

(16) File No. 321/55 (1)

IN THE MATTER of the Trade Marks
Ordinance No. 47 of 1954.

and

IN THE MATTER of an Application
by Chan Yam Chi, trading as
Sunny Garment Factory, for the
registration of a Trade Mark

HEARING before Mr. W. K. Thomson,
Deputy Registrar General,
on 21st, 22nd and 25th June, 1956.

On 3rd May, 1955, Chan Yam Chi, of 201 Haitan Street, Shamshuipo, Kowloon, trading at the same address as Sunny Garment Factory, applied for the registration of the mark

"ALOHA"

牌慕愛

(a Hawaiian word meaning farewell) in Class 25 (Clothing) in respect of shirts, jackets, trousers, pyjamas, swimming costumes, men's and children's suits and women's dresses, all not knitted; underwear, singlets, vests and hosiery, all knitted. In his accompanying Declaration Mr. Chan stated that the mark had not up to then been used by his firm in Hong Kong or elsewhere in respect of the goods mentioned, but it was his firm's intention so to use it in Hong Kong if and when it was registered. The Chinese words 牌慕愛 which read from right to left are pronounced OI MO PAI and mean "Love Fondly Brand" were deleted from the mark upon the Registrar stating that the words 慕愛 meaning "Love Fondly" were not sufficiently distinctive to be capable of registration. The application being then advertised, notice of opposition was given by Cluett, Peabody & Co., Inc., of Troy, New York, U.S.A. The grounds of opposition were stated as follows :-

- "(1) We are the proprietors of the trade mark "ARROW" registered as Nos. 50 of 1927 and 792 of 1952 in Class 38 (Schedule III) in respect of collars and shirts; and shirts, collars, cuffs, underwear, pyjamas, night-shirts and neckties respectively.
- (2) The trade mark for which application is being made and advertised in the Gazette as No. 321 of 1955 bears such a close resemblance to our said trade mark that the use of the Applicants' trade mark in respect of goods the same as or similar to those in connection with which our said trade mark has been used and registered is likely to deceive the trade and the public into the belief that the Applicants' goods bearing their said mark are goods of our company, or otherwise to cause confusion, and such mark ought not to be allowed registration.

- (3) The Registrar of Trade Marks has previously refused registration of the words "HALLOW" and "HARLOW" because of their close phonetic resemblance to our said trade mark (See Article by the Registrar of Trade Marks in the Department of Commerce and Industry TRADE BULLETIN; April 1955 at page 22).

2. The material parts of the Applicant's Counter Statement read as follows:-

- "(4) In phonetic the Applicant's Trade Mark "ALOHA" is pronounced "AL-LO-HA" a Trisyllabic, accent on the second syllable while the Opponent's Trade Mark "ARROW" is pronounced "AR-RÖW" a Disyllabic, accent on the first syllable. In the Colony of Hong Kong those who speak English and/or Cantonese are unlikely to confuse the words "ALOHA" and "ARROW" by sound.
- (5) In appearance, the Applicant's Trade Mark is composed of words only while the Opponent's Trade Mark is composed of words with an arrow cutting through them. The colour of the Applicant's Mark is Blue while the colour of the Opponent's Mark is Black. Therefore intending purchasers of "ARROW" products who are given "ALOHA" will be able to see at a glance that they have not got what was asked for. Similarly, intending purchasers of "ALOHA" products if offered with "ARROW" will see immediately that they have not got what they asked for.
- (6) The retail price of "ALOHA" Shirt is only under \$7.50 per piece while "ARROW" Shirt costs as much as \$17.00-\$18.00 each.
- (7) In Spelling, Phonetic, Design, Colour and Price the Applicant's Mark bears no resemblance at all to the Opponent's Mark and no person would be confused."

3. The Opponents' evidence consisted of a Declaration by Mr Fong Kang Chew, Manager of Dodge & Seymour Ltd, the exclusive agents in Hong Kong for the Opponents. The Applicant himself made a Declaration in reply, and in addition called, as an expert witness on the pronunciation of Cantonese, Professor Cheng Shui Sum, Professor of History of Chinese Literature at Canton College and Heung Kong College.

