

Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd
[2000] SGHC 145

Case Number : OM 4/2000
Decision Date : 21 July 2000
Tribunal/Court : High Court
Coram : Lim Teong Qwee JC
Counsel Name(s) : Dedar Singh Gill and Paul Teo (Drew & Napier) for the applicants; Lim Teng Leong (Donaldson & Burkinshaw) for the respondents
Parties : Sime Darby Edible Products Ltd — Ngo Chew Hong Edible Oil Pte Ltd

Trade Marks and Trade Names – Registration – Distinctive character – Existing trade mark – Trade mark of device of crossed spoons with words "Spoons Brand" on register and new word mark "Royal Spoon" also registered in same class – Whether "Royal Spoon" devoid of distinctive character – Whether marks similar such that there exists likelihood of confusion on part of public – ss 7(1)(b), 8(2)(b) & 23 Trade Marks Act 1998 (Cap 332, 1999 Rev Ed)

: This is an application by originating motion for:

A declaration that Trade Mark Registration No T98/12388G is invalid pursuant to s 23 of the Trade Marks Act 1998 and therefore deemed never to have been made.

and for other reliefs. At the conclusion of the hearing I dismissed it with costs. The applicant (‘Sime Darby’) has given notice of appeal and these are my written grounds.

The respondent (‘Ngo Chew Hong’) is the proprietor of the trade mark registered as number T98/12388G (‘Ngo Chew Hong’s trade mark’) in class 29 for ‘edible oils and fats’. The application for registration was made on 12 December 1998 under the Trade Marks Act then in force (‘old law’) and was accepted for registration in Part A of the register without any disclaimer or limitation. Upon the coming into force of the Trade Marks Act (‘new law’) on 15 January 1999 Ngo Chew Hong’s trade mark was an existing registered mark and it is a registered trade mark for the purpose of the new law. See paras 1 and 2 of the Third Schedule and see also para 10(1). Ngo Chew Hong’s trade mark is a word mark consisting of the two words Royal Spoon.

Sime Darby is the proprietor of the trade mark registered as number B74597 (‘Sime Darby’s trade mark’) in Part B of the register in class 29 in respect of ‘vegetable ghee being an edible oil for export to and sale in the Middle East and Africa’. This appears to be not only a description of the goods in class 29 but also a limitation of the right conferred by registration as to the use of the trade mark as indicated by the Registrar of Trade Marks in his letter of 29 June 1981. A representation of Sime Darby’s trade mark which appears in the certificate for use in legal proceedings issued by the Registrar of Trade Marks shows that it consists of the device of two crossed spoons and below the device the words ‘SPOONS BRAND’. There does not appear to be a disclaimer of either ‘Spoons’ or ‘Brand’. Sime Darby’s trade mark is also a registered trade mark under the new law and any disclaimer or limitation entered on the register kept under the old law is deemed to be transferred to the new register and has effect under s 30 of the new law.

The application as I was informed by counsel is made under s 23(1) on the ground that Ngo Chew Hong’s trade mark was registered in breach of s 7(1)(b) and further or alternatively under s 23(3)(a) on the ground that there is an earlier trade mark in relation to which the conditions set out in s 8(2)

(b) apply.

Section 7(1)(b) provides:

7(1) The following shall not be registered:

(b) trade marks which are devoid of any distinctive character;

and s 8(2)(b) provides:

8(2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

Section 23 provides:

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

(3) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 8 (1), (2) or (3) apply; ...

As Ngo Chew Hong`s trade mark was registered under the old law it may appear that s 23 has no application to it. I have heard no submissions from counsel on this but it seems to me that for the purpose of s 23 and to give effect to it existing trade marks such as Ngo Chew Hong`s trade mark must be considered as if they had been registered under the new law.

Section 7(1)(b)

A trade mark which is devoid of any distinctive character shall not be registered but s 7(2) provides that it shall not be refused registration by virtue of s 7(1)(b) if before the date of application for registration it has in fact acquired a distinctive character as a result of the use made of it. Sime Darby`s case is that Ngo Chew Hong`s trade mark is devoid of any distinctive character but it is not Ngo Chew Hong`s case that it has in any event acquired such a character.

