

## TRADE MARKS ORDINANCE (CAP. 559)

**APPLICATION NO.:** 300086670AA

**MARK:** LITTLE MERMAID BAKERY

**APPLICANT:** ANDERSEN INSTITUTE OF BREAD & LIFE  
(ANDERUSEN PAN SEIKATSU BUNKA  
KENKYUUSHO)

**CLASS:** 30

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### STATEMENT OF REASONS FOR DECISION

#### Background

1. On 30 September 2003, Andersen Institute of Bread and Life (Anderusen Pan Seikatsu Bunka Kenkyuusho) (“the applicant”) applied to register the following mark (“the subject mark”):

LITTLE MERMAID BAKERY

in classes 30 and 43 under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

2. The application was subsequently divided into two divisional applications. One divisional application, covering various services specified in class 43, was accepted by the Registrar of Trade Marks (“the Registrar”).

3. The other divisional application, being the subject of this decision (“the subject application”), is made in respect of the following goods under class 30:

“Breads, pastries, cakes, sweetmeats; all included in class 30.”

4. Objection was raised against the subject application under section 12(3) of Ordinance in respect of the following registered trade marks (“the cited marks”):

#### First cited mark

Trade mark : MERMAID  
Registration no. : 19871597  
Class no. : 30  
Goods : butter cookies

Second cited mark

Trade mark

:



Registration no. : 19871598

Class no. : 30

Goods : butter cookies

An enlarged representation of the second cited mark is shown in the Annex to this decision. Registration of the second cited mark is subject to the following disclaimer condition:

“Registration of this Trade Mark shall give no right to the exclusive use of the devices of cookies and butter and the device of ears of wheat.”

5. The filing date of both cited marks is 28 November 1983. On the date of application of the subject application, i.e. 30 September 2003, the owner of both cited marks was Kelsenbisca A/S (“the cited mark owner”).

6. On 24 February 2005, the applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 7 June 2005 at which Mr Cui Xiao Guang and Ms Ma Ya Jia of Sanyou International Intellectual Property Ltd appeared on behalf of the applicant.

7. At the hearing, Mr Cui and Ms Ma used Chinese Mandarin as the language of their submissions, and interpretation was provided by Mr Reuben Leung from the Official Languages Division of Civil Services Bureau.

8. No case authority was submitted by the applicant during the hearing. I reserved my decision at the conclusion of the hearing.

**Main statutory provisions**

9. It is convenient for me to first set out the main provisions of the Ordinance and the Trade Marks Rules (Cap. 559 sub. leg.) (“the Rules”) relevant for my consideration of the subject application.

*Section 5 of the Ordinance*

“(1) In this Ordinance, “earlier trade mark”, in relation to another trade mark, means –

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

*Section 12(3) of the Ordinance*

“A trade mark shall not be registered if –

- (a) the trade mark is similar to an earlier trade mark;
- (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”

*Section 7(1) of the Ordinance*

“For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.”

*Section 80 of the Ordinance*

“In any proceedings relating to a registered trade mark, including proceedings for rectification of the register, the registration of a person as owner of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

*Rule 79(1) of the Rules*

- “(1) Where under the Ordinance or these Rules evidence may be admitted by the Registrar in any proceedings before him, the evidence shall be filed by way of a statutory declaration or affidavit.”

**Decision**

10. In the subject application, the cited marks, having a date of application for registration earlier than that of the subject mark, are “earlier trade marks” in

relation to subject mark within the definition of section 5(1)(a) the Ordinance.

11. The issue for my determination is whether the subject application should be refused under section 12(3) of the Ordinance based on the cited marks. The relevant date for considering the issue is the date on which the subject application was made, namely, 30 September 2003.

*Test for section 12(3) of the Ordinance*

12. Section 12(3) of the Ordinance is in similar terms to Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1998 (“the First Council Directive”), which provides that:

“A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

.....

- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

13. In interpreting Article 4(1)(b) of the First Council Directive, the European of Court of Justice (“ECJ”) has formulated the “global appreciation” test, the principles of which can be found in the ECJ decisions of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [1999] E.T.M.R. 690 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 561. It is provided in these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 26;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

14. As can be seen from the above, under the “global appreciation” test, an assessment on the likelihood of confusion involves a consideration on the net effect of the similarities between the marks and the goods or services from the perspective of the average consumer. This test has been adopted by the U.K. Trade Marks Registry and the U.K. courts<sup>1</sup> in the interpretation of section 5(2) of the Trade Marks Act 1994, which implements Article 4(1)(b) of the First Council Directive, and is accordingly also similar to section 12(3) of the Ordinance.

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<sup>1</sup> See for example: *Silver Spring Mineral Water Co Ltd's Trade Mark Application (No. 2)* [2004] R.P.C. 13, *Shira's Trade Mark Application* [2003] R.P.C. 44 and *The Infamous Nut Co Ltd's Trade Marks* [2003] R.P.C. 7.

15. Although as distinct from Article 4(1)(b) of the First Council Directive, section 12(3) of the Ordinance contains three sub-paragraphs, section 12(3)(c) refers to “the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public”. As a result, the similarity of marks and the similarity of good or services covered by the marks should be taken together in deciding whether or not the use of the mark in question in relation to the applied-for goods or services is likely to cause confusion under section 12(3).

16 In addition, according to section 7(1) of the Ordinance, in assessing the likelihood of confusion under the Ordinance, the Registrar may take into account all factors relevant in the circumstances. This is also in line with the principles of the “global appreciation” test formulated by the ECJ, under which all relevant factors will be taken into account in the assessment of the likelihood of confusion under Article 4(1)(b) of the First Council Directive.

17. In view of the above, I consider section 12(3) of the Ordinance to be consistent with the principles of the “global appreciation” test, and these principles are applicable to determining an objection under this section.

#### *Similarity of marks*

18. The subject mark consists of the words “LITTLE MERMAID BAKERY” in plain block capitals.

19. The first cited mark consists of the word “MERMAID”, also in plain block capitals. According to Collins English Dictionary, “Mermaid” means “an imaginary sea creature fabled to have a woman’s head and upper body and a fish’s tail”.

20. For the second cited mark, it consists a two dimensional representation of the top view of a round tin cover. A picture depicting a small pot of butter, some ears of wheat, and a wooden spoon pouring out cookies in various shapes is shown in the upper part of the cover. Underneath the picture is the word “Mermaid”, with an outline of a mermaid in a relative small size appearing on the right hand side of it.

21. At the hearing, the applicant submitted that although both the subject mark and the cited marks contained the word “MERMAID”, in comparing marks, they should be considered by reference to their overall impressions. The applicant contends that the subject mark and the cited marks have very different visual impressions and that these marks should not be regarded as similar simply because they contain the common word “MERMAID”, especially when “MERMAID” is a dictionary word which, as opposed to invented words, does not have strong distinctiveness in distinguishing a trader’s goods from those of the others. Rather, the

applicant considers that customers can distinguish the subject mark from the cited marks with the presence of the words “LITTLE” and “BAKERY” in the former, particularly because customers are more familiarised with these words and will pay greater attention to them when compared with the word “MERMAID”.

22. Given that customers normally perceive a mark as a whole and do not proceed to analyse it in various details (*Sabel BV v Puma AG*, paragraph 23), I agree with the applicant that in assessing similarities in marks, it is the overall impressions which are relevant. However, in perceiving a trade mark, customers’ focus will be to its dominant and distinctive components. As such, in considering what overall impression customers will have in a mark, I should take into account what its distinctive and dominant components are. As pointed out in *Sabel BV v Puma AG*, at paragraph 23, visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. I should also remind myself that the average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 26).

