

2011 ("Counter-statement") in response to the Notice of Opposition and the Amended Grounds of Opposition.

3. The Opponent's evidence consists of:

- (a) a statutory declaration of Lesley A. Moradian made on 12 February 2013 ("Moradian's Declaration"); and
- (b) a supplemental statutory declaration of Lesley A. Moradian made on 31 July 2013, which was merely to rectify an error in Moradian's Declaration.

4. Hing Lung did not file any evidence in these proceedings.

5. The substantive opposition hearing took place before me on 15 April 2015. Mr. Philips B. F. Wong, Counsel, instructed by Messrs. Baker & McKenzie appeared for the Opponent. Hing Lung did not appear at the hearing.

6. On 21 July 2015, with leave from the Registrar, 深圳市君億科技有限公司 ("Applicant") substituted Hing Lung as the applicant in the subject opposition proceedings. The Applicant has also undertaken to be bound by the Counter-statement filed in these proceedings.

Grounds

7. At the hearing, of the grounds pleaded in the Amended Grounds of Opposition, the Opponent only relied on the grounds under the following sections of the Ordinance:

- (a) section 11(5)(b);
- (b) section 12(5)(a); and
- (c) section 12(4).

Relevant date

8. The relevant date for considering this opposition is the Application Date, i.e. 22 October 2010.

The Opponent

9. According to Moradian's Declaration, the Opponent's business was founded by the professional make-up artist Bobbi Brown.¹ In 1990, Bobbi Brown began the creation of her 10 super lasting lipsticks. In 1991, BOBBI BROWN was officially launched in the New York Department Store Bergdorf Goodman as a new independent make-up brand. In 1992, the Opponent's make-up line was expanded to include yellow-toned shades of Foundation Stick, powder, blush and eye shadow.² The Opponent's brand continued to grow, and in 1995, the Opponent launched a skincare line. In that same year, the Opponent was acquired by Estee Lauder Companies Inc. as a subsidiary.³ The Opponent's website was launched in 1996 and its online store was launched in 1998.⁴ According to Moradian's Declaration, as at 2009, the Opponent's BOBBI BROWN products were available in over 850 stores in 50 countries around the world.⁵

10. The Opponent's approximate worldwide revenues through sales of the Opponent's goods for the years 2005 to 2010 are stated to be as follows:⁶

<i>Financial Year</i>	<i>Total Global Revenue (US\$)</i>
2005	189.4 million
2006	223.4 million
2007	274.2 million
2008	323.6 million
2009	327.8 million
2010	357.4 million

11. The Opponent's estimated total worldwide expenditure in the promotion and marketing of its BOBBI BROWN mark for the years 2005 to 2010 are stated to be as follows:⁷

<i>Financial Year</i>	<i>Global Marketing Expenditure (US\$)</i>
2005	30 million
2006	39.3 million
2007	46.1 million

¹ Moradian's Declaration, para.4.

² Moradian's Declaration, para.5.

³ Moradian's Declaration, para.7.

⁴ Moradian's Declaration, para.9.

⁵ Moradian's Declaration, para.15.

⁶ Moradian's Declaration, para.16.

⁷ Moradian's Declaration, para.36.

<i>Financial Year</i>	<i>Global Marketing Expenditure (US\$)</i>
2008	54.7 million
2009	59.9 million
2010	65.6 million

12. The Opponent has obtained registrations of its "BOBBIE BROWN" mark in various countries/regions in the world including but limited to Australia, Canada, China, European Community, Hong Kong, Malaysia, Mongolia, Papua New Guinea, Taiwan and USA.

13. The Opponent is the registered owner of the Hong Kong registered trade marks ("Opponent's HK registered marks") listed in the **Schedule**.

