

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 303826440

MARK : 

CLASS: 3

APPLICANT : ALLERGAN HOLDINGS FRANCE SAS

OPPONENT : Dermavita Company Ltd

STATEMENT OF REASONS FOR DECISION

Background

1. On 4 July 2016 (“**Application Date**”), ALLERGAN HOLDINGS FRANCE SAS (“**Applicant**”) filed an application (Application No. 303826440) (“**subject application**”) under the Trade Marks Ordinance (Cap. 559) (“**Ordinance**”) for registration of the following mark:



(“**subject mark**”)

2. Registration of the subject mark is sought in respect of various goods in Classes 3 and 5 (“**applied-for goods**”).

3. Particulars of the subject application were published on 7 July 2017. DERMAVITA COMPANY (LIMITED PARTNERSHIP) PARSEGHIAN & PARTNERS (which later changed its name to Dermavita Company Ltd) (“**Opponent**”) filed on 3 October 2017 a notice of opposition to the registration of the subject mark, with a statement of grounds of opposition (“**Statement of Grounds**”), in respect of the following applied-for goods in Class 3 (“**subject goods**”):

Class 3

Cosmetics, namely preparations for the treatment of glabellar lines, facial wrinkles,

asymmetries and defects and conditions of the human skin, all to be sold and marketed only to licensed physicians, surgeons or healthcare professionals.

4. In response to the notice of opposition, the Applicant filed a counter-statement on 3 January 2018 (“**Counter-statement**”).

5. The Opponent’s evidence consists of a statutory declaration made on 24 August 2018 (“**HET SD**”) by Houssam El-Tawil, Commercial Director of the Opponent.

6. The Applicant’s evidence consists of:

(a) a statutory declaration made on 27 April 2020 (“**CPS SD**”) by CHEUNG PUI SHAN, Senior Manager of Sales and Marketing for Allergan Hong Kong Limited (“**Allergan Hong Kong**”) (Allergan plc is the parent company to more than 100 subsidiaries, including Allergan Hong Kong, the Applicant and Allergan, Inc. (collectively, “**Allergan**”)¹);

(b) a statutory declaration made on 29 April 2020 (“**JMD SD**”) by JONATHAN MATTHEW DAY, a partner of Carpmaels & Ransford LLP; and

(c) a statutory declaration made on 12 May 2020 (“**FML SD**”) by FRANCIS MICHEL LEMOINE, president of the Applicant.

7. The opposition hearing was scheduled to take place before me on 28 October 2021. The Opponent has not filed any notice of attendance at hearing (Form T12) within the prescribed period and is treated as not intending to appear at the hearing under rule 74(5) of the Trade Marks Rules (Cap. 559A) (“**TM Rules**”). The Applicant has elected to have the matter decided on the papers in lieu of an oral hearing, and has filed written submissions dated 27 October 2021. I therefore proceed to decide the matter without a hearing pursuant to rule 75(b) of the TM Rules.

Grounds of opposition

8. In the Statement of Grounds, the Opponent states that it is the proprietor of the trade mark “**Juvederm**” (“**Opponent’s Mark**”). It has on 18 October 2016 filed an application for registration of the Opponent’s Mark in Hong Kong (Application No. 303933928) (“**Opponent’s HK Application**”), details of which are set out in **Annex 1**. For the Opponent’s HK Application, the Opponent claimed 22 April 2016 as priority date based on

¹ CPS SD, para. 3.

the Opponent's application for registration of the Opponent's Mark in Norway (Priority Application No. 201605042, Reg. No. 289642) ("**Opponent's Norwegian Application**").²

9. The Opponent claims that the subject application should be refused on the following grounds:

- (a) under section 11(4)(b) of the Ordinance, as the subject mark is likely to deceive the public;
- (b) under section 11(5)(a) of the Ordinance, as use of the subject mark is prohibited in Hong Kong by virtue of the law of passing off;
- (c) under section 11(5)(b) of the Ordinance, as the subject application was made in bad faith; and
- (d) under any one or more of section 12(1) to section 12(5) of the Ordinance, as the subject mark conflicts with an earlier trade mark.

The Opponent

10. According to the HET SD, the Opponent is a company organized and existing under the laws of Lebanon, and first began developing Juverderm cosmetic products in 1999.³ According to the Opponent, the Opponent company was formed in 2007 by the persons who had been involved in the creation of the JUVEDERM brand since 1999.⁴

11. Exhibit A to the HET SD includes two invoices issued by Aesthetic Services & Development ("**ASD**"), a Bulgarian company and a licensee of the Opponent,⁵ to two different companies in Hong Kong.

12. The first invoice is dated 24 August 2015, and is in respect of (i) four units of "Juvederm Eclat (5x5ml) Lot N: 012414" at the unit price of "EUR 0,10"; and (ii) four units of "Juvederm Visage (5x5ml) Lot N: 012315" at the unit price of "EUR 0,10". The following text also appears in the "Description" section of the invoice:

Samples free of charge.
Value for customs purpose only

² Statement of Grounds, paras 2 & 4.

³ HET SD, para. 2.

⁴ HET SD, Exhibit F.

⁵ JMD SD, para. 8v.

13. The second invoice is dated 1 February 2016, and is in respect of 50 units of “Juvederm Éclat (5x5ml) Lot 012414” at the unit price of “EUR 75,00”.

