

Application No. 8105 of 2002

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

AND

IN THE MATTER of an application by Paul, Hastings, Janofsky & Walker LLP to register the mark

A **PAUL HASTINGS JANOFSKY & WALKER**

B **Paul Hastings Janofsky & Walker**

C **paul hastings janofsky & walker**

in Part A of the Register in Class 42

AND

IN THE MATTER of an opposition thereto by Yung Ching Tat and Kong Yuen Hoong trading as Hastings & Company

DECISION

OF

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on 6 March 2007.

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

Mr Albert Xavier instructed by Messrs. Hastings & Co. for the opponent.

Application for Registration

1. On 3 June 2002 (“the application date”), Paul, Hastings, Janofsky & Walker LLP (“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 marks, representations of which appear below :

A PAUL HASTINGS JANOFSKY & WALKER

B Paul Hastings Janofsky & Walker

c paul hastings janofsky & walker

(“the suit marks”).

2. The services intended to be covered by the registration were “legal services; legal advice; legal research; legal consultancy; professional consultancy relating to legal matters; legal enquiries; legal information research; provision of legal information; provision of legal information relating to legal services; information services relating to legal matters; compilation of legal information; legal services and legal advice relating to intellectual property and technology licensing, patent and trade mark attorney services, patent and trade mark agency services, copyright management services, searching and research services relating to patents, trade marks and intellectual property, establishment, enforcement, maintenance and exploitation of patents, trade marks and intellectual property rights; legal services and legal advice relating to corporate matters including company formation and registration services, corporate finance, project finance, mergers and acquisitions, due diligence investigations, analysis of information and preparation of investigation reports, all relating to the legal and regulatory aspects of an entity; legal services and legal advice relating to due diligence inquiries, analysis of information and preparation of inquiry reports, all relating to the reputation of an entity and its principals; legal services and legal advice relating to financial services, creditors' rights and bankruptcy, telecommunications, public offerings, equipment leasing, private investment fund formation, privatisations, securities regulations, energy, governmental affairs and general corporate representations; legal services and legal advice relating to litigation in the field of general commercial matters, intellectual property, antitrust, Employee Retirement Income Security Act, entertainment securities, Trade Regulation and environmental litigation; legal services and legal advice relating to employment law including employment discrimination litigation, employee benefits design and

litigation, and counselling and litigation under the National Labor Relations Act, the Fair Labor Standards Act, the Occupational Safety and Health Act, Employee Retirement Income Security Act, and State and Federal Statutes, and immigration; legal services and legal advice relating to real estate matters including debt financing, lending, construction and development, leasing, environmental matters, conveyancing, debt restructuring, institutional investment fund formation, joint-venturing and equity participations, land use, and permanent lending; legal services and legal advice relating to tax structuring of real estate and corporate transactions, including bankruptcy, investment funds, leveraged leasing, mergers and acquisitions, and project financing, workouts, cross-border tax advice to multinational clients, state unitary, sales and property taxes, and tax litigation and controversies; dispute resolution services; arbitration services; mediation services; legal support services; providing consultancy, information and advisory services relating to all of the aforesaid services; and also provided on-line from computer databases and from the Internet; translation services; all included in Class 42” (“the specified services”). The Registrar of Trade Marks (“the Registrar”) accepted the marks for registration in Part A of the Register. They are registered under section 26 of the Ordinance as a series of trade marks subject to a disclaimer of the words “PAUL” and “WALKER” in trade mark A, the words “Paul” and “Walker” in trade mark B and the words “paul” and “walker” in trade mark C. The application was advertised in the Government of the Hong Kong Special Administrative Region gazette on 10 October 2003.

Pleadings and Evidence

3. On 9 January 2004, Yung Ching Tat and Kong Yuen Hoong trading as Hastings & Company (“the opponent”) filed notice of opposition to the application. The grounds of opposition state that the opponent is a legal firm in Hong Kong, which provides legal services and related or similar services in Hong Kong and overseas. The opponent has by reason of extensive use acquired substantial reputation and goodwill in the names “Hastings” and “Hastings & Co.” and in the trade marks containing the word “HASTINGS” including the word marks “HASTINGS”, “HASTINGS & CO.”, “Hastings & Device” and the Chinese transliteration/equivalent “希仕廷” and “希仕廷律師行” in respect of legal and related services in Hong Kong and worldwide. The opponent avers that at all times, by reason of provision of the opponent’s services in Hong Kong, the opponent has established a reputation and goodwill in the opponent’s names and trade marks in Hong Kong and overseas. The applicant has applied to register the trade marks

“Paul Hastings Janofsky & Walker” in series in Class 42 under the subject application. It is the opponent’s case that the services covered by the suit marks in series are the same as, or are of the same or similar description to, the services of interest of the opponent. The suit marks so nearly resemble the names and trade marks of the opponent as to be likely to deceive or cause confusion. The opponent also pleads that the applicant is not entitled to be registered as the proprietor of the suit marks and the suit marks are not registrable under section 9 or 10 of the Ordinance. The grounds of opposition comprise sections 2, 9, 10, 12(1), 13(1), 13(2) and 21 of the Ordinance.

4. In the counter-statement, save the applicant’s own application for registration of the suit marks is admitted, essentially, all the allegations in the grounds of opposition are either denied or not admitted by the applicant. The applicant states that the suit marks are registrable under section 9 or 10 of the Ordinance. In relation to other grounds of opposition, the opponent is put to strict proof of its allegations in relation to those grounds. It is specifically denied that the suit marks are confusingly similar to the names and trade marks of the opponent.

5. The opponent’s Trade Marks Rule/s, Cap. 43, Sub. Leg. (“Rule/s”) 25 evidence comprises a statutory declaration declared on 15 November 2004 by Yung Ching Tat, the senior partner of the opponent, together with exhibits (“Yung’s statutory declaration”). The applicant’s evidence filed pursuant to Rule 26 consists of a statutory declaration declared on 17 May 2005 by Yeung Chi Kwong, the Director of Finance and Administration of the applicant’s Hong Kong office, together with exhibits (“Yeung’s statutory declaration”).

Decision

6. Though, by 6 March 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, Mr Xavier for the opponent only relied on the grounds under sections 12(1) (the likely to deceive ground), 13(1) and 13(2) of the Ordinance at the hearing.

