

Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and Another and Another Appeal
[2000] SGCA 29

Case Number : CA 184/1999,185/1999
Decision Date : 27 June 2000
Tribunal/Court : Court of Appeal
Coram : Chao Hick Tin JA; L P Thean JA; Yong Pung How CJ
Counsel Name(s) : Sarjit Singh Gill SC and Suhaimi Lazim (Shook Lin & Bok) for the appellants in CA 184/1999 and the respondents in CA 185/1999; Jimmy Yim SC and Steven Seah (Drew & Napier) for the respondents in CA 184/1999 and the appellants in CA 185/1999
Parties : Super Coffeemix Manufacturing Ltd — Unico Trading Pte Ltd and Another and Another Appeal

Tort – Passing off – Elements of tort – Whether elements established by plaintiffs – Whether descriptive mark had become distinctive of the plaintiffs' product

Trade Marks and Trade Names – Infringement – Whether descriptive word be used as trade mark – Whether defendants use essential feature of mark – Whether defendants infringed plaintiffs' mark

Trade Marks and Trade Names – Infringement – Injunctive or other relief – Whether defendants' products likely to be confused as plaintiffs' products – s 46(2) Trade Marks Act (Cap 332)

Trade Marks and Trade Names – Rectification of register – Expunging mark or imposing disclaimer over descriptive part of mark – Whether defendants "aggrieved" persons – Whether court has discretion not to expunge or order disclaimer – Whether plaintiffs' mark should be expunged or the term "COFFEEMIX" disclaimed – s 39(1) (a) Trade Marks Act

(delivering the judgment of the court): These are two appeals brought against a decision of the High Court [reported at [2000] 1 SLR 587] in an action for infringement of trade mark and/or passing off where the learned trial judge dismissed the action and also dismissed the defendants' counterclaim that the plaintiffs' trade mark 'SUPER COFFEEMIX' be expunged under s 39(1) of the Trade Marks Act or that the word 'COFFEEMIX' in the trade mark should be disclaimed.

The first appeal, CA 184/99, is lodged by the plaintiffs against the dismissal of the action. The second appeal, CA 185/99, is brought by the defendants against the dismissal of their counterclaim. To avoid confusion, we shall hereinafter continue to refer to the parties as 'plaintiffs' and 'defendants' (where necessary, either as the first or second defendant as the circumstances may require).

The plaintiffs, a Singapore registered company, are the registered proprietors of the trade mark 'SUPER & DEVICE COFFEEMIX' bearing registration number B2734/90 in respect of 'coffee'. The plaintiffs were incorporated as a private limited company in 1991. Before the incorporation, the shareholders were operating as a partnership under the name Super Coffeemix Enterprises (the partnership). In 1994, the plaintiffs became a public listed company and its shares were traded on the Stock Exchange of Singapore.

The plaintiffs (including their predecessor, the partnership) were and are in the business of manufacturing and selling convenient food products, particularly coffee and cereal products. One of their main products is a 3-in-1 instant coffee mix, comprising a mixture of coffee, sugar and non-dairy creamer. This product, when mixed with hot water, produces an instant coffee drink. It was first introduced by the partnership in 1987. The product was sold to the public under the mark 'SUPER COFFEEMIX'.

Since its first introduction, the demand for the product grew, so much so that in 1989, the partnership had to acquire new premises and machinery to cope with the increased orders. The plaintiffs (and their predecessor, the partnership) also expended considerable sums of money in promotion and advertising. Sales grew even more significantly. In 1993 the plaintiffs acquired a new and bigger factory.

The revenues from the sales of the product grew from \$599,220.92 in 1987 to \$8,267,930.62 in 1997. Their promotional and advertising expenses (covering all the plaintiffs' products and not just this product of 3-in-1 coffeemix) shot up from \$17,363 to \$6,060,247.45 during the corresponding period. Their advertisements appeared in print as well as on the television.

In the meantime, on 17 April 1990, the partnership applied to register in Part B of the Trade Marks Register their 'SUPER & DEVICE COFFEEMIX' trade mark for 'coffee' in Class 30. The application was allowed with a disclaimer over the word 'SUPER'. In 1993, the mark was eventually registered in Part B and the registration backdated to 1990.

The first defendants are a Singapore incorporated company, while the second defendants, an Indonesian company, have their business address at Desa Tanjung Morawa B, Kabupaten Deli Serdang, Indonesia. The second defendants are the manufacturers of INDOCAFE coffee products in Indonesia while the first defendants are the distributors of those products in Singapore.

The second defendants registered their trade mark 'INDOCAFE' in Part B of the Register on 23 November 1990 in respect of, inter alia, coffee. The first defendants have been selling INDOCAFE coffee products in Singapore since 1990. In July 1993, the first defendants began marketing a 3-in-1 mixture of coffee, sugar and non-dairy creamer under the 'INDOCAFE' trade mark and which also bore the additional style 'Coffeemix'.

We should add that when the plaintiffs first launched their 'SUPER COFFEEMIX' into the market in 1987, there were other brands of coffee mix in the market. One such brand was 'N-Rich' which in 1987 registered its trade mark 'N-Rich' in Part B of the Register for, inter alia, 'coffee mix'.

On 25 September 1995, the plaintiffs, through their solicitors, wrote to the first defendants informing the latter of the plaintiffs' rights in the trade mark, 'SUPER & DEVICE COFFEEMIX'. In the letter, the plaintiffs requested the defendants to refrain from advertising, exporting, importing, distributing and selling products bearing the trade mark 'Coffeemix'. However, the letter also expressly stated that there would be no objection if the first defendants were to use 'Coffee Mix' as two words. After some exchanges of correspondence, the plaintiffs' request was rejected by the defendants.

The plaintiffs commenced these proceedings on 1 September 1998 against the defendants for trade mark infringement and for passing off of their goods as plaintiffs' product, SUPER COFFEEMIX. The plaintiffs sought, inter alia, an injunction restraining further infringement and passing off and an inquiry as to damages or alternatively an account of profits. They also claimed goodwill in the name 'COFFEEMIX'. In their defence, the defendants denied any infringement or passing off, and counterclaimed to expunge the plaintiffs' registered trade mark or to impose a disclaimer over the word 'COFFEEMIX' on the ground, inter alia, that it is descriptive of the nature of the product.

