

**In The Matter Of An Application
N.V. Sumatra Tobacco Trading Company
To Register A Trade Mark**

And

**Opposition Thereto By
Hero**

*Before Principal Assistant Registrar Anne Loo
14 April 2004*

Trade Mark Application – Opposition – whether Applicants’ mark will cause confusion under passing off or due to well known nature of Opponents’ mark, or identical to an earlier trade mark – Sections 7(4), 8(2), 8(3), of Trade Marks Act (Cap. 332, 1999 Ed.) – Application made in bad faith

This is an opposition by HERO (a company incorporated in Switzerland) of 5600 Lenzburg, Switzerland against the trade mark application T00/02450H for the mark “HERO” in Class 42 in respect of “Hotel and motel services; restaurant and catering services; bar and cocktail lounge services; cafes, cafeterias, canteens, coffee shops; provision of temporary accommodation; snack bars; pub services; all included in Class 42” by N.V. SUMATRA TOBACCO TRADING COMPANY. The Opponents argued that the use by the Applicants of the trade mark “HERO” would cause confusion on the part of the public in Singapore and lead to the Applicant’s goods being passed off as the Opponents’ (Sections 7(4) and 8(4) of the Trade Marks Act (Cap. 332, 1999 Ed.). Further, registration of the mark ought not to be allowed by virtue of the registration of the Opponent’s HERO Trade Marks and extensive use of the Opponent’s HERO Trade Marks and trade name in Singapore and because of the close similarity of the mark for which application is made to the Opponent’s HERO Trade Marks and trade name (Sections 8(2) and 8(3). The Applicant cannot claim to be the bona fide owner of the trade mark applied for and registration of the Applicant’s trade mark (Section 7(6)). By reason of the prior registrations and use of the Opponent’s HERO Trade Marks, the Applicant’s mark is devoid of any distinctive character (Section 7(1)) and that the Applicant, in their choice of the mark applied for, is taking advantage of the Opponent’s established reputation in their HERO Trade Marks and as such the Applicant’s mark is not bona fide and should be refused in the exercise of the Registrar’s discretion.

Held, dismissing the opposition and allowing the application to proceed to registration,

1. Parties conceded that the marks are identical, hence it was only necessary to determine whether the Applicants’ services are similar or identical to the goods of the Opponents’ earlier trade mark. While it has been decided in the Fingal and Balmoral cases that suppliers of services relating to provision of food and drink are in close proximity with supplier of food products, the converse cannot be said to be true, namely that producers of food products are likely to be involved in the service industry relating to provision of food and drink. The Hearing Officer was thus not able to find the “close nexus” or the “inextricable link” between the Applicants’ services to the Opponents’ goods. It is true that producers of food products trade with providers of food, accommodation and pub services by supplying goods to them. However, producers of food products are not usually regarded as trading in such close proximity to providers of these services such that the general public would automatically believe that food producers inevitably engage in the business of providing these services. Although the Opponents have submitted that there are instances where manufacturers of well known brands of food products expand their food business to include operation of food services, the Opponents’ bare assertion that this practice is a “market practice” cannot be supported by merely showing some examples of food manufacturers who have chosen this line of business extension. As the services and the goods are not similar or identical, it is unlikely that confusion can arise and the opposition under section 8(2) fails.
2. As the marks are identical and it has been decided under section 8(2) that the Applicants’ services are not identical or similar to the goods of the Opponents’ earlier registered mark, under Section 8(3), the burden is now on the Opponents to prove that their trade mark is well known in Singapore. On the face of the evidence, while the Opponents enjoy good sales relating to food products in Singapore, it is not possible to draw any conclusion whether the sales are substantial sales in respect of food products, or whether the Opponents have cornered the lion’s share of the market in respect of these goods. The Opponents have not discharged the burden of proving that their mark is well known in Singapore under Section 8(3).

3. It has been decided under the section 8(3) ground of opposition that the Opponents' evidence of use does not establish that they are well known, whether as producers of food products or as providers of the sort of services that the Applicants wish to protect under their mark. What the evidence does show is that the Opponents have use of the mark in respect of food products such as jams. This however does not establish the sort of goodwill and reputation required for a passing off action where the Opponents are claiming goodwill or reputation in those services that the Applicants' mark seeks to protect. It has also been decided that there is no confusion or deception and that the public is not likely to think that the Applicants' services are connected to the Opponents' business. As there is no goodwill, reputation or misrepresentation, the Hearing Officer was not satisfied that there would be any damage. The Opponents have not discharged their burden of proving the elements of passing off and the opposition under section 8(4) therefore fails.
4. When bad faith is pleaded as a ground of opposition, there must be clear and sufficient evidence to make out the serious allegation of bad faith. From the examination of the evidence in this matter, there is insufficient evidence to establish that there is bad faith. The Applicants have in their evidence shown that they have long use of the "HERO" mark. There is no misappropriation of the Opponents' mark, and the Applicants have not been shown to have acted in bad faith in their selection of their mark. There is a bare allegation that the proposed registration is made to circumvent the law against advertisement of tobacco products; this is but an allegation. The case for "bad faith" is not made out and the opposition based on Section 7(4) fails.

Provisions of Legislations discussed:

- Sections 7(1), 7(4), 7(6), 8(2), 8(3) and 8(4) of the Trade Marks Act (Cap.332, 1999 Ed.)
- Smoking (Control of Advertisements & Sale of Tobacco) Act

Cases referred to:

- Sabel BV v Puma AG [1998] RPC 199
- British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281
- Fingals Trade Mark [1993] RPC 21
- Balmoral Trade Mark (1999) R.P.C. 197
- SHARP OWL Trade Mark U.K. Registry Hearing O-219-03
- Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc. [1999] E.T.M.R 1
- British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281
- CHEERS Opposition to UK 2220894.
- British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281
- In the Matter of Trade Mark 2012498 by CA Sheimer (M) Sdn Bhd
- SHARP OWL Trade Mark U.K. Registry Hearing O-219-03
- CDL Hotels International Ltd v Pontiac Marine Pte Ltd [1998] 2 SLR 550
- Marca Mode CV [2000] ETMR 561
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD TM [1998] RPC 455

Representation:

- Ms Elaine Tan with Miss Jo Yeo (M/s Allen & Gledhill) for the Opponents.
- Ms Teresa O'Connor with Ms Tay Sock Kheng (M/s Infinitus Law Corporation) for the Applicants.