

**IN THE HEARINGS AND MEDIATION DIVISION OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T0813228H & T0813229F  
2 November 2010

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**HEBEI AULION HEAVY INDUSTRIES CO., LTD**

**AND**

**OPPOSITION THERETO BY**

**VOLVO TRADE MARK HOLDINGS AB**


Hearing Officer: Ms Lee Li Choon  
Principal Assistant Registrar of Trade Marks

Mr Victor Yip (Teh Yip Wong & Tan) for the Applicants

Ms Tasneem Haq (HSLegal LLC) for the Opponents

*Cur Adv Vult*

**GROUND OF DECISION**

1 Hebei Aulion Heavy Industries Co., Ltd (“the Applicants”), applied to protect the trade mark,  in Singapore on 24 April 2008 in Class 7 in respect of “Harvesters; agricultural machines; road rollers; excavators; loaders; bulldozers; concrete mixers (machines); cranes; grain threshing machines; rice transplanters; lawnmowers;

power shovels; diesel engines; gasoline engines; vehicle oil pumps; shock absorbers; vehicle washing installations; bicycle dynamos; hydraulic presses; plastic jet moulding machines; waggon lifts; woodworking machines; papermaking machines; washing machines; dynamos; wind power electricity generators; alternators; emergency power generators; electricity generators; engines not for land vehicles; dynamo belts; driving motors other than for land vehicles; kick starters for motorcycles" (T0813228H designated through International Registration No.975260) and in Class 12 in respect of "Automobiles; vehicles for transport for agricultural use; motorcycles; lifting cars; cycle cars; bicycles; electric vehicles; engines for land vehicles; fork lift trucks; concrete mixing trucks; tractors; trucks; cars; cleaning trolleys; tires for vehicle wheels; aeroplanes; boats; goods handling carts; funiculars; railway vehicles". The Applicants also applied for the trade mark, **LOVOL** on the same date in respect of the same goods in Class 7 and Class 12 (T0813229F designated through International Registration No.975262). Together, these trade marks will be referred to as "the Application Marks".

2 The applications were accepted and published on 17 October 2008 and 31 October 2008 respectively for opposition purposes. Volvo Trade Mark Holding AB ("the Opponents"), filed their Notice of Opposition to oppose the registration of the Application Marks on 16 December 2008. The Applicants filed their Counter-Statement on 6 April 2009.

3 The Opponents filed evidence in support of the opposition on 30 July 2009. The Applicants filed evidence in support of the application on 24 September 2009. The Opponents filed their evidence in reply on 19 March 2010. The Pre-Hearing Review was held on 3 May 2010. Pursuant to the Pre-Hearing Review, certain translations were filed on 23 July 2010, after which the opposition was heard on 2 November 2010.

### **Grounds of Opposition**

4 The Opponents rely on Section 8(2)(b), Section 8(4)(a) and (b)(i), Section 8(4)(b)(ii)(A), Section 8(4)(b)(ii)(B) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this opposition.

### **Opponents' Evidence**

5 The Opponents' evidence comprises a Statutory Declaration affirmed by Ms Monica Dempe, Managing Director of the Opponents on 21 July 2009 and filed on 30 July 2009, as well as a Statutory Declaration in Reply affirmed by the same Ms Monica Dempe on 3 March 2010 and filed on 19 March 2010.

### **Applicants' Evidence**

6 The Applicants' evidence comprises a Statutory Declaration affirmed by Li XiaoGao, Deputy Chief Brand Officer of the Applicants on 10 September 2009 and filed on 24 September 2009.

### **Applicable Law and Burden of Proof**

7 The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed)("the Act"). Under the Act, there is no overall onus on the Applicants either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

### **Background**

8 The Opponents are a corporation which owns the "VOLVO" trademark throughout the world and licenses this trademark to Aktiebolaget Volvo (ABV) and Volvo Car Corporation (VCC) for use in connection with their businesses. ABV and VCC each own fifty percent of the Opponents. ABV owns and controls shares in various corporations and companies ("the Volvo Group"). VCC owns and controls shares in various corporations and companies ("the Volvo Car Companies"). The Volvo Group and the Volvo Car Companies are collectively referred to as "the Volvo TM Companies". The Volvo Group manufactures trucks, buses and construction equipment, drive systems for marine and industrial applications, aerospace components and renders services related to these goods and engines and power systems for land, marine and air transportation. The Volvo Group today has approximately 82,000 employees, 18 production locations and operates in about 185 countries worldwide. The Volvo Group's truck operations first started in 1928 and it has now become the world's second largest producer of heavy trucks. The Volvo Group's product offering includes complete buses and chassis for city traffic, commuter traffic, line haul and tour and charter. The Volvo Group also develops, manufactures and markets different types of construction equipment such as articulated haulers, wheel loaders, excavators, compact excavators, compact loaders, motor graders and backhoe loaders. One company in the Volvo Group also supplies engines and power systems for marine use for both leisure craft and workboats, and industrial engines for irrigation pumps, generating sets and other applications. In addition, one company in the Volvo Group specialises in a number of highly advanced engine components for aircraft and space rockets and has a large aftermarket business which includes engine overhaul and sales of spare parts.

9 The VCC manufacture and distribute passenger cars throughout the world, with the mission to create the safest, most exciting car experience for modern families. The VCC has approximately 27,000 employees, with production locations in 6 countries and operations in over 100 countries worldwide.

