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Grounds of Decision

Trade Mark "KARATE" in Class 25

Application No. 365 of 1981

On 10th February 1981 an application ("the original Application") was made by Mr. Ishwar Mulchand Anandani trading as Renish Trading Co. ("the Applicant") for registration of a trade mark in Part "A" of the Trade Marks Register. The class applied for was Class 25 and the goods in respect of which the trade mark was applied for were jeans and jackets. This original application featured the word "KARATE", a device, the Chinese letter "大" (meaning "big") and the symbol "R". Subsequently, Messrs. Hampton, Winter & Glynn, the solicitors formerly acting for the Applicant, filed a Form TM - No. 3 (Request for Correction of Clerical Error in Register or for Amendment of Application) so that the form of mark applied for was amended to "KARATE".

2. On the 27th March 1981, the Trade Marks Registry wrote to the Applicant objecting to the mark for the following reason :-

"The word "KARATE" is objectionable under Section 20 of the Ordinance because of its conflict with "CARAT" Trade Mark No. 725 of 1980 registered in respect of "ready made garments" in the name of Mideast Mercantile Limited of Ho Lee Commercial Building, 12th Floor, Room "F", 38-44, D'Aguilar Street, Central District, Hong Kong. This word is further considered to be descriptive of the character of the goods in that they are of a similar design or style as the clothes people wear in Karate fighting. As such, registration is not allowed under Section 9(1)(d) of the Trade Marks Ordinance."

3. On the 18th December 1981 Messrs. Stevenson Low & Co, solicitors, advised the Trade Marks Registry that they had been newly instructed by the Applicant.

4. On the 23rd January 1982 Messrs. Stevenson Low & Co. wrote to the Trade Marks Registry setting out arguments why there was no possibility of confusion between the marks "KARATE" and "CARAT" and why the "KARATE" had no direct reference to the quality of the goods. I refer to the following passages from this letter :-

"In connection with your objection to the registrability of the captioned trade mark on the ground that it is in conflict with "CARAT" Trade Mark No. 725 of 1980, we submit that there is no possibility of confusion at all between the two marks.

"CARAT" is a two-syllable word, and in pronunciation, the principal stress is on the first part of the word (i.e. \`carat).

"KARATE" is a three-syllable word and in pronunciation, the principal stress is on the second syllable and the subordinate stress is on the first syllable (i.e. \`ka\`rate).

Phonetically, therefore, we would submit that there is a clear distinction between the two marks in question and there is no possibility that the general public could in any way be misled.

The word "carat" is defined in the English Dictionary to mean a "unit of weight for precious stones" or a "measure

of the purity of gold". "Karate" however is defined as a "Japanese method of unarmed combat using blows made with the sides of the hands, foot, head or elbow". As the two words are substantially different in connotation, we submit that the two marks would not raise any form of confusion in the minds of the general public, and there being no resemblance at all between them we would further submit that our client's proposed mark is not in any way calculated to deceive the public.

In respect of your objection on the basis of section 9(1)(d) of the Trade Marks Ordinance, we would point out that our client's mark is used on denim jeans only.

Jeans are never considered by the general public as a special garment worn for karate fighting, so the proposed mark "KARATE", as represented to the public at large, would not be recognised as a descriptive name for the jeans on which the mark is used.

As denim jeans are never referred to or described as "karate", it is our submission that the word has no direct reference to the character or quality of our client's goods and any reference, if at all, it only vague and indefinite, and as such is not sufficient to render a mark unregistrable."

5. On 18th February 1982, the Trade Marks Registry wrote to Messrs. Stevenson Low maintaining its objections to the mark. I think it important to quote the following passages from this letter :-

"Your submissions relating to the phonetical differences between the subject "KARATE" and the cited "CARAT" Trade Mark have been considered. Whilst I cannot disagree with

you that correctly KARATE is 3-syllabled with the accent placed on the second syllable whereas the cited mark is 2-syllabled with the emphasis placed on its first syllable, I also have to take into account the high incidences of inaccurate, casual and mispronunciation in Hong Kong when the two words KARATE/CARAT could be pronounced virtually alike. In same connexion, I would refer you to the following passage of Luxmoore L.J. in the Rysta's Ltd's Application 60 RPC 87 (at page 108) :-

"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."

