

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark No. T1406403E
Hearing Date: 16 October 2019

**IN THE MATTER OF A TRADE MARK APPLICATION BY
FERRERO S.P.A.**

Hearing Officer: David Llewelyn
IP Adjudicator

Ms Cherlyn Seah (Drew & Napier) for the Applicant

GROUND OF DECISION

Introduction

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

- 2 The question to be answered in this case is whether the evidence submitted by the applicant is sufficient to justify trade mark registration for the shape and packaging itself, shorn of the distinctive trade mark under which the product has been sold and by which consumers and the trade choose and buy it. Put more bluntly, is one of the ‘rewards’ for extensive advertising, promotion and sale of a product bearing a distinctive word mark, that trade mark registration may be obtained for a mark comprised only of its shape and packaging? Or, in the words of Sundaresh Menon CJ in the first paragraph of his judgment on behalf of the Court of Appeal in *Société des Produits Nestlé v Petra Foods Ltd* [2017] 1 SLR 35 (“*Kit Kat*”):

When is a trader entitled to a perpetual monopoly of a shape that has been used in connection with his trade?

- 3 Registered trade marks are potentially valuable property rights for their proprietors. But if granted too freely they can also be obstacles to legitimate competition. In recognition of the need to maintain a proper balance, the Trade Marks Act (Cap 332, 2005 Rev Rd) (“**TMA**” or the “**Act**”) does not provide a system that permits the registration of all and any trade marks (and for all or any goods or services) that an applicant wishes to register: instead, it contains in Section 7 various absolute grounds for the refusal of an application to register a trade mark for the goods or services specified in the application. (Section 8 contains the relative grounds for refusal that involve a comparison of the mark applied for with earlier rights.)
- 4 A number of the absolute grounds for refusal in Section 7 relate to the failure of the applied-for mark to fulfil the essential function of a registered trade mark, which is to indicate the trade origin of the goods and/or services for which it is registered. Such a trade mark is not entitled to the advantages that registration offers over the more uncertain cause of action for passing off (that, rather than the trade mark itself, protects the goodwill that has been generated through use of a trade indicium, such as a word mark or the get-up of a product). It is in the public interest that the Register be kept free of trade marks that do not function as indicators of trade origin.
- 5 The ground of refusal at issue in this case is contained in Section 7(1)(b) TMA (set out at [24] below) which requires an evaluation as to whether, notwithstanding that it falls within the definition of a trade mark contained in Section 2(1) (see below at [7]), the application mark should be refused because it is clear on the face of the application that the mark lacks any distinctive character as an indication of trade origin for the goods or services applied (or, to put it in the words of the Court of Appeal in *Kit Kat* at [25], it lacks ‘inherent distinctiveness’).
- 6 However, an applicant for registration of a mark that is devoid of distinctive character under Section 7(1)(b), when considered in relation to the relevant goods or services without reference to evidence of its actual use in the marketplace, may rely on Section 7(2) TMA (set out at [25] below) if it can adduce evidence that such distinctiveness as an indication of trade origin has been *acquired* as a result of such actual use prior to the date of application.

What is a “trade mark” for the purposes of the TMA?

- 7 Section 2(1) TMA sets out a broad definition of a trade mark:

any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.
- 8 In addition, ‘sign’ is stated in Section 2(1) TMA to include ‘shape, colour, aspect of packaging’.

- 9 Any trade mark that does not fall foul of one of the grounds of refusal may be registered and the absolute grounds for refusal must be applied without regard to the nature of the trade mark being applied for, although it is common sense that the average consumer may well view certain types of trade marks falling within this broad definition differently to others.
- 10 Trade marks can take many different forms, with the most conventional being the word mark or the logo. On the other hand, trade marks comprised of shape, colour and/or aspects of packaging, and combinations thereof, are sometimes described colloquially as “non-conventional” and, as such, have been the subject of extensive case law in many jurisdictions that has explored the extent to which such signs function as indications of trade origin and are therefore entitled to be registered. In Singapore, the Court of Appeal in the *Kit Kat* case dealt with many of the issues in the context of a counterclaim for invalidity and/or revocation of Nestlé’s two-finger shape and four-finger shape registered trade marks. This application to register the Application Mark (as depicted in the following paragraph) raises those issues in the registration context.
- 11 Ferrero S.p.A. (the “**Applicant**”), applied to protect as a 3D (three-dimensional) mark:

(the “**Application Mark**”)

in Singapore on 23 December 2013 under International Registration No. 1199758 (Singapore Trade Mark No. T1406403E).

- 12 The Application Mark was sought to be registered in Class 30 in respect of “Pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices.”

