

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300129221

MARK : **GONDRAND**

CLASS : **39**

APPLICANT : **SOCIETE FRANCAISE DE TRANSPORTS GONDRAND
FRERES**

OPPONENT : **GONDRAND AG**

STATEMENT OF REASONS FOR DECISION

Background

1. On 18 December 2003 (“Application Date”), SOCIETE FRANCAISE DE TRANSPORTS GONDRAND FRERES (“Applicant”) filed an application (“subject application”) under the Trade Marks Ordinance (Cap.559) (“Ordinance”) for registration of the following mark (“subject mark”):

GONDRAND

Registration is sought in respect of the following services in Class 39 (“subject services”):

“national and international transport of goods; freight forwarding, shipping agent, public transport services of goods, travel agency, removal services and furniture storage”.

2. The date of priority claimed by the Applicant in respect of the subject application was 16 October 2003 (“Priority Date”).
3. Particulars of the subject application were published on 6 February 2004. GONDRAND AG (“Opponent”) filed a notice of opposition to the subject

application on 5 July 2004 (“Notice of Opposition”) with a statement of the grounds of opposition (“Grounds of Opposition”).

4. The Applicant filed a counter-statement on 1 December 2004 in response to the Notice of Opposition.
5. The Opponent filed evidence by way of a declaration of Charles-Antoine Gondrand declared on 5 December 2005 (“CAG Declaration”). The Applicant did not file any evidence.
6. The opposition was fixed to be heard on 9 December 2008. Neither the Opponent nor the Applicant filed a notice of intention to appear at the hearing (Form T12). Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559 sub. leg.) (“TM Rules”), they are treated as not intending to appear at the hearing. I therefore proceed to decide the matter without a hearing pursuant to rule 75 of the TM Rules.

Grounds of opposition

7. The Opponent opposes the subject application under the following sections of the Ordinance :
 - (i) section 11(4)(b);
 - (ii) section 12(5)(a);
 - (iii) section 11(5)(a);
 - (iv) section 11(5)(b);
 - (v) section 12(4);
 - (vi) section 12(1) and/or 12(2); and
 - (vii) sections 3(1) and 11(1)(a).

The Opponent’s evidence

8. According to the CAG Declaration, the Opponent is a joint stock company organized and existing under the laws of Switzerland. The Opponent claims

that since 1902, it and its predecessor have been using the mark “GONDRAND” (“Opponent’s Mark”) in Switzerland and other countries in the provision of various freight forwarding and logistic services. The Opponent’s Mark is identical to the subject mark.

9. According to the Opponent, the Applicant has been wholly owned by COMPAGNIE DE TRANSPORTS FINANCIERE ET IMMOBILIERE (“COTRAFI”), a French company founded in 1919. Since then and until July 2003, the Opponent (and its predecessors) and the Applicant had been affiliated with each other, and used to have the same team of management personnel.
10. In or about July 2003, the Opponent sold its share capital in COTRAFI to a third party whereas the Applicant acquired a non-controlling 30 percent equity stake in the share capital of the Opponent. Such transactions led to a change of personnel at the board of directors of the Opponent. The Opponent says that since then, notwithstanding the acquisition by the Applicant of the aforesaid 30 percent equity stake in the share capital of the Opponent, the Applicant does not have control over the management and business affairs of the Opponent. Instead of having the same team of management personnel, the Opponent and the Applicant now each has its own management personnel.
11. According to paragraph 9 of the CAG Declaration, in or about September 2001, the Opponent established its wholly owned subsidiary in Hong Kong, GO-TRANS (HONG KONG) LIMITED (“GO-TRANS”). The Opponent says that GO-TRANS has since its incorporation become one of the main channels through which the Opponent’s group of companies provides in Hong Kong and in other parts of South East Asia various services including “airfreight; seafreight; logistics and supply chain consultation; customs clearance, documentation and insurance; cross trade, transshipment and distribution; project and special transport; storage and warehousing; refrigerated services; and trade fairs and exhibitions” (“Opponent’s Services”).
12. The Opponent has on 20 December 2003 applied under Application No. 300131200 for registration of the Opponent’s Mark in respect of various services in Class 39.

13. I will return to the Opponent's evidence of use of the Opponent's Mark.

Opposition under section 11(4)(b) of the Ordinance

14. Section 11(4)(b) of the Ordinance provides that:

"A trade mark shall not be registered if it is –

... (b) likely to deceive the public."

