

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 301699011

MARK :



CLASS : 9
APPLICANT : G'FIVE IP (SINGAPORE) PTE. LTD.
OPPONENT : CISCO TECHNOLOGY, INC.

STATEMENT OF REASONS FOR DECISION

Background

1. On 26 August 2010, Gewoo Telecom (Shen Zhen) Ltd. (“Former Applicant”) applied to register the trade mark shown above (“Subject Mark”) under the Trade Marks Ordinance (Cap.559) (“Ordinance”) in respect of the following goods:

Class 9

Radiotelephone sets; Radiotelegraphy sets; Telephone apparatus; Video telephones; Portable telephones; Walkie-talkies; Kits (Hands free -) for phones; Transmitting sets [telecommunication]; Transmitters of electronic signals; Vehicles (Navigation apparatus for -) [on-board computers]; Cables [Fibre [fiber (Am.)] optic -]; Audiovisual teaching apparatus; Cables, electric; Computers; Computer peripheral devices; Microphones; Sound recording apparatus; DVD player; Juke boxes [musical]; Megaphones; Television apparatus; MP3; MP4.

2. The application was subsequently assigned by the Former Applicant to G'Five IP (Singapore) Pte. Ltd. (“Applicant”) on 22 February 2011, and the particulars of the application were published on 30 June 2011.

3. On 30 September 2011, Cisco Technology, Inc. (“Opponent”) filed a notice of opposition to the subject application together with a statement of grounds of opposition (“Grounds of Opposition”). In response to the notice of opposition, the Applicant filed a counter statement (“Counter Statement”) on 29 December 2011.

4. The Opponent’s evidence consists of a statutory declaration made by Angela Stark on 18 December 2012 together with exhibits (“Stark Declaration”). No evidence was filed by the Applicant in these proceedings.

5. The hearing for opposition took place before me on 31 October 2014. Mr. Frederick Kwok and Ms. Fandy Ip of Messrs. Vivien Chan & Co. appeared for the Opponent at the hearing. The Applicant did not attend the hearing.

The Opponent and the grounds of opposition

6. According to the Grounds of Opposition, the Opponent is a limited liability company incorporated under the laws of the United States of America. Together with its affiliated entities, the Opponent carries on the business as a developer and provider of goods and services related to information technology.

7. The Opponent is the proprietor of, *inter alia*, the following registered trade mark in Hong Kong:

Trade Mark	Registration No.	Date of Registration	Class No.
 <p>(the “Opponent’s Composite Mark”)</p>	300719794	12 September 2006 (priority claimed from 17 August 2006)	9, 16, 36, 38, 41, 42, 45

The Opponent also applied for registration of the following mark in Hong Kong:

Trade Mark	Application No.	Date of Application	Class No.
 <p data-bbox="268 779 509 860">(the “Opponent’s Device Mark”)</p>	302023352	3 September 2011	9, 16, 35, 36, 38, 41, 42

8. The Opponent claimed that it had used the Opponent’s Composite Mark and the Opponent’s Device Mark (collectively, the “Opponent’s Marks”) in Hong Kong since at least 2007 in relation to various products and services relating to information technology, and had established substantial goodwill and reputation in those marks.

9. It was alleged that the device component of the Subject Mark was confusingly similar to the Opponent’s Marks, and hence the public would be confused between the respective marks and misled into the belief that the Applicant’s goods are associated with the Opponent. By reason of the similarity of the marks in question, the Opponent averred that the use of the Subject Mark was likely to deceive the public, constituted infringement of the Opponent’s Composite Mark, and would take unfair advantage of or be detrimental to the distinctive character or reputation of the Opponent’s Marks. It was also alleged that the subject application was made in bad faith, and was an act calculated to ride on the goodwill and reputation gained by the Opponent’s Marks.

10. The Opponent relied on the grounds for refusal prescribed under sections 12(3), 11(5)(a), 11(1)(a), 12(5)(a), 11(4)(b), 11(5)(b) and 12(4) of the Ordinance in this opposition.

The Applicant and the Applicant's case

11. According to the Counter Statement, the Applicant is a limited liability company incorporated under the laws of Singapore. Both the Applicant and the Former Applicant belong to the G'FIVE group of companies ("G'FIVE Group"), founded in 2003, which carries on the business of manufacturing and selling electronic products, especially mobile phones, under the brand of "G'FIVE". The Applicant claimed that the goods manufactured by the G'FIVE Group in China were exported to a number of emerging markets in South Asia, Southeast Asia, Middle East, Africa and South America.

12. The Applicant denied that the Subject Mark is similar to any of the Opponent's Marks, and that the use of the Subject Mark in relation to the goods applied for was likely to cause confusion on the part of the public.

13. It was averred by the Applicant that the Subject Mark was an original artistic work designed by Zhang Wuxue, the founder of the G'FIVE Group. The invented word "G'FIVE" was originated from the phrase "give me five", whereas the device represents the signals displayed on a mobile phone. The Applicant requested the opposition to be dismissed with costs to the Applicant.

The Opponent's evidence

14. According to the Stark Declaration, the Opponent is a wholly-owned subsidiary of Cisco Systems, Inc., which is entitled to use the intellectual properties held by the Opponent through intercompany agreements. For the purpose of the present proceedings, there is no need to distinguish the Opponent and Cisco Systems, Inc. and I shall refer them together as the "Opponent".

