

IN THE MATTER OF TRADE MARK APPLICATION NO T05/25129D

IN THE NAME OF

PT PERUSAHAAN DAGANG DAN INDUSTRI TRESNO

AND

OPPOSITION THERETO BY

PHILIP MORRIS PRODUCTS S.A.

Before Principal Assistant Registrar Sandy Widjaja

28 April 2010

Trade Marks – *Opposition to registration – Likelihood of confusion - whether the Application Mark 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 - Section 8(2)(b) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(7)(a) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known in Singapore – whether the use of the Application Mark will indicate a connection between the Applicant’s goods or services and the proprietor of the earlier trade mark – whether the use of the Application Mark is likely to damage the interests of the proprietor of the earlier trade mark - Section 8(4)(b)(i) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known to the public at large in Singapore – whether the use of the Application Mark will dilute in an unfair manner the distinctive character of the earlier trade mark – Section 8(4)(b)(ii)(A) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known to the public at large in Singapore – whether the use of*

the Application Mark will take unfair advantage of the distinctive character of the earlier trade mark – Section 8(4)(b)(ii)(B) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

This is an opposition against the Trade Mark Number T0525129D (the application is for a series of 2 marks) as shown below:-



for the following specification in Class 34 “ *Tobacco, cigarettes, matches and smoker's articles.*” (“Application Mark”).

The Applicants, PT. Perusahaan Dagang Dan Industri Tresno (“Applicants”) filed the application for registration on 8 December 2005. The mark was accepted for registration and was published in the Trade Marks Journal on 15 September 2006.

The Applicants are based in Indonesia. Their primary area of focus is the manufacture and marketing of cigarettes throughout the Asian region. The Applicants are the registered proprietors of marks identical to the Application Mark in Class 34 in Indonesia, Taiwan, Thailand, Cambodia, Myanmar and Vietnam.

The Opponents are Philip Morris Products S.A. (“Opponents”) and are the registered proprietors of various trade marks in Class 34 in Singapore:

REGN NO.	TRADE MARK	APPLICATION DATE	CLASS	GOODS
T58/24245A		11 Dec 1958	34	Cigarettes

REGN NO.	TRADE MARK	APPLICATION DATE	CLASS	GOODS
T81/02018D		8 May 1981	34	Cigarettes
T92/03844F		23 May 1992	34	Tobacco Products; all included in Class 34

(collectively, “**the Opponents’ Marks**”).

It is the Opponents’ evidence that they and their related companies (“Philip Morris”) for many years have been engaged in the manufacture, sale and distribution of cigarettes throughout the world. Philip Morris manufacture and sell cigarettes and tobacco products for the global market under various brands. It is also the Opponents’ evidence that MARLBORO cigarettes have been made and sold by Philip Morris (and their predecessors) since 1924. Philip Morris introduced the MARLBORO cigarettes brand bearing the distinctive roof device trade mark in the United States in 1955. The world wide commercialization of MARLBORO cigarettes brand bearing the roof device expanded and has been used and continues to be used worldwide by the Opponents, their affiliates and / or their licensees in over 160 countries.

The Opponents proceeded on Sections 8(2)(b), 8(7)(a), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B) and 7(6).

Held, allowing the application mark to proceed to registration:

1. Under the ground of opposition under Section 8(2)(b), in making a comparison between marks, in particular, in relation to composite marks, it is important to compare them as wholes. Visually the Application Mark is different from the Opponents’ Marks. First and foremost it is noted that the “roof device” is a term which is coined by the Opponents to describe the darker coloured portion in each of the marks comprising the Opponents’ Marks. The “roof device” in the

Application Mark is different from the “roof device” in the Opponents’ Marks. The “roof device” in the Application Mark is at the side rather than at the top of the Application Mark. Further, the “roof device” in the Application Mark is not symmetrical, unlike the Opponents’ “roof device”. Even if the “roof device” in both the Application Mark and the Opponents’ Marks are similar, there is still a need to look into the other components of both marks. The word elements in both the Application Mark and the Opponents’ Marks take up the other 50% of the marks and it is clear from the above that the two words are different. In the Application Mark, the (main) word is COUNTRY and the in the Opponents’ Marks, the words are MARLBORO / MARLBORO LIGHTS / MARLBORO MEDIUM respectively. In conclusion, the marks are visually different. It is also clear that the marks are aurally different. Conceptually, the case of *La Societe* can be distinguished from the instance case in that the device in *La Societe* is a commonly known / understood device of a tiger. Whether the front view or side view of a tiger is portrayed, the public can easily recognize that it is a depiction of a tiger. In contrast, the “roof device” is a term coined by the Opponents in this instance to describe the darker coloured portion in the Opponents’ Marks. It is not a commonly understood device. Thus it is difficult to draw the connection between the “roof device” in the Application Mark and the “roof device” in the Opponents’ Marks. It is clear that the words in the respective marks do not conjure the same ideas, if any. Thus the marks are not conceptually similar.

