

Application No. 5715/86

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

AND

IN THE MATTER of an application for
registration of the Trade Mark

OYSTER

in Class 18 in Part A of the Register by
Samsonite Corporation

AND

IN THE MATTER of an opposition thereto
by Montres Rolex S.A.

DECISION
OF

Mr M.W. Fox acting for the Registrar of Trade Marks after a hearing on Tuesday, 14th
February, 1995.

Appearing : Mr Martin Liao, Counsel, instructed by Wilkinson & Grist on behalf of the
Applicant, Samsonite Corporation

Ms Winnie Tam, Counsel, instructed by Johnson Stokes & Master on
behalf of the Opponent, Montres Rolex S.A.

On 18th December 1986 Samsonite Corporation (hereinafter called "the Applicant") of Denver, Colorado, United States of America applied under the Trade Marks Ordinance (hereinafter called "the Ordinance") for registration of the trade mark **OYSTER** in Part A of the Register in Class 18 in respect of "leather and imitations of leather, and articles made from these materials, and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery" (hereinafter called "the specified goods").

2. Leave to advertise the suit mark in respect of the specified goods was given on 30th September 1991. The suit mark was advertised in the Gazette on 25th October 1991.

3. The application was opposed by Montres Rolex S.A. (hereinafter called "the Opponent") of Geneva, Switzerland, which lodged its notice of opposition on 3rd January 1992 on grounds, effectively, that :-

- (a) The Opponent is primarily a manufacturer and vendor of watches and related goods, including parts and fittings for watches.
- (b) The Opponent directly or indirectly manufactures leather wallets and bags, purses, leather notebook holders, scarves, letter openers contained in imitation leather sheaths, leather cheque book holders, handkerchiefs, perfumes, key rings, pens and pen stands, leather spectacle cases, leather credit card holders, leather diaries and notebooks and leather attache cases.
- (c) The related goods in (b) bear the **ROLEX** and/or **CROWN Device** marks.
- (d) The Opponent's watches and watch bracelets, in addition to bearing the **ROLEX** and/or **CROWN Device** marks, carry a variety of additional marks dependent on the particular range or model of watch.
- (e) The Opponent's most successful and well known watch is its **OYSTER** watch.
- (f) The Opponent first used its **OYSTER** mark in 1926.
- (g) The Opponent's **OYSTER** mark has been registered in many countries worldwide.
- (h) The Opponent's **OYSTER** mark is registered in Hong Kong under No. 456/51 in respect of horological instruments and parts thereof.

- (i) By virtue of substantial use in Hong Kong and elsewhere the Opponent enjoys a substantial reputation and goodwill in its **OYSTER** mark.
- (j) The Opponent's **OYSTER** mark has achieved such a very high level of recognition and fame that reference to an **OYSTER** mark in any context is synonymous with the Opponent.
- (k) Although the Opponent has not traded in **OYSTER** marked Class 18 goods it has traded in **ROLEX** and/or **CROWN Device** marked Class 18 goods so that the Opponent is well known as having a direct business interest in Class 18 goods and other luxury goods such as perfumes in Class 3 and clothing in Class 25.
- (l) The Applicant, a well known manufacturer and supplier of **SAMSONITE** marked travelling suitcases and the like, is not interested in the majority of the specified goods.
- (m) The specified goods cover all leather and imitation leather products such as cheque book holders, attache cases, wallets, notebooks, purses, letter opener sheaths and similar goods which form part of the Opponent's business activities.
- (n) Use of **OYSTER** by the Applicant will give rise to the mistaken belief or impression the specified goods emanate from the Opponent or are in some way endorsed by it.
- (o) As the suit mark is **OYSTER** alone the Opponent assumes it is the Applicant's intention to use it separate and distinct from the Applicant's **SAMSONITE** mark.
- (p) Even if **OYSTER** and **SAMSONITE** are used together the Opponent's substantial fame and goodwill in the **OYSTER** mark may cause deception or confusion in course of trade such that the trade or public may incorrectly consider there is some connection between the Applicant and the Opponent.
- (q) The suit mark is not a trade mark under section 2 of the Ordinance.
- (r) The suit mark is not registrable under sections 9 or 10 of the Ordinance.
- (s) Use of the suit mark in Hong Kong would be likely to deceive or would be disentitled to protection in a Court of justice or would be contrary to law such that registration would contravene section 12(1) of the Ordinance.

- (t) As at the application date the Applicant wrongly claimed proprietorship of the suit mark, which it did not propose to use for all the specified goods, the application does not satisfy section 13(1) of the Ordinance.
- (u) Registration of the suit mark would contravene section 20 of the Ordinance.
- (v) Registration of the suit mark would unfairly prejudice the legitimate business interests of the Opponent.

4. The Opponent also seeks refusal of registration in exercise of the Registrar's discretion.

5. The Applicant by its counter-statement lodged on 6th June 1992 relies, effectively, on the following grounds in support of its application :-

- (a) The Applicant began using the **OYSTER** mark on Class 18 goods in January 1986.
- (b) The Applicant has used the **OYSTER** mark in Hong Kong since February 1986.
- (c) The Applicant's **OYSTER** mark is registered for Class 18 goods in Benelux, Canada, France, Germany, Italy and the United Kingdom, most registrations dating back to 1984.
- (d) By virtue of long and substantial use by the Applicant of the **OYSTER** mark for Class 18 goods in Hong Kong and elsewhere it has become distinctive of and/or is capable of distinguishing the specified goods under sections 9 and/or 10 of the Ordinance.
- (e) The Applicant's **OYSTER** mark is a trade mark under section 2 of the Ordinance and the Applicant is entitled under section 13(1) to apply for and obtain registration of the same.
- (f) As the Opponent has admitted in its pleadings (see paragraph 3(k)) it has not traded in **OYSTER** marked Class 18 goods it "should not have obtained registration of the mark **OYSTER** in Class 18".
- (g) Registration of **OYSTER** for the specified goods would not contravene section 20 of the Ordinance.