Visually, the two words KARATE/CARAT are confusingly similar or alike since the differing first letters K/C are invariably taken as interchangeable in use whereas the additional terminal "E" in the subject mark does not override their common essential identity i.e. "K(C)ARAT(E)". In spite of having very different meanings, such will not positively ensure that in consequence of the visual and phonetical resemblance between KARATE/CARAT, there would not any practical incidences of confusion or deception among the general local purchasers who have only an elementary knowledge of English.

I also maintain that the subject mark "KARATE" has a direct reference to the character of jeans or similar types of casual clothing. The use of the subject mark onto many varieties of clothing would lead people to think that they are intended or meant for wear in karate fighting whether such is the case or not. In the contrary case, the use of the subject mark will become deceptive and thus it has to be open to objection under Section 12(1) of the Ordinance."

6. On the 2nd June 1982, Messrs. Stevenson & Co. (formerly Messrs. Stevenson Low & Co.) wrote to Mideast Mercantile Limited, the owners of the mark "CARAT", seeking their written consent to the use of the mark "KARATE" on dress, shirts and jeans. This letter was copied to the Register of Trade Marks.

7. On the 7th June 1982, Mideast Mercantile Limited wrote to Messrs. Stevenson & Co., copied to the Registrar of Trade Marks stating :-

"It is wrong assumption that we are using our brand "CARAT" in children wear only. We are using our brand in all kind of garments including jeans and shirts and T-shirts. Your client wanted a favour but now knowing the intention in details I find it is hard to give any favour as "KARATE" has pronunciation like "CARAT".

So we will not yield our rights on this subject."

8. By a letter dated 7th October 1982, Messrs. Stevenson & Co. applied for a hearing under rule 18 of the Trade Mark Rules.
9. A hearing took place before me on 15th December 1982 at which the Applicant was represented by Mr. Anthony Rogers of Counsel, and Miss Mimi Chan of Messrs. Stevenson & Co.
10. Mr. Rogers opened his submissions on behalf of the Applicant by saying that there were two points to be decided. These were :-
 - (a) The question of the conflict with "CARAT".
 - (b) The question of the descriptive element in the mark "KARATE".
11. Mr. Rogers said that the look and sound of the words "karate" and "carat" were similar. But he said that if one listened to the words, there was no confusion. The word "karate" would be confused, if anything, with Judo. Mr. Rogers said he had never heard a man use the word "karate" and not know what it meant; the connotation was kung fu.
12. Mr. Rogers submitted that the final syllable of the word "karate" was important. "Carat" was a word associated with gems and gold; the idea was different.
13. Mr. Rogers referred to the ACEC TM case (1965) RPC 369, a copy of which he handed to me. He read the third para. on page 372.

14. Mr. Rogers then referred to the MEM TM case (1965) RPC 347. He read the 3rd and 4th paragraphs on page 349.

15. Mr. Rogers then referred to the case of Aristoc V Rysta Limited 62 RPC 65 case which had been cited by the Trade Marks Registry. He said "Rysta" and "Aristoc" were not common words in the English language; there was a great chance of confusion. But as soon as one saw the word "karate", one thought of a sport; as soon as one saw the word "carat", one thought of something valuable.

16. Mr. Rogers then referred to various paragraphs of Kerly's Law of Trade Marks (10th Edition), namely paragraphs - 17.08, 17.17, 17.23, 17.24 and 17.28. As regards 17.23 (which deals with the question of imperfect recollection) Mr. Rogers referred to the Aristoc case and said that where words are recognised in the English language e.g. karate/carat, imperfect recollection was not so important. Foreigners should be able to recognise the words "karate" and "carat" even though they cannot speak English. Youngsters would recognise the word "karate".

