

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 302757862

MARKS :



CLASSES : 10, 25

APPLICANT : HUMANA MEDICAL LTD

OPPONENT : SWISS FEDERAL INSTITUTE OF INTELLECTUAL PROPERTY

STATEMENT OF REASONS FOR DECISION

Background

1. On 7 October 2013 (“Application Date”), HUMANA MEDICAL LTD (“Applicant”) filed an application (“subject application”) under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for registration of the following series of four marks (collectively, the “subject marks”) under Trade Mark Application No. 302757862:

 (“subject mark A”)

 (“subject mark B”)

 (“subject mark C”)

 (“subject mark D”)

The Applicant claims the colours red and blue as elements of the subject marks.

2. Registration of the subject marks is sought in respect of the following goods (“subject goods”):

Class 10

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

Class 25

Clothing, footwear, headgear.

3. Particulars of the subject application were published on 29 November 2013. SWISS FEDERAL INSTITUTE OF INTELLECTUAL PROPERTY (“Opponent”) filed a notice of opposition on 26 February 2014 (“Notice of Opposition”) with a statement of grounds of opposition (“Statement of Grounds”). The Applicant filed a counter-statement on 9 April 2014 in response to the Notice of Opposition.

4. The Opponent’s evidence consists of a statutory declaration of LEUNG Hoi Shan made on 26 September 2014 (“Leung’s Declaration”).

5. The Applicant’s evidence consists of a statutory declaration of LO Yin Man made on 21 January 2015 (“Lo’s Declaration”).

6. The opposition was fixed to be heard on 26 October 2016. Neither the Opponent nor the Applicant filed any notice of intention to appear at the hearing (Form T12). Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559A), both parties are treated as not intending to appear at the hearing. I therefore proceed to decide the matter without a hearing pursuant to rule 75(b)(i) of the Trade Marks Rules.

Grounds

7. The grounds upon which the Opponent opposes the subject application are:¹

- (a) Each of the subject marks is not a trade mark within the meaning of section 3(1) of the Ordinance because it is not capable of distinguishing the Applicant’s goods and services from those of other traders, including without limitation, from those of the Opponent; the subject mark should be refused registration under section 11(1)(a) of the Ordinance.

¹ Statement of Grounds, para. 7.

- (b) Each of the subject marks is not registrable as a trade mark under sections 11(1)(b)-(d) of the Ordinance.
- (c) Each of the subject marks contains a device which is similar to a national flag/coat of arms, and therefore is also not registrable as a trade mark under sections 11(6) and 11(7)² of the Ordinance.
- (d) Given the subject goods are identical and/or similar to goods for which Switzerland is a well-known geographical origin, the use and/or registration of the subject marks is likely to deceive the public and therefore should be refused registration under section 11(4) of the Ordinance.
- (e) The use of the subject marks is prohibited in Hong Kong under or by virtue of law including but not limited to section 7 of the Trade Descriptions Ordinance (Cap. 362) or made in bad faith and should be refused registration under section(s) 11(5)(a) and/or 11(5)(b) of the Ordinance.
- (f) Use of the subject marks in Hong Kong is liable to be prevented 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 or an earlier right); the subject marks should be refused registration under section(s) 12(5)(a) and/or 12(5)(b)³ of the Ordinance.

The Opponent

8. According to Leung's Declaration, the Opponent is the governmental agency for all matters concerning intellectual property in Switzerland, and is responsible for drafting legislation in the field of intellectual property and executing such legislation within its range of competence. It also represents Switzerland at an international level in areas concerning intellectual property and acts as a consultant to the Swiss Federal Council and other government entities.⁴

² Para. 7 iii of the Statement of Grounds refers to sections "6 and 7" of the Ordinance. As these two sections do not refer to national flag/coat of arms, the reference to sections "6 and 7" is probably a typographical error, and should be referring to sections 11(6) and 11(7) of the Ordinance instead.

