

TRADE MARKS ORDINANCE (Cap. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 303081988

MARK:



CLASSES: 3 and 35

APPLICANT: CHAN, KWONG (陳光)

OPPONENT: AGAS (HONG KONG) LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 28 July 2014, CHAN, KWONG (陳光) (“the Applicant”) filed an application (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for registration of the following mark:



(“the subject mark”).

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

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; non-medicated skin care preparations; facial cleansing milk; perfumery,


essential oils, cosmetics, shampoos, hair lotions; bath lotions; dentifrices; all included in Class 3.

Class 35

Retailing and wholesaling services relating to bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, non-medicated skin care preparations, facial cleansing milk, perfumery, essential oils, cosmetics, shampoos, hair lotions, bath lotions, dentifrices; all included in Class 35.

3. Particulars of the subject application were published on 18 February 2015. On 15 May 2015, AGAS (HONG KONG) LIMITED (“the Opponent”) filed a notice of opposition (“the Notice of Opposition”) with a statement of the grounds of opposition (“the Statement of Grounds”). In response to the Notice of Opposition filed, the Applicant filed a counter-statement on 25 June 2015.
4. The Opponent’s evidence consists of:
 - (a) a declaration of Lo Shun Kei, Director of the Opponent, made on 24 June 2016 (“the Opponent’s 1st Declaration”); and
 - (b) a second declaration of Lo Shun Kei made on 20 September 2017 (“the Opponent’s 2nd Declaration”).
5. The Applicant’s evidence consists of a declaration of the Applicant made on 20 December 2016 (“the Applicant’s Declaration”).
6. The opposition was fixed to be heard on 8 August 2018. Neither party filed a notice of intention to appear at the hearing (Form T12) within the prescribed period. Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559A) (“the Rules”), 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) of the Rules.

Grounds of opposition

7. According to the Statement of Grounds, the Opponent is a limited liability company in Hong Kong that is specialised in the fashion industry. The Opponent claims that it is the owner of the “**Leaveland** ” mark (“the Leaveland Mark”) including the registrations for the same in Hong Kong for goods in classes 25 and 14 (Trade Mark Nos. 19893480 and 19910907) (collectively, “the Hong Kong Registered Marks”). It further claims that the Leaveland Mark has been used in respect of goods in classes 14 and 25 and has acquired substantial goodwill and reputation in Hong Kong and elsewhere.
8. The Opponent contends that the subject mark is identical or confusingly similar to the Leaveland Mark. The use and registration of the subject mark by the Applicant will inevitably cause confusion and give rise to a mistaken belief that the subject goods and services also emanate from the Opponent.
9. The Opponent further contends that the Applicant is located in Hong Kong and should be well aware of the Opponent’s business and mark. The combination of the word “Leaveland” (a coined word without dictionary meaning) and the leaf device is not a common and usual expression used in the relevant industries. It is unlikely that the subject mark has been chosen randomly.
10. The Opponent opposes the subject application under the following sections of the Ordinance:
 - (a) section 3(1) / 11(1)(a);
 - (b) section 11(1)(b);
 - (c) section 11(4)(b);
 - (d) section 11(5)(a);
 - (e) section 11(5)(b);
 - (f) section 12(3)(c);
 - (g) section 12(4); and
 - (h) section 12(5)(a).

Counter-statement

11. In the counter-statement, the Applicant denies most of the claims made by the Opponent in the Statement of Grounds.
12. The Applicant admits that the Opponent is the registered owner of the Hong Kong Registered Marks. However, he claims that he is the founder of the original owner of the Hong Kong Registered Marks, Chiu Yeung Shoes Factory Limited (“CYSFL”). He also claims that the Hong Kong Registered Marks were used by CYSFL and its sister company, Leaveland International Limited (“Leaveland International”) for goods in classes 25 and 14 until the assignment of the same to California Insurance Company Limited (“California Insurance”) in 1994 and 1998 respectively. He emphasises that the Opponent subsequently acquired the Hong Kong Registered Marks by way of assignment.
13. The Applicant admits that “Leaveland” is a coined word and the leaf device is not a common and usual sign used in the relevant industries. However, he claims that the Leaveland Mark and the elements therein were created by him in 1989 and he owns the copyright in the same. The Applicant avers that the subject goods and services are entirely different from those covered by the Hong Kong Registered Marks, and that he is entitled to use the subject mark on his goods and services.
14. The Applicant claims that he has no knowledge of the Opponent’s business and its use of the Leaveland Mark.

Relevant date

15. The relevant date for considering the opposition is 28 July 2014, that is the filing date of the application for registration of the subject mark.

Evidence of the Opponent

16. According to the Opponent's 1st Declaration, the Opponent was incorporated in Hong Kong on 22 May 2013.¹ Its predecessor in business was Agas International Trading Company ("Agas International"), an unincorporated business engaged in the manufacture and sales of shoes established in 2002.²
17. The Opponent states that:
- (a) Between July 2003 and December 2006, Agas International was authorised by Kam Kee Rubber Works Ltd. (錦記樹膠製品廠有限公司) to act as the sole licensee to manufacture, promote and sell class 25 goods (including shoes, clothing and sports articles) under the Leaveland Mark in Hong Kong and Macau;³
 - (b) Between October 2003 and September 2008, Agas International as sole distributor authorised Full Dragon Corporation Ltd. ("Full Dragon") to act as the sole licensee to design, manufacture, promote and sell clothing under the LEAVELAND brand in Hong Kong and Macau;⁴ and
 - (c) Between January 2009 and December 2011, Agas International was licensed by California Insurance to act as the distributor of the LEAVELAND trade name and use the Hong Kong Registered Marks.⁵

¹ Opponent's 1st Declaration, para. 9 & Exhibit "E", printout of official record of the Opponent from the Companies Registry website.

² Opponent's 1st Declaration, para. 4.

³ Opponent's 1st Declaration, para. 5 & Exhibit "A", copy of authorisation letter in Chinese. According to the Opponent's 1st Declaration, Kam Kee Rubber Works Ltd. is a shareholder of California Insurance.

⁴ Opponent's 1st Declaration, para. 6 & Exhibit "B", copy of authorisation contract in Chinese.

⁵ Opponent's 1st Declaration, para. 7 & Exhibit "C", copies of agreement and assignment in English. The copy of agreement in Exhibit "C" refers to a licence agreement dated 4 January 2009 whereby California Insurance granted a licence to Agas International to use the Hong Kong Registered Marks from January 2009 to December 2011.

18. On 29 December 2011, Agas International acquired the Hong Kong Registered Marks from California Insurance, together with all of the latter's rights and interests in respect of the same, by way of assignment.⁶
19. According to the Opponent, Agas International and its associated company, Shun Kei Trading Company ("Shun Kei"), an unincorporated business established in 2008, have continuously used the Leaveland Mark in the course of business in Hong Kong since then.⁷ Between January 2012 and December 2014, Agas International authorised Full Dragon and its associated company to act as the sole licensee to design, manufacture, promote and sell clothing and clothing accessories bearing the Leaveland brand or mark in Hong Kong and Macau.⁸
20. The Opponent states that it was established in 2013 to take over the entire business including all capital and assets of Agas International, as well as the ownership and goodwill of the Leaveland Mark.⁹
21. On 1 January 2014, the Opponent acquired the Hong Kong Registered Marks from Agas International by way of assignment.¹⁰ For ease of reference, the historical details for each of the Hong Kong Registered Marks recorded on the Register are extracted in Annex A and B of this decision.
22. According to the Opponent, it has, through Shun Kei, continuously used the Leaveland Mark in the course of business in Hong Kong. This includes manufacturing, retailing, wholesaling and promoting clothing, including boots, shoes, slippers and sandals under the Leaveland Mark ("the Opponent's Goods").¹¹

⁶ Opponent's 1st Declaration, para. 7 & Exhibit "C".

