

16.6-88

File No. : 143/1984

IN THE MATTER of the Trade  
Marks Ordinance (Chapter  
43)

and

IN THE MATTER of an  
application by Carrera  
S.P.A. to register the mark  
No. 143/84 in Class 25 in  
respect of jeans, trousers,  
blouses, shirts, skirts,  
jackets, coats, dresses,  
hats, waistbands and shoes,  
none being sportswear in  
Part A of the Register.

Grounds of Decision

of

Mr. R.J. PERERA acting for the Registrar of Trade Marks for the  
Register General.

Mr. Paul Chan of Counsel, instructed by Messrs. Wenping & Co. for  
the Applicant.

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On the 16th of January 1984 an application was made by Carrera S.P.A. ("the Applicant") for the registration of the following trade mark ("the applied for mark") in Class 25 :-



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The application was made in respect of "jeans, trousers, blouses, shirts, skirts, jackets, coats, dresses, hats, waistbands and shoes, none being sportswear".

The Applicant's agent in Hong Kong is 'Messrs. Wenping & Co.

By a letter dated the 31st May 1984 the Registrar of Trade Marks advised Wenping & Co. that the mark was not acceptable because, inter alia, it was considered to have a direct reference to the character and quality of the goods and also according to its ordinary signification, to be a surname.

Reference was made to Section 9(1)(d) of the Trade Marks Ordinance and in Schedule II of the said letter the Registrar set out the instances of the name "Carrera" as a surname as follows :-

"Schedule II

WORD "CARRERA"

4 entries in London Telephone Directory  
12 entries in Manhattan Telephone Directory  
32 entries in Los Angeles Telephone Directory  
3 entries in Queens Telephone Directory  
2 entries in Paris Telephone Directory  
18 entries in Rome Telephone Directory  
- entries in Berlin Telephone Directory  
1 entries in Hong Kong/Kowloon Telephone Directories"

The objection that the word "Carrera" was considered to have a direct reference was subsequently waived.

On the 29th August 1984 the Registrar of Trade Marks wrote to Messrs. Wenping and I quote this following extract on the question of the surnominal objection to the word "Carrera" :-

" I must on the other hand maintain the surnominal objection to the word "CARRERA". Although "CARRERA" is a Spanish dictionary word, it occurs more than 30 times in the Los Angeles Telephone Directory. There is nothing unusual about this situation where the word propounded has more than one meanings in its ordinary signification (CANNON case 1980 RPC 519). As to whether the dictionary signification can really override the word's surnominal signification, the "Swallow" case (64 RPC 92) rule will apply. According to the practice as laid down in the Swallow case, the Registrar would be prepared to regard a word's surname signification as a non-ordinary one and to recognise that the word falls within the terms of paragraph (d) of Section 9(1) only when the word propounded is found to occur very rarely as a surname (not more than 15 times in any one telephone directory) and obviously has an overwhelmingly commoner and better-known meaning otherwise as a surname. In the present case, I do not consider that the Spanish meaning of the word "CARRERA" is well-known to the majority of the local population. The number of its entries in telephone directories has also exceeded the normal limit set for rare surnames. In the circumstance, I regret that I must adhere to the view that the mark has to be rejected registration in a prima facie case".

However, on the 30th September 1987 the Registrar of Trade Marks issued to Messrs. Wenping & Co. a leave to advertise in respect of the applied for trade mark. Subsequently, however, the Registrar of Trade Marks reviewed the position regarding this application and thereafter wrote the following letter dated the 12th April 1988 to Messrs. Wenping & Co. :-

" I have to write to advise you that on a review of your client's application prior to registration it has been discovered that it was accepted in error. It cannot, pursuant to S. 17(1) of the Trade Marks Ordinance, therefore now proceed to registration.

The Registrar's position with regard to "Carrera" is that it is not registrable. Though it has various common Spanish meanings it does not have any well known meaning to the general public of English speaking countries. In addition it is a common Spanish surname. Your client's application will be held co-pending with application No. 3155A/87 for registration of "Carrera and device" in the same class".

On the 2nd of May 1988 Messrs. Wenping & Co. wrote to the Registrar of Trade Marks along the following lines :-

" Your letter of 12 April 1988 and your follow-up letter 14 April together with its attachment have been forwarded to our clients for comments.

Our clients comments and instructions are that we should request you to review your decision as contained in your 12 April letter. The word "CARRERA" should be considered registrable per se and the decision given by the Registrar to permit our clients application to proceed to advertisement has been right. Your statement "though it has various common ~~Spanish meanings it does not have any well known~~ meaning to the general public of English speaking countries" as made in the second paragraph of your 12 April letter is far-fetched. May we refer to the acceptance of "CARRERAS" (plural form of "CARRERA") in Class 34 in Hong Kong, full particulars of which we enclose. We would request you to revise your decision and withdraw your Section 17(1) objection".

On the 10th of May 1988 the Registrar of Trade Marks wrote to Messrs. Wenping as follows :-

" I refer to your letter of the 2nd instant. I wish to inform you that the letter of 12th April, 1988 was written only after careful reconsideration of the

whole matter at the highest level within this department. I regret that I am not prepared to accept the subject mark for registration or withdraw the Section 17(1) objection.

