

Application No. 15394/1997

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

AND

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

MEN IN BLACK

In Part A of the register in Class 14 by Casio
Keisanki Kabushiki Kaisha (Casio Computer
Co. Ltd.)

AND

IN THE MATTER of an opposition by
Columbia Pictures Industries, Inc.

**DECISION
OF**

Miss Lavinia Chang acting for the Registrar of Trade Marks after a hearing on 8 August
2003.

Appearing : Mr Lindsay Esler of Messrs Deacons for the applicant
Mr Stewart K M Wong instructed by Messrs Dibb Lupton Alsop for the
opponent

1. These proceedings arise out of an application made under the provisions of the Trade Marks Ordinance, Cap 43 (the “Ordinance”) on 28 October 1997 (the “application date”) by Casio Keisanki Kabushiki Kaisha (Casio Computer Co. Ltd.) of Japan to register the mark “MEN IN BLACK” in Part A of the register. The application is made in respect of “timepieces and parts and fittings therefor; all included in Class 14”. The mark was duly accepted for registration and advertised on 29 May 1998 for the purpose of opposition under Trade Marks Rule 22, Cap 43.

Pleadings

2. A notice of opposition was filed by Columbia Pictures Industries, Inc. (the “opponent”) on 8 April 1999. In it the opponent pleads the genesis of the film entitled MEN IN BLACK, its box office and video sales success in the US and internationally, and its worldwide licensing schemes for exploitation of MEN IN BLACK in relation to a range of products. The opponent pleads that the goodwill and reputation in the film extended to the opponent’s licensed products. The use and registration of the suit mark would amount to passing off of the opponent’s mark, and would unfairly prejudice the opponent’s use of its mark “MEN IN BLACK” on licensed watches to be launched in Hong Kong and cause confusion among the general public.

3. The opponent has also filed an application for registration of MEN IN BLACK in Class 14 in Hong Kong.

4. The opponent relies on sections 2, 9, 10, 12 and 20 of the Ordinance as the grounds of opposition to the application and seeks an award of costs.

5. The applicant contends that the opponent is not the proprietor of the term “MEN IN BLACK” as the term originated from 1953 in the USA to refer to secret agents who investigated extra-terrestrial activities. The same term can also refer to the New Zealand rugby team “The All Blacks”. The opponent is put to proof of its box office and video sales figures. The applicant contends the opponent’s licence arrangements are irrelevant, so are its various foreign applications for identical and similar marks (in classes other than Class 14) and its application in Hong Kong for the same mark. The opponent is put to proof that any goodwill and reputation of the opponent’s MEN IN BLACK extended beyond their motion picture to their licensed products. The applicant asks that the opposition be dismissed with costs against the opponent.

Evidence

6. The opponent filed evidence by way of a statutory declaration dated 19 July 2000 by Jared Jussim, in his capacity as Executive Vice President of the opponent. He says the opponent produced the highly successful film MEN IN BLACK, based on the the comics MEN IN BLACK which was created by Lowell Cunningham and published by Malibu Comics Entertainment, Inc., and from whom the opponent took an assignment of copyright dated 27 July 1995.

7. Mr Jussim says apart from being a huge box office success in the US, the motion picture MEN IN BLACK was widely distributed throughout Asia, particularly in Hong Kong. Its gross international receipts were US\$325 million (not apportioned). Its video sales were US\$140 million in the US and US\$50-60 million internationally. The motion picture was released in Hong Kong on 31 July 1997 and on video on 25 November 1997.

8. The opponent has filed applications for registration of MEN IN BLACK and a similar mark in a number of countries in different classes of goods. Further, the opponent has licensed the use of MEN IN BLACK on merchandise in 33 countries and regions including Hong Kong. These licences are broadly categorised into (i) apparel and accessories including watches, (ii) gifts and novelties, (iii) toys and games, (iv) promotion, (v) domestic and housewares (iv) publishing and (vii) stationery/back to school.

9. In Exhibit 4 of Mr Jussim's statutory declaration, there is one licensee under the "Promotions" category for Hong Kong, viz Mobil Oil Hong Kong Ltd at Ocean Centre, Kowloon for premium promotion incorporating Mobil Oil, Galoob Toys, and Ray Ban. The list was made up to 8 October 1997.

10. The applicant filed evidence by way of a statutory declaration dated 7 January 2002 of Shunji Nakano, its General Manager. In it he exhibits printouts from various websites showing references to the UFO folklore phenomenon of "Men In Black" which bears no relation to the opponent's motion picture. Mr Nakano says the applicant's evidence shows that the UFO folklore phenomenon of "Men In Black" has been in existence for many decades, preceding the opponent's use of the term in its film. According to legend, Men in Black are special government or alien agents who threaten and intimidate into silence people who claim to have seen UFOs. Separately, there is also media coverage referring to the New Zealand Rugby Union Team as the "men in black". On the question of copyright, Mr Nakano points out that contrary to the opponent's evidence, there is evidence showing that copyright in the MEN IN BLACK comic book images resided in Ms Sandy Carruthers.

11. The opponent filed evidence in reply by way of a second statutory declaration by Jared Jussim. Mr Jussim says that the New Zealand Rugby Union Team are officially called the ALL BLACKS and they are known in Hong Kong sports media as the ALL BLACKS. He says even if the UFO folklore phenomena existed, it was only known to some people in the US, and that as far as people in Hong Kong were concerned, MIB agents were unknown until the release of the film in 1997. Searches conducted using 11 major search engines give numerous references to the opponent's film MEN IN BLACK, and its sequel MIB II released in Hong Kong on 13 July 2002. He exhibits (at Jussim II, at Exh-9) various websites offering MEN IN BLACK licensed products, including Hamilton, the official sponsor of timepieces for the sequel to Men In Black (released in 2002), namely, the MIB II Digital watch and Ventura MIB II Chrono. The words "Men In Black II" appear on the packaging of these watches.

12. The matter came on for hearing on 8 August 2003, at which Mr Lindsay Esler represented the applicant and Mr Stewart K W Wong of counsel appeared for the opponent.

13. Although the hearing took place after the commencement of the Trade Marks Ordinance Cap 559, by virtue of sections 1(4) and 10(1) of Schedule 5 to Cap 559, the application is a pending matter and remains to be dealt with under the provisions of Cap 43.

Decision

14. Though initially pleaded, the opponent could not pursue its opposition based on section 20 as there was no mark "already on the register" as such at the date of application. I move on to consider the other grounds raised.

Opposition under section 12(1) of the Ordinance

15. Section 12(1) of the Ordinance provides:

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

16. Before an opponent can launch an opposition under this provision, it bears the onus of establishing that its mark or marks are known to a substantial number of persons in Hong Kong (*Re Arthur Fairest Ltd's Application* (1951) 68 RPC 197).

Reputation sufficient to activate section 12(1)

17. There is no dispute that the opponent may rely on its unregistered mark or trade name for this purpose. The date by which cognizance or awareness in the opponent's mark must be established is the application date of the suit mark (*NOVA Trade Mark* [1968] RPC 357 at 360). This cognizance or awareness in the relevant market must not be *de minimis* in order that section 12(1) could bite, otherwise deception is unlikely to arise (*Da Vinci Trade Mark* [1980] RPC 237). Only if the opponent discharges this burden does the onus shift to the applicant to satisfy the tribunal that there is no reasonable likelihood of deception arising among a substantial number of persons if the mark proceeds to registration (*Eno v Dunn* (1890) 15 App Cas 252 at 261).

18. The opponent's evidence leaves much to be desired. Mr Jussim, Executive Vice President of the opponent states the gross international cinematic receipts of the film MEN IN BLACK to be US\$325 million, and international video sales receipts (USA excluded) to be between US\$50 and 60 million. No breakdown is provided of box office figures for the Hong Kong market. Mr Jussim says that the opponent has entered into licence arrangements in a number of countries and regions including Hong Kong. In the list of international licensees last updated on 8 October 1997 (Jussim, Exh-4), there is one licensee for the territory of Hong Kong, namely, Mobil Oil Hong Kong Ltd under the category of "Promotions", for "Premium Promotion incorporating Mobil Oil, Galoob Toys and RayBan". Apart from that description, there is nothing in the evidence as to the scope and terms of the licence, not to mention whether that includes MEN IN BLACK timepieces. Gross sales figures of licensed products are given as follows:

	<u>US (US\$)</u>	<u>The World (\$US) [sic]</u>
1998	26 Million	31 Million
1999	19 Million	21 Million

19. Needless to say, these figures are broadbrush and ambiguous to the extreme. There is no breakdown, for example, into the different categories of merchandise. There is no breakdown as to the country of sale beyond the distinction between "US" and "The World". If, as common sense would suggest, "The World" is taken to include the "US", then the sales volume for the total of 63 licensees in the rest of the world (compared with 39 for the US) would be a mere US\$5million in 1998 and US\$2million in 1999. That latter figure of US\$2 million would appear to cover sales made in a total of 33 countries, regions and territories (Jussim I, para 9). There is no way one can decipher, from the evidence, the volume of sales of licensed products attributable to the Hong Kong market, or indeed whether any such sales had been made in Hong Kong. Most important of all, as these sales figures post-date the application, they are strictly speaking, irrelevant.

