

## TRADE MARKS ACT 1995

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS, WITH REASONS

Re: Opposition by Sky Channel Pty Ltd to registration of trade mark application 934168, 934169, 934170, 934173 - **CHINESE CHARACTERS/TIAN YING** - filed in the name of Celestial Pictures Limited.




---

<b>DELEGATE:</b>	<b>Terry Williams</b>
<b>REPRESENTATION:</b>	<b>Opponent: Written submissions by Phillips Fox, solicitors</b> <b>Applicant: Ben Fitzpatrick of counsel instructed by Davies Collison Cave, patent attorneys</b>
<b>DECISION:</b>	<b>S 52 opposition: SKY trade marks not deceptively similar to marks in Chinese characters or to transliteration thereof. Registration to proceed.</b>

---

#### Background

1. Celestial Pictures Limited (Celestial) has filed four applications to register the trade marks as follows. These are shown with the transliteration or translation endorsement that was appended to the application before each was accepted for possible registration.

Trade Mark	Trade mark	Translation
934169		The applicant has advised that the Chinese characters appearing in the trade marks may be transliterated as TIAN YING and translated into English as SKY SHINE.
934168		... transliterated as TIAN YING PIN DAO and translated into English as SKY SHINE CHANNEL.
934170		... transliterated as TIAN YING YU IE and translated into English as SKY SHINE ENTERTAIN HAPPY.
934173	TIAN YING	... translation of the CHINESE words appearing in the trade mark is SKY SHINE.

2. I will not set out the relevant goods and services in full. It is sufficient to say that they include a wide range of printed matter in class 16, telecommunications services including image transmission and radio broadcasting services in class 38 and entertainment services in class 41.

3. It will be seen that the Chinese characters that make up trade mark 934169 are common also to 934168 and 934170. What those elements and their Pinyin transliterations<sup>1</sup> signify is at the heart of this opposition. Registration of the applications is opposed by Sky Channel Pty Ltd. (Sky), essentially on the basis that they are “too close” to what I will, for the moment, simply call a large number of SKY trade marks.
4. Both parties served relevant evidence and I was then assigned to hear and decide the opposition under delegation from the Registrar of Trade Marks. At that hearing the applicant was represented by Ben Fitzpatrick of counsel, assisted by Dace Johansons of the instructing patent attorneys, Davies Collison Cave. Sky relied on written submissions by Phillips Fox, solicitors. Central to these are arguments about the consequences for a meaning ascribed to each trade mark by the opponent. I therefore turn to that issue.

### **Meaning of trade marks**

5. The opponent has, I think, been misled by the translations that Celestial has provided to the Trade Marks Office. These are in stark contrast to the ones adopted in Singapore, which I will set out below. The Australian endorsements begin with the words “The applicant has advised that...”.
6. Sky argues that Celestial, having “advised” of a translation, cannot now resile from it. However, perhaps the genesis of the current problem goes back to the examination of these particular applications. The Trade Marks Office is simply not in a position to confirm or deny the accuracy of many of the translations presented to it and current practice therefore acknowledges that the translation provided is that of the applicant, not that of the Trade Marks Office. As to the context of that advice, I note that the first examiner’s report in relation to 934169 and the other Chinese-character marks begins with a request as follows:

Please provide a transliteration (using the Pinyin system) and an English translation of the Chinese characters appearing in the trade mark as required by regulation 4.3 of the Trade Marks Regulations.

---

<sup>1</sup> Chinese is a tonal language. Pinyin is an internationally recognised transliteration system, endorsed by the government of the People’s Republic of China, for transcribing specific sounds of the Chinese language into Roman typescript. Its accurate use requires some study of Chinese and the pinyin system. In other words, an untrained person would almost certainly pronounce Tian Ying in a way that would rob the sounds of meaning.

