

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 301889786

MARK :



CLASS : 11

APPLICANT : HONGKONG EVERBRIGHT SCIENCE & TECHNOLOGY CO., LIMITED

OPPONENT : CHINA EVERBRIGHT GROUP LTD.

STATEMENT OF REASONS FOR DECISION

Background

1. On 14 April 2011 (“Application Date”), HONGKONG EVERBRIGHT SCIENCE & TECHNOLOGY CO., LIMITED (“Applicant”) filed an application (“subject application”) under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for registration of the following mark (“subject mark”):



After an authorized amendment of the subject application,¹ registration is sought in respect of the following goods (“subject goods”):

Class 11

Light bulbs (electric), light bulbs for directional signals for vehicles

¹ On 19 March 2012, the Applicant filed a request on Form T5A to amend the subject application by deleting the Class 9 goods covered by the subject application. Particulars of the proposed amendment were published on 13 April 2012. As no notice of objection was filed under rule 26 of the Trade Marks Rules (Cap. 559A) during the prescribed period, the request to amend the subject application was accepted on 27 July 2012.

2. Particulars of the subject application were published on 9 September 2011. CHINA EVERBRIGHT GROUP LTD. (“Opponent”) filed a notice of opposition on 1 December 2011 (“Notice of Opposition”) with grounds of opposition. With leave from the Registrar, the Opponent filed amended grounds of opposition on 23 December 2011 (“Amended Grounds of Opposition”). The Applicant filed a counter-statement on 19 March 2012 (“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 Yang Xiaobin, Company Secretary of China Everbright Holdings Company Limited (“CEH”) made on 14 September 2012 (“Yang’s 1st Declaration”);
- (b) a statutory declaration of Kathleen Jane Humphreys, a Director of Intellect Consultancy Limited, a private investigator firm, made on 4 October 2012 (“Humphreys’ Declaration”); and
- (c) a second statutory declaration of Yang Xiaobin made on 4 October 2013 (“Yang’s 2nd Declaration”).

4. The Applicant’s evidence consists of a statutory declaration of Ke Xiaoling, CEO of the Applicant, made on 26 April 2013 (“Ke’s Declaration”).

5. The opposition hearing was originally scheduled to take place on 16 December 2014. As the Applicant filed the subject application in English, the language of the proceedings for the subject opposition proceedings is English.² Having regard, *inter alia*, to the level of proficiency in oral English of Ms Ke Xiaoling of the Applicant who appeared at the hearing, the hearing was adjourned to 18 March 2015, and the Applicant was directed, *inter alia*, to arrange for an interpreter conversant in both Putonghua and English to provide interpretation at the resumed hearing on 18 March 2015.³

² Section 76(1) of the Ordinance provides that, “*Except as otherwise provided in the [Trade Marks Rules (Cap. 559A)], and notwithstanding section 5 of the Official Languages Ordinance (Cap 5), the official language in which an application for registration of a trade mark is filed shall be used as the language of the proceedings in all proceedings before the Registrar under this Ordinance.*”

³ Rule 78 of the Trade Marks Rules (Cap. 559A) provides that:

“(1) Any party in a hearing before the Registrar, or any witness or expert called to give evidence by such party, may use a language other than the language of the proceedings on condition that, at least 10 days before the date fixed for the hearing, the party gives to the Registrar and to the other parties written notice of his intention to use, or to call a witness or expert who intends to use, a language other than the language of the proceedings.

6. At the hearing on 18 March 2015, Ms Barbara Tsang of Messrs Li & Partners appeared for the Opponent, whilst Ms Ke Xiaoling appeared for the Applicant with her interpreter Mr. Tsang Fan Chun. Mr. Chris Yip and Miss Jessica Yu from the Official Languages Division of the Civil Service Bureau assisted the Registrar by providing interpretation from English into Putonghua and from Putonghua into English respectively at the hearing.

Grounds

7. Although a number of grounds were pleaded in the Amended Grounds of Opposition, at the hearing, the Opponent only relied on the grounds under the following sections of the Ordinance:⁴

- (a) section 11(5)(b);
- (b) section 12(3); and
- (c) section 12(5)(a).

Relevant date

8. The relevant date for considering this opposition is the Application Date, i.e. 14 April 2011.

The Opponent

9. The Opponent is a state-owned enterprise organized and existing under the laws of the People's Republic of China. It was founded in 1990.⁵ The Opponent is the registered owner of the Hong Kong registered trade marks listed in **Schedule 1** (the "Opponent's Marks").⁶

10. The Opponent authorizes CEH to be the exclusive licensee to use, with the right to sub-licence others to use, *inter alia*, the Opponent's Marks in Hong Kong.⁷

(2) *The Registrar may require a party who gives notice under subrule (1) to make provision for interpretation into the language of the proceedings and may give directions as to who should bear the costs of interpretation.*"

Rule 88(1) of the Trade Marks Rules (Cap. 559A) provides that:

"(1) The Registrar may, at the request of a party to any proceedings before him or on his own initiative, give a direction in relation to the procedure in those proceedings."

