Application No. 6333 of 2002

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

AND

IN THE MATTER of an application by Yung Ching Tat and Kong Yuen Hoong trading as Hastings & Company to register the mark

HASTINGS & CO.

in Part A of the Register in Class 42

AND

IN THE MATTER of an opposition thereto by Paul, Hastings, Janofsky & Walker LLP

DECISION

OF

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on 12 February 2007.

Appearing : Mr Albert Xavier instructed by Messrs. Hastings & Co. for the applicant.

Ms Winnie Tam, SC instructed by Messrs. Paul, Hastings, Janofsky & Walker for the opponent.

Application for Registration

1. On 3 May 2002 ("the application date"), Yung Ching Tat and Kong Yuen Hoong trading as Hastings & Company ("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 42, the trade mark, a representation of which appears below :

HASTINGS & CO.

("the suit mark").

2. The services intended to be covered by the registration were "legal services; intellectual property agency and consultancy services; establishment and maintenance of records and management on intellectual and industrial property rights, patent agency services and trade mark agency services; copyright management services; professional attorney, consultation and advisory services, all relating to registration, infringement, franchising, exploitation, licensing and protection of industrial and intellectual property rights, titling search; attorney services for filing overseas and domestic patents, trade marks, copyright, labels, certification trade marks; company formation and registration services; notarial services; professional consultancy relating to computer security; professional consultancy relating to computer software; professional consultancy relating to computers; professional consultancy relating to data processing; professional consultancy relating to franchising; professional consultancy relating to industrial design; professional consultancy relating to industrial property; professional consultancy relating to technology; professional consultancy relating to technology exploitation; conveyancing services; professional consultation and advisory services, all relating to finance, taxation, litigation, immigration and conveyancing; legal research and preparation of reports relating to legal research, company searching, conveyancing searching, land searching and trade mark searching; professional attorney, advisory and consultancy services for civil proceedings, defences on court material administrative proceedings, international trade disputes, maritime matters, technical cooperations, unfair competition and corporate legal matters, legal matters' drafting and arbitration; attorney services for industrial and commercial registrations, land registrations, translation services; editing and translating of various books, magazines, periodicals and documentation; computer services; computer programming; maintenance, updating and design of computer software; computer system analysis;

legal advisory services; legal advice and representation of others in legal matters; legal support services; security consultancy; provision of information relating to the aforesaid services provided on-line from a computer database or from the Internet, leasing access time to computer databases; provision of information and legal advisory services, all relating to the aforesaid services; all included in Class 42" ("the specified services"). The Registrar of Trade Marks ("the Registrar") accepted the 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 13 June 2003.

Pleadings and Evidence

3. On 8 September 2003, Paul, Hastings, Janofsky and Walker LLP ("the opponent") filed notice of opposition to the application. The grounds of opposition state that the opponent is a limited liability partnership organized under the laws of the State of California in the United States of America in 1951. The opponent provides, inter alia, legal services in Atlanta, Beijing, Hong Kong, London, Los Angeles, New York City, Orange County, San Diego, San Francisco, Stamford, Tokyo and Washington D.C. under the marks "Paul Hastings Janofsky & Walker", "Paul Hastings (logo)" and "Paul Hasting (plain letters)". The opponent avers that at all material times, it has a strong reputation in the aforesaid marks. The opponent further pleads that the suit mark is not distinctive nor capable of distinguishing the applicant's services and is not inherently registrable under section 9 or section 10 of the Ordinance. Further and/or alternatively, the opponent asserts that by reason of the reputation acquired by the opponent's marks, use of the suit mark by the applicant would be likely to deceive or would be disentitled to protection in a court of justice. Registration of the suit mark would unfairly prejudice the business interests of the opponent. The opponent also pleads that the applicant is not entitled to claim to be the proprietor of the suit mark. The grounds of opposition comprise sections 2, 9, 10, 12, 13(1) and 13(2) of the Ordinance.

4. Essentially, all the allegations in the grounds of opposition are either denied or not admitted by the applicant in the counter-statement. The applicant states that the suit mark is sufficiently distinctive for registration under sections 9 and 10 of the Ordinance. The applicant is entitled to claim as proprietor of the suit mark. The applicant has by reason of extensive use acquired substantial reputation and goodwill in the marks containing the word "Hastings", including the word marks

"HASTINGS" and "HASTINGS & CO", and the "Hastings & Device" in respect of legal and related services in Hong Kong and worldwide.

5. The opponent's Trade Marks Rule/s, Cap. 43, Sub. Leg. ("Rule/s") 25 evidence comprises a statutory declaration declared on 29 June 2004 by Yeung Chi Kwong, the Director of Finance and Administration of the opponent's Hong Kong office, together with exhibits ("Yeung's statutory declaration"). The applicant's evidence filed pursuant to Rule 26 consists of a statutory declaration declared on 22 December 2004 by Yung Ching Tat, the senior partner of the applicant, together with exhibits ("Yung's statutory declaration") and a supplemental declaration by the same Yung Ching Tat declared on 19 January 2005, together with exhibits.

Decision

6. Though, by 12 February 2007, the date the matter was heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of sections 10(1) and (2) of Schedule 5, oppositions to registrations still pending as of 4 April 2003 are to be determined under the provisions of the repealed Ordinance, Cap. 43.

7. Although a number of grounds were pleaded in the grounds of opposition, Ms Tam for the opponent only relied on the grounds under sections 9, 10 and 13(2) of the Ordinance at the hearing.

