

**IN THE MATTER OF A TRADE MARK APPLICATION T03/07711D BY  
GUANGZHOU LIBY GROUP CO. LTD**

**AND**

**OPPOSITION THERETO BY  
SUN JIANG TRADING SDN BHD**

*Before Principal Assistant Registrar P Arul Selvamalar  
19 January 2007 & 4 March 2008*

**Trade Marks** – Opposition to registration – Distinctiveness – whether the Application mark satisfies the definition of a trade mark under Section 2(1) and the requirements under Section 7(1) 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.

**Trade Marks** – Opposition to registration – whether the Application Mark is identical to an earlier trade mark and is to be registered for goods or services identical with those for which the earlier trade mark is protected - Section 8(1) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

**Trade Marks** – Opposition to registration – Likelihood of confusion - whether the Application Mark is 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 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 17 April 2003, the Applicants filed an International Application under the Madrid Protocol designating Singapore for the protection of an English word “Liby” which appears below a circular device containing 2 Chinese characters, in Class 3, for “Soaps and cakes of soap, washing powders, hair lotions, shampoos, hair care products, face cleansing creams, laundry starches, cleaning products and preparations, toilet cleaning preparations, cosmetic products, perfumes, skin whitening products, suncare products, dentifrices, hair mousses, stain removers, bleaching products, oil stain removing products, bath lotions” (“the Application Mark”).

On 1 April 2004, the Opponents applied for the mark “DEPEX” appearing above the same 2 Chinese characters as in the Application Mark for goods in class 3. The Opponents contended that the Application Mark was identical or similar to their mark and in respect of the same or similar goods under sections 8(1) and 8(2)(a),(b); that the use of the Application Mark would constitute passing off under section 8(7)(a); that the Application Mark is devoid of any distinctive character under section 7(1)(b); and that the application was made in bad faith under section 7(6).

The Opponents had registered their mark in Malaysia since 1974 and they have been selling their goods in Singapore since 1990/1991. Their goods were contract manufactured in China since 1986. The Applicant company’s president had been aware of the Opponents’ mark from before the date of application for the Application Mark as he was a sales agent in China for the Opponents’ products. The Applicant company was set up in 1994. The Applicants had applied for their mark in Malaysia and when the Opponents filed an opposition they withdrew their application. The Applicants said that their mark was independently derived from their company name in their first Statutory Declaration but in their third Statutory Declaration, they said that the mark was assigned from another company to the Applicant and that therefore they are unable to provide any information on the derivation of the mark.

### **Held, disallowing registration:**

1. The Applicants' evidence on a material issue, the derivation of the Application Mark, was inconsistent. The Opponents were the first to use the mark in Malaysia, Singapore and China and there was credible evidence that the Applicants' president knew of the Opponents' mark because of its use in China. The Registrar found that the Applicants were aware of the Opponents' mark when they made this application and that all the circumstances of the case supported a finding of bad faith. The opposition succeeded under section 7(6).
2. The Opponents do not have an earlier registered mark to support their opposition under section 8(1) or section 8(2). The Opponents' registered mark has a later application date than that of the Application Mark. Neither have the Opponents established that their mark is well known. The opposition under section 8(1) and section 8(2) therefore failed.
3. The Opponents have not established goodwill and reputation in the business of selling goods under their mark. Thus, they have not made out a case of passing off and the opposition under section 8(7)(a) failed.
4. The Registrar found that the Application Mark is inherently distinctive under section 7(1)(b). Therefore the opposition under section 7(1)(b) failed.

### **Provisions of legislation discussed**

- Trade Marks Act (Cap 332) 1999 Rev. Ed. Sections 7(1)b, 7(6), 8(1), 8(2)b and 8(7)a.

### **Cases referred to:**

- Jellinek's Application (1946) 63 RPC 59
- Pianotist Co's Application (1906) 23 RPC 774
- Aristoc Ltd v Rysta Ltd [1944] 62 RPC 65
- Newsweek Inc v British Broadcasting Corp (1979) RPC 441
- de Cordova & Ors v Vick Chemical Co (1951) 68 RPC 103
- Re Lovens Kemiske Fabrik Ved A Konsted's Application (1953) 19 MLJ 215
- Saville Perfumery Ltd v June Perfect Ltd & FW Woolworth & Co Ltd (1941) 58 RPC 147
- Spalding (AG) & Bros v A W Gamage (1915) 32 RPC 273
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SGHC 51
- Hai-O Enterprise Bhd v Nguang Chan [1992] 2 CLJ 436
- Kundry SA' Application [1998] ETMR 178
- Spa Esprit Pte Ltd v Esprit International [2005] SGIPOS 2
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Nautical Concept Pte Ltd v Jeffery Mark Richard & Anor [2007] 1 SLR 1071
- Harrisons TM [2005] FSR 10
- S A Societe LTJ Diffusion v Sadas Vertbaudet SA [2003] FSR 608
- Trend Promoters (M) Sdn Bhd v Simmons Company [2005] SGIPOS 8
- Polo/Lauren Co, LP v Shop-In-Department Store Pte Ltd [2006] 2 SLR 690
- Caterpillar Inc v Ong Eng Peng [2006] 2 SLR 669
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- McDonalds Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147

### **Representation**

- Ms Boo Yee Swan (Lee & Lee) for the Applicants
- Mr Chuah Jern Ern (Advanz Fidelis) for the Opponents