

In The Matter of a Trade Mark Application No. T00/13620I By Kabushiki Kaisha Tokyo Seimitsu (Tokyo Seimitsu Co., Ltd)

And

**Opposition Thereto By
Tsukishima Kikai Co., Ltd**

***Before Principal Assistant Registrar of Trade Marks, Ms Anne Loo
28 August 2007***

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 with or similar to those for which the earlier trade mark is protected - Section 8(2)(b) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

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 (Cap. 332) 1999 Rev. Ed. [now 8(7)(a) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.]

The Applicants, Kabushiki Kaisha Tokyo Seimitsu (Tokyo Seimitsu Co., Ltd.) applied on 4 August 2000 for the registration of the trade mark "TSK & spindle device" in Class 9 in respect of the following goods: "Electric or magnetic measuring machines and instruments; measuring apparatus and instruments; automatic vending machines; optical apparatus and instruments; semi-conductor manufacturing apparatus and measuring apparatus and instruments for use in the semi-conductor industry in Class 9 only."

The Opponents, Tsukishima Kikai Co. Ltd filed an opposition based on their earlier registration for the mark "TSK TSUKISHIMA KIKAI" in various classes. The Opponents raised objections under sections 7(1), 7(6), 8(2) (b), 8(7) (a) [then 8(4) (a) before the 2004 amendments] and 55 of the Trade Marks Act (1998) (hereinafter referred to as "TMA") and Article 6bis of the Paris Convention. At the hearing, the matter proceeded only on the sections 8(2) (b) and 8(7) (a).

The Opponents contended that they are the leading Japanese plant engineering company in Japan and their marks consist of the letters "TSK" was derived from their corporate name Tsukishima Kikai. The Opponents have 9 registrations for the mark "TSK TSUKISHIMA KIKAI" in classes 1, 6, 7, 9, 11, 19, 20, 37 and 42 in Singapore and around the world. Worldwide sales of the products bearing the Opponents' marks amount to millions of yen every year. The Opponents' mark was first used in Singapore as early as December 1986 and the mark has also been widely publicised in various media.

The Applicants contended that their mark was derived from the first letter of their original 1949 name "Tokyo Seimitsu Kogu Co., Ltd." and first used on the Applicants' products in 1966 and in Singapore since 1987. The Applicants engage in the business of selling and manufacturing semiconductor manufacturing equipment and measuring instrument and are marketed worldwide. In 2000, the spindle device was incorporated with the letter mark "TSK" to form the Applicants' "TSK and spindle device" mark. The composite mark has been registered and used internationally. The Applicants' "TSK and spindle device" also co-exists with the Opponents' trade marks in Canada and the European Union. The Applicants' annual export sales figures from Singapore to various countries amount to millions of Singapore dollars.

Held, allowing the application mark to proceed to registration

1. It is clear that the visual impact of both the marks is different, for the Applicants' mark is a composite mark which comprises a device which they refer to as a "spindle device" and the letters TSK below the device. The presence of the device in the Applicants' mark makes them visually dissimilar.
2. The two marks are aurally similar. As the more distinct portion of the words or letters in the marks is "TSK", it is likely that both marks will be referred by the general public as "TSK".
3. Although the Opponents' mark is essentially a word mark and the Applicants' mark is a composite mark with a spindle device and the letters "TSK", the key and distinct feature in both marks is the letters "TSK". They are therefore conceptually similar.
4. Both the Opponents and the Applicants goods relate to machinery. However, on the evidence they do not appear to be engaged in a common field of activity. The products that the Opponents and the Applicants deal in do not move in the same trade channels and the parties are involved in different and specialised areas of technology. Therefore, although the goods that are in question relate generally to machinery used

for measurement and semiconductor manufacturing, they are not goods which in their respective specialised areas can be said to be similar goods.

5. Having considered all these factors and the evidence filed, and taking into account that the marks are aurally and conceptually similar, and that the goods are not similar, it is unlikely that confusion would occur. The goods of both parties are expensive, high-end (in the technological sense) products and because they each cater to a specialised sector, the consumers who buy these products can not be described as the “average consumer”. Consumers of expensive, specialised and technical machinery are likely to be well-informed, discerning and skilled professionals who would inspect their goods with greater due diligence before making the purchase.
6. The evidence adduced is not conclusive as to the Opponents having through use or sale of goods bearing their mark, attained goodwill and reputation in their “TSK Tsukishima Kikai” mark in Singapore as at 4 August 2000. As such, the Opponents have not satisfied the first element required to establish passing off that is, their goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature. As the Opponents are not able to prove on the face of the evidence filed that they have goodwill or reputation in their mark, there will not be a need to deal with the elements of misrepresentation and damage. The opposition under section 8(7) (a) therefore failed.

Provisions of Legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 8(2) (b) and 8(4) (a) [now 8(7)(a) of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.].

Cases referred to:

- In the Matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark [1906] 23 RPC 774
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijzen Handel BV [2000] FSR 77
- Re Wong Seng & Son Bhd’s Application and Salamander AG’s Opposition [1993] AIPR 252
- Automobiles Peugeot v Viva Time Corporation (2001) 54 IPR 568
- Beauty Shop Application v Opposition of Evora BV [1999] ETMR 20
- Trend Promoters (Malaysia) Sdn Bhd v Simmons Company
- Warnaco US Inc v Estee Lauder Cosmetics Ltd (2000) 50 IPR 143
- Associated Newspapers Ltd v Express Newspapers [2003] FSR 51,
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] 2 SLR 690
- Caterpiller Inc v Ong Eng Peng (formerly trading as Catplus International [2006] 2SLR 669
- De Cordova v Vick (1951) 68 RPC 103 at 106
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 WLR 491
- Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (t/a ONE.99 SHOP) [2000] 2 SLR 766
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng
- Foodstuff Pte Ltd [1991] SLR 133
- Taittinger SA v Allbev Ltd [1993] FSR 641
- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD TM [1998] RPC

Representation:

- Mr Lam Chung Nian and Ms Loraine Mutiah (Messrs Lee & Lee) for the Applicant
- Mr Max Ng of Messrs Gateway Law Corporation assisted by Wong Yao Fang, (instructed by Mr Kevin Wong of Ella Cheong Spruson & Ferguson) for the Opponents