

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

Trade Mark No. 40201708607T (International Registration No. 1335625)
Hearing Date¹: 17 April 2019

**IN THE MATTER OF A TRADE MARK APPLICATION BY
SOCIÉTÉ DES PRODUITS NESTLÉ S.A.**

AND

**OPPOSITION THERETO BY
ABBOTT LABORATORIES**

Hearing Officer: Ong Sheng Li, Gabriel
Principal Assistant Registrar of Trade Marks

Representation:

Mr Lim Ren Jun, Ms Diana Bey, Ms Vivien Teo and Mr Kong Xie Shern (Wong & Leow LLC) for the Opponent

Zico Insights Law LLC for the Applicant

GROUND OF DECISION

1 Based in Switzerland, Société des Produits Nestlé S.A. (“Applicant”) is part of the Nestlé group of companies, one of the largest food and beverage groups in the world. On 24 April 2017, it applied, through a subsequent designation under International Registration No. 1335625, to register “HM-O” (Trade Mark No. 40201708607T) in Singapore in Classes 5 and 29 (“Application Mark”) for the following:

Class 5

Nutritional supplements; dietetic supplements for medical use; dietetic substances, beverages and foodstuffs for medical and clinical use; food for babies; lacteal flour for

¹ The parties requested to be heard “on paper” only (i.e. without an oral hearing) in order to save costs, and this was endorsed by way of direction. A hearing date was fixed so that the timelines for written submissions could run backwards from it.

babies; powdered milk for babies; nutritional supplements for medical use for pregnant women and breastfeeding mothers; vitamin preparations.

Class 29

Cooked dishes based on vegetables, potatoes, fruits, meat, poultry, fish and seafood products; milk; dairy products; milk substitutes; milk beverages, milk predominating; milk-based beverages containing cereals and/or chocolate; yogurts; soya milk (milk substitute).

(Note: 24 April 2017 was also the filing date of the Application Mark.)

2 Abbott Laboratories (“Opponent”), a global healthcare company with its registered office in Illinois, USA, opposed the registration of the Application Mark. Without getting into the technicalities just yet, the foundation of the Opponent’s case was that registration should be refused because “HMO” was an abbreviation for “human milk oligosaccharides”: a component of human breast milk which is beneficial for infants. On this premise, the Opponent built a case that the Application Mark was descriptive and/or non-distinctive of the goods claimed. (An outline of the parties’ respective cases is set out at [10] – [13] below.)

Grounds of opposition

3 The pleaded grounds of opposition to the Application Mark were: ss 7(1)(b) and 7(1)(c) of the Trade Marks Act (Cap. 332, Rev Ed 2005) (“TMA”).

- a. Section 7(1)(b) TMA prohibits the registration of “*trade marks which are devoid of any distinctive character*” (i.e. non-distinctive marks).
- b. Section 7(1)(c) TMA bars the registration of “*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*” (i.e. descriptive marks).

Relevant background

4 The parties are competitors in certain market segments.

5 The Applicant (either directly or through various Nestlé group entities) offers a wide range of food and nutritional products, including infant milk formula. In Singapore, the Applicant sells infant formula under “Nestlé NAN OPTIPRO”.

6 The Opponent offers adult and pediatric nutritional products, ranging from infant milk formula to specialised nutrition products. In Singapore, the Opponent’s infant formula is sold under “Similac”, “PediaSure” and “Pedialyte”.

7 The parties were and have been embroiled in trade mark opposition (in Brazil, Ecuador, Panama, Colombia and Vietnam) and trade mark cancellation (in Peru and Costa Rica) disputes abroad in relation to the “HM-O” mark in Classes 5 and 29. In each case, the grounds of attack raised by the Opponent were essentially the same as those raised in this one: namely, that “HM-O” was descriptive and/or non-distinctive in relation to the goods for which it is applied for or

registered. Thus far, the Opponent has been successful in all of the disputes which have been concluded (with the exception of Costa Rica, where cancellation of “HM-O” was partial i.e. for certain goods only).

8 “HM-O” is registered in Classes 5 and 29 in various other jurisdictions including the European Union, United Kingdom, and Switzerland. As far as I can tell, the Opponent did not challenge the registrability of “HM-O” in any of those jurisdictions. Elsewhere, the Applicant has faced trade mark office objections relating to “HM-O”. (See [85] – [87] below.)

Statutory declarations

9 Both sides led evidence in the usual way: via statutory declarations.

- a. Elisa M. Valenzona, Senior Trademark Counsel of the Opponent, gave evidence as well as evidence in reply on its behalf.²
- b. Isabelle de Blic-Hamon, Senior Legal Counsel IP of the Applicant, gave evidence on its behalf.³

I will address their evidence, where relevant and necessary, in the course of this decision.

Outline of parties’ cases

10 As touched on earlier, the Opponent’s case was built on the premise that average consumers of the goods in question would have known and recognised “HMO” as a common abbreviation for “human milk oligosaccharides”. The Opponent tendered evidence with a view to establishing that “HMO” was descriptive and/or non-distinctive in relation to the goods for which registration was sought. In its submission, the sole difference between “HMO” and “HM-O” is an insignificant hyphen which does not alter the fact that, when assessed as a whole, “HM-O” was descriptive and/or non-distinctive in respect of the relevant goods.

11 The public policy argument which underpinned the Opponent’s case was that “HMO”, and by extension the Application Mark, should not be the exclusive monopoly of any one trader; instead, such signs should remain free for honest traders to use without any improper motive. This argument was premised on the established principle that “*the privilege of a monopoly should not be conferred when it might require honest men to look for a defence*” to an action for trade mark infringement (see *Courts (Singapore) Pte Ltd v Big Box Corp Pte Ltd* [2018] 5 SLR 312 (“*Big Box*”) at [42] citing *Re Colorcoat Trade Mark* [1990] RPC 511 at 517).

