

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 303402549

MARKS :



CLASSES : 19, 27, 35

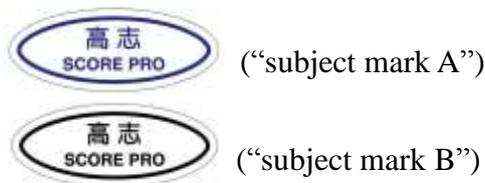
APPLICANT : GREEN FLOOR LTD

OPPONENT : SCORE BUILDING MATERIALS LIMITED
(高志建築材料有限公司)

STATEMENT OF REASONS FOR DECISION

Background

1. On 8 May 2015 (“Application Date”), GREEN FLOOR LTD (“Applicant”) filed an application (Application No. 303402549) (“subject application”) under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for registration of the following series of two marks (collectively, the “subject marks”):



The Applicant claims the colour blue as an element of subject mark A in the series. Registration of the subject marks is sought in respect of the goods in Classes 19 and 27 (collectively, the “Subject Goods”) and the services in Class 35 (“Subject Services”) set out in **Annex 1** hereto (collectively, the “Subject Goods and Services”).

2. Particulars of the subject application were published on 14 August 2015.

3. SCORE BUILDING MATERIALS LIMITED (高志建築材料有限公司) (“Opponent”) filed a notice of opposition on 10 November 2015 (“Notice of Opposition”)

with grounds of opposition (“Grounds of Opposition”). The Applicant filed a counter-statement on 5 February 2016 (“Counter-statement”) in response to the Notice of Opposition.

4. The Opponent’s evidence consists of a statutory declaration of Chan Yee Fai Yvonne made on 24 January 2017 (“Chan’s Declaration”).

5. The Applicant did not file any evidence in this proceedings.

6. IPMS Consultants Ltd, agent for the Opponent, filed skeleton submissions of the Opponent on 1 June 2018.

7. The opposition hearing took place before me on 6 June 2018. Mr Frankie Chan Mun Kay, Deputy General Manager of the Opponent attended the hearing on behalf of the Opponent. The Applicant did not attend the hearing. I reserved my decision at the conclusion of the hearing.

Grounds

8. In the Notice of Opposition, the Opponent states that it is the owner of the trade names and/or trade marks “SCORE”, “SCORE PRO” and “高志”. The Opponent relies on the grounds under the following sections of the Ordinance:

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

Evidence of the Opponent

9. The Opponent’s evidence consists of Chan’s Declaration made by Chan Yee Fai Yvonne, an assistant general manager of the Opponent. Ms Chan has full access to books and records in the possession of the Opponent and related companies which are relevant to these proceedings.

10. The Opponent is a limited liability company established in Hong Kong in 1982. Exhibit 11 to Chan’s Declaration includes (i) a copy of the Certificate of Incorporation of

the Opponent dated 2 November 1982, and (ii) copies of the Opponent’s business registration certificates, the earliest of which covers the period from 2 November 2001 to 1 November 2002, and the latest covers the period from 2 November 2015 to 1 November 2016.

11. According to a letter dated 12 May 2016 issued by Pang Chan & Co.,¹ principal auditors of Score (Holdings) Limited (“SHL”) and its subsidiaries (collectively, the “Group”), the following are subsidiaries of SHL:

<u>English Name</u>	<u>Chinese Name</u>	<u>Nature of business</u>	<u>Year of Establishment</u>
Century Score Trading Limited	成志貿易有限公司	Trading of building materials	1997
Score Building Materials Limited (i.e. the Opponent)	高志建築材料有限公司	Trading of building materials	1982
Score Logistics Limited	高志物流有限公司	Transportation services	2000
Score Harvest Limited	高凱有限公司	Investment holding	1995
Score International Enterprises Ltd.	高益國際企業有限公司	Trading of building materials	1979
Score Pro Shop Limited	高志時尚有限公司	Trading of building materials	2001
Score Tech Engineering Co. Ltd.	高科砂漿工程有限公司	Trading of building materials	2001
Score Tech Mortars Co. Limited	高科砂漿有限公司	Trading of building materials	1999
Scoresun Enterprises Limited	高辰企業有限公司	Trading of building materials	2000
United Score International Ltd.	合高國際有限公司	Investment holding	1997
Score (Macao) Limited	高志(澳門)有限公司	Trading of building materials	2005
N/A	東莞高科建材有限公司	Trading of building materials	2000

¹ Exhibit 1 to Chan’s Declaration.

