

**IN THE MATTER OF TRADE MARK APPLICATION T04/22626A
BY MASTER BEVERAGE INDUSTRIES PTE LTD**

AND

**OPPOSITION THERETO BY
SOCIÉTÉ des PRODUIT NESCAFÉ SA**

*Before Principal Assistant Registrar Anne Loo
26 Feb 2009 & 20 March 2009*

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 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) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known in Singapore – whether the use of the Application Mark will indicate a connection between the Applicant’s goods or services and the proprietor of the earlier trade mark – whether the use of the Application Mark is likely to damage the interests of the proprietor of the earlier trade mark - Section 8(3A)(b)(i) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known to the public at large in Singapore – whether the use of the Application Mark will dilute in an unfair manner the distinctive character of the earlier trade mark – Section 8(3A)(b)(ii)(A) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known to the public at large in Singapore – whether the use of the Application Mark will take unfair advantage of the distinctive character of the earlier trade mark – Section 8(3A)(b)(ii)(B) 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.

This is an opposition against the trade mark application number T0422626A in Class 30, in respect of “coffee; tea; cocoa; beverages made from coffee, tea, cocoa or chocolate; beverages containing coffee, tea, cocoa or chocolate; coffee, tea, cocoa or chocolate based preparations for making beverages; ice beverages with a coffee, tea, cocoa or chocolate base; coffee, tea, cocoa or chocolate based beverages; flavoured tea; all being goods included in Class 30.”

The application is for a series of 2 marks as shown:



The Applicants is Master Beverage Industries Pte Ltd. Products bearing the Applicants’ mark were manufactured and packed in Singapore and thereafter exported and marketed overseas.

The Opponents SOCIÉTÉ des PRODUIT NESCAFÉ SA, a company incorporated in Switzerland of Vevey, Switzerland. The Opponents are one of the largest food and beverage producers and manufacturers in the world and have been heavily involved in the production and manufacture of foods in classes 30 and 32. The Opponents are registered proprietors of trade mark registration numbers T97/15458D in Class 30 and T97/15459B in Class 32 in Singapore. The marks are as shown below.



The Opposition proceeded on these four grounds: Sections 8(2)(b), 8(3A), 8(4)(a) and 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Held, allowing the application mark to proceed to registration:

1. On an assessment of the marks as wholes, the Applicants' marks are visually, aurally and conceptually dissimilar from the Opponents' marks. Based on the evidence, as that the Opponents' device marks have always been strongly co-branded with their house mark NESCAFÉ, it is unlikely that there would be a likelihood of confusion. Thus the ground of opposition under section 8(2)(b) fails.
2. The opposition under section 8(3A) is also not made out since under the section 8(2)(b) ground of opposition, it has been decided that the Opponents' and the Applicants' marks are not identical or similar.
3. The Opponents' evidence does not show that it is the Red Mug and Coffee Beans device marks per se that have garnered the substantial volume of sales. It is evident that the goodwill resides in the Opponents' NESCAFÉ marks and not the device mark bearing the Red Mug and Coffee Beans. Further for the same reasons that the Registrar had earlier found that there is no confusing similarity between the Opponents' earlier trade marks and the Applicants' marks under the section 8(2)(b), there is no misrepresentation by the Applicants leading or likely to lead the public to believe that goods offered by the Applicants are goods of the Opponents. As misrepresentation had not been established, it was not necessary to prove damage. The opposition under section 8(4)(a) also fails.
4. The Opponents have not set out what the Applicants have done or omitted to do which clearly points to bad faith. The Opponents' reiteration that the Applicants have no plausible reply to how the Application mark was derived and the speculation that it was deliberately chosen to unfairly capitalise on the Opponents' goodwill is merely an inference that there is bad faith; and this is not supported by any evidence. The Opponents have not discharged the burden of proving bad faith and the ground of opposition under section 7(6) fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 8(2), 8(3A), and 8(4) [re-numbered as section 8(4)(a) and section 8(7) respectively of the Trade Marks Act (Chapter 332) 2005 Revised Edition].

Cases referred to:

- The Polo Lauren Co. LP v Shop In Department Store Pte Ltd [2006] SLR 690
- British Sugar v James Robertson [1996] RPC 281
- Pianotist Co Ltd's Application (1906) 23 RPC 774
- Mrs Agnes Trouble v Crocodile International Pte Ltd [2005] SGIPOS 12
- The European Limited v The Economist Newspapers Limited [1996] FSR 431
- The Polo/Lauren Co. LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816
- Harker Stagg Ltd.'s Trade Mark [1953] 70 RPC 205
- Richemont International SA v Da Vinci Collections Pte Ltd [2006] 4 SLR 369
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- McDonald's Corp v Future Enterprises Re Ltd [2005] 1 SLR 177
- Associated Newspapers Ltd v Express Newspapers [2003] FSR 51

- Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV [1999] ETMR 690
- Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co) [2003] 4 SLR 92
- E!Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5
- Crown Confectionery, Co., Ltd v Morinaga & Co., Ltd. [2008] SGIPOS 12
- Hyundai Mobis v Mobil Petroleum Company, Inc. [2007] SGIPOS 12
- de Cordova v Vick. Chemical Co. (1951) 68 R.P.C. 103
- The Polo Lauren Co LP v. United States Polo Association [2002] 1 SLR 326
- Novelty Pte Ltd v Amanresorts Ltd and Another [2009] SGCA 13
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- AG Spalding & Bros v AW Gamage Ltd (1915) 32 RPC 273
- Newsweek Inc v British Broadcasting Corporation (1979) RPC 441
- Amanresorts Limited and Another v Novelty Pte Ltd [2008] 2 SLR 32
- Rolls-Royce Motors Ltd v Zanelli [1979] RPC 148
- British Legion v British Legion Club (Street) Ld (1931) 48 RPC 555
- Lloyd's v Lloyd's (Southampton) Ld (1912)29 RPC 433
- Da Vinci Trade Mark [1980] RPC 237
- Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341
- Lifestyle 1.99 Re Ltd v \$1.99 Pte Ltd [2000] 2 SLR 766
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and another appeal [2000] 3 SLR 145
- Nation Fittings (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR 712
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] A.C. 731
- WILD CHILD TM [1998] RPC 455
- Gromax Plasticulture Ltd v Don & Low Nonwovens J [1999] RPC 367
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Harrison v Teton Valley Trading Co Ltd [2004] 1 WLR 2577
- Twinsectra Ltd v. Yardlev [2002] 2 AC 164
- Barlow Clowes International Ltd (in liquidation) and Ors. v. Eurotrust International Ltd [2005] UKPC 37
- George Raymond Zage III and Anor v. Rasif David and Ors [2008] SGHC 244
- Royal Enfield Trade Marks [2002] RPC 24
- Weir Warman Ltd v Research & Development Pty Ltd [2007] SGHC 59
- Davy v Garrett (1877-78) L.R. 7 Ch.D. 473

Representation:

- Ms Elaine Tan (Messrs Amica Law LLC) for the Applicants
- Ms Karol Goh with Mr Arthur Yap (Messrs ATMD Bird & Bird) for the Opponents