

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO. : 300436194**

**MARK** : A 欧科  
B 歐科

**CLASSES : 6, 9, 11, 19, 37, 42**

**APPLICANT : ERCO LEUCHTEN GMBH**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. This is an application of ERCO Leuchten GmbH of Lüdenscheid, Germany (“the Applicant”). On 9 June 2005 (“the application date”), the Applicant applied to register a series of two marks shown below (collectively, “the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

A 欧科  
B 歐科

2. The registration of the subject mark is sought in respect of various goods and services in Classes 6, 9, 11, 19, 37 and 42. At the examination stage, objection was raised against the registration of the subject mark in Classes 9, 11 and 42 under section 12(3) of the Ordinance by virtue of the two registered marks shown below:

(A) Trade Mark Registration No. 300389764 (“the cited mark in Class 11”)

**OUKE 欧科**

(B) Trade Mark Registration No. 300389773 (“the cited mark in Class 9”)

**OUKE 欧科**

(collectively, “the cited marks”). Details of the cited marks are reproduced at Annex A of this statement of reasons for decision. The date of application for registration of each of the cited marks is 22 March 2005, which is earlier than that

of the subject mark. Each of the cited marks therefore constitutes an “earlier trade mark” in relation to the subject mark for the purpose of section 5 of the Ordinance.

3. On 21 June 2007, the Applicant filed evidence in support of the subject application, which comprises a statutory declaration made on 13 June 2007 by the Managing Director of the Applicant, Kay Pawlik (“the Statutory Declaration”), with a view to showing that there has been honest concurrent use of the subject mark and the cited marks.
4. In the letter of 21 June 2007, the Applicant requested a hearing on the registrability of the subject mark. The hearing took place before me on 28 January 2008, at which Ms. Sandra Gibbons of Marks & Clerk appeared for the Applicant. I reserved my decision at the end of the hearing.
5. At the hearing, Ms. Gibbons proposed to amend the specification of services in Classes 37 and 42. Upon the filing of the prescribed form, the services for which registration is sought in Classes 37 and 42 were amended. The full specification of goods and services applied for as amended is reproduced at Annex B of this statement of reasons for decision.
6. Having considered all the relevant facts and evidence, including the amendment of the specification of services in Classes 37 and 42:
  - (a) the objection by virtue of the cited mark in Class 9 is waived; and
  - (b) in respect of:
    - (i) all the goods and services in Classes 6, 19, 37 and 42 applied for; and
    - (ii) the following goods in Class 9:

“software for lighting apparatus and installations, for apparatus to control lighters and for apparatus to regulate lighting; software for lighting apparatus and installations for use by engineers and architects; software for lighting engineering apparatus and installations; apparatus to regulate current drain rails; mechanical signs”

(collectively, the “unobjectionable goods and services”), the objection to the subject application by virtue of the cited mark in Class 11 is waived.

7. Subject to meeting the requirements stipulated in paragraph 55 below, the subject application insofar as it is in respect of the unobjectionable goods and services may proceed to registration.
8. For the rest of this statement of reasons, therefore, I have to consider only the objection under section 12(3) of the Ordinance by virtue of the cited mark in Class 11, and in relation to the subject application only insofar as it is in respect of the following goods and services applied for:
  - (a) the remaining goods in Class 9, namely, “apparatus to control lighting; apparatus to regulate lighting, luminous signs” (“the Class 9 objectionable goods”); and
  - (b) the applied for goods in Class 11 (“the Class 11 objectionable goods”), (collectively, “the objectionable goods”).

## **The Ordinance**

9. Section 12(3) of the Ordinance provides that:-

“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.”

10. Section 7(1) of the Ordinance 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.”

11. Further to section 12, section 13 of the Ordinance states that:-

“(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.”

