

Application No. 06173 of 2000

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

AND

IN THE MATTER of application for the
registration of the trade mark

JOVAN

In Part A in Class 3 by Alexander Satryo
Wibowo

DECISION

OF

Miss Lavinia Chang acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's decision made by Messrs Robin Bridge and John Liu on behalf of the applicant.

BRIEF SUMMARY

Trade Mark – application for registration of JOVAN – section 20 objection based on earlier registrations JOVAN and JOVAN WHISPER OF MUSK – triple identity – application to be refused.

Evidence filed pursuant to section 22 – considerations in exercise of discretion – whether concurrent use proved – issue of honesty – public inconvenience and relative inconvenience – conditions or limitations impracticable – no applicable special circumstances under section 22 - discretion not exercised.

Trade Marks Ordinance sections 20, 21, 22 and 24.

Cases referred to :

Re Smith Hayden & Co. Ltd.'s Application (1946) 63 RPC 97

Jellinek's Application (1946) 63 RPC 59

Australian Wine Importers (1889) 41 Ch D 278

Wertheimer's Trade Mark (1924) 41 RPC 454

Pianotist Co.'s Application (1906) 23 RPC 774

Sandow's Application (1914) 31 RPC 196

"GE" Trade Mark [1973] RPC 297

Alex Pirie & Sons' Application (1933) 50 RPC 147

BALI Trade Mark (No.2) [1978] FSR 193

Re Borsalini Trade Mark [1993] 1 HKC 587

Bainbridge's and Green & Co. Ltd.'s Application (1940) 57 RPC 248

Peddie (1944) 61 RPC 31

Hack's Application (1940) 58 RPC 91

1. On 22 March 2000 (the “application date”), Alexander Satryo Wibowo (the “applicant”) applied to register in Part A of the Register, the trade mark “JOVAN” (the “subject mark”) in Class 3 in respect of (after an authorised amendment), “body spray perfumes, cosmetics, deodorant spray perfumes, hair lotions, shampoos, lipsticks.”

2. By letter dated 29 May 2000, the Registrar of Trade Marks issued an examination report objecting to the application as offending section 20 of the Trade Marks Ordinance (the “Ordinance”) by reason of conflict with two prior registrations (the “citation objections”), details of which are as follows :

<u>Mark</u>	<u>Proprietor</u>	<u>Registration No.</u>	<u>Class</u>	<u>Date of Registration</u>	<u>Specification</u>
JOVAN	Quintessence Incorporated	0677 of 1978	3	18 June 1977	perfume, perfume essence, cologne, aftershave lotions, toilet water, bath preparations, talcum powder, nail polishing preparations, shampoo, soaps and body lotions
JOVAN WHISPER OF MUSK	Quintessence Incorporated	1888 of 1986	3	20 August 1984	non-medicated toilet preparations, cosmetics, perfumes, eau de colognes, anti-perspirants, deodorants for personal use, hair preparations and soaps all containing musk as an ingredient or being musk-scented

3. Objection was initially also taken under section 21 of the Ordinance by reason of conflict with pending application no. 10674 of 1998 for registration of JOVAN SEX APPEAL, which had a prior filing date of 11 August 1998, in respect of goods in Class 3, viz. “soaps for personal use; perfumery, essentials oils; beauty and body care preparations; cosmetics; hair care preparations”. This objection was later declared invalid as pending application no. 10674 of 1998 had been withdrawn. For the purpose of these written grounds of decision, the only relevant citation objections are the two earlier registrations for JOVAN and JOVAN WHISPER OF MUSK (“the cited marks”) registered in respect of the

same class of goods.

4. Under cover of letter dated 13 February 2001, the applicant filed evidence to overcome the citation objections relying on the applicant's alleged long and extensive use of the subject mark in Hong Kong. The evidence of use consisted of a statutory declaration dated 30 January 2001 by S H Mochtar, the legal officer of the applicant (the "Mochtar declaration").

5. In paragraph 4 of the Mochtar declaration, it is stated that the applicant had used the mark continuously in Hong Kong since 23 October 1994 in respect of goods in Class 3 particularly upon and in relation to perfumes. It is also stated that such goods had been supplied and sold by the applicant for the five years immediately preceding the date of application, as follows :

Year	Value
1995	US\$2,049
1996	US\$1,989
1997	US\$2,136
1998	US\$1,287
1999	US\$426

The total value of sales in local currency amounted to HK\$61,518.

6. By letter dated 4 June 2001 the Registrar pointed out that an average annual sales figure of around HK\$12,303 was not sufficiently impressive. This is so especially because, by deduction, there were not many transactions in total of purchase of goods bearing the subject mark. To take an example, on one single invoice dated 17 January 1995, the total sales recorded of goods bearing the subject mark reached US\$396 (approximately HK\$3,000), when the annual sales for the whole of 1995 were a mere US\$2,049.

