

**IN THE HEARINGS AND MEDIATION DIVISION OF
THE INTELLECTUAL PROPERTY OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T99/07860E

26 March 2008

**IN THE MATTER OF AN APPLICATION BY
KOPITIAM INVESTMENT PTE LTD
IN CLASS 42
TO REGISTER A TRADE MARK**

And

**OPPOSITION THERETO BY
RC HOTELS (PTE) LTD**

Hearing Officer: Anne Loo
Principal Assistant Registrar

Mr Jeffrey Lee (Messrs Lee Chai & Boon) for the Applicants

Mr Isaac Tung (Messrs Allen & Gledhill) for the Opponents

GROUND OF DECISION

1. This is an opposition against the trade mark application number T99/07860E in Class 42 in respect of the following services: "Cafes, cafeterias, canteens, provision of food and drinks; all included in Class 42". The trade mark as applied for appears as follows:

KOPITIAM

2 The Applicants, Kopitiam Investment Pte Ltd of 75 Bukit Timah Road #04-01 Boon Siew Building Singapore 229833, filed the trade mark application on the 28 July 1998. The trade mark was accepted and advertised in the Singapore Trade Marks Journal on 22 Jan 2003 with the clause “Proceeding because of acquired distinctiveness through use”.

3 The Opponents RC Hotels (Pte) Ltd lodged a Notice of Opposition against the trade mark application on the 22 May 2003.

Chronology of the Matter

4 The Opponents filed their Notice of Opposition on 22 May 2003. The Applicants filed their Counter Statement on 20 September 2003. The Opponents filed their evidence in support of their opposition on 16 September 2004 and the Applicants filed their evidence in support of their application on 16 November 2004. On 2 February 2005, the Applicants filed further evidence. The Applicants made an application to amend their Counter Statement and filed the amended Counter Statement on 26 August 2005. Extensions of time were requested and granted with the consent of parties for the Opponents to file the statutory declaration in reply as well as to address the amendments to the Counter Statement. At the Pre-hearing reviews held on 16 April 2007, 27 June 2007 and 6 September 2007, the parties requested time to enter into negotiations for settlement. As the settlement negotiations broke down, the opposition was fixed for hearing on the 17 January 2008. The hearing was adjourned at parties’ request and the matter was heard on 26 March 2008.

The grounds of opposition

5 The Opponents relied on the several grounds of opposition in the Notice of Opposition, namely:

5.1 The use of the Applicants’ mark is likely to indicate a connection between those goods and the Opponents’ when no such connection exists. There will exist a likelihood of confusion on the part of the public as a result of such use. As such, registration of the Applicants’ mark is contrary to sections 7 and 8 of the Trade Marks Act Cap 332, 1999 Rev Edition (“the Act”), in particular sections 7(5) and 8(4) of the Act.

- 5.2 By reason of the distinctiveness and reputation of the Opponents' mark and by reason of the fact that the Applicants' mark is confusingly similar to the Opponents' mark, registration of the Applicants' mark would be contrary to section 7(4) of the Act as being contrary to public policy or likely to deceive the public.
- 5.3 By reason of extensive use of the Opponents' mark and by reason of the fact that the Applicants' mark is confusingly similar to the Opponents' mark, the Applicants' mark is not capable of distinguishing the services of the Applicants and registration of the Applicants' mark would be contrary to section 7(1) of the Act.
- 5.4 By reason of the reputation and goodwill established in the Opponents' mark and the trade mark application of the Opponents' mark in Singapore, the Applicants cannot validly claim to be the proprietor of the Applicants' mark. The registration would be contrary to section 4(1) of the Act.
- 5.5 The Applicants' choice of their mark applied for is taking advantage of the Opponents' established and immense reputation and of the goodwill in the Opponents' mark in Singapore. As such the Applicants' mark is not bona fide and should be refused registration under section 7(6) of the Act.
- 5.6 Registration of the Applicants' mark would be prejudicial to the Opponents' business and ought to be refused under the discretionary powers vested in the Registrar.

6 The Applicants in their amended Counter-Statement disputed the Opponents' grounds and stated that there has been honest concurrent use by the Applicants of their mark in the course of trade in Singapore. The Applicants therefore state that their application should be allowed to proceed under section 9 of the Act.

7 At the hearing, the Opponents submitted that they would proceed on sections 7(1)(a), 7(1)(c), 7(4), 8(2)(b) and 8(4)(a) [now 8(7)(a)] of the Act.