⁷ Opponent's 1st Declaration, para. 8.

⁸ Opponent's 1st Declaration, para. 8 & Exhibit "D", copy of authorisation contract in Chinese.

⁹ Opponent's 1st Declaration, para. 9.

¹⁰ Opponent's 1st Declaration, para. 9 & Exhibit "F", printout of official record from the Register for each of the Hong Kong Registered Marks.

¹¹ Opponent's 1st Declaration, para. 10.

23. The Opponent states that, during the period from April 2012 to March 2015, the annual sales figures of the Opponent's Goods in Hong Kong (including sales by Agas International or through Shun Kei) exceeded HK\$6 million per year.¹²
24. Distribution channels of the Opponent's Goods include the Opponent's branches at Tsuen Wan City Landmark and Tuen Mun Citistore and its retailers at City Rich Store and Yata Ltd.¹³ Exhibit "G" to the Opponent's 1st Declaration consists of photos taken in or around 2008 or 2009 showing the Opponent's clothing and shoe products displayed for sale at its branches at Tuen Mun Citistore and Tsuen Wan City Landmark respectively.
25. Exhibits "H" and "J" to the Opponent's 1st Declaration include copies of consignment agreements in 2011, 2012, 2013 and 2014 and sales documents in 2011, 2012 and 2013 in relation to the sale of the Opponent's shoe products by Shun Kei at Yata Ltd.¹⁴
26. The Opponent's Goods have also been promoted or offered for sale (including by reference to the Leaveland name or the leaf device) through the following channels:
- (a) placing advertisements in local newspapers such as the Apple Daily in 2010, 2012, 2013 and 2014;¹⁵
 - (b) placing advertisements in printed materials such as CARE ACTION (樂善行) in 2010 and 2011;¹⁶
 - (c) short term promotions or exhibitions at the department store City Rich Store in 2011, 2012 and 2013;¹⁷ and

¹² Opponent's 1st Declaration, para. 12 & Exhibit "I", copies of financial documents of Shun Kei.

¹³ Opponent's 1st Declaration, para. 11.

¹⁴ Opponent's 1st Declaration, para. 11-12.

¹⁵ Opponent's 1st Declaration, para. 13 & Exhibit "K".

¹⁶ Opponent's 1st Declaration, para. 13 & Exhibit "L".

¹⁷ Opponent's 1st Declaration, para. 13 & Exhibit "M", copies of agreements and statement invoices.

(d) sale booths at the Hong Kong Brands and Products Expo Fair (香港工展會) in 2012.¹⁸

27. According to the Opponent, the Applicant sent three letters to California Insurance to explore the possibility of purchasing the LEAVELAND brand and mark from the latter in October and November 2005. In summary, the Applicant referred to the previous success of the LEAVELAND brand and mark and the fact that they have not been used in Hong Kong in the previous 15 years. He also expressed his disappointment at California Insurance's failure to put the same in use since it obtained the same almost 13 years ago. He was eager to re-establish an association with the LEAVELAND brand and mark. He also referred to disputes between California Insurance and himself over the years and sought California Insurance's acceptance of his offer to purchase the Hong Kong Registered Marks (為了香港LEAVELAND的未來，我希望如果不能徹底地將我們多年的糾葛同時處理，可否先解決商標歸屬問題，即我們現以50萬購回LEAVELAND香港的商標權).¹⁹ His offer to purchase the Hong Kong Registered Marks for a sum of HK\$ 500,000 was subsequently rejected by California Insurance.

28. The Opponent's 2nd Declaration consists of mainly submissions and comments made in response to the Applicant's Declaration which I do not propose to summarise in detail here. For completeness, I only wish to mention that the Opponent denies that it has admitted that the Applicant created the Leaveland Mark. In any event, it considers that the Leaveland Mark (including any copyright thereof) has already been assigned to the Opponent.

