

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 302113938

MARK : 

APPLICANT : TCT MOBILE INTERNATIONAL LIMITED

CLASSES : 9, 38 & 42

STATEMENT OF REASONS FOR DECISION

BACKGROUND

1. On 15 December 2011 (“the application date”) TCT Mobile International Limited (“the Applicant”) filed an application for registration of the mark below (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) -



(“the subject mark”)

2. The priority date claimed by the Applicant in respect of such application was 16 August 2011. Registration of the subject mark is sought to cover various goods and services in Classes 9, 38 and 42 (“the applied for goods and services”).¹ The Applicant claims the colour blue (Pantone 299c) as an element of the subject mark.

3. At the examination stage, the Registrar of Trade Marks (“the Registrar”) raised objections 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 that it consists exclusively of a sign which may serve to designate the characteristics of the applied for goods and services. Objection was also raised under section 12(3) of the Ordinance on the grounds that the subject mark was considered to be similar to an earlier registered trade mark and the applied for goods and services were similar to those of the earlier mark such that use of the subject mark in relation to the

¹ See paragraph 5 below and Annex 1 hereto.

applied for goods and services was likely to cause confusion on the part of the public.

4. The subject application was amended several times in order to overcome the Registrar's objections. By letter dated 7 April 2014, the Registrar accepted the amendments proposed in the letter of 27 December 2013 from the Applicant's agent Liu, Shen & Associates ("the agent") and waived the objection under section 12(3). The section 11 objections were maintained despite the submissions and evidence of use filed by the agent. The agent requested a registrability hearing. One was fixed for 11 August 2014.

5. Late afternoon on 5 August 2014, the Trade Marks Registry ("the registry") received from the agent, by facsimile, a letter enclosing a skeleton argument and a draft statutory declaration with certain exhibit cover sheets. Later that evening, another letter enclosing a skeleton argument marked "REVISED" ("the skeleton argument") came, also by facsimile, together with the same draft statutory declaration and exhibit cover sheets and a Trade Mark Form T5A, the latter seeking to further amend the subject application. Set out in Annex 1 hereto are the specification of the subject application respectively as at 7 April 2014 (see preceding paragraph) and that with amendments proposed in the agent's letter of 5 August 2014.

6. On 6 August 2014, the agent verbally informed the registry that the draft statutory declaration with exhibit covers was intended to be additional evidence in support of the subject application but such additional evidence in its notarized form would not be available probably until the day of the hearing of 11 August 2014.

7. Having perused the draft statutory declaration and the exhibit covers, the content of which appeared not to be entirely straightforward and given the Applicant's last minute application to amend the application and that the purported additional evidence remained unsworn, the Registrar considered the matter not ready to proceed to hearing as scheduled. On 7 August 2014, the agent was notified in writing that the hearing originally fixed for 11 August 2014 was adjourned to a date to be fixed.

8. On 7 August 2014, the registry received the Applicant's sworn additional evidence. By letter dated 18 September 2014, the registry informed the agent that since colour was claimed as an element of the subject mark, parts of the exhibits by way of additional evidence presented in black and white might not assist the

Registrar's full consideration of the subject application. The agent was asked to follow up on the matter should it consider necessary.

9. On 10 October 2014, the agent filed freshly sworn additional evidence, with all the relevant exhibits in colour form. Evidence adduced in support of the subject application is as follows -

- (a) a statutory declaration of VIVIAN LAU WING FU ("Ms Lau") with 10 exhibits marked "Exhibit 1" to "Exhibit 10" declared on 4 June 2013 ("VL's SD"); and
- (b) a statutory declaration of QIONG ZHANG ("Ms Zhang") with 21 exhibits marked "Exhibit XL-0(1)" to "Exhibit XL-12" declared on 9 October 2014 ("QZ's SD").

10. The hearing eventually took place on 26 November 2014 at which Dr Sunny H.M. Yang of the agent ("Dr Yang") appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

THE ORDINANCE

11. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance, the relevant parts of which 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)"*

(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 the use made of it."

DECISION

A. Inherent distinctiveness

12. At the hearing, Dr Yang for the Applicant did not address me on any of the provisions in section 11 of the Ordinance. She indicated that she had no oral submissions to make but was ready to assist me with any queries I might have regarding the subject application.

Section 11(c) of the Ordinance

13. Section 11(1)(c) of the Ordinance precludes registration of 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 in respect of which registration is sought.

14. In *OHIM v Wm Wrigley Jr Company* [2004] E.T.M.R. 9 (the “*DOUBLEMINT*” case), the European Court of Justice (“ECJ”) discussed the proper approach to the application of Article 7(1)(c) of Regulation No. 40/94 of 20 December 1993 on the Community Trade Mark (the provisions of which are broadly similar to section 11(1)(c) of the Ordinance) 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.*” [own emphasis]

15. Given the established legal principles, for a mark to be refused registration under section 11(1)(c) of the Ordinance, it need not inform the consumers what the relevant goods or services it is intended to cover, nor does it have to be the normal way of describing the goods or services concerned. It is sufficient if the mark *could be* used to designate the characteristics of the goods and services, including the intended purposes of the goods and services. A mark should thus be refused registration if at least one of its possible meanings designates a characteristic of the goods and services concerned.

