

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Nos. T0518520H and T0518521F
Hearing Dates: 7 January 2019, 10 January 2019

IN THE MATTER OF TRADE MARK REGISTRATIONS

**IN THE NAME OF
THE PATISSIER LLP**

AND

APPLICATIONS FOR DECLARATION OF INVALIDITY

THEREOF BY

AALST CHOCOLATE PTE LTD

Hearing Officer: See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Representation:

Mr Darrell Low, Mr Samuel Wee and Ms Jacinth Chua (Yusarn Audrey) for the Applicant

Ms Teresa O'Connor and Ms Gillian Tan (Infinitus Law Corporation) for the Registered Proprietor

GROUND OF DECISION

1 Globalisation makes its relentless march into the corners of the earth. On economic and political fronts, its challenges are keenly felt. Globalisation on the social front is no less pervasive. Whether it be food, fashion, or fun, the ease of travel and

proliferation of Internet access has broken down geographical barriers. The foreign becomes familiar; the exotic becomes everyday – almost.

2 This phenomenon puts the robustness of our legal framework to the test. How far can enterprising, local businesses borrow vocabulary from foreign languages for their trade marks, without diminishing competition to the extent that society suffers for it? The answer would differ in each case.

3 The Patisserie LLP is the Registered Proprietor (“the Proprietor”) of the following trade mark in Singapore:

The Patisserie

(“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.		

The above specification of goods shall be referred to as “the Class 30 Specification” in these grounds of decision.

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.		

The above specification of services shall be referred to as “the Class 35 Specification” in these grounds of decision.

4 Aalst Chocolate Pte Ltd (“the Applicant”) applied for declarations of invalidity¹ (“the Applications”) on 2 January 2018. Counter-statements were filed by the

¹ Applications for declarations of invalidity are distinct from applications for revocation. The former has to do with the challenged mark’s registrability on the date of the application for registration. The latter has to do with events occurring after the completion of registration, for example non-use of the

Proprietor on 12 April 2018 in defence of the registrations of the Subject Mark. The Applicant filed evidence in support of its Applications on 21 May 2018. On the same day, the Registrar confirmed that the Applications were consolidated. The Proprietor filed evidence in support of the registrations on 2 July 2018. The Applicant filed evidence in reply on 23 July 2018. Following the close of evidence, leave was granted to the Proprietor to file supplementary evidence, and it did so on 6 September 2018. The parties initially disagreed on issues pertaining to the cross-examination of the Proprietor's witness. They eventually resolved their disagreement – this entailed the Registrar giving leave to the Proprietor to file further supplementary evidence; and it did so on 9 November 2018. The parties then filed their written submissions (“Written Submissions”) on 10 December 2018. The hearing spanned two days. On 7 January 2019, the Proprietor's witness, Tan Siang Oon, gave oral evidence under cross-examination and re-examination. Counsel for both parties then made oral submissions before me on 10 January 2019.

Grounds of Invalidation

5 The Applicant relies on two grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). They are Sections 7(1)(b) and 7(1)(c); both read with Section 23(1) of the Act².

Applicant's Evidence

6 The Applicant's evidence comprises a statutory declaration (“Applicant's 1st SD”) and a statutory declaration in reply (“Applicant's 2nd SD”) made in Singapore by Kwan Hoi Chee Deborah Connie, Chief Operating Officer and Director of the Applicant, on, respectively, 14 May 2018 and 23 July 2018.

Proprietor's Evidence

7 The Proprietor's evidence comprises a statutory declaration (“Proprietor's 1st SD”), a supplemental statutory declaration and a further supplemental statutory declaration by Tan Siang Oon, one of the founders and the manager of the Proprietor. These three statutory declarations were made in Singapore on, respectively, 29 June 2018, 6 September 2018 and 8 November 2018.

8 The Proprietor's evidence additionally comprises oral evidence given by the same Tan Siang Oon at the hearing on 7 January 2019.

Applicable Law and Burden of Proof

9 The applicable law is the Act, and in accordance with Section 101(c)(i) of the Act, *“the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration”*. As a starting point, the undisputed burden of proof in this case falls on the Applicant.

challenged mark for an uninterrupted period of 5 years, or the challenged mark becoming the common name in trade.

² Section 23(1) of the Act states: The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7. The specific grounds under Section 7 are dealt with substantively in this decision.

10 In addition, on the issue of burden of proof in applications for declarations of invalidity, the High Court observed in *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2018] 5 SLR 312 (“*Big Box*”) at [17] that:

... The IP Adjudicator rightly held at [7] of his decision that the burden in the present case fell on the Applicant to prove the ground of invalidity on the balance of probabilities. In the event that the Applicant satisfies that burden, in order to avoid a declaration of invalidity, the burden of proof would shift to the Proprietor under s 23(2) of the Act to show, again on the balance of probabilities, that the Subject Mark has in fact acquired distinctiveness as a result of use by the Proprietor since its registration.

11 The relevance of the point to the outcome of this dispute will be appreciated at [68]-[71] and [81] below.

Background

12 The Applicant is a Singapore company in the business of the manufacture and sale of chocolate and chocolate-related products.

13 The Proprietor is also a Singapore company. It is a boutique bakery, first opened in Ann Siang Road, and now operates its business at Mohamed Sultan Road. In lieu of traditional forms of advertising and marketing, the Proprietor runs a membership programme which gives members exclusive discounts. It also maintains an active online presence through Facebook (www.facebook.com/ThePatissierLLP), its website (www.thepatissier.com) as well as its blog hosted on its website (www.thepatissier.com/blog). The Proprietor enjoys patronage from corporate customers, such as banks (e.g. UBS, Credit Suisse) and motor dealers (e.g. Maserati and Ferrari dealers). These customers routinely purchase the Proprietor’s cakes in substantial amounts for their upper tier customers.

