

Application No.16312 of 1997

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

AND

IN THE MATTER of an application by
Sega Gameworks L.L.C. to register the
mark

GAMEWORKS

in Part B of the Register in Class 28

AND

IN THE MATTER of an opposition
thereto by Games Workshop Limited

**DECISION
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after considering
the pleadings and evidence filed in the opposition proceedings.

Application for Registration

1. On 14 November 1997 (“the application date”), Sega Gameworks L.L.C. (“the applicant”) applied to register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 (“the Ordinance”), in Part B of the register in Class 28, the trade mark, a representation of which appears below :

GAMEWORKS

(“the suit mark”).

2. The goods intended to be covered by the registration were “toys, games, playthings and sporting goods, basketballs; basketball hoop sets; footballs; foam balls; softballs; glide balls; baseballs; kicking balls; gloves for games; hockey pucks; hand held pinball games; pinball games machines (toys) in the form of necklaces; hackysacks; hand-held paddle ball games; playground and rubber balls; video, electronic and computer games; video and computer game cartridges and discs; video and computer output game machines; video game interactive control floor pads or mats; video game joysticks; video arcade games; electronic games and amusement apparatus other than for use with television receivers; video game machines and hand held video game machines not for use with television receivers; coin or counter operated arcade game machines not being for use with television receivers; coin-operated games; plastic and vinyl toy figures; toy figures with magnetic features; plastic inert figures; inflatable toy figures; arcade style pinball machines; electronic table top pinball games; jigsaw, manipulative and three-dimensional puzzles; self-contained hand-held table top games; electronic game equipment with or without watch function and hand-held units for playing electronic games; stuffed and plush toys; baseballs; soft sculpture toy figures; inflatable bop bags; painted toy figures; slide puzzles; water-squirting toys; party favours in the nature of small toys, paper card games and paper and plastic cards; noisemakers, toy horns, whistles and rattles; toy banks, vinyl toy banks; board games; dolls and puppets; flying discs; yo-yos; swimming toys; latex squeeze toys; musical toys; skateboards; toy weapons; plastic play and toy carry cases for children; action figure carry cases; card games; hand-held candy dispenser; balloons, metallic balloons, latex balloons; and pocket play arenas; parts and fittings for all of the aforesaid goods; all included in Class 28” (“the specified goods”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part B of the register. The application was advertised in the

Government of the Hong Kong Special Administrative Region gazette on 24 September 1999.

Pleadings and evidence

3. On 24 November 1999, Games Workshop Limited (“the opponent”) filed notice of opposition to the application. The grounds of opposition state, *inter alia*, that the opponent is a company incorporated under the laws of the United Kingdom. It is the proprietor of the trade mark “GAMES WORKSHOP” under registration nos. B12787 of 1998 and B10976 of 1997 in classes 28 and 42 respectively in Hong Kong. It is the opponent’s case that with substantial and extensive use and promotion of the opponent’s goods bearing the opponent’s mark “GAMES WORKSHOP”, the general public has connected or associated the opponent’s mark with the opponent. The suit mark is similar to the opponent’s mark in terms of appearance, sound and spelling. The use or registration of the suit mark will cause confusion or mistaken belief among the public that the goods bearing the suit mark are originated from or connected in the course of trade with the opponent. The use of the suit mark will also constitute an infringement and passing off of the opponent’s right in its mark “GAMES WORKSHOP”. The grounds of opposition comprise sections 2, 12, 13 and 20 of the Ordinance.

4. In the applicant’s counter-statement, save and except the applicant’s own application for registration of the suit mark and that the opponent is the registered proprietor of the trade marks registration nos. B12787 of 1998 and B10976 of 1997 in Hong Kong are admitted, each and every allegation in the grounds of opposition is denied by the applicant. The applicant contends that the suit mark is clearly distinguishable from the opponent’s mark. It denies that its use of the suit mark would be likely to deceive and confuse the public. It asserts that the goods and retail services in relation to which the opponent uses its mark are limited and remote from the goods and services of the applicant.

5. Trade Marks Rule/s, Cap. 43 Sub. Leg. (“Rule/s”) 25 evidence consists of a statutory declaration from Timothy J.M. Wilson, the UK finance and operations director of the opponent, together with exhibits, which was declared on 7 November 2000. The applicant has not filed any evidence under Rule 26 although it was entitled to do so.

Decision

6. Though, by 19 December 2007, the date the matter was fixed to be heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of section 10(1) and (2) of Schedule 5, oppositions to registrations still pending as of 4 April 2003 are to be determined under the provisions of the repealed ordinance, Cap. 43.

7. A date for hearing the opposition was fixed for 19 December 2007. The applicant did not give notice of its intention to appear by filing TM-No. 8 under Rule 30(2). It is therefore treated as not desiring to be heard. The agents for the opponent, Messrs. Wenping & Co, indicated that they would like these proceedings be decided on the pleadings and evidence filed without any hearing. I shall therefore decide the matter on all the materials available before me without the benefit of any oral submissions or written representations by the parties.

Under section 20(1)

8. At the application date, section 20(1) of the Ordinance insofar as it relates to goods provided :

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


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

(a) the same goods;

(b) the same description of goods; or

(c) ”


9. The following registered mark is relied on by the opponent in mounting the opposition under section 20(1) :

Trade Mark	Registration No.	Class	Part	Goods
	B12787 of 1998	28	B	games and playthings; toys; board games; miniatures and models; all for use in war games, board games, hobby games, skirmish games or role playing games, kits of parts for constructing miniatures and models; parts and fittings for the aforesaid goods

10. Under section 20(1), the first question for me is whether the goods for which the suit mark is sought to be registered, the same goods or description of goods as those of the opponent's registered mark. The answer to this question must be yes as both the specifications of the parties' marks cover toys, games and playthings. The opponent is therefore able to overcome the first limb of section 20(1).