7. In other words, an English translation of the Chinese characters, presumably all of them, was invited. Celestial, having been asked the question in terms that were perhaps more directive than was intended, has obliged with a literal translation - an answer that is both simplistic and, inadvertently, misleading.
8. In its written submissions, Sky is very critical of Celestial's evidence in answer for seeking to establish that better translations exist. However, since the translation of the trade marks lies at the heart of Sky's case it is appropriate to go to the evidence of the parties on this vexed question.
9. Celestial relies on declarations by Dace Johansons, Wu Zhongpu, Edward Tang and Patrick Wong. Of these, Mr Wong's declaration goes simply to his own personal opinion, which I would summarise as: "the Sky marks are in English and clearly Western, the others aren't, so I wouldn't confuse them". I cannot safely assume that Mr Wong's view is typical of that which might prevail either in the Chinese community or in the market in general. Mr Tang declares that he is fluent in English and can read "some traditional Chinese characters and fewer simplified Chinese characters". He goes on to say that the two characters making up trade mark 934169 translate to "Sky Film" or "Horizon Film", before going on to set out an opinion much like Mr Wong's.
10. Wu Zhongpu notes, in his declaration, that the "simplified characters", those to which Mr Tang refers, are used in PR China, while traditional characters are used in Hong Kong and Taiwan. He goes on to state that the two characters used in 934169 "do not have any definite meaning because they are not usually used together". However, he would "translate the combination as meaning 'Sky Reflection' or 'Reflection of the Sky'". Confusingly, he then states that "In the past, people from Hong Kong or Taiwan might have associated these two characters with 'the movies' or 'the pictures'". He does not explain how or when this association might have arisen but, since he does not appear to consider such an association is of more than historical relevance I can leave this enigma without further investigation. The declarant translates the related Chinese character trade marks 934168 and 934170 as "Sky Reflection Channel" and "Sky Reflection Entertainment" respectively.

11. Dace Johansons does not purport to speak or read Chinese. She does however annex documents that are relevant to this matter, for example, translation documents submitted to the Registrar of Trade Marks in Singapore. Her evidence satisfies me that the parties' trade marks coexist in PR China and in Singapore, though I regret that I am not familiar with the practice of the registry in either country and there is no indication of the circumstances that attended the concurrent registrations.
12. The applications made in Singapore show that in that jurisdiction the applicant relied on certificates from an apparently independent translator, to the effect that the Chinese characters [and here the translator refers to the two characters that make up Australian trade mark 934169, of which the one on the left is *tian*] may be transliterated and translated as follows.  
[tian] : sky, heaven, day, season, weather, nature  
[ying] : reflect, shine, mirror.
13. The translation goes on to say, omitting the Chinese characters there set out: "The combined Chinese phrase [tian ying] does not convey any meaning". Consistently, the register in Singapore does not record any translation for the words TIAN YING.
14. The remaining Singapore material is also instructive. There are trade mark registrations in that country that transliterate to Tian Ying Pin Dao and Tian Ying Yu Le. Of the former, the translation on the Singapore register is "a television channel by the name of Tian Ying". The remaining Chinese character trade mark, however, does not appear to be directly comparable with any of the marks before me. Its transliteration is Tian Ying Yu Le, a combination which is said to have "no meaning". The transliteration of the Australian trade mark is Tian Ying Yu Ie.
15. Ms Johansons' further evidence continues the theme that, as a combination, Tian Ying has more than a literal meaning. She tenders in evidence the entire of a 3 volume set of books. Ms Johansons' declares that these are the Ci Hai dictionary. A section has been flagged to show (with my italics added in place of the Chinese characters) "all the recognised Chinese words that begin with the character (*tian*). The import of this is not something to which Ms Johansons is able to declare directly. She declares, instead, that:

The applicant has advised that the absence of this combination from the Ci Hai confirms it is invented and is not a known dictionary word or phrase. The absence also confirms that although the two characters may be separately translated, they do not have any definite meaning when combined in this way which is why various “translations” (sic, including quote marks) have been provided. The applicant has advised that as written together, the characters are as meaningless as the word “SKYANT” (even though the words SKY and ANT have meanings).

