it with any distinctiveness, nor the use of slightly crooked characters alter this finding. The relevant consumers would readily perceive and comprehend the letters “iD” as the abbreviation of “identity”. In view of the direct message connotes by the subject mark in relation to payer authentication services, on first and foremost impression, the relevant consumers would likely perceive the mark “iD” as a mere descriptive indication that these services enabling or enhancing identification or verification of the identity of the user or promoting such fact as opposed to a trade badge indicating the commercial origin from which these services originate. In other words, the perception of the subject mark that would trigger in the mind of the average consumer of the payer authentication services is likely to be origin neutral rather than origin specific (i.e. carry connotations of trade origin) (“*CYCLING IS...*” *Trade Mark Applications* [2002] R.P.C. 37 at paragraphs 66-69).
32. The subject mark can equally be applicable for use by any other service providers to promote and refer to services of a similar sort. It fails to assist the consumers to identify the payer authentication services as originating from a

particular undertaking. I do not consider that the relevant consumers would rely on the subject mark alone as an indication of trade origin of the payer authentication services unless and until the relevant consumers have been educated on its trade mark significance.

33. On the basis of the above, the subject mark therefore fails to perform the essential function of a trade mark in guaranteeing the identity of the origin of the payer authentication services by enabling the relevant consumers, without the possibility of confusion, to distinguish the payer authentication services from those of other undertakings. I conclude that the subject mark is devoid of any distinctive character and is debarred from registration under section 11(1)(b) in relation to payer authentication services .

Conclusion

34. In this decision, I have carefully considered all the documents filed by the applicant and all the written and oral submissions made in relation to this application. For the reasons stated above, I find that the subject mark in respect of the objectionable services and the payer authentication services is precluded from registration under sections 11(1)(b) and 11(1)(c) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance in respect of the objectionable services and the payer authentication services.
35. As I have decided in paragraph 11 above, the subject application in respect of the services acceptable for registration can be proceeded to publication provided that the applicant files, on or before **30 August 2010**, a Form T5A to restrict the specification to those services. If the applicant fails to do so on or before **30 August 2010**, it shall be deemed to have abandoned the subject application.

Vivien LUK
for Registrar of Trade Marks
30 July 2010

Class 36

Insurance services; insurance services relating to the theft of credit cards; insurance services relating to fraudulent or unauthorized use of cards used in financial transactions; insurance services relating to purchase protection, price protection and extended warranty for goods purchased using credit cards; financial affairs; monetary affairs; financial services; banking and debit services; providing debit card and stored value prepaid card services; banking, payment, debit, cash disbursement and stored value deposit access services; bill payment services; agencies for collecting gas and electric power utility charges, telephone charges and public utility charges, and providing information relating thereto; debit card, pre-paid card and stored value card services; processing of financial transactions both on-line via a computer database or via telecommunications and at point of sale; processing services for financial transactions by card holders via automatic teller machines; card and cash replacement services; loss of income protection services; provision of emergency money, including cash and travelers' cheques, and/or replacement travel tickets; the provision of balance details, deposits and withdrawals of money to card holders via automatic teller machines; settlement and authorization services; travel insurance services; insurance services relating to assistance for persons who get into difficulties while travelling, while away from home, while away from their permanent residence; guaranteeing payment of medical expenses for travelers; payer authentication services; verification of financial information; data encryption and decryption of financial information; maintenance of financial records; providing information of credit card statements; information management system for tracing and reporting expenses; electronic funds transfer and currency exchange services; foreign currency exchange services; dissemination of financial information via the Internet and other computer networks; remote payment services; stored value electronic purse services; providing electronic funds and currency transfer services; electronic payments services, cash disbursement services, and transaction authorization and settlement services; provision of debit services by means of radio frequency identification devices (transponders); provision of debit services by means of communication and telecommunication devices; cheque verification services; the provision of financial services for the support of retail services provided through mobile telecommunications means, including payment services through wireless devices; the provision of financial services for the support of retail services provided on-line, through networks or other electronic means using electronically digitized information; value exchange services, namely, the secure exchange of value, including electronic cash, over computer networks accessible by means of smartcards; bill payment services provided through a website; on-line banking; financial services provided over the telephone and by means of a global computer network or the Internet; provision of financial services by means of a global computer network or the Internet; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; credit card protection and registry services; financial information services relating to stolen credit cards; credit guarantees or monetary liability guarantees on use of credit cards by their holders; providing credit consultation and inquiry services; user incentive schemes relating to the use of credit cards, charge

cards, cash cards, debit cards, payment cards, financial cards and purchase cards; arranging discounts in relation to restaurant and hotel services, cinemas, theatres, sporting events and other leisure activities, as part of a membership scheme or programme; issuing of tokens of value in relation to or as part of a membership scheme or programme; repair guarantee services; discounts for travel; arranging discounts for service and retail outlets; arranging discounts in connection with the provision of services and goods by others; introduction services to financial advisors and insurance brokers; pension services; pension fund administration services; charitable fundraising; financial sponsorship; financial analysis and consultation, namely, providing a wide range of information and analysis to financial institutions by electronic means in connection with credit cards, debit cards and other payment cards, marketing data, cardholder spending, fraud, risk management, terminated merchants and reporting of chargebacks on credit cards; rental, hire and leasing of equipment for processing financial cards and data relating thereto; rental of card-readers, card-writers and payment processing machines and equipment used for credit cards or debit cards; membership information relating to services included in this class as specified above, provided via the Internet, databases or other electronic means.