17. Mr. Rogers then referred to Ardath Tobacco Co. V W. Sandorides 1924 4 RPC 50. He read from the headnote on page 50, and then read paragraphs 2 and 3 on page 61 of that case.

18. Mr. Rogers said that in the 3 cases i.e. ACEC, MEM and Ardath cases, the marks were similar. But Mr. Rogers said that one had to consider the use of the marks in a normal and fair manner. As regards "KARATE" and "CARAT", these were recognisable English words people could associate with. If one assumed that both words were used on sets of jeans, there would be no confusion between "KARATE" and "CARAT".

19. There was then a discussion regarding the Trade Marks Registry's objection on the descriptive element in the mark (referred to in the final paragraph of the extract quoted above at para. 5). Mr. Rogers said that any word could be descriptive of goods. He mentioned, en passant, that the word "carat" was more descriptive of jeans; at this point Mr. Rogers referred to the first jeans made by Levi-Strauss from tenting material, and said that these jeans had studs on them.

20. I said that one of the main questions troubling the Trade Marks Registry was that if the mark "KARATE" was not used on karate fighting suits then the mark could be deceptive. Mr. Rogers said that anyone who wanted a karate fighting suit would not buy a pair of jeans. Mr. Rogers referred here to the Galvalloy Trade Mark RPC 1963 34. He read the headnote, and also the last paragraph on page 38, and its continuation on page 39. Mr. Rogers said that one had to look at the people (whether dealers or ordinary people) who purchased jeans and jackets. Would they be confused by the mark "KARATE"? Even beginners in the sport of karate would not be confused, if one considered this matter realistically. Mr. Rogers here referred to paragraph 829 of Kerly.

21. Mr. Rogers finished his submissions by saying if the owners of the "CARAT" mark objected to "KARATE", it would be open to them to take out opposition proceedings.

22. The hearing adjourned at 10:00 a.m.

23. On the 31st January 1983 I wrote to Messrs. Stevenson & Co. setting out my decision, and I quote the following from my letter :-

"Having heard and given careful consideration to all the submissions made in support of the application, I confirm my

agreement with the objections taken by the Trade Marks Registry in paragraphs 2 and 3 of their letter to you dated 18th February 1982. However, I agree that the final paragraph of the said letter may be disregarded.

As you know, if you object to this decision you may, within one month from the date of this letter, make an application in terms of Trade Marks Rule 20 to have stated in writing the grounds of, and the material used by me in arriving at, this decision."

I have now been asked to give the grounds for my decision.

24. Section 20 of the Trade Marks Ordinance provides :-

"Except as provided by Section 22 no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion."

Section 12 of the Trade Marks Ordinance provides :-

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design."

25. I believe that pursuant to the concession I have made in my letter dated 31st January 1983 (and quoted above at para. 23) the only question is whether allowing "KARATE" on to the Trade Marks Register will offend against Section 20 of the Trade Marks Ordinance. Would the registration of "KARATE" be an act likely to deceive or cause confusion because of the prior registration of "CARAT"? I believe that there are two areas where this

deception or confusion could occur: the visual and the phonetic. But before I deal with this I shall discuss the words "karate" and "carat" and their meaning.

26. Karate is the romanised version of a Japanese word defined in the Supplement to the Oxford English Dictionary (First Edition at page 466) as follows :-

"Karate (Kara-ti)(Jap;lit "empty hand")

A Japanese system of unarmed combat in which hands and feet are used as weapons. Also attrib esp. Karate chop, a sharp slanting blow with the hand."

27. In Webster's New Ideal Dictionary (1978 Edition at page 284), the following definition appears :-

"Ka-ra-te Kə-rat-ē - a Japanese system of self-defence without a weapon."

28. It appears that even the dictionaries are not in agreement as to how this Japanese word should be pronounced in English. I have always used the pronunciation suggested by Webster, with an emphasis on the final "e". It is also my understanding that the word is pronounced by the Japanese in a manner which, if romanised, would read "karatair".

