

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

**APPLICATION NO.: 300544365**

**MARK: MIMI MATERNITY**

**CLASS: 25, 35**

**APPLICANT: CAVE SPRINGS, INC.**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 8 December 2005, Cave Springs, Inc. (“the Applicant”), represented by Messrs Lovells, applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“the Ordinance”), to register the following mark (“the subject mark”):

**MIMI MATERNITY**

2. The goods and services in respect of which registration is sought are:

Class 25: clothing, footwear, headgear, maternity clothing, nursing apparel, belts, stockings, hats, caps, scarves, shawls.

Class 35: retail store services, mail-order catalog services, and computerized online retail services, all relating to clothing, footwear, headgear, maternity clothing, nursing apparel, belts, stockings, hats, caps, scarves, shawls.

3. At the examination stage, objection was raised against the subject application under section 12(3) of the Ordinance in respect of the following registered trade mark (“the cited mark”):

Cited Mark



Trade mark :  
Registration no. : 19741111  
Class : 25  
Goods : clothing, boots, shoes, sandals and slippers  
Owner : China Resources (Holdings) Company Limited  
Date of application and registration : 24-05-1974

4. On 20 August 2007, the Applicant filed evidence in support of the subject application, which comprises a statutory declaration made on 10 August 2007 by Ronald Masciantonio, the Assistant Secretary of the Applicant, with a view to show that there has been honest concurrent use of the subject mark and the cited mark.
  
5. A hearing on the registrability of the subject mark took place before me on 20 November 2007, at which Mr Allan Woodley of Messrs Lovells appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

**Decision**

6. The Applicant considers that the subject application is not objectionable under section 12(3) of the Ordinance, and even if it is so objectionable, the subject mark should be allowed for registration pursuant to section 13 of the Ordinance. I will first consider whether the subject mark is objectionable under section 12(3) of the Ordinance.

*Section 12(3) of the Ordinance*

7. Section 12 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.

... ”

(8) Nothing in this section prevents the registration of a trade mark where the owner of the earlier trade mark or other earlier right consents to the registration.”

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. The cited mark has a date of application for registration earlier than that of the subject mark. It is therefore an “earlier trade mark” with respect to the subject mark for the purpose of section 5 of the Ordinance.
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*);
  - (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*);

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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."

- (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*).
12. Section 12(3) precludes a mark from registration if the use of it is likely to cause confusion on the part of the public, as a result of its being similar to an earlier trade mark and that it is sought to be registered in respect of goods or services the same as or similar to those registered under the earlier trade mark. I must therefore consider whether the similarities between the subject mark and the cited mark and the goods and services covered would combine to create 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 goods and services*

13. 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.

14. It is also stated in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, 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<sup>3</sup> and their method of use and whether they are in competition with each other or are complementary.

15. The subject application is made in respect of various goods and services in class 25 and class 35 specified in paragraph 2 above. In respect of the class 25 specification, the goods sought to be registered are “*clothing, footwear, headgear, maternity clothing, nursing apparel, belts, stockings, hats, caps, scarves, shawls*”. The cited mark is registered in respect of “*clothing, boots, shoes, sandals and slippers*” in the same class. The applied for goods and the cited goods overlap so far as clothing is concerned. The goods “*boots, shoes, sandals and slippers*” under the cited mark are covered by the term “footwear” in the specification of the subject mark. I find that these goods, too, are identical.

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<sup>3</sup> It has been suggested at paragraph 56 of *Sergio Rossi SpA v OHIM* (Case T-169/03, Court of First Instance of the European Communities) that the term “end users” is an incorrect translation, and should be replaced by the term “intended purpose” instead. In any event, the users of the respective goods are among the factors referred to in *British Sugar v James Robertson and Sons Ltd*.

