

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 302427868

MARK :  DCN multimedia

APPLICANT : Bosch Sicherheitssysteme GmbH

CLASS : 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 7 November 2012, Bosch Sicherheitssysteme GmbH (the ‘Applicant’) filed an application for registration of the mark shown below (the ‘Subject Mark’) under the Trade Marks Ordinance (Cap. 559) (the ‘Ordinance’).



2. Registration of the Subject Mark is sought in respect of ‘Electronic conference and communication systems, comprising control apparatus, receiving and transmitting units, voting units, parts and accessories therefore, in particular microphones, headphones, loudspeakers, power supplies, plugs and sockets, modems and cables’ in Class 9 (the ‘applied for goods’).
3. At the examination stage, objection was raised by the Registrar of Trade Marks (the ‘Registrar’) against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade mark (the ‘Cited Mark’):-

Cited Mark

Trade Mark :

DCN

Registration Number. : 301998910
Date of Registration : 9 August, 2011
Specification : Class No. 9
數據處理設備；計算機存儲器；計算機；已錄製的計算機程序（程序）；已錄製的計算機操作程序；計算機周邊設備；內部通訊裝置；網絡通訊設備；電源材料（電線、電纜）。

(English Translation¹: Data processing apparatus; computer memory devices; computers; computer programmes, recorded; computer operating programmes, recorded; computer peripheral devices; intercommunication apparatus; network communication apparatus; materials for electricity mains (wires, cables))

Class No. 42

技術研究；技術項目研究；研究與開發（替他人）；計算機編程；計算機軟件設計；計算機軟件更新；計算機數據的復原；計算機軟件維護；計算機系統設計；計算機程序和數據的數據轉換（非有形轉換）。

(English Translation²: technical research; technical project research, research and development for others; computer programming; computer software design; updating of computer software; recovery of computer data; maintenance of computer

1 Reference has been made to the 10th edition of the Nice Classification available at <http://web2.wipo.int/nicepub/edition-20150101/taxonomy/class-9/?pagination=no&lang=en>

2 Reference has been made to the 10th edition of the Nice Classification available at http://web2.wipo.int/nicepub/edition-20150101/taxonomy/class-42/?pagination=no&lang=en&mode=flat&explanatory_notes=show&basic_numbers=show

software; computer system design; data conversion of computer programs and data (not physical conversion))

4. By its letter dated 23 January 2014, the agent of the Applicant, Wilkinson & Grist (the 'Agent'), requested a hearing on the registrability of the Subject Mark. The hearing took place before me on 9 October 2014, at which Ms. Lily Cheung of the Agent appeared for the Applicant. Written submissions were filed by the Agent on 3 October 2014. I reserved my decision at the conclusion of the hearing.
5. No evidence of honest concurrent use of the Subject Mark and the Cited Mark under section 13 of the Ordinance was filed. I therefore only have the *prima facie* case to consider.

DECISION

The Ordinance

6. The objection is raised pursuant to section 12(3) of the Ordinance, which reads as follows:-

'A trade mark shall not be registered if –

- (a) the trade mark is similar to an earlier trade mark;*
- (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and*
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.'*

7. The definition of an 'earlier trade mark', which is referred to in section 12(3) of the Ordinance, is stated in section 5 of the Ordinance. The relevant part is set out below:-

‘(1) In this Ordinance, “earlier trade mark” (在先商標), in relation to another trade mark, means –

- (a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any...’*

The date of application for registration of the Cited Mark is earlier than that of the Subject Mark. The Cited Mark therefore constitutes an ‘earlier trade mark’ in relation to the Subject Mark for the purpose of section 5 of the Ordinance.

8. Another relevant section is section 7(1) of the Ordinance, which throws light on how paragraph (c) of section 12(3) is to be interpreted. It provides that –

‘For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.’