Procedural History

- 13 On 2 September 2014, the examiner examining the application for registration of the Application Mark (the “**Subject Application**”) issued a provisional refusal of protection (“**Provisional Refusal**”) enclosing the statement of refusal with objection to the Application Mark under Section 7(1)(b) of the Act.
- (a) In brief, the examiner’s view under Section 7(1)(b) of the Act was that the Application Mark is devoid of any distinctive character. In this regard, her view was that the Application Mark is “*a three-dimensional shape mark without any other distinctive element that would have allowed the mark to point to a specific undertaking*” and that “*such a shape is common on chocolates and the average consumers are unlikely to view this three-dimensional shape alone as a badge of origin*”. The examiner then took the view that “*the mark does not have the inherent capacity to distinguish the trade origin of the goods claimed and will not be perceived by the general public as a badge of origin without extensive efforts to educate the public that it is one*”.

- (b) At the conclusion of the statement of refusal, the examiner invited the Applicant to file evidence of use in order to overcome the Section 7(1)(b) objections.
- 14 On 4 January 2016, the Applicant made submissions in response to the examiner's statement of refusal and filed evidence of use, in the form of a Statutory Declaration made by Daniele Lingua and Giordano Cardini on 7 December 2015 ("**SD1**"). Daniele Lingua and Giordano Cardini are proxy holders of the Applicant.
- 15 On 27 May 2016, the Applicant was informed that the earlier objections under Section 7(1)(b) of the Act were maintained. In essence, the examiner's view was that there was "*not enough evidence to show that the 3D shape mark acts as an indication of trade source*".
- 16 On 21 June 2017, the Applicant made submissions in response to the examiner's maintained objection on 27 May 2016 and filed evidence in support of its submissions. The evidence was filed in the form of a Statutory Declaration made by the same Daniele Lingua and Giordano Cardini on 14 June 2017 ("**SSD1**").
- 17 On 19 December 2017, the Applicant was once again informed by the examiner that the earlier objections under Section 7(1)(b) of the Act were maintained. The examiner's view was that "*in the absence of other evidence showing use of the subject mark per se as a trade mark, the statutory declaration and supplementary statutory declaration submitted are not sufficient to prove that the mark has acquired distinctiveness as a result of its use in Singapore*".
- 18 On 18 July 2018, the Applicant made a third round of submissions in response to the examiner's decision on 19 December 2017.
- 19 On 1 February 2019, the Applicant was informed by the examiner that the objection under Section 7(1)(b) was maintained.
- 20 Since the examiner's response on 1 February 2019 was a final refusal, the Applicant had to request an *ex parte* hearing if it wanted to pursue its application for protection in Singapore.
- 21 On 30 August 2019, the Applicant requested an *ex parte* hearing. On 30 September 2019, a further Supplementary Statutory Declaration ("**SSD2**") was made by the same Daniele Lingua and Giordano Cardini referred to in [14] and [16] above.
- 22 In its Notice fixing the date of the *ex parte* hearing, IPOS *inter alia* directed the Applicant to "[i]ndicate its stand in relation to the decision in *In the matter of a trade mark application by Societe des Produits Nestle SA* [2011] SGIPOS 6", concerning an application to register the shape of a bottle. The Applicant did so in a written document ("**Stand on Nestlé bottle case**") served with the rest of its evidence and Written Submissions on 2 October 2019.
- 23 The *ex parte* hearing was held on 16 October 2019. I delivered my decision on 27 November 2019 and the Applicant applied for these full grounds of decision on 10 December 2019.

MAIN DECISION

Relevant Provisions

24 Section 7(1)(b) of the Act provides as follows:

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

- (a) ...
- (b) trade marks which are devoid of any distinctive character;
- (c) ...

25 Section 7(2) of the Act provides as follows:

A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) 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.

The Law

Section 7(1)(b) TMA

26 When considering whether a mark being applied for is devoid of distinctive character as an indication of trade origin under Section 7(1)(b), the assessment must be made without “**any consideration of its use, promotion or marketing by the [Applicant] of the trade mark**” (emphasis in the original), *per* Chan Seng Onn J in *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 562; [2008] SGHC 158, at [53]. Likewise, as stated by George Wei JC (as he then was) in *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825, at [78]:

When the law addresses the question posed by Section 7(1)(b) of the TMA ... the question is not to be answered in the abstract. The definition of trade mark relates to the use of the sign in the course of trade on goods or services in circumstances where the sign has a capability of distinguishing the goods or services. The goods or services are those in respect of which the applicant is seeking registration. The question to be answered is whether the trade mark is devoid of any distinctive character in terms of its ability to distinguish those goods or services in the course of trade.

In other words, the Application Mark must be examined on its face, free of any context except knowledge of the goods or services in respect of which registration is sought. For these purposes, any actual use and, as a result of such use, recognition of the Application Mark must be ignored (although obviously it is relevant where the Applicant relies on Section 7(2) in the event the mark is found to fall within the Section 7(1)(b) ground for refusal).

27 The Court of Appeal in *Kit Kat* put the issue pithily, at [33]: under Section 7(1)(b) “the critical question to ask is whether the average consumer would appreciate the trade mark significance of the mark in question without being educated that it is being used for that purpose”.

- 28 Thus, before the “devoid of distinctive character” ground for refusal under Section 7(1)(b) TMA can be considered, the antecedent question is, who is the average consumer or, in the words of Chan J, the “average discerning consumer” of the relevant goods or services? It is for and through this hypothetical person that distinctiveness must be assessed. In this case, such a person is the reasonably well-informed, observant and circumspect man or woman in Singapore who buys confectionery for him/herself or others on a not infrequent basis. The goods in respect of which registration of the Application Mark is sought are not of such a specialist nature or high cost that one can expect a degree of attention to what is being purchased greater than that given by a consumer purchasing fast-moving consumer goods in a supermarket or corner store.
- 29 However, as the Court of Appeal observed in *Kit Kat*, at [24]: “the average consumer is not in the habit of making assumptions about the origin of products on the basis of their shape in the absence of any graphic or word element” (referring to the EU General Court’s decision in *Henkel KGaA v OHIM* [2005] ETMR 44 at [38] and the US Supreme Court in *Wal-Mart Stores Inc v Samara Bros Inc* (2000) 529 US 205). Thus, although the ground for refusal contained in Section 7(1)(b) should be applied consistently across all categories of marks, “it may, in practice, be more difficult to establish the distinctive character of shape marks, especially when they take the shape of the product itself.” (*Kit Kat*, at [24], having cited with approval, at [22], the summary of the principles governing distinctiveness set out in the 15th ed. of *Kerly’s Law of Trade Marks and Trade Names* (“*Kerly’s*”) at para. 8-016; now contained in para.10-072 of the 16th edition).

Section 7(2) TMA

- 30 Nevertheless, even if it is decided that an application mark has no *inherent* distinctiveness and therefore falls foul of Section 7(1)(b), Section 7(2) provides that it may not be refused if as a matter of fact it has *acquired* distinctive character as a result of the use made of it. Such an assessment involves a critical evaluation of the evidence of use that has been adduced in support, bearing in mind the important distinction that applies particularly to non-conventional trade marks: whether the mark has crossed the boundary between marks that are *associated* with a particular undertaking purely by virtue of extensive use and those perceived by the average consumer as an indication of trade origin.
- 31 The importance of this boundary was explained by Kitchin LJ (as he then was) in *Société des Produits Nestlé SA v Cadbury UK Ltd* [2017] EWCA Civ 358 (“*Nestlé v Cadbury*”) at [77]. This was an appeal concerning the registrability as a trade mark under the UK’s Trade Marks Act 1994 of the shape of the ‘Kit Kat’ chocolate-enrobed wafer product.

[T]o a non-trade mark lawyer, the distinction between, on the one hand, such recognition and association [of the mark with the applicant’s goods] and, on the other hand, a perception that the goods designated by the mark originate from a particular undertaking may be a rather elusive one. Nevertheless, there is a distinction between the two and, as I shall explain in a moment, it is an important one.

78. The distinction is this. We are concerned with a mark, the three-dimensional shape of a chocolate product, that has no inherent distinctiveness. A shape of this kind is not inherently such that members of the public are likely to take it as a badge of origin in the way they would a newly coined word or a fancy name. Now assume that products in that shape have been sold on a very large scale under and by reference to a brand

name which is highly distinctive. Assume too that the shape has in that way become very well-known. That does not necessarily mean that the public have come to perceive the shape as a badge of origin such that they would rely upon it alone to identify the products as coming from a particular source. They might simply regard the shape as a characteristic of products of that kind or they might find it brings to mind the product and brand name with which they have become familiar. *These kinds of recognition and association do not amount to distinctiveness for trade mark purposes*". [Emphasis added].

- 32 Thus, the distinctive character that must be present, either inherently or through use, is not just any distinctiveness, such as might result from an "unusual, new or visually distinctive" shape (as affirmed by the Court of Appeal in *Kit Kat* at [33]). For trade mark registration purposes, it is only sufficient where distinctive character *as an indication of origin* is conveyed by the appearance of the mark in itself.
- 33 The burden of proof under Section 7(2) TMA lies on the Applicant. What must be proved was summarised by Kitchin LJ (as he then was) in *Nestlé v Cadbury* at [52]¹:

The applicant must prove that, as a result of the use he has made of the mark, a significant proportion of the relevant class of persons perceive the goods designated by that mark, as opposed to any other mark that might be present, as originating from a particular undertaking.

