

**IN THE MATTER OF TRADE MARK APPLICATION NO. T03/19458G BY SERI
SOMBOONSAKDIKUL**

AND

**OPPOSITION THERETO BY
ORLANE S.A.**

*Before Principal Assistant Registrar of Trade Marks, Mr Kelvin Sum
30 January 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 Application Mark is identical or similar to an earlier trade mark and is to be registered for goods or services which are not identical with or similar to those for which the earlier trade mark is protected - whether the Opponent’s mark is well known in Singapore – whether the use of the Application Mark will indicate a connection between the Applicant’s goods or services and the Opponent and is likely to lead to confusion and damage to the Opponent’s interests - Section 8(3) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

The Applicant, Seri Somboonsakdikul, filed trade mark application T03/19458G on 3 December 2003 in Class 3 for the word mark “LOLANE” (“the Application Mark”). The following goods were claimed: “hair deodorants; soaps; shampoos; hair colourants; hair dyes; hair lotion; hair weaving preparations; hair straightener cream; hair sprays; hair mousse; hair gel; hair conditioner; henna color wax; pomades for cosmetic use; hair treatment preparations; active mud for hair and scalp [hair care products]; skin whitening cream; cleansing cream; cleansing lotion; cream rinse [cosmetic]; cleansing milks for skin care; skin lotion, cold cream, other than for medical use; cosmetic moisturisers; cleansing foam; cleansing milk; mineral water (for cosmetic purposes); mask powder (for cosmetic purposes); mask cream (for cosmetic purposes); roll-on deodorants (toiletries); whitening roll-on deodorants (toiletries); deodorants for personal use, facial massaging cream [not medicated]”. The Applicant claimed to have used the Application Mark in Singapore since 2001.

The Opponent, Orlane S.A. is the registered proprietor of two earlier marks in Singapore: (i) “ORLANE” (T72/54284X) in Class 3 for “Perfumes, perfumery, toilet articles for beautifying, rouge, cosmetics, lotion for the hair, essential oils, soaps and dentifrices”, registered since 17 March 1972; and (ii) “B21 BIO ENERGI ORLANE” (T85/00201F) in Class 3 for “Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices”, registered since 16 January 1985.

The Opponent opposed the registration of the Application Mark under section 8(2)(b) of the Trade Marks Act, as it was claimed to be confusingly similar to the Opponent’s earlier marks. “LOLANE” and “ORLANE” both have an identical suffix “LANE” and similar prefixes “LO”/“OR” with a common vowel sound “O”. The marks also have the same number of letters and syllables.

The Opponent also argued under 8(3) that its earlier marks are well known in Singapore; that use of the Application Mark in relation to the goods claimed would indicate a connection between those goods and the Opponent where none exists; that there is a likelihood of confusion because of such use; and that the Opponent’s interests are likely to be damaged by such use.

Lastly, the Opponent submitted that the Applicant cannot claim to be the bona fide proprietor of the Application Mark as, in the choice of mark and goods claimed, the Applicant is taking unfair advantage of the reputation and goodwill of the Opponent in its earlier trade marks. Registration should therefore be denied under section 7(6) of the Trade Marks Act.

The Applicant denied the Opponent’s allegations and contended that the Application Mark is not visually, aurally nor conceptually similar to the Opponent’s earlier trade marks. It was argued that the prefix is the most important part of a mark and here, the prefixes are different. There also exists other marks in the same class having the same

“LANE” suffix. The Applicant also argued that the difference in price and marketing are relevant as distinct differences in target market segmentation, which minimizes the likelihood of confusion.

Held, allowing the Application Mark to proceed to registration

1. The marks “LOLANE” and “ORLANE” are not conceptually nor aurally similar and only slightly similar visually. The relevant goods are beauty and cosmetics products which will come under more scrutiny by the purchasing public. They are sold through similar trade channels as self-serve goods on display at major shopping areas, with the consumer coming in direct contact with the goods bearing the trade marks. Overall, the Opponent has not established that the Application Mark is similar to “ORLANE” nor that consequently, there is a likelihood of confusion on the part of the public. The opposition under section 8(2)(b) therefore failed.
2. The Opponent has not established, based on the evidence tendered, that “ORLANE” is well known in Singapore. The Application Mark was also not found to be similar to “ORLANE”. The opposition under section 8(3) therefore failed.
3. The Opponent’s evidence does not bear out the allegation of bad faith. There is no mention of any dishonest or misleading conduct on the part of the Applicant. There is no compelling inference to be drawn from the similarity of the marks that there has been an unfair misappropriation of goodwill and reputation that bars the Applicant from claiming to be a bona fide proprietor. The opposition under section 7(6) therefore failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 7(6), 8(2)(b), 8(3) and 2(7)

Cases referred to:

- The Polo/Lauren Co case [2005] 4 SLR 816
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- De Cordova v Vick (1951) 68 RPC 103
- London Lubricants Ltd’s Application (1925) 42 RPC 264
- Nautical Concept Pte Ltd v Jeffrey Mark Richards [2007] 1 SLR 1071
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
- Kellogg Co v Pacific Food Products Sdn Bhd [1998] 3 SLR 28
- Interlicence & Distribution v Dorgi Manufacturing [1999] SGIPOS 5
- E! Entertainment Inc v Deutsche Telekom AG [2005] SGIPOS 5
- Pianotist Co’s Application (1906) 23 RPC 774
- McDonald’s Corp v Future Enterprises Pte Ltd [2004] SGCA 50

Representation:

- Ms Gooi Chi Duan (M/s Donaldson & Burkinshaw) for the Opponent
- Mr. Peter Lo (M/s Shook Lin & Bok LLP) for the Applicant