



IN THE MATTER of the Trade Marks Ordinance

AND

IN THE MATTER of an Application by Sun Wah

Hong to register the trade mark

"THE HARIBER LOTION" and Device in

Class 5 in respect of medicated skin

lotion for external use

AND

IN THE MATTER of an Opposition by Wah Yan

Hong Chemical Factory

D E C I S I O N

of

Mr P. Murphy, acting for the Registrar of Trade Marks.

Hearing on 16th December 1974.

Mr Mo Sheung Foon, one of the Applicants, appeared for them.

Mr R.I. Campbell of Messrs Johnson, Stokes & Master appeared for the Opponent.

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On 23rd August 1974, Mr Mo Sheung Foon and Leung Pak Wa trading as Sun Wah Hong of 138 Kilung Street 2nd Floor Kowloon (hereinafter referred to as "the Applicants") submitted an Application to the Registrar of Trade Marks (hereinafter referred to as "the Registrar") for the registration in Part A of the register of the words "THE HARIBER LOTION" and device in Class 5 in respect of medicated skin lotion for external use. A photocopy of the mark applied for is annexed as Appendix A.

The supporting Statutory Declaration made by Mr Mo Sheung Foon, one of the Applicants, on 23rd August 1974 stated that the mark had not hitherto been used by the Applicants either in Hong Kong or elsewhere but

that the Applicants intended to use it in Hong Kong if and when registered here.

On 28th September 1971, the Registrar wrote to the Applicants granting permission for advertisement of the application and the mark was duly advertised in the Gazette of 5th November 1971.

On 22nd December 1971, Mr Ho Man Sum trading as Wah Yan Hong Chemical Factory of 2-A Yung Shu Terrace 1st floor Kowloon (hereinafter referred to as "the Opponent") gave formal notice of opposition through his agents, Messrs Johnson, Stokes & Master. The grounds of opposition to the mark were as follows :

"(1) The said trade mark of the applicants is confusingly similar to the Trade Marks Nos. 474 of 1970 and 1226 of 1970 which are both registered in Class 5 - for "medicated tonic pills" and "medicated lotion" respectively - and of which I am the sole proprietor. The applicants are now applying to register their said mark for the same class and for the same description of goods as my own said registrations Nos. 474 of 1970 and 1226 of 1970 already cover. The applicants' said mark consists of a representation featuring two silhouetted figures wearing robes and head-dresses of an oriental design, facing each other and holding a smoking pot: this mark thus bears a great visual resemblance to my said Trade Marks Nos. 474 of 1970 and 1226 of 1970. Accordingly, if the applicants are allowed to register the said trade mark, it is highly probable that the public will be deceived and I will be injured in my trade and business.

(2) The applicants' said mark bears such a close resemblance to my said Trade Marks Nos. 474 of 1970 and 1226 of 1970, registered in Class 5 in respect of the same goods or class or

description of goods as those for which the applicants are applying to register the said mark, that the use of the applicants' said mark is calculated and/or likely to deceive the trade and the public into believing that the applicants' goods bearing their said mark are my goods, and therefore to cause confusion.

(3) Under my trading name of WAH YAN HONG CHEMICAL FACTORY, I have extensively used my said trade marks Nos. 474 of 1970 and 1226 of 1970 to denote my medicated tonic pills and medicated lotion. I have manufactured and sold these products in the Colony of Hong Kong since at least September 1969, and they are famous throughout the countries of South East Asia. My said trade marks have therefore become distinctive and indicate to the public that the medicated tonic pills and medicated lotion sold under these marks are manufactured and sold by my firm.

(4) The said mark of the applicants, in so far as it consists of the device as above mentioned in paragraph (1), is not registrable in that the requirements of the Trade Marks Ordinance Cap. 43 as to registrability are not satisfied.

(5) The said mark of the applicants is not registrable in that it is not entitled to protection in a Court of Law."

The counter-statement filed on 11th January 1972 set out the grounds on which the Applicants relied as supporting their application, as follows :

"The Hariber Lotion & Device which we apply for registration is practically irrelevant and dissimilar to the opponent's registered mark. The opponent's mark represents by one figure only, while our mark has two figures, whose costumes are utterly different from that of the opponent's. The two figures

appear on our mark hold an incense burner, while the opponent's holds a lamp. The hair styles between our mark and the opponent's are also different. There is no possibility of confusing the public whatsoever. The opponent's claim somewhat like to say that a dog and a cat look alike and cause misleading and confusions to the public, despite the fact that even a child can distinguish them right at sight."

