

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 302573226

MARK :



CLASSES : 3, 10

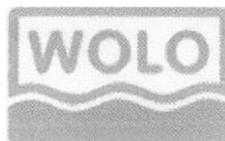
APPLICANT : ALPHA POWER INDUSTRIAL LIMITED

OPPONENT : WOMO S.R.L.

STATEMENT OF REASONS FOR DECISION

Background

1. On 10 April 2013 (“Application Date”), ALPHA POWER INDUSTRIAL LIMITED (“Applicant”) filed an application (“subject application”) under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for registration of the following mark:



(“subject mark”)

Registration of the subject mark is sought in respect of the following goods in Classes 3 and 10 (“subject goods”):

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; all included in class 3.

Class 10

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopaedic articles; suture materials; all included in class 10.

2. Particulars of the subject application were published on 7 June 2013. WOMO S.R.L. (“Opponent”) filed a notice of opposition on 6 November 2013 (“Notice of Opposition”) with grounds of opposition. With leave from the Registrar, the Opponent filed amended grounds of opposition on 7 January 2014 (“Amended Grounds of Opposition”). In response to the Notice of Opposition and the Amended Grounds of Opposition, the Applicant filed a counter-statement on 19 March 2014 (“Counter-statement”) with grounds in support of its application.

3. The Opponent’s evidence consists of a statutory declaration of Stefano Percassi, the founder and Chief Executive Officer of the Opponent, made on 22 October 2014 (“Percassi’s Declaration”).

4. The Applicant did not file any evidence in these proceedings.

5. The opposition was fixed to be heard on 22 June 2016. The Applicant did not file any notice of intention to appear at the hearing (Form T12). Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559A), the Applicant is treated as not intending to appear at the hearing. Furthermore, the Opponent’s agent informed the Registrar that the Opponent would not attend the hearing. I therefore proceed to decide the matter without a hearing pursuant to rule 75(b) of the Trade Marks Rules.

Grounds

6. In this opposition, the Opponent relies on the grounds under the following sections of the Ordinance:

- (a) section 11(1)(a);
- (b) section 11(4)(b);
- (c) section 11(5)(a);
- (d) section 11(5)(b);
- (e) section 12(3); and
- (f) section 12(5)(a).

Relevant date

7. The relevant date for considering this opposition is the Application Date, i.e. 10 April 2013.

Evidence of the Opponent

8. According to Percassi's Declaration, the brand and trademark "WOMO" (the "Opponent's Brand") was created by Stefano Percassi, Chief Executive Officer of the Opponent, in Italy in 2011. It is a brand dedicated to men's personal care and grooming.¹ The Opponent's Brand comes from assonance with the word "man" in Italian (UOMO).² Exhibits "SP-1" and "SP-2" to Percassi's Declaration include copies of printouts from the Opponent's branding company's website showing the creation of the packaging of products of the Opponent's Brand and an article about the Brand Identity Grandprix award received for the Opponent's Brand product.

9. The Opponent is the owner of the marks "WOMO" and "" (collectively, the "Opponent's Trade Marks") registered in Hong Kong under Trade Marks Nos. 302256895 and 302256912 in respect of the same goods in Classes 3, 18 and 25 (collectively, the "Opponent's Registered Goods") as set out in the **Schedule**.

10. Exhibit "SP-3" to Percassi's Declaration includes copies of photos of the Opponent's products, which include eau de toilette, shaving soap and wake-up energy gel. The marks "" and "" appear on the products.

11. The Opponent says that it has used its trade mark "WOMO" since 2012 (i.e. shortly before the relevant date of 10 April 2013), and that products under the Opponent's Brand have been sold in the Opponent's three boutiques in Italy and through the Opponent's online shop at <https://www.womostore.it/>.³ There is no evidence that the Opponent has any sales outlet for its goods in Hong Kong. There is no evidence that the Opponent's online shop has been accessed by, or any purchase has been made by, customers from Hong Kong before the relevant date.

