

TRADE MARKS ORDINANCE (Cap. 559)
OPPOSITION TO TRADE MARK APPLICATION NO. 300347715

MARK:



CLASS: 35, 39, 45

APPLICANT: CHAN CHUN KUEN

OPPONENT: PALMERSTON LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 31 December 2004, Chan Chun Kuen (the “applicant”) filed an application (the “subject application”) under the Trade Marks Ordinance, Cap. 559 (the “Ordinance”) for registration of the following marks in series:-



(“the suit marks”)

2. Registration is sought in respect of the following services (“subject services”) in Classes 35, 39 and 45:-

Class 35

import-export agency services; direct sale, retail and wholesale services relating to books, magazines, periodicals, newspapers, stationery, office supplies, greeting cards, gifts, houseware products, seasonal decorations; organisation of exhibitions for commercial or advertising purposes; advertising agencies; dissemination of advertising matter; demonstration of goods; distribution of samples and promotional items; sales promotion; professional business consultancy, business management consultancy; education, research and analysis, audio and [video] cd.

Class 39

transport, packaging, distribution, storage of goods; passengers transport; provide travel information and travel arrangement.

Class 45

personal and social services rendered by others to meet the needs of individuals.

3. Particulars of the subject application were published on 18 February 2005. Palmerston Limited (the “opponent”) filed a notice of opposition which includes the grounds of opposition (“Grounds of Opposition”) on 15 July 2005.

4. The opposition hearing took place before me on 28 March 2011. Ms. Helen Tang of Wilkinson & Grist, Solicitors, represented the opponent. The applicant, Mr. Chan Chun Kuen, appeared at the hearing representing himself, with the assistance of Mr. Frederick Woodier acting as an interpreter for him.

Grounds of opposition

5. In the Grounds of Opposition, the opponent opposes registration of the suit marks under sections 3(1), 11(4), 11(5), 12(3), 12(4) and 12(5)(a) of the Ordinance.

Counter-statement

6. The applicant filed a counter-statement on 14 December 2005, denying all the grounds of opposition.

The opponent's evidence

7. The opponent's evidence comprises two statutory declarations of Edith Shih, one dated 14 December 2006 was filed as evidence in support of the opposition ("Shih's first statutory declaration"), the other dated 11 December 2007 was filed as evidence in reply to the applicant's evidence ("Shih's second statutory declaration"). Ms. Shih had been associated with the opponent for over 5 years by the time she made the first statutory declaration, and has been a director of the opponent since 2003. She made the statutory declarations from her own personal knowledge and from the opponent's documents and records to which she had full access.

8. According to Ms. Shih, the opponent is a company incorporated and having its registered office in the Isle of Man. The opponent is a company holding intellectual property rights for the so-called "Hutchison Whampoa Group" ("the HW Group") which comprises Hutchison Whampoa Limited and its related or associated HW Group of companies. It is said that the HW Group has operations in 56 countries and over 220,000 employees worldwide.

9. Ms. Shih alleges that the HW Group has five core businesses, one of which is telecommunications. Hutchison Whampoa Limited started mobile business in 1983 in its home market of Hong Kong, and one of its major telecommunications companies, namely, Hutchison Telecommunications International Limited ("HTIL"), together with its subsidiary Hutchison Telecommunications (Hong Kong) Limited, has been running the 3G services in Hong Kong since 2004. According to Ms Shih, 3G is a new wireless communications category – a third generation of mobile telephone services – that fuses together two of the most powerful technologies, namely, the Internet and mobile telephony, in one device and offers a highly personalized interactive multimedia experience. For the sake of the discussions below, 3G

services means the third generation of mobile telephone services that are offered on the horizon: multi-media, high-speed data access and video-link services which will include such facilities as virtual banking, on-line billing, home shopping, video-conferencing on the move, and internet access; and the provision of 3G services includes the making available of 3G network to customers by subscription and the offering of services, apparatus, instruments and mobile phone accessories for use in connection with such network.

10. It is said that the HW Group holds 3G licences in Australia, Austria, Denmark, Hong Kong, Ireland, Israel, Italy, Norway, Sweden and the United Kingdom and markets its services under the global brand “3”. Hence, “3” is the name under which the HW Group has marketed all of its 3G services worldwide, the total number of 3G subscribers (worldwide) of the HW Group is said to be close to 13.5 million as of 22 November 2006. In Hong Kong, Hutchison Telecommunications (Hong Kong) Limited is the first operator to roll out 3G services under the “3” brand name in January 2004, and was providing 3G, GSM Dualband and CDMA services and GPRS roaming covering for its 2.07 million subscribers in Hong Kong as at 30 April 2006.

11. Ms. Shih alleges that the HW Group adopted the mark “3” as early as July 2002 to promote a wide range of goods and services, particularly telecommunications products and services. But in Shih’s first statutory declaration, not only is the alleged mark “3”, but also apparently all marks of the opponent which have “3” incorporated as an element and being the subject of trade mark registrations were referred to as the “Opponent’s Marks”. It is noteworthy that Ms. Shih did not distinguish between all these marks when she made claims of the substantial and extensive use of the opponent’s marks in Hong Kong in relation to the use, advertising, promotion and marketing of the “Opponent’s Goods and Services”. The term “Opponent’s Goods and Services” is likewise defined in a very broad sense to refer to all goods and services scattered over Classes 9, 16, 28, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45, registered under the “Opponent’s Marks” in various trade marks registries over the world, among them the Hong Kong Trade Marks Registry.

12. Advertising and promotion expenditure for promoting the “Opponent’s Goods and Services” under the “Opponent’s Marks” in Hong Kong from 2004 up to

Sept 2006, as well as the revenue generated, were given in Shih's first statutory declaration in substantial and impressive figures. It is alleged that by virtue of the extensive use, advertising and registration of the "Opponent's Marks", the opponent and the HW Group have been enjoying substantial goodwill and reputation worldwide including Hong Kong in connection with the "Opponent's Marks".

13. The exhibits attached to Shih's first statutory declaration are the following:-

- ES-1 – copies of printout of material from websites www.hutchison-whampoa.com and www.three.com.hk introducing the HW Group and its telecommunications services.
- ES-2 – copies of printout from the search system of the Trade Marks Registry showing a vast number of trade mark applications and registrations in Hong Kong in respect of marks owned by the opponent incorporating "3".
- ES-3 – a list of applications and registrations obtained by the opponent in a number of places of the world in respect of marks incorporating "3", and copies of a random selection of registration certificates.
- ES-4 – copies of evidence showing use, advertising, promotion and marketing of the opponent's goods and services under the opponent's marks in Hong Kong.
- ES-5 – copy of printout from the search system of the Trade Marks Registry showing the subject application.

The applicant's evidence

14. The applicant's evidence comprises a statutory declaration of Chan Chun Kuen dated 11 June 2007 ("Chan's statutory declaration"). Mr. Chan is the applicant himself.

15. According to Mr. Chan, he began operating an import and export business in 1990. This involved seeking potential buyers and sellers via telephone, fax and through the internet, and visiting exhibitions and seminars in order to locate suitable products and conduct promotional activities. The customers of the business were mostly buyers from overseas companies, and the products dealt with included a variety of gifts and household goods. Exhibit "JJ-21" to Chan's statutory declaration provides proof that the applicant participated in the Hong Kong Gifts and Premium Fair 2005 by renting a booth under the brandname "3"; exhibit "JJ-22" shows that the applicant participated in the same exhibit in 2007, but this time he did it through a Lanjie Company owned by him. Photographs of the booth show that the suit marks were displayed there.

16. Mr. Chan alleges that the blueprint for the suit marks came from his Chinese birth date. Exhibit "JJ-2" to Chan's statutory declaration is a copy of Mr. Chan's Hong Kong identity card and a copy extract from a Chinese Millennium Calendar book, thereby showing that Mr. Chan's birth date is, as he alleges, the third day of the Chinese Lunar New Year.

