

**In The Matter Of A Trade Mark Application By
Karison Exports Ltd**

And

**Opposition Thereto By
Pre mo International Pte Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar
27 January 2005*

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

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

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 – 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 – whether the use of the Application Mark is liable to be prevented by virtue of the law of copyright - Section 8(4)(b) of the Trade Marks Act 1998 [Cap. 332]

The Applicants filed Trade Mark Application No. T0216533H “Nippon Diesel (& logo)” on 23 October 2002 in respect of “Internal combustion engine assemblies and parts for land vehicles” in Class 12. The Applicants were incorporated in 1995 and are a manufacturer and supplier of diesel automotive parts. The Opponents were incorporated in 1994 and supply vehicle parts and accessories in Singapore under the brand name “Nippon Diesel” and, at times, under their logo comprising a triangle representing the letter “N” and a stylistically extended letter “D”.

The Opponents argued that the Application Mark did not satisfy Section 7(1) of the Trade Marks Act since they used their mark in Singapore before the Applicants. It was also argued that registration of the Application Mark contravenes Section 7(4) of the Act since it would unfairly prejudice the Opponents in their lawful trade and therefore would not be in the interest of the public and trade. It was further argued that the Applicants made this application in bad faith and therefore registration is prohibited under Section 7(6).

Further, the Opponents contended that the Applicants are passing off their goods as the Opponents’ and such use contravenes Section 8(4)(a). Finally, the Opponents claimed that the Applicants infringed the Opponents’ copyright and therefore registration should not be allowed under Section 8(4)(b) of the Act.

Held, disallowing registration of the Application Mark

1. The question of distinctiveness of a trade mark under Section 7(1) is to be determined by reference only to the mark under consideration and not by comparing it with other marks. The Application Mark is capable of distinguishing the Applicants’ goods and therefore the opposition under this section fails.
2. Likewise, Section 7(4) is also to be determined by reference to the mark under consideration only and not by comparing it with other marks. In particular, this ground cannot be made out on the basis that the Opponents’ trade would be affected. The Application Mark is not against public order or morality nor is it of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods. The opposition under this section therefore fails.
3. The Opponents first used the words “Nippon Diesel” and the logo in 1995 and 1994 respectively, before the Applicants did so in 1998. There is evidence that the Applicants knew about the Opponents’ logo as their Managing Director had dealt personally with the Opponents about the engraving of the logo on the Opponents’ goods in 1994, before he set up the Applicant company in 1995. Yet, the Applicants’ Managing Director denied ever having seen the Opponents’ logo as well as other ancillary facts. When confronted with the Opponents’ documentary evidence, the Applicants’ Managing Director did not

explain in further evidence why he made the flat denials. The Applicants' account of how the Application Mark was created was not convincing as there were amazing coincidences in the words, logos and colours of the respective marks. Further, the Applicants' account would have the Registrar believe that the designer of the Application Mark, who runs a corporation himself, would simply allow the Applicants to use the name of his business and the logo he designed as a trade mark for the Applicants' goods. Overall, the marks are so similar (with similar logos and identical words) and the surrounding facts are such that the inference can reasonably be drawn that the Applicants' application is made in bad faith. The opposition therefore succeeds under Section 7(6).

4. The opposition fails under Section 8(4)(a) as the evidence as to reputation is not substantial and there is no evidence as to damage, although the element of misrepresentation may be made out in the Opponents' allegation of passing off.
5. As the Opponents did not substantially argue ownership of copyright in a literary or artistic work nor provide sufficient proof of substantial copying of the literary or artistic work, the ground of opposition under Section 8(4)(b) fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(1), 7(4), 7(6), 8(4)(a), and 8(4)(b)

Cases referred to:

- Dalic TM [1998] 2 SLR 231
- National Dairies Ltd v Xie Chun Trading Pte Ltd [1998] 1 SLR 620
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- CA Sheimer (M) Sdn Bhd's TM Application [2000] RPC 484
- Alteco Chemical Pte Ltd v Chong Yean Wah t/a Yamayo Stationery Manufacturer [2000] 1 SLR 119
- Auvi Pte Ltd v Seah Siew Tee [1992] 1 SLR 639
- KARO Step TM [1977] RPC 255
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- Momentum Creations Pte Ltd v Tan Eng Koon t/a De Angeli [2003] 1 SLR 342
- Draper v Trist [1939] 3 ALL ER 513 CA
- Gromax Plasticulture v Don & Low Nonwovens [1999] RPC 367
- The European Limited v The Economist Newspapers Limited [1998] FSR 283
- In the matter of a trade mark application no. 5495/90 by Coway Investment and Opposition by KK Hattori Seiko [1999] SGIPOS
- In the matter of application no. 2913/91 by Interlicence and Distribution Ltd and Opposition by Dorgi Manufacturing Pte Ltd (IPOS decision)
- Jif Lemon case [1990] RPC 341
- G.E. [1973] RPC 321-322 HL
- Scandecor v Scandecor [1998] FSR 500
- Sabel BV v Puma AG [1998] RPC 199
- Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BC C-342/97 [1999] E.T.M.R. 690
- Pirie's Case (1933) 50 RPC
- Buler TM [1975] RPC 275
- MacDonald's Corporation v Future Enterprises [2004] SGCA 50
- Royal Enfield TM [2002] RPC 24
- Application by Brown Shoe Co Inc [1959] RPC 59
- Vitamins Ltd's Application [1956] RPC 1
- Exxon Corporation & Others v Exxon Insurance Consultation International Ltd [1982] RPC 69

Representation

- Mr Brian Tan and Ms Zarinah Marican (Madhavan Partnership) for the Applicants
- Ms Tan E-Fang (Hin Tat Augustine & Partners) for the Opponents