

Application No. 5858 of 1991

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

AND

IN THE MATTER of an application for the  
registration of the trade mark :-

ZIPPO

in Class 18 in Part A by DDM/Italia S.p.A.

AND

IN THE MATTER of an opposition by Zippo  
Manufacturing Company

DECISION

OF

Mr. Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a hearing on  
12 October 2000.

Appearing : Ms. Margaret K.W. Yu counsel instructed by Union Patent Services Centre on  
behalf of the applicant DDM/Italia S.p.A.

: Ms. Jennifer Tsang counsel instructed by K.F. Wong & Co. on behalf of the  
opponent Zippo Manufacturing Company.

***Application for Registration of “ZIPPO”***

1. On 9 August 1991 DDM/Italia S.p.A. (‘the applicant’) applied to register, pursuant to the provisions of the Trade Marks Ordinance (“the Ordinance”), in Part A of the Register, in Class 18, the trade mark a representation of which appears below :

**ZIPPO**

(“the suit mark”)

2. The goods intended to be covered by the registration, after an authorised amendment, were : “bags and handbags” (“the specified goods”).

3. The Registrar of Trade Marks (“the Registrar”) initially raised an objection to registration as it was considered that the suit mark so nearly resembled the registered mark “Zibbo & device” under No. 2526 of 1986 as to be likely to deceive or cause confusion. This objection was subsequently withdrawn after the Registrar determined that the applicant had established to his satisfaction, pursuant to section 22 of the Ordinance, honest concurrent use.

4. Earlier, on 14 July 1990, Zippo Manufacturing Company of 33 Barbour Street, Bardford, Pennsylvania, United States of America (“the opponent”) had applied to register the mark ZIPPO, Application No. 5702 of 1990, also in respect, *inter alia*, of bags and handbags. As this application had not been accepted for registration prior to the filing by the applicant of its application, both applications became subject to the provisions of section 21 of the Ordinance. After considering evidence of first use of the respective marks in Hong Kong in respect of the specified goods, the Registrar determined that the applicant had established the right to proceed with its later-filed application. I shall return to this application by the opponent later in this decision. The application for registration of the suit mark was advertised in the Gazette on 3 November 1995.

## *The Notice of Opposition*

5. On 12 April 1996, Zippo Manufacturing Company, the opponent herein, filed a Notice of Opposition to the application. The grounds of opposition are in summary:-

The opponent is the proprietor of the trade mark “ZIPPO” (the “opponent’s mark”) and various other marks incorporating the word. The opponent’s mark was first used since at least 1933 and has been continuously and extensively used since. Goods to which the opponent’s mark is applied are wide ranging, including but not limited to, cigarette lighters, lighter flints, wicks for lighters, smoker’s articles, lighter fuel, writing instruments, flexible steel rulers, pocket knives, golf balls, golf clubs, golf club cases, golf bags, caddy bags, ball marks on greens and for cleaning spikes on shoes, leather pouches, key holders, pocket magnifying glasses, letter openers, pill boxes, playing cards, tie bars, watches, clothing, mini portable torches, fragrances and many others. Goods bearing the opponent’s mark are sold and marketed in many countries and have been sold in Hong Kong since at least 1985 and continuously and substantially thereafter. The opponent’s mark is the subject of numerous registrations and applications to register in numerous countries in various International Classes, including but not limited to Classes 3, 4, 6, 8, 14, 16, 18, 25, 28 and 34. In particular, the opponent’s mark has been registered in Class 18 in the United States of America from which the opponent’s goods originate. Substantial expenditure has been incurred in policing its worldwide registrations and in promoting the mark. By reason of these facts, the opponent’s mark has acquired a substantial reputation worldwide and in Hong Kong and has become distinctive of and identified with the opponent and its goods. Specifically, the opponent claims :

### **1. Under section 12(1)**

The suit mark confusingly resembles the opponent’s trade mark. Use and/or registration of the suit mark by the applicant will inevitably cause confusion or a mistaken belief amongst the general public that the applicant’s goods bearing the suit mark are associated or connected in the course of trade with the opponent.

**2. Under sections 9 and 10**

The suit mark is neither inherently adapted to nor capable of distinguishing the applicant's goods from those of the opponent.

**3. Under section 13(1)**

The applicant cannot claim to be a bona fide proprietor of the suit mark.

**4. Under section 23**

Owing to the registration of the opponent's mark in the United States of America, registration of the suit mark should be refused.

The opponent asks that the registration of the suit mark be refused and that costs be awarded in its favour.

***The Counter-Statement***

6. On 5 August 1996 the applicant filed its Counter-Statement. In summary the applicant :

- relies on the fact that the suit mark, as a result of continuous and extensive use in Hong Kong since 1982 and worldwide has become distinctive of the applicant's goods;
- relies on the fact that the suit mark has co-existed in Hong Kong with the opponent's mark without objection either oral or written by the opponent or incidence of confusion among the public;
- relies on the fact that the applicant's mark was accepted by the Registrar, upon evidence being filed, as the first to use ZIPPO in Hong Kong in respect of the specified goods;

- relies on the fact that the suit mark was first used by the applicant in Italy in 1979 and has also been extensively used in Europe and is well known to members of the trade and the public in countries around the world;
- relies on the fact that the applicant is the registered proprietor or applicant for registration of the suit mark in respect of goods in International Classes 9, 18 and 25 in many countries around the world including Italy, the country of origin of the goods;
- relies upon the issue by the Registrar of Leave to Advertise the suit mark as establishing that the suit mark is inherently adapted to distinguish the applicant's goods within the terms of the Ordinance;
- denies that the suit mark confusingly resembles the opponent's mark;
- denies that use and/or registration of the suit mark will inevitably cause confusion or a mistaken belief amongst the general public that the applicant's goods bearing the suit mark are associated or connected in the course of trade with the opponent;
- denies that use of the suit mark would be likely to deceive or cause confusion and would be disentitled to protection in a court of justice;
- denies that the suit mark is not distinctive of the applicant's goods;
- denies that the applicant is not a bona fide proprietor of the suit mark;
- relies on the fact that the applicant is the proprietor of the mark "ZIPPO" when used in relation to, *inter alia*, the goods the subject of this application and is entitled to apply for and obtain registration of the suit mark in respect of such goods;

The applicant asks that the opposition be dismissed with costs, and that its application be allowed to proceed to registration.

