

Application No. 4855 of 2002

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

AND

IN THE MATTER of an application by  
Hyundai Mobis to register the mark

**MOBIS**

in Part A of the Register in Class 12

AND

IN THE MATTER of an opposition  
thereto by Mobil Petroleum Company  
Inc.

**DECISION  
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on  
12 March 2009.

Appearing: Mr Felix Pao instructed by Messrs. Wilkinson & Grist for the  
opponent.

## **Application for Registration**

1. On 9 April 2002 (“the application date”), Hyundai Mobis (“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 12, the trade mark, a representation of which appears below :

**MOBIS**

(“the suit mark”).

2. The goods intended to be covered by the registration were “air bag modules for automobiles, air cleaner filter for automobiles, air conditioners for automobiles, air pumps for automobiles, alarms for backward motion of automobiles, alternators for automobiles, brake disks for automobiles, brake forks for automobiles, brake linings for automobiles, brake shoes for automobiles, burglar alarms for automobiles, chassis for automobiles, clutch disks for automobiles, compressors for automobiles, condensers for automobiles, crank cases for automobiles, disk brake pads for automobiles, door panels for automobiles, driving chains for automobiles, electric motors for automobiles, electromotive chains for automobiles, electromotive shafts for automobiles, electronic control units for automobiles, engine oil filters for automobiles, engine overhaul gaskets for automobiles, engines for automobiles, exhaust pipes for automobiles, fender panels for automobiles, fog lamps for automobiles, front bumper covers for automobiles, front bumper grills for automobiles, front bumper rails for automobiles, front bumpers for automobiles, front mask for automobiles, fuel filters for automobiles, gear boxes for automobiles, gears for automobiles, grill cover for automobiles, head lamps for automobiles, head rests for automobiles, heat control boxes for automobiles, hood panels for automobiles, hood protectors for automobiles, horns for automobiles, idle speed control servos for automobiles, instrument panels for automobiles, links for automobiles, luggage racks for automobiles, mudguards for automobiles, mufflers for reducing noise of exhaust gas in automobiles, overhaul seals for automobiles, quick connectors for automobiles, radiator grills for automobiles, radiators for automobiles, rear bumper covers for automobiles, rear bumpers for automobiles, rear combination lamps for automobiles, rearview mirrors for automobiles, remote keyless entrys for automobiles, rims for wheels of automobiles, roller chain for automobiles, roof carriers for automobiles,

rubber belts for automobiles, safety belts for the seats of automobiles, safety seat for children for automobiles, seat covers for automobiles, seats for automobiles, servomotor for automobiles, shafts for automobiles, shock absorbers using oil pressure and spring force for automobiles, shock absorbing springs for automobiles, short engines for automobiles, side mirrors for automobiles, signal indicators (direction signals) for automobiles, ski carriers for automobiles, spark plug cables for automobiles, spark plugs for automobiles, spiral springs for automobiles, spoilers for automobiles, spokes for wheels of automobiles, springs for automobiles, steering wheels for automobiles, stop lamps for automobiles, sun roofs for automobiles, sun visors for automobiles, timing belts for automobiles, tires for automobiles, torque converters for automobiles, torsion bars for automobiles, trans-axles for automobiles, transmission for automobiles, tubes for automobiles, turbochargers for automobiles, wheel hub bearings for automobiles, wheels for automobiles, windows for automobiles, windshield glasses for automobiles, windshield wipers for automobiles and wood-grain for automobiles; all included in Class 12” (“the specified goods”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part A of the register. The application was advertised in the Government of the Hong Kong Special Administrative Region Gazette on 11 April 2003.

### **Pleadings and evidence**

3. On 10 September 2003, Mobil Petroleum Company Inc. (“the opponent”) filed notice of opposition to the application. The grounds of opposition state that the opponent is a company organized and existing under the laws of the State of Delaware of the United States of America and is a corporate member of the international oil conglomerate, Exxon Mobil Corporation. The opponent is the proprietor of the trade mark “MOBIL” and various other marks comprising the same (“the opponent’s marks”). The opponent’s marks have been used continuously and extensively in over 150 countries including Hong Kong for very many years in respect of a wide range of products and services including but not limited to petroleum, chemicals, mining operations and related products and services.

4. It is the opponent’s case that the mark “MOBIL” was first used by the opponent or its predecessor since at least as early as 1 May 1934 in the United States. The opponent’s choice of the trade name and mark “MOBIL” is based in part on the business history and in part on the derivation from the Latin word “mobilis” which means “capable of being moved”. As part of the brand reinforcement and identity programme implemented 37 years ago, the opponent’s mark “MOBIL” has always

been used in a distinctive colour blue except with the letter “O” shown in colour red. The opponent has engaged a lot of efforts and incurred substantial expenses in advertising and promoting goods and services bearing the opponent’s marks worldwide including Hong Kong. The opponent’s marks have acquired substantial reputation in many countries including Hong Kong and the opponent’s marks have become distinctive of and identified with the opponent and its goods and services.

5. The opponent further avers that it has engaged a lot of efforts and incurred substantial costs in applying for and policing registration of the opponent’s marks. Although the opponent holds no trade mark registration for “MOBIL” in Class 12 in Hong Kong, the opponent’s registrations with registration nos. 832 of 1948 and 8148 of 1998 for the mark “MOBIL” do cover greases, lubricating oils, gasoline and other products in Class 4. The opponent’s registration no. 3662 of 1994 in respect of the mark “MOBIL” covers automotive service station services. The opponent alleges that the goods covered in the present application for the registration of the suit mark like automobile parts and accessories such as tires, windshield wipers, oil and fuel filters are frequently sold at automotive service stations and used in conjunction with fuels and lubricants. So, the parties’ respective goods or services are sufficiently related.

6. The opponent avers that the suit mark is confusingly similar to the trade mark and name of the opponent “MOBIL”. The applicant also displays the letter “O” in the suit mark in colour red which is similar to the manner in which the opponent’s mark “MOBIL” is commonly displayed. The suit mark impresses the consuming public as being a variant and/or abbreviation of the opponent’s mark “MOBIL”. It will give rise to the mistaken belief that goods under the suit mark also emanate from the opponent. Such likelihood of confusion is further enhanced when the goods under the suit mark are of similar, if not the same, description to goods and services marketed under the opponent’s mark “MOBIL” and various other marks comprising the same.

7. The grounds of opposition comprise sections 2, 9, 10, 12(1), 13(1), 20 and 23 of the Ordinance.

8. In the counter-statement, the opponent’s incorporation status and the applicant’s own application for registration of the suit mark are admitted. Paragraphs 7 and 8 of the grounds of opposition, which are reproduced below, are also admitted :

- “7. The opponent has further engaged a lot of efforts and incurred substantial expenses in advertising and promoting goods and services bearing the opponent’s Said Trade Marks worldwide including Hong Kong. Wide-ranging identity programs have been designed and implemented to emphasize the trade mark and trade name “MOBIL”.
8. By reason of the foregoing, the opponent’s Said Trade Marks have acquired substantial reputation in many countries including Hong Kong and the opponent’s Said Trade Marks have become distinctive of and identified with the opponent and its goods and services”.

In paragraph 10 of the counter-statement, the applicant also pleads that the opponent’s mark “MOBIL” is a trade mark which is well-known to consumers both in Hong Kong and abroad, in particular with respect to gasoline, diesel, fuel-oil, lubricating oil and other related products. Save as aforesaid, each and every other allegation in the grounds of opposition is either denied or not admitted.

9. However, the applicant asserts that the suit mark “MOBIS” is impossible to be recognized as a variant or an abbreviation of the opponent’s mark “MOBIL” as the specified goods covered by the present application are not the same or similar to those covered by the opponent’s mark “MOBIL” in Hong Kong. The opponent has neither manufactured nor sold products in Class 12 in Hong Kong or in any other parts of the world. Furthermore, the applicant pleads that the suit mark is different from the opponent’s mark both visually and phonetically. Although the two marks are all English marks which have five English capital letters, the final letter of “MOBIS” is “S” whereas the final letter of “MOBIL” is “L”. The two marks do not have similar sounds in their whole pronunciations, considering that the suit mark has three syllables and the opponent’s mark has two. The third syllable “S” of the suit mark is pronounced long even though it may be pronounced weakly whereas the second syllable “BIL” of the opponent’s mark has short broken pronunciation. Conceptually, the suit mark is an invented word, rather than a word deriving from an existing word.

