

**TRADE MARKS ORDINANCE (CAP. 559)**

**APPLICATION FOR REVOCATION OF TRADE MARK NO. 1999B01692**

**MARK :**

百美

**CLASS :**

17

**APPLICANT :**

**BEMIS ASSOCIATES, INC.**

**REGISTERED OWNER :**

**HOPEWELL PLASTIC LAMINATES LIMITED**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 15 December 2011 (“Revocation Application Date”), Bemis Associates, Inc. (“Applicant”) made an application under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) to revoke the registration of the following mark (“subject mark”) on the ground of non-use:

百美

2. The subject mark is registered as of 21 August 1997 in the name of Hopewell Plastic Laminates Limited (“Registered Owner”) in respect of “plastic decorative laminated sheets; all included in Class 17” (“subject goods”). The actual date of registration of the subject mark is 9 February 1999.

3. The Registered Owner filed its Counter-Statement on 14 June 2012.

4. The Application for Revocation was heard on 19 December 2013. Mr. Jesse H.Y. Kwok of Jesse H.Y. Kwok & Co. represented the Registered Owner at the hearing. Mr. Philips B. F. Wong, counsel instructed by Baker & McKenzie, represented the Applicant.

5. I reserved my decision at the conclusion of the hearing.

### **Evidence**

6. The Applicant's evidence consists of a statutory declaration of Chan Kwon Wah, manager of Kennoway Investigations Limited, together with exhibits, which was declared on 13 December 2011 ("Chan's statutory declaration").

7. The Registered Owner filed a statutory declaration of Wong Kei Tak Ben, sales manager of the Registered Owner, together with exhibits, which was declared on 11 June 2012 ("Wong's statutory declaration").

### **Grounds for revocation**

8. The Applicant contends that the subject mark has not been genuinely used by the Registered Owner or by a third party with its consent in relation to the subject goods for a continuous period of at least three years, and there are no valid reasons for such non-use. The Applicant seeks revocation of the subject mark with effect from 3 October 2008 pursuant to section 52(2)(a) of the Ordinance.

9. Section 52 of the Ordinance provides, *inter alia*, as follows:

"...

(2) *The registration of a trade mark may be revoked on any of the following grounds, namely-*

(a) *that the trade mark has not been genuinely used in Hong Kong*

*by the owner or with his consent, in relation to the goods or services for which it is registered, for a continuous period of at least 3 years, and there are no valid reasons for non-use (such as import restrictions on, or other governmental requirements for, goods or services protected by the trade mark);*

(3) *For the purposes of subsection (2)-*

*(a) use of a trade mark includes use in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered; ...*

(4) *Subject to subsection (5), the registration of a trade mark shall not be revoked on the ground mentioned in subsection (2)(a) if the use described in that subsection is commenced or resumed after the expiry of the 3-year period and before the application for revocation is made.*

(5) *Any commencement or resumption of the use described in subsection (2)(a) after the expiry of the 3-year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the owner of the registered trade mark became aware that the application might be made.*

*...”*

10. As the Applicant seeks revocation of the subject mark with effect from 3 October 2008, it is necessary to consider whether the subject mark has been genuinely used in Hong Kong by the Registered Owner or with its consent in relation to the subject goods during the 3-year period beginning on 3 October 2005. At the hearing, Mr. Wong defined this 3-year period between 3 October 2005 and 2 October 2008 as the “1<sup>st</sup> Relevant Period”. Paragraph 3 of the Statement of Grounds<sup>1</sup> also refers to the Applicant’s case that the subject mark has not been put to genuine use for a continuous

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<sup>1</sup> The Statement of Grounds is attached to the Application for Revocation filed on 15 December 2011.

period of more than 3 years prior to the filing of the Application for Revocation. Mr. Wong defined this three-year period between 15 December 2008 and 14 December 2011 as the “2<sup>nd</sup> Relevant Period”.<sup>2</sup> In paragraph 2 of the Counter-Statement of Oppositions<sup>3</sup>, the Registered Owner avers that the subject mark has been used at all material times, and the subject mark has been used for the last 3 years prior to the filing of the Application for Revocation (i.e. the 2<sup>nd</sup> Relevant Period).

