

**In The Matter Of A Trade Mark Application No. T03/04985D By  
Future Enterprises Pte Ltd**

**And**

**Opposition Thereto By  
McDonald's Corporation**

*Before Principal Assistant Registrar P Arul Selvamalar  
26 August 2005*

**Trade Marks** – Opposition to registration – Likelihood of confusion - whether the application mark is identical with or 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 (Cap. 332, 1998 Rev. Ed.)

**Trade Marks** – Opposition to registration – whether the application mark is identical with or similar to an earlier trade mark and is to be registered for goods or services which are dissimilar to those for which the earlier trade mark is protected - Section 8(3) of the Trade Marks Act (Cap. 332, 1998 Rev. Ed.)

**Trade Marks** – Opposition to registration – whether the Applicants' use of mark would constitute passing off - Section 8(4)a of the Trade Marks Act (Cap. 332, 1998 Rev. Ed.)

**Trade Marks** – Opposition to registration – whether the application is made in bad faith - Section 7(6) of the Trade Marks Act (Cap. 332, 1998 Rev. Ed.)

On 10 April 2003, Future Enterprises Pte Ltd (the Applicants) applied for registration of a mark MacCoffee for the goods “Coffee; tea; cocoa; coffee based beverages; artificial coffee; cappuccino; cereal preparations (including instant cereal in powder form), ice-cream, prepared meals, confectionery, namely candies, sweets, lollipops, liquorice, lozenges, pastilles; cakes, bread, biscuits, jellies (confectionery) and puddings; pastries; snack foods products made from processed flour preparations and potato flour; cookies; snack food products made from corn; snack bars containing dried fruits and nuts (confectionery); cereal-based food bars; rice crackers; muesli bars; wafers” in class 30.

McDonald's Corporation (the Opponents), filed an opposition to the registration of the application mark. They argued that the application mark was confusingly similar to their family of Mc/Mac marks under section 8(2)b and that their family of Mc/Mac marks have become well known and that the application mark which is similar would offend section 8(3) of the Trade Marks Act 1998. They also argued that the registration of the application mark would be contrary to the law of passing off under section 8(4)a and that the application was made in bad faith and it is therefore objectionable under section 7(6) of the Act.

The Opponents started the business of selling hamburgers in the USA in 1960 and by 2003 they operated more than 30,000 restaurants in 119 countries. Their annual sales in the year 2003, was US\$ 17.1 billion. They opened their first restaurant in Singapore in 1979 and by 2003 they had 129 outlets. Their revenue for 2003 was S\$238.27 million and advertising expenditure was S\$13.65 million. The Opponents' mark McCafe [T00/10806] has been registered in class 30 for goods including coffee since 2000. It has also been registered for café services. The Opponents also own 11 marks with the prefix Mc or Mc in class 29 and 30. The Opponents opened their first McCafe outlet in Singapore in 2003, after the application for MacCoffee by the Applicants.

The Applicants have been in the instant beverage business since 1994. They said that they chose the prefix Mac as they were previously in the computer business and sold Macintosh computers, which were referred to as Mac. The mark that the Applicants first used on class 30 goods comprised of a device of an eagle plus the word MacCoffee. It is unclear since when they have used the word MacCoffee on its own.

**Held, disallowing registration**

1. The Applicants' “MacCoffee” and the Opponents' “McCafe” marks, are confusingly similar. Both marks start with M, which stand for Mc in the Opponents' mark and Mac in the Applicants' mark, and contain a capital letter C in the middle, which divides each mark into two such that the impression is not of one

word but of two words put together. The marks McCafe and MacCoffee sound similar and evoke the same idea. Further the goods are similar. Even if the Opponents have hitherto not sold coffee from a supermarket, their registration entitles them to do so. Further the Opponents operate a café and café operators are known to sell coffee beans from their café outlets. If the application mark proceeds to registration a substantial number of Singaporeans are likely to be confused. The opposition under section 8(2)(b) succeeds.

