


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

**APPLICATION NO. : 300628083**

**MARK : **  
**CLASS : 25**  
**APPLICANT : Converse Inc.**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 27 April 2006, CONVERSE INC. (“applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap. 559) (“Ordinance”), to register the following mark (“subject mark”) :



2. Registration of the subject mark is sought in respect of “Footwear, clothing and headgear for men, women and children” in class 25 (“applied for goods”).
3. At the examination stage, objections were raised against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade marks (“cited marks”), both of them being registered in the name of KABUSHIKI KAISHA MOONSTAR (MOONSTAR COMPANY):



(1)

Registration No.: 19570345 (“first cited mark”)

Date of registration: 17 October 1956

Class: 25

Goods: all kinds of footwear, especially rubber and rubberized footwear, such as rubber boots, rubber shoes, rubber-soled canvas shoes and slippers.



(2)

Registration No.: 199510360 (“second cited mark”)

Date of registration: 20 December 1993

Class: 25

Goods: footwear and parts and fittings therefor; all included in Class 25.

4. A hearing on the registrability of the subject mark took place before me on 2 September 2008 at which Mr. Philips B. F. Wong, Counsel, instructed by Messrs. Wilkinson & Grist (“applicant’s agent”), appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.
5. The applicant did not file any evidence. I therefore have only the *prima facie* case to consider.

### **The Ordinance**

6. Relative grounds for refusal of registration are provided in section 12 of the Ordinance. Section 12(3) of the Ordinance (“section 12(3)”) provides:

“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.”

7. Section 7(1) of the Ordinance (“section 7(1)”) provides:

“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.”

8. Section 5 of the Ordinance (“section 5”) provides the meaning of “earlier trade mark”:

“(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...”

## Decision

### *Section 12(3) of the Trade Marks Ordinance*

9. Section 12(3) precludes from registration a mark the use of which 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.
10. Each of the cited marks has a date of application for registration earlier than that of the subject mark. Each of the cited marks is therefore an “earlier trade mark” in relation to the subject mark.
11. Section 12(3) 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> (“Article 4(1)(b)”). In interpreting Article 4(1)(b), the European Court of Justice (“ECJ”) has formulated the “global appreciation” test with the relevant legal principles laid down in a number of ECJ’s decisions, including *Sabel BV v Puma* [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 BV* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723. Those ECJ’s decisions provide guidance in assessing the ground of objection under section 12(3). The relevant legal principles are:

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

“(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 reads –

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

(a) ...

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

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel BV v. Puma AG* (supra));
- (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* (supra)), 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.* (supra));
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v. Puma AG* (supra));
- (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG* (supra));
- (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* (supra));
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it (*Sabel BV v. Puma AG* (supra));
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b) (*Sabel BV v. Puma AG* (supra));
- (h) further, the reputation of a mark does not provide grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode CV v. Adidas AG* (supra));
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon Kabushiki Kaisha v.*

*Metro-Goldwyn-Mayer Inc (supra).*

12. In applying the above legal principles, I must at the outset proceed to consider whether the similarities between the subject mark and each of the cited marks, and the similarities of the respective goods would together result in a likelihood of confusion on the part of the public for the purpose of section 12(3). In assessing the likelihood of confusion, I may, in accordance with section 7(1), take into account all factors relevant in the circumstances.

