

**IN THE MATTER OF REGISTERED TRADE MARKS T03/07469G AND T04/05913F
IN THE NAME OF PENSONIC CORPORATION SDN BHD
[Respondents]**

AND

**APPLICATIONS FOR INVALIDATION THEREOF BY
MATSUSHITA ELECTRIC INDUSTRIAL CO. LTD
[Applicants]**

*Before Principal Assistant Registrar P Arul Selvamalar
27 March 2008*

Trade Marks – Applications for invalidation – Likelihood of confusion - whether the registered marks are similar to earlier trade marks and are to be registered for goods or services identical with or similar to those for which the earlier trade marks are protected - Section 8(2)(b) read with section 23 of the Trade Marks Act [Cap. 332] 1999 Rev. Ed.

Trade Marks – Applications for invalidation – whether the applications to register were made in bad faith – Section 7(6) read with section 23 of the Trade Marks Act [Cap. 332] 1999 Rev. Ed.

Trade Marks – Applications for invalidation – Distinctiveness – whether the registered marks satisfy the definition of a trade mark under section 2(1) and the requirements under Section 7(1) read with section 23 of the Trade Marks Act [Cap. 332] 1999 Rev. Ed.

On 5 August 2005 the Applicants applied for declarations of invalidity of 2 registered trade marks in the name of the Respondents, T03/07469G in class 11 and T04/05913F in class 7, which comprised the word Pensonic and a device of a letter P. These marks had been registered since 19 May 2003 and 14 April 2004 respectively. The Applicants own registrations for the mark Panasonic in class 7 (T71/52492I, T95/00558A, T00/22115Z and T04/08865I) and class 11 (T85/03800B, T95/00562Z, T00/22119B and T02/08869A). Their applications for invalidation were based on 4 grounds, that (i) there exists a likelihood of confusion on the part of the public because the registered marks are confusingly similar to their marks under Section 8(2)(b), (ii) that the registered marks are objectionable under Section 7(5) and the law of passing off under Section 8(7)(a), (iii) that applications for the registered marks were made in bad faith and were contrary to Section 7(6) and (iv) that the registered marks were not distinctive under Section 7(1)(a); all read with Section 23.

The Applicants used the Panasonic mark since 1988 in Japan and this use extended to South East Asia and China since 1991. The Panasonic brand products were sold in Singapore since 1990. The Applicants also own registrations for the Panasonic mark around the world. In Singapore they own registrations or applications in 26 classes and their earliest registration in class 9 is dated 1968. In Malaysia their mark has been registered since 1971.

The Respondents are one of Malaysia's largest manufacturers and distributors of home appliances and their products are marketed in over 800 outlets in Malaysia. They claim that PENSONIC was derived from the words "Penang" (which is their Group Executive Chairman's hometown and where their business commenced) and "sonic" which means sound, as they were initially in the audio business. Their mark means "sound of Penang". The device of the letter "P" was also chosen to represent Penang. The Respondents claim that they had not heard or seen the Applicants' mark when they devised the mark. PENSONIC was registered in Malaysia in 1984. Their Pensonic mark co-exists with the Applicants' mark in Australia, Japan, Hong Kong, Malaysia, Sri Lanka, Vietnam, China, Laos, Myanmar, Kuwait and Lebanon, 11 out of the 16 countries where the Respondents have registrations. The Respondents started selling their products in Singapore in 1984 but later decided to focus on larger markets like Hong Kong and Thailand. They are now interested in entering the Singapore market again.

Held, granting the applications for invalidation:

1. The marks are aurally and conceptually similar. The goods are also similar. When considering the likelihood of confusion, the test is not whether the consumer who is presented with both Panasonic and Pensonic products side by side is going to be confused. The test is whether a person who has seen a Panasonic product is going to select a Pensonic product thinking that it is a Panasonic product. Here, the ending of the marks, the word "sonic", is common and the beginning of the marks sound similar, as the

beginnings will be pronounced as “pen/pan”. The additional vowel “a” in the Applicants’ mark is one distinction between the marks but it is likely to be slurred. The device of the letter P is not dominant enough to distinguish the marks. There is a likelihood that a substantial number of average Singaporeans would be confused. The applications for invalidation therefore succeed under Section 8(2)(b) read with Section 23.

