

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 301724977AA

A

藝康

B

艺康

**MARKS :
APPLICANT : Ecolab USA Inc.
CLASSES : 9, 10**

STATEMENT OF REASONS FOR DECISION

BACKGROUND

1. On 29 September 2010, Ecolab USA Inc. (the “applicant”) filed an application for registration of a series of two marks shown below (the “Subject Marks”) under the Trade Marks Ordinance (Cap. 559) (the “Ordinance”).

A

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2. Registration of the Subject Marks (Mark A and Mark B) was originally sought in respect of various goods in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 16, 17, 18, 20, 21, 24, 25, 26, 27, 28, 30, 35, 36, 37, 40, 41, 42, 43 and 45 under application no.301724977 (the ‘original application’). During the examination stage, the original application was divided into two, one in respect of the goods in Class 9 and 10 (i.e. the subject application) and the other in respect of the goods in Classes 1, 2, 3, 4, 5, 6, 7, 8, 11, 12, 16, 17, 18, 20, 21, 24, 25, 26, 27, 28, 30, 35, 36, 37, 40, 41, 42, 43 and 45 (application no.301724977AB). Application no.301724977AB has been accepted for registration on 21 May 2013 while the objection pursuant to section 12 of the

Ordinance is maintained against the subject application. The goods sought to be registered under the subject application (the ‘applied for goods’) are set out in Annex A.

3. During the examination stage, an objection was raised against the subject application under section 12 of the Ordinance on the basis of the following earlier registered trade marks (‘Cited Marks’):

Cited Mark 1

Trade mark:



Registration no.: 199906743
Class(es) no(s): 9
Date of registration: 16 November, 1995

Cited Mark 2

Trade mark:



Registration no. 1992B05261
Class(es) no(s): 10
Date of registration: 10 October, 1988

The Cited Marks are owned by Kabushiki Kaisha Nikon (Nikon Corporation). Details of the goods covered by the registration of each of the Cited Marks are set out in Annex B.

4. Despite submissions made on behalf of the applicant, the objection was maintained by the Registrar. The applicant requested a hearing on the registrability of the Subject Marks. The hearing took place before me on 11 February 2014, at which Mr. Philips Wong instructed by Messrs. Leung & Lau appeared on behalf of the applicant. I reserved my decision at the end of the hearing.
5. In support of the subject application, the applicant had filed a statutory declaration dated 13 November 2012 made by Mr. Edward R. Courtney, who is the Senior Trade Mark Attorney of the applicant, (the ‘Statutory Declaration’) with a view to

establishing that there has been an honest concurrent use of the Subject Marks and the Cited Marks for the purpose of section 13(1) of the Ordinance.

DECISION

6. Having carefully considered all the relevant facts, oral and written submissions of Mr. Wong and all the circumstances of the subject application, I decide to allow registration of the Subject Marks in respect of the following goods on a *prima facie* basis (hereinafter referred to collectively as the “Accepted Goods”):

Class 9

“Briefcases specially adapted for holding laptop computers; calculators; cases for mobile phones; computer carrying cases; computerized equipment for monitoring and controlling product dispensers; computer network information system comprising computer hardware, computer software, network hardware and network software all for use in allowing users to remotely access company documents and information; computer software for hygiene management; computer software for use in controlling, monitoring, and testing water treatment systems; digital ph meter; dispensers that count or measure output for use of laundry preparations, cleaning preparations, dishwashing detergents, rinsing agents, sanitation chemicals, vehicle care products and water treatment chemicals; dispensers that count or measure output for use with automatic dishwashing detergents and rinse additives, hand soaps, hand lotions, and shampoos; downloadable asset management software that tracks commercial kitchen equipment inventory and service history; downloadable electronic newsletters in the field of food safety; downloadable electronic newsletters in the field of pest control and elimination; downloadable podcasts in the field of food safety; downloadable software for monitoring and reporting cleaning and sanitation systems; downloadable software for monitoring the performance of and collecting data from clean-in-place sanitation systems; downloadable software for recording and analyzing compliance with pest control programs and tracking pest inspection and elimination services; downloadable software for tracking and generating reports regarding the maintenance and service history, equipment maintenance expenditures, condition and performance of commercial kitchen equipment; egg timers; electrical integrated control and dispensing systems for use in the field of automated cleaning and sanitizing equipment; electronic controllers and parts therefor; electronic indicator for measuring the effectiveness of antimicrobial handwash; electronic insect traps; electronic timers; hydrometers; laundry dryer monitoring equipment; mechanical devices, namely, dispensers of preset portions of fluids, solid granules and powder for dosing purposes, all not for medical use; pre-recorded CDs, DVDs, and video tapes featuring commercial cleaning, disinfecting, personal hygiene and food safety; protective and respiratory face masks not for medical purposes; protective work gloves; safety

goggles; software for creating customized food labels; thermocouple; video recordings featuring commercial car wash training modules and marketing information; backlit signs; highway safety cones; video recordings featuring information regarding pest control and elimination; video recordings featuring training and instructions for use of cleaning and sanitation products; weighing scales.”

