

**In The Matter Of Trade Mark Registration No. T00/19888C In The Name Of Sunonwealth Electric
Machine Industry Co. Ltd**

And

**An Application for
Invalidation Thereto by
Siemens Aktiengesellschaft**

*Before Principal Assistant Registrar P Arul Selvamalar
14 November 2006*

Trade Mark Application – Application for Invalidation – Whether Respondents’ mark is devoid of any distinctive character - section 7(1)(b) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Application for Invalidation – Whether Respondents’ mark is descriptive of the characteristics of the goods - section 7(1)(c) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Application for Invalidation – Whether Respondents’ mark has become customary - section 7(1)(d) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Application for Invalidation – Whether the Respondents’ mark is deceptive - section 7(4)(b) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Trade Mark Application – Application for Invalidation – Whether the application was made in bad faith - section 7(6) read with section 23(1) of the Trade Marks Act (Cap. 332, 2006 Rev. Ed.)

Sunonwealth Electric Machine Industry Co. Ltd (the Respondents), a Taiwanese company, are the owners of a trade mark T00/19888C comprising the word “Maglev” in class 11 for the goods, “Ventilating fans for commercial equipment, for commercial or industrial use”, which was registered with effect from 15 November 2000. Siemens Aktiengesellschaft (the Applicants), a German company, applied for the mark to be invalidated 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); all read with section 23(1) of the Trade Marks Act 1998. They also argued that there was fraud in the registration or that the registration was obtained by misrepresentation under section 23(4) of the Act. The Respondents countered the application for invalidation by arguing in their Statement of Grounds that their mark had become distinctive of them, but they did not plead section 23(2) in that Statement. Both parties filed evidence in the form of Statutory Declarations but the Respondents did not file Submissions or appear at the hearing to argue their case.

The Applicants filed evidence that the term Maglev is a generic abbreviation derived from the two words, magnetic and levitation. The Applicants argued that it was descriptive when used in relation to the ventilating fans that the Respondents produce, as the fans employ magnetic levitation technology. They argued that it is deceptive if it is not used on ventilating fans which employ magnetic levitation technology. The Applicants 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 are the US since 1998 and Japan since 1975. The Applicants 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”. The term Maglev 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 Applicants also stated that international conferences on maglev technology have been held since 1972. The Applicants submitted that the application was made in bad faith because the derivation of the mark was not made known to the Registrar examining the mark. The Applicants also argued that there was fraud in the registration as an omission to inform the Registrar was as culpable as a fraudulent act. Alternatively they argued that there was misrepresentation, if the Respondents filed the application for the mark stating that the mark was invented.

In the Respondents' 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, allowing the application for Invalidation:

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 Respondents do not explicitly state in their product literature that they make ventilating fans which employ magnetic levitation technology, it does state that they employ two types of magnetic flux in their fans. One is the standard magnetic flux and the other the Maglev flux. Therefore the Respondents' fans do employ the type of technology that the term maglev refers to, namely, magnetic levitation. When their fans are referred to as Maglev fans, 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 or whether it is a brand name. This is what the Respondents' product brochure (Exh 1) attempts to do: it tries to educate the public that it is a brand name; because it is not capable of distinguishing the Respondents' fans, 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 invalidation under section 23(1) read with section 7(1)b 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. 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 Respondents' goods employ maglev technology. Other traders would desire to use the term maglev to describe their products that employ that technology. Therefore the invalidation under section 7(1) c read with section 23(1) 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 Applicants relating to the use of 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 invalidation under section 7(1)d read with section 23(1) succeeds.
5. The Registrar will not consider whether the Respondents satisfy the requirements of section 23(2), as it was not pleaded in their Statement of Grounds.
6. Whether the mark maglev is deceptive depends on whether it is used on products which to not employ magnetic levitation technology. However it is clear from the Respondents' product literature that the fans that they produce do employ maglev technology. Therefore the mark is not deceptive and the invalidation action under section 7(4)b read with section 23(1) 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 Respondents acted in bad faith. The invalidation under section 7(6) read with section 23(1) therefore fails.
8. As the invalidation is successful under the various sections mentioned above, the Registrar makes no finding on the ground under section 23(4) of the Act.

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), 7(6), 23(1), 23(2) and 23(4).

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 Britian Ltd (1940) 57 RPC 137
- Societe Des Produits Nestle S A v International Nutrition Co Ltd A/S [2005] SGIPOS 20
- Nation Fittings v Oystertec [2005] SGHC 225
- 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
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd & Anor [2000] 3 SLR 145
- 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
- National Diaries Ltd v Xie Chun Trading Pte Ltd [1998] 1 SLR 620

Representation:

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