

Application No. 15199 of 1994

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

AND

IN THE MATTER of an application by Chan Chun Fai trading as Hong Kong Karate-Do Gojukai Honbu to register the mark



in Part A of the Register in Class 41

AND

IN THE MATTER of an opposition thereto by Lau Wai Kwong trading as Karate-Do Goshin-Kan and Ho Kai Hang trading as International Karate-Do Gojukai Association

**DECISION
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on 13 November 2001.

Appearing : Mr. Gary Kwan instructed by Messrs. Johnson, Stokes & Master for the applicant.

_____Mr. Robert Whitehead, SC and Mr. Matthew Chan instructed by Messrs. W. K. To & Co. for the opponents.

Application for Registration

1. On 21 December 1994 (“the relevant date”), Chan Chun Fai trading as Hong Kong Karate-Do Gojukai Honbu (“the applicant”) applied to register, pursuant to the provisions of the Trade Marks Ordinance (“the Ordinance”), in Part A of the Register in Class 41, the trade mark, a representation of which appears below :



(“the suit mark”).

2. The services intended to be covered by the registration were : “education, training, entertainment and club services relating to karate-do; organising of competitions, sporting and cultural activities relating to karate-do; all included in Class 41” (“the specified services”). The Registrar of Trade Marks (“the Registrar”) accepted the mark for registration on evidence of use under section 9(1)(e) of the Ordinance subject to the disclaimers of the Chinese characters “剛柔流” meaning “Gojuryu” and “空手道” meaning “karate-do”. The application was advertised in the Government of the Hong Kong Special Administrative Region Gazette on 24 April 1998.

Notice of Opposition

1. On 22 June 1998, Lau Wai Kwong trading as Karate-Do Goshin-Kan (“the 1st opponent”) and Ho Kai Hang trading as International Karate-Do Gojukai Association (“the 2nd opponent”) filed notice of opposition to the application. The grounds of opposition, in essence, state that the 1st opponent has carried on the business, since 1989, of operating a karate-do (空手道) training group under the name of Goshin-Kan (罡心館). The 2nd opponent is affiliated or related to the 1st opponent and provides training and management support to the 1st opponent in operating Goshin-Kan. Goshin-Kan provides education training, entertainment and club services relating to karate-do, practising the Gojuryu style (剛柔流) of karate-do. It was set up in 1987 initially to provide karate-do training to students at the University of Hong Kong. All the members of the Goshin-Kan are members of the governing body of International Karate-Do Gojukai Association (“IKGA”) in Tokyo, Japan. The president of IKGA is Mr. Goshi Yamaguchi of Japan. The official emblem or trade mark of IKGA is a clenched fist insignia which appears in all or substantially all of IKGA official publications including membership cards of or issued to its members and grading certificates issued to its members who took part in its grading examinations. A representation of the mark appears below :



(“IKGA mark”).

4. The opponents further state that IKGA mark was designed and first used in 1930's in his karate-do school by Mr. Gogen Yamaguchi (the late father of Mr. Goshi Yamaguchi) who was the founder of All Japan Karate-Do Federation and IKGA. The IKGA mark is now the exclusive intellectual property of Mr. Gosei Yamaguchi who is the elder brother of Mr. Goshi Yamaguchi. The 1st and/or 2nd opponents have been, with the consent of Mr. Goshi Yamaguchi, Mr. Gosei Yamaguchi and IKGA, using a clenched fist insignia which is identical or substantially similar to or nearly resembles IKGA mark since about 1987 by applying it to posters, leaflets, pamphlets, membership cards of IKGA, banners, seminar brochures, T-shirts, jackets, badges and stickers for the purpose of identifying the opponents' business in providing karate-do training as being of the Gojuryu style. Specifically :

(a) Under sections 2(1), 9 and 10 of the Ordinance

The IKGA mark has for many years been adopted and used to denote karate-do training and to signify Gojuryu style of karate-do by various associations or organisations, schools and clubs worldwide which provide karate-do training. In Hong Kong the IKGA mark is, and has been for many years, used and adopted by all those karate-do schools, associations, organisations and clubs that practise Gojuryu style of karate-do and are connected with IKGA or All Japan Karate-Do Federation. Therefore, the suit mark does not indicate to the trade or the public that the services associated with the suit mark originate from or are controlled by a single source; that is to say, the suit mark is not distinctive of the applicant's services in Hong Kong. Further and/or alternatively, the suit mark as a whole is descriptive and indistinctive. It consists exclusively of a sign or indication to designate the kind, intended purposes and character of the applicant's services in providing karate-do training contrary to section 9(1)(d) of the Ordinance. The suit mark (being identical to or nearly resembling IKGA mark) is customary in the current language and graphic expression of karate-do, indicating karate-do training and/or the Gojuryu style of karate-do training. It has thus become generic.

(b) Under section 12(1) of the Ordinance

The suit mark is deceptive in that it implies a connection between the applicant and All Japan Karate-Do Federation or IKGA or alternatively an association of the applicant's services with All Japan Karate-Do Federation's or IKGA's

official approbation, thereby suggesting a false trade origin and/or trade connection. The applicant's application would be disentitled to protection in a Court of Justice and it would be inequitable for the applicant to obtain registration of the suit mark.

(c) Under section 13(2) of the Ordinance

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

Counter-Statement

5. On 25 November 1998 the applicant filed his counter-statement. In essence, the applicant :

- (a) denies each and every allegation in the notice of opposition;
- (b) avers the following :
 - (i) The applicant was set up in Hong Kong in 1964 by Mr. Harada Sosogu who was a Japanese national living and working in Hong Kong at the time. The applicant has adopted and used the suit mark in relation to its services since 1966.
 - (ii) The applicant has affiliated itself to All Japan Karate-Do Gojukai, which subsequently changed its name to Japan Karate-Do Federation Gojukai. The applicant has organised a number of events including international tournaments in Hong Kong.
 - (iii) Mr. Gogen Yamaguchi was one of the members of a karate-do club founded in Ritsumeikan University in Japan in 1935. All Japan Karate-Do Gojukai was set up in or around 1950 with Mr. Gogen Yamaguchi as the president. In 1972, All Japan Karate-Do Gojukai was re-organised and changed its name to Japan Karate-Do Federation, Gojukai ("J.K.F. Gojukai"). Mr. Gogen Yamaguchi continued to be the president until 1974. Mr. Gogen Yamaguchi was thus well aware of the adoption and use of the suit mark by the applicant. No objection either oral or written has ever been raised by Mr. Gogen Yamaguchi or any other party. After Mr. Gogen Yamaguchi left J.K.F. Goju-kai, the applicant has continued to be affiliated to J.K.F. Gojukai and has used the suit mark.
 - (iv) J.K.F. Gojukai is one of the main supporting bodies of Japan Karate-Do Federation and is the Japanese national body of karate-do activities. J.K.F. Gojukai is the only official federation which can send members to

represent Japan in international games and is the only organisation recognised by the Organisation of World Karate Union which is the official member of the Olympics.