10. Trade Marks Rules, Cap. 43, Sub. Leg. (“Rule/s”) 25 evidence consists of a statutory declaration from Robert E. Harayda, the assistant controller of Exxon Mobil Corporation which is the ultimate parent company of the opponent, together with exhibits, which was declared on 13 December 2004 (“Harayda’s statutory declaration”). Under Rule 26, the applicant filed a statutory declaration of Myung-ki,

Jung, the manager in charge of intellectual property rights of the applicant, together with exhibits, which was declared on 10 March 2006 (“Jung’s statutory declaration”). Pursuant to Rule 27, the opponent filed a statutory declaration of Linda R. Sexton, the global brand and communications manager of Exxon Mobil Lubricants and Petroleum Specialties Company, a division of Exxon Mobil Corporation, together with exhibits, which was declared on 13 December 2006 (“Sexton’s statutory declaration”).

## **Decision**

11. Though, by 12 March 2009, the date the matter was heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of section 10(1) and (2) of Schedule 5, an application for registration still pending as of 4 April 2003 and an opposition to the application are to be determined under the provisions of the repealed Ordinance, Cap. 43.

12. Although a number of grounds were pleaded in the grounds of opposition, Mr. Pao for the opponent indicated at the hearing that the opponent only relies on the grounds under sections 2, 12(1) and 20 of the Ordinance for the present opposition proceedings.

### Under section 12(1)

13. Before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its mark. At its very highest, it is a question of a substantial proportion of the interested public being aware of its mark, 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] 9 RPC 237). The date at which this reputation in its mark or marks is to be established is the date of the application to register the suit mark, namely 9 April 2002 – *NOVA Trade Mark* [1918] RPC 357 at 360.

14. Mr Pao pointed out that paragraphs 7 and 8 of the grounds of opposition which are reproduced in paragraph 8 above are admitted by the applicant in paragraph 5 of the counter-statement. Whilst “the opponent’s Said Trade Marks” referred to in paragraphs 7 and 8 of the grounds of opposition are defined in paragraph 2 of the grounds of opposition as “the trade mark MOBIL and various other marks comprising the same”, I indicated to Mr Pao at the hearing that the “goods and services bearing

the opponent's Said Trade Marks" mentioned in paragraphs 7 and 8 of the grounds of opposition are not specifically defined in the grounds of opposition. Hence, although admission is made by the applicant in relation to the opponent's assertion that "the opponent's Said Trade Marks have acquired substantial reputation in many countries including Hong Kong and the opponent's Said Trade Marks have become distinctive of and identified with the opponent and its goods and services", there is a certain degree of ambiguity in such an admission. That said, I find that the applicant specifically pleads in paragraph 10 of the counter-statement that "the mark "MOBIL" of the opponent, MOBIL PETROLEUM COMPANY INC, is a trademark which is well known to consumers both in Hong Kong and abroad, in particular with respect to gasoline, diesel, fuel-oil, lubricating oil and other related products". This assertion of the applicant, in my view, somehow clarifies the aforesaid ambiguity.

15. To supplement, Mr Pao submitted there is undisputed evidence that the opponent has very substantial reputation for its mark "MOBIL" in respect of petroleum, chemical products and services including the operation of service stations and the provision of vehicle repair services.

16. As disclosed in Harayda's statutory declaration, Mr Pao pointed out that the opponent is a United States based corporation, organized and existing under the laws of the State of Delaware. The opponent was a wholly owned indirect subsidiary of Mobil Corporation, which until November 30 1999, had been an independently owned global oil and gas company headquartered in the United States. Mobil Corporation and its affiliates including the opponent (collectively "the Mobil Companies") engaged in the exploration, production, refining and marketing of petroleum, gas and their products throughout the world. On 30 November 1999, Mobil Corporation was acquired by Exxon Mobil Corporation and became its wholly owned subsidiary. From then onwards, the opponent has been a wholly owned indirect subsidiary of both Exxon Mobil Corporation and Mobil Corporation.

