

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300156348

MARKS:

A ICE
HOUSE
FUR
B ICE HOUSE FUR
C Ice House Fur
D icehousefur

CLASSES: 25, 35, 37, 39, 40

APPLICANT: Ice House Fur Limited

OPPONENT: Gilmar S.p.A.

STATEMENT OF REASONS FOR DECISION

Background

1. On 11 February 2004, the applicant filed an application for registration (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for the registration of the following marks in series:-

A ICE
HOUSE
FUR
B ICE HOUSE FUR
C Ice House Fur
D icehousefur

(“the suit marks”).

2. Registration is sought in respect of the following goods and services in classes 25, 35, 37, 39 and 40:-

Class 25

clothing, footwear, headgear, fur hats, fur caps, fur stoles, fur garments, fur jackets, fur coats, fur capes, fur vests, fur collars, gloves (clothing), belts (clothing), scarfs and shawls; all included in Class 25

Class 35

wholesale outlet, retail store, distributorship, mail order and telephone order services relating to clothing, footwear, headgear, fur hats, fur caps, fur stoles, fur garments, fur jackets, fur coats, fur capes, fur vests, fur collars, gloves (clothing), belts (clothing), scarfs and shawls; online retail services for the aforesaid goods; sales promotion for others; distribution of samples; all included in Class 35

Class 37

fur care, cleaning and repair; all included in Class 37

Class 39

storage of furs and fur clothing; all included in Class 39

Class 40

custom fashioning of fur; fur conditioning; fur dyeing; fur glossing; fur mothproofing; fur satining; dressmaking; clothing alteration; all included in Class 40

3. Particulars of the subject application were published on 2 April 2004, and the opponent filed a notice of opposition to the subject application on 17 December 2004.

4. The opposition hearing took place before me on 30 November 2009. Mr. Philips Wong, counsel, instructed by Messrs. Deacons represented the opponent. The applicant appeared in person.

Grounds of opposition

5. The grounds on which the Opponent opposes registration of the suit marks as stated in the notice of opposition are under sections 3, 11(1)(a), 11(1)(b), 11(1)(c), 11(4)(b), 11(5)(a), 11(5)(b), 12(3), 12(4) and 12(5)(a) of the Ordinance. At the hearing, the grounds of opposition under sections 3, 11(1)(a), 11(1)(b) and (c) (so far as the designation of geographical origin is concerned) were not relied upon by the opponent.

Counter-statement

6. The applicant filed a counter-statement on 15 March 2005 in response to the opponent's notice of opposition.

Evidence

7. Under Rule 18 of the Trade Marks Rules (Cap.559, sub. leg.)(“Rule/s”), the opponent filed a statutory declaration from Silvano Gerani, the president of the opponent, together with exhibits, which was declared on 7 December 2006 (“Gerani’s statutory declaration”). The applicant did not file any evidence under Rule 19 although it was entitled to do so. Under Rule 20(3), leave was granted to the Opponent to file further evidence by way of a statutory declaration from Lau Wing Tong Candy which was declared on 31 March 2009.

Relevant date

8. The relevant date for considering the opposition is 11 February 2004, the date of the subject application for registration.

Opposition under section 12(5) of the Ordinance

9. Section 12(5) 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) ...”

10. 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 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.

11. Mr. Wong submitted that the Opponent enjoyed substantial reputation and goodwill in the family of "ICE" marks in Hong Kong at the relevant date.

The trade mark "ICEBERG"

12. Mr Gerani declared in paragraph 37 of his statutory declaration that "ICEBERG" clothing and fashion accessories were first distributed in Hong Kong in 1976. Copies of sample invoices issued from the opponent to various Hong Kong distributors in respect of men's and ladies' wearing apparel under the trade mark "ICEBERG" for the years of 1980, 1982 to 1987 and 1989 are produced in exhibit "SG-25". Further sales invoices issued by the opponent to the retailers and distributors in Hong Kong including the Swank Shop and Lane Crawford Department Stores and so on in respect of clothing items for the mark "ICEBERG" for the period from 1999 to 2003 are contained in the exhibits "SG-28" to "SG-32". The Hong Kong sales figures for the opponent's clothing and accessories under the mark "ICEBERG" for 1994 and from 1998 to 2004 were set out in paragraph 42 of Gerani's statutory declaration. The aggregate value of sales amounted to about €2.9 million for the eight-year period prior to the relevant date, giving an annual average of about €360,000. So far as the advertising and promotion of the mark "ICEBERG" in Hong Kong are concerned, I am able to find a bundle of sample magazine or newspaper advertisements published and circulated in Hong Kong for the mark "ICEBERG" in respect of clothing items from 1989 to 2004 in exhibits "SG-26" and "SG-36". It is also apparent from "SG-26" that there were various "ICEBERG" retail clothing shops at the Peninsula Hotel, the Landmark, Swire House, Kowloon Hotel and Hankow Centre over the period. In the light of all the above evidence, I find that the opponent had acquired goodwill and reputation through use of

“ICEBERG” in respect of clothing and fashion accessories in Hong Kong at the relevant date.