11. According to section 52(4) of the Ordinance, genuine use of the subject mark after the expiry of the 3-year period ending on 2 October 2008 (viz. the 1<sup>st</sup> Relevant Period) but before the Revocation Application Date, i.e. during the period from 3 October 2008 to 14 December 2011 (“Subsequent Period”) may, subject to the provisions of section 52(5), save the subject mark from being revoked. Thus, I would also consider whether there is genuine use of the subject mark in respect of the subject goods in Hong Kong during the Subsequent Period.

### **Burden of proving use**

12. Section 82(1) of the Ordinance provides that:

*“If, in any civil proceedings under this Ordinance in which the owner of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with the owner.”*

13. Accordingly, the burden of proving genuine use of the subject mark in Hong Kong in relation to the subject goods during the 1<sup>st</sup> Relevant Period and the Subsequent Period lies with the Registered Owner.

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<sup>2</sup> The whole 2<sup>nd</sup> Relevant Period falls within the Subsequent Period as discussed in paragraph 11.

<sup>3</sup> The Counter-Statement of Oppositions is attached to the Counter-Statement filed on 14 June 2012.

## Genuine use

14. What constitutes genuine use has been considered in a number of cases including *Ansul BV v Ajax Bradbeveiliging BV* [2005] Ch 97, *La Mer Technology Inc v Laboratoires Goemar SA* [2004] F.S.R. 38, *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5 and *Brands Inc Ltd v Kabushiki Kaisha Regal Corp* [2006] HKEC 2313 (HCMP 754/2006). The relevant principles are not in dispute. They include :

- Genuine use does not include token use for the sole purpose of preserving the rights conferred by that mark (*La Mer*, paragraph 27).
- It entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned (*Ansul*, paragraph 37).
- Use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37).
- When assessing whether use of a trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*La Mer*, paragraph 27).
- Even if use of a mark is not quantitatively significant, it may be sufficient to qualify as genuine use if it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark (*La Mer*, paragraph 21).
- What matters are the objective circumstances of each case, and not the owner's commercial intention, purpose or motivation (*Laboratoire*, paragraph 34).

- There is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire*, paragraph 32).
- What is essential (other than where section 52(3)(b) of Cap. 559 is applicable) is that the mark should have been used by being exposed to third parties (other than the owner or his licensees or agents) on *a market in Hong Kong* for goods or services of a type in respect of which the mark was registered. The need for exposure on such a market follows from the fact that to be used as a trade mark, the mark must be used in such a way as to act as a badge of origin, or a guarantee of the source or origin of the relevant goods or services (*Brands*, paragraph 18).

## **Evidence**

### *Chan's statutory declaration*

15. Mr. Chan is the manager of Kennoway Investigations Limited, a limited liability company incorporated in Hong Kong which carries on the business as specialists in investigations concerning the protection of intellectual property rights.

16. Mr. Chan conducted a search at the local trade database of the Hong Kong Trade Development Council which revealed that a company known as "Hopewell Plastics Ltd." ("HPL") had the same office address, contact person, telephone number and fax number as the Registered Owner. A company search with the Companies Registry also revealed that the two shared the same registered office and had the same shareholders. Copies of the relevant records are produced as Exhibit "CKW-1".

17. Mr. Chan produced Exhibit "CKW-2" which contained some coloured printouts from [www.hopewellplastics.com](http://www.hopewellplastics.com), the website of HPL. Mr. Chan found the wording "百美® 耐磨高密度地板" in the Chinese version of the website in relation to wooden flooring, but not in relation to the subject goods.

18. On 3 October 2011, Mr. Chan met Mr. Ben Wong, sales manager of HPL, at the address of HPL in Kwai Chung. The address is also the office and registered address of the Registered Owner. Exhibit “CKW-3” are copies of Mr. Ben Wong’s business card and two coloured photographs of the wooden flooring samples at HPL’s premises. The photographs showed the display of the following mark on the stand holding some flooring samples and the mark attached to one corner of each of the samples :



(“Mark A”)

19. In paragraph 6 of his statutory declaration, Mr. Chan recapped Mr. Ben Wong’s account that flooring marketed under the mark had been launched into the Hong Kong market for over 20 years, and the mark was only used on flooring which was made from high density wood surfaced with high pressure decorative laminate. He



also provided a product catalogue bearing the sign at the cover (a copy of the catalogue is produced at Exhibit “CKW-4”).