The Opponent's evidence consists of two Statutory Declarations by himself dated 22nd February 1974 and 16th July 1974 respectively.

The Applicants' evidence consists of a Statutory Declaration by Mr Leung Pak-wa dated 2nd May 1974.

In his first Statutory Declaration, the Opponent again refers to the fact that he is the sole proprietor of the device trade marks registered in Hong Kong under reference numbers 474 of 1970 and 1226 of 1970. (Copies of the certificates of registration are annexed hereto as Appendices B and C respectively.) I consider that only trade mark reference number 1226 of 1970 (hereinafter referred to as "the registered trade mark") need be taken into account in my consideration of this case because it relates to almost exactly the same kind of goods as those covered by the specification in the mark applied for and in any case there is comparatively little difference between the two registered marks as can be seen from Appendices B and C.

The Opponent states that medicated tonic pills and medicated lotion bearing the said registered trade marks have been sold in Hong Kong under his trading name of Wah Yan Hong Chemical Factory since September 1969 and that annual sales have been as follows :

<u>SALE FOR THE YEARS</u>	<u>NUMBERS OF BOTTLES</u>	<u>HONG KONG DOLLARS</u>
1969 Sept. - Dec.	10,000	\$ 80,000.00
1970 Jan. - Dec.	42,000	336,000.00
1971 Jan. - Dec.	46,000	360,000.00

<u>SALE FOR THE YEARS</u>	<u>NUMBERS OF BOTTLES</u>	<u>HONG KONG DOLLARS</u>
1972 Jan. - Dec.	40,000	320,000.00
1973 Jan. - Dec.	50,000	410,000.00

He also states that details of annual advertising expenditure on these products are as follows :

<u>YEARS</u>	<u>HONG KONG DOLLARS</u>
1969	\$ 70,000.00
1970	170,000.00
1971	190,000.00
1972	190,000.00
1973	220,000.00

He claims that the public would be confused by the similarity between his registered marks and the mark applied for and exhibits samples of press advertising of the Applicants' proposed mark which, he claims, shows the similarity and visual resemblance to his registered marks.

In his second Statutory Declaration the Opponent again stresses his opinion that his registered marks and the marks applied for are so similar as to deceive or cause confusion and elaborates on his grounds for that opinion.

He also claims that the Applicants had placed goods, bearing the mark applied for, on the market in Hong Kong and that his solicitors called upon them to discontinue the use of the mark on the ground that they were passing-off their goods as his or as associated with his. He claims that the Applicants then approached him and asked him to take no official action in connection with the alleged passing-off and delivered up for destruction of a quantity of packing materials, wrappers etc. bearing the mark now applied for by the Applicants. He states that they have not since made any further use of, or sales of goods, bearing the mark applied for in Hong Kong.

In his Statutory Declaration, Mr Leung Pak-Wa confines himself to claiming that the mark applied for is not similar to the registered marks and to explaining his reasons for his view.

At the Hearing, the only additional evidence was the production by Mr Campbell for the Opponent of a sample of the lotion marketed by the Opponent and a sample of the lotion marketed by the Applicants. Mr Mo accepted that the sample of the Applicants' product was a genuine one. In each case, the product is a small spray container filled with a lotion and packaged in a small transparent plastic box. The instructional leaflet enclosed with each explains in coy fashion, and fractured English, that the purpose of the product is to promote male virility. ("To stand the meagre and timid. Up rise the debilitated and strengthen the tired.")

Both sides concentrated their arguments at the Hearing on the similarities/differences, as appropriate, between the respective marks. Neither side presented any independent evidence as to the circumstances of the trade.

Having regard to the number of years over which goods bearing the registered marks have been sold in Hong Kong and the fact that the sales appear to have been fairly substantial, I consider that the Opposition must be considered under both Sections 12(1) and 20 of the Ordinance. The questions to be answered under the corresponding Sections 11 and 12(1) of the Trade Marks Act 1938 were authoritatively summarised in Smith Hayden & Co. Ltd.'s Application (1946) 63 RPC 97 by Evershed J. at page 101 and are reproduced in "Kerly's Law of Trade Marks and Trade Names", Tenth Edition (hereinafter referred to as "Kerly"), section 10-02 (pages 172-174).

