

TRADE MARKS ORDINANCE (CAP. 559)  
OPPOSITION TO TRADE MARK APPLICATION NO. 304676815

Mark:

ATWO

Classes: 5, 29

Applicant: The a2 Milk Company Limited

Opponent: Société des Produits Nestlé S.A.

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STATEMENT OF REASONS FOR DECISION

**Background**

1. On 21 September 2018, 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:

ATWO

(“**Subject Mark**”).

2. Registration is sought in respect of the following goods in Classes 5 and 29 (“**Subject Goods**”):

Class 5

Food for infants; milk and powdered milk for infants; dietetic foods adapted for medical purposes; dietetic beverages adapted for medical purposes; nutritional supplements; powdered nutritional supplement drink mixes; dietary supplemental drinks; protein dietary supplements; protein powder (dietary supplement).

Class 29

Milk powder; milk; butter; cheese; cream; yoghurt; milk beverages, milk predominating; milk-based protein drinks; whey; dry whey; protein powder for use as a food additive.

3. Particulars of the Subject Application were published on 9 November 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” 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.<sup>1</sup>

6. In light of the above, the Opponent contends that the Subject Mark, which simply stands for “A2” to the consumers in Hong Kong, conveys, or can convey, the idea, or could be used to describe, that the Subject Goods are free from A1 beta-casein protein or that they contain A2 beta-casein protein, and should be precluded from registration under section 11(1)(c) of the Ordinance.<sup>2</sup>

7. In addition, given that the Subject Mark, consisting solely of the single term “ATWO” in ordinary font type, is entirely descriptive or customary in the trade in Hong Kong in respect of the Subjects Goods and thus devoid of any distinctive character, the Opponent requests that the Subject Application be refused under section 11(1)(b) of the Ordinance.<sup>3</sup>

### **Counter-Statement**

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

9. The Applicant denies the above contentions of the Opponent.<sup>4</sup>

10. The Applicant avers that the Subject Mark is a distinctive term, which has been accepted for publication by the Trade Marks Registry.<sup>5</sup>

11. 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.<sup>6</sup> 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.<sup>7</sup>

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<sup>1</sup> Paragraphs 8 to 10 and 15 of the Grounds of Opposition.

<sup>2</sup> Paragraph 16 of the Grounds of Opposition.

<sup>3</sup> Paragraphs 19 and 20 of the Grounds of Opposition.

<sup>4</sup> Paragraphs 5, 7, 9 and 11 of the Counter-Statement.

<sup>5</sup> Paragraph 5 of the Counter-Statement.

<sup>6</sup> Paragraph 8 of the Counter-Statement.

<sup>7</sup> Paragraph 43 of the Applicant’s skeleton submissions.

## Opponent's Main Evidence

12. 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 1<sup>st</sup> 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 1<sup>st</sup> Declaration**").

### *(i) de Blic-Hamon's 1<sup>st</sup> Declaration*

13. According to de Blic-Hamon's 1<sup>st</sup> Declaration, there are two primary variants of beta-casein protein in cow's milk, namely A1 and A2.<sup>8</sup> 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.<sup>9</sup> 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](http://www.a2australia.com.au) between 14 April 2005 and 21 September 2007 as captured by the Wayback Machine Web Archive.

14. 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.<sup>10</sup> 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.<sup>11</sup> 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.<sup>12</sup> Other products relating to "A2 milk" are also referred to using the term "A2", e.g. "A2 formula".<sup>13</sup> 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".

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<sup>8</sup> Paragraph 7 of de Blic-Hamon's 1<sup>st</sup> Declaration.

<sup>9</sup> Paragraph 9 of de Blic-Hamon's 1<sup>st</sup> Declaration.

<sup>10</sup> Paragraph 8 of de Blic-Hamon's 1<sup>st</sup> Declaration.

<sup>11</sup> Paragraphs 13 and 18 of de Blic-Hamon's 1<sup>st</sup> Declaration.

<sup>12</sup> Paragraph 17 of de Blic-Hamon's 1<sup>st</sup> Declaration.

<sup>13</sup> Paragraph 13 of de Blic-Hamon's 1<sup>st</sup> Declaration.

