

TRADE MARKS ORDINANCE (CAP. 559)

**APPLICATION FOR DECLARATION OF INVALIDITY OF TRADE MARK
REGISTRATION NO. 300102905**

MARK :



CLASS :

25

APPLICANT :

ALFRED DUNHILL LIMITED

REGISTERED OWNER :

**FRENCH DUNHILL CLOTHING & ACCESSORIES
LIMITED**

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 June 2005, Alfred Dunhill Limited (“Applicant”) applied to the Registrar of Trade Marks under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for a declaration of invalidity (“Application”) of the registration of the following mark (“subject mark”):



(Trade Mark No. 300102905)

2. The subject mark is registered in the name of French Dunhill Clothing & Accessories Limited (“Registered Owner”) in respect of “clothing, shoes, hats” in Class 25 (“subject goods”). The application for registration of the subject mark was made on 30 October 2003, and the subject mark is registered as of that date.

3. The Registered Owner filed a Counter-Statement on 14 September 2005 (“Counter-Statement”) in response to the Application.
4. The Applicant filed evidence by way of a statutory declaration of Anne Marie Turner declared on 12 September 2006 (“Turner Declaration”). The Registered Owner did not file any evidence.
5. A hearing of the Application was set to take place before me on 13 February 2009. The Applicant has, however, indicated in writing that it would not attend the hearing, and has filed written submissions dated 9 February 2009 (“Written Submissions”). The Registered Owner having failed to file any Form T12 is treated as not intending to appear at the hearing under Rule 74 of the Trade Marks Rules Cap. 559 sub. leg. (“TM Rules”). I therefore proceed to decide the matter without a hearing pursuant to Rule 75 of the TM Rules.

Grounds for the Application

6. Although a number of grounds were pleaded, the Applicant only relied on the grounds under the following sections of the Ordinance in its Written Submissions:
 - (i) section 12(3);
 - (ii) section 12(5)(a); and
 - (iii) section 11(5)(b).

Application under sections 53(5)(a) and 12(3) of the Ordinance

7. Section 53(5)(a) of the Ordinance provides, *inter alia*, as follows:

“...the registration of a trade mark may also be declared invalid on the ground-

- (a) *that there is an earlier trade mark in relation to which the conditions set out in section 12(1), (2) or (3) (relative grounds for refusal of registration) apply;*”.

8. Section 12(3) of the Ordinance provides that:

“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.”*

9. According to 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.

10. Section 12(3) of the Ordinance essentially prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of its being similar to an earlier trade mark and because it is to be registered in respect of goods or services the same as or similar to those the subject of the earlier trade mark. A trade mark which has been registered in contravention to section 12(3) of the Ordinance may be declared invalid under section 53(5)(a) of the Ordinance.

11. For this ground under section 12(3) of the Ordinance, the Applicant relies on the following mark (“Applicant’s Mark”):



(Trade Mark No. 19913358) registered as of 26 May 1990 in respect of “clothing, footwear, headgear” in Class 25 (“Applicant’s Goods”).

12. The Applicant’s Mark has a date of application for registration which is earlier than that of the subject mark. According to section 5(1)(a) of the Ordinance, the Applicant’s Mark is an earlier trade mark in relation to the subject mark.

13. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994 which implements Article 4(1)(b) of the EC Directive 89/104 of December 21, 1988. In determining the issue under section 12(3)

of the Ordinance, I take into account the guidance provided by the Court of Justice of the European Communities (ECJ) in *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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

Comparison of goods

14. The subject goods overlap with the Applicant's Goods. In other words, the goods for which the subject mark is registered are identical to some of the goods for which the Applicant's Mark is protected.

Distinctiveness of the Applicant's Mark

15. The Applicant's Mark as set out in paragraph 11 above consists of the word "dunhill", which is a rare surname in Hong Kong. The word has no meaning in relation to the Applicant's Goods and is inherently distinctive of those goods. The "stems" in the letters "d", "h" and the two letters "l" in the mark are particularly elongated. The four elongated "stems" strike the eye and contribute to the overall distinctiveness of the Applicant's Mark. I find that the Applicant's Mark has high inherent distinctive character.
16. According to paragraph 17 of the Turner Declaration, the Applicant has been using the Applicant's Mark on, *inter alia*, clothing products for at least ten years in Hong Kong before the Turner Declaration was made in September 2006. Exhibit "AMT-7" includes invoices bearing the Applicant's Mark in relation to sales of clothing products to retailers in Hong Kong from 1999 to 2003. The earliest brochure of the Applicant's menswear products appearing at Exhibit "AMT-12" to the Turner Declaration indicates that at the time of the brochure in 1992, the Applicant had retail shops at the Pacific Place, the Prince's Building, the Hyatt Regency Hotel and the Peninsula Hotel. Exhibits "AMT-8" and "AMT-9" include advertisements of the Applicant's menswear products between 1995 to 1999. Newspapers and publications in which advertisements of such products have appeared include the South



China Morning Post, Ming Pao, Hong Kong Economic Times, Asia Wall Street Journal, Hong Kong Economic Journal and Esquire.