## Decision

### *Section 12(3) of the Trade Marks Ordinance*

12. Section 12(3) of the Ordinance precludes from registration a mark the use of which is likely to cause confusion on the part of the public, as a result of its being similar to an earlier trade mark and that 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. In the subject application, I must therefore consider whether the similarities between the subject mark and the cited mark in Class 11, and the similarities between the objectionable goods and the goods covered by the cited mark in Class 11 would combine to create a likelihood of confusion. According to section 7(1) of the Ordinance, in assessing the likelihood of confusion, I may take into account all factors relevant in the circumstances.
13. Section 12(3) of the Ordinance is similar in effect to section 5(2) of the UK Trade Marks Act 1994, which implements Article 4(1)(b) of the First Council Directive 89/104 of 21 December 1988 of the Council of the European Communities (“the Council Directive”). In interpreting Article 4(1)(b) of the Council Directive, the European Court of Justice (“ECJ”) has formulated the “global appreciation test”, the principles of which can be found in the ECJ decisions of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.
14. According to these cases:
  - (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel BV v Puma AG*);
  - (b) the matter must be judged through the eyes of the average consumer of the goods or services in question (*Sabel BV v Puma AG*), who is deemed to be reasonably well informed and reasonably observant and circumspect – but who 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 (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*);
  - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*);
  - (d) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*);

- (e) 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 (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
  - (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 (*Sabel BV v Puma AG*);
  - (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Article 4(1)(b) (*Sabel BV v Puma AG*);
  - (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode v Adidas*);
  - (i) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).
15. In my consideration of the likelihood of confusion, I take into account the guidance provided by the ECJ above.

#### Comparison of goods and services

16. In *British Sugar v James Robertson and Sons Ltd* [1996] R.P.C. 281 at 296, after expressing the view that the use of the words “similar to those for which the earlier trade mark is protected” in section 5(2) of the UK Trade Marks Act 1994<sup>1</sup> was “to prevent marks from conflicting not only for their respective actual goods but for a penumbra also”, Mr Justice Jacob (as he then was) found the following factors to be relevant in considering whether or not there is similarity:

- (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;

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<sup>1</sup> Section 5(2) of the UK Trade Marks Act 1994 provides that:-

“(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.”

- (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.
17. It is also stated 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 those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users<sup>2</sup> and their method of use and whether they are in competition with each other or are complementary.
18. The Class 9 objectionable goods are apparatus to control lighting as well as apparatus to regulate lighting and luminous signs. To my mind, “apparatus to control lighting” and “apparatus to regulate lighting and luminous signs” are broad terms which include items such as light switches and light dimmers. Meanwhile, “lamps”, being luminous objects and protected by the cited mark in Class 11, are controlled or regulated by switches or dimmers. Although categorized in different classes, the Class 9 objectionable goods and “lamps” covered by the cited mark in Class 11 are used to serve the same purpose of illumination, serve the same clientele of general consumers who are looking for lights and would likely be sold together at the same retail and wholesale outlets or through the same trade channel. Taking into account all relevant factors relating to the goods concerned including those referred to in paragraphs 16 and 17 above, I find the Class 9 objectionable goods to be similar to “lamps” protected by the cited mark in Class 11.
19. As regards the subject application in Class 11, Ms. Gibbons submitted at the hearing that the Applicant did not sell light bulbs or lights *per se* and thus the Class 11 objectionable goods are not similar to “lamps” covered by the cited mark

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<sup>2</sup> It has been suggested at paragraph 56 of *Sergio Rossi SpA v OHIM* (Case T-169/03, Court of First Instance of the European Communities) that the term “end users” is an incorrect translation, and should be replaced by the term “intended purpose” instead. In any event, the users of the respective goods are among the factors referred to in *British Sugar v James Robertson and Sons Ltd.*, supra.

in Class 11. I do not agree. The Class 11 objectionable goods are “lighting apparatus and parts therefor”, which clearly include “lamps”. In interpreting specifications of goods or services, the terms are to be given their ordinary and natural meaning (*Ofrex v Rapesco* [1963] R.P.C. 169). In this connection, whether the Applicant intends to sell or in fact sells lights is of little relevance. As “lamps” are a type of the applied for “lighting apparatus” and thus the description of “lighting apparatus and parts therefor” clearly includes “lamps”, I find that the Class 11 objectionable goods are items that encompass “lamps”, which are protected by the cited mark in Class 11. Having considered all the relevant factors relating to the goods concerned including those stated in paragraphs 16 and 17 above, I find that the Class 11 objectionable goods are highly similar to and overlap with “lamps” of the cited mark in Class 11.

