

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION FOR REVOCATION OF TRADE MARK 300145683

MARK :



CLASSES : 3, 8, 9, 14, 18, 20, 21, 24, 25, 29, 30, 32, 33, 34, 39, 43

APPLICANT : HOTEL CIPRIANI SRL

REGISTERED PROPRIETOR : ALTUNIS TRADING GESTAO E SERVICOS LDA

STATEMENT OF REASONS FOR DECISION

1. Hotel Cipriani Srl (“the applicant”) applied to the Registrar of Trade Marks on 21 May 2012 to revoke the registration of the trade mark “CIPRIANI & device” in classes 3, 8, 9, 14, 18, 20, 21, 24, 25, 29, 30, 32, 33, 34, 39 and 43 under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) on the ground of non-use (the “application for revocation”). The trade mark was registered, at the time the application for revocation was filed, in the name of Altunis Trading Gestao E Servicos Lda (“the registered proprietor”).

2. The hearing of the application took place before me on 12 February 2015. Mr. Paul Stephenson, Counsel, instructed by Messrs. Wilkinson & Grist, represented the applicant. Mr. Douglas Clark, Counsel, instructed by Messrs. Deacons, Solicitors, represented the registered proprietor.

Ground for revoking the trade mark

3. The application for revocation is made under section 52(2) of the Ordinance on the ground that the trade mark has not been genuinely used in Hong Kong by the registered proprietor or with its consent, in relation to the goods and services for which it is registered.

Three-year period of non-use

4. Under section 52(2)(a) of the Ordinance, the registration may be revoked if the trade mark has not been used for a continuous period of at least three years. The application filed on 21 May 2012 seeks revocation to take effect from, perhaps due to a clerical mistake 21 February 2012, or any other date as the Registrar deems appropriate. In the present proceedings, therefore, the relevant period of the enquiry is the three year period immediately prior to 21 May 2012 or, as the pleaded case suggests, 21 February 2012. Unless stated otherwise herein below, in the present proceedings I detect no real significance in the difference of three months between the stated days, and would, for convenience, refer to the period as “the relevant 3-year period”.

Registration

5. The registration that the applicant applies to revoke is the trade mark below:



(the “subject mark”) which has been registered with registration number 300145683 in classes 3, 8, 9, 14, 18, 20, 21, 24, 25, 29, 30, 32, 33, 34, 39 and 43 in respect of the following goods and services:-

Class 3

perfumes; toilet water; gels and salts for the bath and the shower; toilet soaps; body deodorants; cosmetics namely creams, milks, lotions, gels and powders for the face, the body and the hands; sun care preparations; make-up preparations; shampoos; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers; essential oils for personal use; dentifrices; all included in Class 3.

Class 8

cutlery; forks, knives, spoons; nail clippers; razors, scissors and hand operated tools and parts and fittings thereof; all included in Class 8.

Class 9

glasses; spectacles; sunglasses; sport glasses; and cases and frames for the aforesaid; all included in Class 9.

Class 14

precious metals and their alloys and goods made of precious metals or coated therewith, not included in other classes; jewellery, precious stones, horological and chronometric instruments; watches, watch cases, watch straps; watch faces, bands, dials, buckles, hands, chains; alarm clocks; clock cases; watch crystals; all included in Class 14.

Class 18

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; rucksacks; hand bags; backpacks; suitcases and luggages; wallets (for money); pouches; boxes and cases from leather and imitation of leather; personal suitcases; small vanity cases; small suitcases for documents; cases for traveling; bags; wallets; briefcases; keys cases; toilet and cosmetic cases; document cases; business cards holders; leather strips; all included in Class 18.

Class 20

furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; all included in Class 20.

Class 21

household or kitchen utensils, not of precious metal or coated therewith; containers for storage for household or kitchen; cookware; tableware and kitchenware; serving plates/trays, combs and sponges; brushes or sponges for cleaning purposes; cosmetic applicators, cosmetic boxes, cosmetic utensils, lipstick holders, mini boxes for domestic use, all included in Class 21.

Class 24

textiles and textile goods, not included in other classes; bed and table covers, bed blankets, bed sheets, pillow cases, duvet covers, quilts, shams, bath linen, towels and wash cloths; all included in Class 24.

Class 25

clothing, footwear, headgear; all included in Class 25.

Class 29

meat, fish, poultry and seafoods; fruits and vegetables, all being preserved, dried, cooked or processed; preparations made from all of the aforesaid goods; meat extracts; eggs, milk and milk products; prepared meals and snacks; jams; edible oils; fats; margarine and butter; all included in Class 29.

Class 30

coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; pastry; pastry mixes, products shells and skins; food products and preparations made of wheat,

whole wheat, malted wheat, cereals, grains, maize, flour; wheat flour; flour; wheat meal; whole wheat grains being cooked, dried, precooked, preserved; flour preparations and products for food; aniseed; all included in Class 30.

Class 32

beer; mineral and aerated waters, non-alcoholic beverages; non-alcoholic fruit beverages, fruit juices; lemonades; syrups for beverages, syrups for lemonades, tomato juice; preparations for making beverages; anise (liqueur); all included in Class 32.

Class 33

alcoholic beverages (except beer), alcoholic beverages containing fruits, brandy, cider, digesters, gin, liqueurs, rum, vodka, whisky, wine; all included in Class 33.

Class 34

tobacco; smokers' articles; matches; all included in Class 34.

Class 39

travel arrangement services; travel agency services, organising and conducting personal tours; transportation of goods, travellers and passengers; packaging of goods; storage of goods; information and advisory services relating to the aforesaid services; all included in Class 39.

Class 43

restaurants and catering services; cafeterias, bars, night clubs, room renting, hotel accommodation services; hotel reservation; booking agency services for hotel accommodation; all included in Class 43.

(together "the registered goods and services").

The filing date of the application for registration of the subject mark, which is deemed to be also the date of registration, is 20 January 2004.

Applicant's evidence in support of the application

6. Filed with the application for revocation, besides the Statement of Grounds, were the applicant's evidence in support of the application pursuant to Rule 36 of the Trade Marks Rules, Cap. 559A (the "Rules"). The evidence consists of a statutory declaration of Man Chi Hung Edward and a statutory declaration of Helen Tang, both declared on 17 May 2012.

7. Man Chi Hung was a commercial investigator in the employ of a private investigation company which received instruction in or around mid-January 2012 from Messrs. Wilkinson & Grist, the applicant's solicitors, to conduct an investigation into the use of the subject mark. Man Chi Hung's statutory declaration sets out the process and results of the investigation.

