

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

**OPPOSITION TO TRADE MARK APPLICATION NO. 300462843**

**MARK:**



**CLASSES: 7, 8 and 11**

**APPLICANT: DONG WOO INDUSTRIAL COMPANY LIMITED**

**OPPONENT: PACIFIC TECHNOLOGIES LTD**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 22 July 2005, the applicant filed an application for registration (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for the registration of the following mark :-



(“the suit mark”).

2. Registration is sought in respect of the following goods in classes 7, 8 and 11:-

Class 7

electric washing and drying machines, electric clothes washing machines, electric clothes dryers, electric dish washers; compressors (machines); pumps (machines), electric pumps; mixing, cutting and chopping machines, blender machines, electric juice extractors, electric food processors, electric meat grinders, electric can openers,

electric knife sharpeners, electric coffee mills, electric ice crushers, waste disposal machines; electric apparatus for cleaning, electric vacuum cleaners, electric floor polishers; incubators for eggs; electrical household appliances for cleaning clothes, electrical household appliances for cleaning windows; home electricity generation system; blowing machines; electric blenders for household purposes, electric food mixers; electric paper shredders; electric welding machines; all included in Class 7.

#### Class 8

hand tools and implements; electric razors, beard clippers, crimping irons, curling tongs.

#### Class 11

ventilating apparatus and instruments, electric fans, ventilating fans, electric air purifiers, extraction hoods for cookers (range hoods), electric dehumidifiers, electric humidifiers, air curtains, air handling units, ceiling fans, roof ventilators, electrostatic precipitator, ventilating apparatus and installations; installations for cooking, automatic bread makers for domestic use, electric kettle, electric rice cooker, gas fuelled rice cookers, slow cookers, electric roasters, ovens for cooking, toasters, coffee makers, electric cooking stoves, electric thermo pots, gas cookers, induction heating hobs, electric barbecue griddles, microwave ovens, gas cooking stoves, gas cooking stoves with ovens, electric food-pans, sinks, metallic sinks; installations for lighting, incandescent lamp, screw-in fluorescent lamp, fluorescent lamp, tungsten halogen lamps, flash lights, fluorescent lanterns, lamps, fluorescent lighting fixtures, dynamo lighting sets for bicycles, germicidal lamps, lighting fixtures; installations for refrigeration and freezing, refrigerators, freezers, cold and/or hot water dispensers, freezing and/or refrigerating showcases, electric water coolers, electric ice makers; installations for heating, cooling and air-conditioning, air conditioners, fan coil units for air-conditioning, evaporative air refreshing apparatus, stoves, electric space heaters, electric blankets, electric floor carpets, kerosene fan heaters, electric foot warmers, gas cordless warmers; installations for sanitary purposes, electric bidets, toilets, washing toilet seats, portable toilets, sewage aeration treatment systems, water-purifiers, incinerators (trash burners), kitchen waste processors, sauna baths, bathtubs, bath installations, electric home shower; electric water heaters; gas water heaters, gas instantaneous water heaters; hand dryers, dish dryers, electric hair dryers, clothes dryers; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and/or sanitary purposes; parts and

fittings for the aforesaid goods; all included in Class 11.

3. Particulars of the subject application were published on 19 August 2005, and the opponent filed a notice of opposition to the subject application on 22 December 2005.

4. The opposition hearing took place before me on 11 October 2011. Mr. Kent Yee, counsel, instructed by Messrs. T.C. Foo & Co. represented the applicant. The opponent did not appear.

### **Grounds of opposition**

5. The grounds on which the Opponent opposes registration of the suit mark as stated in the notice of opposition are under sections 11(1)(a), 11(4)(b), 11(5)(a), 12(3) and 12(5) of the Ordinance.