16. Sky, for its part, relies on a single declaration to shed light on this facet of the opposition. Muhammed Dallah works in the finance area of Sky’s solicitors, Phillips Fox. He declares that he is familiar with the traditional and the simplified characters of written Chinese. He is fluent both in English and in Cantonese, which uses the same written character set as Mandarin. He further declares:

As I am bilingual and live in an English-speaking country, when presented with Chinese words or characters I generally read the Chinese words or characters in Chinese and then automatically translate – either in my mind or verbally – the words, phrases and/or sentences to English.

I have been asked by Simone Tierney of Phillips Fox to review four trade marks and provide English translation of those trade marks and my opinion on what each trade mark means.

17. He goes on to address the specifics of the four trade marks, of which I will set out the most relevant items as follows

(Of trade mark 934168)

I note that the applicant translates this trade mark as “Sky Shine Channel”

In Chinese, it is possible to read two or more Chinese characters which appear together as one word. It is impractical and incorrect to translate into English each Chinese character appearing in a sentence or phrase without regard for the surrounding characters. Further, common day usage or colloquialism can further change the meaning of Chinese characters<sup>2</sup>.

In my opinion trade mark 934168 translates into English as “Sky Line Channel” or “Sky Screen Channel”.

(Of trade mark 934169)

I note that the applicant translates this trade mark as Sky Shine

---

<sup>2</sup> This is consistent with the observation of Conti J in *Australian Chinese Newspapers Pty Ltd v Melbourne Chinese Press Pty Ltd* [2004] FCAFC 201.

When I first viewed trade mark 934169 I immediately read it as “Sky” but on further reflection and closer examination I believe the trade mark could also translate into English as the words “Sky Line” or “Sky Screen”.

18. Mr Dallah, in other words, is giving first-hand evidence of his own difficulty in establishing the meaning of a combination that, apparently, has no more literal meaning than Ms Johansons’ example of SKYANT, or, to take another example, SKY-MANGO.
19. Mr Dallah goes on to comment that the translation proposed for 934170 “does not make sense to me”. He declares that it is very rare to translate the last two characters separately into “Entertain” and “Happy”. The correct translation of the combination is “Entertainment”, he says. He then reiterates his previous caution about the need to establish meanings of combinations as wholes, and concludes that the trade mark in question “translates into English as “Sky Line Entertainment” or “Sky Screen Entertainment”. Mr Dallah’s observation is consistent in one respect with the translation material provided by Celestial to the Singapore Trade Marks Office. There, while the characters yu and le are translated separately as, inter alia, “amuse” and “happy” respectively, the combination of the two is said to mean “entertainment, recreation, amusement”.
20. Mr Dallah expresses uncertainty about trade mark 934173, for TIAN YING rendered in ordinary upper case. “When I first viewed (it) I thought of it in English as ‘Sky’ but on further reflection and closer examination I believe (it) could also be translated into English as ‘Sky Line’ or ‘Sky Screen’”. He concludes:

When reading each of the Trade Marks it is clear to me that the first two characters are being used as the name of the company, or as the main part of the trade mark

21. Again, this would be consistent with the Singapore register, where Tian Ying Pin Dao is translated as “a television channel by the name of Tian Ying”.

**Grounds considered.**

22. Sky’s notice of opposition nominated grounds under sections 43 and 58, and under 44 and 60 of the *Trade Marks Act 1995*. Of these, the grounds under sections 43 and 58 were not argued before me and are not established. In its written submissions, Sky pursues only issues involving deceptive similarity. Those remaining grounds also

fail. I will explain, below, why this is so, but before doing so it is necessary to deal with the evidence about a relevant translation of the trade marks in question.

