

## MAY 2008 Singapore: Turkeys fight Geese in High Court trade mark battle

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The case of *Austin Nichols & Co, Incorporated D/B/A Pernod Ricard v Stichting Lodestar* is an unreported Singapore High Court appeal case against the decision of the Registrar of trade marks for the trade mark applications of Wild Geese in Class 32 and 33 by Austin Nichols & Co, Incorporated D/B/A Pernod Ricard. The trial judge dismissed the appeals, holding that: the respondent's mark, Wild Geese was not confusingly similar to the appellant's Wild Turkey mark pursuant to section 8(2)(b) of the Trade Marks Act; there was no likelihood of confusion between the marks Wild Turkey and Wild Geese; and the appellant did not make out a case of passing off under Section 8(7)(a) of the Trade Marks Act.

The appellants were the registered proprietors in Singapore of the trade mark Wild Turkey in class 33 for "alcoholic beverages included in class 33". The respondents on the other hand were the applicants for Singapore trade mark application numbers T00/10876J in class 32 and T00/10877I in class 33 for Wild Geese. Class 32 includes: beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; syrups and other preparations for making beverages. Class 33 includes alcoholic beverages (except beer).

The appellants manufacture a range of full strength bourbon products containing Wild Turkey bourbon and ready to drink products, which are used and registered worldwide. The appellants' mark was first introduced in Singapore around the 1980s when the respondents had not yet started selling their product in Singapore.

The appellants' and the respondents' marks coexist in various countries worldwide notably in Australia, Germany, Hong Kong, Korea, Mexico, Taiwan and Thailand in respect of both classes 32 and 33, and in Argentina and Chile in respect of Class 33.

Section 8(2)(b) states that a trade mark shall not be registered if it is similar to an earlier trade mark and is to be registered for goods and services identical with or similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public.

The burden is on the appellants in an opposition to raise section 8(2)(b) to prove that the application mark and the earlier trade mark are similar, that the goods of the mark applied for and of the earlier trade mark are identical or similar and that there is a likelihood of confusion by virtue of the similarity of the marks and the goods.

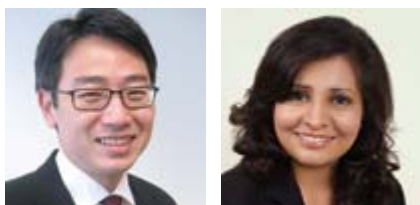
In deciding whether the marks were identical, the Registrar found that although there was a common element in both marks, Wild Geese is visually different from Wild Turkey and she was unable to find that the words turkey and geese were aurally similar. She was also of the view that the marks were not conceptually similar as the consumer in Singapore was not likely to appreciate the idea of turkeys and geese as game birds and the word wild attached before the words turkeys or geese would merely give the consumer the perception that these are free ranging fowl as opposed to domesticated turkeys and geese bred for table.

Furthermore, based on the evidence adduced by the appellants, the Registrar was not convinced that the Wild Turkey mark was well-known in Singapore. There was no evidence that the Wild Turkey mark was a famous mark amongst the alcohol-consuming sector of the public. As such, she was of the view that since she did not find the appellants' mark and the respondents' mark to be similar, from all the evidence provided there was no likelihood of confusion.

The appellants provided evidence of use in Singapore from 1992 to 2001 and also evidence from the local distributor who declared that the local distributorship was in existence from 1991. As such, they were able to satisfy the first element of passing off (goodwill or reputation). They were, however, unable to prove that there was deception or confusion arising out of the goodwill or reputation in their mark. The ground of opposition for passing off therefore failed.

The appellants appealed against the Registrar's decision. In the High Court, the trial judge however confirmed that Wild Geese was not similar to Wild Turkey, and she dismissed both appeals.

*Ella Cheong Spruson & Ferguson and Gateway Law Corporation successfully defended the respondent's application at both the Registry and High Court levels.*



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