

TRADE MARKS ORDINANCE (CAP. 559)
OPPOSITION TO TRADE MARK APPLICATION NO. 301526184

MARK :



CLASS : 3
APPLICANT : CHAN KA LAI
OPPONENT : BLISS WORLD LLC

STATEMENT OF REASONS FOR DECISION

Background

1. On 20 January 2010 (“Application Date”), Chan Ka Lai (“Applicant”) filed an application for registration of the following mark under the Trade Marks Ordinance (Cap 559) (“Ordinance”):



(“subject mark”)

The application number assigned by the Registrar of Trade Marks (“Registrar”) to the above application was 301526184.

2. Registration of the subject mark was sought in respect of goods in Class 3. The applied-for goods were as follows:

Class 3

Skin care products; essential oils; hydrosols (essential oils); aromatherapy products; soap; cosmetics, face and hair lotions; dentifrices; perfumery
(collectively referred to as “subject goods”).

3. Particulars of the above trade mark application were published on 5 March 2010.
4. On 4 August 2010, Bliss World LLC (“Opponent”) filed a Notice of Opposition together with a statement of the grounds of opposition under rule 16 of the Trade Marks Rules (Cap. 559A) (“TMR”).
5. Thereafter the following documents were filed by the Applicant and the Opponent respectively in the present proceedings:
 - (a) Counter-statement filed by the Applicant on 16 September 2010 under rule 17 of TMR;
 - (b) Statutory Declaration dated 14 July 2011 made by Michael Indursky, on behalf of the Opponent, and filed on 19 July 2011 under rule 18 of TMR (“MI’s Declaration”);
 - (c) Affirmation dated 17 January 2012 made by the Applicant, and filed on 17 January 2012 under rule 19 of TMR (“Chan’s Affirmation”); and
 - (d) Second Statutory Declaration dated 18 September 2012 made by Michael Indursky, on behalf of the Opponent, and filed on 25 September 2012 under rule 20 of TMR (“MI’s 2nd Declaration”).
6. The hearing of the above opposition took place before me on 7 February 2014. Mr. Philips B.F. Wong, Counsel, instructed by Eccles & Lee, appeared for the Opponent. The Applicant was represented by Ms. Sabrina Ho, Counsel, instructed by David Ravenscroft & Co. I reserved my decision after the hearing.

Grounds of opposition

7. Although the Opponent pleaded various grounds in the Notice of Opposition,¹ Mr. Wong has appropriately limited the grounds of opposition to section 12(3) and 12(4) of the Ordinance at the hearing.

¹ The grounds of opposition include section 11(5)(b), section 12(3), 12(4) and 12(5) of the Ordinance.

8. I will examine each of the grounds of opposition raised at the hearing in turn in the paragraphs that follow.

The Opponent's evidence

9. The Opponent is a limited liability company incorporated in the State of Delaware, the United States of America. It is the owner and operator of day spas and resort spas around the world under the "BLISS" brand ("BLISS spas"). In addition, it is the manufacturer, distributor and retailer of a family of cosmetics, skin care, bath and body products marketed under the mark "BLISS" (collectively referred to as "BLISS products"). Many of the BLISS products are used by the BLISS spas in providing services to their customers.
10. According to MI's Declaration, the Opponent first adopted the "BLISS" mark in 1996 when it opened the first BLISS spa in New York city, USA. As at July 2011, there were more than 14 BLISS spas in USA. The Opponent started to expand its business outside the USA at the end of 2001 when it opened the BLISS spa in London. In 2004, it opened more Bliss spas at the well-known chain of W Hotels at various locations in the USA. The BLISS spa at the W Hotel in Hong Kong was opened in September 2008. From the date of its opening up to June 2010 (i.e., about 20 months), the gross revenue derived from services provided at the BLISS spa in Hong Kong exceeded US\$ 2 million. On an average yearly basis, this would be about HK\$ 9.3 million² per annum.
11. As regards the Bliss products, the Opponent started to offer them for sale to customers in USA in 1999. These products were later offered as in-room amenities at the W Hotels and they could also be purchased by customers at the hotels. The BLISS products were also offered for sale on the Opponent's website and a few third party websites or through a mail-order catalogue business operated by the Opponent.
12. Consumers in Hong Kong have been able to purchase BLISS products locally since 2005 at Lane Crawford stores and later at the "Faces" concept store. The gross sales of these products at the above outlets from 2007 to 2009 were

² Converted to Hong Kong dollars at the exchange rate of US\$ 1: HK\$ 7.78.

between HK\$ 4.8 million to HK\$ 8.8 million per annum. Based on the figures provided, the gross annual sales would be about HK\$ 7 million on average. In addition, the gross sales of the BLISS products at the W Hotel in Hong Kong from September 2008 to June 2010 exceeded US\$546,000. This would be about HK\$ 2.5 million³ per annum.

13. Globally, the gross sales of the BLISS spa services and the BLISS products from 1998 to 2009 ranged from US\$ 11 million to US\$ 111 million per annum.
14. The MI's Declaration went on to say that the BLISS spa services and the BLISS products were reviewed and recommended by fashion, beauty and lifestyle publications, many of which were circulated and available in Hong Kong. Examples of some of these publications include Allure, Apple Daily, Marie Claire, Business Traveller etc. In addition, the Opponent maintained social media websites such as Facebook that were directed at Asian consumers.
15. In order to protect its trade mark, the Opponent has registered "BLISS" and various marks containing "BLISS" in over 75 jurisdictions worldwide. A list of such marks was provided in MI's Declaration as evidence.⁴

The Applicant's evidence

16. The Applicant is an environmentalist and has been actively promoting natural and organic lifestyle in Hong Kong since 1993. She has given talks on the above topics at various non-governmental organizations and schools.
17. In 1992, the Applicant and her brother incorporated Arcadia Limited ("Arcadia"), a Hong Kong company. A year later, Arcadia opened an "upstairs shop" in Central to sell environmental friendly products. The shop was closed down in 1994 and it was subsequently re-opened in 1998. Since 2003, Arcadia has been operating two retail "upstairs shops", one in Central and the other in Tsimshatsui.