Please substantiate or withdraw your allegation that the Registrar's statement that "Carrera" does not have any well-known meaning to the general public of English speaking countries is farfetched. You are requested to furnish me with examples of well-known English language meanings of that word.

Your quote of the four "CARRERAS" label marks has been noted. "Carreras" is an uncommon surname of its own and it is not appropriate to regard "Carreras" as the plural or possessive of "Carrera". Moreover, these 4 marks were registered over 15 years ago and should not form binding precedents in my present decision relating to the registrability of the subject mark. Each mark is to be considered on its own particular merits.

Your are reminded that the co-pendency with Pending Application No. 3155A/1987 is still subsisting".

On the 16th of June 1988 the Registrar of Trade Marks wrote to Messrs. Wenping & Co. as follows :-

" I write further to my letter of 10th May, 1988 and confirm that the notice to advertise in respect of the captioned mark is deemed withdrawn pursuant to Section 17(1) of the Trade Marks Ordinance and consequentially, the opposition is also deemed withdrawn. It follows that the matter now falls to be considered under Rule 18 as if the leave to advertise had not been issued.

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I would remind you that the subject mark is being confronted with the following objections :-

- (a) co-pending with "CARRERA & device", Pending Application No. 3155/1987.
- (b) the mark is a surname which is unregistrable under Section 9(1)(d) of the Ordinance.

You are requested to advise your clients to provide the relevant information e.g. the date of first use of their mark in Hong Kong during the period of the extent of use for the purposes of resolving the prior right under Section 21. In same connection, I

would refer you to the sub-paragraphs of Para. 9(I) of the Registry's Circular No. 2 of 1985 on "Applications made co-pending under the provisions of Section 21 of the Trade Marks Ordinance".

On the 4th of August 1988 Messrs. Wenping & Co. wrote to the Registrar of Trade Marks along the following lines :-

" This will refer to correspondence ending herein with your letter of 16 June 1988.

Our clients would like to deal with your surnominal objection in the first instance and subject to clearance of this point, our clients would deal with the copending objection under Section 21.

By way of filing a considered reply under Rule 18, we submit counsel's considered reply dated the 2nd of August 1988.

In the light of what has been set out therein, we would appreciate receiving your favourable decision".

This letter enclosed a considered reply which was prepared by Mr. Paul P.L. Chan and was dated the 2nd of August 1988.

On the 2nd May 1988 the Registrar of Trade Marks had written to the Spanish Trade Commission in Hong Kong along the following lines :-

" I am writing to seek your kind assistance in processing an application for registration of the above mark in the name of CARRERA S.P.A., a joint-stock company organized under the laws of Italy in respect of "jeans, trousers, blouses, shirts, skirts, jackets, coats, dresses, hats, waistbands and shoes, none being sportswear".

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It appears to me that the word "Carrera" is a Spanish surname and thus I should be grateful for your advice. If it is a common surname in your country, could you please kindly let me know the approximate number of surname entries in the recent Madrid Telephone directory. If such information is not available, I shall be grateful if you can let me know where I can obtain such information in Hong Kong or in Spain.

Your kind assistance in this matter is very much appreciated".

On the 26th of May 1988 the Spanish Trade Commission wrote to the Registrar of Trade Marks along the following lines :-

"Further to your letter of 2/05/88, I regret to inform you that we do not have in our office a telephone directory of Madrid or any other province since, as you probably know, Spain is a very large country and it would be impossible to keep all of them here.

What we have is a trade directory, but the companies ~~are listed by~~ sector, not by alphabetical order and in any case this would not help very much since what you ask for is the number of surnames listed in Madrid.

All I can tell you is that Carrera is a very common name in Spain".

On the 13th of October 1988 the Registrar of Trade Marks wrote to Messrs. Wenping & Co. along the following lines :-

" Pursuant to Trade Mark Rule 20(1) and with reference to the considered reply accompanying your letter of 4th August will you please let me know whether or not your clients wish to be heard on this matter".

By its letter dated the 21st October 1988 Messrs. Wenping & Co. confirmed that their client wished to be heard in this matter and accordingly a hearing was fixed for the 30th of March 1989.

On the 28th of December 1988 Messrs. Wenping & Co. submitted to the Registrar General with its letter dated 28th December 1988 a copy of the page taken from the Madrid Telephone Directory relating to the surname "Carrera".

A hearing took place before me on the 30th of March 1989. Subsequent to the hearing Messrs. Wenping delivered to me a further Statutory Declaration dated 30th March 1989 of Mr. John Ip.

At the hearing Mr. Chan confirmed to me that he sought to convince me that his client's trade mark was acceptable for Part A in the Trade Marks Register. He said that no evidence of use had been adduced and he agreed with me that this application could only be considered for Part A and not for Part B; the application had been filed in 1984 and would, if it were to be considered for Part B, have to be considered under the provisions of Section 10 of the Trade Marks Ordinance as it stood in 1984, which required two years user. Mr. Chan agreed that he was adopting all the points he had made in his considered reply dated 2nd August, 1988.

