

**TRADE MARKS ORDINANCE (CAP. 559)**

**OPPOSITION TO TRADE MARK APPLICATION NO. 302012868**

**MARK: SWISSPERS**

**CLASSES: 16, 24**

**APPLICANT: MCPHERSON'S CONSUMER PRODUCTS PTY LIMITED**

**OPPONENT: SWISS FEDERAL INSTITUTE OF INTELLECTUAL PROPERTY**

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**STATEMENT OF REASONS FOR DECISION**

**Background**

1. On 23 August 2011 ("Application Date"), MCPHERSON'S CONSUMER PRODUCTS PTY LIMITED ("Applicant") filed an application ("subject application") under the Trade Marks Ordinance (Cap. 559) ("Cap. 559") for registration of the following mark ("subject mark"):

**SWISSPERS**

Registration is sought in respect of the following goods ("subject goods"):

*Class 16*

*Paper, cardboard and articles made from paper not included in other classes; tissues; toilet paper; paper wipes, including facial wipes and paper facial cloths; make-up removal wipes (paper) other than those impregnated with cosmetics and toilet preparations; wipes for toilet use other than those impregnated with cosmetic preparations.*

Class 24

*Tissues of textile included in this class, including make-up removal tissues and tissues for toiletry purposes.*

2. Particulars of the subject application were published on 30 March 2012. On 28 June 2012, SWISS FEDERAL INSTITUTE OF INTELLECTUAL PROPERTY (“Opponent”) filed a notice of opposition (“Notice of Opposition”) against the subject application together with a statement of the grounds of opposition (“Statement of Grounds”). In response to the Notice of Opposition filed, the Applicant filed a counter-statement (“Counter-statement”) on 6 September 2012.

3. The Opponent’s evidence consists of a statutory declaration of LI Tsz Kong Arron made on 4 March 2013 (“Li’s Declaration”).

4. The Applicant’s evidence consists of a statutory declaration of Andrew Jonathan Luttrell made on 3 September 2013 (“Luttrell’s Declaration”).

5. The opposition was fixed to be heard on 26 June 2015. Neither the Opponent nor the Applicant filed any notice of intention to appear at the hearing (Form T12). Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559 sub. leg.), both parties are treated as not intending to appear at the hearing. I therefore proceed to decide the matter without a hearing pursuant to rule 75(b)(i) of the Trade Marks Rules.

**Grounds of opposition**

6. The grounds upon which the Opponent opposes the subject application are:<sup>1</sup>

(a) The subject mark is not a trade mark within the meaning of section 3(1) of Cap. 559 because it is not capable of distinguishing the Applicant’s goods and services from those of other traders, including without limitation, from those of the Opponent; the subject mark should therefore be refused registration under section 11(1)(a) of Cap. 559.

(b) The subject mark is not registrable as a trade mark under sections 11(1)(b)-(d) of Cap. 559.

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<sup>1</sup> Statement of Grounds, para. 7.

- (c) The subject mark contains the word “SWISS”, and is therefore not registrable as a trade mark under section 11(7) of Cap. 559.
- (d) Given the subject goods are identical and/or similar to goods for which Switzerland is a well-known geographical origin, the use and/or registration of the subject mark is likely to deceive the public and therefore should be refused registration under section 11(4) of Cap. 559.
- (e) The use of the subject mark is prohibited in Hong Kong under or by virtue of law including but not limited to section 7 of the Trade Descriptions Ordinance (Cap. 362) (“Cap. 362”) or made in bad faith and should be refused registration under section(s) 11(5)(a) and/or 11(5)(b) of Cap. 559.
- (f) Use of the subject mark in Hong Kong is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off or an earlier right); the subject mark should be refused registration under section(s) 12(5)(a) and/or 12(5)(b)<sup>2</sup> of Cap. 559.

### **The Opponent**

7. According to Li’s Declaration, the Opponent is the governmental agency for all matters concerning intellectual property in Switzerland, and is responsible for drafting legislation in the field of intellectual property and executing such legislation within its range of competence. It also represents Switzerland at an international level in areas concerning intellectual property and acts as a consultant to the Federal Council and other government entities.<sup>3</sup>

### **The Applicant**

8. According to Luttrell’s Declaration, the Applicant is a proprietary limited company organized and existing under the laws of Australia, and is a wholly owned

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<sup>2</sup> Paragraph 7 vi of the Statement of Grounds refers to section “15(5)(b)” of Cap. 559. As there is no subsection (5) in section 15 of Cap. 559, the reference to section “15(5)(b)” is probably a typographical error, and may be referring to section 12(5)(b) of Cap. 559 instead.

<sup>3</sup> Li’s Declaration, para. 2.

subsidiary of McPherson's Limited, a company publicly listed in Australia.<sup>4</sup> According to the Applicant, the subject mark is one of the house marks of the Applicant. It was first used in Australia in 2002 and then in other countries in respect of personal care products.<sup>5</sup>

9. Set out in paragraphs 10 and 11 of Luttrell's Declaration are sales figures for goods bearing the subject mark in Australia since 2007 and in other countries since 2011.

10. McPherson's Limited, the Applicant's parent company, is the owner of the trade marks registered in Australia listed in **Schedule 1** hereto and the trade marks registered in New Zealand listed in **Schedule 2** hereto.

11. The Applicant states that the subject mark is a made up word with no recognized meaning or reference to Switzerland, and that the Applicant and its predecessors have never been aware of any instances in which consumers believe that products depicting the subject mark originate from or are in any way connected with Switzerland or any entity from Switzerland.<sup>6</sup>

### **Opposition under section 11(1) of Cap. 559**

12. Section 11(1) of Cap. 559 provides, *inter alia*, as follows:

*'... the following shall not be registered-*

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark");*
- (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*

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<sup>4</sup> Luttrell's Declaration, para. 3.

<sup>5</sup> Luttrell's Declaration, para. 7.

<sup>6</sup> Luttrell's Declaration, para. 15.

