

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : 301918756

MARKS :



APPLICANT : Dr. August Oetker Nahrungsmittel KG

CLASS : 30

STATEMENT OF REASONS FOR DECISION

Background

1. On 17 May 2011, Dr. August Oetker Nahrungsmittel KG (“the Applicant”) filed an application for registration of the two marks in series shown below (“the subject marks”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).



2. Registration of the subject marks is sought in respect of “coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; pizza, pasta, including the aforesaid goods mainly filled with sausage and/or meat and/or cheese and/or fruit and/or vegetables and/or mushrooms; snacks, namely baguettes and essentially ready-to-eat toasted sandwiches or bread rolls filled with charcuterie and/or meat products

and cheese and/or fruit and/or vegetables; additives for soups, namely noodles, rice, dumplings, semoline dumplings, roasted bread cubes (croutons), strips of pancake (Celestine), dumplings and minidumplings (included in class 30); seasonings, pastry and confectionery; sauces and sauce preparations in powdered form, salad dressings; including the aforesaid goods, where possible, preserved or frozen; dried garden herbs” in Class 30.

3. At the examination stage, objection was raised by the Registrar of Trade Marks (“the Registrar”) against the subject application under section 12(3) of the Ordinance on the basis of the following registered trade mark (“the cited mark”):-

Cited Mark



Trade Marks :
Registration Number. : 300687259
Date of Registration : 25 July 2006
Specification : Class 30
Coffee, tea, cocoa, sugar, rice, tapioca, sago all included in Class 30.
Class 43
Services for providing food and drink all included in Class 43.
Owner : Hong Kong Food Services Limited

4. By its letter dated 29 August 2012, the agent of the Applicant, Twiggy M H Liu Law Office, requested a hearing on the registrability of the subject marks. The hearing took place before me on 14 November 2013, at which Mr. Poon Siu Bunn, counsel instructed by Twiggy M H Liu Law Office appeared for the Applicant. I reserved my decision at the conclusion of the hearing.
5. A statutory declaration of Liu Mei Ho, Twiggy (“the Liu Declaration”) was filed on the hearing day after the hearing was held to submit materials showing how the

subject marks and the cited mark are actually used respectively as evidence. The Liu Declaration includes exhibit “LMH-1”, which are copies of two letters issued by Twiggy M H Liu Law Office dated 29 February 2012 with pictures showing how the subject marks are actually used enclosed; and exhibit “LMH-2”, which are printouts of the website hosted by the owner of the cited mark and a copy of the pamphlet on which the cited mark is shown. It is however noted that the Liu Declaration is not for the purpose of establishing honest concurrent use of the subject marks and the cited mark under section 13 of the Ordinance. I therefore only have the *prima facie* case to consider.

The Ordinance

6. The objection is raised pursuant to section 12(3) of the Ordinance, which reads as follows:-

“A trade mark shall not be registered if –

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

7. The definition of an “earlier trade mark”, which is referred to in section 12(3) of the Ordinance, is stated in section 5 of the Ordinance. The relevant part is set out below:-

“(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...”*

The date of application for registration of the cited mark is earlier than that of the subject marks. The cited mark therefore constitutes an “earlier trade mark” in relation to the subject marks for the purpose of section 5 of the Ordinance.

8. Another relevant section is section 7(1) of the Ordinance, which throws light on how paragraph (c) of section 12(3) is to be interpreted. It 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.”

Section 12(3) of the Ordinance

9. Section 12(3) of the Ordinance essentially precludes 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 similar to an earlier trade mark and because it is sought to be registered in respect of goods or services the same as or similar to those registered under the earlier trade mark. I thus need to consider whether there are similarities between the cited mark and the subject marks and between the goods and/or services covered by those marks which would lead to a likelihood of confusion.
10. 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] R.P.C. 199, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117 and adopted in *Guccio Gucci SpA v Gucci* [2009] 5 HKLRD 28. These principles are:-
- (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.

The relevant public

11. In the global appreciation of the likelihood of confusion, account should be taken of the average consumer of the goods or services concerned. The goods applied for and the goods in Class 30 protected by the cited mark are coffee, tea and some other general food items, which can be consumed by people in their daily lives. The services for providing food and drink in Class 43 protected by the cited mark are services that can be sought by everyone. As such, the relevant consumers of the goods and services in question are members of the general public in Hong Kong. They are deemed to be reasonably well informed and reasonably observant and circumspect. They are expected to exercise merely an average degree of care and attention in selecting such goods and services.

12. Mr. Poon submitted that it would be overly simplistic to hold that members of the general public in Hong Kong who look for food and beverages would represent the relevant consumers of the goods and/or services offered by the owner of the cited mark and the Applicant. He argued that there is a stark difference in terms of trade channels, food processing and target consumers between the respective businesses of the Applicant and the owner of the cited mark. In particular, he made the following submissions:-
 - (a) The Applicant sells its products under the subject marks on shelves in food stores and supermarkets whilst the cited mark is mostly used in respect of home-delivery services, restaurants or take-away services.
 - (b) The Applicant's products are frozen food items which require microwave heating by the users whilst the owner of the cited mark usually provides cooked and ready-to-eat dishes.
 - (c) The Applicant's products are imported products with obvious German features and the consumers of such products are looking for "foreign recipes" or taste rather than the usual home-delivery pizzas.
 - (d) Hence, there is a real distinction between the actual demographic of the consumers of the Applicant's products and the consumers of the products registered under the cited mark.

13. I am not persuaded by Mr. Poon's submissions. In determining the relevant consumers of the goods and services in question, I need to consider the actual items stated in the specification of goods in the subject application and those stated in the specification of goods and services covered by the registration of the cited mark. The goods applied for as stated in the specification are not limited only to frozen food items, imported food products with German features, products made by "foreign recipes" or of foreign taste, or products sold at food stores and supermarkets. Also, the goods and services registered under the cited mark stated in the specification are not limited to those related to cooked and ready-to-eat dishes, home-delivery and take-away services or restaurants. Since the specification of the goods in the subject application and that of the goods and services registered by the cited mark cover a wide range of goods or services, the trade channels and characteristics of such goods or services are not restricted to those of the goods or services presently provided by the Applicant or the owner of the cited mark. As discussed in paragraph 11 above, considering the specification of the goods applied for and that of the goods and services covered by the cited mark, I find that the relevant consumers are members of the general public in Hong Kong.

Comparison of marks

14. In light of the principles stated in paragraph 10 above, a comparison of the marks concerned has to be based on an overall appreciation of the visual, aural and conceptual similarities of the marks, taking into account the overall impressions given by the marks, and bearing in mind, in particular, their distinctive and dominant components. In comparing the marks concerned, I should consider the perception of the marks in the mind of an average consumer of the goods and services in question, who is a member of the general public in Hong Kong.
15. The subject marks are actually two marks registered as a series. The colours red, blue and yellow are claimed as the elements of Mark A in the series whilst there is no colour claim in respect of Mark B. Each of the subject marks contains the words "Pizza" and "Box", which occupy a major part of each of the subject marks, and an oval device, which is on the top left corner of each of the subject marks. The word "Box" is placed below the word "Pizza" and both words are set against a

slanted square. The two words “Pizza” and “Box” are arranged in a tilted manner. There are devices around the corners of the slanted square, which look as if there are two smaller titled rectangles behind the slanted square, making the whole background against which the two words “Pizza” and “Box” are set look three-dimensional. The oval device contains the simplified Chinese words “欧特家博士” at its centre. There is a profile silhouette below the simplified Chinese words “欧特家博士”. In terms of size, the oval device is much smaller than the two words “Pizza” and “Box” and the whole background against which the two words are set.

16. The cited mark consists of the enlarged word “Pizza-BOX” and the smaller words “pizza”, “pasta”, “ribs” and “chicken” underneath. All the words are set against a square background. The word “Pizza-BOX” is underlined and the four words “pizza”, “pasta”, “ribs” and “chicken” are separated by three dots. The word “Pizza-BOX” is at the centre of the square. Comparing with the four small words, “Pizza-BOX” and the square device are much prominent in size.
17. In his submissions, Mr. Poon referred to the oval device in each of the subject marks as “the Oetker Component” and the words “Pizza Box” together with the background against which the words are set as “the Pizza Box Component”. Mr. Poon claimed that the Oetker Component, which is a mark registered in respect of goods in Class 30, is inherently distinctive and that the Pizza Box Component on its own also possessed some distinctiveness due to the use of the unique font, tilted words and devices and the use of different colours in the Pizza Box Component in each of the subject marks. He claimed that from the materials submitted at the examination stage which show how the subject marks are actually used, it can be seen that the Oetker Component is a component equally dominant as the Pizza Box Component and the Oetker Component thus should not be disregarded.
18. Regarding the cited mark, Mr. Poon argued that the two words “pizza” and “box” in the cited mark alone could not be regarded as constituting the sole dominant and/or identifying features for the reasons that (i) the two words are just ordinary and generic English words which are known and commonly used by the general public; and (ii) the trade practice is that pizzas are packaged in boxes. He drew my attention to his observation that the cited mark is invariably used publicly with its background coloured in light blue and words in white. In addition, he invited me

to afford due weight to the following differences in relation to how the words “pizza” and “box” are used and portrayed in the subject marks and the cited mark:-