Section 12(3) of the Ordinance

9. Section 12(3) of the Ordinance essentially precludes a mark from registration if the use of it is likely to cause confusion on the part of the public, as a result of it being similar to an earlier trade mark and because it is sought to be registered in respect of goods or services the same as or similar to those registered under the earlier trade mark. I thus need to consider whether there are similarities between the Cited Mark and the Subject Mark and between the goods and/or services covered by those marks which would lead to a likelihood of confusion.
10. The basic principles regarding the assessment of similarity between marks and the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117 and adopted in *Guccio Gucci SpA v Gucci* [2009] 5 HKLRD 28. These principles are:-

- (a) The likelihood of confusion must be appreciated globally, taking into account all the relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods in issue, who is deemed to be reasonably well informed and reasonably observant and circumspect;
- (c) In order to assess the degree of similarity between the marks concerned, one must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into account the nature of the goods in question and the circumstances in which they are marketed;
- (d) The visual, aural and conceptual similarities of the trade marks must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion;
- (e) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (f) There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (g) The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; further the average consumer's level of attention is likely to vary according to the category of goods in question;
- (h) Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*;

- (i) Mere association, in the sense that the later trade mark brings the earlier trade mark to mind, is not sufficient for the purpose of the assessment;
- (j) But the risk that the public might believe that the goods in question come from the same undertaking or economically-linked undertakings, does constitute a likelihood of confusion within the meaning of the section.

Comparison of marks

11. In light of the principles stated in paragraph 10 above, a comparison of the marks concerned has to be based on an overall appreciation of the visual, aural and conceptual similarities of the marks, taking into account the overall impressions given by the marks, and bearing in mind, in particular, their distinctive and dominant components. In comparing the marks concerned, I should consider the perception of the marks in the mind of an average consumer of the relevant goods.
12. The applied for goods under Class 9 encompass electronic conference and communications systems, comprising control apparatus, receiving and transmitting units, voting units, parts and accessories such as plugs and sockets, modems and cables. These goods may be used by the general public who look for these products, as well as business customers with professional knowledge. Having regard to the generality and popularity of electronic communication goods, the level of care and attention in the purchase or selection of these goods may vary from average to above average.
13. The Subject Mark is a composite mark which contains a device  (the 'device') on the left, three letters 'DCN' in the middle and the word 'multimedia' on the right. The device is composed of 4 sets of 3 concentric broken lines arranged in a hemispherical shape and the lines span across the top of an oval device. A dot is placed slightly to the right on the top of the oval device. It may be said that it resembles the shape of a fan or a radar. The letters 'DCN' are in upper case and the word 'multimedia' is in lower case. Both are without any stylization or decoration. There is no colour claim in the subject application.

14. The verbal element 'multimedia' means 'using, involving, or encompassing several media' or 'a technique (as the combining of sound, video, and text) for expressing ideas (as in communication, entertainment, or art) in which several media are employed; *also* : something (as software) using or facilitating such a technique' (Merriam-Webster's Online Dictionary <http://www.merriam-webster.com/dictionary/multimedia>). When the word is used in respect of the applied for goods such as electronic conference and communication systems, it is likely to be perceived as a descriptive reference to the goods provided as being involved in or using several media. As is clear from *Jose Alejandro SL v OHIM, Anheuser-Busch Inc Intervening* Case T129/01[2004] E.T.M.R. 15, as a general rule, descriptive elements will not generally form the focus of consumer attention with the consequence that such elements will not usually be considered to be distinctive and dominant within the context of the overall impression created by the mark. Having considered the mark as a whole, the word 'multimedia' is a relatively insignificant component. It will be perceived by the relevant consumers as indication that these goods involve or use several media rather than as information on the commercial origin of the applied for goods.
15. Regarding the device of the Subject Mark, while it may have a distinctive character on its own, as the saying goes, words speak louder than devices in a composite mark (*Oasis Stores Ltd. Trade Mark Application* [1998] RPC 631 at 644), consumers will likely pay greater attention to the verbal elements of the Subject Mark. As explained in the preceding paragraph, since the word 'multimedia' is of a descriptive nature, consumers will tend to remember the verbal element 'DCN', which is a more distinctive and dominant element and refer to Subject Mark as the 'DCN' mark.
16. The Cited Mark consists of the plain letters 'DCN' in bold typeface and in upper case. It is the only element of the Cited Mark. There is no other element which could be considered to be more distinctive or dominant than 'DCN'. I consider that 'DCN' should be regarded as the dominant and distinctive element of the Cited Mark.
17. Ms. Cheung submitted that when considered as a whole, the Subject Mark is distinguishable on the overall from the Cited Mark. She emphasized that the

device  having been registered in Hong Kong under no.199509779 for goods similar to those of the applied for goods, has distinctive character and it is of a larger size than the word component of the Subject Mark. As it is at the front of the Subject Mark, it catches viewers' attention. It is more distinctive than the letters 'DCN'. Ms. Cheung also referred to the acronym finder and averred that 'DCN' is a common acronym for 'Data Communication Network'. As it has a descriptive connotation and lacks distinctive character in relation to communication systems, it should not be considered as the main identifying element of the Subject Mark. Moreover, in relation to the cited goods and services such as data processing apparatus (數據處理設備) and network communications apparatus (網絡通訊設備), the Cited Mark comprising only the plain letters 'DCN' is on the whole descriptive and indistinctive. In Ms. Cheung's view, 'DCN' has become generic or otherwise is a mark having low distinctive quality.

