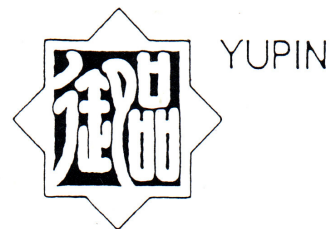


Application No. 10300 of 1999

IN THE MATTER of the Trade Marks  
Ordinance (Cap. 43)

AND

IN THE MATTER of an application for the  
registration of the trade mark: -



In Part A in Class 33 by Guangdong  
Foodstuffs Import & Export (Group)  
Corporation

**DECISION  
OF**

Miss Lavinia Chang acting for the Registrar of Trade Marks after a hearing on 5 May 2003.

Appearing : Mr Sanjay A Sakhrani of Counsel, instructed by Messrs Sanny Kwong & Henry Lo, Solicitors on behalf of the applicant Guangdong Foodstuffs Import & Export (Group) Corporation.

On 4 August 1999, Guangdong Foodstuffs Import & Export (Group) Corporation, of No 2 Dong Hu Road West, Guangzhou, Guangdong, People's Republic of China (the "applicant"), applied to register in Part A of the register, the mark a representation of which follows:



(the "mark"), pursuant to the provisions of the Trade Marks Ordinance, Cap. 43 (the "Ordinance"). The application is made in respect of the specification "alcoholic beverages (except beers)" in Class 33.

2. An examination report was issued on 10 December 1999 rejecting the application under section 9(1)(d) and (e) of the Ordinance. Specifically it was pointed out that the first Chinese character in the mark, 御, stands for "imperial", which in turn means "(esp. of products and commodities) of a superior size or quality." The second Chinese character 品, meaning quality, is indistinctive of any goods. Therefore 御品 as a whole, meaning "imperial quality", lauds that the goods are of a superior quality contrary to section 9(1)(d). Alternatively the mark is indistinctive of the applicant's goods under section 9(1)(e) of the Ordinance.

3. In response, on 14 April 2000 the applicant filed a statutory declaration of Kwong Mun Fai Sanny. Mr Kwong does not state the capacity in which he makes the declaration apart from saying that he has been authorised by the applicant. The bulk of the declaration consists of arguments as to why the mark is not laudatory and therefore registrable. That criticism aside, he says that the characters have achieved distinctiveness through use on the applicant's products since 1995, which were sold via appointed agents in Hong Kong to various retail supermarket chains and grocery stores. Mr Kwong also says that the characters have achieved public recognition through marketing and promotion. The applicant later supplemented the material before the Registrar with a copy certificate of registration of the same mark in Class 29 in Part B of the register.

4. Defects in the evidence were identified by the Registry in a letter dated 29 June 2001. Strictly it was not made by the applicant or its sales agent who would, instead of Mr Kwong, have been in a position to depose on matters relating to its trade use. Furthermore, the proven use and sample (undated) advertisement exhibited relate only to canned foods (specifically use in respect of fried dace and sugar cane juice) but none relating to the goods claimed. Also, the pertinent advertising expenditure has not been provided.

5. Meanwhile, this application was held co-pending under section 21 of the Ordinance with application no. 17381 of 2000 for the registration of a similar mark, 御品九江, made by another proprietor. Details of the competing application are immaterial to this matter. Suffice it to say that for determining priority as between them, the two applicants respectively filed evidence, which was how the statutory declaration of Wei Gao Ping, Deputy General Manager of the applicant, came to be filed on behalf of the applicant on 1 March 2002. Insofar as is relevant to the inherent registrability of the mark, Wei Gao Ping's evidence shows use of the mark on fried dace and sugar cane juice only in Hong Kong through sales made by China Resources Purchasing Co Ltd and the Wellcome Supermarkets. One undated sample advertisement is exhibited but this, again, relates to canned fried dace. Contrary to Mr Wei's assertion of overseas registrations in Class 33 the exhibits show only registrations in respect of Class 29 goods. In respect of user on alcoholic beverages, the position is made abundantly clear in the following statement:

“GDF intends to use the subject mark in respect of rice wines, being another commodity within its range of processed food products. Although the subject mark has not so far been used by GDF on its rice wines, it is our intention to do so once registration is obtained.” (para 12, Wei Gao Ping's declaration)

The statutory declaration of Wei Gao Ping therefore does nothing to advance the applicant's case as far as factual distinctiveness of the mark is concerned.

