

TRADE MARKS ORDINANCE (Cap. 559)
OPPOSITION TO TRADE MARK APPLICATION NO. 303137814

MARK:



CLASS: 5

APPLICANT: EVERGREEN (ASIA PACIFIC) LIMITED

OPPONENT: TINHANKIN PHARMACEUTICAL LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 17 September 2014, Evergreen (Asia Pacific) Limited (the “applicant”) filed an application (the “subject application”) under the Trade Marks Ordinance, Cap. 559 (the “Ordinance”) for registration of the following mark:-



The applicant claims the colour purple (C 61 M93 Y1.9 K 0) as an element of this mark (the “subject mark”).

2. Registration is sought in respect of the following goods (“subject goods”) in Class 5:-

Class 5

food for babies; dietary supplements for humans and animals.

3. Particulars of the subject application were published on 13 March 2015. Tinhankin Pharmaceutical Limited (the “opponent”) filed a notice of opposition which includes a “Grounds of Opposition” on 16 April 2015.

4. The opposition hearing took place before me on 6 April 2017. The applicant having failed to file any Form T12 is treated as not intending to appear at the hearing under Rule 74(5) of the Trade Marks Rules Cap 559 sub leg (the “Rules”). At the hearing, Mr. Lau Yue Sum of Y.S. Lau & Partners, Solicitors, appeared for the opponent.

Grounds of opposition

5. The Grounds of Opposition, which was filed with the notice of opposition on 16 April 2015, was amended once to correct some typographical errors. The amended Grounds of Opposition was deemed filed on 19 May 2015.

6. In the amended Grounds of Opposition, the opponent claims that it has obtained registration of a mark which comprises the Chinese characters “天行健”, the English word “Tinhankin” and an image of two leaves in Class 35, that the subject mark predominantly made up of the Chinese words “天行健” would highly likely confuse or mislead the public into believing that the subject goods come from the opponent’s. The opponent opposes registration of the suit mark under sections 12(3) and 12(5) of the Ordinance.

Counter-statement

7. The applicant filed a counter-statement on the specified Form T7 on 5 June 2015, attached with a statement entitled “Grounds of Counter-statement” which denies that the subject mark bears any similarities with the opponent’s mark, that the subject goods have any conceptual similarity with the opponent’s services and that the registration of the subject mark would cause any confusion or damage to the goodwill

and reputation of the opponent.

The opponent's evidence

8. The opponent's evidence comprises a statutory declaration of Lee Yin Cheung Yinness made on 3 November 2015 ("Lee's statutory declaration"). Lee was one of the directors of the opponent which authorized her to make the statutory declaration to oppose the subject application. Exhibit "LYC-1" to Lee's statutory declaration contains the board resolution of the opponent to that effect.

9. The opponent was incorporated on 1 March 1999 in Hong Kong and carries on the business of manufacturing, distributing, importing and exporting pharmaceutical products, proprietary Chinese medicines, health products and health food. The opponent has purposely adopted and used "Tinhankin (天行健)" all along as its company, trade and/or brand name as well as its trade mark with a view to directing the public and customers to relate the meaning of the term to its products. According to Lee, the term "天行健", with "Tinhankin" being its English phonetic transliteration, is derived from the following verse of the "Books of Changes/I-Ching (易經)": "天行健，君子以自強不息". The complete verse, as Lee alleges, means continuing to re-juvenile energy with full strength like continuous planetary motion in order to strive for improvement and contribution to the world; this is considered to be especially important in the context of health products and/or nutriment where promotion of health and well-being is of paramount focus.

10. The opponent's mark is comprised of "天行健", "Tinhankin" and a two-leaves device. It has been used in the rubber stamp and letterhead of the opponent. Exhibit "LYC-3" to Lee's statutory declaration contains copies of invoices issued by the opponent in 1999 which show the mark at the top left hand corner. Exhibit "LYC-4" is the Trade Marks Registry record of the opponent's mark, which shows the mark obtained registration in Class 35 with effect from 4 May 1999.