³ Converted to Hong Kong dollars at the exchange rate of US\$1: HK\$ 7.78.

⁴ Exhibit "MI-9" of MI's Declaration.

18. From August 1998 to September 2000, Arcadia traded under the names of “康姿堂” and “Ophelia” (the English name of the Applicant). A copy of a newsletter issued by Arcadia showing use of the above names was produced as evidence.⁵ The newsletter shows that workshops relating to natural lifestyle and the use of natural beauty products were organized by Arcadia back in 1999.
19. From September 2000 to May 2002, Arcadia traded under the names of “Ophelia herbal bliss” and “康姿堂”. The Applicant explained in Chan’s Affirmation that “herbal bliss” connoted the pleasure and delight that human derived from the use of herbs and natural resources and most importantly, their connection with the nature. A copy of another newsletter was produced which shows that the above names were used. Besides providing information relating to the workshops, the newsletter also promoted skin care products sold under the brand “ECCO BELLA”.⁶
20. Chan’s Affirmation went on to say that from May 2002 onwards, Arcadia used the names “Herbal Bliss” and “康姿堂”. “Ophelia” was dropped from its English trade name because the previous name was considered to be too long. Copies of various newsletters⁷ issued from the end of 2002 to 2006 were produced. These newsletters contained information on the workshops organized by Arcadia during the said period and the following signs or names appeared on such publications:



21. The Applicant also deposed in Chan’s Affirmation that she created the subject mark based on the designs of two of her friends. She briefly explained that the sign “*Herbal Bliss*” was designed by Victor Siu (a designer of environmental friendly products) and the flower device was designed by

⁵ Exhibit “CKL-9” of Chan’s Affirmation.
⁶ Exhibit “CKL-10” of Chan’s Affirmation.
⁷ Exhibit “CKL-1” of Chan’s Affirmation.

Monster Workshop. The Applicant then combined “*Herbal Bliss*”, the flower device and “康姿堂”, the Chinese trade name of Arcadia, to create the subject mark.

22. It is not entirely clear from the evidence when Arcadia started to market and sell skin care and other natural products under the subject mark. The only piece of evidence that shows use of the subject mark in relation to the subject goods is an undated catalogue.⁸ The subject mark was clearly printed on the top corner of the catalogue. Pictures of some of the subject goods were printed on the catalogue and the sign “*Herbal Bliss*” appeared on the packaging of those goods. However, there is no evidence showing use of the subject mark on the packaging of the subject goods.
23. No information was provided by the Applicant on the sales figures of the subject goods or the expenses incurred in promoting and advertising those goods.

The relevant date

24. For the purpose of the subject opposition, the relevant date is the Application Date (i.e. 20 January 2010).

Opposition under section 12(3) of the Ordinance

The Opponent's marks

25. The Opponent is the registered owner of, *inter alia*, the following trade marks in Hong Kong:

TM registration no. 2003B11886AA

Trade mark : **BLISS**

⁸ Exhibit “CKL-14” of Chan’s Affirmation.

Date of registration : 27 October 1999

Class nos. and specification : Class 3
 Cosmetics, colour cosmetics, facial cosmetics, skin care preparations, soaps, body and foot care preparations, fragrances, essential oils, dentifrices, bath salts, cosmetic preparations for baths, body and shower preparations, perfumes, cologne, eau de toilette, body firming gels and lotions, nail polish, lipstick, makeup, sun block and deodorants for personal use; all included in Class 3.

Class 42⁹
 Health spa services, hair salon services, body waxing services, provision of sauna and steam room facilities, hydrotherapy services, provision of aromatherapy treatments, beauty treatments for the face and body, massages, beauty facials, manicures and pedicures; all included in Class 42.

TM registration no. 300919143

Trade mark : A 
 B 

Date of registration: : 24 July 2007

Class nos. and specification : Class 3
 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics; dentifrices; spa products, beauty care products, facial care, skin care and nail care products, preparations for massage therapy.

Class 44
 Medical services; veterinary services; hygienic and beauty care for human beings; hygienic and beauty care for animals; agriculture, horticulture and forestry services; spas and spa services, beauty

⁹ The services below were classified in Class 42 under the Nice Classification 7th edition which was the applicable edition on the date of application for registration of the above mark. These services were re-classified in Class 44 under the Nice Classification 8th edition which entered into force on 1 January 2002.

salons, facial, skin and nail care services,
massage therapy services.

Mark description : The Opponent claims the colours blue and white as elements of mark “B” in the series.

For ease of reference, the trade marks under TM registration no. 2003B11886AA and TM registration no. 300919143 are hereinafter respectively referred to as “Opponent’s mark (A)” and “Opponent’s mark (B)”. Collectively, they will be referred to as the “Opponent’s marks”.

26. The Opponent relies on the Opponent’s marks as earlier trade marks in its opposition under section 12(3) of the Ordinance.

The relevant law

27. Section 12(3) of the Ordinance is worded as follows:

“(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.”

28. This ground of opposition is based on the existence of an “earlier trade mark”, a term defined in section 5 of the Ordinance. The relevant parts of section 5 read as follows:

“(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
(b)

29. Section 12(3) of the Ordinance is modeled on section 5(2) of the UK Trade Marks Act 1994,¹⁰ which in turn implements Article 4(1)(b) of the European Trade Marks Directive.¹¹ That being the case, the principles stated by the Court of Justice of the European Union (“CJEU”), (previously known as the European Court of Justice) in *Sabel BV v. Puma AG*,¹² *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*,¹³ *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel B.V.*¹⁴ and *Marca Mode CV v. Adidas AG and Adidas Benelux BV*¹⁵ on the application of Article 4(1)(b) of the above Directive are relevant to the construction of section 12(3) of the Ordinance. These principles have been adopted in the main in the Hong Kong case of *Guccio Gucci SPA v. Cosimo Gucci*,¹⁶ and they are:

- (a) The likelihood of confusion must be appreciated globally, taking into account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably observant and circumspect;
- (c) In order to assess the degree of similarity between the marks concerned the court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into

¹⁰ Section 5(2) of the UK Trade Marks Act 1994 provides as follows –

“(2) A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

¹¹ Article 4(1)(b) of the European Trade Marks Directive 89/104/EEC of 21 December 1988 provides –

“(1) 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.”

