

**In The Matter Of Application No. 9771/93
By The Proctor & Gamble Company
To Register A Trade Mark In Class 3**

And

**In The Matter Of Opposition Thereto
By Tohtonku (S) Pte Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar
20 December 2001*

Trade Marks - Opposition by local company to application by foreign company - mark not used by foreign company after application - local company commenced use

The Applicant applied for the registration of the word mark "Secret" for deodorants and anti perspirants in class 3. The application was accepted and advertised. Tohtonku (S) Pte Ltd opposed its registration. The Opponent had applied for registration of the word mark "Secret" with a leaf device for class 3 goods in 1996, 3 years after the applicant. The Opponent evidence was that they had used their mark in Singapore since October 1995. They argued that as the applicant had not used their mark, they should not be registered as the owners, although their application predated the Opponent application.

Held, dismissing the opposition:

- The Opponent had not started using the mark when the applicants applied for their mark in 1993. The case of Tiffany & Co v Fabriques de Tabac Reunies is not authority for the proposition that, where there is no reputation existing in the opposing mark, from before the date of the application mark, the evidence of use after the date of application may be considered to decide whether there would be confusion. Therefore the Opposition under section 15 failed.
- The Opponent argued that the applicant's non-use is fatal to their application because of the opponent prior use. However the opponent had not used their mark prior to the application in 1993. Therefore the Opposition under section 12(1) failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap 331, 1992 revised Ed) section 12(1) and 15

Cases referred to:

- Tiffany & Co v Fabriques de Tabac Reunies [1999] 3 SLR 147
- Vitamin Ltd's Application [1956] RPC
- Application for rectification by Brown Shoe Company Inc. [1959] RPC 29
- GENETTE TM [1969] RPC 189
- The Seven Up Company v O T Ltd [1947] 75 CLR 203

Representation:

- Mrs Murgiana Haq and Ms Bharti Ghaur (Haq & Selvam) for the Applicant
- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponent