

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 302148309

MARK



APPLICANT : GALERIA Kaufhof GmbH

CLASSES : 18 & 25

STATEMENT OF REASONS FOR DECISION

BACKGROUND

1. On 30 January 2012, MIP METRO Group Intellectual Property GmbH & Co. KG (“MIP METRO”) filed an application for registration of the mark below (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) -



(“the Subject Mark”).

2. Registration of the Subject Mark is sought to cover the following goods -

Class 18

Leather and imitations of leather, and goods made of these materials, included in class 18, in particular handbags; trunks and travelling bags; cosmetic bags (made of leather or other materials); make-up bags (made of leather or other materials).

Class 25

Clothing, in particular ladies' underwear and corsetry, bath linen, fitness clothing, sportswear, everyday clothing and leisurewear; footwear, in particular bath slippers and sports shoes; headgear; stockings; tights.

(collectively “the applied for goods”).

3. On 26 August 2014, MIP METRO applied to file a recordal of assignment of the Subject Mark to GALERIE Kaufhof GmbH, effective from 5 June 2014. The particulars of the assignment were entered in the register of trade marks on 6 October 2014. As a result, GALERIE Kaufhof GmbH substituted MIP METRO as the Applicant in the subject application.

4. At the examination stage, the Registrar of Trade Marks (“the Registrar”) raised an objection under section 12(3) of the Ordinance on the ground that the Subject Mark was considered to be similar to the following earlier registered trade mark (“the Cited Mark”)¹ and the applied for goods similar to certain goods and services of the Cited Mark (namely, those in Classes 18 and 40, in bold below) such that use of the Subject Mark in relation to the applied for goods is likely to cause confusion on the part of the public -

Registration No.: 301395126

Trade mark:

Emotion

Class: 14, 18, 26, 35 & 40

Specification: Class 14

未加工或半加工貴重金屬；銀飾品；鏈(首飾)；
金剛石；珠寶(首飾)；裝飾品(珠寶)；人造寶石；
首飾盒；測時儀器；貴重金屬藝術品。

¹ Application for registration of the Cited Mark was made in Chinese.

Class 18

未加工或半加工皮革；背包；錢包(小錢袋)；手提包；旅行包；傘；傢具用皮裝飾；公文包；旅行用具(皮件)；用於裝化妝用品的手提包(空的)。

(Leather, unworked or semi-worked; backpacks; purses (small coin bags); handbags; travelling bags; umbrellas; leather trimmings for furniture; briefcases; travelling sets (leatherware); make-up bags (empty).)²

Class 26

花邊飾品；帽子裝飾品(非貴重金屬)；衣服裝飾品；頭髮裝飾品；髮夾；別針(非首飾)；胸針(服裝配件)；服裝扣；皮帶扣；假髮。

Class 35

組織商業或廣告展覽；替他人採購(替其他企業購買商品或服務)；外購服務(商業輔助)；廣告；為零售目的在通訊媒體上展示商品；進出口代理；替他人推銷；商業管理輔助；商業櫥窗佈置；貨物展出。

Class 40

焊接；金屬處理；鍍金；鍍銀；服裝製作；皮革加工；藝術品裝框；燒製陶器；定做材料裝配(替他人)；雕刻。

(Welding; metal treating; gold plating; silver plating; custom tailoring; leather working; framing of works of art; firing pottery; custom assembling of materials (for others); engraving.)

Date registered: 30 July 2009

5. Despite submissions made by Ella Cheong (Hong Kong) Limited (“the agent”) on behalf of the Applicant, the objection was maintained by the Registrar. The Applicant requested a hearing on the registrability of the

² Translation of the Class 18 and Class 40 specifications is that by the Registrar.

Subject Mark and one was fixed for 18 June 2015. The Applicant filed neither a Form T12 nor any written submissions for the purpose of the hearing. Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559, sub. leg.) (“the Rules”), the Applicant was treated as not intending to appear at the hearing. Pursuant to rule 75(b) of the Rules, I will now proceed to decide on the subject application without a hearing.

