

**In The Matter Of A Trade Mark Application No. T00/21573G By
La Societe Des Brasseries Et Glacieres Internationales**

**And
Opposition Thereto By
Asia Pacific Breweries Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar
06 December 2005*

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 a French company who applied for registration of a trade mark which comprised a device of a tiger’s head in an oval shape with the words BIERE LARUE, meaning “Beer of the Road”, on the margin of the oval shape. The application was filed in class 32 for “beer” on 16 December 2000. The Opponents are a Singapore Company who own various registered marks with the word of a tiger or a device of a tiger in class 32 for beer. The Opponents have been selling beer under their tiger brand in Singapore for the past 73 years. Since 1940, they have registered 19 marks in Singapore which include the device of a tiger or the word “Tiger” (in English and in Mandarin), for beer and/or ale and/or stout in class 32. They also have registrations or application for their marks in 66 countries. From 1997 to 2001 the Opponents’ revenue from sales of Tiger Beer from its brewery in Singapore was in excess of \$1.3 billion. The Opponents’ advertising and promotional expenditure in Singapore from 1999 to 2003 was in excess of \$22 million.

The Applicants have been selling their beer in Vietnam since 1994 where the Opponents have sold their beer since 1992. They say that they are not aware of any confusion in Vietnam. Their volume of sales of Biere Larue beer in Vietnam in year 2003 was 427, 499 and their advertising and promotion expenditure in year 2003 was USD 2,258,065.

The Opponents argued that the Applicants’ marks should not be registered as they were 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.

Held, disallowing registration,

1. The main elements of the Opponent’s marks are the word Tiger and the representation of a tiger under a palm tree in a circular shape. The word tiger is more prominent than the representation. The main element of the Applicant’s mark is the representation of a tiger’s face. The words Biere Larue appear on the margin of the oval shape in which the tiger’s face appears and it is the secondary element. Visually the marks are not similar but aurally the Singaporean customer is more likely to refer to the Applicants beer as a tiger brand beer, than Biere Larue. This is because the words Biere Larue are in French and when faced with a foreign name in a mark and when the picture in the mark is the more dominant feature, the average Singaporean consumer is more likely to refer to it by the picture. Conceptually, both elements in the Opponents’ marks, convey the idea of a tiger. The Applicants mark also conveys the idea of a tiger as the face of the tiger is more prominent than the words. The goods are similar and there is a likelihood of confusion if the applicants mark is registered. The opposition under section 8(2)b succeeds.
2. The Opponents have gained goodwill and reputation through extensive use of their tiger marks, which have two elements – the word tiger and the device of the tiger. As the reputation and goodwill resides in the word tiger, the meaning of the word as well the picture that the word evokes in the mind will be associated with the Opponents. This picture is not restricted to the tiger device that is actually used by the Opponents in their marks. The Applicants have adopted for their goods a representation of a tiger which is deceptively similar to the Opponent’s tiger brand. This would lead an average consumer to believe that the Applicant’s goods are connected with the Opponents or originate from the Opponents because of their representation of a tiger’s face in their mark. There is a real risk of confusion or deception and there is a

real probability of diversion of sales from the Opponents to the Applicants. The opposition based on passing off under Section 8(4) succeeds.

Provisions of Legislation discussed:

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

Case referred to:

- Pianotist Co's Application (1906) 23 RPC 774
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [1999] ETMR 690
- Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175
- Richemont International SA v Goldlion Enterprise (S) Pte Ltd [2005] SGHC 208
- Polo/Lauren v United States Polo Association
- McDonalds Corporation v Future Enterprises
- Reckitt & Colman Products Ltd v Borden Ltd [1990] RPC 341
- Lifestyle 1.99 Pte Ltd v \$1.99 Pte Ltd [2000] 2 SLR 766
- Wild Child TM [1998] RPC 455
- Saga Foodstuffs Manufacturing (Pte) Ltd v Best Food Pte Ltd [1995] 1 SLR 739
- Pernod Ricard SA & Anor v Allswell Trading Pte Ltd [1994] 1 SLR 603
- Sabel BV v Puma AG [1998] RPC 199
- Lloyd Schuhfabrik Meyer Co GmbH v Klijsen Handel BV [2000] FSR 77
- Canon Kabushiki Kaisha v Metro-Goldwin-Meyer Inc [1999] RPC 177
- Jafferjee v Scarlett (1937) 57 CLR 115
- Reinsurance Australia Corporation Limited v Mobil Oil Corporation Limited [1999] ATMO 15
- Mobil Oil Corporation v Dynam Nominees Pty Ltd [1999] ATMO 99
- REEF TM [2002] RPC 387
- Chelsea Man Menswear Ltd v Chelsea Girl Ltd [1987] RPC 189
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550

Representation:

- Ms Elaine Tan (Allen & Gledhill) for the Applicants
- Mr. Lau Wai Ming & Ms Rozalynne Asmali (Drew & Napier) for the Opponents