

Application No. 9918/2000

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

AND

IN THE MATTER of an application by  
Kabushiki Kaisha Sony CP Laboratories for the  
registration of the trade mark **BEAUTY  
SUPPLEMENT C-WHITE** in Class 32

**DECISION  
OF**

Mr. Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's decision made by Messrs. Sit Fung Kwong & Shum on behalf of the applicant.

1. On 8 May 2000, Kabushiki Kaisha Sony CP Laboratories (Sony CP Laboratories Inc.) a corporation of Japan (“the applicant”), applied, pursuant to the provisions of the Trade Marks Ordinance (“the Ordinance”), to register, in Part A of the Trade Marks Register (“the Register”), in Class 32, the trade mark “BEAUTY SUPPLEMENT C-WHITE” (“the subject mark”). The goods for which registration was sought were : “beverages; soft drinks; fruit drinks and fruit juices; whey beverages; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages; all included in Class 32”.

2. The Registrar of Trade Marks (“the Registrar”) determined that the words “BEAUTY SUPPLEMENT C-WHITE” were a direct reference to the character or quality of the goods, and further, the subject mark was neither inherently adapted to distinguish nor inherently capable of distinguishing the applicant’s goods from similar goods of others. The subject mark was accordingly unacceptable for registration, *prima facie*, in either Part A or Part B of the Register.

3. The applicant did not contest the determination regarding Part A registration but argued that the suit mark qualified for registration in Part B of the Register. To facilitate the re-examination of the suit mark, the applicant sought permission to amend the application by transferring the application from Part A to Part B of the Register. The Registrar was not persuaded by the arguments that the suit mark was registrable in Part B. The applicant then offered to separately disclaim the words “BEAUTY”, “SUPPLEMENT”, “WHITE” and the letter “C”. The Registrar determined that such disclaimers did not assist the application.

4. The impasse thus reached became the subject of an “informal discussion” between the applicant’s agents and the Registrar. The Registrar maintained his position with regard to the mark being *prima facie* unregistrable and it is from this decision that the applicant has requested the Registrar to state in writing the grounds for his decision and the materials used by him in arriving at it. These are given as follows :

5. Section 9 of the Ordinance is a restrictive provision. Registration in Part A can only be achieved if the mark contains or consists of at least one of the essential particulars listed in paragraph 1(a) – (e) inclusive.

6. The subject mark is not the name of a company, individual or firm represented in a special or particular manner within the meaning of section 9(1)(a) of the Ordinance; nor does it comprise the signature of the applicant for registration or some predecessor in his business within the meaning of section 9(1)(b) of the Ordinance. Neither “beauty”, “supplement”, nor “c-white” are invented words within the meaning of section 9(1)(c). I turn to the question whether the words of the suit mark satisfied the requirements of section 9(1)(d) as “a word or words having no direct reference to the character or quality of the goods ...”, the prohibition relating to the registration of geographical names or surnames not being relevant in the context of the subject mark.

7. The test to be applied was succinctly stated by Dixon C.J. in *Mark Foy's Limited v Davies Coop & Company Limited* [1956] 95 CLR 190 at 195,

“The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess.”

8. The words “BEAUTY SUPPLEMENT” unequivocally inform the purchaser that an attribute of the beverage in question is that of a supplement which will enhance beauty. The letter “C” would be readily understood as referring to vitamin C, which has for some years been advanced as a skin lightening agent and an aid to health and skin beauty. I shall amplify this in the succeeding paragraphs, but before doing so I need add that it is settled law that in determining whether a word or words have a direct reference to the character or quality of the goods, they are not limited to their strict grammatical significance but are to be regarded as they would present themselves to the public at large – *Keystone Knitting* (1928) 45 RPC 421 at 426. A word need not be adjectival to be descriptive.

9. That the “C” in the subject mark refers to vitamin C is apparent from a photograph of the applicant’s goods in use found on the cover of a pamphlet issued by the applicant. The label attached to the bottle, on the first line contains the words “beauty supplement”; on the second line “C-WHITE”, at least twice the size of the words on the first line; on the third line “POWER VITAMIN C”; on the fourth line “1000 mg”. These four lines take up approximately one third of the label. Directly below is a large letter “C” taking up more than half the label. Over the lower one-third of this letter “C” is superimposed the word “VITAMIN”. Accordingly, in use, a consumer would have unequivocal additional information to correctly identify the letter “C” within the subject mark as referring to vitamin C.

10. The pamphlet refers further to the qualities of the product and lists amongst its qualities :

- prevents and inhibits production of melamin
- effectively reduces freckles to promote skin fairness
- improves clarity of complexion.

