

TRADE MARKS ORDINANCE (CAP. 559)
OPPOSITION TO TRADE MARK APPLICATION NO. 304287097

Mark:

a2 Store

Classes: 5, 9, 29, 30, 35
Applicant: The a2 Milk Company Limited
Opponent: Société des Produits Nestlé S.A.

STATEMENT OF REASONS FOR DECISION

Background

1. On 27 September 2017, The a2 Milk Company Limited (“**Applicant**”) filed an application (“**Subject Application**”) under the Trade Marks Ordinance (Cap. 559) (“**Ordinance**”) for the registration of the following mark:

a2 Store

(“**Subject Mark**”).

2. Registration is sought in respect of the following goods in Classes 5, 9, 29 and 30 (“**Subject Goods**”) and services in Class 35 (“**Subject Services**”):

Class 5

Food for infants; powdered milk for babies; dietetic foods adapted for medical purposes; dietetic beverages adapted for medical purposes; dietary and nutritional supplements; protein dietary supplements.

Class 9

Computer software; downloadable computer software applications; downloadable electronic publications.

Class 29

Milk powder; milk; butter; cheese; cream; yoghurt; milk beverages, milk predominating.

Class 30

Ice cream; edible ices; frozen yoghurt; desserts, namely, bakery desserts, dessert puddings, and frozen desserts; pastries; confectionery.

Class 35

Retail services in relation to foods, beverages, food for infants, powdered milk for babies,

dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery; online retail store services; wholesale services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery; advertising; promotional services; customer loyalty program organisation and management.

3. Particulars of the Subject Application were published on 26 October 2018. Société des Produits Nestlé S.A. (“**Opponent**”) filed a notice of opposition, which includes a statement of grounds of opposition (“**Grounds of Opposition**”), on 22 January 2019.

4. The opposition hearing was scheduled to take place before me on 13 January 2023. Mr William Tse and Ms Kristy K Y Wong, Counsel, represented the Opponent. Mr Ling Chun Wai, Counsel, represented the Applicant. Both parties had filed skeleton submissions before the hearing. I reserved my decision at the end of the hearing.

Grounds of Opposition

5. In the Grounds of Opposition, the Opponent pleads that the term “A2” (or “a2”) designates one of the two primary variants of beta-casein protein contained in cow’s milk (the other being “A1”) and serves in the trade to designate that milk and milk-based products are free or predominantly free of A1 beta-casein protein or to refer to A2 beta-casein protein in such products, and that the relevant consumers in Hong Kong are familiar with such designations of the term.¹ Moreover, the word “store” has the ordinary meaning of “a quantity or supply of something kept for use as needed” or “a shop”.²

6. In light of the above, the Opponent contends that the Subject Mark, being a combination of “a2” and “Store” in an ordinary font type without any additional elements or stylisation³, directly describes:

- (1) in relation to the Subject Goods in Classes 5, 29 and 30, that the goods consist of, or contain as an ingredient, a quantity or supply of milk and/or milk powder containing A2 beta-casein protein or are free or predominantly free of A1 beta-casein protein;
- (2) in relation to the Subject Services in Class 35, that the services are a place where such milk-based products are sold, or that the promotional and customer loyalty programs are designed and catered for the sale and purchase of such milk-based

¹ Paragraphs 7 to 9 and 15 of the Grounds of Opposition.

² Paragraph 10 of the Grounds of Opposition.

³ Paragraph 6 of the Grounds of Opposition.

- products;
- (3) in relation to the Subject Goods in Class 9, that the goods are designed or provided for, or are about, A2 beta-casein protein and/or such milk-based products;⁴

hence, the Subject Mark should be precluded from registration under section 11(1)(c) of the Ordinance.⁵

7. In addition, given that the Subject Mark is entirely descriptive or customary in the trade in Hong Kong in respect of the Subjects Goods and Subject Services and thus devoid of any distinctive character, the Opponent requests that the Subject Application be refused under section 11(1)(b) of the Ordinance.⁶

Counter-Statement

8. The Applicant filed a counter-statement ("**Counter-Statement**") on 20 June 2019.

9. The Applicant denies the above contentions of the Opponent⁷, except that the Subject Mark is a combination of "a2" and "Store"⁸ and that the word "store" has the meaning of "a shop".⁹

10. The Applicant avers that the Subject Mark consists of a distinctive combination of "a2" and "Store", which has been accepted for publication by the Trade Marks Registry.¹⁰

11. According to the Counter-Statement, "a2" is the Applicant's trade mark and part of the Applicant's name.¹¹ Several of the Applicant's trade marks containing "a2" have been accepted for registration in Hong Kong and some other jurisdictions.¹²

12. In the Counter-Statement, the Applicant refers to section 11(2) of the Ordinance and avers that the Subject Mark does not fall within the absolute grounds for refusal under section 11 of the Ordinance.¹³ However, in its skeleton submissions filed before the hearing, the Applicant clarifies that it does not rely on section 11(2) of the Ordinance to argue that the Subject Mark has acquired distinctiveness through use.¹⁴

⁴ Paragraphs 11, 16 to 19 of the Grounds of Opposition.

⁵ Paragraph 20 of the Grounds of Opposition.

⁶ Paragraphs 22 and 23 of the Grounds of Opposition.

⁷ Paragraphs 5 to 12 and 14 of the Counter-Statement.

⁸ Paragraph 4 of the Counter-Statement.

⁹ Paragraph 6 of the Counter-Statement.

¹⁰ Paragraphs 5 and 6 of the Counter-Statement.

¹¹ Paragraph 8 of the Counter-Statement.

¹² Paragraph 5 of the Counter-Statement.

¹³ Paragraph 9 of the Counter-Statement.

¹⁴ Paragraph 40 of the Applicant's skeleton submissions.

Opponent's Main Evidence

13. The Opponent's main evidence consists of the Statutory Declaration of Isabelle de Blic-Hamon, Senior Legal Counsel IP of the Opponent, dated 13 December 2019 ("**de Blic-Hamon's 1st Declaration**") and the Statutory Declaration of Chan Wing Eleanor, Head of Legal, Hong Kong of Nestlé Hong Kong Limited, an associated company of the Opponent, dated 7 January 2020 ("**Chan's 1st Declaration**").

(i) de Blic-Hamon's 1st Declaration

14. According to de Blic-Hamon's 1st Declaration, there are two primary variants of beta-casein protein in cow's milk, namely A1 and A2.¹⁵ Although the formal scientific name of the A2 variant is "A2 beta-casein protein", the term "A2" or "A2 protein" is commonly used to refer to that protein type.¹⁶ Exhibit **IBH-3** contains articles and website printouts showing "A2" or "A2 protein" is used as a short form of, or reference to, A2 beta-casein protein. Exhibit **IBH-4** is a decision of the Australian Trade Marks Office dated 22 July 2019 acknowledging that "A2" is "a shorthand expression for the A2 beta-casein protein". Moreover, exhibits **IBH-7** to **IBH-9** are examples of the Applicant's use of the term "A2 protein" to refer to A2 beta-casein protein. These examples are found in a copy of the Applicant's presentation at the CLSA Investors' Forum, in the packaging of one of the Applicant's milk products, and on the Applicant's website www.a2australia.com.au between 14 April 2005 and 21 September 2007 as captured by the Wayback Machine Web Archive.

15. While most milk contains both forms of beta-casein protein, specially bred cows can produce milk that only, or primarily, contains A2 beta-casein protein.¹⁷ According to Ms de Blic-Hamon, the term "A2" is also commonly used to describe, and is the industry and consumer label for, milk or milk products that are free or predominantly free of A1 beta-casein protein, or to refer to the presence of A2 beta-casein protein in such products.¹⁸ Such a type of milk is commonly known as "A2 milk", in the same way as "skim milk" describes a type of milk with particularly low fat contents.¹⁹ Other products relating to "A2 milk" are also referred to using the term "A2", e.g. "A2 formula".²⁰ Exhibit **IBH-2** contains several academic journal articles about that type of milk. Exhibit **IBH-5** is an excerpt from the online version of the Macquarie Dictionary, which defines "A2 milk" as "milk which contains A2 beta-casein proteins, thought to be less allergenic than milk which contains A1 proteins". Exhibit **IBH-6** shows an online financial news report using the term "A2 milk" to refer to milk that "contains only the A2 beta-casein protein".

16. As expounded in Chan's 1st Declaration (see paragraph 23 below), there are perceived

¹⁵ Paragraph 7 of de Blic-Hamon's 1st Declaration.

¹⁶ Paragraph 9 of de Blic-Hamon's 1st Declaration.

¹⁷ Paragraph 8 of de Blic-Hamon's 1st Declaration.

¹⁸ Paragraphs 13 and 18 of de Blic-Hamon's 1st Declaration.

¹⁹ Paragraph 17 of de Blic-Hamon's 1st Declaration.

²⁰ Paragraph 13 of de Blic-Hamon's 1st Declaration.

health benefits for people with lactose intolerance to consume “A2 milk”. Ms de Blic-Hamon, therefore, argues that the term “A2” is perceived as a positive attribute against “regular” or “normal” milk. Moreover, as “A2 milk” is sourced from a particular type of cow, rather than having A1 beta-casein protein removed from ordinary milk, Ms de Blic-Hamon considers it more apt to describe the milk as “A2 milk” rather than “A1-free milk”.²¹

17. According to Ms de Blic-Hamon, given that the term “A2” is the most generic and reasonable way of describing products of that type and that the term “store” is descriptive of the Subject Goods and Subject Services, the application for the Subject Mark is an attempt to prevent competitors in the market from accessing the most obvious and reasonable descriptor for their goods and services.²² Exhibit **IBH-10** is a printout of the definitions of the word “store” in the online Cambridge Dictionary. Ms de Blic-Hamon contends that the term “a2 Store” naturally gives an allusion to “A2 protein” stored in the milk and dietary products covered by the Subject Goods in Classes 5, 29 and 30 or a retail place where “A2 milk” products are sold or offered for sale as covered by the Subject Services in Class 35.²³ As regards the Subject Goods in Class 9, Ms de Blic-Hamon states that another meaning of “store” in the online Cambridge Dictionary is “a computer memory” (though such a definition is not included in the printout under exhibit **IBH-10**) and that “A2” can easily be interpreted as a computer code.²⁴

18. Ms de Blic-Hamon considers that “a2” is the same as, or at least interchangeable with, “A2” to consumers, media and vendors alike²⁵, and produces as exhibit **IBH-11** some printouts of third-party webpages using “A2” instead of “a2” when referring to the Applicant or its products. Furthermore, Ms de Blic-Hamon contends that the Applicant uses “A2” and “a2” interchangeably and sought to register trade marks containing the element “A2” or “a2”.²⁶ Exhibit **IBH-12** contains printouts of details of the Applicant’s marks containing “A2” from the online registers of different jurisdictions. Marked as exhibit **IBH-13** are printouts of online register records of the Applicant’s refused or cancelled trade marks that contain the element “A2” or “a2” in various jurisdictions.