8. From what were set out in the statutory declaration, it seems all that Mr. Man had done in relation to the investigation was to pay a visit to a restaurant called "Cipriani Hong Kong" located at 12th floor, Old Bank of China Building, Bank Street, Central, Hong Kong on 6 February 2012, talk to the captain of the restaurant and get a name card of Ms. Michelle Li, telephone Ms. Michelle Li the next day as well as on 21 February 2012 and make enquiries about whether "Cipriani Hong Kong" would provide services such as travel arrangement and hotel reservation, and products such as shampoo, perfumes and household and kitchen goods. Mr. Man observed the following out of his investigation:-

- (i) "Cipriani Hong Kong", as said by the captain, is a restaurant which offers "restaurant services" and not any other type of services; it serves clients who are members but food products and gift items can be sold to non-members.
- (ii) The telephone conversations with Ms. Michelle Li also reveals that "Cipriani Hong Kong" is purely a restaurant and it does not offer any of the services, nor does it sell any of the products, as suggested by Mr. Man. The only products Ms. Michelle Li said would be sold by the restaurant were "pasta; rice; sauces; pestos; pastes; oil; vinegar".

9. Mr. Man had also obtained from the restaurant a copy of the brochure of “CIPRIANI HONG KONG” (hereinafter referred to as the “Cipriani Brochure”), a copy of which was exhibited to Man Chi Hung’s statutory declaration as exhibit “MCHE-2”. I shall discuss about this Cipriani Brochure later in this decision.

10. As to Helen Tang’s statutory declaration, this is filed purportedly to give background information about the registered proprietor as well as the applicant’s. In gist, the applicant is owner of the trade mark “CIPRIANI” in various countries and it has filed trade mark applications in Hong Kong for the marks “CIPRIANI” and “HOTEL CIPRIANI” in Classes 35, 36 and 43. Ms. Tang is a partner of Messrs. Wilkinson & Grist, the applicant’s solicitors. The statutory declaration exhibited some company and internet searches caused to be done by Ms. Tang.

Counter-statement and registered proprietor’s evidence

11. There were altogether three statutory declarations filed pursuant to Rule 37 of the Rules, but eventually only the latest one matters as the registered proprietor’s evidence of use, whilst the first two had either been replaced by the latest one or had already served its very purpose of filing for curing or addressing some procedural issues and hence is no longer relevant. For the present purposes of considering Rule 37 evidence, I would therefore confine my consideration to the latest one, which is a statutory declaration of Giuseppe Cipriani declared on 12 April 2013 (“Cipriani’s statutory declaration”). Giuseppe Cipriani is the director of the registered proprietor. He had by then been associated with the registered proprietor for around 12 years.

12. According to Mr. Cipriani, the registered proprietor authorised Cipriani USA, Inc. (“Cipriani USA”) and Cipriani Industria, S.r.l. (“Cipriani Industria”) to use the subject mark in relation to all the goods and services in respect of which the subject mark has been registered. The registered proprietor, Cipriani USA and Cipriani Industria, along with other related companies, collectively referred to as the “Cipriani Group”, were ultimately owned by the same company which was formed after the first Cipriani-owned business was founded by Giuseppe Cipriani’s grandfather in 1931.

The business of the Cipriani Group seems to have originated in a bar in Venice called Harry's Bar which was later declared by the Italian Ministry for Cultural Affairs as a national landmark. Due to its success, the business expanded to other areas of the food and beverage industry including the opening of a number of fine restaurants and also the development of the Cipriani brand of food and drink such as pastas, sauces, olive oils, coffee, as well as kitchenware and books authorised by Giuseppe Cipriani's father, Arrigo Cipriani.

13. Mr. Cipriani further said that the Cipriani Group has not only operated in the food and beverage industry but has also expanded its business to the development and operation of luxurious apartments. The "Cipriani Club Residences at 55 Wall Street" located in New York was cited as an example. In addition, the Cipriani Group is said to also provide management and consulting services to the Mr. C Beverly Hills hotel (the "Hotel") located in Beverly Hills, California. The "C" is said to refer to the Cipriani family name.

14. Mr. Cipriani alleges that the registered proprietor has continuously used the subject mark during the relevant 3-year period in Hong Kong via, inter alia, the website <www.cipriani.com> (the "Cipriani Website") which was owned by Cipriani USA. This Cipriani Website is in English and contains a "Hong Kong" specific page which caters to Hong Kong consumers. Exhibit 1 to Cipriani's statutory declaration contains pages of printout from the Cipriani Website as well as of a Whois search result of the website; Exhibit 2 to Cipriani's statutory declaration contains printout of the Hong Kong specific page from the Cipriani Website.

15. It is alleged that if a Hong Kong consumer clicks on the tab entitled "RETAIL" at the bottom of the Cipriani Website, he or she will be able to access a page which advertises and promotes, inter alia, class 18 goods such as luggages, bags and umbrella, class 20 goods such as photo frames, class 21 goods such as cocktail shakers, class 24 goods such as cashmere throws, class 25 goods such as pashmina scarves and bath robes and class 34 goods such as ashtrays. Exhibit 3 to Cipriani's statutory declaration contains copies of printout from the "RETAIL" page of the Cipriani Website.

16. Mr. Cipriani further claims that the “RETAIL” page of the Cipriani Website also advertises and promotes, inter alia, class 29 goods such as olive oil and class 30 goods such as pasta, rice, sauces, pestos, pastes and vinegar. Exhibit 4 to Cipriani’s statutory declaration also contains copies of printout from the “RETAIL” page of the Cipriani Website, on which it is alleged that the subject mark is prominently located at the top of the Cipriani Website.

17. It is alleged that during the relevant 3-year period, Cipriani Industria also sold a number of food products, including without limitation pasta, olive oils, coffee, breads, cakes, cocktails, tomatoes, jams, vinegar, biscuits, nougats, sauces, olives and anchovies to some Hong Kong customers such as The Dairy Farm Company Ltd and Cipriani Oriental Limited, amounting to a total of around EUR 60,000 (allegedly to approximate HK\$600,000). Exhibit 5 to Cipriani’s statutory declaration contains copies of invoices evidencing the sale between Cipriani Industria and Hong Kong customers during the relevant 3-year period. On all these invoices, the subject mark can be clearly seen at the top left-hand corner.

18. Mr. Cipriani claims that it was he, his father Arrigo and Mr. David Tong who jointly established “Cipriani Hong Kong” in Hong Kong in or around 2003. “Cipriani Hong Kong” is described as being a private members’ club situated in Central, the heart of the city of Hong Kong, offering, inter alia, high-end Italian restaurant services and food and drink products. Exhibit 6 to Cipriani’s statutory declaration contains a copy of the club’s brochure which was distributed to Hong Kong consumers within at least the last 3 years before 2013.