12 In response, the Applicant countered that “HM-O” was distinctive. It stressed that one cannot simply discount the hyphen from the analysis: it made “HM-O” different and distinguishable from “HMO”. It tendered evidence that searches conducted on certain internet websites for “HMO” did not reveal any connection between “HMO” and “human milk oligosaccharides”. The Applicant also pointed out that even if highly specialised health professionals were familiar with the use of “HMO” as an abbreviation for human milk oligosaccharides, it did not follow that this was also the case for average consumers in Singapore.

² I refer to these documents as “Opponent’s SD” and “Opponent’s SD in Reply”

³ I refer to this document as “Applicant’s SD”

13 Naturally, the Opponent disagreed with the Applicant’s submissions in relation to the role of the hyphen in the Application Mark. It also contended that the Applicant was incorrect about how average consumers would perceive “HMO” or “HM-O”.

Written submissions in lieu of oral hearing

14 To save costs, the parties chose to be heard “on paper” without an oral hearing. Arguments were made via written submissions and written submissions in reply.

Relevant date

15 It is trite that descriptiveness and/or distinctiveness must be assessed as of a certain date. In many cases, that date—usually referred to as the relevant date—is the date on which the trade mark was applied for at the registry.

16 However, in this case, the Application Mark stemmed from an international registration where the request for extension of the international registration’s protection to Singapore was made via a subsequent designation. As the name suggests, a subsequent designation is a request that takes place *subsequent* to the international registration. In other words, there was no mention of a request for extension of protection to Singapore in the international registration. The request only came afterwards.

17 In its written submissions, the Applicant appeared to treat the international registration date (in this case: 14 December 2016) as the relevant date for the assessment, without explaining why it took such a position.⁴ On the other hand, the Opponent did not state in its submissions what it considered the relevant date of the assessment to be.

18 I think that the Applicant’s assumption—if it may be called that—was incorrectly made. In subsequent designation cases, protection for a registered mark commences from the date on which the date on which the request for subsequent designation was recorded in the International Register: see r 17(2)(b) of the Trade Marks (International Registration) Rules (Cap. 332, R 3, Rev. Ed. 2002). On the Singapore trade mark register, the aforementioned date would be recorded as the “Date of Subsequent Designation” (here: 24 April 2017, which was also the filing date of the Application Mark). Since a trade mark that is descriptive and/or non-distinctive should—all other things being equal—be refused registration under s 7(1)(b) and/or 7(1)(c) TMA, it would only stand to reason that the subsequent designation date and the relevant date for the assessment must be one and the same.

19 For the reasons above, I hold that the relevant date for the assessment is 24 April 2017.

Relationship between the grounds

20 While each absolute ground of invalidity for registration in s 7(1) TMA operates independently, the grounds may overlap (see *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2008] 1 SLR(R) 561 (“*Love & Co*”) at [45]). Indeed, s 7(1)(c) has been described as a particular example of the objection in s 7(1)(b) TMA (see *Han’s (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 at [59]). Section 7(1)(b) is broader in scope, and is said to be

⁴ Applicant’s Written Submissions at [24] and [40]

“akin to a “sweep up exclusion from registration clause” for marks that lack inherent distinctive character” (see *Love & Co* at [44]).

21 Since it is logical and appropriate to deal with the specific before the general, I will begin with s 7(1)(c) before turning to s 7(1)(b) TMA.

Section 7(1)(c) TMA: descriptive marks

22 The purpose of s 7(1)(c) TMA is to prevent the registration of signs which are descriptive of the goods or services or some characteristic of them. These descriptive marks are excluded from registration because they consist of signs or indications which honest traders either use or may wish to use without any improper motive. (See Mellor et al, *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 16th Ed, 2018) (“*Kerly's*”) at [10-099].)

23 A convenient restatement of the key principles applicable to this ground of objection can be found in *Marvelous AQL Inc.* [2017] SGIPOS 3 (“*Marvelous*”) at [29] which referred to an earlier edition of *Kerly's* (the relevant paragraph in the current edition is [10-101]). For present purposes, it is worth reiterating that a sign must be refused under this provision if *at least one of its possible meanings* designates a characteristic of the goods concerned. It is also important to bear in mind that the situations referred to in s 7(1)(c) TMA are particular examples, but they are not exhaustive: ultimately the provision covers *any* descriptive characteristic, irrespective of how significant the characteristic may be commercially.

24 Whether a sign falls within the scope of s 7(1)(c) TMA must be assessed from the average, discerning, reasonably well-informed and reasonably observant consumer (of the relevant goods and/or services) in Singapore. (*Big Box* at [77]; *Love & Co* at [61].)

The evidence relating to “HMO”

25 I now set out my findings and observations concerning the evidence.

26 Human milk oligosaccharides are carbohydrates naturally found in human breast milk. They have various benefits for infants, including positively influencing the gut microbiome and modulating the innate immune system.⁵ I understand from the scientific literature that the most abundant type of HMO is 2'-Fucosyllactose (abbreviated as “2'-FL” or “2'FL”).⁶ Another type of HMO is lacto-N-neotetraose (abbreviated as “LNnT”). There are numerous other types of HMOs present in human milk. Hundreds of HMO strains have been identified so far.

