

Application No. 200300588

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

AND

IN THE MATTER of an application for
the registration of the trade mark: -

THE EMPORIUM

in Class 25 in Part A of the Register by
Kabushiki Kaisha World (World Co., Ltd.)

AND

IN THE MATTER of an opposition by
Giorgio Armani S.p.A., Milan Swiss
Branch Mendrisio (in substitution of GA
Modelfine S.A.)

**DECISION
OF**

Mr. Frederick Wong acting for the Registrar of Trade Marks after a hearing on 20 May
2013

Appearing: Mr. Douglas Clark, counsel, instructed by Hastings & Co. for the
applicant Kabushiki Kaisha World (World Co., Ltd.)

No appearance recorded by the opponent Giorgio Armani S.p.A., Milan
Swiss Branch Mendrisio

1. These proceedings arise out of an application made on 15 January 2003 by Kabushiki Kaisha World (World Co., Ltd.) of 8-1, 6-Chome, Minatojima-nakamachi, Chuo-Ku, Kobe-City 650-8585, Japan, to register in Part A of the register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 (the “Ordinance”), the trade mark, a representation of which appears below :

THE EMPORIUM

(the “suit mark”) in Class 25 in respect of “aprons; bandanas (neckerchiefs); beach clothes; belts; berets; blouses; boas (necklets); boots; brassieres; breeches; camisoles; caps; chemisettes (shirt fronts); clothing; clothing of imitations of leather; clothing of leather; coats; collar protectors; collars; combinations (clothing); corsets (underclothing); cuffs; drawers; ear muffs; footwear; frocks; furs; gaiters; garters; girdles; gloves; galoshes; half-boots; hats; headbands; headgear for wear; heels; hoods; hosiery; jackets; jerseys; jumpers; knitwear; lingerie; mittens; muffs; neckties; outerclothing; overalls; overcoats; pajamas; pants; parkas; pelerines; pelisses; petticoats; pullovers; pumps (footwear); ready-made clothing; sandals; scarves; shawls; shirt fronts; shirt yokes; shirts; shoes; singlets; skirts; slippers; slips (undergarments); smocks; socks; spats; sports jerseys; sports shoes; stockings; stoles; stuff jackets; suits; suspenders; sweat-absorbent underclothing (underwear); sweaters; swimsuits; tee-shirts; tights; topcoats; trousers; underclothing; underpants; vests; waistcoats; waterproof clothing; wristbands; all included in Class 25” (the “specified goods”). The suit mark was accepted for registration in Part A after examination and advertised for opposition purposes in the Government of the Hong Kong Special Administrative Region Gazette on 11 March 2005.

Pleadings

2. GA Modefine S.A. (“GA Modefine”) filed a notice of opposition which includes a Ground of Opposition on 10 June 2005.

3. GA Modefine is a company organised and existing under the laws of Switzerland, having an address at Via Penate 4, CH-6850 Mendrisio, Switzerland. It claims to be the proprietor of various trade marks which include the word “EMPORIO”. A list of its trade mark registrations and applications in Hong Kong was attached to the Ground of Opposition.

4. GA Modefine claims that all these trade marks are well known worldwide including Hong Kong where they have been used extensively for many years in relation to a diverse range of goods and services, including but not limited to “clothing, footwear, headgear, perfumes and other fragrances, cosmetics and perfumery, eyewear, watches, jewellery and imitation jewellery, horology, optical and leather goods, household goods, bed, table and bath linen, candles, candle holders, books and other printed matters, and retail services relating to the foregoing”.

5. GA Modefine further claims that it has expended much effort, time and money in promoting these trade marks in Hong Kong, the Asia Pacific region and worldwide, and had registered or applied for registration of these trade marks in many places around the world in relation to goods and services as mentioned above.

6. It alleges that the suit mark nearly resembles its trade marks and covers the same goods or goods of same description, such that it is likely to deceive the public that the applicant’s goods are of its or associated with it, and would be disentitled to protection in a court of justice; registration of the suit mark should therefore be refused under section 12(1) of the Ordinance.

7. It also alleges that the suit mark is a term which refers to a trade centre and is descriptive of the place where the goods are sold. Without acquired distinctiveness, GA Modefine alleges, the suit mark is neither distinctive nor capable of becoming distinctive, registration should therefore be refused under sections 9 and 10 of the Ordinance as well.