- (h) Registration of the suit mark would not contravene section 12(1) of the Ordinance.
 - (i) Registration of the suit mark would not unfairly prejudice the legitimate business interests of the Opponent.
6. The Applicant also seeks registration in exercise of the Registrar's discretion.
7. Evidence on behalf of the Opponent comes in a declaration dated 9th December 1992 of Armin Anton Diethelm, Managing Director of Rolex (Hong Kong) Ltd, one of the Opponent's subsidiaries.
8. Mr Diethelm says the Opponent is an internationally famous Swiss company with subsidiaries and associated companies in many countries including Hong Kong. He exhibits (A) copy extract from the Swiss Companies Registry and an English translation of the first page.
9. Mr Diethelm says the Opponent is a world famous manufacturer and seller of watches and related goods.
10. Mr Diethelm repeats information in the notice of opposition (see paragraph 3(e), (f) and (h)).
11. Mr Diethelm says the Opponent's **OYSTER** mark has been used extensively worldwide including Hong Kong. He exhibits (B) copy United Kingdom Daily Mail advertisement dated 24th November 1927 and Hong Kong advertisements between 10th February 1980 and 20th November 1985.
12. Mr Diethelm says the Opponent's **OYSTER** mark is used on the Opponent's goods and in advertisements and promotional materials for them. He exhibits (C) copy brochure showing the Opponent's **OYSTER** watches.
13. Mr Diethelm says the Opponent's **OYSTER** mark is used on wood, leather or substitute leather presentation cases. He says although the presentation cases are not traded in their own right they are provided to customers as a part inducement to purchase the Opponent's **OYSTER** watches. Mr Diethelm says the presentation cases bear the **OYSTER** mark. He exhibits (D) photographs of the Opponent's **OYSTER** marked presentation cases.
14. Mr Diethelm repeats assertions in the Opponent's pleadings (see paragraph 3(i), (j) and (v)).

15. Mr Diethelm says the Opponent has substantial worldwide sales of its watches and related products, particularly its **OYSTER** watches. He says the Opponent has a very high level of local sales of such goods. Mr Diethelm says monthly turnover is many millions of Hong Kong dollars. He declines, for reasons of confidentiality, to give any annual turnover figures. Mr Diethelm considers there is no doubt the Opponent's Hong Kong business is substantial now, as it was at, and many years before, the application date.

16. Mr Diethelm, for reasons of confidentiality, does not disclose the Opponent's expenditure on advertising its products in Hong Kong. He says the amount is substantial. Mr Diethelm considers the advertisements in exhibit (B) clearly illustrate the high level of the Opponent's advertising in Hong Kong newspapers. He continues the Opponent has spent substantial money on other advertising and sponsorship including local television weather reports.

17. Mr Diethelm says although the Opponent has not directly traded for profit in **OYSTER** marked Class 18 goods its business activities include such goods and goods in other classes. He says Class 18 goods indirectly increase or maintain the profitability of the Opponent's overall business. Mr Diethelm exhibits (E) copy photographs illustrating a variety of the Opponent's other goods, some being Class 18 goods. He says these goods are an integral part of the Opponent's business. Mr Diethelm says the substantial number of purchasers or likely purchasers of the Opponent's goods have access to or are provided with a wide variety of these goods, all bearing the Opponent's **ROLEX** and/or **CROWN Device** marks and, on some of them, its **OYSTER** mark too. He submits exhibit (E) shows the Opponent has an extensive business in attache cases, wallets, bags, presentation cases, cheque book holders, credit card holders and note pads, all Class 18 luxury goods. Whilst acknowledging such goods may not be relevant to these proceedings, he says their circulation to the trade and public promotes the Opponent's **OYSTER** watches. Mr Diethelm submits there is a very close connection between the Opponent and Class 18 goods.

18. Mr Diethelm repeats the assertion in the Opponent's pleadings (see paragraph 3(1)). He says the Applicant is a well known manufacturer and supplier of **SAMSONITE** marked travelling suit cases made of plastic and similar products. Mr Diethelm submits goods in the nature of the specified goods formed a recognised part of the Opponent's business activities prior to the application date.

19. Mr Diethelm says application No. 2194/90 by the Applicant to register **SAMSONITE** in Class 14, with specific reference to travel clocks, demonstrates a clear and close association between Class 14 and Class 18 goods. He says this reinforces the Opponent's belief that use by the Applicant of **OYSTER** is likely to give rise to the mistaken belief or impression such goods emanate from the Opponent or are endorsed by

19. Mr Diethelm is convinced the Applicant would agree with this if the Opponent tried to register **SAMSONITE** in Class 14 for watches and clocks. To Mr Diethelm it is clear **SAMSONITE** watches would then, inevitably, be connected with the Applicant rather than the Opponent or another party. He says the Opponent considers **OYSTER** marked Class 18 goods will inevitably be associated with the Opponent, the trade and public, including existing customers of the Opponent, perceiving some connection between the Applicant and the Opponent.

20. Mr Diethelm says the Opponent owns the **OYSTER** mark in America for Class 18 goods. He says there is an agreement, which does not extend to Hong Kong, licensing the use of the mark to the Applicant for a limited period for one of its product lines.

21. Mr Diethelm submits, although the Applicant may use **OYSTER** with its **SAMSONITE** mark, which could lessen any risk of deception or confusion, registration of the suit mark for the specified goods would entitle the Applicant to use **OYSTER** alone in relation to such goods and take infringement action against any use of the same or a similar mark in respect of any of the specified goods.

22. Mr Diethelm exhibits (F) an extract from a French book "Chic and Tock" ("Chic & Fake") by Brodbeck and Mongibeaux together with an English translation. He points out the authors assumed, rightly or wrongly, the adoption by the Applicant of the **OYSTER** mark constituted "a homage of **SAMSONITE** to the Swiss brand". In Mr Diethelm's view the Applicant adopted the **OYSTER** mark in an attempt to ride on the goodwill of the Opponent in its **OYSTER** watches and related promotional and other products. He submits the book "Chic and Tock" shows the Applicant is attempting to benefit from the substantial reputation of the Opponent in **OYSTER** watches, which are known for their reliability and physical qualities in many respects similar to those of an oyster.

23. Mr Diethelm submits the Opponent can rely on its Hong Kong Class 14 registration of **OYSTER** to mount an opposition under section 20 of the Ordinance. He says the registered mark has an important role in the reputation and goodwill of the Opponent.

24. Mr Diethelm submits if the suit mark is registered for the specified goods deception or confusion would arise in course of trade and persons would be caused to wonder whether or not there is some connection between the Applicant and the Opponent. He says there is such a connection in the United States.

25. Evidence on behalf of the Applicant comes in a declaration dated 23rd August 1993 of Michael Clayton, the Applicant's Vice-President, Legal.