The applicable law and the burden of proof

8 The Opposition falls to be determined under the Trade Marks Act Chapter 332, 2003 Revised Edition. The burden of proving the grounds raised in the Notice of

Opposition falls on the Opponents. *Kerly's Law of Trade Marks and Trade Names 14th Edition* at paragraph 9-164 states:

“There is no overall onus on the applicant either before the Registrar or in opposition proceedings. And so when an opponent raises objections under section 5 of the [UK] 1994 Act [Section 8 of our Act] he must make them out.”

The Opponents' Evidence

9 The Opponents' statutory declaration was filed on 16 Sept 2004 by Emily Chin Mei Fong, the company secretary of RC Hotels (Pte) Ltd. She states that the Opponents are the owner of the “KOPI TIAM” marks in Singapore as shown below:



The Opponents have been using their marks extensively in Singapore since 1986, in relation to its KOPI TIAM restaurant which is located at Raffles The Plaza, 80 Bras Basah Road, Singapore 189560 (formerly known as the Westin Stamford Singapore).

10 The Kopi Tiam restaurant has received many accolades in the local media and many promotional activities have been held at the Opponents' Kopi Tiam restaurant over the years, which are featured in the local press. Information about the Opponents' restaurant is available on the internet; which is easily accessible by computer users worldwide. Since the use commenced in 1986, the Opponents have enjoyed significant profits from its Kopi Tiam restaurant. Due to the extensive use and promotion of the Opponents' marks, the marks are distinctive of the Opponents and the word “Kopitiam” has acquired a secondary meaning that is distinctive of the Opponents. The public has come to associate the name “KOPI TIAM” exclusively with the Opponents, especially when the mark is used in relation to a high quality restaurant or food establishment. In their evidence, the Opponents also exhibited an extract from the website of the Accounting and Corporate Regulatory Authority showing the number of other companies and businesses which had used the word “Kopitiam” in their company and business name.

The Applicants' Evidence

11 The Applicant's statutory declaration and supplementary statutory declaration were filed by Tan Siang Hin, the managing director of Kopitiam Investment Pte Ltd, on the 16 November 2004 and 2 February 2005 respectively.

12 The Applicants first used the name "Kopitiam" for its food courts (air-conditioned and non-air conditioned), food malls and eating outlets around 1988 or 1989. The application mark was first used in Singapore around 1997 for the promotional campaign in connection with the Applicants' acquisition of the Lau Pa Sat Festival Market. The Applicants has since applied the mark at various locations within all its 14 outlets as listed below:

<u>Location of Outlet</u>	<u>Date of Opening of Outlet</u>
Bishan Street 11 Blk 151	1989
Jackson Centre	15 February 1992
Pasir Panjang Wholesale Centre	2 October 1993
Boon Lay Shopping Centre	12 November 1994
Kovan Centre	3 June 1995
Orchard Road (Meridian)	23 may 1998
Plaza By The Park	7 November 1998
Plaza Singapura	4 December 1998
Bukit Panjang Plaza	1998
Sun Plaza	2000
Hougang Festival Market	1999
Bukit Batok Central	1999
Jurong Point	1995
NUH	2000

The mark appears on main signboards, smaller signboards placed on counter-tops and above lit menu boards, plates and on the uniform (collared-T shirts, caps and aprons) worn by the staff in the course of work.

13 The estimated advertisement costs are:

<u>Year</u>	<u>Type of Advertisement</u>	<u>Estimated Costs (SGD)</u>
1997	The New Paper	4,100.00
	Lianhe Zaobao	3,951.27
	Corporate Brochure	15,450.00
1998	The Straits Times	8,652.12
	Lianhe Zaobao	1,207.03
1999	The Official Map of Singapore	16,370.00
	Singapore Official Guide 1999	9,555.00
	Pandan Bus Brochures	6,000.00

14 The Applicants and the nature of services rendered have been extensively featured in articles, write-ups, interviews and reviews since 1996, such as:

<u>Year</u>	<u>Type of Publicity</u>	<u>Size of Article</u>
1996	The Straits Times	Quarter Page
	The Sunday Times	Half Page
	Sin Min Jit Poh	Quarter Page
1997	Japan News	Quarter Page
1998	The Business Times	Quarter Page
	The New Paper	Full Page
1999	Lianhe Zaobao	Quarter Page
	The Sunday Times	Full Page
	“Eat” Magazine	One column in a page
	The New Paper -Coca Cola	Quarter Page
	Lianhe Wanbao - Power Gas	Quarter Page

