

IN THE MATTER OF TRADE MARK APPLICATION NO T07/22222D

**IN THE NAME OF
CIDORE HOLDING LIMITED**

**AND
OPPOSITION THERETO BY
SEBAPHARMA GMBH & CO.**

Before Principal Assistant Registrar Sandy Widjaja

11 May 2010

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.*

Trade Marks – *Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade 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 proprietor of the earlier trade mark – whether the use of the Application Mark is likely to damage the interests of the proprietor of the earlier trade mark - Section 8(4)(b)(i) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Cidore Holding Limited (“Applicants”) sought to file an application for registration of the following mark (T07/22222D) as shown below:-



in relation to Class 3 with respect to the following goods:

“Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cleansing preparations for skin; facial cleansing milk; facial cleansing soap; facial cleansing cream; bath liquid; preparations for use in shower and bath; preparations for the care and protection of the skin; skin care moisturizers; skin toners; preparations for the care and protection of sensitive skin (not for medical use); non-medicated preparations for massage; deodorant preparations for personal use; anti-perspirants for personal use (cosmetics); non-medicated preparations for protection and care of the skin; pore astringents creams; anti-wrinkle creams (cosmetics); non-medicated cream for keratosis removal; non-medicated body powder; preparations for age spot reduction; preparations for whitening the skin; skin and body masks; sunscreen and sunblock preparations (cosmetics); body massage oils; body massage creams; preparations for care of bust (cosmetics); bust beautifying and firming skin care products (cosmetics); aromatic oil for personal use, not for medical use; products for babies' skin care; non-medicated preparations for care of the eyes; cosmetic eye treatment masks, not for medical use; cosmetic eye treatment cream, not for medical use; eye creams for firming skin around eyes; non-medicated acne care preparations; acne removing preparations; cosmetic for make-up; essences for cosmetic purposes; lip stick; preparations for care of lips; make-up removers; cosmetic preparations for slimming purposes; cosmetic preparations for skin care; products of make-up; non medicated preparations for care of hair; hair shampoos; hair cleansing preparations; hair cleansing gels; hair conditioners; oils for the care of hair; preparations for the regeneration of hair; preparations for hair waving; preparations for hair colouring; non-medicated preparations for use in oral hygiene; preparations for cleaning teeth; non-medicated preparations for care of hands; treatment for conditioning and care for scalp, hair and hand, not for medical use; cosmetic preparations for nails; preparations for care of nails; non-medicated anti-bacterial and anti-microbial hand washes; hand lotion; non-medicated preparations for care of foot; hair removal preparations; shave creams; preparations for use before shaving and after shaving.”

The Application Mark was published on 4 July 2008. The Applicants are incorporated in the British Virgin Islands. No other evidence was provided in relation to the trading background of the Applicants.

The Opponents were established in 1983 and are in charge of sales and distribution of products under the **sebamed** mark. The Opponents' **sebamed** mark was first used in Germany in the late 1960s, and goods bearing the Opponents' **sebamed** mark have been sold worldwide since. In Singapore, the Opponents have been selling goods bearing the Opponents' **sebamed** mark since at least 1983. The Opponents own registrations for the **sebamed** mark in many countries. In Singapore, the Opponents are the proprietors of the **sebamed** marks T9705976Z in Class 3 and T8206744C in Class 5.

The Opponents relied on Section 8(2)(b), 8(4)(b)(i) and 8(7)(a) of the Act.

Held, allowing the application mark to proceed to registration:

1. Under the ground of opposition under Section 8(2)(b), in assessing a mark, it is important to assess it as a whole. Visually the Application Mark is different from the Opponents' Marks. The Opponents' Marks are word-only marks, namely "SEBA-MED". On the other hand, it is clear the Application Mark is a composite mark consisting of words and devices. In particular, the Application Mark consists of a flag device, the device of a mountain top and the word "SEWAME" as well as the Chinese characters "雪完美". Thus even taking into account the principle of imperfect recollection of a consumer, the impression given by the Application Mark is different from that of the Opponents' Marks. Aurally, while the first syllable for the Opponents' Marks and the English word in the Application Mark are the same (ie "SEE"), the second and third syllables, namely "WA-ME" and "BA-MED" are pronounced differently. In the Opponents' Marks, the second syllable has a strong consonant "BA" while the second syllable for the English word in the Application Mark is "WA" which will be subsumed within the mark when it is being pronounced. Further, "MED" ends with a strong consonant "D". Thus, for the English pronunciation, as two thirds of the marks are different aurally, the marks are aurally different. Conceptually, both the English word in the Application Mark "SEWAME" and the Opponents' Marks "SEBAMED" are invented words with no significance in the English language. Thus the marks are not conceptually similar.

With respect to the goods, in relation to the Applicants' Goods and the Opponents' Class 3 Goods there are some overlapping goods. In relation to the rest of the Applicants' Goods and the Opponents' Class 3 Goods, applying the test for similarity set out in the *British Sugar Case*, other than "*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations*" in the Applicants' Goods, it would appear that the rest of the goods are similar to the Opponents' Class 3 Goods.