6. By letter dated 8 April 2013, the agent put forward its views on the Registrar’s objection. While admitting that there may be some overlap in respect of the Class 18 goods under the conflicting marks, the agent argued that it should not be the case with the Class 25 goods since the Cited Mark concerns no goods of such class. The agent then sought time and extensions in order to obtain consent of the owner of the Cited Mark to the use and registration of the Subject Mark. The Applicant on the other hand did not file any evidence of use to show that there has been an honest concurrent use of the Subject Mark and the Cited Mark for the purpose of section 13(1) of the Ordinance. I, therefore, only have a *prima facie* case to consider.

DECISION

Section 12(3) of the Ordinance

7. The relative grounds for refusal of an application for registration are contained in section 12 of the Ordinance, the relevant provision of which reads 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.”*

8. Section 12(3) prohibits the registration of a trade mark which would be 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 to be registered in respect of goods or services the same as or similar to those of the earlier trade mark.

9. An “*earlier trade mark*” referred to in section 12(3) is defined in section 5 of the Ordinance 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 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;”*

10. Since the Cited Mark has a date of application for registration earlier than that of the Subject Mark, it is an earlier trade mark in relation to the Subject Mark.

11. According to section 7(1) of the Ordinance, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

12. The basic principles regarding the assessment of similarity between signs 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* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.R.S. 19. Such principles have been adopted in Hong Kong and recently by the Court of Appeal in *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd* [2014] HKEC 2004. In *Tsit Wing*, Lam VP cited (at paragraph 35) the propositions endorsed by Kitchen LJ

in *Specsavers* (at paragraph 52) as follows -

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

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;*
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;*
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;*
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;*
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;*
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;*

- (g) *a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;*
- (h) *there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;*
- (i) *mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;*
- (j) *the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;*
- (k) *if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”*

13. The above principles are those that I would bear in mind when considering whether similarity exists between the Subject Mark and the Cited Mark thus giving rise to a likelihood of confusion to the relevant public if the former is used in relation to the applied for goods.

Relevant public

14. In comparing the marks, I have to consider the perception of the marks in the mind of the average consumer of the goods and services in question, who normally views a mark by the overall impression rather than by analysing its details. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. His/her level of attention is likely to vary according to the category of goods and services concerned.

15. The applied for goods include leather and imitation of leather goods such as handbags, travelling bags and make up bags, clothing, ladies’

underwear, fitness and sports clothing, footwear, bath slippers and sports shoes, headgear, stockings and tights etc. These are general merchandise for everyday use by members of the general public. The relevant consumers are therefore members of the general public. Whilst the relevant consumers are deemed to be reasonably well informed and reasonably observant and circumspect, the level of care and attention that can be exercised by them when purchasing the applied for goods is considered to be average.

Subject Mark



16. The Subject Mark “  ” is a composite mark consisting of two word elements “emotions” and “LINGERIE” and a slightly shaded oval-shaped device. The word “emotions” sits across the centre of the device with the two ends of the word spilling over it. The letters in the word “emotions” are presented in the lower case in freestyle script font with the letter “t” enlarged and exaggerated, stretching over the full vertical height of the oval device. All the letters in the word “lingerie” are expressed in the upper case in normal and considerably smaller font than that of the word element “emotions”. This word element positions beneath the letters “ion” of the word element “emotions” in the right lower quadrant of the oval device. As a whole, the Subject Mark is slightly slanted to the right.

17. Both “emotions” and “lingerie” are dictionary defined words. “Emotions” means an *“affective state of consciousness in which joy, sorrow, fear, hate, or the like, is experienced, as distinguished from cognitive and volitional states of consciousness”*.³ “Lingerie” on the other hand are *“women’s undergarments, and may imply their being fashionable and alluring”*.⁴