10 The Opponents own numerous registrations for the "VOLVO" trade mark as a word mark and "VOLVO" as a word mark combined in different forms of stylisation and devices and the registrations are in respect of a variety of goods and services worldwide. The registrations are in countries such as France, Germany, Austria, Denmark, Italy,

Norway, China, South Korea, Singapore, Thailand and the USA, just to name a few. In Singapore, there are two registrations for "VOLVO", one each in Class 7 and 12. The Class 7 registration dated back to 1975 (T7565774E) and the Class 12 registration dated



back to 1962 (T6229924A). The Opponents also own registrations for " " in



Class 12 filed in 1962 (T6229925Z) and for " " in Classes 7 and 12 and services in Class 37 filed in 2006 (T0722398J).

11 The trademark, "VOLVO" was adopted by the Opponents' predecessor on 5 May 1915. The first "VOLVO" branded car was manufactured in 1927 and the first "VOLVO" branded truck was manufactured in 1928. The sales figures worldwide of the Volvo Group ranges from 116,936,000,000 in 2001 to 192,106,000,000 in 2008 in Swedish Kroner. The number of cars sold by VCC worldwide ranges from 409,059 in 2000 to 374,297 in 2008. Suffice to say that the sales figures and number of cars sold are impressive. In terms of promotion by the Volvo Group, the advertising expenditure has been rather consistent over the years, ranging around 1,677,000,000 in Swedish Kroner. As for the VCC, the "VOLVO" mark has been advertised worldwide with expenditure ranging from 593,000,000 in 1997 to 754,000,000 in 2008 in US Dollars.

12 The Opponents have successfully enforced their trademark rights against applications for "LOVOL" in Classes 7 and 12 in Saudi Arabia, in Class 7 in the UAE and Jordan. The Opponents have conducted a survey of companies dealing in high-tonnage trucks and parts thereof in the cities of Lima and Arequipa. That survey showed that 98% of those surveyed put "VOLVO" in the first place as the brand of high tonnage trucks they know. The survey also showed that amongst the companies that had recently acquired high tonnage trucks, 80% of them bought "VOLVO" trucks. The survey further showed that 85% of the companies surveyed affirm that the brand of trucks they would buy are the "VOLVO" trucks. The survey concluded that in Peru, "VOLVO" is synonymous with high tonnage trucks.

13 The Opponents also lodged materials to show proactive and consistent efforts to sustain brand recognition and market presence of the "VOLVO" brand in the motor vehicle industry worldwide through advertisements and publications.

14 In Singapore, the "VOLVO" trade mark has had significant market presence in respect of its use on a variety of construction equipment such as articulated haulers, wheel loaders, excavators, compact excavators, compact loaders, motor graders and backbone loaders, amongst others. The Volvo Group is represented in the region for the construction equipment industry by Volvo East Asia (Pte) Ltd. The "VOLVO" trade mark was first put to use in Singapore for construction equipment in 1979. The sales figures of the "VOLVO" trade mark in Singapore and Southeast Asia for construction

equipment, machines, implements and tools are USD 956,000 in 2006, USD 5,485,000 in 2007 and USD 5,838,000 in 2008. The amount spent on advertising and promoting the "VOLVO" trade mark in Singapore in respect of construction equipment, machines, implements and tools range from USD5,000 in 2003 to USD15,000 in 2005 to USD115,000 in 2006 to USD500,000 to date. In Southeast Asia, the amount spent on advertising and promoting the "VOLVO" trade mark in respect of construction equipment, machines, implements and tools range from USD1,500,000 in 2001 to USD5,090,000 in 2008. The Opponents also lodged copies of advertisements placed in "Southeast Asia Construction" Magazine, a leading magazine catering to the building and construction industry which is available in Singapore as well as brochures and advertisements placed in various places such as the Yellow Pages, the Commercial and Industrial Guide 2007/2008 and other magazines relevant to the industry.

15 In respect of engines and power systems for marine use for both leisure craft and workboats, the sales in Singapore for "VOLVO PENTA" goods range from amounts of S\$23,937,000 in 1998 to S\$26,193,870 in 2008. The amounts spent to promote the "VOLVO PENTA" brand in Southeast Asia, including Singapore, range from S\$210,224 to S\$133,651. In respect of trucks, Malayan Motors is the official distributor of Volvo trucks in Singapore which is involved in the retail and distribution of Volvo trucks, parts and fittings and they also provide services for the repair and maintenance of the trucks. Volvo trucks are used in respect of construction, agriculture, and transporting cargo such as timber and waste materials. The VOLVO trade mark was first used for trucks in Singapore on 17<sup>th</sup> August 1989. Whilst the amount of new truck sales for "VOLVO" trucks in Singapore is not available in 2007 and 2008, the amount of sales range from 1 unit in 2006 to the highest of 55 units in 2002. The amount in spare parts for "VOLVO" trucks in Singapore ranges from the lowest of S\$738,913 in 2007 to the highest of S\$14.7million in 2000.

16 As for "VOLVO" cars, they have been distributed and sold in Singapore for several decades, through SM Motors Pte Ltd. The latter has been promoting and selling "VOLVO" cars since 1978. The units sold range from 212 in 1997 to 1396 in 2000 and 1140 in 2005. The Opponents lodged as evidence a copy of an independent market survey conducted in September 2005 in Singapore concerning "VOLVO" cars and how the Singaporean public perceives it. However, the survey does not contain any relevant information as to how well known the "VOLVO" cars are in Singapore.


17 As for "VOLVO" buses, the "VOLVO" bus first appeared in Singapore in 1980. In 2002, the amount of sales of "VOLVO" buses in Singapore are 203,000,000 Swiss Kroner in 2002; 300,000,000 Swiss Kroner in 2006. Suffice to say that sale of the "VOLVO" buses in Singapore is not insignificant. While citing the reason that more recent figures are not available, the Opponents also stated that the amount spent on promoting "VOLVO" for buses in Singapore is 55,000 Swedish Kroner yearly for the years 2001, 2002 and 2003 and 275,000 Swedish Kroner for year 2000.

