

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300798931AB

MARK : BLUGIRL

APPLICANT : BLUFIN S.P.A.

CLASS : 18

STATEMENT OF REASONS FOR DECISION

Background

1. On 17 January 2007, Blufin S.p.A. (“the Applicant”) filed an application for the registration of **BLUGIRL** (“the subject mark”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”). The application was in respect of a miscellany of goods in Classes 9 and 18. The application was subsequently divided into two, one in respect of the goods in Class 9 and the other in respect of the goods in Class 18. The subject application is the latter one and is in respect of the following goods: -

“Leather and imitations of leather; goods made of these materials included in this class; animal skins, hides; trunks, travelling bags, knapsacks and travelling articles included in this class; bags, handbags, shoulder bags, pouches and the like; beauty bags, beauty cases and vanity cases; wallets, key-cases, change-purses; umbrellas, parasols and walking sticks; saddlery.”

2. At the examination stage, an objection was raised against this application under section 12(3) of the Ordinance on the basis of the following registered trade mark. (“the cited mark”):

Cited Mark

Trade mark : **BLUE GIRL**

Registration no. : 200012945AA
Date of registration : 17 December 1997

The cited mark is registered in respect of various goods and services in Classes 14, 18, 28, 33 and 42. The goods covered by the specification of Class 18 are set out below:

Class 18

leather and imitations of leather, and goods made of these materials and not included in other classes; bags, cases, wallets and purses, key cases, umbrellas, walking sticks; all included in Class 18.

3. During the examination stage, the Applicant filed evidence in the form of a statutory declaration by Gianguido Tarabini of the Applicant to show that there had been honest concurrent use of the subject mark. The objection to registration was maintained after review of the evidence by the examiner.
4. The Applicant requested a hearing on the registrability of the subject mark. This was held before me on 13 May 2010. At the hearing, Mr. CM Ng of Vincent Luk & Associates (“the Agent”) appeared on behalf of the Applicant. I reserved my decision at the conclusion of the hearing.

Provisions of the Ordinance

5. The relative grounds for refusal of an application for registration of a trade mark are set out in section 12 of the Ordinance. The relevant provision, subsection (3), states 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*
- the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”*

6. The term “earlier trade mark”, as referred to in section 12(3), 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 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.”

As the cited mark has a date of application for registration earlier than that of the subject mark, it is an “earlier trade mark” in relation to the subject mark.

7. On the interpretation of paragraph (c) of section 12(3), section 7(1) of the Ordinance is relevant. It 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.”

8. The provisions on honest concurrent use are set out in section 13 of the Ordinance and they read :

“(1) Nothing in section 12 (relative grounds of 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; or

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

(2) The registration of a trade mark under or by virtue of subsection (1) shall be subject to such limitations and conditions as the Registrar or the court thinks fit to impose.”

Decision

Prima facie registrability

9. Mr. Ng made no submissions at the hearing on the objection raised under section 12(3) of the Ordinance. Nonetheless, he mentioned that the Applicant would rely on the submissions made during the examination stage in this regard. I shall therefore deal with the basis of the objection.

10. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994¹, which implements Article 4(1)(b) of the European Trade Marks Directive 89/104/EEC². Appropriate guidance in considering the ground of objection to registration under section 12(3) of the Ordinance can therefore be gleaned from a number of decisions of the European Court of Justice relating to the application of the aforesaid Article 4(1)(b).

11. According to the case of *Sabel BV v Puma AG* [1998] R.P.C. 199, the likelihood of confusion must be appreciated globally, taking into account all relevant factors. The matter has to be judged through the eyes of the average consumer of the goods or services in question who normally perceives a mark as a whole and does not proceed to analyse its various details. In the case of *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, the average consumer is said to be one 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

¹ Section 5(2) of the UK Trade Marks Act 1994 provides as follows –

“(2) A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

² Article 4(1)(b) of the European Trade Marks Directive 89/104/EEC of 21 December 1988 provides –

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

.....

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

the imperfect picture of them that he has kept in his mind.

12. In addition, in assessing the likelihood of confusion, I am mindful of the principle established in the case of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117 (“the *Canon* case”); that is, 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. The *Sabel BV v Puma AG* case, supra, also suggests that 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.
13. To determine whether registration of the subject mark is prohibited under section 12(3) of the Ordinance, I have to consider whether the subject mark would likely cause confusion on the part of the relevant consumers as a result of it being similar to the cited mark and because they are to be registered in respect of goods the same as or similar to the goods in respect of which the cited mark is registered. In assessing the likelihood of confusion, I may, according to section 7(1) of the Ordinance, take into account all factors relevant in the circumstances.

