

TRADE MARKS ORDINANCE (Cap. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 303002057

MARK: ^A 荷兰皇家菲仕兰
 ^B 荷蘭皇家菲仕蘭

CLASS(ES): **5, 29, 30, 31 and 35**

APPLICANT: **FrieslandCampina Nederland B.V.**

OPPONENT: **Faithland Corporation (菲仕蘭股份有限公司)**

STATEMENT OF REASONS FOR DECISION

Background

1. On 20 May 2014 (“**Application Date**”), FrieslandCampina Nederland B.V. (formerly known as Friesland Brands B.V.)¹ (“**Applicant**”) filed an application (“**subject application**”) under the Trade Marks Ordinance (Cap. 559) (“**Ordinance**”) for registration of the following series of two marks (collectively, the “**subject marks**”):

荷兰皇家菲仕兰 (“**subject mark A**”)

荷蘭皇家菲仕蘭 (“**subject mark B**”).

2. Registration of the subject marks is sought in respect of the goods and services in classes 5, 29, 30, 31 and 35 set out in **Annex 1** (“**subject goods and services**”).

3. The date of priority claimed by the Applicant in respect of subject

¹ On 22 March 2016, the Applicant filed a request to change its name from “Friesland Brands B.V.” to “FrieslandCampina Nederland B.V.”. The request was accepted and updated particulars were entered in the register on 8 April 2016.

mark A is 21 November 2013 (“**Priority Date**”).

4. Particulars of the subject application were published on 8 January 2016. Faithland Corporation (菲仕蘭股份有限公司) (“**Opponent**”) filed a notice of opposition on 6 April 2016 (“**Notice of Opposition**”) with grounds of opposition (“**Grounds of Opposition**”). In response to the Notice of Opposition, the Applicant filed a counter-statement (“**Counter-statement**”) on 6 July 2016.
5. The Opponent’s evidence consists of a statutory declaration of Yin-Lung Fan, General Manager of the Opponent, made on 10 March 2017 (“**Fan’s Declaration**”). The Applicant did not file any evidence.
6. The opposition was fixed to be heard on 27 November 2018. Neither party filed a notice of intention to appear at the hearing (Form T12) within the prescribed period. Pursuant to rule 74(5) of the Trade Marks Rules (Cap. 559A) (“**Rules**”), 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) of the Rules.

Grounds of opposition

7. The Opponent relies on the grounds under the following sections of the Ordinance:
 - (a) section 11(1);
 - (b) section 11(4)(b);
 - (c) section 11(5)(b);
 - (d) section 12(5)(a); and
 - (e) section 12(5)(b)².

The Opponent

8. According to Fan’s Declaration, the Opponent is a limited liability

² The Opponent also referred to sections 18(4) and 19(2) of the Ordinance in the Grounds of Opposition. Neither section can constitute a ground of opposition under the Ordinance.

company organised and existing under the laws of Taiwan. The Opponent was founded in 1977. The Opponent claims that it has been engaging in trading, distribution, processing, wholesale and retail of various goods such as milk and edible oil (“**Opponent’s Goods**”) since its incorporation. Exhibit A to Fan’s Declaration includes printouts from the Taiwan Ministry of Economic Affairs showing the Opponent’s basic information and from the Opponent’s website. The printouts from the Opponent’s website bear a print date of 1 November 2016 (i.e. after the Priority Date and the Application Date) or are otherwise undated.

9. According to Fan’s Declaration, Mr. Fann Jen Hong (范征鴻) (“**Mr. Fann**”), one of the founders of the Opponent, devised the “菲仕蘭” mark and used it as part of its company name. The Opponent claims that, in 1979, Mr. Fann appointed an advertising company to design the graphic representation for its trade mark “**菲仕蘭**” and the Opponent has since then used the same in respect of the Opponent’s Goods.
10. The Opponent claims that, since 1977, the Opponent and its parent company, Horng Shing & Co., Ltd. (“**Opponent’s Parent Company**”)³ have obtained registrations for trade marks comprising “菲仕蘭” in Taiwan. Exhibit D to Fan’s Declaration consists of printouts from the online register of the Taiwan Intellectual Property Office showing details of 35 trade mark registrations in the name of the Opponent, the Opponent’s Parent Company or “菲仕蘭有限公司”. According to the printouts:
 - (a) The earliest registrations were filed by “菲仕蘭有限公司” in December 1977 for “**菲仕蘭**” and “**菲仕蘭**” in respect of “爽身粉” (baby powder) and “香皂” (soap) under Reg. Nos. 100320 and 100356 respectively. Both registrations have expired by 1988;
 - (b) 19 other registrations have expired by 1999; and

³ Fan’s Declaration, Exhibit F. The Opponent’s Parent Company was founded in 1964.

(c) In respect of the remaining 14 registrations (details of which are set out in Annex 2), except for items 3 and 11 in the table, these registrations have been cancelled in 2015 or 2016.

11. According to Fan's Declaration, Aw Yu Chun and Fann Jen Hong trading as Horng Shing (H.K.) Co. ("**Opponent's HK Branch**"), the Hong Kong branch of the Opponent's Parent Company, is the owner of the P.R.C. registered trade marks listed in Annex 3.⁴ Both registrations are subject to cancellation proceedings as of June 2016.

12. The Opponent's HK Branch was the owner of the Hong Kong registered trade marks listed in Annex 4. Both registrations have been revoked with effect from 16 August 2012 pursuant to an order made by the Registrar of Trade Marks on 9 July 2015.⁵

13. According to Fan's Declaration, the Opponent, its Parent Company and HK Branch (collectively, the "**Opponent Companies**"), have been advertising or promoting the Opponent's Goods bearing the marks "菲仕蘭", "菲仕蘭" and "菲仕蘭" ("**Opponent's Marks**") in Taiwan and have obtained significant reputation as a result.

14. The Opponent claims that its Parent Company had previously been the sales agent of the predecessor of the Applicant, Cooperative Condensfabriek "Friesland" W.A., for milk products and baby food in Taiwan.

15. According to Fan's Declaration, the Applicant has filed applications

菲氏牧場
Frisian Flag

to register the trade mark "  " in respect of goods in classes 5 and 32 in Taiwan under Case Nos. 945450 and 921601 ("**Applicant's Taiwan applications**") respectively. The Opponent claims that both applications were eventually refused in 2003 as the Taiwan

菲氏牧場
Frisian Flag

Intellectual Property Office considered that the trade mark "  "

⁴ Fan's Declaration, Exhibit E.

⁵ Fan's Declaration, Exhibit G.

was confusingly similar to the Opponent's Marks.

16. Exhibit B to Fan's Declaration consists of copies of the decisions issued by the Taipei High Administrative Court ("**Taipei court**") in March 2003 on the appeals lodged by the Opponent's Parent Company against the opposition decisions made in respect of the Applicant's Taiwan applications. The Taipei court noted in its decisions that the Opponent's Parent Company executed an agency agreement with a Dutch company, Cooperative Condensfabriek "Friesland" W.A., in 1977.
17. Exhibit C to Fan's Declaration consists of printouts from the online register of the Taiwan Intellectual Property Office showing details of the Applicant's Taiwan applications as filed by Friesland Brands B.V. on 29 November 1999. The applications have been cancelled in August and October 2003.
18. The Opponent contends that the Applicant was fully aware of the Opponent and its Marks at the time it filed the subject application.
19. According to Fan's Declaration, the Opponent's Companies have been using the Opponent's Marks in respect of fish oil capsules in Hong Kong since at least 2011.⁶ Exhibit H to Fan's Declaration is said to contain copies of documents evidencing use of the Opponent's Marks in respect of fish oil capsules in Hong Kong. I will return to the documents in this exhibit.

The Applicant

20. In the Counter-statement, the Applicant states that it is a company organised and existing under the laws of the Netherlands. It claims that it is the world's largest dairy co-operatives, and has been using the trade name "Friesland" since the 19th century. It further claims that the subject marks consist of the Chinese trade name of the Applicant, i.e. Dutch Royal Friesland in Chinese characters.⁷

⁶ Fan's Declaration, paras. 12 to 13.

⁷ Counter-statement, para. 12.