On the plaintiffs' product the mark is presented in this manner: the word 'SUPER' is enclosed in a laurel device and below that is the word 'COFFEEMIX' in big bold capital letters. The defendants' mark consists of 'INDOCAFE' with the words 'FROM THE HOUSE OF' in the form of an arch over it and the word 'Coffeemix' below it in bigger print but not capital letters.

The decision below

The learned trial judge held that `to constitute infringement of a registered trade mark, the infringing mark must be used as a trade mark indicative of the origin or identity of the goods.` Furthermore, its use must be likely to deceive or cause confusion.

While the defendants conceded that their mark `INDOCAFE Coffeemix` is used in a trade mark sense, the trial judge nevertheless held that the word `Coffeemix` on the packaging of the defendants was not used in a trade mark sense. He referred to the fact that the plaintiffs do not object to the defendants using the word `coffeemix` in two words and said, if `coffeemix` in two words are descriptive, they must be so even when joined together as one word.

The trial judge also referred to the fact that the plaintiffs themselves did not use the word `Coffeemix` in the trade mark sense in their promotional materials and advertisements. He did not think the defendants` mark is confusingly similar to the plaintiffs` registered trade mark and, relying upon s 46(2) of the Act, he ruled that there was no infringement.

As regards the claim in passing off, the trial judge felt that in order for the plaintiffs to succeed they must prove that the word `COFFEEMIX` is distinctive of their product and none others as at the date of the alleged infringement, ie July 1993. Relying upon the results of a survey carried out on behalf of the plaintiffs where

(i) the vast majority of the interviewees who were aware of `SUPER` and `SUPER COFFEEMIX` did not regard `COFFEEMIX` as a brand;

(ii) they did not regard the word `coffeemix` to refer only to the plaintiffs` products, and none others; and

(iii) the plaintiffs` products were known either as `SUPER` or `SUPER COFFEEMIX` and not `COFFEEMIX` alone,

as well as the results of a survey carried out on behalf of the defendants which were to a similar effect, the trial judge decided that the plaintiffs had not established that the word `COFFEEMIX` had acquired a secondary meaning, indicating that that word mark had become distinctive of the plaintiffs` product. He also held that the survey results showed that there was really no confusion.

The learned trial judge dismissed the defendants` counterclaim to have the trade mark expunged or to have the word `COFFEEMIX` disclaimed on the ground that the defendants were not `aggrieved` persons within the meaning of s 39(1) of the Act. He did not go into the merits of the counterclaim.

Issues on appeal

Before us the plaintiffs contend that the trial judge was in error in the following main respects:

(i) that the word `Coffeemix` on the defendants product, `INDOCAFE Coffeemix`, is not used in the trade mark sense;

(ii) that the defendants` mark `INDOCAFE Coffeemix` is not likely to deceive or cause confusion and that the proviso to s 46(2) is applicable to the case.

The plaintiffs also submit that the trial judge was wrong to have found that the defendants had not committed the tort of passing off.

In relation to CA 185/99, the defendants' contention is that the trial judge was wrong to have held that the defendants were not an aggrieved party and that the counterclaim should not have been dismissed.

Trade mark

The plaintiffs do not dispute that 'COFFEEMIX' has a descriptive quality. They concede that they have been using the word 'Coffeemix' in a descriptive context together with other words like '3-in-1 instant' or '3-in-1' to connote that the product is a mixture of coffee, sugar and creamer. But they argue it does not follow that just because a mark is descriptive it cannot be a trade mark: see **Crosfield & Sons' Application** [1909] 26 RPC 837 at 857 and **Thermawear v Vedonis** [1982] RPC 44. Or that it cannot become distinctive: see **Reddaway v Banham** [1896] AC 199. Part B of the Register caters specifically for such descriptive marks. If a mark is an inventive one, it would have come under Part A of the Register.

We should mention that when the plaintiffs first applied for registration of the mark 'SUPER & DEVICE COFFEEMIX' they sought registration under Part A of the Register and were willing to disclaim the use of the words 'SUPER' and 'COFFEE' separately. The Registrar refused registration in Part A on the ground that the mark had a direct and close reference to the character and quality of the goods. Instead, the plaintiffs were asked to consider registration under Part B and to furnish the evidence as to use. That was done. On 5 February 1993, the Registrar accordingly accepted registration under Part B, with a disclaimer in respect of the word 'SUPER'.

We agree that while the word 'COFFEEMIX' may be descriptive, it could no less be used as a trade mark. Part B of the Register is intended to cater for such descriptive marks. Looking at the packaging of the plaintiffs' product, this is the single most prominent word on it. It is obvious that the plaintiffs intended the word 'COFFEEMIX' to be also a trade mark jointly with 'SUPER', consistent with the registration of the complete mark to be 'SUPER & DEVICE COFFEEMIX'. A word mark can consist of one word or multiple words. Here it is a two-word mark 'SUPER' and 'COFFEEMIX'.

The crucial question for determination is whether the word 'Coffeemix', as used by the defendants on their product, is in the trade mark sense. It is only if the defendants have used the term 'Coffeemix' on their product in the trade mark sense that there would be infringement. While the trial judge recognised that the complete trade mark of the defendants is 'INDOCAFE Coffeemix', he seemed to have accepted the defendants' contention that the word 'Coffeemix' in itself on the product could not be a trade mark. In coming to the view that the single word 'Coffeemix' is not used by the defendants as a trade mark, the trial judge would appear to have placed considerable emphasis on the fact that the word is descriptive and that the plaintiffs themselves had used the word 'Coffeemix' to describe the product in their promotional literature and advertisements. He also seemed to place much importance on the fact that the word 'Coffeemix' was followed by the words '3-in-1' indicating that the product comprised coffee, sugar and creamer.

