

**In The Matter Of A Trade Mark Application Nos. T00/10876J & T00/10877I By
Stichting Lodestar**

And

**Opposition Thereto By
Austin Nichols & Co. Inc.**

*Before Principal Assistant Registrar Ms Anne Loo
29 June 2006*

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 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(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. [now 8(7)(a) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

The Applicants, Stichting Lodestar, filed an application on 22 June 2000 for the mark, “WILD GEESE”, in Class 32 in respect of “Beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; syrups and other preparations for making beverages” and in Class 33 for “Alcoholic beverages (except beer)”.

The Opponents, Austin Nichols & Co Inc., who own the registration of the mark “WILD TURKEY” in Class 33 for “alcoholic beverages” filed an opposition on the grounds that the Applicants’ mark is confusingly similar to the Opponents’ mark and the application is therefore objectionable under section 8(2) of the Trade Marks Act (Cap. 332, 2005 Rev Ed) (“the Act”). They cited section 8(7)(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 Applicants stated that the inspiration for the selection of the “WILD GEESE” trade mark stemmed from Irish folklore. The Applicants are proprietors of this mark in Argentina, Australia, Chile, Germany, Hong Kong, Korea, Mexico, Taiwan and Thailand. The Opponents have filed opposition against the Applicant’s marks in Thailand and Korea but were unsuccessful. The Applicants have obtained favourable judgment in 3 countries: Finland, where no appeal was lodged, Iceland, a favourable final decision on appeal from the decision of first instance and Croatia, where no appeal was allowed against the decision.

The Opponent’s mark, “WILD TURKEY” was first introduced in Singapore around the 1980s. The annual sales figures for “WILD TURKEY” since year 1992 to 2001 increased from S\$34,468-00 to S\$227,271-00; as for advertising and promotional figures, there was an increase from the year 1992 (S\$7,900-00) to year 2001 (S\$145,000-00). The Opponents manufacture a range of full strength bourbon, products containing “WILD TURKEY” bourbon and ready to drink products. These products are used and registered worldwide, and are sold to 44 countries with over 736,000 cases sold each year.

Held, allowing registration,

1. The opposition under section 8(2)(b) failed. There were two oppositions in this matter, one pertaining to Class 33 for “alcoholic beverages (except beer)” and the other to Class 32 for “beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; syrups and other preparations for making beverages”. With respect to the Class 33 application, the Applicants conceded that their Class 33 goods were identical to the Opponents’ goods (“Alcoholic beverages included in Class 33”). For the comparison of the item “beer” in the Applicants’ Class 32 to “alcoholic beverages”, applying the principles in the British Sugar case, beers are goods of similar description to alcoholic beverages.
2. Although the marks “WILD TURKEY” and “WILD GEESE contain the common element “WILD”, the marks when considered as a whole are not visually similar. Aurally, the words “turkey” and “geese” are so dissimilar in sound that even if there were the possibility of the slurring of endings of those words, it would not result in the two words sounding the same.

3. Conceptually the marks are also not similar. The general public in Singapore is not likely to associate “geese” and “turkeys” as game birds since the concept of hunting game is a fairly alien concept to the average Singaporean. Hence, the use of the combination of “WILD” + “the name of a game bird” in a trade mark raises no real risk of confusion that such marks belong to the Opponents. Further, consumers who buy alcoholic beverages, whether or not for personal consumption, will be discerning in their selection of goods. The price of these goods plays a part in determining how discerning the consumer is for the consumer will exercise considerably more care and intelligence when purchasing alcoholic beverages as these goods are not cheap consumerables that are bought without much thought.
4. Under the ground of passing-off, the Opponents provided evidence of 10 years of use of their mark on the goods in Singapore from 1992 to 2001, and satisfied that they had established some form of goodwill in their business. The Opponents however were not able to prove the other 2 elements of misrepresentation and damage and as such, the ground of opposition under Section 8(7) failed.
5. The Opponents did not show evidence which might have pointed to bad faith or cause there to be a finding that there has been any dealings that fell short of the standards of acceptable commercial behaviour observed by reasonable and experience men. The opposition fails under Section 7(6).

Provisions of legislation discussed

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 2(1), 7(6), 8(2) and 8(4)(a) [now 8(7)(a) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

Cases referred to

- Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816
- React Music Limited v. Update Clothing Limited [2000] RPC 285
- Turney & Son’s Trade Mark (1984) 11 RPC 37
- Union Agricola SA’s Trade Marks (1907) 25 RPC 295
- James Mellor & Sons Ltd’s Application (1955) 72 RPC 82
- Open Country Trade Mark [2000] RPC 477
- United Biscuits v. Asda [1997] RPC 513
- Queen’s Club Trade Mark Application [1997] E.T.M.R. 345
- Tran v. Meldrum and Another 44 IPR 233
- Re: Applications by Teleflora (Australia) Inc. (1994) 31 I.P.R. 92
- Telstra Corporation Ltd v. Yellownet Corporation (1999) 44 I.P.R. 415
- Tonka Corporation v. Chong (1994) 29 I.P.R. 253
- Caterpillar Inc. v. Amco (Vic) Pty Ltd (2000) 49 IPR 407
- British Sugar plc v James Robertsons & Sons Ltd [1996] RPC 281
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- 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
- Pianotist Company Ltd Application (1906) 23 RPC 774
- 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
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- In Rothmans of Pall Mall Limited v. Maycolson International Ltd [2006] SGHC 51
- Reckitt & Colman Products Ltd v Borden [1990] RPC 341
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] A.C. 731)
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
- The European Limited v The Economist Newspaper Limited [1998] FSR 283 at 288
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit [2006] 1 SLR 712,
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177

Representation

- Mr Max Ng and Ms Maan Kaur (Gateway Partnership) instructed by Ella Cheong, Spruson & Ferguson for the Applicants
- Mr Ian Oei (Drew & Napier) for the Opponents

The Appeal (OS No. 2019/2006/M and OS No. 2018/2006/H) was heard by Belinda Ang J. on 18 April 2007 and dismissed with costs.