

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

**OPPOSITION TO TRADE MARK APPLICATION NO. 301134882**

**MARK:** **PANDA**

**CLASS:** **43**

**APPLICANT:** **N.V. Sumatra Tobacco Trading Company**

**OPPONENT:** **WWF-World Wide Fund for Nature (formerly World Wildlife Fund)**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 10 June 2008, N.V. Sumatra Tobacco Trading Company (“the Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for registration of the mark below (“the subject application”) -

**PANDA**

(“the suit mark”)

in respect of “Cafes, cafeterias, restaurants, snack bars, bar services” in Class 43 (“the applied for services”).

2. Particulars of the subject application were published on 12 September 2008. On 11 February 2009, WWF-World Wide Fund for Nature (formerly World Wildlife Fund) (“the Opponent”) filed a Notice of Opposition with a Statement of Grounds of Opposition (“the subject proceedings”). On 11 May 2009, the Applicant filed a Counter-statement.

3. The opposition hearing took place before me on 19 March 2015 (“the hearing”). Mr Philips Wong of counsel (“Mr Wong”), instructed by Messrs Eccles & Lee appeared for the Applicant. The Opponent was represented by Mr Lam Chin Ching Gary of counsel (“Mr Lam”) on the instructions of Messrs Mayer Brown JSM.

### **Grounds of opposition**

4. In its Statement of Grounds of Opposition, the Opponent pleaded virtually each and every ground possibly available under sections 11 and 12 of the Ordinance. The Opponent’s skeleton submissions confined them to those under sections 12(2) and 12(3) but with a caveat that the Opponent shall not be taken to have abandoned other grounds in case the matter would have to proceed further.<sup>1</sup> Since the “other grounds” were not canvassed at the hearing at all and I could not identify any evidence relating to them, I would not give them serious consideration. I would deal with the sections 12(2) and 12(3) grounds of opposition first.

### **Counter-statement**

5. In its Counter-statement and skeleton submissions, the Applicant responded to each of the Opponent’s grounds pleaded in the Statement of Grounds of Opposition that such grounds are misconceived and/or not supported by evidence and should therefore be dismissed with costs.

### **Relevant date**

6. The relevant date for considering the opposition is 10 June 2008, the date of the application for registration (“the relevant date”).

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<sup>1</sup> Opponent’s skeleton submissions, §§2-3.

## **Opponent's evidence**

7. The Opponent's evidence comprises a statutory declaration of Michael Rogers ("Mr Rogers"), the Opponent's Legal Advisor, dated 31 May 2010 ("MR's SD") with Exhibits "A" to "P".

8. According to Mr Rogers, the Opponent, established in 1961, is engaged in the services of conservation of natural environment and ecological process worldwide. The Opponent collects, manages and disburses funds for the conservation of nature, promotes awareness of the need for the conservation of nature through various means, finances and conservation activities, projects and researches.

9. The Opponent operates in over 100 countries with more than 5,000 employees worldwide. It also works in partnership with bodies and agencies in fulfilling its objectives. Since 1985, the Opponent has invested over US\$1 billion in more than 12,000 projects, all aimed at improving the quality and harmony of the natural environment and its inhabitants.

10. The Opponent sells online a wide variety of eco-friendly and fair trade products such as books, stationery items, personal care products, pet products, garden and outdoor products, household products, clothing, toys, gift items and organic food etc. Some of these products are of the Opponent's own brand.

11. Mr Rogers said the Opponent's activities have been carried out under its trade marks including "PANDA", "PANDA SHOP", "WWF" with PANDA LOGO, PANDA LOGO, "WWF" and "PANDA CLUB POST" etc (collectively "the PANDA marks"). The PANDA marks appear on the Opponent's goods, product labels, containers, carrying bags, packaging materials, signage, brochures and product literature, company stationery, giveaway items and the Opponent's website.

