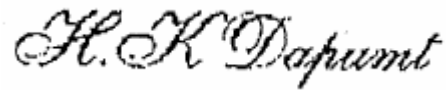


Application No. 20817/2001

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

AND

IN THE MATTER of an application by
Hong Kong Duopent Garment Limited
to register the mark

The logo is a stylized cursive script that reads "H.K. Dupont". The letters are elegant and interconnected, with a classic, handwritten feel. The "H" and "K" are particularly prominent and stylized.

in Part A of the Register in Class 25

AND

IN THE MATTER of an opposition
thereto by S.T. Dupont

**DECISION
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on
17 July 2007.

Appearing : Mr Ling Chun Wai instructed by Messrs Wilkinson & Grist for the
opponent.

Application for registration

1. On 27 December 2001 (“the application date”), Hong Kong Duopent Garment Ltd. (“the applicant”) applied to register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 (“the Ordinance”), in Part A of the register in Class 25, the trade mark, a representation of which as appears below :



(“the suit mark”).

2. The goods intended to be covered by the registration were “clothing, headgear, footwear” (“the specified goods”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part A of the register subject to a disclaimer of the letters “H.K”. The application was advertised in the Government of the Hong Kong Special Administrative Region gazette on 12 April 2002.

Pleadings and evidence

3. On 13 June 2002, S.T. Dupont (“the opponent”) filed notice of opposition to the application. The grounds of opposition state, *inter alia*, that the opponent is a societe anonyme organised and existing under the laws of France. The opponent’s trade mark and trade name “S.T. DUPONT” was adopted after the initials of its founder Mr Simon Tissot-Dupont. The opponent has used the opponent’s mark in Hong Kong since 1961 in respect of lighters and since 1989 in respect of clothing. Substantial advertising expenses have been incurred for the promotion of the opponent’s mark worldwide including Hong Kong. Further, the opponent’s goods under the opponent’s mark have been widely and substantially sold worldwide including Hong Kong. As a result, substantial goodwill and reputation has been established in the opponent’s mark which has become identified with the opponent and its products and none others. The opponent has engaged a lot of efforts and incurred substantial expenses in obtaining and policing registrations for the opponent’s mark in many countries throughout the world. In particular, the opponent has registered the opponent’s mark in Class 25 in France which is the country from which the opponent’s goods bearing the opponent’s mark originate. In

Hong Kong, the opponent has applied for the registration of the opponent's mark in respect of clothing for men in Class 25 under application No. 6701 of 1994 which is a corresponding application to the opponent's home country registered mark under French registration No. 1493637. The opponent pleads that the Hong Kong application was filed on 20 June 1994 and gazetted for opposition on 2 August 1996. The opponent undertakes to take all necessary steps to complete the Hong Kong application pursuant to section 23 of the Ordinance.

4. It is the opponent's case that the suit mark is confusingly similar to the opponent's mark. The script used for the suit mark is almost identical to that used by the opponent's mark. The specified goods are the same goods or goods of the same description as those of interest to the opponent. In the premises, use and/or registration by the applicant of the suit mark will cause confusion or mistaken belief amongst the general public who will be misled into believing that the applicant's goods bearing the suit mark are originated from or connected in course of trade with the opponent. Further, the applicant was incorporated with the word "DUOPENT" as a distinctive part of its company's name. The word "DUOPENT" closely resembles the word "DUPONT" in the opponent's mark. The Chinese name of the applicant's company is 香港都彭服飾有限公司 which incorporates "都彭". The two Chinese words "都彭" which form the distinctive part in the applicant's name are phonetically the same and visually similar to "都彭" which is the Chinese version of the opponent's mark and indeed "都彭" is also the registered Chinese trade mark of the opponent in Hong Kong. The applicant is clearly and unfairly usurping the rights and interests of the opponent in its trade name and mark. The applicant is acting in bad faith by reason of the above. The grounds of opposition comprise sections 2(1), 9, 10, 12, 13, 20 and 23 of the Ordinance.

5. In the applicant's counter-statement, the applicant states, *inter alia*, that the spelling and pronunciation of the suit mark and the opponent's mark are entirely different. The opponent's mark has been in use internationally for a long time and widely recognised by the consumers. Moreover, the applicant and the opponent aim at totally different target markets. The opponent's goods are upmarket products whereas the applicant's goods are casual clothing. In addition, the meanings of the respective marks are entirely different. The opponent's mark stands for the initials of the founder of the opponent whereas the suit mark consists of a complete meaning on its own. In the light of the aforesaid, there is no possibility that the consumers will be confused.

