

Application No. 4533/98

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

AND

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



In Part A in Class 11 by Main Plan Ltd

AND

IN THE MATTER of an opposition by  
De'Longhi S.P.A.

**DECISION  
OF**

Mr. Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a hearing  
on 2 April 2003.

Appearing : Mr Ling Chun-wai, counsel instructed by Messrs Yuen & Partners  
on behalf of Main Plan Ltd

Miss Josephine P.F. Chow counsel instructed by Messrs Wenping  
& Co on behalf of De'Longhi S.P.A.

1. On 8 April 1998, Main Plan Ltd, a Hong Kong company (the “applicant”) filed an application to register in Class 11 in Part A of the register of trade marks (the “register”) the trade mark a representation of which appears below :



(the “suit mark”).

2. The goods sought to be protected, after authorised amendments, were : “lamp glasses; flushing apparatus; toilet bowls; flushing tanks; water conduits installations [sic]; burners for lamps; lamp casings; lampshade holders; electric lamps; hangings for lamps; luminous house numbers; fumigation apparatus (not for medical purposes); pipes (parts of sanitary installations); lavatory basins; hand drying apparatus for washrooms; heating apparatus; water intake apparatus; air purifying apparatus and machines; showers; water filtering apparatus; toilet seats; water heaters; faucets for pipes; taps; water heating installations; hair driers; sanitary apparatus and installations; filters for drinking water; bath linings; bath tubs; bath installations; heaters for baths; bath fittings; lamps; hot air bath fittings; steam generating installations; regulating and safety accessories for water apparatus; bath tubs with massage function; shower cubicles; shower heads with massage function; shower units incorporating thermostatic shower mixers, hand showers with hoses, shower heads with massage function, shower valves and fittings; framework of metal for ovens; heating frames; cookers; cooking apparatus and installations; light bulbs; sockets for electric lights; luminous electric buttons; kilns; hydrants; water distribution installations; water supply installations; immersion heaters; clarifying installations; air deodorising apparatus; air driers; air filtering installations; air conditioning installations; filters (parts of household or industrial installations); mixer taps for water pipes; water purification installations; washers for water taps; turkish bath cabinets (portable); lavatories, ornamental fountains, bath tubs for sitz baths; all included in Class 11”.

3. The mark was accepted for registration subject to the condition that it be associated with pending application numbers 4531 of 1998, 4535 of 1998 and 4536 of 1998. The suit mark was advertised for opposition purposes on 21 May 1999.

4. On 21 July 1999 De'Longhi S.P.A., an Italian company (the "opponent") filed its notice of opposition to the application. Relying on its earlier use in Hong Kong and elsewhere and the registration in Hong Kong under No. 4856 of 1996, in Class 11 of its trade mark :



the opponent pleads that confusion will be caused as the public will believe goods marked with the suit mark originate from or are connected in the course of trade with the opponent. The opponent pleads that registration of the suit mark should be refused pursuant to sections 2, 12, 13 and 20 of the Trade Marks Ordinance (the "Ordinance") or alternatively at the discretion of the Registrar of Trade Marks (the "Registrar"). It also seeks its costs.

5. In its counter-statement the applicant denied any likelihood of confusion as aforesaid and maintained that the opposition was unfounded. It requested that the Registrar permit the application to proceed and its costs.

6. Both parties filed evidence. For the opponent, two statutory declarations of Giuseppe de'Longhi with exhibits, and for the applicant, a statutory declaration of Cho Chor Wah with exhibits. I shall refer to the evidence filed at appropriate times in this decision.

7. At the hearing fixed for 2 April 2003, the applicant was represented by Mr Ling Chun-wai of counsel whilst the opponent was represented by Miss Josephine P.F. Chow also of counsel. Miss Chow filed a skeleton argument in which she appeared to rely only on the opposition under section 12(1) of the

Ordinance, but subsequently she supplemented the skeleton with a further skeleton with her arguments pursuant to sections 13 and 20. At the hearing however Miss Chow neither advanced the opposition under section 13, nor did she withdraw it. I must treat it as a live issue. The opposition was not advanced under section 2 so I need say no more about that.

8. I should also mention that the applicant applied for registration of the suit mark in a number of other classes and the opponent also opposed the application made in Class 21. Both oppositions were heard together though each class has its own separate decision. The decision for the Class 21 application bears the registry number 4536 of 1998 and should be read first.

*Opposition under section 20(1) of the Ordinance*

9. 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) ....

