

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300090927

MARK:



CLASSES: 35 & 42
APPLICANT: ATA CORPORATE FORMATION & MANAGEMENT LIMITED
OPPONENT: ANTONIO PRECISE PRODUCTS MANUFACTORY LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 9 October 2003, the Applicant filed an application for registration of a trade mark (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”). Particulars of the subject application were published on 9 January 2004, and the Opponent filed a notice of opposition to the subject application on 8 April 2004.
2. The opposition hearing took place before me on 13 September 2006. Mr Chan Ka Sun and Ms Chan Bik Ling of the Applicant appeared at the hearing. The Opponent did not appear.

Grounds of opposition

3. The grounds on which the Opponent opposes registration of the Applicant’s mark are under sections 2, 3, 11, 12(2), 12(3), 12(4), 12(5), and 38 of the Ordinance.

The Applicant’s mark

4. The mark the Applicant has applied to register is:



5. The specification of services in respect of which registration is sought is as follows:

Class 35

accounting; analysis (cost price -); answering (telephone -) [for unavailable subscribers]; appraisals (business -); auditing; business information; business inquiries; business management and organization consultancy; business management assistance; business management consultancy; business organization consultancy; commercial or industrial management assistance; cost price analysis; information agencies (commercial -); publicity agencies.

Class 42

consultancy (intellectual property -); copyright management; design (industrial -); industrial design; intellectual property consultancy; intellectual property (licencing of -); intellectual property watching services; licencing of intellectual property; management (copyright -).

The Opponent's marks

6. The Opponent is the owner of the following registered trade marks:



Trade mark no. 1996/5612 in class 9, registered in respect of “sound reproduction, transmitting and recording apparatus; headphones; earphones; speaker apparatus; infra-red headphones and speaker apparatus; radio-frequency headphones and speaker apparatus; parts and fittings of the aforesaid goods; all included in Class 9”; date of application and registration 4 January 1995.



Trade mark no. 2002/3511 in class 9, registered in respect of “apparatus for recording, transmission or reproduction of sound or images; earphones, headphones, microphones, audio speakers, amplifiers, transmitters, high fidelity instruments, walkie-talkies, signal processors, mixers for making signals, tuners, television and audio-visual receivers, compact disc players, equalizers, cassette decks, video decks; electric, photographic, cinematographic and optical apparatus and instruments; parts and fittings for all the aforesaid goods; none relating to computers; all included in Class 9.”; date of application and registration 14 October 2000.

Applicant, Opponent and evidence

7. The Applicant has filed a counter-statement in response to the Opponent’s notice of opposition but has not filed evidence in the proceeding. In the counter-statement, the Applicant states that it has been in the business of corporate formation and management since 1997, but provides no further information about itself.
8. The Opponent’s evidence comprises of a statutory declaration made by Mr Poon Yun Chung, Boby on 24 February 2005 (“the Statutory Declaration”). The Opponent is a limited liability company incorporated in Hong Kong on 24 July 1987. Mr Poon states that the Opponent was incorporated to take over the business of its predecessor, Wong Wing Hong, trading as Antonio Precise Products Manufactory Company.
9. The Opponent and its predecessor have been carrying on business which includes designing (industrial), licensing of intellectual property, developing, manufacturing, wholesaling, retailing, exports, handling of business inquiries, providing of business information and conducting of cost price analysis of audio/visual products since 1982. The Opponent has used the “ATA” mark in relation to the business since 1991. The mark is coined from the first letter of the forenames of the three major directors, Antonio Wong Wing Hong, Johnny Wong Wing Yiu and Anthony Wong Wing Cheong, except that the letter “J” is replaced by the letter “T” to establish a linkage between the mark and the Opponent’s established house mark “ATO”, and to create a more harmonized visual effect.