(ii) Chan’s 1st Declaration

19. According to Chan’s 1st Declaration, “A2 milk” products are readily available in Hong Kong. Exhibit **CWE-2** contains printouts of popular Hong Kong online shopping platforms such as HKTV mall, Ztore, Parknshop, and Wellcome showing the range of “A2 milk” products available. Included in exhibit **CWE-3** are photos of “A2” infant milk products in Hong Kong chain pharmacies and supermarkets. These products are not only from the Applicant but also from Nestlé Hong Kong and other manufacturers.²⁷

²¹ Paragraphs 15 and 16 of de Blic-Hamon’s 1st Declaration.

²² Paragraph 22 of de Blic-Hamon’s 1st Declaration.

²³ Paragraph 23 of de Blic-Hamon’s 1st Declaration.

²⁴ *Ibid.*

²⁵ Paragraph 24 of de Blic-Hamon’s 1st Declaration.

²⁶ Paragraph 25 of de Blic-Hamon’s 1st Declaration.

²⁷ Paragraphs 16 and 19 of Chan’s 1st Declaration.

20. Ms Chan states that there is a high and increasing local demand for “A2” infant milk products and presents a table showing the values (in terms of HK\$) of the “A2” infant formula market and their share in the total infant formula market between 2017 and 2019.²⁸

21. There has been a recent proliferation of advertisements of “A2 milk” products. Exhibit **CWE-4** contains examples of such advertisements in shopping centres, MTR stations and buses around Hong Kong. Ms Chan states that Nestlé Hong Kong and its subsidiary had spent over HK\$5 million on marketing and promoting “A2 milk” products as of September 2019.²⁹

22. There have also been news reports about “A2 milk” in local media.³⁰ Included in exhibit **CWE-5** are articles from the South China Morning Post and Hong Kong Economic Times that discuss “A2 milk”. However, as I shall discuss in paragraphs 76 to 78 below, it appears that the term “A2 Milk” in these articles refers to the Applicant instead of, as Ms Chan alleges, a type of milk.

23. Ms Chan speculates that the demand for “A2 milk” products in Hong Kong will continue to grow due to the health benefits of “A2 milk” to the local population. The vast majority of the Hong Kong population is ethnically Chinese, and studies have found that most Chinese are naturally lactose intolerant.³¹ However, there are recent studies showing that people who are lactose intolerant report experiencing fewer symptoms after drinking “A2 milk” than ordinary milk.³² Ms Chan produces exhibits **CWE-6** to **CWE-9** to support the above. Exhibit **CWE-6** is a printout from the website of the Race Relations Unit of the Home Affairs Department of the Hong Kong SAR Government stating that about 92% of the Hong Kong population is ethnically Chinese. Exhibit **CWE-7** contains some online articles discussing the widespread prevalence of lactose intolerance among Chinese populations. Marked as exhibit **CWE-8** are various research articles on the benefits of “A2 milk” on people who are lactose intolerant. Exhibit **CWE-9** is an article by Hong Kong Adventist Hospital summarising these research findings.

Applicant’s Evidence

24. The Applicant’s evidence consists of the Statutory Declaration of Susan Massasso, the Chief Growth and Brand Officer of the Applicant, dated 18 December 2020 (“**Massasso’s Declaration**”) and the Statutory Declaration of Dr Andrew John Clarke, the Chief Scientific Advisor of the Applicant, dated 21 December 2020 (“**Clarke’s Declaration**”).

²⁸ Paragraph 18 of Chan’s 1st Declaration.

²⁹ Paragraph 20 of Chan’s 1st Declaration.

³⁰ Paragraph 21 of Chan’s 1st Declaration.

³¹ Paragraph 23 of Chan’s 1st Declaration.

³² Paragraph 24 of Chan’s 1st Declaration.

(i) Massasso’s Declaration

25. A large part of Massasso’s Declaration concerns the use of the “a2”, “a2 Milk”, and “THE a2 MILK COMPANY” marks (“**Applicant’s Marks**”) by the Applicant worldwide and in Hong Kong³³, the worldwide trade mark protection of the Applicant’s Marks and the Subject Mark³⁴, the protection and use of domain names containing the Applicant’s Marks and the Subject Mark³⁵, the sales of products bearing the Applicant’s Marks worldwide and in Hong Kong³⁶, the advertisements, promotion, and media coverage of the Applicant’s products³⁷, and the popularity and fame of the Applicant’s products.³⁸ In particular, Ms Massasso states that the “a2” and “a2 Milk” marks have been used by the Applicant as brands for its products rather than descriptive terms and that the Applicant’s Marks are consistently used with the “®” or “TM” symbol.³⁹ To support the above, Ms Massasso produces the following evidence:

Exhibit	Description
Exhibit-2	An article on the launch of the Applicant’s infant formula and milk powder products in Hong Kong chain retail stores in November 2017, and printouts of search results of “a2” on the websites of two local pharmacies
Exhibit-3	Photos of the Applicant’s product packaging that contains at least one of the Applicant’s Marks
Exhibit-4	Printouts of the Applicant’s online store as at 18 June 2018 and 26 November 2020
Exhibit-5	A list of the Applicant’s pending applications for and registrations of trade marks containing the Applicant’s Marks in different jurisdictions (as at 1 August 2018)
Exhibit-6	Copies of the registration certificates and/or printouts of the online database of the Trade Marks Registry in relation to registrations of and applications for the Applicant’s Marks or the Applicant’s other “a2”-containing marks in Hong Kong
Exhibit-7	A schedule of the Applicant’s applications for and registrations of the Subject Mark in different jurisdictions
Exhibit-8	Screen captures from the Wayback Machine Web Archive showing various websites of the Applicant between 2003 and 2018
Exhibit-9	Extracts from the Applicant’s China T-Mall website as at 3 July 2020 showing the Applicant’s “a2” brand and infant formula products
Exhibit-10	Screen captures from the Wayback Machine Web Archive of the Applicant’s Hong Kong website showing the Applicant’s Marks and its products (Note: The screen captures do not bear any date, but the Applicant alleges they are as at 4 September 2018.)
Exhibit-11	Screen captures from the Wayback Machine Web Archive of the Applicant’s Hong Kong T-Mall website as at 5 November 2018 showing the Applicant’s Marks and its products
Exhibit-12	A list of chain retail stores, pharmacy outlets, grocery and convenience stores in Hong Kong where the Applicant’s products bearing at least one of the Applicant’s Marks are

³³ Paragraphs 19 to 27 of Massasso’s Declaration.
³⁴ Paragraphs 28 and 29 of Massasso’s Declaration.
³⁵ Paragraphs 30 to 36 of Massasso’s Declaration.
³⁶ Paragraphs 37 to 48 of Massasso’s Declaration.
³⁷ Paragraphs 49 to 58 of Massasso’s Declaration.
³⁸ Paragraphs 59 to 61 of Massasso’s Declaration.
³⁹ Paragraphs 19 and 21 of Massasso’s Declaration.

	sold (as at August 2020)
Exhibit-13	Photos of the Applicant’s products bearing at least one of the Applicant’s Marks in selected pharmacy outlets and supermarkets in Hong Kong (as at November 2019)
Exhibit-14	Printouts of online retail platforms in Hong Kong selling the Applicant’s products bearing at least one of the Applicant’s Marks (most of them as at 20 February 2020, some undated)
Exhibit-15	Print and online news articles from New Zealand’s media about the Applicant in which the Applicant’s Marks are referred to
Exhibit-16	The Applicant’s half-year reports and annual reports from 2010 to 2019
Exhibit-17	The Applicant’s presentations accompanying its half-year and annual reports
Exhibit-18	Copies of the Applicant’s market announcements between 2014 and 2017
Exhibit-19	Printouts of online articles and publications in which the Applicant’s products are shown
Exhibit-20	Copies of the Applicant’s presentations at the CLSA Investors’ Forum (11 and 12 September 2018), the CLSA Investor Roadshow (16 to 18 May 2018), the CLSA Asia Conference (11 September 2017), and the ASX Spotlight Asia Conference (28 May 2015), all took place in Hong Kong
Exhibit-21	Photos taken from the episodes of the 2013 “MasterChef Australia” cooking competition television series, which feature the Applicant’s products
Exhibit-22	Photos taken at the mother class activity hosted by Hong Kong Suning/Baby Kingdom and sponsored by the Applicant in Hong Kong in 2018
Exhibit-23	Printouts of Facebook posts of intermediaries selling the Applicant’s overseas products in Hong Kong between May 2017 and August 2018
Exhibit-24	Copies of letters issued by the Hong Kong Customs and Excise Department in relation to suspected counterfeits of the Applicant’s products

26. As the Applicant does not argue that the Subject Mark has acquired distinctiveness through use, I will not look at the above evidence from that perspective. Instead, I would see if they reveal anything that could show that the Subject Mark possesses inherent distinctiveness.

27. Regarding the Subject Mark, Ms Massasso argues that the Subject Mark and/or “a2” do not have any relevant dictionary meaning. **Exhibit-25** contains copies of printouts of search results of “a2 Store” and “a2” from online dictionaries such as the Oxford, Cambridge and Collins dictionaries showing that there is no entry for “a2 Store” while “A2” refers to the size of paper or a public examination taken in England and Wales. Therefore, Ms Massasso argues that consumers would unlikely perceive the Subject Mark as describing anything due to its ambiguity.⁴⁰

28. Ms Massasso also emphasises that the Subject Goods and Subject Services do not necessarily contain and/or relate to A2 beta-casein protein and that the Subject Mark is not a descriptive term such as “A2 BETA CASEIN STORE” or “A2 PROTEIN STORE”.⁴¹

29. Furthermore, Ms Massasso produces as **Exhibit-26** printouts of the online trade mark

⁴⁰ Paragraph 63 of Massasso’s Declaration.

⁴¹ Paragraphs 65 and 66 of Massasso’s Declaration.

records of the Subject Mark in different jurisdictions supporting that the Subject Mark has been registered or accepted for registration in Australia, China, New Zealand (being opposed) and Taiwan.⁴²

30. In response to de Blic-Hamon's 1st Declaration, Ms Massasso points out that the decision of the Australian Trade Marks Office referred to in exhibit **IBH-4** has not yet been rendered final as there is a pending appeal before the Federal Court of Australia.⁴³

31. In addition, Ms Massasso argues that the definition of "A2 milk" in the Macquarie Dictionary is irrelevant to the current proceedings as it is only recognised as authoritative on Australian English.⁴⁴ **Exhibit-27** contains printouts of the search results for the term "A2 milk" in the Merriam-Webster Online Dictionary, Oxford Advanced Learner's Dictionary and Cambridge Dictionary, and none of them shows any definition for the term. Moreover, the Federal Court of Australia has previously held in *Moroccanoil Israel Ltd v Aldi Foods Pty Ltd* [2017] FCA 823 that the inclusion of a term in the Macquarie Dictionary was not conclusive as to it becoming an ordinary and common term.⁴⁵ **Exhibit-28** is the relevant excerpt from that decision.