### *The Opponent's Evidence in Chief*

7. Pursuant to Rule 25 of the Trade Marks Rules ("Rule/s"), the opponent filed a Statutory Declaration of James A. Baldo, the Vice President, Sales and Marketing, of the opponent.

8. Mr. Baldo states that the opponent has registered the trade mark "ZIPPO" in Hong Kong in classes 8, 11, 14, 16, 25, 28 and 34. Copies of the Certificates of Registration issued by the Registry are annexed as exhibit "A". (In fact copies of the Certificate of Registration for trade mark registration No. 1839 of 1995 in class 8; and No. 270 of 1996 in class 11 are omitted from exhibit "A").

9. Mr. Baldo states that the opponent has numerous registrations for "ZIPPO" throughout the world in about 70 countries, including Italy and the United States of America, many of which claim a first use date of 1934. Copies of the registrations obtained in the United States of America, including registration no. 1939603 in respect of Class 18 goods are annexed as exhibit "B".

10. Mr. Baldo declares that the opponent's reputation in Hong Kong, and worldwide is so substantial that it is likely that the public of Hong Kong would be misled into believing that the applicant's goods under the suit mark were those of the opponent. A newspaper clipping of 17 June 1991 is annexed to the declaration as exhibit "C".

11. Mr. Baldo then proceeds to state the history of the opponent. The opponent's business began in 1932 when George G. Blaisdell refashioned a cumbersome looking Austrian lighter into an "attractive lighter that works". Fascinated by the name of another invention of that time, the zipper, and liking the onomatopoeic ring of the name, Mr. Blaisdell invented the word "ZIPPO" as the name of his new lighter and his company. The business was originally organized as a partnership in 1932 and the partnership was subsequently organized as a corporation in 1945 in the name of the opponent. A leaflet "The Zippo Lighter and How It Grew .." and a booklet "Zippo, A History of Progress" are annexed to the declaration as exhibit "D".

12. Mr. Baldo continues by stating that the opponent's business consists of design, manufacture and sale of high quality products. Mr. Baldo states that the name "Zippo" has

become a hallmark of quality and each lighter comes with a lifetime guarantee that it will be repaired free of charge. Annexed to the declaration as exhibit “E”, are two catalogues of the Zippo range of goods.

13. Mr. Baldo says that in Hong Kong, products bearing the opponent’s mark are for sale in Wing On Department Stores, Yaohan Department Stores, Sogo Department Stores and many other outlets.

14. Mr. Baldo continues by tabling the sales figures in Hong Kong for products bearing the opponent’s marks – US\$1,690,622 in 1991; US\$1,107,283 in 1992; US\$1,147,996 in 1993; US\$1,577,540 in 1994; US\$1,695,531 in 1995 and US\$2,644,153 in 1996. Annexed to the declaration as exhibit “F”, are sample sales invoices.

15. Mr. Baldo states that the opponent has always felt that the most important advertising and promotion allocation in any market is for point of sale displays. It is and has been the opponent’s policy to always spend at least 5% of sales for point of sale material in Hong Kong and other major markets. Colourful catalogues and collectors’ guides were published. The advertisements placed in two magazines with worldwide circulation, Reader’s Digest and Life Magazine from 1958 to 1967 were reprinted in a book called “Zippo Advertising 1958-1967”. A copy of “Zippo Advertising 1958-1967” is annexed as exhibit “G”.

16. Advertising and promotion expenditure in Hong Kong was US\$84,531 in 1991; US\$55,364 in 1992; US\$57,400 in 1993; US\$78,877 in 1994; US\$84,776 in 1995 and US\$132,207 in 1996.

### ***The Applicant’s Evidence***

17. Pursuant to Rule 26, Mr. Johnson Alana Paola filed a Statutory Declaration as the legal representative of the applicant.

18. Mr. Paola states that the applicant has continuously used the suit mark in respect of the specified goods in Hong Kong since 1982. Sales of the specified goods in Hong Kong were Italian L.2,233,500 in 1982; Italian L.2,620,000 in 1983; Italian L.3,342,000 in 1984; Italian L.10,181,720 in 1987; Italian L.24,007,941 in 1989;

Italian L.10,573,600 in 1990; Italian L.104,003,480 in 1991; Italian L.98,257,310 in 1993; Italian L.306,376,520 in 1994 and Italian L.126,896,965 in 1995. Copies of sample sales invoices are annexed as exhibit “D-2”.

19. Mr. Paola claims that apart from Hong Kong, the suit mark has also been used by the applicant in other countries throughout the world including, Austria, France, Germany, Japan, Greece, Great Britain, Portugal, Spain, Switzerland, Belgium, the Canary Islands, Chile, Columbia, Iceland, Israel, Lebanon, Luxembourg, Holland, Russia, South Africa, Sweden, Taiwan and Italy, the latter being the country of origin of the specified goods sold in Hong Kong. Some advertising materials of the specified goods bearing the suit mark in Italian magazines are annexed to the declaration marked “D-3”. Though the magazines are not in English, one can see without difficulty that the displayed bags and handbags as highlighted bear the mark “ZIPPO”.

20. Mr. Paola states his belief that by virtue of the long and substantial use of the suit mark throughout the world, including in Hong Kong, the trade and purchasing public connect the suit mark with the applicant exclusively and the applicant has a valuable reputation and goodwill residing in the suit mark.

21. Mr. Paola claims that the suit mark has been used by the applicant in Hong Kong since 1982. The date of first use of the suit mark in Hong Kong is earlier than the date of first use of the opponent’s mark, which is 1985. Mr. Paola states that throughout the years in which the applicant has used the suit mark, no objection either oral or written has been raised by any other trade mark proprietor to such use and no complaint of confusion or deception has been received by the applicant from the opponent or customers in Hong Kong.

22. Mr. Paola states that the applicant has obtained registration of the suit mark in Italy, Great Britain and Greece. Copies of the respective certificates of registration are attached as exhibit “D-4”. (No translation is provided for the Certificate of Registration issued by the Trade Marks Office in Greece.)

23. Annexed to the declaration marked exhibit “D-5” is a copy of the Certificate of International Registration No. 501543, which covers Germany, Austria, Benelux, Spain, France, Portugal and Switzerland. (Again, no translation is provided.) Exhibit “D-6” is a copy of the notification from WIPO concerning the territorial extension of the International Registration No. 501543 to Bulgaria, Croatia, Hungary, Morocco, Monaco, Czech Republic,

Romania, Slovakia and Slovenia. (The notification is not issued in English nor is a translation provided.)