I consider that the first point to be decided in considering this case is whether the two marks are to be used on the same goods or goods of the same description. The matters to be taken into account in

considering this question are set out in Jellinek's Application (1946) 63 RPC 59 and are repeated in Kerly, 10-12, (page 162). However, I do not think that in this case there is any difficulty in deciding that the goods covered by the mark applied for ("Medicated Skin Lotion for External Use") are the same as the goods covered by the registered mark No. 1226 of 1970 ("Medicated lotion") or at least are goods of the same description.

I also consider that the onus is on the Applicants to prove that the Opposition is not justified. I base this on the following in Kerly, 17-03, (page 451) :

"(1) On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of section 11 and of section 12(1).

In such cases the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not reasonably likely to deceive or cause confusion, so that refusal to register does not involve the conclusion that the resemblance is such that either an infringement action or a passing-off would succeed. In cases in which the tribunal considers that there is doubt as to whether deception is likely the application should be refused."

The rules for comparison of two words alleged to have a deceptive resemblance are set out in Chapter 17 of Kerly.

The first important question is: "Who are the people whom the mark must be calculated to deceive". In Kerly, 17-05 (pages 453 and 454) the answers given by the Courts in past cases are summarised as: "All of those who are likely to become purchasers of the goods upon which the marks are used, provided that such persons use ordinary care and intelligence". At 17-06 (page 454) Kerly states:

"It is clearly not enough to show that retail dealers buying goods for resale would not be deceived, since they might themselves

fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers."

In this case, I do not think that there is any likelihood of the retail dealers, i.e. retail chemists or pharmacists, being confused by the two marks.

As for the public, it seems to me clear that the vast majority of potential purchasers will be adult, probably mature, men. I also think it reasonable to assume that most of the customers will be Chinese because it is clear from the samples of newspaper advertising and the samples of the goods produced that the goods are aimed almost entirely at the Chinese section of the population. This is to a certain extent confirmed by the fact that that in almost seven years of reading the English press in Hong Kong, I cannot recall ever having seen an advertisement for this type of lotion.

In his second Statutory Declaration the Opponent specifically referred me to an extract from Kerly 17-08 (pages 456-458). I think that this section in Kerly is very relevant to the present case and I found the following, together with the reported cases referred to therein, particularly helpful in reaching my decision in this case :

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different

positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.

When the question arises whether a mark applied for bears such resemblance to another mark as to be likely to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different. On the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same. Thus it is clear that a mark is infringed if the essential feature, or essential particulars of it, are taken. In cases of device marks, especially, it is helpful before comparing the marks to consider what are the essentials of the plaintiff's device;"

The Opponent argues that the essential feature of his marks is "a silhouette figure wearing a robe and headdress of an oriental design and holding a magic lamp with incense emanating from the lamp". He also argues that the essential features of the Applicant's mark are "two

silhouette figures facing each other wearing robes and headdresses and holding a burner with incense emanating from the burner". At the Hearing, Mr Campbell elaborated on this argument by claiming that in both marks the figures are all wearing Arabian dress.

In his Statutory Declaration, Mr Leung Pak Wa argues that "our (the Applicants') mark bears two figures, different costumes, four hands holding the same burner, even the headdress between theirs and ours has little likelihood". At the Hearing he claimed that the figure in the Opponent's registered mark is wearing Indian dress while the figures in the Applicants' mark are wearing Arabian dress.

My own view is that most people would tend to think that the figures in both marks are dressed in Indian style. I think I am supported in this view by the fact that the plastic boxes for both the Applicants' and the Opponent's product have the Chinese characters for "Indian Holy Oil" prominently displayed above the device marks. In any case, we are all agreed that the impression in both marks is of figures in oriental dress.

I think that if the two marks are considered critically side by side then, as Mr Mo claims, various points of difference can be seen. As Kerly points out at 17-08, however, this is not the end of the matter and I must also consider the "ideas" of the marks.

I consider that the "idea" or essential feature of the registered mark is an oriental figure in a seated position holding a lamp which is giving off smoke or incense.

