

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 302126592

MARK :
A 司馬
B 司马

APPLICANT : SOLVIL ET TITUS S.A.

CLASS : 9

STATEMENT OF REASONS FOR DECISION

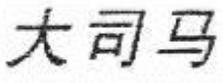
Background

1. On 29 December 2011, SOLVIL ET TITUS S.A. (“the Applicant”) filed an application for registration of the mark shown below (“the Subject Mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

A 司馬
B 司马

2. The Subject Mark is sought to be registered in respect of “Optical products, namely, spectacles, glasses, sunglasses, frames for eyeglasses and cases for the aforesaid goods; cases and pouches adapted for spectacles; parts and fittings for all the aforesaid goods; all included in Class 9” in Class 9.
3. At the examination stage, objection was raised against the subject application under section 12(3) of the Ordinance on the basis that the Subject Mark is considered similar to the following earlier registered trade mark (“the Cited Mark”) and that the goods applied for are considered similar to the goods of the Cited Mark. Details of the Cited Mark are as follows:-

Cited Mark

Trade Marks	:	
Registration Number.	:	301958220
Class	:	9
Specification	:	科學、航海、測地、電氣、攝影、光學、衡器、量具、信號、檢查、營救和教學用具及儀器，錄製、通訊、重放聲音和形象的器具，磁性數據載體，錄音盤，現金收入記錄機，計算機和數據處理裝置，滅火器械；以上所有貨品均包括在第九類。
Date of Registration	:	28 June 2011

4. On 20 December 2012, the Applicant proposed to amend the specification of the subject application to “Spectacles, glasses, sunglasses, frames for eyeglasses and cases for the aforesaid goods; cases and pouches adapted for spectacles; parts and fittings for all the aforesaid goods; all included in Class 9”. The proposed amendment had been considered by the Registrar who indicated that the objection would be maintained. Therefore, the proposed amendment was then not recorded.
5. In support of the subject application, the Applicant filed a statutory declaration dated 8 October 2013 made by Ms. Ho Yin Yee, who is the Brand Director of Optical 88 Limited (“Optical 88”), an affiliated company of the Applicant (the “SD”) with a view to establishing honest concurrent use of the Subject Mark and the Cited Mark for the purpose of section 13(1) of the Ordinance.
6. Despite the filing of the submissions and the evidence, the objection under section 12(3) was maintained. By letters dated 8 and 11 October 2013, the Applicant requested a hearing on the registrability of the Subject Mark.
7. On 9 July 2015, the Applicant filed an amended application in respect of the specification of the subject application in the manner as set out in paragraph 4 above. The specification of the goods of the subject application is now “Spectacles, glasses, sunglasses, frames for eyeglasses and cases for the aforesaid goods; cases and pouches adapted for spectacles; parts and fittings for all the aforesaid goods; all included in Class 9” (the “applied-for goods”).

8. The hearing took place before me on 10 July 2015, at which Ms. Peggy Cheung of Jones Day appeared on behalf of the Applicant. I reserved my decision at the end of the hearing.

The Ordinance

9. The objection is raised pursuant to section 12(3) of the Ordinance, which is as follows:-

“(3) 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.”

10. An “earlier trade mark”, as referred to in section 12(3) of the Ordinance, is defined in section 5 of the Ordinance, and the relevant part of the section 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...”

11. As the Cited Mark has a date of application for registration earlier than that of the Subject Mark, the Cited Mark constitutes an “earlier trade mark” in relation to the Subject Mark for the purpose of section 5 of the Ordinance.

12. Moreover, section 7(1) of the Ordinance throws light on how section 12(3)(c) is to be interpreted. It 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

13. 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 because it is sought to be registered in respect of goods and services the same as or similar to those registered under the earlier trade mark. I thus need to consider whether there are similarities between the Cited Mark and the Subject Mark and between the goods and/or services covered by those marks which would lead to 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] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (the “Canon” case) [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] F.S.R. 77, *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 19 and adopted by the Court of Appeal in *Tsit Wing (Hong Kong) Company Limited and Others v TWG Tea Company Pte Ltd* (CACV 191/2013) at paragraph 35. 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.