21. According to the Applicant, the Opponent's Parent Company had previously been the sales agent of the predecessor of the Applicant in Taiwan. The Applicant claims that, in view of this and the relationship between the Opponent and its Parent Company, the Opponent must have been fully aware of the subject mark and the Applicant's legitimate rights in its Chinese trade name.⁸
22. The Applicant did not, however, file evidence in these proceedings.

Opposition under section 11(4)(b) of the Ordinance

23. Section 11(4)(b) of the Ordinance provides that :

“A trade mark shall not be registered if it is –
...(b) likely to deceive the public.”

24. According to paragraph 11 of the Grounds of Opposition, the Opponent's case under section 11(4)(b) of the Ordinance is that:

“[The subject mark] is confusingly similar to the Opponent's Marks as both contain the highly distinctive element “菲仕蘭”. [The subject goods and services] are similar and/or related to the goods used by the Opponent's Companies or covered by the trade mark registrations of the Opponent's Companies. It is obvious that the Applicant intended to deprive the Opponent's Companies of the rights to use and register the Opponent's Marks in Hong Kong by filing the application for registration of [the subject mark] without any notice to the Opponent's Companies and without any authorisation from the Opponent's Companies. The Applicant's conduct is dishonest judged by ordinary standards of honest people. The filing of [the subject mark] by the Applicant clearly falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field. The Applicant has obviously filed the application for [the subject mark] in bad faith. In the premises, [the subject mark] shall not be granted

⁸ Counter-statement, para. 12.

registration as it is contrary to Section 11(4)(b)... of [the Ordinance].”

25. Section 11(4)(b) of the Ordinance is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. This is consistent with the heading of section 11 of the Ordinance which is entitled “Absolute grounds for refusal of registration” and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties.⁹ Consequently, the Opponent cannot succeed under section 11(4)(b) of the Ordinance based upon its allegedly similar mark(s).
26. The ground of opposition under section 11(4)(b) of the Ordinance is not made out.

Opposition under section 11(1) of the Ordinance

27. Section 11(1) of the Ordinance provides, *inter alia*, as follows :

“Subject to subsection (2), 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

(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.”

28. Section 3(1) of the Ordinance provides as follows :

⁹ *QS by S. Oliver Trade Mark* [1999] RPC 520 at 524; *Kerly's Law of Trade Marks and Trade Names* (16th Edn.) para. 10-216.

“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.”

29. According to paragraph 13 of the Grounds of Opposition, the Opponent’s case under section 11(1) of the Ordinance is that:

“By reasons of [the matters quoted in paragraph 24 above], [the subject mark] is not a sign which is capable of distinguishing [the subject goods] from [the Opponent’s Goods] and registration thereof will be contrary to Section 3(1) and Section 11(1) of [the Ordinance].”

30. It is clear that the Opponent’s ground of opposition under section 11(1) of the Ordinance is based on section 11(1)(a).
31. As noted in paragraph 25 above, section 11 of the Ordinance deals with absolute grounds for refusal of registration, and is to be contrasted with section 12 of the Ordinance which deals with the relative rights of an applicant and other parties.
32. It is apparent from the Opponent’s pleadings and evidence that the basis of its opposition under section 11(1)(a) of the Ordinance is not that the subject marks are by their nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings, nor that they cannot be represented graphically. Rather, the Opponent’s contention is that the subject marks would cause deception or confusion because of their resemblance to the Opponent’s Marks. Section 11(1)(a) of the Ordinance is not a proper avenue for such a contention. The ground of opposition under section 11(1) of the Ordinance therefore necessarily fails.

Opposition under section 12(5)(a) of the Ordinance

33. Section 12(5)(a) of the Ordinance provides:

“(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)...

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.”

34. According to paragraph 12 of the Grounds of Opposition, the Opponent’s case under section 12(5)(a) of the Ordinance is that:

“By reasons of [the matters quoted in paragraph 24 above], registration of [the subject mark] shall be refused as its use in Hong Kong is liable to be prevented by the Opponent who has earlier rights in relation to the Opponent’s Marks. Use of [the subject mark] would constitute an act of passing-off... and registration of [the subject mark] shall be prohibited under Section 12(5)(a)... of [the Ordinance].”