32. In reply to Ms de Blic-Hamon's contention on the aptness to describe the type of milk as "A2 milk" rather than "A1-free milk", Ms Massasso counter-argues that in the dairy industry, where the relevant benefits are derived from the absence of a component in the products, the standard and sensible terminology is "free" as it gives confidence to the consumers about the lack of the component.⁴⁶

33. Regarding Chan's 1st Declaration, Ms Massasso relies on some of the exhibits therein to support her claim that the consumers associate "a2" and "A2 Milk" with the Applicant:

- (1) Exhibit **CWE-2** shows that when a search is conducted on the term "a2 milk" on the HKTV mall website, almost all search results pertain to the Applicant's products;⁴⁷
- (2) Exhibit **CWE-4** shows that the phrase "A2 β -casein type", but not "A2 milk" or the standalone term "A2", is used on the Opponent's products and advertisements to refer to milk containing A2 beta-casein type protein;⁴⁸ and
- (3) In the article entitled *China's parents still mistrust country's brands 10 years after lethal milk powder scandal* in exhibit **CWE-5**, the term "A2 Milk" refers to the Applicant rather than a particular type of milk.⁴⁹

⁴² Paragraph 67 of Massasso's Declaration.

⁴³ Paragraph 74 of Massasso's Declaration.

⁴⁴ Paragraph 75 of Massasso's Declaration.

⁴⁵ Paragraph 76 of Massasso's Declaration.

⁴⁶ Paragraph 77 of Massasso's Declaration.

⁴⁷ Paragraph 69 of Massasso's Declaration.

⁴⁸ Paragraph 70 of Massasso's Declaration.

⁴⁹ Paragraph 71 of Massasso's Declaration.

(ii) Clarke’s Declaration

34. Dr Clarke provides a detailed account of the protein composition in milk as well as the source and the physical and chemical properties of A2 beta-casein protein.⁵⁰ He also presents the research findings about the health benefits of milk containing exclusively A2 beta-casein protein as compared to conventional milk containing both A1 and A2 types of beta-casein protein, such as the reduced gastrointestinal symptoms associated with milk intolerance among Chinese preschool children and the potential to promote the production of the antioxidant glutathione in humans, etc.⁵¹ Exhibits **AJC-1** to **AJC-8** are copies of the relevant academic journal articles.

35. According to Clarke’s Declaration, it is the absence of A1 beta-casein protein, instead of the presence of the A2 variant, that brings about the discussed health benefits.⁵² Conventional milk contains A1 beta-casein protein, which contains a certain amino acid. The fundamental difference between the Applicant’s products and those of other traders is the lack of that particular amino acid.⁵³ Therefore, the assertion that “a2” is purely descriptive of a type of milk is incorrect; instead, “A1 beta-casein free” or “A1 protein free” would be more accurate terms.⁵⁴

36. Dr Clarke also points out that the use of letters and numerals is a convention for naming protein variants and that scientists would not use the terms such as “A1” or “A1 protein” in isolation as they are ambiguous.⁵⁵ Similarly, there is no chemical solely referred to as “A2”, which is a common affix in the nomenclature of biological substances such as proteins and fats that may be found in milk or is used as a part of families of proteins that may be involved in the production of metabolism of milk or milk components. As such, “A2” does not signify any substance or compound in or of itself. Examples of compounds or protein families with names containing “A2” as a prefix or suffix include “vitamin A2”, “apolipoprotein A2”, “A2 adenosine receptor”, “peptidase family A2”, etc.⁵⁶

37. Dr Clarke argues that “a2 Milk” is not a scientific term but a brand created by the Applicant and that A1 or A2 beta-casein was not known to the general purchasing public until the Applicant’s considerable investment in marketing to educate the consumers.⁵⁷

Opponent’s Evidence in Reply

38. The Opponent’s evidence in reply consists of the Statutory Declaration of Isabelle de Blic-Hamon dated 26 October 2021 (“**de Blic-Hamon’s 2nd Declaration**”) and the Statutory

⁵⁰ Paragraphs 6 to 22 of Clarke’s Declaration.

⁵¹ Paragraphs 23 to 28 of Clarke’s Declaration.

⁵² Paragraphs 36 and 37 of Clarke’s Declaration.

⁵³ Paragraph 39 of Clarke’s Declaration.

⁵⁴ Paragraph 47 of Clarke’s Declaration.

⁵⁵ Paragraphs 40 and 41 of Clarke’s Declaration.

⁵⁶ Paragraphs 42 to 44 of Clarke’s Declaration.

⁵⁷ Paragraphs 45 and 46 of Clarke’s Declaration.

Declaration of Chan Wing Eleanor dated 29 October 2021 (“**Chan’s 2nd Declaration**”).

(i) de Blic-Hamon’s 2nd Declaration

39. In response to Ms Massasso’s statement that the Applicant’s Marks are consistently used with the “®” or “TM” symbol, Ms de Blic-Hamon points out that the Applicant refers to “a2”/“A2”, “a2 milk”/“A2 milk” and “A2 protein” in a descriptive manner without any trade mark designation.⁵⁸ She produces exhibit **IBH-1**, which contains downloaded pages from the Applicant’s website, and lists out instances of alleged descriptive use of those terms. She also refers to similar use in **Exhibit-3**, **Exhibit-8** and **Exhibit-10** of Massasso’s Declaration.

40. Ms de Blic-Hamon also contends that many claims about the alleged use and reputation of the Applicant’s Marks in Massasso’s Declaration are bare assertions and identifies various deficiencies in the evidence.⁵⁹ I do not see the need to go into the details of the alleged deficiencies here, but may refer to some of them if necessary in the latter discussions in this decision.

41. Moreover, Ms de Blic-Hamon produces as exhibit **IBH-2** copies of the decisions of the trade marks offices in the European Union, Singapore, Australia, Mexico, USA and Taiwan, all supporting the claim that “A2” refers to a type of beta-casein protein in milk or is commonly known to describe a type of milk which contains only A2 beta-casein protein.⁶⁰

(ii) Chan’s 2nd Declaration

42. Ms Chan also challenges the sufficiency of the evidence in support of Ms Massasso’s allegations about the use and reputation of the Applicant’s Marks in Hong Kong, pointing out various deficiencies in the evidence.⁶¹ In particular, in reply to Ms Massasso’s allegations that the 2013 MasterChef Australian series, which featured the Applicant’s products, was broadcasted via Now TV in Hong Kong and that “a larger number of consumers in Hong Kong are likely to have watched [it]”, Ms Chan produces exhibit **CWE-1**, a printout from the website www.digitaltvnews.net showing the subscriber base of Now TV as at 31 December 2013, and exhibit **CWE-2**, a printout from the Wikipedia page on “MasterChef Australia (series 5)”, which comments that the 2013 season “was considered the worst season” in terms of the number of viewers and the nightly ratings.⁶²

The Ordinance

43. As mentioned, the grounds of opposition are limited to section 11(1)(b) and (c) of the Ordinance and the Applicant has confirmed not to resort to section 11(2) of the Ordinance to

⁵⁸ Paragraphs 7 and 8 of de Blic-Hamon’s 2nd Declaration.

⁵⁹ Paragraph 9 of de Blic-Hamon’s 2nd Declaration.

⁶⁰ Paragraph 11 of de Blic-Hamon’s 2nd Declaration.

⁶¹ Paragraph 7 of Chan’s 2nd Declaration.

⁶² *Ibid.*

argue that the Subject Mark has acquired distinctiveness through use.

44. Section 11(1) of the Ordinance provides, among others, that:

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

...

(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;

...”

Section 11(1)(c) of the Ordinance

45. Section 11(1)(c) of the Ordinance provides that 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 are not to be registered.

46. Section 11(1)(c) of the Ordinance is broadly similar to Article 7(1)(c) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark (“**Regulation No. 40/94**”) and Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the member states relating to trade marks (“**Directive**”).

47. In *Host Hotels & Resorts LP v Registrar of Trade Marks* [2010] 1 HKLRD 541, Sakhrani J referred to *Bignell v Just Employment Law Ltd* [2008] FSR 6 where, in relation to the equivalent of section 11(1)(c) of the Ordinance, it was held that:

“35. The modern approach of the ECJ is summarised in the following passages from the ECJ judgment in *OHIM v Wm Wrigley Jr Co*, the *DOUBLEMINT* case (Case C-191/01 P) [2003] ECR I-12447; [2004] 1 WLR 1728:

‘29. Article 7(1)(c) of Regulation No. 40/94 provides that trade marks which “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service” are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No. 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No. 40/94.⁶³

⁶³ Article 7(3) of Regulation No. 40/94 is similar to section 11(2) of the Ordinance.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No. 40/94 pursues an aim which is in the **public interest**, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks: see, *inter alia*, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104 of 21 December 1988 to approximate the laws of the member states relating to trade marks, *Windsurfing Chiemsee* [2000] Ch 523, 551 para. 25, and *Linde AG v Deutsches Patent- und Markenamt* (Joined Cases C-53–55/01) [2003] ECR I-3161, 3202 para. 73.

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No. 40/94, it is **not necessary** that the signs and indications composing the mark that are referred to in that Article **actually be in use at the time of the application for registration** in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications **could be used** for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.” (emphasis added)

48. The Opponent has also referred to paragraphs 56 to 57 and 101 to 102 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*, the *POSTKANTOOR* case [2004] ETMR 57:

“56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that **that might be the case in the future** (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist ‘**exclusively**’ of signs or indications which may serve to designate characteristics of the goods or services concerned, it does **not require** that those signs or indications should be the **only way** of designating such characteristics.

...

101. Furthermore, for the reason given in para.[57] of this judgment, it is **irrelevant** for the purposes of determining whether the ground for refusal set out in Art.3(1)(c) of the Directive applies to such a mark **whether or not there are synonyms** permitting the same characteristics of the goods or services to be designated.

