

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 302658466

MARK : DartTalk

APPLICANT : Hong International JOOSIKHOISA (Hong International Corp.)

CLASSES : 9 & 38

STATEMENT OF REASONS FOR DECISION

BACKGROUND

1. On 3 July 2013 Hong International JOOSIKHOISA (Hong International Corp.) (“the Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for registration of the mark below (“the subject application”) -

DartTalk

(“the Subject Mark”)

2. Registration of the Subject Mark is sought in respect of the following goods and services (“the applied for goods and services”)¹ -

Class 9

Downloadable computer program; computer application software for mobile phones; computer game program; computer software; application software for smartphone; messenger software using network namely, internet and mobile communication network; recorded software for messenger; recorded messenger program; downloadable messenger program.

¹ The specification of the applied for goods and services was slightly amended after the filing of application. The specification shown herein reflects the amendment.

Class 38

Service for data communication; transmitting digital files; transmitting messages; providing E-mail services; service for instant transmission of messages; providing internet chatting room; service for electronic data communication; providing electronic telecommunication connections for internet users; service for internet bulletin board; transmitting electronic message; service for electronic mail.

3. The Applicant claims a priority date of 21 January 2013.

4. At the examination stage, an objection was raised by the Registrar of Trade Marks (“the Registrar”) under section 12(3) of the Ordinance on the ground that the Subject Mark is considered to be similar to the following earlier registered trade mark (“the Cited Mark”) and the applied for goods and services similar to the services of the Cited Mark (namely, those in Classes 38 and 42) such that use of the Subject Mark in relation to the applied for goods and services is likely to cause confusion on the part of the public -

Registration No.: 300974863

Trade mark: **DART**

Class: 35, 38 & 42

Specification: Class 35

Advertising and promotional services, and information services relating thereto, provided over global computer networks; distribution of advertising materials and providing other electronic commerce offers for advertising purposes to websites; collecting and reporting business information for others to measure the effectiveness of business offers; consulting in the field of online advertising; rental/leasing of publicity materials; providing interactive databases (information services)in the field of advertising and electronic commerce; developing and conducting tests to evaluate the effectiveness of advertising via the global computer network.

Class 38

Communication by computer terminals, communication by telegram, communication by telephone, news agencies services for communication media, rental/leasing of communication equipment, including telephones/facsimile machines.

Class 42

Providing computer information regarding global computer network users; computer programming; technical consultation and technical research in the field of advertising and other electronic commerce offers delivered over the Internet or global computer networks.

Date of registration: 17 October 2007

5. Despite submissions made on behalf of the Applicant, the objection was maintained by the Registrar. The Applicant requested a hearing on the registrability of the Subject Mark. The hearing took place before me on 9 April 2015, where Dr Sunny H.M. Yang (“Dr Yang”) of Liu, Shen & Associates (“the agent”) appeared for the Applicant.

6. At the examination stage, the agent submitted by correspondence certain purportedly relevant materials on fact. Since such materials were not adduced by way of sworn evidence, they carry little evidential value. By letter dated 26 March 2015, the agent also put forward his views on the Registrar’s objection and enclosed a Trade Mark Form T5A seeking to further amend the specification of the applied for goods and services (“the proposed re-amendment”)². The Applicant on the other hand did not file any evidence of use of the Subject Mark to show that there has been an honest concurrent use of the Subject Mark and the Cited Mark for the purpose of section 13(1) of the Ordinance. I, therefore, only have a *prima facie* case to consider.

² The proposed re-amendment is reproduced in the Annex hereto.

DECISION

Section 12(3) of the Ordinance

7. The relative grounds for refusal of an application for registration are contained in section 12 of the Ordinance, the relevant provision of which reads as follows -

- “(3) 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.”*

8. Section 12(3) prohibits the registration of a trade mark which would be 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 to be registered in respect of goods or services the same as or similar to those of the earlier trade mark.

9. An “*earlier trade mark*” referred to in section 12(3) is defined in section 5 of the Ordinance as follows -

- “(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 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;”*

10. Since the Cited Mark has a date of application for registration earlier than that of the Subject Mark, it is an earlier trade mark in relation to the Subject Mark.

11. According to section 7(1) of the Ordinance, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

12. The basic principles regarding the assessment of similarity between signs and the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.R.S. 19. Such principles have been adopted in Hong Kong and recently by the Court of Appeal in *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd* [2014] HKEC 2004. In *Tsit Wing*, Lam VP cited (at paragraph 35) the propositions endorsed by Kitchen LJ in *Specsavers* (at paragraph 52) as follows -

“On the basis of these and other cases the Trade Marks Registry has developed the following useful and accurate summary of key principles sufficient for the determination of many of the disputes coming before it:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;*
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who 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, and whose attention varies according to the category of goods or services in question;*
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;*
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison*

- solely on the basis of the dominant elements;*
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;*
 - (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;*
 - (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;*
 - (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;*
 - (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;*
 - (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;*
 - (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”*

13. The above principles are those that I would bear in mind when considering whether similarity exists between the Subject Mark and the Cited Mark thus giving rise to a likelihood of confusion to the relevant public if the former is used in relation to the applied for goods & services.