³ Para. 7 vi of the Statement of Grounds refers to section "15(5)(b)" of the Ordinance. As there is no subsection (5) in section 15 of the Ordinance, the reference to section "15(5)(b)" is probably a typographical error, and should be referring to section 12(5)(b) of the Ordinance instead.

⁴ Leung's Declaration, para. 1.

The Applicant

9. The Applicant appears to be a limited company with an address in Hong Kong. Lo's Declaration filed in support of the subject application consists mainly of submissions, and does not contain much information about the business and operation of the Applicant or its use of marks.

Opposition under section 11(7) of the Ordinance

10. The Opponent's case is that each of the subject marks contains a device which is similar to the Swiss flag/coat of arms.

11. Section 11(7) of the Ordinance provides that:

"A trade mark shall not be registered in the cases specified in section 64 (national emblems, etc.) and section 65 (emblems, etc., of certain international organizations)."

12. Section 64 of the Ordinance provides, *inter alia*, that:

*"(1) ... a trade mark which consists of or contains the **flag** of a Paris Convention country or WTO member shall not be registered without the authorization of the competent authorities of that country or member, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization.*

*(2) ... a trade mark which consists of or contains the armorial bearings or any other **state emblem** of a Paris Convention country or WTO member which is protected under the Paris Convention (including any armorial bearings or state emblems entitled to such protection by virtue of the World Trade Organization Agreement) shall not be registered without the authorization of the competent authorities of that country or member.*

*(3) A trade mark which consists of or contains an **official sign** or **hallmark** adopted by a Paris Convention country or WTO member and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention (including any sign or hallmark entitled to such protection by virtue of the World Trade Organization Agreement), be registered in relation to goods or services which are the same as, or are of a similar kind to, those in relation to which it indicates control and warranty, without the authorization of the competent authorities of that country or member.*

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorized to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorization of the competent authorities of a Paris Convention country or WTO member is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the trade mark in Hong Kong without their authorization.” (emphasis added)

13. Swiss Confederation is a country specified in Schedule 1 to the Ordinance as being a country which has acceded to the Paris Convention. It is therefore a Paris Convention country as defined in section 2(1) of the Ordinance.

14. Section 66(1) of the Ordinance provides that:

*“(1) For the purposes of **section 64** (national emblems, etc.), **state emblems of a country (other than the national flag), and official signs or hallmarks**, shall be regarded as **protected** under the Paris Convention, or as protected under the Paris Convention by virtue of the World Trade Organization Agreement, **only if**, or to the extent that-*

*(a) the country in question has **notified** the World Intellectual Property Organization in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, sign or hallmark;*

(b) the notification remains in force; and

(c) no objection to the notification has been transmitted to the World Intellectual Property Organization on behalf of Hong Kong in accordance with Article 6ter(4) of the Paris Convention or any such objection has been withdrawn.” (emphasis added)

15. In other words, whilst a state emblem (other than national flags) or an official sign or hallmark would have to be notified in the manner described in section 66(1)(a) of the Ordinance before it can be protected, it is not necessary for a national flag to be so notified before it can be protected.

16. Section 66(4) of the Ordinance provides that:

*“(4) The **Registrar shall keep** and make available for public inspection at the Registry by any person, during the normal business hours of the Registry, and free of charge, a **list of –***

(a) the state emblems and official signs or hallmarks; and

(b) the emblems, abbreviations and names of international intergovernmental organizations,

*which are for the time being **protected** under the Paris Convention **by virtue of a notification** under Article 6ter(3) of the Paris Convention.” (emphasis added)*

17. The list referred to in section 66(4) of the Ordinance is accessible from the website of the Intellectual Property Department ⁵ (http://www.ipd.gov.hk/eng/electronic_services.htm) through the following hyperlink made with the permission of the World Intellectual Property Organization (WIPO):

<http://www.wipo.int/ipdl/en/search/6ter/search-struct.jsp>

18. The national flag of Swiss Confederation consists of a white cross on a red field:



19. The following armorial bearing can be found in the list referred to in paragraph 17 above:



⁵ The Director of Intellectual Property holds the office of Registrar of Trade Marks (section 4 of the Director of Intellectual Property (Establishment) Ordinance (Cap.412)).