15. In accordance with the above principles, I shall examine whether there are similarities between firstly, the Subject Mark and the Cited Mark and secondly, the goods covered by the marks. I would then consider whether such similarities (if any) would be likely to lead to confusion by the public.

Decision

Comparison of marks

16. 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.

17. In comparing the marks concerned, I shall consider the perception of the marks in the mind of an average consumer of the goods in question. The applied-for goods are spectacles, glasses, sunglasses, frames for eyeglasses and cases for the aforesaid goods; cases and pouches adapted for spectacles; parts and fittings for all the aforesaid goods. Users of these goods are people who are with or without eyesight issues alike. The relevant consumers of these goods are therefore members of the general public in Hong Kong. They are deemed to be reasonably well informed, reasonably circumspect and observant but they cannot be expected to exercise more than an average level of care and attention in the purchase of such goods.
18. The Subject Mark consists of two pure word marks in series. Mark A is made up of two traditional Chinese characters “司馬” while Mark B the two same Chinese characters but with the second character being in the simplified form “司马”. Both marks are expressed in plain font and without any stylization. Since Chinese characters presented in the traditional form and in the simplified form are considered the same, Mark A and Mark B are the same mark and can be represented as marks in series.
19. The Cited Mark is likewise a pure word mark. It consists of three Chinese characters “大司马” where the third character is in the simplified form. The Cited Mark differs from the Subject Mark by the presence of the additional character “大” in front of “司马”. As pointed out at the examination stage, the Chinese character “大” means “big, large, great”. The character “大” is such a commonplace word that can be used in any context and description, it is therefore a very indistinctive character. As such “司马” is the dominant and distinctive element of the Cited Mark.
20. Visually, the Subject Mark and the Cited Mark share the same dominant and distinctive element, namely “司馬”. Although the Chinese character “大” in the Cited Mark cannot be totally disregarded, it is considered to be indistinctive as discussed above and thus does not assist in differentiating the marks. I consider the Subject Mark and the Cited Mark to be visually similar to a considerable extent.
21. Phonetically, the marks share the same Chinese characters “司馬”. As such, they have a certain degree of phonetic similarity to that extent. Although the Subject Mark is a mark of 2-syllables whereas the Cited Mark is a mark of 3-

syllables, since the Chinese character “大” in the Cited Mark is indistinctive, the relevant consumers will pay more attention to the distinctive element “司馬”. I consider the Subject Mark and the Cited Mark to be aurally similar to a moderate degree.

22. Conceptually, the shared dominant and distinctive element “司馬” has no dictionary meaning. Ms. Cheung explained at the hearing that the Subject Mark is adopted as the Chinese version of the Applicant’s mark “CYMA” because its pronunciation is almost identical to “CYMA”. Given that the character “大” in the Cited Mark is indistinctive, it does not have an impact on the overall impression of the Cited Mark. Thus, I find the marks to be conceptually similar.
23. Taking the above into account, the overall impressions created by the Subject Mark and the Cited Mark, and bearing in mind the perception of the average consumer and the imperfect recollection he / she has of the marks, I consider the similarities between the marks outweigh their dissimilarities. Therefore, I find the Subject Mark and the Cited Mark to be similar to a significant degree.

Comparison of goods

24. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (at pages 296-7), Mr. Justice Jacob (as he then was) set out the factors that should be taken into account when considering the similarities between goods and/or services. These factors are:-

- (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 service;
- (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.

25. It was also held in the Canon case, that in assessing the similarity of the goods or services concerned, all the relevant factors relating to the goods or services themselves should be taken into account, including, *inter alia*, their nature, their end users, their method of use and whether they are in competition with each other or are complementary.
26. Also, it is stated in *Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (T-133/05) at paragraph 29 that 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.
27. The goods of the Cited Mark and the applied-for goods are set out respectively in paragraphs 3 and 7 above. At the examination stage, it was pointed out to the Applicant that the applied-for goods were similar to “光學用具” of the Cited Mark. At the hearing, Ms. Cheung submitted that the specification of the goods of the Cited Mark was in fact the entire Class 9 heading of the Nice Classification in Chinese, which encompasses, *inter alia*, “光學用具及儀器”, the corresponding item of which in English should be “optical apparatus and instruments”.
28. I do not agree with Ms. Cheung’s submissions. In interpreting specification of goods and services, terms are to be given their ordinary and natural meaning (*Ofrex v Rapesco* [1963] R.P.C. 169). Therefore, albeit the specification of the goods of the Cited Mark being given in Chinese, I do not find it necessary to first determine its corresponding English translation under the Nice Classification before we may determine the ordinary and natural meaning of the term.
29. Moreover, it is established principle that the class headings of the Nice Classification are general indications of the goods or services covered under a class.¹ An application which specifies a class heading only claims protection in respect of the goods or services expressly stated, or that may be clearly encompassed by the heading.² In the present case, the applied-for goods are not expressly covered under the specification of the Cited Mark. The issue to determine is whether the applied-for goods may be clearly encompassed by the item “光學用具及儀器”.