Evidence of the Applicant

29. According to the Applicant, he came to Hong Kong from Mainland China in the 1960s. He states that he designed the Leaveland Mark

¹⁸ Opponent's 1st Declaration, para. 13 & Exhibit "N", photograph of booth.

¹⁹ Opponent's 1st Declaration, para. 22 & Exhibit "O", copies of letters.

for footwear in the 1980s and sold “boat shoes” under the same in Hong Kong. He outlines the design process of the Leaveland Mark.²⁰ I shall discuss this in more detail later.

30. The first owner of the Hong Kong Registered Marks was CYSFL.²¹ CYSFL was incorporated on 20 January 1987 and dissolved by compulsory winding up on 9 November 2002. The Applicant was one of its two directors.²²
31. In respect of Trade Mark No. 19893480, the registration was assigned to Leaveland International on 1 December 1989. The Applicant reiterates that Leaveland International was a “sister company” and used the Leaveland Mark in the 1980s.²³
32. The Applicant states that due to financial difficulties, the Official Receiver was appointed as Provisional Liquidator of CYSFL by the winding up Order of the Supreme Court on 6 November 1991 and he lost control of the Leaveland Mark. There is a record regarding the said appointment in relation to Trade Mark No. 19910907.²⁴
33. Exhibit “CK-3” to the Applicant’s Declaration includes a copy of what the Applicant describes as a report of his detailed history, which is actually an online article titled “汕尾當代名人：陳旭光”(contemporary celebrity of Shanwei: Chen Xu Guang) appearing on the 汕尾市民網 (Shanwei citizen network) at <http://www.swsm.net/thread-352086-1-1.html> (dated 17 April 2015) (“the Article”) including copies of publications circulated in 1990 showing CYSFL’s products under the Leaveland Mark. The Article comes across as a rather lengthy and detailed biography of the Applicant (who the parties agree is also named 陳旭光). In particular, it covers the ups and downs of the Applicant’s life as well as his business experiences in the shoe industry and contributions to

²⁰ Applicant’s Declaration, para. 3-4.

²¹ Applicant’s Declaration, para. 8 & Exhibit “CK-2”, printout of official record from the Register for each of the Hong Kong Registered Marks.

²² Applicant’s Declaration, para. 6 & Exhibit “CK-1”, printout of official record of CYSFL from the Companies Registry website.

²³ Applicant’s Declaration, para. 6.

²⁴ Applicant’s Declaration, para. 7 & Exhibit “CK-2”.

the Shanwei community. Though published in 2015, the Article includes in-depth discussions on the history and success of his shoe business under the “leaveland” brand in the late 1980s or early 1990s. I note, however, that the Article does not make any direct reference to the fact that currently neither the Applicant nor any of his related companies hold rights to use the Leaveland brand or mark in respect of goods such as shoes in Hong Kong.

34. The Applicant states that he is the designer and the copyright owner of the Leaveland Mark and as such is entitled to register the subject mark on the subject goods and services, which are entirely different from the goods covered by the Hong Kong Registered Marks. He emphasises that by adding the Chinese characters “列佛蘭” (which he considers to be a distinctive element) in the subject mark, the subject mark can be distinguished from the Leaveland Mark due to their different overall impressions.²⁵
35. I have not come across any evidence purporting to show that the Applicant has used the subject mark in respect of the subject goods and services in Hong Kong or elsewhere.
36. In relation to his dealings with California Insurance, the Applicant admits that after he lost control of the Leaveland Mark, he offered to buy it back from California Insurance in 2005 but was rejected. He states that he never had any intention to assign the Leaveland Mark to California Insurance.²⁶ However, he did not further elaborate on this or suggest any impropriety on the part of California Insurance in obtaining the assignments.

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

37. Section 11(5)(b) of the Ordinance provides that a trade mark shall not be registered if, or to the extent that the application for registration of the trade mark is made in bad faith.

²⁵ Applicant’s Declaration, para. 11-16, 18.

