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IN THE MATTER of the Trade Marks Ordinance (Cap. 43)

AND

IN THE MATTER of an Application by Mr. Manuhar Mohinani sole proprietor of Shiva Exports for the registration of trade mark Pending Application No. 2802Q/1981 "LONDON BRIDGE" and trade mark Pending Application No. 2802R/1981 "LONDON BRIDGES" both in Class 25 in respect of "all kinds of clothing" in Part A of the Register

D E C I S I O N

of

Miss A.C. Waters acting for the Registrar of Trade Marks at a Hearing held on 8th July 1982.

Mr. Garland, instructed by Messrs. Robertson Double & Boase, appeared for the Applicant.

On the 1st October 1981 Mr. Manuhar Mohinani sole proprietor of Shiva Exports (hereinafter called "the Applicant") of 802 Humphreys Building, 11 Humphreys Avenue, Kowloon, Hongkong applied through his agents, Messrs. Robertson Double & Boase, Solicitors by an Application dated 26th September 1981 for registration in Part A of the Register of the marks "LONDON BRIDGE" and "LONDON BRIDGES" in Class 25 in respect of "all kinds of clothing".

The marks are in the following forms :

P.A. No. 2802Q/1981



P.A. No. 2802R/1981

LONDON BRIDGES

The two applications were supported by Trade Mark Forms 4 dated 26th September 1981 made by the Applicant. In respect of both applications no user in Hong Kong or elsewhere was claimed prior to the date of the Application and no registration was claimed elsewhere.

On the 15th February 1982 the Trade Marks Registry (hereinafter called "the Registry"), replying both to applications the subject of these proceedings as well as to other applications by the Applicant, refused registration of the marks in the following terms:-

"Re: Trade Marks "LONDON BRIDGE & eagle device",
"LONDON LEE", "LONDON BRIDGE" and
"LONDON BRIDGES" in Class 25

With reference to your applications on Forms TM-No. 3 dated 26th September 1981, I would advise you that I am unable to proceed with these cases because I have also received an application for registration of Trade Mark "LONDON BRIDGE & flag device" under Pending Application No. 3264 of 1981.

This application was filed in the name of KENZAR LTD. of 803, Mary Bldg., 71-77 Peking Road, Hong Kong in respect of "all type of garment".

In view of the proximity of receipt of the applications, I must keep them as co-pending under Section 21 of the Ordinance and refuse to register any of the marks applied for until your clients' rights and that of KENZAR LTD. have been determined by the court or settled by agreement in a manner approved by the Registrar.

In this connexion, I am writing a similar letter to Messrs. Kenzar Ltd.

/3 ... As

As regards the registrability of the above marks themselves, please be advised as follows :-

- (i) "London", "Bridge", "Bridges" and "Lee" are surnames and the term "London Bridge" also carries a geographical signification. As such, registration cannot be allowed under Section 9(1)(d) of the Ordinance. Details of incidence of "LONDON", "BRIDGE", "BRIDGES" and "LEE" as surnames are quoted at the end of the letter for your reference.
- (ii) The use of the term "London Bridge" together with the British flag device which connotes a British origin of the goods is deceptive, thus running contrary to Section 12(1) of the Ordinance.
- (iii) The British flag device is unregistrable under Trade Marks Rule 4(b).
- (iv) The words "made in H.K." are indistinctive for registration.
- (v) The marks are in conflict with "LONDON PRIDE" Pending Application No. 2882 of 1980 proposed to be registered in respect of "articles of clothing" filed by Messrs. Deacons, Solicitor, on behalf of William Hollins & Company Limited, of Nottingham Road, Somercotes, Derbyshire, England.
- (vi) Trade Mark "LONDON LEE" is further in conflict with :-

"Lee" Trade Mark No. 357 of 1978 registered in respect of "jeans, T-shirts, pantsuits, overalls, shirts, sports shirts, utility pants and utility jumpsuits, jackets, belts, skirts and shorts" in the name of THE H.D. LEE COMPANY, INC., of 9001 West 67th Street, Merriam, Kansas, U.S.A.

