

**In The Matter Of A Trade Marks Application By  
Casio Keisanki Kabushiki Kaisha (Casio Computer Limited)  
To Register A Trade Mark In Class 14**

**And**

**Opposition Thereto By  
Columbia Pictures Industries, Inc.**

*Before Assistant Registrar Mr. Wong Sheng Kwai  
15 July 2003*

**Trade Marks** – Opposition to registration – Proprietorship of the mark – whether the Applicant had a bona fide claim to proprietorship to the application mark – whether there had been misappropriation of the mark - Section 12(1) of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

**Trade Marks** – Opposition to registration – Likelihood of confusion – whether the registration of the mark would deceive the public as to the origin of the goods - Section 15 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

The Applicants submitted for registration on 24 October 1997 the mark “MEN IN BLACK” for the goods “Electronic watches and clocks” in class 14. The mark was accepted for registration and advertised on 29 June 1999.

The Opponents opposed the registration of the mark, claiming that they are the proprietors in Singapore of the mark “MEN IN BLACK” by reason of the fact that they own the rights in the motion picture of the same name and for a wide range of goods related to the motion picture.

The Opponents contended that the Applicants could not claim to be the proprietor of the mark. They further argued that there had been a misappropriation of the mark. The Opponents pointed out that the submission of the mark had closely followed the 31 July 1997 release date for the motion picture of the same name. It was submitted that this could not have been a mere coincidence, and that the facts speak for themselves with regards to the misappropriation.

The Opponents also contended that it was likely that the registration of the mark would cause confusion in the minds of the public as to the origin of goods.

They further pointed out that due to the widespread practice of character merchandising, the public here is conditioned to believe that there may be a connection between the Opponent’s motion picture and the Applicants’ goods. “Character merchandising” is a term commonly used to describe the licensing of real and fictional characters on or in relation to goods or services with which the character usually has little or no connection.

**Held, dismissing the Opposition:**

1. Section 12- The Applicant had a bona fide claim to proprietorship of the mark.
2. The onus is for the Opponent to establish misappropriation or bad faith. In this case, in the absence of compelling special facts and evidence, the Registrar would be slow to draw any adverse inference against the Applicants. There was therefore no misappropriation of the mark by the Applicant for the purposes of proprietorship considerations.
3. Section 15 – Although the mark enjoyed tremendous goodwill and reputation as a motion picture internationally and in Singapore, the Opponent had failed to adduce evidence that the movie title had used as a trade mark in Singapore specifically for watches and had gained a reputation as a trade mark.
4. There was also no real risk of confusion on the particular facts of the case, as prospective purchasers of the Applicant’s goods are furnished with information as to the origin of the Applicant’s goods. For example, purchases of watches of some value will invariably come with warranty cards with the identity of the manufacturers indicated therein. While it was accepted that there was a general association by the public between with character merchandising based on movies on a wide range of products including watches, the Opponent had failed to prove that the same applied for movie titles per se. On the facts, there was insufficient evidence adduced to show that the Opponent had actual reputation and mindshare in Singapore for there to be a real tangible danger of confusion.

### **Provisions of legislation discussed**

- Trade Marks Act (Cap. 332, 1992 Rev Ed.) Sections 12 and 15.

### **Cases referred to:**

- Pianotists Co's Application [1906] 23 RPC 777
- Radio Corporation Pty Ltd v Disney [1937] 57 CLR 448
- Smith Hayden & Co's Application [1946] RPC 97
- Vitamins Ltd's Application [1956] RPC 1
- Application by Brown Shoe Co. Inc [1959] RPC 29
- Bali TM [1969] RPC 472
- Genette TM [1968] RPC 148
- Rawhide TM [1962] RPC 133
- Kellogg & Co. v Pacific Food Prodcuts Sdn Bhd [1992] 2 SLR 651
- Re Wong Seng & Sons Bhd's Application and Salamander AG's Opposition [1993] AIPR 252
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147

### **Representation:**

- Ms Patsy Koh with Ms Lee Yi Tey (M/s Arthur Loke Bernard Rada and Lee) for the Applicants
- Ms Lim Siau Wen (M/s Drew & Napier) for the Opponents