

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300948394



MARK:

CLASSES: 30 and 32

APPLICANT: HIANG KIE COFFEE GROUP LIMITED

OPPONENT: SHANGHAI HIANG KIE TRADING COMPANY
LIMITED

STATEMENT OF REASONS FOR DECISION

Background

1. On 6 September 2007, the applicant filed an application for registration (“the subject application”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for the registration of the following mark :-



(“the suit mark”).

2. Registration is sought in respect of goods of the following classes :-

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

3. Particulars of the subject application were published on 23 November 2007. On behalf of the opponent, Fulimax Logistics Company Limited (“Fulimax”) filed a notice of opposition with a “statement of ground of opposition” (“statement of grounds”) on 17 January 2008.

4. The opposition hearing was heard on 11 July 2012. Mr. Yuen Tze Fai represented the applicant at the hearing. The opponent did not file a notice of intention to appear and was not represented at the hearing.

Grounds of opposition

5. According to the notice of opposition, the opposition relates to both Classes 30 and 32 of the subject application.

6. The opponent does not identify in the statement of grounds¹ the section(s) of the Ordinance upon which it wishes to rely. From the statement of grounds, I gather that the opponent bases its opposition on grounds which, in gist, are as follows :-

- (i) the “owner” of the applicant, a former member of staff of the opponent, understood that the opponent’s mark (reproduced under paragraph 11 below) was registered in mainland China but not in Hong Kong; he then incorporated the applicant in Hong Kong and sought to register the suit mark which is similar to the opponent’s mark ;
- (ii) the suit mark is similar to the opponent’s mark, and the use of the suit mark would cause confusion among customers; and

¹ Some documents are annexed to the notice of opposition. As those documents are not filed by way of a statutory declaration or affidavit in accordance with Rules 79 and 80 of the Trade Marks Rules (Cap.559, sub. leg.) (“Rule/s”), these documents (except those which are subsequently filed under the applicant’s statutory declarations) would not be regarded as evidence filed in the present case.

- (iii) the opponent has priority to register its mark and has lodged an application for registration in class 30 in Hong Kong (application no. 301001113).

7. Further, from examining the opponent's evidence, it transpires that the opponent relies on the following grounds (as the opponent has not identified the sections of the Ordinance upon which it seeks to rely, I have added the sections to which I believe such grounds are relevant):-

- (i) sections 12(3) and 12(5)(a) : on account of the alleged similarity between the opponent's mark and the suit mark which gives rise to confusion among customers;
- (ii) section 11(5)(b) : on account of the alleged bad faith on the part of the applicant; and
- (iii) section 11(1) : on account of the argument, following (ii) above, that the suit mark is not "a badge of origin" and is not "capable of distinguishing the applicant's goods from those of the opponent".

Counter-statement

8. The applicant filed a counter-statement on 16 April 2008 in response to the opponent's notice of opposition.

Evidence

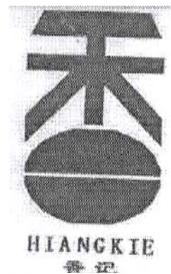
9. Under Rule 18 of the Rules, the opponent filed a statutory declaration from Chiu Ming Sun, Managing Director of the opponent, together with exhibits, which was declared on 17 October 2008 ("Chiu's first statutory declaration"). Under Rule 19, the applicant filed a statutory declaration from Yuen Tze Fai, director of the applicant, together with exhibits, which was declared on 2 July 2009 ("Yuen's statutory declaration"). The opponent filed evidence in reply under Rule 20(1) by way of a second statutory declaration from Chiu Ming Sun together with one exhibit, which was declared on 31 December 2009 ("Chiu's second statutory declaration").

Relevant date

10. The relevant date for considering the opposition is 6 September 2007, the date of the subject application for registration.