7. Subject to compliance with the requirements as stipulated in paragraph 58 below, the Subject Marks, insofar as they are in respect of the Accepted Goods, may proceed to publication.
8. I maintain the objection under section 12(2) and/or 12(3) of the Ordinance in respect of the following:
 - a) goods in Class 9, namely, computer storage devices, namely, flash drives; digital photo frames for displaying digital pictures, video clips, and music; face protection shields; laboratory equipment and supplies, namely, test tubes, beakers, laboratory glassware, burettes, flasks, pipettes, stoppers for laboratory bottles and syringes; sterile personal radiation protection shields; temperature sensors; thermal printers; thermometer; and
 - b) all the applied for goods in Class 10(collectively the “Objected Goods”).
9. The reasons for refusing registration of the Subject Marks in respect of the Objected Goods are set out in the following.

The Ordinance

10. The relative grounds for refusal of an application for registration are contained in section 12 of the Ordinance. The relevant provision under section 12 reads as follows:-

“(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.”*

11. An “earlier trade mark”, as referred to in sections 12(2) and (3) of the Ordinance, is defined in section 5 of the Ordinance. The relevant part under section 5 reads as follows:-

“(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...”*

12. As both Cited Marks have a date of application for registration earlier than that of the Subject Marks, they are “earlier trade marks” in relation to the Subject Marks for the purpose of section 5 of the Ordinance.

13. Moreover, section 7(1) of the Ordinance throws light on how sub-section (c) of sections 12(2) and 12(3) are to be interpreted. Section 7(1) provides that:

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

Sections 12(2) and 12(3) of the Ordinance

14. Sections 12(2) and 12(3) of the Ordinance essentially preclude a mark from registration if the use of it is likely to cause confusion on the part of the public, as a result of it being identical or similar to an earlier trade mark and that it is sought to be registered in respect of goods or services that are the same as or similar to those registered under the earlier trade mark. I must therefore consider whether there is

identity or similarity between the Subject Marks and each of the Cited Marks and between the goods covered by the respective marks which would lead to a likelihood of confusion.

15. The basic principles regarding the assessment of similarity between marks and the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] RPC 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and adopted in *Guccio Gucci SpA v Gucci* [2009] 5 HKLRD 28. These principles are as follows:
 - (a) The likelihood of confusion must be appreciated globally, taking into account all the relevant factors.
 - (b) The matter must be judged through the eyes of the average consumer of the goods in issue, 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, one 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 account the nature of the goods in question and the circumstances in which they are marketed.
 - (d) The visual, aural and conceptual similarities of the trade marks must therefore be assessed by reference to the overall impressions 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 comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his

mind; further the average consumer's level of attention is likely to vary according to the category of goods in question.

- (h) Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*.
- (i) Mere association, in the sense that the later trade mark brings the earlier trade mark to mind, is not sufficient for the purpose of the assessment.
- (j) But the risk that the public might believe that the goods in question come from the same undertaking or economically-linked undertakings, does constitute a likelihood of confusion within the meaning of the section.

Comparison of marks

- 16. Applying the principles set out above, in comparing the marks concerned, I should consider the visual, aural and conceptual similarities of the marks, with reference to the perception of an average consumer of the Objected Goods, who normally views a mark by the overall impression and not by analysing its various details.
- 17. The Objected Goods in Class 9 include computer storage devices, namely flash drives, digital photo frames for displaying digital pictures, video clips and music, thermal printers, some laboratory equipment and supplies and certain protective and measuring equipment. Regarding Class 10, the Objected Goods include goods relating to certain medical devices and products¹ used in a surgical or clinical setting. Goods under Class 9 include generally consumer items as well items for use in a laboratory and as such, the relevant consumers include members of the general purchasing public in Hong Kong as well as certain laboratory personnel. For Class 10, consumers include mainly professionals working in the medical spheres and the public at large (as for example patients). Medical professionals may be expected to be more knowledgeable and observant than the general public.
- 18. Moreover, I have to take into consideration the Subject Marks and the Cited Marks in their normal and fair use in relation to the relevant goods, and the overall impression each of them would give to the relevant consumers of the goods in question, namely the professionals and members of the general public.

¹ See Annex A.