#### Comparison of marks

20. According to the principles stated in paragraph 14 above, a comparison of the visual, aural and conceptual similarities of the subject mark and the cited mark in Class 11 must be on the basis of the overall impression given by the marks, bearing in mind, in particular, the respective distinctive and dominant components. I have reminded myself that the assessment of the similarity between different marks means more than taking just one component of a composite trade mark and comparing it with another mark. Rather, the comparison must be made by each of the marks in question as a whole (*Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2006] E.T.M.R. 13 at paragraph 29). In this regard, the fact that one component of the marks at issue is identical does not necessarily lead to the conclusion that the marks are similar unless it constitutes the dominant element in the overall impression created by each of those marks, such that all the other components are insignificant (*Matratzen Concord v Office for Harmonization in the Internal Market (Matratzen)* [2003] E.T.M.R. 31, confirmed on appeal to the ECJ in *Matratzen* (Case C-3/03P) [2004] E.C.R. I-3657, and followed by *Gfk v Office for Harmonization in the Internal Market* (Case T-135/04) [2006] E.T.M.R. 58 at paragraph 59).
21. In comparing the marks, I shall consider the perception of the marks in the mind of the average consumer of the goods and services in question. As the goods protected by the cited mark in Class 11 and the objectionable goods are all general merchandise which are required in everyday life, the relevant consumers of these goods are members of the general public in Hong Kong, who are looking for lights. While the relevant consumers are deemed to be reasonably well-informed, circumspect and observant, it is unlikely that they would analyse the various

details of a mark when they purchase the respective goods.

22. The subject mark consists of two Chinese characters “歐科” or two simplified Chinese characters “欧科” in plain form. The distinctiveness of the subject mark subsists in the combination of the characters “歐科” or “欧科” as a whole.
23. The cited mark in Class 11 comprises the same simplified Chinese characters “欧科”, which are placed after the English letters “OUKE”.
24. Visually, the subject mark and the cited mark in Class 11 share the identical (“欧科”) or highly similar (“歐科”) words. The difference lies in the English letters “OUKE” in the cited mark in Class 11. While the subject mark is not identical to the cited mark in Class 11, their Chinese elements are identical or highly similar. I find that there is a certain degree of similarity between the subject mark and the cited mark in Class 11 visually.
25. Phonetically, the Putonghua pronunciation of “欧” is [ou] and “科” is [ke]<sup>3</sup>. The combination of the characters “欧科” is thus pronounced as “ou ke”. As the subject mark shares the same combination of Chinese characters with the cited mark in Class 11, the pronunciation of the Chinese characters of both marks is identical. “OUKE” in the cited mark in Class 11 is simply the English phonetic equivalence of “欧科”. As a whole, the cited mark in Class 11 would be pronounced as “ou ke ou ke”, which is a repetition of “ou ke”, the pronunciation of the subject mark. I therefore find that, in terms of phonetic comparison, the subject mark is highly similar to the cited mark in Class 11.
26. Conceptually, while “OUKE” can be pronounced in different ways, depending on accent and mute, “欧科” carries a more definite pronunciation of “ou ke”. Upon seeing the cited mark in Class 11 as a whole, “OUKE” would be perceived as the English phonetic equivalence of “欧科”. In the premises, “OUKE” merely reinforces the concept of “欧科” in the cited mark in Class 11. In relation to the goods for which the cited mark in Class 11 is registered, such as “lamps”, “欧科” as a whole does not have any descriptive meaning. To my mind, the overall impression created by the cited mark in Class 11 is one of “欧科”, which forms the dominant component of the cited mark in Class 11. As regards the subject mark, the distinctive element subsists in the combination of the two Chinese characters “歐科” or “欧科”. In the circumstances, the overall impression of the subject mark and the cited mark in Class 11 left in the mind of the average

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<sup>3</sup> *Lin Yu Tang's Chinese-English Dictionary of Modern Usage*

consumers is the same and peculiar idea of “歐科” or “欧科”. I find the two marks to be highly similar conceptually.

27. Upon considering the visual, phonetic and conceptual similarities as well as the differences between the subject mark and the cited mark in Class 11, I consider that the relevant consumers, who do not normally analyse marks in great details but would rely on the imperfect recollection of the marks, would refer to and remember each of the subject mark and the cited mark in Class 11 as “歐科” or “欧科”. I find the subject mark and the cited mark in Class 11 to be substantially similar.

