

Application No 5526/92

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

AND

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

**MARKWISE**

in Class 42 in Part B of the Register by  
Markwise Limited

AND

IN THE MATTER of an opposition  
thereto by C A Micklewright, D E P  
Hayward, O J R Allen, P C Allam, A C  
Rackham, M J P Deans, P A Bowman  
and E A Hitchcock trading in the United  
Kingdom as the firm Lloyd Wise, Tregear  
& Co and under the trading style LLOYD  
WISE and trading in Hong Kong as the  
firm Lloyd Wise & Co and under the  
trading style LLOYD WISE

DECISION  
OF

Miss Fung Shuk Hing acting for the Registrar of Trade Marks after a hearing on  
Tuesday, 21 October 1997.

Appearing: Ms Winnie Tam, Counsel, instructed by Messrs Benny Kong & Co on  
behalf of the Applicant, Markwise Limited

Mr C A Micklewright of C A Micklewright, D E P Hayward, O J R  
Allen, P C Allam, A C Rackham, M J P Deans, P A Bowman and E A  
Hitchcock trading in the United Kingdom as the firm Lloyd Wise,  
Tregear & Co and under the trading style LLOYD WISE and trading in

Hong Kong as the firm Lloyd Wise & Co and under the trading style  
LLOYD WISE, the Opponent

1. On 2 March 1992 (the "Application Date") Markwise Limited (the "Applicant") of Hong Kong applied under the Trade Marks Ordinance (the "Ordinance") for registration of the trade mark **MARKWISE** in, following a subsequent authorized amendment, Part B of the Register in Class 42 in respect of "advising and prosecution of applications for registration of intellectual property; trade mark and/or design and/or patent search services; design and creation of trade marks; advisory services relating to the infringement and licensing of intellectual property rights; legal services relating to intellectual property rights" (the "Specified Services").

2. Leave to advertise the suit mark in respect of the specified services was given on 23 February 1993. The suit mark was advertised in the Gazette on 12 March 1993.

### **Notice of Opposition**

3. The application was opposed by C A Micklewright, D E P Hayward, O J R Allen, P C Allam, A C Rackham, M J P Deans, P A Bowman and E A Hitchcock trading in the United Kingdom as the firm Lloyd Wise, Tregear & Co and under the trading style LLOYD WISE and trading in Hong Kong as the firm Lloyd Wise & Co and under the trading style LLOYD WISE (the "Opponent") of the United Kingdom, which, by their notice of opposition lodged on 10 November 1993, relies on grounds effectively that:-

- (a) The Opponent practise as, inter alia, patent and trademark attorneys internationally in including the United Kingdom and Hong Kong. Their business includes obtaining patents, designs, trademarks and copyright and other forms of intellectual property in all countries. They and their predecessors in business have traded under the style of **LLOYD WISE** since 1848.
- (b) The suit mark is not capable of distinguishing the specified services of the Applicant from the services of others and registration would contravene section 10 of the Ordinance. The suit mark is the name of an individual not represented in a special or particular manner and is not an invented word since it consists merely of the forename **MARK** and surname **WISE** conjoined.
- (c) The use of the suit mark would be likely to deceive and/or would be disentitled to protection in a court of justice under section 12 of the Ordinance. The **LLOYD WISE** mark has been

used by the Opponent for very many years and is well known in Hong Kong and internationally and others will and have been confused into believing that the specified services offered under the suit mark operate from or are associated with the Opponent. Users of the Opponent 僱 services in Hong Kong and internationally will also be confused into believing that the suit mark is a joint venture between the Opponent and **Marks & Clark**, a firm in the United Kingdom and Hong Kong which competes with the Opponent in the same services. Furthermore unlike the Opponent, the Applicant is not qualified as lawyers, patent or trademark attorneys and clients of the Applicant would be confused or misled into believing that the specified services are provided by qualified professionals.

(At the hearing Ms Tam said the reference to **Marks & Clark** should be **Marks & Clerk**. Mr Micklewright raised no objection. The subsequent references to **Marks & Clark** are therefore amended accordingly.)

- (d) The Opponent applied to register **LLOYD WISE** in Hong Kong under application number 7949/92 for the same or substantially the same services as the specified services. The suit application should be refused under section 21 of the Ordinance as the Opponent have used the **LLOYD WISE** mark in Hong Kong and internationally for very many years prior to the formation of the Applicant.
- (e) The suit application should be refused under section 22 of the Ordinance as the suit mark so nearly resembles the Opponent 僱 **LLOYD WISE** mark under application number 7949/92 for the same or similar services and the Opponent 僱 **LLOYD WISE** mark has been used earlier than the suit mark.
- (f) The Opponent are the proprietor of Class 42 registration in the United Kingdom of **LLOYD WISE**, registration number 1289510, dated 1 October 1986 for “professional advisory services relating to intellectual property rights”. The suit application should be refused under section 23 of the Ordinance as the suit mark and the Opponent 僱 **LLOYD WISE** mark so nearly resemble each other as to be calculated to deceive or cause confusion and the Opponent 僱 United Kingdom

registration is anterior to the date of the first use of the suit mark in Hong Kong.

- (g) The Opponent have requested the Applicant to withdraw the suit application to avoid opposition. However, the Applicant refused.

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

### **Counter-statement**

5. The Applicant by its counter-statement lodged on 4 January 1994 relies, effectively, on the following grounds in support of its application:-

- (a) Registration of **MARKWISE** would not contravene section 10 of the Ordinance.
- (b) Use of the Applicant's **MARKWISE** mark would not be likely to lead the public to believe that the specified services offered under the **MARKWISE** mark operate from or are associated with the Opponent and/or the firm **Marks & Clerk**. Use of the **MARKWISE** mark does not contravene section 12 of the Ordinance.
- (c) It is not admitted that the Opponent's **LLOYD WISE** mark has been used for very many years and is well known in Hong Kong and internationally.
- (d) The Applicant's trade mark agents are fully qualified by experience.
- (e) The suit mark has been used extensively by the Applicant for the specified services since February 1990 and by virtue of the long and substantial use, the suit mark has become identified with and distinctive of the Applicant and its services. Complaints on confusion as alleged by the Opponent have not been come across. The use and registration of the suit mark would not prejudice or deprive the Opponent's rights in their trade mark.

