

In Reply Please Quote Our Reference

Your Ref :  
Our Ref : NRP(OPP)/T1200900B  
Date : 02 September 2013  
Writer's Direct Line : (65) 63302742

The World Intellectual Property Organisation  
International Registrations Department  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

Dear Sirs

**NOTIFICATION OF REFUSAL OF PROTECTION BASED ON OPPOSITION  
MADE PURSUANT TO RULE 17(1) TO (3) OF THE COMMON REGULATIONS  
UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL  
REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT  
AGREEMENT**

**INTERNATIONAL REGISTRATION NO. 1103380  
Dochirnie pidpriemstvo "Kondyterska korporatsiia "Roshen"  
SINGAPORE TRADE MARK NO(S). T1200900B**

We refer to the above international registration.

2 Pursuant to the institution of opposition proceedings against the trade mark in the above international registration, we hereby issue this formal refusal letter. This refusal covers all the goods and/or services of the international registration.

3 The grounds of the opposition are set out in the attached Statement(s) of Grounds filed together with Notice(s) of Opposition (Form(s) TM 11).

4 If the holder wishes to reply to the opposition, he must file a Counter-Statement together with Form TM 12 for each Singapore trade mark number and a fee of SGD357 for each class of goods or services in respect of which his reply is addressed at the Intellectual Property Office of Singapore within 4 months from the date of this letter. At the same time, he must serve a copy of the Counter-Statement and Form TM 12 on the opponent.

If the holder wishes to have an extension of time to file his Counter-Statement(s), he may submit a written request to the Registrar of Trade Marks, Singapore. The holder must send a notice to any person or party who will be affected by such extension, requesting his consent

../2

thereto. His request for extension must be supported by such notice and such consent, if obtained. Even if the holder has not been advised of the outcome of the request for extension of time, the Counter-Statement(s) must still be filed within 6 months from the date of this letter. This is because the maximum time that may be allowed by the Registrar for the filing of a Counter-Statement is 6 months from the date of this letter.

5 Further, if the holder does not already have an address for service in Singapore, he must provide us with one Form TM 1 which should be filed together with his Counter-Statement(s). The fee payable for Form TM 1 is SGD9.00 (via manual submission) or SGD8.50 (via online submission) for each Singapore trade mark number. A copy of Form TM 1 must also be served on the opponent.

6 We also attach:

- (a) details of the conflicting marks upon which the opposition is based;
- (b) Form TM12 for the holder to file his Counter-Statement (one Form TM12 should be used for each Singapore trade mark number in respect of which protection is opposed);
- (c) Form TM 1 for the holder to file an address for service in Singapore;
- (d) Singapore payment form;
- (e) the relevant provisions of the Singapore Trade Marks Act and Rules.

Tan Meng Joek, Jackie (Ms)  
Assistant Registrar  
for Registrar of Trade Marks  
Singapore

cc Opponent (without enclosures)

(This is a computer generated letter. No signature is required)

## **PROVISIONS OF SINGAPORE LAW**

### **TRADE MARKS ACT (CHAPTER 332)**

#### **Section 8 Relative grounds for refusal of registration**

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

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

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

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if -

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered -

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

(ii) if the earlier trade mark is well known to the public at large in Singapore -

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

(5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith.

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &#1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:40  
PAGE : 1  
RPT NO : 292179/&#2

National

S/No : 1  
IR No :  
Date of IR :  
Date of Notification of IR :  
Date of SD :  
Date of Notification of SD :  
Date of Completion of  
Registration Procedure :  
  
TM No : T9006398B  
Application Type : Trade Mark  
Class : 30  
Part : A  
Converted Application : N  
Application Date : 15/09/1990  
Mark Lodged in Colour :  
Mark Status : Registered  
Mark Status Date : 15/09/1990  
Publication Status : Published  
Publication Date : 30/10/1998  
Cert Despatched Date : 22/05/1999  
Expire Date : 15/09/2017  
3-dimensional shape :  
Aspect of packaging :  
Colour(s) as a trade mark :  
Other Non-conventional Mark :

**FERRERO ROCHER**

Description of Particular Feature(s) of Mark

-----  
Nil.

Priority Details

-----  
Nil.

Replacement Application under Madrid Protocol

-----  
Nil.

Transformation Application under Madrid Protocol

-----  
Nil.

MARK INDEX

-----  
Words In Mark : FERRERO ROCHER  
Device Description :  
Phonetic Equivalent :  
Translation :  
Transliteration :

SPECIFICATION OF GOODS AND SERVICES

-----  
Class 30  
Non-medicated chocolate confectionery.

CURRENT APPLICANT/PROPRIETOR DETAILS

-----  
Intellectual Property Office of Singapore, Ministry of Law, Singapore

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:40  
PAGE : 2  
RPT NO : 292179/&&2

-----  
Code : CO153356Z  
Company : FERRERO S.P.A.  
Constitution : A JOINT STOCK COMPANY  
Country : ITALY  
State :  
  
Address : Piazzale Pietro Ferrero 1, 12051 Alba,  
Cuneo, Italy

MARK CLAUSES

-----  
(01) To be associated with Trade Mark Nos. 62665, 63709, 1772/82, 3046/82,  
1690/83, 545/87 and 6166/90.

AGENT/ADDRESS FOR SERVICE

-----  
S/No Agent/AFS Name/Address Action Representing  
-----  
01 DREW & NAPIER Application &  
P.O. Box 152 registration  
ROBINSON ROAD POST OFFICE  
Singapore 900302  
  
02 DREW AND NAPIER LLC Renewals  
10 COLLYER QUAY  
#10-01 OCEAN FINANCIAL CENTRE  
Singapore 049315

CORRECTION RECORDS

-----  
Nil.

LICENSEE DETAILS

-----  
Nil.

LIST OF GRANTEE DETAILS

-----  
Nil.

OWNERSHIP HISTORY

-----  
Nil.

OPPOSITION/REVOCATION/INVALIDATION/RECTIFICATION STATUS

-----  
Nil.

DIVISION DETAILS

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:40  
PAGE : 3  
RPT NO : 292179/&&2

---

Nil.

PENDING ACTION

-----

Nil.

AMENDMENT HISTORY

-----

Nil.