6. In subsequent correspondence dated 22 January 2003, the applicant offered as a condition for acceptance of the mark, a disclaimer of exclusive rights, separately, in 御 and 品. Refusal of the mark for registration was maintained by the Registrar, culminating in a request for a hearing pursuant to Rule 18 of the Trade Marks Rules.

7. The matter came on for hearing before me on 5 May 2003 at which Mr Sanjay A Sakhrani of Counsel appeared on behalf of the applicant.

### *Hearing*

8. Skeleton submissions were filed for the hearing. According to Mr Sakhrani, the meaning ascribed to 御品 YUPIN is “fit for a king or royal family”. He submitted that

“... the language does not strictly refer to the quality of the product nor that it is only something that the royal family would consume. It ascribes a certain standard/status/class along a spectrum which is not defined, albeit towards the higher end (but is not a direct reference to the quality of the product). It is important to read the two words together since there is a different meaning when put together than when read separately ...” (paras 8 and 9, skeleton submissions).

9. He said that the two Chinese characters taken together were no more laudatory than the adage “fit for a king”. On that interpretation he pointed to examples of marks on the register in Hong Kong, namely, “Rum Bacardi Superior & Device” (“Superior” and “Rum” separately disclaimed as a condition of registration), “TIGER THE KING OF SPICES & Device” (application status “withdrawn”) and “ROYAL SALUTE & Device”; and those accepted in the United Kingdom, namely “ROYAL GOLD” (ROYAL” and “GOLD” separately disclaimed as a condition of registration) and “KING’S PRIDE”.

10. Counsel conceded that some of these marks were registered with suitable disclaimer conditions. Nevertheless he argued the subject mark was a stronger candidate for registration because of its acceptance in Class 29 for foodstuffs, which he said were goods of the same description as the goods claimed. It would be illogical, he said, to allow registration in Class 29 but not Class 33. He touched on the applicant’s evidence of use of the mark in relation to processed foodstuffs and claimed that it established recognition of the mark as being indicative of the applicant’s manufacture.

11. I was not persuaded by the evidence filed and arguments advanced. By letter dated 12 May 2003, I issued formal notice of refusal in either part of the register along with brief grounds for my refusal. Pursuant to section 13(4) of the Ordinance, on 16 May 2003 the applicant filed a request for a statement of grounds of my decision and the materials used in arriving at it. These are provided as follows.

### *Decision*

12. Even though the hearing took place after commencement of the new Trade Marks Ordinance (Cap 559) on 4 April 2003, the application is a “pending” application according to paragraph 10(1), Schedule 5 of the new Ordinance. It therefore remains to be dealt with under the provisions of Cap 43.

13. It would be convenient to first deal with the user evidence filed. As pointed out at the examination stage, although some use has been made of the mark in Hong Kong, that use relates only to canned or processed foods. The statutory declaration of Wei Gao Ping further confirms (see paragraph 5 above) that the applicant intends to but has not yet used the mark on rice wines. I need therefore only consider the *prima facie* case.

#### *(a) Section 9*

14. The mark consists of the Chinese characters 御品 presented in a slightly stylised form, within an octagonal device, together with the word YUPIN the Putonghua phonetic equivalent for those characters. It is clear from Counsel’s submissions that the applicant regards the characters to be the focal point or essential

feature of the mark. As a starting point it is convenient to define the meaning of the mark.

15. The Chinese character 御 is defined in 新華字典 (Xinhua Zidian) as 稱與皇帝有關的 (literally “related to the emperor” or imperial; royal). 品 is capable of several meanings including the following:

- 物品、物件 (article; object)
- 等級、種類 (grade; type)
- 性質 (nature; quality)

16. Mr Sakhrani’s position is that in combination, the two characters 御品 become distinctive.

17. 御品 can be readily understood as a noun, namely, that the alcoholic beverages offered by the applicant are imperial articles, or in its adjectival sense, that these goods are of an imperial, or a very superior quality. In my view, at least to the average ethnically Chinese person in Hong Kong who is conversant with the Chinese language, 御品 would mean exactly what the individual characters connote, namely, imperial article; imperial grade, imperial quality etc. 御品 conveys the message that the applicant’s alcoholic beverages are of a very superior quality or grade as to be fit for royalty or connoisseurs. It is a more elegant or literary way of saying “best quality” in a way that imparts more cachet than the ordinary, even brash expressions such as “best” or “top” quality would to the goods. In my view, more so than the examples cited by Counsel, 御品 is objectionable for being overtly and directly descriptive of the character or quality of the goods. “YUPIN” is not a known English word, but in this context it adds little to the Chinese characters as it is simply the Putonghua phonetic equivalent of 御品. YUPIN is therefore likewise objectionable. There remains to be considered the element of the octagonal device. The device, resembling a seal or a star, is used to set off the characters 御品. In my view, rather than to confer distinctiveness on the verbal components, in this context it reinforces the message that the goods bear the imprint of excellence.