### **Counter-statement**

6. The applicant filed a counter-statement on 20 March 2006 in response to the opponent's notice of opposition.

### **Evidence**

7. Under Rule 18 of the Trade Marks Rules (Cap.559, sub. leg.)(“Rule/s”), the opponent filed a statutory declaration from Raymond Anthony Nugent, the managing director of the opponent, together with exhibits, which was declared on 5 June 2007 (“Nugent’s statutory declaration”). Under Rule 19, the applicant filed a statutory declaration from Lam Wai Jan, the director of the applicant, together with exhibits, which was declared on 11 January 2008 (“Lam’s statutory declaration”).

### **Relevant date**

8. The relevant date for considering the opposition is 22 July 2005, the date of the subject application for registration.

### **Opposition under section 12(3) of the Ordinance**

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

“A trade mark shall not be registered if –

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

10. According to section 7(1) of the Ordinance, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

11. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994 which implements Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1988 of the Council of the European Communities. In determining the issue under section 12(3), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. They are as follows:

- (a) The likelihood of confusion must be appreciated globally, taking account of all the relevant factors.
- (b) The matter must be judged through the eyes of the average consumer of the goods in issue, who is deemed to be reasonably well informed and reasonably observant and circumspect.
- (c) In order to assess the degree of similarity between the marks concerned the court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into account the nature of the goods in question and the circumstances in which they are marketed.

- (d) The visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion.
- (e) The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details.
- (f) There is a greater likelihood of confusion where the earlier trademark has a highly distinctive character, either *per se* or because of the use that has been made of it.
- (g) The average consumer 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; further the average consumer's level of attention is likely to vary according to the category of goods in question.
- (h) Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*.
- (i) Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose of the assessment.
- (j) But the risk that the public might believe that the goods come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.

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 the same as or similar to those the subject of the earlier trade mark. I must therefore consider whether there are similarities between the suit mark and the opponent's mark and the goods covered, and whether they would combine to create a likelihood of confusion.

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

Trade Mark	Registration No.	Date of Registration	Class	Goods
PACIFIC	300102590	29.10.2003	8	hand tools and implements; electric razors, beard clippers, crimping irons and curling tongs.
			9	electric circuit noise reduction apparatus; magnetic identity cards; camera film; cases for photographic apparatus and instruments; photographic transparencies and photographic films prepared for exhibition purposes; projection screens; light meters; filters and holders therefor; slide frames and mounts; magazines, files and boxes for slides and for photographic negatives; reels for cinematographic film; lightboxes; apparatus for cutting and/or splicing film; batteries; battery chargers; timers; thermometers; fitted bags and cases all for photographic apparatus; photographic flash lighting apparatus;

Trade Mark	Registration No.	Date of Registration	Class	Goods
				refractors; photographic films and slides prepared for exhibition, photographic transparencies; monopods and tripods; diffusers and reflectors; photocopiers.

14. Though the opponent's mark was not a registered trade mark as at the relevant date, Mr Yee on behalf of the applicant accepts that by virtue of section 5(2) of the Ordinance, the opponent's mark is an earlier trade mark in relation to the suit mark.

*Opponent's evidence of use*

15. According to paragraph 4 of Nugent's statutory declaration, the opponent alleges that it and/or its affiliated company first used the mark "PACIFIC" in the United Kingdom in June 2001 in respect of a wide range of products including but not limited to electrical products such as small domestic appliances, televisions, hi-fis, radios, CD players, DVD players and so on. The approximate annual sales of the opponent's goods sold under the mark "PACIFIC" in the United Kingdom for the period from 2001 to 2005 were set out in paragraph 4 of the statutory declaration without any documentary evidence in support. Further, no sales figures of the opponent's goods bearing the mark "PACIFIC" in Hong Kong were provided.

16. The opponent also made a bare assertion in paragraph 5 of Nugent's statutory declaration that it and/or its affiliated company has put considerable efforts and money to promote the mark "PACIFIC" in the United Kingdom. The "PACIFIC" brand has allegedly been seen by over 500 million people and over one in five of the United Kingdom population has purchased a "PACIFIC" product over the period of four and a half years since the launch of the mark "PACIFIC" in the United Kingdom in June 2001. No evidence has been produced by the opponent to show that there was any advertising or promotion of the mark "PACIFIC" in Hong Kong before the relevant date. Neither is there any suggestion that the reputation of the

mark “PACIFIC” in the United Kingdom, if any, had been spilled over into Hong Kong before the relevant date.