- (f) There are no grounds for objection under section 20, 21, 22 or 23 of the Ordinance.
- (g) The Opponent never requested the Applicant to withdraw the suit application to avoid opposition. Instead, in April 1994 the Opponent asked the Applicant to cease using the company name **MARKWISE**. In reply, the Applicant refused and nothing happened thereafter.
- (h) The suit mark is a good and registrable mark under the Ordinance.

6. The Applicant also seeks registration in exercise of the Registrar's discretion.

### **Evidence under Rule 25**

7. Evidence on behalf of the Opponent comes in a declaration dated 8 September 1994 of C A Micklewright, their partner (the "Micklewright Declaration").

8. Mr Micklewright says around 1848 Francis Wise, a consulting engineer after having found that his clients were increasingly asking him to draft descriptions of their inventions for petitioning for the grant of Letters Patent decided to specialise in this area and started a firm under the style **Francis Wise & Co**. Such style continued until 1868 when William Lloyd Wise (later Sir William Lloyd Wise), his son took over and chose the style **W Lloyd Wise**.

9. Mr Micklewright believes Sir William Lloyd Wise had the strongest personality and was the most publicity-seeking individual that the patent profession in the United Kingdom has ever seen. He says Sir William Lloyd Wise remained the president of The Chartered Institute of Patent Agents in the United Kingdom continuously from 1890 to 1897 whereas nobody has ever served a presidential term for more than two years.

10. Mr Micklewright says Sir William Lloyd Wise and his firm were not only famous among the patent practitioners, he was depicted by a famous cartoonist at that time as the greatest public figure. Mr Micklewright says in a cartoon by the famous cartoonist relating to a dinner at the Savage Club held in Sir William Lloyd Wise's honour to celebrate his receipt of a knighthood, all the people shown therein are famous notables at that time like law officers, senior judges and cabinet ministers.

11. Mr Micklewright says the professional name **LLOYD WISE** has been made publicly famous by Sir William Lloyd Wise and the goodwill in **LLOYD WISE** has been carefully preserved and promoted up to the date of Mr Micklewright 僱 Declaration.

12. Mr Micklewright says in 1908 Sir William Lloyd Wise left and the firm continued under the name **Lloyd Wise & Co** until 1947 when there was an amalgamation with another firm Bouly & Haig which led to the change of style to **Lloyd Wise, Bouly & Haig**. Mr Micklewright says there was no changes until 1979/80 when the firm became **Lloyd Wise, Tregear & Co** consequent on another amalgamation.

13. Mr Micklewright says in 1975 **Lloyd Wise, Bouly & Haig** set up a partnership in Hong Kong under the name **Lloyd Wise & Co** for providing 僱 legal services; legal research; professional consultation; patent, design, trademark and copyright agencies; patent exploitation; patent, design, trademark and copyright management; advisory services on intellectual property rights” from 1975 onwards.

14. Mr Micklewright says since 1975 **LLOYD WISE** has been in continuous use in Hong Kong as a mark for the services provided by **Lloyd Wise & Co** and is distinctive of and distinguishes the services provided by **Lloyd Wise & Co** from services provided by others in the same field.

15. Mr Micklewright produces as Exhibit CAM-1 a bundle of papers showing services provided by **Lloyd Wise & Co** and says clients relate the goodwill of **Lloyd Wise & Co** to the name **LLOYD WISE**. Mr Micklewright says front sheets and covers for patents, designs and trademarks have been used since before he joined the firm in 1980.

16. Mr Micklewright repeats information in the notice of opposition (see paragraph 3(b) and (c)). Mr Micklewright further says users of the Opponent 僱 services in Hong Kong and internationally have been confused into believing that the suit mark is a joint venture between **Marks & Clerk** and **Lloyd Wise & Co**.

17. Mr Micklewright repeats information in the notice of opposition (see paragraph 3(f)) and produces as Exhibit CAM-2 a copy of the Opponent 僱 United Kingdom registration as advertised in the United Kingdom Trade Marks Journal.

## **Evidence under Rule 26**

18. Evidence on behalf of the Applicant comes in a declaration dated 21 December 1995 of Yip Yee May Emily, its Director (作s Yip 德 Declaration”).

19. Ms Yip says the firm **Markwise** was started in February 1990 as her trading style. She produces as Exhibit A copy first business registration certificate of the firm.

20. Ms Yip says before setting up the firm **Markwise**, she has been in business with two partners in the style Wisetaff Personnel Consultants Company. Ms 律ip says WISETAFF is a coalition of the words WISE and STAFF. She produces as Exhibit B copies of business registration certificate and Form 1(c) (application by firm or by other body unincorporate for registration of business(es) carried on by such body in Hong Kong) of Wisetaff Personnel Consultants Company.

21. Ms Yip says she wished to adopt a common word for all the trading styles of her businesses. Ms Yip considers as STAFF could not be appropriate for businesses other than personnel consultancy, she chose WISE from WISETAFF as one of the components of her new trading style.

22. Ms Yip says as she was specialized in trade marks in intellectual property and that trade mark registration was the major business of the new firm at the outset, she chose MARK as the other component of her new trading style.

23. Of the two combinations **WISEMARK** and **MARKWISE**, Ms Yip considers **WISEMARK** could be rejected for registration for being laudatory of the specified services. Ms Yip says she adopted **MARKWISE** because the laudatory meaning of WISE was completely lost when it was used as a meaningless adverbial suffix in **MARKWISE** rather than as a prefix in **WISEMARK**.

24. Ms Yip says her notice of the acceptance of the trade mark **CARDWISE** in a past issue of the United Kingdom Trade Marks Journal has also prompted her to adopt the mark **MARKWISE** and she produces as Exhibit C copy journal advertisement in support.