14. The Opponent has used its BOBBI BROWN mark in relation to its make-up, brushes and tools, organizers, cosmetic bags and cases, fragrances and skincare products.⁸ The Opponent claims that the Opponent's goods under its BOBBI BROWN mark have been continuously sold in Hong Kong since 1996.⁹ Exhibit-17 to Moradian's Declaration includes some invoices issued since September 2004 in respect of sales of products under the BOBBI BROWN mark to Lane Crawford Ltd (Times Square, IFC, Pacific Place), Kowloon Seibu and Harvey Nichols. According to Moradian's Declaration, there were approximately 10 Bobbi Brown stores and counters (including 3 freestanding stores and 7 department store counters) in Hong Kong in 2009.¹⁰

15. The Opponent's approximate revenues in Hong Kong through sales of the Opponent's goods for the years 2005 to 2010 are stated to be as follows:¹¹

<i>Financial Year</i>	<i>Total Revenue (HK\$)</i>
2005	32.7 million
2006	45.6 million
2007	67.7 million
2008	102.4 million
2009	117 million
2010	143.5 million

16. Cosmetics and skin care products marketed under the Opponent's BOBBI BROWN mark have been advertised in magazines in Hong Kong including

⁸ Moradian's Declaration, para.18, Exhibits-12 & 17.

⁹ Moradian's Declaration, para.22.

¹⁰ Moradian's Declaration, para.24.

¹¹ Moradian's Declaration, para.26.

Cosmopolitan, Elle, Jessica and More. The Opponent's products have also been promoted by way of outdoor banners, direct mailers (including joint promotion with credit card companies), electronic direct mailers and in-store posters and bounce-back cards.¹²

17. The Opponent's marketing expenditure in Hong Kong is estimated as follows:¹³

<i>Financial Year</i>	<i>Hong Kong Marketing Expenditure (HK\$)</i>
2005	9.1 million
2006	10.1 million
2007	14.8 million
2008	19.5 million
2009	19.5 million
2010	21.8 million

The Applicant

18. In the Counter-statement, it is stated that Hing Lung is a company incorporated in Hong Kong. Hing Lung claimed that it developed the brand "ABBIE BROWN" in 2010, but had not used the subject mark in Hong Kong.

19. By an assignment dated 1 April 2015, the subject mark was assigned by Hing Lung to the Applicant.

20. Neither Hing Lung nor the Applicant has filed any evidence in these proceedings.

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

21. Section 12(5) of the Ordinance provides, *inter alia*, as follows:

"(5) ... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

(a) 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); ...

¹² Moradian's Declaration, Exhibit-21.

¹³ Moradian's Declaration, para. 37.

and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an “earlier right” in relation to the trade mark.”

22. The Opponent’s case under section 12(5)(a) of the Ordinance is that:¹⁴

"Given the fame and recognition of the [Opponent's HK registered marks] and their similarities with the [subject mark], registration of the [subject mark] is contrary to Section 12(5)(a) of the Ordinance as use of the [subject mark] in Hong Kong is liable to be prevented by virtue of rules of law protecting unregistered trade marks or other signs used in the course of trade or business (in particular, by virtue of the law of passing off) and the Opponent is the owner of earlier rights entitling it to prevent such uses."

23. The relevant question is whether normal and fair use of the subject mark for the purpose of distinguishing the subject services from those of other undertakings was liable to be prevented at the Application Date by an action of passing off.¹⁵

24. The requisite elements for establishing a passing-off action were formulated in the case of *Reckitt & Colman Products v. Borden Inc.*¹⁶ These elements have been repeatedly relied upon by the courts in Hong Kong including the Court of Final Appeal in *Re Ping An Securities Ltd.*¹⁷ In essence, in the present context, the Opponent has to establish that:

- (a) the Opponent enjoys **goodwill** attached to the goods or services which it supplies in the mind of the purchasing public by association with a trade mark under which its goods or services are offered to the public, such that the trade mark is recognized by the public as distinctive specifically of the Opponent’s goods or services;
- (b) the Applicant has made a **misrepresentation** to the public leading or likely to lead the public to believe that the subject services offered by it are the services of the Opponent; and
- (c) the Opponent suffers, or is likely to suffer, **damage** by reason of the erroneous belief engendered by the Applicant’s misrepresentation that

¹⁴ Amended Grounds of Opposition, para.18.

¹⁵ *WILD CHILD Trade Mark* [1998] R.P.C. 455.

¹⁶ [1990] R.P.C. 341.