Comparison of marks

14. A comparison of the marks concerned has to be based on an overall assessment of the visual, aural and conceptual similarities of the marks, taking into account the overall impression given by the marks, and bearing in mind, in particular, their distinctive and dominant components. I have to consider the similarities as well as the dissimilarities between the marks and have regard to the perception of the marks in the mind of the average consumer of the goods in question.
15. Apart from leather, imitations of leather, saddlery and animal skins and hides, the goods applied for are general personal items like bags, cases and umbrellas, which people used in their daily lives. The relevant consumers of such goods are members of the public. They are reasonably well informed and reasonably observant and circumspect, but they cannot be expected to pay great attention in their purchase of such goods.
16. As for saddlery, although equestrian events have become a bit more popular in

Hong Kong after the hosting of such events by Hong Kong in the 2008 Olympic Games, such goods are still required only by people involved in the keeping of horses, whether for racing or for the provision of training in horse riding. Similarly, leather, imitations of leather, animal skins and hides are not something the general public have a need for and they will only be of concern to manufacturers of items made from leather or imitations of leather. Such users can be expected to afford more attention than the general public in their purchases of these items.

17. The subject mark is the one word “BLUGIRL” while the cited mark has two words “BLUE GIRL”. There are no other elements in either mark. The only other difference between the two marks is the absence of the alphabet “E” after “BLU” in the subject mark. Otherwise, the same alphabets appear in the same sequence. All the letters are represented in block letters and there is no stylization or any other features that will aid in the distinguishing of one from the other. Visually, the similarities between the marks are substantial.
18. Phonetically, the two marks are pronounced in the same way and hence there is aural identity as well. As for the conceptual connotation conveyed by the two marks, I find them to be the same too. The absence of the letter “E” in the subject mark may well escape the attention of the consumers of daily use items. With the relevant consumers of items like leather, saddlery and animal skins and hides, they may probably notice the difference. However, the word “BLU” does not have a meaning of itself in the English dictionary and given its similarity with the word “BLUE”, the idea that such consumers will form from gleaning the subject mark will also be that of “blue girl”. Thus, both aurally and conceptually, the two marks are identical.

Comparison of goods

19. On the comparison of goods, the principles laid down in the cases of ***British Sugar v James Robertson and Sons Ltd*** [1996] R.P.C. 281 are relevant. According to the ***British Sugar*** case (at page 296-7), the factors that should be taken into account when considering the similarities between goods 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-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.

20. A glance at the specification for the two marks clearly shows that all goods in Class 18 in respect of which the cited mark is registered are found in the specification of the subject mark. With those not so included, many are specific items that come under the generally described goods in the specification of the cited mark. For example, trunks, travelling bags, knapsacks and travelling articles, handbags, shoulder bags, pouches and the like, beauty bags, beauty cases and vanity cases, change-purses are just various types and sizes of bags, cases or purses. Parasols are also only a specific type of umbrellas. Such items are therefore also identical to those covered by the registration of the cited mark. That leaves animal skins, hides and saddlery to be considered.

21. Leather is made from animal skins and hides. One has been processed while the other is the raw material or the semi-processed material. Both can be made into other products eventually like shoes and handbags. Thus, the use of the two items is the same. Manufacturers of leather goods should be able to source leather from the same supplier as animal skins and hides and hence they share the same trade channels. As animal skins and hides are the source of leather, the users of the two can be the same and they can be regarded as competitive. Although their physical natures are different, when all factors are considered, animal skins and hides should be regarded as similar to leather.

22. Saddlery is the collective term for leather equipment for horses. Albeit made for specific purposes, they can aptly be considered as goods made of leather and

thus also covered by the specification of the cited mark. I therefore regard saddlery also as identical to the goods in respect of which the cited mark is registered.