15. Founded in 1984 by a husband and wife team in Stanford University, the Opponent has evolved into a worldwide leader in the field of computers, communication, networking products and services. The Opponent was publicly listed on the NASDAQ stock exchange in 1993 and its stock has been included in the Dow Jones Industrial Average and the Standard & Poor 500 Index. Currently, the Opponent is headquartered in San Jose, California and has a global presence with more than 400 offices worldwide, including Hong Kong.

16. As to the origin of the Opponent’s Composite Mark, Ms. Stark stated that the Opponent underwent a massive and internationally high profile re-branding exercise in 2006 and adopted a newly designed corporate logo, which is the Opponent’s Composite Mark. The Opponent’s Composite Mark was first used in October 2006 and remains the corporate logo of the Opponent today. It was claimed that the re-branding exercise has successfully made the Opponent’s Composite Mark a “household” brand, with its brand value increased by a record amount of US\$1.56 million in the year of 2007 alone. Copies of the Interbrand’s “Best Global Brands” report for 2007 and ReBrand’s 2008 “100 Distinctive Winners – Cisco Systems” report were produced at exhibit “AS-6” of the Stark Declaration to support the aforesaid assertion.

17. Ms. Stark claimed that the Opponent has since 2006 continuously used the Opponent’s Marks worldwide in relation to its goods and services, including (*inter alia*) telephony products, voice-over Internet Protocol-based (IP) telephones, wireless IP phones, software and infrastructure for mobile phones and the installation and maintenance of the above products and related accessories. It was also claimed that the Opponent has filed applications and obtained registrations for the Opponent’s Marks in many countries and regions around the world, including Hong Kong. The Stark Declaration also set out the various details of the use and promotion of the Opponent’s Marks and proof of the level of fame and reputation attained by such efforts. I do not propose to summarize those testimonies here, but will discuss them as and when appropriate in the latter parts of this decision.

18. There are altogether forty-one pieces of exhibits attached to the Stark Declaration and they are numbered from “AS-1” to “AS-41” respectively. Their brief descriptions are set out as follows:

Exhibit No.	Description of exhibit
AS-1	A copy of the Articles of Incorporation of the Opponent
AS-2	A copy of the Restated Articles of Incorporation of Cisco Systems, Inc. and the Form 10-K as filed with the US Securities and Exchange Commission
AS-3	Copies of printouts of the Opponent’s official website www.cisco.com , showing an overview of the products and services offered by the Opponent

AS-4	Copies of printouts of the Opponent's official website, showing the sections of "Company Overview", "Press Release" and "Corporate Overview Presentation" of the Opponent
AS-5	Copies of the Certificate of Incorporation and the latest Annual Return of Cisco Systems (HK) Limited for the year of 2012
AS-6	Copies of ReBrand's 2008 "100 Distinctive Winners – Cisco Systems" and the "Best Global Brands" report published by Interbrand for the year of 2007
AS-7	A copy of "Cisco Corporate Logo Usage Guidelines for Third Parties" published by the Opponent in October 2006
AS-8	A table showing the worldwide trademark portfolio of the Opponent
AS-9	A copy of the printout of the online trademark record for registration of the Opponent's Composite Mark in Hong Kong
AS-10	A copy of the printout of the online trademark record for registration of the Opponent's Device Mark in Hong Kong (as at December 2012)
AS-11	A selection of copies of the registration certificates of the Opponent's Marks around the world and the English translations thereof
AS-12	Copies of logo guidelines to the media, "Cisco Policy on Trademarks", "Cisco Policy on Copyright" and "Cisco Logo Program – Corporate Logo"
AS-13	Copies of extracts of the 2007, 2009 and 2011 "Cisco Products Quick Reference Guide" for circulation among the Opponent's business partners and local distributors, showing some of the Opponent's goods and services worldwide
AS-14	A copy of online article extracted from the Opponent's official website, discussing the Opponent's milestone of selling its 30 millionth IP phone in the year of 2010
AS-15	Copies of product datasheets of the Opponent, showing the particulars of the various telephony products sold by the Opponent since 1992 and those under the Opponent's Composite Mark since 2007
AS-16	Copies of publically available news and websites in relation to the Opponent's IP phones
AS-17	Copies of website printouts showing the availability of the Opponent's mobile device applications and podcasts from the App Stores
AS-18	Copies of printouts of the Opponent's website, showing the promotion of the Opponent's LINKSYS Wi-Fi routers, and copies of photographs depicting the LINKSYS product packaging and sell sheets used in the Hong Kong market