³ <http://dictionary.reference.com/browse/>

⁴ <https://en.wikipedia.org/wiki/>

18. In respect of the applied for goods in Class 18 (i.e. leather, travelling set and handbags for carrying cosmetics etc), neither the word “emotions” nor “lingerie” has any semantic correlation with them. Both words are inherently distinctive with regard to the applied for goods. However, given its much smaller size and less prominent position relative to the stylized word element “emotions”, the word element “LINGERIE” is obviously secondary. The word element “emotions” is considered more likely to catch the attention of an average consumer and to remain in his memory. As for the oval device, whilst it may come across to some consumers as resembling a mirror, its shape, position or shading is not particularly fanciful or creative. To an average consumer it, in my view, does nothing more than holding the two word elements in place. General legal principle also has it that words in a composite mark speak louder than devices.⁵ The word element “emotions” is thus the dominant and most distinctive element of the Subject Mark with regard to the applied for goods in Class 18.

19. As for the applied for goods in Class 25, the word “lingerie” refers to some of the items (i.e. ladies’ underwear and corsetry, bath linen,⁶ bath slippers, stockings and tights). This would render the word element “LINGERIE” indistinctive, at least as far as those items are concerned. Although the use of some of the applied for goods in Class 25 (e.g. fitness clothing, sportswear and leisurewear etc) may generate a relaxing and/or positive feeling, the word “emotions” cannot be said to be descriptive of those goods. While the oval device may, given the nature of the applied for goods in Class 25, be more readily associated with a mirror, since such possible association is not exceptionally novel, the device would not leave a lasting impression in consumers’ minds. Hence, given its size, position, presentation and distinctiveness, the word element “emotions” would stand out as the most distinctive and dominant element of the Subject Mark in respect of the Class 25 applied for goods as well.

⁵ *Oasis Stores Ltd. Trade Mark Application* [1998] R.P.C. 631 at 644.

⁶ See §35 hereof.

Cited Mark

20. The Cited Mark “**Emotion**” comprises a word element “emotion” and a device. Except the letter “e” which is expressed in the upper case, all other letters of the word element are expressed in the lower case in a normal type font of the same size without any stylization. The device is made up of three disjoined diamond looking shapes, two of the same size and the remaining one slightly larger. The three shapes are arranged in such a way that they resemble an open leaf. The device is positioned above the letter “i” of the word element, slightly slanted to the right. Since the device is relatively straightforward and of a relatively small size as compared to the entire word element and given the “words speak louder than devices” principle generally, I consider that the average consumer would recall the word “emotion” as the distinctive and dominant element of the Cited Mark.

Comparison of marks

21. In comparing the Subject Mark and the Cited Mark, I have to take into consideration their normal and fair use in relation to their respective goods and services, and the overall impression each of the marks would give to the average consumer.

22. A comparison of the marks has to be based on an overall appreciation of their visual, aural and conceptual similarities, taking into account the overall impressions given by the marks, and bearing in mind particularly their distinctive and dominant components. I must consider whether there are similarities between the Subject Mark and the Cited Mark and the respective goods and services covered, and whether they would combine to create a likelihood of confusion.

23. Visually, the Subject Mark and the Cited Mark share an identical distinctive and dominant word element “emotion”. Although this word element is singular and the letter “e” is in the upper case in the Cited Mark, the

word elements are expressed in different fonts and styles and the devices (which are not the dominant elements) have little resemblance in the marks, taking them as wholes and allowing for imperfect recollection, I find the two conflicting marks *visually similar*.

24. Aurally, the Subject Mark is pronounced [ih-**moh**-shuh-nz] [lahn-zhuh-**rey**]. As “emotions” is a more familiar and readily recognizable and easier to pronounce word than “lingerie” even in the Hong Kong context, it is not unreasonable to assume that the average consumer would by and large drop the word “lingerie” when pronouncing the Subject Mark. This would render the pronunciations of the Subject Mark and the Cited Mark identical save the missing “s” sound at the end of the latter. Given the identical frontal part of the two word elements in the two marks, the missing “s” in the Cited Mark would, in my view, be easily overlooked by an average consumer. Taking the two marks as wholes, I find them *aurally similar to a high degree*.