¹⁷ (2009) 12 HKCFAR 808 (FACV 26/2008).

the source of the Applicant's subject services is the same as the source of goods or Services offered by the Opponent.

25. To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation¹⁸ generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

26. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.¹⁹

Goodwill

27. The relevant date for determining whether the Opponent has established the

¹⁸ E.g. an express statement that the defendant's goods or services are goods or services of the plaintiff.

¹⁹ *Halsbury's Laws of Hong Kong* (2nd Edition) Vol. 33, para. [225.021].

necessary goodwill is the date of the application for the mark in question or the date of the commencement of the conduct complained of,²⁰ whichever is earlier. As there is no evidence that the Applicant has used the subject mark before the Application Date, I only need to consider the position as at the Application Date.

28. I have already considered the Opponent's evidence (paragraphs 9 to 17 above). I am satisfied that the Opponent has sufficient goodwill in Hong Kong attached to the cosmetics and skincare products it supplied in the mind of the purchasing public by association with the Opponent's BOBBI BROWN trade mark to mount an action in passing off at the Application Date.

Misrepresentation

29. I refer to the principles set out in paragraphs 25 to 26 above.

30. The Opponent's BOBBI BROWN mark enjoys reputation in the field of cosmetics and skin care products in Hong Kong. The Opponent's products sold under the BOBBI BROWN mark include cosmetics and skin care products, as well as tools, bags and cases for cosmetics. The Opponent also operates retail outlets in respect of its goods. Beauty and skin care information and advice may be provided by the Opponent as ancillary services. There is no evidence that would indicate that the Opponent has used or licensed others to use its BOBBI BROWN mark in relation to goods or services beyond the field of cosmetics and skin care products or services ancillary thereto.

31. The subject services include import, export, wholesale, retail and distributorship of clothing, footwear, headgear. The field of activity of the Applicant by reference to the subject services and the field of activity of the Opponent do not overlap.

32. The subject mark consists of two words "ABBIE" and "BROWN". Each of the Opponent's HK registered marks consists of or contains the words "BOBBI" and "BROWN". Each of the marks "ABBIE BROWN" and "BOBBI BROWN" would be viewed as a whole as a name consisting of a first name and a surname. Although both the subject mark and the Opponent's BOBBI BROWN mark include the word "Brown" as the second word, "Brown" is a common surname. The two marks would simply be perceived as two different names.

²⁰ *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] R.P.C. 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] R.P.C. 8 and 9.

33. Mr. Wong for the Opponent submitted that the subject mark is deceptively similar to the Opponent's **B O B B I B R O W N** mark as:

- (a) both marks are word marks each containing two word elements;
- (b) the second word in both marks is identical ("BROWN");
- (c) the first word of the subject mark ("ABBIE") looks confusingly similar to the first word of the Opponent's mark ("BOBBI"), in particular, both consist of 5 letters of the alphabet, and with the same letters combination "BBI";
- (d) both marks are presented in the narrow sans serif font;
- (e) aurally, the second word of both marks is pronounced the same; and in respect of the first words, the second syllable ("BBI" and "BBIE") also has the same pronunciation.

34. Visually, although each of the subject mark and the Opponent's **B O B B I B R O W N** mark consists of two words, and share the same second word "BROWN", they differ in the first word ("ABBIE" vs "BOBBI"). Although the first word in the two marks each consists of 5 letters and has the same letters combination "BBI", those three letters appear in different positions in the rather short words "ABBIE" and "BOBBI" (second to fourth letters in "ABBIE", and third to fifth letters in "BOBBI"). Consumers usually would not have the two marks side by side and then try to find the letters in common between them. They would simply regard "ABBIE" and "BOBBI" as two different words. Moreover, although the font used in the subject mark is as shown below:

A B B I E B R O W N

the words **BOBBI BROWN** in the Opponent's HK registered marks and in the examples of actual use in the Opponent's evidence do not always appear as follows:

B O B B I B R O W N

In any event, any visual similarity due to the fonts used would be outweighed by the different overall visual impression created by the different first words "ABBIE" and

"BOBBI".

35. Aurally, the subject mark would be pronounced in three syllables "AB-BIE-BROWN", whilst the Opponent's **B O B B I B R O W N** mark would be pronounced in the three syllables "BO-BBI-BROWN". Despite the common second and third syllable, the difference in the first syllable differentiate the subject mark from the Opponent's **B O B B I B R O W N** mark.

36. Conceptually, the subject mark and the Opponent's **B O B B I B R O W N** mark would be perceived as two different names that have no connection with each other.

37. Having regard to the visual, aural and conceptual similarities and differences between the subject mark and the Opponent's **B O B B I B R O W N** / BOBBI BROWN mark, I find that the overall impression created by the subject mark is very different from that created by the Opponent's **B O B B I B R O W N** / BOBBIE BROWN mark. They would be seen and understood as two different names.

38. As the subject mark has not been used before the Application Date, there is no information on the manner in which the Applicant would make use of the subject mark. In any event, I have to consider normal and fair use of the subject mark in relation to the subject services.

39. The Opponent's **B O B B I B R O W N** / BOBBI BROWN mark enjoys reputation in the field of cosmetics and skin care products. The Applicant's subject services consist of import, export, wholesale, retail and distributorship of clothing, footwear, headgear. The class of persons concerned include both end-consumers and dealers of goods in those fields. Visual selection of the goods would be important, although aural use of the marks could not be ignored.

40. The Opponent submitted that although the Applicant and the Opponent may not be in a common field of activity, the Registrar can take judicial notice that many fashion brands nowadays also market cosmetics and other beauty-related products (e.g. Dior, Chanel, Dolce & Gabbana, DKNY, Yves Saint Laurent, Hermes, Prada, Polo Ralph Lauren, Calvin Klein, Jean-Paul Gaultier, Hugo Boss, Tommy Hilfiger Giorgio Armani, Kenzo, Burberry). The Opponent submitted that this would lead members of the public to believe that services provided under the subject mark to be of the same origin as the goods marketed under the Opponent's **B O B B I B R O W N** mark.

41. The Opponent's **B O B B I B R O W N** / BOBBI BROWN mark enjoys reputation in the field of cosmetics and skin care products. There is no evidence before me that would indicate that it is common for cosmetics and skin care products brands to expand their business into the field of importing, exporting, wholesaling, retailing or distributorship of clothing, footwear or headgear. Moreover, I have already found that the overall impression created by the subject mark is very different from that created by the Opponent's **B O B B I B R O W N** / BOBBIE BROWN mark. On seeing the subject mark used in relation to the subject services, the public would not be confused into thinking that those services are of the same origin as the Opponent's goods or services, or are of a different line or label used for the retail business of the Opponent. The argument referred to in paragraph 40 does not assist the Opponent.

42. Taking into account all of the above considerations, I consider that when the subject mark is used in relation to the subject services, the public would unlikely be misled into believing that those services offered by the Applicant are the services of the Opponent or are connected. The element of misrepresentation is therefore not made out.

Damage

43. It follows that 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.

44. I find that the ground of opposition under section 12(5)(a) of the Ordinance is not made out.

Opposition under section 12(4) of the Ordinance

45. Section 12(4) of the Ordinance provides, *inter alia*, as follows:

"... 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."

46. The Opponent's case under section 12(4) of the Ordinance is stated to be as follows:²¹

"The use of the [subject mark] would take unfair advantage of and is detrimental to the distinctive character of the [Opponent's HK registered marks] as it creates the impression that there is a link between it and the Opponent. Accordingly, registration of the [subject mark] is contrary to Section 12(4) of the Ordinance as the [subject mark] is similar to the [Opponent's HK registered marks] which are entitled to protection under the Paris Convention as well-known trade marks.

47. In the Opponent's skeleton submissions for the substantive opposition hearing, the Opponent submitted that:

"31. There is little question that the [Opponent's **BOBBI BROWN** mark] enjoyed well-known status at the time when the Applicant made the present application to register the [subject mark].

32. There is clearly a "link" between the [subject mark] and the [Opponent's **BOBBI BROWN** mark]. In particular, the two marks are similar to each other and that the [Opponent's **BOBBI BROWN** mark] enjoyed strong reputation in the market.