AS-19	Sample copies of the user manuals of the Opponent's products and printouts of certain webpages at which the Opponent's booklets and user manuals are available for download
AS-20	A copy of printout in relation to the Opponent's Hong Kong office
AS-21	Copies of printouts of the Opponent's bilingual Hong Kong microsites
AS-22	Copies of the Opponent's marketing materials promoting its Channel Partner Programs, and a printout of the first page of search results confirming those business partners are based in Hong Kong
AS-23	Copies of printouts of the Opponent's website showing the distributors and retailers of its LINKSYS products in Hong Kong, and a photograph of a LINKSYS retail display at IntelliTech
AS-24	Copies of printouts about the training programs and events organized by the Opponent in Hong Kong from 2007 to 2012, information on the current Cisco Networking Academies in Hong Kong and the marketing materials regarding Cisco Networking Academy generally
AS-25	A copy of a printout of the news in relation to the awards received by the Opponent in Hong Kong
AS-26	Copies of printouts of the Opponent's "Cisco Press" website at www.ciscopress.com , showing the various booklets and user manuals published by the Opponent are available for sale in Hong Kong
AS-27	Copies of excerpts from the Opponent's annual reports, substantiating the sales figures of the Opponent's products from 2007 to 2012
AS-28	Copies of product factsheets and other promotional materials on the Opponent's goods and services for the Hong Kong market
AS-29	Copies of printouts of the Opponent's Facebook page dedicated to Hong Kong
AS-30	Copies of printouts of the Opponent's other social media pages, such as YouTube, Twitter, and LinkedIn
AS-31	Copies of photographs and website printouts regarding the seminars and other events held or attended by the Opponent in Hong Kong
AS-32	A copy of printout from the Opponent's official website showing a list of countries in which the Opponent has business presence
AS-33	Copies of Annual Reports of the Opponent for the years of 2006, 2007, 2009, 2010 and 2011, and excerpts of the 2008 report
AS-34	Copies of printouts of the website of Interbrand showing the ranking of the top 100 "Best Global Brands" from 2001 to 2008, and copies of the reports for "Best Global Brands" for the years from 2009 to 2012
AS-35	Copies of excerpts of BrandZ's "Top 100" reports from 2008 to 2012

AS-36	Interbrand's "Global Green Brands" list for the years of 2011 and 2012
AS-37	Copies of printouts of Google searches on "CISCO" and "CISCO products"
AS-38	Copies of printouts of the websites of "Fortune 500" and "Forbes 2000"
AS-39	A list of awards received by the Opponent for the years 2008-2012
AS-40	Copies of representative decisions laid down by courts or tribunals around the world with verdicts held in favour of the Opponent, including decisions holding the CISCO mark to be well-known
AS-41	Copies of printouts of the websites operated by the Applicant

Decision

19. In his carefully prepared submissions, Mr. Kwok for the Opponent addressed me on virtually each and every ground of opposition which has been pleaded in the Grounds of Opposition. For convenience, I will set out my analysis below in the same sequence as Mr. Kwok's submissions i.e. in the order of sections 12(3), 11(5)(a), 11(1)(a), 12(5)(a), 11(4)(b), 11(5)(b) and 12(4) of the Ordinance.

20. The relevant date for considering the opposition is 26 August 2010, the date of filing of the subject application for registration ("Relevant Date").

Opposition under section 12(3) of the Ordinance

21. Section 12(3) of the Ordinance states as follows:

"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."

22. The term “earlier trade mark” is defined in section 5 of the Ordinance, the relevant part of which 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 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

(b)”

23. The Opponent relies mainly on the registration of the Opponent’s Composite Mark for its opposition under section 12(3). As the date of application for registration of the Opponent’s Composite Mark is earlier than that of the Subject Mark, the Opponent’s Composite Mark is an “earlier trade mark” in relation to the Subject Mark pursuant to section 5(1)(a) of the Ordinance.¹

24. To determine whether registration of the Subject Mark is prohibited under section 12(3) by virtue of the presence of the Opponent’s Composite Mark, I must consider whether there are similarities between the Subject Mark and the Opponent’s Composite Mark, and between the goods covered by them, which would combine to create a likelihood of confusion.

25. In assessing the similarity between the marks and the likelihood of confusion between them, I am guided by the principles 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, all of which were referred to in the Opponent’s Skeleton Submissions and the List of Authorities of the Opponent. The relevant principles are:

(a) The likelihood of confusion must be appreciated globally, taking account of all the relevant factors.

¹ The Opponent did not make any submissions on the Opponent’s Device Mark for its opposition under section 12(3). In any event, the date of application for registration of the Opponent’s Device Mark is later than that of the Subject Mark, so it does not fulfil the requirement of being an “earlier trade mark” in relation to the Subject Mark.

- (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

26. Mr. Kwok submits that the Subject Mark is confusingly similar to the Opponent's Composite Mark, because the Subject Mark contains a device which closely resembles the device in the Opponent's Composite Mark. According to him, the device of the Opponent's Composite Mark is "a device of nine rounded vertical lines of differing lengths resulting in two wave-like shapes", whereas the device of the Subject Mark consists of "seven incrementally rounded vertical lines, two of which overlap with the other two", forming "a wave-like shape or two overlapping wave-like shapes". Given that the device component in each of the marks is prominent and significant, he argues that there is a prima facie case for similarity.

27. I am however not convinced by Mr. Kwok's submissions. The assessment of similarity between two marks means more than taking just one component of a composite mark and comparing it with the other component in another mark. The correct approach, according to the principles referred to in paragraph 25 above, is to assess the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It is also incorrect to put each element of the marks in question under close scrutiny, as the average consumer usually perceives a mark as a whole and does not proceed to analyze its various details.

28. Both of the marks in question are compound marks made up of text and graphic components. The Subject Mark consists of the words "G'FIVE", "Mobile technology" and "Wisepad" on the left, and a device made up of various vertical lines on the right. For the Opponent's Composite Mark, the upper part is occupied by a device of various vertical lines which forms a symmetric pattern, whereas the lower part consists of the word "CISCO" in capital letters.

29. Visually, there is a slight degree of similarity between the Subject Mark and the Opponent's Composite Mark as both of them contains a device which is constituted by a series of parallel vertical lines of different lengths. Having that said, I am of the view that the respective devices are only similar to a moderate degree since the Opponent's device is a longer and symmetric pattern

which resembles the shape of a bridge², whilst the Applicant's one is apparently shorter and asymmetric. More importantly, such similarity between the two marks will be overshadowed by the vast differences created by the presence of the word "G'FIVE" in the Subject Mark and the word "CISCO" in the Opponent's Composite Mark, each of them being the prominent and distinctive element of the respective marks. The visual disparity between the Subject Mark and the Opponent's Composite Mark is further widened by the different manners in which their constituent text and graphic elements are arranged. Even if the effect of the words "Mobile technology" and "Wisepad" in the Subject Mark are discounted as they are less conspicuous and less distinctive in respect of the goods concerned (due to their descriptive references to mobile technology and automated machines in tablet forms), the differences between the two marks are still visible and immediately noticeable to the eye of the average consumer. For these reasons, I find that there is only a low degree of visual similarity between the two marks.

30. Aurally, the Subject Mark is likely to be pronounced as "GEE-FIVE", whereas the Opponent's Composite Mark will be referred to in speech as "CIS-CO". As words speak louder than devices, the device parts of the marks are unlikely to have an impact in the oral references of the marks. Hence, in terms of phonetical comparison, I find that the Subject Mark is not similar to the Opponent's Composite Mark.

31. Conceptually, the words "G'FIVE" and "CISCO" in the Subject Mark and the Opponent's Composite Mark do not convey any perceptible meaning to the average consumer in relation to the applied for goods. Although the term "cisco" may refer to "any of various whitefish, esp. *Coregonus artedi*, of cold deep lakes of North America" (*Collins English Dictionary, Millennium Edition*), I do not think that the relevant consumers will be able to grasp this dictionary meaning upon seeing the mark in the context of the goods in question. Likewise, the abstract device in each of the marks does not evoke any readily known meaning, and they may be regarded as a decoration or embellishment. As discussed, the words "Mobile technology" and "Wisepad" in the Subject Mark will likely be considered as descriptive references to mobile technology and automated machines in tablet forms respectively. Overall speaking, I find that the ideas presented by the respective marks are very different. There is no

² Incidentally, the Opponent itself has referred to its device as a "device of a bridge" in paragraph 8 of the Grounds of Opposition. Such reference was no longer adopted in its later submissions and at the hearing.

conceptual similarity between the two marks.

32. To conclude, I find that the Subject Mark and the Opponent's Composite Mark are only visually similar to a low degree, and they are not similar aurally and conceptually. In overall terms, the two marks are not similar with each other.

Comparison of goods

33. I have set out the specification of the goods applied for under this application in the first paragraph of this decision.

34. As at the Relevant Date, the Opponent's Composite Mark is registered in respect of a long range of goods and services in Classes 9, 16, 36, 38, 41, 42 and 45. For the present purpose, I would only need to consider those goods registered under Class 9, which are:

Electrical and scientific apparatus; computer hardware and software for interconnecting, managing, securing and operating local and wide area networks and telephony systems; telephones, telephone headsets; electronic communication devices, namely, personal digital assistants, pagers, and mobile telephones; wireless communications devices, namely, wireless local area network (LAN) hardware and software for the transmission of voice, data, audio, and video; call processing software for the transmission of data, video, and voice traffic; downloadable instructional materials, namely, manuals, guides, test materials, and magazines in the fields of network communications, and managing, operating and using local, wide and global networks, and cable television systems; televisions; stereos; DVD players; CD players; consumer electronics; routers; telecommunication gateway apparatus; switches; network access range expanders; internet video cameras; print servers; communication terminals comprising computer hardware and/or software for providing video, audio, data, video game, and telephone communications and/or transmissions; network storage devices, comprised of computer hardware and/or software; interfaces for interconnecting computers, projectors, stereo systems, game consoles, home appliances and/or other electronic devices; devices for recording, organizing, transmitting, and reviewing audio files;

computer hardware; network interface cards; network cables; computer network adapters; servers; computer hardware containing network security functionality, including firewalls, data encryption, and/or interoperability with network security protocols; computer software and hardware for sending, storing, managing, integrating and accessing text and voice messages via telephone, electronic mail, pagers, personal digital assistants, and internal and global computer networks; digital video recorders; set-top boxes; cable television units; hardware and software for use in cable television systems, content distribution systems, and communication systems.

35. The Opponent submits that that the applied for goods are in direct conflict with the goods and services in respect of which the Opponent's Composite Mark is registered. This contention is not disputed by the Applicant.

36. In my view, "*radiotelephone sets; radiotelegraphy sets; telephone apparatus; video telephones; portable telephones; walkie-talkies; kits (hands free -) for phones*" of the applied for goods are virtually the same or similar to "*telephones*" in the specification of the Opponent's Composite Mark. "*Cables [fibre [fiber (Am.)] optic]; cables, electric*" in the subject application belongs to the same category as "*network cables*" in the Opponent's registration. The items of "*computers; computer peripheral devices; microphones; sound recording apparatus; DVD player; juke boxes [musical]; megaphones; television apparatus; MP3; MP4*" in the Applicant's specification overlap with "*computer hardware; televisions; stereos; DVD players; consumer electronics; hardware and software for use in cable television systems, content distribution systems, and communication systems*" in the Opponent's specification. For the rest of the Applicant's goods, namely "*transmitting sets [telecommunication]; transmitters of electronic signals; vehicles (navigation apparatus for -) [on-board computers]; audiovisual teaching apparatus*", they are encompassed by and considered to be identical to the broad term "*electrical and scientific apparatus*" in the Opponent's registration.³

37. Hence, I find the two sets of goods under comparison to be identical or closely similar.

³ Goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, or vice versa (*Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-133/05); *Bowerbank's Application* [2008] ETMR 31)

Distinctiveness of the earlier trade mark

38. 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 (*Sabel BV v Puma AG* (supra)).

39. In determining the distinctive character of an earlier trade mark, I must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (*Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (supra)).

40. The Opponent's Composite Mark is a mark which consists of two parts, namely a device in the upper half and the word "CISCO" in the lower half. As analyzed above, both elements are distinctive of the goods in question and as a whole, the Opponent's Composite Mark possesses a reasonably high level of inherent distinctiveness in respect of the goods for which it is registered.

41. As to whether the distinctive character of the Opponent's Composite Mark has been enhanced through use, Mr. Kwok submitted at the hearing that the Opponent's Composite Mark, being the house mark of the Opponent, has acquired, as at the Relevant Date, a high degree of distinctiveness in Hong Kong through its long and extensive use and promotion worldwide and in Hong Kong. With reference to the various parts in and exhibits of the Stark Declaration, he highlighted to me the following points:

- (a) The Opponent is a worldwide leader in the field of computers, communication and networking products and services. The Opponent

has been constantly ranked as one of the most valuable global brands and listed in *Fortune 500* as one of the biggest corporations in the world since 2005.

- (b) The Opponent entered the Hong Kong market as early as in 1993 and currently has over 400 employees. The Opponent has more than 300 authorized business partners in Hong Kong that sell its goods and offer its services to customers, including Microview Telecom Limited and Orange Business Services. For products which target home users, the Opponent has appointed two distributors and 23 retailers in Hong Kong, including Fortress.
- (c) The Opponent's Composite Mark has been used in Hong Kong since at least January 2007 and been applied on various goods and services in the field of information technology and networking communications, including telephony products. As far as the goods under Class 9 are concerned, the Opponent's products include (*inter alia*) voice over IP telephony products, wireless IP phones and software for smartphones ("Relevant Goods"). The use of the Opponent's Composite Mark span across different channels, including the Opponent's website, mobile applications, social media sites, booklets and manuals.
- (d) The annual revenue generated by the Opponent in the Asia Pacific region (including Hong Kong) from 2007 to 2012 was high, ranging from US\$3,652 million to US\$7,485 million.
- (e) The Opponent held and attended numerous seminars, conferences, sponsored events and trade shows in the information technology and communications industry in Hong Kong, such as being the exclusive sponsor for the 10th International Telecommunications Union World (ITU) event in 2006, and the organizer for "Cisco Expo" held at the Hong Kong Convention and Exhibition Centre in 2008.
- (f) The Opponent provided extensive training and education in Hong Kong to its business partners and individuals involved in the information technology and communications industry via webcasts, seminars and programs offered through the Cisco Networking Academy (CNA). Currently, there are 23 CNAs in Hong Kong, including one in the

Chinese University of Hong Kong. The Opponent's CNA program was awarded the "Best Professional Development Grand Award" by the British Computer Society (Hong Kong Section) in 2008.

42. Having examined and considered the Opponent's evidence with reference to the above submissions, I am prepared to accept that the Opponent's Composite Mark is entitled to claim an enhanced degree of distinctive character in respect of the Relevant Goods. Although the duration of use is not particularly impressive (3 years and 7 months before the Relevant Date), I find that the Opponent's Composite Mark, being the house mark of the Opponent, has been used intensively and promoted on a very large scale in respect of the Relevant Goods globally. In Hong Kong, the Opponent has established an extensive network of distributors and taken part in various marketing and public relations activities in the trade. The fact that the Opponent has been ranked by Interbrand (an international branding consultant) and BrandZ (a brand equity database) as one of the most valuable brands in the world for consecutive years before the Relevant Date is particularly telling as to the degree of recognition enjoyed by the Opponent's Composite Mark in the market.

43. For the above reasons, I find that the Opponent's Composite Mark has a reasonably high level of inherent distinctiveness, and the level of its distinctiveness in respect of the Relevant Goods has also been enhanced by the use which has been made of it.

Likelihood of confusion

44. The likelihood of confusion must be appreciated globally, taking account of all relevant factors. The matter must be judged through the eyes of the average consumer of the goods or services concerned who is deemed to be reasonably well informed and reasonably observant and circumspect.

45. The goods for which the subject application is made encompass a fairly broad range of electronic products and accessories. Given that these goods may be used or sought by anyone in Hong Kong, the relevant public comprise members of the general public who look for these products, as well as business users and people in the trade. Having regard to the rapid growth of consumer electronics market and the pace in which new products are launched, the relevant consumers nowadays would merely exercise an average degree of

care and attention in the selection of these goods. The level of attention to be expected of business users will be higher if they look for the more advanced and sophisticated technological products.