"Lee" Trade Mark No. B366 of 1972 registered in respect of "jackets, trousers and jeans", "Lee Westerner & device No. 747/72," "Lee Riders and device" No. B358/78 registered in respect of "trousers and jeans" in the name of THE H.D. LEE COMPANY, INC., of 9001 West 67th Street, Merriam, Kansas, U.S.A.

As regards the eagle device in Trade Mark "London Bridge with eagle device", I shall disclose to you its registrability in a separate letter.

| <u>"LONDON"</u> | <u>"BRIDGE"</u> | <u>"BRIDGES"</u> | <u>"LEE"</u> | <u>Name of Telephone Directories</u> |
|-----------------|-----------------|------------------|--------------|--------------------------------------|
| 46 | 100 | 129 | 1,550 | London |
| 94 | 18 | 21 | 1,600 | Manhattan |
| 48 | 5 | 55 | 1,700 | Los Angeles |
| 89 | 6 | 14 | 400 | Queen's |
| 10 | 2 | / | 7 | Paris |
| / | 1 | 1 | 2 | Rome |
| 1 | / | / | / | Berlin |
| / | 5 | 1 | 54,100 | Hong Kong " |

The Applicants did not make any considered reply in writing to the objections raised by the Registry but on the 21st May 1982 submitted a request for a Hearing which took place on the 8th July 1982 as already stated.

The Application filed in the name of Kenzar Ltd. Pending Application No. 2364 of 1981 was withdrawn on the 17th April 1982 and as a result the citation under S. 21 of the Trade Marks Ordinance (hereinafter called "the Ordinance") has been withdrawn.

The Trade Mark "London Pride" referred to above under Pending Application No. 2882 of 1980 matured to registration on the 31st March 1982. Leave to advertise the mark was given by the Registry on the 21st September 1981 and was duly advertised in the Gazette on the 2nd October 1981. The mark was registered under Number 911 of 1982 in Part A of the Register in respect of "Articles of Clothing" subject to a disclaimer of the word "London" and subject also to a condition that the mark was to be used only in relation to goods manufactured in London, England.

I set out below such of the objections made by the Registry to the Application for registration of the two marks 'London Bridge' and 'London Bridges' as were still outstanding at the date of the Hearing :

- (1) That the marks consist of surnames "London", "Bridge" and "Bridges" for the purposes of S. 9(1)(d) of the Ordinance.

- (2) That the marks "London Bridge" and "London Bridges" are geographical names for the purposes of S. 9(1)(d) of the Trade Marks Ordinance (hereinafter called "the Ordinance").
- (3) That the marks used on goods in Hong Kong would be deceptive for the purposes of S. 12(1) of the Ordinance.
- (4) That the mark conflicts with the trade mark London Pride 911/82 registered in Class 25 in Part A in respect of 'articles of clothing' under the provisions of S. 20 of the Ordinance.

On the 7th July 1982 the Applicant lodged with the Registry through his Agents a Statutory Declaration made by the Applicant on the same day.

Mr. Garland submitted that this evidence showed the Applicant's trading activities and was relevant to these proceedings and I agreed that the evidence could be accepted and considered at the Hearing.

S. 17(1) of the Ordinance provides, inter alia, that the trade mark when registered shall be registered as of the date of the application for registration. I consider it is well settled that for the purposes of S. 9 and S. 22 of the Ordinance in addition to S. 10(1) of the Ordinance, I can only take into account actual user of the goods prior to the date of the Application.

I am supported in this view by para. 8-39 of Kerly's Law Trade Marks (10th Edition) which states as follows :-

"Date at which mark must be distinctive

The date at which the distinctiveness of a mark must be established is the date of the application. Evidence as to subsequent events may, however, be admissible as throwing light on the question."

The Applicant's Declaration contained, inter alia, the following statements insofar as they relate to the Applications the subject of these proceedings :-

- (1) The Applicant stated that he had carried on the business, as sole proprietor, of Shiva Exports since March 1980 and that the principal activity of the business was that of the ordering and purchasing of clothing in Hong Kong for export sales.