- (v) Both the 1st and 2nd opponents were former members of the applicant as early as 1980. They are well aware of the applicant's adoption and use of the suit mark.
 - (vi) The applicant is the true proprietor of the suit mark in Hong Kong. In Hong Kong, all of the goodwill and reputation in the suit mark accrued at common law solely to the applicant. No objection has ever been raised by the opponents or any party to the adoption and use of the suit mark by the applicant and there has been no incidence of confusion among the public. The legitimate freedom of the opponents and other traders or service providers or proprietors in Hong Kong would not be unfairly prejudiced by the registration of the suit mark; and
- (c) seeks the dismissal of the opposition with costs.

Evidence

6. The opponents' evidence consists of :

- (a) a statutory declaration dated 19 May 1999 from Lau Wai Kwong, the 1st opponent, together with exhibits, filed pursuant to Trade Marks Rule 25 ("Lau's first statutory declaration"); and
- (b) a statutory declaration dated 3 August 2000 from Lau Wai Kwong together with exhibits, filed pursuant to Trade Marks Rule 27 ("Lau's second statutory declaration").

7. The applicant's evidence comprises a statutory declaration dated 21 January 2000 from Takahashi Satoshi ("Mr. Satoshi's statutory declaration"), the Shihan and Chief Instructor of the applicant, together with exhibits, and a statutory declaration dated 25 January 2000 from Chan Chun Fai ("Mr. Chan's statutory declaration"), the applicant, together with exhibits, filed pursuant to Trade Marks Rule 26.

8. I shall in the course of this decision refer to the relevant extracts from these statutory declarations where necessary. I shall also assess the evidence on its own merits in the light of the submissions of both parties.

9. At the hearing, it was raised that both parties' evidence contains hearsay. It was agreed between counsel that they would not challenge the admissibility of each other's evidence on the ground that it is hearsay. It is for me to decide the weight that should be attached to the admissible hearsay evidence.

Preliminary Point

10. On 9 November 2001, the applicant sought leave from the Registrar to file a statutory declaration of Rosita Yee Man Li ("Miss Li's statutory declaration") pursuant to Trade Marks Rule 28. By seeking leave to file Miss Li's statutory declaration, the applicant purported to rectify some errors in the exhibits to Mr. Chan's statutory declaration. The exhibit which should have been marked "CCF-34" had inadvertently been marked "CCF-35" and the exhibit which should have been marked "CCF-35" had inadvertently been omitted. The letter originally marked exhibit "CCF-34" was included in error. Further, although it was referred to in paragraph 32 of Mr. Chan's statutory declaration, a copy of the applicant's poster had inadvertently been omitted from exhibit "CCF-32". A copy of Miss Li's statutory declaration together with the exhibits were sent to the opponents' agent before the hearing and it was agreed between the parties that the application under Trade Marks Rule 28 be heard as a preliminary matter at the hearing on 13 November 2001.

11. At the hearing, counsel for the opponents indicated that the opponents would not oppose the application under Trade Marks Rule 28. Leave was granted to the applicant to file Miss Li's statutory declaration lodged with the Registry on 9 November 2001.

Decision

Background

(A) History of Gojuryu (剛柔流) Karate-Do (空手道)

12. There are four main schools of karate-do which are practised in the world. These four schools or ryus as they are known in Japan, are Shitoryu, Wadoryu, Gojuryu, and Shotokanryu. Each school has its own merits and is unique in its own way (see page 686 of the applicant's bundle). Gojuryu Karate was founded by Mr. Chojun Miyagi (宮城長順) (see pages 16, 93, 269 of the applicant's bundle and pages 12 and 17 of the opponents' bundle). "Go" means hard, and "Ju" means soft, hence Gojuryu is translated as "hard and soft way".

13. Mr. Gogen Yamaguchi (山口剛玄) was a disciple of Mr. Chojun Miyagi. Mr. Gogen Yamaguchi was the founder of All Japan Karate-Do Gojukai (全日本空手道剛柔會) ("AJKG") which was formed in 1950 (see paragraph 4 of Mr. Chan's statutory declaration and page 39 of the opponents' bundle). "Gojukai" (剛柔會) refers to associations practising or training in the Gojuryu style of karate-do. AJKG was an organisation formed for the promotion of the Gojuryu style of karate-do. Mr. Gogen Yamaguchi was the first president of AJKG.

14. Literature produced to me by the opponents (see page 12 of the opponent's bundle, The Karate Dojo by Peter Urban) shows that each system of karate has its own symbol. The insignia by which the Gojuryu style of Japan is recognised is the clenched hard fist, a representation of which is reproduced below :



1. The clenched hard fist was modeled after the right fist of Mr. Chojun Miyagi. The opponents allege that the clenched hard fist was designed by Mr. Gogen Yamaguchi and first used in the early 1930's by the karate club he founded at Ritsumeikan University (see paragraph 8 of the grounds of opposition, paragraph 11 of Lau's first statutory declaration and page 20 of the opponents' bundle). In paragraph 5 of Mr. Chan's statutory declaration, the applicant asserts that the same clenched hard fist was used by AJKG since its establishment in 1950 until 1972 when the society was reformed. In 1972, AJKG was reformed and renamed as Japan Karate-Do Federation Gojukai (全日本空手道連盟剛柔會) ("JKF Gojukai") with Mr. Gogen Yamaguchi chosen as the first president. However, there were differences among the internal management of JKF Gojukai. In February 1974, Mr. Gogen Yamaguchi was expelled from JKF Gojukai. However, JKF Gojukai had been using the same clenched hard fist until 1992 when it (acting through one Mr. Motomasa Mayama) obtained a trade mark registration in respect of the mark reproduced below in Class 41 under Registration No. 3183810 in Japan :



16. Apart from AJKG and JKF Gojukai, Mr. Gogen Yamaguchi also established International Karate-Do Gojukai Association (IKGA) (see page 39 of the opponents' bundle) and became its president in 1965. The official emblem or trade mark of IKGA is the same or substantially the same clenched hard fist as that used by AJKG and JKF Gojukai before and after 1992.

