

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

**APPLICATION NO. : 301179081AB**

**MARK : SIMOND**

**APPLICANT : ETABLISSEMENTS SIMOND**

**CLASS : 25**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 12 August 2008, Etablissements Simond (“the applicant”) filed an application for registration of the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

**SIMOND**

2. Registration of the subject mark was sought in respect of various goods in Classes 6, 8, 9, 11, 18, 20, 22, 25 and 28. The application was subsequently divided into two, one in respect of the goods in Class 25 and the other in respect of the goods in Classes 6, 8, 9, 11, 18, 20, 22 and 28. The subject application concerns only the goods in Class 25, which are:

“Clothing, footwear, headgear, trousers, jackets (clothing), gloves (clothing), waterproof clothing, anoraks, parkas, combinations, windcheaters, coats, underwear, shorts, bermudas, tee-shirts, tank tops, shirts, polo, pull-over, fleeces, scarves, belts, caps [headwear], headbands [clothing], caps [headwear], boots, shoes, soles for footwear, sandals, slippers for climbing, all the aforesaid goods being for the practicing of mountain sports (mountaineering) and climbing.”

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

Cited Mark

Trade mark : **SIMOD**  
Registration no. : 19851079  
Date of registration : 20 January 1982

The cited mark is registered in respect of “shoes, boots and footwear being articles of sports clothing” in Class 25.

4. By its letter dated 13 April 2010, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 11 October 2011, at which Mr. Joerg Sosna of Ella Cheong (Hong Kong) Limited 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.”

## **Decision**

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

9. 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.
10. 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*

11. 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.
12. 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 goods applied-for are general consumer items, the relevant consumers are members of the general public in Hong Kong, which are deemed to be reasonably well informed and reasonably circumspect and observant.
13. The subject mark “SIMOND” and the cited mark “SIMOD” are pure word marks without any device. Both marks compose of letters in upper case and in plain font without any stylization. They have five letters in common which appear in exactly the same sequence, including the beginnings and the ends. The only difference between the subject mark and the cited mark lies in the presence of the letter “N” near the end of the subject mark. However, such difference is so minor and insignificant that it may not be noticeable to the average consumer when the principle of imperfect recollection is taken into account. I find that there is a very high degree of visual similarity between the subject mark and the cited mark.
14. In terms of phonetic comparison, Mr. Sosna suggested that the subject mark would be pronounced as [ˈʃimɔ̃ŋ] or [ˈʃaimɔ̃ŋ], whereas the cited mark would be pronounced as [ˈʃimod] or [ˈʃaimod]. It was contended that the last syllable of the subject mark includes a clear nasal sound whilst its equivalent in the cited mark

is characterized by a “d-sound”. Although I agree with Mr. Sosna that the average consumer would treat both marks as two-syllable words, I do not consider that the difference in the last syllable of the respective marks renders them aurally distinguishable from each other when compared as wholes, taking into account that (i) both marks are composed of two syllables, (ii) the stress of both marks falls on their respective first syllable which is identical (whether pronounced as [‘ʃi] or [‘ʃai]), (iii) the sounds of the respective last syllable [mõŋ] and [mõŋ] are very much alike, and (iv) the tendency of consumers to slur the terminations of words. Aurally speaking, the subject mark is substantially similar to the cited mark.

15. Conceptually, Mr. Sosna submitted that “SIMOND” is a French family name whereas “SIMOD” may allude to the world of fashion on account of the syllable “-MOD”. He therefore considered that the subject mark and the cited mark are conceptually dissimilar.
16. Although “SIMOND” may be a family name in French, it is doubtful if the average consumer in Hong Kong would know about such meaning. In the present case, both “SIMOND” and “SIMOD” have no English dictionary meaning, and there is no evidence to suggest that they would convey any readily recognizable meanings to the general public in Hong Kong. As such, I am not convinced that the average consumer would perceive the subject mark and the cited mark as conceptually different.
17. 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 applied-for goods, I find the subject mark and the cited mark to be closely similar to each other.

#### *Comparison of goods*

18. Guidance on the comparison of goods can be found in the case of *British Sugar v James Robertson and Sons Ltd* [1996] RPC 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.

19. 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.
20. The goods applied-for include various items of clothing, footwear and headgear for the practicing of mountain sports and climbing in Class 25, whereas the goods covered by the registration of the cited mark are shoes, boots and footwear being articles of sports clothing in Class 25.
21. Mr. Sosna drew my attention that the applied-for goods are specifically qualified as designated for mountaineering and climbing. He averred that the goods for mountaineering and climbing are sold at specialized retail outlets for outdoor gear, whereas shoes, boots and footwear being articles of sports clothing are sold at general retail outlets and department stores. Mr. Sosna further submitted that the relevant consumers of the applied-for goods are a small segment of consumers in Hong Kong who engage in climbing and mountaineering activities and whose needs are more sophisticated. He also argued that the average consumers will not purchase such goods without due consideration and careful assessment of the products available in the market.

22. I do not find this argument persuasive. “Footwear, boots, shoes, soles for footwear, sandals, slippers for climbing, all the aforesaid goods being for the practicing of mountain sports (mountaineering) and climbing” are considered to be identical to “shoes, boots and footwear being articles of sports clothing” as mountain sports and climbing is a type of sports activity<sup>1</sup>. “Shoes, boots and footwear being articles of sports clothing” can include shoes, boots and footwear tailor made for mountain sports and climbing. For the rest of the applied-for goods, which are essentially clothing and headgear items for mountain sports and climbing, they are considered to be similar to “shoes, boots and footwear being articles of sports clothing” since they are both worn, have the function of covering and protecting and are often sold in the same outlets<sup>2</sup>. From my experience, it is not uncommon that sporting shoes brands produce clothing and headgear items for outdoor activities such as climbing and mountaineering, and vice versa, with these products available at the same point of sales or via the same trade channels. Where they are sold in the department stores, they are likely to be found in the same or nearby area, i.e. the sports section or the area designated for athletic and outdoor products. I do not think that consumers would merely look for the applied-for goods at specialized stores for outdoor equipment as suggested by the applicant. The users and target consumers are also the same, i.e. members of the general public including (but are not necessarily confined to) lovers of sporting or outdoor activities. In addition, footwear is often coordinated or matched with articles of clothing and headgear and chosen as a complementary item of the latter. Taking all these factors into account, I find that the applied-for goods are identical or closely similar to the goods protected by the cited mark.

#### *Likelihood of confusion*

23. 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.

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<sup>1</sup> Goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, or vice versa (*Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-133/05); *Bowerbank's Application* [2008] ETMR 31)

<sup>2</sup> *O'Neill Inc's Application* [2004] ETMR 50

24. As the goods in question are not necessarily expensive and could be found at various sales locations, the relevant consumers would exercise a reasonable degree of care and attention in their purchase of such products. It should also be noted that average consumers seldom directly compare marks side by side but rely upon their imperfect recollection of marks.
  
25. Having regard to the visual, aural and conceptual similarities and dissimilarities between the subject mark and the cited mark, and the fact that the respective marks would be applied to identical and closely similar goods, bearing in mind the principles set out in paragraph 10 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**

26. 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  
17 January 2012