2. The Opponents' "McDonalds" mark is well known by the Singaporean public in relation to the Opponents' restaurant services but the same cannot be said of the prefix "Mc". The Opponents' "Mc" mark is not visually, aurally or conceptually similar to the Applicants' "MacCoffee" mark, and use of the latter mark on instant coffee will not indicate a connection with the former. Similarly, use of MacCoffee on instant coffee would not result in a likelihood of confusion and there would be no damage to the Opponents' interests. Therefore, the opposition under section 8(3) fails.
3. In relation to passing off, it was found that the Opponents have a reputation and goodwill in the restaurant business operating under the mark McDonalds. This does not mean that they have a reputation in running a café business under the mark McCAFE as at April 2003. Therefore if the Applicants use their mark MacCoffee on instant coffeemix, the public would not be deceived into thinking that the Applicants' instant coffee originated from the Opponents and no damage can be inferred. The opposition under section 8(4) therefore fails.
4. There is no bad faith in the Applicants first applying for the eagle device plus the word MacCoffee and then now applying for the word MacCoffee on its own. There is nothing sinister in the owner of a composite mark seeking registration of the device separately and the word separately, in order to ensure that every element of his mark is protected. It just means that the owner is seeking to protect every element of his composite mark. In this case it is unfortunate that the Applicants are unable to protect separate elements of their mark because they chose elements which separately run foul of the Trade Marks Act. The opposition under section 7(6) fails.

### **Provisions of legislation discussed**

- Trade Marks Act (Cap. 332, 1998 Rev Ed.) Sections 7(6), 8(2)b, 8(3) and 8(4)(a).

### **Cases referred to:**

- *Aristoc Ltd v Rysta Ltd* [1945] 62 RPC
- *British Sugar v James Robertson* [1996] RPC 281
- *Brown Shoe Co Inc's Application* [1959] RPC 2
- *Canon Kabushiki Kaisha v MGM* [1999] E.T.M.R. 1
- *Cooper Engineering Company Proprietary Limited v Sigmund Pumps Limited* (1956) 86 CLR 536
- *De Cordova & Ors v Vick Chemical Co* [1951] RPC 103
- *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293
- *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] AC 731
- *Ferodo Ltd's Application* (1948) 62 RPC 111
- *Gromax Plasticulture Ltd v Low Nonwovens Ltd* [1999] RPC 367
- *Harrods Case* (1935) 52 RPC 65
- *Harrods Ltd v Harroddian School Ltd* TM (1996) RPC
- *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (t/a One.99 Shop)* [2000]
- *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] E.T.M.R. 690
- *Mark Euvard v MacDonald's Corp* [1997] ATMO 63 (McMint)
- *McDonalds Corp v Macri Fruit Distributors* [2000] ATMO 37
- *McDonalds Corporation v David Bellamy* [2004] ATMO 26
- *McDonalds Corporation v Future Enterprises Pte Ltd* [2005] 1 SLR 177
- *Minerva TM* [2000] FSR 734
- *Night Nurse v Nit Nurse* (0/085/03)
- *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280
- *Pianotist Co' Application* (1906) 23 RPC 774
- *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR
- *Premier Luggage & Bags v Premier Co (UK) Ltd* [2002] E.T.M.R 69
- *React Music Limited v Update Clothing Limited* [2000] RPC 285
- *Reckitt & Colman Products Ltd v Borden Inc & Ors* [1990] 1 All ER 873
- *Royal Enfield TM* [2002] RPC 24
- *Sabel v Puma* [1998] RPC 199
- *Sandy Gaye Cowley v McDonalds Corp* [1997] ATMO 65 (McVeg)

- Societe LTJ Diffusion v Sadas SA [2003] FSR 608
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175
- Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Vitamins Ltd's Application [1956] RPC 1
- Wild Child TM [1998] RPC 455
- Yu Kwan Yuen Frank v McDonald's Corp (2001) WL 1422899

### **Representation**

- Mr. Tan Tee Jim (SC) and Ms Low Pei Lin (Allen & Gledhill) for the Applicants
- Ms Penny Leng (Drew & Napier) for the Opponents

[The appeal from this decision to the High Court and Court of Appeal have been dismissed]