¹² [1998] R.P.C. 199.

¹³ [1999] R.P.C. 117.

¹⁴ [2000] F.S.R. 77.

¹⁵ [2000] E.T.M.R. 723.

¹⁶ [2009] HKLRD 28. This is an infringement case on the interpretation of, *inter alia*, section 18(3) of the Ordinance. The requisite elements constituting an act of infringement are similar to those provided under section 12(3) of the Ordinance.

account the nature of the goods or services in question and the circumstances in which they are marketed;

- (d) The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impression created by the marks bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion;
- (e) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (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;
- (g) The average consumer rarely has the chance to make direct comparison between different marks and instead rely upon the imperfect picture of them he has kept in his mind;
- (h) 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; and
- (i) Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose of the assessment. But the risk that the public might believe that the respective goods or services come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.

30. In essence, section 12(3) of the Ordinance prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of it being similar to an earlier trade mark and because it is to be registered in respect of goods or services that are the same as or similar to those covered by the earlier trade mark. Furthermore, in assessing whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar is required, under section 7(1) of the Ordinance, to take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

31. Based on the above principles, I will take into account all factors that are relevant in determining whether the ground of opposition under section 12(3) of the Ordinance has been established in the present case.

Earlier trade marks

32. Since the dates of the applications for registration of the Opponent's mark (A) and the Opponent's mark (B) are respectively earlier than the Application Date, each of the Opponent's marks constitutes an earlier trade mark vis-a-vis the subject mark.

The relevant consumers

33. To determine whether there are similarities between the subject mark and the Opponent's marks and whether use of the subject mark by the Applicant is likely to cause confusion, I have to look at the matter from the perspective of the average consumer of the goods. Such consumer is deemed to be reasonably well informed and reasonably observant and circumspect. Very often, his or her level of attention will depend on the nature of the goods in question.
34. The subject goods mainly consist of skin care products, cosmetics, essential oils, aromatherapy products and perfumery. These are common everyday products and the relevant consumers will be members of the public in Hong Kong. Generally speaking, the proportion of female consumers will be considerably higher than men.
35. Although the subject goods are everyday items, they are mainly applied to the skin or body with the intention of beautifying it and protecting it from ageing and other harmful substances. Hong Kong is a cosmopolitan city and the relevant consumers are fairly sophisticated and concerned about their appearance. Therefore, it is likely that they will exercise a slightly higher level of care and attention in selecting the subject goods when compared with other ordinary everyday items.

Distinctiveness of the Opponent's marks

36. The Opponent's mark (A) consists of the word "BLISS" in the upper case. The dictionary meaning of "bliss" is "perfect happiness; serene joy".¹⁷ In relation to the goods in class 3, the Opponent's mark (A) would convey to consumers the message that they will feel happy and peaceful after using the goods. Given the positive connotation of the word "bliss", the above mark only possesses a low degree of inherent distinctiveness.
37. The Opponent's mark (B) consists of a series of two marks. Both marks contain the word "bliss" (in the lower case) set against an oval background. The first mark in the series was registered in black and white. As regards the second mark in the series, the Opponent claimed the colours white and blue as elements of the mark. Irrespective of the colours used, the oval shape will only be perceived as a background which highlights the word "bliss". It does not add any new meaning to the marks. Hence, it is my view that the Opponent's mark (B) also has a low degree of inherent distinctiveness.
38. On behalf of the Opponent, Mr. Wong submitted that the distinctiveness of the Opponent's marks has been substantially enhanced through their extensive use and promotion throughout the years. He relied on the following evidence as support:
- (a) Gross sales of the BLISS products at the Lane Crawford Stores and Faces Concept store from 2007 to 2009;¹⁸
 - (b) Gross sales of the BLISS spa services and the BLISS products at the W Hotel between September 2008 to June 2010;¹⁹ and
 - (c) Promotion and advertisement of the BLISS spas and the BLISS products in publications (including unsolicited press coverage in various fashion and spa magazines) and recommendations of the BLISS spas made by such publications to their readers.²⁰

¹⁷ Collins English Dictionary at <http://www.collinsdictionary.com>.

¹⁸ See paragraph 12 of the decision.

¹⁹ See paragraphs 10 and 12 of the decision.

²⁰ See paragraph 14 of the decision.

39. As I have mentioned in paragraph 12 of this decision, the gross sales of the BLISS products at the department stores from 2007 to 2009 were HK\$ 7 million on an average yearly basis. On the other hand, the gross revenue obtained from the sales of these products at W Hotel from September 2008 onwards was about HK\$ 2.5 million per annum.
40. On behalf of the Applicant, Ms. Ho raised the challenge that the reputation of the Opponent's marks in Hong Kong was not as strong as it claimed. She pointed out that the BLISS products were put on the Hong Kong market starting from 2005 (i.e., about 5 years before the Application Date). These products were initially only sold in a few luxury department stores. It was until September 2008 (i.e., 16 months before the Application Date) that the products were also available for sale in W Hotel. The sales outlets were therefore very limited.
41. As regards the spa services, I mentioned in paragraph 10 above that the BLISS spa at W Hotel was opened in September 2008. The gross annual revenue derived from such services was about HK\$9.2 million. Ms. Ho challenged that even if the Opponent has a reputation in spa services, such reputation was not directly relevant to skin care products.
42. As for the promotion of the BLISS spas and the BLISS products in magazines and other publications, I note Ms. Ho's submission that most of the publications produced by the Opponent were overseas editions. She specifically pointed out some examples of such overseas publications for my reference.²¹ As for publications that appear to target at consumers in Hong Kong, they were mainly related to the BLISS spas and the coverage of the BLISS products was much lower.
43. To counter the above challenge, Mr. Wong argued that the place where those magazines were published was irrelevant. Consumers in Hong Kong could have access to those magazines as many of them were circulated and available in Hong Kong.²² I note Mr. Wong's argument but there is no evidence before me to show that those overseas publications were locally