Under section 12(1)

Threshold under section 12(1)

8. Before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its marks. At its very highest, it is a question of a substantial proportion of the interested public being aware of its marks, and at its very lowest, the question relates to the significance of the numbers in relation to the market for particular goods. In any event, the reputation of the opponent must be something more than *de minimis* (*Re Da Vinci Trade Mark* [1980] RPC 237).

9. By way of background, Ms Tam submitted that the applicant is a leading international law firm that has over 1,000 lawyers serving clients around the globe (paragraphs 6 and 8 of Yeung's statutory declaration). It provides a full range of services and has established long standing partnerships with many of the world's top financial institutions, Fortune 500 companies and other leading corporations (paragraphs 13 to 17 of Yeung's statutory declaration). The applicant was established in November 1951 in Los Angeles, USA (paragraph 3 of Yeung's statutory declaration). The applicant now has 17 global offices and was ranked 23rd in the USA and 28th in the world, according to the American Lawyer gross revenues survey for 2003 (paragraphs 7 and 11 of Yeung's statutory declaration). The applicant has around 50 lawyers in its Hong Kong office (paragraph 9 of Yeung's statutory declaration).

10. Ms Tam pointed out that the opponent is also a law firm and, according to its evidence, was established on 1st January 1904 as Hastings, John, Solicitor, Conveyancer, Proctor, Notary Public, Patent and Trade Mark Agent. The opponent acquired its present name of Hastings & Co in 1934. As at 15 November 2004 the opponent employed around 30 lawyers in Hong Kong.

11. Against that background, Ms Tam conceded on behalf of the applicant that the opponent has sufficient reputation in respect of the opponent's mark "Hastings" for legal services in Hong Kong at the application date for the purpose of satisfying the initial threshold under section 12(1) of the Ordinance. The onus then shifts to the applicant to satisfy the tribunal that there is no reasonable likelihood of deception arising among a substantial number of persons if the marks proceed to registration – *Eno v Dunn* (1980) 15 App case 252 at 261.

12. To supplement on top of Ms Tam's concession as the degree of reputation is relevant in assessing the likelihood of deception, I wish to say having taken a fair appraisal of the applicant's evidence by Yung's statutory declaration, I am satisfied that the applicant has provided legal services in Hong Kong 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, 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 paragraphs 21 and 22 of Yung's statutory declaration and "YCT-7"). In my view, on the evidence, the opponent's reputation in respect of legal services under the mark "Hastings" in Hong Kong was both long and substantial at the application date.

Test for likelihood of deception under section 12(1)

13. Ms Tam contended that under section 11 of the 1938 Trade Marks Act, the classic test of confusing similarity as laid down in *Smith Hayden & Co's application* [1946] 63 RPC 77 and modified in *Bali's* [1969] RPC 472 was to be applied. However, the distinction between the wording of section 11 of the 1938 Act and section 12(1) of the Ordinance cannot be overlooked. Section 11 contains a reference to "confusion" whereas no such reference appears in section 12(1). As a matter of construction of section 12(1) of the Ordinance, it is submitted that a mark will not fail to be registrable merely because a section of the public may be "confused", that is, caused to wonder whether or not services bearing the opponent's mark are the services of the applicant. A significant number of persons in the market must be shown to be likely to be actually deceived as to the origin of services provided, that is, misled into thinking that the services bearing the suit marks come from some other source. Due to the deliberate omission of the wording "or to cause confusion", the test must be regarded as more akin although not necessarily identical to passing off.

14. For clarity, the provisions of section 11 of the UK 1938 Act and section 12(1) of the Ordinance are reproduced below :-

“Section 11 :

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Section 12(1) :

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design.”

15. As an authority for her proposition, Ms Tam referred me to the case of *Excello* [1972] HKDCLR 67 where the applicant sought to register the mark “Excello” in respect of all goods included in Class 25 of Part B of the Register. The application was opposed by the proprietors of a common law mark “Excel” which was not registered under the Ordinance. Mr McLean for the Registrar observed at page 75 of the judgment as follows :

‘Now I turn to the two major questions to be answered in this case of which the first is :

Is the Applicant’s mark likely to deceive? – I have already referred to the distinction between the tests to be applied in Hong Kong and tests to be applied in U.K. under the Trade Marks Act. I am not explicitly required by the provisions of section 12(1) of the Ordinance to consider the question of confusion, but only the question of deception. There is an obvious difference between deception and confusion and this was alluded to by Salmon L.J. in **Re GE Trade Mark** (1970) 87 R.P.C. 339 at p. 364. He was then referring to the difference in wording between section 11 of the Trade Marks Act 1938 and the comparable section 11 of the Trade Marks Act 1905 (the provisions of which were similar to, but not identical with the current section 12(1) of the Ordinance). He said –

“The words ‘or cause confusion’ were, I think, added to the Act of 1938 to dispose of the possible argument that the use of a trade mark, although likely to

confuse by leaving in doubt, was not likely to deceive and therefore did not come within the old section 11”.

In the same case Winn. L.J. said at p. 376 : –

“... ‘to cause confusion’ is, however, a rather more general concept than ‘to deceive’, just as a mis-understanding or failure to understand may be less precise than a mis-conception or an erroneous belief ... Personally, I consider both spontaneously and after careful consideration of the evidence, ... that the use in 1967 in the U.K. of the GE rondel mark on goods in the course of trade ... was likely to cause confusion : it was not, in my view likely, though it was possible, that such use would deceive a substantial number of persons into an affirmative belief or opinion that the goods were the goods of the General Electric Company of England. If such use caused doubt and uncertainty whether such goods or goods were goods of G.E.C. or some other Company, it caused confusion.”

16. Relying on the above quoted passage, Ms Tam submitted that the test of likelihood of deception is not the same as likelihood of confusion which involves a higher hurdle. She pointed out that no higher court has overruled *Excello* although there are different views from different Registrar of Trade Marks.

17. Ms Tam referred me to another unreported decision before Miss A.C. Waters acting for the Registrar in *Jim Trade Mark* dated 27 February 1986. In that case, Miss Waters did not think that the dividing line between “deception” and “confusion” is as strong as may have been implied by Mr McLean in the *Excello* case but she would bear this distinction in mind when considering the case before her.