16. At the hearing, Mr Woodley argues that the subject goods “*headgear*” is different from the cited goods “*clothing*”. Given also that the subject goods “*maternity clothing, nursing apparel, belts, stockings, hats, caps, scarves and shawls*” are not included in the cited specification, Mr Woodley contends that the goods applied for are not similar to the cited goods. I do not agree. In interpreting the specification, the terms are to be given their ordinary and natural meaning (*Ofrex v Rapesco* [1963] R.P.C. 169). It must also be borne in mind that where broad terms are involved, full effect must be given to the notional scope of the specification involved. Clothing and headgear share many of the characteristics set out in the *Treat/Canon* tests referred to paragraphs 13 and 14 above. Headgear may not only be seen as a means for protecting the head against weather influences, but also as a fashion article which is supposed to match the outfit. Their sales outlets are the same or at least closely connected. Moreover, it may not be always easy to draw a dividing line between clothing and headgear. A scarf, for instance, can be worn around the head, neck or shoulders and may, therefore, be termed clothing or headgear. I therefore find that “*clothing*” and “*headgear*” are similar to each other. The applied for “*hats*” and “*caps*” fall within the broad term of “*headgear*”. By the same token, I also find them to be similar to the cited goods “*clothing*”. Looking at the remainder of the specification of the application, that is to say, “*maternity clothing, nursing apparel, belts, stockings, scarves, shawls*”, all of them fall within the general descriptor “*clothing*”. They are thus identical to “*clothing*” in the cited goods.
17. Having regard to all the relevant factors relating to the goods, I consider that all the applied for goods in class 25 are identical or closely similar to “*clothing, boots, shoes, sandals and slippers*” covered by the cited mark.
18. I move on to compare the applied for services in class 35 with the cited goods in class 25. The applied for services in class 35 are “*retail store services, mail-order catalog services, and computerized online retail services, all relating to clothing, footwear, headgear, maternity clothing, nursing apparel, belts, stockings, hats, caps, scarves, shawls*”. The specification expressly states that the services are all related to the goods applied for in class 25. I have already come to the view that the goods applied for in class 25 are identical or closely similar to the goods covered by the cited mark (see paragraphs 15 and 16 above).

To put the matter another way, the applied for services involve the retail or sale of goods which are identical or closely similar to the goods covered by the cited mark. Taking the *Treat/Canon* criteria in the round, I am of the view that the uses of the respective goods and services are identical or closely similar. The applied for services in class 35 relate to clothing and footwear and so on and the cited goods in class 25 also relate to clothing and footwear. The cited goods can be sold and the applied for services can be provided to consumers through the same trade channel. The purchasers or users are likely to be the same. For these reasons, I find that the applied for services in class 35 are also similar to the goods “*clothing, boots, shoes, sandals and slippers*” covered by the cited mark.

19. There is Mr Woodley's submission that the trade channels adopted by the Applicant are different from that of the cited mark owner. Mr Woodley submits that the products under the applied for mark are only available for sale in Hong Kong via the Applicant's own website or via mail order from the website. On this basis, Mr Woodley asserts that there is no risk of any confusion or crossing of trade channels.
  
20. I have considered Mr Woodley's submission. However, in terms of the comparison between the goods and services under application and the goods covered by the cited mark, the current trade channels actually adopted are not decisive. The owner of the cited mark can adopt any form of sale practice that it considers appropriate, for instance, by putting its goods for sale via the Internet or via online mail order. The same is also true of the trade channels that can be used by the Applicant if the subject mark is allowed to be registered. The possibility of confusion arising cannot therefore be ruled out as suggested by Mr Woodley. For the reasons above, I find that all the goods and services applied for are identical or closely similar to the goods covered by the registration of the cited mark.

#### *Comparison of marks*

21. 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. Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. Rather, the comparison must be made by each of the marks in question as a whole (*Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2006] E.T.M.R. 13 at paragraph 29). In this regard, I remind myself that the fact that one component of the marks at issue is identical does not lead to the conclusion that the marks are similar unless it constitutes the dominant element in the overall impression created by each of those marks, such that all the other components are insignificant (*Gfk v Office for Harmonization in the Internal Market* (Case T-135/04) [2006] E.T.M.R. 58 at paragraph 59). I must also have regard to the perception of the marks in the mind of the average consumer of the goods and services in question.