- (a) The font style of the words “Pizza” and “Box” in each of the subject marks and that of the words in the cited mark are different.
 - (b) The words “Pizza” and “Box” are placed at two levels and are not joined together by a hyphen in each of the subject marks.
 - (c) The words “Pizza” and “Box” in each of the subject marks are tilted and are not portrayed in an upright fashion.
 - (d) The background against which the words “Pizza” and “Box” are set in each of the subject marks and the background in the cited mark are different.
 - (e) There are a horizontal line underneath the word “Pizza-BOX” and words underneath the line in the cited mark whilst these features are not present in each of the subject marks.
19. Mr. Poon relied on the Registrar’s Decision on the Opposition to the Trade Mark Application No. 300581067 “CIBO Espresso”. It is Mr. Poon’s observation from the Decision that the font of the words, the capitalization of the alphabets and/or the overall presentation of the words in the marks could serve as distinguishing features when making comparison of marks. As such, he argued that judging from the overall impressions created by each of the subject marks and the cited mark respectively, the Oetker Component in each of the subject marks clearly sets the subject marks apart from the cited mark. He disagreed with the examiner’s comment that the Oetker Component is “not obviously noticeable” as he claimed that the colours of the Oetker Component greatly enhance the eye-catchiness of each of the subject marks and contribute significantly to the overall impression projected by each of the subject marks.
20. Although I have no doubt over the distinctiveness of the oval device *per se* in each of the subject marks, I am not convinced by Mr. Poon’s submissions. A mark has to be considered as a whole. Visually, the background consisting of a square and some rectangles in each of the subject marks, when viewed together with the large

words “Pizza Box”, will likely be perceived by the relevant consumers as pizza boxes. When each of the subject marks is used in relation to the goods applied for, especially those packaged in tiny containers, bags or bottles, such as salt or spices, as the oval device is much smaller in size, the relevant consumers may not be able to see the simplified Chinese words inside the oval device clearly. It is likely that they will not remember or pay much attention to the oval device or the simplified Chinese words inside. The overall visual impression projected by each of the subject marks in the mind of the relevant consumers will be dominated by the words “Pizza Box” and the image of pizza boxes since the words and the image of pizza boxes are all prominent in size. When viewing the cited mark, as the square background and “Pizza-BOX” occupy a substantial portion of the cited mark, the relevant consumers will focus on the word “Pizza-BOX” together with the square device, which will also likely be perceived by them as a pizza box. Since the subject marks and the cited mark all contain the words “pizza” and “box” and images of pizza box(es) as dominant components, when looking at the marks as wholes, the relevant consumers will find that there is a considerable degree of visual similarity between each of the subject marks and the cited mark.

21. Although I am aware of the various visual differences suggested by Mr. Poon, I also bear in mind that an average consumer would not analyse the marks in details. The comparison of the marks is not made side by side and the average consumer will only have his/her imperfect recollection to rely upon. The slight visual differences, for instance, the difference in the font style, the existence of a hyphen between the two words “Pizza” and “BOX” in the cited mark, the arrangement of the two words “pizza” and “box” and the existence of a horizontal line in the cited mark, are unlikely to be remembered by an average consumer. In addition, since the cited mark can be used in any colours, the colour claim in respect of Mark A of the subject marks also does not offer much assistance in distinguishing the subject marks from the cited mark.
22. I note Mr. Poon’s submissions about how the subject marks and the cited mark are currently used in respect of the goods of interest to the Applicant and the owner of the cited mark. However, the assessment of similarities between the marks should be made on the basis of the notional and fair use of the marks, instead of the actual usage of the marks as at a particular time. As such, the materials showing how the subject marks and the cited mark are actually used respectively, which are

submitted as exhibits to the Liu Declaration also do not provide much assistance to the Applicant's case.