102. It is also **irrelevant** whether the characteristics of the goods or services which may be the subject of the description are **commercially essential or merely ancillary**. The wording of Art.3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, **irrespective of how significant the characteristic may be commercially.**" (emphasis added)

49. However, I would like to comment on another authority that the Opponent has cited in its skeleton submissions⁶⁴ but not referred to during the hearing, which is *JW Spear & Sons Ltd & Ors v Zynga Inc* [2015] FSR 19, in which the Court of Appeal (England and Wales) adopted and approved the opinion of Advocate General Jacobs in the *DOUBLEMINT* case. The relevant part in the judgment of *JW Spear & Sons* is paragraph 83:

"83. I have found helpful and agree with the analysis of the Advocate General in his opinion in *DOUBLEMINT* [2003] E.C.R. I-12447 at [61]-[64]. He draws attention to the fact that that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it and suggests **three considerations** which may determine on which side of the line the indication lies. Although the entire passage repays reading, I will summarise his three points as: **(i)** how factual and objective is the relationship between an indication and the product or one of its characteristics? **(ii)** how readily is the message of the indication conveyed? and **(iii) how significant or central to the product is the characteristic?** Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods." (emphasis added)

50. The three factors suggested by the Advocate General were not adopted by the ECJ in its decision in the *DOUBLEMINT* case. In fact, the ECJ in the *POSTKANTOOR* case stated in paragraph 102 of the judgment (a paragraph which the Opponent has also referred to in its skeleton submissions⁶⁵) that for the purpose of determining whether the ground of refusal set out in Art. 3(1)(c) of the Directive applies to a mark, it is irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary, contrasting with factor (iii) of the Advocate General's opinion above. The long-standing approach of this Registry on this matter is that the Registrar does not find himself bound by the three factors suggested by the Advocate General, and this approach has been endorsed by the local Court of Appeal in *RE CREATIVE RESOURCES LLC* [2010] 1 HKC 202, at paragraphs 31 and 32 of the judgment:

"[31] **Quite apart from applying the threefold test suggested by the Advocate General Jacobs** in the *DOUBLEMINT* case - despite the fact that **the hearing officer had**, as noted above, **given valid reasons for casting doubt on the rigid application of, in particular, the third criteria** - the judge below dismissed the hearing officer's view of the matter merely by saying in para 25 of the judgment that he 'was not persuaded by her assessment.' As I have

⁶⁴ Paragraph 11 of the Opponent's skeleton submissions.

⁶⁵ Paragraph 7(c) of the Opponent's skeleton submissions.

earlier stated, that is not the appropriate test on an appeal involving the exercise by the hearing officer of her discretion. In this respect it is to be noted that the judge did not go so far as to say that the hearing officer was clearly wrong. Indeed, he said in para 30:

‘Accordingly, some possibly desirable attributes of a condom can be suggestive of nakedness, while the state of nakedness itself may suggest attributes which would be desirable in a condom. But such evocations would only be at a remove from objective fact and would require some recourse to subjective imagination.’

[32] Whilst **I do not consider that the judge was justified in departing from the decision of the hearing officer on the basis of her approach**, I would also say that in my view the hearing officer was entirely correct in the conclusion to which she came.” (emphasis added)

51. As this Registry is bound by the decisions of the local Court of Appeal whereas those of the Court of Appeal (England and Wales) are of referential value only, I will not consider myself bound by the threefold test suggested by the Advocate General.

52. From the relevant authorities mentioned above, it can be seen that the ground of refusal set out in section 11(1)(c) of the Ordinance pursues an aim in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. For the purposes of determining whether a mark should be refused registration under this ground, it is irrelevant whether there are other ways to designate the same characteristics of the goods or services, whether the characteristics which may be the subject of the description are commercially essential or merely ancillary to the goods or services, or whether the mark was actually used to designate those characteristics at the time of the application for registration. So long as the mark consists exclusively of signs or indications which might serve to designate characteristics of the goods or services in future, the mark should be refused registration.

53. Before I proceed to evaluate whether the Subject Mark may be used to designate characteristics of the Subject Goods and Subject Services, I would like to address the parties’ submissions on the issues of (i) the relevant date, (ii) the relevant public, and (iii) the meaning of “A2”.

(i) Relevant date

54. In Massasso’s Declaration, the relevant date for the present opposition proceedings is stated to be the date of filing of the Subject Application, namely 27 September 2017. In its skeleton submissions, the Opponent refers to “*LEAN WHEY*” Trade Mark, decision of the UKIPO, O-367-13, 11 September 2013, which held, at paragraph 35, that for considering whether the application for a term falls foul of the equivalent of section 11(1)(c) of the Ordinance, exhibits showing actual use of the term that are undated (aside from the date they were printed) or dated after the relevant date can be taken into account if they enable the

drawing of conclusions as to the position on the relevant date.⁶⁶ However, 5 days after the filing of the its skeleton submissions, the Opponent filed a correction note to revise the relevant date to the priority date of the Subject Application, namely 26 September 2017, in relation to the submissions on section 11(1)(b) and (c) of the Ordinance, while keeping the relevant date as the filing date of the Subject Application in relation to submissions on section 11(2) of the Ordinance.⁶⁷

55. When asked for the reasons for changing the relevant date during the hearing, Mr Tse referred to section 41(2)(b) of the Ordinance. The relevant provisions of section 41 read:

- “(1) A person who has duly filed an application for the registration of a trade mark in, or in respect of, a Paris Convention country or WTO member, or his successor in title, shall enjoy, for the purpose of registering the same trade mark under this Ordinance in respect of any or all of the same goods or services, a right of priority for a period of 6 months after the date of filing of the first of any such applications, subject to compliance with any prescribed conditions.
- (2) If the application for registration under this Ordinance is made within the 6-month period referred to in subsection (1)—
 - (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application or WTO application, as the case may be; and
 - (b) the registrability of the trade mark shall not be affected by any use of the trade mark in Hong Kong in the period between that date and the date of the application for registration under this Ordinance.”

56. Mr Tse submits that section 41(2)(b) of the Ordinance stipulates that the registrability of a trade mark shall not be affected by any use of it in Hong Kong between the priority date and the application date. However, he fails to provide any precedent supporting his argument that the relevant date should be the priority date in cases where the registrability of a mark is challenged on absolute grounds under section 11(1)(b) and (c) of the Ordinance as compared to relative grounds.

57. Mr Ling, on behalf of the Applicant, agrees to the change of the relevant date to the priority date. However, he submits that even the Registrar may look at how the mark might be used in future, it does not mean that he can predict how the word may evolve, and argues that any possible future use should be based on the knowledge of the relevant public as at the relevant date.

58. Despite the concurrence of both parties on the relevant date for the present case, I have reservations about the necessity and appropriateness of the Opponent’s request:

⁶⁶ Paragraph 19 of the Opponent’s skeleton submissions.

⁶⁷ At the time of the Opponent’s filing of its skeleton submissions and correction note, the Applicant had not yet filed its skeleton submissions renouncing its reliance on section 11(2) of the Ordinance.

- (1) The purpose for which the priority date should be set as the relevant date is provided in section 41(2)(a), rather than in section 41(2)(b). Section 41(2)(a) unequivocally states that the priority date should be set as the relevant date “for the purpose of establishing which rights take precedence”. I have grave doubts whether the present case, an opposition on absolute grounds under section 11(1)(b) and (c) of the Ordinance rather than on relative grounds, involves the determination of precedence of rights.
- (2) Section 41(2)(b) talks of an otherwise scenario — about the impact or effect of “use” of the trade mark in Hong Kong in the period between the priority date and the date of the application for registration under the Ordinance. However, as held in the *DOUBLEMINT* case (see the extract from the case in paragraph 47 above), the objection under section 11(1)(c) does not require consideration of whether the mark in question was actually used to designate the characteristics of the goods or services concerned at the time of the application for registration. While evidence of actual descriptive use of the mark before and on (and, sometimes, even after) the date of application are clear indication that the mark is capable of such use, the lack of it does not mean that the mark is not so capable. Similarly, for the objection under section 11(1)(b), it is an established principle that the distinctiveness of the mark in question should be assessed absent use⁶⁸ (see the extract of the relevant authority in paragraph 106 below). Therefore, it is highly doubtful whether section 41(2)(b) has any effect on an opposition where the registrability of a mark is challenged on grounds of section 11(1)(b) and (c). In addition, it is the Opponent who, relying on “*LEAN WHEY*” Trade Mark, contends that evidence of descriptive use of a mark after the relevant date should be taken into account if it shows the positions of how the mark was used on the relevant date, it seems counterintuitive for the Opponent to argue that the relevant date should be the priority date on grounds of section 41(2)(b) as such an argument entails that the use after the relevant date (i.e. priority date) but before the application date should be discounted.
- (3) Section 41(2)(b) should be read in conjunction with section 11(2) of the Ordinance as both concern the “use” of a trade mark. Section 11(2) states that the date relevant to the question of whether a trade mark has in fact acquired a distinctive character as a result of the use made of it is the date of application for registration. If the Opponent really wishes to rely on section 41(2)(b) to argue that the relevant date be shifted to the priority date, it should at least explain how the provision that the use between the priority date and the application date be disregarded is to be interpreted and understood. Yet, the Opponent has not offered any explanation in this respect, nor any explanation why there should be different treatments (as the Opponent supposed) in respect of relevant dates for section 11(1)(b) and (c) on one hand and for section 11(2) on the other.

⁶⁸ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, 306.

- (4) In any event, as the priority date and the application date are only one day apart, I could hardly imagine there is any difference in the perception of the Subject Mark by the relevant public.

59. In view of the above, I think the arguments about the relevant date in the present case to be merely of academic interest rather than having any practical implications; as such, it is better to leave it open for further arguments and exposition when its determination is more justifiably required. Therefore, for the present purposes of the case, I will simply take the application date of the Subject Application as the relevant date for consideration.

(ii) Relevant public

60. On the issue of composition of the relevant public, the ECJ held in *Matratzen Concord AG v Hukla Germany SA* [2006] E.T.M.R. 48 the following:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the **perception** of the relevant parties, that is to say **in trade** and or amongst **average consumers** of the said goods or services, **reasonably well-informed and reasonably observant and circumspect**, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).” (emphasis added)

61. The Opponent argues that people in trade consist of the manufacturers, wholesalers and retailers, relying on the following paragraphs in “*Bach and Bach Flower Remedies*” Trade Marks [2000] R.P.C. 513:

“34. I accept the submission that the meaning of a word may depend on its **usage**...

35. The **usage** in question must be by those engaged **in the relevant trade** or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik*. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such a [*sic*] **manufacturers, wholesalers and retailers.**” (emphasis added)

62. In addition, the Opponent argues that since the Subject Goods in Class 5 and 29 (except “butter; cheese; cream; yoghurt”) are, or may be, purchased for infants, specific dietary/nutritional requirements or medicinal purposes, the relevant public also comprise of professionals such as medical professionals, dieticians, pharmacists and academia.⁶⁹ The relevant authorities supporting this argument are (i) “*LEAN WHEY*” Trade Mark, in which the UKIPO accepted, in paragraph 18 of the decision, that for certain goods in Class 5 such as “drugs” and “chemical preparations for pharmaceutical purposes”, the average consumers also

⁶⁹ Paragraphs 18 and 21.4 to 21.6 of the Opponent’s skeleton submissions.

consist of health professionals such as pharmacists; and (ii) *Mundipharma AG v EUIPO*, Case T-256/04, 2007 II-00449, in which the Court of First Instance (EC) held, in paragraph 44 of the judgment, that for the goods “therapeutic preparations for respiratory illnesses”, the relevant public is made up of both patients and healthcare professionals.

