

Application Nos 2618/89
2619/89

IN THE MATTER of the
Trade Marks Ordinance (Cap. 43)

AND

IN THE MATTER of applications by
Miki K.K. for registration of the
trade marks

ジョイ
JOY

in Class 14 in Part A of the
Register

and

ブティック ジョイ
BOUTIQUE JOY

in Class 16 in Part B of the
Register

AND

IN THE MATTER of oppositions
thereto by Joyce Boutique Limited

DECISION
OF

Mr. M.W. Fox acting for the Registrar of Trade Marks after a
hearing on Tuesday, 4th January 1994.

Appearing : Mr Colin Shipp, Counsel, instructed by Robin
Bridge and John Liu on behalf of the Applicant,
Miki K.K.

Mr John Yan, Counsel, instructed by Baker &
McKenzie on behalf of the Opponent, Joyce
Boutique Limited

1. On 31st March 1989 Miki K.K. (hereinafter "the Applicant") of Tokyo, Japan applied under the Trade Marks Ordinance (hereinafter called "the Ordinance") for registration of a trade mark in Part A of the Register in Class 14 in respect of "precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery, precious stones, horological and chronometric instruments" (hereinafter called "the Class 14 specified goods"). A representation of the mark applied for following a subsequent authorized amendment (hereinafter called "the Class 14 suit mark"), appears below :-

ジョイ
JOY

2. Also on 31st March 1989 the Applicant applied under the Ordinance for registration of a trade mark in, following a subsequent authorized amendment, Part B of the Register in Class 16 in respect of "printed matter and periodicals" (hereinafter called "the Class 16 specified goods"). A representation of the mark applied for (hereinafter called "the Class 16 suit mark") appears below :-

ブティック ジョイ
BOUTIQUE JOY

3. Leave to advertise the Class 16 suit mark in respect of the Class 16 specified goods was given on 16th September 1991 on condition registration of the mark shall give no right to the exclusive use of the word "BOUTIQUE" and the Japanese characters which represent phonetically the word "BOUTIQUE". The Japanese characters in the mark, which have no meaning, phonetically represent the words "BOUTIQUE JOY". The mark was advertised in the gazette on 11th October 1991.

4. Leave to advertise the Class 14 suit mark in respect of the Class 14 specified goods was given on 26th September 1991

on condition there appeared in the advertisement the following :- "This Trade Mark is to be associated with the Trade Mark of pending applications Nos. 2640, 2650 and 2666/89.". The Japanese characters in the mark, which have no meaning, phonetically represent the word "JOY". The mark was also advertised in the gazette on 11th October 1991.

5. The applications were opposed by Joyce Boutique Limited (hereinafter called "the Opponent") of Central, Hong Kong which lodged its notices of opposition on 11th December 1991 on grounds effectively that :-

- (a) The Opponent had at the 31st March 1989 application date a substantial, long standing reputation as a publisher of fashion magazines and a manufacturer and retailer of high quality fashion garments and accessories.
- (b) The Opponent applied to register JOYCE in Class 16 in Hong Kong on 16th January 1987 under No. 255/87.
- (c) The Opponent applied to register JOYCE in Class 14 in Hong Kong on 19th October 1989 under No. 8251/89.
- (d) The Opponent has traded under the name JOYCE BOUTIQUE since 1986.
- (e) The Opponent's JOYCE mark has been substantially and extensively used in Hong Kong since 1987 on publications.
- (f) Use of the Class 14 suit mark by the Applicant in relation to the Class 14 specified goods would mislead likely purchasers of such goods into believing they are goods of or associated with the Opponent.
- (g) As the Class 16 suit mark contains the word JOY use by the Applicant of JOY in relation to the Class 16 goods would mislead likely purchasers of such goods into believing they are goods of or associated with the Opponent.
- (h) Registration of either suit mark would contravene section 9 of the Ordinance as neither suit mark is adapted to distinguish the goods in respect of which registration is sought.
- (i) Registration of either suit mark would contravene section 12(1) of the Ordinance because use of either mark in relation to the goods in respect of which registration is sought would be likely to deceive and/or would be disentitled to protection in a court of justice and would be contrary to law.

(j) The suit marks are not trade marks within section 2(1) of the Ordinance because at the application date the Applicant had neither used them or proposed to use them to indicate a connection in course of trade between the Applicant and the goods in respect of which registration is sought.

6. The Opponent also seeks refusal of registration in exercise of the Registrar's discretion.

7. The Applicant by its counter-statements lodged on 17th February 1992, relies, effectively, on the following grounds in support of its applications :-

(a) The Opponent's JOYCE marked goods are not the same goods or description of goods as the Class 14 specified goods.

(b) Use of the suit marks in relation to the goods in respect of which registration is sought would not mislead likely purchasers of such goods into believing they are goods of or associated with the Opponent.

(c) The Applicant relies on the issue by the Registrar of the leaves to advertise the marks as establishing they are adapted to distinguish the goods in respect of which registration is sought under section 9 of the Ordinance.

(d) Registration of the suit marks would not contravene section 12(1) of the Ordinance.

(e) The suit marks are trade marks within section 2(1) of the Ordinance.

(f) No rights of a trade mark nature or otherwise are vested in the Opponent to prevent registration of either suit mark.

8. The Applicant also seeks registration in exercise of the Registrar's discretion.

9. Evidence in support of the Class 14 opposition comes in a declaration dated 5th August 1992 of Yvette Ma, the Opponent's Finance and Corporate Affairs Director.

