

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

**OPPOSITION TO TRADE MARK APPLICATION NO. 301792936**

**MARK:** KIRRA  
**CLASS:** 18 & 25  
**APPLICANT:** Pacific Sunwear of California, Inc.  
**OPPONENT:** UPCOMING TM S.A.

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 17 December 2010, Pacific Sunwear of California, Inc. (“Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for registration of the mark below (“subject application”) -

KIRRA (“suit mark”)

in respect of “*Handbags, tote bags, beach bags, messenger bags, travelling bags, backpacks, fanny packs, coin purses, purses, wallets, clutches and satchels*” in Class 18 and “*Clothing, footwear, headgear*” in Class 25 (“applied for goods”).

2. Particulars of the subject application were published on 29 April 2011. On 28 July 2011, UPCOMING TM S.A. (“Upcoming”) filed a Notice of Opposition with Grounds of Opposition (“subject proceedings”). On 27 October 2011, the Applicant filed a Counter-statement.

3. On 10 June 2016, with leave from the Registrar, Arabella Pte. Ltd. (“Opponent”) substituted Upcoming as the Opponent in the subject proceedings. The Opponent has also undertaken to be bound by the pleadings and evidence filed

by Upcoming herein.

4. The Opponent's evidence consisted of -

- (a) a statutory declaration of Francois Bloch made on 24 October 2012 ("FB's SD") with exhibits "FB-1" to "FB-17"; and
- (b) a statutory declaration of Ng Sau Wah made on 17 June 2016 ("NSW's SD") with exhibits "NSW-1" to "NSW-4" in response to the Applicant's evidence.


5. The Applicant's evidence was a statutory declaration of Craig E. Gosselin made on 24 July 2014 ("CEG's SD") with exhibits "SD-1" to "SD-5".

6. The hearing of the subject proceedings took place before me on 7 December 2016 ("hearing"). The Applicant, represented by Ella Cheong (Hong Kong) Limited, did not file a Form T12 to indicate its intention to appear. Mr Douglas Clark of Counsel, instructed by Messrs Reed Smith Richards Butler, appeared for the Opponent ("Mr Clark"). I reserved my decision at the conclusion of the hearing.

### **Grounds of opposition**

7. The Opponent, incorporated in Luxembourg, was the owner of the trade mark "KILLAH" ("Opponent's mark") in relation to a wide range of products falling within but not limited to Classes 9, 18 and/or 25. In Hong Kong, the Opponent was the owner of the following four registered trade marks -

Trade mark	Date applied/ registered	Goods
300497386	20.9.2005	<u>Class 25</u> Clothing, footwear, headgear.

<b>KILLAH</b>		
199915398 	20.11.1998	<u>Class 25</u> Clothing, footwear, headgear.
300293012 <b>KILLAH</b>	27.9.2004	<u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
300975547 <b>KILLAH</b>	18.10.2007	<u>Class 9</u> Sunglasses and eyeglasses; parts and fittings for all the aforesaid goods; optical apparatus; optical goods, spectacles, spectacle frames, spectacle cases; parts and fittings for all the aforesaid goods.

8. The Opponent was said to have engaged in manufacturing, wholesaling, distributing, marketing, selling and/or providing a wide range of products as listed in the preceding paragraph under and/or by reference to the Opponent's mark ("Opponent's goods") in many countries and places worldwide including Hong Kong.

9. It was the Opponent's case that by virtue of the substantial and extensive use of the Opponent's mark both locally and internationally, including advertising and sales of goods under and/or by reference to the same over a long period of time, the Opponent's mark has acquired substantial goodwill and reputation throughout the world. Further, a wide range of products notably in Class 18 and/or Class 25 sold and provided under the Opponent's mark has become distinctive of the Opponent's business and the said mark has come to be identified exclusively with the business of the Opponent and the goods it sold among the relevant trade and the public.

10. At the hearing, of the grounds pleaded in the Grounds of Opposition, based on alleged close resemblance between the suit mark and the Opponent's mark and between the applied for goods and the Opponent's goods, Mr Clark advanced the grounds under the following sections of the Ordinance -

- (a) section 12(3);
- (b) section 12(4); and
- (c) section 12(5).

