

Application No. 6901 of 1994

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

AND

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



in Class 9 in Part B of the Register by Chitlink  
Electronic International Limited

AND

IN THE MATTER of an opposition by  
Golden Profit Limited

**DECISION  
OF**

Mr Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a hearing on 10  
January 2000.

Appearing : Mr. Martin Liao, counsel instructed by Messrs Ng & Shum on behalf of the  
Applicant Chitlink Electronic International Limited  
: Mr. Ling Chun Wai, counsel instructed by Wenping & Co on behalf of the  
Opponent, Golden Profit Limited

*Application for Registration of “NEWSTAR & DEVICE”*

1. On 23 June 1994 (the “relevant date”) Chitlink Electronic International Limited of Flat 4, 8/F, Block A, Ming Poa Industrial Center, 18 Ka Yip Street, Chai Wan, Hong Kong, applied to register the trade mark “NEWSTAR & DEVICE” (“the suit mark”) in class 9 in respect of the following goods:

“Electrical alternative current and/or direct current adaptors, battery chargers, electrical voltage and/or current converters, nickel-cadmium rechargeable batteries, soldering irons, soldering guns, alternative current sockets, audio and video cables”.

1. The original application was in Part A of the Register. The Registrar objected to the application on the basis that the mark was not distinctive and not a word that had no direct reference to the character or quality of the goods within the meaning of section 9(1)(d) of the Trade Marks Ordinance. The Registrar did however indicate that the suit mark was inherently capable of distinguishing the applicant’s goods from similar goods of other traders and that he was, accordingly, prepared to accept the mark in Part B of the Register. By a form TM—No. 33, filed on 6 December 1995, the applicant agreed to transfer the application to Part B of the Register.

2. A representation of the suit mark appears below:



*The Notice of Opposition*

3. The application was advertised in the Gazette on 26 January 1996. On 26 March 1996, Golden Profit Limited of P.O. Box 71, Craigmuir Chambers, Road Town, Tortola, British Virgin Islands, filed Notice of Opposition to the application. The grounds of opposition are in summary:-

The opponent is the proprietor, in Hong Kong and worldwide, of various trade marks including “WINSTAR”, “NEWSTAR”, “SUPERSTAR” and a “device of star” (“the opponent’s marks”). The opponent is the registered proprietor in Hong Kong of the trade marks “WINSTAR” in classes 7, 9, and 11; of “star & device” in classes 7 and 9; and has applied to register, in class 9, “NEWSTAR”. The opponent had been using, promoting and selling goods bearing the opponent’s marks, particularly “WINSTAR” for more than two decades in Hong Kong and has accordingly acquired a substantial reputation in Hong Kong and worldwide for products sold under or by reference to the opponent’s marks. Specifically:

**1. Under section 20**

The suit mark closely resembles the opponent’s marks. Further, the goods for which the suit mark is sought to be registered are similar to those covered by the opponent’s marks and/or application.

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

Use by the applicant of the suit mark upon or in relation to the goods specified in the said application would be likely to cause confusion and deception to the public and/or would be disentitled to protection in a Court of Justice and/or would be contrary to law.

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

Since the opponent owns prior rights in the opponent's marks by virtue of prior registration and use in Hong Kong, the applicant is not the proprietor of the resembling suit mark and is not therefore entitled to claim to be the proprietor of the suit mark.

**4. Under section 2(1), 9 and 10**

The suit mark denotes the goods of the opponent and not of the applicant. The suit mark is therefore not a validly registrable trade mark as it is not adapted to distinguish, nor capable of distinguishing, the applicant's goods and is not capable of indicating a trade connection between the applicant's goods and the applicant.

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

Registration of the suit mark should be refused by the Registrar in the exercise of his discretion.

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

*The Counter-Statement*

5. On 11 September 1996 the applicant filed its counter-statement. In summary the applicant:

- admits the opponent's registrations and application for registration;
- relies on the ground that its pending application for the registration of the suit mark precedes the opponent's application for the mark "NEWSTAR";
- denies that the opponent has carried on business in Hong Kong or elsewhere in relation to goods to which the marks "WINSTAR", "NEWSTAR" and/or "SUPERSTAR" are applied;
- denies that the marks "NEWSTAR" and/or "SUPERSTAR" have ever been the trade marks of the opponent;

- denies that the opponent has established any exclusive reputation and goodwill in the marks “WINSTAR”, “NEWSTAR” or “SUPERSTAR” in Hong Kong or elsewhere;
- denies that those marks or any of them have become recognised by the trade and the public in Hong Kong as the trade marks of the opponent exclusively;
- relies on the ground that “WINSTAR” is derived from two common, non-distinctive words and that the words, particularly the word “star” are commonly used as, or as part of, trade marks or trade names in Hong Kong, particularly in the field of electronics and electrical products;
- denies any similarity between the suit mark and the opponent’s marks;
- denies any use by the opponent of the mark “NEWSTAR” prior to the applicant’s application for registration and therefore any prior rights, by the opponent, in the mark;
- relies on the ground that it was the first user of the suit mark on the goods specified;
- denies that its use of the suit mark would cause confusion or deception on the part of the public or would be disentitled to protection in a Court of Justice;
- relies on the ground that the public associates its goods, rather than the goods of the opponent with the mark “NEWSTAR”;
- relies on the ground that the suit mark is both adapted to, and capable of, distinguishing its goods;
- and finally asks that any discretion be exercised in its favour; that the opposition be dismissed with costs; and that its application be allowed to proceed to registration.

### *The Opponent’s Evidence*

6. Pursuant to Rule 25, the opponent filed a statutory declaration of YU Ying wai, a director of the opponent. Mr. YU states that he first became engaged in the field of electrical and electronic products in 1966. In 1974, he commenced trading as a sole proprietor under the style, Million Electronics Company. In 1983, that business was incorporated under the name Yu’s Million Electronics Co. Ltd. Eventually all the trade marks were transferred to the opponent. Golden Edge Enterprises Limited was established for the marketing of the opponent’s products.

7. The opponent is the registered proprietor of the “WINSTAR” mark in classes 9, 7 and 11; the registered proprietor of “star & device” in classes 7 and 9; and the applicant for registration of “NEWSTAR” in class 9 under application number 9731 of 1994. Representations of the marks “WINSTAR” and “star & device” are annexed as exhibit “A”.