15. As expounded in Chan’s 1<sup>st</sup> Declaration (see paragraph 22 below), there are perceived 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”.<sup>14</sup>

16. According to Ms de Blic-Hamon, “ATWO” in ordinary font type with no additional element or stylisation is the same or at least interchangeable with “A2” to the relevant consumers in Hong Kong, as they have the same meaning and pronunciation, with the only difference being the spelling of “2” in letters.<sup>15</sup> Exhibit **IBH-10** contains printouts from the Cambridge English Dictionary, the Oxford Learner’s Dictionary, the Macmillan Dictionary and Lexico, showing that “TWO” means “2”. Included in exhibit **IBH-11** are printouts of (1) the search results for “ATWO milk” on various online search engines, (2) the webpage of ATwoProteins<sup>TM</sup> Inc., a Canadian start-up, where terms such as “A2 protein”, “A2 Milk”, “ATwo Milk”, “ATwo Cheese”, etc can be found, (3) the search results for “ATWO” on various online shopping platforms in Hong Kong such as Parknshop, Wellcome and HKTV mall, and (4) a scientific journal article entitled “A Two Proteins<sup>TM</sup>”.

17. Furthermore, Ms de Blic-Hamon contends that consumers, media and vendors alike use “A2” to refer to “A2 milk”, and points out that attempts by the Applicant to claim exclusive right to the term “A2” were unsuccessful in a number of jurisdictions.<sup>16</sup> Marked as exhibit **IBH-12** 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 1<sup>st</sup> Declaration***

18. According to Chan’s 1<sup>st</sup> 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.<sup>17</sup>

19. 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.<sup>18</sup>

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<sup>14</sup> Paragraphs 15 and 16 of de Blic-Hamon’s 1<sup>st</sup> Declaration.

<sup>15</sup> Paragraph 22 of de Blic-Hamon’s 1<sup>st</sup> Declaration.

<sup>16</sup> Paragraph 24 of de Blic-Hamon’s 1<sup>st</sup> Declaration.

<sup>17</sup> Paragraphs 16 and 19 of Chan’s 1<sup>st</sup> Declaration.

<sup>18</sup> Paragraph 18 of Chan’s 1<sup>st</sup> Declaration.

20. 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.<sup>19</sup>

21. There have also been news reports about “A2 milk” in local media.<sup>20</sup> Included in exhibit **CWE-5** are articles from the South China Morning Post and Hong Kong Economic Times that discuss “A2 milk”.

22. 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.<sup>21</sup> However, there are recent studies showing that people who are lactose intolerant report experiencing fewer symptoms after drinking “A2 milk” than ordinary milk.<sup>22</sup> 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**

23. 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**”).

#### **(i) Massasso’s Declaration**

24. 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 Applicants worldwide and in Hong Kong<sup>23</sup>, the worldwide trade mark protection of the Applicant’s Marks<sup>24</sup>, the protection and use of domain names containing the Applicant’s Marks<sup>25</sup>, the sales of products

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<sup>19</sup> Paragraph 20 of Chan’s 1<sup>st</sup> Declaration.

<sup>20</sup> Paragraph 21 of Chan’s 1<sup>st</sup> Declaration.

<sup>21</sup> Paragraph 23 of Chan’s 1<sup>st</sup> Declaration.

<sup>22</sup> Paragraph 24 of Chan’s 1<sup>st</sup> Declaration.

<sup>23</sup> Paragraphs 19 to 28 of Massasso’s Declaration.

<sup>24</sup> Paragraph 29 of Massasso’s Declaration.

<sup>25</sup> Paragraphs 30 to 34 of Massasso’s Declaration.

bearing the Applicant’s Marks worldwide and in Hong Kong<sup>26</sup>, the advertisements, promotion, and media coverage of the Applicant’s products<sup>27</sup>, and the popularity and fame of the Applicant’s products.<sup>28</sup> 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.<sup>29</sup> To support the above, Ms Massasso produces the following evidence:

<b>Exhibit</b>	<b>Description</b>
<b>Exhibit-2</b>	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
<b>Exhibit-3</b>	Photos of the Applicant’s product packaging that contains at least one of the Applicant’s Marks
<b>Exhibit-4</b>	A list of the Applicant’s pending applications for and registrations of trade marks containing the Applicant’s Marks in different jurisdictions, which includes an entry of a pending application of the Subject Mark in Samoa (as at 1 August 2018)
<b>Exhibit-5</b>	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
<b>Exhibit-6</b>	Screen captures from the Wayback Machine Web Archive showing various websites of the Applicant between 2003 and 2018
<b>Exhibit-7</b>	Extracts from the Applicant’s China T-Mall website as at 3 July 2020 showing the Applicant’s “a2” brand and infant formula products
<b>Exhibit-8</b>	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.)
<b>Exhibit-9</b>	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
<b>Exhibit-10</b>	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 sold (as at August 2020)
<b>Exhibit-11</b>	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)
<b>Exhibit-12</b>	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)
<b>Exhibit-13</b>	Print and online news articles from New Zealand’s media about the Applicant in which the Applicant’s Marks are referred to
<b>Exhibit-14</b>	The Applicant’s half-year reports and annual reports from 2010 to 2019
<b>Exhibit-15</b>	The Applicant’s presentations accompanying its half-year and annual reports
<b>Exhibit-16</b>	Copies of the Applicant’s market announcements between 2014 and 2017

<sup>26</sup> Paragraphs 35 to 46 of Massasso’s Declaration.

<sup>27</sup> Paragraphs 47 to 56 of Massasso’s Declaration.

<sup>28</sup> Paragraphs 57 to 59 of Massasso’s Declaration.

<sup>29</sup> Paragraphs 19 and 23 of Massasso’s Declaration.

<b>Exhibit-17</b>	Printouts of online articles and publications in which the Applicant’s products are shown
<b>Exhibit-18</b>	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
<b>Exhibit-19</b>	Photos taken from the episodes of the 2013 “MasterChef Australia” cooking competition television series, which feature the Applicant’s products
<b>Exhibit-20</b>	Photos taken at the mother class activity hosted by Hong Kong Suning/Baby Kingdom and sponsored by the Applicant in Hong Kong in 2018
<b>Exhibit-21</b>	Printouts of Facebook posts of intermediaries selling the Applicant’s overseas products in Hong Kong between May 2017 and August 2018
<b>Exhibit-22</b>	Copies of letters issued by the Hong Kong Customs and Excise Department in relation to suspected counterfeits of the Applicant’s products

25. 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.

26. Regarding the Subject Mark, Ms Massasso describes it as a natural extension of the “a2” and “A2 Milk” brands as they are phonetically equivalent<sup>30</sup>, and argues that it does not have any dictionary meaning. **Exhibit-23** contains copies of printouts of search results of “ATWO” and “a2” from online dictionaries such as the Oxford, Cambridge and Collins dictionaries showing that there is no entry for “ATWO” 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.<sup>31</sup>

27. Ms Massasso also emphasises that the Subject Goods do not necessarily contain and/or relate to A2 beta-casein protein and that the Subject Mark is not a descriptive term such as “ATWO BETA CASEIN” or “ATWO PROTEIN”.<sup>32</sup>

28. Furthermore, Ms Massasso produces as **Exhibit-24** printouts of the online trade mark records of the Subject Mark in different jurisdictions supporting that the Subject Mark has been registered or accepted for registration in the European Union, Samoa, South Korea, Vietnam and Taiwan (being opposed).<sup>33</sup>

29. In response to de Blic-Hamon’s 1<sup>st</sup> 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.<sup>34</sup>

<sup>30</sup> Paragraph 20 of Massasso’s Declaration.

<sup>31</sup> Paragraph 61 of Massasso’s Declaration.

<sup>32</sup> Paragraphs 63 and 64 of Massasso’s Declaration.

<sup>33</sup> Paragraph 65 of Massasso’s Declaration.

<sup>34</sup> Paragraph 67 of Massasso’s Declaration.

30. 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, and that 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.<sup>35</sup> **Exhibit-25** is the relevant excerpt from that decision. Ms Massasso also produces as **Exhibit-26** printouts of the search results for the terms “google”, “hoover” and “xerox” from the Macquarie Dictionary Online, and points out that these words are listed in that dictionary as a verb even though they are registered trade marks in Hong Kong.<sup>36</sup>

31. 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.<sup>37</sup>

32. In relation to exhibits **IBH-7** to **IBH-9**, Ms Massasso argues that “A2” is used by the Applicant with regard to A2 beta-casein protein instead of in a descriptive manner in relation to milk. Moreover, she also repeats that the Applicant consistently uses the “TM” and “®” symbols beside its “a2” and “a2 Milk” trade marks, depending on whether the marks are registered or not in the relevant territory.<sup>38</sup>

33. With regards to exhibit **IBH-12**, Ms Massasso contends that Ms de Blic-Hamon’s statement that the trade marks in question have been refused or cancelled is misleading, and that none of them was declared invalid.<sup>39</sup>

34. Regarding Chan’s 1<sup>st</sup> 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;<sup>40</sup>
- (2) Exhibit **CWE-4** shows that the phrase “A2  $\beta$ -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, and that the use of “Atwo” on the Opponent’s products and advertisements is to indicate a brand, replicating the Subject Mark;<sup>41</sup> and

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<sup>35</sup> Paragraph 68 of Massasso’s Declaration.

