

In The Matter Of Trade Mark Application Nos. T00/19887E & T00/19891C by Sunonwealth Electric Machine Industry Co. Ltd

And

**Opposition Thereto By
Siemens Aktiengesellschaft**

*Before Principal Assistant Registrar P Arul Selvamalar
31 October 2006*

Trade Mark Application – Opposition to registration – Whether Applicants’ mark is devoid of any distinctive character - section 7(1)(b) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Opposition to registration – Whether Applicants’ mark is descriptive of the characteristics of the goods - section 7(1)(c) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Opposition to registration – Whether Applicants’ mark has become customary - section 7(1)(d) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Opposition to registration – Whether the Applicants’ mark is deceptive - section 7(4)(b) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Opposition to registration – Whether the application was made in bad faith - section 7(6) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

On 15 November 2000, the Applicants, Sunonwealth Electric Machine Industry Co. Ltd, a Taiwanese company, applied to register a mark comprising the word “Maglev” in 2 classes for the goods, “motors for electric machines; motors for cooling fans and heat dissipators; all included in class 7”; and “ventilating fans as parts of central processing units, all included in class 9”. The Opponents, Siemens Aktiengesellschaft, a German company, filed oppositions to the applications on the grounds that the mark was devoid of any distinctive character under section 7(1)(b); that it was descriptive of the characteristics of the goods under section 7(1)(c); that the mark has become customary under section 7(1)(d); that the mark was deceptive under section 7(4)(b) and that the application was made in bad faith under section 7(6) of the Trade Marks Act 1998. The Applicants countered the oppositions by arguing in their Counter Statements that their mark had become distinctive of them, but they did not plead section 7(2), which is the proviso to section 7(1)(b), (c), and (d), in their Counter Statements. Both parties file evidence in the form of Statutory Declarations but the Applicants did not file Submissions or appear at the hearing to argue their case.

The Opponents filed evidence that the term maglev is a generic abbreviation derived from the two words, magnetic and levitation. The Opponents argued that it was descriptive when used in relation to the products that the Applicants intend to use them on, namely fans and motors, which use magnetic levitation technology. They argued that it is deceptive, if it is not used on products which employ magnetic levitation technology. They said that they had used magnetic levitation technology in railway projects in Germany and China for the Transrapid high speed train which floats off the tracks so that they may reach speeds of up to 500 km per hour. Other countries that have also used the technology for trains are, the US since 1998 and Japan since 1975. The Opponents state that magazine articles, online newspapers and research papers about the use of magnetic levitation technology, refer to the technology as “maglev”. There are also websites dedicated to magnetic levitation technology which refer to it as “maglev”. It is listed in the 1988 New Oxford Dictionary as a noun which means “a transport system in which trains glide above a track, supported by magnetic repulsion and propelled by a linear motion”, with its origin from the late 20th century from the words, magnetic levitation. The Opponents also stated that international conferences on maglev technology have been held since 1972. The Opponents also argued that the application was made in bad faith because the derivation of the mark was not made known to the Registrar examining the mark.

In the Applicants’ first Statutory Declaration, they exhibited product literature (Exh 1) which describes the MagLev Motor Fan as, “Year 1999 Q4, the ground breaking design - Sunon’s patented “Magnetic Levitation System” was firstly introduced..... The Magnetic Levitation System has now widely applied in Sunon’s product series. Year 2003 Magnetic Levitation System was abbreviated to “MagLev” as its brand name”. On another page,

the literature (Exh 1) states, “MagLev = Standard magnetic flux + Maglev Flux”. In Exhibit 5 of their first Statutory Declaration, the product is described as “Maglev Magnetic Levitation System Motor Fan”.

Held, disallowing registration of both application marks:

1. An internet search in dictionary.com for the meaning of the word maglev produced 5 hits, of which the Random House Unabridged Dictionary describes it as a noun, meaning:
 - i. the suspension of an object above or below a second object by means of a magnetic repulsion or attraction.
 - ii. Railroads. the suspension of a vehicle above or below a suitable guide rail by such means, often with the vehicle being propelled by a linear induction motor.All 5 hits describe the word maglev as a noun meaning magnetic levitation. Therefore it is clear that the word maglev means magnetic levitation. Magnetic levitation refers to the type of technology described in paragraph 1(i).
2. Whether the word maglev is distinctive will depend on the question of whether it is capable of performing the function of distinguishing the goods, without first educating the public that it is a brand name. Although the Applicants do not explicitly state in their product literature that they make cooling fans and motors which employ magnetic levitation technology, it does state that they employ two types of magnetic flux in their fans and motors. One is the standard magnetic flux and the other the Maglev flux. Therefore the Applicants’ fans and motors do employ the type of technology that the term maglev refers to, namely, magnetic levitation. When their fans and motors are referred to as Maglev fans or Maglev motors, it will raise the question in the consumer’s mind as to whether the term maglev refers to the type of technology employed by the fans and motors or whether it is a brand name. What the Applicants’ product brochure (Exh 1) attempts to do is this: it tries to educate the public that it is a brand name, because it is not capable of distinguishing the Applicants’ fans and motors, without the public first being educated that it is a brand name. Therefore the mark is not distinctive under section 7(1)b of the Trade Marks Act 1998. The opposition under this section succeeds.
3. The question of whether the mark is descriptive of the characteristics of the goods is determined by asking 2 questions: whether the mark describes the characteristics of the goods and whether another trader would like to use the term maglev to describe his fans or motors. The answer to both questions is yes, if the goods employ maglev technology. In the equation in the product literature (Exh 1) which states “MagLev = Standard magnetic flux + Maglev flux” the first part of the equation seeks to use the term MagLev as a brand name but the second part of the equation, which refers to the type of magnetic flux used, states “Maglev flux” referring to magnetic levitation or maglev technology. Therefore it is clear that the Applicants’ goods employ maglev technology. Other traders would desire to use the term maglev to describe their products that employ that technology. Therefore the opposition under section 7(1) c succeeds.
4. Whether the mark has become customary in the common language or in the established practises of the trade is the next issue to be decided. The term maglev is found in the dictionary as a noun referring to a type of technology, namely magnetic levitation technology. The literature filed by the Opponents relating to the use of the magnetic levitation technology in various products, refers to maglev products as products employing maglev technology. Therefore the word maglev has become customary in the current language and in the established practises of the trade as designating the type of products which use that technology. The opposition under section 7(1)d succeeds.
5. The Registrar will not consider whether the Applicants satisfy the proviso to section 7(1)(b), (c) and (d), namely section 7(2), as it was not pleaded in their Counter Statements.
6. Whether the mark maglev is deceptive depends on whether it is used on products which do not employ magnetic levitation technology. However it is clear from the Applicants’ product literature that the fans and motors that they produce do employ maglev technology. Therefore the mark is not deceptive and the opposition under section 7(4)b fails.
7. The omission to inform the Registrar examining the mark, that the mark is derived from the words magnetic and levitation is in itself insufficient evidence to infer that the Applicants acted in bad faith. The opposition under section 7(6) therefore fails.

Provisions of Legislation discussed:

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.), Sections 7(1)(b), 7(1)(c), 7(1)(d), 7(4)(b) and 7(6).

Cases referred to:

- Merz v Krell GmbH & Co (Case C-517/99 ECJ)
- Piromalli's TM; An application for cancellation by Greci Industria Alimentaire SpA (Case 133C 000372920/1, unreported)
- Reddaway v Banham [1896] AC 199 / 13 RPC 218
- Gillette Company's TM; An Application for a Declaration of Invalidity by Warner-Lambert & Company (Case 000703579 [2002] ETMR 733)
- Alcon Inc v OHIM (Case T-237/01, 5 March 2003, unreported)
- British Sugar v James Robertson & Sons [1996] RPC 281
- The Canadian Shredded Wheat Co Ltd v Kellogg Co of Great Britain Ltd (1940) 57 RPC 137
- Societe Des Produits Nestle S A v International Nutrition Co Ltd A/S [2005] SGIPOS 20
- Uni-Charm Corporation v The Proctor & Gamble Company [2003] SGIPOS 12
- Re An Application for a mark "Makes Life Better" by Aki Habara Electric Corporation Pte Ltd [2004] SGIPOS 13
- Safari TM [2002] RPC 23
- Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Case C-363/99)
- Taurus-Film GmbH & Co v OHIM (Case T-136/99)
- OHIM v Wm Wrigley Jr Company (Case C-191/01P)
- Mitsubishi HiTec Paper Bielfeld GmbH v OHIM (Case T-331/99)
- Trend Promoters (Malaysia) Sdn Bhd v Simmons Company [2005] SGIPOS 8
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Yomeishu Seizo Co Ltd & Anor v Sinma Medical Products (S) Pte Ltd [1991] SLR 499
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] SGHC 51
- Nation Fittings v Oystertec [2005] SGHC 225

Representation:

- Mr Sukumar Karupiah & Mr Adrian Kwong (Ravindran Associates) for the Opponents
- Applicants were absent