

**In The Matter Of A Trade Mark Application No. 15413/97
By Cocon Food Industries Sdn Bhd**

And

**Objection Thereto By
Conoco, Inc.**

*Before Principal Assistant Registrar P Arul Selvamalar
30 April 2003*

Trade Mark Application– Opposition – whether Opponents had international reputation - whether reputation extends to Singapore – whether the marks were confusingly similar - Trade Marks Act (Cap. 332, 1992 Ed) section 12 and 15

Procedure - Opponents required to state all grounds in Notice of Opposition - Opponents required to state details of mark in Notice of Opposition - Trade Mark Rules 1998, rule 30

Facts

The Applicants are Cocon Food Industries Sdn Bhd, who applied for registration of a trade mark, which comprised the word “COCON” in a capsule device, for the goods “Desserts, milky desserts, snack foods, jellies and fruit jellies” in class 29. Their application was accepted for registration and advertised. The Opponents are Conoco Inc., a major energy producer for 125 years. The Opponents have been using a mark which comprises the word “CONOCO” in a capsule device, and had registrations in classes 4, 37 and 42. In 2002, after the Applicants made a statement in their Statutory Declaration that the Opponents were not interested in food products, the Opponents filed an application for food products in class 30. The Opponents’ petrol stations in Europe and Thailand used the mark “JET” and their petrol stations in Malaysia used the mark “ProJET”. The mark CONOCO appeared on the billboards outside the petrol stations below the marks JET and ProJET. The mark CONOCO is used in the United States of America on food products sold from their petrol station convenience stores and/or petrol stations.

Held, allowing the application to proceed to registration,

- The Opponents pleaded specific grounds in their Notice of Opposition but also stated that they will rely on any other provisions of the Act and Rules not expressly pleaded in the Notice of Opposition, in support of their opposition. The Opponents are required to state all the grounds on which they rely in support of their opposition in their Notice of Opposition. In addition, if an Opponent relies on an earlier mark he is required to include in his Notice of Opposition a representation of the earlier mark; its number, if registered or pending registration; the class and the specification of the goods or services for which it is registered, pending or used.
- Section 15 - The Opponents were not able to establish that they had an international reputation in the mark CONOCO and that that reputation included Singapore. There was insufficient evidence that the Opponents' mark was recognised internationally for their petrol stations and/or convenience store services as the marks that were used varied. There was also insufficient evidence to establish that the Opponents' reputation in the mark CONOCO extended beyond the USA.
- Even if the Opponents had an international reputation in the mark CONOCO for petrol station services and convenience store services, there are no special circumstances which show that the Applicants' goods or services were connected to the Opponents' goods. This is different from the Tiffany's case where the Opponents had established that manufacturers of luxury brand goods had been known to licence their trade marks for use on cigarettes even while they might not themselves produce or be particularly well-known for smokers' articles.
- COCON is shorter and CONOCO is longer and only the first syllables of both marks are identical whereas the rest are distinct. One is a two syllabic word and the other is a three syllabic word. Therefore the marks are visually and aurally distinct. Customers will be able to distinguish the Applicants' goods and the Opponents' services, and they will not be confused between the marks COCON and CONOCO. Therefore the opposition under section 15 failed.
- Section 12 - The Opponents submitted that the Applicants used the mark COCON originally in a script form without a capsule device and that they have not explained the change from the script form to the present form

and their use of a capsule device. However, the change from script form and the use of the capsule device in itself, is insufficient evidence to draw an inference that the Applicants misappropriated the Opponents' mark or that the application is made in bad faith. Therefore the opposition under section 12 failed.

Legislation referred to:

- Trade Marks Act (Cap 332, 1992 Revised Ed) sections 12 and 15
- Trade Mark Rules 1998, rule 30

Cases referred to:

- Kellogg Co v Pacific Food Products Sdn Bhd [1992] 2 SLR 651
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- De Cordova v Vick [1951] 68 RPC 103
- Rysta Ltd's Application (1943) 60 RPC 8
- Golden Jet TM [1979] RPC 19
- Players TM [1965] RPC 363
- Woodles TM [1965] RPC
- Swiss Miss TM [1997] RPC 219
- White Hudson & Co v Asian Organisation Ltd [1965] 1 MLJ 186
- Pianotist Company Ltd Application (1906) 23 RPC 774
- Bali TM [1969] RPC 472
- Smith Hayden & Co's Application (1946) 63 RPC 97
- Edward Hack's Application (1941) 58 RPC 91
- Australian Woollen Mills Ltd v Walton (1937) 58 CLR
- Cooper Engineering Company Proprietary Ltd v Sigmund Pumps Ltd (1952) 86 CLR 536
- Harrods v Harrodian School [1996] RPC 697
- Tornado Trade Mark (1979) RPC 155
- Vitamin Ltd's Application [1956] RPC 1
- Brown Shoe Co. Inc.'s Application [1959] RPC 29

Representation:

- Mr Louis Chan and Ms See Tho Sok Yee (Allen & Gledhill) for the Applicants
- Mr P Sivakumar (Ella Cheong & Gladys Mirandah) for the Opponents