15 The Applicants had publicised their mark through the use of corporate brochures, posters, discount vouchers and other publicity materials; and have had promotional activities with Tiger Beer, Coca-Cola, Singapore Tourism Board and PowerGas. The cost for printing of the materials and running the promotional activities in 1999 totalled SGD 164,381-31. As the activities are often graced by television and radio celebrities, the Applicants had also placed advertisements in the English and Chinese dailies to publicise activities such as opening ceremonies. In addition, banners onto which the Applicants’ mark was affixed were prominently displayed. Besides these activities, the Applicants had also placed recruitment advertisements bearing their mark in the Chinese and English newspapers. The Applicants also used their mark on their letterheads, envelopes, memo pads and name cards of their employees. The Applicants maintain a website within which the Applicants’ services are marketed to its customers and the public in general. The Applicants have other registrations of marks bearing the word “Kopitiam” in Singapore and in other jurisdictions such as Hong Kong and China.

16 The annual turnover of the Applicants from its services in respect of the application mark is as follows:

<u>Year</u>	<u>Annual Sales Turnover (SGD)</u>
1998	8,423,598
1999	4,748,538
2000	5,188,704
2001	5,735,988
2002	52,849,948

17 The Applicants registered the company in 1993 and the registered company's name Kopitiam Investment Pte Ltd incorporates the word "Kopitiam". IE Singapore had also shortlisted the Applicants' services as part of the government efforts to expand local companies operations abroad and to promote the company to interested foreign parties by way of joint venture or licensing or franchising opportunities. The deponent stated that all effort had been made to distance the Applicants' type of services from the Opponents' which is essentially an eating outlet within a five-star hotel. The pricing of the food at the Opponents' outlet is more expensive as compared to food sold at the Applicants' outlets.

Decision

Ground of opposition under section 7(1) of the Act - Absolute grounds for refusal of registration

18 Section 7(1) of the Act states that the following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2 (1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

19 The definition of a "trade mark" in Section 2(1) states that defines it is "any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person".

The Opponents' submissions

20 The Opponents submit that by virtue of the Opponents' goodwill and reputation in their mark, the Applicants' mark is clearly incapable of distinguishing their services from the services provided by the Opponents. The word "Kopitiam" which translates to mean "caffeshop" is a mark which consists exclusively of signs

or indications which may serve in trade to designate the kind, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, and would be contrary to s 7(1)(c) of the Act. The word “Kopitiam” has a strong primary meaning which is difficult to displace. Use of the mark that is required to replace the primary meaning and replace it with a secondary meaning must be very substantial use. The Applicants’ use of the application mark however does not show that the mark has before the date of application (i.e. the 28 July 1999) acquired a distinctive character.

21 The Applicants’ evidence shows that the earliest use of the mark as applied for was in early March 1998. There is no substantiated evidence showing that the Applicants had used the name “Kopitiam” around 1988/1989 as alleged, or that the application mark was used in 1997. Only 6 outlets out of the 14 outlets listed in the Applicants’ evidence were in existence at 1997 but the Opponents state that the year of opening of the outlets is irrelevant for the determination of the length of use. The Opponents also state that the foreign registrations and foreign use are not relevant. The turnover figures that are submitted are not strictly figures from the sale of food and beverage, rather from the rentals of other stall operators who operate under the Applicants’ name.

The Applicants’ Submissions

22 Counsel for the Applicants argued that “capable of distinguishing” means capable to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings” (per Geoffrey Hobbs QC *AD2000 Trade Mark [1997] RPC 168* at page 173) This was a low standard that had to be satisfied. In considering s 7(1)(a), the use or lack of use by other traders of the word “Kopitiam” would not be relevant. The Applicants pointed out that the lettering of their “Kopitiam” mark is stylised and used in a pink colour. They also argue that the Applicants’ mark is used on services which are different from that of a traditional coffee shop- that is, on the food court concept. This shows that the Applicants are not using the mark in a purely descriptive sense for when the application mark was used on the Applicants’ type of business in the early 80s, there was no association between the word “Kopitiam” and “air-conditioned food courts or mega food malls” or “24-hour food courts serving an international selection of food”.