35. The issue for determination is whether at the Priority Date and the Application Date, use of subject mark A and subject mark B respectively by the Applicant was liable to be prevented by virtue of the law of passing off.

36. The elements of the tort of passing off as formulated by Lord Oliver in the *JIF* case¹⁰ have been repeatedly relied upon.¹¹ Adapted to the facts of the present case, the Opponent has to establish that:

(a) the Opponent has sufficient goodwill or reputation attached to the Opponent’s goods or services in the mind of the purchasing public by association with any of the Opponent’s Marks;

¹⁰ *Reckitt & Colman Products Limited v. Borden* [1990] RPC 341.

¹¹ Applied in e.g. *Ping An Securities Ltd v 中國平安保險 (集團) 股份有限公司* (2009) 12 HKCFAR 808 (FACV 26/2008).

- (b) the Applicant has made a misrepresentation leading or likely to lead the public to believe that the subject goods or services offered by the Applicant are the goods or services of the Opponent; and
 - (c) the Opponent suffers, or is likely to suffer, damage by reason of the erroneous belief engendered by the Applicant's misrepresentation that the source of the Applicant's subject goods or services is the same as the source of the goods or services offered by the Opponent.
37. The relevant date for determining the criteria of section 12(5)(a) of the Ordinance is the date of the application for the mark in suit or the date of commencement of the conduct complained of.¹²
38. Since there is no evidence of use of subject mark A or subject mark B in Hong Kong by the Applicant before the Priority Date or the Application Date respectively, the relevant dates are the Priority Date (i.e. 21 November 2013) in the case of subject mark A and the Application Date (i.e. 20 May 2014) in the case of subject mark B.
39. I first consider whether any of the Opponent's goods or services have, by the Priority Date or the Application Date, acquired any goodwill or reputation in Hong Kong which is known by any of the Opponent's Marks.
40. I note that the Opponent has claimed that its Companies have been using the Opponent's Marks in respect of fish oil capsules only in Hong Kong since at least 2011. Exhibit H to Fan's Declaration is said to contain copies of documents evidencing the same.¹³ This is the only exhibit that is relevant to the Opponent's passing off claim.
41. There are altogether five documents in Exhibit H to Fan's Declaration. The first document is a copy of an authorisation letter in simplified Chinese ("**Authorisation Letter**") from the

¹² *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 9.

¹³ Para. 19 above.

Opponent's HK Branch to Guang Zhou Mao Ying Trading Co., Ltd. (广州茂盈贸易有限公司) ("Mao Ying Trading") dated 20 March 2010. The Authorisation Letter shows that Mao Ying Trading has been licensed to use the P.R.C. registered trade mark "菲仕兰" (Reg. No. 512218) in relation to its import of food and health products, as agent, to Mainland China from 20 March 2010 to 19 February 2020.

42. The second document is a copy of a purchase contract in simplified Chinese ("**2011 Purchase Contract**") between Mao Ying Trading (having an address in Guangzhou) and the Opponent's Parent Company / HK Branch dated 28 December 2011. The 2011 Purchase Contract shows that Mao Ying Trading agreed to purchase the following items:

- 200 boxes of 菲仕兰® 鲨鱼肝油软胶囊 / Alkymer® 410mg x 60 caps/box
- 199 boxes of 菲仕兰® 蜂花粉营养片 / Femaflex® 366mg x 60 caps/box
- 198 boxes of 菲仕兰® 蜂花粉提取物片 / Sanaflex® 366mg x 60 caps/box

The contract was concluded in Guangzhou and the delivery port is stated to be Zhuhai.

43. The third document is a copy of a purchase contract in simplified Chinese ("**2012 Purchase Contract**") between Mao Ying Trading and the Opponent's Parent Company / HK Branch dated 28 January 2012. The 2012 Purchase Contract shows that Mao Ying Trading agreed to purchase the following items:

- 12,668 boxes of 菲仕兰® DHA 天然浓缩深海鱼油胶囊 / Health Plus DHA highly concentrated fish oil capsule 1000mg x 30 caps/box

The contract was concluded in Guangzhou and the delivery port is stated to be Zhuhai or Hong Kong.