24. Mr. Paola states that on 17 June 1996, the applicant requested the territorial extension of the International Registration No. 501543 to extend to Algeria, China, Cuba, Egypt, Latvia, Macedonia, Poland, Russia, Yugoslavia, Ukraine and Vietnam.

25. Mr. Paola continues by stating that the applicant has applied for registration of the suit mark in International Class 18 in Israel, Lebanon, Macao, Mexico, South Africa, Tunisia, Venezuela and the Dominican Republic. Mr. Paola claims that the suit mark in Macao was registered on 19 September 1996 and the applicant is awaiting the issue of the Certificate of Registration. Respective copies of the suit mark applications are attached as exhibit "D-7". (Save for the ones issued by the trade marks office in Israel, South Africa and Tunisia, the remaining copies of the suit mark applications are not in English.)

26. Mr. Paola challenges Mr. Baldo's declaration, namely paragraphs 4, 5 and 9 and reiterates that the suit mark has been continuously used by the applicant since 1982 in Hong Kong in respect of the specified goods. No legal action has ever been taken by the opponent which proves, in Mr. Paolo's view, that no likelihood of confusion has been demonstrated and no damage has been caused to the opponent. Mr. Paola claims that the use of the suit mark by the applicant without interference from the opponent establishes its own right.

27. By referring to paragraphs 6 to 16 and the supporting exhibits marked "A" through "G" of Mr. Baldo's declaration, Mr. Paola challenges the opponent for lack of documentary proof to show that the opponent's mark was used and/or has been used in relation to goods in International Class 18.

28. The remainder of the Statutory Declaration is confined to Mr. Paola's belief that the applicant is entitled to registration of the suit mark and a belief that there are no valid grounds to oppose the same.

### ***The Opponent's Evidence in Reply***

29. Pursuant to Rule 27, Mr. Michael A. Schuler, the CEO and President of the

opponent filed a Statutory Declaration.

30. Mr. Schuler challenges the copies of the invoices attached to Mr. Paola's declaration on the ground that they do not mention the mark "ZIPPO". He states that with the exception of an invoice dated 17 March 1994, the invoices relate to other marks, including teen club, pony, old America, new America, Giava.

31. In rebutting Mr. Paola's suggestion that there has been no use of the opponent's mark in Class 18, Mr. Schuler states that the mark "ZIPPO" is used by the opponent for leather lighter pouches, as evidenced by the invoices and advertising material.

32. Mr. Schuler continues by pointing out that the declaration of Mr. Paola did not mention how the applicant came to use the mark "ZIPPO" as its trademark.

33. Mr. Schuler further points out that there is no evidence to show that the advertising materials exhibited to the applicant's declaration were circulated in Hong Kong. The materials are not in Chinese or English and are not therefore readily understood by the general public of Hong Kong.

34. Mr. Schuler concludes by stating that the opponent has taken action against the use and registration of the suit mark in Class 18. So far, cancellation proceedings have been commenced in Austria, France, Greece, Spain and the United Kingdom. Opposition has been allowed in the Dominican Republic, Ireland, China, Turkey and Vietnam. Mr. Schuler explains that except for the evidence from Mr. Paola, the opponent had not been aware of any use of the mark "ZIPPO" in Hong Kong by the applicant and so, has not taken legal action against the applicant so far in Hong Kong.

#### ***Fixing of a date for hearing***

35. The parties were notified, by letter dated 16 August 2000, that the date for hearing argument on the opposition was fixed for 12 October 2000.

36. On 11 October 2000 at 1134 hours, a facsimile was received from the agents for the opponent advising that the opponent had appointed new agents to act for it. At 1512 hours on the same day, a facsimile was received from K.F. Wong & Co, the opponent's new

agent which alerted the Registrar that : “ ...our counsel intends to seek an adjournment of tomorrow’ s hearing”.

37. At 1605 hours on the same day, counsel for the opponent, Jennifer Tsang had caused to be delivered to the Registry a “Skeletal Note” from which it was apparent that the opponent would be seeking leave, pursuant to Rule 28, to file further evidence, or alternatively, would apply to consolidate the opposition with the opponent’ s application for registration under No. 5702 of 1990.

38. On 12 October 2000, after hearing submissions in support of the two applications, I refused both applications. I gave full oral reasons at the time. Briefly, I could not consolidate as there were no “proceedings” lodged in respect of Trade Mark Application No. 5702 of 1990. That application had not been accepted for registration and had therefore not proceeded to advertising. Its fate awaits my decision in the instant opposition proceedings.

39. With respect to the application for leave to file further evidence, Ms. Tsang could give me no assurance that evidence material to the issues was readily available and could be retrieved. It was also apparent that whatever evidence there may have been, was evidence available to the opponent at the time it filed its Statutory Declaration pursuant to Rule 25 and was not “fresh” evidence. I also took into consideration the lateness of the application and the inevitable delay that would be caused if I granted the application.

40. Ms. Tsang then made a further application for leave to cross-examine Mr. Paola, the declarant for the applicant. After considering the matter over the morning adjournment, however, Ms. Tsang withdrew the application.

41. Ms. Tsang informed me that she was prepared to proceed with the substantive opposition and was not seeking an adjournment.

### *Decision*

#### **1. Under sections 9 and 10**

42. During the course of argument, Ms. Tsang conceded that the opposition under

sections 9 and 10 of the Ordinance was based on the same point as the opposition under section 12(1) of the Ordinance. This concession was proper, for although a trade mark which offends against section 12(1) of the Ordinance can never be distinctive of the applicant for the purposes of sections 9 and 10 of the Ordinance, the question is best determined in the wider context of section 12(1) of the Ordinance.

**2. Under section 12(1)**

43. S. 12(1) of the Ordinance provides :

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

44. Before an opponent can mount an opposition under this section, it must first establish that its mark is known to a substantial number of persons in Hong Kong – see *Re Arthur Fairest Ltd.’s Application* (1951) 68 RPC 197 at 200. The reason for this requirement is simply that, if the mark is comparatively unknown in Hong Kong, deception or confusion is unlikely to arise. The date at which this reputation in its mark is to be established is the date of the application to register – *NOVA Trade Mark* [1968] RPC 357 at 360. If the opponent discharges this burden, the onus shifts to the applicant to satisfy the tribunal that there is no reasonable likelihood of deception arising among a substantial number of persons if the suit mark proceeds to registration – *Eno v Dunn* (1890) 15 App Cas 252 at 261.