23. In the subject application, the first cited mark consists only of the word “MERMAID”, which is considered by the applicant to be indistinctive. I do not agree with the applicant because firstly, the first cited mark is a registered trade mark, pursuant to section 80 of the Ordinance, it should be taken prima facie to have possessed distinctive character so as to be free from an indistinctiveness objection under section 11 of the Ordinance (see paragraph 22, *RALEIGH INTERNATIONAL Trade Mark* [2001] R.P.C. 11, concerning sections 3 and 72 of the U.K. Trade Marks Act 1994, which are similar to sections 11 and 80 of the Ordinance respectively).

24. Additionally, whilst “MERMAID” is not an invented word, I consider it to be distinctive of the goods of the cited marks, namely, butter cookies. This is because the word does not designate any of the characteristics of the goods, and the idea of an imaginary sea creature in relation to butter cookies is fanciful. To my mind, the word is distinctive in the sense that it identifies the goods sold under it as originating from a single undertaking, and thus to distinguish them from those of other undertakings. Accordingly, whilst not being at the highest end of the scale which, in my view, will be occupied by invented words, I consider that the word “MERMAID” is distinctive of the goods.

25. Concerning the second cited mark, although apart from the word “Mermaid”, it contains other pictorial representations, it is well-established trade mark law that words speak louder than devices (See for example: *Oasis Stores Ltd’s Trade Mark Application* [1998] R.P.C. 631 at 644). Further, the picture depicting the pot of butter, the ears of wheat and the cookies have no distinctiveness in relation to

the goods registered because it only designates the kind, shape and ingredient of the goods, and the above is self-evident from the disclaimer condition imposed on the registration. The outline of the mermaid beneath the word is not apparent from the mark, and in any event, it merely reinforces the idea of a mermaid.

26. For the above reasons, I consider the word “MERMAID” to be the most dominant and distinctive component of the cited marks, and customers’ main impression and recollection on the marks will be the word “MERMAID”.

27. I turn to consider the subject mark “LITTLE MERMAID BAKERY”, which is sought to be registered in respect of breads, pastries, cakes, and sweetmeats. The word “BAKERY” is totally indistinctive of these goods because it merely designates the place where the goods are baked or sold, and is therefore applicable to other traders selling or producing these goods. For the remaining words “LITTLE MERMAID”, I consider that when customers come across these words, the word “MERMAID” is more likely to catch their attention and to leave in their memories because the main subject of the words is “MERMAID”, and they will merely perceive the word “LITTLE” as an adjective for describing either the smallness in size or the young age of the mermaid. When this is considered in light of the fact that customers only have an imperfect recollection on the marks to which they come across, I consider that the overall impression and general recollection that customers, or at least a significant number of them, have on the subject mark will be the word “MERMAID” as well.

28. In the subject application, the applicant submits that “The Little Mermaid” is a famous fairy tale written by the Danish author, Hans Christian Andersen, and is about the fictional sea princess “The Little Mermaid”. According to the applicant, the story has subsequently been adapted by Disney in a cartoon film, also with the name “The Little Mermaid”. The applicant submits that both the fairy tale and the film are highly popular, and it produces photographs of the books, VCDs, together with printouts from various websites featuring this fairy tale and the Disney movie. The applicant contends that since “The Little Mermaid” is a fictional character whereas “MERMAID” refers to an imaginary sea creature, customers’ perceptions on the words “LITTLE MERMAID” and “MERMAID” will be significantly different.

29. I am unconvinced by the applicant’s submission above. This is because there is no formal evidence before me showing the degree of recognition of “The Little Mermaid” fairy tale and the Disney film amongst the Hong Kong public. I am also doubtful on whether customers will think of this fairy tale when they come across the subject mark, especially when it is used in relation to breads, cakes, pastries, etc, which do not appear to have any connection with the fairy tale or the film. In any case, as shown from the materials provided by the applicant, the fictional sea princess “The Little Mermaid” featuring in both the fairy tale and the film is a young mermaid,

customers' main impression and general recollection on the subject mark will therefore remain to be the idea of and thus the word "MERMAID", even assuming that they associate the subject mark with the fairy tale or the film.