10. At paragraphs 13 and 14 of the Statutory Declaration, the Opponent provides respectively the approximate turnover of its business referred to above under the mark “ATA” and the advertising figures for the financial years 1999 to 2003. There is, however, no breakdown of the figures to show the turnover and the advertising expenditure in Hong Kong.
11. At Appendix 4 to the Statutory Declaration, sample catalogues of the Opponent’s products are shown. One of the catalogues is for the year 1992 and the other two are for the years 2002 and 2003 respectively. The remaining catalogue is undated. The catalogues show the Opponent’s products, headphones, earphones, speakers, microphones and portable headsets for mobile phones, sold under the “ATA” and “ATO” marks. In the catalogues, the “ATA” mark either appears in plain block capitals or in the form in which it is registered as trade mark no. 2002/3511.
12. At Appendix 9 to the Statutory Declaration, the Opponent shows photographs taken from its exhibition booth at the Hong Kong Electronics Fair. One of the photos is dated 15 October 1999, and it shows the Opponent’s booth with a poster displaying the Opponent’s earphones under the “ATO” and “ATA” marks. Additionally, at Appendix 10 to the Statutory Declaration, two copy pages taken from the “asian sources” magazine are exhibited. One page is the cover of the magazine showing the date October 2000, and the other is an advertisement placed by the Opponent, showing its earphones marketed under the “ATO” mark. Sample invoices issued by advertisers concerning the advertisement of the Opponent’s products are also shown at Appendix 8 to the Statutory Declaration.
13. The Opponent states that it has registrations of the “ATA” marks in other countries including Canada, PRC, and U.S., etc. Copies of the registration certificates are enclosed in Appendix 7 to the Statutory Declaration. Appendix 11 to the Statutory Declaration includes copies of various awards and ISO certificates received by the Opponent.

Relevant date

14. The relevant date for considering the opposition is 9 October 2003, the date of the subject application for registration.
15. I shall deal with the opposition under sections 12(2) and 12(3) of the Ordinance first.

Opposition under sections 12(2) and 12(3) of the Ordinance

16. Sections 12(2) and (3) of the Ordinance provide as follows:

“(2) A trade mark shall not be registered if-

- (a) the trade mark is identical to an earlier trade mark;
- (b) the goods or services for which the application for registration is made are similar to those for which the earlier trade mark is protected; and
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.

(3) A trade mark shall not be registered if-

- (a) the trade mark is similar to an earlier trade mark;
- (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”

17. Under section 7(1) of the Ordinance, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

18. Sections 12(2) and 12(3) of the Ordinance are in similar terms to section 5(2) of the U.K. Trade Marks Act 1994, which implements Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1988 of the Council of the European Communities (“the Council Directive”). In interpreting Article 4(1)(b) of the Council Directive, the European Court of Justice (“ECJ”) has formulated the “global appreciation” test, the principles of which can be found in the ECJ decisions of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [1999] E.T.M.R. 690 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 561.

19. According to these cases:

- (i) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (ii) the matter must be judged through the eyes of the average consumer of the goods or services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 26;
- (iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (v) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (vi) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (vii) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b); *Sabel BV v Puma AG*, paragraph 26;
- (viii) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (ix) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

20. I consider that the principles laid down by the ECJ, followed by the U.K. courts and the U.K. Trade Marks Registry, are applicable to determining objections under sections 12(2) and 12(3).
21. In the present case, the Opponent's trade marks, nos. 1996/5612 and 2002/3511, both having a date of application for registration earlier than that of the Applicant's mark, are "earlier trade marks" in relation to the Applicant's mark within the definition of section 5(1)(a) of the Ordinance. According to the section, "earlier trade mark", in relation to another trade mark, means "a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any".

Section 12(2) of the Ordinance

22. I first consider the ground of opposition under section 12(2) of the Ordinance.
23. The pre-requisite to this ground, as provided under paragraph (a) of the section, is that the applied-for mark must be identical to an earlier trade mark. In the present case, the Applicant's mark consists of the letters "ATA CFM", with the letters "ATA" appearing above and to the left of the letters "CFM".
24. Both of the Opponent's trade marks, nos. 1996/5612 and 2002/3511, contain the letters "ATA". Trade mark no. 1996/5612 consists of the letters "ATA" and the words "THE PROFESSIONAL TOUCH" underneath. Trade mark no. 2002/3511 consists of the letters "ATA" and the word "TECHNOLOGY" underneath, with both the letters and the word bounded in an oval device. In both marks, the letters "ATA" are of a much larger font size when compared with the other words in the respective marks.
25. The Applicant's mark and the Opponent's trade marks, nos. 1996/5612 and 2002/3511 contain the letters "ATA", but in view of the differences between the Applicant's mark and the Opponent's marks, I do not consider them to be identical to each other. As identity in the marks is a pre-requisite to establishing an objection under section 12(2) but has not been shown here, the opposition under this section fails.

