

Application No. 5929/91

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

AND

IN THE MATTER of an application for
registration of the Trade Mark



in Class 5 in Part B of the Register by
Chau Wa Kuk trading as Singapore Kuk
Hung Medical Liquor Production
Company

AND

IN THE MATTER of an opposition
thereto by Haw Par Brothers
International Limited

DECISION
OF

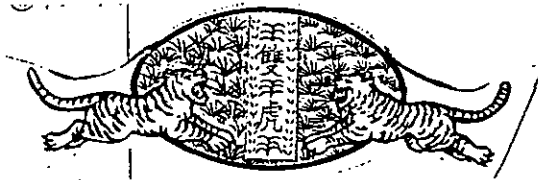
Mr. M.W. Fox acting for the Registrar of Trade Marks after a hearing on Tuesday,
6th February, 1996.

Appearing : Ms Chau Wa Kuk , trading as Singapore Kuk Hung Medical Liquor
Production Company, the Applicant.

Ms Winnie Tam, Counsel, instructed by Deacons Graham & James on
behalf of the Opponent, Haw Par Brothers International Limited.

Interpreter : Ms Ada Chan, Commissioner for Official Languages

1. On 14th August 1991 Chau Wa Kuk trading as Singapore Kuk Hung Medical Liquor Production Company (hereinafter called "the Applicant") of Chai Wan, Hong Kong applied under the Trade Marks Ordinance (hereinafter called "the Ordinance") for registration of a trade mark in, following a subsequent authorized amendment, Part B of the Register in Class 5 in respect, following a subsequent authorized amendment, of "medicated tiger penis wine" (hereinafter called "the specified goods"). A representation of the mark applied for, following a subsequent authorized amendment, appears below :-



2. The transliteration and translation of the Chinese characters in the mark are "Sheung Fu" meaning "DOUBLE TIGER".
3. Leave to advertise the suit mark in respect of the specified goods was given on 23rd July 1993. The suit mark was advertised in the Gazette on 13th August 1993.
4. The application was opposed by Haw Par Brothers International Limited (hereinafter called "the Opponent") of Singapore, which lodged its notice of opposition on 20th April 1994 on grounds, effectively, that :-
- (a) The Opponent is the registered proprietor of Hong Kong Class 5 marks being (i) **TIGER** and **LEAPING TIGER Device** (No. 1309/76); (ii) **LEAPING TIGER & Circle Device** (No. 1172/75) and (iii) **TIGER** and **LEAPING TIGER in Circle Device** (No. 1777/87)
 - (b) The Opponent has used its **TIGER** and **LEAPING TIGER Devices** in Hong Kong for many years for its Class 5 goods.
 - (c) As the suit mark closely resembles the Opponent's marks and the specified goods are similar to the Opponent's goods registration of the suit mark would contravene section 20 of the Ordinance.
 - (d) The suit mark so nearly resembles the Opponent's marks as to be likely to lead the trade and/or public into believing the specified goods are the Opponent's goods.

- (e) As the suit mark is not capable of distinguishing the Applicant's specified goods registration would contravene section 10 of the Ordinance.
- (f) As use of the suit mark in relation to the specified goods is prohibited under sections 4 and 6 of the Animals and Plants (Protection of Endangered Species) Ordinance and would be contrary to law and disentitled to protection in a court of justice registration would contravene section 12 of the Ordinance.
- (g) The Applicant is not the proprietor of the suit mark and cannot claim to be entitled to be registered as its proprietor under section 13(1) of the Ordinance.
- (h) Registration of the suit mark for the specified goods should be refused in exercise of the Registrar's discretion.

5. The Applicant by her counter-statement lodged on 23rd May 1994 relies, effectively, on the following grounds in support of her application :-

- (a) The Applicant is the owner of the suit mark.
- (b) Medicated tiger penis wine is made from a secret prescription handed down to the Applicant from her ancestors.
- (c) The Opponent must show medicated tiger penis wine is a tiger bone liquor.
- (d) As 雙虎 is different from the Opponent's 單虎 mark public confusion is not likely to arise.
- (e) The specified goods are not similar to the Opponent's goods.
- (f) The suit mark is different from the Opponent's 單虎 Device mark.
- (g) As the Applicant has not hunted tigers to make the specified goods she has not violated sections 4 and 6 of the Animals and Plants (Protection of Endangered Species) Ordinance.
- (h) The Applicant has used the suit mark in relation to the specified goods for many years.
- (i) The Opponent should produce its 雙虎 marked products.
- (j) The suit mark should be registered for the specified goods.

