

**In The Matter Of Application Nos. 11198/94, 6229/95 And 6230/95  
By Future Enterprises Pte Ltd  
To Register A Trade Mark In Class 30**

**And**

**In The Matter Of Opposition Thereto  
By Super Coffeemix Manufacturing Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar  
28, 29, 30 & 31 May 2002*

**Trade Mark Application** - Opposition - whether a disclaimer should be entered - meaning of matter that is common to the trade or otherwise non distinctive character - section 20, 15 and 12

The Applicants are Future Enterprises Pte Ltd, who applied for 3 trade marks which comprised the words "MACCOFFEE", "MACNOODLE" and "MACTEA" together with a device of an eagle in each mark, for goods in class 30 namely, instant coffee mix, instant noodles and instant tea mix, respectively. Their applications were accepted for registration and advertised. The Opponents are Super Coffeemix Manufacturing Ltd. The opposition under section 20 is on the grounds that a disclaimer should be entered over the eagle device in each mark. Many traders use or have used eagle devices in their trade marks for goods like coffee, tea and noodles in class 30 before the applicants applied for their trade marks. The Applicants' case was that although many traders use or have used eagle devices on class 30 goods, whether eagle devices are common to the trade should be narrowly defined to mean only trade in instant coffee mix, instant noodles and instant tea mix. The Opponents argued that eagle devices were common to the trade as trade meant trade in coffee, tea and noodles in class 30.

**Held, allowing the marks to proceed to registration with a disclaimer of a device of an eagle:**

- Whether the device of an eagle is common to the trade, means common to the trade of coffee and tea on one hand and noodles on the other hand. At least 5 traders have used marks which comprised the eagle device for coffee and tea. It is a popular choice for coffee and tea products since 1940. It does not matter that some of the marks which contained the eagle device have since expired. There are at least 3 traders who have used or use the eagle device for noodles and vermicelli. Therefore the eagle device is common to the trade of coffee and tea, and noodles and should be disclaimed in all 3 marks and the opposition under section 20 is successful.
- The Opponents submitted that the applicants have made groundless threats that they would sue those who use eagle devices and that the Registrar should consider that as a ground under section 15 of the Trade Marks Act (Cap 332 1992 Ed). The opposition on this ground fails as this is not a ground that the Registrar may take into account under the 1992 Trade Marks Act.
- The Opponents argued that the applicants had no bona fide intention to use the mark as the mark applied for was different from the mark used. The differences pointed out by the Opponents between the mark applied for and the mark in use, are not substantial differences. Therefore the opposition under section 12 also fails.

**Provisions of legislation discussed:**

- Trade Marks Act (Cap 332, 1992 revised Ed) sections 20, 15 and 12

**Cases referred to:**

- Future Enterprises v Tong Seng Produce Pte Ltd [1998] 1 SLR 1012
- In re Albert Baker & Co's Application [1908] 2 Ch 86
- In re Cadbury Brothers Application [1915] 2 Ch 307
- Burland v Broxburn Oil Company [1889] 42 Ch D 274
- In re Apollinaris Company's Trade Marks [1891] 2 Ch 186
- In the Matter of the Registered Trade Marks of Bass Ratcliff & Gretton, Ld [1902] 19 RPC 529
- Univelver PLC's TM [1984] RPC 155
- J Wigfull & Sons Ltd v J Jackson & Son Ltd [1916] 1 Ch 213
- In re Bagots, Hutton & Co's TM 33 RPC 357

- Anglo Swiss Condensed Milk Coy's TM 20 RPC 509
- Great Tower Street Tea Coy v Smith [1889] 6 RPC 165
- Hennessy & Coy v Dompe [1902] 19 RPC 333
- Louise & Coy Ld v Gainsborough [1903] 20 RPC 61
- Rugby Portland Cement Coy Ld & The Rugby & Newbold Portland Cement Coy Ld [1891] 8 RPC 241
- Barlow & Jones v J Johnson & Coy [1890] 7 RPC 395
- Meeus' Application [1891] 8 RPC 25
- Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd (1952) 86 CLR 536
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd & Anor [2000] 3 SLR 145
- Jellinek's application (1946) 63 RPC 59
- Nerit [1982] FSR 72 & [1980] FSR 146
- Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd [1994] AIPR 1
- Ng Chye Mong [1988] 2 MLJ 150
- Re Arnold Palmer [1987] 2 MLJ 691

**Representation:**

- Ms Low Pei Lin and Esther Fong (Allen & Gledhill) for the Applicants
- Mr Daniel Lim (Shooklin & Bok) for the Opponents