8. It seeks costs against the applicant.

9. The applicant filed a counter-statement on 29 November 2005, denying the claims of the opponent. It avers, in particular, the following:-

- (a) GA Modefine’s “EMPORIO” marks are all composite marks comprising device and additional words like “ARMANI” and “ARMANI CAFFE”, whereas the suit mark consisting only of the words “THE” and “EMPORIUM” and when read consecutively, it is distinctive and sufficient to differentiate the suit mark from those of others including GA Modefine’s “EMPORIO” marks. Moreover, the suit mark represented in ordinary manner is totally distinguishable from GA Modefine’s “EMPORIO” marks represented with a device. When considering the suit mark as a whole, it is readily distinguishable from GA Modefine’s

“EMPORIO” marks visually, phonetically and conceptually.

- (b) in fact, during the process of application of the suit mark, no citation of any of GA Modefine’s “EMPORIO” marks has been raised by the Registrar of Trade Marks.
- (c) the suit mark and GA Modefine’s “EMPORIO” marks had been co-existing on the Register in Class 18.
- (d) in view of the foregoing paragraphs, use of the suit mark in relation to its applied for goods is not likely to deceive or cause confusion to the public.

10. The applicant alleges that the suit mark was first adopted by the applicant in Japan in 1987, and since then has been continuously and extensively used in Japan. In addition to registration of the suit mark in Class 25 in Japan, Singapore and Taiwan, the applicant has also obtained registration for the suit mark in Classes 3, 9, 12, 14, 16, 18, 20, 21, 22, 24, 25, 28, 30, 32, 33 and 34 in Japan, Singapore, South Korea and Taiwan. The Applicant was not aware of any actual confusion and had never received any complaint.

11. It seeks costs against GA Modefine.

Substitution of GA Modefine as the opponent

12. Pursuant to an order made by the Registrar on 15 February 2011, GA Modefine, which had undergone a merger with Giorgio Armani S.p.A. to form a branch office in Switzerland under the name Giorgio Armani S.p.A., Milan Swiss Branch Mendrisio (the “opponent”), was substituted by the branch office as opponent in these proceedings, upon the Registrar receiving an undertaking given by Giorgio Armani S.p.A. on the following terms:-

- (a) that it shall be bound by the pleadings and evidence filed herein by GA Modefine;
- (b) that it shall accept liability for costs for the whole proceedings in the event that costs are awarded against the opponent, including such costs

that may have been/may be awarded against the then opponent GA Modefine, up to and including the date of the final determination of this application for substitution.

The above undertaking was duly provided and received on 28 February 2011.

Opponent's Evidence

13. The opponent's evidence consists only of a statutory declaration of Edgardo Cardani dated 17 April 2007 ("Cardani's statutory declaration"). Edgardo Cardani is the Administrative and Financial Manager of GA Modefine. He claims that GA Modefine is part of the world famous Armani Group. The Armani Group was said to have been inspired by the designer Giorgio Armani, and includes among other companies Giorgio Armani S.p.A (Italy), Giorgio Armani Corporation (USA), Giorgio Armani Asia Pacific Limited (Hong Kong), etc.

14. It is alleged that GA Modefine is the beneficial owner of all trade marks used and registered by it in the world except for Italy, San Marino and Vatican City, together with all goodwill and reputation attaching thereto. Trade marks owned and controlled by GA Modefine include "EMPORIO ARMANI", "EMPORIO ARMANI CAFFE", "EMPORIO ARMANI ...lei/elle/she/ella" and "EMPORIO ARMANI ...lui/il/he/el" (these marks hereinafter collectively referred to as "EMPORIO Trade Marks").

15. The EMPORIO Trade Marks are said to have been "used internationally, including in Hong Kong, in relation to a range of men's and women's clothing, headgear, footwear, watches and jewelry, and a range of fashion accessories including bags, small leather goods and other goods made from leather and imitation leather, umbrellas, perfumes and other fragrances, and other fashion accessories, and the provision of retailing services in respect thereof, and catering services."

16. It is further alleged that extensive promotion of the EMPORIO Trade Marks worldwide, including in Hong Kong, have been continuous for many years and made the marks internationally famous and created a massive goodwill therein. Besides promotion by advertisements in internationally circulating magazines, journals and newspapers, the EMPORIO Trade Marks were promoted at trade fashion shows in many places around the world.

