

**In The Matter Of A Trade Mark Application
S-Lite Marketing Pte Ltd**

And

**Opposition Thereto By
Tan Eng Hoe t/a A1 Foodstuff Trading**

*Before Principal Assistant Registrar Ms. P Arul Selvamalar
19 May 2005*

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected - Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4)a of the Trade Marks Act 1998 [Cap. 332]

The Applicants are S-Lite Marketing Pte Ltd, a Singapore company, who filed an application No. T03/00493A for a trade mark on 22 January 2003 for the mark “Action One A1” in colour with a device of a left hand with the forefinger pointing upwards. This device is in a circle which represents the capital letter O in the word One in the mark. This application was made in class 30 for the goods, “spices”.

The Opponent, Tan Eng Hoe is a Malaysian citizen trading as A1 Foodstuff Trading. The Opponent had applied for registration of a trade mark Action One & device (without the letter and numeral A1) in Malaysia on 28 April 2000. He applied for the registration of the mark Action One & device plus the letter and numeral A1 in Malaysia on 18 August 2001. The Opponent has filed an application for the mark Action One & device (without the letter and numeral A1) on 13 October 2003 in Australia. These marks have all not gone into registration.

The Opponent states that the Opponents’ goods namely spices have been sold in Malaysia since 1989 and in Singapore since 1993, under the brand A1. The Opponent redesigned his brand in 2000, resulting in the mark comprising the words Action One and the device of a left hand with its forefinger pointing upwards in the letter O of the word One. The Opponent’s sales in Malaysia and Singapore grew from \$80,000 Malaysian Ringgit in 1993, to \$612,103 in the year 2001 and then there was a decline in the year 2002 to \$455,437. The Opponent also stated that he had started selling his products in Australia, Canada, the USA, Thailand and Indonesia.

The Opponent argued that the application was made in bad faith. He tendered evidence that the Applicants were appointed a distributor of their goods in 2001, and submitted that because of the appointment, the Applicants must have known about the Opponent’s trade mark rights when they applied for the mark in dispute in this opposition. Further, there was a lack of a satisfactory explanation as to why the mark was chosen by the Applicant. The Opponent pointed out that the Applicants had no connection with the name Action One A1 & device whereas the Opponent had been using the mark A1 and had commissioned the design of Action One.

The Opponents also submitted that their mark was a well known mark under section 8(2b) of the Act and that therefore registration of the Applicants’ mark would cause confusion.

Lastly, the Opponents argued that the Applicants are guilty of passing off their goods as the Opponent’s. Despite the fact that the Opponent did not distribute his goods personally in Singapore, he contended that the principle that a business located overseas may acquire goodwill in this country by the supply of its products or services through a subsidiary, agent or license, applies in this case.

The Applicants reiterated that they used the mark Action One A1 & device since October 2000 and that they sold the Opponent’s products under the Applicants’ brand. Therefore the Applicants did not act in bad faith in making the application for the mark. They also submitted that there is no evidence that the marks had caused confusion. They also argued that the sales figures filed by the Opponent were not supported by any documentary evidence and that if the Opponent was the rightful owners of the trade mark they would have taken steps to register it.

Held, disallowing registration

1. There is no evidence from the Applicants as to the creation of the mark. On the other hand, there is evidence that the Opponents designed their mark in April 2001. The evidence further shows that the Opponent was the first to use the mark and that the Applicants were the distributors for the Opponent. When the Applicants applied for the mark Action One A1 & device, the director knew that it was a mark used by the Opponent. The inference that may be reasonably drawn is that the application was made in bad faith. The opposition under section 7(6) therefore succeeds.
2. The Opponent does not have a registration of his mark in Singapore which predates the Applicants' application. Therefore he argued that his mark was a well known mark. Even taking into account the Opponent's evidence of use of the mark in Singapore and Malaysia and the promotion of the mark in Singapore, the evidence is insufficient to establish that the Opponent's mark is a well known mark. Therefore there is no need to consider whether the marks are similar and whether the goods are similar and whether there would be confusion. The opposition under section 8(2b) fails.
3. The Opponent's evidence of use of the mark in Singapore and Malaysia and the Opponent's promotion activities in Singapore is insufficient to establish that the Opponent's mark has the type of reputation or goodwill required for the tort of passing off. There is no need to consider whether there is misrepresentation or damage. The opposition under section 8(4a) fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(6), 8(2b), and 8(4a).

Cases referred to:

- Application by Brown Shoe Co Inc [1959] RPC 59
- Vitamins Ltd's Application [1956] RPC
- Erven Warnick BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Tong Guan Food Products Pte Ltd v Hoe Hng Foodstuff Pte ltd [1991] SLR 133
- RH Macy & Co Inc v Trade Accents [1992] 1 SLR 581
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- Travelpro TM [1997] RPC 864
- Yoo Hoo Chocolate Beverage Corporation (SRIS 0/100/97)
- Be Natural (SRIS 0/106/99)
- Sabel v Puma [1998] RPC 199
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- Scandecor Development v Scandecor Marketing [1999] FSR 26
- Royal Enfield TM [2002] RPC 24

Representation

- Mr Satwant Singh (Sim Mong Teck & Prs) for the Applicants
- Ms Yvonne Tang (Drew & Napier) for the Opponents