10. Evidence in support of the Class 16 opposition comes in a declaration also dated 5th August 1992 of Adrienne Ma, the Opponent's Publisher.

11. Ms Yvette Ma says the Opponent applied to register its JOYCE mark in Class 14 under No. 8251/89 in respect of "precious metals and their alloys and goods in precious metals or coated

therewith; not included other classes; jewellery; precious stones; horological and chronometric instruments".

12. Ms Yvette Ma says the Opponent has been continuously selling JOYCE marked necklaces, brooches, bracelets and earrings in Hong Kong since March 1989.

13. Ms Yvette Ma gives Hong Kong sales figures of JOYCE marked necklaces, brooches, bracelets and earrings for the years 1989 - 1991 inclusive showing sales of approximately HK\$2.42 million in 1989.

14. Ms Yvette Ma gives Hong Kong sales figures of all the Opponent's JOYCE marked goods for the years 1988 - 1991 inclusive showing sales in 1988 of approximately HK\$300,000 and sales the following year of approximately HK\$3.42 million.

15. Ms Yvette Ma says the Opponent's JOYCE mark is applied to its necklaces, brooches, bracelets and earrings by hang tags attached thereto.

16. Ms Yvette Ma says the Opponent has advertised its JOYCE marked necklaces, brooches, bracelets and earrings in newspaper and magazines since March 1989. She says the Opponent has published its JOYCE branded fashion magazine since September 1986 and it now enjoys an enviable reputation as a quality fashion magazine.

17. Ms Yvette Ma gives expenditure figures for marketing the Opponent's JOYCE marked goods and promoting JOYCE fashion shops in Hong Kong for the fiscal years 1988/89 - 1991/92 inclusive showing expenditure of some HK\$3.1 million in the 1988/89 fiscal year increasing to about HK\$4.64 million the following year.

18. Ms Yvette Ma says the Opponent advertises its fashion products including jewellery, clothing, ties and leather products. She exhibits (YM-1) advertisements in support.

19. Ms Yvette Ma exhibits (YM-2) invoices showing sales of the Opponent's JOYCE marked necklaces, brooches, bracelets and earrings.

20. Ms Yvette Ma gives details of the Opponent's sponsorship or co-sponsorship of television programmes since 1990 showing six sponsored or co-sponsored programmes that year and for the next year.

21. Ms Yvette Ma says the Opponent has donated significant amounts to charitable organizations.

22. Ms Yvette Ma exhibits (YM-3) articles about the Opponent.

23. Ms Yvette Ma says the Opponent has used its JOYCE mark on fashion boutiques it has operated since 1970, twelve such boutiques being operated prior to the 31st March 1989 application date.

24. Ms Yvette Ma considers the JOYCE mark signifies to the trade and public the Opponent's necklaces, brooches, bracelets and earrings.

25. Noting the Japanese characters in the Class 14 suit mark, which have no meaning, represent the word JOY phonetically, Ms Yvette Ma says the English word JOY comprises the first three letters of the Opponent's JOYCE mark and the Japanese characters are phonetically equivalent to the first syllable of the Opponent's JOYCE mark.

26. Ms Yvette Ma considers use by the Applicant of the Class 14 suit mark in relation to jewellery would cause the public to believe it was manufactured by or with the authority of the Opponent.

27. Ms Adrienne Ma says the Opponent applied to register its JOYCE mark in Class 16 under No. 255/87 in respect of "paper, cardboard and goods made from these materials, not included other classes, printed matter, printed publications; magazines, including fashion magazines; photographs; bags of paper or plastics for packaging".

28. Ms Adrienne Ma says the Opponent started selling its JOYCE marked goods in Hong Kong in September 1986, continuously using its mark since then on fashion magazines. Ms Adrienne Ma says the Opponent circulated free to its customers approximately 8,000 magazines each year from 1986 - 1991. Ms Adrienne Ma continues that from Winter 1991 an additional 15,000 copies were circulated free to JOYCE card holders. Ms Adrienne Ma exhibits (AM-1) a 1991 Audit Bureau of Circulations report.

29. Ms Adrienne Ma gives Hong Kong sales figures of the Opponent's JOYCE marked fashion magazines from 1988 - 1991 inclusive showing approximate sales the first year of HK\$64,500 increasing to HK\$193,000 the following year.

30. Ms Adrienne Ma says, exhibiting (AM-2) in support, the Opponent's JOYCE mark is applied to its fashion magazines by printing on the cover as well as appearing on the plastic wrapping in which they are packed for posting.

31. Ms Adrienne Ma says the Opponent has since September 1986 advertised its JOYCE marked fashion magazines in newspapers.

32. Ms Adrienne Ma gives expenditure figures incurred by the Opponent in advertising its magazines in newspapers for the quarterly periods between Spring 1989 and Winter 1990. She

exhibits (AM-3) advertisement in support.

33. Ms Adrienne Ma exhibits (AM-4) invoices showing sales of the Opponent's JOYCE marked fashion magazines.

34. Ms Adrienne Ma says the Opponent's revenue from advertisements in its fashion magazines exceeded HK\$4.3 million in 1990 and HK\$4.5 million in 1991.

35. Ms Adrienne Ma says the Opponent has traded in fashion wear and accessories through JOYCE or JOYCE BOUTIQUE outlets since 1986, such outlets being advertised in newspapers and on television.

36. Ms Adrienne Ma says the Opponent's JOYCE mark has been used on fashion boutiques it has operated since 1970, twelve such boutiques being operated prior to the 30th March 1989 application date. Ms Adrienne Ma says the Opponent now operates six boutiques under the JOYCE or The World of JOYCE names.