Before I turn to consider the issues involved in this case I think it would be useful if I dealt with some preliminary matters. First, the question of whether "Carrera" is registrable as a trade mark has to be determined as at the date of the application for registration because of the provisions of Section 17(1) of the Trade Marks Ordinance (quoted at page 16 of these Grounds of Decision). In this case the date of the application is 16th January 1984. Secondly, I set out the following :-

(1) Section 9(1) of the Trade Marks Ordinance provides that a trade mark (other than a certification trade mark) to be registrable in Part A of the register shall contain or consist of at least one of the following essential particulars -

"(d) 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;

(e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness".

(2) Guidelines of the Registrar of Trade Marks dated 10th March 1980 issued by Mr. Piers Jacobs which would have been relevant in considering the registration of surnames in Part A at the time that this application for "Carrera" was made, and which I quote in full :-

"Registration of Surnames in Part A"

Following upon the notification of the United Kingdom Registrar's new practice regarding the above, as set out in the U.K. Trade Marks Journal of 21st November 1979, it has been decided that this Registry's practice with regard to registration of surnames in Part A of the Register should also be amended.

In future, therefore, words which have no signification other than as surnames in the sense that they are to be found in telephone directories, will be allowed prima facie in Part A of the Register if they occur not more than twice in the Hong Kong Telephone Directory and not more than five times in an appropriate foreign directory. With regard to the latter, the Registry will normally search in the London,

Manhattan, Los Angeles, Queen's, Paris, Rome and Berlin Telephone Directories, but it may be necessary on occasions to include other directories, depending on the circumstances of particular cases. For example, if the circumstances of an application indicate a likelihood that the mark is a Japanese surname, it will be necessary to consult the Tokyo Telephone Directory. In applying the new practice, the entries in the individual foreign directories will not be aggregated i.e. even if a surname appears 4 ~~or 5 times in each~~ of the 7 foreign directories searched, it will be regarded as acceptable for registration in Part A (provided, of course, that it does not appear more than twice in the Hong Kong directory).

There will be no change in the Registry's policy regarding registration of surnames in Part B of the Register".

- (3) Section 17(1) of the Trade Marks Ordinance which is as follows :-

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"17(1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted and has not been opposed and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the application has been accepted in error or unless the Governor otherwise directs, register the trade mark in Part A or Part B, as the case may be, and the trade mark when registered shall be registered as of the date of ~~the application for registration~~, and such date shall be deemed for the purposes of this Ordinance to be the date of registration :

Provided that, in relation to the date as of which a trade mark shall be registered and to the date to be deemed the date of registration, this subsection shall, as respects an application to which section 13A applies, have effect subject to that section".

At the hearing Mr. Chan relied on the following cases

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1. CIBA Trade Mark 1983 R.P.C. 75.
2. FARAH Trade Mark 1978 F.S.R. 234.
3. KREUZER Trade Mark 1978 F.S.R. 239.
4. BOOTS PURE DRUG Co. Ltd.'s Trade Mark (1937) 54 R.P.C. 327 "LIVRON" Trade Mark.
5. National Cash Register Company's Application 34 R.P.C. 273.

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At the hearing Mr. Chan said that there were basically 4 points he wished to consider and they were as follows :-

- (1) How should Section 9(1)(d) of the Trade Marks Ordinance be interpreted as regards the crucial words "a word or words ... not being according to its ordinary signification ... a surname"? He said the question was how were these words to be interpreted in Hong Kong.
- (2) What foreign telephone directories should be looked at? Mr. Chan said he sought to persuade me that one should look at the telephone directories of countries near Hong Kong.

(3) He said that the Applicant's trade mark was derived from the Applicant's name and he said it was no purpose of his client to get a name that would be confused with other people's trade mark.

(4) He said that he would seek to convince me that the trade mark was registered in its country of origin and in many other countries of the world.

Before I turn to consider these points, I should mention what was said in paras. 2 and 3 of Mr. Chan's considered reply which is in the following terms :-

"(2) In the said letter from the Trade Marks Registry dated the 12th April, 1988, the registrar stated that the lay Client's application of the said trade mark was accepted in error and therefore it could not, pursuant to S. 17(1) of the Trade Marks Ordinance, proceed to registration. The grounds of the objections of the application raised by the Registrar in the said letter are as follows :-

(a) Though it ("Carrera") has various common Spanish meanings it ("Carrera") does not have any well known meaning to the general public of English speaking countries.

(b) It ("Carrera") is a common Spanish surname.

(3) Let me deal with objection (a) first. The Registrar said that it ("Carrera") does not have any well known meaning to the general public of English speaking countries. I have not come across any authority saying that a registrable trade mark has to have a well known meaning to the general public of English speaking countries. An invented word which is registrable as Trade Mark according to S. 9(1)(c) of the Trade Mark Ordinance usually does not have a well known meaning to the general public of English speaking countries and yet it is registrable".