18 The Opponents also brought up evidence taken from the Applicants' associated company website which they claimed showed blatant actual confusion between


"LOVOL" and "VOLVO". Under the "Historic Events" section of the website, there is reference made to "VOLVO" holding a contest for participation by all in the employment in the Applicants' training centre, thereby promoting the "VOLVO" name when in fact it should be promoting the "LOVOL" name. The Opponents claimed that this showed that the two names are confusing, even within the Applicants' own company and its associated subsidiaries and licensees. The Opponents further claimed that this typographical error confirms the Applicants' intention to adopt a mark which is clearly influenced by the Opponents' "VOLVO" brand and which will benefit from the fame and reputation comprised in the Opponents' "VOLVO" brand.




19 The Applicants acquired all rights, title and interest in the trade marks, "LOVOL"





and  from Beiqi Foton Motor Co., Ltd on 16 March 2006. The Applicants said that both the Chinese trademark 雷沃 ("lei wo" is Chinese Pinyin) and the English mark "LOVOL" were originally designed by the brand designers of Beiqi Foton Motor Co., Ltd ("Foton") for its own engineering trucks. The Applicants said that in the creation period, the Chinese mark 雷沃 came first and then the "LOVOL" mark came later. The Applicants explained in their Statutory Declaration that according to Foton's explanation, in the year 2004, the designing team of Foton was required to create a mark which would reflect the mission and prospect of Foton as an enterprise in heavy industry, taking into consideration the literal meaning of the Chinese words, its pronunciation, connotation, the product characteristics, nature of the industry and people's association. Based on this, Foton first used the Chinese mark 雷沃, (the first character of the Chinese characters means "thunder" and the second character means "fertile"). Thereafter, the creation of the English mark was undertaken on the following bases: (i) the English trade mark was to look like an English word which customers could easily identify and pronounce; (ii) the English trade mark was to sound similar to the Chinese trade mark; (iii) a heiroglyphic element was to be incorporated into the trade mark so that it would be recognized and remembered by people who did not speak or read English or know the Latin alphabet; (iv) the English trade mark should be visual and symmetrical and (v) the English trade mark should not have any meaning. Taking these into consideration, the designing team came up with the mark, "LOVOL". The Applicants explained that the letter "V" represents the frame of the vehicle; the letters "O--O" represent the wheels and the letter "L" at the beginning and end look like handles found on many agricultural equipment such as reapers and harvesters. The designers believed that the trade mark "LOVOL" would help people, especially farmers, to remember equipment bearing the "pattern" of the equipment.

20 Subsequent to the creation, registration was obtained in the Chinese Trademark Office for the Chinese mark, 雷沃 on 19 October 2004 under Application No.4316892 and the trade mark "LOVOL" on 11 August 2005 under Application No.4831530 in Class 12. Both the Chinese character, 雷沃 and the English trade mark "LOVOL" were first used by the Applicants' predecessor in November 2005 in association with trucks.

21 The Applicants claimed that both the "LOVOL" and " " marks are used around the world in association with construction machinery, agricultural equipment and vehicles. These products include engines, loaders, excavators, backhoe loaders, rollers, drilling rigs, cranes, agricultural combine harvesters, and three wheeled passenger and delivery vehicles. The Applicants also stated that on 12 June 2008, at the 5<sup>th</sup> China 500 most valuable brands ranking list jointly organized by World Brand Lab and the World Economic Forum, the "LOVOL" brand was ranked the 99<sup>th</sup> most valuable brand in China. The "LOVOL" brand was also ranked 1<sup>st</sup> in China in domestic agricultural machinery industry category and 3<sup>rd</sup> in the engineering machinery industry category.

22 The Applicants also claimed that in the global market, the marketing of products bearing the trade marks, "LOVOL" and " " have shifted from orders in small quantities to orders in large quantities and that more than 13,000 units of products bearing the said trade marks have been sold in more than 20 countries around the world, generating revenues in excess of US\$100million. The worldwide sales turnover for "LOVOL" and " " products were 5,184,450,000 RMB Yuan in 2006; 4,695,470,000 RMB Yuan in 2007 and 6,270,950,000 RMB Yuan in 2008. In Singapore, the products bearing the trade marks, "LOVOL" and " " were first sold in 2008. The sales turnover in 2008 is 106,300 RMB Yuan.

23 The Applicants own registrations to the trade marks, "LOVOL" and " " in many countries around the world. The Opponents have also filed oppositions against the Applicants' applications to register the trade marks, "LOVOL" and " " in several countries and their oppositions were unsuccessful in Angola, Australia, China, Chile, Ecuador, Oman, Panama, Peru, Philippines and Thailand. The Applicants' case is that for the opposition proceedings in the United Arab Emirates and Jordan that were decided in the Opponents' favour in class 7, the Applicants have filed appeals in both countries. As regards the decision in Saudi Arabia which is in the Opponents' favour, the Applicants had also intended to appeal but for the fact that they missed the deadline for appeal.

24 On the appearance of "VOLVO" on the website of an associated company of the Applicants, the Applicants explained that it was the result of a clerical error made by an employee of the company engaged to do the design. The Applicants were not involved in reviewing or approving the website.

## MAIN DECISION

## **Ground of Opposition under Section 8(2)(b)**

25 Section 8(2)(b) of the Act reads:

### **“Relative grounds for refusal of registration**

**8.** —(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(b) it 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, there exists a likelihood of confusion on the part of the public.”