²¹ Exhibit "MI-8" of MI's Declaration. Ms. Ho made reference to the following pages in the Hearing Bundle: pages 311-312 (related to the BLISS spas in USA), pages 325-338 (related to the BLISS spa in Singapore), pages 339-354 (extracted from an in-flight magazine of Cebu Philippines Airline), pages 360-369, 429-513 (extracted from overseas publications).

²² Paragraph 13 of MI's Declaration.

available. Nor is there any information on the extent of their circulation in Hong Kong. I also agree with Ms. Ho that most of the recommendations made by the magazines were specifically related to the BLISS spas.

44. Although the Applicant has challenged the extent of the reputation of the Opponent's marks in Hong Kong, there was no dispute between the parties that the Opponent's marks have been used in Hong Kong. I note from the evidence that the following marks have most often been used by the Opponent in Hong Kong in respect of the BLISS products and BLISS spa:



Since the fair and notional use of a mark includes its use in both the upper case and lower case, I am satisfied that the Opponent's mark (A) and the Opponent's mark (B) have been used in Hong Kong in respect of skin care and personal care products and spa services.

45. In assessing the extent of use of the Opponent's marks in Hong Kong prior to the Application Date, I will take into account the matters discussed in paragraphs 39 to 43 above. In particular:

- (a) the gross sales of the BLISS products and the services provided at the Bliss spa in Hong Kong;
- (b) the length of time that the BLISS products and BLISS spa services were available in Hong Kong; and
- (c) the promotion efforts of the Opponent in Hong Kong.

I also remind myself that the word "bliss" has a low level of inherent distinctiveness in respect of skin care products and health spa services. After considering the above factors, I conclude that the distinctiveness of the Opponent's marks has been moderately enhanced in respect of the BLISS products and the BLISS spa services as a result of their use in Hong Kong prior to the Application Date.

46. I will consider each of the Opponent's marks in turn for the purpose of determining whether it precludes registration of the subject mark under section 12(3) of the Ordinance.

Opponent's mark (A)

Comparison of marks

47. I remind myself that when making a comparison between different marks, the visual, aural and conceptual similarities must be assessed by reference to the overall impressions created by the marks in question bearing in mind their distinctive and dominant components.

48. Visually, the Opponent's mark (A) is a simple English word "BLISS".

49. The subject mark is a composite mark comprising the following features:
- (a) a rectangular device at the centre of the mark. The Applicant deposed that the device was an artistic representation of a flower though I think that it may not be easily recognized by those consumers who do not know the background of the subject mark. Most consumers would probably perceive it as a rectangular device with some sort of designs;
 - (b) the expression "*Herbal Bliss*" which is placed immediately below the flower device. The expression is in cursive handwriting and it is rather prominent in size. It conveys the message that the subject goods contain herbs which give serenity and joy to consumers. Thus, the expression is fairly descriptive in nature; and
 - (c) the Chinese phrase "康姿堂" which is placed vertically on the left of the device. The font size of the above Chinese characters is smaller than the other elements of the subject mark. "康姿堂" does not have a specific dictionary meaning. The Applicant explained in Chan's Affirmation that the phrase means a place with glow of health (健康姿采). However, the above meaning may not be immediately apparent to consumers. Looking at the phrase as a whole, it does not designate the characteristics or nature of the subject goods.

50. Mr. Wong submitted that the word “Bliss” is one of the most distinctive and dominant elements in the subject mark because of the following reasons:

- (a) “*Herbal Bliss*” appears prominently in the subject mark;
- (b) “*Herbal*,” is descriptive and therefore not distinctive for Class 3 goods. However, “*Bliss*” is distinctive for such goods;



- (c) The device “” is relatively indistinctive; and
- (d) The Chinese phrase “康姿堂” is printed in much smaller font and it may not easily catch the attention of the public. Further, the Chinese phrase would be meaningless to English-speaking members of the public who do not understand Chinese.²³

51. I share Mr. Wong’s view that the flower device may not be easily recognized by consumers. Furthermore, since words speak louder than device, the above device would not have much impact in the minds of the consumers. However, I do not agree that “Bliss” is the most distinctive and dominant element in the subject mark. In my view, consumers will perceive “*Herbal Bliss*” as one phrase. Since it carries a descriptive message, it would not be perceived as a distinctive element in the subject mark. That being the case, it is unlikely that the average consumer will proceed further to dissect “*Herbal Bliss*” and analyze each individual component in the phrase. Quite naturally, consumers would turn to other elements of the subject mark that could help them to identify the origin of the goods. The Chinese expression “康姿堂” is considerably smaller when compared with “*Herbal Bliss*”. However, it could be seen by an average consumer who is reasonably observant and circumspect. Furthermore, since “康姿堂” does not have a clearly defined meaning and does not designate the characteristics of the subject goods, consumers would likely perceive the Chinese expression as the more distinctive element which could enable them to identify the origin of the goods concerned. On the whole, the subject mark would likely be recalled by consumers as a composite sign with “康姿堂” as the dominant feature or more simply by reference to “康姿堂”.

²³ Exhibit “MI-13” of MI’s 2nd Declaration is a copy of a printout from the website of the HKSAR Government which shows that as at September 2012, 3.5% of the Hong Kong population were English speakers.