#### Likelihood of confusion

28. Confusion in the context of section 12(3) of the Ordinance refers to confusion on the part of the public as to origin of the goods in question. To decide on the matter, I have to assess the likelihood of confusion globally, taking into account all relevant factors, and judging the matter through the eyes of the relevant consumers of the goods in question.
29. The goods protected by the cited mark in Class 11 and the objectionable goods are available or sold through a wide variety of outlets and at a wide range of prices. While these goods are not necessarily expensive, they are essentially related to electrical apparatus and the relevant consumers would exercise a reasonable degree of care when purchasing the goods in question. Having regard to the visual, aural and conceptual similarities and differences between the subject mark and the cited mark in Class 11 as analyzed in paragraphs 24 to 27 above, the similarity in and the overlapping of the relevant goods designated by the marks, bearing in mind the principles set out in paragraph 14 above and taking all relevant factors into account, I consider that when the subject mark is used in relation to the objectionable goods, the average consumers would be confused into believing that the objectionable goods provided under the subject mark and “lamps” protected by the cited mark in Class 11 come from the same or economically linked undertakings. In the premises, the registration of the subject mark in respect of the objectionable goods is objectionable under section 12(3) of the Ordinance by virtue of the cited mark in Class 11 on a *prima facie* basis.

*Section 13(1)(a) of the Trade Marks Ordinance*

30. Although the registration of the subject mark in respect of the objectionable goods is objectionable under section 12(3) of the Ordinance, registration should nonetheless be allowed if I am satisfied that there has been honest concurrent use or there are other special circumstances justifying the registration of the subject mark under section 13 of the Ordinance.
31. With reference to the Statutory Declaration, Ms. Gibbons asserted that, *inter alia*, there had been honest concurrent use of the subject mark and the cited mark in Class 11 under section 13(1)(a) of the Ordinance.
32. The following materials are exhibited to the Statutory Declaration:-
  - Exhibit A --- Copies of the Applicant's brochure in both English and Chinese, dated October 2006 and December 2006 respectively, and pages printed from the Internet in March 2007 showing photographs of what are claimed to be some of the "Applicant's projects" in different countries.
  - Exhibit B --- A copy of an extract from the German Trade Mark Register in respect of the registration of the mark "ERCO LEUCHTEN" in the name of the Applicant in Class 11.
  - Exhibit C --- Copies of registration certificates of the mark "欧科" in Classes 9 and 11 in the name of the Applicant in other jurisdictions.
  - Exhibit D --- Copies of the Applicant's brochures dated 1986 and 1991 in German, showing some photographs of Hong Kong structures, and a copy of the Applicant's undated brochure in Chinese.
  - Exhibit E --- Photocopies of the Applicant's undated brochures in Chinese (which are essentially the replicas of the one exhibited to Exhibit D) and a catalogue in Chinese, dated November 2004.
  - Exhibit F --- Copies of invoices dated 1996 and 1998 for translation into Chinese and a copy of "Print Order Agreement" dated 26 November 2004 made between the Applicant and a company organized and existing under the laws of the People's Republic of China.

33. For the purpose of assessing honest concurrent use under section 13(1)(a) of the Ordinance, I must consider the use of the subject mark in Hong Kong by the Applicant or with its consent prior to the application date. The main factors which should be taken into account were laid down by Lord Tomlin in *Re Pirie's Application* (1933) 50 R.P.C. 147 at 159. Briefly, these matters are:
- (a) the extent of use in time and quantity and the area of the trade;
  - (b) the degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;
  - (c) the honesty of the concurrent use;
  - (d) whether any instances of confusion have in fact been proved; and
  - (e) the relative inconvenience which would be caused if the mark were registered.
34. While I shall consider these five factors when assessing whether there is honest concurrent use of the subject mark and the cited mark in Class 11 during the relevant period, I bear in mind that these matters are not exhaustive and in exercising my discretion, “all relevant circumstances ought to be considered” (*Re Electrix Ltd's Application* [1957] R.P.C. 369 at 379).

Extent of use in time and quantity and the area of the trade

35. Turnover figures in relation to the sale of the Applicant’s “goods and services” in Hong Kong under the subject mark from 2000 to 2006 are provided in paragraph 10 of the Statutory Declaration. However, “goods and services” are not defined in the Statutory Declaration and there is no breakdown of the turnover figures as between different classes of goods and services for which registration is sought. It is thus not entirely clear whether these “goods and services” include the objectionable goods or what volume of sales of the objectionable goods is attributable to the use of the subject mark.
36. It is claimed in the Statutory Declaration that the subject mark “欧科” was created by the Applicant in 1994 to represent the Applicant’s name “ERCO” in various Asia-Pacific regions including Hong Kong and the subject mark was first used by the Applicant in Hong Kong in 1995. None of the exhibits, however, shows that the subject mark has been used in as early as 1994 or 1995, and there is very little evidence which shows use of the subject mark in Hong Kong by the Applicant in relation to the objectionable goods prior to the application date.

