

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

**APPLICATION NO. : 301860642**



**MARK :**

**APPLICANT :** **Kabushiki Kaisha Nisshin Seifun Group Honsha  
(Nisshin Seifun Group Inc.)**

**CLASS :** **30**

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**STATEMENT OF REASONS FOR DECISION**

**BACKGROUND**

1. On 16 March 2011, Kabushiki Kaisha Nisshin Seifun Group Honsha (Nisshin Seifun Group Inc.) (the “applicant”) filed an application for registration of a mark shown below (the “Subject Mark”) under the Trade Marks Ordinance (Cap. 559) (the “Ordinance”).



2. Registration of the Subject Mark is sought in respect of goods under Class 30 (the “applied for goods”), the details of which are set out in **Annex A**.
3. During the examination stage, objection was raised by the Registrar of Trade Marks (the “Registrar”) against the subject application under section 12(3) of the Ordinance on the basis of the following 12 registered trade marks<sup>1</sup>, the details of which are set out in **Annex B** attached herein.

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<sup>1</sup> Objection based on a total of 17 citations of earlier trade marks was raised by the Registrar against the subject application on 7 December 2011, 5 out of which (i.e. trade mark nos. 199701263, 199701264, 199708881, 199812454 and 300008612) were not pursued subsequently as a result of the expiration of registration. The latest objection relates to the remaining 12 citations.

Trade Mark Registration no.199911609  
("Cited Mark 1")

日清

Trade Mark Registration no.200003423  
("Cited Mark 2")



Trade Mark Registration no.200111680  
("Cited Mark 3")

日清

Trade Mark Registration no.300033399  
("Cited Mark 4")



Trade Mark Registration no.300074295  
("Cited Mark 5")

日清美味寶

Trade Mark Registration no.300264014  
("Cited Mark 6")



Trade Mark Registration no.300302589  
("Cited Mark 7")

日清奧利友

Trade Mark Registration no.300617319  
("Cited Mark 8")



Trade Mark Registration no.301061775  
("Cited Mark 9")



Trade Mark Registration no.301094139  
("Cited Mark 10")



Trade Mark Registration no.301189828  
("Cited Mark 11")



Trade Mark Registration no.301710549  
("Cited Mark 12")



4. Save that Cited Mark 7 is owned by Nisshin Oillio Group Kabushiki Kaisha (The Nisshin Oillio Group Ltd.), all other cited marks are owned by Nissin Shokuhin Holdings Kabushiki Kaisha (Nissin Foods Holdings Co., Ltd.).
5. Despite submissions made on behalf of the applicant by its agent, namely, Messrs. Benny Kong & Tsai (the "Agent"), the objections were maintained by the Registrar.
6. By a letter dated 4 February 2013, the Agent requested a hearing on the registrability of the Subject Mark. A hearing was scheduled to be held on 18 May 2017. The Agent filed a notice of attendance at hearing (Form T12) on 6 April 2017 but informed the Registrar on 2 May 2017 that the applicant did not wish to attend the hearing. On 4 May 2017, the Registrar confirmed in writing that the said hearing was vacated. No further submission has been filed by the Agent ever since.
7. At the examination stage, in support of the subject application, the applicant filed a statutory declaration dated 24 January 2013 made by Hiroshi Oeda ("Oeda's Declaration"), who is the President of the applicant, with a view to establishing that there has been an honest concurrent use of the Subject Mark and the cited marks for the purpose of section 13(1) of the Ordinance.
8. Pursuant to Rule 75(b)(ii) of the Trade Marks Rules (Cap. 559 sub. leg. A) (the "Rules"), I proceed to decide the matter without a hearing.

## **DECISION**

9. Upon careful consideration and review of all the submissions made by the Agent, the evidence filed and the relevant circumstances of the subject application, I am prepared to waive the objection raised under section 12(3) of the Ordinance based on Cited Marks 2, 4, 5, 6, 7, 8, 9, 10, 11 and 12, and allow registration of the Subject Mark in

respect of the following goods on a *prima facie* basis (hereinafter referred to collectively as the “Accepted Goods”):

Class 30

“bread and buns; Ice cream mixes; Sherbet mixes; Bread crumbs; Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood); Chinese stuffed dumpling (Gyoza); Sandwiches; hamburger; pizzas, Hot dog; Meat pies; Yeast powder; Yeast; Baking powder; Instant confectionery mixes; Premix flour; Wheat Flour for food; Karaage powder (wheat flour mix for making Karaage (Japanese fried chicken)); Tempura powder (tempura batter mix, namely, batter mix for making tempura); Okonomiyaki powder (wheat flour mix for making Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood)); Flour for food; Instant doughnuts mixes; Instant pancake mixes; Instant bread mixes; Kansui (food additive for making Chinese noodles more chewy in texture and yellow in colour); Yeast extract; glaze mix consisting primarily of powdered sugar”.

10. Subject to compliance with the requirements as stipulated in paragraph 61 below, the Subject Mark, insofar as it is in respect of the Accepted Goods, may proceed to publication.
11. I maintain objection under section 12(3) of the Ordinance based on Cited Marks 1 and 3 (collectively the “Cited Marks”) in respect of the following goods:

Class 30

“Frozen doughnuts; Frozen apple pies; Frozen pancakes; Frozen Taiyaki (Japanese-style cake filled with sweat bean paste); Frozen Imagawayaki (Japanese-style cake filled with sweat bean paste); Confectionery; Seasonings; Spaghetti, cooked; Spaghetti, uncooked; Macaroni, cooked; Macaroni, uncooked; Pastas; Cereal preparations, namely processed cereals; Prepared meals or food consisting primarily of cereal preparations; Frozen cooked omelets containing fried rice; Frozen cooked Chuukadon (bowl of rice topped with stir-fried vegetables, meat and seafood); Frozen pre-prepared rice; Frozen pre-prepared pastas; Cooked Soba noodles (Japanese buckwheat noodles); Cooked Yakisoba (pan-fried noodles); Frozen cooked Udon noodles (Japanese thick noodles of wheat); Frozen cooked risotto; Frozen cooked lasagne; Frozen cooked gratin; Frozen cooked Chinese rice noodles; Frozen cooked Chizimi (Korean savory pancakes with vegetables); Frozen cooked Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood); Frozen cooked Takoyaki (fried balls of batter mix with small pieces of octopus); Fried balls of batter mix with small pieces of octopus (Takoyaki); Frozen cooked spring rolls;

Chinese steamed dumpling (shumai); sushi; Steamed buns stuffed with minced meat (Niku-manjuh); Frozen cooked pizzas; Frozen Prepared box lunches (rice and/or pasta predominating) ; Prepared boxed lunches (rice and/or pasta predominating); Frozen cooked corn dogs; Ravioli; Rice; Husked oats; Husked barley; Pasta sauces; Soba noodles (Japanese buckwheat noodles); Udon noodles (Japanese thick noodles of wheat); pancakes; Almond paste; Chocolate paste; Sugar” (collectively the “Objected Goods”).

12. The reasons for refusing registration of the Subject Mark in respect of the Objected Goods are set out in the following.

### **The Ordinance**

13. The relative grounds for refusal of an application for registration are contained in section 12 of the Ordinance. Section 12(3) provides that :-

*“A trade mark shall not be registered if –*

- (a) the trade mark is similar to an earlier trade mark;*
- (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and*
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”*

14. An “earlier trade mark”, as referred to in section 12(3) of the Ordinance, is defined in section 5 of the Ordinance. The relevant part under section 5 reads as follows:-

*“(1) In this Ordinance, ‘earlier trade mark’ (在先商標), in relation to another trade mark, means –*

- (a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any...”*

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

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

*“For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.”*

### **Section 12(3) of the Ordinance**

17. Section 12(3) of the Ordinance essentially precludes a mark from registration if the use of it is likely to cause confusion on the part of the public, as a result of it being similar to an earlier trade mark and that it is sought to be registered in respect of goods or services that are the same as or similar to those registered under the earlier trade mark. I must therefore consider whether there is similarity between the Subject Mark and each of the Cited Marks and between the Objected Goods and the goods registered under the Cited Marks which would lead to a likelihood of confusion.
18. The basic principles regarding the assessment of similarity between signs and the likelihood of confusion between them are set out in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 19. Such principles have been adopted in Hong Kong and confirmed by the Court of Appeal in *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd* [2015] 1 HKLRD 414. In *Tsit Wing*, Lam VP cited (at paragraph 35) the propositions endorsed by Kitchin LJ in *Specsavers* (at paragraph 52) as follows:

“On the basis of these and other cases the Trade Marks Registry has developed the following useful and accurate summary of key principles sufficient for the determination of many of the disputes coming before it:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer**

19. The Objected Goods in Class 30 cover a wide variety of foodstuffs. These include different types of frozen food, dessert dishes, food which contains carbohydrates (e.g. rice, pasta), cereals, pre-prepared food, seasonings, sauces etc. The Objected Goods are in general consumer goods available in supermarkets or groceries. They can be bought on a daily basis and are relatively inexpensive. The relevant consumers in question are members of the general public in Hong Kong. Whilst the relevant consumers are deemed to be reasonably well-informed, reasonably circumspect and observant, the level of care and attention that can be expected to be exercised by them on such goods is average.

## Comparison of marks

20. A comparison of the marks concerned has to be based on an overall appreciation of the visual, aural and conceptual similarities of the marks in question, taking into account the overall impressions given by the marks, and bearing in mind, in particular, their distinctive and dominant components. In comparing the marks concerned, I should consider the perception of the marks in the mind of an average consumer of the relevant goods.



21. The Subject Mark is a composite mark . The four traditional Chinese characters “日清製粉” are set against a background of a parallelogram-like device to the right of the mark. On the far left side, there is a trapezium-like device. At the centre of the mark, a stylized symbol resembling an English letter “N” in upper case is being enclosed in a circular device. There is no colour claim in the subject application. While the combination of the two characters “日清” does not have any particular dictionary meaning, the combination “製粉” to a certain degree is descriptive of foodstuffs, and for that matter the Objected Goods, because the combination may mean crushing any food substances, say, cocoa, beans, rice, wheat, corn flakes, etc., into powder, which relates to or forms part of the process of making or producing a great variety of other foodstuffs (e.g., dessert dishes, noodles, pastas, pancakes, seasonings, sauces, etc.). As is clear from *Jose Alejandro SL v OHIM, Anheuser-Busch Inc Intervening* Case T129/01[2004] E.T.M.R. 15, as a general rule, descriptive elements will not generally form the focus of consumer attention with the consequence that such elements will not usually be considered to be distinctive and dominant within the context of the overall impression created by the mark. Hence, “日清” will capture more attention than “製粉” even though they are being put together as a phrase. Moreover, as the saying goes, words speak louder than devices in a composite mark (*Oasis Stores Ltd. Trade Mark Application* [1998] RPC 631 at 644). When the Subject Mark is considered as a whole, the verbal element “日清” is the most distinctive and dominant element.

