

IN The Matter Of Trade Mark Application Nos. T99/07381F And T99/07382D By United Air Lines, Inc.

And

**Opposition Thereto By
United Parcel Service Of America, Inc.**

*Before Principal Assistant Registrar Ms. Elizabeth V. Cardoza
20 September 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 – earlier registered mark which is identical or similar, but for dissimilar goods – Whether the earlier trade mark is well known in Singapore – Whether use of the later trade mark would indicate a connection between the goods or services and the proprietor of the earlier trade mark – Whether there exists a likelihood of confusion on the part of the public because of such use - whether the interests of the proprietor of the earlier trade mark are likely to be damaged by such use - 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]

The Applicant UNITED AIR LINES, INC., a U.S. company incorporated in Delaware, has been providing air transportation and related services since 1929. They had submitted trade mark applications Nos. T99/07381F and T99/07382D for the word mark: “UNITED SERVICES” under Classes 39 and 42 respectively. Both applications were filed on 16th July 1999. The trade mark application T99/07381F for services in Class 39 was for the specifications “Management of aircraft and airfield operations; aircraft runway services; receipt and dispatch of ground baggage; handling of passengers; aircraft fuelling services; airport baggage handling and check-in services; airline ticket booking and reservation services; airline bookings and check-in services, aircraft handling, parking, air travel services; air transportation and airline services for the transportation of passengers, all included in Class 39.” The second trade mark application T99/07382D for services in Class 42 was for “Engineering services; engineering drawing, design and consultancy; development of aircraft; aircraft safety services; aircraft security services; airline passenger safety screening services, all included in Class 42.” (the UNITED SERVICES marks).

In Singapore, the Applicant owns 10 registrations in Class 39 for various trade marks. In relation to the services provided under the marks applied for, the Applicant states that the UNITED SERVICES mark was first used in commerce in the United States on August 1, 1999, and was first used in Singapore on that same date to indicate that they own a worldwide network of maintenance support stations. The Applicant claims an excellent record for high-quality, reliable engine repair and maintenance services. For these services, between 1999 and 2002, the Applicant submitted evidence of annual revenues ranging from US\$80 million (1999) to over US\$215 million (2000, 2001). The Applicant highlighted that it does not provide air transportation of cargo, or transport any cargo at end destinations.

The Opponent is a U.S. corporation incorporated in Delaware, USA, since 1933, and are a express carrier and package delivery company with an average annual revenue of approximately US\$23 billion, shipping approximately 3 billion packages annually, with more than 330,000 employees worldwide. The Opponent owns various trade mark registrations and applications in Singapore covering a range of goods and services in Classes 9, 16 and 25, to 35, 36, 38, 39, and 42 (the UNITED PARCEL SERVICE marks). In Singapore, the Opponent, together with its local subsidiary company, United Parcel Service Singapore Pte. Ltd has used their UNITED PARCEL SERVICE marks since 1988.

The Opponent contends that the Applicant’s marks so nearly resemble the Opponent’s marks that confusion and/or deception is likely to arise from its use or proposed use. The confusion is accentuated by the fact that the services covered by the Opposed mark are the same and/or similar, and associated with/or similar, to the services and

goods under the Applicant's marks. Thus it is highly probable that the public will perceive the Applicant's marks as being an extension of and/or having some connection with the Opponent's marks.

In addition, through the long use of the Opponent's marks in Singapore and worldwide, the Opponents have made them known to the trade and public as distinctive of themselves and no others. The Opponent further contends that the Applicant in its choice of the mark is taking advantage of the Opponents goodwill and reputation and the Applicant cannot claim to be the bona fide proprietor of the marks they are applying for. Finally, the Opponent contends that the use of the Applicant's mark on the services applied for would lead to such services being passed off or mistaken for Opponent's services.

The Applicant submits that there is no likelihood of confusion between its UNITED SERVICES mark and the Opponent's mark UNITED PARCEL SERVICE, as they are dissimilar in appearance, sound and meaning; the services offered are distinguishable and dissimilar; and the customers to whom Applicant renders its services under this mark are a sophisticated group of consumers, not the average consumer, who can easily differentiate between these marks and services. There is no instance of consumers being misled, deceived or confused between Applicant's services and the services offered under the Opponents UNITED PARCEL SERVICES mark, at any time in the last 75 years anywhere in the world whatsoever. The Applicant and the Opponent have co-existed for many years without confusion.

Held, allowing the two applications to proceed to registration

1. There is no clear and compelling evidence before the Registrar to establish any element of dishonesty, let alone bad faith. The Applicant has not been shown to have acted in bad faith in their selection of their mark. The ground of opposition under Section 7(6) fails.
2. The Applicant's word mark UNITED SERVICES, on the evidence, cannot be said to have "acquired" distinctiveness, and the marks will be compared on a normal and relative basis. Visually, the definitive word PARCEL stands out as a dominant and somewhat distinguishing component of the Opponent's mark. For the same reasons, the marks are not starkly similar aurally. The services under the Opponent's UNITED PARCEL SERVICE marks are overall not similar to that under Applicant's trade mark applications. Since there is no issue of similarity of services, there would be no issue of likelihood of confusion. Further, there is no evidence of actual confusion. The opposition under section 8(2b) therefore fails.
3. The evidence shows sales and advertising figures generally for the "UNITED PARCEL SERVICE marks" as a whole, whether worldwide or in Singapore. The sales and advertising figures are not conclusive in themselves; the effect that the advertising material has on the public is unclear; and the print material, though extensive, does not again establish that the mark is well-known. No empirical data was provided to persuade me that the UNITED PARCEL SERVICE mark was well-known in Singapore. The Opponent has not discharged the burden of proving that their mark is well known in Singapore. It was earlier held that there is no likelihood of confusion in the normal use of the marks in view of the fact that the goods are not identical or similar. The ground of opposition under Section 8(3) fails.
4. Although it is not conclusive as to whether the mark is well known, the evidence indicates that the Opponent's mark does have some form of goodwill or reputation. However, there is no clear evidence of any misrepresentation or intention to deceive by the Applicant. The creation of the name as an extension of its mark is supported by reasonable evidence by the Applicant. The Opponent had not submitted sufficient evidence of damage e.g. loss in earnings, loss in reputation. The ground of opposition under Section 8(4a) fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(6), 8(2b), 8(3) and 8(4a).

Cases referred to:

- De Cordova, [1951] RPC
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731.
- Nationwide Building Society [1987] FSR 579.
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- Sabel v Puma [1998] RPC 199
- WILD CHILD TM [1998] RPC 455

- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and Another and Another Appeal [2000] 3 SLR 145

Representation

- Mr Ian Oei (M/s Drew & Napier LLC) for the Opponent.
- Mr Lim Teng Leong (M/s Donaldson & Burkinshaw) for the Applicant