37. Ms Adrienne Ma says the Opponent operates nineteen fashion boutiques under names of international fashion designers such as Giorgio Armani, Sonia Rykiel, Karl Lagerfeld. She says these boutiques are described in advertisements as "a JOYCE BOUTIQUE".

38. Ms Adrienne Ma exhibits (AM-5) articles about the Opponent.

39. Ms Adrienne Ma says the Opponent's JOYCE marked magazine is closely connected with and is sold at the JOYCE BOUTIQUES.

40. Ms Adrienne Ma considers the Applicant's Class 16 suit mark if used in relation to magazines is likely to cause confusion due to the Opponent's enviable application date reputation in its JOYCE magazine and the Opponent's fashion stores being referred to by the general public as JOYCE BOUTIQUES. Ms Adrienne Ma says the English words, BOUTIQUE JOY, in the Class 16 suit mark are a reversal of the main elements of the JOYCE BOUTIQUE name. Ms Adrienne Ma considers the public could reasonably mistake JOY for an abbreviation of JOYCE particularly as JOY is the important prefix of JOYCE.

41. Saying that the Japanese characters in the Class 16 suit mark are phonetically equivalent to the English words BOUTIQUE JOY Ms Adrienne Ma considers this emphasizes the similarity between BOUTIQUE JOY and JOYCE BOUTIQUE.

42. Ms Adrienne Ma considers use by the Applicant of the Class 16 suit mark in relation to magazines would cause the public to believe they were manufactured by or with the authority of the Opponent.

43. Ms Adrienne Ma also provides certain information given by Ms Yvette Ma (see paragraphs 14, 20 and 21 hereof).

44. No evidence was filed on behalf of the Applicant.

45. Mr Yan said the opposition to the Class 14 application is based on sections 9 and 12(1) of the Ordinance and the opposition to the Class 16 application is based on sections 10 and 12(1). Both counsel agreed the reference to section 9 in paragraph 8 of the Notice of Opposition to the Class 16 application is incorrect and that it should be a reference to section 10 with the words "adapted to distinguish" being replaced by "capable of distinguishing".

46. I will proceed on that basis and deal with the registrability issues first.

47. Sections 9 and 10 of the Ordinance, applicable to these proceedings, are as follows :-

Section 9

"(1) A trade mark (other than a certification trade mark) to be registrable in Part A of the register shall contain or consist of at least one of the following essential particulars -

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature (in other than Chinese characters) of the applicant for registration or of some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in

the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -
 - (a) the trade mark is inherently adapted to distinguish as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

Section 10

- "(1) A trade mark to be registrable in Part B of the register must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to the use within the extent of the registration.
- (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -
 - (a) a trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof."

48. As Mr Shipp said, referring to York TM (1984) RPC 231, a trader, as a matter of public policy, ought not to be allowed to obtain by registration under the Ordinance a monopoly in what other traders may legitimately desire to use.

49. The Classic statement of this doctrine is propounded by Lord Parker in the W & G Case (1913) AC 624 where he said that

the right to registration "should largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods".

50. The same reasoning applies whether considering the inherent adaptability of a mark under section 9 of the Ordinance or the inherent capability of a mark to distinguish under section 10.

51. As Lord Shaw said in the W & G case I have to "survey the possible confusions or difficulties which might arise in consequence of the grant of the trade mark, or the possible impairment of the rights of innocent traders to do that which, apart from the grant, would be their natural mode of conducting their business". As Lord Moulton suggested in the Perfection case (1910) 1 Ch 130 a suitable test is "Will the registration of the word as a trade mark cause substantial difficulty or confusion in view of the right of other traders to use the word as a description of their goods? If the answer is in the affirmative, registration should be refused. If it be in the negative, whether by reason of the nature of the word or because past user has limited the possibility of other traders safely or honestly using the word registration should be allowed."

52. As there is no evidence of any use of either suit mark and there are no circumstances calling for special consideration only the prima facie case falls to be considered.

53. Mr Shipp submitted that the Class 14 suit mark is inherently adapted to distinguish the Class 14 specified goods under section 9(1)(d) of the Ordinance. He argued JOY is a word having no direct reference to the character or quality of the goods and it is not, according to its ordinary signification, a geographical name or a surname. The Class 16 suit mark, Mr Shipp continued, is inherently capable of distinguishing the Class 16 specified goods under section 10.

54. Mr Shipp submitted JOY is not laudatory when applied either to the Class 14 specified goods or the Class 16 specified goods. Referring to Always TM (1986) RPC 93 Mr Shipp submitted JOY is different from such words as "always" and "perfection" and it would not be used in descriptive advertising slogans or laudatory puffs in relation either to the Class 14 or Class 16 specified goods. JOY, Mr Shipp continued, is a girl's name and a noun, used when describing pleasing events and occasions.

55. Mr Shipp said the Registrar correctly issued the leaves to advertise and the Applicant is entitled to rely on them and assume all relevant considerations were taken into account prior to their issue.

56. To Mr Shipp the Class 14 suit mark is registrable in Part A for the Class 14 specified goods and the Class 16 suit mark is registrable in Part B for the Class 16 specified goods.

57. Mr Yan, reminding me future as well as existing traders are to be taken into account, submitted the Class 14 suit mark is neither inherently adapted to distinguish nor inherently capable of distinguishing the Class 14 specified goods and the Class 16 suit mark is not inherently capable of distinguishing the Class 16 specified goods. He submitted the registrability issues relating to the Class 16 suit mark are to be considered without reference to BOUTIQUE, in view of the complete disclaimer of it.

