

## TRADE MARK OPPOSITION DECISIONS IN 2006 AND 2007

### IN THE MATTER OF TRADE MARK APPLICATION NO. T99/07381F AND TRADE MARK APPLICATION NO. T99/07382D IN CLASSES 39 AND 42 IN THE NAME OF UNITED AIRLINES INC AND OPPOSITION THERETO BY UNITED PARCEL SERVICE OF AMERICA, INC. (2006)

United Airlines Inc applied for the word mark UNITED SERVICES in classes 39 and 42. The applications covered services such as airline ticketing, airline booking and reservation services, air travel services in class 39 and engineering services, aircraft safety services and airline passenger safety services in class 42. The applications were opposed by United Parcel Service of America Inc who are the registered proprietors of the trade mark UNITED PARCEL SERVICE and other UPS composite marks in various classes including classes 39 and 42. The opponent based their opposition on sections 7(6), 8(2), 8(3) and 8(4) of the Trade Marks Act 1999 revised edition.

#### Findings of the Registrar:

Section 7(6) pertains to bad faith. In this case, the Registrar held that there must be clear and sufficient evidence to make out the serious allegation of bad faith when it is pleaded as a ground of opposition. In this case there was no clear or compelling evidence of deception and dishonesty.

With reference to section 8(2), a visual, oral and conceptual comparison of the marks (Sabel v Puma), led to the conclusion that the marks were similar on the whole.

In determining whether the services were similar, a global appreciation test had to be applied. Although the marks were similar, the Registrar concluded that the services of the respective parties were dissimilar and a likelihood of confusion does not exist on this basis. The section 8(2) claim failed.

With reference to section 8(3), the evidence showing the sales and advertising figures did not meet the standard to demonstrate that the Opponent's marks were well-known in Singapore.

In respect of section 8(4), the Registrar referred to the case of Erven Warnink BV v J Townsend & Sons (Hull) Ltd AC731. This case states that the elements of passing-off are (i) that there exists goodwill or reputation in the market (ii) misrepresentation to the public or a likelihood thereof, such that the public would believe that the goods or services offered by the defendant are goods and services of the plaintiff (iii) and that the plaintiff suffered or was likely to suffer damage as a result. The Applicant in this case filed evidence that the creation of the name as an extension of its UNITED family of marks was clearly not an intention to deceive and did not make any misrepresentation to the public. On this basis, the Registrar concluded that not all the elements of passing-off were present and the claim pursuant to section 8(4) failed.