27 The term “human milk oligosaccharides” was usually abbreviated as “HMO” or “HMOs” in scientific literature (e.g. research papers or articles). As it will be seen, this abbreviation was also used by various other groups as well. It seems that the singular was used where the intention was to refer to a singular strand or type of HMO (e.g. 2'-FL), and the plural was used where the intention was to refer to them collectively (e.g. HMOs or oligosaccharides). The Applicant did not deny this. It accepted that “HMOs” have been used an informal abbreviation, although it argued that “HM-O” was a different and distinguishable term.⁷

⁵ Opponent's SD at [8] and Annexures 3 and 4

⁶ Opponent's SD in Reply at Annexure 18

⁷ Applicant's Written Submissions at [25]

28 Given the benefits of HMOs for infants, there was a great deal of interest in the infant nutrition field in figuring out how to introduce them into infant formula.⁸ The Opponent tendered two scientific articles (dated 2012 and 2015 respectively) which discussed how this might be done. Notably, both articles used the abbreviation “HMOs”. Based on the footnotes/references in the 2015 article, it appears that the scientific community had been discussing HMOs since at least 2006, if not longer. It also seems reasonable to infer that the abbreviation “HMO” was in use for quite some time.

29 Research into HMOs intensified significantly in recent years. These efforts have since borne fruit, and several companies now offer infant formula products containing one or more HMOs. Despite the name, commercial HMOs are not extracted from human milk. For one, practical difficulties exist in obtaining large enough amounts of human milk for commercial HMO production. One alternative is to concentrate and extract HMOs from cow’s milk.⁹ There appear to be other ways of producing HMOs: at least two articles referred to fermentation on an industrial-scale,¹⁰ apparently based off a stable HMO fermentation strain.

30 In late 2016, the Opponent launched “Similac Pro-Advanced” and “Similac Pro-Sensitive” infant formula containing 2’-FL HMO in the United States.¹¹ On the product packaging, the letters “HMO” appeared in relatively large font, followed by “human milk oligosaccharides” in smaller font. The relevant portion of the Opponent’s website read: “*Unlike other formulas, we have 2’-FL Human Milk Oligosaccharide (HMO), an immune-nourishing prebiotic that circulates throughout the body. Similac with 2’-FL HMO helps strengthen baby’s immune system to be more like the breastfed infant’s than ever before*”.¹²

31 Later on, Similac (with HMO) was made available in Singapore through e-commerce distribution platforms such as Qoo10 and Shopee.¹³ It is unclear, however, when exactly this first happened. It is also unclear whether these products with HMO were sold to consumers in Singapore prior to the filing date of the Application Mark.

32 Notably, the Applicant—or at least various entities in the Nestlé group of companies—were (and are) involved in education, research, development, manufacture, and sale of infant formula containing human milk oligosaccharides. In each of the following examples, one or more Nestlé entities used “HMO(s)” as an abbreviation for human milk oligosaccharides.

- a. On 9 February 2017, a research article titled “*Longitudinal change of selected human milk oligosaccharides and association to infants’ growth, an observatory, single center, longitudinal cohort study*” was published on PubMed Central (US National Library of Medicine, National Institutes of Health).¹⁴ The paper was submitted on 6 September 2016 and the underlying study, which was conducted in Singapore at the National University of Singapore, was funded by Nestlé Nutrition. Four of the five co-authors were employees of Nestlé Nutrition, and the only non-

⁸ Opponent’s SD in Reply at Annexure 18

⁹ Opponent’s SD at Annexure 4, Opponent’s SD in Reply at Annexure 18

¹⁰ Opponent’s SD at Annexure 6

¹¹ Opponent’s SD at Annexure 5

¹² Opponent’s SD at Annexure 5

¹³ Opponent’s SD in Reply at [8] and Annexure 15

¹⁴ Opponent’s SD in Reply at [7] and Annexure 14

Nestlé employee, a medical doctor in Singapore,¹⁵ received financial support from Nestlé Nutrition to conduct the study. The abbreviation HMO was used throughout the paper. Near the beginning of the article, in a side column, under the category “**Abbreviations**”, “HMOs” was defined as “human milk oligosaccharides”.

- b. On 8 June 2017, the Nestlé Nutrition Institute published the results of a trial study on infants fed with a cow’s-milk-based formula supplemented with two HMOs: LNnT and 2’-FL. The study concluded that such infant formula (with added HMOs) was safe, well-tolerated, and supported age appropriate growth.¹⁶
- c. On 4 July 2017, FoodBev Media ran a news update on Nestlé. In brief, Nestlé had announced the launch of an infant formula containing two HMO molecules (approved by both the European Food Authority and the US Food and Drug Administration). José M. Saavedra, global medical director of Nestlé Nutrition, was quoted as having said: “*This is a significant breakthrough in infant feeding, because up until now HMOs were only found naturally in breast milk [...] Now, as a result of almost a decade of extensive research, Nestlé has been able to replicate these constituents which are identical to those found in breast milk*”.¹⁷
- d. In evidence was an undated printout from the HM-O Academy website (<https://www.thehmoacademy.com/internal/Common/AboutUs>). The About Us section of the page revealed that Nestlé Nutrition “*created this digital academy to facilitate access of information and to promote scientific information on HMOs to all healthcare professionals*”. Visitors to the page were welcomed to “*the first knowledge hub dedicated to Human Milk Oligosaccharides (HMOs)*”. From there, one could access “*HMO-related scientific material*”, “*attend a lecture or interact with a specialist*”, under training, or simply “*browse the latest news on HMOs*”.¹⁸
- e. The Applicant, through its local subsidiary Nestlé Singapore, has sold infant formula in Singapore containing 2’FL HMO under “Nestlé NAN OPTIPRO”. The product was advertised as containing HMO and this fact was also stated on the packaging. While it is unclear whether this product was available to consumers in Singapore prior to the filing date of the Application Mark, what is clear is that the “Nestlé Official Store” in Singapore has sold Nestlé NAN OPTIPRO to consumers in Singapore via channels such as Qoo10 since July 2018 at the very least.

