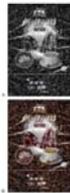


TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 301017846



MARK:

CLASS: 30

APPLICANT: WHITE CAFE SDN. BHD.

OPPONENT: IOT FOOD INDUSTRIES SDN BHD

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 December 2007 (“Application Date”), White Cafe Sdn. Bhd. (“Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“Ordinance”) for the registration of two marks as a series (collectively referred to as “suit marks”), a representation of which is set forth in the Appendix A. Registration is sought in respect of the following goods in Class 30.

Class 30

Coffee; tea; coffee-based beverages; cocoa-based beverages; chocolate-based beverages; coffee beverages with milk; cocoa; artificial coffee; coffee flavorings (flavourings); vegetal preparations for use as coffee substitutes; confectionery; sauces (condiments); cookies; frozen yogurt (confectionery ices); ice cream; ices; fruit jellies (confectionery); marzipan; waffles.

2. Particulars of the application were published on 20 February 2009. On 30 March 2009, Iot Food Industries Sdn Bhd (“Opponent”) filed a notice of opposition against the application together with a statement of the grounds of opposition. In response to the notice of opposition filed, the Applicant filed a counter-statement on 2 July 2009.

3. The evidence of the Applicant is in the form of a statutory declaration made by Goh Chin Mun (“Goh Declaration”). As for the Opponent, a total of four statutory declarations were filed, all made by Ng Hsien Wei. They were declared on 11 December 2009 (“First Ng Declaration”), 29 December 2009 (“Second Ng Declaration”), 13 January 2010 (“Third Ng Declaration”) and 26 November 2010 (“Fourth Ng Declaration”). The Second Ng Declaration serves only to verify the date the First Ng Declaration was made and the Third Ng Declaration corrects a typographical error made in the First Ng Declaration. These two declarations will thus not be further referred to.

4. Some other documents were actually submitted by the parties as and when the notice of opposition and the counter-statement were filed respectively. However, since they were not filed by way of a statutory declaration or affidavit, they do not comply with the requirements of rule 79 of the Trade Marks Rules (Cap. 559A) and will thus not be regarded as evidence.

5. On the Application Date, the Applicant filed another application for the registration of two other marks in series, a representation of which is set forth in the Appendix B, Trade Mark Application No. 301017837. This application is also opposed by the Opponent. In addition, the Opponent is also seeking a declaration of invalidity of a registered mark of the Applicant under section 53 of the Ordinance. The mark under consideration in the invalidation proceedings is Trade Mark No. 300252972 and a representation of this mark is in Appendix C. All three proceedings were fixed to be heard one after another on 15 January 2013. The Opponent did not file a notice of intention to appear at the hearing. On the Applicant’s side, Mr. Gary Lam, counsel instructed by Messrs. Tse Yuen Ting Wong, appeared on its behalf.

Grounds of opposition

6. The grounds of opposition relied on, as clearly set out in the First Ng Declaration and the Fourth Ng Declaration rather than the notice of opposition, are section 11(1)(c) and 11(4)(b) of the Ordinance. The Opponent objects to the registration of the suit marks on the basis that the term “Ipoh Old Town White Coffee” is a widely known description of the specific geographical place and the historical background of a blend of coffee and that the use of the terms “Ipoh”, “Old Town” and “White Coffee” (whether written in English or Chinese) will mislead and confuse the public as to the original producer/ maker/manufacturer of white coffee.

Applicant's evidence

7. Goh Chin Mun is the Managing Director of the Applicant. According to the Goh Declaration, the Applicant started to operate a coffee shop in Ipoh Old Town, a small city in the northern part of Malaysia since as early as 1958. Over the years, the Applicant has gone through many progressive changes in an effort to keep up with times and satisfy the tastes of coffee lovers, one of which was the pioneer development of the 3-in-1 white coffee product. Copies of reports and articles from the press in Malaysia and other materials attached in "Exhibit A" of the Goh Declaration are produced to show the recognition of the products of the Applicant. There is nothing nonetheless to suggest that the Applicant's products enjoy the same reputation in Hong Kong.

8. Among the articles in "Exhibit A", there is one printed in Chinese that reports the expansion of the Applicant's business into China. In the second and third columns of that page, the sites of the various factories of the Applicant are mentioned. It is reported there that the Applicant has a factory for roasting coffee beans in Ipoh.