Section 12(3) of the Ordinance

26. I turn to consider section 12(3) of the Ordinance. Paragraphs (a) to (c) of the section set out the basis for an objection under the section.

27. As mentioned, the letters “ATA” appear in each of the Applicant’s mark and the Opponent’s trade marks nos. 1996/5612 and 2002/3511. It is not apparent that the letters “ATA” designate the characteristics of the services applied for in the subject application, or the goods registered in respect of trade mark nos. 1996/5612 and 2002/3511. I find the letters “ATA” to be distinctive of the goods and services, in the sense that they serve to distinguishing the goods and services from those of other undertakings.
28. The letters “ATA” are the prominent and distinctive elements of both the Applicant’s mark and trade mark nos. 1996/5612 and 2002/3511. Adopting the guidance formulated by the ECJ in the global appreciation test, I am of the view that the Applicant’s mark is similar to trade mark nos. 1996/5612 and 2002/3511. The first pre-requisite under section 12(3)(a) of the Ordinance is therefore satisfied.
29. I turn to consider the similarity in the goods and services under paragraph (b) of the section. As the paragraph makes it clear, the relevant comparison is to be made between the services applied for in the subject application and the goods for which trade marks nos. 1996/5612 and 2002/3511 are protected.
30. The Applicant submits that the applied-for services under the subject application are different from the goods registered in respect of trade marks nos. 1996/5612 and 2002/3511.
31. Guidance on the approach to be adopted in comparing goods and services is given in *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281, in which Mr Justice Jacob considered, at page 296, the following factors to be relevant in determining whether or not there is similarity:
 - (i) The respective uses of the respective goods or services;
 - (ii) The respective users of the respective goods or services;
 - (iii) The physical nature of the goods or acts of service;
 - (iv) The respective trade channels through which the goods or services reach the market;
 - (v) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and

- (vi) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.
32. Similar factors are also referred to in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, at paragraph 23:
- “In assessing the similarity of the goods or services concerned,... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary”.
33. I have set out the services sought to be registered in respect of the Applicant’s mark at paragraph 5 above. The services are classified in classes 35 and 42 of the 8th Edition of the International Classification of Goods and Services under the Nice Agreement (“the Nice Classification”). They include accounting, auditing, business information, business management, consultancy and cost price analysis services (class 35), and consultancy, management and licensing services relating to intellectual property (class 42), etc.
34. It is established that in interpreting the specification, the terms are to be given their ordinary and natural meaning (see for example *Ofrex v Rapesco* [1963] R.P.C. 169). It has also been held that the Registrar is entitled to treat class numbers as relevant to the interpretation of the scope of goods and services (*Reliance Water Controls Ltd v. Altecnic Ltd* [2002] R.P.C. 34).
35. The 8th Edition of the Nice Classification contains the following explanatory notes in relation to classes 35 and 42 services:
- “Class 35 includes mainly services rendered by persons or organizations principally with the object of:
- (1) help in the working or management of a commercial undertaking,
or
 - (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise...”

“Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields

of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer specialists, lawyers, etc.”