12. The Opponent has provided the following sales figures in respect of sales of the Opponent's goods under or by reference to the Opponent's Trade Marks:

Year	Italy Turnover (Euro)
2012	77,113.90
2013	72,452.54

¹ Percassi's Declaration, para. 3.

² Percassi's Declaration, para. 5.

³ Percassi's Declaration, paras 18-20.

No turnover figures in respect of sales of the Opponent's goods in Hong Kong have been provided.

13. The Opponent says that the following are the approximate amounts expended in promoting the Opponent's Trade Marks *in Italy* between 2012 and 2013:

Year	Advertisement Investments (Euro)
2012	5,077.75
2013	47,640.80

There is no evidence that the Opponent has expended any amount to promote the Opponent's Trade Marks in Hong Kong before the relevant date.

14. No invoice in respect of sales of the Opponent's goods under the Opponent's Trade Marks have been provided. No advertising or promotional materials in Hong Kong in respect of the Opponent's goods under the Opponent's Trade Marks have been provided. There is no evidence of actual use of the Opponent's Trade Marks in Hong Kong before the relevant date.

Opposition under section 11(1)(a) of the Ordinance

15. Section 11(1)(a) of the Ordinance provides as follows :

“Subject to subsection (2), the following shall not be registered-

(a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");”.

16. Section 3(1) of the Ordinance provides as follows :

“In this Ordinance, a "trade mark" (商標) means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.”

17. In its Amended Grounds of Opposition, the Opponent claims that:

“16. ... the use and registration of the [subject mark], which is confusingly similar to the Opponent's Trade Marks, will likely cause confusion to the public as to its ownership, and/or will likely mislead the public into believing that the Applicant has

been licensed or authorized by the Opponent's Group⁴ to use the Opponent's Trade Marks.

...

18. Registration of the [subject mark] is contrary to Section 11(1)(a) because it is a sign that is not capable of distinguishing the [subject goods] from that of the others, namely, it is not capable of distinguishing the [subject goods] from the Opponent's Goods and Services, and therefore it is a sign which does not satisfy the requirements of Section 3(1)."

18. Section 11 of the Ordinance deals with absolute grounds for refusal of registration, and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties.

19. It is apparent from the Opponent's pleadings and evidence that the basis of its opposition under section 11(1)(a) of the Ordinance is not that the subject mark is not by its nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings, nor that it cannot be represented graphically. Rather, the Opponent's contention is that the subject mark would cause confusion because of its resemblance to the Opponent's Trade Marks. Section 11(1)(a) of the Ordinance is not a proper avenue for such a contention. The ground of opposition under section 11(1)(a) of the Ordinance therefore necessarily fails.

Opposition under section 11(4)(b) of the Ordinance

20. Section 11(4)(b) of the Ordinance provides that :

*"A trade mark shall not be registered if it is –
... (b) likely to deceive the public."*

21. In its Amended Grounds of Opposition, the Opponent claims that:

"19. Since the [subject mark] is likely to deceive the public into thinking that the [subject goods] sold under the [subject mark] emanate from the Opponent's Group when in fact they do not, or are duly authorized or licensed by the Opponent's Group when in fact they are not, the [subject mark] should thus also be refused under Section 11(4)(b) of the Ordinance."

⁴ Mr. Stefano Percassi, the founder of the Opponent, and the Opponent are collectively referred to in the Amended Grounds of Opposition as "the Opponent's Group".

22. Section 11(4)(b) of the Ordinance is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. This is consistent with the heading of section 11 of the Ordinance which is entitled “**Absolute grounds for refusal of registration**” and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties.⁵ Consequently, the Opponent cannot succeed under section 11(4)(b) of the Ordinance based upon its allegedly similar mark(s).

23. The ground of opposition under section 11(4)(b) of the Ordinance is not made out.

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

24. Section 11(5)(a) of the Ordinance provides that :

“(5) A trade mark shall not be registered if, or to the extent that –

(a) its use is prohibited in Hong Kong under or by virtue of any law;”

25. The Opponent’s pleaded case under section 11(5)(a) of the Ordinance is that:⁶

“Further or in the alternative registration of the [subject mark] should be refused under Section 11(5)(a) of the Trade Marks Ordinance on the ground that the use of the [subject mark] is prohibited in Hong Kong by virtue of law, namely the law of passing off, due to the Opponent’s Group’s reputation, goodwill and fame in its trade marks.”

26. The ground under section 11(5)(a) of the Ordinance is an absolute ground for refusal, and is concerned with the trade mark itself. An objection that use of a mark would cause passing-off arises under section 12(5)(a) of the Ordinance and not under section 11(5)(a).⁷ The ground of opposition under section 11(5)(a) of the Ordinance therefore necessarily fails.

⁵ *QS by S. Oliver Trade Mark* [1999] RPC 520 at 524; *Kerly’s Law of Trade Marks and Trade Names* (15th Edn.) para. 8-201.

⁶ Amended Grounds of Opposition, para. 20.

⁷ *Kerly’s Law of Trade Marks and Trade Names* (15th Edn.) para. 8-210.

Opposition under section 12(3) of the Ordinance

27. Section 12(3) of the Ordinance provides that:

“A trade mark shall not be registered if-

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

28. The Opponent’s pleaded case under section 12(3) of the Ordinance is that:⁸

“Further or in the alternative the [subject mark] should be refused under Section 12(3) of the Trade Marks Ordinance on the ground that the [subject mark] is similar to earlier marks [i.e. the Opponent’s Trade Marks] that the goods for which the application for registration are identical or similar to those for which the earlier trade marks are protected and that the use of the [subject mark] by the Applicant in relation to those goods is likely to cause confusion on the part of the public.”

29. Section 12(3) of the Ordinance essentially prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of its 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 the subject of the earlier trade mark.

30. 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.

31. The following is a useful summary of the approach to be taken in assessing the requirement of likelihood of confusion:⁹

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

⁸ Amended Grounds of Opposition, para. 23.

⁹ *Specsavers International Healthcare Ltd v ASDA Stores* [2012] FSR 555 at 574-575; *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd (No 2)* (2016) 19 HKCFAR 20 (FACV 15/2015) (29 January 2016).

- (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; and
- (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.

Earlier trade mark

32. Section 5(1) of the Ordinance provides, *inter alia*, that:

“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;”*.

33. I refer to the Opponent’s Trade Marks listed in the **Schedule**. Each of the Opponent’s Trade Marks is a registered trade mark with date of application for registration which is earlier than that of the subject mark. According to section 5(1)(a) of the Ordinance, each of the Opponent’s Trade Marks is an earlier trade mark in relation to the subject mark.

34. On the other hand, the mark “” is not similar to the subject mark at all. An opposition under section 12(3) of the Ordinance based on this mark would necessarily fail. I would therefore focus on the following mark:

Registration No.	Trade Mark	Date of Registration	Specification of goods
302256895	WOMO	21-05-2012	<u>Class 3</u> Soaps; perfumery, essential oils, cosmetics, hair preparations, hair care preparations, products for hair care; toothpastes; deodorants for personal use; all included in Class 3.

Registration No.	Trade Mark	Date of Registration	Specification of goods
			<p data-bbox="769 304 1358 611"><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, purses, wallets, briefcases; umbrellas and parasols; walking sticks; whips, harness and saddlery; all included in Class 18.</p> <p data-bbox="769 674 1358 797"><u>Class 25</u> Clothing, footwear, headgear, belts (clothing); all included in Class 25.</p>

Relevant public

35. The average consumer of the category of goods or services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. The average consumer's degree of attention is likely to vary according to the category of goods or services in question.