17. The opponent claims in paragraph 6 of Nugent’s statutory declaration that it and/or its affiliated company has been using the mark “PACIFIC” in Hong Kong. Mr Nugent explains that the opponent’s goods sold under the mark “PACIFIC” are sourced throughout the PRC and shipped through Hong Kong to the United Kingdom. In support of this allegation, a bundle of container load plans for May and December 2004, February, March and May 2005 (excluding the ones dated after the relevant date) was adduced in the exhibit “RAN-2” to Nugent’s statutory declaration. Out of this large bundle, only two container load plans refer to “PACIFIC BABY WAKEY” in a few items under the “Description of Goods” column. The mark “PACIFIC” cannot be found in the majority of container load plans or other documents at “RAN-2”. I have no idea as to whether the bulk of the container load plans is in relation to any goods bearing the mark “PACIFIC”. Further, the container load plans only show that certain goods were shipped through Hong Kong to the United Kingdom. There is nothing to suggest that those goods reached the Hong Kong market through wholesaling, retailing or other means. In short, the evidence in “RAN-2” does not show use of the mark “PACIFIC” in Hong Kong by the opponent before the relevant date.

18. According to paragraph 7 of Nugent’s statutory declaration, the opponent asserts that it and/or its affiliated company has sold its goods under the mark “PACIFIC” in Hong Kong. Altogether four copy credit notes were produced in “RAN-3” to prove the said sales. Out of the four credit notes, three of them were issued before the relevant date on 19 January, 22 March and 26 May 2005 respectively. All the credit notes were issued by Nisko Cargo Consolidation Limited (“Nisko”) in Hong Kong to Schneider UK Ltd (“Schneider”), a sister company of the opponent in the UK. It is stated in the credit notes that Nisko has sold the Schneider’s goods under the brand name “PACIFIC” to Nisko’s client, namely Uwist Trading Company Limited (“Uwist”) in Hong Kong. Pursuant to paragraph 23 of Lam’s statutory declaration filed on behalf of the applicant, the applicant’s solicitors have conducted a search of the company records of Uwist filed with the Companies Registry, and a copy of the record was produced at the exhibit “LWJ-11” to Lam’s statutory declaration. The record indicates that Uwist was dissolved on 30 January 2004, well before the dates when the two pre-relevant date credit notes were issued. No reply evidence or explanation has been advanced by the opponent to clarify this point in face of the evidence on dissolution filed by the applicant.

19. The final allegation of use in Hong Kong can be found in paragraph 8 of Nugent's statutory declaration in which the opponent says that it and/or its affiliated company has also offered its goods for sale under the mark "PACIFIC" at a retail outlet in Hong Kong. This is a bold assertion lacking both details and evidence in support. It is entirely unclear what goods were sold and when the alleged sales took place.

20. Having taken into consideration all the opponent's evidence, I do not find that there is any evidence to show that the opponent has used the mark "PACIFIC" in Hong Kong in respect of any goods prior to the relevant date. It follows that the distinctiveness of the opponent's mark "PACIFIC" has not been enhanced through any use in Hong Kong.

#### *Comparison of Marks*

21. Mr Yee for the applicant accepts that due to the inclusion of the English word "Pacific" in the suit mark, the suit mark is similar to the opponent's mark.

22. Speaking for myself, the suit mark is a composite mark consisting of the word "Pacific", a device and the word "DONGWOO" underneath the device. The opponent's mark is a pure word mark comprising the word "PACIFIC". Both the stylised device and the invented word "DONGWOO" in the suit mark are not in any way descriptive of the subject classes 7, 8 and 11 goods and therefore possess a reasonably high degree of inherent distinctiveness.

