

**In The Matter Of A Trade Mark Application By
TKR Electronics Pte Ltd
To Register A Trade Mark In Class 9**

And

**Opposition Thereto By
Matsushita Electric Industrial Co. Ltd**

*Before Principal Assistant Registrar Ms. Anne Loo
14 May 2003*

Trade Marks – Opposition to registration – Likelihood to cause confusion on the part of the public - whether the Application Mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected - Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Application Mark is identical or similar to an earlier trade mark and is to be registered for goods or services which are not identical with or similar to those for which the earlier trade mark is protected - whether the Opponent's mark is entitled to protection as a well known mark – whether the use of Application Mark will indicate a connection between the Applicants' and the Opponents' goods and will lead to confusion and damage to the Opponent's mark - Section 8(3) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – the use of the Application mark in Singapore may be prevented by law or an earlier right – Section 8(4)(a) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Distinctiveness in the mark – whether the Application mark satisfies the definition of a trade mark under section 2(1) of the Act – Section 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the use of the Application mark in Singapore may be prohibited by any written law or rule of law –Section 7(5) the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration –allegation of bad faith – whether the Applicant's attempt to register the Application Mark is in bad faith – Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

The Applicants applied for the registration of a trade mark 'TKR Techniks' on 3 August 1999 for "Telephones, corded and wireless, telephone apparatus, telephone receivers, telephone answering apparatus, sound recording apparatus, sound recording carriers, sound recording discs, sound recording, amplifying, reproducing and transmitting apparatus, radios, radio cassette recorders, radio cassette players, tapes, tape recorders, amplifiers, blank cassette tapes, compact disc players, compact disc changers, headphones, loudspeakers, video cassette players, digital video disc players." in Class 9. The Opponents are the proprietors of the mark 'Technics' as a word or combined with other words, in several classes of goods and services throughout the world. The Opponents have registrations for their 'Technics' mark in Singapore, in several classes including class 9.

The Opponents relied on sections 7(1)(a), 7(5), 7(6), 8(2)(a)(b), 8(3) and 8(4)(a) Trade Marks Act 1998 [Cap. 332] in their opposition.

Held, disallowing the Application to proceed to registration

1. The opposition under section 8(2) succeeds. Under this section, the Opponents' earlier mark and the Application Mark must relate to either identical or similar goods. A comparison of the specification of goods of both parties shows that they deal with electronic goods which are in direct competition and the goods are identical or at least very similar goods. The Application Mark, when in normal and fair use, has caused the significance of the letters 'TKR' to be diminished; the words 'Techniks' is the dominant and distinctive element of the Application Mark. Taking into account all factors relevant to the circumstances of the case, the visual, aural or conceptual similarity of the marks, there is a likelihood of confusion on the part of the public if the Application Mark is allowed to proceed to registration.

2. The ground of opposition under section 8(3) is not available to the Opponents as the goods under the Application Mark are identical or similar to the goods under the Opponents' mark.
3. The opposition under section 7(1)(a) fails. In considering the question of 'capable of distinguishing' under section 2(1) and 7(1)(a), a low minimum standard is applicable, and is construed as meaning no more than 'not incapable of distinguishing' the Applicants' goods from those of others. In this case the Application Mark is found to satisfy section 2(1) read with section 7(1)(a), that is., it is a mark capable of distinguishing the Applicants' goods.
4. The opposition under section 7(5) fails. The Opponents argued that the by reason of the similarities of the two competing marks, the use of the Application Mark will lead to the Applicants' goods being passed off or mistaken as the Opponents' goods. Section 7(5) only refers to the use of a trade mark to the extent that it contravenes provisions of other written laws, not the provisions of the trade mark law; therefore, the Opponents' submissions on passing off under this section are found to be misplaced.
5. The opposition under section 7(6) fails. The Opponents have not discharged their burden of proving that the Applicants' attempt to register the Application Mark is in bad faith. There is no evidence submitted to substantiate the Opponents' allegations that the Applicants must have known about the Opponents and their mark since they are in related trades or evidence to show that it was incredible to conclude that the Application mark was produced by a coincidence.
6. The ground of opposition under section 8(4)(a) is not available to the Opponents as the Opponents clearly have several registered 'Technics' trade marks, and in particular a 1972 registration in Class 9.

Provisions of legislation discussed

- Trade Marks Act 1998 [Cap. 332], Sections 2(1), 7(1)(a), (5), (6), 8(2)(a)(b), (3) and (4)(a).

Cases referred to:

- Dualit Limited's Trade Mark Applications [1999] RPC 304 at 314
- Dualit Limited's Trade Mark Applications [1999] RPC 890
- In the Matter of Broadhead's Application for Registration of a Trade Mark (1950) 67 RPC 209
- Pianotist Co's Application (1906) 23 RPC 774
- Bali TM, Edward Hack's Application (1941) 58 RPC 91
- Smith Hayden & Co.'s Application (1946) 63 RPC 97 In the Matter of Application No 2008447A by ST DUPONT to register a mark in Class 25 and opposition thereto under No 44948 by E.I. DU PONT NEMOURS AND COMPANY (reported as trade mark case summary: O/546/01)
- In the Matter of Application No 2167825 by TONY KNIGHT to register a mark in Class 25 and opposition thereto under No 50544 by PATROL JEANSWEAR LTD (reported as trade mark case summary: O/549/01)
- Sabel v Puma AG [1998] RPC 199
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77
- British Sugar v James Robertson [1996] RPC 281
- AD 2000 Trade Mark [1997] RPC 168
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- In the Matter of trade Mark Application No 2011973 by Team Lotus Ventures Ltd to register the Team Lotus Device and in the matter of Opposition Thereto under Opposition 45584 by Group Lotus

Representation:

- Mr P. Sivakumar, assisted by Mr Chan Jin Han (M/s Ella Cheong & G Mirandah) for the Opponents
- Ms Joyce Tan (M/s Assomull & Partners) for the Applicants