<u>Under section 9</u>

8. I wish to point out that although the Registrar has considered this section in relation to the suit mark at the ex parte application stage when processing the suit application, the Registrar is not bound by his previous view and/or decision. I have to decide the matter *de novo* based on the pleadings and evidence filed in the opposition proceedings and the submissions before me. Any discretion conferred on the Registrar must be exercised de novo. The issue of the leave to advertise does not assist the applicant in any way.

9. As at the application date, the provisions of section 9 of the Ordinance are as follows :

> "(1) A trade mark (other than a certification trade mark) to be registrable in Part A of

the register shall contain or consist of at least one of the following essential particulars :

(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature (in other than Chinese characters) of the applicant for registration or of some predecessor in his business;

(c) an invented word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade, from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which –

(a) the trade mark is inherently adapted to distinguish as aforesaid; and
(b) by reason of the use of the trade or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

10. The opposition under section 9 of the Ordinance is a registrability issue.

11. The first question before me is whether the word "Hastings" is, according to its ordinary signification, a surname and is registrable under section 9(1)(d) of the Ordinance.

12. At the ex parte application stage, the suit mark was not considered to be a surname according to its ordinary signification based on a guideline issued by the Registrar under Circular No. 11 of 1996, in which the Registrar stated as follows :-

> "The Registry has recently reviewed its practice relating to the registration of surnames in Part A and Part B of the Register and has decided to revise and relax its practice as follows:-
>
> (a) Relevant Telephone Directory
> The Registry will only search in the Hong Kong Telephone Directory to ascertain whether a word is, according to its ordinary signification, a surname.
>
> (b) The Registry will allow registration of surnames, prima facie, on the de minimis principle, in Part A if they appear no more than 50 times in the Hong Kong Directory and in Part B if they appear no more than 100 times in the Hong Kong Directory.
>
> (c) Surnames outside the above limits remain registrable upon evidence of distinctiveness.
>
> 2. The revised practice referred to above will apply to applications filed on or after 1.1.95 which are part examined or still unexamined at present. Applications which have already been advertised or for which leave to advertise has been issued will not be re-opened for discussion.
>
> 3. This Circular supersedes Circular No. 3 of 1993."

13. According to the Registry's records, the word "Hastings" appeared two times in the Hong Kong Telephone Directory at the application date. As such, the word "Hastings" met the criteria of appearing no more than 50 times in the Hong Kong Telephone Directory at the application date as set out in the circular and was accepted for registration in Part A of the Register on a *prima facie* basis under section

9(1)(d) of the Ordinance.

14. Mr Xavier, Counsel for the applicant, accepted that the circular is not conclusive and not binding. He then referred me to a number of authorities regarding the basic legal principles governing the registration of surnames.

15. The first case to which Mr Xavier referred me was the Hong Kong Court of Appeal judgment in *MATTEL Inc v. De Luxe Manufacturing Ltd* [2006] 1 HLRD 143. That was a case in which the plaintiff appealed against the judgment of Barma J. in the Court of First Instance involving the plaintiff's action against the defendant for infringement of its registered trade mark, and the defendant's counterclaim for the rectification of the register of trade mark by the expungement of the plaintiff's trade mark, whereby the Court below found in favour of the defendant. The trade mark concerned is "Kelly". The Court of Appeal held that there was no reason to depart from the judge's conclusion, on a question of fact, that the word "Kelly" was according to its ordinary signification a surname. First, the judge was not bound by the circular and took into account the fact that the surnominal significance had to be assessed by reference to local conditions. Second, a word could have more than one ordinary signification and the fact that the word "Kelly" might have a signification of a first or given name did not prevent it also having ordinary signification as a surname (per Rogers V-P, Yeung JA agreeing at p.149). A word could have many ordinary significations, and as long as one of its ordinary significations was a surname, section 9(1)(d) was applicable. As to considering the ordinary signification of "Kelly", the relevant standard was that of the ordinary people in Hong Kong where "Kelly" was registered as trade mark (per Yeung JA at p.151).

16. Mr Xavier then drew my attention to another Court of Appeal case in the United Kingdom in *DU PONT Trade Mark* (2004) FSR 15 in which it was held that the Registry's guidelines could be useful to help practitioners as to the general attitude of the Registry but they were not decisive and were probably not even helpful when deciding an opposition. When considering the capacity of a mark to distinguish in the United Kingdom, it was relevant to take into account the fact that people travelled between this country and some other country and that the significance of a word in this country could be influenced by its significance in that other country. The extent of that influence would depend on the circumstances of each case.

17. Mr Xavier submitted that it is apparent from the *Mattel* and *Du Pont*

cases, *supra*, that the Registry's circular is by no means conclusive in deciding whether a word is, according to its ordinary signification, a surname. It is still a question of fact whether a word has surnominal significance depending on all the circumstances. At page 306 of the *Du Pont* judgment, Aldous LJ said that hundreds of registration in overseas telephone book is meaningless for local consideration. What is important is its significance in the United Kingdom. Thus, the most important consideration is the significance of the suit mark in Hong Kong, that is, how it is perceived in Hong Kong.

18. Mr Xavier contended that the suit mark is a very uncommon surname and on the evidence there is only one registration in the telephone directory in Hong Kong. Therefore, the suit mark is not according to its ordinary signification a surname in Hong Kong even taking into account overseas travellers and expatriates in Hong Kong. In all the years, the applicant is the only party providing legal service in Hong Kong using the name or mark "Hastings".