13. Apart from clothing and fashion accessories, “ICEBERG” brand of fragrances were first distributed in Hong Kong in 1993. Exhibit “SG-21” shows copies of sample invoices issued to various cosmetic and fragrance retailers in Hong Kong including Vance Trading Limited, Far East Beauty Products Limited and Sa Sa International Holdings Limited for the period from 1993 to 2003. Such fragrances were also promoted in newspapers and magazines circulated in Hong Kong such as Apple Daily, Ming Pao Weekly, East Touch, Hong Kong iMail, Eve 夏娃, Eve Essentials, Sing Tao Daily in the period from 2000 to 2002. Taking the evidence as a whole, I find that the opponent had established goodwill or reputation in the Hong Kong market by virtue of its use of the mark “ICEBERG” in respect of fragrances as well at the relevant date.



The trade mark “ICEJEANS”

14. Mr. Wong submitted that the “ICEJEANS” brand of clothing and fashion accessories were first distributed in Hong Kong in 2000 which were available in Hong Kong through, *inter alia*, Lane Crawford Department Stores and the Swank Shop (paragraph 38 of Gerani’s statutory declaration). Hong Kong sales figures for the opponent’s goods sold under the “ICEJEANS” mark are stated in paragraph 42 of Gerani’s statutory declaration. However, notwithstanding the opponent’s own assertion that the “ICEJEANS” brand clothing and fashion accessories were first distributed in Hong Kong in 2000, the sales figures given in paragraph 42 of Gerani’s statutory declaration, strangely, date back to 1998. Therefore, it casts doubts on the sales figures as to whether those figures include the sale of the opponent’s goods bearing marks other than the mark “ICEJEANS”. I cannot find any clue or explanation to this discrepancy in the opponent’s evidence. Sales invoices issued from the opponent to the Hong Kong distributors bearing the words “ICE jeans” and “ICE JEANS” in relation to clothing and fashion accessories for the years 1999 to 2003 were produced in the exhibits “SG-28” to “SG-32” to Gerani’s statutory declaration.

15. Exhibit “SG-33” is said to consist of “sample wholesale invoices marked with product numbers, and extracts from the corresponding product catalogues for the Autumn/Winter 2002 to Spring/Summer 2003 Collections to illustrate and confirm that the sample wholesale invoices attached under exhibits “SG-28 to SG-32” all


relate to the opponent's trademarked goods". When the evidence in exhibit "SG-33" is considered in conjunction with that from "SG-28" to "SG-32", I accept that some of the invoices in exhibits "SG-28 to SG-32" are in relation to the opponent's clothing and fashion accessories goods bearing the mark "ICE JEANS" and the mark "Ice JEANS ICEBERG" in the following format :



16. Sample magazine and newspaper advertisements circulated in Hong Kong before the relevant date including, for example, the South China Morning Post, B International, Hong Kong Tatler, Elle are attached to exhibit "SG-36". A very large proportion of the advertising materials in "SG-36" concerns the mark "ICEBERG", with only a very small portion (altogether three pages without dates) relating to the mark "  ". From the 2001 – 2003 brochures for the "ICE JEANS" collection produced in exhibit "SG-40", whilst I can find isolated pieces of photographs of men's and women's clothing bearing the mark "ICE JEANS" on their own without the mark "ICEBERG" underneath it, all the covers of the brochures feature the mark "  ".

17. On the evidence, it seems clear to me that the opponent's "ICEBERG" mark first entered the Hong Kong clothing market in as early as 1976. It is twenty four years after the first use of the "ICEBERG" mark in Hong Kong that the opponent's another line of clothing items was introduced in Hong Kong in 2000, four years prior to the relevant date. The connection with ICEBERG can clearly be discerned by the fact that for most of the time, "ICE JEANS" is invariably used and marketed in conjunction with "ICEBERG". Moreover, as pointed out by Mr Gerani in paragraph 38 of his statutory declaration, the opponent's "ICEBERG" products and other "ICE-" collections (I can only identify "ICE JEANS ICEBERG" on the evidence) are distributed in the same retail shops in Hong Kong including the Lane Crawford Department Stores and the Swank Shop.

18. When the evidence is assessed as a whole, I am satisfied that the

opponent had established a goodwill or reputation to a rather modest degree in the Hong Kong market by virtue of use of the mark  in respect of clothing and fashion accessories at the relevant date.

