

Application No. 8293 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 36

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 5 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 36, 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 “financial consultancy; insurance consultancy; financial services; financial brokerage; consultancy relating to real estate affairs, trusteeship; information, consultancy and advisory services in relation to financial services; consulting and risk assessment services in the field of financial services; corporate finance advice; financial advisory and analysis services; financial research; risk analysis services (financial); and also provision of all the aforesaid services via the Internet, on-line and electronic media; all included in Class 36 (“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 36 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 section 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)

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. While Ms Tam accepted on behalf of the applicant that the opponent has reputation in respect of the opponent's mark "Hastings" for legal services in Hong Kong, she did not concede that the opponent is able to overcome the initial threshold under section 12(1) of the Ordinance as the reputation is not in respect of the specified services.

10. Mr Xavier submitted that it is well settled in *Re Omega* (1995) 2 HKC 473 and *Gay Giano Trade Mark* (1996) 2 HKC 646 that the reputation of the opponent needs not be in respect of the same goods as those of the suit marks. The fact that reputation is not in respect of the particular services is a factor to be taken into account in assessing confusion, not a pre-condition for opposing the registration of a mark under section 12(1).

11. I accept Mr Xavier's contention that it is well settled law that to overcome the initial threshold, reputation needs not be in respect of the particular services in question although it is a factor to be taken into account in assessing confusion and deception.

12. To supplement, 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 at the application date.

13. As the opponent has overcome the initial threshold, the onus then shifts to the applicant to show there is no reasonable likelihood of deception or confusion.

Test for likelihood of deception under section 12(1)

14. 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.

15. 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.”

16. 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.”

17. 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.

18. 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.

19. 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”.

20. 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.

21. 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."

22. 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*.

23. 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).

24. 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.

25. 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”.

26. 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).

27. 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?”

28. 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.

29. To paraphrase the test in the context of the present case, the question is “can it be said the opponent’s long and extensive reputation in Hong Kong for legal

services has “spilled-over” to the extent that a substantial number of purchasers of the specified services which are mainly insurance consultancy and financial services, on seeing the suit marks applied thereto, would be caused to wonder that the services were those of the opponent?” Before that could happen however there must be a sufficient similarity between the suit marks and the opponent’s mark such that potential purchasers, upon seeing the suit marks on the specified services would call to mind the opponent’s mark. I bear in mind that it is for the applicant to establish that there is no reasonable likelihood of that connection being made.

Comparison of the marks

30. I therefore move on to consider the resemblance between the respective marks. Under the Smith Hayden test, the comparison under section 12(1) should be between the suit marks “Paul Hastings Janofsky & Walker” in normal and fair use and the opponent’s mark “Hastings” in actual use .

31. 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.

32. 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).

33. 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.

34. 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.

35. 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. I therefore conclude that there is no sufficient similarity between the suit marks and the opponent’s mark such that potential purchasers upon seeing the suit marks on the specified services would call to mind the opponent’s mark.

36. It was Mr Xavier’s contention that the specified services are allied and/or natural extension of the legal services provided by the opponent and most if not all other law firms in Hong Kong or elsewhere.

37. In my judgment, notwithstanding the opponent’s submissions, the opponent has not adduced evidence to show that owners of trade marks in the legal field tend to use those marks for the specified services which are mainly insurance consultancy and financial services as well. There is also no evidence of what the ordinary purchasers of legal services in Hong Kong with a passing similarity of the opponent’s mark might think if they encounter the suit marks on the specified services. In the absence of such evidence, I must substitute myself as one who might be a potential purchaser of the specified services (*GE Trade Marks* [1973] RPC 297 at 321-322). I put to myself, being one with the familiarity of the opponent’s mark in relation to legal services, the question : would I, upon seeing the suit marks on the specified services, conjure up an association with the opponent’s legal services company such that I may be caused to wonder they came from the same source? Clearly, the answer to me is “no”. I think it is not usual for the providers of legal services to diversify into the business of the specified services which are mainly insurance consultancy and financial services. The trade channels and target consumers of the specified services and the opponent’s legal services are not the same. I do not think that the specified services are services that would be seen by purchasers as having the same trade origin as the opponent’s services even if they are sold under confusingly similar marks, not to mention dissimilar marks.

38. Given the differences between the suit marks and the opponent’s mark

and the fact that there is no spill-over of the opponent's reputation from the legal services field to the specified services industry, I have come to the view that there will be no reasonable likelihood of confusion and deception if the suit marks are to proceed to registration. I therefore find that the applicant has discharged its onus and that the opposition in respect of the limb of "likely to deceive" under section 12(1) of the Ordinance fails.

Under section 13(1) - proprietorship

39. 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.

40. 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.

41. 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 at 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."

42. 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(1) – intention to use

43. Under section 13(1) of the Ordinance, the applicant for registration of the trade mark has to be a person claiming to be entitled to be registered as the proprietor of the trade mark used or proposed to be used by him. Mr Xavier briefly contended that the likelihood of the applicant actually using the suit marks for the services in question is extremely slim and it is open to the Registrar to infer that the applicant probably had no intention to use the suit marks for the services in question despite their application.

44. In *Aston v. Harlee Manufacturing Co.* (1960) 103 CLR 391 at 401 Fullagar J. said :

“The making of the application itself is, I think, to be regarded as prima facie evidence of intention to use. I cannot think that the Registrar is called upon to institute an inquiry as to the intention of any applicant, and I think that, on an opposition or on a motion to expunge, the burden must rest on the opponent or the person aggrieved, of proving the absence of intention.”

45. The opponent has not provided me with any basis from which I can infer that the applicant probably has no intention to use the suit marks for the specified services. I am bound to draw the conclusion that the opponent has not discharged its burden of proving the absence of intention to use under section 13(1) of the Ordinance.

Under Section 13(2)

46. 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.

47. I remind myself that the register has been created by the Ordinance for

the purpose of enabling marks to be entered therein. As no proper reasons are given by the opponent to convince me 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

48. 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.

49. 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