

**IN THE MATTER OF TRADE MARK APPLICATION NO. T05/07253E**  
**BY**  
**CROWN CONFECTIONERY, CO., LTD.**

**AND**

**OPPOSITION THERETO BY**  
**MORINAGA & CO., LTD.**

*Before the Principal Assistant Registrar, Ms See Tho Sok Yee*  
*8 May 2008*

**Trade Marks** – Opposition to registration – Preliminary issue – Notice of Opposition – whether the Opponent can rely on a ground of opposition not expressly pleaded in the Notice of Opposition - Section 8(3A) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**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) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**Trade Marks** – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**Trade Marks** – Opposition to registration – Likelihood of confusion - whether the Application Mark is identical to an earlier trade mark and is to be registered for goods or services identical with those for which the earlier trade mark is protected - Section 8(1) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**Trade Marks** – Opposition to registration – Likelihood of confusion - whether the Application Mark is identical or similar to an earlier trade mark and is to be registered for goods or services identical or similar to those for which the earlier trade mark is protected - Section 8(2) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**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 (Cap. 332) 1999 Rev. Ed.

The Applicants, Crown Confectionery, Co., Ltd, applied to register their trade mark “MYCHEW” (“the Application Mark”) on 28 April 2005 in Class 30 in respect of “Chewing gum, not for medical purposes; candy for food; caramels [candy]”. The Application Mark is in upper case, blue and slanting slightly to the right. The Applicants, a confectionery company from Korea, claim to have coined the word “MYCHEW” and have used the Korean version of “MYCHEW” in Korea on candy since 2004. The Applicants claim to have used the Application Mark in Singapore since 2005.

The Opponents are the proprietors of the trade mark “HI-CHEW” in English, Japanese and Chinese. They registered their marks in various forms (word form and label form e.g. “HI-CHEW & HI-CHEW GREEN APPLE (in Japanese katakana) with green apple device”) in various countries. In Singapore, the Opponents registered their trade mark in word and label form (Trade Mark Nos. T0101392E, T0404960B, T0404961J, T0404962I and T9909087G) in respect of a variety of foodstuff in Class 30 including “Biscuits, chocolates, caramels, snacks, cakes, ice cream, cocoa, hotcake mix, candy and gum”. Trade Mark No. T0101392E for the English word mark was registered on 3 February 2001 with the label marks following on 31 March 2004. The Opponents claim to have used their “HI-CHEW” trade marks in Japan since 1975 and in Singapore since 1981.

The Opponents opposed the registration of the Application Mark on the grounds that it is identical to their marks and in respect of identical goods, under Section 8(1). In the alternative, they also claim that the Application Mark was identical or similar to their earlier “HI-CHEW” trade marks in word form and label form, in respect of similar goods, such that there exists a likelihood of confusion under Section 8(2)(a) and (b). The Opponents also claim that use of the Application Mark was liable to be prevented under the law of passing off and as such, the application should be refused under Section 8(4)(a). The Opponents submit that the Application Mark is not capable of distinguishing the Applicants’ goods from the Opponent’s goods in the course of trade under Section 7(1)(a) read with Section 2(1). The Opponents also argue that the Application Mark is devoid of any distinctive character under Section 7(1)(b). Lastly, the Opponents submit that the Applicants fell short of the standards of acceptable commercial behaviour because of the Opponents’ extensive reputation and goodwill in the HI-CHEW Trade

Marks, which the Applicants are very unlikely to be unaware of; the fact that both parties are competitors; and the Applicants' choice of mark, which displays an extremely high similarity to the Opponents' HI-CHEW trade marks and suggests the intention to ride on the Opponents' reputation. Registration should therefore be denied under Section 7(6) of the Trade Marks Act.

In their written submissions and at the hearing, the Opponents sought to admit arguments based on a further ground of opposition under Section 8(3A). The Applicants objected as the ground was not expressly pleaded in the Notice of Opposition.

