

# HONG KONG IP CASE REPORT

## Trade Mark Opposition

- Application filed under Trade Marks Ordinance (Cap. 43) in Hong Kong
- Decision delivered on 20 July 2006

### Applicant's Mark



Applicant : Li Kam Lin trading as Tin Gut Company  
Application No. : 200218013  
Application Date : 19 November 2002  
Class : 25  
Goods : clothing for men and women

### Opponent's Marks



Trade Mark	Class	Goods	Registration No.	Registration Date
<b>WOLSEY</b>	25	articles of clothing	19310228	14/01/1931
A stylized black and white logo of a fox or animal head.	25	knitted articles of clothing and articles of clothing made from knitted materials	19852084	30/03/1985

### Opponent : Wolsey Limited

- The Applicant's Application for registration was published on 20 June 2003.
- The Opponent filed a Notice of Opposition against the Application on 17 September 2003.

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## **DECISION**

Upon considering all circumstances and factors, the Registrar has refused registration of the Applicant's Application and awarded a cost order to the Opponent under Section 20(1).

### ➤ Opposition under section 20(1) of the Ordinance

Section 20(1) provides as follows:

"Except as provided by section 22, no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of –

- (a) the same goods;
- (b) the same description of goods; ..."

## REASONING

1. The applicant's specified goods consist of clothing for men and women. The opponent's goods are articles of clothing (for WOLSEY) and knitted articles of clothing and articles of clothing made from knitted materials (for the Fox Device). There is considerable overlap between the parties' goods, and there is little doubt that they are goods of the same description, if not the same goods.

2. The applicant's mark is not identical to the opponent's marks. However, the parties' respective device components are both simple drawings in outline or silhouette but both are clearly foxes. Their overall presentation is remarkably similar despite minor points of differences (i.e. the tail of one tilts upwards whilst the other points downwards, and the nose of one points outwards and the other points downwards). The impressions conveyed are also remarkably similar. Moreover, the word "Wuleys" is one letter different from "WOLSEY" and the letter "S" displaced. The letters which are different, i.e. "O" and "U," are liable to be confused with one another especially in cursive form or if presented in small print. So, there exists real danger that persons who sees the applicant's mark in the absence of the opponent's marks, having only a general recollection of the latter would be liable to think they are the same mark or that they are related to each other.

3. For the reasons aforesaid, the Registrar ruled that assuming user by the opponent of its marks and in a normal and fair manner for articles of clothing and articles of clothing made from knitted materials, there is reasonable likelihood of deception or confusion among a substantial number of persons if the applicant also uses its mark in respect of the same description of goods covered by its proposed registration.

4. The special background for this case is : prior to filing this application, the applicant had on 6 June 2002 applied to register "Wolsey Silk & Fox Device" (Application No. 200208390) in Class 25 in Hong Kong. This mark is a copy of the opponent's marks, "WOLSEY" (No. 19310229) and "Fox Device" (No. 19852084). In addition, shortly after the present application was made the applicant filed another mark "Wulseys & Fox Device" in respect of "clothing for men and women" in Class 25 under Application No. 200218480. Mr Mitchell says the fox device of that mark is a copy of the opponent's "Fox Device" (No. 19852084) and the word "Wulseys" is a modified form of the opponent's "WOLSEY" (No. 19310229) (Exhibit I). Nevertheless, these two applications were subsequently withdrawn.

5. Based on the pattern and history of the applicant's trade mark applications, the Registrar commented that the possibility of copying the opponent's marks by the applicant cannot entirely be discounted and the applicant's behavior indicated that she has made use of registration of confusingly similar device to free ride on the reputation of the opponent's marks.

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