20. On 24 November 2011, Mr. Ben Wong was contacted by phone for the purchase of three items, namely DPM film, foam underlay and fibre panel underlay which were shown in the catalogue. Mr. Ben Wong explained that these three items had run out for years, HPL would not be importing any more of these items in future, and as far as he was aware, none of them were available in the retail market of Hong Kong.

#### *Wong’s statutory declaration*

21. Mr. Ben Wong averred that he had been working for the Registered Owner for 12 years. He confirmed that HPL and the Registered Owner were associated companies which came under the same shareholders and management.

22. He also confirmed that he met a Mr. Chan in October 2011 at the godown in Kwai Chung, and Mr. Chan specifically asked for information on products under the 百美 mark. Despite some doubts as to whether Mr. Chan was a genuine customer, in order to maintain the good image of the company, he still attended Mr. Chan and took him to the showroom.

23. Mr. Ben Wong deposed that the Registered Owner did use and continue to use the subject mark. He produced a list of inventory of sale of 百美 products sold between 2009 and 2012 in order to show that the Registered Owner had genuinely used the subject mark (Exhibit “WKT-1”). He also averred that “*We have a large quantity of stocks in our godown which is over 80,000 square feet. There is now exhibited and marked “WKT-2” for Photos showing the stock of Products of Trade Mark, 百美, in our Kwai Chung godown.*”. Exhibit “WKT-2” comprises copies of six coloured photographs showing stacks of flooring. From four of the photographs, Mark A can be found on the packaging of the flooring.

24. As to the intended purchase of three items of products referred to in Chan’s statutory declaration, Mr. Ben Wong averred that these accessory items were not products under the subject mark. As he did not want to deal with this unidentified customer, he just told Mr. Chan on phone that the products ran out of stock.

25. Mr. Ben Wong stated that the Registered Owner did use the 百美 mark at all material times and up to the date of the statutory declaration. It paid advertisement fees in the sum of HK\$70,000 a year. Exhibits “WKT-3” to “WKT-7” are copies of advertisements posted in Hong Kong Source Book 2011-2012, Hong Kong Builders Directory 2010/42nd Edition Vol. 1.1 and Design Architecture 2010-2011 Volume 2.<sup>4</sup>

The mark shown in the printed advertisement is in the form of (“Mark B”).



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<sup>4</sup> The extracts themselves do not bear a date. From an inspection of the original full volume of the publications provided by Mr. Kwok at the hearing, I am able to confirm that the extracts were copied from those publications. The publications related to the years as shown in their titles.

## Decision

26. There is no dispute that the Registered Owner bears the onus of proof to prove use of the subject mark in the present proceedings. At the hearing, Mr. Wong drew my attention to the principle that a mere assertion of use by the trade mark owner without corroborative evidence is not sufficient (see page 7 of decision of the UK Trade Marks Registry in *ACADEMY Trade Mark*, 27 November 1998). Further, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see *Kabushiki Kaisha Fernandes v. OHIM* (Case T-39/01) [2003] E.T.M.R. 98, paragraph 47). The party concerned with proof of use should read the proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the t’s should be crossed and all the i’s dotted (*Laboratoire de la Mer Trade Marks* [2002] F.S.R. 790, paragraph 9). There is no dispute that these are the relevant principles which I should bear in mind.

27. At the hearing, Mr. Kwok referred to the exhibits produced in Wong’s statutory declaration and submitted that they, being evidence of sales, stock and advertisements, demonstrated genuine use of the subject mark in the 3-year period prior to the Revocation Application Date. It follows that the Registered Owner does not rely on any valid reason for non-use to resist the Application for Revocation. Mr. Kwok also referred to paragraph 4 of Wong’s statutory declaration to make good the point that the Registered Owner has consented to HPL’s use of the mark as both companies are associated companies.<sup>5</sup>

28. I am mindful of the requirement that the Registered Owner has to demonstrate by solid and objective evidence of effective and sufficient use of the subject mark on the market concerned, and mere assertion of use without corroborative

