Application No. 200218013

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

AND

IN THE MATTER of an application for registration of the trade mark

in Part A of the Register in Class 25 by Li Kam Lin trading as Tin Gut Company

AND

IN THE MATTER of an opposition by Wolsey Limited

DECISION
OF

Miss Lavinia Chang acting for the Registrar of Trade Marks on the notice of opposition and evidence in support filed by Messrs Wenping & Co. on behalf of Wolsey Limited, the opponent, and the counter-statement filed by China.hk Intellectual Property Services Co., Ltd. on behalf of Li Kam Lin trading as Tin Gut Company, the applicant.

1. These proceedings arise out of an application made on 19 November 2002 (the “application date”) by Li Kam Lin trading as Tin Gut Company, to register the following mark, pursuant to the provisions of the Trade Marks Ordinance Cap 43 in Part A of the register:

(the “suit mark”). The application is made in respect of 男女裝衣服 [clothing for men and women] in Class 25 (the “specified goods”). The suit mark was accepted for registration in Part A of the register and advertised for opposition purposes on 20 June 2003 in the Hong Kong Special Administrative Region Government Gazette.

2. On 17 September 2003 a notice of opposition was filed by Wolsey Limited (the “opponent”), a company organized and existing under the laws of the United Kingdom, having its principal place of business at Abbey Meadows, Leicester LE4 5AD, United Kingdom.

3. The opponent pleads that it is the proprietor of two trade marks registered in Hong Kong, namely, Trade Mark No. 19852084

registered in respect of “knitted articles of clothing and articles of clothing made from knitted materials” in Class 25 (the “Fox Device mark”), and Trade Mark Registration No. 19310228

WOLSEY

registered in respect of “articles of clothing” in Class 25 (collectively the “opponent’s marks”). The opponent pleads it is one of the oldest textile companies in Europe and has continuously manufactured and sold a wide range of garments and items of clothing such as socks, underwear and outerwear for over 250 years. It has been using the Fox Device and WOLSEY marks for many years either together or separately on goods, labels, packaging, advertising materials, promotional publications and other items, and enjoys substantial goodwill and reputation in connection with these marks.

4. The opponent asserts that the suit mark is “visually, phonetically and conceptually” similar to its Fox Device and WOLSEY marks, that the specified goods are identical or similar to those covered by the opponent’s marks, and that they are sold or proposed to be sold to the same customers or group of customers via the same or similar trade channels. The opponent claims the suit mark has been adopted in bad faith to deliberately import a reference to the opponent’s marks.

5. The opponent pleads that registration of the suit mark should be refused pursuant to sections 9, 10, 12, 20 and in the exercise of the Registrar’s discretion under section 13(2) of the Ordinance. It seeks an award of costs.

6. The applicant filed a counter-statement on 15 December 2003. In it the applicant asserts the suit mark is distinctive and distinguishable from the opponent’s mark. The applicant states that WOLSEY is a foreign surname pronounced “WOL-SEY”, whereas the suit mark is pronounced “WU-LEY-S” with a close resemblance to the Chinese characters 狐狸 (pronounced WU-LEI in the Cantonese dialect) meaning “fox” in English. It asserts that the respective fox devices are distinguishable: the fox device takes up only a small part of the suit mark while the word “Wuleys” occupies the most prominent position of the suit mark. It avers that animal devices such as foxes, dogs and wolves are commonly used in the clothing industry. It avers the trade and customers are accustomed to distinguishing different composite marks incorporating animal devices by paying more attention to the word element(s) of the marks.

7. Further, the applicant contends that the opponent does not, by having registered Trade Mark No. 19852084, acquire any right to prevent other traders from using other fox devices as trade marks. The applicant seeks registration of the suit mark and costs against the opponent.

Evidence

8. The opponent has filed evidence by way of a statutory declaration of Mr Jonathan Mitchell, Managing Director of the opponent. He says the opponent was formed in Leicester, England in 1755. It has had a long history in the United Kingdom. The opponent adopted and registered the mark "WOLSEY" in Britain on 2 May 1928. The opponent's marks **WOLSEY** have been registered worldwide including Hong Kong and the Mainland.