I interpose to record that the “WINSTAR” mark is an unadorned word mark in upper case. A representation of the “star & device” mark appears below.



Reference is also made throughout to the so called “SUPERSTAR” mark. For the sake of clarity, a representation of that mark appears below.



8. The opponent has been using the marks “WINSTAR” and “star & device” for various electrical appliances including electric sirens, digital multimeters, panel meters, printed circuit board pens, audio frequency dividing networks, stereo radios, headphones, electric soldering wires, electric soldering irons, digital multimeters, multiple adaptors, electricity converters, speakers, head cleaners, tape head demagnetizers, loudspeakers for Hi-Fi, and calipers. Of the listed goods, electricity converters, the production of which commenced as early as 1974, are the most popular products of the opponent and are available from almost every Hong Kong sales outlet selling such products. The “WINSTAR” and “star & device” marks have been applied to these products since 1983.

9. Sales for products bearing the marks “WINSTAR” and “star & device” were HK\$30.8 million in 1990; HK\$ 31.6 million in 1991; HK\$ 32.9 million in 1992; HK\$ 39.1 million in 1993 and HK\$40.8 million in 1994. Annexed to the declaration, marked “AA”, are sample sales invoices. The “WINSTAR” and “star & device” marks have been advertised in various magazines, exhibitions and television. Copies of the magazine advertisements are annexed as exhibit “B”.

10. Mr. YU continues by stating that Madam WU Kam Chun (Madam WU) is one of the directors and shareholders of the applicant. Previously she had been employed as secretary to both Million Electronics Company, having commenced on 16 March 1981, and Yu’s Million Electronics Co. Ltd., resigning on 1 March 1994. Payroll records are annexed as exhibit “D” to establish this. When the idea was born, in early 1993, to develop a new mark “NEWSTAR” to add to the “star” series, this fact was communicated to several staff members including Madam WU.

11. Mr. YU concludes with the opinion that on the local market for electricity converters, the opponent’s marks are the only dominant brand. Customers will confuse the

goods of the applicant with those of the opponent as a result of the adoption by the applicant of the suit mark.

### *The Applicant's Evidence*

12. Pursuant to Rule 26, Madam WU Kam Chun filed a Statutory Declaration as director and shareholder of the applicant. In brief she admits her employment with Yu's Million Electronics Co. Ltd., but states that she left in February 1994. Madam WU opines that the opponent was a private BVI of Mr. YU which had not, during her employ, ever traded in the products bearing the opponent's marks. All products bearing these marks were traded by Golden Edge Enterprise Ltd., and after her termination, by Winstar Tokyo Japan Ltd. Furthermore, Madam WU states that throughout her employment with Yu's Million Electronics Co. Ltd., the "WINSTAR" mark was mainly used on export goods and always with a logo. For the Hong Kong market, the "star & device" mark was used, always preceded by the word "SUPER". The opponent's "NEWSTAR" mark of application No. 9731/94 has not been used by any of Mr. YU's businesses on any of their goods. Madam WU denies any knowledge of the opponent's idea to adopt a "NEWSTAR" mark.

13. Also filed is a Statutory Declaration of NG Chung Fat, a manager of the applicant. He annexes a representation of the suit mark and explains how the mark was selected. He supports this with copies of concepts prepared by the designer and evidence of the cheque sent in payment for those services. In summary, "NEWSTAR" was the preferred name of three, (the others being "NORTHSTAR" and "VIEWSTAR") and the suit mark, was the preferred rendition of that name. The applicant has been using the suit mark since approximately June 1994 up to the day of his declaration.

14. Mr. NG continues by exhibiting copies of the earliest invoices relating to sales of products bearing the suit mark. "NEWSTAR & Device" products have been advertised in every issue of the Hong Kong Electronics magazine since approximately late 1994, and in the Electronic Technology magazine. Mr. NG claims that through sales and marketing, the suit mark has become the market leader in Hong Kong in respect of products such as adaptors and converters and has come to denote the goods of the applicant and none other. Exhibited are examples where the names Newstar and Chitlink are used almost interchangeably in commercial trade inquiries. Mr. NG conservatively estimates that "NEWSTAR & Device" has 60% of the Hong Kong market share for adaptors and converters compared to 30% for products bearing the opponent's marks. Mr. NG concedes that the opponent is the registered proprietor of the "WINSTAR" marks in classes 7, 9 and 11, and of the "star & device" marks in classes 7 and 9. He then repeats many of the points made by Madam WU, adding that sales of products in Hong Kong bearing the "WINSTAR" mark were negligible until after the applicant's "NEWSTAR" products were introduced.

15. Mr. NG challenges the accuracy of the sales figures given in Mr. YU's declaration by reference to different figures contained in a High Court Statement of Claim filed on behalf of Golden Edge Enterprises Ltd. According to this document, Golden Edge achieved sales of HK\$ 18.2 million in 1990; HK\$ 20.2 million in 1991; HK\$23.6 million in 1992; HK\$ 24.9 million in 1993 and HK\$ 34.5 million in 1994. Of these figures only 50 – 60% were attributable to products bearing the marks "WINSTAR" and/or "star & device". Finally Mr. NG exhibits numerous examples of other products which use the word "star" as part of their trade mark or trade name.

*The Opponent's Evidence in Reply*

16. Pursuant to Rule 27, Mr. YU filed a further Statutory Declaration in reply. He asserts that no explanation had been given as to how the applicant came upon the idea of adopting the suit mark. He repeats his assertion that Madam WU knew of the opponent's plan to use a "NEWSTAR" mark. He exhibits 1977 annual returns to show he is listed as director of Golden Edge Enterprises Limited and Winstar Tokyo Japan Limited, all of which were, at the material time, under his control. He admits an error in the sales figures in his earlier declaration and now adopts those contained in Mr. NG's Statutory Declaration. He concedes there had been no prior use of the "NEWSTAR" mark by the opponent, but explains that this was because of advice received from the Registry of the applicant's prior application. Finally he points out that the other "star" marks exhibited by Mr. NG relate to different classes of goods and, as a result, confusion with the opponent's marks is less likely in the market place.