### ***Opponents’ Submissions***

26 The "VOLVO" trade mark registrations owned by the Opponents pre-date the filing of the Application Marks by the Applicants. The Opponents submitted that based on the 3-step test enunciated in *British Sugar PLV v James Robertson & Sons Ltd [1996] RPC 281* ("*British Sugar*"), the two marks, "LOVOL" and "VOLVO" are confusingly similar. The Opponents submitted that the "LOVOL" mark has visual and phonetic similarities to the "VOLVO" trade marks. Both marks are made up of five letters of the Alphabet. Although the letters appear in a different order in each mark, there are similarities in the appearance and pronunciation of the marks when perceived by the average consumer. The two syllables "VOL-VO" and "LO-VOL" produce the same sound and can be confused with each other. The pronunciation of each syllable of the respective marks is similar and has the same intonation and sound.

27 The Opponents submitted that in terms of visual similarities, "LOVOL" can be misread or could be mistakenly connected to "VOLVO". The Opponents also submitted that it is possible for the average consumer to think that "LOVOL" is a fanciful play of the famous "VOLVO" brand and therefore originated from the same source or undertaking. The first visual impression of the marks which plays on the average consumer's mind are the word elements which are similar.

28 As both "VOLVO" and "LOVOL" have no dictionary meanings, neither mark could be distinguished from each other conceptually. Thus, the average consumer would rely on the visual and phonetic elements of the marks which are similar. Therefore, there exists a likelihood of confusion on the basis that "VOLVO" and "LOVOL" closely resemble each other visually and phonetically.

29 The Opponents cited the case of *Festina Lotus SA v Romanson Co Ltd [2010] SGHC 200* ("*Festina*") ([58]-[60]) in support of their argument. In that case, it was held that a modification of at least a substantial degree has to be done for the Applicants' mark



to be dissimilar to the Opponents' mark. In that case, it was held that the visual differences between the two marks were outweighed by the aural similarities and the identical goods and a likelihood of confusion was established. The Opponents submitted that in the same manner, "VOLVO" is such a distinctive trade mark that visual and phonetic similarities between "LOVOL" and "VOLVO" can result in confusion between the marks.

30 The Opponents also compared the goods covered in the Applicants' application and the Opponents' earlier registrations and concluded that the Applicants' mark would be used and marketed to the same consumers, through the same trade channels and would appeal to the same industry, namely, the automobile, motor and land vehicle industry, the construction and agricultural products in general. Further, the Applicants' goods and the Opponents' goods are either identical and/or similar. The Opponents also submitted that they have tendered strong evidence to show use of their "VOLVO" trade marks in respect of an identical or at least closely similar range of goods to the goods applied for in the "LOVOL" trade marks. The goods used by the Applicants for their "LOVOL" trade marks such as wheel loaders, trucks, cranes, cement mixers, tractors and other forms of construction and agricultural vehicles are goods which fall within the major business areas of the Opponents.

31 The Opponents submitted that by virtue of the identical or closely similar goods, and the fact that "LOVOL" and "VOLVO" make similar impressions both visually and phonetically, there is a likelihood of confusion (the test being that laid down by the Court of Appeal in *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR(R) 690 ("Polo/Lauren")*). Further, applying the test in *Polo/Lauren*, which required that the question of confusion be considered by reference to extraneous factors such as trade practices and the nature of the market which the respective parties cater to, the Opponents submitted that both the "VOLVO" and the "LOVOL" marks are advertised and promoted through the same trade channels and they cater to the same type of consumer and this could lead to the conclusion that "LOVOL" is an extension of the "VOLVO" trade marks and that the Applicants' goods originate from the same source as the Opponents' goods or originate from related undertakings. Further, the Opponents challenged the Applicants' claim of use of the "LOVOL" mark in Singapore as no evidence was filed to support this claim. The Opponents' case is that the "LOVOL" trade mark would not have any impact in the Singapore market and this lessens the likelihood of the average consumer being able to identify "LOVOL" as being associated with the Applicants and their ability to distinguish the goods as those of the Applicants.

32 The Opponents also submitted as precedent value the European Court of Appeal's decision in *Volvo Trademark Holdings AB v OHIM Case No T434/07* which held that "SOLVO" is similar to "VOLVO". The Opponents also cited the evidence taken from the Applicants' associated company's website that they claimed showed actual confusion because in one portion of the website, there was a mistaken reference to "VOLVO" instead of "LOVOL". The Opponents submitted that this evidence showed how the "LOVOL" mark is perceived and misread by the average man on the street. The Opponents further relied on the principle enunciated in *Weir Warman Ltd v Research &*

*Development Pty Ld [2007] 2 SLR(R) 1073 ("Weir Warman")* in which the High Court stated, "...marks that are misleading or likely to cause confusion or no longer serve their function should not be accepted or allowed to remain on the register, as the case may be." The Opponents submitted that the the "LOVOL" trade mark falls within the ambit of marks which are likely to cause confusion in relation to the Opponents' "VOLVO" trade marks and that it would be contrary to law to permit the "LOVOL" trade mark to co-exist with the "VOLVO" trade marks on the Singapore Trade Mark Register.

33 In conclusion, the Opponents' case is that the Application Marks should be refused registration under Section 8(2)(b) of the Act.

### *Applicants' Submissions*

34 The Applicants contended that in terms of visual similarity for T0813228H, the marks are visually dissimilar as the Opponents' mark "VOLVO" is in white, enclosed by a black rectangle and encapsulated in a double ringed circle with an arrow pointing outwards whereas the Applicants' mark "LOVOL" is in black enclosed in a stylized rectangle. In terms of visual similarity for T0813229F, the Applicants' case is that the Applicants' mark is a palindrome, reading the same backwards as forwards. The visual symmetry of "LOVOL" is striking, especially, the "book-ending" of the letter "V" by letters "OL". The Opponents' mark, "VOLVO" has no symmetry and has the two letters "V" visually dominant. The Applicants also submitted that the font in the Applicants' mark is different from that of the Opponents' mark.

