

HONG KONG / JUDGMENT

FAST FAIR LTD v. MIROGLIO S.p.A.

COURT

Court of First Instance

DECIDED

23 April 2007

CASE / FILE NUMBER

HCMP124/2007

Source: legalref.judiciary.hk · Research copy typeset by Esheria. Not court-issued or certified.

bjbj HCMP 124/2007 IN THE HIGH COURT OF THE HONG KONG SPECIAL ADMINISTRATIVE
REGION COURT OF FIRST INSTANCE MISCELLANEOUS PROCEEDINGS NO. 124 OF 2007

IN THE MATTER of Section 84 of the Trade Marks Ordinance (Cap. 559) and IN THE MATTER of
an appeal against the Decision of Mr. Frederick Wong acting for the Registrar of Trade Marks
given on 27th December 2006 in relation to an opposition filed by Fast Fair Limited to Trade mark
Application No. 200120640 in Class 25 in the name of Miroglio S.p.A.

BETWEEN FAST FAIR LIMITED Appellant (Opponent) MIROGLIO S.p.A. Respondent (Applicant)

Before: Hon Sakhrani J in Court Date of Hearing: 16 April 2007 Date of Judgment: 16 April 2007
Date of Handing Down Reasons for Judgment: 23 April 2007 REASONS FOR JUDGMENT
AUTONUMOUT By notice of motion dated 18 January 2007, the appellant appealed against the
decision of Mr Frederick Wong the acting Registrar of Trade Marks given on 27 December 2006 in
relation to an unsuccessful opposition by the appellant to a trade mark application in the name of
the respondent. AUTONUMOUT On 16 April 2007, I dismissed the motion with costs to the
respondent. I indicated at the time that reasons for judgment would be given. These are my
reasons. AUTONUMOUT The appeal was in relation to opposition proceedings before the acting
Registrar. The respondent Miroglio S.p.A. (Miroglio) made an application on 21 December 2001
to register in Part A of the register the trade mark CARACT Miroglio s mark) for women s
outerclothing, all included in Class 25. AUTONUMOUT After examination by the Registrar,
Miroglio s mark was deemed to be distinctive of Miroglio s goods in Hong Kong pursuant to
section 9(1)(e) of the Trade Marks Ordinance Cap. 43, use being claimed from 1992 pursuant to
section 22 and the mark was accepted for registration in Part A of the register. Miroglio s mark
was then advertised in the Government Gazette on 9 January 2004. AUTONUMOUT The appellant
Fast Fair Limited (Fast Fair) filed a notice of opposition on 6 March 2004 together with grounds
of opposition. AUTONUMOUT Fast Fair is the registered proprietor of the trade mark

CHARACTER registered in respect of jackets, skirts in Class 25 (Fast Fair s mark AUTONUMOUT Fast Fair avers that Miroglio had previously applied to register Miroglio s mark in Class 25 under application no. 13877 of 1994 but later withdrew that application. Fast Fair also alleges that in the application for registration which resulted in Fast Fair s mark being registered, Miroglio had lodged an opposition against Fast Fair s mark which Fast Fair alleged was unsuccessful. However, it is clear from paragraph 7 of the statutory declaration of Mr Ronchi Roberto of Miroglio made on 10 March 2005 that Miroglio voluntarily withdrew its opposition to the registration of the Fast Fair mark. The reason it did so was that it decided that the opposition was unnecessary as Miroglio considered that the Miroglio mark and Fast Fair s mark could co-exist in Hong Kong. The statutory declaration of Mr Roberto is unchallenged. AUTONUMOUT The acting Registrar considered the question of whether there had been an abuse of the process on the part of Miroglio in making the application on 21 December 2001 which was a second application for the registration of the Miroglio mark. It is plain that the first application for registration by Miglio for registration of the Miroglio mark under application no. 13877 of 1994 was withdrawn with no adjudication on the merits. And it is also plain, as the acting Registrar found, that there had never been any adjudication on the merits of Miroglio s opposition to Fast Fair s application. AUTONUMOUT The acting Registrar held that Miroglio was entitled to make the second application for registration on 21 December 2001 and that the opposition based on abuse of process was not made out. AUTONUMOUT Fast Fair also relied on paragraph 5(b) of the grounds of opposition relying on section 12 of the TMO. This provides:

- (1) It shall not be lawful to register a trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design AUTONUMOUT Fast Fair contended that as Miroglio s mark is similar to Fast Fair s mark the use of Miroglio s mark is likely to confuse the public. The acting Registrar also held that the opposition on this ground failed. AUTONUMOUT Mr Lin, for Fast Fair, contended at the hearing of the appeal that the acting Registrar erred in law as his decision was based on a wrong understanding of the burden of proof under section 22 of the TMO. It was also his contention that by making the second application, there was an abuse of process and the acting Registrar was wrong to find that there was no abuse of process. Mr Lin also contended that the acting Registrar erred in law in understanding and applying sections 21 and 22 of the TMO. AUTONUMOUT In my judgment there is no merit in any of Mr Lin s contentions. AUTONUMOUT Although the hearing before the acting Registrar took place after the commencement of the Trade Marks Ordinance, Cap. 559, by virtue of section 10(2) of Schedule 5 of Cap. 559, oppositions that are pending at the commencement date of 4 April 2003 remain to be dealt with under the provisions of the TMO. Hence he was right to deal with the opposition proceedings under the provisions of the TMO. In my judgment the acting Registrar correctly considered the provisions of the TMO. Honest concurrent use AUTONUMOUT Section 22 of the TMO provides: In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or of the Registrar make it proper to do so, the Court or the Registrar may permit the registration by more than one proprietor, in respect of the same goods or

services; the same description of goods or services; or goods and services or descriptions of goods and services which are associated with each other, of trade marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose. AUTONUMOUT There is no dispute that the onus of showing honest concurrent use is on Miroglio. On the statutory declaration of Mr Roberto, which was unchallenged, there was substantial evidence of honest concurrent use by Miroglio of Miroglio s mark in Hong Kong prior to the date of the application on 21 December 2001. Use of the mark in Hong Kong was claimed as early as October 1992 which was about 9 years before the application on 21 December 2001. The evidence was that Miroglio s mark was first developed by Miroglio s predecessor in Italy in 1988 and first registered in Italy in 1990 as a trade mark for, inter alia, clothing in international Class 25 and textiles and textile goods in international Class 24. There was also evidence that Miroglio s predecessor was not aware of Fast Fair s mark when it devised and used the Miroglio mark in Italy in 1988. There was no evidence of any use by Fast Fair of the Fast Fair mark in Hong Kong at that time. AUTONUMOUT The evidence put forward on behalf of Miroglio was unchallenged. AUTONUMOUT In the circumstances, honest concurrent use on the part of Miroglio was plainly established. AUTONUMOUT Nothing that the acting Registrar has said suggests that he regarded the burden of proof of honest concurrent use to be on Fair Fast and there is no merit that the acting Registrar misunderstood the burden of proof. Was there an abuse of process? AUTONUMOUT It was submitted by Mr Lin that Miroglio was not entitled to make the second application for registration on 21 December 2001 and that the acting Registrar was wrong to find that there was no abuse of process in making the second application. AUTONUMOUT It seems to me that it has been well established that an applicant is entitled to withdraw an application and to make a second application so as to obtain the advantage of a longer period of use (para. 10-20 Kerly s Law of Trade Marks and Trade Names 12th Edn; Portogram Radio Electrical Co. Ltd s Application (1952) 69 RPC 241). AUTONUMOUT In Portogram at page 242 the Hearing Officer said: I also do not think that any conclusions adverse to the Applicants can be legitimately drawn from the circumstance that after the Opponents had filed their evidence on the 15th of August, 1950, the Applicants withdrew their first application, having in the meantime (viz., on 16th of January, 1950) filed another application to register the mark, because if their claim to registration had been adjudicated upon in the opposition proceedings against their first application, the period of use of their mark, up to the relevant date concerned viz., the 21st of January, 1947, would have been about 2 years, whereas by the time the Opponents had filed their evidence in those opposition proceedings, viz., 15th of August, 1950, the Applicants use of their mark had increased to about 6 years, and I consider that, once the honesty of adoption of the Applicants mark has been established, they are perfectly entitled to test the matter upon the footing of a new application as they in fact have done. AUTONUMOUT Thus, once the honesty of the adoption of the mark has been established, Miroglio is in my view perfectly entitled to test the matter upon the footing of the second application to take advantage of the longer period of use from October 1992 up to the date of the second application 21 December 2001. Here, the honesty of the adoption of

