

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION FOR DECLARATION OF INVALIDITY OF TRADE MARK
REGISTRATION NO. 305993227

MARK :

We Play

CLASS(ES) : 9 & 38

APPLICANT : WEJOY PTE. LTD.

REGISTERED OWNER : SNOWBOY DIGITAL LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 20 November 2023, WEJOY PTE. LTD. (“**Applicant**”) filed an application (“**Subject Application**”) under section 53 of the Trade Marks Ordinance (Cap. 559) (“**Ordinance**”) for a declaration of invalidity of the registration of the following mark (Trade Mark No. 305993227) (“**Subject Mark**”):

We Play

2. Registration of the Subject Mark was granted on an application for registration filed on 23 June 2022 (“**Filing Date**”) by SNOWBOY DIGITAL LIMITED (“**Registered Owner**”) in respect of “computer software and programs; software and applications for mobile devices; downloadable mobile applications” in Class 9 and “computer aided transmission of messages and images; electronic bulletin board services; information services relating to telecommunications; message delivery and sending services; providing internet chatrooms; providing online forums; providing telecommunication access to the Internet; providing user access to global computer networks; transmission of data and information by electronic means; transmission of digital files;

videoconferencing services; voice mail services” in Class 38 (collectively, the “**Subject Goods and Services**”).

3. As the Registered Owner did not file any counter-statement, the Subject Application was treated as being unopposed by the Registered Owner pursuant to rules 41(3) and 47 of the Trade Marks Rules (Cap. 559A) (“**TM Rules**”).

4. The Subject Application was fixed to heard before me on 14 January 2025. The Applicant did not file a notice of attendance at hearing (Form T12) within the prescribed period, and was treated as not intending to appear at the hearing under rule 74(5) of the TM Rules. I now proceed to decide the matter without a hearing in accordance with rule 75 of the TM Rules.

Grounds of invalidation

5. According to the statement of grounds dated 20 November 2023 (“**Statement of Grounds**”), the Applicant relies on the grounds under the following sections of the Ordinance in making the Subject Application:

- (i) sections 11(5)(b) and 53(3);
- (ii) sections 12(1), (2), (3) and 53(5)(a);
- (iii) sections 12(5)(b) and 53(5)(b); and
- (iv) sections 12(5)(a) and 53(5)(b).

6. Each of the above grounds of invalidation is separate and independent. The Subject Application will succeed if any of the above grounds can be established.

The Applicant and the Applicant’s Mark

7. Pursuant to rules 42 and 47 of the TM Rules, the Applicant filed a statutory declaration of Chan Tat Cheung dated 15 August 2024 (“**Chan’s SD**”) as evidence in support of the Subject Application.

8. According to Chan’s SD, the Applicant is a limited liability company in Singapore which was incorporated in October 2020. It was stated that the Applicant engaged in the provision of application software for mobile phones; computer game software, downloadable; computer peripheral devices; electronic publications, downloadable; headsets for virtual reality games; downloadable image files; electronic

notice boards; cases for smartphones; portable power supplies (rechargeable batteries); animated cartoons; teaching; organization of competitions [education or entertainment]; organisation of esports events; providing online non-downloadable comic books and graphic novels; online publication of electronic books and journals; game services provided online from a computer network; entertainment services; production of radio and television programmes; electronic games services provided by means of the internet; and games equipment rental.

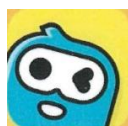
9. According to paragraphs 3 to 8 of Chan’s SD, the Applicant is the owner of the



trade mark “ **WePlay** ” (“**Applicant’s Mark**”), which has been used by the Applicant in respect of an entertainment software with games and social media function (“**Applicant’s Goods**”). For the meaning of “WePlay”, Chan explains that “We” refers to “us”, “Play” refers to “play game, entertainment”, and the combined word “WePlay” means “hope to build up a social platform to make players around the world to experience the fun of gaming and social entertainment together”.

10. Chan claims that the development of the Applicant’s Goods was completed on 1 March 2021 and the Applicant’s Goods were globally released on 27 March 2021. “Exhibit A” of Chan’s SD is a copy of certificate of software copyright registration (計算機軟件著作權登記證書) issued by the National Copyright Administration of the PRC (“**NCAC**”) on 8 February 2023, in which it was stated that a software named “WePlay” was completed on 1 March 2021 and first published on 27 March 2021.

11. Chan also claims that the device/logo of the Applicant’s Mark was created and first published in March 2021, and it was slightly revised in July 2023. “Exhibit B” of Chan’s SD are copies of two certificates of registration (作品登記證書) issued by NCAC in respect of the old and new versions of the said “WePlay” logo (shown below).



(Old version)



(New version)

It was stated in the certificates that the dates of creation of the old and new versions of the “WePlay” logo were 22 March 2021 and 6 July 2023 respectively.