17. The remaining part of Chan's statutory declaration (taking up roughly 16 paragraphs out of the 22 paragraphs of the whole statutory declaration) contains responses and comments on Shih's first statutory declaration, which in the main consists of submissions and allegation of facts about the opponent which, in my view, are not relevant to the consideration of the core issues of the present proceedings. I do not propose to summarize them but would only refer to the relevant parts as and when appropriate.

The opponent's evidence in reply

18. Shih's second statutory declaration was filed under Rule 20(1) of the Trade Marks Rules Cap 559 sub leg (the "Rules") as evidence in reply to the applicant's evidence, namely, Chan's statutory declaration. Similarly I do not propose to summarize Shih's second statutory declaration which purports to be a reply to all that I have categorized as Chan's submissions and allegations that I do not consider to be relevant to the core issues of the present proceedings. I would only refer to the relevant parts of Shih's second statutory declaration as and when appropriate.

Findings on reputation of the opponent's marks

19. As the opponent's opposition is premised substantially on sections 12(3), 12(4) and 12(5)(a) of the Ordinance where any mark of the opponent must be assessed with reference to any enhanced distinctive character, or reputation and goodwill, that it has acquired or generated through use, it is convenient for me to first investigate the evidence and make the relevant findings in this connection before further considering the sections themselves.

20. I have outlined the evidence of the opponent largely at paragraphs 7 to 13 above. On evidence, there is nothing to doubt or dispute about the breadth of the businesses of the HW Group, for which the opponent acts as an intellectual property rights holding company, nor question about the facts that one of the HW Group's core businesses is telecommunications products and services, in particular in respect of the present proceedings, the HW Group's involvements in the provision of 3G services are highlighted, and that the HW Group marketed its 3G services in Hong Kong in as early as January 2004, was providing 3G, GSM Dualband and CDMA services and GPRS roaming covering for its 2.07 million subscribers in Hong Kong as at 30 April 2006.

21. On the other hand, despite the fact that the terms "Opponent's Marks" and "Opponent's Goods and Services" are used so indiscriminately that it cannot be known from the text of Shih's first statutory declaration specifically which mark or

marks had been used by the HW Group in relation to its telecommunications businesses, the evidence in exhibit “ES-4” shows unequivocally that there is one mark, which appeared in various colour combinations but basically in the same shape and form, constituting the main mark used by the HW Group in its telecommunications businesses, in particular in the provision of 3G services. The marks shown below are chosen randomly from some of the exhibited newspaper advertisements in 2004 and 2005, there are other similar marks not shown below but appearing in the materials exhibited at “ES-4” as well, which, in my view, do not differ from one another in any material respects and they have the same distinctive character. I would treat all these similar marks as essentially the same mark and hereinafter refer to any one of them as the “stylized-3 mark”:-



22. The evidence as it was presented in exhibit “ES-4” is composed of various advertisements extracted from local newspapers and magazines, promotional leaflets, magazines published by the HW Group, photos of promotional items and CD-Rom containing video-clips of TV advertisements, spreading between 2004 and 2006. In all these materials, the stylized-3 mark was shown or displayed prominently and independently.

23. The substantive expenditure figures given for advertising, promotion and revenue between 2004 and 2006 were in respect of the “Opponent’s Marks” vis-à-vis the “Opponent’s Goods and Services”, but they could still serve as a guide to the investment and success of the HW Group’s telecommunications businesses. As discussed above, the opponent’s evidence in other respects sufficiently shows that 3G services are offered by the HW Group to the public in Hong Kong by reference to the stylized-3 mark through substantial advertising and promotion since 2004. Taking the opponent’s evidence as a whole, the stylized-3 mark has undeniably acquired a reputation and goodwill in the products and services sold and promoted in connection with the HW Group’s 3G business in Hong Kong, and the HW Group is entitled to

claim for the stylized-3 mark an enhanced degree of distinctive character in respect of its use in the 3G business.

Findings on grounds of oppositions

24. As pleaded by the opponent in the Grounds of Opposition, there are a number of grounds of opposition against the subject application, namely, those under sections 3(1), 11(4), 11(5), 12(3), 12(4) and 12(5)(a) of the Ordinance. Some of the grounds I have difficulty seeing that they are based on tenable basis. I shall first deal with those that could be readily disposed of.

Section 3(1) of the Ordinance

25. Section 3(1) defines a “trade mark” (商標) to mean any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically. Section 11(1)(a) stipulates that signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”) shall not be registered.

26. Under section 11(1)(b), it is provided that trade marks which are devoid of any distinctive character shall not be registered.

27. It is apparent from the opponent’s pleadings and evidence that the basis of its opposition is not that the suit marks are by their nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings, or to put it in another way, devoid of any distinctive character, nor that it cannot be represented graphically. Rather the opponent’s contention seems to be that since the suit marks would cause deception or confusion because of its resemblance to the “Opponent’s Marks”, they are not capable of distinguishing one undertaking from those of others. I do not find section 3(1) a proper avenue for such a contention, hence this ground must fail.

Section 11(5)(a) of the Ordinance

28. Section 11(5)(a) provides that a trade mark shall not be registered if, or to the extent that, its use is prohibited in Hong Kong under or by virtue of any law. The basis for this ground, as pleaded, appears to be that registration of the suit marks in relation to the goods and services covered under the subject application will likely cause public deception and confusion. The opponent has not specifically pointed out how the registration of the suit marks would cause public deception and confusion under the context of the section, however, it appears from the grounds of opposition that this is due to the alleged close resemblance between the suit marks and the “Opponent’s Marks”.

29. I note that section 11(5)(a) is intended to apply where the prohibition by law arises from the mark itself. Moreover, the right place to consider the issue of confusion or deception arising from resemblance between the marks should be section 12(3) or 12(4) in so far as any of the “Opponent’s Marks” constituted earlier trade mark or well known trade mark under the Ordinance, or under 12(5)(a) in so far as the use of the suit marks are prohibited by virtue of the law of passing off. As noted by Kerly’s Law of Trade Marks and Trade Names (“Kerly”), 14th Edition, paragraph 8-212, in discussing section 3(4) of the UK Trade Marks Act 1994 (which is similar to our section 11(5)(a) of the Ordinance) -

“This is an absolute ground for refusal and, as indicated above, is concerned with the trade mark itself. An objection that use of the mark would cause passing off arises under s.5(4)(a) of the 1994 Act [which is similar to our section 12(5)(a) of the Ordinance] and not under this subsection.”

30. This is also consistent with the heading of section 11 of the Ordinance which is entitled “Absolute grounds for refusal of registration” and is to be contrasted with section 12 of the Ordinance which deals with the “relative” rights of the applicant and other parties. In fact the opponent has already pleaded sections 12(3), 12(4) and 12(5)(a) as grounds of opposition. It follows that the ground under section 11(5)(a) must fail.

Sections 11(4)(a) and 11(4)(b) of the Ordinance

31. Section 11(4)(a) provides that a trade mark shall not be registered if it is contrary to accepted principles of morality.

32. Section 11(4)(b) provides that a trade mark shall not be registered if it is likely to deceive the public.

33. Same as the opposition based on section 11(5)(a), the opponent has not specifically pointed out how the registration of the suit marks is contrary to accepted principles of morality, and how it is likely to deceive the public. It just appears that these allegations also stemmed from the alleged fact that the suit marks closely resemble the “Opponent’s Marks”.

34. It has been well established that section 11(4)(b) provides for circumstances where a mark is inherently deceptive when considered in the context of the goods applied for. It is not intended to provide an alternative avenue of attack on relative grounds as provided for in section 12 which deals with the “relative” rights of any parties (see for example *QS by S. Oliver Trade Mark* [1999] R.P.C. 520 at 524; *Ruefach Marketing GmbH’s Application v. Oppositions of Codemarsters Ltd.* [1999] E.T.M.R. 412 at 422-423). Consequently, I can see nothing inherent in the suit marks which would make them open to objection under the terms of section 11(4)(b).