9. The opponent has appointed Beijing Yehongda Trading Company Limited ("Beijing Yehongda") as licensee for use of the opponent's marks in the Mainland, Hong Kong and Macau. Beijing Yehongda has appointed C & Y Group Limited as its Hong Kong representative for the use of the opponent's marks (Exhibit E). Mr Mitchell says there has been extensive use of the opponent's marks in respect of clothing in Hong Kong and in the Mainland.

10. Mr Mitchell provides the opponent's worldwide annual advertising expenditures and worldwide annual sales, including breakdown of annual sales figures for the Mainland market by city. Sales recorded in the selected Mainland cities are substantial. Mr Mitchell says by reason of long and extensive use of the opponent's marks worldwide particularly in the Mainland and nearby Asian countries, the opponent's marks have acquired substantial reputation and are known to a substantial number of people living in Hong Kong, by reason of frequent business and tourist traffic between the Mainland, South-East Asia and Hong Kong (Exhibit H).

11. Mr Mitchell says that prior to filing this application, the applicant had on 6 June 2002 applied to register "Wolsey Silk & Fox Device" (Application No. 200208390) in Class 25 in Hong Kong. This mark is a copy of the opponent's marks, "WOLSEY" (No. 19310229) and "Fox Device" (No. 19852084). In addition, shortly after the present application was made the applicant filed another mark "Wulseys & Fox Device" in respect of "clothing for men and women" in Class 25 under Application No. 200218480. Mr Mitchell says the fox device of that mark is a copy of the opponent's "Fox Device" (No. 19852084) and the word "Wulseys" is a modified form of the opponent's "WOLSEY" (No. 19310229) (Exhibit I). These two applications were subsequently withdrawn. Based on the pattern and history of the applicant's trade mark applications Mr Mitchell observes that the applicant has made use of every opportunity to free ride on the reputation of the opponent's marks.

12. No evidence has been filed in support of the application.

Decision

13. By letters dated 6 February 2006 and 10 May 2006 respectively, the agents acting for the opponent and applicant indicated their wish that these proceedings be decided on the pleadings and evidence already filed. In the circumstances, no oral hearing was necessary.

14. Although this matter falls to be decided after the commencement on 4 April 2003 of the Trade Marks Ordinance, Cap 559, by virtue of section 10(2) of Schedule 5 of Cap 559, oppositions still pending as of 4 April 2003 remain to be dealt with under the provisions of the repealed Trade Marks Ordinance, Cap 43.

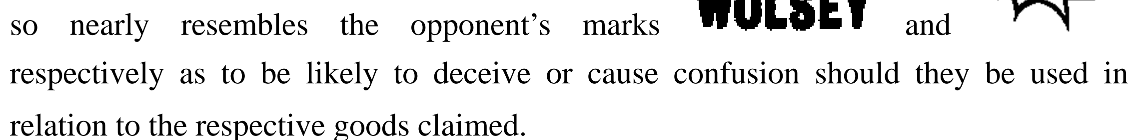
Opposition under section 20(1) of the Ordinance

15. It will be convenient to first deal with the opposition under section 20(1). In so far as it relates to goods, section 20(1) provides as follows:

> "Except as provided by section 22, no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of –
>
> (a) the same goods;
> (b) the same description of goods; or
> (c) …"

16. The suit mark is not identical to the opponent's marks. References to a near resemblance of marks in the Ordinance, according to section 2(4) mean a resemblance "so near as to be likely to deceive or cause confusion."

17. Thus, two questions arise for determination under section 20(1), firstly, whether the goods of the opponent's registration, and the goods in this application are the same or of the same description; and secondly whether the suit mark

so nearly resembles the opponent's marks 

and respectively as to be likely to deceive or cause confusion should they be used in relation to the respective goods claimed.