4. At the hearing Mrs Peter Wong appeared for the Applicant, Mr. J.C. Wilman for the Opponents.

5. The issue in this case is whether the mark "ALOHA" so nearly resembles the mark "ARROW" which is already on the Register in respect of goods of the same description, as to be likely to deceive or cause confusion, and is consequently prohibited from registration by Section 20 of the Trade Marks Ordinance.

6. Contrary to what is stated in para. 5 of the Counter Statement the Opponent's mark does not have an arrow

cutting through the word; it has an arrow below it thus

ARROW



7. The principles to be followed in considering whether one mark resembles another so closely as to be likely to deceive or cause confusion were summed up by Parker J. in Pianotist Co. Ltd's Application (1906) 23 R.P.C. 774 at p. 777, as follows: -

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case".

To this it is hardly necessary to add that the risk of confusion must not be too remote; there must be a reasonable likelihood of deception or confusion arising among a substantial number of persons if the mark is allowed to be registered. - Kerly, p. 217 & p. 618.

8. At first sight there would seem to be little chance of ARROW being confused with ALOHA. ARROW has two syllables with the stress on the first; ALOHA three syllables with the stress on the second. The difficulty, however, is that the Chinese, or at least the Cantonese, to whom the majority of the Opponents' goods under the Arrow mark are sold, have difficulty in pronouncing the letter R, and most of them pronounce it with an L sound. For this reason the Registrar has in the past refused to register "HALLOW" and "HARLOW" for shirts because of probable confusion with Arrow. Is there the same possibility of confusing Aloha with Arrow? The Applicant argued that there was not: firstly because Aloha is a three syllable word, secondly because the two words are pronounced in different tones.

9. Professor Cheng testified to the importance of tones in Cantonese, which is monosyllabic in character, every word consisting of a single syllable. The same syllable may mean different things when pronounced in different tones. It follows therefore that the Cantonese must be able readily to distinguish different tones, since otherwise ludicrous mistakes might be made. Their ears are therefore sensitive to tones, of which there are, according to Professor Cheng, four, which occur both in an upper and in a lower register. English words are

rendered into Cantonese by Cantonese words approximating in sound to the syllables. Sometimes a syllable can be represented by different Cantonese words. He said the correct pronunciation of Arrow in Cantonese was represented by the Chinese characters 鵝 盧 pronounced AH first tone, upper register, LO first tone, and according to my ear in the upper register, but here my ear has apparently deceived me, for when having the Chinese characters inserted in this decision, the LO was pronounced low, and as Mr. Chan in his declaration puts it in the fifth tone, which apparently corresponds with the Professor's first tone, lower register, and this is confirmed by Dr Eitel's Dictionary, I presume the Professor must have pronounced it in first tone, lower. The Opponents have, however, chosen to represent their mark by the characters 鵝 路. These, the Professor says, are pronounced AH first tone, upper register, LO third tone, upper register. As for ALOHA, he gives the correct pronunciation as 亞 AH, 3rd tone upper register, 撈 LO first tone upper register, 𠵼 HA first tone, lower register. There was no other word than 撈 that could give the right LO in Aloha. Tabulating these, we have the following stated to be the correct pronunciations:

Strictly correct pronunciation of Arrow,

鵝 盧 AH (1,u) LO (1,l)

Pronunciation of Arrow according to Chinese characters used by Opponents,

鵝 路 AH (1,u) LO (3,u)

Correct pronunciation of Aloha

亞 撈 𠵼 AH (3,u) LO (1,u) HA (1,l)

Thus, whichever way Arrow is pronounced by a Cantonese not knowing English, it is pronounced differently from the first two tones of Aloha.

10. Mr. Wilman referred to the tendency of persons using the English language to slur the terminations of words. That there is such a tendency has been recognized in many cases - see Kerly on Trade Marks, 7th Edition, page 624, but Professor Cheng says there is no such tendency in Cantonese, and the last syllable must be pronounced. Obviously this is essential in a monosyllabic language, but the aspirate 𠵼 "HA" pronounced in the lower register would naturally not be heard as distinctly as a word beginning or ending with a hard consonant.