- (2) He stated that he had been using the mark "LONDON BRIDGE" and "BRIDGE device" for a period exceeding 2 years from the date of making the Declaration and that the total sales of goods by reference to these marks were as shown below :-

| <u>1980</u> HK\$ | <u>1981</u> HK\$ | <u>1982 (Up to 30.6.82)</u> HK\$ |
|---------------------|---------------------|-------------------------------------|
| 2,350,639.60 | 11,700,015.90 | 11,711,499.65 |

- (3) He claimed that sales under the marks the subject of the applications were made world-wide as well as in Hong Kong and all the sales were channelled through Hong Kong. He also stated that he had made applications to register the trade marks in the various countries with a view to exporting the goods the subject of these applications. These countries included United Kingdom, Australia, France, West Germany, Portugal, Cyprus and Greece.
- (4) He stated that considerable amounts were paid by way of advertising the marks to promote the Company's goods and that he had calculated that for the calendar periods 1981 and 1982 (up to the 30th June) the Company has spent the following by way of advertising on the relative promotional media as indicated :

| | <u>1981</u> HK\$ | <u>1982 (Up to 30.6.82)</u> HK\$ |
|--------------------------------|---------------------|-------------------------------------|
| Printed Posters & Calendars | 15,915.00 | 37,810.00 |
| Printed Shopping Bags | 9,078.40 | - |
| Promotional Key Chains | 73,367.50 | 90,677.75 |
| Promotional Belts | 34,698.51 | 76,698.42 |
| | <u>133,094.41</u> | <u>212,186.17</u> |
| | ===== | ===== |

Total of both 1981 and 1982 = HK\$345,280.58.

- (5) The Applicant disputed the view that the mark "LONDON BRIDGE" had a "geographic" signification as he did not believe that "LONDON BRIDGE" was a particular region but rather was a description of a monument such as the "Eiffel Tower", which he had understood from his solicitors, was registered as a trade mark in class 23 of Trade Mark No. 772 of 1977 registered on the 15th December 1976.

The following items were exhibited to the Statutory Declaration :-

- (i) Exhibit marked MM1 contained copies of Invoices showing sales to various parts of the world for articles of clothing, mainly jeans marked "Brand : London Bridge". The earliest of these invoices was dated 23rd June 1980.
- (ii) Exhibit marked MM2 showed a plastic bag with the mark "London Bridge" in the form applied for together with a device, a pair of jeans on which the word "London Bridge" appears in various forms and with various devices and examples of the mark as shown on posters etc.
- (iii) Exhibit marked MM3 contained copies of invoices relating to orders for polythene bags, key rings etc. These invoices are dated from August 1981 to June 1982.
- (iv) Exhibits marked MM4 and MM5 are not relevant to these proceedings.

I comment on various aspects of this evidence as follows :-

- (i) The user claimed is in respect of the mark "London Bridge" only and Mr. Garland confirmed at the Hearing that none of the evidence related to the mark "London Bridges".
- (ii) Mr. Garland submitted that the evidence related to export sales and that such sales fell within the provisions of S. 39(1) of the Ordinance. I agree with this view.

- (iii) According to the evidence the Applicant commenced his business in March 1980 and claimed user of the mark "London Bridge" for a period of two years prior to the date of the Declaration. This would mean user commenced in approximately July 1980. The sales figures given are from 1980 - June 1982 and as already indicated the earliest sales invoice was dated June 1980.
- (iv) The Applicant applied for his mark "London Bridge" on the 1st October 1981 and accordingly the evidence shows user prior to the date of the Application for a period of approximately 1 year and 5 months.
- (v) The advertising figures were given from January 1981 and the first invoice was dated August 1981.

As a preliminary point I wish to consider whether the evidence is sufficient for the purposes of S. 10(1) of the Ordinance.

S. 10(1) of the Ordinance provides that where any mark has for not less than two years being bona fide used for the purpose of indicating that they are goods of the Proprietor of the mark the Proprietor may apply in writing for the mark to be registered in Part B of the register in respect of such goods. As there has been only approximately 1 year and 5 months use prior to the date of the application I take the view that the evidence is not sufficient for the purposes of S. 10(1) of the Ordinance and Mr. Garland confirmed at the Hearing that he agreed with this view.