(d) *trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.*'

13. Section 3(1) of Cap. 559 provides as follows:

*'In this Ordinance, a "trade mark" (商標) means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.'*

14. The Opponent considers that:

(a) the subject mark is not registrable as a trade mark under section 11(1)(a) of Cap. 559 because it is not capable of distinguishing the Applicant's goods and services from those of other traders, including without limitation, those of the Opponent;<sup>7</sup>

(b) as the subject mark as a whole is a made up word with no recognized meaning, consumers are likely to focus on those elements which have an identifiable meaning; the subject mark contains the entirety of the word "SWISS", which would easily mislead consumers as to the origin of goods or a reference to Switzerland; the subject mark therefore should be refused registration under section 11(1)(b)-(d) of Cap. 559.<sup>8</sup>

15. The subject mark consists of a single word "SWISSPERS" which has no recognizable meaning.

16. Each of the absolute grounds for refusing registration under section 11(1) of Cap. 559 is independent of the others and calls for a separate examination, although there is a degree of overlap between sections 11(1)(b), 11(1)(c) and 11(1)(d).<sup>9</sup>

17. Section 11(1)(d) of Cap. 559<sup>10</sup> is directed at preventing registration of those signs which honest traders customarily use in trade – signs which are generic.<sup>11</sup> The

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<sup>7</sup> Li's Declaration, para. 9.

<sup>8</sup> Li's Declaration, para. 10.

<sup>9</sup> *Koninklijke KPN Nederland NV v Benelux-Merkenbureau ("POSTKANTOOR")* (Case C-363/99) [2004] E.T.M.R. 57, paras 67, 85.

<sup>10</sup> Similar to section 3(1)(d) of the UK Trade Marks Act 1994 ("UK 1994 Act"), article 3(1)(d) of the EC Trade Mark Directive (2008/95/EC) ("EC TM Directive") and article 7(1)(d) of the Community Trade Mark Regulation (Council Regulation (EC) No 207/2009) ("CTM Regulation").

<sup>11</sup> *Kerly's Law of Trade Marks and Trade Names* (15<sup>th</sup> Edn.) para. 8-099.

provision refers to “trade marks which consist *exclusively* of signs which *have become* customary” (*emphasis* added). This means the generic terms constituting such trade marks must actually be in current use, as opposed to being capable of being used generically in the future. Not only must the mark consist *exclusively* of generic matter, but the fact of genericism must be *established*.<sup>12</sup>

18. There is no evidence that would indicate that “SWISSPERS” has become customary in the current language or in the honest and established practices of any trade. The ground of opposition under section 11(1)(d) of Cap. 559 is not made out.

19. The purpose of the ground of objection under section 11(1)(c) of Cap. 559<sup>13</sup> is to prevent the registration of signs which are descriptive of the goods or services or some characteristic of them. These marks are excluded from registration because they consist of signs or indications which honest traders either use or may wish to use without any improper motive.<sup>14</sup>

20. The fact that the word ‘characteristic’ is used in section 11(1)(c) of Cap. 559 highlights the fact that the signs referred to in section 11(1)(c) are merely those which serve to designate a property, easily recognizable by the relevant class of persons, of the goods or the services in respect of which registration is sought. A sign can be refused registration on the basis of section 11(1)(c) only if it is reasonable to believe that it will actually be recognized by the relevant class of persons as a description of one of those characteristics.<sup>15</sup>

21. The subject mark consists of a single word “SWISSPERS” which has no recognizable meaning. The subject mark must be considered as a whole, and must be assessed by reference to the perception of the average consumer of the subject goods.

22. The subject goods consist of tissues, wipes and other goods in Classes 16 and 24. They are essentially consumer goods. The relevant public for these goods include ordinary members of the public.

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<sup>12</sup> *Kerly's, op. cit.*, para. 8-111.

<sup>13</sup> Similar to section 3(1)(c) of the UK 1994 Act, article 3(1)(c) of the EC TM Directive and article 7(1)(c) of the CTM Regulation.

<sup>14</sup> *Kerly's Law of Trade Marks and Trade Names* (15th Edn) para. 8-087; *Nissha Printing Co Ltd v Registrar of Trade Marks* (HCMP 720/2009) [2010] 3 HKLRD H4 para. 9.

<sup>15</sup> *Agencja Wydawnicza Technopol v OHIM* (Case C-51/10 P) [2011] E.T.M.R. 34, at para. 50.

23. It is stated in paragraph 11 of Li's Declaration as follows:

“According to the result of a simple poll, the relevant public believed that the [subject mark] and the goods were related to Switzerland when they saw the mark. It is therefore obvious that confusion of origin has been caused among the relevant public.”

24. In *Imperial Group PLC v Phillip Morris* [1984] RPC 293, Whitford J laid down guidelines for the future conduct of surveys, which have since become known as the Whitford Guidelines. The Whitford Guidelines were recently summarised by Lewison LJ in *Interflora v Marks & Spencer* [2012] EWCA Civ 1501.<sup>16</sup> At paragraph 61 Lewison LJ said the following:

“(i) If a survey is to have any validity at all, the way in which the interviewees are selected must be established as being done by a method, such that a relevant cross section of the public is interviewed;

(ii) any survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;

(iii) the party relying on the survey must give the fullest possible disclosure of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because otherwise it is impossible to draw any reliable inference from answers given by a few respondents;

(iv) the questions asked must not be leading and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;

(v) exact answers and not some sort of abbreviation or digest of the exact answer must be recorded;

(vi) the totality of all answers given to all surveys should be disclosed;

(vii) the instructions given to the interviews must also be disclosed.”

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<sup>16</sup> Applied in *Zee Entertainment Enterprises Ltd v Zeebox Ltd* [2014] F.S.R. 26.

25. In the present case, there is no evidence as to how the “poll” was conducted, how many interviewees were selected and what questions had been put to them. The information provided in Li’s Declaration regarding this “poll” is very far from satisfying the Whitford Guidelines for the “poll” to be of any weight at all.

