

**In The Matter Of A Trade Mark Application By
Seiko Kabushiki Kaisha
(Trading As Seiko Corporation)**

And

**Opposition Thereto By
Montres Rolex S.A.**

*Before Principal Assistant Registrar Anne Loo
31 March 2004*

Trade Marks – Opposition to registration – Likelihood of confusion - 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 the Application Mark will indicate a connection between the Applicant’s goods or services and the Opponent and is likely to 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 – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4)(a) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the requirements under Section 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Deceptiveness – whether the Application Mark is of such a nature as to deceive the public under Section 7(4) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the use of the Application Mark in Singapore is prohibited by any law(s) - Section 7(5) of the Trade Marks Act 1998 [Cap. 332]

The Applicants, Seiko Kabushiki Kaisha (trading as Seiko Corporation), filed Trade Mark Application No. T99/15212J to register the mark “ROOX”, for the goods “watches, clocks, stop watches, horological and chronometric apparatus and instruments; cases, watch boxes, parts and fittings for all the aforesaid goods; all included in Class 14” on 22 December 1999.

The Opponents, Montres Rolex S.A., are the registered proprietors of the trade mark “ROLEX” in respect of “Watches” (T39/00218A in Class 14) and “Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks, and spoons); jewellery; precious stones, horological and other chronometric instruments” (T61/28022I in Class 14). The Opponents have used their mark in Singapore since 1956.

The Opponents filed an opposition under Sections 8(2), 8(3), 8(4), 7(1), 7(4) and 7(5) of the Trade Marks Act 1998. They contend that the Application Mark “ROOX” is so similar to the registered mark “ROLEX” in respect of identical or similar goods that there exists a likelihood of confusion on the part of the public. The Opponents also contend that their mark “ROLEX” is well known in Singapore and registration of the Application Mark “ROOX” would be contrary to Section 8(3). By virtue of the Opponents’ reputation and goodwill in the “ROLEX” mark and because the Opponents’ and the Applicants’ marks are so similar, any use of the Applicants’ “ROOX” mark is likely to deceive and/or cause confusion and/or lead to the Opponents’ goods being passed off as or mistaken for those of the Applicants’. It was also argued that the Application Mark is not distinctive and is of such a nature as to deceive the public. The Opponents finally contend that the use of the Application Mark is prohibited in Singapore.

It was not disputed that the Applicants’ goods and the Opponents’ goods are identical or similar to each other.

Held, allowing the Application Mark to proceed to registration

1. Looking at the marks “ROOX” and “ROLEX” as wholes, taking into account their aural and visual dissimilarities as well as the circumstances of selection and purchase of the relevant goods, the marks are not confusingly similar. The ground of opposition under Section 8(2) therefore fails.
2. One of the main requirements to successfully invoke Section 8(3) is that the relevant goods must not be similar. As it is not disputed that the Applicants’ goods and the Opponents’ goods are identical or similar to each other, the ground of opposition under Section 8(3) fails.
3. To succeed in an action for passing off, the Opponents must prove three elements: a goodwill or reputation in his goods, misrepresentation by the Applicants to the public which causes the public to believe that the Applicants’ goods are the goods of the Opponents and damage by reason of the Applicants’ misrepresentation. The necessary elements of misrepresentation and damage are not established in view of the visual and aural differences between the marks. The ground of opposition under Section 8(4) therefore fails.
4. “ROOX” is an invented word, satisfies the definition of a trade mark, is not devoid of distinctive character, does not offend the requirement in Section 7(1)(c) and does not consist exclusively of signs or indications which traders legitimately and customarily use in their trade. The ground of opposition under Section 7(1) therefore fails.
5. “ROOX” and “ROLEX” are not confusingly similar. “ROOX” itself is an invented word with no meaning and no bearing on the nature, quality or geographical origin of the goods. The Application Mark is therefore not of such a nature as to deceive the public and the ground of opposition under Section 7(4) fails.
6. Under Section 7(5), the Opponents submit that use of the Applicants’ “ROOX” mark on the goods must be prohibited by law because there is a real likelihood that it would lead to the Applicants’ goods being passed off as the Applicants’ goods. As there is no basis found for passing off under Section 8(4), the ground of opposition under Section 7(5) fails.

Provisions of legislation discussed:

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

Cases referred to:

- *Cannock Chase District Council v Kelly* [1978] 1 W.L.R. 1
- *Smith Hayden’s Application* (1946) 63 RPC 97
- “Bali” Trade Mark [1969] RPC 472
- *Jellinek’s Application* (1946) 63 RPC 59
- *Pianotist Co. Application* [1906] 23 RPC 774
- *De Cordova v Vick* (1951) 68 RPC 103
- *Sandow* [1914] 31 RPC 196
- *Aristoc Ltd v Rysta Ltd* (1945) 62 RPC 65
- *Aktiesielskabet Freia Chocolate Fabrik’s Application* [1924] 41 RPC 653
- *In the Matter of Applications by John Taylor Peddie* [1944] 61 RPC 31
- *Otsuka Pharmaceutical Co Ltd v Fumitalia Carlo Erba SpA* [1995] AIPR 86
- *Re Lovens Kemiske Fabrik Ved a Konsted’s Application for Registration of Trade Mark “LEOCILLIN”* [1953] MLJ 215
- *Sabel BV v Puma AG* [1998] E.T.M.R 1
- *Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc* [1999] E.T.M.R 1
- *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V* [2000] FSR 77
- “Buler” Trade Mark [1966] RPC 141
- *BULOVA ACCUTRON Trade Mark* [1969] RPC 102
- *RENNIE MACKINTOSH U.K. Patent Office decision no. 0/143/00*

Representation:

- Mr Dedar Singh Gill with Ms Chen Shu Tyin (M/s Drew & Napier) for the Applicants.
- Mr Tan Bock Hoay with Mr Kelry Loi (M/s Donaldson & Burkinshaw) for the Opponents.