63. The Applicant submits that the notion of relevant public proposed by the Opponent is too wide. Mr Ling draws my attention to paragraph 23 of the judgment of the Court of First Instance (EC) in *Glaverbel SA v OHIM* [2008] ETMR 37 on the assessment of distinctive character of a mark:⁷⁰

“23. ... In general, the **perception of consumers or end users** plays a **decisive role** since the whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it (*Björnekulla Fruktindustrier* at [24]).” (**emphasis added**)

64. Mr Ling argues that whether the average consumers include professionals depends on the goods and services concerned. He contends that, apart from the certain goods for medical purposes in Class 5, all Subject Goods in Classes 5 and 29 are ordinary food items available in normal retail outlets and no professional advice is needed to get them, and hence the health professionals should not be part of the relevant public.

65. On the other hand, Mr Tse replies that the Subject Goods in Classes 5 and 29 are all milk-based products. Given that the majority of the population in Hong Kong are of Chinese ethnicity, who tend to be lactose intolerant, he argues that the public in Hong Kong may seek medical or nutritional advice from professionals for those Subject Goods.⁷¹

66. I agree with the Applicant’s submissions that the relevant consumers depend on the goods and services concerned. This is also consistent with the rulings in “*LEAN WHEY*” Trade Mark and *Mundipharma AG*, in which the medical professionals are considered as part of the average consumers for specialized goods such as “drugs”, “chemical preparations for pharmaceutical purposes” and “therapeutic preparations for respiratory illnesses”. In the present case, as all Subject Goods in Classes 5, 9, 29 and 30 and Subject Services in Class 35 are available to the general public through ordinary trade channels without resort to professional advice, the average consumers should be the consuming public in general. For goods “dietetic foods adapted for medical purposes; dietetic beverages adapted for medical purposes” in Class 5, the average consumers also consist of medical professionals. For services “advertising; promotional services; customer loyalty program organisation and management” in Class 35, business professionals are also part of the average consumers.

67. I would also like to highlight the fact while “*Bach and Bach Flower Remedies*” Trade Mark reminds us that the meaning of a mark may be shaped through usage by those engaged in the trade such as manufacturers, wholesalers and retailers, both *Matratzen Concord AG* and

⁷⁰ Paragraphs 12 and 13 of the Applicant’s skeleton submissions.

⁷¹ Paragraph 18 of the Opponent’s skeleton submissions.

Glaverbel SA emphasise the importance of the perceived meaning of the mark in the minds of those in the trade and, even more importantly, of the average consumers in assessing the distinctiveness and/or descriptiveness of a mark.

(iii) Meaning of “A2”

68. For the ground of opposition under section 11(1)(c) of the Ordinance, I have to consider whether people in the trade and the average consumers of the goods and/or services concerned perceive the Subject Mark as describing the characteristics of the goods or services. While evidence of the actual use of the mark as at the application date of the Subject Application may shed lights on how the mark is perceived in the trade, I am mindful of the legal principle that the lack of descriptive use of the mark does not mean that the mark cannot be refused under section 11(1)(c), as marks consisting exclusively of signs or indications which could serve to designate the characteristics of the goods/services also fall foul of the section.

69. In the present case, both parties have submitted evidence of use. Yet, except a few pages of printouts from the Applicant website <https://a2store.com.au> in **Exhibit-4**, no evidence concerns the use of the Subject Mark “a2 Store” as a whole. Instead, most evidence shows the use of the term “A2” or “a2” in a range of other contexts.

70. It is the submission of the Opponent that the term “A2” or “a2” is descriptive of the Subject Goods and Subject Services or otherwise nondistinctive, namely, “A2 milk” is a kind of milk and “A2 protein” is a kind of protein, and “A2”, when used in relation to milk and protein products, refers to those specific kinds of milk or protein. On the other hand, Applicant, as submitted by Mr Ling, argues that “a2” has no relevant accepted meaning.⁷²

I. Opponent’s Evidence

71. I will start by reviewing to what extent the parties’ submissions above are supported by the Opponent’s evidence. For the purpose of considering whether “A2” or “a2” is descriptive of the Subject Goods and Subject Services, I will focus on the evidence of use that was mainly for the average public. In other words, articles from academic journals (e.g. **IBH-2**), decisions from foreign trade marks offices (e.g. **IBH-4**, **IBH-13**), and articles or materials that are targeted to investors (e.g. **IBH-6**, **IBH-7**) are not the focus in this exercise.

72. Among such evidence, I have found multiple references of “A2 milk” and “A2 protein” which unmistakably refer to a type of milk or a type of protein, and instances of “A2” referring to that type of milk or protein instead of the Applicant. Some examples are extracted below (**emphasis** added):

⁷² Paragraph 6 of the Applicant’s skeleton submissions.

Exhibit	Source	Date	Relevant extracts
IBH-3	<i>Choosing the right milk for your family</i>	14 May 2012	<p>A2milk</p> <p>The A2 refers to the type of protein found in cows' milk. Friesian cows produce milk that has more A1 protein and Guernsey cows produce milk high in A2. Regular cows' milk produced in Australia and New Zealand has a mixture of A1 and A2 proteins. While A2 milk is being promoted widely as having health benefits, there's little scientific evidence to suggest that A2 protein is any better for us than A1. Food Standards Australia and New Zealand recommend milk (both A1 and A2) as a healthy and safe part of children's diets.</p>
	<i>Dear Mark: Full-Fat Dairy Roundup</i>	9 Dec 2013	A1 and A2 refer to two types of beta-casein (a protein) found in milk. A1 milk has mostly A1 beta-casein and A2 milk has mostly A2 beta-casein...
	<i>Got to Drink Milk? Learn Your A1's and A2's</i>	17 Feb 2014	<p>Casein is the most abundant overall, and the genetic variations of A1 and A2 refer to a specific type of casein known as beta-casein...</p> <p>The European Food Safety Authority in 2009 conducted their own review of the literature and suggested that there is no benefit of A2 milk over its more common A1 counterpart. Even more, it concluded that a cause and effect relationship is not established between the dietary intake of A2 milk and disease.</p>
	<i>WHICH MILK TO CHOOSE: IS A2 SUPERIOR?</i>	29 Jan 2016	<p>A1 and A2 refer to the beta casein protein type...</p> <p>My firsthand experience with A1 versus A2 milk has convinced me that there is a difference.</p> <p>Although for decades Americans have understood that lactose intolerance can complicate their digestion or tolerance of pasteurized milk, research about A1 and A2 milks starting in the early 1990's has added new insight to this common food allergy, even among those who adhere to <i>raw</i> milk products...</p> <p>While it would be convenient to attach A2 milk to certain breeds of cattle, the truth is even the Jersey cow, commonly linked with A2 milk, is often A1. Only a genetic test can tell the cow's breeding; ... Despite the fact that Guernsey cows produce A2 and many Dutch Belted, 75% of cows in the world are A1...</p>
	<i>ASK ALEX: WHAT IS THE DIFFERENCE</i>	16 Oct 2017	Both a1 and a2 fall under the beta-casein category (one of the three major groups of caseins)... a1 features histidine whereas a2 features proline. This simple difference can lead to key differences in the digestion of a1 vs. a2 milk ...

	<i>BETWEEN A1 AND A2 MILK</i>		<p>a2 milk is distinguished from a1 milk because it does not contain any a1 beta-casein protein.</p> <p>The a2 protein was the original a1 form of beta-casein produced by cows thousands of years ago...</p> <p>Conversely, a2 dairy cows undergo testing and if found to have the specific genes for the natural production of only the a2 protein and not the a1, they then enter an exclusive a2 dairy herd. It should be noted, that genetic modification is not a part of this process, rather the process relies on genetic testing and breeding of a2 producing dairy cattle.</p>
	<i>Digesting dairy: What's the difference between A2 and ordinary milk?</i>	22 Nov 2017	<p>As lactose-free, soy and nut milks become more common household staples, there is another variety of milk that is becoming increasingly popular - A2 milk. It is marketed as an easier-to-digest version of conventional cow milk, differing by only one amino acid in one protein chain.</p> <p>A2 refers to the beta-casein proteins found in milk...</p> <p>Natasha Murray is an accredited practising dietitian for Dietitians Association of Australia and said there was some - but not much - evidence showing the A2 protein was easier for people to digest....</p> <p>Every cow must be tested before being approved to be used for A2 milk production....</p>
CWE-9	<i>Is Lactose Intolerance or Protein to Blame for Dairy Reactions?</i>	2019	<p>New theories have emerged in recent years suggesting that these symptoms are actually an adverse reaction caused by the proteins in milk, which led to the development of A2 milk.</p> <p>Traditional milk contains both A1 and A2 proteins, while A2 milk only contains A2 protein. Some studies have shown that people who are lactose intolerant report experiencing less symptoms after drinking A2 milk (when compared to drinking A1 milk), though clinical evidence is still limited. Regardless of whether you are allergic to milk or not, if you experience discomfort after drinking milk, you may want to consider switching to A2 milk or lactose-free milk to see if one of these alternatives eases your symptoms.</p>

73. The above list is by no means exhaustive. Yet, it clearly and consistently shows that “A2 milk” or “A2” were used to refer to a type of milk alternative to ordinary milk or “A1 milk”, and “A2 protein” or “A2” were used to refer to A2 beta-casein protein.

74. In addition, there are also examples of the term “A2” used with words other than “milk” and “protein”, such as “A2 cows”, “A2 ice cream”, “A2乳牛” and “A2奶源”. This shows that “A2” does not just collocate with “milk” or “protein” and lends support to the argument that “A2”, by itself and appearing independently of the term “A2 milk” or “A2 protein”, is capable of featuring a particular type of milk or protein in or associated with a range of milk and protein products under different contexts. These examples include (**emphasis added**):

Exhibit	Source	Date	Relevant extracts
IBH-3	<i>Got to Drink Milk? Learn Your A1's and A2's</i>	17 Feb 2014	While not well-known, even in most nutrition and natural health circles, the fact is there are genetically different cows out there – A1 cows and A2 cows . All cows used to be A2 cows until a naturally-occurring genetic mutation in European cows changed the genetics of milk-producing cow herds. To find A2 milk, look for a dairy farm that uses only A2 cows . Asian and African cows are known to be mostly A2 , whereas European and American cows are mostly A1. Two breed [<i>sic</i>] of A2 cows in America are the Jersey and Guernsey cows.
	<i>WHICH MILK TO CHOOSE: IS A2 SUPERIOR?</i>	29 Jan 2016	I have raw A2 milk in my fridge right now and just had raw A2 ice cream with my lunch!
	<i>What are A1 and A2 cows? And what type of cows live on your farms?</i>	Undated (printed on 24 Oct 2019)	What are A1 and A2 cows ?... A1 and A2 refers to the type of beta-casein – one type of protein found in cows’ milk (the other is whey). Most cows produce a combination of these two proteins... We have not invested in any testing to determine if our cows are primarily A1 or A2 cows , or carry any percentage of A2 genes ...
CWE-3	Photos	Undated (taken before the execution of Chan’s 1 st Declaration on 7 Jan 2020)	A2乳牛 經DNA檢測... 全新 A2珍稀奶源 將最珍貴送給寶寶...

