

**In The Matter Of A Trade Mark Application By
National Australia Trustees Limited**

And

**Opposition Thereto By
Sea World, Inc.**

*Before Principal Assistant Registrar P Arul Selvamalar
8 June 2004*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the requirement of distinctiveness under Section 11 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – whether the opponents had a reputation – whether registration of the application mark would cause confusion or deception - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration - whether the Application Mark is similar to an earlier registered trade mark - Section 23 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – whether there was honest concurrent use of the Application mark under section 25 of the Trade Marks Act [Cap. 332, 1992 Ed]

The Applicants, National Australia Trustees Limited, applied for a trade mark which comprised a device of a dolphin leaping over waves with the words SEA WORLD below the device, in class 39 for “travel services in the nature of providing information to travellers and vouchers for tours abroad inclusive of entry into amusement parks”. The Opponents, SEA WORLD INC, an American corporation, had been using a number of marks comprising the words, “SEA WORLD” alone, and / or with a device of a whale. These marks were registered in several classes including Class 41 in the United States and in Singapore. The Opponents opposed the registration on the basis that the Applicants’ mark is not distinctive under section 11, that the mark is likely to deceive or cause confusion under section 15, and that the mark nearly resembles the Opponents’ registered trade mark under section 23. The Applicants argued that their mark was distinctive and that there would be no deception or confusion. They also pleaded that they had honestly and concurrently used their mark under section 25.

Held, allowing the application mark to proceed to registration

- The Opponents have established that they have an international reputation in the business of providing amusement park services under the mark Sea World and the whale device before 1996. Singaporeans would have knowledge, cognisance and awareness of this international reputation, as about 60,000 Singaporeans have visited the Opponent’s theme parks in the US between the period 1994 – 2002, and this works out to about 15,000 Singaporeans who would have visited the Opponents’ theme parks in the US before the date of application, 1996. Although these visitor numbers are only available from the year 1994, the fact that the Opponents have been operating as Sea World since 1964 and that they have been using the words Sea World with the whale device since 1980 cannot be ignored.
- It was found that visually and aurally the marks are similar; the services of providing information and vouchers for entry into amusement parks and amusement park services are related; and that the kind of customer who seeks these services are also the same type of customers, as they are essentially tourists. However, there are circumstances in this case which will not lead to confusion or deception. The tourist who goes to the Australian amusement park may know that there are marine parks in the US called Sea World. He may wonder whether they are connected in any way but it is unlikely that he would connect the two as originating from the same source. There is no real danger of confusion because the Opponents’ marks which comprise the words sea and world and a device of a whale leaping over waves, are descriptive. Descriptive words can become distinctive trade marks through use, and/or when stylised and joined together with other elements but the average person would still be influenced by the descriptive elements in the mark. It is the descriptiveness of the mark which will not lead a substantial number of persons to wonder whether the Australian amusement park is connected to the American amusement park. Confusion for the purposes of sections 15 and 23 was not established.

- Although the Hearing Officer was not satisfied with the lack of explanation on the Applicants' part about when they commenced use of the mark which forms the subject of this application, and why they changed the design of their mark from the earlier mark (which was registered in Australia in 1990) to the later design, that dissatisfaction with the lack of explanation cannot form the basis of a finding that therefore their use was not honest. While taking into account the lack of evidence, the Hearing Officer also took into account that the elements of the mark, the words "sea" and "world", and the whale device leaping over waves, are not so distinctive that if anyone else used similar features, he must have copied them from the Opponents. On the facts, there is insufficient evidence to make a finding that the concurrent use was not honest.
- It was found that it was not likely that the Applicants' mark and the Opponents' mark will be confused by a substantial number of persons for the reasons given. However, even if the marks are confusingly similar, the Hearing Officer found that there was honest concurrent use. Therefore the application succeeded under section 25 in the alternative.
- The application mark is capable of distinguishing the Applicants' services. Therefore, the opposition under section 11 failed.

Provisions of Legislation discussed

- Trade Marks Act (Cap. 332, 1992 Ed.) Sections 11, 15, 23 and 25

Cases referred to:

- Polo/Lauren Co LP v United States Polo Association & Anor Action [2002] 1 SLR 326
- De Cordova & Ors v Vick Chemical Co (1951) 58 RPC 103
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd & Anor [2000] 1 SLR 587
- Pruriderm TM [1985] RPC 187
- Floradix TM [1974] RPC 583
- Tiffany & Co v Fabriques De Tabac Reunies SA [1999] 3 SLR 147
- Hack's Application (1941) 58 RPC 91
- Kellogg Co v Pacific Food Products Sdn Bhd [1998] 3 SLR 28
- Jellinek's Application (1946) 63 RPC 59
- Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd (1954) 91 CLR 592
- Pioneer Hi-Bred Corn Co [1979] RPC 410
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
- AD 2000 TM [1997] RPC 168
- Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc [1999] RPC 117
- Re AUVI Trademark; AUVI Pte Ltd v Seah Siew Tee & Anor [1992] 1 SLR 639
- KARO STEP TM [1977] RPC 255
- Metric Resources Corporation v LeaseMetric Ltd [1979] FSR 571
- ConAgra Inc v McCain Foods (Aust) Pty Ltd [23] IPR 193
- Reckitt & Colman (Aust) Ltd v Boden (1945) 70 CLR 84
- Arthur Fairest Ltd's Application (1951) 68 RPC 197
- Re Arthur Fairest Ltd's Application (1951) 68 RPC 197
- Eno v Dunn (1890) 15 App Cas 252
- Aristoc v Rysta [62] RPC 72
- Application for the mark BOOKWORLD No. 0/194/02 UK Patent Office (unreported)
- Broadhead's Application (1950) 67 RPC 209
- Woolworths v Registrar of Trade Marks (1999) 45 IPR 411
- Dalic TM [1998] 2 SLR 231
- Fitton's Application (1949) 64 RPC 110
- Alex Pirie & Sons Ltd's Application (1932) 49 RPC 195
- Massachusetts Saw Works Application (1918) 35 RPC 137
- Baume & Co Ltd v Moore (AH) Ltd (1958) RPC 226 at 235
- Joseph Rogers & Sons Ltd v WN Rogers & Co (1924) 41 RPC 277
- Parkington & Co Ltd's Application (1946) 63 RPC 171.
- In Re Butler TM (1975) RPC 275
- McCormick & Co Inc v McCormick [2000] FCA 1335

Representation

- Ms Sharmila Segaram (Tay & Partners) for the Opponents
- Mr Christopher Woo (Harry Elias & Partners) for the Applicants