

**In The Matter Of A Trade Mark Application No. T95/07674H By Superbowl Golf School
& Country Club Pte Ltd**

And

**Opposition Thereto by
National League Properties Inc.**

*Before Principal Assistant Registrar of Trade Marks, Mr Wong Sheng Kwai
22 August 2007*

Trade Marks – Opposition to registration – whether the opponents had a reputation – whether registration of the application mark would cause confusion or deception - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – whether the elements of the tort of passing off have been established - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – whether the Applicant could claim to be a bona fide proprietor of the mark - section 12 of the Trade Marks Act [Cap. 332, 1992 Ed]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the requirement of distinctiveness under Section 10 of the Trade Marks Act [Cap. 332, 1992 Ed]

The Applicant, SUPERBOWL GOLF SCHOOL & COUNTRY CLUB PTE LTD applied for registration of a mark on 17 August 1995, which comprised the words “SUPERBOWL GOLF SCHOOL”, for the services, “provision of golf lessons” in class 41.

The Opponent, NATIONAL FOOTBALL LEAGUE PROPERTIES INC., raised objections under sections 10, 12, 15, 23(2) of the Trade Marks Act (Cap 332, 1992 Revised Edition) [hereinafter referred to as “TMA”] and Article 6bis of the Paris Convention in their Amended Notice of Opposition. At the hearing, the Opponent proceeded on sections 10, 12 and 15 of the TMA, leaving out section 23(2) and reference to Article 6bis of the Paris Convention on the protection of well known marks.

As at 17 August 1995, the Opponent had applied for the registration in Singapore of the mark “SUPER BOWL” for various goods in classes 16 and 25. The Opponent also had registrations of “SUPER BOWL” marks in respect of goods and services in various classes in a number of countries. The Opponent had adopted and used their mark since 15 January 1967 when the first “SUPER BOWL” games were held in Los Angeles, California. Since then, the “SUPER BOWL” games are held without fail on an annual basis. Worldwide sales figures for the television rights to broadcast the “SUPER BOWL” games have been extensive. In Singapore, the “SUPER BOWL” games were broadcast on television from as early as 1984. As a result, the Opponent contended that there was a real likelihood that the public would be confused or deceived that there was a connection between the Opponent and Applicant if registration for a similar mark for the Applicant’s services in class 41 - “provision of golf lessons” is granted. The Applicant’s services bearing the mark might also be passed off as and for the goods and/or services of the Opponent.

The Opponent also contended that the Applicant could not claim to be the proprietor of the mark as the conception of the said mark was influenced by the Opponent’s internationally famous mark “SUPER BOWL” which had been used from 1967 and since 1984 in Singapore. By reason of the long use, reputation and goodwill of the Opponent in the “SUPER BOWL” mark, the Applicant’s mark would not be distinctive or capable of distinguishing the services of the Applicant.

The Applicant contended that the onus to prove reputation at the material time (i.e. the date of filing of the application mark - 17 August 1995) under section 15 of the TMA is on the Opponent and they have failed to discharge the same. The requirement is to establish use and reputation of the Opponent’s trade marks in Singapore. Consequently, there was no likelihood of confusion as the Opponent’s mark “SUPER BOWL” and the Applicant’s mark “SUPERBOWL GOLF SCHOOL” compared as wholes, are distinguishable phonetically and visually. The tangible goods of the Opponent bear no similarity to or association with the intangible services provided under the Applicant’s mark. As such, the allegation of passing off is also untenable.

The Applicant further contended that they did not copy of the Opponent’s mark. The Applicant’s mark was derived from the name of the Applicant, “SUPERBOWL GOLF & COUNTRY CLUB PTE LTD” which was in

turn derived from the name of the SUPERBOWL GROUP. The mark has been used in Singapore by the SUPERBOWL GROUP since 1987. Besides the words “GOLF SCHOOL” in the mark which is not distinctive and hence disclaimed in the context of the provision of golf lessons, the mark examined as a whole is distinctive as the word “SUPERBOWL” in the mark has no direct reference to the character and quality of the services claimed.