35. Similarly, the opponent has not provided anything that could possibly lead to suggestion that the trade mark contains anything that is contrary to accepted principles of morality. The opponent also fails on the ground under section 11(4)(a).

36. I now turn to the more substantial grounds of opposition based on alleged similarity between the marks in question, the first of which is section 12(3).

Section 12(3) of the Ordinance

37. 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.”

38. 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.

39. 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.

40. In essence, the test under section 12(3) is whether there are similarities in marks and goods or services 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 or services and how they are marketed. I must

compare the marks at 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 or services within their respective specifications. I must do all of this from the standpoint of the average consumer for the goods or services in question.

41. The relevant date is the date the subject application was filed, viz., 31 December 2004.

Earlier trade marks

42. 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.

43. At Annex C of the Grounds of Opposition, the opponent set out a list of trade mark registrations in Hong Kong which it owns and obviously wishes to rely upon as earlier trade marks to launch the opposition. The list runs to 94 pages long and includes a great number of marks, with each specification containing a long list of items of goods or services. I do not think I need to set them all out here, suffice to say that I find the only mark or marks that really matter for the present purposes are really the following two marks, in respect of which registrations in altogether 16 Classes have been obtained:-



44. The other marks listed out at Annex C of the Grounds of Opposition, or other marks identified by the opponent as the “Opponent’s Marks”, are just marks that have either one of these two marks incorporated as an element, hence I would ignore them as they practically could not stand a better chance of success against the suit

mark for the present purposes of section 12(3). The above two marks have obtained 16 registrations in Hong Kong in respect of goods and services scattered over Classes 9, 35, 36, 37, 38, 39, 41 and 42, particulars of which are set out at **Appendix A** to this decision. All of these registrations meet the criteria of “earlier trade mark” as defined under section 5(1)(a) of the Ordinance.

45. The two marks, as shown above, are in my view really the same mark being represented in a pale version and a dark version. For the purposes of the discussions below I shall not distinguish between the two but would treat them as one and the same mark, and call it the “Opponent’s “3” Mark”. It goes without saying that the Opponent’s “3” Mark, when put in use in different colour combinations, is really the stylized-3 mark as I have previously identified when evaluating the opponent’s evidence of use of marks in the HW Group’s 3G services.

The average consumer

46. As the case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The case-law also informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is being considered (see, for example, the judgment in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

47. The applicant states that he is involved in import and export business, and the products dealt with included a variety of gifts and household goods. On the other hand, the opponent has highlighted the HW Group’s 3G services for the present proceedings. I would say that the relevant public is comprised of members of the general public in Hong Kong interested in those goods and services, which means it is made up of the general public in Hong Kong. The public concerned is therefore, at least in part, one which is reasonably well informed and reasonably observant and circumspect.

Comparison of goods and services

48. According to settled case-law, in order to assess the similarity between goods or services, all the relevant features of the relationship between them should be taken into account. Those features include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods or services concerned (see for example *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* See also Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-2579, paragraph 37 and the case-law cited).

49. The applicant applies under the subject application to register the suit marks in Classes 35, 39 and 45. The applied for services cover largely services relating to buying, selling, transporting, distributing and storing of goods, and the specific goods involved in the buying and selling services are spelt out to be, under Class 35, the following:- books, magazines, periodicals, newspapers, stationery, office supplies, greeting cards, gifts, houseware products, seasonal decorations.

50. The opponent, understandably to serve its purpose of acting as an intellectual property holding company for the HW Group, has registered the Opponent's "3" Mark in many classes, namely, Classes 9, 35, 36, 37, 38, 39, 41 and 42, with the specification in each class comprising a very long list of items of goods or services. Though it could be said that many of those goods and services can be perceived to be in connection with the provision of 3G services, their scopes are so broad that they could cover other telecommunications services and other fields of business as well. For example, the opponent's Class 39 services include warehousing services, arranging of travel services, tourist office services (except hotel reservation), tourist agency services, etc. Hence the opponent's goods and services cannot be designated by putting them into one or two generalized categories.

51. In any event, the comparison of the goods and services must concern the description of the goods and services covered by the marks at issue and not the goods and services for which the trade marks are actually used. In this connection, I would

therefore resort to comparing the respective specifications items by items. To the extent that the respective specifications of goods or services overlap, identical goods or services are involved for the purpose of section 12(3)(b) of Cap. 559¹.

52. There is no Class 9 goods sought to be registered under the subject application. On the other hand, the Opponent's "3" Mark has not been registered in Class 45.

53. As regards the Class 35 services of the subject application ("Class 35 subject services"), the item "dissemination of advertising matter" is covered also in the specification of the Class 35 registration of the Opponent's "3" Mark, and should be considered identical service. As to the other items of Class 35 subject services, applying the principles discussed above and considering the various factors, I consider that they are similar to the services of the same class of the Opponent's "3" Mark, in accordance with the following comparisons:-

- (i) "direct sale, retail and wholesale services relating to books, magazines, periodicals, newspapers, stationery, office supplies, greeting cards, gifts, houseware products, seasonal decorations; distribution of samples and promotional items; sales promotion" of the subject services vis-à-vis "retail services, the bringing together, for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase goods in a department store";
- (ii) "import-export agency services" of the subject services vis-à-vis "advice and assistance in the selection of goods and services on behalf of others; agency services relating to bringing customers and/or buyers and sellers together",
- (iii) "organisation of exhibitions for commercial or advertising purposes; advertising agencies; demonstration of goods" of the subject services vis-à-vis "advertising and promotion and information services relating

¹ In *Galileo Trade Mark* [2005] R.P.C.22, it was held that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the UK Trade Marks Act 1994 (equivalent to section 12(1) of Cap. 559), and there is no necessity for such specifications to co-extend. The term "identical goods or services" in section 12(3)(b) of Cap.559 should be construed accordingly.

[to commercial or industrial management assistance]; rental of advertising space; television advertising commercials; compilation of advertisements for use as web pages on the Internet; preparation and presentation of audio visual displays for advertising purposes; organisation of promotional activities through audio visual media; provision of information, consultancy services and advice relating to the foregoing”; and

- (iv) “professional business consultancy, business management consultancy; education, research and analysis, audio and [video] cd” of the subject services vis-à-vis “commercial or industrial management assistance; marketing studies; business planning, business appraisal; business management; business administration; office administration (for others); marketing and business research; compilation of business statistics and commercial information; provision of information, consultancy services and advice relating to [all the foregoing services]”.

54. The applicant’s applied for services in Class 39 (“Class 39 subject services”) are related to transporting, distributing and storing of goods, and passengers transport, which I consider to be by nature and purpose either overlap with or similar to all those more diverse and specific services registered by the opponent in that Class.

55. Coming back to the Class 45 services of the subject application (“Class 45 subject services”), they are “personal and social services rendered by others to meet the needs of individuals”. These are in fact part of the class headings for Class 45, according to the general classification under the 8th edition of the NICE Classification² by the World Intellectual Property Organization (WIPO), then applied in Hong Kong when the subject application was filed in 2004.³ The explanatory note published by WIPO in respect of the 8th edition states that Class 45 includes “investigation and surveillance services relating to the safety of persons and entities;

² The Nice Classification is an international classification of goods and services applied for the registration of trademarks and service marks. It was established by an Agreement concluded at a Diplomatic Conference held in Nice in 1957: the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

³ The current edition of the Nice International Classification is the 9th edition (with 45 class), which applies in Hong Kong with effect from 1 January, 2007.

services provided to individuals in relation with social events, such as social escort services, matrimonial agencies, funeral services”, but does not include, inter alia, “professional services giving direct aid in the operations or functions of a commercial undertaking (Cl. 35)”, “services relating to financial or monetary affairs and services dealing with insurance (Cl. 36)”, “escorting of travellers (Cl. 39)”, “security transport (Cl. 39)”, “services consisting of all forms of education of persons (Cl. 41)”, “performances of singers or dancers (Cl. 41)”, “legal services (Cl. 42)”.