HISTORY OF ACTION TAKEN ON MARK

-----

- (01) Lodgement Date : 15/09/1990  
Form Type : TM 4  
Document Type : TMA  
Status : Processing Completed
- (02) Lodgement Date : 08/02/1999  
Form Type : TM 6  
Document Type : FGG  
Status : Processing Completed
- (03) Lodgement Date : 28/06/1999  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed
- (04) Lodgement Date : 17/08/2007  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed
- (05) Lodgement Date : 17/04/2009  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (06) Lodgement Date : 21/03/2011  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed

NON-LIVE CLASS HISTORY

-----

Nil.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &&1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 1  
RPT NO : 292180/&&2

International Registration Designating Singapore

S/No : 1  
IR No : 799546  
Date of IR : 28/01/2003  
Date of Notification of IR : 24/04/2003  
Date of SD :  
Date of Notification of SD :  
Date of Completion of  
Registration Procedure : 11/05/2004

TM No : T0305569B  
Application Type : Trade Mark  
Class : 30  
Part :  
Converted Application : N  
Application Date : 28/01/2003  
Mark Lodged in Colour : Y  
Mark Status : Registered  
Mark Status Date : 06/12/2002  
Publication Status : Published  
Publication Date : 10/03/2004  
Cert Despatched Date :  
Expire Date : 28/01/2023  
3-dimensional shape : N  
Aspect of packaging : N  
Colour(s) as a trade mark : N  
Other Non-conventional Mark :



Description of Particular Feature(s) of Mark

-----  
Nil.

Priority Details

-----  
Class No : 30  
S/No : 1  
Priority Date : 06/12/2002  
Priority Country : IT  
Goods/Services claimed : All goods/services claimed in this application

Replacement Application under Madrid Protocol

-----  
Nil.

Transformation Application under Madrid Protocol

-----  
Nil.

MARK INDEX

-----  
Words In Mark : ferrero rocher  
Device Description : wrapped chocolate paper cup ellipse hazelnut  
Phonetic Equivalent :  
Translation :  
Transliteration :

SPECIFICATION OF GOODS AND SERVICES

-----  
Class 30

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &#1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 2  
RPT NO : 292180/&#2

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flours and milled cereal products (except for fodder); bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; cooking salt, mustard; pepper, vinegar, sauces; spices; ice for refreshment, cocoa, cocoa products, namely paste for cocoa beverages, chocolate paste, toppings and, including, chocolate toppings, chocolate, pralines, chocolate articles for Christmas-tree decorations, food products consisting of an edible chocolate casing filled with an alcoholic liquid, sweet products, pastries, including fine pastry and longlife pastry; chewing-gum, sugarless chewing gum, sugarless candies.

CURRENT APPLICANT/PROPRIETOR DETAILS

-----  
Code : MC003195G  
Company : FERRERO S.P.A.  
Constitution :  
Country : ITALY  
State :  
  
Address : Piazzale Pietro Ferrero, 1, I-12051  
ALBA (CN), Italy.

MARK CLAUSES

- (01) The following claim is made in the International Registration: Colours claimed: Gold, red, white, green, light brown, yellow.  
  
(02) Priority Date Claimed: 6 December 2002 (Italy).

AGENT/ADDRESS FOR SERVICE

-----  
S/No Agent/AFS Name/Address Action Representing  
-----  
01 DREW AND NAPIER LLC Application &  
10 COLLYER QUAY registration  
#10-01 OCEAN FINANCIAL CENTRE  
Singapore 049315

CORRECTION RECORDS

-----  
Nil.

LICENSEE DETAILS

-----  
Nil.

LIST OF GRANTEE DETAILS

-----  
Nil.

OWNERSHIP HISTORY



TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 3  
RPT NO : 292180/&2

---

Nil.

OPPOSITION/REVOCATION/INVALIDATION/RECTIFICATION STATUS

-----  
Nil.

DIVISION DETAILS

-----  
Nil.

PENDING ACTION

-----  
Nil.

AMENDMENT HISTORY

-----  
AMENDMENT HISTORY OF PARTICULARS OF COMPANY

-----  
(01) Amendment Date : 05/01/2010  
Status : Processing Completed  
Amendment Type : Company Address  
  
Amendment From : Piazzale Pietro Ferrero, I-12051 ALBA (CN), Italy.  
Amendment To : Piazzale Pietro Ferrero, 1, I-12051 ALBA (CN), Italy.

HISTORY OF ACTION TAKEN ON MARK

-----  
(01) Lodgement Date : 24/04/2003  
Form Type : MIR 4  
Document Type : ENN  
Status : Processing in Progress  
  
(02) Lodgement Date : 05/01/2004  
Form Type : NIL  
Document Type : LTR  
Status : Processing in Progress  
  
(03) Lodgement Date : 05/01/2004  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed  
  
(04) Lodgement Date : 26/01/2004  
Form Type : TM 6  
Document Type : FGG  
Status : Processing Completed  
  
(05) Lodgement Date : 17/04/2009  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed  
  
(06) Lodgement Date : 05/01/2010  
Form Type : MA 26  
Document Type : MTN  
Status : Processing Completed

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 4  
RPT NO : 292180/&2

---

- (07) Lodgement Date : 21/03/2011  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (08) Lodgement Date : 16/02/2013  
Form Type : MR 19  
Document Type : NRR  
Status : Processing Completed

NON-LIVE CLASS HISTORY

-----

Nil.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 1  
RPT NO : 292181/&2

National

S/No : 1  
IR No :  
Date of IR :  
Date of Notification of IR :  
Date of SD :  
Date of Notification of SD :  
Date of Completion of  
Registration Procedure :  
  
TM No : T9302352C  
Application Type : Trade Mark  
Class : 30  
Part : A  
Converted Application : N  
Application Date : 01/04/1993  
Mark Lodged in Colour : Y  
Mark Status : Registered  
Mark Status Date : 01/04/1993  
Publication Status : Published  
Publication Date : 28/04/2000  
Cert Despatched Date : 22/08/2000  
Expire Date : 01/04/2023  
3-dimensional shape :  
Aspect of packaging :  
Colour(s) as a trade mark :  
Other Non-conventional Mark :



Description of Particular Feature(s) of Mark

-----  
Nil.

Priority Details

-----  
Nil.

Replacement Application under Madrid Protocol

-----  
Nil.

Transformation Application under Madrid Protocol

-----  
Nil.

MARK INDEX

-----  
Words In Mark : ferrero rocher  
Device Description : doily  
Phonetic Equivalent :  
Translation :  
Transliteration :

SPECIFICATION OF GOODS AND SERVICES

-----  
Class 30  
Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates,  
pralines, candies for food and cakes.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 2  
RPT NO : 292181/&2

CURRENT APPLICANT/PROPRIETOR DETAILS

-----  
Code : CO153356Z  
Company : FERRERO S.P.A.  
Constitution : A JOINT STOCK COMPANY  
Country : ITALY  
State :  
  
Address : Piazzale Pietro Ferrero 1, 12051 Alba,  
Cuneo, Italy

MARK CLAUSES

-----  
Nil.

AGENT/ADDRESS FOR SERVICE

| S/No  | Agent/AFS Name/Address  | Action Representing           |
|-------|---|-------------------------------|
| ----- | -----   | -----                         |
| 01    | DREW AND NAPIER LLC<br>10 COLLYER QUAY<br>#10-01 OCEAN FINANCIAL CENTRE<br>Singapore 049315 | Application &<br>registration |
| 02    | DREW AND NAPIER LLC<br>10 COLLYER QUAY<br>#10-01 OCEAN FINANCIAL CENTRE<br>Singapore 049315 | Renewals                      |

CORRECTION RECORDS

-----  
Nil.

