

In The Matter Of A Trade Mark Application No. T02/05501Z By Hyundai Mobis

And

**Opposition Thereto By
Mobil Petroleum Company, Inc**

*Before Principal Assistant Registrar of Trade Marks, Ms P Arul Selvamalar
26 June 2007*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark is a sign devoid of any distinctive character under Sections 7(1)(b) of the Trade Marks Act 1998 [Cap. 332]

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 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]

Trade Marks – Opposition to registration – whether the Application Mark is similar to an earlier trade mark which is well known in Singapore and is to be registered for goods or services not similar to those for which the earlier trade mark is protected – whether the use of the Application Mark on such goods or services would indicate a connection between them and those for the earlier mark – whether there is 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(7) of the Trade Marks Act 1998 [Cap. 332]

The Applicant, Hyundai Mobis, applied for registration of a trade mark “MOBIS” on 17 April 2002 for the goods “automobile apparatus and equipment, automobile mechanisms, engines automobile bodies, sections, devices including safety and anti-theft devices, automobile componentary segments, parts fittings and accessories for automobiles being goods in class 12”.

The Opponent, Mobil Petroleum Company, Inc, filed an opposition on the basis of their earlier applications or registrations for the mark “MOBIL” in various classes. The Opponent raised objections under sections 7(1), 7(6), 8(2) (b), 8(3) and 8(7) [then 8(4) before the 2004 amendments] of the Trade Marks Act (1998) (hereinafter referred to as “TMA”)

The Opponent contended that by virtue the Opponent’s or related Exxon Mobil companies’ proprietorship of the mark “MOBIL” or “MOBIL” derivative marks in several classes in Singapore (49 registrations) and worldwide (179 countries) and the extensive promotion and sale of fuel products in Singapore under the marks, they are well known here. The Applicant’s mark “MOBIS” is similar and is to be used for similar goods and would lead to a likelihood of confusion under section 8(2)(b). Alternatively, because “MOBIL” is an earlier well known mark, even if the goods or services of the Applicant’s Mark are not similar, it may nonetheless lead members of the public into thinking that there was connection between the Opponent and the Applicant’s goods and there is a likelihood of confusion and the interests of the Opponent are likely to be damaged under section 8(3). A case of passing off may also be made out under section 8(7).

The Opponent further contended that the Application mark is devoid of any distinctive character and the Application was made in bad faith and registration should be refused under sections 7(1) (b) and 7(6) respectively.

The Applicant contended that the mark “MOBIS” is derived from the combination of the words mobile and system and was first used in Korea in 2000. The Applicant has registrations and pending applications for the Mobis mark in 58 countries around the world. The Applicant’s “MOBIS” and the Opponent’s “MOBIL” mark co-exist in 13 countries. The Applicant’s goods in class 12 are different the Opponent’s in class 4 for fuels and lubricants and these are typically sold in fuel stations and that the Applicant’s goods are sold to distributors of car parts. The Applicant hence denied that their mark is not distinctive, that the application was made in bad faith and that there was any likelihood of confusion and passing off in relation to the use of their mark.

Held, allowing the application mark to proceed to registration

1. The mark “MOBIS” is an invented word and is proposed to be used on vehicle parts under class 12. It is inherently distinctive for vehicle parts and satisfies the requirement of distinctiveness under section 7(1)(b).
2. There was insufficient evidence to show that the Applicant had behaved in a manner which fell short of the standards of acceptable commercial behaviour and hence there is no basis for an inference of bad faith under section 7(6).
3. Considering the registration in class 4 for the mark “MOBIL” and the application mark “MOBIS” under section 8(2)(b), there is similarity between the two marks. Although there is no conceptual similarity as both marks are invented words and meaningless, there is aural similarity as the marks have identical first syllables and the second syllables sound similar. It is only the ending consonants of the second syllables that differentiate the marks. Despite a sibilant sound at the end of the mark, “MOBIS”, there is a risk of the ending consonant of both marks being slurred in speech in Singapore. Viewed as wholes, there is also visual similarity as a large part of the marks are similar. Both marks appear capitalized as “MOBIS” and “MOBIL” each with 5 letters. The first 4 letters are identical and only the last letter is different.
4. Vehicle parts sold under the “MOBIS” mark and fuels and lubricants sold under the “MOBIL” mark are not similar goods under section 8(2) although the users are the same and the channels of trade may overlap. This is because the uses are different and the physical nature of the goods is different.
5. There is no likelihood of confusion under section 8(2)(b) taking into account all the circumstances, in particular, the trading circumstances of the goods and the mechanism of purchase. The majority of the Applicants’ goods, being vehicle parts to be fitted into vehicles, require a certain degree of care in the purchase. There is a difference in the way a consumer buys a self serve item from a shop shelf in an off the cuff fashion and the way in which a consumer buys a vehicle part. The Applicants goods would be bought after a considered purchasing decision.
6. The fact that the Opponents’ mark is so distinctive and well known must also be taken into account. Because Mobil is so distinctive and well known, a consumer will be reminded of the Opponents’ Mobil mark when he sees the Applicant’s mark. However being reminded of an earlier mark in itself does not constitute confusion. And when a consumer is reminded of the Opponents’ mark, he will not have an imperfect recollection of the Opponents’ mark. He would be able to recollect the Opponents’ mark “MOBIL” for fuels and lubricants. The consumer would not think that the “MOBIS” vehicle part that he is considering purchasing is a product which is from the same source as the Opponents. He would not be confused and make the purchase thinking that the Applicants’ vehicle parts and the Opponents’ fuels and lubricants come from the same source.
7. On section 8(3) considerations, Mobil has been in Singapore long enough for it to acquire the status of a well known mark in Singapore. The use of the “MOBIS” mark with a red O, on vehicle parts is unlikely to lead a substantial number of average Singaporeans to make a connection between the Applicant’s vehicle parts and the Opponent. When choosing a vehicle part, a consumer must choose a part according to its compatibility with the vehicle and therefore it requires some consideration. The consumer may be reminded of the well known mark “MOBIL” but that is not sufficient to establish a connection between the vehicle part and the Opponent. To show a connection the consumer must think that the mark “MOBIS” is a new line of products sold by the owners of the mark “MOBIL”, which has hitherto been selling fuels and lubricants. The consumer will not make that connection. There is consequently also no likelihood of confusion. As the Applicant had not used the mark “MOBIS” in Singapore, it would not be possible for the Opponent to show that their interests are likely to be damaged by such use. The opposition under section 8(3) failed.
8. For section 8(7) considerations, the question is whether use of the “MOBIS” mark by the Applicant (with a red O) on vehicle parts would lead to the type of misrepresentation required by passing off law. There is no misrepresentation in this case for the same reasons that there would be no confusion under section 8(2) and that there would be no connection and confusion under section 8(3). The opposition under section 8(7) failed.