With respect, we find the logic of the argument, that while the whole trade mark of the defendants' product is 'INDOCAFE Coffeemix' the word 'Coffeemix' is nevertheless not used as a mark, difficult to follow. The word 'Coffeemix' is used as a part of the trade mark 'INDOCAFE Coffeemix'. We do not see how it can be argued that the word 'Coffeemix' viewed separately on the defendants'

product is not being used as a mark.

We would further add that as far as the defendants are concerned, there is clear evidence that they have always intended to use `INDOCAFE Coffeemix` as the trade mark for their product. First, immediately after the plaintiffs` solicitors demanded that the defendants refrained from continuing with the infringement of their trade mark, the second defendants proceeded in Indonesia to apply for registration of `INDOCAFE Coffeemix` as a trade mark there. The second defendants even attempted to register `INDOCAFE Coffeemix` as a trade mark in Part A of the Register here without disclaiming `Coffeemix` initially. Secondly, the defendants` witness (PW2: Hadi Sofian Minaria, the Vice-President of the second defendants) admitted in his evidence in court that the defendants are using the words `INDOCAFE Coffeemix` in the trade mark sense.

In our opinion, whether a word which is essentially descriptive, when used on a product, is used in the descriptive sense or in the trade mark sense would depend very much on the way it is presented on the product. We think the intention of the manufacturer is an important factor, though that is not necessarily decisive. Here, having regard to the fact that on the defendants` product the word `Coffeemix` is presented most prominently, bigger in dimension than any other words on the package, and the admission by the defendants that they intended the style `INDOCAFE Coffeemix` to be used in the trade mark sense, we have to disagree with the learned trial judge that `Coffeemix` is not used by the defendants in the trade mark sense. We find that the word `Coffeemix` is used by the defendants in the trade mark sense.

The trial judge in coming to his decision that the word `Coffeemix` is not used in the trade mark sense relied upon two Australian decisions. First is **Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceutical Pty Ltd** 101 ALR 700; (1991) 21 IPR 1, where the respondent`s trademark was `Panadeine Caplets` and `Panadol Caplets` and they contended that the appellants had infringed their trademark by the use of the word `Caplets` on their packaging for Tylenol products. The Federal Court of Australia found that the appellants had used the word `Caplets` in the descriptive sense in respect of the shape and dosage and not as indicative of origin or identity and thus had not used the term as a trademark.

The second case is **Pepsico Australia (t/a Frito-Lay Australia) Pty Ltd v Kettle Chip Co Pty Ltd** [1996] 33 IPR 161, where the word in issue was the descriptive word `Kettle`. It was not disputed that the trademark `KETTLE` had acquired a secondary meaning indicative of the origin of the goods of the respondents. However, the Federal Court of Australia found the phrase `Double Crunch Kettle Cooked Potato Chips` used by the appellants on the front and back of their packaging merely described the process by which the `Thins` potato chips of the appellants were produced. It held that the appellants had not used the word `Kettle` as a trademark indicating the origin of the appellants` chips.

It must, however, be borne in mind that in both these cases, the relevant words `Caplets` and `Kettle` were not presented in the same manner as the word `Coffeemix` is on the defendants` packaging.

The UK trade mark case involving an identical name, **COFFEEMIX TM** [1998] RPC 717, where Simon Thorley QC sitting as the Appointed Person dismissed an appeal against the Registrar`s refusal to register `COFFEEMIX` for coffee preparations, coffee based beverages, etc was relied upon by the trial judge as indicating that `Coffeemix` could not have been used by the defendants as a mark. It is important to note that in this UK case, there was no evidence of any prior use. It did not relate to any question of infringement. It merely decided that `Coffeemix` is descriptive. That cannot be disputed. We would agree with the plaintiffs` counsel that the absence of prior use distinguished the

UK **Coffeemix TM** case from our present case where the Registrar of Trade Marks, having been satisfied as to prior use, registered the plaintiffs' mark. In any event, in our opinion, this UK case cannot help answer the question whether the defendants have used the word 'Coffeemix' in the trade mark sense in relation to their product.

Is there an infringement of plaintiffs' mark?

As we have found that the defendants have used the word 'Coffeemix' in the trade mark sense, the next question to consider is whether by using 'INDOCAFE Coffeemix' the defendants have infringed the plaintiffs' mark 'SUPER & DEVICE COFFEEMIX.'

A mark is infringed even though the whole of it is not adopted by another trader, so long as an essential feature of the mark is so used by that trader. In determining whether there is infringement, one must look at the whole mark, both its distinguishing as well as its essential features. Here we would quote from **Kerly's Law of Trade Marks and Trade Names** (12th Ed) (hereinafter referred to as '**Kerly's**'), where the learned authors summarised the position as follows (para 14-21):

A mark is infringed by another trader if, even without using the whole of it, he uses one or more of its essential features. The identification of an essential feature depends partly on the court's own judgment and partly on the burden of the evidence that is placed before it. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude a consideration of the sound of words forming part or the whole of the mark. Thus, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark, or part of the mark, of another trader. [Emphasis added.]

What is the essential feature of a mark is for the court to decide: **De Cordova & Ors v Vick Chemical Co [1951] 68 RPC 103** at 105.

The fact that the defendants have inserted their own name to the word mark of the plaintiffs' does not necessarily mean that the defendants have not infringed the mark of the plaintiffs. The ultimate question is how significant that insertion is to the whole mark and whether it has sufficiently distinguished the defendants' mark from that of the plaintiffs'. A case which illustrated this is **Associated Rediffusion v Scottish Television [1957] RPC 409** where the plaintiffs registered their mark 'TV Times' in Part B. The defendants proposed to call their publication 'Scottish T/V Times' or 'Scottish Television Times'. The plaintiffs moved for the grant of an injunction to restrain the defendants from doing so. The court held that the juxtaposition of 'TV' and 'Times' was the essential feature of the plaintiffs' mark and the defendants had copied that essential feature. The fact that the defendants had added the word 'Scottish' did not detract from this infringement.

Looking at the mark of the plaintiffs, it seems to us that the word 'COFFEEMIX' is an essential feature of the registered mark and the defendants have, by using the identical word as a part of their mark, infringed the mark of the plaintiffs.