17. Cardani deposed that GA Modefine through its previous Hong Kong agent Joyce Boutique Limited had used the trade mark “EMPORIO ARMANI” in relation to retail services, selling goods bearing the trade mark “EMPORIO ARMANI”. Joyce Boutique Limited was said to be an agent for GA Modefine in Hong Kong from 1976 to 2000, operating a number of stores in various high-end shopping arcades or shopping areas in Hong Kong. Exhibit 2 to Cardani’s statutory declaration contains copies of extracts from the Hong Kong Business Name Register relating to the EMPORIO ARMANI stores, showing shops of Joyce Boutique Limited or of the Armani Group companies had been running branch office in the name “EMPORIO ARMANI”.

18. Exhibit 3 to Cardani’s statutory declaration is said to contain copies of media clippings and website materials showing the nature of GA Modefine’s megastore complex in Chater House, Hong Kong in October 2002, which is alleged to be GA Modefine’s only other megastore outside Milan and its goods under the EMPORIO Trade Marks were sold there.

19. Cardani’s statutory declaration contains further details of the use and promotion of the EMPORIO Trade Marks in Hong Kong. I do not propose to summarize them but would discuss them in the latter part of this decision.

Applicant’s Evidence

20. The applicant’s evidence consists of a statutory declaration of Shoko Tsuzuki made on 27 April 2009 (“Shoko Tsuzuki’s statutory declaration”). Shoko Tsuzuki is the person in charge of the matter in the Intellectual Property and Legal Affairs Department of the applicant since 2007. She deposed to the matter in the statutory declaration according to her knowledge and information, or that gleaned from the records of the applicant, under the authorisation of the applicant.

21. According to Shoko Tsuzuki, the then current president of the applicant devised the suit mark and the mark “EMPORIUM / エソポリアム” (the English transliteration of the Japanese characters is “EMPORIUM”) before 1987 and has subsequently obtained registration thereof in Japan in a number of classes of goods. The applicant also owns trade mark registrations for the marks in Singapore, South Korea and Taiwan.

22. The suit mark was first used in Japan in 1987 and had been continuously used since then in relation to goods in classes 9, 14, 18, 24 and 25. Shoko Tsuzuki claims that the applicant sells goods under the suit mark not only in the shops but also through online shopping at the applicant's website "WORLD DIRECT STYLE" (<http://directstyle.world.co.jp/>). Exhibit "ST-3" to the statutory declaration of Shoko Tsuzuki contains photographs allegedly showing the applicant's goods under the suit mark, exhibits "ST-4" to "ST-7" are printout photographs from the applicant's various websites allegedly showing the applicant's various goods sold in the shops and by online shopping.

23. Global annual sales figures for the applicant's goods under the suit mark for the years 2001 to 2006 were given. They show a steady growth from US\$20,837,557 in 2001 to US\$85,186,909 in 2006. It is alleged that by the continuous and extensive use of the suit mark in different jurisdictions, the applicant has acquired goodwill and reputation of the mark in respect of the relevant public in the trade, and the mark is adapted to distinguish the applicant's goods from those of other traders.

24. Shoko Tsuzuki deposed in her statutory declaration that although the Italian and Spanish word "EMPORIO", which appears in the EMPORIO Trade Marks, may be translated into English as "emporium" or "trade centre", the EMPORIO Trade Marks are all composite marks such that they should be clearly distinguishable from the suit mark; and to the best of her knowledge, the applicant has not received any report of confusion in that connection, and indeed the marks had been allowed to co-exist in Singapore, Taiwan, South Korea and Japan.

Decision

25. Although the substantive hearing on 20 May 2013 took place after the commencement of the Trade Marks Ordinance, Cap. 559, by virtue of section 10(2) of Schedule 5 of Cap. 559, oppositions that are pending at the commencement date, 4 April 2003, remain to be dealt with under the provisions of the repealed Trade Marks Ordinance, Cap. 43 ("the Ordinance").

26. The opponent relies on a number of grounds in opposition, namely, objections under sections 9, 10, 12(1) and 20(1) of the Ordinance. I will first deal with the registrability issue under sections 9 and 10.

Opposition under sections 9 and 10

27. In the Ground of Opposition, the opponent alleged that the suit mark is a term which refers to a trade centre and is descriptive of the place where the goods are sold, and without acquired distinctiveness, the suit mark is neither distinctive nor capable of becoming distinctive and offends sections 9 and 10 of the Ordinance.

28. There is no further elaboration on this point in the Ground of Opposition, nor in Cardani's statutory declaration. On the other hand, Shoko Tsuzuki deposed in her statutory declaration that the Italian and Spanish word "EMPORIO", which appears in the EMPORIO Trade Marks, may be translated into English as "emporium" or "trade centre".¹

29. To be registrable in Part A of the register, the suit mark must contain or consist of at least one of the essential particulars listed in paragraphs (1)(a) to (d) of Section 9 of the Ordinance, and must be distinctive. Section 9(1)(d) prescribes that a trade mark shall contain or consist of at least a word or words having no direct reference to the character or quality of the goods or services. According to the online Compact Oxford English Dictionary, "emporium" means "a large retail store selling a wide variety of goods". The specified goods applied for are a long list of Class 25 goods, as set out in paragraph 1 above. Given the wide variety of merchandise that could be sold at an "emporium", it's hard to deny that the term is totally unsuggestive of the specified goods, which after all are daily clothing items or apparel that may be sold, as the opponent alleged, at a large retail store. But I do not think such a description or reference could amount to a direct reference to the character or quality of the specified goods making the suit mark unregistrable under section 9(1)(d) of the Trade Marks Ordinance.

30. As said by the learned author of *Shanahan, Australian Law of Trade Marks and Passing Off (2nd Edition)* at p. 98:-

"The word 'direct' was introduced in the United Kingdom by the Act of 1905, and in Australia by the Trade Marks Act 1912, to 'check the tendency which had been disclosed by certain decisions to find a sufficient reference to the character or quality of goods in expressions from which it could only be spelled out'. But how a direct reference differs from an indirect reference has been difficult to state. The mark need not be absolutely unsuggestive and this

¹ Exhibit 5 to Cardani's statutory declaration contains printout from an online dictionary www.freedict.com, showing that the English translation of both the Italian word and the Spanish word "EMPORIO" to be "EMPORIUM".

was true even under the earlier legislation. It has been said that ‘direct reference corresponds in effect to aptness for normal description’ and it would seem that a direct reference is one that seriously affects the word’s capacity for distinguishing goods from a particular source, as compared with the sort of reference that can be found only as an ‘academic exercise’”

31. It is, I think, a stretch of the imagination to assume that words like “the emporium” do convey a meaning to customers in general such that the words, if applied to clothing items or apparel, would aptly describe their character or quality. If anything, emporium just describes the place where a great variety of goods may be bought and sold there; this, however, has nothing to do with the character or quality of the specified goods.

32. I am satisfied that the suit mark does not fall foul of section 9(1)(d), nor could it possibly be conceived as falling foul of any other subparagraphs of section 9(1)(a) to (d). The fact that the words do not describe the goods in question is, without the need to show more, illustrative that the mark is distinctive with respect to the applicant’s goods. Hence the suit mark is registrable under section 9. There is no need for me to go on to consider section 10. The opposition based on these two sections necessarily fails.

Opposition under section 12(1)

33. It is well-established that before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its mark. At its very highest, it is a question of a substantial proportion of the interested public being aware of its mark, and at its very lowest, the question relates to the significance of the numbers in relation to the market for particular goods. The reputation in the opponent’s mark must be more than de minimis to bring section 12(1) into operation the reason being, if the opponent’s mark is unknown in Hong Kong, deception or confusion is unlikely to arise (*Da Vinci Trade Mark* (1980) RPC 237). Only if the opponent discharges this burden does the onus shift to the applicant to satisfy the tribunal that there is no reasonable likelihood of deception among a substantial number of persons if the suit mark proceeds to registration (*Eno v Dunn* (1890) 15 App Cas 252 at 261). The date at which this cognizance or reputation is to be established is the date of the application to register the suit mark (*NOVA Trade Mark* (1968) RPC 357 at 360), which in the present case is 15 January

2003 (“the application date”).

34. Reputation in the local market may be established through user of the mark in its widest sense including advertisements if the goods are available to be traded in Hong Kong or even if they are not, through the spill-over of foreign goodwill and reputation into Hong Kong (*Hong Kong Caterers Ltd v. Maxim's Ltd* [1983] HKLR 287. See also *Sans Souci Trade Mark*, unreported decision of the acting Registrar M W Fox dated 28 May 1991).