18. Ms Tam then drew my attention to *Hong Kong Caterers v Maxim’s Ltd* [1983] HKLR 287 where Hunter J. observed at 296 of the judgment that “section 12(1) makes the likelihood of deception an independent ground of objection. Lord Diplock’s speech in *G.E. Trade Mark* case [1973] RPC 297 wherein he delivered the opinion of the House of Lords makes it clear that the English section 11 differs in this respect. In the UK deception or confusion is only a possible means to an end, namely disentitlement to protection by the court, not an independent ground of its own”.

19. In reply, Mr Xavier submitted that the Registrar has consistently applied

the Smith Hayden test as modified by the Bali's test for the purposes of the "likely to deceive" objection under section 12(1) of the Ordinance which should be followed by me.

20. Mr Xavier pointed out that the High Court approach to section 12(1) of the Ordinance can be found in the case of *RE OMEGA* [1995] 2 HKC 473 at 477 where the then Deputy Judge Le Pichon at 477 said as follows :

"Mr Yan submitted that s 12(1) differs from s 11 of the Trade Marks Act of UK in that the likelihood of deception is an independent ground of objection. That proposition finds support in the decision of Hunter J in *Hong Kong Caterers Ltd v Maxim's Ltd* [1983] HKLR 287 at 296. Mr Yan submitted that the opponent is entitled to succeed under s 12(1) if it could establish either (a) that there is a likelihood of deception or (b) the use of the suit mark would be disentitled to protection in a Court of Justice. The onus of proof in such cases that there is no reasonable probability of deception is cast on the applicant. See *Kerly's Law of Trade Marks and Trade Names* (12th Ed) at 10-06.

(a) the likelihood of deception

The test is whether having regard to the user by the opponent of its trade marks, in particular in the vertical arrangement in which they are almost invariably represented in Hong Kong, the use by the applicant of the suit mark in a normal and fair manner in connection with writing instruments will not be unreasonably likely to cause deception and confusion. See *Re Smith Hayden & Co Ltd's Application* (1946) 63 RPC 97 at 101 and *Kerly* (op cit) at 10-02. As noted above, the onus of proof is on the applicant.

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 *GoldenJet* [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 mark 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?

I am satisfied on the evidence and in the light of all the factors referred to above that the use by the applicant of the suit mark in a normal and fair way would lead to deception and confusion. I do not agree with Mr Faux's finding that watches and pens would not normally be sold through the same trade channels. The evidence which relates to the market for luxury goods, into which category the opponent's goods unquestionably fall, is otherwise.

Further, I do not agree that what the applicant is seeking is a monopoly of the market. Rather, it is to prevent someone who is deliberately copying the opponent's mark with the intention of trading on the opponent's goodwill from trading on a mark that would inevitably confuse and deceive the public.

For these reasons, the opponent succeeds in its objection under s 12(1). It is therefore not strictly necessary to consider Mr Yan's second point on s 12(1). Nevertheless as the point was taken, I will address it."

21. Mr Xavier contended it is clear that the then Deputy Judge did not confine herself to deception. She also mentioned confusion in applying the test under section 12(1) of the Ordinance in *Re Omega*.

22. Furthermore, Mr Xavier argued that, for the purposes of section 12(1), it is trite law that the confusion need not necessarily lead to passing off. There may be confusion in the sense of section 12, although the purchaser is not, in the end, deceived. If persons are likely to wonder whether or not goods were made or services provided by an opponent, the mark applied for is one which is likely to cause confusion because people's minds will be put in a state of doubt or uncertainty (*Hack's Application* (1941) 58 RPC 91 at 102 and *Kerly's Law of Trade Marks and Trade Names* (12th Ed) at paragraph 10-06).

23. In my view, Ms Tam's submissions raise the question as to whether the omission from the Ordinance of the words "or cause confusion" significantly alters the classic test for the application of section 12(1) as laid down in *Smith Hayden*. The crux of Ms Tam's submissions is that "deception" means that people must be likely to be actually deceived as to the origin of services provided and therefore the

onus of the applicant to establish there is no reasonable likelihood of that occurring is easier than if he had also to establish there is no reasonable likelihood of purchasers being “confused” or made to wonder whether it might be the case that both services come from the same source.

24. In my judgment, in the *Maxim's* case cited by Ms Tam, Hunter J. at page 297 of the judgment expressed the test for section 12(1) in these terms : “The likelihood of deception or confusion has here to be assessed ...” Similarly in *Re Gay Giano Trade Mark* [1996] 2 HKC 646, Leonard J., under the heading “Likely to deceive” at page 652 of the judgment said : ‘The test to be applied here is whether there will be a “reasonable likelihood of deception or confusion among a substantial number of persons” if the respondent sells its watches in Hong Kong bearing the trade mark which it has registered.’ In *Re Omega* [1995] 2 HKC 473, Deputy Judge Le Pichon (as she then was) simply adopted the Smith Hayden test including the words “and confusion”.

25. I have to say that the point was not argued before the High Court when the aforesaid observations were made in the cases above. However, the point was argued and considered by some Registrar’s decisions in the past. The difference between the two sections had been considered by Mr Perera in the unreported decision of *Citizen Trade Mark* dated 14 December 1990 (pages 12 to 14), Mr Fox in *Sans Souci & Device* [1991] HKEC 135 (paragraphs 43 and 44) and Miss Fung Shuk Hing in *Bossini*, unreported decision dated 30 December 1997 (paragraphs 82 to 85). It was considered that the likelihood of deception is wide enough to catch confusion (*Southern Cross Refrigerating Co v. Toowoomba Foundry Proprietary Ltd* (1954) 91 CLR 592).

26. Having taken into account all the above authorities, I still consider 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 name or mark “Hastings” in respect of legal services, is the Registrar satisfied that the suit marks, if used in a normal and fair manner in respect of the specified services 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 the 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?”

27. In my opinion, it is clear in the application of the test that the suit marks must offend if its use in respect of any of the specified services is likely to cause deception or confusion in the minds of persons to whom it is addressed, even if actual purchasers will not ultimately be deceived. Likely purchasers must not be put into a state of doubt. There must however be a real tangible risk of confusion, not mere possibility.