The trade mark “ICEBERG PELLETTARIA”

19. Mr Wong submitted that “ICEBERG PELLETTARIA (meaning leatherwear in Italian)” leatherwear collection was created in or about 1992. The new line was available in major fashion capitals including Hong Kong (paragraph 11 of Gerani’s statutory declaration). Exhibit “SG-9” contains copies of sample advertisements in relation to this mark. Mr Wong submitted that this is about all the evidence that the opponent is able to produce in relation to the alleged use of the mark in Hong Kong for leather goods. In my view, paragraph 11 is merely a bare assertion made by Mr Gerani without any concrete evidence in support. No sales and advertising figures in relation to the mark are given in the statutory declaration. Neither have relevant sales invoices and advertising materials been adduced. Most of the advertising materials in “SG-9” are in Japanese which I suppose are extracted from Japanese magazines which were not circulated in Hong Kong before the relevant date. I do not find that the opponent enjoyed any goodwill or reputation in Hong Kong through use of this mark in respect of leather goods at the relevant date.

The trade marks “ICEBERG DONNA”, “ICEBERG UOMO” and “ICEBERG HISTORY”

20. No sales and advertising figures in Hong Kong in relation to the three marks are provided in the opponent’s evidence. There is not one single piece of advertisement circulated in Hong Kong as produced in the exhibits “SG-26” and “SG-36” which shows use of any of the three marks in Hong Kong.

21. I have not overlooked that some of the invoices in the exhibits “SG-28” to “SG-32” bear the words “ICEBERG DONNA”, “ICEBERG UOMO”, “ICE JEANS ICEBERG UOMO” and “ICEBERG HISTORY”. As regards the marks “ICEBERG DONNA” and “ICEBERG UOMO”, as pointed out in paragraph 49 of Gerani’s statutory declaration, the word “Donna” means “women” (in Italian) and “ICEBERG DONNA” is a women collection. The word “UOMO” means “men” (in Italian) and “ICEBERG UOMO” is a collection for men. Furthermore, it appears that the words “ICEBERG DONNA” and “ICEBERG UOMO” appear under the

items “DESCRIZIONE” (meaning “description” in Italian) or “COMPOSIZIONE” (meaning “composition” in Italian) in the invoices. It is unclear whether the words “ICEBERG DONNA”, “ICEBERG UOMO” and “ICE JEANS ICEBERG UOMO” appearing in the invoices refer to men’s and women’s collections under the mark “ICEBERG” or “ICE JEANS ICEBERG” rather than being trade marks on their own.

22. Mr Gerani says in paragraph 50 in his statutory declaration that “exhibit SG-33 consists of sample wholesale invoices marked with product numbers, and extracts from the corresponding product catalogues for the Autumn/Winter 2002 to Spring/Summer 2003 collections to illustrate and confirm that the sample wholesale invoices attached under Exhibits SG-28 to 32 all relate to the Opponent’s trademarked goods”. However, neither “ICEBERG DONNA”, “ICEBERG UOMO” nor “ICEBERG HISTORY” is depicted in any of the product catalogues contained in exhibit “SG-33”.


23. Taking a fair appraisal of all the opponent’s evidence, I do not feel myself able to conclude that at the relevant date, the opponent had established a goodwill or reputation in the Hong Kong market through the use of the marks “ICEBERG DONNA”, “ICEBERG UOMO” and “ICEBERG HISTORY” in respect of any goods or services.

24. On the whole, I do not find the opponent’s reliance on the “ICE” family of marks founded on any basis. In fact, if there is any common feature which can be discerned from the family of marks as alleged, the common feature should be “ICEBERG” rather than “ICE”. In any case, the “series” objection is primarily founded upon user. Paragraph 17-046 of *Kerly’s Law of Trade Marks and Trade Names*, the 14th Edition, states as follows :

“Where there are a “series” of marks, registered or unregistered, but in use, having a common feature or a common syllable and where all the marks in such a series belong to an opponent, these are generally circumstances adverse to an applicant for a mark containing the common feature, since the public might think that such a mark indicated goods coming from the same source ... **If the marks in a series ... are not shown to be in use and so known to the public, the above considerations do not apply ...**” (emphasis added)

25. In *Il Ponte Finanziaria SpA v. OHIM* (C-234/06 P) [2008] E.T.M.R. 13, the European Court of Justice observed at paragraph 64 of the judgment that :

“No consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or series, to detect a common element in such a family or series and/or associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a “family” or “series”, the earlier trade marks which are part of that “family” or “series” must be present on the market.”

26. As analysed above, the opponent’s evidence does not demonstrate that the alleged family of marks comprising “ICEBERG UOMO”, “ICEBERG DONNA” and “ICEBERG HISTORY” were present on the Hong Kong market at the relevant date. Therefore, the issue boils down to merely a comparison between the applied for marks and the marks “ICEBERG” and “” in relation to which the opponent has established goodwill and reputation in Hong Kong at the relevant date.