10. For section 20(1) to apply, both requirements, i.e. identity or similarity of marks and identity or similarity of goods must be satisfied. If the

suit mark is adjudged to so nearly resemble the opponent's registered mark (No. 4856 of 1996) as to be likely to deceive or cause confusion, and any of the applicant's goods are the same or the same description of goods as those protected by the opponent's aforesaid registration, the suit mark shall not be registered – I have no discretion.

11. The opponent's registration is confined to "electric oil-filled radiators, electric ovens, electric deep fryers, electric fan heaters, electric convector heaters". These goods are placed in Class 11 for administrative convenience. The fact that the applicant's goods are also in Class 11 does not, of itself, mean they are the same description of goods – see *Australian Wine Importer's Trade Mark* (1889) 6 RPC 311.

12. There is an overlap with some of the goods in the applicant's specification, namely "... hand drying apparatus for washroom, heating apparatus ... water heaters ... cookers ... kilns", which, if not the same goods, are the same description of goods as electric fan and convector heaters for the first three items and electric ovens for the remaining two. The first leg of section 20(1) is accordingly satisfied.

*Does the suit mark so nearly resemble the opponent's registered mark as to be likely to deceive or cause confusion?*

13. The authorities have established the following general principles to guide the tribunal in answering this question. The resemblance between two competing marks must be considered with reference to the ear as well as the eye. A purchaser of electrical home appliances and other household articles is expected to exercise normal care and be of average intelligence but no more. His memory is imperfect. He remembers marks by general impression or by some significant feature rather than by a photographic recollection of the whole. Too detailed an examination should not be made. The question of whether one mark too nearly resembles another is essentially one of first impression. Marks are not to be compared side by side. They should be compared as a whole. Ultimately the question of whether one mark too nearly resembles another is a question of fact, not an exercise of discretion. The suit mark offends against section 20(1) if it is likely to cause deception or confusion in the minds of persons to whom it is

addressed, even if actual purchasers will not ultimately be deceived. It is enough that they are left in doubt whether goods marked with the suit mark come from the same source or are associated with the opponent. I must consider all fair and normal use that could be made of both marks in respect of the goods for which they are registered or sought to be registered, who are likely purchasers of the goods and their respective trade channels, both now and in the future. Conceptual similarity may increase the likelihood of confusion as may a reasonably held belief that both marks belong to the same family of marks.

14. Both marks are represented in a similar manner, white lettering against a dark background surrounded by a white border. The applicant's border is rectangular, whilst the opponent's border is rounded at the left and right sides. On a side by side comparison other differences are apparent. The opponent's mark is two letters longer, has only the first and third letters capitalised and has a stylised apostrophe which appears as a line over the letter "e". The script employed by the applicant differs from that registered by the opponent. The opponent's mark looks foreign and may be perceived as a surname. The suit mark appears to be invented.

15. Although the opponent's mark has been used for a considerable time, for the purposes of the comparison under section 20(1) I must consider both the applicant's and the opponent's mark in fair and notional use.

16. Miss Chow said there was a striking similarity visually between the two marks and that the differences between them are apparent only upon a side by side comparison. Marks however are not to be compared side by side, rather, imperfection recollection must be taken into account. Mr Ling did not take issue with that proposition which is widely accepted as the correct test.

17. Much has been made of the sound of the marks and the importance of the first syllable. Both counsel referred me to lengthy passages from *BULER Trade Mark* [1966] RPC 141. Miss Chow stressed that the authorities suggest that the termination of English words are often slurred and that Hong Kong people might not know that the last letter of the opponent's mark should be pronounced. This submission runs contrary to my understanding. Expert evidence was adduced on the pronunciation of Cantonese in the *ALOHA Trade Mark* case (W K

Thomson 24 July 1956). Professor Cheng there said there was no tendency in Cantonese to slur the last syllable, every syllable must be pronounced. I would expect this habit to extend to English or foreign words. I do not find authorities dealing with the way Englishmen pronounce English words to be overly helpful. Both counsel however agreed that the “h” in the opponent’s mark would be silent. Mr Ling, relying on *BULER*, said extra care is taken with surnames, i.e. de’Longhi, and one would not easily overlook the omission of the last two letters “hi” from the suit mark. Miss Chow submitted that the stylised apostrophe seen as a line over the letter “e” of the opponent’s mark would distinguish it from a surname.

18. Miss Chow also called in aid the fact that there is no Chinese version of the opponent’s mark. Whatever awareness there is of the opponent’s mark is therefore of “Dē Longhi” and not a local Chinese equivalent.