23. Visually speaking, in my view, there is only a low level of visual similarity between the suit mark and the opponent's mark although there is clearly the presence of the common word "PACIFIC" in them. The device element together with the word "DONGWOO" take up about one third of the whole composite mark and have a certain appeal to the eye even though the word "Pacific" is undoubtedly the most prominent feature in the mark. The first impression given to me by the suit mark is that it is a composite mark consisting of the words "DONGWOO", "Pacific" together with a distinctive device. The opponent's mark is at first glance a compact mark comprising solely the word "PACIFIC". As such, on the whole, the suit mark and the opponent's mark convey to certain extent different visual impression.

24. In terms of conceptual comparison, while the word "DONGWOO" is as a matter of fact the English name adopted by the applicant, the word itself has no

dictionary meaning and is inherently distinctive. Although the word “DONGWOO” is much less eye-catching than the word “PACIFIC” because of its relative small size, it can be seen as part of the composite mark and cannot be ignored totally. The idea of “Dongwoo Pacific” is somehow different from “Pacific”. For my part, the level of conceptual similarity is moderate.

25. Aurally, I consider that the sharing of the common word “Pacific” only gives a moderate degree of aural similarity between the marks. The device element in the suit mark will not form part of the oral reference or likely pronunciation. However, with the addition of the word “Dongwoo”, though less prominent than the word “Pacific”, to the suit mark, there is a degree of dissimilarity between the oral references of the marks.

#### *Comparison of goods*

26. Guidance on the approach to be adopted in comparing goods and services is given in *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281, in which Mr. Justice Jacob (as he then was) considered, at page 296, the following factors to be relevant in determining whether or not there is similarity :

- (i) The respective uses of the respective goods or services;
- (ii) The respective users of the respective goods or services;
- (iii) The physical nature of the goods or acts of service;
- (iv) The respective trade channels through which the goods or services reach the market;
- (v) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (vi) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

27. It is also stated in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, supra, at paragraph 23, that in assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary. The goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility of those goods lies with the same undertaking (*Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06).

*The applicant's application for registration in respect of Class 8 goods*

28. At the hearing, Mr Yee indicated that the applicant will not seek registration in class 8 goods and will accordingly abandon the application so far as class 8 is concerned.

*The applicant's application for registration in respect of Class 7 goods*

29. I shall first consider whether the applicant's class 7 goods under application are similar to the opponent's class 8 goods covered by the earlier mark. The applicant's class 7 goods encompass different types of electric machines and electrical appliances. There are electrical appliances for cleaning purposes including washing and drying machines, clothes washing machines, dish washers, household appliances for cleaning windows, clothes, electric apparatus for cleaning, electric vacuum cleaners and so on. The second type of electrical appliances in question is those for the kitchen and food processing purpose like mixing, cutting and chopping machines, blender machines, juice extractors, food processors, meat grinders, can openers, knife sharpeners, coffee mills, ice crushers and food mixers. Some miscellaneous machines for both household and industrial purposes are also covered like electric pumps, compressors, paper shredders, welding and blowing machines.

30. The opponent's class 8 goods are broadly speaking hand-operated implements used as tools in the respective professions. For example, they include beard clippers, crimping irons and curling tongs used by the hairdressers in the hair salons. The specification "hand tools and implements" in the opponent's class 8 goods may also cover other types of hand tools such as cattle skinning instruments, appliances and instruments for slaughtering butchers' animals, hammers, hammer

sharpeners, drawing knives, jig-saws, carpenters' augers, clamps (for carpenters or cooper) and so on used by different tradesmen such as craftsmen, carpenters and butchers (see the List of Goods in Class 8, Nice Classification, the Eighth Edition).

