

**In The Matter Of An Application By
Mrs Agnes Trouble
To Register A Trade Mark**

And

**Opposition Thereto By
Crocodile International Pte Ltd**

*Before Principal Assistant Registrar Ms. Anne Loo
11 May 2005*

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 Applicant’s mark is confusingly similar to one or more of the Opponent’s marks – Section 23 of the Trade Marks Act (Cap. 332, 1992 Rev.Ed.)

The Applicant filed an application for a device mark in Class 25 in respect of “Clothing for men, women and children; headgear; but not including footwear; all included in Class 25.” on the 30 January 1997. The device mark comprised a detailed line drawing of a lizard. The Applicant deposed that the “LIZARD” device mark had been used on clothing, headgear and bags in Singapore since April 1997, and that advertising and promotional activities in relation to use of the “LIZARD” device mark had been carried out extensively in Singapore.

The Opponent, Crocodile International Pte Ltd, opposed the registration of the mark under sections 15 and 23 of the Trade Marks Act (Cap. 332, 1992 Rev Ed.). The Opponent contended that it is the registered proprietor of a series of trade marks: marks bearing the word “LIZARD” or “LIZARD AND HOUSE-LIZARD”, marks bearing the device of a lizard, marks bearing both the word “LIZARD” and device of a lizard in combination and the “CROCODILE” marks. The Opponent had widely used these marks on goods sold and marketed in the Opponent’s boutiques and counters in Singapore. As a result of the extensive use, the Opponent had built up its goodwill and reputation and the Opponent’s marks had become a household name in the fashion apparel and accessories industry. The Opponent also claimed to be the proprietor of an unregistered “LIZARD” mark.

The Opponent stated that although the Applicant’s and the Opponent’s “LIZARD” marks are visually different, there exists a distinct possibility of oral confusion between the Opponent’s registered mark T54/18627A for the words “LIZARD AND HOUSE-LIZARD” and the Applicant’s “LIZARD” device mark.

In respect of the Opponent’s “CROCODILE” marks, the Opponent submitted that these form a “series” of marks with the common feature being the device of the crocodile. As the Applicant’s “LIZARD” device mark contains reptilian features similar to the crocodile device, the public might be confused or deceived into believing that the Applicant’s mark is an extension of the Opponent’s “CROCODILE” marks.

Held, dismissing the Opposition

1. Three elements must be satisfied under the section 23 ground of opposition: firstly, the marks must belong to different proprietors and the Opponent’s mark must already be on the register; secondly, the Opponent’s and the Applicant’s marks must be identical or so nearly resembling each other; and finally, the Opponent’s and the Applicant’s marks must be in respect of goods that are either the same goods, or goods of the same description. The first and third requirements being satisfied, the onus is on the Applicant to show that the marks are not identical nor do they resemble each other so closely in relation to the same goods or goods of the same description, such that there will be reasonable likelihood of deception or confusion arising among a number of persons. The test to be applied is the test formulated in Smith Hayden & Co’s Application
2. Applying the case of Pianotist Co’s Application to determine the similarity of marks, the Applicant’s and the Opponent’s “LIZARD” marks are visually different. In addition, by comparing the Opponent’s word mark, “LIZARD AND HOUSE-LIZARD” and the Applicant’s “LIZARD” device mark, there cannot be any likelihood of confusion as these marks are conceptually different. Further, the device of the crocodile

in the Opponent's "CROCODILE" marks is visually distinct from the Applicant's "LIZARD" device mark and conceptually, the idea the marks portray is also different. There is no real tangible danger of confusion if the Applicant's mark is allowed registration. The opposition under section 23 fails.

3. From the evidence filed by the Opponent in their statutory declarations, there is no evidence of use of the marks "LIZARD AND HOUSE-LIZARD" and of the mark with the device of a lizard. As for the Opponents' unregistered "LIZARD" mark, the Opponent only commenced use of the unregistered mark more than 4 years after the application date. Hence the Opponent had not established that their "LIZARD" marks and the unregistered "LIZARD" mark have either reputation or use at the material date of 30 January 1997. The opposition under the ground of section 15 fails.
4. The Applicant's "LIZARD" device mark and the Opponent's "CROCODILE" marks are also not similar and there is no real and tangible risk that there will be confusion among a substantial number of persons if the Applicant's mark is allowed to proceed to registration. The opposition under the ground of section 15 also fails.

Cases referred to:

- Accutron (1966) RPC 152
- Application by Li Long Yu & Ors Trading as Chan Li Chai MLJ Volume 10 1941
- Bali Trade Mark 1969 RPC 472
- Bulova Accutron T.M. [1968] F.S.R. 336
- De Cordova v Vick (1951) 68 RPC 103
- Dunhill v Bartlett & Bickley 1922 Vol.39 RPC 426
- Frigiking (1973) RPC 739
- Hack's Application (1941) 58 RPC 91
- Harker Stagg Ld.'s Trade Mark [1953] RPC 20
- Harker Stagg Ld.'s Trade Mark [1953] RPC 205
- Hubbuck v Brown (1900) 17 RPC 638
- 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 [1999] 2 SLR 651 Kleenoff (1934) 51 RPC 129
- Payton v Snelling (1900) 17RPC 628
- Philips (1969) RPC 78
- Pianotist Co's Application (1906) 23 RPC 774
- Polo/Lauren Co LP v United States Polo Association (2002) 1 SLR 326
- Ravenhead Brick v Ruabon (1937) 54 RPC 341
- Sandow (1914) 31 RPC 196
- Seixo v Provezende (1865) L.R. 1 Ch 192
- Smith Hayden & Co's Application (1945) 63 RPC 97
- Thermos Prima
- Tiffany & Co. v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Wilkinson v Griffith (1891)8 RPC 370

Representation

- Mr. Lim Keng Boon (Administrative and Legal Manager of Crocodile International Pte Ltd) for the Opponent.
- Mr. Paul Teo assisted by Ms. Ho Wei Yen (M/s Drew & Napier) for the Applicant.