

**In The Matter Of A Trade Mark Application By
Smile Inc. Asia Pte Ltd
To Register A Trade Mark In Class 42**

And

**Opposition Thereto By
Britesmile International Ltd**

*Before Principal Assistant Registrar Ms. P Arul Selvamalar
29 October 2003*

Trade Marks - Opposition to registration - Distinctiveness in the mark - whether usage of part of the Applicant's company name in the mark rendered the mark indistinct - whether the mark had a direct reference to the services - Section 10 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks - Opposition to registration - Proprietorship of the mark - whether the Applicant had a bona fide claim to proprietorship of the application mark - whether there had been misappropriation of the Opponents' mark - Section 12(1) of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks - Opposition to registration - Likelihood to deceive or cause confusion that would disentitle the mark to protection in a court of justice or would be contrary to law if it was registered - whether there was reputation in the Opponent's mark before the date of application of the Applicant's mark - Section 15 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

The Applicants are a Singapore Company who had applied for the word mark "SMILEinc." on 5 February 1998 for "Computer programming; computer software design; dentistry; design of interior décor; healthcare; hospitals; graphics arts designing; maintenance of computer software; medical clinics; professional consultancy services relating to the non-business aspects of dentistry; research and development (for others); software (updating of computers)" in Class 42. The Opponents are an Irish Company who use the mark "BriteSmile" and have applications and registrations in Singapore and other countries for their mark "BriteSmile".

The Opponents relied on sections 10, 12(1) and 15 in their opposition. They contended the Applicant's mark "SMILEinc." was the name of the Applicant company which was not represented in a special or particular manner and that it had direct reference to the services provided by the Applicants.

The Opponents also contended that the Applicants were not the bona fide proprietors of the mark "SMILEinc.", and that the Applicants had misappropriated the Opponents' mark.

The Opponents also contended that they had a reputation in the mark "BriteSmile" in Singapore and internationally from before the date of application of the mark "SMILEinc.". Therefore the use of the mark "SMILEinc." would be likely to deceive or cause confusion in the minds of consumers.

Held, dismissing the Opposition

1. The opposition under section 10 fails. The mark "SMILEinc." is not the full name of the Applicant company, neither does it have a direct reference to the dental services provided by the Applicants. The mark "SMILEinc." has sufficient distinctiveness to be registered.
2. The opposition under section 12(1) fails. Whether an inference should be drawn that the Applicants have misappropriated the Opponents' mark depends on the facts of each case. In this case, the explanation given by the Applicants about the creation of the mark is credible, and they are clearly the authors of the mark "SMILEinc." There is insufficient evidence to suggest that the Applicants misappropriated the mark "SMILEinc." from the Opponents. The Applicants are the proprietors of the mark "SMILEinc."
3. The opposition under section 15 fails. There was insufficient evidence of the Opponents reputation in the "BriteSmile" mark whether in America or internationally before 1998, the date of application, such that there would be knowledge, cognisance and awareness of the Opponents' mark in Singapore.
4. Phonetically and visually the marks are not so similar that they are likely to be confused by a substantial number of persons. Although the word "smile" is found in both marks, the beginnings of the marks serves to distinguish them in the minds of the consumer. The ideas conveyed by the two marks are also different.

In addition, as the consumer who is looking for teeth whitening is doing so for cosmetic purposes, there would be due deliberation about the teeth whitening services and teeth whitening methods available. Therefore the teeth whitening systems provided by the Applicants under the SMILEinc. mark and the Opponents under the “BriteSmile” mark are not going to be confused by a substantial number of people considering whitening their teeth.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1992 Rev Ed.) Sections 10, 12(1) and 15.

Cases referred to:

- Budd v Lucas [1891] 1 QB 408
- The Pianotist Company Ltd’s Application [1906] 23 RPC 774
- In the matter of an application by Fanfold Ltd [1928] RPC 25
- Smith Hayden & Co’s Application [1946] RPC 97
- The Seven Up Co v OT Ltd & Anor [1947] 75 CLR 203
- Shell Co of Australia v Rohm & Haas Co. [1949] 78 CLR 601
- Application by Brown Shoe Co. Inc [1959] RPC 29
- Aston v Harlee Manufacturing [1960] 103 CLR 391
- Gynomin TM [1961] RPC 408
- Clark Equipment Co v Registrar of Trade Marks [1964] 111 CLR 511
- Thunderbird Products Components Corporation v Thunderbird Marine Products Pty Ltd [1974] 131 CLR 592
- Karo Step TM [1977] RPC 255
- Moorgate Tobacco Co. Ltd. v Philip Morris Ltd [1980] 54 ALJR 479
- Tai Muk Kwai & Ors v Luen Hup Medical Co. [1988] SLR 466
- RH Macy & Co Inc v Trade Accents [1992] 1 SLR 581
- Sidewinder TM [1988] RPC 261
- Al Bassam TM [1995] RPC 511
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Dalic TM v Dalic SA [1998] 2 SLR 231
- Pontiac Marina Pte Ltd v CDL Hotels Ltd [1998] 2 SLR 550
- Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd [1998] 1 SLR 1012
- Kellogg & Co. v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Super Coffeemix [2000] 3 SLR 145
- Demon Ale [2000] RPC 345
- Republic Home Loans Pty Ltd v The CIA Pty Ltd [2001] AIPC 91-683
- Supacenta Pty Ltd v Vesudi Pty Ltd 36 IPR 399
- Ferrero S.p.a. v Soldan Holding + Bonbonspezialitaeten GmbH (IPOS decision dated 20 July 2001)

Representation:

- Mr Samuel Seow (M/s David Chong & Co.) for the Applicants
- Mr P. Sivakumar and Ms Meat Kaur (M/s Ella Cheong & G. Mirandah) for the Opponents