The Registrar concluded that the opposition failed and the applications could proceed to registration.

~~~~~

next

## IN THE MATTER OF A TRADE MARK APPLICATION BY GRAND TEC RESOURCES PTE LTD AND OPPOSITION THERETO BY THE GATES CORPORATION, 08 FEBRUARY 2006

Grand Tec Resources Pte Ltd ('Grand Tec') filed an application for the mark T02/17200H 'GT DRIVES & Logo' ('the Application Mark') in Class 7 in respect of '*Belts for machines for industrial purposes; belts for motors and engines used in cars; all included in Class 7*' on 31 October 2002. The mark applied is shown below:-



Gates Corporation ('Gates'), a US company filed an opposition against this application on 25 April 2003. They claim to have acquired earlier rights in the use 'GT' in Singapore and other countries worldwide. They also have registrations and applications in other countries.

Gates made the following claims in their opposition:-

- Grand Tec's 'GT DRIVES and Logo' are visually and phonetically very similar to Gates' 'GT' mark and is used on similar goods 'GT'. By virtue of the reputation of the Opponents' 'GT' mark, registration of the Applicants' mark would be contrary to section 8(2) of the Act.
- That they have continuous and extensive use of their 'GT' mark both locally and internationally over a long period of time. They acquired goodwill and fame in Singapore and that the said 'GT' mark is entitled to protection under the Paris Convention or the TRIPS Agreement as a well-known mark in Singapore.
- Further, they claim that Grand Tec's 'GT DRIVES & Logo' mark is likely to deceive and/or cause confusion and/or lead to Grand Tec's goods been passed off as or mistaken for Gates' goods. This would be contrary to section 8(4)(a) of the Act.
- Finally, they claim that Grand Tec knew of their mark and that the application was made in bad faith. The use or intended use of the Grand Tec's 'GT and device' mark is therefore not bona fide and is contrary to section 7(6) of the Act.

### Held, disallowing registration:

1. From a global appreciation tests, the marks were deemed similar and a likelihood of confusion exists.
2. However, Gates did not provide evidence that the 'GT' mark is well known in Singapore. To show that a mark is well known, the type of evidence that is required is more substantial than just evidence of sales revenue and advertising expenditure. From the evidence furnished, the 'GT' mark is always used in conjunction with other elements. Even though a mark is able to acquire distinctiveness through such use, the evidence furnished in this case is not sufficient to establish the claim of 'GT' as a well-known trade mark. The ground of opposition under section 8(2) therefore failed.
3. Gates did not substantially submit on damage that would be suffered by them, but merely argued on the possibility of damage. Although the elements of goodwill and misrepresentation may be made out, the submission made and evidence furnished in relation to damage were insufficient and insubstantial. The ground of Opposition under section 8(4) therefore failed.
4. The facts of this case revealed that Gates had terminated the employment of one Victor Lian, who registered the Grand Tec company within one week of leaving his employment with Gates. Although he explained that the derivation of the mark 'GT DRIVES & Logo' was from the name Grand Tec company, this evidence was rejected. The two marks were confusingly similar and the surrounding facts were such that an inference of bad faith was a reasonable conclusion. The opposition succeeded under section 7(6).

~~~~~

**IN THE MATTER OF A TRADE MARK APPLICATION NO. T02/12589A BY NAUTICAL CONCEPT PTE LTD  
AND OPPOSITION THERETO BY MARK RICHARD JEFFERY AND GUY ANTHONY WEST - 14 FEB 2006**

A company incorporated in Singapore, Nautical Concept Pte Ltd ('Nautical'), filed Application No. T02/12589A, 'JWEST' (stylised) in respect of "*Shoes, boots, slippers and sandals; sports shoes and sports boots; gymnastic shoes; athletic shoes; sneakers; shoes and boots for walking and climbing; socks and stockings; soles for footwear; all included in Class 25*" on 26 Aug 2002.



Mark Richard Jeffery and Guy Anthony West are the co-founders of the UK company Jeffery-West & Co Ltd ('the Opponents') and the owners of the registered mark JEFFERY-WEST [T02/08210F] in Singapore, since 5 June 2002 in Class 25 for '*articles of clothing, footwear and headgear*'. They filed an opposition against Nautical's application above. These were the grounds of their opposition:-

- Nautical knew of their mark and that the application was made in bad faith, contrary to Section 7(6) of the Trade Marks Act 1998.
- Nautical's mark was confusingly similar to their mark under Section 8(2)(a) and (b) of the Act.
- Their mark was well known under Section 8(3) of the Act and that the JWEST (stylized) application was objectionable under Section 8(4)a of the Act by virtue of the law of passing off.
- They also argued that the mark did not satisfy the definition of a trade mark and that it was devoid of distinctive character under Section 7(1)(a) and (b) of the Act.

The Opponents have been selling footwear branded Jeffery West since mid-1980s in England. They have registrations for the mark in the United Kingdom, the European Community, Australia, Indonesia and Malaysia. Their worldwide sales figures range from S\$3.46 million in 1998 to S\$5.68 million in 2002. They first sold footwear in Singapore in 1992 through C K Tang department store.

Nautical has been selling footwear in Singapore since 1994. They say that the mark JWEST was first used by them in 1998 but they did not apply for it until 2002. The Registrar did not accept this evidence and found that their mark was used only since 2002.

