

TRADE MARKS ORDINANCE (Cap. 559)

OPPOSITION TO TRADE MARK APPLICATION NO.: 302954656

MARK: OLYMPRIX 奧林披治

CLASS: 41

APPLICANT: MATHEMATICAL CORPORATION (HK) LIMITED

OPPONENTS: COMITE INTERNATIONAL OLYMPIQUE

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 April 2014, Mathematical Corporation (HK) Limited (“the Applicant”) filed an application (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for the registration of the mark “OLYMPRIX 奧林披治” (“the subject mark”).
2. Registration is sought in respect of “Education; providing of training; entertainment; sporting and cultural activities” in Class 41 (“the subject services”).
3. Particulars of the subject application were published on 27 June 2014. On 26 September 2014, Comite International Olympique (“the Opponent”) filed a notice of opposition to the subject application together with a statement of grounds of opposition (“Notice of Opposition”). In response to the Notice of Opposition filed, a counter-statement (“Counter-statement”) was filed by the Applicant on 24 December 2014.
4. As evidence in support of the opposition, on 29 June 2015 the Opponent filed under Rule 18 of the Trade Marks Rules (Cap.559, sub. leg.)(“the Rules”) a

statutory declaration made by Christophe De Kepper and Howard Stupp, the Director General and Director of Legal Affairs of the Opponent, together with exhibits (“the Opponent’s SD”). The Applicant did not file under Rule 19 of the Rules any evidence in support of its application.

5. The Opposition hearing was fixed to be heard on 8 December 2016. Neither party filed a notice of intention to appear at the hearing. But the Opponent has filed written submissions on 2 December 2016. Pursuant to rule 74(5) of the Rules, both parties are treated as not intending to appear at the hearing. I now proceed to decide the matter without a hearing under rule 75 of the Rules.

Grounds of opposition

6. The grounds on which the Opponent opposes registration of the subject marks as stated in the Notice of Opposition are under sections 11(4)(b), 11(5)(a), 11(5)(b), 12(3), 12(4) and 12(5)(a) of the Ordinance.

Counter-statement

7. The Applicant denies or does not admit all grounds pleaded in the Notice of Opposition. It asserts in the Counter-statement that the subject mark is differentiable from the Opponent’s trade marks and is not likely to deceive the public or cause any confusion on the part of the public and that there is no passing off of the Opponent’s trade marks.

Relevant date

8. The relevant date for considering the opposition is 8 April 2014, that is the filing date of the subject application for registration.

The Opponent's evidence

9. The Opponent was established in 1894 and is based in Switzerland with the prime responsibility to supervise the organizing and running of the Olympic Games. The Opponent is the owner of all rights in the Olympic trade marks, symbols, flag, motto, emblem, anthem, and other intangible properties associated with the Olympic Games.
10. The Opponent adopted the word OLYMPIC as early as in 1894 in relation to organizing sporting events. Since then, the trade mark OLYMPIC (“English Mark”) has been continuously, extensively and exclusively used by the Opponent. Exhibit A to the Opponent’s SD contains a copy of the Opponent’s website supporting the said date of adoption of the English Mark.
11. The Opponent has been organizing the modern Olympic Games and Youth Olympic Games every four years since 1896. Today the Opponent comprises a membership of 100 active members, 33 honorary members and 1 honour member and is considered to be the supreme authority of the modern Olympic Movement¹. It promotes collaboration between all parties of the Olympic family, including the National Olympic Committees (NOCs), the International Sports Federations (IFs), the athletes, the Organising committees for the Olympic Games (OCOGs), The Olympic Programme (TOP) partners, broadcast partners and United Nations agencies through a wide range of programmes and projects. Exhibit B to the Opponent’s SD contains a copy of the Olympic Charter that sets out the rules and guidelines for the organization of the Olympic Games and for governing the Olympic Movement.
12. The Olympic Games have been broadcast on television since 1936. The Olympic Games held in Beijing in 2008 and London in 2012 were watched by about 4.3 billion and 4.8 billion viewers respectively around the world including Hong Kong. Exhibits C and D to the Opponent’s SD contain extracts from reports in support of the broadcasting facts and figures.
13. The Opponent has entered into sponsoring agreements with leading companies