35. Mr. Douglas Clark, counsel for the applicant, submitted that the applicant does not challenge the opponent’s evidence that shows the trade mark “Armani” was known at the application date to a substantial number of persons in Hong Kong, however, he noted that far less evidence has been produced showing “Emporio Armani” was known at the application date. How Mr. Clark came to such a view is a bit surprising to me, having regard to the opponent’s evidence which I have outlined in paragraphs 13 to 19 above. In Cardani’s statutory declaration, all trade marks owned and controlled by GA Modefine, which include “EMPORIO ARMANI”, “EMPORIO ARMANI CAFFE”, “EMPORIO ARMANI ...lei/elle/she/ella” and “EMPORIO ARMANI ...lui/il/he/el”, are collectively referred to as “EMPORIO Trade Marks”, and Mr. Cardani generally did not make distinction between them, but he did specifically mention that “The trade mark ‘EMPORIO ARMANI’ has been used worldwide and in Hong Kong in relation to clothing (including clothing, ties, socks, hats, gloves, shoes, underwear, foulards), footwear and headgear since 1981.”²

36. The evidence shows that GA Modefine acted through its previous Hong Kong agent Joyce Boutique Limited in selling goods bearing the trade mark “EMPORIO ARMANI” from 1976 to 2000. As shown by records gleaned from the Hong Kong Business Name Register (Exhibit 2 to Cardani’s statutory declaration), stores or shops operated by Joyce Boutique Limited in 1989 and 1995 carried on business under the branch name “EMPORIO ARMANI”; and from 2001 onwards stores or shops operated by Giorgio Armani Hong Kong Limited, which presumably was within the Armani Group, also carried on business under the branch name “EMPORIO ARMANI”. Then in Exhibit 3, which contains copies of media clippings and website materials showing GA Modefine’s megastore complex, or flagship store as it is known, in Chater House, Hong Kong in October 2002. On the one hand, the megastore was called or referred to as “Armani/Chater House”; on the other hand, in those pictures which show the building that housed the megastore, it could be clearly seen that the trade mark “EMPORIO

² Words in quotation marks taken directly from paragraph 8 of Cardani’s statutory declaration.

ARMANI & device”, which is the same as the one I reproduce under paragraph 38 below, was conspicuously displayed on the outside wall of the building, together with some other trade marks that contain the word “ARMANI”. The many publications contained in Exhibit 3, among them the Sing Tao newspaper dated 2 November 2002, mentioned that the flagship store housed both “Giorgio Armani” and “Emporio Armani” at the same time, and “Emporio Armani” brand men’s and women’s clothing and fashion accessories were sold at the flagship store. So, with regard to the evidence filed by the opponent, if it is accepted that reputation has been established with respect to “Armani” brand goods, it’s puzzling not to accept that “Emporio Armani” brand goods had been established as well.

37. Having said that, I might as well point out that the evidence in Exhibit 3 did reveal that the opponent had another famous trade mark or brand “GIORGIO ARMANI” used in relation to the same description of goods, and that might lead Mr. Clark to think that “ARMANI” is more distinctive and well known than “EMPORIO, and hence his submission as I mentioned it under paragraph 35 above. But this, as supported by evidence, should in no way deny that “Emporio Armani” brand goods had established its own reputation.

38. Promotion of the EMPORIO Trade Marks is alleged to have been done by advertisements in internationally circulating magazines, journals and newspapers, press articles, trade shows, catalogues, books and other media in the same form around the world. Cardani’s statutory declaration gives figures in US Dollars and in Hong Kong Dollars in respect of the worldwide and Hong Kong sales, as well as the expenditure on worldwide and Hong Kong advertising, of various clothing and fashion accessories products under the trade mark or brand “EMPORIO ARMANI”, and some other forms of the EMPORIO Trade Marks, for the years 1996 to 2003. I do not intend to go into the details of them, suffice to say that they are all impressive sums such that it is safe to conclude that reputation had been widely established in the local market of clothing and fashion accessories products through user of “EMPORIO ARMANI” and other forms of EMPORIO Trade Marks. As shown by the catalogues and promotional and sales materials at Exhibit 4 to Cardani’s statutory declaration, the following mark is the dominant mark widely seen, whether in advertisements or affixed to the goods themselves, in relation to clothing and fashion accessories products:-



(this mark is referred to hereinafter as the opponent’s mark “EMPORIO ARMANI”)

39. Taking the evidence of the opponent discussed above as a whole, it is easy to find that the opponent has established a reputation in the opponent's mark "EMPORIO ARMANI" in respect of clothing and fashion accessories products in Hong Kong prior to the application date, sufficient at least to mount an opposition under section 12(1).