25. Conceptually, both marks contain word element(s) and a device. Given the less dominance or the lack of distinctiveness, as the case may be, of the word element “LINGERIE” in the Subject Mark with regard to the applied for goods and the distinctiveness and dominance of the respective (remaining) word element “emotion” common to the two marks as discussed above, the Subject Mark and the Cited Mark are considered *conceptually similar*.

26. Having regard to the conflicting marks as wholes and their visual, aural and conceptual similarities, I find the two marks *similar*.

27. I note that having disagreed with the Registrar on the similarity in the goods and services covered by the two conflicting marks, the agent never challenged the Registrar’s views on the similarity in the marks themselves.

Comparison of goods

28. The well-known tests for assessing similarity in goods or services are

found in *British Sugar v Robertson and Sons Ltd* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra). The court considered that all relevant factors relating to the goods or services in question should be taken into account. These factors include, in particular, their nature, intended purpose, method of use, whether the goods/services are in competition with each other or are complementary, as well as their users and the channels through which they reach the market.

29. Goods and services are considered identical if they fall within the ambit of the terms within the competing specification.⁷ Goods and services are considered complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods and services lies with the same undertaking.⁸

30. Based on these legal principles, I now compare the applied for goods with the goods and services in Classes 18 and 40 under the Cited Mark -⁹

Subject Mark	Cited Mark
<p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials, included in class 18, in particular handbags; trunks and travelling bags; cosmetic bags (made of leather or other materials); make-up bags (made of leather or other materials).</p> <p><u>Class 25</u> Clothing, in particular ladies' underwear and corsetry, bath linen, fitness clothing, sportswear, everyday clothing and leisurewear;</p>	<p><u>Class 18</u> 未加工或半加工皮革；背包；錢包(小錢袋)；手提包；旅行包；傘；傢具用皮裝飾；公文包；旅行用具(皮件)；用於裝化妝用品的手提包(空的)。(Leather, unworked or semi-worked; backpacks; purses (small coin bags); handbags; travelling bags; umbrellas; leather trimmings for furniture; briefcases; travelling sets (leatherware); make-up bags (empty).)</p> <p><u>Class 40</u> 焊接；金屬處理；鍍金；鍍銀；服裝製作；皮革加工；藝術品裝框；燒製</p>

⁷ *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05.

⁸ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-325/06.

⁹ §4 above, out of the five classes of goods and services under the Cited Mark, citation was raised only in respect of those in Classes 18 and 40.

footwear, in particular bath slippers and sports shoes; headgear; stockings; tights.	陶器；定做材料装配(替他人)；雕刻。(Welding; metal treating; gold plating; silver plating; custom tailoring; leather working; framing of works of art; firing pottery; custom assembling of materials (for others); engraving.)
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31. From the outset, the respective Class 18 goods under the Subject Mark and the Cited Mark share identical nature, intended purposes, methods of use and sales channels. The two sets of goods are *identical*.

32. The Class 18 goods of the Subject Mark are the end products of the Class 40 service “皮革加工” (“**leather working**”) of the Cited Mark. They are complementary or otherwise closely related to each other and are hence *highly similar*.

33. When assessing similarity between Class 25 and Class 18 goods, I am aware of the acknowledgement by a line of European case authorities that certain goods in the two classes may, in addition to their basic function to cover and protect the human body, have a common aesthetic function by jointly contributing to the external image (“look”) of the consumer concerned. The perception of the connections between them must therefore be assessed by taking into account any attempt at coordinating the presentation of that “look”, i.e. the various components at the design stage or when they are purchased. That coordination may exist, in particular, between **clothing, footwear and headgear** in Class 25 and the various **clothing accessories which complement them, such as handbags** in Class 18. These goods are considered related because consumers are likely to consider the latter as complementary accessories to the former as they are closely co-ordinated. The fact that these goods are often sold in the same sales outlets is likely to facilitate the perception by an average consumer of the close connections between them and strengthen the impression that the same undertaking is responsible for their production.¹⁰