44. The fourth document is a copy of a packaging agreement (“**Packaging Agreement**”) between Pharmtech (Hong Kong) Limited and the Opponent’s HK Branch executed on 23 May 2013. The Packaging Agreement shows that Pharmtech (Hong Kong) Limited was engaged to repackage the following items:

- 500 boxes of 菲仕兰 Health Plus EPA x 60 caps/box
- 500 boxes of 菲仕兰 Health Plus Omega-3 x 60 caps/box

The agreement specifically states that the goods are for the “China” market.

45. The last document is a bill of lading (“**Bill of Lading**”) dated 13 June 2013 relevant to the shipment of 62 boxes of “菲仕蘭濃縮深海魚油膠囊”. The consignee is stated to be Mao Ying Trading. The ports of loading and discharge are stated to be Hong Kong and Zhuhai Wanzai respectively. None of the Opponent’s Companies is mentioned on the Bill of Lading.

46. Having considered the five documents mentioned above, I note that:

- The Authorisation Letter is not concerned with any use of the Opponent’s Marks in Hong Kong;
- In respect of the 2011 and 2012 Purchase Contracts, both agreements were concluded in Mainland China with the same entity, i.e. Mao Ying Trading, a company with an address in Guangzhou and which appears to be the agent of the Opponent’s HK Branch in Mainland China. While, according to the terms of the 2012 Purchase Contract, goods purchased thereunder could be delivered to Zhuhai or Hong Kong, it is unclear from the evidence as to whether goods have indeed been purchased and delivered to Hong Kong;
- The relationship between the Packaging Agreement and the other documents is unclear. In any case, the Packaging Agreement clearly states that the goods referred to therein are for the “China”

market;

- The Bill of Lading was issued less than 6 months before the Priority Date (i.e. less than 1 year before the Application Date). It does not bear any reference to any of the Opponent's Companies. The consignee is Mao Ying Trading and the port of discharge is in Mainland China. There is no information on how “菲仕蘭” was used on the goods or their packaging; and
- There is a lack of evidence which shows that there has been any exposure of fish oil capsules bearing the Opponent's Marks to the Hong Kong market. There is no evidence on any sale of goods or provision of services by reference to the Opponent's Marks to customers or business entities, or on any advertising or promotion of such goods or services, in Hong Kong.

47. Taking into account all of the above, I do not find that the Opponent's Companies have established the requisite goodwill or reputation in Hong Kong which is known by any of the Opponent's Marks to mount a passing off action in Hong Kong at the Priority Date (in respect of subject mark A) or the Application Date (in respect of subject mark B). It follows that the ground of opposition under section 12(5)(a) necessarily fails.

Sections 11(5)(b) of the Ordinance

48. Section 11(5)(b) of the Ordinance states:

“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.”

49. The term “bad faith” is not defined in the Ordinance. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367, Lindsay J. stated the following in relation to section 3(6) of the U.K. Trade Marks Act 1994 (equivalent to section 11(5)(b) of the Ordinance):

“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 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.”

50. In *Harrison v Teton Valley Trading Co (CHINAWHITE)*, 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.”

51. In the case of *Ajit Weekly Trade Mark* [2006] R.P.C. 25, the Appointed Person stated (at paragraph 44):

“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.”

52. 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 paragraph 31). Cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith (*Brutt Trade Marks* [2007] R.P.C. 19 at paragraph 29).

53. According to paragraph 11 of the Grounds of Opposition, the Opponent's case under section 11(5)(b) of the Ordinance is that:

- The subject marks are confusingly similar to the Opponent's Marks as both contain the highly distinctive element “菲仕蘭” and the subject goods and services are similar and/or related to the goods used by the Opponent's Companies or covered by the trade mark registrations of the Opponent's Companies;
- It is obvious that the Applicant intended to deprive the Opponent's Companies of the rights to use and register the Opponent's Marks in Hong Kong by filing the application for registration of the subject marks without any notice to the Opponent's Companies and without any authorisation from the Opponent's Companies; and
- The Applicant's conduct is dishonest judged by ordinary standards of honest people. The filing of the subject marks by the Applicant clearly falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field. The Applicant has obviously filed the application for the subject marks in bad faith.

