

**In The Matter Of A Trade Mark Application No T03/02011 By  
Mitsubishi Jodosha Kabushiki Kaisha**

**And**

**Opposition Thereto By  
Iveco S.p.A.**

*Before Principal Assistant Registrar of Trade Marks, Ms P Arul Selvamalar  
15 May 2007*

**Trade Marks** – Opposition to registration – Likelihood of confusion - whether the Application Mark is confusingly 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 2006 Revised Edition]

**Trade Marks** - Opposition to registration - whether the Applicant's use of the Application mark would constitute passing off - Section 8(7) of the Trade Marks Act [Cap. 332 2006 Revised Edition]

The Applicants, Mitsubishi Jodosha Kabushiki Kaisha, applied on 14 Feb 2003 for registration of a trade mark “MIVEC” in class 7 for the goods “Air cleaners for engines, air cleaning filters for the air intake of engines or motors, air filters being parts of engines, air filters for engines, belts for motors and engines, cylinder heads for engines, electronic devices for starting engines, electronic starters for engines”.

The Opponents, Iveco S.p.A, filed an opposition to the registration of the application mark on the basis of their registrations for the mark “IVECO” in 2 classes - class 7 [T86/003620H] for the goods, “machine tools; motors (not for land vehicles); machine couplings and machine belting; and parts and fittings included in class 7 for all the aforesaid goods”, and class 12 [T86/03619D] for the goods “motor land vehicles; motors for land vehicles; couplings and beltings, all for land vehicles; parts and fittings included in class 12 for all the aforesaid goods”. The Opponents raised objections under sections 8(2)(b) and 8(7) [then 8(4) before the 2004 amendments] of the Trade Marks Act (1998) (hereinafter referred to as “TMA”). At the hearing of the opposition, the Opponents attempted to include in their oral submissions, arguments based on section 8(3) of the Act but as this provision was not pleaded, the Hearing Officer did not allow the Opponents to proceed on that ground.

The Opponents contended that they have been using their IVECO mark since 1975 worldwide and in Singapore since 1983 via a Singapore company, VMD Pte Ltd. They claimed to be a global leader in machine tools, motors, couplings and machine belting as well as motor land vehicles and have extensive market share throughout the world. Their contention was that the marks in question were confusingly similar and used on similar goods which would lead to a likelihood of confusion under section 8(2)(b) and passing off under section 8(4) [now 8(7) of the TMA].

The Applicants contended that they are a global dealer in the manufacture of automobiles and automobile parts and have been using the “MIVEC” mark worldwide since 1992 and in Singapore since 1997. “MIVEC” is coined from the phrase “Mitsubishi Innovative Valve timing and lift Electronic Control”. Their goods are sold by the Applicants, its licensees and authorized distributors in more than 170 countries. The Applicants’ focus is on passenger automobiles whereas the Opponents’ focus is on heavy and commercial vehicles. The component parts used in the manufacture and assembly of passenger automobiles are different from those used in heavy commercial vehicles. The marks in question co-exist in 8 countries.

**Held, allowing the application mark to proceed to registration**

1. Considering the Opponents’ registration for “IVECO” class 7, the same class for which the Applicants are applying for the mark “MIVEC”, the marks are aurally, visually and conceptually dissimilar.
2. Taking into account the entire width of the specification in the Applicants’ application and the entire width of the specification in the Opponents’ registered mark in class 7, the goods are similar as the Opponents’ and the Applicants’ specification of goods comprises identical goods like “machine beltings” and others which are similar.
3. The purchase of a motor vehicle part is not a simple transaction, as a compatible part has to be selected for a vehicle. Two parties will be involved in the selection of the vehicle part, the person fitting the part to the vehicle, namely the technician, and the vehicle owner who will ultimately pay for the vehicle part.

Whether confusion is likely to result must be considered taking into account the actual mechanism of purchase of vehicle parts by the vehicle owners, as compatible parts have to be purchased for fitting into vehicles by technicians who will exercise more care in the purchase. Considering all the circumstances, it is unlikely that a substantial number of average consumers would be confused by the marks in question.

4. Having found that the marks are not confusingly similar, there is no misrepresentation, which a requirement under the law of passing off. As one of the 3 elements to be proved under the tort of passing off has not been satisfied, the opposition under section 8(7) [then section 8(4)] failed.

**Provisions of Legislation discussed:**

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.) Sections 8(2)(b) and 8(7).

**Cases referred to:**

- Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2005] 4 SLR 816
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199
- Pianotist Company Ltd (1906) 23 RPC 774
- Rlichemont International SA v Goldlion Enterprise (S) Pte Ltd [2006] 1 SLR 401
- London Lubricants (1925) 42 RPC
- Aristoc Ltd v Rysta Ltd [1945] 62 RPC 65
- Wagamama v City Centre Restaurants [1995] FSR 713
- React Music Limited v Update Clothing Limited [2000] RPC 285
- E! Entertainment Television, Inc v Deutsche Telekom [2005] SGIPOS 5
- Proctor & Gamble v Pugsley Dingman (1929) 46 RPC 421
- Lauritzen's Application (1931) 48 RPC 392
- Slazenger v Feltham (1889) 6 RPC 392
- Magdalena Securities (1931) 48 RPC 477
- Sporoptic Pouilloux SA v Arnet Optic Illusions Inc (1995) 32 IPR 430
- Valentine Meat Juice v Valentine Extract (1900) 17 RPC 673
- Marshall's Application (1943) 60 RPC 147
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuffs Pte Ltd [1991] 2 MLJ 361
- Caterpillar Inc v Ong Eng Peng [2006] 2 SLR 669
- Lancer TM [1987] RPC 303
- FIF TM [1979] RPC 355
- Reebok International Ltd v JH Imort Export Co (1997) 40 IPR 535
- Gilead Sciences Inc v Glaxo Group Limited [2006] SGIPOS 12 Re Trade Mark "Cameo" (1974) 1 NZIPR 1 RHEUMATION TM [1978] RPC 406
- Spa Esprit v Esprit International [2005] SGIPOS 2
- First Principal Financial Pte Ltd v Principal Financial Group, Inc [2006] SGIPOS 2
- CODAS TM [2001] RPC 14 and Pirie's TM [1933] 50 RPC 149
- Trend Promoters (M) Sdn Bhd v Simmons Company [2005] SGIPOS 8
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550 J
- JM Collective Pte Ltd v Perlini's Pte Ltd [2005] SGIPOS 4

**Representation:**

- Mr. Peter Lo (Shooklin & Bok) for the Applicants
- Ms. Ngoi Soon Hui (Drew & Napier LLC) for the Opponents