25. Ms Yip says **MARKWISE** is adopted in good faith.

26. Ms Yip says since the joining of a partner in May 1991, **Markwise** became a wholly owned subsidiary of Ontop Consultants Limited and she produces as Exhibit D copy business registration certificate in support. Ms Yip says she is a director and shareholder of Ontop Consultants Limited. She further says in January 1992 the name of Ontop Consultants Limited was changed to **Markwise Limited** and

she produces as Exhibit E copy certificate of incorporation on change of name relating thereto.

27. Ms Yip says Lloyd Wise & Co by a letter dated 9 April 1992 asked the Applicant to cease using **MARKWISE** and the Applicant in replying on 15 April 1992 considered such request unreasonable. Ms Yip produces as Exhibit F copies of correspondence relating thereto.

28. Ms Yip considers **MARKWISE** as a whole should at least be capable of distinguishing the specified services. Ms Yip considers the Trade Marks Registry has recognized the distinctiveness of **MARKWISE** and allowed it to proceed to registration in Part B under section 10 of the Ordinance.

29. Ms Yip compares the two marks, **MARKWISE** and **LLOYD WISE**. To Ms Yip, the Opponent's **LLOYD WISE** mark is the name of an individual comprising a forename and a surname whereas the Applicant's **MARKWISE** mark is a single worded invented term. Ms Yip does not agree the Applicant's **MARKWISE** mark can be viewed as the name of an individual as claimed by the Opponent. Ms Yip considers it unfair to assume the general public would have difficulties in distinguishing the two marks because of the existence of the common word WISE. Ms Yip points out comparison should be made to the marks in their entirety. Ms Yip concludes when considered as a whole, **MARKWISE** is visually, phonetically and conceptually completely different from **LLOYD WISE**.

30. Ms Yip refers to **Coca Cola of Canada v Pepsi Cola of Canada (1942) 59 RPC 127** and **Shredded Wheat Co Ltd v Kellogg (G B) (1940) 57 RPC 137** and considers greater emphasis should be put on the prefixes of **MARKWISE** and **LLOYD WISE**, namely, MARK and LLOYD. Ms Yip denies any claim of confusion of the two marks, **MARKWISE** and **LLOYD WISE** on the basis that the first part of trade marks are recognized as being the most important part as confirmed in **"Mipcastroid" (1925) 42 RPC 264**.

31. Ms Yip says the Applicant has been using its **MARKWISE** mark continuously for the specified services in Hong Kong since February 1990. Ms Yip says the **MARKWISE** mark is and has been used for the specified services by means of letterheads, envelopes, compliment slips, forms for submission to the Trade Marks Registry and gazette advertisements as address for service and she produces as Exhibit G materials showing use relating thereto.

32. Ms Yip considers the **MARKWISE** mark has by reason of the facts set out come to signify to the trade and the general public services provided by the

Applicant. Ms Yip further says the **MARKWISE** mark has become identified with and distinctive of the Applicant and its services by virtue of long and substantial use.

33. Ms Yip points out the Applicant has received no complaints on confusion that **MARKWISE** is a joint venture between the firms **Marks & Clerk** and **Lloyd Wise & Co.**

### **Preliminary Point**

34. On 3 October 1997 the Opponent wrote to the Registrar making an application pursuant to section 83(1) of the Ordinance for viva voce evidence to be taken from Yip Yee May Emily, the declarant of Ms Yip 僱 Declaration (see paragraph 18) during the course of the coming hearing on 21 October 1997. The Registrar ruled that such an application would be dealt with as a preliminary issue at the beginning of the hearing.

35. At the hearing on 21 October 1997, Mr Micklewright confirmed the Opponent 僱 application for viva voce evidence to be taken from Ms Yip related to how the **MARKWISE** mark was devised. Ms Tam indicated she would raise no objection if the scope of viva voce evidence was to be confined to this aspect. I directed, pursuant to section 83(1) of the Ordinance, that viva voce evidence be taken during the course of the hearing from Ms Yip confined to how the **MARKWISE** mark was devised.

### **Grounds of Opposition**

36. Mr Micklewright agreed not to pursue the ground of opposition under section 22 of the Ordinance.

37. The opposition is based on sections 10, 12(1), 21 and 23 of the Ordinance.

### **Section 10**

38. As at the Application Date, the provisions of section 10 of the Ordinance are as follows:-

- “(1) A trade mark relating to goods to be registrable in Part B of the register must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the

case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to the use within the extent of the registration.

- (1A) A trade mark relating to services to be registrable in Part B of the register must be capable, in relation to the services in respect of which it is registered or proposed to be registered, of distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -
  - (a) the trade mark is inherently capable of distinguishing as aforesaid; and
  - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.”

39. Ms Tam noted there were two reasons put forward by the Opponent in support of their submission that the suit mark contravened section 10 of the Ordinance (see paragraph 3(b)).

40. Ms Tam said one reason was that the suit mark was the name of an individual not represented in a special or particular manner. Ms Tam pointed out this reason could only be traced in section 9 but not section 10 of the Ordinance. Ms Tam referred to section 9(1)(a) of the Ordinance which provides as follows:

- “(1) A trade mark ... to be registrable in Part A of the register shall contain or consist of at least one of the following essential particulars-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;”

Ms Tam submitted there was no legal basis to support the contention that for marks to be registrable in Part B of the Register section 9(1)(a) had to be complied with.

41. Ms Tam said the other reason was that the suit mark was not an invented word since it consisted merely of the forename MARK and the surname WISE conjoined. Ms Tam emphasized whether a mark was invented or not was only relevant for considering registrability under section 9 but not section 10 of the Ordinance. Ms Tam pointed out the suit mark was considered for registration under section 10. Ms Tam stressed the **MARKWISE** mark was in one word. Ms Tam submitted it was completely unjustifiable for the Opponent to dissect the suit mark for claiming that MARK was a forename and WISE was a surname. Ms Tam submitted although the suit mark contained WISE, WISE was obviously used as a suffix when there was the coalescence of MARK and WISE into one word without hyphen, as “wise” in “otherwise”.