6. Trade Marks Rule/s Cap. 43, Sub. Leg. (“Rule/s”) 25 evidence consists of a statutory declaration from Mr William Christie, the president of the opponent, together with exhibits, which was declared on 14 April 2004 (“Christie’s statutory declaration”). The applicant, though it was entitled to do so pursuant to the provisions of Rule 26, filed no evidence.

Decision

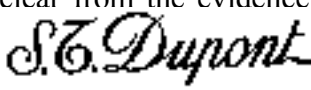
7. Though, by 17 July 2007, the date the matter was heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of sections 10(1) and 10(2) of Schedule 5, oppositions to registrations still pending as of 4 April 2003 are to be determined under the provisions of the repealed Ordinance, Cap. 43.

8. Although a number of grounds were pleaded in the notice of opposition, Mr Ling for the opponent indicated at the hearing that the opponent only relies on the grounds under sections 2(1), 12(1), 13(2) and 23 of the Ordinance for the present opposition proceedings.

Under section 12(1)

9. Before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its marks. At its very highest, it is a question of a substantial proportion of the interested public being aware of its marks, and at its very lowest, the question relates to the significance of the numbers in relation to the market for particular goods. In any event, the reputation of the opponent must be something more than *de minimis* (*Re Da Vinci Trade Mark* [1980] RPC 237). The date at which this reputation in its mark or marks are to be established is the date of the application to register the suit mark, viz : 27 December 2001 – *NOVA Trade Mark* [1918] RPC 357 at 360.

10. Mr Ling submitted that given opponent’s reputation in Hong Kong and internationally, and in particular its trading history in Hong Kong going back to 1961, there can be little doubt that the opponent possessed sufficient reputation at the date of application to oppose the application.

11. In my judgment, it is clear from the evidence that the opponent’s mark “S.T. Dupont” in the stylised form  (“the opponent’s mark”)

was first used by the opponent in Hong Kong in respect of lighters in or around 1961. Relevant sample invoices showing the sales of the lighters bearing the opponent's mark in Hong Kong were produced in exhibit "WC-8" to Christie's statutory declaration. As shown by the copy sample invoices exhibited in "WC-11", the opponent had in the 1970s and 1980s branched into the business of selling pens, watches and leather goods bearing the opponent's mark in Hong Kong. Since 1989, the opponent has used the opponent's mark continuously in respect of clothing, specifically men's ready-to-wear in Hong Kong. Substantial sales figures for the opponent's clothing under the opponent's mark in Hong Kong from 1997 up to the date of application were given in paragraph 34 of Christie's statutory declaration and copies of sample sales invoices verifying the sales were produced in the exhibit marked "WC-12". The opponent's mark had prior to the application date been extensively used in Hong Kong and advertisements of the opponent's mark appeared in press, the television, circulars to the trade, exhibitions, posters and various other means. The amounts expended in making the opponent's mark known in Hong Kong are significant. Relevant sample promotion and publicity materials and invoices for advertising expenses were produced in the exhibits marked "WC-13" and "WC-13A" respectively. As illustrated in the evidence produced in the exhibit "WC-14", the opponent's mark had been used on the goods themselves, labels, hanging tags, products descriptions and catalogues and in the promotion, sale and advertising materials of the opponent.

12. On the evidence, I am satisfied that the opponent has established a reputation at the application date in Hong Kong in respect of the opponent's mark for lighters, pens, watches, leather goods and men's clothing which is both very long and substantial. The onus then shifts to the applicant to show that there is no reasonable likelihood of deception and confusion. In the present case, the applicant has adduced no evidence to discharge this burden.

13. It is well established that the test to be used in applying section 12(1) is that stated by Evershed J. in *Smith Hayden & Co's Application* (1946) 63 R.P.C. 97 at 101. The test under section 12(1), adapted to this application, is as follows :

"Having regard to the reputation of the opponent's mark *S.T. Dupont* in respect of lighters, pens, watches, leather goods and men's clothing, is the Registrar satisfied that the suit mark, if used in a normal and fair manner in respect of the specified goods will not be reasonably likely to cause deception and confusion

amongst a substantial number of persons? May a number of people be caused to wonder whether the goods under the respective marks come from the same source? Is there a real tangible danger of confusion if the applied for mark is put on the Register?"

14. In my opinion, under section 12(1), as apparent from the formulation of the *Smith Hayden* test, the comparison is between the opponent's mark in actual use and the suit mark in a notional fair use. As pointed out above, on the evidence, the opponent's mark "S.T. Dupont" in stylised form has been used. A representation of the mark is shown in paragraph 11 above.