19. The Subject Marks are pure word marks, each of which composes of two Chinese characters i.e. “藝康” (in traditional Chinese characters) for Mark A and “艺康” (in simplified Chinese characters) for Mark B. The two characters are in plain font. There is no stylization, additional device or decoration. The combination of the two characters does not have particular dictionary meaning and the two characters are the only distinctive elements. Mark A and the Cited Marks are identical. Regarding Mark B, the Chinese characters “艺康” are considered substantially similar to the Cited Marks given that the word “艺” in mark B is the simplified equivalent of “藝” in all respects. They have the same pronunciation and the same meaning. In consequence, Mark B is substantially similar to the Cited Marks visually, aurally and conceptually.
20. In his written submissions and at the hearing, Mr. Wong accepted that Mark A and the Cited Marks are identical in all respects for the purpose of section 12(2) of the Ordinance while Mark B and the Cited Marks are substantially similar. There is no dispute about the identity or similarity of the marks concerned.

Comparison of goods

21. In assessing the similarity of the goods concerned, the following factors set out by Jacob J (as he then was) in *British Sugar Plc v James Robertson and Sons Ltd* [1996] R.P.C. 281 (at pages 296-7) should be taken into account:
 - (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-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.
22. It was also held in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, supra (at paragraph 23) that when comparing the similarity of the goods or services in question, all the relevant factors relating to the goods or services, including but not limited to their nature, their end users, their method of use and whether they are in competition with each other or are complementary, should be taken into account.

23. I further note that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (*Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*) (OHIM) Case T-325/06 at paragraph 82).
24. The Cited Marks are registered in respect of various goods in Classes 9 and 10 respectively.

Objected Goods under Class 9

25. Goods covered by Cited Mark 1 include, *inter alia*, “cameras, computer peripheral devices for use in photography” in Class 9. Mr. Wong referred to the Wikipedia webpage <http://en.wikipedia.org/wiki/Peripheral> which states that the term “peripheral” means a device connected to the computer, but not being an integral part of it. He is of the view in the present case, such term should be interpreted in the context of and be confined to use in *photography* and not any other kinds of computer peripherals.
26. The term “computer peripheral devices”, even if it is qualified by “for use in photography”, is a broad and general term. It may include printers, image scanners, graphics cards, flash drives, memory cards etc. It is commonly known that images produced by digital cameras are capable of being stored in some form of memory device e.g. a flash drive which is readable by a computer. Moreover, digital images or photographs could be printed out by printers. “Computer storage devices, namely flash drives” and “thermal printers” in Class 9 of the Objected Goods which are capable of being attached to a computer can clearly be computer peripheral devices and be capable of use related to photography. Target consumers of the goods covered by Cited Mark 1 and the aforesaid Objected Goods are the same i.e. professional photographers as well as the general public. These Objected Goods are considered to be similar to the goods registered under Class 9 of Cited Mark 1.
27. As for “digital photo frames for displaying digital pictures, video clips and music” of the Objected Goods under Class 9, Mr. Wong’s submission is that such item should not be regarded as a computer peripheral device and the use or purpose of a photo frame is very different from that of a camera or other photographic instruments covered by the registered goods under Class 9 of Cited Mark 1. In my view, although “digital photo frames for displaying digital pictures, video clips and music” may not be computer peripherals as such, they are still considered, to a large extent, similar to “cameras, computer peripheral devices for use in photography” in Class 9 goods of Cited Mark 1 in view of the use and users of those goods. Photographs and videos

captured by digital cameras may be displayed in digital photo frames. Digital photo frames and cameras are complementary in nature and as accepted by Mr. Wong, they can be found in the same retail shops which sell electrical and electronic appliances and devices. They are considered to be similar.

28. With regard to “face protection shields; laboratory equipment and supplies, namely, test tubes, beakers, laboratory glassware, burettes, flasks, pipettes, stoppers for laboratory bottles and syringes; sterile personal radiation protection shields; temperature sensors; thermometer”, Mr. Wong opines that these goods are not necessarily “surgical and medical apparatus and instruments” registered under Class 10 of Cited Mark 2. Even accepting that these Objected Goods may not be surgical or medical apparatus and instruments as such, there is no doubt that they are commonly used in clinics, and laboratories including laboratories in hospitals. They may be used for and/or facilitate testing, examination and experimental purposes and are therefore complementary to the “medical apparatus and instruments” and/or “apparatus for use in medical analysis” under Class 10 goods of Cited Mark 2. The users of the said Objected Goods and Class 10 goods under Cited Mark 2 include consumers with professional knowledge or expertise in the healthcare or medical area. These goods would have similar distribution channels. They are considered as similar goods.

