

**In The Matter Of A Trade Mark Application No. 4696/89 By
Marco Polo Leather Design Limited**

And

**Opposition By
Marhani Binte Abdul Mutalib
Trading As
House of Burton (1888) Of Bloomsberry**

*Before Ms Anne Loo Principal Assistant Registrar of Trade Marks
6 March 2003.*

Trade Mark Application – Opposition to registration – whether application mark may cause confusion or deception - sections 11, 23, 24, 26 Trade Marks Act (Cap.332, 1992 Ed)

Facts

The Applicants Marco Polo Leather Design Limited filed a trade mark application for the word mark “Marcopolo” in Class 25 in respect of “Belts (clothing)”. The Opponents Marhani Binte Abdul Mutalib trading as House of Burton (1888) Of Bloomsberry lodged a Notice of Opposition against the trade mark application on the grounds that the Applicants’ mark is similar or identical to the Opponents’ earlier mark, that there is a likelihood of confusion between the marks and that the Applicants’ mark is not distinctive as it is a generic word. The Applicants relied on sections 11(1), section 23(1), section 24 and section 26(1) of the Trade Marks Act 1992 Revised Edition. The Applicants denied all the grounds raised in the Notice of Opposition. No submissions were filed as both parties were not present on the day of the hearing.

Held, allowing the application to proceed to registration,

- The Opponents raised a section 11(1) objection on the ground that the Applicant’s mark which had the identical words “Marco Polo” as the Opponent’s mark, would confuse the trade and the public; and cause the public to think that there is a trade connection between the Applicants and the Opponents when no such connection exists. Section 11(1) of the Trade Marks Act (Chapter 332) 1992 Edition however makes reference to the registrability of marks that may be accepted in Part B of the register. Issues relating to whether marks are confusingly similar or whether there is likelihood of confusion or deception if the marks are confusingly similar are however, are not considerations that are determined under section 11. Opposition under section 11 therefore cannot stand.
- In order to succeed under section 23, one of the criteria to be satisfied is that the Opponents must have a mark which was “already on the register” at the time the opposition was filed. As the Opponents’ earlier application for a device mark containing the word “Marcopolo” had been abandoned, the opposition under Section 23 fails.
- Section 24 sets out the methods to resolve conflicts where there are two or more applications pending which relate to similar or identical marks belonging to different proprietors, and which are used in respect of goods that are either the same goods, or to goods of the same description. The section would not specifically be used by an Opponent to oppose a conflicting mark in an opposition proceeding.
- Section 26 is not relevant to an opposition. Section 26 relates to the association of trade marks. Although the wording of section 26 is similar to the section 23 wording in that it uses the words “similar or identical marks, the same goods or goods of the same description, the likelihood of confusion”, these considerations are there for different reasons. Unlike section 23 which may lead to the Applicants’ mark not being accepted for registration if the considerations are fulfilled, the same considerations under section 26 if met, allows the Registrar to impose an association clause.
- The Opponents’ had raised an issue relating to the specification of goods, and claimed that the items specified as “belts (clothing) in class 25 were incorrectly classified and should rightly fall within class 18 for “leather belts”. Class 25 includes items such as belts made of leather for wear, suspender belts of leather as well as fabric belts, hence the specification as lodged by the Applicant is correct.

Legislation referred to:

- Trademarks Act (Cap.332) 1992 Ed. Sections 11, 23, 24, 26

Representation:

Both parties did not attend the hearing on 6 March 2003