26. The subject mark consists of a single word “SWISSPERS” which has no recognizable meaning. Although the subject mark contains the entirety of the word “SWISS”, even if one splits up the word “SWISSPERS” into two parts, namely “SWISS” and “PERS”, the two parts together do not have any recognizable meaning. The relevant public would view the mark as a whole, and would not simply isolate the element “SWISS” from the subject mark, ignoring the letters “PERS”. The subject mark as a whole does not designate the geographical origin or any easily recognizable property of the subject goods.

27. As the subject mark does not consist exclusively of a sign which may serve, in trade or business, to designate the geographical origin or any other characteristic of the subject goods, the ground of opposition under section 11(1)(c) of Cap. 559 is not made out.

28. I turn to consider the ground of opposition under section 11(1)(b) of Cap. 559.

29. The relevant principles have been referred to in the case of *Host Hotels & Resorts, L.P. v. Registrar of Trade Marks* [2010] 1 HKLRD 541:

‘17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 Jacob J (as he then was) said at page 306:

“What does *devoid of any 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 *Societe des Produits Nestle SA v Mars UK Ltd* [2004] F.S.R. 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.....”

30. The subject mark “SWISSPERS” as a whole does not have any recognizable meaning in relation to the subject goods other than as a badge of trade origin. When used in relation to the subject goods, the average consumer would perceive the subject mark as indicating that those goods originate from a particular undertaking, thereby distinguishing them from the goods of other undertakings. The subject mark is therefore not devoid of distinctive character within the meaning of section 11(1)(b) of Cap. 559. The ground of opposition under section 11(1)(b) is not made out.

31. To be free from objection under section 11(1)(a) of Cap. 559, a sign must come within the meaning of “trade mark” in section 3(1) of Cap. 559,<sup>17</sup> i.e. it must be (i) capable of distinguishing the goods or services of one undertaking from those of other undertakings and (ii) capable of being represented graphically.

32. Whereas section 11(1)(a) of Cap. 559<sup>18</sup> is an overriding provision which prevents registration of a mark which is so descriptive or so lacking in content capable of performing the function of a trade mark that it cannot be registered, from section 11(2), it is apparent that Section 11(1)(b) prevents from registration, without proof of distinctiveness, trade marks which are not so wholly lacking in trade mark content as to be registrable at all but which, without evidence of use, do not display a sufficiently distinctive content.<sup>19</sup>

33. The subject mark is represented graphically. I have already found that the subject mark is not objectionable under section 11(1)(b) of Cap. 559. It can, without use, do the job of distinguishing the Applicant’s subject goods from those of other undertakings. The subject mark therefore satisfies the requirements of section 3(1) of Cap. 559 (see paragraph 31 above). The ground of opposition under section 11(1)(a) of Cap. 559 is not made out.

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<sup>17</sup> See para. 13 above.

<sup>18</sup> Similar to section 3(1)(a) of the UK 1994 Act.

<sup>19</sup> *MESSIAH FROM SCRATCH Trade Mark* [2000] R.P.C. 44, para. 13.

## Opposition under section 11(7) of Cap. 559

34. Section 11(7) of Cap. 559 provides that:

*“A trade mark shall not be registered in the cases specified in section 64 (national emblems, etc.) and section 65 (emblems, etc., of certain international organizations).”*

35. Section 64 of Cap. 559 provides, *inter alia*, that:

*“(1) ... a trade mark which consists of or contains the **flag** of a Paris Convention country or WTO member shall not be registered without the authorization of the competent authorities of that country or member, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization.*

*(2) ... a trade mark which consists of or contains the armorial bearings or any other **state emblem** of a Paris Convention country or WTO member which is protected under the Paris Convention (including any armorial bearings or state emblems entitled to such protection by virtue of the World Trade Organization Agreement) shall not be registered without the authorization of the competent authorities of that country or member.*

*(3) A trade mark which consists of or contains an **official sign** or **hallmark** adopted by a Paris Convention country or WTO member and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention (including any sign or hallmark entitled to such protection by virtue of the World Trade Organization Agreement), be registered in relation to goods or services which are the same as, or are of a similar kind to, those in relation to which it indicates control and warranty, without the authorization of the competent authorities of that country or member.*

*(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.*

*(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorized to make use of a state*

*emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.*

*(6) Where by virtue of this section the authorization of the competent authorities of a Paris Convention country or WTO member is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the trade mark in Hong Kong without their authorization.” (emphasis added)*

36. Section 65 of Cap. 559 provides that:

*“(1) This section applies to-*

*(a) the armorial bearings, flags or other emblems; and*

*(b) the abbreviations and names,*

*of international intergovernmental organizations of which one or more Paris Convention countries or WTO members are members.*

*(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention (including any emblem, abbreviation or name entitled to such protection by virtue of the World Trade Organization Agreement) shall not be registered without the authorization of the international intergovernmental organization concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed-*

*(a) is not such as to suggest to the public that a connection exists between the organization and the trade mark; or*

*(b) is not likely to mislead the public as to the existence of a connection between the user and the organization.*

*(3) The provisions of this section as to emblems of an international intergovernmental organization apply equally to anything which from a heraldic point of view imitates any such emblem.*

(4) *Where by virtue of this section the authorization of an international intergovernmental organization is or would be required for the registration of a trade mark, that organization is entitled to restrain by injunction any use of the trade mark in Hong Kong without its authorization.*

(5) *Nothing in this section affects the rights of a person whose use in good faith of the trade mark in question began before 16 November 1977 (when the relevant provisions of the Paris Convention entered into force in relation to Hong Kong)."*  
(*emphasis added*)

37. Section 66 of Cap. 559 provides that:

*"(1) For the purposes of **section 64** (national emblems, etc.), **state emblems of a country (other than the national flag), and official signs or hallmarks**, shall be regarded as **protected** under the Paris Convention, or as protected under the Paris Convention by virtue of the World Trade Organization Agreement, **only if**, or to the extent that-*