35 On aural similarity, the Applicants submitted that the oral pronunciation and aural impression of the Applicants' "LOVOL" are notably different from the Opponents' "VOLVO". The Applicants' mark is pronounced as "LOW-VOL" whereas the Opponents' mark is pronounced as "VOL-VO". The Applicants further submitted that as English is spoken as a first language in Singapore, any pronunciation based on the spelling alone of "LOVOL" would never be confused with "VOLVO".

36 On conceptual similarity, the Applicants' contention is that there is no conceptual similarity at all since both are invented words.

37 On similarity of goods, the Applicants conceded that there is some overlapping for some goods in Class 12, for example, in relation to "automobiles, trucks, tractors". Other than these, the other goods in Class 12 are not similar in terms of their uses, users, and physical nature. The Applicants also raised the point that both the Applicants' and Opponents' Class 12 goods are likely to be found in the shops or showrooms of their respective authorised sole agents or distributors. On Class 7 goods, the Applicants contended that the uses and users of the goods are different. In relation to trade channels, there is no overlap in relation to trade channels as both Applicants' and Opponents' goods are likely to be found in the shops or showrooms of their respective distributors/sole agents.

38 On the question of the likelihood of confusion, the Applicants cited the principle in *Polo/Lauren* that in order to assess the likelihood of confusion, it would be necessary to

consider all relevant surrounding circumstances, including the nature of the goods, the price of the goods, the nature of the consumers, the nature of the industry and the respective trade channels.

39 In relation to Class 12 goods, the Applicants contended that in Singapore, cars are the second most expensive item next to property. Therefore, a car will only be purchased after much scrutiny, consideration and thought and not bought at whim. Consumers would be discerning as their purchase. As there are different brands to choose from, from the lower-end range to the much higher-end luxury range, consumers will be more deliberate and circumspect during their selection and purchase to ensure that they are buying exactly what they are looking for. "VOLVO" cars are by no means inexpensive and consumers would be well aware of the differences in the price range of cars. Furthermore, consumers would have brand loyalty in light of the extensive branding exercises that such products generally go through. The Applicants also cited the point made in the case of *McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177* that the average consumer in Singapore is one who is literate, educated, exposed to the world and not easily hoodwinked. Further, cars are sold through car distributors and in this case, the Applicants' and Opponents' cars are sold via different car distributors. The Applicants' case is that this factor greatly reduces the likelihood of confusion. The Applicants also highlighted the fact that the visual appearance of the marks prominently displayed outside car showrooms also greatly reduces the likelihood of confusion. In the case of car parts and fittings, they are sold in authorised workshops. The fact that they require some degree of compatibility and are not items purchased by consumers spontaneously, also adds to lessen any likelihood of confusion. It is also most unlikely for motor workshops, another group of consumers, to be confused.

40 In relation to Class 7 goods which are construction equipment such as haulers, loaders and excavators, because these goods cater to a specialized sector, the consumers are likely to be well-informed people in the trade who would exercise greater due diligence before making the purchase and therefore, it would be unlikely that they get confused.

41 In relation to trucks, the Applicants' point is also that these goods cater to a specialised sector who are likely to be well-informed and discerning persons in the transportation and construction trade who would exercise greater due diligence before the making purchase and thus, confusion would not occur.

### ***Decision on Section 8(2)(b)***

#### *Criteria under Section 8(2)(b)*

42 An "earlier trade mark" is defined in Section 2 as follows:

***"earlier trade mark" means –***

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking

account (where appropriate) of the priorities claimed in respect of the trade marks;"

As the Opponents' marks, T7565774E and T6229924A for "VOLVO" in Classes 7 and




12 respectively and T6229925Z for "

" in Class 12 and T0722398J for "



" in Class 7 are all registered as at 24 April 2008 (the date of application of the Application Marks), the Opponents' marks definitely qualify as "earlier trade marks" within the definition of Section 2. As for the requirements under Section 8(2)(b), the test is that as enunciated by the Court of Appeal in the *Polo/Lauren* ([8]-[9]) for Section 27(2)(b) of the Act (the requirements for infringement under Section 27(2)(b) are the same as those under the relative grounds for refusal or registration in Section 8(2)(b) (see also [15] of the *Polo/Lauren*)). The Court of Appeal adopted the test in *British Sugar* and held that the following conditions must be present. First, the Application Marks,

"LOVOL" and " " must be shown to be similar to the Opponents' earlier



registrations for "VOLVO", " " and " ". Second, the Application Marks and Opponents' marks must be used in relation to similar goods. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. On the question of similarity, it is a matter of degree. The greater the similarity between the two marks, the greater the likelihood of confusion will be. However, if either of the first two conditions is not satisfied, there will not be any need to go into the third question of determining whether there exists a likelihood of confusion. The Court of Appeal also said at [25]-[26] that it does not necessarily follow that just because the marks are similar and the goods are similar, confusion will automatically arise. In assessing the question of likelihood of confusion, regard must be had to extraneous factors such as trade practices. At [28], the Court of Appeal also pointed out other important factors such as steps taken by by the *Applicants* to differentiate his goods from those of the *Opponents* and the kind of customer who would be likely to buy the goods of the *Applicants* and *Opponents* have to be taken into consideration in assessing whether there is a likelihood of confusion. On similarity between the marks, the comparison is as to their visual, aural and conceptual similarities. The test to see if the goods are similar is that as held in *British Sugar* ([296]) which has been followed in all our local cases. The following factors may be used to assess if the goods are similar:-

- (a) the respective uses of the goods;
- (b) the respective users of the goods;
- (c) the physical nature of the goods;


- (d) the trade channels through which the goods reach the market;
- (e) for self-serve consumer items, whether in practice they are found or likely to be found, in particular, on the same or different shelves; and
- (f) the extent to which the respective goods are competitive.