29. The word "carat" is defined by The Concise Oxford Dictionary (6th Edition) as "1. measure of weight for precious stones, 200 milligrams.

2. measure of purity of gold, pure gold being 24 carats."

30. Visually, the words "karate" and "carat" contain differences; one begins with the letter "k" and the other, the letter "c"; "karate" ends with the letter "e". Notwithstanding these differences I think it true to say that, considered as a whole (see Rule 17.17 in Kerly, page 465) there is a similarity in the shape and balance of both words. I refer here to the "CHEMODAN" Trade Mark (1965) RPC 351. Here the application to register the mark "CHEMODAN" for metal and plastic pipes was opposed by the owners of the

mark "CHEMIDUS". The registration of "CHEMODAN" was refused, inter alia, on the ground that "the two marks had the same balance and shape with visual and phonetical similarity, leading to the possibility of deception and confusion." (page 351) This similarity in shape and balance is important, particularly when one takes into consideration the concept of imperfect recollection. I refer to paragraph 17.23 of Kerly's Law of Trade Marks, at page 469, from which I quote the following :-

"The question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection."
(per Sargant J., Sandow's Appn 1914 31 RPC at page 205)

31. During the course of the hearing, Mr. Rogers mentioned, as a differentiating feature between both marks, the separate ideas each mark represented (which I have referred to in paragraphs 11 and 12 above). It is, of course, true that the words "karate" and "carat" each have separate meanings in the English language. But one must bear in mind that the vast majority of people in Hong Kong have Cantonese as their mother tongue and may not necessarily be familiar with the meaning of "karate" and "carat" in the English language. As Kerly puts it, at para. 17.29, "Marks which are readily distinguishable by Englishman, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different characters and in a different manner." In my view,

this diminishes the impact of arguments based on "the idea of a mark" as a means of differentiating the "KARATE" and "CARAT" marks in the eyes of the public.

32. Mr. Rogers mentioned the "ACEC", "MEM" and the "Ardath" cases. In the "ACEC" and "MEM" cases, the choice was between a word which had meaning in English, and another word construed as a series of initials. These cases are not on all fours with the case before me, which involves two pronounceable words rather than one word and a set of initials. Meaning was clearly an important factor in distinguishing "ACEC" and "ACE", and "MEM" and "GEM"; but I have already explained why meaning or the idea of the mark has a reduced impact in a society where the majority of people have Cantonese as their mother tongue. I do not find the Ardath case of great importance, even on the subject of "the idea of a mark" as a means of distinguishing a trade mark. The idea of a particular kind of repetition put forward by the Plaintiff Company was rejected since, as Tomlin J. put it, "The truth is that the Plaintiff Company seek to establish that their Trade Mark of three nines gives them in effect a monopoly in a repetition of, nines. I do not think that this claim can be sustained" (at page 61)

33. I turn to consider the question of phonetic confusion. where, in my view, the potential for deception or confusion is even greater. I have alluded earlier to the fact that Cantonese is the mother tongue for the majority of people in Hong Kong. For many, English is a second language taught in schools, but not necessarily spoken outside school. Such people may not know how the word "karate" is pronounced in English and many simply pronounce "karate" in the same manner as "carat". Or he or she, applying the English lessons taught in the classroom, could give the last three letters of "karate" i.e. ate, the same pronunciation one would give to the English words "rate" or "nominate"; this would give a pronunciation very close

to "carat". At this point, I feel it important to recall the words of Luxmoore J's in Rysta Limited's Appn (1943) 60 RPC 87, at page 108 :-

"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."

34. As regards my reasons for conceding that the arguments of the Trade Marks Registry stated in the final paragraph of its letter of 18th February 1982 to Messrs. Stevenson, Low & Co. (quoted in para. 5 above) should be disregarded, I refer to paragraphs 19 and 20 above and confirm that I agree with the views of Mr. Rogers.

R. J. Perera
(R.J. Perera)
Senior Solicitor
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