52. I should also mention here that it was Mr. Wong's alternative submission that even if the word "bliss" would not be considered as the dominant feature of the subject mark, the above word retained an independent distinctive role in the subject mark. I will return to this point later when I consider whether there is a likelihood of confusion.
53. Taking into account the overall impression of the subject mark and the Opponent's mark (A) and bearing in mind the dominant and distinctive component in the subject mark is the Chinese phrase "康姿堂", I consider that there is only a low level of visual similarity between the above marks. The similarity lies in the word "bliss".
54. Aurally, the Opponent's mark (A) will simply be referred to as "bliss". The subject mark will be referred to as "康姿堂 herbal bliss" or more simply, by reference to its dominant component, "康姿堂". Hence, from the aural perspective, the above marks would be considered as similar to a fairly low degree given that the only common element is the word "bliss".
55. Conceptually, the Opponent's mark (A) conveys the simple message of joy and serenity. As regards the subject mark, I have discussed earlier that the flower device cannot be readily recognized. "Herbal Bliss" carries a fairly descriptive message and would not be perceived by consumers to have much significance in identifying the origin of the goods. On the whole, the subject mark will be recalled by consumers as a composite sign with "康姿堂" as the dominant feature or more simply as "康姿堂" since they would likely perceive this phrase as an identifier of origin.
56. Given that "康姿堂" does not have a clearly defined meaning or concept, there is no conceptual similarity between the subject mark and the Opponent's mark (A).
57. Mr. Wong drew to my attention that a small section of the public in Hong Kong does not understand Chinese and the expression "康姿堂" would be meaningless to them. These members of the public would simply perceive or refer to the subject mark as "Herbal Bliss". I note Mr. Wong's submission but it is important to remember that Hong Kong is a bilingual city where English and Chinese are commonly used by the majority of people living here. Furthermore, even for the non-Chinese speaking section of the public, they

would not attach much significance to “Herbal Bliss” given that it carries a descriptive message. They would perceive the subject mark as a whole and their overall impression would be a composite mark with Chinese characters and a message describing the positive effect of herbs. Hence, the similarity between the subject mark and the Opponent’s mark (A) would still be considered to be of a low degree.

Comparison of goods and services

58. I now turn to compare the subject goods and the goods and services in respect of which the Opponent’s mark (A) is registered. The relevant principles were discussed in *British Sugar v. Robertson and Sons Ltd.*²⁴ The court held in that case that the following factors should be taken into account when considering the similarities between goods and/or services:

- (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 services;
- (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 the goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

59. Further, in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*,²⁵ the court considered that all relevant factors relating to the goods and services in question should be taken in account. These factors include, *inter alia*, their

²⁴ [1996] R.P.C. 281.

²⁵ See footnote 13.

nature, their end users and their method of use and whether they are in competition with each other or are complementary.

60. There is no dispute between the parties that the subject goods are similar to some of the goods protected by the registration of the Opponent’s mark (A). For clarity, I will set out below the relevant goods that are identical and those that are similar.

(a) The subject goods set out in first column below are identical to the goods in the corresponding second column:

Subject goods	Goods in respect of which the Opponent’s mark (A) is registered
Skin care products	Skin care preparations
Essential oils; hydrosols (essential oils)	Essential oils
Soap	Soaps
Cosmetics	Cosmetics
Face lotions	Skin care preparations
Dentifrices	Dentifrices
Perfumery	Perfumes

(b) The subject goods set out in first column below are similar to the goods in the corresponding second column:

Subject goods	Goods in respect of which the Opponent’s mark (A) is registered
Aromatherapy products	Fragrances, essential oils
Hair lotions	Skin care preparations, body and foot care preparations, body firming gels and lotions

For ease of reference, the goods set out in the second columns of the above tables will be collectively referred to as “Opponent’s category (A) goods”.

61. The services in respect of which the Opponent’s mark (A) is registered (collectively, “Opponent’s category (A) services”) are mainly health spa and

other beauty care services. In my view, the subject goods are similar to such services for the following reasons:

- (a) The purpose of skin care products and health spa and beauty care services is to beautify and improve the well-being of their users;
- (b) Users of skin care products often overlap with those who use health spa and beauty care services. They are generally those consumers who are concerned about their appearance and well-being;
- (c) The subject goods and the Opponent's category (A) services are complementary since skin care and aromatherapy products are often used in providing health spa and beauty care services; and
- (d) Skin care and beauty products are often sold in health spas and beauty care centres. Hence, the trade channels of the subject goods and the Opponent's category (A) services are often the same.

Likelihood of confusion

62. Having compared the similarities between the marks and the relevant goods and services, I now turn to consider whether there is a likelihood of confusion if the subject mark is applied to the subject goods. Under section 12(3) of the Ordinance, likelihood of confusion refers to confusion on the part of the public as to the trade origin of the goods and services in question. This is a matter of global appreciation taking into account all relevant factors and judging them through the eyes of the average consumer of the goods and services in question. I will also need to bear in mind the principles in paragraph 29 above.

63. Ms. Ho submitted that although the subject goods were similar to some of the goods of the Opponent, the use of the subject mark on the subject goods would not cause confusion to the public. Her main reasons are summarized below:

- (a) The nature of the goods were different. The subject goods were made of natural, organic and/or herbal ingredients and they were supplied by small scale producers. On the other hand, the Opponent's goods were produced and distributed in large scale.

- (b) The packaging of the subject goods and the Opponent's goods was different. The Applicant used simple packaging that was consistent with the promotion of natural and organic lifestyle.
- (c) The trade channels were different. While the subject goods were sold through limited means, the Opponent's goods were sold in hotels and high-end department stores.

64. I need to point out that when considering the ground of opposition under section 12(3) of the Ordinance, one should consider the notional and fair use of the relevant marks in relation to the full range of goods and services covered by the specifications of the earlier mark and the opposed trade mark application. In the present case, the subject goods are broad enough to cover skin care and other personal care products made from any ingredients or packaged in any style. Further, the Applicant is not restricted to her present marketing and sales channels. On the other hand, the protection that the Opponent obtained from the prior registrations of the Opponent's marks is also wide enough to cover skin care products made from any ingredients (including natural or organic materials). It can also adopt any packaging that is consistent with its marketing strategy. That being the case, Ms. Ho's submissions are not relevant in the present context.

