

**In The Matter Of A Trade Mark Application
Nos. 6229/95, 6230/95 & 6231/95
By Future Enterprises Pte Ltd**

And

**Objection Thereto By
McDonald's Corporation**

*Before Principal Assistant Registrar P Arul Selvamalar
15, 16, 17 and 23 January 2003*

Trade Mark Application - Opposition - whether marks are confusingly similar - whether Opponents had a reputation in a family of marks - whether Applicants' use of prefix bona fide - rightful proprietorship - Trade Marks Act (Cap. 332, 1992 Ed.) sections 15, 23 and 12

Facts

In 1995, Future Enterprises Pte Ltd (the Applicants), applied for registration of 3 marks which contained the words MacNoodles, MacTea and MacChocolate below an eagle device and other devices for the following goods: instant noodles, instant tea mix and instant chocolate mix respectively, in class 30. The registration of these marks were opposed by the McDonald's Corporation on the grounds that the Applicants' use of "Mac" as a prefix in their marks was confusingly similar to their reputation in a family of marks which had the prefix Mc under sections 15 and 23. The Opponents also argued that the Applicants' use of the prefix Mac was not bona fide and that therefore the Applicants were not the rightful proprietors of the mark under section 12.

The Applicants, who were initially in the computer business, went into the instant beverage and food business in 1994. Their evidence was that in order to portray a sophisticated, western image, they chose the device of an American eagle and that as Apple Computer Inc's Macintosh computer was known as Mac, they chose Mac as a prefix for the words Noodles, Tea and Chocolate in their marks. In an earlier High Court case the Applicants had stated that they chose Mac as a prefix as they understood that it was a way of addressing people whose names were not known in the Western English speaking countries.

The Opponents had used Mc as a prefix and Mac as a suffix in the following marks, McNuggets, McChicken, Egg McMuffin, Sausage McMuffin, McPuzzle, McHappy, Big Mac and SuperMAC ice cream before 1995. After 1995, the Opponents had used McPepper Burger, McTowkay Burger, Chicken McCrispy, McSpicy Double, McFlurry, McSalmon Burger and Chicken McSphagetti. The Opponents also had numerous trade mark registrations in classes 3, 14, 16, 25, 28, 29, 30, 31, 32 and 42 for various marks which included: the word McDonalds, the device of the golden arches which formed the letter M, their corporate logo which had the word McDonalds superimposed on the golden arches, the words Ronald McDonald, a device of a clown, Big Mac, Egg McMuffin, Mac Fries, McChicken, McRib, McNuggets, McDonald's Chicken L T, McBurger, Mac Tonight, McPizza, McKids, Mc D.L.T., McDonald's McLean Deluxe, McDonalds in Chinese characters, McDonaldland, McFreeze, McDonald's Express, McMarker, McDonald's Quarter Pounder, McCola, SUPERMAC, McWorld and globe device, McBaby device and Mc. Their case was that whenever the prefix Mc or Mac is used in relation to a food product, it would cause confusion or deception that the food product may originate from the Opponents.

Held, allowing the marks to proceed to registration,

- The issue in this case is not whether the Opponents had a reputation in the mark McDonalds and how extensive that reputation is. The issue is whether their reputation in a family of marks with the prefix Mc plus a descriptive word in relation to food, is so extensive that, confusion and deception would result if the Applicants' marks MacNoodle, MacTea and MacChocolate were registered for instant noodles, tea mixes and chocolate mixes.
- The Opponents have a reputation in a family of marks with the prefix Mc plus a descriptive word in relation to food, in the business of selling fast food from their restaurants as they have used the marks McChicken, McNuggets and McMuffin extensively in Singapore before 1995. Taking in account the Opponents' reputation in a family of marks, the Registrar must compare the Opponents' family of marks with the Applicants' marks MacTea, MacNoodle and MacChocolate plus an eagle device, and consider whether confusion or deception is likely if the Applicants' marks are registered. The device of an eagle is more prominent than the word

MacNoodle, MacTea and MacChocolate in the Applicants' marks. The total impression created by the Applicants' marks is that they are different from the Opponents' family of marks with the prefix Mc plus a descriptive word in relation to food.

- With respect to the goods and services, the Registrar took into account that the Opponents' reputation in their family of marks with the prefix Mc plus a descriptive word in relation to food, which was found to reside in the restaurant business in class 42, could extend to the business of selling food in its unprepared form in class 30, ie, the same class as the Applicants' marks. The Registrar took into account that those in the restaurant business like Delifrance, do extend their business into selling food in its unprepared form. For example, Delifrance sells bread in a frozen form from supermarkets. However the evidence of use of the Opponents' family of marks did not show use on foods in its unprepared form, even up to the date of hearing of the opposition. Therefore the Opponents reputation in their family of marks did not extend to the business of selling food in its unprepared form. Therefore there would be no confusion or deception if the Applicants' marks are registered under section 15.
- Under section 23, all of the Opponents registered marks when compared individually with the Applicants' marks, were different from the Applicants' marks. However the Opponents argued that their reputation in a family of marks should also be considered under section 23. It had been found that they had a reputation in a family of marks with the prefix Mc plus a descriptive word in relation to food. However this reputation extended only to the restaurant business in class 42. Therefore even if the concept of a family of marks was considered under section 23, as the Opponents reputation resided in class 42, the opposition under section 23 failed.
- Under Section 12, there were 2 explanations by the Applicants for their choice of the prefix Mac but both were not so contradictory that the finding must be that they were lying. However the explanation did not convince the Registrar of the reason why the prefix Mac was chosen. However the absence of any convincing explanation for the choice of the prefix Mac and the dissimilarity of the marks form insufficient evidence to infer that the applicant had copied the marks from the opponents. The opposition under section 12 failed.

Legislation referred to:

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

Cases referred to:

- American Home Products v Knoll Aktiengesellschaft [2002] EWHC 282
- Australian Wollen Mills v Walton (1937) 58 CLR 641
- Bali TM [1969] RPC 472
- Beck, Koller (1947) 64 RPC 76
- Brown Shoe Co Inc's Application [1959] RPC 29
- Cooper Engineering Company Proprietary Limited v Sigmund Pumps Limited (1952) 86 CLR 536
- Flowstacka TM (1968) RPC 66
- Future Enterprises v Tong Seng Food Products [1998] 1 SLR 1012
- Golden Crumpet Co Australasia v Hardings Manufactures Pte Ltd (1987) 8 IPR 147
- Harrods (1935) 52 RPC 65
- Harrods v Harrodian School Ltd [1996] RPC 697
- Jellinek (1946) 63 RPC 59
- Pianotist (1906) 23 RPC 777
- Re Application by Soldan Holding + Bonbonspezialitaeten Gmbh Semigras [1979] RPC330
- Smith Hayden & Co's Application (1946) RPC 97
- South Beach Café [OHIM dec. 534/1999]
- Swiss Miss TM [1997] RPC 219
- Tiffany & Co. v Fabriques de TabacReunies SA (1999) 3 SLR 147
- Turbogaz [1978] RPC 206
- UNIMAX TM [1979] RPC 469
- Wagamama v City Centre Resturants PLC [1995] FSR 713
- Yuen v McDonald's Corporation 2001 WL 1422899

Representation:

- Mr Tan Tee Jim (SC), Ms Low Pei Lin and Ms Clara Kwan (Allen & Gledhill) for the Applicants
- Mr Dedar Singh Gill, Mr Paul Teo, Mr Cheah Yew Khin and Ms Anita Misra (Drew & Napier) for the Opponents

NB: The appeals to the High Court and to the Court of Appeal were dismissed.