17. That concludes my summary of the evidence filed.

18. In addition to the Statutory Declarations filed, both counsel agreed that I may also take into account, insofar as the opponent's registered marks are concerned, the state of the Register as at the relevant date. This was necessary as the exhibits marked "A" annexed to Mr. YU's Statutory Declaration show the proprietor of the "WINSTAR" mark in class 9 as YU Ying Wai rather than the opponent, and the applicant for registration of the "star & device" mark in class 9 as YU Ying Wai trading as Million Electronics Company. The evidence filed would suggest that as at the date of the Declaration, (14 March 1997) that mark had not matured to registration. The true position, as disclosed from the Register, is that the "star & device" mark matured to registration on 1 July 1988 (effective from 11 February 1983) and that both it and the "WINSTAR" marks were assigned to the opponent on 29 June 1993 by virtue of a Deed of Assignment dated 16 December 1992.

*Fixing of a Date for the Hearing of Argument*

19. No application to file further evidence pursuant to Rule 28 having been received from either party, a hearing was fixed for 10 January 2000. The fixture date was communicated to both parties on 22 November 1999, and both parties confirmed their desire to be heard.

*Pre-trial Interlocutory Application*

20. A facsimile was received at the Registry at 14:15 hours on 5 January 2000 from the opponent's agent in the following terms:

"We ...write to inform you that we are advised by our counsel that we intend to call Mr. Ng and Ms. Wu as witnesses for cross-examination due to the stark contrast between the evidence given by Mr. Ng and Ms. Wu in their respective Statutory Declarations and the evidence which is given by our client."

21. The letter concluded with reference to section 83 of the Trade Marks Ordinance and the discretionary power provided therein to direct *viva voce* evidence in lieu of or in addition to evidence by declaration. Significantly, there was no request for the taking of *viva voce* evidence from the opponent's declarant.

22. In *Kidax Shirts Ltd.'s Appln.* (1959) R.P.C. 167, the Court of Appeal held that the applicant for cross-examination must discharge the onus of showing that cross-examination is necessary. As the “stark contrast” had not been identified, and on the face of the evidence, no contrast in evidence could be seen that related to any of the pleaded grounds of opposition, I exercised my discretion on the material before me and provisionally refused the request, subject to the parties’ right to be heard. The applicant, to whom all correspondence was copied, responded to the request in the following terms:

“We take the view that no or no sufficient case is made out by the Opponent in the letter for the Registrar to exercise his discretion to order cross-examination. We do not consider that this is an appropriate case for it and, in the event, we object to the lateness in making the application just 3 days before the hearing.”

23. Crossing with the provisional determination was a further facsimile from the opponent’s agent in which the “contrast” was identified. On 7 January 2000 I indicated, in writing to both parties that, subject to the applicant agreeing to an abridgement of time, I would be prepared, pursuant to Rule 87, to hear argument on the cross-examination issue on 10 January 2000. In the event, on 8 January 2000, the opponent, by facsimile, withdrew the request for a hearing pursuant to Rule 87. On 10 January 2000, before the commencement of the opposition hearing, and after satisfying myself that the opponent understood the consequences of the withdrawal of the request, I allowed the opponent to withdraw its application for the taking of *viva voce* evidence.

24. Before leaving the subject of interlocutory applications, just prior to the luncheon adjournment on the day of the hearing, counsel for the opponent sought leave to amend the grounds of opposition, pursuant to Rule 98, by inserting, as a further ground under section 13(1), the following:

“(a) the application has been made in breach of confidence and/or the duty of fidelity owed by WU Kam Chun, a director and shareholder of the Applicant and a former employee of the Opponent and/or its predecessors”.

25. In support of the application for leave, Mr. Ling argued that the evidence to support the ground was contained in the Statutory Declarations and that there could therefore be no complaint of surprise. Mr. Ling referred to paragraph 4-36 of *Kerly’s Law of Trade Marks and Trade Names*, which states that it is customary at the [UK] Patents Office to treat arguments raised by the evidence as supplementing the pleadings. He referred to the decisions in *Club Europe Holidays Ltd.* and *NASA v Higgins*, both as yet unreported but which were heard in June 1999, in which, despite criticism by the Vice-Chancellor Sir Richard Scott, the amendments sought to the pleadings were allowed.

26. The applicant objected to the amendment on a number of grounds. I trust I do Mr. Liao no disservice if I refer to only two. Nowhere in the Statutory Declarations, argues Mr. Liao, is there any direct allegation, or inference that could be drawn from the facts, that the idea [of the opponent] of adopting a new mark “NEWSTAR” had been communicated to [*inter alia*] Madam WU (a fact that she categorically denies) with the requisite degree of confidentiality. Secondly, Mr. Liao argues, there was no duty of fidelity owed by Madam WU to the opponent as she was employed, on the opponent’s evidence, by

Yu's Million Electronics Company Limited, rather than the opponent. This is borne out by the record of employment annexed to the Statutory Declaration of Mr. YU.

27. Dealing with Mr. Liao's second point first, I do not believe the matter is quite so simple. Mr. Ling, without developing the point, drew my attention to the signature of Madam WU under the chop of Golden Edge Enterprises Limited, wherein she purports to be an authorised signatory of that company on invoices exhibited. I refer to page 40 of the bundle as an example. The signature has not been proved, but Mr Liao did not take the point. The "signature" certainly contains the characters for Madam WU Kam Chun. This goes some way towards establishing a loose relationship between the different legal entities sharing premises and the same staff. I am not prepared to hold that in those circumstances the technical objection taken by Mr. Liao is sustainable.

28. In my view however, it would be a wrongful exercise of the discretion provided in Rule 98, to accede to Mr. Ling's application. Before allowing a late amendment to the grounds of opposition, I would need to be satisfied that there was sufficient evidence to support the ground. It is established law that where a breach of confidence is alleged, three essential elements must be established: (i) that the information was of a confidential nature; (ii) that the information was communicated in circumstances importing an obligation of confidence; and (iii) that there had been an unauthorised use of the information to the detriment of the person communicating it. I entirely agree with Mr. Liao that the bare recital of the fact of Madam WU's employment; the bare recital that the opponent had an idea to develop a new mark; and the bare recital that the idea was communicated to various staff of the opponent, including Madam WU, in the absence of even an assertion that the information was of a confidential nature and was imparted in circumstances importing an obligation of confidence, cannot amount to evidence that could support the proposed new ground.