¹⁰ *El Corte Inglés v OHIM-Bolaños Sabri (PirañÑAM diseño original Juan Bolaños)* (T-443/05) [2007] E.C.R. II-2579, at paras. 49 and 50, and applied in, inter alia, OHIM, Case R

34. I am also mindful of the findings by the General Court of the European Union (Seventh Chamber) in *Asos plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2014] E.T.M.R. 37, at paragraphs 48 to 51, that firstly, **bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses** in Class 18, unlike **clothing, footwear, headgear** in Class 25, had an essential utilitarian function and not an essentially aesthetic function. There was no reason for the consumer to co-ordinate them with clothing, footwear, headgear in Class 25. The said goods in Class 25 did not contribute to the external image of consumers. Secondly, the purchase of the said goods in Class 18 was viewed independently from the purchase of clothing, footwear, headgear in Class 25 in a way that the purchase of the said goods in Class 18 would be made without worrying about the possession or purchase of the said goods in Class 25. The said goods in Class 25 were as a result considered not to be clothing accessories. The fact that the said Class 25 and Class 18 goods in *Asos* may share the same distribution channels did not support a conclusion that similarity exists between them.

35. The above principles would be relevant when I compare the applied for goods in Class 25 and those in Class 18 under the Cited Mark. Before comparing, I note that the item “**bath linen**” (i.e. bath mat, bath towel, face cloth, washcloth, washrag, flannel)¹¹ sought to be covered by the Subject Mark appears to be out of place under Class 25 as the item is usually considered under Class 24 instead of the Nice Classification as “**bath linen, except clothing**”.¹² Given the overall specification of the applied for goods in Class 25 in the present case, it would not be unreasonable to take the item “bath linen” as referring to “**bath robes**” or “**dressing gowns**” which are indeed Class 25 items.

36. Based on the foregoing, I find similarity/complementarity between

804/2013-1, First Board of Appeal, 30 April 2015 and OHIM, Opposition No. B 2 445 099, Opposition Division, 12 August 2015.

¹¹ <http://www.thefreedictionary.com/>

¹² Class 24: “*Textiles and textile goods, not included in other classes; bed covers; table covers*”, Nice Classification, 10th ed, 2012 version.

the applied for goods in Class 25 and the Class 18 goods under the Cited Mark as follows -

Subject Mark - Class 25 goods	Cited Mark - Class 18 goods	Findings
<p>Clothing, in particular ladies' underwear and corsetry, bath linen... everyday clothing and leisurewear; footwear, in particular bath slippers...; headgear; stockings; tights.</p>	<p>Handbags; purses (small coin bags); travelling bags; make-up bags (empty).</p>	<p>Despite the ruling in <i>Asos</i> (supra) that wallets and purses (Class 18) were not complementary to clothing, footwear, headgear (Class 25), I am of the view that specific practical functions aside, purses, travelling bags and make-up bags also carry an aesthetic function like handbags (Class 18) in the Hong Kong context where consumers generally are fashion sensitive. It is not unusual for a consumer here shopping for clothing and footwear etc (Class 25) and a handbag (Class 18) to be seeking a purse, travelling bag and/or make-up bag that are mutually matching by design, colour or material to the Class 25 goods. It is not uncommon either for these items under the two classes to be manufactured by the same economic undertaking and sold in the same sales outlets. Overall I find the two listed sets of goods <i>complementary and similar</i>.</p>
<p>Clothing, in particular...fitness clothing, sportswear,...; footwear, in particular...sports shoes</p>	<p>Backpacks</p>	<p>Backpacks (Class 18) are likely to be considered by an average consumer as complementary accessories to the listed applied for goods in Class 25 as both sets of goods are common merchandise in fitness training and sports, often co-ordinated, produced by the same manufacturer and sold in the same sales outlets. The two listed sets of goods are hence <i>closely connected and similar</i>.</p>

37. Given my findings above, every item of the specification of the applied for goods has a corresponding item or items of goods and/or services in Class 18 and/or 40 of the Cited Mark that can be considered to be either ***identical or similar***.