22. Regarding Cited Mark 1 , the combination of the two plain Chinese characters “日” and “清” is the only element of the mark and would naturally be the dominant and distinctive element of Cited Mark 1. Likewise for Cited Mark 3, given that “日清” is the only element of Cited Mark 3, it is also the distinctive and dominant element of Cited Mark 3.

23. With regard to the comparison between Cited Mark 1 and the Subject Mark, the overlap in the dominant and distinctive word element “日清” has a significant impact on the visual perception of the marks. The devices in the Subject Mark are likely to be perceived only as an ornamental background, which, while not being totally disregarded, cannot counteract the overall visual similarity resulting from the overlap in the characters “日清”. In addition, the term “製粉”, as discussed above, is of a descriptive nature. As consumers will pay more attention to the word element of a mark, they will tend to remember the characters “日清”. The two marks are, in my view, visually similar to a considerable extent on the whole. Similar observation applies to the visual comparison between the Subject Mark and Cited Mark 3. As both marks coincide in the common dominant element “日清”, they are visually similar.
24. Phonetically, the Subject Mark and Cited Marks 1 and 3 respectively share the most prominent element “日清”, but the Subject Mark has the addition of the characters “製粉”. It is possible that the Subject Mark will only be referred to as “日清製粉” or simply “日清” since one may have difficulty in identifying the devices in speech in respect of the Subject Mark. Moreover, people would pay more attention to the first words being spoken i.e. “日清” in this case, and might ignore “製粉” in view of its descriptive nature. As to Cited Marks 1 and 3, no doubt they would be referred to as “日清” in speech. I find there is moderate aural similarity between the Subject Mark and the Cited Marks.
25. As for the conceptual comparison with the Cited Marks, the word “製粉” in the Subject Mark is relatively insignificant within the overall impression created as a result of its descriptive nature. As for the devices of the Subject Mark, no particular meaningful concept can be perceived. Since the overall impression of both marks in the mind of an average consumer will be dominated by “日清”, the marks are conceptually similar to a moderate degree.
26. Having taken into account the visual, aural and conceptual similarities and differences between the Subject Mark and each of Cited Marks, I find these marks to be similar.

### **Comparison of goods**

27. In assessing the similarity of the goods and services concerned, the following factors set out by Jacob J (as he then was) in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (at pages 296-7) should be taken into account:
- (a) The respective uses of the respective goods or services;
  - (b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of services;
  - (d) The respective trade channels through which the goods or services reach the market;
  - (e) In the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
  - (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.
28. It was also held in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, supra (at paragraph 23) that when comparing the similarity of the goods or services in question, all the relevant factors relating to the goods or services, including but not limited to their nature, their end users, their method of use and whether they are in competition with each other or are complementary, should be taken into account.
29. Cited Mark 1 is registered in respect of various types of food in Class 30 including coffee, tea, cocoa, seasonings, salt, sauces (except dressing), spices, desserts like red beans with lotus seed dessert, various types of starchy foods such as noodles, processed rice and cereal like corn flakes etc. Cited Mark 3 is registered in respect of “soup bases, instant cooking soups; pre-cooked foodstuffs; all included in Class 29”.
30. At the examination stage, it was pointed out to the Agent that the applied for goods including the Objected Goods were similar to the cited goods. The Agent did not raise any argument to the contrary.
31. Given that both the Objected Goods and the goods registered under Class 30 of Cited Mark 1 and Class 29 of Cited Mark 3 are diverse and cover a wide spectrum, comparing the respective specifications item by item is the preferred method. To the extent that the respective specifications of goods overlap, identical goods are involved for the purpose of section 12(3)(b) of the Ordinance.<sup>2</sup>
32. As the General Court said in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* at [29]:
- “In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark

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<sup>2</sup> In *Galileo Trade Mark* [2005] R.P.C.22, it was held that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the UK Trade Marks Act 1994 (equivalent to section 12(1) of the Ordinance), and there is no necessity for such specifications to co-extend. The term “identical goods or services” in section 12(3)(b) of the Ordinance should be construed accordingly.

application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42.”

33. The Objected Goods under Class 30, which are considered to be identical or similar to the goods registered under Class 30 of Cited Mark 1 and Class 29 of Cited Mark 3, may be broadly divided into 6 categories. Goods which are placed in one category may also fit in another category in some instances. They are set out in the table below:

	<b>The Objected Goods</b>	<b>Goods registered under Cited Mark 1</b>	<b>Goods registered under Cited Mark 3</b>
1	<i>Dessert Dishes</i>  <u>Class 30</u> Frozen doughnuts; Frozen apple pies; Frozen pancakes; Frozen Taiyaki (Japanese-style cake filled with sweat bean paste); Frozen Imagawayaki (Japanese-style cake filled with sweat bean paste); confectionery; Pancakes; Almond paste	<u>Class 30</u> red beans with lotus seed dessert; assorted beans dessert	<u>Class 29</u> pre-cooked foodstuffs
2	<i>Seasonings and sauces</i>  Seasonings; pasta sauces, Sugar	Seasonings; Sauces (except dressing); salt	-
3	<i>Rice, pasta and dishes containing the same</i>  Spaghetti, cooked; Spaghetti, uncooked; Macaroni, cooked; Macaroni, uncooked; Pastas; Frozen cooked omelets containing fried rice; Frozen cooked Chuukadon (bowl of rice topped with stir-fried vegetables, meat and seafood); Frozen pre-prepared rice; Frozen pre-prepared pastas; Cooked Soba noodles (Japanese buckwheat noodles); Cooked Yakisoba (pan-fried noodles); Frozen cooked	Chinese rice noodles, noodles, instant noodles; processed rice	Pre-cooked foodstuffs

	Udon noodles (Japanese thick noodles of wheat); Frozen cooked risotto; Frozen cooked lasagne; Frozen cooked Chinese rice noodles; sushi; Frozen Prepared box lunches (rice and/or pasta predominating); Prepared boxed lunches (rice and/or pasta predominating); Ravioli; Rice; Soba noodles (Japanese buckwheat noodles); Udon noodles (Japanese thick noodles of wheat)		
4	<i>Frozen cooked food and other prepared food or dishes</i>  Frozen cooked gratin; Frozen cooked Chizimi (Korean savory pancakes with vegetables); Frozen cooked Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood); Frozen cooked Takoyaki (fried balls of batter mix with small pieces of octopus); Fried balls of batter mix with small pieces of octopus (Takoyaki); Frozen cooked spring rolls; Chinese steamed dumpling (shumai); Steamed buns stuffed with minced meat (Niku-manjuh); Frozen cooked pizzas; Frozen cooked corn dogs	-	Pre-cooked foodstuffs
5	<i>Cereals</i>  Cereal preparations, namely processed cereals; Prepared meals or food consisting primarily of cereal preparations; Husked oats; Husked barley	Retort pouch-packed rice porridge; processed rice, corn flakes	Pre-cooked foodstuffs
6	<i>Cocoa related product</i>  Chocolate paste	Cocoa	-

*Category I Dessert dishes*

34. “Frozen doughnuts” “Frozen apple pies”, “Frozen pancakes”, “Frozen Taiyaki (Japanese-style cake filled with sweat bean paste)”, “Frozen Imagawayaki (Japanese-style cake filled with sweat bean paste)”, “Confectionery”, “Almond paste” and “Pancakes” of the Objected Goods are in general sweet in nature and can serve as

desserts. They are similar to “red beans with lotus seed dessert, assorted beans dessert” under Class 30 of Cited Mark 1 in terms of purpose and end-users. Insofar as those frozen items are concerned, they can be a type of ‘pre-cooked foodstuffs’ under Class 29 of Cited Mark 3. They are either identical to or similar to the aforesaid cited goods.

### *Category 2 Seasonings and sauces*

35. “Seasonings” and “pasta sauces” of the Objected Goods are identical to “seasonings” and “sauces (except dressings)” registered under Cited Mark 1 respectively. “Sugar” and “salt” are substances which can be added to food to improve its flavour. They are often placed at the same section or adjoining sections in supermarkets. “Sugar” in the subject application is considered similar to ‘seasonings’ and ‘salt’ registered under Cited Mark 1.

### *Category 3 Rice, pasta and dishes containing the same*

36. This category contains “Spaghetti, cooked”, “Spaghetti, uncooked”, “Macaroni, cooked”, “Macaroni, uncooked”, “Pastas”, “Frozen cooked omelets containing fried rice”, “Frozen cooked Chuukadon (bowl of rice topped with stir-fried vegetables, meat and seafood)”, “Frozen pre-prepared rice”, “Frozen pre-prepared pastas”, “Cooked Soba noodles (Japanese buckwheat noodles)”, “Cooked Yakisoba (pan-fried noodles)”, “Frozen cooked Udon noodles (Japanese thick noodles of wheat)”, “Frozen cooked risotto”, “Frozen cooked lasagne”, “Frozen cooked Chinese rice noodles” “sushi”, “Frozen Prepared box lunches (rice and/or pasta predominating)”, “Prepared boxed lunches (rice and/or pasta predominating)”, “Rice”, “Ravioli”, “Soba noodles (Japanese buckwheat noodles)”, “Udon noodles (Japanese thick noodles of wheat)”.
37. “Rice” of the Objected Goods includes “processed rice” of Cited Mark 1 hence they are identical. According to the Collins English Dictionary <https://www.collinsdictionary.com/dictionary/english/pasta>, “Pasta” is “a type of food made from a mixture of flour, eggs, and water that is formed into different shapes and then boiled. Spaghetti, macaroni, and noodles are types of pasta”. As such, all the pasta e.g. “Spaghetti, cooked” and different types of noodles e.g. “Soba noodles (Japanese buckwheat noodles)”, “Udon noodles (Japanese thick noodles of wheat)” etc. in this category are similar to “noodles” or “instant noodles” registered under Cited Mark 1. Some dishes which contain either rice (e.g. Frozen cooked risotto) or pasta (e.g. Frozen cooked lasagne, Cooked Yakisoba (pan-fried noodles)) are considered similar in nature to “processed rice”, “Chinese rice noodles”, “noodles”, or “instant noodles” registered under Cited Mark 1 respectively. Food in this category can serve as standard staple foods and targets similar groups of customers. Insofar as those frozen items are concerned, they can be a type of ‘pre-cooked foodstuffs’ under

Class 29 of Cited Mark 3. They are either identical to or similar to the aforesaid cited goods.

*Category 4 Frozen cooked food and other prepared food or dishes*

38. The frozen cooked rice, pasta and related dishes in category 3 overlap with the frozen cooked foodstuff in this category. Category 4 contains non-rice and non-pasta food products and snacks, which are “Frozen cooked gratin”, “Frozen cooked Chizimi (Korean savory pancakes with vegetables)”, “Frozen cooked Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood)”, “Frozen cooked Takoyaki (fried balls of batter mix with small pieces of octopus)”, “Fried balls of batter mix with small pieces of octopus (Takoyaki)”, “Frozen cooked spring rolls”, “Chinese steamed dumpling (shumai)”, “Steamed buns stuffed with minced meat (Niku-manjuh)”, “Frozen cooked pizzas” and “Frozen cooked corn dogs”. These items are either identical to or similar to the “pre-cooked foodstuffs” designated by Cited Mark 3 in terms of method of preparation and use. Both are prepared in advance (either cooked or half-cooked) for later consumption in a quick and convenient manner. Some may be found to be placed in the same or adjoining sections in a supermarket.

*Category 5 Cereals*

39. The item “corn flakes” designated by Cited Mark 1 is included in the more general category of “Cereal preparations, namely processed cereals” of the Objected Goods. They are identical. “Retort pouch-packed rice porridge” under Cited Mark 1 can be a type of “prepared meals or food consisting primarily of cereal preparations” of the Objected Goods hence they are identical. “Husked oats” and “Husked barley” of the Objected Goods on the one hand and “processed rice” and “corn flakes” on the other hand are all cereal products of a similar nature. They are considered similar.

*Category 6 Cocoa related product*

40. As to the item “chocolate paste”, I consider that it is similar to the “cocoa” in Class 30 of Cited Mark 1. “Cocoa” is the basic raw material for making “chocolate paste”. Both may be offered on the same shelf in a supermarket and consumers may expect that producers of cocoa may also produce chocolate paste. ‘Chocolate paste’ is similar to “cocoa”.

41. Taking into account all relevant factors and observations above, I conclude that the Objected Goods and the goods protected by the Cited Marks as discussed above are either identical or similar.

### **Likelihood of confusion**

42. Under section 12(3) of the Ordinance, a likelihood of confusion refers to confusion on the part of the public as to the trade origin of the goods or services in question. It is a matter of global appreciation taking into account all relevant factors and judging through the eyes of the average consumer of the goods or services at issue.
43. As mentioned in paragraph 19 above, the relevant consumers of the Objected Goods are largely members of the general public. The Objected Goods are ordinary everyday foodstuffs. Therefore, consumers cannot be expected to pay more than an average level of attention when selecting the Objected Goods. It should also be noted that the average consumer seldom directly compares marks side by side but rely upon his imperfect recollection of marks.
44. Having regard to the similarities between the Subject Mark and the Cited Marks and the identity and/or similarity between the Objected Goods and the cited goods, bearing in mind the principles laid down in paragraph 18 above and taking into account all relevant factors, I consider that when the Subject Mark is used in relation to the Objected Goods, an average consumer would be confused into believing that the goods provided under the Subject Mark and the goods covered by the Cited Marks (as discussed above) originate from the same trade origin or economically linked undertakings. I conclude that there is a real likelihood of confusion if the Subject Mark is allowed to co-exist with the Cited Marks. In the premises, the registration of the Subject Mark in respect of the Objected Goods under Class 30 is objectionable under section 12(3) of the Ordinance.

### **Section 13(1) of the Ordinance**

45. I now proceed to consider whether the Subject Mark can nonetheless be accepted for registration by virtue of honest concurrent use under section 13 of the Ordinance. The relevant provision under section 13 reads as follows:-

*“(1) Nothing in section 12 (relative grounds for refusal of registration) prevents the registration of a trade mark where the Registrar or the court is satisfied –*

*(a) that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right; or*

(b) *that by reason of other special circumstances it is proper for the trade mark to be registered.*”

### **Section 13(1)(a) of the Ordinance**

46. As stated in *Re CSS Jewellery Co. Ltd.* [2010] 2 HKLRD 890 at paragraph 35, the assessment of honest concurrent use under section 13(1)(a) of the Ordinance involves the following two-stage determination:

- (1) whether there has been an honest concurrent use of the subject mark and the earlier trade mark;
- (2) if the answer to (1) is in the affirmative, whether after considering all relevant circumstances, including public interest, the Registrar’s discretion should be exercised to accept the application for registration of the mark, despite the fact that the use of the mark in relation to the goods or services in question is likely to cause confusion on the part of the public.