He indicated that the Opponent did not intend to pursue the section 11(5)(b) ground of opposition.

### **Counter-statement**

11. The Applicant was founded in 1980 and has since been a leading speciality retailer rooted in the action sports, fashion and music influences of the California lifestyle. The Applicant claimed to be selling a combination of branded and propriety casual apparel, accessories and footwear which were designed to appeal to teens and young adults. Apart from operating over 800 stores across United States and Puerto Rico, the Applicant also shipped internationally via its website. The Applicant's products of variety in the fashion and accessories industry covered goods in Classes 3, 14, 18 and/or 25.

12. The brand under the suit mark was said to have been launched in 1994 in the US and since then in a long list of countries and places including Hong Kong, and used extensively and continuously by the Applicant and/or its subsidiaries, affiliated or associated companies, distributors and retailers in relation to goods in the aforesaid classes.

13. The Applicant said its goods were marketed worldwide through its website and on social media where the suit mark has attained high exposure. The Applicant's sales of goods under the suit mark were said to be substantial

whereas the suit mark was the subject of many trade mark applications and registrations in numerous countries throughout the world. Due to extensive and continuous marketing, substantial sales and comprehensive trade mark protection measure, the suit mark has acquired reputation and goodwill both locally and overseas and was undoubtedly distinctive of and identified with the Applicant and its goods.

14. By averring that the suit mark was distinguishable from the Opponent's mark in all aspects, the Applicant denied all grounds of opposition raised in the subject proceedings and prayed that they be dismissed with costs.

### **Relevant date**

15. The relevant date for considering the subject proceedings is 17 December 2010, the date of the subject application ("the relevant date").

### **Opponent's evidence**

16. According to Francois Bloch ("Mr Bloch"), an attorney of the trade mark agent for the Opponent, the Opponent's mark was first designed and used by the Opponent's predecessor, Fronsac Investment S.A. since 1998. The Opponent and its predecessor were companies operating within the Sixty Spa group of companies ("Sixty group") which also created other brands of clothing such as "Miss Sixty". The Opponent's mark and the brand in that name were in fact an extension of the Miss Sixty brand which was predominantly aimed at ladies' fashion wear. Contained in Exhibit "FB-1" were copy materials downloaded from two websites setting out background information about the Sixty group and that the Opponent's KILLAH brand of fashion was first presented in 1998. One copy downloaded page with a date of 27 July 2009 in that exhibit displaying the word "KILLAH" contained the particulars of five retail stores in Hong Kong. Another copy downloaded page with a date of 17 January 2010 showing "KILLAH GIFTS" on the product bar

displayed at the top of the webpage contained the particulars of three retail stores in Hong Kong. By way of exhibits “FB-2” to “FB-10” which were copy product catalogues for the “KILLAH” brand for the Fall/Winter 2001/02 right through to Fall/Winter 2009/2010, Mr Bloch sought to demonstrate that the Opponent’s mark and the “KILLAH” brand have been used on ladies’ clothing, shoes, boots, bags and accessories. Mr Bloch was, however, silent on where those product catalogues were distributed to. I noticed that of those close to 500 pages of copy catalogue materials in exhibit “FB-4”, one page in a Spring/Summer 2003 catalogue pictured a model in a background with names of places and shops in Hong Kong. Paragraph 6 of FB’s SD referred to the Opponent’s goods bearing the Opponent’s mark being sold in many countries and territories worldwide including Hong Kong.

17. Copy trade mark records of the four marks set out in paragraph 7 above were contained in exhibit “FB-11”. Adduced in exhibit “FB-12” was a list, as at 14 July 2009, of jurisdictions where the registration of the Opponent’s mark was applied for, granted or pending.