29. The allegation would not only fail on the first and second of the essential requirements, but, in my judgement, it would also fail on the third. Even in the event that a duty of confidentiality could be inferred, that duty would have lapsed with the termination of Madam WU's employment. It is clear from the decision in *Faccenda Chicken Ltd. v Fowler* [1985] FSR 105, (confirmed on appeal [1987] 1 Ch 117) that confidential information acquired by an employee could be used by him after his employment ceased except where the information was classed as a "trade secret", (such as chemical formulae or special methods of construction or manufacture) or was so confidential that it required the same protection as a trade secret. I am unable to accept that the purported communication of the possible use, at some future time, of a trade name could be classified, in law, as so confidential that it must be treated as a trade secret. Any use made by Madam WU of the information could not therefore be regarded as unauthorised. Ultimately however, for there to be a breach of confidence or duty of fidelity, there must be proof, on the balance of probabilities, that the alleged communication was in fact made to Madam WU. I have an allegation of communication and a denial. There is nothing further to assist me in finding where the truth lies. As I cannot be satisfied upon the evidence that there was such a communication, the issue simply cannot arise.

30. That would be sufficient to rule against the admission of the new ground of opposition, but in deference to Mr. Ling's tenacious arguments, I shall also briefly touch on his other submissions.

31. The reference to the extract from *Kerly* does not assist as the UK practice presupposes there is “evidence” filed from which one could discern an unpleaded ground. As explained above, this was not the case here. That would also dispose of the submission that there could be no complaint of surprise by the applicant. The two unreported decisions referred to were concerned with filing further evidence on appeal. They have no relevance to the question before me.

32. Mr. Ling then argued that the opponent was entitled to raise the subject matter under section 12(1), (disentitlement to protection in a court of justice), and under section 13(2) (the exercise of the Registrar’s discretion to refuse registration), so that this application was really brought from an abundance of caution and as a result of Mr. Liao’s objection to the request for cross-examination of the applicant’s declarants. Mr. Ling submitted that it is implicit from the evidence, particularly from the indisputable fact that in June 1994, Madam WU applied to register the mark “NEWSTAR & Device”, and that the mark applied for has the device element of three thick stripes rounded at their intersection with the word element, precisely in the same way as that element has been used by the opponent for his “SUPERSTAR” mark, that Madam WU has copied ideas developed by the opponent.

33. In my view, that submission ignored the evidence contained in the Statutory Declaration of Mr. NG, of the tentative selection by the applicant of three names, “NEWSTAR”, “NORTHSTAR”, and “VIEWSTAR” and the engagement of Design Factory to design marks based on those three names. There is no evidence of who suggested the device element of three thick stripes in the suit mark, but the inference that it was the Design Factory that first submitted representations containing the three thick stripes is as equally open to me as an inference that Madam WU copied the design from the “SUPERSTAR” mark. The submission also totally ignored the fact that Madam WU denied any communication to her of the opponent’s idea to develop a new mark. The inference of copying is not one that is irresistible and could not therefore provide justification to exercise my discretion in favour of allowing the amendment simply because the same issue could arise under another section of the Ordinance.

34. Similarly, to exercise my discretion under section 13(2) would require me to find as a fact, that there had been a breach of “good faith” on the part of Madam WU. Again, to reach such a finding, on the balance of probability, would require me to be satisfied on the evidence filed that copying had occurred. For the reasons given, this I cannot do. For all the above reasons I refused leave to introduce this new ground of opposition.

35. Finally Mr. Ling argued that, when the issue of who has the better right to claim proprietorship of a mark is raised, the tribunal must determine that issue before it can go on to determine issues of likelihood of confusion. There is force in this argument which is supported by authority —see *Al Bassam’s Trade Mark* [1955] R.P.C. 511. Mr. Ling submitted that in the circumstances, as issues had been raised that could not be resolved on the evidence filed, I should direct *viva voce* evidence of the applicant’s declarants on my own motion.

36. The fact that Madam WU denied any knowledge of the opponent’s idea to develop a new mark would have been apparent to the opponent since at least early October 1997 when Madam WU’s Statutory Declaration was served. Assuming the absence of independent evidence to rebut the denial, that would have been the proper time to make application for cross-examination. I was prepared to entertain the last minute application,

bearing in mind my power to award costs to compensate the applicant. In the event the application was withdrawn. However, having elected not to press for cross-examination of the applicant's declarants, the opponent cannot now shift the responsibility to patch up deficiencies in its evidence to the tribunal.

37. I also bore in mind that even if Mr. Ling did not come up empty handed from his cross-examination of Madam WU and was able to raise a doubt regarding her denial of knowledge of the opponent's "idea" to develop a new mark, "NEWSTAR", I was not satisfied that this would advance the opposition. There is no original literary copyright in a word, even an invented word —see *Exxon Corporation v Exxon Insurance Consultants International Ltd.* (1982) R.P.C. 69. Nor is there property in an "idea" of a mark that can be appropriated—see Lord Upjohn in *Boardman v Phipps* [1967] 2 A.C. 46 at 127, a point Mr. Ling conceded when he agreed that he could only rely on a breach of confidence. I have already referred to the fact that there was no request to take *viva voce* evidence from Mr. YU. The circumstances surrounding the alleged communication of the "idea" would thus still remain unproved and in any event any duty owed by Madam WU terminated when she left her employment. Finally, where a mark is "unused" upon goods, as that term is understood in its technical trade mark sense, the person claiming a right of proprietorship over it, must assert that right. —See *Vitamins Ltd.'s Appln.* [1956] R.P.C. 1; *Brown Shoe Company Inc.'s Appln.* [1959] R.P.C. 29 and *Hong Kong Caterers Ltd. v Maxim's Ltd.* [1983] HKLR 287. There is no evidence that the opponent did anything about the "idea" from inception until after the applicant had made its application to register. There is no evidence, for example, that the opponent reduced the idea to any written form of representation, so that he could be said to be the "designer" of the mark as described in the *obiter* comments of L.J. Cotton in *Hudson's Trade Mark* (1886) 3 R.P.C. 155.

38. For all the above reasons I exercised my discretion not to order the cross-examination of the applicant's declarants on my own motion.