30. In light of my finding that as with the cited marks, the overall impression and general recollection that customers have on the subject mark are the word "MERMAID", I consider the subject mark to be visually, aurally and conceptually similar to the cited marks.

#### *Similarity of goods*

31. As the provision of section 12(3)(b) of the Ordinance makes it clear, the relevant comparison is to be made between the goods for which the subject application is made and those for which the cited marks are protected.

32. Guidance on the approach to be adopted in comparing goods and services can be found in *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281, in which Mr Justice Jacob considered the following factors to be relevant in determining whether or not there is similarity (at page 296):

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33. Similar factors are also referred to in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, at paragraph 23:

"In assessing the similarity of the goods or services concerned, as the French

and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary”.

34. In the subject application, the applied-for goods are breads, pastries, cakes, and sweetmeats. While Western people always take breads as staple food, it is not uncommon for local people to take them as snack. For pastries, cakes, and sweetmeats, people usually take them as snack or dessert, and this applies equally to the goods covered by the cited marks, namely, butter cookies. Accordingly, I consider that uses of the two sets of the goods are the same. Further, I am of the view that users of both sets of goods, consisting of members of the general public in Hong Kong, are also in common.

35. Turning to the physical nature of these goods, breads, pastries, cakes and butter cookies are all baked from dough. Both sets of goods will be available for sale in the bakeries, or supermarkets, grocery or convenience stores where these goods are likely to be found on the same shelves. Accordingly, I consider that the goods reach customers through the same trade channel as well. Further, since the uses, users, and the physical nature of the respective sets of goods are the same or are very similar, I am of the view that these goods are in competition with each other.

36. On the above basis, although the applied-for goods and the goods of the cited marks are not identical, following the guidance in *British Sugar v James Robertson and Sons Ltd* and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, I am of the view that the goods to be closely similar to each other.

#### *Likelihood of confusion*

37. Confusion in the context of section 12(3) of the Ordinance refers to confusion as to origin of the goods and services in question.

38. In the subject application, the applicant submits that confusion as to origin is unlikely, and it draws my attention to the differences in the qualities and the prices of the goods actually sold by the applicant and the cited mark owner, along with the differences in the way in which their respective goods are produced and packaged, and sold to customers in Hong Kong in reality. The applicant further submits that in real life, its and the cited mark owner’s products are consumed by customers for different purposes. In particular, the applicant draws my attention to the followings:

- (a) The cited mark owner is a Danish company and its products are

traditional and expensive Danish butter cookies possessing special taste and quality. Its cookies are taken by consumers as snacks at leisure times. By contrast, the applicant is a Japanese company whose products are ordinary and inexpensive bread and cakes which, like other fast food, do not have any special quality and taste, and are consumed by customers as staple food at normal meal times.

- (b) The cited mark owner's butter cookies are produced and processed in Denmark, shipped to other places including Hong Kong, and are then placed in supermarket shelves for sale, whereas, the applicant's goods are produced in the workshop behind its bakery shops, and are sold instantly in the bakery shops after baked;
- (c) The cited mark owner's butter cookies are packaged in elegant blue tins catered for long distance transportation, and its registered trade mark “丹麥藍罐” (meaning “Denmark Blue Tin Cookies”) appears invariably on the packaging. According to the applicant, the “blue tin” packaging together with the “丹麥藍罐” mark have become distinctive of the cited mark owner's products. By contrast, the applicant's goods are sold without or in very simple packaging.

39. Printouts from the applicant's and the cited mark owner's websites, along with photographs, video clips and sample advertising literature showing the applicant's and the cited mark owner's products, and the way in which they are presently packaged and sold to consumers in Hong Kong are provided by the applicant.

40. In addition, the applicant submits that from its own research, the cited mark owner has not used the cited marks in the Hong Kong for a substantial period of time. Further, the applicant submits that according to its own research on the register of trade marks in Hong Kong (“the register”) and on the cited mark owner's websites, it notes that the cited mark owner has registered other “sub-ordinate” marks and it only uses them to indicate different flavours rather than the trade origin of its butter cookies. It is the applicant's belief that “MERMAID” is like one of those subordinate marks, and will not be relied on by customers as an indication of trade origin of the cited mark owner's products. Rather, they will rely on the “丹麥藍罐” mark and the “blue tin” packaging for this purpose. The applicant accordingly believes that confusion as to the trade origin of its and the cited mark owner's products is likely.

