

(7)

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

and

IN THE MATTER of Trade Marks  
No 4011/90 YESSICA and  
No B1615/91 YESSICA & device  
registered in class 25 of the  
Register of Trade Marks in the  
name of C & A NEDERLAND

and

IN THE MATTER of an application  
by TOPPY COMPANY  
(HONG KONG) LIMITED  
to rectify the Register of Trade Marks

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DECISION  
OF

Teresa Grant acting for the Registrar of Trade Marks after a hearing on Wednesday 1 May  
1996

Appearing : Mr Colin Shipp instructed by Katherine Y W Or & Co for the applicant for  
removal

Ms Fiona Sturrock of Deacons Graham & James for the registered proprietor

1. These two applications are for an order to rectify the register by removing the trade mark YESSICA and the trade mark YESSICA & device. The applicant for removal is Topy Company (Hong Kong) Limited ('the applicant').

The registered proprietor's marks

2. The registrations which the applicant seeks to remove are in the name of C & A Nederland ('the registered proprietor'). The registrations are:

4011/90 YESSICA (in block capitals) registered in Part A of the register for clothing, footwear, headgear in class 25. The mark is associated with the registered proprietor's other trade mark B1615/91, and

B1615/91 YESSICA & device (a representation of the mark is shown below) registered in Part B of the register for clothing, footwear, headgear, all for women and girls, in class 25.



The registration is subject to a disclaimer of the exclusive use of the letter 'Y'. The mark is associated with the registered proprietor's other trade mark 4011/90.

The applicant's registered marks

3. The applicant for removal relies on four registrations in its name. All four registrations are in Part A of the register:

933/79



for garments for ladies and girls, in class 25. The registration is subject to a disclaimer of the exclusive use of the letters 'SS'. The mark is associated with the applicant's trade mark 2521/88,

2521/88

JESSICA

for ladies' and men's clothing, in class 25. The mark is associated with the applicant's trade mark 933/79,

3457/93 JESSICA (in block capitals) for precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery, precious stones, horological and other chronometric instruments in class 14, and

4343/95 JESSICA (in block capitals) for retail store services relating to articles of clothing, footwear and headgear; precious metals and their alloys and goods in precious metals or coated therewith; jewellery; precious stones; horological and other chronometric instruments; leather and imitations of leather and articles made of these materials; trunks and travelling bags; umbrellas, parasols and walking sticks; all included in class 42. The mark is associated with the applicant's trade marks 933/79, 2521/88 and 3457/93.

Grounds of application to rectify

4. The grounds of the applications to rectify under s48 of the Trade Marks Ordinance are essentially that the marks YESSICA and YESSICA & device were registered without sufficient cause and wrongly remain on the register. The marks should not have been registered because at the date of application they were likely to deceive or cause confusion under s12(1) and s20.

5. In the statements of case the applicant also relied on s9 and s10, pleading that the registered proprietor's trade marks 4011/90 and B1615/91 were, at the date of their application, neither distinctive of nor capable of distinguishing the registered proprietor's goods. Those grounds are not pursued.

6. At the hearing reference was made to the registered proprietor's lack of use of its marks but the applicant does not rely on s37 and there is no issue of non-use in these proceedings.

Pleadings

7. There are two statements of case; one relating to the application to remove registration 4011/90, the other to the application to remove registration B1615/91. The grounds in both statements of case are identical and are as follows:

- (a) The applicant is the applicant for registration of the trade mark JESSICA in class 42 in respect of retail store services under application 5779/92. (The mark was later registered under no 4343/95.)
- (b) The registered proprietor's marks 4011/90 YESSICA in class 25 in respect of clothing, footwear, headgear, and B1615/91 YESSICA & device in class 25

in respect of clothing, footwear, headgear, all for women and girls have been cited by the Registrar as grounds of objection to application 5779/92 and the application stands refused unless the cited mark is cancelled from the Register. The applicant is therefore aggrieved by the entry on the register of trade marks 4011/90 and B1615/91.