45. Ms. Yu submitted that the opponent has fallen short of establishing the requisite reputation in Hong Kong. She conceded the opponent’s reputation in USA and possibly other parts of Asia, notably Japan, but pointed out that nowhere in the opponent’s evidence is there mention of Hong Kong as a significant market for the opponent’s goods and even the unsupported sales figures contained in paragraph 14 of Mr. Baldo’s Statutory Declaration for 1991 (US\$1,690,622 for the full year) are less than impressive.

46. Ms. Tsang submitted that the opponent’s international reputation was such that it must have spilled over into Hong Kong. She referred me to the article annexed to

Mr. Baldo's Statutory Declaration (exhibit "C"), particularly to the passage :

"Sixty percent of Zippo lighters made today are sold overseas, up from 40 percent five years ago, Jones says. Twenty percent of those exported are sold in Japan alone, double the sales there in 1986 ...while the growth in smoking – and demand for Zippo lighters – has risen sharply in Pacific Rim countries in recent years ...not all Zippo customers are smokers ...Zippos have become the rage among collectors ..."

47. Earlier in the article there is reference to :

"More than 250 million Zippo lighters have rolled off the assembly line since it was invented and first produced here in 1932 ...Zippo can't keep up with demand, churning out 60,000 lighters a day ..."

48. The source of the article is not disclosed beyond it being attributed to the Knight - Ridder News Service. A date of June 17, 1991 has been added to the photocopy of the article. I have no reason however to doubt the accuracy of the facts it discloses regarding the opponent's production volumes nor its overseas reputation.

49. Ms. Tsang submitted that the test to be applied is the awareness of the opponent's mark in Hong Kong and that it mattered not how that awareness was achieved. Sales in Hong Kong were not the sole criteria. She referred me to a passage in *Philip Morris Products Inc. v R.J. Reynolds Tobacco Co.* [1996] AIPR 28 at p. 44. I propose to adopt the passage as an accurate summary of the law on this point.

"*Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd* [1976] RPC 294 and *Hong Kong Caterers Ltd v Maxims* [1983] HKLR 287 establish it is the awareness of the overseas mark in Hong Kong that is relevant and it does not matter in what manner that awareness is achieved. The awareness of the mark need not be related to goods actually being sold or offered for sale in Hong Kong or other experience in the Hong Kong market. In *Maxims*, Hunter J. held that reputation associated in trade or business with a name is recognized in law for trade mark purposes whether such reputation is based on what would be regarded by Hong Kong law as registerable trade mark user or not and, following *Wienerwald Holding AG v Kwan, Wong, Tan & Fong* [1979] FSR 381, that a reputation can exist in Hong Kong without any business having been carried on here. The *Maxims* case also recognizes that, when

considering whether or not there is a reputation, overseas visitors (from the English speaking world) are to be taken into account.

Application of the principles in the *Pioneer Hi-Bred* and *Maxims* cases is consistent with the observation in *Ten-ichi Co Ltd v Jancar Ltd* [1990] FSR 151 that ‘a court must respond to the changes which have occurred in international communications. The large number of tourists crossing and recrossing boundaries: the speed and the efficiency of modern technology which causes business reputation to be more widely spread and recognized than in the past.’ Internationalization, the global village concept, is gaining increasing judicial weight.”

50. It is unfortunate that the opponent’s evidence lists sales income and advertising expenditure for the years 1991-1996 when it is the reputation in its mark at the application date (9 August 1991) rather than after it that is relevant. Nevertheless, taking 7/12 of the 1991 figure as being representative, the sales achieved for the opponent’s products in Hong Kong in the 7 months leading up to the application date was in the vicinity of US\$986,196 (HK\$7,593,710) which is certainly not *de minimus* (see the comments in *Da Vinci Trade Mark* [1980] RPC 237 at 241). The opponent’s reputation is in respect of cigarette lighters, and although it has branched out into other metal products (steel rules, pocket knives, money clips), golf accessories and some items of clothing, the evidence filed does not satisfy me that it has acquired a reputation in respect of these products outside of the USA. In respect of items in International Class 18, being the goods of interest to the applicant, I have no evidence at all of a reputation in these products let alone one in Hong Kong for such articles. This is a matter I shall be returning to later in this decision, but for the purposes of overcoming the initial burden, the law is that the requisite reputation need not be in relation to goods of a similar nature to those of interest to the applicant. See *Re Yuen Nuen Sun* [2000] 2 HKLRD 346 at 354-356.

51. I find that the combined effect of the claimed Hong Kong sales (these are not fully supported by independent documentary evidence) and the inevitable spill-over from its international reputation in lighters is sufficient for the opponent to meet the lower range of the requisite threshold of public awareness in its mark in Hong Kong, enough for it to mount an opposition under section 12(1) of the Ordinance.

52. I turn to my consideration of the substantive opposition under section 12(1) of the Ordinance. It is well established that the test to be used in applying section 12(1) of the

Ordinance is that stated by Evershed J. in *Smith Hayden & Co.'s Application* (1946) 63 RPC 97 at 101, modified by Lord Upjohn in *Bali's Trade Mark* [1969] RPC 472 at 496. The test under section 12(1) of the Ordinance, adapted to this application, is as follows :

“Having regard to the user of “ZIPPO” in respect of lighters, is the court satisfied that “ZIPPO”, if used in a normal and fair manner in respect of bags and handbags, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

53. The reference to “substantial” is a question to be judged in relation to the market for the goods concerned. “Persons” are all those likely to become purchasers of the goods upon which the respective marks are used. The reference to “the user” of the opponent’s marks and “if used in a normal and fair manner” of the suit mark in the above test normally mandates that what is to be compared is the notional and fair use which the applicant would be entitled to make of its mark in the ordinary course of trade in respect of bags and handbags, against the use actually made by the opponent of its marks. Where, however, it is known how the applicant proposes to use the suit mark, that use may be considered in place of notional use. See *Kerly* para 10-04 (*Kerly's Law of Trade Marks and Trade Names* 12<sup>th</sup> ed.).

