

**In The Matter Of An Application By  
Mohamed Mustafa & Samsudin Co Pte Ltd  
To Register A Trade Mark**

**And**

**Opposition Thereto By  
Koyo Seiko Company Limited**

*Before Principal Assistant Registrar Ms. Anne Loo  
24 February 2005*

**Trade Marks** – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

**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 similar to an earlier trade mark and is to be registered for goods or services which are dissimilar to those for which the earlier trade mark is protected - Section 8(3) of the Trade Marks Act 1998 [Cap. 332]

The Applicants MOHAMED MUSTAFA & SAMSUDIN CO PTE LTD, filed the application on the 21 June 2000 for the mark “KOYO” in Class 11 in respect of “Torches for lighting, electric torches, searchlights, lanterns for lighting, installation and apparatus for lighting, electric lamps, light fittings; sockets for electric lights, cookers; electric cooking utensils; parts and fittings for all the aforesaid goods included in Class 11”. The trade mark was accepted and advertised on the 29th June 2001 in the Trade Marks Journal.

The Opponents KOYO SEIKO COMPANY LIMITED (a Japanese company) of 3-5-8, Minami-semba, Chuoku Osaka, Japan, lodged the Notice of Opposition against the trade mark application on the 28th August 2001. The Opponents are the registered trade mark owners of the mark “KOYO” in classes 7, 9 and 12, and have an application for “KOYO” in class 17. The Opponents have also many registrations worldwide and have used the “KOYO” mark worldwide since 1960. In Singapore, the “KOYO” mark has been used since 1972 and the Opponents claim to have valuable goodwill and reputation for their business in the “KOYO” trade mark.

The Opponents contend that the use by the Applicants of the identical trade mark “KOYO” is likely to deceive or cause confusion as to the origin of the goods and/or lead to the Applicant’s goods being passed off or mistaken as the Opponents’ goods. The public will be misled into thinking that the Opponents have diversified into the goods for which registration is sought by the Applicants. The Opponents also state that as the Applicants had copied their mark, they cannot claim to be the bona fide owner of the trade mark applied for as there was bad faith. Further, as the Opponents’ “KOYO” mark is well known in Singapore, the use of the mark by the Applicants is likely to lead to the belief that there is a connection between the Opponents’ “KOYO” trade mark. The Opponents are likely to suffer damage as a result of the confusion

The Applicants state that their evidence shows that the Applicants’ goods are designed and developed in Japan by a “Koyo Co., Ltd” of Osaka, Japan, hence the name “KOYO” was derived from this relationship. The Applicants were directed at the hearing on 24 February 2005 to file a further statutory declaration verifying the existence of the company “Koyo Co., Ltd Osaka, Japan” and clarifying the relationship between the said company and the Applicants. The further evidence was filed on --- and established that the Applicants purchased goods from a third party but do not purchase any goods directly from Koyo Co., Ltd Osaka, Japan. The evidence also showed that the Applicants state were unaware where this third party purchased their goods from, neither did the Applicants know the identity of the supplier of the goods to the third party.

At the hearing, the Opponents proceeded on the Section 7(6), Section 8(2) and Section 8(3) grounds.

**Held, allowing registration**

1. In order to reach a finding under the section 7(6) ground of opposition, all material surrounding circumstances as well as the evidence submitted has to be examined. Although the evidence shows uncanny coincidences which might cause one to “smell a rat”, points out that the Applicants’ evidence lacks credence, has inconsistencies and raises some suspicion of bad faith; where the Opponents have not adduce any other evidence that could lead to the conclusion that there was misappropriation of the Opponents’ marks or any other evidence of fraud, it does not conclusively prove there is bad faith. Bad faith allegations should not be made unless it is distinctly proved, and this is rarely possible by a process of inference. The Opponents have not discharged the burden of proving that there is bad faith under section 7(6) of the Act and the opposition fails under this ground.
2. The Applicants conceded at the hearing that the Applicants’ and the Opponents’ marks are identical as both substantially comprise of the word “KOYO”. Considering the uses, the users, the physical nature of the goods or acts of services, the trade channels through which the goods or services reach the market, the extent to which the goods and services are in competition with each other, the goods applied for by the Applicants in their application are similar to goods of the Opponents’ mark registrations.
3. There is no evidence lodged of confusion or even lack of confusion. Hence, considering the “average consumer, who is considered to be reasonably well informed and reasonably circumspect and observant”; yet not encumbered by the principles of imperfect recollection of a mark or the principle that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various detail as both the marks are identical marks, no confusion is found. The ground of opposition under section 8(2)(a) therefore fails.
4. The marks being identical marks used on similar goods such that there exists a likelihood of confusion, it is not necessary to make a finding under section 8(3) of the Act.

#### **Provisions of legislation discussed**

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(6), 8(2)(b) and 8(3).

#### **Cases referred to:**

- Gaines Animal Foods Ltd’s Application for a Trade Mark [1958] RPC 312,
- Demon Ale [2000] RPC 345
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- Jellinek’s
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- Singapore Trade Mark Application No. 1533/93 by Tai Kwong Battery Industries Sdn Bhd for “Komasu” in Class 9
- Lloyd Shuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77,
- Sabel BV v Puma AG [1998] RPC 199
- Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc. [1999] E.T.M.R 1
- Singapore Trade Mark Application No. 13086/99 by Newmans Chocolates Ltd for “MILKBEARS” in Class 30.

#### **Representation:**

- Mr Patrick Yap (M/s KL Tan & Associates) for the Applicants
- Ms Gooi Chi Duan (M/s Donaldson & Burkinshaw) for the Opponents