(B) Applicant's Background

17. The applicant was set up by Mr. Harada Sosogu in Hong Kong in about 1964. The applicant asserts, in paragraph 4 of Mr. Chan's statutory declaration, that since its formation, it has been acting as the sole representative office of, first AJKG, and then JKF Gujukai after the reorganisation of AJKG in Hong Kong and was authorised to use AJKG's clenched hard fist from its formation and then the suit mark. A copy of a certificate of authorisation was produced (see page 69 of the applicant's bundle). The exhibit on page 69 of the applicant's bundle is a copy of the certificate issued by JKF Gojukai to the applicant dated 29 August 1992 which states as follows :

“We hereby certify that Hong Kong Karate-Do Gojukai represents Japan Karate-Do Federation Gojukai and also that the above was approved as the sole organisation for the overseas headquarters in your country.”

(C) Opponents' Background

18. The opponents were former karate-do students of the Hong Kong Karate-Do Gojukai when its Chief Instructor was Mr. Takahashi Satoshi who was also known as Mr. Takashikai (高橋戒). The 1st opponent has been trading as Karate-Do Goshin-Kan since 1987, operating a karate-do training group by the name of Goshin-Kan (罡心館). Goshin-Kan was first set up as an interest group by other karate-do masters who invited the 1st opponent to take up the operation of Goshin-Kan in 1987. With a view to providing better service and training to Goshin-Kan students, the 1st opponent invited the 2nd opponent to assist him and other karate-do masters in operating Goshin-Kan. The 2nd opponent registered with the Business Registration Office as International Karate-Do Gojukai Association. All members of the Goshin-Kan are members of the governing body of IKGA in Tokyo, Japan. By virtue of this, Goshin-Kan had adopted a clenched fist insignia which is identical or substantially similar to IKGA mark and the suit mark since about 1987.

19. For the sake of clarity, representations of AJKG mark, IKGA mark, JKF Gojukai mark and the suit mark are shown below side by side :



AJKG mark
("CCF-2")
(used from 1950 to 1992)



IKGA Mark/The Opponent's Mark
(paragraph 10 of Lau's first statutory declaration)
(used from 1965 to the present)



JKF Gojukai Mark
("CCF-6")
(used from 1992 to the present)



The Suit Mark
(used from 1994 to the present)

The main identifying feature in all the four marks is the fist device. The differences between the four fist devices are so minor that they are virtually identical. It is apparent from the background information above that all the four marks derive from the same source, that is, Mr. Gogen Yamaguchi who started to use the clenched hard fist to signify the Gojuryu style of karate-do in 1930's in Japan and who was the founder of AJKG, IKGA and JKF Gojukai.

Under section 2 of the Ordinance

20. I set out the relevant provisions as follows :

S.2(1) :

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

"trade mark relating to services" means a mark used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person.

21. Undoubtedly, the suit mark being a composite word and device mark falls within the definition of a "mark" under section 2(1) of the Ordinance. The next question for me is whether the mark is used or proposed to be used in relation to services for the purpose of indicating or so as to indicate a connection in the course of business between the services and the applicant.

22. Mr. Kwan contended that the suit mark has been used by the applicant, or alternatively, is proposed to be used by the applicant, to indicate a connection in the course of trade between it (including those branches or dojos that are connected with it) and its services. The objection under section 2 is misconceived. The applicant has made substantial use of the suit mark in Hong Kong before the date of application. It shows that the suit mark has been used alone, or it has been recognised as a trade mark or has a branding function. Random samples of

copies of the following documents were exhibited to Mr. Chan's statutory declaration as evidence of use of the suit mark in Hong Kong :

- (a) promotional pamphlets for various Hong Kong Karate-do Gojukai Championships organised by the applicant and held in Hong Kong in 1980, 1981 and 1988 bearing the suit mark (it should be the AJKG mark according to my observation);
- (b) the applicant's advertisements placed in various magazines in 1977, 1978, 1981 and 1983 featuring the suit mark (it should be the AJKG mark according to my observation);
- (c) a poster for the Gojukai International Karate-do Championship (Hong Kong) 1988 showing the suit mark (it should be the AJKG mark according to my observation);
- (d) instructor contracts made between the applicant and the Earnest Winkler Health Club of the St. James' settlement from 1989 to 1995 bearing the suit mark (it should be the AJKG mark according to my observation);
- (e) correspondence of the applicant from 1989 to the relevant date bearing the AJKG mark or the suit mark;
- (f) a certificate of participation issued by the applicant in relation to the goodwill tournament and training program which was jointly organised by the applicant and the Karate-Do Gojukai, India in 1992 featuring the suit mark (it should be the AJKG mark according to my observation);
- (g) an employment agreement signed on behalf of the applicant in 1970 bearing the suit mark (it should be the AJKG mark according to my observation);
- (h) circulars or announcements issued by the applicant to its members and the application form used by the applicant from 1986 to 1989 bearing the suit mark (it should be the AJKG mark according to my observation);
- (i) correspondence exchanged between the Commissioner of Police or the War Memorial Students' Union and the applicant in 1974 and 1976 bearing the suit mark (it should be the AJKG mark according to my observation);
- (j) application form dated 28 July 1977 and a contract of hire dated 30 August 1977 made between the Hong Kong Playground Association and the applicant for using the Southern and Macpherson Stadium showing the suit mark (it should be the AJKG mark according to my observation); and

- (k) lists of members who had taken part in the examinations conducted by the applicant in 1988 and 1989 bearing the suit mark (it should be the AJKG mark according to my observation).

23. Mr. Kwan submitted that the applicant has taught the public to recognise the suit mark as its trade mark and logo. The applicant and its services were recognised and identified by reference to the suit mark. The suit mark was recognised by other traders as the logo belonging to the applicant which shows that the suit mark was distinctive of the applicant and its services.