At the Hearing, Mr Campbell claimed that his client is the only manufacturer of this type of product who uses an Arabian (Indian in my opinion) with a lamp as a device mark and that it is this which gives the registered trade mark its distinctiveness. Mr Mo disagreed with this and said that other manufacturers have in the past used such a device but he did not produce any evidence to support this claim. In the absence of such

evidence, I do not see how I can regard the device of a seated oriental figure with a lamp/incense burner as being in any way common to the trade and I agree with Mr Campbell's view that users of the Opponent's goods very probably associate the idea of a seated oriental figure with a lamp/incense burner, with the Opponent's goods.

I think that this is also the general idea conveyed by the Applicants' mark. True, there are two figures wearing a rather different type of clothing and a different type of incense burner. Nevertheless, I consider that the overall impression of the mark is still that of seated oriental figures with an incense burner.

In these circumstances, I have come to the conclusion that there is at least some danger of confusion between the device part of the mark applied for and the registered trade mark. As is pointed out in Kerly at 17-03, quoted on page 7 of this decision, the onus is on the Applicants to satisfy me that the mark applied for is not reasonably likely to deceive or cause confusion and that where I consider that there is doubt as to whether deception is likely I should refuse the application. I cannot accept that the Applicants have discharged the said onus and accordingly I hereby refuse this application in so far as it relates to the device part of the mark.

As no substantial use of the device part of the mark had taken place in Hong Kong before the date of application for registration, consideration of the application under Section 22 of the Ordinance, "honest concurrent use", does not appear to arise.

I find that the Opponent is entitled to an award of the costs of the Opposition and any representations which either party may wish to make as to the amount of those costs will be considered if received within 21 days from the date of this Decision and that failing such representation, or subject to any representation calling for special treatment, costs will be calculated on the usual scale.

I should also mention that Mr Campbell put it to me at the Hearing that I should have regard to the general "get-up" of the packages containing the respective samples of the Applicants' and the Opponent's goods. I take the view, however, that my function is to compare the mark applied for with the Opponent's registered mark and that the question of "get-up" of packaging is not a consideration which I can validly take into account and I have not done so in this case.

The Opponent has not, as far as I am aware, objected at any time to the words "THE HARIBER LOTION" and Mr Campbell did not address me regarding these at the Hearing. I confirm that these words are acceptable for registration.

h  
( P. Murphy )  
Senior Solicitor  
14th February 1975

THE HARIBER  
LOTION.



K. K. Lam  
Assistant Registrar

Misc. 455/7. refers

TM-210 26/62  
(file P2 @ B/5)



# TRADE MARKS ORDINANCE

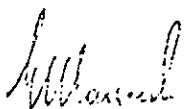
## CERTIFICATE OF REGISTRATION

It is hereby certified that the Trade Mark a specimen of which is herewith annexed has been registered in Part A of the Register in the name of HO MAN SUM trading as WAE YAN HONG CHEMICAL FACTORY, of 2-A, Yung Shu Terrace, 1st floor, Kowloon, Hong Kong,

in Class 5 under No. 474 of 1970 as of the date of 19th November, 1969  
in respect of medicated tonic pills.

Scaled at my direction this 18th day of April, 1970.

Trade Marks Registry,  
Registrar General's Department,  
Hong Kong.

  
E.R. MAYCOCK  
for Registrar General  
(Registrar of Trade Marks)



- Note: — 1. Registration is for a period of 7 years from the date first above-mentioned. At the end of that period it may be renewed for 14 years, after which it may be renewed successively for further periods of 14 years.
2. This certificate is not for use in legal proceedings or for obtaining registration abroad.
3. Upon any change of ownership of this trade mark, or change in address, application should AT ONCE be made

TRADE MARKS ORDINANCE


CERTIFICATE OF REGISTRATION

It is hereby certified that the Trade Mark a specimen of which is herewith annexed has been registered in Part A of the Register in the name of HO MAN SUM trading as WAH YAN HONG CHEMICAL FACTORY, of 2-A, Yung Shu Terrace, 1st floor, Kowloon, Hong Kong,

in Class 5 under No. 1226 of 1970 as of the date of 12th February, 1970 .  
in respect of medicated lotion.

Scaled at my direction this 26th day of September, 1970 .

Trade Marks Registry,  
Registrar General's Department,  
Hong Kong.

  
E.R. MAYCOCK  
for Registrar General  
(Registrar of Trade Marks)



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2. This certificate is not for use in legal proceedings or for obtaining registration abroad.
3. Upon any change of ownership of this trade mark, change in address, application should AT ONCE be made to the Registrar to register the change.

P.T.O.