11. The opponent has since 2004 submitted various applications for registration of proprietary Chinese medicines under the Chinese Medicines Ordinance, Chapter

549. Exhibit “LYC-5” to Lee’s statutory declaration contains copies of the packaging materials and invoices submitted by the opponent for applications for registration of proprietary Chinese medicines and the notices of confirmation of transitional registration issued by the Department of Health, involving products which used “天行健” as part of the product names and the opponent’s mark in their packaging. Exhibits “LYC-6” and “LYC-7” contain copies of respectively the packaging materials and newspaper advertisements of cordyceps capsules and lingzhi capsules, two pharmaceutical products allegedly manufactured by the opponent.

12. Exhibit “LYC-8” to Lee’s statutory declaration contains copy of pages printed out from the opponent’s website (www.tinhankin.com) and facebook page (www.facebook.com/tinhankin). The opponent is said to have subscribed to various advertising campaigns at facebook to promote its facebook page, exhibit “LYC-9” contains copy of invoices issued by facebook evidencing that.

13. The rest of Lee’s statutory declaration was mainly devoted to discussions of the similarity between the opponent’s mark and the subject mark, and the opposition on the ground of passing off. Whilst I would consider them, I do not propose to go into the details here, as I find they are mostly in the nature of observations bearing little evidential value, which can be put forward as submissions rather than being incorporated as contents of a statutory declaration.

The applicant’s evidence

14. The applicant did not file any evidence in the proceedings.

Decision on grounds of oppositions

15. In the Grounds of Opposition as amended, the opponent opposes registration of the subject mark under sections 12(3) and 12(5) of the Ordinance. I shall deal with the ground based on section 12(3) first.

Section 12(3) of the Ordinance

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

“(3)A trade mark shall not be registered if-

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

17. Under 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.

18. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the U.K. 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 (“the Council Directive”). In interpreting Article 4(1)(b) of the Council Directive, the European Court of Justice (“ECJ”) has formulated the “global appreciation” test, the principles of which can be found in the ECJ decisions 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, *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723 and more recently, in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 19.

19. Such principles have long been adopted in Hong Kong, as confirmed by the Court of Appeal in *Tsit Wing (Hong Kong) Co Ltd v TWG Tea Co Pte Ltd* [2015] 1 HKLRD 414. In essence, the test under section 12(3) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally. In *Tsit Wing*,

Lam VP cited (at paragraph 35) the propositions endorsed by Kitchin LJ in *Specsavers* (at paragraph 52) as follows:

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

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

is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Earlier trade marks

20. The term “earlier trade mark” is defined in section 5 of the Ordinance. References to an earlier trade mark shall be construed as including a trade mark in respect of which an application for registration has been made under the Ordinance and which, if registered, would constitute an earlier trade mark under or by virtue of section 5(1)(a), subject to its being so registered.

21. In the amended Grounds of Opposition, the mark the opponent relied upon is a mark registered with the Trade Marks Registry under no.200015032 for “distributorship; importing and exporting of pharmaceutical preparations, Chinese medicines, health products and health food; all included in Class 35”.

22. Given that the date of registration of that mark (the “opponent’s mark”) is 4 May 1999, which is earlier than the date the subject application was filed, the opponent’s mark is considered to have met the criteria of “earlier trade mark” as defined under section 5(1)(a) of the Ordinance for the purposes of this proceedings.

The average consumer

23. The concept of "average consumer" has been well discussed in many of the case law of the UK and the European Union. As those case law shows, in the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods and services concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (*Mundipharma AG v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – Altana Pharma (RESPICUR) (T-256/04) [2007] E.C.R. II-449 at [42] and the case law cited), and I have to determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade.

24. Moreover, in *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The applicant’s applied for goods are “food for babies; dietary supplements for humans and animals” in Class 5, whereas the opponent’s mark is registered in Class 35 for the service of “distributorship; importing and exporting of pharmaceutical preparations, Chinese medicines, health products and health food”. Both the applicant’s applied for goods and the opponent’s registered service, in a broad term, can be said to be in the nature of or being rendered in relation to pharmaceutical preparations or health products and food including food for babies and dietary supplements. Distributing, importing and exporting of these products are all related to the supply of these products to stores and other businesses that sell to consumers. The relevant public is therefore made up of members of the general public who purchase these products from stores, as well as the retailers of such products. I do not see there is a great difference between these two sectors of the relevant public, as after all these involve mainly pharmaceutical or health products which are sold and purchased without a prescription and which would be selected mainly by visual means, although I accept that there may be an interaction with a salesperson if advice is sought on the nature, function and purposes of these products, and so aural considerations must also be taken into account. In both cases they should be considered to be reasonably well informed and reasonably observant and circumspect, and whose degree of attention must be regarded as average when

purchasing them.