Likelihood of confusion

23. Having compared the marks in question and the goods of concern, I still have to consider the other requirement under section 12(3) of the Ordinance, namely, whether the use of the mark applied for on the goods in question will likely cause confusion on the part of the public. To do so, I have to apply the global appreciation test, taking into account all relevant factors. In assessing the likelihood, I need to consider the normal and fair use of the two marks as they are.
24. As indicated in the analysis above, the visual similarities between the subject mark and the cited mark are substantial while the two are identical aurally and conceptually. As for the similarities of the goods, apart from animal skins and hides, all the goods applied for are identical to the goods registered under the cited mark. With animal skins and hides, they are regarded as similar to leather. Although the relevant consumers of a few items can be expected to afford greater care and attention in their selection of the products in question, they will not analyse every detail of the mark. I need also to bear in mind that the comparison is not of the marks side by side, and that the consumers only have their imperfect recollection to rely on. Thus, with such high level of similarity between the marks and the identity or similarity between the goods, there is a real likelihood of confusion.
25. At the examination stage, the Applicant was represented by another agent. The case put forward on behalf of the Applicant was based on the visual differences between the two marks. The applicable principles as stated in paragraphs 10-13 above were referred to by the former agent, including the global appreciation test and in particular the statement from the *Canon* case, that a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity between the goods or services, and vice versa. It was submitted that a reasonably well informed, circumspect and observant consumer would be able to perceive the visual differences and so would unlikely be confused as to the trade

origin of the respective goods.

26. I do not find that to be a correct application of the global appreciation test. In the first place, the comparison of the marks has to be conducted on the basis of the marks as a whole and not merely on the visual impressions given by the marks. It is also not appropriate to make the comparison by taking into account only the differences but not the similarities. When the overall impression of each of the two marks is considered, they would be regarded as similar marks rather than dissimilar marks. Furthermore, I do not see how the aforesaid principle enunciated in the *Canon* case can be of help to the Applicant when there is such close proximity between the marks as well as between the goods in question.
27. Rather, with all the relevant factors taken into account as demonstrated in the discussions above, I find that there is a real likelihood of confusion of the origin of goods applied for if the subject mark is allowed to co-exist with the cited mark. The subject mark is therefore precluded from registration under section 12(3) of the Ordinance.

Honest concurrent use

28. I need to start off with a point on the admissibility of the evidence submitted. The statutory declaration filed (“Tarabini Declaration”) was made by a person whose name appears on the front page as Gianguido Tarabiniin in Italy. According to the text of the Tarabini Declaration, it has nine exhibits, numbered as “Exhibit A to I”, and the contents of each are described as follows :-

Exhibit A	List of Hong Kong distributors of the Applicant
Exhibit B	Catalogue of the Applicant
Exhibit C	Sales records regarding the volume of sales in Hong Kong for 2002-2006
Exhibit D	Random sample invoices issued by the Applicant and the Applicant’s licensee
Exhibit E	Samples of print advertisements in magazines in Hong Kong
Exhibit F	Print-outs from the Applicant’s website
Exhibit G	Sample print-outs of server log files form webhosting service

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| | provider of Applicant's website |
| Exhibit H | Sample print-outs showing Applicant's goods during its 20 annual fashion shows |
| Exhibit I | Other materials bearing the mark |

29. The requirements for making a statutory declaration for the purposes of any proceedings before the Registrar can be found in section 80 of the Trade Marks Rules (Cap. 559, sub. leg.) ("the Rules"). It is clearly stated there that if the declaration is made outside Hong Kong, it has to be made before certain authority or persons which include a notary public.
30. The Tarabini Declaration is bound on the side to form one single document. It has five pages with substantive content, one backsheet following the first five pages and eight cover sheets for Exhibits A-H at the end. The contents of the exhibits were placed in a box, physically separated from the Tarabini Declaration. Only the signature of the declarant is found on the fifth page of the declaration, although a space had been marked for the signature of the notary public in whose presence the declaration was supposed to have been made. No signature appears in the space. At the backside of the fifth page and also of each of the cover sheets for the exhibits, a uniform passage in the Italian language can be found but no translation was provided at the time the declaration was filed. At the end of this passage on every page where it appears, an imprint of a seal or chop can be found and the signature of another person has been subscribed.
31. With the Tarabini Declaration in such shape, there is doubt as to whether the requirements of section 80 of the Rules are met. The Applicant was therefore asked to provide a certified translation of the passage in question. This was not produced until I asked Mr. Ng about it at the hearing, after he had completed his own submissions. He tabled a two page document. Save for the words "Certified translation" printed on it, the first page is blank. There is nothing on the second page save for two passages in English, the first of which should, by reason of the circumstances of its procurement, be the English translation of the passage in Italian that appears on the backside of the various pages of the Tarabini Declaration. According to this translation, the Tarabini Declaration was made by the deponent in the presence of Dr. Aldo Fiori, a notary public in Capri, Italy.