Objected Goods under Class 10

29. In Mr. Wong’s written submissions, the Objected Goods under Class 10 are divided into two categories:
- a) those goods which Mr. Wong believes are “disposable items” and “covering items” and which should not be regarded as apparatus and instruments, namely, “Disposable drapes for medical equipment; disposable patient sheets for use in hospitals; disposable plastic medical devices, namely, bags for medical waste, mouth guards, supports for arms, ring cushions, ice bags, and internal administrative systems consisting primarily of bag and pump sets; Medical products, namely, covers, cushions, radiology drapes, surgical drapes, surgical gowns and gloves, collection bags; non-woven wrap to sterilize medical instruments and supplies; surgical lamp handles and disposable sterile covers for surgical lamp handles; surgical microscope drapes and adapter rings for attachment to the drapes” and
 - b) all other goods namely, “electric blankets for medical purposes; electrosurgical smoke evacuator; medical devices, namely, gas evacuators in the nature of air filters and purifiers; medical devices, namely, inflatable surgical boots and sleeves; medical goods, namely, absorbent pads used as surgical sponges for fluid absorption during medical procedures, absorbent surgical instrument table pads used for fluid absorption

during medical procedures, absorbent pads used for fluid absorption during preparation of patient for medical procedures; medical products, namely, containment devices, shields; medical equipment for providing a sterile field; medical products, namely, infection control kits for surgical use, comprising disposable packs containing disposable mop heads, disposable non-sterile linens and drapes for the surgical table, bags for biohazardous waste, non-sterile linens and noninfectious landfill waste; pneumatic compression controller for cyclically inflatable surgical devices; radiation shields sold as an integral component of surgical patient drapes; resuscitation apparatus; surgical instruments for use in orthopedic surgery, namely, trays, orthopedic brushes, orthopedic suction wands, implantable cement restrictors, cement sculpts, sponges and rods for cement restrictors; surgical kits consisting primarily of laryngopharyngeal tube, tube clamp, securing strap and tongue depressor; vacuum splints for medical purposes; wound suction apparatus”.

30. I do not find the classification of goods into categories a) and b) by Mr. Wong based on the nature of these items (i.e. whether they are disposable items or covering items) necessarily accurate. For instance, there appears to be certain disposable items in category b) e.g. medical products, namely, infection control kits for surgical use, comprising disposable packs containing disposable mop heads, disposable non-sterile linens and drapes for the surgical table”. In any event, even assuming that these items are either “disposable items” or “covering items” and such classification is accurate, I am not convinced by Mr. Wong’s argument that the nature of the use of the Objected Goods placed under category a) is very different from the nature of the medical apparatus and instruments under Class 10 goods of Cited Mark 2.
31. I note that the medical devices or products under category a) are used by medical professionals or patients in a clinical setting such as a hospital or clinic. It is not disputable that these goods are used together with and are complementary to “surgical and medical apparatus and instruments” of the cited goods in Class 10. The users of these goods are common to those of Cited Mark 2. These goods are considered similar.
32. For the rest of the Objected Goods under Class 10 in category b), they are medical equipment or products. Given the similar reasoning in the preceding paragraph, they are considered highly similar to surgical and medical apparatus and instruments protected under Class 10 of Cited Mark 2.
33. Taking into account all relevant factors and observations referred to in paragraphs 25 to 32 above, I conclude that the Objected Goods are considerably similar to the goods in Class 9 and/or Class 10 of Cited Marks 1 and 2.

Likelihood of confusion

34. Having compared and considered the identity of Mark A and the Cited Marks and the similarity between Mark B and the Cited Marks and having considered the similarity between the respective goods, I need to examine whether there is a likelihood of confusion. Under sections 12(2) and 12(3) of the Ordinance, a likelihood of confusion refers to confusion on the part of the public as to the trade origin of the goods in question. It is a matter of global appreciation taking into account all relevant factors and judging through the eyes of the average consumer of the Objected Goods.
35. As mentioned above, the relevant consumers of the Objected Goods include members of the general public as well as, photographers, laboratory and medical professionals/ personnel. Whether they are people in the trade or members of the general public, all these customers are deemed to be reasonably well informed and reasonably observant and circumspect. Nonetheless, professional customers are expected to be more knowledgeable and observant than the general public.
36. In the present case, the combination of the Chinese characters of Subject Marks does not have any particular dictionary meaning and is considerably distinctive. Mark A is found to be identical to the Cited Marks and Mark B substantially similar to the Cited Marks visually, aurally and conceptually. Hence, even if a higher level of care and attention can be expected of photographers, the laboratory or medical professionals/ personnel, in view of the identity of Mark A and the Cited Marks and the substantial similarity between Mark B and the Cited Marks, and the considerable similarity between the Objected Goods and the goods protected by the Cited Marks, and bearing in mind the principles laid down in paragraph 15 above and taking into account all relevant factors, I consider that when the Subject Marks are used in relation to the Objected Goods, the relevant consumers, whether members of the general public or the professionals, would be confused into believing that the Objected Goods and the goods covered by each of the Cited Marks originate from the same trade origin or economically linked undertakings. In the premises, the registration of the Subject Marks in respect of the Objected Goods is objectionable under section 12(2) or 12(3) of the Ordinance.

