

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 300763885AB

MARK : 聯合包裹服務
聯合包裹服务

CLASSES : 9, 35, 36 and 39

APPLICANT : UNITED PARCEL SERVICE OF AMERICA, INC.

STATEMENT OF REASONS FOR DECISION

Background

1. This is an application by United Parcel Service of America, Inc. (“Applicant”) under the Trade Marks Ordinance (Cap. 559) (“Ordinance”), to register a series of two marks shown below (collectively, “subject marks”)

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in respect of various goods and services in Classes 9, 35, 36 and 39, the specifications of which are reproduced at **Annex A** of this statement of reasons for decision. It is a divisional application of an application filed on 20 November 2006 (“filing date”) and has the same filing date as that application.

2. At the examination stage, objection was raised against the subject application in Classes 9, 35, 36 and 39 under section 12(3) of the Ordinance on the basis of the following registered trade marks:

(A) **聯合**

Registration No.: 199806482 (“first cited mark”) in Class 39

(B) **聯合航空**

Registration No.: 199710407 (“second cited mark”) in Class 39

In relation to the subject application in Classes 35 and 36, objection was also raised under section 12(3) of the Ordinance on the basis of the following registered trade mark:

(C) **聯合**

Registration No.: 199804210AA (“third cited mark”) in Classes 29, 35, 36 and 37

Details of the above cited marks (collectively, “cited marks”) are reproduced at **Annex B** of this statement of reasons for decision.

3. As the objection was maintained at the examination stage, the Applicant requested a hearing on the registrability of the subject marks. The Registrar fixed a hearing, which was later rescheduled for 19 December 2008 at the Applicant’s request. The hearing took place before me on 19 December 2008 at which Mr. Philips B. F. Wong, Counsel, instructed by Messrs. Deacons (“Deacons”), appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.
4. It is noted that prior to the hearing, the Applicant filed additional written submissions under the cover of Deacons’ letters dated 12 December 2008 and 17 December 2008 respectively (“Applicant’s additional written submissions”) in order to overcome the objection. In addition to Mr. Wong’s submissions made at the hearing, I will deal with the Applicant’s additional written submissions at this statement of reasons for decision.
5. The Applicant did not file any evidence of use of the subject marks. I therefore only have the *prima facie* case to consider.

Decision

6. My decision after the hearing is to allow registration of the subject marks in respect of :
 - (a) the applied-for goods in Class 9;
 - (b) “retail store services relating to stamps and office supplies; provision of on-line business information over the Internet relating to shipping of packages and documents; distribution of samples” in Class 35; and
 - (c) “arranging ship charters for others” in Class 39.

(collectively, “Unobjectionable Goods and Services”)
7. I maintain the objection under section 12(3) of the Ordinance in respect of:
 - (a) the remaining services in Class 35, namely, “Advertising services; business management relating to logistics; business management services; business

consulting services; business administration services; office functions services namely assisting in the management of the business affairs or commercial functions of customers; management assistance services; management consulting services; providing computerized business information of packages in transit for tracking and tracing purposes; business management services relating to sorting and routing of mail packages; data processing services; photocopying services; document reproduction services; provision of business assistance in the establishment of franchisers; business management of transportation networks; all included in Class 35.”

- (b) the applied-for services in Class 36; and
- (c) the remaining services in Class 39, namely, “Freight forwarding; packaging articles for transportation; services of transportation of letters, documents, communications, printed matter, and goods and property by diverse means of transportation; warehousing, storage, packing, delivery and returns with respect to the foregoing; providing computerized information on domestic and international transportation and delivery services; rental of document boxes, document forwarding and receipt and delivery of documents for others; customs clearance; all included in Class 39.”

(collectively, “Objectionable Services”)

- 8. The reasons for refusing registration of the subject marks in respect of the Objectionable Services are set out below.

Section 12(3) of the Trade Marks Ordinance

- 9. 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.”

- 10. 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.”

11. An “earlier trade mark” is defined in section 5 of the Ordinance, 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...”