⁴ Amended Grounds of Opposition, paras 6 to 11.

⁵ Yang's 1st Declaration, para. 3.

⁶ Yang's 1st Declaration, para. 6.

⁷ Yang's 1st Declaration, para. 3.

CEH was incorporated in Hong Kong and has established its business in Hong Kong since 1983. Yang's 1st Declaration and Yang's 2nd Declaration were made by Yang Xiaobin, Company Secretary of CEH.⁸ The Opponent and CEH are collectively referred to in Yang's 1st Declaration as the "China Everbright Group", and shall likewise be so referred to below.

11. According to paragraph 4 of Yang's 1st Declaration, the China Everbright Group has used, among others, "EVERBRIGHT" as its trading name, which is the English equivalent of the dominant element "光大" in its Chinese name. In Hong Kong, CEH has authorized or otherwise sub-licensed, *inter alia*, the following companies to use the Opponent's Marks:

- (a) China Everbright Limited (中國光大控股有限公司)(Stock Code: 00165) ("CEL"), a company established in 1972 which provides in Hong Kong and Mainland China financial services such as direct investment, asset management and asset investment, whilst developing fee-based businesses including investment banking (corporate financing) and brokerage services (wealth management);
- (b) China Everbright International Limited (中國光大國際有限公司)(Stock Code: 00257) ("CEIL"), a company established in 1961 which focuses on green environmental protection and alternative energy.

12. Both CEL and CEIL (collectively, the "Opponent's HK Listed Companies") are listed on The Stock Exchange of Hong Kong Limited. The estimated average business turnover of the Opponent's HK Listed Companies for the years 2007 to 2010 exceeded HK\$5.7 billion per annum,⁹ which was substantial.

13. According to a publication of CEL,¹⁰ as at 30 June 2007, the total value of China Everbright Group's assets was RMB 700 billion. In Mainland China, the China Everbright Group held several financial institutions including China Everbright Bank, Everbright Securities Company Limited, Sun Life Everbright Insurance Company Limited, as well as non-financial institutions including China Everbright Investment Management Limited and Shanghai Everbright Convention & Exhibition Center Company Limited. As at 30 June 2007, China Everbright Bank had a network of 30

⁸ Yang's 1st Declaration, paras 1 & 3.

⁹ Yang's 1st Declaration, para.5.

¹⁰ Yang's 1st Declaration, Exhibit "YXB-2", p.11-28.

branches and 387 offices in 23 provinces and autonomous regions in China and a representative office in Hong Kong; whilst Everbright Securities Company Limited had a network of 77 sales offices and 14 securities service centres in 19 provinces and autonomous regions.

14. CEL was one of the companies awarded the "Outstanding China Enterprise Awards" by CAPITAL Magazine in 2008 and 2009. The awards were publicized in local Chinese newspapers such as Takungpao (大公報), Hong Kong Economic Times (香港經濟日報) and Ming Pao (明報), and the following mark of CEL appeared in the relevant newspaper advertisements:¹¹



The above mark was also used in a congratulatory advertisement dated 21 July 2008 for the third anniversary of Headline Daily (頭條日報).¹²

15. Exhibit "YXB-2" to Yang's 1st Declaration includes extracts of a prospectus dated 30 June 2010 in respect of the global offering of shares in Tian Shan Development (Holding) Limited. China Everbright Capital Limited¹³ was the Sponsor, and China Everbright Securities (HK) Limited was Sole Global Coordinator, Sole Bookrunner and Sole Lead Manager for the offering. The following marks appear on the front page of the prospectus:¹⁴



16. CEL was also one of the companies awarded the "Hong Kong Outstanding Enterprises" awards by the Economic Digest in 2007.¹⁵

17. CEIL is the environmental protection, infrastructure and property investment management vehicle of CEH. It focuses on green environmental protection and alternative energy businesses. CEIL has invested in various cities in Mainland China

¹¹ Yang's 1st Declaration, Exhibit "YXB-2", p. 256-261, 222-223.

¹² Yang's 1st Declaration, Exhibit "YXB-2", p.231.

¹³ According to an organization chart in a publication of CEL (Yang's 1st Declaration, Exhibit "YXB-2", p.22) China Everbright Capital Limited was a wholly-owned subsidiary of CEL.

¹⁴ Yang's 1st Declaration, Exhibit "YXB-2", p.140.