6. Evidence on behalf of the Opponent comes in declarations of Jenny Loh Yuh Yang, its company secretary, dated 12th January 1995 and 10th March 1995.

7. Ms Loh says Aw Boon Haw and Aw Boon Par trading as Eng Aun Tong started manufacturing and marketing **TIGER BALM** medicinal balm around 1900. She says Haw Par Brothers (Private) Ltd was incorporated in 1932 to take over the business, the Opponent being formed in 1969 to take over Haw Par Brothers (Private) Ltd.

8. Ms Loh says the **TIGER & Device** mark was first used on medicinal balms and oils around 1900. She says **TIGER & TIGER Device** marked products were probably first exported to Hong Kong in the early 1900s. Ms Loh says medicinal balms and oils have been sold under various **TIGER** word and device marks which are now associated with the Opponent. She says "Haw" in Chinese means "tiger". Ms Loh exhibits (A) a historical booklet entitled "Legend from a Jar - The Story of Haw Par" and the Opponent's 1993 Annual Report. She says the Opponent's **LEAPING TIGER Device** mark is shown on the inner cover and pages 16 and 34 of the booklet and on the front cover and pages 12 and 15 of the Annual Report. Ms Loh contends the exhibit illustrates the Opponent's substantial size and worldwide reputation.

9. Ms Loh says by 1940 the Opponent's **TIGER** products were being sold on a substantial scale throughout Asia and in Asian communities elsewhere, including the United States and the United Kingdom. She says Hong Kong is one of the Opponent's major sales areas. Ms Loh exhibits (B) a list of countries where the Opponent's **TIGER & TIGER Device** marked products are sold.

10. Ms Loh exhibits (C) copy invoices showing sales of the Opponent's **TIGER & TIGER Device** marked products.

11. Ms Loh says early sales figures of the Opponent's **TIGER** products in Hong Kong are not available. She says the Opponent cannot provide pre-1988 sales figures as it is not on friendly terms with its previous distributor, the Jack Chia Group of Companies.

12. Ms Loh gives annual retail sales figures for the years 1988 to 1992 inclusive showing sales in the first three years totalling approximately HK\$115 million.

13. Ms Loh says the Opponent has advertised its goods in newspapers and trade journals including the Grocery Trade Magazine and The Buying Guide. She says the Opponent's previous distributor was responsible for advertising the Opponent's products in Hong Kong and because of a dispute with that distributor the Opponent cannot ascertain the amount spent on promotional activity. Ms Loh believes prior to 1990 approximately HK\$100,000 was spent annually on promoting the Opponent's goods. She

says approximately HK\$803,000 and HK\$5.5 million was spent in 1992 and 1993 respectively in advertising and promotion worldwide including Hong Kong. Ms Loh exhibits (D) press advertisements.

14. Ms Loh submits the Opponent's well known **TIGER** products are household names throughout Asia, including Hong Kong and Singapore. She says the Haw Par Villa in Singapore is commonly known as the **TIGER BALM** Gardens and the **TIGER BALM** Gardens in Hong Kong are open to the public.

15. Ms Loh exhibits (E) a list of countries where the Opponent's **TIGER** trade marks are registered worldwide for medicinal preparations and similar goods.

16. Ms Loh exhibits (F) copies of the Opponent's Hong Kong Class 5 registrations. She says Haw Par Brothers International (H.K.) Ltd, the Opponent's wholly owned subsidiary, has registered or applied to register **TIGER** marks in other classes.

17. Ms Loh says the Opponent's **TIGER & TIGER Device** marked products have been extensively promoted in many countries. She exhibits (G) copy advertisements in Australia, Germany, Gibraltar, Hong Kong, Italy, Norway, Singapore, Sweden and Switzerland.

