

**In The Matter Of A Trade Mark Application By
Tasco, S.A.
To Register A Trade Mark In Class 9**

And

**Opposition Thereto By
Tequila Cuervo, S.A. de C.V.**

*Before Principal Assistant Registrar Mr Dennis Low
10 December 2004*

Trade Marks – Opposition to registration – whether the opponents had a reputation – whether registration of the application mark would cause confusion or deception - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – Proprietorship of the mark – whether the Applicants are the rightful proprietors of the Application Mark – section 12

The Applicants applied for the registration of a word mark ‘Tequila’ (‘the Application Mark’) on 20 June 1996 for “advertising, direct mail advertising, publicity material rental; business assistance for commercial and industrial companies; business management and organization consultancy and assistance; statistical processing and data processing; accounting; reproduction of documents; employment agencies; office machines and equipment rental; service of advertising agency; distribution of prospectus, samples; organization of exhibitions for commercial or advertising purposes” in class 35.

The Opponents, Tequila Cuervo, S.A. de C.V., are the manufacturer and distiller of the Tequila beverage. The Opponents are opposing this application relying on sections 12 (1) and (2) and 15(1) of the Trade Marks Act (Cap 332, 1992 Revised Edition) (the ‘Act’).

The Opponents stated that they are registered proprietors and applicants for registration of marks which include the word ‘tequila’ (‘the Tequila marks’) in respect of a variety of goods worldwide. The Opponents contended that the Application Mark should not be registered because of its visual and aural similarity with the Tequila marks owned by them and thus would be contrary to section 15 of the Act. The Opponents also submitted that the use of the Application Mark on its specified services is likely to deceive or cause confusion amongst the public as to whether the Applicants’ services are those of the Opponents’ or that there is some connection and/or association between the Applicants’ services and the Opponents’ goods when in fact such connection and/or association does not exist.

The Opponents further contended that, by reason of the prior registrations and extensive use of the Tequila marks and by reason of the fact that the Application Mark is so similar to the Tequila marks, the Applicants cannot claim to be the bona fide proprietor of the Application Mark. Therefore, The Opponents submitted that therefore the registration of the Application Mark would be contrary to Section 12(1) of the Act.

Held, dismissing the Opposition

1. The opposition under section 15(1) fails. Although Tequila as a name of an alcoholic beverage from Mexico has established goodwill and reputation in Singapore, such goodwill and reputation is mainly confined to the alcoholic beverage industry. The Opponents had furnished some evidence relating to the interests of alcoholic manufacturers in advertising services, however, it was found that the evidence in this case was insufficient to substantiate that the same reputation of Tequila beverage extends to advertising services, or that there was a strong the nexus between alcoholic beverage and advertising services. Taking into account all the relevant factors, such as the circumstances in which the Application Mark would be used and the character of the probable purchasers of the services, in this case it was found that the Opponents’ claim of a real risk or real tangible danger of confusion was not well founded.
2. The opposition under section 12(1)-(2) fails. Misappropriation is the key ingredient to establish in order for an opposition under Section 12 to succeed. In this case, the Applicants’ explanation of how they had derived the Application Mark was found to be reasonable. The Applicants’ use of the Application mark was found to be honest as there were prior applications/registration of the Application Mark in various

countries and in Class 16 in Singapore, as well as evidence to show sufficient use of the Application Mark in Singapore as at the relevant date.

Provisions of legislation discussed

- Trade Marks Act [Cap. 332, 1992 Revised Edition], Sections 12(1)-(2) and 15(1).

Cases referred to:

- Hunt-Wesson Inc's Trade Mark Application [1996] RPC 233
- Tiffany & Co. v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Decision No. 1645/2001 of the OHIM in Re Budweiser (9 July 2001)
- Smith Hayden & Co. Ltd's Application (1946) 63 RPC 97
- Lancer Trade mark [1987] RPC 303
- Southern Cross v. Toowomba Foundry [1954] 91 CLR 592
- Perfumes Of Singapore (Pte) Ltd v Raffles Hotel (1886) Pte Ltd [1993]
- Florence Line SRL v Advance Magazine Publisher Inc. [1995] AIPR 642
- Granada Trade Mark [1979] RPC 303
- Pianotist Co's Application (1906) 23 RPC 774
- Lego System A/S v Lego M Lemelstrich [1983] FSR 155
- Koyo Seiko Kabushiki Kaisha's Application for a Trade Mark [1957] RPC 297
- Gaines Animal Foods Pte Ld's Application for a Trade Mark [1958] RPC 312
- Application by Brown Shoe Company Inc. [1959]

Representation

- Ms Koay Min Pin (M/s Donaldson & Burkinshaw) for the Applicants
- Ms Lim Siau Wen (Drew & Napier LLC) for the Opponents