- (c) The applicant has, since about 1977, sold in Hong Kong ladies' clothing bearing and sold under the mark JESSICA in retail stores of that name.
- (d) The applicant has expended considerable sums in advertising and promoting its JESSICA ladies' clothing in Hong Kong.
- (e) As a result there has been a substantial reputation and goodwill in, and awareness of, the mark JESSICA in Hong Kong in relation to the applicant's ladies' clothing since about 1977 and long before the applications for registration of trade marks 4011/90 and B1615/91.
- (f) By reason of the close similarity between JESSICA and YESSICA, use by the registered proprietor of trade marks 4011/90 and B1615/91 was, at the respective dates of application for registration of the marks, likely to deceive, disentitled to protection in a court of justice and contrary to law within the meaning of s12(1) of the Trade Marks Ordinance.
- (g) The applicant is the registered proprietor of the mark 933/79 JESSICA, in stylised script, in respect of garments for ladies and girls, and the mark 2521/88 in respect of ladies' and men's clothing.
- (h) Trade marks 4011/90 and B1615/91, at their respective dates of application, so nearly resembled trade marks 933/79 and 2521/88 as to be likely to deceive

or cause confusion and were in respect of the same, or same description of goods.

- (i) Registration of trade marks 4011/90 and B1615/91 was therefore contrary to s20.
- (j) Trade marks 4011/90 and B1615/91 were, at their respective dates of application, neither distinctive of the registered proprietor's goods within the meaning of s9 of the Ordinance nor capable of distinguishing the registered proprietor's goods within the meaning of s10 of the Ordinance.
- (k) Trade marks 4011/90 and B1615/91 were entries made in the register without sufficient cause and/or entries wrongly remaining on the register within the meaning of s48 of the Ordinance and the Registrar should exercise her discretion to cancel the registrations.

8. The registered proprietor in its counterstatements admits only that the applicant and the registered proprietor are the registered proprietors of their respective marks. All other statements in the applicant's statement of case are denied or the registered proprietor has no knowledge of the information and the applicant is put to strict proof.

#### Evidence

9. Only the applicant has filed evidence in the proceedings. The evidence is in two declarations of Jeffrey Fang Fang, the chairman of the applicant. One declaration relates to the application to remove registration 4011/90, the other to the application to remove registration B1615/91. The evidence in both declarations is identical and is as follows:

- (a) Copies of the applicant's registrations 933/79, 2521/88, 3457/93 and 4343/95 are exhibited at 'JFF 1' of the declarations.
- (b) The applicant has used the mark JESSICA in Hong Kong at least since 1976 in respect of clothing, footwear and headgear; precious metals and their alloys and goods in precious metals or coated therewith; jewellery; precious stones; horological and other chronometric instruments; leather and imitations of leather and articles made of these materials; trunks and travelling bags; umbrellas, parasols and walking sticks.
- (c) The applicant has vast sales of its goods in Hong Kong bearing various marks including EPISODE, JESSICA and EXCURSION. Total sales figures for the years 1976/77 to June 1995 are given.
- (d) The applicant's annual sales turnover for goods bearing the mark JESSICA from August 1989 to June 1995 is given. Copies of sales invoices are exhibited at 'JFF 2' of the declarations.
- (e) The trade mark JESSICA is and has been applied to the applicant's goods and it appears on printed matter, catalogues and magazines. Catalogues showing use of the mark exactly as applied for are at 'JFF 3' of the declarations.
- (f) During the period the mark JESSICA has been used in Hong Kong, the applicant has advertised the mark. The amounts expended on advertising in each year from 1976/77 to June 1995 are listed. Copies of advertisements are exhibited at 'JFF 4' of the declarations.
- (g) Examples of price tags, labels, stationery, and carrier bags showing the mark JESSICA and photographs of JESSICA stores are exhibited at 'JFF 5' of the

declarations.

Statutory provisions

10. The relevant statutory provisions are s12(1), s20, s2(4), s48, s29 and s30 of the Trade Marks Ordinance. Section 12(1) makes it unlawful to register a mark the use of which would be likely to deceive or would be disentitled to protection in a court of justice. Section 20 prohibits the registration of a trade mark which is identical with or so nearly resembles another registered trade mark. Section 2(4) states that a near resemblance of marks is a resemblance so near as to be likely to deceive or cause confusion. Section 48 gives the Registrar power to expunge or vary an entry made in the register without sufficient cause or wrongly remaining on the register. Section 29 states that in all proceedings relating to a registered trade mark, including applications under s48, the fact that a person is registered as proprietor is prima facie evidence of the validity of the original registration. Section 30 states that registration in Part A of the register is conclusive as to the validity of the original registration after seven years unless the registration was obtained by fraud or the mark offends against s12(1).