12. The Opponent claims to have spent considerably over the years on the

promotion, registration and enforcement of rights worldwide in respect of the PANDA marks. It has also received extensive donated advertising.

13. Paragraph 9 of MR's SD set out the Opponent's promotion expenditure in Hong Kong for the six years between 2003 and 2008. Such expenditure was at its lowest in 2004 at HK\$225,503 and peaked in 2008 at HK\$667,694. As shown in Exhibit "E" to MR's SD, news and promotion about the Opponent and its activities in Hong Kong have appeared on newspapers, magazines and the Internet. Since 1985 the Opponent has published a quarterly junior bilingual magazine "PANDA CLUB POST" to which around 8,500 people on average per annum have subscribed.

14. In Hong Kong the Opponent operates a "Panda Shop" on its website [www.wwf.org.hk](http://www.wwf.org.hk) selling, inter alia, goods bearing the PANDA marks. As examples of the goods sold, Exhibit "J" to MR's SD shows a copy photograph of a "WWF Panda 3D Puzzle" and a "WWF Polar Bear Labyrinth", both bearing the



Opponent's "WWF" mark. In paragraph 13 of MR's SD, Mr Rogers gave figures on the Opponent's sales of goods bearing the PANDA marks for the five years between 2005 and 2009. The figures grew steadily from about HK\$279,000 in 2003 to just over HK\$1 million in 2009.

15. Since February 1990 the Opponent also operates "The Panda Shop" through its licensee in Hong Kong in the Mai Po Nature Reserve selling souvenirs, small gift items, food and beverages (by vending machines). Contained in Exhibit "K" to MR's SD are copy photographs of The Panda Shop



where the "WWF" mark and vending machines selling beverages can be seen at the shop front.

16. Mr Rogers has also given figures on the Opponent's global annual income for the six years from 2003 to 2008, varying between CHF104,873,000



and CHF174,542,000. The Opponent's " **WWF** " mark and/or "FOR A LIVING PLANET" mark can be seen in the Opponent's Annual Reviews for the said years and on a handful of copy sample Hong Kong sales invoices adduced in Exhibit "M" to MR's SD.

17. Mr Rogers said the Opponent has about 780 applications and registrations worldwide in respect of the PANDA marks. Listed in paragraph 19 of MR's SD and shown in Exhibit "P" thereto are respectively the Opponent's 35 trade mark applications and registrations in Hong Kong and the copy corresponding downloaded trade mark records. These trade mark applications and registrations are noted to cover goods and services of great diversity.

18. It was Mr Rogers' contention that the suit mark "**PANDA**" is identical to the Opponent's trade mark "PANDA" and resembles its PANDA LOGO etc and that even if the applied for services are dissimilar to the Opponent's goods and services (not admitted by the Opponent), there would still be a likelihood of confusion as to the origin of the applied for services. Mr Rogers did not, however, specify the trade mark registration(s) and/or application(s) of the Opponent upon which such a contention was relied.

### **Applicant's evidence**

19. The Applicant responded to MR's SD by way of a statutory declaration of Lewis Lionel Chanderson ("Mr Chanderson"), the Applicant's International Marketing Manager, dated 1 August 2013 ("LLC's SD") with Exhibits "LLC-1" to "LLC-4".

20. According to Mr Chanderson the Applicant was incorporated in Indonesia in 1952, majoring in the manufacturing, marketing and sale of cigarettes and tobacco related products. The Applicant is said to be currently

one of the largest tobacco manufacturers and traders in Indonesia.

21. The Applicant's tobacco products are manufactured under various trade marks including "JET", "HERO", "UNITED" and "PANDA" etc. Exhibit "LCC-1" to LLC's SD contains copy downloaded trade mark records of 15 such trade marks registered in Hong Kong under the Applicant's name in respect of Class 34 goods.