22. The goods and services at issue are general merchandise. The average consumer is therefore the public at large, who is deemed to be reasonably well informed and reasonably observant and circumspect. Most people can be expected to employ a modicum of care in the selection and purchase of clothing items and footwear *et cetera* and it has been said that the purchasing process is primarily a visual one though oral recommendations or ordering cannot be ruled out (see *REACT Trade Mark* [2000] RPC 285).
23. The subject mark consists of the words “MIMI MATERNITY” in plain block capitals.
24. The cited mark consists of the word “Mimi” set against a rectangular and dark background together with the Chinese characters “咪咪” in smaller font above the letters “imi”.
25. Considering the cited mark, although the word “Mimi” is a common English feminine given name, it is distinctive in relation to the goods for which the cited mark is registered. Moreover, the word “Mimi” is in much larger size and occupies a substantial portion of the cited mark. Given also of its slightly

stylized capital letter “M”, the word gives quite a particular visual attraction. To my mind, the word “Mimi” is the distinctive and dominant component of the cited mark. The rectangle, which serves merely as a backdrop for the word “Mimi”, does not have any distinctive quality. The Chinese characters “咪咪”, each of which pronounces as [mi] according to the *Lin Yu Tang’s Chinese-English Dictionary*, are merely the Cantonese phonetic equivalent of the word “Mimi”. The Chinese characters “咪咪” are smaller in size and in my view, they merely reinforce the notion of the word “Mimi” in the mark and serve as an aural reference to the word “Mimi”. The Chinese characters “咪咪” are therefore far less prominent in the mark and consequently, the relevant consumer’s overall impression of the cited mark is likely to be the word “Mimi”.

26. Regarding the subject mark, it also contains the word “MIMI”. It is similarly distinctive in relation to the applied for goods and services. The word “MATERNITY”, according to the *Collins English Dictionary*, has the meaning of “motherhood; the characteristics associated with motherhood; motherliness; modifier; relating to pregnant women or women at the time of childbirth.” When used in relation to the goods and services for which the subject mark is applied for, the word merely indicates that those goods and services are or relate to maternity clothing and wear. The word “maternity” is therefore descriptive and indistinctive of those goods and services. As is clear from *Jose Alejandro SL v OHIM, Anheuser-Busch Inc Intervening Case T129/01[2004] E.T.M.R. 15*, as a general rule, descriptive elements will not generally form the focus of consumer attention with the consequence that such elements will not usually be considered to be distinctive and dominant within the context of the overall impression created by the mark. In my opinion, the word “MIMI” stands out in the subject mark as it is distinctive and appears at the beginning of the subject mark. It is followed by the word “MATERNITY” which is descriptive and indistinctive in relation to the goods and services. Having considered the subject mark as a whole, I consider that the overall impression created by the subject mark would be dominated by the word “MIMI” and the word “MATERNITY” is insignificant within the overall impression created by the subject mark. Accordingly, I also find that it is the word “MIMI” that will, for the average consumer, constitute the distinctive and dominant component of the subject mark.

27. In comparing the two marks, I must, as said, assess the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components.
28. In this instance, the subject mark and the cited mark coincide in the word “MIMI”/“Mimi”, which as pointed out above, is the distinctive and dominant component of both marks.
29. Visually, the marks share the identical word “MIMI”/“Mimi” (albeit that in the subject mark it is presented in upper case while in the cited mark it is presented in upper and lower cases). I do not lose sight of the fact that the subject mark and the cited mark contain other elements, namely, the word “MATERNITY” and the Chinese characters “咪咪” respectively. However, I do not accept Mr Woodley’s submission that such difference renders the marks as wholes visually and aurally distinguishable from each other. In my judgment, the subject mark and the cited mark are visually and phonetically similar to the extent that they both contain the distinctive word “Mimi”.
30. At the hearing, Mr Woodley points out that registration of the cited mark is subject to the following condition: - “The transliteration and translation of the Chinese characters appearing in the mark are ‘Mai Mai’ meaning Cat”. On this basis, Mr Woodley argues that since the Chinese characters “咪咪” would be pronounced as “mai mai”, the cited mark contains a different phonetic component. At this juncture, I should mention that whilst “mai mai” appears to be a transliteration of the Chinese characters “咪咪”, I find that “mimi” is also capable of being the transliteration of the characters “咪咪”. In this regard, apart from the *Lin Yu Tang’s Chinese-English Dictionary* referred to in paragraph 25 above, I find support for my view from the *Pinyin Chinese English Dictionary (The Commercial Press)* which states that the transliteration of the Chinese characters “咪咪” is [mimi]. In fact, as illustrated by an extract downloaded from <http://www.nuiku.com/Search.php?query=Mimi> shown to me by Mr Woodley at the hearing, the Chinese characters “咪咪” are pronounced as [mimi] in speech. In the cited mark, it is clear that there is no oral reference to the rectangular and dark background of that mark. As to the text elements in the cited mark, given