42. Ms Tam submitted even if one considered the registrability of the suit mark under section 9 of the Ordinance, one had to consider the ordinary signification of the suit mark. Ms Tam said when one came across the suit mark for the specified services, one would relate the suit mark to services connecting with trademark instead of considering the suit mark as a personal name. Ms Tam submitted it was ordinary for quite descriptive trade marks to be registered under section 10 of the Ordinance.

43. Ms Tam stressed the registrability of the suit mark had to be considered under section 10 but not section 9 of the Ordinance. Ms Tam reiterated the Opponent’s reasons for objecting the registration of the suit mark which were based on section 9 of the Ordinance were not right. Ms Tam drew my attention to page 324 of **“hunky” T M [1978] FSR 322** where Mr Justice Whitford said under section 10 of the United Kingdom Trade Marks Act 1938 (“1938 Act”) the substitution of the words “capable of” for “adapted to” as in section 9 indicated a less stringent test. Ms Tam said both section 10 of the 1938 Act and section 10 of the Ordinance dealt with registration in Part B of the Register whereas both section 9 of the two legislation dealt with registration in Part A of the Register. Ms Tam submitted just because a mark consisted of a descriptive word or a surname did not render it incapable of distinguishing. Ms Tam considered such mark might be registrable in Part B of the Register. Ms Tam said the Opponent’s reasons for objecting to the registration of the suit mark did not suggest the descriptiveness of the suit mark. Ms Tam considered Opponent’s surnominal objection could not stand.

44. Ms Tam referred me to the headnote of **Always [1986] RPC 93** where it was held, inter alia, that “traders cannot obtain a monopoly of certain words to the detriment of other traders who may properly wish to use them in relation to their own goods, and ‘Always’ was such a word”. Ms Tam pointed out there was the application of the dictum of Lord Wilberforce in **YORK Trade Mark [1982] FSR 111** in the **Always** case which was as follows:

“ there can be no doubt that exactly similar reasoning must be applied to the words ‘inherently capable of distinguishing’ in section 10(2)(a) of the Act. They mean, in effect ‘inherently capable in law of distinguishing’, the relevant law being the accepted principle that, in relation to certain words, of which laudatory epithets and some geographical names were established examples, traders could not obtain a monopoly in the use of such words (however distinctive) to the detriment of members of the public who, in the future, and in connection with other goods, might desire to use them. That this principle has been firmly laid down in relation, in particular, to geographical words, by a strong current of authority, I shall now demonstrate.”

Ms Tam said “exactly similar reasoning” referred to the reasoning of Lord Diplock in **Smith Kline & French Laboratories Ltd v Sterling-Winthrop Group Ltd [1976] RPC 511** citing the observations of Lord Parker in **W & G” (1913) AC 624** which were brought under 1905 Act before there was a Part B in the Register. Ms Tam submitted the dictum of Lord Wilberforce applied equally to common surnames. However, relating to the suit mark, Ms Tam pointed out, it was unjustifiable to dissect it and treated WISE as a surname. Ms Tam submitted the use and notional fair use of the suit mark for the specified services did not interfere with the rights of other parties.

45. Ms Tam considered the situation was analogous in **Orange Grove Fruit Drinks’ Application, Re [1962] RPC 83** where the word GROVE in the mark ORANGE GROVE was both a surname and a word which possessed an ordinary dictionary meaning. Ms Tam said it was decided in the **Orange Grove** case that when considering the mark ORANGE GROVE as a whole, it was not inherently incapable of distinguishing one brand of orange juice from another. Ms Tam also mentioned two common words “spot” and “joint” were joined together to form “spotpoint” which was allowed to be registered for electrical appliances, other than irons in **Hotpoint Electric Heating Co. Application (1921) 38 RPC 63**.

46. Mr Micklewright maintained that the suit mark was not inherently capable of distinguishing under section 10 of the Ordinance based on the reasoning in the notice of opposition (see paragraph 3(b)). Mr Micklewright referred to the **Hotpoint** case and submitted the registration of “Hotpoint” was based on use whereas the Registrar’s acceptance of the registration of the suit mark in Part B was on a prima facie basis.

47. Both Ms Tam and Mr Micklewright had made submissions on the use of the suit mark. For the reason given in paragraph 54, there is no need for me to deal with this aspect.

48. I have to decide whether **MARKWISE** is registrable within the terms of section 10 of the Ordinance. Unlike section 9(1) of the Ordinance which specifies the characteristics required in a mark in order that it may qualify for registration in Part A of the Register, section 10 requires only that a mark shall be “capable of distinguishing” the services of an applicant. The matter turns upon the suit mark’s inherent capability of distinguishing the specified services provided by the Applicant. I agree with Ms Tam that the test of registrability under section 10 of the Ordinance is less stringent than is provided by section 9. The burden is on the Applicant to show the suit mark is registrable. I must look at the suit mark and all the surrounding factors afresh. The issue of the leave to advertise does not assist the Applicant in any way.

49. A trader, as a matter of public policy, should not to be allowed to obtain by registration under the Ordinance a monopoly in what other traders may legitimately desire to use.

50. The classic statement of this doctrine, referred to as “the observations of Lord Parker” by Ms Tam (see paragraph 44), is propounded by Lord Parker in the **W & G** case where he said that the right to registration “must largely depend upon whether other traders are likely, in ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods”.

51. The same reasoning applies whether considering the inherent adaptability of a mark under section 9 of the Ordinance or the inherent capability of a mark to distinguish under section 10.

