

TRADE MARKS ORDINANCE (Cap. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300142235

MARK :



CLASS : 25

APPLICANT : TRAILWALKER LIMITED

OPPONENT : C & J CLARK INTERNATIONAL LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 13 January 2004, Trailwalker Limited (the “applicant”) filed an application for registration (the “subject application”) of the mark represented above (the “suit mark”), in Classes 9, 14, 16, 25, 30, 36 and 41, under the Trade Marks Ordinance, Cap. 559 (the “Ordinance”).

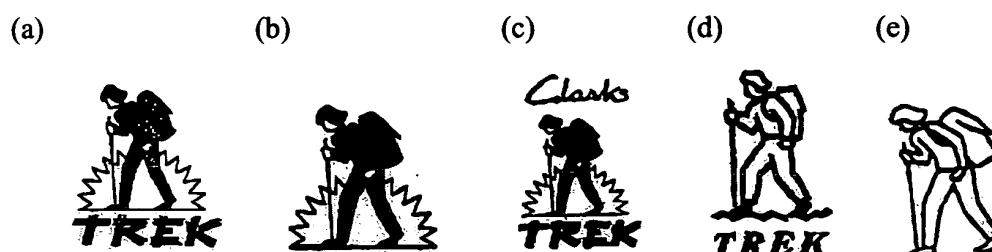
2. Particulars of the subject application were published on 4 June 2004. C & J Clark International Limited (the “opponent”) filed a notice of opposition which includes a Grounds of Opposition on 3 November 2004.

3. The opposition hearing took place before me on 9 October 2008. At the hearing, Mr. Philips B.F. Wong, counsel, instructed by Stevenson, Wong & Co., Solicitors, appeared for the opponent. Mr. W.K. Cheung, of Lo & Lo, Solicitors, appeared for the applicant.

Grounds of opposition

4. The original Grounds of Opposition filed with the notice of opposition has since been amended. The Amended Grounds of Opposition, filed on 20 January 2005, states that the opponent only opposes registration of the suit mark in Class 25 in respect of “articles of clothing, headgear and footwear”, under sections 3(1), 11(1)(a), 11(4)(b), 11(5)(a), 12(3) and 12(5) of the Ordinance.

5. In the Amended Grounds of Opposition, the opponent states that it has used and is continuing to use the following device marks, which all depict a human figure carrying a backpack and a walking stick, extensively in various jurisdictions worldwide including Hong Kong in respect of footwear, and parts and fittings of and for footwear:



(collectively referred to as “the opponent’s marks”)

6. Amongst the opponent’s marks, mark (e) as shown above was applied for registration in Class 25 with the Hong Kong Trade Marks Registry on 3 December 2001 under application no. 200119470:

7. It is alleged that the opponent’s marks had been used in Hong Kong for at least 25 years, and that by reason of their long and extensive use and promotion, the opponent’s marks had acquired distinctiveness and obtained instant recognition by members of the public in Hong Kong.

Counter-statement

8. The applicant filed a counter-statement on 20 April 2005, denying all claims in the Amended Grounds of Opposition.

9. The applicant, Trailwalker Limited, is a charitable organization in Hong Kong established in 1976. Being a member of the Oxfam International, which was first found in England in 1942 and currently has 12 members around the world, the applicant has supported development and emergency relief projects in more than 40 countries, and enjoyed high reputation with Oxfam International both in Hong Kong and in the globe as autonomous non-governmental organizations dedicated to the fighting of poverty and related injustice.

10. The applicant avers that it has no knowledge of either the opponent's marks or their extent of use, sales, advertising, goodwill and/or distinctiveness. The applicant further avers that the suit mark consists of a device which is the prominent part of registered trade marks nos. 200012463 (in Class 25), 200012461 (in Class 14), 200012462 (in Class 16) and 200012464 (in Class 41), all in the name of the applicant. The subject application is to "consolidate the use of the suit mark under one single application".

11. The applicant alleges that the suit mark is capable of distinguishing the applicant's goods from those of the others through its long history of use in the annual fundraising event, namely, "Trailwalker" which was first organized in Hong Kong by the applicant in 1981 and has become one of the largest and most well-known fundraising sports events in Hong Kong.

