

**IN THE MATTER OF TRADE MARK APPLICATION T01/17954H
BY NIKE INTERNATIONAL LTD**

AND

**OPPOSITION THERETO BY
CAMPOMAR, S.L.**

*Before Principal Assistant Registrar Ms Lee Li Choon
16 September 2009*

Trade Marks – Opposition to registration – Whether the Opponents’ earlier trade mark T86/01301A which has been expunged is an earlier trade mark - Section 8(1) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether the Application Mark is identical with the Opponents’ earlier trade mark T86/01301A and whether the goods applied are identical with the goods for which the said earlier trade mark is protected - Section 8(1) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether the application is made in bad faith - Section 7(6) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

This is an opposition against the trade mark application T01/17954H by Nike International Ltd for the word mark, “NIKE” in class 3 for use on “bleaching preparations and other substances for laundry use; cleaning; polishing; scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; colognes; toiletries; sunscreens; cosmetics; skincare products; deodorants and antiperspirants for personal use; shaving preparations”. The date of application was 20 November 2001.

The Opponents are the proprietor of the trade mark “NIKE” with the following trade mark registrations T92/06434Z (“NIKE” registered in the name of the Opponents in Class 3 for “bleaching; cleaning; polishing; scouring and abrasive preparations; soaps; all not for laundry use nor for use on sport goods or sporting apparel; all included in Class 3”) and T86/01301A (application dated 2 April 1986 for “NIKE” was earlier registered in the name of the Opponents in Class 3 for “perfumery with essential oils” but which was later expunged as from 21 January 2002 upon the successful revocation application filed by the Applicants).

Held, allowing registration:

1. In the definition of an “earlier trade mark” in Section 2(1), there is a reference to “a registered trade mark”. In so far as an earlier application is concerned, it is an “earlier trade mark”, only if it becomes registered because of the qualification, “if registered” and the proviso, “subject to its being registered”. From this interpretation, it is clear that the mark must be a validly registered mark to qualify as an “earlier trade mark”.
2. The point in time at which the Registrar considers if the Opponents’ T86/01301A is a validly “registered” mark that qualifies as an “earlier trade mark” as the basis for a Section 8(1) objection against registering the Application Mark will be when the Registrar decides whether the Application Mark can be registered. For the instant case, it would be now as part of the Registrar’s decision in these opposition proceedings.
3. There is no longer a valid earlier registered trade mark under Section 8(1) at this point in time since T86/01301A has been expunged as from 21 January 2002.
4. The Applicants knew about the Opponents’ 1986 Registration.
5. The Nike Group to which the Applicants belong, carries on an established business in respect of a large variety of goods, particularly sporting goods. There are also many sporting brands such as Adidas, Puma, Lacoste, Nautica, Ocean Pacific and Quicksilver that have diversified into Class 3 goods including perfumes, colognes, deodorants, shampoos, sunscreens and other products of personal grooming use. Given that the NIKE brand is a well-known brand for sporting goods in Singapore and given that it is not unusual for well known brands for sporting goods to diversify into other areas to extend the reach of their brands, it is therefore not inconceivable that the Applicants would apply for registration to extend the monopoly of their brand name to other product areas, including Class 3 goods.
6. The Applicants’ Application Mark that was applied for in November 2001 has been held in abeyance pending the final outcome of relevant revocation and opposition proceedings in relation to the Opponents’ marks of T86/01301A and T92/06434Z respectively. Pending the finality of the intervening proceedings,

it would be reasonable for the Applicants to withhold any use of the mark, “NIKE” on the goods applied for. Thus, the lack of use on such goods should not, therefore, be held against the Applicants.

7. By virtue of paragraphs 4 and 5 above, there was therefore no bad faith on the part of the Applicants in applying to register the Application Mark when judging the subjective knowledge of the Applicants against the ordinary standards of honest traders. The principle that: “An allegation of bad faith is a serious matter and should not be lightly inferred” was also applied.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 8(1), 7(6).

Cases referred to:

- Nike International Ltd v Campomar SL [2006] 1 S.L.R. 919 (Court of Appeal)
- SA Societe LTJ Diffusion v SA Sadas [2003] FSR 1
- Trend Promoters (Malaysia) Sdn Bhd v Simmons Company [2005] SGIPOS 8
- Richemont International SA v Goldlion Enterprise (S) Pte Ltd [2006] 2 SLR 401 (High Court)
- Crown Confectionery Co Ltd v Morinaga & Co Ltd [2008] SGIPOS 12
- Proctor & Gamble Company v Tohtonku (S) Pte Ltd [2002] SGIPOS 3
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147 (Court of Appeal)
- Re Palmer Arnold D [1986] SLR 500
- Hugo Boss AG v Reemtsma Gigarettenfabriken GMBH [2009] SGIPO 7
- Wing Joo Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Anor and Another Appeal [2009] 2 SLR 814 (Court of Appeal)
- Demon Ale Trade Mark [2000] RPC 345
- Proctor & Gamble Company v Tohtonku (S) Pte Ltd [2002] SGIPOS 3
- Marhani Bte Abd. Mutalib trading as SaudiPetrol v Esquire Associates and the Hearst Corporation [1999] SGIPOS 4
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551 (High Court)
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177 (Court of Appeal)

Representation:

- Mr Prithipal Singh, Mr Patrick Yap and Ms Michelle Loi (M/s K.L.Tan & Associates) for the Opponents.
- Mr Michael Palmer, Ms Toh Wei Yi and Ms Deryne Sim (M/s Harry Elias Partnership) for the Applicants.

[The appeal from this decision to the High Court is dismissed. The further appeal to the Court of Appeal is successful.]