33 Not surprisingly, apart from the Applicant and the Opponent, there were other companies which offered, or planned to offer, products containing HMOs. I shall list three examples: (a) DuPont Nutrition & Health in partnership with Inbiose;¹⁹ (b) Gerber (which offered an infant formula containing “2’FL HMO” under the brand Gerber Good Start and bearing the letters “HM-O”);²⁰ and (c) BASF (which intended to launch a product containing 2’FL HMO by early 2019).²¹ These are not the only examples in evidence, but I do think they are sufficient to show

¹⁵ The doctor held the following positions: (a) Consultant Neonatologist, Department of Neonatology, Khoo Teck Puat-National University Children’s Medical Institute, National University Hospital, Singapore; and (b) Assistant Professor, Department of Pediatrics, Yong Loo Lin School of Medicine, National University of Singapore.

¹⁶ Opponent’s SD at Annexure 8

¹⁷ Opponent’s SD at [10] and Annexure 7

¹⁸ Opponent’s SD at Annexure 8

¹⁹ Opponent’s SD at [10] and Annexure 6

²⁰ Opponent’s SD in Reply at Annexure 17

²¹ Opponent’s SD in Reply at Annexure 18

that various companies in the infant nutrition field have used “HMO”—and in the case of Gerber: “HM-O”—as an abbreviation.

34 I should also mention the following documents in evidence relating to Singapore.

- a. On 12 October 2017, Channel News Asia published on its website an article about Sugarlogix, a Silicon Valley startup, that wanted to isolate HMOs and turn these milk sugars into a product for not only infants but also adults (in the form of a prebiotic pill).²²
- b. On 6 December 2017, The Straits Times, carried an article originally published in Kuala Lumpur, Malaysia (by The Star / Asia News Network) relating to dietary choices and, among other things, human milk oligosaccharides. The term was abbreviated as “HMOs”.²³
- c. On 26 April 2018, an online article was published on <https://specialty.mims.com> (a website apparently targeted at doctors, nurses and pharmacists) titled “2’-FL HMO in formula milk can benefit infants”. It appears that in a “*recent symposium in Singapore*”, a presenter claimed that infant formula with HMOs “*supports infant grown similarly as breast milk and leads to fewer infections and eczema compared to formula milk without HMOs*”. Two Singapore doctors were quoted in the article: Adjunct Associate Professor Anne Goh (Department of Paediatrics, Allergy Service at KK Women’s and Children’s Hospital), and Dr Alvin Chang (Department of Neonatology at KK Women’s and Children’s Hospital). Goh discussed the benefits of HMOs, while Chang emphasised that breast milk “*is still the best for babies... especially during the first 6 months of life*”.²⁴

35 To conclude, I find that the term “human milk oligosaccharides” was commonly abbreviated as “HMO(s)” prior to the relevant date. The abbreviation appeared to have been first used by a segment of the scientific community, healthcare professionals, and companies in the field of infant nutrition or health supplements. Efforts were made to educate the public about what HMOs are, especially for products that contain one or more HMO strains as an ingredient. On the flip side, there is no evidence that any trader—whether the Applicant or otherwise—used “HMO” in the marketplace as a trade mark: a badge or designator of origin.

36 For completeness, I turn to address the Applicant’s evidence, which contained printouts of internet searches from the following websites: (a) <https://dictionary.cambridge.org>,²⁵ (b) www.acronymfinder.com,²⁶ and (c) <https://medical-dictionary.thefreedictionary.com>.²⁷ The reason it relied on these documents was that they showed searches for “HMO” which did not yield any mention of “human milk oligosaccharides”. Instead, the search results suggested that “HMO” could mean anything from “Health Maintenance Organization” to “Hear Me Out”. Arguing by extrapolation, the Applicant asserted that the relevant public in Singapore would not readily associate the Application Mark with “human milk oligosaccharides”.

²² Opponent’s SD in Reply at Annexure 19

²³ Opponent’s SD in Reply at Annexure 19

²⁴ Opponent’s SD in Reply at Annexure 19

²⁵ Applicant’s SD at Exhibit 2

²⁶ Applicant’s SD at Exhibit 3

²⁷ Applicant’s SD at Exhibit 4

- 37 I consider that the Applicant’s evidence did not assist its case for the following reasons.
- a. Abbreviations are context-dependent. Consider this: in Singapore, “MRT”, “CTE” and “ERP” are widely used and understood as “Mass Rapid Transit”, “Central Expressway”, and “Electronic Road Pricing” respectively. Outside of Singapore, each of these abbreviations may have a different meaning, or even no meaning at all. “Singapore” is what gives each of these abbreviations context. As a practical matter, searches for “HMO” alone, without context, have little to no probative value in the overall assessment.
 - b. In the Opponent’s evidence was a Google search printout which showed that when one searched for “HMO” and “infant milk formula” together, one might get “human milk oligosaccharides” in some of the results.²⁸ This underscored a very simple but important point: on the internet, you usually get what you search for. Cherry-picked internet searches may sometimes provide helpful background, but they do not necessarily carry the matter further in any direction. Moreover, they do not always shed light on the perception of average consumers in Singapore.

Post-dated evidence?

38 Before moving on, I should address the elephant in the room. It is true that a significant proportion of the evidence is from late 2017 or 2018, which was after the relevant date or filing date of the Application Mark: 24 April 2017.