20. Sections 64(1) and 64(2) of the Ordinance prohibit the registration and use of the national flag and state emblems of a Paris Convention country not only as a trade mark, but also as an element of a trade mark. Moreover, the prohibition applies not only to an exact copy of a national flag or a state emblem, but also to anything which from a heraldic point of view imitates any such flag or state emblem (section 64(4) of the Ordinance). In other words, a trade mark or an element of a trade mark which does not exactly reproduce a national flag or a state emblem may nevertheless come under the prohibition of sections 64(1) and 64(2) where it is perceived by the relevant public as imitating such a flag or emblem (*American Clothing Associates NV v OHIM* [2010] EMTR 3, para. 50).

21. So far as the expression “imitation from a heraldic point of view” in section 64(4) of the Ordinance is concerned, a difference detected by a specialist in heraldic art between the trade mark applied for (or an element thereof) and the relevant flag or state emblem will not necessarily be perceived by the average consumer who, in spite of differences at the level of certain heraldic details, can see in the trade mark (or an element thereof) an imitation of the flag or emblem in question (*American Clothing Associates* (supra) para. 51).

22. In the present case, each of the subject marks consists of the words “Happy Walking” and the Chinese characters “步足履” with the following device (“subject device”) at the letter “a” in the word “Walking”:



The Applicant claims the colours red and blue as elements of the subject marks.

23. The Applicant claims that there are 12 letters of the English alphabet and three Chinese characters in each of the subject marks, and that the subject device is not a key element in the subject marks as “it consists only 1/15 of [each of the subject marks].”⁶ Moreover, the Applicant claims that the subject device is not similar to the “Swiss” sign as it consists of an “a” shape boundary with a white cross inside, and is only part of the word “walking”.⁷

24. The subject device consists of a white cross set against a red background. Although small in size, the subject device with its red and white colours stands out in

⁶ Lo’s Declaration, para. 4.

⁷ Lo’s Declaration, para. 7.

each of the subject marks. Although there is a small protrusion from the lower-right portion of the subject device, the small protrusion is not very prominent, especially when it is set against a blue background as in subject mark C and subject mark D.⁸ The overall impression given by the subject device in the context of each of the subject marks is that of a white cross set against a red background.

25. The fact that the flag or emblem in question is stylized or that only a part of the flag or emblem is used does not mean that there is no imitation from a heraldic point of view (*Concept v OHIM* [2004] ETMR 81, para. 41). It is sufficient for a single element of a trade mark applied for to represent a flag or emblem covered by section 64 or an imitation thereof for that mark to be refused registration (*American Clothing Associates* (supra) para. 59).

26. In the present case, like the flag and the emblem set out in paragraphs 18 and 19 above, the subject device consists of a white cross set against a red background. In spite of differences at the level of certain details, the average consumer of the subject goods would still see the subject device in the subject marks as an imitation of the flag or the emblem.

27. I find that each of the subject marks contains the subject device which from a heraldic point of view imitates the flag or the emblem set out in paragraphs 18 and 19 above. There is no evidence that registration of the subject marks containing the subject device is authorized by the competent authorities in the Swiss Confederation. In fact, it is opposed by the Opponent. I find that the ground of opposition under section 11(7) of the Ordinance is made out.

28. As I have found in favour of the Opponent on the ground of opposition under section 11(7) of the Ordinance, it is not necessary for me to consider the grounds under other sections of the Ordinance referred to in paragraph 7 above.

Costs

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

⁸ The subject marks are applied for as a series of trade marks, i.e. they are considered to be marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark (section 51(3) of the Ordinance).

30. 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.

(Finnie Quek)
for Registrar of Trade Marks
30 March 2017