58. Mr Yan said that in Health TM (1912) 29 RPC 440 "health" was held unregistrable for cocoa despite many years user on the basis the word is a laudatory or commendatory epithet for such goods. JOY, Mr Yan submitted, a mental state of well being, equates with health, a physical state of well being. Referring to Must TM (1976) RPC 712 Mr Yan submitted the present or future desire of other traders to use JOY in advertising and promoting their products is the relevant factor when considering the registrability issues. Mr Yan argued JOY is a laudatory and descriptive term emphasized in advertising to influence potential customers. JOY, he said, is often used, particularly at Christmas, by traders in advertising and otherwise in connection with jewellery, watches, greeting cards and magazines. Mr Yan recalled having seen John Keats' famous line "A thing of beauty is a JOY for ever" in an advertisement. Traders, Mr Yan continued, would reasonably wish to use such slogans as "a JOY to behold" and "a JOY to wear" in connection with their jewellery or watches and "a JOY to read" and "a JOY to the senses" in connection with their magazines. Mr. Yan produced by way of examples in support an advertisement in the South China Morning Post 1993 Christmas magazine for Swarovski silver crystal containing the words "dancing flames of JOY" and a copy of the 1993 New Year's eve dinner menu of the Pierrot Restaurant at the Mandarin Hotel showing JOY prominently used, on one occasion with an unidentified pocket watch, hands closing on twelve o'clock.

59. Mr Yan submitted the burden is on the Applicant to show the suit marks are registrable and if I am in doubt I must refuse registration. It would be wrong, Mr Yan said, to allow the Applicant to acquire a monopoly over JOY, a word meaning happiness, for its Class 14 or Class 16 specified goods. To Mr Yan the Applicant's indistinctive suit marks are not registrable in Part A or Part B.

60. The Class 14 suit mark is shown in paragraph 1 hereof. The Class 16 suit mark is shown in paragraph 2 hereof. The Japanese characters in the marks, which have no meaning, phonetically represent the English words in the marks. The Registrar has required the complete disclaimer of the word

BOUTIQUE and the Japanese characters phonetically representing it in the Class 16 suit mark.

61. As Mr Yan said the burden is on the Applicant to show the marks are registrable. I must look at the marks and all surrounding factors afresh. The issue of the leaves to advertise does not assist the Applicant in any way.

62. As Mr Shipp said traders cannot obtain a monopoly in the user of certain words (however distinctive), such as laudatory epithets or geographical names, to the detriment of members of the public who, in the future and in connection with other goods, might desire to use them.

63. As Mr Shipp did not object I admitted the advertisement and copy menu produced by Mr Yan into the proceedings for their probative value. JOY is not used in the advertisement to describe the advertised goods. JOY is not used descriptively on the menu or in connection with the watch. I cannot agree with Mr Yan that JOY for the Applicant's goods equates with "health" for cocoa. "Health" for any food or drink is unregistrable because it directly refers to the goods (health foods, health drinks). JOY does not directly refer to the character or quality of jewellery, watches or periodicals. The terms "JOY periodicals" and "watches of JOY" are not used. I consider Mr Yan's arguments and the slogans put forward in support of them (see paragraph 58 hereof) do not follow the reasoning in the ALWAYS TM and MUST TM cases. The slogans do not describe the goods, rather the feeling experienced by the observer, wearer, reader or viewer of them. All the slogans suggest human interaction. They describe a human reaction to the goods rather than the goods themselves. JOY indirectly refers to jewellery, watches and periodicals ("wearing this jewellery will bring JOY": "This periodical is a JOY to read".) The reference is illusory. I consider JOY, which is not a geographical name or a surname, has not been shown to have been used, is not used and is not likely to be used in a laudatory fashion or as a commendatory epithet when applied to jewellery, watches and periodicals. I consider registration of JOY for the Class 14 goods and periodicals would not cause substantial difficulty or confusion in view of the right of other traders to use JOY as a description of their goods in the nature of the Class 14 goods and periodicals. I consider other traders, now and future, are not likely, in the ordinary course of their business and without improper motive, to desire to use JOY or some word or mark nearly resembling it, upon or in connection with their own Class 14 goods or periodicals or goods similar thereto. I consider the rights of innocent traders to do what would be their natural mode of conducting their business will not be impaired by a registration of JOY for the Class 14 specified goods and periodicals.

64. As I have found JOY is inherently adapted to distinguish the Applicant's Class 14 specified goods there is no need to consider the Japanese characters appearing in the Class 14 suit mark or indeed the mark as a whole. As JOY is registrable for the Class 14 specified goods in Part A of the Register under section 9(1)(d) of the Ordinance so must the Class 14 suit mark be registrable thereunder for them too.

65. I have excluded printed matter from my deliberations and conclusions. Printed matter is matter that is printed by any of various mechanical processes (letterpress, lithography) and is eligible for mailing at a special rate by postal regulations, which specifically exclude matter produced by various other duplicating processes (carbon, copying-press). I understand the Post Office will treat cards (birthday cards, Christmas cards etc) as printed matter and consider they are eligible under postal regulations for mailing at a special rate. It follows cards (birthday cards, Christmas cards etc) fall within the term printed matter. A card is also a piece of paper or thin paperboard having any of a variety of shapes and formats and bearing a greeting or a message of sentiment, sympathy or congratulations. Though JOY does not strictly describe a card and such words as "greetings", "birthday" or "condolence" etc do not strictly describe a card, nevertheless the terms "greeting cards", "get well cards", "wedding cards", "Christmas cards", "birthday cards", "anniversary cards" and "condolence cards" are in such common use that, though not so now, future traders may legitimately wish to use the term "JOY cards" or "a card of JOY" to describe a particularly type of card, such as one announcing the birth of a baby. "A JOY card" could become a common term. For that reasons I consider the Applicant should not acquire monopoly rights in JOY when applied to cards (printed matter). I consider JOY is neither inherently adapted to distinguish nor inherently capable of distinguishing the Applicant's cards, included within the term printed matter in the Class 16 specification.

