

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 301054557AD

MARK : A-STARS

APPLICANT : ALPINESTARS RESEARCH S.R.L.

CLASS : 25

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 February 2008, Alpinestars Research S.R.L. (“the applicant”) filed an application for registration of the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

A-STARS

2. Registration of the subject mark is sought in respect of “anoraks, trousers, shorts, jeans, gym suits, pants, shirts, t-shirts, pullovers, cardigans, jackets, wind-resistant jackets, knitwear, jersey, flannel waistcoats, jumpers, sweaters, skirts, dresses, blouses, vests, waterproof clothing, coats, raincoats, overcoats, topcoats, socks, hoisery, stockings, hats, caps, suits, track suits, salopettes, coveralls, dungarees, gloves, scarves, berets, sports footwear, shoes, boots, and slippers, shoes and boots for motorcyclists and motorists, casual riding shoes, casual footwear for motorcyclists and motorists” in Class 25. The subject application is a divisional application derived from an application bearing application number 301054557.
3. At the examination stage, objection was raised against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade mark (“the cited mark”) :

Cited Mark



Trade mark :
Registration no. : 300779068
Date of registration : 13 December 2006

The cited mark is registered in respect of “服裝，鞋，帽” (clothing, footwear, headgear) in Class 25.

4. By its letter dated 26 April 2010, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 9 November 2011, at which Mr. Lam Pok Man of Wenping & Co. appeared for the applicant. I reserved my decision at the conclusion of the hearing.
5. The applicant did not file any evidence of honest concurrent use of the subject mark and the cited mark under section 13 of the Ordinance.

The Ordinance

6. The objection is raised on the basis of section 12(3) of the Ordinance, which 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.”

7. As to the meaning of “earlier trade mark” as referred to in section 12(3), the relevant part of section 5 of the Ordinance 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...”

The date of application for registration of the cited mark is earlier than that of the subject mark. The cited mark therefore constitutes an “earlier trade mark” in relation to the subject mark for the purpose of section 5 of the Ordinance.

8. Another section to consider is section 7(1) of the Ordinance which throws light on how subsection (c) of section 12(3) is to be interpreted. 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.”

The applicant’s submissions

9. Mr. Lam’s main submissions are summarized as follows:

- (a) The cited mark is distinguishable from the subject mark as the former contains a button-like device and an enlarged letter “A”, whereas the latter consists of the word “STARS” in plural form.
- (b) There are a total of 57 marks in the register containing the word “STAR”, which illustrates that the word “STAR” is commonly used among traders of goods in Class 25.
- (c) The applied-for goods are specifically designed for cycling, motorcycling and motor-auto racing sports, whilst the cited mark is registered in respect of general items in Class 25. The goods covered by the respective marks are therefore not similar.
- (d) In order to overcome the citation, the applicant is prepared to restrict the scope of the applied-for goods by adding the words “all the above goods are relating to cycling, motorcycling and motor-auto racing sports” at the end of the specification.

Decision

10. 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 mark and the cited mark and between the goods covered by the two trade marks which would combine to create a likelihood of confusion.

11. The basic principles regarding the assessment of similarity between marks and the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] RPC 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and adopted in *Guccio Gucci SpA v Gucci* [2009] 5 HKLRD 28. These principles are:
 - (a) The likelihood of confusion must be appreciated globally, taking account of all the relevant factors.
 - (b) The matter must be judged through the eyes of the average consumer of the goods in issue, who is deemed to be reasonably well informed and reasonably observant and circumspect.
 - (c) In order to assess the degree of similarity between the marks concerned one must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into account the nature of the goods in question and the circumstances in which they are marketed.
 - (d) The visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion.

- (e) The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details.
- (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.
- (g) The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; further the average consumer's level of attention is likely to vary according to the category of goods in question.
- (h) Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*.
- (i) Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose of the assessment.
- (j) But the risk that the public might believe that the respective goods come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.

Comparison of marks

12. A comparison of the marks concerned has to be based on an overall appreciation of the visual, aural and conceptual similarities of the marks in question, taking into account the overall impressions given by the marks, and bearing in mind, in particular, their distinctive and dominant components.
13. In comparing the marks, I shall consider the perception of the marks in the mind of the average consumer of the goods in question. As the applied-for goods are everyday consumer items, the relevant consumers of these goods are members of the general public in Hong Kong. While the average consumer is presumed to be reasonably well-informed, circumspect and observant, it is unlikely that he would pay a particularly high level of care and attention in the purchase of such goods.