37. In materials where use of the subject mark can be seen, Exhibit A comprises of materials that are produced after the application date and Exhibit D consists of materials that are either undated or in the German language and therefore do not appear to be catered for the Hong Kong market. These exhibits therefore do not show use of the subject mark in Hong Kong in relation to the objectionable goods before the application date.
38. Apart from Exhibits A and D, the subject mark can also be seen in Exhibit E, which comprises copies of seemingly three catalogues. While two of these copies of catalogues are undated, the remaining one bears “11/2004” at the back cover, indicating that it was printed and available around seven (7) months prior to the application date. This catalogue is in simplified Chinese and purportedly shows that certain goods and services were offered under the subject mark. It contains numerous photographs depicting structures and events at different places, including those outside Hong Kong. Although there are accreditations regarding the design or architectural design of the structures next to some of the photographs, the Applicant is not mentioned, and it is not entirely clear whether any of these photographs or the designs that they depict relates to the Applicant. In this catalogue, the Applicant claims to sell “lighting apparatus” (灯具). It is, however, not clear to whom in Hong Kong this catalogue was distributed, how frequently it was distributed or what the scale of distribution was prior to the application date.
39. The invoice for translation services, the documents in German and the “Print Order Agreement” in Exhibit F do not even show the subject mark. I am not convinced by Ms. Gibbons’ submission that the materials in Exhibit F show there being “significant number of brochures” of the Applicant bearing the subject mark supplied for distribution in Hong Kong. At the outset, nowhere in these documents is the subject mark mentioned. It is not clear whether the subject mark was indeed printed onto the brochures. Moreover, merely having the brochures translated and printed does not equal to use of the subject mark in respect of the objectionable goods or distribution of the brochures in Hong Kong to the relevant consumers.
40. In spite of the turnover claimed in the Statutory Declaration, there is not a single invoice showing that any of the objectionable goods has been sold under the subject mark in Hong Kong, and there is nothing to show the use of the subject mark in any advertising or promotional activities in Hong Kong in respect of the objectionable goods. Reading the Statutory Declaration and the exhibits together, I find that evidence of use of the subject mark in respect of the objectionable

goods is minimal at most.

41. Regarding the lack of documentary proof of sales turnover and promotional materials, Ms. Gibbons explained that owing to the nature of the Applicant's business, such proof was hard to obtain.
42. While samples of invoices are materials that can verify the sales of goods, they are by no means the only type of evidence that can show use of the mark in respect of the objectionable goods in question. What type of materials to be filed in support of a claim of honest concurrent use is a matter for the Applicant to decide. In the subject application, there is simply no evidence filed, other than the bare assertions in the Statutory Declaration, to substantiate the claim of first use of the subject mark in Hong Kong and the volume of sales under the subject mark. Having considered all the relevant facts, there is simply no evidence to show the extent of use of the subject mark in Hong Kong.
43. I should also mention that while Exhibit C shows the subject mark, they are in fact registrations of the subject mark in Classes 9 and 11 in other jurisdictions. I do not find them to be of any relevance in establishing use of the subject mark in Hong Kong. Mere registrations do not mean that the subject mark has in fact been used, let alone in Hong Kong. The registration certificates produced in Exhibit C do not show whether the subject mark was met with the same citation in these jurisdictions. Ultimately, trademark rights are territorial. Where an objection is raised under section 12(3), the Registrar needs to be satisfied that there has been honest concurrent use of the subject mark and the cited mark in Class 11 in Hong Kong before he could allow registration of the subject mark in Hong Kong. Meanwhile, Exhibit B merely shows the registration of "ARCA" in Class 11 in the name of the Applicant in Germany. Suffice it to say that the mark shown in Exhibit B is not at all similar to the subject mark. In the circumstances, I find the overseas registrations of the subject mark to be of no assistance to the Applicant in establishing honest concurrent use in Hong Kong or showing the extent of use of the subject mark in Hong Kong prior to the application date.

#### The degree of confusion likely to ensue

44. The degree of confusion is to a large extent indicative of the measure of public inconvenience (*Re Borsalini Trade Mark* [1993] 1 HKC 587). If public inconvenience is unlikely, there would be no good reason to refuse the application for registration of the mark in question.

