

**In A Matter Of A Trade Mark Application No. T03/09642I By
Ismet Nadir Aslan**

And

**Opposition Thereto By
Oracle International Corporation**

*Before Principal Assistant Registrar Mr. Kelvin Sum
10 March 2006*

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 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 earlier trade mark is well known in Singapore – whether the use of the later trade mark would indicate a connection – whether there exists a likelihood of confusion – whether the interests of the proprietor of the earlier trade mark are likely to be damaged – 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 is a Swedish citizen who applied for registration of a trade mark “ORACLEOLOGY” on 3rd July 2003. The application was filed in class 42 in respect of “Scientific and Technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware and software, legal services”.

The Opponent is an American company and are the prior registered owners of several registered marks (i) T84/02040A for “ORACLE” in class 9 for the goods “pre-recorded computer programs recorded on tapes; disks and diskettes”, (ii) T89/00313J for “ORACLE SQL.PLUS” in class 9 for the goods “computer programs included in class 9”, (iii) T84/02041Z for “ORACLE” in class 16 for the goods “introductory manuals, user manuals and guide books, all being printed and all relating to the operation of computerised data-based management systems”. There is a history of products and services going back to 1977 for the Opponent and to date, the Opponent and its associated companies submit that they are the world’s second largest supplier for software for information management, with annual revenues of USD\$10 billion. The Opponent’s marks were first used in Singapore in 1988 and the Opponent’s revenue from sales in Singapore from the year 1989 to year 2003 ranges from S\$4,204,861.00 to S\$97,942,844.00. The Opponent’s advertising and promotion figures for Singapore ranges from S\$800, 000 in year 2001 to S\$600, 000 in year 2003.

The Applicant submitted evidence to the creation of the mark “ORACLEOLOGY”, stating that his grandfather was of Greek descent and so the Applicant, as a child, had always remembered his stories about wisdom (i.e. oracle). The Applicant further submitted that the “ORACLE” portion of his mark is used to describe his childhood days of listening to stories of wisdom and “LOGY” from the modern technological era, adding an “O” was part of the Applicant’s creativity and innovation. He submitted that the word “ORACLE” is a generic term of use and existed thousands of years before Christ (B.C.).

The Opponent argued that the Applicant’s mark should not be registered as there is similarity in terms of the mark and the goods claimed and in view of this and that the Opponent’s mark is well known in Singapore, there will be a strong risk that confusion will arise on the part of public as such registration of the mark would be contrary to the provision of section 8(2)b and section 8(3). Furthermore, the registration of the mark would be contrary to the law of passing off under section 8(4) and it would also contravene section 7(6) of the Trade Marks Act.

Held, disallowing registration:

1. The Opponent’s mark is “ORACLE” while the Applicant’s mark is “ORACLEOLOGY”, which means that every time the Applicant’s mark is enunciated, there would be a specific mention of the Opponent’s

mark. The extra syllables in the suffix that may serve to distinguish the two marks phonetically may not have enough of an effect to distinguish the two marks visually and conceptually, especially where the whole of the Opponent's distinctive mark appears in the Applicant's mark. The services in relation to the Applicant's mark relating to "design and development of computer hardware and software" are similar to the Opponent's class 9 goods relating to "computer programs". Further, there exists a likelihood of confusion on the part of the relevant public who are looking to purchase or obtain software, even if the relevant public include IT specialists. The opposition succeeds under 8(2)b.

2. As it was earlier held under Section 8(2b) that the goods and services are similar, the elements of Section 8(3) are not satisfied, in particular Section 8(3b), and the opposition under this alternate ground fails.
3. There is substantial goodwill and reputation in the Opponent and its marks in Singapore, across a relevant portion of the public. However, the Opponent has not given evidence other than bare allegations on how the substantial goodwill and reputation would be damaged as a result of the Applicant's probable activities. Since one of the elements necessary for this ground of opposition is not present, the opposition fails under Section 8(4a).
4. There must be clear and sufficient evidence to make out the allegation of bad faith. The Opponent's submissions centre around an absence of a bona fide intention of use. However, there is insufficient evidence to establish or give rise to an irresistible inference that there is bad faith. There is no evidence of an intention to misappropriate the Opponent's marks. The opposition therefore fails under Section 7(6).

Provision of legislation discussed:

- Trade Marks Act 1998 [Cap.332, Rev Ed.] Sections, 7(6), 8(2)b, 8(3) and 8(4)a.

Cases Referred to:

- Microsoft Corporation v Lindows Inc. (Case No C01-2115C, US 9th Circuit, District of Washington)
- Sabel v Puma [1998] RPC 199
- The Polo/Lauren Co, LP v Shop in Department Store Pte Ltd [2005] 4 SLR 816
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit [2005] SGHC 225
- Calormatic v Calor (O/53/05)
- Listerpower (O/033/05)
- Reemark GEellschaft fur Markenkooperation mBH v OHIM (Trade mark and Designs) (Westlife v West) (CFI Case T-22/04)
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- South Beach Café (O/196/00)
- Registrar of Trade marks v Woolsworth [1999] FCA 1020
- N.V. Sumatra Tobacco Trading Company v Hero (TM Opposition T00/02450H)
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD TM [1998] RPC 455
- McDonald's Corp v Future Enterprises [2004] SGCA 50

Representation:

- Mr. Paul Teo (M/s Drew & Napier LLC) for the Opponents
- Mr. Leong Wai Nam (M/s Nathan Isaac & Co.) for the Applicants