26. Mr Clayton says the Applicant first adopted the **OYSTER** mark around 1984 for a new line of luggage, trunks and bags. He says the **OYSTER** mark was chosen to reflect the tough product design, affording extremely good protection against water, dust and dirt.
27. Mr Clayton says since around 1985 the Applicant's **OYSTER** products have been sold in many countries including America, France, Germany, Italy, Hong Kong and the United Kingdom.
28. Mr Clayton says the Applicant's **OYSTER** marked products have been sold in Hong Kong since around April/May 1986. He exhibits (MC-1) copy invoices supporting sales of the Applicant's **OYSTER** marked products in Hong Kong and elsewhere.
29. Mr Clayton gives approximate annual sales details of the Applicant's **OYSTER** marked products in Hong Kong and worldwide for the years 1986-1992 inclusive. They show some 400 units were sold in Hong Kong and about 200,000 units were sold worldwide in 1986.
30. Mr Clayton says the Applicant's **OYSTER** marked products have been extensively advertised worldwide, including Hong Kong, in newspapers and magazines and on television and through promotional materials. He exhibits (MC-2) copy promotional and advertising material.
31. Mr Clayton gives approximate annual expenditure on advertising the Applicant's **OYSTER** marked products in Hong Kong and worldwide for the years 1986-1992 inclusive. They show some US\$20,000 was spent in Hong Kong and about US\$90,000 was spent worldwide in 1986. He exhibits (MC-3) copy credit vouchers and Hong Kong advertisements in support.
32. Mr Clayton says the Applicant, to protect the substantial reputation of its **OYSTER** mark, has spent much effort and money registering it for Class 18 goods in many countries including Canada, France, Germany, Italy and the United Kingdom. He exhibits (MC-4) some copy certificates.
33. Mr Clayton submits, by virtue of extensive use, advertisement and promotion since about 1985 in Hong Kong and elsewhere, the Applicant has acquired a substantial reputation in its **OYSTER** mark in Hong Kong and internationally and **OYSTER** has become distinctive of and identified with the Applicant and its products.
34. Mr Clayton says the Opponent has only used **OYSTER** for watches and their presentation cases. He submits any reputation the Opponent has in **OYSTER**

extends only to watches. Mr Clayton considers reference to an **OYSTER** mark in any context is not synonymous with the Opponent.

35. Mr Clayton says exhibits (B) and (C) show the Opponent always uses **OYSTER** with its **ROLEX** or **ROLEX & CROWN Device** marks. He submits any reputation and goodwill the Opponent has come primarily from use of its **ROLEX** and/or **CROWN Device** marks and not solely from use of **OYSTER** by itself.

36. Mr Clayton notes the Opponent has not provided any sales turnover or advertising expenditure figures. He considers the Opponent must do this to substantiate its allegations.

37. Mr Clayton submits any connection between the Opponent's **OYSTER** mark and Class 18 goods is too remote. He says, even if Class 18 goods form an integral part of the Opponent's business, exhibit (E) shows they rarely, if at all, bear the **OYSTER** mark. Mr Clayton submits consumers identify the Opponent's Class 18 goods by the **ROLEX** and/or **CROWN Device** marks rather than the **OYSTER** mark, which has never been used by itself on any Class 18 goods sold by the Opponent for profit.

38. Mr Clayton submits there is no association between Class 14 and Class 18 goods. He considers use by the Applicant of its **OYSTER** mark will not be likely to give rise to the mistaken belief or impression by the trade or public that the specified goods emanate from the Opponent, or are connected with it, or come from the same or a related source. Mr Clayton believes the Opponent has not established that the degree of use by the Opponent of **OYSTER** on its watches makes **OYSTER** so well known that its reputation extends to Class 18 goods. He submits the Opponent has no reputation for **OYSTER** in relation to Class 18 goods.

39. Mr Clayton exhibits (MC-5) a copy of the agreement referred to by Mr Diethelm (see paragraph 20). He notes the agreement is a Settlement Agreement arising from proceedings in America between the Applicant and Rolex Watch U.S.A. Inc., not the Opponent. Mr Clayton says Clause 1 specifically provides that all terms are applicable only in relation to use of **OYSTER** in America. He says Clauses 4, 5 and 6 provide for Rolex Watch U.S.A. Inc. to pay the Applicant US\$60,000 for the **OYSTER** mark in America and its trade mark registration and for the Applicant to retain all its worldwide rights to use the **OYSTER** mark, including the right to use it for its **OYSTER** products worldwide including America. Mr Clayton says the Applicant is not the licensee of the Opponent.

40. Mr Clayton says the Applicant is not trying to benefit from the reputation of the Opponent in its **OYSTER** watches. He says the Applicant has established its own

reputation and goodwill in its **OYSTER** mark. Mr Clayton says the Applicant has demonstrated its choice of **OYSTER** was bona fide.

41. Mr Clayton says the Applicant is a world renowned manufacturer of Class 18 goods. He says **SAMSONITE** is the Applicant's trade name and house mark.

42. Mr Clayton says the Applicant's **OYSTER** products are sold at specialist travel luggage and suitcase retail outlets. He says they are also sold from specialized sections of department stores. Mr Clayton believes the Opponent's goods are sold in specialist high quality watch and jewellery retail outlets. He submits, in view of the entirely different trade channels for the sale and purchase of the Applicant's **OYSTER** marked products and the Opponent's watches, there is not likely to be any possibility of confusion between them. Mr Clayton is not aware of any confusion having occurred anywhere since the Applicant's **OYSTER** marked products have been on the market.

43. Mr Clayton submits, as the Opponent has no Hong Kong registration of any trade mark identical with or nearly resembling the Applicant's **OYSTER** mark for Class 18 goods or goods of the same description as the specified goods, the Opponent cannot mount an opposition under section 20 of the Ordinance.

44. Mr Clayton considers there is no basis for the Opponent's bare assertions that deception or confusion would inevitably arise in course of trade and that use and registration of the Applicant's **OYSTER** mark would unfairly dilute the Opponent's exclusive rights in its **OYSTER** mark and would unfairly prejudice the legitimate business interests of the Opponent. He submits the Opponent has not established any independent use or reputation for its **OYSTER** mark in relation to Class 18 goods. Mr Clayton notes the Opponent has not provided any evidence of actual confusion during the period the Applicant's **OYSTER** mark and the Opponent's mark have co-existed.

45. Mr Clayton submits the Applicant's **OYSTER** mark has acquired distinctiveness in relation to the Applicant's products and the suit mark is registrable under section 9 of the Ordinance.

46. Though the Opponent is the Hong Kong registered proprietor of **OYSTER** under No. 456/51 in Class 14 for horological instruments and parts thereof, Ms Tam, appropriately, did not seek to rely on it for the purpose of opposing under section 20 of the Ordinance. None of the goods covered by this registration are the same as any of the specified goods. Applying the various matters to be taken into account in deciding whether goods are of the same description classified by **Romer J in the "Panda" Case (1946) RPC 59**, none of the goods covered by this registration are goods of the same description as any of the specified goods.

47. The opposition is based on section 12(1) of the Ordinance.

48. Section 12(1) of the Ordinance, applicable to these proceedings, is as follows :-

Section 12(1)

"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."

49. Whilst there are slight differences between section 12(1) of the Ordinance and section 11 of the United Kingdom Trade Marks Act 1938 (the likelihood of deception, which is wide enough to catch confusion, being an independent ground of objection under section 12(1)), decisions on section 11 of the 1938 Act are relevant to section 12(1) of the Ordinance and it can be considered on much the same basis as section 11 of the 1938 Act.

50. The accepted tests to be applied to cases under section 12(1) of the Ordinance are those propounded by **Evershed J in Smith Hayden and Co's Application (1946) 63 RPC 97 at page 101**. Adapted to the features of the suit case and with the recognised glosses they may be expressed as follows :-

"Having regard to the awareness of the Opponent's mark is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be likely to cause deception and confusion amongst a substantial number of persons? May a number of people be caused to wonder whether the goods under the respective marks come from the same source? Is there a real tangible danger of confusion if the applied for mark is put on the Register?"

51. The reference to "substantial" is a question to be judged in relation to the markets for the goods concerned. "Persons" are all those people likely to become purchasers of the goods upon which the respective marks are used.

52. I do not have a discretion under section 12(1) of the Ordinance. If the Opponent succeeds registration must be refused. If I am in doubt registration must be refused.

53. The onus is on the Applicant to defeat the opposition under section 12(1) of the Ordinance. This is done by satisfying me there is no reasonable probability of

deception or confusion, the test, in different words, being whether use of the suit mark by itself on the specified goods, in any manner which can be regarded as normal fair use of it, will be calculated to deceive or cause confusion, without necessarily leading to passing-off. The suit mark must offend if it is likely to cause deception or confusion in the minds of persons to whom it is addressed, even if actual purchasers will not ultimately be deceived. Likely purchasers must not be put into a state of doubt. It is enough if an ordinary person entertains a reasonable doubt.

54. To bring section 12(1) of the Ordinance into operation an opponent must have some reputation for its mark in Hong Kong derived from user in the widest sense or awareness of it here.

55. The actual extent of the reputation of the Opponent's mark and the range of goods for which it has been achieved are factors in determining whether there is sufficient likelihood of deception or confusion to warrant refusal of registration under section 12(1) of the Ordinance.

56. Section 12(1) of the Ordinance also extends to cases where an opponent's mark has been used upon goods of a different description from or not closely related to those for which registration is sought if confusion may be likely due to the mark of an opponent being particularly well known or unusually inventive or an applicant having closely copied a very distinctive mark.

57. I must decide whether the public at large, purchasers or likely purchasers of the Applicant's and Opponent's goods bearing their respective marks, would infer they come from the same source or at least be caused to wonder whether that might not be so. Having regard to the reputation of the Opponent's mark in Hong Kong at the relevant date I must decide whether it would be likely that the public would be deceived or confused if that mark or a similar mark is used in relation to any of the specified goods.

58. The relevant date for determining these proceedings is 18th December 1986, the date the Applicant applied for registration of the suit mark.

59. I will consider whether an opposition can be mounted under section 12(1) of the Ordinance.

60. As Mr Liao said the initial onus is on the Opponent to establish a reputation for its mark in Hong Kong. If it succeeds in doing that the onus shifts to the Applicant to establish the proposed registration would not be reasonably likely to cause deception or confusion among a substantial number of persons.

61. Mr Liao submitted the Opponent has not provided any sales information

relating to its **OYSTER** marked products. He said no sales figures have been given and no supporting invoices provided. Mr Liao said the Opponent has not provided details of any advertising or promotional expenditure for its **OYSTER** marked products. He said the Opponent has provided some evidence its **ROLEX OYSTER** watches were advertised in Hong Kong prior to the application date. Mr Liao said the Opponent has shown use of **OYSTER** on a presentation case for the Opponent's **ROLEX OYSTER** watch and has produced a photograph of a scarf marked **ROLEX OYSTER**. He said there is no evidence **ROLEX OYSTER** marked scarves, which the Opponent has admitted are promotional items, were distributed in Hong Kong before the application date. Mr Liao concluded there is not sufficient information before me to reach a finding the Opponent's **OYSTER** mark had any reputation in Hong Kong prior to the application date to enable the Opponent to oppose under section 12(1) of the Ordinance.

62. Mr Liao said the Opponent has only shown use of its **OYSTER** mark with its **ROLEX** mark. That use, he submitted, is not enough. Mr Liao submitted the Opponent cannot rely on the reputation of its **ROLEX** mark to aid the reputation of its **OYSTER** mark. He said the Opponent has not shown **OYSTER** is synonymous with **ROLEX** in whatever context it is used. Mr Liao said all the promotional and other items given away by the Opponent to advertise its watches show its **ROLEX** and/or **CROWN Device** marks. He said use of **OYSTER** has only been demonstrated on presentation cases and scarves, in each case with the Opponent's **ROLEX** mark. Mr Liao submitted use of a mark on promotional items does not establish a reputation in that mark. He said there was no such finding in **Lego v Lego M Lemelstrich Ltd (1983) FSR 155**. Mr Liao submitted the scarf will be recognised and referred to as a **ROLEX** scarf rather than an **OYSTER** scarf. He submitted, citing **Bugatti TM (1993) 1HKC 557**, that the Opponent has shown no use of **OYSTER** for Class 18 goods and has not demonstrated the Opponent's **ROLEX** and **OYSTER** marks are virtually interchangeable such that the reputation of **OYSTER** for watches spills over into goods in the nature of the specified goods. Mr Liao concluded that, if the advertisements for the Opponent's **ROLEX OYSTER** watches and the unknown extent of the distribution of the Opponent's **OYSTER** presentation cases give the Opponent some reputation for **OYSTER** in Hong Kong, the extent of the reputation is not sufficient to cross the minimum reputation threshold required to allow the Opponent to oppose under section 12(1) of the Ordinance.

63. To Mr Liao the Opponent's **OYSTER** mark had no or insufficient reputation in Hong Kong at the application date. He submitted the Opponent cannot oppose under section 12(1) of the Ordinance.