Relief under s 46(2)

We now turn to consider the question whether relief should be granted to the defendants under s 46(2) of the Act. That subsection provides that no injunction or other relief shall be granted to the

plaintiffs if -

the defendant establishes to the satisfaction of the court that the use of which the plaintiff complained is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as registered owner to use the trade mark.

The burden clearly falls on the defendants to show that his case comes within that subsection.

The trial judge was satisfied that though both the plaintiffs' and the defendants' marks have a common word 'Coffeemix', he did not think, even assuming that the defendants did use the word 'Coffeemix' as a mark, that it was likely to cause confusion. This was how he viewed the two marks:

... the plaintiffs' mark is 'SUPER COFFEEMIX' all in capital letters; the defendants' mark is 'INDOCAFE Coffeemix'. Judging 'both by their look and by their sound' they look different and sound different. The differences become apparent when one looks at the respective packagings. The defendants' packaging has a brown background with the words 'FROM THE HOUSE OF INDOCAFE' on the front and back. In the plaintiffs' packaging, it is 'SUPER' that is emphasized on the front and back.'

How a court should compare two marks to determine whether they are likely to cause confusion is put as follows by the learned authors of **Kerly's** at para 17-07:

In comparing the marks, the Registrar or the court, ... must, as appears from the authorities referred to below, take into account all the circumstances of the case and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's.

*The test in relation to the reasonable probability of deception under the predecessor to s 12(1) of the 1938 Act was summed up by Parker J in a case involving the comparison of two words, as follows: [**Pianotist** [1906] 23 RPC 774 at 777]: 'You must take the two words. You must judge 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.*

In all cases as stated above, it should be borne in mind that a decision on the question whether a mark so nearly resembles another as to be likely to deceive or cause confusion is not an exercise of discretion by a tribunal but a finding of fact.'

The authorities also indicate that where two marks have common elements, the court would pay more regard to the parts that are not common. This was highlighted by Lord Russell in **Coca Cola Co (Canada) v Pepsi-Cola Co (Canada)** [1942] 59 RPC 127 as follows:

Where you get a common denominator you must in looking at the competing formulae pay much more regard to the parts of the formulae which are not common although it does not flow from that that you must treat the words as though the common part was not there at all.

This same comment was echoed by Evershed MR in **Broadhead`s Application** [1950] 67 RPC 209 at 215.

A similar sentiment was also expressed in the earlier case, **Harrods` Application** [1935] 52 RPC 65:

It is a well-recognised principle that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the markets in which the marks under consideration are being or will be used.

There is really no one decisive test to determine similarity or deception. Neither do the decided cases provide any useful criteria on the amount of resemblance before it may be held sufficient to deceive or cause confusion. We think that is to be expected. It depends on the facts of each case. In **Seixo v Prozende** [1866] LR 1 Ch 192 Lord Cranworth recognised that when he said `What degree of resemblance is necessary ... is from the nature of things incapable of definition *a priori* .` The standard also depends on the nature of the product. **Harker Stagg`s TM** [1953] 70 RPC 205, would appear to indicate that where pharmaceutical products were involved, the court would be more inclined to protect the public from the consequences of deception and confusion.

Reverting to the present matter, the question is whether, looking at the defendants` product packaging as a whole, is it likely to be confused with that of the plaintiffs` product. On the packaging of both parties, it is obvious that the most prominent word is `COFFEEMIX` though it is presented in an even more striking manner on the plaintiffs` packaging than the defendants`. To recap: on the plaintiffs` it is set out in bold capital letters in yellow; the other word `SUPER` pales in comparison. In the case of the defendants`, although the word `Coffeemix` is not in bold capital it is clearly the main word on the packaging while the other word `INDOCAFE`, which is in smaller font than `Coffeemix`, is in bold capital and is much more conspicuous than the way `SUPER` is presented on the plaintiffs` packaging. Above the word `INDOCAFE` are the words `FROM THE HOUSE OF` presented in the form of an arch; although these words are in even smaller font than `INDOCAFE`, they are visibly clear.

Emphasis is also placed by the plaintiffs on the other words that appear on the defendants` packaging. The expression `3-in-1` appearing on the defendants` packaging is not unlike that of the plaintiffs`. But the other things that appear on the packaging are quite different. The plaintiffs` packaging depicts three cups of coffee on a saucer and the defendants`, one cup and a saucer. The designs and colours of the cups and saucers are also different. Generally, the entire colour schemes of the two packaging are quite different.

References are also made by the plaintiffs to the similarities between the designs of the sachets of

the plaintiffs' and the defendants' products. While there are similarities there are also very clear differences.

Taking an overall view, which we must, we would agree with the trial judge that the public is not likely to confuse the product of the defendants' with that of the plaintiffs'. The law expects the consumers to use ordinary care and intelligence: see **Morecambe & Heysham Corp v Mecca** [1966] **RPC 423**. In the case of an educated consumer he would be able, without difficulty, to differentiate one from the other. In the case of an illiterate consumer, or a Chinese educated consumer, as the plaintiffs contend their customers generally are, who goes by what he sees on the packaging, then as the graphic designs of the two packaging are quite distinct, it is doubtful that he is likely to be misled. We would further say that the fact that a consumer is Chinese educated does not mean that he does not possess the usual faculties to differentiate. In any case, as the finding whether a mark is likely to deceive or cause confusion is a question of fact, and as the trial judge had held that it is not likely to confuse, in the circumstances of the present case there is hardly any sufficient basis for us to disagree with him.

We would make one other observation. While the parties intended the word 'COFFEEMIX' (whether fully in capital letters or otherwise) to have the character of a trade mark, and have presented it as such, we do not think the consumers have viewed it as such. The consuming public have really treated it as a product name, not unlike 'Corn-Flakes' 'Ice-Cream' or 'Condensed Milk'. We are fortified in this view by the results of the surveys commissioned by the parties.