40. For the purpose of overcoming the threshold for mounting an opposition under section 12(1) of the Ordinance, the awareness of the opponent's mark in Hong Kong need not be in respect of the same goods as the applicant wishes to protect. All that the opponent needs to show, which I find it has, was reputation for the mark in Hong Kong derived from user in the widest sense or awareness here. The difference in the goods may become a factor when I consider the likelihood of deception but it is not a pre-condition to mounting an opposition – see *Re Yuen Nuen Sun* [2000] HKLRD 341 at 354-356 (also reported as *Re Sun's Jewellery Co.* [2000] 2 HKC 210 at 223C-224F), *Re Omega Trade Mark* [1995] 2HKC 473 at 479.

41. The onus thus shifts to the applicant to satisfy me that use of the suit mark will not be reasonably likely to cause deception and confusion amongst a substantial number of persons. The classic expression of the question to be decided is in *Smith Hayden & Co.'s Application* (1946) 63 RPC 97 which, if adapted to the present case, is as follows:

“Having regard to the reputation of the opponent's mark “EMPORIO ARMANI” in respect of men's and women's clothing and fashion accessories, is the tribunal satisfied that the mark 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 persons 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?”

42. The reference to “substantial” is a question to be judged in relation to the market for the goods concerned. “Persons” are all those likely to become purchasers of the goods upon which the respective marks are used. The reference to “the user” of the opponent's mark “EMPORIO ARMANI” and “if used in a normal and fair manner” of the suit mark in the above test normally mandates that what is to be compared is the notional and fair use which the applicant would be entitled to make of its mark in the ordinary course of trade in respect of the specified goods, against the use actually made by the opponent of its mark.

43. One point to note in the instant case is that there is no suggestion of a deliberate copying of the opponent's mark for the purpose of trading on the goodwill or reputation of the opponent and so as to deceive the purchasing public into associating the applicant's goods with the opponent's. This distinguishes the instant case from cases such as *Re Omega* and *Re Gay Giano* (cases to be discussed later) where the applicant's proposed mark was identical to the proprietor's mark and no explanation was advanced as to why the mark had been chosen by the respective applicants in the two cases. Nevertheless, lack of intention to deceive on the part of the applicant does not absolve the Registrar from his statutory duty to refuse registration of any matter which is likely to deceive or would be disentitled to protection in a court of justice. The real question is whether people would be confused, given the reputation of the opponent's mark "EMPORIO ARMANI" in respect of men's and women's clothing and fashion accessories, if they see the specified goods of the applicant with the suit mark.

44. This would involve the comparison of the two marks. The comparison is between the opponent's mark "EMPORIO ARMANI" as it has in fact been used and the suit mark in notional fair use.

45. The opponent's mark "EMPORIO ARMANI" in actual use is the mark as represented under paragraph 38 above. It contains the two words "EMPORIO" and "ARMANI" in equal size, with an eagle-like device in striped form in between. Although the device occupies the central part of the mark, given the relative size of the words, and as the saying goes, words "speak louder" than devices in a composite mark, I would regard the words to be more dominant and prominent than the device.

46. Although the device can be described as a striped eagle-like figure, it does not seem to me to be capable of on its own conveying any specific idea on or about the specified goods to the potential customers. As between the two words, I would say "ARMANI" is at least of equal prominence and distinctiveness, if not more than, "EMPORIO" is in the opponent's marks. "EMPORIO", as discussed above in paragraph 28, may be an Italian word or a Spanish word, which, if translated into English, would mean "emporium" or "trade centre". I have discussed that such a meaning does not specifically describe the goods in question. "ARMANI" is the surname of the famous Italian designer, and there is no suggestion that it carries any further meaning. On balance, I am of the view that though the device is not to be discounted in assessing the overall perception of the opponent's mark "EMPORIO ARMANI" in the mind of purchasers, it would be the two words which constitute the most distinctive feature or elements of the mark.

47. The suit mark is a pure word mark consisting of the words “THE” and “EMPORIUM”. Discounting the ordinary determiner “THE”, “EMPORIUM” is the distinctive element of the mark.

48. Comparing the two marks, whether from the visual perspective or the aural perspective, the same can be said that there is both similarity and dissimilarity existing between them. On the one hand, there is some similarity between the respective marks as “EMPORIUM” and “EMPORIO” in the respective marks are similar to each other. On the other hand, as I have said, “ARMANI” is as prominent and distinctive as, if not more than, “EMPORIO” in the opponent’s mark, whereas in the suit mark “EMPORIUM” is the only distinctive element. Even discounting the existence of the eagle-like device in the opponent’s mark, which I should not, the two marks are quite different visually and aurally. On balance, even without the device, I consider the dissimilarity outweighs the similarity. I conclude that visually and aurally, the marks are more different from each other than they are similar.