- (a) the country in question has **notified** the World Intellectual Property Organization in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, sign or hallmark;*
- (b) the notification remains in force; and*
- (c) no objection to the notification has been transmitted to the World Intellectual Property Organization on behalf of Hong Kong in accordance with Article 6ter(4) of the Paris Convention or any such objection has been withdrawn.*

*(2) For the purposes of **section 65** (emblems, etc., of certain international organizations), the **emblems, abbreviations and names of an international intergovernmental organization** shall be regarded as **protected** under the Paris Convention, or as protected under the Paris Convention by virtue of the World Trade Organization Agreement, **only if**, or to the extent that-*

- (a) the organization in question has **notified** the World Intellectual Property Organization in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, abbreviation or name;*

(b) *the notification remains in force; and*

(c) *no objection to the notification has been transmitted to the World Intellectual Property Organization on behalf of Hong Kong in accordance with Article 6ter(4) of the Paris Convention or any such objection has been withdrawn.*

(3) *Notification in accordance with Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification.*

(4) *The Registrar shall keep and make available for public inspection at the Registry by any person, during the normal business hours of the Registry, and free of charge, a list of -*

(a) *the state emblems and official signs or hallmarks; and*

(b) *the emblems, abbreviations and names of international intergovernmental organizations,*

*which are for the time being protected under the Paris Convention by virtue of a notification under Article 6ter(3) of the Paris Convention.”*

38. The list referred to in section 66(4) of Cap. 559 is accessible from the website of the Intellectual Property Department<sup>20</sup> ([http://www.ipd.gov.hk/eng/electronic\\_services.htm](http://www.ipd.gov.hk/eng/electronic_services.htm)) through the following hyperlink made with the permission of the World Intellectual Property Organization (WIPO):

<http://www.wipo.int/ipdl/en/search/6ter/search-struct.jsp>

39. The Opponent's case under section 11(7) of Cap. 559 is that the subject mark contains the word "SWISS", and is therefore not registrable as a trade mark under section 11(7) of Cap. 559.<sup>21</sup>

40. I refer to sections 66(1) and 66(2) of Cap. 559 (set out in paragraph 37 above).

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<sup>20</sup> The Director of Intellectual Property holds the office of Registrar of Trade Marks (section 4 of the Director of Intellectual Property (Establishment) Ordinance (Cap.412)).

<sup>21</sup> Statement of Grounds, para. 7 iii.

The word “SWISS” is not a national flag. The word “SWISS” is also not found in the list kept under section 66(4) of Cap. 559, and is not anything which from a heraldic point of view imitates anything included in that list (sections 64(4) and 65(3) of Cap. 559). As the word “SWISS” is not protected whether under section 64 or section 65 of Cap. 559, the subject mark is not objectionable under section 11(7) of Cap. 559. The Opponent’s case under section 11(7) of Cap. 559 is therefore not made out.

#### **Opposition under section 11(4) of Cap. 559**

41. Section 11(4) of Cap. 559 provides that:

*“A trade mark shall not be registered if it is –  
(a) contrary to accepted principles of morality; or  
(b) likely to deceive the public.”*

42. In the Statement of Grounds, the Opponent claims that:

*“The [subject mark] contains the word “SWISS”, but the applicant is from Australia and the specifications are not restricted to Switzerland. If the [subject mark] is allowed to be registered, it may mislead the public about the origin of the goods.”<sup>22</sup>*

*“Given the goods proposed for registration are identical and/or similar to goods for which Switzerland is a well-known geographical origin, the use and/or registration of the [subject mark] is likely to deceive the public and therefore should be refused registration under section 11(4) of [Cap. 559].”<sup>23</sup>*

43. It would appear from the foregoing that the Opponent’s pleaded case under section 11(4) of Cap. 559 is that the subject mark is likely to deceive the public (section 11(4)(b)) because the subject goods are “identical and/or similar to” goods for which Switzerland is a well-known geographical origin.

44. In the evidence filed in support of its opposition,<sup>24</sup> the Opponent went further:

*“The use of the [subject] mark is very likely to mislead the public that the designated goods are of Swiss origin or related to Switzerland. This is **contrary to accepted***

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<sup>22</sup> Statement of Grounds, para. 6.

<sup>23</sup> Statement of Grounds, para. 7 iv.

<sup>24</sup> Li’s Declaration, para. 12.

**principles of morality** and likely to deceive the public and therefore the mark should be refused registration under section 11(4) of [Cap. 559]. These arguments have been justified by the judge on prejudication of *Swiss Miss* [1997] RPC 219<sup>25</sup> and *Chocosuisse v Cadbury* [1998] RPC 117.<sup>26</sup> (**emphasis added**)

45. It appears that the Opponent purports to include in its evidence a further ground under section 11(4)(a) of Cap. 559, which is not pleaded in the Statement of Grounds.

46. I will first deal with the ground under section 11(4)(b) of Cap. 559. This is an absolute ground for refusal which is concerned with deceptiveness inherent in the mark itself. Whether a mark as a whole is deceptive must be considered against the goods applied for and in the general context of the relevant trade. If a mark gives rise to an expectation which will not be fulfilled, then registration will be refused. The expectation must be a real one, as opposed to something obscure or fanciful, arising from the mark itself.<sup>27</sup> The relevant public is the consumer who is reasonably observant and circumspect and thus sufficiently alert and sensible such as not to need protection from claims that might only deceive a relatively small number of customers.<sup>28</sup> For this ground of refusal to apply, there must be actual deceit or a sufficiently serious risk that the consumer will be deceived.<sup>29</sup>

47. In *Swiss Miss Trade Mark* [1997] R.P.C. 219<sup>30</sup>, the application to register the trade mark “SWISS MISS” in respect of *mixes and preparations for making hot or cold chocolate or cocoa beverages*, etc. was opposed by an association of Swiss chocolate manufacturers on the ground, *inter alia*, that the mark was likely to deceive or cause confusion, having regard to section 11 of the UK Trade Marks Act 1938<sup>31</sup>, if the goods were not of Swiss origin. The question was whether the mark would cause a number of persons to wonder, to entertain as a serious and not a merely fanciful possibility, whether the goods had a Swiss origin. It was established in evidence in that case that sales of Swiss chocolate form approximately 30% of sales of high quality chocolate in

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<sup>25</sup> See para. 47 below.