¹⁵ Yang's 1st Declaration, Exhibit "YXB-2", p. 248-251; advertised in Ming Pao on 12 Dec 2007 (Exhibit "YXB-2", p.252-253).

including Shenzhen, Beijing, Suzhou, Changzhou, Yixing, Jiangyin, Zhenjiang, Jinan, Qingdao, Zibo and Binzhou.¹⁶

18. CEIL was one of the companies awarded the “Hong Kong Outstanding Enterprises” awards by the Economic Digest in 2007,¹⁷ 2008,¹⁸ 2009¹⁹ and 2010²⁰ respectively. It was also one of the companies awarded the "Outstanding China Enterprise Awards" by the CAPITAL Magazine in 2008, and the following mark appeared at the relevant advertisements in Takungpao (大公報) and Hong Kong Economic Times (香港經濟日報):²¹



19. It is estimated that CEH and the Opponent's HK Listed Companies incurred an average of over HK\$1.7 million per annum during the period from January 2007 to March 2011 on advertising, marketing and promoting the Opponent's Marks and the relevant goods and services.²²

The Applicant

20. The Applicant was incorporated in Hong Kong on 5 September 2007. It is validly existing under the laws of Hong Kong.²³

21. In Ke's Declaration, it is claimed that the Applicant has been carrying on lighting business for many years, and has won "*critical acclaims from customers from domestic and overseas with honesty and trustworthiness as well as high-quality products*".²⁴ The Applicant's evidence, however, gives little information about the Applicant's business and how the Applicant has actually used the subject mark or other marks in business.

22. The Opponent has engaged Intellect Consultancy Limited, a private investigator firm, to conduct investigation regarding the Applicant and its use of the

¹⁶ Yang's 1st Declaration, Exhibit "YXB-2", p. 235.

¹⁷ Yang's 1st Declaration, Exhibit "YXB-2", p. 244-247; advertised in Ming Pao on 12 Dec 2007 (Exhibit "YXB-2", p.252-253).

¹⁸ Yang's 1st Declaration, Exhibit "YXB-2", p. 208-211.

¹⁹ Yang's 1st Declaration, Exhibit "YXB-2", p. 217-221.

²⁰ Yang's 1st Declaration, Exhibit "YXB-2", p. 212-216.

²¹ Yang's 1st Declaration, Exhibit "YXB-2", p.256-261.

²² Yang's 1st Declaration, para.7.

²³ Company name search made on 16 January 2013 at Exhibit "EBKXL-1" to Ke's Declaration.

²⁴ Ke's Declaration, para. 1.1.

subject mark. Exhibit "YXB-4" to Yang's 1st Declaration and Humphreys' Declaration contain findings of the investigation as well as results of further searches conducted on behalf of the Opponent after receiving the investigator's report. They reveal, *inter alia*, that:

- (a) According to a search of the Applicant's records at the Hong Kong Companies Registry, the address of the Applicant's registered office is the same as that of its corporate secretary, HONG KONG CHINAFLY SECRETARY SERVICE LIMITED. The sole director and shareholder of the Applicant is Ms KE Xiao Ling, a Chinese national with an address in Fujian Province.²⁵
- (b) The Applicant's website is at www.everbright-led.com; a domain name search regarding this website reveals, *inter alia*, the following information:²⁶

Domain Name	everbright-led.com
Creation Date	2007-09-11 13:10:24
Registration Date ...	2007-09-11 13:10:24
...	
Organisation Name	HONGKONG EVERBRIGHT SCIENCE TECHNOLOGY CO LTD
Organisation Address	Shenzhen 518019 GD CN
Admin Name	Ke xiaoling
Admin address	Shenzhen 518019 GD CN
Admin Email	hensel.hk@163.com
Admin Phone	+86.75525815171
Admin Fax	+86.75525815171

- (c) The following contact details of the Applicant can be found on its website:²⁷

²⁵ Humphreys' Declaration, para.5. & Exhibit "KJH-1".
²⁶ Humphreys' Declaration, para.9; Yang's 1st Declaration, Exhibit "YXB-5", p.1.
²⁷ Yang's 1st Declaration, Exhibit "YXB-5", p.4.

HongKong Everbright Science & Technology Co., Ltd.

HK Office: 1690-12A Nan Fung Tower, 173 Des Voeux Road C. SHEUNG WAN, Hong Kong.

Shenzhen Office: Rm 1002 U2, B Building Sun, Buxin Jindaotian Rd, Shenzhen city, China

Tel.:+86 755-25686471 25096445 Fax: +86 755-25686471

A visit made by an investigator on 29 June 2012 to the above "HK Office" at 1690-12A Nan Fung Tower revealed that the Applicant was not listed at the lobby directory of that tower, and that the whole of the 16th Floor of that tower was occupied by a law firm, Patrick Mak & Tse Solicitors.²⁸

- (d) The following mark and company name appear at the top of a page printed from the Applicant's website:²⁹



HONGKONG EVERBRIGHT SCIENCE & TECHNOLOGY CO.,LTD

- (e) Other pages printed from the Applicant's website³⁰ include photographs of the Applicant's products. The word "Everbright" appears on most of the photographs, which are reproduced below:



²⁸ Humphreys' Declaration, paras 13-14.