20. What is borne out by the evidence is the extent of the advertising, promotion and media coverage in Hong Kong associated with the film before and shortly after its release on 31 July 1997, approximately three months before the application date. This includes special previews and premiere nights featuring the film; souvenirs and memorabilia associated with the film (available with or without purchase of sponsors' goods); publicity write-ups and advertisements in local magazines including 東周刊、東 Touch、壹周刊, 凸週刊, and newspapers such as Apple Daily, Oriental Daily, Sing Tao Daily and Hong Kong Standard. In the evidence MEN IN BLACK is found mainly accompanying the Chinese title “黑超特警隊” or the abbreviation “MIB”. The applicant submits, in my view validly, that the population of Hong Kong, being predominantly Cantonese-speaking, would more likely recall the opponent's film by its Chinese title. Equally however, MEN IN BLACK is a short, simple and catchy title, and even if the majority of Hong Kong people are Cantonese-speaking, from my personal experience, they have at least a smattering of common English words. In the light of that, I do not find Mr Esler's comment overwhelmingly persuasive.

21. Mr Wong submits that case law demonstrates that the initial onus the opponent has to discharge is a very low one. If the mark is not wholly unknown among the relevant persons, the onus is discharged (*Pioneer v Hy-Line Chicks* [1976] RPC 294). In *Hong Kong Caterers Ltd v Maxim's Ltd* [1983] HKLR 287, Hunter J considered the question whether domestic user is necessary and on which goods or services, but came round to the view that it is irrelevant how the local cognizance is derived. The applicant submits, to the contrary, that high viewership does not of itself equate to reputation in all classes of goods and services, in this case, timepieces.

22. Before deciding this point, it is convenient to deal with two of the applicant's other submissions, first, that the assignment of copyright subsisting in the comic strip “MEN IN BLACK” had not actually been effected (Nakano, para 21), and secondly, that the opponent's evidence relating to the use of MEN IN BLACK in relation to watches does not show use by the opponent itself or its licensees but by third parties, e.g. OK Convenience Stores, and Hamilton, an independent watchmaker.

23. This would appear to be a challenge on the opponent's *locus standi*, but I do not understand proprietorship to have been raised as a ground of opposition. *Locus standi* is of little relevance to section 12(1) as must be apparent from the opening words of section 15(1) of the Ordinance, that “any person”, without discrimination, may oppose. Quite apart from any question of authorization, there is no bar to opposition proceedings being launched based on use by another, since section 12(1) is primarily concerned with the public interest:

“[Section 12] is ... for the protection of the public and anyone may object, but if he relies only on similarity he must prove the practical likelihood of confusion to the public and this he can only do, for the purposes of the section, by proving the existing user by another, not necessarily by himself, which is likely to cause deception or confusion.” (*Bali Trade Mark* [1969] RPC 472 at 495-6)

24. As I have said the evidence relating to box office sales is unsatisfactory. However, in my view a vast majority of cinema-goers in Hong Kong who might not necessarily have seen the film MEN IN BLACK would still be aware of it through the advertising and movie tie-ins launched just before and certainly during, its cinematic release in Hong Kong. In the recent decision of *Café Vogue*, the Hearing Officer, speaking of fashion magazines and luxury cars, was of the opinion that

“sales figures alone do not delimit reputation. Many potential purchasers would not buy the magazine (Vogue) ... That does not however mean that they are not aware of the magazine in the same way that people in Hong Kong know of Rolls Royce and Bentley motor vehicles though few are in a position to purchase one.” (*Decision of the Registrar of Trade Marks dated 29 August 2003*, unrep., at pp 9-10)

I respectfully adopt the same approach.

25. I think there can be little doubt that cinema-goers are also buyers of watches and timepieces. Indeed I am bound by the decisions in *Re Omega* [1995] 2 HKC 473 and *Gay Giano Trade Mark* [1996] 2 HKC 646 that for the enquiry under section 12(1), awareness of the opponent’s mark need not extend to the goods covered by the application as long as there was some reputation for its mark in Hong Kong derived from user in the widest sense or awareness. The true position has been summarised in *Tiffany Lunettes Srl*:

“The fact that reputation is not in respect of the particular goods is a factor to be taken into account in assessing confusion, not a precondition for opposing the registration of a mark under s.12.” (*Decision of the Registrar of Trade Marks dated 17 December 1999*, unrep., at p18)

26. Despite the paucity of the evidence, I find that on balance there was sufficient awareness amongst Hong Kong people at the application date i.e. 28 October 1997, of the film title MEN IN BLACK, to meet the threshold requirement under section 12(1).