Normal and fair use of the suit marks

28. Mr Xavier pointed out there is clear evidence that the applicant intends to use and is in fact using only the name “Paul Hastings” (see “Bundle Exhibit B” at page 923 to 950 of “YCT-12”). If in fact it is known what use an applicant intends to make of a mark, that use cannot be excluded. Thus evidence that an intended use is particularly likely to be confusing is helpful to an opponent, to prevent such use being dismissed as unfair or fanciful (*Kerly’s* (12th Ed) at paragraph 10-04).

29. Mr Xavier submitted that the applicant is virtually unknown in Hong Kong. The name “Paul Hastings” has never been used before by anyone in Hong Kong. As against that, the opponent has already established a very substantial and extensive reputation under the name “Hastings” in Hong Kong. Thus, there would be a strong likelihood of confusion if not deception by the use of simply the name “Paul Hastings”. This is because in Hong Kong “Hastings” only means the opponent.

30. Further, Mr Xavier argued that the addition of the name “Paul” is insufficient to distinguish the applicant from the opponent at all. “Paul” is a very common forename indeed in Hong Kong and perhaps the rest of the English speaking world.

31. In *Dominique Arpels TM* (unreported decision dated 17 May 1994), the learned Registrar held that Dominique is a relatively common forename and the significant part was the name “Arpels”. The suit mark was therefore confusingly similar to the opponent’s mark Van Cleef & Arpels because Arpels and Van Cleef do not outshine one another and Arpels retains sufficient significance on its own account

(see paragraph 120 of the decision) in the opponent's mark to cause the mark to be recognised and remembered as much as by Arpels as by Van Cleef. In particular, the Registrar referred to *Parker-Knoll* (1962) RPC 265 and said that that case showed the first name of a two-name mark is not necessarily the significant feature of the mark.

32. Applying the above authority to the present case, Mr Xavier contended that "Paul" being such a common forename in Hong Kong would be totally ignored by the general public. Alternatively, they might assume that "Paul" is simply the forename of whoever founded the opponent. If the applicant simply uses "Paul Hastings" as its name, the relevant public will definitely wonder if the applicant is the opponent.

33. It is clear from the formulation of the test under section 12(1) in *Smith Hayden* that I must have regard to the normal and fair use of the suit marks and the actual use of the opponent's mark in the comparison. Whilst it is not in dispute that the opponent's mark in actual use is "Hastings", there is a dispute on what the normal and fair use of the suit marks should be. Mr Xavier submitted that there is clear evidence that the applicant intends to use and in fact using only the name "Paul Hastings" ("YCT-12" to Yung's statutory declaration). Therefore, Mr Xavier said that the comparison under section 12(1) should be between "Paul Hastings" being a normal and fair use of the suit marks and "Hastings".

34. In my judgment, it is trite law that it must not be assumed against the applicant that he is going to use his mark unfairly, in the sense that he is going to use something different, by leaving out or obliterating any parts of the mark so as to make it more like that of the opponent, for the court presumes that a trade mark will be used fairly and without fraud. The presumption will be rebutted if there is evidence that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent (*Kerly's* (12th Ed) at paragraph 17-20).

35. I have carefully considered the evidence, in particular, "YCT-12" to Yung's statutory declaration and exhibits "1-3" to Yeung's statutory declaration. In paragraph 19 of Yeung's statutory declaration, Mr Yeung says that the applicant provides legal services through its offices worldwide under the trade marks "Paul Hastings Janofsky & Walker", "Paul Hastings (logo)" and "Paul Hastings (plain letters)". As shown by the evidence in "YCT-12" to Yung's statutory declaration and "1-3" to Yeung's statutory declaration, I do not think that I can agree with Mr Xavier

that the applicant intends to use and is in fact using only the name “Paul Hastings” instead of the suit marks. I consider it is apparent from the evidence that the applicant has used both the suit marks and name or mark “Paul Hastings” in providing and promoting their legal services. In fact, the applicant has filed a series of trade mark applications in Hong Kong for both the suit marks and the mark “Paul Hastings” in different forms (paragraph 22 of Yeung’s statutory declaration). In all the circumstances, for the purposes of the present application, I do not accept that use of the name or words “Paul Hastings” without “Janofsky & Walker” is a normal and fair use of the suit marks. The suit marks must be supposed to be used precisely as registered (see paragraph 10-04 of *Kerly’s* (12th Ed)). Hence, the comparison under section 12(1) should be between the suit marks “Paul Hastings Janofsky & Walker” and “Hastings”.

Comparison of the marks

36. On a comparison of the marks, Ms Tam submitted that the suit marks in series are the same : each of them is a combination of four surnames, namely, “Paul”, “Hastings”, “Janofsky” and “Walker”. Ms Tam argued that besides the fact that the common surname “Hastings” is used in the suit marks and the opponent’s mark, there is no similarity between the two sets of marks. The former is a set of marks with a combination of four surnames, while the latter, one.

37. Mr Xavier submitted that the actual extent of the reputation of the opponent’s mark and the range of services and/or goods for which it has been achieved are factors in determining whether there is sufficient likelihood of deception or confusion to warrant refusal of registration under section 12(1).

38. Mr Xavier contended that through extensive and prolonged use, the opponent has acquired a substantial reputation in the mark “Hastings” in Hong Kong. It is the only party in Hong Kong using the name or mark “Hastings” for legal services since 1904 and the name or mark “Hastings & Co.” since 1934 in Hong Kong. “Hastings” means the opponent and no one else in Hong Kong. By the application date, the opponent’s mark has been used for about 103 years in Hong Kong.

39. Mr Xavier argued that as the opponent’s name and mark “Hastings” has been extensively used over a very prolonged period in Hong Kong and has acquired a very substantial reputation, the use of the name and mark “Hastings” and/or Hastings

& Co. in the legal field means the opponent and no one else. The use of the name and mark “Hastings” in the suit marks in series and name of the applicant in the legal field would clearly suggest that the applicant is associated and/or connected with the opponent or that the two firms have merged.

40. The addition of the other names namely “PAUL”, “JANOFSKY” and “WALKER”, Mr Xavier argued, cannot prevent the association and/or connection being made by the general public. This is because at the application date, the proprietor of the name and mark “Hastings” is the opponent and the opponent is the only party in Hong Kong using the name and mark “Hastings” for legal services in Hong Kong. To the general public, “Hastings” means the opponent only.