32. Below this passage is a declaration by the translator of, inter alia, her knowledge of both the Italian and the English languages. What follows reads “...THAT TO THE BEST OF MY KNOWLEDGE AND BELIEF THE FOLLOWING IS A TRUE AND COMPLETE TRANSLATION INTO THE ENGLISH LANGUAGE MADE BY ME OF THE DOCUMENT IN ITALIAN LANGUAGE ATTACHED THERETO”. Contrary to what is stated in the declaration by the translator, there is nothing else attached to the document, whether in the Italian language or otherwise. The English translation also precedes instead of follows the declaration of the translator.
33. The problem with the statutory declaration does not end there. As mentioned, the bound Tarabini Declaration has eight cover sheets for Exhibits A-H. There are however nine sets of exhibits in the box submitted, Exhibits A-I. Not only that, each has a separate cover sheet, without notarization, on top. In addition, although a description of each exhibit can be found in the contents of the Tarabini Declaration (as set out in paragraph 28 above), Exhibit C and Exhibit G are in fact blank or empty.
34. I should add that the name of the person making the statutory declaration is not itself beyond doubt. The name given on the front page and in the first paragraph where the deponent was described is Gianguido Tarabini. When this person signed on the fifth page of the Tarabini Declaration, a name chop was affixed and that shows the name as Tarabini Gianguido. This is also the case with the name appearing in the passage in Italian on the backside of the various pages of the Tarabini Declaration, and so in the purported English translation tendered as well.
35. A problem with the date on which the Tarabini Declaration should also be mentioned. On the page where the signature of the deponent was subscribed, the date printed on it is November 2008. The English translation provided however records the attendance of the deponent at the office of the notary public and the making of the signature there on 5 February 2009. This also casts doubt on the manner in which the Tarabini Declaration was made.
36. Against such background, I have to first consider the admissibility of the

Tarabini Declaration. Section 120 of the Rules is clear about the requirement of a translation of a document or such part of it that is not in Chinese or English. The translation has to be verified as corresponding to the original text to the satisfaction of the Registrar. Since there is no basis to relate the translation provided to the passage appearing on the backside of the various sheets of the Tarabini Declaration, there can be no verification that it corresponds to the original text. In the absence of a satisfactory translation, I cannot be satisfied that the requirements of section 80 of the Rules have been met. The Tarabini Declaration is therefore inadmissible and there is no evidence on which a case of honest concurrent use can be made out. The application for registration of the subject mark has to be refused.

37. In case I am wrong about the admissibility of the Tarabini Declaration, I am prepared to go through the materials filed as if all the formalities for the filing of evidence have been duly observed. For this purpose, I shall now turn to the assessment of whether there had been honest concurrent use of the subject mark on the presumption that the Tarabini Declaration conforms to all the requirements of section 80 of the Rules.
38. Under section 13 of the Ordinance, a mark would not be prevented from registration under section 12 if there has been an honest concurrent use of the mark and the earlier trade mark. As noted in the recent judgment in the *C.S.S. Jewellery Company Limited v The Registrar of Trade Marks* (HCMP 2602/2008), the following two-stage determination is required:
 - (1) whether there has been an honest concurrent use of the subject mark and the cited mark;
 - (2) if the answer to (1) is in the affirmative, whether after considering all relevant circumstances, including public interest, the Registrar's discretion should be exercised to accept the application for registration, despite the fact that the use of the subject mark in relation to the goods or services in question is likely to cause confusion on the part of the public.
39. The point of time for establishing honest concurrent use is the date of this application, that is, 17 January 2007. The task before me is therefore to

consider whether a case of honest concurrent use of the subject mark as at 17 January 2007 can be made out.