The opponent and its evidence

12. The opponent's evidence comprises a statutory declaration of Judith Enid Derbyshire made on 6 February 2006 ("Derbyshire's first statutory declaration") as evidence in support of opposition under Rule 18 of the Trade Marks Rules, Cap 559A (the "Rules"), and a second statutory declaration of her made on 1 February 2007 ("Derbyshire's second statutory declaration") as evidence in reply under Rule 20 of the Rules. Ms. Derbyshire is the Company Secretary of the opponent and has held that position since 1991.

13. In her first statutory declaration, Ms. Derbyshire states the opponent's history which began from the 1830s in the United Kingdom. It is stated that in 1971, the opponent started to use marks which depict a human figure carrying a backpack and a walking stick for the marketing and distributing of the "Goods" which was

defined to include footwear, clothing, headgear, inner socks and parts and fittings of and for footwear. I note that all the marks mentioned are the same as the opponent's marks referred to in the Amended Grounds of Opposition and set out graphically under paragraph 5 above.

14. Exhibit 1 to Derbyshire's first statutory declaration contains the certificate of registration in respect of the mark mentioned in paragraph 6 above. This mark was one of the opponent's marks and was subsequently registered with the Hong Kong Trade Marks Registry in Class 25 under registration no. B00266 of 2005 as of the date of 3 December 2001 in respect of "footwear; clothing; headgear; inner socks; parts and fittings of and for footwear". Ms. Derbyshire states that this mark is the latest version of the opponent's marks. The graphic representation of the mark is set out below and I shall hereinafter refer to it as "the opponent's registered mark":-



15. Ms. Derbyshire alleges that the opponent first used the opponent's marks in Hong Kong at least 25 years ago in around 1980 in respect of the Goods, and has continued the use since then.

16. I shall discuss in more details the evidence in Derbyshire's first statutory declaration in the latter part of this decision.

17. As to Derbyshire's second statutory declaration, understandably its purported aim is to give a response to the applicant's evidence. Hence it consists in the main of comments and submissions. I do not propose to summarize them but would refer to the relevant parts as and when appropriate in the latter part of this decision.

The applicant and its evidence

18. The applicant's evidence comprises a statutory declaration of To King Hoi made on 16 August 2006. Mr. To is the Finance Director of the applicant.

19. According to Mr. To, the applicant is a wholly-owned subsidiary company of Oxfam Hong Kong (“Oxfam”). Oxfam, which in turn is a member of Oxfam International, was set up by a group of volunteers in 1976 and since then has become a well established charity in Hong Kong and is an independent development and relief agency based in Hong Kong, supporting projects in more than 60 regions including China and Hong Kong. To support its goals and works, Oxfam has organised a number of fundraising activities. One of the successful fundraising events organised by Oxfam is the “Trailwalker”, which in Chinese is called the “毅行者”. Trailwalker was originally co-hosted by Oxfam and the Gurkhas from 1986 onwards, but Oxfam since 1997 has become the sole organiser of the event. Over the years, Trailwalker has become an annual fundraising event of Oxfam and has been known to and well participated by members of the general public in Hong Kong. Up to 2004, over \$158 million had been raised by Oxfam to help disadvantaged people in Hong Kong and poor people in Asia and Africa.

20. Mr. To avers that the logo and device of Trailwalker exhibited as “KT-1” to his statutory declaration has been used since the 1980s. By way of illustration I produce the logo and device below:-



(hereinafter referred to as the “Trailwalker Logo and Device”).

21. It can be seen that the Trailwalker Logo and Device is made up of the word “Trailwalker” and the Chinese characters “毅行者” underneath a device which without dispute is the suit mark itself. Mr. To avers that the advertisements through media of the fundraising activity of Trailwalker over these years have promoted the Trailwalker Logo and Device, and since many people have either joined in the walk or acted as sponsors in Trailwalker which takes place in the winter time every year, the suit mark has been known to a large population of the Hong Kong people.

22. Mr. To exhibits copies of leaflets, paper-clippings from newspaper and magazines and a brief history of Trailwalker downloaded from the website of Oxfam as “KT-2” and “KT-3” to his statutory declaration to show that the suit mark had been

used in the Trailwalker event. He also states that the aforesaid exhibits show that Trailwalker received support from the general public as well as celebrities and big organisations in Hong Kong. Moreover, Mr. To exhibits some photos as “KT-4” to his statutory declaration to show that the Trailwalker Logo and Device has been applied on souvenirs such as tee shirts, polo shirts, hats, headbands, wind-breakers, scarves and other wearing apparels. Such souvenirs were produced by the applicant for sale in order to produce more income.

