

In The Matter Of A Trade Mark Application No.T01/15881H by N.V. Sumantra Tobacco Trading Company

And

**Opposition Thereto By
Reemtsma Cigarettenfabriken GmbH**

*Before Principal Assistant Registrar Mr. Kelvin Sum
06 October 2005*

Trade Mark – 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 Mark – 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 Mark – 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 an Indonesian Company incorporated in 1953, who applied for registration of a trade mark “MIDWEST” on 09 October 2001. The application was filed in class 34 for the goods “Cigarettes, tobacco, matches, smokers articles, lighter, cigar, cigarette filter and cigarette paper”. The Opponents, who are a German Company, are the owners of the registered marks, “West Park” for the goods, “tobacco, whether manufactured or unmanufactured”, and “West” & crest label for the goods, “tobacco products, especially cigarettes”, both in class 34. The Opponents were established in 1910, and have used their trade marks since 1981 in Germany. The use of the Opponents’ marks has spread from Germany since 1982 and the Opponent’s marks are now registered in over 150 countries. Their total annual sales figures in number of cigarettes sold worldwide from year 1997 to 2003 ranged from 26,704 million to 25,795 million sticks. In Singapore the annual sales volume from year 1997 to year 2003 ranged from 668,000 to 2,686,000 sticks in duty free sales. In 2003 they entered the domestic market in Singapore (as opposed to duty free sales) and sold 3,536,000 sticks of cigarettes. The Opponents argued that the applicants’ mark should not be registered as it is confusingly similar to their marks under section 8(2)b and that the registration of the application mark would be contrary to the law of passing off under section 8(4)a of the Act. They submitted that registration of the mark should also be refused as the application was not made bona fide under section 7(6) of the Act.

Held, disallowing registration,

1. The Applicants’ mark is “Midwest” while the Opponents’ marks are “West Park” and “West” with a crest device. In the Opponents’ first mark “West Park”, the West is in front whereas in the Applicants’ mark, it is at the back. There is little similarity aurally as the two marks West Park and Midwest, begin differently. The Opponents second mark “West” & crest device, has the word “West” boldly printed on top and it is larger than the crest device. In the Opponents’ mark West and Applicants’ mark Midwest, the emphasis is on the word “west”, as it is prominent and plays a dominant part in both marks, causing aural similarity. There is visual similarity in the marks as the dominant element in the Opponents two marks and Applicants mark is the word WEST. Overall, the Applicants mark is confusingly similar to the Opponents’ mark West, and it is likely to cause confusion in the minds of the average consumers of the product. The opposition succeeds under Section 8(2)b.
2. To determine whether the Opponents had goodwill, the evidence of sales in Singapore were examined. There were sales in the airport duty free areas since 1997 and domestic sales since 2003. However as the application was made in 2001, only the sales up to 2001 were relevant. There is no clear evidence that buyers of the Opponents’ cigarettes in the duty free areas were Singaporeans or Singapore residents. Therefore the Opponents have not shown that they had goodwill and reputation in Singapore. There is misrepresentation as there is similarity in the aural and visual elements of the marks, which leads to likelihood of confusion and deception. However there were insufficient submissions from the Opponents on anticipated loss and potential damage. The Opponents have failed to support at least one out of three elements of passing off and therefore, opposition fails under Section 8(4)a.

3. The Opponents sought to discredit the creation of the mark by the Applicants by submitting that they did not support it with any credible evidence. The Opponents also stated that the worldwide reputation of the Opponent's mark is the reason why the Applicant had intended to register such a similar mark. However, the facts do not lead to an inference that there has been misappropriation or copying. There is insufficient evidence to establish bad faith. The Opposition fails under Section 7(6).

Provisions of Legislation discussed:

- Trade Marks Act 1998 [Cap.332, 1999 Rev Ed.] Sections 7(6), 8(2)b and 8(4)a

Case referred to:

- Pianotists Co's Application [1906] 23 RPC 774
- TORREMAR [2003] RPC 89
- Kelloggs Co. v Pacific Food Products Sdn Bhd [1999] 2 SLR 652
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD TM [1998] RPC 455
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- Flowstacka Trade Mark [1968] RPC 66
- Application for Brown Shoes Company Inc [1959] RPC 59

Representation:

- Ms Winnie Tham & Ms Jo Yeo (M/s Allen & Gledhill) for the Opponents
- Ms Teresa O'Connor (M/s Infinitus Law Corporation) for the Applicants