46. In paragraphs 26 to 32 above, I have analyzed the similarities and dissimilarities between the Subject Mark and the Opponent's Composite Mark from the visual, aural and conceptual perspectives and come to the conclusion that the two marks are only visually similar to a low degree and they are not similar aurally and conceptually. The overall impressions created by the marks in question are quite different. That being the case, despite the fact that the goods covered by the two marks are overlapping and the Opponent's Composite Mark enjoys a reasonably high level of inherent distinctiveness which has also been enhanced by use, I do not find that there exists a likelihood of confusion in that the average consumer would be confused into believing that the respective goods offered under the Subject Mark and the Opponent's Composite Mark come from the same or economically linked undertakings.

47. The ground of opposition under section 12(3) is not established.

Opposition under sections 11(5)(a) and 11(1)(a) of the Ordinance

48. Section 11(5)(a) provides that a trade mark shall not be registered if, and to the extent that, its use is prohibited in Hong Kong under or by virtue of any law.

49. Section 11(1)(a) stipulates that signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark") shall not be registered. Section 3(1) defines a "trade mark" as any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.

50. The Opponent's case under these two sections is that given the alleged similarity of the Subject Mark and the Opponent's Composite Mark and the alleged likelihood of confusion between them, the use of the Subject Mark would constitute infringement of the Opponent's Composite Mark under section 18(3) of the Ordinance and is hence prohibited under section 11(5)(a), and since the Subject Mark is not capable of distinguishing the goods of the Applicant from those of the Opponent, it shall not be allowed registration under section 11(1)(a).

51. I have already found that the Subject Mark is not similar to the Opponent's Composite Mark. I have also found that there is no likelihood of confusion between the respective goods offered under the Subject Mark and the Opponent's Composite Mark. As the Opponent's case under sections 11(5)(a) and 11(1)(a) is built essentially on its ground under section 12(3), which is now unsuccessful, logically the opposition under sections 11(5)(a) and 11(1)(a) of the Ordinance should fail as well.

52. In any event, the grounds under section 11(5)(a) and 11(1)(a) of the Ordinance are "absolute grounds for refusal" which are concerned with the trade mark itself, not the "relative" rights between parties. It is apparent however that the Opponent's basis of objection stems from the alleged conflict of the Subject Mark with the Opponent's Marks, which should be dealt with by section 12 of the Ordinance (relative grounds for refusal). The grounds of opposition under sections 11(5)(a) and 11(1)(a) are therefore misconceived and bound to fail.

Opposition under section 12(5)(a) of the Ordinance

53. Section 12(5)(a) of the Ordinance provides that a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off).

54. The main argument put forward by Mr. Kwok in relation to section 12(5)(a) is that as at the Relevant Date, the Opponent's Device Mark is an unregistered trade mark which has acquired substantial goodwill and reputation in the market, and as a result of which, together with the similarity between the Subject Mark and the Opponent's Device Mark, the use of the Subject Mark by the Applicant in Hong Kong would constitute an act of misrepresentation which is liable to be prevented by the common law action of passing off. As an alternative argument, the Opponent also claims that the use of the Subject Mark would amount to passing off on the basis of its similarity with the Opponent's Composite Mark.

55. As to what amount to an actionable passing off, Mr. Kwok referred me to the following classic statements made by Lord Oliver in the House of Lord's decision of *Reckitt & Coleman Products Ltd v Borden Inc.* [1990] RPC

341 (also known as the “*Jif Lemon*” case):

*“The law of passing off can be summarized in one short general proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. **First**, he must establish a **goodwill or reputation** attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognized by the public as distinctive specifically of the plaintiff’s goods or services. **Second**, he must demonstrate a **misrepresentation** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff... **Third**, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer **damage** by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.” (emphasis added)*

56. The existence of goodwill or reputation in a given mark, get-up or other indication of origin is a question of fact which must be established by evidence. On the evidence filed, I do not find that the Opponent has established goodwill or reputation in the Hong Kong market by virtue of any use of the Opponent’s Device Mark. There is very limited evidence to show that the Opponent’s Device Mark has in fact been used by the Opponent in respect of any of its goods or services in Hong Kong. Instead, the marks which were most frequently used by the Opponent, as I gleaned from the exhibits of the Stark Declaration, are the Opponent’s Composite Mark (i.e. its house mark) and the word mark “CISCO”. When these observations are pointed out to Mr. Kwok at the hearing, he replied that there were instances in which the Opponent’s Device Mark was used alone without the word “CISCO” (such as at page 12 of Exhibit “AS-17”) but he also accepted that the extent of such use was not substantial. Mr. Kwok however suggested that customers will focus more attention on the device which is more distinctive than the word “CISCO” when they see the

Opponent's Composite Mark. I am not for a moment convinced by this argument. As discussed earlier, "CISCO" is a meaningless and highly distinctive word in relation to the relevant goods. It is also clear from the representation of the Opponent's Composite Mark that the word "CISCO" is prominent, clearly visible and will be readily spotted and remembered by the relevant consumers. Moreover, "CISCO" is the corporate name of the Opponent and it can be referred to aurally. As such, I do not think that the relevant purchasers will ignore the word "CISCO" and recognize only the abstract device. Rather, they would view the Opponent's Composite Mark in its entirety and perceive the device as merely a part of the Opponent's Composite Mark. In light of the foregoing, I am not satisfied that the Opponent's Device Mark has acquired goodwill or reputation in the mind of the purchasing public, and accordingly, there is no question of any goodwill which could be damaged by any alleged misrepresentation on the part of the Applicant.

