

**In The Matter Of Application No. 6551/90
By New Olympian Rubber Products Co. Inc**

And

**In The Matter Of An Opposition Thereto
By Converse Inc.**

Before Senior Assistant Registrar Nor' Ashikin Samdin

Trade Mark - Application for registration - Opposition by registered proprietor of similar trade mark in different class - Whether the marks nearly resemble each other - likelihood of deception or confusion - Whether the goods are of the same description - Application disallowed

Tai Kwong Battery Industries Sdn Bhd (the Applicants) applied for registration of a trade mark "KOMASU" in Class 9 in respect of electrical cells, batteries and accumulators. The application was advertised in the Gazette on 23 December 1994.

New Olympian Rubber Products Co. (the Applicants) applied for registration of a composite mark comprising a device of a star and the words "US MASTER HARLEM STAR" within two concentric circles in Class 25 in respect of footwear, being articles of clothing; boots, shoes and slippers; T-shirts, jackets and jeans. The application was advertised in the Gazette on 16 June 1995.

The Opponents, a US company were the registered proprietors of inter alia, the composite mark comprising the device of a star within two concentric circles and the words "CONVERSE ALL STAR Chuck Taylor" in Class 25 in respect of footwear, being mainly canvas shoes with an ankle patch bearing the Opponents' trade mark. The Opponents' claimed to have sold the such shoes for more than 78 years. As such, its trade mark has become distinctive of its goods and has acquired a high level of goodwill and reputation. The Opponents contend that as the application mark closely resembles its own trade mark and is used on the same type of goods, use and registration of the application mark would give rise to confusion and deception and therefore be contrary to sections 15 and 23 of the Trade Marks Act (Cap. 332) 1992 Edn (hereinafter called the Act). The Opponents further contend that in view of the long and extensive use by the Opponents of its trade mark and the reputation and goodwill it has acquired through such long use, the Applicant cannot claim to be the bona fide proprietor of the application since it closely resembles the Opponents' well – known mark and therefore registration of the same would be contrary to section 12 of the Act. The Opponents also contend that the application mark is not distinctive nor capable of distinguishing the goods of the Applicants and registration therefore would be contrary to section 11 of the Act.

Held, allowing registration:

- The objection under section 23 fails as the words appearing in both marks, being substantially different, are sufficient to distinguish one mark from the other. Further, given that "words speak" in a composite mark, the Opponents' mark would clearly be known as the "CONVERSE" mark whilst the Applicants' mark would be known as the "US MASTER" mark, thus eliminating any likelihood of confusion or deception.
- As the two marks have been found not to be nearly resembling under section 23 and given the insubstantial use of the Opponents' mark in Singapore, there is no real tangible danger of confusion or deception arising if the two marks are used in a normal and fair manner in the course of trade. The objection under section 15 accordingly fails.
- As the Opponents had insufficient evidence to prove that the Applicants had misappropriated its mark, the objection under section 12, fails.
- Any mark which is either inherently capable of distinguishing, or in fact, capable of distinguishing by virtue of use, is registrable under section 11 of the Act. The considerations which apply under section 15 or 23 do not apply to section 11 as Parliament could not have intended section 11 to be redundant.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Revised Edition), sections 11, 12, 15 and 23.

Cases referred to:

- Smith Hayden & Co. Ltd's Application [1946] 63 RPC 97
- Pianotist Co.'s Application [1906] 23 RPC 774
- Bali Trade Mark [1969] RPC 472
- Tiffany & Co v Fabriques de Tabac Reunies SA (1999, unreported)

Representation:

- Ms Teresa O' Connor (M/s Chu Chan Gan & Ooi) for the Applicants
- Mr Lim Teng Leong (M/s Donaldson & Burkinshaw) for the Opponents