

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

**APPLICATION FOR DECLARATION OF INVALIDITY OF TRADE MARK  
REGISTRATION NO. 300028917**

**MARK :**



**CLASS :** 29

**APPLICANT :** TAM YUN TIN TONY

**REGISTERED OWNER :** CAYUAN INTERNATIONAL LTD.

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 29 April 2008, **TAM YUN TIN TONY** (“Applicant”) made an application (“Application”) under the Trade Marks Ordinance (Cap. 559) (“Cap. 559”) for a declaration of invalidity of the registration of the following mark (“subject mark”):



(Trade Mark No. 300028917).

2. Registration of the subject mark was granted on an application for registration made on 6 June 2003 (“Filing Date”). The subject mark has been registered as of that date in the name of **CAYUAN INTERNATIONAL LTD.** (“Registered Owner”) in respect of the following goods (“subject goods”):

“Class 29

*dietary supplements (including ginger jam, eggs consumption, meat extracts, eggs powdered), other than for medical use; all included in Class 29.”*

3. The Registered Owner did not file a counter-statement within the prescribed period. The Application is therefore treated as unopposed by the Registered Owner under Rule 41(3) (as applied by Rule 47) of the Trade Marks Rules (Cap. 559 sub. leg.) (“TM Rules”).
4. Moreover, the Registered Owner failed to file an address for service within the prescribed two-month period after a notice under Rule 107(1) of the TM Rules was issued to the Registered Owner on 28 July 2008. According to Rule 107(3), the Registered Owner is deemed to have withdrawn from the subject invalidation proceedings.
5. The Applicant filed evidence by way of a statutory declaration of the Applicant dated 29 September 2008 (“Applicant’s Declaration”).
6. The Application was fixed to be heard on 16 June 2011. The Applicant did not file a notice of intention to appear at the hearing (Form T12) within the prescribed period. The Applicant is therefore treated as not intending to appear at the hearing under Rule 74(5) of the TM Rules. Pursuant to Rule 75 of the TM Rules, I proceed to decide the matter without a hearing.

**Grounds of the Application**

7. The Applicant relies on the grounds under, *inter alia*, sections 53(5)(a) and sections 12(1), (2), (3), (4) and (5) of Cap. 559.
8. The Applicant relies on the following mark (“Applicant’s Mark”):



(Trade Mark No. 200600239) registered as of 21 June 2001 in respect of the following goods (“Applicant’s Goods”):

“Class 29  
*dietary supplements, other than for medical use; all included in Class 29.”*

### **The material date**

9. The material date at which validity of the registration of the subject mark is to be determined is the Filing Date, i.e. 6 June 2003.

### **The ground under sections 53(5)(a) and 12(3) of Cap. 559**

10. Section 53(5)(a) of Cap. 559 provides, *inter alia*, as follows:

*“...the registration of a trade mark may also be declared invalid on the ground-*

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 12(1), (2) or (3) (relative grounds for refusal of registration) apply;”.*

11. Section 12(3) of Cap. 559 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.”*

12. Section 12(3) of Cap. 559 essentially prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of its being similar to an earlier trade mark and because it is to be registered in respect of goods or services the same as or similar to those the subject of the earlier trade mark. A trade mark which has been registered in contravention to section 12(3) of Cap. 559 may be declared invalid under section 53(5)(a) of Cap. 559.

13. According to section 7(1) of Cap. 559, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.
14. The Applicant's Mark has a date of application for registration which is earlier than that of the subject mark. According to section 5(1)(a) of Cap. 559, the Applicant's Mark is an earlier trade mark in relation to the subject mark.
15. The basic principles regarding the assessment of similarity between signs and the likelihood of confusion between them can be found in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, and have been adopted in *Guccio Gucci SpA v Gucci* [2009] 5 HKLRD 28. They are as follows:
  - (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 the court 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 trademark 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 goods come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.

