

**IN THE MATTER OF TRADE MARK APPLICATION T02/03173J
BY OZONE COMMUNITY CORPORATION**

AND

**OPPOSITION THERETO BY
ADVANCE MAGAZINE PUBLISHERS INC.**

*Before Principal Assistant Registrar Kelvin Sum
16 December 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 with or similar to an earlier trade mark -- whether the Application Mark is to be registered for goods or services which are not 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 Applicant's use of the Application Mark would constitute passing off - Section 8(4) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

This is an opposition against the word mark "HYSTERIC GLAMOUR" in Class 16 in respect of "Paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailor's chalk; table cloths of paper; blinds of paper banners of paper; flags of paper; baggage tags; printed matter; paintings and calligraphic works; photographs, photograph stands; playing cards; stationery and study materials".

The Applicants, OZONE COMMUNITY CORPORATION, a company incorporated and existing under the laws of Japan, filed an international application on 26 November 2001 with international registration No. 774118. The mark was advertised in Singapore with the trade mark application number T02/03173J. The Applicants are focused on the design and retailing of fashion apparel and accessories for both men and women and are the registered proprietors of the trade mark HYSTERIC GLAMOUR in Japan, United Kingdom, United State of America, Hong Kong, Indonesia, Taiwan and Korea.

The Opponent, ADVANCE MAGAZINES PUBLISHERS INC., is a company incorporated and existing under the laws of New York, USA. They are the proprietors of several prior registered "GLAMOUR" marks in Singapore in classes 9, 16, 35, 41, 42 for various goods and services.

Held, disallowing registration:

1. The Registrar is of the view that, although there are some visual and aural differences between the Opponents' mark and the Applicants' mark, there is a likelihood of confusion on the part of the relevant public. The similarity in concept could give rise to a likelihood of confusion in the relevant segment of the public if the marks were affixed on similar goods, especially since the businesses of the Applicants and Opponents overlap. Thus this ground of opposition under Section 8(2) succeeds.
2. The Opponents have failed to show that the Section 8(3) can be evoked as the Opponent has a registration which is in the same class as the Applicants' mark. Further, based on the evidence, the Registrar is of the view that the mark is not well-known in Singapore. Thus the opposition under Section 8(3) fails.
3. The Opponents have not proved that there was misrepresentation that resulted in the Opponents suffering damage or is likely to cause the Opponents to suffer damage. Thus the Opponents have failed to prove the elements in passing off. Thus, the ground of opposition under Section 8(4) is also not made out.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 8(2), 8(3), and 8(4) [re-numbered as section 8(7) of the Trade Marks Act (Chapter 332) 2005 Revised Edition].

Cases referred to:

- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- Caterpillar Inc. vs. Ong Eng Peng (formerly trading as Catplus International) [2006] 2 SLR 669
- Matratzen Concord GMBH v OHIM, Case T-6/01, Judgement of the Court of First Instance (fourth Chamber)
- Mobil Petroleum Company Inc. vs. Hyundai Mobis [2008] SGHC 104
- CDL Hotels International Ltd vs. Pontiac Marina Pte Ltd [1998] 2 SLR
- Harrods Limited vs. Harroddian School Limited [1996] 21 RPC 697
- Excelsior Pte Ltd vs. Excelsior Sport (S) Pte Ltd [1984-1985] SLR 591
- Jumbo Seafood Pte Ltd & anor vs. Hong Kong Jumbo Seafood Restaurant Pte Ltd [1998] 1 SLR 860
- Nation Fittings (M) Sdn Bhd vs. Oystertec Plc [2006] 1 SLR 712
- Dermik Laboratories Inc vs. Galderma SA [2005] SGIPOS 17
- E! Entertainment television inc vs. Deutsche Telekom AG [2005] SGIPOS 5
- Crown Confectionery vs. Morinaga & Co Ltd [2008] SGIPOS 12
- NV Sumatra v British American Tobacco (Brands) Inc [2008] SGIPOS 1
- Stichting Lodestar vs. Austin Nichols & Co Inc [2006] SGIPOS 11
- Itochu corporation v Worldwide Brands Inc [2007] SGIPOS 9
- In the matter of International Registration No. 832179 in the name of Quelle Aktiengesellschaft and In the matter of Opposition thereto under number 71182 in the name of Republic Technologies (NA) LLC (O-040-07)
- The European Ltd v The Economist Newspaper Ltd [1998] ETMR 307
- In the matter of application no 1568121 in the name of Globe Spa and in the matter of opposition thereto under the number 45679 in the name of Advance Magazine Publishers Inc (O-084-00)
- The Pianotist Company Ltd Application (1906) 23 RPC 774
- McDonald's Corp v Future Enterprises Pte Ltd [2004] SGCA 50
- De Cordova v Vick (1951) 68 RPC 103
- Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD TM [1998] RPC 455
- Trends Promoters vs. Simmons Company [2005] SGIPOS 8

Representation:

- Ms Low Pei Lin and Ms Koh En Ying (M/s Allen and Gledhill) for the Opponents
- Ms Ruby Tham (M/s Drew & Napier) for the Applicants

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