

**In The Matter Of A Trade Mark Application No. 6434/92
By Campomar S. L.**

And

**Opposition by
1. Nike International Ltd
2. Nike Singapore Pte Ltd**

*Before Principal Assistant Registrar Anne Loo
13 Jan 2004*

Trade Mark Application – Res Judicata

The Applicant, Campomar S.L., applied on 21 August 1992 for registration of a trade mark “NIKE” in class 3 for “Bleaching preparations, and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations; soap. The subject application was advertised before acceptance on 10 October 1997 and was opposed by Nike International Ltd, the 1st Opponents in this matter. The opposition was heard on 16th April 2001 (“the previous opposition”) before Assistant Registrar Chua Ser Ching, who did not allow the opposition and directed the Applicant to amend the specification of goods. Thus the specification was restricted to “Bleaching, cleaning, polishing, scouring and abrasive preparations; soaps; all not for laundry use nor for use on sport goods or sporting apparel; all included in Class 3.” The 1st Opponents lodged an Originating Motion (Originating Motion No. 600020 of 2001) in the High Court to seek leave to appeal out of time against the Assistant Registrar Chua Ser Ching’s decision. The application was refused. As the mark was advertised before acceptance under the proviso of section 18 Trade Marks Act 1992 edition which empowers the Registrar to re-advertise the application again, if he thinks fit, the mark was re-advertised in on 30th November 2001. On 25th January 2002, Nike International Limited, the 1st Opponent and Nike Singapore Pte Ltd, the 2nd Opponent, lodged a Notice of Opposition against the re-advertised mark.

Held, disallowing the application

- The principles of res judicata are as stated in the Reebok case. They are (1) whether there has been a final judgement or decision (2) whether there is an identity of subject matter or issue in the former and in the present litigation and (3) whether there is an identity of parties.
- The previous opposition proceeded on sections 12 and 15 of the Trade Marks Act 1992. A decision made on these sections cannot said to be interlocutory in nature for a hearing officer must necessarily apply his mind to the law and the evidence before him in deciding the opposition under those substantive grounds. The proper test to be applied of what is final or interlocutory is the test found in the Boszon case. The test is whether “the judgement or order, as made, finally disposes of the rights of the parties; if it does, then it ought to be treated as a final order; but if it does not, it is then an interlocutory order.” The Singapore White Book (Singapore Civil Procedure 2003) further states that “rights of parties” in the Boszon case refers to the “substantive rights in dispute in the particular action in which the application for summary judgement is made.” The decision of the Assistant Registrar Chua Ser Ching in disallowing the previous opposition does dispose of the right of the parties, these rights being the right of proprietorship of the mark NIKE in respect of class 3 goods. Her decision thus cannot be said to be an interlocutory order.
- There is an identity of subject matter or issue in the previous and in the present opposition. Both oppositions will proceed on the same grounds of opposition. The Trade Marks Act does not make a distinction between oppositions against “unaccepted marks” and “accepted marks”.
- There is also an identity of parties. In the Notice of Opposition, 1 of the grounds of opposition is that the “1st opponent and not the applicant is the proprietor of the mark”. In the present opposition therefore, what is essentially to be decided is a proprietorship issue, an issue relating to the 1st Opponent’s rights in the mark. The 2nd Opponent is joined as a party as it operates the Singapore arm of business and is the repository of all evidence of use of the mark within this jurisdiction.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332,1992 Ed) section 18 and Trade Marks Rules rule 23.

Cases referred to:

- Chia Ah Seng v Hong Leong Finance Limited [2001] 1 SLR 591
- Reebok International Ltd v Royal Corp [1988] SLR 921
- Salter Rex & Co v Ghosh [1971] 2 QB 597
- White v Brunton [1984] QB 570
- Official Assignee of the estate of Tang Hsiu Lan, a bankrupt v Pua Ai Seok & Ors [2001] 2 SLR 436
- Re Lee Chu Ming Martin QC and another application [2002] 4 SLR 929
- Abacus Realty Pte Ltd & Or v Indian Overseas Bank [1999] 1 SLR 1
- Boszon v Altrincham Urban District Council [1903] 1 K.B. 547 (Court of Appeal)
- Rank Xerox (Singapore) Pte Ltd v Ultra Marketing Pte Ltd [1992] 1 S.L.R. 73

Representation:

- Mr Patrick Yap (KL Tan & Associates) for the Applicant
- Mrs Ang Su-Lin and Mr Christopher Woo (Harry Elias Partnership) for the 1st and 2nd Opponents

Note:

A Notice of Originating Motion for appeal against the decision of the Assistant Registrar was lodged by Messrs Harry Elias Partnership on the 4 May 2004. The Appeal was heard and dismissed by the Honourable Justice Tay Yong Kwang on the 28 March 2005.

The Appellants have filed a Notice of Appeal against the decision of the High Court on the 27 April 2005.

The appeal to the Court of Appeal was dismissed.