the way in which the word “Mimi” and the Chinese characters “咪咪” are presented, that is, the Chinese characters “咪咪” appear closely with the word “Mimi”, and bearing in mind that the Chinese characters “咪咪” are capable of being pronounced as [mimi] in speech as indicated above, the cited mark readily lends itself to be naturally pronounced as [mimi] by the average consumer. Having shared the distinctive word “MIMI/ Mimi”, I find that the subject mark and the cited mark are phonetically similar.

31. Turing to the conceptual comparison, as analyzed above, given its relevance to the goods and services applied for, the word “MATERNITY” is insignificant within the overall impression created by the subject mark. The overall impression of the subject mark left in the mind of the average consumer lies in the word “MIMI”. This is the same as the distinctive overall impression projected by the cited mark. Thus, the subject mark and the cited mark share conceptual similarity.
  
32. There is Mr Woodley’s submission that the marks are conceptually dissimilar because they convey different messages. At the hearing, Mr Woodley refers to an extract downloaded from Wikipedia at <http://zh.wikipedia.org> and submits that since the Chinese characters “咪咪” contain the meanings of “家貓，或牠們的叫聲” (“cat, or the sound of cats”), the cited mark relates to cats in some way. In addition, Mr Woodley argues that “咪咪” is a slang which connotes “對女性乳房不雅的稱呼，見眷村黑話；一些女性所用的暱稱” (an indecent way of addressing a female’s breasts under the cant of a military dependants’ village; a hypocorism used by females), and therefore “咪咪” is distinctive in the cited mark. I do not accept these propositions. According to the same Wikipedia website Mr. Woodley referred me to, the “cant of a military dependants’ village” (眷村<sup>4</sup>黑話<sup>5</sup>) referred to above is a cant or language peculiar to a military








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<sup>4</sup> “眷村在台灣通常是指 1949 年起至 1960 年代，於國共內戰失利的國民政府，為了安排被迫自中國大陸各省遷徙至台灣的的中華民國國軍及其眷屬所興建的房舍。” (A “military dependants’ village” generally means a community in Taiwan built in the late 1940s and the 1950s whose original purpose was to serve as provisional housing for Nationalist soldiers and their dependents from Mainland China after the Chinese Nationalist Party retreated to Taiwan.)

<sup>5</sup> “眷村黑話，又稱為「眷村土話」、「土話」，係指臺灣昔日眷村內流行的詞彙，與一般社會上所使

dependents' village in Taiwan in the past. I am not satisfied that to the average consumer of the subject goods in Hong Kong, the words “咪咪” would have the meanings referred to by Mr. Woodley. Moreover, trade marks do not operate in a vacuum. The distinctive character of a trade mark must be considered in the context of the goods or services to which they relate and by reference to the way it is perceived by the relevant consumer. Consumers normally perceive a mark as a whole (*Sabel BV v Puma AG*, paragraph 23). Upon seeing the Chinese characters “咪咪” used together with the word “Mimi” as in the case of the cited mark, the average consumers would, on first impression, perceive the Chinese characters “咪咪” as the Cantonese phonetic equivalent of the word “Mimi” as identified in paragraph 25 above and not in the ways as suggested by Mr Woodley.


33. Mr Woodley also attempts to play down the significance of the word “MIMI”/ “Mimi” in the imperfect recollection of both marks. Mr Woodley argues that since a number of trade marks that include the word “Mimi” are registered in class 25 and other classes of the Hong Kong register, the word “Mimi” is not of particularly high distinctiveness. For example, Mr Woodley refers to

“  ” under Trade Mark No. 300481068,  
 “  ” under Trade Mark No. 300473292,  
 “  ” under Trade Mark No. 300274635,  
 “  ” under Trade Mark No. 300160587, “  ”  
 under Trade Mark No. 200500212, “  ” under Trade Mark No.  
 199904471 and “  ” under Trade Mark No.

