

**In The Matter Of Application No. 13877/96
By Tohtonku (s) Pte Ltd
To Register A Trade Mark In Class 16**

And

**In The Matter Of Opposition Thereto
By The Proctor & Gamble Company**

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

Trade Marks - Opposition by foreign company to mark applied for by local company - marks similar but in different classes - section 12(1), 15 and section 23

The Applicants applied for the registration of the word mark Secret with a leaf device for stationery in class 16. The application was accepted and advertised. It was opposed by Proctor & Gamble Company who had been using the word Secret with a leaf device on anti perspirants and deodorants in class 3. The Opponents had applied for registration of the mark Secret for deodorants and anti perspirants in class 3 in 1993. They also have a registration in class 3 for the mark Secret Key for perfumes and cosmetics since 1981. They had been using the mark Secret with a leaf device on anti perspirants and deodorants in North and South America extensively. They did not use the mark on class 16 goods. They argued that there was an overlap between class 3 and class 16 goods as class 16 goods included cosmetic pencil sharpeners which the applicants were interested in making. They also argued that the applicants' mark was inspired by the opponents' mark and that therefore copying was made out.

Held, dismissing the opposition:

- The Opponents had no reputation in the mark Secret with leaf device in Singapore as their evidence of use was mainly from North and South America. Even if they have a reputation, their reputation extends only to deodorants and anti perspirants which are goods in class 3 and the applicants' goods are in class 16. Therefore the opposition under section 15 fails.
- The Opponents' registration for the mark Secret Key was in class 3 for perfumes and cosmetics. Although there is an overlap in the goods in class 3 and class 16, the marks are dissimilar. Therefore the opposition under section 23 fails.
- There is insufficient evidence to infer that there is copying of the opponents' mark by the applicants. For a successful opposition under section 12(1), misappropriation of the mark is necessary. Therefore the Opposition under section 12(1) fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332, 1992 Revised Ed) sections 12(1), 15 and 23

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
- Rawhide [1962] R P C 133

Representation:

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