12. In paragraphs 9 to 10 of Chan’s SD, Chan avers that the Applicant’s Mark has been used on the Applicant’s Goods globally since 27 March 2021. The Applicant’s Goods were available in various markets including Hong Kong, Taiwan and Japan, and they could be downloaded from Google Play, AppStore and Huawei AppGallery.

13. “Exhibit C” of Chan’s SD are printouts of screenshots from the websites of 點點數據, 七麥數據 and AppStore, showing (*inter alia*) the provision of the Applicant’s Goods under the Applicant’s Mark. According to the website of 點點數據, the date on which the earliest version of the Applicant’s Goods were published online globally (全球最早版本上綫日期) is 27 March 2021. It was also stated in the website of 七麥數據 that the date of release (發布日期) of the Applicant’s Goods is 27 March 2021.

14. “Exhibit D” of Chan’s SD are printouts of screenshots from Google Play, AppStore and 點點數據 in different countries. The last page of the printouts shows the respective release dates of the Applicant’s Goods under the Applicant’s Mark in various countries such as Korea, Japan, United States, Vietnam and Thailand. The release dates range from 26 May 2021 to 6 October 2022.

15. In paragraph 13 of Chan’s SD, Chan mentions that the Applicant has promoted the Applicant’s Mark around the world through various channels including Facebook and YouTube since March 2021. “Exhibit G” is a printout of screenshots from the Facebook page for “WePlay App” created by the Applicant on 22 March 2021. “Exhibit I” are printouts of the relevant screenshots showing the promotion of the Applicant’s Mark in YouTube, Facebook and TikTok. The old version of the Applicant’s Mark can be found in some of the screenshots of YouTube videos published in 2021 as follows:



01113w-169-HK (dated 14-12-2021) 0040W-169-HK (dated 14-12-2021)

16. In paragraph 16 of Chan’s SD, Chan states that the Applicant has registered the Applicant’s Mark in Taiwan under Registration No.02168521, in respect of goods in Class 9, with a registration date of 16 September 2021. “Exhibit M” is a copy of

certificate of the above registration, showing the old version of the Applicant's Mark as follows:



17. Chan asserts that (i) by virtue of the extensive use of the Applicant's Mark in respect of the Applicant's Goods since 2021, the Applicant has acquired substantial goodwill and reputation in the Applicant's Mark in Hong Kong, and (ii) in view of the similarity between the Subject Mark and the Applicant's Mark, the Applicant believes that the Subject Mark was intentionally copied from the Applicant's Mark by the Registered Owner, in order to take advantage of the Applicant's goodwill and repute.

The Registered Owner

18. According to the registration record of the Subject Mark, the Registered Owner is a limited company with an address in Hong Kong.

19. The Registered Owner did not file any counter-statement in these proceedings, nor any response to Chan's SD.

20. According to paragraph 26 of Chan's SD, between June 2022 and February 2023, the Registered Owner filed a number of applications for registration of trade marks in various countries and regions (including Hong Kong) which are the same as or similar to brand names belonging to other companies. Examples of some of the aforesaid marks filed by the Registered Owner in Hong Kong are set out below:

Trade mark	TM No.	Class(es)	Filing date	Applied by
FLALA	306003044	9, 38	06-07-2022	SNOWBOY DIGITAL LIMITED
Bondee	306178041	9, 38	27-02-2023	SNOWBOY DIGITAL LIMITED
LITMATCH	305988223	9, 38	18-06-2022	SNOWBOY DIGITAL LIMITED
LITMATCH	306041484	41, 42, 45	21-08-2022	SNOWBOY DIGITAL LIMITED

"Exhibit O" of Chan's SD includes (*inter alia*) printouts of the registration records of the above marks.

21. The brand names which are claimed to be “squatted” by the Registered Owner in paragraph 26 of Chan’s SD include (*inter alia*) the following:

Brand name	Owned by	Product nature	Publication date
Flala	Ruiyi Technology Co., Ltd.	Application software	25-04-2022
Bondee	METADREAM TECH PTE. LTD.	Application software	17-01-2023
Litmatch	CONSTRUCT TECHNOLOGY	Application software	30-03-2019

“Exhibit P” of Chan’s SD includes (*inter alia*) printouts of screenshots from Google Play, AppStore and other websites showing the above brand names and products.

22. From the printout of the notice of reasons for refusal issued by the Japan Patent Office and its English translation attached in “Exhibit Q” of Chan’s SD, it is revealed that the application for registration of the mark “WePlay” (Application No. 2022-144583) filed by “Snow boy Digital Limited” (the Registered Owner) on 19 December 2022 was ***refused*** by the Japan Patent Office on the basis that it was identical or similar to the mark “WePlay” which was used by the Applicant and has been widely recognised among consumers before the date of the said application.