With respect, I think that Mr. Chan may have misunderstood what the Registrar was saying. The Registrar was not saying that a registrable trade mark has to have a well known meaning to the general public of English speaking countries. However, the fact that a surname does have a commoner and better known meaning may assist an applicant who is trying to register a surname. See, for example, in Swallow Raincoat Ltd. Appn. ([1947] 64 R.P.C. 92, at pages 94-95) where the English Registrar of Trade Marks referred to this practice in the United Kingdom :-

"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 ...".

All the Registrar of Trade Marks in Hong Kong was saying (in its letter of 29th August 1984 to Wenping, for example (see page 4 above)) was that the meaning of the Spanish word "Carrera" (given in Cassell's Spanish/English Dictionary as meaning, inter alia, "run, race, race-track, road") did not have such a well known meaning in Hong Kong as to override the surnominal signification of the word "Carrera" which, as I show later, is not a rare surname in any event.

I turn first to consider the question of what meaning should be given to the words "a word or words ... not being according to its ordinary signification ... a surname" in Section 9(1)(d) of the Trade Marks Ordinance. Here I think that Mr. Chan's arguments at the hearing mirrored what he said in his considered reply dated 2nd August 1988 at paragraphs 5, 6, 7, 8 and, 9, which are as follows :-

"(5) It is my strong submission that the Registrar is wrong in saying that "Carrera" being a common Spanish surname is unregistrable. There is no law nor authority stating that a word being that it is a surname is unregistrable. It is well established and clearly stated in the S. 9(1)(d) of the Trade Mark Ordinance and S. 9(1)(d) of the U.K. Trade Marks Act 1938 also that a word having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a surname is registrable.

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Definitely "Carrera" does not have any direct reference to the character or quality of the goods concerned (which are mainly clothings, hats, waistbands and shoes, non being sportswear in our case). Although "Carrera" may be a common Spanish surname, yet it is my opinion that it is not according to its ordinary signification a surname in Hong Kong.

(6) Since S. 9(1) of the Hong Kong Trade Mark Ordinance is equivalent to S. 9(1) of the U.K. Trade Mark Acts 1938, I have to rely on the U.K. authorities to support my argument that "Carrera" is not according to its ordinary signification a surname in Hong Kong. In the U.K. case "CIBA

trade mark" 1983 R.P.C. 75 Mr. Justice Whitford of the Chancery Division approved the dictum of Kenny J. in the Irish case "FARAH Trade Mark" (1978) F.S.R. 234 where it was held that the words "according to its ordinary signification" in section 17 of the Irish Trade Mark Act 1963 meant the ordinary meaning of the word to an Irish man or woman; and that on that basis, "FARAH" was not a surname within the meaning of the Acts. Section 17 of the Irish Trade Mark Act 1963 corresponds to Section 9 of the U.K. Trade Mark Act 1938 and corresponds also to Section 9 of the Trade Mark Ordinance of Hong Kong.

(7) In the case "Boots Pure Drug Co's Trade Mark (the "Livron" case) (1973) 54 R.P.C. 327 at 338 line 15 Romer L.J. said :-

"The question which arises on that paragraph seems to me to be this, so far as the arguments in the present case have been addressed to it : can it be said of a word that has no signification whatsoever to the ordinary Englishman that it is according to its ordinary signification a geographical name? I confess I myself can give only one

answer to that question. If there is no signification to the ordinary Englishman, it certainly cannot have a geographical signification."

Kenny J. said in FARAH case :

"I prefer the views of Romer L.J. to those of the other two judges and I think that they are supported by the history of the legislation in this matter."

FARAH Trade Mark (1978) F.S.R. 234 at 237.

- (8) According to Romer L.J. in "Boots Pure Drug Co's Trade Mark (1973) 54 R.P.C. 327, Kenny J. in "FARAH Trade Mark (1978) F.S.R. 234 and Whitford J. in "CIBA" Trade Mark (1983) R.P.C. 75, we can see that all the three distinguished judges have come to the same conclusion in their interpretations of the words "according to its ordinary signification" and that they mean "the ordinary meaning of the word to the ordinary people of the place or (country) where the respective trade mark law applies." Hence in England, the words "according to its ordinary signification" in S. 9(1) of U.K. Trade Mark Act

1938 mean "the ordinary meaning of the words to the ordinary Englishman, while in Ireland, the words "according to its signification" in the S. 17(1) of the Irish Trade Mark Act 1963 mean "the ordinary meaning of the word to the ordinary Irish man or woman. If we apply (I think we should) the same principle of interpretation of the words "according to its ordinary signification" in the S. 9(1) of the H.K. Trade Mark Ordinance, they mean "the ordinary meaning of the word to the ordinary Hong Kong man or woman."

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- (9) When we apply the same settled principle of interpretation of the phrase "according to its ordinary signification" as stated in paragraph 8 herein above to the said "Carrera" in our case, we have to ask a simple question whether the ordinary Hong Kong men or women (who are mainly Chinese who do not know much English, not to say Spanish,) think that "Carrera" is a surname. I very much believe that no Hong Kong man or woman (I emphasize the point that they are mostly Chinese and do not know much English and do not know at all Spanish) would think that "Carrera" is a surname. Honestly I myself had never heard

of the word "Carrera" before I received this case. To me it was just a kind of an invented word for trade mark. Hence in my opinion "Carrera" is not accordingly a surname according to its ordinary signification."