LICENSEE DETAILS

-----  
Nil.

LIST OF GRANTEE DETAILS

-----  
Nil.

OWNERSHIP HISTORY

-----  
Nil.

OPPOSITION/REVOCATION/INVALIDATION/RECTIFICATION STATUS

-----  
Nil.

DIVISION DETAILS

-----  
Nil.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &#1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:41  
PAGE : 3  
RPT NO : 292181/&#2

---

PENDING ACTION

-----

Nil.

AMENDMENT HISTORY

-----

Nil.

HISTORY OF ACTION TAKEN ON MARK

-----

- (01) Lodgement Date : 01/04/1993  
Form Type : TM 4  
Document Type : TMA  
Status : Processing Completed
- (02) Lodgement Date : 20/08/1999  
Form Type : NIL  
Document Type : LTR  
Status : Lodged
- (03) Lodgement Date : 07/04/2000  
Form Type : TM 6  
Document Type : FGG  
Status : Processing Completed
- (04) Lodgement Date : 27/03/2003  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed
- (05) Lodgement Date : 17/04/2009  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (06) Lodgement Date : 21/03/2011  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (07) Lodgement Date : 21/03/2013  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed

NON-LIVE CLASS HISTORY

-----

Nil.

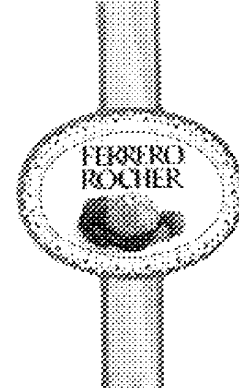
TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:42  
PAGE : 1  
RPT NO : 292182/&2

National

S/No : 1  
IR No :  
Date of IR :  
Date of Notification of IR :  
Date of SD :  
Date of Notification of SD :  
Date of Completion of  
Registration Procedure :  
  
TM No : T9302351E  
Application Type : Trade Mark  
Class : 30  
Part : A  
Converted Application : N  
Application Date : 01/04/1993  
Mark Lodged in Colour : Y  
Mark Status : Registered  
Mark Status Date : 01/04/1993  
Publication Status : Published  
Publication Date : 28/04/2000  
Cert Despatched Date : 22/08/2000  
Expire Date : 01/04/2023  
3-dimensional shape :  
Aspect of packaging :  
Colour(s) as a trade mark :  
Other Non-conventional Mark :



Description of Particular Feature(s) of Mark  
-----  
Nil.

Priority Details  
-----  
Nil.

Replacement Application under Madrid Protocol  
-----  
Nil.

Transformation Application under Madrid Protocol  
-----  
Nil.

#### MARK INDEX -----

Words In Mark : FERRERO ROCHER  
Device Description : DOILY CHOCOLATE ROSETTE  
Phonetic Equivalent :  
Translation :  
Transliteration :

#### SPECIFICATION OF GOODS AND SERVICES -----

Class 30  
Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates,  
pralines, candies for food and cakes.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:42  
PAGE : 2  
RPT NO : 292182/&2

CURRENT APPLICANT/PROPRIETOR DETAILS

-----  
Code : CO153356Z  
Company : FERRERO S.P.A.  
Constitution : A JOINT STOCK COMPANY  
Country : ITALY  
State :  
  
Address : Piazzale Pietro Ferrero 1, 12051 Alba,  
Cuneo, Italy

MARK CLAUSES

-----  
Nil.

AGENT/ADDRESS FOR SERVICE

| S/No  | Agent/AFS Name/Address  | Action Representing           |
|-------|---|-------------------------------|
| ----- | -----   | -----                         |
| 01    | DREW AND NAPIER LLC<br>10 COLLYER QUAY<br>#10-01 OCEAN FINANCIAL CENTRE<br>Singapore 049315 | Application &<br>registration |
| 02    | DREW AND NAPIER LLC<br>10 COLLYER QUAY<br>#10-01 OCEAN FINANCIAL CENTRE<br>Singapore 049315 | Renewals                      |

CORRECTION RECORDS

-----  
Nil.

LICENSEE DETAILS

-----  
Nil.

LIST OF GRANTEE DETAILS

-----  
Nil.

OWNERSHIP HISTORY

-----  
Nil.

OPPOSITION/REVOCATION/INVALIDATION/RECTIFICATION STATUS

-----  
Nil.

DIVISION DETAILS

-----  
Nil.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &#1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:42  
PAGE : 3  
RPT NO : 292182/&#2

---

PENDING ACTION

-----

Nil.

AMENDMENT HISTORY

-----

Nil.

HISTORY OF ACTION TAKEN ON MARK

-----

- (01) Lodgement Date : 01/04/1993  
Form Type : TM 4  
Document Type : TMA  
Status : Processing Completed
- (02) Lodgement Date : 03/06/1999  
Form Type : NIL  
Document Type : LTR  
Status : Lodged
- (03) Lodgement Date : 07/04/2000  
Form Type : TM 6  
Document Type : FGG  
Status : Processing Completed
- (04) Lodgement Date : 31/03/2003  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed
- (05) Lodgement Date : 17/04/2009  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (06) Lodgement Date : 21/03/2011  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed
- (07) Lodgement Date : 21/03/2013  
Form Type : TM 19  
Document Type : RE1  
Status : Processing Completed

NON-LIVE CLASS HISTORY

-----

Nil.



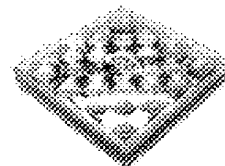
TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &#1bbb

Mark Listing 3 (Full Details)

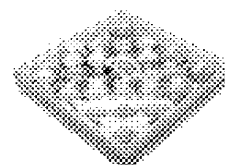
02/09/2013 10:12:42  
PAGE : 1  
RPT NO : 292183/&#2

National

S/No : 1  
IR No :  
Date of IR :  
Date of Notification of IR :  
Date of SD :  
Date of Notification of SD :  
Date of Completion of  
Registration Procedure :



TM No : T0508919E  
Application Type : Trade Mark  
Class : 30  
Part :  
Converted Application : N  
Application Date : 30/05/2005  
Mark Lodged in Colour : Y  
Mark Status : Registered  
Mark Status Date : 30/05/2005  
Publication Status : Published  
Publication Date : 08/02/2006  
Cert Despatched Date : 24/04/2006  
Expire Date : 30/05/2015  
3-dimensional shape : Y  
Aspect of packaging : N  
Colour(s) as a trade mark : N  
Other Non-conventional Mark :



Description of Particular Feature(s) of Mark

-----  
The mark consists of a three-dimensional shape of a box with the words FERRERO  
ROCHER appearing thereon.

