

**In The Matter Of Application No. 6509/90
By Kellogg Company.
To Register A Trade Mark In Class 30**

And

Opposition By Pacific Food Products Sdn Bhd

*Before Assistant Registrar Chiam Lu Lin
31 March and 27 April 1999*

Trade Mark - Application for registration - Opposition - Part B registration under S 12 of the Trade Marks Act (Cap. 332 1985 Edn) based on UK precedent - Whether 2 years' prior use is necessary - Whether Registrar has discretion to refuse to accept such a mark in Part B - Whether mark capable of distinguishing - Burden of proof - Application allowed

Kellogg Company's mark "Smacks" was advertised in Part B of the Register in Class 30 in respect of "Wheat cereal, for food for human consumption, coated with sugar and honey". The application was accepted in Part B under Section 12 of the Trade Marks Act, Cap. 332 1985 Edn (the Act) based on a corresponding United Kingdom (UK) registration. Pacific Food Products Sdn Bhd (the Opponents) opposed the registration under Sections 12 of the Act.

The Opponents contended that the application did not satisfy Section 12 on the basis that there had been no prior 2 years' use of the mark "SMACKS" alone in Singapore and that the mark was not capable of distinguishing the Applicants' goods.

Held, allowing the application for registration:

- An applicant might proceed under Section 12(1) of the 1985 Trade Marks Act on one of two grounds, namely, that there had been at least two years of bona fide use of the mark in Singapore or that the same mark had been correspondingly registered in Part B of the UK Register.
- Kerly's Law of Trade Marks & Trade Names, 12th edition; Smith Hayden & Co's Application (1946) RPC 97; Bali Trade Mark (1969) RPC 472; Edward Hack for the Registration of a Mark (1941) 58 RPC 91 referred to.
- Section 12 (2) of the 1985 Act sets out the 4 factors the Registrar would have to consider:
 - Whether the registration is inconsistent with Section 15 (ie whether it is likely to deceive or cause confusion)
 - Whether the registration is inconsistent with Section 23 (ie whether there is a conflicting prior registration)
 - Whether the mark has indeed been used 'as aforesaid' in Singapore for two years
 - Whether the mark is capable of distinguishing the applicants' goods or services
- However, if the application is proceeding (as in the present case) on a UK precedent, it is not necessary to lodge evidence of two years' prior use. To hold otherwise would render the second ground in Section 12 (1) otiose. In the present case, the only outstanding issue was whether the mark was capable of distinguishing the Applicants' goods.
- The mere fact that there was a corresponding UK Part B registration or that there was more than 2 years' use does not imply that the mark was automatically capable of distinguishing. There were marks that were totally devoid of distinctiveness as to be incapable of becoming distinctive. Examples of marks like "Good", "Best", "Excellent", "Perfect" and the like. Such marks could not qualify as being "capable of distinguishing" even if there was very substantial use and similarly, even if the United Kingdom Registry for whatever reason, had accepted the mark in Part B.
- "Smacks" did not fall into this genre of marks that were totally devoid of distinctiveness and was prima facie capable of distinguishing the Applicants' goods.
- The Court of Appeal in Civil Appeal No. 101 of 1998 was deciding on the registrability of "SMACKS" for Part A and not Part B (which the Court recognised as requiring a lower standard).
- In opposition proceedings, the burden of proof was on the applicant for registration. In rectification proceedings, the burden of proof was on the applicant for rectification. This would be the case even if the mark was registered in Part B of the Register.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1985 Revised edition), Section 12

Cases referred to:

- Frank James David (trading as The Ustikon Company) and anor. v The Sussex Rubber Co. Ltd 1927 44 RPC 412
- Verve's Records Inc.'s Application to Register a Trade Mark 1958 RPC 3
- Tiffany's case Civil Appeal No. 317 of 1998
- Smax case Civil Appeal No. 101 of 1998

Representation:

- P. Sivakumar (M/s Ella Cheong & G. Mirandah) for the Applicants
- Jo-Ann See (M/s Allen & Gledhill) for the Opponents