Provisions of Legislation discussed:

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.) Sections 7(1), 7(6), 8(2)(b), 8(3) and 8(7).

Cases referred to:

- Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281

- Rlichemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
- Pianotist Company Ld (1906) 23 RPC 774,
- Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp) [2007] 1 SLR 1082
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690
- In the Matter of London Lubricants (1920) Limited's Application to Register a Trade Mark (1925) 42 RPC 264
- Aristoc Ltd v Rysta Ltd (1945) 62 RPC 65
- Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
- Re Enliva [Takeda Chemical Industries v Solvay Duphar b.v. UKPTO Opp No O/115/00]
- Sabel BV v Puma AG Rudolf Dassler Sport [1998] RPC 199
- De Cordova & Ors v Vick Chemical Co [1951] RPC 103
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] RPC 341
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147; [1999] SGCA 39.
- Harrods Ltd v Harrodian School Ltd [1996] RPC 697.
- Gromax Plastics Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Rothmans of Pall Mall v Maycolson International Ltd [2006] 2 SLR 551
- Weir Warman Ltd v Research & Development Pte Ltd [2007] SGHC 59
- Flowstacka TM (1968) RPC 66
- Application by Brown Shoe Company Inc [1959] RPC 29
- Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 14
- Duckham & Co's TM Application [2004] RPC 557,
- Nestle SA's TM Application [2004] FSR 16
- Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc [1999] RPC 117
- Wagamama Ltd v City Centre Restaurants Plc [1995] FSR 713.
- McDonalds Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Mct Unilables Sa v Kathalos (1993) 27 IPR 176
- Jenoptik Jena GmbH v Nippon Kogaku KK (1985) IPD 8053
- Makers Application (1986) IPD 9002
- Chanel Ltd v Chantal Chemical & Pharmaceutical Corp (1990) 19 IPR 108
- Esprit v Union Knitting Mills Pty Ltd (1998) 44 IPR 404
- Hyundai Mobis v Exxonmobil Oil Corporation [2006] (UK IP Office)
- Capoco Design Limited v Exxonmobil Oil Corporation [2004] (UK IP Office)
- Multipart Distribution Limited v Bayerische Motoren Werke AG
- Nation Fittings (M) Sdn Bhd v Oystertec Plc & Anor [2005] SGHC 225
- 10 Royal Berkshire Polo Club TM [2001] RPC 32.
- McDermott Laboratories Ltd v May & Baker Ltd [2006] ETMR 17
- Bayer Aktiengesellschaft v Beecham Group P.L.C. [2002] SGIPOS 2
- Oracle Corp v Newcom Technologies Pty Ltd (2001) 49 IPR 647
- E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5
- General Motors Corporation v Yplon SA [1999] E.T.M.R. 122
- St Leonards Motors Limited v Daimler Benz AG (UK Patent Office)
- Paco/Paco Life in Colour TM [2002] RPC 451
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd (1998) 2 SLR 550
- AG Spalding & Bros v AW Gamage Ltd (1915) 32 RPC 273
- Alteco Chemical Pte Ltd v Chong Yean Wah t/a Yamayo Stationery Manufacturer [2000] 1 SLR 119
- Newsweek Inc v British Broadcasting Corporation (1979) RPC 441
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- Harrisons TM Application [2005] FSR 10
- Royal Enfield TM [2002] RPC 24
- Delight Express Limited v In-Comix Food Industries Sdn Bhd [2004] SGIPOS 14

Representation:

- Ms. Karol Goh, Mr. Ang Kai Hsiang & Mr. John Lim (Alban Tay Mahtani De Silva) for the Applicant.
- Ms. Elaine Tan, Ms Eunice Lim & Mr. Vignesh Vaerhn (Allen & Gledhill) for the Opponent.

NB: An appeal against this decision to the High Court is pending