54. The issue under section 11(5)(b) of the Ordinance is whether the subject application was made in bad faith. The burden of proof rests on the Opponent.

55. In respect of the Opponent's bad faith claim, the Applicant's response is that it has been using the trade name “Friesland” since the 19th century and the subject marks consist of its Chinese trade name, i.e. Dutch Royal Friesland in Chinese characters. The

Applicant further contends that, in view of the Opponent's Parent Company's previous role as the sales agent of the predecessor of the Applicant in Taiwan and the relationship between the Opponent and its Parent Company, the Opponent must have been fully aware of the subject mark and the Applicant's legitimate rights in its Chinese trade name.¹⁴

56. It is common ground that the Opponent's Parent Company had previously been the sales agent of the predecessor of the Applicant in Taiwan. While the Applicant has not filed any evidence, its claims are, to a certain extent, corroborated by the evidence filed by the Opponent. In particular, the Opponent's evidence shows that such predecessor of the Applicant was a Dutch company named Cooperative Condensfabriek "**Friesland**" W.A. (**emphasis** added).¹⁵ It is clear that as sales agent, the Opponent's Parent Company would have been well aware of this.
57. I note that the Hong Kong trade mark registrations owned by the Opponent's HK Branch have already been revoked with effect from 16 August 2012. I have also found above that the Opponent has failed to establish the requisite goodwill or reputation in Hong Kong which is known by any of the Opponent's Marks to mount a passing off action in Hong Kong at the Priority Date (in the case of subject mark A) or the Application Date (in the case of subject mark B).
58. Taking into account all the relevant circumstances of this case, I find that there is no material before me which could form the basis of the conclusion that in applying for registration of the subject mark, the Applicant's conduct is dishonest or otherwise falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the trade.
59. I find that the opposition under section 11(5)(b) of the Ordinance also fails.

¹⁴ See paras. 20 and 21 above.

¹⁵ See also para. 16 above.

Opposition under section 12(5)(b) of the Ordinance

60. Section 12(5)(b) of the Ordinance provides:

“(5)... a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented-
... (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.”

61. According to paragraph 12 of the Grounds of Opposition, the Opponent’s case under section 12(5)(b) of the Ordinance is that:

“By reasons of [the matters quoted in paragraph 24 above], registration of [the subject mark] shall be refused as its use in Hong Kong is liable to be prevented by the Opponent who has earlier rights in relation to the Opponent’s Marks. Use of [the subject mark] would constitute... an act of copyright and registration of [the subject mark] shall be prohibited under... Section 12(5)(b) of [the Ordinance].”

62. Though section 12(5)(b) is pleaded in the Grounds of Opposition, there is a lack of particulars to support the assertion that the use of the subject marks is prohibited by the law of copyright. The Opponent has not pleaded in the Grounds of Opposition that it owns any copyright in any of the Opponent’s Marks. There is also no information, let alone evidence, on any copyright work(s) relied upon.

63. In the circumstances, the ground of opposition under section 12(5)(b) of the Ordinance is neither properly pleaded nor made out.

Conclusion and costs

64. As the opposition has failed, I award the Applicant costs.
65. 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 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.

(Jasmine Kun)
for Registrar of Trade Marks
20 May 2019

Subject goods and services

Class 5

Pharmaceutical and veterinary preparations; dietetic and fortifying substances for medical use; food for babies; nutritional additives, not included in other classes; vitamin preparations; food and beverages for medical dietetic use, with or without the addition of vitamins, minerals, proteins and/or carbohydrates, whether or not intended for sportsmen; food, nutritional additives and fortifying substances for animals, for veterinary use; ingredients for the aforementioned products, included in this class, namely lactose and milk ferments; prebiotics and probiotics for medical and veterinary use; supplements and additives for feed and animal feed, not for medical use; fortifying substances for animals, not for medical use.