47. Oeda’s Declaration filed in support of honest concurrent use includes 4 exhibits i.e. from “Exhibit A” to “Exhibit D”, the contents of which are summarized as follows:

- Exhibit A – Copy of printouts downloaded from the applicant’s website, printed matter issued by the applicant and photo and package drawing of a mark relating to flour products
- Exhibit B – Copy of export permits of various dates (from 1991 to 1994)
- Exhibit C – Copy of export permits of various dates (from 2001 to 2012)
- Exhibit D<sup>3</sup> – Copy of export permits of various dates (from 2006 to 2011)

48. It is noted that Oeda’s Declaration was made in Tokyo, Japan. According to the Notarial Certificate attached to Oeda’s Declaration, a notary named Kotaro Nagashima (the “Notary”) certified that it was one Chiyo Ishikawa (an attorney-in-fact of the declarant i.e. Hiroshi Oeda) who appeared before the Notary stating that Hiroshi Oeda acknowledged to have signed the declaration for and on behalf of the applicant. There is no indication that Hiroshi Oeda, made his declaration *before* the Notary. Pursuant to Rule 80(1)(b) of the Rules, with regard to a statutory declaration or affidavit made outside Hong Kong, it may be made and subscribed before any court, judge, justice of the peace, notary, notary public, consul or other person authorized by law to administer an oath or to exercise notarial functions in that place for the purpose

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<sup>3</sup> The pages in Exhibit D are a complete duplicate of the 19<sup>th</sup> to 39<sup>th</sup> pages of Exhibit C.

of any legal proceeding. Since Oeda's Declaration was neither made nor subscribed by the declarant before the Notary, the requirement of rule 80(1)(b) of the Rules has not been satisfied.

49. Moreover, the documents in Exhibits A, B, C and D are in Japanese. Pursuant to rule 120(1) of the Rules, where any document or part of a document that is not in one of the official languages is filed with the Registrar, the document shall be accompanied by a translation of the document or that part of the document into the language of the proceedings and such translation must be verified to the satisfaction of the Registrar as corresponding to the original text. Given that no English translation has been provided, the requirement under rule 120 has not been complied with. The observation of non-conformity with rules 80(1)(b) and 120 of the Rules was communicated to the Agent in the Registrar's letter of 31 May 2016 during the examination stage. Despite that, no remedial measures were taken by the Agent or the applicant on or before the scheduled date of hearing on 18 May 2017.
50. Notwithstanding the non-compliance with the Rules, for the purpose of this decision, I will go through Oeda's Declaration as well as the exhibits to examine whether there could be a case of honest concurrent use of the Subject Mark at the date of filing of the subject application, i.e. 16 March 2011, if only all the requirements in respect of the evidence have been duly observed.
51. To pass the first stage stated in *Re CSS Jewellery Co. Ltd.*, the applicant needs to establish three matters, namely, (a) there had been use of the Subject Mark in respect of the applied for goods in Hong Kong; (b) such use had been made concurrently with the Cited Marks; and (c) such concurrent use had been honestly made.
52. As the Accepted Goods have been allowed for registration on a *prima facie* basis, my observations on the evidence relate to the Objected Goods only.
53. First of all, it is noted that the 7<sup>th</sup> to 8<sup>th</sup> pages of Exhibit A, and the 3<sup>rd</sup> and 14<sup>th</sup> pages of Exhibit C are undated. The 35<sup>th</sup> to 42<sup>nd</sup> pages of Exhibit C and the 17<sup>th</sup> to 21<sup>st</sup> pages of Exhibit D (showing copies of the export permits) are dated posterior to the date of the subject application. These documents are irrelevant in ascertaining the status of use of the Subject Mark as at the date of application.
54. According to Mr. Oeda, the president of the applicant, the mark “ 日清製粉 ” (the “older mark”) (*not* the Subject Mark) was first used in Hong Kong in relation to flour products including but not limited to the goods ‘Wheat Flour for food; Flour for food’

(the “said goods”) at the latest in 1991 (paragraph 6 of Oeda’s Declaration). The Subject Mark was created in 2001 to replace the older mark and had since been used continuously in relation to the said goods in Hong Kong and Japan (paragraph 7 of Oeda’s Declaration).

55. Exhibit A consists of a copy of printouts downloaded from the applicant’s website and printed matter issued by the applicant. The contents are in Japanese. No use of the Subject Mark as a trade mark for any of the Objected Goods can be found in these documents. The photo and package drawing purported to show the Subject Mark are undated.
56. The applicant produced in Exhibits B, C and D copies of export permits stated to be issued from the applicant’s distributor Kanematsu Corporation during different periods of time. The export permits were in Japanese with certain information appearing in English. Such information includes, for example, the name of the product, date, address, weight of goods. A number of names such as “WHEAT FLOUR “FLOWER” BRAND”, “WHEAT FLOUR “MIGHTY” BRAND”, “WHEAT FLOUR “KK” BRAND”, “WHEAT FLOUR “KIN SUZURAN” BRAND”, “WHEAT FLOUR “FIRST” BRAND” (Exhibit B), “-SUPER KING-“ “-CAMELLIA”, “LYS DOR”, “VIOLET” (Exhibits C and D), which resemble brand names, appear on the export permits but the Subject Mark is nowhere to be found. Moreover, the product names on the export permits are predominantly ‘wheat flour’ and on a few instances “premix flour” or “cake muffin mix”. None relates to the Objected Goods. Despite Mr. Oeda’s claim that Exhibits B, C and D contain the export details of the said goods bearing the older mark or the Subject Mark (paragraphs 6, 7 and 8 of Oeda’s Declaration), no use of the Subject Mark (or the older mark) as a trade mark for any of the Objected Goods has been shown on the exhibits. These documents are not able to illustrate use of the Subject Mark as a trade mark in respect of the Objected Goods in Hong Kong. In any event, an export permit by itself is not sufficient proof that the Objected Goods were sold in Hong Kong.
57. Under paragraphs 8 and 9 of Oeda’s Declaration, it was claimed that the annual sales figures of the said goods sold under the Subject Mark in Hong Kong since 2006 ranged from US\$124,300 in 2006 to US\$192,844 in 2011 and the amount of flour products under the Subject Mark exported to Hong Kong was 1,914 tons from 2006 to June 2012. According to paragraph 10 of Oeda’s Declaration, the said goods have been widely and extensively sold by Kanematsu (Hong Kong) Ltd., which is a branch of Kanematsu Corporation. It is noted, however, that the alleged sales figures was not supported by any invoice or other documentary proof for the relevant period. Moreover, as there is no breakdown of the sales figures of the individual items of said goods involved, it is unclear as to whether the alleged sales of goods in fact relate to

any of the Objected Goods. No promotional expenses spent in respect of the Subject Mark on the Objected Goods in Hong Kong was produced. Nor was there any sample of advertisement or promotional material filed to show use of the Subject Mark in Hong Kong.

58. In sum, there is no evidence before me to show that the applicant had in fact used the Subject Mark on the Objected Goods in Hong Kong on or before the date of application. Since the use of the Subject Mark has not been established, the answer to stage (1) of the two-stage determination must be in the negative and it is not necessary for me to consider the other two aspects of concurrent use and honesty of the concurrent use in the first stage inquiry. It follows that even if Oeda's Declaration was duly made in accordance with rule 80 of the Rules, the applicant's reliance on establishing a case of honest concurrent use of the Subject Mark and the Cited Marks under section 13(1)(a) of the Ordinance in relation to the Objected Goods would still fail.

#### **Section 13(1)(b) of the Ordinance**

59. Pursuant to section 13(1)(b) of the Ordinance, registration of a trade mark should not be prevented under section 12 of the Ordinance if, by reason of other special circumstances, it is proper for the trade mark to be registered. On the evidence before me, I do not see any special circumstances which would warrant registration of the Subject Mark in respect of the Objected Goods. Accordingly, I do not allow the Subject Mark to be registered in respect of the Objected Goods in accordance with section 13(1)(b) of the Ordinance.

#### **CONCLUSION**

60. I have carefully considered all the submissions and evidence filed in respect of the subject application. For the reasons stated above, the Subject Mark is precluded from registration under section 12(3) of the Ordinance in respect of the Objected Goods under Class 30. The subject application is accordingly refused in respect of the Objected Goods under section 42(4)(b) of the Ordinance.
61. As I find that registration of the Subject Mark can be accepted in respect of the Accepted Goods as indicated in paragraph 9 above, the subject application in respect of such goods can proceed to publication, provided that the applicant files, on or before **25 September 2017**, a Form T5A to restrict the specification by deleting the Objected Goods. If the applicant fails to do so on or before **25 September 2017**, it

will be deemed to have abandoned the subject application.

Winnie WH NG  
for Registrar of Trade Marks  
25 August 2017

**Specification of the applied for goods under Class 30**

Frozen doughnuts; Frozen apple pies; Frozen pancakes; Frozen Taiyaki (Japanese-style cake filled with sweet bean paste); Frozen Imagawayaki (Japanese-style cake filled with sweet bean paste); Confectionery, bread and buns; Seasonings; Ice cream mixes; Sherbet mixes; Spaghetti, cooked; Spaghetti, uncooked; Macaroni, cooked; Macaroni, uncooked; Pastas; Bread crumbs; Cereal preparations, namely processed cereals; Prepared meals or food consisting primarily of cereal preparations; Frozen cooked omelets containing fried rice; Frozen cooked Chuukadon (bowl of rice topped with stir-fried vegetables, meat and seafood); Frozen pre-prepared rice; Frozen pre-prepared pastas; Cooked Soba noodles (Japanese buckwheat noodles); Cooked Yakisoba (pan-fried noodles); Frozen cooked Udon noodles (Japanese thick noodles of wheat); Frozen cooked risotto; Frozen cooked lasagne; Frozen cooked gratin; Frozen cooked Chinese rice noodles; Frozen cooked Chizimi (Korean savory pancakes with vegetables); Frozen cooked Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood); Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood); Frozen cooked Takoyaki (fried balls of batter mix with small pieces of octopus); Fried balls of batter mix with small pieces of octopus (Takoyaki); Frozen cooked spring rolls; Chinese stuffed dumpling (Gyoza); Sandwiches; Chinese steamed dumpling (shumai); sushi; Steamed buns stuffed with minced meat (Niku-manjuh); hamburger; Frozen cooked pizzas; pizzas; Frozen Prepared box lunches (rice and/or pasta predominating) ; Prepared boxed lunches (rice and/or pasta predominating); Hot dog; Frozen cooked corn dogs; Meat pies; Ravioli; Yeast powder; Yeast; Baking powder; Instant confectionery mixes; Premix flour; Rice; Husked oats; Husked barley; Wheat Flour for food; Karaage powder (wheat flour mix for making Karaage (Japanese fried chicken)); Tempura powder (tempura batter mix, namely, batter mix for making tempura); Okonomiyaki powder (wheat flour mix for making Okonomiyaki (Japanese savory pancakes with chopped cabbage and meat or seafood)); Flour for food; Instant doughnuts mixes; Instant pancake mixes; Instant bread mixes; Baking powder; Kansui(food additive for making Chinese noodles more chewy in texture and yellow in colour); Yeast extract; Pasta sauces; Soba noodles (Japanese buckwheat noodles); Udon noodles (Japanese thick noodles of wheat); Pancakes; Almond paste; Chocolate paste; Sugar; glaze mix consisting primarily of powdered sugar.

