

**In The Matter Of A Trade Mark Application By
Trend Promoters (Malaysia) Sdn Bhd
And**

**Opposition Thereto By
Simmons Company**

*Before Principal Assistant Registrar Ms. P Arul Selvamalar
16 February 2005*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the definition of a trade mark under section 2(1) and the requirements under Section 7(1) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is identical or 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 - Sections 8(1) and 8(2) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

Trade Marks – Opposition to registration – whether the Applicants use of the application mark would constitute passing off - Section 8(4)(a) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

The Applicants, Trend Promoters (Malaysia) Sdn Bhd, filed an application on 10 August 1999 for the mark, “Paolo Simmons with a device”, in Class 24 for “bed clothes, bed covers, bed linen (except clothing), bed spreads, calico, calico cloth (printed), diapered linen, face towels of textiles, furniture coverings of plastic, covers for furniture (loose), handkerchiefs of textiles, knitted fabric, linen cloth, lingerie fabrics, mattress covers, non-woven textile fabrics, printer’s blankets of textiles, pillowcases, table cloths (not of paper), table linen (textiles), table mats (not of paper), table napkins of textiles, tapestry (wall hangings) of textiles, all included in class 24”. The Opponents, Simmons Company, an American company or their Singapore subsidiary own registrations of marks which comprise or contain the word Simmons, for goods in Class 20 or 24 in Singapore. The Opponents filed an opposition on the grounds that the marks are identical, confusingly similar, or well known and that the application is therefore objectionable under section 8(1), 8(2) and 8(3) of the Trade Marks Act (Cap. 332, 1999 Rev Ed) (“the Act”). They also cited sections 7(5) and 8(4)(a) and argued that the registration would be contrary to the law of passing off. They also argued that the application was made in bad faith and pleaded section 7(6) of the Act. The Opponents also argued that the Applicants mark did not satisfy the definition of trade mark under section 7(1)(a) of the Act.

Held, disallowing registration,

1. The plea under Section 8(1) fails. The Opponents argued that the Applicants mark is identical to their prior registered marks as the prominent word in both marks is the word Simmons. Their submission on whether the goods were similar was simply that the goods are similar, if not identical. The decision in SA Societe LTJ Diffusion case was approved and hence, under Section 8(1) of the Act, the requirement of identity of marks should be interpreted strictly. A strict interpretation is appropriate for a consideration under section 8(1) as the identity of marks and identity of goods leads to a presumption of confusion and therefore the Opponents need not prove that there would be likelihood of confusion to succeed in opposing the mark. The Opponents mark which is registered in class 24, “Simmons Gallery Picture the Possibilities in Bed” on a device of a head board and the Applicants mark which is Paolo Simmons with a device, are not identical and they do not contain differences so insignificant that they may go unnoticed by an average consumer.
2. The plea under section 8(2)(b) succeeds. For the comparison of marks under this section, the Registrar took into account the Opponents marks that are registered in both Classes 24 and 20. With regard to Class 24, the Opponents mark comprises a device of a headboard with the words Simmons and the word Gallery below the word Simmons, and with the tag line Picture the Possibilities in Bed below both words. It has been registered in respect of “bed linen, bed spreads, bed covers and pillow cases”. These goods are identical with some of the Applicants goods and the remainder goods are similar to the remainder of the

Applicants goods. The distinctive and dominant component of both the Opponents mark and Applicants mark is the word Simmons. In terms of visual comparison, the marks look different except for the word Simmons. This is mainly because the words in the Opponents mark are set on a back drop of the head board and because of the additional elements in both marks. However, marks are not only remembered visually they are also remembered aurally and conceptually. The average consumer would not have the two marks side by side to make a detailed comparison. Instead, he would have a picture or a memory of the Opponents mark in his mind, and the question is whether, when he sees the Applicants mark would he be confused, or is there a likelihood that a substantial number of average consumers would be confused. Since the dominant and distinctive part of both marks is the word Simmons, when an average consumer remembers the Opponents mark it is likely to be the word Simmons that he remembers. When he sees the Applicants mark too, the part of the mark that will strike him first is also the word Simmons as Paolo is quite illegible. Therefore although visually there may be differences between the marks, aurally and conceptually the marks are similar. A substantial number of average consumers who are reasonably well informed, observant and circumspect, is likely to wonder whether the Applicants goods originated from the Opponents.