41. I have noted the applicant's submissions above, but do not consider that they assist the applicant's argument that there will be no likelihood of confusion.

42. First, since the materials produced by the applicant are not provided by

way of a statutory declaration or affidavit as required under rule 79(1) of the Rules, I cannot take them into account in my determination of the subject application.

43. Secondly, in relation to the applicant's claim that the cited marks have not been used, I do not believe that this is an appropriate forum for me to consider this allegation. Since the cited marks have been validly registered, the Ordinance presupposes that the cited mark owner will put the marks into use. Even if, as submitted, the marks have not been put into actual use at present, the cited mark owner can legitimately do so in future. If the subject application is blocked by the registration of the cited marks, but they have not been genuinely used in Hong Kong for a period of at least three years and there are no valid reasons for non-use, the proper course for the applicant to take is to invoke revocation proceeding under section 52 of the Ordinance. I believe the above has also addressed the applicant's submission that the cited marks will not be used by the cited mark owner to indicate the trade origin of its products, as there is nothing to prevent the cited mark owner from doing so in future, whether independent of or in conjunction with the “丹麥藍罐” mark and the “blue tin” packaging.

44. Thirdly, in my assessment of the likelihood of confusion in the subject application, I see no reason in limiting myself in considering and comparing the qualities and the prices of the applicant's and the cited mark owner's goods and how they are respectively packaged and sold at this point in time. The reason is that these are matters which can be changed by the cited mark owner and the applicant in future.

45. With respect to the second and third reasons above, I refer to *Origins Natural Resources Inc v. Origin Clothing Limited* [1995] F.S.R. 280, a trade mark infringement case decided under section 10(2) of the U.K. Trade Marks Act 1994, which is couched in similar terms to section 5(2) of the Act. Mr Justice Jacob says, at page 284, that:

“It is said that... the proposed trading circumstances of the plaintiffs are such that there is no likelihood of confusion. It is queried whether the plaintiffs ever will use their mark. If they do not the defendant asks "how can there ever be a likelihood of confusion on the part of the public?" In my judgment this point is misconceived. Section 10 of the Trade Marks Act presupposes that the plaintiff's mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered and then to assess a likelihood of confusion in relation to the way the defendant uses its mark, discounting external added matter or circumstances. The comparison is mark for mark.”

46. Although *Origins Natural Resources Inc v. Origin Clothing Limited* is

an infringement case, owing to the similarity in the wordings of section 5(2) and section 10(2) of the U.K. Trade Marks Acts 1994, the case has been relied on by the U.K. Trade Marks Registry as the authority for the proposition that in considering the likelihood of confusion under section 5(2) of the Act, normal and fair use of earlier mark owners' and applicants' trade marks in respect of the goods or services for which they are respectively registered and proposed to be registered is to be assumed.<sup>2</sup>

47. For the reasons given in paragraphs 42 to 44 above and drawing reference to the U.K. approach, I should assess the likelihood of confusion in the subject application in the following manner:

“Assuming normal and fair use of the cited marks in relation to the goods for which they are registered is there, leaving aside added matter or circumstances, a likelihood of confusion on the part of the public if the applicant uses the subject mark normally and fairly in relation to any of the goods for which it is proposed to be registered?”

48. Assuming normal and fair use of the cited marks and the subject mark in relation to the goods respectively registered or proposed to be registered, the cited mark owner may sell, under the “MERMAID” mark, fresh instead of preserved butter cookies in simple packaging rather than in the “blue tin” packaging. By the same token, the applicant may offer, under the subject mark “LITTLE MERMAID BAKERY”, its pastries and cakes, etc in elegant tins rather than in simple packaging. The applicant and the cited mark owner may also place their respective goods on the same shelf in the same supermarket, and sell them at comparable prices. Further, notwithstanding the applicant's claim that its goods are taken by consumers as staple food in reality, the specification applied for in the subject application is wide enough to cover snack products.

