

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 300447048

MARK : *Secret Recipe*

APPLICANT : SECRET RECIPE CAKES & CAFÉ SDN BHD

CLASS : 30, 43

STATEMENT OF REASONS FOR DECISION

Background

1. On 28 June 2005, Secret Recipe Cakes and Café Sdn Bhd (“the applicant”) filed an application (“the application”) pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”) for the registration of the following mark (“the subject mark”):

Secret Recipe

- The application is in respect of “coffee, coffee-based beverage, tea, tea-based beverages, cocoa, cocoa-based beverage, sugar, rice, tapioca, sago, artificial coffee, flour and preparation made from wheat namely, cake, bread, biscuits, pies, quiches, pastry and confectionary, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces (condiments), spices, ice” in Class 30 and “restaurants, cafés, cafeterias, self service restaurants, snack-bars, services for providing food and drink” in Class 43.
2. At the examination stage, objections were raised against the application under section 11(1)(b) and (c) of the Ordinance on the grounds that the subject mark consists exclusively of a sign which designates the characteristics of the goods and services applied for and that it is devoid of any distinctive character. Despite submissions made on behalf of the applicant, the objections were maintained by the Registrar.

3. The applicant requested a hearing on the registrability of the subject mark and this was held before me on 25 August 2010. Ms. Jessie Low acting for and on behalf of the applicant appeared at the hearing. I reserved my decision until after the conclusion of the hearing.
4. In support of the subject application, the applicant had filed the following statutory declarations and affidavits with a view to showing that the subject mark had in fact acquired a distinctive character as a result of the use made of it for the purpose of section 11(2) of the Ordinance:-
 - (i) Statutory declaration of Sim Leong Thun dated 2 November 2006 (“Sim Declaration”)
 - (ii) Affidavit of Poh Chee Boon dated 9 November 2006 (“Poh Affidavit”)
 - (iii) Affidavit of Pang Wai Fung dated 15 May 2007 (“Pang Affidavit”)
 - (iv) Statutory declaration of Sim Leong Thun dated 17 August 2010 (“Sim Supplemental Declaration”)

(collectively, the “Declarations”)

The Ordinance

5. The absolute grounds for refusal of an application for registration of a trade mark are set out in section 11 of the Ordinance. The relevant provisions of section 11 read as follows:

“(1) Subject to subsection (2), the following shall not be registered –

- (a) ...;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; and

(d) ...”

6. Notwithstanding the provisions in the preceding paragraph, section 11(2) of the Ordinance provides that:-

“(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Decision

7. Having considered all the relevant facts, I consider that the subject mark is acceptable for registration in respect of “restaurants, cafés, cafeterias, self service restaurants, snack-bars, services for providing food and drink” in Class 43 on a *prima facie* basis (the “unobjectionable services”). Subject to meeting the requirements stipulated in paragraph 44 below, the subject mark insofar as it is in respect of the unobjectionable services may proceed to registration.
8. For the rest of this statement of reasons, therefore, I shall consider the subject application insofar as it is in respect of “coffee, coffee-based beverage, tea, tea-based beverages, cocoa, cocoa-based beverage, sugar, rice, tapioca, sago, artificial coffee, flour and preparation made from wheat namely, cake, bread, biscuits, pies, quiches, pastry and confectionary, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces (condiments), spices, ice” in Class 30 (the “objectionable goods”).

Inherent registrability

Section 11(1)(c) of the Ordinance

9. Section 11(1)(c) of the Ordinance excludes from registration trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of

production of goods or rendering of services, or other characteristics of goods or services in respect of which registration is sought.

10. Section 11(1)(c) of the Ordinance is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (“Regulation No. 40/94”). In *Wm. Wrigley Jr. Company v OHIM* (Case-191/01P) [2004] R.P.C. 18 (the “*DOUBLEMINT*” case), the European Court of Justice (“ECJ”) discussed the approach to Article 7(1)(c) of Regulation No. 40/94 and stated the relevant principles as follows:

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p.1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of

Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

11. Moreover, the ECJ stated in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) [2004] E.T.M.R. 57 (the "POSTKANTOOR" case) that:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements...

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its

parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components...”

12. In light of the legal principles above, to be precluded from registration under section 11(1)(c) of the Ordinance, a mark does not have to be the normal way of describing the goods in question. It is sufficient that the mark could be used for such a purpose. A mark is therefore objectionable if at least one of its possible meanings designates a characteristic of the goods in question.
13. The subject mark consists of two simple English words “Secret Recipe”. It has no other added element or stylization. Whilst the word “secret” means “a fact that is known by only a small number of people and is not told to anyone else”, the word “recipe” is defined as “a list of ingredients and directions for making something, esp. a food preparation” (Collins English Dictionary). When put together, the two words simply mean the ingredients and the directions of making something are known by only a few people.
14. The objectionable goods are mainly food and beverage items. When the subject mark is used in respect of the objectionable goods, the direct and obvious meaning that would convey to the relevant consumers is that those goods are made by a method and with ingredients known by only a small number of people. As such, the overall impression that the relevant consumers would have is that the subject mark designates the characteristics of those goods, namely that the goods are made with a secret formula.
15. At the hearing, Ms. Low submits that the subject mark introduces a unique and intriguing concept which would arouse the curiosity of the consumers in knowing what is so special about the goods in question. In her words, the subject mark depicts the process in which some of the goods in question are hand-made and that they are made out of love and passion.
16. I do not agree that a unique or intriguing concept has been put forward. As indicated above, upon seeing the subject mark being used on the goods in question, the consumers would only perceive those goods are made with a secret formula. I agree with Ms. Low though that the subject mark depicts the very process in which the goods in question are made. This, however, means that the mark is

indicative of the characteristics of those goods rather than indicative of trade origin. Indeed, various other traders have made use of the subject mark to describe the nature of their signature products. The Internet references cited during the examination stage, as set out in the Appendix, reinforce that the subject mark is commonly used by other traders in relation to food and beverage items.

17. Based on the above findings, I consider the subject mark consists exclusively of a sign that may serve to designate the characteristics of the objectionable goods. The subject mark is therefore debarred from registration in respect of the objectionable goods under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

18. Section 11(1)(b) of the Ordinance precludes registration of trade marks which are devoid of any distinctive character. The public interest underlying section 11(1)(b) of the Ordinance is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (*Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM* (Case C-173/04P) [2006] E.T.M.R. 41 at paragraphs 60-61).

19. In *Host Hotels & Resorts, L.P. v Registrar of Trade Marks* (HCMP 554/2009), the Hon Sakhrani J cited with approval the following cases (paras 17-18):

“17. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 Jacob J as he then was) said at page 306:

“What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

18. In *Nestle SA's Trade Mark Application (Have a Break)* [2004] FSR 2 Sir Andrew Morritt VC (as he then was) said at paragraph 23:

“The distinctiveness to be considered is that which identifies a product as originating from a particular undertaking. Such distinctiveness is to be considered by reference to goods of the class for which registration is sought and consumers of those goods. In relation to the consumers of those goods the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers. For my part I would particularly emphasise that the relevant distinctiveness is that which identifies a product as originating from a particular undertaking.....”

20. According to the above legal principles, I have to assess a mark’s distinctiveness by reference to the goods applied for, and the perception of the relevant consumers, who are presumed to be reasonably well-informed, circumspect and observant. To determine whether the subject mark has any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the mark, assuming no use, serves to identify the applicant’s products as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. In other words, the question is whether the perception and recollection the subject mark would trigger in the mind of the average consumer of the applied-for goods would be origin specific (i.e. carry connotations of trade origin) or origin neutral (“*CYCLING IS...*” *Trade Mark Applications* [2002] R.P.C. 37 at paragraphs 66-69).
21. By virtue of the nature of the objectionable goods, the relevant consumers are ordinary members of the general public in Hong Kong who would purchase food and beverage items from time to time. They are likely to come across the subject mark in advertisements, promotional materials or websites for promoting the goods in question or on the goods themselves and their packaging. They are reasonably well-informed and circumspect but they cannot be expected to exercise more than an average level of care and attention in their selection of such products.
22. As explained in paragraph 14 above, the subject mark simply means the goods in question are made with a secret formula. This is the direct and immediate message that is conveyed to the relevant consumers. As such, the relevant consumers are likely to perceive the subject mark, on first impression, as an indication that the objectionable goods are made with a secret formula or method.