14 The same parties are no strangers to each other, being involved in several other proceedings before the Registrar of Trade Marks. The Proprietor has recently succeeded in its application to revoke the Applicant’s Trade Mark No. T0626526D³



on grounds of non-use. The Applicant has also filed two trade mark



applications, for under TM No. 40201719808V and for under TM No. 40201719809S on 11 October 2017; these are currently under opposition by the Proprietor.

MAIN DECISION

General Approach

³ [2019] SGIPOS 6

15 In **Big Box**, the approach to issues of distinctiveness was set out by Wei J at [36]-[37]:

36 The general principles on distinctiveness are well established. Distinctiveness is the concept underlying ss 7(1)(b), (c) and (d) of the Act. That said, each ground must be assessed independently in relation to the proposed mark and the relevant goods and services and in light of the public interest underlying each ground: see Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) (“*Leong on IP*”) at para 28.076.

37 Ultimately, the question whether a trade mark lacks distinctiveness is essentially one of degree and judgment. Some trade marks may comprise signs which are patently descriptive of the product or service in question or which bear an obvious and direct reference to the quality of the goods or services. In other cases, the descriptive content or allusion to quality, *etc.*, may be nuanced, subtle or less obvious. Indeed, at the other end of the spectrum are signs which are entirely meaningless (in themselves) or whose meanings are counter-intuitive in terms of the character, quality, geographical origin or nature of the goods or services.

16 At [47] of the same decision, Wei J also cited ***Love & Co Pte Ltd v The Carat Club Pte Ltd*** [2009] 1 SLR(R) 561 (“*Love & Co*”), at [35], where Chan J summarised the inquiry as:

... whether the average discerning consumer operating in that market place and environment can readily and immediately identify the trade mark viewed as a whole to be unequivocally designating the goods or services originating from the particular trader when he first encounters the trade mark on the goods or services – or will the average discerning consumer be unclear or uncertain as to the commercial source or origin of the goods or services nevertheless.

The Average Consumer

17 Before delving into the central issues of descriptiveness and non-distinctiveness, I will deal with the antecedent issue of who the “average consumer” is.

18 The High Court in ***Big Box*** commented on the “average consumer” at [48(c)] as follows:

Third, in reaching the decision it is necessary to consider whether a notional and fair use of the Subject Mark in connection with the retail and other services for which it is registered would have fallen within all or any of the three grounds as at the Application Date by reference to “the perception of the average consumer of those goods or services, who is deemed to be reasonably well informed, observant and circumspect”, as explained by the Court of Appeal in ***Société des Produits Nestlé SA and another v Petra Foods Ltd and another*** [2017] 1 SLR 35 (“*Kit Kat*”) at [22(b)], citing *Kerly’s* at para 8-016.

19 I therefore consider the “*average consumer of (the) goods and services*” claimed under the Subject Mark. The relevant goods are found in the Class 30 Specification; and the services, in the Class 35 Specification.

20 The Class 30 Specification covers a spread of various (i) bakery products; (ii) confectionery; and (iii) pastry products. Examples include, respectively, (i) bread, cakes; (ii) toffees, sweetmeats; and (iii) tarts, quiches. Other goods falling in Class 30, such as coffee and tea, are also claimed in this specification.

21 The Class 35 Specification essentially covers retail services in relation to a range of bakery products, confectionery, pastry products, coffee and tea. The modes of provision of such services (“in a retail store, from a general merchandise catalogue by mail order or by means of telecommunications”) is specified but not of direct relevance to the inquiry here.

22 From the above goods and services, the nature of the “average consumer” can be arrived at. IP Adjudicator David Llewelyn succinctly summarises the significance of this – “*It is for and through this hypothetical person that distinctiveness must be assessed*”: see *Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.* [2018] SGIPOS 20 (“*Brent / Brent Index*”) at [16].

23 However, the parties have diametrically opposed positions on the nature of the “average consumer”, for understandable reasons.

24 Counsel for the Applicant drew my attention to several parts of the Proprietor’s 1st SD and sought to demonstrate that the Proprietor itself targets “high end” clients with “high end” products and pricing. [16] of the Proprietor’s 1st SD makes references to corporate clients and “high end” brands Maserati, Ferrari and Lamborghini⁴. The following exhibits of the Proprietor’s 1st SD were also highlighted by counsel for the Applicant:

No.	Exhibit No.	Page No.	Content	Year
1	TSO-9	276-277	<u>Article in The Business Times, “Sweet dreams are made of these”</u> The article states “The recent proliferation of small high-end bakeries is exemplified by The Patisserie...”	2001
2	TSO-8	247-248	<u>Interview (published on Spirit of Enterprise website) with Tan Siang Oon & Tan Siang Yee of the Proprietor as a Spirit of Enterprise Award Nominee</u>	2005

⁴ “The Registered Proprietor’s other corporate clients include StarHub, Development Bank of Singapore, HSBC Corporate Banking, Philip Morris, Hong Seng Motors (for all owners of Maserati Cars), Ital Auto (for all owners of Ferrari cars), Eurosports Auto (for all owners of Lamborghini cars).”

No.	Exhibit No.	Page No.	Content	Year
			In response to the question “How does your business work?”, the Proprietor says “We target mainly the high-end customers and corporate businesses.”	
3	TSO-9	298	<u>Article in The New Paper, “From hip to homey”</u> The article states “Upscale restaurants and residential amenities, like a cake shop...” and “...The Patisserie, an upmarket cake shop...”	2006
5	TSO-9	379-381	<u>Article in The Straits Times, “BABY, YOU CAN BAKE”</u> The article states “High-end bakery The Patisserie also started offering two baking courses...”	2008
6	TSO-8	251-252	Singapore Tatler Best of Singapore presents The Patisserie with the Best Bakers & Patisseries Award “...as selected by the readers and editors of Singapore Tatler.”	2011, 2014

25 Based on the above, the Applicant’s position is that the relevant consumers are people in the “high-end” space. My attention was also drawn to **Brent / Brent Index**, where, at [17], the IP Adjudicator concluded that the relevant consumers in that case were “*financial services professionals and investment-savvy individuals, in Singapore*”. He elaborated in the same paragraph that “*For the avoidance of doubt, I emphasise that this is not a case in which the man and woman on the MRT is the requisite standard and I would not expect such a person would have the same perceptions of and reactions to the BRENT mark as would the financial services professionals and investment-savvy individuals that are pertinent in deciding these Applications.*” The Applicant would have me agree that this is also the case in the present action.

26 Counsel for the Proprietor disagreed. She pointed out that it was very common for cakes and confectionery (claimed in the Class 30 Specification) to be purchased by people from all walks of life. The potential range of consumers, given the nature of the goods, was very broad. Further, she highlighted that the Proprietor’s evidence was adduced from widely read publications like The Straits Times and Lianhe Zaobao, which are available to the general public and not only to the higher social stratum. She also referred to **Love & Co**, where Chan J opined at [33] that:

An “immediately registrable trade mark” must have a “distinctive character” status and it is immediately capable of distinguishing the goods or services of a trader from those of other traders, in the sense that it can immediately function

as a clear badge of origin of that trader, unequivocally identifying, designating and differentiating the goods or services of that trader from those of the others in the relevant market place and environment, when viewed from the eyes of the hypothetical average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (the “*average discerning consumer*”). (Underlined emphasis mine)

27 In particular, counsel for the Proprietor identified the perspective relevant to an assessment of distinctiveness. This is “*the hypothetical average consumer of the category of goods or services in question*”. She submitted that one should look at the category of goods and services, and not limit the goods and services to “high end” ones, because this is not mentioned in the specifications. **Brent / Brent Index** was also distinguished because the Class 36 services claimed in that case were very specific to the financial sector.

28 Of pertinence in the above phrase from *Love & Co* is the word “category”. As such, at the hearing, I asked for the Applicant’s comment on the Proprietor’s foregoing argument and reliance on *Love & Co*. Counsel for the Applicant submitted that Chan J only said “category”, not “class” nor “specification”, in the phrase “*the hypothetical average consumer of the category of goods or services in question*”. He ventured that the term “category” could not be detached from the intended purpose of the goods. Since the Proprietor has declared that it catered to the high end market, the evidence should be seen in that light.

29 I am inclined to think that the notional specification of goods or services is in view in the phrase “*the hypothetical average consumer of the category of goods or services in question*”, rather than the specific goods sold by the trade mark proprietor in connection with its marketing strategy. In a different (but relevant, in that it relates to a consideration of goods and services claimed) context under Section 8(2)(b) of the Act, the Court of Appeal in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), also made clear, at [40], that “*it is not within the scheme of the classification system to make distinctions within a specification based on whether the particular product is targeted at one or another market segment.*” Thus, for example, “*Hotel services are hotel services, whether these concern a luxury hotel or a more modest one*” (*Staywell* at [41]).

30 Looking at the issue from another angle, I also observe Chan J’s emphasis at [53] of *Love & Co* that:

the assessment is made by examining the trade mark and its meaning (if any), ***absent any consideration of its use, promotion or marketing by the promoter of the trade mark***, as will be reasonably perceived and understood at the relevant date by the average discerning consumer of that category of goods or services...

31 Again, the word “category” is used in the above paragraph, in connection with a guide to how the assessment of distinctiveness should and should not be made – it should not be made with any consideration of the actual “*use, promotion or marketing*” of the trade mark. This corroborates my inclination above that the average consumer should be derived from a notional apprehension of what has been claimed in the

specification, rather than from how the trade mark has (apart from the specification) in fact been used, promoted or marketed.

32 Thus, in the present case, one should have regard to the notional specifications of goods and services in respect of which the Subject Mark is registered. These have been described above and include bakery products, pastry products, coffee etc. and retail services relating thereto. Nothing in the Class 30 Specification and the Class 35 Specification qualifies the goods and services as being pitched at the high end of the market. The goods and services covered are generic, e.g., “cakes” and not “upmarket cakes”.

33 As such, the average consumer would be the general public, or, as IP Adjudicator David Llewelyn more colourfully puts it in *Brent / Brent Index*, “the man and woman on the MRT”. Such would be the ordinary consumer of the goods in the Class 30 Specification and the services in the Class 35 Specification. Such a person “is reasonably well informed and reasonably observant and circumspect”, as Chan J opined in *Love & Co.*

34 This is an important preliminary point, because it has a bearing on how the Subject Mark is perceived⁵.

The Subject Mark

The Pâtissier

35 The Subject Mark, *The Pâtissier*, comprises two words in cursive font. The first word, “The”, is a word in the English language. The second, “Pâtissier”, is derived from the French word “Pâtissier” (with the accent over the letter “a”). Both parties accept the meaning of “Pâtissier” as “pastry chef”. The Subject Mark may be treated as a combination of English and French words⁶.

36 Having addressed the antecedent issues of this dispute, I turn my mind to the grounds of invalidity canvassed in these applications.

Ground of Invalidation under Section 7(1)(c): Descriptiveness

37 Section 7(1)(c) of the Act reads:

(1) The following shall not be registered:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services

⁵ For example, the Applicant submits, at [15] of its Written Submissions, and at the oral hearing, that “the relevant average consumer who purchases such high-end bakery products would understand the meaning of “PATISSIER”...”. In contrast, the unspoken suggestion is that the average consumer who purchases general bakery products (not particularly high-end) may not necessarily understand the meaning of the French word.

⁶ See elaboration below at [48] on why this is the case.

Decision on Section 7(1)(c)*Relevant Principles*

38 The relevant principles under this ground have been summarized in *In the Matter of a Trade Mark Application by Marvelous AQL Inc.* [2017] SGIPOS 3 (“*Marvelous*”), at [29], referencing Mellor, Llewelyn, et. al., *Kerly's Law of Trade Marks and Trade Names* (15th Edition), Sweet & Maxwell (2011).

