

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO. : 301232009AA

MARK : ^a RICE PAPER
^b rice paper
^c *rice paper*

APPLICANT : MAXIM'S CATERERS LIMITED

CLASS : 16, 30, 35

STATEMENT OF REASONS FOR DECISION

Background

1. On 3 November 2008, Maxim's Caterers Limited ("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 three marks in series ("the subject marks"):

^a RICE PAPER
^b rice paper
^c *rice paper*

The application is in respect of the goods and services set out in Appendix I hereto.

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 marks consist exclusively of a sign which designates the characteristics of the goods and services applied for and that they are 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 marks and this was scheduled to take place on 24 August 2011. The applicant filed Form

T12 on 27 July 2011 but subsequently informed the Registrar that they would not attend the hearing. Pursuant to rule 75(b) of the Trade Marks Rules (Cap. 559, sub leg), I now proceed to decide the matter without a hearing.

4. In support of the subject application, the applicant had filed the following statutory declarations with a view to showing that the subject marks had in fact acquired a distinctive character as a result of the use made of them for the purpose of section 11(2) of the Ordinance:-

(i) Statutory Declaration of Wu Wei Kuo Michael dated 26 April 2010 (“Wu Declaration”)

(ii) Supplementary Statutory Declaration of Wu Wei Kuo Michael dated 18 August 2011 (“Wu Supplemental Declaration”)

(collectively, the “Declarations”)

5. A Form T3 was filed by the applicant prior to the hearing to divide trade mark application number 301232009 into two separate applications, i.e. application numbers 301232009AA (“the subject application”) and 301232009AB. Trade mark application number 301232009AB covering goods and services under Classes 29 and 43 has already been accepted and published. Hence the task before me is to consider the registrability of the subject marks in respect of the applied-for goods and services under Classes 16, 30 and 35 of the subject application.

The Ordinance

6. 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) ...”

7. 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

8. Having considered all the relevant facts, I consider that the subject marks are acceptable for registration in respect of

- (i) “plastic materials for packaging (not included in other classes)” in Class 16
- (ii) “Coffee, artificial coffee, coffee substitutes; tea, tea leaves and tea products; cocoa, cocoa powder and cocoa products; almond flakes; chocolate; macaroni, spaghetti, noodles and pasta products; honey; treacle; yeast; baking powder; salt; sugar; vinegar; mustard; pepper, spices; horseradish sauces; sauces (condiment); salad dressing; ketchup; curry; ice; tapioca; sago; ice-cream; mayonnaise” in Class 30
- (iii) “Advertising; business management; business administration; office functions; advertising by mail order; business consultancy (professional-); business information; business inquiries; business investigations; business management assistance; business management consultancy; business organization consultancy; business research; commercial or industrial management assistance; demonstration of goods; direct mail advertising; dissemination of advertising matter; distribution of samples; organization of exhibitions for commercial or advertising purposes; import-export agencies; marketing research; marketing studies; organization of trade fairs for commercial or advertising purposes; sales

promotion (for others); updating of advertising material” in Class 35

on a *prima facie* basis (the “unobjectionable goods and services”). Subject to meeting the requirements stipulated in paragraph 32 below, the subject marks insofar as they are in respect of the unobjectionable goods and services may proceed to registration.

9. For the rest of this statement of reasons, therefore, I shall consider the subject application insofar as it is in respect of
 - (i) “Paper, cardboard and goods made from these material, not included in other classes; printed matters” in Class 16
 - (ii) “bread; biscuits; cakes; snack food, cookies; crackers; Chinese cakes and Western style cakes; Chinese dumplings; bread sticks; pancakes; desserts; pudding; pastry and confectionery; flour and preparation made from cereals; rice; all included in Class 30” in Class 30
 - (iii) “retail and distribution (distributorship) services connected with food” in Class 35(collectively, the “objectionable goods and services”).

Inherent registrability

Section 11(1)(c) of the Ordinance

10. 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.
11. 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 of 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.”

12. 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...”

13. 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.