¹ *Daimler AG v Sany Group Co Ltd* [2009] E.T.M.R. 58

² *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* [2013] R.P.C. 20

30. As pointed out to the Applicant during the examination stage, “光學” means “optics, optical” and “optical” means “of or relating to vision”, “用具” refers to “tools and implements; appliance” whereas “implement” means “something used to achieve a purpose”. Therefore, the term “光學用具” as a whole refers to anything for use relating to vision which, in my view, is broad enough to cover “spectacles, glasses, sunglasses and frames for eyeglasses” (the “Eyewear Goods”).
31. Taking the Applicant’s case to the highest, even if the term “光學用具及儀器” is considered to be equivalent to “optical apparatus and instruments”, the issue to determine is whether the applied-for goods are indeed covered by “optical apparatus and instruments”. On this, Ms. Cheung submitted that the item “optical apparatus and instruments” does not cover the applied-for goods because “apparatus” means “a machine having a specific function” and “instruments” means “a mechanical tool or implement”. The item “optical apparatus and instruments” referred to bulky items such as machines and mechanical tools, whereas the applied-for goods are small items and are not mechanical in nature.
32. I do not find Ms. Cheung’s argument convincing. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.³ The meaning of “optical apparatus and instruments” is broad and thus should not be restricted to cover optical machines, mechanical tools or optical goods which are mechanical in nature only. It should cover optical goods which are not bulky and non-mechanical in nature. Taking into account of the nature and characteristics of the Eyewear Goods, I am of the view that they are encompassed by the item “optical apparatus and instruments” and are considered as identical goods⁴.
33. As to the other applied-for goods “cases for the aforesaid goods; cases and pouches adapted for spectacles; parts and fittings for all the aforesaid goods” (the “Other Goods”), they are parts or accessories of the Eyewear Goods and are likely to be used by consumers of such products. The Other Goods will also be available in the same trade channels as the Eyewear Goods and they are complementary to the Eyewear Goods. It is also not uncommon for manufacturers of the Eyewear Goods to produce the Other Goods, for optical shops to sell the Other Goods or to provide repair services using the parts and fittings for the Eyewear Goods. Thus, I consider that the Other Goods are also

³ *Youview TV Ltd v Total Ltd* [2012] EWHC 3158

⁴ *Hoya Kabushiki Kaisha v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (T-9/05) [2008] E.T.M.R. 29

similar to “光學用具” in Class 9 of the Cited Mark as they are complementary to the Eyewear Goods.

Likelihood of confusion

34. Having concluded that the Subject Mark is similar to the Cited Mark and the applied-for goods are identical or similar to the item “光學用具” of the Cited Mark, I still have to consider whether there is a likelihood of confusion as referred to in section 12(3) of the Ordinance. Under section 12(3)(c), 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 of all relevant factors and judging through the eyes of the average consumer of the applied-for goods.
35. At the hearing, Ms. Cheung submitted that the relevant consumers of the applied-for goods such as the Eyewear Goods would exercise a higher level of care and attention in the purchasing process because they would have an eye examination for their lens prescription before they make their purchase.
36. I disagree. As discussed in paragraph 17 above, the relevant consumers of the applied-for goods are members of the general public. The applied-for goods are not necessarily restricted to expensive or highly specialised items. Although some of the applied-for goods such as spectacles or glasses may require prescription, they are goods used by members of the general public on a daily basis. Given the current advanced level of technology, I consider that the ease of obtaining a proper optical prescription could not be analogous to, for instance, getting a right size pair of jeans. It is therefore expected that the relevant consumers would merely exercise an average degree of care and attention in selecting the applied-for goods. I am also aware that an average consumer seldom compares marks side by side but will instead rely upon his imperfect recollection of marks.
37. Having noted the degree of similarity between the Subject Mark and the Cited Mark, I further note that the goods involved are similar. Bearing in mind the principles laid down in the cases discussed in paragraph 14 above and taking all relevant factors into account, I consider that when the Subject Mark is used in relation to the applied-for goods, the relevant consumers, with only his imperfect recollection to rely on, would be confused into believing that the applied-for goods originated from the same trade origin as those from the Cited Mark. There is a real likelihood of confusion of the origin of the applied-for goods if the Subject Mark is allowed to co-exist with the Cited Mark. In the premises, the

registration of the Subject Mark is objectionable in respect of the applied-for goods in Class 9 under section 12(3) of the Ordinance.

Honest Concurrent Use

38. I now proceed to consider whether the Subject Mark can, despite my finding above, 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

39. In *Re CSS Jewellery Co. Ltd.* [2010] 2 HKLRD 890 (“CSS”), it was held that 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 (“CSS Stage 1 test”); and
- (2) if the answer to the above 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 (“CSS Stage 2 test”).

40. The Applicant’s evidence for the purpose of establishing honest concurrent use comprises the statutory declaration of Ms. Ho Yin Yee (“Ms. Ho”) and 6 exhibits thereto. The exhibits are as follows:-

- HYY-1 --- A printout of the relevant webpage of the Hong Kong Consumer Council website (dated 13 September 2013)
- HYY-2 --- Printouts of the relevant pages in the internet forums (3 strings of discussions dated 2006, 2008 and 2009)
- HYY-3 --- A copy of an excerpt of the affidavit used in a court case in Singapore (dated 17 August 2008)
- HYY-4 --- Copies of invoices evidencing sales of the applied-for goods bearing the CYMA Brand for the years from 2007 to 2012
- HYY-5 --- Copies of photographs showing the use and promotion of the CYMA Brand in Optical 88 stores (17 pages of photographs)(undated)
- HYY-6 --- Copies of annual reports of Stelux Holdings Limited and Optical 88's internal memos and monthly account reports showing the CYMA Brand (Annual reports of 1992 and 1993)

41. I am required to determine whether there has been an honest concurrent use of the Subject Mark at the date of filing of the subject application, i.e. 29 December 2011 (“the relevant date”).
42. First, I note on the outset that the evidence at most suggests that the Applicant has produced and sold the Eyewear Goods. However, there is nothing in the SD to show use of the Subject Mark in relation to the Other Goods. Therefore, as far as the Other Goods are concerned, the answer to CSS Stage 1 test must be in the negative and the Applicant’s claim for honest concurrent use in relation to those goods must fail. I shall set out my analysis of the Applicant’s evidence in respect of the Eyewear Goods below.
43. Second, it is stated under paragraph 11 of the SD that “HYY-6” includes Optical 88’s internal memos and monthly accounts reports showing the CYMA Brand. However, these are not found in “HYY-6”. Nonetheless, even if they were adduced, they would have been considered as internal documents which would not illustrate use of the Subject Mark as a trade mark in respect of the applied-for goods.⁵
44. Finally, before I proceed to consider the subject application in the two-stage test, I find the following evidence to be irrelevant:-

⁵ *OCH-Ziff v OCH Capital* [2011] Bus. L.R. 632

Unable to show use of the Subject Mark	<ol style="list-style-type: none"> 1. “HYY-5” (the first 10 pages of photographs) 2. “HYY-4” 3. “HYY-6” (the 1992 annual report of Stelux Holdings Limited)
Unable to show use of the Subject Mark in relation to the applied-for goods	<ol style="list-style-type: none"> 1. “HYY-1” shows use in relation to watches 2. The first two discussion threads in “HYY-2” are discussions on watches 3. “HYY-3” shows use in relation to watches
Evidence were post-dated or undated	<ol style="list-style-type: none"> 1. “HYY-1” is after the relevant date 2. 4 invoices in “HYY-4” are after the relevant date 3. “HYY-5” are undated photographs
Unable to show use of the Subject Mark by the Applicant	<ol style="list-style-type: none"> 1. The third discussion thread in “HYY-2” is a discussion by third parties 2. The 1993 annual report under “HYY-6” is use of the Subject Mark by Stelux Holdings Limited
Unable to show use of the Subject Mark in Hong Kong	<ol style="list-style-type: none"> 1. “HYY-3” relates to a case in Singapore

The evidence as mentioned in the above table are of little, if any, assistance to this application.