75. On the other hand, contrary to the Opponent’s contentions, some of its own evidence does not show descriptive use of the term “a2”. For example, Ms de Blic-Hamon alleges that in exhibit **IBH-1**, the Applicant has used the term “A2” in a descriptive manner as there is no

“®” or “TM” symbol next to it.⁷³ However, in most cases, “A2” is part of either the term “a2 Milk” or the Applicant’s name, with the former marked with the “®” symbol while the name marked with the “TM” symbol. The only instance where the term “a2 Milk” is not used together with the “®” or “TM” symbol is in the quotation of a customer’s remarks about the Applicant’s products, which is clearly referring to none other than the Applicant in the context.

76. Similarly, the use of the term “a2” or “a2 milk” without the “®” or “TM” symbol by third parties does not necessarily constitute descriptive use. Examples can be found in the article entitled *澳洲 a2 奶粉香港上架 專攻腸道敏感人士* under exhibit **CWE-5**, where “a2” or “a2 Milk” always refers to the Applicant. All references of “a2” and “a2 Milk” in the article are extracted below in the order of appearance (numbered with keywords highlighted for easy reference):

- (1) “澳洲市場第二大嬰幼兒配方奶粉品牌 **a2 Milk** 日前正式在香港發售...”
- (2) “與之相比，**a2 Milk 牛奶**則沒有 A1 蛋白質，而只有 A2 蛋白質...”
- (3) “**a2 Milk** 近期於中國三個城市進行研究...”
- (4) “研究參與者飲用 **a2 Milk 牛奶**後，其腸道不適的反應相對一般牛奶較少...”
- (5) “**a2 嬰幼兒配方奶粉**於澳洲市場的市佔率由去年同期的 16% 高速增長至今年的 26%，成為澳洲市場第二大嬰幼兒配方奶粉品牌。”

77. From extract (1), it can be seen that “a2 Milk” refers to the second largest brand for infant formula milk powders in the Australian market (“澳洲市場第二大嬰幼兒配方奶粉品牌”) from the outset of the article. In (2) and (4), the term “a2 Milk 牛奶” is also an indication that “a2 Milk” is a brand rather than a type of milk as otherwise there is no need to add the word “milk” (“牛奶”) after it. In (3), the fact that “a2 Milk” “conducted researches” (“進行研究”) clearly rules out any descriptive interpretation. In (5), the fact that “a2 infant formula milk powder” has become the second largest brand of infant formula milk powder in the Australian market (“a2 嬰幼兒配方奶粉... 成為澳洲市場第二大嬰幼兒配方奶粉品牌”) again reinforces the notion that “a2” in this article refers to a brand.

78. The other article under **CWE-5**, entitled *China’s parents still mistrust country’s brands 10 years after lethal milk powder scandal*, also shows similar deficiencies in proving “A2 Milk” as a descriptive term. Some of them have been identified in Massasso’s Declaration,⁷⁴ and I will not repeat them.

II. Applicant’s Evidence

79. As regards evidence provided by the Applicant, it was supposed to show the use of the Applicant’s Marks as an indication of trade origin. Yet, sometimes its own websites show descriptive use of “A2” (**emphasis added**):

⁷³ Paragraph 7(i)(A) of de Blic-Hamon’s 2nd Declaration.

⁷⁴ Paragraph 71 of Massasso’s Declaration.

Exhibit	Source	Date	Relevant extracts
Exhibit-8	a2milk.nz (p.278)	3 Sep 2018	a2 Milk™ brought to you by Anchor is fresh New Zealand cows' milk which contains only the A2 protein and no A1 protein...
	a2milk.co.uk (p.331)	26 Sep 2014	We worked with each farmer to test herds to identify how many A2 cows and non A2 cows (A1 Cows) they had...
	a2milk.co.uk (p.333)	8 Dec 2014	a2 Milk is fresh cows milk that naturally contains a protein called a2 ...
Exhibit-10	a2nutrition.hk (p.384)	4 Sep 2018	It is the only formula made with milk from cows specially selected to naturally produce the A2 protein and none of the A1 protein commonly found in ordinary cows' milk...

80. At this juncture, I would like to address the Opponent's allegations of the Applicant's descriptive use of "a2"/"A2" and "a2 milk"/"A2 milk" in **Exhibit-8** of Massasso's Declaration.⁷⁵ I find many of them unconvincing. For example, sometimes when the term "A2 protein" is used, there is a note underneath clarifying that "A2 protein" refers to A2 beta-casein protein, i.e. the proper scientific name of the protein (e.g. **Exhibit-8**, pp.313, 316 and 368). The Opponent even refers to pages where the term "A2 protein" is nowhere to be found (e.g. **Exhibit-8**, p.322). Moreover, sometimes when the term "A2 Milk" appears on the Applicant's websites or product packaging without the "®" or "TM" symbol (e.g. **Exhibit-8**, pp.279 to 281 and 330), it is ambiguous whether it is a descriptive use of the term or instead refers to the Applicant or its products as "a2" is part of the Applicant's name.

81. Apart from the Applicant's own websites, I note instances of descriptive use of "A2" referring to a type of milk or protein in third parties' articles (**emphasis added**):

Exhibit	Source	Date	Relevant extracts
Exhibit-15	<i>Dairy Board tight-lipped on venture</i>	29 Aug 2000	Breeding cows free of the A1 protein, leaving only non-implicated A2 protein , could eliminate the potential risk factor...
	<i>Milk research firm plans dual listing</i>	10 Nov 2000	The milk protein A2 does not have the peptide, hence the name given to the company...
	<i>heads-UP/ The week ahead</i>	24 Aug 2003	Most New Zealand milk, including Fonterra's, has A1 and A2 proteins ...
	<i>MILK BATTLE</i>	21 Sep 2007	The Dominion Post and Independent have led the charge on the campaign against ordinary milk, highlighting the diabetes-related health concerns of a couple of scientists and advocating a move to the A2 variety championed by the NZAX-listed minnow...
	<i>A2 Corp in bid to merge with Australian partner</i>	13 Apr 2010	There are two types of milk, A1 and A2 , which are usually mixed together...

⁷⁵ Paragraphs 7(ii) to (vi) and 8 of de Blic-Hamon's 2nd Declaration.

<i>Overseas markets key for a2 processor</i>	19 Jul 2014	The company's intellectual property enables the identification of cattle and the production of milk that does not contain the a1 protein (leaving only the a2 protein)...
<i>The OF A2 MILK RISE RISE and [sic]</i>	4 Mar 2016	<p>While the wider dairy industry struggles, A2 is profiting from its point of difference: the fact that its milk comes from cows selected to produce only a particular type of protein, known as A2 beta-casein, unlike most dairy products, which contain both A1 and A2 proteins...</p> <p>The company claims the A2 variant offers health benefits over the more common A1 variety...</p> <p>In the long run, Patney believes A2 has an advantage over its competitors when it comes to supply of raw ingredients, as the A2 type milk provides superior returns, encouraging New Zealand farmers to produce more of it...</p>
<i>Trust drives A2's China growth</i>	27 Apr 2016	<p>Most dairy products contain both A1 and A2 proteins.</p> <p>The company claims the A2 variant offers health benefits over the more common A1 variety...</p>
<i>Share plunge: A2 Milk says it has complied with rules</i>	21 May 2016	<p>"Conversely, it [could] also be seen as an endorsement of the potential benefits that the A2-type milk could bring to some dairy consumer beyond the lone voice of ATM [A2 Milk] in the market to date."...</p> <p>First NZ notes Ohio, US-based Snowville Creamery, Origin Milk, and Hidden Acre Farms all separately make claims around the benefits of A2 proteins, referencing A2 on its packaging, while Netherlands-based Veco Zuivel has been reported as planning to make A2-type products available later this year...</p> <p>"We note all of these four companies have made statements relating to the potential benefits of A2 type milk on their websites or in media releases, but did not make any reference to 'The a2 Milk Company' or the 'a2' brand," First NZ said. "None of these four contacted ATM prior [to] launching their products in the market."...</p> <p>First NZ kept its target price unchanged at \$1.67, with its view based on whether the company can successfully execute its plan to sell A2-variety milk products in Australia, the UK and the US, and crack the Chinese and Australian infant formula markets...</p>

82. Attention is drawn to the last article in the table *Share plunge: A2 Milk says it has complied with rules* dated 21 May 2016. The second and third extracted paragraphs report

that other companies in the milk industry, such as Snowville Creamery, Origin Milk, and Hidden Acre Farms, have made statements about the benefits of “A2 proteins” and “A2-type milk” and refer to “A2” on their product packaging while the dairy company Veco Zuivel was planning to make “A2-type products”. While it is impossible to verify the accuracy of the report, this is still very strong evidence that “A2” is used in the industry to refer to a type of protein or a type of milk.

III. Discussions

83. While some of the Opponent’s claims of descriptive use of the term “A2” are untenable (see paragraphs 75 to 78 and 80), it is undisputable that there are plenty of examples of such use from the evidence of both parties (see tables in paragraphs 72, 74, 79 and 81).

84. I am mindful of the fact that many of those examples are not from Hong Kong (exceptions being *Is Lactose Intolerance or Protein to Blame for Dairy Reactions?* (“**Article**”) in **CWE-9**, the photos in **CWE-3** and the website a2nutrition.hk in **Exhibit-10**). Moreover, those examples from Hong Kong are all dated after the relevant date, i.e. the application date of the Subject Application.

85. Mr Tse submits that overseas materials are accessed by the Hong Kong medical practitioners and nutritionists, who are part of the relevant public, and that the Article from the Hong Kong Adventist Hospital after the relevant date is evidence of the awareness of the relevant professionals about the descriptive use of “A2”, and should be taken into account according to the principle in the *“LEAN WHEY” Trade Mark* case. On the other hand, Mr Ling argues that we should not refer to foreign materials as they are not targeted to local consumers⁷⁶, that a single local article is insufficient to represent any prevailing understanding of the term “A2” among professionals in Hong Kong⁷⁷, and that much of the evidence is dated after the relevant date.⁷⁸

86. As mentioned above in paragraph 66, while medical professionals are part of the relevant public for some of the Subject Goods in Class 5, the majority of the relevant public is the general consumers at large. As held by the ECJ in *Matratzen Concord AG*, the average consumers are reasonably well-informed and reasonably observant and circumspect. Moreover, the general consumers in Hong Kong likely have access to the internet. When encountering terms that appear to be abbreviations, such as a term like “A2” which is comprised of only a letter and a numeral, they may refer to foreign sources online in order to understand their meanings. Given the abundance of materials in which the term “A2” had been put to descriptive use to refer to “A2 milk” or “A2 protein” in relation to milk and protein products and the fact that these materials were readily available online to anyone interested, I consider that as at the relevant date, the average consumers in Hong Kong may have been aware of the

⁷⁶ Paragraphs 24 and 26 of the Applicant’s skeleton submissions.