56. In the light of the aforesaid, even though I may be able to pick out some goods or services within the specifications of the various classes of goods or services of the registrations of Opponent’s “3” Mark that may have certain personal or social appearances or dimensions – say for example, “provision of information, consultancy services and advice relating to the opponent’s Class 35 services” (Class 35); “financial management and advisory services relating to investment; financial planning” (Class 36); “arranging of travel services” (Class 39); “organization of exhibitions for cultural or educational purposes” (Class 41) – these services are by nature within the scope of the exclusion list of the explanatory note as mentioned above, and thus would not be considered covered by the Class 45 subject services. Moreover, in the absence of evidence or proof to the contrary, the very fact that they fall within Classes 35, 36, 37, 38, 39, 41 or 42 but are excluded from Class 45 due to their different nature (as the explanatory note clearly illustrate this point) also means that the services at issue would not be in competition with each other, nor being complementary, and it goes without saying that their trade channels or distribution methods would also be different. I therefore do not perceive that there is any similarity involved between the different kinds of services at issue. I conclude that the Class 45 subject services do not overlap with and are not similar to any of the services registered under the Opponent’s “3” Mark.

Comparison of marks

57. 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 and 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 (supra)*, paragraph 27).

58. In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural and 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 (supra)*, para 23; *Lloyd Schuhfabrik Meyer (supra)*, para 25; and the order in *P Matratzen Concord v OHIM (Case C-3/03)*, para 29). In that regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Shaker di L. Laudato & C. Sas, Limiñana y Botella, SL (C-334/05 P) [2007] E.C.R. I-4529* at [35] and the case law cited).

59. Whilst the comparison must be made by examining each of the marks in question as a whole, that does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *OHIM v Shaker [2007] E.C.R. I-4529* at [41] and the case law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker (supra)* at [42]).

Distinctive and dominant components of the Opponent's "3" Mark

60. The Opponent's "3" Mark, as represented under paragraph [43] above, is a mere logo that takes the shape of a stylised numeral 3, having on it certain wave or lightning-like designs. Ms Shih describes the logo as having "a light titanium outside and a dynamic, playful, vibrant inside, animating through the whole spectrum of colour" (paragraph 19 of Shih's first statutory declaration).

61. Section 3(2) of the Ordinance, like section 1(1) of the U.K. Trade Marks Act 1994 or Article 2 of the Council Directive, confirms that a trade mark may consist of

letters and numerals. Hence there is no bar to the acceptance of single letters or numerals as trade marks, nonetheless questions have to be asked over whether a single letter or a single numeral, without any other distinctive feature or stylization, is registrable as a trade mark. In the European Court of Justice case *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) [2011] E.T.M.R. 4, it is said that, in relation to the aforesaid question, “even though it is apparent from the case law cited that the Court has recognized that there are certain categories of signs which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts” (paragraph 37).

62. The marks at issue in the present proceedings have numeral 3 devices incorporated in them. Any distinctiveness a numeral 3 device has may be due to the very fact that it is a numeral 3, or that the numeral 3 is stylised in a distinctive way, or a combination of both of these. Thus, in order to ascertain the distinctiveness of any numeral 3 device at issue, I would like to first ascertain whether, on the facts of the present case, an ordinary numeral 3 is capable of distinguishing the opponent’s goods and services from those of other undertakings.

63. In the present case, though the goods and services in respect of which the opponent has caused the Opponent’s “3” Mark to be registered with are in no way limited to only those for the provision of 3G services, the evidence of use of the mark by the HW Group suggests at least that the mark had in fact been heavily used in that connection.

64. 3G, according to Ms Shih, is a new wireless communications category that offers a highly personalized interactive multimedia experience – anywhere, anytime. Ms Shih in her statutory declaration has further deposed to the following:

“The mark “3” was chosen for its brevity and simplicity. “3” is easy to remember, ubiquitous, and transcends language, cultural barriers and even technology. In numerology, “3” is a lucky number, and is associated with entertainment, optimism and clarity. *Behind the name of “3” also lies a new adventure – “3” is the door to a brand new multi-media communications category that offers much more than 2G or 2.5G.*” (Emphasis added)

65. This underlies the fact that, to say the least, 3 is indicative of goods and services in relation to 3G services, and hence a plain numeral 3 may not simply on its own distinguish a particular undertaking from other undertakings in the provision of 3G services. This could be reinforced by the fact that, all along, the Opponent's "3" Mark, rather than a plain numeral 3, has been used in all advertising and promotional activities of the HW Group's 3G business. The applicant has pointed out that registrations of the Opponent's "3" Mark come with the following disclaimer:

“Registration of this Trade Mark shall give no right to the exclusive use of a numeral '3”.

66. The discussion above in no way implies that the Opponent's "3" Mark does not have distinctive character, but it highlights that the distinctive character of the Opponent's "3" Mark resides not in the mere fact that it contains the numeral 3, but in the fact that the numeral 3 takes on a stylised shape with certain wave or lightning-like designs on it.

Distinctive and dominant components of the suit marks

67. The suit marks are marks in series which differ from each other only in the combination of colours, though it is noted that no colour claims had been made in respect of any of the marks of the series. For the following comparison of marks therefore, I shall refer to the suit mark in the singular to signify that all that of the suit marks in series are considered one and the same mark.

68. The suit mark has a near-complete circular outer layer, encapsulating a numeral 3 inside. The applicant himself does not deny that his mark has the numeral 3 incorporated in it, and given the prominence and position of the numeral within the mark, I would assume that every one looking at the mark would focus their attention on the numeral, this is so notwithstanding that there are two parallel curved lines running across the circle and cutting through the numeral.

69. The numeral 3 inside is stylised by itself, having sharp and pointed bulges protruding from its upper and lower parts. Hence, even though the circular layer and the parallel curved lines running across it are not to be considered negligible, I

consider that each one of the suit marks in series is dominated by the stylised numeral 3.

Visual similarity

70. I have described the trade marks at issue above and examine the distinctive character of their respective components. Although the comparison for similarity must be made by examining each of the marks in question as a whole (see *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05P) [2009] E.T.M.R. 16, at paragraph 42), the suit mark, as I have discussed, is dominated by the stylised numeral 3. This stylised numeral 3, as I have also discussed above, has sharp and pointed bulges protruding out from its upper and lower parts, that could remind one of the wave or lightning-like designs on the Opponent's "3" Mark such that, on imperfect recollection, the wave or lightning-like designs could be mentally transposed into the sharp and pointed bulges of the numeral 3 of the suit mark, or vice versa, and the result could lead one to mix up the two.

71. If the marks at issue are placed side by side, one would see that the numeral 3 inside the suit mark has its upper, middle and lower curves getting thinner as they protrude towards their respective edges and finishing by a point, whereas the numeral 3 of the Opponent's "3" Mark (indeed it's the mark itself) has its top and middle curves each finished with a blunt end and the lower curve finished with a big rounded end, hence the shape of the two numeral devices are actually not the same. But 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 at issue 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). In my view, the difference between the shapes of the numeral devices is just negligible, and given the effect of the possible mental transposition of the wave or lightning-like designs on one numeral 3 device into the sharp and pointed bulges of the other numeral 3 device, or vice versa, upon imperfect recollection as I have discussed above, I am of the view that the numeral 3 devices of the respective marks share a high degree of visual similarity.

72. One would not, of course, ignore that the suit mark has a circular outer layer coupled with parallel curved lines running across it. These “extra” components, however, could not take away the focus of attention of the average consumers on the stylised numeral 3 which, as I have discussed, is the distinctive and dominant component of the suit mark.