<sup>26</sup> A passing off case; see paras 74 to 75 below.

<sup>27</sup> *Kerly's Law of Trade Marks and Trade Names* (15<sup>th</sup> Edn.) paras. 8-200 to 8-201.

<sup>28</sup> *Smirnoff Trade Marks* (UK Reg) (23 Nov 2001) [2006] R.P.C.16; upheld on appeal ([2003] EWHC 970 (Ch)).

<sup>29</sup> *Emanuel v Continental Shelf* [2006] E.T.M.R. 56.

<sup>30</sup> Referred to in para. 44 above.

<sup>31</sup> Section 11 of the UK Trade Marks Act 1938, so far as material, provides that it shall not be lawful to register as a trade mark or part of a trade mark “*any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice*”.

the United Kingdom, and that Swiss chocolate had a reputation for chocolate of high quality in the United Kingdom. It was on this basis that it was held that the mark “Swiss Miss” would be confusing and deceptive if applied to *chocolate* or *chocolate confectionery* not of Swiss-origin, and that it would be equally confusing and deceptive if applied to *chocolate powder for making a chocolate beverage*. Furthermore, it was noted that both chocolate and cocoa powder were produced from the cocoa bean, the latter after extraction of the fat content. There was evidence that some of the manufacturers of cocoa powder were also manufacturers of chocolate and chocolate powder. Because of the reputation which Switzerland enjoyed for chocolate manufacture which was established in the evidence, the judge concluded that the affixing of the mark “SWISS MISS” to chocolate or cocoa drink mixes might well cause ordinary members of the public to wonder if those mixes had a Swiss origin. The mark “SWISS MISS” would therefore be confusing and deceptive when applied to chocolate or cocoa drink mixes. The Court of Appeal considered that this conclusion made by the judge could not be impugned (*Swiss Miss Trade Mark* [1998] R.P.C. 889).

48. That case is very different from the present case. The Opponent’s case that the subject mark is likely to deceive the public is built on the premise that the subject goods are “identical and/or similar to goods for which Switzerland is a well-known geographical origin” (paragraphs 42 to 43 above). The Opponent has not specified which goods for which Switzerland is a well-known geographical origin. The subject goods include a range of goods in Classes 16 and 24. Unlike in the *Swiss Miss Trade Mark* case, no evidence whatsoever has been adduced in the present case to show the reputation of Switzerland for any kind of goods. There is no evidence upon which it could be found that the subject mark would give rise to an expectation as to geographical origin. It does not create an expectation which will not be fulfilled. There has been no evidence of the existence of actual deceit. I am entirely unconvinced that there is a sufficiently serious risk that the relevant consumer will be deceived. The ground of opposition under section 11(4)(b) of Cap. 559 is not made out.

49. I turn to consider the ground under section 11(4)(a) of Cap. 559. A mark is only objectionable under section 11(4)(a) of Cap. 559<sup>32</sup> if its use would contravene a generally accepted moral principle by reason of its intrinsic qualities.<sup>33</sup> In any given social group, there are certain standards of behaviour or moral principles which society requires to be observed and there are standards of conduct which are widely shared.

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<sup>32</sup> Similar to part of section 3(3)(a) of the UK 1994 Act, which reads, “(3) A trade mark shall not be registered if it is --- (a) **contrary to public policy or to accepted principles of morality**” (*emphasis added*).

<sup>33</sup> *FCUK Trade Mark* [2007] R.P.C. 1 at para. 88.

Society requires this so as to ensure that religious, social or family values are not unreasonably undermined. Accordingly it is right that in an exceptional case where the trade mark selected contravenes these standards it should be denied registration. Since however the primary objective of the system of registration of trade marks is to protect both traders and the public and since the system does not prevent a trader using a mark but merely denies him the protection of registration, it is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough. There must be a clearly identified aspect of morality which exists and which would be undermined by the registration.<sup>34</sup>

50. Each case must be decided on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice. The matter should be approached by invoking the concept of right-thinking members of the public. A right-thinking member may himself or herself not be outraged but will be able, objectively, to assess whether or not the mark in question is calculated to cause the “outrage” or “censure” amongst a relevant section of the public. The matter must be approached objectively.<sup>35</sup>

51. The Opponent has not identified what aspect of morality would be undermined by registration of the subject mark, save to state that “*The use of the [subject] mark is very likely to mislead the public that the designated goods are of Swiss origin or related to Switzerland*” (paragraph 44 above). I have already found that the subject mark does not create an expectation which will not be fulfilled (paragraph 48 above). There is no evidence that the subject mark would justifiably cause outrage or would be the subject of justifiable censure amongst a relevant section of the public, and I am entirely unconvinced that it would do so. The ground under section 11(4)(a) of Cap. 559 is neither properly pleaded<sup>36</sup> nor made out.

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<sup>34</sup> *Ghazilian's Trade Mark Application* [2002] R.P.C. 33, paras 20-21.

<sup>35</sup> *Ghazilian's Trade Mark Application* (supra), paras 30-31.

<sup>36</sup> See para. 45 above.