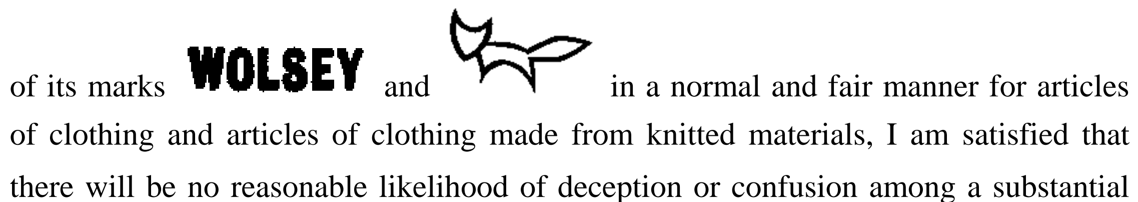
18. The applicant's specified goods consist of clothing for men and women. The opponent's goods are articles of clothing (for WOLSEY) and knitted articles of clothing and articles of clothing made from knitted materials (for the Fox Device). There is considerable overlap between the parties' goods, and there is little doubt that they are goods of the same description, if not the same goods.

19. The opponent's marks are respectively the word mark WOLSEY, and a device mark consisting of the simple outline drawing of a fox. The suit mark is a composite mark, set against a dark background, comprising the word "Wuleys" presented in the upper half of the mark in a faint rectangular border slightly off centre of the mark, and the picture of a fox in outline in grey beneath it. The word "Wuleys" appears to be an invented word. In her counter-statement the applicant explains the word resembles the Chinese characters 狐狸 (pronounced WU-LEI in the Cantonese dialect, meaning a "fox" in English) and the device is the silhouette of a fox.

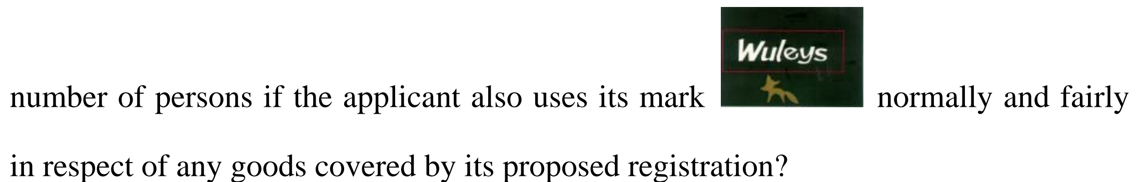
20. The parties' respective device components are both simple drawings in outline or silhouette but both are clearly foxes. The word "Wuleys" is one letter different from "WOLSEY" and the letter "S" displaced. The letters which are different, i.e. "O" and "U," are liable to be confused with one another especially in cursive form or if presented in small print. To persons already aware of the WOLSEY mark, "Wuleys" would appear to be visually similar to WOLSEY.

21. The suit mark is set against a dark background. There is a faint rectangular line that frames the word "Wuleys." There are some differences between the parties' device components e.g. whether the nose and tail of the fox point upwards or downwards. The opponent's mark WOLSEY is in plain block capitals whereas the applicant's word component is in italics and consists of letters in both upper and lower cases.

22. The question I have to determine is whether, assuming user by the opponent



of its marks WOLSEY and [fox device] in a normal and fair manner for articles of clothing and articles of clothing made from knitted materials, I am satisfied that there will be no reasonable likelihood of deception or confusion among a substantial



number of persons if the applicant also uses its mark normally and fairly in respect of any goods covered by its proposed registration?

23. The comparison does not require me to engage in a side-by-side examination for differences, instead I have to compare the marks sequentially, allowing for imperfect recollection. The test is whether there would be a probability of confusion if a person who only generally recollects what the nature of the opponent's mark was, sees the suit mark in the absence of the opponent's mark. The onus is on the applicant to show on a balance of probabilities, that there is no reasonable likelihood of deception or confusion among a substantial number of persons if the suit mark is also used and registered in respect of any goods in its specification.

24. The purchasers to be considered are those likely to purchase the product in question. The applicant has filed no evidence whatsoever. The opponent's evidence shows that its marks are used in relation to a wide range of clothing including woollens, casual wear, golf wear for men and women, and underwear and socks for men. The applicant's specification reads 男女裝衣服 [clothing for men and women]. On the premise that the respective parties' goods are common consumer products, I postulate the ultimate purchasers of both parties' goods to be members of the general public in Hong Kong.