12. Exhibit 2 to Chan's Declaration includes copies of invoices issued by the Opponent to various construction and engineering companies in Hong Kong. The invoices are dated between November 1999 and December 2013. Each of those invoices bears the Chinese and English names of the Opponent "高志建築材料有限公司 Score Building Materials Ltd." The products covered by the invoices are mainly construction materials, in particular tiles, and they are described in the invoices by reference to the brands "'SCORE' brand" or "高志牌".

13. According to a printout dated 23 September 2015 from the website of Hong Kong Domain Name Registration Company Limited at Exhibit 3 to Chan's Declaration, the Opponent is the holder of the domain name "SCORE.COM.HK" which name has existed since 1996.

14. According to a letter dated 4 June 1996 issued by the Hong Kong Housing Authority,² the Opponent's 'Score' brand 200 x 200 mm non-slip homogeneous floor tiles had passed the relevant prequalification tests and had been included in the Housing Authority's List of Approved Proprietary Names for Architectural Materials for Harmony Blocks in 1996.

15. According to a brochure of the Opponent in 2015 included in Exhibit 3 to Chan's Declaration, the Opponent has supplied for government construction projects (e.g. for government offices, public housing estates, hospitals and schools) as well as for private construction projects (e.g. for private residential buildings, commercial buildings and hotels). Reproduced at **Annex 2** hereto is a list of the Opponent's job references found in that brochure. Exhibits 6 and 7 to Chan's Declaration include contracts and purchase orders dated between October 2005 and November 2013 for the supply of the Opponent's tiles under the brands "'SCORE' brand" or "高志牌" in respect of various private and Government construction projects in Hong Kong.

16. Exhibit 5 to Chan's Declaration includes copies of test reports dated between May 2003 and July 2010 issued by either (i) FUGRO TECHNICAL SERVICES LIMITED (MaterialLab Division) or (ii) CASTCO TESTING CENTRE LTD. ("CASTCO"), showing that the Opponent's 'SCORE' Brand tiles passed certain tests conducted by those companies. Exhibit 9 to Chan's Declaration includes certificates issued in 2013 and 2015 by CASTCO showing that the Opponent had been found to conform to Product Conformity Certification Scheme for Ceramic Tiles PCCS-CT Issue 1 (10 September 2010)

² Exhibit 8 to Chan's Declaration.

of the Hong Kong Concrete Institute for the manufacture of certain ‘SCORE’ Brand (‘高志’牌) tiles.

17. Exhibit 4 to Chan’s Declaration includes copies of undated promotional leaflets and brochures in respect of the Opponent’s ‘Score Chinese Mosaic Tiles’, ‘SCORE Brand Clay Paver’ and ‘SCORE Homogeneous Tiles’. Marks appearing on these promotional materials include:



The Opponent’s contact address, telephone and facsimile numbers in Hong Kong appear on these promotional materials.

18. Score Pro Shop Limited (高志時尚有限公司) (“SPS”), a related company of the Opponent,³ had been carrying on the business of retailing of building materials at a shop at G/F., 274 Lockhart Road, Wanchai from around February 2001 to February 2015. Copies of tenancy agreements included in Exhibit 12 to Chan’s Declaration indicate that SPS was the tenant in respect of the shop at G/F., 274 Lockhart Road, Wanchai from February 2001 to February 2015. According to the copies of business registration certificates included in the same Exhibit 12, the business which SPS had been carrying on at that address was retailing of building materials. The same Exhibit 12 includes copies of invoices dated between May 2008 and January 2015 issued by SPS. The following appears on the top part of each of those invoices:



³ According to the letter referred to in paragraph 11 above, both SPS and the Opponent are subsidiaries of SHL.

19. Having considered the Opponent's evidence as a whole, I find that the Opponent has been using in Hong Kong the trade marks "Score"/"SCORE" ("Opponent's Mark A") and "高志" ("Opponent's Mark B") in respect of building materials, in particular tiles, at least since 1999, and has through its related company Score Pro Shop Limited used the trade names and marks "Score Pro" ("Opponent's Mark C") and the Opponent's Mark B in respect of retailing of building materials at least since 2008. (The Opponent's Mark A, the Opponent's Mark B and the Opponent's Mark C are collectively referred to below as the "Opponent's Marks").

The Applicant

20. In the Counter-statement, the Applicant states that it is a limited company incorporated under the laws of Hong Kong, and is a wholesaler and retailer as well as manufacturer of building and construction materials. The Applicant has filed no evidence in these proceedings.