17. According to paragraph 10 of the Turner Declaration, Exhibit “AMT-6” to the Turner Declaration is said to contain ‘sales figures in Hong Kong for the Applicant’s products bearing the trade mark “DUNHILL” from 1984 up to 31st October 2005’ (my emphasis). It is not entirely clear whether, and if so to what extent, the figures relate to use of the Applicant’s Mark, especially since the Applicant’s Mark has been referred to in other parts of the Turner Declaration as the “DUNHILL” (longtail) trade mark’, rather than just the ‘trade mark “DUNHILL”’. Moreover, it is apparent from paragraph 5 of the Turner Declaration that the Applicant’s products include fashion products, watches and clocks, leather goods, writing instruments, lighters, jewellery, fragrances and other personal grooming products. Since the sales figures at Exhibit “AMT-6” are said to relate to “the Applicant’s products”, which term is not defined, and there is no breakdown as between different products, it is not clear to what extent those figures relate to the Applicant’s Goods. Likewise, although the Applicant’s advertising and promotional expenditure from 1999 to October 2003 are set out in paragraph 12 of the Turner Declaration, there is no breakdown of these figures as between different products of the Applicant.

18. I have already found that the Applicant’s Mark has high inherent distinctive character. Taking the Applicant’s evidence as a whole, whilst the distinctiveness of the Applicant’s Mark might, to some extent, have been enhanced through use in relation to men’s clothing, I consider that the extent is not as considerable as claimed in reliance on the sales and advertising figures referred to above.

Comparison of marks

19. The global appreciation of the visual, aural or conceptual similarities of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (*Sabel BV v Puma AG*).

20. The perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer of the products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details (*Sabel BV v Puma AG*). He only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect recollection of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*).
21. The subject goods consist of clothing, shoes and hats. The average consumers for these goods include ordinary members of the public. The price for these goods can vary widely. The average consumer can be expected to pay a reasonable degree of care and attention commensurate with the amount being spent.
22. The subject mark consists of the word “deeriu”. It is not a dictionary word and has no meaning in relation to the subject goods. The “stems” in the letters “d”, “r” and “u” in the subject mark are particularly elongated. Normal and fair use of the subject mark on the subject goods includes use on labels in relation to the subject goods as well as use in advertising. Marks appearing on labels may not be of a large size. The average consumer normally does not proceed to analyse the various details of a mark and remembers a mark by its overall impression.
23. Visually, each of the subject mark and the Applicant’s Mark starts with the identical letter “d” with a particularly elongated “stem”. In the subject mark, the “stem” at the left side of the letter “r” as well as the two conjoined “stems” in the letter “u” are also unusually long. With the three elongated “stems” at the latter part of the subject mark (), this part of the subject mark is visually very similar to the latter part of the Applicant’s Mark (). Viewing each of the two marks as a whole, each of them has four elongated “stems” which strike the eye, and these “stems” occupy more or less the same relative positions in the two marks. Although there is some visual difference between the two marks due to the different letters “ee” and “un” in the middle of the subject mark and the Applicant’s Mark respectively, the structures of and the overall visual impressions created by the two marks are very similar.

24. Aurally, the subject mark may be pronounced as “dee-ri-u” or “dee-hill”, depending on what the consumer, on first impression, makes of the last few letters with particularly long “stems” in the subject mark. The Applicant’s Mark would be pronounced as “dun-hill”. Although there is some difference in the pronunciation between the two marks, the majority of the public rely primarily on visual means to identify the trade origin of clothing, although one cannot say that aural means of identification are not at all relied upon (*REACT Trade Mark* [2000] R.P.C. 285).
25. Conceptually, each of the subject mark and the Applicant’s Mark has no meaning in relation to the relevant goods. They do not convey any specific meaning capable of being grasped by the average consumers.
26. The average consumer rarely has the chance to make a direct comparison between marks and places his trust in the imperfect recollection of them he has kept in his mind. He is more likely to remember that which strikes him by way of first impression, rather than details that do not make much difference in the overall impression given. I have already found that the elongated stems in the two marks strike the eye and occupy more or less the same relative positions in the marks. The overall structures of the two marks are also very similar. Taking an overall assessment of the visual, aural and conceptual similarities and differences between the subject mark and the Applicant’s Mark, I find that the overall impressions created by the two marks are very similar.

Likelihood of confusion

27. The likelihood of confusion must be appreciated globally, taking account of all relevant factors. The matter must be judged through the eyes of the average consumer of the goods applied for who is deemed to be reasonably well-informed and reasonably observant and circumspect. 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.*).

28. 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.
29. Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose of section 12(3) of the Ordinance (*Sabel BV v Puma AG*). If the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically-linked undertakings, there is a likelihood of confusion within the meaning of section 12(3) of the Ordinance (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).
30. I have already found that the subject goods are identical to some of the Applicant's Goods, and that the overall impression created by the subject mark is very similar to that created by the Applicant's Mark. Taking into account the combined effect of these considerations and having regard to the degree of distinctiveness of the Applicant's Mark, I consider that when the subject mark is used in relation to the subject goods, the average consumer would be confused into thinking that the Registered Owner's subject goods and the Applicant's Goods come from the same or economically-linked undertakings.
31. The ground under section 12(3) of the Ordinance is made out.

Conclusion

32. For the reasons stated above, the registration of the subject mark is declared invalid under sections 53(5)(a) and 12(3) of the Ordinance.
33. As I have found in favour of Applicant on the ground under section 12(3) of the Ordinance, it is not necessary for me to consider the other grounds for the Application.
34. As the invalidation has succeeded, 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 the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

(Finnie Quek)
for Registrar of Trade Marks
12 March 2009