Relevant dates

11. The dates of applying for registration of the YESSICA marks, 4011/90 and B1615/91, were 5 May 1989 and 30 May 1989, respectively. These are the relevant dates for the purposes of these applications to rectify. The applications to rectify were lodged on 10 June 1994. No issue under s30 arises as the registered proprietor's Part A mark 4011/90, at the time of the application to rectify, had not been on the register for over seven years. The registered proprietor's other mark B1615/91 is a Part B mark to which s30, which is limited to Part A marks, cannot apply.

'Person aggrieved'

12. The first issue is whether the applicant is a 'person aggrieved' so as to have the necessary standing to apply for rectification of the register under s48. At the time of lodging the removal proceedings in 1994, the applicant's class 42 application was facing the citation of the registered proprietor's mark B1615/91. Unless the cited mark was removed from the register, it would be a bar to the registration of the applicant's application. The applicant, in paragraph 5 of its statements of case, thereby claimed to be a person aggrieved by the entry on the register as required by s48.

13. The application in class 42 has since been registered; the Registrar having waived the citation. Ms Sturrock for the registered proprietor argues that the applicant, now that it is registered in class 42, is not a person aggrieved.

14. Mr Shipp, for the applicant, says the mere fact of the registered proprietor's marks remaining on the register would be against s12 as there would be a probability of deception and the applicant is thereby a person aggrieved. Mr Shipp refers to the definition of 'person aggrieved' in Kerly's Law of Trade Marks and Trade Names 12edn at paragraph 11-07 which was approved in the recent High Court judgment Gay Giano (1995 No MP 3003). Kerly notes that 'person aggrieved' has been very liberally construed so that 'it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who is prevented by the qualification which it requires from moving to rectify the register'. Kerly quotes Lord Herschell in Powell [1894] AC 8; 11 RPC 4 (HL) 'wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which but for the existence of the mark upon the register he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved'.

15. I agree with Mr Shipp. The argument in Gay Giano was whether the applicant could be a person aggrieved if he did not trade in the same class of goods as the respondent or was not in an allied or connected trade. It was never in doubt that an applicant trading in the same class of goods would be a person aggrieved. In the present application, the applicant and the registered proprietor are in the same trade. The applicant has a substantial interest in having the registered proprietor's marks removed. The applicant need not be aggrieved by any use of the YESSICA marks, it is sufficient that the marks remain on the register and would limit the applicant's legal rights.

16. The applicant and the registered proprietor have registrations in the same class for broadly the same goods. I am satisfied that the applicant and the registered proprietor are in the same trade and that the applicant is a person aggrieved for the purposes of s48 of the Trade Marks Ordinance.

#### Discretion in favour of registration

17. The fact that the Registrar has exercised his discretion in favour of the registration of a mark, is no bar to rectification proceedings, as Kerly states in paragraph 11-36. In rectification proceedings the Registrar looks at the matter afresh.

#### Section 12(1) and s20

18. The applicant relies on s12(1) and 20. Under s12(1) the applicant must show that the marks YESSICA and YESSICA & device were wrongly registered in 1989; that in 1989 the marks were likely to deceive because of their resemblance to the JESSICA marks. A mark can fall foul of s12(1) for reasons other than its resemblance to another mark but in this application to rectify, the only likelihood of deception is the resemblance between the

marks YESSICA and YESSICA & device and JESSICA. Under s20 and s2(4) the applicant must show the marks YESSICA and YESSICA & device were wrongly registered in 1989; that the marks are identical with or so nearly resemble the JESSICA marks, which were already on the register, as to be likely to deceive or cause confusion.