Comparison of goods and services

26. According to settled case-law, in order to assess the similarity between goods or services, all the relevant features of the relationship between them should be taken into account. Those features include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). Other factors may also be taken into account such as the distribution channels of the goods or services concerned (see for example *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281; Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-2579, paragraph 37 and the case-law cited).

27. “Complementarity” was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

28. In comparing goods with services, often there could hardly be found any connection between their nature, their method of use and their distribution channels. However, the complementarity between the goods and services in the context of a likelihood of confusion does not rely on the existence of a connection between the goods and services at issue in the mind of the relevant public from the point of view of their nature, their method of use and their distribution channels, but on the close connection between these goods and services, in the sense that one is indispensable or important for the use of the other in such a way that the public might think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (see *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) v *Sanco SA* (C-411/13) Unreported; ECJ; 08 May 2014)

29. Indeed in *Oakley Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-116/06) [2008] E.C.R. II-2455 at paragraphs 46-57, the General Court has found that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

30. Does it mean that complementarity plays a special role in the comparison between goods and services? In *Van Gulck v Wasabi Frog Ltd (MissBoo Trade Mark)* [2014] R.P.C. 33, Mr Geoffrey Hobbs Q.C., as the Appointed Person for the UK Trade Marks Registry, reviewed the law concerning retail services against goods. At paragraph 19 of the judgment, he said:

“19 The judgment of the General Court [*in Sanco SA v OHIM (Case C-411/13P)*] stands for three inter-related propositions. First, as part of the overall assessment of ‘similarity’ it is necessary to consider whether there is ‘complementarity’ between the goods and services in issue. Second, there is ‘complementarity’ when the goods and services in issue are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. Third, ‘complementarity’ as thus defined is not adequately addressed by adopting a checklist approach to the factors conventionally taken to have a particular bearing on the question of ‘similarity’ between goods and services: see [4] above.”

31. Mr. Hobbs Q.C. has also rejected the submission that the consequence of the General Court’s findings in *Oakley* was that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).¹

32. In the present proceedings, we are not dealing with retail services but services for distributorship, importing and exporting of the relevant products; nonetheless, the same principles of analysis should apply. First, I am of the view that the applicant’s “food for babies; dietary supplements for humans and animals” are types of “health products and health food” of the opponent’s and are therefore covered by them. Secondly, as the opponent submits, “dietary supplement” is likely to share

¹ See paragraph 22 of *Van Gulck v Wasabi Frog Ltd (MissBoo Trade Mark)*.

the same uses and users as “health products and health food” and are also to be distributed through pharmacies and would be placed in similar shelves in supermarkets, hence whether they are competitive products or complementary to each other, “dietary supplement” is likely to be the subject of the same services of distributorship, importing and exporting as “health products and health food”.

33. As distributorship, importing and exporting of pharmaceutical preparations, Chinese medicines and health products or food involve action or process of supplying those goods to stores and other businesses that sell to consumers, they are indispensable or important for the bringing of those products, which as discussed above are wide enough to cover the applicant’s goods, to the open and daily market, and hence to the average consumers of these products. In the circumstances, although there is no evidence submitted in this connection, it is plausible that the relevant public might believe that the undertaking which sells food for babies and dietary supplements for humans and animals under a particular trade mark is the same undertaking, or a connected undertaking, to one that provides or undertake the services of distributorship, importing and exporting of a variety of pharmaceutical preparations, Chinese medicines and health products or food. On the same basis as *Oakley*, I have no doubt that the opponent’s distributorship, importing and exporting services of pharmaceutical and health products in Class 35 is complementary to the applicant’s baby food and dietary supplements in Class 5 and, as a consequence, similar to at least a medium degree.

Comparison of marks

34. According to consistent case law, in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural and conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer v Klijsen Handel*, paragraph 27).