With respect to the goods, except for “matches”, the Applicants’ goods can be said to be identical / similar to the Opponents’ goods.

With regards to the likelihood of confusion, the mechanism of the sale in this instance is peculiar in that due to statutory restrictions, the average consumer in this instance cannot pick a pack of cigarettes off the shelf but must approach a counter staff for assistance. This is when the word MARLBORO as displayed on the Opponents’ goods comes into play since the consumer would have to tell the counter staff which brand of tobacco products he would like to purchase. Alternatively, a consumer will have to point and verbally request for a particular brand of tobacco products. In either case, it is the word MARLBORO which is pertinent. It has been concluded earlier that both visually and aurally, it is the word MARLBORO which stands out. Further based on the evidence tendered, it is the MARLBORO brand (and not the Opponents’ Marks) which has long usage and wide exposure in Singapore. Thus consumers recognize the Opponents goods as those which encompass the word MARLBORO and as such they would, in trying to purchase the Opponents’ goods, look out and ask for, the MARLBORO brand.

Thus the ground of opposition under Section 8(2)(b) is not made out.

2. For the ground of opposition under Section 8(7)(a), while the Opponents do have goodwill in their MARLBORO brand within the relevant sector of the public in Singapore, for the same reasons under the element of “likelihood of confusion”

- under 8(2)(b), the element of misrepresentation is not made out. Thus the ground of opposition under Section 8(7)(a) is not made out as well.
3. Under the ground of opposition under Section 8(4), the whole or an essential part of the Application Mark not is identical with or similar to the Opponents' Marks for the same reasons that the marks are not considered to be similar under Section 8(2)(b). Thus this ground of opposition is not made out.
 4. In relation to the ground of opposition under Section 7(6), there is no copying on the part of the Applicants as the Application Mark is different from the Opponents' Marks. The same response applies to the Opponents' arguments that the Applicants' decision to re-file despite their knowledge of the Opponents' Marks is indicative that the Applicants have not acted in a *bona fide* manner. Finally in relation to the Opponents' arguments that the Applicants have no intention to use the Application Mark in Singapore or to use it in the manner as filed, the fact is that the law gives the Applicants up to 5 years from the date of completion of the registration procedure to commence use of the mark and thus non-use at this point in time does not point to bad faith.

Provisions of legislation discussed:

Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 8(2)(b), 8(7)(a), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B) and 7(6).

Cases referred to:

The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR(R) 690
Pianotist Co Ltd's Application (1906) 23 RPC 774
Mrs Agnes Trouble v Crocodile International Pte Ltd [2005] SGIPOS 12
De Cordova v Vick (1951) 68 RPC 103
Harker Stagg Ltd.'s Trade Mark [1953] RPC 205
La Societe Des Brasseries et Glacieres Internationales v Asia Pacific Breweries Ltd [2006] SGIPOS 5
Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
MediaCorp News Pte Ltd v Astro All Asia Networks plc [2009] 4 SLR (R) 496
City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2009] SGCA 53
Nation Fittings (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR(R) 712
Novelty Pte Ltd v Amanresorts Ltd and another [2009] SGCA 13
Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 2 SLR (R) 541
Spalding (AG) & Bros v A W Gamage Ltd (1915) 32 RPC 273
Mobil Petroleum Company, Inc v Hyundai Mobis [2009] SGCA 38
Harrods Ltd v Harrodian School Ltd [1996] RPC 697
Sega Corporation v Segafredo Zanetti S.P.A. [2006] SGIPOS 3
CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975

Neutrogena Corporation v Golden Limited [1996] RPC 473
Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
Harrison v Teton Valley Trading Co Ltd [2004] 1 WLR 2577
Rothmans of Pall Mall Ltd v Maycolson International Ltd [2006] 2 SLR 551
PT Swakarya Indah Busana v Dhan International Exim Pte Ltd [2009] SGHC 280
Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth [2009] ETMR 56
Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR (R) 1073
Kundry SA's Application: Opposition by the President and Fellows of Harvard College [1998] ETMR 178
Ferrero SpA's Trade Marks [2004] RPC 29
Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal [2009] 2 SLR(R) 814
Societe des Produit Nescafe SA v Master Beverage Industries Pte Ltd [2009] SGIPOS 5
McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177

Representation:

Ms. Gwendolene Lee and Ms Lim Hui Nan (Amica Law LLC) for the Opponents
The Applicants were not present at the hearing