65. Turning to Mr. Wong's submission, he argued that there was clearly a likelihood of confusion. He explained that the Opponent's mark (A) was incorporated in the subject mark in its entirety. Even if the word "Bliss" would not be considered as the dominant element, it has an independent distinctive role in the subject mark. Mr. Wong referred to the case of *Aveda Corp. v. Dabur India Ltd.*²⁶ ("*Dabur*") to support his view.

66. *Dabur* is an appeal to the High Court of England made by Aveda Corp ("*Aveda*") against the decision of a hearing officer at the UK Trade Mark Registry. Aveda was the proprietor of the mark "AVEDA" and the mark was registered for, *inter alia*, Class 3 goods. Dabur India ("*DI*") subsequently applied to register the mark "DABUR UVEDA" also in respect of Class 3 goods. Aveda's opposition against *DI*'s application was dismissed by the hearing officer. Arnold J. sitting in the High Court allowed Aveda's appeal. He followed the guidance given by the CJEU in *Medion*

²⁶ [2013] E.T.M.R. 33 at 669.

*AG v. Thomson Multimedia Sales Germany & Austria GMBH (“Medion”)*²⁷
where the court explained as follows:

- “29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *MatratzenConcord*, paragraph 32).
30. However, *beyond the usual case* where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that *in a particular case* an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.
31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.
32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.” (*my emphasis*)
67. After considering the guidance given by CJEU and other basic principles concerning assessment of likelihood of confusion, Arnold J. concluded that the average consumer who was familiar with Aveda’s beauty products would likely be confused by the use of “DABUR UVEDA” in relation to the identical goods in Class 3. In particular, there would be a strong likelihood

²⁷ [2006] E.T.M.R. 13.

that the average consumer would think that it indicated some connection between DABUR and AVEDA.

68. I note the principles in the above cases. In particular, I note that it is possible that in certain cases where an earlier mark is incorporated into a composite sign of a third party, the earlier mark still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element in the composite sign. *Medion* and *Dabur* were examples of these cases. The question now before me is: does the subject mark fall into this category of cases? The marks in dispute in *Medion* and *Dabur* were both word marks consisting of two words (“THOMSON LIFE” in *Medion* and “DABUR UVEDA” in *Dabur*). However, the subject mark is more complex and consists of a device, a Chinese phrase and an English phrase. The average consumer will generally perceive the subject mark as a whole and will pay particular attention to the dominant and distinctive element in the mark. I have discussed in paragraph 51 above that “Herbal Bliss” will be perceived as one phrase to mean the joy and serenity derived from herbs. Since it carries a descriptive message, it would not be perceived as a distinctive element in the subject mark. That being the case, it is unlikely that the average consumer will proceed further to dissect “Herbal Bliss” and analyze each individual component in the phrase. Instead, they will turn their attention to “康姿堂” which is the more distinctive element of the subject mark. I also remind myself of the finding in paragraph 45 above that the distinctiveness of the Opponent’s marks has been moderately enhanced in respect of the skin care and personal care products and spa services. Even taking this factor into account, I am still of the view that “Herbal Bliss” will be seen as a whole with a descriptive message and the word “Bliss” will not be perceived to have an independent distinctive role in the subject mark. Hence, the present case can be distinguished from *Medion* and *Dabur* where the marks concerned consisted of two unrelated words.

69. To summarize, I have found that the subject mark and the Opponent’s mark (A) are visually and aurally similar to a low degree. The distinctiveness of the Opponent’s mark (A) has been moderately enhanced through its use in respect of skin care and personal care products and health spa services prior to the Application Date. In relation to the relevant goods, I have also found that: (a) the subject goods are either identical or similar to the Opponent’s category (A) goods; and (b) the subject goods are similar to the Opponent’s

category (A) services. Further, the average consumer of skin care and beauty products is likely to exercise a slightly higher level of care and attention when selecting these goods than other ordinary everyday products. I also bear in mind the principle that a lesser degree of similarity between the conflicting marks may be offset by a greater degree of similarity between the goods or services concerned. However, in the present case, given that the overall impression as well as the distinctive and dominant components of the above marks kept in the mind of an average consumer are fairly different, I do not think that there is a real likelihood of confusion of the origin of the subject goods if the subject mark is allowed to co-exist with the Opponent's mark (A) in the market.

Opponent's mark (B)

Comparison of marks

70. The Opponent's mark (B) has been described in detail in paragraph 37 above. Visually, it is oval in shape and the word "bliss" can be prominently seen in the centre of the oval. Aurally, the mark will be referred to as "bliss". Conceptually, the mark conveys the simple message of joy and serenity.
71. As for the subject mark, I have found earlier in this decision that the dominant and distinctive element is "康姿堂" and the subject mark would likely be recalled by consumers as a composite mark with "康姿堂" as its dominant feature or more simply as "康姿堂".²⁸ The Chinese phrase "康姿堂" does not have a specific or clearly defined meaning or concept.
72. Looking at the subject mark and the Opponent's mark (B) as a whole, I find that they are visually and aurally similar to a low degree. Such similarity lies in the word "bliss" that is found in both marks. Conceptually, the two marks are different.

Comparison of goods and services

73. After applying the principles regarding comparison of goods and services, I find that the subject goods are identical or similar to some of the goods and

²⁸ Paragraph 51 above.

services protected by the registration of the Opponent’s mark (B). For clarity, my findings are set out in the tables below.