16. Although the subject mark appears to be a single word mark, the single word can be easily perceived to be formed by conjoining two common English words “one” and “touch” without hyphen or space in between. All eight letters making up the mark are presented in the lower case. They are in mere plain font of the same size and in colour blue of the same tone and effect throughout. The edges of all eight letters are smooth and round. There are no additional elements in the subject mark.

17. When considering a mark for registration, one has to approach it from the perspective of the relevant consumers of the goods and services in question. The applied for goods and services cover a wide range of telecommunications apparatus; mobile telephones; mobile telephone charges; computers; maintenance of telecommunication and communication software and technical support services in the field of information technology and telecommunications etc. Such goods and services are directed at members of the general public in Hong Kong who are interested in acquiring them.

18. The Applicant submits in the skeleton argument that the applied for goods and services are rarely sold to the general consumers but to professionals who sell mobile telephones, USB modems and tablet computers etc in specialized shops. The

Applicant's consumers are also the distributors of the applied for goods and services.²

19. At the hearing, Dr Yang reiterated that the Applicant's consumers are usually distributors. Having examined the Applicant's own evidence on the nature, means and extent of the promotion activities carried out in respect of certain products of the applied for goods and services, Dr Yang conceded that the relevant consumers are indeed members of the general public in Hong Kong. Given the extensive use nowadays of goods and services related to information technology and telecommunications by the public at large in Hong Kong, I regard the degree of attention of the relevant consumers when choosing such goods and services to be average.

20. At the examination stage, it was pointed out to the Applicant that when the subject mark is used in respect of the applied for goods and services, it merely indicates that the goods are easy to operate through the touch of one button or screen, and that the services are supporting services for such equipment or they are easily accessible via a touch of the equipment. The subject mark was thus considered to consist exclusively of a sign which designates a characteristic of the applied for goods and services. Furthermore, as such a mark can be equally applied to similar goods and services of other undertakings, consumers are unlikely to take it as a badge of origin for identifying the particular trade source of the applied for goods and services. The subject mark is, therefore, devoid of any distinctive character.

21. In the skeleton argument, the agent simply puts up a bare denial of the subject mark being descriptive and lacking in distinctive character. It is argued that it would obviously require a leap of imagination on the part of the relevant consumer in linking the subject mark with the kind of goods and services applied for and that the mark is not able to identify immediately and precisely the goods and services it intends to cover.

22. To illustrate the perceived descriptiveness of the subject mark, I drew Dr Yang's attention to three advertisements extracted from a "clipping report" of August 2011 produced by an OAT Limited in respect of the promotion in the period between June and August 2011 in newspapers/magazines of a mobile telephone of the Applicant ("**Alcatel OT-990**"), appearing in "**Exhibit XL-2(1)**" to QZ's SD,³ a plain reading of which suggests that the product in question was -

² The Applicant's letter to the Registrar dated 5 August 2014, page 7, last paragraph.

³ Reproduced in Annex 2 hereto.

- (a) meant to carry down the concept of “One Touch”;
- (b) designed with simplicity and style (“以簡潔和型格為設計原則”);
- (c) equipped with wide-ranging and necessary technology and services (“配備多元而必備的科技與服務”); and
- (d) capable of being used and operated by merely one finger (“讓用戶的操控盡在一指之間” / “讓大家的手機世界盡在一指之間”).

23. It is also noted that two of the three cited advertisements bear the pun “...「一觸」即發” where “「一觸」” has the meaning of “one touch” in English.⁴ The advertisements are by themselves an illustration of using the subject mark descriptively. Although they provide no conclusion on the issue of the subject mark being descriptive, the message the Applicant intended to convey by the subject mark in the advertisements is self-evident.

24. In response to my observations about the three advertisements, Dr Yang submitted that it is commonplace in advertising that product descriptions are by and large untrue or exaggerated. She said that the phrase “*used and operated by merely one finger*” (“一指之間”) used in the advertisements was only a gimmick in promoting the product in question and did not in any way suggest the ease of use of the product or the ease of access to services through a touch of it. She urged me to disregard such descriptions of the Applicant’s product by the subject mark.

25. Commonsense dictates that, advertising is a description or presentation of a product or idea etc, in order to induce individuals to buy, support or approve of it. Dr Yang’s submission that the descriptions of the Applicant’s product by the subject mark in the cited advertisements were untrue or exaggerated and should therefore be disregarded is, in my view, beside the point. The advertisements at least show that the subject mark constitutes such a phrase that could be used by traders to describe or designate the kind, quality or a characteristic of the goods and services in question. Hence an objection under section 11(1)(c) is solidly grounded.

26. Save as aforesaid, nothing in the skeleton argument or Dr Yang’s submissions at the hearing touched on the overall impression created by the subject mark in respect of the applied for goods and services for the purpose of overcoming the Registrar’s objections under 11(1)(c) of the Ordinance.

27. In the light of the above, I am not persuaded that it would require a leap of

⁴ <https://translate.google.com.hk/>

imagination on the relevant consumers' part to link the subject mark with a kind and/or characteristic of the applied for goods and services. The subject mark will be perceived as a mere description of the kind and/or a characteristic of such goods and services.

28. As the subject mark may serve to designate a characteristic of the applied for goods and services, it fails to meet the requirements of registration pursuant to section 11(1)(c) of the Ordinance.