12. As each of the cited marks has a date of application for registration earlier than those of the subject marks, so each of the cited marks is an “earlier trade mark” in relation to the subject marks.

13. Section 12(3) is similar in effect to section 5(2) of the UK Trade Marks Act 1994¹, which implements Article 4(1)(b)² of the European Trade Marks Directive³ (“Article 4(1)(b)”). In determining the question under section 12(3) I take into account the guidance provided by the European Court of Justice 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 BV* [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

¹ 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.”

² 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.”

³ That Directive has now been replaced by Directive EEC/95/2008, but the relevant provisions remain essentially the same.

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 BV*);

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*);
 - (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*);
 - (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*);
 - (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it (*Sabel BV v Puma AG*);
 - (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b) (*Sabel BV v Puma AG*);
 - (h) further, the reputation of a mark does not 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*);
 - (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.*).
14. Section 12(3) essentially 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 there are similarities between the subject marks and each of the cited marks and the services covered which 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 services

15. Guidance on the approach to be adopted in comparing goods or services is given in *British Sugar Plc. 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:
- (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-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
 - (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.
16. 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 users⁴ and their method of use and whether they are in competition with each other or are complementary.

Class 39

17. Mr. Wong submitted that the services of “rental of document boxes; customs

⁴ *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 services at issue are among the factors specified in *British Sugar Plc. v James Robertson and Sons Ltd.*

clearance” in the subject application in Class 39 were of a completely different nature from the services of “transportation of persons by air” covered by the first cited mark. They were not competitive to each other and the respective uses and users were all very different. The remaining services in Class 39 were also of a different nature from those of the first cited mark as they were related to transportation of property instead of persons. Given the extreme difference in the services in question, there would not be any genuine likelihood of confusion among the public, even if the marks themselves were substantially similar (which was denied).

18. As regards the second cited mark, Mr. Wong made the same argument, as above, that “rental of document boxes; customs clearance” services were different from “transportation of persons, mail and property by airlines” covered by the second cited mark. For the remaining services in the subject application in Class 39, Mr. Wong accepted that they were similar to the type of services provided under the second cited mark or at least relatively more regularly associated with airlines. In respect of those services, the Applicant could only rely on the difference between the subject marks and the second cited mark to support that there was no confusion.
19. Contrary to Mr. Wong’s submission, I consider that “rental of document boxes; customs clearance” services in the subject application in Class 39 are similar to the services protected by the first cited mark and the second cited mark. Transportation companies usually provide rental of boxes and customs clearance services to their customers. Such applied-for services could be considered to be complementary to transportation services as there is a close connection between such applied-for services and transportation services, 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 for the provision of those services lies with the same undertaking (*Commercy AG v OHIM* (Case T-316/07) [2009] All ER (D) 193 (Jan) at paragraph 57); *Sergio Rossi SpA v OHIM* (Case T-169/03) [2005] E.C.R. II-685 at paragraph 60; *El Corte Ingles, SA v OHIM* (Case T-420/03) [2008] E.T.M.R. 71 at paragraph 98). Users of those services are the same, namely individual users and business enterprises. Those services serve the same purpose of delivering goods to destinations and they are likely to be provided through the same trade channels.
20. As pointed out in the Registry's previous correspondence and accepted by Mr. Wong, it is not uncommon for airline companies to offer air freight services such as parcel delivery services in addition to transportation of passengers. Therefore, I consider that the remaining services in Class 39 (except the services of “arranging ship charters for others”) are similar to those services for which the first cited mark and the second cited mark are registered.