24. Mr. Whitehead for the opponents pointed out that the IKGA mark was designed by Mr. Gogen Yamaguchi, the founder of both AJKG and IKGA and first used in the 1930' s in his karate-do school. He submitted that the IKGA mark has always been regarded as denoting, or being descriptive of, the affiliation to the Yamaguchi school or Gojuryu style of karate-do. To illustrate this, I was referred to an extract from a book concerning karate-do entitled The Karate-Dojo, Traditions and Tales of a Martial Art by Peter Urban, printed in Japan in 1992 (page 12 of the opponents' bundle) which states :

“Each system of Karate has its own symbol. The insignia by which the Goju style of Japan is recognised is the clenched hard fist, an example of which is shown as the frontispiece of this book.”

25. The clenched hard fist displayed at the frontispiece of the book is the IKGA mark. Mr. Whitehead then referred me to page 4 of the exhibit marked “LWK-3” to Lau' s second statutory declaration which contains a copy of the magazine Traditional Karate, Volume 13, March 2000, the front cover, and from pages 20 to 25 concerning an interview of one Mr. Tony Childs, a senior karate practitioner in England. My attention was specifically drawn to page 22, the middle column where Tony Childs talks about the fist insignia, i.e. the IKGA mark. From the photographs in those pages taken of those wearing karate gear or training suits, the “fist” refers to what is shown as the badge at the left chest position on the karate gear upper garment – namely the IKGA mark. Tony Childs says that :

“The fist is the family crest, developed by Gogen Yamaguchi and this is what all the Yamaguchi Gojukai (IKGA) wear on their gi [i.e. gars]. When you wear it, you wear it with pride, knowing that you are part of the Yamaguchi family but when I look in the back of “Trad” [i.e. Traditional Karate, the magazine] I see many Goju adverts and they use this crest, this fist, yet they are nothing to do with Yamaguchi Gojukai. I believe they are using the crest because they feel it will give them authenticity ..when someone else wears your crest and goes somewhere and maybe behaves badly, it reflects on the true owners of the crest, it gives them a bad name.”

26. My attention was next drawn to page 16 of the applicant' s bundle which consists of a passage with the title ‘ Brief Introduction of Gojuryu Style of Karate-do’ exhibited by the applicant. Mr. Whitehead submitted that the IKGA mark is shown next to this title. The bottom part of the same page was separated by a solid line, below which brief information relating to five different Gojukai was published. Mr. Whitehead concluded that this shows that the IKGA mark has again been used to refer to “Gojuryu” style of karate-do.

27. It was pointed out by Mr. Whitehead that the IKGA mark has been used by Gojukai in various parts of the world. A copy extract of a brochure of the Karate-Do Gojukai World Tournament held in Japan in 1993 was produced by the opponents to show that the IKGA mark was used by the Japan Karate-Do Gojukai Association and International Karate-Do Gojukai Association. Copies of extracts of web pages from the Internet exhibited to Lau's first and second statutory declarations were also referred to to show that the IKGA mark is used by All Africa Karate-do Gojukai, Gojukai Karate-do Australia and International Karate-do Gojukai Association Canada.

28. Mr. Whitehead also referred me to the following exhibits to Mr. Chan's statutory declaration filed on behalf of the applicant in support of his submission that the IKGA mark has been used by Gojukai in various parts of the world to denote affiliation to the Yamaguchi school or Gojuryu style of karate-do :

- (a) brochure of the Gojukai International Karate-Do Championship, Singapore 1987 (except the Chinese characters “剛柔會” meaning “Gojukai” were used instead of “剛柔流” meaning “Gojuryu”, the mark used in the brochure by the Metropolitan YMCA Goju-Ryu Karate-Do Club, Singapore is identical to the IKGA Mark) (page 249 of the applicant's bundle);
- (b) photograph of the Australian contestant participating in the Gojukai International Karate-do Championship, Singapore 1987, Neville Klein, showed that he was wearing the IKGA mark on his karate suit (page 276 of the applicant's bundle);
- (c) compliments notice of Gi Toku Kai (技德會) in Japan placed in the brochure in paragraph (a) above showing a fist device virtually identical to the IKGA mark and words to associate Gi Toku Kai (技德會) with JKF Gojukai (page 323 of the applicant's bundle);
- (d) poster of the Federation of All Japan Karate-Do Organisations Gojukai in the brochure in paragraph (a) above bearing the IKGA mark or a closely resembling mark (page 341 of the applicant's bundle);
- (e) brochure of the Third International Tournament held on 25 February 1990 in Australia with the IKGA mark (page 343 of the applicant's bundle);
- (f) extract from the brochure in paragraph (e) above bearing the IKGA mark (page 366 of the applicant's bundle); and
- (g) extract from the brochure in paragraph (e) above showing karate-do training classes in Australia by members of the Australian Karate Association and of the All Japan Karate-Do Federation Gojukai and that the IKGA mark was used to denote affiliation of that particular Gojukai karate training class in Australia with the Gojukai in Japan (page 367 of the applicant's bundle).

1. As Gojukai all around the world do, Mr. Whitehead contended that the evidence of the 1st and 2nd opponents shows that Goshin-Kan (罡心館) have been using the clenched fist insignia identical to or nearly resembling the IKGA mark or the suit mark since about 1987 on posters, leaflets, pamphlets, membership card, banners, seminar brochures, T-shirts and jackets, badges and stickers for the purpose of identifying the fact that Goshin-Kan is practising the Gojuryu style of karate-do and is affiliated with the Yamaguchi family. Samples of the publicity materials have been exhibited with Mr. Lau's first statutory declaration (see paragraph 14 of the statutory declaration and pages 37-45 and 58 of the opponents' bundle).