33. The Applicant's use of the [subject mark] will take unfair advantage of the distinctive character and repute of the [Opponent's **BOBBI BROWN** mark] by riding on the coat-tails of the [Opponent's **BOBBI BROWN** mark] in order to benefit from the power of attraction, the reputation and the prestige of the [Opponent's **BOBBI BROWN** mark] and to exploit the marketing effort expended by the Opponent over the years.²²

34. Alternatively, the use of the [subject mark] will cause detriment to the distinctive character of the [Opponent's **BOBBI BROWN** mark]. In particular, the use of the [subject mark] will dilute the distinctive character of the [Opponent's **BOBBI BROWN** mark], and the [Opponent's **BOBBI BROWN** mark]'s ability to identify the goods is weakened, since use of the [subject mark] will lead to dispersion of the identity and hold upon

²¹ Amended Grounds of Opposition, para.17.

²² *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] F.S.R. 39, at 952-953 (para. 76).

the public mind of the [Opponent's B O B B I B R O W N mark].²³"

48. To succeed under section 12(4) of the Ordinance, the Opponent has to establish, *inter alia*, that:

- (a) the Opponent's B O B B I B R O W N mark is an earlier trade mark which is entitled to protection under the Paris Convention as a well-known trade mark;
- (b) the subject mark is identical or similar to that earlier mark, and that on a global appreciation of all the factors relevant to the circumstances, the use of the subject mark would give rise to a link with the earlier mark in the minds of the relevant public;
- (c) that in consequence of that link, the use of the subject mark without due cause either takes unfair advantage of the distinctive character or repute of the earlier mark or is detrimental to that distinctive character or repute.

49. The requirements listed in paragraph 48(a) to (c) above are cumulative. Each of those requirements must be established before a claim under section 12(4) of the Ordinance is made out.

Similarity and link

50. I refer to the requirement set out in paragraph 48(b) above.

51. For the prohibition in section 12(4) to apply, 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.²⁴ The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind is tantamount to the existence of such a link.²⁵ The existence of such a link must be appreciated globally, taking into account all factors relevant to the circumstances of the case,²⁶ including:²⁷

²³ *Intel Corp Inc.v CPM United Kingdom Ltd* [2009] R.P.C. 15, at 495 (para. 29).

²⁴ *Adidas-Salomon v Fitnessworld* [2004] F.S.R.21 at para. 29; *Intel v CPM* (supra) at para. 30.

²⁵ *Intel v CPM* (supra) at para. 63.

²⁶ *Adidas-Salomon v Fitnessworld* (supra) at para. 30; *Intel v CPM* (supra) at para. 41.

- (i) the degree of similarity between the conflicting marks;
- (ii) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- (iii) the strength of the earlier mark's reputation;
- (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- (v) the existence of the likelihood of confusion on the part of the public.

52. I have already found that the overall impression created by the subject mark is very different from that created by the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark, and that when the subject mark is used in relation to the subject services, the public would unlikely be misled into believing that those services offered by the Applicant are the services of the Opponent or are connected. Cosmetics and skin care products in respect of which the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark enjoys a reputation are not similar to the subject services. Despite the strength of the reputation of the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark and its distinctive character, the dissimilarities between that mark and the subject mark and the respective goods and services are such that when the relevant public is confronted with the subject mark used in relation to the subject services, it would not even call to mind the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark. Use of the subject mark in relation to the subject services would not give rise to a link with the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark in the minds of the relevant public. The requirement referred to in paragraph 48(b) above is not established.

Unfair advantage/detriment

53. As the Opponent has failed to establish that use of the subject mark in respect of the subject services would give rise to a link with the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark in the minds of the relevant public, it follows that there is nothing from which it could be inferred that in consequence of such a link, the use of the subject mark either takes unfair advantage of the distinctive character or repute of the Opponent's **B O B B I B R O W N / BOBBIE BROWN** mark or is detrimental to that distinctive character or repute. The requirement referred to in paragraph 48(c) above is not established.