¹The Olympic Movement encompasses organisations, athletes and other persons who agree to be

from all sectors, known as Olympic Partners, which pay significant fees for the rights to combine their signs/trademarks with names such as “Olympic”, “The Olympics” or the Olympic Symbol and their local transliterations. The Olympic Games licensing and domestic sponsorship programmes are managed by the OCOGs under the direction of the Opponent. The Opponent and the Olympic Movement finance the Olympic events with the contribution of these sponsors and licensees. The Opponent and its related organizations provide a range of diverse goods and services including, inter alia, in classes 1 to 7, 10 to 12, 14, 16 to 19, 25, 28 to 30, 32 and 35 to 44. Owing to such use, an immense goodwill and reputation has inured to the English mark.

14. The English Mark and its local transliterations including “奥林匹克” (“Chinese Mark”) appear on millions of products of the Opponent’s sponsors which include some of the most well-known companies in the world, and the consumers would see and associate these marks with the Opponent. The official partners receive exclusive marketing rights and association with the Olympic brand. They may exercise these rights worldwide and may activate marketing initiatives with members of the Olympic Movement that participate in the partnership programme. The Opponent’s SD has set out the number of partners and the revenue earned in the past seven games. The revenue has increased from US\$96 million in 1985-1988 to US\$950 million in 2009-2012. Exhibits E to H contain copies of documents illustrating the use of the English Mark and the Olympic symbols by the said sponsors.
15. The Olympic Games would not be financially viable without the financial contribution of the Olympic Partners and sponsors. The Opponent has one of the most effective international marketing platforms in the world, reaching billions of people in over 200 countries and territories. The revenue generated by commercial partnerships accounts for more than 40% of Olympic revenues. Each level of sponsorship entitles companies to different marketing rights in various regions and categories and the use of designated Olympic images and marks. Exhibit I to the Opponent’s SD contains the Opponent’s media guide

guided by the principles of the Olympic Charter (see Exhibit A to the Opponent’s SD).

for the London Olympics 2012.

16. By association with the Olympic Movement, the Olympic Partners are provided with unparalleled opportunities to promote their brands and enhance their reputation. It is crucial for the Opponent to ensure that access to the Olympic Protected Identifications or any expressions closely resembling a Protected Identification is reserved to the selected partners and sponsors. The Opponent's reputation for building brands have been discussed in various articles and publications. Exhibit J to the Opponent's SD contains extracts from the book "The Olympic Games Effect – How Sports Marketing Builds Strong Brands".
17. The Olympic brand value has gained unparalleled heights by way of the sheer respect that the Olympic Games command worldwide. Exhibits K and L contain a copy of the 2004 Sponsorship Intelligence Survey and the 2008 Olympic Global Research for the Olympic brand.
18. The Opponent has applied for and obtained registrations for the English Mark and its variants (mainly local transliterations) in various classes of goods and services in many jurisdictions worldwide. Exhibit M to the Opponent's SD contains a schedule setting out some of the said registrations. The Opponent's marks appear on its goods and services as well as in connection with all the activities, programmes and projects undertaken by the Opponent in various parts of the world, including Hong Kong. The Opponent's marks are well-known trade marks in these countries and the Opponent is world renowned by virtue of the Olympic Games it organizes.
19. In Hong Kong, the Opponent is the proprietor of the English Mark, Chinese Mark and the mark "奥运" in various classes of goods and services. Exhibit N to the Opponent's SD contains a copy of the said Hong Kong registrations.
20. Hong Kong has competed in 16 Summer Olympic Games and 4 Winter Olympic Games since 1952. Hong Kong is a member of the Olympic Council since the creation of the NOC of Hong Kong (i.e. Sports Federation & Olympic Committee of Hong Kong) in 1950. The NOCs (including the one of Hong Kong) receive financial support for the training and development of Olympic