*Visual Similarity*

Visually, both words, "LOVOL" and "VOLVO" are five letters long and both words contain the letters, "V", "O" and "L" and no other letters. Visually, both words also contain the component, "VOL". The difference as regards the component, "VOL" is that in "LOVOL", the component, "VOL" is at the end of the word but in "VOLVO", the component "VOL" is at the beginning of the word. It is also noted that there is another visual difference between the two words. As pointed out by the Applicants, the Applicants' "LOVOL" is symmetrical and is a palindrome whereas, the Opponents' "VOLVO" is not symmetrical and not a palindrome. On the whole, in comparing the two words, "VOLVO" and "LOVOL" visually, on the basis that the words are of the same length and contain the same letters, "V", "O" and "L" and the component, "VOL", there is a slight degree of similarity between the two words, "LOVOL" and "VOLVO". Next, a visual comparison of the marks with the respective words in combination with a device

will be made. The comparison is now between  on the one hand and



and  on the other. In this visual comparison, it is noted that the devices look rather different. The device in the Opponents' marks consists of a ring device with an arrow in a 2 o'clock position pointing outwards. The device in the Applicants' mark is less distinctive; it appears to be merely a border surrounding the word, "LOVOL". As regards the visual comparison of the marks with the devices therein, I find the devices to be dissimilar. On the whole, in comparing the marks with a device incorporated therein visually, there is lesser visual similarity between the marks. In fact, the marks with the respective words and devices therein are more dissimilar than they are similar.

*Aural Similarity*

43 In relation to aural similarity, both words, "LOVOL" and "VOLVO" are 2-syllable words. Both words have a strong "O" intonation or sound. In pronunciation, one word reads and sounds as "LOW-VOL", whereas the other word reads and sounds as "VOL-VO". Thus, the two words read and sound quite differently. Aurally, the two words are dissimilar. As for a comparison between the marks with the respective words and devices, as the words are aurally dissimilar, the marks are also aurally dissimilar.

*Conceptual Similarity*

44 As both words are each meaningless, it is not meaningful to compare the marks for their conceptual similarity.

*Comparison of the marks on the whole*

45 In the above, I have found a slight degree of visual similarity between the two words, "LOVOL" and "VOLVO"; very little visual similarity between the marks with the respective words, "LOVOL" and "VOLVO" in combination with devices; and no aural similarity between the two words, "LOVOL" and "VOLVO". As the primary element in both the Opponents' marks and the Application Marks is the respective word, "VOLVO" and "LOVOL", in comparing the marks for similarity, greater weight will have to be attached to their aural similarity. As I have found that the marks are aurally dissimilar, on the whole, by comparing the marks per se, my conclusion is that the marks are not similar.

*Comparison of the goods*

*Similarity of Goods*

46 For ease of reference, the goods to be compared by class are as follows:

<b>Class</b>	<b>Application Marks in T0813228H and T0813229F</b>	<b>Opponents' Marks in T6229924A and T629925Z</b>	<b>Opponents' Marks in T0722398J</b>
12	Automobiles; vehicles for transport for agricultural use; motorcycles; lifting cars; cycle cars; bicycles; electric vehicles; engines for land vehicles; fork lift trucks; concrete mixing trucks; tractors; trucks; cars; cleaning trolleys; tires for vehicle wheels; aeroplanes; boats; goods handling carts; funiculars; railway vehicles	Automobiles, parts thereof and accessories therefor included in Class 12.	Vehicles, including cars, vans, sport-utility vehicles (including golf carts), buses, trucks, tractor units/prime movers, on and off road vehicles/dump trucks and parts, including components, and accessories to these items which do not pertain to other classes, including vehicle chassis, vehicle bodies, brakes, brake callipers, draw bars, bumpers, clutches, vehicle engines, electric motors for vehicles, turbines, combustion engines, spark eliminators, power take-offs, gearboxes/transmissions for vehicles, transmission shafts for vehicles, differentials, drive gears, drive shafts, gear change selectors, manual and power steering apparatus, power steering systems, hydraulic steering systems, as well as component parts of these items, compressed-air reservoirs, and pneumatic motors, anti-pollution devices, air pumps, anti-dazzle devices, anti-theft devices and alarms for vehicles, vehicle immobilizers; trailer hitches, springs, shock absorbers, height regulators, wheels, wheel bearings, wheel trims, balance weights for wheels, engine mountings, tanks and fuel tanks, engine noise shields, protective covers, front grills, fluid reservoirs, wind deflectors, direction indicators, hatches, upholstery for all vehicles, handles for doors, hoods, horns for all vehicles, hubs for land vehicles, hub caps, hydraulic circuits, tyres for land vehicles, non-skid devices for tyres, mud flaps, brakes, power brakes and pneumatic brakes, anti-lock