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

21. The Opponent claims that registration of the subject marks is contrary to section 12(5) of the Ordinance because use of the subject marks in Hong Kong is liable to be prevented by virtue of the rules of law protecting unregistered trade marks or other signs used in the course of trade or business (in particular, by virtue of the law of passing off).⁴

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

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

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

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

⁴ Grounds of Opposition, para. 8(7).

23. The issue for determination is whether normal and fair use of the subject marks for the purpose of distinguishing the Subject Goods and Services from those of other undertakings was liable to be prevented at the Application Date by virtue of the law of passing off (*Wild Child Trade Mark* 1998 RPC 455).

24. The elements of the tort of passing off as formulated by Lord Oliver in the *JIF* case⁵ have been repeatedly relied upon.⁶ Adapted to the facts of the present case, the Opponent has to establish that:

- (a) there is **goodwill** attached to the goods and services it supplies in the mind of the purchasing public by association with the Opponent's mark(s) which is recognised by the public as distinctive specifically of the Opponent's goods and services;
- (b) use of the subject marks in relation to the Subject Goods and Services would give rise to a **misrepresentation** (whether or not intentional) leading or likely to lead the public to believe that the Subject Goods and Services offered by the Applicant are the goods or services of the Opponent; and
- (c) the Opponent suffers, or is likely to suffer, **damage** by reason of the erroneous belief engendered by that misrepresentation.

25. The relevant date for determining the criteria of section 12(5)(a) of the Ordinance is the date of the application for the mark in suit or the date of commencement of the conduct complained of.⁷

26. Since there is no evidence of use of any of the subject marks in Hong Kong by the Applicant before the Application Date, the relevant date is the Application Date, i.e. 8 May 2015.

Goodwill

27. I have considered the evidence filed by the Opponent in these proceedings. I am satisfied that as at the Application Date, the Opponent had goodwill attached to building

⁵ *Reckitt & Colman Products Limited v. Borden* [1990] RPC 341, 406, [1990] 1 All ER 873, 880.

⁶ Applied in e.g. *Ping An Securities Ltd v 中國平安保險 (集團) 股份有限公司* (2009) 12 HKCFAR 808 (FACV 26/2008).

⁷ *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 9.

materials and retailing of building materials (“Verified Goods and Services”) in the mind of the purchasing public by association with the Opponent’s Marks which are recognised by the public as distinctive of the Opponent’s Verified Goods and Services.

Misrepresentation

28. Deception is the gist of the tort of passing off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct.

29. Each of the subject marks consists of the Chinese characters “高志” and the words “SCORE PRO” placed inside a double oval border. Whilst the textual elements and the border constituting subject mark A are in blue, those elements constituting subject mark B are in black. The presence of the double oval border and the difference in colour between subject mark A and subject mark B have no impact on the distinctiveness of the subject marks. Each of the subject marks would be recognized and remembered by the textual elements “高志” and “SCORE PRO”.

30. Each of the subject marks is essentially a combination of the Opponent’s Mark B and the Opponent’s Mark C, and fully incorporates the Opponent’s Mark A.

31. I refer to the Subject Goods and Services set out in Annex 1 and the Opponent’s Verified Goods and Services set out in paragraph 27 above. The Subject Goods include various building materials such as tile floorings. The Subject Services include retailing of building and construction materials. The Applicant’s field of activity by reference to the Subject Goods and Services overlaps with that of the Opponent by reference to the Opponent’s Verified Goods and Services.

32. Having regard to the extent of the Opponent’s reputation and goodwill, the clear overlap between the respective fields of activity between the Opponent and the Applicant, and the fact that each of the subject marks is essentially a combination of the Opponent’s Mark B and the Opponent’s Mark C and fully incorporates the Opponent’s Mark A, I consider that when customers see any of the subject marks used in the relation to the Subject Goods and Services, they are likely to be misled into believing that the Subject Goods and Services provided under any of the subject marks and those provided under the Opponent’s Marks are from the same source. A substantial number of persons are liable to be deceived by the normal and fair use by the Applicant of any of the subject marks into

believing that the Applicant's Subject Goods and Services are goods and services of the Opponent.

33. I find that the element of misrepresentation has been made out.

Damage

34. A misrepresentation that the defendant's goods or business are those of the claimant is intrinsically likely to damage the claimant if the fields of business of the claimant and the defendant are reasonably close (*The Law of Passing-Off*, Christopher Wadlow, 4th edition, 4-013).