27. I shall first compare the suit marks with the opponent’s mark “ICEBERG”. Although “ICEBERG” is a commonly known English word, it is not descriptive of the opponent’s goods. It has a high degree of inherent distinctiveness. The suit marks in series comprise the words “ICE HOUSE FUR” in different scripts. As the word “FUR” is descriptive of the goods or services in relation to fur covered by the specifications of the suit marks, the most distinctive and dominant components in the suit marks must be the words “ICE HOUSE”.

28. Conceptually, according to *Collins English Dictionary*, the Millennium Edition, the term “ice house” as a whole means “a building for storing ice”. The opponent’s mark “ICEBERG” is also a dictionary word meaning “a large mass of ice floating in the sea, esp. a mass that has broken off a polar glacier”. To my mind, the respective marks have their own meanings and are conceptually distinct from one another.

29. Turning to a visual comparison, “ICE HOUSE FUR” is a three-word mark whereas “ICEBERG” is a single word mark of shorter length. Their appearances are different on first impression. The only visual similarity between “ICE HOUSE FUR” and “ICEBERG” lies in the identity of the word “ICE” with the first three letters of “ICEBERG”. Speaking for myself, this is a very slight similarity given that all the other elements in the marks do not look alike to any extent. On the

whole, I do not consider the marks visually similar.

30. Aurally speaking, the first syllables of the marks are the same pronouncing as the word “ICE”. However, the other components of the marks comprising “HOUSE FUR” and “BERG” produce entirely different sounds. Overall, I do not find the marks phonetically similar.

31. I now move on to compare the suit marks and mark “”. I have found above that the words “ICE HOUSE” are the most distinctive and dominant components in the suit marks. Similarly, in relation to the opponent’s mark, as the word “JEANS” is descriptive of the opponent’s goods, the most distinctive and dominant components in the opponent’s mark are the words “ICE ICEBERG”. As mentioned earlier on, “ICEBERG” essentially means “a large mass of ice floating in the sea”. “ICE” is a commonly known word referring to “water in the solid state”. To my mind, “ICE” and “ICEBERG” do share an apparent conceptual link. The opponent’s mark in essence refers to “ice or ice mass”. To recap, “ICE HOUSE” means “a building for storing ice”. As such, the respective marks do, in my view, convey different meanings and are conceptually distinguishable.

32. So far as visual comparison is concerned, both the respective marks comprise three English words with the first word “ICE” being identical. However, as a whole, the visual impact given by the marks is different as there are marked differences in the other elements of the marks. The overall representation of the marks is also different. The words in the suit marks are more or less of the same size whereas the words “ICE JEANS” in the opponent’s mark are of much larger size than the word “ICEBERG” underneath them.

33. Phonetically, I consider that the sharing of the common first word “ICE” only gives a very low degree of aural similarity between the marks. With the addition of the words “HOUSE FUR” to the suit marks and “JEANS ICEBERG” to the opponent’s mark, they do as a whole sound differently from one another.

34. In the light of the foregoing, I am not satisfied that the public would likely be confused into believing that goods and services bearing the suit marks offered by the applicant are goods or services of the opponent, or in some way connected with or guaranteed by the opponent. The element of misrepresentation is therefore not made out. It follows that there is nothing from which it could be

inferred that the opponent is likely to suffer damage by reason of any erroneous belief engendered by the applicant's misrepresentation.

35. The opposition under section 12(5) therefore fails.

Opposition under section 12(3) of the Ordinance

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

“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.”

37. 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.



38. 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 First Council Directive 89/104 of 21 December 1988 of the Council of the European Communities. In determining the issue under section 12(3), I take into account the guidance provided by the European Court of Justice (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.

39. Section 12(3) 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. I must

therefore consider whether there are similarities between the subject mark and the Opponent's marks and the goods and services covered, and whether they would combine to create a likelihood of confusion.

40. The likelihood of confusion is to be assessed globally, taking into account all factors relevant to the circumstances of the case.

41. The opponent relies on the following registered marks as earlier trade marks for the opposition under section 12(3) :

Trade Mark	Registration No.	Date of Registration	Class	Goods
	2369 of 1991	1.8.1989	18	leather and imitations of leather and goods made of these materials not included in other classes; bags, trunks and travelling bags; cases, suit-cases and wallets all included in Class 18
	2372 of 1991	1.8.1989	25	clothing, footwear, headgear; all being used in sports
<p data-bbox="220 1467 469 1579">ICE</p>	11714 of 1997	18.11.1996	18	leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; handbags, wallets; umbrellas, parasols and walking sticks; whips, harness and saddlery

42. Each of the above opponent's registered trade marks has a date of the application for registration earlier than that of the suit marks. According to section 5(1)(a) of the Ordinance, all the opponent's marks are earlier trade marks in relation to the suit marks.

The opponent's earlier marks of registration nos. 2369 and 2372 of 1991

43. I shall first consider the opponent's marks of registration nos. 2369 and 2372 of 1991. Both registrations concern the same mark but one is in respect of class 18 and another in class 25.

Comparison of goods and services

44. 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 (as he then was) 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.