- (a) The subject goods set out in the first column below are identical to the goods in the corresponding second column:

Subject goods	Goods in respect of which the Opponents’ mark (B) is registered
Skin care products	Skin care products
Essential oils; hydrosols (essential oils)	Essential oils
Soaps	Soaps
Cosmetics	Cosmetics
Face lotions	Facial care products
Dentifrices	Dentifrices
Perfumery	Perfumery

- (b) The subject goods set out in the first column below are similar to the goods in the corresponding second column:

Subject goods	Goods in respect of which the Opponent’s mark (B) is registered
Aromatherapy products	Essential oils; preparations for massage therapy
Hair lotions	Beauty care products, facial care, skin care and nail care products

For ease of reference, the goods set out in the second columns of the above tables will be collectively referred to as “Opponent’s category (B) goods”.

74. Furthermore, I consider that the subject goods are similar to some of the services in respect of which the Opponent’s mark (B) is registered. These services are:

“spas and spa services, beauty salons, facial, skin and nail care services, massage therapy services”

(the above services are collectively referred to as “Opponent’s category (B) services”)

The reasons for my findings above are essentially the same as those set out in paragraph 61 of this decision.

Likelihood of confusion

75. To summarize, I have found that the subject mark and the Opponent’s mark (B) are visually and aurally similar to a low degree. The distinctiveness of the Opponent’s mark (B) has been moderately enhanced through use in respect of skin care and personal care products and health spa services prior to the Application Date. In relation to the relevant goods, I have also found that: (a) the subject goods are either identical or similar to the Opponent’s category (B) goods; and (b) the subject goods are similar to the Opponent’s category (B) services. Further, the average consumer of skin care and beauty products is likely to exercise a slightly higher level of care and attention when selecting these goods than other ordinary everyday products. I also bear in mind the principle that a lesser degree of similarity between the conflicting marks may be offset by a greater degree of similarity between the goods or services concerned. However, in the present case, given that the overall impression as well as the distinctive and dominant components of the above marks kept in the mind of an average consumer are fairly different, I do not think that there is a real likelihood of confusion of the origin of the subject goods if the subject mark is allowed to co-exist with the Opponent’s mark (B) in the market.

76. Mr. Wong referred to the decisions of the Registrar in “*BOCHING Simple me*” Trade Mark²⁹ and “*星輝百痛敵 ARTIBO*” Trade Mark³⁰ to support his views.

77. In “*BOCHING Simple me*”, the opposed mark is “*Simple me*”. The earlier mark is “SIMPLE” which was accepted for registration on the basis of

²⁹ Decision dated 12 October 2012. Available at http://www.ipd.gov.hk/eng/intellectual_property/trademarks/trademarks_decisions/decision/DEC300637948OP.pdf

³⁰ Decision dated 31 March 2011. Available at http://www.ipd.gov.hk/chi/intellectual_property/trademarks/trademarks_decisions/decision/DEC300424953OP.pdf

distinctiveness acquired through use. The hearing officer in that case found that there has been extensive use of the earlier mark and hence its distinctiveness has been enhanced to a significant degree. The conflicting marks were also found to be visually, aurally and conceptually similar to a moderate degree, but since the goods applied for were either identical or similar to the goods covered by the registration of the earlier mark “SIMPLE”, a likelihood of confusion was found to subsist. In that case, “Simple” was considered to be the dominant component of the opposed mark because it was considerably larger in size and it was positioned in the centre of the mark as a whole.

78. In the present case, although I have found that the distinctiveness of the Opponent’s marks has been enhanced to a moderate extent through the use of the marks, I do not think that the word “Bliss” is the dominant component of the subject mark. Nor do I consider that such word has an independent distinctive role in the subject mark. That being the case, the differences between “BOCHING Simple me” case and the present case are immediately obvious. Hence, the “BOCHING Simple me” case can be distinguished from the present case.

79. The “星輝百痛敵 ARTIBO” case was an opposition which succeeded on section 12(5)(a) of the Ordinance. The opposed mark was “^{ARTIBO}星百痛敵輝”



and the earlier mark was “PAK TON DICK”. The hearing officer found that the words “百痛敵” were placed in the centre of the opposed mark and as a whole, the phrase constituted an independent distinctive unit in such mark. After conducting a comparison of the conflicting marks, the hearing officer took the view that the marks were visually, aurally and conceptually similar to a moderate extent. Since the other elements of passing-off were also established by the proprietor of the earlier mark, the hearing officer ruled that the opposition was successful.

80. In the present case, the word “Bliss” neither constitutes a dominant component nor an independent distinctive unit in the subject mark. Further, I have found that the subject mark and the Opponent’s marks are merely

similar to a low degree. Hence, I do not find that the present case is comparable to “星輝百痛敵 ARTIBO” case.

Finding on the opposition under section 12(3) of the Ordinance

81. For the reasons above, the Opponent has failed to establish its case under section 12(3) of the Ordinance.

Opposition under section 12(4) of the Ordinance

82. Section 12(4) of the Ordinance reads as follows:

“....., 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.”

83. Mr. Wong submitted that the Opponent’s marks enjoyed well-known status in Hong Kong and such marks have also been registered in many jurisdictions around the world. He reiterated his view that the subject mark is similar to the Opponent’s marks and then went further to say that use of the subject mark by the Applicant would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Opponent’s marks.

84. To succeed on the ground of opposition under section 12(4), the Opponent has to show three conditions:-

- (a) the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark;

- (b) the subject mark is identical or similar to the earlier trade mark;
and
- (c) the use of the subject mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

I will examine the above conditions with reference to the Opponent's marks in the paragraphs that follow.

