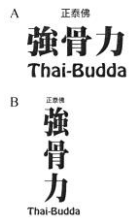


TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 302035485

MARKS :



CLASS :

5

APPLICANT :

WAH SING PHARMACEUTICAL LIMITED

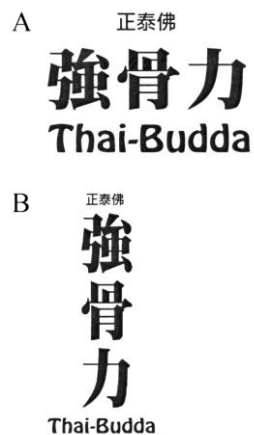
OPPONENT :

周榮亮以健臨藥業之名經營

STATEMENT OF REASONS FOR DECISION

Background

1. On 20 September 2011, the Applicant filed an application under the Trade Marks Ordinance (Cap.559) (“Ordinance”) for registration of a series of two marks shown below (“Subject Mark/s”):



in respect of the following goods (“Subject Goods”):

Class 5

Chinese medicinal capsule; pharmaceutical preparations and substances; nutritional and dietetic additives and substances adapted for medical use; Chinese patent medicines; Chinese medicinal plants; veterinary and sanitary preparations and substances; food for infants; plasters, materials for

dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; all included in Class 5.

2. Particulars of the application were published on 4 November 2011. On 18 November 2011, the Opponent filed a notice of opposition to the subject application (“Notice of Opposition”).¹ In response, the Applicant filed a counter statement (“Counter Statement”) on 21 February 2012.

3. The opposition was fixed to be heard on 17 February 2015. Neither the Opponent nor the Applicant has filed a notice of intention to appear at the hearing. Pursuant to rule 74(5) of the Trade Marks Rules (Cap.559A) (“Rules”), both parties are treated as not intending to appear at the hearing. I now proceed to decide the matter without a hearing pursuant to rule 75(b)(i) of the Rules.

Grounds of opposition

4. According to the Notice of Opposition, the Opponent is the owner of the following registered trade mark in Hong Kong (“Opponent’s Mark”):

Trade Mark	Registration No.	Date of Registration
	301445805	9 October 2009

¹ The Notice of Opposition filed on 18 November 2011 was in Chinese and did not comply with the language of proceedings under section 76(1) of the Ordinance. Pursuant to a direction made by the Registrar of Trade Marks on 23 November 2011, the Opponent filed an English translation of the Notice of Opposition on 6 December 2011 and served it on the Applicant on 7 December 2011. Thus, the time limit under rule 17 of the Rules only started to run as from 7 December 2011 and the Counter Statement filed by the Applicant on 21 February 2012 was considered to be timely filed.

5. The Opponent’s Mark is registered in respect of a spectrum of goods in Class 5 (“Opponent’s Goods”), the specification of which is set out in the **Appendix** of this decision. The registration of the Opponent’s Mark was granted by consent of the owner of the following earlier trade marks:

Trade Mark	Registration No.	Date of Registration
	300212868	12 May 2004
	300212895	12 May 2004

6. The Opponent claimed that the Subject Mark is similar to the Opponent’s Mark and there will be a likelihood of confusion between them. In other words, the ground of opposition relied on by the Opponent is section 12(3) of the Ordinance.

Counter statement

7. In the Counter Statement, the Applicant denied that the Subject Mark is similar to the Opponent’s Mark and the use of the Subject Mark will cause confusion to the public. The Applicant averred that “正泰佛” in the Subject Mark refers to the Buddha in Thailand but “泰國” in the Opponent’s Mark refers to Thailand which is the name of a country. Moreover, “強骨力” is a universal product name in the market so that the presence of such name in the marks will not cause confusion to the public.

The Opponent’s evidence

8. The Opponent’s evidence comprises a statutory declaration made by the Opponent himself on 9 July 2012 (“Chau Declaration”). However, apart from repeating his submissions in the Notice of Opposition and referring to the

other registered trade marks owned by him,² the Opponent did not make any factual assertions or enclose any exhibits in the Chau Declaration to support the opposition.

The Applicant's evidence

9. The Applicant's evidence comprises a statutory declaration made by Eric Hui, the Deputy General Manager of the Applicant, on 5 February 2013 ("Hui Declaration"). Likewise, the Applicant merely repeated his case as pleaded in the Counter Statement and did not assert any facts or enclose any exhibits in the Hui Declaration to support the application.

Opposition under section 12(3) of the Ordinance

10. Section 12(3) of the Ordinance states 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."

11. The term "earlier trade mark", as referred to in section 12(3), is defined in section 5 of the Ordinance as follows:

"5(1) In this Ordinance, "earlier trade mark", in relation to another trade mark, means –

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

(b)"

² The marks referred to by the Opponent are (1) "瑞士 將軍牌 強骨力 Under Licence by J.C.BAZZ" (Trade Mark No. 301626606), (2) "泰國 將軍牌 強骨力" (Trade Mark No. 301684369) and (3) "將軍牌 瑞士 強骨力" (Trade Mark No. 301824949).

12. As the Opponent's Mark has a date of application for registration earlier than that of the Subject Mark, it constitutes an "earlier trade mark" in relation to the Subject Mark for the purpose of section 12(3) of the Ordinance.

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

14. The basic principles regarding the assessment of similarity between marks and the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] RPC 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] FSR 19 and adopted by the Court of Appeal in Hong Kong in *Tsit Wing (Hong Kong) Co Ltd and Others v TWG Tea Co Pte Ltd* [2015]1 HKLRD 414. These principles are :

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

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

The average consumer

15. According to the above principles, the likelihood of confusion must be assessed through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably observant and circumspect. On the other hand, the level of attention that will be paid by the average consumer is likely to vary according to the category of goods or services in question.

16. The Subject Goods and the Opponent's Goods include a broad range of pharmaceutical, medicinal and sanitary products in Class 5 without restriction as to whether such goods are for specialist use by professional medical staff, available by prescription only, or available for purchase over the counter at retail outlets without the need for a prescription. Hence, the relevant consumers for these goods would include both medical professionals and the public at large. In view of the serious consequences that may ensue if a wrong pharmaceutical preparation is taken, with the degree of seriousness depending on the nature of the particular medication, the end users of pharmaceutical products will generally show a high degree of attentiveness even in relation to prescription medicines where the healthcare professional will make the purchasing decision (*Alcon v OHIM* [2007] ETMR 68; *Kerly's Law of Trade Marks and Trade Names (15th Edition)* at para.9-050). As such, I am of the view that the level of care and attention that can be expected from the average consumer of these goods will be higher than that of other daily merchandise.

Distinctiveness of the Opponent's Mark

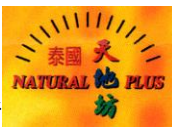
17. The more distinctive the earlier mark, the greater will be the likelihood of confusion (*Sabel BV v Puma AG* (supra)). I must therefore consider whether the Opponent's Mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

18. The Opponent's Mark is a composite mark that is made up of a number of textual and graphical elements. The largest word element is the Chinese characters “強骨力” at the right hand side of the mark. The character “強” means “strong, powerful” (as an adjective) or “to strengthen” (as a verb); “骨” means “bones”; and “力” means “strength, power” (*Lin Yu Tang's Chinese-English Dictionary of Modern Usage* (Online Version)). In relation to the pharmaceutical and medicinal products in question, the phrase “強骨力” as a whole is merely descriptive of the intended effect or characteristics of medicines which can strengthen the power of a person's bones or make the bones stronger and more robust, and is not inherently distinctive.