35. In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their

distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *Sabel BV v Puma AG*, para 23; *Lloyd Schuhfabrik Meyer*, para 25; and the order in *P Matratzen Concord v OHIM* (Case C-3/03), para 29). In that regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Shaker di L. Laudato & C. Sas, Limiñana y Botella, SL* (C-334/05 P) [2007] E.C.R. I-4529 at [35] and the case law cited).

36. Whilst the comparison must be made by examining each of the marks in question as a whole, that does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *OHIM v Shaker* [2007] E.C.R. I-4529 at [41] and the case law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* [2007] E.C.R. I-4529 at [42]).

Distinctive and dominant components of the opponent's mark and the subject mark

37. The opponent's mark is comprised of “天行健”, “Tinhankin” and two separate devices of leaves, as represented below:-



(the “opponent’s mark”)

38. It is noteworthy that this opponent's mark is registered with the following disclaimer/limitation/conditions:

The transliteration and translation of the Chinese characters appearing in the mark are "Tin Hang Kin" meaning "the sky, to walk, to be healthy".

Registration of this Trade Mark shall give no right to the exclusive use of the Chinese

character "健".

39. “天行健” and “Tinhankin” are the two word components of the opponent’s mark. As “Tinhankin” could naturally be broken down into "Tin Hang Kin", the very fact that the Trade Marks Registry took the view that "Tin Hang Kin" is the transliteration and translation of the three corresponding Chinese characters “天”, “行” and “健” respectively bespeaks the likely average consumer's perception of the word “Tinhankin” as nothing but the English transliteration of the entire term “天行健”.

40. “天行健” is allegedly a term derived from the I-Ching (易經) verse “天行健，君子以自強不息”. According to Lee’s statutory declaration, the I-Ching (易經) verse means continuing to re-juvenile energy with full strength like continuous planetary motion in order to strive for improvement and contribution to the world. This, as Lee’s statutory declaration put it, is especially important in the context of health products and/or nutriment where promotion of health and well-being is of paramount focus. Although no evidence has been filed for information in this respect, I trust many people in Hong Kong would be aware of the fact that “天行健” is a particular phrase taken from I-Ching (易經), an ancient Chinese book of divination, and may even know about the entire verse and the meaning it carries. On the other hand, even if one does not know about the I-Ching verse, merely judging from the respective literal meanings the three constituent characters represent, namely, "the sky, to walk, to be healthy" (as attributed to “天行健” by the Trade Marks Registry), I think the Chinese term could easily evoke certain surreal and striking imageries, say, a continuous planetary movement (or a moving heaven), a gentleman ceaselessly striving along or the enlightened earnestly exerting themselves, all alluding somehow to health products and/or nutriment where the promotion of health and well-being is of paramount importance. I agree that “天行健” is to a certain extent descriptive of the characteristics of the goods and services in issue, namely, health products and/or nutriment.

41. But the very fact that “天行健” is somewhat descriptive of the goods and services in issue does not mean that it does not have any distinctive character at all. Although “天行健” may well be a phrase that has slipped into common parlance, I do not think it is such a phrase or name that anyone in the health products and/or

nutriment industries would wish to describe his business or shop as a “天行健” business or shop. It is that sort of name which bear certain indications to suggest to you what the business is or might be about, but is also obviously intended to be a name designed to denote a particular business, though it is true that it is not particularly inventive given that it is a phrase extracted from an ancient Chinese book of divination. “天行健” as an element of a complex mark for health products is considered to be of a distinctive character, though not a strong one.

42. It should be borne in mind, moreover, that in any event, even possibly weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since it may make an impression on consumers — because, in particular, of its position in the sign or its size — and be remembered by them (*Inex SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Wiseman—Representation of a cowhide)* (T-153/03) [2006] E.C.R. II-1677 at [32]; see also, to that effect, *Avex Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Ahlers (a))* (T-115/02) [2004] E.C.R. II-2907 at [20]). This more or less speaks of “天行健” as it is considered the most distinctive and dominant element in the opponent’s mark, despite its weak distinctive character.