23 The Applicants highlighted that the ban on use of Chinese dialects in the media had not been relaxed in the 80s and hence the use of the term “Kopitiam” on the Applicants’ type of business made it memorable to the general public. The Applicants’ extensive prior use of the mark is evidence that the mark functions as a trade mark. This use together with the non-descriptive nature, the stylisation and pink colour of the mark clearly indicate that the Applicants’ mark functions as a trade mark.

24 The Applicants’ mark is also not devoid of distinctive character as it can do the job of distinguishing without first educating the public that it is a trade mark. (*British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281*) The mark is not used in a descriptive manner and the use of it on the Applicants’ “super-modern mega-sized” Western-style café or cafeteria or food court, does not inform consumers of a specific and objective characteristic of the services. (*Deutsche Post EURO-EXPRESS GmbH v OHIM Case T334/03, January 2005*)

25 The Applicants reject the Opponents’ submission that there is a prevalence of third parties using the word “Kopitiam”. They submit that third parties are not prejudiced from using the word “Kopitiam” to describe an actual traditional coffeeshop as s 28(1)(b) of the Act provides a fair use defence for these third parties. The distinctiveness of the Applicants’ mark resides not only in the word but in the overall stylised design and manner of use; hence trade mark infringement would arise only where there was almost identical copying of the mark as well as use of the third party of that mark on the same or similar services.

Decision:

26 The Notice of Opposition raising this ground states: “By reason of extensive use of the Opponents’ mark and by reason of the fact that the Applicants’ mark is confusingly similar to the Opponents’ mark, the Applicants’ mark is not capable of distinguishing the services of the Applicants and registration of the Applicants’ mark would be contrary to section 7(1) of the Act.” As a preliminary point, Counsel for the Applicants had argued that s 7(1) of the Act contains 4 subsections, and as Counsel for Opponents did not particularise the ground sufficiently to state which subsection the Opponents were relying on, this had caused some prejudice to the Applicants. The

Applicants' argument that the use of the words "capable of distinguishing" in the Notice of Opposition would serve to confine the Opponents' ground of opposition to s 7(1)(a) only. The Applicants further submitted that s 7(1)(a) is a distinct and separate ground from s 7(1)(b) to (d) as supported by *AD2000 Trade Mark [1997] RPC 168*.

27 The Opponents' countered this and argued that as the Notice of Opposition had indicated reliance upon s7(1) as a ground of opposition, sufficient notice had been given to the Applicants that the Opponents intended to rely on the whole section to prevent registration. The written submissions were also exchanged by parties on the 14 January 2008, prior to the hearing on 26 March 2008 and these clearly stated that all the limbs of s 7(1) were relied on. The Applicants had ample notice of the Opponents' intention.

28 I allowed the Opponents to proceed with their arguments under all the limbs of s 7(1). The meaning of "capable of distinguishing" suggests that there a considerable overlap between the subsections, hence when a determination is made under section 7(1) of the Act, all the limbs of the section ought to be considered. The precedents relied upon by the parties give guidance on the meaning of "capable of distinguishing". In both *British Sugar* and *AD2000* which were cited, it is clear that a mark must have distinctive character before it can perform its function as a trade mark. Jacob J at p. 305 of *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, said:

"Capable of distinguishing means whether the mark can in fact do the job of distinguishing. So the phrase in section 1(1) (our Section 2(1)) adds nothing to section 3(1) (our Section 7(1)) at least in relation to any sign within section 3(1)(b)-(d) (our Section 7(1)(b)-(d)). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is

simply that the Applicants will be unable to prove the mark has become a trade mark in practice - “Soap” for “soap” is an example. The bar (no pun intended) will be factual not legal.”

29 And in *AD2000 [1997] R.P.C. 168*, G. Hobbs Q.C., the Appointed Person stated:

“Section 3(1)(a) (our Section 7(1)(a)) prohibits the registration of “signs” which do not satisfy the requirements of section 1(1) (our Section 2) (because they are incapable of being graphically represented and/or incapable of distinguishing the goods or services of one undertaking from those of other undertakings whereas the prohibitions in sections 3(1)(b), 3(1)(c), 3(1)(d) (our Sections 7(1)(b), 7(1)(c) and 7(1)(d)) are applicable to “trade marks”, i.e. signs which satisfy the requirements of section 1(1), but nonetheless lack a *distinctive character* in the absence of appropriate use.”