²⁹ Yang's 1st Declaration, Exhibit "YXB-5", p.3.

³⁰ Yang's 1st Declaration, Exhibit "YXB-5", p.6-15, 17-38.



POWER TOP LED

CERAMIC LED



EV-MP35

EV-MP30

EV-MP20

EV-MP50



EV-RC35



EV-SA55



EV-MP55



5500 Single color series

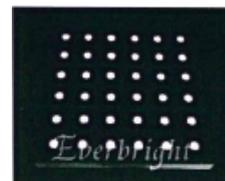
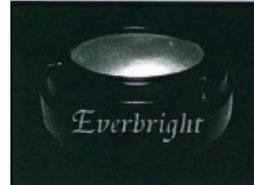
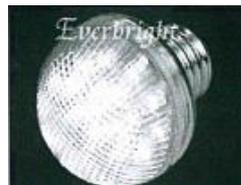
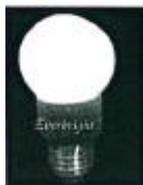
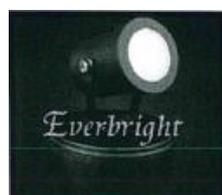
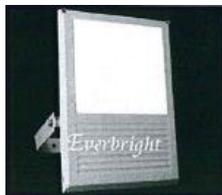
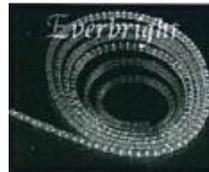


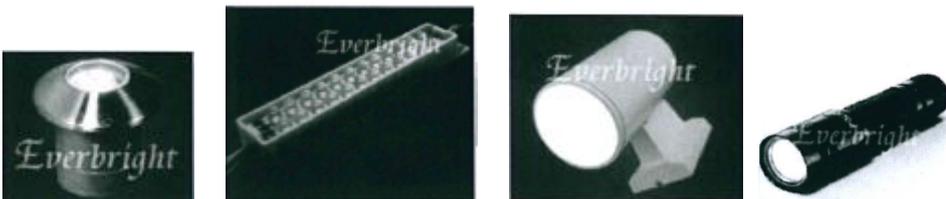
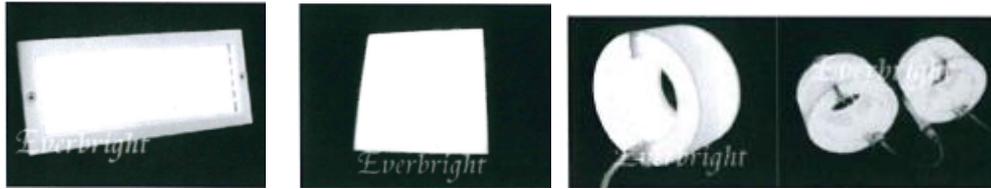
1208 Single color series

SIDEVIEW LED



EV-SW06







The subject mark in the form applied for, i.e.  does not appear on any of the pages printed from the Applicant's website appearing at Exhibit "YXB-5" to Yang's 1st Declaration. The Applicant also has not filed any evidence of actual use of the subject mark in these proceedings.

23. The Applicant also claimed that the word "Everbright" was not proprietary to the Opponent, and that the Opponent was not the first entity to apply for registration of marks containing the word "EVERBRIGHT". The Applicant gave the examples of two Hong Kong registered trade marks, namely Trade Mark Nos. 1991B3769 and 2002B01335, details of which are set out in **Schedule 2**.³¹

24. It is noted that the registration date of Trade Mark No. 2002B01335 is actually later than that of the Opponent's "CHINA EVERBRIGHT" marks. Moreover, the fact that a mark remains registered does not necessarily mean that it is actually in use. There is no evidence as to whether any of Trade Marks Nos 1991B3769 and 2002B01335 were in use and whether the Applicant had been aware of those two marks in the market before it filed the subject application.

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

25. 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.”*

26. The term “bad faith” is not defined in the Ordinance.

27. 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

³¹ Ke's Declaration, para. 4.1; Exhibit "EBKXL-3", p.2-5.

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.”

28. 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.”

29. Further, in *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person stated as follows:³²

“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.”

30. 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.³³

31. The Opponent claims that the subject mark contains the word "Everbright" which is closely similar to the Opponent's "CHINA EVERBRIGHT" marks; that the subject application was made by the Applicant with knowledge of the Opponent's reputation in its trade marks and was therefore made in bad faith.³⁴ The Opponent

³² Applied in *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG (LG Corporation)* HCMP 881/2013, [25]-[27].

³³ *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG (LG Corporation)* HCMP 881/2013, [31].

