

**In The Matter Of A Trade Mark Application No. 1392/93  
BY Magna International Pte. Limited**

**And**

**Opposition Thereto By  
The Morgan Crucible Company Limited**

*Before*  
**Anne Loo Principal Assistant Registrar of Trade Marks  
11 April 2002**

**Trade Mark** – application for registration – opposition – applicant’s mark similar to and/or so resembles opponent’s mark – deception and confusion – application for registration not bona fide - Trade Marks Act (1992 Revised edition) ss 10, 12, 15 and 23.

**Facts**

The Applicant Magna International Pte Ltd filed the trade mark application on the 25 February 1993. The trade mark was accepted and advertised on the 24 July 1998. The Opponent The Morgan Crucible Company Plc lodged a Notice of Opposition against the trade mark application on the 23 September 1998. The Opponent claimed that to be the user and/or registered proprietor and/or applicant in Singapore and worldwide of numerous “MAGNA” trade marks. As the Opponent had used its MAGNA mark on its products extensively in Singapore and all over the world for many years, it had built up a large and valuable reputation and goodwill in respect of the said marks. The trade and public associated the Opponent’s MAGNA mark as a symbol of reputation, quality and reliability of the Opponent’s product. The Applicant’s mark was so similar and/or so closely resembled the Opponent’s MAGNA marks that when used on the Applicant’s goods, it was likely to deceive or cause confusion, and/or lead to the Applicant’s products to be passed off as or mistaken for the Opponent’s products. Registration and use of the Applicant’s mark would cause purchasers of the products to believe and to be confused that the Applicant’s products have the same source or origin as the Opponent’s products, when no such connection exists. The Opponent also argued that the applicants mark was copied from its mark.

**Held, dismissing the opposition,**

1. The preliminary issues that have to be considered for an opposition based on Section 23 is whether the Opponent’s and the Applicant’s marks are identical to or so nearly resemble each other, and whether the Opponent’s and the Applicant’s goods are the same or of the same description. The Opponent’s and the Applicant’s marks are both “MAGNA” marks and are therefore identical. However, whether the Opponent’s and the Applicant’s goods are the same or of the same description, must be read in context of the operative words of s.23(1) which are: “belonging to a different proprietor and already on the register”. The Opponent must have a trade mark “already on the register” if he is to raise a ground of opposition under s.23. The date at which his mark must be registered is the date of application for registration by the Applicant, that is, the 25 February 1993 for S.15(2) of the Trade Marks Act (Cap 332) 1992 Revised Edition clearly states “a trade mark when registered shall be registered as of the of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.” Since the Opponent did not have a registration “already on the register” on the 25 February 1993, s.23 does not extend to the Opponent’s case. Therefore the opposition under section 23 fails.
2. There is no evidence of copying of the mark by the Applicant in this matter. The evidence lodged by both parties does not suggest any nexus between the Opponent and the Applicant that might suggest any evidence of copying or that would allow an adverse inference to be drawn against the Applicant. For a successful opposition under section 12(1), misappropriation of the mark is necessary. Therefore the Opposition under section 12(1) fails.

Note: At the hearing, counsel for the Opponent informed that they were not proceeding with the opposition under s.10 and s.15.

**Legislation referred to:**

- Trade Marks Act (Cap 332, 1992 Revised Ed) sections 12(1), 12(2), 15 and 23

**Cases referred to:**

- Jellinek's Application [1946] 63 RPC 59
- Vitamin Ltd's Application [1956] RPC
- In the Matter of Applications by John Taylor Peddie [194] 61 RPC 31
- Broadhead's Application [1959] 67 RPC 207
- Keraion Trade Mark [1977] RPC 588
- Smith Hayden & Co's Application (1945) 63 RPC 97
- GE Trade Mark [1993] RPC 297
- Shell Co (Aust) Ltd v Rohm and Haas Co (1949) 78 CLR 601

**Representation:**

- Mrs Anna Tan and Mr Andrew Tan (Andrew Tan Tiong Gee & Partners) for the Applicant.
- Mr Tan Bok Hoay and Mr Kelry Loi (Donaldson & Burkinshaw) for the Opponent.