

Intellectual Property Office of Singapore Case Summary: The Pâtissier LLP v Aalst Chocolate Pte Ltd [2019] SGIPOS 6

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In this dispute, a registered trade mark is sought to be revoked on the ground of non-use. The proprietor did not use the mark in the exact form registered. This decision therefore deals primarily with the approach to such scenarios and whether the actual use here satisfies the use requirement.

Aalst Chocolate Pte Ltd is the Registered Proprietor (“the Proprietor”) of the following trade mark (“the Subject Mark”):



in Singapore in Class 30 in respect of “Chocolates; chocolate-based products; cocoa products; chocolate chips; chocolate bars; chocolate candy; chocolate creams; chocolate extracts; chocolate-based beverages; chocolate beverages with milk; chocolate sauce; chocolate fudge; liqueur chocolates; milk chocolate; chocolate coated nuts; chocolate truffles and sweets; cocoa; coffee-based beverages; snack foods consisting principally of chocolate; chocolate base aerated beverages; cocoa-based beverages; chocolate wafers; confectionery; biscuits; cakes; coffee; tea; tea-based beverages; caramels [candy]; candy for food; cookies; prepared desserts [chocolate based]; flavorings, other than essential oils, for beverages; ice cream; pastry; pies; sugar confectionery; puddings; fondants [confectionery]; mousse confections; bread and bakery products; buns; prepared snack foods; tarts, all included in class 30”.

The Pâtissier LLP (“the Applicant”) applied for revocation of the above registration on the basis of non-use. The Trade Marks Act (“the Act”) requires that a registered mark be used within 5 years from the completion of the registration process, and that there is no consecutive 5-year period of non-use at any time.

The Proprietor’s best evidence of use of its mark is as follows:



The Proprietor conceded that there was *no evidence of any use* of the Subject Mark *in the exact form* in which it had

been registered. The focus was whether the Proprietor’s usage of the “Pâtissier-hat device”,  , on its own, qualified under Section 22(2) of the Act as “use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. If it did, there would have been “use” of the registered mark.

The IP Adjudicator considered that the distinctive character of the Subject Mark resides in the combination of two

distinctive components – the Pâtissier-hat device and the “Aalst Chocolate word element”,  – within a single composite mark.

The IP Adjudicator then considered whether use of the Pâtissier-hat device *on its own*, without the concurrent use of the Aalst Chocolate word element below it (as portrayed in the Subject Mark), constitutes “use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. He determined that the Aalst Chocolate word element would be regarded by the average consumer as a distinctive element (i.e. a component that will catch the eye of the average consumer looking at the Subject Mark as a whole). Thus, the excision of the Aalst Chocolate word element from the Subject Mark when the Proprietor chose to use the Pâtissier-hat device on its own means that the latter is different from the former in respect of a distinctive element. This difference between

the registered form and actually used forms of the trade mark led the IP Adjudicator to conclude that the variant of the Subject Mark used by the Proprietor is one that has altered the “distinctive character” of the Subject Mark.

As such, the forms of the mark that have been actually used by the Proprietor do not fall within the scope of Section 22(2) of the Act and cannot be relied upon as evidence of use of the Subject Mark during the relevant 5-year periods. There being no other better evidence of use of the Subject Mark, its registration is to be revoked as from 25 July 2013 (being the first day immediately following the end of the 5-year period from the completion of registration).

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/the-patisserie-v-aalst-chocolate-2019-sqipos-6.pdf>.