

**In The Matter Of A Trade Mark Application By
Grand Tec Resources Pte Ltd**

And

**Opposition Thereto By
The Gates Corporation**

*Before Principal Assistant Registrar Mr Dennis Low
08 February 2006*

Trade Mark – 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) of the Trade Marks Act 1998 [Cap. 332]

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

The Applicants, Grand Tec Resources Pte Ltd filed an application for the mark T02/17200H “GT DRIVES & Logo” (“the Application Mark”) in Class 7 in respect of “Belts for machines for industrial purposes; Belts for motors and engines used in cars; all included in Class 7” on 31 October 2002. The Opponents, Gates Corporation, a company incorporated in USA, lodged a Notice of Opposition against the trade mark application on 25 April 2003. The Opponents claim to be the proprietors of the mark “GT”, which they have used and advertised in Singapore as well as in other jurisdictions. They have also registered or applied for registration of the ir “GT” trade mark in other countries.

The Opponents contended that through continuous and extensive use of their “GT” mark both locally and internationally over a long period of time, it has acquired goodwill and fame in Singapore and that the said “GT” mark is entitled to protection under the Paris Convention or the TRIPS Agreement as a well-known mark in Singapore. The Applicants’ mark “GT DRIVES and Logo” is both visually and phonetically very similar to the Opponents’ “GT” mark and is used on goods which are similar to the goods covered by the Opponents’ “GT” mark. By virtue of the reputation of the Opponents’ “GT” mark, registration of the Applicants’ mark would be contrary to section 8(2) of the Act.

The Opponents further contended that by virtue of the Opponents’ valuable reputation and goodwill in their “GT” mark and because the Opponents’ and the Applicants’ marks are so similar, any use of the Applicants’ “GT DRIVES & Logo” mark is likely to deceive and/or cause confusion and/or lead to the Applicants’ goods being passed off as or mistaken for those of the Opponents’. This would be contrary to section 8(4)(a) of the Act.

The Opponents also submitted that the Applicants knew of the Opponents’ mark and that the application was made in bad faith. The use or intended use of the Application Mark is therefore not bona fide and is contrary to section 7(6) of the Act.

Held, disallowing registration,

1. From a global consideration of all the facts and evidence of the case, it was found that the marks are similar, that the Opponents’ and the Applicants’ goods are similar and that there would be a likelihood of confusion.
2. Although the marks are confusingly similar, the Opponents failed to discharge their burden of proof that the “GT” mark is well known in Singapore. To show that a mark is well known, the type of evidence that is required is more substantial than just evidence of sales revenue and advertising expenditure. From the evidence furnished by the Opponents, the “GT” mark is always used in conjunction with other marks. Even though a mark is able to acquire distinctiveness through such use, the evidence furnished in this case is not sufficient to establish the claim of “GT” as a well-known trade mark. Furthermore, the Opponents’ advertisements in the Yellow Pages do not even show the “GT” mark at all. Such practice is totally

inconsistent with the Opponents' claim that the "GT" mark is a well-known mark. The ground of opposition under section 8(2) therefore failed.

3. The Opponents had established substantial use of and goodwill in the mark GT even if it was together with other marks. It was also found that the two marks in this case are similar and the consumers are likely to be confused. However, the Opponents did not substantially submit on damage that would be suffered by them, but merely argued that it is usually presumed. Although the elements of goodwill and misrepresentation may be made out, the submission made and evidence furnished in relation to damage were insufficient and insubstantial. The ground of Opposition under section 8(4) therefore failed.
4. The facts of this case revealed that the Opponents had terminated the employment of one Victor Lian, who registered the Applicant company within one week of leaving the Opponents' employment. Although he explained that the derivation of the mark "GT DRIVES & Logo" was from the name of the applicant company Grand Tec, this evidence was rejected. The two marks were confusingly similar and the surrounding facts were such that an inference of bad faith can be reasonably drawn. The opposition succeeded under section 7(6).

Provisions of Legislation discussed:

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 2(1), 7(6), 8 (2)b, and 8 (4)a.

Case referred to:

- Sabel BV v Puma AG [1998] R.P.C. 199
- Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] E.T.M.R. 1
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] FSR 77
- In the Matter of a Trade Mark Application by E! Entertainment Television, 17 January 2005
- Pianotist Co. Application [1906] 23 RPC 774
- Safari Trade Mark [2002] RPC 23
- Societe des Produits Nestle SA v Mar UK Ltd [2006] FSR 2
- Newmans Chocolates Ltd v Societe des Produits Nestle SA [2003] SGIPOS 2
- British Sugar v James Robertson [1996] RPC 281
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Yoo Hoon Chocolate Beverage Corporation in respect of Registration No 1430368 (SRIS O/100/97)
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] SGHC 51
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177

Representation:

- Ms Lim Siau Wen (M/s Drew & Napier LLC) for the Opponents.
- Ms Jo-Ann See with Ms Jo Yeo (M/s Allen & Gledhill) for the Applicants.