54. Ms. Yu submits that the evidence discloses that the representation reproduced below is the only representation of the opponent’s mark to have been used in Hong Kong. That is certainly true of the mark as reproduced on the invoices exhibited, but the earliest of these post-dates the application, and in any event would not be seen by the purchasing public. It is not true of all but one of the trade marks registered in Hong Kong. The catalogue of “ZIPPO” products dated 1991 (exhibit “E” to the Statutory Declaration of Mr. Baldo) does however depict the “ZIPPO” products with the “flame” mark and it would be highly improbable that a different mark would be applied to products sold in Hong Kong. I accordingly accept Ms. Yu’s submission as correct.



(the “flame” mark)

55. The actual use made of the applicant's mark varies. From the evidence filed, the following uses are common :



56. There are visual differences between the marks, in fact Ms. Yu submits they are quite different. She places particular emphasis on the flame in place of the dot in the letter “i” and the stylized lower case letters adopted by the opponent compared to the unembellished upper case lettering of the suit mark. Trade marks are not however generally seen side by side. I must instead apply the sequential or imperfect recollection test, best summarised in the following passage from *Sandow Ltd.’s Appln.* (1914) 31 RPC 196 at 205.

“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 mark, and in view only of his general recollection of what the nature of the other 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.”

57. One of the consequences of the numerous ways the applicant has used the mark “ZIPPO” is to dilute the visual cognizance of the various representations of “ZIPPO” it uses. Persons having a familiarity with any of the marks of the applicant or that of the opponent are more likely to recall the word “ZIPPO” rather than any composite mark or

stylised representation of the same. The effect is referred to in trade mark law as the “essential feature” or “idea of the mark”. It is that which will be recalled as memory dims. It is also trite to say that words are recalled better than devices. The respective marks must therefore be compared as word marks *simpliciter*.

58. The established test for the comparison of word marks is that promulgated by Parker J. in *Pianotist Co. Ltd.’s Application* (1906) 23 RPC 774 at 777.

“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 marks is used in a normal way as a trade mark for the goods of the respective owners of the marks”.

59. I have dealt with the visual appearance of the marks and the consequences of the varied uses made of the suit mark by the applicant in paragraph 57 above. To summarise, the essential feature of both the suit mark and the opponent’s “flame” mark is the word ZIPPO. I cannot accept Ms. Yu’s submission that the “flame” element and the stylised use made of lower case lettering in the opponent’s mark is so distinctive that the marks are very different visually. Such a finding would give insufficient weight to the imperfect recollection test and the essential feature test. I find the opponent’s mark and the suit mark to be visually similar in law. The words of course are identical aurally.

60. I must next consider the goods to which the respective marks are to be applied. The inevitable consequence of registration of a trade mark is that protection will extend not only to the specified goods, but also to a penumbra of closely related goods. This is clear from the provisions of sections 20 to 23 of the Ordinance which prohibit the registration of identical or nearly resembling marks owned by different proprietors in respect of the same goods or *the same description of goods* except in the case of honest concurrent use. It is accordingly important, when considering the likelihood of deception or confusion, to have regard to the respective goods to which the marks are applied or might be applied.

61. This point has given me the greatest trouble in deciding the case. The question is how far does the penumbra extend in cases where the opponent has a famous mark, not unknown in Hong Kong, a mark it claims to be of its own invention but one in

which its reputation can fairly be confined to dissimilar goods?

62. In *The Eastman Photographic Materials Co. Ltd. and another v The John Griffiths Cycle Corporation Ltd. and The Kodak Cycle Co. Ltd.* (1898) 15 RPC 105 it had been established that the plaintiffs had invented and used the word “Kodak” in relation to cameras and related goods. The defendants had obtained registration of the word “Kodak” for cycles and other vehicles. The defendants’ mark was ordered to be expunged. At first sight cameras and cycles would appear to be totally dissimilar products, but on the facts this proved not to be the case. At p-110 Romer J summarised the evidence :

“It appears that the “Kodak Cameras” are especially available for use on cycles, and that they are much used by cyclists, and the Plaintiff company had done a large trade in these “Kodaks” for the purpose of cycles. It has made certain special forms of “Kodaks” so as to especially adapt them for use on cycles. It has advertised for some time these special “Kodaks” as “Cycle Kodaks” or “Bicycle Kodaks”, and it also has a considerable trade in bicycle accessories as far as relates to the adaptation of the bicycle for photographic purposes. At one recent large cycle show the Plaintiff company had a stall, and the evidence shows that between the two trades, the bicycle trade and the camera trade, there is an intimate connection. Many shops sell and deal in both bicycle and photographic cameras and materials. To a certain extent the Plaintiff company is identified with the name “Kodak” as connected with cycles, and so great is the connection between the two classes of business, that in all probability, I may say, the Plaintiff company may wish hereafter to manufacture and sell cycles specially adapted to carry their “Kodaks”.”

63. In *Edward Hack’s Appn.* (1941) 58 RPC 91 an application for the registration of “Black Magic” in respect of “medicated preparations in solid form for human use as laxatives” was opposed by the proprietors of “Black Magic” in respect of “chocolate”. On appeal, the opposition was successful on the basis that there was a risk of confusion in that some persons would be likely to think that the two “Black Magic” preparations were made by the same manufacturers, and others to wonder if this might be the case. At p.105 Morton J. said this of the evidence :

“The evidence shows that, at the time of application for registration chocolate laxatives were a very common form of solid laxatives. When I say “chocolate laxatives”, I mean laxatives in which chocolate is either employed as a coating for the

actual laxative medicine or is admixed with it. There were, I think, twelve samples produced, and of these samples four contained about 90 percent of chocolate and one contained 87½percent of chocolate. One of these samples is a brand called “Ex-lax” which appears, from the evidence, to be widely advertised, and it looks just like a bar of solid chocolate. These chocolate laxatives are all medicinal preparations. The evidence also shows that it is not unusual for chocolate manufacturers to supply the chocolate to the manufacturers of medicated preparations, or to make certain medical preparations themselves. ... It is also clear from the evidence that laxatives and chocolates are not infrequently sold in the same shops and over the same counter. ... It is to be observed also that chocolates and laxatives are alike in this, that they are both edible, that the laxatives which Mr. Hack seeks to sell under his trade mark are in solid form, and that both articles are intended for human consumption.”

