

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO. : 300449307AA**

**MARK :**



**APPLICANT : GA MODEFINE S.A.**

**CLASS : 3**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. This is an application by GA MODEFINE S.A. (“the Applicant”) made on 30 June 2005 to register the following mark (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”):



2. Registration is sought in respect of “soaps; perfumery, essential oils, cosmetics; hair lotion; dentifrices” in Class 3. It is a divisional application derived from an application bearing application number 300449307.
3. Objection was raised against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade mark (the “cited mark”):

Cited Mark



Trade mark :

Registration no. : 1997B06163

Class no. : 3

- The date of registration of the cited mark is 14 February 2005. It is registered in relation to “soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; skin creams and lotions; preparations for the bath and shower” in Class 3.
4. The objection under section 12(3) has been maintained at the examination stage. The Registrar however indicated that the objection could be overcome by providing written consent from the owner of the cited mark.
  5. On 15 January 2007, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 5 July 2007 at which Mr Kenny Leung of Wenping & Co. appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.
  6. The applicant has not filed any evidence of use of the subject mark. I therefore only have the *prima facie* case to consider.

### **Decision**

7. Section 12(3) of the Ordinance provides that:

“A trade mark shall not be registered if–

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

“For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the

circumstances, including whether the use is likely to be associated with an earlier trade mark.”

9. An “earlier trade mark” is defined in section 5, the relevant part of which states :

“(1) In this Ordinance, "earlier trade mark", in relation to another trade mark, means–

(a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any.”

10. As the cited mark has a date of application for registration earlier than that of the subject mark, it is an “earlier trade mark” in relation to the subject mark.

11. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994<sup>1</sup>, which implements Article 4(1)(b) of the European Trade Marks Directive<sup>2</sup>. In determining the question under section 12(3) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C.117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R.723. According to these cases :

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel BV v Puma AG*);

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<sup>1</sup> Section 5(2) of the UK Trade Marks Act 1994 provides as follows –

"(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

<sup>2</sup> Article 4(1)(b) of the European Trade Marks Directive 89/104/EEC of 21 December 1988 provides –

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

.....

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

- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question (*Sabel BV v Puma AG*), who is deemed to be reasonably well informed and reasonably observant and circumspect – but who rarely has the chance to make direct comparison between different marks and instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*);
  - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*);
  - (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*);
  - (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
  - (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it (*Sabel BV v Puma AG*);
  - (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b) (*Sabel BV v Puma AG*);
  - (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode v Adidas*);
  - (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*).
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12. Section 12(3) essentially prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of its being similar to an earlier trade mark and because it is to be registered in respect of goods or services the same as or similar to those of the earlier trade mark. I must therefore consider whether there are similarities between the subject mark and the cited mark and similarities in the goods that, cumulatively, lead to a likelihood of confusion. According to section 7(1) of the Ordinance, in assessing the likelihood of confusion, the Registrar may take into account all factors relevant in the circumstances.

#### *Comparison of marks*

13. In comparing the marks concerned, I must have a global appreciation of the visual, aural and conceptual similarity of the marks in question, based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. I must also have regard to the perception of the marks in the mind of the average consumer of the goods in question.
14. The goods in issue are soaps; perfumery, essential oils, cosmetics; hair lotion; and dentifrices. The average consumer of these goods is the public at large, who is deemed to be reasonably well informed and reasonably observant and circumspect. I would expect consumers to exercise a modicum of care in the purchase of these goods commensurate, no doubt, with the nature of the actual goods being purchased and the amount being spent.
15. The subject mark comprises the letters “E” and “A” sitting on top of the numeral 7. The cited mark only contains the letters “E” and “A”. In both marks, the letters “E” and “A” are arranged in the same order.
16. The applicant submits that according to the Concise Oxford Dictionary of Current English (8<sup>th</sup> edition, 1990), the common element, the letters “EA”, is an abbreviation of the word “each” which is a common word used by traders in the ordinary course of business and is, therefore, non-distinctive in character. On that basis it is further submitted that the average consumer would pay more attention to another element, i.e. the numeral 7, in the subject mark.