11. It follows that the second issue for my determination is whether the suit mark so nearly resembles the opponent's registered mark as to be likely to deceive or cause confusion.

12. The accepted test to be applied under section 20(1) of the Ordinance is that stated by Evershed J. in *Smith Hayden & Co.'s Application* [1946] 63 RPC 97. Adapted to the matter in hand, the test may be expressed as follows :

“Assuming user by the opponent of its mark “  ” in a normal and fair manner for any of the goods covered by the registration, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant also uses its mark “ **GAMEWORKS** ” normally and fairly in respect of any goods covered by its proposed registration?”

13. The onus is on the applicant to satisfy the Registrar that the trade mark

applied for is not reasonably likely to deceive or cause confusion. In cases in which the tribunal considers that there is doubt as to whether deception is likely the application should be refused (*Kerly's Laws of Trade Marks and Trade Names*, 12th Edition, paragraph 17-03).

14. The established test for the comparison of word marks is that promulgated by Parker J. in *Pianotist Co. Ltd.'s Application* (1906) 23 R.P.C. 774 at 777.

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

15. The suit mark is a pure word mark consisting of the word “GAMEWORKS” in plain block letters. The suit mark is formed by the conjoining of the two words “GAME” and “WORKS”. It is highly likely that the potential purchasers will see the suit mark as an honest combination of the two ordinary English words “GAME” and “WORKS”. I do not see that there is any other way in which the purchasers would perceive the suit mark. The opponent’s registered mark is also a word mark comprising the two words “GAMES” and “WORKSHOP”. I have not overlooked that there is a certain degree of stylisation of the lettering and presentation in the opponent’s registered mark. However, to my mind, whilst the stylisation has some impact on the appearance of the opponent’s registered mark, it adds nothing of significance. Essentially, it is still a word mark comprising the two words “GAMES WORKSHOP”.

16. Visually, on the one hand, the arrangement of the two words “GAMES WORKSHOP” in two levels and the stylised scripts used do make the overall appearance of the opponent’s registered mark somewhat different from that of the suit mark. On the other hand, there is some visual similarity between the respective marks as they both contain the word “GAME”. The first five letters of the word “Workshop” in the opponent’s registered mark are the same as the word “Works” in the suit mark. For my part, the visual similarity is a finely balanced consideration, bearing in mind that the marks are not to be placed side by side for critical comparison.

17. Turning to consider whether the two marks sound similar, I believe the correct approach to aural similarity can be found in the following passage from *Aristoc Ltd v Rysta Limited* (1945) 62 RPC 65 :

“The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of the Trade Marks Act, 1938, S.12, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person’s wants.”

18. If the respective marks are fully and carefully articulated, the suit mark is a two syllable word whereas the opponent’s registered mark is a three syllable word. The first two syllables of the marks however pronounce the same. Taking into account of imperfect recollection and making allowance for careless pronunciation, I consider that the respective marks are phonetically similar. It is apparent that the marks have greater aural similarity than visual similarity.

19. Conceptually, the suit mark refers to a works related to games and the opponent’s registered mark a workshop also related to games. According to the Collins English Dictionary, the 3rd Edition, “works” means “1. a place where a number of people are employed, such as a factory. 2. the sum total of a writer’s or artist’s achievements, especially when considered together : the works of Shakespeare.” For “workshop”, it refers to “1. a room or building in which manufacturing or other forms of manual work are carried on. 2. a room in a private dwelling, school, etc. set aside for crafts.” In my judgment, the idea of “works” is very similar to “workshop” both of which can refer to a place where people are employed to produce games. I consider that the conceptual similarity between the marks tips the balance in favour of the likelihood of confusion or deception.

20. I must next consider the surrounding circumstances of trade. The

parties' goods cover toys, games and playthings which may include a wide range of goods, for example, from electronic and computer game machines in the upper end to kicking, rubber balls and balloons in the lower end. Whilst the more costly items like the electronic and computer game machines can be sold at department stores, the lower costs items such as kicking balls, rubber balls, inflatable toy figures and balloons can be sold at market stalls. The purchasers of the applicant's goods would be the same people as the purchasers of the opponent's goods. Apart from ordinary adult purchasers, the purchasers may include teenagers and youngsters buying the toys, games and playthings for themselves. The potential purchasers may not pay great attention and more than ordinary care when purchasing.

21. Having taken into account all the above, I conclude that there is a real tangible risk that the purchasing public would be confused into believing the goods of the parties come from the same source or at least wondering whether or not that might be so if the marks are applied to the same goods.

22. It follows that the section 20 opposition succeeds.

Under sections 2, 12 and 13(1)

23. Having decided that the opposition succeeds under section 20, I do not think I need to consider the opposition under these sections.

Under section 13(2)

24. As the opponent has succeeded in the opposition under section 20, the exercise of my discretion under section 13(2) of the Ordinance does not arise.

Costs

25. 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 its costs. I accordingly order that the applicant pays the costs of these proceedings.

26. Subject to any representations as to 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. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

Original Signed

(Ms Fanny Pang)

p. Registrar of Trade Marks

11 January 2008