

## Intellectual Property Office of Singapore Case Summary: Application by OOO "TVM Trade" to strike out notice of opposition and objection thereto by Societe De Produit Nestle SA [2014] SGIPOS 12

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<http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>

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This case addresses the issue of whether the Intellectual Property Office of Singapore ("IPOS") has the power to strike out a notice of opposition. This action allows an aggrieved party (in this case, the applicants) to bring an end to proceedings without having to incur further time and costs to gather and present evidence, and to argue the case before IPOS at a full hearing.

### **Brief Facts**

OOO "TVM-Trade" ("**the Applicants**") applied to register  ("**Application Mark**") for coffee and related products.<sup>1</sup> Societe De Produit Nestle SA ("**the**

**Opponents**") opposed the registration relying on their prior rights in  and



, which are registered for identical and similar products.<sup>2</sup>

Societe des Produit Nescafe SA had previously unsuccessfully opposed an application by Master Beverage Industries Pte Ltd ("**MBI**") to register a similar mark



(comprising a series of two marks)  ("**Prior Mark**") for identical and similar products.<sup>3</sup> The Applicants assert that MBI had assigned the Prior Mark to them. They argue that the doctrine of *res judicata* applies, i.e, the Opponents should not be allowed to start proceedings again for something which had already been adjudicated upon previously.

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<sup>1</sup> The full list of goods applied for are "artificial coffee; chocolate; chocolate beverages with milk; chocolate-based beverages; cocoa; cocoa beverages with milk; cocoa products; cocoa based beverages; coffee; coffee beverages with milk; coffee-based beverages; flavourings, other than essential oils, for beverages; iced tea; tea; tea-based beverages; unroasted coffee; vegetal preparations for use as coffee substitutes" in Class 30.

<sup>2</sup> Specifically, the first mark relied on is registered for "coffee and coffee extracts; coffee substitutes and extracts of coffee substitutes" in Class 30 and " Non-alcoholic beverages containing coffee " in Class 32, while the second mark is registered in Class 30 for "coffee".

<sup>3</sup> The Prior Mark was applied for 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."

## **Decision**

### **1. IPOS does not have power to strike out a notice of opposition.**

IPOS derives its powers from the Intellectual Property Office of Singapore Act (“**the IPOS Act**”), and for trade mark matters, the Trade Marks Act (“**the TM Act**”) and Trade Marks Rules (“**the TM Rules**”) as well. There are no provisions in any of these statutes which give IPOS the power to strike out a notice of opposition.

This is in contrast to the High Court and State Court, which, under Order 18 rule 19 of the Rules of Court, are expressly empowered to strike out a claim, if the criteria under Order 18 rule 19 have been met. As there is no equivalent to this provision in the TM Act or TM Rules, there are no factors to guide IPOS as to when it would be appropriate to strike out an opposition, which itself indicates that IPOS has no such power. Further, it is not possible for an opponent to appeal to the High Court against a decision by IPOS striking out a notice of opposition, although such a decision would bring proceedings to an end.

It would appear from all the above that it was a deliberate decision by the legislature that such a power should not be conferred on IPOS.

### **2. It is not appropriate to strike out the notice of opposition in the current case.**

Even if IPOS is empowered to strike out a notice of opposition, the Applicants would still have to show that the circumstances are so clear as to merit the striking out of the opposition summarily without giving the Opponents the opportunity of a full hearing.

The Applicants argue that the doctrine of *res judicata* applies, and the Opponents should not be permitted to “re-litigate” this matter.

However, the Opponents in the current opposition proceedings are different from the opponents in the earlier proceedings (i.e. MBI); the Opponents and MBI are currently engaged in litigation in respect of the assignment and ownership of the Prior Mark. Furthermore, the current opposition relates only to the Application Mark. It is clear that the outcome would not have any impact on the registration of the Prior Mark.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>.*