49. Conceptually, whilst I could accept that “EMPORIUM” and “EMPORIO” might be perceived by consumers as more or less the same, taking into account the existence of “ARMANI” as well as the device in the opponent’s mark, the opponent’s mark “EMPORIO ARMANI” would convey the message that this is Armani’s store, whereas the suit mark lacks such specificity. I consider that the two marks only share a low degree of conceptual similarity.

50. On the whole, I am of the view that the marks are more dissimilar than they are similar.

51. I must next consider the goods to which the respective marks are to be applied. The inevitable consequence of registration of a trade mark is that protection will extend not only to the goods covered by the registration, but also to a penumbra of closely related goods. This is clear from the provisions of sections 20 to 23 of the Ordinance which prohibit the registration of identical or nearly resembling marks owned by different proprietors in respect of the same goods or the same description of goods except in the case of honest concurrent use. It is accordingly important, when considering the likelihood of deception or confusion, to have regard to the respective goods to which the marks are applied or might be applied.

52. In *Re OMEGA* [1995] 2HKC 473, where the respondent’s attempt to register a composite OMEGA mark in respect of “writing instruments” was disallowed in view of

the appellant's registrations and user of a practically identical mark in respect of "horological instruments", Deputy Judge Le Pichon (as she then was) noted, at p. 476 :

"Whilst the opponent admits that it has neither registered its marks in respect of writing instruments, refills and parts thereof nor sold such goods in Hong Kong, it has adduced evidence to show that owners of famous trade marks tend to use them for a range of products including, in particular, watches and writing instruments. Examples of famous trade marks being used in relation to watches and writing instruments include 'ST Dupont', 'Cartier', 'Dunhill', 'Christian Dior', 'Guy Laroche', 'Tiffany', 'Corum', 'Chaumet', 'Philippe Charriol' and 'Caran d' Ache'.

53. In *Re Gay Giano Trade Mark* [1996] 2 HKC 646 at 651, Leonard J. was invited to take, and indeed took judicial notice of the fact that owners of famous trade marks in the fashion industry apply those marks to various fashion items such as clothing, hand bags, footwear and watches.

54. It is, I accept, as the Registrar in earlier decisions like "*bossini*" (unreported decision dated 30 December 1997) and "*Michel Renee*" (unreported decision dated 29 August 2001) did, a widely acknowledged practice that see well established trade marks owners in the fashion world apply their mark to various fashion accessories. The specified goods covered by the registration proposed are just a long list of goods falling under Class 25 which has class headings of "clothing, footwear, headgear". Comparing them with men's and women's clothing and fashion accessories upon which the opponent's mark "EMPORIO ARMANI" had built its reputation, it is obvious that they can fairly be described to be of the same goods or same description of goods.

55. Returning to the test propounded under paragraph 41 above, I must consider whether a substantial number of purchasers of the long list of goods making up the specified goods, with a passing familiarity with the opponent's mark "EMPORIO ARMANI" used in relation to men's and women's clothing and fashion accessories, would be reasonably likely, upon seeing the suit mark applied to the specified goods, to be caused to wonder whether both come from the same source. Is there any tangible danger of confusion among people of reasonable intelligence taking ordinary care?

56. As discussed above, I find the suit mark and the opponent's mark "EMPORIO ARMANI" being more dissimilar than they are similar. Evidence filed in the present proceedings show that the opponent's mark "EMPORIO ARMANI" is a well established

mark and brand name in the local market of men's and women's clothing and fashion accessories, whereas the applicant's evidence, which I have summarised in paragraphs 20 to 24 above, on close examination did not reveal that the suit mark had been used in the local market at all. Whilst the opponent's products could be said to occupy the luxurious or higher end of the market, how the applicant would position its products in the local market is just a speculation in the circumstances of the present case. Shoko Tsuzuki did depose in her statutory declaration that the marks had been allowed to co-exist in Singapore, Taiwan, South Korea and Japan, and the applicant had not received any report of confusion from anywhere in the world.

57. In the absence of concrete evidence proving purchasers' perceptions of each of the marks, I have to satisfy myself that if I were a purchaser of the goods concerned, I would upon seeing the suit mark conjure up an association with the opponent so that I might be caused to wonder whether they come from the same source? With the well perceived image of the opponent's mark "EMPORIO ARMANI" in mind and the passing familiarity of calling it "EMPORIO ARMANI", I would answer that question in the negative.