27. The onus accordingly shifts to the applicant to satisfy me that, having regard to the reputation or awareness of the opponent's mark in Hong Kong, use of the suit mark in a normal and fair manner in connection with "timepieces and parts and fittings therefor" would not be reasonably likely to cause deception and confusion amongst a substantial number of purchasers of the goods upon which the mark is used (*Smith Hayden & Co's Application* (1945) 63 RPC 97 at 101, per Evershed J, as adapted to this matter).

Likelihood of deception and confusion

28. I turn to the substantive question to be decided under section 12(1).

29. For a start, the marks are identical visually and phonetically. The following argument made by the opponent relates more to the question of proprietorship and my residual discretion under section 13, but it is convenient to deal with it at this juncture.

30. Mr Wong for the opponent submits it is simply incredible for the applicant to say that there was no cognizance of the film MEN IN BLACK in Japan given the film was a worldwide blockbuster. He says the timing of the date of application, being so close to the premiere of the film, seems too much of a coincidence. He invites me to infer from these factors that the applicant had set out to deceive.

30. Although the applicant's evidence is that the phrase MEN IN BLACK had been in use for some time prior to the launch of the opponent's film, it is true that it has not adduced evidence on how it itself came upon the suit mark. Section 13(1), however, provides only that "any person *claiming to be entitled* to be registered as the proprietor of a trade mark *used or proposed to be used* by him who is desirous of registering it" (emphasis added) must make an application for registration in the prescribed manner.

31. While one might have expected an explanation for the choice of the suit mark, the applicant is under no obligation to do so when no challenge has been made. There is no allegation of bad faith made in the notice of opposition or in the statutory declaration of Mr Jussim under Trade Marks Rule 25. The applicant filed its evidence in support of the suit mark in the light of the opposition disclosed. In any case, the authorities are clear that inferences of commercial dishonesty ought not to be drawn, unless irresistible, in the absence of cross-examination (*Re Borsalini Trade Mark* [1993] 1 HKC 587).

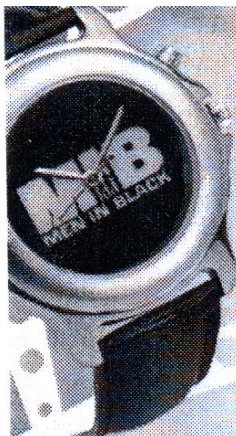
32. The question that I have to decide is whether deception or confusion would necessarily follow among a substantial number of persons if the applicant were to use the suit mark fairly in respect of timepieces and parts and fittings therefor.

33. The reference to “substantial” is a question to be judged in relation to the market for the goods concerned. “Persons” refers to all those who are likely to become purchasers of the goods upon which the respective marks are used or intended to be used. The comparison is between user of the opponent’s mark and the suit mark if used in a normal and fair manner, that is to say, the notional and fair use which the applicant would be entitled to make of its mark in the ordinary course of trade in respect of timepieces and parts and fittings therefor, against the use that has been made by the opponent of its mark.

34. I accept that there is use in Hong Kong of the opponent’s mark by virtue of its cinematic release and attendant promotional activities. That does not automatically lead to a finding that deception or confusion would necessarily follow if the applicant were to use the suit mark fairly in respect of timepieces and parts and fittings.

35. There is nothing in Mr Jussim’s evidence to suggest that either the opponent itself or Mobil Oil Hong Kong Ltd as its Hong Kong licensee is a manufacturer of timepieces and parts and fittings or is otherwise known for its association with such goods. Instead, the opponent seeks to argue that the reputation associated with the film MEN IN BLACK is so overwhelming that it spills over into all kinds of goods, in this case, timepieces and parts and fittings, so that deception or confusion would arise on an assumption of normal and fair use of the suit mark. Does this hold true?

36. Although the opponent claims to license the use of MEN IN BLACK in relation to watches, the evidence does not provide details of the extent of sales made and where they were made. Evidence of actual use in relation to watches figures no more than two or three times in the evidence, and even then, the watches are among the many prizes of lucky draws run by OK Convenience Stores, 壹周刊 and Apple Daily as memorabilia of the film. The following is the best example one could find in the evidence:



37. The nature of the deception which the opponent complains of is that the applicant's use will be taken as having been licensed by or connected with the opponent. In effect, the opponent is saying that because the film MEN IN BLACK is widely known, the goodwill and reputation of the film title extends beyond the film to its licensed products. If the mark is used in relation to any goods, be it watches or other items of merchandise, it will give rise to deception.

38. There is of course no evidence in this case of deception or confusion or the lack thereof. In my view, the opponent's "use" in relation to the goods of interest is too flimsy to form the basis for such an association with the opponent.

39. That said, there is no evidence that the applicant has used the suit mark as such. Instead, its evidence consists of the long use of the term "Men in Black" to refer to the special agents in US folklore whose mission it is to track down and silence people who have had sightings of UFOs or aliens, or as another term to refer to the New Zealand Rugby Union Team. All this information is supposedly available on the internet (which the opponent disputes, see Jussim II, paras 7 and 9), but there is no evidence of the degree of penetration of this particular US folklore and usage of "Men in Black" in Hong Kong. The searches were also conducted in November 2000, which was three years after the application date, and more than three years after the opponent's film was released. It would be difficult, in the circumstances, to discount the possibility that the film may have already entered the consciousness of the media and public. There is evidence too of internet printouts of information on books on the subject of "Men in Black" special agents available on Amazon.com but again, that alone does not disprove the likelihood of deception or confusion when it gives no indication of the level of sales made to the people in Hong Kong.

40. To return to Evershed J's enquiry in *Smith Hayden (supra)*, the burden of proof is on the applicant to demonstrate that normal and fair use of the suit mark will not be likely to cause deception or confusion among a substantial number of persons. The only relevant persons under that test are those in Hong Kong. The evidence of "specialist" usage in a foreign context is not by itself a measure of the likelihood of deception among local persons. The usage of the term "men in black" to refer to the New Zealand Rugby Union Team are anecdotal in my view, cropping up, judging by the dates, only subsequent to the release of the opponent's film.

41. No evidence having been adduced on the circumstances of the trade nor the relevant class of end-users, I need to turn to the goods themselves. There is no suggestion that the parties' watches and timepieces are other than general consumer items.

42. The question then as to whether potential buyers would be likely to be deceived or confused by the use of the suit mark is a “jury question” (*GE Trade Mark* [1973] RC 297 at 321). For that purpose, I am entitled to rely on my common knowledge as a member of the public.

43. In my view, the typical purchaser of watches and timepieces is an average member of the public, of average intelligence and power of observation. There is no dispute that the marks and goods are identical. While I am prepared to accept that the applicant is a known watch manufacturer, absent evidence of actual use in relation to the goods claimed, I must apply, in my comparison of the marks, the test of notional fair use of the suit mark. Clearly this must include use of the suit mark on its own, in plain block lettering.

44. In the course of argument, Mr Esler accepts that even though there is express reference in the corresponding UK legislation and authorities to “confusion” which is not present in our section 12(1), the longstanding practice in Hong Kong is not to make a difference (see, for example, the test adopted by Mayo J in *Mitac Inc v Mita Kogyo Kabushiki Kaisha* [1993] 2 HKLR 153, at 158). I too accept that point to have been settled.

45. It is well-established that the enquiry into a likelihood of deception or confusion, for the purposes of section 12(1), places no limitation

“upon the nature of the confusion or deception so envisaged, whether it be visual or phonetic confusion of the marks themselves, or what is termed contextual confusion, or confusion or deception as to the trade provenance of the goods... [in] all such instances... the confusion or deception mainly to be feared is that the public would attribute a common trade origin to both sets of goods.” (*John Fitton & Company Limited’s Appn* (1949) 66 RPC 110 at 113).

It is sufficient if the result of registering the suit mark will be that there is a real tangible danger that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source.

46. Having considered the applicant’s evidence, I cannot say that the suit mark will be understood by an average buyer of watches in Hong Kong as either a reference to the US folklore or another term for the New Zealand Rugby Union Team. I do not find that the applicant’s web site extracts serve to prove the state of perception at the application date, and in particular, in Hong Kong. Instead, having regard to the extent of publicity associated with the opponent’s film in Hong Kong, I would think that at the

material date, the awareness of the film title far outweighed the awareness of the US folklore, and the possible association with the New Zealand Rugby Union Team. In my view, the applicant has not disproved the likelihood, given that the marks are the same, that the public would attribute a common trade origin to both sets of goods.

47. I find that the opposition succeeds under section 12(1) of the Ordinance on the basis of likelihood of deception, and accordingly, I need say no more on the other grounds of opposition based on sections 9 and 10 or in the exercise of my discretion.

Costs

48. The opponent 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 applicant pays the costs of these proceedings.

49. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part 1 of the First Schedule to Order 62 of the Rules of the High Court (Cap 4) as applied to trade mark matters, with one counsel certified, unless otherwise agreed between the parties.

(Lavinia Chang)
p. Registrar of Trade Marks
30 October 2003