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用詞語有相當差別。” (A “cant used in a military dependents' village” means vocabulary used in such village in Taiwan in the past, which is considerably different from ordinary language used in the society”.)



199709854. Furthermore, Mr Woodley draws my attention to “” under Trade Mark No. 200304829 and submits that the word “MIMI” is disclaimed in that registration. I have considered those registrations. It is not entirely clear to me why the word “MIMI” is disclaimed in Trade Mark No. 200304829. I have already found that although the word “Mimi” is a common English feminine given name, it is distinctive in respect of the goods and services under application as well as the goods covered by the cited registration (paragraphs 25 and 26 above). Moreover, it is well established that comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration. The significance of the letters “MIMI” in the subject mark and in the cited mark must be considered in the context of each of those marks as whole. I do not consider the registrations Mr. Woodley referred me to assist the Applicant.

34. 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.

#### *Likelihood of confusion*

35. 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 and 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 goods and services in question.
36. Items of clothing, footwear and headgear *et cetera* are sold to the public at large through ordinary retail outlets. Mr Woodley submits that the applicant’s goods and services targets only a specific group within the general public, namely, those who has a need for maternity wear. However, the specifications of the goods and services applied for are not so limited and I must, given the breath of the

applied for specifications, consider the full range of potential customers.

37. As stated in paragraph 22, the relevant consumers for clothing, footwear, headgear and so on are the public in general. Such goods are necessities as well as being fashion items and are sold through a wide variety of outlets and at a wide range of prices. The goods are not necessarily expensive or sophisticated purchases but it seems to me that clothing, footwear and headgear *et cetra* are usually bought with a reasonable degree of care e.g. as to their size, colour, appearance, and after a visual reference.
38. Having regard to the visual, aural and conceptual similarities and dissimilarities between the subject mark and the cited mark, the similarity in the goods and services 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 and services, the average consumer would be confused into believing that the respective goods and services provided under the subject mark and the cited mark come from the same or economically linked undertakings. The subject mark which consists of the word “MIMI MATERNITY” might well be taken by consumers to be a mere variant of the cited mark or to denote a new line of its goods and services in relation to maternity wear. Therefore, the subject mark is objectionable under section 12(3) of the Ordinance on a *prima facie* basis.
39. I move on to consider whether registration of the subject mark could nonetheless be allowed by virtue of honest concurrent use or other special circumstances under section 13 of the Ordinance.

#### ***The Applicant’s evidence***

40. The Applicant’s evidence is by way of a statutory declaration of Ronald Masciantonio dated 10 August 2007 (the “Statutory Declaration”).

41. According to Mr Masciantonio, the Applicant is a wholly owned subsidiary of Mothers Work Inc. In the Statutory Declaration, Mr Masciantonio refers to the Applicant and Mothers Work Inc. collectively as “Mothers Work” and states that “Mothers Work” was founded in 1982 in the United States as a retail catalogue business. Mr Masciantonio states that “Mothers Work” offers its products under different lines and “MIMI MATERNITY” is one of the principal trade marks used by “Mothers Work” under its “Mimi Maternity” line. Mr Masciantonio states that a large portion of the products of “Mothers Work” are available for purchase online, and customers located in Hong Kong have been purchasing “Mimi Maternity” products online since November 2001.

42. Mr Masciantonio exhibits copies of:

- RM-1 - pages downloaded from <http://www.motherswork.com> on 3 August 2007 showing the history and background of Mothers Work Inc.
- RM-2 - pages downloaded from <http://www.motherswork.com> on 3 August 2007 showing the different lines of clothing of Mothers Work Inc.
- RM-3 - pages downloaded from [www.maternitymall.com](http://www.maternitymall.com) on 3 August 2007 showing that Mothers Work Inc. offers maternity apparels under different clothing lines.
- RM-4 - pages downloaded from <http://www.motherswork.com> on 3 August 2007 showing that Mothers Work Inc. have more than 1,500 retail locations in the United States, Puerto Rico and Canada.
- RM-5 - pages downloaded from <http://www.mimimaternity.com> on 3 August 2007 describing the “Mimi Maternity” line.
- RM-6 - pages downloaded from <http://www.mimimaternity.com> on 3 August 2007 showing that maternity apparels are offered under the “Mimi Maternity” line.
- RM-7 - pages downloaded from <http://www.mimimaternity.com> on 3 August 2007 containing contact information of Mimi Maternity.
- RM-8 - pages downloaded from <http://www.mimimaternity.com> on 3 August 2007 containing information of how customers may

purchase the “Mimi Maternity” line products through the web site.