45. It is also stated in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, at paragraph 23, that 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.

46. I consider the opponent's class 25 goods "clothing, footwear, headgear; all being used in sports" are identical to the applicant's class 25 goods which include "clothing, footwear, headgear" under application. The opponent's class 25 goods are similar to the various retailing services in relation to clothing, footwear and headgear and the service of dressmaking covered by the applicant's applied for services in classes 35 and 40 respectively.

47. However, in my view, I do not find the opponent's class 25 goods similar to the applicant's applied for services in classes 37, 39 and 40 which are specifically in relation to the storage, cleaning, repair, processing and maintenance of fur services and the service of clothing alteration. The opponent's class 25 clothing, footwear and headgear are all being used in sports. Applying the tests in *British Sugar*, it seems clear to me that the respective uses of the applicant's services and the opponent's goods are different. Although both the consumers of the opponent's class 25 sports clothing, headgear and footwear and the applicant's services may include members of the general public, they are likely to involve different segments of the public who have different needs. For the fur services in class 40, the consumers may include specialised fur manufacturers as well. I also do not find the nature of the goods and services similar. The applicant's services and the opponent's class 25 goods are not provided through the same trade channels. Neither are they complementary that there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking (*Sergio Rossi SpA v OHIM* (case T-169/03), Court of First Instance of the European Communities).

48. Turning to the opponent's class 18 goods, according to *El Corte Ingles SA v OHIM* [2007] ETMR 81, the Court of First Instance of the European Communities observed that when the similarity between class 25 and class 18 goods is considered, a distinction must be made between different types of goods within class 18. It was held that regarding "leather and imitations of leather, animal skins,

hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery”, they should not be similar to the class 25 goods. The distribution channels between the aforesaid class 18 goods are different from those used for the distribution of goods in class 25. The fact that these two categories of goods may be sold at the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin.

49. However, in relation to goods made of leather and imitations of leather not included in other classes such as, for example, handbags, purses or wallets, the Court of First Instance noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. There is a slight similarity between these goods in classes 18 and 25. Furthermore, the Court found that “it is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods.” Hence, clothing, footwear and headgear in class 25 show a degree of similarity with the clothing accessories included in “goods made of leather and imitations of leather materials not included in other classes” in class 18 which cannot be classified as slight.

50. Applying the same reasoning, I consider that the opponent’s class 18 goods including “leather and imitations of leather, bags, trunks and travelling bags; cases, suit-cases” not similar to the applicant’s applied for goods and services. On the other hand, I find that “goods made of leather and imitations of leather not included in other classes and wallets” covered by the opponent’s registration in class 18 similar from a slight to moderate degree to the applicant’s applied for goods and services in classes 25 and 35 but not similar to classes 37, 39 and 40 services.

Comparison between the suit marks and the opponent’s earlier marks of registration nos. 2369 and 2372 of 1991

51. The suit marks in series are pure word marks comprising the words “ICE HOUSE FUR”. The opponent’s marks are composite marks consisting of the words “SPORT ICE” and devices of icebergs floating in the sea together with a polar bear.

52. Visually speaking, in my view, there cannot be any serious argument that the suit marks and the opponent's marks look similar. As the word "SPORT" in the opponent's marks is descriptive of the goods in classes 18 and 25, the dominant element in the opponent's marks is the word "ICE". The devices of icebergs floating in the sea together with the polar bear reinforce the concept of "ice". I consider that the conceptual meanings of "ICE HOUSE" and "ICE" as identified in paragraphs 28 and 31 above are distinguishable. Aurally, the reference to "ICE HOUSE" is different from "SPORT ICE" or "ICE". I do not conclude that the respective marks are similar.

53. 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 and services applied for who is deemed to be reasonably well-informed and reasonably observant and circumspect.

54. Having considered all the above relevant factors, I find that when the suit marks are used in relation to the applied for goods and services, the average consumers would not be confused into thinking that those goods and services and the opponent's classes 18 and 25 goods come from the same or economically-linked undertaking.

The opponent's earlier mark of registration no. 11714 of 1997

55. The registration is in respect of the mark "ICE" for class 18 goods.

Comparison of goods and services

56. As analysed above, I take the view that the opponent's class 18 goods including "leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery" not similar to the applicant's applied for goods and services. There is a slight to moderate degree of similarity between the opponent's class 18 goods including "goods made of leather and imitations of leather not included in other classes, handbags and wallets" and the applicant's class 25 goods and class 35 services. There is no similarity between the opponent's class 18 goods and the applicant's services in classes 37, 39 and 40.

Comparison between the suit marks and the opponent's earlier mark of registration no. 11714 of 1997

57. Both the suit marks and the opponent's mark are word marks. The opponent's mark comprises the single word "ICE" whereas the suit marks in series comprise the three words "ICE HOUSE FUR". Although the word "ICE" is a commonly known dictionary word, it is not descriptive of the class 18 goods and enjoys a reasonably high degree of inherent distinctiveness. As I have found above, the most distinctive and dominant components in the suit marks are the words "ICE HOUSE".


