

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300995527

MARKS: A 八喜 8 Happiness
 B 八喜 8 HAPPINESS

CLASSES: 16, 29, 30 and 35

APPLICANT: Maxim's Caterers Limited

OPPONENT: Beijing Allied Faxi Food Co., Ltd.

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 November 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 marks in series:-.

A 八喜 8 Happiness
B 八喜 8 HAPPINESS

(“the suit marks”).

2. Registration is sought in respect of the following goods and services in classes 16, 29, 30 and 35 :

Class 16

Envelopes (stationery); forms (printed); handbooks (manuals); magazines (periodicals); manuals (handbooks); newsletters; note books; pamphlets; paper; paper sheets (stationery); coupons; paper ribbons; periodicals; printed matter; printed publications; prospectuses; stationery; wrapping paper; packaging; writing instruments; writing materials; writing or drawing books; writing pads; writing paper; cardboard and goods made from these materials, not included in other classes; photographs; plastic materials for packaging (not included in other classes).

Class 29

Meat and preserved meat; fish; poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; compotes; eggs; milk and milk products; milk powder; cream; ice-cream; edible oils and fats; yoghurt; mayonnaise; sandwich spread on the basis of milk; nuts; pickles; preserved and dried sea products (except fish).

Class 30

Coffee, artificial coffee, coffee substitutes; tea, tea leaves and tea products; cocoa, cocoa power and cocoa products; soup stock; bread; biscuits; cakes; snacks; cookies; crackers; Chinese cakes and Western style cakes; Chinese dumplings; almond flakes; chocolate; bread sticks; pancakes; desserts; puddings; pastry and confectionery; macaroni, spaghetti, noodles and pasta products; flour and preparation made from cereals; honey; treacle; yeast, baking-powder; salt; sugar; vinegar; mustard; pepper; spices; horseradish sauces; sauces (condiment); salad dressings; ketchup; curry; ice; rice; tapioca; sago.

Class 35

Advertising; business management; business administration; office functions; advertising by mail order; business consultancy (professional-); business information; business inquiries; business investigations; business management and organization consultancy; business management assistance; business management consultancy; business organization consultancy; business research; commercial or industrial management assistance; demonstration of goods; direct mail advertising; dissemination of advertising matter; distribution of samples; organization of exhibitions for commercial or advertising purposes; import-export agencies; marketing research; marketing studies; organization of trade fairs for commercial or advertising purposes; sales promotion (for others); updating of advertising material; retail and distribution services connected with sale of food.

3. Particulars of the subject application were published on 28 March 2008, and the opponent filed a notice of opposition to the subject application on 27 June 2008.

4. The opposition hearing was fixed to be heard on 12 November 2012. Neither party has filed a notice of intention to appear at the hearing. Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559, sub. leg.) (“Rules”), both parties are treated as not intending to appear at the hearing. I now proceed to decide the matter without a hearing under rule 75 of the Rules.

Grounds of opposition

5. The grounds on which the Opponent opposes registration of the suit marks as stated in the notice of opposition are under sections 11(4)(b), 11(5)(a), 11(5)(b), 12(1), 12(2), 12(3) and 12(4) of the Ordinance.

Counter-statement

6. The applicant filed a counter-statement on 22 September 2008 in response to the opponent's notice of opposition.

Evidence

7. Under rule 18 of the Rules, the opponent filed an affidavit from Dunkun, the manager of the opponent, together with exhibits, which was sworn on 11 March 2009 ("Dunkun's affidavit"). Under rule 19 of the Rules, the applicant filed a statutory declaration from Wu Wei Kuo Michael, the chairman and managing director of the applicant, together with exhibits, which was declared on 16 December 2009.

Relevant date

8. The relevant date for considering the opposition is 19 November 2007, the date of the subject application for registration.

Opposition under sections 12(1), 12(2), 12(3) and 12(4) of the Ordinance

9. Sections 12(1), 12(2), 12(3) and 12(4) of the Ordinance provide as follows :-

“(1) A trade mark shall not be registered if-

- (a) the trade mark is identical to an earlier trade mark; and
- (b) the goods or services for which the application for registration is made are identical to those for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if-

- (a) the trade mark is identical to an earlier trade mark;

- (b) the goods or services for which the application for registration is made are 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.
- (3) 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.
- (4) Subject to subsection (6), a trade mark which is-
- (a) identical or similar to an earlier trade mark; and
 - (b) proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

10. Each of sections 12(1), 12(2), 12(3) and 12(4) of the Ordinance requires that there is an earlier trade mark in relation to the suit marks.

11. Section 5(1) of the Ordinance provides that :

“(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.”

12. Section 2(1) of the Ordinance provides that a “registered trade mark” means a trade mark registered under section 47 of the Ordinance.

13. Both the opponent’s marks “  ” and “  ” (collectively referred to as “the opponent’s mark”) are not registered trade marks which have a date of application for registration earlier than that of the suit marks. The opponent claims that the opponent’s mark is entitled to protection under the Paris Convention as a well-known trade mark, and that the opponent’s mark is an earlier trade mark in relation to the suit marks as defined in section 5(1)(b) on the Ordinance.

14. To rely on section 5(1)(b) of the Ordinance, the opponent has to show that the opponent’s mark was, at the relevant date, entitled to protection under the Paris Convention as a well-known trade mark.

15. According to section 4(1) of the Ordinance, references in the Ordinance to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as references to a trade mark which is well-known in Hong Kong. In determining whether a trade mark is well-known in Hong Kong, the Registrar shall have regard to Schedule 2 to the Ordinance (section 4(2) of the Ordinance). The Registrar shall take into account any factors from which it may be inferred that the trade mark is well-known in Hong Kong (section 1(1), Schedule 2 to the Ordinance), including information concerning the matters referred to in section 1(2), Schedule 2 to the Ordinance. They include the degree of knowledge or recognition of the trade mark in the relevant sectors of the public; the duration, extent and geographical area of any use of the trade mark; the duration, extent and the geographical area of any promotion of the trade mark and of any registrations or applications for registration of the trade mark, to the extent that they reflect use or recognition of the trade mark and so on.