64. Ms Tam said **OYSTER** has been used by the Opponent since 1926. She referred to the 1927 advertisement for the Opponent's **ROLEX OYSTER** watch (exhibit B). Ms Tam observed **OYSTER** is at least as prominent as **ROLEX** in this advertisement and other advertisements in exhibits (B) and (C). She submitted the almost

invariable use of **OYSTER** with **ROLEX** does not detract from the reputation of **OYSTER** established thereby. Ms Tam submitted the reputation of **OYSTER** benefits from its joint use with **ROLEX**, a mark in which the Opponent has very considerable goodwill. She said **OYSTER** is connected with the Opponent. Ms Tam said the Opponent has a longstanding worldwide reputation in its **OYSTER** mark, sustained by many years of continuous sales, advertising and promotion. She said exhibit (B) includes many pre-application date Hong Kong advertisements for the Opponent's very wide and extremely important range of **OYSTER** watches. Ms Tam said exhibit (D) shows **OYSTER** used on the inside of a presentation case for the Opponent's watches, distributed in Hong Kong. She said exhibit (E) shows use of the Opponent's **OYSTER** mark on scarves, which in the context of the Opponent's evidence as a whole should be presumed to have been available in Hong Kong prior to the application date. Ms Tam submitted, citing **Bugatti TM**, the Opponent has a long established pre-application date Hong Kong reputation for its **OYSTER** mark well sufficient to enable the Opponent to oppose under section 12(1) of the Ordinance.

65. Exhibit (B) shows many Hong Kong advertisements, dated between February 1980 and November 1985, for the Opponent's **OYSTER** watches, available for local purchase. Though the Opponent has failed to supply any sales or advertising figures and has not provided any invoices showing pre-application date sales of any of its watches in Hong Kong, the advertisements establish for the Opponent sufficient reputation in its **OYSTER** mark to enable the Opponent to oppose under section 12(1) of the Ordinance.

66. I will consider the similarity of the respective marks by comparing them. I must establish the reasonable probability of deception or confusion governed by the well established principles laid down by **Parker J in Pianotist Co's Application (1906) 23 RPC 774**. They are as follows :-

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

67. The resemblance between the marks must be considered with reference to the ear as well as to the eye. An ordinary person is expected to exercise reasonable care and be of normal intelligence but no more. His memory is imperfect. Marks are remembered by general impression or some significant detail, rather than by photographic recollection of the whole. Too detailed an examination of the marks should not be made. The question of resemblance is one of first impression. Marks should not be compared

side by side. They are compared as a whole, regard being had to the idea of each mark. Ultimately whether marks resemble each other or not is a question of fact, to be judged objectively.

68. Under Section 12(1) of the Ordinance the Opponent's mark is considered as actually used and the Applicant's suit mark is considered in notional fair use.

69. Notional fair use is any normal and fair use a registered proprietor may make of his mark in ordinary course of business in respect of goods covered by the registration.

70. Mr Liao said the Opponent uses its **OYSTER** mark with its **ROLEX** mark and sometimes its **CROWN Device** mark too. He said there is no independent use of **OYSTER** by the Opponent. Mr Liao submitted this manner of actual use must be taken into account under section 12(1) of the Ordinance. He argued the Opponent has no monopoly to use **OYSTER** in relation to all goods. Mr Liao said the Opponent's monopoly to use **OYSTER** is confined to horological instruments. He submitted the Applicant is entitled to use **OYSTER** to indicate the toughness or durability of its goods. Mr Liao said the Opponent has no exclusive right of ownership in the idea conveyed by its **OYSTER** mark. He submitted the Opponent is seeking to fence off **OYSTER**, an English dictionary word, and prevent its use by other than the Opponent.

71. Mr Liao said the Opponent has only traded for profit in **OYSTER** marked watches. He said the Opponent has used its **OYSTER** mark since 1926 for watches. Mr Liao said the Opponent has not expanded its use of its **OYSTER** mark in nearly seventy years since its first use. He said the Opponent is still a watch manufacturer, though it now distributes, but does not sell, a range of gift items with its marks on them to promote its watches. Mr Liao said there is no evidence to show any other **OYSTER** marked goods were available in Hong Kong prior to the application date. He said there is no evidence of the availability or manner of distribution anywhere of **OYSTER** marked goods other than watches. Mr Liao said the gift items on which the Opponent uses its **ROLEX** and/or **CROWN Device** marks are not traded. He said such items are not available for purchase. Mr Liao said the **OYSTER** marked presentation cases are not traded. He said when an **OYSTER** watch is sold it is handed over to the purchaser in a presentation case bearing the **OYSTER** mark on the inside. That, Mr Liao said, is the only way a member of the public can obtain an **OYSTER** marked presentation case. He said use of **OYSTER** on the presentation cases enhances the reputation of the Opponent's **OYSTER** watches. Mr Liao said scarves are not Class 18 goods. He submitted use of **ROLEX OYSTER** on scarves given away as promotional items is not use of **ROLEX OYSTER** in a trade mark sense in relation to scarves. Mr Liao said the Opponent has not shown use of **OYSTER** in a trade mark sense on Class 18 goods anywhere in the world at any time. He submitted the Opponent has not shown any evidence of intention to trade for profit in **OYSTER**

marked Class 18 goods. Mr Liao said the Opponent has only used its **OYSTER** mark in a trade mark sense on its watches. He said watches and the specified goods are totally different goods.

72. Mr Liao submitted the trade channels for the sale and purchase of the parties' respective goods are very different, though he accepted that, as watches and the specified goods are not inherently specialized items, there will inevitably be some overlap at times between the nature and kind of customer likely to buy them. Mr Liao said the Opponent's **OYSTER** watches, as opposed to watches in general, are very expensive items purchased with considerable care. He submitted this would further decrease any likelihood of deception or confusion between the parties' **OYSTER** marked goods. Mr Liao said, citing **Mitac TM (1992) 2 HKC 22**, it is necessary to have regard to this as a surrounding circumstance of purchase.

73. Mr Liao submitted the Applicant, through extensive sales and advertising, has acquired a substantial reputation in its **OYSTER** marked products worldwide including Hong Kong. He says the evidence shows a considerable amount of money was spent advertising the Applicant's **OYSTER** products in Hong Kong in 1986, the year of the suit application and the year the Applicant began selling its goods here. Mr Liao submitted that, by virtue of extensive sales and advertising worldwide, including Hong Kong, **OYSTER** signifies a connection in course of trade between the Applicant and its products.