9. The Applicant has obtained registration of "怡保舊街場", its English version "IPOH OLD TOWN", "OLD TOWN WHITE COFFEE", "OLD TOWN" and "舊街場" in respect of coffee, coffee-based products, tea and cocoa-based products in a number of jurisdictions, including Hong Kong. A selection of the related trade mark registration certificates are shown in "Exhibit B". It can be gleaned from the information in that exhibit that in Hong Kong, the Applicant holds four trade mark registrations. The marks involved are "怡保舊街場", "OLDTOWN 舊街場", "舊街場白" and "OLDTOWN WHITE", with the earliest application being filed in respect of "怡保舊街場" in July 2004.¹

10. The Applicant claims first use of the suit marks in Malaysia in January 2003 and in Hong Kong in September 2003. In paragraph 11 of the Goh Declaration, the annual sales of products of the Applicant which bear the suit marks are set out. The figures relate to the years of 2003-2010. Taking the figures for the years from 2003 to 2007,² the average annual sales made in Hong Kong is about 2.9 million

¹ There is another mark registered in Hong Kong that is included in Exhibit B. The mark is "舊街場白" and it is registered in respect of services in Class 43 (Trade Mark No. 301017828). The owner of this registered mark is Kopitiam Asia Pacific Sdn. Bhd. As the relationship of this company with the Applicant has not been accounted for, this registration is not considered as a registration held by the Applicant.

² For the year 2007, since the Application Date is 19 December 2007, the pro rata amount for 11 months only has been taken into account.

Malaysian Ringgits. It should be noted though that this figure is not supported by sales invoices as the samples attached in “Exhibit D” are for the years 2009 and 2010 only.

11. Promotion of the products of the Applicant is also mentioned, with details of the advertising expenditure for the years 2003-2009 set forth. Samples of the advertisements are shown in “Exhibit C”, but all of them either do not show the dates or are dated after the Application Date. All the invoices for placing the advertisements that are included in “Exhibit C” post-date the Application Date.

12. One thing notable is that the evidence of the Applicant relates to the sale of coffee only and nothing else. The Applicant will not be entitled to claim that there has been use of the suit marks on any other products covered by the specification of the subject application. A more important matter is the fact that the evidence submitted by the Applicant for this opposition, the opposition against Trade Mark Application No. 301017837 and the invalidation proceedings in relation to Trade Mark No. 300252972 is almost identical. In terms of the details of the sales figures and the advertising expenditure for the respective marks in question, they are the same. As the three sets of marks differ from one another in material aspects, without further account of the amount attributable to the use of each set of mark or marks, the figures, to say the least, offer no help in determining the extent of use of each individual set of mark or marks.

Opponent’s evidence

13. Ng Hsien Wei is the Managing Director of the Opponent, a company incorporated under the laws of Malaysia. According to him, the term “Ipoh Old Town White Coffee” is synonymous to a blend of coffee which originated from and was made famous by the cafés located at the older part of the Ipoh Town in Malaysia. In support of this statement, Ng refers to copies of a few articles from the internet which are shown in “Exhibits NHW-1(a)-(d)”. The articles are all in English and there is mention in each of what white coffee is, which tallies with what Ng has stated.

14. As for the notoriety of the term “white coffee”, it was averred that coffee drinkers have come to recognize the term as coffee that is produced with only margarine, without sugar, in the roasting process and the Ipoh Old Town area is where white coffee originated. There is also an assertion that Ipoh Old Town White Coffee

blend of coffee beverage is common knowledge among coffee drinkers around the world. Copies of articles from two websites (www.bignewsnetwork.com and www.hindustantimes.com) are produced in “Exhibit NHW-6” in support of this assertion. The articles are dated 26 October 2010 and 25 September 2010 respectively and the contents of them are exactly the same. In the first paragraph of the two articles, it is stated that *“Coffee drinkers from across the world are now flocking to Malaysia’s Ipoh city to taste a beverage created there for the first time – white coffee.”*

15. On the well known status of the term “Ipoh Old Town White Coffee”, Ng specifically refers to the result of over 80,000 hits on the internet when a search for that term was made on 25 October 2010. Page one of the report from that internet search can be found in “Exhibit NHW-7”. In “Exhibit NHW-8”, the meaning of “Ipoh white coffee” as provided by Wikipedia is shown. The search was also carried out on 25 October 2010 and in it, the term “Ipoh white coffee” is described as generic and that in Chinese it reads “怡保白咖啡”. There is also mention of Ipoh White Coffee being adopted as one of the official drinks in the Malaysia Pavilion at the World Expo 2010 held in Shanghai, China.