30. Apart from the 1st and 2nd opponents, Mr. Whitehead submitted that other associations or organisations in Hong Kong have adopted the IKGA mark to signify their training and/or teaching of Gojuryu style of karate-do by using the mark extensively on their advertisement posters, leaflets, pamphlets, web-site homepage design, name chops, banners, official publications and souvenirs of joint-events and competitions between them and other similar organisations. According to paragraph 20 of Lau's first statutory declaration, the other associations or organisations include :

- (a) All Japan Karate-Do Federation Gojukai (Hong Kong Sei Wa Kai) (全日本空手道連盟剛柔會(香港誠和會)) which used the IKGA mark (it should be JKF Gojukai mark according to my observation) in a brochure distributed at the Karate-Do Super Champion Tournament organised by it and held on 17 December 1994 (see pages 41 and 42 of the opponents' bundle) and in an admission ticket for a karate-do tournament organised by it and held on 27 March 1994 (see page 64 of the opponents' bundle);
- (b) Seigokan (正剛會) which used the IKGA mark (it should be the AJKG mark according to my observation) in an advertisement leaflet of karate training by it for Junior Police Club members circulated in early to mid 1990s (see page 66 of the opponents' bundle);
- (c) 正武館香港道場 : an extract of a brochure for Kujekai Club '95 (橋治會盃 '95) Hong Kong Karate-Do Teams Invitation Tournament held on 16 July 1995 organised by Okinawa Gojuryu Karate-Do Kugekai was referred to in paragraph 20 of Lau's first statutory declaration. At page 2 of the brochure (see page 72 of the opponents' bundle) was an old photograph showing the famous Jojo Chief of Kugekai Mr. Lee Kam Kwan standing on the left and next to him was a big banner with a fist design substantially similar to the suit mark, the IKGA mark and the opponents' mark used by one " 正武館香港道場 ". Mr. Lau said that he knows Mr. Lee Kam Kwan personally. He was the chief instructor of all the karate-do dojos situated at various Correctional Services Institutions in the territory. The old photograph was taken sometime over 20 years ago in Hong Kong when Mr. Lee Kam Kwan's Japanese karate-Do master (standing on the right of the photograph) visited Hong Kong; and
- (d) Hong Kong Karate-do Ken Do Kai(香港空手道拳道會)which used the IKGA mark or a closely resembling mark (see the original exhibits marked "CCF-34" and "CCF-35" to Mr. Chan's statutory declaration).

31. Mr. Whitehead submitted that when one examines the evidence of use submitted by the applicant in relation to the suit mark or the IKGA mark, one will see that the suit mark or IKGA mark was also used by the applicant to denote affiliation with the Gojukai in Japan. In the exhibits of copies of letters, the names and the logos appearing in the letterhead of the applicant have changed, in approximate chronological sequence, as follows :

<u>Name and Mark in the Letterhead</u>	<u>Page numbers of applicant' s bundle</u> (Date of letter in brackets)
(1) Hong Kong Karate-Do Gojukai Association (without any mark on the letterhead, but with a stamp showing the IKGA mark)	485, 486, 487, 488, 489
(2) Hong Kong Karate-Do Gojukai Association (with the IKGA mark)	434, 435, 436, 437, 438, 439, 440, 441, 442, 443, 444, 445, 446, 447, 448, 449, 450, 452, 453, 454
(3) Hong Kong Karate-Do Gojukai Honbu (with the IKGA mark)	426, 428, 429, 430, 432, 433, 479 (25/11/1993), 480, 481, 482, 483, 484
(4) Hong Kong Karate-Do Gojukai Honbu (with the suit mark)	477 (2/8/1994), 478 (15/7/1994)
(5) Hong Kong Karate-Do Gojukai Honbu (with the suit mark) (with the name "The Overseas Headquarter of Japan Karate-Do Federation Gojukai")	455, 456, 457, 458, 459, 460, 461, 462, 463, 465, 466, 467, 468, 470, 471, 472, 473, 474, 475, 476 (18/11/1994)

It can be observed that in about mid-1994, the applicant has switched from the IKGA mark (it should be the AJKG mark according to my observation) to the suit mark (see pages 477, 478 and 479 of the applicant' s bundle). In late 1994, the letterhead of the applicant started to include the words "The Overseas Headquarter of Japan Karate-Do Federation Gojukai". The name and logo was changed to show the affiliation of the applicant to the JKF Gojukai. It was not done in connection with the course of trade. The duration of the applicant' s use of the suit mark was very short indeed before its application for registration dated 21 December 1994.

32. In reply, Mr. Kwan submitted that the Hong Kong Karate-Do Gojukai Association (Kowloon Branch) (香港空手道剛柔會 - 九龍分會), which is also known as Kowloon Karate-Do Gojukai (九龍空手道剛柔會), the Japan Karate-Do Federation Gojukai (Hong Kong Sei Wa Kai) (全日本空手道連盟剛柔會 - 香港誠和會) and the Hong Kong Karate-do Ken Do Kai (香港空手道拳道會) are and were at all material times members of the JKF Gojukai, of which the Applicant is the sole representative office in Hong Kong. Further, Kowloon Karate-Do Gojukai helped organise the Sino Japanese Martial Art Performance Competition

1992 which was hosted by the applicant organisation. This shows that the Kowloon Karate-Do Gojukai was part and parcel of the applicant. Thus the said dojos or branches or groups form part of and were connected with the applicant and their use of the suit mark was legitimate and lawful as they properly indicate the connection with the applicant. The applicant has granted its approval for the use of the suit mark (in both forms) by conduct.

33. Mr. Whitehead, on the other hand, pointed out that in paragraph 14 of the grounds of opposition, it was pleaded by the opponents that various other associations, organisations, clubs and dojos are using the IKGA mark in their business. In reply, the applicant in paragraph 13 of its counter-statement denies those facts and states in the alternative that he shall take appropriate action against those organisations to “protect its lawful rights, if necessary”. Mr. Whitehead indicated that the counter-statement was filed in 1998. He said that even by 1998, the applicant was threatening to take legal action against those other associations, organisations, clubs and dojos. The belated allegation by the applicant that those other associations, organisations, clubs and dojos are their sub-branches is incredible. He argued that in fact those other associations, organisations, clubs and dojos operated quite separately from the applicant as at the relevant date using the same or closely resembling clenched fist insignia to show affiliation with the Yamaguchi family or the Gojuryu style of karate-do.

34. Having considered the background and the evidence in this case as fully as I may, I find that the Gojuryu style of karate-do was founded by Mr. Chojun Miyagi. In order to promote the Gojuryu style of karate-do, Mr. Gogen Yamaguchi, being a disciple of Mr. Chojun Miyagi, founded a karate club at Ritsumeikan University in Japan and started to use a clenched hard fist to signify the Gojuryu style of karate-do in the 1930' s. Subsequently, Mr. Gogen Yamaguchi founded three different Gojukai (meaning associations practising or training the Gojuryu style of karate-do) in Japan to further promote the Gojuryu style of karate-do. AJKG, IKGA and JKF Gojukai were set up in Japan by Mr. Gogen Yamaguchi in 1950, 1965 and 1972 respectively. All three Gojukai have adopted and used the clenched hard fist (with very minor variations as illustrated in paragraph 19 above) to signify that they practise the Gojuryu style of karate-do.