35. In view of the reputation and goodwill of the Opponent, the fact that the Opponent's and the Applicant's fields of activity overlap and the fact that a substantial number of persons are likely to mistakenly infer from the Applicant's use of any of the subject marks in relation to the Subject Goods and Services that the Applicant's Subject Goods and Services are from the Opponent, damage to the Opponent's goodwill is a reasonably foreseeable consequence of use of the subject marks.

36. I am satisfied that normal and fair use of any of the subject marks for the purpose of distinguishing the Subject Goods and Services from those of other undertakings was liable to be prevented at the Application Date by virtue of the law of passing off. The ground of opposition under section 12(5)(a) of the Ordinance is made out.

37. As I have found in favour of the Opponent on the ground of opposition under section 12(5)(a) of the Ordinance, it is not necessary for me to consider the grounds under the other sections of the Ordinance referred to in paragraph 8 above.

Conclusion and costs

38. For the reasons stated above, the subject application is refused under section 12(5)(a) of the Ordinance.

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

40. Subject to any representations, as to the amount of costs or calling for special treatment, which either party may make within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to

Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed.

(Finnie Quek)
for Registrar of Trade Marks
13 September 2018

Subject Goods and Services

“Subject Goods”:

Class 19

wooden floor boards; works of art of stone, concrete or marble; wood, semi-worked; wood paneling; wood pulp board, for building; wood paving; veneers wood; linings, not of metal, for building; tile floorings, not of metal; building materials, not of metal; Stone; building timber; cask wood; sandstone for building; building stone; works of stonemasonry; cement; bricks; refractory construction materials, not of metal; building cardboard [asphalted]; floors, not of metal; framework, not of metal, for building; reinforcing materials, not of metal, for building; building panels, not of metal; building glass.

Class 27

artificial turf; bath mats; carpet underlay; carpets; decorative wall hangings, not of textile; door mats; floor coverings; gymnastic mats; linoleum; mats of woven rope for ski slopes; mats; non-slip mats; reed mats; textile wallpaper; vinyl floor coverings; wallpaper; underlay and backing for floor coverings.

“Subject Services”:

Class 35

Retailing, wholesaling and distributorship relating to building and construction materials, floorings, stones, semi-worked woods, wallpaper, floor coverings; Import-export agencies; Presentation of goods on communication media, for retail purposes; Advertising; Management (Advisory services for business -); Business consultancy (Professional -); Marketing studies; Auctioneering; Sales promotion for others; Marketing; Procurement services for others [purchasing goods and services for other businesses]; Administrative processing of purchase orders; Personnel management consultancy; Secretarial services; Auditing; Accounting; Administration (Commercial -) of the licensing of the goods and services of others; Commercial or industrial management assistance; Relocation services for businesses; Cost price analysis; Exhibitions (Organization of -) for commercial or advertising purposes; Comparison services (Price -); Systematization of computer database information; Sponsorship search.

A list of the Opponent's job references

Private	HKHA
Hong Kong Science Park HSBC Building, Tseung Kwan O Lohas Park, Tseung Kwan O (日出康城) Mount Beacon, Kow Loon Tong (畢架山峰) Pacific Place The Austin The Wings II, Tseung Kwan O (天晉2期) Vision City, Tsuen Wan (萬景峰)	Choi Wan Estate Hung Shui Kiu Area 13 - Phases 1, 2 & 3 Lam Tin Estate - Phases 1, 3, 5 & 11 Lower Wong Tai Sin Estate New Housing Headquarters, Fat Kwong Street Pak Tin Estate - Phases 3, 4 & 6 Tak Long Estate Tung Tau Estate - Phase 9
ASD	University
Hammer Hill Road Leisure Pool Hin Tin Swimming Pool International Wetland Park 2 Kowloon Bay Fire Station New Headquarter of EMSD Building, Kai Tak (特電工程署新總部大樓) Pemala Youde Nethersole Eastern Hospital (東區醫院) Penny's Bay Fire Station Princess Margaret Hospital Queen Mary's Hospital Tseung Kwan O Sportsground Tung Chung Library	Hong Kong Baptist University Hong Kong University Shue Yan University Student Hostel of Hong Kong Polytechnic University Student Hostel of Lingnan University, Tuen Mun
Housing Society	Macau
Healthy Village, North Point Kai Tak Garden	City of Dreams Dynasty Plaza Macau Science Center Macau Tower MGM Cotai Wynn Macau Resort