14. Exhibit A to the HET SD also includes printouts showing images of various skin care products of the Opponent with description. The printouts are undated. Images of two such products are reproduced below:



Juvederm VISAGE Anti-aging and lifting mixture



Juvederm ÉCLAT Whitening cocktail

15. The Opponent states that after successful development and sales in the MENA region (Middle East and North Africa) from 1999 to 2006, it filed and registered the Opponent’s Mark in Lebanon on 14 March 2007.⁶ Exhibit B to the HET SD includes copies of (i) Judgment of the First Instance Court in Beirut dated 23 June 2011 with English translation, and (ii) Decision of the Civil Court of Appeal in Beirut dated 29 January 2015 with English translation, relating to proceedings in Lebanon between the Opponent and Allergan in respect of, *inter alia*, the Opponent’s Mark. It was held by the Civil Court of Appeal in Beirut, *inter alia*, that the Opponent ‘was precedent [as compared with Allergan] in *using* the trademarks subject of the litigation as well as precedent in *registering*⁷ them before the competent authorities *in Lebanon*’ (*emphasis added*).

16. The Opponent also filed an opposition in 2017 against an application by the Applicant to register the mark “**JUVÉDERM**” in Macao SAR in respect of goods in Class 3, which proceedings were ongoing at the time of the HET SD.⁸

⁶ HET SD, para. 4.

⁷ According to para. 4 of the HET SD, Allergan Inc. filed an application in Lebanon (No. 111139) on 26 May 2007 for registration of “JUVEDERM” in respect of goods in Classes 5 and 10.

⁸ HET SD, para. 4 & Exhibit B.

17. The Opponent has applied for registration of the Opponent's Mark in the European Union and in a number of other countries in the world.⁹ For example, the Opponent is the holder of International Registration No. 1266937 registered on 17 June 2015, which is based on EU registration 014016737 filed on 30 April 2015 and registered on 3 November 2015.¹⁰ Exhibit C to the HET SD includes copies of official records and certificates in respect of the Opponent's various trade mark applications and registrations.

18. The Opponent states that its Juvederm formulations are manufactured in Europe in accordance with European regulations for cosmetic products (EC) No 1223/2009, and that it has obtained in the name of its licensees free sale certificates by the French Cosmetics Association for SMEs, a prerequisite for market access of finished cosmetic products in more than 15 countries.¹¹

19. The Opponent states that from 2015, it began granting licenses to EU companies, and that according to the license agreements, the licensees develop their own R & D (Research and Development) and manufacturing, and under their own responsibility organize their distribution of the products to end-customers and beauticians.¹²

20. In 2016, the Opponent together with two other companies founded the Beauty Professional Academy, which provides courses designed for beauticians on the use of Juvederm beauty products. It is stated in an undated printout of the Academy's website (<http://beautyprofacademy.com>) that it has established training centers in Bulgaria, Lebanon, Norway and Russia, and the main training center is located in Sofia, Bulgaria.¹³

21. The Opponent states that it has attended various exhibitions in different regions of the world to promote the Opponent's Mark and the Opponent's goods, such as Beauty World Middle East (Dubai 2015), Cosmoprof Asia Expo (Hong Kong 2015) and Dubai Derma (Dubai 2016).¹⁴ Exhibit E to the HET SD includes an extract of the exhibitors list and photos taken at the Cosmoprof Asia Expo held in Hong Kong from 11th to 13th November 2015. The following mark appears at the Opponent's stand at that exhibition:



⁹ HET SD, para. 6.

¹⁰ According to para. 11 of the JMD SD, Allergan has applied to invalidate the Opponent's EU registration 014016737.

¹¹ HET SD, para. 8.

¹² HET SD, para. 9.

¹³ HET SD, para. 10 & Exhibit D.

¹⁴ HET SD, para. 12.

The Applicant

22. According to the Applicant, Allergan's "JUVÉDERM" mark is a collection name for Allergan's cosmetic dermal fillers that are used to smooth wrinkles and add volume to areas of the face where the skin sags ("**Applicant's JUVÉDERM Products**"), and that such products were developed and have been distributed in European and other markets since at least 2001.¹⁵

23. Allergan owns more than 200 trade mark registrations and pending applications worldwide for the trade mark "JUVÉDERM" presented in various forms (including "JUVEDERM" without the accent) and either on its own or in conjunction with other elements (collectively, the "**Applicant's JUVÉDERM Marks**").¹⁶

24. In 2016, the global annual net revenue for the Applicant's JUVÉDERM Products was over US\$ 867 million.¹⁷

25. According to the Applicant, the Applicant's JUVÉDERM Products can only be legally prescribed and administered to patients by trained and qualified physicians and medical practitioners, or under their supervision. With a view to ensure safety and efficacy of the Applicant's JUVÉDERM Products, between 2010 and 2015, Allergan has expended over US\$11 million on research and development of the said products including undertaking analytical research and pre-clinical and clinical studies.¹⁸

26. Allergan has invested time and resources in advertising and promoting the Applicant's JUVÉDERM Products in various parts of the world.¹⁹ Such marketing efforts include Allergan's dedicated website www.juvederm.com and various local websites, outdoor and printed media advertisements, posters in clinics, trade exhibitions and conferences, and consumer information leaflets and brochures.²⁰ Exhibit FML-09 to the FML SD includes archived printouts of the website www.juvederm.com on various dates in 2001, 2002, 2003, 2004, 2008, 2009, 2010, 2011, 2012, 2013, 2014 and 2015, with the earliest printout being dated 17 May 2001.