14. The subject marks consist of two simple English words “rice paper”. The letters in applied-for mark A are in upper case whilst the letters in applied-for marks B and C are in lower case. Notwithstanding the applied-for mark C is in a particular script form, the overall impression conveyed by the mark is still the words “rice paper”. It has no other added element or stylisation.
15. As indicated to the applicant at the examination stage, the subject marks which comprise the words “rice paper” generally refer to paper made from the pith of a rice-paper plant or from other plant source. It can mean “kind of thin paper used by Chinese artists for painting or edible kind used in cooking and for packing cakes, sweets, etc.” (Oxford Advanced Learner’s English-Chinese Dictionary, Revised 3rd Edition).
16. The objectionable goods and services are ordinary paper related products, food products as well as the retail and distribution services of food products. When the subject marks are used in respect of the objectionable goods and services, the direct and obvious meanings that would convey to the relevant consumers are that (a) for the objectionable goods under Class 16, they are made of or contain rice paper, (b) for the objectionable goods under Class 30, they are food products made of, contain or wrapped by rice paper, and (c) for the objectionable services under Class 35, they are retail and distribution services relating to food products which are made of, contain or wrapped by rice paper. As such, the overall impression that the relevant consumers would have is that the subject marks designate the characteristics of the objectionable goods and services.
17. Based on the above findings, I consider the subject marks consist exclusively of a sign that may serve to designate the characteristics of the objectionable goods and services. The subject marks are therefore debarred from registration in respect of the objectionable goods and services 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 & 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 and services 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 marks have any distinctive character for the purpose of section 11(1)(b) of the Ordinance, the relevant question is whether the marks, assuming no use, serve to identify the

applicant's goods and services 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 marks would trigger in the mind of the average consumer of the applied-for goods and services 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 and services, the relevant consumers are general members of the public in Hong Kong. They are likely to come across the subject marks in advertisements or promotional materials for promoting the goods and services 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 goods and services.
22. As explained in paragraph 15 above, the subject marks simply mean paper made from parts of the rice plant or from other plant source and can, for example, include a kind of thin paper used for painting or writing or for eating and cooking. 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 marks, on first impression, as an indication that the objectionable goods relate to, are made of, contain or wrapped by a kind of thin paper for painting, writing, eating or cooking, and the objectionable services relate to the retail and distribution services of food products which are made of, contain or wrapped by rice paper. In other words, the subject marks do not inform the consumers of the origin of the goods and services in question, and the message conveyed by the subject marks is origin neutral.
23. In view of the message conveyed by the subject marks in the context of the objectionable goods and services, the subject marks fail to perform the essential function of a trade mark in guaranteeing the identity of the origin of those goods and services by enabling the relevant consumers to distinguish them from those of other traders. I conclude that the subject marks are devoid of any distinctive character in respect of the objectionable goods and services and are thus precluded from registration under section 11(1)(b) of the Ordinance.

Acquired distinctiveness

24. Although I have found that the subject marks lack inherent distinctive character and are not registrable under section 11(1)(b) and 11(1)(c) in respect of the objectionable goods and services, if the subject marks have in fact acquired a distinctive character as a result of the use made of them in respect of those goods and services for the purpose of section 11(2), the application for registration should not be refused. I shall therefore proceed to consider whether the subject marks have in fact acquired a distinctive character in respect of the objectionable goods and services with reference to the evidence of use filed by way of the Declarations.
25. 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.”
26. 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 marks as a badge of origin of the objectionable goods and services. If I consider that a significant proportion of the relevant class of consumers identifies those goods and services as originating from a particular undertaking because of the use made by the subject marks before the application date, the objection raised against the subject marks under section 11(1)(b) and 11(1)(c) of the Ordinance would be overcome.

27. The relevant date in determining whether the subject marks have in fact acquired a distinctive character is 3 November 2008, 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.

28. Mr. Wu deposed to in the Wu Declaration that the applicant established a brand “rice paper” focusing on Vietnamese cuisine in 2004. The first restaurant under the subject marks was opened in the same year and that was when the applicant first used the subject marks. As at the date of the application, the applicant has three “rice paper” restaurants in Hong Kong. As I find it, all the exhibits in the Wu Declaration, including samples of in-store point of sale materials (Exhibit “MW-1”), copies of restaurant photos (Exhibit “MW-2”), the list of applicant’s restaurants (Exhibit “MW-3”), sample advertisements and articles (Exhibit “MW-4”), internet extracts relating to commentaries from consumers who patronised the applicant’s restaurants (Exhibits “MW-5” to “MW-9”), as well as the exhibits in the Wu Supplemental Declaration, including copies of promotional materials of the restaurants (Exhibit “MW-1”), are in relation to use of the subject marks in respect of the applicant’s restaurant services. Besides,

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

some of the materials provided are posterior to the date of the filing of this application, such as the advertisements in the Eat & Travel magazine and the Weekend Weekly (MW-4, Wu Declaration). In addition, although Mr. Wu has given us the figures of the total gross sales and the promotional expenditure figures incurred in relation to the marketing and promotion of the “rice paper” restaurants from 2004 to 2009 (para 6, Wu Declaration), there was no documentary evidence in support. In any event, even ignoring the deficiencies in the evidence filed, it is clear that all the evidence filed only indicates use of the subject marks in respect of the applicant’s restaurant services since 2004.