Opponent's evidence

11. Mr. Chiu has been the Managing Director of the opponent since 1996. He explains that a Hiang Kee trade mark ("the opponent's mark" as reproduced below) has been used by the opponent on "coffee and coffee bean" ("the opponent's goods") in mainland China since 1996 under a licence from "Hiang Kie Group". Hiang Kie Group is a Singapore company which manufactures the opponent's goods. The mark was created by Hiang Kie Group and the mark has been in use in Singapore since 1936.



12. The opponent's mark was registered on 21 April 2002 in mainland China in respect of "coffee, coffee bean and coffee powder" in class 30. A copy of the registration certificate is produced at Exhibit B.

13. According to Mr. Chiu, the opponent's goods are sold in different parts of mainland China including Beijing, Shanghai, Shenzhen and Guangzhou. Copies of some sales invoices bearing various dates in 2006, some brochures and menus relating to the use of the opponent's mark in mainland China are produced at Exhibit A.

14. In July 2007, the opponent authorised Fulimax to be the exclusive distributor of the opponent's goods in Hong Kong and Macau for a duration of 3 years. A copy of an authorization dated 18 July 2007, and copies of some sales invoices bearing various dates from October 2007 to September 2008 are produced at Exhibit C.

15. Mr. Chiu avers that the opponent is the legitimate owner of the opponent's mark. He further deposes to the application for registration of a variant of the opponent's mark in Hong Kong ("the opponent's variant mark" as reproduced below). A copy of trade mark records for application no. 301001113 retrieved online is exhibited as Exhibit D.²



16. Mr. Chiu avers that the similarity between the suit mark and the opponent's mark phonetically, conceptually and visually gives rise to confusion among consumers, particularly due to the fact that the respective goods of the opponent and the applicant are distributed through the same trade channels and distributed to the same consumers.

17. He also deposes to an unsuccessful application by a related company of the applicant for registration of a trade mark (which resembles the applicant's mark B, reproduced at paragraph 22 below) for "promotion (for others); import and export agency" in class 35 in mainland China. A copy of a printout from the online records of the trade marks office of mainland China is produced at Exhibit E.

18. Mr. Chiu believes that the applicant's choice of the suit mark is made in bad faith seeking to take advantage of the reputation of the opponent's mark, and the suit mark cannot be "*a badge of origin*" or "*capable of distinguishing the Applicant's goods from those of the Opponent*" (paragraph 15 of Chiu's first statutory declaration).

Applicant's evidence

19. Mr. Yuen is a director of the applicant and has occupied the position since 15 May 2008. The contents of his statutory declaration are either matters within his personal knowledge or derived from the applicant's records.

² According to the printout from the online records, the application for registration was filed by Fulimax and the opponent on 27 November 2007. Except the omission of "ice" in the specification, the specification for the goods sought to be registered in class 30 under application no. 301001113 is identical to the specification of goods in class 30 under the subject application.

20. Mr. Yuen deposes to the incorporation of Hiang Kie Limited (香記有限公司) and the applicant on 7 May 2001 and 18 May 2007 in Hong Kong respectively. Copies of the certificates of incorporation are produced at Exhibits A1 and A2.

21. Hiang Kie Limited had since its establishment been using the trade mark as reproduced below (“the applicant’s mark A”) :-



22. The mark was subsequently modified by Hiang Kie Limited in 2004. The modified mark is reproduced below (“the applicant’s mark B”) :-



23. The applicant now seeks to register the suit mark which resembles the applicant’s mark B, except that the word “LTD.” in the applicant’s mark would be replaced by “COFFEE” in the suit mark.

24. Mr. Yuen produces Exhibits B1 to B4 which are copies of an internal “Leave Application Form”, a coffee machine rental contract dated 12 November 2002, two undated name cards and a delivery note dated 4 October 2002 to illustrate the use by Hiang Kie Limited of the applicant’s mark A. The applicant’s mark B is shown on Exhibits C1 and C2 which consist of copies of a sales invoice and a delivery note both dated 31 August 2004.