73. In sum, even taking each of the marks as a whole, any dissimilarity arising from the fact that the suit mark has “extra” components than the Opponent’s “3” Mark is lessened by the high degree of similarity shared between the numeral 3 devices. The overall effect is therefore that visually, the marks are more similar to each other than they are different.

Aural similarity

74. Aurally, the Opponent’s “3” Mark would most likely be called the “3 device” mark for the simple reason that this is the only point of reference for the mark and that can be easily pronounced by the average consumers. As for the suit mark, since the numeral 3 device inside is the distinctive and dominant component of the mark, it would similarly be referred to as the “3 device” mark, or if one is more precise, he may call it the “circle-3” mark, or the “3 and ball” mark, etc. In the light of the aforesaid, aurally, I would say the marks are either identical or very similar.

Conceptual similarity

75. Conceptually, the position should be more or less the same. If, as I have analysed, people are more likely to remember the suit mark by the numeral 3 device, then the effect would be that, conceptually, despite the fact that the suit mark has “extra” components than the Opponent’s “3” Mark, there is a high degree of similarity between the two marks.

Distinctiveness of the Opponent's "3" Mark

76. 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).

77. As I have analysed, the stylised shape of the numeral 3 together with the wave or lightning-like designs endow the Opponent's "3" Mark with distinctive character. This is the inherent distinctive character of the mark.

78. On the other hand, I have found that the 3G services of the HW Group are offered to the public in Hong Kong by reference to a mark which is basically the Opponent's "3" Mark, and through the substantial advertising and promotion efforts since 2004 the mark is entitled to claim an enhanced degree of distinctive character.

Likelihood of confusion

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

80. In the present case, having found that the parties have identical or similar services under Classes 35 and 39, but not Class 45, I find that visually, aurally and conceptually the marks at issue are similar. Against these is my finding that the Opponent's "3" Mark has acquired an enhanced degree of distinctive character through use in relation to 3G services.

81. The applicant has deposed in Chan's statutory declaration that he deals with import and export business, and submits that the product functionality, usage, trade channel, customer base are all different from that of the opponent's. Given the very wide scope of services the Opponent's "3" Mark has been registered with, it is not clear which part or parts of the opponent's services the applicant was referring to there.

Even assuming that he was referring to the provision of 3G services under the Opponent's "3" Mark, as I have found on evidence that this is where the Opponent's "3" Mark has been used and has acquired a reputation and goodwill, there is nothing further in the applicant's evidence to show how the applicant's services are different from that of the opponent, or for that matter the HW Group, in terms of product functionality, usage, trade channel, customer base, etc. In any event, there is nothing to stop the opponent to embark on any of the services that the Opponent's "3" Mark has been registered with – irrespective of whether or not they are in the context of provision of 3G services – in particular those registered in Classes 35 and 39 which are found to be similar to the subject services of these classes. As I have also found that the marks at issue are similar at all the visual, aural and conceptual levels, it is just reasonable to come to the conclusion that the use of the suit mark in relation to the services applied for under Classes 35 and 39 would be likely to cause confusion.

82. Moreover, I also consider that even if the public are not directly confused in the sense that they mistake the suit marks for the Opponent's "3" Mark, they would still make a connection between the applicant and the HW Group (which includes the opponent) and confuse them by the likelihood of indirect confusion or association. In this connection, it has been well established that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of the provision of section 12(3) of the Ordinance (see *Sabel BV v Puma AG, op. cit.* paragraph 18). However, in the present case, given my finding that the respective numeral 3 devices are similar at all visual, aural and conceptual levels, and the numeral 3 device of the suit marks is actually encapsulated within a circular device, the suit marks can be perceived as just the result of add-on to the Opponent's "3" Mark. Coupled with the finding that the services involved as far as those under Classes 35 and 39 are concerned are similar, an association would result from the perception of the two marks by the average consumers such that it would cause them to wrongly believe that the respective goods and services come from the same or economically-linked undertakings, there is a likelihood of confusion within the meaning of section 12(3) of the Ordinance (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc., op. cit.*).

83. I hold that the opposition based on section 12(3) succeeds as far as those of the subject services sought to be registered in Classes 35 and 39 are concerned.

84. The above discussions, however, do not fit in with the Class 45 subject services. As I do not find there are any goods or services within the specifications of the various classes of goods or services of the registrations of the Opponent's "3" Mark which could be considered to be possibly covered by or similar to the Class 45 subject services, the mere similarity between the marks at issue is insufficient as a basis for me to conclude that opposition based on section 12(3) is made out in relation to the Class 45 subject services.

85. As I have found that the opposition succeeds in relation to the subject services under Classes 35 and 39, I only need to consider below whether any of the other grounds of opposition relied on by the opponent is made out in relation to the Class 45 subject services.

Section 12(4) of the Ordinance

86. Section 12(4) of the Ordinance, like section 12(3), requires the existence of an earlier trade mark which is identical or similar to the mark in question. Moreover, section 12(4) requires that the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark.

87. Section 4 of the Ordinance provides that a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as references to a trade mark which is well known in Hong Kong, and further provides that in determining whether a trade mark is well known in Hong Kong, the Registrar or the court shall have regard to Schedule 2 to the Ordinance.

88. Although I have found that the opponent's evidence as a whole is sufficient to show that 3G services are offered to the public in Hong Kong by reference to the Opponent's "3" Mark, and through the substantial advertising and promotion efforts since 2004 the mark has acquired a reputation and goodwill in the products and

services sold and promoted in connection with the HW Group's 3G business in Hong Kong, it is another thing to say that the mark has become a well-known trade mark within the meaning of section 4 of the Ordinance.

89. In any event, even assuming that the Opponent's "3" Mark has become a well known trade mark, section 12(4) requires proof that the use of the later trade mark, which in the present case means the suit marks, without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark. In the European Court of Justice case *L'Oréal SA v. Bellure NV* [2009] E.T.M.R. 55, the ECJ classifies the types of injury into the following:- first, detriment to the distinctive character of the mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark. The court explains the first two types of injury a little more in paragraphs [39] and [40] there. Basically, these two types of injury are referred to as "dilution", "whittling away" or "blurring", "tarnishment" or "degradation". It is not necessary to go into these here because the evidence filed in the present proceedings simply has nothing to support there is any blurring or tarnishment of the Opponent's "3" Mark if the suit marks are used in relation to the Class 45 subject services. What matters is its explanation of the third type—unfair advantage. Here is what the court says:

“41 As regards the concept of "taking unfair advantage of the distinctive character or the repute of the trade mark", also referred to as "parasitism" or "free-riding", that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.”

90. So, the opponent must demonstrate in evidence that there was some form of unfairness, such as intent, or it must be obvious from the facts of the case. No evidence to, for instance, intent has been furnished. Taking advantage requires an advantage to the customers of the applicant. There is no connection between the existing business of the opponent or that of the HW Group and the Class 45 subject services. This distance means that it is not possible to see what advantage the applicant would gain, hence there is no basis for the claim of unfairness from the facts of the case, even if the use of the suit mark brought the Opponent's "3" Mark to mind.

91. I must therefore also hold that the opposition based on section 12(4) of the Ordinance fails in relation to the Class 45 subject services.

Section 12(5)(a)

92. Section 12(5)(a) concerns the protection of "an unregistered trade mark or other sign used in the course of trade or business" by virtue of the law of passing off vis-à-vis the mark in question.

93. 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. 3419 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731, and is as follows :

"The House of Lords has restated the necessary elements which a plaintiff has to establish in an action for passing off:

- (1) the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) the plaintiff has suffered or is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation.

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

94. Whilst reputation or a protectable goodwill could have been found for the Opponent's "3" Mark in relation to the HW Group's provision of 3G services in Hong Kong, there is an enormous distance between goods and services for which the opponent or the HW Group has goodwill and the Class 45 subject services. In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business.

.....

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

"...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant": *Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J.

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion."

