

**In The Matter Of Application No. 5495/90
In The Name Of Coway Investment Ltd.
To Register A Trade Mark In Class 14**

And

**In The Matter Of Opposition Thereto
By Kabushiki Kaisha Hattori Seiko
(Hattori Seiko Co. Ltd.)**

*Before Assistant Registrar Toh Hwee Lian
28 July 1999*

Trade Mark- Application for registration - Opposition by registered proprietor of similar trade mark - whether the marks nearly resemble each other - likelihood of deception or confusion - Application allowed

Coway Investments Ltd, a Hong Kong corporation, applied for registration of a trade mark "ALBINA" in Class 14 in respect of watches, watch bands, watch chains, watch straps and clocks; parts and fittings thereof.

The application was opposed by Kabushiki Kaisha Hattori Seiko (Hattori Seiko Co. Ltd.), a Japanese corporation, who are the registered proprietors of the trade mark "ALBA" in Class 14. The opposition was made pursuant to sections 15, 23, 10 and 12 of the Trade Marks Act (Cap. 332), 1985 Revised Edition.

The opponents claimed use of their mark on watches since 1979 and adduced evidence of the sale of watches bearing the "ALBA" trade mark as well as advertisements in Singapore.

The applicants claimed that the word "ALBINA" was derived from three Indonesian words and adduced evidence of registration of the mark "ALBINA" in Class 14 in the United Kingdom.

In response, the opponents stated that the trade mark they registered in the United Kingdom was "ALBLBA" and not "ALBA".

Held, allowing registration:

- The issue turns primarily on whether the marks nearly resemble each other. Under section 2(4), the resemblance must be "so near as to be likely to deceive or cause confusion".
- The two marks are aurally different. "ALBINA" has three syllables while "ALBA" has two, and the two are very different phonetically.
- "AL" is a common prefix. Furthermore, "ALBA" is a very short word while "ALBINA" is significantly longer. Hence confusion and deception is not likely to occur among people faced with either of the marks.
- To decide that there is similarity between the two marks would effectively preclude others from using either "AL" or "ALB" in the marks they wish to register. This would result in giving the opponents an undesirable monopoly over a large class of words.
- Relevant matters to be considered include whether the goods are expensive and thus usually deliberately selected, the course of business and the way in which the goods are usually sold as well as the way in which the goods are packaged and displayed. Considering the circumstances under which goods in Class 14 are usually selected and purchased, there is no resemblance of the marks in question such that it is likely to deceive or cause confusion. The objection under section 23 fails.
- Pianotist Co.'s Application [1906] 23 RPC 774, Australian Woollen Mills Ltd. V. F. S. Walton & Co. Ltd (1937) 58 CLR 641, Deeko Australia Pty. Ltd. V. Décor Corp. Pty. Ltd. (1988) AIPC 90 applied. General Foods Corporation v. Tchibo Frisch-Rose-Kaffee AG (1992) 25 IPR 417 distinguished.
- Comparing the two marks in question as a whole, there is insufficient similarity to confuse or deceive.
- La Francaise D'Horlogerie v. Kremetz & Co. [1993] AIPR 512 distinguished.
- Although the marks in question would be used on small objects, there is still substantial dissimilarity to preclude confusion or deception.
- Kremetz & Co. v. LA Francaise D'Horlogerie (1992) 25 IPR 663 distinguished.
- Under section 15, the objection would be successful if there would be a reasonable likelihood of deception and confusion caused by the normal and fair use by the applicant of their mark, bearing in mind the reputation acquired by the opponent's mark.

- Smith Hayden (1946) 63 RPC 97 at p. 101 applied.
- In considering the probability of deception, all surrounding circumstances have to be taken into consideration.
- Southern Cross v. Toowomba Foundry [1954] 91 CLR at p.595
- On the facts, no one looking at watches bearing the mark of "ALBINA" would be confused or misled into thinking it originated from the same source as "ALBA" watches. Hence registration of the applicant's mark would not be likely to cause deception or confusion under section 15. Furthermore, it is unlikely that the objection will successfully disentitle the applicant's mark to protection in a court of justice.
- The applicants have consistently explained that the word "ALBINA" was derived from three Indonesian words meaning watches made in Indonesia. There is also no evidence that the applicants misappropriated or copied the opponents' mark.
- Re An Application by Brown Shoe Company Inc. [1959] RPC 29 distinguished.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332), 1985 Revised Edition, sections 2(4) 10, 12, 15 and 23.
- Trade Marks Act 1998 paragraph 10 of Third Schedule.

Cases referred to:

- Smith Hayden (1946) 63 RPC 97
- Pianotist Co.'s Application [1906] 23 RPC 774
- Hennesy & Co. v. Keating (1908) 25 RPC 361
- Prichard and Constance (Wholesale) Ltd. V. Amata Ltd. (1925) 42 RPC 63
- Australian Woollen Mills Ltd. V. F. S. Walton & Co. Ltd (1937) 58 CLR 641
- Deeko Australia Pty. Ltd. V. Décor Corp. Pty. Ltd. (1988) AIPC 90
- La Francaise D'Horlogerie v. Krementz & Co. [1993] AIPR 512
- General Foods Corporation v. Tchibo Frisch-Rose-Kaffee AG (1992) 25 IPR 417
- Krementz & Co. v. LA Francaise D'Horlogerie (1992) 25 IPR 663
- Waide (1946) 33 RPC 320
- Bali Trade Mark [1969] RPC 472
- LANCER Trade Mark [1987] RPC 303
- In the matter of an Application by Edward Hack for the Registration of a Trade Mark [1940] RPC 91
- Southern Cross v. Toowomba Foundry [1954] 91 CLR 595
- Dundas ("Duatic") (1955) 72 RPC 151
- Re An Application by Brown Shoe Company Inc. [1959] RPC 29

Representation:

- Patrick Yap (Messrs. K. L. Tan & Associates) for the Applicants
- Gillian Woon (Messrs. Drew & Napier) for the Opponents