

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300139905

MARK: "sms smartmail"

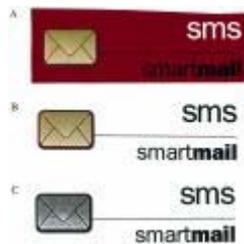
CLASS: 38

APPLICANT: SMARTONE MOBILE COMMUNICATIONS LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 January 2005, 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 Class 38.
2. The applicant claims the colours brown, yellow, black and white as elements of the mark "A" in the series. The applicant also claims the colours yellow, black and white as elements of mark "B" in the series.
 3. The specification of services are: 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 fiber 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.

4. At the examination stage, objection was raised against the application under section 11(1)(b) of the Ordinance as the mark only describes the nature and characteristics of the services applied-for and is devoid of any distinctive character.
5. The applicant requested a registrability hearing which took place before me on 24 May 2005. The applicant was represented by Mr. Andrew Chan of Messrs. So, Keung, Yip & Sin. I reserved my decision at the end of the hearing.
6. The applicant did not file any evidence of use of the mark. I therefore have only the *prima facie* case to consider.

The law

7. The relevant part of the Ordinance under which the objection was taken is as follows:

Section 11(1):

“Subject to subsection (2), the following shall not be registered-

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");
- (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) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.”

The applicant's submissions

8. Mr. Chan's main submissions are summarised as follows:
 - (a) The applicant does not dispute that the words "smart" and "mail" by themselves may be meaningful, when the words are used collectively, the combination "smartmail" does not convey any idea relating to telecommunication services.
 - (b) Ordinary members of the public will not use the word "smart" to describe a "mail".
 - (c) In relation to the Registrar's objection that the "smartmail" mark conveys the

idea that the applicant's mail services are quick and clever, the Registrar's objection at most applies to combinations like "Smart Transmitter", "Smart Receiver" etc.

- (d) In assessing the distinctiveness of a mark that combines a number of elements, the mark must be regarded as a whole. It is immaterial to consider whether any of the mark's component parts are registrable by themselves (*Diamond T. Motor Car Co.'s Appn* (1921) 38 R.P.C. 373 (Ch.D.)).
- (e) Mr. Chan quoted the trade marks "wed connection Winning Solutions in the Digital Economy 城網聯繫" (Reg.No.2002B13651), "CORPORATECONNECTIONS" (Reg.No.2000B10834), "Global Crossing & Device" (Reg.No.2000B01623), "FIRST PHONE" (Reg.No.2000B13884), "WEB DEVELOPER" (Reg.No. 2000B07622) on the register, which were registered on a prima facie basis. He submitted that the quoted marks are all combination marks which include non-distinctive and/or descriptive elements but have been accepted for registration. He therefore submitted that the said marks are no more distinctive than the subject mark.
- (f) The Registrar should not rely on the internet searches referred to in the examination stage as they are overseas websites and there is no indication that the mark is used by someone else other than the applicant in Hong Kong. Mr. Chan also drew reference to Chapter 6 of the U.K. Trade Marks Registry Work Manual in relation to the use of the Internet and urged us to adopt a similar approach as in the U.K. Trade Marks Registry.

Decision

- 9. The mark (in series) consist of an envelope on the left, the words "sms" on the top right corner, a line in the middle and the word "smartmail" (with the word "mail" in bold print) appearing below the letters "sms".
- 10. The letters "sms" stand for short message service (cellular phone text messaging).¹ According to Wikipedia², "Short message service (SMS) is a service available on most digital mobile phones that permits the sending of short messages between mobile phone, other handheld device and even landline telephones". The term is commonly used in the telecommunication industry in particular mobile phones and electronic mail services.
- 11. In the context of the telecommunications industry such as mobile phones and e-mail services on the Internet, the device of the envelope is indicative and descriptive of sms and e-mail services. In some mobile phones, the envelope device indicates that a short message or sms has been received. In the subject mark, the envelope merely describes the nature of the services provided by the applicant namely sms and mail services.