18. It matters not whether the mark is objectionable because it is descriptive or because it is a laudatory epithet. The test for registrability is the same regardless (*Colorcoat Trade Mark* [1990] RPC 511 at 517). In my view the mark taken as a whole bears,

- (a) a clear and direct reference to a characteristic of the goods claimed, namely, they are imperial articles; or
- (b) a clear and direct reference to the quality of the goods, namely, quality fit for royalty.

Accordingly, the mark is not inherently adapted to distinguish for being contrary to section 9(1)(d).

19. As I have said, there is no relevant evidence for consideration of the mark under section 9(1)(e). The mark accordingly fails to qualify for registration in Part A.

(a) *Section 10(1)*

20. The applicant's submissions were made with no distinction drawn between sections 9 and 10(1) of the Ordinance. As Counsel urged that the same treatment be given to this mark as the applicant's registration for the same mark, in Part B, in respect of Class 29 goods (No. B06795 of 1998), I go on to consider if it is registrable in Part B under section 10(1).

21. The test under section 10(1) is whether the mark is capable of distinguishing the applicant's goods from those of other traders. Consideration is required of the inherent capacity of the mark to distinguish and whether, by reason of the use of the mark or of any other circumstances, it is in fact capable of distinguishing. It enquires whether other traders (both at present and in the future) are likely to legitimately wish to use the same mark, or some mark nearly resembling it in connection with or to describe their own goods.

22. The onus is on the applicant to demonstrate that the mark is inherently capable of distinguishing, and one cannot look at a mark in isolation from the goods for which it is to be registered. Canned foodstuffs are really "instant" food so that despite branding or labelling them as "御品" (imperial article/quality), are hardly likely to appeal to the gourmet. In my view alcoholic beverages, which covers all kinds of wines, spirits, aperitifs and liquors, belong in a category of goods where a representation that a particular product is of the highest quality would influence the decision to purchase. Exactly because of the cachet and distinction associated with the characters 御品, in my view other traders, quite legitimately, would wish to use the same mark or a mark nearly resembling the applicant's to describe the quality of their alcoholic beverages. I am not satisfied that the mark is inherently capable of distinguishing the applicant's goods.

23. There is no relevant user evidence. Mr Sakhrani has drawn my attention to the applicant's registration in Class 29 and use of the exact same mark for what he has termed "foodstuffs". Mr Sakhrani did not tie this to any basis for registration, or refer to any authority to demonstrate how this information might assist. Based on *ESSO Trade Mark* [1972] RPC 283 and *Laura Ashley Trade Mark* [1990] RPC 539 however, I believe I may properly have regard to this under section 10(2)(b). Section 10(2)(b) reads,

"In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which –

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
  - (b) by reason of the use of the trade mark or of *any other circumstances*, the trade mark is in fact capable of distinguishing as aforesaid."
- (emphasis added)

24. Where the applicant seeks to invoke “any other circumstances” by including use for goods different from the goods of the application, it will only weigh significantly if the goods can, on a reasonable basis be said to be fairly close in kind to the goods to which the applicant has been using the mark. The closeness must be such that the goods are of the same description or allied in some other significant way (*Re Laura Ashley Trade Mark* [1990] RPC 539 at 552).

25. Can the scope of the registration in Class 29 extend to the present application?

26. According to Mr Sakhrani, canned foods and alcoholic beverages are goods of the same description because alcoholic beverages are just as “processed” as canned or processed foods. They can both be termed “foodstuffs”. They can be found in the same retail outlets. Mr Sakhrani also referred me to *DAIQUIRI RUM Trade Mark* [1969] RPC 600 to illustrate, that

“...classification cannot be the basis of ‘description’, since there are many cases where a single class contains goods of different descriptions, while goods which one would think were of the same description may be found in different classes.” (*per* Lord Wilberforce, at 620)

I do not doubt those words for one moment, but Lord Wilberforce continued to say:

“Nor, on the more general test, is it sufficient to find a single trade description covering each of the goods in question.”

