

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 301657459AB

MARK : Cambridge

APPLICANT : Cambridge Nutritional Foods Limited

CLASS : 9

STATEMENT OF REASONS FOR DECISION

Background

1. On 7 July 2010, Cambridge Nutritional Foods Limited (“the applicant”) filed an application for registration (“the subject application”) of the mark shown below (“the Subject Mark”) under the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

Cambridge

2. Registration of the Subject Mark was originally sought in respect of a broad range of goods and services in Classes 5, 9, 16, 29, 30, 32, 41 and 44 (“the original application”). During the examination stage, the original application was divided into four applications, one application, being the subject application, is in respect of the following goods (“the applied-for goods”) in Class 9:

Electronic publications; newsletters, magazines, pamphlets and booklets available in electronic form and for downloading from a database or from the Internet; all of the aforesaid relating to health, exercise, diet, weight-loss or nutrition.

and the other two applications, namely application nos. 301657459AC and 301657459AD, are in respect of Classes 16 and 44 respectively. The remaining application, i.e. application no. 301657459AA (Classes 5, 29, 30, 32 and 41),

proceeded to registration.

3. At the examination stage, an objection was raised against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade marks:

Trade Mark Registration No.300439164 (Cited Mark 1)



Trade Mark Registration No.301370835 (Cited Mark 2)

Cambridge Young Learners English

Trade Mark Registration No.301457901 (Cited Mark 3)

CAMBRIDGE UNIVERSITY PRESS

Details of the above cited marks are provided at the **Annex** of this statement of reasons for decision. All the cited marks are owned by The Chancellor, Masters & Scholars of the University of Cambridge.

4. Despite submissions made on behalf of the applicant by its agent, namely Messrs. Robin Bridge & John Liu (“the agent”), the objection was maintained by the Registrar.
5. By a letter dated 19 August 2011, the agent requested a hearing on the registrability of the Subject Mark. The status of the subject application had once been inadvertently stated to have been “refused” by the Trade Marks Registry but that was subsequently corrected on 4 September 2014. A hearing was scheduled to be held on 19 November 2014; the agent filed a notice of attendance at hearing (Form T12) on 13 October 2014 but it did not show up on the day of hearing. No evidence of honest concurrent use of the Subject Mark and the cited marks under section 13 of the Ordinance was filed.
6. Pursuant to Rule 75(b) of the Trade Marks Rules (Cap. 559 sub. leg. A) (the

“Rules”), I now proceed to decide the matter without a hearing.

Decision

7. Upon careful review of all the submissions made by the agent and the relevant circumstances of the subject application, I am prepared to waive the objection raised under section 12(3) of the Ordinance on the basis of Cited Mark 3. However, the objection under section 12(3) of the Ordinance based on Cited Marks 1 and 2 (collectively, the “Cited Marks”) is maintained. The reasons for refusing registration of the Subject Mark are set out below.

The Ordinance

8. The relative grounds for refusal of an application for registration are contained in section 12 of the Ordinance. Section 12(3) 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.”*

9. An “earlier trade mark”, as referred to in section 12(3), is defined in section 5 of the Ordinance, and the relevant part of the section reads 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 the 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...”*

10. As the Cited Marks have a date of application for registration earlier than that of the Subject Mark, they are “earlier trade marks” in relation to the Subject Mark for the purpose of section 5 of the Ordinance.

11. Moreover, section 7(1) of the Ordinance throws light on how sub-section (c) of section 12(3) is to be interpreted. Section 7(1) 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.”

12. 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] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (the “Canon” case) [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] F.S.R. 77, *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 19 and adopted by the Court of Appeal in *Tsit Wing (Hong Kong) Company Limited and Others v TWG Tea Company Pte Ltd* (CACV 191/2013) at paragraph 35. These principles are:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors.
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably observant and circumspect, but who 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, and whose attention varies according to the category of goods or services in question.
- (c) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
- (d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements.

- (e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.
- (f) And beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark.
- (g) A lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.
- (h) There is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it.
- (i) Mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient.
- (j) The reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense.
- (k) If the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

13. In accordance with the above principles, I need to examine whether there are similarities between firstly, the Subject Mark and the Cited Marks and secondly, the goods and services covered by the marks and then consider whether such similarities (if any) would be likely to lead to confusion by the public.