18. Ms Loh contends the Opponent has prior registered rights in **TIGER** or **TIGERS** Devices, particularly **LEAPING** or **JUMPING TIGER** or **TIGERS** Devices, the English word **TIGER** and the Chinese character 虎 . She says the use of a circular device is a recurring element in the Opponent's trade marks. Ms Loh contends the character 雙 , meaning "double", in the suit mark is insufficient to distinguish the suit mark from the Opponent's registered trade marks, which include **DOUBLE LION** in English and the equivalent Chinese characters and the device of a **DOUBLE LION**. She submits the concept of the suit mark is confusingly similar to the Opponent's **DOUBLE LION** marks in view of the shared characteristics of lions and tigers. Ms Loh exhibits (H) copies of **DOUBLE LION** marks registered in the name of Haw Par Brothers International (H.K.) Ltd.

19. Ms Loh says a Hong Kong trade mark search showed no other Class 5 registered trade marks or applications for registration with the device of the whole body of a tiger in profile apart from the suit application and another application by the Applicant under No. 9552/94. She contends consumers seeing the suit mark will presume it belongs to the Opponent which has a registered monopoly in such devices.

20. Ms Loh submits that if the specified goods are not obtained from tigers the suit mark is deceptive when used in relation to them. She continues that if the specified goods contain tiger ingredients the Applicant is dealing in unlawful products under the Animals and Plants (Protection of Endangered Species) Ordinance.

21. The Applicant's Evidence comes in her declaration dated 20th June 1995.
22. The Applicant says she uses the suit mark on medical liquor she manufactures, which can be taken orally and used externally.
23. The Applicant says she designed the suit mark.
24. The Applicant considers the **TWO TIGER Device** suit mark is different from the Opponent's **SINGLE TIGER Device** mark.
25. The Applicant considers the specified goods are totally different from the Opponent's **TIGER BALM** ointment, which is used externally.
26. The Applicant says she makes the specified goods because she wishes to help other people.
27. The opposition is based on section 12(1) of the Ordinance. The Opponent is also relying on section 20, if necessary.
28. Section 12(1) of the Ordinance 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."

29. 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.
30. 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 :-

Under section 12(1) "Having regard to the reputation of the Opponent's marks is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with the goods covered by the registration proposed, will not

be likely to cause deception or confusion amongst a substantial number of persons? May a number of people be caused to wonder whether goods under the respective marks come from the same source? Is there a real tangible danger of confusion if the applied for mark is put on the Register?"

31. 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.

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

33. The onus is on the Applicant to defeat the opposition. This is done by satisfying me there is no reasonable probability of deception or confusion, the test, in different words, being whether use of the suit mark by itself on the 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. The suit mark must offend if its use in relation to the specified goods 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. Purchasers must not be put into a state of doubt.

34. 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 or awareness of it here.

35. The actual extent of the reputation of an 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.

36. 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 an invented mark of an opponent being particularly well known or an applicant having closely copied an extremely distinctive mark.

37. I must decide whether the public at large, purchasers or likely purchasers of the Applicant's and the 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 those marks is

used in relation to the specified goods.

38. Registration of the suit mark for the specified goods would also be unlawful if the suit mark comprises or contains matter the use of which would be contrary to provisions of the Animals and Plants (Protection of Endangered Species) Ordinance (Cap 187).

39. The relevant date for determining these proceedings is 14th August 1991, the date the Applicant applied for registration of the suit mark for the specified goods.

40. I will consider whether an opposition can be mounted under section 12(1) of the Ordinance.

41. The Applicant acknowledged the Opponent has been making its **TIGER** marked products for a long time. She said she has known of the Opponent's goods for many years.

42. Ms Tam said the Opponent's evidence shows the Opponent's **TIGER** mark has been used worldwide, including Hong Kong, for almost one hundred years. She said exhibit (D) to Ms Loh's first declaration comprises advertisements showing actual use of the Opponent's **TIGER** mark in Hong Kong. Ms Tam said advertisements showing use of the Opponent's **TIGER** mark internationally appear in exhibit (G). Ms Tam submitted the Opponent's famous **TIGER** mark is now a household name. To Ms Tam the Opponent can rely on pre-application date use of its **TIGER** mark in Hong Kong to oppose under section 12(1) of the Ordinance.

