

**In The Matter Of A Trade Mark Application By
WBL Corporation Ltd**

And

**Opposition Thereto By
Warner Communications, Inc.**

*Before Ms P Arul Selvamalar, Principal Assistant Registrar
3 November 2004*

Trade Marks – Opposition to registration – whether the Applicants had a bona fide claim to proprietorship of the application mark - whether the similarity between the application mark and the Opponents’ mark alone would give rise to an inference of misappropriation - Section 12(1) of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – whether there was a reputation in the Opponents’ mark - whether registration of the application mark would cause confusion or deception as to the origin of the goods - Section 15 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – whether the application mark was identical to or nearly resembles the Opponents’ registered trade mark - Section 23 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

Trade Marks – Opposition to registration – whether there was honest concurrent use - Section 25 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.)

The Applicants are a Singapore company who had applied for registration of a “W” logo mark in class 9 for a wide specification of goods. They restricted their specification of goods during the proceedings. The Opponents are an American corporation which owned 2 registered marks for a W logo, since 1976 and 1991, for goods in classes 9 and 41, respectively. The goods of interest to them were films, sound and video recordings and media in the form of discs and tapes in class 9. The use of the Opponents’ mark showed that they had a reputation in the business of selling music compact discs under their W logo mark since 1990 in Singapore. The Opponents contended that the outrageous similarity between their mark and the application mark was sufficient to give rise to a reasonable inference of copying and bad faith on the Applicants part. The Opponents also contended that because of their reputation, there would be a strong likelihood of confusion and deception if the application mark was allowed registration under section 15 and that there would also be confusion under Section 23.

The Applicants argued that their mark was independently created and that unless the marks are substantially identical or identical, there could not be a finding that there was copying or misappropriation. The Applicants contended that, on a comparison of the marks, there would not be a real, tangible danger of confusion or deception under section 15 or section 23. The Applicants also argued that the application mark had been used concurrently with the Opponents’ mark in Singapore for a period of more than 15 years prior to the date of application.

Held, allowing the application mark to proceed to registration:

1. The Opposition under Section 12 failed. The marks were found to be similar but they were not so similar that the only inference was that the Applicants copied the Opponents’ mark. The types of cases where misappropriation had actually been proven were cases where the marks are identical or almost identical. Misappropriation is also inferred from the facts which disclose how the applicant derived the mark and other circumstances which indicate bad faith. Both marks were stylisations of the letter W, which is the first letter of the company names of both the Applicants and Opponents. The evidence of the Applicants that the mark was independently conceived was accepted. The Opponents had not disproved the Applicants bona fide claim of proprietorship.
2. The opposition under section 15 succeeded. The Opponents were found to have had a reputation in the business of selling music CDs under their W logo mark since 1990 in Singapore. The Opponents’ mark and the Applicants’ mark were found to be visually similar. Whether the Registrar took into account the Applicants’ original specification of goods or the amended specification of goods, there was an overlap in the Applicants’ specification of goods and the goods of interest to the Opponents’. Therefore the goods were also similar. The Applicants had not discharged their burden of proof that the registration of their

mark would not lead to confusion or deception under section 15. The opposition under Section 23 succeeded for similar reasons.

3. The Opponents had used their W logo worldwide since 1972 and the Applicants had used their W logo mark since 1979. There is clear evidence that there has been honest concurrent use of the Applicants' mark in Singapore for about 9 years. There is a clear divergence between the Opponents' business and the Applicants' business although there is an overlap in the specification of goods. The degree of confusion that would result is such that the public would not be greatly inconvenienced. There is also no evidence of actual confusion. Therefore it was found that although there will be confusion under section 15 and 23, in view of the honest concurrent use of the Applicants' mark, the application mark may proceed to registration under section 25.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1992 Rev Ed.) Sections 12(1), 15, 23 and 25.

Cases referred to:

- Pianotist Co [1906] RPC 774
- McDowell [1926] 43 RPC 313 (CA).
- Pirie's Trade marks [1933] 50 RPC 149
- Harrods Ld [1934] RPC 65
- Hacks Application [1941] 58 RPC 91
- Jellinek's Application [1946] 63 RPC 59
- Smith Hayden & Co's Application [1946] RPC 97
- Vitamins Ltd's Application [1956] RPC 1
- Application by Brown Shoe Co [1959] RPC 29
- Rawhide TM [1962] RPC 133
- Genette TM [1968] RPC 148
- Bali TM [1969] RPC 472
- Buler TM [1975] RPC 275.
- Granada TM [1979] RPC 303
- CELINE's S.A's Trade Mark Applications [1985] RPC 388
- RE Star Trade Mark [1990] RPC 522
- Re AUVI TM; Auvi Pte Ltd v Seah Siew Tee & Anor [1992] 1 SLR 639
- Re Jaguar TM [1993] 2 SLR 466.
- Linkworld Technology (S) Pte Ltd v Intel Singapore [1994] AIPR 197
- All Bassam TM [1995] RPC 511
- Samsonite Corp v Montres Rolex SA [1995] AIPR 244
- Dalic TM v Dalic SA [1998] 2 SLR 231
- Canon Kabushiki Kaisha v MGM Inc [1999] FSR 332.
- Kellogg Co v Pacific Foods Sdn Bhd [1999] 2 SLR 651
- PB Foods Ltd v Malanda Dairy Foods [1999] 47 IPR
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147.
- McDonalds Corp. v Future Enterprises [2004] 2 SLR 652
- Give Me Five (SRIS O/133/99) (UK Patent Office)
- 7 Heaven (SRIS O/023/99) (UK Patent Office)
- Application by Bobby Footwear Pte Ltd (a decision of IPOS)

Representation

- Ms Winnie Tham (M/s Allen & Gledhill) for the Applicants
- Mr Lim Teng Leong (M/s Donaldson and Burkinshaw) for the Opponents