

“REAL STUPIDITY ALWAYS TRUMPS AI”: REGISTRABLE & ENFORCEABLE?

- China & Hong Kong

SHIRLEY KWOK

China & Hong Kong

Ribeiro Hui

HK Trade Mark Work Manual

- “Slogans often consist of expressions that are catchy, clever or topical. They are frequently used with a main trade mark or house mark to create a positive sentiment, aura or cachet to be associated with that brand of goods or services. Slogans are not objectionable in themselves as trade marks; the principal difficulty with them is that they are often incapable of serving as badges of origin because they consist of indistinctive, descriptive or generic matter.”

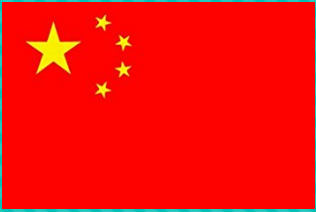
Similarities & Differences – China & HK

- Registrability of slogans under local trademark laws
- Examples of rejected and registered slogans
- Registrability of “Real stupidity always trumps AI”
- Enforceability of “Real stupidity always trumps AI”

Any special provisions for “slogans”
in the trade mark laws?

- China X
- Hong Kong X

Basic trade mark registrability principles apply



Definition of “trade mark”



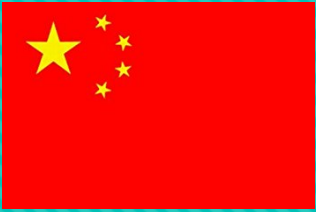
- Trademark Law, Art. 8
- Any sign, capable of distinguishing the goods or services of one natural person, legal person or any other organization from those of other persons, including words, devices, letters, numerals, three-dimensional signs, combination of colors, sounds, etc., as well as the combination of such signs, shall be eligible for application for registration as a trademark.
- Trade Marks Ordinance, Sec. 3
- “trade mark” (商標) means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.



“Distinctiveness” requirement



- Art. 9 A trademark ... shall have distinctive character.
- Art. 11 The following signs shall not be registered as trademarks:
 - (1) signs which consist **exclusively** of the generic names, designs, or model numbers of the goods in respect of which the trademark is used;
 - (2) signs which consist **exclusively** of direct indications of the quality, primary raw material, functions, intended purposes, weight, quantity or other characteristics of goods; or
 - (3) Other signs which are devoid of any distinctive character.
- Trade Marks Ordinance, Sec. 11
 - (1) ...the following shall not be registered ...
 - (b) trade marks which are devoid of any distinctive character;
 - (c) trade mark 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; ...



“Quality is the Best Recipe”?

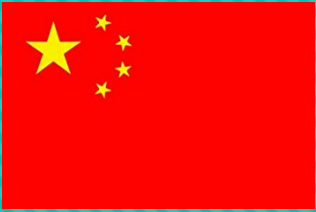


- PROVISIONS OF THE SUPREME PEOPLE'S COURT ON SEVERAL ISSUES CONCERNING THE TRIAL OF ADMINISTRATIVE CASES INVOLVING TRADEMARK AUTHORIZATION AND CONFIRMATION
- Art. 7: The People's Court, when examining the distinctiveness of the disputed trademark, shall base on the general understanding of the relevant public on the designated goods of the trademark to decide if the mark as a whole is distinctive. A trademark should be considered as having distinctiveness even if it includes descriptive elements **but which would not affect the distinctiveness of the mark as a whole**; or the descriptive elements are expressed in a special way to the extent that the relevant public can still identify the place of origin.
- TRADE MARK WORK MANUAL ON “ABSOLUTE GROUNDS OF REFUSAL”
- Section 11(1)(c) is applicable only when the sign consists exclusively of the descriptive element or word(s). **If there is another element in the sign which is not descriptive** (except an element which is insignificant, e.g. a simple border), the sign would not be objectionable under section 11(1)(c) but may remain objectionable under section 11(1)(b).

Original \neq Capable of Distinguishing

What make these slogans distinctive?

- Rarely any reference to the products/services
- Abstract and pushes one's imagination
- Focus on the consumer
- Highlight how the consumer can stand out
- Not lengthy, but catchy and easy to remember
- No difficult words, but unusual combination of common words






Real Stupidity Always Trumps AI



As already registered	
Real	 Reg. No. 1165426
Stupidity	Reg. No. 3081160
Always	 Reg. No. 710136
Trumps	 Reg. No. 9948071
AI	 Reg. No. 22375437
	 ARTIFICIAL INTELLIGENCE Reg. No. 3782223



As already registered	
Real	 Reg. No. 1995B01755
Stupidity	DUMB AND DUMBER Reg. No. 199609557
Always	<i>always</i> Reg. No. 303433563
Trumps	TRUMP Reg. No. 9948071
AI	 Reg. No. 303262275
	 Reg. No. 304044159

The image features a teal background with a black jagged shape at the bottom. The text "How to improve Distinctiveness?" is centered in the black area.

How to improve Distinctiveness?

Addition of distinctive element



Distinctiveness acquired through use



- Trademark Law, Art. 11

- Signs mentioned in the preceding paragraph may be registered as trademarks if they have acquired distinctive character through use and are capable of being readily identified and distinguished.

