

**In The Matter Of Application No. 1712/87
By Marhani Bte Abd. Mutalib Trading As Saudiapetrol
To Register A Trade Mark In Class 16**

And

Opposition By Esquire Associates And The Hearst Corporation

*Before Assistant Registrar Nor'Ashikin Samdin
24 March 1999*

Trade Mark - Application for registration - Opposition - Whether marks are likely to deceive or cause confusion - Whether lack of use of Applicant's mark due to the threat of Opposition is a defence to an allegation that there is no bona fide intention on Applicant's part to use the mark - Opposition allowed

The Applicant, Marhani Bte Abd. Mutalib, trading as Saudiapetrol, submitted an application under Section 11 of the Trade Marks Act, Cap. 332 1985 Edition to the Registrar of Trade Marks for registration in Part A of the Register for the Mark "**EXECUTIVE SUITE QUARTERLY, ESQ**" in respect of magazines in Class 16.

Subsequent to the advertisement of the Applicant's mark in the Trade Marks Gazette, the Opponents, Esquire Associates and the Hearst Corporation, filed their Notice of Opposition citing the contravention of Sections 10, 11, 15 and 23 of the Trade Marks Act. The Applicant was neither present nor represented at the Hearing.

Held, allowing the opposition:

- Onus is on the Applicant under section 23 to show that the marks are neither deceptive nor confusing. Degree of confusion required is a low one as the test is whether or not persons are likely to wonder if the goods were made or services provided by an opponent, the mark applied for is one which is likely to cause confusion because people's minds will be put in a state of doubt or uncertainty.
- Kerly's Law of Trade Marks & Trade Names, 12th edition; Smith Hayden & Co's Application (1946) RPC 97; Bali Trade Mark (1969) RPC 472; Edward Hack for the Registration of a Mark (1941) 58 RPC 91 referred to.
- The test under section 15 is the same as that under section 23, the only difference being that the Opponent must prove actual use of the mark or that it has acquired a reputation such that registration of the Applicant's mark is likely to cause confusion or deception.
- Court of Appeal decision in *Tiffany & Co. v Philip Morris Holland B.V* referred to.
- The key ingredient in a successful opposition under section 11 is the misappropriation of the mark by the Applicant. No evidence to support such an allegation.
- Court of Appeal decision in *Tiffany & Co. v Philip Morris Holland B.V* referred to.
- Section 10 deals with the registrability requirements of a mark for registration under part A. As long as a mark complies with any of the five limbs under section 10(1), it is prima facie registrable as each limb is independent of the other. The considerations which apply under sections 15 and 23 do not apply to section 10 as section 10 would otherwise be redundant.
- Kerly's Law of Trade Marks and Trade Names, 12th edition referred to.

Provisions of legislation discussed:

- Trade Marks Act, (Cap. 332), 1985 Revised Edition, sections 10, 11, 15 and 23

Cases referred to:

- Pianotist Co's Application (1906) 23 RPC 774

- Smith Hayden & Co's application (1946) RPC 97
- Bali Trade Mark (1969) RPC 472
- Rysta Ltd's Application (1943) 60 RPC 87
- Edward Hack for the registration of a mark (1941) 58 RPC 91
- Tiffany & Co v Philip Morris Holland B.V
- Rose Garden Tree Mark (1955) RPC 246

Representation:

- Applicant not present or represented at hearing;
- Steven Seah (Messrs. Drew & Napier) for the opponents.