19. Section 29 provides that registration is prima facie evidence of validity. The onus in rectification proceedings is therefore on the applicant for removal to show that the marks were wrongly registered at the date of application for registration. The onus is on the applicant to show the probability of deception and confusion under s12(1) and s20. As Kerly states in paragraph 10-06, 'the question whether or not a particular mark is calculated to deceive or cause confusion is not the same as the question whether the use of the mark will lead to passing off'. 'If persons are likely to wonder whether or not goods were made ..... by an opponent' that is enough. Hack's Application (1940) 58 RPC 91 is the authority often cited. It was said there that 'the mark must be held to offend against the provisions of s11 (our s12) if it is likely to cause confusion or deception in the minds of persons to whom the mark is addressed, even if actual purchasers will not ultimately be deceived'.

20. It is well established that the tests to be used in applying s12(1) and s20 are those stated in Smith Hayden & Co's Application (1946) 63 RPC 97 at 101. The case was decided under the UK Trade Marks Act 1938 s11 and s12 which are substantially similar to s12(1) and s20 of our Ordinance. The Smith Hayden test under s12(1), adapted to this application, is as follows: 'Having regard to the reputation of the mark JESSICA, is the Registrar 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 reasonably likely to cause deception and confusion amongst a substantial number of persons?' Under s20 the test is, 'assuming user by the applicant for removal of its mark JESSICA in a normal and fair manner for any of the goods covered by the registrations of the mark, is the Registrar satisfied that there will be no reasonable likelihood of deception or confusion among a substantial number of persons if the registered proprietor also uses its marks YESSICA and YESSICA & device

normally and fairly in respect of any goods covered by its proposed registrations?' The requirement that the deception and confusion must be among a substantial number of persons is a judicial gloss to be properly and sensibly applied (Bali Trade Mark [1969] RPC 472 at 496).

21. To find that a mark offends against s12(1), and also under s20, 'it is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register. And so mutatis mutandis when it is sought to expunge a mark' (Bali Trade Mark [1969] RPC 472 at 496).

22. Under s12 and s20, the question of whether there is deception among a substantial number of persons must be judged in relation to the market concerned, that is, all likely purchasers of the goods. If there is a probability of deception, there is no discretion to the Registrar in the application of s12. There is always a discretion not to expunge under s48 but generally, where the applicant shows that by reason of s12 or s20 the mark should not have been registered, the Registrar should rectify the register. For s12 and s20 to apply, it is enough that the ordinary person has a reasonable doubt as to the source of the goods. To succeed under s12 the applicant must show a reputation in the mark JESSICA at the date of the applications to register the marks YESSICA and YESSICA & device.

23. The applicant has filed evidence of reputation. The evidence is in two statutory declarations of Jeffrey Fang Fang. The evidence in both declarations is identical. The applicant's mark 933/79 JESSICA in stylised script has been registered since 1978. Copies of the applicant's Hong Kong registrations are exhibited at 'JFF 1' of Mr Fang's declarations. In paragraph 4 of the declarations, Mr Fang states that the applicant has used

the mark JESSICA in Hong Kong since 1976. By May 1989, the application date of the registered proprietor's marks, the applicant had used the mark JESSICA for over 13 years. Paragraph 5 of the declarations states the value of combined sales of the applicant's marks EPISODE, JESSICA and EXCURSION for the years 1976/77 to June 1995. Paragraph 6 of the declarations gives the annual sales turnover for goods bearing the mark JESSICA. The figures are from August 1989 onwards. The sales turnover in 1989 from August onwards was over HK\$17.5 million.

24. The applicant puts in evidence, at Exhibit 'JFF 3' of the declarations, catalogues for Spring-Summer 1987, Spring 1989, Spring-Summer 1990, Summer 1991, Fall 1993, Spring 1994 and Spring 1995 showing how the mark JESSICA is actually used. The applicant's 1987 Spring-Summer catalogue shows use of the mark JESSICA.

25. Substantial money has been spent every year to advertise the mark JESSICA as is seen from the figures in paragraph 8 of the statutory declarations. The advertising expenditure in 1988/89 was just over HK\$2 million. In 1987/88 it was HK\$425,700. The exhibited advertisements at 'JFF 4' include advertisements dated 20 February, 20 March, 17 April, 15 May 1989 which show the mark JESSICA on women's clothes.