74. Mr Liao said there is no evidence of confusion anywhere in the world, including Hong Kong, despite nearly ten years user by the Applicant of its **OYSTER** mark in Hong Kong. He submitted that, though the likelihood of confusion is considered at the date of application to register, subsequent experience is relevant as providing a test of tendency to confuse. Mr Liao said exhibit (F), in which the respective **OYSTER** marks of the parties are commented on together, clearly shows there is no confusion between them.

75. Mr Liao submitted the cases of **Lego v Lego**, **M. Lemelstrich Ltd and Kodak (1898) 15 RPC 105** are irrelevant as they concern household marks. He said **Ames Crosta v Pionex International (1977) FSR 46**, **Alfred Dunhill v Sunoptic (1979) FSR 377** and **Portakabin v Powerblast (1990) RPC 427** were decided on the basis of male fides of the unsuccessful party. Mr Liao said there was no male fides by the Opponent in its choice of **OYSTER** for the specified goods.

76. Mr Liao said the American Settlement Agreement (exhibit MC-5), apart from not benefiting the Opponent as it was not a party to it, has no relevance to the suit proceedings. He said the Agreement specifically states it does not affect the rights of the parties outside America. Mr Liao said, under the Agreement, the Applicant's **OYSTER**

mark was purchased without prejudice to the Applicant's previous rights to use it in America. He submitted this is an acknowledgement of the Applicant's rights in its **OYSTER** mark.

77. Mr Liao submitted the Applicant's **OYSTER** mark was at the application date distinctive of the Applicant's products in Hong Kong. He said the Applicant then had, as it has now, a proprietary right in its **OYSTER** mark for the specified goods. Mr Liao said the Applicant proposes to use the **OYSTER** mark in respect of all the specified goods. He submitted this proposal is implicit in the application. Mr Liao said the Opponent has not provided any evidence to contradict it. He submitted the Applicant rightly claimed to be proprietor of the **OYSTER** mark when it applied to register the suit mark for the specified goods.

78. Mr Liao submitted that there are no prior rights in the **OYSTER** mark vested in the Opponent or any other party in respect of Class 18 goods to prevent the Applicant being registered for the specified goods.

79. Mr Liao submitted the Applicant should be allowed to register **OYSTER** for the specified goods as use of the mark in relation to them will not give rise to the reasonable probability of deception or confusion.

80. Ms Tam said **OYSTER** is a very innovative mark that has become highly distinctive of the Opponent's products through extensive worldwide use since 1926. She submitted **OYSTER** is recognized by the public as indicating a connection between such marked goods and the Opponent. Ms Tam submitted the Opponent's idea of **OYSTER** is unique. She said no other legitimate trader, apart from the Applicant, uses **OYSTER**, the same mark, to indicate the toughness and physical attributes of its goods. Ms Tam said, referring to exhibit (B), the Opponent was in 1927 describing its **OYSTER** watch as "the wonder watch that defies the elements" and "proof against changes of climate, dust, water, damp, heat, moisture, cold, sand or grease". She said the Applicant uses **OYSTER** in the same way. Referring to exhibit (MC-2) she said the Applicant uses phrases such as "as safe as inside an **OYSTER**" and "this **OYSTER** has a stronger shell". Ms Tam said the Applicant has adopted the idea created by the Opponent. She said the Applicant uses **OYSTER** in precisely the same manner as the Opponent to convey an impression of strength, safety, durability and toughness. Ms Tam submitted this will cause **OYSTER** marked goods of the Applicant to be linked with those of the Opponent.

81. Referring to exhibit (F), she said the book's authors had linked the two marks even though they knew the Applicant sells suitcases and the Opponent sells watches. Ms Tam submitted that though the authors were not confused likely purchasers would be. She submitted the likelihood of confusion is increased because watches and the specified goods are similar in price range. Ms Tam submitted the nature and kind of

likely purchaser of the respective parties' goods will inevitably overlap. She submitted likely purchasers of the respective parties' goods would at least be caused to wonder whether or not a trade connection exists between the Applicant and the Opponent.

82. Ms Tam submitted, citing **Lego v Lego M Lemelstrich**, the Opponent's **OYSTER** mark had such a high reputation in Hong Kong at the application date for watches that reputation naturally extended to other fields of activity. Ms Tam submitted, citing **Kodak**, that whilst there is no evidence of a close connection between the Applicant's specified goods and the Opponent's watches the Opponent has shown a substantial trade in many goods including leather **OYSTER** presentation cases which are used for its watches. She said this is to be taken into account. Ms Tam submitted lack of evidence of a close connection between watches and the specified goods does not prejudice the Opponent. She said as many presentation cases have been distributed as **OYSTER** watches sold. Ms Tam submitted, citing **Ames Crosta v Pionex International**, the fields of activity of the Applicant and the Opponent are naturally allied. Such an alliance, she said, exists between watches, leather presentation cases for watches and the specified goods. Ms Tam submitted the evidence shows the Opponent deals in goods other than watches in normal course of trade. She submitted the promotional items and other goods are a legitimate part of the Opponent's business. Ms Tam said the promotional items, including **OYSTER** marked scarves in exhibit (E), all convey the same image as the highly reputable **OYSTER** watch. She submitted, citing **Lego v Lego M. Lemelstrich**, the Opponent's use of **OYSTER** on promotional items and presentation cases is a relevant factor for consideration. Ms Tam said it is implicit, from the context of the evidence as a whole, the promotional items and goods shown in exhibit (E) were available in Hong Kong prior to the application date. Referring to exhibit (A) she said this shows the Opponent is a manufacturer and trader of watches, instruments for measuring time and parts and fittings, such as cases, boxes etc. Ms Tam said it is clear the Opponent's legitimate business interests extend beyond horological instruments. She said use by the Opponent of its **OYSTER** mark on its scarves shows the Opponent's activities now extend into clothing items. Ms Tam submitted Class 18 goods and Class 25 goods are closely related. She submitted, citing **Alfred Dunhill v Sunoptic**, it is not necessary for all the Opponent's promotional items and other goods shown in exhibit (E) to have been distributed in Hong Kong prior to the application date for a natural connection between the Applicant's and the Opponent's goods to exist. Ms Tam said registration of **OYSTER** by the Applicant for the specified goods would unfairly thwart the Opponent's plans for the natural expansion of its trading operations into Class 18 goods.

83. Ms Tam said that the Applicant has not explained why it chose **OYSTER**. She said the Applicant must have known the Opponent was using **OYSTER** when it chose the mark for the specified goods. Ms Tam submitted the evidence (see

paragraph 26) explaining the adoption by the Applicant of **OYSTER** does not go to the root of the choice.