S. 9 of the Ordinance provides for registration in Part A of the Register and S. 9(1)(d) of the Ordinance provides that a trade mark to be registrable in Part A shall contain or consist of a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname.

I propose to deal in turn with the objections raised by the Registry.

The marks consist of the surnames "London" "Bridge" and "Bridges"

Mr. Garland submitted that the mark should not be divided up into two names but the mark should be taken as a whole from the point of view of a surnominal signification. In support of this view he submitted that S. 9(1)(d) should be read as "a word or words not being according to its ordinary signification a surname" and that in his submission the trade mark consisted of words not according to its ordinary signification a surname and that "its" in this context includes the word "their". Mr. Garland further submitted that this section is to do with a trade mark as a whole and not parts of a trade mark.

He cited in support the statement of Mr. W. Hume in the "Koola Kreema" case (In re J. Lyons & Co. Ltd's Application reported in 1963 Vol. 3 Trade Mark Cases of the Hong Kong Law Reports p. 301).

In that case in considering whether the words "Koola Kreema" were deceptive for the purposes of S. 9(1)(d) Mr. Hume stated that he accepted that the mark was to be regarded as a whole.

Mr. Garland further submitted that the relevant test in this case was whether the word "London Bridge" or the words "London Bridges" were, according to ordinary signification, a surname, and he submitted that, on applying that test, this was not the case.

Whilst I accept the view that I should view the two marks as a whole I do consider that I can and should consider the two words comprising the mark separately as well as together.

I am supported in this view by the "Wacker-Chemie" case (In the matter of Wacker-Chemie GMBH's application for a Trade Mark (1957) RPC 278) where Lloyd Jacob J. on Appeal agreed with the separate consideration which the Hearing Officer had given to the two integers of the mark.

In considering the two words I note the list of entries in the Telephone Directories referred to in the letter from the Registry dated 5th February 1982 for "London" "Bridge" and "Bridges". The maximum entry for "London" is "94" in the Manhattan Telephone Directory and for "Bridge" and "Bridges" the maximum figures are in the London Telephone Directory and are "100" and "129" respectively.

These entries would I consider show that these are not very rare surnames but equally could not in my opinion be considered as very common surnames. Both "London" and "Bridge(s)" do however have common and better known meanings. London is of course a well known city and "bridge(s)" is defined in Websters Dictionary as "a structure carrying a pathway or roadway over a depression or obstacle."

Taking the marks as a whole I note there is no evidence of entries of a double barrelled name "London-Bridge" or "London-Bridges" and the two marks as a whole would have another signification which would be "London Bridge" and "the Bridges of London" respectively.

The question of the registration of surnames is considered in para. 8.52 and 8.53 of Kerly's Law of Trade Marks and Trade Names (10th Edition) and in particular para. 8.53 deals with the practice of the Registrar in the United Kingdom.

" (b) Where the word propounded is found to occur very rarely as a surname and obviously has an overwhelmingly commoner and better-known meaning otherwise than as a surname (e.g. words such as "Coup" or "Cheer"), the Registrar would be prepared to regard the surname signification as a non-ordinary one, to recognise that the word falls within the terms of section 9(1)(d) and ... to register the mark in Part A without requiring any further evidence of its distinctiveness; or, if the word were a less rare surname (and yet not in any sense a common surname) and had an overwhelmingly commoner and better-known meaning otherwise than as a surname (e.g. such as "Jury" or "Bugler"), the Registrar would in the absence of evidence of distinctiveness refuse registration in Part A but would allow registration in Part B of the Register.

The combination of a surname with the ordinary name of the goods concerned does not create a distinctive mark in the absence of special circumstances within section 9(3). The combination of a foreign surname and a foreign descriptive word has been held to be not registrable."

In this particular case the words taken separately have in addition to their surname signification a more common meaning and even more important in this case the marks taken as a whole have a well known meaning. In the case of "London Bridge" this is a well known monument of London and would be known as such by members of public. In the case of "London Bridges", I consider, in view of the number of bridges in London that its commoner and better known meaning would prevail.

✓ Having considered the two marks as a whole and as separate words I find that the marks "London Bridge" and "London Bridges" are not surnames in their ordinary signification for the purposes of S. 9 of the Ordinance.

