

**In The Matter Of An Application By
Societe Des Produits Nestle S.A.
To Register A Trade Mark**

And

**Opposition Thereto By
International Nutrition Co. Ltd. A/S**

*Before Principal Assistant Registrar Ms Anne Loo
24 August 2005*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the definition of a trade mark under section 2(1) and the requirements under Section 7(1)(a), (b), (c) and (d)) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

Trade Marks – Opposition to registration – evidence of use proviso – whether evidence sufficient to show mark acquired distinctiveness through use - Sections 7(2) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

The Applicants, SOCIETE DES PRODUITS NESTLE S.A. of Vevey, Switzerland, filed trade mark application T02/11536E for the mark “GOLD” in Class 30 in respect of “Cereals and cereal preparations; ready-to-eat cereals; breakfast cereals; cereal bars; foodstuffs having a base of rice or of flour” on the 31 July 2002 (“the Mark”). The Mark was accepted and advertised on the 25 April 2003 in the Trade Marks Journal. The Opponents, INTERNATIONAL NUTRITION CO. LTD. A/S of Uplandsglade 38, 2300 Copenhagen S, Denmark, opposed the Mark on the basis that

- a) it does not fall within the definition of a trade mark under Section 7(1)(a) of the Trade Marks Act (Cap 332, 1999 Rev. Ed.) (hereinafter, “the Act”) as it is a common laudatory term;
- b) it is devoid of distinctive character and is contrary to and Section 7(1)(b) and/or 7(1)(c) of the Act as it is likely to be perceived as a suggestion that the product has certain positive qualities or characteristics, irrespective of the pre-filing use; and
- c) the Applicants’ Mark consists exclusively of the word “GOLD” which is a common or generic term in the trade and registration would be contrary to Section 7(1)(d) of the Act.

The Opponents themselves own the brands of infant formulas containing permutations of the words, “Mamex” and “GOLD”, with other words. The goods are associated goods with cereals and foodstuffs having a base of rice or flour and these brands use the mark or have the word “GOLD” represented in their packaging.

Held, disallowing the registration,

1. The plea under Section 7(1)(a) succeeds. The word “GOLD” is incapable of distinguishing the Applicants’ goods as it is a commonly used laudatory word applied by many other traders. This is evidenced by the exhibits of other traders’ goods in the same class of food products, where the word “gold” is used descriptively on those goods. Hence, it can be concluded that the mark “GOLD” is not incapable of being applied to goods of other traders who trade in a similar line of goods as the Applicants.
2. The plea under Section 7(1)(b) succeeds. The word “GOLD” is a mark which is devoid of distinctive character under section 7(1)(b). The test in *British Sugar* was applied and one would ask whether the word “GOLD” is the sort of word which cannot do the job of distinguishing without first educating the public that it is a trade mark. To answer this, it is important to look at the plain meaning of the word “GOLD” which is defined to mean “something brilliant, beautiful, precious, excellent, of great value or valued as the finest of its kind”. The evidence shows that the word “gold” is always used in a descriptive manner on packaging and in advertisements; indicating either a premium quality or a standard of excellence; or describing the colour of the product. It is also clear that “GOLD” is used descriptively on the Applicants’ goods which are “honey gold flakes” or “honey gold cornflakes”. The word “GOLD” is used to describe the colour of the cereals which are honey-coated and made of corn for honey and cornflakes are both yellow-hued. The colour gold is often used to describe goods which are yellow in colour. The word “GOLD” is a powerful colour descriptor for it immediately draws attention and conjures up imagery of something bright, something of quality and value. Used in this descriptive manner on honey and cornflakes, it clearly raises the expectations of a purchaser reading the packaging, compared to a situation where the

