

**In The Matter Of Trade Mark Application No. BT94/04390J
In The Name Of ITC Limited**

And

**Opposition By
Dunhill Tobacco Of London Limited**

*Before Principal Assistant Registrar Ms P Arul Selvamalar
13 January 2004*

Trade Marks – Opposition to registration – Likelihood of deception or confusion – whether there was a reputation in the Opponents’ mark – Section 15 of the Trade Marks Act (Cap 332, 1992 Rev. Ed.)

Trades Marks – Opposition to registration – whether the Application Mark nearly resembles the Opponents’ registered Trade Marks – section 23

Trades Marks – Opposition to registration – Proprietorship of the mark – whether the Applicants are the rightful proprietors of the Application Mark – section 12

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark is capable of distinguishing – section 11

On 1 June 1994, the Applicants, ITC Limited, an Indian company, applied for the registration of a series of two marks which comprised a heraldic device, a pyramid device, the letters “C” and “ITC”, the word Classic, all contained within a rectangular box device with a double frame with other descriptive words. The application was for manufactured tobacco goods in class 34. When the mark was examined, the Applicants were directed to delete the descriptive words but the Applicants also deleted the word ‘Classic’ and the letter ‘C’ from the marks by mistake. The remaining mark which was advertised and opposed, comprised the heraldic device, the pyramid device and the letters ‘ITC’. The Opponents, Dunhill Tobacco of London Limited, own a number of registered DUNHILL trade marks for tobacco products in Singapore and other countries. The Opponents argued that the Applicants’ mark is likely to cause confusion or deception under section 15 and that the Applicants’ mark nearly resembles the Opponents’ registered marks under section 23 as the Applicants intend to use the mark in the same colours as the Opponents’ marks, that the Applicants were not the bona fide proprietors of the Applicants’ mark under section 12 and that the Applicants’ mark is not distinctive under sections 10 and 11.

Held, dismissing the Opposition with conditions and disclaimers imposed on registration,

1. The Registrar was satisfied that the Opponents have a reputation in the business of selling cigarettes under a mark which comprised the word Dunhill, a heraldic device and a burgundy and gold colour scheme. Phonetically and visually, the Application Mark and the Opponents’ Mark were found to be different in a number of ways. Visually, their respective heraldic devices were noticeably different in design and the degree of elaboration. Phonetically, the letters ‘ITC’ were very different from the word ‘Dunhill’. However, it was found that if the application mark is used in burgundy/red/maroon and gold, there is a likelihood of confusion. The Registrar found that there was insufficient evidence to establish that the said colour scheme is common in the cigarette industry as argued by the Applicants. The opposition under section 15 failed except that the use of the Applicants’ mark in Burgundy/maroon/red and gold would lead to confusion. Therefore a condition was imposed on the registration that the mark should not be used in burgundy/red/maroon and gold.
2. The opposition under section 23(1) also failed for the same reasons except that confusion or deception is likely if the application mark is used in burgundy/red/maroon and gold. Thus the Applicants’ mark could proceed to registration on condition that the mark shall not be used in the colours red/burgundy/maroon and gold.
3. Given the various differences between the 2 marks, the Registrar was not convinced that the Application Mark created a total impression of similarity with the Opponents’ Trade Marks. Even if the Application Mark is used in burgundy/red/maroon and gold and a similarity is established, that alone is insufficient evidence to establish that the Applicants have acted in bad faith. The opposition under section 12(1) failed.

4. The Registrar found that the Application Mark was distinctive and the opposition under sections 10 and 11 failed. However it was clear from the evidence that the mark is intended to be used with the word 'Classic' and that this word and the letter 'C' were deleted from the mark by mistake. Therefore it was directed by the Registrar that the Application Mark be amended to include the word "Classic" and the letter "C", but a disclaimer will be imposed over the word 'Classic'.

Provisions of legislation discussed

- Trade Marks Act (Cap 332, 1992 Rev. Ed) Sections 10, 11, 12, 15 and 23.

Cases referred to:

- Al Bassam TM [1995] RPC 511
- Aristoc v Rysta [1945] RPC 68
- Bali TM [1969] RPC 472
- Bass, Ratcliffe and Gretton (1902) 19 RPC 529
- Carnival Cruise Lines Inc v Sitmar Cruises Ltd (1994) 31 IPR 375
- Castrol Limited's Trade Mark [1972] RPC 531
- Christiansen (1886) 3 RPC 54
- De Cordova v Vicks Chemical Co [1951] 68 RPC 103
- Dewhurst [1896] Ch 137; 13 RPC 188
- Flowstacka [1968] RPC 66
- Hack's Application (1941) 58 RPC 91
- Harrods Application [1935] 52 RPC 65
- Kellogg Co v Pacific Food Products Sdn Bhd [1998] 3 SLR 28
- Lee Cooper Group plc v Levi Strauss & Co [1995] AIPR 457
- Lyle and Kinahan (1907) 24 RPC 249
- Morning Star Co-op Society v Express Newspapers [1979] FSR 113
- Newsweek v British Broadcasting Corp [1979] RPC 441
- Perfumes of Singapore (Pte) Ltd v Raffles Hotel (1886) Pte Ltd [1993] AIPR 278
- Pianotist Co's Application [1906] 23 RPC 774
- Polo/Lauren Co LP v United States Polo Association [2002] 1 SLR 326
- Re Wong Seng & Sons Bhd's Application and Salamander AG's Opposition [1993] AIPR 252
- Re Worthington Co's TM (1880) 14 Ch D 8
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Seven Up Co. v. OT Ltd (1947) 75 CLR 203
- Smith Hayden's Application [1946] 63 RPC 9
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- TIME TM [1961] RPC 381

Representation:

- Ms Tang Yock Miin with Mr Adrian Tan (Gurbani & Co) for the Applicants
- Mr Gilbert Leong with Ms Elaine Liew (Rodyk & Davidson) for the Opponents

NB: The appeal from this decision to the High Court was dismissed.