39 I set out the principles found in the latest edition of Mellor, Llewelyn, et. al., *Kerly's Law of Trade Marks and Trade Names* (16th Edition), Sweet & Maxwell (2018) (“*Kerly's*”) at [10-101], pp 301 – 303, as adapted to Singapore’s legislation set out in square brackets:

- (1) [Section 7(1)(c)] is in the public interest, *to ensure that descriptive terms may be freely used by all ...* Recently, the Court of Justice has taken to referring to the “general interest” underlying the provisions in [Section 7(1)(c)], rather than the public interest.
- (2) The signs and indications referred to in [Section 7(1)(c)] are those which may serve *in normal usage from a consumer’s point of view* to designate, *either directly or by reference to one of their essential characteristics*, goods or services such as those in respect of which registration is sought.
- (3) The situations specifically covered by [Section 7(1)(c)] are those in which the sign *is capable of* designating a “characteristic” of the goods or services referred to in the application. The terms mentioned in [Section 7(1)(c)] must all be regarded as characteristics, but the list is not exhaustive.
- (4) The provision extends to *any characteristic whatsoever* of goods or services, *irrespective of how significant the characteristic may be commercially*.
- (5) The property (or characteristic) in question must be easily recognisable by the relevant class of persons.
- (6) It is *not necessary that such descriptive terms are actually in use*, it is *sufficient that such signs and indications could be used* to designate a characteristic of the goods or services.
- (7) Accordingly, a sign must be refused under [Section 7(1)(c)] *if at least one of its possible meanings* designates a characteristic of the goods or services concerned.
- (8) Likewise, *it is irrelevant if there are other, more usual signs or indications for designating a particular characteristic* of the goods or services. These provisions *do not require that the sign or indication under examination should be the only way of designating the characteristic in question...* It is irrelevant if there are synonyms. It follows that [Section 7(1)(c)] *does not require the sign at issue to be the usual means of designation*.

- (9) As a general rule, *a mere combination of elements, each of which is descriptive of characteristics of the goods or services, itself remains descriptive. However, the combination may not be descriptive if there is a perceptible difference between the resultant combination and the mere sum of its parts...*, where *the unusual nature of the combination in relation to the goods or services creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts... or the combination has acquired its own meaning, with the result that it is now independent of its components.*
- (10) The existence of a specific defence [Section 28(1)(b)] does not limit the scope of [Section 7(1)(c)]. In fact the existence of the defence discloses the need for [Section 7(1)(c)] to be applied to any sign which may designate a characteristic of the goods or services for which registration is sought.
- (11) “Exclusively” requires a purposive approach.

(emphasis added)

Parties’ Submissions

40 In light of the observations of the Subject Mark above, the Applicant submitted that the relevant average consumer who purchases the Proprietor’s high-end bakery products would understand the meaning of “pâtissier” (pastry chef) and view the word as alluding to a person who makes pastries and related products and/or such a person who works in a store selling such products. The Applicant contended that there is an association between “pâtissier” and (i) pastries; (ii) a retail store that sells pastries. The Subject Mark is therefore descriptive of the goods and services in respect of which it is registered.

41 The Proprietor submitted that the Subject Mark refers to a person having the qualification of a professional pastry chef. In the English and/or French language, it would be wrong to refer to a cake or a cake shop as being “the pâtissier” or “pâtissier”, because “pâtissier” describes the *person*, not the *product* nor the *shop* from which the product is sold. The shop may be referred to as a “pâtisserie”⁷. There is therefore no direct descriptiveness here. The Proprietor emphasized that the Registrar must consider the actual words in the Subject Mark, citing the decision in *CBR Textile GMBH v IC Companys A/S* [2010] SGIPOS 7, where the Principal Assistant Registrar found that the addition of the letter “S” to the word “COMPANY” caused the registered mark “COMPANYS” as a whole to be perceptibly different from “COMPANY” or “COMPANIES” and provide sufficient inherent distinctive characteristic to “COMPANYS”.

Perception of Marks in a Non-English Language: Principle

⁷ In France, “pâtisserie” is a controlled title that can only be used by bakeries that employ a licensed master pastry chef. Loosely speaking, a pâtisserie denotes a pastry shop or bakery which sells cakes made by a highly skilled pastry chef. See [36] of the Proprietor’s 1st SD and [18] of the Proprietor’s Written Submissions.

42 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.

43 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). This approach was taken in *Starwood Hotel & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Limited* [2018] SGIPOS 11 at [69] in relation to the Chinese word element “柏•伟诗酒店”⁸. The same approach was also adopted in relation to Spanish word elements in *Ex Hacienda Los Camichines, S.A. de C.V. v Rum Creation & Products Inc.* [2012] SGIPOS 1 at [69]-[70]⁹.

Average Consumer's Perception of Subject Mark

44 Not taking for granted that the French word element “pâtissier” is necessarily understood in Singapore at the Relevant Date, I turn to the evidence on how the average consumer would perceive the Subject Mark.

45 Ms Tan, in the Proprietor's 1st SD at [35], “*verily believe(s) that as at the application date of the Registered Marks, that is, 27th September 2005, the word “Pâtissier/Pâtissier” was not a commonly known term to the relevant public in Singapore, nor was it incorporated into any other business, company or trade names in Singapore.*” Earlier in the same statutory declaration, at [5], Ms Tan also declared, “*As far as I know, it was unknown at that time for cake shops to use the term “pâtissier” or “pâtisserie”.*”

46 On the other hand, Ms Kwan, in the Applicant's 2nd SD at [6], declared the following:

...

- (a) Sometime in or around 2005, the Applicant decided to explore a brand as part of its business expansion plans. This included conceptualising a sign that incorporated the word “pâtissier”.