<sup>36</sup> Paragraph 69 of Massasso’s Declaration.

<sup>37</sup> Paragraph 70 of Massasso’s Declaration.

<sup>38</sup> Paragraph 71 of Massasso’s Declaration.

<sup>39</sup> Paragraph 72 of Massasso’s Declaration.

<sup>40</sup> Paragraph 74 of Massasso’s Declaration.

<sup>41</sup> Paragraph 75 of Massasso’s Declaration.



- (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.<sup>42</sup>

**(ii) Clarke's Declaration**

35. 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.<sup>43</sup> 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.<sup>44</sup> Exhibits **AJC-1** to **AJC-8** are copies of the relevant academic journal articles.

36. 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.<sup>45</sup> 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.<sup>46</sup> 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.<sup>47</sup>

37. 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.<sup>48</sup> 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.<sup>49</sup>

38. 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.<sup>50</sup>

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<sup>42</sup> Paragraph 76 of Massasso's Declaration.

<sup>43</sup> Paragraphs 6 to 22 of Clarke's Declaration.

<sup>44</sup> Paragraphs 23 to 28 of Clarke's Declaration.

<sup>45</sup> Paragraphs 36 and 37 of Clarke's Declaration.

<sup>46</sup> Paragraph 39 of Clarke's Declaration.

<sup>47</sup> Paragraph 47 of Clarke's Declaration.

<sup>48</sup> Paragraphs 40 and 41 of Clarke's Declaration.

<sup>49</sup> Paragraphs 42 to 44 of Clarke's Declaration.

<sup>50</sup> Paragraphs 45 and 46 of Clarke's Declaration.

## Opponent's Evidence in Reply

39. The Opponent's evidence in reply consists of the Statutory Declaration of Isabelle de Blic-Hamon dated 26 October 2021 ("**de Blic-Hamon's 2<sup>nd</sup> Declaration**") and the Statutory Declaration of Chan Wing Eleanor dated 29 October 2021 ("**Chan's 2<sup>nd</sup> Declaration**").

### *(i) de Blic-Hamon's 2<sup>nd</sup> Declaration*

40. 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.<sup>51</sup> 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-6** and **Exhibit-8** of Massasso's Declaration.

41. 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.<sup>52</sup> 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.

42. Regarding Ms Massasso's allegation that exhibits **IBH-3**, **IBH-6** and **IBH-7** are either undated or dated after the filing date of the Subject Application, Ms Blic-Hamon points out that some of the materials under those exhibits were published before that date.<sup>53</sup>

43. 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.<sup>54</sup>

### *(ii) Chan's 2<sup>nd</sup> Declaration*

44. 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.<sup>55</sup> 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

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<sup>51</sup> Paragraphs 7 and 8 of de Blic-Hamon's 2<sup>nd</sup> Declaration.

<sup>52</sup> Paragraph 9 of de Blic-Hamon's 2<sup>nd</sup> Declaration.

<sup>53</sup> Paragraph 10 of de Blic-Hamon's 2<sup>nd</sup> Declaration.

<sup>54</sup> Paragraph 11 of de Blic-Hamon's 2<sup>nd</sup> Declaration.

<sup>55</sup> Paragraph 7 of Chan's 2<sup>nd</sup> Declaration.

are likely to have watched [it]”, Ms Chan produces exhibit **CWE-1**, a printout from the website [www.digitaltvnews.net](http://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.<sup>56</sup>

## The Ordinance

45. 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 argue that the Subject Mark has acquired distinctiveness through use.

46. 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

47. 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.

48. 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**”).

49. 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:

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<sup>56</sup> *Ibid.*

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.<sup>57</sup>

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)

50. 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

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<sup>57</sup> Article 7(3) of Regulation No. 40/94 is similar to section 11(2) of the Ordinance.