18. According to paragraph 9 of FB’s SD, the Opponent marketed and sold its goods in Hong Kong through its branch office Sixty Far East Ltd. which operated under the Sixty group. Adduced in exhibit “FB-13” were some 140 pages of copy invoices concerning the Sixty Far East Ltd. for the period roughly from January 2003 to September 2007. It was noted that each of those copy invoices bore the name “Sixty Spa” (with an address in Roma, Italy) at the top left hand corner and “Sixty Far East Ltd.” or “Sixty Far East / wholesales” (at one same Hong Kong address) as destination. These copy invoices appeared to be related to shipment of goods from Sixty Spa in Italy to the Hong Kong market via Sixty Far East Ltd or Sixty Far East / wholesales in the said period. Of these copy invoices, Mr Clark identified at the hearing about 20 pages containing references to “Killah Basic” or “Killah Fashion” line of goods.

19. Mr Bloch also said that the Opponent’s goods were sold in five named retail outlets and stores throughout Hong Kong in recent years, with copy photographs of some outlets/stores in exhibit “FB-14” in support.

20. I pointed out to Mr Clark at the hearing that FB's SD did not give any figures of the Opponent's sale of goods bearing the Opponent's mark in Hong Kong or elsewhere while the copy photographs of outlets/stores in exhibit "FB-14" were all undated and did not show any goods bearing the Opponent's mark. In fact, only one copy photograph in the said exhibit showed "KILLAH" but as a sign/decoration on the wall of a shop while one other copy photograph bore a description of display of goods by the product line "POCA". Mr Clark agreed.

21. Mr Bloch said in paragraph 11 of his evidence that the Opponent's "KILLAH" line of products has been extensively advertised and promoted in Hong Kong by various means such as print, poster and catalogue, magazines and newspaper with major circulation. Adduced in exhibit "FB-15" were records of advertisement and promotion materials on fashion items and accessories of the "KILLAH" line placed in May and October 2007 in over 10 magazines in Hong Kong with rather considerable circulation in most cases. Similar promotional materials adduced in exhibit "FB-16" pertaining to the "KILLAH" line of products were circulated in various overseas jurisdictions in the year of 2009 while two pages thereof were concerned with one magazine in Hong Kong, both for April 2009. Advertising campaign for the "KILLAH" line of products was also said to have been carried out on social media on the Internet including facebook, YouTube and MySpace. I was nonetheless unable to discern from the copy webpages of those social media appearing in exhibit "FB-17" the date/s when those advertising materials were posted.

22. As in the case of sales figures, Mr Clark agreed that FB's SD was silent as to how much the Opponent had expended on promoting the "KILLAH" brand in Hong Kong at the relevant date. He nonetheless submitted that Mr Bloch's evidence was sufficient to show that the distinctiveness of the Opponent's mark was enhanced through use.

23. Having considered the Opponent's evidence, I am inclined to accept that the Opponent's mark has demonstrably been promoted and used in respect of the Opponent's goods in the Hong Kong market from about 2003 to 2009, albeit

not as extensively as claimed.

24. Finally, by comparing the suit mark and the Opponent's mark, Mr Bloch sought to demonstrate that the two marks were confusingly similar and that the subject application should be refused.

25. Ng Sau Wah ("Mr Ng"), a director of the Opponent, adduced NSW's SD in answer to the Applicant's evidence. Based on the lack of documentary proof, Mr Ng attacked the Applicant's claim as to when the suit mark was first used respectively in the US and in Hong Kong; alleged promotion and sale of products under the suit mark in Hong Kong; and the registration of the suit mark anywhere in the world.

26. Mr Ng then pinpointed the alleged similarity between the Opponent's mark and the suit mark. He also refuted the Applicant's assertion that the two marks co-existed in the trade mark registers in various countries for the reason that the Applicant did not adduce the relevant trade mark records. To conclude his evidence, Mr Ng gave a synopsis of certain opposition proceedings which the Opponent successfully brought against the Applicant in Macau in 2014 in respect the suit mark and the Opponent's mark.

### **Applicant's evidence**

27. Craig E. Gosselin, the Applicant's SVP and General Counsel ("Mr Gosselin") gave evidence in support of the subject application. The Applicant was a company incorporated in the US, initially founded in 1980 as a small surf shop in California. It offered a wide range of goods for both men and women and built its business from selling merchandise from a number of established surf brands and had long since expanded to sell skate and street wear labels. "Kirra" was said to be one of the first proprietary brands established by the Applicant ("KIRRA brand") for the sale of clothing, accessory and fragrance products. The Applicant was said to be operating over 600 stores in all 50 states in the US



and Puerto Rico. It also shipped internationally via its website.