18. I am not convinced by Ms. Cheung's argument. While 'DCN' can be an abbreviation for 'Data Communication Network', it was also accepted by Ms. Cheung at the hearing that 'DCN' could be abbreviations for other terms and have other meanings. For example, it can refer to 'DLA (Defense Logistics Agency) Corporate Network', 'Disconnect', 'Document Control Number' (Acronym Finder <http://www.acronymfinder.com/DCN.html>), 'document change notice' (dictionary.com <http://dictionary.reference.com/browse/DCN?r=66>). 'DCN' is not a term used in ordinary parlance by the members of the public which form the average consumers of the applied for goods. Although it cannot be ruled out that certain professional customers may perceive or associate 'DCN' with 'Data Communication Network', in the absence of other elements in the mark that could give hint to the meaning of 'DCN' as alleged, one cannot conclude that ordinary members of the public would perceive 'DCN' as such, not to mention that it is or has become generic. In any event, I am of the view that the verbal element 'DCN' will have no meaning in respect of the applied for goods for the vast majority of the public. There is simply no evidence to support the proposition that "DCN" has become a generic term. With regard to the Cited Mark, it does not have any additional elements which can be considered more distinctive than 'DCN'. I maintain that 'DCN' is the most distinctive and dominant element in the Subject Mark and the Cited Mark.

19. Visually, the Subject Mark contains a fan or radar like device which, to a certain degree, is distinctive on its own. Notwithstanding that, as explained, in the case of composite marks, it is generally the word element which mostly captures the consumers' attention. Taking into consideration the descriptive nature of the word 'multimedia' in relation to the applied for goods in the Subject Mark, the letters 'DCN' will have a stronger impact on consumers than the word 'multimedia' and the device. The overall impression conveyed by Subject Mark is dominated by the distinctive element 'DCN', which is identical to that of the Cited Mark. I consider that the Subject Mark and Cited Mark are visually similar.
20. Phonetically, one may have difficulty in identifying the device in speech. The Subject Mark and the Cited Mark share the same element 'DCN', but the Subject Mark has in addition the word 'multimedia'. It is likely that the Subject Mark will be referred to as "DCN Multimedia" whilst the Cited Mark merely "DCN". As people would pay more attention to the first word being spoken, and might tend to ignore the second word 'multimedia' given that it is descriptive, I find there is high aural similarity between the Subject Mark and the Cited Mark.
21. As for the conceptual comparison with the Cited Mark, the word 'multimedia' in the Subject Mark is relatively insignificant within the overall impression created by those marks as a result of its descriptive nature. Ms. Cheung submitted that the device resembles sets of lines evoking sound or electromagnetic waves but also gives an impression of a conceptual layout plan of an auditorium. She also submitted that the device corresponds to some degree to the word 'multimedia' in the Subject Mark. Be that as it may, Ms Cheung's submissions would suggest that both the word 'multimedia' and the device are descriptive of the applied for goods that befit an auditorium setting, and hence just reinforce my analysis above that 'DCN' is the most distinctive and dominant element in the Subject Mark. Since the overall impression of both marks in the mind of the average consumer will still be dominated by the letters 'DCN', there is no significant conceptual difference between the Subject Mark and the Cited Mark.
22. Taking into account the overall impression created by the marks and bearing in mind the perception of the relevant consumers and the imperfect recollection they have of the marks, I consider that the similarities outweigh the dissimilarities. I find the Subject Mark and the Cited Mark to be similar.