The marks "London Bridge" and "London Bridges" are geographical names for the purposes of S. 9(1)(d) of the Ordinance

The provisions of S. 9 of the Ordinance are similar to the provisions of S. 9 of the Trade Marks Act 1938 (hereinafter called 'the UK Act') and I consider the UK cases are relevant.

I refer to Kerly's Law of Trade Marks & Trade Names (11th Edition) in para. 8-33 and in particular the following lines :-

"..... so that the question here ought to have become: Given that the word concerned is a place name, is this its ordinary signification (or one of its ordinary signification) ? The Irish Courts have so decided: holding "ordinary signification" to mean, as understood and as ordinarily and commonly used, in Ireland, by ordinary people of the class to whom the mark would be addressed - the general public, for goods purchased by them, the likely purchaser for specialised goods. Thus a word may (although a place name, or a rare surname or both) have no "ordinary signification," except as a likely trade mark." ...

and also further in para. 8-33

"... The Registry practice on this point is relatively simple. If a word sought to be registered in Part A is recognised as a place name, an objection will be taken under section 9(1) unless the use of that name is obviously fanciful. The mark may still be registrable on evidence of distinctiveness, see below the discussion of section 9(1)(e). Or, if the geographical reference is unlikely to cause any confusion, the mark may be accepted in Part B. Thus the important question under this head is less often "Is this mark a geographical name?" than "How strong must the evidence of distinctiveness be, to render this mark registrable ?" However, since York, the practice has tightened somewhat - most geographical names are refused."

I propose considering first the mark 'London Bridge'. 'London Bridge' was according to the Encyclopedia Britannica the only bridge across the Thames from Roman times until the 18th Century. Since 1894 a total of fourteen other bridges have been built across the Thames in the London area but there is still a bridge over the Thames in the city of London known as "London Bridge". It is therefore true to say that although 'London Bridge' is a place name its more ordinary significance is that of a particular bridge over the Thames in the City of London. It could therefore fall into the category of a 'monument' or 'landmark' rather than that of a 'place name'.

I am aware of the registration of the trade marks of other well known monuments and or landmarks which could be said to have a geographical signification. Some of these are as follows :-

- (1) Trade Mark No. 1014 of 1961 "Big Ben & Device" registered in Part A of the Register in Hong Kong in Class 34.
- (2) Trade Mark No. 1244 of 1949 "Tower Bridge Label & Device" in Class 43 registered in Hong Kong in Part A.
- (3) Trade Mark No. 944856 "Windsor Castle" registered in the United Kingdom in Class 32.
- (4) Trade Mark No. B946,185 "Hampton Court" registered in Part B in Class 24 which proceeded after evidence of distinctive. This case can perhaps be distinguished in that Hampton Court in addition to being a well known Palace is also a district in London.

I am also aware of the fact that since the date of the Hearing the mark 'London Bridge' has been registered in Part A of the United Kingdom Trade Mark Register in the Applicants name. In considering the question of registrability under S. 9 of the Ordinance which is identical to S. 9 of the UK Act I consider I should give weight to the registration in the United Kingdom. No written decision of the grounds of allowing the application has been supplied but I note from the UK Trade Marks Journal No. 5476 dated 24th August 1983 that the mark was advertised without any reference to user.

As far as I am aware 'London Bridge' is not a district in London although I know that a station close to London Bridge is known as London Bridge *Station* *9/12*

Mr. Garland referred me to various cases in connection with the question of whether a mark is in its ordinary signification a geographical name.

I refer first to the 'Cannon' case (Cannon Trade Mark (1980) RPC 519) which was concerned with the surname signification and in particular the words of Whitford J. at p. 523 :-

"The exclusion of surnames and geographical names, as has been pointed out in a great many cases, stems from the fact that consideration for registration is essentially dependent upon the undesirability of allowing one individual to monopolise, for example, a very common surname, and I need only refer to the Burford case, which is one of the cases where the undesirability of this is emphasised; or the undesirability of allowing one trader to secure a monopoly of a geographical location, being a place whose inhabitants are in or may want to enter into a relevant field of business, and Livron was a good example of that. If, in truth, the word sought to be registered is a common surname and would be accepted by ordinary people as, in one of its ordinary significations having a surname significance, then I think that the Registrar has rightly over the years proceeded upon the basis that, in the absence of evidence of distinctiveness, if it be a common surname it ought to be refused altogether."