19. The Chinese characters “泰國” arranged horizontally above the characters “強骨力” are also indistinctive as they are likely to be perceived as an indication that the goods in question are produced in Thailand. “100 Capsules” at the top left corner of the mark refers to the quantity of pills or capsules of the

goods concerned and is not a distinctive element as well. For the English words “RMEUMAIESMAS INFLAMMATORY DISDIROERS” at the bottom left corner, from the context it may likely be perceived by consumers who knows English as the misspelt words for “RHEUMATIC INFLAMMATORY DISORDERS”³ and are likewise of little distinctiveness in relation to pharmaceutical products. For those consumers who don’t read English, those words in relatively small size and at marginal position would simply be ignored. The blurred image of a human skeleton (showing especially the ribs and the pelvis) at the background of the Opponent’s Mark is equally of low distinctiveness as it merely reinforces the idea of bones.



20. On the other hand, the logo “” appeared at the left side of the Opponent’s Mark, which consists of the Chinese characters “泰國” and “天地坊”,⁴ the English words “NATURAL PLUS” and a device in the shape of a rainbow, possesses a certain degree of distinctiveness as it has no obvious meaning in relation to the relevant goods and will be noticed by the average consumer for the purpose of identifying the trade origin of the goods.

21. I have not lost sight of the different colours that are applied in different parts of the Opponent’s Mark, but due to the fact that colours are not claimed by the Opponent as an element of the mark, they will not be taken into account in assessing the distinctiveness of the Opponent’s Mark.

22. Viewing it as a whole, I find the Opponent’s Mark to be inherently distinctive but the degree of distinctiveness is just moderate.

23. There is no evidence before me to show that the Opponent’s Mark has ever been used. Accordingly, I do not find that the distinctive character of the Opponent’s Mark has been enhanced by the use that has been made of it.

³ The term “RHEUMATIC INFLAMMATORY DISORDERS” generally refers to disorders that are caused by inflammation of the movement organs or supportive tissue surrounding these organs, in other words the bones, muscles and tendons
(<http://ki.se/en/research/facts-about-rheumatic-inflammatory-diseases>).

⁴ “天地” means the heaven and earth, or the world; and “坊” means a memorial arch or a street (*Lin Yu Tang’s Chinese- English Dictionary of Modern Usage* (Online Version))

Distinctiveness of the Subject Mark

24. I now turn to consider the distinctive character of the Subject Mark.

25. Each of the Subject Marks consists of the Chinese characters “正泰佛”, “強骨力” and the English characters “Thai-Budda”. The only difference between the two marks in the series is that the characters “強骨力” are presented horizontally in mark A and vertically in mark B. The characters “正泰佛” and “Thai-Budda” are arranged horizontally in each of the Subject Marks.

26. I will firstly deal with the Chinese characters “正泰佛” at the top of the Subject Mark. “正” means real; “泰” means Thai or Thailand; and “佛” means the Buddha (*Lin Yu Tang’s Chinese- English Dictionary of Modern Usage* (Online Version)). Putting these characters together, the phrase “正泰佛” as a whole carries the meaning of the real Buddha in Thailand.

27. Echoing the Chinese characters “正泰佛”, the English word “Thai-Budda” at the bottom of the Subject Mark will likely be seen as referring to the Thai Buddha, although Buddha is intentionally misspelt as “Budda”.⁵ The two elements, namely “正泰佛” and “Thai-Budda”, have some distinctiveness even though some may perceive the terms being tainted by certain geographical connotation of Thai or Thailand.

28. On the other hand, the Chinese characters “強骨力” in the middle of the mark will, as explained earlier, be regarded as a descriptive reference to the intended effect or characteristics of the relevant products which can strengthen the power of a person’s bones or make the bones stronger and more robust, and is therefore not distinctive in relation to the goods in question.

29. In other words, the distinctive parts of the Subject Mark lie in the words “正泰佛” and “Thai-Budda” rather than in “強骨力”, despite the fact that the latter is the more eye-catching component in the Subject Mark. The Subject Mark as a whole has certain inherent distinctiveness.