teams, Olympic athletes and Olympics hopefuls. The Opponent distributes sponsorship programme revenue to each of the NOCs throughout the world. Exhibit O to the Opponent's SD contains an extract from the Olympic Solidarity report showing amounts allocated to each Asian country or territory including Hong Kong for training and support of athletes. The NOC of Hong Kong was and is authorized by the Opponent to use in Hong Kong the Opponent's marks and other Olympic properties. Exhibit P contains a printout from the official website of the Hong Kong NOC and Exhibit Q contains information on the Hong Kong athletes who have competed in the Olympic Games and the Medalists.

21. By virtue of the continuous and wide spread use and publicity in relation to sports and allied activities and products over a century, the Opponent's marks have acquired the status of well known trade marks in Hong Kong and have gained tremendous goodwill and enviable reputation that people worldwide including those in Hong Kong will invariably believe that any products or services under these marks are associated with or related to the Opponent. The Opponent's marks have become distinctive and have acquired secondary significance with the Opponent alone.
22. The Opponent is the rightful proprietor of the English Mark and its variants, which are the most valuable assets of the Opponent. The Opponent's marks and the Olympic Games are household names in Hong Kong and the English Mark makes an immediate association in the mind of the relevant public with the Olympic Games and all the associated entities. The Opponent's marks are world famous marks and are registered in many countries of the world and the same are being used and publicized extensively throughout the world including Hong Kong. In the circumstances, the Opponent believes that any adoption of the Opponent's marks or similar marks by any third party would trade upon and benefit from the goodwill and reputation enjoyed by the Opponent in its marks.
23. The Office for Harmonization in the Internal Market (OHIM) has in several decisions acknowledged the repute of the English Mark. Exhibit R to the Opponent's SD contains a copy of the relevant decisions of OHIM and other courts in Europe.

Opposition under section 12(3) of the Ordinance

24. Section 12(3) of the Ordinance provides as follows:

“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.”

25. 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.

26. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994 which implements Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1988 of the Council of the European Communities. In determining the issue under section 12(3), I take into account the guidance and principles provided by the European Court of Justice (ECJ) in *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 B.V.* [2000] F.S.R. 77 and *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 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* [2015] 1 HKLRD414. In *Tsit Wing*, Lam VP cited (at paragraph 35) the following propositions (which were endorsed by Kitchen LJ in *Specsavers* (at paragraph 52)) as useful guidelines for assessing likelihood of confusion –

“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.”

27. Section 12(3) 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 the same as or similar to those the subject of the earlier trade mark. I must therefore consider whether there are similarities between the subject mark and the Opponent’s trade marks and the services covered, and whether they would combine to create a likelihood of confusion.
28. In its written submissions, the Opponent only sought to rely on the English Mark and Chinese Mark registered in class 41 (see Annex for details) in Hong Kong in support of its opposition under section 12(3) of the Ordinance. Both marks have been set out in the Notice of Opposition and each of them is an earlier mark under section 5(1)(a) of the Ordinance in relation to the subject mark as it has a date of the application for registration earlier than that of the subject mark. Each of the earlier marks must be considered in turn for the purpose of determining whether it prevents acceptance of the subject application for registration under section 12(3) of the Ordinance (*Torremer Trade Mark* [2003] R.P.C. 4). I will first consider the English Mark.

The Opponent’s English Mark

Distinctiveness of the Opponent’s English Mark

29. The Opponent’s English Mark consists of the word “OLYMPIC” which means “relating to the Olympic Games” (<https://www.merriam-webster.com/dictionary/Olympic>). It is the Opponent’s case that the English Mark enjoys high fame and reputation due to its long history and extensive use in Hong Kong and worldwide.
30. As evidenced by the Opponent’s SD and exhibits thereto, I have no doubt in finding that the English Mark has acquired a high level of distinctiveness in Hong Kong through its extensive and long period of use. In particular, I note that the NOC of Hong Kong was set up in 1950 and Hong Kong has competed in the Olympic Games since 1952 and financial support has been given for the

training and development of Olympic teams, athletes and hopefuls in Hong Kong.