39 As a general rule, publications, press releases and other material which post-date the application date of a trade mark, while relevant, must be viewed with caution. In approaching such evidence, the key question is this: to what extent do they assist in shedding light on what was the perception of the Singapore public at the relevant time? (See *Big Box* at [35].)

40 The nature of abbreviations is that they are context dependent (see [37] above). The context, as the reader would recall, is that infant formula products containing HMOs first appeared on the market from late 2016 to 2017. By late 2017 or 2018, it would have been clear if any single trader had been using “HMO” as a trade mark to distinguish its goods from those of other traders. Yet there was no evidence of this. Instead, the evidence in late 2017 and 2018 consistently pointed toward the use of “HMO” as an abbreviation.

41 For these reasons, I consider the post-dated evidence that I have taken into account above to be relevant as well as helpful in illuminating the state of affairs at the relevant date.

Whether the Application Mark was descriptive at the relevant date?

42 Just because “HMO” was used as an abbreviation for “human milk oligosaccharides” does not automatically mean that the Application Mark was descriptive at the relevant date. Whether this was so must be assessed by reference to the perception of the average consumers of the goods applied for. Furthermore, the Application Mark contains a hyphen between the letters “M” and “O”. What role, if any, does the hyphen play in the Application Mark? I address these issues in turn.

²⁸ Opponent’s SD at Annexure 9

Perception of average consumers

43 It is well established that a sign can be refused registration under s 7(1)(c) TMA only if it is reasonable to believe that it will actually be *recognised* by the relevant class of persons as a description of one of those characteristics (see *Agencja Wydawnicza Technopol v OHIM* (C-51/10) CJEU at [50], cited by *Kerly's* at [10-101], point (4) for the proposition that the property or characteristic in question must be *easily recognisable* by the relevant class of persons).

44 The law does not require that the entire class of persons, or even a majority of them, must recognise the sign in issue as being descriptive of a characteristic. It is sufficient that at least “*a non-negligible part of the public*” would regard it as such. Authority for the “non-negligible” standard may be found in *Ecolab USA, Inc., v EUIPO* (Case T-40/18) at [29], a decision of the European General Court. To my mind, “non-negligible” is just another way of saying that the identified segment of the public is relevant in the assessment. It is not a new or different test.

45 The Opponent submitted that the average consumer of the goods in question would be “*pregnant women, breastfeeding mothers, parents of newborns, and everyday consumers who are interested in nutrition and food supplements, as well as nutritional experts and health professionals with the relevant knowledge of nutritional science*”. As regards infant food products specifically, the Opponent argued that the average consumer would pay “*particular attention to the ingredients*” and would be likely “*familiar with*” and “*on the lookout for*” the “*ingredients which have proven health benefits*” such as “HMOs”.²⁹

46 The Applicant’s counterargument was that the relevant public consists of “*consumers of everyday products*” who are “*not interested in and do not have relevant or comprehensive knowledge of nutritional science*”. It also submitted that “HMO” is “*not a scientific term that is known or recognised by the general public in Singapore*” and that given this “*lack of knowledge in nutritional science by the relevant public in Singapore*”, the term “HMO” would not be recognised as a reference to “human milk oligosaccharides”.³⁰

47 In reply submissions, the Opponent attacked the Applicant’s characterisation of the goods in issue as erroneous. It stressed that the goods applied for were not simply “*everyday products*”. It also sought to expose what it considered to be a logical flaw in the Applicant’s arguments: if the relevant consumers are “*indeed as ignorant as the Applicant portray[ed] them to be*”, why would the Applicant (or indeed, one might add: any other company in this field) use “HMO” and/or other scientific terms in promotional material for its infant formula?³¹

Class 5

48 In my assessment, the goods applied for in Class 5 fall into three broad categories: infant nutrition (e.g. *food for babies; powdered milk for babies; lacteal flour for babies*), general nutrition (e.g. *nutritional supplements; vitamin preparations*) and nutritional products for medical use (e.g. *dietetic substances, beverages and foodstuffs for medical and clinical use; nutritional supplements for medical use for pregnant women and breastfeeding mothers*). Naturally, these categories are not rigid boxes and there are areas of overlap. In any case, it is sufficient to consider whether “HMO” would be recognised by any non-negligible segment of the public as being descriptive: see [43] – [44] above.

²⁹ Opponent’s Written Submissions at [58] and [59]

³⁰ Applicant’s Written Submissions at [21]

³¹ Opponent’s Written Submissions in Reply at [16]

49 It is convenient to begin with the segment of the public comprising mothers-to-be and parents of infants in Singapore (i.e. purchasers of infant nutrition products). Logically speaking, this sector of the public in Singapore cannot be negligible in nature and would, I daresay, constitute a substantial segment of the public. In my judgment, it is clear from the evidence that this sector of the public would have recognised “HMO” as being descriptive of the goods in Class 5. Now, I acknowledge that when babies grow older, they no longer require powdered infant formula milk or baby food. But it should also be said that children are conceived and born in Singapore all the time. What this means, in effect, is that the pool of individuals who were (and are) likely to recognise “HMO” as being descriptive of the goods would—all other things remaining equal—increase over time.

50 In addition to mothers-to-be and parents of infants in Singapore, segments of the general public may also purchase infant nutrition products, perhaps as a gift for, or on behalf of, family or friends of mothers-to-be and parents of infants in Singapore. Gifts are usually selected with care. As such, these market segments are likely to pay greater attention to the goods and would—on account of efforts by manufacturers to educate the public about HMOs—likely regard “HMO” as being descriptive of the goods in question.

51 I turn next to the second category: general nutrition. There is evidence that some manufacturers were seeking to add HMOs to adult supplements for probiotic or other health benefits, and there is evidence concerning the meaning of HMOs. Given this, purchasers/consumers of nutritional supplements would likely have also considered “HMO” being descriptive of the goods.

52 Finally, the third category: nutritional products for medical and clinical use. These goods are not typically purchased off the shelf. Instead, they are prescribed or recommended by healthcare providers (e.g. doctors, pharmacists, or nutritionists) who would likely be aware of what HMOs are, and may also advise end-consumers accordingly. Consequently, purchasers/consumers of these goods would likely have also considered “HMO” to be descriptive of the goods.

Class 29

53 I now turn to Class 29. Apart from *cooked dishes based on vegetables, potatoes, fruits, meat, poultry, fish and seafood products*, the rest of the goods claimed relate to milk/dairy (e.g. *milk; dairy products; milk beverages, milk predominating; milk-based beverages containing cereals and/or chocolate; yogurts*) or milk substitutes (e.g. *milk substitutes; soya milk (milk substitute)*). I accept that the goods in this class are everyday products which may be purchased and consumed by the general public. They are not specialised goods.

54 However, I do not consider the Applicant’s submission (viz. that “HMO” is not descriptive because the general public in Singapore lacks knowledge of nutritional science and so would not know or recognise the term) to be a satisfactory response to the Opponent’s evidence. It might be persuasively argued that average consumers of cooked dishes in Class 29 might not have known of “HMOs”, but the same cannot be said of average consumers of milk/dairy and milk substitutes.

55 As a practical matter, the Opponent does not need to show that the Application Mark is descriptive (or non-distinctive) in respect of each and every item in the specification of goods.

For the purposes of Class 29, it is sufficient for the Opponent to establish that the Application Mark was descriptive (or non-distinctive) in relation to *at least one* of the goods claimed. I will return to this point shortly under the sub-heading “Partial Oppositions”. But, for now, it is convenient to leave aside cooked dishes and focus on milk/dairy and milk substitutes.

56 I have found, in relation to Class 5 above, that mothers-to-be and parents of infants in Singapore (and also certain segments of the general public) would consider “HMO” as being descriptive of infant nutrition products which would include goods such as *food for babies; powdered milk for babies; lacteal flour for babies*. It must logically follow that average consumers from these sectors of the public would also have considered “HMO” to be descriptive of milk/dairy (specifically: *milk; dairy products; milk beverages, milk predominating*) and milk substitutes in Class 29. One can readily see why: there are areas of overlap, or at least a close connection, between the abovementioned goods. After all, what is infant formula, if not a type of milk powder with certain additives (perhaps including HMOs) formulated for babies as a substitute for breast milk?

57 In addition, I think that HMO was, at the relevant date, descriptive of milk/dairy and milk substitutes in Class 29 in at least one other way: there is some evidence (see [29] above) that HMOs may be present in, and extracted from, cow’s milk.

Conclusion on consumer perception

58 For the reasons above, I find that “HMO” would have been regarded by average consumers of the goods in Class 5 and 29 as being descriptive of the goods either directly or by reference to one of their essential characteristics.

59 This is not to say that every case involving an abbreviation would turn out the same way. It all depends on the facts. Consider, for instance, *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] IP&T 768. There, the English Court of Appeal rejected an argument that “E.S.B.” referred to “Extra Strong Bitter”. It did so because there was evidence from brewers and other experts which showed that, from the perspective of the average consumer, the term in its abbreviated form was not exclusively descriptive of a type of beer and possessed a distinctive character. In this case, however, the evidence pointed the other way and there is no evidence to suggest that “HMO” would have been regarded as being distinctive of the goods.

The hyphen and the issue of exclusive descriptiveness

60 I come now to the hyphen in the Application Mark.

61 Taking guidance from *Kerly’s* (at [10-103]), which sets out the ways of avoiding a descriptiveness objection, the Applicant advanced two related lines of argument concerning the role of the hyphen.

- a. First, it submitted that the Application Mark, being a combination of “H”, “M”, a hyphen (-), and “O”, had sufficient distinctive character as a whole notwithstanding that “HMO” might be considered in some quarters to be an abbreviation.
- b. Second, it argued that the Application Mark has a material or tangible part to it (here: the hyphen) which did not designate a characteristic of the goods. In other

words, its case was that the Application Mark was not caught by the objection because it did not consist *exclusively* of an objectionable sign (“HMO”).

My understanding is that this second argument overlapped with, but is different from, the first in that the extra non-objectionable portion of the mark (the hyphen) does not necessarily have to confer distinctive character.

62 In response, the Opponent argued, among other things, the following. First, since “HMO” is not an English word, the average consumer would visually read both “HMO” and “HM-O” in the same way: letter by letter, without the insignificant hyphen.³² Second, the addition of the “-” between “HM” and “O” would not alter the aural pronunciation of the Application Mark.³³

63 The Opponent also referred to two cases where a hyphen was considered to be insignificant in the marks-similarity comparison. They were: (a) *International Business Machines Corp and another v Web-Sphere Ltd and others* [2004] EWHC 529 (Ch) (“*WEBSHERE*”), an English High Court decision where “*WEBSHERE*” and “*WEB-SPHERE*” were held to be identical in the context of an infringement action; and (b) *Microsoft Corporation v Tokyo Micro-Soft (M) Sdn Bhd* [2008] 8 MLJ 510 (“*MICROSOFT*”), a Malaysian High Court (Kuala Lumpur) decision where Microsoft Corporation succeeded in an action for passing off against the defendant’s use of “Tokyo Micro-Soft”.