35. With the spread of Gojuryu karate-do throughout the world, different Gojukai have been set up in various parts of the world including Hong Kong. As can be seen from the evidence, the AJKG mark, IKGA mark and JKF Gojukai mark, which are virtually identical to or closely resemble the suit mark, have been adopted and used by different Gojukai worldwide including Hong Kong to signify their practice of the Gojuryu style of karate-do and denote their affiliation with the specific Gojukai in Japan.

36. The applicant had used the AJKG mark in Hong Kong from 1970 to 1994. Since July 1994, the applicant has been using the suit mark. On the evidence, I find that the applicant first adopted the AJKG mark because it was affiliated with AJKG. In 1972, AJKG was re-organised and changed its name to JKF Gojukai. However, JKF Gojukai had been using the AJKG mark until 1992 when it obtained a trade mark registration in respect of the JKF Gojukai mark. In late 1994, the letterhead of the applicant started to include the words “the overseas headquarter of Japan Karate-do Federation Gojukai” and at the same time the applicant has switched from the AJKG mark to the suit mark. The suit mark is virtually identical with the JKF Gojukai mark (with the same flat base which is different from the ribbon base found in the AJKG mark or the IKGA mark). I accept the submission for the opponents that the change from the AJKG mark to the suit mark of the applicant was to show the change of affiliation of the applicant

from AJKG to JKF Gojukai. Although the applicant makes use of the AJKG mark or the suit mark, he does not, in my view, make use of them as a trade mark, that is to say so as to indicate the source or commercial origin of the services.

37. Furthermore, given that as at the relevant date, the opponents, other karate-do associations or organisations in Hong Kong or other countries have adopted the AJKG mark, the IKGA mark or the JKF Gojukai mark, which are virtually identical to or closely resemble the suit mark, to signify the training and/or teaching of the Gojuryu style of karate-do and their affiliation with the Gojukai in Japan, it is very difficult, if not impossible, for the applicant to argue that the suit mark refers to his services only and none other. In my view, the use of the suit mark or a closely resembling mark by any karate-do association or organisation in Hong Kong would convey to those who are interested in karate-do that the organisation or association is practising the Gojuryu style of karate-do. The prospective consumer of the services would not associate the suit mark with any particular karate-do organisation or association.

38. I do not accept the submission for the applicant that the other karate-do associations or organisations in Hong Kong were part and parcel of the applicant as at the relevant date and the use of the suit mark by them indicates their connection with the applicant. In paragraph 6 of Mr. Chan's statutory declaration, he said that the AJKG appointed the applicant as its sole representative office in Hong Kong and authorised the applicant to use the AJKG mark in Hong Kong. However, no evidence was filed in support of the said appointment and authorisation. The only authorisation produced is a copy of a certificate issued by JKF Gojukai to the applicant dated 29 August 1992 (see paragraph 17 above). Although the copy certificate was produced by the applicant, I cannot make any sense of the wording of the certificate, viz : "the above (the applicant) was approved as the sole organisation for the overseas headquarters in your country (Hong Kong)". As the evidence shows, the letterhead of the applicant started to include the words "the overseas headquarter of Japan Karate-do Federation Gojukai (JKF Gojukai)" from 18 November 1994 only (see paragraph 31 above). In fact, I find that the All Japan Karate-do Federation Gojukai (Hong Kong Sei Wa Kai) (全日本空手道連盟剛柔會) (香港誠和會) had not used the suit mark of the applicant. Instead, it had used JKF Gojukai mark to show its affiliation with the JKF Gojukai in Japan (see page 42 of the opponent's bundle). Similarly, the Kowloon Karate-do Gojukai (九龍空手道剛柔會) had used JKF Gojukai mark, not the suit mark of the applicant. In the poster on page 67 of the opponents' bundle, there was a reference under the name of Kowloon Karate-do Gojukai (九龍空手道剛柔會) which reads "(全日本空手道連盟會員、香港奧運會業餘空手道會會員、香港政府註冊非牟利團體)". The reference in English should read as "a member of JKF Gojukai, a member of the Hong Kong Olympics Amateur Karate-do Association, Hong Kong Government Registered Non-Profitable Organisation). There was no reference that it was a member of the applicant at all. Again, I find that the JKF Gojukai mark was used on the poster by the Kowloon Karate-do Gojukai to signify its affiliation with the JKF Gojukai.

39. I do not think the exhibits marked "RYML-1" and "RYML-2" attached to Ms. Li's statutory declaration serve to prove that the Hong Kong Karate-do Ken Do Kai (香港空手道拳道會) and the Kowloon Karate-do Gojukai (九龍空手道剛柔會) were part and parcel of the applicant. As to the exhibit marked "CCF-34", it only serves to prove that Mr. Chan Ping For and Choi Chi Ping decided to form the Hong Kong Karate-do Ken Do Kai and requested support from the president of the applicant. Regarding the letter dated 15 March 1995 exhibited in "CCF-35", the letter was sent by a group of experienced coaches of the Kowloon Karate-do

Gojukai (九龍空手道剛柔會) to the applicant. In the letter, the experienced coaches requested to join the applicant as full members.

40. As to the exhibit marked “CCF-33” attached to Mr. Chan’s statutory declaration, it is a letter of acknowledgement dated 21 January 2000 issued by the presidents of All Japan Karate-do Federation Gojukai (Hong Kong Sei Wa Kai) (全日本空手道連盟剛柔會) (香港誠和會) and the Kowloon Karate-do Gojukai (九龍空手道剛柔會) acknowledging that the two Gojukai “are (my emphasis) part of the Hong Kong Karate-do Gojukai Honbu”. In my opinion, even taking this piece of evidence to its highest, it serves to illustrate the relationship between the two Gojukai and the applicant as at the date of the letter, that is, 21 January 2000. It does not help to throw any light on the relationship between the parties as at the relevant date. It is interesting to note that again the mark shown on the letter of acknowledgement is not the suit mark. It is the JKF Gojukai mark.

41. In the exhibit marked “LWK-4” to Lau’s second statutory declaration, a pamphlet of Hong Kong Karate-do Ken Do Kai was exhibited. At the end of the pamphlet, there was a reference which states that “本會為：香港政府註冊非牟利團體，全日本空手道連盟會會員，香港業餘空手道總會會員”. The reference in English means that the Hong Kong Karate-do Ken Do Kai is a Hong Kong Government Registered Non-Profitable Organisation, a member of the JKF Gojukai and a member of the Hong Kong Amateur Karate-do Honbu. Again, there was no reference that the Hong Kong Karate-do Ken Do Kai is affiliated with the applicant. As to the use of the AJKG mark by Seigokan (正剛會) and the use of a fist design substantially similar to the suit mark by “正武館香港道場” referred to in paragraph 30 above, the applicant has not asserted that the two organisations were part and parcel of the applicant as at the relevant date.

42. With regard to the use of the IKGA mark, which closely resembles the suit mark, by the opponents in relation to the Goshin Kan (罡心館), the applicant said that the 1st and 2nd opponents were former members of the applicant and they had copied and misappropriated the suit mark from the applicant. However, the applicant has not contended that Goshin Kan (罡心館) was part of the applicant. I do not consider that the opponents have copied and misappropriated the suit mark. As analysed above, the clenched hard fist appearing in the AJKG mark, IKGA mark, JKF Gojukai mark and the suit mark all share the same source, that is, Mr. Gogen Yamaguchi who started to use the clenched hard fist to signify the Gojuryu style of karate-do in the 1930’s in Japan and who was the founder of various Gojukai practising the Gojuryu style of karate-do in Japan. The opponents are affiliated to the IKGA. They are entitled to use the IKGA mark to denote their connection and association with the IKGA.

43. Having taken into account all the above, I have come to the conclusion that the suit mark has not been used as a trade mark within the meaning of section 2 of the Ordinance. On the evidence, I find that the suit mark has been used to denote the affiliation to the Gojukai in Japan and the Gojuryu style of karate-do. It does not appear to have been used for the purpose of indicating a connection in the course of business between the specified services and the applicant.

Under sections 9 and 10

44. Should I be wrong in my decision under section 2 of the Ordinance, I proceed to consider the opposition under sections 9 and 10 of the Ordinance.

45. I wish to point out that although the Registrar has considered these two sections in relation to the suit mark at the ex parte application stage when processing the suit application, the Registrar is not bound by his previous view and/or decision. I have to decide the matter de novo based on the pleadings and evidence filed in the opposition proceedings and the submissions before me. The issuance of the leave to advertise does not assist the Applicant in any way.

46. As at the relevant date, the relevant provisions of section 9 of the Ordinance are as follows :

“(1) A trade mark (other than a certification 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;
- (b) the signature (in other than Chinese characters) of the applicant for registration or of some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means –

- (a) in the case of a trade mark relating to goods, adapted in relation to the goods in respect of which the trade mark is registered or proposed to be registered, to distinguish 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 connection subsists; or
- (b) in the case of a trade mark relating to services, adapted in relation to the services in respect of which the trade mark is registered or proposed to be registered, to distinguish services with the provision of which the proprietor 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.

- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which –
- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.”

47. As at the relevant date, the relevant 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.”

48. Mr. Whitehead submitted that the suit mark is descriptive and indistinctive of the applicant’s services. The 1st and 2nd opponents have been using the IKGA mark since about 1987. The suit mark and the IKGA mark are identical or substantially similar to or nearly resembling each other. Other karate-do schools, associations, organisations in Hong Kong and worldwide practising the Gojuryu style of karate-do have been using the IKGA mark. The IKGA mark is descriptive of the Gojuryu style of karate-do and has become generic.

49. I was referred to *Prince Sovereign and Device Trade Mark* [1989] 2 HKC 247 where Jones J. said :

“The question .. is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, ‘I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons,’ and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant’s chance of success in this respect must .. largely depend upon whether other traders are likely, in the 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.”

50. Mr. Whitehead contended that in the light of the evidence, the applicant has not adapted the suit mark to distinguish the provision of the specified services connected to him, because other associations or organisations, including the 1st and 2nd opponents, practising and/or teaching the Gojuryu style of karate-do have been using the IKGA mark to show affiliation to the Yamaguchi school, or the Gojuryu style of karate-do they teach or practise. Further, as the evidence has shown, the applicant has not adapted the suit mark to distinguish the provision of the specified services connected to him, because the history of the usage of the suit mark – in about mid-1994 in his letterhead – is shortly (or in relation to his services) before his application for registration dated 21 December 1994. If the suit mark is registered, other associations or organisations, including the 1st and 2nd opponents, would have to cease using the IKGA mark to show their affiliation, because of its near resemblance to the suit mark. Registration of the suit mark will therefore trespass upon the legitimate freedom of other traders, service providers or proprietors in Hong Kong.

51. Mr. Kwan submitted that the suit mark is inherently adapted to distinguish the services of the applicant from other traders. The fist device (including its base) is a simple and striking device. It is represented in a particular stylised form. It is a neutral device in itself and does not have any direct reference to karate activities. Karate is more recognised by the Hong Kong public by the use of karate kicks or the breaking of planks or other objects by the lateral side of a hand rather than by the use of a closed fist. It is equally suitable to use the fist device in respect of institutes teaching the Chinese martial art such as “Nam Kuen” (南拳), or those providing fitness training services or body guard or security guard services. It is also appropriate to use the fist device in respect of businesses providing anti-burglary or alarm system. The power suggested by the fist device would only have an indirect reference to the practice of kung fu, of which karate is only one example. But the particular form of representation of the fist device in the suit mark is adapted to denote the specified services of the applicant. The *Price Sovereign & Device Trade Mark* case (supra) was distinguishable from the present case. The suit mark there was a merely a pictorial representation of the goods (tennis racquets) and it was therefore not distinctive. Also, there was no evidence of use of the mark in that case.

52. Mr. Kwan went on to submit that the words “剛柔流空手道” are actually Japanese characters represented in Kanji (as the suit mark in the old form was first used by All Japan Karate-Do Gojukai, the applicant’s predecessor, in Japan). It is an unfamiliar use in Chinese as the general public in Hong Kong would be likely to use the term “剛柔派空手道” instead. Further, the general Hong Kong public would not be likely to know that there are different styles of karate,

let alone a particular style called “剛柔流”. They are likely to understand these words to form part of the motto of the applicant (similar to the words of wisdom which are usually incorporated into the emblems of schools or universities). The adaptability of the suit mark to distinguish is overwhelmingly supported by the opponents’ evidence. The opponents clearly and repeatedly argued that the suit mark (in its old form), which was copied by IKGA and the opponents to form the so-called “IKGA mark” and the “opponents’ mark” respectively, served as a badge or origin or an indicia of a connection in the course of trade with a particular source.

