

**In The Matter Of A Trade Mark Application By  
Britesmile International, Ltd**

**And**

**Opposition Thereto By  
Smile Inc. Asia Pte Ltd**

*Before Principal Assistant Registrar Ms. Lee Li Choon  
08 April 2005*

**Trade Marks** – Opposition to registration – whether the application to register was 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 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) of Trade Marks Act [Cap. 332, 1999 Rev Ed.]

**Trade Marks** – Opposition to registration – well known trade mark - 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 dissimilar to those for which the earlier trade mark is protected - Sections 8(3) 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) of the Trade Marks Act [Cap. 332, 1999 Rev Ed.]

The Applicants, Britesmile International Ltd, applied for the registration of a word mark, “BRITESMILE” on 22 June 2000 for goods and services in Class 3, 10 and 42 respectively being “toothpastes, dentifrice, mouthwashes and dental cleaning and polishing products”, “dental apparatus and devices”, and “teeth whitening services and centers”. These applications were accepted for registration and published on 9 September 2002, 31 August 2001 and 25 September 2002 respectively.

The Opponents, Smile Inc, Asia Private Limited, a Singapore company, has a registration for the mark, “SMILE inc.” for “computer programming; computer software design; dentistry; design of interior décor; healthcare; hospitals; graphic arts designing; maintenance of computer software; medical clinics; professional consultancy services relating to the non-business aspects of dentistry; research and development (for others); software (updating of computer-)” in Class 42, registered as from 5 February 1998.

Under the style of “SMILE inc”, the Opponents run a dentistry service, and their services have been featured rather extensively in magazines and newspaper articles, inter alia, for the innovative design of their dental clinics, the main one being the one at Suntec City Mall and for the teeth whitening services that the Opponents render. From these features and other publicity materials, it would appear that the Opponents were probably the first to introduce teeth whitening services using the “Britesmile” laser technology which were purportedly imported from the US by the Opponents.

The trade mark dispute concerns the marks, “SMILE inc” for which the Opponents have a registration for services, including dental services, in Class 42, and “BRITESMILE” which is being applied for by the Applicants in relation to dental products and dentistry services in Class 3, 10 and 42. Behind the trade mark dispute appears to be a contractual dispute between the Opponents and a company named, “Britesmile, Inc”, concerning an agreement relating to the distribution and use of a laser aided teeth whitening technology and executed between the said two parties on 2nd June 1998. As further background, the Opponents’ mark, “SMILE inc”, was opposed by the Applicants earlier but that opposition failed.

Pursuant to the above decision, the Opponents’ Mark proceeded to registration. The Opponents in turn object to the Applicants’ Mark in the said three applications on the following grounds, inter alia:-

- i. By virtue of Opponents' Mark, applications and registrations in other jurisdictions, long use and significant goodwill and reputation in the "SMILE inc" mark, the word "Smile" has become known to the trade and the public locally and in the world as symbols associated only with the Opponents and their business. As such, the Applicants' Mark which incorporates the word, "smile" that is distinctive of the Opponents and is used or is proposed to be used by the Applicant within the dental industry would give rise to confusion, and contravene Section 8(2) and/or Section 8(3) of the Trade Marks Act.
- ii. The Applicants' use or intended use of the Applicants' Mark amounts to taking unfair advantage of the Opponents' goodwill and reputation in the word, "Smile" and would offend Section 8(4) of the Act.
- iii. There are alleged breaches by the Applicant of an exclusive distributorship agreement ("the Agreement") signed between the Opponents and Britesmile, Inc ("the Utah Corporation") on 2nd June 1998 and hence, the Applicants' applications may amount to applications made in bad faith and should not be permitted as it offends Section 7(6) of the Act.