First is the survey carried out by Frank Small & Associates in October 1993 at the request of the plaintiffs. One of the objects was to study the usage of '3-in-1 Coffee Mixes'. Five hundred housewives were selected for the exercise. The survey showed that consumers were aware of the different brands of coffee mix in the market though the 'Super' brand would appear to be more well known and more well used than the other brands - one in four housewives preferred Super 3-in-1 coffee mix than the other brands. Maxwell House even referred to their 3-in-1 product as 'CoffeeMix' in one word. This survey is interesting because in the plaintiffs' mind they recognised that even in October 1993 there were many brands of coffee mix and the aim of the survey was to determine how well known/well used was the Super brand of coffee mix.

In July 1998, about two months before the institution of this action, a survey was carried out by Taylor Nelson Sofros (TNS), again commissioned by the plaintiffs. This showed that out of 500 persons polled, only 1% of the respondents who replied were aware of 'COFFEEMIX' as a brand on first mention and 4% were aware of it as a brand. Only 75 persons (out of 500) believed that there was some connection between 'coffeemix' of other brands and 'SUPER COFFEEMIX'. Nine of the 75 thought so on the basis that the products belonged to the same company or manufacturer and only three thought that the products were from the same brand.

A third survey, the AMI survey, commissioned by the defendants in January 1999, shows that out of 300 persons polled:

- (a) 74% of the respondents perceived the word 'Coffeemix' as a coffee product.
- (b) Only 3% of the respondents associated the word 'Coffeemix' with the brand SUPER.
- (c) 57% of the respondents did not think that Indocafe Coffeemix and Super Coffeemix originate from the same manufacturer and 35% did not commit an answer to the question.
- (d) Only 7% of the respondents thought that Indocafe Coffeemix and Super Coffeemix originate from

the same manufacturer. However, only a small minority of them attributed the confusion to the word `coffeemix`, and even so, these respondents were referring to `coffeemix` as a product.

It was clear that by 1993 there were many other brands of coffee mix. While most of the other brands had referred to their 3-in-1 product in two words (except for Maxwell House) and none so prominently as that shown on the plaintiffs' and the defendants' product, that could not detract from the fact that the market would have known that there were many brands of coffee mix. The plaintiffs said that they would not object if the defendants had used the word `Coffeemix` in two words. We are unable to see how that could really have made a difference. Whether `Coffeemix` appears as one or two words, both visually and audibly, they are to all intents and purposes the same. To us, it seems like a distinction without a difference. It is really a case of splitting hairs.

In this regard we would add that the plaintiffs have relied on three cases to argue that like in those three cases, there would be confusion in our present case. First is **Eno v Dunn & Co [1893] 10 RPC 261**, which was a passing off case and where the court granted an injunction to restrain the defendant from using the word `Fruit Salts` on their product `Dunn's Fruit Salts`. The plaintiffs' product was called `Eno Fruit Salts`. Kekewich J said:

It seems to me quite conceivable - and I am bound to bring my knowledge of mankind, sitting as a judge of fact in the position of a jurymen, into it - that persons walking into a chemist's shop, intending to buy Eno's Fruit Salt, and seeing these tablets on the counter, would say perhaps, 'that is a more pleasant form, I will try the tablets this time'; directly you get that into your mind - I confess I have desire to add that as my opinion, after the decision of the House of Lords and all was said by the different judges, it was the duty of Messrs Dunn to avoid the possibility occurring, and they must have been perfectly aware that they would be attacked if they tried to use anything that infringed on Mr Eno's right, if they tried to deceive the public ...

The second is **Perry v Truefitt [1862] 6 Beav 66**, again a passing off case, which was concerned with the `Medicated Mexican Balm`. There the plaintiffs' product was called `Perry Medicated Mexican Balm` and the defendants', `Truefitt's Medicated Mexican Balm`. The court held that `Medicated Mexican Balm` had become a trade mark and the defendants had no right to use that.

The third case is **Associated Rediffusion v Scottish Television [1957] RPC 409** which we have referred to above.

With regard to **Eno v Dunn and Perry v Truefitt** we would make these observations. First, those two cases related in a sense to medicinal product. Second, they are very old cases and the social and educational conditions of the population then in England would be quite different from what those conditions were in Singapore a hundred years later in 1993. Third, whether there would be confusion or deception would depend on the circumstances of each case, and in the light of the considerations referred to in [para] 43-51 above, we are satisfied that the defendants have made out a case under s 46(2). The third observation also applies equally to the case **Associated Rediffusion v Scottish Television**. We would further add that whereas in that case, the term `TV Times` was used by the plaintiffs solely, in our case here, by 1993, when `INDOCAFE Coffeemix` came into the market, the term `coffeemix` whether in one or two words had been used widely by other manufacturers of coffee mix.

Passing off

We now turn to the claim in passing off. To succeed in this claim, the plaintiffs here must prove that first, they have acquired goodwill in relation to the product under the `COFFEEMIX` mark alone; second, there is misrepresentation, and third, there is damage: see [Reckitt & Colman Products v Borden \[1990\] 1 All ER 873](#).

The trial judge held that the plaintiffs must prove that the word `COFFEEMIX` was distinctive of their goods, and none others at the relevant date, namely, July 1993 which was the date the defendants introduced their 3-in-1 `Coffeemix` into the market. The plaintiffs contend that the test applied by the trial judge was too high and thus erroneous.

From the sales and advertising figures tendered at the trial, it is clear that the plaintiffs had by July 1993 acquired goodwill in the mark `SUPER COFFEEMIX` in relation to the 3-in-1 instant coffee product. The critical question that remains is whether the plaintiffs had by then also acquired goodwill in the mark `COFFEEMIX` by itself. On this, there is hardly sufficient evidence to show that the public had regarded `COFFEEMIX` alone as the mark which linked the product to the plaintiffs. The evidence on sales and advertising cannot assist the plaintiffs on this as they relate to the entire mark `SUPER COFFEEMIX` and not to `COFFEEMIX` alone. The plaintiffs never sold or promoted their product simply as `COFFEEMIX`. As mentioned before, the TNS survey showed that only 1% of the respondents who replied were aware of `COFFEEMIX` as a brand on the first mention and 4% were aware of it as a brand. The AMI survey also showed pretty much the same picture. Only 11% of the respondents perceived the word `Coffeemix` as a brand, and only 3% associated the word `Coffeemix` with the `SUPER` brand.