11. In addition to the difference in pronunciation the Applicant sought to argue that there was no danger of confusion because first, the Opponents' mark was by reason of its enormous turnover very well known, and secondly, the Opponents' goods were sold to a different class of customer from that to which Aloha goods were sold. Arrow shirts cost \$17.00 to \$20.00 and were sold to middle class people; Aloha shirts cost about \$7.00 and were sold to lower class people. There is however no evidence before me as to the respective prices of Arrow and Aloha shirts, or as to the class of people to whom they are respectively sold. In any case, as Mr. Wilman countered,

people offered Aloha shirts at \$7.00 might think that they were cheap Arrow shirts, or Arrow shirts sold at a low sale price. The fact that the Arrow mark is very well known by no means negatives the possibility of deception or confusion. It is precisely because a mark is well known that some people attempt to imitate it and so get the benefit of the goodwill attaching to it, and the Reports of Patent Cases are full of cases where new marks have been held to resemble well known marks so closely as to be likely to deceive or cause confusion. There is no suggestion here of any deliberate attempt to deceive, but an innocent and accidental resemblance may deceive or confuse no less than a deliberate imitation.

12. In Aristoc v. Rysta (1943) 60 R.P.C. 87 at page 108, Luxmoore L.J. said:

"It is now well settled that the onus of proving that there is no reasonable probability of deception is cast on the applicant.

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution.

The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."

This passage was quoted with approval by Lord Maugham when the same case reached the House of Lords on appeal (1945) 62 R.P.C. 65 at page 72 and in the same appeal (at page 84) Lord Simonds said:

"The answer is necessarily one of first impression, It is easy perhaps to exaggerate the risk of careless pronunciation, but it may at least be said that the standard of ordinary speech is not the precise articulation of the perfect announcer and that the enquiry for one article or the other will not be made in the quiet atmosphere of the studio."

Although when deciding whether two marks are likely to be confused little is to be gained from decisions relating to other marks, it may be mentioned in passing that the final decision in this case was that Rysta, pronounced like vista with the accent on the first syllable, was likely to be confused with Aristoc although that is a three-syllable word with the accent on the A and an emphatic final syllable.

13. The two passages just quoted are directly in point here. By the nature of things the retail trade in shirts and other clothing is conducted personally by word of mouth. Mr. Fong has declared that the sale of goods in Hong Kong bearing the Opponents' Arrow trade mark amounts to approximately HK\$1,000,000 each year, and that the majority of these are sold to persons speaking the Cantonese dialect. It is reasonable to suppose that a substantial number of these persons know either no English, or only a little, and it is hardly to be expected that all of them know and use the correct Cantonese equivalent in sound of Arrow. They may not remember exactly how the word was pronounced by the salesman the last time they bought an article under the Arrow trade mark. Similarly people who have heard of or been recommended to buy Arrow shirts may not remember how it was pronounced to them. While therefore I have no doubt that Arrow and Aloha are readily distinguishable by Cantonese if spoken in an atmosphere of peace and quiet by an expert on pronunciation, I am not satisfied that they would be so distinguished when spoken, albeit correctly, in a busy shop or crowded street. When spoken incorrectly the risk would be so much the greater. It is therefore in my opinion likely that persons who have bought Arrow goods before, or have heard of the high reputation of Arrow goods, and wish to buy more, may be supplied, innocently or otherwise, with goods bearing the Aloha mark. It was suggested that in case of doubt the Customer could refer to the mark on the goods and so dispel it. That would, however, hardly suffice for someone who cannot read English. Both marks are of five letters beginning with A, and the arrow under Arrow is not really a feature that strikes the eye, resembling as it does a mere underlining. In his Counter-Statement the Applicant said his mark was blue, the Opponents' black. No evidence was, however, given on this aspect of the matter, and in any case by virtue of Section 11(2) of the Trade Marks Ordinance the Opponents' mark is deemed to be registered for all colours, and Mr. Wilman said the Opponents did not always use black.

14. I accordingly hold that the Applicant has failed to discharge the onus resting upon him to prove that his mark does not so nearly resemble the Opponents' mark as to be likely to deceive or cause confusion. The application is therefore refused.

15. I award the Opponents their costs to be taxed on the Original Jurisdiction scale, and direct that they be paid to them by the Applicant.

W. K. Thomson

(W. K. Thomson)
24th July, 1956.