66. Therefore I must consider those parts of the Class 16 suit mark that remain after BOUTIQUE and the phonetically equivalent Japanese characters have been disclaimed. Those parts are JOY and the phonetically equivalent Japanese characters, which have no meaning. Effectively before me for consideration then is the Class 14 suit mark to be applied in relation to the Class 16 specified goods. I take the view other traders will not legitimately wish to use the combination mark, JOY and the phonetically equivalent Japanese characters, on or in connection with their cards (printed matter). Provided JOY and the phonetically equivalent Japanese characters in the Class 16 suit mark are separately disclaimed and BOUTIQUE and the phonetically equivalent Japanese characters are completely disclaimed I consider the Class 16 suit mark as a whole is inherently capable of distinguishing, though not inherently adapted to distinguish, the Applicant's Class 16 specified goods and is accordingly

registrable in Part B of the Register under section 10 of the Ordinance.

67. I move on to consider the oppositions under section 12(1) of the Ordinance, which is as follows :-

Section 12(1)

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design."

68. Whilst there are slight differences between section 12(1) of the Ordinance and section 11 of the United Kingdom Trade Marks Act 1938 (the likelihood of deception, which is wide enough to catch confusion, being an independent ground of objection under section 12(1)) decisions on section 11 of the 1938 Act are relevant to section 12(1) of the Ordinance and it can be considered on much the same basis as section 11 of the 1938 Act.

69. As Mr Shipp said, referring me to R Device TM (1993) HKDCLR 15, the accepted tests to be applied to consideration of cases under section 12(1) of the Ordinance are those propounded by Evershed J in Smith Hayden & Co's Application (1946) 63 RPC 97 at page 101. Adapted to the features of the suit case and with the recognized glosses they may be expressed as follows :-

"Having regard to the user of the Opponent's marks is the tribunal satisfied that each of the marks applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be likely to cause deception and confusion amongst a substantial number of persons? May a number of people be caused to wonder whether goods under the respective marks of the Applicant and Opponent come from the same source? Is there a real tangible danger of confusion if each of the applied for marks is put on the Register?"

70. The reference to "substantial" is a question to be judged in relation to the markets for the goods concerned. "Persons" are all those people likely to become purchasers of the goods upon which the respective marks are used.

71. I do not have a discretion under section 12(1) of the Ordinance. If the Opponent succeeds registration must be refused. If I am in doubt registration must be refused.

72. The relevant date for determining these proceedings is 31st March 1989, the date the Applicant applied for registration of the suit marks.

73. The onus is on the Applicant to defeat the oppositions. This is done by satisfying me there is no reasonable probability of confusion or deception, the test in different words being whether use of either suit mark by itself on the relevant specified goods in any manner which can be regarded as normal fair use of it will be calculated to deceive or cause confusion without necessarily leading to passing off. Either suit mark must offend if it is likely to cause deception or confusion in the minds of persons to whom it is addressed, even if actual purchasers will not ultimately be deceived. Likely purchasers must not be put into a state of doubt.

74. To bring section 12(1) of the Ordinance into operation an Opponent must have some reputation for its mark in Hong Kong derived from user in the widest sense and awareness of it here.

75. The actual extent of the reputation of the Opponent's mark and the range of goods for which it has been achieved are factors in determining whether there is sufficient likelihood of deception or confusion to warrant refusal of registration under section 12(1) of the Ordinance.

76. Section 12(1) of the Ordinance also extends to cases where an Opponent's mark has been used upon goods of a different description from or not closely related to those for which registration is sought if confusion may be likely due to the mark of an Opponent being particularly well-known or unusually inventive or the Applicant having closely copied a very distinctive mark. Section 12(1) further extends to cases where the confusion is not with an Opponent's mark but merely his name.

77. I must decide whether the public at large, purchasers or likely purchasers of the Applicant's and Opponent's goods bearing their respective marks, would infer they come from the same source or at least be caused to wonder whether that might not be so. Having regard to the reputation of the Opponent's marks in Hong Kong at the application date I must decide whether it would be likely that the public would be deceived or confused if one of those marks or a mark similar to one of them is used in relation to the Class 14 or Class 16 specified goods.

78. I will consider whether oppositions can be mounted under section 12(1) of the Ordinance.

79. Mr Shipp submitted the Opponent had not indicated the date in March 1989 when it commenced selling necklaces, brooches, bracelets or earrings. He continued that even if the Opponent began selling such goods at the beginning of the month it is unlikely it would have acquired a reputation for them prior to the application date at the end of the month. Mr Shipp said the only 1989 invoices relating to such goods are dated June, nearly three months after the application date. Mr Shipp said the evidence should be looked at with circumspection to decide

whether or not the Opponent had at the application date a sufficient reputation for its mark to enable it to pursue an opposition against the Class 14 application under section 12(1) of the Ordinance.

80. Mr Shipp had no comment on the reputation of the Opponent's mark in relation to its section 12(1) opposition against the Class 16 application.