22. The subject application is said to have been triggered by the Applicant's international business expansion into Hong Kong. The Applicant's expansion and diversification strategy into other areas and products besides Class 34 has likewise been carried out under the Applicant's "JET", "HERO" and "UNITED" trade marks (Exhibit "LCC-2" to LLC's SD). The Applicant also expanded its business in Macau resulting in the application and registration of the suit mark there for goods and/or services under Classes 30, 32 and 43 respectively (Exhibit "LCC-3" to LLC's SD).

23. The remainder of LLC's SD categorically denied the Opponent's grounds of opposition, in particular, on the basis that the Opponent's evidence was largely confined to showing the use of the "WWF" mark and/or the PANDA logo mark only. Moreover the "PANDA" word mark was not shown to have been used on any of the Opponent's goods and/or services in class(es) relevant to the subject proceedings.

### **Oppositions under sections 12(2) and 12(3) of the Ordinance**

24. Section 12(2) of the Ordinance provides that –

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

*(a) the trade mark is identical to an earlier trade mark;*

*(b) the goods or services for which the application for registration is made are 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.”*

25. Section 12(3) of the Ordinance provides that –

*“(3) 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.”*

26. Sections 12(2) and 12(3) essentially prohibit the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of it being identical or 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 of the earlier trade mark.

27. The two grounds of opposition are premised on the existence of an “earlier trade mark”, a term defined in section 5 of the Ordinance as follows –

*“(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; or*  
*...”*

28. According to section 7(1) of the Ordinance, 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.

29. The basic principles regarding the assessment of similarity between signs and the likelihood of confusion between them are set out in the cases of *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 *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.R.S. 19. Such principles have been adopted in Hong Kong and recently by the Court of Appeal in *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd* [2014] HKEC 2004. They require a consideration of whether there is identity or similarity in marks, and in goods and/or services, which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally taking into account the degree of visual, aural and conceptual similarity between the marks, the importance to be attached to differing elements, the degree of similarity in the goods and services and how they are marketed. 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 marks in question must be compared having regard to the distinctive character of each one and assuming normal and fair use of the marks across the full range of the goods and services within their respective specifications. Moreover all of the above must be considered from the standpoint of the average consumer of the goods and services in question.

### **Opponent's registered trade marks**

30. In paragraph 5 of the Opponent's skeleton submissions, Mr Lam for the Opponent highlighted the legal principle in assessing the distinctive and dominant components in a *composite* mark that generally speaking words "spoke louder" than devices. If the device in a composite mark was too simple to evoke any particular concept for the average consumer, it could not be regarded as the dominant element in the composite mark.

31. At the hearing I sought Mr Lam’s clarification as to which of the PANDA mark(s) he had in mind when making the above proposition. Mr Lam pinpointed the five PANDA marks listed in paragraph 16 of the Opponent’s skeleton submissions (“the five PANDA marks”, particulars see paragraph 52 below). He also emphasised that the cited legal principle should be read together with a particular guideline in assessing the likelihood of confusion as elaborated in *Tsit Wing* (supra) that the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by them bearing in mind their distinctive and dominant components, but it was only when all other components of a complex mark were negligible that it was permissible to make the comparison solely on the basis of the dominant elements.<sup>2</sup> Mr Lam then suggested that given that legal principle, the average consumer would, in his view, refer to the five PANDA marks by the word “panda”.

32. While recognising the said legal principle as trite law, Mr Wong for the Applicant contended that it would in fact work against the Opponent unless the five PANDA marks actually contained the word element “PANDA” as well as a panda device. This point would be further discussed at the appropriate juncture.

### **Section 12(2) ground of opposition**

33. In advancing the section 12(2) ground of opposition, Mr Lam relied on the following three PANDA marks (“the three PANDA marks”) – <sup>3</sup>

Trade mark	Date registered	Specification
19831158 <b>PANDA</b>	22.5.1981	<u>Class 8</u> Hand tools and instruments; cutlery; forks and spoons.
19831159 <b>PANDA</b>	22.5.1981	<u>Class 31</u> Agricultural, horticultural and forestry products and grains not included in other

<sup>2</sup> Opponent’s skeleton submissions, §6(d).