23. Whilst I take note of the Decision of the Registrar referred to by Mr. Poon, each case should be considered on the basis of its own merits. Features which constitute the distinguishing features in one case does not necessarily become features for distinguishing marks in another case. I also noted that in the said Decision, the word components in the marks concerned are different whilst the words "Pizza Box" and "Pizza-BOX" in this case are closely similar.
24. Aurally, Mr. Poon did not raise any issues over the pronunciation of the words "pizza" and "box" in the subject marks and the cited mark. Since the most prominent word component in the cited mark is "Pizza-BOX", the relevant consumers will call the cited mark as "pizza box". The most conspicuous word components in each of the subject marks are the two words "Pizza" and "Box". The subject marks are thus likely to be referred to by speech as "Pizza Box". Therefore, the subject marks and the cited mark are aurally similar to a significant degree.
25. For conceptual comparison, Mr. Poon argued that the underlying concept of the subject marks and that of the cited mark are considerably different based on an anticipated cursory look of the marks by the members of the public. According to him, the square background of the cited mark would appear to an average consumer as merely serving as a border for the words and one may come under the impression that the word "Pizza-BOX" could indicate the trade name of that particular undertaking. On the other hand, he argued that the overall impression created by each of the subject marks is that there are boxes of pizzas being prepared, processed and/or offered by 欧特家博士.
26. I do not agree with Mr. Poon. As explained above, the simplified Chinese words in the oval device in each of the subject marks are too tiny to be read clearly and remembered by the relevant consumers. On the other hand, the most dominant word component in the cited mark, namely "Pizza-BOX" and that in each of the subject marks, namely "Pizza Box" convey similar messages. The whole background against which the words "Pizza Box" are set in each of the subject marks and the square device in the cited mark, when considered by the relevant

consumers together with the words in the respective marks, will be perceived by them as conveying messages about pizza boxes. I therefore take the view that the subject marks are conceptually similar to the cited mark.

27. Taking into account the visual, aural and conceptual similarities between each of the subject marks and the cited mark and also the differences between them, I come to the view that each of the subject marks and the cited mark will be regarded by the relevant consumers as highly similar.

Comparison of goods and services

28. 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) set out the factors that should be taken into account when considering the similarities between goods and/or services. These factors are:-

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

29. It was also held in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, *supra* (at paragraph 23) that in assessing the similarity of the goods or services concerned, all the relevant factors relating to the goods or services themselves, 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.

30. Mr. Poon submitted that the fact that there may be some overlapping in the goods applied for and the goods covered by the cited mark is by no means conclusive. He argued that a pragmatic approach should be adopted by the Registrar and that the true nature and types of the goods, the mode of sale and the business modus operandi of the Applicant and the owner of the cited mark should be taken into account in the assessment of the similarity between the goods and services concerned.
31. Mr. Poon also claimed that the specification of the goods and services protected by the cited mark is fairly limited. He specifically drew my attention to the fact that “pizza”, “pasta”, “ribs” and/or “chicken”, despite being found in the representation of the cited mark, are not goods in respect of which the cited mark is registered. He also invited me to take note of the fact that “flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice”, which he claimed to be the goods of essential interest to the Applicant, are not covered by the registration of the cited mark.
32. In my view, “coffee, tea, cocoa, sugar, rice, tapioca, sago” among the goods applied for are identical to “coffee, tea, cocoa, sugar, rice, tapioca, sago” covered by the registration of the cited mark.
33. I take the view that “artificial coffee” in the subject application is similar to “coffee” registered under the cited mark since “artificial coffee” is a substitute of “coffee”.
34. “Tapioca” and “sago” are starchy granular substances used in cooking and can be used as a dense glutinous flour. There is a certain degree of similarity among “tapioca”, “sago” and “flour” in their uses and users. “Flour”, “tapioca” and “sago” can usually be found on the same shelf or adjoining shelves in supermarket and food stores. I consider that “flour” in the subject application is similar to “tapioca, sago” in Class 30 covered by the registration of the cited mark.
35. “Yeast, baking-powder” and “tapioca” are all ingredients for cakes and pastries. They are often placed on the same shelf in supermarkets or food stores. “Yeast, baking-powder” are commonly sold in powder form. “Tapioca” can also be sold in powder or granular form. The users, uses and physical nature of these products

are similar. I thus consider that “yeast, baking-powder” among the goods applied for are similar to “tapioca” protected by the cited mark.