19. 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.”

20. On first impressions the opponent’s mark looks like a foreign surname the distinguishing feature being the unusual combination of the letters “ghi” at the termination of the word. I have no evidence on how the respective

marks would be pronounced locally. Doing the best I can, whilst I agree that the “h” of the opponent’s mark would be silent, I believe the “i” would be pronounced. On the visual and aural features of the two marks, taking into account imperfect recollection, the question of the likelihood of visual and aural confusion is finely balanced.

21. I turn to consider the purchasers of the respective parties’ goods. In my view the purchasers of home appliances and the purchasers of the applicant’s range of goods, particularly those that overlap, are the same people.

22. I must then consider the surrounding circumstances of trade. Would a substantial number of purchasers of the goods upon which the respective marks are used, having some, but an imperfect recollection of the Dē Longhi mark applied to electric household appliances, have reason to call to mind that mark when confronted by household articles bearing the suit mark? For the reasons given in paragraphs 33 – 36 of my decision in the corresponding opposition in Class 21, the answer is no for the applicant’s goods which are not of the same description as those protected by the opponent’s registration. The position is quite different when the overlapping goods are considered.

23. In my view the applicant’s good, which I have identified as being the same description of goods as those protected by the opponent’s registration, would be sold through the same trade channels, namely, specialist electrical appliance dealers such as Fortress and dedicated departments in department stores. The opponent’s evidence on trade channels, which I have set out in detail in the corresponding Class 21 opposition, is unsatisfactory so I have reached my conclusion on the application of common sense. The applicant lists the major department stores as outlets for its goods – paragraph 15 of the statutory declaration of Mr Cho.

24. That being so, the applicant comes up against the problem of “triple identity” – the same goods marked with a similar mark and sold in the same trade channels. The authorities have found that in such cases confusion as to origin is inevitable.

25. I am accordingly of the view that a potential purchaser of hand

drying apparatus, heating apparatus, water heaters or cookers, with a familiarity but imperfect recollection of the opponent's mark applied to electrical oil filled, fan or convector heaters, ovens and deep fryers, would be confused or at least caused to wonder whether the former are goods from the same source as the latter.

26. The opposition under section 20(1) succeeds and I must refuse registration of the suit mark.

*Opposition under section 12(1) of the Ordinance*

27. For the reasons stated above, the opposition also succeeds under section 12(1) as the actual use made by the opponent of its mark on many of its electrical appliance is exactly as registered. I set out in more detail in the corresponding Class 21 opposition the pattern discernable from the opponent's evidence, but briefly, those appliances which have a light colour are marked with a version of the mark which is in black lettering, whilst those appliances with a dark surface colour are marked with the suit mark.

28. Mr Ling submitted that the Registrar had power to accept the suit mark subject to the applicant agreeing to delete the overlapping goods from its specification.

29. Mr Ling argued that there is nothing in the language of section 20(1) to deny the Registrar such power. He argued that goods may be restricted at the *ex parte* stage to overcome a citation of an earlier registered mark raised by the examiner. After advertisement for opposition purposes the applicant and the proprietor of the earlier mark may reach agreement to restrict their respective goods to remove the likelihood of confusion in the market place. Even after registration a proprietor can strike out goods from the range for which the mark is registered pursuant to section 50(1)(d) of the Ordinance. It would be illogical, submits Mr Ling, that an otherwise meritorious mark is denied registration because of an overlap in some goods with the opponent's mark and the Registrar has no power to accept the mark subject to the deletion of the overlapping goods.

30. In relation to paragraph 10-11 of *Kerly's Laws of Trade Marks and*

*Trade Names*, which would appear to run contrary to Mr Ling's argument *viz* :

“Section [20(1)] applies where and only where either some goods or services for which the existing mark is registered and some goods or services for which the applicant seeks to register are the same ‘of the same description’, or else (where one mark is for goods, the other for services), some are ‘associated’. Thus a section [20(1)] objection cannot be removed merely by disclaiming from the application those goods or services specified in the earlier registration.”

Mr Ling submitted that the passage is unsupported by authority. The case referred to in the footnote, *Granada* [1979] RPC 303 (Regy.) does not support the proposition. The other footnote refers back to an earlier paragraph, 10-07, which commences :

“A second mark can be admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise have opposed it, on the terms that it shall be limited to part only of the Register class. The prior registrant may voluntarily cancel from his specification of goods or services those of the applicant's specification and those of the same description<sup>47</sup>; or the applicant exclude from his specification those of the prior registration and of the same description.”