<sup>3</sup> Opponent’s skeleton submissions, §§9-12.

		classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; food-stuffs for animals, malt.
19831160 <b>PANDA</b>	22.5.1981	<u>Class 32</u> Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.

34. Each of the three PANDA marks has a date of application for registration earlier than that of the suit mark and hence meets the criteria of an “earlier trade mark” as defined under section 5(1)(a) of the Ordinance.

***Comparison of suit mark and three PANDA marks***

35. In comparing the suit mark and the three PANDA marks, I have to consider the perception of the marks in the mind of the average consumer of the goods/services in question. The average consumer of the categories of goods/services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. His/her level of attention is likely to vary according to the category of goods in question.

36. 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 particularly their distinctive and dominant components. I must consider whether there are similarities between the suit mark and the three PANDA marks and the respective goods and services covered, and whether they would combine to create a likelihood of confusion.

37. The applied for services and the Opponent’s goods, insofar as the three PANDA marks are concerned, include cafe and restaurant services, hand tools, cutlery, foodstuffs and beverages of various types. They are daily consumption goods and services directed at members of the general public. The average consumer is therefore any member of the public. Since the goods or services in

question are not specialized or particularly expensive, the level of attention of the average consumer paid at the point of purchase/patronising or selection of them is average.

38. The suit mark and each of the three PANDA marks are pure word marks expressed in the uppercase and contain exclusively the word “PANDA” without any stylization. From the perspective of the average consumer, the suit mark and the three PANDA marks are *identical*.

### *Comparison of goods and services*

39. The well-known tests for assessing similarity in goods and services are found in *British Sugar v Robertson and Sons Ltd* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (supra). The court considered that all relevant factors relating to the goods in question should be taken in account. They include, *inter alia*, their nature, intended purpose, method of use, whether the goods/services are in competition with each other or are complementary, as well as their users and the channels through which they reach the market.

40. Goods and services are considered identical if they fall within the ambit of the terms within the competing specification.<sup>4</sup> Goods and services are considered complementary if there is a close connection between them, 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 those goods and services lies with the same undertaking.<sup>5</sup>

41. Based on these legal principles, I now compare the applied for services and the goods covered by the registration of the three PANDA marks –

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<sup>4</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05.

<sup>5</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-325/06.

Suit mark	Three PANDA marks	
<u>Class 43</u> Cafes, cafeterias, restaurants, snack bars, bar services	19831158	<u>Class 8</u> Hand tools and instruments; cutlery; forks and spoons.
	19831159	<u>Class 31</u> Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; food-stuffs for animals, malt.
	19831160	<u>Class 32</u> Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.

42. I note first of all that none of the registration of the three PANDA marks covers Class 43 services.

43. Mr Lam's arguments on similarity between the Opponent's goods and the applied for services are set out in paragraphs 10 to 12 of the Opponent's skeleton submissions. He argued that the applied for services were related to food and drinks and so were the Opponent's goods (including cutlery, forks and spoons) covered by the three PANDA marks. Furthermore, trading foods and beverages may well *naturally* expand into café and restaurant business and the like. Mr Lam opined that it is likely in the circumstances that the average consumer would be misled into thinking that the Applicant was or was associated with the Respondent.

44. At the hearing, Mr Lam did not substantiate the above arguments by reference to any part of the Opponent's voluminous evidence nor any case authorities. He simply cited the examples of one or two local sizable and well-known supermarket chains which allegedly produce and market from time to time their own line of products and/or venture into café and/or restaurant business under their own brand names.