19. Mr. Cipriani pointed out that in paragraph 9 of the statutory declaration of Man Chi Hung Edward, the club also sells pasta, rice, sauces, pestos, pastes, oil and vinegar.

20. Furthermore, Cipriani Industria is alleged to be also the owner and operator of the website <www.ciprianifood.com> (the “Cipriani Food Website”) which advertises, promotes and/or markets the goods in classes 29, 30, 32 and 33 of the registered goods and services. The Cipriani Food Website is in English and is alleged

to target consumers from all over the world including Hong Kong. Exhibit 7 to Cipriani's statutory declaration contains pages of printout from the Cipriani Food Website as well as of a Whois search result of that website. The subject mark is alleged to have been displayed prominently on the front page of the Cipriani Food Website; Exhibit 8 to Cipriani's statutory declaration contains a screen-shot of the Cipriani Food Website.

21. As for the class 43 services, Mr. Cipriani made reference to the Hong Kong specific page from the Cipriani Website, as displayed in Exhibit 2 to Cipriani's statutory declaration, and alleges that it contains contact details for Hong Kong consumers to make reservation, and a menu of the restaurant operated by the club in Hong Kong can be found on the Cipriani Website. Exhibit 9 to Cipriani's statutory declaration contains a copy of the menu from the Hong Kong page of the Cipriani Website which is alleged to have been shown to consumers within at least the last 3 years before 2013.¹

22. Mr. Cipriani further deposed that if a Hong Kong consumer clicks on the tab entitled "RESORTS" at the bottom of the Cipriani Website, he or she will be able to easily access a page dedicated to the Hotel; and on that page there is a hyperlink which allows a Hong Kong consumer to easily access the Hotel's website at <www.mrchotels.com> ("Hotel Website"). Exhibit 10 to Cipriani's statutory declaration contains copies of printout from the "RESORTS" page of the Cipriani Website as well as a printout of the Hotel Website.

23. Based on the above, Mr. Cipriani is of the view that the subject mark has been genuinely used in Hong Kong in respect of all the goods and services for which it has been registered, by or with the consent of the registered proprietor.

¹ But this copy at Exhibit 9 allegedly taken from the Cipriani Website does not seem to be downloaded from the Internet.

Applicant's additional evidence in support of the application

24. The applicant filed additional evidence, pursuant to Rule 38 of the Trade Marks Rules, Cap. 559A (the "Rules"), in support of the application. The additional evidence consists of a second statutory declaration of Helen Tang dated 22 October 2013.

25. This second statutory declaration of Helen Tang is filed mainly to comment on Cipriani's statutory declaration. The comments are of Helen Tang's own observations, I do not propose to summarize them but may refer to them if deems appropriate in the latter parts of this decision.

Decision

26. At the outset, Mr. Douglas Clark, Counsel for the registered proprietor, rightly pointed out that this application for revocation relies only on the ground of non-use and no other, as the skeleton submissions of the applicant seemed to raise at issue other grounds such as bad faith which had not been pleaded and was not appropriate for the present form of proceedings.

27. Revocation of the registration of a trade mark is provided for under section 52 of the Ordinance. In particular, section 52(2)(a) provides that the registration of a trade mark may be revoked where "the trade mark has not been genuinely used in Hong Kong by the owner or with his consent, in relation to the goods or services for which it is registered, for a continuous period of at least 3 years, and there are no valid reasons for non-use".

28. Section 52(8) provides that for the purposes of subsection (2)(a), the 3-year period may begin at any time on or after the actual date on which particulars of the trade mark were entered in the register under section 47(1), i.e., the actual date of registration of the trade mark.

29. In the present case, the application filed on 21 May 2012 seeks revocation to take effect from 21 February 2012 or any other date as the Registrar deems appropriate. I would, as discussed above, refer to the three year period immediately prior to 21 May 2012, or for that matter 21 February 2012, as “the relevant 3-year period” unless otherwise stated.

30. Section 82(1) of the Ordinance states : ‘if in any civil proceedings under this Ordinance in which the owner of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with the owner’. The result is that in an application to revoke for non-use, the onus of proof of use is on the owner of the mark in question, which in the present context is the registered proprietor.

31. Whilst this point was not expected to be seriously in dispute, Mr. Clark submitted that this is so only in relation to the evidential burden, whereas the legal burden remains on the applicant. He drew my attention to paragraph 24 of *Pan World Brands Ltd v Tripp Ltd (Extreme Trade Mark)* [2008] R.P.C. 2, in particular the last sentence of that paragraph, which is reproduced below:-

24 There was some debate at the hearing before me as to the incidence of the burden of proof. In my judgment the position is as follows. The legal burden of proving that the requirements for revocation under section 46(1)(a) or (b) [*similar to section 52(2)(a) of the Ordinance*] are met lies on the applicant for revocation. By virtue of section 100, however, the evidential burden of showing what use has been made of the mark lies upon the proprietor. Similarly, by virtue of rule 31(3)(a) [*similar to Rule 37(1) & (2)(a) of the Rules*], if the mark has not been used, the evidential burden of showing what the reasons for non-use are lies upon the proprietor. The evidential burden may shift during the course of the proceedings: if, for example, the applicant for revocation were to accept that the proprietor's evidence showed use of the trade mark but to contend that the use was not genuine because it was purely for the purpose of preserving the registration, then the evidential burden of showing that that was the case would lie upon the applicant (although the applicant might be able to discharge that burden by relying upon the proprietor's own evidence). Finally, once the evidence is complete, the tribunal should not decide whether there has been genuine use,

or proper reasons for non-use, purely on the basis that the party bearing the burden of proof has not discharged that burden unless it cannot reasonably make a finding in relation to that issue despite having striven to do so: see *Stevens v Cannon* [2005] EWCA 222 at [46].

32. I accept that the above formulation is the proper approach that should be adopted. In any event, examination of the evidence of use filed by the registered proprietor is of crucial importance, which I shall now turn to.

Use of the subject mark in Hong Kong

33. I have summarized the evidence filed by both parties in paragraphs 6 to 25 above, of which paragraphs 11 to 23 relate to the evidence of use filed by the registered proprietor by way of Cipriani's statutory declaration. Relying on the real evidence attached to the statutory declaration, Mr. Cipriani, who is the grandson of the founder of the Cipriani Group and the director of the registered proprietor, purported that the subject mark has been genuinely used in Hong Kong in respect of all the goods and services for which it has been registered, by or with the consent of the registered proprietor. At the hearing, Mr. Clark presented a table as part of the registered proprietor's written submission matching, item by item, those parts of the evidence suggesting use with the specifications of the subject mark to illustrate that the subject mark has been used on all of the registered goods and services. The table, however, deals only those of the registered goods and services in Classes 14, 18, 21, 25, 29, 30, 32, 33, 34 and 43 only.

