

**In The Matter Of Application No. 5627/94
By Soldan Holding + Bonbonspezialitaeten GmbH
To Register A Trade Mark An Class 30**

And

**In The Matter Of Opposition Thereto
By Ferrero S.P.A.**

*Before Assistant Registrar Chua Ser Ching
23 May 2001*

Trade Mark - Application for registration - Opposition - Preliminary objection on the pleadings - Opponent's marks is contained in applicant's mark - Essential feature of a mark - Secondary marks - Ability of descriptive words to act as distinctive trade marks.

The Applicant applied for the registration of a trade mark which consists of the words "Kinder eukal", and a device of a boy in respect of "chocolates, candy, bread, pastry and confectionery" in Class 30. The Opponent is the registered proprietor of the word "KINDER" in Class 30 in respect of similar goods. The Opponent has used its marks in Singapore since 1990. The Applicant was unable to show use of its marks in Singapore.

The Applicant's main argument is that the Opponent does not have the exclusive right to the word "Kinder" as it means "children" in German and is hence descriptive for the goods concerned. The German Patent Office had in fact dismissed the Opponent's opposition in corresponding proceedings. The Applicant also raised a preliminary objection to the Opponent's reliance on Section 15 of the Trade Marks Act (Cap. 332, 1992 Revised Edition) as it was not clearly pleaded.

Held, allowing the opposition:

- The preliminary objection is overruled as the essential elements of Section 15 are pleaded in the Notice of Opposition. In any event, the Registrar has an overriding duty under Section 12(2) to consider all relevant provisions in the Act, whether they are pleaded or not.
- The word "Kinder" is the sole feature of the Opponent's mark. The use of said word by the Applicant in its mark is likely to cause people to think that the Applicant's goods originate from the Opponent. The public may perceive "eukal" and the device of a boy as the Opponent's secondary marks. The Applicant cannot defend its use of the word "Kinder" by disclaiming it.
- A descriptive word may act as a distinctive trade mark in a place where the populace is not conversant in the language concerned. Since German is not a commonly-spoken language in Singapore, the word "Kinder" can be distinctive, unlike in Germany.
- The Applicant is ordered to remove the word "Kinder" from its mark. The Opponent's reliance on Section 10 & 11 is misconceived since these two sections are not meant for determining whether a mark is distinctive in the light of another mark. Sections 15 & 23 are provided for that purpose.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Revised Edition), Sections 10, 11, 12, 15 and 23.

Cases referred to:

- Harrods Case (1935) 52 RPC 65
- Sime Darby Case (2000) 4 SLR 360
- The Carborundum Case (1909) 26 RPC 504
- Ardath Tobacco Case (1925) 42 RPC 50
- Coca-Cola Canada v Pepsi-Cola Canada (1942) 69 RPC 127
- R. Demuth (1948) 69 RPC 342

Representation:

- Mr Lim Teng Leong (M/s Donaldson & Burkinshaw) for the Applicant
- Ms Kemmy Chan (M/s Drew & Napier LLC) for the Opponent