

Intellectual Property Office of Singapore Case Summary: Bavaria N.V. v Bayerischer Brauerbund E.V. [2019] SGIPOS 17

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This is the first case in Singapore where an application for a collective mark has been opposed.

Briefly, a collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by *members of an association to distinguish* those goods or services from goods or services so dealt with or provided by persons who are *not members of the association*.¹ This is in contrast to a “normal” trade mark which serves to identify *a specific trader* as the source of goods or services.²

This raises interesting issues when deciding if the grounds of opposition succeed:

- (i) The collective mark scheme is but one avenue of protecting geographical indications (GIs).³ By seeking to protect a GI as a collective mark under the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”), it must necessarily mean that the collective mark *must* exude some modicum of distinctiveness so as to distinguish the relevant goods from goods which are not provided by members of that association.⁴
- (ii) Under the Act, a collective mark is subject to the provisions in the First Schedule in addition to the common grounds of objection for a trade mark (such as section 7 and / or section 8 of the Act). Paragraph 4(1) of the First Schedule provides (among other things) that a collective mark shall not be registered if the public is likely to regard it as something other than a collective mark (e.g. if the public thinks it is a “normal” trade mark). In such a situation, paragraph 4(2) of the First Schedule empowers the Registrar to require that the collective mark applied for include some indication that it is a collective mark (e.g. by adding the words “collective mark” to the application).

The Registrar was of the view that:

- a. Paragraph 4(2) of the First Schedule is applicable regardless whether the objection raised to the application is “absolute” (where a mark is considered objectionable in and of itself) or “relative” (where a mark is considered objectionable due to an earlier right);
 - b. Any amendment to a collective mark required by the Registrar under paragraph 4(2) to overcome the objection under paragraph 4(1) may not obviate the need to assess a collective mark against section 8 of the Act.
- (iii) In assessing the element of “the likelihood of confusion” under section 8 of the Act, the fact that a collective mark is *typically* used by companies alongside their own trade marks to indicate their membership in a certain association is merely *one* example of notional use; in such an instance, it would be too speculative to take into account the indeterminate primary marks (the collective mark being the secondary mark). The collective mark should therefore be compared with the prior marks relied upon by the opponent.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/bavaria-v-bayerischer-brauerbund-2019-sgipos-17.pdf>.

¹ Section 60(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”).

² Section 2 of the Act.

³ The main vehicle for protection of GIs is the Geographical Indication Act (“GIA”) (2014). Starting from 1 April 2019, it is possible to apply for registration of certain GIs under the GIA. This was not an option when the collective mark in the current case was applied for.

⁴ This flows logically from the definition of a “collective mark” above.