### *Decision*

39. I am deeply indebted to counsel for their exhaustive analysis of the evidence filed and their valuable submissions on the applicable law.

40. I am satisfied that all three declarants have personal knowledge of, and are authorised respectively by the applicant and the opponent to give evidence on, the matters to which they depose. I will deal with the opposition under the various headings in the order that appears in the grounds of opposition filed.

#### **1. Under section 20**

A preliminary observation is that, in so far as the opponent bases its opposition on its application for registration of the mark "NEWSTAR", the opposition is misconceived for the section is confined to marks "already on the register". This part of the section 20 opposition is struck out. For the sake of clarity, I should also say that it is common ground that there is no registered "SUPERSTAR" mark, and accordingly, to the extent that the grounds of opposition refer to the similarity to that mark under section 20, that opposition is also struck out.

41. Section 20, to the extent that it relates to goods, provides:

**20. Prohibition of registration of identical and resembling trade marks**

(1) except as provided by section 22, no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register 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.

42. Section 2(4) of the Ordinance, which is relevant to the definition of “nearly resembles”, provides that a near resemblance of marks is a resemblance so near as to be likely to deceive or cause confusion.

43. The suit mark is not identical to any of the opponent’s registered marks. The two issues for determination therefore are whether the goods for which the suit mark is sought to be registered are the same goods or goods of the same description as those of the opponent’s registrations; and, if so, does the suit mark so nearly resemble the opponent’s mark/s as to be likely to deceive or cause confusion?

44. Mr. Liao for the applicant accepts that the goods sought to be covered by the application for registration of the suit mark are, at the very least, goods of the same description as those of the opponent’s registrations. I accordingly find the answer to the first question is in the affirmative.

45. The accepted test to be applied under section 20 is that stated by Evershed J. in *Smith Haydens & Co.’s Application* (1946) 63 R.P.C. 97. Adapted to the matter in hand, the test may be expressed as follows:

“Assuming user by the opponent of its marks “WINSTAR” and/or “star & device” in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion among a substantial number of persons if the applicant also uses its mark “NEWSTAR & Device” normally and fairly in respect of any goods covered by its proposed registrations?”

46. The comparison of the marks is complicated by reason that “WINSTAR” is purely a word mark, whereas “NEWSTAR & Device” has both a word and a graphical component, and “star & device” is purely a device mark, though one which readily invokes the word equivalent of the graphic. Different tests have been promulgated in the decided authorities to deal with marks that differ in their composition. I am accordingly obliged to perform a number of comparisons.

47. First however, some general rules which are applicable in every section 20 situation. The onus is on the applicant to satisfy the tribunal that the trade mark applied for is not reasonably likely to deceive or cause confusion. A decision on the question of a resemblance likely to deceive or cause confusion is not an exercise of discretion by the tribunal but a finding of fact. If the applicant fails to discharge its onus or if I am left in doubt, registration must be refused. The question of whether there is deception amongst a substantial number of persons must be judged in relation to the market concerned, that is, all likely purchasers of the goods, provided that such persons use ordinary care and intelligence. The fact that no evidence of actual confusion has been filed does not preclude the tribunal from finding that the marks are, or are not, as the case may be, in fact confusingly similar.

*“Star & device” v “Newstar & Device” as the Former Appears and the Latter Would Appear on the Register*

48. When comparing device marks against word marks, or device marks against mixed marks, a useful test is one that has come to be known as “the idea of the mark”. What are the essential characteristics of the marks, the impression left in the mind by each when the two are not placed side by side for critical comparison? The first impression that each makes is important. In my judgement, the essential feature of the “NEWSTAR & Device” mark, despite the device element of three horizontal stripes, is nevertheless the word “newstar”. The essential feature, in my judgement, of the “star & device” mark is the pictorial representation of a shining star and although, no doubt, goods bearing that mark would be orally referred to as “star brand”, or “shining star brand”, the overall impression is still that of a pictorial representation of a star and not the word form of “star”. It may, by a stretch of imagination, be perceived, as a bright and therefore “new” star, but this interpretation has not been suggested by Mr. Ling nor is it supported by evidence. Taking both marks as a whole, I find as a fact that there is no deceptive resemblance between the two marks as they appear, or in the case of “NEWSTAR & Device”, would appear on the Register.

*“Star & device” v “Newstar & Device” Assuming Notional use of Both*

49. Marks, when applied to goods, can show variations from the registered representations. For example, a mark which is formed in the process of plastic injection moulding or stamped by a die may appear less distinctly on goods than its sharp black and white image would appear on the Register or on a printed label. The size of the mark in use may have a bearing on its legibility. For that reason the tribunal must also consider “notional use”. Notional use means no more than the assumption that both marks will be used in a “normal and fair manner” for all the goods covered by the registration or application in question.

50. Mr YU, in paragraph 7 of his first Declaration states that, electricity converters are the most popular goods of the opponent. In paragraph 5 of Mr. NG’s Declaration, he states that “NEWSTAR” has become the market leader in Hong Kong in respect of products such as adaptors and converters. These then would be the goods on which the purchasing public will most frequently encounter the respective marks. These are moderately sized goods which would have ample room for an adequately sized trade mark to be applied to them. I am satisfied that used normally and fairly on these goods, neither the appearance of the “star & device” mark nor the suit mark would differ appreciably from their respective appearance on the Register. Batteries, one of the goods covered by the “star & device”

registration, are much smaller, but I think I am entitled to assume that the trade mark would appear longitudinally along the body of the battery, as it does on batteries with which I am familiar. Again, I do not think there would be much variation from the registered mark if the mark is used normally and fairly on batteries. Having considered the notional use of the respective marks upon the goods to which the marks would be applied, I find that there would be no deceptive resemblance.

51. That does not entirely dispose of the matter. In *Kerly*, paragraph 10-04, the following passage appears:

“If in fact it is known what use an applicant intends to make of a mark, that use cannot be excluded. Thus evidence that an intended use is particularly likely to be confusing is helpful to an opponent, to prevent such use being dismissed as unfair or fanciful.”

