

**IN THE MATTER OF TRADE MARK APPLICATION T06/25855A
BY PARDACO TRADING PTE LTD**

AND

**OPPOSITION THERETO BY
CARITA**

*Before Principal Assistant Registrar Anne Loo
2 July 2009*

Trade Marks – Opposition to registration – whether the Application Mark is contrary to public policy or to morality or of such nature as to deceive the public - Section 7(4) of the Trade Marks Act (Cap. 332) 2005 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) 2005 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) 2005 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) 2005 Rev. Ed.

This is an opposition against the trade mark application number T06/25855A in Class 3, in respect of the following goods:

“almond milk for cosmetic purposes; almond oil; almond soap; antiperspirants (toiletries); aromatics (essential oils); astringents for cosmetic purposes; baths (cosmetic preparations for); beauty masks; cakes of toilet soap; cleansing milk for toilet purposes; cosmetic preparations for slimming purposes; cosmetics; creams (cosmetic); creams (skin whitening); deodorant soap; deodorant for personal use; depilatories; essential oils; eye lashes (cosmetic preparations for); hair colorants; hair dyes; hair lotions; hair sprays; hair waving preparations; lotion for cosmetic purposes; medicated soap; pomade for cosmetic purposes; shampoos; skincare (cosmetic preparations for); toiletries”

The Applicant, Pardaco Trading Pte Ltd, (“the Applicant”) filed the trade mark application on 23 Nov 2006. The trade mark application was accepted and advertised in the Singapore Trade Marks Journal on 19 January 2007. The application mark is a mark composed of the words “SARITA”, “Paris” and a device.

The Opponent is the registered proprietor of an earlier trade mark registration no. T75/63364A in Class 3 for “CARITA” in relation to the following goods “Perfumery preparations, essential oils, hair lotions, make – ups, toilet soaps, dentifrices”. The Opponent is also the proprietor of the CARITA mark in other countries including Australia, Canada, France, Japan, New Zealand, United Kingdom and United States of America. The Opponent’s trade mark has been used in Singapore since 2003 on products such as cosmetics, skin care preparations, toiletries, hair care products, perfumery preparations and essential oils.

Held, allowing the application mark to proceed to registration:

1. Under the section 8(2)(b) ground of opposition, the Registrar found that the marks are more dissimilar than similar. Taking into account all factors including relevant surrounding circumstances such as the nature of the goods, the nature of the industry, the price of the goods, the nature of the consumers and the respective trade channels, the Registrar was of the view that there would be no likelihood of confusion. The opposition under section 8(2)(b) therefore failed.
2. For the same reasons that there is no likelihood of confusion arising under the section 8(2)(b) ground of opposition, the Registrar found that there would be no misrepresentation by the Applicant (if the mark is used) leading or likely to lead the public to believe that goods offered by the Applicant are goods of the Opponent. The opposition under section 8(7)(a) also failed.
3. Based on the evidence lodged, the Registrar found that the ground of opposition under section 7(4) failed as the goods are not likely to be of such nature as to deceive the public in relation to its geographical origin.

4. The ground of opposition under section 7(6) was not made out as the Registrar found that the Opponent had not established that the Applicant fell short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant area of trade, both objectively and subjectively.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 7(4), 7(6), 8(2)(b) and 8(7)(a)

Cases referred to:

- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] SGCA 14
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Pianotist Co's Application (1906) RPC 774
- Aristoc v Rysta [1945] RPC 65
- Johnson & Johnson v Uni – Charm Kabushiki Kaisha (Uni – Charm Corp) [2007] 1 SLR 133
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- De Cordova v Vick Chemical Co Ltd (1951) 68 RPC 103
- Richemont International SA v Da Vinci Collection Pte Ltd [2006] 4SLR 369
- Yahoo!Inc. v Akash Arora and Another [1999] FSR 931
- Wagamama Ltd v City Centre Restaurants (1995) 22 FSR 713
- Kabushiki Kaisha Nihon Josephine Sha (doing business as Josephine Cosmetics Inc.) v Sothys S.A. [2004] SGIPOS 15
- Pruriderm Trade Mark [1985] RPC 187
- Standard Paint Co v Hales Ltd (1920) 27 CLR 350
- Bristol-Myers Company and Others v Bristol Pharmaceutical Company Ltd [1968] RPC 259
- Kimberly-Clark Corp v Vereinigte Papierwerke Schickedanz & Co (1967) 118 CLR 79
- Middlemas & Wood v Moliver (1921) 38 RPC 97
- INADINE Trade Mark (1992) 18 RPC 421
- Astra Zeneca AB v Pifzer, Inc [2007] SGIPOS 16
- Pacific Rim Industries Inc v Valentino Globe B.V. [2008] SGIPOS 6
- Stichting Lodestar v Austin Nichols & Co Inc. [2006] SGIPOS 11
- McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Pret A Manger (Europe) Limited v Ezaki Glico Kabishiki Kaisha [2006] SGIPOS 13
- Hu Kim Ai trading as Geneve Timepiece v Liew Yew Thoong trading as Crystal Hour [2007] SGIPOS 1
- Gilead Sciences Inc. v Glaxo Group Limited [2006] SGIPOS 12
- La Societe Des Brasseries Et Glacieres Internationales v Asia Pacific Breweries Ltd [2006] SGIPOS 5
- Kabushiki Kaisha Tokyo Seimitsu (Tokyo Seimitsu Co Ltd) v Tsukishima Kikai Co Ltd [2007] SGIPOS 15
- WILD CHILD Trade Mark [1998] RPC 455
- Reckitt v Colman Products Ltd v Borden Inc & Ors [1990] All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] A.C. 731
- Alteco Chemical Pte Ltd v Chong Yean Wah trading as Yamayo Stationery Manufacturer [2000] 1 SLR 119
- N.V. Sumatra Tobacco Trading Company v Reemsta Cigarettenfabriken GMBH [2006] SGIPOS 1
- United Air Lines Inc. v United Parcel Service of America, Inc. [2005] SGIPOS 22
- Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd [2000] 2 SLR 766
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit [2006] 1 SLR 712
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- Karison Exports Ltd v Premo International Pte Ltd [2005] SGIPOS 6
- Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A. [2004] SGIPOS 8
- LEUCO Great – Britain Trade Mark [1985] RPC 587
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR 1073
- Demon Ale Trade Mark [2000] RPC 345
- Ajit Weekly Trade Mark [2006] RPC 25
- Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Another and Another Appeal [2009] SGCA 9
- Nautical Concept Pte Ltd v Jeffery Mark Richard and Another [2007] 1 SLR 107
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Mohamed Mustafa & Samsudin Co Pte Ltd v Koyo Seiko Company Limited [2005] SGIPOS 11
- Goldlion Enterprises (Singapore) Pte Ltd v Baume & Mercier SA [2005] SGIPOS 10

- Newmans Chocolates Ltd v Societe des Produits Nestle SA [2003] SGIPOS 2

Representation:

- Ms. Joyce Tan and Mr. Dominic Tan (Joyce A. Tan & Partners) for the Applicants
- Ms. Lim Siau Wen (Drew & Napier LLC) for the Opponent