In the evidence of Gordon Stewart (PW3), the Managing Director of TNS, he gave the following answer to the specific question:

Q: The findings in para 15.1 and 15.2 do not show that the word `Coffeemix` denotes the plaintiff's product?

A: Correct.

There is another problem in the way of the plaintiffs' claim in passing off. The plaintiffs must show that that part of the mark alone `COFFEEMIX`, which is descriptive in nature, has become distinctive of the plaintiffs' product. Distinctiveness is a term of art in the law of passing off. **Wadlow on The Law of Passing Off** (2nd Ed) explains it in this way at para 6.02:

Matter such as a name, mark or get-up is said to be distinctive if it denotes the goods of the plaintiff to the exclusion of other traders. It is the significance which the relevant public attaches to the supposed mark which is all important. Matter which is not relied on by the public in this way is not in law distinctive, irrespective of how novel, striking or different it may be.

As mentioned before, the word `Coffeemix` is clearly descriptive. Unlike an inventive word it would be harder to acquire distinctiveness in relation to a descriptive word. The evidential burden placed on a plaintiff in such a case would be higher, but it would not be impossible to establish it: see the decisions of this court in [CDL Hotels International Ltd v Pontiac Marina \[1998\] 2 SLR 550](#) and [Lifestyle 1.99 Pte Ltd v S\\$1.99 Pte Ltd \[2000\] 2 SLR 766](#) at [para] 34-46.

PW3`s evidence on this is very telling (NE61-62):

Q: See your para 16.3, of the 36 people, 18 associated `Coffeemix` with plaintiffs` brand, this means that the other 18 associated `Coffeemix` with some other brands?

A: Yes.

Q: On this finding alone, it would show that the word `Coffeemix` does not refer to plaintiffs` goods only and none other?

A: Correct.

Furthermore, where a mark is descriptive, minor differences would be held to be sufficient to distinguish: see **Office Cleaning Services Ltd v Westminster Window and General Cleaners [1946] 63 RPC 39**. The plaintiffs` product is known as `SUPER COFFEEMIX` and the defendants`, `INDOCAFE Coffeemix`. This should suffice to differentiate. And if we examine the get up of the packaging of the two products, they are also different, both in terms of design and colour scheme. While it may well be that when a person purchases `INDOCAFE Coffeemix` he may not have in front of him a `SUPER COFFEEMIX` product to make an accurate comparison, we seriously doubt he would be confused. Furthermore, in the context of a population which is becoming more literate, there would not be any real difficulties to differentiate.

In this regard, there is a further point we wish to make. It relates to both the elements of misrepresentation and damage. From July 1993, when the defendants` product appeared on the market, up to the date of the trial, was a period of more than five and a half years. Yet there is no evidence that during that long period any consumer had been deceived, having bought `INDOCAFE Coffeemix` when he was thinking of `SUPER COFFEEMIX`. This shows that either the consumers were not bothered which particular brands of coffeemix they purchased or they were more discerning than the plaintiffs are prepared to accept.

In the premises, we agree with the learned trial judge that the plaintiffs failed to establish a claim in passing off.

Counterclaim on disclaimer

We now turn to CA 185/99. Here the defendants contend that the word `COFFEEMIX` in the plaintiffs` registered trademark should be disclaimed under s 39(1)(a) of the Act, read with s 16 or s 20. Initially, at the trial, the defendants also sought to have the entire trade mark expunged from the Register. Towards the close of the trial, they asked only for a disclaimer in respect of the word `COFFEEMIX`. We will now set out the relevant statutory provisions:

39	(1)	Subject to the provisions of this Act -	

	(a)	the court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongfully remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging or varying the entry as it thinks fit;	
16	(1)	Subject to this section, the registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of a word or words which the trade mark contains, or of which it consists, as the name or description of an article, substance or service.	
	(2)	Subsection (3) shall have effect where -	

		(a)	there is a well-known and established use of the word or words as the name or description of the article, substance or service by a person or persons carrying on a trade in that article, substance or service, not being used in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or, in the case of a certification trade mark, in relation to goods or services certified by the proprietor; or
			...
	(3)	Where the facts mentioned in subsection 2(a) or (b) are proved with respect to any word or words, then -	

		(a)	if the trade mark consists solely of that word or those words, the registration of the trade mark so far as regards registration in respect of the article or substance or of any goods of the same description, or of the services or of any services of the same description, as the case may require, shall be deemed for the purposes of section 39 to be an entry wrongly remaining on the register;

		(b)	if the trade mark contains that word or those words and other matter, the court or the Registrar, in deciding whether the trade mark shall remain on the register, ... may, in the case of a decision in favour of the trade mark remaining on the register, require as a condition that the registered proprietor shall disclaim any right to the exclusive use of that word or those words ...

20	If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade, or otherwise of a non-distinctive character, the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain upon the register, may require as a condition of its being upon the register that the proprietor shall disclaim any right to the exclusive use of any part or parts of the trade mark, or of all or any portion of such matter, to the exclusive use of which the Registrar or the court holds him not to be entitled, ...
	Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

The defendants assert that there is `a well known and established use` by the trade of the word `Coffeemix` as the name or description of the product consisting of coffee-sugar-cream, 3-in-1, within the meaning of s 16(2)(a) and that the word `Coffeemix` is also common to the trade and of a non-distinctive character within the meaning of s 20.

There are two main issues arising out of the counterclaim, namely:

(i) whether the trial judge was correct to hold that the defendants are not an aggrieved party within the meaning of s 39(1);

(ii) whether the word `Coffeemix` on the plaintiffs` registered trade mark should be disclaimed under s 16 and/or s 20.

