

**In The Matter Of A Trade Mark Application By
Boonsueb Chanarat
(Assigned To Audace Industries CO Ltd)
To Register A Trade Mark In Class 3,**

And

**Opposition Thereto By
Pharmacia & Upjohn Company**

*Before Principal Assistant Registrar Ms. Anne Loo
13 February 2004*

Trade Marks – Opposition to registration – Proprietorship of the mark – whether the Applicant was the lawful proprietor of the application mark – whether the mark was registered in good faith - Section 12(1) of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – Likelihood to deceive or cause confusion that would disentitle the mark to protection in a court of justice or would be contrary to law if it was registered – whether there was reputation in the Opponent’s mark before the date of application of the Applicant’s mark - Section 15 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – whether the application mark was identical or nearly resembles a registered trade mark belonging to a different proprietor in respect of the same goods or the same description of goods - whether the goods of the Applicant are the same goods or have the same description of goods as those of the Opponent’s mark - Section 23 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

The Applicants Audace Industries Co Ltd (through the assignor Boonsueb Chanarat) had applied for the word mark “REGAN” on 15 April 1995 for “haircare products, hair lotion, hair tonic, hair cream, perfumery, soaps, skin care products and cosmetics” in Class 3. The Opponents Pharmacia & Upjohn Company, lodged a Notice of Opposition against the trade mark application relying on sections 12(1), 15 and 23 in their opposition. The Opponents contended that they were the registered proprietors in Singapore for the marks (TM/1383/85) “REGAINE” in Class 5 for “pharmaceutical preparations”, and “PREGAINE” in Class 3 for “preparations (non-medicated) for hair and scalp”. They also contended the Applicant had not registered their mark in good faith and that registration of the Applicant’s mark would give rise to a real or tangible danger of confusion to the public as to the origin and source of the goods. The Opponents submitted that there was substantial overlap between the description of goods as between Class 3 and Class 5, and this together with a identical or similar trade mark by the Applicant, would give rise to a reasonable likelihood of deception or confusion arising among a number of persons.

Held, allowing the Opposition

1. The opposition under section 12(1) failed. The Applicants are the lawful proprietors of the mark “REGAN”. There is no evidence of bad faith on the part of the Applicants. The Applicants had showed evidence that the mark “REGAN” was independently created by one of the Applicants’ directors, and had been in use in Thailand, Malaysia, Indonesia and Brunei without objections from the Opponent.
2. The opposition under section 23 succeeded. Under this ground of opposition, a determination must be made as to whether the Opponent’s goods for which the marks “REGAINE” and “PREGAINE” are registered for the same goods or for goods of the same description as the Applicants goods for the application mark “REGAN”. Then, the Applicants’ mark “REGAN” must be compared to the Opponents’ registered marks “REGAINE” and “PREGAINE” to determine if they are identical with or so nearly resembles each other. Finally, whether there was a reasonable likelihood of deception or confusion if the Applicants mark proceeded to registration.
3. The relevant considerations in deciding whether goods are of the same description are the nature and composition of the goods, the respective uses of the articles and the trade channels through which the commodities were bought and sold. There is an overlap in the headings of Class 3 and Class 5 in the Nice Agreement for the Classification of goods. The use and purpose of the goods are the same; both the Opponents’ and the Applicants’ goods are sold and advertised as solutions or treatments for prevention of

hair loss and for stimulation of hair growth. There is an overlap in respect of trade channels; both the Opponents' and Applicants' goods are sold commonly in pharmacies.

4. The marks "REGAN" and "REGAINE" are identical to or closely resemble each other, as they are aurally and visually similar. Inaccurate and imperfect pronunciation of the words would lead to confusion of one for the other.
5. There is a high likelihood that the target consumers of these products, which are individuals with hair loss problems, when confronted with the similarity of the marks "REGAN" and "REGAINE" would be confused into thinking that the marks emanate from the same source.
6. The Opponents succeeded in their opposition under Section 15. The Opponents have adduced evidence that shows that they had established use and reputation in their mark at the date of the application for the Applicants' mark "REGAN". The marks "REGAN" and "REGAINE" also closely resemble each other. Taking into account all the circumstances of the case, there is a real and tangible risk that there will be confusion among a substantial number of persons if the Applicants' mark "REGAN" is allowed to proceed to registration.
7. The Opponents are entitled to a contributions towards their costs and the Applicant is ordered to pay two-thirds the taxed costs of this opposition to the Opponents.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1992 Rev Ed.) Sections 12(1), 15 and 23.

Cases referred to:

- The Pianotist Company Ltd's Application [1906] 23 RPC 774
- Aristoc v Rysta Ltd [1943] 60 RPC 108
- Smith Hayden & Co's Application [1946] RPC 97
- In the matter of an Application by Laslidas Jellinek for the Registration of a Trade Mark [1946] 63 RPC 59
- De Cordova v Vick [1951] 68 RPC 103
- Gaines Animal Foods Ltd's Application for a Trade Mark [1958] RPC 312
- Players TM [1965] RPC 363
- Bali TM [1969] 86 RPC 472
- Kellogg & Co. v Pacific Food Products Sdn Bhd [1998] 3 SLR 28
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Polo/Lauren Co LP v United States Polo Association (2002) 1 SLR 326

Representation:

- Ms Moi Sok Ling (M/s Khattar Wong & Partners) for the Applicants
- Ms Gooi Chi Duan (M/s Donaldson & Burkinshaw) for the Opponents