

**In The Matter Of Trade Mark Application No. T97/07578A
In The Name Of Kabushiki Kaisha Nihon Josephine Sha
(Doing Business As Josephine Cosmetics Inc.)**

And

Opposition By Sothys S.A.

*Before Principal Assistant Registrar Ms. Elizabeth V. Cardoza
15th September 2004*

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

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

The Applicants, Kabushiki Kaisha Nihon Josephine Sha (doing business as Josephine Cosmetics Inc.), are a company incorporated in Japan. On 26 June 1997, they applied for the registration of a mark “**Satys**”. The application covers “bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” in class 3. The Opponents, Sothys S.A., are a well-established company involved in providing a wide range of goods in Classes 3 and 5 worldwide, and their areas of business include the provision of goods relating to the cosmetics and beauty care industry. The Opponents have identified the mark “**SOTHYS**” as their principal mark and it is also their company name. The Opponents filed an opposition on 16 August 2000 to the application relying on Sections 10, 12, 15 and 23 of the Trade Marks Act (Cap 332, 1992 Ed).

Held, disallowing registration

1. Under Section 15 of the Act, the Applicants have the burden of proof that their mark is registrable. However, the burden of proof that the Opponents’ mark has acquired sufficient reputation through use, is on the Opponents and once this onus is discharged, the burden of proof that the mark is registrable is on the Applicants.
2. The test to be applied in Section 15 is that propounded in the Smith Hayden case [1945]. The Opponents have produced evidence of substantive volume of sales and advertising expenses. It is clear from the evidence that the Opponents have used their mark long before the Applicants have used theirs, and that the Opponents’ mark is known to a substantial number of persons within Singapore. Accordingly, the Registrar is satisfied that the Opponents have a reputation in the business of selling its products under its SOTHYS mark. The question is whether because of their reputation in their mark, the registration of the Applicants’ mark would cause confusion or deception.
3. In comparing the Opponents’ mark with the Applicants’ mark, the Registrar finds that should the Applicants’ mark be registered, there is a likelihood that consumers would wonder whether the Applicants’ goods came from the same source as the Opponents’. As brand extension is common in the marketplace, and a trader of goods and services would be prepared to take the risks of diversifying into related or unrelated fields of trade, it is a valid contention that consumers will be deceived into thinking that any product of the Applicants would indeed be related to the Opponents.
4. The Application mark is similar to the Opponents’ mark in several ways. Both are word marks, albeit the Application mark does not comprise all uppercase letters, only the first letter S is set out in capitals with the remaining letters set out in lowercase or small print, and there is an apostrophe after the letters, while the Opponents’ mark consists of all uppercase letters. However, while visually the marks are not identical, they are nevertheless very similar, because they share many common letters, which are set out at key points, (the beginning, the mid-point, and the end) in each mark. The different lettering in the Application mark, are in essence, non-substantive differences. In terms of phonetic similarity, especially in the local context, there is no sound basis to make the finding that the word “satys” is pronounced very differently from the word ‘sothys’. There is a real risk that the two marks would be confused phonetically.
5. Therefore, the opposition under sections 15 and 23 succeed.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1992 Rev. Ed.) Sections 10, 12, 15 and 23.

Cases referred to:

- Aristoc Ltd v Rysta Ltd [1943] 60 RPC 87
- Bailey (1935) 52 RPC 136
- Bali Trade Mark 1969 RPC 47
- De Cordova v Vicks [1951] W.N. 195
- Dewhurst [1896] 2 Ch. 137
- Hacks Application (1940) 58 R.P.C. 91
- Harrods' Application (1935) 52 R.P.C. 65
- In the Matter of an Application by Laslidas Jellinek for the Registration of a Trade Mark [1946] 63 RPC 59
- Kellogg Co. v Pacific Food Products Sdn Bhd (1998) 3 SLR 28 [High Court]
- Kellogg Co. v Pacific Food Products Sdn Bhd (1999) 2 SLR 651 [Court of Appeal]
- Otsuka Pharmaceutical Co Ltd v Farmalita Carlo Erba SpA [1995] AIPR 86
- Perfumes of Singapore v Raffles Hotel [1993] AIPR 278
- Pianotist Co's Application (1906) 23 RPC 774
- Polo/Lauren LP v United States Polo Association & Anor [2002] 1 SLR 326
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Sandow [1914] 31 RPC 196
- Saville Row Trade Mark [1998]
- Smith Hayden & Co's Application (1945) 63 RPC 97
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Re Wong Seng & Son Sdn Bhd's Application and Salamander AG's Opposition [1993] AIPR 252
- Re Worthington & Co's Trade Mark (1880) 4 Ch. D. 8

Representation:

- Mr. Lee Shy Tsong (Messrs Donaldson & Burkinshaw) for the Applicants
- Mr. Nathan Lau with Ms. Jennifer Cheng and Mr. Kevin Wong (Ella Cheong Spruson & Ferguson (Singapore) Pte Ltd) for the Opponents