36. The subject goods include (i) various cleaning, polishing and personal care products in Class 3; and (ii) various surgical, medical, dental and veterinary apparatus and instruments in Class 10.

37. Those of the subject goods that are in Class 3 are directed at the public at large, whose degree of attention is average. Those of the subject goods that are in Class 10 target professionals from the medical sector and the degree of attention may be higher in relation to them, considering that the goods may have an impact on the patients' health and comfort. The subject goods are likely to be selected from websites, brochures or physical premises. The manner of selection indicates that the visual impact of the marks will take on more importance, although any other aspects of similarity are not to be ignored completely from the analysis.

Comparison of marks

38. The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details.

39. The subject mark consists of a four-letter word “WOLO” in block capitals appearing in a box-like device with a wave-like pattern below the word “WOLO”.

40. The Opponent’s “WOMO” mark consists of a four-letter word in block capitals without any figurative element.

41. Visually, the subject mark consists of a word and a device, whereas the Opponent’s “WOMO” mark consists of a word only. Although the word “WOLO” in the subject mark and the Opponent’s “WOMO” mark each consists of four letters, and share the same first, second and fourth letters, they differ in the 3rd letter (“L” as opposed to “M”). Each of the words “WOLO” and “WOMO” are rather short. The third letter occupies an almost central position in each of those words. The letter “M”, which is almost symmetrical, is visually very different from the letter “L”. The combination of the four letters “WOLO” is therefore visually different from the combination “WOMO”. Furthermore, the device in the subject mark has a certain prominence and is far from being negligible. The overall visual impression created by the subject mark as a whole is very different from that created by the Opponent’s “WOMO” mark.

42. Aurally, the subject mark would be pronounced as “WO-LO” whereas the Opponent’s “WOMO” mark would be pronounced as “WO-MO”. The two marks share the same first syllable “WO” and differ in the second syllable, although the vowel in the second syllable is the same (“O”). The two marks are aurally similar to a moderate degree.

43. Conceptually, neither the word “WOLO” in the subject mark nor the Opponent’s “WOMO” mark has any meaning.

44. I bear in mind that the manner of selection of the subject goods indicates that the visual impact of the marks will take on more importance, although any other aspects of similarity or dissimilarity are not to be ignored completely from the analysis.

45. Having regard to the visual, aural and conceptual similarities and differences between the subject mark and the Opponent’s “WOMO” mark and the overall impression created by each of them, I find that the two marks are only similar to a very low degree.

Comparison of goods

46. The well known tests for assessing similarity in goods and services are found in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117 and *British Sugar Plc v James Robertson & Sons Ltd.* [1996] RPC 281. These require considerations of all relevant factors relating to the goods and services including, *inter alia*, their nature, intended purpose, method of use, whether the goods and services are in competition with each other or are complementary, as well as their users and the channels through which they reach the market.

47. The subject goods and the Opponent's Registered Goods are set out below:

subject goods	Opponent's Registered Goods
<p><u>Class 3</u> Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; all included in class 3.</p> <p><u>Class 10</u> Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopaedic articles; suture materials; all included in class 10.</p>	<p><u>Class 3</u> Soaps; perfumery, essential oils, cosmetics, hair preparations, hair care preparations, products for hair care; toothpastes; deodorants for personal use; all included in Class 3.</p> <p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, purses, wallets, briefcases; umbrellas and parasols; walking sticks; whips, harness and saddlery; all included in Class 18.</p> <p><u>Class 25</u> Clothing, footwear, headgear, belts (clothing); all included in Class 25.</p>

48. Those of the subject goods that are in Class 3 are either identical or similar to those of the Opponent's Registered Goods that are in Class 3.

49. *Soaps; perfumery, essential oils and cosmetics* are identically contained in both lists of goods.

50. *Hair lotions* in the subject goods come within *hair care preparations* in the Opponent's Registered Goods, whilst *dentifrices* in the subject goods include *toothpastes* in the Opponent's Registered Goods. Identical goods are involved.