81. Mr Yan submitted the Opponent need not show the reputation of its mark extends to Class 14 goods, though it does in fact extend to such goods by virtue of the Opponent having used JOYCE for many years prior to the application date in relation to its boutiques, which sell fashion items. Mr Yan continued that at the application date the Opponent had a substantial reputation in JOYCE in relation to fashion items, extending to fashion accessories in the nature of the Class 14 specified goods, which in any event the Opponent was selling only a few months after the application date.

82. Mr Yan submitted the evidence demonstrates JOYCE and JOYCE BOUTIQUE had a reputation at the application date in relation to the Opponent's magazines, goods within the Class 16 specified goods.

83. The evidence shows the Opponent's JOYCE mark had a reputation in Hong Kong at the application date for male and female clothing. The Opponent's clothing is sold in its shops known, in the singular, as a JOYCE BOUTIQUE. As Mr Shipp said there is no evidence of sales of necklaces, brooches, bracelets or earrings by the Opponent prior to the application date.

84. The evidence shows pre-application date sales of the Opponent's JOYCE fashion magazines.

85. I consider JOYCE and JOYCE BOUTIQUE had a reputation in Hong Kong at the 31st March 1989 application date sufficient to enable the Opponent to oppose both applications under section 12(1) of the Ordinance.

86. I move on to consider the similarity of the respective marks by comparing them. I must establish the reasonable probability of deception and confusion governed by the well established principles laid down by Parker J in Pianotist Co's Application (1906) 23 RPC 774. They are as follows :-

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal

way as a trade mark for the goods of the respective owners of the marks."

87. The resemblance between the marks must be considered with reference to the ear as well as to the eye. An ordinary person is expected to exercise normal care and intelligence but no more. His memory is imperfect. He remembers marks by general impression or some significant detail, rather than by photographic recollection of the whole. Too detailed an examination of the marks should not be made. The question of resemblance is one of first impression. They should not be compared side by side. Marks are compared as a whole, regard being had to the idea of each mark. Ultimately whether marks resemble each other or not is a question of fact, to be judged objectively.

88. Under section 12(1) of the Ordinance an Opponent's mark is to be considered as actually used. The Applicant's suit marks must be considered in notional fair use, which is any normal and fair use a registered proprietor may make of his mark in ordinary course of business in respect of goods covered by the registration.

89. Whether or not a mark so nearly resembles another as to be likely to deceive or cause confusion in course of trade is judged in part with regard to the simplicity or complexity of the marks under consideration. The likelihood of a mark being judged nearly to resemble another mark is greater where the Opponent's mark is a complex one, particularly if an invented word. Where an Opponent's mark is a simple word another mark must closely resemble it for there to be a likelihood of confusion and deception.

90. The Applicant's suit marks are shown in paragraphs 1 and 2. The Opponent uses its JOYCE mark in relation to its Class 14 fashion accessories and its magazine in unadorned, block capitals, much as shown herein. It also uses JOYCE BOUTIQUE in similar unadorned block capitals. On other occasions BOUTIQUES is dwarfed by JOYCE being squeezed between the "C" and "E". A representation of such use appears below :

J O Y C E
BOUTIQUES

91. Mr Shipp, referring to Bailey TM (1935) 52 RPC 136, said though JOY comprises the first three letters of JOYCE, the

marks must be compared as a whole, regard being had to the Japanese characters in the suit marks. Mr Shipp submitted the Applicant's suit marks and the Opponent's JOYCE and JOYCE BOUTIQUE marks are visually completely different. He said the Applicant's marks include Japanese characters of significant initial visual impact and BOUTIQUE appears before JOY in the Class 16 suit mark. Mr Shipp continued JOY and JOYCE sound completely different, it not being possible to slur the distinct ending of JOYCE, which will not be mispronounced. Mr Shipp submitted the ideas conveyed by the Applicant's suit marks and the Opponent's JOYCE and JOYCE BOUTIQUE marks are different. He said JOY is either a girl's name or a noun. He continued JOYCE is either a girl's name or a surname. Mr. Shipp submitted the principle of imperfect recollection should not be stressed, particularly in relation to the Class 16 application which is concerned with at least average sized goods. Mr Shipp submitted, citing Pianotist Co's Application, that as the Opponent's goods are directed at the upper and middle classes, expected to be of above average intelligence and to exercise a higher standard of care, any likelihood of confusion between the respective goods of the parties is further reduced.

92. To Mr Shipp likely purchasers coming upon the Class 14 suit marked specified goods or the Class 16 marked specified goods will not associate such goods with the Opponent or be caused to wonder whether or not such a connection may exist.

93. Mr Yan submitted JOY and JOYCE are very close visually and even closer phonetically. Both words, he said, are short words. Mr Yan submitted a person unfamiliar with JOYCE and hearing it could consider it a reference to JOYS or JOY'S. In any event, he continued, sloppy pronunciation could cause JOY and JOYCE to be confused. Mr Yan submitted the Applicant and the Opponent would apply their respective marks to the same goods, both in relation to the Class 14 application and the Class 16 application. Mr Yan submitted I must not only consider the middle and upper classes to whom the Opponent's products are currently directed. He said the Applicant's intended customers for its products had not been disclosed. They could, he continued, be the same as the Opponent's and/or they could be less educated. Mr Yan submitted less educated customers, whilst not being customers of the Opponent, may have heard of it through the media and may believe JOYCE is JOYS or JOY'S. Mr Yan saw the possibility of this scenario applying to a substantial part of the Hong Kong population. He said they would not be able to distinguish between JOY and JOYCE. Mr Yan submitted the meaningless Japanese characters in the suit marks are insignificant. He said only Japanese would understand them. Others, he continued, may assume them to be the Japanese transliterations of their English equivalents. Mr Yan submitted the presence of BOUTIQUE in the Class 16 suit mark enhances the likelihood of confusion. He said the Opponent, JOYCE BOUTIQUE Limited, has for a long time published its JOYCE magazine and it

