

**IN THE MATTER OF A TRADE MARK APPLICATION T05/03804C BY
PENSONIC CORPORATION SDN BHD**

AND

**OPPOSITION THERETO BY
MATSUSHITA ELECTRIC INDUSTRIAL CO. LTD**

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

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 whole or essential part of the Application Mark is identical or similar to an earlier trade mark which is well known in Singapore – whether use of the Application Mark on goods or services would indicate a connection between them and the proprietor of the earlier trade mark - whether the interests of the proprietor of the earlier trade mark are likely to be damaged - Section 8(4)(a)(b)(i) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the application to register is made in bad faith – Section 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the definition of a trade mark under section 2(1) and the requirements under Section 7(1) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

On 23 March 2005, the Applicants filed a trade mark application (T05/03804C) for a composite mark comprising the word PENSONIC and a device of the letter “P” in respect of electronic goods in Class 9 (“the Application Mark”). The Opponents, who own registrations in Class 9 for the mark “Panasonic” (T68/45252A, T95/00560C, T00/22117F and T04/08867E), opposed the application on five grounds. The Opponents contended that (i) there exists a likelihood of confusion on the part of the public because the Application Mark is confusingly similar to their marks under Section 8(2)(b); (ii) that their marks are well known marks in Singapore and registration of the Application Mark would be contrary to Section 8(4)(a)(b)(i), 8(4)(a)(b)(ii)(A) and 8(4)(a)(b)(ii)(B); (iii) that the Application Mark was objectionable under Section 7(5) and the law of passing off under Section 8(7)(a); (iv) that the application was made in bad faith and contrary to Section 7(6); and (v) that the Application mark was not distinctive under Section 7(1)(a).

The Opponents used the Panasonic mark since 1988 in Japan and this use extended to South East Asia and China since 1991. The Opponents 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 Panasonic brand products were sold in Singapore since 1990. The Opponents have more than 100 authorised dealers selling their products. Between 1995 and 2001, sales of Panasonic brand products were not less than S\$100m annually. In the years 2002, 2003 and 2004, when the Opponents’ National brand was phased out and replaced by their Panasonic brand, their sales increased to S\$150m, S\$400m and S\$480m respectively. Between 2000 and 2004, S\$50m was spent on advertising and promotion (A & P) in Singapore. Globally their sales were S\$90b to S\$106b between 1995 to 2005. Their A & P expenditure globally was between S\$1b to S\$1.1b between 2000 and 2005. A Brand Finance survey (Jan 2007) shows that Panasonic is ranked number 123 among the top 250 brands in the world and the World Trade Marks Review (May/June 2007) shows that Panasonic is number 9 out of the top 10 Japanese brands. The Opponents group of companies in Singapore employs more than 6,500 employees and they spend millions on research and development.

The Applicants 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 Applicants claim that they had not heard or seen the Opponents’ mark when they devised the mark. PENSONIC was registered in Malaysia in 1984. Their Pensonic

mark co-exists with the Opponents' mark in Australia, Japan, Hong Kong, Malaysia, Sri Lanka, Vietnam, China, Laos, Myanmar, Kuwait and Lebanon, 11 out of the 16 countries where the Applicants have registrations. The Applicants 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, disallowing registration:

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 Opponents 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 opposition therefore succeeds under Section 8(2)(b).
2. The essential part of the Application Mark is the word PENSONIC, which is similar to the Opponents' mark. From 2002 to 2004, the Opponents' sales under their Panasonic brand were S\$400 to S\$480 million. The value of the Panasonic brand according to the 2007 report by Brand Finance is US\$6.196 billion. It ranked number 123 out of the 250 top brands and in the electronics sector, it ranked number 6. Of the top 10 Japanese brands it ranked number 9. "Panasonic" is therefore a well known mark in Singapore. A consumer would think that a Pensonic product was somehow connected or related to the owner of the Panasonic mark, and the interests of the Opponents are likely to be damaged. The opposition therefore succeeds under Section 8(4)(a)(b)(i).
3. No finding was made under Section 8(4)(a)(b)(ii)(A) or (B) nor Section 8(7)(a).
4. Omission to investigate the Malaysian register of trade marks when the Applicants created their own brand cannot by itself lead to an inference of bad faith. The Opponents did not start using the Panasonic mark in the South East Asian region until the 1990's and the Applicants created the mark in the 1980's. There is insufficient evidence to make an inference that the application was made in bad faith. The opposition on the grounds of Section 7(6) therefore fails.
5. The Application Mark is inherently capable of distinguishing the Applicants' goods and satisfies the definition of a trade mark under Section 2(1). The opposition under Section 7(1)(a) fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 2(1), 7(1), 7(6), 8(2)(b) and 8(4)(a)(b)(i).

Cases referred to:

- Trend Promoters (M) Sdn Bhd v Simmons Company [2005] SGIPOS
- 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
- 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
- E! Entertainment Television Inc v Deutsche Telekom AG [2005] SGIPOS 5
- 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
- Bulmer v Bollinger [1978] RPC 79
- Harrods Ltd v Harroddian School Limited [1996] RPC 697
- Intel Corporation Inc v CPM UK Ltd [2006] All ER 399
- Mastercard International v Hitachi Credit [2005] ETMR 10
- Quorn Hunts Application v Opposition of Marlow Foods Ltd [2005] ETMR
- Application by R Delamore Limited O-097-04 (UK IP Office)
- Adidas-Salomon AG & Anor v Fitness World Trading Ltd [2004] Ch 130
- Mobil v Mobilicity (Application by Capaco Design Limited O-367-04, UK IP Office)
- 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
- 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

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