

**IN THE MATTER OF A TRADE MARK APPLICATION T04/16646C BY
BERGER INTERNATIONAL LIMITED**

AND

**OPPOSITION THERETO BY
LEONHARD KURZ & STIFTUNG & CO. KG**

*Before Principal Assistant Registrar P Arul Selvamalar
16 July 2008*

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 [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(7)(a) of the Trade Marks Act [Cap. 332]1999 Rev. Ed.

On 1 October 2004, the Applicants filed a trade mark application number T04/16646C for the word mark Touchwood, in Class 2 for the following goods, “Paints, gloss, primers, varnishes, lacquers, enamels in the nature of paints, japans, distempers, rust preservatives, wood preservatives, wood stains, anti-fouling and anti corrosive compositions, paints and varnish driers, oil, putties, stoppers and fillers and thinners; colorants; colouring matters, dyestuffs, mordants; raw natural resins, metals in foil and powder form for painters, decorators, painters and artists”.

The Opponents own registration number T03/06050E for the mark Touchwood in class 17 for “Stamping (blocking) foils of plastic, especially hot press stamping foils of plastic; laminating foils”. The Opponents contended that there exists a likelihood of confusion on the part of the public because the Application Mark is confusingly similar to their mark under section 8(2)b and that the Application Mark was objectionable under the law of passing off under Section 8(7)(a).

The Opponents’ mark was first used worldwide in 1994 and they have registrations in the United Kingdom, New Zealand, United States, Hong Kong, Japan and China. The Opponents mark was first used in Singapore in 1995 and the value of sales in 1996 was USD 869,000. However, the Opponents’ sales in other years were insignificant. The Opponents also spend S\$6500 every year advertising in the Yellow Pages and the Green Book in Singapore since 1996. Their product comes in the form of a multi layered sheet with a top layer which is a polyester carrier. Below that is a decorative lacquer layer which can be designed to replicate wood grains or comprise colours and below that is a bottom layer comprising an adhesive. During the hot stamping process, heat and pressure causes the protective lacquer layer and decorative layer to separate from the polyester carrier layer and the adhesive layer bonds the lacquer and decoration to any surface and forms a permanent bond with the surface. Then the polyester carrier layer is stripped away.

The Applicants had not started use of their Touchwood mark in Singapore at the time of application. Their application in class 2 is for goods which include varnishes and lacquers which are protective coatings applied mainly to wood to protect it and give it a shine. The Applicants wet lacquer is painted on which a brush or sprayed on.

Held, disallowing registration:

1. The Registrar found that the marks were identical and that the goods were similar, considering the factors set out in the British Sugar case. The Registrar found that the uses of the goods were the same, as they were both protective and decorative coatings and that the users were the same, who were mainly people in the wooden furniture industry. The Registrar found that the physical nature of the goods was different as the Applicants lacquer was contained in a can whereas the Opponents’ lacquer was contained in plastic sheets. In the industries that use wet lacquer and dry lacquer, the trade channels through which the goods reach the industry would be the same. It was found that, as the uses and the users of the goods are the same, the goods are competitive. Taking into account the identity of the marks and the similarity of the goods, the Registrar found that there was a likelihood of confusion under section 8(2)(b). The opposition under this section succeeded.

2. The Registrar found that there was insufficient evidence to establish that the Opponents had goodwill and reputation in the business of trading in their goods under their mark before 2004. The opposition under section 8(7) therefore failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332) 1999 Rev. Ed. Sections 8(2)b and 8(7).

Cases referred to:

- Polo /Lauren Co LP v Shop In Department Store Pte Ltd [2006] 2 SLR 690
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Pianotist Co's Application [1906] RPC 774
- Future Enterprises Pte Ltd v McDonalds Corp [2007] 2 SLR 845
- Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp) [2007] 1 SLR 1082
- Inadine TM [1992] RPC 421
- Gromax Plastics Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- 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
- First Principal Financial Pte Ltd v Principal Financial Group Inc [2006] SGIPOS 2
- Nation Fittings (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR 712
- Kellogg v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- In the Matter of an Application by R.K. Dundas Ld (1955) 72 RPC 151
- Thermos Prima TM [1991] RPC 120
- Kabushiki Kaisha Tokyo Seimitsu v Tsukishima Kikai Co Ltd [2007] SGIPOS 15
- The Commissioners of Inland Revenue v Muller & Co.'s Margarine, Limited [1901] AC 217
- Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd [1998] 1 SLR 1012
- Anheuser-Busch Inc v Budejovicky Budvar N.P. & Ors [1984] FSR 413
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- Star Industrial Co Ltd v Yap Kwee Kor [1975-1977] SLR 20
- Medgen Inc v Passion for Life Products [2001] FSR 496
- Scandecor Development AB v Scandecor Marketing AB & Anor [1999] FSR 26
- Diehl TM [1970] RPC 435
- Stringfellow & Anor v McCain Foods (GB) Limited & Anor [1984] RPC 501
- Harrods Limited v Harrodian School Limited [1996] RPC 697
- Lego System Aktieselskab & Anor v Lego M Lemelstrich Ltd [1983] FSR 155

Representation

- Dr Stanley Lai, Mr Goh Li-Ming and Ms Koh En Ying (Allen & Gledhill LLP) for the Applicants
- Ms. Lim Siau Wen (Drew & Napier LLC) for the Opponents