

**In The Matter Of Application No. 1533/93
By Tai Kwong Battery Industries Sdn Bhd
To Register A Trade Mark In Class 9**

And

**In The Matter Of Opposition Thereto
By Kabushiki Kaisha Komatsu Seisakusho
(aka and/or d.b.a. Komatsu Ltd.)**

*Before Deputy Registrar Chiam Lu Lin
25 April 2000*

Trade Mark - Application for registration - Opposition by registered proprietor of similar trade mark in different class - Whether the marks nearly resemble each other - likelihood of deception or confusion - Whether the goods are of the same description - Application disallowed

Tai Kwong Battery Industries Sdn Bhd (the Applicants) applied for registration of a trade mark "KOMASU" in Class 9 in respect of electrical cells, batteries and accumulators. The application was advertised in the Gazette on 23 December 1994.

Kabushiki Kaisha Komatsu Seisakusho (aka and or d.b.a. Komatsu Ltd.), (the Opponents opposed the registration under sections 10,12, 15 and 23 of the of the Trade Marks Act (Cap. 332 1992 Revised Edition) (the Act).

The Opponents were the registered proprietors of 4 marks relating to the word "KOMATSU" and "KOMATSU" & device and claimed long and extensive use of these marks in Singapore and elsewhere. The Opponents' marks fell in class 7 for "earth working machines and machines for road making and civil engineering construction, metal working machines, machine tools, and parts included in Class 7 of all the aforesaid machines and of machine tools" and in class 12 for "land vehicles and parts thereof included in Class 12". The Opponents claimed that the Applicants' mark, by look and sound, closely resembled their "KOMATSU" mark. The Opponents also claimed that registration of the Applicants' mark would be likely to deceive or cause confusion to the public or mislead the public.

The Applicants claimed that their mark was an invented word with no meaning unlike the Opponents' mark which was a common Japanese surname. They also claimed differences between the two marks. Furthermore, the Applicants asserted that having registered their mark in respect of "batteries" in other countries, they should be allowed to register in Singapore since the Opponents' marks were all registered in completely different classes and hence no deception or confusion was likely to occur.

Held, disallowing registration:

- The Applicants' mark "nearly resembles" the Opponents' marks under section 23. Visually and phonetically, the marks were similar. The public was unlikely to distinguish the marks on the basis that the Opponents' KOMATSU marks would sound significantly different (being Japanese sounding) from the Applicants' KOMASU mark (being derived from a Malay word). The Applicants have not shown in their evidence that any confusion that might occur would not survive the mechanism of trade. The differences in stylisation of the marks and the conceptual differences did not affect the above conclusion. In the test for similarity, the marks should not be compared side by side. Rather, marks are remembered by general impression or significant details.
- Under section 23, one has to determine whether the goods were the same or "of the same description". Each case is judged on its own merits, and on the facts, the goods were not the same but were goods "of the same description". The Opponents' goods in class 7 covered not just earth working machines and so forth but "parts included in class 7 of all the aforesaid machines and of machine tools". Their goods in class 12 covered not just land vehicles but "parts thereof included in class 12". One must consider such matters as the nature and composition of the goods, the respective uses and functions, the trade channels through which respectively they were marketed or sold and in different cases one (but not always the same one) of these characteristics might have greater significance of emphasis than the others. The matter should be decided in a business sense. The Applicants' batteries and some of the Opponents' goods could be viewed as being sources of electrical

energy and had similar uses. The Applicants' batteries were also likely to be sold in the same trade channels as those through which the Opponents' parts and fittings for land vehicles and machinery in Class 7 were traded.

- Some products covered by the Opponents' registrations would be goods of the same description as the Applicants' car batteries. Hence the section 23 objection succeeded because there was a likelihood of confusion.
- From the evidence, it was clear that the opponents had used their marks extensively in Singapore and had also built up a reputation in their marks not only in relation to construction equipment and industrial machinery but also in relation to batteries, accumulators and other related goods. Actual probability of deception leading to a passing off or an infringement action need not be proved. It would be sufficient if the result of the registration of the mark would be that a number of persons would be caused to entertain a reasonable doubt as to whether the two products came from the same source. The Applicants had not discharged their burden of proving that their proposed mark is not likely to deceive or cause confusion. Mere co-existence of the 2 marks in several countries did not show that there was no confusion or deception. The objection under section 15 succeeded.
- The objections under section 10 failed. As long as the mark for which registration was applied for satisfied the conditions of section 10 of the Act, it qualified for registration under that section. The possibility of confusion arising from a normal and fair use of the Opponents' and Applicants' mark was properly to be considered under sections 15 and 23, not section 10.
- The objection under section 12 failed as the alleged mala fides was not proven. Allegations of mala fides must always be subject to strict proof.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Revised Edition), sections 10, 12, 15 and 23.

Cases referred to:

- Bali Trade Mark [1969] RPC 472
- Pianotist Co.'s Application [1906] 23 RPC 774
- INADINE Trade Mark [1992] RPC 421
- Re Jellinek's Application [1946] RPC 59
- J Lyons & Coy. Ld's Application [1959] RPC 120
- Tiffany & Co. v Fabriques de Tabac Reunies SA (1999 unreported)
- Smith Hayden (1946) 63 RPC 97
- Savile Row Trade Mark [1998] RPC 155
- Gardenia Overseas Pte Ltd v. Garden Co. Ltd. [1993] AIPR 558
- Swift's Application 1962 (RPC) 37
- Sri Lankan case of In the Matter of Trademark Application No. 66386 – KOMASU

Representation:

- Ms Low Pei Lin (M/s Allen & Gledhill) for the Applicants
- Mr Raphael Lee (M/s Lee & Lee) for the Opponents