41. In making a comparison of the respective marks, I accept Ms Tam’s submissions that apart from the fact that the surname “Hastings” is used in the suit marks and the opponent’s mark, there is no similarity between the two sets of marks as a whole. I am of the view that the suit marks as a whole are distinguishable from the word “Hastings” alone notwithstanding the fact that “Hastings” has been used in Hong Kong for a long time and substantially by the opponent to indicate the origin of its legal services.

Services to which the respective marks are applied and all the surrounding circumstances

42. I now turn to consider the services to which the respective marks are applied. Ms Tam rightly submitted that all the surrounding circumstances and the nature of the goods and services must be considered when deciding whether there is likelihood of deception (*Pianotist* (1906) 23 RPC 774). She contended that it must not be assumed that a very careful or intelligent examination of the mark will be made. But, on the other hand, it can hardly be significant that unusually stupid people, “fools or idiots”, or a “moron in a hurry” may be deceived. If the goods are expensive or important to the purchasers and not of a kind usually selected without deliberation, and the customers are generally educated persons, these are all matters to be considered (*Kerly’s* (14th Ed) at paragraph 17-019). Ms Tam relies strongly on the last proposition. She argued that the class of purchasers will vary with the nature of the product. Where goods or services are expensive or of a technical nature, it is likely that they will be bought by discerning people or those of relevant training (*Shanahan’s Australian Law of Trade Marks and Passing Off* (3rd Ed)) at paragraph

7.135).

43. Ms Tam submitted that seeking legal services or advice is not a frivolous matter. Unlike the typical supermarket “grab-and-go” situation, legal services are costly and are not sought frequently by members of the public. The fact that the goods in question are expensive means that it is unlikely that the consumers would be confused or deceived (*Montres Tudor Sa v Concord Watch Co SA* [2001] HKEC 915 at paragraph 30). For corporate clients who have to seek legal services regularly, they are more likely than not to be prudent about their choices and would not fail to discern between one firm and another. Clients seeking legal services are therefore expected to exercise great discernment. This is an overriding factor.

44. Ms Tam argued that clients seeking provision of legal services by international firms are generally more educated. Most are businessmen or professionals. They therefore would not be easily confused by mere visual or aural resemblance of the marks of the service providers. If customers are people in the trade, they are less likely to be deceived (see also *Claudius Ash v Invicta* (1911) 29 RPC 465 (HL), where the customers were dentists and their assistants). Even clients seeking legal services by a local law firm are most unlikely not to distinguish between the applicant and opponent’s firm names. The suit marks consisting of a list of four names is plainly different from the applicant’s firm name “Hastings & Co.”.

45. Ms Tam went on to contend that the prevalent practice and the nature of the trade further render deception highly unlikely. Names of most law firms comprise a combination of surnames. Inevitably, many of the law firms are making use of the same surnames as part of their names. As a result, many of the names of the law firms are visually similar (paragraph 28 of Yeung’s statutory declaration). Clients seeking legal services are therefore expected to be familiar with the minor variance between the names of different firms. Further, in practice, most clients seeking legal services are looking for an individual, that is, a solicitor or partner as a point of contact (see “YCT-11” to Yung’s statutory declaration, where on most occasions the clients or callers looked for a named individual in the firm) without caring about the firm’s name. If he or she is not available at a given address or telephone number, alarm would sound, and no “deception” would be likely. Moreover, professional ethics demand lawyers to clarify with the client upon discovery of any mistakes in approaching the wrong legal service provider (paragraph 31 of Yeung’s statutory declaration).

46. Ms Tam submitted that even if the Registrar takes the view that mere likelihood of confusion is sufficient to prohibit the suit marks from being registered by virtue of section 12(1), the applicant can still show that there is no real tangible risk that a substantial number of persons would be confused by the use of the suit marks.

47. To counter, Mr Xavier submitted that the relevant public for the present purposes is not restricted to the legal profession but to the general public at large i.e. anyone who might need legal services of all types. This would include all walks of life. Unlike the legal profession, there is no or little opportunity for the public at large to know or find out that the applicant is not related or associated with the opponent in any way.

48. Mr Xavier submitted that by virtue of the extremely prolonged use and substantial reputation of the opponent's name and mark "Hastings" and the fact that the opponent is the only and exclusive party using the mark "Hastings" for legal services in Hong Kong, the use of the mark "Hastings" in any other names by a third party who is totally unknown in Hong Kong and has never used the same in Hong Kong would lead the public to assume that such company with the "Hastings" mark in its name is either an offshoot of the owner of the mark or that owner having changed its name and/or it is associated or merged with the opponent "Hastings". Alternatively, members of the general public who may need legal services may have been informed of the opponent under the name "Hastings" and when they see the applicant's name, they would definitely be caused to wonder whether the applicant was the opponent and/or that the applicant was associated with the opponent. If in doubt, the application must be refused.

49. I have found in paragraph 41 above that the suit marks as a whole are distinguishable from the word "Hastings" alone. It is not in dispute that in addition to a comparison of the marks *per se*, I must also have regard to all the circumstances of the trade in which the marks in question are employed or are to be employed including the nature of the services and the persons who will encounter the services in deciding whether there is a likelihood of deception or confusion. Whilst I accept Mr Xavier's submissions that the relevant public for seeking legal services is not restricted to the professionals, businessmen or corporate clients but includes the general public at large, I am convinced by Ms Tam's submissions that the circumstances of the trade would significantly minimise any possible risk of

deception or confusion. Given the nature of legal services which are expensive and important to the purchasers, they would only be sought after thought and with care. It is also true that in practice, most clients seeking legal services are looking for an individual, i.e. a solicitor or partner as a point of contact. Further, having regard to the practice of the naming of law firms, I also accept that clients seeking legal services are expected to be familiar with the minor variance between the names of different firms. Turning to the present case, I would not consider the difference between the suit marks and the opponent's name or mark "Hastings" as minor variance at all. Therefore, it is even much more easier for the public to distinguish the two firms.

50. Having taken into account all the above, I find that there is no reasonable likelihood that members of the public will be deceived or confused into thinking that the applicant's services bearing the suit marks are those of the opponent or in some way related to or endorsed by the opponent.

Alleged evidence of actual public confusion

51. The opponent has produced some alleged evidence of actual public confusion on the applicant's name and suit mark "Paul Hastings Janofsky & Walker" and the opponent's name and/or mark "Hastings" (see paragraph 29 of Yung's statutory declaration and "YCT-11").

52. At this juncture, I would like to mention that although most of the evidence on alleged instances of confusion filed by the opponent is post-application date, Ms Tam accepted that those evidence as experience subsequent to the date of application is relevant as providing a test of tendency to confuse. She therefore proceeded to make submissions in relation to those evidence on alleged instances of confusion.

53. Ms Tam contended that with respect to the alleged "incidents of confusion" particularized in "YCT-11", none is of a relevant kind of confusion in law, as those incidents do not lead the public into receiving the "wrong" goods or services. Alternatively, they are misconceptions which are quickly dispelled.

54. Ms Tam pointed out that according to paragraph 29 of Yung's statutory declaration, he deposed to the fact that there were several occasions where he had

been approached by his learned friends, friends and clients whether the applicant is related to “Hastings” . Evidence on alleged actual instances of confusion were said to be produced in the exhibit “YCT-11” which includes copies of envelopes, letters, extract of internet website, memos and telephone notes.

55. By way of background, Ms Tam pointed out that the opponent first commenced practice in Hong Kong in May 2002 and the office was then located at the 22nd Floor of the Bank of China Tower. The 21st Floor of the Bank of China Tower was the old address for the opponent Hastings & Co.’s office. When Hastings & Co. moved out of the 21st Floor of the Bank of China Tower, the applicant took up the 21st Floor, the old office of the opponent, as their office as well.

56. Ms Tam then went through the evidence on the alleged instances of confusion in “YCT-11” piece by piece. The first piece of evidence contained in “YCT-11” is a memo from one Cedric Yip dated 13 November 2002. In the memo, it was stated that :

“On 2 September 2002, we have arranged a meeting with our client, Ms. Shirley Chan and Mr. Kevin Wong of W.H. MANDOLYN INTERNATIONAL LTD. in our office at 2:30 pm. Ms. Chan and Mr. Wong did not aware that we had relocated at Landmark since last September and went to our old address at 21/F Bank of China Tower. As the name of the law firm currently located at 21/F Bank of China contains the word “HASTINGS”, they did not aware that is another law firm without any connection with us. They therefore told the receptionist they have an appointment with “Miss Mok”. However, the “Miss Mok” at that firm did not have appointment with them.

They eventually realized that they might go to the wrong place because no people at that firm have appointment with them. Ms. Chan then called me to clarify which is our current address at around 2.50 pm.”

57. In relation to this piece of evidence, Ms Tam submitted that Ms Chan and Mr Wong, clients of the opponent, mistakenly went to the applicant’s office for an appointment with “Miss Mok” of the opponent. This contains multiple hearsay. Presumably, Ms Chan and Mr Wong had been Hastings’ old address before and went to that address for an appointment. It is a mistaken address scenario which refers to the fact that the applicant happened to have moved into the old office of the opponent

and the mistake was about the address and not the respective identities of the applicant and the opponent. As a named individual was specified as a point of contact, ultimately no deception or confusion could occur.

58. As to the second piece of evidence in “YCT-11”, it contains a fax from Deacons dated 13 November 2002. It seems that Deacons intended to send a fax to one Mohan Datwani, a partner of the applicant, but wrongly sent it to the opponent’s office. Ms Tam submitted that this is hearsay evidence. Again it is a mistaken number scenario. It is not clear how Deacons made the mistake and who sent the fax. It is the opponent who was mistaken as the applicant and not vice versa. As the fax was addressed to a named individual, ultimately no deception or confusion could occur.

59. The third item contained in “YCT-11” is a mail (envelope) from Richard Ellis dated 28 August 2002 addressed to “Mr Yung Shing Tat, Partner Paul, Hastings, Janofsky & Walker” which was mailed to the opponent’s address. Ms Tam contended that this is hearsay evidence. There is a misspelling of the first letter of the word “Ching” in the partner’s name “Yung Ching Tat”. Therefore, in fact, there is no such person, whether in the applicant or the opponent’s firm. There is no evidence from the opponent as to the nature of the mail, whether Mr Yung is thought as part of the applicant’s firm and whether Richard Ellis is Yung’s client.

60. Turning to the fourth piece of evidence in “YCT-11”, it is a mail from MTR Corporation addressed to “Mr Shing-Tat Yung, Partner Paul, Hastings, Janofsky & Walker” which was mailed to the opponent’s address. As with the third piece of evidence, the same mistake was made by two different senders : they would have obtained those mailing details from the same source. This is again a mistaken firm name or address scenario. It is not clear whose mistake it was or how the mistake was made. There is no evidence from Mr Yung as to what this mail is about. This appears to be a plastic envelope containing promotional materials. As the mail was addressed to a named individual, ultimately no deception or confusion could occur.

61. Ms Tam moved on to the fifth piece of evidence in “YCT-11” which is an extract from a website, namely Icered.com. It seems that the messages dated 20 March to 11 April 2002 posted on the website were related primarily to gossip concerning the opponent’s personnel problems. On 26 April 2002, someone posted

“heard rumour of a merger”. On 28 April 2002, someone posted “is Hastings the same as Paul Hastings”? The answers to the questions posted are not shown in the website. Ms Tam submitted that it is hearsay evidence. In the light of the nature of the website which is posting gossip, it is not clear who posted the message but it is highly unlikely that he or she would be a relevant member of the public seeking legal services. The nature of the communication is such that people are not expected to be reasonably prudent about the correctness of what they say. The website contains silly remarks and questions. The contents of the website are inherently unreliable and do not assist at all.

62. The sixth piece of evidence in “YCT-11” is a “visitor and telephone message” dated 6 May 2002. Someone jotted down that a Mr Wu from “唯一水壺” called YCT, intending to ask him “is Hastings same as Paul Hastings”. Ms Tam submitted that it is not known who recorded the message and whether the record is contemporaneous. It is not known what weight should be attached to it. The evidence is multiple hearsay. There is no evidence from Mr Yung following the receipt of this message. It is not known how Mr Wu was mistaken. There is simply no confusion or deception as to origin. If somebody goes to the firm of the applicant Paul, Hastings, Janofsky & Walker on the strength of Hastings’s reputation and seeks legal services thinking that they are seeking Hastings’ services, that only will amount to confusion or deception as to origin.