Comparison of marks

14. A comparison of the marks has to be based on an overall appreciation of the visual, aural and conceptual similarities of them, taking into account the overall impressions given by them, and bearing in mind, in particular, their distinctive and dominant components.
15. In comparing the marks, I shall consider the perception of the marks in the mind of the average consumer of the applied-for goods. The applied-for goods cover various electronic publications relating to health, exercise, diet, weight-loss or nutrition in Class 9. They are publications covering a wide range of subjects in health and well-being which can be downloaded from a database or from the Internet. Given people nowadays are increasingly more health conscious and would look for ways to improve or maintain their well-being, and given the Internet is widely and easily accessible, the average consumer of the applied-for goods therefore consists of members of the general public in Hong Kong. Whilst members of the general public are deemed to be reasonably well-informed, reasonably circumspect and observant, the level of care and attention that can be expected by them on such goods is only average.
16. The Subject Mark consists of the English word “Cambridge” with the letter “C” in uppercase and a device above the letter “e”. The word “Cambridge” is in pure plain font.
17. At the examination stage, the agent submitted that the word “Cambridge” was presented in a unique and stylised font-type that looked like a handwritten script because of the uneven ends of the strokes in the writing. Besides, it was the agent’s submission that the device of a mortar board on top of the letter “e” gave the idea of a head being placed under the mortar board; the overall visual impression as presented by the Subject Mark was therefore unique and less formal.
18. I do not agree. First, I cannot discern from the word “Cambridge” any uneven ends of the strokes; rather, the word “Cambridge” is in plain font. Second, I note that the size of the device in the Subject Mark is noticeably smaller when compared to the word element. Even if the device may resemble that of a

mortar board, I do not reckon that a mortar board device being placed on top of the letter “e” would give the average consumer the impression that a head was placed under the mortar board. At its best, the mortar board device could only be treated as a decoration to the word “Cambridge”. Moreover, as words speak louder than devices in a composite mark (*Oasis Stores Ltd’s Trade Mark Application* [1998] RPC 631 at 644), the average consumer’s attention will be drawn to the word element “Cambridge” and not the device. In other words, the device would not bestow any distinctive character upon the Subject Mark, and the word element stands out to be the dominant and distinctive element in the Subject Mark. The average consumer will focus on the word “Cambridge” and the overall impression given by the Subject Mark as a whole is the word “Cambridge”. This is also how the Subject Mark is referred to and remembered by the average consumer.

19. Regarding Cited Mark 1, it consists of the words “CAMBRIDGE” and “Learning” in plain font and presented against a rectangular device, with the left half of the device presented in black and the right half in white. Again, I consider that the word element “CAMBRIDGE” and “Learning” speaks louder than the rectangular device and the black/ white background. The device and the black/white background are merely decorative and do not bestow distinctive character on the mark. Given the cited goods include, inter alia, instructional and educational apparatus and instruments, printed matters and electronic publications, and that the services in provision are, inter alia, education oriented, the word “Learning” is descriptive of such goods and services; the word “Cambridge” therefore stands out to be the dominant and distinctive element of the mark.

20. As regards Cited Mark 2, it comprises the words “Cambridge Young Learners English” in plain font. Similar to Cited Mark 1, given the cited goods include, inter alia, teaching materials, educational textbooks, and publications in electronic form, and that the services in provision are, inter alia, education-oriented, the words “Young Learners English” are descriptive as they only mean the materials and the services are targeting young learners of the English Language. As such, the word “Cambridge” constitutes the dominant and distinctive element of the mark.