34. It is in no doubt that all purported use of the subject mark in Hong Kong on or in respect of the registered goods and service, if at all, are either through the services offered at "Cipriani Hong Kong", or via the internet platform constituted by the Cipriani Website, the Cipriani Food Website and the Hotel Website. "Cipriani Hong Kong" is described by Mr. Cipriani as a private members' club situated in Central, the heart of the city of Hong Kong, offering, inter alia, high-end Italian restaurant services and food and drink products. The brochure of "Cipriani Hong

Kong”² gives more details about the same, while Mr. Man, the investigator acting for the applicant, described “Cipriani Hong Kong” simply as a restaurant. Whatever kind of institution one might call “Cipriani Hong Kong”, it is, after all, not that important; Ms. Michelle Li, Membership Officer of “Cipriani Hong Kong”, just confirmed that it did not offer any services other than restaurant services, nor did it sell any of the products suggested by Mr. Man except “pasta; rice; sauces; pestos; pastes; oil; vinegar”. There is little doubt that “Cipriani Hong Kong” is providing merely restaurant or catering services in Hong Kong.

35. As to the use of the subject mark on the Cipriani Website, Mr. Cipriani stated in his statutory declaration that this is in relation to the goods in Classes 18, 20, 21, 24, 25 and 34. This has to be discussed in the context of whether use of the subject mark on the website constitutes use of the mark in Hong Kong, as there are implications for issues of jurisdiction. Very often there is a general argument that use of a trade mark on a website constitutes use of the trade mark throughout the world because the website can be accessed throughout the world. Such an argument was rejected by Jacob J. in *1-800 Flowers Inc v. Phonenames Ltd* [2000] FSR 697, where he said,

“For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that the mere fact that websites can be accessed anywhere in the world does not mean... that the law should regard them as being used everywhere in the world. It all depends upon the circumstances, particularly the intention of the website owner and what the reader will understand if he accesses the site. In other fields of law publication on a website may well amount to a universal publication, but I am not concerned with that.” (in para.138 of the judgment)

36. Jacob J. had further elaborated this point in another case *Euromarket Designs Inc v Peters* [2001] F.S.R. 20. In that case, a US corporation operated the CRATE & BARREL chain of household goods stores in the US and owned UK

² The copy displayed at Exhibit 6 to Cipriani’s statutory declaration is the same as the Cipriani Brochure exhibited as “MCHE-2” to Man Chi Hung’s statutory declaration, except that it also contains the cover page of the brochure on which the subject mark is prominently displaced.

registered trade mark consisting of the words CRATE & BARREL for glassware, crockery and other goods in Class 21. The defendant owned a shop in Dublin, Ireland which had been selling furnishings and accessories under the name "Crate & Barrel". The US corporation commenced proceedings for summary judgment for infringement of its UK registration by, among other things, placing of an advertisement for the Dublin shop on the defendant's website (which bore "ie", meaning Ireland, in its address). Jacob J., after recounting the number of ways one can access the defendant's website, said,

"Whether one gets there by a search or by direct use of the address, is it rational to say that the defendants are using the words "Crate & Barrel" in the United Kingdom in the course of trade in goods? If it is, it must follow that the defendants' are using the words in every other country of the world. Miss Vitoria (plaintiff's counsel) says that the internet is accessible to the whole world. So it follows that any (Internet) user will regard any web site as being "for him" absent a reason to doubt the same. She accepted that my Bootle fishmonger example in *1-800 Flowers* is that sort of case but no more. I think it is not as simple as that. In *800 Flowers* I rejected the suggestion that the website owner should be regarded as putting a tentacle onto the user's screen. Mr. Miller (defendant's counsel) here used another analogy. He said using the internet was more like the user focusing a super-telescope into the site concerned; he asked me to imagine such a telescope set up on the Welsh hills overlooking the Irish Sea. I think Mr. Miller's analogy is apt in this case. Via the web you can look into the defendants' shop in Dublin. Indeed the very language of the internet conveys the idea of the user going to the site--"visit" is the word. Other cases would be different--a well-known example, for instance, is Amazon.com. Based in the United States it has actively gone out to seek world-wide trade, not just by use of the name on the internet but by advertising its business here, and offering and operating a real service of supply of books to this country. These defendants have done none of that."

37. The *1-800 Flowers* case did go to appeal and the judgment of the Court of Appeal (*800-Flowers Trade Mark* [2002] F.S.R. 12) came after the judgment of *Euromarket Designs Inc v Peters*. Nonetheless, Buxton L.J. of the Court of Appeal said something more or less the same:

“...it was a significant part of the applicant's submissions that, for instance, "publication" of statements in a particular jurisdiction by downloading from the Internet according to the rules of the law of defamation or of misrepresentation was of at least strong analogical relevance to whether a trade mark downloaded from the Internet had been "used" in the jurisdiction to which it was downloaded; and, even more directly, that when A placed a mark on the Internet that was downloaded by B, the same criteria should apply in determining whether A thereby used the mark as determine whether A thereby infringed the same mark in the jurisdiction where B was located.

I would wish to approach these arguments, and particularly the last of them, with caution. There is something inherently unrealistic in saying that A "uses" his mark in the United Kingdom when all that he does is to place the mark on the Internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A.” (in paras.136 and 137 of the judgment)

38. His Lordship then continued:

“...the very idea of "use" within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use.” (in para.138 of the judgment)

39. The above quoted passages from the two UK cases are, as pointed out by Lam J. in the local case *Kabushiki Laisha Yakult Honsha & Others v Yakudo Group Holdings Ltd & Another (No 4)* [2004] 2 HKLRD 587, only *obiter*. But Lam J. had not expressed any disagreement with them. For the UK Trade Marks Registry, Mr. A Knight in *Carte Bleue Trade Marks* [2002] R.P.C. 31 (TMR) said, with reference to the *1-800 Flowers* case and the *Euromarket* case, “I am prepared to take from those judgments a cautious approach to the use of website material in determining whether or not a trade mark has been used in the United Kingdom. However, I am not prepared

to rule out the use of such material in order to determine whether or not a trade mark has been used within this jurisdiction.”