45. Relying on the following decisions of the Opposition Division or Boards of Appeal, as the case may be, of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”), Mr Wong for the Applicant vehemently refuted Mr Lam’s contention that there exists similarity between the applied for services and the goods covered by the registration of the three PANDA marks –

- (a) “AERONAUTICA” trade mark – opposing goods in **Class 8** “*hand tools and implements (hand-operated); cutlery; side arms; razors; tableware, namely forks, knives and spoons*” were found to be *dissimilar* to contested services in Class 43 “*providing of food and drink; temporary accommodation*”. The Opposition Division took the view that by nature goods were generally dissimilar to services. The Class 8 goods concerned were regarded as articles of trade, wares, merchandise or real estate the sale of which usually entailed the transfer of title in something physical whereas the contested services consisted of the provision of intangible activities. Fundamentally the applicant’s services had a different purpose from that of the opponent’s goods. There existed no complementarity nor competition between them either that would render them similar.<sup>6</sup>
  
- (b) “Fany” trade mark – when comparing opposing goods in **Class 31** under an exact same specification as that of the PANDA mark under registration **No. 19831159** to contested services in Class 43 “*providing food, drink and accommodation*”, the Opposition Division considered that the only possible link was that some of the opposing goods were foodstuff. Those goods (e.g. fruits and vegetables) were, however, not similar to restaurant services. They were basic or unprocessed kinds of food. They were not similar to restaurant or accommodation services because the consumers concerned would not believe that restaurants or

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<sup>6</sup> *Nautica Apparel v Cristiano Di Thiene S.p.A*, OHIM, Opposition No. B 1 767 881, Opposition Division, 28 November 2012.

providers of accommodation were in control of their manufacturing. The opposing Class 31 goods and the contested Class 43 services were held to be *dissimilar*.<sup>7</sup>

- (c) “THAI SPA” trade mark – opposing goods in **Class 32** “*mineral water and aerated waters and other non-alcoholic beverages, syrups and other preparations for making beverages*” and contested services in Class 43 “*restaurant services (food)*” were held to be *dissimilar*. The Fourth Board of Appeal found that the contested services obviously differed in nature from the opposing goods and did not share the same purpose and method of use. Those goods and services were provided by different undertakings and were not in competition with each other. They were not complementary either as complementarity required a close connection between two goods/services, in the sense that one was indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lied with the same undertaking. Such close connection did not exist between mineral water and non-alcoholic beverages on one hand and food restaurant services on the other. The mineral water or soft drink a consumer may order while having a meal at a restaurant could not be regarded as indispensable to a successful dining experience in such a way that the customer may think the responsibility for the production of the drinks and the provision of the food restaurant services lied with the same undertaking.<sup>8</sup>

46. In reply, Mr Lam urged me to give little weight to the above OHIM’s decisions for the reason that they were decided in the European context where

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<sup>7</sup> *Jose Zapata y Compañía, S.L. v Fany Gastoservis s.r.o.*, OHIM, Opposition No. B 1 432 352, Opposition Division, 22 March 2010.

<sup>8</sup> *S.A. Spa Monopole, Compagnie fermière de Spa, en abrégé S.A. Spa Monopole N.V. v Royal Méditerranée, S.A.*, OHIM, Case R 1976/2010-4, Fourth Board of Appeal, 20 October 2011.

business environment and practices in the food and restaurant industries were allegedly vastly different from those locally. Mr Lam repeated his “natural expansion” point discussed in paragraph 43 above.

47. While I accept that the business environment and practices in the local food manufacturing and restaurant industries may well be different, the OHIM’s decisions Mr Wong cited are nonetheless not particularly fact sensitive but are generally applicable given the nature and purposes of the Classes 8, 31 and 32 goods and Class 43 services concerned, which to a large extent are respectively analogous to those in suit in the subject proceedings. Furthermore, there is no evidence before me to demonstrate the Opponent’s intention or its efforts made in producing and marketing its own line of products and/or venturing into café and/or restaurant business under any of the three PANDA marks as at the relevant date, assuming such business activities are within the scope of the registration of the three PANDA marks. Mr Lam did not bring to my attention either any case authorities of any jurisdiction which may support the alleged similarity between the Opponent’s goods in question and the applied for services.

