

# Intellectual Property Office of Singapore Case Summary: Société Des Produits Nestlé S.A. v Liwayway Marketing Corporation [2014] SGIPOS 5

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

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Since the recent, seminal Court of Appeal decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911, this is the first decision of the Registrar of Trade Marks that substantively applies the changes to the 3-step test under Section 8(2)(b) of the Trade Marks Act.



The applicants applied to register the trade mark  in Classes 29<sup>1</sup> and 30<sup>2</sup> (the "Application Mark"). The opponents opposed the registration, arguing that the Application Mark was confusingly similar to their earlier trade

marks  ,  ,  and  (the "SMARTIES Marks") which were already registered in respect of identical or similar goods.

The Registrar of Trade Marks held that the Application Mark was not similar to the SMARTIES Marks overall. They were visually and conceptually dissimilar, and any aural similarity was traded off against these dissimilarities such that on the whole, the marks were more dissimilar than similar. Further, even if the respective marks could be said to be similar, the opponents still could not establish a reasonable likelihood of confusion. This was partly because the goods in common, such as chocolate confectionery, and other foods such as jellies, jams, milk, coffee, tea, cocoa, sugar, rice and cakes are generally available off the shelf and tend to be bought on a regular basis, such that the consumer is used to identifying the brand of his choice from an array of options on the same few shelves where the same or similar goods under competing brands are displayed. The upshot of this is that the purchasing public will have opportunity to exercise care to select and help themselves to the goods off the shelves without the need to, for example, articulate the marks "MARTY'S" or "SMARTIES" and have the goods handed to them by sales assistants. Hence, the visual and conceptual aspects of the Application Mark and the Opponents' SMARTIES marks are more dominant than the aural aspects in the marketplace. Accordingly, the visual and conceptual dissimilarities between the marks bear more heavily on the consumer's perception at the point of selection and purchase, than does any aural similarity; and the consumer is not reasonably likely to be confused.

The opponents also failed in their ground under passing off under Section 8(7)(a) of the Trade Marks Act, for largely similar reasons.

The Application Mark could therefore proceed to registration.

*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>.*

<sup>1</sup> Class 29: Preserved, dried and cooked fruits and vegetables; jellies, jams; eggs; milk and other dairy products; edible oils, fats; preserves, pickles; meat, fish, poultry and game; meat extracts.

<sup>2</sup> Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; pepper, vinegar, sauces; spices; ice.