Section 13(1) of the Ordinance

37. I now proceed to consider whether the Subject Marks can nonetheless be accepted for registration by virtue of honest concurrent use under section 13 of the Ordinance. The relevant provision under section 13 reads as follows:-

“(1) Nothing in section 12 (relative grounds for refusal of registration) prevents the registration of a trade mark where the Registrar or the court is satisfied –

- (a) *that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right; or*
- (b) *that by reason of other special circumstances it is proper for the trade mark to be registered.”*

Section 13(1)(a) of the Ordinance

38. As stated in *Re CSS Jewellery Co. Ltd.* [2010] 2 HKLRD 890 at paragraph 35, the assessment of honest concurrent use under section 13(1)(a) of the Ordinance involves the following two-stage determination:

- (1) whether there has been an honest concurrent use of the subject mark and the earlier trade mark;
- (2) if the answer to (1) is in the affirmative, whether after considering all relevant circumstances, including public interest, the Registrar’s discretion should be exercised to accept the application for registration of the mark, despite the fact that the use of the mark in relation to the goods or services in question is likely to cause confusion on the part of the public.

39. The Statutory Declaration filed in support of honest concurrent use includes 23 exhibits i.e. from “Exhibit A” to “Exhibit W”, the contents of which are summarized as follows:

- Exhibit A – Copy Certificate of Incorporation on Change of Name dated 4 November 1988 and Special Resolution dated 17 October 1988
- Exhibit B – Copy Certificate of Approval of the company 艺康化工有限公司 in Mainland China dated 28 February 1987
- Exhibit C – Copy article of Wen Hui Bao dated 2 March 1987 in respect of a news report about the incorporation of 艺康化工有限公司 in Shanghai
- Exhibit D – Copy lease dated 13 May 1987 signed by ECON LAB HOLDINGS INC Hong Kong Branch with the Chinese name 艺康有限公司
- Exhibit E – Copy product catalogues and business name cards (undated)
- Exhibit F – Copy Chinese newsletter named “China Times” containing several articles and copy photographs showing staff of the applicant at the offices and warehouses of the applicant
- Exhibit G – Copy blank sample report forms claimed to be dated 2008

- Exhibit H – Copy photographs of certain sample product packaging dated 13 November 2003 and a sample quotation dated 24 April 2001 issued by Ark System Graphics to ECOLAB Limited
- Exhibit I – Copy sample service reports of divers dates between 2001 and 2003
- Exhibit J – Copy contracts signed by 艺康化工有限公司 relating to supplies of goods and services dated between 1999 and 2003
- Exhibit K – Copy advertising contracts signed with PCCW Media Limited and advertisements placed in yellow pages on divers dates between 2007 and 2009
- Exhibit L – Copy advertisement in Apple Daily claimed to be dated 1 April 2008
- Exhibit M – Copy sample invitation letter dated 28 April 2008 issued by 藝康化工有限公司 and several photographs taken between 1999 and 2001
- Exhibit N – Copy advertisements shown in the publication “China Clean” between 2002 and 2004
- Exhibit O – Copy brochure issued by 艺康(中國) (claimed to be dated 2005)
- Exhibit P – Copy brochure issued by 艺康(中國) dated April 2008
- Exhibit Q – Copy brochure issued by 艺康(中國) (claimed to be dated 2008)
- Exhibit R – Copy newsletter titled 禄港之声 dated September 2009
- Exhibit S – Copy media reports on “ECOLAB” extracted by the National Library of China (国家图书馆社科咨询室)
- Exhibit T – Copy news clippings from 2008 to 2009 and 2011 to 2012
- Exhibit U – Copy awards in Mainland China in 2011 and 2012
- Exhibit V – Partial printouts of the website of Ecolab (China) Investment Co. Ltd., 纳尔科公司 and printouts from checkdomain.com and www.net.cn
- Exhibit W – Printouts of records in relation to registration of the Subject Marks in China

40. I am required to determine whether there has been an honest concurrent use of the Subject Marks at the date of filing of the subject application, i.e. 29 September 2010.

Stage 1

41. To pass the first stage stated in *Re CSS Jewellery Co. Ltd.*, the applicant needs to establish three matters, namely, (a) there had been use of the Subject Marks in respect of the applied for goods in Hong Kong; (b) such use had been made concurrently with the Cited Marks; and (c) such concurrent use had been honestly made.
42. As the Accepted Goods have been allowed for registration on a *prima facie* basis, my observations on the evidence relate to the Objected Goods only.