58. So far as conceptual comparison is concerned, notwithstanding the opponent's mark "ICE" is fully incorporated in the suit marks, I consider that the meanings conveyed by "ICE" and "ICE HOUSE" are distinct and clearly distinguishable. The respective marks have clearly different specific meanings which the potential purchasers can grasp immediately on first impression.

59. Aurally, to my mind, with the addition of the word "HOUSE" or the words "HOUSE FUR" to the suit marks, there is a substantial phonetical difference between the suit marks and the opponent's mark "ICE".

60. Visually, the opponent's mark is a compact mark of very short length. The suit marks comprising three words are much longer. Although the respective marks share the same first word "ICE", they do not look similar as a whole.

61. Having considered all the above relevant factors, I find that when the suit marks are used in relation to the applied for goods and services, the average consumers would not be confused into thinking that those goods and services and the opponent's class 18 goods come from the same or economically-linked undertaking.

The opponent's earlier mark of registration no. 495AA of 1999

62. The registration is in respect of the mark "  " for classes 18 and 25 goods.

Comparison of goods and services

63. Applying the same reasoning above, I am of the opinion that the

opponent's class 18 goods "luggage, trunks, travelling bags, umbrellas, parasols, walking sticks, key holders; belts made of leather" are not similar to the applicant's applied for goods and services. Only the item "purses" is slightly similar to the applicant's applied for goods and services in classes 25 and 35 so far as clothing, footwear, headgear and retailing of them are in issue. Turning to the opponent's class 25 goods under the registration, it seems to me that they are identical or similar to the applicant's class 25 goods and classes 35 and 40 (only dressmaking is concerned) services. The opponent's classes 18 and 25 goods bear no similarity to the applicant's services in classes 37, 39 and 40 (excluding dressmaking).

Comparison between the suit mark and the opponent's earlier mark of registration no. 495AA of 1999

64. The suit marks in series consist of the words "ICE HOUSE FUR" whereas the opponent's mark comprises the words "HISTORY ICEBERG". It seems clear to me that the marks are not similar to one another no matter from the visual, conceptual or aural perspective.

65. Having a global appreciation of all the relevant factors, I conclude that there is no likelihood of confusion in respect of the applied for goods and services. The relevant consumers would not be led into believing that the respective goods and services of the parties originate from the same or economically-linked undertaking.

The opponent's earlier mark of registration no. 14598AA of 2003

66. The registration is in respect of the mark "ICE ICE ICEBERG" for classes 18 and 25 goods.

Comparison of goods and services

67. Similarly, I consider that the opponent's class 18 goods including "leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols, saddlery" are not similar to the applicant's applied for goods and services. However, I find "goods made of leather and imitations of leather not included in other classes" which could cover handbags, purses and wallets slightly to moderately similar to the applicant's applied for goods and services in classes 25 and 35 so far as clothing, headgear and footwear and the retailing of them are in question. With respect to the opponent's class 25 goods, they are identical or similar to the

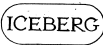
goods and services in classes 25, 35 and dressmaking services in class 40 but they are not similar to classes 37, 39 and 40 (excluding dressmaking) services.

Comparison between the suit mark and the opponent's earlier mark of registration no. 14598AA of 2003

68. Both the suit marks and the opponent's mark are three-word marks. There is a certain degree of visual and phonetical similarity between the marks because of the incorporation of the word "ICE" in them. Nevertheless, I consider that the similarity is at a very low level. Conceptually, "ICE" and "ICEBERG" convey different meanings from "ICE HOUSE FUR" or "ICE HOUSE". Visually, apart from the word "ICE", the overall appearances of the respective marks do not look similar to me. Aurally, the respective marks share the same first syllable "ICE". However, the differences in the other syllables of the marks render the overall pronunciations of them dissimilar.

69. Taking into account of all the relevant factors, I conclude that when the suit marks are used in relation to the applied for goods and services, the average consumers would not be confused into thinking that those goods and services and the opponent's classes 18 and 25 goods emanate from the same or economically-linked undertaking and thus there is no likelihood of confusion.

The opponent's earlier mark of registration no. 1386AA of 1996

70. The registration is in respect of the mark "  " for "clothing, headgear" in class 25.

Comparison of goods and services

71. I take the view that the opponent's class 25 goods are identical or similar to the applicant's goods in class 25 and services in classes 35 and 40 (so far as dressmaking is concerned). However, there is no similarity to the applicant's remaining services in class 40. Nor is there any similarity to the applicant's classes 37 and 39 services.