¹⁵ FML SD, paras 9-10.

¹⁶ FML SD, paras 14-15, Exhibit FML-07.

¹⁷ FML SD, para. 11.

¹⁸ FML SD, paras 17-18.

¹⁹ Including Australia, Brazil, Colombia, Egypt, Finland, France, Georgia, Germany, Greece, Hungary, Italy, Kazakhstan, Morocco, Netherlands, New Zealand, Portugal, Russia, San Marino, Slovenia, South Africa, Spain, Sweden, Turkey, US (FML SD, Exhibit FML-08 pp.280-281).

²⁰ FML SD, paras 19-21, Exhibits FML-08, FML-09 and Exhibit FML-10.

27. Allergan operates dedicated social media accounts relating to the Applicant's JUVÉDERM Products.²¹ Exhibit FML-12 to the FML SD includes printouts from the Facebook and Instagram accounts for the Applicant's JUVÉDERM Products.

28. Allergan has participated in exhibitions and trade fairs to promote the Applicant's JUVÉDERM Products. This includes being a platinum sponsor in 2016 of the International Master Course on Aging Science (IMCAS) World Congress, an annual international congress in aesthetics (medicine, cosmetic dermatology and aesthetic surgery).²²

29. The Applicant's JUVÉDERM Products have featured in articles in the press, magazines and other media in various parts of the world.²³ Exhibit FML-14 to the FML SD includes copies of articles published at online media such as The New York Times, Los Angeles Times and ELLE Australia. The earliest of those articles is dated 9 November 2006.

30. According to the Applicant, Allergan has been using the Applicant's JUVÉDERM Marks in Hong Kong in respect of the Applicant's JUVÉDERM Products since at least as early as 2008.²⁴ Allergan sells the Applicant's JUVÉDERM Products to its sole distributor DKSH Hong Kong Limited ("DKSH"). DKSH then supplies the Hong Kong market for ultimate sale to doctors, health care facilities, beauty salons, aesthetic centres and dermatology centres. This distribution arrangement has been in place since 2008.²⁵

31. Exhibit CPS-05 to the CPS SD includes copies of invoices issued by Allergan Hong Kong to DKSH in Hong Kong in 2012, 2013, 2014, 2015 and 2016. Products covered by the invoices include the following:

JUVÉDERM ULTRA
JUVÉDERM VOLBELLA
JUVÉDERM VOLIFT
JUVÉDERM VOLUMA

32. Exhibit CPS-02 to the CPS SD includes images of the Applicant's JUVÉDERM Products, such as the following:

²¹ FML SD, para. 23, Exhibit FML-12.

²² FML SD, para. 24, Exhibit FML-13.

²³ FML SD, para. 25.

²⁴ CPS SD, para. 11.

²⁵ CPS SD, para. 15.



33. At the time of the CPS SD in April 2020, DKSH has been selling the Applicant's JUVÉDERM Products to approximately 320 trained practitioners and 120 beauty salons, aesthetic centers and dermatology centers in Hong Kong.²⁶ Exhibit CPS-06 includes copies of invoices issued by DKSH to customers in Hong Kong in 2008, 2009, 2010, 2011, 2012, 2013, 2014, 2015 and 2016, the earliest of which is dated 11 December 2008. Products covered by these invoices include the following:

JUVÉDERM ULTRA
JUVÉDERM VOLBELLA
JUVÉDERM VOLUMA

34. Set out in paragraph 21 of the CPS SD are the approximate total net sales of the Applicant's JUVÉDERM Products in Hong Kong for each of the years from 2008 to 2018. Such total net sales rose from approximately USD 2,500,000 in 2008 to approximately USD 27,700,000 in 2016.²⁷

35. Set out in paragraph 23 of the CPS SD are the approximate annual expenditure in connection with advertising and selling the Applicant's JUVÉDERM Products in Hong Kong for each of the years from 2010 to 2018. Such expenditure rose from approximately USD 174,000 in 2010 to approximately USD 610,000 in 2016.²⁸

²⁶ CPS SD, para. 20.

²⁷ CPS SD, para. 21.

²⁸ CPS SD, para. 23.

36. Promotion and marketing of the Applicant's JUVÉDERM Products in Hong Kong has been carried out via online, outdoor and printed media advertisements, posters in clinics, trade exhibitions and conferences, and consumer information leaflets and brochures.²⁹ Exhibit CPS-07 to the CPS SD includes copies of promotional and marketing materials in respect of the products referred to in paragraph 31 above, with dates between 2010 and 2016. Marks used in these materials include the following:



JUVÉDERM



Juvéderm



37. For marketing and promotion of the Applicant's JUVÉDERM Products, Allergan has been operating a Hong Kong website www.juvederm.com.hk from at least 2009 onwards.³⁰ Exhibit CPS-08 includes archived printouts of this website on various dates in 2009, 2010, 2014, 2015 and 2016. Marks appearing on these printouts include the following:



JUVÉDERM

38. Allergan has also promoted the Applicant's JUVÉDERM Products in Hong Kong at events such as seminars, exhibitions and trade fairs, including (i) the JUVÉDERM seminar hosted by Allergan for VIP customers at The Peninsula Hotel, Hong Kong on 23 October 2014; and (ii) a scientific seminar on "Unlocking Facial Codes for Facial Reshaping & Periorbital Rejuvenation" held at the Hyatt Regency, Hong Kong on 3 May 2015.³¹

39. The Applicant's JUVÉDERM Products have featured in various third party websites such as those of Dr. Reborn, Hong Kong Skin Centre, MEDICSKIN Medical Skincare Centre, Skin Lasercare, and SkinWorks Medical Centre.³²

40. The Applicant's JUVÉDERM Products have featured in industry-specific and general media such as the South China Morning Post, Reuters and The Hong Kong Medical Diary published by the Federation of Medical Societies of Hong Kong.³³ Exhibit CPS-12 to the CPS SD includes copies of articles from such media, the earliest of which is an article in the South China Morning Post dated 24 March 2009.