48. To make good a section 12 ground of opposition, the requirements that marks are identical or similar on one hand and the goods and/or services are similar or identical on the other are cumulative. If the contested goods or services are dissimilar, an opposition would remain unsuccessful despite similarity or even identity of the conflicting marks. On this point Mr Wong referred me to a passage in paragraph 9-071 of *Kerly’s Law of Trade Marks and Trade Names* (15th Edn.) that the prohibition against registration of a mark invoked under section 5(2) of the UK Trade Marks Act 1994<sup>9</sup> requires there to be at least some similarity between the goods or services the subject of the earlier mark and those the subject of the application in question. In the round I am persuaded by Mr Wong in finding that alleged similarity is indeed lacking between the goods covered by the registration of the three PANDA marks and the applied for services.

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<sup>9</sup> Section 5 of the UK Trade Marks Act 1994 is similar to section 12 of the Ordinance.

49. Incidentally while the distinctiveness of an earlier mark is one factor to be taken into account in the global assessment of likelihood of confusion, the Opponent did not adduce any evidence nor did Mr Lam make any submissions to suggest enhanced distinctiveness of the three PANDA marks, either by virtue of intensive use or reputation having been built as at the relevant date, that may significantly increase the likelihood of confusion in the dissimilar goods/services situation found.

***Likelihood of confusion***

50. Although the suit mark is identical to the three PANDA marks, I have found no similarity between the applied for services and the goods covered by the registration of the three PANDA marks nor any reputation or goodwill built upon them at the relevant date which may otherwise lead to a likelihood of confusion. Given such findings, I come to the view that when the suit mark is used in relation to the applied for services, it would not give rise to a risk that the public might believe that the services so rendered and the goods provided under the three PANDA marks come from the same or economically-linked undertakings.

51. In the premises, the ground of opposition under section 12(2) of the Ordinance is not established.

**Section 12(3) ground of opposition**

52. As for the section 12(3) ground of opposition, Mr Lam sought to invoke it based on alleged similarity between the suit mark and the five PANDA marks below – <sup>10</sup>

Trade mark	Date registered	Specification
19840277	22.5.1981	<u>Class 29</u> Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables;

<sup>10</sup> Opponent’s skeleton submissions, §§13-17.

		jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.
19831154 	22.5.1981	<u>Class 30</u> Coffee, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; ice.
19831156 	22.5.1981	<u>Class 32</u> Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.
199704966 	5.5.1992	<u>Class 30</u> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread and bakery products.
300606618 	24.3.2006	<u>Class 35</u> ...sale of...meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, agricultural, horticultural and forestry products and grains, live animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; online sales of goods.

53. In paragraph 14 of the Opponent’s skeleton submissions, Mr Lam argued that when seeing the panda device (allegedly the most conspicuous part) plus a word element “panda” or “WWF” (considered a relatively small part), the average consumer would focus on the panda device and have the concept “panda” and refer to the mark by that word. At the hearing Mr Lam reinforced his

argument that the *panda device* in trade mark registration Nos. 199704966 and 300606618 was dominant enough to make the average consumer focus on it and refer to the two marks by the word “panda”. The suit mark and the five PANDA marks are thus said to be similar.

54. I note from the outset that three of the five PANDA marks, namely under registration Nos. 19840277, 19831154 and 19831156 are an identical *pure device* mark. The remaining two marks respectively under registration Nos. 199704966 and 300606618 are an identical *composite* mark containing a panda device and a word element “WWF”. As such I do not quite follow Mr Lam’s said proposition that any of the five PANDA marks contains a word element “panda”. Furthermore, I am unable to reconcile this argument of Mr Lam with the trite law he cited in paragraph 10 of the Opponent’s skeleton submissions that words in a composite mark generally speak louder than devices (paragraph 30 above).