19. Ms Tam, Counsel for the opponent, submitted that the burden of proof is on the applicant to show that the suit mark is registrable in Part A of the Register. It is clear that the suit mark, being a surname according to its ordinary signification, is not registrable under section 9(1)(d) of the Ordinance. It is unchallenged evidence that "Hastings" is a common surname in the Western world (paragraphs 24, 25, 26 and Exhibit 6 of Yeung's statutory declaration). From the evidence of Yung Ching Tat filed on the applicant's behalf, it is clear that the applicant did not contest that "Hastings" is a surname according to its ordinary signification. The applicant however asserted that "Hastings" is an uncommon surname or company name in Hong Kong (paragraph 29 and "YCT-9" and "YCT-10" of Yung's statutory declaration). Moreover, the applicant alleged that according to the Registrar's Circular No. 11 of 1996, the Registrar should allow the registration of "Hastings" on the *de minimis* principle, as it appears no more than 50 times in the Hong Kong Telephone Directory (paragraph 28 and "YCT-12" of Yung's statutory declaration).

20. Ms Tam moved on to pick up some deficiencies in the applicant's evidence. First, Ms Tam pointed out that the evidence in "YCT-9" and "YCT-10" only revealed the number of people with the surname "Hastings" as of 20 August 2004, not the application date. In any event, following the leading Hong Kong Court of Appeal judgment in the case *Mattel*, *supra*, Ms Tam contended it is now settled that the Registrar's Circular No. 11 of 1996 which set to determine whether the ordinary

signification of a word is surnominal by reference to the frequency of appearances in the Hong Kong telephone directory did not set out the law. With respect to paragraphs 26 and 27 of Yung's statutory declaration, it should be noted that "2004 PCCW WHITE PAGES BUSINESS" actually showed 4, not 3 Hong Kong companies having the word "HASTINGS" in their names ("YCT-10").

21. Ms Tam contended that in determining whether a trade mark is in its ordinary signification a surname, we have to take into account the circumstances of the case. In the present case, because of the circumstances and nature of trade and the applicant's evidence, it is impossible to say that "Hastings" is not in its ordinary signification a surname.

22. As to the circumstances and nature of trade, Ms Tam submitted that the suit mark is used in respect of legal services. The services in issue are in reality often named by reference to the proprietors' surnames.

23. Turning to the applicant's evidence, according to paragraph 5 of Yung's statutory declaration, the applicant was established by Mr. John Hastings on 1 January 1904 with the name of Hastings, John, Solicitor, Conveyancer, Proctor, Notary Public and Patent and Trade Mark Agent. In 1906, Mr George Andrew Hastings, a solicitor and notary public, joined the firm and the partnership became Hastings & Hastings by January 1907. In 1923, with the retirement of Mr George Andrew Hastings, the firm was re-named Hastings & Hastings, Dennys and Bowley, and adopted the name of Hastings, Dennys and Bowley in 1926. The opponent acquired its present name of Hastings & Co in 1934. If the firm, John Hastings and his successors were as well-known as the applicant would have asserted, it is impossible to say that "Hastings" is in its ordinary signification not a surname. All the century-old historical documents including the past legal directory, the Articles of Association of the Law Society of Hong Kong and the Hong Kong Government Gazette (Bundle "Exhibit A", pages 438, 439, 442 and 444) showed that at times, the word "Hastings" had been held out as a surname of a practitioner in the legal field, whether or not there are entries for it in the telephone directory as at the application date.

24. In my judgment, applying the *MATTEL* case, *supra*, it is clear that I am not bound by the contents of the circular issued by the Registrar. The circular refers to the Registrar's practice and does not set out the law. It sets out how the Registrar will approach decisions which he has to take in respect of trade mark applications.

In essence, the circular issued by the Registrar said that the Registrar will consider how many entries there are in specified telephone directories in coming to a decision as to whether a word should be regarded as a surname. If the word exceeds the set number of entries in a particular telephone directory, the Registrar will require evidence of distinctiveness before permitting registration. Such tests cannot in any event be conclusive. There are some words which are surnames, and only surnames, but may not feature enough times in a telephone directory to fall outside the limits beyond which evidence of distinctiveness may be required. Nevertheless those words would still be, in their ordinary signification, and indeed their only signification, surnames (*MATTEL Inc* v. *De Luxe Manufacturing Ltd, supra,* at pp.148 – 149, as per Rogers V-P).

25. It is not in dispute that "Hastings" is a surname according to its ordinary signification. Mr Xavier has not suggested that "Hastings" has other recognized meaning or signification apart from its surnominal signification. The point made by Mr Xavier is that "Hastings" is a very uncommon surname in Hong Kong at the application date. As pointed out by Ms Tam, the opponent's evidence that "Hastings" is a common surname in the western world is not challenged in the reply evidence of the applicant.