In **British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281** the plaintiff had registered `TREAT` for `dessert sauces and syrups; all included in Class 30`. Jacob J said at p 306:

Next, is 'Treat' within s 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ('North Pole' for bananas) can clearly do. But a common laudatory word such as 'Treat' is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any [inherently] distinctive [...] character.

Section 3(1)(b) of the Trade Marks Act 1994 (UK) is in pari materia with s 7(1)(b). 'Treat' was a common laudatory word and was held to be devoid of any distinctive character.

A trade mark that consists of a combination of two or more words raises an additional problem. In **FROOT LOOPS TM** [1998] RPC 240 the trade mark was refused registration in respect of 'cereals and cereal preparations'. Simon Thorley QC (Appointed Person) said at p 242:

I believe Mr Waugh is correct in saying that regard must be had to the whole of the mark applied for and that dissecting it into individual words may cause one to lose sight of the effect of the mark as a whole. This however does not mean that the exercise of considering the effect of individual parts of a mark when assessing the effect of the whole is neither impermissible nor unhelpful. It can provide useful assistance along the road to reaching a conclusion as to the registrability of the whole but it must not be used as a substitute therefor.

and later at the same page:

The words 'froot' (fruit) and 'loops' when used separately in relation to cereal are, as the hearing officer held, words of a descriptive nature which might naturally be used to describe the nature of the goods. Indeed Mr James pointed out and Mr Waugh accepted that the presence in cereals of fruit was a common occurrence. Inherently therefore in my judgment the words 'froot' (fruit) and 'loops' considered separately are devoid of any distinctive character. Thus far I am in complete agreement with the hearing officer. Can linking the words together overcome this conclusion? I believe not. There is nothing about the combination which alters the individual character of the words. They are inherently devoid of distinctive character precisely because they are words which in combination may serve to designate the kind of goods in question.

In **BONUS GOLD TM** [1998] RPC 859 the trade mark was refused registration in respect of 'investment account services'. The appeal went before Simon Thorley QC again as the Appointed Person and he said at p 861:

As I see it, the question on this appeal is what could be the significance of the expression BONUS GOLD in relation to investment account services? Looking first at the word 'gold', it is a matter of common knowledge - as Mr Hodgkinson readily accepted - that gold is a word currently in relatively widespread use in the field of banking and finance to indicate some form of premium service. In relation to the class of goods for which registration is sought (investment account services) the term 'gold' is both descriptive and laudatory. So far as concerns the word 'bonus' that is not unknown in the financial field, but it is also extremely well-known and used as a descriptive term in the course of

ordinary use of language. Mr James suggested that by itself it was incapable of distinguishing and I think he is right.

The next consideration is whether putting the two together does create, as Mr Hodgkinson suggested, a combination phrase that has no real meaning in English which, at best, merely alludes to or points in the direction of the type of service to be provided, and was not as such contrary to s 3(1)(b) and (c).

I have concluded that this is a case where putting the two words together does give nothing more than the sum of the individual parts.

In **MESSIAH FROM SCRATCH TM** [2000] RPC 44 the trade mark was refused registration in respect of 'organisation of musical entertainment services; advisory and consultancy services all relating to the aforesaid services; all included in Class 41'. Again the appeal went before Simon Thorley QC as the Appointed Person and he said at paras 22, 23:

22 It was not, nor could it be, seriously disputed that the word Messiah when used in relation to musical entertainment would be taken as a reference to Handel's Messiah. I do not believe that it needs the aid of dictionary definitions to reach the conclusion that the suffix 'From Scratch' would be taken as [...] being a reference as some form of unrehearsed or impromptu musical performance. This likelihood is increased when one takes into account, as in my judgment it is to proper to do, the fact that the expression 'scratch orchestra' was known in the music business as a description of an informal or irregular gathering of musicians.

23 I am thus satisfied that Mr James was correct to hold that the mark 'Messiah From Scratch' could not be registered pursuant to the 1994 Act otherwise than on proof of a distinctive character pursuant to the proviso to s 3 having regard to the use made of it.