Stage (1)

40. To pass the examination for stage (1), the Applicant has to show that there had been use of the subject mark as a trade mark in respect of the goods applied for, that such use of the subject mark had been made concurrently with the cited mark and that such concurrent use had been honestly made.
41. The contents of the Tarabini Declaration only give an incomplete picture of the status of use of the subject mark. There are many places where the draftsman of the declaration gave direction in parenthesis for details to be inserted so as to complete the picture but this had not been done at the time the declaration was made. For example, information about the advertising expenditure was supposed to be set forth in paragraph 10 of the Tarabini Declaration but the deponent had just left the phrase “[advertising expenditure]” intact there without putting in any details. As a consequence, one can only gather from whatever information that has been put in some aspects of the use of the subject mark.
42. During the examination stage, a number of problems with the position of use as demonstrated by the Tarabini Declaration had been drawn to the attention of the Applicant. At the hearing, Mr. Ng only dealt with one of them, namely whether the use of another mark can be considered as use of the subject mark for the purpose of showing honest concurrent use. It has been pointed out to the Applicant that the use averred to in the Tarabini Declaration relates to the mark represented below (“the Actual Mark”) and not the subject mark –



43. Mr. Ng did not dispute the factual finding. He only put it to me that the use of the Actual Mark should be accepted as use of the subject mark. According to

him, each of the three elements of the Actual Mark – the word “BLUGiRL”, the word “BLUMARINE” and the device should be considered as a separate mark, with “BLUMARINE” being the house mark and “BLUGiRL” being a secondary mark. Although the letter “i” in the word “BLUGiRL” as it appears in the Actual Mark is not in the upper case, Mr. Ng took the view that “BLUGiRL” is so similar to the subject mark that they should be regarded essentially as the same mark. In support, he referred me to the passage in para 8-118 of the 14th edition of *Kerly’s Law of Trade Marks and Trade Names* which reads as follows:-

“Potentially, this is a problem which faces any trader who claims that there is more than one badge of origin for his product or service. The trader has a primary mark which the public see as a badge of origin. However, the trader wishes to establish a secondary mark as an additional badge of origin. Whether he succeeds obviously depends on the facts. The potential problem is avoided if, for example, the secondary mark has an inherent distinctive character of its own, particularly if such a mark joins a group of other secondary marks on a range of products all sold under a recognized house mark. However, the problem faces any trader who adopts as his secondary mark a descriptive or laudatory word, some feature of the goods or their get-up which is seen as decorative or, worse, functional. The problem inherent in the mark itself is then compounded by being used in conjunction with a distinctive mark.”

Mr. Ng also went on to refer to the examples cited in *Kerly’s* and in the case of *Philips Electronics BV v Remington Consumer Products* [1998] RPC 283, at 312 as well as an Indian case *Parle Products* [2009] FSR 727 at 735 where secondary marks were given recognition,. It was his submission that, given that the subject mark did not face any absolute grounds of refusal, it could serve as a secondary mark.

44. I agree that each of the elements in the Actual Mark can be separate marks on its own. However, the reason for raising an objection under section 12(3) of the Ordinance in the first place is to prevent the causing of confusion to the relevant consumers of the goods in question because of the identity or similarity of one mark with another. Thus, to establish honest concurrent use, use of the mark as applied for, not on its own but in conjunction with other marks or other elements in such a way that will effectively remove the likelihood of confusion is of no

help to the applicant.

45. I face one other difficulty in accepting the suggestion of Mr. Ng. The subject mark is not presented in the same way as applied for when used as an element of the Actual Mark. Putting aside the difference in the presentation of the letter “T”, the fact that the Actual Mark is formed by the three elements to form one composite is apparent. The two words are specifically arranged to form the border of an oval shape, with the space in between them occupied by the device. To the relevant consumers, the subject mark is perceived as an element of the Actual Mark rather than as a secondary mark used in conjunction with a house mark or primary mark. To regard the use of the Actual Mark as use of the subject mark will be to fly in the face of the public perception of marks.
46. As for the passage from *Kerly’s* quoted by Mr. Ng, I do not see how it can lend support to the Applicant’s case. Chapter 8 of *Kerly’s*, from which para 8-118 is extracted, deals with the absolute grounds of refusal of registration under the UK Trade Marks Act 1994 and the European Trade Mark Directive 89/104/EEC, which are similar in effect to section 11(1) of the Ordinance. For instance, the earlier sections of that chapter, sections 1-7, touch upon the issues relevant to objections that can be raised against an application for registration of a trade mark under Article 3(1)(a) to (d) of the Directive and section 3(1)(a) to (d) of the Act³ and are concerned only with the assessment of the distinctiveness of a mark. Section 8 of that chapter, of which para 8-118 forms part, covers a host of miscellaneous points, all of which are tied to the evaluation of distinctiveness. It is also clear from the context of para 8-118 that it is only talking about when a secondary mark will be considered as being capable to serve as an additional badge of origin.
47. The ability of the subject mark to serve as an identifier of trade source is a separate and distinct matter from the likelihood of confusion that it may cause if it is used in parallel with an identical or similar mark in respect of identical or similar goods. That being the case, I do not see how the passage from *Kerly’s* or the examples sought to be relied on by Mr. Ng can take the Applicant’s case any further.