26. Yeung JA in the *Mattel* case, *supra*, made the following observations at paragraphs 19 to 22 of p.152 of the Court of Appeal judgment :-

> "19. Most people, I suspect, will not be concerned with the nominal or surnominal signification of the word "Kelly" at all.
>
> 20. However, those who are concerned and those who take the trouble to find out, if in doubt, would have concluded that it was indeed a common surname.
>
> 21. Unlike words such as "Dent", "Cannon", "Power" and the like, "Kelly" has no other well-known meaning or signification. Hence, the ordinary signification of "Kelly" to a Hong Kong man is either nominal or surnominal.
>
> 22. Ms Tam, for the plaintiff, emphasizes the fact that "Kelly" was used on dolls is a relevant factor to determine its ordinary signification. I do not disagree with such a suggestion. However, I fail to see why being used on dolls would fundamentally change the nature of the word "Kelly" and eradicate its

surnominal signification altogether."

27. In my view, given that "Hastings" has no other recognized meaning or signification and applying the standard of the ordinary people in Hong Kong having taken into account of the local conditions such as there are foreigners and expatriates living in Hong Kong and a substantial segment of the population is English speaking, whether as a first or second language, the ordinary signification of "Hastings" to the public of Hong Kong is surnominal, i.e., a surname. This is particularly so when one considers that the suit mark is used in respect of legal services which are named in reality often by reference to the proprietors' surnames.

28. I therefore conclude that "Hastings" is a surname according to its ordinary signification and is not registrable under Part A of the Register by virtue of section 9(1)(d) of the Ordinance.

29. That does not dispose of the matter completely. I have to move on to consider whether the suit mark is registrable under section 9(1)(e) of the Ordinance upon evidence of its distinctiveness.

30. It is well-established law and, as apparent from the submissions of Ms Tam and Mr Xavier, it is not in dispute that in order for a trade mark, as a matter of law, to be registrable under section 9(1)(e) of the Ordinance, both inherent adaptability to distinguish and actual adaptability to distinguish in fact must be considered and satisfied (section 9(3) of the Ordinance). Thus, even if a mark is found to have one hundred per cent factual distinctiveness it shall still not be registrable if it is not inherently adapted to distinguish the services in respect of which the trade mark is sought to be registered (see *York Trade Mark* [1984] RPC 231 applied in *Aqua-leisure Industries Inc & another* v. *IMPAG Toys Europe BV & others* [2006] HKEC 797 at para. 96). What is in issue in the present case is whether the suit mark possesses both inherent adaptability to distinguish and actual adaptability to distinguish in fact.

31. Mr Xavier referred me to the *Mattel* case, *supra*, again on this issue. In paragraph 11 of the judgment, Rogers V-P said the following :-

> "In summary, the Judge was most certainly not bound by the contents of the circular issued by the Trade Marks Registrar. I see no reason for departing from the

Judge's view. Once it had been decided that the signification of the word "Kelly" was a surname it fell to be treated as not a distinctive mark in that it was not adapted to distinguish the goods of the proprietor from those of other persons bearing the same surname. That problem could be cured by user of the mark rendering the mark distinctive: see eg *Burford (HG) & Co's Application* [1936] RPC 1 at p.139.

The question of whether anybody else had a right to use his or her own name in respect of goods was a different matter. There has always been a common law right to use one's own name honestly: see, for example, *Kerly's Law of Trade Marks and Trade Names* (1st ed.) at pp. 420 – 427. At least since Trade Marks Act 1905, which was substantially reproduced in the Trade Marks Ordinance enacted in Hong Kong in 1909, there has been a statutory provision exempting from infringement the *bona fide* use of a person's name."

32. Mr Xavier contended that even if the word "Hastings" is in its ordinary signification a surname, there is no bar to registration provided that one can demonstrate the user to show that the trade mark is in fact distinctive. In the *MATTEL* case, no evidence was filed by the registered proprietor to prove the factual distinctiveness of the mark "Kelly". The *MATTEL* decision is thus restricted only to the issue of whether "Kelly" is a word of surnominal signification. The question of distinctiveness of the mark is never argued.

33. Mr Xavier then invited my attention to the case of *Teofani v Teofani* (1913) 30 RPC 446 where the question of distinctiveness of a mark was argued. It is another United Kingdom Court of Appeal judgment. Teofani & Co. Ltd. and their predecessors had for some years manufactured and sold cigarettes which were known in the trade and by public as "Teofani's cigarettes". They also registered the word "Teofani" as a trade mark for manufactured tobacco. An Athanasius Teofani commenced to manufacture and sell "A. Teofani" cigarettes. Teofani & Co. Ltd. brought an action to restrain A. Teofani from passing off his cigarettes as and for cigarettes manufactured and sold by them, and they also claimed to restrain A. Teofani from infringing their registered trade mark "Teofani". A Teofani moved to expunge the trade mark from the register on the grounds that the name "Teofani" was not capable of being a distinctive mark, and that it was outside the category of "essential particulars" of a trade mark. It was held by the Court of Appeal that a surname was not necessarily incapable of being a registrable trade mark. The name "Teofani" was very uncommon and its user for twenty years had in fact made it "distinctive" for

cigarettes. The mark was thus held to be distinctive for registration. Swinfen Eady LJ observed at page 463 :-

> "A surname is a word, and therefore is prima facie registrable, …. The present Act seems to remedy these defects by abandoning the policy of absolute exclusion of all the members of specified classes of words and substituting therefor a judicial examination of the merits of each individual case, and leaving the court free to pronounce the word or words to be eligible for registration if on such an examination it holds it proper to do so.
>
> It is not for the court to lay down a rule excusing all surnames from registration, when the Statute has left the matter entirely open – left it to be determined as a question of fact in each case, whether the word is in fact distinctive. The quality of distinctiveness may be inherent in the word selected, but it also may be acquired, and the Statute in terms allows evidence of acquired distinctiveness to be adduced. In my opinion a surname is capable of being a registrable Trade Mark, and "Teofani" was properly registered in the present case.
>
> I wish however to add that caution is necessary in admitting surnames to registration, and the circumstances in which registration should be allowed are exceptional. Much would depend on the name itself, whether it is a surname of unusual occurrence in the United Kingdom, or whether it is a name not infrequently met with; and again whether the Application is made after the word has been in use as a Trade Mark for some time, and there is evidence of distinctiveness acquired by user, or whether the Application refers to a mark "proposed to be used," but not yet in actual use."