2. No finding was made under Section 8(7)(a) read with section 23.
3. Omission to investigate the Malaysian register of trade marks when the Respondents created their own brand cannot by itself lead to an inference of bad faith. The Applicants did not start using the Panasonic mark in the South East Asian region until the 1990’s and the Respondents created the mark in the 1980’s. There is insufficient evidence to make an inference that the applications for the registered trade marks had been made in bad faith. The applications for invalidation on the grounds of Section 7(6) read with Section 23 therefore fail.
4. The registered trade marks are inherently capable of distinguishing the Respondents’ goods and satisfy the definition of a trade mark under Section 2(1). The applications for invalidation under Section 7(1)(a) read with Section 23 fail.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 2(1), 7(1), 7(6) and 8(2)(b) read with Section 23.

Cases referred to:

- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816, [2006] 2 SLR 690
- British Sugar Plc v James Robertson Sons [1996] RPC 281
- Pianotist Co’s Application (1906) RPC 774
- Kellogg Co. v Pacific Food Product Sdn [1999] 2 SLR 651
- Application by William Bailey (Birmingham) Ltd and Opposition by A C Gilbert Co [1935] 52 RPC 136
- Caterpillar Inc v Ong Eng Peng [2006] 2 SLR 669
- Application by TKR Electronics Pte Ltd and Opposition by Matsushita Electric Co Ltd
- Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd [2000] 4 SLR 360
- Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Unicharm Corp) [2007] 1 SLR 1082
- Trend Promoters (M) Sdn Bhd v Simmons Company [2005] SGIPOS
- McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuffs Pte Ltd [1991] SLR 3
- Amanresorts Limited & Anor v Novelty Pte Ltd [2007] SGHC 201
- Sabel BV v Puma AG [1998] RPC 199
- Stichting Lodestar v Austin Nicols & Co Inc [2006] SGIPOS 11
- Lloyd Shuhfabric Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- Itochu Corporation v Worldwide Brands Inc [2007] SGIPOS 9 and
- Premier Brands UK Limited v Typhoon Europe Ltd [2000] ETMR 1071
- Mitsubishi Jodosha Kabushiki Kaisha v Iveco SpA [2007] SGIPOS 10
- Lancer TM [1987] RPC 303
- Frigiking TM [1973] RPC 739
- Pret a Manger (Europe) Limited v Ezaki Glico Kabushiki Kaisha [2006] SGIPOS 13
- Super Coffeemix Manufacturing Limited v Unico Trading Pte Ltd [2003] 3 SLR 145
- Application by Robert Morrison and Opposition by William Levene Ltd [UK IP Office]
- Polo Lauren v US Polo Association [2002] 1 SLR 326
- Solavoid TM [1977] RPC 1
- Clause Ruiz-Picasso v OHIM Case T-185/02 [2005] ETMR 22
- Hyundai Mobis v Mobil Petroleum Company Inc [2007] SGIPOS 12.
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Kabushiki Kaisha World v Wolverine World Wide Inc [2007] SGIPOS 2
- Reckitt & Coleman Products Ltd v Borden Inc & Ors [1990] 1 All ER
- Bulmer v Bollinger [1978] RPC 79
- Harrods v Harrodian School [1996] RPC 697
- Hyundai Mobis v Mobil Petroleum Company Inc [2007] SGIPOS 12
- CDL Hotels International Limited v Pontiac Marina Pte Ltd [1998] 2 SLR 550
- 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] 2 SLR 551

Representation

- Mr Sukumar Karuppiah and Ms Vicki Heng (Ravindran Associates) for the Applicants
- Ms Celine Teo (Citilegal LLC) for the Respondents