- 34 It is also pertinent to bear in mind the warnings given by Jacob J (as he then was) in *Unilever plc's Trade Mark Application* [2003] RPC 35 ("*Viennetta*"), referred to by the Court of Appeal in *Kit Kat* at [38], and by Andrew Phang Boon Leong J (as he then was) in *Nation Fitting (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 ("*Nation Fitting*"). In the first, which concerned an application to register two shapes of the well-known VIENNETTA ice-cream products, the danger of accepting mere recognition as sufficient for registration was highlighted, at [32]:

There is a bit of sleight of hand going on here and in other cases of this sort. The trick works like this. The manufacturer sells and advertises his product widely and under a well-known trade mark. After some while the product appearance becomes well-known. He then says the appearance alone will serve as a trade mark, even though he himself has never relied on the appearance alone to designate origin and would not dare to do so. He then gets registration of the shape alone. Now he is in a position to stop other parties, using their own word trade marks, from selling the product, even though no-one is deceived or misled.

In the latter, which involved an application to register a 3D shape of pipe fittings, the learned judge cautioned, at [45], that

[W]hilst the court should recognise and give effect to the rights of registered trade mark holders wherever appropriate, it should also bear in mind the fact that such rights should not be permitted to either blatantly or subtly develop into disguised monopolies which stifle or stymie the general public interest and welfare.

¹ This summary was in relation to the proviso to Section 3(1) of the Trade Marks Act 1994 (UK), which is to the same effect as Section 7(2) TMA.

- 35 Before proceeding to consider the application of Section 7(1)(b) and Section 7(2) to the facts in this case, I should mention two aspects of the Application Mark that were not raised by the examiner but which I have found troubling. I set out my views on these two aspects for the sake of completeness and in the hope that they may be of some value either if this case goes further or when considering future applications to register signs similar in nature to the Application Mark.
- 36 The first is that I am by no means convinced that the Application Mark is even a ‘trade mark’ as defined in Section 2(1), although obviously it is comprised of features mentioned specifically in the non-exhaustive list of what may constitute a ‘sign’. Those features were described by the Applicant in its Written Submissions (at [11]) as a “coordinated packaging design, consisting of a crinkled gold foil spherical wrapping, in a brown pleated designed cup-holder with two gold lines. The combination is topped off with a white oval sticker, also designed with a gold rim with a black [sic: blank] white space.” In this blank space, the registered trade mark FERRERO ROCHER is printed when the Application Mark is used in the real world.
- 37 Even when the features identified by the Applicant are combined to comprise the Application Mark and are viewed as a whole, it is not clear to me that such a sign is capable of distinguishing goods or services dealt with or provided in the course of trade by one person from goods or services so dealt with or provided by others, which is the basic requirement to be a trade mark within the definition set out in Section 2(1). Signs that do not satisfy that definition must be refused under Section 7(1)(a) even before one moves on to consider if there are any other relevant grounds for refusal if it be determined that it is in fact a trade mark. That having been said, the examiner did not take this point, relying instead on the ‘devoid of distinctive character’ ground of refusal, and therefore it was neither dealt with in the Applicant’s Written Submissions nor raised by me with the Applicant’s counsel at the *ex parte* hearing.
- 38 The second aspect arises from the written description of the Application Mark provided by the Applicant in a letter of 10 September 2019 from Messrs Drew & Napier² responding to the examiner’s request for this to be addressed before a date for the *ex parte* hearing could be arranged.³ This written description was first requested by the examiner as long ago as 2 September 2014 when giving the Provisional Refusal referred to at [13] above and explaining there that such description “will be entered as an endorsement of the protection and serves to define the scope of protection”.⁴
- 39 The written description submitted in the letter of 10 September 2019 was: “The mark comprises of the 3-dimensional ball shape chocolate wrapped in a golden foil, with a white sticker on top of the chocolate and resting in a brown and gold striped paper cup as shown in the representation of the application”. This description no longer makes any reference to the “gold rim” of the white oval sticker that was referred to by Drew & Napier in its 18 July 2018 letter at [6].⁵

² Bundle 1 at R5.

³ Bundle 1 at OA5.

⁴ Bundle 1 at OA1, in [3] of the Statement of Refusal.

⁵ Bundle 1, R3.

