

**IN THE MATTER OF TRADE MARK
APPLICATION NO. T97/03260H BY
N.V. SUMATRA TOBACCO TRADING COMPANY**

AND

**OPPOSITION THERETO BY
NEW ZEALAND DAIRY BOARD
(assigned to NEW ZEALAND MILK BRANDS LIMITED)**

*Before Principal Assistant Registrar Anne Loo
29 January 2008*

Trade Marks – Opposition to registration – whether the opponents had a reputation – whether registration of the Application Mark would cause confusion or deception - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration - whether the Application Mark is similar to an earlier registered trade mark - Section 23 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the requirement of distinctiveness under Section 10 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the requirement of distinctiveness under Section 11 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration - whether the applicants can claim to be the proprietor of the Application Mark - Section 12(1) of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration - whether the Registrar’s discretion should be exercised to protect overriding public interest - Section 12(2) of the Trade Marks Act [Cap. 332, 1992 Ed]

The Applicants applied for registration of the word mark “ANGKOR” in Class 30 on 21 March 1997 in respect of “Coffee, cocoa, coffee beans, instant coffee, mixtures of coffee, coffee beverages, artificial coffee, coffee flavoured drinks, tea, instant tea, cereal confectionery and non dairy creamer; all included in Class 30”.

The Opponents own the trade mark “ANCHOR”, a leading dairy brand. They established their first operating company in Singapore in 1974. They registered their “ANCHOR & anchor device” composite mark under Trade Mark No. T81/04312E in Class 29, covering “Milk, milk powders, butter, cheese and all other dairy products for food, margarine, edible oils and fats.” They also registered the word mark “ANKORIA” under Trade Mark No. T80/05218Z in Class 29 in respect of “Dietetic foods and beverages for medical use; infants' and invalids' foods and beverages, all included in Class 5.” These two registrations have been on the register long before the Application Mark was filed on 21 March 1997.

The Opponents submitted that by virtue of their earlier registered marks “ANCHOR & anchor device” and “ANKORIA”, Section 23 applies to bar the registration of the Application Mark. The respective marks nearly resemble each other as to be likely to deceive or confuse; and the respective goods are of the same description.

Further, by virtue of the use and reputation of the Opponents’ earlier marks in Singapore, registration of the Application Mark is likely to deceive or cause confusion, contrary to Section 15 of the Act. In addition, the Opponents’ alleged passing off on the part of the Applicants, is also contrary to Section 15.

The Opponents also argued that the Application Mark is neither adapted to distinguish (under Section 10) nor capable of distinguishing (under Section 11) the goods claimed because of the goodwill and reputation of the Opponents’ mark in relation to similar goods.

In addition, the Opponents contended that the Applicants cannot claim to be the rightful proprietor of the Application Mark, as they have misappropriated it in contravention of Section 12(1) of the Act.

Finally, the Opponents urged the Registrar to exercise her discretion under Section 12(2) of the Act to disallow the application.

The Applicants averred that the Application Mark “ANGKOR” was derived from the capital of the ancient Khmer empire, Angkor, and adopted by the Applicants around 1997.

Held, allowing the Application Mark to proceed to registration

1. The respective goods of the parties are not of the same description. The respective marks also do not so nearly resemble each other as to be likely to deceive or confuse, despite visual and aural similarity between “ANGKOR” and “ANCHOR & anchor device”. There would not be reasonable likelihood of deception or confusion arising from the Applicants’ normal use of “ANGKOR” on the goods claimed. The ground of opposition under Section 23 therefore fails.
2. On the evidence, the Opponents have not established a reputation in their earlier marks by the application date. The respective marks are not confusingly similar and there is no reasonable likelihood of deception or confusion. The ground of opposition under Section 15 therefore fails.
3. Sections 10 and 11 deal with the distinctiveness criteria for registrability of marks. The sections are not concerned with considerations that would apply under Section 23 and Section 15 such as comparison of marks and likelihood of confusion or deception. The grounds of opposition under both sections here therefore fail.
4. The Applicants satisfactorily explained how their mark “ANGKOR” was derived and the Opponents have not established any bad faith by any misappropriation of the Application Mark. Therefore, the Applicants can claim to be the proprietor of the Application Mark and the ground of opposition under Section 12(1) fails.
5. It has been found that the respective marks and goods are not confusingly similar; and that there is no bad faith on the Applicants’ part. There is also no overriding public interest to protect. There is no reason for the Registrar to exercise her discretion and disallow the application. The ground of opposition under Section 12(2) therefore fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Ed) Sections 23, 2(4), 15, 10, 11, 12(1) and 12(2)

Cases referred to:

- Jellinek’s Application (1946) 63 RPC 59
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
- Lifeguard’s Application [1957] RPC 79
- Colman’s Application (1929) 46 RPC 126
- Spillers Ltd’s Application [1953] RPC 51
- Pianotist Co.’s Appn (1906) 23 RPC 774
- Clark v Sharp (1898) 15 RPC 141
- Sabel BV v Puma [1998] RPC 199
- LANCER Trade Mark [1987] RPC 303
- Smile Inc Asia Pte Ltd v Britesmile International Ltd [2004] SGIPOS 1
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651; [1998] SGCA 72
- Future Enterprises Pte Ltd v McDonald’s Corp [2006] 4 SLR 629
- London Lubricants (1920) Limited’s Application to Register a Trade Mark (1925) 42 RPC 264
- Tai Kwong Battery Industries Sdn Bhd v Kabushiki Kaisha Komatsu Seisakusho [2000] SGIPOS 1
- Societe des Produits Nestle SA v Strasburger Enterprises Inc (1995) 31 IPR 639
- Aristoc Ltd v Rysta Ltd (1943) 60 RPC 87
- De Cordova v Vick (1951) 68 RPC 103
- Bali Trade Mark [1969] RPC 472
- Smith Hayden & Co’s Application [1946] RPC 97
- Playboy Pte Ltd v Playboy Enterprises Inc [1999] SGIPOS 2
- Re Wong Seng & Sons Bhd’s Application and Salamander AG’s Opposition [1993] AIPR 252
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Soldan Holding and Another v Ferrero S.P.A. [2001] SGIPOS 5
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Tiffany & Company v. Fabriques de Tabac Reunies S.A. [1999] 3 SLR 147
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Harrods Ltd v Harroddian School Ltd [1996] RPC 697
- McDonald’s Corp v Future Enterprises Pte Ltd [2004] SGCA 50
- Royal Enfield Trade Marks [2002] RPC 24

Representation:

- Ms Catherine Lee (M/s Rodyk & Davidson) for the Applicants
- Mr. Vignesh Vaerhn and Miss Eunice Lim (M/s Allen & Gledhill) for the Opponents