

**In The Matter Of Application No. 1188/93
By Pentax S.R.L.
To Register A Trade Mark In Class 7**

And

**In The Matter Of Opposition Thereto
By Asahi Kogaku Kogku K. K.
(Asahi Optical Co. Ltd)**

*Before Assistant Registrar Toh Hwee Lian
11 and 15 February 1999*

Trade Mark - Application for registration - Opposition by registered proprietor of similar trade mark - "goods of the same description" - likelihood of deception or confusion - Application allowed

Pentax S.R.L., an Italian corporation, applied for registration of a trade mark comprising the word "Pentax" and a device in Class 7 for centrifugal and hydraulic pumps (machines).

The application was opposed by Asahi Kogaku Kogku K. K. (Asahi Optical Co. Ltd), a Japanese corporation, who are the registered proprietors of the marks "PENTAX" in Class 9 in respect of "photographic, cinematographic, surveying, measuring, electrical, electronic, scientific and optical apparatus and instruments; parts, fittings and cases, all included in Class 9 for all the aforesaid goods; but not including switching apparatus or instruments", and in Class 10 in respect of "medical apparatus and instruments and their parts and fittings thereof, artificial bones and teeth". They are also registered proprietors of the mark "SMC PENTAX" in Class 9. The opposition was made pursuant to sections 15, 23, 10 and 12 of the Trade Marks Act (Cap. 332, 1992 Revised Edition).

The opponents claimed use of their marks on goods, in particular camera lenses, optical devices, video apparatus, and medical apparatus. In their evidence, the opponents sought to rely on the fact that their medical instruments such as endoscopes, video scopes and video processors incorporate air pumps.

Held, allowing registration:

- The transitional provision in paragraph 10 of the Third Schedule to the new Trade Marks Act 1998 requires this application to be dealt with under the old law, viz. the Trade Marks Act (Cap. 332, 1992 Revised Edition).
- The classification of goods, although not determinant, is a good guide as to whether the goods are "of the same description".
- Centrifugal pumps and hydraulic pumps are essentially different from air pumps (as incorporated in medical instruments). They are not "goods of the same description". They reach the public by different routes and cannot be said to belong to the same trade channel. The potential purchasers of the applicants' tools are technical people and it is likely that they will deliberate before buying the goods.
- Re Jellinek's Application (1946) 63 RPC 59, "Floradix" Trade Mark [1974] RPC 583 and Invicta Trade Mark [1992] RPC 541 applied.
- There will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if the applicants also use their mark normally and fairly in respect of any goods covered by their proposed registration.
- Smith Hayden (1946) 63 RPC 97 at p. 101, Pianotist Co.'s Application [1906] 23 RPC 774 applied.
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- The goods on which the opponents have used their marks are not of the same description as that of the applicants. The applicants' goods are industrial machinery and tools sold in a specialised market. There is no close association between the applicants' good and the opponents' goods and there is no evidence of confusion. The use of the mark by the applicants is not likely to cause confusion and deception, or cause the public to be confused thinking that the opponents have diversified into other goods.

- Re An Application by Smith Hayden & Co (1946) RPC 97 at p. 101, Bali Trade Mark [1969] RPC 472 at p. 496-7 applied. LANCER Trade Mark [1987] RPC 303 at p. 316, "G.E." [1973] RPC 297 at 321-2 and "Solavoid" Trade Mark [1977] RPC 1 at p. 29 considered. Re Jaguar Trade Mark [1993] 2 SLR 466, Lego Systems Aktieselskab v. Lego M. Lemelstrich Ltd [1983] FSR 155 distinguished.
- The applicable provisions to these proceedings do not include the provisions of the new Trade Marks Act 1998 relating to well-known marks, and the argument that, in view of the new legislation, this mark should as a matter of policy be protected taking into consideration the new legislation cannot succeed.

Note:

The case of Tiffany & Company v. Fabriques de Tabac Beunies S.A. & Registrar of Trade Marks, Singapore went on appeal to the Court of Appeal vide Civil Appeal No. 317 of 1998. At the date of this decision, the case has been heard and judgment was reserved.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332), 1992 Revised Edition, sections 10, 12, 15, 23, 41 and 45
- Trade Marks Act 1998, section 8(3), Third Schedule

Cases referred to:

- Smith Hayden (1946) 63 RPC 97
- Pianotist Co.'s Application [1906] 23 RPC 774
- Re Jellinek's Application (1946) 63 RPC 59
- "Floradix" Trade Mark [1974] RPC 538
- Invicta Trade Marks [1992] RPC 541
- Bali Trade Mark [1969] RPC 472
- LANCER Trade Mark [1987] RPC 303
- Southern Cross v. Toowomba Foundry [1954] 91 CLR 592
- "G.E." [1973] RPC 297
- H.J. Lees & Sons (London) Ltd's Application for a Trade Mark (1955) 72 RPC 75
- Players Trade Mark [1965] RPC 363
- Hack's Application [1941] 58 RPC 91
- Eastman v. Griffiths [1898] 15 RPC 105
- Golden Jet [1979] RPC 19
- "Solavoid" Trade Mark [1977] RPC 1
- Re An Application by C.A. Sheimer (M) Sdn Bhd ("VISA Case") (Opposition to TM No. 3319/84, Registry of Trade Marks, Singapore)
- Re Jaguar Trade Mark [1993] 2 SLR 466
- Lego Systems Aktieselskab v. Lego M. Lemelstrich Ltd [1983] FSR 155
- Radio Corporation Pty Ltd v. Disney & Ors (1937) 57 CLR 488
- Tiffany & Company v. Fabriques de Tabac Beunies S.A. & Registrar of Trade Marks, Singapore (Originating Motion No. 42 of 1997, High Court, Singapore)

Representation:

- Arifin Vasanwala and Max Ng (Messrs. Rodyk & Davidson) for the applicants;
- Jo-Ann See and Corrine Tan with Carolyn Siau, pupil (Messrs. Allen & Gledhill) for the opponents.