84. Ms Tam submitted, citing **Portakabin v Powerblast**, the existence of the respective marks of the parties in Hong Kong for some years without evidence of confusion does not prejudice the Opponent. Ms Tam said absence of evidence of confusion is not the same as evidence of no confusion.

85. Ms Tam said the Opponent effectively owns the **OYSTER** mark for Class 18 goods in America. She said a subsidiary of the Opponent purchased the mark from the Applicant. Ms Tam said the Applicant is now using the Opponent's **OYSTER** mark in America under licence for luggage subject to detailed restrictions on its use.

86. To Ms Tam use of **OYSTER** by the Applicant for the specified goods would be likely to cause deception or confusion. She submitted registration would contravene section 12(1) of the Ordinance.

87. It is not possible to discover from decided cases any standard as to the amount of resemblance which may suffice to deceive or cause confusion. Except insofar as they lay down a general principle, cases are of little assistance in determining new questions of fact raised on other materials.

88. The absence of evidence of confusion does not prejudice the Opponent in any way in these proceedings.

89. Exhibit F is irrelevant. The authors are not experts on Hong Kong trade mark laws. Mr Diethelm quoted a translation of some of the words. The full phrase, as translated, is "a homage of Samsonite to the Swiss brand, and a symbol, which augurs the interest that the counterfeiters are going to have in this superior range of suitcases".

90. The terms of the Settlement Agreement, specifically confined to America, are not relevant to the proceedings before me.

91. The suit mark is shown in paragraph 1 hereof.

92. The Opponent also uses its **OYSTER** mark in unadorned, block capitals, much as shown herein. It is always used in conjunction with the Opponent's **ROLEX** mark and sometimes its **CROWN Device** mark too. This use of **OYSTER**, the manner of actual use to be considered for the purposes of comparison of the marks under section 12(1) of the Ordinance, lessens the impact of the Opponent's **OYSTER** mark but not sufficient to deny it any independent identity.

93. The evidence shows the Applicant began using its **OYSTER** mark in Hong Kong just prior to the application date. The earliest invoice in exhibit "MC1" is dated 11th December 1986.

94. Both the Applicant and the Opponent use the word **OYSTER** for their respective goods. **OYSTER** as used by the Applicant and the Opponent look and sound the same. The idea conveyed by **OYSTER** as used by both the Applicant and the Opponent is the same. **OYSTER** is a common dictionary word. An **OYSTER** is an edible marine bivalve mollusc having a rough irregularly shaped shell and occurring on the sea bed, mostly in coastal waters. Both parties use **OYSTER** in advertising in similar ways, which are not strictly compatible with any of the dictionary meanings of **OYSTER**. This cannot assist the Opponent further. The words used by the Applicant and the Opponent are identical.

95. The specified goods are set out in paragraph 1. They are diverse in nature and use. Some are worn. Some are decorative. Some are used when travelling (trunks, travelling bags), walking (umbrellas, parasols, walking sticks) or horse riding (whips, harness, saddlery). Some are made of leather or imitation leather. Apart from umbrellas and parasols they are fairly sturdy. Some of the specified goods are sold in leather goods shops. Others are sold in travel goods stores or specified outlets dealing in horse riding equipment. The Opponent's horological instruments are used to measure and indicate time. They are precision instruments made of precious or semi-precious metals. They are sold in specialist outlets. A watch, usually worn strapped to the wrist, has a decorative function too, being an item for personal adornment. As indicated some of the Applicant's goods (leather and imitation leather goods) are worn or carried, in part, for personal adornment. To that extent only, the nature and use, though not the composition, of the respective goods of the parties are the same. The specialized outlets through which the respective parties' goods are sold and purchased are different. Where both the Applicant's specified goods and the Opponent's watches and other horological instruments are sold in the same department store, they are placed in different sections thereof.

96. The nature, composition and use of the Applicant's specified goods and the Opponent's watches and other horological instruments are different, except to the very limited extent indicated. The trading channels for the sale and purchase of the Applicant's specified goods and the Opponent's watches and other horological instruments are different.

97. It follows the nature and kind of customers likely to buy the Applicant's specified goods and the Opponent's watches and horological instruments are different. Because the specified goods and watches and other horological instruments are not essentially expensive, specialized items, there will necessarily, from time to time, be some

overlap, in that likely purchasers of both sets of goods will come from the same stratum of society.

98. I consider watches and other horological instruments are not closely allied or related to leather or imitation leather goods or any other of the specified goods.

99. Exhibit (D) shows a presentation case with an **OYSTER** watch inside. The inside of the presentation case is marked **OYSTER QUARTZ**. The presentation cases are for use in connection with the Opponent's **OYSTER** watches. Exhibit (E) shows a selection of goods, some Class 18 goods, marked with the Opponent's **ROLEX** and/or **CROWN Device** marks. Apart from the scarf marked **ROLEX OYSTER** none of the items is marked with **OYSTER**. There is no indication any of the goods shown in exhibit (E) were distributed in Hong Kong prior to the application date. I cannot presume they were. The Opponent has acknowledged it has not traded in **OYSTER** marked Class 18 goods. If the **OYSTER** marked goods in exhibits (D) and (E) have been distributed as promotional items, use of **OYSTER** would not constitute trade mark use of **OYSTER** in relation to them. If such **OYSTER** marked products have been sold, there is nothing to suggest such sales were other than ancillary to the Opponent's main trade. In that event use of **OYSTER** on such goods would not constitute trade mark use of **OYSTER** in relation to the products. There is nothing in **Lego v Lego M. Lemelstrich** to contradict the premise that use of a mark on promotional items given away free does not constitute trade mark use in relation to those items (**Ferodo Ltd's Application (1945) 62 RPC 111**). This view is taken further in **Kodiak TM (1990) FSR 49** in which it was held there is not a trade in goods if they are merely ancillary to a wider trade. The purpose of such **OYSTER** marked promotional items as there are and the Opponent's **OYSTER** marked presentation cases is to enhance the reputation of the Opponent's **OYSTER** watches. There is no need for me to consider the exhibit (E) goods or other promotional items further. There has been no independent trade in any of the goods or items. Similarly there has been no independent trade in the Opponent's **OYSTER** presentation cases. When a purchaser buys an **OYSTER** watch it is delivered to him in a presentation case with **OYSTER** marked on the inside. Distribution of these cases is inextricably linked to the Opponent's **OYSTER** watches. Distribution is fully consistent with the Opponent's trade as a manufacturer and vendor of watches and other horological instruments. Exhibit (A) shows the Opponent is not a manufacturer or trader in goods in the nature of the specified goods. Despite having demonstrated it first used **OYSTER** over sixty seven years ago, the Opponent has not shown it has in the intervening period used **OYSTER** in a trade mark sense in relation to any goods other than horological instruments. The Opponent has not shown its **OYSTER** mark is registered in Switzerland, the country of the Opponent's origin, for Class 18 goods. The Opponent has not shown it has applied to register **OYSTER** in Hong Kong for Class 18 goods. If the Opponent had a genuine intention to use its **OYSTER** mark in a trade mark sense in relation to Class 18 goods it would have taken one, more or all of those steps by now. The **OYSTER** marked

presentation cases, whether made of leather or otherwise, and the **ROLEX OYSTER** scarves do not take the Opponent any further in these opposition proceedings.