is well recognized it is published by the Opponent which often uses the word BOUTIQUE with JOYCE. Mr Yan submitted the Applicant has not indicated how it intends to use the Class 16 suit mark. He said it could be used in the same way as the Opponent uses JOYCE in relation to its magazine. Alternatively, he continued, BOUTIQUE could be dwarfed by JOY, as it sometimes is when used with JOYCE. This, Mr Yan submitted, would increase the likelihood of confusion. Mr Yan said the juxtaposition of JOY and BOUTIQUE in the Class 16 suit mark does not assist the Applicant because JOY and BOUTIQUE would be recognized in the mark, as JOYCE and BOUTIQUE are recognized in the Opponent's mark.

94. To Mr Yan there would be a likelihood of confusion between the respective marks of the parties, particularly taking account of the principles of imperfect recollection, if registration of the Class 14 suit mark or the Class 16 suit mark is allowed.

95. Though the Japanese characters in the marks are of little significance to the Hong Kong public, which generally (those familiar with Japanese characters excluded) would not recognize them, the characters cannot be entirely ignored as the Applicant's and Opponent's marks are to be compared as a whole.

96. JOY is a three-letter word with a well recognized English meaning. JOY is a deep feeling or condition of happiness or contentment or something causing such a feeling. It is also a source of happiness or an outward show of pleasure, delight or rejoicing. JOY is also a female forename. JOYCE is a female forename of five letters. It is also a surname. The female forename JOY is not a derivative of or abbreviation for JOYCE.

97. JOY and JOYCE are monosyllabic. The "OY" ending of JOY is pronounced as in "BOY". The "OYCE" ending of JOYCE is pronounced as in "CHOICE". I agree with Mr Shipp the distinctive ending of JOYCE will not be slurred. Indeed there is a tendency to roll the sharp ending, prolonging the word. I cannot accept Mr Yan's submission that a reference to JOYCE may be interpreted as a reference to JOYS or JOY'S. Apart from the different emphasis between JOYCE and JOYS or JOY'S JOYCE is a commonly used, well known female forename which would not be confused with the possessive form of JOY, another well known female forename or the plural form of the noun.

98. BOUTIQUE is a well recognized English word. A BOUTIQUE is a shop, especially a small one selling fashionable clothes or other items. BOUTIQUE also denotes a small specialized producer or business. As marks are to be compared as a whole it is correct to consider the impact of BOUTIQUE and the Japanese phonetic equivalent in the Class 16 suit mark even though they are to be completely disclaimed as well as the impact of JOY and the Japanese phonetic equivalent which are to be separately

disclaimed. BOUTIQUE and its phonetically equivalent Japanese characters have a trade mark significance when determining whether the marks are confusing similar as do JOY and its phonetically equivalent Japanese characters. It is necessary to focus attention on the content of the Class 16 suit mark as a whole and not upon the content of the protection afforded it if registered. The impact of BOUTIQUE however is of little significance. BOUTIQUE has little impact whether used by the Applicant or the Opponent. It is an indistinctive, unregistrable word particularly when used in relation to fashion, including fashion periodicals. Fashion periodicals are within the Class 16 specified goods : hence the complete disclaimer. The little significance that attaches to BOUTIQUE is further reduced by the Opponent generally using JOYCE after BOUTIQUE and BOUTIQUE being placed before JOY in the Class 16 suit mark.

99. Because JOY conveys to the Hong Kong public a precise, memorable image, often associated with Christmas and other festive occasions and, because JOY and JOYCE are both well recognized different female forenames, I consider the principles of imperfect recollection do not come into play. Though size is not in itself a material factor when comparing marks I consider the necessary small application of JOY or JOYCE on certain items of jewellery (including watch faces) will not lead to deception or confusion for the same reasons.

100. I consider the visual identities of the Class 14 suit mark and the Class 16 suit mark are distinct and separate from the visual identities of the Opponent's JOYCE and JOYCE BOUTIQUE marks because of the different ideas conveyed by the respective marks due to JOY and JOYCE being well recognized different female forenames and JOY having in addition a well know English meaning. The separate visual identities are enhanced to a very small extent by the presence of the Japanese characters in the Applicant's marks.

101. I consider the phonetic identities of the Class 14 suit mark and the Class 16 suit mark are distinct and separate from the phonetic identities of the Opponent's JOYCE and JOYCE BOUTIQUE marks due to the different pronunciations of JOY and JOYCE, the recognition of them as different forenames and acknowledgement of the well recognized meaning of the English word, JOY.

102. At the application date the Opponent was not using JOYCE or JOYCE BOUTIQUE in relation to any goods included in the Class 14 specification. The Opponent's use of JOYCE in relation thereto did not commence until June 1989. The Opponent had not at the application date any reputation in JOYCE or JOYCE BOUTIQUE acquired by trading in goods in the nature of the Class 14 specified goods.