Comparison of goods and services

23. Jacob J (as he then was) in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (at pages 296-7) set out the factors that should be taken into account when considering the similarities between goods and/or services. These factors are:-
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of service;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.
24. It was also held in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, supra (at paragraph 23) that in assessing the similarity of the goods or services concerned, all the relevant factors relating to the goods or services themselves, including but not limited to their nature, their end users, their method of use and whether they are in competition with each other or are complementary, should be taken into account.
25. The Cited Mark is registered in respect of various goods under Class 9 including, *inter alia*, intercommunication apparatus; network communication devices; materials for electricity mains (wires, cables)) and services under Class 42 such as computer software design; updating of computer software; recovery of computer data.

26. The applied for goods under Class 9 are electronic conference and communication systems, comprising control apparatus, receiving and transmitting units, voting units, parts and accessories therefore, in particular microphones, headphones, loudspeakers, power supplies, plugs and sockets, modems and cables.
27. At the examination stage, it was pointed out to the Agent that the applied for goods are similar to the cited goods and services. The Agent did not raise any argument to the contrary. At the hearing, Ms. Cheung argued that a large part of the goods and services under the Cited Mark relate to computer equipment and computer services. They are different to the conference system of the applied for goods. She argued that network communications apparatus (網絡通訊設備) refers to things like mobile phones and are different from a telephone conference system. However, she admitted that both items serve communication function.
28. In view of the nature and uses of ‘network communication equipment’ and ‘intercommunication apparatus’ under Class 9 of the cited goods and the applied for goods, (for example, they can serve the same or similar functions by providing audio, visual or data transmission and communication) and that they could be used by the same end users, I consider the said cited goods and the applied for goods to be highly similar.
29. As for the computer services under Class 42 such as computer software design and computer system design, they are complementary to and have a certain degree of similarity to the applicant’s electronic conference and communication systems and the parts and accessories thereof such as modems. Software developed from the aforesaid services can play a part in the functioning of the said applied for goods. It is also not uncommon for companies to offer under the same brand both electronic conference and communication systems and accessories which utilize computer software and auxiliary services such as computer software design, maintenance of computer software and recovery of computer data. These goods and services may be offered through the same trade channels.
30. In the circumstances, I find that the applied for goods in Class 9 in the subject application are similar to the goods in Class 9 and services in Class 42 in respect of which the Cited Mark is registered.

Likelihood of confusion

31. Under section 12(3) of the Ordinance, a likelihood of confusion refers to confusion on the part of the public as to the trade origin of the goods or services in question. It is a matter of global appreciation taking into account all relevant factors and judging through the eyes of an average consumer of the goods or services in question.
32. As discussed in paragraph 12 above, the relevant consumers of the goods concerned are members of the general public in Hong Kong and business customers with professional knowledge. They are deemed to be reasonably well informed and reasonably observant and circumspect. It is expected that the level of attention of the majority of the relevant consumers is normal and they would not pay particularly great attention to selecting those goods. It should also be noted that the average consumer seldom directly compares marks side by side but rely upon his imperfect recollection of marks.
33. Taking account of the visual, aural and conceptual similarities between the Subject Mark and the Cited Mark, and the similarities between the applied for goods and the goods and services protected by the Cited Mark, and also bearing in mind the principles as set out in paragraph 10 above and having regard to all relevant factors, I find that when the Subject Mark is used in relation to the applied for goods, the relevant consumers would be confused into believing that the goods provided under the Subject Mark and the goods or services provided under the Cited Mark come from the same undertaking or economically-linked undertakings. I come to the conclusion that there is a real likelihood of confusion if the Subject Mark is allowed to co-exist with the Cited Mark. In such circumstances, the registration of the Subject Mark is objectionable under section 12(3) of the Ordinance.

Other matters

34. Ms. Cheung also relied on some other registered marks in Hong Kong which she believes are either similar to the Cited Mark or marks which share common letters,

but are allowed to co-exist on the register. I have considered those marks referred to but do not think that they are comparable with the subject application. In any event, it has been long established that the state of the register is not relevant in considering the registrability of a mark since each case has to be decided on its own merits. As noted by Jacob J in the case of *British Sugar v James Robertson and Sons Ltd*, *supra*, at page 305 ‘It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark and the same must be true under the 1994 Act.*’. The reference to the co-existence of certain registered marks is of no assistance to this application.

Conclusion

35. I have carefully considered all the documents filed on behalf of the applicant and all the oral and written submissions made in respect of the subject application. For the reasons stated above, the Subject Mark is precluded from registration under section 12(3) of the Ordinance in respect of the applied for goods in Class 9. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Winnie WH Ng
for Registrar of Trade Marks
6 March 2015