Relevant date

23. For the present purpose, I have to determine the validity of the registration of the Subject Mark by reference to the position as at the Filing Date, i.e. 23 June 2022.

Declaration of invalidity under sections 11(5)(b) and 53(3) of the Ordinance

24. I will first deal with the ground of invalidation under sections 11(5)(b) and 53(3) of the Ordinance.

25. Section 53(3) of the Ordinance provides that:

“(3) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in contravention of section 11 (absolute grounds for refusal of registration).”

26. Section 11(5)(b) of the Ordinance provides that:

“(5) A trade mark shall not be registered if, or to the extent that –
... (b) the application for registration of the trade mark is made in bad faith.”

27. The following summary of the legal principles on bad faith given by Arnold J (as he then was) in *Red Bull GMBH v Sun Mark Ltd, Sea Air & Land Forwarding Ltd* [2013] ETMR 53 (at [131]-[138]) have been adopted and applied by the courts in Hong Kong, including in *Owndays Co Ltd v Professional Optometrist Ltd & Ors* [2019] HKCFI 3147 (at [15]) and *樂氏同仁藥業科技集團有限公司 v 中國北京同仁堂(集團)有限責任公司* [2022] HKCFI 2512 (at [16]):

- (i) The relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date.
- (ii) Although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date.
- (iii) A person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities, but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith.
- (iv) Bad faith includes not only dishonesty, but also “*some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined*”.
- (v) The relevant statutes are intended to prevent abuse of the trade mark system. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of their application; and the second concerns abuse vis-à-vis third parties.
- (vi) In order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case.
- (vii) The tribunal must first ascertain what the defendant knew about the matters in

question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry.

(viii) Consideration must be given to the applicant's intention.

28. In accordance with the above principles, when assessing whether the application for registration of the Subject Mark was filed in bad faith, I have to take into consideration all relevant factors, including the facts that the Registered Owner knew or should have known on the Filing Date.

29. In addition, in *Mila Schön Group SpA v Lam Fai Yung (t/a Tung Kwong Co)* [1998] 1 HKLRD 682 at 697, Recorder Kotewall SC stated that "although the onus was on the applicant for rectification, where the devices as they ultimately became were so similar, a court can be forgiven for concluding that one is derived from the other unless there is acceptable evidence from the originator of the idea to the contrary". Moreover, in *Ip Man Shan Henry v Ching Hing Construction Co Ltd (No 2)* [2003] 1 HKC 256 at 307, it was held that if a *prima facie* case is made out, and if there is evidence available to the party against whom the case is established which could displace the *prima facie* case, and he omits to call such evidence, an inference could be drawn in the absence of any plausible explanation by the party who elected not to call the evidence; if an inference is to be drawn, it would be an inference that such available evidence, even if adduced, would not displace the *prima facie* case.

30. The Applicant's case under sections 11(5)(b) and 53(3) of the Ordinance was pleaded in paragraphs 15, 18, 19 and 22 of the Statement of Grounds as follows:

"15. The Registrant was and is fully aware that it was not entitled to claim proprietorship of and should not commercially exploit, register, apply to register or take any steps to register as a trade mark the character "WePlay" or any mark consisting of "WePlay" in any jurisdiction without the Applicant's consent or authorization. The Registrant also has full knowledge that the Applicant and the Applicant's commercial interest will be substantively affected and/or prejudiced due to the Registrant's usurpation of the intellectual property rights subsisting in the



Applicant's mark " WePlay ".

18. The wrongly registered Mark consisting of the English words “We Play” is



confusingly similar to the Applicant’s Mark, i.e. “ WePlay ”. Visually, the wrongly registered Mark consists of the English words “We Play”, whereas the Applicant’s Mark also consists of the English word “WePlay” being one of the main similar elements. The overall visual impression created by the wrongly registered Mark is similar to that created by the Applicant’s Mark. Conceptually, the wrongly registered mark would be remembered as “We Play”, while the Applicant’s Mark would also be remembered as “WePlay” with other elements. The overall impression created by each of them is that of “We Play/ WePlay”. Also, the pronunciation of the wrongly registered Mark is also same as that of “WePlay” part in the Applicant’s Mark. The wrongly registered Mark is therefore visually, conceptually and phonetically confusingly similar and/or identical to the Applicant’s Mark. Having regard to the visual, conceptual and aural similarities between the wrongly registered mark and the Applicant’s Mark as well as the overall impression created by each of them, these marks are confusingly similar to and/or identical with each other.

19. Moreover, the goods and services claimed in the wrongly registered Mark are similar and/or identical to the Applicant’s Goods and Services covered by the Applicant’s Mark, especially both the goods and services claimed in the wrongly registered Mark and the Applicant’s Goods and Services covering Class 9, 38 and 41 goods and services.