Comparison of the suit marks and the opponent's earlier mark of registration no. 1386AA of 1996

72. As I have found in paragraph 27 above, the opponent's mark "ICEBERG" is inherently distinctive of the opponent's goods. I have also analysed the opponent's evidence of use in paragraph 12. On the evidence, I find that through the use that has been made of the opponent's mark "ICEBERG" in Hong Kong before the application date in relation to clothing and fashion accessories, the distinctiveness of the opponent's mark has enhanced.

73. I have compared the respective marks in paragraphs 27 to 30 above. The same reasoning is adopted here and I do not find them similar.

74. Having taken into account all the above relevant considerations, I find that when the suit marks are used in relation to the applied for goods and services, the average consumers would not be confused into thinking that those goods and services and the opponent's class 25 goods come from the same or economically-linked undertaking.

75. The opposition under section 12(3) therefore fails.

Opposition under section 12(4)

76. Section 12(4) of the Ordinance provides as follows :

"... 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."

77. To succeed under section 12(4), the Opponent has to establish at least the

following :

- (a) that the suit marks are identical or similar to the opponent's marks;
- (b) that the opponent's marks are entitled to protection under the Paris Convention as well-known trade marks; and
- (c) the use of the suit marks without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponent's marks.

78. Under this ground of opposition, the opponent relies on the same marks as those for the ground of opposition under section 12(5)(a) including "ICEBERG", "ICE JEANS", "ICEBERG PELLETERIA", "ICEBERG DONNA", "ICEBERG UOMO" and "ICEBERG HISTORY".

79. I have already found that the suit marks are not similar to the opponent's marks "ICEBERG", "ICE JEANS ICEBERG", "ICE" and "HISTORY ICEBERG". Applying the same reasoning, I do not consider any of the marks relied on by the opponent similar to the suit marks when the whole marks are considered. The degree of similarity between them is very low. I am therefore not satisfied that the degree of similarity is sufficient to have the effect that the relevant consumers would establish a link between those marks and the suit marks. I do not find the requirement under paragraph 77(a) above established.

80. I refer to the requirement referred to in paragraph 77(c). Section 12(4) does not have the sweeping effect of preventing the registration of a sign which is the same as or similar to a well-known earlier trade mark. It is also not intended to enable the owner of a well-known earlier trade mark to object as a matter of course to the registration or use of a sign which may remind people of his mark (*Premier Brands v Typhoon* [2000] F.S.R. 767). Detriment to and unfair advantage of distinctive character or repute must be provable by real, as opposed to theoretical, evidence and cannot be merely assumed from the fact that the earlier mark has a substantial reputation (*Creditmaster Trade Mark* [2005] R.P.C. 21).

81. The closer the similarity between the marks, the greater is the risk that unfair advantage will be taken (*Kerly's Law of Trade Marks and Trade Names*, 14th edition, para. 9-114B).

82. The opponent has not filed any evidence to support its claim that use of the suit marks would take unfair advantage of, or be detrimental to, the distinctive character or repute of any of the opponent's marks.

83. I find the opposition under section 12(4) of the Ordinance not established.

Opposition under section 11(5)(b)

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

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

(a)

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

85. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367, Lindsay J. said at page 379:

“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.”

86. 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).

87. In the present case, Mr Wong submitted that the opponent has been using the opponent's marks since the 1970s. The applicant has not denied its knowledge of the opponent's marks and the opponent's products. In any event, it would be most

unlikely for the applicant not to have heard of the opponent's marks given the enormous reputation and user enjoyed by the opponent in respect of the opponent's marks. The suit marks are confusingly similar to the opponent's marks. However, the applicant has never explained how the subject marks came into existence. Given the enormous reputation enjoyed by the opponent in the opponent's marks and the similarity between the subject marks and the opponent's marks, the Registrar is entitled to infer that the suit marks were copied from the opponent's marks in the absence of any evidence as to how the suit marks came into existence. Further or in the alternative, the applicant intends to mislead the public into believing that its products are originated from or somehow associated with the opponent so as to ride on the reputation enjoyed by the opponent in the opponent's marks. Mr Wong therefore contended that the subject application was made in bad faith.

88. In my view, bad faith on the part of the applicant is not distinctively proved in this case. Nor are there any materials before me from which I could draw any inference that the application was made in bad faith. As I have earlier found that the suit marks are not similar to any of the opponent's marks, even if the applicant had known about the opponent's marks before the application date, the applicant's application for registration of the suit marks cannot be considered to have been made in bad faith according to the standards of commercial behaviour observed by reasonable and experienced men in the trade.

