

In The Matter Of An Application By Hu Kim Ai T/A Geneve Timepiece

For Declaration of Invalidity Of

**Registered Trade Mark T99/08070G
In The Name Of Liew Yew thoong T/A Crystal Hour**

*Before Principal Assistant Registrar of Trade Marks, Ms Anne Loo
20 June 2007*

Trade Marks – Invalidation proceedings – whether the application to register was made in bad faith – Section 23(1) in reference to section 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Invalidation proceedings – whether the registered mark is identical to an earlier trade mark and is registered for goods or services identical with those for which the earlier trade mark is protected – Section 23(3)(a)(i) in reference to section 8(1) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Invalidation proceedings – Likelihood of confusion - whether the registered mark is identical to an earlier trade mark and is registered for goods or services similar to those for which the earlier trade mark is protected – Section 23(3)(a)(i) in reference to section 8(2)(a) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Invalidation proceedings – Likelihood of confusion - whether the registered mark is similar to an earlier trade mark and is registered for goods or services identical with or similar to those for which the earlier trade mark is protected – Section 23(3)(a)(i) in reference to section 8(2)(b) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Invalidation proceedings – whether the Applicant’s use of the Application Mark would constitute passing off - Section 23(3)(b) in reference to Section 8(4) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed. [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

The Applicant for the declaration of invalidity, Hu Kim Ai t/a Geneve Timepiece (“the Applicant”), filed the application for declaration of invalidity on 12 March 2004 of the trade mark registration no. T99/08070G. The mark consists of the word “COMMODORE” and the device of 5 stars (as shown below) and was registered on 2 August 1999 in Class 14 in respect of “Horological and chronometric instruments; all included in Class 14” in the name of LIEW YEW THOONG t/a Crystal Hour (hereinafter referred to as “the Registered Proprietor”).



The Applicant is the registered proprietor of trade mark numbers T97/06504B and T01/09283C both in Class 14. The Applicant’s marks are as shown below:

T97/06504B Class 14 Date of registration: 4 June 1997	T01/09283C Class 14 Date of Registration: 30 June 2001
 “Horological and chronometric instrument.”	 “Clocks; horological and chronometric instruments; watches; parts and fittings therefor, all included in Class 14.”

The Applicant contended that their main business is in the import, export, wholesale and retail business of various

types of watches. They began selling watches bearing the “BLANSACAR” and 5 Star Device” trade mark sometime on or about 31 December 1993 in Malaysia. The Applicant’s marks are registered in several jurisdictions with different permutations of the word “BLANSACAR”, the 5 Star Device” and the Chinese Characters the transliteration of which is “WU XING SHANG JIANG”. The Applicant also contended that both the Registered Proprietor’s and the Applicant’s watches have the “5 Star Device” on the face of the watches and are known by the Chinese name “WU XING SHANG JIANG”; hence it would be difficult for non-English speaking buyers who do not understand English to differentiate between the watches belonging to the Applicant and the Registered Proprietor.

The Registered Proprietor contended that their “COMMODORE” mark and the Applicant’s “BLANSACAR” and 5 Star Device” trade mark are registered in several jurisdictions. The marks coexist on the Australian register. In Indonesia, the Registered Proprietor owns a registered trade mark with a 5 star device and the word “COMMANDER”, which coexists with the Applicant’s mark as represented in T97/06504B. The Registered Proprietor started using the “COMMANDER” trade mark with the 5 star device in Singapore as early as February/March 1988. In August 1999, the Registered Proprietor’s trade mark “COMMODORE” and “5 Star Device” was registered in Singapore and use of the mark commenced in 2001. The Registered Proprietor’s trade mark has never been known as “WU XING SHANG JIANG” as alleged by the Applicant.

The Applicant and the Registered Proprietor did not dispute that they had been acquainted with each other for a number of years before the date of registration of the mark; and due to the competing nature of their goods, they had become business competitors.