40. I think we should similarly take this cautious approach. It seems the key question is whether use is “aimed and directed” at customers within the jurisdiction. Kitchin J. in *Dearlove v Combs* [2007] EWHC 375 (Ch) summed up the position as follows:-

“I believe it is clear from these authorities that placing a mark on the internet from a location outside the United Kingdom can constitute use of that mark in the United Kingdom. The internet is now a powerful means of advertising and promoting goods and services within the United Kingdom even though the provider himself is based abroad. The fundamental question is whether or not the average consumer of the goods or services in issue within the United Kingdom would regard the advertisement and site as being aimed and directed at him. All material circumstances must be considered and these will include the nature of the goods or services, the appearance of the website, whether it is possible to buy goods or services from the website, whether or not the advertiser has in fact sold goods or services in the United Kingdom through the website or otherwise, and any other evidence of the advertiser's intention.” (para 25)

41. On the side of European case law, it is relevant to note that the Court of Justice of the European Communities (“CJEU”) has similarly held that “the mere fact that a website [advertising or selling the product or service concerned] is accessible from the territory covered by the trade mark is not a sufficient basis for concluding that the offers for sale displayed there are targeted at consumers in that territory” – *L'Oreal SA v eBay International AG* (Case C-324/09) EU:C:2011:474 [2011] ECR I-6011, para 64. The CJEU was there worrying about websites and advertisements which, although obviously targeted solely at consumers in third States, are nevertheless technically accessible from the EU territory and if the aforesaid proposition of the law were otherwise, they would wrongly be subject to EU law. But then it went on to say the following: - it falls to the national courts to assess on a case-by-case basis whether there are any relevant factors on the basis of which it may be concluded that an offer for sale, displayed on an online marketplace accessible from

the territory covered by the trade mark, is targeted at consumers in that territory. When the offer for sale is accompanied by details of the geographic areas to which the seller is willing to dispatch the product, that type of detail is of particular importance in the said assessment (para 65).

42. More recently in the local context, Andrew Chung J in *China National Gold Group Corp v HK China Gold Co Ltd* [2013] HKEC 1684 has summarized the state of the law, citing Kerly's Law of Trade Marks and Trade Names (2011) 15th Ed., to be like this:

- (1) the use of a mark on a website which can be accessed from anywhere in the world does not necessarily constitute use of the mark throughout the world (para 27-059 thereof, p 872);
- (2) the other extreme, that is, such a use only takes place in the country where the web server is situated is also incorrect (para 27-059 thereof, p 873);
- (3) the dividing line is indicated by normal principles. It is ultimately a question of fact to be decided in the circumstances. An important matter is whether the website is "aimed and directed" at customers within the jurisdiction and seeks order for delivery to the jurisdiction (going beyond merely waiting in the hope of custom from within the jurisdiction). The inquiry is an objective one, to be judged from the reasonable user's understanding when looking at the website (para 27-062 and 27-064 thereof);
- (4) what is required is not an established trade within the jurisdiction (although this will be an important factor) but for use of the mark in the course of trade (para 27-062 thereof);
- (5) the quality of the internet users is that they are reasonably robust: they expect an internet search to produce a lot of irrelevant sites, and expects many to be foreign (para 27-063 thereof).

43. Coming back to the present case, Cipriani USA and Cipriani Industria, owners and operators of the Cipriani Website and the Cipriani Food Website

respectively, belonged to the same Cipriani Group which comprised the registered proprietor and others. I don't see much point here in contending that the absence of real evidence of any express consent or licence means that the use of the subject mark on these websites cannot be considered use by or with the consent of the registered proprietor, as Mr. Cipriani in his statutory declaration has expressly said that the registered proprietor authorized Cipriani USA and Cipriani Industria to use the subject mark in relation to all goods and services concerned and the Cipriani Website expressly stated the copyright of the website is owned by Cipriani USA and its affiliates. Mr. Clark highlighted the fact that the Cipriani Website, as well as the Cipriani Food Website, is in English, a language prevalently used and understood by the average consumers in Hong Kong, and the Cipriani Website in particular contains a "Hong Kong" specific page which caters to Hong Kong consumers. Mr. Clark submitted that the Cipriani Website was clearly targeted at Hong Kong consumers, as it promoted the club in Hong Kong, viz., the "Cipriani Hong Kong" and specially listed Hong Kong as one of the cities it had a presence.

44. But from the authorities discussed above, I bear in mind that an offer of supply to the world at large which is not targeted at the particular jurisdiction concerned is not, without more, use directed at the user in that jurisdiction. With regard to the various webpages exhibited to Cipriani's statutory declaration, I have the following observations:

- (i) The Cipriani Website's home page had Hong Kong listed as one of the ten odd cities over the world at the top right-hand side of the page; the sign on the top left-hand side of the page is the following:-



- (ii) The Hong Kong specific page of the Cipriani Website, which was accessible by clicking on the words "Hong Kong" on the top right-hand side of the home page, referred to the abovementioned club or restaurant "Cipriani Hong Kong" with an address in Hong Kong at 12/F., Old Bank of China Building,

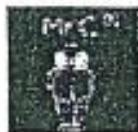
Central, Hong Kong; as seen from the copy at Exhibit 2 to Cipriani's statutory declaration, the same sign above also appeared on the top left-hand side of the "Hong Kong" page.

- (iii) The "RETAIL" page, which was accessible by clicking on the word "RETAIL" at the bottom of the Cipriani Website and allegedly sold goods under Classes 18, 20, 21, 24, 25, 29, 30, 33 and 34, as seen from the copies at Exhibits 3 and 4 to Cipriani's statutory declaration, had the following sign on the top left-hand side of the page:-



- (iv) As a matter of fact, I could not see any sign or mark being displayed on the front page of the Cipriani Food Website at Exhibit 7 to Cipriani's statutory declaration, contrary to what is claimed in the statutory declaration, though I could see a mark virtually the same as the subject mark being displayed on the copy at Exhibit 8, which Mr. Cipriani alleged is what appeared after a user clicks on the Cipriani Food Website.