*Comparison of marks*

13. According to the legal principles for comparing marks set out in paragraph 11 above, I have to consider the visual, aural and conceptual similarities and differences between the marks with reference to the perception of the average consumer of the goods concerned, who normally perceives a mark by the overall impression and not by its various details.
14. The subject mark and the cited marks are two-dimensional devices without any word or letter on it.
15. The subject mark is a device of a five-pointed star in dark enclosed inside a circle.
16. The first cited mark is a device of a five-pointed star in dark substantially enclosed inside a circular border. The circular border has two tapering horns producing an opening at the top. The mark as a whole has no meaning in relation to the goods for which it is registered, and is distinctive as a whole.
17. The second cited mark is a device of a five-pointed star in dark enclosed inside an oval border with the whole device inclined to one side. The oval border has two tapering horns that nearly close up to the right. The second cited mark as a whole also has no meaning in relation to the goods for which it is registered, and is distinctive as a whole.
18. Mr. Wong submitted that the overall impression and image conveyed by each of the cited marks and the subject mark was substantially different. According to Mr. Wong, the subject mark consisted of a star device placed neatly within a circle with no artistic element. On the other hand, he argued that the “crescent device” in each of the cited marks was very prominent, as eye-catching as the star device and not a simple arc or band surrounding the star. He viewed that the cited marks were specially designed to form the

shape of a crescent or moon, presumably to denote the company name of the proprietor of the cited marks, “moon” and “star”. He therefore considered that both the star and crescent devices are dominant and prominent in each of the cited marks. Mr. Wong further stated that the second cited mark as a whole was artistic in style that looked even more different from the subject mark since the whole device was slanted to one side.

19. In comparing the marks, I have to consider the subject mark and each of the cited marks in normal and fair use in relation to the relevant goods, and the overall impression each of them would give to the average consumer of the goods in question.
20. Visually, the subject mark consists of a five-pointed star inclosed in a circle. Each of the cited marks consists of a five-pointed star inclosed in a more or less circular border. I do not consider that the average consumer would perceive each of the borders in the cited marks as a crescent. He would not look first at the company name of the proprietor of the cited marks, and then try to give a meaning to the border in each of the cited marks. The average consumer rarely has a chance to compare marks side by side, and would rely on the imperfect picture of them he has kept in his mind. Although the border in the first cited mark is opened at the top and is thicker towards the bottom, the first cited mark as a whole would be viewed and remembered as a star inclosed in a more or less circular border. Likewise, although the border in the second cited mark is thicker on the left side and the whole device is slanted towards the left, it would also be viewed and remembered as a star inclosed in a more or less circular border.
21. Aurally, each of the subject mark and the cited marks would either not be pronounced, or be referred to as a star device.
22. Conceptually, each of the subject mark and the cited marks would be perceived as a star inclosed in a more or less circular border.
23. Having regard to the visual, aural and conceptual similarities and differences between the subject mark and each of the cited marks, I find that the overall impression created by the subject mark is very similar to that created by each of the cited marks.
24. Mr. Wong submitted that neither of the cited marks was particularly distinctive *per se*. He claimed that the use of a star device in a mark or as part of a mark was nothing innovative and that consumers were accustomed to see and would be able to differentiate between similar simple trade marks in respect of goods

under class 25. In support, he referred me to the applicant's agent's letters dated 22 February 2007 and 8 August 2007 which showed various trade marks consisting of star devices registered in Hong Kong in relation to goods in class 25 ("other star marks"). These other star marks are set out in **Annex I** hereto.

25. I cannot accept Mr. Wong's submission. Instead of a mere 'star' device, each of the cited marks is a device formed by a star and a border, and as pointed out in paragraphs 16 and 17, each of the cited marks as a whole is distinctive in relation to the class 25 goods for which it is registered. I have also considered the other star marks but I find that they each create a very different visual impact as compared to the cited marks, due to differences in the appearance of the stars device(s), the patterns they form or the way the star device(s) combine with other elements.
26. Mr. Wong further referred me to the following dictum of the Comptroller General in *Harrods Ld's Application* (1935) 52 R.P.C. 65 at 70, which is also referred in *Kerly's Law of Trade Marks and Trade Names* (14th Edition) para.17-041:

"Now, it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features".

27. Mr. Wong argued that in light of the existence of the other star marks registered in relation to the relevant type of goods and in actual use<sup>3</sup>, the public would pay more attention to other features of the respective marks and would not simply rely on the star device as indicating trade origin, but would rely on the mark as a whole.
28. I note, however, the above dictum of the Comptroller-General in *Harrods Ld's Application* was immediately followed by the following:

"This principle, however, clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the markets in which the marks under consideration are being or will be used".