31. For my part, the nature and intended use of the applicant's class 7 goods are electrical appliances and machines for both household and industrial purposes whereas those of the opponent's class 8 goods are mainly hand-operated tools used in the respective professions. While the users of the applicant's class 7 goods may involve a mixture of professionals and the public at large, the users of the opponent's class 8 goods would include mainly the tradesmen in a wide range of professions. Further, in my opinion, trade channels are in the main different. The different types of electrical appliances and machines contained in the applicant's class 7 goods would be available in electrical shops or retail outlets specialised in selling electrical appliances and machines. The hand tools and implements are sold in specialised hand tools shops. They do not appear to be in competition with each other or are complementary. I therefore find the applicant's class 7 goods under application not similar to the opponent's class 8 goods as covered by the specifications of the earlier mark.

32. I move on to consider the similarity between the applicant's class 7 goods and the opponent's class 9 goods. Most of the opponent's class 9 goods are photographic and cinematographic products and apparatus such as camera film, cases for photographic apparatus and instruments, photographic transparencies and films, fitted bags and cases for photographic apparatus, photographic flash lighting apparatus, refractors, slides, monopods and tripods, diffusers and reflectors, apparatus for cutting and/or splicing film, photocopiers and so on. Apart from the aforesaid, electric circuit noise reduction apparatus and magnetic identity cards are also included in the specifications of the opponent's class 9 goods. It seems clear to me that the intended purposes, uses and channels of trade between the applicant's class 7 goods as analyzed above and the opponent's class 9 goods are different although the users of the respective goods would be the same consisting of both the public and professionals. Overall, I do not consider the respective goods similar.

*The applicant's application for registration in respect of class 11 goods*

33. In my view, the applicant's class 11 goods cover electrical appliances and apparatus for ventilating such as ventilating apparatus and instruments, electric fans, ventilating fans, electric air purifiers, hoods for cookers. Also included are

electrical apparatus for cooking such as automatic bread makers for domestic use, electric kettles, electric rice cookers, roasters, ovens, toasters, coffee makers, cooking stoves, thermo pots, microwave ovens and so on. The third type of electrical apparatus that can be found in the applicant's class 11 goods are those for lighting including different types of lamps, fluorescent lanterns and lighting fixtures. There are also apparatus for heating, refrigerating, drying, water supply and sanitary purposes. For example, refrigerators, freezing and/or refrigerating showcases, electric water coolers, air-conditioners, heaters, washing toilet seats, portable toilets, sewage aeration treatment systems, water-purifiers, hand dryers, dish dryers, bathtubs and so on are within the specifications of the applicant's class 11 goods. I do not find the applicant's class 11 goods similar to the opponent's class 8 goods which are hand tools and implements and the class 9 goods which are mainly photographic and cinematographic products and apparatus given the different intended purposes, nature, uses and channels of trade in relation to the respective goods.

#### *Likelihood of confusion*

34. The likelihood of confusion must be appreciated globally, taking account of all relevant factors all of which have a degree of interdependency. The matter must be judged through the eyes of the average consumer of the goods who is deemed to be reasonably well-informed and reasonably observant and circumspect. The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the actual goods concerned. Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A greater degree of similarity between the marks may be offset by a lesser degree of similarity between the goods.

35. I have found above that the goods are not similar, the marks are visually similar to a low degree and are aurally and conceptually similar to a moderate degree. The relevant consumers for the goods in question are likely to pay a reasonable degree of care and attention in purchasing the goods. Many of the goods in issue are durables. The consumers have to make sure that the goods are reliable and fit for purpose. They are not day to day items that will be purchased on impulse. The goods in question are likely to be subjected to a careful visual examination by any intending purchaser, not usually sold over the phone. To a certain extent, the visual impact of the respective marks is of more importance than aural similarity although it cannot be ignored completely.

36. Having regard to the considerations I have set out above, I take the view that when the suit mark is used in relation to the applied for goods in classes 7 and 11, the average consumers would not be confused into thinking that those goods and the opponent's classes 8 and 9 goods come from the same or economically-linked undertaking.

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

### **Opposition under section 11(1)(a) of the Ordinance**

38. Section 11(1)(a) provides that signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark") shall not be registered. Section 3(1) defines a "trade mark" 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.