Comparison of marks


30. The visual, aural and conceptual similarities of the marks must be

⁵ The word “Budda” has no readily known meanings in most English dictionaries.

assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

31. Visually, the only similarity between the Subject Mark and the Opponent's Mark lies with the presence of the Chinese characters “強骨力” in the respective marks. However, as discussed above, the words “強骨力” is of nil distinctiveness and it will generally be neglected by the average consumer in the comparison of marks, especially in view of the presence of other legible and distinguishing features in the marks, such as “正泰佛” and “Thai-Budda” of the



Subject Mark and the logo “” of the Opponent's Mark. Viewing the Subject Mark and the Opponent's Mark as wholes, I find that the overall visual image created by each of the marks are rather different. In other words, they are visually dissimilar.

32. Aurally, given that “強骨力” is the prominent part of both marks, I accept that it is a convenient point of aural reference, even though as discussed so far the term is a descriptive term. More careful consumers would refer to other distinctive elements such as “正泰佛”, “Thai-Budda” or “天地坊” etc. besides mentioning “強骨力”. I consider the marks are moderately aurally similar.

33. In terms of conceptual comparison, I have analyzed the meaning of each of the components of the Subject Mark and the Opponent's Mark in the discussions above. The Subject Mark is conceptually similar to the Opponent's Mark only to the extent that both of them convey the ideas that the goods in question can make bones stronger and are originated from Thailand, but they are not similar insofar as their distinctive features (namely, “正泰佛 Thai-Budda” and “天地坊”) and other elements are concerned. Overall speaking, I find that the ideas presented by the each of the marks as a whole to be quite different. The Subject Mark is conceptually dissimilar to the Opponent's Mark.

34. Taking all the above factors into account, I consider that the Subject Mark and the Opponent's Mark are more dissimilar to each other than they are similar.

Comparison of goods

35. According to *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (supra)*, in assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary.

36. It was also held in *British Sugar v James Robertson and Sons Ltd* [1996] RPC 281 that the following factors should be taken into account when considering the similarities between the goods or services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

37. Moreover, goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, or vice versa (*Meric v OHIM* (Case T-133/05)).

38. Bearing these principles in mind, I consider that the Subject Goods set out in the left column below are identical or closely similar to those of the Opponent's Goods set out in the right column below:

The Subject Goods (Class 5)	The Opponent's Goods (Class 5)
Chinese medicinal capsule	中西草藥製成品；中西藥材及其製品；

	<p>人及動物用的醫藥品、藥物、藥劑、藥丸、藥丹、醫藥膠囊</p> <p>(Chinese and Western medicinal herbs and products; Chinese and Western herbal medicines and products; pharmaceuticals, drugs, pharmaceuticals preparations, medicinal pills, medicinal pellets, capsules for medicines, all for use by humans and animals)</p>
<p>pharmaceutical preparations and substances; nutritional and dietetic additives and substances adapted for medical use</p>	<p>醫用和獸醫用製劑；醫用營養品</p> <p>(pharmaceutical and veterinary preparations; dietetic substances adapted for medical use)</p>
<p>Chinese patent medicines; Chinese medicinal plants</p>	<p>中西草藥製成品；中西藥材及其製品</p> <p>(Chinese and Western medicinal herbs and products; Chinese and Western herbal medicines and products)</p>
<p>veterinary and sanitary preparations and substances</p>	<p>醫用和獸醫用製劑；醫用衛生製劑</p> <p>(pharmaceutical and veterinary preparations; sanitary preparations for medical purposes)</p>
<p>food for infants; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides</p>	<p>嬰兒食品；膏藥；繃敷材料；填塞牙孔和牙模用料；消毒劑；消滅有害動物製劑；殺真菌劑；除莠劑</p> <p>(food for babies; plasters; materials for dressing; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides)</p>

39. Hence, I find the two sets of goods under comparison to be identical

or highly similar.