89. The ground of opposition under section 11(5)(b) is therefore not made out.

Opposition under sections 11(1)(b) and (11)(1)(c) of the Ordinance

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

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

- (a);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or

rendering of services, or other characteristics of goods or services; and

(d)”

91. Mr Wong submitted that the suit marks are descriptive in the sense that “FUR” and related goods are sold, distributed, cleaned or stored in an “ICE HOUSE”. With the hot and humid weather in Hong Kong, storage, cleaning and care of fur related goods require special treatment and handling. These goods need to be stored and handled at locations with freezers where the temperature is controlled at a sufficiently low level. The subject application covers, *inter alia*, “fur care, cleaning and repair” in class 37, “storage of furs and fur clothing” in class 39 and “custom fashioning of fur; fur conditioning; fur dyeing; fur glossing; fur mothproofing; fur satining” in class 40. The words “ICE HOUSE” are in the context descriptive in that the applicant’s goods are stored and handled at “ICE HOUSE” (meaning a place which is cool), and the applicant provides storages and care services which are suitable for fur and related goods.

92. In my judgment, as identified above, the term “ICE HOUSE” has its own dictionary meaning referring to “a house which stores ice”. I do not find the mark “ICE HOUSE FUR” as a whole is descriptive of the goods and services in the manner as argued by Mr Wong.

93. Mr Wong has not made any submissions for the opposition under section 11(1)(b). To my mind, the suit marks are not devoid of distinctive character and it is clear to me that they can denote trade origin.

94. The opposition under sections 11(1)(b) and 11(1)(c) of the Ordinance therefore fails.

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

95. Section 11(4) of the Ordinance provides as follows :

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

(a);

(b) likely to deceive the public.”

96. Mr Wong pointed out that the opposition under this section is only related to those applied for goods and services which are not fur related in classes 25, 35 and 40. The opposition does not apply to the applied for services in classes 37 and 39 which are exclusively related to fur.

97. Mr Wong submitted that the suit marks are deceptive as the applicant's goods do not solely consist of or substantially consist of fur products, but consisting of goods which are not made of fur or not substantially made of fur. Under this ground of objection, Mr Wong contended that the suit marks are deceptive when used in relation to items which are not made of fur and these include faux (fake) fur. Use and registration of the suit marks "ICE HOUSE FUR" on goods not made of fur or not substantially made of fur is likely to deceive the public. As such, the scope of the goods in respect of which the suit marks are sought to be registered shall be properly limited or qualified. In the absence of such qualification, some of the goods and services, for example, clothing, headgear and footwear not mainly made of fur, shall be refused registration unless certain qualification is included.

98. In my judgment, the opposition is based on an absolute ground for refusal which is concerned with deceptiveness inherent in the mark itself. Whether a mark as a whole is deceptive must be considered against the goods and services applied for and in the general context of the relevant trade. If a mark gives rise to a real expectation which will not be fulfilled, then registration will be refused. The expectation must be a real one, as opposed to something obscure or fanciful (*Kerly's*, supra, paras 8-203 and 8-204). What is alleged to be misleading has to be sufficiently serious and likely to affect the economic behaviour of the public. The relevant public is the consumer who is reasonably observant and circumspect and thus sufficiently alert and sensible such as not to need protection from claims that might only deceive a relatively small number of customers. I have to decide whether there is anything inherent within the suit marks that would cause a number of persons to entertain a serious possibility that there is a real expectation which will not be fulfilled (*Smirnoff TM* [2006] RPC 16 at 473).

99. What I am concerned with is not so much what the word "FUR" means but whether the suit marks "ICE HOUSE FUR" as a whole by reason of the presence in them of the single word "FUR" are likely to deceive in relation to the goods sold and services provided under the marks. In my view, upon seeing the suit marks being applied to clothing, footwear and headgear and the retailing services thereof, the dressmaking and clothing alteration services, the relevant public would not expect that

all the relevant goods or the subject matter in relation to the provision of the services are made of fur. Nowadays, I think it is not uncommon for the manufacturers in the trade to produce both fur clothing and other types of clothing under the same mark. One would also expect that a retailing shop with the mark “ICE HOUSE FUR” will sell other clothing, footwear and headgear products apart from products made of or substantially made of fur. I do not find that there is any real expectation that will not be fulfilled.

100. The opposition under section 11(4)(b) hence fails.

Opposition under section 11(5)(a)

101. Section 11(5) 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; or

(b)”

102. Paragraph 16 of the amended grounds of opposition pleads that the use of the suit marks “ICE HOUSE FUR” on goods not made of fur or not substantially made of fur is prohibited in Hong Kong under the Trade Descriptions Ordinance Cap. 362, and therefore the application should be refused by virtue of section 11(5)(a) of the Ordinance.

103. The opponent has not pleaded any specific section or sections of the Trade Descriptions Ordinance which the opponent considers that the use of the suit marks is prohibited. At the hearing, Mr Wong has not made any submissions in this regard apart from repeating what is stated in the amended grounds of opposition.

104. In the circumstances, I do not find that the opposition under this section is made out by the opponent.

Costs

105. The applicant has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the

successful party is entitled to its costs. I accordingly order that the opponent pays the costs of these proceedings.

106. 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.

Original signed

(Ms Fanny Pang)
p. Registrar of Trade Marks
26 April 2010