25. Mr. Yuen avers that since 1 April 2008, the opponent has inherited all the business, including the trade mark, of Hiang Kie Limited. In support, he produces a copy of a letter dated 1 March 2008 (Exhibit A3) issued by the Managing Director of Hiang Kie Limited under the letterhead of Hiang Kie Limited which bears the applicant’s mark B. The letter reads, inter alia, the following :-

“Dear Business partners and Customers,

Hiang Kie Limited is a wholly subsidiary of Hiang Kie Coffee Group Limited... we are pleased to inform you that, with effective from 1st April 2008, all the businesses to be done with your good selves shall be carried out by Hiang Kie Coffee Group Limited. All outstanding businesses will be continued and executed by Hiang Kie Coffee Group Limited...

The contact persons and relative details are remained unchanged as below : ”
(and the address, telephone number, fax number, email address and website are set out)

26. Referring to the opponent’s allegation in the statement of grounds outlined in paragraph 6(i) above, Mr. Yuen reiterates the point made by the applicant in the counter-statement that enquiries have been made with all shareholders of Hiang Kie Limited and the applicant, and it was found that no existing shareholder was a former member or staff of the opponent.

27. Mr. Yuen avers that the applicant’s mark A and the applicant’s mark B had been used in Hong Kong before the establishment of Fulimax on 18 July 2005. Fulimax’s application for registration of the opponent’s variant mark under application no. 301001113 was made after the subject application and the publication of the acceptance of the suit mark for registration.

28. In response to the reference in Chiu’s statutory declaration to “Hiang Kie Group” in Singapore, Mr. Yuen deposes that “Hiang Kie Pte Ltd”, (formerly known as “Hiang Kie (Private) Limited”) was wound up on 13 August 2004. He also produces by way of Exhibit D1 a copy of a “Corporate Insolvency Search Result” issued by the Official Receiver of Singapore on “Hiang Kie Pte Ltd” showing 13 August 2004 as the date of winding up order. (The date of search shown on the copy is 22 April 2009).

29. Copies of other materials including some photographs, a brochure and extracts from some publications are produced to show the use of the applicant’s mark B in Hong Kong (Exhibits E1 to E4, and Exhibit F1). Mr. Yuen avers that both Hiang Kie Limited and the applicant have been using and promoting the mark and the mark has been used in all correspondences of both companies.

30. In relation to the unsuccessful application for trade mark registration in mainland China by a related company of the applicant, Mr. Yuen explains the reason for rejecting that application was due to the similarity of the text of the mark with that of another mark on the register registered for similar services. A copy of a “商標駁回通知書” dated 18 April 2007 is produced at Exhibit G1.

Opponent’s evidence in reply

31. Mr. Chiu asserts that Hiang Kie Limited was never authorized by Hiang Kie Group to register the suit mark in Hong Kong. On the contrary, the opponent and Fulimax were authorized to use and to apply for registration of the opponent’s variant mark before Hiang Kie (Private) Limited was wound up. He also contends that the letter produced by Mr. Yuen at Exhibit A3 cannot show that Hiang Kie Limited has transferred any trade mark rights to the applicant.

Opposition under section 12(3) of the Ordinance

32. Section 12(3) of the Ordinance provides as follows:

“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.” (emphasis added)*

33. The term “earlier trade mark” is defined in section 5(1) of the Ordinance. Section 5(1) provides :

“(1) In this Ordinance, "earlier trade mark" (在先商標), 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*

(b) a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Ordinance to an earlier trade mark shall be construed as including a trade mark in respect of which an application for registration has been made under this Ordinance and which, if registered, would constitute an earlier trade mark under or by virtue of subsection (1)(a), subject to its being so registered.

(3)”

34. There is no dispute that the opponent’s mark has been registered in mainland China but not in Hong Kong. The opponent’s mark is not the subject of any pending application for registration in Hong Kong at the relevant date. As such, the opponent’s mark does not satisfy the meaning of an “earlier trade mark” within the meaning of section 5(1)(a) read together with section 5(2) of the Ordinance.

35. As to whether the opponent’s mark qualifies as an earlier trade mark by virtue of its being a “well-known trade mark”, upon examination of the statement of grounds and the two statutory declarations filed by the opponent, I do not see any assertion by the opponent that the opponent’s mark is a well-known trade mark entitled to protection under the Paris Convention at the relevant date. It follows that the opponent is not seeking to invoke section 5(1)(b).