CSS Stage 1 test

45. To pass the CSS Stage 1 test, the Applicant is required 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 was concurrent with use of the Cited Mark; and (c) such concurrent use was honestly made.
46. From the SD and the exhibits, the relevant exhibits where the Subject Mark was found to have been used in relation to the Eyewear Goods are “HYY-2” (the third discussion thread in relation to spectacles), “HYY-5” (11th to 17th pages of the

exhibit) and “HYY-6” (the 1993 annual report of Stelux Holdings Limited). I shall discuss those exhibits further below.

47. Ms. Ho claimed in paragraphs 5 and 6 of the SD that the Subject Mark was adopted by the Applicant first as the Chinese name of “CYMA”, which was said to be the Applicant’s well-known mark. However, the date of such alleged first use was not given. Out of “HYY-1” and “HYY-2” which were adduced in support of that aspect of the Applicant’s case, “HYY-1” post-dated the relevant date. Furthermore, the subject matter in both “HYY-1” and the first two discussion threads in “HYY-2” was exclusively relating to watches while the third discussion thread, among third parties, in “HYY-2” was on spectacles. In summary, neither “HYY-1” nor “HYY-2” tends to support the facts alleged in paragraphs 5 and 6 of the SD.
48. According to paragraph 8 of the SD, spectacle frames and sunglasses bearing the CYMA Brand (which was defined in paragraph 4 of the SD as the English mark “CYMA” and the Subject Mark as opposed to the Subject Mark alone) have been sold in the Optical 88 stores in Hong Kong and a few other regions since as early as 1992. However, the Subject Mark was only found cited in the 1993 annual report of Stelux Holdings Limited (“Stelux”) in “HYY-6”.
49. At the hearing, Ms. Cheung sought to explain the relationship between the various parties. Stelux was said to be the holding company of Optical 88 and the Applicant where the former is a retail chain for selling the Applicant’s Eyewear Goods. However, since this part of the Applicant’s case was not adduced by way of sworn evidence in accordance with rules 79 and 80 of the Trade Marks Rules (Cap. 559A) (“the Rules”), I am precluded from taking it into account when considering the subject application. Suffice to say that “HYY-6” tends to show use of the Subject Mark by Stelux and not the Applicant.
50. Paragraph 9 of the SD stated that the annual sales figures for the Eyewear Goods bearing “the CYMA Brand” between 2007 to 2012 were in the range between over HK\$9 million to over HK\$12 million. “HYY-4” was produced to substantiate the sales figures of all the applied-for goods, which included copies of invoices between 2007 to 2012 (those in 2012 post-dated the relevant date). An address in Hong Kong was shown on each of the invoices but without any company name.

