

**In The Matter Of An Application For A Mark “THE RED MUG” Device By Societe Des Produits Nestle S.A.
In Class 30**

AND

Refusal Of Registration Under Section 12 Of The Trade Marks Act And Rule 24 Of The Trade Mark Rules

*Before Principal Assistant Registrar Louis Chan Ken Yu
31 October 2006*

Trade Mark Application - Refusal of Registration - Whether Applicants' mark registrable under section 7(1)(a) and (b) of the Trade Marks Act (Cap. 332, 1999 Ed.)

Trade Mark Application – Refusal of Registration – Whether the Applicants' mark had acquired distinctiveness through use – Whether use of a composite mark is sufficient to prove that individual elements in the composite mark have acquired distinctiveness under section 7(2) of the Trade Marks Act (Cap. 332, 1999 Ed)

On 9 January 2003, Société des Produits Nestlé S.A. (“the Applicants”) filed an international application under the Madrid Agreement Concerning the International Registration of Marks, and under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Protocol”) via the Swiss trade mark office, claiming “coffee, coffee extracts and preparations made with coffee; coffee substitutes and artificial coffee extracts; tea, tea extracts and preparations made with tea; cocoa and preparations made with cocoa, chocolate, chocolate products, confectionery, sweetmeats; sugar; natural sweeteners; bakery products, bread, yeast, pastry articles; biscuits, cakes, desserts made with vegetable products and other desserts made with cereals (cereals being the main ingredient); dough, baking powder, flour, spices and flavourings (other than essential oils) included in this class for making desserts (in which cereals predominate); puddings; edible ice, products for preparing fine foods; honey and honey substitutes; breakfast cereals, rice, pasta, foodstuffs made with rice, flour or cereals, also in the form of cooked dishes; sauces; products for flavouring or seasoning foodstuffs, sauces for salads, mayonnaise”. The international application, which was accorded Application No. 796 607, was based on a Swiss basic registration, No. 506128, and priority was claimed on that Swiss registration from 12 December 2002. Singapore was designated in the international application under the Madrid Protocol.

The Assistant Registrar, Ms Ho Sok Yin, examined the application on 22 July 2003 and raised a provisional refusal on the basis that the mark, a three-dimensional shape of a red mug of coffee, did not satisfy the definition of a trade mark under Sections 2(1) and 7(1)(a) of the Trade Marks Act (Cap. 332, 1999 Ed.) (“the Act”) and that the mark was devoid of distinctive character under Section 7(1)(b) of the Act. The Applicants' agents, Messrs Donaldson & Burkinshaw, lodged submissions on the basis that the mark was registered in the UK and Australia and a coloured document to show that the mark had been used in various countries. They also offered a colour limitation, and relied on evidence of use and a prior Singapore trade mark registration belonging to the Applicants, viz. Registration No. T97/15458D. The objections were maintained.

The Applicants' agents applied for an ex parte hearing and appeared before the Hearing Officer on 31 October 2006. They argued that the mark satisfies the definition of a trade mark, is not devoid of distinctive character and is prima facie registrable. In the event that the mark is not prima facie distinctive, they submitted that

- i. there is a precedent for a very similar mark viz. Singapore Registration No. T97/15458D;
- ii. there is extensive prior use of the mark in Singapore;
- iii. the mark has acquired distinctiveness through use under Section 7(2) of the Act;
- iv. the evidence of use lodged is directly relevant to the application;
- v. UK Registration No. 2157854B is highly persuasive; and
- vi. there are numerous precedent registrations from other countries.

Held, maintaining the refusal of the application

1. The mark is devoid of distinctive character and offends Section 7(1)(b) of the Act. The mark is a three-dimensional shape of a red mug with a gold band around its exterior and that red mug contains a liquid which appears to be coffee. There are no other distinguishing features in the mark apart from these. The declaration from the creator that the mark was created by him, and the Applicants claiming that the mark

was designed to be “distinctive and unique”, were not relevant. The mark is a simple cylindrical red mug with a handle and containing coffee. The gold band is mere decorative and does not add much in raising its distinctiveness. When considered in relation to the goods viz. coffee, the mark is descriptive because it is the normal manner of containing the coffee for consumption.

2. Singapore Registration No. T97/15458D is not relevant because the two marks are obviously different in nature. Registration No. T97/15458D is a conventional two-dimensional mark whereas the present mark is a three-dimensional shape mark. Secondly, Registration No. T97/15458D was a converted application under the Act. There were no disclaimers imposed since it was accepted under the Act but had the mark been accepted under the old Trade Marks Act (Cap. 332, 1992 Ed.), separate disclaimers over the red mug of coffee and the devices of coffee beans were likely to be imposed. That would have meant that the Applicants would have had rights only in the mark as a whole but no exclusive rights in the device of the red mug or the coffee beans.
3. The plea under the proviso of Section 7(2) fails. The present mark relates to a three-dimensional mark of a red mug of coffee but the Statutory Declaration relates to a composite two-dimensional mark with other accompanying elements and features. There is no evidence of use of the present mark which is three-dimensional.
4. The UK precedent is not persuasive because it relates to a different mark and was accepted upon lodgement of survey evidence in the UK. The precedents from the other jurisdictions are also not persuasive because trade mark rights are territorial and the registrability of a trade mark is dependent on the national law of each country underwhich the mark has been filed.

Provisions of Legislation discussed:

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

Cases referred to:

- Uni Charm Corporation by Procter & Gamble Company [2003] SGIPOS 12

Representation:

- Mr Tan Bok Hoay and Mr Michael Kraal (Donaldson & Burkinshaw) for the Applicants

NB. This matter is on appeal in the High Court.