Comparison of marks

- 31 The subject mark consists of an eight-letter English word “OLYMPRIX” on the left in plain capital letters and a four-character Chinese phrase “奧林披治” on the right in plain font type. I consider both the Chinese and English components of the subject mark are distinctive and the English component is to some degree more dominant due to its position at the beginning of the mark and that the Chinese component, of similar length, is a mere transliteration of the English component. The Opponent’s English Mark is a seven-letter word “OLYMPIC” in plain capital letters. The Applicant alleged in the Counter-statement that the subject mark is a composition of two groups of English and Chinese words, namely “OLYMPRIX” and “奧林披治”, which strongly differentiates it from the Opponent’s earlier marks.
- 32 In comparing the marks, it is not appropriate to concentrate on the similarities to the exclusion of the differences between the marks and one cannot assume that because an element of the marks is identical the marks are similar unless the identical part constitutes the dominant element in the overall impression created by each mark, such that all the other components are insignificant (*Kerly’s Law of Trade Marks and Trade Names* (15th edition), paragraph 9-093).
- 33 I bear in mind that an average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, and rarely has the chance to make direct comparisons between marks but must instead rely upon the imperfect picture of them he has kept in his mind. I also take note that consumers generally pay greater attention to the beginning than to the end of a mark.
- 34 Visually, the English component of the subject mark and the Opponent’s English Mark are similar in length and they coincide in the first five capital letters “OLYMP” as well as the second last capital letter “I”. The marks differ in the respective remaining English letters and in the Chinese phrase, which occupies a

secondary position, of the subject mark. When the effect of imperfect recollection of marks is taken into account, I consider that there is a moderate degree of visual similarity between the subject mark and the Opponent's English Mark given the identical letters at the beginning of the marks and the similarity in length of the English components.

- 35 Aurally, the English component of the subject mark and the Opponent's English Mark are hardly distinguishable as their pronunciations coincide in the first two syllables "ə-lɪm" and resemble closely between "pri:" and "pɪk". In addition, the first three syllables of the Chinese component, being a mere transliteration of the English component, of the subject mark also sound highly similar to the Opponent's English Mark. Therefore, I consider that the subject mark is aurally similar to a moderate to high degree to the Opponent's English Mark.
36. Conceptually, the Opponent's English Mark relates to the world famous Olympic Games. While the Applicant argued in the Counter-statement that the respective suffixes "PRIX" and "披治" of the subject mark's English and Chinese components are related to race cars competition, I find that their prefixes "OLYMP" and "奧林" would easily be perceived as relating to the Olympic Games. I therefore consider the subject mark is conceptually similar to the Opponent's English Mark to a moderate degree.
37. Having regard to their visual, aural and conceptual similarities and differences and the effect of imperfect recollection of marks, when the marks are considered in their entirety, I find their differences, including the additional Chinese component of the subject mark, are insufficient to counteract the similarities given by the presence of the highly similar English words "OLYMPRIX" and "OLYMPIC". Consequently, I consider that the overall impression created by the subject mark, bearing in mind its distinctive and dominant components, is similar to that created by the Opponent's English Mark to a moderate degree.

Comparison of goods

38. Guidance on the approach to be adopted in comparing goods and services is given in *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281, in which Mr Justice Jacob considered, at page 296, the following factors to be

relevant in determining whether or not there is similarity:

- (i) The respective uses of the respective goods or services;
- (ii) The respective users of the respective goods or services;
- (iii) The physical nature of the goods or acts of service;
- (iv) The respective trade channels through which the goods or services reach the market;
- (v) 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
- (vi) 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.