29. Having concluded that the subject mark is precluded from registration by section 11(1)(c), it is unnecessary for me to consider other grounds of refusal under the Ordinance. For completeness, I will nonetheless also consider the subject application under section 11(1)(b) of the Ordinance, an objection which operates as a ground for refusal separate and independent from that under section 11(1)(c).

Section 11(1)(b) of the Ordinance

30. The essential function of a trade mark is to distinguish the goods and/or services of one undertaking from those of other undertakings, without any possibility of confusion. Section 11(1)(b) precludes from registration signs which are devoid of any distinctive character. At issue is whether the mark, when used in relation to the goods and services for which registration is sought, serves to indicate the trade origin of the goods and services.

31. The relevant principles in assessing distinctiveness have been referred to in the case of *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* [2010] 1 HKLRD 541 -

“17. *In British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 Jacob J (as he then was) said at paragraph 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?” [own emphasis]

18. *In Nestle SA's Trade Mark Application (Have A Break)* [2004] F.S.R. 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.....”

32. Given these principles, one has to assess the distinctiveness of a mark by reference to the goods and/or services in question from the perspective of the relevant consumers who are presumed to be reasonably well-informed, circumspect and observant. The question to ask is whether the mark, *assuming no use*, serves to identify the applied for goods and services as originating from a particular undertaking and thus distinguishing the same from those of other undertakings. One has to consider whether the perceptions and recollections that the mark would trigger in the mind of the relevant consumers of such goods and/or services would be origin specific or origin neutral. A mark is not inherently distinctive if the relevant consumers do not perceive it as a badge of trade origin.

33. I have in paragraphs 17 and 19 above found that the relevant consumers in the subject application are members of the general public in Hong Kong and that their degree of attention when choosing the applied for goods and services to be average.

34. Applying the legal principles as discussed above, without first being educated that the subject mark is intended and used as a guarantee of trade origin, the relevant consumers are, as discussed in paragraphs 20 to 25 above, likely to regard the subject mark as a mere designation that the goods and services in question are easy to use and operate or gain access to. In the context of the applied for goods and services, the relevant consumers would not in my assessment perceive the subject mark as a badge of trade origin.

35. For the reasons stated above, I find the subject mark devoid of any distinctive character and is precluded from registration pursuant to section 11(1)(b) of the Ordinance.

B. Acquired distinctiveness

36. Although I have found the subject mark descriptive and lacking in inherent distinctive character hence not registrable according to sections 11(1)(c) and 11(1)(b) of the Ordinance, given section 11(2), if the subject mark has in fact acquired a distinctive character as a result of the use made of it, the subject application should not

be refused. I would next consider the Applicant's evidence of use made of the subject mark in the light of the established legal principles.

The law

37. On acquired distinctiveness of a mark, the ECJ stated in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Another* [2000] Ch. 523 that -

- “51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.
- 52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied...
- 54. ... 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.”

38. The *Windsurfing Chiemsee* case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC (now replaced by Directive 2008/95/EEC), which is broadly similar to section 11(2) of the Ordinance. The principle stated in the case is thus applicable to the subject application. According to the above principle, the competent authority must make an overall assessment of the evidence in determining the issue on acquired distinctiveness. The crucial question to ask is whether the relevant consumers in Hong Kong have been educated to recognize the subject mark as a badge of trade origin of the applied for goods and services. It follows that if I consider that a significant proportion of the relevant class of consumers identifies those goods and services as originating from a particular undertaking because of the use made of the subject mark, the objections raised against the subject mark under sections 11(1)(c) and 11(1)(b) of the Ordinance would be overcome.

39. The relevant date in determining whether the subject mark has in fact acquired a distinctive character is 15 December 2011, the application date.

40. I now turn to VL’s SD and QZ’s SD and the exhibits thereto, both of which were filed with a view to showing that the subject mark has in fact acquired a distinctive character as a result of the use made of it.

Evidence on acquired distinctiveness

VL’s SD

41. According to Ms Lau, the Applicant’s Intellectual Property Counsel, the Applicant was established in Hong Kong in 2005⁵ and its business includes trading in mobile devices.

42. Among “Exhibit 2” to “Exhibit 10” to VL’s SD, the following three exhibits, either undated or post-dated the application date, offer little assistance to the subject application -

Exhibit	Description
“Exhibit 7”	Copy photograph of a battery bearing the mark “ALCATEL onetouch” said to have been manufactured since 2012.
“Exhibit 9”	Copy photograph of a performance at a roadshow in Hong Kong in December 2012.
“Exhibit 10”	Copy photograph (undated) of the screen of a mobile telephone (model unknown) showing application icons including “onetouch Manager”.

43. Below is a synopsis of the discussion of the remaining six exhibits at the hearing –

Exhibit	Description	My observation	Dr Yang’s submission
“Exhibit 2”	Copy Trade Mark Records of the subject application downloaded from the Trade Marks Registry’s website.	The Applicant has applied to amend the specification in question several times.	The Registrar is asked to consider the specification and proposed amendments thereto set out in the agent’s letter dated 5 August 2014. ⁶

⁵ “Exhibit 1” to VL’s SD is a copy of the Applicant’s business registration covering the period between 11 May 2013 and 10 May 2014. The exhibit does not show the Applicant’s date of establishment.

⁶ Paragraph 5 above and Annex 1 hereto.

“Exhibit 3”	Copy technical specifications of mobile telephone “ ONE TOUCH 500 ”, launched in 1999.	The mark used was “ONE TOUCH”. Mobile telephone “ ONE TOUCH 557 ” does not appear in the list of mobile telephones launched under the name “One Touch” between 1998 and January 2013 (see “Exhibit 6” below).	Dr Yang submitted that it is common practice for a trade mark to be presented in a variety of ways and the subject mark is a new generation of the mark “ONE TOUCH”. ⁷
“Exhibit 4”	Copy technical specifications of mobile telephones “ ONE TOUCH 556 ” and “ ONE TOUCH 557 ”, both launched in 2004.		
“Exhibit 5”	Copy pamphlet on mobile telephone “ ONE TOUCH 715 ”, launched in 2002.	The marks used were “ONE TOUCH TM ” and “One Touch TM ”.	
“Exhibit 6”	A list of 45 models of mobile telephone under the name “One Touch” with launch dates between 1998 and January 2013.	As at the application date, 39 models were said to have been launched but there is no indication of where they were launched.	Dr Yang said the list is not necessarily related to the Hong Kong market. She was unable to guide me to evidence showing which one(s) of the 39 models was/were sold in Hong Kong.
“Exhibit 8”	Copy photograph of the package of USB modem “ One TouchTM X220S ” manufactured since December 2010.	The mark used was “One Touch TM ”.	See Dr Yang’s submissions on “Exhibit 3”, “Exhibit 4” and “Exhibit 5” above.

44. By cross-referencing to certain exhibits to QZ’s SD, considerable time was spent at the hearing in trying to ascertain the market(s) in which the 39 models of mobile telephone were launched as at the application date (“**Exhibit 6**”) but in vain (see paragraphs 54 to 57 below). Dr Yang conceded that, absent requisite details including the location of launch, the sales volume and promotion expenses etc, “**Exhibit 6**” to VL’s SD provides little assistance to the subject application.

45. Under paragraph 12 of her evidence, Ms Lau gave sales figures (in so-called “KU” unit which Dr Yang explained to mean “kilo-unit”, i.e. 1,000 pieces per unit) on mobile telephones traded under the mark “ONE TOUCH”⁸ in Hong Kong for the period between 2009 and 2012 as follows -

⁷ It is said that “*Trademark ONE TOUCH is always printed in capital characters or with the device as applied in the subject application and it is often followed by the symbol TM.*”, skeleton argument, page 9, under “5. Use as a trade mark”.

⁸ A random pattern is observed in the Applicant’s description/presentation of its marks in its evidence and the skeleton argument.

Year	2009 (Ku)	2010 (Ku)	2011 (Ku)	2012 (Oct) (Ku)
Sales (unit)	421	5,921	8,471	5,274

46. As can be seen in paragraph 59 below, these sales figures do not tally with those Ms Zhang deposed to.

47. Consistency and adequacy aside, VL's SD and the exhibits thereto deal only with a handful of models of *mobile telephones* and one model of *USB modem* in a very limited way. On the whole, while I tend to accept that the Applicant has launched a few models of mobile telephone and one model of USB modem prior to the application date, I am unable to ascertain from Ms Lau's evidence that the subject mark was indeed used on those products and whether such use (if any) was made locally and/or the extent of it. All the more, Ms Lau's evidence fails to show use of the subject mark in Hong Kong in respect of each and every item of the applied for goods and services. As a matter of fact, Dr Yang conceded in the course of examining the Applicant's evidence that the Applicant has not adduced any evidence on use of the subject mark in respect of the applied for goods or services other than mobile telephones and USB modems.

QZ's SD

48. Ms Zhang has been the Applicant's Legal Counsel since 2011. She deposed to the details of the structure of the Applicant's parent company, TCL Communication Technology Holdings Ltd, under the principal company TCL Corporation which trades in mobile telephones, wearable devices, accessories, data cards, tablets and fixed-line telephones etc. According to Ms Zhang, TCL Corporation's products have been traded in over 160 countries. Its business expanded to the Hong Kong market in recent years.

49. Ms Zhang said the brand ONETOUCH⁹ has been used all over the world since 1995 and that products of the brand are also sold on-line through the Applicant's website www.Alcatelonetouch.com.

50. There are altogether 21 exhibits to QZ's SD. The ten exhibits below, either undated or post-dated the application date, fall outside the scope of my consideration -

⁹ Preceding footnote.

Exhibit	Description
“Exhibit XL-0(2)”	Copy photograph of headphone “ one touch BH35 ” with packaging. The subject mark “ onetouch ” was shown but the exhibit was undated.
“Exhibit XL-0(3)”	Copy photograph of “ PC software suite 3 ” packaging and an image of a screen page. The mark “Alcatel One Touch” was shown and the exhibit was undated.
“Exhibit XL-5”	Copy sample advertisements on mobile telephone “ Alcatel OT918N ”, mostly undated otherwise post-dated the application date.
“Exhibit XL-6”	Copy sample advertisements on mobile telephones “ Alcatel OT995 ”, “ Alcatel 995 ULTRA ” and “ Alcatel One Touch T50 ”, all dated 2012.
“Exhibit XL-7(1)”	Copy sample advertisements on mobile telephones “ Alcatel OT992D ”, “ Alcatel OT997D ” and “ Alcatel OT918N ”, dated between October 2012 and March 2013.
“Exhibit XL-7(2)”	Copy clippings on roadshow events to promote mobile telephones “ Alcatel OT992D ” and “ Alcatel OT997D ”, dated December 2012.
“Exhibit XL-9(3)”	Copy product catalogue for 2012.
“Exhibit XL-10”	Copy product catalogue for 2013.
“Exhibit XL-10(1)”	Copy webpage extracted from the Applicant’s Facebook account showing information collected from 1 December 2013 to 31 May 2014.
“Exhibit XL-10(2)”	Copy webpage extracted from the Applicant’s Facebook account, dated 31 July 2014.