52. As Lord Shaw said in the **W & G** case I have to survey the possible confusions or difficulties which might arise in consequence of the grant of the trade mark, or the possible impairment of the rights of innocent traders to do that which,

apart from the grant, would be their natural mode of conducting their business. As Lord Moulton suggested in **“Perfection” (1910) 1 Ch 130** a suitable test is : Will the registration of the word as a trade mark cause substantial difficulty or confusion in view of the right of other traders to use the word as a description of their goods? If the answer is in the affirmative, registration should be refused. If it be in the negative, whether by reason of the nature of the word or because past user has limited the possibility of other traders safely or honestly using the word, registration should be allowed.

53. The suit mark must be regarded as a whole. I consider the suit mark, when considered in the context of the specified services, does not carry the signification of a personal name having MARK as the forename and WISE as the surname. The suit mark may suggest services relating to trademark matter. However, **MARKWISE** is not a word that other traders would normally use to describe the nature of their services. **MARKWISE** is not the natural word to be chosen for the purpose. I cannot see others could legitimately lay claim to the whole word as a mark or be embarrassed by the registration of **MARKWISE**. I consider registration of **MARKWISE** for the specified services would not cause substantial difficulty or confusion in view of the right of other traders to use **MARKWISE** as a description of their services in the nature of the Class 42 services. I consider other traders, now and future, are not likely, in the ordinary course of their business and without improper motive, to desire to use **MARKWISE** or some word or mark nearly resembling it, in connection with their own Class 42 services. I consider the rights of innocent traders to do what would be their natural mode of conducting their business will not be impaired by a registration of **MARKWISE** for the Class 42 specified services.

54. I finds **MARKWISE** is inherently capable of distinguishing the Applicant's Class 42 specified services, even without evidence of use. The suit mark is therefore acceptable for registration in Part B of the Register in Class 42 in respect of the specified services.

55. I find the opposition under section 10 of the Ordinance fails.

### **Section 12(1)**

56. The provisions of section 12(1) as at the Application Date are as follows:

“ 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.”

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

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

“ Having regard to the Opponent 儂reputation in **LLOYD WISE** and **LLOYD WISE & CO** is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any services covered by the registration proposed, will not be likely to cause deception or confusion amongst a substantial number of persons? May a number of people be caused to wonder whether the services under the respective marks come from the same source? Is there a real tangible danger of confusion if the applied for mark is put on the Register?”

59. The reference to 儂substantial” is a question to be judged in relation to the markets for the services concerned. 儂persons” are all those people likely to become customers of the services concerned involving the use of the respective marks as about the availability or performance of services concerned or otherwise in relation to services concerned.

60. As Ms Tam accepted the onus is on the Applicant to defeat the opposition under section 12(1) of the Ordinance. This is done by satisfying me there is no reasonable probability of deception or confusion, the test, in different words, being whether use of the suit mark by itself in relation to any of the specified services, in any manner which can be regarded as normal fair use of it, will be calculated to deceive or cause confusion, without necessarily leading to passing-off. The suit mark must offend if its use in relation to any of the specified services is likely to cause deception or confusion in the minds of persons to whom it is addressed, even if actual customers will not ultimately be deceived. Likely customers must not be put into a state of doubt.

61. To bring section 12(1) of the Ordinance into operation an opponent must have some reputation for its mark in Hong Kong derived from user in the widest sense or awareness of it here. The onus then shifts to the applicant to show there is no reasonable likelihood of deception or confusion.

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

63. Section 12(1) of the Ordinance further extends to cases where the confusion is with an opponent's name or any other matter that associates the services in question with an opponent.

64. I must decide whether the public at large, customers or likely customers of services involving the use of the respective marks of their owners, would infer they come from the same source or at least be caused to wonder whether that might not be so. Having regard to the Opponent's reputation in **LLOYD WISE** and **LLOYD WISE & CO** in Hong Kong at the Application Date I must decide whether it would be likely that the public would be deceived or confused if the suit mark or a similar mark is used in relation to any of the specified services.

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

66. The relevant date for determining these proceedings is the Application Date.

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

68. Ms Tam referred to Exhibit CAM-1 of Mr Micklewright's Declaration (see paragraph 15) and said the documents therein showed **LLOYD WISE & CO** was used in Hong Kong by the Opponent in respect of services in the nature of the specified services at the Application Date. Ms Tam accepted **LLOYD WISE** was the Opponent's trading style. The Opponent can mount an opposition under section 12(1) of the Ordinance.

69. The core issue that requires consideration is the similarity of the suit mark and **LLOYD WISE** (and also **LLOYD WISE & CO**) by comparing them to establish the reasonable probability of deception or confusion.

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

“ 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. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

71. The resemblance between the marks must be considered with reference to the ear as well as to the eye. An ordinary person is expected to exercise normal care and be of average intelligence but no more. His memory is imperfect. He remembers marks by general impression or some significant details, rather than by photographic recollection of the whole. Too detailed an examination of the marks should not be made. The question of resemblance is one of first impression. Marks should not be compared side by side but rather as a whole, regard being had to the idea of each mark. Ultimately whether marks resemble each other or not is a question of fact, to be judged objectively.

72. Under section 12(1) of the Ordinance the Opponent 僣 mark is considered in its form in actual use in Hong Kong. The Applicant 僣 suit mark is considered in notional fair use, which is any normal and fair use a registered proprietor may make of his mark in ordinary course of business in respect of services covered by the registration.

73. Ms Tam submitted that **LLOYD** could be a forename or a surname whereas **WISE** was obviously a surname. Ms Tam went through the history of the Opponent and their predecessors (see paragraphs 8 to 14). She mentioned the change of the name from **W Lloyd Wise** to **Lloyd Wise, Bouly & Haig** and then to **Lloyd Wise, Tregear & Co**. Ms Tam pointed out the name **LLOYD WISE** was carefully preserved despite there had been changes of the business during a span of 150 years.

In the actual use of **LLOYD WISE** by the Opponent, Ms Tam submitted, both **LLOYD** and **WISE** were given equal significance and it was not solely **WISE** which was given prominence. Ms Tam said **WISE** might stand out if **LLOYD** was substituted by a more common forename like DAVID. Ms Tam submitted when I considered the likelihood of deception or confusion, I had to consider **MARKWISE** and **LLOYD WISE** each as a whole.