25. The opponent's fox device is in my view highly distinctive. It is a far cry from device marks so non-descript or so abstract as to be incapable of mental classification (see *audio pro and device*, unreported decision of Acting Registrar K S

Kripas on behalf of the Registrar of Trade Marks dated 6 March 2003, at paragraph 50). Their overall presentation is remarkably similar despite minor points of differences (i.e. the tail of one tilts upwards whilst the other points downwards, and the nose of one points outwards and the other points downwards). The impressions conveyed are also remarkably similar. In my view both will be recalled as fox devices. Persons who sees the suit mark in the absence of the opponent's mark, having only a general recollection of the latter would be liable to think they are the same mark or that they are related to each other.

26. In addition, the word component "Wuleys" is likely to be confused with the opponent's WOLSEY. As fair notional use of a mark registered in plain capital letters covers the same mark presented in lower case and vice versa, the use of different cases is immaterial for the purpose of a section 20(1) opposition. Instead attention should focus on the look, sound and concept of the marks themselves. To persons whose mother tongue is not English (as is the case with the majority of the Hong Kong population), the word WOLSEY carries no obvious meaning and is not readily recognisable as a surname. There is no suggestion in either parties' pleadings or the opponent's evidence (the applicant has filed none) that the parties' goods are aimed at different sectors of the purchasing public, such that one might be more discerning than another when it comes to identifying particular trade marks. The marks are therefore likely to be remembered by general impression than by literal meaning. To persons with only a general impression of "WOLSEY," there is a tangible risk that the word "Wuleys" may be confused with "WOLSEY." They are visually similar as both words start with the same letter of the alphabet and have the same number of letters of the alphabet. They are also to some degree phonetically similar.

27. Since the applicant has filed no evidence in this matter, no issue of honest use concurrent with the opponent's registrations arises under section 22 of the Ordinance. In any case I am mindful of the principle that, the onus being on the applicant, in a doubtful case the public interest requires the application to be refused (*Dunn's Trade Mark* (1908) 7 RPC 311 at 315-316). Accordingly, the opposition under section 20(1) of the Ordinance is successful, and I must refuse the application.

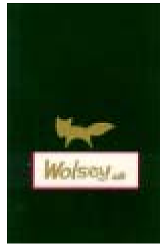
28. The opponent having succeeded under section 20(1), it is unnecessary to deal with the opposition under the remaining grounds. Suffice it to say that I would also have found for the opponent for the same reasons on a comparison of the marks under section 12(1), based on the opponent's evidence of use of its marks on the relevant goods. This takes various forms, including

and

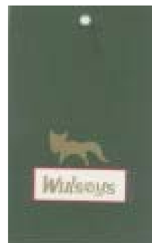
29. The opponent's case is even stronger under section 12(1) due to the identity of the typeface of the suit mark and the opponent's marks above, as the comparison to be made is between the opponent's marks as used on the one hand, and the suit mark in notional fair use. The risk of confusion is highest between the suit mark and the second of the opponent's marks above, as both are word-and-device composite marks.

30. Should I be wrong in these conclusions, for the reasons that follow I would have exercised my discretion under section 13(2) of the Ordinance and refused registration of the suit mark.

31. The opponent has put in evidence the two trade mark applications which the present applicant made but subsequently withdrew, namely Application No. 200208390



and Application No. 200218480



32. These marks bear an even closer resemblance than the suit mark to the opponent’s marks as not just the fox device but also the typeface of the word components are very similar, heightening the risk of confusion. Mr Mitchell, the opponent’s deponent, has in his statutory declaration suggested these marks are copies of the opponent’s marks (at paragraph 8), and the applicant has not seen fit to either refute, reply, or to explain how she came upon the suit mark, if not the two withdrawn marks. The applicant is not strictly required to file evidence in reply, but it is a little surprising that she chose to remain silent in the face of adverse evidence suggestive of systematic copying of the opponent’s marks. In the circumstances, the possibility of copying cannot entirely be discounted.

33. I do not overlook the fact that the opponent’s evidence is that its marks have been and are still in use, whereas the applicant has given no evidence of use of the suit mark, or indeed any evidence at all.

Costs

34. The opponent has sought costs. There is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that costs should follow the event. I accordingly order that the applicant pays the costs of and incidental to these proceedings.

35. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap 4) as applied to trade mark matters, unless otherwise agreed between the parties.

(Lavinia Chang)
p. Registrar of Trade Marks
20 July 2006