

Trade Mark Practice Developments in Singapore between 2008 and 2009

DECISIONS OF THE REGISTRAR OR TRADE MARKS.

IN THE MATTER OF TRADE MARK APPLICATION NO. T05/07253E BY CROWN CONFECTIONERY, CO., LTD. AND OPPOSITION THERETO BY MORINAGA & CO., LTD. (8 May 2008)

The Applicant is a confectionery company from Korea. The Applicant applied for the trade mark "MYCHEW" ("the Application Mark") on 28 April 2005 in Class 30 in respect of "*Chewing gum, not for medical purposes; candy for food; caramels [candy]*". The Applicant claimed that "MYCHEW" was coined from the Korean version of "MYCHEW" and that the mark had been put to use in Korea since 2004 and since 2005 in Singapore.

The Opponent is the registered proprietor of the trade mark "HI-CHEW" in Singapore. "HI-CHEW" was registered on 3 February 2001. They are also the registered proprietors of the label marks consisting of the "HI-CHEW" element such as "HI-CHEW" & "HI-CHEW GREEN APPLE" in Japanese Katakana characters with green apple device. Their marks are registered in class 30 including "*Biscuits, chocolates, caramels, snacks, cakes, ice cream, cocoa, hotcake mix, candy and gum*". The Opponent claimed to have used their "HI-CHEW" trade marks in Japan since 1975 and in Singapore since 1981.

The Opponent claimed the following :-

- (i) that "MYCHEW" was identical and/or similar to their "HI-CHEW" marks and was applied for identical goods;
- (ii) that use of the Application Mark was liable to be prevented under the law of passing off. The Opponent submitted that "MYCHEW" is not capable of distinguishing the Applicants' goods from the Opponent's goods in the course of trade;
- (iii) that "MYCHEW" is devoid of any distinctive character; and
- (iv) that the Applicant would have been aware of the Opponent's "HI-CHEW" marks and chose "MYCHEW" with an intention to ride on Opponents' extensive reputation and goodwill in the "HI-CHEW" trade marks. The Opponent claimed that the Applicant acted in bad faith the basis that the Applicant's choice of trade mark fell short of the standards of acceptable commercial behaviour because the parties were in competition.

The opposition was refused and the application was allowed to proceed on the following grounds :-

1. "MYCHEW" and "HI-CHEW" are not identical to each other. Further, "MYCHEW" and "HI-CHEW" are slightly similar phonetically but not visually or conceptually. As the goods were everyday consumer items, which the consumer could pick and choose, the visual and conceptual differences far outweighed the phonetic similarities at the time the consumer purchases the respective goods. As the Opponent did not demonstrate a likelihood of confusion on the part of the public, the opposition under failed on these grounds.
2. Despite the Opponent's goodwill in their "HI-CHEW" trade marks, there was no misrepresentation by the Applicant leading or likely to lead the public to believe that the goods offered by them were the goods of the Opponent and Opponent's interest in their trade mark had not been damaged.
3. The Registrar considered that "MYCHEW", is not devoid of any distinctive character so the opposition failed on this ground.
4. On the evidence, the Applicants coined the word "MYCHEW" as their trade mark and even if they were aware of the "HI-CHEW" trade mark, bad faith cannot be established as their choice of trade mark did not fall short of the standards for acceptable commercial behaviour.

IN THE MATTER OF TRADE MARK APPLICATION T05/21789D BY SOCIETE DES PRODUITS NESTLE S.A. ("Nestle") AND OPPOSITION THERETO BY NUTRICIA INTERNATIONAL B.V. ("Nutricia") (8 June 2009)

Nestle filed a trade mark application for "PROTECT" in class 5 for use on "*Dietetic foodstuffs and substances for medical and clinical purposes; food and food substances for babies, milk for infants, milk for babies, milk substitutes for babies; food and food substances for medical purposes for children and the sick; foods and food substances for medical use for nursing mothers; nutritional and dietetic supplements for medical use; vitamin preparations, preparations made with minerals; dietetic confectionery for medical use*".

The Application was opposed by Nutricia, a specialist baby food and clinical nutrition company. Nutricia claimed the mark applied was devoid of any distinctive character and consists of a sign or indication, which may serve in trade to designate the intended purpose or characteristic of the goods. Nutricia also claimed that the mark applied consisted exclusively of signs or indications, which have served to become customary in the bona fide and established practices of the trade.