- (v) The "RESORTS" page, which was accessible by clicking on the tab "RESORTS" at the bottom of the Cipriani Website and contained a hyperlink which allows a Hong Kong consumer to easily access the Hotel Website at <www.mrchotels.com>, as seen from the copies at Exhibit 10 to Cipriani's statutory declaration, did not have a sign or mark that resemble the subject mark, but instead only featured the following signs or marks on the page and on the Hotel Website:-



45. My observation above basically cover all that have been put forth as evidence of use on the basis that the Cipriani Website, as well as the Cipriani Food Website, amounted to use of the subject mark in advertising and promoting in Hong Kong the registered goods and services. Putting aside the issue whether use of the sign under paragraph 44(i) above in fact constitutes use of the subject mark, the only Hong Kong connection the Cipriani Website seemed to have, apart from the “Hong Kong” specific page itself, was that its home page had Hong Kong listed as one of the ten odd cities over the world at the top right-hand side there, and clicking on the “Hong Kong” tab would lead one to the “Hong Kong” specific page. Pages other than the “Hong Kong” specific page, say the “RETAIL” page where some goods allegedly under Classes 18, 20, 21, 24, 25, 29, 30, 33 and 34 were displayed, did not contain any hints of a Hong Kong connection such as, say, a point of sale in Hong Kong, or that goods can be ordered online from the webpage and be delivered to a location in Hong Kong. On the contrary, Ms. Helen Tang in her second statutory declaration pointed out that clicking on the tab entitled “FAQ” on the “RETAIL” page would lead one to a paragraph entitled “Shipping” which stated, specifically, that “Currently, we are shipping within the continental US only.” (Exhibit “HTT-5” to Helen Tang’s second statutory declaration). At the hearing, Mr. Clark pointed out that the copy at Exhibit “HTT-5” to Helen Tang’s second statutory declaration was printed out on 22 October 2013, and as at the relevant date, there might not have existed a tab entitled “FAQ” on the “RETAIL” page. Be that as it may, the registered proprietor had not filed any evidence denying that shipping would only be available within the continental US. Ms. Tang further noted that the prices of goods shown on the pages contained in Exhibit 3 to Cipriani’s statutory declaration were quoted in the United States currency and not Hong Kong currency.

46. The Cipriani Food Website did not even have a Hong Kong specific page or a “Hong Kong” tab, and the displayed goods were quoted in euro only. I disregard the “RESORTS” page where the marks appearing there were simply not the subject mark.

47. As to the “Hong Kong” specific page on the Cipriani Website, all it set out to do was advertising about the club or the restaurant called “Cipriani Hong Kong” by providing the catchy description of the club or restaurant as set out below (which

basically can also be found in the Cipriani Brochure), together with an address, a telephone number, a fax number and an email address in Hong Kong:-

“On June 22, 2003 David Tang and Giuseppe Cipriani established Cipriani Hong Kong, a private members' club, to offer a quintessence of the best Italian food and drinks, style and service. In the marvellous history of the Cipriani family who are dedicated to serve, and serve the best, Cipriani Hong Kong continues the same time honored traditions that makes each experience so sought after today.”

48. Looking at all this in the round, when one visits the Cipriani Website at its home page, it seems it was nothing more than a website dedicating to advertising and promoting its goods and services to consumers all over the world, hinting that they had specific interest or establishment to provide their goods and services at those cities or places listed at the top right-hand side of the home page. Up to this point I could see that a Hong Kong consumer might just wonder this website has him or her as one of its targets around the world. But the strength of this Hong Kong target argument would soon wane when one clicks on any of the tabs at the bottom of the home page leading one to, say, the “RETAIL” page where goods were priced in US\$ and might have statement saying “shipping within the continental US only”, or to the “RESORTS” page which advertised the Hotel situate at Beverly Hills, California.

49. But if he or she happens to click on the tab “Hong Kong” and be directed to the “Hong Kong” specific page, the situation would be a bit different. What one sees on this “Hong Kong” specific page is an introduction of the “Cipriani Hong Kong”, billed as a private members' club, with its contact details provided. It does not seem that one could order any goods or services directly from this webpage, though one can contact “Cipriani Hong Kong” making use of the contact details. Whilst this page can be said to dedicate to anyone in the world who plans to go or is visiting Hong Kong prompting or encouraging him or her to go to “Cipriani Hong Kong” for a meal, it could also be understood to be targeting local consumers in Hong Kong to invite them to try out the Italian food and drink and enjoy the style and service offered there. Moreover, “Cipriani Hong Kong” presented as a private members' club would have its

eye kept on Hong Kong consumers as its potential source of subscription for membership.

50. In a narrow sense, I am prepared to consider that the Cipriani Website is aimed and directed at Hong Kong customers as far as what appeared on the “Hong Kong” specific page was concerned but no more. That means whilst other webpages would not be considered to be targeting Hong Kong, if the subject mark really appeared on the Cipriani Website’s home page and the “Hong Kong” specific page, then the subject mark can be considered being used in Hong Kong on the goods and services offered in connection with “Cipriani Hong Kong”. But a more fundamental question has yet to be answered, viz., whether use of the sign appearing on the home page and the “Hong Kong” specific page – the sign as set out under paragraph 44(i) above – can be considered use of the subject mark.

51. I am afraid the question has to be answered in the negative. The subject mark comprises a figurative part and a textual part, whereas the sign only has a figurative part. Even ignoring the slight difference between the two figurative parts – in the three objects purportedly placed before the person – the missing of the textual part featuring the word “CIPRIANI” is significant. Section 52(3)(a) of the Ordinance provides that for the purposes of revocation on the ground of non-use, use of a trade mark includes use in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered. “CIPRIANI” is, in my view, at least one of the two, if not the most, prominent and distinctive elements of the subject mark. The missing of “CIPRIANI” from the sign on the relevant webpages means that the sign differs from the subject mark in a significant element which alters the distinctive character of the subject mark in the form in which it is registered. As there is no use of the subject mark on the Cipriani Website’s home page and the “Hong Kong” specific page, though I am prepared to accept that these linked webpages are targeted at Hong Kong consumers, I cannot say that the subject mark had been used to advertise and promote the relevant goods and services through or via these webpages.

52. I just add that use of the sign under paragraph 44(iii) above could be considered use of the subject mark in a form which do not alter the distinctive character of the trade mark, and Mr. Stephenson has rightly admitted that. But as that sign only appeared on The “RETAIL” pages and the Cipriani Food Website, all of which I do not consider to be targeting Hong Kong consumers, I do not consider it is relevant for the present purposes.

53. With that, I now turn to the other evidence on use of the subject mark in Hong Kong in relation to all that might be offered by or at “Cipriani Hong Kong”.

54. The evidence of use in relation to “Cipriani Hong Kong” could be gathered from the visit paid by Man Chi Hung on 6 February 2012, his telephone conversations with Ms. Michelle Li the next day and on 21 February 2012, copies of invoices contained in Exhibit 5 to Cipriani’s statutory declaration evidencing the sale between Cipriani Industria and Hong Kong customers during the relevant 3-year period, and copy of the club’s brochure contained in Exhibit 6 to Cipriani’s statutory declaration³ which was allegedly distributed to Hong Kong consumers within at least the last 3 years before 2013.