**Held, allowing the Application Mark to proceed to registration**

1. On the preliminary issue of whether the Opponents may base their opposition on a ground not expressly pleaded in the Notice of Opposition, the Registrar found for them in principle but against them on the facts. An opponent may rely on a ground of opposition if it is substantially pleaded in the Notice of Opposition, even if the actual section and sub-section were not stated. In the Notice of Opposition, the Opponents only stated that "the Opponents' Marks have successfully come to be distinctive of the Opponents' goods and are well-known to the trade and public as a symbol of its reputation, quality and taste of the Opponents' products." This does not amount to a substantial pleading of Section 8(3A) as some elements of this ground of opposition are missing.
2. "MYCHEW" and "HI-CHEW" are not identical to each other. The opposition under Sections 8(1) and 8(2)(a) therefore failed.
3. "MYCHEW" and "HI-CHEW" are not visually nor conceptually similar and only marginally similar aurally. Because the goods are self-serve food items, the visual and conceptual aspects of the marks figure more prominently than the aural aspects at the point of selection and sale. The public will have inclination and sufficient opportunity to discern and correctly select the desired food item. As the Opponents have not proven a likelihood of confusion on the part of the public, the opposition under Section 8(2)(b) therefore failed.
4. The Opponents enjoy goodwill in their earlier "HI-CHEW" trade marks. However, there is no misrepresentation by the Applicants leading or likely to lead the public to believe that the goods offered by them were the goods of the Opponents. It further follows that the element of damage is not made out. The opposition under Section 8(4)(a) therefore failed.
5. Considering the Application Mark, "MYCHEW", on its own, the Registrar was satisfied that it is a trade mark that is not devoid of any distinctive character. The opposition therefore failed on Section 7(1)(a) and (b).
6. On the evidence, the Applicants coined the word "MYCHEW" as their trade mark and without more, even if they knew of the Opponents' "HI-CHEW" trade marks and were competitors, they cannot be inferred to have acted in bad faith. It cannot be said that the Applicants fell short of the standards of acceptable commercial behaviour objectively and subjectively. The opposition under Section 7(6) therefore failed.

**Provisions of legislation discussed:**

- Trade Marks Act (Cap 332, 1999 Rev Ed) Sections 2(1), 7(1), 7(6), 8(1), 8(2), 8(3A) and 8(4)(a)

**Cases referred to:**

- First Principal Financial Planning Pte Ltd v Principal Financial Group, Inc [2004] SGIPOS 11
- First Principal Financial Pte Ltd v Principal Financial Group, Inc. [2006] SGIPOS 2
- LTJ Diffusion SA v Sadas Vertbaudet SA [2003] FSR 34
- Aktiebolaget Volvo v Heritage (Leicester) Limited [2000] FSR 253
- Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] 4 SLR 755
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
- R v. IDG Communications Ltd's Trade Mark Application [2002] RPC 10
- Origins Natural Resources Inc v. Origin Clothing Limited [1995] FSR 280
- Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp) [2007] 1 SLR 1082
- Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
- ENLIVA Trade Mark, UK Opposition no. O/115/00
- La Societe Des Brasseries et Glacieres Internationales v Asia Pacific Breweries Ltd [2006] SGIPOS 5
- The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690
- N.V. Sumatra Tobacco Trading Company v Reemsta Cigarettenfabriken GmbH [2006] SGIPOS 1
- Bobby Footwear Pte Ltd v Parfums Nina Ricci [1999] SGIPOS 1

- In the Matter of Broadhead's Application for Registration of a Trade Mark (1950) 67 RPC 209
- E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5
- Itochu Corporation v Worldwide Brands, Inc. [2007] SGIPOS 9
- JM Collective Pte Ltd v Perlini's Pte Ltd [2005] SGIPOS 4
- McDonald's Corp v Future Enterprises [2005] 1 SLR 177
- The Polo/Lauren Co, LP v. Shop-In Department Store Pte Ltd [2005] 4 SLR 816
- In the Matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark (1906) 23 RPC 774
- Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV [2000] FSR 77
- In the Matter of London Lubricants (1920) Limited's Application to Register a Trade Mark (1925) 42 RPC 264
- Gilead Sciences Inc. v Glaxo Group Limited [2006] SGIPOS 12
- FRIGIKING Trade Mark [1972] FSR 183
- The Polo/Lauren Company L.P. v United States Polo Association [2002] 1 SLR 326
- Reckitt & Colman Products Ltd v Borden Inc [1990] 1 WLR 491
- Harrods Ltd v Harroddian School Ltd [1996] RPC 697
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and Another Appeal [2000] 3 SLR 145
- Gromax Plastics Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR 1073
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- FLOWSTACKA Trade Mark [1968] RPC 66
- Application by Brown Shoes Company Inc for Rectification of the Register [1959] RPC 29
- Royal Enfield Trade Marks [2002] RPC 24
- Harrison v Teton Valley Trading Co Ltd [2004] 1 WLR 2577
- Twinsectra Ltd v Yardley [2002] 2 AC 164
- Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2, [1998] RPC 283
- Duckham & Co's Trade Mark Application [2004] RPC 28
- Nestle SA's Trade Mark Application [2004] FSR 2
- Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co. Ltd [2008] SGIPOS 9

**Representation:**

- Ms Elaine Tan and Ms Lim Hui Nan (Amica Law LLC) for the Opponents
- Ms Vicki Heng (Ravindran Associates) for the Applicants