The Application was refused registration for the following reasons:

1. The Registrar held "PROTECT" did not have inherent features or characteristics that are sufficiently unique to enable it to immediately function as a badge of origin of one specific undertaking when used in relation to milk, foodstuff and dietetic substances such that the average consumer is able to differentiate the Applicants' goods from those originating from other traders.
2. In addition, the fact that other traders would use "protect" in the industry, makes it unlikely that the average consumer would associate the "PROTECT" mark with the goods of the Applicant. The Registrar would that the mark is devoid of any distinctive character.
3. From the evidence lodged, it is clear that when buying such goods, especially for infants or young children, one primary "intended purpose" of choosing the goods is the ability to "protect" the health of the infant or child consuming it. The Registrar concluded that the Applicant's "PROTECT" mark consists exclusively of a sign that may serve, in trade, to designate the intended purpose or other characteristic of the goods in question. It was concluded that the mark is descriptive.
4. However, the Opponent failed to demonstrate, with the support of evidence, that the Application Mark consists exclusively of signs or indications, which have become customary in the bona fide and established practices of the trade. The fact that "PROTECT" designates the intended purpose or is descriptive of the goods does not mean it is generic.

SIGNIFICANT LEGAL DECISIONS IN THE COURTS

Love & Co Pte Ltd v The Carat Club Pte Ltd [2009] 1 SLR 561; [2008] SGHC 158

“LOVE” is the registered trade mark of the Defendant, The Carat Club Pte Ltd. The Plaintiff, Love & Co Pte Ltd, sought to invalidate and/or revoke this trade mark registration. The Defendant first opened its outlet in Singapore in 2002. The Defendant conceptualized the idea of having its own branded diamonds, which led to the creation of “the LOVE Diamond”. The Defendant applied and registered the trade mark shown below for “*Diamonds in Class 14*” which included a disclaimer of the word “Diamond” and the device of a diamond.



Approximately 13 months after the registration of “the LOVE Diamond” mark, the Defendant successfully registered the “LOVE” mark on 19 April 1999, the subject registration in this case. The mark was registered for “*Diamonds, jewellery, and precious stones*”. Unlike the registration for the “the LOVE Diamond”, there was no condition or limitation attached to the registration. The Defendant did not register “LOVE” elsewhere. The Defendant exhibited copies of advertisements and product catalogues promoting “the LOVE Diamond” and the “LOVE” trade mark.

The word “LOVE” however was featured with some motif design or a representation of a diamond filling up the center of the capital letter “O”. The Defendant could not provide the sales turnover for the simple “LOVE” trade mark but claimed that the sales figures provided in their Director’s Affidavit related to both the “LOVE” and “the LOVE Diamond” trade marks.

The Defendant submitted that “LOVE” is a fanciful mark adopted by the Defendant to distinguish its jewellery products from those of other traders. The word “love” does not describe attributes of diamonds and whilst these are given as expressions of love, this does not mean the word “love” cannot function as badge of origin for the goods of one undertaking. The Defendant also claimed that their simple “LOVE” mark had acquired distinctive character after the registration of their mark in 1999 as a consequence of its use in the jewellery trade.

The Plaintiff submitted that “LOVE” cannot by itself, distinguish jewellery of one store from another. Jewellery is often purchased to express love and is closely associated with the idea of love. The Plaintiff provided some examples of other jewelers using “Love” in connection with their jewellery stores. The Plaintiff therefore claimed that “LOVE” is incapable for distinguishing the Defendant’s jewellery from another trader’s, that the mark was devoid of any distinctive character and designates the intended purpose of jewellery and is a sign, which has become customary. The Plaintiff also claimed that the registration should be revoked on the grounds of non-use.

The Court found as follows :-

- (i) The simple “LOVE” mark is capable of distinguishing the defendant’s jewellery in the course of trade from those of other jewelers. The mark therefore qualifies as a trade mark. The simple ‘LOVE” mark is also not descriptive of a diamond, a ruby ring or a gold bangle – the fact that it is descriptive of the intended purpose of the jewellery does not mean that it is similarly descriptive of all other aspects or characteristics of jewellery. Consequently, the Plaintiff’s first claim was dismissed.

- (ii) Is "LOVE" devoid of any distinctive character? The Court ruled that since the Defendant had decided on a rather low level of uniqueness in the design of its simple "LOVE" mark, the higher the risk will be that it is devoid of any distinctive character. It is doubtful that the average discerning consumer will be able to immediately recognize jewellery inscribed with the word "LOVE" as identifying the Defendant to be source of the goods, especially when one takes into account evidence of the extensive adoption and the ubiquitous use of the same mark or almost identical marks by other jewellery traders. The simple "LOVE" mark on its own does not have any distinctive character to differentiate the Defendant's goods without first educating the public that it is employed by the Defendant as its trade mark.
- (iii) Does "LOVE" designate the intended purpose of jewellery? It is purchased for self-adornment, bought as gifts for loved ones and to be tangible expressions of love. It does therefore, designate one of the intended purposes of jewellery.
- (iv) Is "LOVE" a sign, which has become customary? It is still an overstatement to claim that "love" is a generic term for jewellery or to assert that it has become customary usage for such goods. This claim was dismissed.
- (v) The Court found there was no evidence of use of the simple "LOVE" mark prior to its registration. The Defendant only began its operations in Singapore in 2002. There was no evidence to show demonstrate the education of the public in the form of advertisements of the simple "LOVE" mark on its own. The mark seems to be treated very much as redundant or nearly non-existent trade mark by the Defendant.