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<sup>3</sup> Mr. Wong invited me to take "judicial notice" that the other star marks are in actual use.

29. In the subject application, there is no evidence as to whether any of the other star marks are in actual use at all, and if so, to what extent. There is no material before me which supports the claim that the star device is a common element in fairly extensive use in the same market as the subject mark and the cited marks. Moreover, each of the other star marks set out in **Annex I** gives a very different overall impression from that of the subject mark and each of the cited marks. I do not consider that the average consumer would pay less attention to the star in the subject mark and the cited marks, and distinguish the subject mark from each of the cited marks by their borders. They would perceive each of the marks as a whole, and would rely on the imperfect picture of them he has kept in his mind. I have already found that the subject mark and each of the cited marks would be perceived and remembered as a star inclosed in a more or less circular border. The subject mark is very similar to each of the cited marks. I do not find Mr. Wong's submission and the case of *Harrods Ld's Application* to be of any assistance to the applicant.

*Comparison of goods*

30. In *British Sugar v. James Robertson and Sons Ltd.* [1996] R.P.C. 281 at 296-297, Mr. Justice Jacob found the following factors were relevant in considering whether or not there is similarity in the goods and services at issue. The factors are —
- (a) The respective uses of the respective goods or services;
  - (b) The respective users of the respective goods or services;
  - (c) The physical nature of the goods or acts of services;
  - (d) The respective trade channels through which the goods or services reach the market;
  - (e) In the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves; and
  - (f) 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.
31. Additionally, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* (supra) at paragraph 23 expressly addressed 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 consideration. Those factors

include, *inter alia*, their nature, their end users<sup>4</sup> and their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, for example, the distribution channels of the goods concerned (*Ampafrance SA v. OHIM--Johnson & Johnson (monBeBé)* [2005] E.C.R. II-1401 at paragraph 53).

32. At the examination stage, the Registry pointed out that the applied for goods are identical or similar to the goods of the cited marks. Mr. Wong did not make any counter arguments at the hearing on this point.
33. “Footwear for men, women and children” included in the applied for goods overlaps with and is identical to “all kinds of footwear” covered by the first cited mark and “footwear” covered by the second cited mark<sup>5</sup>. “Clothing and headgear” in the applied for goods and “footwear” covered by each of the cited marks are all items for wearing, and have the like function of covering and protecting<sup>6</sup>. “Footwear” encompasses anything that covers the foot, including socks. Clothing also includes socks, and to that extent, overlaps with footwear. Further, “clothing and headgear” in the applied for goods and “footwear” covered by the cited marks have the same target consumers and trade channels, e.g. boutiques, fashion or specialist sales outlets. In my experience, it is not uncommon that sporting shoes brands produce sporting and leisure clothing and headgear in addition to sporting footwear, and vice versa, with these products available at the same point of sales or specialized shop. Additionally, as a fashion article, footwear is often coordinated or matched with articles of clothing and headgear and chosen as a complementary item to the latter. Taking all these factors into account, I consider “clothing and headgear” in the subject mark are very similar to “footwear” covered by each of the cited marks.

#### *Likelihood of confusion*

34. Under section 12(3), likelihood of confusion refers to confusion on the part of the public as to the trade origin of the goods in question. This is a matter of global appreciation taking into account all relevant factors and judging

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<sup>4</sup> *Kerly's Law of Trade Marks and Trade Names (14th Edition)* page 252, FN 62 It has been suggested that “end users” is an incorrect translation and should read as “purpose of use” instead. In any case, the users of the respective goods at issue are among the factors specified in *British Sugar v James Robertson and Sons Ltd.* (supra).

<sup>5</sup> Goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, or vice versa (*Gérard Meric v OHIM* Case T-133/05 (Court of First Instance of the European Communities); *Galileo Trade Mark* [2005] RPC 22).