wording states that “the honey and cornflakes are yellow in colour”. The wording on back of one of the packaging reads: “THE GOLD STANDARD of taste and nutrition” (as a heading) and then goes on to state that “Nestle Honey Gold is “the gold standard” of taste and nutrition”. It is significant that the Applicants themselves refer to their mark as “Nestle Honey Gold” and not “GOLD”. Further, the Applicants use the word “gold” in a laudatory fashion in the heading “THE GOLD STANDARD” and tout their goods as being the “gold standard”. When one reads through the body of the text, it is very likely that he will draw the conclusion that the Applicants are holding out their cereals as the “model or yardstick of excellence” in respect of taste and nutrition. It is also clear from the evidence that the word, “GOLD” is always used by the Applicants together with their primary mark “NESTLE”. The word “GOLD” has also always been used as part of descriptive phrases such as “Honey Gold Flakes” or “Honey Gold Cornflakes”. It would be quite a stretch to conclude that the word “GOLD” is the Applicants’ secondary trade mark (since it is always used in conjunction with their primary mark “Nestle”) because the brochures and advertisements lodged by the Applicants all show that the word, “GOLD” has never been used on its own as a trade mark. It is also telling that on the Applicants’ packaging, the Applicants themselves do not refer to their mark as “GOLD”, rather “Nestle Honey GOLD”. It is therefore not possible to conclude that the public or the average consumer has come to regard the mark comprising, “GOLD” on its own as the Applicants’ trade mark as at the relevant date. “GOLD” is unable to perform the role as a trade mark for the average consumer viewing a mark like this will know that the word “gold” is meant to refer to goods of exceptional quality. The word “GOLD” cannot do the job of distinguishing without first educating the public that it is a trade mark and is therefore devoid of distinctive character.

3. The Applicants have not been able to show that the mark as at the date of application has acquired a distinctive character by virtue of use, and hence section 7(1)(b) read with section 7(2) of the Act would apply to bar the registration absolutely. The evidence lodged in the Applicants’ statutory declaration does not present any Singapore dollars figures of annual sales of the goods of the application bearing the mark “GOLD” or of advertisements or promotions for the goods under the Mark. The evidence points out that the word “gold” is used generically by the Applicants as well as by other traders, either to denote that their goods are of premium quality or to refer to the colour of their products. The word “gold” therefore is a word that no one particular trader should claim monopoly over.
4. The plea under section 7(1)(c) succeeds and this section read with Section 7(2) applies to bar the registration absolutely. In respect of the ground of opposition under section 7(1)(c), the finding in section 7(1)(b) has bearing. Since it was found that the word “GOLD” is a descriptive and laudatory word commonly used to allude to premium quality and to describe the characteristic of the goods in a laudatory manner, the Applicants in choosing “GOLD” exclusively as a trade mark are caught by section 7(1)(c) of the Act as the subsection makes reference to “signs which may serve, in trade, to designate the kind, quality, ... intended purpose, value, ... or other characteristics of goods.” It has also been decided that the mark has not acquired a distinctive character so as to be able to overcome the absolute ground of refusal under section 7(1)(c).
5. The plea under section 7(1)(d) fails. Although the Opponents have succeeded under the section 7(1)(c) where it is held that “GOLD” is a laudatory word commonly used to designate the quality or other characteristics of the goods such as cereals, it does not automatically follow that the word is one which is “customary in the current language or in the bona fide and established practices of the trade”. The word “gold” is not one which is “customary in the current language of the trade” in light of the submissions presented.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) 7(1)(a), (b), (c) and (d), 7(2)

Cases referred to:

- Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC
- Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehor Walter Huber and Franz Attenberger [1999] ECR I-2779 ‘DOUBLEMINT’ Case C-191/01P
- August Storck Kg [2003] 57 I.P.R.
- BONUS GOLD TRADE MARK [1998] RPC
- Syngenta Participations AG v Homcare Service AB (TM No. 2325142) UK TMR
- J.H. Munro Ltd v Neaman Fur Co [1947] 1 D.L.R. 868
- PROFITMAKER TRADE MARK [1994] RPC 613.
- Merz & Krell GmbH & Co [2001] ECR I-
- P.R.E.P.A.R.E Trade Mark [1997] RPC 884

- BONUS GOLD TRADE MARK [1998] RPC 859
- Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd [2000] SGHC 145

Representation

- Mr Dedar Singh (M/s Drew & Napier) for the Opponents
- Mr Lim Teng Leong (M/s Donaldson & Burkinshaw) for the Applicants