49. In assessing the likelihood of confusion, I remind myself again that the matter must be judged through the eyes of the average consumer of the goods or services in question. As stated earlier, the relevant customers of both the applied-for goods and the goods of the cited mark are members of the general public in Hong Kong, and I consider their level of attention and care in relation to the purchase of these goods are merely average. I also remind myself that I must take into account all relevant factors, in particular, the similarities in the goods and the similarities in the marks.

50. In the subject application, as explained, the goods covered by the cited mark are closely similar to those applied for in the subject application. As also explained, taking imperfect recollection into account, the overall impression and general recollection that customers have on both the subject mark and the cited marks

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<sup>2</sup> For example: *IDG Communication Ltd's Trade Mark Application* [2002] R.P.C. 10 at paragraph 22.

are the word “MERMAID”. In such circumstances, customers, in my view, are likely to be confused into believing that the goods respectively sold under the subject mark and the cited marks originate from the same or economically-linked undertakings.

51. The applicant further submits that it has been using the subject mark in Japan since 1948 and it has more than 450 outlets in Japan, most of which are located in popular tourist spots in Japan. Further, the applicant submits that its first Hong Kong shop was opened in October 2003, with promotional campaign for the same, including advertisements in local newspapers and magazines, first launched in September 2003. According to the applicant, its shops are located in a famous supermarket chain in Hong Kong and media reports and commentaries on the same can be found in various Hong Kong websites.

52. It is the applicant’s submission that reputation of the subject mark in Japan has been spilled over to Hong Kong owing to the heavy tourist exchange between Hong Kong and Japan, and coupled with the promotion and use of the subject mark in Hong Kong since September 2003, the subject mark has become a famous and influential Japanese brand name in Hong Kong. On the above basis, the applicant submits that customers in Hong Kong will be able to distinguish the goods sold under the subject mark from those sold under the cited marks.

53. I have noted the applicant’s submissions above, but I cannot take them into account in the subject application because the use of the subject mark in Hong Kong and Japan has not been substantiated by formal evidence (rule 79(1) of the Rules again refers). I should also mention that since the applicant’s first shop was only opened in October 2003, i.e. after the relevant date, no issue of honest concurrent use under section 13 of the Ordinance can arise in the subject application.

54. The applicant further claims that since the opening of its first Hong Kong shop in October 2003, it has not received any complaint from the cited mark owner over its use of the subject mark. However, as I have not been provided with a letter of consent to the registration of the subject mark from the cited mark owner, I am not able to waive the section 12(3) objection under section 12(8) of the Ordinance.

55. There is also the applicant’s submission that the subject mark has gained recognition amongst the Denmark people and even the Danish Royal family. Again, there is no formal evidence in support. In any event, I do not believe that this is a factor relevant for my consideration of likelihood of confusion in the subject application, an issue which has to be assessed from the perspective of the average consumer in Hong Kong.

*Reference to other registered marks on the register and foreign registrations*

57. I take note of the applicant's reference to the co-existence of the "MERMAID QUEEN" and "LITTLE MERMAID" marks in class 24 in the register. However, it is well-established that comparison with other marks on the register is in principle irrelevant when considering a particular mark for registration (see *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 305).

58. I also note the co-existence of the numerous "MERMAID" marks in Japan referred to by the applicant, but where there are valid reasons for refusing the subject application, I am not prepared to follow the acceptances of other registries, especially when the reasons behind those acceptances are not available before me.

**Conclusion**

59. In this decision, I have carefully considered all documents filed by the applicant, together with all oral and written submissions made in respect of the subject application. For the reasons given, the subject mark is precluded from registration by section 12(3) of the Ordinance based on the cited marks, and the subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Simon Chan  
for Registrar of Trade Marks  
11 August 2005

Annex