52. In *Shanahan* (Australian Law of Trade Marks and Passing Off (second edition)) at page 152 the same point is expressed in this way:

“An opponent cannot allege that confusion will result from some particular manner of use that the applicant could not reasonably adopt. On the other hand, if the evidence shows that the applicant has in fact adopted a particular manner of use, it may be difficult for the applicant to deny that this is not a “normal and fair” notional use of the mark for the purposes of the comparison.”

Mr. Liao accepts that proposition.

53. How the suit mark has been used upon the goods of the applicant appears from the advertisements placed by the applicant in the Hong Kong Enterprise magazines exhibited to the Statutory Declaration of Mr. NG. The device elements of the three long horizontal stripes on either side of the word element have been omitted. The mark as it appears on the application to register is faithfully reproduced when it appears other than upon the goods, for example on invoices and in the headnote of advertisements.

54. I see nothing in the user of the suit mark upon the goods that would lead me to a different conclusion to that reached in relation to the comparison of the two marks as they appear, or would appear on the Register. The absence of the device element of the suit mark does not alter the essential feature of the mark which remains the word “newstar”. I find as a fact that there is no deceptive similarity between the two marks in this comparison.

*“Winstar” v “Newstar & Device” as the Former Appears, and the Latter Would Appear on the Register*

55. When the two marks are compared as they would appear in the Register, even allowing for imperfect recollection, the first impression left is that they are marks with a significantly different appearance. This is attributable to the device element of the suit mark together with its italicized typeface. I must consider the marks as a whole, and in so doing, I find as a fact that the device element of the suit mark is sufficiently prominent to avoid any tangible danger of confusion in this comparison.

“Winstar” v “Newstar & Device” as Both Would Appear in Notional Use

56. In normal and fair use, both marks may be applied to the goods, or some of them, by a process other than printing. In the case of production by plastic injection moulding, assuming the trade mark and the rest of the body of an adaptor, for example, are in the same colour, the distinctiveness of the different typefaces may be less apparent. In my judgement, however, even bearing that factor in mind, there is no reason to suppose that the dissimilarity between the marks detailed above, particularly the effect of the device element of the suit mark, would be marginalised by notional use in the broad sense.

57. To conclude my consideration of notional use by the applicant, I turn to consider the suit mark as it is in fact used. In advertisements and invoices, the suit mark is faithfully reproduced, whilst on goods the device element has been omitted. The omission of the device element may have gone beyond use which could be considered as normal and fair, a matter upon which I need make no finding, for it is clear that having so used the suit mark upon goods, the applicant must submit to that use forming the basis of this comparison. The comparison thus becomes one of the two 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 R.P.C. 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 must 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. Both marks are seven-letter conjoined words comprising of a three letter prefix to the common element “star”. Both prefixes are meaningful words in their own right. They have completely unrelated meanings. Within the prefix, both share the letter “W”, albeit in a different location within the prefix. This does however have a slight bearing as a cursory glance at both words could lead the eye to match the five common letters of the seven letter words and mistakenly conclude they are the same.

60. Aurally I find they are quite dissimilar. The non-common element of the words appear at the beginning of the words, so that the natural tendency to slur or under-emphasise the termination of words is not a consideration. Each prefix is a full syllable and thus unlikely to receive less prominence in pronunciation than the common element. I have tried to mispronounce the words, but have been unable to achieve a similarity in sound by this process.

61. I have no evidence of how the respective goods would be sold. Would they be packaged, or sold without packaging? Would they appear on shelves from which a customer could select from other goods of the same description, or would they be fetched by a salesperson from stock stored in the back of a shop upon a spoken request? As Mr. Liao commented, there is no evidence that the competing goods are even sold through the same sales channels. Whilst agreeing with that observation, the criticism lies more with the applicant than the opponent, for it is for the applicant to establish there is no likelihood of

confusion. I conclude that I have insufficient evidence before me to draw any conclusions that might assist me from the circumstances of sale of the goods to which the marks are to be applied.

62. I turn now to consider the nature and kind of customer who is likely to buy those goods. There is a considerable overlap in the range of goods to which the two marks will be applied. They are not specialized goods that are sold only to professionals, nor are they high ticket items that would attract careful purchaser examination. This is apparent from the various invoices exhibited. The ultimate purchasers of the goods will be ordinary members of the public, and judging from the evidence of the sales volumes, a substantial number of the purchasing public will be exposed to these goods. They are not items which are purchased on a frequent basis as would be the case with supermarket commodities. They are not goods which would be placed on display by the purchaser so that their detailed features would become instantly identifiable. Imperfect recollection of the precise brand name of the product could thus be a factor here. But for what follows, these considerations assist the opponent.

63. In addition to these general considerations however, a number of specific rules have been suggested by the authorities which are relevant to my consideration. The first is best exemplified in *Coca-Cola of Canada v Pepsi-Cola of Canada* (1942) 59 R.P.C. 127. This case, though an infringement case decided under the provisions of the Unfair Competition Act of Canada, is nevertheless a decision of the Privy Council and is highly persuasive. The principle propounded therein is, that where both marks have a common element, it is the different element that would remain in the average memory. In *Broadhead's Application* (1950) 67 R.P.C. 209, the Court of Appeal approved the principle and applied it to section 12 (our section 20) considerations in the following terms:-

“..where you get a common denominator, you must, in looking at the competing formulae, pay much more regard to the parts of the formulae that are not common— although it does not flow from that...that you must treat the words as though the common part was not there at all.”

64. I take the last sentence as confirming the general principle set out in *Bailey's Trade Mark* (“*Erectiko*”) (1935) 52 R.P.C. 136 that the mark must be taken as a whole and not be divided up so as to seek to distinguish a portion of it from a portion of the other word.

65. Another rule with a similar effect is that, when an element of the mark is common in the trade, as the word “star” appears to be (see below), and the only resemblance between the two marks is the common part, one cannot say that the owner of one has taken anything which is peculiar to the other. The cases relied upon by *Kerly* for this rule are “passing-off” cases, and the editors also caution that the approach is hardly suited to a comparison of word marks. I take these cautionary points into consideration.

66. The third special rule is that if the opponent is the proprietor of a series of marks, registered or unregistered, having the common element, this can often be fatal to the application, as a member of the public may be caused to wonder whether the applied for mark is not another in the series and from the same source as the other marks. The strength of this evaporates however when there is no commonality of proprietorship of the various marks in the series.