Classes 35 and 36

21. As regards the citation of the first cited mark and the second cited mark, the Applicant argued that according to the chapter of “Cross search list” in the Trade Marks Registry Work Manual, cross searches in relation to an application in Classes 35 and 36 were not required to be done in Class 39. However, I am not convinced by this argument. As stated in the first paragraph of that chapter, the cross search list is not exhaustive and the Registrar needs to exercise his judgement in deciding the classes to be searched.
22. The Applicant also reiterated that the Applicant was a courier service provider whereas the owner of the first cited mark and the second cited mark was an airline company. The respective services, intended customers and sales channels should be sufficiently distinguishable and thus there should be no likelihood of confusion.
23. However, I consider that the actual activities engaged by and current trade channels of the Applicant and the owner of the first cited mark and the second cited mark are of little relevance. There is no restriction on the respective parties to expand the scope of their current businesses. When determining the registrability of the subject marks, I have to consider the normal and fair use of the subject marks and the cited marks with reference to the respective specifications. In interpreting specification of services, the terms are to be given their ordinary and natural meaning (*Ofrex v Rapesco* [1963] R.P.C. 169).
24. Mr. Wong further submitted that the applied-for services in Classes 35 and 36 were of a very different nature to the services covered by the first cited mark and the second cited mark. The services were not competitive to each other and the respective uses and users were all very different. Accordingly, there would not be any genuine likelihood of confusion among the public, even if the marks themselves were substantially similar (which was denied).
25. In my view, the services of “providing computerized business information of packages in transit for tracking and tracing purposes”, “business management relating to logistics”, “business management services relating to sorting and routing of mail packages” and “business management of transportation networks” in the subject application in Class 35 are similar to transportation services covered by the first cited mark and the second cited mark. To my knowledge, transportation companies usually provide online tracking facilities for their customers to trace the delivery of their goods, and some transportation companies such as FedEx and DHL also provide logistics solutions or transportation management services to their customers. Such applied-for

services could be considered as complementary to transportation services and could be provided by the same service provider and through the same trade channels. Therefore, I consider that the nature of such applied-for services and the services covered by the first cited mark and the second cited mark is similar. These services serve the same purpose of facilitating delivery of goods. As business entities and members of the general public would also seek these services, users of these services are the same.

26. In the subject application in Class 36, I consider that “customs brokerage services”, “reclamation of import duties for others”; “bonding services in the nature of underwriting customs bonds”, “provision of temporary import bonds”, “custom brokerage services for the processing of import visa quotas”; “provision of customs bonds”; “custom brokerage services relating to duty drawbacks” are similar to the transportation services covered by the first cited mark and the second cited mark. Many transportation companies and freight forwarders provide customs brokerage services including provision of temporary import bonds and customs bonds (which insure importers’ performance of legal obligations including the payment of duties and taxes), preparation of customs documents and duty drawback management to their customers. Such applied-for services aim to ensure that goods are cleared through Customs and delivered. Accordingly, such applied-for services and services covered by the first cited mark and the second cited mark are closely linked. They serve the same purpose of delivery of goods. Users of these services are also the same, namely business enterprises and members of the general public who need to transport their goods. As service providers of transportation often provide customs brokerage services to their customers, they share the same trade channels.
27. I turn to consider the citation of the third cited mark. According to the Applicant, although the subject application also covers services in Classes 35 and 36, the nature of the business of the Applicant and the owner of the third cited mark is sufficiently distinguishable. The owner of the third cited mark is an investment holding company primarily engaging in investment services which is not in anyway related to the Applicant’s courier business. However, as explained in paragraph 23 above, I consider that such argument does not assist the Applicant’s case.
28. Mr. Wong also submitted that in relation to
 - (a) “advertising services; providing computerized business information of packages in transit for tracking and tracing purposes; retail store services relating to stamps and office supplies; data processing services; photocopying services; document reproduction services; provision of on-line

business information over the Internet relating to shipping of packages and documents; distribution of samples” in the subject application in Class 35; and

- (b) “insurance services; customs brokerage services; reclamation of import duties for others; bonding services in the nature of underwriting customs bonds; provision of temporary import bonds; custom brokerage services for the processing of import visa quotas; provision of customs bonds; custom brokerage services relating to duty drawbacks; electronic payment services” in the subject application in Class 36,

they were different in nature from the services in respect of which the third cited mark was registered and the respective uses and users of the services in question were also very different. Thus, confusion was unlikely to arise.

