

**In The Matter Of A Trade Mark Application No. 4150/93
By Kabushiki Kaisha Chandeal**

And

**Objection Thereto By
Chantelle**

*Before Principal Assistant Registrar P Arul Selvamalar
19 September 2003*

Trade Mark Application - Opposition - whether marks confusingly similar - whether applicant is the rightful proprietor - section 12(1), 15 and 23 - Trade Marks Act (Cap 332, 1992 Ed)

Facts

The Applicants, Kabushiki Kaisha Chandeal, a Japanese company, applied for registration of a word mark "Chandeal" in script form with a circular device in class 25 for "trousers; skirts; blouses; sweaters; jackets; jumpers; suits; coats; overcoats; shirts; pants; furs; underclothing; lingerie; brassieres; suspenders; girdles" on 3 June 1993. The Opponents, Chantelle, a French company, own a registered trade mark "CHANTELLE" in class 25 for "corsets, girdles, brassieres, suspenders, stockings, panties, and underwear for women." The Opponents mark had been registered since 1983 and had been used in Singapore. The Opponents filed an opposition to the application relying on sections 10, 12(1), 15, and 23 but at the hearing, they indicated that they will be proceeding only on section 12(1), 15 and 23. They also filed submissions on section 12(2) of the Act although it was not pleaded as a ground in their Notice of Opposition.

Held, allowing the application to proceed to registration,

- The Applicants' mark is visually different from the Opponents' mark as the word Chandeal is in a particular script with a circular device surrounding it whereas the Opponents' mark is in capital letters. In terms of aural similarity, the average Singaporean consumer is likely to read the Opponents mark Chantelle as Shantel and the Applicants' mark Chandeal as "Chan-deal" or "Shan-deal". The average Singaporean consumer would examine the type of goods sold under both marks for their brand, style, colour and size before purchasing them and because they are for personal use, they would pay some attention in the selection of the particular brand that they are after.
- Taking into account all circumstances, in particular, the effect of imperfect recollection, the effect of mispronunciation and comparing the marks as wholes, there is no reasonable likelihood of confusion or deception among a substantial number of persons in Singapore.
- There is insufficient evidence of use or promotion of the Opponent's mark in Singapore before 1993. The Registrar was unable to find that the Singaporean public could have been aware or taken cognizance of the Opponents' mark because of their international reputation. Even applying the Tiffany case, that reputation may not only be acquired by use within jurisdiction, the Opponent's have not acquired the kind of reputation that is necessary to lead to confusion and deception between the respective marks, among a substantial number of persons, whether at the date of application by the Applicants or after the date of application. In any event the marks are not confusingly similar. The opposition under section 15 and 23 fails.
- There is insufficient evidence to establish that there has been long and extensive use of the Opponents' mark. Even if the Applicants were aware of the Opponents' mark, there is insufficient evidence that the Applicants have misappropriated the Opponents' mark. The fact that they have not explained the derivation of their mark alone, is not sufficient evidence that they have acted in bad faith. As such, the opposition under section 12(1) also fails.
- The Opponents submitted on section 12(2) although it was not pleaded as a ground of opposition. The Registrar will not consider a ground which is not pleaded in the Notice of Opposition.

Legislation referred to:

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

Cases referred to:

- In the Matter of an Application by The Pianotist Company Ltd for the Registration of Trade Mark [1906] 23 RPC 774
- Aktieselskabet Freia Chocolate Fabrik's Application [1924] 41 RPC 655
- William Bailey (Birmingham) Ltd's Application [1935] 52 RPC 136
- Aristoc Ltd v Rysta Ltd [1945] 62 RPC 87
- Smith Hayden [1946] 63 RPC 97
- Bali TM [1969] 86 RPC 472
- Dunns TM [1890] 7 RPC 311
- Edward Hack Application (1941) 58 RPC 91
- Tiffany & Co v Fabriques de Tabac Ruenies SA [1999] 3 SLR 147
- Harrods (1935) 52 RPC 65
- Sandow (1914) 31 RPC 196
- Lancer TM [1987] RPC 303
- Polo/Lauren v US Polo Association [2002] 1 SLR 326
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- Solavoid TM [1977] RPC 1
- Lego System v Lego Lemelstrich [1983] FSR

Representation:

- Mr Patrick Yap (K.L. Tan & Associates) for the Applicants
- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents

NB: The appeal from this decision to the High Court was dismissed.