- RM-9 - a list of orders placed by customers located in Hong Kong for the period from November 2001 to December 2006.
- RM-10 - a list of customers located in Hong Kong.
- RM-11- pages downloaded from <http://www.ebay.com.hk> on 3 August 2007 showing that “Mimi Maternity” products are available for purchase from the web site.
- RM-12- pages downloaded from <http://www.tdctrade.com> on 3 August 2007 showing that a Hong Kong company, New Way Development Company Limited, manufactures garments for the “Mothers Work” brand.

43. The remainder of the Statutory Declaration consists in the main of submissions in relation to the overseas registrations of the subject mark. Copies of trade mark registration certificates obtained in Canada, Singapore, Costa Rica, Korea and Taiwan are exhibited from RM-13 to RM-17 to the Statutory Declaration.

***Honest concurrent use***

44. At the hearing, Mr Woodley submits that the evidence filed is sufficient to warrant the waiver of the section 12(3) objection on the basis of honest concurrent use.

45. Section 13 of the Ordinance provides as follows:

“(1) Nothing in section 12 (relative grounds for refusal of registration) prevents the registration of a trade mark where the Registrar or the court is satisfied-

(a) that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right’.

46. The main matters which should be taken into account when considering whether registration should be allowed on honest concurrent use are stated in *Pirie* (1933)

50 R.P.C. 147 at 159. These matters are:

- (1) the extent of use in time and quantity and the area of the trade;
- (2) the degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;
- (3) the honesty of the concurrent use;
- (4) whether any instances of confusion have in fact been provided;  
and
- (5) the relative inconvenience which would be caused if the mark were registered.

47. I shall consider these five factors in turn, bearing in mind that these matters are not exhaustive and in exercising my discretion, “all relevant circumstances ought to be considered” (*Electrix Ld’s Application for Trade Mark* [1957] R.P.C. 369 at 379).

*The extent of use in time and quantity and the area of the trade*

48. An assessment of the use of a mark must take into account the length of time the mark has been used in Hong Kong, and the volume of goods sold and/or the turnover of services in relation to the extent of the market. In the Statutory Declaration, the Applicant claimed to have used the subject mark in relation to the goods and services applied for in Hong Kong prior to the date of the application on 8 December 2005. Use of the mark in Hong Kong was claimed as early as November 2001, which was about four years before the application on 8 December 2005. There is, however, no evidence in this respect.

49. The first point to make is that there is no evidence to show use of the subject mark

by the Applicant prior to the date of application. Most of the evidence are dated after the application date. For example, all the materials produced in exhibits marked from RM-1 to RM-8 bear a copyright notice of 2007 and the materials produced in exhibits RM-11 and RM-12 are downloaded after the application date. They do not serve to throw light on the situation as at the date of application and I cannot therefore attach any weight to them.

50. Moreover, there is no information on the volume of goods sold and the turnover of services in relation to the extent of the market. The Applicant has not provided in the Statutory Declaration any sales turnover figure in Hong Kong in respect of the goods and services applied for within five years before the date of application. At the hearing, Mr Woodley refers to the list of orders and the list of customer exhibited as RM-9 and RM-10 respectively to the Statutory Declaration and submits that the Applicant has 57 customers located in Hong Kong since November 2001. However, the subject mark does not appear in the list of orders and I cannot ascertain whether the purchases so made were in respect of products offered under the “Mimi Maternity” line but not in relation to other lines of clothing. This is especially so when the Applicant states that “Mothers Work offers its products under different clothing lines” and “MIMI MATERNITY” is just “one of the principal trade marks used by Mothers Work under its ‘Mimi Maternity’ line” (paragraphs 5 and 6 of the Statutory Declaration). In any event, even if the purchases so made were in respect of the subject mark “MIMI MATERNITY”, of which there is no evidence, I am not convinced that the sales during the relevant period are substantial. Contrary to Mr. Woodley’s submission that RM-9 and RM-10 shows that the Applicant has 57 customers located in Hong Kong, I consider they merely show that there were 57 transactions in Hong Kong since November 2001. Moreover, I note that out of these 57 transactions, 10 of them were after the date of application. I do not consider that having a volume of not more than 50 transactions over a claimed period of use of four year (from November 2001 up to the application date) is substantial.
51. Furthermore, there is no evidence regarding the advertising expenditures incurred by the Applicant in promoting the use of the subject mark in Hong Kong. The Applicant has not provided in the Statutory Declaration any advertising expenditure spent in the promotion of the mark in respect of the goods and