- 40 This raises a number of problems, not least of which are (a) its inconsistency with the description given in the Applicant’s Written Submissions at [11]⁶ and elsewhere⁷, which gives rise to a legitimate concern that the description is altogether too vague and uncertain (for example, the adjective ‘crinkled’ is used in the Written Submissions but not in the written description provided in the letter of 10 September 2019)⁸, and (b) the fact that it seems to suggest that the mark comprises a “ball-shape chocolate [in the specified wrapping and packaging]”. At no other place in the Applicant’s submissions or evidence is it contended that the Application Mark is limited to a “ball-shape chocolate” (see further at [48] below). Yet, if it is indeed the Applicant’s intention to use the Application Mark only for chocolates, this is at odds with the specification of goods for which registration is sought (and therefore in respect of which the Applicant has attested it has a bona fide intention to use the Application Mark), which is much broader: “Pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices”. I do not see how this attestation can be reconciled with the written description the Applicant submitted in the 10 September 2019 letter.
- 41 As the examiner did not raise these issues with the Applicant and therefore I did not do so at the *ex parte* hearing, they have played no role in my decision on the applicability of Section 7(1)(b) and Section 7(2) to the Application Mark, which I now proceed to consider.

Application of Section 7(1)(b) and Section 7(2) to the Facts

Section 7(1)(b)

- 42 The Applicant contends in its Written Submissions⁹ that the Application Mark, which is applied for as a 3D mark, “as a whole, is a coordinated packaging design, consisting of a crinkled gold foil spherical wrapping, in a brown pleated designed cup-holder with two gold lines. The combination is topped off with a white oval sticker, also designed with a gold rim with a black [sic: blank] white space”. As such, it does not seem correct to evaluate it purely as a 3D shape mark: instead, it is better characterised as a composite mark comprised of a design that is a combination of 3D shapes, aspects of packaging and colours (all as depicted in the photograph taken from a particular perspective that is the Application Mark and described in writing as quoted earlier in this paragraph).
- 43 By contrast, in her statement of refusal referred to at [13] above, the Assistant Registrar stated that “such a shape is common on chocolates”. However, it is not clear what shape she was referring to: if she meant a spherical shape, that may well be the case but the Application Mark is not limited to a spherical shape but comprises three different shape elements: the shape of the wrapping, the shape of the cup in which the product rests and the shape of the oval sticker on the top of the wrapping, all as shown in the photograph. In addition, the Application Mark includes the use of three separate colours: gold, brown and

⁶ For example, compare the description at [11] of the Written Submissions “a brown pleated designed cup-holder with two gold lines” with the 10 September letter’s rendition “resting in a brown and gold striped paper cup” and the description at FN 7 below.

⁷ For example, in the letter of 4 January 2016 from Messrs Drew & Napier to IPOS (Bundle 1 at R1) it is stated “We highlight that the subject mark depicts a confectionery item wrapped in golden foil placed in a brown paper cup with wavy gold patterns”, at [12].

⁸ It should be noted also that ‘crinkled’ is not a description that is either clear or precise: eg, how crinkled? Where crinkled? It is evident from much of the advertising and promotion that forms the Exhibits E and F to SD1 that the extent and positioning of ‘crinkling’ differs from advert to advert and promotion to promotion.

⁹ Written Submissions, at [11].

white, together with the crinkled feature of the gold foil and pleated nature of the paper cup.

- 44 Looked at as a whole, the Application Mark is an unusual (probably unique) combination of, first, a spherical and crinkled gold foil wrapping, secondly, a brown paper cup that has two gold lines around it and in which the gold foil-wrapped product sits, and, thirdly, a white oval sticker. However, notwithstanding its unusual nature, it seems to me beyond doubt that, without any knowledge of the Applicant's FERRERO ROCHER chocolate product, the average consumer would view the Application Mark as a somewhat unusual, somewhat attractive (as are many gold-coloured products) but largely functional packaging if it were to be used for all or any of the goods in respect of which registration is sought: "pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices".
- 45 As such the Application Mark falls clearly within that category of marks referred to by Andrew Phang Boon Leong J (as he then was) in *Nation Fitting* at [30], whose unusual shape, or in this case unusual combination of features, does not afford a sufficient basis for finding that the mark is a trade mark worthy of registration without any evidence of use to show that it has acquired distinctiveness. The Application Mark therefore should be refused registration under Section 7(1)(b) as being devoid of distinctive character unless the evidence of use shows that it has acquired distinctiveness. I therefore move on to consider the evidence submitted by the Applicant to support its contention that the Application Mark has acquired distinctiveness "through long use and promotion".¹⁰

Section 7(2)