34. Mr Xavier went on to draw my attention to the *Dupont* case, *supra*, where the United Kingdom Court of Appeal held that the circumstances which a court would take into account when considering capacity to distinguish included (i) the extent, type and effect of user of the trade mark; (ii) the characteristics of the trade mark which included whether it was an unusual or common name; (iii) the nature of the goods for which the trade mark was sought to be registered and the nature of the trade in those goods; and (iv) the extent to which registration would impose on the needs of others (para. 33 at p.309 of the judgment).

35. If the circumstances set out in *Dupont* are considered in the present case,

Mr Xavier submitted that the suit mark is inherently adapted to distinguish. The suit mark is a very uncommon surname and on the evidence there is only one registration in the telephone directory in Hong Kong at the application date. The suit mark is thus inherently distinctive. "Hastings" is not a word required by the legal profession in the ordinary course of business.

36. Mr Xavier submitted that the real concern in *York Trade Mark* [1984] RPC 231 is that there are special classes of trade marks bearing names or words where on public policy reasons are never registrable. For example, geographical names such as New York and Hong Kong which are well-known cities with extremely large population are never registrable. As regards surnames, for those extremely common surnames, for example, Chan in Hong Kong and Smith in England are also not registrable. For laudatory words or epithets such as good or bad, they are also not registrable since they relate directly to the quality of goods and services. Mr Xavier submitted that the suit mark does not fall within any of the above categories and is inherently adapted to distinguish.

37. On the contrary, Ms Tam contended that as there is a total lack of or only minimal inherent adaptability in the suit mark to distinguish the applicant's services from other legal service providers, the Registrar should refuse registration of the suit mark under Part A, irrespective of its factual adaptability to distinguish. (See *York Trade Mark* [1984] RPC 231, applied in *Aqua-leisure Industries Inc & anther v IMPAG Toys Europe VB & others* [2006] HKEC 797 at para. 96)

38. Ms Tam pointed out that in a recent Hong Kong High Court judgment in *Aqua-leisure*, *supra*, Sahkrani J. said at para. 98 :-

> 'In determining whether a mark is inherently adapted to distinguish, the applicable test is that as stated by Lord Parker in *The Registrar of Trade Marks* v. *W. & G. Du Cros Ltd.* [1913] 30 RPC 660 at 672 namely,
>
> > "whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods."'

39. Ms Tam submitted that in relation to certain words, of which laudatory epithets and some geographical names are established examples, traders could not

obtain a monopoly in the use of such words (however distinctive) to the detriment of the members of the public who, in the future, and in connection with other goods, might desire to use them (*York Trade Mark* [1984] RPC 231 at 254). Ms Tam said that the tribunal has to regard to what might happen in future. "Hastings", being a well-known English surname, is quite likely to become a mark that other professionals would like to use in future. To allow registration of the suit mark would be detrimental to the interests of the members of the public. Hong Kong is an important financial centre and a lot of people come to Hong Kong to establish their practices.

40. Admittance of surname to registration, Ms Tam argued, ought to be most closely scrutinized. Surnames are *prima facie* not distinctive marks in that they are not adapted to distinguish the services of the proprietor from those of other persons bearing the same surname.

41. Ms Tam invited my attention to *H.G. Burford & Co's Application* (1919) 36 RPC 139. H.G. Burford & Co Ltd made an application to register the word "Burford" as a trade mark in Class 22 in respect of commercial motor vehicles, the word being both a surname and a geographical name. The applicants adduced evidence that the word, when used in connection with commercial motor vehicles, meant their vehicles. The user had extended over about three-and-a-half years, during which 400 to 500 vehicles had been sold. At the first instance hearing, it was held that the word was at that time, within the limits of the trade, distinctive in the ordinary sense of the goods of the applicants, but that the surname "Burford", though not particularly common, was not exceptionally rare, and that, under all the circumstances of the case, the application ought to be refused. The applicants appealed to the Court of Appeal. The appeal was allowed and "Burford", though being a surname, was allowed to be registered.

42. In the Court of Appeal judgment in *Burford*, Swinfen Eady M.R. said at pp.145 and 146 :-

> "It is also shown that it is the common practice in the motor car industry for manufacturers to distinguish the vehicles built by them by some Trade Mark, which is frequently, and indeed usually (though not universally) the surname of the manufacturer, such as "Napier," "Crossley," "Daimler," "Peugeot," "Humber," "Austin," "Talbot," "Rolls-Royce," and others. All these names, with others, are at

present on the Register as Trade Marks in Class 22. Some have been registered by direction of the *Board of Trade* allowing the application to proceed. "Daimler" was registered by an Order of the High Court directing the application to proceed, the *Board of Trade* having referred the matter to the Court. The evidence is that these word marks so registered have never been found to interfere with any legitimate use of his own name by any one else. Indeed, with so many instances of name marks in the motor industry, and the preference shown by manufacturers in that trade for name marks, it would appear that such marks more readily become distinctive of the goods of particular manufacturers than would *prima facie* be supposed.