14. The subject mark consists of an invented word “A-STARs”, whereas the cited mark is composed of a similar word “A-STAR” and a button-like device.
15. Mr. Lam drew my attention to the various differences between the subject mark and the cited mark. He submitted that the button-like device and the letter “A” (which are larger than and placed ahead of the word “STAR”) in the cited mark stand out as the prominent features of the cited mark, whereas in the case of the subject mark, the use of the letter “A” followed by the word “STARs” in plural form is a clever play of words. He maintained that the subject mark is as a whole distinguishable from the cited mark.
16. I am not convinced by Mr. Lam’s submissions. Despite that the letter “A” in the cited mark is slightly larger than the word “STAR”, the difference in size between them is so minimal that the average consumer would still read them together as “A-STAR”. Such impression is enhanced by the adoption of the same case and typeface in the letter “A” and the word “STAR” and the presence of a hyphen as a connector between them. Although there is a button-like device in the cited mark which is absent in the subject mark, it is well settled that “words speak louder than devices”. In *Oyster Cosmetics SpA v Office for Harmonization in the Internal Market (OHIM) (OYSTER COSMETICS)* [2011] ETMR 26¹, the European Court of Justice explained, in paragraph 36:

“As regards the figurative elements of the mark applied for, although the stylised oyster is the same size as the first letter of the word element, it still cannot dominate the overall impression produced by the mark applied for in the memory of the relevant public. When a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element of the mark (see judgment of December 15, 2009 in *Trubion Pharmaceuticals v OHIM – Merck (TRUBION)* (T-412/08), not yet reported, at [45] and the case law cited)...”

¹ In that case, the court found that the overall impressions produced by the marks in question were dominated by their respective word elements, namely “oystra” and “oyster”, and in view of the substantial similarity between the two words in terms of visual, aural and conceptual comparisons, there was a finding of likelihood of confusion notwithstanding the existence of other word and figurative elements in those marks.

17. In the instant case, the device of a button in the cited mark cannot be pronounced. Such device is slightly descriptive of the applied-for clothing items and does not possess a particularly high level of distinctiveness. Contrary to the applicant's view, I think the distinctive word "A-STAR", rather than the button-like device, would stand out as the key identifying element in the cited mark.
18. As regards Mr. Lam's contention that the use of a plural term "STARS" with the letter "A" in the subject mark is a clever play of words so as to make it distinguishable from "A-STAR", I think that argument has gone too far. After all, the only difference between "A-STAR" and "A-STARS" is that the latter ends with the letter "S", which makes the latter the plural form of the former. To my mind, this subtle difference, even if noticed by consumers, would not enable the average consumer to distinguish the two marks from each other. In *IDG Communications Ltd's Trade Mark Application (DIGIT)* [2002] RPC 10, the UK Trade Marks Registry upheld the opposition to the application for registration of the mark "DIGIT" by reason of its similarity with an earlier mark "digits". The hearing officer analyzed, at paragraphs 26-27 of the decision, that:

"26. Visually on a side by side analysis of the two trade marks I have no hesitation in finding that there are clear similarities between the two trade marks. The opponents' and applicants' trade marks contain the same first five letters. The applicants' trade mark is contained within the opponents' trade mark and differs only in that it does not end with the letter S. The opponents' trade mark is the English word digits, the applicants' trade mark is the singular form of that word ... Aurally there are again clear similarities between the trade mark digits and DIGIT. They differ only in the letter S at the end of the opponents' trade mark and in my view they could easily be misheard.

27. It seems to me that there is also some conceptual similarity between the two trade marks. The applicants' trade mark calls to mind DIGIT meaning a finger, toe or a numeral and the opponents' is merely the plural form of that word. Mr Marsh pointed out that the applicants' trade mark DIGIT was short for digital; the applicants' magazine covers areas of interest associated with digital technology. Taking into account the applicants' use, that may be so but the applicants' specification is not restricted to use on magazines relating to digital technology.

Even if it was so limited, there remains, in my view, some conceptual similarity between the two trade marks.”

