

Trade Marks Ordinance (Cap. 43)

IN THE MATTER of an opposition by Mul-T-Lock Limited to the registration of trade mark application 6043/95 in class 7 by Guangzhou Light Industrial Products Import & Export (Group) Corporation to register the trade mark



DECISION

of

Teresa Grant acting for the Registrar of Trade Marks after a hearing on 18 June 2002.

Appearing : Mr Gary Kwan instructed by Li & Partners for the applicant for registration.

Guangzhou Light Industrial Products Import & Export (Group) Corporation ('the applicant') has applied for registration of a trade mark under the Trade Marks Ordinance. Mul-T-Lock Limited ('the opponent') opposes the application for registration under the Trade Marks Ordinance section 15.

The applicant's argument in the opposition was put to me at a hearing on 18 June 2002. The opponent did not attend the hearing but relies on its pleadings and evidence.

Applicant's mark

The applicant has applied to register the mark :



application number 6043/95 in class 7 for 'sewing machines and parts thereof'. The application for registration was filed on 20 May 1995.

Opponent's marks

The opponent relies on two registrations in Hong Kong :



MULTLOCK

263/82 for 'doorlocks' in class 6



1591/96 for 'locks (other than electric) of metal, lock bolts, door bolts, mortise locks, car transmission locks, keys and key blanks; bolts of metal; lock cylinders of metal; padlocks, hasps, chains of metal, key rings of metal, doors of metal; gates of metal; shutters of metal, door panels of metal; latches latch bars of metal; door closers and door openers (non-electric); safes (strong boxes); boxes of common metal; identity plates of metal; small hardware of metal; locksmith apparatus; parts and fittings for all the aforesaid goods' in class 6.

The date of application and registration of the opponent's registrations in Hong Kong is 7 December 1979 and 8 December 1992, respectively.

Grounds of opposition

The opponent opposes on a number of grounds under the Trade Marks Ordinance : sections 2, 9 and 10 (applicant's mark not distinctive as a trade mark); section 13(1) (applicant not entitled to be registered as proprietor); section 12(1) (applicant's application in bad faith); section 20 (applicant's mark nearly resembling opponent's marks registered in Hong Kong); section 23 (applicant's mark identical with or nearly resembling opponent's marks registered in country of origin); section 13(2) (applicant's application should be refused in exercise of registrar's discretion).

Section 20

The opponent's marks are registered in Hong Kong in class 6 (registration numbers 263/82, 1591/96). The opponent pleads section 20 in paragraph 9 of its statement of grounds in the notice of opposition. The ground of opposition under section 20 can be stated as follows. The applicant's mark (application 6043/95) nearly resembles the opponent's marks that are already on the register for the same goods or goods of the same description. As a result,

registration of the applicant's mark should be refused under section 20 as being likely to deceive or cause confusion.

To bring section 20 into play, it is enough if the opponent can show its registrations extend to any goods, not necessarily all goods specified in the applicant's application, or to goods of the same description (*Smith Hayden & Co's Application (1946) 63 RPC 97 at 101*). But the opponent cannot show that its registrations extend to any of the applicant's goods, or to goods of the same description.

The opponent's registrations are for locks, bolts, keys, doors, gates, safes, strong boxes and other items that could be described loosely as 'security hardware'. Those goods are not the same as sewing machines and parts for sewing machines.

Whether goods are of the same description depends on the nature of the respective goods, the use of the goods and the trade channels through which the goods are bought and sold (*Jellinek's Application (1946) 63 RPC 70*). But there can be no argument on this point in view of the clear difference between the respective goods. Sewing machines and parts for sewing machines are wholly different in nature, use and trade channels from locks, bolts, keys, doors, gates, safes, strong boxes and other goods of the opponent's registration. Sewing machines have working parts made of metal and older style models have casings and stands of metal. Locks and lock mechanisms are of metal and the opponent's other goods are likely to be made of metal. But sewing machines are for sewing and the opponent's goods are for securing property. The difference is absolute.

As the respective goods are not the same goods or goods of the same description, the opponent cannot rely on section 20.

Section 12(1) – deception and confusion

The opponent does not expressly plead section 12(1), except in relation to bad faith (which it pleads in paragraph 8 of the statement of grounds in the notice of opposition : a point that I deal with below). Perhaps the opponent means to plead section 12(1) in relation to its statements about deception and confusion in paragraph 6 of the statement of grounds. If so, the basis of the opposition on that ground would be that the opponent's marks have a

reputation through use in Hong Kong so that at the date of the applicant's application to register, use of the applicant's mark would be likely to deceive.

Although section 20 applies only where the competing marks are for the same goods or goods of the same description, section 12(1) is not similarly restricted. But the extent of the reputation of the opponent's mark and the goods for which it has been achieved are factors in determining whether there is a sufficient likelihood of deception or confusion to refuse the applicant registration under section 12(1).

The opponent gives details of the use of its marks in Hong Kong in paragraphs 5 - 8 of Mr Ron Doran's statutory declaration. The sales figures and advertising expenditure stated there are substantial but despite being put to strict proof by the applicant, the opponent does not support its figures by filing invoices or audited accounts. Additionally, the opponent's brochures do not indicate that they are for distribution in Hong Kong.