15. Mr Ling submitted that phonetically, the words "Dupont" in the opponent's mark and "Dapumt" in the suit mark share three common consonants, that is, "D", "P" and "T" with slightly different vowels. Both the words have two syllables. One is pronounced as "Du-pont" and another as "Da-pumt". They do sound confusingly similar. Visually, Mr Ling submitted, the most eye-catching elements are the capitalised letters. In their stylised form, each of the letters "S.T." and "H.K." exhibits a distinctive round twirl in flowery writing. The ornate script obscures any remaining differences between "Dupont" and "Dapumt" making the two essentially indistinguishable. On the whole, Mr Ling contended that the respective marks are written in a very similar way. When the principle of imperfect recollection is taken into account, the two marks look very similar.

16. In my judgment, the whole picture on each of the respective marks has to be considered. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the part or parts is enough to make the whole dissimilar (*Kerly's Law of Trade Marks and Trade Names*, 12th Edition, paragraph 17-11). The overall arrangement and layout of the respective marks are very similar. Both marks consist of two initials at the beginning followed by a six-letter word in the format of "D-p--t". The mode in which the various parts of the respective marks are put together is the same. Judging the general effect of the respective marks as a whole, I consider that the overall impressions created by them are very similar. The differences in the parts of each mark are not sufficient to make the whole dissimilar.

17. Visually, it is well settled law that the question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion

and deception. The question should be whether an intending purchaser perceives the suit mark in the absence of the opponent's and based on only his general recollection of the idea of the latter, will be liable to be deceived or confused that the two are the same or come from the same source or wonder whether that might not be so. Although the beginning two initials and the actual spelling of the word "Dupont" and "Dapumt" are not the same, the way in which the initials and words are presented is more or less the same. There is also a high degree of similarity in the writing style and the scripts used. On first impression and taking into account of the principle of imperfect recollection, I am of the view that they look similar to each other and convey more or less the same visual impact.

18. I must also consider how the respective marks may appear when applied to clothing. When applied to clothing, the respective marks are very likely to be applied on the labels on clothing which are generally embroidered and small in size and therefore less distinct than the respective marks as they appear on paper. This renders the possibility of visual confusion more likely.

19. Turning to the aural comparison, I consider the correct approach 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."

20. There is no evidence before me on how the respective marks would be pronounced. To my mind, I believe that when the respective marks are pronounced or referred to by the intending purchasers, focus should be placed on the words "Dupont" and "Dapumt" rather than on the initials "S.T." and "H.K." respectively. "Dupont" and "Dapumt" are words of the same length with two syllables. As submitted by Mr Ling, they also share three common consonants "D", "P" and "T". In my opinion, while the similarity may not be as great as that identified in the visual

comparison, the respective marks do share a certain degree of similarity in pronunciation.

21. As the respective goods of the applicant and opponent, ready-made clothing, are always purchased over the counter by self-selection, rather than being ordered orally, I would say that the visual similarity is relatively more important than the aural similarity in the present case.

22. I now move on to consider the goods in respect of which the marks are to be applied. The specified goods in this case are clothing, headgear and footwear. The opponent's goods are lighters, watches, pens, leather goods and men's clothing. The applicant's and the opponent's goods do overlap so far as clothing is concerned. In the counter-statement, the applicant pleads that the applicant and opponent aim at totally different target markets. The opponent's goods are upmarket products whereas the applicant's goods are casual clothing. That does not assist the applicant. It is trite law that I must assume that the suit mark would be used in a normal and fair manner for all the goods covered by the application in question. This would include use of the suit mark in respect of clothing which is aimed at the upper end of the market. The present application has to be considered on the basis that the parties may meet at the same market and have the same trade channels. The applicant may not at present offer goods under the suit mark in direct competition with opponent's present goods, but that is not the issue for there is nothing in its specification that would preclude it from rightfully doing so in the future. As the goods of the parties overlap, it follows that the nature and kind of purchasers likely to buy the parties' goods are the same. Goods in the nature of the parties' goods are generally purchased with normal care and attention only, and purchasers will make no more than averagely intelligent examination of the marks.

23. In the light of the visual and aural similarities between the marks and the similarities in the overall arrangement and layout, 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 wondering whether or not that might be so if the marks are applied to the same goods.

24. It follows that the section 12(1) opposition succeeds.

Under sections 2(1) and 23(1)

25. Having decided the opposition under section 12(1), I do not think I need to consider the opposition under these sections and go through the matters put to me in argument thereon.

Under section 13(2)

26. As the opponent has succeeded in the opposition under section 12(1), the exercise of my discretion under section 13(2) of the Ordinance does not arise.

Costs

27. 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.

28. 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. 4) as applied to trade mark matters, with one counsel certified, unless otherwise agreed between the parties.

Original Signed

(Ms Fanny Pang)
p. Registrar of Trade Marks
3 September 2007