51. It is noted that there were also various abbreviations or codes on the said invoices including “CYMA FRAME”, “CYMA-SUN FRAME” and “刀鋒邊Knife Cut” etc. Some of which seem to suggest sales of spectacle frames and sunglasses. However, as no explanations were provided, I am unable to determine whether the invoices in “HYY-4” showed sales of the Other Goods as claimed apart from the Eyewear Goods.
52. Regarding the absence of a company name on the invoices in “HYY-4”, Ms. Cheung explained at the hearing that the invoices were copies printed from Optical 88’s internal records. Be that as it may, while I am prepared to accept that these sales took place in Hong Kong, as none of the invoices bore the Subject Mark, I am unable to deduce from these invoices use of the Subject Mark on the Eyewear Goods let alone the applied-for goods as a whole.
53. In an attempt to make good the Applicant’s case, Ms. Cheung submitted that even if the Subject Mark was not found on the invoices, the Subject Mark was used in relation to the applied-for goods by other means. She referred me to *Stichting Greenpeace Council v Income Team Limited T/A Green Peace and Others* [1996] 1 HKLR 269 and argued that although the Subject Mark was not applied to the spectacle frames or sunglasses, the Subject Mark was used in shop windows, hang-tags, shopping bags, label tags inside the display cabinets, advertising billboards and posters in the Applicant’s affiliated Optical 88 stores. Such use would, in Ms. Cheung’s view, constitute use of the Subject Mark in relation to the applied-for goods.
54. Based on her submissions, I note that “HYY-5” (11th to 17th pages) showed some use of the Subject Mark in shop windows and display cabinet, I shall discuss them later. However, there is no evidence to show that the Subject Mark was being used in hang-tags, shopping bags, advertising posters or billboards in the Optical 88 stores as alleged by Ms. Cheung in paragraph 53 above.
55. Paragraph 10 of the SD stated that the CYMA Brand was used and promoted in relation to spectacle frames and eyewear in Optical 88 stores and “HYY-5” (copies of undated photographs) was produced in support. Paragraph 12 of the SD sets out the annual advertising and promotional figures for spectacle frames and sunglasses for the CYMA Brand ranging from over HK\$120,000 to over HK\$190,000 between 2007 to 2013. However, as mentioned above, the Subject Mark was not found in the first 10 pages of photographs in “HYY-5”. It was

only seen in the 11th to 17th pages of “HYY-5”.

56. In the relevant pages of photographs in “HYY-5” where the Subject Mark was found, I note that it was used in conjunction with other marks, e.g. “CYMA” and/or the device “”. From the evidence, they seemed to suggest that the mark “CYMA” may be used without the Subject Mark⁶, therefore it is likely that the sales figures (paragraph 10 of the SD) and the advertising figures (paragraph 12 of the SD) which are for the CYMA Brand would include those under the “CYMA” mark alone, i.e. without the Subject Mark at all. In view that those figures were not broken down to reflect the figures attributable to the Subject Mark, I am unable to conclude that the sales figures and the advertising figures reflected use of the Subject Mark in relation to the Eyewear Goods. In this connection, I invited Ms. Cheung to address me regarding this issue in the hearing.
57. Ms. Cheung argued that, according to the principles in CSS, it was common for traders in Hong Kong to use two or three marks all at the same time in relation to the same goods, for example, the mark in Chinese, the mark in English and a logo. Thus, she averred that there is no need to break down the sales figures and advertising figures to show the proportion attributable to the Subject Mark. However, even if those use of the Subject Mark with other marks were considered as use of the Subject Mark, the photographs in “HYY-5” were all undated and thus throw doubt as to whether use of the Subject Mark is concurrent with use of the Cited Mark on the Eyewear Goods.
58. Regarding the issue of honesty of the Applicant, I do not find anything in the evidence to cast any doubt on this.
59. On the issue of concurrent use, despite the lack of apportionment as discussed in paragraph 56 above, I find the annual sales and advertising figures adduced in paragraphs 10 and 12 of the SD for the 5-year period prior the relevant date would nonetheless include sales and advertising figures of the Subject Mark and therefore they are acceptable in support of a claim of concurrent use of the Subject Mark.
60. On the totality of the evidence before me, despite some doubts in the evidence, I

⁶ The invoices in “HYY-4” and the first 10 pages of “HYY-5” referred to the “CYMA” mark and/or the device “” and the Subject Mark was not cited at all.

find the Applicant has passed the CSS Stage 1 test in respect of the Eyewear Goods. As to the Other Goods, there was no evidence of use being produced before me and therefore the Other Goods must fail the CSS Stage 1 test as discussed in paragraph 42 above. I will now proceed to the CSS Stage 2 test for the Eyewear Goods.

Further evidence

61. Given that Ms. Cheung has provided some factual explanations such as the history of the Subject Mark, the relationships between the Applicant, Optical 88, City Chain and Stelux, the use of the Subject Mark in shopping bags, hang-tags etc. during the hearing but such information were not provided in the form of a statutory declaration in accordance with rules 79 and 80 of the Rules. I therefore invited Ms. Cheung to file further evidence in the appropriate form by the end of day. However, I was informed that no further evidence may be filed within time. Therefore, I am to consider the case based on the facts and evidence as provided in the SD and the submissions made during the hearing.