67. Annexed to the Statutory Declaration of Mr. NG are numerous trade references to traders of electrical and electronic goods, all trading under the style of a company which contains “star” in the title. There are a great number of these. Also annexed are various registered trade marks in which the common element of “star” is present. Mr. Liao concedes that not all of these companies can be said to be trading in the same description of goods as those of the opponent. Some however do. “CellStar” includes in its range of goods covered by the registration, batteries and battery chargers. “Penstar” deals with Hi-fi stereo apparatus; audio. “Soundstar” deals in radios. “CITYSTAR” has an extensive overlap of goods; “Aistar” includes radio apparatus; “Prostar” covers power supply apparatus, and “Bestar” covers electronic components in class 9. They are all owned by proprietors other than the opponent and all registrations pre-date the application of the suit mark. Mr. Ling submits that, without evidence of use, such registrations have little evidentiary value. Having searched through the advertisements, I take Mr. Ling’s point. Those companies that appear in both sets of exhibits are not those involved in the manufacture of goods of the same description, and I therefore place little weight on this evidence. That does not mean to say however that I am placed in a straitjacket by the evidence filed and must disregard my own knowledge of local conditions. The popularity of the word “star” in the trade names of traders involved in the electrical appliance, electronics and telecommunications field is well known to the local community. I am looking here at the narrow issue of whether the proliferation of “star” marks with different proprietors substantially reduces the likelihood of the ordinary purchasers associating a new star mark (in fact “NEWSTAR”) with the opponent to the exclusion of other traders.

68. Taking all of these matters into consideration, in my judgement, there is no real likelihood of deception and confusion among a substantial number of persons, even if the applicant continues to use its mark without the device element, in respect of the goods covered by its proposed registration. In reaching this conclusion I have taken into account all of the factors referred to above and balanced them carefully. In the final analysis, both words contain the common element of “star” as the second syllable. I am bound by authority to pay more regard to the element that is not common, without falling into the trap of dissecting the word and overlooking the whole. In this context, my earlier finding of aural dissimilarity is important. I cannot disregard local conditions in which the use of “star” in trade names is very common. With no evidence of a monopolistic proprietorship of “star” marks as a series in the hands of the opponent, I do not believe that a number of persons will be caused to wonder whether it might be the case that the two products come from the same source. In fact this commonality of “star” marks would focus a purchaser’s attention on the unique element of the words. I accordingly find as a fact that there is no reasonable likelihood of confusion if the opponent’s mark is normally and fairly used for all the goods covered by its registration and the applicant uses its proposed mark normally and fairly, or as it has done, for all the goods covered by the application in question. I find the applicant has defeated the opposition under section 20.

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

69. It is well established that the test to be used in applying section 12(1) is that stated by Evershed J. in *Smith Haydens & Co.’s Application* (1946) 63 R.P.C. 97 at 101, modified by Lord Upjohn in *Bali’s Trade Mark* [1969] R.P.C. 472 at p. 496. The test under section 12(1), adapted to this application, is as follows:

‘Having regard to the user of the “WINSTAR” and “star & device” marks, is the Registrar satisfied that “NEWSTAR & Device”, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?’

70. The test in essence is the same as the section 20 test save that opposition is not dependent upon having the confusingly similar mark on the Register; and the comparison to be made is between the opponent’s actual use of its mark and the applicant’s proposed mark in notional use.

71. For reasons that I shall elaborate shortly, I have no evidence of how the opponent actually used its mark “WINSTAR” and “star & device” at the relevant time. Insofar as those marks are concerned, the findings made under the section 20 opposition must therefore apply equally to the section 12(1) opposition.

72. I am obliged also to consider the unregistered “SUPERSTAR” mark, a representation of which can be found in paragraph seven hereof. By reason of the insertion of the word “SUPER” into the device, this mark is even further removed from a “star & device” mark connoting a bright “new” star. It follows that I find no deceptive resemblance between this mark and the suit mark.

73. I said earlier that there was no evidence of how the “WINSTAR” and “star & device” mark were used at the relevant date. This is because all copies of advertisements exhibited by the opponent depicting the opponent’s goods post-date the application date. Invoices from Golden Edge Enterprises Ltd. pre-dating the application date are in evidence. The letterhead of these depicts a “WINSTAR” mark preceded by a device. This was the way Madam WU declares the goods were marked at the time. Mr. Ling however submits I am not entitled to draw the inference from the invoice letterheads that the goods were also marked in like manner. Having seen that the applicant has not marked its goods in the same manner as its mark appears on its invoices, I am prepared to accede to this submission, leaving me with no evidence of the opponent’s actual use of its marks.

74. My findings contained in paragraphs 71 and 72 hereof dispose of the opposition under section 12(1) based on deceptive resemblance. There is however a second limb to section 12(1) (disregarding for the purposes of this judgement the further barriers to registration namely, being contrary to law or morality or any scandalous design which do not arise on the facts) with which I must deal. I should also say that there was argument addressed to the issue of whether the opponent had proved it had acquired sufficient reputation in its marks to be entitled to mount an opposition under this head at all. The argument is based on the generally accepted principle that before an opposition can be mounted under section 12(1), the opponent must establish that it has acquired a reputation in its mark in Hong Kong as at the date of the application to register the suit mark. The difficulty in this case arises by reason of the fact that the opponent, that is Golden Profit Limited, on its own evidence, has never traded in either the “WINSTAR” or the “star & device” marks. All trading in those marks, at the relevant time, was through Golden Edge Enterprises Ltd. The question then is, can the reputation, if any, acquired by Golden Edge Enterprises Ltd. inure for the benefit of the opponent for the purposes of mounting an opposition under section 12(1)?

75. As interesting as the point is, and I am grateful to counsel for their research on the issue, I find that I am not required to decide the point for reasons that follow.

76. The second limb of the section 12(1) opposition relates to disentitlement to protection in a court of justice. As I understand Mr. Ling, the sole plank for this ground is the purported breach of the duty of fidelity by Madam WU. I have already found that I do not regard that the communication to Madam WU of the “idea”, if it in fact occurred, and occurred in circumstances of confidentiality (of which there is no evidence) was of such consequence as to require protection appropriate to a trade secret. That being so, no duty of fidelity was owed after Madam WU terminated her employment. It follows that the suit mark would not be disentitled to protection in a court of justice.

