

**IN THE MATTER OF TRADE MARK APPLICATION NO. T03/04866A  
BY  
ITOCHU CORPORATION  
AND  
OPPOSITION THERETO BY  
WORLDWIDE BRANDS, INC.**

Before Principal Assistant Registrar of Trade Marks, Ms Anne Loo

24 April 2007

*Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected - Section 8(2) (a) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.*

*Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark 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 (Cap. 332) 1999 Rev. Ed.*

*Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is identical or similar to an earlier well known trade mark and is to be registered for goods or services not similar to those for which the earlier trade mark is protected – whether the use of the Application Mark on such goods or services would indicate a connection between them and those for the earlier mark - Section 8(3) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.*

*Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed. [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]*

The Applicants, Itochu Corporation, applied on 4 April 2003 for registration of the trade mark “SWEETCAMEL” in class 25 in respect of “clothing”.

The Opponents, Worldwide Brands, Inc., filed an opposition on the basis of their earlier applications or registrations for the “CAMEL” mark in various classes.

The Opponents contended that they had used the “CAMEL” trademarks in Singapore on class 25 and class 18 goods for many years prior to application by the Applicants for their mark. They have built up an extremely large and valuable goodwill in the “CAMEL”

trademarks and had substantial annual sales figures for goods in classes 25 and 18 in Singapore.

The Applicants contended their mark has been used on clothing, particularly jeans for women, in Japan since 1979 and appended the sales values of the Applicants' goods bearing the "SWEETCAMEL" mark in Japan and other evidence to show the extensive use of the mark in Japan since 1979. The mark had also been registered in Hong Kong, China, Thailand and Taiwan and applications made in the United States, Malaysia, the European Union and South Korea. There is co-existence of the Applicants' and the Opponents' marks in Japan and Hong Kong.

### **Held, allowing the application mark to proceed to registration**

1 The Applicants' and Opponents' marks are not visually similar although the word "Camel" appears in all the marks. Aurally, the marks are also dissimilar. Whether the words "Camel Tribe" or "Camel Boots" or "Camel Active" are slurred at the endings do not make a difference for there is no aural similarity between these words and "Sweetcamel". Although there is a common word "CAMEL" appears in all the marks, the marks must be assessed as wholes. There is no conceptual similarity between the marks in question as the Applicants' "SWEETCAMEL" mark does not convey the same idea and impression as the Opponents' marks. The Opponents' "CAMEL" marks evoke the sense of ruggedness, adventure and masculinity whereas the Applicants' mark which is preceded by the adjective "sweet" projects a totally opposite impression.

2 The goods in class 25 to which the Applicants' and the Opponents' marks are applied are identical goods where articles of clothing are concerned; and are similar goods in relation to items such as "headgear", "footwear". The articles in Class 18 which are worn or together with clothing such as belts are also similar goods. However, in relation to the Opponents' registrations in classes 9, 14, 16, 22, and 28, these are not identical or similar goods. The Applicants' goods are also not in competition with the Opponents' goods in classes 9, 14, 16, 18, 22 and 28.

3 Having found that there is no similarity in the marks; the necessity to decide whether there is confusion does not arise as the average consumer of goods will not be faced with the dilemma of similar marks on similar or identical goods. The average consumer is discerning and will exercise care and good sense before making a purchase; and the fact that the Applicants' and the Opponents' marks are not similar to each other would decrease the possibility of consumers being confused as to the origins of the marks. Taking into account all the circumstances, there is no real likelihood of confusion among a substantial number of members of public if the Applicants' mark is registered. The Opposition hence failed under section 8(2).

4 Although the Opponents satisfy the requirement under section 8(3)(b) in that they have earlier trade marks in classes where the goods are not similar to those of the Applicants; this has to be read together with 8(3)(a) which requires the Applicants' "SWEETCAMEL" mark to be identical or similar to the Opponents' earlier "CAMEL"

marks. Having found that the marks in question are not similar under section 8(3) (b), the same applied for consideration under section 8(3) and hence there would be no likelihood of confusion under section 8(3) (iii).

5 The evidence of extensive use adduced by the Opponents is use by one Japan Tobacco Inc. It had been decided at the preliminary stage of the hearing that evidence lodged in the name of RJ Reynolds Company and Japan Tobacco Inc would not be accorded weight as there was no explanation how the company was related to the Opponents. The remaining evidence filed did not satisfy the requirement that the Opponents' earlier trade mark is well known in Singapore as required under section 8(3)(ii). As the other requirements of section 8(3) were not satisfied the opposition failed under this ground.

6 Having found that the marks are not confusingly similar under the section 8(2) (b) ground and that there is no likelihood of confusion under the section 8(3) (iii), there would not be misrepresentation leading or likely to lead the public to believe that Applicants' goods are the goods of the Opponents. It was hence not necessary to go into the question whether the other elements of reputation and damage under passing off are made out. The opposition under section 8(4) [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.] failed.

**Provisions of Legislation discussed:**

Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 8(2) (a), 8(2) (b), 8(3) and 8(4) [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.] .

**Cases referred to:**

*Sabel BV v Puma AG [1998] RPC 199*

*Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc. [1999] E.T.M.R 1*

*De Cordova v Vick (1951) 68 RPC 103*

*Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2005] 4 SLR 819*

*British Sugar Plc v James Robertson & Sons Ltd (Treat) [1996] RPC 281*

*The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] SGCA 14*

*In the Matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark [1906] 23 RPC 774,*

*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77*

*Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401*

*Sports Café Ltd v Registrar of trade Marks [1999] 42 IPR 552*

*Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd (1952) 86 CLR 536*

*McDonald's Corp v Future Enterprises Pte Ltd [2004] 2 SLR 652*

*London Lubricants (1925) 42 RPC 264*

*Dermik Laboratories, Inc v Galderma S.A.[2005] SGIPOS 17*

*Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873*

**Representation:**

Ms Ngoi Soon Hui, assisted by Miss Joanne Lim (M/s Drew & Napier LLC) for the Applicants

Ms Gooi Chi Duan (M/s Donaldson & Burkinshaw) for the Opponents