11. By letter dated 18 May 2002 the Registrar referred the applicant’s agents to a number of websites and other existing products which, in the Registrar’s view, supported the conclusions reached above. On the website [www.medidermlab.com/vitaminc.htm](http://www.medidermlab.com/vitaminc.htm) an article may be found commencing with the following paragraphs :

“There is an increasing awareness that Vitamin C has a wide variety of role in human health. New therapeutic uses are being investigated daily, among recent discoveries is that Vitamin C can play important role in the health and beauty of your skin.

Vitamin C as Ascorbyl form has been tested extensively and reported in journal of American Academy of Dermatology to inhibit the production of the melanin (Melanin is the pigment which gives the skin it's dark colour), when Vitamin C inhibit the production of the melanin, **a lighter and brighter skin will reveal** in just few weeks.” (*sic*. Emphasis as in text.)

On another page within the same website ([www.medidermlab.com/skinfading.htm](http://www.medidermlab.com/skinfading.htm)) under the heading “More on skin fading” the final paragraph reads :

“ ...Vitamin C, they are all of natural origin and considered the agents of choice of high quality, very effective skin lightening agents in the world to date.”

12. Revlon's Vitamin C Absolutes skin products, sold in Hong Kong through Watsons and other outlets, are promoted as having the properties of beautifying and whitening the skin. Kawai EC's Vitamin C supplement, also sold through Watsons and other outlets, is promoted as an aid to beauty.

13. The applicant has not commented on these materials or products beyond confirming it still required written reasons for the Registrar's decision.

14. The contraction “C-WHITE” therefore informs that the specific aspect of beauty to which this supplement is directed is that of enhancing a whiter or paler skin tone and this is how the contraction will present itself to the public at large. Read together, therefore, the words which make up the subject mark have a direct reference to the character or quality of the goods, namely, a health supplement containing vitamin C which would have the effect of lightening one's complexion thus adding to one's beauty.

15. The onus of establishing that the suit mark has no direct reference to the character or quality of the goods lies with the applicant – *Lloyd-Jacob LJ in American Screw Company Ltd's Application* [1959] 14 RPC 344. I am not satisfied that the applicant has discharged his onus of establishing that the mark has no direct reference to the character or quality of the goods.

16. I need not in the context of section 9 further consider the question whether the mark is distinctive, for section 9(1)(e) provides that a word or words having a direct reference to the character or quality of the goods shall not be registrable under the provisions of paragraph 9(1)(e) except upon evidence of its distinctiveness. No evidence of

distinctiveness has been provided.

17. Marks which are ineligible for registration by reason of having a direct reference to the character or quality of the goods in question are generally also incapable of being distinctive for the purposes of section 10 of the Ordinance. The distinctiveness addressed by section 10 is the capacity of the mark to distinguish goods with which the proprietor is or may be connected in the course of trade from goods in which no such connection subsists.

18. The entire mark comprises words having a direct reference to the character or quality of the goods. There is no single feature which can be regarded as indicating the origin of the goods, rather the entire mark merely tells you what the goods are and their purpose.

19. In *JERYL LYNN Trade Mark* [1999] FSR 491 Laddie J said at 497:

“The distinction between a sign which is capable of distinguishing for the purposes of trade mark law and one which is not can be turned into a question posed in colloquial language. Does the sign indicate who the product or service came from or does it only tell the customer what the product or service is?”

20. This quotation aptly describes why the suit mark is not capable, *prima facie*, of distinguishing, and thereby is not registrable in Part B, for the mark merely tells you what the goods are and would equally be apt to describe the goods of another.

21. It may be that with time the primary significance of the words may be displaced in the minds of consumers so that the subject mark is seen as a trade mark rather than a description of the characteristics and perceived qualities of the goods. If that is so, the application, is pre-mature at this stage. In any event, the applicant has adduced no evidence or material to satisfy me that the mark is capable of acquiring a secondary, trade mark meaning.

22. I turn now to the disclaimer offered by the applicant. A disclaimer can be accepted by the Registrar when the mark as a whole has a distinctive quality albeit that it contains or comprises several indistinctive elements. There can be no question that each of the individual elements in the mark are indistinctive in their own right. Having considered the mark as a whole I find that the combination of the elements adds no distinctiveness absent from the individual components. As stated by Lloyd-Jacob J in *Ford-Werke AG's Appln.* (1955) 72 PRC 191 at 195, attention must be focused upon the content of the mark and not upon the content of the protection sought for the mark. The offer of separate disclaimers accordingly does not assist the applicant.

23. In arriving at this decision I have given consideration to the form of the mark presented for registration; the provisions of sections 9 and 10 of the Ordinance; the written submissions of the applicant contained in their letters of 7 March 2001, 4 October 2001; the written summary dated 22 April 2002 of matters discussed in the informal discussion, and the Registrar's supplemental letter of 18 May 2002; and the authorities, website and pamphlets referred to herein.

(K.S. Kripas)  
p. Registrar of Trade Marks  
1 August 2002