77. The applicant has accordingly defeated the opposition under section 12(1).

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

78. There is no authority for the proposition that the opponent’s proprietorship of similar marks disentitles the applicant from claiming proprietorship of the suit mark, as the section 13(1) opposition is pleaded. The contrary would appear to be the position in law. In *Mila Schön Group SpA v Lam Fai Yuen* [1998] 1 HKLRD 682, after reviewing a number of Australian decisions, Recorder Kotewall S.C. concluded that a claim to prior proprietorship was only open in respect of an identical mark to the suit mark. The section 13(1) opposition, as pleaded, is misconceived.

79. However despite the inadequacy of the pleadings, an opposition under section 13(1) can be mounted if a ground, though not specifically pleaded, has been supplemented by the evidence. Mr. YU asserts in his statutory declaration, to be the inventor of a “NEWSTAR” mark. This ground of opposition can accordingly be restated as: “since the opponent invented the suit mark the applicant cannot claim to be the proprietor thereof.”

80. I have touched upon, when dealing with the interlocutory application, the question of proprietorship. I accept what Mr. Ling says, namely, that at the relevant date, there had been no use of the “NEWSTAR” mark by either the applicant or the opponent. Who has the better right to proprietorship must therefore be determined in the light that the mark is “unused”. The Ordinance is silent on that point. The position at common law was summarised by Morritt L.J. in *Al Bassam Trade Mark* [1995] R.P.C. 511 at page 524 thus: “.in the case of an unused mark the person with the best right to use it was the designer or inventor.” The citation for that principle was *Hudson’s Trade Mark* (1886) 3 R.P.C. 155 at pages 160 and 163. When one turns to *Hudson* however, the principle is not expressed in such simple language, and the comments are *obiter dicta*. *Hudson* was concerned with the question whether the Act of 1875 (which introduced for the first time the right to register a trade mark), fundamentally changed the law by extending the category of signs which could be regarded, in law, as trade marks. By enabling not only the registration of existing marks, but, by its language, introducing a new category of mark that could also be registered (the forerunner to our present section 9), it extended the definition of a trade mark to include previously unused marks. The Court concluded that this was indeed the effect of the 1875 Act, but the question of who was best entitled to register such unused marks was a peripheral issue that did not require a finding. The *dicta* was simply part of the analysis that was necessary to find the true meaning of the Act by an analogical process. The judges dealt

with the proprietorship point thus: Fry L.J. —“Therefore, although not without hesitation, and not without difficulty, I come to the conclusion that the true meaning of the Act was to enable a person who had invented a trade mark, which had not previously been used by some other person, to obtain registration of that trade mark and to treat its being on the register as evidence of public user or equivalent to public user.”

81. Cotton L.J dealt with the meaning of section 5 of the 1875 Act in this way:

“It is said that the difficulty is this; —Is a man to be considered as entitled to the exclusive use of any trade mark when he has never used it at all? That is a difficulty, but then, I think, the meaning is this: —If a man has designed and first printed or proposed, or framed, any of those particular and distinctive devices which are referred to in the first part of section 10 (the forerunner to our section 9), he is then looked upon as the proprietor of that which is under that Act a trade mark, and this will give him the right as soon as he registers it. How can it be said that he is entitled to the exclusive use of it when he never has used it? In my opinion, though the language is not appropriate, it means this, that a man who designs —no one else having used it— one of these special things pointed out in section 10, as designer he is to be considered as the proprietor of it; and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to that mark, then he is to be considered as entitled within the meaning of the Act to the exclusive use of that which in fact has never been in any way used, but which has been only designed by him, and which he can be treated as the person entitled to register (if no one else has so used it, as that his user would be interfered with by registration), so that no one else can say “Although you pretended to have designed this, in fact, as you well know, it was my design which you took from me.””

82. What Cotton L.J was envisaging, it seems to me, was something more than merely coming “to an idea of developing a new mark under the same feature of “star” in early 1983”, then doing nothing further to reduce the idea to some material form by, for example, designing the graphical appearance of the mark as it might be submitted to the Registrar. The need to assert a right to the mark has been referred to in more recent cases, but I shall mention only one, namely *Maxim’s* (supra) at page 298. I find therefore that whatever rights the opponent (or Mr. YU) may have had in the idea, the subsequent inactivity to perfect title necessarily means that those rights had lapsed by the relevant date. I find that the applicant had the right to claim to be entitled to claim proprietorship of the suit mark and it therefore follows that the applicant has defeated this ground of opposition.

#### **4. Under section 2(1), 9 and 10**

83. There is no evidence to support the ground that the suit mark denotes the goods of the opponent. It was conceded by Mr. Ling that the opponent has never used the mark on goods. I add that it had not advertised the mark before the relevant date either. This ground is entirely unsustainable. The second half of the opposition under section 2(1) is that the suit mark is not capable of indicating a trade connection between the applicant’s goods and the applicant. Quite properly, Mr. Ling did not seek to advance this ground at the hearing. Clearly the applicant proposed to do precisely that by registration and his subsequent use of the mark on its goods. I need say no more before rejecting this ground of opposition. The applicant has defeated the opposition under section 2(1).

84. The Registrar did not allow the application to proceed under section 9 for reasons I have already set out. It follows that the opposition under section 9 is misconceived.

85. The Registrar found that on a *prima facie* basis the mark was inherently capable of distinguishing the goods of the applicant from similar goods of other traders. I see no reason to reverse that decision and accordingly the applicant has defeated the opposition under this ground also.

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

86. The exercise of discretion pursuant to section 13(2) arises when opposition under sections 12(1) and 20 fail and the mark is acceptable for registration under either section 9 or 10. I remind myself that the Register has been created by the Ordinance for the purpose of enabling marks to be entered therein. If no proper reason can be advanced as to why registration should be refused for a qualifying mark, the exercise of discretion should not be adverse to the applicant. I have found no proper reason to refuse registration in the exercise of my discretion and accordingly order that the registration of the applicant's mark "Newstar & Device" may proceed.

### *Costs*

87. 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 pay the costs of these proceedings.

88. 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, unless otherwise agreed between the parties.

(K S Kripas)  
p. Registrar of Trade Marks  
11 February 2000