100. It is extremely difficult for an opponent to show his mark is so famous for a particular set of goods that its reputation extends much beyond the fields of activity in which that Opponent is directly involved, where his mark is not an invented word. The habitual use of **OYSTER** with the Opponent's **ROLEX** mark and sometimes its **CROWN Device** mark too and the fact **OYSTER** is an English dictionary word firmly confines the reputation of the Opponent's **OYSTER** mark to watches and other horological instruments and closely related and allied goods. The Opponent has no general monopoly over the use of an ordinary dictionary word or the idea such word creates. **OYSTER**, a common dictionary word, is not so famous for the Opponent's watches that members of the public seeing **OYSTER** on the specified goods may be caused to wonder whether or not they might emanate from the Opponent.

101. The salutary words of **Cozens- Hardy M.R. and Farwell L.J.** in the **Perfection Case (1910) 26 RPC 837** extracted in **Yorkshire Copper Works Application (1953) 71 RPC 150** bear repeating. They are as follow :-

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure" and "the court should be careful not to interfere with other persons' rights further than is necessary for the protection of the claimant, and not to allow any claimant to obtain a monopoly further than is consistent with reason and fair dealing".

102. I conclude there is no likelihood of deception arising if each of the trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

103. **Under section 12(1)** : Having regard to the awareness of the Opponent's mark I am satisfied that the suit mark, if used in a normal and fair manner in connection with any of the specified goods, will not be likely to cause deception or confusion amongst a substantial number of persons. I consider a number of people may not be caused to wonder whether goods under the respective marks come from the same source. I consider there is no real tangible danger of confusion if the suit mark is put on the register for the specified goods.

104. I find the Applicant has defeated the opposition under section 12(1) of the Ordinance.

105. It follows the Applicant rightfully claimed to be the proprietor of the suit

mark in relation to the specified goods at the date of application. The making of the application is prime facie evidence of intention to use for all the specified goods. The Registrar cannot be called upon to institute an enquiry as to the intention of the Applicant. The burden rests on the Opponent of proving absence of intention. It has failed to discharge such burden. It does not matter the mark will not be used immediately (if this is the case) in relation to all the specified goods. I consider the Applicant has satisfied the requirements of section 13(1) of the Ordinance.

106. Though **OYSTER** has some illusory laudatory qualities ("the world is my oyster") they are sufficiently remote for the suit mark to be inherently adapted to distinguish the Applicant's specified goods. As **OYSTER** was correctly registered for the Opponent's Class 14 goods so it qualifies for registration in the name of the Applicant for the specified goods. The suit mark meets the requirements of section 9 of the Ordinance.

107. That being so the exercise of my discretion arises. This is a discretion under section 13(2) of the Ordinance to refuse registration to a mark which complies with section 9, that is not prohibited by section 12(1).

108. This discretion is of a judicial nature to be exercised on reasonable grounds with regard to all the circumstances of the case. My prime concern is for the public interest.

109. Mr Liao submitted loss of exclusivity and dilution is not an appropriate matter for me to consider when exercising my discretion under section 13(2) of the Ordinance. He submitted there is no reason for me to exercise my general discretion in a manner adverse to the Applicant.

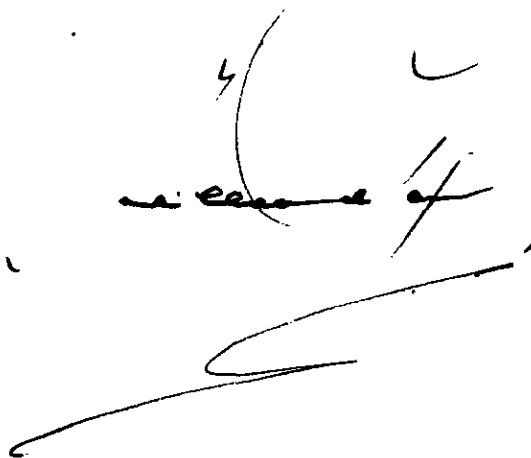
110. Ms Tam said use and registration of the suit mark by the Applicant would unfairly dilute the goodwill of the Opponent in its **OYSTER** mark. She said I must have regard to the reputation of the **OYSTER** mark in the Applicant's hands and the effect of the restriction on the expansion of the Opponent's legitimate business interests if registration is permitted. She submitted I must take into account the loss of exclusivity, erosion and swamping of the distinctiveness of the Opponent's **OYSTER** mark by use of **OYSTER** by the Applicant. Ms Tam submitted registration should be refused in exercise of the Registrar's discretion.

111. I do not agree registration of the suit mark would unfairly restrict any plans the Opponent has to extend the use of its **OYSTER** mark in a trade mark sense to goods other than watches and other horological instruments. Registration would not unfairly dilute the reputation of the Opponent's **OYSTER** mark or cause a loss of its exclusivity or erode or swamp its distinctiveness for watches and other horological instruments..

112. The Applicant has explained why it chose the suit mark. For the reasons in paragraph 111 and in view of my observations in paragraph 99 (From "Despite having demonstrated" to "one, more or all of those steps by now.") I see no cause for me to exercise my discretion in a manner adverse to the Applicant. I decline to do so.

113. I find and direct the suit mark is acceptable for registration in Part A of the Register in Class 18 in respect of the specified goods.

114. The Applicant is entitled to an award of costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party makes within one month from the date hereof, costs will be calculated with reference to the usual scale set forth in Part I of the First Schedule to Order 62 of the Rules of the Supreme Court (Cap. 4) as applied to trade mark matters, unless otherwise agreed between the parties.

A handwritten signature in black ink, appearing to read 'M.W. Fox', is written over a large, stylized flourish or scribble.

(M.W. Fox)
for Registrar of Trade Marks
21st March 1995