## Opposition under section 11(5)(a) of Cap. 559

52. Section 11(5)(a) of Cap. 559 provides that:

*“(5) A trade mark shall not be registered if, or to the extent that –  
(a) its use is prohibited in Hong Kong under or by virtue of any law;”*

53. The Opponent’s case is that the “use of the [subject mark] is prohibited in Hong Kong under or by virtue of law including but not limited to section 7 of the Trade Descriptions Ordinance (Cap. 362)”.<sup>37</sup>

54. Section 7 of Cap. 362 provides that:

*“(1) Subject to the provisions of this Ordinance, any person who -  
(a) in the course of any trade or business-  
(i) applies a false trade description to any goods; or  
(ii) supplies or offers to supply any goods to which a false trade description is applied; or  
(b) has in his possession for sale or for any purpose of trade or manufacture any goods to which a false trade description is applied, commits an offence.  
(2) A person exposing goods for supply or having goods in his possession for supply shall be deemed to offer to supply them.  
(3) Subject to the provisions of this Ordinance any person who disposes of or has in his possession any die, block, machine, or other instrument for the purpose of making, or applying to goods a false trade description commits an offence unless he proves that he acted without intent to defraud.” (*emphasis added*)*

55. At all material times,<sup>38</sup> “false trade description” was defined in section 2 of Cap. 362 as follows:

*“false trade description means-  
(a) a trade description which is false to a material degree;*

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<sup>37</sup> Statement of Grounds, para. 7 v.

<sup>38</sup> The subject application was filed on 23 August 2011, and the Notice of Opposition was filed on 28 June 2012. On both dates, the Trade Descriptions (Unfair Trade Practices)(Amendment) Ordinance 2012 (Ord. No. 25 of 2012) has not taken effect.

- (b) a trade description which, though not false, is misleading, that is to say, likely to be taken for such an indication of any of the matters specified in the definition of **trade description** as would be false to a material degree;
- (c) anything which, though not a trade description, is likely to be taken for an indication of any of the matters specified in the definition of **trade description** and, as such an indication, would be false to a material degree;
- (d) a false indication, or anything likely to be taken as an indication which would be false, that any goods comply with a standard specified or recognized by any person or implied by the approval of any person if there is no such person or no standard so specified, recognized or implied; or
- (e) a false indication, or anything likely to be taken as an indication which would be false, that any goods of any class or type-
  - (i) being goods in respect of which duty is payable under the laws of Hong Kong, are supplied free of the duty so payable in respect of that class or type of goods; or
  - (ii) not being goods in respect of which duty is payable under the laws of Hong Kong, are supplied free of the duty so payable;”.

56. At all material times, “*trade description*” was defined in section 2 of Cap. 362 as follows:

**“trade description** (商品說明) means an indication, direct or indirect, and by whatever means given, of any of the following matters with respect to any goods or parts of goods, that is to say-

- (a) quantity (which includes length, width, height, area, volume, capacity, weight and number), size or gauge;
- (b) method of manufacture, production, processing or reconditioning;
- (c) composition;
- (d) fitness for purpose, strength, performance, behaviour or accuracy;
- (e) any physical characteristics not included in the preceding paragraphs;
- (f) testing by any person and results thereof;
- (g) approval by any person or conformity with a type approved by any person;
- (h) place or date of manufacture, production, processing or reconditioning;
- (i) person by whom manufactured, produced, processed or reconditioned;
- (j) other history, including previous ownership or use;
- (k) availability in a particular place of-
  - (i) a service for the inspection, repair or maintenance of the goods; or
  - (ii) spare parts for the goods;

- (l) warranty given in respect of the service or spare parts referred to in paragraph (k);
- (m) the person by whom the service or spare parts referred to in paragraph (k) are provided;
- (n) the scope of the service referred to in paragraph (k)(i);
- (o) the period for which the service or spare parts referred to in paragraph (k) are available;
- (p) the charge or cost at which the service or spare parts referred to in paragraph (k) are available;”(emphasis added).

57. For the purpose of determining whether use of the subject mark is prohibited under section 7 of Cap. 362, I first have to decide whether the subject mark constitutes a “trade description”, and if so, whether it is a “false trade description”.

58. There is no evidence that the subject mark is a trade description as defined in section 2 of Cap. 362. I have already found that the subject mark “SWISSPERS” as a whole does not designate the geographical origin or any easily recognizable property of the subject goods (paragraph 26 above). To the public, it has no meaning other than as a badge of trade origin, i.e. a trade mark. It is not an indication of the place of manufacture, production, processing or reconditioning, or of any other matter with respect to the subject goods or any part thereof. The subject mark does not constitute a trade description.<sup>39</sup> There is therefore no question of the subject mark being a false

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<sup>39</sup> Ord. No. 25 of 2012, *inter alia*, amended Cap. 362 to extend its coverage to services, providing, *inter alia*, for a more extended definition of “trade description” as follows:

“**trade description**, in relation to goods, means an indication, direct or indirect, and by whatever means given, with respect to the goods or any part of the goods including an indication of any of the following matters-

- (a) quantity (which includes length, width, height, area, volume, capacity, weight and number), size or gauge;
- (b) method of manufacture, production, processing or reconditioning;
- (c) composition;
- (d) fitness for purpose, strength, performance, behaviour or accuracy;
- (e) (Repealed)
- (ea) availability;**
- (eb) compliance with a standard specified or recognized by any person;**
- (ec) price, how price is calculated or the existence of any price advantage or discount;**
- (ed) liability to pay duty on them under the laws of Hong Kong, generally or in specified circumstances;**
- (f) testing by any person and results thereof,
- (g) approval by any person or conformity with a type approved by any person;
- (ga) a person by whom they have been acquired, or who has agreed to acquire them;**
- (gb) their being of the same kind as goods supplied to a person;**
- (h) place or date of manufacture, production, processing or reconditioning;
- (i) person by whom manufactured, produced, processed or reconditioned;
- (j) other history, including previous ownership or use;
- (k) availability in a particular place of-

trade description for section 7 of Cap. 362 to bite. In other words, the claim that use of the subject mark is prohibited in Hong Kong under or by virtue of section 7 of Cap. 362 is not made out.

59. The Opponent has not specifically pleaded any other law under or by virtue of which use of the subject mark is prohibited in Hong Kong.