29. In so far as the remaining services in Classes 35 and 36 were concerned, Mr. Wong accepted that they were more similar to the services in respect of which the third cited mark was registered. The Applicant would rely on the difference between the subject marks and the third cited mark to support that there was little likelihood of confusion.
30. Regarding the services set out in paragraph 28(a) above, I consider that “advertising services; data processing services; photocopying services; document reproduction services” in the subject application in Class 35 are similar to “marketing research and studies; business management assistance; commercial management assistance” in Class 36 covered by the third cited mark.
31. According to www.dictionary.com, “marketing” means “the total of activities involved in the transfer of goods from the producer or seller to the consumer or buyer, including *advertising*, shipping, storing, and selling”. As such, “marketing studies” could include “advertising”. “Market research” is defined in *Compact Oxford English Dictionary*⁵ as “the activity of gathering information about consumers’ needs and preferences. Such research is very often carried out preliminarily to the launch of an advertising campaign. It is likely that advertising services and marketing research services are provided by the same undertaking or through the same trade channels to potential consumers. Users of “advertising services” and “marketing research and studies” are business enterprises who need to promote and sell their goods or services to consumers. Hence, the use and users of these services are the same.
32. The services of “business management assistance” and “commercial management assistance” covered by the third cited mark refer to the help in the

⁵ http://www.askoxford.com/concise_oed/marketresearch?view=uk

management of business affairs and commercial functions of a commercial undertaking. They should be broad enough to encompass “data processing services; photocopying services; document reproduction services” in the subject application in Class 35. Therefore, the nature and purpose of such applied-for services and the above services covered by the third cited mark are the same. Users of these services are also the same, namely business entities, and these services are likely to be provided through the same trade channels.

33. I also consider that “insurance services; electronic payment services” in the subject application in Class 36 are similar to “capital investment; financial management; fund investment” services covered by the third cited mark.
34. Since there are many investment-linked insurance products in the market and insurance companies often provide investment services to their clients, I consider that “insurances services” are similar to “capital investment” and “fund investment” services. Users of these services are also the same, namely individual users and business enterprises. These services are likely to be provided by the same service provider and through the same trade channels.
35. In my view, “electronic payment services” in the subject application are closely linked with “capital investment; financial management; fund investment” services covered by the third cited mark. These services serve the same purpose of managing financial resources. They are likely to be provided by the same service provider such as banks or through the same trade channels. Consumers of these services include individual users and business enterprises. Hence, use and users of these services are the same.

Comparison of marks

36. Mr. Wong referred me to *Broadhead’s Application* [1950] 67 R.P.C. 209 at page 215 that where the marks have a common denominator, one must in looking at the competing formulae pay much more regard to the parts of the formulae which are not common, although it does not flow from that one must treat the words as though the common part was not there at all.
37. However, according to the principles stated in paragraph 13 above, in comparing the subject marks and the cited marks, I must take into account the visual, aural and conceptual similarities of the marks, based on the overall impressions given by the marks, bearing in mind, in particular, their distinctive and dominant components. I have reminded myself that the assessment of the similarity between different 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 (Case C-120/04) [2006] E.T.M.R. 13 at paragraph 29). In this regard, 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 AG v OHIM* (Case T-135/04) [2006] E.T.M.R. 58 at paragraph 59).

38. I must also have regard to the perception of the marks in the mind of the average consumers of the services in question. The services at issue are mainly business management, financial, freight forwarding and related services, and these services can vary in scale and complexity. The average consumers of these services include members of the general public as well as people in the trade. While the relevant consumers are deemed to be reasonably well-informed, circumspect and observant, it is unlikely that they would analyse the various details of a mark when they purchase or select the respective services.
39. Each of the subject marks in series consists of six Chinese characters “聯合包裹服務”. The only difference between the two subject marks is that one is written in complicated Chinese characters and another one in simplified Chinese characters. Both the first and third cited marks consist of two Chinese characters “聯合”. The second cited mark consists of four Chinese characters “聯合航空”.
40. Mr. Wong argued that visually, the subject marks looked completely different from the cited marks. The subject marks consist of six Chinese characters whereas the first and third cited marks only consist of two Chinese characters and the second cited mark only consists of four Chinese characters. Aurally, the subject marks consist of six syllables whereas the first and third cited marks only consist of two syllables and the second cited mark only consists of four syllables. Therefore, he considered that the subject marks as a whole were pronounced very differently from the cited marks (except that the first two syllables of the subject marks were the same as those of the cited marks).
41. Mr. Wong also submitted that although, as pointed out by the Registry in the previous correspondence, the Chinese characters “包裹服務” had some descriptive meaning, they did confer extra distinctiveness to the subject marks as a whole. This is particularly so when “聯合” is commonly used as a mark, which can be seen from the examples obtained from the register at **Annex C**.
42. Based on those examples, Mr. Wong further asserted that since the term “聯合”