74. Ms Tam said the message given by the Opponent was that they provided professional services and as such the nature of the Opponent's services was unlike, for example, the shoe shine business where the business came cheap and one would pick up the service in a hurry. Ms Tam submitted for the purpose of considering the likelihood of deception or confusion the kind of customers seeking the Opponent's services and the way these customers approached the Opponent for their services had to be taken into account.

75. Ms Tam submitted because of the Opponent's longstanding reputation in **LLOYD WISE**, the public would not connect **MARKWISE** with **LLOYD WISE**. Ms Tam regarded this as a significant surrounding circumstance favouring the Applicant.

76. Ms Tam referred to the notice of opposition where it was said others "were ill and have been confused" into believing that the specified services offered under the suit mark operated from or were associated with the Opponent (see paragraph 3(c)). Ms Tam submitted it was a bare assertion with no evidence in support.

77. Ms Tam submitted the assertion that the suit mark was a joint venture between the Opponent and **Marks & Clerk** (see paragraphs 3(c) and 16) was too far-fetched. Ms Tam pointed out no evidence of the reputation of **Marks & Clerk** had been put forward and **Marks & Clerk** had not made any complaints as to the likelihood of deception or confusion despite **MARK** constituted the first part of **MARKWISE**. Ms Tam queried how **Marks & Clerk** could be recognizable from **MARKWISE**. Ms Tam said there was no evidence of confusion in this respect.

78. Ms Tam referred me to a copy letter from the Opponent to the Applicant dated 9 April 1992 at Exhibit F (see paragraph 27) where the Opponent alleged instances of confusion between the parties' marks. Ms Tam submitted it was inconceivable that the Opponent, being professionals themselves, had not taken any steps to preserve such evidence and put the evidence before the tribunal after 9 April 1992. Ms Tam said the Opponent could not even give the evidence of one single instance of confusion and the inference had to be that no such evidence of confusion existed. Ms Tam concluded a number of persons would not be caused to wonder

whether the services under **MARKWISE** and **LLOYD WISE** respectively came from the same source.

79. To Ms Tam there would be no likelihood of deception or confusion if the suit mark was registered for the specified services.

80. Mr Micklewright submitted visually the suit mark was composed of two words joined together. Mr Micklewright further pointed out phonetically the suit mark could not be considered as one word and that there should not be any dispute that there were really two words. Mr Micklewright said similarly there were two words in **LLOYD WISE**. Mr Micklewright did not agree with Ms Tam that **LLOYD** and **WISE** should be considered equally prominent. Mr Micklewright said **LLOYD** was a forename but not a surname. He said if **LLOYD** was a surname, then the Opponent's mark should be **LLOYD & WISE** instead of **LLOYD WISE**. Mr Micklewright concluded **WISE** being the surname was the most important part in **LLOYD WISE** and as the identical word **WISE** was used in the Applicant's **MARKWISE** mark, **MARKWISE** and **LLOYD WISE** so nearly resembled each other as to be likely to deceive or cause confusion.

81. Mr Micklewright submitted the Opponent and **Marks & Clerk** were two intellectual property firms in Hong Kong. It was not inconceivable, he submitted, that there was a likelihood of deception or confusion amongst the trade arising from the belief that **MARKWISE** was a joint venture between **Marks & Clerk** and the Opponent and that the suit mark was formed by adopting the first word of **Marks & Clerk** and the second word of **Lloyd Wise & Co.**

82. Mr Micklewright reminded me in determining whether there was sufficient likelihood of deception or confusion, **MARKWISE** and **LLOYD WISE** should not be placed side by side for meticulous comparison and I had to take into account of the effects of imperfect recollection.

83. Mr Micklewright said anyone knowing **LLOYD WISE** might wonder whether there was any relation between **MARKWISE** and **LLOYD WISE**. He submitted there was a reasonable likelihood that some people would be confused.

84. In response to Ms Tam's submission that it was inconceivable that the Opponent produced no evidence of confusion (see paragraph 78), Mr Micklewright attempted to submit that the head of an intellectual property department was confused. Ms Tam objected to such submission on the ground that this amounted to the submission of new evidence. Mr Micklewright was reminded to confine the scope of his submission to the pleadings and the evidence submitted.

85. Mr Micklewright did not agree with Ms Tam that just because **LLOYD WISE** was so well-known, nobody would suspect **MARKWISE** had any relation with **LLOYD WISE** (see paragraph 75). Mr Micklewright submitted the more well-known a mark was, the more likely confusion was possible due to people's suspicion of the relation between the two marks.

86. In reply, Ms Tam submitted the test was whether "a substantial number of persons" not "some people" as stated by Mr Micklewright or one or two persons would be confused. Ms Tam said it was trite law that it was "a real tangible danger of confusion" not some fanciful danger of confusion that should be taken into account. Ms Tam pointed out Mr Micklewright's submission relating to the head of an intellectual property department being confused lacked evidence and particulars and was highly prejudicial and should therefore be disregarded. Ms Tam said moreover a intellectual property department head was not a likely customer. Ms Tam concluded there was no evidence before the tribunal as to how and whether confusion between **MARKWISE** and **LLOYD WISE** arose.

87. As Ms Tam said **MARKWISE** and **LLOYD WISE** must be compared as wholes.

88. As Mr Micklewright said imperfect recollection is a matter for consideration. A likely customer, a person with an ordinary memory, can only contrast the mark in relation to the services provided to him with his recollection of the mark used in relation to those he is seeking to get. Allowance must be made for this in estimating the probability of deception. A person acquainted with one mark, and not having the two side by side for comparison, may well be deceived, if the second mark was used in relation to the services, into a belief that he was dealing with services, which bore the same mark as that with which he was acquainted. The question is not 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 the trade mark before him is the same as the other, of which he has a general recollection.

