

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300010862

APPLICANT : SMARTONE MOBILE COMMUNICATIONS LIMITED

CLASSES: 9, 38 & 41

MARK: mobile karaoke

STATEMENT OF REASONS FOR DECISION

Background

1. On 25 April 2003, Smartone Mobile Communications Limited (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark (in series):



(“the subject mark”) in classes 9, 38 and 41. The applicant claims the colours pink and blue as the element of mark “A” in the series.

2. Registration is sought in respect of the following goods and services:

Class 9

apparatus for storing, recording, transmitting and reproducing sounds and/or images; sound and video recordings; players for singing with pre-recorded background music; entertainment apparatus for singing with pre-recorded background music; audio receivers and video receivers, loudspeakers, speaker apparatus, microphones and microphone mixers; stereo headphones; computer programs, software linking digitized video and audio media to a global computer information network; apparatus and instruments for displaying and/or printing out data, information, pictures and/or images; voice mail system; telephone dialling apparatus by vocal synthesizer; answering machine; telephone answering apparatus; automatic

answering apparatus for communications apparatus; computer programs; computer software supplied on the Internet; on-line electronic publications (downloadable from the Internet); scientific, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and teaching apparatus and instruments; apparatus and instruments for recording, receiving, transmitting and/or reproducing data, information, pictures, images, and/or sound; telephones, pagers, mobile phones, facsimile machines; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; video tapes, audio cassettes, compact discs, floppy discs, CD ROMS and DVD ROMS; data processing equipment and computers; computer software for searching of data; cards, wires, discs and semiconductor devices carrying computer programs; telecommunications apparatus, instruments, networks and circuitry; cables, cable installations, optical fibres, optical communication apparatus and circuitry, all for telecommunication purposes; electronic and computer apparatus and instruments for debiting and/or crediting financial accounts and/or for paying for goods or services; machine-readable debit and/or credit and/or charge cards; electronic and computer apparatus, instruments and software for communicating with computer networks and the world-wide web; television, radio, video and audio apparatus, equipment and devices; digital music (downloadable) provided from the Internet; MP3 (Moving Picture Experts Group-1 audio layer 3) players; computer software for event scheduling and for managing, viewing and editing address books and personal and professional contact information; apparatus for coding and decoding signals; and parts and fittings for all the aforesaid goods; all included in Class 9.

Class 38

telecommunication services; provision of telecommunication access and links to computer database and to the Internet; electronic communication services; interactive telecommunications services; telecommunication of information (web pages), computer programs and data; providing telecommunications connections to the Internet or data bases; telecommunication gateway services; computer network communication services; provision of telecommunication access to world-wide web facilities and structures; communication by computer terminals, communication by fibre optic networks, computer aided transmission of messages and images, facsimile transmission, message sending, paging services, rental of modems, data communication services by electronic means; telephone services, telegraph services, telex services; telegraphic-wire services; wire services; satellite communication services; electronic mail services; rental of telecommunication equipment; electronic message sending; receiving and forwarding services; collection, transmission and delivery of data by electronic means; collection, transmission and delivery of mail message, telegrams, information and data by mechanical, electronic messaging,

conferencing and order-transmission services; radio and television communication services; communication services between computers; provision of telecommunication access to signal coding and decoding apparatus; broadcasting and transmission of radio and television programmes; cable television broadcasting; preparation of reports in relation to the foregoing services; provision of telecommunication facilities for interactive discussion and conversation; issuance of telephone card services; providing telecommunication access to digital music websites on the Internet; providing telecommunication access to MP3 (Moving Picture Experts Group-1 audio layer 3) web sites on the Internet; delivery of digital music by telecommunications; operating search engines; computerized consultation of telephone directories information; consultancy, information and advisory services in relation to the aforesaid services; all included in Class 38.

Class 41

musical entertainment services; rental of sound recordings; television and radio entertainment services; entertainment involving electronic and digital interactive media; entertainment services relating to provision of sound, images, digital music, movies, audio-visual works, visual works, audio works and video from the internet, a computer database or communication networks; arranging, organizing, hosting and conducting events and competitions for entertainment purposes; arranging, organizing, hosting and conducting singing competitions; online electronic publication of lyrics, song sheets, statements, news, leaflets, magazines and books; provision of digital music (not downloadable); club services relating to entertainment; electronic games services provided by means of the Internet; entertainment ticket agency services; operating chat rooms; entertainment services; education, training and instruction services relating to telecommunications, computers, computer programs, web site design, e-commerce, business management and advertising; information, advisory and consultancy services relating to the aforementioned services; all included in Class 41.

3. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance on the basis that the subject mark consists exclusively of a sign which may serve, in trade or business, to designate the characteristics of the applied-for goods and services, and is devoid of any distinctive character.
4. Objection was also raised under section 12(3) of the Ordinance in respect of the following registered trade mark:

Trade mark : **KARAOKE**
Registration no. : 19832084

Class no. : 9
Goods : 8-track tape players and cassette recorders, with microphone and guitar mixing
Owner : Matsushita Denki Sangyo Kabushiki Kaisha (Matsushita Electric Industrial Co. Ltd.)
Date of registration : 24 February, 1983

5. On 30 March 2005, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 5 July 2005 at which Mr Andrew Chan of Messrs So Keung Yip & Sin appeared on behalf of the applicant. I reserved my decision at the conclusion of the hearing.
6. The applicant did not file any evidence of use of the subject mark. I therefore have only the prima facie case to consider.

The Trade Marks Ordinance

7. Section 11(1) of the Ordinance is 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) ...”

8. Section 12(3) of the Ordinance provides that:

“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.”

Decision

Section 12(3) of the Ordinance

9. Having considered the applicant’s submissions, I am satisfied that use of the subject mark in relation to the applied-for goods and services is not likely to cause confusion on the part of the public within the terms of section 12(3)(c) of the Ordinance. Accordingly, the objection under section 12(3) of the Ordinance is hereby waived.

Section 11(1)(c) of the Ordinance

10. Section 11(1)(c) of the Ordinance precludes from registration marks consisting 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 good or rendering of services, or other characteristics of the goods or services in respect of which registration is sought.
11. In the subject application, the goods specified in class 9 cover a wide range of audio, video and communication apparatus including “apparatus for storing, recording, transmitting and reproducing sounds and/or images”, “players for singing with pre-recorded background music”, and “mobile phones”, etc. For the services specified in classes 38 and 41, they respectively encompass a wide range of telecommunication and entertainment services, such as “interactive telecommunication services” and “transmission and delivery of data by electronic means”, etc in class 38, and “musical entertainment services” and “entertainment involving electronic and digital interactive media”, etc in class 41.
12. The subject mark consists of the words “mobile karaoke”, with the diagonal strokes of the first “k” in the word “karaoke” replaced by a mobile phone device, and the upper diagonal stroke of the second “k” replaced by a microphone device.
13. According to Cambridge Advanced Learner’s Dictionary, the word “mobile” means “able to move freely or easily moved”. The dictionary also defines “mobile (phone)” as a telephone which is connected to the telephone system by radio, rather than by a

wire, and can therefore be used anywhere where its signals can be received. For the word “karaoke”, it is defined as “a form of entertainment, originally from Japan, in which recordings of the music but not the words of popular songs are played, so that people can sing the words themselves”.

14. With the above meanings, I consider that the words “mobile karaoke”, when used in relation to the applied-for goods and services, will directly tell customers that the goods and services allow or facilitate them to enjoy karaoke anytime and anywhere.
15. At the examination stage, the applicant has been referred to a number of websites, which show that the words “mobile karaoke” are used by traders other than the applicant to describe a technology which allows mobile phone users to download songs with synchronized lyrics to their mobile phones, so that they can enjoy karaoke anytime and anywhere. The websites therefore confirm the descriptive message conveyed by the words “mobile karaoke” as pointed out above.
16. At the hearing, Mr Chan, in reliance of “*Cycling IS...*” *Trade Mark Applications* [2002] R.P.C. 37 and *AD2000 Trade Mark* [1997] R.P.C. 168, submitted that to be objectionable under section 11(1)(c), the mark must consist *exclusively* of matters descriptive of the goods and services in question. It is Mr Chan’s submission that the subject mark does not merely consist of the words “mobile karaoke”, but contain the mobile phone and microphone devices as well. He submits that the devices are incorporated in the words “mobile karaoke” in a fanciful and stylised manner and will not be regarded by consumers as descriptive elements. He further relies on *Proctor & Gamble Co. v OHIM* (Case C-383/99P) (European Court of Justice) (“the *BABY-DRY* case”), and submits that the subject mark is not objectionable under section 11(1)(c) because it is presented in a manner that distinguishes the resultant whole from the *usual way* of designating the goods or services concerned or their essential characteristics.
17. I agree with Mr Chan that to be objectionable under section 11(1)(c), the mark in question must consist *exclusively* of signs which may serve, in trade or business, to designate the kind, quality, ..., or other characteristics of the applied-for goods and services. However, despite it is incorporated in the word “karaoke” of the subject mark the mobile phone and microphone devices, the devices merely reinforce the descriptive message conveyed by the words “mobile karaoke” and tell customers that they can have karaoke anytime and anywhere with their mobile phones. As a result, I consider that the devices are descriptive of the goods and services as well, and that the subject mark, as a whole, conveys to customers the direct and

immediate message that the applied-for goods and services allow or facilitate them to enjoy karaoke anytime and anywhere with their mobile phones.

18. I have also considered the *BABY-DRY* case referred by Mr Chan, but subsequent to that decision, the European Court of Justice clarified the approach to Article 7(1)(c) of the Council Regulation on the Community Trade Mark 40/94 (equivalent to section 11(1)(c) of the Ordinance) in a number of cases, including *Wm. Wrigley Jr. Company v OHIM* (Case-191/01 P) (“the *DOUBLEMINT* case”). At paragraph 32 of the *DOUBLEMINT* case, it is stated that:

“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 provisions 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.”

19. Accordingly, marks objectionable under Article 7(1)(c) of the Council Regulation do not have to be the *usual way* of describing the goods or services in question, and it is sufficient if the mark could be used to the describe their characteristics.
20. In view of my above finding that the subject mark, as a whole, directly tells customers that the applied-for goods and services allow or facilitate them to enjoy karaoke anytime and anywhere with mobile phones, I find that the subject mark could be used to designate the kind, intended purpose and the characteristics of the applied-for goods and services, and is accordingly objectionable under section 11(1)(c) of the Ordinance.
21. I turn to consider whether the subject mark is objectionable under section 11(1)(b) of the Ordinance, which operates as a separate and independent ground of objection under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

22. Section 11(1)(b) of the Ordinance precludes from registration signs which are devoid of any distinctive character.

23. Mr Chan refers me to *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 and “*Cycling IS...*” *Trade Mark Applications* [2002] R.P.C. 37, in which the approach in assessing distinctiveness was discussed.

24. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 at page 306, Mr Justice Jacob said:

“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?”

25. In “*Cycling IS...*” *Trade Mark Applications* [2002] R.P.C. 37, it was stated, at paragraph 53, that:

“It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings.”

26. I refer further to *Nestle SA’s Trade Mark Application (Have a Break)* [2004] F.S.R. 2, which states, at paragraph 23, that:

“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.”

27. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must be capable of identifying the goods and services in question as originating from a single undertaking, and thus distinguishing them from those of other undertakings. I must assess the mark's distinctiveness in relation to the goods and services for which registration is sought taking into account the presumed perception of the relevant consumers.
28. In the subject application, the relevant consumers of the applied-for video, audio and communication apparatus, as well as the telecommunication and entertainment services comprise the members of the general public.
29. At the hearing, Mr Chan, relying on *Diamond T. Motor Car Company's Application* (1921) 38 R.P.C. 373, submitted that in assessing the distinctiveness of a mark, it must be considered as a whole rather than be dissected. Mr Chan considers the subject mark to be distinctive because the mobile phone and the microphone devices in the subject mark are incorporated in the word "karaoke" in a stylised manner, and that customers are likely to realise the subject mark to be carefully designed and will therefore regard it as a badge of trade origin of the applied-for goods and services.
30. I agree with Mr Chan that in assessing the distinctiveness of a mark, it must be considered in its entirety rather than be dissected. Additionally, since the average consumer normally perceives a mark as a whole and does not proceed to analyse it in various details, it is the overall impression given by the mark which must be considered. However, as explained in paragraph 17 above, I consider that when customers see the subject mark used in relation to the applied-for goods and services, it will convey to them the direct and immediate message that the goods or services allow or facilitate them to enjoy karaoke anytime and anywhere with their mobile phones. As such, I consider that customers' overall impression on the subject mark will be that it is a descriptive designation, telling them the kind, intended purpose and characteristics of the applied-for goods and services, rather than as what Mr Chan has submitted, a badge of the trade origin, which identifies the applied-for goods and services as originating from a single undertaking.
31. There is Mr Chan's submission that the subject mark is carefully designed and that the mobile phone and microphone devices are incorporated in the subject mark in a stylised manner. I also note that the applicant has made a colour claim for the colours pink and blue for mark "A" in the series. Whilst I admit that there is some stylisation in the way that the subject mark is presented, it does not necessarily follow that customers will perceive the subject mark as a badge of trade origin.

Consumers nowadays are accustomed to seeing colourful and stylised product or service descriptions appeared in product packaging, as well as advertising and promotional literature, etc. As stated by Mr Justice Jacob at page 300 of *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281:

“I am, of course, aware that the words “Toffee Treat” are written in a fancy way. But then so are many other mere descriptors. One only has to look at how British Sugar write such words as “meringue mix” or “golden syrup” to see parallel sorts of use. I do not think this affects the matter one way or the other.”