In other words, the subject mark does not inform the consumers of the commercial origin of the goods in question, and the message conveyed by the subject mark is origin neutral.

23. At the hearing, Ms. Low avers that the subject mark is stylised and original as it is derived from the applicant's company name. I do not agree. The subject mark is made up of the simple English words "Secret Recipe" and the words are easily comprehensible in the script form which it has adopted. The adoption of such script form in the presentation of the subject mark fails to endow the subject mark with a distinctive character as a whole. Besides, the fact that the subject mark is original and is derived from the applicant's company name is not relevant for the purposes of this application either. The question is whether the perception which the subject mark would trigger in the mind of the average consumer when it is used in relation to the goods in question would be origin specific. Given the direct descriptive nature of the mark as discussed above, I am not satisfied that without first educating the relevant consumers that the subject mark is a trade mark, the consumers would perceive the subject mark as a badge of origin so as to distinguish the applicant's goods from those of other traders.
24. In view of the message conveyed by the subject mark in the context of the objectionable goods, the subject mark fails to perform the essential function of a trade mark in guaranteeing the identity of the origin of those goods by enabling the relevant consumers to distinguish those goods from those of other traders. I conclude that the subject mark is devoid of any distinctive character in respect of the objectionable goods and is thus precluded from registration under section 11(1)(b) of the Ordinance.

Acquired distinctiveness

25. Although I have found that the subject mark has no inherent distinctive character and not registrable under section 11(1)(b) and 11(1)(c) in respect of the objectionable goods, if the subject mark has in fact acquired a distinctive character as a result of the use made of it in respect of those goods for the purpose of section 11(2), the application for registration should not be refused. I shall therefore

proceed to consider whether the subject mark has in fact acquired a distinctive character in respect of the objectionable goods with reference to the evidence of use filed by way of the Declarations.

26. To assess the acquired distinctiveness of a mark, the ECJ stated in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots-und Segelzubehör Walter Huber and Another* (Joined Cases C-108 and 109/97), [2000] Ch. 523:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied...

54. ... a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings.”

27. Although the above case is concerned with the interpretation of Article 3(3) of the First Council Directive 89/104/EEC¹, the provisions of the article are broadly similar to section 11(2) of the Ordinance and I find that the relevant principle is applicable to the subject application. Further to the principle above, the competent authority must make an overall assessment of the evidence in determining the question. The crucial question to ask is whether the relevant consumers referred to in paragraph 21 above have been educated to recognise the subject mark as a badge of origin of the objectionable goods. If I consider that a

¹ That Directive has now been replaced by Directive EEC/95/2008, but the relevant provisions remain essentially the same.

significant proportion of the relevant class of consumers identifies those goods as originating from a particular undertaking because of the use made by the subject mark before the application date, the objection raised against the subject mark under section 11(1)(b) and 11(1)(c) of the Ordinance would be overcome.

