

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300440766



MARK :

APPLICANT : CHAPMAN ENTERTAINMENT LIMITED

CLASS : 25

STATEMENT OF REASONS FOR DECISION

Background

1. On 17 June 2005 Chapman Entertainment Limited (the applicant) made an application pursuant to provisions under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark:




(the “subject mark”).

2. The application is made in respect of goods in Classes 16, 25 and 28. By Notice of the Registrar’s Opinion dated 4 July 2005, objection is raised under section 12(3) of the Ordinance in respect only of the application in Class 25 (the “application”).

The application covers “clothing; footwear; headgear; all included in Class 25 (the “specified goods”). The subject mark is considered similar to an earlier registered Trade Mark No. 300330803 (“earlier trade mark”), and the specified goods considered similar to those of that earlier trade mark. Details of the earlier trade mark are as follows:



TRADE MARK : 
REGISTRATION NO. : **300330803**
CLASS : **25**
GOODS : 服裝、鞋、帽、襪、腰帶、圍巾、裙子、手套
[clothing, shoes, hats, socks, belts, shawls,
dresses, gloves]
DATE OF REGISTRATION: **2 December 2004**
OWNER : 許少作

3. The Registrar indicated that the objection may be overcome by furnishing written consent of the owner of the earlier trade mark. No such consent was obtained. Instead by letter dated 28 November 2005 the applicant filed written arguments to distinguish the earlier trade mark. In brief, the applicant contends that the subject mark consists of the character of a “Bee Prince” presented in a 3-dimensional manner, whereas the cited mark looks more like a wingless grub or caterpillar with four limbs. The applicant contends that use of the crown device, and the 3-dimensional presentation of the subject mark, among other features, are sufficient to distinguish the mark from the cited mark.
4. By a Further Opinion dated 4 April 2006, the Registrar stated the view that visually and conceptually the subject mark is similar to the earlier trade mark as consumers are unlikely to remember the details of the mark. The crown device, being very

small in size, is hardly perceivable unless upon close examination. On the contrary, both marks are immediately recognisable as insect devices. As the parties' goods overlap, consumers will perceive that the goods originate from the same or linked commercial undertakings. The marks are therefore so similar that confusion is likely to arise. The Registrar reiterates that the objection may be overcome by furnishing the consent of the owner of the earlier trade mark in writing, or filing evidence to establish honest use concurrent with the registration of the earlier trade mark from a date prior to the date of application.

5. By letter dated 4 May 2006, the applicant's agent requested a registrability hearing. The hearing came before me on 14 June 2006 at which Mr C M Ng of Messrs Vincent Luk & Associates appeared on behalf of the applicant. Written submissions in support had earlier been filed on 8 June 2006.

Decision

6. At the outset I note that no evidence has been filed of any antecedent use of the subject mark in relation to the specified goods. No claim has been made for a 3-dimensional shape as an element of the subject mark. Mr Ng concedes that I only have the *prima facie* case to consider, based on a comparison of the two marks.
7. Mr Ng does not dispute there is close similarity between the specified goods and the goods covered by the earlier trade mark. The sole issue to be decided is whether the application should be refused by reason of likelihood of confusion with Trade Mark No. 300330803 under section 12(3).
8. Section 12(3) is in the following terms:

“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.”
9. Section 7(1) of the Ordinance expressly provides that the Registrar may take into account all factors relevant in the circumstances including whether the use of the subject mark is likely to be associated with an earlier trade mark in assessing the likelihood of confusion under the Ordinance.
10. Additionally, sections 12(3) and 7(1) of the Ordinance are in similar terms to Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1988, issued by the Council of the European Communities to approximate the laws of its Member States relating to trade marks (the “Council Directive”).

Article 4(1)(b) reads:

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

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

As sections 12(3) and 7(1) of the Ordinance is in similar terms to Article 4(1)(b) of the Council Directive, I find the ECJ’s interpretation of Article 4(1)(b) to be of persuasive authority.

11. The position which has emerged from case law, and which Mr Ng accepts, is that in assessing whether two marks and their respective goods of interest are so similar as to give rise to a likelihood of confusion (including the likelihood of association), a “global appreciation” test, as formulated by the European Court of Justice (“ECJ”) in interpreting Article 4(1)(b) of the Council Directive is to be applied. I set out the ECJ’s guidance in applying the “global appreciation” test in a comparison between conflicting marks:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel BV v. Puma AG* [1998] RPC 199 at paragraph 22);
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v. Puma AG*, paragraph 23), who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [1999] ETMR 690 at paragraph 26);
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v. Puma AG*, *supra* at paragraph 23);
- (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG supra* at paragraph 23);
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117 at paragraph 17);

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it (*Sabel BV v. Puma AG, supra* at paragraph 24);
 - (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b) (*Sabel BV v. Puma AG, supra* at paragraph 26);
 - (h) further, the reputation of a mark does not provide grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode CV v. Adidas AG* [2000] ETMR 561, at paragraph 41);
 - (i) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc, supra* at paragraph 29).
12. Hence, for present purposes, the likelihood of confusion depends on the overall effect of the similarity between the marks and the goods from the perspective of the average consumer, bearing in mind that he perceives marks by overall impression, not by their various details.
13. The applicant disputes the view expressed in the Registry's Further Opinion dated 4 April 2006, as follows:

“In appearance [the subject mark and earlier trade mark] are insects with similar heads and postures. ... We do not agree that the crown device in the subject mark contributes to distinguish the subject mark and the

earlier trade mark. Being very small in size and not eye-catching, the crown device is hardly perceivable at first glance. It is only recognisable after detailed examination of the subject mark ...”

14. On behalf of the applicant Mr Ng submits that there are “distinctive differences” between the marks. He urges me to consider that the subject mark is visually and conceptually different from the earlier trade mark. He says that the marks are aurally different. He says the subject mark is not just the device of a bumble bee but a “Bee Prince” since it wears a crown. The earlier trade mark, on the other hand, is a grub or a bug. Mr Ng submits that human attributes are not exclusive to these two marks, noting the many trade marks which consist of cartoon characters with human attributes which are registered in Class 25. He submits that therefore the subject mark will be referred to as “Bee Prince” and the earlier trade mark a “grub” or a “bug.”

15. As I said at the hearing, I have difficulties with these arguments. Mr Ng is relying on differences between the marks which are not apparent unless on a side-by-side, close inspection of the marks. That the subject mark is a “Bee Prince” device because of the three-pronged crown it wears is not, in my view, immediately apparent. Based on the image of the mark filed, the overall impression one gets is of a dark-coloured cartoon creature or insect. The “crown”, which is depicted in more or less the same shade as the rest of the mark, looks as if it forms part, such as a crest, of the creature or insect itself. The applicant has filed no evidence of how the subject mark is used or proposed to be used to assist my assessment. In fact I doubt if it is even obvious that the subject mark is a “Bee” device. The impression one is left with is that of a cartoon creature or insect with a pair of antennae and big round eyes, portrayed in a standing posture and wearing a big smile. It wears clothes, and trousers with braces and shoes. It has skinny arms and legs. The cited mark also consists of a cartoon creature or insect with antennae and big round eyes. It wears what looks like a quilted outfit and socks and shoes. It also has skinny arms and legs. It is also portrayed in a standing posture wearing a big

smile. The image of the mark filed by the applicant shows that the creature or insect wears an object which resembles a buoyancy aid at his neck. If this is in fact a pair of wings characteristic of bees, it is not apparent from the representation.

16. In my view aural similarity is not relevant here, since both are device-only marks for cartoon figures resembling insects, not necessarily bees. Neither mark includes a word element for aural comparison but, in any event, both might well be referred to as a “bug” or an “insect” device.
17. It is axiomatic that customers normally perceive marks by overall impressions and do not proceed to analyse them in various details (*Sabel BV v. Puma AG*, paragraph 23). *Sabel* establishes that the average customer’s focus will be drawn to a mark’s dominant and distinctive components. He rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he has kept of them in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [1999] ETMR 690 at paragraph 26). In fact, Mr Ng himself also relied on *Sabel* and *Lloyd Schuhfabrik* in setting out the applicable law for my consideration. As I have said, both device marks will come across as cartoon “insect” marks due to the memorable features of the antennae, big round eyes, the thin limbs, the standing posture and the beaming smile of both device marks.
18. I accept there are differences between the two marks, such as the presence of the small three-pronged crown or crest and the “buoyancy aid” in the subject mark. However, in my assessment the overall impression that the two marks convey is overwhelmingly that of a smiling, cartoon insect with antennae and long, thin limbs. Those visual and conceptual similarities, in combination with the complete overlap between the parties’ goods, mean that use of the subject mark in relation to the specified goods will likely cause confusion on the part of the public as to origin with the earlier trade mark.

19. I should also mention that the applicant has referred to other marks already registered in Class 25 which comprise insects or creatures with human attributes. As a general rule comparison with other marks is of little assistance, but in any case the marks which Mr Ng referred to at the hearing (Trade Marks Nos. 19822246, 200210000, 200314243, 300080306, 300235944 and 300447543) convey very different impressions due to the different postures adopted by those cartoon devices.
20. For these reasons, the subject mark is debarred from registration, in respect of the application in Class 25, by virtue of section 12(3). I accordingly refuse the application under section 42(4)(b) of the Ordinance.
21. In this decision I have considered all documents filed by the applicant and all oral and written submissions made in relation to this application. I draw the applicant's attention to the provisions under Trade Marks Rule 91(1) and (4), Cap. 559A.

Lavinia Chang

for Registrar of Trade Marks

26 June 2006