Relevant public

14. In comparing the marks, I have to consider the perception of the marks in the mind of the average consumer of the goods and services in question, who normally views a mark by the overall impression rather than by analysing its details. The average consumer is deemed to be reasonably well informed and reasonably

observant and circumspect. His/her level of attention is likely to vary according to the category of goods and services being discussed.

15. The applied for goods and services include programs and software on one hand and data communication/transmission service or network on the other, both for use on computer and/or mobile telephone. They are essentially related to computer programs and telecommunication for everyday use. Such goods and services are directed at members of the general public in Hong Kong who are interested in using them. The average consumer is therefore any member of the general public. Given the common and broad-scale use nowadays of such goods and services by the public at large, the average consumer, though reasonably well informed and reasonably observant and circumspect, is not expected to exercise a high level of care and attention when considering those goods and services. The relevant level of care and attention is considered to be average.

The Subject Mark

16. The Subject Mark “**DartTalk**” is a single word mark containing eight letters of the English alphabet. It is expressed in mere plain font and ordinary uniform typeface without any stylization. Save the letter “d” at the beginning and the letter “t” in the middle of the mark that are presented in the upper case, all six remaining letters making up the mark are in the lower case. There are no additional elements in the Subject Mark. Although the Subject Mark appears to be a single word mark, given the natural construction of the word, the average consumer would have no difficulty perceiving it as being made up of two English words “dart” and “talk”. Moreover, the capital letters “D” and “T” in the Subject Mark reinforce such perception.

17. As a single word, “DartTalk” has no meaning in English or Chinese. When perceived separately, however, both “dart” and “talk” are dictionary defined words. As noun, “dart” is a *“small, slender missile that is pointed at one end and usually feathered at the other and is propelled by hand, as in the game of darts, or by a blowgun when used as a weapon”* or as verb *“to move swiftly; spring*

or start suddenly and run swiftly".³ "talk" on the other hand means "*to discuss, to communicate or exchange ideas and information etc, by speaking*".⁴

18. In view of the nature and purposes of the applied for goods and services being mainly for chatting, communication and data transmission by means of computer and/or mobile telephone, the word "talk" in the Subject Mark is indistinctive as it merely describes the characteristics of the goods and services concerned.

19. At the hearing, Dr Yang submitted that the word "talk" was rarely used to describe the characteristics of the applied for goods and services. By citing the example of "WeChat"⁵ [or "WeeChat"⁶], Dr Yang reckoned that the word "chat" was by far a more popular, apt and colourful word to be used in, for instance, advertising products akin to the applied for goods and services. When asked whether it was at all possible that the word "talk" be used nonetheless, Dr Yang conceded such a possibility. The word "talk" can indeed be regarded as descriptive or indistinctive for the applied for goods and services as the word "chat" can.

20. That being the case, in the eyes of the average consumer "Dart" is the distinctive and dominant element of the Subject Mark. Moreover, "Dart" is the front part which is what primarily catches one's attention.

The Cited Mark

21. The Cited Mark "**DART**" is likewise a single word mark containing four letters of the English alphabet. It is also expressed in mere plain font and ordinary uniform typeface without any stylization. All four letters of the Cited Mark are presented in the upper case. There are no additional elements. As mentioned above, the word "dart" is dictionary defined. The Cited Mark is not

³ <http://dictionary.reference.com/browse/>

⁴ <http://dictionary.reference.com/browse/>

⁵ A mobile text and voice messaging communication service developed by a company in China, <http://en.wikipedia.org/wiki/WeChat>.

⁶ A free and open-source Internet Relay Chat client, <http://en.wikipedia.org/wiki/WeeChat>.

descriptive of the services its registration covers and is hence inherently distinctive.

Comparison of marks

22. In comparing the marks, I have to take into consideration the Subject Mark and the Cited Mark in normal and fair use in relation to the relevant goods and services, and the overall impression each of the marks would give to the average consumer.

23. A comparison of the marks concerned has to be based on an overall appreciation of their visual, aural and conceptual similarities, taking into account the overall impressions given by the marks, and bearing in mind particularly their distinctive and dominant components. I must consider whether there are similarities between the Subject Mark and the Cited Mark and the respective goods and services covered, and whether they would combine to create a likelihood of confusion.