51. It is mentioned in QZ’s SD and repeatedly emphasized by Dr Yang at the hearing that the brand ONETOUCH is often referred to by the press, consumers and in-house within the Applicant by the abbreviation “OT” and hence the Applicant would come to mind as soon as consumers see the words “OT”.¹⁰

52. Be that as it may, there is no basis for me to substitute “OT” for the subject mark “ **onetouch** ” in assessing its use for the purpose of the subject application. That being the case, advertising materials on mobile telephones “**Alcatel OT-990**” and “**OT-808**” and “**OT-980**” under “**Exhibit XL-3**”, “**Exhibit XL-4**” and “**Exhibit XL-8**”, no part of which (as Dr Yang agreed) shows the subject mark but only “OT”, would not assist the Applicant.

53. That leaves the following eight exhibits to be examined -

¹⁰ QZ’s SD, paragraph 3.

Exhibit	Description	My observation	Dr Yang's submission
"Exhibit XL-0(1)"	Copy photograph of package of mobile telephone " ALCATEL ONE TOUCH 556 ", launched in 2004.	The mark used was "ONE TOUCH".	Dr Yang said that the mark "ONE TOUCH" was used without any colour element in the past.
"Exhibit XL-1"	Copy media monitoring report by OAT limited as at August 2011 on advertising of mobile telephone " Alcatel OT-990 " for the period between June and August 2011. The total number of clippings was 57 and total "advertising value" was HK\$2,135,726.60.	Only one mobile telephone " Alcatel OT-990 " was involved.	
"Exhibit XL-2(1)"	Copy sample advertisements on mobile telephone " Alcatel OT-990 " for the period between June and August 2011 in newspapers, magazines and websites etc.	The marks "Alcatel" and "OT" were shown on the majority of the 57 advertisements. The mark "onetouch" or "One Touch" was used (either in black or white) in 40 of the advertisements. This exhibit contains the three advertisements discussed in paragraphs 22 to 25 above and reproduced in Annex 2 hereto.	
"Exhibit XL-2(2)"	Copy 19 sample advertisements on mobile telephone " Alcatel OT-990 " for the period between June and August 2011 in newspapers.	The subject mark and "Alcatel" were used on all 19 advertisements.	
"Exhibit XL-9(1)"	Copy product catalogue for 2009 covering 24 models of mobile telephone and 2 models of USB modem.	The subject mark was used on nine models of mobile telephone and both of the two models of USB modem. There is however no indication of the place and extent of distribution and the target recipient of the catalogue.	Dr Yang said she has no idea on which market(s) the two product catalogues were circulated. She however believed that such circulation was not extensive but consumers interested in the Applicant's products
"Exhibit XL-9(2)"	Copy product catalogue for 2009 covering 30 models of mobile telephone and three models of USB modem.	The subject mark was used on 11 models of mobile telephone and all three models of USB modem. There is however no	

		indication of the place and extent of distribution and the target recipient of the catalogue.	could approach the relevant retailers for information.
“Exhibit XL-11”	29 sample invoices dated between 26 November 2009 and 12 January 2011 of products sold in the Hong Kong market.	The sample invoices covered 13 models of mobile telephone and two models of USB modem. While five sample invoices showed “ONE TOUCH”, the rest merely showed “OT-...”, “ALCATEL OT ...” or “OT-... ALCATEL” etc.	
“Exhibit XL-12”	A list of 41 registrations of “ONE TOUCH” in overseas registries.	All but one of these 41 overseas trade mark registrations cover only Class 9 goods.	

54. It is apparent from the table above that Ms Zhang’s evidence under examination likewise deals exclusively with mobile telephones and USB modems and that the subject mark was rarely used. In the two product catalogues under “**Exhibit XL-9(1)**” and “**Exhibit XL-9(2)**” where the subject mark is observed to have been used, there is no evidence on the place and extent of distribution and the target recipient of the catalogues. As for “**Exhibit XL-2(2)**” which shows use of the subject mark in an advertisement, such use was only in respect of one model of mobile telephone and over a mere three months’ period.

55. Where evidence on advertising was adduced (“**Exhibit XL-1**”, “**Exhibit XL-2(1)**” and “**Exhibit XL-2(2)**”), it was only related to one model of mobile telephone “**Alcatel OT-990**”.

56. According to the list under “**Exhibit 6**” to **VL’s SD**, three models of mobile telephone (“**One Touch 280**”, “**One Touch 708 One Touch Mini**” and “**One Touch 800 One Touch Chrome**”) are said to have been launched in 2009.

57. While these three models of mobile telephone are indeed covered in either of the two product catalogues of 2009 (“**Exhibit XL-9(1)**” and “**Exhibit XL-11**” to **QZ’s SD**), as discussed in paragraph 54 above, the two product catalogues lend little support in proving use. I am therefore still not in a position to deduce the number of mobile telephones actually launched or otherwise being sold by the Applicant *in the Hong Kong market* under the subject mark in 2009, or at any time before the application date.

58. When examined globally, the 29 sample invoices under “**Exhibit XL-11**” do not assist me in ascertaining the Applicant’s sales volume in the relevant years either. Such sample invoices were related to 13 models of mobile telephone and two models of USB modem sold by the Applicant in the Hong Kong market during the period between November 2009 and January 2011. Only five out of the 29 sample invoices showed use of the mark “ONE TOUCH” (spanning between September 2010 and May 2011) while the rest merely bore “OT”, “ALCATEL OT” or “OT-... ALCATEL” etc. In any event, based on the sample invoices, any period of purported use of the subject mark could at best amount to only about two years (i.e. from November 2009 to December 2011) prior to the application date. Such period is well below the usual benchmark of five years for considering acquired distinctiveness, especially for a mark which is inherently descriptive and lacking a distinctive character. Evidence of more use would be required.

59. Ms Zhang deposed in paragraph 23 of her evidence that the sales of the Applicant’s mobile telephones in the Hong Kong market under the mark “ONETOUCH” between 2007 and 2012 were as follows -

Year	2007	2008	2009	2010	2011	2012
Sales (unit)	10,150	9,724	14,336	157,243	292,353	335,568

60. Strenuous efforts were made at the hearing in trying to make sense out of these sales figures as compared to those given in paragraph 12 of VL’s SD (paragraph 45 above). I note at the outset that in giving a completely different (much lower) set of figures, Ms Zhang (who I believe must have had a chance to consider VL’s SD before compiling her own evidence) never sought to explain the discrepancy between the two. On this point, Dr Yang referred me to the first paragraph at page 10 of the skeleton argument that one should take Ms Zhang’s evidence as referring to the Hong Kong market whereas the figures given by Ms Lau might include export sales.

61. Since the skeleton argument forms no part of the evidence, I am obliged to fall back on the Applicant’s evidence given on oath in considering factual issues pertaining to the subject application.

62. Even if I were to accept both Ms Lau and Ms Zhang’s sales figures to be accurate, lacking evidence on the number of mobile telephones actually sold under the subject mark, the intensity and spread in the use of it and the total expenses in

promoting the same etc, I would remain unable to conclude whether either set of the sales figures is sufficient in proving use of the subject mark on mobile telephones in the Hong Kong market prior to the application date.

63. As can be plainly seen, the Applicant did not adduce evidence of use of the subject mark in respect of USB modems except the scanty and unspecific mention as described in paragraphs 43 and 53 above, which in no way could be regarded as sufficient in proving acquired distinctiveness.

64. Moreover, I would add that mere evidence of use of a non-distinctive sign will not be sufficient, without more, to prove that it is distinctive of one particular trader, or is taken by the public as a badge of origin. It must be accompanied by evidence that the use has been for making such distinction. I find none of such evidence in the instant case.

65. In sum, as it has been conceded on the Applicant's behalf that no evidence has been adduced on the use of the subject mark other than on mobile telephones and USB modems (paragraph 47 above), the subject application in respect of all other items of the applied for goods and services must fail. Having assessed the Applicant's evidence of use of the subject mark in the round, I am unable to conclude either that there had been distinctive use of the subject mark in the context of mobile telephones and USB modems that would justify a finding that the subject mark has acquired a distinctive character in Hong Kong prior to the application date in respect of such goods as a result of the use made of it.

66. I have duly examined the amendments (i.e. deletions) to the specification of the applied for goods and services proposed in the agent's letter of 5 August 2014.¹¹ These proposed amendments unfortunately do not assist in advancing the Applicant's case in any manner and are hence rejected.

67. Based on the foregoing, I am not satisfied that the subject mark has come to be identified by the relevant consumers as an indicator of trade origin that distinguishes the 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 under section 11(2) of the Ordinance.

¹¹ Reproduced in Annex 1 hereto.

Foreign registrations

68. To substantiate the subject application, the Applicant also relies on the fact that the subject mark has been accepted for registration in the United States, France, Macau, Australia and Singapore etc.¹² Suffice it to say that all but one such foreign registrations are related to Class 9 goods only and that registrability of a trade mark has to be assessed on the basis of its own merits. This is particularly so if registrability of the mark in question has to be sought on the basis of acquired distinctiveness, where use of the mark in the territories concerned varies from place to place. As national trade mark rights are territorially limited and granted independently of one another, the mere fact of registration in other jurisdictions is not sufficient to establish that a trade mark is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885, followed by *Tonalite Henne Trade Mark* [2001] R.P.C. 729).

CONCLUSION

69. I have carefully considered all the evidence and arguments adduced and advanced for and on behalf of the Applicant in the subject application. For the above reasons, I find that the subject mark is precluded from registration under sections 11(1)(b) and 11(1)(c) of the Ordinance in respect of the applied for goods and services. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Elsie Tse
for Registrar of Trade Marks
5 March 2015

¹² QZ's SD, "Exhibit XL-12" and observed in paragraph 53 above.

(1) Specification of the subject application as at 7 April 2014

Class 9

Telecommunications apparatus, devices, equipment and installations, particularly mobile equipment; telecommunications software; mobile equipment batteries; battery chargers; devices for hands-free use of mobile equipment, namely loudspeakers, microphones, headsets, containers for mobile equipment; keyboards for mobile equipment; cases for mobile equipment; computers, hand held computers, tablet computers, personal digital assistants, electronic organizers, electronic notepads, mobile digital electronic devices, global positioning system(GPS) devices; aerials for mobile telephones and communication networks; prepayment devices and equipment for recharging mobile equipment; all the above are relating to the field of telecommunication and communication purpose only.

Class 38

Telephone, radio broadcasting, radiotelephony and videotelephony services. Telecommunication services, namely secured transmission of data, images and sound, communication via computer terminals, transmission of information via computer or telephone communications; transmission of information via satellites; sending of messages, transmission of encoded images and sound; data transmission services, particularly transmission via packets of information and images, multimedia data transmission services; electronic and computer messaging and mail services; multimedia and interactive multimedia information transmission and downloading (transmission) of data, images, games, ringtones, animations, wallpapers, designs, graphics, sounds and electronic melodies to be played or used on cellular mobile; services of transmission, communication and telecommunication by any means, including electronic, computer and telephone means; transmitting of information held in data and image banks, diffusion of information electronically, in particular for global communication networks (such as the Internet) or private or restricted access networks; transmission, communication and telecommunication of messages, information and all other data, including those provided online or stored and forwarded from data-processing systems, computer databases or computer or data communication networks, including the Internet and the World Wide Web; transmission of information accessible via access codes, data processing servers, computer database servers, computer or data communication networks, including the Internet and the World Wide Web; transmission of text, electronic documents, databases, graphics and audiovisual information accessible via access codes, via a

computer and via a telecommunication network including the Internet; transmission of computer programs accessible via access codes, by interfaces for personal home pages; transmission of periodicals and other printed matter relating to the Internet via computers and communication networks; real time communication services between telephone or computer users on the Internet and World Wide Web; telecommunication services provided via the Internet; Instant electronic messaging services; access services via computers and communication networks, including the Internet, to texts, electronic documents, databases, graphics and audio-visual information; provision of access to computer programs via homepage interfaces; providing virtual facilities for real-time interaction between computer users; services for access to periodicals and other printed publications relating to the Internet via computers and via communication networks; providing user access to a global computer network (service providers); providing telecommunications connections to a global computer network, providing user access to search engines; providing connections to the Internet or local telecommunication networks; providing user access to internal or local networks; providing user access to the Internet via portals; sending and receiving of data, sound, signals and information processed by computers or telecommunication apparatus and instruments; providing user access to national and international server centers, providing access time to databases and computer or telematic database server centers; providing access time to telephone networks; providing access time to telephone, radio, radiotelephony and telematic networks, to a data bank server center, in particular for global communication networks (such as the Internet) or private or restricted access networks (such as intranets); rental of access time to a database server center; providing access to a computer database especially for downloading images, sounds, melodies, ringtones, animations, graphic designs, wallpapers and games; rental of mobile phones; all the above are relating to the field of telecommunication and communication purpose only.

Class 42

Rental of computers, hand held computers and tablet computers; maintenance of telecommunication and communication software; computer software (for telecommunication and communication purposes) design, updating of computer software (for telecommunication and communication purposes), maintenance of computer software (for telecommunication and communication purposes); technical assistance in the operation and monitoring of computer networks; technical support services in the field of information technology and telecommunications; computer programming (for telecommunication and communication purposes); computer and telecommunication system design; supervision services (monitoring, surveillance) of

telecommunication networks; developing, maintaining and updating of a search engine for telecommunication networks; design of computer and telecommunication networks; converting codes and formats between different types of text; database design.

(2) Amendments to the specification proposed in the agent's letter of 5 August 2014

Class 9

Telecommunications apparatus, devices, equipment and installations, particularly mobile equipment; telecommunications software; mobile equipment batteries; battery chargers; devices for hands-free use of mobile equipment, namely loudspeakers, microphones, headsets, ~~containers for mobile equipment; keyboards for mobile equipment;~~ cases for mobile equipment; computers, ~~hand held computers,~~ tablet computers, ~~personal digital assistants, electronic organizers, electronic notepads,~~ mobile digital electronic devices, ~~global positioning system(GPS) devices;~~ ~~aerials for mobile telephones and communication networks;~~ prepayment devices and equipment for recharging mobile equipment; all the above are relating to the field of telecommunication and communication purpose only.