64 I agree that average consumers would not have regarded the hyphen as visually or aurally significant. But that is not all. In my judgment, what is equally—if not more—important is the function of a hyphen. A hyphen serves a joining function. It is used to join words or letters together, so that they would be read collectively. It informs average consumers that “HM” and “O” should be read together. This is common-sense and consistent with the context: that the oligosaccharides (“O”) present are the same as those found in human milk (“HM”). What this means, then, is that average consumers are not accustomed to regarding a hyphen as having any special or additional meaning. Adding it to “HMO” would not alter its distinctive character.

65 Turning next to *WEBSHERE* and *MICROSOFT*, I note that they involved a comparison of competing word marks rather than the inherent distinctiveness of an abbreviation.³⁴ Nevertheless, they helpfully illustrated the same point from a different angle. And the point is this: average consumers are not used to according any sort of trade mark significance to the presence of a hyphen. Otherwise, a mark that incorporates such a hyphen would be considered distinguishable from a mark that does not: an absurd proposition that holds no water.

66 For these reasons, I reject the Applicant’s first argument.

67 As regards the Applicant’s second argument, it is instructive to consider the following English decision where a similar argument succeeded: “*Cycling IS ...*” *Trade Mark Application* [2002] RPC 37 at 729 (“*Cycling IS...*”). The application was for the following two signs, in series:

³² Opponent’s Written Submissions at [34]

³³ Opponent’s Written Submissions at [40]

³⁴ Applicant’s Written Submissions in Reply at [5] – [6]

“Cycling IS ...”

“Cycling
IS ...”

Cycling IS... was heard by Hobbs QC sitting as Appointed Person. He found that the ellipsis (i.e. the three dots) visibly invited people to add meaning to the words. Importantly, while the combination of the words did not lack descriptive power, the description was unfinished. For this reason, the marks were held to not consist exclusively of descriptive matter. It thus escaped the descriptiveness objection.

68 Quite obviously, the punctuation in this case is different from *Cycling IS...*. A hyphen fulfils a different function from an ellipsis. Three dots may create an awkward unfinished description for the reader, but a hyphen does not. Instead, it joins the parts together; nothing more, nothing less. “HM-O”, as a whole, retains the exclusive descriptiveness of “HMO”.

69 My findings relating to the hyphen are not inconsistent with *Marvelous*, an earlier *ex parte* decision of this tribunal. In that case, an examiner’s refusal to allow registration of “

MARVELOUS!

” in respect of various goods and services was upheld by this tribunal on the basis of ss 7(1)(b) and 7(1)(c) TMA (the same two grounds raised in this case). The hearing officer considered the exclamation mark to be one that “*accentuated*” the word “MARVELOUS” (see *Marvelous* at [39]). She did not disregard the punctuation, but evaluated it appropriately in light of how it would be ordinarily perceived. And her conclusion was that the various features, including the “!”, were unlikely to alter public perception of the mark as being descriptive of the quality, intended purpose, or other characteristics of the goods/services.

Conclusion to s7(1)(c) ground of objection

70 For the reasons above, I find that the ground of objection under s 7(1)(c) TMA has been established and accordingly would refuse registration of the Application Mark.

Partial opposition

71 There is one final point that I should address.

72 The Applicant argued in the alternative that *even if* the Opponent’s evidence showed that the Application Mark was descriptive in relation to milk and milk-based products, it nevertheless fell short of proving descriptiveness (or non-distinctiveness) in respect of the non-milk products applied for under the Application Mark. Flowing from this, at the very least, the Registrar should allow the Application Mark to be registered for non-milk products.³⁵

73 Although the Applicant did not frame its alternative argument as such, it was in essence a request for an order for partial opposition. However, the Applicant did not set out what it considered to be the basis on which such an order might be made. Since it is not for this tribunal to formulate arguments for the Applicant, I confine myself to the following observations.

³⁵ Applicant’s Written Submissions at [35]

- a. There has never been a clear jurisdictional basis for permitting a partial opposition in Singapore and it appears that such an order has never been made in Singapore. (A slightly different order was made in *Nike International Ltd v Campomar SL* [2001] SGIPOS 4 under an earlier version of the TMA: see *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9 (“*Tencent*”) at [91(b)].)
- b. In *Tencent*, I expressed the view that the Registrar does *not* have the power under the TMA to make an order for partial opposition under s 8(2)(b) TMA and s 8(4) TMA (see *Tencent* at [74] – [92]). While it is true that *Tencent* did not involve an opposition under s 7(1)(c) or 7(1)(b) TMA, similar considerations apply to both cases. In brief, I think that a good case can be made that the Registrar has no power under the TMA to allow a partial opposition on the pleaded grounds of opposition.
- c. It remains unclear whether the non-availability of partial oppositions extends to multi-class applications. In *Tencent* I noted in parentheses that it was “*uncontroversial that the Registrar can refuse an opposition in one class and allow it in another; the issue is whether the Registrar can refuse the registration of certain goods or services in a certain class, but allow it for others in the same class*” (see *Tencent* at [79]). That observation was made in relation to the specific dispute at hand wherein the issue was not raised, but I do see how it could be argued either way in a number of different situations. Consider this hypothetical scenario: if I find that the Application Mark was descriptive or non-distinctive in Class 5, does it mean that the Class 29 application must be refused registration as well? What if—assuming for argument’s sake only—the mark is distinctive in relation to the Class 29 goods? There does not appear to be any satisfactory answer, but at least on the present facts the conundrum does not arise because I have found the Application Mark to be objectionable in both classes.

74 Returning to the main point, what all of this means is that it is not necessary for the Opponent to establish that the Application Mark was descriptive (or non-distinctive) in respect of each and every one of the items in the specification of goods. It is enough to prove a case in relation to *at least one* of the goods claimed. And so while it might be arguable that the Application Mark was not descriptive (and hence distinctive) of non-milk goods such as cooked dishes in Class 29, nothing ultimately turns on it.