Priority Details

-----  
Nil.

Replacement Application under Madrid Protocol

-----  
Nil.

Transformation Application under Madrid Protocol

-----  
Nil.

MARK INDEX

-----  
Words In Mark : ferrero rocher  
Device Description : three-dimensional, box box wrapped chocolate  
Phonetic Equivalent :  
Translation :  
Transliteration :

SPECIFICATION OF GOODS AND SERVICES

-----  
Class 30  
Biscuits, cakes, pastry and pastry products, chocolate and chocolate products,  
snacks, confectionery, ice-creams.

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:42  
PAGE : 2  
RPT NO : 292183/&2

CURRENT APPLICANT/PROPRIETOR DETAILS

-----  
Code : CO224991A  
Company : FERRERO S.P.A.  
Constitution :  
Country : ITALY  
State :  
  
Address : Piazzale Pietro Ferrero 1, 12051 Alba,  
Cuneo, Italy.

MARK CLAUSES

- (01) Application for a series of two marks.  
  
(02) The second mark(s) in the series is/are limited to the colour(s) gold, white, brown and green as shown in the representation on the form of application.

AGENT/ADDRESS FOR SERVICE

-----  
S/No Agent/AFS Name/Address Action Representing  
-----  
01 DREW AND NAPIER LLC Application &  
10 COLLYER QUAY registration  
#10-01 OCEAN FINANCIAL CENTRE  
Singapore 049315

CORRECTION RECORDS

-----  
Nil.

LICENSEE DETAILS

-----  
Nil.

LIST OF GRANTEE DETAILS

-----  
Nil.

OWNERSHIP HISTORY

-----  
Nil.

OPPOSITION/REVOCATION/INVALIDATION/RECTIFICATION STATUS

-----  
Nil.

DIVISION DETAILS

-----  
Nil.

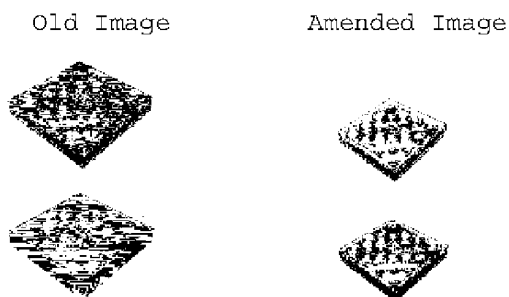
PENDING ACTION

-----  
Nil.

AMENDMENT HISTORY

-----  
AMENDMENT HISTORY OF PARTICULARS OF MARK

(01) Amendment Date : 05/09/2005  
Status : Processing Completed  
Amendment Type : Mark



(02) Amendment Date : 05/09/2005  
Status : Processing Completed  
Amendment Type : Description of Particular Feature(s) of Mark

Amendment From :

Amendment To : The mark consists of a three-dimensional shape of a box  
with the words FERRERO ROCHER appearing thereon.

HISTORY OF ACTION TAKEN ON MARK

-----  
(01) Lodgement Date : 30/05/2005  
Form Type : TM 4  
Document Type : TMA  
Status : Processing in Progress

(02) Lodgement Date : 05/09/2005  
Form Type : NIL  
Document Type : LTR  
Status : Processing in Progress

(03) Lodgement Date : 05/09/2005  
Form Type : TM 27  
Document Type : AAE  
Status : Processing Completed

(04) Lodgement Date : 05/09/2005  
Form Type : NIL  
Document Type : LTR  
Status : Processing in Progress

(05) Lodgement Date : 26/01/2006  
Form Type : TM 6  
Document Type : FGG  
Status : Processing Completed

(06) Lodgement Date : 17/04/2009  
Form Type : TM 1

TRADEMARK SYSTEM  
EQSR6103A/1  
SVCS NO : &1bbb

Mark Listing 3 (Full Details)

02/09/2013 10:12:42  
PAGE : 4  
RPT NO : 292183/&2

---

Document Type : AFS  
Status : Processing Completed  
(07) Lodgement Date : 21/03/2011  
Form Type : TM 1  
Document Type : AFS  
Status : Processing Completed

NON-LIVE CLASS HISTORY

-----  
Nil.



**ravindran  
associates**

an intellectual property law practice since 1993

20 AUG 2013

advocates and solicitors  
trademark and patent agents  
commissioner for oaths  
notary public

Your Ref : OPP T1200900B  
Our Ref : KS/S216-18/sj  
(Please quote our file reference)

Date : 20 August 2013

**Intellectual Property Office of Singapore**  
51 Bras Basah Road  
#04-01 Manulife Centre  
Singapore 189544

**BY HAND ONLY**

Dear Sirs,

Re: **Singapore – Trade Mark Application No. T1200900B for**



R13/41622  
\$374.00  
20/08/13  
048-SEP 20 AUG 13 15:27

**In Class 30**

**filed in the name of Dotchirne Pidpriemstvo "Konditerska Korporatzia  
"ROSHEN" and Opposition thereto by Ferrero S.p.A.**

1. We act for Ferrero S.p.A. of Piazzale Pietro Ferrero 1, 12051 Alba, Cuneo, Italy, the Opponent to the application captioned above.
2. We enclose the following for the Registrar's kind attention:-
  - (i) Form TM 11;
  - (ii) Notice of Opposition; and
  - (iii) Requisite fees for the sum of S\$374.00 payable by way of GIRO together with the relevant payment form.

We have also arranged to serve a copy of the Notice of Opposition at the address for service of the trade mark agents for the Applicant, China Intellectual Property Agency (H.K.), as required under the Trade Mark Rules, and enclose herewith a copy of our letter to them of even date for the Registrar's records.

Yours faithfully,

**RAVINDRAN ASSOCIATES**

Enc:

- cc: 1. China Intellectual Property Agency (H.K.)  
2. Client

IPOS 20AUG13 PM 3:03

20 AUG 2013



**ravindran  
associates**

an intellectual property law practice since 1993

advocates and solicitors  
trademark and patent agents  
commissioner for oaths  
notary public

Your ref : Not known  
Our re : KS/S216-18/sj  
(Please quote our file reference)

Date : 20 August 2013

**China Intellectual Property Agency (H.K.)**  
14 Robinson Road #13-00  
Far East Finance Building  
Singapore 048545

**BY HAND ONLY**

Dear Sirs,

**Re: Singapore – Trade Mark Application No. T1200900B for**



**in Class 30**

**filed in the name of Dotchirne Pidpriemstvo "Konditerska Korporatzia  
"ROSHEN" and Opposition thereto by Ferrero S.p.A.**

1. We act for Ferrero S.p.A. of Piazzale Pietro Ferrero 1, 12051 Alba, Cuneo, Italy, the Opponent to the application captioned above.
2. We have filed the Notice of Opposition with the Intellectual Property Office of Singapore ("IPOS") today. By way of service, we enclose copies of the following:-
  - (i) Form TM.11;
  - (ii) Notice of Opposition; and
  - (iii) Our letter of even date to IPOS.