95. The wide gap between the services under consideration means that there should not be any kind of association in the minds of the public between the field of

activities of the applicant in respect of the Class 45 subject services and the field of activities of the opponent or the HW Group. There would be no misrepresentation and so this ground of opposition would also fail on this basis.

96. Owing to the completely different lines of business, neither would there be any damage to the opponent or the HW Group.

97. I must therefore also hold that the opposition based on section 12(5)(a) of the Ordinance fails in relation to the Class 45 subject services.

Section 11(5)(b)

98. Section 11(5)(b) of the Ordinance provides that a trade mark shall not be registered if the application for registration of the trade mark is made in bad faith. The term “bad faith” is not defined in the Ordinance.

99. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 at 379, Lindsay J. said in relation to section 3(6) of the U.K. Trade Marks Act 1994 (equivalent to section 11(5)(b) of the Ordinance):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also 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 adjudged 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.”

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

“The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his

decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.” (Emphasis added)

101. Further, in *Ajit Weekly Trade Mark* [2006] RPC 25, the Appointed Person said,

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

102. The position is best summarised more recently in the following passage in *Melly’s Trade Mark Application (Oppositions of Fianna Fail and Fine Gael)* [2008] E.T.M.R. 41, where it is said:

“53 The mental element required for a finding of bad faith has been much discussed. The discussion has centred on the test for determining dishonesty in English law, that is to say the “combined test” as explained by the House of Lords in *Twinsectra Ltd v Yardley* and clarified by the Privy Council in *Barlow Clowes International Ltd (In Liquidation) v Eurotrust International Ltd*. In her decision in *Ajit Newspaper Advertising Marketing & Communications Inc’s Trade Mark* (No.2283796) Professor Annand considered whether the “combined test” makes it necessary to give effect to the applicant’s belief in the propriety of his own behaviour when deciding whether he applied for registration in bad faith. She said not, on the basis that his own perception of propriety could not provide a conclusive answer to the question whether he actually had applied for registration in bad faith. I agree with her analysis. It supports the view that the relevant determination must ultimately be made “on the basis of objective evidence” rather than upon the basis of evidence as to the beliefs and opinions of the applicant with regard to the propriety of his disputed application for registration. I note in this connection that in the *Harrison v Teton Valley Trading Co Ltd--CHINA WHITE* the Court of Appeal upheld the Hearing Officer’s finding of bad faith: (1) notwithstanding that the applicant for registration had deposed to the fact that he “recognised no bad faith in my decision to develop and market the drink CHINA WHITE” and was not cross-examined on the evidence he had given; and (2) notwithstanding that the Registrar’s Hearing Officer had accepted the applicant’s evidence and concluded that at the date of the disputed application for registration the applicant “saw nothing wrong in his own behaviour”.” (footnotes omitted)

103. In any event, bad faith is a serious allegation that must be proved. An allegation of bad faith should not be lightly 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).

104. Same as the opposition based on section 11(4)(a), 11(4)(b) and 11(5)(a) as discussed above, the opponent has not in the Grounds of Opposition specifically pointed out how the application for registration of the suit marks was made in bad faith, and it just appears that the allegation of bad faith also stemmed from the alleged fact that the suit marks closely resemble the “Opponent’s Marks”, or for that matter the Opponent’s “3” Mark.

105. Nevertheless, given my findings that the Opponent’s “3” Mark has acquired a reputation and goodwill in the products and services sold and promoted in connection with the HW Group’s 3G business in Hong Kong, and that the opposition based on section 12(3) succeeds in relation to the subject services under Classes 35 and 39 (but not Class 45), it is reasonable to ask why the applicant has chosen the numeral 3 to be incorporated as an element into his mark, and this requires a deeper look into the evidence.

106. The applicant filed his evidence by way of Chan’s Statutory Declaration in which he alleges that the blueprint for the suit marks came from his Chinese birth date. Although that explanation may appear to some to be a bit stretch of the imagination, there is nothing to suggest that what Mr. Chan said is something concocted, or is something that cannot be true; on the contrary, the applicant did provide evidence to prove that his birth day is indeed the third day of the Chinese Lunar New Year.

107. Ultimately, the issue must be determined on the balance of probabilities. Given the facts and findings in the present case, I do not see there is a sufficient basis to conclude that a bad faith claim has been made out.

108. I must therefore hold that the opposition based on section 11(5)(b) of the Ordinance fails.

Conclusion

109. For the reasons stated above:

- (a) the opposition succeeds in respect of those of the subject services sought to be registered in Classes 35 and 39;
- (b) the opposition fails in respect of those of the subject services sought to be registered in Class 45.


110. As the opponent has been largely successful in this opposition, I award the opponent costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either the opponent or the applicant 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.



(Frederick Wong)



for Registrar of Trade Marks



27 September 2011


Appendix A

<u>Registration No.</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Goods/Services</u>
2004B08334		9	<p>electric, electronic, photographic, cinematographic, optical, signaling, checking (supervision) and teaching apparatus and instruments; television apparatus and instruments; telecommunications equipment; electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; optical disc players and computer programs therefor; magnetic data carriers, smart cards, encoded cards, encoded cards for carrying data; recording discs; apparatus for recording, transmission or reproduction of sound, images, data; calculating machines; telecommunications apparatus and instruments; facsimile, telex, telephone, telegram, data acquisition installation, apparatus and instruments; computer programs including computer programs consisting of an engine (download from the Internet), namely, a software/hardware system running a platform, machine, computer, infrastructure or system to achieve certain tasks including copying, analysing, storing and compiling data; computer software and programmes; computer software and telecommunications apparatus and modems to enable connection to databases and the Internet; operating system programs; computer software and networking hardware for the facilitation of interactive multimedia communications; computer software for use in creating, editing and delivering textual and graphic information via computer communication networks; computer programs for digital publishing, printing, imaging, and electronic document storage, manipulation, transfer and retrieval; computers, handheld computers; computer programs for managing communications and data exchange between handheld computers and desktop computers; computer hardware and computer output devices, printers, image setters, photocopiers, CD-ROM writers, electronic and electric screen displays, liquid crystal display screens; digital wireless telecommunications hardware and software; electronic publications (downloadable) and downloadable software, electronic maps and corporate information; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet and web sites; electronic and computer games, games programs, game cartridges, entertainment consoles; entertainment consoles comprising computer hardware and software for providing audio, video, and multimedia output; parts and fittings for all the aforesaid goods; all included in Class 9.</p>


2005B00712		35	<p>commercial or industrial management assistance; commercial or industrial information agencies; management of ports; advertising and promotion and information services relating thereto; rental of advertising space; television advertising commercials; compilation of advertisements for use as web pages on the Internet; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; business information services; receipt, storage and provision of computerised business information data; marketing studies; business planning, business appraisal; business management; business administration; office administration (for others); marketing and business research; compilation of business statistics and commercial information; auctioneering; retail services, the bringing together, for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase goods in a department store, or a supermarket, or retail electrical store or pharmacy, or from a website specializing in electrical or pharmacy goods, or telecommunications apparatus and instruments and mobile phone accessories; retail services in the field of telecommunications; advice and assistance in the selection of goods and services on behalf of others; agency services relating to bringing customers and/or buyers and sellers together; organisation of promotional activities through audio visual media; provision of information, consultancy services and advice relating to the foregoing; all included in Class 35.</p>
2003B13710		36	<p>arranging monetary transfers, foreign monetary exchange advisory services, monetary exchange, monetary transaction services, monetary transfer; financial services; financial management and advisory services relating to investment; financial planning; financial appraisal; banking evaluation; banking services; savings banks; financial brokerage services; securities brokerage and electronic discount brokerage services and on-line discount brokerage services; stocks and bonds brokerage; investment services; lending services and lending against security; financial services for the provision of treasury and derivative financial products; investment banking, treasury and foreign exchange services and providing financial services to institutional investment clients; trust, credit, savings account, safety deposit, loan, loan guarantee services; debit card, credit card, charge card, store value card services; issuance of debit card, credit card, charge card, store value cards; automated banking services; actuarial services; arranging and financial management of life insurances, guarantee insurance and mutual funds; pension services; insurance underwriting; travel insurance; bankers' clearing services; clearing-house services; buying and issuing of travellers' cheques; currency exchange services; escrow services; stockbroking agency services; executors' services; provision of financial guarantees;</p>