30 Hence, a sign which is “capable of distinguishing” must have distinctive character and the evaluation of whether a sign has this distinctive character calls for an assessment of the whole section 7(1) as the subsections (a), (b), (c) and (d) have some degree of overlap.

31 **Ng-Loy Wee Loon** in her book **Law of Intellectual Property of Singapore, Sweet & Maxwell Asia 2008** skilfully classifies the threshold for distinctiveness under section 7 of the Act as the “three thresholds of distinctiveness (capacity-to-distinguish; inherent distinctiveness; de facto distinctiveness)” and articulates the interplay between these as follows at [21.3.5] on page 265:

“The first threshold is found in the statutory definition of ‘trade mark’ itself: a sign must be capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with by any other person. A sign which fails to cross this **capacity-to-distinguish** threshold is not a trade mark for the purposes of the Trade Marks Act and s 7(1)(a) prohibits its registration. The second threshold is found in ss 7(1)(b) -(d) which prohibit the registration of trade marks which are devoid of distinctive character, for

example, trade marks which are descriptive of the goods or services for which registration is sought. Such trade marks are the ones which lack **inherent distinctiveness**, and as indicated above, they are *prima facie* not allowed registration. If the applicant of an inherently non-distinctive trade mark shows that it has crossed the third threshold of distinctiveness set out in s 7(2), that is, the mark has acquired sufficient **de facto distinctiveness** as a result of the Applicant's use made of the mark before the date of application, the mark will be accepted for registration." [emphasis mine]

Section 7(1)(a) - capacity-to-distinguish

32 Section 7(1)(a) states that a sign which does not satisfy the definition under s 2 (1) shall not be registered. The requirements under s 2(1) are firstly, the sign must be capable of being represented graphically and secondly, it must be capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person. The Applicants' mark satisfies the first requirement of being capable of graphically represented. The more critical question is whether the mark "Kopitiam" can cross the capacity-to-distinguish threshold under s 7(1)(a) and this will necessitate an examination of the word "*kopitiam*" itself.

33 "Kopitiam" is a portmanteau word - a word which has been coined by "the telescoping of two dictionary (and generally descriptive) words." ("***Whisqueur case***" - ***Hallgarten's Application (1948) 66 RPC 105***) Examples from the older cases include portmanteau marks such as "Frumato" ("Fruit" + "Tomato"), and "Vaporub" ("Vapour" + "Rub"). The word "Kopitiam" fuses two known words, albeit a Malay word and a *Hokkien* word. (*Hokkien* is a dialect of the Chinese language and is the most widely spoken dialect by the Chinese population in Singapore). "Kopitiam" is derived from the joining of the Malay word "*kopi*" which means "coffee" and "*tiam*" which means "shop" in the *Hokkien* dialect. Even though these individual words "*kopi*" and "*tiam*" are not English words, they are very widely used and well known words in Singapore's multiracial multilingual society. The word "*kopitiam*" has long been accepted to mean a traditional coffee shop and the term is commonly used not only in Singapore but also in Malaysia.

34 Although English dictionaries such as the Oxford or the Collins Dictionary do not carry a definition of the term, it is pertinent to note that the word “*kopitiam*” can be found in the 4th and most recent edition of the Kamus Dewan, the authoritative Malay dictionary published by Malaysia’s Dewan Bahasa dan Pustaka. This Malay language dictionary is used in Singapore by the Malay community and students of the Malay language, and is one of the Singapore Ministry of Education’s approved Malay language dictionaries for use in schools. At page 822 of the said dictionary, it states that the entry “*kopitiam*” means “*kedai kopi*” (the Malay words “*kedai kopi*” mean “coffee shop”).

35 I take judicial notice that the term “*kopitiam*” has been liberally used for many years in local press reports to describe a traditional coffee shop. The Opponents’ statutory declaration of use, for example, has an article dated July 9 1993 which is titled “Hotels turning on *kopi tiam* charm”. The article relates how “[t]he old world charm of a *kopi tiam* is being kept alive...” in the different coffee houses and restaurants of some Singapore hotels; where the food, the ambience, the flavours and the nostalgia of the old-style coffee shops are maintained. Other uses of the word in various articles have included: “*kopitiam* food” (cuisine served in these coffee shops and which traditionally comprises of a local coffee, toast with a local jam called “kaya” and soft-boiled eggs); “*kopitiam* talk” (a phrase used to describe gossip about politics, life or any topic of interest generated by groups of people congregating at these coffee shops); and “*kopitiam* politics”. I also take judicial notice of the fact that the word “*kopitiam*” has been used by foreign correspondents, for example, Jonathan Kent writing for the British Broadcasting Corporation, in a Saturday, 25 March 2006 article titled “The changing face of Malaysian politics” where he wrote:

“In Pulau Tikus on Penang Island there is a coffee shop - I forget its name - what locals call a *kopitiam*, in the *hokkien* Chinese dialect.”