Kindly acknowledge receipt of the same.

Yours faithfully,

**RAVINDRAN ASSOCIATES**

Enc.

- cc: 1. Intellectual Property Office of Singapore (Your ref: OPP T1200900B)  
2. Client



**SINGAPORE  
TRADE MARKS ACT  
(CHAPTER 332)  
TRADE MARK RULES**

**FORM TM 11**

**NOTICE OF OPPOSITION**

*This form may take about 4-8 minutes to complete.*

General Instructions

- a. *If there is not enough space to fill in any part of this form, please use separate sheets.*
- b. *If the Notice of Opposition relates to an international registration designating Singapore, the international registration number must be given, in addition to the trade mark number and class number(s).*
- c. *The fee for this form is payable on a per class basis.*
- d. *Please note that any fee paid is not refundable.*

1 This opposition relates to:

**20 AUG 2013**

- ☒ a pending trade mark application
- ☐ an amendment of a pending trade mark application after publication
- ☐ an alteration of a registered trade mark
- ☐ an amendment of regulations governing the use of a collective mark or certification mark
- ☐ the removal of any matter from the Register

*(tick one box only)*

2 Trade Mark Number

**T1200900B**

International Registration Number

-

Class number(s) this opposition relates to

**30**

Total number of classes this opposition relates to

**01**

3 Particulars of opponent

Company Code  
(if applicable)

|   |  |   |  |
|---|--|---|--|
| Name  | <b>FERRERO S.P.A.</b>  |   |  |
| Address   | <b>Piazzale Pietro Ferrero</b><br><b>1-12051 Alba (CN)</b><br><b>Italy</b> |   |  |
| Citizenship or Country of incorporation/ constitution                           | <b>Italy</b>   | State of incorporation<br>(for U.S.A. corporations) |  |
| Sole Proprietor or Partners' name(s)<br>(if sole proprietorship or partnership) | -  |   |  |

4 Address for service

Note  
The address for service must be a Singapore address.

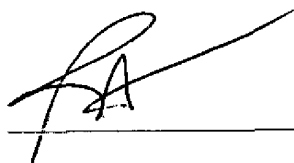
|                               |  |
|-------------------------------|--|
| Agent Code<br>(if applicable) | <b>AG0862I</b>   |
| Name                          | <b>Ravindran Associates</b>  |
| Address                       | <b>P.O. Box 2988</b><br><b>Raffles City Post Office</b><br><b>Singapore 911799</b> |



5 Grounds of opposition

See attached Statement of Grounds.

Signature



Date

20  
Day

August  
Month

2013  
Year

Name  
(block letters)

**RAVINDRAN  
ASSOCIATES**

Direct Tel No.

**63366990**

Number of extra sheets attached to this form

13

**THE TRADE MARKS ACT  
(CHAPTER 332)**

**NOTICE OF OPPOSITION TO APPLICATION FOR  
REGISTRATION OF A TRADE MARK**

---

IN THE MATTER OF Trade Mark  
Application No. T1200900B for



in Class 30 in the name of Dotchirne  
Pidpriemstvo "Konditerska  
Korporatzia "ROSHEN" (hereinafter  
referred to as the Applicant")

And

Opposition thereto by Ferrero S.P.A.  
(hereinafter referred to as "the  
Opponent")

**STATEMENT OF GROUNDS OF OPPOSITION**

**A. THE APPLICANT'S APPLICATION**

1. The Applicant, Dotchirne Pidpriemstvo "Konditerska Korporatzia "ROSHEN", a company incorporated under the laws of Ukraine of Vul. Pavla Usenka, 8, KYIV, 02105, Ukraine (hereinafter referred to as "the Applicant") has applied



to register the mark under Trade Mark Application No. T120090B, in respect of, "Chocolate".

(hereinafter referred to as the "Applicant's Mark").


**B. FACTS AND BACKGROUND ABOUT THE OPPONENT**




2. The Opponent, Ferrero S.P.A. is a company incorporated under the laws of Italy with a registered address at Piazzale Pietro Ferrero, 1-12051 ALBA (CN), Italy ("the Opponent").
3. The Opponent is the owner of world renown brands of confectionery such as, among others, 'Ferrero Rocher', 'Nutella', 'Tic Tac', 'Kinder', 'Kinder Bueno' and 'Kinder Surprise'. Several trademarks relating to these brands had been registered in Singapore for more than 40 years now, brief details of which is set out at paragraph 4 below. Sales of confectionery bearing these and other brands have placed the Opponent in the top 4 rank of the global confectionery industry.
4. The following is a summary of the earliest series of registered trademarks in the name of the Opponent, in Singapore, covering the brands mentioned at paragraph 3 above in class 30 of the International Classification of Goods and Services ("ICGS") :

| No | Trademark      | Reg. No.  | Registered Since |
|----|----------------|-----------|------------------|
| 1  | <b>NUTELLA</b> | T7048827I | 6 April 1970     |
| 2  | <b>KINDER</b>  | T7462645E | 16 November 1974 |
| 3  | <b>TIC TAC</b> | T7357891J | 22 May 1973      |

These marks are valid and subsisting.

5. The Opponent and its related companies (hereinafter, the "Ferrero Group") have a global presence, which spans throughout Europe, North America, South America, Africa and Asia, almost the entire world.
6. Ferrero Group ended the 2011/12 financial year with a consolidated turnover of over 7,795 million euros (over SGD 12.9 billion). The worldwide operations of Ferrero Group include 38 trading companies, 18 production sites (which during 2013 will become 20) and around 22,300 employees.
7. The Opponent is both the common law and registered proprietor in Singapore of, inter alia, marks consisting the word "ROCHER" in Class 30 of the International Classification of Goods and Services. Ferrero is the registered proprietor of, inter alia, the following trade marks, all in Class 30 in Singapore:

| No. | Trade Mark  | Registration No. | Goods  |
|-----|---|------------------|--|
|     |   | Date             |  |
| 1   | FERRERO ROCHER  | T9006398B        | Non-medicated chocolate confectionery.   |
|     |   | 15 Sep 1990      |  |
| 2   |  | T0305569B        | Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flours and milled cereal products (except for fodder); bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; cooking salt, mustard; pepper, vinegar, sauces; spices; ice for refreshment, cocoa, cocoa products, namely paste for cocoa |

|   |   |                          |  |
|---|---|--------------------------|--|
|   |   | 28 Jan 2003              | beverages, chocolate paste, toppings and, including, chocolate toppings, chocolate, pralines, chocolate articles for Christmas-tree decorations, food products consisting of an edible chocolate casing filled with an alcoholic liquid, sweet products, pastries, including fine pastry and longlife pastry; chewing-gum, sugarless chewing gum, sugarless candies. |
| 3 |    | T9302352C<br>1 Apr 1993  | Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates, pralines, candies for food and cakes.   |
| 4 |  | T9302351E<br>1 Apr 1993  | Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates, pralines, candies for food and cakes.   |
| 5 |  | T0508919E<br>30 May 2005 | Biscuits, cakes, pastry and pastry products, chocolate and chocolate products, snacks, confectionery, ice-cream  |

[hereinafter referred to collectively as the "ROCHER Marks"]

8. The Opponent is well-known around the world including Singapore, for inter alia, the ROCHER Marks. Ferrero Group has used and continues to use the ROCHER Marks in commerce in many countries around the world including Singapore. The sales of goods bearing the Opponent's ROCHER Marks in

Singapore is carried out through a network of retailers which includes hyper markets, departmental stores, supermarkets, convenience stores, medical drug stores and petrol kiosks which are well spread around Singapore.

