

**In Matter Of A Trade Mark Application No. 00698/00 By
Uni-Charm Kabushiki Kaisha (Uni-Charm Corporation)**

**And
Opposition Thereto By
Johnson & Johnson**

*Before Principal Assistant Ms. Anne Loo
26 October, 17 November and 25 November 2005*

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)b of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – 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 a Japanese company who applied for registration for “Careree” on 18 January 2000. The application was filed in class 5 for “Napkins and pads for wear by person prone to incontinence”. The Opponents are an American company who has several registrations and applications bearing “CAREFREE” in classes 3,5,8,11,16,21,24 and 25 in Singapore and in many jurisdictions worldwide, opposed the application. The Opponents’ marks bearing or incorporating the word “CAREFREE” have been used extensively since 1965 on sanitary napkins, panty liners, panty shields, tampons, intimate washes and wipes. The Opponents argued that their “CAREFREE” mark has been marketed for at least 15 years in Singapore and that they have secured valuable goodwill and reputation of their marks through long and extensive use. The Opponents’ worldwide annual sales and advertising amounted to SGD510,890,800-00 in 2002 and their advertising and promotion expenditure worldwide in 2002 was SGD61,533,200-00.

In their Notice of Opposition, the Opponents argued that the Application Mark is confusingly similar to their mark under Section 8(2)(b) of the Act. They further argued that their mark was well known under Section 8(3) of the Act and that the application was objectionable under Section 8(4)a of the Act by virtue of the law of passing off. At the opposition hearing, the Opponents proceeded on the sections 8(2)(b) and 8(4) grounds of opposition and relied on their registration T66/40052D for the mark “CAREFREE” on “catamenial products, sanitary tampons, napkins and napkin belts for hygiene” in Class 5.

Held, allowing the application mark to proceed to registration,

1. The Opponents’ and the Applicants’ marks are visually similar, being of similar length and appearance. Aurally, the two marks are not similar as the word “carefree is an ordinary English word which is known and often used, and has a particular meaning of its own. The Applicants’ “Careree” on the other hand, is an invented word, which will be perceived either as a 2-syllable word comprised of “Care” and “ree” and enunciated thus; or at the very least, read as “Ka-ruh-Ree”, a 3 syllable word. As such, either way, the Opponents’ and the Applicants’ marks are not enunciated in the same manner. Conceptually, both the marks are also very different as an average consumer. The Opponents’ “CAREFREE” mark gives consumers the impression that they will be free of care, worries or troubles when using the Opponents’ catamenial products, whereas the Applicants’ mark will be perceived as an invented word which has no particular meaning as it is not an English word.
2. The Opponents’ and Applicants’ goods are not likely to be sold through the same trade channels or in the same sections in the supermarkets. The goods are also definitely not in competition with each other. The Opponents’ set of goods are used to address catamenia whereas the Applicants’ goods are specific goods catering to the sector of the population who suffer from urinary or bowel incontinence. As, the goods are also not identical or similar, there will be no likelihood of the average consumer being confused that the Applicants’ goods emanate from the Opponents. The overall impression of the marks are different such that the average consumer who is deemed to be reasonably well informed and reasonably circumspect and who would rarely have the chance to make direct comparisons between the Opponents’ and the Applicants’ marks; and who must instead rely upon an imperfect recollection of the marks will not be confused. The ground of opposition under section 8(2)(b) fails.
3. The Opponents’ do not have any applications or registrations for “napkins and pads for wear by person prone to incontinence” or any goods of the like. The Opponents’ goodwill and reputation in the

“CAREFREE” mark resides in the business of providing goods for feminine hygiene purposes and feminine sanitary protection. The Applicants’ goods under their “Careree” mark are goods targeted for a specific consumer base, and this is confined to the business of providing products for the management of incontinence. The Opponents failed to prove that there was misrepresentation by the Applicants leading or likely to lead the public to believe that their goods are emanate from or are connected to the opponents as there is no evidence in the statutory declarations showing attempts by the Applicants to misrepresent their goods as originating from the opponents. The opposition under section 8(4) therefore fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1999 Rev Ed.)

Cases referred to:

- Sabel v Puma AG [1998] RPC 199
- Canon Kabushiki Kaisha v Metro-Goldwyn Mater Ins. [1999] RPC 117
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77
- London Lubricants (1920) Ltd’s Application (1925) 42 RPC 264
- British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281
- In the matter of an opposition by Johnson & Johnson to the registration of trade mark application 2000 01105 by Uni-Charm Kabushiki Kaisha (Uni-Charm Corporation) to register the trade mark CAREREE in class 5 (“the Hong Kong decision”)
- WILD CHILD TM [1998] RPC 455
- 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
- L.R.C. International Limited & Anor v Lilla Edets Sales Company Limited [1973] RPC 560
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550

Representation:

- Ms Jacqueline Baruch (M/s Drew & Napier) for the Opponents
- Mr. Patrick Yap (M/s KL Tan & Associates) for the Applicants

(The appeal to High Court was allowed)