16. Ng has also pointed to the offer of tour packages in Hong Kong to bring tourists to visit the old town of Ipoh. Pamphlets of tour packages in “Exhibit NHW-2” are supposed to prove the situation as stated. However, the effective date printed on all those pamphlets is 6 August 2009. That being the case, they offer no assistance for ascertaining the position as at the Application Date.

17. Information about other parties selling “Ipoh old town white coffee” as a product can also be found in the First Ng Declaration, with copies of the packaging used by those parties attached in “Exhibit NHW-3”. Two of these have the words “Ipoh Old Town” and “White Coffee” and the Chinese characters “怡保”, “舊街場” and “白咖啡” appearing on them. Two others have “Ipoh”, “White Coffee” and “怡保白咖啡”. Of the remaining two, one has “White Coffee” and “Old Town” but no Chinese equivalent, while the other has “Premix Original Ipoh” and “White Coffee”, but again no corresponding Chinese versions. It is not clear though from the statutory declaration whether those companies were selling their products as at the Application Date and if so, whether they were sold in Hong Kong. However, on the package of one of such products,³ a price label can be seen, and the amount is 9.20 RM, the currency of Malaysia. Without additional information to show that those

³ The product of Aik Cheong.

products were in fact sold in Hong Kong as at the Application Date, it is not for me to infer that that is the case.

18. The evidence of the Opponent includes information on the further development of three trade mark applications filed by the Applicant in Malaysia, which have been referred to by the Opponent in the notice of opposition filed. According to the Opponent, the Applicant succeeded in registering one of the marks applied for in Malaysia because a wrong transliteration of the term “怡保舊街場” was provided to the trade marks registry of Malaysia.

19. There is also mention in the Fourth Ng Declaration that there is no documentary evidence to prove that the Applicant is the original producer of 3-in-1 instant white coffee or to show that the products of the Applicant is or refers to the actual or original or authentic white coffee made in Ipoh Old Town. It is not clear though from the Opponent’s evidence how any such claim has been made by the Applicant in relation to its products.

Section 11(1)(c)

20. Section 11(1)(c) and (2) of the Ordinance read as follows –

“(1) Subject to subsection (2), the following shall not be registered-

...

(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

...

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d), if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

21. The Opponent objects to the application for registration of the suit marks on the ground that Ipoh is a city in Malaysia and it is widely known that Ipoh is best for its blend of white coffee known as “Ipoh Old Town White Coffee”. Although the Applicant does not dispute that Ipoh is a place in Malaysia and white coffee is sold by many traders, the critical point at issue here is whether each of the suit marks consists

exclusively of descriptive signs, that is, each of them consists of descriptive signs only and nothing else.

22. The suit marks are not mere word marks. Each of them comprises of words and various pictorial elements. The objections of the Opponent, as can be discerned from the notice of opposition and the various statutory declarations filed, are directed at the use of the terms “Ipoh Old Town White Coffee” and “舊街場白咖啡”. Nonetheless, each of the suit marks has at least four pictorial elements, the logo above the three big Chinese characters “舊街場”, the street scene at the centre, the cup of coffee at the lower right hand corner of the street scene and the coffee beans forming the background of the package. I see no complaints from the Opponent on the pictorial elements that appear on the suit marks.

23. At the hearing, Mr. Lam provided me with an enlarged version of the suit marks, but still the minute details of the logo in the suit marks are beyond normal vision. Yet, the general outline can be made out and it appears to be a logo, somewhat oval in shape, showing a street scene similar to, if not the same as, the one at the centre of the suit marks. The street scene of the logo is bordered, giving it the appearance of a picture within a frame.

24. The street scene at the centre of the suit marks is much larger in size and it occupies a prominent position. More details can be observed from this street scene and rickshaw-like conveyances are depicted. The buildings on the sides of the streets are all low-rise and in the case of Mark B in the series, with the sepia tone adopted for the display of the street scene, a practice which was common in the era when colour photographs were not available, the street scene gives the impression of an ancient old town.

25. The goods applied for are food and drink items that people consume all the time. The relevant consumers of such goods are therefore members of the general public. To the average consumer in Hong Kong, the street scene at the centre of the suit marks and the logo will not serve to designate the geographical origin or any other characteristic of the goods under consideration. In light of the significance of these two elements in the overall impression conveyed by the suit marks, even if the terms “Ipoh Old Town White Coffee” and “舊街場白咖啡” were to be considered descriptive, neither of the suit marks consists exclusively of signs which may serve, in trade or business, to designate the geographical origin or any other characteristic of

the goods applied for.⁴ The suit marks therefore do not fall foul of section 11(1)(c) of the Ordinance.