60. The ground of opposition under section 11(5)(a) of Cap. 559 is not made out.

### **Opposition under section 11(5)(b) of Cap. 559**

61. Section 11(5)(b) of Cap. 559 provides that:

*“(5) A trade mark shall not be registered if, or to the extent that –  
... (b) the application for registration of the trade mark is made in bad faith.”*

62. The term “bad faith” is not defined in Cap. 559.

63. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367 at 379, Lindsay J. said in relation to section 3(6) of the UK Trade Marks Act 1994 (equivalent to section 11(5)(b) of Cap. 559):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the

- 
- (i) a service for the inspection, repair or maintenance of the goods; or
  - (ii) spare parts for the goods;
  - (l) warranty given in respect of the service or spare parts referred to in paragraph (k);
  - (m) the person by whom the service or spare parts referred to in paragraph (k) are provided;
  - (n) the scope of the service referred to in paragraph (k)(i);
  - (o) the period for which the service or spare parts referred to in paragraph (k) are available;
  - (p) the charge or cost at which the service or spare parts referred to in paragraph (k) are available;”.

“*trade description*, in relation to a service, means an indication, direct or indirect, and by whatever means given, with respect to the service or any part of the service ...” (**emphasis added**).

At the time the Notice of Opposition was filed, Ord. 25 of 2012 had not come into force. In any event, the subject mark as a whole does not designate the geographical origin or any easily recognizable property of the subject goods or any part thereof. To the public, it has no meaning other than as a badge of trade origin. It is not an indication of any matter with respect to the subject goods or any part thereof. The subject mark is not a “trade description” even under the extended definition of “trade description” in Cap. 362 as amended by Ord. 25 of 2012.

particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

64. In *Harrison v Teton Valley Trading Co (CHINAWHITE)* [2005] F.S.R. 10, the English Court of Appeal said (at paragraph 26):

“The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

65. Further, in *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person stated as follows:<sup>40</sup>

“The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the determination of the objective element.”

66. The Opponent’s case under section 11(5)(b) of Cap. 559 is rolled up with that under section 11(5)(a) as follows:<sup>41</sup>

“The use of the [subject mark] is prohibited in Hong Kong under or by virtue of law including but not limited to section 7 of the Trade Descriptions Ordinance (Cap. 362) or made in bad faith and should be refused registration under sections 11(5)(a) and/or 11(5)(b) of [Cap. 559].”

67. The Opponent has not elaborated in Li’s Declaration as to why it considers the Applicant’s subject application to have been made in bad faith.

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<sup>40</sup> Applied in *深圳市德力康電子科技有限公司 v Joo-Sik-Hoi-Sa LG (LG Corporation)* HCMP 881/2013, [25]-[27].

<sup>41</sup> Statement of Grounds, para. 7 v.

68. An allegation that a trade mark has been applied for in bad faith is a serious allegation. It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference (*ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24 at para. 31).

69. The Opponent has not specifically pleaded facts in support of the claim that the subject application was made in bad faith. I have already found that the subject mark is not likely to deceive the public, and its use is not prohibited in Hong Kong under or by virtue of any law. I do not find that there is any basis for concluding that the Applicant's decision to apply for registration of the subject mark would be regarded as in bad faith by persons adopting proper standards. The ground of opposition under section 11(5)(b) of Cap. 559 is not made out.

### **Opposition under section 12(5) of Cap. 559**

70. Section 12(5) of Cap. 559 provides that:

*“(5) ... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented-*  
*(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off); or*  
*(b) by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (4) (in particular, by virtue of the law of copyright or registered designs),*  
*and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an “earlier right” in relation to the trade mark.”*

71. The Opponent claims that:<sup>42</sup>

“Use of the [subject mark] in Hong Kong is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off or an earlier right). The [subject mark] should be refused registration under sections 12(5)(a) and/or 15(5)(b) [*sic*] of [Cap. 559].”

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<sup>42</sup> Statement of Grounds, para. 7 vi.

72. I will first deal with the ground under section 12(5)(a).

73. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] R.P.C. 31 (“the *Advocaat* case”) Lord Diplock identified five characteristics which must be present in order to create a valid cause of action for passing-off. They are: (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods and services supplied by him, (4) which is calculated to injure the **business or goodwill** of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to the business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.

74. In *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1999] R.P.C. 826 (on appeal from [1998] R.P.C. 117<sup>43</sup>), Cadbury contended that the Swiss Chocolate Manufacturers<sup>44</sup> had no goodwill in the designation “Swiss chocolate” which was capable of being protected by the law. The English Court of Appeal considered the issue of whether, in the minds of the public or a section of the public in that country, the designation “Swiss chocolate” distinguished that class of goods from other similar goods. The Court of Appeal considered that the trial judge was right in pointing out that the words “Swiss chocolate” were descriptive in nature, that they were apt to describe chocolate made in Switzerland, but they were also apt to describe chocolate made to a Swiss recipe with Swiss expertise by a Swiss manufacturer, and that if the words were no more than descriptive --- whether of the place of manufacture or of the identity of the manufacturer --- they could not found an action in passing-off. The Court of Appeal considered that the trial judge correctly identified the point in the following passage of his judgment, [1998] R.P.C. 117, at page 129:

“It is only if they [the words ‘Swiss chocolate’] are taken by a significant part of the public to be used in relation to and indicating a particular group of products having a **discrete reputation as a group** that a case of passing off can get off the ground. I have had to bear in mind when assessing the evidence of what the words mean to members of the public. If they convey nothing more than their descriptive meaning the action must fail.” (**emphasis added**)

75. The trial judge in that case considered the evidence of members of the public

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<sup>43</sup> Referred to in para. 44 above.