23. “KT-5” to Mr. To’s statutory declaration contains copies of registration certificates in respect of the applicant’s registered marks that have been mentioned in paragraph 10 above. These marks are essentially the Trailwalker Logo and Device registered in Classes 14, 16, 25 and 41. “KT-6” to Mr. To’s statutory declaration contains copies of registration certificates in respect of the applicant’s plain word mark “Trailwalker” and plain Chinese character mark “毅行者” respectively registered in Classes 9, 14, 16, 25, 30, 36 and 41.

24. Mr. To alleges that he is not aware of the opponent having advertised its goods through or by the use of the opponent’s marks other than the mark “Clarks”.

25. Finally, though not having been pleaded by the applicant in the counter-statement, Mr. To in his statutory declaration raises the possibility of the suit mark being accepted for concurrent registration under section 13 of the Ordinance in case the Registrar considers that there exists similarity between the suit mark and the opponent’s marks.

26. I shall go into the details of the various claims made in Mr. To’s statutory declaration in the latter part of this decision.

Decision

27. At the hearing, Mr. Philips Wong, counsel for the opponent, very realistically and sensibly in my view indicated that the applicant only wished to pursue the ground of objection based upon section 12(3). I therefore do not need to deal with the other grounds of objection pleaded in the Amended Grounds of Opposition.

Section 12(3) of the Ordinance

28. Section 12(3) of the Ordinance provides as follows:

- “(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.”

29. 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.

30. Section 12(3) of the Ordinance is similar in effect 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 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.

31. In essence, the test under section 12(3) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, and taking into account the degree of similarity in the goods and how they are marketed. I must compare the marks in issue, having regard to the distinctive character of each and assuming normal and fair use of the marks across the full range of the goods within their respective

specifications. I must do all of this from the standpoint of the average consumer for the goods in question.

32. The relevant date is the date the subject application was filed, viz., 13 January 2004.

Earlier trade mark

33. The term “earlier trade mark” is defined in section 5 of the Ordinance. References to an earlier trade mark shall be construed as including a trade mark in respect of which an application for registration has been made under *the Ordinance* and which, if registered, would constitute an earlier trade mark under or by virtue of section 5(1)(a), subject to its being so registered. Of the opponent’s marks depicted in paragraph 5 above, from the pleadings and evidence filed by the opponent, the only mark that has been registered under *the Ordinance* is the opponent’s registered mark that I have mentioned in paragraph 6 as well as paragraph 14 above, which bears an application date of 3 December 2001 which is earlier than that of the suit mark of 13 January 2004. For the present purposes therefore, only the opponent’s registered mark, but not any other of the opponent’s marks, is the earlier trade mark in relation to the suit mark.

The average consumer

34. The goods in issue are clothing items and footwear. The average consumer will range from the general public to the wholesaler/merchandising distributor. Purchases of clothing and footwear are likely to be made with some degree of care at least because issues of size, style, colour, price, etc. must be considered. Nevertheless, the consumer may not exhibit the very highest level of attention particularly if the item is a relatively low cost or utilitarian item such as a pair of socks. The contrary may of course be the case if very expensive items are involved, but there is no indication to that effect in the present case.

Comparison of goods

35. Despite the various classes the subject application comprises, the opposition is directed only at Class 25 of the application: “articles of clothing, headgear and footwear”.

36. The opponent’s registered mark is registered in Class 25 in respect of “footwear; clothing; headgear; inner socks; parts and fittings of and for footwear”.

37. I consider inner socks and parts and fittings of and for footwear to be also footwear. It is clear that, based on the notional scope of the respective specifications, identical goods are in play.

Distinctiveness of the opponent’s registered mark

38. The distinctive character of a trade mark must be taken into account when determining whether the similarity between the marks and between the goods or services covered by the two marks is sufficient to give rise to a likelihood of confusion. A mark may be particularly distinctive either per se or because of the reputation it enjoys with the public. The more distinctive an earlier mark, the greater will be the likelihood of confusion (*Sabel BV v Puma AG*).