3. With regard to Class 20, the Opponents' goods and the Applicants goods are similar. If the Applicants mark Paolo Simmons with the device of a dot and a wavy line is compared with the Opponents registered word mark Simmons, the whole of the prior registered mark, namely the word Simmons, is incorporated into the Applicants mark, albeit with other additional elements like the word Paolo and the device of a dot and a wavy line. However this does not detract from the fact that these marks are similar visually, aurally and conceptually. Therefore the marks are confusingly similar. Therefore the opposition under section 8(2)(b) based on the earlier registration of the Opponents mark in class 20 for the word Simmons succeeds.
4. The plea based on the tort of passing off under section 8(4)(a) fails. The Opponents argued that their mark satisfies the elements of passing off namely reputation, misrepresentation and damage. They said that they had goodwill in their marks and that use of the Applicants mark would mislead members of the public into thinking that there was a connection between the Applicants and the Opponents goods. They also argued that they would suffer damage as they would lose the exclusive right to use the Simmons mark. On the facts, it was found that the Opponents have a reputation and good will in the business of selling mattresses and bed linen under the mark Simmons in Singapore since at least 1995. The element of misrepresentation requires more than just a likelihood of confusion in the sense understood under trade marks law. While the Registrar was certain that a substantial number of the average consumers are going to be confused between the Applicants mark and the Opponents mark, she was not convinced that a substantial number of consumers are going to be misled into purchasing the Applicants' goods in the belief that they are the Opponents' goods. The Opponents have not discharged their burden of proving that a substantial number of average consumers are likely to be deceived. It is not possible to establish the ingredient of misrepresentation by merely submitting that the public would be misled. On the facts, there was also insufficient evidence of damage as there are no declining sales figures that the Opponents may complain of, although the Applicants seem to have been using their mark since 1986 in Singapore on mattresses.
5. The plea under Section 7(1) fails as the question of distinctiveness under this section is to be determined by reference to the mark under consideration only and not by comparing the mark with other marks. It is only under section 8 that such relative grounds for refusal may be considered. Since the Applicants' mark is capable of distinguishing their goods, the opposition under section 7(1) fails.
6. The plea of bad faith under Section 7(6) failed as there was insufficient evidence on the facts to make an inference of bad faith.

Provisions of legislation discussed

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

Cases referred to

- British Sugar plc v James Robertsons & Sons Ltd [1996] RPC 281
- Saville Perfumery Ltd v June Perfect Ltd (1941) 58 RPC 147,
- Pan West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] 4 SLR 755,
- SA Societe LTJ Diffusion v S A Sadas [2003] FSR 1
- Aktiebolaget Volvo v Heritage (Leicester) Limited [2000] FSR 253
- Lloyd Shuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- Sable BV v Puma AG [1998] RPC 199
- Canon v MGM [1999] RPC 117 Windsurfing Chiemsee v Huber and Attenberger [1999] ETMR 585

- Gut Springenhiede and Tusky [1998] ECR 1-4657
- Pianotist Company Ltd Application (1906) 23 RPC 774
- Wong Seng & Son Bhd's Application and Salamander AG's Opposition [1993]
- TKR Electronics Pte Ltd's application and Matsushita Electric Industrial Co Ltd's Opposition
- Ferrero SpA v Soldan Holding Bonbonspezialitaeten GmbH.
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133 Newsweek Inc v British Broadcasting Corporation [1979] RPC 441
- Team Lotus Ventures Ltd's application and Group Lotus' Opposition
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367 and Dawaat TM [2003] RPC 11
- Philips Electronics NV v Remington Consumer Products [2003] RPC 2
- Origins Natural Resources Inc v Origin Clothing Ltd [1995] FSR 280
- Newmans Chocolate Ltd's Application and Nestle's
- Beautimatic v Mitchell Pharmaceuticals [2000] FSR 267 cases.
- Australian Woollen Mills Ltd v Walton (1937) 58 CLR 641
- Kellogg Co v Pacific Food Products [1999] 2 SLR 651
- London Lubricants (1920) Limited's Application (1925)42 RPC 264
- REACT TM [2000] RPC 285
- Balmoral TM [1999] RPC 297
- Origins UKHC [1994]
- British Sugar case UKHC [1996]
- Volvo case UKHC [2000]
- Decon Laboratories Ltd v Fred Baker Scientific Ltd [2001] RPC 293
- SA Societe LTJ Diffusion case ECJ [2003]
- Pan West case SGHC [2003]
- Compass Publishing BV v Compass Logistics [2004] RPC 41
- Reckitt & Colman Products Ltd v Borden [1990] RPC 341

Representation

- Mr Samuel Yuen and Ms Sophie Chin (Madhavan Partnership) for the Applicants
- Mr Nathan Lau, Mr Kevin Wong and Ms Jennifer Cheng (Ella Cheong Spruson & Ferguson) for the Opponents