

**In The Matter Of A Trade Mark Application By
Rock International Singapore (Pte) Ltd**

And

**Opposition Thereto By
The London Tobacco Company Limited**

*Before Principal Assistant Registrar Ms P Arul Selvamalar
15 June 2005*

Trade Marks – Opposition to registration – whether the application mark was distinctive - Section 7(1) of the Trade Marks Act 1998 [Cap. 332]

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 Applicant is Rock International (Singapore) Pte Ltd, who filed an application T01/18797D on 7 December 2001, for a mark containing the word “BONJOUR” above a device comprising the Eiffel tower with two birds, one on each side of the tower. The application was made in class 34 for the goods, “Tobacco, tobacco products, cigarettes, cigars, smokers’ articles and smokers’ requisites”. The application was accepted for registration and advertised on 30 December 2002 for opposition. The Applicant states that their mark has been registered in other countries since 1999. The Applicant states that their Bonjour mark has been used in Singapore since March 2002 and that they have been selling their cigarettes to countries outside Singapore even before they applied for the mark in Singapore in 2001.

The Opponent is a member of the British American Tobacco Group of Companies. The Opponent or its BAT group affiliates are owners of the trade mark London either as a word mark or in combination with various label designs, in more than 150 countries around the world. In Singapore they are the owners of the following registrations, T80/03719, T97/07159, T99/01055 and T00/13257. The Opponent states that they have been using their mark since 1980 in the Middle East and that it is now sold in more than 45 countries including Singapore. The Opponent states that their London brand of cigarettes has been widely advertised and promoted through various media including television, radio, outdoor posters, billboards, print and by point of sale material and other merchandising activities. The London brand was first sold in Singapore in September 2001, although there is no evidence of advertising and promotion activity in Singapore specifically.

The Opponent contended that the Applicant’s mark was confusingly similar to their marks. They submitted that although the mark is applied for in black and white, the Registrar may take into account the actual use of the Applicant’s mark. The Opponent also contended that the principle of imperfect recollection should apply, especially where cigarettes are placed behind a counter because then the words in the marks are not obvious. They also submitted that consumers with sufficient knowledge would recognise that Bonjour is a French word and that that knowledge would reinforce the impression created by the Eiffel tower which evokes the city of Paris. Further, because of the reputation of the Opponent’s marks, the risk of confusion would be higher, and that confusion or deception have no borders and can arise as easily from knowledge, cognisance or awareness of an international reputation.

The Opponent submitted that the Applicant deliberately chose a cigarette pack which is specifically designed to trade off the main attributes of the Opponent’s product in a manner calculated to deceive or confuse the average consumer in Singapore. Therefore it may be inferred that the Applicant is trying to usurp the Opponent’s goodwill by passing off their goods as the Opponent’s.

The Opponent submitted that new traders have a desire to copy well established marks and submitted that in

relation to tobacco products the desire to copy well established marks was great, especially in Singapore where advertising tobacco products was restricted.

The Opponent also submitted that in considering distinctiveness, it is necessary to consider other marks in use in the industry, and that because of the Opponent's reputation in and extensive use of their mark, the Applicants' mark is not capable of distinguishing the Applicant's goods from the Opponent's goods.

The Applicant argued that the marks were not confusingly similar. They submitted that the only possible similarity is in the use of the colour gold by both parties but they submitted that the Opponent does not have the right to monopolise the use of the colour gold. The Applicant also submitted that the test should be that of the ordinary person with ordinary intelligence having reasonable time to observe and pay a little attention to what he is doing. The Applicant submitted that they did not pass off the Applicant's goods as the Opponent's goods.

The Applicant submitted that an allegation of bad faith should not be made unless it can be fully and properly pleaded, that such an allegation should not be proved by inference alone, and that an allegation that the Applicant was aware of the use and worldwide reputation of the Opponent's trade marks is not sufficient to sustain an objection based on bad faith. The Applicant also submitted that the question of distinctiveness should be determined only with reference to the mark under consideration.

Held, allowing the application mark to proceed to registration:

1. There is no risk of aural confusion of the marks. There is very little risk of visual similarity in the words and the devices of the Opponent's and the Applicant's marks. In considering the issue of confusion, a number of factors are relevant when deciding oppositions against trade marks that are meant to sell cigarettes. In Singapore, the sale of cigarettes is restricted. Therefore a customer must ask a counter assistant to retrieve a packet of cigarettes. Further the legal requirement for a health warning to be placed prominently on the front and back of cigarette packets diminishes the importance of the distinguishing visual features of cigarette packs. Taking these factors into consideration, and on a comparison of all the elements of the marks, the marks are not confusingly similar. The ground of opposition under section 8(2b) therefore fails.
2. The Opponent is not arguing that any particular feature of the Applicants' trade mark has become common in the trade and that therefore it is not distinctive. Instead, the Opponent has tried to persuade the Registry that in order to judge whether a mark is distinctive, one must look at the other trade marks which it is alleged were in use at that time. Specifically, they are also arguing that the Applicant's mark is not distinctive only because of the Opponent's reputation in their marks. These arguments cannot be made under section 7(1) as the question of whether a mark is distinctive should be decided by considering the mark in question only. The ground of opposition under section 7(1) therefore fails.
3. The Opponent submitted that there was some copying by the Applicant of the Opponent's marks. The finding of bad faith must be made from the facts of each case. There is insufficient evidence to infer bad faith in this case. The onus of proving bad faith is on the Opponent and they have not discharged it. The case precedent for the Opponent is dated and is not persuasive. The ground of opposition under Section 7(6) therefore fails.
4. There is no likelihood of confusion under section 8(2b). There is no risk of deception or confusion between the Applicant's mark and the Opponent's marks under the ground of passing off, for the same reasons discussed above. The Opponent did not submit on damage and there is also no evidence of damage. The ground of opposition under section 8(4a) therefore fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(1), 7(6), 8 (2b), and 8(4a).

Cases referred to:

- Worthington's TM (1880) 14 Ch Div 8
- Christiansen's TM (1886) 3 RPC 54
- Bass Ratcliffe & Gretton, Ld's Application (1902) 19 RPC 529.
- Pianotist Co's Application (1906) 23 RPC 774
- Australian Woollen Mills v Walton [1937] CLR 641
- Hacks Application (1941) 58 RPC 91
- Application by Hardings Manufacturers (1987) 8 IPR 147

- Saga Foodstuffs v Best Food [1995] 1 SLR 739
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Sabel BV v Puma AG (1997) 48 IPR 716
- CDL Hotels International Ltd v Pontiac Marina Ltd [1998] 2 SLR 550
- Kellogg Co v Pacific Food Products [1999] 2 SLR 651
- Tiffany & Co v Fabriques de Tabac [1999] 3 SLR 147
- Jos' the Boss (SRIS 0/170/99)
- Lloyd Shuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd [2000] 4 SLR 360
- Polo/Lauren Co LP v United States Polo Association [2002] 1 SLR 326
- Royal Enfield TM [2002] RPC 24
- Granada TM [1979] RPC 303, MacDonald's v Future Enterprises [2005] 1 SLR 177

Representation

- Mr Boey Swee Siang & Mr Daniel Chan (Yu Sarn Audrey & Prs) for the Applicants
- Mr Gilbert Leong & Mr Koh See Khiang (Rodyk & Davidson) for the Opponents