²⁹ CPS SD, para. 22, Exhibit CPS-07.

³⁰ CPS SD, para. 24.

³¹ CPS SD, paras 25-26, Exhibits CPS-09 & CPS-10.

³² CPS SD, para. 27, Exhibit CPS-11.

³³ CPS SD, para. 28, Exhibit CPS-12.

41. The Applicant or its corporate affiliate Allergan, Inc. own the Hong Kong registered trade marks set out in **Annex 2**.³⁴

Section 12(1) to section 12(5) of the Ordinance

42. Section 12 of the Ordinance provides, *inter alia*, as follows:

“12. *Relative grounds for refusal of registration*

- (1) *A trade mark shall not be registered if—*
 - (a) *the trade mark is identical to an earlier trade mark; and*
 - (b) *the goods or services for which the application for registration is made are identical to those for which the earlier trade mark is protected.*

- (2) *A trade mark shall not be registered if—*
 - (a) *the trade mark is identical to an earlier trade mark;*
 - (b) *the goods or services for which the application for registration is made are 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.*

- (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.*

- (4) *Subject to subsection (6), a trade mark which is —*
 - (a) *identical or similar to an earlier trade mark; and*
 - (b) *proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected,**shall not be registered if, or to the extent that, the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and the use of the later trade mark without due cause would take*

³⁴ CPS SD, para. 13, Exhibit CPS-01.

*unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.*³⁵

- (5) *Subject to subsection (6), 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); or*
- (b) *by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (4) (in particular, by virtue of the law of copyright or registered designs),*
- 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.”*

43. I will first consider the Opponent’s case under section 12(5) of the Ordinance.

Opposition under section 12(5) of the Ordinance

44. The issue for determination under section 12(5)(a) of the Ordinance is whether normal and fair use of the subject mark for the purpose of distinguishing the subject goods 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] R.P.C. 455).

45. The elements of the tort of passing off as formulated by Lord Oliver in *Reckitt & Colman Products Limited v. Borden* [1990] R.P.C. 341 (the *JIF* case) have been repeatedly relied upon (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). Adapted to the facts of the present case, the Opponent has to establish that:

- (a) the Opponent has sufficient **goodwill** attached to the Opponent’s goods in the mind of the purchasing public by association with the Opponent’s Mark;
- (b) the Applicant has made a **misrepresentation** leading or likely to lead the public to believe that the subject goods offered by the Applicant are the goods of the Opponent; and

³⁵ Although section 6 of the Trade Marks (Amendment) Ordinance 2020 (3 of 2020) came into operation on 19 June 2020 amending, *inter alia*, section 12(4) of the Ordinance, pursuant to section 2(1), Schedule 7 to the Ordinance, the pre-amended Ordinance continues to apply in relation to the subject application.

- (c) the Opponent suffers, or is likely to suffer, **damage** by reason of the erroneous belief engendered by the Applicant's misrepresentation that the source of the Applicant's subject goods is the same as the source of the goods offered by the Opponent.

46. The relevant date for proving reputation and goodwill in a claim for passing off is the date of commencement of the activities complained of (*Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] R.P.C. 429 at 494). Although the relevant date for assessing whether section 12(5)(a) of the Ordinance applies is the date of the application for registration (or, if there is a priority date, that date), where the applicant has used the mark before the date of the application for registration, it is necessary to consider what the position would have been at the date of first use of the applicant's mark for the goods or services in question. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application. As stated in *Advanced Perimeter Systems Ltd v Keycorp Ltd* [2012] R.P.C. 14:

'41 There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Croom's Trade Mark Application* [2005] R.P.C. 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42 As to (b), it is well established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Co. Inc. v Penneys Ltd.* [1975] F.S.R. 367; *Cadbury-Schweppes Pty Ltd v The Pub Squash Co. Ltd* [1981] R.P.C. 429 (PC); *Barnsley Brewery Company Ltd v RBNB* [1997] F.S.R. 462; *Inter Lotto (UK) Ltd v Camelot Group plc* [2003] EWCA Civ 1132, [2004] R.P.C. 9 : "date of commencement of the conduct complained of." If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43 In *SWORDERS Trade Mark* BL O/212/06 Mr Alan James acting for the registrar summarised the position well in s.5(4)(a) proceedings as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Art.4 of Directive 89/104 . However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

44 In the specific context of s.5(4)(a), the relevant date will be that of first use of the applicant's mark for the goods or services in question....’