- 46 The Applicant sets out in SD1¹¹ the sales turnover of "ROCHER Chocolate Products" in Singapore between the years 1982/1983 and 2014/2015: these grew remarkably from USD 1,000 in 1982/3 to USD 25,126,000 in 2014/15. A relatively small sample selection of invoices for products supplied to business purchasers in Singapore during this period forms Exhibit C to SD1. In addition to ROCHER chocolate products, these invoices include charges for the purchase of other Ferrero products from the Applicant, such as TIC TAC mints, ROND NOIR chocolates, KINDER CHOCOLATE, KINDER BUENO, KINDER JOY and TRONKY chocolate products and NUTELLA spreads. Notwithstanding this, what is clear from this evidence is that there have been very extensive sales to and in Singapore of FERRERO ROCHER chocolate products, although such evidence also shows that the overwhelming majority of such sales were in boxes¹² that featured prominently the word mark "FERRERO ROCHER" on the outside as well as on each of the individually-wrapped pralines.
- 47 In addition, FERRERO ROCHER chocolate products have been advertised and promoted extensively in Singapore. The Applicant's proxies aver in SD1¹³ that the annual advertising expenditure for the ROCHER chocolates between 1999 and 2014 was at least USD 357,000 (in 2003/4) and at most USD 949,000 (in 2008/9). A small selection of promotional Point of Sale ("POS") materials and advertisements for the FERRERO ROCHER products used in Singapore in both mainstream media and in retail outlets such as Giant and NTUC

¹⁰ Written Submissions at [13].

¹¹ SD1 at [10.i].

¹² For example, SD1, Exhibit E, at pp103, 119 – 121, 136, 145 – 147, 151, 157, 160.

¹³ SD1 at [15].

Fairprice forms Exhibit E. Certain of this material¹⁴ (see **Figure 1** below) shows what appear to be piles of gold foil wrapped balls but does not evidence use of the Application Mark as the various features are not discernable.

Ferrero Rocher Xmas National Activity



Ferrero Rocher CNY 09 National Activity



Figure 1

¹⁴ SD1, Exhibit E, at pp107-108,110-111, 113-114. Figure 1 shows pp113-114.

Other material¹⁵ (see **Figure 2** below) features a pyramid of gold spheres each with an oval sticker with writing on it that is sometimes illegible.



Figure 2

However, in all of the promotional/POS material where a product can be discerned, the brand FERRERO ROCHER is prominently featured. The only places where all the features of the Application Mark identified by the Applicant are seen together is where a mock-up of the FERRERO ROCHER product (that shows each of the crinkled foil, the brown pleated paper cup and the oval sticker) is included on the external packaging of a box bearing prominently the brand FERRERO ROCHER¹⁶: see **Figure 3** below.

¹⁵ SD1, Exhibit E, at pp116-118 (which appear to be Thai promotional materials), 123-127, 130-135. Figure 2 shows pp131-132.

¹⁶ For example, at pp146-147 of Exhibit E, SD1.



Figure 3

48 The evidence referred to in the previous paragraph that shows a varying number of gold spheres in pyramids of varying heights illustrates one of the serious concerns that applications to register trade marks such as the Application Mark give rise to. Viewing this evidence (for example, pp124-125 of Exhibit E, SD1: see **Figure 4** below), one could get the impression that the mark being applied for is a gold foil wrapped spherical shape,¹⁷ and certainly that is a shape and colour that would be recognized by those who purchase FERRERO ROCHER pralines.

¹⁷ The ‘balls’ in these promotional materials for Mother’s Day 2013 would appear to differ not insignificantly from both (a) the crinkled gold foil wrapping referred to in the Applicant’s Written Submissions at [11] and (b) the representation of the Application Mark, reproduced at [9] above.



Figure 4

However, notwithstanding this recognition, such a common shape and colour is clearly not distinctive on its own as an indication of trade origin for chocolates and the like, and therefore would be extremely difficult, if not impossible, to register as a trade mark.¹⁸ The Application Mark is however a composite mark in which there is added to that shape and colour: first, a brown pleated paper cup that serves the function of preventing the ball-shaped chocolates from rolling around in the box they are sold in and, second, an oval white sticker (on which the word mark FERRERO ROCHER is printed when the Application Mark is used in practice¹⁹). These additions achieve, in the words used in [11] of the Written Submissions, a “coordinated package design”. Despite this, it cannot be correct to permit registration for chocolate products of a mark whose main feature is a gold spherical ball shape merely because the Application Mark combines with that shape and colour these other features: a brown pleated paper cup with two gold stripes around it and a white oval sticker.²⁰ None of these features adds anything to the trade mark distinctiveness of the Application Mark as a whole because the average consumer would view them as merely functional or decorative elements. Such sleight of hand, that goes even further than that in