- Trade Marks Ordinance, Sec. 11 (2)

- A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.



Distinctiveness acquired through use



- TM Examination Guidelines Part 2(VII)
- Trade Marks that are not distinctive but have acquired distinctiveness through use such that they can indicate the source of goods, may be accepted for registration.

○ Example :

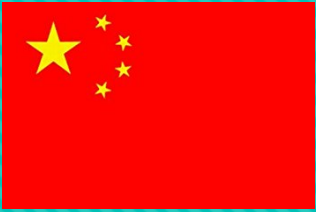
○ Goods : Water heaters



- A review of a trade mark that has acquired distinctiveness through use should take into account the relevant public's perception of the trade mark, the actual use of the trademark by the applicant, and other factors involved in the use of the trade mark to obtain distinctiveness.

○ TM Work Manual

- As regards evidence of use, we need to consider whether there has been use of a mark **as a trade mark**, and whether as a result of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as **originating from a given undertaking**. It is not sufficient that consumers may be caused to wonder whether or not this might be the case or simply be 'reminded' of the undertaking concerned". The best evidence will be of **the mark being used on its own**, without any other trade mark, so that the slogan may be taken as an indication of origin and not merely as informational or otherwise non-trade mark matter.



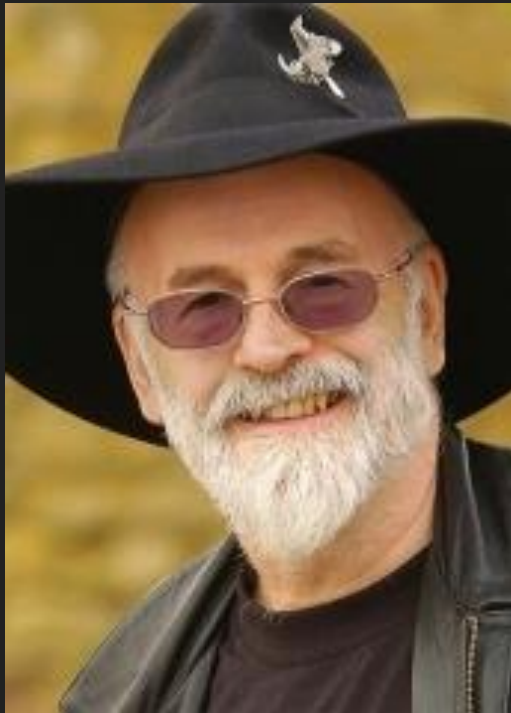
Other possibly Relevant Objections



- Trademark Law, Art. 10
- The following signs shall not be used as trademarks:
 - (6) Those having the nature of discrimination against any nationality;
 - (7) Those that are deceptive and likely to mislead the public in terms of the quality, place of production or other characteristics of the goods;
 - (8) Those detrimental to socialist ethics or customs, or having other unhealthy influences.
- Trade Marks Ordinance, Sec. 11
 - (4) A trade mark shall not be registered if it is—
 - (a) contrary to accepted principles of morality; or
 - (b) likely to deceive the public.
 - (5) A trade mark shall not be registered if, or to the extent that—
 - (a) its use is prohibited in Hong Kong under or by virtue of any law; or

Prima facie registrable, but

- “Real stupidity beats artificial intelligence every time.”



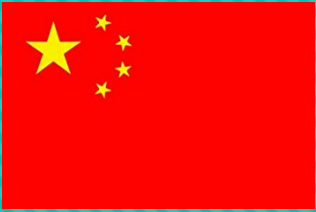
- - Terry Pratchett, Hogfather



Are slogans copyrightable?



- (1) In Chengdu Huangcheng Laoma Restaurant v Beijing Huangrong Laoma Hotpot, Beijing No.1 Intermediate People's Court held: 3 advertising slogans by the plaintiff are distinctive and should be protected under the copyright law.
- (2) In Guangzhou Hengda Real Estate Development Limited v. Guangzhou Rengfeng Real Estate Development Limited, Guangzhou Intermediate People's Court held: The slogan by the plaintiff is distinctive and should be protected as a work under the copyright law.
- In a UK TM invalidation case re TM No. 1391538 in the name of ANIMATED MUSIC LTD, the Trade Marks Registry held: it should not be assumed that an advertising slogan,, is incapable of protection as a matter of principle; rather, one should look at the amount of independent skill, labour and judgement involved in its composition....



Copyright as prior right in TM app



- Trademark Law, Art. 32

- No applicant for trademark application may infringe upon another person's **existing prior rights**,

- Trade Marks Ordinance, S.12(5)

- A trade mark shall not be registered if,, its use in Hong Kong is liable to be prevented by virtue of an earlier right(in particular, by virtue of the law of copyright ...

Are the two Slogans similar?

Real stupidity beats artificial intelligence every time

Vs

Real stupidity always trumps AI

Assuming they are similar ...

Relative grounds for refusal –

rights owner will have legal basis to

- **file opposition at application stage, or**
- **file invalidation if the mark is registered**

Enforceability – scope of protection?

Real stupidity always trumps AI

Vs

Real stupidity beats artificial intelligence every time



Thank you!

Shirley Kwok
s.kwok@ribeirohui.com