58. I therefore cannot conclude that there is a real tangible risk that the purchasing public would be confused into believing the goods of the parties come from the same source.

59. The two limbs of objection under section 12(1) of the Ordinance, namely likelihood of deception and disentitlement to protection by the court, are disjunctive so that the likelihood of deception is an independent ground of objection (*Hong Kong Caterers Limited v Maxim's Ltd* [1983] HKLR 287 at 296). As the opponent has not advanced any argument in respect of the other limb of section 12(1), the applicant has accordingly defeated the opposition under section 12(1) of the Ordinance.

Opposition under section 20(1)

60. At the application date, section 20(1) of the Ordinance, insofar as it related to goods, read as follows:

"20. Prohibition of registration of identical and resembling trade marks

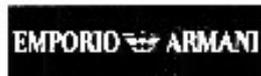
(1) Except as provided by section 22, no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of-

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those good or goods of that description.”

61. Section 2(4) of the Ordinance, which is relevant to the definition of “nearly resembles”, provides that a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

62. Under section 20(1) opposition, I should consider whether the goods for which the suit mark is sought to be registered are the same or of the same description as those of the opponent’s registered marks. But before that, due to the long list of GA Modefine’s trade mark registrations and applications in Hong Kong attached to the Ground of Opposition, I shall consider first whether the suit mark resembles any of the trade marks of the opponent.

63. I have examined and compared the opponent’s mark “EMPORIO ARMANI” with the suit mark at paragraphs 44 to 50 above. Among those listed in the Ground of Opposition, I note registration no.1990B3332 is a registration of the following mark in Class 25 on “clothing, footwear, headgear”:-³



64. The mark under the above registration is indeed the opponent’s mark “EMPORIO ARMANI”. As I have discussed above in paragraph 54, well established trade marks owners in the fashion world would like to apply their mark to various fashion accessories, it is obvious that the opponent’s and the applicant’s goods can fairly be described to be of the same goods or same description of goods. As the comparison exercise to establish whether there is confusing similarity between the marks is the same

³ Trade Marks Registry record of this registration is displaced in Exhibit 1 to Cardani’s statutory declaration.

under both sections 12(1) and 20(1), I just repeat my conclusion and find that the opponent's registered mark under registration no.1990B3332 and the suit mark are more dissimilar than they are similar, such that they are not so resembling each other as to be likely to deceive or cause confusion.

65. The opponent's mark "EMPORIO ARMANI" is, in my view, the mark on the trade mark list attached to the Ground of Opposition that comes closest to the suit mark. In the light of the above finding, there is no chance that the opponent would succeed under section 20(1).

66. Finally, a discretion arises under section 13(2) of the Ordinance when the opponent has failed in its objection under section 12(1) of the Ordinance and the suit mark is registrable under either section 9 or 10 of the Ordinance.

67. There are no specific grounds advanced by the opponent in relation to my exercise of discretion under this section in the Ground of Opposition. Nonetheless, the opponent's agent, Marks and Clerk, instead of representing the opponent in the hearing filed a skeleton of argument before the hearing, in which it is argued that the Registrar is entitled to give judicial recognition of the fact that "emporium" is a word likely to be of legitimate commercial interest to other traders for lawful use as a descriptive term in their businesses in the same way as "shop", and the applicant should not be granted exclusive statutory rights to monopolize it. I do not think it right for me to exercise such a judicial recognition. On my part I do not think "emporium" is on a par with "shop" in terms of usage in our daily language, and there is nothing before me to support the claim that other traders would wish to lawfully use this term to describe their business.

68. As no proper reasons can be advanced why registration should be refused for the suit mark which is, after all, a qualifying mark, the exercise of discretion should not be adverse to the applicant. I decline to exercise the discretion to refuse the application for registration.

Costs

69. The opponent has failed in all grounds of opposition. The applicant has sought costs. As nothing in the circumstances or conduct of this case warrants a

departure from the general rule that the successful party is entitled to his costs, I order that the opponent pays the costs of these proceedings.

70. 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 1 of the First Schedule to Order 62 of the Rules of the High Court (Cap 4A) as applied to trade mark matters, with one counsel certified, unless otherwise agreed between the parties.

(Frederick Wong)
p. Registrar of Trade Marks
14 November 2013