17. The Mobil Companies including the opponent trace their origins to one Vacuum Oil Company which was founded in Rochester, New York in 1866 and began as a manufacturer of lubricants. In 1892, the Mobil Companies, operating under the name Socony, opened an office in Shanghai. In 1895, the Mobil Companies opened their first office in Hong Kong. In 1926, the Mobil Companies opened their first service station in Kowloon, Hong Kong under the name of Socony. In 1928, the first Socony gas station was opened in the Central, Hong Kong, and used the trade name "Mobil". In 1966, the Socony company name was changed to Mobil Oil

Corporation. In 1993, a new oil complex on Tsing Yi Island was opened upon the completion of the multi-million dollar project. I would add that the oil complex supplied both local and regional industry and transport with the oil they needed. They included, for example, Towngas, Hong Kong Telecom and the underground Mass Transit Railway. In 1994, Mobil opened its fortieth Hong Kong service station at Tseung Kwan O. All the service stations operated on a twenty-four hour basis. In 1991, Mobil Marts were introduced and then featured in every service station. In Hong Kong, sales of MOBIL branded fuels and lubricants exceeded US\$519,000,000 for the period from the year 2000 to 2003.

18. Mr Pao submitted that the opponent has also engaged substantial efforts and expenses in advertising the opponent's MOBIL mark in Hong Kong. Copies of some advertisements and promotional materials for promoting the opponent's products and/or services in Hong Kong were produced in the exhibits "REH-2" and "REH-10" to Harayda's statutory declaration. When I go through the evidence in "REH-2" and "REH-10" in details, I find that there are advertisements of the mark "MOBIL" in respect of various petroleum products and the opponent's service stations. The opponent had sponsored events, activities and competitions over the years such as the Community Chest "Walk for Millions", scholarships to local students, the Mobil's Children Festival and the Hong Kong Open Windsurfing Championship. From 1989 to 1991, Mobil staged the Badminton Invitational Tournament in Hong Kong and key cities in China. In April 1994, a Far Eastern Economic Review Survey of Asia's top two hundred companies ranked Mobil as the leading oil company in the region. In my view, it is obvious that there is a record of Mobil's participation in the community.

19. I find that, in the face of the opponent's evidence together with the applicant's admissions in the counter-statement, the opponent has established long and extensive reputation in respect of its MOBIL mark in respect of petroleum and chemical products and the operation of service stations in Hong Kong at the application date. It follows that the opponent has overcome the threshold question to ground an opposition based on section 12(1). The onus then shifts to the applicant to show there is no reasonable likelihood of deception or confusion.

20. 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 RPC 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 “MOBIL” in respect of petroleum and chemical products and the operation of service stations, 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 and services 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?”

21. To paraphrase the test in the context of the present case, the question is “can it be said that the opponent’s long and extensive reputation in Hong Kong for petroleum, chemical products and the operation of service stations has “spilled-over” to the extent that a substantial number of consumers of the specified goods which are mainly apparatus, parts and accessories for automobiles, on seeing the suit mark applied to those goods, will be caused to wonder whether the goods are those of the opponent?” Before that could happen however there must be a sufficient similarity between the suit mark and the opponent’s mark such that potential purchasers, upon seeing the suit mark used in relation to the specified goods, would call to mind the opponent’s mark. I bear in mind that it is for the applicant to establish that there is no reasonable likelihood of that connection being made.

22. I now turn to consider the resemblance between the respective marks. Under section 12(1), the comparison is between the opponent’s mark in actual use and the suit mark in notional fair use.

23. I accept, on the evidence, that the opponent’s “MOBIL” mark, in actual use, appears in the following formats :


(A) MOBIL (B) Mobil



(C)

24. I consider that although in actual use, the opponent’s “MOBIL” mark is

represented in the above different formats, the identifying feature of the mark is undoubtedly the word “MOBIL”. The suit mark “MOBIS” is also a pure word mark consisting of five letters. It is clear to me that the first four of the five letters of the respective marks are the same.

25. Mr Pao on behalf of the opponent submitted that the suit mark and the opponent’s mark look the same as both of them contain five letters with only the last letter being different. Mr Pao also placed great emphasis on the point that according to the applicant’s own evidence, the red, white and blue colour scheme adopted by the applicant for the suit mark “MOBIS” in actual use reinforces its similarity with the opponent’s mark “MOBIL” or “”. Phonetically, Mr Pao submitted that the importance of the first syllable enhances the phonetic similarity between the marks. The “S” in the suit mark may often be dropped with “lazy” pronunciation. With the principle of imperfect recollection in consideration, Mr Pao contended that they are phonetically similar. Mr Pao submitted that it is possible that the public would perceive the suit mark as a variant of the opponent’s “MOBIL” mark.