28. The relevant date in determining whether the subject mark has in fact acquired a distinctive character is 28 June 2005, the filing date of the subject application. No fixed rule can be laid down as to the minimum period of use necessary, although the Registrar looks for a reasonable period of use, usually about five years prior to the application date. Extensive use over a shorter period may well be sufficient, although use for less than two years prior to the date of application would very unlikely be regarded as sufficient.
29. The overall picture presented by the Declarations can be summarized as follows – the subject mark has been used by the applicant since 1998 in connection with its chain of “Secret Recipe” café outlets offering a variety of cakes, desserts and fusion meals and has since expanded its presence from Malaysia to Singapore, Indonesia and Thailand through its franchise system up to the filing date of the subject application. However, from the evidence filed, I am not satisfied that the subject mark has in fact acquired a distinctive character in respect of the objectionable goods as a result of the use made of it under section 11(2) of the Ordinance. I will now explain why acquired distinctiveness has not been established in respect of those goods.
30. Both the Poh Affidavit and Pang Affidavit are of just one-page long in showing that both deponents view that the applicant’s outlets are famous and popular in Asian countries and that both of them have patronised its outlets in Malaysia. However, the Poh Affidavit submitted to us was not the original affidavit but a copy of such. Thus, I consider that the Poh Affidavit is of doubtful evidential weight for the purpose of this application.
31. As regards the Pang Affidavit which was sworn in Malaysia, I discover that it was not sworn in front of authorized persons. Pursuant to rule 80 of the Trade Marks Rules (Cap. 559A) (the “Rules”), an affidavit, if made outside Hong Kong, has to be made before any court, judge, justice of the peace, notary, notary public, consul or other person authorized by law to administer an oath or to exercise notarial

functions in that place for the purpose of any legal proceeding. I also note that unlike the Pang Affidavit, the Sim Declaration and Sim Supplemental Declaration were declared before the Commissioner for Oaths and Notary Public in Malaysia respectively. In the circumstances, I am not satisfied that the Pang Declaration complied with Rule 80 and is of doubtful evidential weight for the purpose of this application.

32. Turning to the Sim Declaration and Sim Supplemental Declaration, Mr. Sim declares that the applicant has used the subject mark since 1998; as at the date of the application, its outlets are located in Malaysia, Singapore, Indonesia and Thailand and have become extremely popular. Further, Mr. Sim avers that the numerous outlets are patronised by locals as well as foreigners and that the applicant's publicity and recognition extend well beyond the countries where its outlets are located (paragraph 7, Sim Declaration); in his view, the subject mark is also well-known amongst Hong Kong residents (paragraph 8, Sim Declaration) as evidenced by the Poh Affidavit and the Pang Affidavit.

33. Despite the above assertions that the applicant's outlets have become extremely popular in Asian countries, the applicant has not put forward any evidence to support the contention that members of the general public in Hong Kong have come across the subject mark in respect of the objectionable goods. The newspaper clippings in Exhibit 1 of the Sim Declaration only show that the "Secret Recipe" outlets are located in Malaysia, Singapore, Indonesia and Thailand before the date of the filing of the application. There was no evidence showing the market share held by the mark has extended to HK for the applicant has no outlet in Hong Kong. Indeed, at the hearing, Ms. Low acknowledged that the applicant has not yet opened any outlet in town. She submitted that people nowadays get to travel and some of them may have come across the subject mark in countries where the applicant's outlets are located. However, there was no evidence, say a breakdown of sales figures of its outlets showing the portion attributable to sales to Hong Kong consumers or the number of Hong Kong people purchasing the applicant's objectionable goods, to substantiate its assertions.

34. There was no evidence supporting the claim that the subject mark is well-known amongst Hong Kong residents either. Whilst I do not rule out the possibility that people get to travel and some consumers in Hong Kong may have come across the

subject mark, this is a far cry from saying that a substantial number of people here in Hong Kong recognised the mark. Indeed, the Poh Affidavit and Pang Affidavit only represent the views of two Hong Kong residents, which even if I were to ignore their doubtful evidential nature and treated them as having been properly filed as evidence, they do not assist in showing that a significant proportion of the relevant consumers in Hong Kong, because of the mark, could identify the goods as originating from the applicant. Any claimed reputation of the mark here must be proven by reference to actual evidence and not simply by reliance on an assumption that, because of certain circumstances, the mark must have a reputation here. Given there is no information showing the extent that the sales of the objectionable goods in other countries can lead to the education of the consumers in Hong Kong of the trade mark significance of the subject mark, I am not satisfied that a case of spill-over of overseas sales to the Hong Kong consumers can be made out.