55. It is without doubt that “Cipriani Hong Kong” located at 12th floor, Old Bank of China Building, Bank Street, Central, Hong Kong is a restaurant serving customers with Italian food and drink.⁴ At the same time, although it is described as a private members’ club, and an Application for Membership form as well as a Membership Structure and Fees incorporating Terms and Conditions can be seen attached to the Cipriani Brochure (as exhibited at “MCHE-2” to Man Chi Hung’s statutory declaration), it has not been shown and cannot be ascertained what other services beyond ordinary restaurant services are on offer by or at the club. The Terms and Conditions incorporated under Membership Structure and Fees spell out nothing more than the fiscal matters of a membership.

³ Please see footnote 2 above.

⁴ Exhibit 9 to Cipriani’s statutory declaration contains a copy of the menu printed from the “Hong Kong” specific page of the Cipriani Website which is alleged to have been shown to consumers within at least the last 3 years before 2013. It can be seen that Italian food and drink were offered.

56. The sign appearing on the cover page of the Cipriani Brochure differs from the subject mark in that the space between the figurative part and the textual part is much wider. But I consider this difference as well as other slight differences in the visual presentation of the figure and the word merely differences in elements which do not alter the distinctive character of the trade mark in the form in which it was registered and accept use of this sign as use of the subject mark. I also note that the subject mark conspicuously appears on the name card of Ms. Michelle Li (exhibited as “MCHE-1” to Man Chi Hung’s statutory declaration). It follows from all this that the subject mark has been used in relation to the restaurant services offered by or at the club or restaurant known as “Cipriani Hong Kong”.

57. As to the supply of goods under the subject mark in Hong Kong, the invoices at Exhibit 5 to Cipriani’s statutory declaration, with the subject mark clearly seen on the top left-hand corner of these invoices, evidence sales of an alleged total amount of around EUR 60,000 (approximately HK\$600,000) for the relevant 3-year period, were all in respect of transactions between Cipriani Industria and The Dairy Farm Company Limited (“Dairy Farm”), or between Cipriani Industria and Cipriani Oriental Limited at 12th floor, Old Bank of China Building, Bank Street, Central, Hong Kong (which is the same address as “Cipriani Hong Kong”).

58. Mr. Paul Stephenson submitted that use on a small range of food items amounting to only HK\$600,000 spread over the relevant period of 3 years does not amount to use capable of protecting the subject mark registration pursuant to the principles in *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 (referred to below as “*La Mer*”)⁵ and *Ansul BV v Ajax Brandveiliging BV* [2003] RPC 40. His elaboration of the argument is that out of the total of Hong Kong’s population and Hong Kong visitors the sales of only HK\$600,000 are merely “nominal”; and in the absence of explanation or justification for such nominal or token use there is no genuine use that could be relied upon to justify that the subject mark should remain on the register.

⁵ Mr. Stephenson cited this case as *Laboratoire Goemar SA v La Mer Technology Inc.* [2005] EWCA Civ 978.

59. Whilst I do not agree that HK\$600,000 on food items spread over a period of three years is a nominal or token sum, I have to see what principles were enunciated in the cited cases.

60. In *Ansul* the ECJ states that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (*paras. 36 to 40*).

61. In *La Mer*, the ECJ affirmed *Ansul*. It is said that if use of the mark does not have as its essential aim the preservation or creation of market share for the goods or services that it protects, such use cannot be characterised as genuine (*para. 26*).

62. What these two cases could assist Mr. Stephenson is that they seem to say, according to one view of interpretation, that if use is just nominal, something more, such as use of the mark on the market for the goods or services protected by that mark, or use of the mark has as its essential aim the preservation or creation of market share for the goods or services that it protects, was required to show that the use was “genuine”.

63. In my view, HK\$600,000 on food items spread over a period of three years is neither nominal nor token. But even if I were wrong on that, or if the transactions between Cipriani Industria and Cipriani Oriental Limited were suspected to be merely internal transactions — given that Cipriani Oriental Limited and Cipriani Industria seem to be belonging to the same Cipriani Group and the two shared the same address in Hong Kong — and hence have to be discounted, merely relying on the sales to Dairy Farm, I think the face value of the invoices in respect of the transactions with Dairy Farm are still sufficient in themselves to be of significance which goes beyond

merely monetary terms. In the absence of evidence suggesting that the use of the subject mark on the sales to Dairy Farm is merely internal, use of the subject mark on transactions with this party which is not privy to the Cipriani Group has clearly established that its essential aim is to preserve or create market share for the goods involved.

64. If there is any doubt that the consumers concerned should be individual consumers or end users of the goods — as Mr. Stephenson submitted that there was no evidence showing the food items sold to Dairy Farm had actually hit the market — rather than a company or corporate body which might have imported the food items in order to make them into final products for end consumers or users, paragraph 33 of *Laboratoire De La Mer* [2006] FSR 5, which is reproduced below, is the answer:-

“33 Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm’s length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.”

65. Also in *Laboratoire De La Mer*, Mummery L.J. said, “The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine” (para. 32); and Neuberger L.J., referring to the argument, is more expressive in saying:-

“Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way

as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.” (para. 48)

66. As to the goods concerned, the invoices on their face did not reveal clearly, nor in English, the kind of goods being transacted, but Mr. Cipriani at paragraph 9 of his statutory declaration deposed that Cipriani Industria sold a number of food products to Hong Kong consumers, including without limitation pasta, olive oils, coffee, breads, cakes, cocktails, tomatoes, jams, vinegar, biscuits, nougats, sauces, olives and anchovies. This list, though a bit longer and finer, echoes the list of products Ms. Michelle Li told Mr. Man in the telephone conversation that would be sold by the restaurant, namely, pasta, rice, sauces, pestos, pastes, oil and vinegar. In the absence of evidence to cast doubt on Mr. Cipriani’s deposition, this could be taken as a range of foodstuffs that had been sold by reference to the subject mark. The goods could be categorized as under Classes 29, 30, 32 and 33.

67. I therefore consider it a fair reading of the evidence that Cipriani Industria had through the use of the subject mark sold a range of foodstuffs in Classes 29, 30, 32 and 33 to Hong Kong consumers. Although as the evidence revealed, the consumers were corporate bodies and the sales seemed to be wholesale, this, as discussed above, could suffice for constituting genuine use of the subject mark on the market.