²⁷ *Intel v CPM* (supra) at para. 42.

54. I find that the ground of opposition under section 12(4) of the Ordinance is not made out.

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

55. Section 11(5)(b) of the Ordinance provides that:

*“(5) A trade mark shall not be registered if, or to the extent that –
... (b) the application for registration of the trade mark is made in bad faith.”*

56. In the Amended Grounds of Opposition, the Opponent's case under section 11(5)(b) is stated as follows:

“19. In addition, in light of the reputation and fame of the [Opponent's HK registered marks], the deliberate choice by the Applicant of a female forename comprised of five letters, with the second syllable being aurally identical to the corresponding second syllable of the first element of the Opponent's BOBBI BROWN mark, and the surname BROWN, in a virtually identical sans serif font as that of the [Opponent's HK registered marks], indicate that the application has been filed in bad faith. Accordingly, registration of the [subject mark] is contrary to Section 11(5)(b) of the Ordinance as the application for registration of the [subject mark] was made with knowledge of the Opponent's reputation in its name and trade marks and was therefore made in bad faith.”

57. In the Counter-statement, the Applicant states that:

“5. The [subject mark] " ABBIE BROWN " is a word mark consisting of the English words "ABBIE BROWN". The [subject mark] is visually different from the Opponent's mark. Although it can be argued that the word "brown" appears in both the [subject mark] and the [Opponent's HK registered marks], it is not possible to isolate certain elements of one mark and comparing it to another isolated element in another. Any visual similarity must be established when comparing the contested marks in their entirety. Further, consumers tend to be more attentive towards the beginning of a mark rather than the end. The [subject mark] begins with the word "ABBIE" whereas the Opponent's marks begin with the word "BOBBI". There are no similarities between the first parts of the contested marks, neither are there any visual similarities between the marks when compared in their entirety.

6. *The [subject mark] is aurally different from the Opponent's mark. The global appreciation test formulated by the European Courts stresses the importance of the first syllable of the contested marks. When read out loud, the first syllable of the [subject mark] is "ab" where the first syllable of the [Opponent's HK registered marks] is "bob". The [subject mark] and the [Opponent's HK registered marks] exhibit little, if any, phonetic similarity.*

7. *The [subject mark] is conceptually different from the Opponent's mark. The marks "ABBIE BROWN" and "BOBBI BROWN" are persons' names. While "Brown" is a common surname, "ABBIE" and "BOBBIE" demonstrate no similarity whatsoever.*

8. *The services covered by the [subject mark] and the goods and services covered by the [Opponent's HK registered marks] are completely different. While the services covered by the [subject mark] is "import, export, wholesale, retail and distributorship of clothing, footwear, headgear", the goods and services covered by the [Opponent's HK registered marks] are mainly cosmetic products and beauty services. The purpose of the goods and services are different, and they are neither in competition nor complementary.*

9. *For the above reasons, the [subject mark] will not cause confusion to the [Opponent's HK registered marks] on the part of the public. The [subject mark] should be accepted for registration.*

...

13. *Paragraph 12, 13, 14, 15, 16, 17, 18 and 19 of the Grounds of Opposition are strongly denied." (**emphasis added**).*

58. The term "bad faith" is not defined in the Ordinance. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 at 379, Lindsay J. said in relation to section 3(6) of the UK Trade Marks Act 1994 (equivalent to section 11(5)(b) of the Ordinance):

"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.”

59. In *Harrison v Teton Valley Trading Co (CHINAWHITE)* [2005] F.S.R. 10, the English Court of Appeal said (at paragraph 26):

“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.”

60. Further, in *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person stated as follows:

“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.”

61. An allegation that a trade mark has been applied for in bad faith is a serious allegation. It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved (*ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24 at para. 31). The standard of proof is on the balance of probabilities but 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 (*Brutt Trade Marks* [2007] R.P.C. 19 at para. 29).

62. On the other hand, a case of bad faith is not always established by way of direct evidence, and that where circumstances are such that a conclusion that there has been copying is warranted, a bad faith claim may well succeed.²⁸

63. In *Mila Schon Group SpA v Lam Fai Yung (t/a Tung Kwong Co)* [1998] 1

²⁸ *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG HCMP 881/2013* (26 March 2014), at para. 31.