19. Mr. Lam also claimed that the existence of other marks containing the word “STAR” in the register illustrates that the word “STAR” is commonly used among traders of goods in Class 25. It should be noted that the state of the register does not necessarily reflect how marks would actually be used in the market place, and there is no evidence before me to show that the word “STAR” is a common element which has been in fairly extensive use in the market². Moreover, the “STAR” marks referred to by Mr. Lam at the hearing contain other elements which create very different overall impressions from those of the subject mark and the cited mark. On the other hand, both the subject mark and the cited mark comprise the ingredients of an alphabet “A” and a hyphen, which are absent in these registered marks. Hence, I do not see how these registrations could assist the applicant’s case.
20. Visually, the dominant and distinctive element of the cited mark i.e. the word “A-STAR” is almost identical to the sole element of the subject mark i.e. the word “A-STARS”. All letters of both words are represented in upper case and in plain form without any stylization. Hence, there is a clear visual similarity between the two marks. Phonetically, each of the marks will be referred to by their respective word elements “A-STAR” and “A-STARS”, which sounds confusingly similar. Conceptually, it is likely that consumers would regard “A-STARS” as the plural form of “A-STAR”, so there is also a high degree of conceptual similarity between the subject mark and the cited mark.
21. Taking into account the visual, aural and conceptual similarities between the subject mark and the cited mark as well as the differences between them as a whole, and bearing in mind the perception of the average consumer of the goods in question, I find the subject mark and the cited mark to be in close resemblance to each other.

Comparison of goods

² *Kerly’s Law of Trade Marks and Trade Names* (14 Edition), para.17-041

22. Guidance on the comparison of goods can be found in the case of *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281(at page 296-7). In that case, Jacob J (as he then was) set out the factors that should be taken into account when considering the similarities between goods and/or services. They 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.
23. It was also held in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra) that in assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.
24. I consider that the applied-for goods set out in the left column below are identical to those of the goods covered by the registration of the cited mark set out in the right column below:

Goods applied-for under the subject application (Class 25)	Goods covered by the cited mark (Class 25)
anoraks, trousers, shorts, jeans, gym suits, pants, shirts, t-shirts, pullovers, cardigans, jackets, wind-resistant jackets, knitwear, jersey, flannel waistcoats, jumpers, sweaters, skirts, dresses, blouses, vests, waterproof clothing, coats, raincoats, overcoats, topcoats,	clothing

socks, hoisery, stockings, suits, track suits, salopettes, coveralls, dungarees, gloves, scarves	
sports footwear, shoes, boots, and slippers, shoes and boots for motorcyclists and motorists, casual riding shoes, casual footwear for motorcyclists and motorists	footwear
hats, caps, berets	headgear

25. Contrary to what Mr. Lam suggested at the hearing, I do not find that the goods applied-for are limited to those relating to cycling, motorcycling and motor-auto racing sports. Save for a few items such as shoes and boots for motorcyclists and motorists, casual riding shoes, casual footwear for motorcyclists and motorists, all the remaining applied-for goods are general items of clothing, footwear and headgear in Class 25 which are considered to be identical³ to clothing, footwear and headgear protected by the registration of the cited mark. Even if the specification of the applied-for goods is qualified by the phrase “all the above goods are relating to cycling, motorcycling and motor-auto racing sports”, the goods as amended remain to be covered by and fall within the broad terms of “clothing, footwear, headgear” for which the cited mark is registered. The amendment cannot therefore assist in distinguishing the two sets of goods.

26. For the reasons stated, I find that the goods applied for are identical to the goods covered by the registration of the cited mark.

Likelihood of confusion

27. 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 through the eyes of the average consumer of the goods at issue.

³ 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 (*Merix v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-133/05); *Bowerbank's Application* [2008] ETMR 31)

28. As discussed in paragraph 13 above, the relevant consumers of the applied-for goods are ordinary members of the public. Given that the price and quality of the goods in question can vary widely, the average consumer can be expected to pay a reasonable degree of care and attention commensurate with the amount being spent. It should also be noted that the average consumer seldom directly compares marks side by side but rely upon his imperfect recollection of marks.
29. In addition, in assessing the likelihood of confusion, I have to be mindful of the principle established in the case of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (supra) that 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. In the instant case, the applied-for goods are considered to be identical to the goods protected by the registration of the cited mark.
30. Having regard to the visual, aural and conceptual similarities and dissimilarities between the subject mark and the cited mark, and the overlapping in the goods involved, bearing in mind the principles set out in paragraph 11 above and taking into account all relevant factors, I consider that when the subject mark is used in relation to the applied-for goods, the average consumer would be confused into believing that the respective goods provided under the subject mark and the cited mark come from the same or economically-linked undertakings. In the premises, the registration of the subject mark is objectionable under section 12(3) of the Ordinance.

Conclusion

31. I have considered all the oral and written submissions made by the applicant in respect of the subject application. For the reasons stated above, the subject mark is precluded from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Ryan Ng
for Registrar of Trade Marks
20 January 2012