

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300484038AB
MARK : FOCACCINO
APPLICANT : MILANO FOOD CONCEPTS PRIVATE LIMITED
CLASS : 43

STATEMENT OF REASONS FOR DECISION

Background

1. This is an application by Milano Food Concepts Private Limited (“the Applicant”) under the Trade Marks Ordinance (Cap. 559) (the “Ordinance”) to register the mark **FOCACCINO** (“the subject mark”) in respect of “restaurant services, including catering” in Class 43 (the “subject application”). It is a divisional application of an application filed on 25 August 2005.
2. 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

A **FOMACCINO**
B **FOMACCINO**

Trade mark :
Registration no. : 300047709
Date of registration : 15 July 2003
Class no. : 43
Specification : provision of food, drinks, dietetic beverages and health food; restaurant, fast food restaurant, café, cafeteria, self-service restaurant; food catering services; all included in Class 43.

3. The objection under section 12(3) has been maintained at the examination stage. On 2 November 2007, the Applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 16 May 2007 at which

Ms Fiona Yip of Messrs. Sit Fung Kwong & Shum appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

4. The Applicant has not filed any evidence of use of the subject mark. I therefore only have the *prima facie* case to consider.

Decision

5. 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.”

6. 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.”

7. 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.”

8. 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.
9. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994¹, which implements Article 4(1)(b) of the European Trade Marks Directive². In 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*);
 - (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*);

¹ 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."

² 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."

- (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*).
10. 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 services 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

11. In comparing the marks concerned, I must have a global appreciation of the visual, aural and conceptual similarity of the marks in question, taking into account the overall impression given by the marks and 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 services in question.
12. The services in issue are restaurant and catering services. The average consumers of these services are the members of the public, who are deemed to be reasonably well informed and reasonably observant and circumspect.
13. The subject mark “FOCACCINO” and the cited mark “FOMACCINO” are pure word marks without any device. Both of them consist of 9 capital letters in plain font without any stylization. The only difference between the two marks lies in the spelling of their third letter and the remaining letters are all identical. I note the Applicant’s argument that the difference between “C” and “M” causes the subject mark and the cited mark to be visually different. However, I consider that such visual difference is so small and insignificant that it may not be noticeable to the average consumer when the principle of imperfect recollection is taken into account. In my view, the average consumer would, on first impression, find the subject mark and the cited mark visually very similar.
14. As far as phonetic difference is concerned, although the subject mark and the cited mark are not English dictionary words, I consider that the average consumer would treat both of them as a 4-syllable word, one pronounced as “FO-CA-CCIN-O” whereas the other one as “FO-MA-CCIN-O”. There is no dispute that three out of the four syllables are pronounced the same. While I note the Applicant’s argument that the sound of “CA” and “MA” are different, they, to my mind, are not totally dissimilar as both of them share the same vowel. Having taken into account the difference between “CA” and “MA” in the second syllable, I still find that the difference in pronunciation between the subject mark and cited mark as a whole is insignificant. I consider that “FOCACCINO” and “FOMACCINO” to a large extent sound similar to the average consumer.
15. The Applicant submitted that the cited mark “FOMACCINO” has no dictionary or known meaning but the subject mark is an invented word derived from two

Italian words “Focaccia” and “Cappuccino”. The Applicant also submitted that the public in Hong Kong would understand the underlying meaning of the subject mark because it was mentioned in some articles in newspaper and magazines that the word “FOCACCINO” is formed by combining “Focaccia” and “Cappuccino”. The Applicant therefore argued that the subject mark and the cited mark would be regarded as conceptually different. I, however, cannot agree with that. Conceptual difference or similarity of two marks must be assessed by reference to the overall impressions created by them. In the present case, both “FOCACCINO” and “FOMACCINO” have no English dictionary meaning. Nor do they, whether as a foreign word or an invented word, convey any obvious meaning to the general public in Hong Kong. There is no evidence before me that the average consumer in Hong Kong would understand the above underlying meaning of “FOCACCINO” as submitted by the Applicant. I, therefore, consider unlikely that the average consumer would perceive the subject mark and the cited mark as conceptually different.

16. Having considered the similarities and differences between the subject mark and the cited mark, and taking into account the overall impression created by them, I consider that the subject mark and the cited mark are substantially similar.

Comparison of goods

17. The subject application is applied to be registered under Class 43 in respect of “*restaurant services, including catering*” whereas the cited mark is registered under the same class in respect of “*provision of food, drinks, dietetic beverages and health food; restaurant, fast food restaurant, café, cafeteria, self-service restaurant; food catering services*”. The applied-for services are therefore identical to those for which the cited mark is protected. The applicant has not argued otherwise.

Likelihood of confusion

18. 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 services 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 services in question.

19. As stated earlier, the relevant consumers of the services in question are members of the general public in Hong Kong, and I consider that their level of attention and care in relation to these services are merely average.
20. Having regard to the visual, aural and conceptual similarities and dissimilarities between the subject mark and the cited mark, the identity in the services designated by the marks, bearing in mind the principles set out in paragraph 9 above and taking all relevant factors into account, I consider that when the subject mark is used in relation to the applied-for services, the average consumer would be confused into believing that the respective services provided under the subject mark and the cited mark come from the same or economically linked undertakings.

Reference to other registered marks on the register

21. The Applicant has drawn the Registrar's attention to the Applicant's trade mark "FOCACCINO" (Application no. 300484038AA) which was accepted for publication on 10 November 2006 despite the existence of the cited mark. The Applicant also submitted that the Applicant's trade mark "FOCACCINO & device" (Registration no. 300484047) under Classes 30 and 43 was allowed to co-exist with the cited mark. The Applicant also referred to the co-existence of the mark "Buccino" (Registration no. 200113539) and "Luccino & device" (Registration no. 200403956) both under Class 14. The Applicant therefore argued that, in view of the above registered marks, the Registrar should also allow the subject mark and the cited mark to co-exist.
22. I note that the mark "FOCACCINO" (Application no. 300484038AA) was accepted for publication in respect of the goods under Class 30 whereas the cited mark was registered in respect of the services under Class 43. I also note the obvious visual difference between the mark "FOCACCINO & device" and the cited mark, as well as between the marks "Buccino" and "Luccino & device". In any event, I do not see how the co-existence of these marks could have any bearings on the present case. It is well established that each case must be considered on its own merits and not by reference to other registered marks (*British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305). I therefore disregard the state of the register evidence and do not find that the marks quoted by the Applicant are of any relevance or assistance to the subject

application.

Conclusion

23. 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(4)(b) of the Ordinance.

Patrick Yeung
for Registrar of Trade Marks
29 October 2007