……………………………………………………………………

Thus the evidence establishes that the word "Burford" has been used by the Company, since its formation, as a Trade Mark, and that it has served to distinguish its vehicles from those of all other markers. There is therefore some evidence although by no means conclusive, that the word is "adapted to distinguish"; but even if the mark be in fact distinctive, the tribunal is not bound to allow the application to proceed, but has a discretion in the matter. Other circumstances must be taken into account before that question can be answered, of which Lord Shaw approved in *Registrar of Trade Marks* v *W. & G. Du Cros Ltd.* (L.R. (1913) A.C. 624, at p. 631)* : "Will the registration of the Trade Mark cause substantial "difficulty, or confusion, in view of the rights of user by other traders?" We know that similar word marks of other motor car makers have been registered for years without causing any difficulty or confusion, even though (as in the Daimler case) the word forms part of the name of other companies. Again, the business of a manufacturer of motor vehicles is one requiring considerable works and capital, and much plant and machinery, and the number of such manufacturers in the United Kingdom is not large. The materiality of this is that the names of all the manufacturers are well known to the trade, and if there was any other person of the name "Burford" already a manufacturer of cars or parts, that fact would be readily ascertained. It is not like the case of a trade in smaller and less expensive articles, where there may be numerous persons engaged in it, in different parts of the Kingdom, ignorant of the existence of other so engaged, or of the Trade Marks which they are using."

43. Ms Tam said that the *Burford* case is distinguished from the present case. The *Burford* case concerns a mark for goods, that is, commercial motor vehicles. The present case concerns a service trade mark in respect of legal services. The only

indicia relied on would be the trade mark when the goods are put on the market. For the legal services, the scenario is completely different. Services operating on surnames or predecessors' surnames do not have customers that go to the firm for services by their names. They go to the individual lawyers as the points of contact. Services providers should be allowed to use their surnames. It is quite wrong to allow someone to monopolize the use of a surname simply because they have used it for some time.

44. In particular, Ms Tam pointed out that with respect to the naming practice of law firms, it could be seen that their names are generally made up by a combination of surnames. (See paragraph 28 and the table of Yeung's statutory declaration.) This illuminates why no one should monopolize the use of a particular surname in the legal profession. Unlike business in relation to, say, commercial motor vehicles manufacturing, provision of legal services is not limited to a small class of the community. The services in issue are in reality often named by reference to the proprietors' surnames. There are bound to be professionals sharing common surnames, and no one of them should have a statutory monopoly to the exclusion of others regardless of the length of use in one locality.

45. Ms Tam contended that even if the suit mark has acquired a high degree of distinctiveness, the distinctiveness could not and should not be maintained in the future. The evidence clearly reveals that the opponent has acquired worldwide and local reputation concerning the use of its mark in relation to provision of legal services. Registration of the suit mark would unduly restrict the honest service providers such as the opponent with the same surname from using their surname in providing the same services (see *In Re Teofani & Co.'s Trade Mark* [1913] 2 Ch. 545 and *Burford (HG) & Co's Application* [1919] 2 Ch. 28 p 146-147).

46. As to the observations of Rogers V-P in *Mattel* case that the question of whether anybody else had a right to use his or her own name in respect of which was a different matter and there has always a common law right to use one's own name honestly (see paragraph 31 above), Ms Tam pointed out that the own name defence is very narrow and is only available for use of the defendant's full name subject to the proviso of honest practices. (See unreported decision of High Court Action No. 204 of 2006, *Richemont International S.A.* v. *Da Vinci Collections (HK) Ltd* at paragraph 35). The use of one's own name must be in accordance with honest practice in trade. This leaves considerable uncertainty for the unregistered owner to use his own name.

Therefore, own name defence is not a safety net for allowing the registration of a surname as a trade mark.

47. Ms Tam concluded that in light of the total lack of or minimal inherent adaptability of the suit mark to distinguish the applicant's services from other legal service providers, the Registrar should refuse registration of the suit mark under Part A.

48. In reply to the argument of Ms Tam that registration of the suit mark would unduly restrict the honest service providers with the same surname from using the surname in providing legal services and therefore the suit mark is not inherently adapted to distinguish, Mr Xavier said that precisely the same issue was discussed in the *Burford* case, *supra*. After having decided that the circumstances of the case pointed strongly in favour of permitting registration of "Burford" as a trade mark, Eve J. said at page 151 of the case as follows :-

> "The questions then remain whether this conclusion [I think it refers to the conclusion to register the mark] is outweighed by any possible injustice which registration may inflict upon members of the "Burford" family who may hereafter engage in the manufacture of similar goods, or by any possible detriment accruing to the general public in consequence of allowing registration to proceed.
>
> Section 44 of the Act[1] undoubtedly affords considerable protection to the potential manufacturer, but it has been suggested that, in common with other manufacturers, he might desire to distinguish his goods by attaching his own name to them as a distinctive mark, and that registration will unfairly deprive him of this opportunity. I do not think this suggestion is well founded, and for this reason : the word "Burford" having already become distinctive of the goods manufactured by the Applicants, no honest manufacturer – and it is of course only the honest manufacturer who has to be protected – could, in the future, apply the same appellation to his goods, whether the word is registered or not. It is not, therefore, by registration, but by the state of things by which the user of the word has already made it distinctive of the Applicants' goods that the future manufacturer is debarred from adopting the same word for his goods. In short, registration will, in my opinion, put him in no more

[1] Section 44 of the United Kingdom Trade Marks Act 1905 provides that "No registration under this Act shall interfere with any *bona fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods."

unfavourable position in this respect than he is in already by reason of the accomplished fact which is the very foundation of the Application. In other respects he will, I think, be sufficiently protected by Section 44, and I can see no valid ground why this Application should be refused for the protection of the potential manufacturer.