Aggrieved party

Following from his finding that the defendants had not infringed the plaintiffs` mark, the trial judge, relying upon **Cheng Kang Pte Ltd v Sze Jishian** [1992] 2 SLR 214, dismissed the counterclaim on the technical ground that the defendants were not an `aggrieved` person within the meaning of s 39(1)(a) as the defendants were not someone whose `legal right are affected` by the mark being entered onto the Register.

We think, with respect, that the trial judge had taken too narrow a view of the term `aggrieved` parties. In **Appollinaris Co`s TM** [1891] 2 Ch 186[1891] 8 RPC 137, Fry LJ explained the scope of the equivalent English provision as follows:

In our opinion, when one trader uses the fact of registration as any part of his case against another trader in any legal proceedings, that second trader is aggrieved, and this is not the less so because the trader may have other means of defending himself. If the owner of the registered trade mark says to a defendant in a litigation, `I am the owner of this registered trade mark, and therefore you are doing me a wrong`, the person attacked ought to be at liberty to reply two things: first, `You ought not to be on the register,` and secondly, `Even if you ought, I have done you no wrong.` The completeness of the second line of defence ought not to preclude the attacked person from availing himself of the first.

That this statement of Fry LJ still represents the law can be seen from the fact that in **Kerly`s**, at para 11-07, it is stated that:

An alleged infringer of a mark is always a person aggrieved by its registration.

Even a trade rival would be an aggrieved person - per Fry LJ in **Apollinaris Cos TM** at [1891] 2 Ch 186, 229; (1891) 8 RPC 137, 160. This was reaffirmed by Lord Herschell in **Re Powell`s TM** [1894] 11 RPC 4 where he said at pp 7-8:

My Lords, I should be very unwilling unduly to limit the construction to be placed upon these words; because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the Register a mark which ought not to be there, and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation.

Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and whenever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicants, so that by reason of the existence of the mark upon the register, he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved.

In **Daiquiri Rum TM** [1969] RPC 600 at 615 Lord Pearce explained as follows the philosophy behind the Trade Marks Act and why the word `aggrieved` should be given a broad sense:

In my opinion, the words were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled. At common law a trader could ask the courts to protect him from the improper use of his mark by others who would pass off their goods as his. But to do this he had to establish by cogent evidence from the purchasing public and the trade that the mark had come to denote his goods and his alone. To avoid the paraphernalia of proof and

to help traders by enabling them to see more clearly where they stood in respect of particular marks the Trade Marks Acts were passed. It is, and was intended to be, a great advantage to a trader to have his mark registered under the Acts. That advantage to him is to some extent a corresponding disadvantage to his rivals. He was only intended to have it if the necessary qualifications are fulfilled. If they are not, the mark is not to be entered on the register. If it subsequently appears that it is wrongly on the register, it is to be removed. For to permit it to remain would give him, at the expense of his rivals, an advantage to which he is not entitled. Thus, the general intention and policy of the Act show, I think, that Parliament intended the words to have a wide meaning. If an erroneous entry gives to his rival a statutory trade advantage which he was not intended to have, any trader whose business is, or will probably be, affected thereby is 'aggrieved' and entitled to ask that the error should be corrected.'

It seems to us that the trial judge was mistaken in his appreciation of the decision in **Cheng Kang** where the learned judge there (Rubin JC, as he then was) in fact agreed, after reviewing the authorities, that a wide definition should be given to the term 'aggrieved' person. The trial judge's approach, that a defendant who succeeds in defending an action for trade mark infringement and/or passing off would not be an 'aggrieved' person because his legal rights would not have been affected, would run counter to the reasoning propounded by Fry LJ in **Appollinaris Co's TM**. We would add that counsel for the plaintiffs, in his written case, did not support the narrower view taken by the trial judge.

Is s 16(2) or 20 applicable?

The first question to consider is the scope of s 16, which is certainly not a straightforward provision. The English equivalent of the provision is s 15 of their Trade Marks Act, 1938. Fortunately, in **Daiquiri Rum TM [1969] RPC 600** the House of Lords had the occasion to consider their s 15. This was what Lord Reid said (at p 609-610):

Section 15 has been said to be obscure and ambiguous. I think that is much too harsh a criticism. Its structure may be unusual, and it does require some analysis to arrive at its meaning, but I think after careful study its meaning becomes reasonably clear. It refers to trade marks which consist of or include a word or words, and deals with the case where, after registration of such a trade mark, such word or words have come to be used as the name or description of 'an article or substance'. If the word or words have come to be so used by the public at large, that does not matter; but if they have come to be regularly so used by a person or persons carrying on a trade in that article or substance, then subsection 2 has to be applied.

It may be helpful to bear in mind the facts in **Daiquiri Rum**. There, the trade mark Daiquiri Rum was registered in 1922. Thereafter, the word 'Daiquiri' came to be regularly used in England by those selling cocktails as the name of a cocktail of which the main ingredient was light rum, which was more often BACARDI rum than rum sold under the trade mark. That having been proved, the House held that the registration was an entry wrongly remaining on the register and ordered its removal.

In relation to s 20, the defendants based their case on the fact that part of the trade mark, namely, 'Coffeemix', contains matter common to the trade or that it is of a non-distinctive character. The

defendants have equated `common to the trade` in s 20 with that of `well known and established use` in s 16(2)(a). There is clear evidence that the owners of `N-Rich` applied to register in Part B their mark in June 1987 in respect of, inter alia, `instant coffee mix`. This meant that the owners of `N-Rich` would have tendered evidence to show that they had used that mark to sell coffee mix for a period of two years before their application for registration.

As early as in February 1989, a media report stated that there were five brands of coffee mix on sale in Singapore under the heading `when coffee, sugar and milk come in one`. They were:

- (i) N-Rich Instant Coffee Mix;
- (ii) Owl 3-in-1 Instant Coffee Mix;
- (iii) Super Coffeemix 3-in-1 Instant Coffeemix;
- (iv) GoldRoast 3-in-1 Instant Coffee Mix;
- (v) Randall`s Coffee Mix.

Apparently, a year later, Nescafe and Maxwell House also introduced a coffee mix product. All these were there before the plaintiffs applied to register their mark. At some point in time Maxwell House even called their product `coffeemix` in one word.