63. The seventh piece of evidence in “YCT-11” is handwritten notes by Stella Lee dated 15 May 2002. The notes state, *inter alia*, that a foreign lady dialled the opponent’s number looking for her friend “Paul Hastings” who was allegedly working in Hong Kong. Ms Tam pointed out that this piece of evidence is multiple hearsay. The opponent was mistaken as the applicant and not vice versa. Stella clearly did not understand the lady properly when she took the message. It is a mistaken number scenario. It is not clear how the mistake was made.

64. The eighth piece of evidence in “YCT-11” comprises handwritten notes by Dora dated 28 April 2003. Essentially, it is a postal misdelivery case. Allegedly someone on the 21st Floor of the Bank of China Tower wrongly told the postman that the letter was wrongly addressed to them. Ms Tam contended that it is multiple hearsay. It is a mistaken address scenario and the postman is not a relevant member of the public seeking legal services. It is not known who Dora was. The letters mentioned are not part of the evidence. It is not known how the envelopes of the

letters read. It is an ignorant messenger situation compounded by the confusion over office address.

65. The ninth piece of evidence in “YCT-11” consists of handwritten notes by Dora dated 7 October 2004. The notes state, *inter alia*, that an English speaker who did not leave his name dialled the opponent’s number and requested to speak to the partner-in-charge of its Shanghai office. Dora told him that “we did not have any branch at Shanghai but got one at Shenzhen. I told we were Hastings & Co.”. He then asked to speak to Mr Tom Shoemith. Actually, he was looking for Thomas Mark Shoemith of the applicant. The notes specifically state “he thought that ‘Paul Hastings’ and ‘Hastings & Co.’ were the same firm. He also could not locate Paul Hastings on the Law List”. Ms Tam pointed out that it is multiple hearsay. As a named person was specified as a point of contact, ultimately no deception or confusion could occur. The main cause of the problem was probably the fact that the English speaker could not find the applicant in the Law List. The opponent was mistaken as the applicant and not vice versa. Further, the person who made the call might only know “Paul Hastings” and not “Hastings”. If so, the classic test of confusion does not apply. Ms Tam further argued that to find out whether the English speaker actually said “Paul Hastings and Hastings & Co. were the same firm”, there is a need to cross-examine Dora. However, it is not possible to do so as Dora is not a deponent of any evidence filed by the opponent. Ms Tam submitted that this kind of evidence is extremely unreliable. The English speaker in this case was looking for a particular lawyer in the applicant’s firm. He was not a client of Hastings & Co. telephoning Paul Hastings thinking that he was getting the services from Hastings & Co.

66. Finally, the last piece of evidence in “YCT-11” contains one Lee’s response to a circular from JAN for YCT of the opponent to all of its partners and staff dated 11 November 2004. The circular asked staff to let JAN or [YCT] know “if any of your clients/other professional contacts have informed them of their confusion on discovery that there is a solicitors’ firm with a name similar or close to our name HASTINGS & COMPANY (which incidentally is operating from our old address)”. Lee wrote “offhand I can think of two”. He wrote first, “through arrangement of Jingle, I moved the admission of a US attorney qualified as HK solicitor. She thought we were Paul Hastings”. Secondly, Lee wrote “Mr Eric Lam of Jianlibao Holdings (HK) Co Ltd asked if we were connected with Paul Hastings”. Ms Tam contended that it is multiple hearsay. Freshness of recollection is not

assured. Both queries have arisen obviously because they know “Paul Hastings” but did not know “Hastings”. So classic test of confusion does not apply.

67. On the whole, Ms Tam submitted that the evidence on those alleged instances of “confusion” is inherently unreliable because of their hearsay and multiple hearsay nature. It is impossible to test the cause of the confusion, or to the cause of the confusion, or to rely on the information collected by the provider of the hearsay evidence. By reason of the nature of the evidence, the applicant is deprived of the opportunity to probe into the cause and the facts whether by further investigation or by cross-examination.

68. Ms Tam contended it is clear that if those incidents occurred at all, they had occurred only due to the fact that the opponent happened to have moved into the old office of the applicant and that the applicant’s reputation precedes the ready availability of its number as a local law firm, as it had just commenced practice on advising on foreign law only. As a result of knowledge of the presence of Paul Hastings in Hong Kong, enquirer would like to know whether Hastings is connected with Paul Hastings. In all the cases, a particular individual was named. The people involved know the difference and just want to confirm that whether they are the same firm or not. Individuals might have been mistaken about the address and contact details of the opponent or the applicant by having been given a wrong telephone number to dial. They are cases of ignorant messengers of telephone or fax numbers identified by office assistants or clerks. As to the circumstances of how that number was obtained, nobody will ever know. Any misconception was quickly put to rest at the first contact. There was no confusion as to origin at all.

69. In the premises, the applicant says that there is no evidence involving any material confusion, let alone deception, since the setting up of the applicant’s Hong Kong’s office.

70. With respect to the alleged instances of confusion referred to by the opponent, I have set out in detail Ms Tam’s criticisms on the evidence above with much of which I totally agree. I consider that the criticisms on the main are validly made. For some documentary evidence such as mails of Richard Ellis and MTR Corporation, they are just unexplained documents. I find it difficult to draw any inference from those documents and really do not see that they amount to any evidence of likelihood of deception or confusion. Furthermore, most of the evidence

is not in the trading context of seeking legal services. As described by Ms Tam, they are cases of mistaken firm names or address scenario. I have to say that mere “administrative” confusion such as misdirected post and the like will not assist (*Kerly’s* (14th Ed) at paragraph 17-072). For those evidence concerning whether “Hastings” and “Paul Hastings” are the same firm or connected, they seem to me no evidence of confusion. The people involved knew the difference between “Hastings” and “Paul Hastings”. I am convinced that the main cause of the problem, as submitted by Ms Tam, is that the opponent happened to have moved into the old office of the applicant at the material time. In all the circumstances, I do not see that the evidence contained in “YCT-11” constitutes any evidence of likelihood of confusion or deception on the part of a member of the public as to whether the opponent is indeed connected with the applicant. I am therefore not persuaded that I should depart from my own initial conclusion above, based on my own consideration of the similarity between the marks in issue and all the surrounding circumstances having regard to the reputation of the opponent’s mark in respect of legal services that there is no reasonable likelihood of deception or confusion should the suit marks proceed to registration.