⁸ The transliteration and translation clause in the Register reads: The transliteration of the Chinese characters [柏•伟诗酒店] appearing in the mark is “Bai” which means “Cypress”, “Wei Shi” which has *no meaning*⁸ and “Jiu Dian” which means “Hotel”. At [69] of this decision, the Principal Assistant Registrar said, “Having regard to the demographics of Singapore, I am of the view that Chinese will be understood in the local context such that it is not likely that 柏•伟诗酒店 will be viewed simply as a decorative element. Nonetheless, having regard to the fact that English is the working language in Singapore, I am also of the view that 柏•伟诗酒店 are of *secondary* significance in comparison to “PARK REGIS” ”.

⁹ “The same cannot be said of the word “Centenario”, a Spanish word that the average Singapore consumer is unlikely to be familiar with. While “Centenario” may bear some resemblance to the English word “centennial”, it would be a stretch to conclude that “Centenario” is a common English word as “polo” is, and thus place emphasis on “ZACAPA” and “GRAN” instead.”

- (b) In the process of doing so, I recall noting that “pâtissier” is both an English word as well as a French word which broadly means “a pastry chef” and is closely related to food and beverage products / services.
- (c) Accordingly, to the best of my recollection, “pâtissier” was a term that was used and well known in the food and beverage industry at that time. This included use in relation to products such as pastries, cakes and confectioneries.

47 The Applicant’s 1st SD exhibits, at “KHC-2”, two English dictionary extracts¹⁰ of “pâtisserie/pâtisserie” dated around 2005, the year of the Relevant Date:

- (i) Collins English Dictionary & Thesaurus (HarperCollins Publishers, Third Edition 2004, Last Reprint 2005)

pâtisserie (pə'li:əri) n 1 a shop where fancy pastries are sold. 2 such pastries. [C18: F, from *pâtissier* pastry cook, ult. from LL *pasta* PASTE]

- (ii) Bloomsbury Concise English Dictionary (A&C Black Publishers Ltd, Second Edition 2005)

pâtisserie /pə'teɪsəri, -tɪsəri/ n 1 a bakery that specializes in pastries and cakes 2 sweet pastries or cakes collectively [Late 16C. < French *pâtisserie* < *pâtissier* pastry chef < late Latin *pasta* (see PASTE)]

48 It is observed that the above dictionary entries pertain to “pâtisserie/pâtisserie”. It is only in the parenthesis of both entries that the dictionaries indicate the etymology of the word as being derived from the French word “pâtissier” and from the Latin word “pasta”. Thus, these dictionary entries do not establish that “pâtissier” is in fact part of the English language in 2005. On the contrary, the latter is explicitly recognized as the French derivation of the entry for “pâtisserie/pâtisserie”. Also, the Applicant’s foregoing evidence still does not reflect the state of mind of the average consumer in Singapore at the Relevant Date in 2005. To his credit, counsel for the Applicant clarified at the hearing that it was not its case that just because a foreign word was in the English dictionary meant that it was not distinctive. However, he submitted, the fact of being found in an English dictionary brings the mark closer to the scenarios in Section 7(1) of the Act. Nevertheless, as expressed above and in the footnote, I have reservations whether the Applicant has discharged its burden to show that “pâtissier” is an English word in Singapore in 2005. Hence my earlier description, at [35], that the

¹⁰ It is curious that the Applicant has only exhibited entries for “pâtisserie/pâtisserie” in Collins English Dictionary & Thesaurus, and Bloomsbury Concise English Dictionary; and not in other, highly established dictionary titles such as the venerable Oxford English Dictionary. Even after 2005, it is noted that the Applicant did not find (presumably, as one would expect the Applicant to exhibit them if such entries exist) “pâtisserie/pâtisserie” and “pâtissier/pâtissier” entries in the Oxford English Dictionary (not other titles under the Oxford publishing group such as English Oxford Living Dictionary). Further, it is also not clear how reflective the Collins English Dictionary & Thesaurus, and Bloomsbury Concise English Dictionary are of the use of English in Singapore, the relevant territory in this dispute. Ultimately, the issue whether “pâtissier/pâtissier” has in fact crossed over from the French language into mainstream English vocabulary in Singapore in 2005 falls to be proven by the Applicant.

Subject Mark may be treated as a combination of English (“the”) and French (“Pâtissier”) words.

49 On this basis, there are a few layers to unpack. I first ask, would the average consumer in Singapore, being a member of the general public (as discussed above), understand the Subject Mark to have a meaning? If the answer is in the affirmative, the next issue is the meaning the average consumer would attribute to the Subject Mark – would it be “The Pastry Chef”? Third, even if the average consumer perceives the Subject Mark as “The Pastry Chef”, would that be understood by the consumer as a descriptor of a characteristic of the goods and services claimed, or as a badge of origin?

Proprietor’s Evidence

50 I note Ms Tan’s assertion in the Proprietor’s 1st SD at [35], set out at [45] above, on the state of mind of the Singapore public, and go on to consider any other possibly relevant evidence¹¹ on this point.

(i) Use of “Pâtissier” in company names and business names

51 At [35] of the Proprietor’s 1st SD, in addition to her assertion, Ms Tan also exhibits printouts showing that “*the Proprietor’s predecessor, The Patissier, was the very first entity in Singapore to be registered with a name containing the word “Patissier”. This was on 26th January 2000.*”

52 The relevant Exhibit TSO-11 of the Proprietor’s 1st SD shows the undated search results using the search term “PATISSIER” on bizfile, the business filing portal of ACRA; as well as undated printouts from the Singapore Business Directory (www.sgpbusiness.com), an online directory portal with information on some of the entities disclosed in the bizfile search. Among the search results are:

- Patissier J’s (incorporated on 19 March 2008, terminated as on 24 February 2017)
- Sharsan Patissier LLP (incorporated on 31 August 2005, struck off as on 1 July 2017)
- Something Sweet Patisserie (formerly known as I Patissier; registration expired)
- The Patissier (the Proprietor’s predecessor, incorporated on 26 January 2000)
- Works Patissier Pte. Ltd. (incorporated on 29 May 2012)

53 From what is available in the exhibit to the Proprietor’s 1st SD above, it does appear that its predecessor, The Patissier (a partnership subsequently converted to a LLP that is the Proprietor), was the first registered business entity to use the word “Patissier” in its name in Singapore in 2000. It was not until five years later, in 2005 (also the year of the Relevant Date), that another entity, Sharsan Patissier LLP, also used the word “Patissier” in its name.