57. As far as the Opponent's claim of passing off on the basis of the Opponent's Composite Mark is concerned, I do not consider that there is any real prospect of success as well. Even assuming that the Opponent's Composite Mark has got sufficient goodwill and reputation to launch an action of passing off, it has been my finding above that the Subject Mark and the Opponent's Composite Mark are not similar in overall terms. It follows that the public will unlikely be confused or misled into the belief that the goods offered by the Applicant are those of the Opponent, or in some way connected with or guaranteed by the Opponent. The element of misrepresentation is missing. In the circumstances, there is nothing from which it could be inferred that the Opponent is likely to suffer damage by reason of any erroneous belief engendered by the Applicant's misrepresentation.

58. In view of the foregoing, the Opponent has not shown that the use of the Subject Mark in Hong Kong was liable to be prevented by virtue of the law of passing off at the Relevant Date. The opposition under section 12(5)(a) of the Ordinance fails.

Opposition under section 11(4)(b) of the Ordinance

59. Section 11(4)(b) of the Ordinance provides that a trade mark shall not be registered if it is likely to deceive the public.

60. The Opponent's case is that the use of the Subject Mark is likely to deceive the public due to its resemblance with the Opponent's Marks. However, it has been well established that section 11(4)(b) of the Ordinance is intended to apply where the alleged deception arises from the nature of the mark itself, as opposed to that arising from the similarity of marks between different parties. Hence, same as the opposition under section 11(5)(a) and 11(1)(a), I consider that the Opponent's claim under section 11(4)(b) is misconceived and is bound to fail.

Opposition under section 11(5)(b) of the Ordinance

61. Section 11(5)(b) of the Ordinance provides that a trade mark shall not be registered if the application for registration of the trade mark is made in bad faith. As to the meaning of "bad faith" in this context, Mr. Kwok referred me to a number of case authorities, including the following passage made by Mr. Justice Lindsay in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379:

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

62. In *Harrison's Trade Mark Application* [2005] FSR 10, the English Court of Appeal held that:

"The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards."

63. Further, in *Ajit Weekly Trade Mark* [2006] RPC 25, the Appointed Person referred to the above two cases and said:

“The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the determination of the objective element.”

64. The Opponent did not file any evidence to show that the Applicant has acted dishonestly or behaved in a manner which falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area of trade. Instead, Mr. Kwok invited me to draw an inference of bad faith on the basis of the following circumstances of this case:

- (a) The Opponent’s Marks have established a strong reputation in the information technology and communications industry. As a business undertaking in the same industry, the Applicant must have been aware of the Opponent’s reputation.
- (b) The Applicant explained the origin of the Subject Mark in the Counter Statement, but no sworn evidence was filed in support of such claim. The Applicant’s account as to the origin of the device in the Subject Mark was a mere cover up story and cannot stand. It is not common to present waving signals displayed on a mobile phone in the form of parallel vertical lines with rounded ends. The device in the Subject Mark must be deliberately copied by the Applicant from the Opponent’s Device Mark with a view to mislead people to believe that the Applicant’s goods are associated with the Opponent.
- (c) Apart from the subject application, the Applicant also filed other applications for registration of marks incorporating the device element in the Subject Mark (TMA 302016503, 301749916AA and 301608192). Those applications were either successfully opposed by the Opponent or are pending examination.

65. Mr. Kwok also referred me to the High Court case of *Mila Schon Group SpA v Lam Fai Yuen (t/a Tung Kwong Co)* [1998]1 HKLRD 682 and a Registry’s decision on the mark “*GOLDEN HARE 金火兔 & Device*” and argued that a bad faith claim may well succeed even in cases where only one part of a trade mark was said to have been copied.

66. In my view, the submissions of Mr. Kwok have gone too far. At page 697 of the judgment in the *Mila Schon* case, Recorder Kotewall SC (as he then was) stated that:

*“There was also a fair amount of discussion as to the provenance of the respondent’s device. I note that there is no evidence from the person who is alleged to have devised the design of the respondent’s device. This is a Ms Yeung and she has apparently refused to co-operate with the respondent in these proceedings and has refused to file evidence before this court. The fact of the matter is that there is no evidence as to from where she got the device or the idea. This is a significant omission. I say this because, although the onus is on the applicant for rectification, **where the devices as they ultimately became are so similar**, a court can be forgiven for concluding that one is derived from the other unless there is acceptable evidence from the originator of the idea to the contrary. Nor is there an abundance of evidence from Mr Sugaya, the person who drew the final version of the respondent’s device, as to the instructions Mr Lam or Ms Yeung supplied to him. It would not be much of a stretch to conclude that the respondent’s device may well have been derived from that of the applicant.” (emphasis added)*

67. In *Mila Schon*, the court was prepared to make an inference of fact that the respondent’s device was derived from the applicant’s device on the basis that the two devices are “so similar” and in the absence of acceptable evidence from the originator of the mark. In the *GOLDEN HARE* case, the hearing officer also found that the devices in question (each depicting the head of a rabbit) were highly similar to each other (at paragraph 17).⁴ However, in the instant case, I do not consider that the device in the Subject Mark is similar to the Opponent’s Device Mark to such an extent that the drawing of an inference of copying is warranted. As discussed in paragraph 29 above, the devices in question are

⁴ The decision was written in Chinese. The relevant passages were “涉訟商標中兔子的頭部跟反對人的商標極為相似” and “兩個圖案中的兔頭部分的相似程度極高”.

only moderately similar to each other, when the Opponent's device is a longer and symmetric pattern, whereas the Applicant's one is shorter, asymmetric and with overlapping shades. In the premises, I do not find that there is any solid basis to conclude that the device in the Subject Mark must be copied from the Opponent's Device Mark.