47. The earliest of the invoices referred to in paragraph 33 above is dated 11 December 2008. The Applicant’s JUVÉDERM Products have featured in the media as referred to in paragraph 40 above, the earliest instance of which was an article in the South China Morning Post dated 24 March 2009. Promotional materials for marketing the Applicant’s JUVÉDERM Products in Hong Kong between 2011 and 2016 show use of the marks referred to in paragraph 36 above. The Applicant has provided approximate sales figures of the Applicant’s JUVÉDERM Products in Hong Kong since 2008 and the approximate amounts expended in advertising and selling the Applicant’s JUVÉDERM Products in Hong Kong since 2010 (paragraphs 34 to 35 above). I am satisfied that the Applicant has used the subject mark in Hong Kong in respect of the subject goods since no later than December 2008.

48. The earliest invoice provided in these proceedings in respect of sales of the Opponent’s “Juvederm” products in Hong Kong is dated “24 August 2015” (paragraph 12 above). The Opponent participated in the exhibition in Hong Kong referred to in paragraph 21 above in November 2015. The printouts showing images of the Opponent’s “Juvederm” products referred to in paragraph 14 above are undated. There is no evidence as to the volume of sales of the Opponent’s “Juvederm” products in Hong Kong or of the amounts expended in promoting such goods in Hong Kong. There is no evidence that the Opponent has used the Opponent’s Mark in Hong Kong before 2015.

49. Having considered the Opponent’s evidence as a whole, I am not satisfied that at the date of the Applicant’s first use of the subject mark in Hong Kong in respect of the subject goods, the Opponent has sufficient goodwill attached to the Opponent’s goods in the mind of the purchasing public by association with the Opponent’s Mark to mount an action in passing off.

50. As the Opponent lacks entitlement to prevent the Applicant from using the subject mark in respect of the subject goods in Hong Kong by virtue of the law of passing off, the Opponent's opposition under section 12(5)(a) of the Ordinance fails.

51. The Opponent has not claimed any other earlier right for the purpose of section 12(5)(b) of the Ordinance.

52. The Opponent therefore cannot succeed whether under section 12(5)(a) or 12(5)(b) of the Ordinance.

Opposition under section 12(4) of the Ordinance

53. I refer to the provisions of section 12(4) of the Ordinance set out in paragraph 42 above.

54. To succeed under section 12(4) of the Ordinance, the Opponent has to establish that:

- (a) the Opponent's Mark is an earlier trade mark which is entitled to protection under the Paris Convention as a well-known trade mark at the Application Date;
- (b) the subject mark is identical or similar to the Opponent's Mark, and that on a global appreciation of all the factors relevant to the circumstances, the use of the subject mark would give rise to a link with the Opponent's Mark in the minds of the relevant public; and
- (c) in consequence of that link, the use of the subject mark without due cause either takes unfair advantage of the distinctive character or repute of the Opponent's Mark or is detrimental to that distinctive character or repute.

55. The requirements listed in paragraph 54(a) to (c) above are cumulative. Each of those requirements must be established before a claim under section 12(4) of the Ordinance could succeed.

Well-known trade mark

56. I refer to the requirement set out in paragraph 54(a) above.

57. Section 4 of the Ordinance provides, *inter alia*, as follows:

“(1) References in this Ordinance to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as references to a trade mark which is well known in Hong Kong and which is the trade mark of a person who-

(a) is a national of, or is domiciled or ordinarily resident in, a Paris Convention country or WTO member;

(b) has a right of abode in Hong Kong; or

(c) has a real and effective industrial or commercial establishment in a Paris Convention country, a WTO member or Hong Kong,

whether or not that person carries on business in Hong Kong or owns any goodwill in a business in Hong Kong.

(2) In determining for the purposes of subsection (1) whether a trade mark is well known in Hong Kong, the Registrar or the court shall have regard to Schedule 2.”

58. Section 5(1) of the Ordinance provides, *inter alia*, as follows:

“In this Ordinance, "earlier trade mark" (在先商標), in relation to another trade mark, means-

...

(b) a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention as a well-known trade mark.”

59. The Applicant has not claimed any priority in respect of the subject application. Pursuant to sections 4(1) and 5(1)(b) of the Ordinance, the relevant question is whether the Opponent’s Mark is well known in Hong Kong at the Application Date.

60. In determining whether the Opponent’s Mark is well known in Hong Kong, I have to take into account any factors from which it may be inferred that the trade mark is well known in Hong Kong (section 1(1) of Schedule 2 to the Ordinance). I shall consider any information submitted in this regard, including, but not limited to, any information concerning:³⁶

(a) the degree of knowledge or recognition of the trade mark in the relevant sectors of the public;

³⁶ Section 1(2), Schedule 2 to the Ordinance.

- (b) the duration, extent and geographical area of any use of the trade mark;
- (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the trade mark, to the extent that they reflect use or recognition of the trade mark;
- (e) the record of successful enforcement of rights in the trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by competent authorities in foreign jurisdictions; and
- (f) the value associated with the trade mark.

61. The two invoices referred to in paragraphs 11 to 13 above are the only invoices provided by the Opponent in these proceedings in respect of sale of the Opponent's products under the Opponent's Mark. No sales figures have been provided. There is, therefore, limited evidence on the duration, extent and geographical area of use of the Opponent's Mark.

62. The printouts showing images of various skin care products of the Opponent referred to in paragraph 14 above are undated. Other than participation in the exhibitions in 2015 and 2016 referred to in paragraph 21 above, there is very little evidence on the Opponent's efforts in promoting the Opponent's Mark. No figures on the amounts expended in promoting or advertising the Opponent's Mark have been provided. Although it is stated that the Beauty Professional Academy referred to in paragraph 20 above was founded in 2016, there is no evidence as to whether this was before or after the Application Date. There is no training center of that Academy in Hong Kong. Overall, there is limited evidence on the duration, extent and geographical area of promotion of the Opponent's Mark.