I also note the comments of Oliver L.J. at p. 526:-

"The learned judge pointed out that the exclusion of surnames and geographical names from consideration for registration was essentially dependent upon the undesirability of allowing one individual to monopolise a very common surname, or one trader to secure a monopoly of a geographical location."

and also the comments of Buckley L.J. also on page 526 which I consider are in my opinion relevant to the geographical signification :-

"It seems to me that a word may, according to its ordinary signification, embrace more than one sense in which it can, quite ordinarily and quite appropriately, be used."

In considering these comments it seems that I should consider whether 'London Bridge' is a geographical place or location or merely a well known monument or construction. Having taken into account the various decisions and the circumstances of this case I take the view that the ordinary signification of 'London Bridge' is the bridge over the river Thames known by that name and would fall into the category of a monument or construction rather than a geographical location. It does not seem that there would be traders affected by the use of 'London Bridge' as a trade mark. I consider therefore that the mark 'London Bridge' as a whole is not in its ordinary signification a geographical name and there would be no objection to registration under S. 9(1)(d) of the Ordinance. I propose to deal later with the question of a disclaimer of the word 'London'.

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Mr. Garland was of the view that the mark 'London Bridges' could be considered on the same basis as 'London Bridge' I cannot agree with this view in respect of the geographical signification.

'London Bridges' can either be the plural form of 'London Bridge' or can mean 'the Bridges of London' as already indicated. Although London Bridge has been rebuilt on various occasions I take the view that the more common meaning would be that of 'the bridges of London'. As I have already indicated there are some fourteen of these and this does to my mind create more of an impression of a place or locality than simply a construction or monument as in the case of 'London Bridge'.

It does seem from the decisions and passages I have quoted from Kerly that if there is an element of doubt evidence as to distinctiveness should be obtained.

I take the view that this is just such a case where evidence of distinctiveness should be obtained to consider whether the mark has in fact become distinctive under the provisions of S. 9(1)(e) of the Ordinance. The evidence submitted did not show user in respect of the mark 'London Bridges' prior to the date of the application and I consider therefore that I should still maintain the objection. It is of course still open to the Applicants to file a fresh application to show evidence prior to the date of any such application.

The mark used on goods in Hong Kong would be deceptive of origin for the purposes of S. 12(1) of the Ordinance

The question of whether a mark is deceptive of the origin of goods is of course connected with the geographical signification.

I refer to Kerly (11th Edition) para. 10-32 on this question.

"Misleading geographical terms

Just as a descriptive term may be deceptive, wrongly applied, so may a geographical term. Thus "Royal Worcester" was objectionable, inter alia, as failing to make it clear that the "Worcester" was in the United States. "Livron" used for a medicine compounded of liver and iron, was deceptive as implying connection with the opponents' works at Livron in France. A mark containing the word "Advokaat" was refused since the goods were not Dutch; and "Tonino" was refused in the same way: it is the practice to refuse word marks indicating a foreign country except for goods from that country, unless-see below-the applicant comes from there. But the rule is not too rigid. But "Roman Holiday", for perfumes and cosmetics, was held unobjectionable: the mark no more suggested a Roman origin for the goods than would "Holiday in Rome".

The question therefore arises as to whether the use of the marks "London Bridge" and "London Bridges" on their own on articles of clothing would imply that the goods were made in London and would therefore be deceptive in respect of goods actually made in Hong Kong. I wish to make it clear that I am considering the word marks in the form applied for under Pending Applications No. 2802Q and 2802R only.

Although evidence of sales of goods with the mark "London Bridge" was produced to me no evidence on this particular aspect was deduced.