26. I should perhaps deal with one other matter before proceeding to the other ground of objection. The Applicant seeks to rely on various articles on the internet to establish the notoriety of the Ipoh Old Town White Coffee. There is no magic about information that is available on the internet. Matters reported on the internet are not necessarily well known facts. It is not possible to expect people to know everything that can be found on the internet. Without additional information such as the number of parties from Hong Kong that have accessed those websites, there is simply no footing to base a finding that the relevant consumers in Hong Kong are conversant with or otherwise interested in the origin of the white coffee of Ipoh just because there is such information on the internet.

27. Further, I have, in setting out the Opponent's evidence in the above, referred to the articles printed from the two internet websites in "Exhibit NHW-6", and quoted the passage "*Coffee drinkers from across the world are **now** flocking to Malaysia's Ipoh city to taste a beverage created there for the **first time** – white coffee.*" (emphasis added) that appears in them. Of course the two 2010 articles are not helpful for deciding the case because they do not relate to the position as at the Application Date. Nonetheless, it is clear from the passage that prior to 2010, Ipoh white coffee did not draw much attention from people outside Malaysia. Hence, the two articles tend to show that the relevant consumers in Hong Kong were unlikely to know about Ipoh white coffee when the application for registration of the suit marks was filed.

Section 11(4)(b)

28. Section 11(4)(b) of the Ordinance reads as follows –

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

29. The basis for this ground of objection is stated by the Opponent in paragraph 8 of the First Ng Declaration. The Opponent takes the view that, to allow the registration of “Ipoh”, “Old Town” and “White Coffee” collectively will mislead

⁴ At the hearing, Mr. Lam referred to the decision of the Registrar in the case of opposition to Trade Mark Application No. 300685873 in support. The decision can be found at the Registry's website www.ipd.gov.hk.

and/or confuse the public as to the original producer/maker/manufacture of white coffee. As the objection is directed at coffee only and not the other goods that are included in the specification of the application of the suit marks, I will consider the ground of opposition in relation to coffee only. In any event, as was correctly put to me at the hearing by Mr. Lam, the onus of proof is on the Opponent to establish that this ground of objection applies. Not having mentioned anything about how the use of the suit marks on the goods applied for other than coffee is likely to deceive the public, it is not for me to fill in the gap for the Opponent.

30. The words “IPOH OLD TOWN WHITE COFFEE” do appear in the suit marks as one single phrase, as well as the phrase “正宗怡保舊街場白咖啡” in Chinese, but in rather small prints. There is no evidence as to the message that will be conveyed to the relevant consumers in Hong Kong when they see the phrase “IPOH OLD TOWN WHITE COFFEE” and/or “正宗怡保舊街場白咖啡” being used on the packaging of the Applicant’s coffee. I will therefore have to take the place of an average consumer in Hong Kong and consider what the phrase tells me about the original producer/maker/manufacture of white coffee.

31. Mr. Lam pointed to the meaning of “white coffee” as averred to in the First Ng Declaration and the Fourth Ng Declaration, as well as the Opponent’s account of the origin of white coffee there. In his view, the phrases “IPOH OLD TOWN WHITE COFFEE” and “正宗怡保舊街場白咖啡” would merely tell consumers that the coffee has the characteristics of white coffee, namely the beans are roasted in a particular way, but would not convey the message that the products come from Malaysia.

32. I find good sense in this submission of Mr. Lam. The phrases are simply part of the overall design of the suit marks which can be used as the packaging for the coffee products of the Applicant. The words “producer”, “maker” and “manufacturer” are not used at all on the suit marks. Attention should also be paid to the use of the characters “正宗” in the Chinese phrase. When used in the phrase “正宗怡保舊街場白咖啡”, the message communicated is one about the characteristic of the white coffee inside the package, that is, the beans are roasted in the style that white coffee of Ipoh are carried out. Hence, I cannot see how the use of any of the two phrases or, for that matter, any other elements in the suit marks can pass on any information about the original producer/maker/manufacture of white coffee. Ergo, how would the relevant consumers be misled or confused as to the identity of such party?