43. Compared with “天行健”, “Tinhankin”, as discussed above, will be perceived and remembered by the average consumers to be merely the English transliteration of “天行健”; this, coupled with its relative position and size in comparison, make it less prominent and significant than “天行健” is, though it still has to be taken into account in the overall impression created by the mark.

44. If the word components are considered to be not of strong distinctive character, the figurative component of the opponent’s mark, which takes the form of either a stem with two leaves, or simply two leaves without stem, should be considered to be of weak distinctive character since they are banal as they come naturally to mind in relation to the marketing of health products and/or nutriment, and are suggestive of health products which often come or be promoted as composing mainly of natural ingredients.

45. To conclude, of the various components of the opponent’s mark, as the

saying goes, words speak louder than devices in a composite mark (*Oasis Stores Ltd. Trade Mark Application* [1998] RPC 631 at 644), consumers tend to rely on the word component rather than a figurative component to identify and purchase goods and services. Moreover, as the figurative component can only be considered as of weak distinctive character, it is the Chinese term and its English transliteration which lend the trade mark its distinctiveness and which will dominate the overall impression the opponent's mark conveys.

46. Turning to the subject mark which is another composite mark, it contains the term “天行健”, the word “HUMANFUEL”, and two rectangular purple-coloured backdrops against the two word components respectively. The subject mark is registered with the following “Mark Description”:-

The applicant claims the colour purple (C 61 M93 Y1.9 K 0) as an element of the trade mark.

47. My analysis of the distinctive character of “天行健” above applies equally to the subject mark as it does to the opponent's mark. As to the other word component, namely, “HUMANFUEL”, it is neither a transliteration of the Chinese term nor a word that can be found in an English dictionary, nevertheless it carries a perceptible meaning if one breaks it up into “human” and “fuel”, which is a natural thing to do. The combination of “human” and “fuel” refers to the “fuel” that humans would need or desire, which naturally alludes to health food and nutriment. “HUMANFUEL” is therefore descriptive of the goods and services in issue.

48. As to the claim of the colour purple as an element of the subject mark, by being given only the colour identification code (C 61 M93 Y1.9 K 0), it is difficult for me to understand which one of those colours that appear on the two rectangular backdrops is the particular colour claimed and intended by the applicant to be treated as an element of the subject mark, for there is a combination of colours in the abstract, without contours. For a better understanding of the difficulty I am facing, I just reproduce below the representation of the subject mark on the application form (Form T2) with all the colours it is represented in:-



49. The colour claim is essential for the applicant as they wish to put forward the particular colour as a distinguishing feature of the subject mark, but even pushed aside the identification question above, merely looking at the subject mark, it does not occur to me that any one of the colours that constitute the combination appearing on the mark possesses inherent capacity for communicating specific information, including any origin specific message. After all, a combination of colours in the abstract, without contours, is just common for advertising and marketing goods and services. There is simply nothing to persuade me that the colour purple, identified as C 61 M93 Y1.9 K 0, however and wherever it is used on the face of the subject mark, possesses any inherent distinctive character.

50. Moreover, as the applicant did not file any evidence in the proceedings, there is no way I can ascertain whether the particular colour as applied for has to any extent been adapted to factually distinguish the applicant's goods from those of other traders. In the absence of any evidence to support a claim to distinctiveness acquired through use, I do not find that the colour purple (C 61 M93 Y1.9 K 0) put forward for registration to be a distinctive element of the subject mark.

51. With regard to the subject mark, I consider that only the word components are inherently adapted to distinguish, with “天行健” being more distinctive than “HUMANFUEL” is in relation to the goods and services in issue; moreover, given their relative positions and sizes, I find that “天行健” is the most distinctive and dominant component. I just note in passing that the character “行” in “天行健” is larger in size than the other two characters, if anything, that just reinforces the overall dominating position “天行健” occupies in the subject mark.

