In The Matter Of Application No. 63827
By Playboy Pte Ltd
To Register A Trade Mark In Class 18

And

In The Matter Of Opposition Thereto
By Playboy Enterprises Inc.

Before Assistant Registrar P Arul Selvamalar
27 November, 3 and 4 December 1998

Trade Mark - Application for registration - Opposition - likelihood of deception or confusion - Allegation of passing-off - Application allowed

Playboy Pte Ltd applied for registration of a trade mark comprising a device and the word "Playboy" in Class 18.

The application was opposed by Playboy Enterprises Inc. who have been using the mark comprising a bunny head and the word "Playboy". The opponents claimed use of the mark worldwide since 1953 on a variety of business, namely magazine publications, running clubs, hotels and casinos. They are also registered proprietors of the mark "Playboy" in Class 3 for perfumes, cosmetics and soaps since 1965 and in Class 10 for prophylactic appliances (condoms) since 1972. The opposition was made pursuant to sections 15 and 10 of the Trade Marks Act.

Subsequent to the application, the opponent made their application for registration of their mark comprising a bunny head device only in Class 18 for leather goods.

Held, allowing registration:

- Use of the mark by the opponents within jurisdiction is required in an action under section 15. Even if there need not be use in Singapore, there is no evidence that the name "playboy" had become so famous in Singapore in 1975, by access to or dissemination of information or international travel, that it would cause confusion and deception to a substantial number of persons if the applicants' mark was registered.

- As the opponents had not been selling magazines in Singapore for 16 years before the applicants' application, any reputation the opponents may have enjoyed had perished after 16 years. Any notoriety would also have perished for non-use after that period. There is no evidence from the opponents to substantiate claim of sales of consumer goods in Singapore before 1975.

- There is no evidence of any connection in the course of trade between the opponents' goods and the applicants' goods. The fact that the applicants have been using their mark for 5 years preceding their application for registration was taken into consideration.

- The marks as a whole are not confusingly similar and the registration of the applicants' mark would not cause confusion or deception amongst a substantial number of persons.

- So long as a mark for which registration is applied for satisfies the conditions of section 10, it qualifies for registration. The prior registrations of the opponents, their use and reputation have no place in a section 10 consideration.

- Passing-off is a separate and distinct action and should not be considered in opposition proceedings.

Note:
At the time of hearing, the case of Tiffany & Company v. Fabriques de Tabac Beunies S.A. & Registrar of Trade Marks, Singapore was pending appeal to the Court of Appeal vide Civil Appeal No. 317 of 1998.

Provisions of legislation discussed:

- Trade Marks Act, sections 10, 12 and 15

Cases referred to:

- Smith Hayden & Co's Appln (1946) 63 RPC 97
- Bali Trade Mark [1969] RPC 472
- Macy's Trade Mark [1989] RPC 546
- Star Industrial Co Ltd v. Yap Kwee Har [1976] FSR 256
- J C Penney Co Inc v. Punjabi Nick [1979] FSR 26
- RH Macy v. Trade Accents [1992] 1 SLR 592C
- Tiffany & Company v. Fabriques de Tabac Beunies S.A. & Registrar of Trade Marks, Singapore (Originating otion No. 42 of 1997, High Court, Singapore)
- Re Jellinek's Application (1946) 63 RPC 59
- Pianotist Co.'s Application [1906] 23 RPC 774
- Solex Industries v. Montres Rolex [1995] AIPR 307
- Florence Line SRL v. Advance Magazine Publishers Inc. [1995] AIPR 642
- Players Trade Mark [1965] RPC 363
- Golden Jet [1979] RPC 19
- Lego Systems Aktieselskab v. Lego M. Lemelstrich Ltd [1983] FSR 155
- Samsonite Corp v. Montres Rolex [1995] AIPR 269

Representation:

- Messrs. Allen & Gledhill for the applicants;
- Messrs. Donaldson & Burkinshaw for the opponents