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)

51. However, I would like to comment on another authority that the Opponent has cited in its skeleton submissions<sup>58</sup> 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 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)

52. 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 submissions<sup>59</sup>) 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

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<sup>58</sup> Paragraph 11 of the Opponent’s skeleton submissions.

<sup>59</sup> Paragraph 7(c) of the Opponent’s skeleton submissions.

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 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)**

53. 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.

54. 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.

55. Before I proceed to evaluate whether the Subject Mark may be used to designate characteristics of the Subject Goods, I would like to address the parties' submissions on the issues of (i) the relevant date, and (ii) the relevant public.

**(i) Relevant date**

56. 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 21 September 2018. 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.<sup>60</sup> 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 28 March 2018, 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.<sup>61</sup>

57. 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.”

58. 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.

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<sup>60</sup> Paragraph 17 of the Opponent's skeleton submissions.

<sup>61</sup> 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.

59. 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.

60. 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:

- (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 49 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 use<sup>62</sup> (see the extract of the relevant authority in paragraph 82 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

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<sup>62</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, 306.



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.

- (4) Although the priority date and the application date are six months apart, there is no evidence of actual descriptive use of the Subject Mark dated between those dates (see paragraph 78 below). I could hardly imagine there is any difference in the perception of the Subject Mark by the relevant public due to this 6-month period.

61. 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**

62. 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)

63. 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)

64. In addition, the Opponent argues that since the Subject Goods (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 and academia.<sup>63</sup> 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 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.

65. 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.<sup>64</sup>

“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)

66. Mr Ling argues that whether the average consumers include professionals depends on the goods concerned. He contends that, apart from the certain goods for medical purposes in Class 5, all Subject Goods 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.

67. On the other hand, Mr Tse replies that the Subject Goods 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 the Subject Goods.<sup>65</sup>

68. I agree with the Applicant’s submissions that the relevant consumers depend on the goods 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 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.

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<sup>63</sup> Paragraphs 16 and 19.4 to 19.6 of the Opponent’s skeleton submissions.

<sup>64</sup> Paragraphs 17 and 18 of the Applicant’s skeleton submissions.

<sup>65</sup> Paragraph 16 of the Opponent’s skeleton submissions.

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.

69. 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 *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) Subject Mark***

70. 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 concerned perceive the Subject Mark as describing the characteristics of the goods. 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 also fall foul of the section.

71. The Subject Mark is the word mark “ATWO”.

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

- (1) “A2” is commonly used in the trade to denote A2 beta-casein protein;<sup>66</sup>
- (2) the relevant public will usually break down a verbal sign into elements which suggest a concrete meaning or resemble words known to him;<sup>67</sup>
- (3) the Subject Mark is composed of “A” and the numeral “2” spelt out in letters, and shares the same pronunciation and conceptual meaning as “A2”;<sup>68</sup>
- (4) “ATWO” and “A2” have been used interchangeably by the relevant public, e.g. the Opponent has used “ATWO” for its “A2 milk” products, and “ATwo Proteins” is the name of a Canadian start-up which manufactures “A2 milk” products;<sup>69</sup>
- (5) the Subject Goods are, or are likely to be, protein-based or dairy-based and either contain, or may contain, beta-casein protein; the Subject Mark, which would be perceived as “A2”, is a factual, objective reference to a type/kind of such goods that contain A2 beta-casein protein and exclude the A1 variant.<sup>70</sup>

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<sup>66</sup> Paragraph 15 of the Opponent’s skeleton submissions.

<sup>67</sup> Paragraph 18(a) of the Opponent’s skeleton submissions.

<sup>68</sup> Paragraph 18(b) of the Opponent’s skeleton submissions.

<sup>69</sup> Paragraph 18(c) of the Opponent’s skeleton submissions.

<sup>70</sup> Paragraph 20.1 of the Opponent’s skeleton submissions.

73. On the other hand, the Applicant argues:

- (1) “ATWO” has no dictionary meaning or relevant accepted meaning known to the relevant public as at the relevant date, and may be pronounced as “*at-wou*”;<sup>71</sup>
- (2) the breakdown of “ATWO” into “A” and “TWO” is highly artificial; even when confronted with the phrase “A TWO”, the consumers are likely to reject it as meaningless and revert to the original, equally meaningless, sign, perceiving it as a whole rather than equating it with “A2”;<sup>72</sup>
- (3) even if the relevant consumers established the link between “ATWO” and “A2”, they would not understand it to refer to the presence of A2 beta-casein protein or the absence of the A1 variant as the use of “A2” to refer to a type of milk rich in A2 beta-casein protein was confined to foreign markets;<sup>73</sup>
- (4) the use of “ATWO” or “ATwoProteins” were adopted by third parties as a name of a product or as a trade mark, rather than an accepted substitute of the scientific name of the protein.<sup>74</sup>

74. 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)

75. 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)

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<sup>71</sup> Paragraphs 6 and 35 of the Applicant’s skeleton submissions.