Class 29

Meat, fish, poultry and game; meat extracts; meat substitutes, not included in other classes; soups; potato products, not included in other classes; preserved, dried and cooked fruits and vegetables; jellies, jams, eggs, dairy products; dairy-based beverages, in which the dairy component is the main ingredient; dairy products for dietetic purposes (not for medicinal use); preserved dairy products; spreads, not included in other classes; milk and milk products, including reduced fat milk, milk and milk products with low caloric values as well as substitutes therefor, not included in other classes; milk powder; evaporated (condensed) milk, sweetened or otherwise; milkshakes; fermented dairy products; buttermilk; yoghurt and yoghurt products; cottage cheese, quark; cheese and cheese products; cream; whipped cream; sour cream; crème fraîche; evaporated milk and coffee cream and substitutes therefor, including so-called "creamers"; dairy desserts, fruit desserts, fish mousses and vegetable mousses, not included in other classes; dairy-based ingredients and preparations to be used for the

preparation and/or production of beverages; aforementioned dairy products natural as well as with the addition of fruits, fruit juices, flavourings, nuts, seeds, tea, herbs, spices, mustard, coffee, cocoa, honey, vitamins, minerals and/or other additives; edible oils and fats and mixtures thereof, whether or not with a reduced fat and/or reduced caloric value; butter; clarified butter (butter ghee); ready-made meals made from dairy [dairy predominating], semi-prepared meals made from dairy [dairy predominating], milk beverages, yoghurt drinks, dairy substitutes, sweet snacks made from dairy, not included in other classes; dairy products and derivatives thereof used as ingredient and/or semi finished product for food and beverages; dairy products, including milk and milk drinks with casein, proteins and calcium.

Class 30

Chocolate and coffee beverages, including chocolate milk and coffee beverages with lower caloric values, as well as preparations for their manufacture, not included in other classes; products (mainly) made on the basis of honey (not included in other classes); beverages made on the basis of tea, chocolate, cocoa or coffee with honey as an ingredient, as well as preparations for their manufacture, not included in other classes; flour and cereal preparations and food made with these, namely, meal bars; gruel with a basis of milk or milk products for food; spreads, not included in other classes; puddings, Bavarois (confectionery), mousses and desserts (confectionery) not included in other classes, with or without the addition of fruits, fruit juices, nuts or other additives or flavourings; pastries and confectionery; bakery goods; glucose syrup and powder for food purposes; ice cream (edible ices); sauces; cream stabilizer; powders for ice cream (edible ices); thickening agents for ice cream (edible ices); glucose in powder form for the preparation of food; spices and season mixtures in powder form, for the preparation of meals; ready-to-eat meals made from cereal, half prepared meals made from cereal, cereal substitutes for meals, savory snacks not included in other classes; custard.

Class 31

Foodstuffs for animals and ingredients therefor of animal or vegetable origin not included in other classes; dietetic foodstuffs for animals, ingredients therefor.

Class 35

Import and export, retail and wholesale services of pharmaceutical and veterinary preparations; dietetic and fortifying substances for medical use; food for babies; nutritional additives, not included in other classes; vitamin preparations; food and beverages for medical dietetic use, with or without the addition of vitamins, minerals, proteins and/or carbohydrates, whether or not intended for sportsmen; food, nutritional additives and fortifying substances for animals, for veterinary use; ingredients for the aforementioned products, included in this class, namely lactose and milk ferments; prebiotics and probiotics for medical and veterinary use; supplements and additives for feed and animal feed, not for medical use; fortifying substances for animals, not for medical use; meat, fish, poultry and game; meat extracts; meat substitutes, not included in other classes; soups; potato products, not included in other classes; preserved, dried and cooked fruits and vegetables; jellies, jams, eggs, dairy products; dairy-based beverages, in which the dairy component is the main ingredient; dairy products for dietetic purposes (not for medicinal use); preserved dairy products; spreads, not included in other classes; milk and milk products, including reduced fat milk, milk and milk products with low caloric values as well as substitutes therefor, not included in other classes; milk powder; evaporated (condensed) milk, sweetened or otherwise; milkshakes; fermented dairy products; buttermilk; yoghurt and yoghurt products; cottage cheese, quark; cheese and cheese products; cream; whipped cream; sour cream; crème fraîche; evaporated milk and coffee cream and substitutes therefor, including so-called "creamers"; dairy desserts, fruit desserts, fish mousses and vegetable mousses, not included in other classes;