36 The Singapore Tourism Board (“STB”) recognises that language is living and constantly evolving especially in a multiracial country like Singapore which has a rich potpourri of different languages and cultures. The STB has helped initiate a website on which a dictionary known as a “Singlish dictionary” lists local portmanteau words such as “*kopitiam*”. “*Kopitiam*” is an acknowledged local portmanteau word

commonly used to describe an eating place which has a drinks stall that serves beverages as well as other stalls which serve food. In a typical *kopitiam* setting whether in Singapore or Malaysia, the drinks stall is usually managed by the landlord or owner, who then leases the other stalls to independent stallholders who sell cooked food; not unlike the food court concept.

37 In Singapore, there are four official languages - English, Malay, Chinese (Mandarin) and Tamil. Besides these official languages, there are close to 20 other living languages used and these include the Chinese language dialects such as *Hokkien*, *Cantonese*, *Hakka* and others. In a multiracial society like Singapore where different languages are understood and used interchangeably and very comfortably by people of different races (and increasingly as Singapore becomes more globalised, by her residents of different nationalities); it would not be acceptable to allow any trader to monopolise commonly and frequently used descriptive words in the different official or living languages. Examples of such words would be “*Roti*” for bread, (“*roti*” being the commonly used Malay word for bread), “*Dhobi*” for laundry services (“*dhobi*” comes from a Hindi word meaning launderer) or “*teh peng*” for iced tea (“*teh*” means tea in Malay and “*peng*” means ice in the *Hokkien* dialect.) These sort of marks, which are merely common names for the goods (albeit in one of the commonly used languages in Singapore) are akin to the “soap” for soap example mentioned in the *British Sugar* case and clearly do not pass the capacity-to-distinguish threshold; hence they would be barred from registration under s 7(1)(a) of the Act.

38 Is “Kopitiam” the sort of word that will fall in this category of marks? Using the analogy given in the *British Sugar* case, would it fall within the category of cases where:

“ ..no matter how much use the Applicants made of the word “Kopitiam” as a purported trade mark for “cafés, cafeterias, canteens, provision of food and drinks; all included in Class 42”, would the word be distinctive of their services?”

39 The Applicants have led evidence to show that there has been substantial use of their mark since the date of application. The annual turnover from 1998 to 2002 is

an astounding six-fold increase from about SGD8million to SGD52 million. The advertisements, collaterals and promotional activities show that the Applicants have been actively using their mark over the years. The soap analogy given in the *British Sugar* case however, seems to indicate that in the assessment of “capacity-to-distinguish” under s 7(1)(a), the mark ought to be examined on its own without any consideration of prior use of the mark.

40 The mark on its own merits must be able to or serve to distinguish a proprietor’s goods or services from another proprietor’s; in other words, it must have the capacity to serve the essential function of a trade mark. Although the precedents and indeed, the Work Manual of the Intellectual Property Office of Singapore, have indicated that the “capacity-to-distinguish” threshold is a “relatively low threshold”, nevertheless s 7(1)(a) requires that any mark being considered for registration must be able to cross the capacity-to-distinguish threshold. In fact, it follows that a mark which does not have this primary distinguishing function also fails to have any inherent distinctiveness and will be absolutely barred from registration with no possibility of proving factual distinctiveness through use.

41 In the *British Sugar* case, Jacob J went on to say that in a “soap” for soap case, (where the mark was clearly one which lacked the “capacity-to-distinguish” and hence would also not have any inherent distinctiveness) “...[the manufacturer] could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark”.