35. The applicant has also given us the total gross income obtained from its outlets from 2003-2005 (paragraph 13, Sim Declaration), i.e. only two years before the filing of the application. The objectionable goods cover a wide spectrum of food and beverage products in Class 30. However, no invoices were produced to substantiate the sales recorded, nor has the applicant provided to us a breakdown of sales in respect of each of the objectionable goods and in each of the countries where the outlets are located. In any event, with no outlets in Hong Kong, I am not satisfied that the total gross income of the applicant's outlets elsewhere assists the applicant for there has been no use of the subject mark in respect of the goods in question in Hong Kong.

36. Under paragraph 14 of the Sim Declaration, the applicant has also shown to us evidences of expenditure incurred in relation to promotions and advertising of the subject mark worldwide. However, no information was available on the amount of advertising expenditure incurred for the promotion of the subject mark in respect of each of the objectionable goods. From the expenditure invoices produced (Exhibit 5, Sim Declaration), some of which were post-dated and in Malay, they only show that the applicant had invested in some promotion outside of Hong Kong. With no breakdown of advertising figures for Hong Kong, I fail to see how much effort the applicant has spent on advertising to educate the relevant consumers in Hong Kong of the trade mark significance of the subject

mark in respect of all the objectionable goods.

37. On the other hand, the applicant has indicated that the extensive media coverage and co-branding with other organizations illustrate that the subject mark has attained goodwill and reputation in respect of its outlets (paragraphs 9 & 11, Sim Declaration; paragraph 8, Sim Supplemental Declaration). It is noted that most newspaper clippings show that the subject mark is being used by the applicant in its retail services rather than being used on the actual objectionable goods themselves. Further, almost all of the newspaper clippings (Exhibit 1 in both the Sim Declaration and Sim Supplemental Declaration) were extracted from local newspaper or magazines in Malaysia or Singapore. There is no evidence that such materials are in circulation in Hong Kong. In addition, the Internet cake ordering service of the applicant, as mentioned in various newspaper clippings, tends to show that the subject mark has been used on its retail services of such products whilst I also note that such ordering service is not made available to the relevant consumers in Hong Kong. Likewise, the co-branding promotions with other organizations in Malaysia or Singapore, and the brand packaging materials in the form of gift boxes or insulation bags used in Malaysia or Singapore (Exhibit 3, Sim Declaration), fail to support the contention that the subject mark has been used and exposed to the relevant consumers in Hong Kong.
38. Concerning the awards obtained by the applicant prior to the date of the filing of the application (paragraph 12, Sim Declaration; paragraph 8, Sim Supplemental Declaration), they were mostly awarded by Malaysian or Singaporean organizations, for instance, the Special Awards for Product Excellence (Development of Malaysian Brand Name) and Book of Records (Exhibit 4, Sim Declaration; Exhibit 1, Sim Supplemental Declaration). With no evidence of use of the subject mark in Hong Kong, I am not of the view that the awards obtained outside of Hong Kong support the claim that the subject mark has acquired a distinctive character here in Hong Kong.
39. Many of the materials provided are posterior to the date of the filing of this application, such as the signing of franchise agreements with relevant parties from Sabah, India and New Zealand in 2006 (Exhibit 2, Sim Declaration), various newspaper clippings and the list of outlets set up outside of Hong Kong, international promotion materials in Australia, Brunei, China, Pakistan and

Philippines and sponsorship segment featuring Ms. Tourism International (Exhibit 1, Sim Supplemental Declaration). They fail to show that the subject mark has, before the date of application for registration, acquired a distinctive character as a result of the use made of it in Hong Kong.