71. It follows that the opposition under section 12(1) is defeated.

Under section 13(1)

72. Mr Xavier submitted that the opponent having used the name “Hastings” since 1904 is the sole and lawful owner of the said name or mark. No one including the applicant can claim proprietorship to that name or has any right to include the name owned by the opponent as part of the applicant’s name or suit marks.

73. In reply, Ms Tam submitted that the applicant is entitled to be registered as the proprietor of the suit marks pursuant to section 13(1) as the applicant has always been using the suit marks for half a century worldwide in relation to the provision of legal services (see Yeung’s statutory declaration). The suit marks continue to be so used by the applicant after the application date. There is no prior assertion of proprietorship by others.

74. In my judgment, an opponent, to successfully mount an opposition under Section 13(1), must establish that it, rather than the applicant, is the proprietor of that trade mark, or a mark virtually identical to it, in respect of identical goods. This

principle was clearly established in *Re Wowi & Device Trade Mark* [1998] 3 HKC 221.

75. The test that should be applied by me in determining whether the two marks are virtually identical can be found on page 229 of *Re Wowi & Device Trade Mark* (supra) :

“However, for the question of proprietorship to arise all the parties must be claiming the same mark or at least marks which are so nearly identical as to be virtually the same mark : *Kendall Co v. Mulsyn Paint and Chemicals* (1963) 109 CLR 300; *Tavefar Pty Ltd v Life Savers (Australia) Ltd* (1988) 12 IPR 159. The question is not whether the marks are so alike as to be deceptively similar, which is obviously a relevant consideration under sections 28 and 33. In deciding whether the marks are substantially identical I think I am entitled to compare the marks side by side. This would seem to follow from what the High Court has said in relation to the question where conflicting marks are substantially identical in terms of section 33 : *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407. I think it is clear when the applicant’s and opponent’s marks are compared side by side that there are very obvious differences to the extent that it cannot be said that they are the same mark or so similar as to be in effect the same mark.”

76. I think it is apparent when the suit marks and opponent’s mark are compared side by side, there are obvious differences that it cannot be said they are the same mark or so similar as to be in effect the same. It follows that the opposition under section 13(1) is defeated.

Under Section 13(2)

77. The opponent has asked me to exercise my overriding discretion to refuse registration. The discretion arises when the opponent has failed in its objection under sections 12(1) and 13(1) of the Ordinance and the suit marks are registrable under either section 9 or 10 of the Ordinance.

78. Mr Xavier submitted that the following factors are relevant in the exercise of discretion under section 13(2). First, the register exists not simply to protect the interest of trade mark owners but also to protect the general public from being misled or confused. In the present case, the applicant is one who is totally

unknown in Hong Kong. The applicant has never used the suit marks and/or the name “Paul Hastings” in Hong Kong. At all material times, the applicant knew the existence of the opponent and its substantial reputation and that “Hastings” means the opponent in Hong Kong. The applicant knew that the opponent is the only party offering legal services in Hong Kong under the name “Hastings”. The applicant has elbowed into a market which it has no reputation and thereby benefiting from the goodwill and reputation owned by the opponent. If a trader enters a market in which his surname has already been appropriated to denote an article, it is no great hardship that he should have to pick another name for a similar article which he wants to make competitive (*Parker Knoll* (1962) RPC 265 at page 289, as per Lord Delvin).

79. Mr Xavier contended that the relevant public is not restricted to professionals, the well-educated or the middle class. It covers almost everyone in Hong Kong (except perhaps very young children) including in particular a very large substantial group of poor and less educated members of the public. Despite knowing of the opponent being the only party using the name “Hastings” for legal services in Hong Kong and is the lawful proprietor of the same, the applicant has used simply the name “Paul Hastings” knowing the “Paul” is a very common forename of no significance. Confusion is not only likely but inevitable.

80. In reply, Ms Tam submitted that the opponent did not suggest any basis for the Registrar to exercise his discretion under section 13(2) to refuse the application. Ms Tam contended the fact that the applicant accepts the opponent can establish reputation as to “Hastings” in respect of legal services does not necessarily mean that the opponent is the only party in Hong Kong that could use “Hastings” as part of a trade mark. The opponent has not commenced an action of passing-off against the applicant. There is no law restraining the applicant to use their firm name. It only depends on whether there is a reasonable likelihood to deceive by the use of the suit marks by the applicant. If there is no reasonable likelihood to deceive, the discretion should not be exercised in an adverse manner to the applicant to refuse the application for registration.

81. In my judgment, as disclosed in paragraph 3 of Yeung’s statutory declaration, the applicant is a limited liability partnership organised under the laws of the state of California in the United States of America. The applicant was established in 1951 and was named after its four founding partners Mr Lee Paul, Mr Robert Hastings, Mr Leonard Janofsky and Mr Charles M. Walker. Its first office

was in Los Angeles. Since 1974, the applicant had opened additional offices outside Los Angeles in the United States. In 1988, the applicant increased its global capabilities by opening an office in Tokyo, Japan (paragraph 4 of Yeung's statutory declaration). In 2002 the applicant submitted an application to the Law Society of Hong Kong for registration as a foreign law firm. In May 2002 the applicant commenced practice as a registered foreign law firm in Hong Kong and commenced an association with Koo & Partners (paragraph 5 of Yeung's statutory declaration). The intention is that once the applicant has completed the necessary three year period as a registered foreign law firm and once all other regulatory requirements have been satisfied, steps will be taken to enable the applicant to merge with Koo and Partners and for the merged firm to operate under the applicant's name.

82. It is clear from the evidence that the applicant is an international law firm and had started to expand their business in Hong Kong as at the application date. I do not accept Mr Xavier's contention that the applicant has elbowed into a market which it has no reputation and thereby benefiting from the goodwill and reputation owned by the opponent by using the suit marks which on the whole, as I have found, are distinguishable from the opponent's mark or name "Hastings". It appears that the applicant has all along acted *bona fide* and there is no particular evidence of dishonesty on the part of the applicant. There is no question of the copying of the opponent's mark by the applicant with the intention to ride on the opponent's reputation so as to obtain benefit in the marketplace which would inevitably confuse and deceive the public. I do not find that there are circumstances in the present case that would justify the exercise of discretion against the grant of the registration of the suit marks. For these reasons, I decline to exercise my discretion in an adverse manner to the applicant.

Costs

83. 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.

84. 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
2 May 2007