

Intellectual Property Office of Singapore Case Summary: In the matter of a trade mark application by Ferrero S.p.A. [2019] SGIPOS 19

Source: <https://www.ipos.gov.sg/protect-ip/hearings-mediation/legal-decisions>

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Registered trade marks are potentially valuable property rights for their proprietors. However, if granted too freely, they can also be obstacles to legitimate competition. The Trade Marks Act therefore seeks to maintain a proper balance.

This case deals with an application by Ferrero S.p.A. (the “Applicant”) to protect the following mark:



(the “Application Mark”)

in Singapore on 23 December 2013 in respect of “Pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices.”

One of the grounds for refusing to register a trade mark relates to the failure of the applied-for mark to fulfil the essential function of a registered trade mark, which is to indicate the trade origin of the goods and/or services for which it is registered. It is in the public interest that the Register be kept free of trade marks that do not function as indicators of trade origin.

In general, the shape and packaging of products can be functional, attractive to look at, out of the ordinary or just plain. Rarely, however, will that shape and packaging in themselves and without education of the relevant public be inherently distinctive as an indication of the trade origin of the product. For the latter, the consumer will normally look to, rely on and ask for the word or logo on the product. Nevertheless, through extensive advertising, promotion and sale of products bearing a distinctive trade mark such as a word, that shape and packaging may sometimes become recognised even without that word mark.

The primary focus of the decision was whether the Application Mark had in fact acquired a distinctive character as a result of the use made of it. The distinctive character that must be present is not just any distinctiveness, such as might result from an “unusual, new or visually distinctive” shape (as affirmed by the Court of Appeal in **Société des Produits Nestlé v Petra Foods Ltd** [2017] 1 SLR 35 at [33]). For trade mark registration purposes, it is only sufficient where distinctive character *as an indication of origin* is conveyed by the appearance of the mark in itself. If the Application Mark had indeed acquired distinctiveness as a result of the use made of it, then the objection that it was devoid of any distinctive character could be waived.

What is clear from the Applicant’s evidence is that there have been very extensive sales to and in Singapore of FERRERO ROCHER chocolate products, although such evidence also shows that the overwhelming majority of such sales were in boxes that featured prominently the word mark “FERRERO ROCHER” on the outside as well as on each of the individually-wrapped pralines. In all of the promotional / point of sale material where a product can be discerned, the brand FERRERO ROCHER is prominently featured.

The IP Adjudicator observed that the Application Mark was a composite mark in which there is added to that shape and colour: first, a brown pleated paper cup that serves the function of preventing the ball-shaped chocolates from rolling around in the box they are sold in and; second, an oval white sticker (on which the word mark “FERRERO ROCHER” is printed when the Application Mark is used in practice). These additions achieve, in the words used by the Applicant, a “coordinated package design”. Despite this, it cannot be correct to permit registration for chocolate products of a mark whose main feature is a gold spherical ball shape merely because the Application Mark combines with that shape and colour these other features: a brown pleated paper cup with two gold stripes around it and a white oval sticker. None of these features adds anything to the trade mark distinctiveness of the Application Mark as a whole because the average consumer would view them as merely functional or decorative elements.

The Applicant also had a survey conducted, in which 400 people in 24 locations around Singapore were asked “Do you know this product?” when shown a picture of the Application Mark. The IP Adjudicator considered that the survey results fail to show that the Application Mark functions as an indication of trade origin absent the distinctive word mark

FERRERO ROCHER. Recognition and association are not sufficient, there must be shown to be distinctiveness of the Application Mark as a trade mark on its own.

The IP Adjudicator therefore maintained the objection that the Application Mark is devoid of any distinctive character and could not be protected in Singapore.

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/in-the-matter-of-a-trade-mark-application-by-ferrero-2019-sgipos-19.pdf>.