*Deceptive similarity?*

23. Deceptive similarity is critical to Sky's case under sections 44 and 60, of which it is a common element. Relevantly, s 10 provides

For the purposes of this Act, a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

24. Sky's written submission draws no substantive distinction between the Chinese character trade marks the subject of three applications and the Pinyin transliteration the subject of the fourth. Nor did Mr Fitzpatrick, at the hearing. In view of the nature of the Pinyin system, a reader knowledgeable in the translation and transliteration of Chinese would ascribe a translation to trade mark 934173, and a consistent transliteration to the other marks. Accordingly, the issue arises (or not) equally in all four cases.
25. In the submission by Sky it is asserted that the first character of each of the four trade marks is consistently translated as Sky. This does not appear to be correct on a careful reading of the Dallah declaration. His evidence has the more force because it is something that Sky itself has brought into evidence and is consistent with the Singapore translations. Mr Dallah, it will be recalled, was asked by a solicitor within his employer's firm to translate the characters in question. The tenor of his declaration is that he is trying to cautiously and honestly answer a leading but unanswerable, or at least difficult, question.
26. It appears to me that the lawyers for Sky recognise this tenuous basis for an alleged translation needs shoring up. They rely on s 210(1), which simply establishes that "The Register is prima facie evidence of any particular or other matter entered in it". This argument goes much too far. In the first place, the trade mark is not yet registered and perhaps one result of the opposition process would be to filter out, inter alia, questionable translations. Leaving that rather obvious problem aside, the most that could be said is that the register establishes the facts of the registration. Section 210 goes on to note that copies or extracts that are certified by the Registrar of Trade Marks will be recognised in proceedings. Since the Act also contains provisions for

proceedings for the correction of errors, either administratively or through the courts, it is simply not possible to argue, as Sky does, that the mere existence of an entry is proof of the actual correctness of the entry. The occurrence of a purported translation on the pages of the register cannot magically establish the accuracy of that translation.

27. In other respects I fully accept the broad thrust of Sky's written submissions. Sky's trade marks include the words SKY CHANNEL, a logo device, and (as registered) a number of word marks such as SKY MOVIES, SKY RACING, SKY SELECTIONS and SKY GAMES and there is little room for debate about the context in which deceptive similarity of the competing trade marks is to be assessed. In use, the reputation appears to reside in either the words SKY CHANNEL or SKY for short and the SKY CHANNEL trade marks are relatively well-known. SKY CHANNEL, and the promotions thereof, would be familiar to the Australian community, including the Chinese-literate section of that community<sup>3</sup>. Sky has registrations that entitle it to use its trade marks in the broadcasting and reception of television programmes, and in film hire, production and film studios, rental of television sets and television entertainment.
28. This overlapping area of services sets the context, as it were, for the comparison of trade marks. In particular, since Sky raises the matter, I note the opponent's evidence that gambling is "an important component of Chinese culture and an acceptable and common social activity among people of Chinese ancestry in Australia and other comparable countries".<sup>4</sup> Sky appears to have stressed this aspect of the market because of a recent change in its ownership, such that it is now owned by TabCorp. I do not believe that this is necessarily something that Sky can invoke in establishing deceptive similarity for the purposes of s 10. It is, however, confirmation that Sky's reputation would continue to be as solid and commercially significant as it now is. I state, accordingly, that I have allowed for a gambling-related element among the circumstances of the comparison. Such allowance does not, however, affect the outcome and I stress that I make it simply in order to demonstrate to Sky that I have set its arguments on what its lawyers find to be the strongest base.

---

<sup>3</sup> According to census data provided by Sky, Chinese languages are now the most commonly-spoken non-English language in this country, the next most common being Italian.

<sup>4</sup> Australian National University Centre for Gambling Research, 2004, in a report commissioned for the the ACT Gambling and Racing Commission.

29. Finally, I note the opponent's evidence that in Australian commerce it is common to find an English translation of Chinese signage of various sorts. Interestingly, the opponent is well aware of the usage made by Celestial in Australia and elsewhere. Its lawyers have reviewed Celestial's website, which is bi-lingual but, among many instances of Celestial doing business under the trade mark CELESTIAL, Sky's lawyers could apparently find no instance of Celestial making any usage that supports the "translation" Sky's case relies on so heavily.
30. Mr Fitzpatrick noted a number of court and administrative decisions. He stressed the strong auguries for deceptive similarity present in *Melbourne Chinese Press Pty Ltd v Australian Chinese Newspapers Pty Ltd*<sup>5</sup>. This was a decision of the Full Court of the Federal Court, on an appeal in an infringement matter. The case turned on the comparisons of two logos, both in Li Shu style calligraphy, with consideration of direct evidence of confusion within the Chinese-literate community. It was not one where the finding of deceptive similarity was based on a comparison of translations. More tellingly, infringement was said to have arisen only with the adoption of that particular calligraphy, not with the previously-used style. Properly seen, that case is an example of the comparison of devices. Mr Fitzpatrick contrasted it with the finding that, most relevantly, the following trade marks were not deceptively similar:

СТОЛИЧНОЕ and STOLICHNAYA<sup>6</sup>

CLINIQUE and LA CLINICA<sup>7</sup>

ST MICHAEL and SAN MIGUEL<sup>8</sup>

SOLIBRISA and SUMMER BREEZE<sup>9</sup>

31. These must be balanced with another which Mr Fitzpatrick also acknowledged, the refusal of LA REINE (with the device of a coronet)<sup>10</sup> as being deceptively similar to CORONET or CROWN trade marks (in various forms). In the latter, the deciding officer gave due allowance to the device in common. From the textual description of the trade marks, this is understandable. However, it is a concrete element of

<sup>5</sup> See footnote 2 above

<sup>6</sup> 63 IPR 38 Note that the former mark may be transliterated as STOLICHNOYE, a word with a somewhat similar translation to STOLICHNAYA.

<sup>7</sup> *Clinique Laboratories Inc v Luxury Skin Care Brands Pty Ltd* 61 IPR 130

<sup>8</sup> *Marks & Spencer v San Miguel Corp* (1989) AIPC 90-554

<sup>9</sup> *Marcos Bale Y Hnos Appn* 65 RPC 17

<sup>10</sup> *Klein's application*. 1936 AOJP 78. Students of legislative history will appreciate the explicit reference to the onus being, at that time, on the applicant to negate the likelihood of confusion.

resemblance that is missing from the present situation. The same decision also establishes that the applicant's trade mark was *not* held to be deceptively similar to various trade marks featuring the word QUEEN.

32. I am required to decide the likely reaction to, and response of, an average consumer encountering the applicant's marks in circumstances where imperfect recollection is a factor. To paraphrase *Australian Woollen Mills v F S Walton & Co Ltd*<sup>11</sup>, I must consider:

the usual manner in which ordinary people behave... the course of business and the way in which the particular class of goods are sold. These give, it may be said, the setting, and the habits and observation of people in general affords the standard.

33. This should be augmented by noting a very old principle, coming from what Lord Cranworth said in *Seixo v Prozende*<sup>12</sup>:

If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device.

34. I would combine these two principles to the following effect. Were I satisfied that, within the Chinese-literate community, itself a significant group within the market in Australia, Celestial's trade marks would be conceptualised in some way that ascribed to any one of them the name "Sky", or that might otherwise allow it to be seen or recalled as "another of Sky's marks", deceptive similarity would be arguable, if not established. I am far from satisfied that this is the case. Sky has, instead, invited me to string a number of ambiguities together and to conclude that, despite an uncertain translation and no visual or audible resemblance whatsoever, there would be confusion. There is nothing that suggests to me that, for the purposes of s 10, the applicant's trade mark "so nearly resembles (any of the various SKY marks, as variously used or registered) that it is likely to deceive or cause confusion". Deceptive similarity has simply not been established and Sky's opposition accordingly fails.

---

<sup>11</sup> (1937) 58 CLR 641

<sup>12</sup> (1866) LR 1 Ch. 192, at 197

**Conclusion**

35. Sky has not established any ground of opposition in relation to any of the four applications for registration. The applications may therefore proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal of the decision in relation to one or more applications before that time, I direct that registration of the relevant application shall not occur until the appeal has been discontinued or registration is otherwise ordered by the court.
36. Celestial may, at its discretion, propose a more accurate translation endorsement. It is no doubt undesirable that registration proceed with the present endorsements but this is precisely what would have happened had Sky not intervened. Accordingly, and since no ground of opposition is established, I do not see the translation matter as being of sufficient consequence to impede registration.
37. I award costs against Sky.

Terry Williams  
Hearing Officer  
8 November 2006