⁷⁷ Paragraph 22 of the Applicant’s skeleton submissions.

⁷⁸ Paragraphs 16 and 20 of the Applicant’s skeleton submissions.

meanings of “A2 milk” and “A2 protein”, as well as the meaning of “A2” when used on dairy-based and protein-based goods and the relevant services alike.

87. Mr Ling also argues that “A2” is a technical jargon unknown to the relevant public in Hong Kong as at the relevant date,⁷⁹ and refers to *Matratzen Concord AG* in which the ECJ held that the word mark “MATRATZEN” is registrable in Spain for goods such as mattresses even though the word “MATRATZEN” means “mattress” in German. Mr Ling explains that the term “A2” is like a word in a foreign language unknown in Hong Kong, analogous to the term “MATRATZEN” in Spain. He also argues that the general consumers would not know the cryptic nature of “a2” as the nutritional value of the relevant products lies in the absence of “A1 protein” instead of the presence of “A2 protein”.⁸⁰ Yet, I do not find this analogy convincing. As illustrated in the tables in paragraphs 72, 74, 79 and 81, the term “A2”, despite its scientific origin, has been commonly used in the media and in the trade in other English-speaking countries to refer to a type of milk or a type of protein, regardless of whether the term is used by itself or together with the word “milk” or “protein”. In fact, section 11(1)(c) of the Ordinance does not require the relevant public to fully understand the scientific facts behind the term; it only calls for an assessment of whether it may be used in the trade to designate a characteristic of the goods/services concerned. Based on my above discussions, there were ample instances in the evidence where research or general knowledge would easily identify a history of descriptive use of “A2” to denote a particular type of milk or protein in the trade of dairy-based or protein-based goods and the relevant services.

88. Finally, I would like to address the Applicant’s arguments that it is incorrect to assert that “A2” is descriptive of a type of milk called “A2 milk” as the relevant health benefits are derived from the exclusion of the A1 beta-casein protein and not the presence of the A2 variant.⁸¹

89. At the hearing, Mr Tse referred to the opinion of Advocate General Jacobs in the *DOUBLEMINT* case, at paragraph A65:

“I would stress, however, that the **question of precision, accuracy or factual correctness is not normally relevant** to the examination from any of those points of view. As I have stated above, practically any designation of a product characteristic can be rendered more precise, and it is obvious that descriptions used in trade may be untruthful while still serving to designate product characteristics; indeed, it is for that very reason that misleading descriptions are generally prohibited.” (emphasis added)

90. I note that the relevant opinion was not adopted by the ECJ in its decision in the *DOUBLEMINT* case. That said, the established legal principles referred to in paragraphs 47 and 48 above do not require assessment of whether the designation of the product characteristics is factually accurate. So long as the mark in question consists exclusively of

⁷⁹ Paragraph 19(1) of the Applicant’s skeleton submissions.

⁸⁰ Paragraphs 19(2) and 27 of the Applicant’s skeleton submissions.

⁸¹ Paragraph 47 of Clarke’s Declaration.

signs or indications which might serve to designate characteristics of the goods or services, it should be refused registration under section 11(1)(c) of the Ordinance. The examples of descriptive use of “A2” listed in the tables in paragraphs 72, 74, 79 and 81 evidently show that “A2” is capable to be used in the trade to refer to a type of protein or a type of milk, even in Hong Kong.

(iv) Subject Mark

91. The Subject Mark is a combination of “a2” and “Store”.

92. Regarding the letter case difference between “A2” and “a2”, the Opponent argues that the two versions are interchangeable and that consumers, media and vendors use “A2” and “a2” to refer to “A2 milk”.⁸² It produces as exhibit **IBH-11** printouts of third party websites such as www.parknshop.com and www.livehealthy.com that refer to the Applicant or its products using the term “A2 Milk” with a capital letter “A”. However, that exhibit only shows that others in the trade use “A2” to refer to the Applicant, but fails to demonstrate that “A2” and “a2” are interchangeable in the trade as a descriptive term for milk or protein. That said, I note that the articles *ASK ALEX: WHAT IS THE DIFFERENCE BETWEEN A1 AND A2 MILK* in exhibit **IBH-3** and *Overseas markets key for a2 processer* in **Exhibit-15** do use the small-letter terms “a2 milk” and/or “a2 protein” to refer to a type of milk and/or protein respectively although most articles in the exhibits used “A2” with a capital “A” (see extracts in the table in paragraphs 72 and 81 above). Therefore, I agree that “A2” and “a2” are interchangeable in the trade as a descriptive term for a type of milk or a type of protein.

93. As regards whether the combination of “a2” and “Store” is descriptive of the Subject Goods and/or Subject Services, I am guided by the principles in the *POSTKANTOOR* case, at paragraph 104:

“104. The answer to the fifth question must therefore be that Art.3(1)(c) of the Directive must be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purposes of that provision, **unless there is a perceptible difference between the word and the mere sum of its parts**: that assumes either that because of **the unusual nature of the combination** in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, **with the result that the word is more than the sum of its parts**, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision. For the purposes of determining whether Art.3(1)(c) of the Directive applies to such a mark, it is **irrelevant** whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or **that the**

⁸² Paragraph 24 of de Blic-Hamon’s 1st Declaration.

characteristics of the goods or services which may be the subject of the description **are commercially essential or merely ancillary.**” (emphasis added)

94. The Opponent has referred to *Ford Motor Co v OHIM* (Case 7-67/07), at paragraph 24, on the relationship between the sign and the goods and services in question under the ground of section 11(1)(c) of the Ordinance:

“24. It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a **sufficiently direct and specific relationship** between the sign and the goods and services in question to enable the public concerned **immediately to perceive, without further thought**, a description of the category of goods and services in question or one of their characteristics (Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 25, and *RadioCom*, paragraph 22 above, paragraph 29).” (emphasis added)

95. This does not seem to be disputed by the Applicant who, in addition, has also drawn my attention to *Agencja Wydawnicza Technopol v OHIM (1000)*, [2011] ETMR 34, at paragraph 50:

“50. The fact that the legislature chose to use the word “characteristic” highlights the fact that the signs referred to in art.7(1)(c) of Regulation 40/94 are merely those which serve to designate a property, **easily recognisable by the relevant class** of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of art.7(1)(c) of Regulation 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in art.3 of Directive 89/104, *Windsurfing Chiemsee* [1999] E.T.M.R. 585 at [31], and *Koninklijke KPN Nederland* [2004] E.T.M.R. 57 at [56]).” (emphasis added)

96. The Opponent argues that there was a direct and specific relationship between the Subject Mark and the Subject Goods and Subject Services, namely:

- (1) “a2”, commonly used in the trade to denote A2 beta-casein protein, is an essential feature to “A2 milk” and the descriptive element “Store” has several meanings including “a place where people go to buy things”;⁸³ and the Subject Mark is merely a straightforward combination of descriptive elements which does not give any impression far removed from the respective meanings of the elements;⁸⁴
- (2) all Subject Goods under Classes 5, 29 and 30 are, or are likely to be, protein-based or dairy-based and either contain, or may contain, beta-casein protein, and the Subject Mark is a factual, objective reference to a type/kind of such goods that contain A2 beta-casein protein and exclude the A1 variant;⁸⁵
- (3) regarding the Subject Services in Class 35, the Subject Mark is an objective reference to the retail and wholesale services in which such products are sold, advertised, and

⁸³ Paragraphs 16, 20 and 22.3 of the Opponent’s skeleton submissions.

⁸⁴ Paragraph 22.4 of the Opponent’s skeleton submissions.

⁸⁵ Paragraph 22.1 of the Opponent’s skeleton submissions.

- promoted, whether through customer loyalty programs or otherwise;⁸⁶
- (4) for the Subject Goods under Class 9, the Subject Mark could be used to designate the purpose for storing information concerning goods containing “A2 protein”,⁸⁷ or it is a combination of “A2”, which is easily interpreted as a computer code, and “Store”, meaning “a computer memory”.⁸⁸

97. On the other hand, the Applicant argues:

- (1) “a2” is a meaningless sign among the relevant public in Hong Kong as at the relevant date as the use of “A2” to refer to a type of milk was confined to foreign markets and “store” means “a place where people go to buy things”, and the combination “a2 Store” has no descriptive meaning in the context of the Subject Goods and Subject Services;⁸⁹
- (2) even if “a2” is an immediately recognisable reference to the type of milk protein, the combination “a2 Store” would be understood as a “a shop selling a2”, which at most refers to the retail services covered by the Subject Services but not the Subject Goods;⁹⁰
- (3) in relation to the Subject Goods in Class 9, there is no discernible, direct or specific relationship between the characteristic (milk protein content) and the goods in question.⁹¹

98. As concluded in paragraphs 90 and 92 above, the term “A2” or “a2” may be used to designate in the trade a type of milk or a type of protein. Among the Subject Goods in Classes 5, 9, 29 and 30, those in Classes 5 and 29 are wholly or primarily dairy-based or protein-based and hence the term “A2” may be used to designate the kind of milk or protein therein. For Class 30, the Subject Goods “ice cream” and “frozen yoghurt” are also wholly or primarily dairy-based. For the rest of the Subject Goods in Class 30, namely “edible ices” and “desserts, namely, bakery desserts, dessert puddings, and frozen desserts; pastries; confectionery”, they represent a very broad category of goods. While sometimes dairy products may not necessarily be the primary or main ingredients, some of those goods may yet be heavily dairy-based, such as cheese cake, cream tarts, milk-based popsicles, etc, and the term “A2” or “a2” is apt to designate the type of dairy that those goods contain. Therefore, the term “A2” or “a2” may be used to designate the type of dairy or protein in the Subject Goods in Classes 5, 29 and 30. When the relevant public see the term “A2” or “a2” used in associated with those Subject Goods, such a designation would be immediately perceived.

99. The Subject Mark is “a2 Store”. One of the meanings of the word “Store”, as agreed by both parties, is “a place for people to buy things”. The Subject Mark is merely a

⁸⁶ Paragraph 22.1 and 22.5 of the Opponent’s skeleton submissions.

⁸⁷ Paragraph 23 of the Opponent’s skeleton submissions.

⁸⁸ Paragraph 23 of de Blic-Hamon’s 1st Declaration.

⁸⁹ Paragraphs 6 to 8, 26 and 30 of the Applicant’s skeleton submissions.

⁹⁰ Paragraphs 9 and 31 of the Applicant’s skeleton submissions.

