

**In Trade Mark Application No. 15262/00
By Uni-Charm Corporation**

And

**Opposition
By The Procter & Gamble Company**

*Before Principal Assistant Registrar Lee Li Choon
7 May 2003*

Trade Mark Application - Opposition - Whether Applicant's mark is a sign capable of distinguishing his goods from those of another - Whether it is devoid of distinctive character - Whether it indicates the characteristics of the goods - Section 2(1), 7(1)(a), 7(1)(b), 7(1)(c), 7(1)(d), 7(4), 7(6) and 8 of the Trade Marks Act (Cap. 332 1999 Ed)

The Applicants are Uni-Charm Corporation, who applied for a trade mark "BREATHABLE" (hereinafter, "the Applicants' Mark") in class 5 for "sanitary napkins, panty liners (sanitary), sanitary pants, menstruation tampons, napkins for incontinents, pads for incontinents". The Opponents are The Procter & Gamble Company, who are manufacturers of consumer products which include sanitary napkins, panty liners and diapers (hereinafter, referred to collectively as "the Opponents' Products"). The Opponents opposed the application on the grounds that "BREATHABLE" is not capable of distinguishing goods dealt with or provided in the course of trade by the Applicants from goods so dealt with or provided by the Opponents or any other trader, and that the word "BREATHABLE" had been used as a descriptive term on the Opponents' Products. The Applicants argued that the use of the word "breathable" on the Applicants' goods "is hardly to be associated with the meaning of "breathable" in the real or literal sense of the word and is more normally used in connection with goods such as oxygen masks or the like."

Held, disallowing the application:

- Section 7(1)(b) read with Section 7(2) is a bar to the registration of the Applicants' mark absolutely. The mark "BREATHABLE" is obviously the sort of word which cannot do the job of distinguishing without first educating the public that it is a trade mark. The word is a common descriptor for such products, and is a word which would naturally be used by other traders in relation to similar products.
- As the mark has not been established to have acquired a distinctive character, Section 7(1)(c) read with Section 7(2) is also a bar to the registration absolutely.
- Section 8 is only applicable if there is an "earlier trade mark" which is claimed by the Opponents to belong to them. The Opponents did not claim that they have any "earlier trade mark" within the definitions of Section 2 to which any of the sub-sections of Section 8 would apply. They merely maintained that they have used the word, "breathable" in a descriptive sense. Therefore, Section 8 is wholly inapplicable in this instance. Further, the Opponents cannot on the one hand allege that the Applicants' Mark "BREATHABLE" is not a registrable trade mark and on the other hand, claim that they have earlier rights to the same non-registrable word, "breathable". Therefore the opposition under section 8 failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1999 Revised Ed) sections 2(1), 7(1)(a), 7(1)(b), 7(1)(c), 7(1)(d), 7(2), 7(4), 7(6), 8.

Cases referred to:

- Autoanalyser [1970] RPC 201
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Nippon Paint (Singapore) Co Pte Ltd v ICI Paint (Singapore) Pte Ltd [2001] 1 SLR 1
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte & Anor [2000] 3 SLR 145
- AD2000 [1997] RPC 168
- Philips v Remington [2002] All ER (EC) 634

- Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd [2000] 4 SLR 360

Representation:

- Ms Joyce Lynn Yap (Haq & Selvam) for the Opponents
- Mr Patrick Yap (K.L.Tan & Associates) for the Applicants