Even if I accept the opponent has extensively used its marks in Hong Kong and had a reputation in its marks at the date of the applicant's application, the opponent has not shown a reputation in sewing machines. Nor is there is evidence to suggest that locks, bolts, keys, doors, gates, safes, strong boxes and other goods of the opponent's would be sold through the same trade channels as sewing machines so that this, or any other circumstance of sale would lead people seeing the applicant's sewing machines to think of the opponent's mark (*Re Omega [1995] 2 HKC 473*). There is also the fact that the opponent's registration 263/82 is for the composite mark MULTILOCK and device and the opponent's evidence indicates its marks are always used with the word MUL-T-LOCK (Mr Ron Doran's statutory declaration paragraphs 6 and 7 and exhibit RD-2).

Finally, in comparing the opponent's marks with the applicant's mark, I find they are not confusingly similar, even allowing for imperfect recollection. The immediate impression given by the opponent's marks is of a key and a muscular man's torso with arms raised. The man's torso is particularly prominent in the opponent's registered mark 263/82. The applicant's mark is a T-shaped, robot-like figure with arms hanging from a vase-like body. The respective marks might be described as human figures but there is no reasonable likelihood of their being confused. The United Kingdom Registrar found the marks similar in the opponent's opposition to the applicant's application to register the mark in class 6 in the UK (exhibit RD-5) but on the evidence before me, I have come to a different view.

For these reasons the opponent cannot succeed on the ground of deception and confusion under section 12(1).

Section 12(1) – bad faith

The opponent alleges the applicant's amendment of its application in class 6, to remove the device from the application to register TITAN and device, is an admission that its present application to register the device in class 7 is in bad faith and contrary to section 12(1). The opponent makes the allegation in paragraph 8 of the statement of grounds in the notice of opposition and paragraphs 12 to 15 of Mr Ron Doron's statutory declaration and relies in particular on two letters dated 2 April and 15 May 1998 from China Patent Agent.

But bad faith cannot be imputed from those facts and nothing more. The allegation apparently relies on the opponent's assertion that its marks in class 6 and the applicant's mark in class 7 are confusingly similar. But the opponent has not shown the marks are confusingly similar, either under section 12(1) on the basis of reputation, or under section 20 on the basis of a mark already on the register in respect of the same goods or the same description of goods. If the applicant's mark is not likely to confuse in use for goods in class 7, the application cannot be in bad faith and contrary to section 12(1).

Section 12(1) catches more than confusion but in this opposition the opponent puts forward no other facts to support the allegation of bad faith.

Sections 2, 9 and 10

The opponent (in its statement of grounds in paragraphs 6 and 7 of the notice of opposition and paragraph 11 of Mr Ron Doron's statutory declaration) asserts that the applicant's mark is confusingly similar to the opponent's trade mark and that as a result the applicant's mark has no independent distinctive character because it indicates a connection with the opponent's goods and not the applicant's.

That argument cannot stand on its own. It is entirely dependent on a finding under section

12(1) or section 20 that the respective marks are confusingly similar. As a result, it adds nothing to the opponent's opposition.

Section 13(1)

The opponent pleads section 13(1) presumably on an argument that the applicant is not entitled to registration as proprietor of its mark because a claim to proprietorship would be inconsistent with the opponent's rights in its marks. But logically, a claim to proprietorship under section 13(1) can be relevant only where the respective marks are virtually identical (*Re Wowi and device [1998] 3 HKC 221*) and that is not the position here.

Section 23

The opponent pleads section 23 in paragraph 9 of its statement of grounds. The opponent is an Israeli company (statement of grounds paragraph 1) and has registrations of its mark in Israel (Mr Ron Doron's statutory declaration paragraph 3 and exhibits RD-1 and RD-3). The registrations are earlier than date of the applicant's application. The opponent does not show its goods are manufactured in Israel (Mr Ron Doron's statutory declaration paragraph 9 says only that 'goods manufactured by my company are marketed and sold in Israel'. A brochure at RD-2 reads 'Mul-T-Lock boasts six modern plants covering over 40,000 square meters' but it does not say the plants are in Israel.). But perhaps it can be inferred from the opponent's evidence that its business is in Israel (exhibit RD-2 shows the opponent is an Israeli public company) so that in the trade mark sense, its goods originate from Israel (*Hong Kong Caterers Ltd v Maxim's Ltd [1983] HKLR 287 at 299*).

But the opponent cannot succeed under section 23 because it does not show the applicant's mark is identical with or nearly resembles its own marks registered in Israel and it does not show that its registrations are for goods of the same description as the applicant's goods. Not surprisingly, the opponent does not give an undertaking to comply with section 23(3)(b) because it does not have a registration in Israel for sewing machines, or for goods of the same description as sewing machines.

Section 13(2)

The registrar has a general discretion, to refuse an application for registration or to accept it. He must exercise the discretion judicially, considering all the circumstances of the case (*Hong Kong Caterers Ltd v Maxim's Ltd [1983] HKLR 287 at 301*). For the reasons I have given, I find there is no reasonable likelihood of confusion between the applicant's and the opponent's marks and no other grounds on which the opponent can oppose registration of the applicant's mark. It follows that I have no reason to exercise the discretion under section 13(2) adversely to the applicant.

Costs

As the opposition has failed, I award the applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4) as applied to trade mark matters, unless otherwise agreed between the parties.

(Teresa Grant)
for Registrar of Trade Marks
21 June 2002