

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO.: 300296163AC



MARK:

CLASS:


3

APPLICANT:

Le Tigre, LLC

STATEMENT OF REASONS FOR DECISIONS

Background

1. This is an application of Le Tigre, LLC (the “applicant”) made on 5 October 2004 to register the mark “ *Le TIGRE*” under the Trade Marks Ordinance (Cap. 559)(the “Ordinance”). Registration is sought in class 3 in respect of cosmetics, perfumes, skin care products, and hair care products. It is a divisional application derived from an application bearing application number 300296163.
2. At the examination stage, objections were raised against the subject application under section 12(3) of the Ordinance on the basis of the marks reproduced immediately below (each an “cited mark” and collectively, the “cited marks”)—



(1)

Registration No.: 200203176 (the first cited mark)



(2)

Registration No.: 200203179 (the second cited mark)

3. Both cited marks are registered in the name of Haw Par Corporation Limited with a date of registration on 4 June 2001, in respect of “non-medicated bath salts; non-medicated bath capsules and tablets; non-medicated bath capsules and tablets in the form of bath crystals; incenses; non-medicated ointments; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices”.
4. On 27 December 2006, the applicant requested a hearing on the registrability of the subject mark. Accordingly, a hearing was scheduled to take place on 12 June 2007. Although the applicant filed notice of its intention to appear at the hearing by way of a Form T12, the applicant did not finally appear at the hearing. Prior to the scheduled hearing date, Messrs. Deacons, the applicant’s solicitors, filed written submissions in support of the subject application for registration.
5. The applicant did not file any evidence of honest concurrent use of the subject mark and the earlier marks under section 13 of the Ordinance.

The Ordinance

6. The relative grounds for refusal of an application for registration are set out in section 12 of the Ordinance. Section 12(3) provides that—

“A trade mark shall not be registered if-

 - (a) the trade mark is similar to an earlier trade mark;
 - (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and
 - (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”
7. Section 7(1) of the Ordinance provides that—

“For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.”
8. The term “earlier trade mark” is defined in section 5 of the Ordinance. Section 5(1) of the Ordinance stipulates that—

“In this Ordinance, “earlier trade mark”, 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 account the priorities claimed in respect of each trade mark, if any...”

Decision

9. The issue before me is whether the subject application for registration should be refused under section 12(3) based on the cited marks.
10. As set out in paragraph 2 above, both cited marks have their dates of application for registration earlier than that of the subject mark. Therefore, they are “earlier trade marks” with respect to the subject mark for the purpose of section 5 of the Ordinance.
11. Section 12(3) precludes a mark from registration if the use of it is likely to cause confusion on the part of the public, as a result of its being similar to an earlier trade mark and that it is sought to be registered in respect of goods or services the same as or similar to those registered under the earlier trade mark.
12. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994¹, which implements Article 4(1)(b) of the European Trade Marks Directive². In interpreting the said Article 4(1)(b), the European Court of Justice (“ECJ”) has formulated the ‘global appreciation’ test with the relating legal principles laid down in various ECJ’s decisions, including *Sabel BV v Puma* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [1999] E.T.M.R. 690 and *Marca Mode CV v*

¹ Section 5(2) of the UK Trade Marks Act 1994 provides that –

“A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

² Article 4 of the European Trade Marks Directive 89/104/EEC of 21 December 1988 provides that –

“(1) A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

... (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Adidas AG and Adidas Benelux BV [2000] E.T.M.R. 723. The relevant legal principles are summarized as follows.

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

economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

13. Having regard to the above legal principles, I will now proceed to consider whether and to what extent the subject mark and the cited marks are similar, whether and to what extent the respective goods are similar, and whether the net effect of the similarities (if any) taken together results in a likelihood of confusion on the part of the public for the purpose of section 12(3). In assessing the likelihood of confusion, according to section 7(1) of the Ordinance, the Registrar may take into account all factors relevant in the circumstances.

Comparison of marks

14. The global appreciation of the visual, aural and conceptual similarities of the marks in question must be based on the *overall impression* given by the marks, bearing in mind, in particular, their distinctive and dominant components.
15. The subject mark consists of a device of a tiger and the words “Le Tigre”. “Le Tigre” are French words meaning “the tiger”.
16. The first cited mark consists of a device of a tiger, the Chinese character “虎” (stylized)(meaning “tiger”), and the word “TIGER”, all enclosed in a circle.
17. The second cited mark consists of the word “TIGER” enclosed in a rectangular border.
18. Considering the first cited mark, which is a composite mark, I find the distinctive and dominant components of it being the word “TIGER” and the stylized character “虎”. The device of a tiger is just a pictorial representation of the textual elements in the mark being the word “tiger” and the character “虎”. The overall impression immediately created by the first cited mark is the word “tiger” and the character “虎” also meaning “tiger”. The enclosing circle is merely a simple border of negligible significance. The word “tiger” and the character “虎” are distinctive and fanciful in respect of the registered goods because they do not designate any characteristics of the registered goods concerned, for example, bath salts, perfumery and cosmetics etc.

