

**IN THE MATTER OF TRADE MARK APPLICATION NO. T0218492H BY
FFM Berhad**

*Before Principal Assistant Registrar, Mr Louis Chan Ken Yu
19 October 2008*

Trade Marks – Refusal of registration – relative grounds for refusal of registration – likelihood of confusion – where an application mark is similar to an earlier trade mark and is to be registered for goods identical with or similar to those for which the earlier trade mark is protected – Section 8(2)(b) of the Trade Marks Act

Trade Marks – Opposition to registration – sufficiency of honest concurrent use and supporting evidence - Section 9 of the Trade Marks Act

The applicants, FFM Berhad, filed a trade mark application for the mark, CAP SAUH with the device of an anchor against three wavy lines, all within an oval device, as shown below (“the Mark”),



in respect of “flour for food, flour milling products, gluten for food, milled maize, maize flour, maize meal, soya flour, wheat flour”. The Assistant Registrar refused the application because the Mark was in conflict with three prior marks, namely,

a. Registration No. T9802305Z , in respect of “rice, sugar, flour and starch”;

b. Registration No. T7978785F , in respect of “noodles and vermicelli; and

c. Registration No. T4707938D , in respect of “coffee powder, mustard powder, pepper, chicory, curry powder, cocoa, vinegar, tea, arrowroot (for food), and cakes containing dried prawn and fish”, all under Section 8(2) of the Trade Marks Act (Cap. 332, 1999 Ed.). The Assistant Registrar eventually waived the citations except Registration No. T9802305Z (“the Cited Mark”), because the Cited Mark and the Mark were similar and the evidence of honest concurrent use that was lodged was not sufficiently substantial to overcome the objection based on Section 8(2). The Assistant Registrar maintained her objections despite lodgement of arguments. The applicants applied for a hearing which was fixed on 29 October 2008.

At the hearing, the applicants argued that the Mark and the Cited Mark were distinguishable visually and conceptually and that there was sufficient honest concurrent use of the Mark to invoke successfully the relevant provisions under Section 9 of the Act. At the hearing, the applicants also undertook to lodge a Statutory Declaration to attempt to show evidence of honest concurrent use, which they did so on 18 February 2009.

Held, maintaining the refusal of the application,

1. While marks do “talk”, that is only one factor to be considered in the comparison of marks and would be particularly relevant where the word element in the two marks is featured prominently. In the present case, the two marks each contain a similar prominent anchor device within an oval border. While the Mark does contain the words, CAP SAUH, it is overshadowed by a proportionately larger device of an

anchor. The element that strikes the eye of the consumer would be the similar anchor devices in both marks. In the circumstances, the two marks are indeed similar for the purposes of Section 8(2)(b). Further, the marks are used on identical goods and confusion is likely given 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 marks are used in respect of flour, an inexpensive perishable household commodity.

2. There was insufficient honest concurrent use to accept the Mark under Section 9 in order to overcome the positive finding under Section 8(2)(b). The use of the mark in Singapore in respect of wheat flour was very little, amounting to a total of \$12,570.00 for a period of 10 years prior to the filing of the mark in 2002. Further, the invoices do not appear to support the sales figures that were claimed.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1999 Ed.), Sections 8(2)(b) and 9

Cases referred to:

- The Pianotist Co's Application (1906) RPC 774
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] SGCA 14
- Buler Trade Mark [1975] RPC 275

Representation:

- Ms Boo Yee Suan (Messrs Lee & Lee)

[The appeal from this decision to the High Court has been dismissed.]