Footnote 47 is in these terms :

“It is, of course, not enough just to disclaim the actual specified goods, since there will remain goods in both which are of the same description. A disclaimer actually using the words ‘of the same description as ...’ is possible, but has the disadvantage of leaving it open to argument what the registration does cover.”

31. If I understand Mr Ling's argument correctly, the first passage from *Kerly* is not therefore to be read as prohibiting the removal of goods from the

specification after opposition is entered, but rather prohibiting acceptance of a disclaimer to overlapping goods, as goods of the same description may remain in both specifications.

32. The point I think can be illustrated by the facts in *555 & device* (Teresa Grant 20.7.1998 upheld on appeal [2000] 1 HKLRD 465). The earlier mark was registered for “singlets”. The applicant applied to register its mark for “clothing, footwear, headgear” but after the earlier mark was cited against it, offered to amend to “clothing except singlets and underwear, footwear, headgear”. It was held that the amended specification was still in conflict with the earlier mark as clothes other than singlets were the same description of goods as singlets.

33. I am of the view that the final sentence of the first passage from *Kerly* does have the more limited meaning suggested by Mr Ling. That however does not end the matter.

34. Ms Chow submitted that under section 20(1), if any of the goods in the applicant’s specification overlap with those in the earlier mark, the suit mark must be rejected. It is an “all or nothing” situation. I have no discretion.

35. That must be right, and it certainly accords with the long-standing practices of the Registry’s hearing officers.

36. Section 20(1) provides :

“... 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) ....”

(my emphasis).

37. The word “any” I have highlighted is significant. The section does not use the word “all”. Had the word “all” been used the onus would be upon the opponent to show that every item in the applicant’s specification is the same description as those protected by the opponent’s registration. That is clearly not the case and the use of “any” is totally consistent with the onus being on the applicant to show that no item in its specification is the same description as those protected by the opponent’s registration.

38. Ms Chow is correct when she says I have no discretion under section 20(1), contrasted to the discretion contained in sections 21 and 23. Once opposition is entered, if the parties have not previously agreed to limit their respective specifications, it is the specification as it stands on the date of the hearing that must be tested against section 20(1) and if any of the goods of the applicant’s specification fall within section 20(1) then that trade mark shall not be registered.

39. There is further support for this view in section 37(1) where there is a specific power to remove a trade mark “in respect of any of the goods or services in respect of which it is registered” in certain circumstances. Special provision has also been made in the current Trade Marks Ordinance, Cap 559 (section 12(7)) for refusal to apply only to the goods or services where the grounds for refusal exist in respect of only some of the goods or services for which the application for registration is made.

40. I accordingly hold that I have no power to accept the suit mark subject to the deletion of overlapping goods.

*Opposition under section 13(1) of the Ordinance*

41. In its notice of opposition the opponent pleads its opposition under section 13 in this way :

“As the public would connect the Opponent’s Mark with the Applicant and create confusion, the subject application should be refused under Section 13 of the TMO.”

42. As confusion is not an element under section 13 of the Ordinance this pleading is misconceived.

43. In her written skeleton Miss Chow has this to say in support of the opposition under section 13 :

“It is submitted the Opponent is the proprietor of its mark. The Registrar shall not exercise discretion and registration of the Applicant’s Mark shall be refused.”

44. I do not believe the applicant would take issue with the first sentence but this does not advance this ground of opposition. If I do not exercise my discretion under section 13(2), the suit mark will be registered, so the second part of the second sentence is a *non sequitur*.

45. As I said earlier, Miss Chow made no oral submission at the hearing directed at section 13(1). She did however cast doubt on the *bona fides* of the applicant’s choice of the suit mark. Although, when probed as to which ground of opposition the lack of *bona fides* was directed, Miss Chow replied it was section 12(1), that is clearly wrong and I shall instead consider the evidence under my discretion to refuse registration pursuant to section 13(2) of the Ordinance.

46. The applicant was incorporated on 19 March 1992. Mr Cho declares that :

“In 1993, the Applicant launched its line of product under the mark of “DELONG” and/or (帝朗) covering, *inter alia*, the range of products in bathroom fittings, mixers, sanitary ware, massage shower sets, bathroom mirrors.

Recently, the Applicant intends to extend its services for

goods covered under class 11 and there became a need to seek for registration of its mark “DELONG” and/or (帝朗) under this class.”

