

**In The Matter Of A Trade Mark Application No. 13086/99
By Newmans Chocolates Ltd**

And

**Objection By
Societe Des Produits Nestle SA**

*Before Principal Assistant Registrar P Arul Selvamalar
20 December 2002*

Trade Mark Application - Opposition - whether mark is devoid of any distinctive character - whether there is a likelihood of confusion - passing off - section 7 & 8 Trade Marks Act (Cap 332, 1999 Ed)

Procedure - Failure to plead specific written law or rule of law in notice of Opposition - section 7(5) Trade Marks Act (Cap 332, 1999 Ed)

Facts

The Applicants are Newmans Chocolates Ltd, who applied for registration of a trade mark "MILKBEARS" in class 30 for "candy, chocolate, chocolate candies and pastries". The Opponents are Societe des Produits Nestle SA, who applied for the trade mark "MILKY BAR" in two classes, "white chocolate and white chocolate like confectionery, ice cream and ice cream preserves" in class 30 and "milk, yoghurt and dairy products, milk based beverages and milk jellies" in class 29. Their application in class 30 was registered on 8 Aug 2002 while their application in class 29 was still pending on the date the opposition was heard. The Opponents relied on sections 7(1)(b), 7(4), 8(2) and 8(4) in their opposition.

Held, allowing the mark to proceed to registration,

- The word "MILKBEARS" may serve as a badge of origin of the Applicant's goods and is incapable of fair and honest application to the goods of anyone else, as stated in the Dualit's case. It may not be a totally meaningless word, which is inappropriate for the goods concerned as stated in the case of British Sugar. However, it is not like the word "TREAT" which cannot do the job of distinguishing without first educating the public that it is a trade mark. The mark, looked as a whole is a fanciful name. Thus the opposition under section 7(1)(b) failed.
- A consideration of whether a mark is against public policy or deceptive under section 7(4) of the Act is limited to a consideration of the mark itself. If the mark "MILKBEARS" is registered, other traders would not be prevented from using bear shapes on chocolate or candy. This ground may be considered if the Applicants use the mark on candy that did not contain milk and/or if the candy was not in the shape of a bear. At present, there is no evidence that the Applicants are going to use it on candy that does not contain milk and/or that are not shaped as bears. Thus the opposition under section 7(4) is not made out.
- Visually, aurally and conceptually, there are sufficient differences between the marks and the likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case. One relevant factor is that "MILK" which is the prefix in both marks, is commonly used in the market for chocolates. Having considered that the Opponent's mark MILKY BAR contains a descriptive element which is common in the relevant market, the other elements are sufficient to distinguish the Applicant's mark from the Opponent's mark. Thus the opposition on the ground of section 8(2) is not made out.
- Section 8(4) prevents registration of marks whose use is prevented by a rule of law protecting unregistered marks. By the time the opposition was heard, the opponent's mark in Class 30 was registered, therefore section 8(4) did not apply to that mark. The Opponent's application in class 29 was unregistered. However, the evidence filed by the Opponents did not show any use of the mark MILKY BAR on goods in class 29. Thus the Opponents did not have any goodwill in the business of selling those goods under the MILKY BAR mark. As such, the law of passing off did not protect the Opponent's mark in relation to the business of selling goods in class 29. The opposition under section 8(4) therefore failed.

Legislation referred to:

- Trade Marks Act (Cap 332,1999 Ed) sections 7(1)(a), (b), (c), 7(4), 7(5), 7(6), 8(1), 8(2), 8(3) and 8(4)

Cases referred to:

- Dualit Ltd's Trade Marks Application [1999] RPC 890
- Joseph Enterprises Inc and Opposition by Sandholzer International GmbH (UK Patent Office)
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- In an Application by Soldan Holdings + Bonbonspezialitaeten GmbH and opposition by Ferrero S.p.a.
- Jardex [1946] RPC 63
- "A" (SRIS/0/081/99) (UK Patent Office)
- "Jo's the Boss" (SRIS/0/170/99) (UK Patent Office)
- " R v IDG Communications Ltd's Trade Mark Application [2002] RPC 10
- Sabel BV v Puma AG [1998] RPC 199
- Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc [1999] RPC 117
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- Marca Mode CV v Adidas AG [2000] ETMR 723
- POLACLIP Trade Mark [1999] RPC 282
- LIFESYSTEMS Trade Mark [1999] RPC 851
- REACT Trade Mark [2000] RPC 285
- Harrods (1935) 52 RPC 65
- TRANSPAY Trade Mark [2001] RPC 10
- R v 10 Royal Berkshire Polo Club Trade Mark [2001] RPC 32
- Eleven Inc v Helshaw Food Products [2002] EWHC 1685
- Erwen Warnink BV v Townend & Sons (Hull) Ltd [1979] AC 731
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Mechanical Handling Engineers Pte Ltd v Material Handling Engineering Ltd (1993) 2 SLR 205
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd & Anor [2000] 3 SLR 145
- Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (t/a ONE.99 SHOP) [2000] 2 SLR 766
- Office Cleaning Services v Westminster Office Cleaning Services Assn [1946] 1 All ER
- CDL Hotels International v Pontiac Marina [1998] 2 SLR 550
- McCain International Ltd v Country Fair Foods Ltd [1981] RPC 69
- Horlicks Malted Milk Co v Summerskill [1916] 33 RPC 108
- Office Cleaning Services Ltd v Westminster Window & General Cleaners Ltd [1946] 63 RPC 39

Representation:

- Ms Yvonne Tang and Ms Misra (Drew & Napier) for the Applicants
- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents