

# Intellectual Property Office of Singapore Case Summary: Japan Tobacco Inc v Philip Morris Products S.A. [2015] SGIPOS 4

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The Opponents, Japan Tobacco Inc, sought to oppose the registration of the following marks:

S/N	Trade Marks	Goods
1	 <p>T1101909H ("<b>L&amp;M Activate Mark</b>")</p>	Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches.
2	 <p>T1101910A ("<b>Activate 2-in-1 Mark</b>")</p>	Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches.

on the basis of their earlier mark "Activate" T11033921.

One of the Applicants' main contentions is that the word "activate" is descriptive of flavour-switching cigarettes. Such cigarettes contain a capsule which a smoker can crush (or "activate") to release a different flavour such as menthol while he is smoking. The Applicants also sought to tender evidence to show that the Opponents intended to use the earlier mark on such tobacco goods.

While the Opponents raised several grounds of objections, in the end, they only proceeded on one ground ie Section 8(2)(b), alleging that there is mark similarity and goods similarity, and consequently that there is a likelihood of confusion.

The Registrar found that the objection was not made out for **L&M Activate Mark**, as the marks are, in particular, dissimilar visually and aurally, given the dominant and distinctive component "L&M". In the event that the marks can be considered to be marginally similar, there is also no likelihood of confusion.

It is important to note that first and foremost, the sale of tobacco products is regulated by law in Singapore. Due to the statutory restrictions imposed on the sale of tobacco in Singapore, the would-be consumers are all adults above 18 years. Importantly, it is a common characteristic of smokers that they recognise and purchase their preferred product by brand and they tend to stick to their preferred brand. Further, the sale of tobacco products is regulated such that tobacco products are displayed in retail outlets in a way that consumers will require the assistance of an employee of the retailer to obtain the items, usually from a display case behind the counter. Thus, the consumer would have to approach a staff to request for a particular brand of cigarettes or point to the brand which he wishes to purchase. In this regard, the visual and aural aspects of the marks are more important.

However, the Registrar found that the objection was made out for **Activate 2-in-1 Mark**, for the following reasons. The Registrar is of the view that the marks are similar. The word "Activate" is the dominant and distinctive component of the **Activate 2-in-1 Mark** (even though it is not highly distinctive for a specific type of tobacco goods as described above) such that the additional components of the **Activate 2-in-1 Mark** are not sufficient to render the marks dissimilar.

Given that the marks are similar, visually and aurally, there is a likelihood of confusion as, due to the mode of retail of tobacco goods in Singapore, it is the visual and aural aspects of the marks which are more pertinent. In the local context, the sale of tobacco products is regulated by law such that tobacco products are displayed in retail outlets in a

way that consumers will require the assistance of an employee of the retailer to obtain the items, usually from a display case behind the counter. Thus, the consumer would have to approach a staff to request for a particular brand of cigarettes or point to the brand which he wishes to purchase.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.*