

**In The Matter Of Application No. 5174/98
By Corporate Licensing Pty Ltd
To Register A Trade Mark In Class 30**

And

**In The Matter Of Opposition Thereto
By Raffles Hotel (1886) Limited**

*Before Principal Assistant Registrar P Arul Selvamalar
11 January to 3 February 2002*

Trade Mark Application - opposition to registration - whether application mark would cause confusion or deception - whether registrar should exercise her discretion under section 12(2) - section 12(1), 12(2), 15 and 23

Corporate Licensing Pty Ltd is an Australian Company which applied for registration of the mark "Lady Raffles" (words only) in class 30 for "confectionery, chocolates, candy, cakes, bread, pastries, biscuits, ice-cream and frozen desserts". The Opponents are Raffles Hotel (1886) Ltd and they have been using a mark, which comprises the front façade of the hotel and the words "Raffles Singapore" in an oval device in class 30. The Opponents also have a registration for the mark "Raffles Hotel" with a device of a hotel and a coat of arms and an application for the word "Raffles" alone, both in class 30. The Opponents opposed the registration of the applicants' mark on the basis that they are the owners of the mark "Raffles" in class 30 and that therefore the use of the mark "Lady Raffles" by the applicant would cause confusion or deception. The applicants argued that the Opponents used the word "Raffles" together with other devices and that the other devices sufficiently distinguished their mark from the opponents' marks, and that therefore there would be no confusion or deception.

Held, disallowing the application:

- The Opponents have been using their mark Raffles Singapore on class 30 goods since 1993. The issue in this case does not revolve around the question of whether only the Opponents can use the word "Raffles" which is a common surname. The issue is, in light of the Opponents' ownership of 3 marks containing the word Raffles, is there a likelihood of confusion or deception, if the applicants' mark is registered. The Opponents own composite marks with one common element - the word Raffles. Although the word Raffles may not be the main element in these 3 composite marks, there is a special circumstance in this case. The Opponents' Raffles Hotel is so famous in Singapore that when a member of public buys class 30 goods sold by the Opponents, they would buy them because these goods are from the Raffles Hotel. Therefore the common feature may not be the main feature in terms of size or prominence but it is the main feature because of the fame of the hotel. When the public see the mark Lady Raffles on the applicants' goods, there is a likelihood that they would think that they are connected with the Opponents' goods. Therefore there is a likelihood of confusion.
- Under section 12(2) of the Trade Marks Act, the Registrar has the discretion to disallow the registration of the mark even if it complies with section 10 or 11 and is not prohibited by section 15 and 23. The applicants approached the opponents for a licensing program in 1995 and when rejected, applied for the mark Lady Raffles in various classes. The applicants created a mark, which comprised of the same surname that the opponents had been using, for the same classes that the opponents had started merchandising in. It did not appear that the applicants wanted to make their mark so distinct from the opponents' marks, so that no connection could be made between the opponents' marks and the applicants' mark. Therefore the Registrar exercised her discretion under section 12(2) to reject the application.
- The opposition under section 23 failed because the Opponent have 2 prior registered marks whereas for a consideration of a family of marks at least 3 marks should be registered. The opposition under section 10 also failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332, 1992 revised Ed) section 12,15 and 23

Cases referred to:

- Eno v Dunn [1890] HL 252
- Bali TM [1969] RPC 472
- Southern Cross Refrigerating Company [1953] 91 CLR 592
- National Dairies Ltd v Xie Chun Trading Pte Ltd [1998] 1 SLR 620
- An application by Smith Hayden & Co [1946] RPC 97
- Hacks Application [1941] 58 RPC 91
- An application by Pianotist Company [1906] RPC 774
- Beck Koller 64 RPC 76
- Australian Woollen mills [1937] 58 CLR 641
- re Application by Harding Manufactures Pty Ltd (1987) 8 IPR 147
- Perfumes of Singapore v Raffles Hotel [1993] AIPR 278

Representation:

- Mr Donald Vivien Roach director of the Applicants in person
- Ms Winnie Tham and Mr Louis Chan (Allen & Gledhill) for the Opponent