

**IN THE MATTER OF TRADE MARK APPLICATION T05/21789D
BY SOCIETE DES PRODUITS NESTLE S.A.**

AND

**OPPOSITION THERETO BY
NUTRICIA INTERNATIONAL B.V.**

*Before Principal Assistant Registrar Ms Lee Li Choon
08 June 2009*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark should be refused registration under Section 7(1) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – whether the Application Mark is devoid of distinctive character - Section 7(1)(b) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – whether the Application Mark consists exclusively of signs or indications which may serve, in trade, to designate the intended purpose or other characteristics of the goods – Section 7(1)(c) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – whether the Application Mark consists exclusively of signs or indications which have become customary in the bona fide and established practices of the trade – Section 7(1)(d) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

This is an opposition against the trade mark application T05/21789D by Societe Des Produits Nestle S.A. for the word mark, “PROTECT” in class 5 for use on “Dietetic foodstuffs and substances for medical and clinical purposes; food and food substances for babies, milk for infants, milk for babies, milk substitutes for babies; food and food substances for medical purposes for children and the sick; foods and food substances for medical use for nursing mothers; nutritional and dietetic supplements for medical use; vitamin preparations, preparations made with minerals; dietetic confectionery for medical use”.

The Opponents, Nutricia International B.V. are a specialist baby food and clinical nutrition company, and manufacturers and retailers of products ranging from infant milk formula to specialized nutrition products. In Singapore, some of the brands of these products distributed by the Opponents’ sister company, International Nutrition Company Ltd, include the range of Dumex, Mamex and Mamil brands.

Held, disallowing registration:

1. The word, “PROTECT” does not have intrinsic or inherent features or characteristics that are sufficiently unique to enable it to immediately function as a readily obvious and reliable badge of origin when used in relation to milk, foodstuff and dietetic substances such that the average consumer is able to differentiate the Applicants’ goods from those originating from other traders. In addition, the extensive adoption and ubiquitous use of the notion of “protect” by other traders in this industry makes it doubtful that the average discerning consumer will immediately identify the Applicants to be the source of milk, foodstuff and dietetic substances bearing the mark, “PROTECT”. Thus, the Application Mark is devoid of distinctive character and is to be refused registration under section 7(1)(b) of the Act.
2. From the evidence lodged, it is clear that when buying such goods, especially for infants or young children, one primary “intended purpose” from the perspective of the purchaser is the quality of the product in terms of its ability to “protect” the health of the infant or child consuming it. “PROTECT” is also descriptive of a characteristic of the goods. Thus, the Application Mark consists exclusively of a sign which may serve, in trade, to designate the intended purpose or other characteristic of the goods in question and is thus refused registration under section 7(1)(c) of the Act.
3. The fact that “PROTECT” designates the intended purpose or is descriptive of a characteristic of milk, foodstuff and dietetic substances does not necessarily make it a generic term thereof. The Opponents have not compiled a sufficiently convincing body of evidence for the Registrar to reach a finding that “PROTECT” has become customary in the current language or in the bona fide and established practices of the trade. Accordingly, the Opponents failed to establish that the word mark, “PROTECT” must be refused registration under section 7(1)(d).

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 7(1)(b), 7(1)(c), 7(1)(d).

Cases referred to:

- *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2008] SGHC 158 (High Court)
- *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Another and Another Appeal* [2009] SGCA 9 (Court of Appeal)
- *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281
- *P.R.E.P.A.R.E Trade Mark* [1997] RPC 884
- *Uni-Charm Corporation v The Proctor & Gamble Company* [2003] SGIPOS 12
- *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehor Walter Huber and Franz Attenberger* [1999] ECR I-2779
- *OHIM v Wrigley Jr Company Case C-191/01P* (“DOUBLEMINT”)
- *Ford Motor Co v OHIM Case T-67/07*
- *PROFITMAKER TRADE MARK* [1994] R.P.C.613
- *Merz & Krell GmbH & Co* [2001] ECR I-6959
- *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] RPC 28

Representation:

- Ms Yvonne Tang (Drew & Napier) for the Opponents.
- Ms Gooi Chi Duan (assisted by Mr Chua Shang Li) (Donaldson & Burkinshaw) for the Applicants.