**Held, allowing the application mark to proceed to registration**

1. The case of bad faith is to be examined on two bases: (i) proprietorship of the Applicants' Mark; and (ii) the circumstances leading to the applications for registration of the Applicants' Mark. The plea of bad faith through misappropriation on the part of the Applicants in applying for registration of the Applicants' Mark failed for lack of evidence. The Opponents' case is that there is inconsistency and confusion in the Applicants' claim of ownership of the Applicants' Mark. The Opponents also sought to rebut the Applicants' claim of a parent-child relationship with the Utah Corporation as the premise by which the Applicants obtain rights to the Applicants' Mark. The Hearing Officer relied on the Court of Appeal's decision in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 which held that the key ingredient in a successful opposition under Section 12 of the Trade Marks Act (Cap. 332, 1992 Rev Ed.) (which would be equally applicable to the determination of bad faith under the Act) is a misappropriation of the mark by the applicant. The Opponents had not claimed that the Applicants had misappropriated (or even copied) the "Britesmile" mark from them. The Opponents also had not adduced any evidence to show that the Applicant had misappropriated the Opponents' Mark. Mere inconsistencies in the origins of the Applicants' Mark, even if there were any, do not go to show "misappropriation". Further, the Opponents' Mark and the Applicants' Mark are not substantially identical. Although it is not necessary, consideration was given to the Applicants' explanation of the relationship between the Applicants and the Utah Corporation and the fact that there were other applications for the Applicants' Mark lodged in the name of the Applicants in various other jurisdictions. All these would sufficiently rebut the Opponents' unsubstantiated allegation of bad faith. The Opponents' argument that the Applicants must show that they are the ones behind the "authorship" of the marks was also rejected as "authorship" is only a relevant consideration in the absence of "use" of the mark by the Applicants before the Applicants' applications, which is not the case presently. Instead, the burden is on the Opponents to satisfy the Registrar that the application should not be registered by reason that the applications are made in bad faith and the Opponents have not discharged this burden on a balance of probabilities.
2. The plea of bad faith based on the circumstances leading to the applications for registration of the Applicants' Mark also failed. The Opponents cited breach of the Agreement and pointed to certain surrounding circumstances (such as premature cessation of the production of certain "Britesmile" products) in support of their claim that the dealings of the Applicants smacks of "dishonesty" and therefore, bad faith. It was not clear in the Agreement itself that the Opponents had acquired rights to the "Britesmile" mark in question. On the face of the Agreement, there was no evidence of a breach in relation to the "Britesmile" mark or in relation to a transfer of the "Britesmile" mark between the Applicants and the Opponents such that the Applicants' act of filing for registration for the "Britesmile" mark would be called into question. If there were indeed "any acts of dishonesty" arising from a breach of the Agreement, they are not acts of the Applicants. Rather, the facts raised in support of the claim relate to the Utah Corporation, a separate entity from the Applicants and a third party for the purpose of these opposition proceedings. The Opponents' allegation would require the Hearing Officer to go behind the evidence as pleaded in order to elicit and impute the relevant acts of "dishonesty" of the Utah Corporation on the Applicants. This is not possible since these opposition proceedings are to be based only on evidence adduced. Clearly, the Opponents' have not been able to substantiate their allegation of bad faith with concrete evidence.
3. The plea under Section 8(2) failed as the dental products and services provided by the Applicants under the "BRITESMILE" mark are not likely to be confused with the teeth whitening and dentistry services of the Opponents under the "SMILEInc" mark by a substantial number of relevant consumers. As the Opponents have not adduced any evidence of confusion, the question of "confusion" is then made from an objective basis, taking into account the overall impression given by the two marks in the perception

of the relevant consumers. Phonetically and visually the marks are not so similar that they are likely to be confused by a number of persons. The two marks have completely different beginning words. BRITESMILE starts with the word “Brite” and the mark “SMILEInc” starts with the word “Smile”. Although the word “smile” is found in both marks, the beginnings of the marks distinguish them in the minds of the consumer. Further, the ideas conveyed by the marks are also different. Britesmile conveys the idea of a happy person’s smile or that a person’s smile is very bright. It is a covert and skilful allusion to a smiling happy person or a person with a bright smile. SMILEInc on the other hand conveys the idea of a smiley or happy company or a company that makes you smile or happy. As the ideas conveyed by the two marks are also different, it assists in distinguishing the marks in the minds of the consumer. From the perception of the average consumer of the types of goods in question, the Hearing Officer noted that as these are specialized products and specialized services, the relevant consumers would include specialists such as dentists or specialists who render teeth whitening services. An average consumer in such categories of people would also place special care when purchasing such goods. Combined with dissimilarity in the marks, there would not be a real likelihood of confusion amongst such consumers. As for the applications for “teeth whitening services and centers” in Class 42 and “toothpastes, dentifrice, mouthwashes and dental cleaning and polishing products” in Class 3, the type of consumer who is looking for teeth whitening services (and teeth whitening products) is not going to settle for a particular service or method of teeth whitening (or teeth whitening products) in the same way that he would shop for groceries. In fact, any dental service that is performed on a patient is not something that is done without due consideration on the part of the patient. As teeth whitening is usually done for cosmetic purposes, there would be due deliberation about the teeth whitening services and the teeth whitening methods (or teeth whitening products) that are available.

4. The plea under Section 8(3) fails. The Opponents did not present any submissions or evidence to support the claim that “SMILEInc” was well-known in Singapore and that registration of the Applicants’ Mark would be objectionable under Section 8(3). The evidence showing how successful Opponents’ dentistry services have been and how much goodwill emanated from the Opponents’ dentistry services is not sufficient to show that the mark is well-known in Singapore within the definition of “well-known” in the Act. Further, an essential ingredient under Section 8(3), ie “confusion”, has not been established.
5. The plea of passing off under Section 8(4) fails because the Opponents have no proprietary claim to any goodwill in the word, “smile” alone or in the mark, “BRITESMILE”. The word, “smile”, cannot be exclusive to the Opponents since the word is entirely descriptive of dental products and services. From the evidence lodged, it can also be inferred that the Opponents had not laid any ownership claim to any goodwill in the “BRITESMILE” mark.

#### **Provisions of legislation discussed**

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) 7(6), 8(2), 8(3) and 8(4).

#### **Cases referred to**

- Kerly’s Law of Trade Marks and Trade Names, 13th Edition
- Staniforth Ricketson, “The Law of Intellectual Property” at page 620
- Demon Ale Trade Mark [2000] RPC 354
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177 (at p. 196, 197)
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Sabel BV v Puma AG [1998] RPC 1999
- Lloyd Schuhfabrik Meyer Co GmbH v Klijsen Handel B.V [2000] F.S.R. 77.
- Pianotist’s Application [1906] 23 RPC 774
- Reckitt & Colman Products Ltd v Borden [1990] R.P.C.341
- Warnick v Townend [1980] R.P.C.31 at page 93)

#### **Representation**

- Mr Sivakumar (M/s Joseph Lopez & Co) for the Applicants
- Mr Samuel Seow assisted by Mr Sean Say (Samuel Seow Law Corporation) for the Opponents