7. The evidence therefore does not demonstrate that the subject mark had acquired sufficient user awareness to overcome the confusion likely to ensue from the resemblance to the citation objections. Because the mark shares the same element "JOVAN" as in the two cited registrations, and because the applicant's verified goods of

interest, namely, perfumes, coincided with the goods covered by the two cited marks, the Registrar considered that confusion would likely result.

8. It is in respect of the Registrar's decision communicated in the letter dated 4 June 2001 that I am asked to state in writing, pursuant to Trade Marks Rule 20(2), the grounds of that decision and the materials used in arriving thereat.

Decision

9. Section 20 of the Ordinance, insofar as is relevant to this matter, is in the following terms :

“(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; ..”

The expression “nearly resembles” is defined in respect of a resemblance of marks in section 2(4) to mean a resemblance “so near as to be likely to deceive or cause confusion”.

10. Section 22, insofar as is relevant to this matter, is in the following terms :

“In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or of the Registrar make it proper to do so, the Court or the Registrar may permit the registration by more than one proprietor, in respect of –

- (a) the same goods or services;
- (b) the same description of goods or services; ...

of trade marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.”

11. The test as to whether a new mark is likely to conflict with registered marks is that propounded by Evershed J in *Re Smith Hayden & Co. Ltd's Application* (1946) 63 RPC 97 at 101. Adapted to the instant case, the formulation may be expressed thus:

“Assuming user by Quintessence Incorporated, the cited proprietor (“Quintessence”) of their mark “JOVAN” and “JOVAN WHISPER OF MUSK” in a normal and fair manner for any of the goods covered by the registrations of these marks (and including particularly goods also covered by the proposed registration of the mark “JOVAN”), is the Registrar satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if Alexander Satryo Wibowo also uses his mark “JOVAN” normally and fairly in respect of any goods covered by his proposed registration?”

If the answer to that enquiry is in the affirmative, I am bound to refuse the mark for registration. I do not have a discretion, save where there is evidence of “honest concurrent use, or of other special circumstances”, triggering the application of section 22. Against those considerations, I must first decide whether the subject mark and the cited marks are identical or nearly resembling each other.

(a) *Trade Mark No.0677 of 1978 JOVAN*

12. Although differing slightly in the typeface used there can be no serious argument that the subject mark is not identical with Trade Mark No. 0677 of 1978 JOVAN, either visually or aurally.

13. I next turn to compare the goods in respect of which the subject mark and Trade Mark No.0677 of 1978 JOVAN are registered. The applicant’s goods of interest are “body spray perfumes, cosmetics, deodorant spray perfumes, hair lotions, shampoos, lipsticks”. The operation of section 20 hinges on whether the goods of the cited marks and the applied for goods are the same or of the same description. The test to be applied as to whether the goods are “of the same description” is a factual one, having regard to the nature of the goods, the uses thereof and the trade channels through which they are bought or sold (*Jellinek’s Application* 63 RPC 59). The question to ask is whether the two sets of goods are so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it used in relation to the other, would be likely to suppose that it was so used also to indicate they were his? (*Australian Wine Importers* (1889) 41 Ch D 278 at 281, *per Kay J*)

14. I note that “shampoos” are common to both specifications. I also regard the

applicant's "body spray perfumes" and "deodorant spray perfumes" to be of the same nature as Quintessence's "perfume, perfume essence, cologne, after shave lotions and toilet water", all being toiletry products for personal care and hygiene. I draw support, in so saying, from *Wertheimer's Trade Mark* (1924) 41 RPC 454 where it was found that perfumes and perfumed face powder were goods of the same description.

15. Based on the fact that these are personal care and hygiene products, it is likely that Quintessence's goods and those of the applicant are sold through the same trade channels, such as chemist shops, perfume and cosmetics outlets. The applicant has not placed any information before me to suggest otherwise. It may be that the applicant's goods are found in supermarkets and other self-service outlets of a similar nature, whereas slightly more sophisticated personal care products such as those covered by Quintessence's specification are not. In my view, however, customers may quite legitimately assume that the applicant's goods are a natural extension of Quintessence's JOVAN line of perfumes, colognes, and aftershave lotions, etc. I have no information on how the respective marks are actually used. However, the authorities are clear that it is the notional, or legitimate statutory rights of use rather than the actual modes of use that are to be compared for the purpose of section 20 (*Smith Hayden, supra*).

(b) *Trade Mark No. 1888 of 1986 JOVAN WHISPER OF MUSK*

16. Although it is not strictly necessary to do so, I will compare briefly the subject mark with Trade Mark No. 1888 of 1986 JOVAN WHISPER OF MUSK for its propensity to cause deception or confusion. I must have regard to the look and sound of the respective marks, the goods to which they are applied, the nature and kind of customer who would be likely to buy those goods, and any other relevant circumstances (*Pianotist Co's Application* (1906) 23 RPC 774 at 777).