64. In two related cases *PLAYERS Trade Mark* [1965] RPC 363 and *WOODIES Trade Mark* [1965] RPC 366 the same applicant sought to register “PLAYERS” and “WOODIES” in respect of confectionery intending to use it on imitation cigarettes made of confectionery. The applications were opposed by the owners of the marks PLAYERS, registered in respect of tobacco, and WOODBINE (known to customers as “WOODIES”) registered not only for tobacco but also for “non-medicated confectionery”. The opponent had a considerable reputation in both marks as applied to tobacco. The opposition was successful. Dr. Atkinson accepted the evidence of the opponent that it was well known that confectionery goods and cigarettes were sold in a great majority of cases from the same shop or kiosk and even from the same counter in many shops. There was also questionnaire evidence in which all declarants in answer to the question “What goods does the word PLAYERS imply to you?” replied cigarettes; and to the question “If you were to see confectionery cigarettes or confectionery tobacco goods sold under the trade mark PLAYERS with whom would you associate such goods?” replied that the goods came from the opponent company.

65. In *Re OMEGA* [1995] 2HKC 473, where the respondent’s attempt to register a composite OMEGA mark in respect of “writing instruments” was disallowed in view of the appellant’s registrations and user of a practically identical mark in respect of “horological instruments”, Deputy Judge Le Pichon (as she then was) noted, at p. 476 :

“Whilst the opponent admits that it has neither registered its marks in respect of writing instruments, refills and parts thereof nor sold such goods in Hong Kong, it *has*

*adduced evidence* to show that owners of famous trade marks tend to use them for a range of products including, in particular, watches and writing instruments. Examples of famous trade marks being used in relation to watches and writing instruments include ‘ST Dupont’, ‘Cartier’, ‘Dunhill’, ‘Christian Dior’, ‘Guy Laroche’, ‘Tiffany’, ‘Corum’, ‘Chaumet’, ‘Philippe Charriol’ and ‘Caran d’Ache’.” (emphasis mine)

66. Finally in *Re Gay Giano Trade Mark* [1996] 2 HKC 646 Leonard J. was invited to take, and indeed took judicial notice of the fact that owners of famous trade marks in the fashion industry apply those marks to various fashion items such as clothing, hand bags, footwear and watches. See p.651.

67. The common thread running through all these decisions, is that it is not the reputation of the opponent’s mark *per se* that extended the penumbra to apparently dissimilar goods but that it must also be shown, *by evidence*, that there is likely to be a perception of association, in the trade, between the respective goods. I shall return to these cases later in this decision.

68. As I have observed earlier in this decision, the opponent has filed no evidence of what products it may have sold in Hong Kong prior to the application date. Ms. Tsang pointed to certain invoices which detailed the provision of lighter pouch clips and lighter pouch loops as part of the invoices for lighters supplied. The invoice dated 12 November 1992 refers to 400 clips and 1,000 loops, while that of 21 November 1994 has 1,000 brown loops, 600 black loops, 1,200 brown clips and 800 black clips. The invoice of 31 March 1995 includes 768 pens and that of 19 March 1996, a further 300 brown loops. Ms. Tsang, properly, does not ask me to infer that pens and pouches for lighters were, by reason of this evidence, also supplied to Hong Kong prior to the application date.

69. Ms. Tsang does however suggest that a manufacturer of lighters would be likely to expand into leather goods. She points to the opponent’s own evidence, drawn from its catalogue, that it supplies leather pouches for its knives and lighters. Pouches for lighters appear nowhere in the opponent’s product catalogue (“Exhibit E” to Mr. Baldo’s Statutory Declaration). The knife pouch is depicted on page 19 and on a loose page entitled “ZIPPO Cut-About Series”. In both these examples the pouch is supplied as part of a gift box with a knife. The pouch does not appear to be marked with the “ZIPPO” mark and does not appear to be available as a separate item. I am left with lighters as the product which the opponent has sold in Hong Kong. Ms. Tsang further cites from the bar table the examples of Dunhill

and Cartier as companies that produce both lighters and bags. I do not believe I can accept, without evidence, that the Dunhill and Cartier examples are indicative of the trade so that I can be satisfied that manufactures of bags and handbags commonly also manufacture lighters and vice versa. I am unable, from this evidence, to accept that the opponent has expanded its business into leather goods generally. I turn to the nature and kind of customer who would be likely to buy the respective goods.

70. Smoking is of course not confined to men. I have considerable doubt however that female smokers would find the opponent's lighters appealing for their own use. From the examples depicted, the lighters are "chunky" in appearance rather than slim and elegant as might appeal to women. They operate on a "striking wheel" principle rather than by electronic ignition. This requires some physical effort.

71. One of the features of the "ZIPPO" lighter is its flame guard making it suitable for use out of doors. The lighter's utility to pipe smokers is also emphasised. Neither of these features is likely to appeal to women. A perusal of the booklet "Zippo advertising 1958 – 1967" (exhibit "G" to Mr. Baldo's Statutory Declaration) almost without exception depicts the "ZIPPO" in the hand of a male. Overall the advertising bias is towards appeal to males and it is accordingly more likely that the nature and kind of customer for the ZIPPO lighter is a male, particularly one who will be smoking out of doors. This customer is not the normal customer for bags and handbags.

72. I have not overlooked the collector of ZIPPO lighters, but no evidence has been adduced that there are such collectors in Hong Kong among women, nor have I overlooked the fact that women may buy "ZIPPO" lighters as gifts for men. On balance however, I have concluded that the normal customer for bags and handbags is quite different to the normal customer for ZIPPO lighters. I turn to other surrounding circumstances, namely the non-customer who may encounter the respective goods.

73. There may be some overlap between trade channels, as some department stores undoubtedly sell both bags and lighters. The opponent stresses that 5% of its sales revenue is expended on point of sale promotions. I do not find I can place much weight on this factor as point of sales material available at the lighter counter of a department store is unlikely to come to the attention of handbag purchasers.

74. Returning to the test propounded by Evershed J. in testing the likelihood of

deception, I must consider whether a substantial number of purchaser of bags and handbags, with a passing familiarity with the opponent's mark, would be reasonably likely, upon seeing "ZIPPO" applied to handbags, to be caused to wonder whether both came from the same source. Is there any tangible danger of confusion among people of reasonable intelligence taking ordinary care? Section 12(1) is intended to protect the purchasing public from deception or confusion rather than the commercial interests of the opponent. The inquiry must therefore be seen from the point of view of the purchaser rather than the opponent.