36. On a natural reading of the specification of the applied-for services, and taking into account the above explanatory notes in the 8th Edition of the Nice Classification, I consider that the class 35 services applied for in the subject application are mainly services in accounting, auditing and cost analysis, as well as providing business information and managing business affairs. For the services applied for in class 42, they are mainly consultancy, management and licensing services in the field of intellectual property.
37. As regards the goods registered in respect of trade marks nos. 1996/5612 and 2002/3511, they are mainly audio and visual products.
38. Following the guidance in *British Sugar* and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, I do not find the services applied for in the subject application to be similar to the goods registered in respect of trade marks nos. 1996/5612 and 2002/3511. The applied-for services in the subject application are for accounting, auditing and cost analysis, as well as providing business information and managing business affairs (class 35), and providing consultancy, management and licensing services in the field of intellectual property (class 42), etc. By contrast, audio/visual products are for hearing sound and viewing images. The nature and purpose of the goods and services are completely different.
39. Users of the applied-for services under the subject application are persons or businesses who need accounting, auditing, business management and consultancy services, etc, whereas users of audio/visual products are members of the general public who would like to hear music and to watch movies or TV, etc. The applied-for accounting, auditing and business management and consultancy services, etc are provided in a business context unrelated to the purchase of audio/visual products by the general public at retail outlets for audio/visual products or electrical appliances. The distribution channels are not the same nor do I find the respective services and goods to be competitive or complementary. The goods and services are also unlikely to be provided by the same undertaking.
40. Similarity in the goods and services is one of the pre-requisites that must be proved for establishing an objection under section 12(3). In this respect, I would refer to *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, in which the ECJ held, at paragraph 22, that:

“It is, however, important to stress that, for the purpose of applying Article

4(1)(b) [similar to sections 12(2) and (3) of the Ordinance], even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(b) [similar to section 12(4) of the Ordinance], which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services are identical or similar.”

41. This line has been followed by the U.K. Court in *Sihra's Trade Mark Application* [2003] R.P.C. 44, in which Mr Justice Patten, in interpreting section 5(2) of the U.K. Trade Marks Act 1994, states that the flexibility inherent in the global appreciation test leaves intact the threshold requirement for a recognisable degree of similarity between the goods and services in question.
42. For the reasons given, I do not consider that the threshold as to similarity in the goods and services under subsection (b) of section 12(3) has been passed. However, if I was wrong on the above, I go on to deal with subsection (c).
43. Confusion in the context of section 12(3) of the Ordinance refers to confusion as to trade origin of the goods and services in question.
44. Under the global appreciation test, there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it.
45. The Opponent has supplied catalogues of its audio/visual products sold under the “ATA” marks (in plain block capitals or in the form of trade mark no. 2002/3511), together with photos showing the exhibition of the Opponent’s earphones, under the “ATA” mark (in plain block capitals) in the Hong Kong Electronic Fair in 1999. However, there is no breakdown of the business turnover and advertising figures to show the extent of the sales and promotion of the Opponent’s audio/visual products in Hong Kong. Nor have invoices for sales of the Opponent’s products been provided. In the invoices for the advertisement of the Opponent’s products shown at Appendix 8 to the Statutory Declaration, the Opponent’s advertisement at the “asian sources” magazine at Appendix 10, together with copy awards and ISO certificates awarded to the Opponent at Appendix 11, the Opponent’s “ATA” marks do not appear. I therefore have difficulty in assessing the extent of the Opponent’s goodwill and reputation in its “ATA” marks in Hong Kong. From the evidence filed, I cannot be satisfied that the Opponent’s trade marks, nos. 1996/5612 and 2002/3511 have acquired enhanced distinctiveness.

46. I have taken into account the similarity between the Applicant's mark and trade nos. 1996/5612 and 2002/3511. However, as earlier explained, the applied-for services in the subject application are completely different from the goods registered in respect of the Opponent's trade marks, nos. 1996/5612 and 2002/3511. Having applied all the relevant principles in the global appreciation test, I consider customers are unlikely to be confused into believing that the services provided under the Applicant's mark and the goods sold under trade mark nos. 1996/5612 and 2002/3511 come from the same undertaking or economically-linked undertakings. Accordingly, the requirement under paragraph (c) of the Ordinance is not satisfied.
47. As the pre-requisites to an objection under section 12(3) of the Ordinance have not been shown, the Opponent's opposition under the section fails.

Opposition under section 12(5) of the Ordinance

48. The Opponent opposes under section 12(5) of the Ordinance on the ground that use of the Applicant's mark is liable to be prevented by virtue of the law of passing-off.
49. A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of Hong Kong Vol 15(2)* at paragraph 225.001. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C. 341 and *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

“The House of Lords has restated the necessary elements which a plaintiff has to establish in an action for passing off:

- (1) the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) the plaintiff has suffered or is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation.”