Class 38

Telephone, ~~radio broadcasting, radiotelephony~~ and videotelephony services. Telecommunication services, namely secured transmission of data, images and sound, ~~communication via computer terminals,~~ transmission of information via computer or telephone communications; ~~transmission of information via satellites;~~ sending of messages, ~~transmission of encoded images and sound; data transmission services, particularly transmission via packets of information and images, multimedia data transmission services;~~ electronic and computer messaging and mail services; multimedia and interactive multimedia information transmission and downloading (transmission) of data, images, games, ringtones, animations, wallpapers, designs, graphics, sounds and electronic melodies to be played or used on cellular mobile; services of transmission, communication and telecommunication by any means, including electronic, computer and telephone means; transmitting of information held in data and image banks, diffusion of information electronically, in particular for global communication networks (such as the Internet) or private or restricted access networks; transmission, communication and telecommunication of messages, information and all other data, including those provided online or stored and forwarded from data-processing systems, computer databases or computer or

data communication networks, including the Internet and the World Wide Web; ~~transmission of information accessible via access codes, data processing servers, computer database servers, computer or data communication networks, including the Internet and the World Wide Web; transmission of text, electronic documents, databases, graphics and audiovisual information accessible via access codes, via a computer and via a telecommunication network including the Internet; transmission of computer programs accessible via access codes, by interfaces for personal home pages; transmission of periodicals and other printed matter relating to the Internet via computers and communication networks; real time communication services between telephone or computer users on the Internet and World Wide Web; telecommunication services provided via the Internet; Instant electronic messaging services; access services via computers and communication networks, including the Internet, to texts, electronic documents, databases, graphics and audio visual information; provision of access to computer programs via homepage interfaces; providing virtual facilities for real time interaction between computer users; services for access to periodicals and other printed publications relating to the Internet via computers and via communication networks; providing user access to a global computer network (service providers); providing telecommunications connections to a global computer network, providing user access to search engines; providing connections to the Internet or local telecommunication networks; providing user access to internal or local networks; providing user access to the Internet via portals; sending and receiving of data, sound, signals and information processed by computers or telecommunication apparatus and instruments; providing user access to national and international server centers, providing access time to databases and computer or telematic database server centers; providing access time to telephone networks; providing access time to telephone, radio, radiotelephony and telematic networks, to a data bank server center, in particular for global communication networks (such as the Internet) or private or restricted access networks (such as intranets); rental of access time to a database server center; providing access to a computer database especially for downloading images, sounds, melodies, ringtones, animations, graphic designs, wallpapers and games; rental of mobile phones; all the above are relating to the field of telecommunication and communication purpose only.~~

Class 42

~~Rental of computers, hand held computers and tablet computers; maintenance of telecommunication and communication software; computer software (for telecommunication and communication purposes) design, updating of computer software (for telecommunication and communication purposes), maintenance of~~

~~computer software (for telecommunication and communication purposes); technical assistance in the operation and monitoring of computer networks; technical support services in the field of information technology and telecommunications; computer programming (for telecommunication and communication purposes); computer and telecommunication system design; supervision services (monitoring, surveillance) of telecommunication networks; developing, maintaining and updating of a search engine for telecommunication networks; design of computer and telecommunication networks; converting codes and formats between different types of text; database design.~~

- (1) Publication: “Milk”
Date: 7 July 2011
Page: 43, Issue 520

3. ALCATEL OT990

法國手機品牌Alcatel，決心再戰香港市場，推出採用Android 2.2作業平台之智能機種——OT990。手機繼續以「One Touch」為理念，以簡潔和型格為設計原則，並整合必備的科技與服務，讓用戶的操控盡在一指之間。OT990配備3.5吋HVGA電容式觸控屏幕，內置500萬自動對焦拍攝鏡頭，支援A-GPS衛星定位技術及Wi-fi 802.11b/g無線網絡系統，裝備雖非頂班，但相信售價很親民。OT990備有3款機殼顏色，包括透藍黑、紫紅及玫瑰紅3色。
售價待定 Alcatel 3180-2777

- (2) Publication: “Wealthy Magazine”
Date: 29 July 2011
Page: 104

INFORMA

Alcatel推出全新華麗OT990系列

夏日熱潮「一觸」即發

TCL公司近日宣佈，旗下的法國品牌Alcatel將於今年6月推出One Touch智能手機OT990，畀時手機用戶可親身體驗這股「一觸」即發的夏日熱浪。

Alcatel One Touch以簡潔和型格為設計原則，配備多元而必備的科技與服務，為用戶整合生活，讓大家的手機世界盡在一指之間。OT990不但秉承這個概念，而且不斷求進，以電容式觸控畫面，揮手感控功能及更精確的觸控感應系統，為用戶帶來更先進的手機體驗。

Alcatel OT990主要重點功能：三款誘人機 顏色；包括成熟穩重的透藍黑色、散髮神秘吸引力的誘人紫紅色及熱情奔放的火辣玫瑰紅色。流線型及光滑設計；12.15毫米超薄機身，配以強化玻璃及防污屏幕技術。採用最新Android? 2.2作業平台。



- (3) Publication: “MR Magazine”
Date: 1 August 2011
Page: 152, Issue 42



ALCATEL
one touch 990 手機

來自法國的夏日熱浪，「一觸」即發。說到法國，別以為只有高級時裝、美食或是浪漫可以販賣，它們的手機你應同樣注意。貴為 TCL 公司旗下的法國品牌ALCATEL推出 One Touch 智能手機 OT990，以簡潔和型格為設計原則，配備多元而必備的科技與服務，為用戶整合生活，讓大家的手機世界盡在一指之間。OT990 不但秉承這個概念，而且不斷求進，以電容式觸控畫面，揮手感控功能及更精確的觸控感應系統，流線型及光滑設計，3.5吋特大的 HVGA 亮麗屏幕，為你帶來更先進的手機體驗。備有三款誘人機殼顏色包括透藍黑色、誘人紫紅色及火辣玫瑰紅色，任君選擇。