In relation to the Applicants' Goods and the Opponents' Class 5 Goods, applying the factors as laid out in the *British Sugar Case* the Applicants' Goods may not be similar to the Opponents' Class 5 Goods.

With regard to the likelihood of confusion, it would appear that the Applicants have not used the Application Mark in the local context. Thus in the analysis, a notional, normal and fair use of the Applicants' Mark is assumed.

In relation to the nature of the industry, it is clear that the personal products industry consists of an array of different brands. In light of this, consumers will be more careful in their purchase in that they will ensure that they are getting the brand that they are looking for. More pertinently, it is clear that these are personal products which are applied and used directly onto the face and body of the consumer. Thus it is natural that consumers will be more careful in ensuring

that they are getting exactly what they are looking for. This is because the consequences of buying the wrong product can be serious. In this particular instance both the Applicants and the Opponents provide general toiletries as well as products which are generally of a mild nature and thus cater to those with sensitive make-up. In relation to the Opponents, they appear to have a range of products for different consumers including those with normal skin, sensitive skin (both in Class 3) and those with problematic skin (Class 5). The point is, in addition to the fact that in the personal products industry the consumers would be more careful in their purchase this is all the more so for consumers who have sensitive make-up, or those who require personal products with medicinal input. This is because the consequences of buying the wrong products would have especially grave consequences for these consumers. As to the way in which the products are sold, the Opponents' Class 3 Goods and some of the Opponents' Class 5 Goods are / would be sold side by side with the Applicant' Goods. These are goods which are displayed on open shelves and are self serve consumer items. A consumer who wishes to purchase the goods would not only have a chance to look at the Opponents' goods at close range, but also to personally handle the goods. It has been concluded above that the marks are visually dissimilar. Thus this mode of sale will further reduce the likelihood of confusion. It is also noted at this juncture that the Opponents' Marks as used always come in a set of 2 different colours. The Opponents' use of contrasting colours for "SEBA" and "MED" (in addition to the way the words "SEBA" and "MED" are arranged – see above) only serves to emphasize (to their customers) that the Opponents' Marks only consists of two words "SEBA" and "MED". This is in contrast to the Application Mark which contains 4 distinct elements. Further, the above visual presentation will also serve to emphasize that the Opponents' Marks are pronounced as "SEBA-MED" and nothing else. All of the above will only serve to further diminish the likelihood of confusion.

Thus the ground of opposition under Section 8(2)(b) is not made out.

2. For the ground of opposition under Section 8(7)(a), from the average annual value of sales, it would appear that the Opponents have the requisite goodwill in Singapore. However, for the same reasons that there is no likelihood of confusion under the ground of opposition under Section 8(2)(b), there will be no misrepresentation if the Application Mark is used. Thus the ground of opposition under Section 8(7)(a) is not made out as well.
3. Under the ground of opposition under Section 8(4), the whole or an essential part of the Application Mark not is identical with or similar to the Opponents' Marks for the same reasons that the marks are not considered to be similar under Section 8(2)(b). In addition, for the same reasons that the element of misrepresentation has not been made out under the ground of opposition under Section 8(7)(a), the damaging connection element is also not made out under Section 8(4)(b)(i). As the Opponents have not made out 2 of the elements under Section 8(4)(b)(i), this ground of opposition also fails.

Provisions of legislation discussed:

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

Cases referred to:

The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR(R) 690
The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR(R) 816
MediaCorp News Pte Ltd v Astro All Asia Networks PLC [2009] 4 SLR (R) 496
Trend Promoters (Malaysia) Sdn Bhd v Simmons Company [2005] SGIPOS 8
Hu Kim Ai trading as Geneve Timepiece v Liew Yew Thoong trading as Crystal Hour [2007] SGIPOS 11
INADINE Trade Mark [1992] RPC 421
Aristoc Ltd v Rysta Ltd (1945) 62 RPC 65
Sega Corporation v Segafredo Zanetti S.P.A. [2006] SGIPOS 3
London Lubricants Ltd's Application (1925) 42 RPC 264
Astrazeneca AB v Pfizer, Inc. [2007] SGIPOS 16
BENSYL Trade Mark [1992] RPC 529
ACCUTRON Trade Mark [1966] RPC 152
BULER Trade Mark [1966] RPC 141
Johnson & Johnson v Uni-Charm Kabishiki Kaisha (Uni-Charm Corp) [2007] 1 SLR (R) 1082
British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
In the Matter of Vono Limited's Application for the Registration of a Defensive Trade Mark in Class 3 (1949) 66 RPC 305
Future Enterprises Pte Ltd v McDonald's Corp [2006] 4 SLR (R) 629
Canon Kabishiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117
WILD CHILD Trade Mark [1998] RPC 455
Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] 1 SLR(R) 903
Novelty Pte Ltd v Amanresorts Ltd and another [2009] SGCA 13
CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975
Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co. Ltd [2008] SGIPOS 9
Amanresorts Ltd and another v Novelty Pte Ltd [2008] 2 SLR (R) 32

Representation:

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