26. Exhibit 'JFF 5' is of JESSICA labels sewn into or attached to clothes.

Submissions for the registered proprietor on the evidence

27. Ms Sturrock, for the registered proprietor, says the essence of the applicant's challenge to the validity of the registered proprietor's trade marks is that use of the registered proprietor's marks was likely at the date of application to cause confusion or deception. She says there is no evidence of confusion. The applicant has filed evidence of use of its mark but the evidence does not go to confusion. The evidence does not establish a significant public awareness of JESSICA and does not support the applicant's claim to a substantial reputation or goodwill prior to the application dates of the registered proprietor's marks.

28. Ms Sturrock says the figures in paragraph 5 of the declarations showing the value of combined sales of the marks EPISODE, JESSICA and EXCURSION do not assist. Ms Sturrock's objections are that there is no indication of the percentage of sales for the mark JESSICA. The sales could be very small. The sales turnover figures for 1989 to 1995 in paragraph 6 of the declarations are after YESSICA's application date and are irrelevant. The earliest invoice for goods sold under the mark JESSICA, exhibited at 'JFF 2', is dated 30 September 1989 which is after the date of registration of the registered proprietor's marks. Earlier invoices show the mark TOPPY. Ms Sturrock says the advertisements in catalogues, magazines and newspapers do not indicate the extent of use. Significant advertising expenditure only dates from 1989 onwards.

#### Findings on the evidence

29. The objections to the evidence are not persuasive. The evidence shows that by 5 May 1989, the date of the earlier of the applications to register the two marks YESSICA and YESSICA & device, the applicant had incurred substantial expenditure in advertising goods sold under its mark JESSICA. The advertising expenditure in 1987/88 was HK\$425,700. The evidence shows advertisements in magazines prior to the date of the YESSICA applications. The applicant's 1987 Spring-Summer catalogue shows JESSICA on the front cover. I find that the mark had been widely advertised before 5 May 1989.

30. Additionally, in view of the advertising expenditure in 1989 and in earlier years and the fact that the applicant's sales turnover for JESSICA goods alone, in 1989 from August onwards, was over HK\$17.5 million, it is reasonable to assume that there were sales of JESSICA goods before 5 May 1989.

31. On the evidence I am satisfied that by 5 May 1989 a large number of people would think JESSICA identified the applicant. On the evidence I find that, at the respective dates of application for registration of the marks YESSICA and YESSICA & device,

JESSICA had a reputation as denoting the applicant's goods. I find the applicant has sufficient reputation to establish its application to expunge the mark on grounds based on s12(1).

32. I find the applicant is entitled to rely on s20 because at 5 May 1989, the date of the earlier of the applications for registration of the marks 4011/90 YESSICA and B1615/91 YESSICA & device, the applicant's marks 933/79 and 2521/88 were already on the register.

Submissions for the registered proprietor on actual confusion

33. There are no instances of actual confusion. Ms Sturrock argues that the lack of actual confusion is a relevant consideration. Ms Sturrock's arguments are that at the date of Mr Fang's declarations, the registered proprietor's marks had been on the register for six years without evidence of confusion, let alone deception. If there has been no confusion for the past six years, then at the date of application there was no likelihood of confusion. Ms Sturrock refers to the High Court decision in Wellcome Foundation Ltd v Otsuka Pharmaceutical Co Ltd [1989] 2 HKLR 365, a case in which there was no admissible evidence before the court of either deception or confusion.

34. Ms Sturrock says the present application for removal was made some five years after the date of registration of the YESSICA marks. Ms Sturrock says this indicates the applicant was not aware of any confusion between its marks and the registered proprietor's and supports the view that there has been no confusion.

Submissions for the applicant on actual confusion

35. Mr Shipp's argument is that there can be no instances of confusion if the registered proprietor has not used its marks in Hong Kong. The registered proprietor has not

put in any evidence of use. In Wellcome v Otsuka the two marks were used in the market side by side for a period of some six years. In those circumstances, lack of confusion was necessarily a factor.