<sup>44</sup> In that case, “Swiss Chocolate Manufacturers” referred to persons who manufactured chocolate in Switzerland and exported such chocolate to the United Kingdom.

as well as the evidence of trade witnesses. He summarized the evidence as to reputation in the following passage, [1998] R.P.C. 117, at page 133:

“Bearing in mind all the evidence, I have come to the conclusion that the words ‘Swiss chocolate’ have acquired in England a distinct reputation. Although it refers to chocolate which emanates from Switzerland, the plaintiffs have proved that to a significant part of the public here those words denote a group of products of **distinctive reputation**. Further, the actions of major retailers like Marks & Spencer reinforce that conclusion. They are experts in assessing and catering to the wishes of the public. I accept Ms Kirkbride’s evidence as indicating Marks & Spencer’s view that the words ‘Swiss chocolate’ had a reputation for quality among a significant part of the public. The fact that members of that public have different views of what the features of the distinctive quality are or are incapable of defining it is of little relevance.” (**emphasis added**)

The Court of Appeal was satisfied that the trial judge was entitled to make his finding in relation to reputation as he did.

76. In paragraph 3 of the Statement of Grounds, the Opponent claimed that:<sup>45</sup>

“Swiss goods and services enjoy an exceptionally good international reputation. They are considered reliable and of very high quality.”

Unlike in the case of *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* mentioned above, no evidence has been filed in support of the Opponent’s claim of reputation or goodwill in this case. The Opponent not having established any protectable goodwill or reputation, the Opponent’s case that use of the subject mark in Hong Kong is liable to be prevented by virtue of the law of passing off cannot get off the ground. The ground of opposition under section 12(5)(a) of Cap. 559 is not made out.

77. I refer to paragraph 71 above. As there is no subsection (5) in section 15 of Cap. 559, the reference to section “15(5)(b)” is probably a typographical error, and may be referring to section 12(5)(b) of Cap. 559 instead. Nonetheless, the Opponent has not pleaded any copyright, registered design or any other earlier right by virtue of which use of the subject mark in Hong Kong is liable to be prevented. The ground of opposition under section 12(5)(b) of Cap. 559 is not made out.

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<sup>45</sup> Statement of Grounds, para. 3.

## “Registrar’s discretion”

78. After setting out the grounds of opposition in paragraph 7 of the Statement of Grounds,<sup>46</sup> the Opponent went on to say as follows:

“8. The [subject mark] should be refused by the Registrar in exercising of his discretion under [Cap. 559]. In the circumstances, the Opponent respectfully prays that registration of the [subject mark] under Application No. 302012868 should be refused ...”.

79. I have considered each of the grounds of opposition relied on by the Opponent and found that none of them has been made out. I do not find that there is any basis for refusing registration of the subject mark.<sup>47</sup>

## Costs

80. As the opposition has failed, I award the Applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party may make within one month from the date of this decision, costs will be

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<sup>46</sup> See para. 6 above.

<sup>47</sup> Cap. 559 contains no equivalent of Section 13(2) of the repealed Trade Marks Ordinance (Cap. 43), which provides that, “*Subject to the provisions of this Ordinance, the Registrar **may** refuse the application, or accept it absolutely or subject to such conditions, amendments, modifications, or limitations, if any, as he may think right.*”(emphasis added) That provision is similar to section 17(2) of the Trade Marks Act 1938 (“UK 1938 Act”). As stated in *Kerly’s Law of Trade Marks and Trade Names* (12<sup>th</sup> Edn.) para. 4-07, the word “may” in section 17(2) of the UK 1938 Act gives the Registrar a discretionary power to refuse registration to marks which do or may comply with section 9 (Distinctiveness requisite for registration in Part A) or section 10 (Capability of distinguishing requisite for registration in Part B) and are not prohibited by section 11 (Prohibition of registration of deceptive, etc., matter) or 12 (Prohibition of registration of identical and resembling trade marks) of the UK 1938 Act. There is, however, no equivalent of such provision whether in the UK 1994 Act or in Cap. 559. In *Procter & Gamble Ltd’s Trade Mark Applications* [1999] R.P.C. 673, the English Court of Appeal endorsed the statement made by the Appointed Person in *EUROLAMB Trade Mark* [1997] R.P.C. 279 at 288 that the Registrar no longer has the discretion he previously had with regard to registration under the UK 1938 Act, and has to make a judgment, yes or no, upon the materials before him as to the registrability of a mark put forward for registration. Accordingly, under Cap. 559, the Registrar no longer has the discretion which he had under section 13(2) of Cap. 43.

*Kerly’s Law of Trade Marks and Trade Names* (12<sup>th</sup> Edn.) at para. 4-07 also points out that the English appellate courts ‘habitually use the term “discretion” for the exercise by the Registrar of judgment as to the permissibility, on balance, of allowing registration under section 9 [(Distinctiveness requisite for registration in Part A)] or section 10 [(Capability of distinguishing requisite for registration in Part B)] [of the UK 1938 Act]. This is a discretion in a different sense: the word those sections use is “must”, not “may”.’ That “discretion of the Registrar” referred to by the appellate courts should be read as saying that “the Registrar’s exercise of judgment is discretionary in nature”. Similarly, references to “exercise of discretion by the Registrar” in *RE CREATIVE RESOURCES LLC* [2010] 1 HKLRD 382 (CACV 15/2009) (para. 22 ff) may be read in that sense.

calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed between the parties.

( Finnie Quek )  
for Registrar of Trade Marks  
3 November 2015

**Schedule 1****Registrations in Australia**

<b>Mark</b>	<b>Trade Mark No.</b>	<b>Registered from</b>	<b>Class(es)</b>
Swisspers	879577	19 Jun 2001	3, 5
SWISSPERS	954166	15 May 2003	3, 5, 16, 24
	965981	13 Aug 2003	3, 5, 16, 24

**Schedule 2****Registrations in New Zealand**

<b>Mark</b>	<b>Trade Mark Number</b>	<b>Registration Date</b>	<b>Class(es)</b>
SWISSPERS	679908	27 Nov 2003	3
SWISSPERS	679909	27 Nov 2003	5
SWISSPERS	679911	20 Nov 2003	16
SWISSPERS	679912	20 Nov 2003	24
	700275	26 Feb 2004	3, 5, 16, 24