9. The ROCHER Marks has been used and continues to be used in numerous countries including Singapore for an extensive period of time and such use predates the application date of the Applicant' Mark. As a result of such long and extensive usage of the Opponent's ROCHER Marks, the said marks have become distinctive of the Opponent and their goods. The Opponent's ROCHER Marks has become well known to the trade and public both worldwide and in Singapore. It signifies a symbol of the reputation for quality and reliability associated exclusively with the Opponent and none other. The Opponent has acquired considerable common law rights in the ROCHER Marks by reason of their goodwill and reputation worldwide and in Singapore.
10. The annual sales of goods bearing the ROCHER Marks have been in terms of millions of Singapore dollars which keeps increasing over the years commencing from the 1982. It is sold throughout Singapore at various trade outlets such as hypermarkets, departmental stores, supermarkets, medical drug stores, convenience stores and petrol kiosks. These include the most recognized household names such as NTUC Fairprice, Cold Storage, 7 Eleven, Cheers, Giant, Guardian, Watsons, Carrefour, Sheng Siong and Mustaffa.

11. The annual sales volume in Singapore too has been substantial. The annual sales turnover of goods bearing the ROCHER Marks for the last 30 years is summarized below:

| No | Fiscal Year Ending<br>[1 September to 31 August] | Amount (Not Less than SGD\$) |
|----|--|------------------------------|
| 1  | 1982/83  | 1,000                        |
| 2  | 1983/84  | 200                          |
| 3  | 1984/85  | 30,000                       |
| 4  | 1985/86  | 250,000                      |
| 5  | 1986/87  | 350,000                      |
| 6  | 1987/88  | 1 million                    |
| 7  | 1988/89  | 3 million                    |
| 8  | 1989/90  | 3.2 million                  |
| 9  | 1990/91  | 3 million                    |
| 10 | 1991/92  | 3.2 million                  |
| 11 | 1992/93  | 3.5 million                  |
| 12 | 1993/94  | 4.5 million                  |
| 13 | 1994/95  | 4 million                    |
| 14 | 1995/96  | 6 million                    |
| 15 | 1996/97  | 8.5 million                  |
| 16 | 1997/98  | 4.5 million                  |
| 17 | 1998/99  | 3.5 million                  |
| 18 | 1999/00  | 4.5 million                  |
| 19 | 2000/01  | 4.7 million                  |
| 20 | 2001/02  | 4 million                    |
| 21 | 2002/03  | 4.6 million                  |
| 22 | 2003/04  | 4.4 million                  |
| 23 | 2004/05  | 6.5 million                  |
| 24 | 2005/06  | 8 million                    |
| 25 | 2006/07  | 13 million                   |
| 26 | 2007/08  | 15 million                   |
| 27 | 2008/09  | 18 million                   |
| 28 | 2009/10  | 18 million                   |

|    |         |            |
|----|---------|------------|
| 29 | 2010/11 | 19 million |
| 30 | 2011/12 | 29 million |

The amounts set out above do not include the actual markup that the trade retailers would charge when they sell the products to the end consumers in Singapore. If the marked up figures are taken into consideration, the sales turnover figures would be much higher than those reflected at the Table above.

12. The advertisement and promotion of goods and services bearing the Opponent's ROCHER Marks in Singapore has been and continues to be intensive, with several millions of Singapore dollars spent annually. Such advertisement and promotion of goods bearing the Opponent's ROCHER Marks has been and continues to be carried out through various media.
13. The approximate amounts expended in advertising and promoting the sale of the of goods bearing the Opponent's ROCHER Marks for the last 13 financial years, 1999 to 2012 is summarized below:

| No | Fiscal Year Ending<br>[1 September to 31 August] | Amount (Not Less than SGD\$) |
|----|--|------------------------------|
| 1  | 1999/00  | 800,000                      |
| 2  | 2000/01  | 480,000                      |
| 3  | 2001/02  | 520,000                      |
| 4  | 2002/03  | 530,000                      |
| 5  | 2003/04  | 520,000                      |
| 6  | 2004/05  | 650,000                      |
| 7  | 2005/06  | 600,000                      |
| 8  | 2006/07  | 1 million                    |
| 9  | 2007/08  | 1.1 million                  |



|    |         |             |
|----|---------|-------------|
| 10 | 2008/09 | 1.3 million |
| 11 | 2009/10 | 1.8 million |
| 12 | 2010/11 | 2.0 million |
| 13 | 2011/12 | 1.1 million |

The amounts set out above do not include the costs incurred through 3<sup>rd</sup> party marketing. If the 3<sup>rd</sup> party marketing were taken into consideration, the advertisement and promotional figures would be much higher than those reflected at the Table above.

14. Though the Opponent's ROCHER Marks each has 3 essential features: (i), the words "FERRERO ROCHER", (ii) "FERRERO" and (iii) "ROCHER", the importance of the word "ROCHER" has greater relevance, given the fact that "FERRERO" is the house mark of the Opponent and is used, by the Opponent and by other companies belonging to the Ferrero Group, also on other products bearing different marks such as 'Nutella', "Rond-Noir" and "Collection" besides 'FERRERO ROCHER'. As a result, considered that "FERRERO" is intended as the name of the manufacturer, there is a greater tendency for the goods on which the ROCHER Marks are applied to be referred to as "ROCHER" goods.