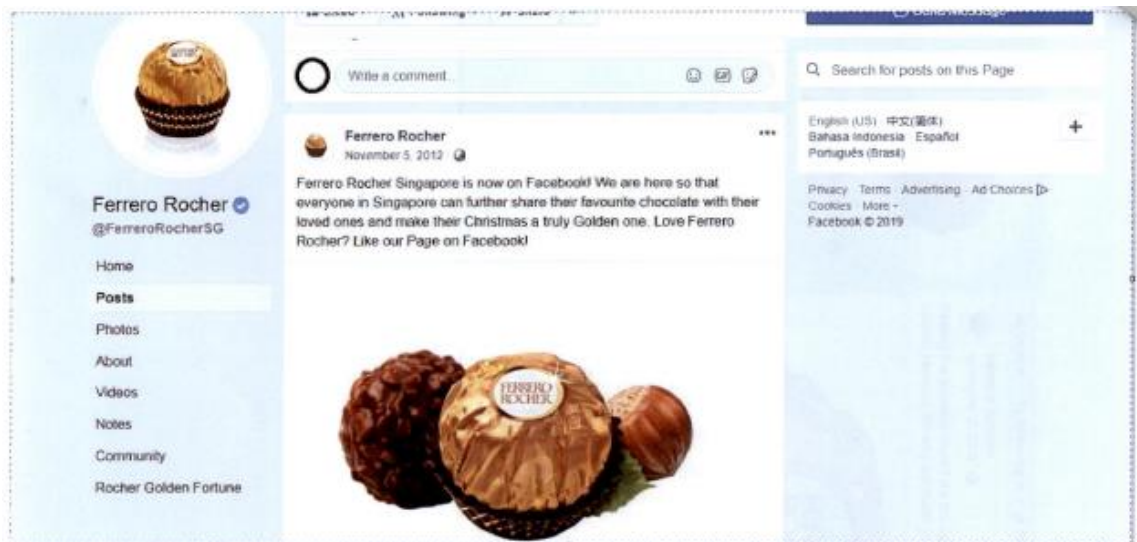
¹⁸ The Assistant Registrar noted in her Statement of Refusal that the spherical shape is common for chocolates and the Applicant has not denied this. Instead at different times different aspects of the combination of features in the Application Mark have been emphasised: eg, in its letter of 4 January 2016 Messrs Drew & Napier on behalf of the Applicant (Bundle 1, at R1) referred particularly to the “golden foil wrap” as sufficiently distinguishing the Applicant’s confectionery products from those of others, at [13].

¹⁹ For example, at pp152, 153, 155, 162 and 163 of Exhibit E, SD1.

²⁰ The Applicant’s Written Submissions, at [11], state that this sticker has a gold rim, but this feature is not included in the written description provided in the letter of 29 September 2019, see [39] above.

the pure 3D shape mark cases referred to by Jacob J in *Viennetta* (at [35] above), should not be permitted.

- 49 The Applicant also adduced in Exhibit F to SD1 what it contends is evidence of the use of the Application Mark on its Facebook page. However, on inspection, the overwhelming majority of this use appears either to be a mock-up of a FERRERO ROCHER chocolate bearing clearly the FERRERO ROCHER brand²¹ or does not show the Application Mark as it appears either in the Subject Application or in the Applicant's written description.²² In SSD2, the Applicant's proxies exhibit four mock-ups of FERRERO ROCHER chocolates that have appeared in posts on the Facebook page www.facebook.com/FerreroRocherSG: these mock-ups feature in three of the four examples²³ (see **Figure 5** below) a sparkling star device (not existing in the real world and thus evidencing the fact they are mock-ups) beside the FERRERO ROCHER words on the oval sticker, are coloured more brown than gold²⁴ and seem to be oval rather than spherical.²⁵ Although I acknowledge that the way that these are seen may be due to perspective, this merely serves to highlight the artificial and unclear nature of the trade mark being applied for.



²¹ For example, at p155

²² For example, at p159 (where there is no sign of the brown paper cup) and p161 (where the spherical product does not sit in the cup which itself seems splayed out).

²³ SSD2, Exhibit A, pp5, 6 and 7.

²⁴ SSD2, Exhibit A, pp5 and 6.

²⁵ SSD2, Exhibit A, pp7 and 8.



