

**In Trade Mark Application No. 12030/97
By P.T. Super World Wide Foodstuff Industries**

And

**Opposition
By Hiang Kie Pte Ltd,**

**Assigned To
Coffee Club Private Limited**

*Before Principal Assistant Registrar Anne Loo
17 April 2003*

Trade Mark Application - Opposition - Whether Applicant's mark is identical to the Opponents' mark - Whether use of the Applicants' mark is likely to deceive or confuse members of the public - Whether the Applicants' mark is distinctive and capable of distinguishing the Applicants' goods from the Opponents' goods - Whether the Applicants' choice of the mark is in good faith - Section 10, 12, 15 and 23 of the Trade Marks Act (Cap. 332 1999 Ed)

The Applicants are P.T. Super World Wide Foodstuff Industries who filed a trade mark application for "Coffee Club" and device in Class 30 on 30 September 1997. The trade mark was accepted and advertised on 27 October 2000. The Opponents Hiang Kie Pte Ltd lodged a Notice of Opposition on 23 December 2000. The Opponents are the registered proprietors or the applicants of several trade marks with the words "Coffee Club" and device in classes 30, 40 and 42, and they and their wholly owned subsidiary Coffee Club Pte Ltd had used their trade marks extensively in Singapore. The Opponents had assigned their trade marks to Coffee Club Pte Ltd in 2001. The Opponents argued that given the Opponents' tremendous amount of reputation and goodwill in the "Coffee Club" marks, the Applicants' mark if allowed registration will cause the public to be deceived or confused as to the origin of the goods bearing the Applicants' mark. The Applicants pointed out that one of the Opponents' marks have the word "Coffee Club" fully disclaimed, therefore other traders are free to use these words. The Opponents argued that their recent marks have been accepted for registration with separate disclaimers of the words "Coffee" and "Club" therefore the distinctive combination of the words "Coffee Club" is protected.

Held, disallowing the application:

- Disclaimers over words in a trade mark do not follow the mark into the market. Consumers purchasing the goods will not be any wiser whether the words used on the mark are not meant to be monopolised by a single trader or whether by virtue of a separate disclaimer, the trader has rights over the distinctive combination of the words. Hence the question whether the Applicants' and the Opponents' marks are confusingly similar such that a likelihood of confusion or deception arises will have to be determined regardless of the disclaimers imposed on the Opponents' marks.
- Section 15 - The Applicants' and the Opponents' marks have a common distinguishing element - the words "Coffee Club". This is the feature which first catches the eye and the attention of the consumer, who in this case is the average Singaporean with an ordinary memory who will undoubtedly remember the marks by the words "Coffee Club" and not by the other elements. Having considered all the evidence, the Registrar concluded that the Applicants' and the Opponents' marks are very similar and there is a very real and tangible risk that there will be confusion if the Applicants' mark is allowed to proceed to registration. The opposition under section 15 is therefore successful.
- Section 23 - The Applicants' goods include "confectionery, bon bon being sweets, toffee, chocolate confectionery, all included in Class 30" but not including coffee, unroasted coffee and coffee confectionery. The Opponents have registrations in Class 30 but for "Coffee and unroasted coffee". They also provide services for coffee grinding (Class 40) but are better known to the Singaporean public as operators of coffee shops. The Applicants' argument is that the Opponents are not known as manufacturers of sweets but as a provider of coffee shop services. However, applying the principles in Jellinek's case, the Applicants' goods and the food items sold in the Opponents' coffee shop outlets are goods of the same description, and would be likely to cause confusion or deception among the public. Therefore the opposition under section 23 succeeded.

- Section 10 - The Opponents argued that the Applicants' mark had been advertised before acceptance, which serves to indicate to the Registrar was not satisfied that the Applicants' mark was able to overcome the similarities of the cited marks, which included the Opponents' marks. Section 10 sets out the criteria for the registrability of a mark. There is nothing within the section that states that if a mark is advertised before acceptance, it will not be registrable under the Act. As long as the Applicants' mark satisfies the provisions of section 10 it qualifies for registration under the section. Therefore the opposition under section 10 failed.
- Section 12 - No evidence was shown that the Applicants' choice of the word "Coffee Club" for their mark was not in good faith. The Opponents argued that the Applicants sought to take advantage of the Opponents' reputation in the Opponents' "Coffee Club" marks. An allegation of bad faith is a serious allegation to make and must always be subject to strict proof. Therefore the opposition under section 12 failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332, 1992 Revised Ed) sections 10, 12, 15 and 23.

Cases referred to:

- Jellinek's Application [1946] 63 RPC 59
- Pianotist Co. Application [1906] 23 RPC 774
- Polo/Lauren LP v United States Polo Association & Anor [2002] 1 SLR 326
- Re Jaguar [1993] 2 SLR 466
- Kellogg Co. v Pacific Food Products Sdn Bhd (1999) 2 SLR 651
- Smith Hayden & Co's Application (1945) 63 RPC 97
- Diamond T. (1921) 38 RPC 373
- De Cordova v Vick (1951) 68 RPC 103
- Bali Trade Mark (1969) RPC 472

Representation:

- Mr Leslie Tham (Khattar Wong) for the Opponents
- Mr Mohan Das (Haq & Selvam) for the Applicants