

Intellectual Property Office of Singapore Case Summary: Aalst Chocolate Pte Ltd v The Pâtissier LLP [2019] SGIPOS 7

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In this dispute, the validity of a trade mark registration is challenged on the grounds of descriptiveness and non-distinctiveness. The twist in the tale is that the challenged mark has a French word element, which leads to a consideration of how the average consumer in Singapore would perceive the mark.

The Pâtissier LLP is the Registered Proprietor (“the Proprietor”) of the following trade mark:

The Pâtissier

(“the Subject Mark”)

The Subject Mark was registered on 27 September 2005 (“the Relevant Date”) under Trade Mark Nos. T0518520H (in Class 30) and T0518521F (in Class 35) with the following details:

Trade Mark No.	Application Date	Class
T0518520H	27 September 2005	30
Specification		
Bread, biscuits, cakes, pastry, cookies, bakery products, food mixes for making bakery products, pralines, puddings, tarts, frozen desserts, sweets, chocolates, non-medicated confectionery, toffees, candies, sweetmeats, ices; ice cream cake; edible sandwiches for consumption, meat pies, quiches, chips [cereal products], coffee, tea, cocoa, flour and preparations made from cereals; all included in Class 30.		

Trade Mark No.	Application Date	Class
T0518521F	27 September 2005	35
Specification		
The bringing together, for the benefit of others, of a variety of goods, namely cakes, tarts, chocolates, confectioner's items, bakery products, pastry, biscuits, sandwiches for consumption off the premises, meat pies, quiches, coffee, tea, sweets, enabling customers to conveniently view and purchase those goods in a retail store, from a general merchandise catalogue by mail order or by means of telecommunications; all included in Class 35.		

Aalst Chocolate Pte Ltd (“the Applicant”) applied for declarations of invalidity against both registrations above. This action is but one of the several between the same parties. As reported in [2019] SGIPOS 6, the Applicant in the present case was unsuccessful in its defence against the Proprietor’s application for revocation in relation to the former’s own



registered mark,

Back to the present invalidation dispute, there is no law or established practice in Singapore, in the context of trade mark examination, opposition and post-registration challenge, that marks in a non-English language are automatically, necessarily translated into English for their meaning under an inquiry based on the absolute grounds under Section 7(1) or the relative grounds under Section 8 of the Act. Where a non-English word is involved, the starting point is to ask whether its meaning will be understood in Singapore by the average consumer of the relevant goods or services at the relevant date. This is the case whether the non-English language is one of Singapore’s official languages (e.g. Chinese) or not (e.g. French, in the present case).

The Principal Assistant Registrar considered the parties’ evidence, including media features on the Proprietor, business listings and dictionary entries, and concluded that the Applicant has not established that the average consumer in Singapore, being a member of the general public, would understand the Subject Mark (especially the French word element “Pâtissier”) to have a meaning in Singapore at the Relevant Date. As such, it was found that the Subject Mark was not likely to be understood by the consumer as a descriptor of a characteristic of the goods and services claimed. The ground of invalidation alleging descriptiveness (under Section 7(1)(c) of the Trade Marks Act) therefore failed. Likewise, the ground of invalidation alleging non-distinctiveness (under Section 7(1)(b) of the Trade Marks Act) also failed.

This case relied extensively on the High Court decision in **Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd** [2018] 5 SLR 312 (“**Big Box**”), where the trade mark “BIG BOX” was also challenged on grounds of descriptiveness and non-distinctiveness. As in **Big Box**, the present decision also recognised the practical difficulties of proof which arise where the registration of a trade mark is attacked many years after registration on the basis of invalidity at the date of registration.

Notwithstanding this decision on the registrability of the Subject Mark, if the evidence is that the trade mark has become the common name in the trade for the product or service in respect of which it is registered due to the acts or inactivity of the proprietor, the solution would be to seek revocation of the registration under Section 22(1)(c) of the Trade Marks Act instead. The present proceedings are different in nature, involving applications for declarations of invalidity, based on Section 23(1), and the state of affairs at the Relevant Date (almost 14 years ago in 2005) is most relevant. What other traders and businesses adopt as part of their trade or business name *after* the Relevant Date is a separate matter, and this decision does not go so far as to adjudicate those issues not before the Principal Assistant Registrar.

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 <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/aalst-chocolate-v-the-patisserie-2019-sgipos-7.pdf>.