I have taken into account the words of Lord Maugham in the "Glastonbury" case (A. Bailey & Co. Ltd. v Clark Son & Morland Ltd. (1938) RPC 253) at p. 258 :-

"It is clear that the name Glastonbury used in connection with slippers might indicate first that they were made at Glastonbury, or secondly, that they were made (there or elsewhere) out of skins tanned in a special manner commonly used at Glastonbury, or, thirdly, that they were slippers made, or marketed, irrespective of place of manufacture and of materials, by a particular manufacturer. Moreover, the word in some minds might indicate more than one of these facts, or might leave the purchaser guessing which of the three was indicated. In such a case, as it seems to me, the evidence that the third only of the above meanings would in general be attached to the word by the trade and the public ought to be particularly cogent and convincing."

and also on p. 258

"One of the questions to be determined on this second branch of the case is whether the registration of the Trade Mark would be likely to cause substantial difficulty or confusion, in view of the rights of other traders to use the name of the place where they do, or may in the future, manufacture similar goods."

I should therefore consider into which of the three categories the marks "London Bridge" and "London Bridges" would fall.

Taking the mark as a whole it seems unlikely that clothing would be made at "London Bridge" or indeed "London Bridges" or that they were clothes particular to 'London Bridge'. The question which, in my opinion, I should consider is whether any purchaser would wonder whether the clothes sold under the marks came from London or were made in London. I am aware from my own knowledge that people in Hong Kong attach great importance to clothes made in London, Paris or Italy and will pay large prices for the purchase of such clothes. I have therefore to be particularly careful as to whether any person would wonder whether the clothes were made in London. The evidence of user produced is of no help to me in this respect except that the evidence does in fact show user of the marks on "jeans" alone and it is I feel well known that Hong Kong is a very large manufacturer of jeans.

In view however of the meaning of the marks as a whole, which would I feel also be known to the people of Hong Kong, I think it is unlikely that a purchaser would immediately think of the goods as made in London and would be more likely to consider they were the goods of a particular manufacturer, particularly if the clothes are actually jeans.

Despite my opinion on this point there is no disputing the fact that London, in addition to being the capital of the United Kingdom, is a centre of fashion and I consider that in Hong Kong people do attach a considerable importance to this fact and the origin of articles of clothes. This can perhaps be compared with the United Kingdom where, in my opinion, not so much importance is attached to this aspect except, perhaps, in the very expensive range of goods.

Mr. Garland did indicate that his clients were prepared to offer a disclaimer of the words "London" and "Bridge" used separately and limit the goods to 'jeans'.

Under the provisions of S. 16 of the Ordinance the Registrar may, if a trade mark contains parts which are of a non-distinctive character, require such parts to be disclaimed as a condition of allowing the mark to be registered.

I consider therefore that in this case in view of the points I have already made that in order to overcome the S. 12(1) objection the goods should be limited to the actual goods sold namely 'Jeans'. In addition in view of the points already made I consider a condition should be imposed in the following form :-

"Registration of this Trade Mark shall give no right to the exclusive use of the word "London" except as associated with the word "Bridge"."

I consider that the same principles could apply in the case of "London Bridges" but such would be dependent on the evidence deduced as to distinctiveness, if any.

The mark was in conflict with the trade mark No. 911 of 1982 "London Pride"

As already indicated "London Pride" was registered under Trade Mark No. 911 of 1982 in Class 25 in respect of Articles of Clothing in Part A of the Register. The word "London" has been disclaimed.

In comparing the two marks I refer to the "Pianotist" case (1906) 23 RPC 774 and the words of Parker J referred to as follows in Kerly (11th Edition) para. 17-07.

"You must take the two words. You must judge them, both by their look and 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 these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the mark".

I consider the various points as follows.

The persons likely to be deceived

On the evidence produced the user is shown to be for export purposes only and no sales in Hong Kong were produced. It is not however proposed that the mark be limited to goods for export only and I have therefore to consider not only the persons involved in the trade but also the public at large who would be actually purchasing the clothes for their own personal use.

The mark "London Pride" is registered in respect of "Articles of Clothing" which covers the whole range of goods in Class 25 and it is clear that the persons likely to be deceived would be the same in respect of both marks.

The mark as a whole

It is well settled that I should consider the mark as a whole but equally I take the view that I should consider the component parts as well.

The two marks are "London Pride" and "London Bridge". The common element is the word "London" - I do not consider that the word "Pride" resembles the word "Bridge" as there is no common meaning and no similar sound or visual appearance. Taken together the word "London Pride" means a type of plant.