Condition (a) – well-known trade marks

85. The meaning of a well-known trade mark is set out in section 4 of the Ordinance. Under this provision, the Registrar shall have regard to the factors set out in Schedule 2 of the Ordinance in determining whether a trade mark is well-known in Hong Kong. Schedule 2 is reproduced in the Appendix of this decision. In a nutshell, these factors 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 and promotion of the trade mark, the duration and geographical area of any registrations, or applications for registration, of the trade mark to the extent that they reflect use or recognition of the trade mark, any record of successful enforcement of rights in the trade mark, the extent to which the trade mark has been recognized as a well-known trade mark in other jurisdictions, and the value associated with the trade mark. Nonetheless, paragraph 1(3) of that Schedule has made it clear that none of the above factors is a precondition, nor are the factors to be given equal weight in the assessment of whether a trade mark is to be regarded as a well-known trade mark.
86. The evidence adduced by the Opponent shows that the first BLISS spa was opened in New York in 1996 and the BLISS products were introduced in 1999. Towards the end of 2001, the Opponent expanded its spa services outside USA and opened the BLISS spa in London. However, it was only until 2005 (i.e., about 5 years before the Application Date) that the BLISS products became available for sale in Hong Kong at a few luxury retail outlets. Subsequently in September 2008 (i.e., 15 months before the Application Date), the Opponent opened the BLISS spa at the W Hotel in Hong Kong. As far as the evidence shows, the number of retail outlets in Hong Kong has been rather limited. Gross sales of the BLISS spa services and the BLISS

products in Hong Kong have been set out in paragraphs 10 and 12 of this decision.

87. As regards the worldwide gross sales of the Opponent, the sales figures were not split up between BLISS spa services and BLISS products. Although the aggregate gross sales recorded from 1998 to 2009 were rather impressive and the Opponent's marks (and other marks containing the word "bliss") were registered in more than 75 jurisdictions, it appears from the map of the BLISS spa locations³¹ and the non-exhaustive list of global retail locations³² that the Opponent's business activities were principally focused in USA where most of its revenue was derived.
88. The Opponent has not provided any quantitative figures on its promotion and advertising expenses, whether in relation to Hong Kong or on a worldwide basis. It appears from the MI's Declaration that most of Opponent's promotion and marketing efforts were focused on the overseas markets. The Opponent has adduced copies of some global publications featuring the BLISS spa services and (to a much lesser extent) the BLISS products. However, the extent of the circulation of such publications in Hong Kong was not known.
89. It was also deposed in MI's Declaration that consumers in Hong Kong could purchase the BLISS products through the Opponent's website or by mail orders. The Opponent has also maintained interactive pages in Facebook directed towards Asian customers. However, the gross revenue of the BLISS products derived from Hong Kong customers through the above means was not provided.
90. The Opponent has not adduced any evidence on its enforcement efforts in relation to the Opponent's marks. Furthermore, information on the extent to which the Opponent's marks have been recognized as well-known trade marks in other jurisdictions was not provided in the evidence.
91. More importantly, I should point out that the onus of proving that the Opponent's marks are well-known trade marks lies with the Opponent. Considering the evidence available before me and, in particular, having

³¹ Exhibit "MI-2" of MI's Declaration.

³² Exhibit "MI-3" of MI's Declaration.

regard to the observations noted in paragraphs 86 to 90 above, I am not convinced that any of the Opponent's marks is a well-known trade mark in Hong Kong as at the Application Date within the meaning of section 12(4) of the Ordinance.

92. Given my findings above, there is no need for me to go further to examine the conditions in sub-paragraphs (b) and (c) of paragraph 84 above.
93. Based on the reasoning above, I find that the Opponent has failed to establish the ground of opposition under section 12(4) of the Ordinance.

Conclusion

94. As the Opponent was not able to make out any of the grounds of opposition put forward at the hearing, its opposition fails.

Costs

95. 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. Accordingly, I order that the Opponent should pay the costs of these proceedings.
96. 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.

(Maria K. Ng)
for Registrar of Trade Marks
15 July 2014

SCHEDULE 2 OF THE ORDINANCE

DETEMINATION OF WELL-KNOWN TRADE MARKS

1. Factors for consideration

(1) In determining for the purposes of section 4 (meaning of "well-known trade mark") whether a trade mark is well known in Hong Kong, the Registrar or the court shall take into account any factors from which it may be inferred that the trade mark is well known in Hong Kong.

(2) In particular, the Registrar or the court shall consider any information submitted to the Registrar or the court from which it may be inferred that the trade mark is, or is not, well known in Hong Kong, including, but not limited to, information concerning the following-

- (a) the degree of knowledge or recognition of the trade mark in the relevant sectors of the public;
- (b) the duration, extent and geographical area of any use of the trade mark;
- (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the trade mark, to the extent that they reflect use or recognition of the trade mark;
- (e) the record of successful enforcement of rights in the trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by competent authorities in foreign jurisdictions; and
- (f) the value associated with the trade mark.

(3) The factors mentioned in subsection (2) are intended to serve as guidelines to assist the Registrar and the court to determine whether the trade mark is well known in Hong Kong. It is not a precondition for reaching that determination that information

be submitted with respect to any of those factors or that equal weight be given to each of them. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not mentioned in subsection (2). Such additional factors may be relevant alone, or in combination with one or more of the factors mentioned in subsection (2).

(4) For the purpose of subsection (2)(a), "relevant sectors of the public" (有關的公眾界別) includes, but is not limited to-

- (a) actual or potential consumers of the type of goods or services to which the trade mark applies;
- (b) persons involved in channels of distribution of the type of goods or services to which the trade mark applies; and
- (c) business circles dealing with the type of goods or services to which the trade mark applies.

(5) 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.

(6) For the purpose of subsection (2)(e), "competent authorities in foreign jurisdictions" (外地主管當局) means administrative, judicial or quasi-judicial authorities in jurisdictions other than Hong Kong that are competent to determine whether a trade mark is a well-known trade mark, or in enforcing the protection of well-known trade marks, in their respective jurisdictions.

2. Factors not required to be established

For the purpose of determining whether a trade mark is well known in Hong Kong, it is not necessary to establish-

- (a) that the trade mark has been used, or has been registered, in Hong Kong;
- (b) that an application for registration of the trade mark has been filed in Hong Kong;
- (c) that the trade mark is well known, or has been registered, in a jurisdiction other than Hong Kong;

- (d) that an application for registration of the trade mark has been filed in a jurisdiction other than Hong Kong; or
- (e) that the trade mark is well known by the public at large in Hong Kong.