45. In the present case, the respective marks share the same characters “欧科” as their distinctive element. For the reasons stated in paragraphs 18, 19, 24 to 27 above, I have found that the respective marks are substantially similar, so are the objectionable goods and “lamps” protected by the cited mark in Class 11. I am of the view that the likelihood of confusion and the measure of public inconvenience are high. That is to say, upon seeing the respective marks being used on the goods in question, the relevant consumers would highly likely be confused and perceive that the respective goods originate from the same or economically linked undertakings.

#### Honesty of the concurrent use

46. As there is no evidence which shows concurrent use of the subject mark with the cited mark in Class 11 in Hong Kong, there is no issue of the honesty of the concurrent use of the subject mark.

#### Instances of confusion and the relative inconvenience

47. It is asserted in the Statutory Declaration that the Applicant is not aware of any instances of confusion or inconvenience caused to the public arising from the concurrent use of the subject mark.
48. As I have found that use of the subject mark in respect of the objectionable goods in Hong Kong during the relevant period to be minimal, the lack of reported instances of confusion may be owing to the lack of substantive use of the subject mark rather than because the relevant consumers could distinguish the subject mark from the cited mark in Class 11. In the circumstances, the lack of reported instances of confusion would not justify the registration of a mark which is otherwise objectionable.
49. As regards the relative inconvenience which would be caused if the subject mark is registered, allowing a mark highly similar to the cited mark in Class 11 to co-exist is likely to cause confusion on the part of the public regarding the trade origin of the relevant goods. Thus, the co-existence will prejudice the owner of the cited mark in Class 11 as well as the relevant consumers. On the contrary, there is no evidence before me indicating that refusing registration of the subject mark will prejudice the Applicant, particularly when the evidence does not show that the Applicant has used the subject mark in Hong Kong prior to the application date to any significant extent.

50. Having considered the totality of the evidence filed and all the relevant circumstances, I am not satisfied that there had been honest concurrent use of the subject mark with the cited mark in Class 11 in respect of the objectionable goods.

*Section 13(1)(b) of the Trade Marks Ordinance*

51. In the alternative, Ms. Gibbons submitted that it is proper to register the subject mark on the ground that there are “special circumstances”. According to Ms. Gibbons, even if the evidence filed in support of the subject application does not establish honest concurrent use for the purpose of section 13(1)(a) of the Ordinance, the use of the subject mark in Hong Kong prior to the registration of the cited mark in Class 11 constitutes “special circumstances”.
52. The only piece of evidence that shows the subject mark and bears a date prior to the registration of the cited mark in Class 11 is the catalogue printed in November 2004 produced at Exhibit E. As pointed out in paragraph 38 above, it is unclear how widely, to whom and when the catalogue has been distributed in Hong Kong, if at all. I do not consider that this catalogue establishes any “special circumstances” which would justify my exercise of discretion under section 13(1)(b) of the Ordinance.
53. As I have found the subject mark to be objectionable under section 12(3), and the Applicant has not made out a case for registration under section 13, I have no discretion to accept the subject application.

**Conclusion**

54. In this decision, I have considered all documents filed by the Applicant together with all oral and written submissions made in respect of the subject application. For the reasons given, registration for the subject mark in respect of the objectionable goods is precluded by section 12(3) of the Ordinance by virtue of the cited mark in Class 11. The subject application in respect of the objectionable goods is accordingly refused under section 42(2)(b) of the Ordinance.
55. As I have indicated in paragraph 6 above, the subject application in respect of the unobjectionable goods and services may proceed to publication, provided that the Applicant files, on or before **25 August 2008**, an amendment on Form T5A to amend the specification by restricting the application to the unobjectionable goods and services only. If the Applicant fails to do so on or before 25 August 2008,

the subject application in respect of these goods and services is deemed to be abandoned.

Margaret K.W. Yu  
for Registrar of Trade Marks  
23 July 2008

**(A) The cited mark in Class 11**

Trade Mark no. : 300389764

Trade Mark : The logo consists of the word "OUKE" in a bold, black, sans-serif font, followed by the Chinese characters "欧科" in a similar style. The "O" and "U" are connected, and the "K" and "E" are also connected.