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<sup>5</sup> In the decision of the HK Trade Marks Registry in *Bio-Beauty* trade mark, the hearing officer, following *Einstein Trade Mark* [2007] R.P.C. 23, accepted that where the registered proprietor and the entity using a mark can be regarded as “economically linked”, and in the absence of cross-examination or evidence to the contrary, that would be sufficient to prove the required consent. In the present case, given the Registered Owner and HPL have the same shareholders and registered office, and there is no evidence to the contrary, I accept that they are “economically linked” entities and HPL has the consent from the Registered Owner to use the subject mark.

evidence is not sufficient. Apart from the mere assertion that the Registered Owner did use and continue to use the subject mark,<sup>6</sup> the Registered Owner did not file any evidence to show use of the mark in the 1<sup>st</sup> Relevant Period. Mr. Kwok also did not refer to any evidence showing use in the 1<sup>st</sup> Relevant Period and his submissions concentrated on claimed use in the 2<sup>nd</sup> Relevant Period. I can thus conclude that there is no use of the subject mark in the 1<sup>st</sup> Relevant Period. The next question is whether the Registered Owner can successfully defend the Application for Revocation by invoking section 52(4).

29. As discussed above, the Subsequent Period which is to be considered for the purpose of section 52(4) covered a longer period than the 2<sup>nd</sup> Relevant Period. If the Registered Owner can discharge the burden of proving genuine use of the subject mark in respect of the subject goods in Hong Kong in the 2<sup>nd</sup> Relevant Period, subject to section 52(5), the Registered Owner would be able to resist the Application for Revocation. As a matter of fact, Mr. Kwok focused the Registered Owner's case on the 2<sup>nd</sup> Relevant Period and did not argue that there was any use at any time before 15 December 2008.<sup>7</sup>

30. I will look at the exhibits produced in Wong's statutory declaration and see how far the exhibits showed genuine use of the subject mark in the 2<sup>nd</sup> Relevant Period.

31. Exhibit "WKT-1" is said to be a list of inventory of sale of products under the 百美 mark from 20 February 2009 up to 1 February 2012. Exhibit "WKT-2" bears the description "*Photos showing the stock of Products of Trade Mark, 百美, in our Kwai Chung godown*".<sup>8</sup> As pointed out above, the mark which appeared on the packaging of the flooring as shown in the photographs was Mark A, instead of the subject mark. For Exhibits "WKT-3" to "WKT-7", Mark B appeared in the printed advertisements.

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<sup>6</sup> Paragraph 2, Counter-Statement of Oppositions; paragraphs 10 and 13, Wong's statutory declaration.

<sup>7</sup> The Registered Owner pleaded that the 百美 mark has been used for the last 3 years prior to the filing of the Application for Revocation (paragraph 2, Counter-Statement of Oppositions).

<sup>8</sup> Paragraph 11, Wong's statutory declaration.

32. The list of inventory at Exhibit “WKT-1” appears to be an internal record and I cannot find any use of the subject mark in the list. Besides, no invoices or other records have been adduced to substantiate the claimed transactions. As to the photographs at Exhibit “WKT-2”, they are produced to show that there were large volume of stocks in the godown on or around the date of the statutory declaration on 11 June 2012. There is no suggestion that the photographs were taken on a date within the 2<sup>nd</sup> Relevant Period. The photographs therefore cannot assist the Registered Owner.

33. For Exhibits “WKT-3” to “WKT-7”, I am prepared to accept that the publications (showing Mark B) were published on a date within the 2<sup>nd</sup> Relevant Period.<sup>9</sup> However, for the reason set out in paragraph 38 below, I do not have to determine whether such evidence assists the Registered Owner in showing genuine use of the subject mark in Hong Kong.

34. The Registered Owner seeks to rely on the evidence of use of Mark A and Mark B as evidence of use of the subject mark. Mr. Kwok submitted that the evidence showed use of the subject mark as these marks included the element 百美. As to the goods on which the marks had been used, Mr. Kwok confirmed that the goods was flooring.

35. Mr. Wong’s contention was that the use of the device mark as shown in Exhibit “WKT-2” (in the form of Mark A) was completely different from the subject mark and it cannot possibly be said that the device mark differs in elements which do not alter the distinctive character of the subject mark. Mr. Wong also ran the same argument in relation to the advertisements at Exhibits “WKT-3” to “WKT-7” (which showed use of mark in the form of Mark B).<sup>10</sup> In other words, the submission is that the Registered Owner is not entitled to invoke section 52(3)(a) of the Ordinance and to rely on the use of the Mark A and Mark B as use of the subject mark. In any event, Mr. Wong argued that the advertisements at most showed use of Mark B in relation to flooring in Class 19, but not “plastic decorative laminated sheets” in Class 17.

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<sup>9</sup> See footnote 4.

<sup>10</sup> Paragraph 20(c) and (e), Applicant’s skeleton submissions.

36. Mr. Wong at the hearing made submissions citing the case authorities on the relevant enquiry which should be conducted in determining whether section 52(3)(a) of the Ordinance is applicable in the present case.<sup>11</sup> He also referred me to passages in the decisions of the Hong Kong Trade Marks Registry in respect of *Heng Yuan Xiang*<sup>12</sup>, *Beetle & device*<sup>13</sup> and *TEXAPORE*<sup>14</sup> trade marks, and the decision of the UK Trade Marks Registry in *ALFAD* trade mark.<sup>15</sup>

37. I will first deal with the question of the mark used by the Registered Owner or HPL. I have covered in the discussion above the appearance of either Mark A or Mark B in some of the exhibits adduced. On the question of whether there are any instances of use of the subject mark 百美 *per se*, I wish to refer to an observation in respect of Chan's statutory declaration. I noticed that two pages of printouts from the Chinese version of HPL's website (Exhibit "CKW-2") show, among other products of HPL, a product known as "百美® 耐磨高密度地板" on the menu on the left of the printout. Images of specimen of ten different types of flooring in different colours and appearances are displayed on two pages. The words "欲知產品的真實顏色和表面，請向敝公司職員聯絡索取樣板。" in Chinese<sup>16</sup> appear beneath the menu. A copyright notice which reads "© HOPEWELL PLASTICS LIMITED, 2010 All Rights Reserved" can be found on the printouts. On the last page of the printouts exhibited, the contact details of HPL viz. the address, telephone number, fax number and email account can be found. Potential customers can enter their own contact information and enquiry on that page to make online enquiry with HPL if required. These printouts may lend support for a case that the subject mark 百美 *per se* has been used on the website in the 2<sup>nd</sup> Relevant Period (as shown by the copyright notice).

38. Nevertheless, taking such evidence at its highest (i.e. 百美 has been used as a trade mark for the goods of the Registered Owner or HPL on the website in or since

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<sup>11</sup> The relevant enquiry is set out by Lord Walker of the UK Court of Appeal in paragraphs 43 to 45 of *BUD AND BUDWEISER BUDBRÄU TRADE MARKS* [2003] R.P.C. 25, also reviewed by Mr. Richard Arnold QC, sitting as the Appointed Person for the UK Trade Mark Registry in paragraphs 33 and 34 of *NIRVANA Trade Mark* (BL O/262/06) and reiterated in *REMUS Trade Mark* (BL O/061/08).

<sup>12</sup> Decision dated 6 July 2010.

<sup>13</sup> Decision dated 27 April 2011.

<sup>14</sup> Decision dated 3 October 2012.

<sup>15</sup> Case O/037/12, 1 February 2012.

<sup>16</sup> The words mean "For exact colour and surface of the product, please approach our company staff for samples."

sometime in 2010, and assuming such use amounts to genuine use of the subject mark in Hong Kong), the Registered Owner is still required to discharge the burden of demonstrating that the subject mark has been used on the subject goods. I also observe that the use of Mark B<sup>17</sup> in the advertisements cannot assist the Registered Owner in discharging the burden either as such instances of use at most only show use of the mark in relation to the same goods.