			brake systems, brake pads and brake linings, bumpers, mudguards (body parts), mudguards; cabs for all vehicles, cab tilt mechanisms for all vehicles, reversing signals, headrests for seats in all vehicles, armrests, doors for all vehicles, seats for all vehicles, safety seats for all vehicles, personal safety restraint seats with attachments for all vehicles, child safety seats for all vehicles, tables tailored for seats in all vehicles, seat covers for all vehicles, headrest covers for all vehicles, seat belts for all vehicles, devices for collision protection, sliding roofs, sun roofs, vehicle steering columns, steering wheels for all vehicles, steering linkages, stabiliser bars, suspensions, suspension lowering outfits, torsion bars, tow bars, windows for all vehicles, power windows for all vehicles, windscreens (also of safety glass), accelerator pedals; windscreen and headlight wipers, wiper blades, vehicle window blinds, driving mirrors, mirrors (rearward vision), tank caps for all vehicles, luggage restraints for vehicles, luggage nets, luggage carriers, wheel carriers, bicycle carriers, surfboard carriers, boat carriers, mudflaps, snow chains, roof racks and ski racks, stowage boxes, safety deposit boxes, stowage compartments specially designed for all vehicles; trim panels, spoilers, side and rear skirts, safety cushions, airbags (safety devices for all vehicles), holders for mirrors, sun shades, passenger safety systems for installation in motor vehicles in the form of belt tensioners, airbags and inflatable curtains (safety devices for all vehicles); tyres, pneumatic tyres; adhesive rubber patches for repairing inner tubes; baby carriages, wheelchairs for invalids; bicycles; rudders, propellers, trimming vanes, steering units for boats, steering wheels and fittings for boats as well as component parts of these items in this class; apparatus for locomotion by land, air or water.
<b>Class</b>	<b>Applicants' Mark in 0813228H and T0813229F</b>	<b>Opponents' Mark in T7565774E</b>	<b>Opponents' Marks in T0722398J</b>
7	Harvesters; agricultural machines; road rollers; excavators; loaders; bulldozers; concrete mixers (machines); cranes; grain threshing machines; rice transplanters; lawnmowers; power shovels; diesel engines; gasoline engines; vehicle oil pumps; shock absorbers; vehicle washing installations; bicycle dynamos;	Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators	Motors and engines (except for land vehicles), including marine engines, aircraft engines, engines for industrial, agricultural and forestry machines, stationary combustion engines, turbines, electric motors; electrical generators and alternators; high-frequency generators; air cleaners (air filters) for engines and anti-pollution devices for motors and engines; carburettors, converters for liquid fuels, injectors, injection pumps, fuel pumps, speed governors, injection nozzles and nozzle holders, machine valves, vaporizers, starters, ignition systems, ignition coils, glow plugs, spark plugs, spark plug connectors, magnetos, silencers and spark arresters for

	<p>hydraulic presses; plastic jet moulding machines; waggon lifts; woodworking machines; papermaking machines; washing machines; dynamos; wind power electricity generators; alternators; emergency power generators; electricity generators; engines not for land vehicles; dynamo belts; driving motors other than for land vehicles; kick starters for motorcycles</p>		<p>combustion engines; fuel filters, oil filters, air filters; roller bearings, slide bearings, axles for machines, shaft seals for machines, gearwheels, drive wheels, transfer gears, pulleys, drive chains and belts not for vehicles, springs (machine parts), pumps (machines), pumps (parts of machines, electrical motors and engines), regulators (machine parts), relief valves (machine parts), controls, fans for engines and electric motors and fan belts for engines and electric motors, all for engine cooling radiators; radiator cooling fans, radiators, starters, fuel feed mechanism, oil cooler, brakes, caps for radiators, hydraulic pumps, hydraulic cylinders, hydraulic reservoirs, hydraulic filters, hydraulic motors, hydraulic pipes, hydraulic valves, servo units for hydraulic transmission, all for machines and engines; machine coupling and transmission components (except for land vehicles), including power transmissions, gearboxes/transmissions not for vehicles, reverse gears not for vehicles, reduction gears not for vehicles, gearbox controllers not for vehicles, traction control systems, vehicle dynamics control systems, shaft connections not for vehicles, clutches not for vehicles, exhausts, clutch and transmission belts for machines; power take-off units for vehicle engines, for use as prime movers; inboard/outboard drive units and sailing boat drive units for inboard engines; hydraulic pumps and motors and components thereof, bushings and bearings (machine parts); pneumatic valves (machine parts), power steering systems, control valves (machine parts), brake valves (machine parts); exhaust-gas turbochargers; compressors (machine parts), pneumatic brakes, compressed air reservoirs, compressed air cylinders and compressed air motors, bilge pumps (machines); metal and plastics processing machines; machines for the chemical industry, for agriculture, mining, incubators for eggs; agricultural implements (not hand operated); construction machines; machines for the automobile industry; machine tools and tools (machine parts) electric power tools and their plug-in tools included in this class; electric can openers; hydraulic lift jacks, body and frame aligners; packing and labelling machines, conveyors, conveyor belts; loading and handling machines for pressing plants and foundries and machines for the tooling of blanks; loaders, dumper bodies, excavators, diggers, road graders and parts, including components and equipment for such products included in this class; hydraulic lifting apparatus, cranes and lift cranes, winches; machine parts, namely buckets, grapples and fork-type implements; wood working machines, including delimiting, slashing, and debarking equipment; teeth and cutting edges for machines; car vacuum</p>
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			cleaners; car wash facilities; electrical fans for engines and electric motors; starting devices for combustion engines for indoor use, hydraulic cylinders and motors, engine radiators, silencers, parts, fittings and accessories for the abovementioned goods and for motorized land vehicles, not included in other classes; starter motors, exhausts, exhaust cowls, axles, shafts and couplings, machine coupling and transmission components, compressed-air cylinders fans, fan belts, bearings, mechanical controls.
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47 In relation to the Class 12 goods, the Applicants' application covers automobiles which are also covered in Opponents' registrations in T6229924A and T6229925Z. In addition, there are items such as engines for land vehicles and tires for vehicle wheels in the Applicants' application which are covered in the Opponents' registrations in T6229924A and T6229925Z which include "parts and fittings of automobiles". The Opponents' registration in T0722398J covers almost all types of vehicles as it includes all apparatus for locomotion by land, air or water and as such, would cover all the items in the Applicants' application. Thus, in relation to the goods in Class 12, the goods are similar if they are compared by their respective uses, users, physical nature and trade channels. In relation to the Class 7 goods, the Opponents' registration in T0722398J is wide enough to include goods very similar to the Applicants' agricultural machines, generators and engines and the Opponents' registration in T7565774E which covers machines would overlap with the agricultural machines and paper-making machines claimed by the Applicants. Suffice to say that the goods in Class 7 are also similar when they are compared by their uses, users, physical nature and trade channels.