			issuing letters of credit and certificates of deposit; investment trust services; surety services; share underwriting; insurance services; insurance consultancy; insurance information; insurance underwriting, accident insurance underwriting, fire insurance underwriting, health insurance underwriting, life insurance underwriting, marine insurance underwriting; insurance brokerage, accident insurance brokerage, fire insurance brokerage, health insurance brokerage, life insurance brokerage, marine insurance brokerage; credit bureau; issue of tokens, coupons, and vouchers of value; deposit of valuables; safe deposit services; funds transfer, electronic funds transfer; electronic payment services; fiduciary services; stock exchange quotations; fiscal assessments; financial management; installment loans financing; lease-purchase financing, hire-purchase financing, mortgage banking; retirement payment services; real estate financing services; charitable fund raising; sponsorship (financial) of competitions; provision of information, consultancy services and advisory services relating to all the aforesaid services; and all the above also provided on-line from a computer database or the Internet; all included in Class 36.
2005B00713		37	construction, repair and installation services for computers, computer networks, telecommunications apparatus, equipment, installations and networks; construction and repair services of information technology systems; maintenance, repair, installation services for computers, computer peripheral devices, telecommunication apparatus, and parts and accessories therefore; on-site computer set-up and installation services and maintenance of computers, computer system and telecommunication apparatus; provision of information relating to repair or installation provided on-line from a computer database or the Internet; provision of information, consultancy services and advice relating to the foregoing; all included in Class 37.
2004B08335		38	electronic and telecommunication transmission services; transmission of data documents, messages, images, sounds, voices, text, audio, video and electronic communications and data and information by electronic, computer, cable, radio, radiopaging, teleprinter, teletype, electronic mail, facsimile machine, television, microwave, laser beam, communications satellite, microwave link, terrestrial means, wireless or wirelink system or the Internet or other telecommunications means; broadcasting services; provision of multi-media telecommunication information and interactive multimedia services; provision of telecommunication link for operation of search engines; consultancy services relating to data communications; telecommunication services for the transmission, provision of display of information for business or domestic purposes from a computer-stored data bank; electronic mail services; telecommunication services relating to the Internet; telecommunication of



			information and web pages, computer programs and any other data; providing telecommunications connections to the Internet or databases; teletext services; telecommunication access services; provision of telecommunication on-line access and links to the Internet and Intranet; provision of telecommunication access to the Internet; Internet portal services; Internet services providers (ISPs); providing access to MP3 web sites on the Internet; providing access to digital music web sites on the Internet; providing an online interactive bulletin board; hiring, rental and leasing of set-top boxes; provision of information, consultancy services and advice relating to the foregoing; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 38.
2003B13981		39	warehousing services; arranging of travel services; tourist office services (except hotel reservation) and tourist agency services; arranging of transport services; arranging and providing transport by land, sea and air; arranging, organising and providing tours and cruises; travel agency services; travel ticket reservation services; rental of apparatus for transportation by land, sea and air, cargo handling; provision of car parking facilities; carting and chauffeur services; collection of goods for transportation, crating of goods; delivery of goods services; escorting of travellers; guarded transport; travel guide services; route planning; porter services; conducting sightseeing tours; tour operating and organising; transport brokerage; travel courier services; chartering of transport; chartering of ships; cruise ship services; ferry transport services; sea freight services; marine transport services; piloting of ships; pleasure boat transport services; river transport services; reservation services for travel; freight and cargo transportation services; freight forwarding, freight brokerage services; shipping agency; transportation of goods, shipping of goods, packaging and storage of goods; provision of information, consultancy services and advisory services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 39.
2005B00714		41	arranging and conducting of conferences, exhibitions, competitions and quizzes; organization of exhibitions for cultural or educational purposes; organization of competitions; arranging of workshops; arranging and conducting of seminars; provision of training relating to telecommunications and cooking; publication of books and texts; entertainment services relating to music, MTV, movies, entertainment services in the nature of the sending of SMS or texts having entertainment content, jokes and horoscopes; television entertainment; planning, production and distribution of live or recorded audio, visual or audiovisual materials relating to education and entertainment, sports and leisure activities for broadcasting on


		<p>terrestrial means, cable, satellite channels, the Internet, wireless or wirelink systems and other means of communication; provision of information relating to television and radio programmes, entertainment, music, sport and recreation; provision of information relating to entertainment or education provided on-line from a computer database or the Internet or via terrestrial means, cable, satellite channels, wireless or wirelink systems and other means of communication; electronic games services provided by means of the Internet or via terrestrial means, cable, satellite channels, wireless or wirelink systems and other means of communication; providing on-line electronic publications (not downloadable); provision of electronic and on-line dictionary and thesaurus (non-downloadable); publication of electronic books and journals on-line; booking and reservation of tickets for education and entertainment events; gaming services, betting, lottery and gambling services; information and advisory services relating to education and entertainment; operating and organising chat rooms; hiring, rental and leasing of television and television display apparatus; provision of news on-line; provision of information, consultancy services and advice relating to the aforesaid services; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 41.</p>
2005B00715		<p>42 design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web sites; hosting web sites of others; installation and maintenance of computer software; provision of computer access to sites on an electronic information networks; provision of computer access to various databases; providing user access to the Internet; leasing access time to a computer data base (other than by Internet services providers); hiring, rental and leasing of computers, computer programs, computer terminals, monitors, computer keyboards, laptop computers, modems, computer peripherals, and parts and accessories of all these goods; computer services; computer services provided online from the Internet; consultancy services relating to computer industries; provision of information to mobile phone users on the location of people and facilities; provision of information relating to restaurant; medical, hygiene, nutrition, health, beauty care services; provision of horoscopes; dating agency services; technical support services for computers, computer peripheral devices, telecommunication apparatus, and parts and accessories therefore; provision of information and advice relating to the aforesaid services, all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 42.</p>

2004B08332		9	<p>electric, electronic, photographic, cinematographic, optical, signaling, checking (supervision) and teaching apparatus and instruments; television apparatus and instruments; telecommunications equipment; electronic devices for receiving television and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; optical disc players and computer programs therefor; magnetic data carriers, smart cards, encoded cards, encoded cards for carrying data; recording discs; apparatus for recording, transmission or reproduction of sound, images, data; calculating machines; telecommunications apparatus and instruments; facsimile, telex, telephone, telegram, data acquisition installations, apparatus and instruments; computer programs including computer programs consisting of an engine (download from the Internet), namely, a software/hardware system running a platform, machine, computer, infrastructure or system to achieve certain tasks including copying, analysing, storing and compiling data; computer software and programmes; computer software and telecommunications apparatus and modems to enable connection to databases and the Internet; operating system programs; computer software and networking hardware for the facilitation of interactive multimedia communications; computer software for use in creating, editing and delivering textual and graphic information via computer communication networks; computer programs for digital publishing, printing, imaging, and electronic document storage, manipulation, transfer and retrieval; computers, handheld computers; computer programs for managing communications and data exchange between handheld computers and desktop computers; computer hardware and computer output devices, printers, image setters, photocopiers, CD-ROM writers, electronic and electric screen displays, liquid crystal display screens; digital wireless telecommunications hardware and software; electronic publications (downloadable) and downloadable software, electronic maps and corporate information; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet and web sites; electronic and computer games, games programs, game cartridges, entertainment consoles; entertainment consoles comprising computer hardware and software for providing audio, video, and multimedia output; parts and fittings for all the aforesaid goods; all included in Class 9.</p>
2005B00708		35	<p>commercial or industrial management assistance; commercial or industrial information agencies; management of ports; advertising and promotion and information services relating thereto; rental of advertising space; television advertising commercials; compilation of advertisements for use as web pages on the Internet; preparation and presentation of audio visual displays for advertising</p>