36. “Honey”, “treacle” and “sugar” are of similar uses since they can give food a sweet flavour. These products are in competition with each other and are targeted at similar groups of users. The respective trade channels through which these products reach the market are also similar. “Honey, treacle” in the subject application are thus similar to “sugar” in Class 30 registered by the cited mark.
37. Although “sugar” and “salt” are of different tastes, both of them are used to add flavour to food. They are often placed at the same section or adjoining sections in supermarkets. Their physical forms and uses are also similar. I consider that “salt” in the subject application is similar to “sugar” protected by the cited mark.
38. “Rice” is a type of cereals. Both “rice” and “preparations made from cereals” can be consumed as staple food. They are substitutes of each other. I therefore find that “preparations made from cereals” of the goods applied for are similar to “rice” in respect of which the cited mark is registered.
39. “Bread, pastry and confectionery, ices”, “pizza, pasta, including the aforesaid goods mainly filled with sausage and/or meat and/or cheese and/or fruit and/or vegetables and/or mushrooms; snacks, namely baguettes and essentially ready-to-eat toasted sandwiches or bread rolls filled with charcuterie and/or meat products and cheese and/or fruit and/or vegetables; additives for soups, namely noodles, rice, dumplings, semoline dumplings, roasted bread cubes (croutons), strips of pancake (Celestine), dumplings and minidumplings (included in class 30)” are various kinds of food products that are often offered for sale by providers of “services for providing food and drink” at restaurants, cafes or outlets at which such services are provided. There is thus similarity in the trade channels through which the said goods and services reach the market. The target customers of the said goods and services are similar. As such, I find that these goods are similar to “services for providing food and drink” in Class 43 covered by the registration of the cited mark.
40. “Mustard; vinegar, sauces (condiments); spices; ice”, “seasonings”, “sauces and sauce preparations in powdered form, salad dressings” and “dried garden herbs” are processed products that can enhance the flavour or taste of food. It is not

uncommon for merchants offering “services for providing food and drink” to also sell at the venue at which such services are provided these kinds of products, which can be purchased by diners for their household use. The users and distribution channels of these products and services display similarity. These products are considered to be similar to “services for providing food and drink” in Class 43 registered under the cited mark.

41. In the circumstances, I find that the goods in the subject application are either identical or similar to the goods in Class 30 or services in Class 43 in respect of which the cited mark is registered.

Likelihood of confusion

42. Under section 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 or services in question. It is a matter of global appreciation taking into account all relevant factors and judging through the eyes of an average consumer of the goods or services in question.
43. As discussed in paragraph 11 above, the relevant consumers of the goods and services concerned are members of the general public in Hong Kong. They are deemed to be reasonably well informed and reasonably observant and circumspect. Given that the goods and services concerned are not necessarily restricted to expensive goods and services, it is expected that the relevant consumers would not pay particularly great attention in selecting those goods and services.
44. Mr. Poon claimed that it is very unlikely that reasonably well informed, observant and circumspect consumers in Hong Kong would be confused into considering the Applicant’s products as having a trade origin the same as that of the goods and services offered by the owner of the cited mark. He submitted that there would be no likelihood of confusion because:-
 - (a) There are obvious visual and conceptual differences between the subject marks and the cited mark.
 - (b) The cited mark does not have a highly distinctive character (if any) *per se*.

- (c) The cited mark is actually used with its background depicted in light blue colour and the colour of the cited mark constitutes a distinctive feature and such feature is not found in the subject marks.
 - (d) The mere fact that each of the subject marks, which contains the generic words “pizza” and “box”, may bring the cited mark to mind is insufficient to justify a refusal of the subject application.
 - (e) There is no overwhelming overlapping of the goods applied for and the goods and services registered by the cited mark.
 - (f) There are differences in the sales channels and intended consumers of the goods and services concerned.
45. I do not find Mr. Poon’s arguments convincing. I have already found that the subject marks are visually, aurally as well as conceptually similar to the cited mark. Also, the cited mark is as a whole distinctive in respect of the goods and services protected by it. As already stated above, we are only concerned with the notional and fair use of the marks in respect of the goods applied for and the goods and services registered by the cited mark in the present hearing. The current usage of the cited mark is thus not of much assistance. The sales or trade channels and the users of the goods and services concerned have already been discussed and I have already found that the goods applied for in Class 30 are either identical or similar to the goods in Class 30 or services in Class 43 covered by the registration of the cited mark.
46. Taking account of the visual, aural and conceptual similarities between each of the subject marks and the cited mark, and the identity and/or similarities between the goods applied for and the goods and services protected by the cited mark, and also bearing in mind the principles as set out in paragraph 10 above and having regard to all relevant factors, I find that when each of the subject marks is used in relation to the goods applied for, an average consumer would be confused into believing that the goods provided under each of the subject marks and the goods or services provided under the cited mark come from the same undertaking or economically-linked undertakings. I come to the conclusion that there is a real likelihood of

confusion if the subject marks are allowed to co-exist with the cited mark. In such circumstances, the registration of the subject marks is objectionable under section 12(3) of the Ordinance in respect of the goods applied for in Class 30.