Owner's name : 胡秋雷

Specification of goods : Class No. 11

燈，乙炔發生器，油燈，水果烘烤器，電炊具，烤箱，電力煮咖啡機，電熱壺，煤氣灶，電熱水瓶，烤麵包器，微波爐(廚房用具)，熱水器，電壓力鍋(高壓鍋)，電油炸器，電熱製酸奶器，冷凍設備和機器，冰箱，加熱裝置，家用乾衣機(電烘乾)，空氣淨化裝置和機器，水龍頭，廚房用抽油煙機，風扇(空氣調節)，衛生間用手乾燥器，浴室裝置，消毒設備，電暖器，氣體打火機。

(Lamps , Acetylene generators , Oil lamps , Fruit roasters , Electric cooking utensils , Bakers' ovens , Electric coffee machines , Electric kettles , Burners (Gas —) , Hot water bottles , Bread toasters , Microwave ovens [cooking apparatus] , Water heaters , Autoclaves [electric pressure cookers] , Electric deep fryers , Electric appliances for making yogurt , Refrigerating apparatus and machines , Refrigerators , Heating apparatus , Electric laundry dryer , Air purifying apparatus and machines , Hydrants , Extractor hoods for kitchens , Fans [air-conditioning] , Hand drying apparatus for washrooms , Bath fittings , Disinfectant apparatus , Electric radiators , Gas lighters )<sup>4</sup>

Date of registration : 22 March, 2005

<sup>4</sup> Translations of the specification of goods are based on the “International Classification of Goods and Services for the purposes of the registration of marks (NICE Classification), 9<sup>th</sup> Edition” of the World Intellectual Property Organization and its corresponding Chinese version by the Trademark Office of the State Administration for Industry and Commerce of the People’s Republic of China (中華人民共和國國家工商行政管理總局商標局).

**(B) The cited mark in Class 9**

Trade Mark no. : 300389773

Trade Mark : **OUKE 欧科**

Owner's name : 胡秋雷

Specification of goods : Class No. 9

計算機，電子字典，筆記本電腦，計數器，傳真機，秤，尺（量器），信號燈，天線，錄音機，收音機，攝像機，電視機，氣量計，電線，變壓器（電），工業操作遙控電器設備，電鍍設備，滅火器，電焊設備，個人用防事故裝置，電子防盜設備，眼鏡（光學），照明用電池，照蛋器，錄像機，鼠標（數據處理設備），掃描儀（數據處理設備），手提電話，擴音器。

(Computers , Electronic pocket translators , Notebook computers , Counters , Facsimile machines , Scales , Rulers [measuring instruments] , Signal lanterns , Aerials , Tape recorders , Radios , Camcorders , Television apparatus , Aerometers , Electric Wires , Converters [electric] , Electric installations for the remote control of industrial operations , Electroplating apparatus , Extinguishers , Electric welding apparatus , Protection devices for personal use against accidents , Electric Theft prevention installations , Spectacles [optics] , Batteries for lighting , Egg-candlers , Video recorders , Mouse [data processing equipment] , Scanners [data processing equipment] , Portable telephones , Loudspeakers)<sup>5</sup>

Date of registration : 22 March, 2005

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<sup>5</sup> Translations of the specification of goods are based on the “International Classification of Goods and Services for the purposes of the registration of marks (NICE Classification), 9<sup>th</sup> Edition” of the World Intellectual Property Organization and its corresponding Chinese version by the Trademark Office of the State Administration for Industry and Commerce of the People’s Republic of China (中華人民共和國國家工商行政管理總局商標局).

**Class 6**

Metal building materials; building ceilings of metal; louvered ceilings of metal; signboards of metal; road signs of metal.

**Class 9**

Software for lighting apparatus and installations, for apparatus to control lighters and for apparatus to regulate lighting; software for lighting apparatus and installations for use by engineers and architects; software for lighting engineering apparatus and installations; apparatus to control lighting; apparatus to regulate lighting, current drain rails, luminous signs; mechanical signs.

**Class 11**

Lighting apparatus and parts therefor.

**Class 19**

Non-metallic signs and road signs.

**Class 37**

Maintenance of lighting engineering apparatus and installations for commercial and public structures such as office blocks, industrial buildings, airports, hotels, restaurants, shopping centres.

**Class 42**

Planning (design) of lighting engineering installations; conducting of light calculations; computerized simulation of lighting situations; design of lighting engineering installations; creating software for data processing, in particular in the field of lighting engineering; all the foregoing services relating to commercial and public structures such as office blocks, industrial buildings, airports, hotels, restaurants, shopping centres.