

**In The Matter Of An Application To Rectify Trade Mark Registration No. 511/89 In The Name Of
Topifram Laboratories, Inc**

By

Roussel Uclaf

*Before Principal Assistant Registrar P Arul Selvamalar
17 March 2004*

Trade Marks – Application for Rectification – Likelihood of Confusion – whether goods are of the same description – sections 15 and 23 of the Trade Marks Act (Cap 332, 1992 Rev. Ed.)

The Applicants for rectification, Roussel Uclaf, owned a registered Trade Mark No. 65978 TOPIFRAM, registered since 1975, in class 5, for “a medical dermatological preparation for topical use”. They applied for Trade Mark No. 511/89 TOPIFRAM, registered since 1989 in the name of Topifram Laboratories, Inc, in class 3, for “Preparations for the hair, shampoos, depilatory preparations, soaps, cosmetics, preparations for use in waving the hair, perfumes, toilet preparations and skin cream for care of skin, all being non-medicated” to be expunged from the Register. The Applicants’ grounds were that the Respondents’ mark was confusingly similar to their mark TOPIFRAM under sections 15 and 23, that the Respondents were not the lawful proprietors of the mark under section 12 and that the Respondents were infringing the Applicants’ prior registered mark under section 45 of the Trade Marks Act. The Respondents did not file any evidence after filing the Counter Statement and did not attend the hearing.

Held, allowing the application for rectification of the register,

1. The Registrar found that the marks were the same and that although the goods were in different classes, class 3 and class 5, they were both skin creams, one for medicated use and the other for non-medicated use. The Registrar followed the **BENSYL TM** case and found that whether the goods were in the same class or in different classes did not determine whether they were of the same description. The Registrar also followed the **Harker Stagg** case and found that when pharmaceutical goods were involved, the danger of confusion is something the public should be protected from. It was found that there was a likelihood of confusion under sections 15 and 23.
2. The Registrar found that a key ingredient to a successful opposition under section 12 is a misappropriation of the mark by the applicant following the **Tiffany & Co case**. It was found that there was insufficient evidence that the Respondents misappropriated the mark from the Applicants. The application for rectification failed on this ground.
3. It was found that if the Respondents’ mark had not been registered, it would constitute infringement of the applicants mark. However as the Respondents’ mark was registered, the application for rectification under section 45 failed.
4. Registered Trade Mark No. 511 of 1989 was expunged from the Register with effect from 17 June 2004.

Legislation referred to:

- Trade Marks Act (Cap 332, 1992 Rev Ed) Sections 12, 15, 23 and 45.

Cases referred to

- Smith Hayden & Co Ltd’s Application (1946) 63 RPC 97
- Pianotist Co Ltd’s Application (1906) 23 RPC 774
- M1 & M Corp & Anor v A MoHamed Ibrahim [1964] MLJ 391
- Otsuka Pharamaceutical Co Ltd v Farmitalia Carlo Erba SpA [1995] AIPR 86
- Harker Stagg Ltd’s TM [1953] 70 RPC 206
- Chugai Seiyaku v Elf Sanofi UK Ltd [1995] AIPR 371
- Players TM [1965] RPC 363
- Bali TM [1969] 86 RPC 472
- G.E. [1973] RPC 297
- Woodies [1965] RPC 366
- Erectiko [1935] 52 RPC 126

- Gaines Animal Foods Ld's Application [1958] RPC 312
- BENSYL TM [1992] RPC 529
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147

Representation:

- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Applicant for Rectification
- Respondents – absent