63. I have considered the official records and certificates at Exhibit C to the HET SD in respect of the Opponent's trade mark applications and registrations in a number of countries and regions in the world. There is no evidence of use of the Opponent's Mark in these countries and regions save as described above.

64. Save as to the proceedings in Lebanon referred to in paragraph 15 above, there is no record of successful enforcement of rights in the Opponent's Mark. There is no evidence that the Opponent's Mark has been recognized as a well-known trade mark by any competent authority in any foreign jurisdiction. There is no evidence as to the value associated with the Opponent's Mark. There is no direct evidence on the degree of knowledge or recognition of the Opponent's Mark in the relevant sectors of the public in Hong Kong.

65. Having regard to the totality of the Opponent's evidence filed in these proceedings and all relevant factors for consideration in accordance with section 1, Schedule 2 to the Ordinance, I find that the Opponent has failed to establish that the Opponent's Mark is well known in Hong Kong as at the Application Date.

66. Since the Opponent has failed to establish the requirement referred to in paragraph 54(a) above, the claim under section 12(4) of the Ordinance necessarily fails.

Opposition under sections 12(1), 12(2) and 12(3) of the Ordinance

67. I refer to the provisions of sections 12(1), 12(2) and 12(3) of the Ordinance set out in paragraph 42 above. To rely on any of those provisions, the Opponent has to establish that there is an earlier trade mark in relation to the subject mark.

68. Section 5 of the Ordinance provides, *inter alia*, that:

"(1) In this Ordinance, "earlier trade mark" (在先商標), in relation to another trade mark, means—

*(a) a **registered trade mark** which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any; or*

*(b) a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention as a **well-known trade mark**.*

*(2) References in this Ordinance 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 this Ordinance and which, if registered, would constitute an earlier trade mark under or by virtue of subsection (1)(a), **subject to its being so registered.**" (*emphasis added*)*

69. I refer to section 5(1)(a) of the Ordinance set out above. The Opponent’s Mark is not a registered trade mark in Hong Kong. The Opponent’s HK Application has not matured to registration. The Opponent does not have any registered trade mark to rely on for the purpose of section 5(1)(a) of the Ordinance.

70. For section 5(1)(b) of the Ordinance, I have already found that the Opponent has failed to establish that the Opponent’s Mark is an earlier trade mark which is entitled to protection under the Paris Convention as a well-known trade mark at the Application Date (paragraphs 65-66 above).

71. For the purpose of section 5(2) of the Ordinance, the Opponent relies on the Opponent’s HK Application, claiming 22 April 2016 as priority date based on the Opponent’s Norwegian Application.

72. Section 41(1) of the Ordinance provides that:

*“(1) A person who has duly filed an application for the registration of a trade mark in, or in respect of, a Paris Convention country or WTO member, or his successor in title, shall enjoy, for the purpose of registering the same trade mark under this Ordinance in respect of any or all of the same goods or services, a right of priority for a period of 6 months after the date of filing of **the first of any such applications**, subject to compliance with any prescribed conditions.” (emphasis added).*

73. Before filing the Opponent’s Norwegian Application, the Opponent has filed the following applications for registration:³⁷

	Trade Mark	Application/ Registration No.	Application date	Country/ territory / area	Classes
(i)	JUVEDERM	2015/21232	12/03/2015	Turkey	3, 5, 35
(ii)	JUVEDERM	2015136198N	18/03/2015	Bulgaria	3, 5, 35
(iii)	JUVEDERM	014016737	30/04/2015	European Union	3, 35, 44

74. Each of Norway, Turkey and Bulgaria is a Paris Convention country, and each of these countries as well as the European Union is a WTO member. Each of the applications referred to in paragraph 73 above was filed more than six months prior to the date of filing of the Opponent’s HK Application (i.e. 18 October 2016).

³⁷ JMD SD, para. 14 & Exhibit JMD-12.

75. Although the date of filing of the Opponent's HK Application was within 6 months after the date of filing of the Opponent's Norwegian Application (i.e. 22 April 2016), the Opponent's Norwegian Application was not the first filing of application for registration of the Opponent's Mark in a Paris Convention country or WTO member in respect of the relevant goods. The applications referred to in paragraph 73 above were filed before the filing of the Opponent's Norwegian Application. The Opponent therefore cannot claim 22 April 2016 as priority date for the Opponent's HK Application. Moreover, as provided in section 5(2) of the Ordinance, reliance on an application for registration of a trade mark for the purpose of that provision is subject to the mark being registered. The Opponent's HK Application has not, however, matured to registration. The Opponent cannot rely on the Opponent's HK Application for the purpose of section 5(2) of the Ordinance.

76. As there is no earlier trade mark which the Opponent can rely on for the purpose of sections 12(1), 12(2) and 12(3) of the Ordinance, the Opponent cannot succeed in its opposition under any of those provisions.

Opposition under section 11(4)(b) of the Ordinance

77. Section 11(4)(b) of the Ordinance provides that :

“(4) *A trade mark shall not be registered if it is –*
...
(b) likely to deceive the public.”

