

**In The Matter Of A Trade Mark Application By  
Viacom International Inc**

**And**

**Opposition Thereto By  
Gary Lee Ongkowijaja**

*Before Principal Assistant Registrar P Arul Selvamalar  
7 April 2004*

**Trade Mark Application** – Opposition – whether Applicants’ mark is distinctive, descriptive or customary – whether it has acquired distinctiveness through use – whether the application was made in bad faith - Section 7(1)(a), (b), (c) and (d), 7(2) and 7(6) of the Trade Marks Act 1998.

The Applicants, Viacom International Inc., applied to register a mark comprising the letters, “MTV”, for the services “providing multiple users access to information (only information under class 42) via a global communications network or the world wide web” in Class 42, on 29 February 2000. The Opponent, Gary Lee Ongkowidjaja, is the owner of the domain name address [www.mtv.com.sg](http://www.mtv.com.sg) which has been registered since 23 February 2000 with SGNIC, the Singapore Network Information Centre. The Opponent filed an opposition under sections 7(1)(b), (c) and (d) of the Trade Marks Act 1998 on the basis that the mark was not distinctive and that it was descriptive and/or had become customary. The Applicants argued that they had used their trade mark, “MTV”, in respect of internet services internationally since 1995 via their website and had also registered their mark, “MTV”, in Class 42 for the same or similar services in various countries. The Applicants had also used the mark, “MTV”, in respect of entertainment services since 1981. In Singapore, the Applicants are also the registered proprietors of several marks containing, inter alia, the letters, “MTV”, in respect of entertainment services in Class 41.

**Held, allowing the application to proceed to registration,**

- In order to determine if the mark is distinctive under Section 7(1)(b) for internet services, a consideration was made as to what “MTV” meant at the date of application.
- It was accepted that “MTV” is the abbreviation for “music television”. However, even through the words, “music television”, are descriptive and not distinctive of music being shown on television, the abbreviation of the words, “music television”, ie. “MTV”, was found to be distinctive and not descriptive in respect of music being shown on television or internet services. The case *Staph Guard TM [1967] RPC 165* is not authority for the proposition that every abbreviation of a known word is not distinctive. The opposition under sections 7(1)(b) and (c) failed.
- Even if the mark, “MTV”, was indeed descriptive, the descriptiveness had been overcome through use. The mark, “MTV”, had been used from 1981 to 2000 on music television services. Reliance was placed on *Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147* for the proposition that if a justifiable connection could be established between the goods and services for which a trade mark is known and the goods and services for which the trade mark may not be known, a connection may be made and there may be confusion if the same trade mark is registered for the other goods or services. On the facts, it was found that the average consumer would have knowledge of the Applicants’ music television services, and would expect the Applicants’ internet services if he logs on to the computer and types “MTV”. In the alternative, it was also found that the use of the mark, “MTV”, for internet services from 1995 to 2000 had made the mark, “MTV”, distinctive of internet services.
- The opposition under section 7(1)(d) failed as the Opponent had not discharged his burden of proving that the letters, “MTV”, had become customary for internet services. The Opponent’s evidence, which did not predate the date of application, 29 February 2000, was also in Mandarin and not translated. The mark, “MTV”, was not found to have been customary for internet services under section 7(1)(d).
- The opposition under Section 7(6) failed because of insufficient evidence. There was no other evidence filed in support or the allegation of bad faith on the part of the Applicants other than the fact that the Applicants filed the trade mark application six days after the Opponent’s domain name registration for “[mtv.com.sg](http://mtv.com.sg)”.

- The decision of the Sole Panellist of the Administrative Panel which heard the Applicants' complaint against the Opponent's registration of the domain name address, "mtv.com.sg", was not followed.

**Provisions of legislations discussed:**

- Trade Marks Act (Cap 332, 1999 Revised Ed) sections 7(1)(a), (b), (c) and (d), 7(2) and 7(6)

**Cases referred to:**

- Staph Guard TM [1967] RPC 165
- An Application by the Secretary of State for Defence and Opposition by Arcadia Group Brands Ltd (unreported, United Kingdom Patent Office)
- David West t/a Eastenders v Fuller Smith & Turner Plc [2002] F.S.R. 55 (HC)
- David West t/a Eastenders v Fuller Smith & Turner Plc [2003] F.S.R. 44 (CA)
- An Application by Masterframe Windows for Invalidation of TM 1524198 in the name of Premdor Crosby Limited (unreported; UK Patent Office)
- An Application by Barr Recycling and Opposition by G I Hadfield & Sons. (unreported; UK Patent Office)
- British Sugar v James Robertson & Sons [1996] RPC 281
- Profitmarker [1994] RPC 613
- Torq-Set [1959] RPC 344
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147

**Representation:**

- Mr Dedar Singh Gill with Mr Paul Teo (Drew & Napier) for the Applicants
- Mr Gary Lee Ongkowitz, the Opponent, in person