19. Similar to the first cited mark, the subject mark is a composite mark also consisting of a tiger device and the words “Le TIGRE”. The words “Le TIGRE” constitute the distinctive and dominant components of the subject mark. The device of a tiger reinforces the impression of the words “Le TIGRE”. I find the overall impression immediately created by the subject mark is the word “TIGRE”.
20. Regarding the second cited mark, the distinctive element of it is the word “TIGER”. The rectangular border is of minimal if not nil significance. Its overall impression is unquestionably the word “tiger”, which is distinctive of the goods covered by it, namely bath salts, perfumery and cosmetics etc.
21. The applicant refers to the word elements in the marks in question and argues that the subject mark is visually and phonetically different from the cited marks in that the words “Tiger” in the cited marks and “Tigre” in the subject mark are spelt and pronounced differently. Also since the subject mark consists of the French words “le tigre”, the applicant contends that consumers seeing the subject mark will immediately perceive it as being of a French origin and will likely think that it is to be used in relation to goods or services originated from France. By contrast, as the first cited mark contains the Chinese character “虎”, the applicant submits that consumers will perceive it as indicating an Asian origin.
22. While I hesitate to think that average consumers would understand the word “le” as meaning “the”, I consider that the French word “Tigre” in the subject mark is highly likely to be understood as “tiger” because it is visually very close and aurally close to the English equivalent “tiger”. It also looks like a misspelt word for “tiger” or a trifling variation of the same. Given also the tiger device and that average consumers do not normally proceed to analyse a mark in its various details, the immediate overall impression of the subject mark left in the mind of average consumers remains to be the word “tiger”. This is the same as the distinctive overall impression projected by the first and second cited marks. The marks are therefore visually and conceptually very similar. Phonetically, both the respective marks will likely be referred to as “tiger”. Even if the subject mark will be referred to as “tigre”, “tiger” and “tigre” still sound strikingly similar. As a whole, I find that the subject mark is substantially similar to the first and second cited marks.

Comparison of goods

23. The factors to be considered in determining the similarities in marks are set out in *British Sugar v James Robertson and Sons Ltd.* [1996] R.P.C. 281 by Mr. Justice Jacob. The factors are —
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of services;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves; and
 - (f) 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.
24. The applicant has made no submission in relation to the similarities in the respective goods concerned.
25. Having regard to the factors in paragraph 24, it is apparent to me that the entire range of the applied-for goods sought to be registered under the subject mark overlap with the goods covered by the cited marks. For instance, cosmetics and perfumes respectively covered under the subject mark and the cited marks are identical goods. Incenses and essential oils under the cited marks are also similar to perfumes under the subject mark. The applied-for skin care products overlap with non-medicated bath salts, non-medicated bath capsules and tablets, non-medicated bath capsules and tablets in the form of bath crystals, non-medicated ointments and soaps under the cited marks. The latter set of goods can be used for skin care purposes. For the applied-for hair care products, they overlap with hair lotions covered by the cited marks. The respective uses and users of the respective goods are highly similar. They may also be purchased through the same trade channel, e.g. specialty shops selling cosmetics, perfumes and skin and hair care products. As the relevant goods are like products, they are competitive to one another. To my mind,

overall, there is a high degree of similarity in the goods concerned.

Likelihood of confusion

26. Confusion in the context of section 12(3) of the Ordinance refers to confusion as to trade origin of the goods and/or services in question. The likelihood of confusion must be assessed globally, with all relevant factors to be taken into account, and the matter is to be judged through the eyes of the average consumers of the goods and/or services in question.
27. In the present case, the relevant average consumers are members of the general purchasing public who are likely to buy everyday products such as the applied-for goods.
28. The subject mark is found to be substantially similar to the cited marks and it is also found that there is an overlap or a high degree of similarity between the applied-for goods and the goods respectively registered under the cited marks. Judging through the eyes of the average consumers, overall, I find that the net effect of the similarities in the marks in question and the similarities between the applied-for goods and the goods respectively covered by the cited marks results in a likelihood of confusion on the part of the public as to the trade origin of their respective goods for the purpose of section 12(3). In other words, I find that consumers are likely to be confused into believing that the goods respectively sold under the subject mark and the cited marks are originating from the same or economically-linked undertakings.

Conclusion

29. In this decision, I have considered all the documents filed by the applicant, together with the written submissions made in respect of the subject application. For the reasons stated above, I find that the subject mark is objectionable under section 12(3) of the Ordinance and I therefore refuse this application under section 42(4)(b) of the Ordinance.

Doreen Wan
For Registrar of Trade Marks
3 December, 2007