36. As the opponent’s mark is not an “earlier trade mark” under section 5 of the Ordinance, there is no need for me to go on to consider the alleged similarity between the opponent’s mark and the suit mark and the other elements under section 12(3).

37. The opposition under section 12(3) of the Ordinance fails.

Opposition under section 11(5)(b) of the Ordinance

38. Section 11(5)(b) of the Ordinance provides that :

“(5) A trade mark shall not be registered if, or to the extent that –

... (b) the application for registration of the trade mark is made in bad faith.”

39. There is no definition of the term “bad faith” in the Ordinance. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsey J had, at page 379, expressed his views on the meaning of the term, as follows:-

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

40. In determining whether an application was made in bad faith, the courts have applied a test which involves both subjective and objective elements. In the case of *Ajit Weekly Trade Mark* [2006] RPC 25, the Appointed Person formulated the test (at paragraph 44 of the decision) as follows –

“The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the determination of the objective element.”

41. It should be noted that an allegation of bad faith is a serious allegation which must be distinctly alleged. An allegation of bad faith should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference (*ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24 at paragraph 31). Cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith (*Brutt Trade Marks* [2007] R.P.C. 19 at paragraph 29).

42. The onus rests with the opponent in demonstrating that the application for registration was made in bad faith. The test for bad faith comprises both subjective and objective elements. The opponent's allegation of bad faith on the part of the applicant must be supported by evidence of dishonest activities or dealings or at the least commercial behaviour or activities that fall below the standard regarded as acceptable by honest people of proper standards.

43. In the present case, the allegation of bad faith is not pleaded in the statement of grounds.

44. I have outlined in paragraph 6(i) above the opponent's allegation in the statement of grounds which corresponds to a reliance on the bad faith ground, albeit the opponent does not make any explicit reference to "bad faith" there. I note that the allegation outlined in paragraph 6(i) is only raised in the statement of grounds but is not covered in the statutory declarations filed.

45. I have in paragraph 26 above referred to the applicant's evidence in response to the opponent's allegation as set out in paragraph 6(i) above. The applicant's evidence in this respect is not contested by the opponent in Chiu's second statutory declaration. The opposition alleging bad faith on the part of the applicant on this basis is therefore not substantiated.

46. I also refer to the opponent's evidence summarised in paragraphs 12 to 18 above which, as I understand it, constitutes the other basis of the opponent's allegation of bad faith.

47. A copy of a brochure of Hiang Kie Group (香記集團) is exhibited among other documents at Exhibit A to Chiu's first statutory declaration. Whilst the brochure does not bear a date of publication, I notice from the context of the brochure that it was prepared before December 1995.³

48. A passage under "NEXT MOVES" on page 20 of the brochure reads "*Hiang Kie has established a company in Hong Kong for the roasting and packaging of coffee for the Hong Kong retail and institutional markets. Hiang Kie Hong Kong will be the principal distributor for the Group's products in Hong Kong and China....*

³ A passage on page 9 of the brochure reads "A four-storey warehouse is also presently under construction at the Senoko site of Hiang Kie Industries. The building, on completion in December 1995, will add approximately 6000 sq. metres of warehouse space which will be used principally to house the commodities traded by Hiang Kie, the parent company." (emphasis added)

Hiang Kie sees opportunities in China for its products, especially in the main cities and intends to have its name plate in China before 1997.”

49. The document following page 20 of the brochure bears the title “HIANG KIE CORPORATE STRUCTURE”. Hiang Kie Pte Ltd is at the top of the corporate structure diagram. “Hiang Kie Hong Kong Limited” is one of the five companies under Hiang Kie Pte Ltd, and its contact information in Hong Kong is set out below the corporate structure diagram.