³ Corresponding in effect to section 11(1)(a) to (d) of the Ordinance

48. Although not addressed by Mr. Ng at all, for the sake of completeness, I should go through the other concerns identified upon a review of the Tarabini Declaration. When asked why the Applicant had not responded to the other comments of the Registry, Mr. Ng indicated that the Applicant would have corrected those problems had it been able to. This suggests to me that the Applicant is of the view that it should be able to rely on honest concurrent use if it succeeds in persuading me to accept the use of the Actual Mark as use of the subject mark. That cannot be further from the truth.
49. In paragraph 4 of the Tarabini Declaration, the Applicant refers to the first use of the subject mark and some other marks, including the Actual Mark, in Italy and in Hong Kong. The wording is ambiguous as it is not clear whether the year of commencement of use relates to the subject mark or any one of the other marks or all of them. The year of first use as stated is April 1995 for Italy and September 1995 for Hong Kong and the Applicant claims continuous use of the subject mark in Hong Kong since then. This claim cannot however be verified from the materials provided, in particular when the use shown is merely that of the Actual Mark.
50. Information about the volume of sales in Hong Kong of the goods applied for from 2002-2006 is set out in paragraph 8 of the Tarabini Declaration. The figures are the same as those provided by the Applicant for showing honest concurrent use of two other marks⁴ the registration of which is separately applied for, and so it would appear that all three marks contributed to the sales figures reported. It was pointed out at the examination stage that without a breakdown showing the sales that should be attributed to each mark, the extent of use of each of them could not be ascertained. As the Applicant has not provided further information on this, the extent of sales of goods applied for under the subject mark cannot be established.
51. Another major setback with the Tarabini Declaration is that the use shown relates to goods other than those applied for. This again had been pointed out to the Applicant during the examination stage; for example, information about fashion shows in Exhibit H shows mainly use of the Actual Mark in respect of clothing. In addition, with the voluminous copy invoices provided, only a handful record

⁴ TMA300798940AA and TMA300798959AA

sale of bags and belts.

52. There is actually a separate lot of copy invoices which relate to bags but they were issued in the name of EMMA SAS or EMMA SRL. There is indeed mention in the Tarabini Declaration of invoices issued by the Applicant's licensee. Nonetheless, in most of the invoices in this lot, the Applicant is named as the agent rather than the principal or licensor. In a few other cases, "DIREZZONALE" is named as the agent. Although the need for clarification of the capacity of the party issuing such invoices had been brought up, there has been no explanation from the Applicant.
53. There are a few other concerns with the Tarabini Declaration but they are relatively minor when compared with those deliberated in the above. These include the absence of any contents to Exhibits C and G, failure to insert details about, inter alia, the advertising expenditure and the fashion shows in paragraphs 10 and 16 of the declaration, and the fact that some materials post-date the filing of this application.
54. With the evidence in such deplorable shape, there can be no other finding but that the Applicant has failed to show that there had been use of the subject mark as a trade mark in respect of the goods applied for. Since the use of the subject mark has not been demonstrated, the other two requirements, namely that the use had been made concurrently with the cited mark and that such concurrent use had been honestly made, are also not satisfied. The answer to Stage (1) must be answered in the negative and it is not necessary for me to proceed to stage (2) of the assessment of honest concurrent use.
55. Despite the above finding, I wish to express in the clearest term that I am not suggesting in any way that the Applicant adopted the subject mark with any dishonest intent. There is absolutely no basis for any such suggestion. However, the onus is on the Applicant to show that there had been honest concurrent use. Had the Applicant been able to show that it commenced use of the subject mark in 1995 as claimed, prior to the application for registration of the cited mark, honesty of the use of the subject mark would have been presumed. Since the Applicant has failed to show use of the mark as applied for, it has to offer an explanation for its adoption. Such an account has not been provided.

Conclusion

56. I have considered all the documents put before me by the Applicant, including the Tarabini Declaration, and all written and oral submissions made in respect of the application and the authorities referred to. For the reasons stated above, the subject mark is precluded from registration under section 12(3) of the Ordinance. The application is accordingly refused under section 42(4)(b) of the Ordinance.

Caroline Chow
for Registrar of Trade Marks
8 June 2010