Lord Reid in the same case went further:

“‘The same goods’ is not synonymous with ‘goods of the same description’: ‘same’ does not mean identical, but denotes a rather close similarity: and ‘the same description’ does not mean that you look for a description which applies to both goods, but rather indicates a similarity in various respects, there being no single conclusive test.” (*per* Lord Reid at 609)

27. Quite clearly, one does not make diverse goods “of the same description” by ascribing a trade description wide enough to cover all of them. Whether they are goods of the same description is a question of fact that may be determined by reference to Romer J’s guidance in *Jellinek’s Application* (1946) 63 RPC 59, including (a) the nature and composition of the goods; (b) the respective uses of the articles; and (c) the trade channels through which the commodities respectively are bought and sold. I am also mindful that the phrase “goods of the same description” is not to be interpreted in a legalistic sense (*Lyons & Co Ltd’s Application* [1959] RPC 120); the test of sameness being a business and practical one (*DAIQUIRI RUM Trade Mark* [1969] RPC 600).

28. The specification is broad enough to cover all kinds of wines, aperitifs, spirits and liquors. It is common knowledge that alcoholic beverages such as wines and spirits are made by fermentation and distillation, and so are quite different, I would have thought, from the processing of meat, fish and poultry by curing or other means of preservation. The compositions of the goods are evidently very different. Admittedly, wines and spirits and canned foods are all intended for human consumption. Indeed wines or spirits may even be consumed in accompaniment to canned foods or be used as an ingredient in manufacturing canned foods, but that is hardly the test. To hark back to Lord Reid's remarks, it would be straining the language to term the goods claimed "foodstuffs". To my mind, canned foods and alcoholic beverages are as far apart, if not more so, than shoe polish is to shoes even though they are closely associated in use (*Jellinek's Application* (1946) RPC 59); or mustard is to semolina even though both are intended for human consumption and often sold in the same grocer's shops or supermarket outlets, though not necessary on the same shelves (*Colman's Application* 46 RPC 126); or tea is to milk (*Lifeguard Milk Products Proprietary Ltd's Application* [1957] RPC 79) where it was thought the manufacturing ends of the trade channels for tea and milk are completely different, and the nature and uses of the products are different.

29. I do not find, on a business and practical test that processed foods and alcoholic beverages to be of the same description or closely allied so as to bring into play "any other circumstances" under section 10(1).

30. Before I leave this point, I need to return to the applicant's assertion that the evidence filed shows that a general recognition has been established of the mark as being indicative of foodstuffs of the applicant's manufacture, irrespective of the type of products in question.

31. The copy receipts of remittance exhibited at KMF-9 show receipt by one "陳麗霞" (Chan Lai Ha) presumably on behalf of the applicant. The funds are labelled "promotion fee" but there is nothing to indicate the destination of the funds, for example to Hong Kong advertising agents or the press. Taking the most generous view of the evidence, I think it is still doubtful if an advertising expenditure of RMB168,000 in one single year (1997) in Hong Kong would be substantial enough to build up a public recognition of the mark in all kinds of foodstuffs and beverages. Even if I were to find on the evidence that public recognition was established, it would not necessarily assist the applicant. It has been held it is not enough for the applicant for a mark unregistrable without evidence of use to show that his mark is a household name for certain goods to enable him to get registration for any goods or any goods in which he might reasonably or possibly deal (*Laura Ashley Trade Mark* [1990] RPC 539 at 552). In the final analysis, if the use is for goods different from the goods of the application it will only carry weight if the goods are close in kind - which takes us back to the test of "goods of the same description".

32. I have also considered whether or not the applicant's offer of a disclaimer of exclusive rights in 御 and 品 separately would assist. In my view the position would remain unsatisfactory as the objection is not in fact leveled at the characters, separately, but that 御品, in this particular grammatical combination, aptly describes goods for which quality or the perception of quality is an important factor in the purchase. Notwithstanding the decorative flourishes in the mark, the Chinese characters 御品, forming as they do the "core" of the mark are likely to be confused with ordinary descriptions that belong in the public domain. In saying so, I do not foreclose the possibility that the mark may through sufficient use in the future acquire factual distinctiveness. I need not however, decide that question here.

33. I conclude that the subject mark as a matter of law also lacks the capacity to distinguish for registration in Part B. In the result this application fails.

34. In arriving at my decision I have considered the applicant's submissions made both at the hearing and in writing, the statutory declarations of Kwong Mun Fai Sunny and Wei Gao Ping along with exhibits, the correspondence between the applicant and this Registry, the Trade Marks Ordinance Cap 43, the Trade Marks Rules Cap 43A, and the authorities and case law cited herein.

(Lavinia Chang)  
p. Registrar of Trade Marks  
29 May 2003