42 I am of the view that word “*kopitiam*” used in relation to “cafés, cafeterias, canteens, provision of food and drinks; all included in Class 42” falls within the category of marks that do not satisfy the low threshold of capacity-to-distinguish under section 7(1)(a). In the assessment of the mark “Kopitiam” on its own *sans* any prior use, publicity or active promotion of the mark, when one says: “I am going to the kopitiam” or “I am going to a kopitiam”, would the Applicants’ outlets immediately spring to mind? I think not. Given the descriptive nature of the word “*kopitiam*” and how it is so commonly and generically used in the local parlance to mean an eating place or coffee shop which sells a variety of cooked food and beverages, the Applicants’ mark stripped of the evidence of use clearly lacks the

capacity to distinguish. The word “*kopitiam*” therefore ought not to be monopolised by anyone trader who desires to trade in services relating to provision of food and drink.

43 I find that the opposition therefore succeeds under the s 7(1)(a) ground of opposition.

Section 7(1)(b), (c) and (d)- inherent distinctiveness

44 As the mark has been held not to be able to cross the capacity-to-distinguish threshold, it follows that the sign is also inherently non-distinctive. In any event, even if the mark “Kopitiam” had cleared the first threshold, it would be difficult for the Applicants to overcome the test for inherent distinctiveness laid down by of Jacob J in the case *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, at page 306. The test is whether the descriptive word “Kopitiam” is the sort of sign which cannot do the job of distinguishing without first educating the public that it is a trade mark. As discussed under the s 7(1)(a) ground of opposition, “*kopitiam*” is a word that is highly descriptive of the kind of services that the Applicants seek to protect via registration. The word would not be automatically seen by members of the public as a badge of origin of the Applicants’ services. The Applicants’ evidence shows that a lot of money and effort went into the publicity and advertising of the mark, the intended outcome of which was to draw the connection between the Applicants’ services and the “Kopitiam” mark; in short to educate the public that it is a trade mark.

45 The “fair use defence” under section 28(1)(b) of the Act states that a person does not infringe a registered trade mark when he uses a sign to indicate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or the time of production of goods or of the rendering of services; if such use is in accordance with honest practices in industrial or commercial matters. The Opponents’ argument here is that if registration of their mark is granted, other traders who use the word “*kopitiam*” in a descriptive sense will have a defence under s 28(1)(b) against possible infringement proceedings. I find that the Opponents’ argument is untenable. Given the non-distinctiveness of the word, this would be akin to giving the Opponents an unfair advantage and placing an unnecessary burden on other traders wanting to legitimately use the descriptive word, which they would have

had a right to but for its registration. In situations where smaller traders are challenged by a cease-and-desist letter by the owner of such a mark, the practical preference would be to avoid the expense of potential litigation and drop the use of the mark in question. This outcome would not be desirable and would go against the fundamental principle that all traders should be free to legitimately describe their goods or services using ordinary words of the language; without the burden of wondering whether they have infringed on the rights of proprietors of registered trade marks.

46 The evidence lodged in the Opponents' statutory declaration showing that more than 200 companies had at some point applied to use the word "*kopitiam*" in their company or business name is consistent with the fact that it is a word descriptive of services relating to provision of food and beverage in Singapore. It confirms that the word "*kopitiam*" is perceived by traders to be a generic word that is ordinarily used by traders in this area of trade and that all traders should be at liberty to use it.

Ground of opposition under section 7(4)(b)

47 Having decided under the s 7(1)(a) ground of opposition that the Applicants' mark "Kopitiam" lacks the capacity to distinguish, I make no finding under this ground of opposition.

Ground of opposition under section 7(6): Bad Faith

48 The Opponents decided not to proceed under the section 7(6) ground of opposition.

Ground of opposition under section 8 of the Act

49 Section 8 is only applicable if there is an "***earlier trade mark***" which is claimed by the Opponents to belong to them. Section 2 of the Act defines "an earlier trade mark" as:

- (a) a registered trade mark or international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,
and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

50 The Opponents submitted that by virtue of s 2(7) read with s 2(1) of the Act, the Opponents' marks are well-known marks in Singapore and hence are earlier trade marks for the purposes of this opposition.

51 s 2(7) states that:

“Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

52 s 2 (8) goes on to add that “where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.”