Likelihood of confusion

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

41. I have compared the Subject Mark with the Opponent's Mark from the visual, aural and conceptual perspectives and come to the conclusion that the two marks are not similar in overall terms. The Opponent's Mark does not have a highly distinctive character and it has not been used by the Opponent. Moreover, in view of the nature of the goods in question and the risks involved, I have found that the average consumer will exercise a higher level of attentiveness in the selection of these products, and so should be more alert of the differences between marks. That being the case, despite the fact that the goods covered by the marks are identical or highly similar, I do not consider that there exists a likelihood of confusion in that the average consumer would be confused into believing that the respective goods offered under the Subject Mark and the Opponent's Mark come from the same or economically linked undertakings.

42. For the above reasons, the ground of opposition under section 12(3) of the Ordinance is not established.

Conclusion

43. As section 12(3) is the only ground of opposition relied on by the Opponent and the ground is not made out, the opposition fails.

(Ryan Ng)
p. Registrar of Trade Marks
7 August 2015

Appendix

Specification of the Opponent's Goods

類別 5

醫用和獸醫用製劑；醫用衛生製劑；醫用營養品；嬰兒食品；膏藥；繃敷材料；填塞牙孔和牙模用料；消毒劑；消滅有害動物製劑；殺真菌劑；除莠劑；中西式藥用營養食品及飲品；中西式藥用保健食品及飲品；中西草藥製成品；中西藥材及其製品；中西藥酒及其製品；生理及生化藥品；放射性藥物；醫療用品、食品、飲料及浸液；人及動物用的醫藥品、藥物、藥劑、藥膏、藥油、藥丸、藥丹、藥水、藥液、藥糖、藥粉、藥散、藥錠、藥茶、藥酒、醫藥膠囊、醫藥片劑、醫藥滴劑、醫藥貼劑、醫藥搽劑、醫藥栓劑、醫藥敷劑、醫藥針劑、醫藥凝膠、醫藥氣體；血液製品(醫用)；個人用調節生理藥品；戒煙藥品；乾製藥用菌；醫用營養補充品、魚油製品、枇杷露、卵磷脂製品、大豆異黃酮製品、蔘茸製品、靈芝破壁孢子製品、骨膠原製品、羊胎素製品、蘆薈製品、蟲草製品、維生素製品、維他命製品、王漿及其製品；減肥藥品及飲料(醫用)；降脂藥品及飲料(醫用)；排毒藥品及飲料(醫用)；非營養性的食用植物纖維；醫療用衛生輔助材料及用品；化妝品除外的個人及動物保健及衛生製劑；毛髮促生劑；催生劑；人用生物製劑、疫苗、抗生素、荷爾蒙；醫用注射胎盤素及葡萄糖；防蚊及驅蚊製劑；非人用除臭劑；漱口劑(藥用)；淨化製劑；除黴化學製劑；含藥性洗滌劑；醫療用浴泥、浴鹽；消毒及消炎用品、製劑、啫喱、紙巾、藥品、藥水；殺精子用品；殺微生物用品；殺菌及抗菌用品；殺蟲用品；殺蟻用品；殺鼠用品；殺蟑螂用品；農藥；消滅有害植物製劑；防蛀用品；氨基酸溶液；隱形眼鏡保存液、清潔液及片劑；漂白粉(消毒)；醫用牙用光潔劑；醫用無菌布及織物、通氣膠布、外科和矯形用黏固劑、潤滑軟膏、棉花、藥用酒精、紗布、膏布、繃帶、膠帶、縫合皮膚傷口用膠布、磁性穴道貼布；已裝藥急救箱；醫用保健袋；急救包；中藥袋及枕；失禁用衣、尿褲、尿片；月經衛生用品；女性衛生用品；懷孕診斷用化學劑；嬰兒奶粉；嬰兒用含乳麵粉；蛋白及白朮牛奶；哺乳用墊；以上貨品全包括在第五類。