³⁴ Amended Grounds of Opposition, paras 7, 9.3.

believes that the Applicant, in the choice of the subject mark, is taking advantage of the Opponent's reputation and the Opponent's Marks.³⁵

32. The subject mark consists of the device " " and the text element „EverbrightLED“. As the word "Everbright" and the letters "LED" appear in different colours in the subject mark, the average consumer would naturally divide the text element into "Everbright" and "LED" when reading the mark. The subject goods consist of light bulbs. The letters "LED" (abbreviation for "light-emitting diode") are indistinctive of LED light bulbs. The device " " resembles a light bulb to a certain extent. Moreover, words speak louder than devices. The most distinctive element in the subject mark is the word "Everbright".

33. The Opponent's "CHINA EVERBRIGHT" marks each consists of the word "CHINA" and the word "EVERBRIGHT". The word "CHINA" is descriptive of goods from China or a company established in China. The most distinctive element in the "CHINA EVERBRIGHT" mark is the word "EVERBRIGHT". CEL and CEIL have also used marks containing the word "EVERBRIGHT" as a prominent element, such as those found in paragraphs 14 and 18 above.

34. The Opponent's sub-licensees are involved in a diversified scope of business, ranging from providing financial services to environmental protection, infrastructure and property management services.³⁶ The subject mark is applied for in relation to light bulbs. The subject mark contains the letters "LED". Light-emitting diodes (LEDs) are an energy-efficient alternative to traditional incandescent light bulbs and are an eco-friendly lighting choice.

35. The Applicant claims that the subject mark *"consists of phrases "Everbright" and "LED" intact, with difference in text font and graphic image with that of the Opponent"*.³⁷ The Applicant claims that the word "Everbright" in the subject mark is from the Chinese characters "洲际" in the Applicant's Chinese name "香港洲際科技有限公司", and that "EVERBRIGHTLED" in the subject mark is the "meaning extension" of "洲际".³⁸ I do not, however, see any connection between the word "Everbright" and

³⁵ Yang's 1st Declaration, para. 15.

³⁶ Paras 11 & 17 above.

³⁷ Counter-Statement, para.3; Ke's Declaration para. 1.3.

³⁸ Ke's Declaration, para. 1.2.

the Chinese characters “洲际”, whether in meaning or in pronunciation. I do not find the Applicant's claim that "Everbright" in the subject mark is from the Chinese characters "洲际" a satisfactory explanation of why the Applicant has decided to use the word "Everbright" in the subject mark.

36. The Applicant claimed that it was the first to apply for registration of a trade mark containing the word "Everbright" in Class 11,³⁹ and that the Applicant did not know the Opponent and had never heard of the Opponent's brand name "CHINA EVERBRIGHT" before the Opponent opposed the subject application.⁴⁰

37. Ms Tsang for the Opponent pointed out at the hearing that the Opponent was a China state-owned enterprise,⁴¹ the Applicant was carrying on business in Mainland China, and the sole director and shareholder of the Applicant was a Chinese national with an address in Mainland China.⁴² Ms Tsang submitted that the Applicant should have heard about the Opponent before filing the subject application. Ms Tsang also referred to an email from the Applicant dated 13 February 2012 ("2012 Feb Email").⁴³ The background to the 2012 Feb Email was that before the subject opposition proceedings were commenced, the Opponent had by a letter dated 15 November 2011 requested the Applicant to withdraw the subject application, and some exchange of correspondence between the Opponent and the Applicant ensued. The 2012 Feb Email was sent from the email address hensel.hk@163.com which was the email address of Ms Ke Xiaoling of the Applicant according to the domain name search referred to in paragraph 22(b) above. The 2012 Feb Email was addressed to Ms Barbara Tsang, who appeared for the Opponent at the hearing. Ms Tsang referred to the following sentence in the 2012 Feb Email:

「跟你客户那种大公司打官司的结果就是帮我们做免费广告。」 (**emphasis added**)

(To litigate with big companies like your client is free advertising for us.)

38. The 2012 Feb Email was referred to in paragraph 11 of, and exhibited at Exhibit "YXB-3" to, Yang's 1st Declaration filed on 14 September 2012. In response to the Applicant's claim in paragraph 2.1 of Ke's Declaration filed on 26 April 2013 that "[T]he Applicant did not know the Opponent, CHINA EVERBRIGHT GROUP LTD and

³⁹ Ke's Declaration, para. 1.4.

⁴⁰ Ke's Declaration, para. 2.1.

⁴¹ See para. 9 above.

⁴² See para. 23(a) above.

⁴³ Yang's 1st Declaration, Exhibit "YXB-3" p. 14.

never heard its brand name "CHINA EVERBRIGHT" before the Opponent opposes the Applicant's trademark", the Opponent pointed out in paragraph 6 of Yang's 2nd Declaration filed on 4 October 2013 that the 2012 Feb Email showed that the Applicant had actual knowledge of the Opponent.

