

**In The Matter Of Application No. 1053/96
By P.T. Permona
To Register A Trade Mark in Class 34**

And

**In The Matter Of Opposition Thereto
By Shanghai Tobacco Group And The China Tobacco Import And Export Shanghai Corporation**

*Before Principal Assistant Registrar Lee Li Choon
05 June 2001*

Trade Mark - Application for registration - Opposition - Registration under Section 10 - Relevance of prior use - Likelihood of confusion or deception - claim of proprietorship - non-registrability of trade mark - geographical signification - Application refused

The Applicant, P.T. Permona submitted an application on 29 January 1996 for registration in Part A of the Register for "CHUNG HWA" in Class 34 in respect of "cigarettes and tobacco products; all included in Class 34". The Opponent, Shanghai Tobacco Group and The China Tobacco Import and Export Shanghai Corporation lodged an opposition on 26 June 1998. The Opponent's evidence is that it is the manufacturer of tobacco products bearing the mark which comprises the word, "CHUNGHWA", a pagoda device and the Chinese characters. The Opponent has been manufacturing its "CHUNGHWA" brand of cigarettes in China since 1989. Since 1994, the Opponent has been selling its "CHUNGHWA" brand of cigarettes through Paradise Trading Pte Ltd in the Duty Free Shop at Changi Airport. Since 1994, the Opponent has sold more than \$7m worth of cigarettes to the Duty Free Shop, Changi Airport.

The grounds of opposition were:

- Registration of the Applicant's mark would be contrary to Section 12 of the Trade Marks Act as the Applicant is not the bona fide proprietor of the mark, "CHUNG HWA".
- Registration of the Applicant's mark would be contrary to Section 15 of the Trade Marks Act as it will give rise to confusion and deception or a likelihood thereof.
- Registration of the Applicant's mark would be contrary to Section 10(1)(d) of the Trade Marks Act in view of its geographical indication.

Held, refusing the registration:

In view of the fact that there is no evidence that the Opponent has a prior claim to "CHUNGHWA" and that the Applicant has misappropriated or copied the Opponent's mark, the opposition on the ground of Section 12 of the Trade Marks Act cannot stand. The principles enunciated in *Tiffany & Co v Fabriques de Tabac* [1999] 3 SLR 147 were applied.

As the two marks are confusingly similar and a portion of the public might be led to wonder if the Applicant's goods originate from the same source as the Opponent's goods, registration of the Applicant's mark would be contrary to Section 15 of the Trade Marks Act. In view of this, the opposition on the ground of Section 15 is allowed.

There is no basis for saying that "CHUNG HWA" has geographical signification since it is in Romanised form and its phonetic equivalent in Chinese can mean a number of things other than. On the whole, opposition is allowed and costs was awarded against the Applicant. The Applicant's application T96/1053 was accordingly refused.

Provisions of legislation discussed:

- Trade Marks Act 1991(Cap. 332), section 10, 11, 12, 15 and 76
- Regulations 3, 4, 4A and 5 of the Smoking (Control of Advertisement and Sale of Tobacco)(Labelling)Regulations

Cases referred to:

- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Vitamins Ltd's Application [1956] RPC 1
- Application by Brown Shoe Co Inc [1959] RPC 29
- Genette TM [1968] RPC 148
- Rawhide TM [1962] RPC 133
- Al Bassam [1995] RPC 511
- Shell Co (Aust) Ltd v Rohm and Haas Co (1949) 78 CLR 601
- Pianotist Co.'s Application (1906) 23 ROC 774
- Smith Haydon's Application (1946) RPC 97
- Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd [1979] RPC 410
- Hack's Application (1941) 58 RPC 91
- Jellinek's Application (1946) 63 RPC 59

Representation:

- Faridah Eryani Pairin (Drew & Napier) for the Applicant
- Farah Namazie (Haq & Namazie) for the Opponent