HKLRD 682, Mila Schon applied, as a person aggrieved, to rectify the register of trade marks by removing a device in the respondent's (the registrant) trade mark pursuant to section 48 of the repealed Trade Marks Ordinance (Cap. 43). In considering Mila Schon's application, Recorder Kotewall SC stated that although the onus was on the applicant for rectification, where the devices as they ultimately became were so similar, a court could be forgiven for concluding that one was derived from the other unless there was acceptable evidence from the originator of the idea to the contrary.

64. In *Ip Man Shan Henry v Ching Hing Construction Co Ltd (No 2)* [2003] 1 HKC 256 at 307, the then Deputy Judge Lam summarized the relevant principles applicable to civil proceedings on drawing adverse inference:

- "(a) if a prima facie case is made out, and if there are evidence available to the party against whom the case is established which could displace the prima facie case, and he omits to call such evidence, an inference could be drawn;
- (b) however, the inference could be rebutted by a plausible explanation by the party who elected not to call the evidence;
- (c) if an inference is to be drawn, it would be an inference that such available evidence, even if adduced, would not displace the prima facie case;
- (d) it is also open to a tribunal of fact, upon the drawing of such an inference, to take it into account in respect of a matter with respect to which the person not called as a witness could have spoken,
 - i. in deciding whether to accept any particular evidence, which has in fact been given, either for or against that party;
 - ii. in deciding whether to draw inferences of fact, which are open to them upon evidence which has been given."

65. The judgment of Deputy Judge Lam in *Ip Man Shan* was subsequently upheld by the Court of Appeal in CACV 183 of 2003, 4 February 2005.

66. In the present case, the dissimilarities between the Opponent's **B O B B I B R O W N** / **BOBBIE BROWN** mark and the subject mark and the respective goods and services are such that when the subject mark is used in relation to the subject services, it would not even call to mind the Opponent's **B O B B I B R O W N** / **BOBBIE BROWN** mark. Given the high degree of dissimilarity between the marks, I find no

basis for concluding that the subject mark was copied from the Opponent's BOBBI BROWN / BOBBIE BROWN mark.

67. Taking into account all the relevant circumstances of this case, I do not find that there is any basis for concluding that the Applicant's decision to apply for registration of the subject mark in respect of the subject services would be regarded as in bad faith by persons adopting proper standards. The ground of opposition under section 11(5)(b) of the Ordinance is also not made out.

Conclusion and Costs

68. I have considered each of the grounds of opposition relied on by the Opponent. I find that none of them has been made out. The opposition against the subject application therefore fails.

69. As the opposition has failed, I award the Applicant costs. 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 between the parties.

(Finnie Quek)
for Registrar of Trade Marks
31 July 2015

Schedule

Opponent's Hong Kong registered trade marks

<i>Trade Mark No.</i>	<i>Trade Mark/ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification</i>
2005B00907	<p style="text-align: center;">B O B B I B R O W N</p>  <p>Registration of this Trade Mark shall give no right to the exclusive use of the word "BROWN" and the letter "B".</p>	19 Sep 2002	<p><u>Class 3</u> bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; skincare preparations, toiletries, hair care preparations; all included in Class 3.</p>
2002B04282	<p>BOBBI BROWN</p> <p>Registration of this Trade Mark shall give no right to the exclusive use of the word "BROWN".</p>	15 Feb 2000	<p><u>Class 3</u> bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p>
300473139	<p>BOBBI BROWN</p>	9 Aug 2005	<p><u>Class 21</u> Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; cosmetic brushes and applicators; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</p> <p><u>Class 44</u> Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; cosmetic, make-up and beauty consultation services; beauty salon</p>

<i>Trade Mark No.</i>	<i>Trade Mark/ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification</i>
			services, beauty treatment services, make-up services, massage services, pedicure services, cosmetic treatment services, manicure, skin care, facial and reflexology services; provision of information, advisory and consultancy services relating to all the aforesaid services.