39. I am mindful of Mr. Kwok's submissions that the subject mark has been used on flooring but not on other goods. Specifically, I note that there was no challenge to Mr. Chan's evidence in paragraph 4 of his statutory declaration where he observed that the wording “百美® 耐磨高密度地板” on the website (Exhibit “CKW-2”) was used in relation to wooden flooring, but not the subject goods. The Registered Owner did not contest Mr. Chan's evidence that the samples shown at the Kwai Chung godown during his visit in October 2011 were “wooden flooring samples” and his recollection of Mr. Ben Wong's account that the flooring was made from high density wood surfaced with high pressure decorative laminate (see paragraphs 18 and 19 above). There is also no suggestion that the flooring offered under the subject mark, Mark A or Mark B is flooring other than those made of wood.

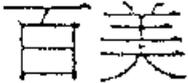
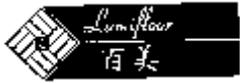
40. There are three items of goods in HPL's catalogue, namely DPM film, foam underlay and fibre panel underlay, which Mr. Chan enquired with Mr. Ben Wong in November 2011. Even assuming that these three items of goods fall within the specification of the subject goods, the Registered Owner's clear evidence is that the subject mark was not used on these items.

41. Mr. Wong also submitted that the Registered Owner is the registered proprietor of the following two registered marks, and even if there is evidence to show that the subject mark has been used on flooring, the use is only relevant to the use on goods registered under these other registered marks in Class 19, but not the subject mark in Class 17. He said that the fact that the Registered Owner registered the same mark 百美 in both Classes 17 and 19 supported the view that flooring does not fall

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<sup>17</sup> For the purpose of the present proceedings, I do not have to determine whether the use of Mark B by itself amounts to use of the subject mark, or whether Mark B is an acceptable variant of the subject mark by virtue of section 52(3)(a).

within Class 17 but rather Class 19 of the Nice Classification.

Registered mark	Specification
 <p>(TM no. 1999B09512)</p>	<p>plastic decorative laminate sheets, plastic decorative laminate floor, all being non-metallic building materials and included in Class 19.</p>
 <p>(TM no. 1999B16649)</p>	<p>laminate floorings; all included in Class 19.</p>

42. I have to consider whether the Registered Owner can discharge the burden of proving that the subject mark has been used on the subject goods. The subject goods are “plastic decorative laminated sheets”. The evidence adduced by the Applicant and the Registered Owner relate to flooring described as “超耐磨高密度地板” or “耐磨高密度地板”. I also refer to paragraph 39 above. Mr. Kwok did not make any submissions on whether flooring falls within the specification of “plastic decorative laminated sheets” of the subject mark.

43. I find the following passages from paragraph 10-064 of *Kerly’s Law of Trade Marks and Trade Names* (15<sup>th</sup> Edition) helpful to the consideration of the issue.

“The use must be in relation to goods or services within the specification. Use on any other goods or services is irrelevant. If an issue arises as to whether particular goods or services do or do not fall within the specification, it may be necessary to construe what the words used in the specification actually mean. The general approach to construction has been described thus :

‘When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.’<sup>18</sup>

<sup>18</sup> This passage is quoted from the decision of Jacob J. in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281 at 288.

The words in the specification must be construed as at the date of application for the mark in question.”

44. I should also consider Schedule 4 to the repealed Trade Marks Rules (Cap.43)<sup>19</sup> and the broad description of the goods covered by Class 17, namely “Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal”.

45. Considering the specification of goods under the subject mark and the broad description of goods in Class 17 above, I do not see that the specification of “plastic decorative laminated sheets” can be construed to cover wooden flooring. As such, the Registered Owner has failed to discharge the burden of proving that the subject mark has been used on the subject goods in the 2<sup>nd</sup> Relevant Period.

## **Conclusion**

46. The Registered Owner has failed to discharge the burden of showing genuine use of the subject mark in Hong Kong in relation to the subject goods during the relevant periods. The Application for Revocation is successful. The registration of the subject mark is revoked with effect from 3 October 2008.

## **Costs**

47. The Applicant has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the successful party is entitled to its costs. I accordingly order that the Registered Owner pays the costs of these proceedings.

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<sup>19</sup> The subject mark was registered under the repealed Trade Marks Ordinance (Cap. 43). Goods or services were classified in the manner appearing in Schedule 4 to the Trade Marks Rules which set out the different classes of goods and services.

48. 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 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.

(Miss Joyce POON)  
for Registrar of Trade Marks  
11 June 2014