¹ www.acronymfinder.com

² http://en.wikipedia.org/wiki/Short_message_service

12. The word "smartmail" is indistinguishable from "smart mail". The representation of the word "mail" in bold print highlights the combination of two different words conjoined together. These two words are ordinary words with dictionary meanings. According to Collins English Dictionary³, the word "smart" means "clever or bright" and in particular, "(of systems) operating as if by human intelligence by using automatic computer control".
13. During the examination stage, objection was raised as the mark indicates that the applicant provides smart mail services and short message service (sms) and describes the nature and characteristics of the services applied for registration. The mark was found to be devoid of any distinctive character. Searches were conducted on the Internet on the usage of "sms" and the combination "smart mail" in the telecommunication field. The Internet searches indicate that the letters "sms" and the combination "smart mail" are commonly used in the telecommunication field.
14. To my mind, the term "smart mail" indicates that the applicant's mail services are clever or have artificial intelligence. I am of the view that "smart mail" conveys the message that the mail services provided by the applicant have artificial intelligence and are capable of performing automated functions for example spell checks, auto reply or prioritise incoming messages according to the date or size of the message etc. All these functions are feasible and the Internet searches referred to in the examination stage support this view.

Section 11(1)(b) of the Ordinance

15. Section 11(1)(b) of the Ordinance excludes from registration marks which are devoid of any distinctive character.
16. The approach of assessing distinctiveness was discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] F.S.R. 2 (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.”

17. It is well established that in assessing a mark, the mark must be considered in its entirety in relation to the goods and services sought for registration. I must assess the mark's distinctiveness in relation to the goods and services for which the applicant seeks registration taking into account the perception of the relevant consumer.
18. The services applied for registration cover a wide range of services in the telecommunication sector and is likely to be patronised by a wide section of the public ranging from the trade to the general public.

³ Third Edition Updated 1994

19. The meanings of each of the components have been explained above. In my view, each of the components in the mark are descriptive of the nature and type of services provided by the applicant. When the components are considered as a whole, they convey the message that the applicant provides sms and mail services that have artificial intelligence and are capable of performing automated functions.
20. I must of course also consider the way the mark is presented, the colour elements and whether the combination of the various components as a whole result in a distinctive trade mark.
21. I do not find anything unusual about the way the components are arranged. There is nothing striking or novel in the way the envelope is presented. The words "sms" and "smartmail" are written in plain font without any stylization and the line in between the two words does not add any trade mark significance to the mark as a whole. The envelope and the words "sms" and "smart mail" convey the message that the applicant provides both sms and mail services with artificial intelligence. I find from this that the combination is equally applicable as a description of similar services of other undertakings.
22. As regards the colours contained in mark "A" and "B", I do not find anything particularly distinctive about the colours or about the way they are presented. Advertisements in promotional materials are usually in colour. It is unlikely that the relevant consumer would consider the colours as having trade mark significance. The colours brown, yellow, black and white are no more distinctive than any other colour and do not add any distinctiveness to the mark.
23. To my mind, the mere conjoining of the components and the way the mark is represented does not create a fanciful combination nor does it overcome the descriptive meaning of each of the components. When considered in its entirety, the combination does not create an impression of a distinctive trade mark.
24. Without being first educated that the subject mark is intended and used as a badge of origin, the relevant consumer is likely to perceive the subject mark as a description of the short message or mail communication services provided by the applicant and that the said services have artificial intelligence that are capable of performing additional automated features and not as a badge of origin.
25. As the mark is equally applicable as a description of similar services by other undertakings, it would not enable the relevant consumer to distinguish the applicant's services from other similar services.
26. Based on the reasons stated above, I am of the view that the relevant consumer is unlikely to perceive the subject mark as an indication of the trade origin of the applied for services, and it is therefore devoid of any distinctive character. The subject mark is thus debarred from registration under section 11(1)(b) of the Ordinance.
27. Mr. Chan referred me to other marks containing descriptive elements that have been accepted for registration. All the mark quoted by Mr. Chan were registered under the

old Trade Marks Ordinance (Cap.43, now repealed) with disclaimer conditions in respect of different types of services. I have considered the quoted marks and I find that the subject mark is more descriptive and less distinctive than the quoted marks. Furthermore, it has been established by case law that each case must be considered on its own merits and other marks on the register is in principle irrelevant when considering a particular mark for registration (*British Sugar Plc v James Robertson & Sons Ltd.* [1996] RPC 281). Hence, I find that the acceptances of the quoted marks do not assist the subject application.

28. Turning to the use of Internet references, Mr. Chan urged me not to rely on the websites referred to in the examination stage. In my view, the Internet references quoted at the examination stage confirm the examiner's objection that the various components of the mark are commonly used in a descriptive sense in the telecommunication field. The Internet references also support my finding in relation to "smart mail" as stated in paragraph 14. I therefore consider that the Internet references are relevant to the subject application.

Conclusion

29. In this decision I have considered all the documents filed by the applicant and the arguments submitted by the applicant in relation to the application. For the reasons stated above, I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.

Theresa S.Y. Mak
for the Registrar of Trade Marks
21 June 2005