¹¹ The Proprietor’s evidence generally shows use of the Subject Mark and the term “The Patissier” in Singapore across a range of dates. It did not need to specify in *evidence* (and therefore did not) whether such evidence goes towards establishing the average consumer’s perception of the Subject Mark at the Relevant Date, or whether it goes towards a finding of acquired distinctiveness either before or after the Relevant Date. Here, I consider the evidence with the aim of understanding the state of mind of the average consumer at the Relevant Date.

54 This factor could have corroborative value, but cannot in itself determine how the average consumer in Singapore perceived the Subject Mark in 2005. After all, hypothetically, a trader could be the first to adopt a descriptive sign in Singapore, and the average consumer could still have perceived that it was descriptive of the relevant goods or services, rather than as a badge of origin.

(ii) President Nathan’s question and remarks

55 The Applicant also sought to show the state of mind of the general public by way of example, with reference to the late President Nathan. In this regard, Ms Tan, in the Proprietor’s 1st SD at [26] states:

I distinctly recall that when President Nathan presented us with the Spirit of Enterprise Award in 2005, he asked me how the word “Pâtissier” is pronounced and whether we had coined the word. He remarked that he had never heard of the word before. This anecdote demonstrates the novelty of the name “The Pâtissier” in Singapore in the early 2000s.

56 While being mindful of the rule against hearsay, I can consider that Ms Tan affirmed the fact that the above was said by President Nathan, rather than the truth of what he said. However, no submissions were made by either party on what this showed about the state of mind of the general public.

(iii) Re-examination of Ms Tan

57 The Applicant also points out that in the re-examination of Ms Tan, she herself admitted that she came across the word “Pâtissier” from the Oxford dictionary¹² she was flipping through, and this led to a conversation with her sister:

So I asked my sister, “Do you know what does the pâtissier means (*sic*)?” She looked at me and she said “ya” but I didn’t know what it meant. Then she said, “ya... it means pastry chef”. Then I said, “ok then let’s call it ‘The Pâtissier’” and that’s how we came up with the name.

...

... my sister is the pâtissier... that’s why we always call her the pâtissier.

58 Counsel for the Applicant cited the above testimony to advance the line of argument that Ms Tan admitted or conceded that the words “The Pâtissier” have a descriptive meaning. Leaving that argument aside (as noted above at [35], both parties accept the meaning of “pâtissier” as “pastry chef”; however, the question is what the average consumer perceives), I see that the above testimony is also a snapshot of how two individuals in Singapore, before The Pâtissier was incorporated on 26 January 2000, had different perceptions of the word “pâtissier”. Ms Tan (Siang Onn, the deponent) did not know the word and its meaning, prior to encountering it in a

¹² No further details, such as the title of the specific dictionary published by Oxford (there are various), and the specific dictionary entry (e.g. whether it was for “pâtisserie” and not “pâtissier” as such, whether “pâtissier” only appeared as the French derivation), were available.

dictionary. The other Ms Tan (Siang Yee), the Proprietor's executive chef, was a newly qualified pastry chef who had returned from a pastry diploma course at the prestigious Le Cordon Bleu, London – and, not surprisingly, knew what the word meant. It would appear that Ms Tan Siang Yee's accomplished culinary profile is not typical of the average consumer in Singapore; and that Ms Tan Siang Onn not knowing the word or its meaning before flipping through a dictionary would be closer to the state of mind of the general public in 2005.

(iv) Media features

59 The Proprietor has been featured in newspaper and magazine articles since 2000, when it started business. [29] of the Proprietor's 1st SD sets out a very long tabulated list of such newspaper and magazine articles. There are 119 of them in all, spanning the years 2000 to 2017¹³.

60 I briefly describe a selection of these articles from 2000 to the year of the Relevant Date (2005), to summarise the sense I got from these media features in terms of how the Subject Mark is perceived. These articles are essentially "lifestyle" articles in mainstream media such as The Straits Times, The New Paper and Lianhe Zaobao, featuring food and beverage (F&B) establishments, food, and human interest stories on how owner-chefs started their businesses. The Subject Mark appears in these articles not in its stylized form, but in plain word form as the Proprietor's name in short, "The Patisserie". When the words "The Patisserie" appear, they consistently refer to the name of the Proprietor's cake shop. The authors of the articles do not treat the name "The Patisserie" differently (e.g. descriptively) from any the names of other F&B establishments mentioned in their articles.

61 Counsel for the Proprietor also highlighted a feature in March 2013¹⁴, in Lianhe Zaobao, entitled "New Titles in the Workplace". The author mused about "*chim*" (Singlish, loosely translated as deep, difficult) job titles observed in Singapore. Whereas ordinarily, the general populace would use terms such as baker, coffee uncle/auntie, bartender, the author noted that newer terms such as patissier, barista and mixologist have surfaced. With regard to the Proprietor, the author additionally quipped that there was a boutique cake shop by the name of "The Patisserie"; the author found the vocabulary difficult so whenever speaking about it to family and friends, the author would refer to the Proprietor as "That 'P' cake shop".

62 It would appear to the author of this feature that even as recently as 2013, eight years after the Relevant Date, the term "patissier" is a "new title in the workplace" in Singapore.