The Court found in favour of the Plaintiff for their application to revoke the "LOVE" trade mark registration for non-use. The Defendant had not been able to show evidence of genuine use of the registered mark i.e. "LOVE" on its own, without additional motifs or design. The Defendant appeared to have promoted "the Love Diamond" extensively but not "LOVE". The sales figures supplied as evidence was misleading as it related to both marks rather than "LOVE" specifically. The burden was on the Defendant to show genuine use in the course of trade in Singapore and this burden was not discharged with evidence. No proper reason was furnished for non-use of the mark either. As such the registration of the simple "LOVE" mark was revoked for non-use.

Trade Mark Registry Circulars and Practice Directions for 2008 to 2009

(1) **Registry Circular No. 11/2008 dated 4 July 2008**

Image of e-filed mark

The Intellectual Property Office of Singapore, IPOS that images on some trade mark applications filed electronically appear with blurred or jagged lines. This is because applicants attach images of the marks with a lot of background or blank space, which IPOS then has to adjust resulting an inaccurate depiction of the trade mark applied.

In order to ensure that the image of mark is accurately captured by IPOS, applicants should crop the mark with little background or blank space and save the image as approximately 480 x 480 pixel. This will remove the need for IPOS to adjust the image and the applicant can then obtain clear and accurate image of the mark at the time of publication and registration.

(2) **Registry Circular No. 14/2008, dated 26 September 2008**

Return of Assignment Deed and Other Registrable Transaction Documents

The Registry will stop its practice of returning deeds of assignment and other documents for other registrable transactions. However, should the applicant wish for the return of such documents, he could make his request known at the time of filing the recordal application in a cover letter accompanying the application to that effect. This practice will affect all applications lodged on or after 1 October 2008.

(3) **Registry Circular No. 17/2008, dated 28 November 2008**

Launch of e-Communications Portal on 1 December 2008

IPOS launched the e-Communications Portal on 1 December 2008. This is an electronic online system developed by IPOS for the main purpose of facilitating the sending, receipt and exchange of all correspondence, relating to trademark applications and prosecutions, between IPOS and registered account holders. Some 16 law firms are participating in the pilot scheme. The Trade Marks Rules have been amended to give effect to the sending, receipt and exchange of correspondence via the e-Communications Portal. The Rules will provide for service of documents by the Registrar as well as by applicants by electronic communication through the e-Communications Portal.

(4) **Registry Circular No. 18/2008 dated 12 December 2008**

Application for Renewal of Registration (Form TM 19)

With effect from 1st January 2009, the Registrar will not issue renewal certificates. This applies to all applications for renewal lodged on or after 1st January 2009. Renewal applications filed on-line will be processed instantaneously and an acknowledgement of the renewal showing the extended expiry date will be displayed for printing for a period of one month from the date of renewal.

Where the application for renewal is posted or submitted over the counter, the applicant will receive an acknowledgement from the Registry. The onus will be on the applicant to check the expiry date of the mark at www.etrademarks.gov.sg within 2 weeks of lodgment of the application for renewal of registration to confirm that the Registry has extended the expiry date. This change in practice does not apply to applications for late renewals and for the restoration and renewal of registrations removed from the Register.

(5) **Registry Circular No. 5/2009, dated 24 April 2009**

Trade Marks Work Manual

The Registry of Trade Marks has added six new chapters to the existing Trade Marks Work Manual. The six new chapters cover the following topics:

- (1) Marks contrary to public policy or morality;
- (2) Names and representation of famous people, building, etc;
- (3) Other grounds of refusal;
- (4) Deceptive marks;
- (5) Licences; and
- (6) Slogans.

(6) **Registry Circular No. 10/2009, dated 28 August 2009**

Costs for attending Case Management Conferences and Pre-Hearing Reviews

In course of opposition, invalidation and revocation actions, the Registrar has directed parties to attend case management conferences and pre-hearing reviews at the appropriate time for the purpose of achieving a just, expeditious and economical disposal of the matter. The Registrar will treat the costs for attending such case management conferences and pre-hearing reviews in the same manner as for attending interlocutory hearings. The costs may be included as party and party costs under the Trade Marks Rules to be awarded to the successful party at the end of the proceedings.

(7) **Registry Circular No. 8/2009 dated 3 July 2009**

Marks Published for Opposition Purposes.

Oppositions can be filed against the following:

- Application published before registration;
- Collective and certification marks published before registration;
- Alteration to registered marks;
- Amendment to regulations governing use of collective and certification marks;
- Application amended after publication.