78. In the Statement of Grounds, the Opponent claims, *inter alia*, that:

“12. The [subject mark] is confusingly similar or identical to the **Juvederm** Mark. The significance of the [subject mark]'s logo design is small relative to its wording, which should be regarded as the essential part of the [subject mark] as consumers are more likely to use it as an identifying element. The Opponent's right to the **Juvederm** Mark covers all representations of the standardised characters, including differences in font style and the inclusion of accent marks like in the [subject mark].

13. Therefore, the Applicant's use of the [subject mark] will or is likely or intended to mislead the public that any goods and/or services supplied or marketed under it are those of the Opponent. Such possibility is further enhanced as the goods and/or services of the [subject mark] are similar or identical in nature to those provided by the Opponent. Registration of the [subject mark] would unfairly

prejudice the legitimate business interests of the Opponent and should be refused under Sections 11 and 12 of the Ordinance.

14. By reason of the foregoing, the [subject mark] should be refused registration on any or all of the following grounds:

(a) Registration of the [subject mark] is likely to deceive the public under Section 11(4)(b) of the Ordinance.”

79. It is clear from paragraphs 12, 13 and 14(a) of the Statement of Grounds that the Opponent’s ground of opposition under section 11(4)(b) of the Ordinance is based on the alleged similarity between the subject mark and the Opponent’s Mark “**Juvederm**”.

80. Section 11(4)(b) of the Ordinance is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. This is consistent with the heading of section 11 of the Ordinance which is entitled “**Absolute grounds for refusal of registration**” and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties.³⁸ Consequently, the Opponent cannot succeed under section 11(4)(b) of the Ordinance based upon its allegedly similar mark. The ground of opposition under section 11(4)(b) of the Ordinance is not made out.

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

81. Section 11(5)(a) of the Ordinance provides that :

“(5) *A trade mark shall not be registered if, or to the extent that –*
(a) *its use is prohibited in Hong Kong under or by virtue of any law;*”.

82. In paragraph 14(b) of the Statement of Grounds, the Opponent states that:

“(b) Registration of the [subject mark] is contrary to Section 11(5)(a) because its use is prohibited in Hong Kong by virtue of the law of passing off.”

83. The ground under section 11(5)(a) of the Ordinance, however, is an absolute ground for refusal, and is concerned with the trade mark itself. An objection that use of a mark conflicts with another mark arises under section 12 of the Ordinance and not under section

³⁸ *QS by S. Oliver Trade Mark* [1999] R.P.C. 520 at 524; *Kerly’s Law of Trade Marks and Trade Names* (16th Edn.) para. 10-216.

11(5)(a).³⁹ Moreover, I have already found that the Opponent lacks entitlement to prevent the Applicant from using the subject mark in respect of the subject goods in Hong Kong by virtue of the law of passing off (paragraph 50 above). The ground of opposition under section 11(5)(a) of the Ordinance therefore necessarily fails.

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

84. Section 11(5)(b) of the Ordinance provides that :

“(5) *A trade mark shall not be registered if, or to the extent that –*

...

(b) the application for registration of the trade mark is made in bad faith.”

85. In the Statement of Grounds, after the claims referred to in paragraphs 78 and 82 above, the Opponent claims in paragraph 14(c) that the subject mark should be refused registration on the ground that:

“The application for registration of the [subject mark] was made in bad faith, under Section 11(5)(b) of the Ordinance.”

86. The term “bad faith” is not defined in the Ordinance. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 at 379, Lindsay J. said 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.”

87. In *Harrison v Teton Valley Trading Co (CHINAWHITE)* [2005] F.S.R. 10, the English Court of Appeal held that (at para. 26):

³⁹ *Kerly's Law of Trade Marks and Trade Names* (16th Edn.) para. 10-223.

“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.”

88. Further, in *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person stated 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.”

89. The above principles have been applied in *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG (LG Corporation)* HCMP 881/2013 (paras 25-27).

90. The fact that an applicant knows that a third party has long been using an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith. Consideration must also be given to the applicant’s intention at the time when he files the application for registration, which is a subjective factor to be determined by reference to the objective circumstances of the particular case. (*Chocoladefabriken Lindt v Franz Hauswirth GmbH* [2009] E.T.M.R. 56, at paras 40-41).

91. The Court in *Lindt* stopped short of defining bad faith. Rather it preferred to give guidance on the factors which might contribute to such a finding in particular factual scenarios close to those in issue in the main proceedings in that case. One theme which emerges is that the facts must justify a conclusion that the applicant’s intentions were solely ones which were inconsistent with the essential functions of a trade mark or designed to promote unfair competition. If the facts show that the applicant is justified in applying for the mark, for example because he seeks to prevent third parties taking advantage of his sign, or if he has a reputation which deserves broader protection, this is capable of defeating an allegation of bad faith (*Sky v Skykick* [2021] EWCA Civ 1121, at para. 52).

92. An allegation that a trade mark has been applied for in bad faith is a serious allegation. It should not be made unless it can be fully and properly pleaded and should not be

upheld unless it is distinctly proved (*ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24 at para. 31). The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith (*Brutt Trade Marks* [2007] R.P.C. 19 at para. 29).

93. It is not entirely clear from the Statement of Grounds what facts the Opponent is relying upon for the bad faith claim under section 11(5)(b) of the Ordinance.

94. In the HET SD, it is stated that:

“15. In summary of the aforementioned points, the Opponent has first use of the **Juvederm** Mark since 1999 and has been using it honestly for 17 years. I believe the Applicant applied for registration of the [subject mark] with this knowledge and therefore in bad faith – “Exhibit F” and that it should not be allowed to register which causes damage to the Opponent.”