			<p>purposes; dissemination of advertising matter; business information services; receipt, storage and provision of computerised business information data; marketing studies; business planning, business appraisal; business management; business administration; office administration (for others); marketing and business research; compilation of business statistics and commercial information; auctioneering; retail services, the bringing together, for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase goods in a department store, or a supermarket, or retail electrical store or pharmacy, or from a website specializing in electrical or pharmacy goods, or telecommunications apparatus and instruments and mobile phone accessories; retail services in the field of telecommunications; advice and assistance in the selection of goods and services on behalf of others; agency services relating to bringing customers and/or buyers and sellers together; organisation of promotional activities through audio visual media; provision of information, consultancy services and advice relating to the foregoing; all included in Class 35.</p>
2003B13979		36	<p>arranging monetary transfers, foreign monetary exchange advisory services, monetary exchange, monetary transaction services, monetary transfer; financial services; financial management and advisory services relating to investment; financial planning; financial appraisal; banking evaluation; banking services; savings banks; financial brokerage services; securities brokerage and electronic discount brokerage services and on-line discount brokerage services; stocks and bonds brokerage; investment services; lending services and lending against security; financial services for the provision of treasury and derivative financial products; investment banking, treasury and foreign exchange services and providing financial services to institutional investment clients; trust, credit, savings account, safety deposit, loan, loan guarantee services; debit card, credit card, charge card, store value card services; issuance of debit card, credit card, charge card, store value cards; automated banking services; actuarial services; arranging and financial management of life insurances, guarantee insurance and mutual funds; pension services; insurance underwriting; travel insurance; bankers' clearing services; clearing-house services; buying and issuing of travellers' cheques; currency exchange services; escrow services; stockbroking agency services; executors' services; provision of financial guarantees; issuing letters of credit and certificates of deposit; investment trust services; surety services; share underwriting; insurance services; insurance consultancy; insurance information; insurance underwriting, accident insurance underwriting, fire insurance underwriting, health insurance underwriting, life insurance underwriting, marine insurance underwriting; insurance brokerage,</p>

			accident insurance brokerage, fire insurance brokerage, health insurance brokerage, life insurance brokerage, marine insurance brokerage; credit bureau; issue of tokens, coupons, and vouchers of value; deposit of valuables; safe deposit services; funds transfer, electronic funds transfer; electronic payment services; fiduciary services; stock exchange quotations; fiscal assessments; financial management; installment loans financing; lease-purchase financing, hire-purchase financing, mortgage banking; retirement payment services; real estate financing services; charitable fund raising; sponsorship (financial) of competitions; provision of information, consultancy services and advisory services relating to all the aforesaid services; and all the above also provided on-line from a computer database or the Internet; all included in Class 36.
2005B00709		37	construction, repair and installation services for computers, computer networks, telecommunications apparatus, equipment, installations and networks; construction and repair services of information technology systems; maintenance, repair, installation services for computers, computer peripheral devices, telecommunication apparatus, and parts and accessories therefore; on-site computer set-up and installation services and maintenance of computers, computer system and telecommunication apparatus; provision of information relating to repair or installation provided on-line from a computer database or the Internet; provision of information, consultancy services and advice relating to the foregoing; all included in Class 37.
2004B08333		38	electronic and telecommunication transmission services; transmission of data documents, messages, images, sounds, voices, text, audio, video and electronic communications and data and information by electronic, computer, cable, radio, radiopaging, teleprinter, teletype, electronic mail, facsimile machine, television, microwave, laser beam, communications satellite, microwave link, terrestrial means, wireless or wirelink system or the Internet or other telecommunications means; broadcasting services; provision of multi-media telecommunication information and interactive multimedia services; provision of telecommunication link for operation of search engines; consultancy services relating to data communications; telecommunication services for the transmission, provision of display of information for business or domestic purposes from a computer-stored data bank; electronic mail services; telecommunication services relating to the Internet; telecommunication of information and web pages, computer programs and any other data; providing telecommunications connections to the Internet or databases; teletext services; telecommunication access services; provision of telecommunication on-line access and links to the Internet and Intranet; provision of telecommunication access to the Internet; Internet portal services; Internet services providers (ISPs);

			providing access to MP3 web sites on the Internet; providing access to digital music web sites on the Internet; providing an online interactive bulletin board; hiring, rental and leasing of set-top boxes; provision of information, consultancy services and advice relating to the foregoing; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 38.
2003B13980		39	warehousing services; arranging of travel services; tourist office services (except hotel reservation) and tourist agency services; arranging of transport services; arranging and providing transport by land, sea and air; arranging, organising and providing tours and cruises; travel agency services; travel ticket reservation services; rental of apparatus for transportation by land, sea and air, cargo handling; provision of car parking facilities; carting and chauffeur services; collection of goods for transportation, crating of goods; delivery of goods services; escorting of travellers; guarded transport; travel guide services; route planning; porter services; conducting sightseeing tours; tour operating and organising; transport brokerage; travel courier services; chartering of transport; chartering of ships; cruise ship services; ferry transport services; sea freight services; marine transport services; piloting of ships; pleasure boat transport services; river transport services; reservation services for travel; freight and cargo transportation services; freight forwarding, freight brokerage services; shipping agency; transportation of goods, shipping of goods, packaging and storage of goods; provision of information, consultancy services and advisory services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 39.
2005B00710		41	arranging and conducting of conferences, exhibitions, competitions and quizzes; organization of exhibitions for cultural or educational purposes; organization of competitions; arranging of workshops; arranging and conducting of seminars; provision of training relating to telecommunications and cooking; publication of books and texts; entertainment services relating to music, MTV, movies, entertainment services in the nature of the sending of SMS or texts having entertainment content, jokes and horoscopes; television entertainment; planning, production and distribution of live or recorded audio, visual or audiovisual materials relating to education and entertainment, sports and leisure activities for broadcasting on terrestrial means, cable, satellite channels, the Internet, wireless or wirelink systems and other means of communication; provision of information relating to television and radio programmes, entertainment, music, sport and recreation; provision of information relating to entertainment or education provided on-line from a computer database or the Internet or via terrestrial means, cable, satellite

			<p>channels, wireless or wirelink systems and other means of communication; electronic games services provided by means of the Internet or via terrestrial means, cable, satellite channels, wireless or wirelink systems and other means of communication; providing on-line electronic publications (not downloadable); provision of electronic and on-line dictionary and thesaurus (non-downloadable); publication of electronic books and journals on-line; booking and reservation of tickets for education and entertainment events; gaming services, betting, lottery and gambling services; information and advisory services relating to education and entertainment; operating and organising chat rooms; hiring, rental and leasing of television and television display apparatus; provision of news on-line; provision of information, consultancy services and advice relating to the aforesaid services; all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 41.</p>
2005B00711		42	<p>design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web sites; hosting web sites of others; installation and maintenance of computer software; provision of computer access to sites on an electronic information networks; provision of computer access to various databases; providing user access to the Internet; leasing access time to a computer data base (other than by Internet services providers); hiring, rental and leasing of computers, computer programs, computer terminals, monitors, computer keyboards, laptop computers, modems, computer peripherals, and parts and accessories of all these goods; computer services; computer services provided online from the Internet; consultancy services relating to computer industries; provision of information to mobile phone users on the location of people and facilities; provision of information relating to restaurant; medical, hygiene, nutrition, health, beauty care services; provision of horoscopes; dating agency services; technical support services for computers, computer peripheral devices, telecommunication apparatus, and parts and accessories therefore; provision of information and advice relating to the aforesaid services, all the aforesaid services also provided on-line from a computer data base or from the Internet; all included in Class 42.</p>