40. Ms Low has submitted to me at the hearing an information pack of the applicant containing leaflets showing the different types of cakes available at its outlets as well as two corporate video and business presentation VCDs, and a folder containing various newspaper clippings mostly relating to the business of the applicant's outlets. However, since the materials submitted were not filed by way of a statutory declaration or an affidavit in accordance with rule 79 of the Trade Marks Rules (Cap. 559A), I am unable to treat them as formal evidence filed in support of the subject application. Even if they had been properly filed as evidence, they do not assist in showing that a significant proportion of the relevant consumers in Hong Kong would, because of the subject mark, identify those goods as originating from the applicant as most newspaper clippings are posterior to the date of application and, in any event, they are not in circulation in Hong Kong.

41. On the whole, with no evidence of use before me of the subject mark in Hong Kong, I am not satisfied that the subject mark has come to be identified by the relevant consumers as an indication of trade origin distinguishing the objectionable goods of the applicant from those of others for the purpose of section 11(2) of the Ordinance. It follows that the objections raised under sections 11(1)(b) and 11(1)(c) of the Ordinance against the subject application cannot be overcome pursuant to section 11(2).

Other matter

42. Ms. Low submits that the subject mark has been accepted for registration in Malaysia, Indonesia, Thailand, New Zealand, United Arab of Emirates, Philippines, Oman, Canada, Saudi Arabia, Australia, Singapore, Pakistan, Qatar, Brunei and Japan. It should be noted that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for

registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As valid reasons for refusal have been found, I am not persuaded that the subject mark should be accepted merely by following the decisions of other registries, in particular, when I am not aware of the reasons behind the acceptances.

Conclusion

43. In this decision, I have carefully considered all the documents filed by the applicant together with all the oral and written submissions made in respect of the application. For the reasons stated above, I find that the subject mark is precluded from registration by section 11(1)(b) and 11(1)(c) of the Ordinance in respect of the objectionable goods. The application is accordingly refused under section 42(4)(b) of the Ordinance in respect of these goods.

44. As I find that the registration of the subject mark can be accepted in respect of the unobjectionable services indicated in paragraph 7 above, the application for registration in respect of such services can proceed to publication, provided that the applicant files, on or before **15 December 2010**, a Form T5A to restrict the specification by deleting the objectionable goods. If the applicant fails to do so on or before **15 December 2010**, it will be deemed to have abandoned the application.

Karine Lai
for Registrar of Trade Marks
15 November 2010

Appendix

- KFC still guards Colonel's **secret recipe**
"This **secret recipe** really ensures that we have a product that people love and that nobody else can serve them," Dedrick said.
(www.msnbc.msn.com/id/8667946/)
- Garlic Mashed Potatoes **Secret Recipe**
By: AUSTAD
"This is my **secret recipe** for Garlic Mashed potatoes, reverse engineered from a certain Italian restaurant. This recipe is for 100 servings, I usually cut it down to 10 servings (1 51b bag of potatoes). I guarantee that these are the best potatoes you've ever tasted."
(sidedish.allrecipes.com/az/GrlicMshdPttsScrtRcip.asp)
- The "**Secret**" **Recipe** For Orange Julius
Put orange juice in blender. Fill with ice to 3/4 full. Add water to just cover ice. Add syrup and "secret powder" (i.e. instant vanilla pudding mix; use a good brand). Blend until smooth.
(www.ichef.com/recipe.cfm?task=display&itemid=74703&recipeid=74366)
- The Coca-Cola formula is http://en.wikipedia.org/wiki/The_Coca-Cola_Company [The Coca-Cola Company's] top-**secret recipe** for [Coca-Cola]. The formula is considered one of the most closely-held in modern business. Only a few top Coca-Cola employees are reported to know or have access to the formula.
(en.wikipedia.org/wiki/Coca-Cola_formula)
- Welcome to the Golden Grid Fish Restaurant web site!
In 1999 the restaurant became home to the Greenlays 1873 **Secret Recipe** Sausage. These unique sausages are extremely popular with customers and may be bought to take away.
(www.goldengrid.co.uk)