> The same reasoning applies to the general public. Whether this registration proceeds or not, the word "Burford" will continue to be distinctive of the Applicants' goods, and no future "Burford" who starts manufacturing similar goods will be permitted to put them on the market under that name alone. The position of the public, therefore, so far, is, for practical purposes, identical whether the name is registered or not. In either case, they must be prepared, in the event of a future "Burford" manufacturing similar goods, to discriminate between the goods sold under the Applicants' name or mark, and the goods sold under the name or mark selected by the second or subsequent manufacturer. I cannot, therefore, see that registration will prejudicially affect the public any more than the potential manufacturer. On the contrary, registration will, in all probability, indirectly assist the public to discriminate, in that the later manufacturer, being in consequence thereof exposed to the additional risk of an action for infringement, will probably exercise more caution in selecting his name or mark than he would do if the only risk he ran was of an action for passing off."

49. Mr Xavier argued that even without registration, no honest trader should use the suit mark to indicate the origin of their services. The registration will not cause other traders any more difficulty. If the reputation of the mark is established, whether registered or not, the trade mark owner can take passing off action against other traders.

50. I am grateful to both Ms Tam and Mr Xavier in referring to me relevant legal authorities in details. In my opinion, in determining whether a mark is inherently adapted to distinguish, the applicable test as stated by Lord Parker in the *Registrar of Trade Marks* v. *W. & G. Du Cros Ltd.* [1913] 30 RPC 660 at 672 is,

> "Whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some marks nearly resembling it, upon or in connection with their own goods."

51. The Lord Parker test has been applied by the Hong Kong Court of Appeal in *re Guangdong Foodstuffs Import and Export (Group) Corp.* [2005] 1 HKLRD 520 and the High Court case in *Aqua-Leisure*, *supra*.

52. In the leading case *York Trade Mark*, *supra*, the House of Lords ruled that even if it is accepted that a mark is one hundred per cent factually distinctive of an applicant, in relation to certain words, no one could obtain a monopoly to the detriment of those who might legitimately and without improper motive wish to use them.

53. Apart from the aforesaid applicable test which appears to me to be the overall guiding principle, Ms Tam and Mr Xavier have also helpfully drawn my attention to the authorities of the *Burford*, *Teofani* and *Du Pont* cases which concern specifically the registration of surnames as trade marks. It is apparent from the authorities that in determining whether a surname is inherently adapted to distinguish, a number of factors have to be taken into account. To summarise, they include whether the surname is unusual, the extent, type and effect of user of the trade mark, the nature of the service for which the trade mark is sought to be registered and the nature of the trade in those services and the extent to which registration would impose on the needs of others. At the end of the day, I have to decide whether the registration of the suit mark would unduly restrict the honest service providers with the same surname from using the surname in providing the legal services.

54. On the evidence, I consider that the surname "Hastings" is a very uncommon surname in Hong Kong. As at the application date, the surname "Hastings" only appeared two times in the Hong Kong Telephone Directory. The "2004 PCCW WHITE PAGES BUSINESS" actually showed only 4 Hong Kong companies having the word "Hastings" in their names ("YCT-16"). In all the years before the application date, the applicant is the only party providing legal service in Hong Kong using the name or mark "Hastings".

55. Turning to the extent, type and effect of user of the suit mark, Mr Xavier submitted that by reason of the extensive and substantial use of the suit mark by the applicant over a very long period of some 103 years in Hong Kong, the suit mark has acquired factual distinctiveness. The name or mark "Hastings" has been used in Hong Kong since 1904 and the name "Hastings & Co." since 1934 to denote to the public the applicant and has by its use distinguished the applicant from all other

parties providing legal services in Hong Kong. Everyone in the legal profession at all material times understand that "Hastings" means the applicant and no one else. At all material times, the applicant is the only party providing legal services under the name or mark "Hastings" in Hong Kong since 1904. In the premises, it is respectfully submitted that the suit mark is distinctive and is registrable in Part A.

56. In reply, Ms Tam submitted that when considering the degree of factual distinctiveness the suit mark has acquired, the Registrar should note that the mere fact that the founder of the applicant is famous is irrelevant to the question of whether the suit mark is capable of distinguishing in fact. The evidence in "YCT-1" to "YCT-4" to Yung's statutory declaration should therefore be ignored. Also, the mere use of the mark does not mean that it is capable of distinguishing one's goods or services from another. It is alarming that save for 2 alleged incidents of confusion in "YTC-13" to Yung's statutory declaration, all the other so called "instances of confusion" particularized therein shows that consumers have only mistaken the applicant as the opponent. With respect to the 2 alleged incidents of confusion showing otherwise, it is clear that both occurred only due to the fact that the opponent happened to have moved into the old office of the applicant. They were mistaken about the address of the opponent or the applicant, not their respective identity.