Kerly (11th Edition) considers this aspect at para. 17-17 and I set this out as follows :-

"The trade mark is the whole thing - the whole picture on each has to be considered. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the part or parts is enough to make the whole dissimilar."

and further at para. 17-19

"In Broadhead's Application, Evershed M.R. followed the observations of Lord Russell in Coca Cola Canada V. Pepsi Cola Canada, where he stated: "Where you get a common denominator, you must in looking at the competing formulae pay much more regard to the parts of the formulae which are not common - although it does not flow from that that you must treat the words as though the common part was not there at all." Where common marks are included in the trade marks to be compared, or in one of them, the proper course is to look at the marks as wholes, and not to disregard the parts which are common."

Thus looking at the two marks "London Pride" and "London Bridge" as a whole and without disregarding the common element I do not consider the marks as a whole are similar.

The idea of the mark

I have also considered the idea of the mark as a whole and I do feel that the idea of these two marks are not the same. As I have already said "London Pride" is a plant and would not, even without such a secondary meaning, have the same idea or meaning as "London Bridge" which relates to the famous bridge over the Thames or "London Bridges".

Ear as well as eye must be considered

In view of the common part of "London" both visually and phonetically the mark could be said to have similarities however when viewed as a whole I would not consider the mark was phonetically or visually the same as the words "Pride" & "Bridge" are quite different both to the ear and the eye.

Imperfect Recollection

I consider that on taking the two marks as a whole that even if a purchaser is aware of one mark and not the other I do not consider that there would be a likelihood of confusion.

Marks to be compared as they would be seen in actual use

The marks should be compared as if in actual use when fairly and honestly used. Assuming notional user in the form of printed labels, even if used in the same size and form of printing, would not lead me to consider the marks as a whole were similar.

In this case the word "London" in the mark "London Pride" has been disclaimed. It is clear however from the "Granada" case that I should take into account disclaimed matter when considering the case for the purposes of S. 20 of the Ordinance.

In the "Granada" case ((1979) RPC 303) it was held that in making the comparison under S. 12(1) the Registrar must have regard to the whole of the opponents mark, including the disclaimed matter, and must assume use of it in a normal and fair manner for, inter alia, the applicants goods.

I do not consider therefore on taking the marks as a whole, the condition as to disclaimer already suggested and considering all the circumstances of this case that the two marks would be confused and I do not consider that the mark applied for so nearly resembles the mark "London Pride" as to be likely to deceive or cause confusion.

As I have decided this I do not propose to comment on the question of honest concurrent user pursuant to S. 22 of the Ordinance as raised by Mr. Garland at the Hearing. I do however wish say that the user of 1 year & 7 months would fall short of the usual requirements for establishing a case of honest concurrent user. I am supported in this view by the "Granada" case where the period of use was only 2 years and 10 months. Such a short period of user was accepted in the particular circumstances of that case. It is quite clear from Kerly 10th Edition para. 10-20 that whilst no fixed rule can be laid down as to the minimum period there has been no reported cases having a period shorter than 2½ years.

One further point I would like to raise is the question of the evidence required for the purposes of establishing distinctiveness under the provisions of S. 9(1)(e) of the Ordinance. I have not had to consider in this case whether the evidence is sufficient but I would wish to state that the usual requirements call for a much longer period of user and much stronger evidence supported by independent traders.

I find therefore that the Applicant's mark 'London Bridge' Pending Application No. 28020 can proceed to registration in Part A provided that the goods in Class 25 are limited to 'jeans' and subject to a condition in the following form :-

"Registration of the Trade Mark shall give no right to the exclusive use of the word "London" except as associated with the word "Bridge"."

I find however that as regards the mark 'London Bridges' I am not satisfied for the purposes of registration in Part A pursuant to S. 9 that its ordinary signification is not geographical in the absence of any evidence of distinctiveness and the mark should still be refused on those grounds. It is of course open to the Applicant to submit evidence of use for consideration by the Registry.

Aueil C Waters

(A.C. Waters)(Miss)
Assistant Principal Solicitor
19th December 1983