

**In The Matter Of A Trade Mark Application No. T95/08420A
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 10, 15, 23 and 25 Trade Marks Act (332, 1992 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 1995 in Class 29 for ‘Meat fish, poultry and game, meat extracts, preserved dried and cooked fruits and vegetables; preserves and pickles’. 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 relied on sections 23, 15 and 10(1) in their opposition. They contended that by reason of the Opponents’ long use of more than 60 years in Singapore in respect of various kinds of edible goods as well as the extensive advertising activities; they had acquired goodwill and reputation in their mark. Registration of the Applicants’ trade mark would lead to deception and confusion of the trade and public. The Opponents also contended that the Applicants’ trade mark so resembled the Opponents’ trade mark as to be likely to deceive and cause confusion. The Applicants’ mark was also not distinctive or capable of distinguishing the goods of the Applicants.

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 the look of their marks over the period of time of 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 sections 23 and 15 of the Trade Mark Act 1992 edition because, using the rules of comparison of marks, the Applicants’ mark does not nearly resemble the Opponents’ mark. The devices of the different fowls are not similar and the words appearing in the marks have clearly different meanings. Hence, there will be no reasonable likelihood of deception or confusion amongst the trade and public if the Applicants use their marks normally and fairly in respect of their goods.
- There was no necessity to examine the issues of the defence of honest concurrent use under section 25 as the marks are not similar so as to cause deception or confusion.
- Section 10(1) of the Trade Mark Act 1992 edition deals with the criteria of registrability of a mark, and is not concerned with considerations such as comparison of marks and the likelihood of confusion or deception. The Applicants’ mark satisfies the requirements under the said provision in terms of distinctiveness. The Opponents thus also failed on this ground of opposition.
- Since it had been decided that the marks were not confusingly similar, it was clear that there was no blatant copying as alleged by the Opponents. 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 discussed:

- Trade Marks Act (332, 1992 revised Ed) sections 10(1), 15, 23 and 25

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

Representation:

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