

**In The Matter Of A Trade Mark Application No. T99/087321
By Tai Say (Import & Export) Pte Ltd
To Register A Trade Mark In Class 29**

And

**In The Matter Of Opposition Thereto
By Ayam S.A.R.L.**

*Before Principal Assistant Registrar Anne Loo
28 February 2003*

Trade Mark Application – opposition to registration – whether application mark may cause confusion or deception – whether the applicants’ mark is distinctive or capable of distinguishing the Applicants’ goods – sections 7(6), 8(2)(b), 8(4) and 9 Trade Marks Act (Cap 332, 1999 revised Ed)

The Applicants, Tai Say (Import & Export) Pte Ltd, whose original trade mark (with the Malay words ‘Chap Ayam Belanda’, the Chinese characters ‘huo ji shang biao’ and the device of a turkey) was registered in 1967, applied for the registration of an updated version of their trade mark in 1999 in Class 29 for ‘Meat fish, poultry and game, meat extracts, preserved dried and cooked fruits and vegetables; and edible oils and fats; in particular tuna fish, mackerel and crustaceans (crab meat)’. The Opponents, Ayam S.A.R.L. were the registered proprietor of numerous trade marks bearing the words “Cap Ayam” or “Ayam Brand” and the device of a rooster in Singapore, in various classes covering a large variety of edible goods.

The Opponents contended that by reason of their long and continuous use as well as extensive advertising, their mark had acquired goodwill and reputation. Registration of the Applicants’ trade mark would tarnish the Register of Trade Mark and lead to (i) deception and confusion of the trade and public, (ii) the Applicants’ goods being passed off or mistaken as the goods of the Opponents, (iii) interference with the prestige, and grave possibility of diminishing the value of the Opponents’ mark.

The Opponents also contended that the Applicants’ mark was not distinctive or capable of distinguishing the goods of the Applicants, and that the Applicants’ mark so resembled the Opponents’ trade mark that it was not bona fide and would be likely to deceive and cause confusion.

The Applicants denied the aforesaid points raised by the Opponents and contended that there was of honest concurrent use of the Applicants’ mark and device.

Held: allowing the application to proceed to registration.

- Both the Applicants’ and the Opponents’ marks are not new in the market; and both parties have not substantially changed their marks over the period of time for their respective use. The main elements appearing in their original marks have been preserved in the updated versions. In particular, the Applicants’ device remains clearly distinguishable as a turkey, and hence the contention that the Applicants have caused their mark to appear more similar to the Opponents’ is not well grounded.
- The Opponents failed on the grounds of section 8(2)(b) of the Trade Mark Act 1999 edition because, in comparing the two marks, and taking into account the main idea or the main impression of the mark that is conveyed, the Opponents’ and the Applicants’ marks cannot be said to be similar. The devices of the different fowls were not similar and the words on the marks had clearly different meanings. Hence, there would be no reasonable likelihood of confusion amongst the consumers.
- Section 8(4) of the Trade Mark Act 1999 was not applicable as the Opponents’ mark is not an unregistered mark. The ground of opposition under this section therefore also failed.
- The change in the look of the Applicants’ marks from 1967 to 1995, and eventually to 1999 was an exercise in modernizing the look and feel of their trade mark. The main elements were retained, and there were no material differences between the three marks. As there was no evidence to establish the Opponents’ allegation of bad faith, the ground of opposition under section 7(6) also failed.

- There was no necessity to examine the issues of the defence of honest concurrent use under section 9 as the Opponents had not succeeded under their ground of opposition based on section 8(2)(b).
- Since the Opponents failed on the ground under section 8(2)(b), and there was insufficient evidence of actions taken by the Opponents against the Applicants to prevent them from using the mark or instances of confusion, the Opponents therefore had not made out of a case of bad faith on the Applicants' part and the grounds of opposition based on public policy grounds failed.

Provisions of legislation:

- Trade Marks Act (Cap 332, 1999 revised Ed) sections 7(6), 8(2)(b), 8(4) and 9

Cases referred to:

- Pianotist Co's Application (1906) 23 RPC 774
- Smith Hayden & Co's Application (1945) 63 RPC 97
- Jellinek (1946) 63 RPC 59
- De Cordova v Vick (1951) 68 RPC 103
- In the matter of Farrow's Trade Mark (1980) RPC
- Kellogg Co v Pacific Food Products Sdn Bhd [1992] 2 SLR 651
- Wagamama v City Centre Restaurants [1995] FSR 713
- Tiga Gajah Cho Heng Sdn Bhd v Majuperak Tepung Beras [1997] 4 MLJ 504
- Sabel BV v Puma AG [1998] RPC 199
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77

Representaion:

- Mr John Wong (M/s Robert W.H. Wang & Woo) for the Applicants
- Ms Catherine Lee (M/s Rodyk & Davidson) for the Opponents