15. According to the Grounds of Opposition, the Opponent's case under section 11(4)(b) of the Ordinance is that:

- (i) The Opponent's Mark has become distinctive and well-known to the public as identifying the goods of and services (particularly in the industry of transport, packaging and storage of goods and travel arrangement services) provided by the Opponent and none other.
- (ii) The subject mark is identical to the Opponent's Mark. The subject services are identical and/or similar to those for which the Opponent's Mark is protected.
- (iii) By reasons of the aforesaid, registration and use of the subject mark would inevitably confuse or deceive the public and general consumers that the Applicant's services originated from the Opponent and/or are at least licensed, authorized, approved and endorsed by and/or in some way associated or connected with the Opponent when this is not the case. Accordingly, the subject mark should be refused registration pursuant to section 11(4)(b) of the Ordinance¹.

16. Section 11(4)(b) of the Ordinance is intended to apply where the deception alleged arises from the nature of the mark itself. This is consistent with the heading of section 11 of the Ordinance which is entitled "Absolute grounds for refusal of registration" and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties. Consequently, the Opponent cannot succeed under section 11(4)(b)

¹ Grounds of Opposition, paragraphs 6, 8, 9.

of the Ordinance based upon its allegedly identical mark (*QS by S. Oliver Trade Mark* [1999] R.P.C. 520 at 524).

17. The Opponent therefore has not made out its opposition under section 11(4)(b) of the Ordinance.

Opposition under section 12(5)(a) of the Ordinance

18. Section 12(5)(a) of the Ordinance provides, *inter alia*, as follows :

“... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off);”.

19. The Opponent’s case under section 12(5)(a) of the Ordinance is that, use and registration of the subject mark constitutes acts of passing off and therefore the subject mark should be refused registration pursuant to section 12(5)(a) of the Ordinance.

20. The relevant question is whether normal and fair use of the subject mark for the purpose of distinguishing the subject services from those of other undertakings was liable to be prevented at the Application Date by an action for passing off.

21. A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of Hong Kong Volume 15(2)* at paragraph 225.001. The guidance takes account of 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 Townend & Sons (Hull) Ltd* [1979] A.C. 731, and is 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.*

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House of Lords. However, like the previous statement of the House of Lords, this latest statement should not be treated as akin to a statutory definition or as if the words used by the House of Lords constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognized forms of the action for passing off which were not under consideration on the facts before the House of Lords."

22. Further guidance is given at paragraph 225.020 of the same volume as follows:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) *that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*
- (2) *that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.*

While it is helpful to think of these two factual elements as two successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;*
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;*
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and*
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

- 23. I first consider whether the Opponent’s Services have, by the Application Date, acquired a goodwill or reputation in Hong Kong which is known by the Opponent’s Mark.
- 24. I proceed to consider each of the exhibits to the CAG Declaration in turn.
- 25. The extract from the Opponent’s website at exhibit “CG-1” was downloaded from the Internet in 2005, i.e. after the Application Date.
- 26. Although the employment letter issued in August 1997 at exhibit “CG-2” shows that the Opponent employed a commercial delegate in Hong Kong in 1997, it does not show whether, and if so how, the Opponent’s Mark was used by or on behalf of the Opponent in Hong Kong in relation to its business of providing the Opponent’s Services.

27. Exhibit “CG-3” is said to contain copies of sample advertising and promotional materials illustrating use of the Opponent’s Mark by the Opponent and its affiliated companies. The first page in that exhibit CG-3 appears to be a promotional leaflet in respect of the Opponent’s logistics services. The marks “GO-TRANS” and “GONDRAND” appear in equal size prominently at the bottom of the page. On the other hand, this leaflet is undated, and there is no evidence that it has been distributed to customers or potential customers in Hong Kong before the Application Date.
28. The contract for advertising in The Hong Kong Shipping Gazette dated 1 August 2002 included in exhibit “CG-3” does not show use of the Opponent’s Mark. The copy of the advertisement at the Hong Kong Shipping Gazette on the next page bears a date in November 2005, i.e. after the Application Date.
29. Photographs of trucks appearing in exhibit “CG-3” are also dated after the Application Date.
30. The only pieces of evidence which are dated prior to the Application Date and in which the Opponent’s Mark appears are the following, which are found in exhibit “CG-3”:
- (i) A customer invoice issued in December 2001 to The Wider Int’l Trading Ltd. in respect of certain freight forwarding and related services. Whereas the full company name of the Opponent’s subsidiary, GO-TRANS (HONG KONG) LIMITED, appears prominently both at the top and at the lower right corner of the invoice, the Opponent’s Mark only appears as part of a phrase in rather small print at the top right corner as follows:

GO-TRANS
member of Gondrand Group

- (ii) An air waybill issued in January 2002 to Topfine Technologies Ltd (“Topfine”). Whereas the name GO-TRANS (HONG KONG) LIMITED appears prominently at the right column at the top part of the air waybill, the Opponent’s Mark appears in small print at the top right corner as follows:

Air Waybill No.: 601000674

GO-TRANS (HONG KONG) LIMITED

- (iii) A letter from GO-TRANS to Topfine in August 2002 relating to, *inter alia*, the air waybill referred to in sub-paragraph (ii) above. The following appears at the top right corner of the letter:

GO-TRANS

member of Gondrand Group

- (iv) A printer's proof and a delivery order issued in November 2003 in respect of the printing of name cards of two officers of GO-TRANS. The following appears at the top right corner of both name cards:

GO-TRANS
member of Gondrand Group

Although 200 pieces of each of the two name cards were ordered, they were only delivered to GO-TRANS around a month before the Application Date. One would not, therefore, expect that a large number of the name cards would have been distributed by the Application Date.

- (v) Copies of calendars for January 2002 and January 2003. The full names of GO-TRANS and two of its affiliates appear in bold at the bottom part of both copies of calendars. The following mark appears at the bottom right corner of both calendars:

GO-TRANS
member of Gondrand Group

It is not clear whether, and if so to what extent, these calendars were distributed to customers in Hong Kong in the promotion of the Opponent's Services before the Application Date.

31. The calendars for January 2004 and January 2005 included in exhibit "CG-3" post-date the Application Date. The remaining exhibits "CG-4", "CG-5" and

“CG-6” to the CAG Declaration contain copies of foreign registration certificates in respect of the Opponent’s Mark, details of the Opponent’s application for registration of the Opponent’s Mark under Application No. 300131200, and a copy of an annual return of GONDRAND LIMITED, an affiliated company set up by the Applicant, for the year ending in August 2005. None of these relate to use of the Opponent’s Mark in relation to provision of the Opponent’s Services to customers or potential customers in Hong Kong.

32. Although the Opponent’s net revenue in Hong Kong for the years 2001 to 2004 are given at paragraph 6 of the CAG Declaration, the only invoice, shipping document and correspondence produced are as referred to in paragraph 30(i) to (iii) above. Moreover, there is no evidence of promotion of the Opponent’s Services by reference to the Opponent’s Mark or of the amounts invested by the Opponent in promoting the Opponent’s Mark in Hong Kong before the Application Date.
33. The Opponent considers that by reason of the use and promotion of the Opponent’s Mark “GONDRAND” as described in the CAG Declaration, the mark “has become identified with and is distinctive of the Opponent and its services exclusively amongst members of the industry and the public, and none other.”
34. A name, mark or sign is distinctive if it denotes the goods or services of the claimant to the exclusion of other traders. It is the significance which the relevant public attaches to the mark which is all-important².
35. The relevant public in relation to the Opponent’s Services mainly includes businesses and individuals looking for freight forwarding, logistics and related services. I have considered the manner of use of the Opponent’s Mark described in paragraph 30 above. It is noted that in each of the instances of use referred to in paragraph 30, the Opponent’s Mark does not appear alone, but as part of the phrase “member of Gondrand Group”. These words appear in much smaller font underneath or otherwise in a less prominent position than “GO-TRANS” or the full name “GO-TRANS (HONG KONG) LIMITED”. In some instances, the words “member of Gondrand Group” are so small that they are hardly noticeable if one were not looking for them. I consider that the average member of the relevant public is likely to rely on the

² *Wadlow, The Law of Passing Off: Unfair competition by misrepresentation* (3rd Ed.) para. 8-4.

mark “GO-TRANS” to distinguish the Opponent’s Services from those of other traders. The Opponent’s Mark “Gondrand” as part of the phrase “member of Gondrand Group” appearing in much smaller print than “GO-TRANS” or “GO-TRANS (HONG KONG) LIMITED” is unlikely to make any significant impression in the minds of customers. Moreover, there is no evidence of any use of the Opponent’s Mark in advertisements or promotional activities in respect of the Opponent’s Services or of the amounts invested by the Opponent in promoting the Opponent’s Mark in Hong Kong before the Application Date. I am not satisfied that a substantial number of persons who are or may become potential customers in Hong Kong for the Opponent’s Services would associate the Opponent’s Mark “GONDRAND” with the Opponent’s Services. In other words, the Opponent has failed to show that the Opponent’s Services have, by the Application Date, acquired a sufficient goodwill or reputation in the Hong Kong market which is known by the Opponent’s Mark.