Held, dismissing the application for invalidation with costs to the registered proprietor of TM No. T99/08070G

1. There is clearly a long history between the Applicant and the Registered Proprietor. However, the long relationship per se does not automatically impute that there is bad faith. Although there were some similarities between the Registered Proprietor’s and the Applicant’s packaging, this was not conclusive evidence for a finding of bad faith. The Applicant therefore failed under section 23(1) in reference to section 7(6).
2. In respect of the application for invalidation, as the Registered Proprietor’s mark was registered on the 2 August 1999, only the Applicant’s first mark T97/06504B which was registered on the 4 June 1997 is relevant to the proceedings. There is no dispute that the goods of the Registered Proprietor’s registration and the Applicant’s registration T97/06504B are identical goods. However, the marks of the Registered Proprietor and the Applicant however are not identical within the meaning of section 8(1).
3. As the marks are not identical, there was no need to consider section 8(2) (a) which requires that the marks be identical.
4. Visually, the 2 marks are not similar. The Applicant’s mark has 3 different elements in it - the “5 Star Device”, the word “BLANSACAR” and 4 Chinese characters. The Registered Proprietor’s mark is made up of the same “5 Star Device” and the word “COMMODORE”. The words “BLANSACAR” and “COMMODORE” are very visually different and serve to distinguish one mark from the other. The difference is further enhanced by the 4 Chinese characters in the Applicant’s mark.
5. The marks are also not aurally similar. Where marks have English words (whether proper English words with meaning or invented words like “BLANSACAR”), there is a tendency for the consumers to refer to the marks by that word, for words speak in marks. It would be inconceivable to say that words “BLANSACAR” and “COMMODORE” have the same pronunciation. Further, as there are Chinese characters in the Applicant’s mark, it may also be referred to as “Wu Xing Shang Jiang” by persons who are literate in the Chinese language.
6. The 2 marks are also conceptually dissimilar. The Oxford English Dictionary has definitions for the word “COMMODORE”. The Applicant’s mark “BLANSACAR” is taken to be an invented word.
7. Since the two trademarks are not similar and there is no dispute that the goods of the Registered Proprietor are identical or similar to the Applicant’s goods; there is no need to determine whether or not there might be confusion if both marks are used under section 8(2) (b). The marks have been in the market since 1999 and there is no evidence of actual confusion or deception adduced. The Applicant’s own evidence shows that the word “BLANSACAR” is always used on their goods and advertisements, and this shows that the 5 Star device is never used on its own. In the premises, there would not be any likelihood of confusion. The Applicant therefore failed under section 23(3)(a)(i) in reference to section 8(2)(b).
8. The three elements of goodwill, misrepresentation and damage stated must be proved cumulatively to succeed in an action for passing off. Having found that the mark in T97/06504B is not similar to the Registered Proprietor’s mark and that there is no likelihood of confusion between the 2 marks under the section 8(2), the second element - misrepresentation – which is required in order for the passing off action to succeed is not proven. The Applicant therefore failed under section 23(3)(b) in reference to section 8(4) [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

Provisions of Legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed.], Section 23 by reference to sections 7(6), 8(2) and 8(4) [now 8(7) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

Cases referred to

- In The Matter Of A Trade Mark Application By Trend Promoters (Malaysia) Sdn Bhd [2005] SGIPOS
- SA Societe LTJ Diffusion case ECJ [2003]
- National Aerated Water Co Pte Ltd v Monarch [2000] 2 SLR 24
- In the matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark (1906) 23 RPC 774
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175
- McDonald's Corp v Future Enterprises [2005] 1 SLR 195
- McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Gromax Platiculture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Nautical Nautical Concept Pte Ltd v Mark Richard Jeffery and Another [2006] SGHC 239
- WILD CHILD TM [1998] RPC 455
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit [2005] SGHC 225

Representation:

- Mr Adrian Ee (M/s Ramdas & Wong) for the Applicant
- Mr Daniel Lim (M/s Khattar Wong) for the Registered Proprietor