38. In its letter of 8 April 2013, the agent admitted that there may be overlap between the Class 18 applied for goods and those of the same class of the Cited Mark. It, however, argued that overlap should not exist in respect of the Class 25 applied for goods since the Cited Mark does not designate Class 25 goods. The Registrar was urged to waive the citation against Class 25 and that if it was waived, the Applicant may be prepared to abandon the Class 18 part of the subject application.

39. On this point, I find a passage in paragraph 9-073 of *Kerly's Law of Trade Marks and Trade Names* (15th Ed.) that “*goods in different classes may nevertheless be considered similar, and likewise that goods or services within the same class may be found to not be similar*” to be relevant. The case of **SK.4 TM Application** (O-176-08) illustrated that the classification of goods and services of the International Classification system shall serve exclusively administrative purposes and that class numbers are irrelevant to the question of similarity of goods and services.¹³ It was accepted in a more recent case of **Genalt 2000, S.L. v GeckoLogic GmbH** that the classification system obviously did not preclude cross-class similarity.¹⁴ Given this principle, there are no reasons to disturb my analysis and findings in paragraphs 31 to 37 above.

40. The agent also argued in the said letter why Class 35 services and Class 25 goods should not be cross-cited. Since the Registrar in fact never suggested such citation, the agent's argument does not give rise to any issue for consideration in the subject application.

Likelihood of confusion

41. Having compared the similarities between the Subject Mark and the Cited Mark and those between the respective goods and services, I would next examine whether there is a likelihood of confusion between the conflicting marks. A likelihood of confusion under section 12(3) of the Ordinance refers

¹³ OHIM, Appeal from Opposition No. 93633, 24 June 2008, §§32-34.

¹⁴ OHIM, Opposition No. B 1 590 523, Opposition Division, 5 October 2010.

to confusion on the part of the public as to the trade origin of the goods and services in question. Given the relevant guiding principles set out in paragraph 12 above, it is a matter of global appreciation and all relevant factors should be taken into account. The matter must be judged through the eyes of the average consumer of the goods and services in issue, who is deemed to be reasonably well-informed and reasonably observant and circumspect. The average consumer seldom has the opportunity to compare marks side by side but relies upon his imperfect recollection of the marks. The perception of the marks in his mind plays a decisive role in the global appreciation of the likelihood of confusion. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa.

42. I have found the Subject Mark and the Cited Mark to be similar.¹⁵ I have also found the applied for goods to be identical or similar to certain goods and services protected by the registration of the Cited Mark.¹⁶ Given such findings, I come to the view that when the Subject Mark is used in relation to the applied for goods, with only his imperfect recollection to rely on, there is a real risk that the average consumer would be confused into believing that the goods so provided and goods and/or services within the relevant specification provided under the Cited Mark come from the same or economically-linked undertakings. Such risk constitutes a likelihood of confusion within the meaning of section 12(3) of the Ordinance.

43. I am also aware that it is not uncommon for manufacturers to use sub-brands to distinguish goods/services between different product lines. The Subject Mark may possibly be perceived by the average consumer as denoting a new sub-brand or a subsidiary line in leather goods, clothing and/or footwear etc originating from the owner of the Cited Mark.

44. As mentioned in paragraph 38 above, the agent proposed that if the Registrar's citation in respect of the applied for goods under Class 25 was

¹⁵ §§23-26 hereof.

¹⁶ §§31, 32, 36 & 37 hereof.

waived, the Class 18 part of the subject application could be abandoned. Given my findings above of similarity between the marks and between the goods and services and on the likelihood of confusion, I do not see any justification to waive the said citation as sought. I do not see how the abandonment of the Class 18 goods could help advance the subject application either. Furthermore, no consent of the owner of the Cited Mark to the use and registration of the Subject Mark turned out to be forthcoming despite the time and extensions granted to the agent in order to secure the same.¹⁷

CONCLUSION

45. I have carefully considered the subject application. For the reasons given, I find that the Subject Mark in respect of the applied for goods is precluded from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

(Elsie Tse)
for Registrar of Trade Marks
30 October 2015

¹⁷ §6 hereof.