43. Exhibits (A) and (C) to Ms Loh's first declaration establish the Opponent's **TIGER** balm and **TIGER** oil products were sold in Hong Kong prior to the application date. The Opponent can mount an opposition under section 12(1) of the Ordinance.

44. I will consider the similarity of the respective marks by comparing them. I must establish the reasonable probability of deception and confusion. I am governed, in so far as they apply to device marks, 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."

45. 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 be of average intelligence but no more. His memory is imperfect. Too detailed an examination of the marks should not be made. The question of resemblance is one of first impression. Marks should not be compared side by side. Marks are compared each 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.

46. Marks are recalled by the ideas they convey rather than their precise details. A likely purchaser can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy. Allowance must be made for this in estimating the probability of deception. The question is not whether if a person is looking at two trade marks side-by-side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection.

47. Under section 12(1) of the Ordinance the Opponent's marks are considered as actually used and the Applicant's suit mark is considered in notional fair use.

48. Notional fair use 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.

49. The Applicant submitted the ideas of both parties' marks are different.

50. The Applicant argued the details of the **TIGER Device** in her suit mark and the Opponent's **TIGER Device** are different. She contended these differences will be recognized by the public. The Applicant observed her tigers have claws. She said the Opponent's tiger does not have claws. The Applicant said the paws of her tigers are in the same position. She pointed out the Opponent's tiger has one paw in front of the other. The Applicant said the stripes on her tigers' tails are much clearer than the stripes on the smaller and more curled tail of the Opponent's tiger. She said her tigers are projected against a contrasting background unlike the Opponent's tiger, which appears against a uniform background.

51. The Applicant argued the nature of her medicated wine is different from the nature of the Opponent's medicated ointments. She observed the Opponent's **TIGER** balm and **TIGER** oil products cannot be taken orally. The Applicant said her medicated wine can be taken orally. She said the manufacturing process of each party's products is different. She said the Opponent does not know how to make her medicated wine. The Applicant said her medicated wine and the Opponent's medicated ointment are used for

different purposes. She said the effects of medicated **TIGER** penis-wine are different from the effects of the Opponent's medicated ointment. The Applicant said medication is applied in different ways by different people. She argued the Opponent does not have a monopoly over products used to treat muscle pains. The Applicant contended the public does not buy wine if it is looking for ointment. She submitted the public is clear about the type of product it wishes to buy. The Applicant argued the public will not confuse the respective goods of the parties.

52. The Applicant said she chose a **DOUBLE TIGER Device** for her medicated wine because she wished to avoid a resemblance with the Opponent's **TIGER Device**. She said she had not copied Opponent's **TIGER Device**. The Applicant said she does intend to use the suit mark on medicated ointment.

53. The Applicant considered her use of the suit mark on medicated wine will not cause deception or confusion. She concluded her suit mark is registrable for the specified goods.

54. Ms Tam submitted, citing **Hariber Lotion TM (Decision dated 14th February 1975)**, the ideas of the parties' marks are identical even though the suit mark contains two tigers. She said the leading characteristic of both parties' marks are **LEAPING TIGERS**.

55. Ms Tam said the suit mark consists of the profile of two tigers leaping against each other with the Chinese characters 雙虎 (meaning "double tiger") placed vertically between them. She submitted the Applicant repeats the Opponent's famous **LEAPING TIGER Device** to form her **DOUBLE TIGER Device** mark. Ms Tam said the form of representation of the Opponent's **LEAPING TIGER Device** is unique. She argued I must have regard to the respective postures and representations of the **TIGER Devices** in the parties' marks. Ms Tam said the marks of the parties resemble each other because not only is the general appearance of each tiger very similar but each tiger is represented in the same particular profile. She submitted the public, well acquainted with the Opponent's famous **LEAPING TIGER Device**, will consider the variations in detail in the Applicant's suit mark to have been made by the Opponent. Ms Tam submitted the marks of both parties will be perceived as **LEAPING TIGER Devices** by the public, who will have imperfect recall of the details of the Applicant's suit mark.