From what has been said by Mr. Chan in paragraphs 6, 7, 8 and 9 of the considered reply I think that the relevant question is : Does the word "Carrera" have a surnominal signification to the ordinary man or woman in Hong Kong? I should mention the following preliminary matters. First, in the case of Swallow Raincoats Application [1947] 64 RPC 92 the Registrar held that the words "according to its ordinary signification in Section 9(1)(d) of the Trade Marks Act 1938 were to be interpreted as though they read "according to any of its ordinary significations"". The Swallow Case was expressly approved in Cannon Trade Mark [1980] R.P.C. at page 519. Secondly, the restriction in Section 9(1)(d) of Trade Marks Act 1938 that a word should not, according to its ordinary signification, be a surname "extends to foreign as well as English surnames". (Kerly's Law of Trade Marks and Trade Names, (12th Edit. - para. 8-37). Thirdly, I also bear in mind the fact that "Carrera" is being applied for in Class 25, and not for a limited, specialised class of goods. In this respect I refer to the decision of Costello J. in Kreuzer Trade Mark [1978] F.S.R., 239, at page 242,

"... If the classification is for a limited, specialised class of goods then the persons to whom the mark will be addressed will be a limited and specialised class of persons. The test then to be applied is what to the ordinary person within that specialised class of persons will be the ordinary significance of the word. Different considerations will arise where, as in the present case, the class of goods in respect of which registration is sought is a wide one and when the goods will be purchased by the general public. Then the test will be what is the ordinary significance of the word to the ordinary Irish man or woman in this country".

These considerations are relevant for the Trade Marks Ordinance.

It will be noted that at the time of the reply of the Trade Marks Registry to Messrs. Wenping dated the 31st of May 1984 (cited on page 2 above), there were 32 entries in Los Angeles, 12 in Manhattan, 18 in Rome, and 1 entry in the Hong Kong/Kowloon telephone directory. I refer to the Registrar's guidelines dated the 10th of March 1980 (referred to on page 14 above) where words with no signification other than a surname would be allowed in prima facie in Part A provided they occurred not more than twice in Hong Kong telephone directory and not more than 5 times in an appropriate foreign directory; on the basis of

the Registrar's guidelines (which applied to this particular application) and on the basis that the Spanish meaning of the word "Carrera" does not have a well known meaning to the general public of English speaking countries (and in this respect no arguments persuading me otherwise have been made to me by Messrs. Wenping or Mr. Chan), the surname "Carrera" would be regarded as exceeding the criteria for Part A registration. I refer also to the reply from the Spanish Trade Commission (quoted at page 11 above) where it is stated that the name "Carrera" is a common name. I also refer to the extract from the Madrid Telephone Directory which has been sent to the Registrar of Trade Marks by Messrs. Wenping (see page 12 above). Messrs. Wenping has not identified from what particular year the extract of the Madrid Telephone Directory comes from, but by my own computation the surnames shown on that extract show that "Carrera" appears 386 times. It is a fair inference that at the time this application to register the trade mark "Carrera" was made there would have been a considerable number of surname entries for "Carrera" in the Madrid Telephone Directory which would have exceeded the criteria stated in the Guidelines dated 10th March 1980 issued by the Registrar of Trade Marks, particularly that a surname should not appear more than 5 times in an appropriate foreign directory.

At the hearing Mr. Chan argued that there was only one entry for "Carrera" in Hong Kong, and although "Carrera" may be a common Spanish surname, it was not according to its ordinary

signification a surname in Hong Kong. Mr. Chan has referred to the "CIBA" case. However, bearing in mind that there was one entry for "Carrera" in Hong Kong telephone director at the time this particular application was made, the following passage from Whitford J.'s decision in the CIBA Trade Mark Case is relevant (at page 84).

"For my own part, I think one must approach the question of surnames, as identified in telephone directories and in particular in foreign telephone directories, with the greatest care. I was referred by Mr. Jacobs to two Irish cases as being cases of persuasive importance. The one was FARAH Trade Mark [1978] F.S.R. 234 where it was held under a comparable section of the relevant Irish Act that the words "according to its ordinary signification" meant the ordinary meaning of the word to an Irish man or woman, and that on that basis "Farah" was not a surname within the meaning of the Act. It did not appear in the Irish telephone directory. There were four entries in the London telephone directory, four in the Paris one and 22 in the New York telephone directory; but still Kenny J. thought it was a highly unusual surname. He says that the next question is whether it has, according to its ordinary signification, a surname signification; and he continues that he is

convinced that "no Irish man or woman thinks that "Farah" is a surname and, accordingly, it is not a 'surname according to its ordinary signification'.

I think one has to be a little careful and, had there been an entry or a number of entries in the Irish telephone directory, I have no doubt a different conclusion might have been reached; but I think that Kenny J. rightly attached importance to the fact that there were no entries in the Irish telephone directory at all, and only a very limited number of entries elsewhere, albeit a very much larger number of entries (and one in a country very adjacent) than we are considering in this case ...". (My underlining).