Further, Nautical's director, Lee, knew the Opponents since 1992 or 1993 when the company he worked for distributed the Opponents' shoes to C K Tang, a well-known department store, in Singapore. Nautical was set up in 1994 and from 1995 to 1996, they were the Opponent's agent in Singapore. Nautical distributed ladies shoes under the brand JW and men's shoes under the brand Jeffery West for the Opponents. This relationship ended in 1996 and there appeared to be no communication between the parties until 1999 when the Opponents were alerted of the Applicants use of the mark Jeffery West in Singapore.

Thereafter the Opponents visited Nautical in Singapore and there were discussions about the transfer of the ownership of the marks Jeffery West and JW to the Opponents, as Nautical had applied for registrations of those marks in Singapore in 1997. There was also discussion about an undertaking not to use the marks Jeffery West for men's shoes. Thereafter Nautical withdrew their applications for Jeffery West and JW.

However they continued to use the mark JW for women's shoes and they filed an application in 2000 for the mark JW for women's shoes which has since been registered.

### Held, disallowing registration

1. The Opponents mark Jeffery West and Nautical's mark JWEST, are dissimilar although phonetically there are similarities. Conceptually both marks have a common element but more importantly Nautical's mark JWEST will be perceived as an abbreviation of the Opponents mark Jeffery West. The opposition under Section 8(2)b succeeds as the marks are similar, the goods are similar and there is a likelihood of confusion among a substantial number of consumers, if the application mark proceeds to registration.
2. The Registrar did not accept Nautical's explanation for the derivation of the mark JWEST. Nautical has a history with the Opponents and were aware of the Opponents' use of their marks Jeffery West and JW on men's and ladies shoes. Even if Nautical thought that their JWEST mark was dissimilar to the Opponents mark Jeffery-West, they should have sought the Opponents' consent to use the mark JWEST. Their conduct in applying for the trademark JWEST, without confirming with the Opponents that they were not interested in using the mark JWEST infers that the application was made in bad faith. The opposition under Section 7(6) succeeds.
3. Section 8(4)a claim fails as there is insufficient evidence to establish the kind of reputation and goodwill make out a case of passing off.
4. The section 8(3) claim fails as there is insufficient evidence to establish the kind of recognition that the Opponents mark must enjoy in Singapore to establish that their mark is well known.

### The Appeal

Subsequently, Jeffrey West appealed against the decision. The issues before the court were (a) whether Jeffrey West's (the appellant's) application to register the JWEST mark was made in bad faith; and 9b) whether the appellant's JWEST mark and Nautical's (the respondent's) Jeffrey-West mark were confusingly similar in the manner required by section 8 (2) Trade Marks Act (Cap 332, 1999 Rev. Ed).

The High Court dismissed the appeal in part:

- (1) If bad faith was established, the application to register the trade mark in question would not be allowed even if the mark did not cause any confusion or breach of duty. Admittedly, the appellant had not sought to register an identical mark. However, bad faith has been found even where marks were not identical.
- (2) The appellant failed to furnish any legitimate reason for trying to hijack the respondent's marks and had merely asserted that it thought that the respondents were no longer in business. Admittedly, the word 'West' was commonly used in the shoe industry. However, what was different in the present case was that in the light of the appellant's history of dealing with the respondents and its blatant attempt to take advantage of the respondent's trade mark time and again in the past, the present attempt to register the JWEST trade mark might be regarded as more of the same unacceptable business tactics adopted by it in relation to the respondent's mark. What the appellant tried to do by registering the trade mark JWEST was, in the light of its relationship with the respondents and Jeffrey West, short of standards of acceptable social behaviour observed by reasonable and experienced men. The appellant had therefore acted in bad faith when it tried to register the trade mark JWEST.
- (3) When comparing two marks, what was relevant was the 'imperfect recollection of the consumer'. JWEST was visually different from Jeffrey West and the two words did not sound similar when pronounced. The respondents were also unable to assert with any seriousness that there was a conceptual similarity between JWEST and Jeffrey West.
- (4) There was also no credible evidence of confusion or deception. To this average Singaporean, there were sufficient differences between the marks JWEST and Jeffrey West not to confuse consumers. Apart from visual and aural dissimilarities, the difference in price between the products, while not conclusive of confusion, was not altogether irrelevant. After taking all circumstances into account, the average Singaporean would not be confused in the manner required by section 8(2)(b) of the trade Marks Act. The appellant's application for registration was not allowed on the ground of bad faith alone.