50. I notice that the telephone and fax numbers of Hiang Kie Hong Kong Limited provided in the brochure are the same as those appearing on the copies of the internal Leave Application Form at Exhibit B1, coffee machine rental contract at Exhibit B2, and delivery note at Exhibit B4. The applicant’s mark A, together with the names “香記有限公司” and “Hiang Kie Limited” (or “Hiang Kie Ltd”) also appear at the top of these exhibits. On the delivery note at Exhibit B4, there is a sentence which reads “A division of HIANG KIE PTE LTD established since 1936” beneath the names of “香記有限公司 Hiang Kie Limited”. The business address appearing on these exhibits is different from that indicated on the brochure.

51. The fax number of Hiang Kie Hong Kong Limited provided in the brochure also appears on the copies of sales invoice and delivery note at Exhibits C1 and C2. The applicant’s mark B, together with the names “香記有限公司” and “Hiang Kie Limited” appear at the top of these two exhibits. The business address and the telephone number appearing on the two exhibits are different from those indicated on the brochure.

52. Another copy of an undated brochure of Hiang Kie Group is also produced among other documents at Exhibit A to Chiu’s first statutory declaration. The last page of the brochure sets out the respective names and contact details of Hiang Kie Group and the opponent, as well as other related companies. Under “Hong Kong Office”, the telephone number of Hiang Kie Hong Kong Limited provided is the same as that appearing on the other brochure referred to in paragraph 49 above.⁴ I notice that the business address of Hiang Kie Hong Kong Limited provided in this brochure is also the same as that appearing on the copies of the internal Leave Application Form, coffee machine rental contract and delivery note produced by the applicant at Exhibits B1, B2 and B4.

⁴ The fax number of Hiang Kie Hong Kong Limited appearing on this brochure is identical (with the exception of one numeral) to that appearing on the other brochure referred to in paragraph 49 above.

53. Both the opponent and the applicant have not in their respective statutory declarations proffered any explanations as to the relevance of “Hiang Kie Hong Kong Limited”, or explanations as to the relationship between Hiang Kie Limited, Hiang Kie Hong Kong Limited and Hiang Kie Group (or Hiang Kie Pte Limited).

54. Mr. Chiu alleges in his second statutory declaration that “*Hiang Kie Limited (sic) was never authorised by Hiang Kie Group (being the originator of the Opponent’s mark) to register the proposed trade mark in Hong Kong...*”, and “*While Hiang Kie Limited (sic) has been using the proposed mark in Hong Kong, such use is illegal...*” (paragraphs 2 and 7 of Chiu’s second statutory declaration). The opponent however has not adduced any evidence to substantiate these allegations.

55. Regarding the letter from Hiang Kie Limited dated 1 March 2008 at Exhibit A3, Mr. Chiu comments “*[t]he Exhibit A-3 ... is merely a notice from Hiang Kie Limited to business partners and customers, and cannot show that Hiang Kie Limited has transferred any trade mark rights to [the applicant]*” (paragraph 3 of Chiu’s second statutory declaration). In my view, Mr. Chiu’s comment is short of substantiating the allegation that the applicant has no right to use or to apply for registration of the suit mark in Hong Kong at the relevant time.

56. Mr. Chiu also has not provided responses to the other exhibits produced by the applicant in Yuen’s statutory declaration which show the use of the applicant’s mark A and the applicant’s mark B.

57. The applicant has adduced evidence to demonstrate that the suit mark is derived from earlier mark(s) which has been in use in Hong Kong since at least October 2002 in the case of the applicant’s mark A (as evidenced by the delivery note at Exhibit B4), i.e. almost 5 years before the relevant date. The opponent has not adduced any evidence to show that, at the relevant date, the applicant is not entitled to apply for registration of the suit mark, or any evidence of dishonest activities or dealings or at the least commercial behaviour or activities on the part of the applicant that fall below the standard regarded as acceptable by honest people of proper standards.

58. I have in mind the principles set out in paragraph 41 above in particular that an allegation of bad faith should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference. Viewing the evidence as a whole, I do not consider that the opponent has discharged its burden in adducing

cogent evidence to demonstrate that the applicant's application for registration was made in bad faith.