26. The applicant neither turned up at the hearing nor filed any written submissions. However, it pleads in the counter-statement that :-

“The Applicant’s Mark is different from the Opponent’s Mark both visually and phonetically. Although the two marks are all English marks which have 5 English capital letters, the final letter of “MOBIS” is “S”, and the final letter of “MOBIL” is “L”. Meanwhile, the Applicant’s mark is pronounced to [mɔbis] and the Opponent’s mark is pronounced to [mɔbil]. Therefore, the two marks do not have similar sounds in their whole pronunciations, considering that the Applicant’s mark has three syllables whereas the Opponent’s mark has two syllables, and the second syllable [s] of the Applicant’s mark is pronounced long even though being pronounced weakly, but the second syllable [bil] of the Opponent’s mark has shortly broken pronunciation.”

27. In the Rule 26 evidence filed by the applicant, the applicant explains that the suit mark is an invented word as follows :-

“The applicant’s mark is an invented word (MOBILE + SYSTEM) ([www.mobis.co.kr](http://www.mobis.co.kr)). Namely, trademark “MOBIS” is composed of the words MOBILE which is representing automobiles and SYSTEM which is representing harmonization of the complicated mechanical apparatus. Thus, MOBIS means an

enterprise specially manufacturing components and system of automobile.”

28. 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.”

29. So far as visual comparison is concerned, it is plain for me to say that both the suit mark “MOBIS” and the opponent’s mark “MOBIL” are in plain capital letters without any degree of stylization. They are of the same length consisting of five letters, with the first four letters being identical. The only difference between the two marks lies in the ending letter which is “S” in the suit mark and “L” in the opponent’s mark.

30. Of course, when the respective marks are placed side by side, the final letters in the marks are visually distinguishable. However, it is 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; the question is whether the person who sees the proposed trade mark in the absence of the other mark, and in view only of his general recollection of what the nature of the other 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. This is the principle of imperfect recollection summarized in *Sandow Ltd.'s Application* (1914) 31 RPC 196 at 205.

31. With the principle of imperfect recollection in mind, I do not think that a one-letter difference in a five-letter word is a very significant difference, in particular when the differing letters are the ending letters of the words. I am of the view that there are chances that the suit mark will be misread as “MOBIL”. I consider that the respective marks are visually similar.

32. 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.”

33. I consider that if the respective marks are fully and carefully articulated, the ending letters of the marks do sound differently. The first two syllables of the marks however pronounce the same. Taking into account of imperfect recollection and making allowance for careless pronunciation or mishearing, I am of the view that the respective marks are phonetically similar.

34. Conceptually, in my view, both “MOBIS” and “MOBIL” are invented words without any dictionary meaning. The applicant’s allegation that “MOBIS” is a combination of the words “mobil” and “system” would not be apparent to the consuming public. Neither of the words conveys any specific meaning or idea to the likely purchasers in Hong Kong and they therefore do not benefit from conjuring up distinct impressions. Generally, where two words have dissimilar meanings, or one has a meaning and the other none, they will be more easily distinguished than will two words having no readily apparent meaning. Invented words may be more likely to be confused with one another than will English words or an English word and an invented word (*Shanahan’s Australian Law of Trade Marks and Passing Off*, 2<sup>nd</sup> Edition, page 175).

35. Mr Pao invited my attention to some evidence of use by the applicant and submitted that, on the evidence, the applicant has used the suit mark in a similar manner to the opponent’s mark in actual use in that the letter “O” is also red in colour. According to paragraph 6 of Harayda’s statutory declaration, in 1966, the Mobil Companies implemented a brand reinforcement and identity program and introduced

an updated look to the MOBIL mark in which the mark appeared in a distinctive colour blue, with the exception of the letter “O” which was shown in the colour red (see the opponent’s mark (C) in paragraph 23 above).