36. As the Opponent has failed to establish the requisite goodwill or reputation in Hong Kong which is known by the Opponent’s Mark to mount a passing off action in Hong Kong at the Application Date, it follows that the Opponent has failed to show that normal and fair use of the subject mark for the purpose of distinguishing the subject services from those of other undertakings was liable to be prevented at the Application Date by an action for passing off.
37. The Opponent’s opposition under section 12(5)(a) of the Ordinance therefore fails.

Opposition under section 11(5)(a) of the Ordinance

38. Section 11(5)(a) of the Ordinance provides that :

“A trade mark shall not be registered if, or to the extent that –

(a) its use is prohibited in Hong Kong under or by virtue of any law;”.

39. The Opponent’s case under section 11(5)(a) of the Ordinance is that, for the same reasons referred to in paragraphs 15 and 19 above, use of the subject

mark in respect of the subject services should be prohibited³.

40. Section 11(5)(a) is intended to apply where the prohibition by law arises from the mark itself. An objection that use of the mark would cause passing off arises under section 12(5)(a) of the Ordinance and not under this subsection⁴.
41. I have already found that the Opponent has failed to establish that at the Application Date, use of the subject mark in Hong Kong is liable to be prevented by virtue of the law of passing off. The Opponent also has not established that use of the subject mark is prohibited in Hong Kong under any other law.
42. The Opponent therefore has not made out its opposition under section 11(5)(a) of the Ordinance.

Opposition under section 11(5)(b) of the Ordinance

43. Section 11(5)(b) of the Ordinance provides that :

“A trade mark shall not be registered if, or to the extent that –

... (b) the application for registration of the trade mark is made in bad faith.”

44. The Opponent’s case under section 11(5)(b) of the Ordinance is that, the application for registration of the subject mark was made in bad faith calculated to ride upon the goodwill and reputation gained by the Opponent’s Mark which unfairly, adversely and severely prejudices the legitimate business interests of the Opponent⁵.
45. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 at 379, Lindsay J. stated the following in relation to section 3(6) of the UK Trade Marks Act 1994 (equivalent to section 11(5)(b) of the Ordinance):

³ Grounds of Opposition, paragraph 11.

⁴ *Kerly’s Law of Trade Marks and Trade Names*, 14th Edition, paragraph 8-212, in relation to section 3(4) of the UK Trade Marks Act 1994 (which is similar to section 11(5)(a) of the Ordinance) and section 5(4)(a) of the UK Trade Marks Act 1994 (which is similar to section 12(5)(a) of the Ordinance).

⁵ Grounds of Opposition, paragraph 12.

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be judged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

46. In *Harrison v Teton Valley Trading Co (CHINAWHITE)* [2005] F.S.R. 10, the Court of Appeal in the United Kingdom held (at paragraph 26) that:

“The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

47. Further, in *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person said,

“The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the determination of the objective element.”

48. Bad faith is a serious allegation that must be proved. An allegation of bad faith should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference (*ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24 at para. 31).

49. The Opponent said that the Applicant set up or caused to be set up in around August 2004 its own affiliated company in Hong Kong called Gondrand Limited, which name was subsequently changed to Gondrand Transportation Services Limited. The Opponent said that such business was directly in

unfair competition with the Opponent's prior business in Hong Kong. The Opponent said that it was gathering evidence of other wrongful conducts of the Applicant and/or its related companies and would take appropriate actions against its and/or their acts of infringement, passing off and/or unfair competition⁶.

50. The issue under section 11(5)(b) of the Ordinance is whether the subject application was made in bad faith.
51. I have already found that the Opponent has failed to establish the requisite goodwill or reputation in Hong Kong which is known by the Opponent's Mark to mount a passing off action in Hong Kong at the Application Date. There is no evidence of any agreement between the parties on the right to use the subject mark at any time before or after the transactions and change in personnel in July 2003 referred to in paragraph 10 above. Having considered the Opponent's pleaded case and its evidence as a whole, I find that there is no material before me which could form the basis of the conclusion that in applying for registration of the subject mark, the Applicant's dealings fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the trade.
52. I find that the opposition under section 11(5)(b) of the Ordinance also fails.