53. Mr. Kwan said that the suit mark as a whole is not descriptive of karate or the Gojuryu of karate. A reasonable man would not use the suit mark to refer to or describe karate or the Gojuryu of karate in their daily life. Instead, they would say or write the word “karate” or “Gojuryu” (or the Chinese equivalent “剛柔流”) in their daily communication. Mr. Kwan argued that the suit mark is not generic. Except the infringers, other organisations practising the Gojuryu or karate did not use the suit mark to refer to themselves or their activities. The logos of these organisations are very different from the applicant’s suit mark. The suit mark is therefore inherently adapted to distinguish and/or in fact adapted to distinguish the services of the applicant from other traders. The objection under section 9 is misconceived.

54. Mr. Kwan also argued that the suit mark is not common to the trade. Other traders (the Okinawa Gojuryu Karate-do Kugekai and 14 other organisations are quoted as examples) do not use the suit mark as their logos to denote themselves or refer to Gojuryu of karate. The alleged use of the suit mark by Seigokan is undated. It does not provide any assistance. Further, an isolated instance of unauthorised use of the mark would not make it common to the trade. The opponents still alleged that their copy of the suit mark is the exclusive property of Mr. Gosei Yamaguchi and that the opponents had to obtain the consent of Mr. Gosei Yamaguchi, Mr. Goshi Yamaguchi and IKGA to use the mark in Hong Kong. As such, the mark could not have been common to the trade. According to *Kerly’s Law of Trade Mark and Trade Names, 12th ed.* at p.126, para. 8-71 : marks have to be in common use in the trade with respect to the specified services; and “be open to the trade” to use before they would become “common to the trade”. Neither condition is satisfied here.

55. As regards the applicant’s argument that it is not correct to say that the public has come to use the IKGA mark to refer to Gojuryu style of karate-do and the applicant’s citation of the marks of the Okinawa Gojuryu Karate-do Kugekai and 14 other organisations as examples, Mr. Whitehead pointed out that the applicant has confused the distinction between the mark signifying the Gojuryu style of karate-do and the mark signifying the association or organisation itself. Display of the IKGA mark shows a connection to the Yamaguchi school or the Gojuryu style of karate-do, but there is no mandatory requirement that an association or organisation practising and/or training Gojuryu of karate-do must display the IKGA mark. Such association or organisation can have its own mark for the entity.

56. As I have found that the suit mark has been used to signify the applicant’s practising of the Gojuryu style of karate-do and to denote its affiliation with the JKF Gojukai in Japan, it follows that the suit mark is indistinctive for registration in Part A or Part B of the register.

57. In *Colorcoat Trade Mark* [1990] RPC 511, the applicant applied to register the trade mark COLORCOAT in part A of the register for “steel sheet and steel strip, all having a

coloured protective coating of plastics or of paint” in Class 6. Extensive evidence of use was filed. However, the Registrar refused the application on the ground that, although the mark was factually adapted to distinguish, it was not inherently adapted in law. The applicant appealed to the Secretary of State. The appeal was dismissed by Robin Jacob, Q.C. who observed at page 517 :

“..The Applicants seek a permanent monopoly in a very descriptive mark. Other traders may want to use the words colour coat or something similar. If they are not passing off I do not see why they should be put at risk of an infringement suit.

He pointed to many other traders’ brochures which do not use the words at all – using instead expressions such as “laminated”. Indeed he urged upon me that “colour coat” is not a natural description at all – one would say “painted” or “laminated” or the like. I cannot accept this. The burden lies on the applicant to justify registration: even one genuine example (such a H. H. Robertson) of descriptive use must be a conclusive answer that other honest traders may want to use the term.”

58. The fact that other karate-do associations, organisations or clubs in Hong Kong have used the suit mark or nearly resembling marks in relation to the specified services must be a conclusive answer that other honest traders may want to use the suit mark or a similar mark. On the evidence, I find that the suit mark or a closely resembling mark has been commonly used by other karate-do organisations, associations or clubs in Hong Kong providing education, training, entertainment and club services relating to karate-do and organising competitions, sporting and cultural activities relating to karate-do to signify their practising of the Gojuryu style of karate-do and to denote their affiliation with the respective Gojukai in Japan. The suit mark is therefore indistinctive and it should be open to free use by traders in general. The registration of the suit mark would prevent other associations or organisations from using the suit mark or a closely resembling mark for legitimate purpose and with proper motive to show their affiliation to the Gojukai in Japan and to denote the Gojuryu style of karate-do. It should be borne in mind that the test for registrability was not whether registration would impose an intolerable burden on traders who wished to use the mark, but whether they would merely be hindered or embarrassed in what they might legitimately want to do in the future. See *Colocoat Trade Mark* (supra).

59. As to the possibility of registration in part B of the Register under the terms of section 10 of the Ordinance, I take the view that the objections which preclude acceptance in Part A apply equally to Part B. As Lloyd Jacob J. remarked in the *TORQ-SET Trade Mark* [1959] RPC 344 at 346, lines 37-39 :

“Part B of the register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders.”

60. For the reasons set out above, I consider that the registration of the suit mark even in Part B of the register is likely to inconvenience other karate-do organisations, associations or clubs in Hong Kong who might legitimately wish to use the suit mark or a nearly resembling mark.

Under section 12(1)

61. At the hearing, Mr. Whitehead abandoned opposition under this section.

Under section 13(1) and section 33

62. Having decided the opposition under sections 2, 9 and 10, I do not think I need to consider the opposition under these two sections and go through the matters put to me in argument thereof.

Under section 13(2)

63. As the opponents have succeeded in the opposition under sections 2, 9 and 10, the exercise of my discretion under section 13(2) of the Ordinance does not arise.

Conclusion

64. The application to register the suit mark in Class 41 in part A of the Register in respect of the specified services fails.

65. I award the Opponents 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 High Court (Cap 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

Signed

(Ms Fanny Pang)
p. Registrar of Trade Marks
31 December 2001