39. In determining the distinctive character of an earlier trade mark, I must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (*Windsurfing Chiemsee v Huber and Attenberger* [1999] E.C.R. I-2779; *Lloyd Schuhfabrik Meyer v Klijsen Handel* [1999]

E.T.M.R. 690).

40. The opponent's registered mark consists entirely of a graphic depiction of a human figure carrying a backpack and a walking stick. This is just an image of a person engaging in certain walking activity which, in the context of the goods for which it has been registered, namely, footwear; clothing; headgear; inner socks; parts and fittings of and for footwear, may serve as an indication that the goods are of the kind apt to be used for such activity. The mark is in a sense descriptive of the goods, and that means the mark is inherently of weak distinctive character.

41. The opponent has submitted evidence said to be showing use of the opponent's marks, one of which is the opponent's registered mark. I must assess the evidence for the purposes of any enhanced distinctive character.

42. Ms. Derbyshire in her first statutory declaration alleges that the opponent's marks are usually sealed or printed on the Goods and labelled on their packaging, and Exhibit 4 to Derbyshire's first statutory declaration is said to contain copies of product catalogues of the Goods bearing the opponent's marks. On inspection I find, except for a few pages which depict photographs of shoes bearing the opponent's registered mark, the marks used on the catalogues are either the word mark "Clarks" or the mark I would call it "Clarks ORIGINALS & device" mark (the device has nothing similar, in whole or in part, to any of the opponent's marks). The catalogues that contain photographs of shoes bearing the opponent's registered mark are dated 2002 and 2003. Although the catalogues list out retail agents that are located worldwide including one with a Hong Kong address, there is no hint whether the goods shown in the catalogues were actually offered for sale and sold in Hong Kong. And I must say that despite the claim by Ms. Derbyshire in her first statutory declaration that the Goods bearing the opponent's marks are available for sales to the general public through various local shops, boutiques and department stores, and extensive and constant promotion has been performed in Hong Kong ever since the Goods became available for sale in Hong Kong, the aforesaid few photographs of shoes bearing the opponent's registered mark is the only evidence that show use of the opponent's registered mark.

43. Ms. Derbyshire gives some annual sales figures of the opponent for the years 2000 to 2004 in her first statutory declaration. But these figures are only said to be sales figures "of the Goods sold under and by reference to the [*opponent's marks*] in Hong Kong and/or export from Hong Kong", and there is no breakdown whatsoever into the specific marks comprising the opponent's marks. I have no way

to evaluate how much sales, if any, is related to the opponent's registered mark. In any event, these are only mediocre sales figures in the context of the goods in question, I do not consider they are of any significant help in establishing a reputation for the goods and marks concerned.

44. Considering all the above, I conclude that the evidence is wholly unconvincing when it comes to establishing that the opponent's registered mark has acquired an enhanced degree of distinctive character through use.

Distinctiveness of the suit mark

45. I now turn to consider the distinctive character of the suit mark. As pointed out above, the suit mark is in fact the pictorial part of the Trailwalker Logo and Device, the latter having in addition the word "Trailwalker" and the Chinese characters "毅行者" underneath.

46. I have summarised the applicant's evidence in paragraphs 18 to 25 above. The emphasis on the recognition by the general public in Hong Kong of the annual Trailwalker event is well borne out by the copy leaflets, paper-clippings from newspaper and magazines and website information from Oxfam as exhibited in "KT-2" and "KT-3" to Mr. To's statutory declaration. And I also accept that what goes with the popularity of the event is the recognition by the general public in Hong Kong of the marks and signs appearing on items and articles such as banners, promotional leaflets, sponsorship forms, tee shirts, headbands, wind-breakers, etc. From the materials exhibited in "KT-2", "KT-3" and "KT-4" to Mr. To's statutory declaration, aside from the plain word marks "Trailwalker" and "毅行者", and some marks apparently of Oxfam, what had been applied on those items and articles, particularly on tee shirts, polo shirts and hats, is the Trailwalker Logo and Device. On the evidence, I am not able to find even one single piece of item or article that has the suit mark appearing alone and separated from the Trailwalker Logo and Device.