89. The Opponent's mark in use is as shown in Exhibit CAM-1, that is, **LLOYD WISE & CO**, much as shown herein. There is no dispute that **LLOYD WISE** is also in use as the Opponent's trading style.

90. The suit mark is in unadorned block capitals, much as shown herein.

91. From the exhibits in Ms Yip 僂 Declaration, it is shown that the Applicant 僂 mark in actual use can be in the forms of **MARKWISE LIMITED** or **Markwise Limited**, much as shown herein. It is not necessary to consider whether the use of the suit mark in these two forms constitutes notional fair use. If I find there is sufficient resemblance between **MARKWISE** and **LLOYD WISE** or **LLOYD WISE & CO** so as to be likely to cause deception or confusion there will be no need to consider **MARKWISE LIMITED** or **Markwise Limited**. If I do not so find then a separate comparison of **LLOYD WISE** or **LLOYD WISE & CO** with either **MARKWISE LIMITED** or **Markwise Limited**, if possible will not advance the Opponent 僂 case.

92. I, like Ms Tam and Mr Micklewright, concentrate on the resemblance between the suit mark and **LLOYD WISE** rather than **LLOYD WISE & CO**. If I find there is sufficient resemblance with **LLOYD WISE** as to be likely to cause deception or confusion there will be no need to consider **LLOYD WISE & CO** separately. If I do not so find then a separate comparison with **LLOYD WISE & CO** with “& CO” being the indistinctive elements will clearly not assist the Opponent further.

93. **MARKWISE** is a eight-letter word. The impression created by **MARKWISE** is its possible linkage with trademark matter.

94. **LLOYD WISE** comprise two words, the first word **LLOYD** having five letters and the second word **WISE** having four letters. **LLOYD** can be a forename or a surname. The impression created by **LLOYD WISE** can be that of an European male individual of that name or that of two European surnames. It is commonplace not only at present but also at the Application Date that professionals providing services in the nature of the specified services adopt personal names and surnames as marks or trading styles for their services.

95. I consider **MARKWISE** and **LLOYD WISE** are visually different, when compared as wholes. Where there is a common denominator, more regard should be paid to the parts not common, without ignoring the common parts. The common denominator of **MARKWISE** and **LLOYD WISE** is that the last four letters of **MARKWISE** is identical to the second word of **LLOYD WISE**. The differences are that the first four letters of **MARKWISE** are **MARK** whereas the first word of **LLOYD WISE** is **LLOYD**. There is not a single common letter in **MARK** and in **LLOYD**. **MARK** and **LLOYD** are so unlike to the eye. Both **MARKWISE** and **LLOYD WISE** are word marks comprising letters of the Roman alphabet, which are read from left to right, so that the visual impact of letters at the beginning is greater than those at the end. I find the visual identity of the suit mark is distinct and separate from the visual identity of **LLOYD WISE**.

96. I consider **MARKWISE** and **LLOYD WISE**, when compared as wholes, are phonetically dissimilar. The second syllable in **MARKWISE** is likely to be pronounced as in ˈtherwise". The second word in **LLOYD WISE** will be pronounced either as in ɪˈ wise man" or as in ˈtherwise". The pronunciation of the first syllable of **MARKWISE** and the first word of **LLOYD WISE** is different. The second syllable of **MARKWISE** and the second word of **LLOYD WISE** may or may not be pronounced the same. Even if they are pronounced the same, I find such is not unduly significant in view of the differences in the pronunciation of the first syllable of **MARKWISE** and the first word of **LLOYD WISE**. I consider the differences in pronunciation ensure no likelihood of phonetic confusion arising between **MARKWISE** and **LLOYD WISE**. I find the phonetic identity of the suit mark is distinct and separate from the phonetic identity of **LLOYD WISE**.

97. It is not in dispute that the services of the parties are the same.

98. It follows the nature and kind of customers likely to use the parties' services are the same. Ms Tam 僂 submission in paragraph 74 may suggest that because of the nature of the services provided by the parties, customers would exercise a higher standard of care and so any likelihood of deception or confusion between the marks of the parties is further reduced. I consider likely customers are expected to exercise normal care and intelligence and I see no reason why the standard of care and intelligence attendant on using the services should be any more or less than that. Additional care and attention will attend the procurement of some services because of their inevitable expense. Services in the nature of the specified services do not fall into that category.

99. Arguments of a lessened chance of imperfect recollection of a well-known mark because of its familiarity seem balanced by the increased numbers who, attracted by their recall of the mark and aware of its cachet, will find themselves in the situation where the spectre of imperfect recollection may arise. A well-known mark is no more or less deserving of protection than any other mark.

100. I agree that I should not take into account of Mr Micklewright 僂 submission that the head of an intellectual property department was confused. Such does not arise from the pleadings and the evidence submitted and there is a lack of evidence substantiating the submission. The Opponent, in any event, is not penalized in these proceedings by their failure to produce any evidence of deception or confusion amongst the trade or public.

101. I am satisfied that **MARKWISE** and **LLOYD WISE** do not look alike and they do not sound alike. They do not give any impression that they denote the

same trade source. The first impression of them on the eye or the ear would preclude any risk of confusion. Although I have taken into full account of the possibilities of imperfect recollection, the pre-Application Date reputation of the Opponent in **LLOYD WISE** in Hong Kong, the nature and kind of customers likely to use the parties' services and all the surrounding circumstances, it seems to me almost impossible for the ordinary customers of the Class 42 services to confuse or be misled by **MARKWISE** and **LLOYD WISE**. I consider there is no likelihood of deception or confusion arising amongst a substantial number of persons if the Applicant uses **MARKWISE** in a normal way as a trade mark for the specified services and the Opponent uses **LLOYD WISE** in Hong Kong in the same way as it has previously used it here in relation to services in the nature of the specified services. The reasoning here which I have given as regards the comparison of **MARKWISE** and **LLOYD WISE** applies, mutatis mutandis, to the comparison of **MARKWISE** and **LLOYD WISE & CO**.