33. The statements in the Fourth Ng Declaration about the lack of evidence to show that the Applicant is the original producer of 3-in-1 instant white coffee may also be taken as the reason why the Opponent considers the suit marks to be deceptive. However, I do not find the suit marks to be a carrier of any such message. A claim that the 3-in-1 instant white coffee was developed by the Applicant after research can indeed be found in the newspaper article in “Exhibit A” of the Goh Declaration (“the News Article”), but the Applicant did not claim to be the original producer.⁵ In any event, no such claim can be deciphered from the suit marks.

34. As regards the suggestion that the Applicant is claiming that its products are the actual or original or authentic white coffee made in Ipoh Old Town, without further elaboration by the Opponent as to how this would be misleading, I cannot see any falsity in such a claim. In particular, I note from the News Article that the Applicant does have factories in Ipoh. If it is the Opponent’s case that the suit marks are misleading because the coffee of the Applicant is not from Ipoh old town, it has to adduce evidence to establish that, the onus being on its shoulders. There is no such evidence. In any event, I do not find the two phrases or other elements in the suit marks to be an indication of the place of origin of the coffee, when coffee can be roasted anywhere outside Malaysia. I also see nothing wrong in the inclusion of a phrase that informs consumers that the coffee is roasted in a particular fashion.

35. For the reasons stated above, the opposition under section 11(4)(b) is also unsuccessful.

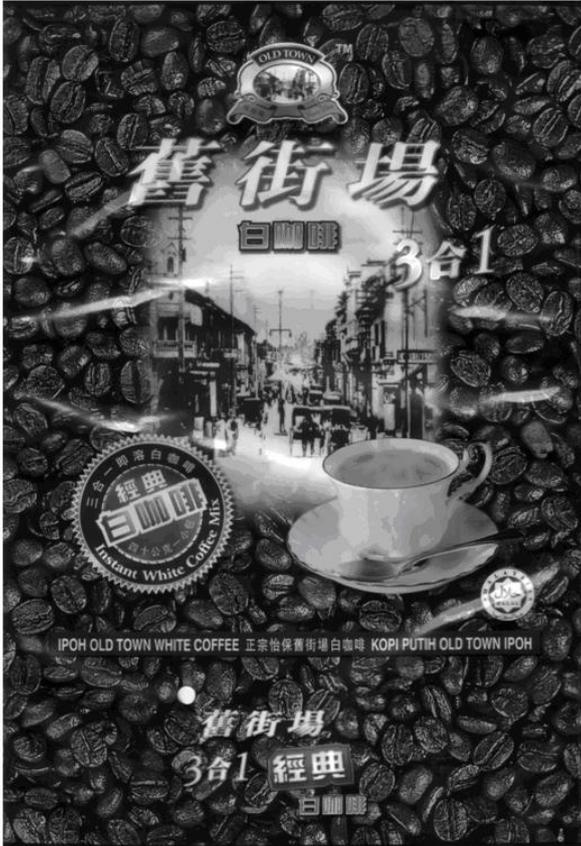
36. One other thing that I wish to deal with is the Opponent’s complaint about the incorrect translation or transliteration for the Chinese characters “怡保舊街場” that was provided by the Applicant to the trade marks authorities of Malaysia. Malaysia and Hong Kong are different legal jurisdictions and the acceptance of the suit marks for registration in Hong Kong is not based on acceptance of the same or similar marks in other jurisdictions. A more important matter is the fact that Chinese is one of the official languages of Hong Kong and applicants will not be asked to provide translation of any Chinese characters used in their trade marks. Examination of the marks will be carried out by officers who are conversant with the Chinese language. What happened with the trade mark applications filed by the Applicant in Malaysia is therefore of no relevance to the opposition under consideration.

⁵ In the latter part of that article, there is mention that 3-in-1 products had already been marketed in Europe, albeit not very popular there.