<sup>6</sup> *O'Neill Inc's Application* [2004] E.T.M.R. 50.

through the eyes of the average consumer of the goods at issue, who seldom directly compares marks but relies upon his or her imperfect recollection of marks.

35. The applied for goods and the goods covered by each of the cited marks are general merchandise. The average consumers for these goods are members of the general public. Considering the use of the subject mark and each of the cited marks in the normal and fair way, these everyday consumer items will not be purchased with the highest level of care and attention.
36. Overall, in view of the visual, aural and conceptual similarities between the subject mark and each of the cited marks, the inherent distinctiveness of each of the cited marks, and the fact that the respective marks would be applied to identical and closely similar goods, there is a real likelihood of confusion on the part of the public as to the trade origin of the applied for goods. It is an association between the subject mark and each of the cited marks that causes the consumers to be confused into thinking that goods sold under the subject mark and those covered by each of the cited marks emanate from the same or economically-linked undertakings. In consequence, the subject mark is objectionable under section 12(3) on a *prima facie* basis.

*Reference to other trade marks on the register and other matter*

37. Mr. Wong drew my attention to trade mark registration no. 300983052 (“quoted mark”) that consisted of a series of two marks registered in class 25. The quoted mark is set out in Annex II hereto. The first mark in the series consisted of a star device in white set against a background of five different colours within a circle. The second mark in the series consisted of a star device in white set against a dark background within a circle. He stated that such registration reinforced the fact that the subject mark could co-exist with each of the cited marks without likelihood of confusion. I do not agree. I find the reversed colour scheme of the star device in the quoted mark, in particular, the coloured background in the first mark in the series, gives a distinctly different overall impression and renders it distinguishable from each of the cited marks. Registrability of each mark must be considered on its own merits and the co-existence of other marks on the register does not affect registrability of the subject mark. In any event, it is well established that comparison with other marks on the register is in principle irrelevant when considering a mark tendered for registration (*British Sugar Plc v. James Robertson and Sons Ltd* (supra) at 305). The fact of other registrations on the register does not assist the applicant when there are valid grounds for refusal

against the subject application.

38. Mr. Wong also contended that even if the Registrar allowed the subject application to proceed to registration, the owner of the cited marks or any other companies could still oppose it by lodging opposition proceedings, whereby the rights of the respective owners might further be explored.
39. I cannot accept this argument. While the Ordinance provides a statutory channel for an owner of an earlier trade mark to oppose the registration of a trade mark after it is published for opposition, the Registrar is duty bound to refuse an application for registration of a mark at the examination stage if it falls foul of the provisions of, inter alia, section 12(3) of the Ordinance. The availability of opposition proceedings does not alleviate the Registrar of his duty to examine applications for registrations in accordance with the provisions of the Ordinance, and is not a ground for allowing an application to proceed when there are valid objections under the Ordinance.







### **Conclusion**







40. In this decision, I have carefully considered all the written and oral submissions made in relation to this application. Based on the reasons stated above, I conclude that the subject mark is debarred from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Vivien LUK  
For Registrar of Trade Marks  
15 January 2009

**Annex I**

“other star marks” referred to by the applicant at paragraphs 24 and 29 above

<b>Trade Mark No.</b>	<b>Trade Mark</b>	<b>Class(es) No.</b>
300747036		14, 15, 16, 25, 28, 32, 41
19901923		25
1995B09034		25
199806843		25
199916580		25
300113499		25, 45

Trade Mark No.	Trade Mark	Class(es) No.
300441251		5, 25, 30
300514791		16, 25, 38, 39, 42
300565218		25
2004B01133		25
300726093		3, 6, 9, 12, 14, 16, 18, 20, 24, 25, 28, 32, 35, 36, 38, 39, 41
300280809		4, 8, 9, 11, 14, 15, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 32, 35, 39, 41, 43

**Annex II**

“quoted mark” referred to by the applicant at paragraph 37 above

Trade Mark No.	Trade Mark	Class No.
300983052	<p>(A)  (B) </p>	23, 24, 25, 26, 28