²⁶ Applicant’s Declaration, para. 20.

38. In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* (Case C-529/07) [2009] E.T.M.R. 56, the Court of Justice of the European Union considered that in order to determine whether there was bad faith, consideration must be given to the applicant's intention at the time when he filed the application for registration. The applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

39. In *Gromax Plastics Ltd. v Don & Low Nonwovens Ltd.* [1999] R.P.C. 367, Lindsay J. stated the following 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.”

40. In *Harrison's Trade Mark Application* [2005] F.S.R. 10, the English Court of Appeal held that:

“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.”

41. In determining whether an application for registration was made in bad faith, the courts have applied a test which involves both subjective and objective elements. In the case of *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person formulated a test (at paragraph 44 of the decision) as follows –

“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.”

42. The above principles were referred to and adopted in the High Court judgment of 深圳市德力康電子科技有限公司 v. *JOO-SIK-HOI-SA LG (LG Corporation) and another* [2014] HKEC 530 (HCMP 881/2013) in Hong Kong.

43. Based on the legal principles discussed above, the matters in issue are the Applicant’s knowledge at the relevant date and whether its act of applying for registration of the subject mark in respect of the subject goods and services in the light of that knowledge falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant field of trade. The onus of proving bad faith is on the Opponent.

44. In this case, the Applicant does not deny that the subject mark consists of, *inter alia*, the English word “Leaveland” and the leaf device, i.e. elements of the Leaveland Mark. However, he considers that he is entitled to incorporate these elements in the subject mark because he created and owns the copyright in the same. Meanwhile, he also claims that he has no knowledge of the Opponent or its use of the Leaveland Mark.

45. I note that the Leaveland Mark must have been created at a time before 4 March 1988, i.e. the date CYSFL filed for application of

Trade Mark No. 19893480 (in relation to goods in class 25) in Hong Kong.²⁷ The Applicant's version of the design process of the Leaveland Mark and the elements therein is outlined in his Declaration as follows²⁸:

"The inspiration of [the Leaveland Mark] came from the advertisement of "Maple Leaf" gold coin I saw in the newspaper, which was the design concept behind [the Leaveland Mark]. Back to my company on that day, I drew a model of the device of [the Leaveland Mark], found it beautiful, then immediately engaged my shoebox design friends to formalise the design of the device of [the Leaveland Mark] according to my draft. The next morning, the device of [the Leaveland Mark] was born. The device of [the Leaveland Mark] was created and I needed the English word mark to accompany the device. Because I did not know English, I told my inspiration "in a forest of land" to my then account clerk. She wrote "leaveland" to me and I adopted this English word "leaveland" with [the Leaveland Mark]."

Apart from the above, the Applicant has not provided any concrete evidence in support of his claim to have created the Leaveland Mark and the elements therein. In other words, the statements above can be said to be mere assertions without solid proof.²⁹

46. In any case, a closer look at the statements quoted in paragraph 45 above reveal that they do not actually support the Applicant's claim. Instead they suggest that it was his shoebox friends who formalised or created the leaf device (as it appears in the Leaveland Mark) and his then account clerk who came up with the word "leaveland"³⁰. Meanwhile, there is also no evidence which suggests that the Applicant expended any skill, labour or judgment in the

²⁷ I note, however, that the Applicant stated in the counter-statement that the Leaveland Mark and the elements therein were created by him in 1989. Meanwhile, the Applicant's Declaration does not refer to the date of creation at all.

²⁸ Applicant's Declaration, para. 4.

²⁹ Meanwhile, as mentioned in footnote 27, the Applicant's Declaration does not even refer to the date of creation.

³⁰ I note that the single-word "leaveland" may not attract copyright as a literary work anyway.

incorporation of the elements in the Leaveland Mark so as to attract copyright as an artistic work.

