

**In The Matter Of A Trade Mark Application By
Delight Express Limited**

And

**Opposition Thereto By
In-Comix Food Industries Sdn Bhd**

*Before Principal Assistant Registrar Ms. P Arul Selvamalar
19 August 2004*

Trade Marks – Opposition to registration – Distinctiveness of the mark – whether the Application mark satisfies the definition of a trade mark under section 2(1) and the requirements under Section 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the use of the Application mark in Singapore is prohibited by any law(s) - Section 7(5) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant’s application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected - Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4)a of the Trade Marks Act 1998 [Cap. 332]

The Applicants are a company incorporated in British Virgin Islands which applied for the registration of a trade mark ‘Eagle Express’ on 30 November 2001 for “Coffee; tea; cocoa; beverages made from coffee, tea, cocoa or chocolate; beverages containing coffee, tea, cocoa or chocolate; coffee, tea, cocoa or chocolate based preparations for making beverages; ice beverages with a coffee, tea, cocoa or chocolate base; coffee, tea, cocoa or chocolate based beverages; flavoured tea” in Class 30. The Opponents are a Malaysian Company also engaged in the trade of coffee products. They have filed a subsequent trade mark application to register the mark ‘Eagle Express’ on 20 June 2002 in class 30 for coffee products.

The Opponents pleaded sections 7(1)(a), 7(5), 7(6), 8(2)(b), 8(3) and 8(4)(a) of the Trade Marks Act 1998 [Cap. 332] in their Notice of Opposition. They also argued sections 8(1) and 8(2)a at the hearing but these sections were not considered as they were not pleaded in the Notice of Opposition. They contended that the Applicant’s mark “Eagle Express” should not be registered as it is incapable of distinguishing its goods and that it does not satisfy the definition of a trade mark in section 2(1) of the Act. The Opponents also submitted that the Application Mark infringes the copyright enjoyed by them, and the use of the Application Mark would constitute passing off.

The Opponents further contended that the Applicant had applied to register its mark in bad faith. The Opponents also contended that the Application Mark and the Opponents’ mark are similar, and that the goods sought to be protected are also similar; hence there exists a likelihood of confusion.

Held, dismissing the Opposition

1. The opposition under section 7(1) fails. The question of distinctiveness under section 7 is to be determined by reference to mark under consideration only and not by comparing the mark with other marks. The Application Mark was found to be distinctive. It is also not a requirement that the trade mark must be used before the date of application; a bona fide intention to use the mark will suffice.
2. The opposition under section 7(5) and section 8(4) fails. The combination of the words ‘Eagle’ and ‘Express’ in a common typeface is neither an original literary or artistic work. Further, the manner of expression of the Application Mark is different from that of the Opponents’ mark and the Opponents have not proved that the Applicants have copied their expression under copyright law. There is also insufficient evidence to support the Opponents’ claim to have a reputation or goodwill in their ‘Eagle Express’ trade mark in Singapore under passing off law.

3. The opposition under section 7(6) fails. The Opponents have not discharged their burden of proving that the Applicants' application to register the Application Mark was made in bad faith. The Applicants' explanation that the Application Mark is derived from the marks 'GOLDEN EAGLE' and 'EXPRESS CAFÉ' of their associate company, MBI, is credible.
4. The opposition under section 8(2)(b) fails as there is insufficient evidence to establish that the Opponents mark was a well known mark in Singapore before the date of application.
5. Section 8(3) was not available to the Opponents as a ground of opposition as the goods under the Application Mark are identical or similar to the goods under the Opponents' mark.

Provisions of legislation discussed

- Trade Marks Act 1998 [Cap. 332], Sections 7(1), 7(5), 7(6), 8(2)(b), 8(3) and 8(4)(a).

Cases referred to:

- Lloyd Schuhfabrik Meyer & Co. Gmbh v Klijsen Handel BV [2000] FSR 77
- Re AUVI Trademark [1992] 1 SLR 639
- CDL Hotels International Ltd v Pontiac Marina Pte Lte [1998] 2 SLR 550
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC367
- Bravado Merchandising Services Ltd v Mainstream Publishing (EDINBURGH) Ltd [996] SLT 567
- Gananth Wilmalal Ediriwira v The Baywatch Production Company (unreported)
- Newmans Chocolates Ltd's Application (unreported)
- Beautimatic v Mitchell Pharmaceuticals [2000] FSR 267
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117
- Balmoral Trade Mark [1999] RPC 297
- The Coffee Club TM (Trade Mark Application No 12030/97)(unreported)
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- An application by Soldan Holding + Bonbonspezialitaeten Gmbh and Opposition by Ferrero S.p.a. (unreported)
- Roland Corporation & Anor v Lorenzo & Sons Pty Ltd [1991] 22 IPR 245
- Exxon Corporation & Others v Exxon Insurance Consultation International Ltd [1982] RPC 69
- Jo's the Boss (SRIS 0/170/99/0)
- Royal Enfield TM [2002] RPC 24
- "A" (SRIS 0/081/99)
- Eleven Inc v Helshaw Food Products Ltd [2002] EWHC 1685
- Reckitt & Colman Products Ltd v Borden Inc & Others [1990] 1 All ER 873
- Future Enterprises Ptd Ltd v Tong Seng Produce Pte Ltd [1998] 1 SLR 1012
- Burberry Ltd v J Cording & Co Ltd (1909) 26 RPC 701
- MacDonald's Corporation v Future Enterprises Pte Ltd [2004] SGCA 50

Representation:

- Ms Lim Siau Wen (Drew & Napier LLC) for the Applicants
- Mr Boey Swee Siang (M/s Yu Sarn Audrey & Partners) for the Opponents

The appeal to the High Court was dismissed.