43. First of all, it is noted that Exhibit E and the 11th to 14th pages of Exhibit F (showing copies of certain photographs of the applicant's staff) are undated. Moreover, the 22nd to 31st pages of Exhibit T (showing copies of certain news clippings), Exhibit U and Exhibit V are dated posterior to the date of the subject application. These exhibits are irrelevant in ascertaining the status of use of the Subject Marks as at the date of application. Exhibit W shows printouts of the records in relation to the registration of the Subject Marks in Mainland China. They are of little value to the subject application for the purpose of establishing a case of honest concurrent use.
44. According to Mr. Courtney, the applicant incorporated its Hong Kong company i.e. ECONOMICS LABORATORY (HONG KONG) LIMITED on 4 April 1975. Since November 1988, the name of this company was changed to ECOLAB LIMITED (藝康化工有限公司) which contains Mark A (paragraph 4 and Exhibit A of the Statutory Declaration). The applicant claimed it first used the Subject Marks in Hong Kong in November 1988 and in China in October 1987 (paragraph 6 of the Statutory Declaration). It was also claimed that the Subject Marks had been first used in Hong Kong on all the applied for goods in Class 9 since 1988 and Class 10 since 2012 (paragraph 7 of the Statutory Declaration).
45. The applicant produced the respective copies of the Certificate of Incorporation of ECOLAB LIMITED (藝康化工有限公司) which is the Hong Kong company of the applicant, the Certificate of Approval of 艺康化工有限公司 which is the company of the applicant in Mainland China, an article in Wen Hui Bao dated 2 March 1987 which features the establishment of 艺康化工有限公司 in Shanghai and a lease dated 13 May 1987 signed in the name of 艺康有限公司 under Exhibits A, B, C and D respectively. According to Mr. Courtney, the aforesaid documents showed that the company name of the companies of the applicant incorporated the Subject Marks. I am of the view that the aforesaid exhibits can only be regarded as evidence showing the incorporation and/or change of name of a business under a name that contains the characters of Mark A or Mark B. They cannot illustrate use of the Subject Marks as trade marks in respect of the Objected Goods.
46. My other observations on the Statutory Declaration and the other exhibits are set out as follows. Leaving aside the undated photographs, Exhibit F consists of a copy of a newsletter named "China Times" which appears to be a newsletter circulated to the applicant's employees. It is noted that the name 藝康 was referred to as a company name but no use of the Subject Marks as trade marks for any of the Objected Goods could be seen. Apart from the aforesaid, some photographs show the applicant's staff as well as the warehouse of 艺康化工有限公司. On one of the photographs on page 7 of Exhibit F, it was stated that "货架上的产品都有 ECOLAB 商标". It is

observed that in all the dated photographs under Exhibit F, none of them shows any use of the Subject Marks as trade marks in respect of any of the Objected Goods.

47. Exhibit G comprises copies of some sample blank report forms which are titled “PEST ELIMINATION SERVICE REPORT”, “SERVICE REPORT (RODENT BAIT STATION)” etc. The Chinese characters 艺康 appear as part of the name of certain entities e.g. “艺康(中國)有害生物防治部” and “艺康服务代表签字”. They fail to show use of the Subject Marks as trade marks and these forms have nothing to do with any of the Objected Goods.
48. Exhibit H shows certain packaging of “oxygen additive for alkaline cleaning”. Contrary to the claim in paragraph 15 of the Statutory Declaration, none of the Subject Marks is legible on such packaging. Moreover, the sample quotation dated 24 April 2001 for the supply of product packaging materials contained in Exhibit H only shows the company name 藝康化工有限公司. No use of the Subject Marks as trade marks for any of the Objected Goods is shown.
49. Apart from references to the company name 藝康化工有限公司 or 艺康化工有限公司 or the said names in their short forms, Exhibits I, J, K, L, M and N do not show any use of the Subject Marks as trade marks for any of the Objected Goods.
50. Exhibits O, P and Q are brochures while Exhibit R is a newsletter titled 禄港之声. These exhibits were stated to be issued by the applicant. The Chinese characters 艺康 appear to refer to the applicant or 艺康(中國) and do not show use as a trade mark in respect of any of the Objected Goods.
51. Exhibits S and T (leaving aside the post-dated materials) contain extracts of Mainland Chinese news reports or articles where the Chinese characters “艺康” could be found. Without exception, the mere appearance of “艺康” does not show or prove use of the Subject Marks as trade marks on any of the Objected Goods.
52. Despite Mr. Courtney’s claim in the Statutory Declaration of the Subject Marks being used for the applied for goods, none of them shows any use of the Subject Marks as trade marks on any of the Objected Goods, whether in Class 9 or Class 10. What the exhibits have in common is that where the Chinese characters “藝康” (Mark A) and/or “艺康” (Mark B) appear in the Exhibits, they merely appear as part of the name of certain companies which relate to the applicant (e.g. 藝康化工有限公司, 艺康化工有限公司, 艺康(中國), 艺康(廣州)化工有限公司, 艺康有限公司 etc). Moreover, the claim to the date of first use of the Subject Marks on all the Objected Goods in Class 10 was 2012 (paragraph 7 of the Statutory Declaration), which is posterior to the date of the subject application. Such statement would mean that no

honest concurrent use could in fact be established in respect of all the Objected Goods under Class 10.

53. At the hearing, Mr. Wong submitted that except for use in certain pest control services shown in the advertisements in Exhibit K (such services are outside the ambit of the Objected Goods) and the undated product catalogues in Exhibit E, he could not locate any use of the Subject Marks on any of the applied for goods in any of the exhibits. However, he invited me to ignore the exhibits but consider the evidence as a whole, in particular the substantial sales and promotion figures over the years as stated in paragraphs 16 and 19 of the Statutory Declaration. Further, Mr. Wong took the view that the evidence adduced by the applicant is unchallenged (as opposed to what could happen in opposition proceedings) and the Registrar should generally assume in favour of the applicant on the evidence given that the owner of the Cited Marks would be able to oppose the subject application if it wishes to do so in due course.

54. Although the applicant's sales in Hong Kong amounted to very impressive figures of over HK\$100 million per annum between 2005 and 2010, it is unclear whether the sales figures relate to the Objected Goods. There is no breakdown of the sales figures in Hong Kong for the applied for goods (including the Objected Goods). The sales figures relating to Mainland China (also without breakdown for any of the applied for goods including the Objected Goods) would not be of assistance in establishing use of the Subject Marks as trade marks on the Objected Goods in Hong Kong and are of no relevance in the present case. The same observation applies to the promotion figures given under paragraph 19 of the Statutory Declaration which stated that the promotion on solutions, goods and services in Hong Kong ranged from some HK\$130,000 to \$600,000 per year between 2005 and 2010. The sales figures and the promotion figures are unable to assist the applicant's case. Before section 13(1)(a) of the Ordinance could be applied, it is the duty of the applicant to prove its case of honest concurrent use. Contrary to the claim of use of the Subject Marks on the applied for goods in the Statutory Declaration, all the exhibits do *not* show any use of the Subject Marks as trade marks on any of the applied for goods (including the Objected Goods). There is simply no legal basis for the Registrar to assume in favour of the applicant on the issue of honest concurrent use when no use of the Subject Marks on any of the Objected Goods could be shown. That being the case, the first limb of the two-stage determination in *Re CSS Jewellery Co. Ltd.* must be answered in the negative. The applicant has failed to establish a case of honest concurrent use of the Subject Marks and the Cited Marks under section 13(1)(a) of the Ordinance in relation to the Objected Goods.

Section 13(1)(b) of the Ordinance

55. Pursuant to section 13(1)(b) of the Ordinance, registration of a trade mark should not be prevented under section 12 of the Ordinance if, by reason of other special circumstances, it is proper for the trade mark to be registered.
56. On the evidence before me, I do not see any special circumstances which would warrant registration of the Subject Marks in respect of the Objected Goods. Accordingly, I do not allow the Subject Marks to be registered in respect of the Objected Goods in accordance with section 13(1)(b) of the Ordinance.

CONCLUSION

57. I have carefully considered all the documents filed by the applicant together with all the oral and written submissions made in respect of the subject application. For the reasons stated above, I find that the Subject Marks in respect of the Objected Goods are precluded from registration under sections 12(2) and 12(3) of the Ordinance. The subject application is accordingly refused in respect of the Objected Goods under section 42(4)(b) of the Ordinance.
58. As I find that registration of the Subject Marks can be accepted in respect of the Accepted Goods as indicated in paragraph 6 above, the subject application in respect of such goods can proceed to publication, provided that the applicant files, on or before **30 July 2014**, a Form T5A to restrict the specification by deleting the Objected Goods. If the applicant fails to do so on or before **30 July 2014**, it will be deemed to have abandoned the subject application.