It is interesting to note that Whitford J. was prepared to opine that had there been one entry for "Farah" in an Irish telephone directory, he had no doubt that a different conclusion would have been reached. In this case there was, of course, one entry for "Carrera" in Hong Kong of the time of the search in 1984.

Is Mr. Chan correct in saying that, although "Carrera" is a common Spanish surname, it is not in its ordinary signification a surname to an ordinary Hong Kong man or woman? Mr. Chan believes that Hong Kong men and women (who he says are

mostly Chinese and do not know much English or Spanish) would not think that "Carrera" is a surname. First, I think, it should be noted that there are many expatriates from Europe, U.S.A. and Latin America working in Hong Kong. I see no reason why these people should not also be regarded as Hong Kong men and women, and this seems to be implicitly recognised by Mr. Chan in paragraph 9 of his considered reply when he says : "... whether the ordinary Hong Kong men or women (who are mainly Chinese ...)" (My underlining). Many of them would be aware that "Carrera" is a surname. However, even if one views "Hong Kong men or women" as referring only to those people residing here who are of the Chinese race (which I do not accept), then, with respect, I think that Mr. Chan is selling Hong Kong people a little short. Many Hong Kong people receive a bilingual education in English and Chinese. Many Hong Kong people are educated overseas, in Europe and the United States, which has a large Hispanic population. Hong Kong is not a place hermetically sealed off from the rest of the world; Hong Kong does not exist in a vacuum. It is a very sophisticated financial and trading centre trading extensively with the world. Since "Carrera" is a Spanish surname, it is interesting to note that in the "Hong Kong Review of Overseas Trade in 1983", the following figures (in U.S. dollars million) are given in relation to Hong Kong's exports to Spain :-

		<u>1981</u>	<u>1982</u>	<u>1983</u>
Peinsular Spain	overall imports	32,146	31,466	21,549
	imports from	113	105	71
	Hong Kong			
	percentage share	0.4	0.3	0.3

(Jan-Sep)

It will be apparent that even in 1984 there was a degree of trade between Hong Kong and Spain. The fact that there is a Spanish Trade Commission in Hong Kong attests to the links between Spain and Hong Kong.

I do not agree with Mr. Chan when he says that Hong Kong men and women would not think of "Carrera" as a surname. At the hearing Mr. Chan said that the guidelines issued by the Trade Marks Registry were just that; they did not have the force of law. This is so. However, the purpose of the guidelines is to try and determine whether any mark that has been applied for is a surname acceptable for Part A registration. I refer to the following quotation from Whitford J.'s judgment in the "CIBA" case (at page 85) :-

"I am conscious also of the fact that I feel unable to give any really firm guidance as to where the dividing line ought to be drawn, save only to say this : that

whatever the effect of one or two entries in a telephone directory in this country might be, when one gets to foreign countries one must look first I think at the countries near at hand, but even there one or two entries cannot conceivably have the effect of a similar number of entries in, for example the London Telephone Directory. Even there, if it is only a case of a single entry or, at the most, two entries I do not think it would be right to proceed upon the basis that that particular combination of letters would, according to its ordinary signification, have a surname significance to ordinary people in this country. Beyond that, I can only say that it must be a question of a number of entries in a number of directories, perhaps in various towns. The matter is one which must be left for decision in each individual case. So far as this case is concerned, however, it seems to me that it falls well outside any possibility of this being a word which, according to its ordinary signification, is a surname" (My underlining).

As one can see from this quote, the matter is one which is a question of a number of entries in a number of directories (perhaps in various towns) and must be left for decision in each individual case; one or two entries in a telephone directory in a foreign telephone directory would not lead to the conclusion that

a particular word was a surname according to its ordinary signification in England. What is the situation in this particular case? The entries revealed by the searches in 1984 in the telephone directories (see page 3 of these Grounds of Decision) show more than one or two entries, and the figures produced for Los Angeles, Rome and Manhattan exceeded the figures set out in the Guidelines dated 10th March 1980 issued by the Trade Marks Registry for Part A registration. (I shall deal later with what telephone directories should be searched). The results of the searches in 1984, the extract from the Madrid Telephone Directory and the reply from the Spanish Trade Commission reveal quite clearly that "Carrera" is a common Spanish surname and cannot be regarded as a rare foreign surname. On balance, I fee "Carrera" will have a surnominal significance to people in Hong Kong.

The second point made by Mr. Chan related to question of which foreign telephone directories one should consult and here I quote what he said in para. 10 of his considered reply :-

"(10) Furthermore, according to the Registrar's letter dated the 31st May, 1984, there was only one entry of "Carrera" in the Hong Kong/Kowloon Telephone Directories. Hence in Hong Kong "Carrera" is a highly unusual foreign surname. After looking into the local Hong Kong/Kowloon

Telephone Directories, the Registrar is entitled to look into the appropriate foreign directories. But which are the appropriate foreign directories? It is the observations made by Mr. Justice Whitford in "CIBA" case 1983 R.P.C. 75 at 85 that "... when one gets to foreign countries one must look into first I think at the countries near at hand ...". Hence it is my opinion that the Registrar after looking into the local Hong Kong/Kowloon Telephone Directories, he should look into the telephone directories of the countries near Hong Kong. The Registrar should look into telephone directories of (for example China, Taiwan, Thailand, Japan, or Korea). More importance should be placed on the entries in the telephone directories of the neighbouring countries rather than the telephone directories of the countries far far away from Hong Kong. Hence it is my opinion that the Registrar was wrong in not looking into the telephone directories of the countries in the FAR EAST, near Hong Kong but to look into the telephone directories in Europe & America. And the Registrar should also apply the principle of de minimis as they do in the U.K. Trade Mark Registry".