Visual similarity

52. Visually speaking, both the opponent's mark and the subject mark have “天行健” as their most distinctive and dominant component, but this is the only similarity between them. The dissimilarities lie in the other word components of the respective marks, namely, “Tinhankin” and “HUMANFUEL”; and the figurative parts. Nonetheless, as analyzed above, it is the terms “天行健” and “Tinhankin” which lend

the opponent's mark its distinctiveness and which will dominate the overall impression the mark conveys; moreover, "Tinhankin" being its English transliteration would only reinforce the overall impression "天行健" conveys rather than distract attention from it. With regard to the subject mark, I also consider "天行健" the most distinctive and dominant component, with "HUMANFUEL" and the coloured backdrops having minimal impact on the overall impression the mark conveys due to their descriptiveness and indistinctiveness. Given that "天行健" is dominating the overall impression conveyed by either of the marks, I find the similarity between the marks is qualitatively stronger and not much mitigated by the dissimilarities. The overall effect is that there is high degree of visual similarity between the opponent's mark and the subject mark.

Aural and conceptual similarities

53. Aurally and conceptually, the same analysis applies. "天行健" dominating the overall impression conveyed by either of the marks means that the two marks would be aurally referred to as well as remembered by the relevant public by this one and the same term. There is also a high degree of aural similarity and conceptual similarity between the opponent's mark and the subject mark.

Distinctiveness of the opponent's mark

54. A mark may be particularly distinctive either per se or because of the reputation it enjoys with the public. The more distinctive an earlier mark, the greater will be the likelihood of confusion (*Sabel BV v Puma AG*).

55. 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 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 (*Windsurfing Chiemsee v Huber and Attenberger* [1999] E.C.R. I-2779; *Lloyd Schuhfabrik Meyer v Klijsen Handel* [1999] E.T.M.R. 690).

56. I have summarized the opponent's evidence at paragraphs 8 to 13 above. As revealed in Lee's statutory declaration, the opponent was incorporated in Hong Kong in 1999 and carries on the business of manufacturing, distributing, importing and exporting pharmaceutical products, proprietary Chinese medicines, health products and health food by adopting and using "Tinhankin (天行健)" all along as its company, trade and/or brand name as well as its trade mark with a view to directing the public and customers to relate the meaning to its products. Copies of the opponent's invoices as early as 1999 and packaging materials submitted by the opponent for applications for registration of proprietary Chinese medicines products, together with newspaper advertisements and online advertising campaigns of pharmaceutical and health products manufactured by the opponent, had been put forward to show that "天行健" had been used adopted and incorporated as parts of the opponent's trade mark and product names.

57. Although the materials filed do not sufficiently prove that the opponent's mark was widely used on all the packaging or label of the individual pharmaceutical products, it is clear that the opponent's mark invariably appeared on the invoices and advertisements concerned and this shows use of the mark at least in relation to the services of distributorship, importing and exporting of a variety of pharmaceutical and health products. Judging from the long history of use and the not insignificant amounts of product transactions evidenced by the invoices, I am satisfied that the opponent's mark has acquired to a certain extent an enhanced degree of distinctive character through use.

Likelihood of confusion

58. The global assessment that I am required to undertake implies some interdependence between the relevant factors. Thus, a lesser degree of similarity

between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

59. In the present case, having found that there is at least a medium degree of similarity between the opponent's services and the applicant's goods, I find that visually, aurally and conceptually, the opponent's mark and the subject mark are of a high degree of similarity.

60. It has been said that the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24). Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20). I have also found that the opponent's mark has acquired an enhanced degree of distinctive character through use in Hong Kong.

61. Given the high degree of similarities between the marks and at least a medium degree of similarity between the respective goods and services in respect of which the marks are used and registered or seeking registration, and the enhanced degree of distinctiveness of the opponent's mark, the risk that consumers would mistake the subject mark for the opponent's mark, or being confused into believing that the baby food and dietary supplements provided by the applicant are supplied by the opponent's distributorship, importing and exporting services of pharmaceutical and health products or provided by some undertaking linked to the opponent, is high. There is a likelihood of confusion within the meaning of section 12(3) of the Ordinance (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, op. cit.).

62. It follows that the ground of opposition under section 12(3) succeeds.

63. As I have found in favour of the opponent on the ground of opposition under section 12(3) of the Ordinance, it is not necessary for me to consider the other ground of opposition under section 12(5)(a).

Conclusion

64. As the opponent has been successful in this opposition, I award the opponent

costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either the opponent or the applicant 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.

(Frederick Wong)
for Registrar of Trade Marks
27 September 2017