Subsequent to the plaintiffs` application to register the mark, other manufacturers had also introduced such a 3-in-1 product. They included the following:

- (i) Mr Caf,`s 3-in-1 Instant Coffee Mix;
- (ii) Ye Ye 3-in-1 Instant Coffee Mix;
- (iii) Hosen 3-in-1 Coffee Mix;
- (iv) Goldkili 3-in-1 Instant Coffee Mix;
- (v) INDOCAFE Coffeemix 3-in-1 Coffeemix;
- (vi) Coffeeking 3-in-1 Coffeemix;
- (vii) Eagle King 3-in-1 Coffeemix;
- (viii) Boss Coffee 3-in-1 Coffeemix.

However, there is also evidence that by the time of the trial, some of the earlier brands, eg Randall`s, N-Rich and Maxwell House, had ceased production of the product.

Apart from the three surveys mentioned earlier, evidence on one other survey was also tendered to court. This was carried out in October 1992 on behalf of the owners of the `Owl` brand where out of nine brands of coffee mix identified, seven of them used the term `3-in-1 coffee mix`. The October 1993 survey by Frank Small & Associates listed eight brands of such products and they all used the expression `3-in-1 coffee mix`. The TNS and AMI surveys also depicted a similar picture.

What all these surveys show is that in 1993, as well as in 1998/99, the term `coffee mix` was used to indicate or describe a product consisting of coffee, sugar and creamer which upon mixing with hot water produced an instant coffee drink. In the light of the evidence, we are satisfied that the term `coffee mix` was and is common to the trade, and it is well known and established in the trade to indicate or describe the product. While we recognise that the plaintiffs have combined `coffee mix` into one word, we would reiterate that we are unable to see what difference there is whether the term `coffee mix` is presented in two words or one word. The audio impact is identical and the visual impact is hardly distinguishable.

The question that remains is, in the light of what has been established, whether this court ought under s 39(1)(a) read with s 16(2), or under s 20, order a disclaimer in respect of the word `coffeemix`. Furthermore, even if it is shown that s 16(2)(a) and/or s 20 are satisfied, does this court still have a discretion not to order such a disclaimer? It seems to us that by the use of the terms such as `may` and `as it thinks fit` in s 39(1)(a), the court has a discretion in the matter. In s 20, one also finds a similar discretionary expression `may require`. The court is, therefore, entitled to consider all the circumstances in coming to its decision.

The authorities would appear to indicate that whether the court should exercise its discretion to order the expunging of a registered mark, or that a word in the mark be disclaimed particularly when deception is shown, depends not so much on the conduct of the applicant but on a balancing of the interests of the public on the one hand and those of the registered mark owner on the other. The merits or demerits of the applicant are irrelevant in this regard: see **Hill`s TM [1893] 10 RPC 113**.

In the local case **Davidoff Extension SA v Davidoff Commercio e Industria Ltd [1987] SLR 462** the mark `Davidoff` was registered by the respondents. In truth, this name originated from the applicant, an established Swiss company, and that name, in association with the applicant, had gained an extensive reputation. The respondents applied for registration of the mark in September 1978 and the application was approved in October 1980. In the meantime, the applicant`s products were introduced into Singapore in 1979. The respondents` actual use of the mark in Singapore commenced only in September 1982. At the time of their application for registration, the respondents were aware of the prior claim to proprietorship of the mark by the applicants. They were not able to explain their choice of the `Davidoff` trade mark. FA Chua J ordered the mark be expunged from the Register. He said:

It is clear from the authorities that the court always has a discretion under s 39 to rectify or not in the light of all the circumstances of the case. The merits or demerits of the applicants are of little relevance, at least where a likelihood of confusion is established, as the question is not between the applicants on the one hand and the respondents on the other, but between the public and the respondent.

In Australia, the High Court in **Continental Liqueurs Pty Ltd v GF Heublein & Bro Inco [1960] 103 CLR 422** had the occasion to consider a provision in the Australian statute where it was provided that the court may, if there had been no bona fide user of a registered trade mark for three years, order its removal. It ruled that the primary consideration to the question of expunging was public interest rather than the unmeritorious conduct of the applicant and that such public interest would generally be better served by rectifying the register.

In relation to the present application, the fault that one can place at the door of the defendants is only in respect of their delay in applying to disclaim the word `coffeemix`. They could have done so in

1993 when they introduced their coffeemix brand in Singapore or in 1995 when the plaintiffs wrote to ask them to refrain from using the word `coffeemix` as one word. As the authorities indicate, the conduct of the applicant is not a relevant consideration. In *Continental Liqueurs* the delay on the part of the applicant in applying for the removal was raised as a ground for the court to take into account in exercise of its discretion whether to order a removal. The Australian High Court reaffirmed the views expressed in *Hill's TM* that the issue was really one between the respondent and the public and not only between the respondent and the applicant and ordered the removal none the less.

We would, therefore, order that the word `coffeemix` in the plaintiffs' mark be also disclaimed. While we recognise that this would mean that both the words in the plaintiffs' mark are disclaimed, this would not be unlike the position on those trade marks such as `Singapore Airlines` and `British Airways`. Neither does it mean that any other manufacturer/trader is at liberty to pass off their `coffee mix` product as that of the plaintiffs'. It will all depend on the get up of the packaging, which in turn will determine if there is misrepresentation.

Judgment

In the result, the appeal in CA 184/99 is dismissed. We would allow the appeal in CA 185/99 and order that the word `coffeemix` in the registered mark of the plaintiffs be disclaimed. On the question of costs, we would award the defendants only 75% of the costs of the appeal, as the defendants have failed on the point that the word `Coffeemix` is not used as a mark by them. The security for costs in CA 184/99 (with interest, if any) shall be paid out to the defendants or their solicitors to account of the latter's costs. As for CA 185/99, the defendants shall be entitled to the costs of the appeal as well as those for the hearing below. The security for costs in CA 185/99 (with interest, if any) shall be refunded to the defendants.

Outcome:

Appeal in CA 184/99 dismissed; appeal in CA 185/99 allowed.