59. The opposition under section 11(5)(b) therefore fails.

Opposition under section 12(5)(a) of the Ordinance

60. The opponent's reliance on the "passing off" ground is not pleaded in the statement of grounds. In paragraph 4 of Chiu's second statutory declaration, Mr. Chiu asserts "[t]he use of the proposed mark by the Applicant is illegal, and would also constitute an infringement of the Opponent's right in the Opponent's mark including passing off ...".

61. Section 12(5) of the Ordinance provides, inter alia, as follows:

"... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off) ..."

62. A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of Hong Kong Vol 15(2)* at paragraph 225.001. The guidance takes account of speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C. 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731, and is as follows :

The House of Lords has restated the necessary elements which a plaintiff has to establish in an action for passing off:

(1) the plaintiff's goods or services have acquired a *goodwill or reputation* in the market and are known by some distinguishing feature;

(2) there is a *misrepresentation* by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) the plaintiff has suffered or is likely to suffer *damage* by reason of the erroneous belief engendered by the defendant's misrepresentation.

Reputation or goodwill of the opponent's mark

63. In the present case, the opponent has not adduced any evidence of use of the opponent's mark in respect of the opponent's goods in Hong Kong before the relevant date. The copies of invoices produced at Exhibit C to Chiu's first statutory declaration bear dates ranging from October 2007 to September 2008 (the earliest one is dated 11 October 2007). Although the opponent has produced a copy of an authorisation dated 18 July 2007 to show the opponent's authorisation of Fulimax as the exclusive distributor of the opponent's coffee beans and coffee powder products in Hong Kong, the sales in Hong Kong (as evidenced by the copies of invoices produced) were all conducted after the relevant date.

64. As there is no evidence on the use of the opponent's mark in respect of the opponent's goods in Hong Kong before the relevant date, there is no basis for me to find that the opponent has established goodwill or reputation in Hong Kong by virtue of its use of the opponent's mark. The first element under paragraph 62 is therefore not made out. There is no need for me to go on to consider the other elements under that paragraph.

65. The opposition under section 12(5)(a) fails.

Other grounds

66. Mr. Chiu says in paragraph 15 of his first statutory declaration that "*In view of the aforesaid, I verily believe that the Applicant in its choice of the proposed mark is in bad faith, seeking to take advantage of the reputation and fame established in the Opponent's mark, and is therefore not bona fide. The proposed mark cannot therefore be said to be a "badge of origin" or capable of distinguishing the Applicant's goods from those of the Opponent*". The opponent has not cited the section(s) of the Ordinance which it seeks to rely upon in this respect.

67. The absolute grounds for refusal of an application for registration are contained in section 11 of the Ordinance. Section 11(1)(a) provides that *signs* which

do not satisfy the requirements of section 3(1) (meaning of “trade mark”) shall not be registered.⁵

68. The provisions of section 11(1)(b) to (d) are applicable to “*trade marks*”, i.e. signs which satisfy the requirements of section 3(1). They in general prohibit the registration of trade marks which lack a distinctive character in the absence of appropriate use.

69. It is apparent that the opponent is not contending that the suit mark is by its nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings, or that it lacks a distinctive character. As a matter of fact, the opponent has not adduced any evidence on how the suit mark is not registrable under section 11(1).

70. Rather, I find that Mr. Chiu seeks to argue that the applicant’s choice of the suit mark, which is made in bad faith, gives rise to confusion among consumers as to the origin of the goods concerned. What Mr. Chiu says here is his view and argument, but not evidence to prove such allegation.

71. I have already dealt with the opponent’s ground of opposition based on the allegation of bad faith. Section 11(1) is not the proper avenue for the contention. In so far as the opponent is seeking to rely upon section 11(1), the opponent’s opposition is not made out.

Costs

72. The opponent has failed in all grounds of opposition. 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 opponent pays the costs of these proceedings.

73. 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

⁵ Section 3(1) defines a “trade mark” (商標) to mean any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.

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
14 November 2012