68. The above would dispose parts of the allegation of non-use as far as the restaurant services provided by “Cipriani Hong Kong” and some food items supplied by Cipriani Industria are concerned. But Mr. Clark would argue that use of the subject mark was in relation to all the food and drink offered by “Cipriani Hong Kong” as a restaurant, as whether they were consumed by the customers at the premises or taken home to be consumed later, they would constitute food and drink sold or provided under the subject mark. Mr. Clark opined that people of the public go to restaurant for the food and drink there offered, and there is no difference between take-away restaurants and restaurants where food and drink have to be served and consumed there.

69. Mr. Stephenson disagreed and pointed out that the “Cipriani Hong Kong” restaurant as it was didn’t have any take-away element in it. Mr. Stephenson submitted that an owner of registered trade mark on restaurants and catering services could sue an infringer using an identical or similar mark on food and drink by relying on section 18(3) or (4) of TMO. Mr. Clark, on the other hand, asked why such a trade mark owner would have to resort to an infringement action to protect his interest when he or she is entitled to protection of registration in classes of goods that cover the food and drink.

70. The example of registration for retail services had been raised in the discussion on this point, but I do not think this is a good analogy, as retail services are in nature very different from restaurant services. Although food and drink is indispensable to or at the very least, important for the provision of restaurant services or catering services, I would not go as far as to say that restaurant services or catering services are solely for and constitute the sale or provision of food and drink items. According to the online Oxford Advanced Learner's Dictionary, “restaurant” means “a place where you can buy and eat a meal”; and the online Cambridge Advanced Learner's Dictionary has “restaurant” meaning “a place where meals are prepared and served to customers”. The primary meaning of “restaurant” is a place where meals are served or provided and eaten. In common parlance restaurant service includes as an important element the provision of waitress service for providing the food and drink which customers would consume at the premises.⁶ So although I can accept that food and drink may sometimes be taken away from a restaurant for later consumption, and restaurant service may be taken to include a take-away service, it is nonetheless an overtone of something more, which goes beyond mere retailing of food and drink.

71. In these proceedings of revocation on non-use, the issue is, on what goods or services has the trade mark been used and what is a fair specification for those goods or services. In deciding on a fair specification I must consider the nature of the trade and how the goods or services concerned is, as a practical matter, regarded for the

⁶ It was suggested that those who operate the premises of a restaurant might have difficulty in imposing a condition that meals sold by them should be consumed on the premises. As a matter of contract for the provision of a restaurant service, I could see no difficulty in imposing or, for that matter, enforcing such a condition.

purposes of trade. I cannot envisage a trade mark proprietor of a brand name restaurant marketing or advertising its restaurant services by entirely focusing on what items of food and drink it would offer, and indeed what “Cipriani Hong Kong” in the present case did is to always acclaim itself as being “dedicated to serve, and serve the best”, and avow to continue “the same time honored traditions that makes each experience so sought after today.”⁷ Quality of the services offered is what this restaurant is proud of. On the other hand, even if I were to accede to Mr. Clark’s submission, which I would not, that the food and drink offered or served at the restaurant is to be considered as use of the subject mark on those items of food and drink, I would have tremendous technical difficulty of identifying the proper items in the specifications to cover the food and drink that might be offered by “Cipriani Hong Kong”, and that could not be made any easier by looking at the menu of the restaurant.

72. I therefore come to a view that the mere fact that food and drink was served under restaurant services did not render the items of food and drink served becoming items of goods on which the trade mark of the restaurant could be said to have been used. Food and drink is an integral part of restaurant services but should not be counted on its own for the present purposes of determining whether there was genuine use of the subject mark on any goods concerned.

Revocation

73. Following all the discussions above, as the registered proprietor had valid evidence of use only in respect of a range of foodstuffs in Classes 29, 30, 32 and 33 and restaurants and catering services in Class 43, the registration in respect of all other goods and services in all classes other than Classes 29, 30, 32, 33 and 43 would be revoked in their entirety. As to Classes 29, 30, 32, 33 and 43, I have found that the evidence showed that the mark was used on services in respect of restaurants and catering services; and on goods in respect of pasta, olive oils, coffee, breads, cakes, cocktails, tomatoes, jams, vinegar, biscuits, nougats, sauces, olives and anchovies.

⁷ See the description in the Cipriani Brochure at paragraph 47 above.

74. Against the above findings, I must consider a fair specification for the registered goods and services in Classes 29, 30, 32, 33 and 43 that would cover Mr. Cipriani's deposed list of food items and the services offered at "Cipriani Hong Kong". In considering what constitutes a fair specification, Mr. Justice Arnold (as he now is) in his judgments as the Appointed Person in *Nirvana Trade Mark* (UK Trade Marks Registry case: BL O-262-06) and *Extreme Trade Mark* (UK Trade Marks Registry case: BL O-161-07) comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

"(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

75. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, (UK Trade Marks Registry case: BL O/345/10), Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

76. Bearing in mind the above principles, and having found genuine use of the subject mark in Hong Kong in respect of the goods of pasta, olive oils, coffee, breads, cakes, cocktails, tomatoes, jams, vinegar, biscuits, nougats, sauces, olives and anchovies, and restaurants and catering services, I have worked out a fair specification that is to be set out below, for those goods and services that could remain on the register (the “Excepted Goods and Services”).

77. To sum up, the evidence contains nothing that can show that the subject mark had, since the date of registration, been used on or in relation to the registered goods and services other than the Excepted Goods and Services. Registration of the subject mark in Classes 3, 8, 9, 14, 18, 20, 21, 24, 25, 34 and 39 should be revoked in their entirety. As to Classes 29, 30, 32, 33 and 43, the registration of the subject mark is to be revoked for all goods and services save for the Excepted Goods and Services. All revocation is to take effect from 21 May 2012, which is the date of the application for revocation. The specification would, after the partial revocation, comprise only of the Excepted Goods and Services, which is to read:

“Class 29

anchovies; tomatoes, olives, all being preserved, dried, cooked or processed;

jams; edible oils including olive oils; all included in Class 29.

Class 30

coffee, artificial coffee; bread, nougats; vinegar, sauces (condiments); pasta, cakes, biscuits; all included in Class 30.

Class 32

cocktails; all included in Class 32.

Class 33

cocktails; all included in Class 33.

Class 43

restaurants and catering services; cafeterias, bars, night clubs; all included in Class 43.”

Costs

78. Both the applicant and the registered proprietor have sought costs. The applicant has prayed for a full revocation whereas the registered proprietor has asked for a total dismissal of the revocation application in these proceedings. As each side has achieved a measure of success, each should bear its own costs. I therefore make no order as to costs for the present proceedings.

(Frederick Wong)

for Registrar of Trade Marks

25 June 2015