47. Nonetheless, Mr. To in his statutory declaration has tried to argue that the suit mark forms the prominent background of the Trailwalker Logo and Device and hence is known to a large population of the Hong Kong people. I do not find Mr. To's argument convincing. It is often said that in the case of composite trade marks "words speak louder than devices". That, in my opinion, is the case of the

Trailwalker Logo and Device. The word “Trailwalker” and the Chinese characters “毅行者” would capture the public’s attention and inform them that the items or articles on which the mark appears have something to do with the annual event of Trailwalker (or in Chinese, 毅行者). The pictorial component, which is essentially the suit mark, would at best play a subsidiary role in gripping the mind of the public in so far as the Trailwalker Logo and Device is concerned.

48. The suit mark on its own consists of a graphic depiction of a human figure carrying a backpack and a walking stick walking up a mountain slope under a cloudy sky. The human figure, though in appearance different from the one in the opponent’s registered mark, is similarly descriptive of the applied for goods, namely, articles of clothing, headgear and footwear. The background scenery, depicted in black and white stripes, whilst in itself may not give away much of its indicative meaning, would on combination with the human figure convey the idea and image of a person engaging in hiking activity in the mountains or countryside. The suit mark on its whole may serve as an indication that the goods in question are of the kind suitable to be used as a hiker’s outfit, and that means the mark is inherently of weak distinctive character.

Comparison of marks

49. According to consistent case law, in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer v Klijsen Handel*, paragraph 27).

50. In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion: see *Sabel BV v Puma AG*, para 23, *Lloyd Schuhfabrik Meyer*, para 25, and the order in *P Matratzen Concord v OHIM* (Case C-3/03), para 29.

51. Each of the marks concerned for the present purposes, namely, the suit mark and the opponent's registered mark, consists merely of a picture without any words or Chinese characters. Whilst the opponent's registered mark consists entirely of the pictorial presentation of a human figure carrying a backpack and a walking stick and there is little point in discussing about its distinctive and dominant components, the picture in the suit mark, on the other hand, can be divided into a component of the human figure and a component consisting of a striped backdrop of a mountain slope under a cloudy sky. I find the character of the suit mark resides in the bringing together of these two components to create a new idea and image of a person engaging in hiking activity in the mountains or countryside. I do not think the overall impression of the suit mark is dominated by either one of these components.

52. In the cases cited above, the European Court of Justice suggested I should look at the marks in the order of visual, aural and conceptual. That is what I propose to do. In so doing I bear in mind that account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but has to place his trust in the imperfect image of them that he has retained in his mind, and that the average consumer's level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, paragraph 26).

53. In visual terms, I would therefore disregard the niggling differences in the respective human figures such as the opposite directions the human figures are bounding towards, the detailed postures of the human figures, or the different genders the human figures seem to be of, as these are things that may not be reflected in imperfect recollection. Nonetheless, I find, on first impression, the two marks have clear and marked differences in presentation: on the one hand, in the suit mark, the human figure, depicted as a silhouette, is walking up a mountain slope under a cloudy sky. The slope and cloudy sky are depicted in black and white stripes forming a scenic backdrop to the whole picture. On the other hand, in the opponent's registered mark, there is only a plain outline of a human figure carrying a backpack and a walking stick *simpliciter* without any background at all. I find the image of the suit mark, created by the bringing together of the component of the human figure and the component of the slope-and-cloudy-sky, is more pronounced and arresting in terms of the impact on the eye than is the human figure *simpliciter* in the opponent's registered mark. I conclude that visually, the marks are more different from each other than they are similar.

54. I then turn to consider the aural use of the marks. The marks are both mere pictorial marks containing not a single word or Chinese character. In other words, the marks have no given sound, and the parties have not put in evidence as to how the public would call the marks. This becomes a matter for conjecture. I accept that in mere pictorial marks like the present ones, if one were to give each mark a name, the human figure would be the most convenient point of reference aurally, disregarding the more inconvenient references to the other components such as the slope and the cloudy sky in the suit mark. In respect of each mark, depending on how one views the activity the human figure is engaging in, one might just call it a mark of hiker or trekker, or a mark of hiking or trekking, or by reference to some other words describing a walker or a walking activity. Though not necessarily so, there is a fair chance that the suit mark and the opponent's registered mark may be aurally referred to by the same words of description, or that one may disregard the subtle semantic difference in the choice of words¹ and think that, say, a mark of hiking is just the same as a mark of trekking. In that light, I would say the marks are marginally more similar to each other than they are different.