#### *The relevant public*

16. The subject goods and the Applicant's Goods are dietary supplements other than for medical use. The average consumers of these goods include ordinary members of the public who are interested in these health products. They can be expected to be health-conscious and would pay a reasonably high degree of attention when selecting these goods.

#### *Comparison of marks*

17. The subject mark consists of the device , and Chinese characters “盛富麗” placed underneath the device. The device is eye catching and is distinctive in respect of the subject goods. The combination of the Chinese characters “盛富麗” has no meaning in relation to the subject goods and is distinctive in respect thereof.

18. The Applicant's Mark consists of the same device "", the words "YVES FOUL' EE" and the Chinese characters "盛富麗". The words "YVES FOUL' EE" would likely be taken as a transliteration of the Chinese characters "盛富麗".
19. Visually, the subject mark and the Applicant's Mark have in common the distinctive device "", and the distinctive combination of Chinese characters "盛富麗". As the words "YVES FOUL' EE" would likely be taken as a transliteration of the Chinese characters "盛富麗", the Applicant's Mark would likely be remembered by those Chinese characters and the distinctive device "". Although the subject mark does not contain the words "YVES FOUL' EE", it has incorporated both the distinctive device "" and the distinctive combination of Chinese characters "盛富麗". I find that the overall visual impression created by the subject mark is very similar to that created by the Applicant's Mark.
20. Aurally, the subject mark would be referred to as "盛富麗". For the Applicant's Mark, as the words "YVES FOUL' EE" are not easy to pronounce, the Applicant's Mark would more likely to be pronounced as "盛富麗" than "YVES FOUL' EE" or "YVES FOUL' EE 盛富麗". I find that aurally, the subject mark and the Applicant's Mark are identical or highly similar.
21. Conceptually, the subject mark and the Applicant's Mark have both the distinctive device "" and the Chinese characters "盛富麗" in common. Although the Applicant's Mark also contains the words "YVES FOUL' EE", they merely reinforce the meaning of the Chinese characters "盛富麗". I find that the subject mark and the Applicant's Mark are conceptually highly similar.
22. Having regard to the degree of visual, aural and conceptual similarities and differences between the subject mark and the Applicant's Mark, I find that the overall impression created by the subject mark is very similar to that created by the Applicant's Mark. I find that the two marks are highly similar.

*Comparison of goods*

23. The subject goods and the Applicant's Goods are respectively set out in paragraphs 2 and 8 above. Both the subject goods and the Applicant's Goods cover dietary supplements other than for medical use. They are identical.

*Distinctiveness of the Applicant's Mark*

24. The Applicant's Mark consists of the distinctive device “”, the combination of Chinese characters “盛富麗” which has no meaning in relation to the Applicant's Goods and is distinctive thereof, and the words “YVES FOUL' EE” which would be perceived as a transliteration of the Chinese characters “盛富麗”. Overall, I find that the Applicant's Mark is inherently distinctive of the Applicant's Goods.
25. The Applicant's Declaration does not include any evidence of use of the Applicant's Mark.

*Likelihood of confusion*

26. Applying the global appreciation test and taking into account all relevant factors, I find that the subject mark and the Applicant's Mark are highly similar, the respective goods are identical and the Applicant's Mark is inherently distinctive. When the subject mark is used in relation to the subject goods, the average consumer would be confused into thinking that those goods of the Registered Owner and the Applicant's Goods provided under the Applicant's Mark come from the same undertaking or economically-linked undertakings.
27. I find that the ground under sections 53(5)(a) and 12(3) of Cap. 559 is made out.

## **Conclusion**

28. For the reasons stated above, the registration of the subject mark is declared invalid under sections 53(5)(a) and 12(3) of Cap. 559.
29. As I have found in favour of the Applicant on the ground under sections 53(5)(a) and 12(3) of Cap. 559, it is not necessary for me to consider the other grounds for the Application.

## **Costs**

30. As the Application has succeeded, I award the Applicant costs.
31. Subject to any representations, as to the amount of costs or calling for special treatment, which either party may make within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed.

(Finnie Quek)  
for Registrar of Trade Marks  
28 July 2011