29. There was simply no allegation or evidence for the use of the subject marks on any of the objectionable goods and services. In particular, for the objectionable goods in Class 16, there was no allegation and evidence on the use of the subject marks in relation to sale of any paper products. For the objectionable goods in Class 30, there was no allegation and evidence on the use of the subject marks in relation to sale of any flour and preparation made from cereals and food products *such as* bread, biscuits, cakes, snack food, dumplings, desserts, confectionary, rice and so on. For the objectionable services in Class 35, there was no allegation and evidence on the use of the subject marks in relation to any retail and distribution services connected with food which are different from restaurant services. The applicant has not advanced any allegation or argument to suggest that the provision of food in its restaurants for consumption which should be services in Class 42 falls within the scope of retail and distribution services connected with food in Class 35. Nor do I find any effort has been spent on advertising to educate the relevant consumers of the trade mark significance of the subject marks in respect of any of the objectionable goods and services other than its restaurant services. Hence, the use of the subject marks for restaurant services fails to demonstrate that the subject marks have become identified, in the minds of the public, with the objectionable goods and services themselves.
30. On the whole, with no evidence of use before me of the use of the subject marks on the objectionable goods and services, the subject marks have failed to acquire a distinctive character in respect of the objectionable goods and services as a result of the use made of them. I am not satisfied that the subject marks have come to be identified by the relevant consumers as an indication of trade origin distinguishing the objectionable goods and services 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).

Conclusion

31. In this decision, I have carefully considered all the documents filed by the applicant in respect of the application. For the reasons stated above, I find that the subject marks are precluded from registration by section 11(1)(b) and 11(1)(c) of the Ordinance in respect of the objectionable goods and services. The application is accordingly refused under section 42(4)(b) of the Ordinance in respect of those goods and services.

32. As I find that the registration of the subject marks can be accepted in respect of the unobjectionable goods and services indicated in paragraph 8 above, the application for registration in respect of such goods and services can proceed to publication, provided that the applicant files, on or before 13 February 2012, a Form T5A to restrict the specification by deleting the objectionable goods and services. If the applicant fails to do so on or before 13 February 2012, it will be deemed to have abandoned the application.

Karine Lai
for Registrar of Trade Marks
13 January 2012

Appendix I

Class 16

Paper, cardboard and goods made from these material, not included in other classes; printed matters; plastic materials for packaging (not included in other classes).

Class 29

Meat and preserved meat; fish; poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; compotes; eggs; milk and milk products; milk powder; cream; edible oils and fats; yoghurt; sandwich spread on the basis of milk; nuts; pickles; preserved and dried sea products (except fish); soup stocks; all included in Class 29.

Class 30

Coffee, artificial coffee, coffee substitutes; tea, tea leaves and tea products; cocoa, cocoa powder and cocoa products; bread; biscuits; cakes; snack food, cookies; crackers; Chinese cakes and Western style cakes; Chinese dumplings, almond flakes; chocolate; bread sticks; pancakes; desserts; pudding; pastry and confectionery; macaroni, spaghetti, noodles and pasta products; flour and preparation made from cereals; honey; treacle; yeast; baking powder; salt; sugar; vinegar; mustard; pepper, spices; horseradish sauces; sauces (condiment); salad dressing; ketchup; curry; ice; rice; tapioca; sago; ice-cream; mayonnaise; all included in Class 30.

Class 35

Advertising; business management; business administration; office functions; advertising by mail order; business consultancy (professional-); business information; business inquiries; business investigations; business management assistance; business management consultancy; business organization consultancy; business research; commercial or industrial management assistance; demonstration of goods; direct mail advertising; dissemination of advertising matter; distribution of samples; organization of exhibitions for commercial or advertising purposes; import-export agencies; marketing research; marketing studies; organization of trade fairs for commercial or advertising purposes; sales promotion (for others); updating of advertising material; retail and distribution (distributorship) services connected with food.

Class 43

Provision and preparations of take-away food on behalf of third parties; restaurant, café and catering services; all included in Class 43.

Appendix II

http://feastandfamine.com/rice_paper_rolls.html

Rice Paper Rolls with spicy passion fruit sauce

Working with one **rice paper** at a time, dip in water and remove quickly.

www.taasty.com/hk/rice-paper

rice paper rolls are the specialty of this restaurant.

<http://aww.ninemsn.com.au/article.aspx?id=176511>

Rice paper for confectionery is available from some supermarkets, health food stores and kitchenware stores.

www.rice-paper.com