17. JOVAN WHISPER OF MUSK is made up of four separate, distinct words compared with one in the subject mark. The word JOVAN has no known dictionary meaning in the current English language. It is positioned at the front of the mark giving it relative prominence. The rest of the mark consists of the words "WHISPER OF MUSK". The choice of "WHISPER OF MUSK" suggests that the products are musk-scented. As a condition of registration, the exclusive right to use these three words has been expressly disclaimed. Disclaimers are, generally speaking, imposed on that part of a mark which is considered to lack sufficient distinctive character to serve as a badge of origin, or which

consists of matters which should be reserved for bona fide use by other traders in connection with their business. As a preliminary remark, it is fair to say that Quintessence, the registered proprietor of JOVAN WHISPER OF MUSK, agrees that the distinctive element lies in the word “JOVAN” rather than “WHISPER OF MUSK”. I find the word “JOVAN” to be distinctive, to occupy a relatively prominent position in the mark, and is the leading feature of the mark.

18. It is well established that in comparing conflicting marks, a tribunal should consider whether “the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection” (*Sandow’s Application* (1914) 31 RPC 196, per Sargant J at 205).

19. In my view, armed only with a general recollection of JOVAN WHISPER OF MUSK, the prospective customer is very likely to regard JOVAN WHISPER OF MUSK as a line of musk-scented products sold under the “house” trade mark JOVAN.

20. Turning to the specified goods, the authorities make clear that for the purpose of section 20, I am to assume that the proprietor of the cited marks would use the marks to the full extent of the goods in respect of which the marks are registered (*Smith Hayden, supra*). On that basis, I find that the applicant’s wider specification encompasses that of Trade Mark No. 1888 of 1986. The applicant’s “body spray perfumes, cosmetics, deodorant spray perfumes” are broad enough to cover Quintessence’s more restricted “cosmetics, perfumes, eau de colognes, anti-perspirants, and deodorants for personal use all containing musk as an ingredient or being musk scented”. By the same token, the applicant’s “hair lotions” and “shampoos” encompass Quintessence’s “hair preparations containing musk as an ingredient or being musk scented”. “Cosmetics” are common to both the subject mark and Trade Mark No. 1888 of 1986. The applicant’s “lipsticks” rightly belong under the heading of “cosmetics”, and is therefore covered by Trade Mark No 1888 of 1986.

21. For the above reasons, I come to the view that the likelihood is that members of the public would be caused to wonder whether the goods in relation to which the subject mark is used or proposed to be used came from the same source as the goods marketed under Quintessence’s JOVAN and JOVAN WHISPER OF MUSK. This is in fact consistent with the Registrar’s position vis-à-vis the two cited marks since, as a condition for registration,

Quintessence's JOVAN and JOVAN WHISPER OF MUSK are required to be associated pursuant to section 24 of the Ordinance. Subject, therefore, to the application of section 22 (which I address below), I must refuse registration of the subject mark under section 20.

Section 22 of the Ordinance

22. The applicant has filed evidence by way of the Mochtar declaration, for the purpose of overcoming the citation objections by reason of the applicant's purported "long and extensive use" of the subject mark in Hong Kong. I take it that the applicant's intention is to proceed under section 22.

23. Lord Diplock expounded on the genesis of section 22 in "*GE*" *Trade Mark* [1973] RPC 297 at 326. In a nutshell, it evolved out of the consideration that

"the interest of the public in not being deceived about the origin of the goods [has] to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill ... Under this doctrine a trade mark remained entitled to protection in cases where the use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events which did not involve any dishonesty or other wrongful conduct upon the part of the proprietor of the mark."

24. The principal matters to be taken into account in the exercise of discretion under section 22 are set out in *Alex Pirie & Sons' Application* (1933) 50 RPC 147, as adopted in *BALI Trade Mark (No. 2)* [1978] FSR 193 and in Hong Kong, in *Re Borsalini Trade Mark* [1993] 1 HKC 587 at 593, viz.:

- (a) the extent of use in time and quantity and the area of the trade;
- (b) the degree of confusion likely to ensue from the resemblance of the marks;
- (c) whether any instances of confusion have in fact been proved;
- (d) the honesty of the concurrent use; and
- (e) the relative inconvenience which would ensue if the mark was registered, subject if necessary to any conditions and limitations.

25. My discretion under section 22 is unfettered and, if justified in the relevant circumstances, registration may be allowed even where the probability of confusion is considerable. However, even though my discretion tempers the severity of section 20, the general burden of justifying registration under section 22 still rests with the applicant.