⁹¹ Paragraph 29 of the Applicant’s skeleton submissions.

juxtaposition of “a2” and “Store” in a plain font without any other elements or stylisation. The elements “a2” and “Store” are simply combined in a usual way which does not contribute any perceptible difference between the individual terms and the mere sum of the same. The Subject Mark, considered as a composite whole, merely denotes a place where people can buy goods that feature or contain A2-type milk or A2-type protein. Therefore, I find a direct and specific relationship between the Subject Mark and the following Subject Services in Class 35:

“retail services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery”, and

“wholesale services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery”,

in the sense that the relevant public can immediately perceive, without further thought, the Subject Mark as a description of the services in question, namely a place where people can buy goods that feature or contain A2-type milk or A2-type protein, given that the products being retailed or wholesaled are wholly or primarily dairy-based or protein-based or may be heavily dairy-based. Moreover, for the item “online retail store services”, although it does not indicate what type of goods is sold under the services, this is broad enough to cover goods that feature A2-type milk or A2-type protein. Therefore, the Subject Mark may also be used to designate a characteristic of this item of the Subject Services, bearing in mind the fact that a term is not already in descriptive use does not preclude an objection under section 11(1)(c) of the Ordinance if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

100. That said, the Subject Mark is not descriptive of the Subject Goods in Classes 5, 29 and 30 in view of the constituent word “Store”, which renders the Subject Mark an indication of a place of selling goods rather than the goods themselves.

101. For the remaining Subject Services in Class 35, namely, “advertising; promotional services; customer loyalty program organisation and management”, although they may be offered in relation to dairy or protein products, these products are rarely associated with these services in the mind of the relevant public. Therefore, I do not think the relevant public would immediately perceive, without further thought, the Subject Mark to be a description of these services in Class 35.

102. Similarly, as regards the Subject Goods in Class 9, namely, “computer software;

downloadable computer software applications; downloadable electronic publications”, I do not consider these goods to be generally associated with dairy or protein products in the mind of the relevant public either. As regards the submissions that “A2” may be interpreted as a computer code, while not denying such a possibility, I do not consider that the relevant public would think of a computer code upon seeing “A2” as any letter or numeral or combination of them can be, or form part of, a computer code and the Opponent has not provided any evidence, or even make any further elaboration, on the significance of “A2” in computer coding which enables the relevant public to immediately perceive it as such. Moreover, the Subject Mark is “a2 Store” and not simply “A2”. It would be even more far-fetched that the Subject Mark would be used in the trade to designate the Subject Goods in Class 9 as providing computer memory for the “A2” computer code or information concerning goods containing “A2 protein”. I am not at all convinced that the relevant public would immediately perceive, without further thought, the Subject Mark to be a description of these goods in Class 9.

103. To conclude, I find that in relation to the following Subject Services in Class 35:

“retail services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery; online retail store services; wholesale services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery”,

the registration of the Subject Mark is contrary to section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

104. Section 11(1)(b) of the Ordinance precludes from registration trade marks which are devoid of any distinctive character.

105. Section 11(1)(b) of the Ordinance is broadly similar to Article 7(1)(b) of Regulation No. 40/94 (now replaced by the equivalent Article 7(1)(b) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (“EUTMR”)) and Article 3(1)(b) of the Directive.

106. In *Host Hotels & Resorts LP*, the Honourable Mr. Justice Sakhrani cited with approval the following principles (paragraphs 17–18):

“17. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, Jacob J (as he then was) said at p. 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 V-C (as he then was) said at para. 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...’ (emphasis added)

107. The Opponent has also referred to “*WeShop*” Trade Mark, Decision of EUIPO, 11 March 2022, which upheld the similar principles:

“A sign that fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) EUTMR if it may be **perceived immediately** as an indication of the commercial origin of the goods and services (05/12/2002, T-130/01, *Real People, Real Solutions*, EU:T:2002:301, §20; 13/04/2011, T-523/09, *Wir machen das Besondere einfach*, EU:T:2011:175, §31). Since the relevant consumer is not very attentive, if a sign does not immediately indicate to them the origin or intended use of the object of their intended purchase, but just provides them with purely promotional, abstract information, they will not take the time to either enquire into the sign’s various possible functions or to register it mentally as a trade mark (05/12/2002, T-130/01, *Real People, Real Solutions*, EU:T:2002:301, §28-29; 11/12/2012, T-22/12, *Qualitat hat Zukunft*, EU:T:2012:663, §30).

The distinctive character must be assessed, **first**, by **reference to the goods and services** in respect of which registration is sought and, **second**, by **reference to the perception of the sign by the relevant public** (29/04/2004, C-473/01 P & C-474/01 P, *Tabs*, EU:C:2004:260, §33; 08/05/2008, C-304/06 P, *Eurohypo*, EU:C:2008:261, §67; 21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, §34).” (emphasis added)

108. According to the above legal principles, a mark’s distinctiveness shall be assessed by reference to the goods and/or services applied for, and the perception of the relevant consumers, who are presumed to be reasonably well-informed, circumspect and observant. The question to be asked is whether the mark, assuming no use, serves to identify the applicant’s goods and/or services as originating from a particular undertaking, and thus distinguishing them from those of other undertakings. In other words, the question is whether the perception of the mark triggered in the mind of the average consumers of the relevant goods and services is origin specific or origin neutral.

109. Furthermore, regarding the objections between section 11(1)(c) and 11(1)(b) of the Ordinance, the *POSTKANTOOR* case held at paragraph 86 that:

“86. In particular, a word mark which is **descriptive** of characteristics of goods or services for the purposes of Art.3(1)(c) of the Directive is, on that account, **necessarily devoid of any distinctive character** with regard to the same goods or services within the meaning of Art.3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.” (emphasis added)

110. In other words, in relation to the Subject Services listed in paragraph 103 above, the registration of the Subject Mark is also contrary to section 11(1)(b).

111. For the rest of the Subject Goods and Subject Services, the Opponent submits that the Subject Mark lacks any distinctive character as it merely describes the kind of outlet which sells goods containing A2 beta-casein protein and services rendered in relation thereto, and that it would be immediately apparent to the relevant public as such.⁹² The Opponent draws an analogy between the Subject Mark with the mark “EUROSHOP”, which is the subject of the case “*EUROSHOP*” *Trade Mark*, decision of Board of Appeal (OHIM), R 212/2000-2, 6 May 2002. In that case, the Board of Appeal refused the registration in relation to products from a wide range of classes, taking the view that the word “EUROSHOP” consists of the components “EURO” and “SHOP”, in which “EURO” is an abbreviation of “Europe” or “European”, and that the word “EUROSHOP” is readily comprehensible to consumers as an indication of an establishment which is based in the European Community, serves European customers especially or has specialised in selling European goods or providing Europe-wide services, and hence devoid of any distinctive characters.

112. The Applicant argues that “*EUROSHOP*” *Trade Mark* is distinguishable on the facts as “EURO” has a well-accepted dictionary meaning whereas “a2” is meaningless.⁹³

113. Moreover, there has been an exchange of submissions as to whether customary use is included under section 11(1)(b) of the Ordinance and the Opponent has cited a few authorities on this. The reason for such an exchange is that the Opponent further, or alternatively, argues that the Subject Mark has become customary in the bona fide and established practices of the trade of the Subject Goods and Subject Services, as “A2” is a common designation of A2 beta-casein protein in respect of dairy-based products.⁹⁴ However, as mentioned in paragraph 69 above, there is no evidence of use of the Subject Mark as a whole in Hong Kong, so there is no evidence showing that the Subject Mark is or has been customarily used in the trade in any event. Therefore, I will not consider this issue and those authorities here.

114. The Subject Mark is a plain word mark juxtaposing the terms “a2” and “Store”. I have

⁹² Paragraph 35 of the Opponent’s skeleton submissions.

⁹³ Paragraph 39 of the Applicant’s skeleton submissions.

⁹⁴ Paragraphs 38 and 39 of the Opponent’s skeleton submissions.

already found that the Subject Mark, considered as a whole, may be used to denote a place where people buy goods that feature A2-type milk or A2-type protein. Given that the Subject Goods in Classes 5, 29 and 30 are wholly or primarily dairy-based or protein-based or may be heavily dairy-based, the Subject Mark merely describes the kind of outlet selling those goods, and the same term may aptly be used by other undertakings offering similar goods. In other words, the Subject Mark cannot serve to distinguish the Subject Goods from those of other undertakings by their trade origin. Therefore, the Subject Mark is precluded from registration in respect of the Subject Goods in Classes 5, 29 and 30 under section 11(1)(b) of the Ordinance.

115. However, as mentioned in paragraphs 101 and 102 above, for the remaining Subject Services in Class 35, namely, “advertising; promotional services; customer loyalty program organisation and management” and the Subject Goods in Class 9, I do not consider these goods or services to be generally associated with dairy or protein products in the mind of the relevant public. For these Subject Services in Class 35, the Opponent does not suggest that “a2” has any other meaning unrelated to dairy or protein products. On the other hand, for the Subject Goods in Class 9, I have, in paragraph 102 above, already rejected the Opponent’s argument that “a2” has a generally perceived meaning of referring to a computer code. Therefore, I consider that the term “a2” is meaningless and distinctive in relation to such goods and services, and that the Subject Mark cannot be said to be devoid of any distinctive characters for those goods and services so that the registration of the Subject Mark on those goods and services should be refused under section 11(1)(b) of the Ordinance.

Conclusion

116. I have carefully considered all evidence filed and submissions made by or on behalf of both parties. For the reasons given above, the registration of the Subject Mark is refused in relation to the following Subject Services under section 11(1)(b) and 11(1)(c) of the Ordinance:

Class 35

Retail services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery; online retail store services; wholesale services in relation to foods, beverages, food for infants, powdered milk for babies, dietetic foods adapted for medical purposes, dietetic beverages adapted for medical purposes, dietary and nutritional supplements, protein dietary supplements, milk powder, milk, butter, cheese, cream, yoghurt, milk beverages (milk predominating), ice cream, edible ices, frozen yoghurt, desserts, bakery desserts, dessert puddings, frozen desserts, pastries, and confectionery.

117. The registration of the Subject Mark is refused in relation to the following Subject Goods under section 11(1)(b) of the Ordinance:

Class 5

Food for infants; powdered milk for babies; dietetic foods adapted for medical purposes; dietetic beverages adapted for medical purposes; dietary and nutritional supplements; protein dietary supplements.

Class 29

Milk powder; milk; butter; cheese; cream; yoghurt; milk beverages, milk predominating.

Class 30

Ice cream; edible ices; frozen yoghurt; desserts, namely, bakery desserts, dessert puddings, and frozen desserts; pastries; confectionery.

118. The registration of the Subject Mark may proceed in relation to the following Subject Goods and Subject Services:

Class 9

Computer software; downloadable computer software applications; downloadable electronic publications.

Class 35

Advertising; promotional services; customer loyalty program organisation and management.

Costs

119. As the opposition is successful with respect to the majority of the Subject Goods and Subject Services, I award the Opponent costs.

120. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes 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 between the parties.

(Frederick Kwok)
for Registrar of Trade Marks
7 June 2023