55. In order to further consider the Opponent’s section 12(3) ground of opposition, it would be necessary for me to compare the suit mark and the five PANDA marks.

### ***Comparison of suit mark and five PANDA marks***

56. Each of the five PANDA marks has a date of application for registration earlier than that of the suit mark, they are therefore “earlier trade marks” as compared to the suit mark.

57. In comparing the suit mark and the five PANDA marks, I make reference to the legal principles mentioned in paragraphs 35 and 36 above in a like manner as I compared the suit mark and the three PANDA marks.

58. The registration of the five PANDA marks cover meat, fish, poultry, dried and cooked fruits and vegetables, dairy products, coffee, rice, flour, baking products, beer, mineral and aerated waters, and the sale of the said goods and

products etc. These are daily consumption goods and services directed at members of the general public. The average consumer is again any member of the public. The level of attention of the average consumer paid at the point of purchase/patronising or selection of them is likewise average.

59. Comparing first the suit mark “**PANDA**” (a pure word mark) and the



Opponent's mark “” (a pure device mark), although both marks may bring to mind the animal panda and the latter may be described as “the panda mark”, absent any common element, be it word or device, in the actual representations of the two marks, taking the two marks as wholes, I find a low degree of similarity in them from a visual, aural or conceptual point of view.

60. Comparing next the suit mark “**PANDA**” and the Opponent's mark



“ **WWF** ” (a composite mark), I note Mr Lam's submission that the average consumer may focus on the panda device (allegedly the dominant element) in the latter and have the concept “panda” and refer to the mark by that word (paragraph 53 above). Be that as it may, the panda device does not feature in the suit mark.



Furthermore, the mark “ **WWF** ” also contains a word element “**WWF**” which I consider to be at least equally dominant as the panda device even though the general principle that words in composite marks usually speak louder than devices (main thrust of Mr Lam's submissions, paragraph 30 above) does not apply here with full vigour due to the relative size and position of the two elements. Contrary to Mr



Lam's proposition, aurally the mark “ **WWF** ” could be pronounced “WWF” rather

than “panda”. Taking these two marks as wholes, I find that they share a low degree of similarity visually, aurally and conceptually.

61. Given the above, I conclude that the suit mark and the five PANDA marks are similar only to a low degree. With this in mind, I would next compare the applied for services and the goods/services covered by the registration of the five PANDA marks.

***Comparison of goods and services***

62. In carrying out the comparison, I also take heed of the legal principles discussed in paragraphs 39 and 40 above as I did when comparing the applied for services and the goods/services covered by the three PANDA marks. The relevant goods and services are as follows -

Suit mark	Five PANDA marks	
<u>Class 43</u> Cafes, cafeterias, restaurants, snack bars, bar services	19840277	<u>Class 29</u> Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.
	19831154	<u>Class 30</u> Coffee, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; ice.
	19831156	<u>Class 32</u> Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.
	199704966	<u>Class 30</u> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made

		from cereals, bread and bakery products.
	300606618	<u>Class 35</u> ...sale of...meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, agricultural, horticultural and forestry products and grains, live animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; online sales of goods.

63. I note, as in the case of the three PANDA marks, none of the registration of the five PANDA marks concerns Class 43 services.

64. In paragraphs 16 and 17 of the Opponent’s skeleton submissions, Mr Lam submitted that the applied for services were related to food and it was likely in the circumstances that an average consumer would be misled into thinking that the Applicant who supply them was or was associated with the Opponent.

65. Again by citing a number of the OHIM’s decisions, Mr Wong strongly refuted the alleged linkage between the applied for services and the Opponent’s goods and services covered by the five PANDA marks.

66. One of the cited cases touches on three classes of goods/services in question. In “JENSON’S FOODS” trade mark, by applying “THAI SPA” trade mark (supra), the Opposition Division of the OHIM carried out a detailed comparison between Class 43 services (“*providing food and drink, restaurants, ... cafes and bars...*”) and the goods/services in **Class 29** (“*...vegetables, meat,*

*poultry and game, ...meat extracts*”), **Class 30** (“*pastry and confectionery*”) and **Class 35** (“*retail services in relation to foodstuffs*”). It was held that the mere fact that foods and drinks were consumed in a restaurant was not enough reason to find similarity between them. The opposing goods/services in the said three classes were categorically found to be **dissimilar** to contested services in Class 43. While recognising that some foodstuff producers did provide restaurant services under their brands (e.g. coffee and coffee shops, ice cream and ice cream parlours, beer and pubs), the Opposition Division was of the view that such was *not* an established custom in the trade but rather applied only to *economically successful undertakings*.<sup>11</sup> This seems to echo the examples cited by Mr Lam that one or two local *sizable and well-known* supermarket chains allegedly produce and market from time to time their own line of products and/or venture into café and/or restaurant business under their own brand names (paragraph 44 above), but as an exception rather than a norm. Such exception, however, does not give rise to similarity between the Class 43 applied for services and the Opponent’s goods/services in the said three classes.

67. Class 30 goods “*coffee, tea, cocoa and artificial coffee...*” were also held to be **dissimilar** to Class 43 services in “*caffè kenon*” trade mark. The Opposition Division expressed the same view on the provision of restaurant and bar services by some foodstuff producers not being an established trade custom and that the mere fact that foods and drinks were consumed in a restaurant was not enough reason to find similarity between them.<sup>12</sup>

68. This disposes of the Opponent’s goods and services forming the subject matter of trade mark registration Nos. 19840277, 19831154, 199704966 and 300606618.

69. As for the alleged similarity between the applied for services and the Opponent’s goods in the remaining Class 32 (i.e. trade mark registration no.

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<sup>11</sup> *H. Redlefsen GmbH & Co. KG v Danske Familierestauranter A/S*, OHIM, Opposition No. B 2 087 412, Opposition Division, 21 May 2014.

<sup>12</sup> *Aldi Einkauf GmbH & Co. oHG v Café Centro Brasil Vittorio Wurzbürger S.A.S. Di Taurisano Antonietta & C.*, OHIM, Opposition No. B 2 235 011, Opposition Division, 26 November 2014.

19831156), the discussion of the “THAI SPA” trade mark in paragraph 45(c) above is considered relevant and sufficient in showing that such allegation is misconceived.

70. Having compared the applied for services and the goods/services covered by the registration of the five PANDA marks, I do not find any similarity between them as alleged by the Opponent.

71. Based on my finding of a low degree of similarity between the suit mark and the five PANDA marks and the absence of evidence to suggest enhanced distinctiveness of the five PANDA marks as at the relevant date which may otherwise lead to a likelihood of confusion, I conclude that when the suit mark is used in relation to the applied for services, it would not give rise to a risk that the public might believe that the services so rendered and the goods/services provided under the five PANDA marks come from the same or economically-linked undertakings.

72. The ground of opposition under section 12(3) of the Ordinance is therefore not made out.

### **Opponent’s other grounds**

73. As mentioned in paragraph 4 hereof, on pleadings the Opponents also alleged a number of other grounds under sections 11 and 12 of the Ordinance which, the Opponent said, should not be taken as abandoned. Given the Opponent’s failure with its sections 12(2) and 12(3) grounds, presumably its “best” grounds, and the fact that no evidence whatsoever has been identified in support of any other grounds, I am not offered a chance to consider them in any depth. The only logical conclusion to be reached is that these other grounds also fail.

## **Conclusion and costs**

74. I have considered the grounds of opposition advanced by the Opponent and found that none of them has been made out. The opposition therefore fails.

75. As the opposition is unsuccessful, I award the Applicant costs. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes 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 between the parties.

( Elsie Tse )  
*for* Registrar of Trade Marks  
9 July 2015