#### Findings on lack of actual confusion

36. The fact that the applicant has not shown instances of actual confusion does not weaken its case. I agree with Mr Shipp that the facts of Wellcome v Otsuka are very different to the facts of the present application. There is no evidence here of side-by-side trading so that I should give weight to the absence of actual confusion.

#### No issue of proprietorship

37. Ms Sturrock says the applicant's evidence does not establish an improper motive on the part of the registered proprietor in adopting the YESSICA mark. I find that improper motive is not the issue here. There is no issue of proprietorship of the mark in these proceedings.

#### Similarity

38. Does YESSICA so nearly resemble JESSICA that confusion is likely? The test as to whether there is sufficient similarity between the marks to cause confusion is essentially the same under s12 and s20. Evidence of actual use by the registered proprietor is relevant to s20 but it does not arise in this application because the registered proprietor has not put in evidence of use of its marks. Section 20 applies only where the competing marks are registered for the same goods or goods of the same description. It is not disputed that the goods of the YESSICA marks and the goods of the JESSICA marks in class 25 are of the same description.

39. To gauge the possibility of confusion between the two marks, you must take the two words. You must judge of 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' (Pianotist Co Ltd's Application (1906) 23 RPC 774 at 777).

### Sound

40. The difference in pronunciation of the words JESSICA and YESSICA is in the first syllable. Mr Shipp for the applicant argues that the difference is minor. He argues that 'Ye' is not strong enough in pronunciation to make it distinct from 'Je'. In Hong Kong not every customer is so westernised that the closeness would not confuse.

41. Ms Sturrock disagrees. She refers to Wellcome v Otsuka. The marks in that case were MEPTIN and SEPTRIM which were held not to confuse. Ms Sturrock says that similarly, JESSICA is unlikely to be confused with YESSICA. The names Cherry, Terry, Perry and Kerry are distinguishable despite differences in only the first or first two letters. Ms Sturrock says the Registrar has to take into account the fact that 98% of Hong Kong's population is Chinese. Cantonese members of the population are familiar with English forenames and often have an English forename. Chinese speaking members of the population are attuned to subtle differences in tone and sound. Ms Sturrock refers to the Registrar's decision in the opposition to registration of the trade mark Brio (M.W.Fox 24 March 1992) where the Registrar took into consideration Cantonese pronunciations and found there would be no real risk of deception or confusion.

42. I agree with Ms Sturrock that although 98% of Hong Kong's population is Chinese, JESSICA would be widely recognised as a girl's name. I do not agree that

YESSICA would be readily distinguished from JESSICA by Cantonese or by English speakers. If JESSICA is widely recognised as a girl's name, there is no reason to suppose that the word would be pronounced in any other than the usual way. I think that YESSICA would be pronounced like JESSICA with the stress on the first syllable. I do not find the Registrar's decision in Brio relevant to this application. There is no evidence here of how YESSICA and JESSICA would be pronounced by a Cantonese speaker. Further, in Brio the marks to be compared were BRIO and BRILLO and the difference between them is greater than the difference between YESSICA and JESSICA. I think YESSICA is so close to JESSICA that it sounds like a mispronunciation.

#### Look

43. Mr Shipp's submissions are as follows. The applicant's marks JESSICA are in ordinary font. The registered proprietor's word mark is similar. The script in the registered proprietor's word and device mark B1615/91 is not sufficiently stylised to distinguish it from the applicant's marks. In the word and device mark YESSICA the female figure is subservient. In ordinary use the mark would be applied to labels on clothes and would not be as large as shown on the certificate. The marks are to be compared as a whole. The eye catching features of the word and device mark YESSICA are the 'Y' and the word YESSICA. It is recognised that words speak louder than devices. Further the registered proprietor's two marks are associated.

44. Ms Sturrock submits that YESSICA can be distinguished from JESSICA. Ms Sturrock refers to the Registrar's decision in the opposition to registration of the trade mark Winefeld (P. Murphy 31 July 1981). In that opposition the Registrar found that the number of people in Hong Kong who were so illiterate in English as not to appreciate the difference in the English names of the rival cigarette brands was very small.

45. I do not find the Registrar's findings in the Winefeld opposition relevant to the present application. The marks in that opposition were MARLBORO and WINEFELD. In that context the Registrar's finding, that the difference between the names would be noticed, is not perhaps surprising. I find that YESSICA is so close to JESSICA in appearance that it looks like a misspelling. The differences in the script between the applicant's and the registered proprietor's marks do not affect the likelihood of confusion.

46. I find the word YESSICA is the dominant and essential feature of the registered proprietor's word and device mark B1615/91. It is the word YESSICA that springs to mind after seeing the mark. The device, which incorporates the letter 'Y', does not affect the likelihood of confusion. The mark, with the device, would only be referred to as a YESSICA mark.

#### Idea of the mark

47. Ms Sturrock submits the idea conveyed by YESSICA is that the word 'yes' has been combined with a meaningless ending. YESSICA does not call to mind a girl's name.

48. To my mind YESSICA does not convey the meaning 'yes'. YESSICA suggests to me the name of a girl, JESSICA. There are no commonly used words that sound or look like JESSICA. This heightens the similarity between YESSICA and JESSICA.

#### Goods for which the mark is used

49. There is little or no distinction in so far as the goods are concerned. The applicant and the respondent are trading in closely allied or the same business.

### Nature and kind of customer

50. The nature and kind of customer are identical. It is not disputed that the customers are women.

### Notional use

51. The registered proprietor's goods could be expensive or inexpensive. That does not prevent the public thinking that JESSICA has produced a new range. Potential buyers may think the registered proprietor's marks are associated with the applicant. YESSICA may be thought to be an actual extension of JESSICA's business.

### Probability of deception and confusion

52. Mr Shipp for the applicant cited Bolivar (1921) 38 RPC 97 at 102, where the court found that, despite a difference in price between the goods, there was a possibility of confusion between the two marks BOLIVAR and MOLIVAR. Mr Shipp argues the case is persuasive. It was an action for passing off in which it is more difficult to succeed than in rectification.

53. Mr Shipp also cited Brighten v Cavendish (1915) 32 RPC 229, a case in which the mark RADIUM was found to be similar to CA RADIUM. The plaintiff in that case sought an interlocutory injunction and in those days, to get an injunction, the plaintiff had to show that he was more likely than not to succeed at trial. The letters 'Ca' in front of 'Radium' were not sufficient to make a difference. In Wheatley Akeroyd (1920) 37 RPC 137, the marks VYNO and VINO were held similar to HARVINO. The difference of the first syllable was slight and the court held that there would be a considerable probability of deception.

54. I agree with Mr Shipp that if there is a probability of deception between the applicant's and registered proprietor's word marks, that probability must extend to the registered proprietor's word and device mark. If people will not actually be confused, which is not the test here, they may very well wonder whether the registered proprietor's goods are associated with the applicant and that is enough.


55. Considering each of the marks as a whole, rather than syllable by syllable, I find the registered proprietor's marks so nearly resemble the applicant's as to be likely to deceive or cause confusion. There are strong similarities in the pronunciation and appearance of the words JESSICA and YESSICA. Someone seeing the marks side by side might not mistake one for the other but one has to take into account imperfect recollection. In Sadow (1914) 31 RPC 196 at 205, which is quoted in Kerly at paragraph 17-16, it was said 'the question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection'. In Rysta (1943) 60 RPC 87 at 108, also quoted in Kerly at paragraph 17-16, Luxmoore LJ said 'the answer to the question whether the sound of one word resembles too nearly the sound of another must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived or confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused.'

56. I find the applicant has established its case under s12(1) and s20.

Exercise of discretion

57. Should the discretion under s48 be exercised in the applicant's favour? At the date of the application for removal, the registered proprietor's marks had been registered for five years and the registrations have not prevented the applicant from becoming registered in class 42. However, the exercise of discretion does not depend on these facts. I have found that the marks YESSICA and YESSICA & device, at their date of application, if used in a normal and fair manner were likely to deceive or cause confusion among a substantial number of persons. The circumstances are no different now. In the public interest I exercise my discretion under s48 by ordering that the marks are expunged from the register.

58. I award the applicant 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 of this decision, costs will be calculated with reference to the usual scale 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.



(Teresa Grant)

for Registrar of Trade Marks  
28 May 1996