56. Ms Tam said the Hong Kong Register does not contain any **LEAPING TIGER Device**, the same as or similar to the Opponent's well know **LEAPING TIGER Device**, in the name of any party other than the Opponent or its associates.

57. Ms Tam said the Applicant's tiger penis wine is medicated. She said the Applicant's evidence shows medicated tiger penis wine, a product in liquid form, can be

applied externally to relieve muscle pains, as well as being taken orally. Ms Tam said the Opponent's goods are medicinal oils or ointments used for the same purpose, to relieve muscle pains. She considered the natures and uses of the Applicant's medicated **TIGER** penis wine and the Opponent's medicinal oils and ointments are the same, even though the precise ailments to be treated by the application of the parties' respective goods may be different. Ms Tam submitted the trade channels through which the parties' products are sold and purchased are the same. She said the Applicant has not provided evidence to the contrary.

58. Ms Tam submitted a stricter test of the likelihood of deception or confusion is to be applied as the products of the parties are medicinal. She said I should require a higher degree of assurance that there is no likelihood of confusion, in view of the potentially serious consequences of confusion.

59. To Ms Tam use of the suit mark in relation to the specified goods would cause deception or confusion. She concluded registration of the suit mark for the specified goods should be refused.

60. The suit mark is shown in paragraph 1.

61. The Applicant has not provided evidence showing use of the suit mark in relation to the specified goods. At the hearing she said she had not used the suit mark for her medicated tiger penis wine.

62. The evidence shows the Opponent uses its **TIGER Device** mark in different ways. The single **LEAPING TIGER Device** appearing in the Opponent's registered marks Nos. 1172/75, 1309/76 and 1777/87 is shown in exhibits (A), (D) and (G). A composite mark featuring many **LEAPING TIGER Devices** appears on page 16 of the booklet in exhibit (A). Two **LEAPING TIGER Devices** appear in a photograph of the Opponent's **TIGER** balm in exhibit (D). Three **LEAPING TIGER Devices** appear in The Chinese Daily News, 10th August 1981 issue, advertisement for the Opponent's **TIGER** product in exhibit (G). The **LEAPING TIGER Device** used by the Opponent hardly varies at all (the marginal change to the tail being the most significant alteration); whether appearing as a **SINGLE TIGER Device**, a **DOUBLE TIGER Device**, a **TRIPLE TIGER Device** or a **MULTI TIGER Device**. A representation of the Opponent's **SINGLE LEAPING TIGER Device** as actually used and as registered in the Opponent's mark No. 1309/76 appears below :-



63. Under section 12(1) of the Ordinance the cumulative effect of the Opponent's marks in actual use is considered.

64. Where the Opponent's marks have a common feature I must consider, having regard to the distinctiveness of that common feature, whether it is likely the public may believe the suit mark, dependent on the nature of the shared common feature, belongs to the same series as the Opponent's marks, suggesting goods marked with the suit mark come from the same source as the Opponent's goods.

65. As Ms Tam said, referring to Kerly's Law of Trade Marks and Trade Names, twelfth edition, Chapter 17, paragraph 8 :-

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.

When the question arises whether a mark applied for bears such resemblance to another mark as to be likely to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different. On the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

66. The suit mark conveys the idea of two tigers. The Chinese ideograms and the images complement each other. The two tigers in the suit mark are slightly imperfect mirror images of each other. Both can be described as leaping tigers. That is the impression they create. The shaded oval background is not a significant feature of the Applicant's mark. The repeated symbols in the mark that have no meaning, that appear above, between and below the ideograms for "double" and "tiger", are not significant

features of the Applicant's mark. The two tigers are the dominant, essential feature of the mark. The Chinese ideograms, small in size in relation to the tigers and muted in representation, form part of and are almost lost in the ornate, patterned background, against which the leaping tigers are partially set.

67. The Opponent's marks, dependent on the actual use, give the impression of one or more tigers or leaping tigers, the essential feature of all the Opponent's marks. The Opponent's tigers always leap from right to left.