The proviso to s 3 of the UK Act is equivalent to s 7(2) of the new law.

I come now to the Royal Spoon trade mark. Mr Gill submitted that the word 'royal' was well-known and commonly used as a laudatory term to convey to the ordinary man's mind the sense of pre-eminence or of superior quality. I think so. In relation to edible oils or vegetable ghee, I think it is a descriptive word which may serve to designate the quality of the goods. A trade mark which consisted exclusively of this word would not be registrable without proof of acquisition of a distinctive character as a result of use made of it. This is covered by s 7(1)(c) which is not Sime Darby's case but I think Royal by itself would also be devoid of any distinctive character under s 7(1)(b).

Mr Gill said that the representation of a spoon or spoons in the packaging of edible oils and fats was very common in the industry as admitted by Ngo Chew Hong. He also referred to the affidavit of Mr Yong Wee Hau who referred to a letter dated 19 October 1979 to Sime Darby's predecessor from its then solicitors who reported the Registrar of Trade Marks as having said that a spoon was commonly used for the measuring of cooking oil. This is clearly inadmissible as evidence of the common use of a spoon for that purpose. I would of course accept that a spoon would be commonly used for

dispensing oil or other substances found in the kitchen such as salt and the like from an open container or when poured into it and might also be used as a measure.

Is Spoon distinctive without having acquired a distinctive character as a result of use? The word denotes primarily a common utensil for domestic use but I think it is also a word of a descriptive nature in relation to items which are usually dispensed using such a utensil. It is a word which might naturally be used to describe the physical nature or characteristic of edible oils used in the kitchen. An illustration of a spoon dispensing a fluid or semi-solid substance might not mean much to anyone but once he sees that as a trade mark in relation to edible oils he would recognise the spoon as a utensil that is apt to describe the goods of a kind rather than those of a particular manufacturer. I agree that Spoon by itself is devoid of any distinctive character in relation to the goods in this case.

Ngo Chew Hong's trade mark consists not of Royal or Spoon separately but of the two words used in combination. Royal is a laudatory word but by linking it with an object such as Spoon the 'praise' is wholly directed towards it. It describes Spoon. It does not describe the goods. Any sense of pre-eminence or of superior quality conveyed to the ordinary man's mind (I take this from Mr Gill's argument) would be in relation to Spoon and not to the goods. I think it would be understood more in the sense of being kingly or majestic but it would in any sense in which the word is understood describe or attribute some quality to Spoon and not the goods. Again Spoon by itself may be associated with the goods but Royal Spoon in the sense the expression is likely to be understood by persons using the English language would be a wholly inappropriate phrase for edible oils or vegetable ghee (not unlike North Pole for bananas). In my judgment Royal Spoon is a trade mark which is not devoid of any distinctive character and if it had been registered under the new law its registration would not have been in breach of s 7(1)(b).

Section 8(2)(b)

It is not disputed that Sime Darby's trade mark and Ngo Chew Hong's trade mark are both registered in respect of similar if not identical goods. It is also not disputed that Sime Darby's trade mark was registered under the old law before Ngo Chew Hong's trade mark was registered. It was accordingly an earlier trade mark. What Sime Darby has to show is that Ngo Chew Hong's trade mark is similar to its trade mark and that because of the similarity there exists a likelihood of confusion on the part of the public. The likelihood of confusion has to be the result of the similarity to the earlier trade mark.

In **Pianotist Co's Application [1906] 23 RPC 774** the registration of the trade mark Neola in respect of 'a piano player, being a musical instrument included in Class 9' was allowed against the opposition of the registered proprietors of the trade mark Pianola in respect of all goods in the same class. Parker J said at p 777:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.

The question was whether Neola had 'such resemblance' to Pianola with respect to the same goods 'as to be calculated to deceive' but I think what Parker J said is helpful in relation to the question before me.

Neola and Pianola are both word marks but what I have to compare is a word mark Royal Spoon with a trade mark consisting of a device with the words 'SPOONS BRAND' below. Spoon is devoid of any distinctive character and so is its plural variation and Brand is clearly so. The two words are obviously not an essential part of Sime Darby's trade mark. The two trade marks look different. Even the two words in the non-essential part of Sime Darby's trade mark sound different from Royal Spoon.

