

**In The Matter Of A Trade Mark Application Nos. T96/13388, T96/13389, T96/13390 & T96/13393 By
Resorts World Bhd**

And

**Opposition Thereto By
Kellogg Company**

*Before Principal Assistant Registrar Ms P Arul Selvamalar
27 June 2006*

Trade Mark – Opposition to registration – whether registration of the application marks would cause confusion or deception – Section 15 of the Trade Marks Act [Cap.332, 1992 Ed]

Trade Mark – Opposition to registration – whether the Application Marks were similar to an prior registered trade mark – Section 23 of the Trade Marks Act [Cap.332, 1992 Ed]

Trade Mark– Opposition to registration – Proprietorship of the marks – whether the Applicant had a bona fide claim to proprietorship of the application marks – whether there had been misappropriation of the Opponent’s mark – Section 12(1) of the Trade Marks Act [Cap.332, 1992 Ed]

Trade Mark– Opposition to registration – whether the application marks were distinctive – Section 10 of the Trade Marks Act [Cap.332, 1992 Ed]

The Applicants, Resorts World Bhd, a Malaysian company, applied for a series of marks which depicted the profiles of a tiger (Tabby) in 4 classes on 16 December 1996. Their applications are (i) T96/13388 for “soft toys and other playthings included in Class 28”, (ii) T96/13389 for “mugs, cups, saucers, bowls, plates and trays included in Class 21”, (iii) T96/13390G for “T-shirts, shorts, shirts, raincoats, caps, sun visors and belts included in Class 25” and (iv) T96/13393A for “stationery and advertising materials of paper included in Class 16”.

The Opponents, Kellogg Company, is a multi national corporation which produces cereals and convenience foods. They use a variety of animal devices to promote their cereals, which come in a variety of flavours. They created their tiger device mark (Tony) in USA in 1952 for use on their sugar coated flakes. They have registrations in the US and around the world for their tiger device mark, the words “Tony the Tiger”, and “Tony” in various classes. The tiger device that is registered in Singapore is, T80/00898I in Class 30 for “cereal preparations”. Other than using their tiger device on the boxes of sugar coated flakes that they sell, they have given away promotional items which comprise several products. In 2003 the Opponent’s projected that their sales are US\$9 billion annually, presumably for all their cereals and convenience foods sold under their various brands. Although the Opponents state that they had applied their tiger device mark to their cereal products sold in Singapore, there is no evidence of the sales volume or advertising and promotional expenditure in Singapore.

The Applicants created their tiger device as one of the character mascots to promote their Genting Theme Park and Genting Highland Resort on 1 Jan 1994. Their mark has since been used and promoted in Malaysia. Their mark has been registered in Australia, Taiwan, Hong Kong, Indonesia, China and Thailand.

Held, allowing the application marks to proceed to registration

1. The Opponents use a variety of animal devices to promote their cereals and they have been selling their cereals internationally in more than 160 countries, including Singapore. They have a registration in Singapore since 1980 for their tiger device mark for cereals. However it is unclear when they commenced sales of their sugar coated flakes with their tiger device mark in Singapore and the extent of the sales is also not stated in the evidence. It is also unclear when they started giving away promotional gift items with the tiger device mark in Singapore. Reputation is usually established by sales figures and/or advertising and promotion figures but neither was stated in their Statutory Declarations. Therefore there was insufficient evidence to establish that the Opponents had a reputation in the business of selling sugar coated flakes under the tiger device brand internationally or in Singapore before 1996. Even if they had a reputation in the business of selling cereals which are class 30 goods, they were not able to establish that their reputation extended to the goods in classes 16, 21, 25 and 28. In any event, the Opponents mark and the Applicants marks are not confusingly similar. Therefore the opposition under section 15 failed.

2. The Opponent's registered mark is a device of a tiger's face which is clearly defined with no fur, with a napkin around its neck with the name Tony. The Applicants tiger device is full bodied and wears dungarees. The Applicants tiger is more youthful and furry and is named, Tabby. The devices are different visually and there are neither visual nor aural similarities in the words Tony and Tabby. The goods for which the Opponents mark is registered and the applicants marks are applied for, are different. A substantial number of members of the public will not be confused or deceived as to the origin of the Applicant's goods, in view of the Opponents' registration. Therefore, opposition under Section 23 fails.
3. The Opponents argued that the Applicants cannot claim to be the proprietor of their tiger device mark, as the Opponents are the proprietors of their tiger device mark. As the marks are not identical or very similar, this argument failed. The Opponents' argument that the Applicants had no intention to use the mark in Singapore also failed. The opposition under Section 12 therefore failed.
4. The Applicant's marks are distinctive on their own and therefore, the opposition under Section 10(1)e failed.

Provisions of Legislation discussed:

- Trade Marks Act (Cap.332, 1992 Rev Ed) Sections, 15, 23, 12 and 10.

Case referred to:

- Smith Hayden & Co's Application [1946] RPC 97
- Bali TM [1996] RPC 472
- Kellogg Company v Toucan Golf, Inc [2003] 337 F.3d 616
- Exxon Corporation v Kellogg Company TM Applications 724327(42) & 2200962
- McDonalds Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Pianotist Co's Application (1906) 23 RPC 774
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- Harrods Case [1935] 52 RPC 65
- Mars (GB) Ltd v Cadbury Ltd [1987] RPC 387
- Polo/Lauren Company LP v US Polo Association
- Cooper Engineering Company Pty Ltd v Sigmund Pumps Limited [1952] 86 CLR 356
- Re Jellineks Application [1946] 63 RPC 59
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- R v Reef TM [2002] CUD 387
- Nation Fittings (M) Sdn Bhd v Oystertec Plc & Anor [2006] 1 SLR 712
- Harrods Ltd v Harroddian School Ltd [1997] RPC 697
- Shell & Co (Aust) Ltd v Rohm & Haas Co (1949) 78 CLR 601
- Dalic TM [1998] 2 SLR 231
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] SGHC 51
- Tesco Stores Limited Application No. 2203648
- Demon Ale TM [2000] RPC 345
- Edward Hack's Application (1941) 58 RPC
- ST Dupont v E I Du Pont Nemours & Company (O/546/01)
- Tony Knight v Patrol Jeanswear Application No. 2167825
- Re Wong Seng & Son Bhd v Salamander SG [1993] AIPR 252
- De Cordova v Vick (1951) 68 RPC 103
- Otsuka Pharmaceutical Co Ltd v Farmitalia Carlo Erba SpA [1995] AIPR 86
- Swiss Miss TM [1997] RPC 219
- Cartoon Network LP v Cartoon Triangle Apparel Inc Application No. 2142579
- Johnson & Johnson v Unigate Dairies Limited Application No. 2167713
- Golden Jet TM [1979] RPC 19
- Rainmaster v Rain King

Representation:

- Ms Low Pei Lin, Mr. Daryl Lim & Ms Sheryl Kang (Allen & Gledhill) for the Applicants
- Mr. P. Sivakumar (Joseph Lopez & Co) for the Opponents