<sup>72</sup> Paragraphs 10 and 11 of the Applicant’s skeleton submissions.

<sup>73</sup> Paragraphs 13, 32 to 34 of the Applicant’s skeleton submissions.

<sup>74</sup> Paragraphs 12 and 30 of the Applicant’s skeleton submissions.

76. According to the evidence submitted by the parties, “ATWO” is not a word that can be found in dictionaries, which means that it has no established meaning or pronunciation. Meaning/interpretation and pronunciation come hand in hand; how the Subject Mark is interpreted determines how it is pronounced. For example, it may be interpreted as an abbreviation of a phrase with all letters spelt out individually as “*ay-tee-duh.blyoo-oh*”. Alternatively, it may be treated as a word or an acronym and pronounced as “*ay-too*” or “*at-woh*”, depending on how the letters are grouped into syllables. With no obvious hints such as spacing or colour contrasts in the Subject Mark indicating the expected letter grouping, both pronunciations are equally plausible.

77. The Opponent argues that the relevant public will break “ATWO” into “A” and “TWO”, as that would have the same pronunciation and conceptual meaning as “A2”. I am doubtful of such assertion, and given its importance in the determination of this case, I think concrete evidence should have been produced to prove it. I am aware that the Subject Mark is used on Subject Goods in Classes 5 and 29, which are wholly or primarily dairy-based or protein-based, and I have in the decision of the opposition against the trade mark application no. 304287097 for “**a2 Store**” [2023] HKTMR 29 held that “A2” is capable to be used in the trade in Hong Kong to refer to a type of protein or a type of milk by the date of filing of that trade mark application, namely 22 September 2017.<sup>75</sup> That said, I cannot conclude that the relevant public, upon seeing the Subject Mark “ATWO” on the Subject Goods in Classes 5 and 29, will immediately perceive, without further thought, that “ATWO” refers to “A2” and, further, to a type of protein or a type of milk. As both parties agree, the term “A2” originates from the scientific field as part of the nomenclature of proteins or other biological substances. It is precisely due to its scientific origin that “A2” is rarely written out in full as “A TWO” in two words, let alone “ATWO” in one. Moreover, letter-and-numeral combinations can also give very different impressions from their counterparts in full written form to the relevant public. To illustrate this, Mr Ling gives a hypothetical example of “COTWO” and questions if an average consumer would, upon perception, associate it with “CO<sub>2</sub>” (carbon dioxide).<sup>76</sup> I see the force of such analogy; likewise, in the present case, I consider that the impressions of “ATWO” and “A2” are perceptually different. It is not easily recognisable by the relevant public that “ATWO” refers to “A2” and hence is capable of describing a type of milk or a type of protein, even if it is used in relation to the Subject Goods in Classes 5 and 29.

<sup>75</sup> The evidence submitted for the case [2023] HKTMR 29 and extracted in the tables in paragraphs 72, 74, 79 and 81 of that decision also form part of the evidence of the present case. However, there are slight differences in the exhibit numbers and page numbers of the relevant extracts as summarized below:

[2023] HKTMR 29		Present case
Paragraph of the decision	Exhibit/page number	Exhibit/page number
79	Exhibit-8 (pp.278, 331, 333)	Exhibit-6 (pp.259, 312, 314)
	Exhibit-10 (p.384)	Exhibit-8 (p.365)
81	Exhibit-15	Exhibit-13

<sup>76</sup> Paragraph 11 of the Applicant’s skeleton submissions.