39. At the hearing, Ms Ke for the Applicant denied that the 2012 Feb Email was from the Applicant. Ms Ke submitted that the 2012 Feb Email did not bear the Applicant's signature and should not be regarded as true. Ms Ke gave an example of a telephone call purporting to be from the police in Mainland China which turned out to be a fraud. Ms Ke submitted that whether a telephone call or an email, one must prove that it was really from the person by or from whom it was purported to be made or sent. Ms Ke submitted that as there was no signature on the email, and the Opponent had not proved who wrote it and at what place, who saw the writer wrote it and what clothing the writer was wearing at the time, the email could not be regarded as true.

40. Ms Tsang for the Opponent pointed out that fabrication of evidence was a very serious allegation, and queried why the Applicant had not objected to the 2012 Feb Email (or any other email messages exhibited at "YXB-3" to Yang's 1st Declaration) all this time since Yang's 1st Declaration was filed in September 2012 until the hearing on 18 March 2015. In response, Ms Ke stated that the Applicant had neither objected to nor acknowledged those email messages before the hearing, and she considered that the hearing was an opportunity to "clarify" on the evidence.

41. Where evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence (*Pan World Brands Ltd v Tripp Ltd (Extreme Trade Mark)* [2008] R.P.C. 2 at [36]).

42. In the present case, the 2012 Feb Email was stated to be from the email address of Ms Ke of the Applicant according to the domain name search referred to in paragraph 22(b) above. The contents of the email indicated that the writer was fully in the picture regarding the trade mark dispute between the parties. The 2012 Feb Email is not obviously incredible.

43. Although the Applicant filed its evidence in April 2013 after receiving Yang's

1st Declaration made on 14 September 2012 with the 2012 Feb Email, the Applicant had not in its evidence raised any query about the 2012 Feb Email, or indeed about any other email message found at Exhibit "YXB-3" to Yang's 1st Declaration. Even when the 2012 Feb Email was specifically referred to in Yang's 2nd Declaration filed on 4 October 2013 to refute the Applicant's claim that it did not know the Opponent and had never heard its brand name "CHINA EVERBRIGHT" before the Opponent opposed the Applicant's subject mark, the Applicant did not raise any query about the 2012 Feb Email, until Ms Ke for the Applicant raised the issue for the first time at the hearing on 18 March 2015. Any person seeing in the other side's evidence an email which purported to be from that person's company but in fact was not would naturally be very concerned. One would not expect such a person to remain quiet for more than two years.

44. The Applicant had not given advance notice that the 2012 Feb Email would be challenged. The Applicant had not sought to cross-examine the declarant of Yang's 1st Declaration, Yang Xiaobin. The Applicant had not adduced evidence to contradict the 2012 Feb Email despite having had ample opportunity to do so. Ms Ke did not give any evidence on oath at the hearing. Her claim that the 2012 Feb Email should not be regarded as true was only by way of submission. Her bare assertion that the 2012 Feb Email was not from the Applicant was not supported by any evidence. The example given by the Applicant concerning fraudulent telephone calls from someone purporting to be from the police in Mainland China had no bearing on the issue of whether the 2012 Feb Email was indeed from the Applicant. The Applicant's claim that the 2012 Feb Email could not be regarded as true without any signature on the 2012 Feb Email and without the Opponent proving who wrote it at what place, who saw the writer wrote it and what clothing the writer was wearing at the time, was an attempt by the Applicant to place before the Opponent an unsurmountable hurdle of proof which was without any legal basis. It was a desperate attempt on the part of the Applicant to undermine evidence unfavourable to its case.

45. In face of the serious allegation of bad faith, the Applicant has not given any reasonable explanation as to why the Applicant has chosen the word "Everbright" as the most prominent element in the subject mark. Although the Applicant claims that the word "Everbright" in the subject mark is from the Chinese characters "洲际" in the Applicant's Chinese name "香港洲際科技有限公司", there is no connection between the word "Everbright" and the Chinese characters "洲际", whether in meaning or in pronunciation. Moreover, the Applicant was using a mark consisting only of the word "Everbright" in almost every photograph of its products on its website (paragraph 22(e))

above). Despite the claim that the letters "LED" and the graphic image distinguished the subject mark from the Opponent's Marks,⁴⁴ the letters "LED" and the device "" were left out in the mark "Everbright" repeatedly found in the many photographs of products appearing on the Applicant's website. Even the mark at the top of the page on the Applicant's website was without the letters "LED" (paragraph 22(d) above). Ms Ke's mentioning at the hearing that the Applicant had not on its website used the subject mark in the form as applied for because the subject mark had not yet been registered as it was still under opposition begged the question of why then the Applicant chose to use

on its website the mark "Everbright" and the mark "" when neither of those marks had been registered or applied for.⁴⁵

46. Having considered the Opponent's evidence and the Applicant's evidence as a whole, there can be no doubt that at the time of the subject application, the Applicant was aware of the Opponent's reputation in its trade marks and that the choice of the word "Everbright" as the most prominent element in the subject mark was deliberate to take advantage of the Opponent's reputation.