**Cited Mark 1**

Trade mark no.: 199911609

Trade mark:



Class(es) no(s):: 30

Specification(s):

Class 30

coffee, tea, cocoa, seasonings, salt, mustard, sauces (except dressing), spices, retort pouch-packed rice porridge, red beans with lotus seed dessert, assorted beans dessert, Chinese rice noodles, noodles, instant noodles and processed rice, corn flakes; all included in Class 30.

Date of registration: 2 April 1997

**Cited Mark 2**

Trade mark no.: 200003423

Trade mark:



Class(es) no(s):: 30

Specification(s):

Class 30

noodles, instant noodles.

Date of registration: 5 October 1995

**Cited Mark 3**

Trade mark no.: 200111680

Trade mark:



Class(es) no(s):: 29

Specification(s):

Class No. 29

soup bases, instant cooking soups; pre-cooked foodstuffs; all included in Class 29.

Date of registration: 23 January 2001

#### **Cited Mark 4**

Trade mark no.:

300033399

Trade mark:



Class(es) no(s).:

30

Specification(s):

Class 30

coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; aromatic preparations for food; condiments; seasonings; essences for foodstuffs (except etheric essences and essential oils); farinaceous foods; noodles; pasta; instant noodles; deep frozen noodles; chilled noodles; dried noodles; and prepared meals containing (principally) noodles; all included in Class 30.

Date of registration:

16 June 2003

#### **Cited Mark 5**

Trade mark no.:

300074295

Trade mark:

日清美味寶

Class(es) no(s).:

29, 30

Specification(s):

Class 29

pre-cooked foodstuffs in this class packed in retort pouch; soup bases, instant cooking soups; retort pouch-packed soup; retort pouch-packed curry; pre-cooked foodstuffs; all included in Class 29.

Class 30

pre-cooked foodstuffs in this class packed in retort pouch; almond cordial with fungus dessert; green beans with kelp dessert; cha cha dessert; sago with coconut milk dessert; red beans with lotus seeds dessert; assorted beans dessert; retort pouch-packed rice porridge; coffee; tea; cocoa; sugar; rice; tapioca; sago; artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery; ices; honey; treacle; yeast; baking powder; salt; mustard; vinegar; sauces (condiments); spices; ice; aromatic preparations for food; condiments; seasonings; essences for foodstuffs [except etheric essences and essential oils]; farinaceous foods; noodles; pasta; instant noodles; deep frozen noodles; chilled noodles; dried noodles; and prepared meals containing [principally] noodles; all included in Class 30.

Date of registration:

5 September 2003

### **Cited Mark 6**

Trade mark no.:

300264014

Trade mark:



Class(es) no(s).:

29

Specification(s):

Class 29

meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; soups; preparations for making soups; broth; broth concentrates; bouillon; bouillon concentrates; instant soups; noodle soups; instant noodle soups; dry mixes for soups; noodle soups consisting primarily of dried noodles and soup mixes sold in a disposable container; prepared and preserved ingredients for use with soups; edible seaweed; processed and preserved meat products; and processed and preserved sea foods; all included in Class 29.

Date of registration:

6 August 2004

### **Cited Mark 7**

Trade mark no.:

300302589

Trade mark:

日清奧利友

Class(es) no(s).:

29, 30

Specification(s):

Class 29

edible fats, edible oils, milk products.

Class 30

mayonnaise, dressing (condiments).

Date of registration:

15 October 2004

### **Cited Mark 8**

Trade mark no.:

300617319

Trade mark:



Class(es) no(s).:

30

Specification(s):

Class 30

coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee;

flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; aromatic preparations for food; condiments; seasonings; essences for foodstuffs [except etheric essences and essential oils]; farinaceous foods; noodles; pasta; instant noodles; deep frozen noodles; chilled noodles; dried noodles; and prepared meals containing [principally] noodles.

Date of registration: 11 April 2006

**Cited Mark 9**

Trade mark no.: 301061775

Trade mark:



Class(es) no(s):: 29, 30

Specification(s):

Class 29

Instant noodle soup; instant bean-starch noodle soup

Class 30

Instant noodles; instant bean-starch noodles; and condiments

Date of registration: 28 February 2008

**Cited Mark 10**

Trade mark no.: 301094139

Trade mark:



Class(es) no(s):: 29, 30

Specification(s):

Class 29

Instant noodle soup; instant bean-starch noodle soup

Class 30

Instant noodles; instant bean-starch noodles; and condiments

Date of registration: 15 April 2008

**Cited Mark 11**

Trade mark no.: 301189828

Trade Mark:



Class(es) no(s):  
Specification(s):

30  
Class 30  
Noodles, instant cooking noodles.

Date of registration:

27 August 2008

**Cited Mark 12**

Trade mark no.:  
Trade mark:

301710549



Class(es) no(s):  
Specification(s):

30  
Class 30  
Noodles; instant noodles.

Date of registration:

8 September 2010