21. At the examination stage, the agent contended that the overall visual impression given by the Subject Mark was unique and less formal, and in light of the adoption of different devices and longer phrases for the Cited Marks, their visual outlooks were readily distinguishable from the Subject Mark. In its view, this is particularly so when “Cambridge” is famous as a university town in England and that any slight variation in the marks comprising the word “Cambridge” should be sufficient to distinguish them. Besides, due to the additional words contained in the Cited Marks, the agent also submitted that the Cited Marks and the Subject Mark were pronounced differently. Conceptually, the agent was of the view that with the stylisation of the word “Cambridge” and the mortar board above the letter “e” in the Subject Mark which conveys the idea of a head, the conceptual impression given by the Subject Mark was an abstract one. It is to be contrasted from the Cited Marks which gave the average consumer the conceptual impression of an educational institute (Cited Mark 1) or the learning of English language for young people (Cited Mark 2).
22. I am not convinced by such propositions. Visually, the overlap in the dominant and distinctive word element “Cambridge” has a significant impact on the visual perception of the marks. The device resembling the mortar board in the Subject Mark, and the additional words in the Cited Marks (i.e. “Learning” in Cited Mark 1 and “Young Learners English” in Cited Mark 2), while not being totally disregarded, cannot counteract the overall visual similarity resulting from the overlap in the word “Cambridge”. As such, all the marks coincide with regard to the common word element “Cambridge” and are visually similar.
23. Phonetically, as the Subject Mark and the Cited Marks share the same word “Cambridge”, and to that extent, the marks are aurally identical. Besides, it should be noted that the devices in the subject mark and Cited Mark 1 could not be pronounced as a word. Although there are also the words “Learning” and “Young Learners English” in Cited Mark 1 and Cited Mark 2 respectively, in view of its descriptive nature and applying the principles as discussed, aurally the public would likely refer to each of the marks conveniently as the “Cambridge” mark. The Subject Mark is therefore considered to be aurally identical to the Cited Marks. Even if some people would call the Cited Marks in their full literal contents, given the descriptive nature of the words “Learning” and “Young Learners English”, the listeners would pay attention mainly to the

word “Cambridge” and in this regard the marks are still aurally very similar.

24. Conceptually, I am not convinced that the Subject Mark with the word “Cambridge” in plain font and a tiny device on top of the letter “e” would give the average consumer an abstract conceptual impression. Sharing the same dominant element (“Cambridge”) for the Subject Mark and the Cited Marks, and applying the principles as discussed, the overall impressions of the Subject Mark and the Cited Marks in the mind of the average consumer will be dominated by the word “Cambridge”, which without doubt is a well-known university town in England. The Subject Mark and the Cited Marks therefore are conceptually similar.
25. I have compared the Subject Mark and the Cited Marks visually, aurally and conceptually. Taking into account the overall impressions created by the Subject Mark and the Cited Marks and bearing in mind the perception of the average consumer and the imperfect recollection he/ she has of the marks, I consider the similarities outweigh the dissimilarities. I therefore find the Subject Mark and the Cited Marks to be similar.

Comparison of goods and services

26. In *British Sugar v James Robertson and Sons Ltd* [1996] RPC 281 (at pages 296-7), Mr. Justice Jacob (as he then was) found that the following factors were relevant in considering whether or not there is similarity in the goods and services at issue:
 - (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.

It was also held in the *Canon* case, *supra* (at paragraph 23) that in assessing the similarity of the goods or services in question, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, end users, method of use as well as whether they are in competition with or are complementary to each other.

27. Also, it is stated in *Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (T-133/05) that 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 (at paragraph 29).
28. I further note that the goods and services are 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 lies with the same undertaking (*Boston Scientific Ltd v OHIM* Case T-325/06 at paragraph 82).
29. Both Cited Marks are registered in respect of various goods and services in Classes 9, 16 and 41. The cited goods cover, *inter alia*, electronic publications, materials in digital format, instructional and educational apparatus and instruments in Class 9 and periodical publications, printed matter, instructional and teaching materials, educational textbooks and stationery in Class 16. The cited services are in relation to, *inter alia*, the provision of publication and on-line publication of electronic books, books and other materials, translation of books and other relevant materials, provision of fitness training and the rental of books and magazines relating to each training, and educational services which could be provided online from computer databases in Class 41 (collectively, the “cited goods and services”).
30. As mentioned above, the applied-for goods include electronic publications, newsletters, magazines, pamphlets and booklets available in electronic form and

for downloading from a database or from the Internet, with all of the aforesaid relating to health, exercise, diet, weight-loss or nutrition in Class 9. At the examination stage, the agent averred that the applied-for goods were all specifically restricted to those in relation to health, exercise, diet, weight-loss, or nutrition; as such, the applicant was targeting consumers with health problems, or those to improve their health or to control their weight, and that the purposes or functions of the applied-for goods were different from those of the business interest of the owner of the Cited Marks, whose purposes are concerned with learning or improving one's English skills. On that basis, the agent submitted that the trade channels as well as the points of sale of the applied-for goods and the provision of the cited goods and services were different.