51. *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations* in the subject goods are all agents used for cleaning. *Polishing preparations* are used to make a product smooth and shiny by rubbing especially with wax or an abrasive. *Scouring preparations* are used to clean or polish (a surface) by washing and rubbing, as with an abrasive cloth. *Abrasive preparations* are substances or materials such as sandpaper, pumice, or emery, used for cleaning, grinding, smoothing or polishing. All of these products are agents for cleaning. To that extent, their nature and purpose are similar to those of *soaps* in the Opponent's Registered Goods. Moreover, they target the same consumers and are sold in the same retail outlets and in the same section in supermarkets. Furthermore, they are similar to bleaching preparations because they target the same consumers and have the same producers and distribution channels. These goods are considered similar to *soaps* in the Opponent's Registered Goods.

52. Regarding those of the subject goods that are in Class 10, they are very different from the Opponent's Registered Goods in terms of their nature and intended purpose. They are not complementary or in competition with each other. Furthermore, they are sold in different outlets, target different consumers and are manufactured by different producers. Those of the subject goods that are in Class 10 are dissimilar to any of the Opponent's Registered Goods.

Distinctiveness of the Opponent's "WOMO" mark

53. The distinctive character of the earlier trade mark is a factor to be taken into account in the assessment of the likelihood of confusion. It is well established that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character either because of its inherent qualities or because of the use that has been made of it.¹⁰

54. In determining the distinctive character of an earlier trade mark, I must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making

¹⁰ *Sabel v Puma* [1998] RPC 199; para. 31(h) above.

that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.¹¹

55. The word “WOMO” has no meaning in relation to the Opponent’s Registered Goods and is inherently distinctive in respect thereof.

56. I have considered the Opponent’s evidence (paragraphs 8 to 14 above). The Opponent claimed to have used the “WOMO” mark since 2012, i.e. shortly before the relevant date. No turnover figures and no invoice in respect of sales of the Opponent’s goods in Hong Kong under the Opponent’s “WOMO” mark have been provided. There is no evidence of actual use of the Opponent’s “WOMO” mark in Hong Kong before the relevant date. There is no evidence that the Opponent has expended any amount to promote the Opponent’s “WOMO” mark in Hong Kong. There is no direct evidence as to the proportion of the relevant section of the public which, because of the Opponent’s “WOMO” mark, identifies any of the Opponent’s Registered Goods as originating from a particular undertaking, and there is no statement from chambers of commerce and industry or other trade and professional associations.

57. I have already found that the word “WOMO” is inherently distinctive of the Opponent’s Registered Goods. Having regard to the Opponent’s evidence, I do not consider that the distinctiveness of the Opponent’s “WOMO” mark has been enhanced through use. Overall, I find the distinctiveness of the Opponent’s “WOMO” mark to be above average.

Likelihood of confusion

58. 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 and services in issue who is deemed to be reasonably well-informed and reasonably observant and circumspect. A lesser degree of similarity between the marks

¹¹ *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] FSR 77.

may be offset by a greater degree of similarity between the goods or services, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra)).

59. Although the subject mark and the Opponent's "WOMO" mark are aurally similar to a moderate degree, the two marks are visually very different. Neither of the marks have any meaning in relation to the goods. Having regard to the overall impression created by each of the subject mark and the Opponent's "WOMO" mark, I find that the two marks are only similar to a very low degree. The average consumer of the subject goods is deemed to be reasonably well informed and reasonably observant and circumspect, and is likely to pay an average to a high level of attention to the goods and the marks used. The subject goods include goods that are identical or similar to the Opponent's Registered Goods as well as goods that are dissimilar. The distinctiveness of the Opponent's "WOMO" mark is above average.