47. I have not overlooked the assertion that the idea or concept of the Leaveland Mark came from the Applicant. However, in the present inquiry this is not a relevant consideration as copyright protects the form of expression and not the underlying idea.³¹ Having considered the evidence before me, there is nothing upon which I could base a conclusion that the Applicant created the Leaveland Mark or the elements therein, as the author of the work. It appears that, at best, the Applicant may be the author of an earlier draft of the leaf device. However, the Applicant has not provided any proof or included any drawings in relation to such earlier draft. Meanwhile, I note that there is no suggestion that the Applicant owns the copyright in the Leaveland Mark or the elements therein (if any) by way of an assignment or otherwise.³²
48. The Opponent's predecessor in business, Agas International, acquired all rights and interests in the Hong Kong Registered Marks from California Insurance on 29 December 2011. The Hong Kong Registered Marks were then assigned to the Opponent on 1 January 2014. The Opponent's evidence shows that its predecessor was first licensed to use the Leaveland Mark in relation to class 25 goods in Hong Kong and Macau in 2003. It also shows that its clothing and shoe products have been promoted and marketed under the Leaveland brand and the Hong Kong Registered Marks and exposed for sale at various locations including department stores in Hong Kong before the relevant date. I accept that the Opponent and its predecessor have used and developed the Leaveland brand and the Hong Kong Registered Marks over time and have built up reputation in the same in Hong Kong.

³¹ See for example Article 9.2 of the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights.

³² In any event, even if I have found that the Applicant owned the copyright in the Leaveland Mark or the elements therein, it would not necessarily follow that he owned the subject mark or had a right to apply for it. However, this is a somewhat more complicated matter and given my finding I do not need to delve further into it.

49. The applications for the Hong Kong Registered Marks were filed in the name of CYSFL, i.e. not in the Applicant's name. The Hong Kong Registered Marks were later assigned to California Insurance (by 1994 and 1998). Given the Applicant's role in CYSFL and its association with Leaveland International, he must have known about the assignments to California Insurance and the details of the same. Indeed, the Applicant's letters to California Insurance in 2005 show that he was clearly aware of the assignments and the fact that neither he nor any of his related companies had rights to use the same thereafter.³³ On the other hand, there is nothing in the letters which supports the Applicant's claim that he retained any copyright in the Leaveland Mark further to the assignments.
50. The Applicant's evidence shows that he is based in Hong Kong and has long-standing interests in the shoe industry. In light of this and the matters set out in paragraphs 48 and 49 above, it would be difficult to accept that he had absolutely no knowledge of the Opponent's business and its use of the Leaveland brand and the Hong Kong Registered Marks.
51. There is therefore, on the one hand, nothing before me to conclude that the Applicant owned copyright in the Leaveland Mark or any elements (in particular, in relation to the word or name "leaveland") at the time he filed the subject application in 2014; on the other hand, as I have found above, the Applicant was clearly aware of the assignments to California Insurance and the fact that neither he nor any of his related companies had rights to use the Hong Kong Registered Marks thereafter. Meanwhile, the Opponent and its predecessor have used and developed the Leaveland brand and the Hong Kong Registered Marks over time and have built up reputation in the same in Hong Kong.
52. The subject mark consists of the English word "Leaveland", the leaf device and the Chinese characters "列佛蘭". Save for the addition

³³ See para. 27 above. The Applicant also stated in the counter-statement that CYSFL and Leaveland International stopped using the Hong Kong Registered Marks for goods in classes 25 and 14 until the assignment to California Insurance in 1994 and 1998 (see para. 12 above).

of the Chinese characters, the subject mark is essentially identical to the Leaveland Mark. An average consumer would perceive “列佛蘭” to be a transliteration for “Leaveland”, the name of the brand, in Chinese. Even with the Chinese characters, the marks would still be perceived to be highly similar.

