

**In The Matter Of A Trade Mark Application
Nos. T96/11883 & T96/11963 By Sega Corporation**

And

**Opposition Thereto By
Segafredo Zanetti S.P.A.**

*Before Principal Assistant Registrar P Arul Selvamalar
08 November 2005*

Trade Mark – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the requirement of distinctiveness under Section 10 of the Trade Marks Act [Cap.332, 1992 Ed.]

Trade Mark – Opposition to registration – Proprietorship of the mark – whether the Applicant had a bona fide claim to proprietorship of the Application Mark – Section 12(1) of the Trade Marks Act [Cap.332, 1992 Ed.]

Trade Mark – Opposition to registration – whether registration of the Application Mark would cause confusion or deception – Section 15 of the Trade Marks Act [Cap.332, 1992 Ed.]

Trade Mark – Opposition to registration – whether the Application Mark is similar to an earlier registered trade mark – Section 23 of the Trade Marks Act [Cap.332, 1992 Ed.]

The Applicants, Sega Enterprises Ltd, a Japanese company, now known as Sega Corporation, applied for registration of a mark “SEGA” [T96/11883] in a stylised form, for the goods “Tea, sugar, rice, tapioca, sago; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; coffee, cocoa, artificial coffee; flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices” in class 30 on 2 November 1996. On 5 November 1996, they applied for another mark “SEGA” [T96/11963] which was not stylised, for the same goods in the same class.

The Opponents, Segafredo Zanetti S p A, an Italian company, are the owners of a registered trade mark no. T84/04147 for the words Segafredo Zanetti in class 30, for the goods, “Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes” in Singapore. They also own registered trade marks Segafredo Zanetti Emozioni [T96/04337] and Segafredo Zanetti Intermezzo [T96/04338], both in class 30 for the goods “coffee”. These marks were registered in 1996 before the Applicant’s applications.

The Applicants are manufacturers and distributors of amusement machines and they also operate amusement arcades. They have also used their mark “SEGA” since 1960 in Japan but presumably on amusement machines and amusement arcade services. Their sales turnover ranges from \$5 billion in 1993 to \$4 billion in 1997. The Opponents first used their Segafredo mark in Italy in 1960 and registered it in 1963. They have registrations in the United States of America, Great Britain, India, Hong Kong, Australia and New Zealand. Their annual sales turnover in Singapore ranges from \$8,274 in 1989; to \$2,064 in 1990; to \$30,756 in 1995. Thereafter there was a decrease in their sales figures to \$7,224 in 1996 and a subsequent increase to \$9,101 in 1997.

Held, allowing the application mark to proceed to registration,

1. The Opponents have been using their Segafredo mark in Italy since 1960 and in Singapore since 1989. However the extent of their sales plus the fact that they sold only to 2 entities in Singapore, is insufficient evidence to establish the kind of reputation required under Section 15. The only visual similarity between the Applicants mark SEGA and the Opponents mark Segafredo, is in the first 4 letters of the marks Sega. The Opponent’s mark is a 4 syllabic word, Se-ga-fre-do while the Applicant’s mark is a 2 syllabic word, Se-ga. The Opponent’s mark, Segafredo would not naturally and obviously be abbreviated to Sega. “Sega” is not more distinctive than “fredo” as it is not the type of mark where one part is invented and the second part is descriptive, so the invented part becomes the distinctive part of the mark. The whole mark is a distinctive Italian sounding name. There is no reasonable likelihood of confusion or deception among a substantial number of Singaporeans if the Applicants mark is registered. Therefore, Opposition under Section 15 fails.
2. The comparison of marks under Section 23 is similar to the comparison under Section 15. The Opponent’s registered marks, Segafredo, Segafredo Zanetti Emozioni and Segafredo Zanetti Intermezzo and the

Applicant's marks are not confusingly or deceptively similar and they do not nearly resemble each other as required under Section 23. The Opposition under Section 23 fails.

3. The Opponents argued that the Applicants have not used their trade mark on class 30 goods and that their use was not trade mark use, as their mark was used together with other marks. However, the Registrar cannot speculate how the Applicants will use their marks in Singapore, nor can she presume that because they have used it in a particular way hitherto, they will only use it in the same way in the future; and decide that way of using the mark is not trade mark use and therefore disallow the mark. The opposition fails under Section 10.
4. The Applicants have used the mark Sega on amusement machines, interactive entertainment software and computer and video gaming equipment and their global sales turnover ranges from S\$5 billion to S\$4 billion from 1993 to 1996. They started using the mark Sega in 1960 in Japan, about the same time that the Opponents started using their mark Segafredo in Italy on Coffee. Bad faith cannot be made out solely on the basis that the Applicants now want to register a mark they have been using since 1960 on goods that are similar to the goods of interest to the Opponents. Further, the marks are too dissimilar. Therefore, opposition fails under Section 12.

Provisions of Legislation discussed:

- Trade Marks Act [Cap.332, 1992, Rev Ed.] Sections 15, 23, 10 and 12.

Case referred to:

- Smith Hayden & Co's Application (1946) RPC 97
- Pianotist Co Ltd's Application (1906) 23 RPC 774
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Bluestar Exchange (S) Pte Ltd v Teoh Keng Long & Ors [2003] SGHC 169
- Semigres TM [1979] RPC 330
- Unimax TM [1979] RPC 469
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- Weldmesh [1966] RPC 220
- ITC Limited v Dunhill Tobacco of London Ltd 2004 [SGIPOS] 4
- Bailey (1935) 52 RPC 136
- Kellogg Co v Pacific products Sdn Bhd [1999] 2 SLR 651
- MacDonald's Corporation v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Bali TM [1969] RPC 472
- Reckitt & Colman Products Ltd v Borden Inc [1990] 1 All E R 873

Representation:

- Ms Regina Quek and Ms Patsy Koh (One Legal LLC) for the Applicants
- Ms Elaine Tan (Allen & Gledhill) for the Opponents