31. I do not agree. As there has been no restriction on the nature of the cited goods and services, it is apparent that the cited goods, consisting of, inter alia, various electronic publications and educational textbooks could relate to health, exercise, diet, weight-loss, nutrition or, in fact, any other subject matter. In other words, the cited goods are broad enough to cover the applied-for goods in Class 9. Hence, irrespective of whether the owner of the Cited Mark has other business interests, the use, physical nature and users of the cited goods and the applied-for goods are the same. Furthermore, the applied-for goods are sold at retail stores or available on online bookstores and those points of sale are likewise the same trade channels for the cited goods to reach the average consumer. Applying the principle in paragraph 27 above, the applied-for goods and the cited goods are identical.
32. As regards the cited services in Class 41, I consider that the publications and other relevant materials sold or provided under the cited services are identical or highly similar to the different types of electronic publications as applied-for by the applicant. The applied-for goods are therefore considered to be similar and complementary to the cited services.
33. Taking into account all relevant factors and observations referred to from paragraphs 26 to 32 above, I conclude that the applied-for goods and the cited goods and services are identical or closely similar.

Likelihood of confusion

34. Under section 12(3) of the Ordinance, likelihood of confusion refers to confusion on the part of the public as to the trade origin of the applied-for goods. This is a matter of global appreciation taking into account all relevant factors and judging through the eyes of the average consumer of the applied-for goods.
35. At the examination stage, the agent argued that the relevant consumers would normally pay a higher level of attention to both the goods and services offered by the applicant and the owner of the Cited Marks at the point of purchase, much more so than other types of day-to-day necessities, the reason being the purposes of the applied-for goods directly affect one's health and safety.
36. I disagree. As mentioned in paragraph 15 above, people nowadays are increasingly more health conscious and would look for ways to improve or maintain their well-being. As the applied-for goods cover a wide range of publications on related topics, the average consumer therefore consists of members of the general public in Hong Kong. They are deemed to be reasonably well-informed, circumspect and observant, but the level of care and attention that can be expected of them on such goods is only average. More importantly, as the applied-for goods are electronic publications which aim to provide information on related topics but not food or drugs per se, I do not see how the applied-for goods would directly affect one's health and safety and that the average consumer is expected to pay a higher level of care at the point of purchase. That said, even if I were to accept that a higher level of care and attention can be expected of the average consumer, in view of the similarity between the Subject Mark and the Cited Marks, and the identity/ similarity of the applied-for goods and the cited goods and services, the average consumer is likely to believe that the goods and services provided by the two conflicting marks come from the same or economically-linked undertakings.
37. Therefore, having regard to the visual, aural and conceptual similarities between the Subject Mark and the Cited Marks, and the identity/ similarity of the applied-for goods and the cited goods and services, and bearing in mind the principles set out in paragraph 12 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 applied-for goods and the cited goods and services 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.

Overseas registrations

38. At the examination stage, the agent pointed out the co-existence of the Subject Mark with the Cited Marks in the UK and EU, and that any disputes as regards the owner of the Cited Marks in the EU were not between the owner of the Cited Marks and the applicant. However, it should be noted that national trade mark rights are territorially limited and granted independently of each other. The mere fact that a sign is registrable in other countries is not sufficient to establish that it is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As valid reasons for refusal have been found, I am not persuaded that the Subject Mark should be accepted merely by following the decisions of other registries, in particular, when I am not aware of the reasons behind the acceptances.

Conclusion

39. I have considered all the submissions made by the agent in respect of the subject application. For the reasons stated above, the Subject Mark is therefore precluded from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Karine Lai
for Registrar of Trade Marks
10 April 2015

Cited Mark 1



Trade mark:

Registration no.: 300439164

Classes no : 9, 16, 41

Specification: Class 9

Computer software; electronic publications; electronic books; audio, video and audio-visual recordings; prerecorded CDs, CD-Roms and DVDs; teaching, instructional and educational apparatus and instruments.