32. In assessing whether the subject mark possesses distinctiveness, the question for me is whether the subject mark is sufficiently embellished to outweigh its descriptive connotation, so that customers will perceive it as a badge of trade origin which identifies the applied-for goods and services as originating from a single undertaking, as opposed to a mere description of the goods and services.
33. Taking into account the direct and immediate descriptive message conveyed by the subject mark as explained, along with my finding that the mobile phone and microphones devices incorporated in the word “karaoke” merely reinforce the descriptive message conveyed by the subject mark, I do not consider that the stylisation in the subject mark is sufficient to outweigh its descriptive connotation, and to imbue itself with trade mark significance. Instead, I maintain that when used in relation to the applied-for goods and services, customer will immediately perceive the subject mark as a descriptive designation, telling them that the goods and services allow or facilitate them to enjoy karaoke with their mobile phones anytime and anywhere. Without first being educated that it is a trade mark, I consider it unlikely that customers will perceive the subject mark as a badge of trade origin which identifies the applied-for goods and services as originating from a single undertaking, and thus distinguishing them from those of the other undertakings.
34. On the above basis, I conclude that the subject mark is devoid of any distinctive character, and is excluded from registration under section 11(1)(b) of the Ordinance.

Internet reference and reference to other registered marks

35. At the hearing, Mr Chan drew my attention to a number of registered marks which also contain the word “MOBILE”. I have reviewed those registered marks but do not consider them to be on par with the subject mark as their references to the

characteristics of goods or services registered are less direct. In any case, it is well-established that each case must be considered on its own merits and comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration (*British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 305). The registered marks referred to by Mr Chan cannot accordingly assist the applicant in the subject application.

36. In reliance of the Practice Amendment Circular PAC 11/00 issued by the Trade Marks Registry of the UK Patent Office, which sets out the U.K. Trade Marks Registry's practice concerning use of Internet reference to support objections taken under section 3 of the Trade Marks Act 1994 (equivalent to section 11 of the Ordinance), Mr Chan also questions the justification of conducting Internet search to support the objections raised against the subject application. Mr Chan further submits that since all websites referred to by examiners are either undated, or have a date later than the application date of the subject application, it is not appropriate to raise objections against the subject application based on those websites.
37. I note the UK Registry's practice on the use of Internet references and Mr Chan's challenge to conducting Internet searches in the subject application, but the Registrar's practice is set out in the chapter on "Search" of the Trade Marks Registry Work Manual, which provides that the Registrar will conduct Internet searches in considering objections to an application for registration.
38. Additionally, I do not consider websites dated after the date of the subject application to be totally irrelevant. As explained in paragraphs 18 to 19 above, to be objectionable under section 11(1)(c), it is not necessary for the mark to be actually in descriptive use on the date of the application, and it is sufficient if the mark could be used for such a purpose. In my view, the websites, despite dated after the application date of the subject application, is relevant as they confirm the objection that the words "mobile karaoke" could be used to designate the kind, intended purpose, and the characteristics of the goods and services applied for in the subject application.
39. In any case, contrary to what Mr Chan has submitted, the section 11(1)(b) and 11(1)(c) objections raised against the subject application are based on the meaning and message conveyed by the subject mark as a whole rather than the findings on the websites, which only serve to support the objections raised. As I have found the subject mark to be objectionable under sections 11(1)(b) and 11(1)(b) of the Ordinance based on the meaning and message conveyed by the subject mark as a

whole, Mr Chan's submissions in relation to the Internet reference cannot assist the applicant either.

The offer to add the applicant's mark “卡拉手 K & device” to the subject mark

40. At the examination stage, the applicant, with a view to overcoming the objections raised, has offered to amend the subject mark by adding its registered trade mark “卡拉手 K & device” (trade mark no. 300010871) to the subject mark. Mr Chan invited me to reconsider this offer at the hearing.
41. I note the applicant's offer above. However, as pointed out at the examination stage and at the hearing, section 46(2)(c) of the Ordinance provides that an amendment to add the representation of a registered trade mark can only be allowed if the date of registration of the registered trade mark is *earlier than* the date of the application of the trade mark in question. Since the date of registration of the applicant's “卡拉手 K & device” mark and the application date of the subject application are the same: both are 25 April 2003, the applicant's request for amendment cannot be acceded to, and its offer can neither assist in overcoming the objections raised.

Conclusion

42. In this decision I have carefully considered all documents filed and submissions made by the applicant. Despite the objection under section 12(3) of the Ordinance has been waived, for the reasons given above, the subject mark is precluded from registration by sections 11(1)(b) and (c) of the Ordinance, and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Simon Chan
for Registrar of Trade Marks
30 September 2005