47. Taking into account all the relevant circumstances of this case, I consider that the Applicant's decision to apply for registration of the subject mark would be regarded as in bad faith by persons adopting proper standards. I find that the subject application was made by the Applicant in bad faith within the meaning of section 11(5)(b) of the Ordinance. The ground of opposition under section 11(5)(b) of the Ordinance is made out.

48. As I have found in favour of the Opponent on the ground under section 11(5)(b) of the Ordinance, it is not necessary for me to consider the other grounds of opposition.

Costs

49. As the opposition has succeeded, I award the Opponent costs.

50. Subject to any representations, as to the amount of costs or calling for special

⁴⁴ See para. 35 above.

⁴⁵ According to the investigation report at Exhibit "YXB-4" to Yang's 1st Declaration, a search of the electronic register of trade marks kept by the Hong Kong Trade Marks Registry revealed that the subject application was the only trade mark application in Hong Kong filed by the Applicant.

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.

(Finnie Quek)
for Registrar of Trade Marks
10 June 2015

Schedule 1

Opponent's Hong Kong registered trade marks

<i>Trade Mark</i>	<i>Trade Mark No./ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
CHINA EVERBRIGHT	2002B11241AA Registration of this Trade Mark shall give no right to the exclusive use of the word "CHINA".	15 Sep 1999	<p><u>Class 4</u> industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks; all included in Class 4.</p> <p><u>Class 5</u> air purifying preparations, medicines for veterinary purposes, insecticides, sanitary napkins, materials for dental treatment; medicines for dental purposes; all included in Class 5.</p> <p><u>Class 36</u> insurance services; financial services; monetary transaction services; real estate agency services; all included in Class 36.</p> <p><u>Class 37</u> installation, maintenance and repair of computers, computer peripheral and parts, fax modems, computer keyboards, computer data storage drives and devices, CD-ROMs and CD-ROM drives, floppy disk drives, computer magnetic and optical data storage media, floppy disks, compact discs, magneto-optic disks, intercommunication apparatus, telecommunication apparatus and transmitters, telephone apparatus, telephone receivers and transmitters, mobile phones, pagers, fax machines, telephone wires and telephone cables; all included in Class 37.</p> <p><u>Class 38</u> telecommunications; included in Class 38.</p> <p><u>Class 39</u> arranging of tours; booking of seats for travel; escorting of travellers; freight services; freight forwarding; freighting services; transport of passengers; transport reservation; travel reservation; warehouse storage services; all included in Class 39.</p>

<i>Trade Mark</i>	<i>Trade Mark No./ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
			<p><u>Class 40</u> processing of oil; production of energy; all included in Class 40.</p> <p><u>Class 41</u> arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and workshops; booking of seats for shows; club entertainment services; health club services; music-hall services; organization of balls; organization of exhibitions for cultural or educational purposes; organization of shows, impresario services; organization of sports competitions; party planning; providing sports facilities and recreation facilities; rental of lighting apparatus for theatrical sets; rental of sports equipment; rental of stadium facilities; rental of tennis courts; all included in Class 41.</p> <p><u>Class 42</u> accommodation bureaux; accommodation reservations; analysis for oil-field exploitation; boarding house bookings; boarding house services; cafe services; cafeteria services; cocktail lounge services; recovery of computer data; leasing access time to a computer database; computer programming; computer rental; maintenance of computer software; computer software design; computer system analysis; consultancy in the field of computer software; hotel reservations; hotel services; leasing access time to a computer for the manipulation of data; lounge services; maintenance of computer software; massage; motel services; oil prospecting; oil-field exploitation; oil-field surveys; oil-well testing; providing facilities for exhibitions; providing hotel accommodation; rental of chairs, tables, table linen and glassware; rental of computer software; rental of meeting rooms; rental of temporary accommodations; restaurant services; self-service restaurant services; beauty salon and hairdressing salon services; updating of computer software; tourist home services; installation and maintenance</p>