In a nut shell, Mr. Chan in saying that the Registrar should have looked at the telephone directories of neighbouring countries, e.g., China, Taiwan, Thailand, Japan or Korea. More emphasis should be placed on entries in the telephone directories of neighbouring countries rather than telephone directories of the countries far away from Hong Kong, and the Registrar was wrong in not looking into the telephone directories of the countries in the Far East near Hong Kong.

I refer to what was stated by Mr. Jacobs in the ~~Guidelines dated the 10th of March 1980 of the Trade Marks~~ Registry. He referred to the directories which the Registrar would normally research but went on to say that "it may be necessary on occasions to include other directories, depending on the circumstances of particular cases. For example, if the circumstances of an application indicates the likelihood that the mark is a Japanese surname it will be necessary to consult the Tokyo Telephone Directory". The purpose of such a policy directive issued by the Trade Marks Registry is to determine whether a particular applied for mark is a surname. I accept what Mr. Chan said at the hearing that these are guidelines. But they constitute an attempt to determine whether a word is in its ordinary signification a surname.

In this particular case the word involved is "Carrera". It is perfectly sensible for the Registrar to have initiated a search in accordance with the Guidelines dated on the 10th of March 1980 in the various telephone directories which he did search. The usefulness of the various United States directories is that each of these contains a fairly good selection of names deriving from various European countries. I think in this particular case the name might also have, in 1984, been searched in the Madrid Telephone Directory although it was not. Be that as it may, the numbers for "Carrera" revealed by the searches in the telephone directories referred to in Mr. Jacobs' Guidelines of 10th March 1980 (see page 3 above) and the extract from the Madrid Telephone Directory show that "Carrera" is a common surname, and in these circumstances I see no scope for the application of the "deminimis" principles which Whitford J. applied in the "CIBA" Case where there were only two entries of the name "CIBA" in the Berlin and Hamburg telephone directories.

At the hearing Mr. Chan referred to the fact that according to the research of his agents, Messrs. Wenping, searches have been made in directories in Japan, Taipei and Singapore. Mr. Chan said that there was no English language telephone directory in Japan. There had been no sign of the word "Carrera" in the Taipei English Telephone Directory and he said that the

surname "Carrera" was not revealed in the search of the Singapore Telephone Directory. Subsequent to the hearing, I received a Statutory Declaration from Mr. John Ip, who confirmed that :-

"3. So far as I am informed and verily believe that "Carrera" is not listed as a surname in Singapore, Taiwan and Japan. There is now produced and shown to me marked "J1-1" copies of the correspondence from my firm's associates in Singapore, Taiwan and Japan to this effect".

Mr. Chan said that looking at the telephone directories of other countries was only a guideline and not law. However, in my opinion, where you are dealing with a trade mark application for a word written in the Roman alphabet which might be a surname, looking only at telephone directories of countries neighbouring Hong Kong may not be very helpful because some of the neighbouring countries (Japan, for example) may not have telephone directories written in the English language or in any other language using the Roman alphabet. In case of marks written in the Roman alphabet (as in this case) it makes sense for the Registrar of Trade Marks to widen the scope of his enquiry and consider what the position is in selected cities of Europe and the United States (as stated in the Guidelines of 10th March 1980); I do not think that this approach conflicts with what Mr. Justice Whitford said in the Ciba Case (at page 85) :-

"When one gets to foreign countries one must look first I think at the countries near at hand ... Beyond that, I can only say that it must be a question of number of entries in a number of directories, perhaps in various towns. The matter is one which must be left for decision in each individual case ..." (My underlining).

It will be recalled that Whitford J. was considering the case of a mark "Ciba" which is set out in the Roman alphabet, and the applicant he was considering was a Swiss company. In my view Whitford J. clearly does not confine himself only to a search of telephone directories in countries near at hand (he uses the word "first"). The matter must be looked at on a case by case basis. A search made only in the telephone directories of Japan (where there is no English language directory) Taiwan and Singapore where the names are likely to be oriental ones is really not going to settle the question of whether "Carrera" is a surname in its ordinary signification. What has been revealed in this case by a search of the telephone directories in London, Manhattan, Los Angeles, Queens, Paris, Rome and Hong Kong is that "Carrera" is indisputably a surname. Subsequent to that particular search there is the response of the Spanish Trade Commission and the extract from the Madrid Telephone Directory showing that "Carrera" is a very common surname in Spain. With respect, it cannot make much sense in dealing with a name like

"Carrera" to search only neighbouring countries which may not even have telephone directories produced in English or other language adopting the Roman alphabet.