47. It would seem from this statement that DELONG and its Chinese character phonetic equivalent 帝朗 were chosen from the outset as the applicant’s brand name and trade mark.

48. Miss Chow referred me to the exhibits at pages 492 and 493 of the bundle being copies of earlier trade marks registered by the applicant in Class 21. The first trade mark registered under No. 5690 of 1997 by the applicant was a word mark “DELONG 帝朗” with the device of a three pronged crown over the letter “D”. The English word appears all in capital letters and exactly in the script used in the suit mark. There is no background or border. The application date would appear to have been 14 November 1995.

49. Shortly thereafter, on 20 December 1995, the applicant filed a second application (subsequently registered under No. 4715 of 1997). This trade mark features the word “DELONG” in a different script enclosed in a rectangular border. The “O” looks exaggerated as it is a full circle whilst the other letters are elongated and narrow. The “O” features also as a device reminiscent of the view through a port hole of a ship at sea. Two Chinese characters, one above the other and together representing half the height of the English letters are squashed into the upper right corner of the mark. These characters, “迪朗” (pronounced “TIK LONG”) are different to those of the first mark i.e. “帝朗”(pronounced “DAI LONG”).

50. To complete the chronology, on 8 April 1998 the applicant applied to register the characters “帝朗” in Classes 6, 9, 11, 19, 20, 21, 24 and 27. On the same day, or in the case of the Class 14 application, on 12 May 1995, the applicant applied to register the suit mark in Classes 6, 9, 11, 14, 19, 20, 21, 24 and 27. The opponent entered opposition to the applications of the latter group in Classes 11 and 21 only. The remainder proceeded to registration.

51. Miss Chow commented that it was suspicious that the applicant changed its mark from the stylised “O” “迪朗” (No. 4715 of 1997) mark to the suit mark. The applicant has offered no explanation for this change. In the

absence of an explanation, Miss Chow submitted I was entitled to draw the inference that the stylistic change was to have the suit mark more closely resemble the opponent's mark. Miss Chow relied upon *Re Wowi & Device Trade Mark* [1998] 3 HKC 221 at 237 B-E, a passage which Miss Chow conceded was *obiter dictum*, and upon *Slazenger & Sons v Feltham & Co* (1889) 6 RPC 531.

52. The facts of the latter case can be distinguished. There the plaintiff's goods were marked "The Demon" and were known as "Demon racquets". The defendant made an identical racquet. The defendant admitted looking through a dictionary for the entry "Demon" and wanted to see how near he could go to that word without actually taking it. He came upon "Demotic" and adopted that word. It had been argued that "Demon" described a particular kind of racquet. If that was so, the court asked, rhetorically, how could "Demotic" describe that particular kind of racquet? The court concluded that the defendant's motive was not to describe a particular kind of racquet but to go as closely as he thought he could safely go to the plaintiff's established trade mark. It is in that context that the court said that if, in the exercise of common sense there was an intention to deceive, why should the court not credit with occasional success that which the defendant was straining every nerve to do.

53. Mr Ling said that if the marks are not similar, the applicant is under no obligation to explain anything.

54. There is no challenge on the grounds of bad faith specifically made in the notice of opposition or in the statutory declaration of Mr de'Longhi filed under Rule 25. The applicant filed its evidence in support of the mark in the light of the opposition disclosed. It had no reason to explain the provenance of its mark when no challenge had been made. It was not until the second statutory declaration of Mr de'Longhi was filed pursuant to Rule 27 that he raises the issue that "the applicant has not illustrated, explained or disclosed the reasons for employing the Applicant's Mark. I suspect that the Applicant has seen or read of the Opponent's promotions and advertisements worldwide and copied the same for its own use." (paragraph 4).

55. This "submission" and suspicion is not evidence and, as it is also not evidence strictly in reply to the applicant's evidence, the applicant could safely

ignore it as I do. The opponent did not avail itself of the opportunity to seek leave to cross-examine Mr Cho and in the absence of such cross-examination, I am not prepared to infer commercial dishonesty on the part of the applicant or its officers – see *Re Borsalini Trade Mark* [1993] 1 HKC 587 at 592 B-F.

56. There being no other reason to refuse the suit mark in the exercise of my discretion under section 13(2), I decline to do so.

*Costs*

57. 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 and incidental to these proceedings.

58. 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.

(K.S. Kripas)  
p. Registrar of Trade Marks  
2 May 2003