

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300166662

MARK: *131* PhoneHome

CLASS: 38

APPLICANT: SMARTONE MOBILE COMMUNICATIONS LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 27 February 2004, 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 colour red as an element of the marks "A" and "B" in the series.
3. The services for which registration is sought 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 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.

4. At the examination stage, objection was taken to the application under section 11(1)(b) of the Ordinance as the mark merely conveys the message that customers can phone home through the access code *131* and is devoid of any distinctive character.
5. The applicant requested a registrability hearing which took place before me on 15 June 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 only have the *prima facie* case to consider.

Section 11(1)(b) of the Trade Marks Ordinance

7. At the examination stage, objection to registration was raised under section 11(1)(b) of the Trade Marks Ordinance which states:

Section 11(1):

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

.....

(b) trade marks which are devoid of any distinctive character”

The test for section 11(1)(b)

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

"What does devoid of 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?"

9. In “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37, Mr. Geoffrey Hobbs as the Appointed Person, stated that the test of registrability under section 11(1)(b) resides in the question "whether the perceptions and recollections that the sign in issue would trigger in the mind of the average consumer of the specified goods or services are likely to be origin-specific or origin-neutral".
10. The approach to assessing distinctiveness was further 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.”

Decision

11. The subject mark (in series) comprises the asterisks and numerals "*131*", followed by the term "PhoneHome", and they are all circumscribed in a dialogue box. In the first mark of the series, all the letters, numerals, word and the dialogue box are shown in red with a white rectangular background. In the second mark of the series, all the said elements are shown in white with a red background. Lastly, in the third mark of the series all the elements are simply shown in black with a white rectangular background. The applicant claims the colour red as an element of the first two marks in the series.
12. It has been well established that a mark must be considered as a whole before deciding whether it is devoid of any distinctive character. In so doing I must consider whether the combination of the words, numerals, device of the dialogue box and colour element, as represented in the subject mark would give it distinctive character in respect of the specified services.
13. Applying the test for section 11(1)(b) of the Ordinance, I also need to consider the distinctiveness of the mark by reference to the goods and services in respect of which registration is sought and by reference to the presumed perception of the relevant consumer.
14. The services for which registration is applied cover a wide range of services in and related to the telecommunication and communication fields and are likely to be patronised by the public in general. I consider that the relevant consumer in relation to the applied-for services is the general public.
15. Turning first to "*131*", my view of "*131*" is that it appears to be an access code when making an international call or the initial numbers to dial or input to gain access to certain services. This is particularly so when "*131*" is seen in relation to the services sought for registration which include telecommunication services, telephone services, facsimile transmission, telegraph services, issuance of telephone card services etc.
16. Mr. Chan submitted that even though "*131*" could be interpreted as a telephone number, every telephone number is unique and no other party would be able to use the same number. While this may be true, this does not mean that the relevant consumer would regard "*131*" as a trade mark particularly in the telecommunication field.
17. I find that "*131*" is not distinctive in the context of the specified services and is not registrable without evidence of acquired distinctiveness. It is likely that the relevant

consumer would merely perceive it as an access code rather than as a badge of trade origin.

18. The combination "PhoneHome" is indistinguishable from 'Phone Home'. It is another way of saying 'to make a telephone call home' or 'to call home'. Mr. Chan submitted that although the individual elements 'Phone' and 'Home' by themselves may be meaningful, when they are used collectively, the combination does not convey any idea in relation to telecommunication services and has a fanciful meaning when applied to the same.
19. I do not agree with Mr. Chan's submission in relation to the combination "Phone Home". The meaning of the two words is obvious and the conjoining of the two words simply means 'to call home' and is indistinctive in relation to telecommunication and communication services. During the examination stage, the examiner quoted various websites indicating that "Phone Home" is used widely in the telecommunication field. This demonstrates that "Phone Home" is indistinctive in relation to the specified services.
20. I consider that the combination "*131*PhoneHome" is the most prominent feature of the subject mark and it merely conveys the message that consumers can phone home from overseas by dialling the access code "*131*". The rectangular dialogue box circumscribing "*131*PhoneHome" simply reinforces the message of communication services and is indistinctive for the said services. The dialogue box does not add distinctiveness to the subject mark.
21. For the first two marks of the series, the applicant has made a colour claim for the colour red. I do not think this affects the matter one way or the other, nor do I find the colour red any more distinctive than any other colour. The mark is likely to appear in advertisements, promotional materials and leaflets which are usually in colour. The fact that the colour red has been used in the first two marks does not add any distinctiveness to the mark.
22. When the subject mark is considered in its totality in respect of the specified services, I find that the combination of the various elements of the subject mark and the presentation of the subject mark do not create a fanciful or striking combination in respect of the services sought for registration, nor do they outweigh the meaning conveyed by "*131*PhoneHome" as stated above. It is unlikely that the relevant consumer would perceive the subject mark as an indication of trade origin.
23. In the context of the applied-for services, the relevant consumer would merely perceive the mark as a description of telecommunication services which support customers to phone back home from overseas by dialling "*131*" and not as an indicator of trade origin. Unless the public has been educated by use of the mark as a trade mark, it is unlikely that the public would attach trade mark significance to the subject mark. Applying the test in *Cycling IS.*, the perceptions and recollections that the sign would trigger in the mind of the average consumer of the specified services would be origin neutral rather than origin specific.
24. For the reasons stated above, I conclude that the relevant consumer is unlikely to perceive the subject mark as a badge of trade origin and it is therefore devoid of any

distinctive character. The subject mark is debarred from registration under section 11(1)(b) of the Ordinance.

25. At the hearing, Mr. Chan referred me to other combination marks containing indistinctive and/or descriptive elements that have been accepted for registration. All the marks 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, some of them having prominent and distinctive devices and I find that the subject mark is not comparable with 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.

Conclusion

26. In this decision I have considered all the documents filed by the applicant and the arguments submitted 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 Registrar of Trade Marks
3 August 2005