Reputation

50. As explained at paragraph 45 above, I have difficulty in assessing the extent of the Opponent's goodwill and reputation in its "ATA" marks in Hong Kong. From the evidence filed, I am not satisfied that the Opponent has established a goodwill or reputation in relation to its "ATA" marks in Hong Kong before the relevant date.

Misrepresentation

51. To establish misrepresentation, the Opponent has to show that the relevant public will believe that the applied-for services provided under the Applicant's mark are the services of the Opponent.
52. The Opponent has supplied catalogues of its audio/visual products sold under the "ATA" marks (in plain block capitals or in the form of trade mark no. 2002/3511), together with photos showing the exhibition of its earphones, under the "ATA" mark (in plain block capitals), in the Hong Kong Electronic Fair in 1999. For the reasons I have given in respect of the similarity in the Applicant's mark and the Opponent's trade marks nos. 1996/5612 and 2002/3511 above, I find there is similarity between the Applicant's mark and the Opponent's "ATA" marks, which the Opponent has used.
53. The Opponent states in its evidence that it and its predecessor have been carrying on a business which includes designing (industrial), licensing of intellectual property, developing, manufacturing, wholesaling, retailing, exports, handling of business inquiries, providing of business information and conducting of cost price analysis of audio/visual products. However, from the evidence provided, I am only able to find that the Opponent has been engaged in the manufacturing and sales of audio/visual products.
54. Further, even if the Opponent may, in the course of manufacturing and selling audio/visual products, license its intellectual property rights, handle business inquiries, and provide business information on its own products, these acts do not make the Opponent's business an intellectual property consultancy, or a provider of business information or management services. The Opponent's reputation is in the business of manufacturing and sale of audio/visual products. The nature of the Opponent's business is different from the applied-for services, which relate to accounting, auditing and cost analysis, providing business information and managing business affairs (class 35), and providing

consultancy, management and licensing services in the field of intellectual property (class 42), etc.

55. Whilst it is well-established under the law of passing off that there is no requirement for common field of activity (*Lego System A/S v Lego Lemelstrich Ltd* [1983] F.S.R. 155), in deciding whether there is likelihood of confusion, it is an important and highly relevant consideration “whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant (*Harrods Ltd v Harrodian School Ltd* [1996] R.P.C. 697 at 714). In the present case, the nature of the services applied for in the subject application is entirely different from that of the business in relation to which the Opponent has used the “ATA” marks. In view of this significant difference, I do not consider that the public would be likely to believe that the applied-for services provided under the Applicant’s mark are those of the Opponent’s.

Damage

56. As the evidence has not shown the Opponent’s goodwill or reputation and I am unable to find any misrepresentation, I do not consider that the Opponent is likely to suffer any damage as a result of the use of the Applicant’s mark.
57. In conclusion, I do not consider that the Opponent has discharged the onus of showing the necessary elements required to be established in an action in passing off. The opposition under section 12(5) of the Ordinance therefore fails.

Opposition under section 12(4) of the Ordinance

58. Section 12(4) of the Ordinance provides that a trade mark which is-
- (a) identical or similar to an earlier trade mark; and
 - (b) proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