24. Visually, the Subject Mark and the Cited Mark share the identical initial element “Dart”. Although the element “Dart” in the Subject Mark is presented in the mixed cases whereas in the Cited Mark the upper case, absent any stylization in both marks, from the trade mark perspective such distinction does not have significance in the mind of an average consumer. The difference between the two marks lies in the element “Talk” which is present only in the Subject Mark. However, as discussed earlier, the element “Talk” in the Subject Mark is indistinctive and would thus attract less attention as compared to the frontal element “Dart”. It has indeed been recognized that consumers generally pay more attention to the frontal part of a mark, taking into account the fact that they read from left to right and that the beginning of a word sign is on the left.⁷ Given that the Subject Mark adopts the Cited Mark entirely as its dominant frontal element and allowing for imperfect recollection, I find the two conflicting marks **visually similar**.

⁷ *Citigroup v. OHIM - Link Interchange Network Ltd* (Case T 325/04), at paragraph 82, Court of First Instance of the European Communities (Second Chamber), 27 February 2008.

25. Aurally, the Subject Mark is pronounced with two-syllables whereas the Cited Mark only one. In view of the usual accent on the entirely reproduced dominant element “Dart” when pronouncing the Subject Mark and taking into account that people pay more attention to the first word read, the two marks as wholes, I find them **aurally similar**.

26. Conceptually, as words, both the Subject Mark, when perceived as two conjoined words, and the Cited Mark are dictionary defined (paragraphs 17 and 21 above). To the average consumer the word “dart” common to the two marks carries a non-distinct meaning. On this point, Dr Yang contended that to *professionals in computer software development*, the word “dart” in the Cited Mark would readily bring to mind a computer programming language whereas the same word in the Subject Mark would carry an entirely different meaning unrelated to computer programming. With respect and absent any evidence of any sort in support, I do not find Dr Yang’s argument convincing. Furthermore, judging from the specification of the applied for goods and services, contrary to Dr Yang’s submission, there is nothing to suggest that such goods and services are meant to target at professionals in computer software development only. As the allegedly distinct meaning of the same word “dart” in the two conflicting marks may not be readily apparent to the average consumer, the presence of the common distinctive and dominant element “Dart” / “DART” in the marks may likely imply a connection between them. The Subject Mark and the Cited Mark are thus considered **conceptually similar**.

27. Having regard to the conflicting marks as wholes and their visual, aural and conceptual similarities, I find the two marks **similar**.

Comparison of goods

28. The well-known tests for assessing similarity in goods are found in *British Sugar v Robertson and Sons Ltd* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (supra). The court considered that all relevant factors relating to the goods in question should be taken in account. They include, *inter alia*, their nature, intended purpose, method of

use, whether the goods/services are in competition with each other or are complementary, as well as their users and the channels through which they reach the market.

29. Goods and services are considered identical if they fall within the ambit of the terms within the competing specification.⁸ Goods and services are considered complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods and services lies with the same undertaking.⁹

30. Based on these legal principles, I now compare the applied for goods and services with the services in Classes 38 and 42 under the Cited Mark.¹⁰ From the outset, it is obvious that the two sets of goods and services are commonly related to computers and/or mobile telephones and their use. Furthermore, I find identity, similarity and/or complementarity, as the case may be, between **all** items of the applied for goods and services and certain services under the Cited Mark as below -

Subject Mark	Cited Mark	Comparison of specification
<u>Class 9</u> downloadable computer program; computer application software for mobile phones; computer game program; computer software	<u>Class 42</u> computer programming	The Class 9 goods are the products of the Class 42 service. The conflicting goods and services are <i>closely connected and complementary.</i>
<u>Class 9</u> application software for smartphone; messenger software using network namely, internet and mobile communication network;	<u>Class 38</u> communication by telephone	The Class 38 service in many ways relies on and operates through the Class 9 goods. The conflicting goods and services are <i>closely connected and complementary.</i>

⁸ *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05.*

⁹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-325/06.*

¹⁰ Specification of the Subject Mark and of the Cited Mark is respectively set out in paragraph 2 and paragraph 4 above.

recorded software for messenger; recorded messenger program; downloadable messenger program		
<u>Class 38</u> service for data communication; transmitting messages	<u>Class 38</u> communication by telegram	These services within the same Class fall within the ambit of each other's specification and are therefore <i>identical</i> .
<u>Class 38</u> Service for data communication; transmitting digital files; transmitting messages; providing E-mail services; service for instant transmission of messages; providing internet chatting room; service for electronic data communication; providing electronic telecommunication connections for internet users; service for internet bulletin board; transmitting electronic message; service for electronic mail.	<u>Class 38</u> Communication by computer terminals, communication by telephone, rental/leasing of communication equipment, including telephones/ facsimile machines	All the services under the Subject Mark fall within the ambit of the generic specification "communication by computer terminals" and/or "communication by telephone" within the same class under the Cited Mark . These conflicting services are hence <i>identical</i> . The service "rental/leasing of communication equipment, including telephones" under the Cited Mark could be offered by the same manufacturer and available through the same trade channels as all the services within the same class under the Subject Mark . These conflicting services are therefore <i>closely related and complementary</i> .