**C. GROUND OF OPPOSITION**

15. The Applicant's Mark is set out below:



16. The Applicant's Mark is a composite mark, consisting of words and a generic depiction of chocolate bars, nuts, grapes, raisins and leaves. The most prominent word is "ROSHEN", while the other words which are descriptive and less prominent, are, "FINE CHOCOLATE", "SINCE 1996", "CLASSIC" ("the other words") and an unpronounceable word in a foreign language. The word, "ROSHEN" visually overwhelms the other words given their much smaller font size.
17. In addition, in the light of the striking resemblance with the pre-existing and well-known Opponent's ROCHER Marks in which the word "ROCHER" has greater importance for reasons highlighted at paragraph 14 above, the word "ROSHEN" in the Applicant's Mark will be perceived by the consumers and kept in their mind, while it is only upon very close scrutiny and examination that the other words would be noted, and in any case never perceived as distinctive. The word, "ROSHEN" is the essential feature in the Applicant's Mark. The mark will therefore be referred to as "ROSHEN" and will be pronounced as the "RO-SCHEN" mark (with a "C") Besides being less prominent, the other words, "FINE CHOCOLATE", "SINCE 1996" and classic are also descriptive.
18. Given the substantial goodwill and reputation that Opponent's ROCHER Marks enjoy in Singapore due to voluminous sales and promotion, the Applicant's Mark may be readily confused by the consumers that it is yet another mark of the Opponent's family of ROCHER Marks.

19. The Opponent's ROCHER Marks and the Applicant's Mark are both substantially similar visually and phonetically. There is a real risk of confusion occurring and not just hypothetically. Such risk of confusion occurring is very high given the test of imperfect recollection.
20. By reason of the earlier registration/application and use of the Opponent's ROCHER Marks in Singapore and by reason of the fact that the Applicant's Mark is similar to the Opponent's ROCHER Marks phonetically and visually and has been applied for the same goods in Class 30 (chocolate) for which Opponent's ROCHER Marks are protected, there exists a likelihood of confusion on the part of the Singapore public. Therefore, registration of the Applicant's Mark, if allowed, would be contrary to Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Ed) ("the Act").
21. Further and/or in the alternative, the Opponent's ROCHER Marks are well-known marks in Singapore and the Applicant's Mark is similar to the Opponent's ROCHER Marks. Therefore, registration of the Applicant's Mark, if allowed, would be contrary to Section 8(4) (a) (b) (i) of the Act as use of the Applicant's Mark in relation to the goods for which the said mark is sought to be registered would indicate a connection between those goods and the Opponent and thereby, the interests of the Opponent are likely to be damaged.
22. Further and/or in the alternative, the Opponent's ROCHER Marks are well known marks in Singapore and the Applicant's Mark is similar to the

Opponent's ROCHER Marks. The Opponent's ROCHER Marks are also well known to the public at large in Singapore. Therefore, registration of the Applicant's Mark, if allowed, would be contrary to Section 8(4)(a)(b)(ii)(A) of the Act as use of the Applicant's Mark in relation to the goods for which the said mark is sought to be registered would cause dilution in an unfair manner of the distinctive character of the Opponent's ROCHER Marks.

23. Further and/or in the alternative, the Opponent's ROCHER Marks are well-known marks in Singapore and the Applicant's Mark is similar to the Opponent's ROCHER Marks. The Opponent's ROCHER Marks are also well known to the public at large in Singapore. Therefore registration of the Applicant's Mark, if allowed, would be contrary to Section 8(4)(a)(b)(ii)(B) of the Act as use of the Applicant's Mark in relation to the goods for which the said mark is sought to be registered would take unfair advantage of the distinctive character of the Opponent's ROCHER Marks.
24. Further and/or in the alternative, in view of the substantial goodwill and reputation acquired by the Opponent through the use and promotion of the ROCHER Marks, the use/proposed use of the Applicant's Mark in respect of the goods applied for, if allowed, is likely to deceive and/or cause confusion, and/or lead to the Applicant's goods being passed off as or mistaken for the Opponent's goods, and be injurious to the goodwill and proprietary rights of the Opponent and would be tantamount to an usurpation of the public image in respect of the well-known Opponent's ROCHER Marks as the Applicant's Mark is visually and phonetically identical or confusingly similar to the Opponent's ROCHER Marks. It is highly probable that the public will perceive

the Applicant's Mark as being an extension of the Opponent's famous ROCHER Marks. Accordingly, registration of the Applicant's Mark, if allowed, would be contrary to Section 8(7)(a) of the Act.

25. The Opponent was the first to use the ROCHER' Marks in Singapore. As such, the Applicant are not the bona fide proprietor of the mark applied for and are attempting and has attempted to trade upon the subsisting goodwill and reputation in the Opponent' trademarks.
26. By reason of the matters aforesaid, the application of the Applicant' Mark should be refused by virtue of the law and/or by the Registrar in the exercise of the Registrar's discretion under the provisions of the Act.
27. The Opponent hereby prays that the opposition be allowed against the Applicant with costs and the Applicant' Mark is refused registration.

Address for service in these proceedings:

61 Stamford Road  
#02-09 Stamford Court  
Singapore 178892

Dated this 20<sup>th</sup> day of August 2013



**RAVINDRAN ASSOCIATES**  
Solicitors for the Opponent

To : 1. Intellectual Property Office of Singapore  
Your ref: OPP T1200900B

2. China Intellectual Property Agency (H.K.)  
14 Robinson Road #13-00  
Far East Finance Building  
Singapore 048545

**SINGAPORE  
TRADE MARKS ACT  
(CHAPTER 332)  
TRADE MARKS RULES**

**FORM TM 1**

**REQUEST TO APPOINT OR CHANGE AN AGENT OR  
TO ENTER OR CHANGE AN ADDRESS FOR SERVICE**

*This form may take about 2-7 minutes to complete.*

General instructions

- a. *If there is not enough space to fill in any part of this form, please use separate sheets.*
- b. *Please file Form TM 26 instead if you are amending your trade or business address and the trade or business address is your address for service.*
- c. *The fee for this form is payable on a per trade mark number basis. However, where a request for change does not affect the legal entity of the agent, only a single set of fee is payable.*
- d. *Please note that any fee paid is not refundable.*

Indicate your request by ticking one of the following boxes

- ☐ Request to enter, alter or substitute:
- the name of an agent; and/or
  - an address for service (including discharging an agent on record and substituting with the applicant/proprietor's business address or address for service)
- (please fill in Parts 1- 4)*
- ☐ Request to change an appointed agent's name and/or address for service on record where the agent remains the same legal entity before and after the change
- (please fill in Part 4 only)*

1 Trade Mark Number

|  |
|--|
|  |
|  |
|  |
|  |
|  |
|  |

Note

*All the trade mark numbers listed must pertain to the same person indicated on Part 2 of this Form. Please use a separate form if otherwise.*

2 Person for whom an address for service is to be entered/changed and his particulars

☐ Applicant/  
Proprietor

(tick one box only)

☐ Opponent

☐ Others \_\_\_\_\_  
(Please specify)

Company Code  
(if applicable)

Name

Address

Citizenship or  
Country of  
incorporation/  
constitution

State of  
incorporation  
(for U.S.A. corporations)

3 Is the agent or address for service authorised for :

☐ Application for registration/  
Registration\*

☐ Renewal

☐ Assignment

☐ Renewal and registration

☐ Intervention by third parties

☐ Recordal of Licence

☐ Entry of Disclaimer/Limitation

☐ Amendment of Licence

☐ Amendment of registered mark

☐ Termination of Licence

☐ Revocation of registration/  
Declaration of invalidity

☐ Cancellation/Partial cancellation of  
registration

☐ Recordal of registrable transactions  
other than assignment or licence

☐ Cancellation of recordal of registrable  
transactions other than assignment or  
licence

☐ Opposition

☐ Others \_\_\_\_\_ (Please state the  
specific transaction)

(tick one box only)

\* If the mark has been renewed at least once, this selection will not update the address for service on renewal matters. To update the address for service on renewal matters as well as the registered proprietor's address for service, please select "Renewal and registration".