103. It is necessary to exercise caution before associating different sets of goods when considering an opposition under section 12(1) of the Ordinance. Generally if the goods of an Opponent are not the same or of the same description or closely associated with the specified goods there will be no likelihood of deception or confusion. The Opponent in these proceedings had a substantial pre-application date reputation for clothing for men and women directed at the affluent and fashion conscious (Exhibit AM-1). It operated fashion boutiques targeting that market. A few months after the application date the Opponent was selling necklaces, brooches, bracelets and earrings at its boutiques. The Opponent's particular reputation in Hong Kong at the application date entitles me to take the view the extension into fashion accessories in the nature of the Class 14 specified goods a few months later was likely to occur. I consider the Opponent's reputation at the application date fully protected its right, to extend, as it did, into jewellery and all goods in the nature of the Class 14 specified goods.

104. The Applicant's Class 14 specified goods could be directed at precisely the same affluent and fashion conscious customer targeted by the Opponent for its goods. The Applicant could alternatively or additionally direct its Class 14 specified goods at a less affluent, less fashion conscious market. The Opponent too is free at any time in the future to direct its goods at a less affluent, less fashion conscious market. The Applicant's Class 14 specified goods and similar goods of the Opponent could be purchased for the same purpose at the same prices by the same nature and kind of customer, exercising the same care and attention and being of similar intelligence. The Applicant's Class 14 specified goods and similar goods of the Opponent are effectively the same.

105. The Opponent uses and used at the application date JOYCE and JOYCE BOUTIQUE in relation to magazines. Periodicals, part of the Class 16 specified goods, are magazines.

106. The Opponent directs its magazines to the affluent and fashion conscious. The Applicant's Class 16 specified goods include fashion magazines which could be targeted at the rich and fashion conscious. The Applicant's Class 16 specified goods and the Opponent's fashion magazines could be purchased for the same purpose at the same prices by the same nature and kind of customer, exercising the same care and attention and being of similar intelligence. The Applicant's Class 16 specified goods and the Opponent's magazines are effectively the same goods.

107. However, because of the visual and phonetic differences between the Class 14 suit mark and the Class 16 suit mark and the Opponent's JOYCE and JOYCE BOUTIQUE marks (see paragraphs 100 and 101 hereof), I consider there is no likelihood of confusion or deception arising if each of the marks of the respective parties is used in a normal way as a trade mark for the goods of their

respective owners.

108. Under section 12(1) (Class 14 Application) Having regard to the user of the Opponent's marks I am satisfied that the Class 14 suit mark, if used in normal and fair manner in connection with any of the Class 14 specified goods, will not be likely to cause deception and confusion amongst a substantial number of persons. I consider a number of people may not be caused to wonder whether goods under the respective marks come from the same source. I consider there is no real tangible danger of confusion if the Class 14 suit mark is put on the Register for the Class 14 specified goods.

109. Under section 12(1) (Class 16 Application) Having regard to user of the Opponent's marks I am satisfied that the Class 16 suit mark, if used in a normal and fair manner in connection with any of the Class 16 specified goods, will not be likely to cause deception and confusion amongst a substantial number of persons. I consider a number of people may not be caused to wonder whether goods under the respective marks come from the same source. I consider there is no real tangible danger of confusion if the Class 16 suit mark is put on the Register for the Class 16 specified goods.

110. I find the Applicant has defeated the oppositions under section 12(1) of the Ordinance.

111. That being so the exercise of my discretion arises. This is a discretion under section 13(2) of the Ordinance to refuse registration to a mark which complies either with section 9 or section 10 that is not prohibited by section 12(1).

112. This discretion is of a judicial nature to be exercised on reasonable grounds with regard to all the circumstances of the case, my prime concern being for the public interest.

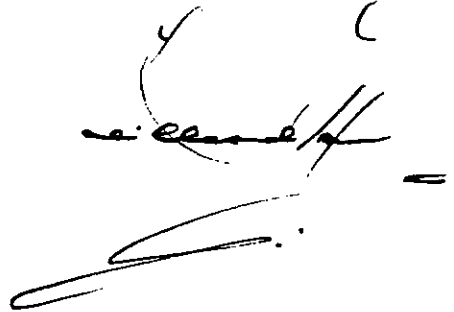
113. I see no cause to exercise my discretion in a manner adverse to the Applicant. I decline to do so.

114. I have found the Class 14 suit mark meets the requirements of section 9 of the Ordinance. I direct it is acceptable for registration in Part A of the Register in Class 14 in respect of the Class 14 specified goods. The mark is to be associated as indicated in the leave to advertise (see paragraph 4 hereof).

115. I have found the Class 16 suit mark only meets the requirements of section 10 of the Ordinance for the Class 16 specified goods on condition that, in addition to the exclusive disclaimer of the English word BOUTIQUE and the Japanese characters representing the same phonetically, the English word JOY and the Japanese characters representing the same phonetically are separately disclaimed. If the Applicant wishes

to proceed on that basis I direct the mark is acceptable for registration in Part B of the Register in Class 16 in respect of the Class 16 specified goods.

116. The Class 14 opposition failed. The Class 16 opposition succeeded to the extent the Opponent prevented the Applicant obtaining rights in JOY alone. The Applicant is entitled to the costs of the Class 14 opposition. I consider there is no entitlement to the costs of the Class 16 opposition. As the oppositions have been consolidated I award the Applicant costs but limit the amount to one half of the costs to which it would have been entitled if both oppositions had failed. Subject to any representations, as the amount of costs or calling for special treatment, which either party makes within one month from the date hereof, costs will be calculated with reference to the usual scale, set forth in Part I of the First Schedule to Order 62 of the Rules of the Supreme Court (Cap. 4) as applied to trade mark matters, unless otherwise agreed between the parties.



(M.W. Fox)
p. Registrar for Trade Marks
8th February 1994