55. More or less the same goes for the conceptual comparison. People would not go into detailed analysis of the marks. Instead, they would roughly perceive the human figure, common in both marks, as presenting an idea of a hiker or a trekker, or hiking or trekking, and remember the marks as such. I am of the view that the marks are to that extent conceptually similar.

56. In sum, I find that the marks can be readily distinguished at the visual level, but they do have certain aural and conceptual similarity.

Likelihood of confusion

57. The global assessment that I am required to undertake implies some interdependence between the relevant factors particularly the marks and the goods. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

¹ To "hike" means to walk a long way, usually for pleasure or exercise, especially in the country; whereas to "trek" means to make a long and often difficult journey (Collins English Dictionary, Third Edition).

58. In the present case, having found that the parties' goods in Class 25 are identical, I find that aurally and conceptually the marks are similar in that they would conveniently and roughly be referred to and perceived as the mark of a hiker or trekker, or of hiking or trekking. Against these are my findings that the opponent's registered mark is of weak distinctive character, and that the marks can be readily distinguished at the visual level.

59. It has been said that the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24). Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20). The converse, however, is the situation here. I have found that the human figure, which constitutes the entirety of the opponent's registered mark and is allegedly the only similar element with the suit mark, is descriptive of the goods in question and hence of weak distinctive character. How a tribunal like ours should approach the global assessment under such circumstances had been discussed in the case *Digipos Store Solutions Group Ltd v. Digi International Inc* [2008] R.P.C. 24. The English Chancery Court in that decision has the following observation:-

“...A weak mark is, in practice, likely to have a reduced scope because there is a lesser likelihood that other marks will be confused with it, if all that the respective marks have in common is the descriptive element. That, in turn, is because, as a matter of fact, the common element would not be thought by the average consumer to signal that the goods in relation to which the respective marks are used come from the same trade source, not because of any special approach under section 5(2)(b) to marks composed of descriptive elements: *Reed Executive* [2004] RPC 767 and *L'Oréal SA v OHIM* (Case C-235/05P) 27 April 2006.” (paragraph [42])

60. Going back to the present case, the aural and conceptual similarity existing between the marks stems, as I found, from the common element of the human figure which, obviously, is an apt and commonplace device to describe a hiker or trekker's outfit including articles of clothing, footwear, headgears, etc. As said in *Reed Executive*, “Where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another.”

61. I have already come to the conclusion that the marks can be readily distinguished at the visual level. This is of great significance here because it has been held that the appearance of trade marks is particularly important in relation to the goods of clothing, which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (see *React Trade Mark* [2000] R.P.C. 285). That same consideration also applies in relation to footwear and headgear which also form the goods in question besides clothing.

62. Aural and conceptual similarity is therefore of much less importance than the visual difference here. It has also been pointed out in *Sabel BV v Puma AG* that where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion (*Sabel BV v Puma AG*, paragraph 25). This is the case here.

63. In conclusion, with regard to the global assessment of the likelihood of confusion between the marks in question, first, the marks at issue are visually different, secondly, the significance of the visual difference is increased by the fact that perception of the marks by the average consumer, who tends to be observant, is overwhelmingly visual, and thirdly, any aural and conceptual similarity is low, the view must be taken that the visual difference is sufficient to counteract their aural and conceptual similarity, with the result that the marks at issue are different overall. It follows that, notwithstanding the identity of the goods concerned, the differences existing in this case between the conflicting marks are such that there is no reasonable likelihood that the relevant public will be led to believe that the goods covered by the suit mark come from the undertaking which holds the opponent's registered mark, or from an undertaking economically linked to that undertaking.

64. The ground of opposition under section 12(3) therefore fails.

65. As section 12(3) is the only ground of opposition the opponent pursues, and that has failed, there is no need for me to go on to consider the issue of honest concurrent use which, as discussed at paragraph 25 above, has not been properly raised by the applicant in its pleading. I just record that Mr. Philips Wong has, justly in my view to do so, devoted part of the hearing to deal with that issue.

Conclusion

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 the opponent or the applicant may make 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.

(Frederick Wong)
for Registrar of Trade Marks
24 March 2009