4 Name and/or address for service to be entered/altered/substituted

Note

*The address for service must be a Singapore address.*

Agent Code  
(if applicable)

Name

Address

☐ If the address indicated above is the trade or business address of the person indicated on Part 2 of this form, please mark this box.

Signature \_\_\_\_\_

Date \_\_\_\_\_  
Day Month Year

Name  
(block letters) \_\_\_\_\_

Direct Tel No. \_\_\_\_\_

Number of extra sheets attached to this form



**SINGAPORE  
TRADE MARKS ACT  
(CHAPTER 332)  
TRADE MARKS RULES**

**FORM TM 12**

**COUNTER-STATEMENT**

*This form may take about 4-8 minutes to complete.*

General instructions

- a. If there is not enough space to fill in any part of this form, please use separate sheets.
- b. Please use one form for every Form TM 11 (Notice of Opposition) received.
- c. If the counter-statement relates to an international registration designating Singapore or a protected international trade mark (Singapore), the international registration number must be given, in addition to the trade mark number and class number.
- d. The fee for this form is payable on a per class basis.
- e. Please note that any fee paid is not refundable.

|   |   |   |  |  |  |  |  |  |  |  |  |  |
|---|---|---|--|--|--|--|--|--|--|--|--|--|
| 1 | Trade Mark Number   | <input type="text"/>  |  |  |  |  |  |  |  |  |  |  |
|   | International Registration Number                         | <input type="text"/>  |  |  |  |  |  |  |  |  |  |  |
|   | Class number(s) this counter-statement relates to         | <table border="1"><tr><td></td><td></td><td></td><td></td><td></td><td></td><td></td><td></td><td></td><td></td></tr></table> |  |  |  |  |  |  |  |  |  |  |
|   |   |   |  |  |  |  |  |  |  |  |  |  |
|   | Total number of classes this counter-statement relates to | <input type="text"/>  |  |  |  |  |  |  |  |  |  |  |

2 Particulars of registered proprietor/applicant for registration/holder of international registration\*

Company Code  
(if applicable)

Name

Address

Citizenship or  
Country of  
incorporation/  
constitution

State of  
incorporation  
(for U.S.A. corporations)

*\* delete where appropriate*

Sole Proprietor or  
Partners' name(s)  
(if sole  
proprietorship  
or partnership)

|  |
|--|
|  |
|--|

3 On a separate sheet of paper provide the following information:

- (a) details of the grounds upon which the applicant/holder/registered proprietor\* of the trade mark relies to support the application/international registration designating Singapore/registration/protection of the protected international trade mark (Singapore)/amendment/alteration\*
- (b) details of any allegations in the notice of opposition/application for revocation/declaration of invalidity/rectification\* that the applicant/holder/registered proprietor\* is admitting

Signature \_\_\_\_\_

Date \_\_\_\_\_  
Day Month Year

Name  
(block letters) \_\_\_\_\_

Direct Tel No. \_\_\_\_\_

Number of extra sheets attached to this form

|  |
|--|
|  |
|--|

*\* delete where appropriate*



# PAYMENT FORM

This Form is to be completed, in duplicate, when making payments.

|  |                                    |
|--|------------------------------------|
| (1) <u>Name and Address of Payer</u><br><br><br>   | <u>For Office Use:</u><br><br><br> |
| (2) <u>Agent Code:</u> <span style="border: 1px solid black; display: inline-block; width: 200px; height: 20px; vertical-align: middle;"></span> |                                    |
| (3) <u>Payment Mode</u> (please tick):<br><input type="checkbox"/> GIRO <input type="checkbox"/> NETS/Cashcard <input type="checkbox"/> Cheques  |                                    |

| (4a) TM No.**                | TM 1 | TM 4 | TM 19 | TM 26 | TM 27<br>A / B | (5) Other Fees<br><small>Indicate form number &amp; amount.</small> | (6) Total Fees |
|------------------------------|------|------|-------|-------|----------------|---|----------------|
|                              |      |      |       |       |                |   |                |
|                              |      |      |       |       |                |   |                |
|                              |      |      |       |       |                |   |                |
|                              |      |      |       |       |                |   |                |
| <b>Total Amount Payable:</b> |      |      |       |       |                |   | <b>\$</b>      |

| (4b) Patent No.**            | PF 01 | PF 14 | PF 23 | PF 37 | PF 41 | (5) Other Fees<br><small>Indicate form number &amp; amount.</small> |           |
|------------------------------|-------|-------|-------|-------|-------|---|-----------|
|                              |       |       |       |       |       |   |           |
|                              |       |       |       |       |       |   |           |
|                              |       |       |       |       |       |   |           |
|                              |       |       |       |       |       |   |           |
| <b>Total Amount Payable:</b> |       |       |       |       |       |   | <b>\$</b> |

| (4c) Design No.**            | D01 | D02 | D03 | D07 | D08 | (5) Other Fees<br><small>Indicate form number &amp; amount.</small> |           |
|------------------------------|-----|-----|-----|-----|-----|---|-----------|
|                              |     |     |     |     |     |   |           |
|                              |     |     |     |     |     |   |           |
|                              |     |     |     |     |     |   |           |
|                              |     |     |     |     |     |   |           |
| <b>Total Amount Payable:</b> |     |     |     |     |     |   | <b>\$</b> |

**\*\*Separate Payment Form (TM81)** is required for payment of different registrable IP. This is not a receipt.

**Intellectual Property Office of Singapore**

51 Bras Basah Road #04-01, Plaza By The Park Singapore 189554

Tel: (65) 63398616 Fax: (65) 63390252 <http://www.ipos.gov.sg>

TM81

Note

1) Payment hours:

Monday to Friday: 8.30am - 5.00pm

2) Fill in the Payer's name & address

3) Indicate the payment mode:

- If payment mode is by cheque, the cheque has to be made payable to:

**"Intellectual Property Office of Singapore"**

- If payment mode is by GIRO, please indicate your Agent Code

4) Fill in the Trade Mark, Patent or Design Number. For new application, this column should be left blank.

5) Please submit separate Payment Form (TM81) for payment of different registrable IP.