60. Taking into account the combined effect of all of the above considerations, I consider that even when the subject mark is used in relation to those of the subject goods that are identical to the Opponent's Registered Goods, given the very low degree of similarity between the subject mark and the Opponent's "WOMO" mark, the average consumer would unlikely be misled into believing that those goods and the Opponent's Registered Goods offered under the Opponent's "WOMO" mark come from the same or economically-linked undertakings. I conclude that there is no likelihood of confusion even in respect of identical or similar goods, and *a fortiori*, in respect of dissimilar goods.

61. The ground of opposition under section 12(3) of the Ordinance is not made out.

Opposition under section 12(5)(a) of the Ordinance

62. Section 12(5)(a) of the Ordinance provides, *inter alia*, as follows:

"(5) ... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off); ...

and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an "earlier right" in relation to the trade mark."

63. The Opponent claims that:¹²

“Further or in the alternative the [subject mark] should be refused under Section 12(5)(a) of the Trade Marks Ordinance on the ground that use of the [subject mark] in Hong Kong is liable to be prevented by virtue of rules of law protecting unregistered trade marks or other signs used in the course of trade or business (in particular, by virtue of law of passing off) and the Opponent’s Group is the owner of the earlier rights entitling it to prevent such uses, namely rights through the prior use of its trade marks in relation to goods that are identical or similar to those for which the Applicant seeks registration.”

64. The issue for determination is whether at the Application Date, use of the subject mark by the Applicant was liable to be prevented by virtue of the law of passing off.

65. The elements of the tort of passing off as formulated by Lord Oliver in the *JIF* case¹³ have been repeatedly relied upon.¹⁴ Adapted to the facts of the present case, the Opponent has to establish that:

- (a) the Opponent has sufficient **goodwill** attached to any of the Opponent’s Registered Goods in the mind of the purchasing public by association with the Opponent’s “WOMO” mark;
- (b) the Applicant has made a **misrepresentation** leading or likely to lead the public to believe that the subject goods offered by the Applicant are the goods of the Opponent; and
- (c) the Opponent suffers, or is likely to suffer, **damage** by reason of the erroneous belief engendered by the Applicant’s misrepresentation that the source of the Applicant’s subject goods is the same as the source of those offered by the Opponent.

66. The relevant date for determining whether the Opponent has established the necessary goodwill is the date of the application for the mark in question or the date of

¹² Amended Grounds of Opposition, para. 24.

¹³ *Reckitt & Colman Products Limited v. Borden* [1990] RPC 341.

¹⁴ Applied in e.g. *Ping An Securities Ltd v. 中國平安保險 (集團) 股份有限公司* (2009) 12 HKCFAR 808 (FACV 26/2008).

the commencement of the conduct complained of,¹⁵ whichever is earlier. As there is no evidence of the Applicant having used the subject mark before the Application Date, I only need to consider the position as at the Application Date.

67. I have already considered the Opponent's evidence (paragraphs 8 to 14 above). I am not satisfied that the Opponent has sufficient *goodwill* attached to any of the Opponent's Registered Goods in the mind of the purchasing public in Hong Kong by association with the Opponent's "WOMO" mark.

68. Moreover, even if the Opponent can establish that it has sufficient goodwill in the market in Hong Kong by virtue of the use of the Opponent's "WOMO" mark in relation to any of the Opponent's Registered Goods, the degree of similarity between the subject mark and the Opponent's "WOMO" mark is so low that when the subject mark is used in relation to the subject goods, the average consumer would unlikely be misled into believing that those goods and any of the Opponent's Registered Goods offered under the Opponent's "WOMO" mark come from the same or economically-linked undertakings. The Opponent therefore cannot establish the element of *misrepresentation*. It follows that there is nothing from which it could be inferred that the Opponent is likely to suffer *damage* by reason of any erroneous belief engendered by the Applicant's misrepresentation. The ground of opposition under section 12(5) of the Ordinance is not made out.