53. Having considered all relevant facts and circumstances, I consider that the only reasonable conclusion is that the Applicant knew that, further to the assignments to California Insurance, neither he nor any of his related companies had rights in the Hong Kong Registered Marks. At the same time, he was clearly aware of the Opponent and its business by reference to the Leaveland brand and the Hong Kong Registered Marks. Nevertheless, he filed the subject application for a mark which incorporates the Leaveland name and the leaf device with the intention to create an impression that the subject goods and services and the Opponent’s goods come from the same or economically-linked undertakings.
54. Accordingly, I find that the Applicant’s conduct of applying for registration of the subject mark in respect of the subject goods and services falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant field of trade, and amounts to bad faith.

Conclusion

55. For the reasons given above, I find that the ground of opposition under section 11(5)(b) of the Ordinance has been made out. As I have found in favour of the Opponent on the ground under section 11(5)(b) of the Ordinance, it is not necessary for me to consider the other grounds of opposition.
56. As the opposition is successful, I award the Opponent 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.

(Jasmine Kun)
for Registrar of Trade Marks
31 January 2019

**Historical details of Hong Kong Trade Mark No. 19893480
extracted from the Register of Trade Marks**

詳細背景資料：

Historical Details:

作出記項日期 事項

Date of entry Matters

02-07-2014 APPLICATION FOR REGISTRATION OF / NOTICE TO
REGISTER PARTICULARS OF ASSIGNMENT /
TRANSFER FILED

18-03-2015 ASSIGNMENT/TRANSFER

New Owner's Name and AGAS (HONG KONG)
Address: LIMITED
Room 1404, 14/F., Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, N.T.,
Hong Kong.

New Owner's Address for AGAS (HONG KONG)
Service: LIMITED
Room 1404, 14/F., Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, N.T.,
Hong Kong.

Previous Owner's Name LO SHUN KEI and ZHANG
and Address: WEIZHI trading as Agas
International Trading Company
Room 4, 14th Floor, Million
Fortune Industrial Centre,

34-36 Chai Wan Kok Street,
Tsuen Wan, New Territories.
Hong Kong

Previous Owner's Address for Service: LO SHUN KEI
Room 4, 14th Floor, Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, New Territories
Hong Kong

Date of Assignment: 01-01-2014

作出記項日期 事項

Date of entry Matters

20-01-2012 APPLICATION FOR REGISTRATION OF / NOTICE TO
REGISTER PARTICULARS OF ASSIGNMENT /
TRANSFER FILED

12-09-2012 ASSIGNMENT/TRANSFER

New Owner's Name and Address: LO SHUN KEI and ZHANG
WEIZHI trading as Agas
International Trading Company
Room 2304, 23rd Floor, Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, New Territories,
Hong Kong

New Owner's Address for Service: Chak and Associates, Solicitors
Room 1904, 19th Floor, Far East
Finance Centre,
No.16 Harcourt Road,
Admiralty,
Hong Kong.

Previous Owner's Name and Address: CALIFORNIA INSURANCE COMPANY LIMITED
16TH FLOOR,
INTERNATIONAL BUILDING,
141 DES VOEUX ROAD
CENTRAL, HONG KONG

Previous Owner's Address for Service: KAM & FAN
UNIT A, 22ND FLOOR, TWO
CHINACHEM PLAZA,
NO.68 CONNAUGHT ROAD
CENTRAL,
HONG KONG.

Date of Assignment: 29-12-2011

作出記項日期 事項
Date of entry **Matters**
01-02-1994 ASSIGNMENT/TRANSFER

CALIFORNIA INSURANCE COMPANY LIMITED, of
16TH FLOOR, INTERNATIONAL BUILDING, 141 DES
VOEUX ROAD
CENTRAL, HONG KONG

作出記項日期 事項
Date of entry **Matters**
30-04-1990 ASSIGNMENT

LEAVELAND INTERNATIONAL LTD., of FLAT A, 4TH
FLOOR, CHEONG WAH INDUSTRY BUILDING, 39-41
SHEUNG HEUNG ROAD, TOKWAWAN, KOWLOON,
HONG KONG registered as subsequent proprietor by virtue
of a Deed of Assignment dated 1st December, 1989.