36. I do not entirely agree with Mr Pao’s submission that the applicant has used the suit mark in a similar manner to the opponent’s mark in actual use. As a matter of fact, I find from the applicant’s evidence that, in actual use, the applicant’s mark is represented as follows :



It is obvious that the letter “O” in the mark above, albeit red in colour, is represented in a stylized manner and the other letters are not in blue.

37. That said, as I have found above that the suit mark as applied for and the opponent’s mark are visually and phonetically confusingly similar and there are no conceptual differences between the marks which help to distinguish between the two, there is no need for me to go further.

38. I must next consider the goods and services to which the respective marks are to be applied. I have found above that the opponent has established long and extensive reputation in Hong Kong for petroleum, chemical products and the operation of service stations in respect of the mark “MOBIL” at the application date. The question before me is whether a substantial number of consumers of the specified goods which are mainly apparatus, parts and accessories for automobiles, on seeing the suit mark applied to those goods, will be caused to wonder whether the goods are those of the opponent.

39. Mr Pao submitted that the specified goods covered by the present application are parts and accessories for motor vehicles. Although the opponent’s business is in the sale and distribution of its petroleum and chemical products, it also provides related services in the servicing, repair and maintenance of motor vehicles through its Mobil branded service stations. Through these related services, parts and accessories of motor vehicles are frequently purchased and used by consumers. The goods covered by the application and the petroleum, chemical products and vehicle servicing, repair and maintenance services provided by the opponent are aimed at the

same group of ultimate consumers, drivers and owners of motor vehicles.

40. The applicant pleads in the counter-statement that the specified goods covered by present application are not the same or similar to those covered by the opponent's mark "MOBIL" in Hong Kong. The opponent does not manufacture nor sell products in Class 12 in Hong Kong. In the Jung's statutory declaration filed on behalf of the applicant, Mr Jung avers that the applicant's goods are "for assembling and completing land motor vehicles" and the opponent's goods are "for serving as sources of energy for motion of already produced motor vehicles". He further avers that the different trade channels are sufficient to eliminate confusion in the market.

41. In the opponent's reply evidence by way of Sexton's statutory declaration, Ms Sexton asserts that many of the specified goods are equally used in servicing and repair of motor vehicles. Service stations selling fuels and lubricants have frequently offered automobile servicing and repair and the specified goods have been available for purchase at such service stations such as alternators, brakes, oil filters, mufflers, rubber belts, shock absorbers, spark plugs and spark plug cables, tires and wind shield wipers. She further points out that many of these goods are also sold in retail outlets specializing in auto parts and supplies often side by side with the opponent's lubricants and other petroleum products. In addition, some products such as oil filters are in fact intended for use with (and frequently would be sold with) automotive motor oils and other lubricants.

42. In order to show the similarity and close relationship between the respective goods and services of the opponent and the applicant, Ms Sexton produced as exhibit "LRS-2" photographs of the opponent's oil and air filters under the mark "MOBIL", which are examples of the opponent's Class 12 products. Ms Sexton avers that the oil and air filters products are a logical extension of the well known MOBIL lubricants. They not only show that Mobil Companies including the opponent are selling under the MOBIL brand some of the goods covered by the present application, but also demonstrate that the opponent's MOBIL goods are themselves closely related to the applicant's goods. She concludes that there is a connection between the specified goods and those sold by the opponent.

43. In my judgment, unlike section 20, under section 12(1), there is no limitation to cases involving goods or services of the same description or associated; although the matters to be considered in assessing the likelihood of deception are necessarily somewhat similar (*Kerly's Law of Trade Marks and Trade Names*, 12<sup>th</sup>

Edition, paragraph 10-14). Apart from making the factual submission that there is a connection between the opponent's goods and services and the applicant's goods, Mr Pao has not drawn my attention to any cases on this point. I find that there are legal authorities on deceptiveness of a mark used on other goods, where the goods concerned were clearly not "of the same description".