**IN THE MATTER OF A TRADE MARK APPLICATION NO. T00/21573G BY LA SOCIETE DES BRASSERIES ET GLACIERES INTERNATIONALES AND OPPOSITION THERETO BY ASIA PACIFIC BREWERIES LTD 06 DECEMBER 2005**

The Applicant is a French company who filed a trade mark application for a mark comprising of a device of a tiger's head in an oval shape with the words BIERE LARUE, meaning "Beer of the Road", on the margin of the oval shape. The application was filed in class 32 for "beer" on 16 December 2000. Their device appears as follows:-



The Opponent is a company incorporated in Singapore and they are the proprietor of marks with the word of a tiger or a device of a tiger in class 32 for beer. The Opponent has been selling beer under their tiger brand in Singapore for the past 73 years. Since 1940, they have registered 19 marks in Singapore which include the device of a tiger or the word "Tiger" (in English and in Mandarin), for beer and/or ale and/or stout in class 32. They also have registrations or application for their marks in 66 countries. Examples of the Opponent's famous trade mark is as follows:-



The Applicant has been selling their beer in Vietnam since 1994 whereas the Opponent had been selling their beer in Vietnam since 1992. They say that they are not aware of any confusion in Vietnam. Their volume of sales of Biere Larue beer in Vietnam in year 2003 was 427, 499 and their advertising and promotion expenditure in year 2003 was USD 2,258,065.

The Opponent claims the Applicant's mark is confusingly similar to their marks under section 8(2)b and that the registration of the application mark would be contrary to the law of passing off under section 8(4)a of the Act.

**Held, disallowing registration**

1. The main elements of the Opponent's marks are the word Tiger and the representation of a tiger under a palm tree in a circular shape. The word tiger is more prominent than the representation. The main element of the Applicant's mark is the representation of a tiger's face. The words Biere Larue appear on the margin of the oval shape in which the tiger's face appears and it is the secondary element.
2. Visually the marks are not similar. However, aurally the Singaporean customer is more likely to refer to the Applicant's beer as a tiger brand beer, than Biere Larue. Biere Larue is in French and when faced with a foreign name in a mark and when the picture in the mark is the more dominant feature, the average Singaporean consumer is more likely to refer to it by the picture.
3. The Applicant's mark also conveys the image of tiger in one's mind, as the face of the tiger is more prominent than the words. The conceptual link is made. Coupled with the fact that the goods are similar, a likelihood of confusion exists. The opposition under section 8(2)b succeeds.
4. The Opponent gained goodwill and reputation through extensive use of their tiger marks, which have two elements – the word tiger and the device of the tiger. As the reputation and goodwill resides in the word tiger, the meaning of the word as well the picture that the word evokes in the mind will be associated with the Opponent. This picture is not restricted to the tiger device that is actually used by the Opponents in their marks.

next

- 2 -

5. The Applicant adopted a representation of a tiger for their trade mark which is deceptively similar to the Opponent's tiger brand. This would lead an average consumer to believe that the Applicant's goods are connected with the Opponents or originate from the Opponents because of their representation of a tiger's face in their mark. There is a real risk of confusion or deception and there is a real probability of diversion of sales from the Opponents to the Applicants. The opposition based on passing off under Section 8(4) succeeds.

~~~~~

next