Opposition under sections 12(1), 12(2) and 12(4) of the Ordinance

53. Each of sections 12(1), 12(2) and 12(4) of the Ordinance requires that there is an earlier trade mark in relation to the subject mark.
54. Section 5(1) of the Ordinance provides that:

“(1) In this Ordinance, “earlier trade mark” (在先商標), in relation to another trade mark, means-

(a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into

⁶ CAG Declaration, paragraphs 14, 16.

*account the priorities claimed in respect of each trade mark, if any;
or*

(b) a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention as a well-known trade mark.”

55. The Opponent’s Mark is not a registered trade mark which has a date of application for registration earlier than that of the subject mark. The Opponent claims that the Opponent’s Mark is entitled to protection under the Paris Convention as a well-known trade mark, and that the Opponent’s Mark is an earlier trade mark in relation to the subject mark as defined in section 5(1)(b) on the Ordinance.
56. To rely on section 5(1)(b) of the Ordinance, the Opponent has to show that the Opponent’s Mark was, at the Priority Date, entitled to protection under the Paris Convention as a well-known trade mark.
57. According to section 4(1) of the Ordinance, references in the Ordinance to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as references to a trade mark which is well-known in Hong Kong. In determining whether a trade mark is well-known in Hong Kong, the Registrar shall have regard to Schedule 2 to the Ordinance (section 4(2) of the Ordinance). The Registrar shall take into account any factors from which it may be inferred that the trade mark is well-known in Hong Kong (section 1(1), Schedule 2 to the Ordinance), including information concerning the matters referred to in section 1(2), Schedule 2 to the Ordinance.
58. I have already considered the duration, extent and manner of use and promotion of the Opponent’s Mark by the Opponent before the Application Date (paragraphs 24 to 32 and 35 above). The Priority Date was before the Application Date. The extent to which the Opponent’s Mark has been used in Hong Kong by the Priority Date was less than that by the Application Date. For example, the printer’s proof and delivery order referred to in paragraph 30(iv) above were issued after the Priority Date but before the Application Date.

59. The Opponent claims that since 1902, it (including its predecessors) has been using the Opponent's Mark extensively in Switzerland and in many countries throughout the world, but the only exhibits verifying use of the Opponent's Mark before the Application Date are as described in paragraph 30 above. There is no evidence of any use of the Opponent's Mark in advertising or publicity and the presentation (at fairs or exhibitions) of the Opponent's Services. I note the foreign registrations referred to in paragraph 5 and exhibit "CG-4" to the CAG Declaration. Not all the documents included in exhibit "CG-4" to the CAG Declaration are in either of the official languages. It would appear that the registrations were obtained in the 1980's and 1990's. It is not entirely clear from those registrations the extent to which the Opponent's Mark has been used or recognized in the relevant jurisdictions. There is no evidence of the degree of knowledge or recognition of the Opponent's Mark in the relevant sectors of the public or of any successful enforcement of rights in the Opponent's Mark, or of the value associated with the Opponent's Mark.
60. Having considered the totality of the Opponent's evidence and all relevant factors in accordance with section 1 in Schedule 2 to the Ordinance, I am not satisfied that the Opponent's Mark is well-known in Hong Kong at the Priority Date.
61. As there is no earlier trade mark on which the Opponent can rely for the purposes of sections 12(1), 12(2) and 12(4) of the Ordinance, it cannot succeed in its opposition under those sections.

Opposition under sections 3(1) and 11(1)(a) of the Ordinance

62. Section 3(1) of the Ordinance provides as follows :

"In this Ordinance, a "trade mark" (商標) means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically."

63. Section 11(1)(a) of the Ordinance provides as follows :

“Subject to subsection (2), the following shall not be registered-

(a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");”.

64. The Opponent’s case under sections 3(1) and 11(1)(a) of the Ordinance is that the subject mark is not capable of distinguishing the goods and services of one undertaking from those of other undertakings and hence is not a registrable mark within the meaning of section 3(1) of the Ordinance. The Opponent has not explained why this is the case.

65. The subject mark “GONDRAND” is graphically represented, and has no meaning in the relation to the subject services or any of their characteristics. I consider that the subject mark as a whole is capable of distinguishing the subject services of one undertaking from those of other undertakings. The Opponent therefore has not made out its opposition under sections 3(1) and 11(1)(a) of the Ordinance.

Cost

66. As the opposition has failed, 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 February 2009