itself was not an uncommon term both in everyday language and in trade mark sense, the public would be more careful in identifying the distinguishing parts of the marks to avoid any possible confusion. The public would not simply look at “聯合” and think that all sort of “聯合” marks came from the same undertaking.

43. I note that the first and third cited marks consist of two Chinese characters “聯合” only. These Chinese characters have no apparent meaning or bearing in relation to the services for which the first and third cited marks are registered. They are therefore, in my view, distinctive of those services.
44. The second cited mark consists of four Chinese characters “聯合航空”. Similarly, I consider that the first two Chinese characters “聯合” are distinctive of the services covered. The last two Chinese characters “航空” have the meaning of “aviation”, “by air” or “airline”. When used in relation to the services for which the second cited mark is registered, the Chinese characters “航空” are likely to convey to consumers the message that the services relate to aviation or are provided by air or airline. The Chinese characters “航空” are therefore descriptive and indistinctive of those services. As is clear from *Jose Alejandro SL v OHIM* (Case T-129/01) [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 conveyed by the mark. In my opinion, the Chinese characters “聯合” stand out in the second cited mark as they are distinctive and appear at the beginning of the second cited mark. Viewing the second cited mark as a whole and taking account of the principle of imperfect recollection, I find that the overall impression created by the second cited mark is dominated by the Chinese characters “聯合”.
45. Regarding the subject marks, they also contain the Chinese characters “聯合” which are distinctive in relation to the goods and services applied for. The Chinese characters “包裹服務” have the meaning of parcel or packaging services. When used in relation to the goods and services for which the subject marks are applied for, the Chinese characters “包裹服務” merely indicate that those goods and services relate to parcel or packaging services. Those Chinese characters are therefore descriptive and indistinctive of those goods and services. In my opinion, the Chinese characters “聯合” stand out in the subject marks as they are distinctive and occupy the frontal parts of the subject marks. They are followed by the Chinese characters “包裹服務” which are descriptive and indistinctive in relation to the applied-for goods and services. Having considered the subject marks as a whole, I consider that the overall impressions

created by the subject marks would be dominated by the Chinese characters “聯合” and the Chinese characters “包裹服務” are insignificant within the overall impressions created by the subject marks. Accordingly, I find that the Chinese characters “聯合” will, for the average consumer, constitute the distinctive and dominant components of the subject marks.

46. In comparing the subject marks and the cited 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.
47. Visually and aurally, the subject marks and all the cited marks share the identical Chinese characters “聯合”. In my judgement, the subject marks and the cited marks are visually and phonetically similar to the extent that all of them contain the distinctive Chinese characters “聯合” and this common element occupies the frontal part of the marks, which leaves a stronger impression on the minds of the consumers. Thus, the differences in the indistinctive and descriptive Chinese characters (i.e. “包裹服務” and “航空”) do not serve to counteract the visual and phonetic similarities between the subject marks and the cited marks.
48. Conceptually, as analyzed above, given their relevance to the goods and services applied for, the Chinese characters “包裹服務” are insignificant within the overall impressions created by the subject marks. The overall impressions of the subject marks left in the mind of the average consumers lie in the Chinese characters “聯合”. This is the same as the distinctive overall impressions projected by the cited marks. Thus, the subject marks and the cited marks share conceptual similarity.
49. I am not convinced by Mr. Wong’s argument that the term “聯合” is a common term such that the public will be more careful in identifying the distinguishing parts of the marks to avoid any possible confusion. There is no concrete evidence before me that the term “聯合” has become a common term. The state of the register does not tell me what is actually happening out in the market (*British Sugar Plc. v James Robertson and Sons Ltd.* [1996] R.P.C. 281 at page 305). Additionally, the fact that the term “聯合” has been registered in other classes does not necessarily mean that such term is not distinctive in respect of the services applied for and the services protected by the cited marks. I would therefore disregard the state of the register evidence in that regard.
50. Having considered the similarities and dissimilarities between the subject marks and each of the cited marks, and taking into account the overall impression created by each of the subject marks and the cited marks, I consider that there is