95. Exhibit F to the HET SD consists of submissions. No evidence of actual use has been provided to verify the claim that the Opponent first used the **Juvederm** Mark in 1999.

96. According to the Opponent, after successful development and sales in the MENA region (Middle East and North Africa) from 1999 to 2006, the Opponent filed and registered the trade mark **Juvederm** in Lebanon on 14 March 2007.⁴⁰ From 2015 the Opponent began granting licenses to specialized EU companies.⁴¹

97. In these proceedings, the Opponent has provided no sales figures and no figures on the amounts expended in promoting or advertising the Opponent’s Mark, whether in Hong Kong or elsewhere. The extent of use of the Opponent’s Mark and the extent of any goodwill or reputation attached to the Opponent’s goods under the Opponent’s Mark anywhere in the world are therefore unclear.

98. The Applicant’s case is that the Applicant’s JUVÉDERM Products were developed and have been distributed in European and other markets since at least 2001.⁴² The earliest of the archived printouts from the Applicant’s website www.juvederm.com is dated 17 May 2001.⁴³ According to the Applicant, Allergan discovered in 2007 that the Opponent had

⁴⁰ Para. 15 above.

⁴¹ Para. 19 above.

⁴² Para. 22 above.

⁴³ Para. 26 above.

applied to register the Opponent's Mark in Lebanon. Also in 2007, the Opponent began offering for sale "Juvederm" branded products to doctors in France and Switzerland.⁴⁴

99. There is no evidence of the extent of any goodwill or reputation attached to the Opponent's products under the Opponent's Mark when the Applicant first developed and distributed the Applicant's JUVÉDERM Products.

100. I have already found that the Applicant has used the subject mark in Hong Kong in respect of the subject goods since no later than December 2008 (paragraph 47 above). Allergan has the registered trade marks in Hong Kong referred to in **Annex 2** hereto, amongst which application for registration of the mark "JUVÉDERM" (Trade Mark No. 300846162) was filed in April 2007. The Applicant has provided approximate sales figures regarding the Applicant's JUVÉDERM Products in Hong Kong since 2008 and the approximate amounts expended since 2010 in advertising and selling such products in Hong Kong, which are substantial.

101. On the other hand, there is no evidence that the Opponent has used the Opponent's Mark in Hong Kong before 2015 (paragraph 48 above). I have already found that at the date of the Applicant's first use of the subject mark in Hong Kong in respect of the subject goods, the Opponent does not enjoy sufficient goodwill attached to the Opponent's goods in the mind of the purchasing public by association with the Opponent's Mark to mount an action in passing off. There is no earlier trade mark and no earlier right which the Opponent can rely on for the purpose of section 12 of the Ordinance.

102. Taking into account all the relevant circumstances of this case, I do not find that the Applicant's decision to apply for registration of the subject mark in respect of the subject goods would be regarded as in bad faith by persons adopting proper standards. The ground of opposition under section 11(5)(b) of the Ordinance is not made out.

Conclusion and Costs

103. I have considered each of the grounds of opposition relied on by the Opponent and found that none of them has been made out. The opposition against registration of the subject mark in respect of the subject goods therefore fails.

104. As the opposition has failed, I award the Applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party

⁴⁴ JMD SD, paras 8ii & 8iii.

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 between the parties.

(Finnie Quek)
for Registrar of Trade Marks
28 March 2022

Opponent's HK Application

Trade Mark No.	303933928
Mark	Juvederm
Class No.:	3
Specification	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; Cosmetics for professional use and for use by the end consumer; Cosmetic creams, emulsions, lotions, liquids, solutions, milks, gels and oils for the skin (of the face, body, hands, feet, and neck), oils for cosmetic purposes; cosmetic kits; cosmetic products and preparations for skin care; cosmetic masks; cosmetics, cosmetic preparations for slimming purposes; cosmetics for exfoliation, cosmetic peelings; cosmetics for smoothing the skin; cosmetics for hair conditioning and care of the hair and scalp; cosmetic sunscreen products and preparations (emulsions, lotions, milks, gels, oils, liquids); cosmetic preparations for skin whitening, skin whitening creams; bleaching preparations (decolorants) for cosmetic purposes; cosmetics for lightening the skin; cosmetics for perfecting the complexion; anti-wrinkle cosmetics, skin rejuvenation cosmetics, skin lightening cosmetics; cosmetic preparations for skin hydration; cosmetics for toning the skin; essential oils and aromatic extracts; toiletries; cleaning and fragrancng preparations; all included in class 03.
Date of Filing	18-10-2016
Dates of Priority Claimed:	22-04-2016
Priority Application No.:	N° 201605042
Country/Territory/Area of Priority Applications:	NORWAY

Allergan's Hong Kong registered trade marks

Trade Mark No.	Mark	Registered Owner	Filing date	Classes
300846162	JUVÉDERM	Applicant	04-04-2007	5, 10
301059020	JUVÉDERM REFINE	Allergan, Inc.	26-02-2008	5, 10
302806452	JUVÉDERM VISTA	ALLERGAN, INC.	18-11-2013	5, 10
303181590	JUVÉDERM VOLITE	Allergan, Inc.	29-10-2014	5
303231143	JUVÉDERM VYBRANCE	Allergan, Inc.	10-12-2014	5