102. As the Opponent did not submit any evidence of the reputation of the **Marks & Clerk** mark in Hong Kong, the Opponent cannot mount an opposition based on the **Marks & Clerk** mark under section 12(1) of the Ordinance.

103. I conclude reflecting on the spirit of the words of Cozens-Hardy M R and Farwell L J in the **Perfection** case extracted in **Yorkshire Copper Works Application (1954) 71 RPC 150** as follows:-

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

104. **Under section 12(1)** Having regard to the Opponent 僇 reputation in **LLOYD WISE** and **LLOYD WISE & CO** I am satisfied that the suit mark, if used in a normal and fair manner in connection with any of the specified services, will not be likely to cause deception or confusion among a substantial number of persons. I consider a number of people may not be caused to wonder whether services under the respective marks come from the same source. I consider there is no real tangible danger of confusion if the suit mark is put on the Register for the specified services.

105. I find the opposition under section 12(1) of the Ordinance fails.

## **Section 21**

106. As at the Application Date, the provisions of section 21 of the Ordinance are as follows :

“ Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of -

- (a) the same goods or services;
- (b) the same description of goods or services; or
- (c) goods and services or descriptions of goods and services which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or, on an appeal, by the Court.”

107. The Opponent are relying on their application made on the same date as the Application Date under the Ordinance for registration of the trade mark **LLOYD WISE** in Part A of the Register in Class 42 in respect of 憤 legal services; legal research; professional consultation; patent, design, trade mark and copyright agencies; patent exploitation; patent, design, trade mark and copyright management; advisory services on the intellectual property rights” under Application No 7949/92.

108. Mr Micklewright rightly pointed out that one of the prerequisites to invoke section 21 of the Ordinance was that **MARKWISE** and **LLOYD WISE** had to nearly resemble each other. Section 2(4) of the Ordinance provides that references in the Ordinance to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion. I have already found that **MARKWISE** and **LLOYD WISE** are not deceptively similar under section 12(1). As the level of deception and confusion required for section 12(1) should be the same as that required for section 21, the Opponent also fail under section 21 of the Ordinance.

## **Section 23**

109. The provisions of section 23 as at the Application Date are as follows:

- “(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) Subject to subsection (3), the Registrar may refuse to register any trade mark relating to services in respect of any services or description of services 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 services;
  - (b) the same description of services; or
  - (c) goods or a description of goods which are associated with those services or services of that description,
- in a country or place from which such services originate.
- (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) if the opponent does not give an undertaking to the satisfaction of the Registrar that he will, within 3 months from the giving of the notice of opposition, apply for registration in Hong Kong of the trade mark so registered in the country or place of origin, and will take all necessary steps to complete such registration.”

110. Section 23 of the Ordinance is discretionary. However, the exercise of my discretion thereunder does not arise unless the mark is found to be likely to deceive or cause confusion. The level of deception and confusion is the same under section 12(1) as under section 23. As Ms Tam said the objection of the Opponent under section 23 stood and fell with their section 12 objection. Having failed under section 12(1) the Opponent must fail under section 23 of the Ordinance.

### **Section 13(2)**

111. That being so the exercise of my general discretion arises. This is a discretion under section 13(2) of the Ordinance to refuse registration to a mark which complies, as the suit mark does, with section 10 of the Ordinance that is not prohibited by section 12(1) or 21.

112. This discretion is of a judicial nature to be exercised upon judicial principles affected neither by caprice nor over caution and on reasonable grounds, with regards to all the circumstances of the case. My prime concern is for the public interest. A bona fide application should not be refused on fanciful grounds or grounds which are unsubstantial in a business sense. I am justified in exercising my discretion against an applicant where it is shown that its conduct was such as to secure it some advantage (**Rectico**” (1935) 52 RPC 136).

113. As the suit mark has its own independent visual and verbal identity the Applicant is under no obligation to explain how it was chosen. Nevertheless, in Ms Yip’s Declaration Ms Yip explained how she chose the suit mark. Moreover, at the hearing viva voce evidence was taken from Ms Yip as to how the suit mark was devised. Mr Micklewright did not dispute Ms Yip’s evidence on this. The Applicant had explained how it came up with the suit mark.

114. I decline to exercise my discretion in a manner adverse to the Applicant, nothing having been put before me to persuade otherwise.

### **Conclusion**

115. As the suit mark meets the requirement of section 10 of the Ordinance and the opposition has failed I find and direct the suit mark is acceptable for registration in Part B of the Register in Class 42. I note the Applicant in another proceeding unrelated to the present one has agreed to delete “advisory services relating to the infringement and licensing of intellectual property rights; legal services relating to intellectual property rights” from the specified services. In the circumstances, the specification of services that is allowed is “filing and prosecution of applications for registration of intellectual property; trade mark and/or design and/or patent search services; design and creation of trade marks”.

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

( Fung Shuk Hing )  
p. Registrar of Trade Marks  
30 December 1997

## Brief Summary

### MARKWISE

Application for registration of **MARKWISE** in Part B in Class 42 for filing and prosecution of applications for registration of intellectual property; trade mark and/or design and/or patent search services; design and creation of trade marks; advisory services relating to the infringement and licensing of intellectual property rights; legal services relating to intellectual property rights - Opposition based on sections 10, 12(1), 21 and 23 - Registrar gives direction to take viva voce evidence during the course of hearing - **MARKWISE** is inherently capable of distinguishing the Applicant's services even without evidence of use - Opposition under section 10 fails - Opponent's reputation in **LLOYD WISE** and **LLOYD WISE & CO** prior to application date enables Opponent to mount opposition under section 12(1) - Parties' services the same - Marks considered in their entireties - Parties' marks not visually or phonetically similar - No likelihood of deception or confusion - Opposition fails under section 12(1) - Opposition also fails under sections 21 and 23 - Registrar's discretion under section 13(2) not exercised adverse to Applicant - Application allowed.