CSS Stage 2 test

62. For stage 2, the main discretionary considerations in deciding whether registration should be allowed on honest concurrent use are set out in *Pirie* (1933) 50 R.P.C. 147 and referred to in *Re CSS Jewellery Co. Ltd.* at paragraph 39. They are:-
- (a) the extent of use in time and quantity and the area of the trade;
 - (b) the degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;
 - (c) the honesty of the concurrent use;
 - (d) whether any incidents of confusion have in fact been proved;
 - (e) the relative inconvenience which would be caused if the mark were registered.
63. I will continue to discuss the above factors in turn, bearing in mind that the above factors are not exhaustive and that all relevant circumstances ought to be considered (*Re CSS Jewellery Co. Ltd.* at paragraph 40).

The extent of use in time and quantity and the area of the trade

64. The extent of use of the Subject Mark in Hong Kong can be assessed by reference to the sales and advertising figures of the spectacle frames and sunglasses.
65. As mentioned above, the annual sales figures and advertising figures provided in the SD were all based on the CYMA Brand (paragraphs 8 and 12 of the SD). With reference to the discussion in paragraph 56 above, the sales figures and the advertising figures were not broken down to show the proportion attributable to the Subject Mark. Therefore, it is impossible for me to assess the sales of the Eyewear Goods under Subject Mark and to determine the amount of effort spent by the Applicant in advertising and promoting the Eyewear Goods under the Subject Mark in Hong Kong.
66. Taking into account of the evidence before me, I am not convinced that the Applicant has demonstrated substantial and extensive use of the Subject Mark in respect of the Eyewear Goods as at the date of the application.

The degree of confusion likely to ensue from the resemblance of the marks

67. The degree of confusion is to a large extent indicative of the measure of public inconvenience (*Re Borsalini Trade Mark* [1993] 1 HKC 587). If public inconvenience is unlikely, there would be no good reason to refuse the application for registration of Subject Mark.
68. I have already discussed the degree of confusion which is likely to ensue in paragraphs 34 to 37 above. In my view, the likelihood of confusion with the Cited Mark and the measure of public inconvenience are high.

The honesty of the concurrent use

69. As already discussed in paragraph 58 above, I have no reason to doubt the honesty of the Applicant in using the Subject Mark.

Instances of confusion

70. It is asserted in paragraph 14 of the SD that no instances of confusion were encountered. There is also no evidence to show any instances of confusion.

Balance of inconvenience

71. The owner of the Cited Mark will obviously be inconvenienced if another party is allowed to register a similar mark in respect of the Eyewear Goods, which, as considered above, are identical or similar to the goods of the Cited Mark since it may lead to confusion in the market. On the other hand, the Applicant is unable to show that the Subject Mark has been used extensively in Hong Kong.
72. Taking into account the similarities between the Subject Mark and the Cited Mark, and the similarities between the goods concerned, I am of the view that the relative inconvenience which would be caused to the owner of the Cited Mark will be higher if the Subject Mark is allowed to proceed to registration.

Weighing all factors

73. Having considered the totality of the evidence and all relevant circumstances, in particular the fact that the Applicant has failed to provide sufficient evidence to demonstrate substantial and extensive use of the Subject Mark in respect of the Eyewear Goods in Hong Kong as at the date of application, I do not consider it appropriate to exercise my discretion to allow registration of the Subject Mark in respect of such goods on honest concurrent use under section 13(1)(a) of the Ordinance.

Section 13(1)(b) of the Ordinance

74. Pursuant to section 13(1)(b) of the Ordinance, if by reason of other special circumstances it is proper for a trade mark to be registered, an objection under section 12(3) of the Ordinance can be overcome.
75. Nevertheless, on the evidence before me, I do not see any special circumstances to justify the registration of the Subject Mark in respect of the applied-for goods. Thus, I do not allow the Subject Mark to be registered in respect of the applied-for goods pursuant to section 13(1)(b) of the Ordinance.

Conclusion

76. I have carefully considered all the oral and written submissions and the evidence made 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 all the applied-for goods in Class 9. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Irene Ip
for Registrar of Trade Marks
15 December 2015