A device trade mark or a combination trade mark which includes a device will often be recognised by its description in words. In **Re Trade Mark of John Dewhurst & Sons Ltd [1896] 2 Ch 137** the Comptroller-General of Patents, Designs, and Trade Marks refused to register a trade mark containing as an essential part of it words amounting to a verbal description of a mark already on the register. Lindley LJ said at p 147:

... we know perfectly well that if you once put upon the register a golden fan in the shape of a picture like Mr Boyd's, and you also put upon the register a mark called 'The Golden Fan,' although without a golden fan, the two must mislead the public ...

and later at p 148:

I think that it does not matter what the language is, nor what the hieroglyphics are, if their meaning is a mere verbal description of a mark already on the register. If you have got a mark on the register applicable to cotton goods of a golden fan, you cannot have another mark called a 'Golden Fan' in any language or in any hieroglyphics.

The device in Sime Darby's trade mark shows two spoons forming a St Andrew's or 'X' shaped cross with the handles of the spoons pointing down. Below the device are the words 'SPOONS BRAND'. The trade mark has been registered in respect of 'vegetable ghee being an edible oil for export to and sale in the Middle East and Africa'. There is no evidence as to what the trade mark would be described in words in the local language or languages but I do not think the language is relevant. If Sime Darby's trade mark can be described in words using any language and such words may fairly be translated as 'royal spoon' then the trade mark Royal Spoon would be similar to Sime Darby's trade mark for the purpose of s 8(2)(b).

I also have no evidence of the impressions Sime Darby's trade mark would leave in the minds of those who come across it but I must do the best I can and try to place myself in that position. It seems to me that the one feature that stands out is the 'X' shaped cross. It is represented by two spoons but the spoons themselves are not significant to any substantial degree at all. I would describe the trade mark as a 'cross' or as 'crossed spoons' or a 'spoon cross'. I will also see 'SPOONS BRAND' but that will leave no lasting impression even if noticed. They are common words and add nothing to the trade mark.

In **De Cordova & Ors v Vick Chemical Co [1951] 68 RPC 103** Lord Radcliffe said at p 106:

The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.

The impressions left in the mind are bound to be affected by imperfections in one's recollection. Sime Darby's trade mark is I think more likely to be remembered by the striking feature of the cross or spoon cross than by a 'photographic recollection of the whole' including the words in the non-essential part.

I have judged the two trade marks and taken into account all the relevant circumstances. I do not see that there exists any likelihood of confusion on the part of the public whether the 'public' is in Singapore or the Middle East or Africa and whether the 'public' is the consumer or otherwise. I do not see that there exists any likelihood of such confusion because of any similarity perceived or real between Ngo Chew Hong's trade mark and Sime Darby's trade mark. I do not see any similarity at all. In my judgment the conditions set out in s 8(2)(b) do not apply in relation to the registration of Ngo Chew Hong's trade mark.

There is one other matter that I should make reference to if only because the parties have placed some emphasis on it. There were earlier proceedings which culminated in a consent judgment dated 12 February 2000. Paragraph 1 of the judgment reads:

*[Ngo Chew Hong] whether acting by their directors, officers, servants or agents or any of them or otherwise howsoever be restrained from infringing and/or causing, enabling or assisting others to infringe [Sime Darby's trade mark] by the use in connection with [Ngo Chew Hong's] vegetable ghee **under** the brands 'Four Spoons Foodland Brand with the device of the crossed-spoons' and 'Royal Spoon Brand with the device of the crossed-spoons' as depicted in the Schedule attached hereto.*

Counsel for both parties agreed that the italicised word '**under**' ought to be read as 'of'. For all the differences to which the parties have given so much expression what seems to stand out from this part of the judgment is that it is the device of the crossed spoons that has given cause for the offence. The device as depicted in the schedule to the judgment is identical (so far as I can make out) with that in Sime Darby's trade mark. Royal Spoon with which I am concerned does not have any device as part of the trade mark as registered.

Outcome:

Application dismissed.