Held, allowing the application mark to proceed to registration

1. Although the Opponent sought to show the long use and extensive reputation of the mark “SUPER BOWL” around the world in respect of the American Football League and associated commercial activities, the pertinent issue is whether as at 17 August 1995, there had been use of the marks by the Opponent as trade marks in Singapore, in respect of what range of goods and/or services and the extent of reputation, if any, that the marks had acquired amongst the public here. The Opponent’s registrations of the “SUPER BOWL” marks around the world other than those in Singapore are not relevant as an inquiry under section 15 of the TMA seeks only to protect the public here from confusing or deceptive trade marks.
2. As at 17 August 1995, although the Opponent failed to discharge the burden of showing that the Opponent’s marks were used extensively, if at all, in Singapore, there was evidence that there was knowledge, cognizance or awareness among the public here of the mark “SUPER BOWL” as the name of the annual American Football League games broadcast around the world via television and other modes.
3. Comparing the marks in question, the inclusion of the words “GOLF SCHOOL” to the common denominator, “SUPER BOWL” did not sufficiently negate the possibility of an association in the minds of the buying public between the two proprietor’s marks because the words “GOLF SCHOOL” are descriptive of the services provided.
4. While there was some evidence to show the Opponent did provide training services for its domain sport as a logical extension, there was no indication that there was an industry practice of providing training services in an unrelated sport such as golf. There was also no evidence to show that the purchasing public here was aware of such a practice.
5. Assuming fair and normal use of the marks in question, the tangible goods of the Opponent, essentially stationary, paraphernalia and clothing, bore no similarity to or association with the intangible services provided under the Applicant’s mark, namely “the provision of golf lessons”. The trade channels do not overlap. It would be speculative that the Opponent may, one day, provide training lessons in a totally different sport like golf, using the same mark “SUPER BOWL” which had since 1967 been only associated with American football and related activities in that domain. Taking into account all the surrounding circumstances, there was no “real tangible danger” of confusion or deception under section 15 of the TMA.
6. Having found that the respective marks of the Opponent and the Applicant are not confusingly similar for the purposes of section 15, the objection on passing off also fails.
7. The Applicant conceived the “SUPERBOWL GOLF SCHOOL” which incorporated the mark that the earliest entity in the SUPERBOWL GROUP adopted in 1987. The derivation of the said mark at that time was for the bowling alleys they operated. It may not be the most imaginative or distinctive mark that could be used but the context provides a credible reason for its adoption. In the absence of evidence of compelling special facts and evidence in this case establishing mala fides, the onus of which is on the Opponent to show, no adverse inference against the Applicant being a bona fide proprietor of the mark is drawn.
8. For the purpose of the services applied for, with the disclaimer of the words, “GOLF SCHOOL”, the remaining word, “SUPERBOWL” has no direct reference to the character or quality of the services claimed as per Section 10(1) (d). The mark is registrable under Part A of the register.

Provisions of Legislation discussed:

- Trade Marks Act (Cap 332, 1992 Revised Edition) Sections 10, 12, and 15.

Cases referred to:

- Smith Hayden & Co’s Application [1946] RPC 97
- Re Wong Seng & Sons Bhd’s Application and Salamander AG’s Opposition [1993] AIPR 252
- Kellogg Co v Pacific Food Products Sdn Bhd [1992] 2 SLR 651
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- The Proctor & Gamble Company v Tohtonku (S) Pte Ltd [2002] SGIPOS 3
- The Polo/Lauren Co LP v Shop-in Department Store Pte Ltd [2006] 2 SLR 690
- Jellinek’s Application [1946] 63 RPC 59
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177

- Tong Guan Food Products Pte Ltd v Hoe Huat Hing Foodstuff Pte Ltd [1991] SLR 133
- Harrodian School [1996] RPC 697
- Vitamins Ltd's Application [1956] RPC 1
- Application by Brown Shoe Co Inc [1959] RPC 29
- Genette TM [1968] RPC
- Harrison's Trade Mark Application [2005] FSR 10] Royal Enfield TM, [2002] RPC 24 62

Representation:

- Dr Stanley Lai with Ms Moi Sok Ling (M/s Allen & Gledhill LLP) for the Applicant.
- Mr Max Ng with Ms Wong Yao Fang (M/s Gateway Law Corporation) instructed by Ms Kiran Dharsan (M/s Ella Cheong Spruson & Ferguson) for the Opponent.