39. In my judgment, the opposition is based on an absolute ground for refusal which is concerned with something inherent in the mark itself. The essence of objection under section 11(1)(a) is that a sign cannot be registered if it does not possess a distinctive character, inherent or acquired, so that it can carry out the essential function of a trade mark which is to distinguish the goods or services of one undertaking from those of other undertakings (see *Kerly's Law of Trade Marks and Trade Names*, 14<sup>th</sup> Edition ("Kerly's"), paragraph 8-061). Neither in its pleadings nor in its evidence has the opponent explained why the suit mark does not satisfy the requirements of the definition of a trade mark under section 3(1) of the Ordinance in that it is not capable of distinguishing the applicant's goods from those of other undertakings or it is incapable of being represented graphically. It appears that the objection is taken under this section because of the alleged confusing similarity between the suit mark and the opponent's mark. The opposition under this ground is therefore misconceived and must fail.

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

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

41. Similarly, the opposition under this section is based on an absolute ground for refusal which is concerned with deceptiveness inherent in the mark itself,

as opposed to deception caused by the similarity of the mark to another (Kerly's, supra, paragraph 8-204). The opponent has not specifically pointed out in its pleadings or evidence how the suit mark itself is likely to deceive the public. The opponent's objection under section 11(4)(b) appears to have grounded on the basis of the confusing similarity between the suit mark and the opponent's mark. It is the opponent's pleaded case that use of the suit mark is likely to deceive the public that the products bearing the suit mark originate from the opponent or that the applicant has some connection with the opponent or that the suit mark is derived from the opponent's mark. The opposition under this section is therefore misconceived and must fail.

### **Opposition under section 11(5)(a) of the Ordinance**

42. Section 11(5)(a) of the Ordinance provides that a trade mark shall not be registered if its use is prohibited in Hong Kong under or by virtue of any law.

43. The objection is taken under section 11(5)(a) because of the alleged goodwill and reputation of the opponent's mark that use of the suit mark would be prevented by virtue of the law of passing off. This ground of opposition should be dealt with under section 12(5)(a) of the Ordinance.

44. The learned author of Kerly's, supra, in discussing section 3(4) of the UK Trade Marks Act 1994 (which is similar to our section 11(5)(a) of the Ordinance) said at paragraph 8-212 as follows -

“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.”

45. Equally, the opposition under this section is misconceived and therefore must fail.

### **Opposition under section 12(5)(a) of the Ordinance**

46. Section 12(5)(a) of the Ordinance provides, *inter alia*, as follows:

“(5) ... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

- (a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off); ...

and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an “earlier right” in relation to the trade mark.”

47. A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of Hong Kong Vol 15(2)* at paragraph 225.001. The guidance takes account of speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C. 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731, and is as follows :

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

- (1) the plaintiff’s goods or services have acquired a *goodwill or reputation* in the market and are known by some distinguishing feature;
- (2) there is a *misrepresentation* by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) the plaintiff has suffered or is likely to suffer *damage* by reason of the erroneous belief engendered by the defendant's misrepresentation.

48. I have analysed the opponent’s evidence of use in paragraphs 15 to 20 above. I do not find that there is any evidence to show that the opponent has used the mark “PACIFIC” in Hong Kong in respect of any goods prior to the relevant date. Having taken into account the opponent’s evidence fully and carefully, I am not satisfied that the opponent has established that by the relevant date, it has enjoyed a goodwill or reputation attached to the opponent’s goods in the mind of the purchasing public by association with the opponent’s mark “PACIFIC”. It follows that there was no relevant goodwill or reputation of the opponent as at the relevant date which could be damaged by any misrepresentation (if any) on the part of the applicant.

49. The ground of opposition under section 12(5)(a) of the Ordinance

therefore is not made out.

### **Costs**

50. The applicant has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the successful party is entitled to its costs. I accordingly order the opponent pays the costs of these proceedings.

51. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

*Original signed*

(Ms Fanny Pang)  
p. Registrar of Trade Marks  
21 November 2011