17. I do not accept the applicant's submission. I bear in mind that a mark consisting only of two letters is not amongst the most distinctive of marks. However, it does not occur to me that the consumer would, on seeing "EA" in relation to the goods in question, apprehend the letters as an abbreviation for the word "each". The letters "EA" have no obvious meaning in relation to soaps, perfumery, essential oils, cosmetics, hair lotion and dentifrices. In my view, "EA" is distinctive in relation to the goods in respect of which the cited mark is registered. "EA" is the sole identifying element in the cited mark.
18. Turning to the subject mark, it comprises the letters "EA" and the numeral 7. The "EA" element comes in the upper part of the subject mark. On first impression, "EA" stands out from the subject mark and is similarly considered distinctive in relation to the goods applied for in the subject application. I have not overlooked the fact that the subject mark also consists of the numeral 7. However, the numeral 7 being in the lower part of the subject mark strikes me as being subsidiary to the element "EA". For Class 3 items, I do not consider numerals are particularly distinctive. Of themselves, they have nothing that hooks onto the mind and memory of the consumers readily. I would also add that in the abstract, two apparently random letters are more likely to have an effect upon the recollection than a numeral when used in relation to a trade mark. In my view, the "EA" element, rather than the numeral 7, is more likely to draw the relevant consumer's attention, be taken in and stay longer in their memory. I therefore find that "EA" is the dominant and distinctive component of the subject mark. Consequently, I take the view that the subject mark and the cited mark share obvious conceptual similarity.
19. Visually, the most eye-catching element in the subject mark is the letters "EA" which is identical with the cited mark. The applicant submits that because the letters "E" and "A" appearing in the cited mark are linked together, the marks in question can thus be differentiated. I am not convinced by the applicant's submission. Although the letters "EA" in the cited mark are presented with a degree of stylization, they would nevertheless be seen as the letters "EA" which are the same as the most prominent element in the suit mark. As pointed out in paragraph 23 of *Sabel BV v Puma AG*, consumers normally perceive a mark as a whole and do not proceed to analyse it in various details. On the basis of overall impression and having taken into account of imperfect recollection, it seems to me that the respective marks are visually similar. Aurally, having shared the

prominent element “EA”, they are on the whole phonetically similar.

20. Considering the trade marks in their entirety and taking into account the likely perception of the average consumers in relation to the goods, I find the respective trade marks similar.

#### *Comparison of goods*

21. The subject application is applied to be registered in respect of “*soaps; perfumery, essential oils, cosmetics; hair lotion; dentifrices*” and the cited mark is registered in respect of “*soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; skin creams and lotions; preparations for the bath and shower*”. The applied for goods are therefore identical to those for which the cited mark is protected and the applicant has not argued otherwise.

#### *Likelihood of confusion*

22. Confusion in the context of section 12(3) of the Ordinance refers to confusion on the part of the public as to origin of the goods in question. I have to assess the likelihood of confusion globally, taking into account all relevant factors, and judging the matter through the eyes of the average consumers of the goods in question.
23. As stated earlier, the relevant consumers of both the applied for goods and the goods of the cited marks are members of the general public in Hong Kong, and I consider that their level of attention and care in relation to the purchase of these goods are merely average.
24. Having regard to the conceptual, visual and aural similarities and dissimilarities between the subject mark and the cited mark, the identity in the goods designated by the marks, bearing in mind the principles set out in paragraph 11 above and taking all relevant factors into account, I consider that when the subject mark is used in relation to the applied for goods, the average consumer would be confused into believing that the respective goods provided under the subject mark and the cited mark come from the same or economically linked undertakings. The addition of the indistinctive numeral 7 to the subject mark having the same letters

“EA” as the cited mark might well be supposed by the consumers to have been made by the owner of the cited mark to denote a new line of its products. Therefore, an objection under section 12(3) is established. As no letter of consent from the owner of the cited mark has been filed by the applicant, I am unable to waive the section 12(3) objection under section 12(8) of the Ordinance.

### **Conclusion**

25. In this decision, I have carefully considered all the documents filed by the Applicant, together with all written submissions that it has made. For the reasons given, the subject mark is precluded from registration by section 12(3) of the Ordinance. As a result, the subject application is refused under section 42(2)(b) of the Ordinance.

Jessica Law  
For Registrar of Trade Marks  
17 August 2007