substantial similarity between the subject marks and each of the cited marks.

Likelihood of confusion

51. Under section 12(3), likelihood of confusion refers to confusion on the part of the public as to the trade origin of the services in question. This is a matter of global appreciation taking into account all relevant factors and judging through the eyes of the average consumers of the services at issue.
52. As stated above, the relevant consumers of the Objectionable Services and the services of the cited marks are members of the general public and people in the trade. As the services in question are not daily household items, the relevant consumers would likely exercise some degree of care and attention in their purchase or selection of such services. However, it should also be noted that average consumers seldom directly compare marks side by side but rely upon their imperfect recollection of marks.
53. Having regard to the visual, aural and conceptual similarities and dissimilarities between the subject marks and each of the cited marks, and the similarity in the services involved, bearing in mind the principles set out in paragraph 13 above and taking into account all relevant factors, I consider that when the subject marks are used in relation to the Objectionable Services, the average consumers would be confused into believing that those services provided under the subject marks and the services provided under the cited marks come from the same undertaking or economically-linked undertakings. The subject marks might well be taken by consumers to be a mere variant of the cited marks or to denote a new line of the services in relation to parcels or packaging. In consequence, the subject marks are objectionable under section 12(3) on a *prima facie* basis.

Other matter

54. By reference to some correspondence exchanged between the Applicant and the owner of the first and second cited marks, and letters of consent and a co-existence agreement signed by the respective parties, Mr. Wong submitted that there had been some consensus or intention between the parties to have their respective marks co-existed and co-registered. He also pointed out that when that owner applied to register the first and second cited marks, the Applicant had given its consent for the registration of the marks upon that owner's request. Accordingly, it was inequitable for the first and second cited marks, which required the Applicant to give consent for registration in the first place, to serve as a hurdle or obstacle to the subject application.

55. Having examined the documents referred to by Mr. Wong, I do not agree that the owner of the first and second cited marks has given its consent to the registration of the subject marks by the Applicant. As conceded by Mr. Wong, the co-existence agreement and other documents are more specifically concerned about the English marks such as “United Parcel Service”, “United” and “UPS” and the subject marks have not been explicitly mentioned in them. There is no concrete evidence before me that the owner has the intention to allow the Applicant to register and use the subject marks. Accordingly, I consider that the documents do not assist the subject application.

Conclusion

56. In this decision, I have considered all the 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 marks in respect of the Objectionable Services is precluded by section 12(3) of the Ordinance by virtue of the cited marks in Classes 35, 36 and 39. The subject application in respect of the Objectionable Services is accordingly refused under section 42(4)(b) of the Ordinance.

57. As I find that the registration of the subject marks can be accepted in respect of the Unobjectionable Goods and Services set out in paragraph 6 above, the application for registration in respect of such goods and services can proceed to publication provided that the Applicant files, on or before **16 July 2009**, an amendment on Form T5A to amend the specifications by restricting the subject application to the Unobjectionable Goods and Services only. If the Applicant fails to do so on or before **16 July 2009**, the subject application in respect of those goods and services is deemed to be abandoned.

Sandra Hui
for Registrar of Trade Marks
16 June 2009

Annex A

Class 9

Computer programs; computer hardware and computer software; batteries; alternative power supply appliances; voltage surge protectors; magnetic discs and tapes; printers, scales and scanners; computer software for providing automated download of files; for preparing and printing of shipping labels, documents and invoices; for providing electronic shipping labels, shipping documents and invoices; for providing information on available transportation and delivery services, and for providing proof of delivery documentation, including digitized signature of the recipient of the package, and for the receipt, transmission and processing of customer identifying shipping account information.