39. Similar factors are also referred to in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, at paragraph 23:

“In assessing the similarity of the goods or services concerned,... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

40. The Opponent submitted that the subject services are identical and/or similar to the services covered by each of the Opponent’s earlier marks.

41. For the Opponent’s English Mark, I find that the “Organizing and conducting sporting and cultural activities, sports competitions; film production” are highly similar to “sporting and cultural activities” and “entertainment” of the subject services, and the “publication of books and of texts (other than publicity texts)” is similar to “education; providing of training” of the subject services.

Likelihood of confusion

42. The likelihood of confusion must be appreciated globally, taking account of all relevant factors all of which have a degree of interdependency. The matter

must be judged through the eyes of the average consumer of the goods who is deemed to be reasonably well-informed and reasonably observant and circumspect. In this case, the relevant consumers for the services in question are members of the general public who would exercise an average level of care and attention when purchasing these services.

43. I have already found in paragraphs 37 and 41 above that the subject mark is moderately similar to the Opponent's English Mark and the subject services in class 41 are highly similar or similar to the services registered under the Opponent's English Mark in class 41.
44. Taking into account the combined effect of all of the above considerations, including the high distinctiveness acquired through use of the Opponent's English Mark and the degree of similarity of marks and services, when the subject mark is used in relation to the subject services in class 41, I consider that the average consumer would be confused into thinking that those services and the services offered under the Opponent's English Mark come from the same or economically-linked undertakings.
45. The opposition under section 12(3) therefore succeeds, on the basis of the Opponent's English Mark, in respect of the subject services in class 41. There is no need for me to further consider whether the opposition under section 12(3) would also succeed by relying on the Opponent's Chinese Mark.

Opposition under other sections of the Ordinance

46. Since the opposition against the subject application succeeds under section 12(3), I am not required to consider further the other grounds of opposition under other sections of the Ordinance.

Costs

47. As the opposition has succeeded, I award the Opponents costs. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes 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.

(Connie Law)
for Registrar of Trade Marks

10 April 2017

Annex

	Trade Mark No.	Trade Mark	Date of Registration	Specification
1	199602106AA	OLYMPIC	1-4-1993	<u>Class 41</u> organising and conducting sporting and cultural activities, sports competitions; film production; publication of books and of texts (other than publicity texts); all relating to Olympic Games; all included in Class 41.
2	301049003AA	奥林匹克	11-2-2008	<u>Class 41</u> Entertainment; sporting and cultural activities, television sporting and cultural entertainment; organization of cultural and educational exhibitions; organisation of lotteries and competitions; betting and gaming services relating to or in conjunction with sport; entertainment services provided at or relating to sports events; organisation of sporting and cultural events and activities; organisation of sporting competitions; management of sporting facilities; administration of the participation of national teams to an international athletic competition; rental services for audio and video equipment; production, presentation, distribution of films and video and sounds recordings; rental of films and video and sounds recordings; presentation, networking and/or rental of interactive education and entertainment products; radio and television coverage of sports and sporting events; radio and television program and video tapes production services; production of animated movies; production of animated television programs; seat booking

				<p>services for shows and sporting events; timing of sports events; organisation of beauty contests; interactive entertainment; on-line gambling services; providing of games over the Internet; providing of raffle services; information relating to entertainment or education, provided on-line from a computer database or the Internet; electronic games services provided by means of the Internet; providing digital music from the Internet; providing digital music from MP3 Internet web sites; sport record and statistical information services; leasing of recorded sound and images; audio production services; providing sporting results; information related to sporting events provided on-line from a computer database or from the Internet; providing digital music (non-downloadable).</p>
3	301049003AB	奥林匹克	11-2-2008	<p><u>Class 41</u> Education; providing of training; providing on-line electronic publications; publication of books, reviews, journals, magazines, texts (other than publicity texts); on-line publication of electronic books, reviews, journals, magazines, texts (other than publicity texts); publishing services.</p>