16. Under section 1(4), Schedule 2 to the Ordinance, “relevant sectors of the

public” includes, but is not limited to, actual or potential consumers of the type of goods or services to which the trade mark applies; persons involved in channels of distribution of the type of goods or services to which the trade mark applies; and business circles dealing with the type of goods or services to which the trade mark applies. Section 1(5), Schedule 2 further provides that where a trade mark is determined to be well-known in at least one relevant sector of the public in Hong Kong, it shall be considered to be well-known in Hong Kong.

17. According to paragraph 2 of Dunkun’s affidavit, the opponent, Beijing Allied Faxi Food Co., Ltd, is a limited company founded under the laws of the People’s Republic of China on 7 August 1990. The opponent resides in Jinma Industrial Park, Shunyi, Beijing, China. A copy business licence was produced at exhibit “BZY-1”.

18. The opponent claims in paragraph 3 of Dunkun’s affidavit that it had focused on the production of fresh ice cream bearing the opponent’s mark for more than ten years prior to 2009. The opponent’s ice cream is “the real ice cream without adding water, which has created domestic precedent and ended the history of Chinese importation of pure fresh milk ice cream”. As per paragraph 4 of Dunkun’s affidavit, the opponent avers that the ice cream cakes produced by the opponent were sold in one YUM! PIZZA Restaurant in March 2004 and the sales turnover had been more than 20 million (the type of currency is not specified) up to the date of swearing the affidavit. I am not sure whether the ice cream cakes bear the opponent’s mark. The opponent has not expressly stated the location of the YUM! PIZZA Restaurant and where the alleged 20 million sales took place. Presumably, reading from the context of the affidavit, the alleged sales seem to have occurred in China. However, in any case, no documentary evidence such as invoices, receipts, accounts or order forms have been produced to support the alleged sales.

19. Mr Dunkun goes on to state that some promotional activities were conducted in China in 2005 and 2006. Some pictures showing the ice-cream shops and products depicting the “” mark were attached to exhibit “BZY-2”. Nevertheless, save and except there is one photo with a date of 16 January 2006 printed on it, all the other pictures are undated. The dated photo shows a very big ice-cream cake bearing the “” mark. At the backdrop shown in the photo, one can see the same “” mark and the simplified Chinese characters “世界

最大冰淇淋蛋糕见证仪式 北京儿童艺术剧院股份有限公司 北京艾莱发喜食品有限公司”。

20. As illustrated by paragraph 5 of Dunkun’s affidavit and the copies of certificates of registration produced at exhibit “BZY-3”, the opponent has obtained registrations of the mark “ ” in stylised form or “ ” without stylisation in classes 10, 16, 20, 21, 25, 29, 30 and 35 in China. The registrations were obtained in the period from 1995 to 2005. However, it does not seem to me that those registrations serve to reflect the extent to which the opponent’s mark has been used or recognised in China.

21. Based on a copy certificate dated 16 May 2007 at exhibit “BZY-4”, the applicant states that the trade mark “ ” 冰淇淋 was recognised as a well-known trade mark of Beijing City, China in 2007 by the 北京市工商行政管理局. I note that the geographical area of recognition is confined to Beijing City only.

22. Taking a fair appraisal of the opponent’s evidence, I can at most gather that the opponent had somehow used and promoted the opponent’s mark in relation to ice cream and ice cream cakes in Beijing City, China before the relevant date. However, in light of the flimsy nature of the opponent’s evidence, the exact duration and extent of use of the opponent’s mark even in Beijing City, China only is unknown. Save there is a single piece of pre-relevant date advertising material for the China market, there is no evidence concerning the precise duration, extent and geographical area of any promotion of the opponent’s mark in relation to ice cream and ice cream cakes to which the opponent’s mark applies. Neither is there any information concerning the degree of knowledge or recognition of the opponent’s mark in any of the relevant sectors of the public in Hong Kong. There is also no evidence of any successful enforcement of rights in the opponent’s mark, or of the value associated with it.

23. Although for the purpose of determining whether a trade mark is well-known in Hong Kong, it is not necessary to establish that the trade mark has been used, or has been registered, in Hong Kong (section 2(a), Schedule 2 to the Ordinance), having regard to the totality of the opponent’s evidence of use in China and all relevant factors in accordance with section 1 of Schedule 2 to the Ordinance, I consider that the opponent has failed to establish that the opponent’s mark was well-known in Hong Kong at the relevant date.

24. As there is no earlier trade mark on which the opponent can rely for the purposes of sections 12(1), 12(2), 12(3) and 12(4) of the Ordinance, its opposition under those sections fails accordingly.

Opposition under sections 11(4)(b), 11(5)(a) and 11(5)(b) of the Ordinance

25. The opponent has adopted a very broad-brush approach in pleading that the subject application was “filed in bad faith and is likely to deceive and/or the use of the opposed mark [the suit marks] is prohibited in Hong Kong by virtue of the operation of the law such that registration should be refused pursuant to section 11(4) and/or 11(5) of the Trade Mark[s] Ordinance.” The same allegation was repeated in the Dunkun’s affidavit without anything to add. The opponent has therefore not provided any reasons or particulars to substantiate the opposition based on these provisions. As a result, the opposition under these sections also fails.

Costs

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

27. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

(Ms Fanny Pang)
p. Registrar of Trade Marks
14 November 2012