28. Goods offered by the Applicant included but not limited to those in Classes 3, 9, 14, 18 and/or 25. Mr Gosselin said the KIRRA brand was launched in the US in 1994 and since then in countries throughout the world.

29. It was claimed that the suit mark was first used in Hong Kong as early as in 2011, then continuously and extensively in respect of goods sold by the Applicant worldwide including Hong Kong. The Applicant said it had used the suit mark in Hong Kong on the applied for goods. Exhibit “SD-1a and b” to CEG’s SD were two downloaded webpages displaying the suit mark: one showing the particulars of a “Cropped Surplus Top” (original price HKD182.96 reduced to promotion price of HKD82.45) while the other those of a “Short Sleeve Lace Black Top” (original price HKD228.81 reduced to promotion price of HKD91.62), both worn by female models. The Applicant’s purported use of the suit mark was demonstrated by reference solely to those two webpages but both undated, on two female tops and nothing else.

30. According to Mr Gosselin, the Applicant had expended considerable resources on advertising and promoting the applied for goods under the suit mark whereby building goodwill and reputation in it. The suit mark was said to have attained high exposure on social media. No sample advertisements, actual figures of expenses nor any relevant details were, however, given in CEG’s SD.

31. The Applicant said it had spent a lot of efforts and incurred substantial expenses in policing trade mark registrations in many countries in order to protect its intellectual property rights. As for trade mark registration, exhibit “SD-2” to CED’s SD was a 9-page list of “selected TM records” pertaining to registrations which the Applicant had obtained (or was applying) in a number of jurisdictions. That list nonetheless did not show any date of registration or application therefor. Further, despite Mr Gosselin’s claim that the Applicant had first registered the suit mark in the US in 2004, that list did not refer to any trade mark registrations in the US.

32. In paragraphs 17 to 24 of CED's SD, by reference to the definition respectively of the words "Kirra" and "killah" found in an online "urban dictionary" (exhibits "SD-3" and "SD-4") and a downloaded webpage showing the Opponent's mark (exhibit "SD-5"), Mr Gosselin discussed the purported differences between the suit mark and the Opponent's mark. Mr Ng for the Opponent described the online "urban dictionary" as "crowdsourced" as opposed to being official and averred that there was no guarantee that the definitions it contained were correct or well-known among the general public.<sup>1</sup> I agree with Mr Ng on this point.

33. Mr Gosselin also said that, in a dispute akin to the proceedings herein, the two marks were found not to be similar by the Argentina Intellectual Property Office. The two marks were then claimed to have co-existed in the countries and places appearing in the list in exhibit "SD-2" which I have already discussed in paragraph 31 above.

### **Opposition under section 12(3) of the Ordinance**

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

*"(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."*

35. Section 12(3) essentially prohibits the registration of a trade mark which would be likely to cause confusion on the part of the public as a result of it

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<sup>1</sup> NSW's SD, paragraph 19.

being similar to an earlier trade mark and because it is to be registered in respect of goods or services the same as or similar to those of the earlier trade mark.

36. This ground of opposition is premised on the existence of an “earlier trade mark”, a term defined in section 5 of the Ordinance as a registered trade mark which has a date of 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.

37. According to section 7(1) of the Ordinance, in determining whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

38. The basic principles regarding the assessment of similarity between signs and the likelihood of confusion between them are set out in the cases 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 *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.R.S. 19. Such principles have been adopted in Hong Kong and recently affirmed by the Court of Final Appeal in *TWG Tea Co Pte Ltd v Tsit Wing (Hong Kong) Co Ltd* (FACV 15/2015) -

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who 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, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) 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;
- (k) 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.”

### ***Opponent's KILLAH mark***

39. The particulars of the four marks the Opponent sought to rely on herein are set out in paragraph 7 above. Each of the four marks has a date of application for registration earlier than that of the suit mark and hence meets the criteria of an "earlier trade mark" as defined under section 5(1)(a) of the Ordinance.

