

**In the Matter of Application No. 12359/95
by MAGIC-KOIL PTE LTD
to register a trade mark in Class 20**

And

**In the Matter of Opposition Thereto
by KING KOIL LICENSING COMPANY INC &
MATSUSHITA GREATWALL CORPORATION PTE LTD**

*Before Assistant Registrar Chua Ser Ching
27 June 2001*

Trade mark - Application for registration - Opposition - Whether confusingly similar - Bona fides of application - Trade Mark Act (1992 Revised Edition) Sections 12, 15 and 23

The Applicant, Magic-Koil Pte Ltd filed the subject application on 22 December 1995. The subject mark consists of the words "Magic-Koil" in gold against a background of blue, red and purple hues. The goods covered are "beds, mattresses, spring mattresses, cushions, pillows; all included in Class 20". The mark was advertised before acceptance on 19 November 1999 with a disclaimer of the word "Koil". The mark was also limited to the colours shown in the representation of the mark on the trade mark application form.

The first Opponent, King Koil Licensing Co. Inc. is the proprietor of several KING KOIL trade mark registrations in Singapore, all in respect of "beds, mattresses and box springs" in Class 20. The word "Koil" was disclaimed in all of them except for TM No. 9750/96 which was advertised before acceptance on 4 February 2000. The second Opponent is its Singapore licensee and had been selling KING KOIL beds, mattresses and box springs in Singapore since 1981. Its annual sales figures and advertisement expenditure run into a few million Singapore dollars in recent years.

Held, allowing the opposition:

- The Registrar reviewed the evidence and is of the view that the Applicant's adoption of the word "Koil" in the subject mark is not bona fide.
- The general manager of the Applicant was the factory manager for the second Opponent from 1976 to 1986 and thus the Applicant would be well aware of the use of the word "Koil" by the first and second Opponents. While manufacturers may want to make an indirect reference to the nature of their goods by misspelling the descriptive words concerned, however, bearing in mind the different ways in which the word "coil" may be misspelled, the Registrar is of the view that there is no reason why the Applicant should use the word "Koil" in the subject mark except to ride on the Opponents' reputation for the same goods.
- The Registrar is also of the view that there is a likelihood of confusion between the subject mark and the KING KOIL marks.
- The word "Koil", although disclaimed in the first Opponent's earlier trade mark registrations, has become a distinctive part of the KING KOIL mark due to the Opponents' aggressive promotion of the mark in Singapore. This is probably what led the examiner to let TM No. 9750/96 proceed to advertisement and registration without a disclaimer of the word "Koil". It is clear from the cases that a disclaimed element may nevertheless have a trade mark connotation in a composite mark. In this case, "Koil" does have trade mark significance in "KING KOIL".
- In addition, the Applicant does not always limit the subject mark to the colours shown on the trade mark application form. The way the Applicant uses the subject mark increases the likelihood of confusion between it and the KING KOIL marks.

Provisions of legislation considered:

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

Cases referred to:

- Philip Morris Inc's Trade Marks Application [1980] RPC 527
- Super Coffeemix Manufacturing [2000] 1 SLR 587

Representation:

- Ms Angela Lee (M/s Jansen, Menon & Lee) for the Applicant.
- Mrs Ang Su-Lin (M/s Harry Elias Partnership) for the Opponents.