dairy-based ingredients and preparations to be used for the preparation and/or production of beverages; aforementioned dairy products natural as well as with the addition of fruits, fruit juices, flavourings, nuts, seeds, tea, herbs, spices, mustard, coffee, cocoa, honey, vitamins, minerals and/or other additives; edible oils and fats and mixtures thereof, whether or not with a reduced fat and/or reduced caloric value; butter; clarified butter (butter ghee); ready-made meals made from dairy [dairy predominating], semi-prepared meals made from dairy [dairy predominating], milk beverages, yoghurt drinks, dairy substitutes, sweet snacks made from dairy, not included in other classes; dairy products and derivatives thereof used as ingredient and/or semi finished product for food and beverages; dairy products, including milk and milk drinks with casein, proteins and calcium; chocolate and coffee beverages, including chocolate milk and coffee beverages with lower caloric values, as well as preparations for their manufacture, not included in other classes; products (mainly) made on the basis of honey (not included in other classes); beverages made on the basis of tea, chocolate, cocoa or coffee with honey as an ingredient, as well as preparations for their manufacture, not included in other classes; flour and cereal preparations and food made with these, namely, meal bars; gruel with a basis of milk or milk products for food; spreads, not included in other classes; puddings, Bavarois (confectionery), mousses and desserts (confectionery) not included in other classes, with or without the addition of fruits, fruit juices, nuts or other additives or flavourings; pastries and confectionery; bakery goods; glucose syrup and powder for food purposes; ice cream (edible ices); sauces; cream stabilizer; powders for ice cream (edible ices); thickening agents for ice cream (edible ices); glucose in powder form for the preparation of food; spices and season mixtures in powder form, for the preparation of meals; ready-to-eat meals made from cereal, half-prepared meals made from cereal, cereal substitutes for meals, savory snacks not included in other classes; custard; foodstuffs for animals and ingredients therefor of animal or vegetable origin not included in other classes; dietetic foodstuffs for animals, ingredients therefor.

Annex 2

**Taiwan registered trade marks owned by the Opponent or the
Opponent's Parent Company**

No.	Trade Mark	Registration No.	Filing Date
1.	菲仕蘭	271540	23-05-1984
2.	菲仕蘭	281265	23-05-1984
3.	菲仕蘭	28297	12-03-1987
4.	菲仕蘭 FEISHILAN	471042	04-05-1989
5.	菲仕蘭 FRESHLAND	481724	10-08-1989
6.	菲仕蘭 FRESHLAND	482700	10-08-1989
7.	菲仕蘭 FRESHLAND	482788	22-08-1989
8.	菲仕蘭 [®]	691346	22-10-1994
9.	菲仕蘭	695929	22-10-1994
10.	菲仕蘭	818461	02-07-1997
11.	菲仕蘭 [™]	111881	14-07-1998
12.	菲仕蘭 [®]	860294	14-07-1998
13.	菲仕蘭 Freshland	877731	12-02-1999
14.	菲仕蘭 [™]	918194	28-09-1999

Note: Apart from items 3¹⁶ and 11¹⁷, the above registrations have been cancelled in 2015 or 2016.

¹⁶ Registered in respect of “代理國內外產品之報價、投標之服務。” (agency services for price quotation of domestic and foreign products, bidding quotation services).

¹⁷ Registered in respect of “冷熱飲料店、飲食店、小吃店、冰果店、茶室、餐廳、咖啡廳、啤酒屋、酒吧、飯店、賓館、旅社、旅館。” (hot and cold drinks shop, restaurant, snack bar, ice fruit shop, tea room, restaurant, cafe, beer house, bar, hotel, guesthouse, hostel, hotel).

Annex 3

**P.R.C. registered trade marks owned by the Opponent's HK
Branch**

Trade Mark	Registration No.	Filing Date	Class
菲仕蘭	512218	14-04-1989	29
菲仕蘭	512025	14-04-1989	30

Annex 4

**Hong Kong registered trade marks previously owned by the
Opponent's HK Branch**

Trade Mark	Registration No.	Filing Date	Class
菲仕蘭™	200213481	15-08-1994	30
菲仕蘭™	200213482	15-08-1994	29

Note: The above registrations have been revoked with effect from 16 August 2012.