68. The similarity between the right to left **TIGER Devices** of both parties' marks is particularly outstanding on first impression. They are essentially identical. Even the resemblance between the Applicant's left to right tiger and the Opponent's tiger is striking, the left to right tiger being but a mirror image, albeit a slightly flawed one, of the other. On close examination some minor, inconsequential differences between the parties' respective tigers become apparent. Taking account of the cumulative effect of the Opponent's **TIGER Device** marks in actual use, the respective marks of the parties are visually similar.

69. Orally, the suit mark will be referred to as a **TWO TIGER** or **DOUBLE TIGER Device** or possibly a device of **TWO LEAPING TIGERS**.

70. Orally the Opponent's marks will be referred to variously as a **TIGER Device**, a **LEAPING TIGER Device** or **Devices with TIGERS** or **LEAPING TIGERS**. The mark in exhibit (D) (see paragraph 62) may be referred to as a **TWO TIGER** or **DOUBLE TIGER Device** or a device of **TWO LEAPING TIGERS**.

71. The Applicant's suit mark and at least one of the Opponent's marks may be referred to orally in the same way.

72. Wine is an alcoholic drink produced by fermenting fruits, flowers etc with water and sugar or anything resembling wine in its intoxicating or invigorating effect. Wine, in western pharmacological usage, is a fermented grape juice containing medicaments.

73. The Applicant has given evidence that her medicated **TIGER** penis wine is a medical liquor that can be taken orally or applied externally. It is used to relieve pain, treat ailments or generally improve health.

74. The Opponent's goods are medicated balms and oils. Balms are oily, aromatic resins or other substances. The Opponent's balms and oils are used for healing and soothing.

75. The nature of both parties' products, having particular regard to the external

application of the Applicant's medicated wine, is very similar. The uses of the parties' goods, having particular regard to the external application of the Applicant's medicated wine, are essentially the same, though the specific ailments to be treated may be different. As both parties' products have medicinal properties and remedial uses they are likely to be sold and purchased through the same or similar trade channels, such as chemists, dispensaries, pharmacies, druggists etc, at the same or similar prices.

76. Likely purchasers of both parties' goods will seek them for their healing, soothing or remedial properties, A likely purchaser of the Applicant's medicated wine for external use may buy it to treat the same muscle pain that he could treat with the Opponent's balms and oils. The nature and kind of customer likely to buy the parties' goods are essentially the same, being generally of average intelligence and exercising normal care and attention.

77. Having regard to the distinctiveness of the common feature of the Opponent's **TIGER Device** marks I consider it is likely the public may believe the suit mark belongs to the same series as the Opponent's **TIGER Device** marks, suggesting goods marked with the suit mark come from the same source as the Opponent's goods.

78. I conclude there is a likelihood of deception or confusion arising if each of the trade marks of the parties is used in a normal way as a trade mark for the goods of the respective owners of the marks.

79. Having reached this conclusion I need not consider the other limb of the opposition under section 12(1) of the Ordinance (see paragraph 38)

80. Under section 12(1) Having regard to the reputation of the Opponent's marks I am not satisfied that the suit mark, if used in a normal and fair manner in connection with the specified goods, will not be likely to cause deception or confusion amongst a substantial number of persons. I consider a number of persons may be caused to wonder whether goods under the respective marks come from the same source. I consider there is a real tangible risk of confusion if the suit mark is put on the Register for the specified goods.

81. I find the Applicant has not defeated the opposition under section 12(1) of the Ordinance.

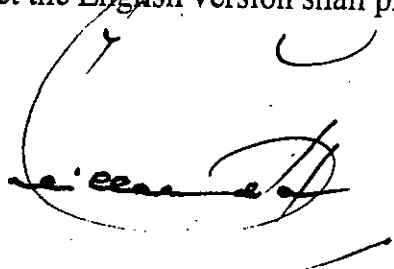
82. That being so, there is no need for me to consider the opposition under section 20 of the Ordinance.

83. As the Opponent has succeeded the exercise of my discretion under section 13(2) of the Ordinance does not arise.

84. The application to register the suit mark in Part B of the Register in Class 5 in respect of the specified goods fails.

85. I award the Opponent costs. Subject to any representations, as to 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.

86. This decision is written in English and issued with a Chinese translation, which I have not authenticated. In case of conflict the English version shall prevail.



(M.W. Fox)

p. Registrar of Trade Marks

30th April 1996