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

69. Section 11(5)(b) of the Ordinance provides that:

*"(5) A trade mark shall not be registered if, or to the extent that –
... (b) the application for registration of the trade mark is made in bad faith."*

70. The Opponent claims that:¹⁶

"Further or in the alternative the [subject mark] should be refused under Section 11(5)(b) of the Trade Marks Ordinance on the ground that the application for registration of the [subject mark] was made with knowledge of the Opponent's

¹⁵ *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 8 and 9.

¹⁶ Amended Grounds of Opposition, para.21.

Group's reputation and goodwill in its trade marks and was therefore made in bad faith."

71. The term "bad faith" is not defined in the Ordinance. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379, Lindsay J. said in relation to section 3(6) of the UK Trade Marks Act 1994 (equivalent to section 11(5)(b) of the Ordinance):

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

72. In *Harrison v Teton Valley Trading Co (CHINAWHITE)* [2005] FSR 10, the English Court of Appeal held that (at para. 26):

"The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards."

73. Further, in *Ajit Weekly Trade Mark* [2006] RPC 25, the Appointed Person stated as follows:¹⁷

"The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the determination of the objective element."

¹⁷ Applied in *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG (LG Corporation)* HCMP 881/2013, [25]-[27].

74. An allegation that a trade mark has been applied for in bad faith is a serious allegation. It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved (*ROYAL ENFIELD Trade Marks* [2002] RPC 24 at para. 31). The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith (*Brutt Trade Marks* [2007] RPC 19 at para. 29).

75. I have already found that there is no evidence of actual use of the Opponent's "WOMO" mark in Hong Kong before the relevant date (paragraph 14 above). There is no direct evidence that the Applicant has knowledge of the Opponent's "WOMO" mark before applying for registration of the subject mark. Moreover, I am not satisfied that the Opponent has sufficient goodwill attached to any of the Opponent's Registered Goods in the mind of the purchasing public in Hong Kong by association with the Opponent's "WOMO" mark (paragraph 67 above). The claim that the subject application "*was made with knowledge of the Opponent's Group's reputation and goodwill in its trade marks*" is not made out.

76. Furthermore, I have compared the Opponent's "WOMO" mark with the subject mark and find that the degree of similarity between the two marks is so low that when the subject mark is used in relation to the subject goods, the average consumer would unlikely be misled into believing that those goods and any of the Opponent's Registered Goods offered under the Opponent's "WOMO" mark come from the same or economically-linked undertakings.

77. Taking into account all the relevant circumstances of this case, I do not find that there is sufficient basis for concluding that the Applicant's decision to adopt and to apply for registration of the subject mark would be regarded as in bad faith by persons adopting proper standards. The ground of opposition under section 11(5)(b) of the Ordinance is also not made out.

Conclusion and Costs

78. I have considered each of the grounds of opposition relied on by the Opponent and found that none of them has been made out. The opposition against the subject application therefore fails.

79. As the opposition has failed, I award the Applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party may make within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

(Finnie Quek)
for Registrar of Trade Marks
28 October 2016

Schedule
Opponent's Trade Marks

Registration No.	Trade Mark	Date of Registration	Specification of goods
302256895	WOMO	21-05-2012	<p><u>Class 3</u> Soaps; perfumery, essential oils, cosmetics, hair preparations, hair care preparations, products for hair care; toothpastes; deodorants for personal use; all included in Class 3.</p> <p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, purses, wallets, briefcases; umbrellas and parasols; walking sticks; whips, harness and saddlery; all included in Class 18.</p> <p><u>Class 25</u> Clothing, footwear, headgear, belts (clothing); all included in Class 25.</p>
302256912		21-05-2012	<p><u>Class 3</u> Soaps; perfumery, essential oils, cosmetics, hair preparations, hair care preparations, products for hair care; toothpastes; deodorants for personal use; all included in Class 3.</p> <p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, purses, wallets, briefcases; umbrellas and parasols; walking sticks; whips, harness and saddlery; all included in Class 18.</p> <p><u>Class 25</u> Clothing, footwear, headgear, belts (clothing); all included in Class 25.</p>