44. In *The Eastman Photographic Materials Co. Ltd. and another v The John Griffiths Cycle Corporation Ltd. and The Kodak Cycle Co. Ltd.* (1898) 15 RPC 105, the defendants had obtained registration of the word "Kodak" for cycles and other vehicles. The plaintiffs applied to expunge the mark on the ground that it had invented and used the word "Kodak" in relation to camera and related goods. Although cameras and cycles would appear to be dissimilar products, on the facts and evidence of the case, the plaintiffs succeeded and the mark was ordered to be expunged. Though the plaintiffs did not trade in bicycles, the evidence showed a close connection between the bicycle and photographic trade. At p-110 Romer J summarised the evidence :

"It appears that the "Kodak Cameras" are especially available for use on cycles, and that they are much used by cyclists, and the Plaintiff company had done a large trade in these "Kodaks" for the purpose of cycles. It has made certain special forms of "Kodaks" so as to especially adapt them for use on cycles. It has advertised for some time these special "Kodaks" as "Cycle Kodaks" or "Bicycle Kodaks", and it also has a considerable trade in bicycle accessories as far as relates to the adaptation of the bicycle for photographic purposes. At one recent large cycle show the Plaintiff company had a stall, and the evidence shows that between the two trades, the bicycle trade and the camera trade, there is an intimate connection. Many shops sell and deal in both bicycle and photographic cameras and materials. To a certain extent the Plaintiff company is identified with the name "Kodak" as connected with cycles, and so great is the connection between the two classes of business, that in all probability, I may say, the Plaintiff company may wish hereafter to manufacture and sell cycles specially adapted to carry their "Kodaks"."

45. In *Re OMEGA* [1995] 2HKC 473, where the respondent's attempt to register a mark "Omega" with a logo and three Chinese characters arranged vertically in respect of "writing instruments" was disallowed in view of the appellant's registrations and user of a practically identical mark in respect of "horological instruments", Deputy Judge Le Pichon (as she then was) noted, at p. 476 :

“Whilst the opponent (the appellant) admits that it has neither registered its marks in respect of writing instruments, refills and parts thereof nor sold such goods in Hong Kong, it has adduced evidence to show that owners of famous trade marks tend to use them for a range of products including, in particular, watches and writing instruments. Examples of famous trade marks being used both in relation to watches and writing instruments include ‘ST Dupont’, ‘Cartier’, ‘Dunhill’, ‘Christian Dior’, ‘Guy Laroche’, ‘Tiffany’, ‘Corum’, ‘Chaumet’, ‘Philippe Charriol’ and ‘Caran d’Ache’.”

and at p. 479 :

“I accept Mr Yan’s submission that s 12(1) does not require that the goods be ‘closely allied’. It is stated in *Kerly* (op cit at 10-03) that s 11 of the UK Act extends to cases where the opponent’s mark has been used only upon goods of a different description from those for which registration is sought. See also *Players* [1965] RPC 363 and *Golden Jet* [1979] RPC 19. Indeed, the learned hearing officer had, earlier in his decision (at para 58) correctly taken this view of s 12(1).

Mr Faux concluded (at para 118) that no one would think of pens when seeing the opponent’s marks or hearing its name. That, with the greatest respect, is not the question. The real question is what would people think if they see the applicant’s pens with the suit mark?”

46. Going back to the test propounded by Evershed J. in respect of the likelihood of deception, I must consider whether a substantial number of purchasers of the specified goods, with a passing familiarity with the opponent’s mark, would be reasonably likely, upon seeing the suit mark applied to the specified goods, to be caused to wonder whether both come from the same source. Having taken into account of the opponent’s evidence that many service stations including the opponent’s Mobil branded service stations selling motor fuels and lubricants have frequently offered automobile servicing and repair services and some of the items covered by the present application are available for purchase at such service stations and the opponent’s expansion into the business of supplying oil and air filters under the MOBIL mark, I consider there is likely to be a perception of association or connection between the respective goods and services. I find that a substantial number of purchasers of the specified goods, with a passing familiarity with the opponent’s mark, would be reasonably likely, upon seeing the suit mark applied to the specified goods, to be caused to wonder whether both come from the same source. It follows that there is a tangible risk of deception or confusion among the consumers of

average intelligence taking ordinary care.

47. Having taken into consideration all the circumstances outlined above, I find that the applicant has not discharged its onus to satisfy me that there is no reasonable likelihood of deception or confusion if the suit mark is to proceed to registration. I accordingly find that the opposition under section 12(1) of the Ordinance succeeds.

Under sections 2 and 20

48. Having decided that the opposition succeeds under section 12(1), I do not think I need to consider the opposition under these sections.

Under section 13(2)

49. 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

50. 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.

51. 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 I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) 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  
25 May 2009