services applied for in Hong Kong within five years before the date of application. Mr Woodley submits that online commerce does not depend on traditional advertising and advertising expenditure is only one criteria and absence thereof does not negate other factors establishing the ability of the marks to coexist, such as different trade channels and the specialized nature of the maternity market and consumers. However, from the evidence I have before me, I cannot see that there has been any advertising of the mark by the Applicant prior to the application date. As indicated in paragraph 49 above, the materials exhibited as RM-1 to RM-8 to the Statutory Declaration are after the application date and I cannot ascertain how and to what extent the subject mark has been promoted in Hong Kong, if at all, by the Applicant prior to the application date.

52. Lastly, Mr Woodley refers me to *Granada Trade Mark* [1979] R.P.C. 275 and paragraph 9-160 of *Kerly's Law of Trade Marks and Trade Names, 14<sup>th</sup> Edition*, and submits that no fixed rule can be laid down as to the minimum period of honest concurrent use required. Mr Woodley further refers to the Hong Kong Trade Marks Registry's Work Manual Chapter on "Consent, honest concurrent use and other special circumstances" and submits that if there is only two years of use, such use should be of "large scale" or substantial. On this basis, Mr Woodley argues that since there has already been four years of use, the period of use of the subject mark is closer to five years than to two years, thus the threshold that should be applied should not be to show substantial evidence of use in Hong Kong.
53. I cannot accept Mr Woodley's submission. As with the U.K. Trade Marks Registry, the Registrar's practice is to look for five years' honest concurrent use. I note Mr Woodley's reference to *Granada, supra* and *Kerly's*. However, in *Granada* and the cases referred to in *Kerly's*, a shorter period of use is considered acceptable in the particular circumstances of those cases. Those circumstances include: two years and 10 months use on a very large scale, and non-infringing use of the applicant's mark<sup>6</sup> (*Granada, supra*); three and a half years use, on a larger scale than that of the opponent (*Buler* [1975] R.P.C. 275); absence of use of its mark by the applicant for rectification during the period of concurrent use of

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<sup>6</sup> The only similarity between the opponent and the applicant's mark is the word "Granada", but the word has been disclaimed in the opponent's registration.

the mark by the registered proprietor, who have built up considerable goodwill (*Peddie* [1944] 61 R.P.C. 31). None of these circumstances are present in the subject application. As explained in the preceding paragraphs, there is no evidence to show the extent of use of the subject mark in Hong Kong.

*The degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience*

54. As said in *Re Borsalini Trade Mark* [1993] 1 HKC 587, the most important consideration is the likelihood of inconvenience to the public. In the exercise of my discretion, the degree of confusion is to a large extent indicative of the measure of public inconvenience. If there was very little likelihood of public inconvenience, there would be no good reason why registration of the mark in question should be refused. I also bear in mind that my discretion is unfettered and concurrent registration may be allowed even where the possibility of confusion is considerable. Each case has to be determined on its own merits (Paragraph 9-156, Kerly's Law of Trade Marks and Trade Names, 14th Edition - concerning the corresponding provision in the U.K. Trade Marks Act 1994: section 7).
55. In the present case, the respective marks share the same word "Mimi" as their distinctive and dominant component. For the reasons that I have given at paragraphs 13 to 38 above, the respective marks are closely similar and the near identity of the majority of the goods and services means, in my view, that the likelihood of confusion and therefore the measure of public inconvenience is high.