Figure 5

50 To bolster its contentions further, the Applicant exhibited in SD1, at Exhibit H, extracts from a November 2017 market survey report prepared by Millward Brown on the basis of fieldwork carried out from 25 July to 28 September 2017. This report concluded that the ROCHER Chocolate Product is “strong within the praline segment in Singapore where it has built a distinctive imagery and personality.”²⁶ This conclusion cannot be given any probative value as evidence in a trade mark registration case as it does not address the essential question that must be answered: would the average consumer view the distinctive

²⁶ SD1, Exhibit H, at p375.

packaging, if indeed all or any of the components of the packaging are distinctive, to be an indication of trade origin of a product which did not have the distinctive word mark FERRERO ROCHER on it?

- 51 In its ‘Stand on *Nestlé bottle* case’ the Applicant relies on a survey it had conducted by Commercial Investigations LLP (CI) on 28 and 29 December 2016 (the Survey Report forms Exhibit A to SSD2). This survey involved asking 400 people in 25 locations around Singapore “do you know this product?” when shown a picture of the Application Mark. If they did not, the interview ended there but if they did, they were asked “what is the brand of the product?”. Unsurprisingly, 360 answered yes to the first question and, equally unsurprisingly, 331 of those answered either FERRERO, ROCHER, FERRERO ROCHER or Ferrero Rocher in Mandarin. Indeed, it is noteworthy that Mr Philip Tan, the Managing Partner of CI, seems to have been well aware of what the survey was expected to show when he states in his summary of the findings: “the survey yielded positive results”.²⁷
- 52 The Applicant served a CD-ROM containing a copy of each individual survey questionnaire. I have examined these carefully and concluded that they do not begin to be evidence capable of proving what needs to be proved by the Applicant in this case: it seems highly unlikely that the recording of the responses was verbatim as none of those interviewed seem to have stumbled, mis-stated or garbled the names FERRERO or FERRERO ROCHER; nor are the instructions given to the interviewers provided. For example, if a respondent hesitated, did the interviewer prompt the interviewees in any way? Was the briefing of the interviewers (which is not described) done in a neutral way or were they made aware of what the survey was aiming to show? Notwithstanding these and other flaws in methodology that make somewhat suspect the findings of the survey, even if one takes the results at face value, they fail to show that the Application Mark functions as an indication of trade origin absent the distinctive word mark FERRERO ROCHER.
- 53 As was made clear by the Court of Appeal in *Kit Kat*, at [44], recognition and association are not sufficient, there must be shown to be distinctiveness of the Application Mark as a trade mark on its own:

such recognition and association is quite different from and does not equate with reliance upon that shape as a badge of origin. The latter occurs in the quite distinct situation where the trader and consumers of his product regard the shape in question as a badge of origin. This might happen from time to time, but it will not be found to have happened merely because the shape is associated with a product that the trader has put on the market.

The survey does not begin to prove that the Application Mark is such a ‘badge of origin’, especially when one bears in mind its composite nature: crinkled gold spherical shape, brown pleated paper cup and white oval sticker. By combining a number of elements in the packaging used for FERRERO ROCHER pralines, the Applicant should not be permitted merely by virtue of such use to obtain a registered trade mark for that packaging. Registration of the packaging as a trade mark does not automatically follow from the extensive promotion, advertising and sale of products under a distinctive word mark. If such ‘sleight of hand or trick’ (to adopt the words of Jacob J cited at [34] above) were permitted, the Application Mark could then be exploited to frighten off other traders who

²⁷ SSD1, Exhibit A, at p5 of the Report.

are legitimately using one or more of the dominant elements of that packaging (the gold spherical shape, the paper cup or the white oval sticker) for their own chocolate products. This would apply especially to SMEs who may lack the resources to spend on defending a trade mark infringement claim, however speculative or unjustified that claim may be.

- 54 Looked at both individually and in their entirety, the documents and evidence adduced by the Applicant to support its contention that the Application Mark has acquired distinctiveness by virtue of the use made of it prior to the application date fail to satisfy me on a balance of probabilities that this is so. In coming to this conclusion, I have considered the Application Mark both as a whole and as a combination of its separate constituent elements, the crinkled gold spherical shape, the brown pleated paper cup with two gold stripes and the white oval sticker, whilst bearing in mind that “the mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character”, as stated by the Court of Justice of the European Communities in *Eurohypo v OHIM* [2008] I-3297 at [41] (and cited in *Kerly’s* at [10-078]).

Conclusion

- 55 Having considered all the submissions made and the evidence filed, the objection under Section 7(1)(b) of the Act is maintained and the reliance by the Applicant on Section 7(2) of the Act is rejected.
- 56 Finally, I would like to record my appreciation for the robust but fair submissions made at the *ex parte* hearing by Ms Seah on behalf of the Applicant. She was commendably measured, succinct and firm in pressing the Applicant’s case, eschewing hyperbole or unsustainable propositions unsupported by relevant evidence.

Date of Issue: 12 December 2019