78. After all, the Opponent has provided very little evidence showing that “ATWO” itself is used in the trade to refer to a type of milk or a type of protein. The only relevant evidence is exhibit **IBH-11**, which includes, among others, the printouts of (1) the search results for “ATWO milk” on various online search engines, (2) the webpage of ATwoProteins™ Inc., a Canadian start-up, where terms such as “A2 protein”, “A2 Milk”, “ATwo Milk”, “ATwo Cheese”, etc can be found, and (3) a scientific journal article entitled “A Two Proteins™”. The printouts in (1) show the phrases “ILLUMA® ATWO™” and “ATwoProteins™ Inc. – Know your milk” among the top search results. “ILLUMA® ATWO™” refers to the milk-based products of the Opponent. The “TM” symbol next to “ATWO” clearly shows that it is used as a trade mark rather than a descriptive term. The same applies to the search result “ATwoProteins™ Inc. – Know your milk”. In fact, “ATwoProteins™ Inc.” is the name of the Canadian start-up in (2), and the title “A Two Proteins™” in the journal article in (3) also refers to the same start-up. All these uses of the term “ATwo” are marked with the “TM” symbol, indicating their non-descriptive nature. The only uses of the term “ATWO” without the “TM” symbol are found on the webpage of the Canadian start-up in terms such as “ATwo Milk” and “ATwo Cheese”. At the same time, I am mindful of the fact that the relevant search results, webpage and article in exhibit **IBH-11** were all printed out in or is dated 2019, after the relevant date. While I note that the webpage of the start-up contains a copyright notice “© 2018 Atwo Proteins”, it is impossible to tell whether the contents were posted before or after the relevant date. Even if I take them into account on the assumption that they showed the position of how the term “ATWO” was used as at the relevant date, such uses by a single trader is insufficient to establish that “ATWO” itself has been generally used in the trade to refer to the term “A2” or, further, to a type of milk or a type of protein.

79. To conclude, given the different plausible interpretations of the Subject Mark “ATWO”, I do not find that the relevant public would, upon perception, immediately associate “ATWO” with “A2” and hence understand it to refer to a type of milk or a type of protein. Moreover, there is no evidence before me showing that the Subject Mark itself had been generally used in the trade to designate any characteristics of the Subject Goods as at the relevant date. Therefore, I do not find the Opponent’s attempt successful in proving that the Subject Mark could serve in the trade to designate the characteristics of the Subject Goods. The registration of the Subject Mark does not fall foul of section 11(1)(c) of the Ordinance.

### **Section 11(1)(b) of the Ordinance**

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

81. 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.

82. In *Host Hotels & Resorts LP*, the Honourable Mr. Justice Sakhani 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**)

83. 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**)

84. 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.

85. For the ground of section 11(1)(b), the Opponent mainly relies on the arguments for the ground of section 11(1)(c), namely that the Subject Mark “ATWO” is purely descriptive of the Subject Goods and there is nothing in the mark that can distinguish the Subject Goods of the Applicant from those of other undertakings.<sup>77</sup> The Applicant, on the other hands, simply submits that the Registrar’s conclusion of the meaning (or lack of it) of the sign “ATWO” under the heading of section 11(1)(c) would determine the outcome of this ground.<sup>78</sup>

86. As mentioned in paragraph 79 above, I do not find the Subject Mark could serve to designate any characteristics of the Subject Goods as at the relevant date. Instead of seeing it as referring to “A2” or a type of milk or protein, the relevant public will likely perceive the Subject Mark as a sequence of four letters as a whole that has no dictionary meaning. The Subject Mark, when used in relation to the Subject Goods, is capable of indicating their trade origin, i.e. the Applicant, without first educating the public that it is a trade mark. Therefore, it cannot be said to be devoid of any distinctive character.

87. 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.<sup>79</sup> However, as mentioned in paragraph 78 above, the evidence only shows a single undertaking using the Subject Mark in a descriptive manner. In other words, there is no evidence showing that the Subject Mark has ever been customarily used in the trade in any event. Therefore, I will not consider this issue and those authorities here.

88. In view of the above, I do not find the registration of the Subject Mark contrary to section 11(1)(b) of the Ordinance.

## **Conclusion**

89. I have carefully considered all evidence filed and submissions made by or on behalf of both parties. Since none of the grounds under section 11(1)(b) and 11(1)(c) of the Ordinance has been made out, the opposition fails.

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<sup>77</sup> Paragraphs 31 to 34 of the Opponent’s skeleton submissions.

<sup>78</sup> Paragraph 42 of the Applicant’s skeleton submissions.

<sup>79</sup> Paragraphs 35 and 36 of the Opponent’s skeleton submissions.



## **Costs**

90. As the opposition is unsuccessful, I award the Applicant costs.

91. 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