53 The Opponents argued that the wording “as may be relevant” in s 2(7) indicates that the list is inclusive and the Opponents need not prove all the matters set

out in subsections (a) to (e). In relation to s 2(7)(b), the Opponents tendered evidence from 3 sources - independent sources, press releases and publications on the website – to show that their mark is well-known. The Opponents state that although no turnover figures or advertisement costs are exhibited in the evidence; there is evidence that the mark has been used since 1987; 12 years before the date of application of the Opponents’ mark. These include the press release about the opening of the restaurant and is dated 12 March 1987 and an article written for the Food Paper the date of publication of which is purportedly August 1987. (I use “purportedly” as the date was not printed as part of the article; rather it was handwritten on the same.) The Opponents state that their marks were used as early as 1986 when used in relation to the Opponents’ “KOPI TIAM” restaurant located at 80 Bras Basah Road, Singapore 189560. The restaurant’s many accolades in the local media and promotions over the years were also exhibited. Given the extent and duration of the Opponents’ use and the extensive promotion and advertising of the services, the Opponents submit that their marks are well-known in Singapore and are therefore earlier trade marks within the meaning of the Act.

54 I find that the Opponents’ evidence does not lead me to the conclusion that the Opponents’ mark is well-known in Singapore. The evidence is insufficient for such a finding. Further, the Opponents’ statutory declaration does not show any sales figures that would confirm the “extensive use, promotion and advertising” over the long period of use from 1987 that the Opponents have declared. No advertising or promotional costs were indicated either.

55 The Opponents are therefore not able to proceed under this ground of opposition as they have not shown that that they have an earlier trade registration which satisfies the definition in section 2 of the Act. The application for registration of their trade mark was filed in 2003, approximately 4 years after the date of application of the Applicants’ mark. As such it will not be necessary to deal with the issues of whether the application mark and the earlier trade marks are similar or whether there is a likelihood of confusion by virtue of the similarity of the services under this ground of opposition.

56 As the Opponents have not discharged the burden under s 8(2)(b) of the Act, the opposition under this ground therefore fails.

Grounds of opposition under s 8(4)(a) [now s 8(7)(a)] of the Act: Passing Off

57 Section 8(4)(a) [now 8(7)(a)] reads:

A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

58 Mr Geoffrey Hobbs Q.C. in the case of *WILD CHILD TM [1998] RPC 455* at page 460 states:

“The necessary elements of an action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods and services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

59 As I have found under the s7(1) ground of opposition that the word “*kopitiam*” is a word that fails to cross the capacity-to-distinguish threshold and that fundamentally it cannot be registered as a trade mark, it will be anomalous to conclude that the Opponents have goodwill in a mark that has no capacity-to-

distinguish. The Opponents’ mark as shown here -  - is essentially comprised of the word “KOPI TIAM” and Chinese characters of which the *hanyu pinyin* is “Ka Fei Dian” meaning “coffee shop”. The inclusion of the Chinese characters in the Opponents’ mark does not make the mark any more distinctive since the characters merely enhance the meaning of the portmanteau word “Kopi tiam” which means “coffee shop”.

60 Even if it had been possible to assess the passing off issue, it would be difficult to glean from the Opponents’ evidence whether the Opponents had goodwill in their mark. The Opponents’ evidence shows that their mark “KOPI TIAM” with

Chinese characters is almost always co-branded with the name of a hotel. The hotel's own trade marks, be it the "WESTIN hotels & resorts", "Westin Stamford", "Westin", "Raffles the Plaza" or "Swissotel the Stamford" usually appear in the publicity materials together with the Opponents' mark. In news articles, references to the Opponents' mark are usually couched as "Kopi Tiam in The Westin Stamford", "Kopi Tiam at Westin Stamford hotel", "Westin's Kopi Tiam" or "Westin Stamford's Kopi Tiam". The manner in which the marks have been presented in the evidence would make it difficult to conclude that the Opponents have goodwill in their mark alone.

61 I therefore make no finding under this ground of opposition.

Section 9 of the Act: Honest concurrent use

62 Similarly, I make no finding under this ground of opposition for the reason that the opposition having succeeded on the s 7(1)(a) ground effectively means that both the Opponents and the Applicants do not have any claim over the generic and non-distinctive word *kopitiam* used on services relating to the provision of food and drinks.

Conclusion

63 Having considered all the pleadings and evidence filed and the submissions made orally and in writing, I find that the opposition succeeds under section 7(1)(a) of the Act but fails under section 8(2)(b) of the Act. Each party is to bear its own costs of the proceedings.

Dated this 26th day of June 2008

Anne Loo
Principal Assistant Registrar
Registry of Trade Marks
For Registrar of Trade Marks
Intellectual Property Office of Singapore