Class 16

Periodical publications; magazines and journals; books; maps; posters; charters; printed matter; instructional and teaching materials (other than apparatus); paper articles; cardboard and cardboard articles.

Class 41

Educational services; training; correspondence courses; publication of texts; publication of books; on-line publication of electronic books and magazines; providing on-line electronic publication of electronic books (not downloadable).

Date of registrtion: 15 June 2005

Cited Mark 2

Trade mark: Cambridge Young Learners English

Registration no.: 301370835

Classes no.: 9, 16, 41

Specification: Class 9

Audio tapes, audio cassettes, audio equipment; video cassettes, video tapes; floppy disks; floppy disks bearing with computer

software; CD-ROMS; CD-R; CD-RW; DVDs; DVD-ROMs; DVD-R; DVD-RW; CDs; published materials in digital format; optical, electronic and magnetic data storage devices bearing recorded information; digital data carriers; carriers for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; sound, images, text and information downloadable via telecommunication networks, online, and by the internet; computer software; computer software for teaching, instructional, and educational purposes; electronic publications; electronic databases; apparatus and instruments for recording and/or reproducing sound and/or images and/or text and/or data; blank cassette tapes, blank video tapes, blank CDs, and blank DVDs, and pre-recorded sound and video recording materials; electronic, digital and magnetic carriers with recorded information; publications in electronic form, supplied on-line from databases or from facilities provided on the internet; computer programs; mouse-pads.

Class 16

Audio books; books; journals; periodicals; printed publications; teaching materials; reference books; dictionaries; thesaurus; magazines, posters and charts; flyers; printed advertisements; manuals and handbooks; booklets; catalogues; educational textbooks.

Class 41

Educational services including the provision of instructional, training, teaching, testing, examination, and/or assessment services, and including all the aforesaid services being provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination, and/or assessment materials, including examination papers and syllabuses and materials for the testing of English language skill; testing of English language skills; information, advisory, and

consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases, and/or intranets, and/or extranets, and/or the internet; translation of books, magazines, periodicals, instructional, training, teaching, testing, examination, and/or assessment materials; publication of books, journals, magazines, internal articles; syndication of books, journals, magazines, internal articles, newspapers, instructional, training, teaching, testing, examination , and/or assessment materials; production, presentation, and/or syndication of educational and current affairs programmes, radio, television programmes, films, cassettes, videos, and disks, including those related to long distance learning programmes; provision of information relating to, and assisting with entry into, foreign universities, colleges, and/or schools; the provision services relating to libraries, galleries, museums, arranging cultural and educational exhibitions; arranging concerts, opera performances, concert performances, theatrical performances, symphony orchestra performances, live performances, balls, dances, clubs, theatres, golf courses, conducting conferences, conducting sports games and activities, and sports training camps; agency for the entertainment industry, and agency for writers; provision of skills training courses, training institutes, language training institutes, professional schools, practical training (demonstrations), job training, fitness training, and the rental of books and magazines relating to such training; provision of searching via on-line means relating to the aforesaid services.

Date of registrtrion: 24 June 2009

Cited Mark 3

Trade mark: **CAMBRIDGE UNIVERSITY PRESS**

Registration no.: 301457901

Classes no.: 9, 16, 41

Specification: Class 9

Computers; computer software; computer programs; electronic books and publications; on-line electronic books and publications

provided over the internet; electronic computer games; video games; recording discs; sound, audio, video and audio visual recordings; pre recorded CDs, CD-Roms and DVDs; digital and pre recorded video tapes, cassettes, compact discs and phonograph records; optical apparatus and instruments; spectacles; sunglasses; fridge magnets; teaching and instructional apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 16

Printed matter; paper; stationery; paper articles; cardboard and cardboard articles; newspapers, periodical publications, magazines and journals, all being publications; books; posters; maps; charts; instructional and teaching materials (other than apparatus); photographs; paper knives; bookmarks; souvenir plastic bags.

Class 41

Educational services; training; correspondence courses; publication of texts; publication of books; publication services; on-line publication of electronic books and magazines; providing on-line publication of electronic books (not downloadable).

Date of registration: 24 October 2009