26. Having thus set the parameters of my discretion, I come to the view that, insofar as the subject application is identical to Trade Mark No 0677 of 1978 JOVAN, be it the mark itself, the goods or the trade channels through which these goods are sold, confusion is virtually certain (the oft-quoted “triple-identity” scenario propounded in *Bainbridge’s and Green & Co Ltd’s Application* (1940) 57 RPC 248). In those circumstances it is somewhat futile to embark on an enquiry on each of the considerations for establishing honest concurrent use. However, even if I was wrong in that view, for the reasons that follow I do not think that my discretion ought to be exercised in favour of the applicant.

27. According to the evidence, the proved sales figures related only to perfumes, while the use of the subject mark on the other goods claimed have not been verified. If there is no evidence of concurrent use, section 22 does not avail the applicant in respect of the goods in his specification other than perfumes. I also note that the evidence shows that all sales were made to one K H Chan (and to no one else), in Stanley Street, Central, as the applicant’s Hong Kong agent. There is no information before me showing the degree of penetration of the subject mark in the particular sector of the market, either from the trade or customers, upon which I might find that perfume sprays marked JOVAN were associated with the applicant. Furthermore, the invoices show not just the sale of products marked JOVAN but also of a number of other brands, for example, “Anaiso”, “Tiara”, “Cucci”, “Jacomo”, “Derrick” and “One Man Show”. With such a range of marks in the applicant’s repertoire, it is doubtful if the subject mark could have, as the Mochtar statutory declaration states, come to “signify to the trade and general public goods manufactured and exported by the applicant” (paragraph 8 thereof).

28. I have already found that because “triple-identity” obtains in this case, confusion is virtually certain. In the exercise of my discretion, the degree of confusion is to a large extent indicative of the measure of public inconvenience. If there was very little likelihood of public inconvenience, there would be no good reason to refuse registration of the subject mark. I have found the local sales of the applicant’s JOVAN perfume sprays to have been of a small scale. It may then be open to the applicant to argue that there is no actual confusion.

29. In contested proceedings, each party may be expected to file evidence proving instances of actual confusion or otherwise. In an *ex parte* application, the factor of actual confusion loses its significance, as this is one area where one would not reasonably expect an applicant to file evidence against his own interests. I have no information suggesting that the cited marks are not in use, such as may come within the consideration of “other special circumstances” in my enquiry under section 22 (*Peddie* (1944) 61 RPC 31 at 37). Indeed, the negligible sales made of perfume sprays bearing the subject mark means that actual instances of confusion were somewhat unlikely. However, this overlooks the fact that, one must take into account all legitimate uses which Quintessence may reasonably make of its marks (*Hack’s Application* (1940) 58 RPC 91 at 103), even if only in relation to perfume sprays (the use of which the evidence supports). I take note that Trade Mark No 677 of 1978 JOVAN was registered (18 June 1977) nearly 23 years, and Trade Mark No. 1888 of 1986 JOVAN WHISPER OF MUSK (20 August 1984) nearly 16 years prior to the application date. In the light of that information, I consider the relative inconvenience to Quintessence would be the greater should the subject mark be allowed registration.

30. I also respectfully follow Godfrey J’s view in *Re Borsalini Trade Mark* [1993] 1 HKC 587 at 593H, that the public would be seriously inconvenienced if both the applicant and Quintessence were granted the right to market their perfume sprays under marks which are identical or virtually identical.

31. I do not find the consideration under (d) assists greatly. There is no evidence tending to show either that JOVAN was chosen with knowledge of the cited marks or arrived at independently. All that the Mochtar declaration says on this point is that the applicant first used the subject mark in Indonesia in January 1990 in respect of perfumes he manufactured and sold. There is no material upon which to raise an issue of dishonesty either. However, I cannot rule out entirely the possibility of copying, intentional or otherwise, as the applicant began use in Hong Kong only in 1995, that is to say, 18 years after Trade Mark No 677 of 1978 JOVAN was registered (18 June 1977) and 11 years after Trade Mark No. 1888 of 1986 JOVAN WHISPER OF MUSK was registered (20 August 1984).

32. In my view, the single consideration that the public would be seriously inconvenienced by the confusion engendered, would weigh heavily against registration. I have considered whether conditions or limitations on the applicant’s use would reduce confusion to an acceptable level. However, the position would remain unsatisfactory as the only concurrent use proved relates to perfumes, an item covered by both cited marks. A

geographical limitation is hardly practicable in a highly compact city such as Hong Kong. Accordingly, I am not satisfied that the discretion under section 22 ought to be exercised in favour of the applicant.

33. The applicant has not drawn the Registrar's attention to any applicable "special circumstances" under section 22.

34. As the applicant has not discharged his onus under section 22, the subject mark has to be refused registration under section 20.

35. In this decision I have taken into account all the material available to me, *viz.* the applicant's evidence and its correspondence with the Registrar, and all the authorities I have referred to above.

Signed

(Lavinia Chang)
p. Registrar of Trade Marks
5 February 2002