68. The fact that the Applicant has applied to register, or failed to register, other marks incorporating the same device element in the Subject Mark cannot offer much assistance to the Opponent's case as well. Just as the Opponent have filed a number of applications to protect different marks of the Opponent, I do not think that it is fair to criticize the Applicant for making multiple applications for registration covering different versions of its marks as claimed. In any event, as these allegations have not been properly raised by the Opponent in the Grounds of Opposition and were not supported by any exhibits in the Stark Declaration, I am not prepared to take this matter any further.

69. As stated in *Royal Enfield Trade Mark* [2002] RPC 24, an allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. Like a plea of fraud, an allegation of bad faith should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference. If bad faith is being alleged, it should be alleged up front as a primary argument or not at all. Also, according to *BRUTT Trade Mark* [2007] RPC 19, although the standard of proof applicable to an allegation of bad faith is on the balance of probabilities, cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith.

70. In the present case, I do not find that there is any prima facie evidence to justify the allegation of bad faith. I also do not find that an inference of bad faith is justified in the circumstances of the case. Viewing all the matters in the round, I am not satisfied that the Applicant's filing of the subject application can be regarded as dishonest or falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the trade.

71. The ground of opposition under section 11(5)(b) of the Ordinance is therefore not established.

Opposition under section 12(4) of the Ordinance

72. I will now deal with the final ground of opposition relied on by the Opponent, namely section 12(4). The Opponent's case under section 12(4) is that each of the Opponent's Marks is a well-known trade mark in Hong Kong, and the use of the Subject Mark by the Applicant is without due cause and would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Opponent's Marks.

73. Section 12(4) of the Ordinance provides:

“Subject to subsection (6), a trade mark which is –

- (a) identical or similar to an earlier trade mark; and*
- (b) proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected,*

shall not be registered if, or to the extent that, the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

74. In other words, for an opposition under section 12(4) of the Ordinance to succeed, the following elements must be established:

- (a) the applied-for mark is identical or similar to an earlier trade mark of the opponent;
- (b) the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark; and
- (c) the use of the applied-for mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

75. For the condition under paragraph 74(a) above is to be satisfied, there must be a degree of similarity between the earlier mark and the applied-for mark such that the relevant section of the public establishes a link between them, even though it does not confuse them (*Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] ETMR 10). The existence of such a link must be appreciated globally, taking into account all relevant factors, including the degree of similarity between the marks at issue; the nature of the goods or services for which the marks at issue were registered, the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and the existence of likelihood of confusion on the part of the public (*Intel Corporation Inc. v CPM United Kingdom Ltd.* [2009] RPC 15).

76. Regarding the requirement referred to in paragraph 74(c) above, the proprietor of the earlier mark must adduce proof that the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark (*Intel v CPM* (supra)). Detriment to and unfair advantage of distinctive character or repute has to be proved by real, as opposed to theoretical, evidence and cannot be merely assumed from the fact that the earlier mark has a substantial reputation (*Creditmaster Trade Mark* [2005] RPC 21). Section 12(4) does not have the sweeping effect of preventing the registration of a sign which is the same as or similar to a well-known earlier trade mark. It is also not intended to enable the owner of a well-known earlier trade mark to object as a matter of course to the registration or use of a sign which may remind people of his mark (*Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767).

77. I have already found that, overall speaking, the Subject Mark is not similar to the Opponent's Composite Mark. Having considered all the factors relevant to the circumstances of the case, I am not satisfied the relevant consumers would establish a link between the Subject Mark and the Opponent's Composite Mark. The first requirement set out under paragraph 74 above is therefore not satisfied.

78. Moreover, the Opponent has not submitted any evidence to show that use of the Subject Mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Opponent's Composite Mark. The

evidence filed in these proceedings relates merely to the use and reputation of the Opponent's Composite Mark. In other words, the Opponent's claims of taking unfair advantage and detriment are nothing but bare assertions. The third requirement referred to in paragraph 74 above is also not established.

79. As such, it is no longer necessary for me to make a finding on the second requirement, namely whether the Opponent's Composite Mark is entitled to protection under the Paris Convention as a well-known trade mark or not. The opposition under section 12(4) of the Ordinance on the basis of the Opponent's Composite Mark must fail.

80. As far as the opposition under section 12(4) on the basis of the Opponent's Device Mark is concerned, I would just need to say that the Opponent's Device Mark does not qualify as an "earlier trade mark" in relation to the Subject Mark pursuant to section 5(1)(a) of the Ordinance, because its date of application for registration is later than the Relevant Date. In view of the paucity of user evidence as discussed in paragraph 56 above, the Opponent's Device Mark is also not entitled to be claimed as a well-known trade mark and be considered as an earlier trade mark pursuant to section 5(1)(b) of the Ordinance. Accordingly, the Opponent's case of section 12(4) insofar as it relates to the Opponent's Device Mark must fail as well.

Conclusion and costs

81. I have considered each of the grounds of opposition relied on by the Opponent and found that none of them has been made out. The opposition therefore fails.

82. As the opposition is not successful, I award costs to the Applicant. 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.

(Ryan Ng)
p. Registrar of Trade Marks
18 March 2015