<i>Trade Mark</i>	<i>Trade Mark No./ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
			of computer programs; installation and maintenance of computer software; installation and maintenance of computer memories; all included in Class 42.
CHINA EVERBRIGHT	2002B13645 Registration of this Trade Mark shall give no right to the exclusive use of the word "CHINA". It is a condition of registration that the Mark shall be used in relation only to goods made in China.	15 Sep 1999	<u>Class 9</u> telecommunication apparatus, telecommunication transmitters, telephone apparatus, telephone receivers, telephone transmitters, mobile phones, pagers, fax machines, telephone wires, telephone cables; all included in Class 9.
^a 中國光大 ^b 中国光大	200200154AA Registration under Section 26 as a series of Trade Marks. Registration of this Trade Mark shall give no right to the exclusive use of the Chinese characters "中國" /"中国". It is a condition of registration that the Mark shall be used in relation only to goods made in China.	15 Sep 1999	<u>Class 4</u> industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit); all included in Class 4. <u>Class 5</u> air purifying preparations, medicines for veterinary purposes, insecticides, sanitary napkins, materials for dental treatment; medicines for dental purposes; all included in Class 5. <u>Class 9</u> telecommunications apparatus, telecommunication transmitters, telephone apparatus, telephone receivers, telephone transmitters, mobile phones, pagers, facsimile transmission machines, telephone wires, telephone cables; all included in Class 9.
^a 中國光大 ^b 中国光大	200200155AA Registration under Section 26 as a series of Trade Marks.	15 Sep 1999	<u>Class 36</u> insurance services; financial services; monetary transaction services; real estate agency services; all included in Class 36. <u>Class 37</u> installation, maintenance and repair of

<i>Trade Mark</i>	<i>Trade Mark No./ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
	<p>Registration of this Trade Mark shall give no right to the exclusive use of the Chinese characters "中國" for mark "A" and "中国" for mark "B".</p>		<p>computers, computer peripheral and parts, fax modems, computer keyboards, computer data storage drives and devices, CD-ROMs and CD-ROM drives, floppy disk drives, computer magnetic and optical data storage media, floppy disks, compact discs, magneto-optic disks, intercommunication apparatus, telecommunication apparatus and transmitters, telephone apparatus, telephone receivers and transmitters, mobile phones, pagers, fax machines, telephone wires and telephone cables; all included in Class 37.</p> <p><u>Class 38</u> telecommunications; included in Class 38.</p> <p><u>Class 39</u> arranging of tours; booking of seats for travel; transport brokerage; arranging of cruises; escorting of travelers; freight (shipping of goods); freight brokerage; freight forwarding; freighting; passenger transport; rental of warehouses; reservation services for tours; sightseeing; storage of goods; tourist office services (travel); provision of tours; transport reservation services; travel reservation services; transport of travellers; warehousing; all included in Class 39.</p> <p><u>Class 40</u> processing of oil; production of energy; all included in Class 40.</p> <p><u>Class 41</u> arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums, workshops; booking of seats for shows for entertainment purposes; club services; health club services; music hall services; organization of balls; organization of exhibitions for cultural or educational purposes; organization of shows for entertainment purposes, impresario services; organization of sports competitions; party planning; providing sports facilities, recreation facilities; rental of lighting apparatus for theatrical sets; rental of tennis courts; arranging and</p>

<i>Trade Mark</i>	<i>Trade Mark No./ Disclaimer/ Limitation/ Condition</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
			<p>conducting of seminars; rental of sports equipment; rental of stadium facilities; arranging and conducting of workshops; all included in Class 41.</p> <p><u>Class 42</u> accommodation bureaux; temporary accommodation reservations; analysis for oil-field exploitation; boarding house bookings; boarding houses; cafes; cafeterias; cocktail lounge services; leasing access time to a computer data base; computer programming; computer systems analysis; consultancy in the field of computer software; hotel reservations; hotels; leasing access time to a computer for the manipulation of data; lounge services; maintenance of computer software; massage; motels; oil prospecting; oil-field surveys; oil-well testing; providing facilities for exhibitions; providing hotel accommodation; recovery of computer data; computer rental; rental of chairs, tables, table linen, glassware; rental of computer software; rental of meeting rooms; rental of temporary accommodations; restaurants; beauty salons; hairdressing salons; self-services restaurants; updating of computer software; computer software design; tourist homes; all included in Class 42.</p>

Schedule 2

Other Hong Kong registered trade marks with the element "EVERBRIGHT"

<i>Trade Mark</i>	<i>Trade Mark No.</i>	<i>Registered Owner</i>	<i>Registration Date</i>	<i>Specification of Goods</i>
	1991B3769	SINOCHEM CORPORATION (中國中化股份有限公司)	9 Sep 1987	<u>Class 2</u> pigments.
EVERBRIGHT	2002B01335	YKK KABUSHIKI KAISHA (YKK CORPORATION)	1 Mar 2001	<u>Class 26</u> slide fasteners, hook and loop fasteners for clothing, adjustable fasteners for clothing; buttons, snap buttons for clothing; stud buttons for clothing; buckles for clothing, hooks and eye fasteners; eyelets for clothing, eyelets for shoes, strap holders; ribbons, elastic ribbons, shoulder pads for clothing; braids; all included in Class 26.