Class 35

Advertising services; business management relating to logistics; business management services; business consulting services; business administration services; office functions services namely assisting in the management of the business affairs or commercial functions of customers; management assistance services; management consulting services; providing computerized business information of packages in transit for tracking and tracing purposes; business management services relating to sorting and routing of mail packages; retail store services relating to stamps and office supplies; data processing services; photocopying services; document reproduction services; provision of business assistance in the establishment of franchisers; provision of on-line business information over the Internet relating to shipping of packages and documents; business management of transportation networks; distribution of samples; all included In Class 35.

Class 36

Insurance services; financial services; monetary services; credit services; customs brokerage services; reclamation of import duties for others; real estate agency services; real estate brokerage services; financial brokerage services; commercial lending services; bonding services in the nature of underwriting customs bonds; provision of temporary import bonds; custom brokerage services for the processing of import visa quotas; provision of customs bonds; custom brokerage services relating to duty drawbacks; electronic payment services; factoring services; warranty claims administration services; underwriting services; risk management; all included in Class 36.

Class 39

Freight forwarding; packaging articles for transportation; services of transportation of letters, documents, communications, printed matter, and goods and property by diverse means of transportation; warehousing, storage, packing, delivery and returns with respect to the foregoing; providing computerized information on domestic and international transportation and delivery services; arranging ship charters for others; rental of document boxes, document forwarding and receipt and delivery of documents for others; customs clearance; all included in Class 39.

(A) The first cited mark

Trade Mark no. : 199806482

Trade Mark : **聯合**

Owner's name : UNITED AIR LINES, INC.

Specification of services : Class 39
transportation of persons by air; all included in Class 39

Date of registration : 2 March 1992

(B) The second cited mark

Trade Mark no. : 199710407

Trade Mark : **聯合航空**

Owner's name : UNITED AIR LINES, INC.

Specification of services : Class 39
transportation of persons, mail and property by airlines; all included in Class 39

Date of registration : 2 March 1992

(C) The third cited mark

Trade Mark no. : 199804210AA

Trade Mark : **聯合**

Owner's name : ALLIED GROUP LIMITED

Specification of goods and services: Class 29
food preparations made from fish, caviar, lobsters; all included in Class 29.

Class 35
business appraisals; business management assistance; business management and organisation consulting; commercial or industrial management assistance; and marketing research and studies; all included in Class 35.

Class 36

capital investment, financial management; financial valuation; fund investment; leasing of real estate; real estate appraisal, broking and management; all included in Class 36.

Class 37




construction of buildings; construction of roads; construction of bridges; construction of tunnels; construction engineering; rental of construction apparatus; demolition of buildings; and factory construction; all included in Class 37.



Date of registration

: 4 July 1997

Annex C

Examples of marks bearing the Chinese characters “聯合” on the register:

Trade Mark No.	Mark	Class	Owner
199710402	聯合	16	United Air Lines, Inc.
199806482 (first cited mark)	聯合	39	United Air Lines, Inc.
199710403	聯合航空	16	United Air Lines, Inc.
199710407 (second cited mark)	聯合航空	39	United Air Lines, Inc.
199906196	聯合	42	Lai Ching Chen, Kingson and Lee Cheng May trading as Union Patent Service Centre
199802799	聯合	29	Flavor Full Foods Inc.
199804214AA		29, 37	Allied Group Limited
199806892	加州聯合銀行	36	Union Bank of California, N.A.
199707423	銀業聯合保險有限公司	36	Bankers Alliance Insurance Company Limited
200212342		42	UMP Professional Management Limited
200208042		36	United Asia Finance Limited

300135837	<i>UMP Dental Centre</i> 聯合牙科中心	44	UMP Dental Services Limited
300577125	A  聯合銀行 UNITED COMMERCIAL BANK B  聯合銀行 UNITED COMMERCIAL BANK	36	United Commercial Bank