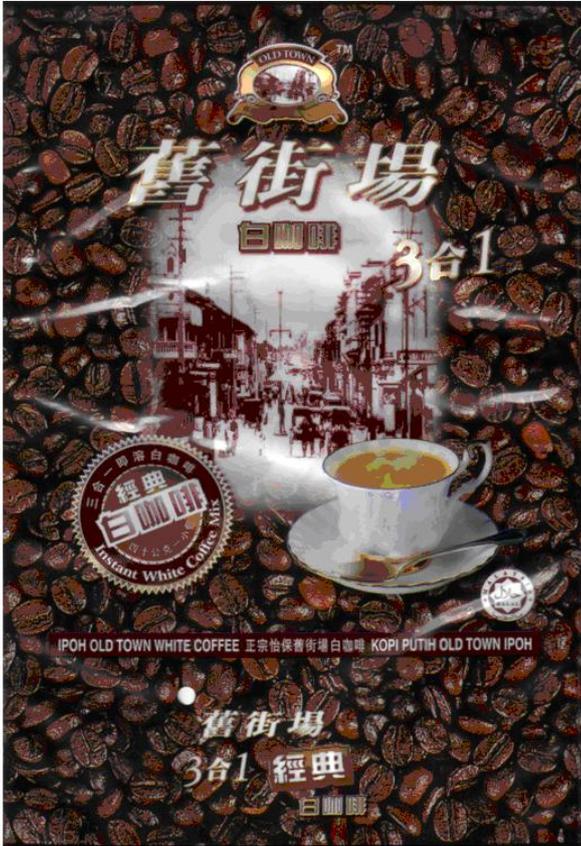
Costs

37. As the opposition is unsuccessful, I award the Applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, made by either party 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.

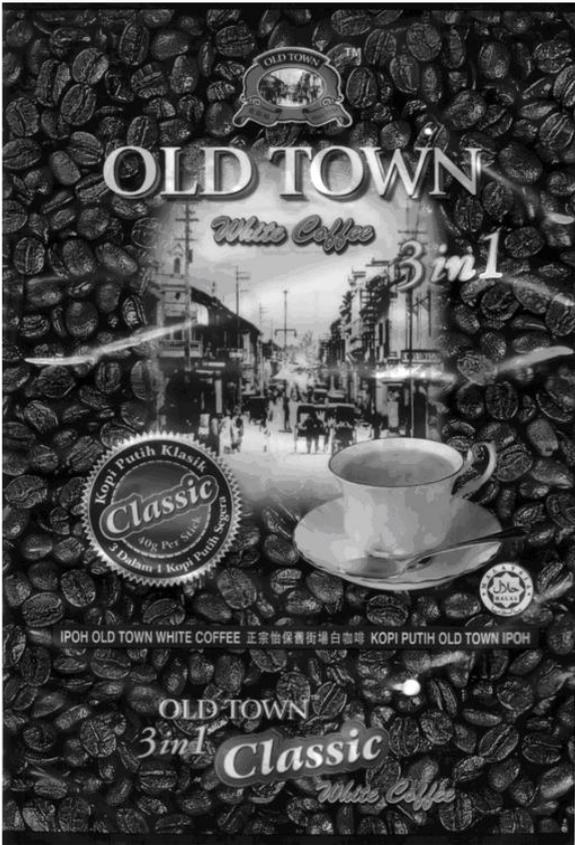
Caroline Chow
For Registrar of Trade Marks
28 March 2013



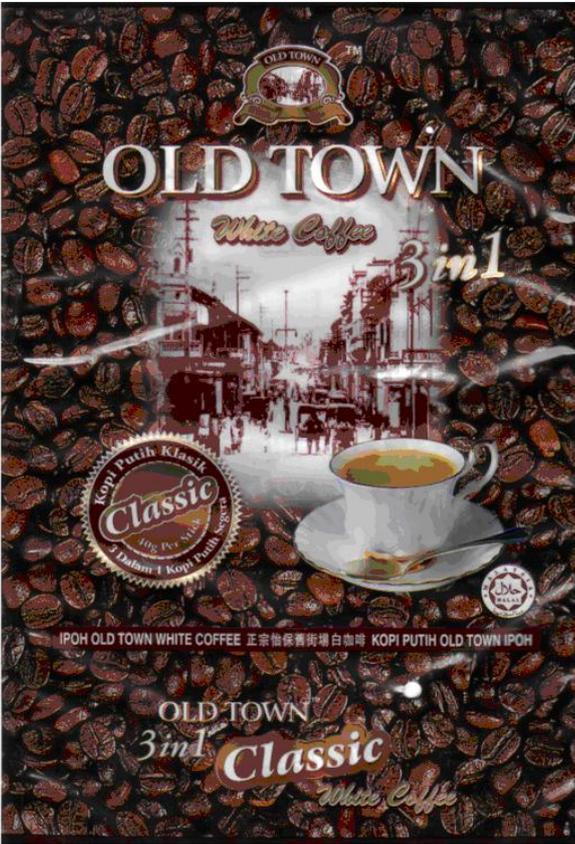
A.



B.



A.



B.

怡保舊街場