22. By reason of the foregoing, the registration of the wrongly registered Mark is contrary to Section 11(5)(b) because the application for registration of the wrongly registered Mark was made in bad faith and the Registrant was not entitled to claim proprietorship in the wrongly registered Mark. The wrongly registered Mark therefore did not qualify for registration in the name of the Registrant in the first place for being in breach of Section 11(5)(b) of the Ordinance on this ground. The registration of the Registrant’s mark should therefore be declared invalid under Section 53(3). ”

31. I note from the Applicant’s unchallenged evidence that the Applicant has been using the Applicant’s Mark in relation to the Applicant’s Goods since March 2021, which is prior to the Filing Date (see paragraphs 9 to 15 above). Although I note that the device element of the Applicant’s Mark has been revised in July 2023, there has been no change to the word element “WePlay”, which has all along been used by the Applicant since the

creation of the Applicant's Mark (and the launch of the Applicant's Goods) in March 2021. As a Hong Kong company trading in or with an intention to trade in the Subject Goods and Services (which encompass and overlap with the Applicant's Goods), the Registered Owner should have knowledge of the use of the Applicant's Mark by the Applicant in relation to the Applicant's Goods before filing the application for registration of the Subject Mark in Hong Kong. In fact, the Registered Owner has not filed any counter-statement or evidence to deny knowledge of the Applicant's Mark before it filed the application for registration of the Subject Mark.

32. The Subject Mark consists solely of the words "We Play", which have the same spelling, pronunciation and meaning as the word "WePlay" in the Applicant's Mark, except that there is no space between "We" and "Play" in the latter. The words "We Play" or "WePlay" (with or without space) are not directly descriptive of the Subject Goods and Services or commonly used in the relevant trade. In my view, it is hard to believe that the Registered Owner has independently come up with the Subject Mark for use on the Subject Goods and Services without knowledge of the Applicant's Mark. Moreover, there is evidence to suggest that the Registered Owner is seeking to register a number of different trade marks belonging to other proprietors in the software industry without their consent (see paragraphs 20 and 21 above). Apart from filing the present application for registration of the Subject Mark in Hong Kong, the Registered Owner also sought to register the mark "WePlay" (which is *exactly identical* to the word element of the Applicant's Mark) in Japan and was subsequently refused by the Japan Patent Office. Taking all the above into account and applying the principle in the *Mila Schön* case, I find the only reasonable inference that can be drawn is that the Registered Owner must have knowledge of the Applicant and its rights in the Applicant's Mark, and have chosen to copy the Applicant's Mark when filing the application for registration of the Subject Mark.

33. The Applicant has explicitly accused bad faith on the part of the Registered Owner in filing for registration of the Subject Mark in Hong Kong. In face of the serious allegation of bad faith and the evidence filed by the Applicant, the Registered Owner did not file any evidence or offer any explanation as to how the Subject Mark was created, or to rebut the Applicant's proposition that the Subject Mark was copied from the Applicant's Mark. In fact, the Registered Owner did not even file a counter-statement and the Subject Application was treated as unopposed. Applying the principles in the *Ip Man Shan Henry* case, given that the Registered Owner has not filed any evidence in this case, an inference could be drawn that any such evidence, even if adduced, would not displace the *prima facie* case established as aforesaid.

34. There remains the question, whether in the light of the knowledge of the Registered Owner, its conduct is dishonest judged by ordinary standards of honest people. To this, my answer is in the affirmative, since the Registered Owner's decision to register the Subject Mark which is highly similar to the word element of the Applicant's Mark, without the Applicant's permission, will plainly be regarded as falling short of the standards of acceptable commercial behaviour as observed by reasonable and experienced men in the field as the Registered Owner's.

35. To conclude, I consider that the Registered Owner's decision to apply for registration of the Subject Mark in respect of the Subject Goods and Services falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant field. I find that the application for registration of the Subject Mark was made in bad faith within the meaning of section 11(5)(b) of the Ordinance. It follows that the registration of the Subject Mark in respect of the Subject Goods and Services should be declared invalid pursuant to section 53(3) of the Ordinance.

Conclusion and costs

36. For the above reasons, I find that the ground of invalidation under sections 11(5)(b) and 53(3) of the Ordinance has been made out. I therefore allow the Subject Application and declare the registration of the Subject Mark invalid. That being the case, it is not necessary for me to consider the other grounds relied on by the Applicant.

37. As the Subject Application has succeeded, I award costs to the Applicant. Subject to any representations, as to the amount of costs or calling for special treatment, which either party may make within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

(Ryan Ng)
for Registrar of Trade Marks
19 March 2025