As regards the third point which Mr. Chan made, the fact that the name "Carrera" is the name of the company of the Applicant does not I think assist much. If it is a surname in its ordinary signification then it must fall foul of Section 9(1)(d) of the Trade Marks Ordinance. The only section of the Trade Marks Ordinance that might have assisted the Applicant is Section 9(1)(a) of the Trade Marks Ordinance. However, the name of the Applicant is "Carrera S.P.A." and the mark applied for is "Carrera" which cannot be said to be the name of the Applicant "represented in a special or particular manner" (Section 9(1)(a) of the Trade Marks Ordinance).

The final point which Mr. Chan made as I think being summarised in para. 13 of his considered reply which I set out :-

"(13) Furthermore, "Carrera" is an important part of the name of the Applicant Company and "Carrera" as Trade Mark has been registered in Italy (the country of origin), Algeria, Austria, Benelux, Czechoslovakia, Denmark, Egypt, France, German Democratic Rep., German Federal Rep., Hungary,

Liechtenstein, Monaco, Morocco, Poland, Rumania, S. Marino, Switzerland, Tunisia, U.R.S.S., Vietnam, Yugoslavia and also Ireland".

Mr. Chan went on to refer to the National Cash Register Company Case, which was decided in 1917.

It is interesting that none of the examples of registrations relates to a Commonwealth country. No evidence has been introduced in this case on what the criteria is for trade mark registrations in these countries, or what evidence was adduced to obtain these registrations. In Hong Kong the question of foreign registrations has been dealt with, fairly recently, by Mr. Peter F. Grindey in his decision the Virginia Slims Case dated 28th March 1985, and by Scriven J. in the Virginia Slims Case (Miscellaneous Proceedings 1985, No. 2214). As I have said, no evidence of the criteria for registrations in those countries have been given to me, nor as to what evidence has been adduced to obtain the registrations. As Mr. Grindey said in the Virginia Slims Case regarding the registrations of the mark he was dealing with in other jurisdictions :-

"Evidence has not been given in this case of the conditions, market or otherwise, obtaining in those jurisdictions, nor as to the user associated with the registrations, nor as to the law in those territories ... The most significant defect to my mind is that I

cannot know what evidence has been adduced in support of a particular registration so far as distinctiveness is concerned ... With due respect to the jurisdictions of the other territories, I think it fair to say that the United Kingdom, Australian and New Zealand registrations would appear likely to be of most assistance if all the facts were known. As it is, I can only regard the bald facts of their registrations as inconclusive ..." (at pages 29 and 31)

Scriven J. had this to say in the Virginia Slims Case

(at page 16) :-

"During the hearing of this appeal I heard considerable argument as to the admissibility and the effect of evidence of registration of the same trade mark in foreign jurisdictions. Only certificates thereof have been tendered in evidence and while I consider that the Registrar was entitled to say that the fact of registration with no supporting evidence to show upon what requirements on evidence it was based, was of no particular effect, I myself would have taken a more liberal approach and would have supported the view expressed by Zimmern J. (in Re Bruschi and Lomb

Incorporated 1979 HKLR) that our trade marks Registry ought not to turn a blind eye to the laws of Trade Marks in friendly Commonwealth countries ...".

These quotes from the Virginia Slims Case, and the passage from Kerly on the "Use or registration abroad" (para. 8-68, Kerly's Law of Trade Marks and Trade Names, 12th edition) give some guidance on how foreign registrations are to be looked. In para. 13 of his considered reply Mr. Chan refers to the registrations of "Carrera" in various countries, but there is no evidence before me, other than the statement by Mr. Chan, of the law relating to the territories where the mark has been registered nor any evidence relating to the other matters mentioned by Mr. Grindey. "Carrera" has not been registered in any friendly Commonwealth country so the considerations mentioned by Scriven J. in the Virginia Slims Case cannot apply. In the circumstances, the bald fact of the registrations of "Carrera" in the countries referred to in para. 13 of Mr. Chan's considered reply does not, ipso facto, assist the Applicant.

I refer finally to para. 17 of Mr. Chan's considered reply where he referred to Section 34(a) of the Trade Marks Ordinance. In this respect, I would refer to the headnote of the Chunky Trade Mark (Fleet Street Reports 1978, at page 322) and refer to the headnote of this case, which was a decision by Whitford J., namely :-

"that when registrability is in issue, it is not appropriate to consider the fact of Section 5(2) or Section 8 of the Trade Marks Act 1938" (Sections 28(2) and Section 34 of the Trade Marks Ordinance are the Hong Kong equivalent of the sections in the Trade Marks Act 1938 previously referred to).

For the reasons set out above, I am of the view that "Carrera" is a word which is according to its ordinary signification a surname and therefore falls foul of Section ~~9(1)(d)~~ of the Trade Marks Ordinance. No evidence of use having been submitted to the Registrar of Trade Marks, "Carrera" cannot be accepted for prima facie registration in Part A of the Register. The acceptance of the mark for registration in the leave to advertise issued on 30th September 1987 was an acceptance in error within the meaning of Section 17(1) of the Trade Marks Ordinance.

R. Perera

R.J. PERERA

Date : 16th June 1989.