(v) Mentions in websites, blogs, online forums

63 [30] of the Proprietor's 1st SD also sets out a list of 58 instances where it has been mentioned or covered in websites, blogs, online forums, from 2002 to 2018¹⁵. The relevant instances before the Relevant Date are online discussions on the Singapore Brides Wedding Forum under two separate forum discussion headings, "A Real

¹³ Exhibit TSO-9 of the Proprietor's 1st SD

¹⁴ Page 455, Exhibit TSO-9 of the Proprietor's 1st SD

¹⁵ Exhibit TSO-10 of the Proprietor's 1st SD

Wedding Cake” and “Cakes Anybody”. When the words “The Patisserie” or “Patisserie” appear, they consistently refer to the name of the Proprietor’s cake shop¹⁶ or the Proprietor’s cakes¹⁷. There is no hint that the online public perceives the words “The Patisserie” other than as a badge of origin.

Applicant’s Evidence

64 On the other hand, the Applicant does not appear to have adduced evidence on the state of mind of the average consumer in Singapore.

65 The Applicant’s 1st SD does exhibit dictionary extracts on the terms “Patisserie”, “Pâtisserie”, “Confectioner”, “Confection”, “Confectionery”, “Patisserie” and “Pâtisserie”. However, as noted above at [48], dictionary extracts on the French / French derived word “Patisserie” do not reflect the state of mind of the average consumer in Singapore at the Relevant Date in 2005. Not all dictionary words (especially those derived from foreign languages) are equally known and used; and it is not evident that the average consumer Singapore would be aware of the word “Patisserie” or its meaning in 2005.

66 The Applicant’s 1st SD also cites¹⁸ three other entities which use the term “Patisserie”. They are “Chocolat Patisserie Menier” used in relation to a chocolate product by Nestlé France¹⁹; “Joulietta Chocolatier Patisserie”²⁰, which sells luxury artisan chocolates with the taste of Cyprus; and “Sélection du Pâtisserie”, a Canadian company selling desserts²¹. However, these examples of use of the term “Patisserie” appear to emanate from outside Singapore. The advertisement for “Chocolat Patisserie Menier” Swiss Dark Chocolate 100g lists the price as €1.95. The Euro currency denomination suggests that the product is targeted at the European market. “Joulietta”, styled as chocolatier and patisserie, operates a shop in Cyprus. As for “Sélection du Pâtisserie”, there is no evidence that the Canadian company has any exposure in Singapore. Even if any light is shed on the state of mind of the average consumer in Singapore, the internet printouts showing these examples are dated 2018 and therefore post-date the Relevant Date.

67 The Applicant’s 1st SD also lists²² examples of businesses in Singapore that use the term “patisserie”, such as Patisserie G and Deluscious Patisserie. However, the printouts pertaining to these establishments all post-date the Relevant Date. No further light is shed on the state of mind of the average consumer as regards the term “patisserie” in 2005.

68 We are thus left with the bare assertion of Ms Kwan, as set out above at [46], in the Applicant’s 2nd SD at [6], that “*to the best of my recollection, ‘patisserie’ was a term*

¹⁶ E.g. Page 500, Exhibit TSO-10 of the Proprietor’s 1st SD: “I’m actually looking for an actual multi-tiered wedding cake. Other than Patisserie and a few others, i dun (*sic*) know of any other good confectionaries (*sic*) that can do the same”

¹⁷ E.g. Page 501, Exhibit TSO-10 of the Proprietor’s 1st SD: “Hi Cody, Patisserie cakes are very nice, normally I get them to deliver cakes for special occasions...”

¹⁸ [21](a) to (c) of the Applicant’s 1st SD

¹⁹ Page 147, Exhibit KHC-2 of the Applicant’s 1st SD

²⁰ Pages 150-151, Exhibit KHC-2 of the Applicant’s 1st SD

²¹ Page 212, Exhibit KHC-2 of the Applicant’s 1st SD

²² [21](d) to (k) of the Applicant’s 1st SD

that was used and well known in the food and beverage industry at that time. This included use in relation to products such as pastries, cakes and confectioneries.” This, without more, cannot be the sole basis for a finding on the state of mind of the average consumer at the Relevant Date, especially when contradicted by Ms Tan’s assertion that as on “27th September 2005, the word “Patissier/Pâtissier” was not a commonly known term to the relevant public in Singapore”, see [45] above.

Other Considerations

69 I am also mindful that the average consumer in Singapore could have some exposure to the international community. Wei J observed, at [71] of **Big Box**:

The point might also be made that well before 2005, many (or some) Singaporeans would have been likely to have come across the concept of big-box retailing when travelling, working or studying overseas such as in North America. Further, it may be thought that by 2005, there would already have been a sizeable number of Singapore residents originating from Europe or North America and who may therefore have been acquainted with the concept (in relation to warehouse and retail establishments) said to be embodied by the term “big box”. The difficulty, however, is that there is no evidence at all before this court to support the view that by 2005, the average Singapore consumer (even bearing in mind exposure to the international community) would have been familiar with the meaning that is being advanced.

(emphasis added)

70 The same difficulty presents itself in the case before me. The burden lies on the Applicant to show, on a balance of probabilities, that the average consumer would have perceived that the Subject Mark serves, in trade, to describe the relevant goods and services. However, as in **Big Box**, so here, there is no evidence before me to support the view that by the Relevant Date, the average Singapore consumer would have been familiar with the meaning that is advanced by the Applicant.

71 The words of the learned judge in **Big Box** (at [113]-[114]) are apposite:

113 The point has been made that the burden lies on the Applicant to prove the ground of invalidity on a balance of probabilities (see [17] above). A considerable time has elapsed between the Application Date and the invalidity attack. It is understandable that the Applicant may encounter practical problems in marshalling evidence as to what the state of affairs in Singapore was in January 2005 as to the relevant public’s understanding or usage of the words “big box” in the Singapore market. Nevertheless, the burden falls on the Applicant’s shoulders.