75 If this seems unduly harsh, my response is this. In opposition proceedings, a trade mark applicant always has the option of discussing with the opponent the possibility of amending the specification of goods (or services) in order to address the objection either in whole (if possible) or at least in part. Alternatively, it may apply to divide the application into two or more applications in order to hive off the goods or services in respect of which it might have better chances of success so that they might be in a better position to survive. There may also be other avenues available, depending on the circumstances of each case.

Section 7(1)(b) TMA: marks devoid of any distinctive character

76 I now turn to s 7(1)(b) TMA, which prevents registration of marks that are “*devoid of any distinctive character*”.

77 While a mark can be devoid of any distinctive character under s 7(1)(b) TMA without also being unduly descriptive for the purposes of s 7(1)(c) TMA, the converse is not true. A mark which is unduly descriptive for the purposes of s 7(1)(c) TMA is necessarily devoid of distinctive character for the purposes of s 7(1)(b) TMA. (See *Kerly's* at [10-062].)

78 Above, I found the Application Mark to have been unduly descriptive and therefore objectionable under s 7(1)(c) TMA. It follows that I also consider the Application Mark to have been devoid of distinctive character under s 7(1)(b) TMA for substantially the same reasons.

79 Even if I am wrong in concluding that the Application Mark was not *exclusively* descriptive because the hyphen constitutes a material or tangible addition that does not designate a characteristic of the goods, it would nevertheless be caught by s 7(1)(b) TMA.

80 A similar scenario took place in *Cycling IS...* where the marks, despite having evaded the descriptiveness prohibition because of the ellipsis, were held to be nevertheless devoid of distinctive character in relation to “*clothing, footwear and headgear*” in Class 25 and “*advertising, all relating to the cycling industry*” in Class 35. In Hobbs QC’s view, the signs would be perceived by the relevant class of persons as pronouncements identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. Importantly, he did not consider the nature of the pronouncement or its presentation (which necessarily included the “*IS*” in uppercase followed by the three dots) as being sufficiently striking to function as an indication of trade origin in relation to the relevant goods or services. They would, in his judgment, be considered as origin neutral rather than origin specific.

81 So too, here. I consider that average consumers of the goods would not have regarded the Application Mark as designating trade origin. Simply put, if “HMO” was descriptive and hence non-distinctive of the goods, then “HM-O” must be devoid of distinctiveness as well. The hyphen is not distinctive *per se*, and its presence in the Application Mark does not render the mark distinctive as a whole.

Conclusion to s7(1)(b) ground of objection

82 I would therefore refuse registration of the Application Mark under s 7(1)(b) TMA.

Acquired distinctiveness not pleaded

83 At times, a trade mark applicant (or in invalidation cases: registered proprietor) may seek to overcome a distinctiveness attack through evidence of acquired distinctiveness through use.

84 The Applicant did not attempt this route, and after reviewing the evidence in detail one can see why: there was no evidence that it or indeed any other company in the Nestlé group of companies had ever used “HM-O” in the trade mark sense, or advertised “HM-O” as being a trade mark. On the contrary, Nestlé educated the public about human milk oligosaccharides through the HM-O Academy and in so doing abbreviated the term as “HMOs”. As such, the Application Mark would not be perceived as designating trade origin.

State of play in foreign jurisdictions

85 Arguments were advanced on both sides concerning: (a) foreign opposition or cancellation decisions relating to “HM-O”; (b) office actions by trade mark offices where

distinctiveness objections to “HM-O” were raised; and (c) the fact that “HM-O” is registered in a number of other jurisdictions.

86 I have considered the evidence relating to the present state of play abroad, and it has informed my view of the dispute. Be that as it may, I do not think that it is meaningful to discuss such evidence at length since the only average consumers that matter for the purposes of the descriptiveness/distinctiveness analysis are those in this country.

87 But I will say this. As a practical matter, a trade mark examiner may not always be able to uncover the type of evidence that the Opponent has presented before this tribunal in the context of an *inter partes* challenge. Thus it is not surprising that “HM-O” has been successfully registered in various jurisdictions. What is telling, however, is that the Applicant has yet to succeed in any of the challenges by the Opponent abroad to its applications/registrations for “HM-O”. My present decision does not deviate from this trajectory.

Conclusion

88 As the curtain falls, I would sum up this dispute thus. At heart, this case concerned an attempt by one trader to obtain an impermissible monopoly over a descriptive sign that it as well as other traders were using—and indeed continue to use—in a descriptive fashion. As a matter of policy, descriptive signs which honest traders use, or may wish to use without improper motive, must remain free (see: *Love & Co* at [70]). The privilege of a monopoly should not be conferred where it might require honest men to look for a defence (see *Big Box* at [40]). If the Application Mark were registered, the Applicant would be able to wield it against a competitor using an identical mark (HM-O) or a similar mark (e.g. HMO and HMOs) for identical or similar goods. Perhaps in infringement litigation, a less well-resourced defendant might yield to a demand letter even if it has a good arguable defence in principle (see *Marvelous* at [58]). But it should not have to come to that: ss 7(1)(c) and 7(1)(b) TMA seek to ensure this.

89 Having considered all the pleadings and evidence filed and the submissions made in writing, I allow the opposition under s 7(1)(c) as well as s 7(1)(b) TMA and consequently refuse registration of the Application Mark.

90 The Opponent is entitled to the costs of this action.

Date of Issue: 18 June 2019

[The appeal from this decision to the High Court was dismissed.]