57. Having considered counsel's submissions and taken a fair appraisal of the applicant's evidence by Yung's statutory declaration, I am satisfied that the applicant has used the suit mark to indicate a connection, in the course of business, between the applicant and the legal services provided. It is clear that the applicant has provided legal services under the mark "Hastings" since 1904 and the latest since 1934. The applicant offers its multi-national and local clients with a wide range of services under the mark "Hastings" in different areas of legal practice including but not limited to civil and criminal litigation, insurance, personal injuries, banking, corporate finance, acquisition, commercial, company secretarial, intellectual property, conveyancing, employment, landlord and tenant, family, will and probate and China-related services. The applicant's legal services have been continuously and extensively promoted under the mark "Hastings" in Hong Kong by placing advertisements in different media, sponsoring events and participating in symposiums, seminars and so on (see paras. 22 and 23 of Yung's statutory declaration and "YCT-8").

58. Applying the *Teofani*, *Burford* and *Dupont* cases, *supra*, given that

"Hastings" is a very uncommon surname in Hong Kong and its user for about one hundred years in Hong Kong have in fact made it distinctive for legal services, the suit mark is both inherently and factually adaptable to distinguish the applicant's legal services.

59. Ms Tam placed great force in her argument that in determining whether the suit mark possesses any inherent adaptability to distinguish, I must take into account the particular nature of the service for which the suit mark is sought to be registered. As the names of law firms are generally made up by a combination of surnames, no one should monopolise the use of a particular surname in the legal profession. In reply to this argument, I would be like to borrow the words of Cozens-Hardy M.R. at page 460 of the *Teofani* case, *supra*, as follows :-

> "For the present purpose, I can see no distinction between a geographical name and a surname, except that I think a surname is more open to objection than a geographical name. Where the surname is not that of the proprietor, it is more easy to justify its claim to be a Trade Mark than where the surname is that of the proprietor. It is only in very exceptional circumstances that such an application ought to be allowed to proceed. If my name is *John Smith*, the name *Smith* may indicate that the goods are not made by *Brown*, but it is not adapted to distinguish my goods from those of any other person who has the surname *Smith*. A surname may however be so peculiar, and its user may have been so extensive, that it has in fact become "distinctive" of the proprietor's goods. The clause at the end of Section (9) seems to me to show that it cannot be said that a surname is under no circumstances a registrable Trade Mark."

60. In the *Burford* case, *supra*, at p.145, it is also shown that it is the common practice in the motor car industry for manufacturers to distinguish the vehicles built by them by some trade mark, which is frequently, and indeed usually (though not universally) the surname of the manufacturer. However, the surname "Burford" was allowed to be registered by the Court of Appeal on the ground that the distinctive character of the word "Burford" had been clearly proved by the evidence of use in that case.

61. As to whether the registration of the suit mark would unduly restrict the honest service providers with the same surname from using the same name in providing the legal services, I share with Mr Xavier that precisely the same issue was

discussed in the *Burford* case (see paragraph 48 above). As in the *Burford* case, I am not convinced that the conclusion to register the suit mark should be outweighed by any possible injustice which registration may inflict upon members of the "Hastings" family who may hereinafter engage in providing legal services, or by any possible detriment accruing to the general public in consequence of the registration to proceed. Furthermore, as pointed out in *Burford* and *Mattel*, *supra*, the question of whether anybody else has a right to use his or her own name in respect of service is a different matter. There has always been a common law right to use one's own name honestly.

62. In all the circumstances, I have come to the conclusion that the suit mark possesses inherent adaptability to distinguish and, by virtue of its long and extensive user, it has in fact become "distinctive" of the applicant's services and is therefore registrable under section 9(1)(e) of the Ordinance.

63. It follows that the opponent fails in its opposition under section 9 of the Ordinance.

Under section 10 of the Ordinance

64. Having decided that the mark is registrable under Part A of the Register, I do not think I need to consider the opposition under this section.

Under section 13(2)

65. A discretion arises under this section when the suit mark is accepted for registration under section 9 or 10 of the Ordinance and any opposition to the registration has been defeated.

66. Pursuant to this section, Ms Tam submitted that the Registrar can exercise his discretion to refuse registration of a mark as he thinks right. If the Registrar is in doubt about a mark's registrability, discretion should be exercised to disallow registration.

67. Ms Tam submitted that it is against public interest to ever allow monopoly of a surname by a single legal service provider, particularly when the surname is common in the western world. The ramifications and unfairness is poignantly demonstrative in the present case. It is obvious that the Registrar would

not allow registration of “Yuen & Co” or “Ho & Co”, not to mention just “Yuen” or “Ho”. The opponent said that in fact there is no difference between “Yuen”, “Ho”, “Smith”, or “Hastings”, viewing from a westerner’s perspective.

68. I remind myself that the register has been created by the Ordinance for the purpose of enabling marks to be entered therein. I do not think that the reasons advanced by Ms Tam are proper reasons to refuse registration for a qualifying mark, I therefore consider that the exercise of discretion should not be adverse to the applicant. I therefore decline to exercise my discretion adversely to the applicant.

Costs

69. The applicant 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 opponent pays the costs of these proceedings.

70. 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.

Original Signed

(Ms Fanny S.F. Pang)
p. Registrar of Trade Marks
27 April 2007