

**In A Matter Of A Trade Mark Application No. T01/16791D By
Pret A Manger (Europe) Limited**

And

**Opposition Thereto By
Ezaki Glico Kabushiki Kaisha**

*Before Principal Assistant Registrar Ms P Arul Selvamalar
12 September 2006*

Trade Marks – Opposition to registration – Likelihood of confusion – whether the Application Mark is confusingly 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 earlier trade mark is well known in Singapore – whether the use of the later trade mark would indicate a connection – whether there exists a likelihood of confusion – whether the interests of the proprietor of the earlier trade mark are likely to be damaged – Section 8(3) 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(7) of the Trade Marks Act 1998 [Cap.332]

The Applicants are a British Company who applied for registration of a mark, PRET on a star device on 29 October 2001. The application was in class 30 for the goods “coffee; tea; cocoa; sugar; cereals; flour and preparations made from cereals; bread; pretzels; pastry; cakes; buns; biscuits; cookies; muffins; croissants; couscous; rice; tapioca; sago; chocolate; confectionery; ices and ice creams; honey; treacle; salt; mustard; vinegar; sauces (condiments); salad dressings; spices; mayonnaise; pasta; pastries and pies; sandwiches ; wrap sandwiches; puddings; sushi; tarts; prepared and cooked meals and snacks”.

The Opponents are a Japanese company who own the registered mark PRETZ for the goods “biscuits, pretzels, bread; all included in class 30”. The mark PRETZ was first used in Japan in 1962 and first used in Singapore in 1973. The Opponents sell at least 8 types of pretzel products in Singapore under the PRETZ mark. They have also used their PRETZ mark in Thailand, China, Taiwan, Hong Kong, Saudi Arabia, USA and Canada. The Opponents have also applied to register or have registered their PRETZ mark in Japan, Korea, China, Philippines, Vietnam, Australia, Canada, Mexico, Argentina, Finland, Germany, France, Spain, Portugal, UK, Ireland, Russia, EU (CTM) and South Africa. The value of sales of goods under the Opponents’ PRETZ mark in Singapore in year 1973 was US\$23,474 and it increased to US\$116,110 in year 2001. The Opponents’ advertising and promotional expenditure in Singapore in year 2001 was S\$120,000.

The Applicants have a number of trade marks including PRET and PRET & star logo and these two marks have been registered in many countries. In Singapore, they have registered the marks PRET, PRET A MANGER, PRET & star logo and star logo in classes 29 and 30. The Applicants say that their mark PRET is short for their other mark PRET A MANGER and that it is word in French meaning “ready”. “Pret a Manger” means “Ready to eat” in French.

The Opponents argued that the Applicants’ mark should not be registered as it is confusingly similar to their mark under section 8(2)(b), that the registration of the application mark would be contrary to the provisions of section 8(3) and under the law of passing off under section 8(7) of the Trade Marks Act.

Held, allowing the application mark to proceed to registration

1. The Opponents’ mark is PRETZ, while the Applicants’ mark is PRET on a star device. Although there is some aural similarity in the beginnings of the words, the marks are aurally dissimilar. The Applicants’ mark is stylised, namely whereas the Opponents’ mark appears in normal script. As the star device on which the word Pret appears in the Applicant’s mark, forms a prominent part of the mark, there is visual dissimilarity between both marks. Conceptually, there is also no similarity as the Applicants’ mark will have no meaning until the customer is educated of its meaning, whereas the Opponents’ make will have some reference to the product, pretzels. Although the goods of the Applicant and the Opponent are identical and the kind of customer of the goods will also be the same, there will be no real likelihood of

confusion among a substantial number of members of public. Therefore, opposition under section 8(2)b fails.

2. The evidence filed is insufficient to establish that the Opponents Pretz mark is a well known mark under section 8(3)(i). Furthermore, the marks are not similar under section 8(3)a and there would be no confusion under section 8(3)(iii). Therefore, opposition fails under section 8(3).
3. As it has been found that the marks are not similar and there would be no confusion, there will be no misrepresentation under the law of passing off. The opposition under section 8(7) fails.

Provisions of legislations discussed:

- Trade Marks Act 2005 [Cap. 332, Rev Ed.] Sections 8(2)b, 8(3) and 8(7)

Cases Referred to:

- Polo/Lauren Co, LP v Shop-In-Department Store Pte Ltd [2006] 2 SLR 690
- Aristoc Ltd v Rysta Ltd [1945] 62 RPC 65 at pg 72
- Wagamama v City Centre Restaurants [1995] FSR 713
- Eric Peterson v Henkel Kommanditgesellschaft Aug Aktien [O-149-04], Application by Bass Public Company [O-204-02]
- Official Starter LLC v Converse Inc.[O-012-2]
- Application by Hardings Manufactures Pty Ltd t/a Wyandra Industries (1987) 8 IPR 147
- Rowntree Plc v Rollbits Pty Ltd (1988) 10 IPR 539 [Rolo v Roll-O-Bar]
- Aldi Stores Limited v Frito Lay Trading Company 54 IPR 344 [Cheesy Twist v Twisties]
- In the Matter of Perfetti SpA [1999] C.L.Y. 3537 [CHLORALIT v CLORETS]
- Johnson & Johnson v Unigate Diaries Limited [O-387-01] [CALCIA v CALCIMILK]
- Major League Baseball Properties Inc v Sec. of State for Defence [O-356-03] [MET v METS]
- CODAS TM [2001] RPC 14 [CODA v CODAS]
- React Music Limited v Update Clothing Limited [2000] RPC 285
- British Sugar v James Robertson [1996] RPC 281
- Nestle v Strasburger (1995) 31 IPR 639
- Pianotist Company Ld's Application (1906) 23 RPC 774
- Future Enterprises v McDonalds Corporation 2005 [SGIPOS] 21
- WILD CHILD TM [1998] RPC 455
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] A.C. 731
- Sabel BV v Puma AG [1998] RPC 199
- JM Collective Pte Ltd v Perlini Pte Ltd 2005 [SGIPOS] 4
- Law of Trade Marks & Passing Off in Singapore [2003 Ed]
- Marca Mode CV [2000] ETMR 561

Representation:

- Mr. Patrick Yap (KL Tan & Associates) for the Applicants
- Mr. Ian Oei (Drew & Napier) for the Opponents