the mark and honest concurrent use has been plainly established. There is no abuse of process and the acting Registrar was right to so hold. Section 21 AUTONUMOUT Mr Lin also submitted that the acting Registrar erred in law in understanding and applying sections 21 and 22 of the TMO and their inter-relationship. AUTONU the same description of goods or services; or goods and services or descriptions of goods and services which are associated with each other, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or, on an appeal, by the Court. AUTONUMOUT Section 21 deals with the situation where there are separate applications by different persons to register marks that are identical or nearly resemble each other. AUTONUMOUT The section deals with cases in which there are two or more applications pending. This has nothing to do with the opposition proceedings before the acting Registrar. There was only one application before the acting Registrar namely, Miroglio s application. Fast Fair s mark had already been registered by that time. There is simply no basis for contending that the acting Registrar should have considered section 21 and that he was wrong in law in failing to do so. AUTONUMOUT Mr Lin also made the submission that by failing to rely on section 22 of the TMO in the first application for registration in 1994, Miroglio is somehow debarred from relying on honest concurrent use under section 22 on the second application made on 21 December 2001. No authority is cited for this proposition. There is no merit in it. It is in my view untenable to suggest that Miroglio is unable to rely on honest concurrent use under section 22 in its second application for registration. The first application was withdrawn and I have held that Miroglio was perfectly entitled to take advantage of the longer period of use from October 1992 up to 21 December 2001, the date of the second application. AUTONUMOUT Although section 12(1) of the TMO was also relied on in the grounds of opposition, this was not pursued by Mr Lin at the hearing of the appeal. Before Fast Fair can mount an opposition under section 12(1), it must first overcome the burden of establishing that the Fast Fair mark is known to a substantial number of persons in Hong Kong (Montres Tudor SA v Concord Watch Co SA (No. 1) [2001] 3 HKC 349 at 352). No evidence was adduced by Fast Fair to show this and Mr Lin rightly did not pursue the opposition under section 12(1). AUTONUMOUT For the above reasons, the motion was dismissed. I also ordered that the costs of the motion be costs to Miroglio as costs should follow the event. (Arjan H Sakhrani) Judge of the Court of First Instance Mr Lin Feng, instructed by M/s William Lam & Co., for the Appellant (Opponent) Mr Philips B. F. Wong, instructed by M/s Johnson, Stokes & Master, for the Respondent (Applicant) PAGE - A B C D E F G H I J K L M N O P Q R S T U V 1udk 1udk S T U V A B C D E F G H I J K L M N O P Q R S T U V (#p# (#p# r p# r p# r p# (#p# r p# r p# r p# r p# "@AB9D vy4" / Jz @m2z]C]6 uxB26I]C]6 & 6" abc-sak-HCMP.dot setup Microsoft Word 9.0 Judiciary Title Microsoft Word Document MSWordDoc Word.Document.8

Source & reproduction note

Judgment wording, source notices and original paragraph numbers are retained. Esheria supplies the layout and this PDF's page numbers; these are not the source pagination. This is a research copy, not an official or certified court document. Check quotations, citations and publication restrictions against the original source before relying on it.

ORIGINAL SOURCE https://legalref.judiciary.hk/lrs/common/ju/ju_frame.jsp?DIS=56823

CASE PAGE <https://chat.esheria.ai/case-law/hong-kong/fast-fair-ltd-v-miroglio-s-p-a-2007>

Prepared on 29 October 2026 · Esheria