75. There is no evidence of what the ordinary purchaser of handbags in Hong Kong with a passing familiarity of the opponent's mark might think if it encountered the suit mark on handbags. In the absence of such evidence, I must substitute myself as one who might be a potential purchaser of handbags – See *GE Trade Mark* [1973] RPC 297 at 321-322. The question I put to myself, being one with a familiarity of the opponent's mark in relation to lighters, is : would I, upon seeing "ZIPPO" on handbags, conjure up an association with the ZIPPO lighter company so that I may be caused to wonder whether they came from the same source? The answer is no. Apart from the same brand name there is absolutely nothing which would trigger the connection in my mind. Had the applicant used the identical flame mark as that of the opponent, one might be curious about the appropriateness of a flame as a trade mark for bags, and then the connection might be made, but that is not the case.

76. The risk of confusion is of course even less if the potential purchaser is one who has come upon the "ZIPPO" mark in relation to the applicant's products by reason of having seen the mark applied to handbags at any time since 1982, or 1989 if I take the date established by invoice evidence.

77. I take into account also the fact that no evidence of confusion has been brought to the applicant's attention, nor to the attention of the opponent who claims that it was not aware that the applicant was using the mark in Hong Kong until it read the Declaration of Mr. Paola. Although the likelihood of confusion must be considered at the date of the application to register, subsequent experience is relevant as providing a test for tendency to confuse – See *Kerly* (supra) para 10-05.

78. The onus is upon the applicant to satisfy me that, on the facts presented, there is no likelihood of confusion if the applicant's mark was to proceed to registration. Having taken into account all the circumstances outlined above I find that the applicant has

discharged its onus and accordingly find that the opposition under section 12(1) of the Ordinance fails (the opponent not having relied upon any of the other legs of section 12(1) of the Ordinance).

### **3. Under section 13(1)**

79. The opponent originally opposed the application by pleading that the applicant could not claim to be a bona fide proprietor of the suit mark. The basis of this claim is to be found in paragraph 10 of the Statutory Declaration of Mr. Baldo :

“My company’s business began in 1932 when George G. Blaisdell refashioned a cumbersome looking Austrian lighter into an “attractive lighter that works”. Fascinated by the name of another invention of that time, the zipper and like [sic] the onomatopoeic ring of the name, Blaisdell invented the word “ZIPPO” as the name of his new lighter and his company.”

80. Ms. Tsang accepted that she could not advance this ground of opposition and I therefore propose to say no more about it beyond saying that this was a proper concession in light of the authority of *Re Wowi & Device Trade Mark* [1998] 3 HKC 221. There it was held that before a proprietorship objection could be taken based on an earlier mark, the mark had to be virtually identical to the suit mark and be in respect of virtually identical goods. Here the opponent has no user evidence for even similar goods. I do not believe that the principle is any the less applicable when the mark is an “invented word”. The applicant has defeated the opposition under section 13(1) of the Ordinance.

### **4. Under section 23**

81. Section 23 of the Ordinance provides :

#### **Protection of marks registered in country of origin**

- (1) Subject to subsection (3), the Registrar may refuse to register any trade mark relating to goods in respect of any goods or description of goods if it is proved to his satisfaction by the person opposing the application for registration that such mark is identical with or nearly resembles a trade mark which is already registered in respect

of –

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description,

in a country or place from which such goods originate.

(2) ...

(3) No application to register shall be refused under this section –

- (a) if the applicant proves that he or his predecessors in business have in Hong Kong, in relation to such goods or services, continuously used the trade mark for the registration of which he has made application from a date anterior to the date of the registration of the other mark in such country or place of origin; or

(b) ...

82. For the section to be triggered, the registration of the mark upon which the opponent relies must precede the application date. It must be a registration, in the country of origin of the goods and be in respect of goods of the same description. The opponent has registrations in the USA, the country of origin of the opponent's goods, but no registration in respect of bags and handbags. The closest is Registration No. 1,768,823 in respect of "leather pouches for cigarette lighters in class 34". This registration however dates from 4 May 1993 so does not qualify under section 23 of the Ordinance. Ms. Tsang accordingly sought to argue that the opponent's Registration No. 1356785, which does pre-date the application date, is in respect of similar goods.

83. The date of registration is 27 August 1985. The applicant's assertion is that it has used "ZIPPO" in respect of bags and handbags in Hong Kong continuously since 1982. Sales figures are given for the years 1982, 1983 and 1984. S.23(3)(a) would accordingly defeat the objection based on the opponent's registration No. 1356785. The opponent however challenges the assertion pointing out that the invoices exhibited do not support the assertion until 1989. There are also gaps in the sales figures for the years 1985 and 1986 which may raise a doubt whether the mark has been used continuously from a date anterior to 27 August 1985. I accordingly go on to consider whether Registration No. 1356785 is in respect of similar goods. That mark, exhibited as part of Exhibit B to the Statutory Declaration of Mr. Baldo, is in respect of "Articles of Clothing – namely belts with buckles in class 25".

84. In considering whether goods are goods of the same description as those specified in the suit mark application, I propose to adopt the test set out in *Jellinek's Application* (1946) 63 RPC 59 a case dealing with section 12 of the UK 1938 Act. That section is couched in language very similar to section 20 of the Ordinance which in turn mirrors section 23 of the Ordinance but deals with marks registered in Hong Kong.

85. There Romer J. said that the matters to be taken into consideration in determining whether goods were goods of the same description were :

- (a) the nature and composition of the respective goods;
- (b) the respective uses of the goods; and
- (c) the trade channels through which the goods are bought and sold.

86. Ms. Tsang argues that belts with buckles and bags and handbags are both fashion accessories and belts would often be sold alongside bags in the leatherwear section of certain stores. This is of course true but does not, to my mind, satisfy the test. The composition of a belt with a buckle need not be of leather at all. It may be of plastic or of any of the wide variety of other natural and synthetic materials which can and are used for belts and buckles. A secondary use of both belts and handbags could be as a fashion accessory, but I am concerned with the primary use of the respective goods, and that is markedly different.

