

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300380114

^A 

MARK

: ^B 

APPLICANT

: ADVANCE MAGAZINE PUBLISHERS INC.

CLASSES

: 38, 42

STATEMENT OF REASONS FOR DECISION

Background

1. On 4th March 2005, Advance Magazine Publishers Inc. (“the Applicant”) of New York, United States of America applied, pursuant to the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register a series of two marks shown below (“the subject marks”):-

A 

B 

2. Registration of the subject marks in series is sought in respect of the following services in Classes 38 and 42:-

Class 38

Transmission of messages via access to an interactive global computer network.

Class 42

Providing access to information via a global computer network.

3. Objections were raised under sections 11(1)(b) and 11(1)(c) of the Ordinance. The Applicant requested a registrability hearing which was scheduled to take place on 31st July 2006. Despite having filed a notice of intention to attend, neither the Applicant nor its agent, Messrs. Vivien Chan & Co., appeared at

the hearing.

4. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

The Ordinance

5. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. The relevant provisions under section 11(1) read 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) ...”

Decision

Section 11(1)(b) of the Ordinance

6. Each of the subject marks consists of the word “WIRED”. In A of the series, the letters “W”, “R” and “D” are each set against a square shaded background (“Mark A”). In B of the series, the word “WIRED” and contrasting squares behind the letters “W”, “R” and “D” are all set against a shaded rectangular background.
7. The word “wired” carries the meanings of “making use of computers and information technology to transfer or receive information”¹ and “having access to the Internet”².

¹ Compact Oxford English Dictionary of Current English, Oxford University Press, Third Edition, 2005

² Microsoft Computer Dictionary, Microsoft Press, Fourth Edition

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

“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?”

9. Section 11(1)(b) of the Ordinance is broadly similar to Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (“the Directive”). In respect of the interpretation of Article 3(1)(b) of the Directive, the European Court of Justice stated in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch.1 at 11, paragraph 34:-

“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect.”

10. In view of the above legal principles, distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it for the purposes of section 11(2), must be capable of identifying the product or service as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. The distinctiveness of the subject mark must be assessed by reference to the services for which registration is sought and the perception of the relevant consumers, who are presumed to be reasonably well informed, observant and circumspect.
11. The services applied-for are essentially the transmission of and providing access to information through the Internet. The relevant consumers are the members of the general public in Hong Kong who use computers and who wish to access the Internet. When used in respect of the applied-for services, the subject marks would likely be perceived by the relevant consumers as referring to the provision of access to the Internet via which information can be transmitted.

12. Additionally, in the field of information technology, the term “wired” is commonly used to refer to a computer network connected to the Internet. “Wired” can be and is used in a purely descriptive sense by other traders to promote their services of a similar nature to the applied for services.
13. I am not persuaded by the argument of the Applicant’s agent that the shaded squares in A and B of the series and the rectangle in B of the series are artistic, creative and therefore distinctive. To my mind, the shaded squares and rectangle would be perceived merely as the background of or highlighting the word “WIRED”. They do not carry a distinctive character *per se* and do not contribute distinctiveness to each of the subject marks as a whole.
14. Section 51 of the Ordinance provides that marks may be registered as a series of trade marks if they resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark. In the present application, the only difference between A and B in the series is in the rectangular background which is clearly non-distinctive; a fact that is necessarily conceded by the Applicant by applying for registration of the marks in series.
15. I am not convinced that the combination of the word “wired” and the shaded background in squares (and the rectangle in B of the series) gives distinctive character to each of the subject marks as a whole.
16. I consider that the subject marks fail to perform the essential function of the trade mark, which is to guarantee the identity of the origin of the marked services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the service from others which have another origin.
17. For the reasons stated above, I find that each of the subject marks is devoid of distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Section 11(1)(c) of the Ordinance

18. As I have found that the subject marks are devoid of any distinctive character, registration of the subject must be refused and it is unnecessary for me to consider the other grounds for refusal under section 11 of the Ordinance.

However, for completeness, I shall now consider whether each of the subject marks consists exclusively of signs that may serve to designate the characteristics of the services under section 11(1)(c) of the Ordinance. The objection under section 11(1)(c) of the Ordinance operates as a ground for refusal separate and independent from that under section 11(1)(b).

19. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve, in trade or business, to designate the kind, intended purpose, or other characteristics of the services in respect of which registration is sought.
20. The Applicant's agent argues that "wired" can be taken to mean "to bind, connect or attach with wire or wires" and "to equip with a system of electrical wires", which have no direct reference to the applied-for services, and therefore the registration of the subject marks should not be objected to under section 11(1)(c) of the Ordinance.
21. Where the elements of a mark have more than one way of interpretation, the European Court of Justice stated in *OHIM v WM Wrigley JR Company* (the "DOUBLEMINT" case) [2004] R.P.C. 18 that:-

"it is not necessary that the signs and indications composing the mark ... 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."
22. It is plain from the use of the words "may serve" in section 11(1)(c) of the Ordinance and the decision in the DOUBLEMINT case that a sign is precluded from registration if *at least one* of its possible meanings designates a characteristic of the applied for goods or services. So long as at least one of the meanings serves to describe the services in question, a sign that has more than one meaning does not escape the application of section 11(1)(c).

23. In the present application, although the word “wired” may have different connotations, when used in respect of the transmission of messages via access to an interactive global computer network in Classes 38, the subject marks clearly describe that the transmission of messages is by way of computer and information technology. The subject marks, which indicate having access to the Internet, directly designate the characteristic of providing access to information via a global computer network in Class 42.
24. As explained above, the shaded squares (and the rectangle as well in B of the series) will be perceived by the relevant consumers as the background only. They accentuate the word “wired” which describes the characteristic of the applied-for services. Each of the subject marks is considered to consist exclusively of a sign that serves to designate the kind and characteristics of the applied for services. The registration of the subject marks is therefore precluded under section 11(1)(c) of the Ordinance.

Other registered marks on the register and foreign registrations

25. The Applicant’s agent points out that the word mark “WIRED” has been registered in Classes 9 and 16 on a *prima facie* basis in Hong Kong. The registrations in Classes 9 and 16 show that the subject marks are inherently registrable. I have considered the registrations in Classes 9 (registration no. 200214581) and 16 (registration no. 199908913). The word mark is registered in respect of:-

Class 9

pre-recorded optical discs, audio discs, video discs, films, CD-ROMs, digital and analogue audio tapes and video tapes in the fields of economics, politics, business, entertainment and technology.

Class 16

magazines, books, newspapers, periodicals and printed materials.

The goods covered by the registration of the word mark “WIRED” have nothing to do with wires, Internet or access to the Internet. The word mark therefore has a distinctive character and is not comparable to the subject marks

26. The Applicant's agent also refers to a number of marks that have been registered by the Registrar on a *prima facie* basis. In registration nos. 300021662AB and 300094004, the registered marks consist of squares. The agent argues that these registrations show that the simple shape of a square is distinctive and inherently registrable. I have reviewed the registrations quoted by the agent but I consider that the quoted examples are not on par with the present application. In 300021662AB, the squares are arranged in a manner which would be perceived by the relevant consumers as a badge of origin rather than as mere background as the shaded squares and rectangle in the subject application. In 300094004, the squares and other word elements are arranged in a manner that is distinctive. The agent also refers to other registered marks which I consider to be distinctive when used in respect of the relevant goods and services. In any event, I do not think that it is appropriate to make direct comparison between different marks on the register. Each case must be considered on its own merits. This issue has been discussed in *British Sugar Plc* (supra):-

“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, e.g. *MADAME Trade Mark* ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

27. There are valid grounds for refusal and I am not convinced that the registrations of other marks in Hong Kong are of any assistance to the Applicant in overcoming the objections.

28. The Applicant's agent seeks support from the registration of the word mark “WIRED” in Australia to establish that the subject marks are registrable. We note that, however, the Australian registration is in respect of services in Class 38 but not in Class 42. Besides, the Class 38 registration is in respect of telecommunications services which are different from the applied-for services in the subject application. It must be noted that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here, where there are valid grounds for refusal under the Ordinance. Despite the foreign registration of the word mark “WIRED”, I am not convinced that the subject marks should be accepted for registration in light of the reasons for the objections stated above.

Conclusion

29. I have considered all the documents filed by the Applicant and its agent in relation to this application. For the reasons stated above, I find that each of the subject marks is precluded from registration under sections 11(1)(b) and 11(1)(c) of the Ordinance. I therefore refuse this application under section 42(4)(b) of the Ordinance.

Margaret K.W. YU
for Registrar of Trade Marks
31st August 2006