*The honesty of the concurrent use*

56. Mr Masciantonio's statutory declaration does not address the issue of honesty. There is no explanation as to how the Applicant designed and created the subject mark. Nor is there any explanation on whether the Applicant was aware of the cited mark in developing its own mark.

*Whether any instances of confusion have in fact been provided*

57. There is no evidence of confusion, but neither is there any evidence of use of the cited mark.

*The relative inconvenience which would be caused if the mark were registered*

58. Turning to the issue of relative inconvenience, allowing a mark highly similar to the cited mark to co-exist will undoubtedly prejudice the cited mark owner. As mentioned, the likelihood of the confusion of trade origin caused by the co-existence of the subject mark and the cited mark is high. On the contrary, there is no evidence before me indicating that refusing registration of the subject mark will prejudice the Applicant, particularly when the evidence does not show that the Applicant has used the subject mark in Hong Kong to any significant extent, if at all.

*Others*

59. In the Statutory Declaration, Mr. Masciantonio stated that “I note that the Hong Kong Trade Marks Registry decided that the [subject mark] is devoid of distinctive character”, and submitted copies of certificates showing registration of the subject mark in various classes in Canada, Singapore, Costa Rica, Korea and Taiwan (exhibits marked from RM-13 to RM-17).
60. The nub of the case is the relative grounds of objection under section 12(3) of the Ordinance. No absolute grounds of objection under section 11 of the Ordinance have ever been raised against the subject application. In any event, I do not consider that the evidence submitted on the overseas registrations of the mark would assist the Applicant’s case for registration. The evidence does not show whether the mark was met with the same citation in these jurisdictions. Moreover, trademark rights are territorial. The Registrar needs to be satisfied that there has been an honest concurrent use of the subject mark and the cited mark in Hong Kong before he could allow registration of the subject mark in

Hong Kong, despite the section 12(3) objection.

61. Having thus considered the totality of the evidence filed and all the relevant circumstances, in particular, taking into account the fact that use of the subject mark applied for in Hong Kong before the application date has not been shown, and the extent of its use cannot be ascertained, I am not satisfied that honest concurrent use of the subject mark has been established.
62. Finally, I proceed to consider whether there is any special circumstances which render it proper for the subject mark to be registered.

*Special circumstances*

63. Section 13(1)(b) of the Ordinance provides that:

“(1) Nothing in section 12 (relative grounds for refusal of registration) prevents the registration of a trade mark where the Registrar or the court is satisfied -

...

(b) that by reason of other special circumstances it is proper for the trade mark to be registered.”

64. At the hearing, Mr Woodley relies on the evidence filed under Mr Masciantonio’s statutory declaration and submits that since the evidence “confirms that the Applicant is one of the world’s leading manufacturers and marketers of maternity apparel, the Applicant would be unfairly inconvenienced by having to adopt a new trade mark for the Hong Kong market, leading to loss of goodwill”. He says that “the Applicant could re-file a further application claiming six years pre-application use but such duplication of process should not be necessary and is not in the public interest”.
65. Mr Woodley goes on to submit that “although the quantum of sales and

advertisement in Hong Kong is not high, the evidence confirms the nature of the Applicant's business and the online trade channels and the period of pre-application use of four years is substantial'. He submits, "on a global assessment, taking account of all other factors, the evidence filed supports the case for registration and should not be automatically rejected for being less than five years pre-application use".

66. It seems to me that Mr Woodley, as a final catch-all, mainly repeats his arguments made under the honest concurrent use claim. For the reasons given above, I am not satisfied that the evidence filed shows that there has been an honest concurrent use of the subject mark "MIMI MATERNITY" with the cited mark in relation to the goods and services applied for. There is no special circumstances which justify my exercise of discretion under section 13(1)(b) of the Ordinance.
67. As I have found the subject mark to be objectionable under section 12(3), and the Applicant has not made out a case for registration under section 13, I have no discretion to accept the subject application.

## **Conclusion**

68. In this decision, I have considered all documents filed by the Applicant together with all oral and written submissions made in respect of the subject application. For the reasons given, registration for the subject mark is precluded by section 12(3) of the Ordinance by virtue of the cited mark. The subject application is accordingly refused under section 42(2)(b) of the Ordinance.

(Jessica Law)  
For Registrar of Trade Marks  
7 May 2008