31. Given my findings on identity, similarity and/or complementarity above, the applied for goods and services are considered to be *identical or highly similar* to the relevant services under Classes 38 and 42 of the Cited Mark.

32. At the hearing, Dr Yang submitted that the applied for goods and services were mainly communication software/applications for use on *mobile telephones* and that the technology required in the networking via a computer

(allegedly through a *land line*) and that via a mobile telephone (allegedly *in the air*) were starkly different. Accordingly the applied for goods and services and the services of the Cited Mark could not be similar. When asked whether networking through, for example, *Wi-Fi*¹¹ would render the so-called difference common, Dr Yang maintained that a land line would still be required in the setting up of a Wi-Fi connection.

33. While goods and services related to mobile telephones do feature in the subject application, those (equally) related to computers are undoubtedly involved as well, just to name a few “*downloadable computer program; computer game program; computer software;*” under the Class 9 specification and, in fact, all the services within the Class 38 specification are equally accessible on a computer. Furthermore, none of the specification of the applied for goods and services bears any restriction on the means of technical networking, be it via land line, in the air or otherwise. After all, given the trend in technology to unify all manner of computer services, I doubt very much the relevance of such argument by Dr Yang.

34. As such, I fail to see how Dr Yang’s point would help remove the founded identity or high degree of similarity between the applied for goods and services and the relevant services under the Cited Mark, or facilitate the subject application in any way.

Likelihood of confusion

35. Having compared the similarities between the Subject Mark and the Cited Mark and those between the respective goods and services, it remains for me to examine whether there is a likelihood of confusion between the conflicting marks. A likelihood of confusion under section 12(3) of the Ordinance refers to confusion on the part of the public as to the trade origin of the goods and services in question. Given the relevant guiding principles set out in paragraph 12 above, it is a matter of global appreciation and all relevant factors should be taken into

¹¹ A local area wireless computer networking technology that allows electronic devices to network; many devices can use Wi-Fi, e.g. personal computers, video-game consoles, smartphones, digital cameras, tablet computers and digital audio players, <http://en.wikipedia.org/wiki/Wi-Fi>.

account. The matter must be judged through the eyes of the average consumer of the goods and services in issue, who is deemed to be reasonably well-informed and reasonably observant and circumspect. The average consumer seldom has the opportunity to compare marks side by side but relies upon his imperfect recollection of the marks. The perception of the marks in his mind plays a decisive role in the global appreciation of the likelihood of confusion. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa.

36. I also take note that it is not uncommon for manufacturers to use sub-brands to distinguish goods/services between different product lines. The appearance of “Talk” after “Dart” in the Subject Mark may be perceived by the average consumer as denoting a new sub-brand or a subsidiary line in the field of telecommunications under the owner of the Cited Mark.

37. I have found the Subject Mark and the Cited Mark to be similar.¹² I have also found the applied for goods and services to be identical or highly similar to certain services protected by the registration of the Cited Mark.¹³ Given such findings, I come to the view that when the Subject Mark is used in relation to the applied for goods and services, with only his imperfect recollection to rely on, there is a real risk that the average consumer would be confused into believing that the goods and services so provided and services within the relevant specification provided under the Cited Mark come from the same or economically-linked undertakings. Such risk constitutes a likelihood of confusion within the meaning of section 12(3) of the Ordinance.

38. I have duly examined the Applicant’s proposed re-amendment (i.e. deletions) to the specification of the applied for goods and services.¹⁴ Even if the proposed deletions were accepted, the Applicant’s goods and services after the re-amendment would remain related to computers and/or mobile telephones and their use. As such the proposed re-amendment does not assist in advancing the Applicant’s case in any way and is hence rejected.

¹² Paragraphs 24 to 27 hereof.

¹³ Paragraphs 30 to 34 hereof.

¹⁴ Paragraph 6 above and Annex hereto.

CONCLUSION

39. I have carefully considered the subject application together with Dr Yang's submissions made at the hearing. For the reasons given, I find that the Subject Mark in respect of the applied for goods and services is precluded from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Elsie Tse
for Registrar of Trade Marks
5 August 2015

Proposed re-amendment to specification

Class 9

~~Downloadable computer program; computer application software for mobile phones; computer game program; computer software; application software for smartphone; messenger software using network namely, internet and mobile communication network;~~ recorded software for messenger; recorded messenger program; downloadable messenger program.

Class 38

~~Service for data communication; transmitting digital files; transmitting messages; providing E-mail services; service for instant transmission of messages; providing internet chatting room; service for electronic data communication; providing electronic telecommunication connections for internet users; service for internet bulletin board; transmitting electronic message; service for electronic mail~~
messenger.