(Winnie WH NG)
for Registrar of Trade Marks
30 June 2014

Annex A

Class 9

Briefcases specially adapted for holding laptop computers; calculators; cases for mobile phones; computer carrying cases; computerized equipment for monitoring and controlling product dispensers; computer network information system comprising computer hardware, computer software, network hardware and network software all for use in allowing users to remotely access company documents and information; computer software for hygiene management; computer software for use in controlling, monitoring, and testing water treatment systems; computer storage devices, namely, flash drives; digital ph meter; digital photo frames for displaying digital pictures, video clips, and music; dispensers that count or measure output for use of laundry preparations, cleaning preparations, dishwashing detergents, rinsing agents, sanitation chemicals, vehicle care products and water treatment chemicals; dispensers that count or measure output for use with automatic dishwashing detergents and rinse additives, hand soaps, hand lotions, and shampoos; downloadable asset management software that tracks commercial kitchen equipment inventory and service history; downloadable electronic newsletters in the field of food safety; downloadable electronic newsletters in the field of pest control and elimination; downloadable podcasts in the field of food safety; downloadable software for monitoring and reporting cleaning and sanitation systems; downloadable software for monitoring the performance of and collecting data from clean-in-place sanitation systems; downloadable software for recording and analyzing compliance with pest control programs and tracking pest inspection and elimination services; downloadable software for tracking and generating reports regarding the maintenance and service history, equipment maintenance expenditures, condition and performance of commercial kitchen equipment; egg timers; electrical integrated control and dispensing systems for use in the field of automated cleaning and sanitizing equipment; electronic controllers and parts therefor; electronic indicator for measuring the effectiveness of antimicrobial handwash; electronic insect traps; electronic timers; face-protection shields; hydrometers; laboratory equipment and supplies, namely, test tubes, beakers, laboratory glassware, burettes, flasks, pipettes, stoppers for laboratory bottles and syringes; laundry dryer monitoring equipment; mechanical devices, namely, dispensers of preset portions of fluids, solid granules and powder for dosing purposes, all not for medical use; pre-recorded CDs, DVDs, and video tapes featuring commercial cleaning, disinfecting, personal hygiene and food safety; protective and respiratory face masks not for medical purposes; protective work gloves; safety goggles; software for creating customized food labels; sterile personal radiation protection shields; temperature sensors; thermal printers; thermometer; thermocouple; video recordings featuring commercial car wash training modules and marketing information; backlit signs; highway safety cones; video recordings featuring information regarding pest control and elimination; video recordings featuring training and instructions for use of cleaning and sanitation products; weighing scales.

Class 10

Disposable drapes for medical equipment; disposable patient sheets for use in hospitals; disposable plastic medical devices, namely, bags for medical waste, mouth guards, supports for arms, ring cushions, ice bags, and internal administrative systems consisting primarily of bag and pump sets; electric blankets for medical purposes; electrosurgical smoke evacuator;

medical devices, namely, gas evacuators in the nature of air filters and purifiers; medical devices, namely, inflatable surgical boots and sleeves; medical goods, namely, absorbent pads used as surgical sponges for fluid absorption during medical procedures, absorbent surgical instrument table pads used for fluid absorption during medical procedures, absorbent pads used for fluid absorption during preparation of patient for medical procedures; medical products, namely, containment devices, covers, shields, cushions, radiology drapes, surgical drapes, surgical gowns and gloves, collection bags; medical equipment for providing a sterile field; medical products, namely, infection control kits for surgical use, comprising disposable packs containing disposable mop heads, disposable non-sterile linens and drapes for the surgical table, bags for biohazardous waste, non-sterile linens and noninfectious landfill waste; non-woven wrap to sterilize medical instruments and supplies; pneumatic compression controller for cyclically inflatable surgical devices; radiation shields sold as an integral component of surgical patient drapes; resuscitation apparatus; surgical instruments for use in orthopedic surgery, namely, trays, orthopedic brushes, orthopedic suction wands, implantable cement restrictors, cement sculpts, sponges and rods for cement restrictors; surgical kits consisting primarily of laryngopharyngeal tube, tube clamp, securing strap and tongue depressor; surgical lamp handles and disposable sterile covers for surgical lamp handles; surgical microscope drapes and adapter rings for attachment to the drapes; vacuum splints for medical purposes; wound suction apparatus.

Annex B

Cited Mark 1

Trade mark:

藝康

Registration no.:

199906743

Class(es) no(s).:

9

Specification(s):

cameras, photographic lenses, photographic flashlights, computer peripheral devices for use in photography, parts and fittings for photographic apparatus and instruments, binoculars; all included in Class 9.

Cited Mark 2

Trade mark:

藝康

Registration no.

1992B05261

Class(es) no(s).:

10

Specification(s):

surgical and medical apparatus and instruments; incubators for medical purposes, apparatus for use in medical analysis, and ophthalmic instruments; refractometers; parts and fittings included in Class 10 for the aforesaid goods.