114 Hindsight knowledge or analysis must be avoided. Evidence that the words “big box” are synonymous in Singapore today with large retail/warehouse businesses does not necessarily mean that the words lacked distinctiveness, *etc*, at the Application Date. 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 s 22(1)(c) of the Act instead.

Furthermore, an argument based on the current state of affairs which then looks back to a much earlier point in time is particularly dangerous when combined with a “leading question” type of analysis which asks the court to consider a number of recent publications on “big-box” retailing and whether they indicate that BIG BOX was descriptive of and/or alluded to some characteristic of a very large retail/warehouse store at the Application Date. Instead, the proper question is whether the relevant public (retailers and consumers) in Singapore would appreciate the trade mark significance of BIG BOX on 26 January 2005 without being educated that it is being used for that purpose.

72 The above observations by Wei J also address a policy-based argument canvassed by the Applicant here. The Applicant *“does not see how or why the Registrant should be allowed to prevent other traders from using the said word. In fact, there are many other traders who use the word “PATISSIER” / “PÂTISSIER” or the derivative / related word “PATISSERIE” / “PÂTISSERIE” as part of their trade / business name.”*²³ If the evidence is that the trade mark has become the common name in the trade²⁴ 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 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 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. In any case, the concerns expressed by the Applicant are not a given. It does not fall before me to determine whether, based on the Subject Mark’s registrations, the Proprietor could prevent other traders from using signs which include “Patissier” or “Patisserie” (such as those cited by the Applicant by way of examples of the use of “Patisserie” in Singapore) in infringement actions. However, suffice it to say that the burden of proof would lie on the Proprietor (as the putative plaintiff) and there are specific elements of the relevant infringement provision which need to be proven, such as the putative defendant’s use of “patissier” as a trade mark (i.e. to denote origin), marks-similarity and likelihood of confusion²⁵.

Conclusion on Section 7(1)(c)

73 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 “Patissier”) to have a meaning at the Relevant Date (i.e. 27 September 2005). As such, the Subject Mark is not likely to be understood by the consumer as a descriptor of a characteristic of the goods and services claimed.

74 Having considered the parties’ evidence and arguments, I am not persuaded on a balance of probabilities that the Subject Mark consists exclusively of a sign that

²³ [21] of the Applicant’s 1st SD

²⁴ Which still remains to be proved, especially since the Subject Mark here is a combination of the English word “The” and the French-derived word “Patissier”; and also not the term “Patisserie” which is more frequently used in Singapore than “Patissier” according to the Applicant’s evidence – for avoidance of doubt, I make no finding on the term “Patisserie” here, nor on whether the Subject Mark has become the common name in the relevant trade under Section 22(1)(c) of the Act. Such matters do not fall to be adjudicated in the present applications.

²⁵ Unless the allegedly offending mark and the registered mark, and the respective goods and services, are identical

designates the characteristics of the relevant goods or services. The ground of invalidation under Section 7(1)(c) therefore fails.

Ground of Invalidation under Section 7(1)(b): Non-distinctiveness

75 Section 7(1)(b) of the Act reads:

The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character

Decision on Section 7(1)(b)

76 A mark can be devoid of any distinctive character for the purposes of Section 7(1)(b) without also being unduly descriptive for the purposes of Section 7(1)(c). However, a mark which is unduly descriptive for the purposes of Section 7(1)(c) is necessarily devoid of distinctive character for the purposes of Section 7(1)(b): *Marvelous* at [48].

77 Hence, as a matter of structure and approach, it may sometimes be possible to canvass distinct arguments under Section 7(1)(b), even if the mark in question has not been found descriptive under Section 7(1)(c).

78 The Applicant has elected to canvass collective arguments under the two grounds “because of the inextricable link”²⁶. There are no other arguments²⁷ in support of the Applicant’s claim that the Subject Mark is devoid of any distinctive character – apart from descriptiveness arguments under Section 7(1)(c). Thus, I have no basis to deviate from the same conclusion as that for Section 7(1)(c) above.

Conclusion on Section 7(1)(b)

79 The Applicant has not made out its case that the Subject Mark was devoid of any distinctive character on the Relevant Date, in Singapore, in respect of the goods and services claimed. The ground of invalidation under Section 7(1)(b) therefore fails.

Acquired Distinctiveness under Section 7(2) and Section 23(2)

80 As the Subject Mark has not been found descriptive under Section 7(1)(c), nor non-distinctive under Section 7(1)(b), there is no need to further consider the Proprietor’s evidence and the parties’ arguments on acquired distinctiveness under either Section 7(2) or Section 23(2).

81 Suffice it to say, generally, that with the passage of time since the Relevant Date, there are practical challenges of proof, both on the part of the party seeking a declaration of invalidity, and also on the part of the proprietor should its mark be found descriptive or devoid of distinctive character. *Wei J* puts it well at [128] of *Big Box*:

²⁶ [13] of the Applicant’s Written Submissions – this appears reasonable in the case

²⁷ Not considering arguments relating to the lack of acquired distinctiveness, which only come into play if the Subject Mark were found descriptive or non-distinctive in the first place, which is not the case here

This case highlights the difficulties which arise where a registered trade mark is attacked many years after registration on the basis of invalidity at the date of registration... Just as it is very difficult to obtain independent persuasive evidence on whether the relevant public viewed the mark in question as a trade mark (*ie*, whether they appreciated the trade mark significance without being educated of that purpose) for the relevant goods or services at a date long in the past, it is also challenging for the proprietor to marshal evidence to demonstrate that, even if the trade mark lacked distinctiveness all those years ago, it has through use acquired *de facto* distinctiveness (as an indicator of trade origin) in the minds of the relevant public...

Overall Conclusion

82 Having considered all the pleadings, evidence, and submissions made in writing and orally, I find that the applications for declarations of invalidity fail on all grounds. The Registered Proprietor is also entitled to costs to be taxed, if not agreed.

Date of Issue: 9 April 2019