87. The trade channels may be the same when the belts are made of leather, but as this is only one material encompassed by the opponent's wide specification, it would not be true for belts made of other materials. You would expect to find, in any clothing store, a rack of belts, but you would not necessarily expect to find a range of handbags. I am unable to find that belts with buckles on the one hand and bags and handbags on the other are goods of the same description. It follows that the opponent has defeated the opposition under section 23 of the Ordinance.

## **5. Under section 13(2)**

88. The opponent has not, in its pleadings, asked the Registrar to exercise his

overriding discretion to refuse registration. I do not find that this omission precludes the opponent from raising it now.

89. The discretion arise when the opponent has failed in its objections under sections 12(1), 13(1) and 23 of the Ordinance and the mark is registrable under either sections 9 or 10 of the Ordinance. As a residual discretion, it would be something that I must consider as part of my decision making process in any event.

90. The basis of the request can be summarised as follows :

- (a) the opponent invented the mark “ZIPPO”;
- (b) the applicant has given no explanation as to how it came to also use the mark;
- (c) an available inference is that it copied the opponent’s successful mark intending to commercially exploit the goodwill and repute of the opponent’s mark; and
- (d) such behaviour taints the application and the Registrar should disallow the mark as a sign of his disapproval.

91. Is the evidence such that I can draw the inference that the applicant seeks to trade off the opponent’s reputation? For reasons which appear later, my finding is that it is not, but before returning to the cases, I also made the following observation. There is no copyright subsisting in a single word even an invented word – See *Exxon Corporation and others v Exxon Insurance Consultants International Ltd.* (1982) RPC 69 at 87-88; nor does the use by a trade mark proprietor of a word necessarily confer a monopoly over the use of the word for all goods.

92. In *Eno v Dunn* (1890) 7 RPC 311 (H.L.) Lord Herschell said at 317 :

“I may say, at once, that in my opinion the appellant has no exclusive property in the words “Fruit-Salt”, and, if it was proposed so to employ them, that no reasonable person could suppose that they had reference to the appellant’s preparation, such a use would be

perfectly unobjectionable. For example, I cannot conceive anyone imagining that a “Fruit-salt umbrella” was in any way connected with the article manufactured by Mr. Eno.”

93. Returning to the inference to be drawn from the applicant’s adoption of the word “ZIPPO”, I turn first to *Eastman v Griffiths* (supra). Continuing from the passage quoted at paragraph 62 hereof, Romer J. said :

“The John Griffiths Cycle Corporation Ltd. had for some time been selling bicycles under the names of “Dunlop” and “Ariel”. It suddenly, and, so far as appears, for no reason, unless it be the reason which I will hereafter suggest, adopted the name “Kodak” as applied to its cycles ...”

94. Romer J. then detailed that the defendant successfully obtained registration of “Kodak” for cycles, misrepresenting that the word had not previously been used in connection with cycles, and then registered, as a company, the second defendant in the name of the Kodak Cycle Company Ltd. It was against this background that Romer J. was able to say :

“ ...in my opinion, it *wanted* to use the word “Kodak” and acquire a monopoly of it, as applied to cycles, *in the hope and intention* of, in some share or other, identifying their company with the Plaintiff company whose “Kodaks” were so well-known in the market – *to cause the public to suppose* either that the defendant company, under its own name or under the name the Kodak Company Ltd. was the Plaintiff company, or was, at any rate, connected with the Plaintiff Company, or to lead the public to suppose that the goods which the defendant company was going to sell were the goods of the Plaintiff company, and so to obtain the benefit of the large reputation, and the benefit also of the expenditure of the Plaintiff company. With that object also the defendants have commenced recently to sell cycles, though they do not manufacture them, under the title of “Kodak Cycle”.” (emphasis mine)

95. In *Re Omega* (supra) the court was able to say :

“It is noteworthy that the suit mark which the applicant seeks to register is not identical to the Taiwan mark ...the applicant has chosen not to give any explanation as to why the mark it seeks to register is not the Taiwan mark but rather a mark that is virtually the

same as that used by the opponent ... *If someone sets out to deceive* such an inference may properly be drawn against them – See *Slazenger & Sons v Fulham & Co* (1889) 6 RPC 531 at 538. Therefore the court is entitled to find that the applicant's intention is to trade on the opponent's reputation." (emphasis mine)

96. What was found in each of these cases, and what is missing in the instant case, is a finding, based upon a reasonable view of the evidence, that there was a positive intention to deceive on the part of the applicant for the later mark.

97. In *Gay Giano* (supra) the respondent had not sold its watches in Hong Kong prior to applying to register; in *Hack's Trade Mark* (supra) similarly Mr. Hack had not used the mark before he applied for registration. By contrast the applicant itself has an international reputation in handbags, not quite to the same degree as the opponent has in lighters, but nevertheless a reputation of considerable significance. The evidence for this is to be found in the length of time the mark has been applied to bags and handbags, the number of countries in which such bags are sold and the number of countries in which it has registered or applied to register its mark.

98. The applicant has also been selling handbags in Hong Kong since 1982, although independent evidence of this fact is not available until 1989. On the applicant's evidence, its Hong Kong sales in 1990 were Italian L.10,573,600.

99. The mark is registered in Italy, Great Britain, Greece and an International Registration under No. 501543 extends to Germany, Austria, Benelux, Spain, France, Portugal, Switzerland, Bulgaria, Croatia, Hungary, Morocco, Monaco, Czech Republic, Romania Slovakia and Slovenia. I am unable, in these circumstances to accept that the applicant is commercially exploiting the opponent's reputation. There is nothing suggested in the evidence that the applicant would have benefited by the use of the same trade mark or indeed welcome an association with the opponent.

100. I remind myself the Register has been created by the Ordinance for the purpose of enabling marks to be entered therein. If no proper evidence can be adduced as to why registration should be refused for a qualifying mark, the exercise of discretion should not be adverse to the applicant. No proper evidence has been adduced and I therefore decline to exercise my discretion adversely to the applicant.

*Costs*

101. The applicant has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the successful party is entitled to his costs. I accordingly order that the opponent pays the costs of these proceedings.

102. 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 1 of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4) as applied to trade mark matters, with one counsel certified, unless otherwise agreed between the parties.

(K.S. Kripas)  
p. Registrar of Trade Marks  
4 December 2000