作出記項日期 事項
Date of entry **Matters**

17-11-1989

REGISTRATION

Original Owner's
Name and Address:

CHIU YEUNG SHOES
FACTORY LTD.

Flat C, 10th Floor, Cheong Wah
Industry Building, 39-41 Sheung
Heung Road, Tokwawan,
Kowloon, Hong Kong

**Historical details of Hong Kong Trade Mark No. 19910907
extracted from the Register of Trade Marks**

詳細背景資料：

Historical Details:

作出記項日期 事項

Date of entry Matters

02-07-2014 APPLICATION FOR REGISTRATION OF / NOTICE TO
REGISTER PARTICULARS OF ASSIGNMENT /
TRANSFER FILED

18-03-2015 ASSIGNMENT/TRANSFER

New Owner's Name and AGAS (HONG KONG)
Address: LIMITED
Room 1404, 14/F., Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, N.T.,
Hong Kong.

New Owner's Address for AGAS (HONG KONG)
Service: LIMITED
Room 1404, 14/F., Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, N.T.,
Hong Kong.

Previous Owner's Name LO SHUN KEI and ZHANG
and Address: WEIZHI trading as Agas
International Trading Company
Room 2304, 23rd Floor, Million
Fortune Industrial Centre,

34-36 Chai Wan Kok Street,
Tsuen Wan, New Territories,
Hong Kong

Previous Owner's
Address for Service: Chak and Associates, Solicitors
Room 1402, 14th Floor, Tower
2, Admiralty Centre,
18 Harcourt Road, Admiralty,
Hong Kong

Date of Assignment: 01-01-2014

作出記項日期 事項

Date of entry Matters

20-01-2012 APPLICATION FOR REGISTRATION OF / NOTICE TO
REGISTER PARTICULARS OF ASSIGNMENT /
TRANSFER FILED

12-09-2012 ASSIGNMENT/TRANSFER

New Owner's Name and LO SHUN KEI and ZHANG
Address: WEIZHI trading as Agas
International Trading Company
Room 2304, 23rd Floor, Million
Fortune Industrial Centre,
34-36 Chai Wan Kok Street,
Tsuen Wan, New Territories,
Hong Kong

New Owner's Address for Chak and Associates, Solicitors
Service: Room 1904, 19th Floor, Far East
Finance Centre,
No.16 Harcourt Road,
Admiralty,
Hong Kong.

Previous Owner's Name and Address: CALIFORNIA INSURANCE COMPANY LIMITED
16TH FLOOR, CHINA INSURANCE GROUP BUILDING,
NO.141 DES VOEUX ROAD CENTRAL,
HONG KONG.

Date of Assignment: 29-12-2011

作出記項日期 事項
Date of entry **Matters**
19-02-1998 ASSIGNMENT

CALIFORNIA INSURANCE COMPANY LIMITED, of
16TH FLOOR, CHINA INSURANCE GROUP BUILDING,
NO.141 DES VOEUX ROAD CENTRAL, HONG KONG.
registered as subsequent proprietor by virtue of a certified
copy of an Assignment executed by the liquidator

作出記項日期 事項
Date of entry **Matters**
27-07-1995 ENTRY OF DISCLAIMER/MEMORANDUM

The Official Receiver was appointed as Provisional
Liquidator of CHIU YEUNG SHOES FACTORY LIMITED
(in liquidation) by the winding up Order of the Supreme
Court on 6 NOVEMBER 1991.

(File Ref: 9559/89)

作出記項日期 事項
Date of entry **Matters**
21-03-1991 REGISTRATION

Original Owner's
Name and Address:

CHIU YEUNG SHOES
FACTORY LTD.

FLAT C, 10TH FLOOR,
CHEONG WAH INDUSTRY
BUILDING, 39-41 SHEUNG
HEUNG ROAD, TOKWAWAN,
KOWLOON, HONG KONG.