59. Subsections (a) and (b) of section 12(4) are satisfied because in the earlier part of this decision, I have found that there is similarity between the Opponent's "ATA" marks and the Applicant's mark, and that there is no similarity in the services applied for in the subject application with the goods for which the Opponent's marks are protected.
60. I turn to consider whether the Opponent's "ATA" marks constitute well-known trade marks protected under the Paris Convention. Pursuant to sections 4(1) and 5(1)(b) of the Ordinance, the question for me is whether the Opponent's marks are well known in Hong Kong before the relevant date.
61. Factors relevant for determining whether a trade mark is well known in Hong Kong are set out in Section 1(2) of Schedule 2 to the Ordinance. These factors serve as guidelines to assist the Registrar of Trade Marks or the court to determine the question. They include the degree of knowledge or recognition of the trade mark in the relevant sectors of the public, and the duration, extent and geographical area of any use and promotion of the trade mark, etc. Section 1(5) of Schedule 2 further provides that where a trade mark is determined to be well known in at least one relevant sector of the public in Hong Kong set out in section 1(4), it shall be considered to be well known in Hong Kong. Section 2 of Schedule 2 sets out the factors which are not necessary to be established.
62. As mentioned, in the Statutory Declaration filed by the Opponent, there is no breakdown of the turnover and advertising figures to show the extent of the sales and promotion of the Opponent's products in Hong Kong. I therefore have difficulty in assessing the degree of knowledge or recognition of the Opponent's "ATA" marks amongst the relevant sectors of the public in Hong Kong. Nor am I able to assess the duration, extent and geographical area of the use and promotion of the "ATA" marks in Hong Kong. The Opponent has provided its catalogues, as well as photos showing exhibition of its products under the "ATA" mark (in plain block capitals) in a Hong Kong trade fair. It has also shown copy registration certificates of the overseas registrations of its "ATA" marks. However, I consider that this evidence falls far short of showing that the Opponent's "ATA" marks are well known amongst the relevant sectors of the public in Hong Kong.
63. As also discussed, in the invoices for advertisement of the Opponent's products at Appendix 8 to the Statutory Declaration, the Opponent's advertisement at the "asian sources" magazine at Appendix 10, together with copy awards and ISO certificates awarded to the Opponent at Appendix 11, the Opponent's "ATA" marks do not appear. They are not therefore relevant in showing that the

Opponent's "ATA" marks are known to the relevant sectors of the Hong Kong public, let alone well known by them. I am aware of no other evidence in the Statutory Declaration which can show that the Opponent's marks are well known in Hong Kong. I do not accordingly consider the Opponent has substantiated that its "ATA" marks are "well-known trade marks" within the meaning of section 4(1) of the Ordinance.

64. Further, I am unable to see how the Opponent's "ATA" marks will be damaged as a result of the use of the Applicant's mark. To succeed under section 12(4), the Opponent must specifically address the question how the use of the Applicant's mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Opponent's marks. In the absence of evidence and submissions in this respect, I do not consider that the Opponent has substantiated an opposition under section 12(4).

Opposition under sections 2, 3 and 11 of the Ordinance

65. The Opponent opposes the Applicant's mark under section 11 of the Ordinance, contending that the mark is devoid of any distinctive character, and that there has been no use of the mark by the Applicant so as to acquire a distinctive character.
66. The Opponent also opposes the Applicant's mark under sections 2 and 3 of the Ordinance, alleging that the mark is not capable of indicating a connection in the course of trade between the Applicant and the services applied for and that the Applicant does not have right to use the mark in Hong Kong.
67. The Opponent has not however provided any reason to substantiate the opposition based on these provisions. As mentioned in paragraph 27 above, I am not aware that the letters "ATA" designate the characteristics of the services applied for in the subject application, and I find that the Applicant's Mark is distinctive in the sense that it serves to distinguish the applied-for services from those of other undertakings. I have not been provided with any reasons to the contrary. As a result, the opposition under these sections also fails.

Opposition under section 38 of the Ordinance

68. The Opponent also opposes the Applicant's mark under section 38 of the Ordinance on the basis that the Applicant is not entitled to be registered as the proprietor of the mark. I am not aware of any reasons as to why the Applicant is not entitled to be registered as the owner of the Applicant's mark.

69. Section 38 of the Ordinance sets out the manner in which an application for registration has to be filed, and the particulars and fees, etc that must be included in a trade mark application. As I am unable to find any deficiencies in the subject application which fall short of the requirements provided under section 38 of the Ordinance, the opposition under this section fails as well.

Discretion

70. The Opponent has pleaded, without drawing reference to any particular section of the Ordinance, that the Registrar should exercise his discretionary power to refuse the subject application for reason that registration of the Applicant's mark would unfairly prejudice the rights of the Opponent.
71. Under section 42 of the Ordinance, the Registrar must conduct an examination of all applications to ensure that they comply with the provisions of the Ordinance. If an application meets the requirements of registration, the Registrar has no power to refuse the application.
72. As I have come to the view that the subject application meets the requirements of the Ordinance, and I have found the opposition fails in all of the pleaded grounds of opposition, there is no basis on which I may refuse the application.

Conclusion

73. As the opposition fails, I award the Applicant costs. 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 High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

Simon Chan
for Registrar of Trade Marks
20 October 2006