40. While all four marks of the Opponent contain the word "KILLAH", three of them share one same representation in plain font without any stylization whereas the remaining mark (trade mark No. 199915398) is stylized and contains a device. Since the suit mark is a pure word mark, I would focus on the three pure word marks of the Opponent namely, trade mark Nos. 300497386, 300293012 and 300975547 in my continued assessment of the Opponent's case and refer to them collectively as the "KILLAH mark".

### ***Relevant Public***

41. The applied for goods include bags, purses, wallets, clutches and satchels etc in Class 18 and clothing, footwear and headgear" in Class 25. Those are common goods for day-to-day use targeted at any member of the general public. As those goods are not specialised or particularly expensive, I consider that an average consumer would pay an average level of care and attention in selecting and purchasing them.

### ***Comparison of marks***

42. 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 and services in

question and the circumstances in which they are marketed.

43. In comparing the marks, it is not appropriate to concentrate on the similarities to the exclusion of the differences between the marks and one cannot assume that because an element of the marks is identical the marks are similar unless the identical part constitutes the dominant element in the overall impression created by each mark, such that all the other components are insignificant.<sup>2</sup> One must also consider the perception of the marks in the mind of the average consumer of the goods in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. As mentioned above, the level of attention and care of the relevant consumers of the applied for goods would pay in selecting and purchasing them is average.

44. Both the KILLAH mark and the suit mark “KIRRA” are pure word marks, made up respectively of six and five English alphabets and expressed in the uppercase in plain font without any stylization.

45. The Opponent’s arguments on the similarity between the two marks were set out in paragraphs 11 to 13 of its skeleton submissions<sup>3</sup> and supplemented verbally by Mr Clark at the hearing. By emphasising on the perceived similarity between the two marks particularly from the aural point of view and by reference to several decisions of the Office for Harmonization in the International Market, Mr Clark submitted that the two marks were obviously similar.

46. Visually, the KILLAH mark and the suit mark share an identical frontal part “KI” and differ by their middle part “LL” vs. “RR”, and one mark ends in “AH” while the other “A”. The average consumer normally perceives a mark as whole and does not proceed to analyse its various details and that he/she rarely has the chance to make direct comparisons between marks and would rely upon

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<sup>2</sup> *Kerly's Law of Trade Marks and Trade Names* (15<sup>th</sup> edition), paragraph 9-093.

<sup>3</sup> Filed on 5 December 2016 together with case authorities.

the imperfect picture of them in his mind (paragraph 38 above). Although the suit mark is one alphabet shorter than the KILLAH mark, such a difference is too subtle to be noticed by an average consumer. Given the identity in their frontal part, I am of the view that the difference in their middle part “LL” vs. “RR” may also be glossed over. I find that visually there exists a *higher than average degree of similarity* between the two marks.

47. Mr Clark discussed at some length at the hearing the aural similarity between the KILLAH mark and the suit mark. He said that when targeted at the Hong Kong market which was primary Chinese speaking, the two marks would be orally and aurally identical as the ending alphabet “H” in the KILLAH mark would not be pronounced and the middle part “LL” and “RR” shared the same rhythm and intonation. Mr Clark further submitted that the alphabets “L” and “R” were often pronounced in the same way by Japanese speakers as well as Chinese speakers. As such the pronunciation of the two marks would unlikely to be differentiable.

48. Aurally, both words making up the two marks have two syllables, KILLAH possibly being pronounced as /'kilə/ while the suit mark /'kirə/, both with accent on the first syllables. The only difference in such pronunciations lies in the sound between /lə/ and /rə/ of the respective second syllable, which is not prominent. The suit mark on the other hand may be pronounced as /'kərə/. For an average consumer who reads the suit mark in the latter way, the aural difference between the two marks may better imprint in his mind. Having considered the identity and the difference in the phonetics of the respective parts of the Opponent’s mark and the suit mark and Mr Clark’s submissions, I am satisfied that the two marks are *aurally similar to an average degree*.

49. As words, neither “KILLAH” nor “KIRRA” is defined in conventional dictionaries. Although they both appeared in an online dictionary cited in the Applicant’s evidence, I have already observed in paragraph 32 above that I agree with the Opponent that such respective meaning is not plain to an average consumer. As such *no conceptual similarity* is to be taken into account between

the two marks.

50. Having regard to the visual, aural and conceptual similarities and differences between the KILLAH mark and the suit mark and the overall impression created by each of them, I find that the *two marks are similar to an average degree*.

### ***Comparison of goods***

51. The well-known tests for assessing similarity in goods and services are found in *British Sugar v Robertson and Sons Ltd* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra). The court considered that all relevant factors relating to the goods or services in question should be taken in account. They include, *inter alia*, their nature, intended purpose, method of use, whether the goods/services are in competition with each other or are complementary, as well as their users and the channels through which they reach the market.

52. Goods and services are considered identical if they fall within the ambit of the terms within the competing specification.<sup>4</sup> Goods and services are considered 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 and services lies with the same undertaking.<sup>5</sup>

53. The specification of the Class 25 goods “*clothing, footwear, headgear*” sought to be registered under the suit mark is identical to that of the goods in the same class protected by the KILLAH mark in trade mark registration No. 300497386. The items “*Handbags, tote bags, beach bags, messenger bags,*

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<sup>4</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05.

<sup>5</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-325/06.



*travelling bags, backpacks, fanny packs, coin purses, purses, wallets, clutches and satchels*” in Class 18 among the applied for goods fall squarely within the specification “*Leather and imitations of leather, and goods made of these materials and not included in other classes; .....travelling bags*”, also in Class 18, under trade mark registration No. 300293012 belonging to the Opponent.

54. In the circumstances, the only logical conclusion for me to draw is that the applied for goods are at least highly similar, if not identical, to the goods protected by the KILLAH mark.

### ***Distinctiveness of KILLAH mark***

55. The distinctive character of an earlier trade mark is a factor to be taken into account in the assessment of the likelihood of confusion. It is trite law that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character either because of its inherent qualities or because of the use that has been made of it (*Sabel v Puma* (supra)).

56. As a word, “KILLAH” is not an official English word. As a trade mark, it is not descriptive of any of the Opponent’s goods. The KILLAH mark is therefore inherently distinctive.

57. The Opponent’s evidence of use is outlined in paragraphs 16 to 22 above. Having considered it in the round, I am of the view that such evidence has demonstrated use of the KILLAH mark but not extensively. Taking the Opponent’s evidence to the highest, I can at most find that as at the relevant date the distinctiveness of the KILLAH mark has been slightly enhanced through use of it in respect of the Opponent’s goods.

### ***Likelihood of confusion***

58. The likelihood of confusion between marks must be appreciated globally, taking into account all relevant factors. 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. 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* (supra)).

59. In the present case, the applied for goods and the Opponent's goods include bags, purses, wallets, clutches and satchels etc in Class 18 and clothing, footwear and headgear in Class 25. Since those goods are not specialised or particularly expensive, I have found the level of attention paid by the average consumer at the moment of selection or acquisition to be average.

60. I have compared the suit mark with the KILLAH mark and found an average degree of similarity between them (paragraphs 42 to 50 above). I have also compared the applied for goods with the Opponent's goods and likewise found them to be at least highly similar, if not identical (paragraphs 51 to 54).

61. Taking into account the combined effect of these findings and having regard to the degree of distinctiveness (inherent by nature and slightly enhanced through use) of the KILLAH mark, I consider that, given an average level of care and attention, when the suit mark is used in relation to the applied for goods, the average consumer would be confused into thinking that those goods offered under the suit mark and the Opponent's goods offered under the KILLAH mark come from the same or economically-linked undertakings. The ground of opposition under section 12(3) of the Ordinance is therefore made out in respect of the applied for goods.

62. Given the establishment of the Opponent's ground of opposition under section 12(3), I need not consider other grounds set out in paragraph 10 above.

## **Conclusion and costs**

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

( Elsie Tse )  
*for* Registrar of Trade Marks  
17 May 2017