Proposal of enlarging the Applicant’s house mark in each of the subject marks

47. With a view to overcoming the objection raised against the subject application, the Applicant proposed to enlarge the Oetker Component in each of the subject marks to enhance the dominance of the said component.
48. The provisions governing amendment of an application for registration of a trade mark at the request of an applicant are found in section 46 of the Ordinance. The relevant provisions are as follows:-

“(1) At the request of the applicant, the Registrar may amend an application for registration of a trade mark as provided in this section.

(2) An application for registration of a trade mark may be amended for the purpose of adding a representation of a registered trade mark to the representation of the trade mark in question but only if all of the following conditions are met—

- (a) at the time the request for amendment is made, the registered trade mark is registered in the name of the applicant;*
- (b) the goods or services for which the registered trade mark is registered are identical or similar to the goods or services covered by the application; and*
- (c) the date of registration of the registered trade mark is earlier than the date of application for registration of the trade mark in question.*

...

(4) An application for registration of a trade mark may be amended in other respects but only for the purpose of correcting—

- (a) the name or address of the applicant;*
- (b) errors of wording or of copying; or*
- (c) obvious mistakes,*

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application...”

49. Since what the Applicant requested is not an addition of a registered trade mark but a variation of the size of a registered trade mark as a component in the representation of each of the subject marks, the Applicant's proposal clearly does not fall within the ambit of section 46(2). Section 46(4) of the Ordinance is also not applicable since the proposed amendment is not for any of the purposes described in sections 46(4)(a), (b) and (c). Therefore, the Applicant's proposal could not be allowed under section 46 of the Ordinance.

Offer of a disclaimer

50. At the examination stage, the Applicant offered to disclaim the right to the exclusive use of the words "Pizza Box" to overcome the citation of the cited mark. The examiner had already indicated to the Applicant that the offer of a disclaimer does not assist in overcoming the citation. At the hearing, Mr. Poon reiterated the Applicant's willingness to disclaim any right to the exclusive use of the words "pizza" and "box" or the phrase "pizza box". He also submitted records of a number of marks which contain the word "pizza" and are registered subject to various disclaimers of the exclusive use of the word "pizza" or phrases containing the word "pizza". He urged the Registrar to follow the precedents of the said registered marks and to allow the registration of the subject marks subject to a disclaimer offered.
51. It is observed by the hearing officer in the case of *PACO/PACO LIFE IN COLOUR Trade Marks* [2000] R.P.C. 451 (at paragraph 63) that an entry of the disclaimer should be regarded as an admission by the proprietor that in any proceedings based upon a registration with a disclaimer, the disclaimed matter is not to be regarded as in itself distinctive of the trade origin of the proprietor's goods or services.
52. In paragraph 5-034 of *Kerly's Laws of Trade Marks and Trade Names (15th edition)*, the following is stated:-

"... But an applicant's offer to disclaim part of his mark will not often assist in overcoming a s.5¹ objection because the Registry considers that an admission made by the applicant cannot of itself be deemed to affect the scope of protection of the earlier mark..."

¹ Similar to section 12 of the Ordinance

53. Even if the subject marks were allowed to be registered subject to a disclaimer, only the rights of the Applicant in later proceedings based upon their registration would be affected. The scope of protection of the cited mark, however, is not affected by the disclaimer. As the present proceedings are proceedings based upon the registration of the cited mark, instead of one based upon the registration of the subject marks, the Applicant's offer of a disclaimer does not assist.

Other matters

54. Mr. Poon claimed that no other commercial entities, including the owner of the cited mark, have come forward to express complaint, objection, warning and/or disapproval in respect of the subject application and that the registrability of the subject application is thus unlikely to be challenged in the future.
55. I do not agree. The Ordinance provides that any person may give notice to the Registrar of opposition to the registration of the subject marks within a period of three months beginning on the date of publication if the subject application were allowed to proceed to publication. As such, the fact that the subject application is not challenged at this stage is not relevant to the assessment of the registrability of the subject marks.

Conclusion

56. I have carefully considered all the documents filed on behalf of the Applicant and all the oral and written submissions made in respect of the subject application. For the reasons stated above, the subject marks are precluded from registration under section 12(3) of the Ordinance in respect of the goods applied for in Class 30. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Winnie Mak
for Registrar of Trade Marks
29 April 2014