

**In The Matter Of Application No. 6434/92
By Campomar S L
To Register A Trade Mark In Class 3**

And

**In The Matter Of Opposition Thereto
By Nike International Ltd**

*Before Assistant Registrar Chua Ser Ching
26 April and 4 July 2001*

Trade Mark - Application for registration - Opposition - Identical mark but different goods - Whether confusingly similar - Bona fides of application - Trade Mark Act (1992 Revised Edition) Sections 12 and 15

The Applicant applied for the registration of the word "NIKE" in respect of "bleaching preparations and substances, all for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; all included in Class 3" ("the subject goods"). The Opponent is the registered proprietor of the word "NIKE" in Classes 16, 18 and 25 in respect of goods such as bags, clothing, headwear, footwear and printed matter. The Opponent first used its mark in Singapore in 1975. It does not use its NIKE mark on the subject goods. The Applicant has not started using its mark on the subject goods in Singapore.

The Opponent argued that:

- it is the rightful proprietor for the NIKE mark in Singapore by virtue of first use.
- the Singapore public will think that subject goods bearing the mark NIKE originate from it because its NIKE mark is so well-known and it is common for well-known brands to produce cleaning substances for its goods. The Opponent also tendered survey evidence to show that its NIKE brand is well-known in Singapore.
- the Applicant's application is not bona fide. There is worldwide litigation involving both parties over the same mark. The Opponent has obtained judgements in its favour in China, Hong Kong, the UK and Sweden.

Held, allowing the opposition in part:

- The first use of a mark on one type of goods does not automatically confer proprietary rights in unrelated goods.
- The evidence is insufficient to show that the Applicant's application is not bona fide. Decisions from non-Commonwealth countries are not persuasive. The UK and Hong Kong decisions pertain to infringement actions involving the use of the mark on perfumes and toiletries, which are different from the subject goods.
- Even if the Applicant has been trying to pass off its goods as the Opponent's in other countries, the tribunal cannot assume that the mark will be used in a fair and normal manner. There are other remedies at law for trade mark infringement.
- There is no evidence that the Opponent's NIKE brand is well-known for all types of goods. The survey evidence pertains only to sport shoes. In any event, the concept of well-known marks does not apply to proceedings under the Trade Marks Act 1992 Revised Edition.
- The subject goods do not appear targeted at the same cross-section of consumers as the Opponent's goods, which are primarily of a sporting nature, hence the facts are not on all fours with Tiffany.
- If the subject goods are for purposes totally unrelated to the Opponent's goods, then it is not reasonable for a purchaser to assume that they emanate from the Opponent.
- Since confusion may arise if the subject goods for use on sport shoes or clothes, the specification is restricted to goods not for laundry use or for use on sport goods or sporting apparel.

Provisions of legislation discussed:

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

Cases referred to:

- Smith Hayden (1946) RPC 97
- Murray Goulburn (1990) 171 CLR 363

- Quiet May (1967) FSR 27
- Gaines Animal Foods (1958) RPC 312
- Dalic (1998) 2 SLR 231
- Tiffany & Co v Fabrique de Tabac Reunies SA (1999) 3 SLR 147

Representation:

- Mr Patrick Yap (M/s K L Tan & Associates) for the Applicant
- Mrs Ang Su-Lin (M/s Harry Elias Partnership) for the Opponent