48 Section 8(2)(b) requires that the likelihood of confusion has to arise from the identity or similarity between the Application Marks and the Opponents' earlier trade marks as well as from the identity or similarity between the goods. As I have found that the Application Marks and the Opponents' earlier trade marks are not aurally similar and not similar on the whole, although the marks are used on goods which are similar, there is no likelihood of confusion. The Court of Appeal in *Polo* states ([8]), "*First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public...,if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion.*"

#### *Likelihood of Confusion*

49 In case I am wrong in finding that the Application Marks and the Opponents' earlier marks are not similar, I will go on to examine the other relevant circumstances to determine whether there exists a likelihood of confusion. I will use the circumstances listed in "*Polo*" to show this. In "*Polo*" at [28], it was held that:

*“..the question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, **the impression given by the marks**, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources...Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent...**So also is the kind of customer who would be likely to buy the goods.**”*

50 On the impression given by the marks, as pointed by the Applicants which I agree, the Applicants' mark is a palindrome with a symmetry. The Opponents' "VOLVO" give a different impression. In addition, in relation to the Opponents' marks that comprise both the word, "VOLVO" and a device, the impression given makes the Application Marks and the Opponents' marks even more dissimilar and therefore, there is no likelihood of confusion at all. On the kind of customer who would be likely to buy the goods, I agree with the Applicants' submission that in relation to Class 7 goods, these are specialised goods that cater to a specialised sector of consumers who would exercise due diligence before buying these types of goods. They will not be morons in a hurry. In relation to Class 12 goods such as automobiles, these are expensive goods and relevant consumers will exercise great care in deciding which brand of automobile they want to invest their money in. I also take into account the fact that automobiles are usually sold through authorised distributors and a consumer will have to choose which authorised distributor to approach to buy the particular brand of automobile that he wants. All these factors or circumstances lessen the likelihood of confusion amongst consumers that the Applicants' goods come from the same source or economically-linked sources as the Opponents' goods.

51 I will now turn to the point raised by the Opponents concerning the evidence of actual confusion due to the one instance of a reference to the Opponents' mark, "VOLVO" in the website content of an associate company of the Applicants. I find it rather tenuous to make a conclusion that this evidence shows actual confusion. Even if the evidence points to actual confusion, it does not point to actual confusion amongst relevant consumers or the general public. It merely points to actual confusion in the party designing or putting up the website content for the Applicants or at the very most, the Applicants' associate company. The erroneous reference may cause confusion amongst users visiting the particular website as to whether the website belongs to the people dealing in the "VOLVO" brand or the "LOVOL" brand. But, the evidence does not show that people or consumers will confuse the "LOVOL" brand with the "VOLVO" brand.

52 To sum up, on the ground of opposition under Section 8(2)(b), in addition to my finding above that the marks are not similar on the whole, I will further conclude that taking into account all the relevant surrounding circumstances, there is no likelihood of confusion amongst the relevant consumers as to the source of the Applicants' goods if the Application Marks are allowed to proceed to registration.

53 Accordingly, the opposition under section 8(2)(b) fails.

## Ground of Opposition under Section 8(4)(a) and (b)(i)

54 Section 8(4)(a) and (b)(i) of the Act reads:

### “Relative grounds for refusal of registration

**8.** — (4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or”

### *Opponents' Submissions*

55 The Opponents cited the test for "well-known" marks in *Novelty Pte Ltd v Amanresorts Ltd and Another [2009] SGCA 13 ("Amanresorts")* and submitted that "Volvo" is a well-known mark. They also made reference to the remarks made by the Court of Appeal in *Polo/Lauren* ([19]) that, "*First, "Volvo" is not an English word. It is an inventive word, and is thus distinctive. Second, it had been used on the claimant's automobiles for a long time and had acquired a reputation and goodwill in it...*" and further, at [23], that, "*We recognize that some marks are inherently distinctive because they consist of inventive words without any notional or allusive quality. An example would be "VOLVO".*"

56 The Opponents also referred to the numerous registrations for "VOLVO" in several jurisdictions and pointed to the extent of use of the "VOLVO" trade marks in Singapore. In addition, the Opponents also pointed to the successful oppositions or enforcement efforts against "LOVOL" in countries such as Saudi Arabia, Jordan, Iraq, Croatia and other enforcement efforts against marks similar to "VOLVO" in countries such as Spain, China, Japan and so forth. The Opponents concluded that by virtue of the above facts, the Opponents' "VOLVO" mark is a well known mark in Singapore.

57 The Opponents further submitted that use of "LOVOL" in relation to the goods would indicate a connection with the Opponents' "VOLVO" goods and is likely to damage the interests of the Opponents. Their contention is that the connection between "LOVOL" and "VOLVO" goes beyond mere association and that the connection is made because the parties' trade marks are similar and they use their respective marks on their goods in a similar manner. As for the requirement of damage to the Opponents' interests, the Opponents cited the case of *Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co. Ltd [2008] SGIPOS 9* ([109]), that, "*where it has been shown that the mark is well-known and that there is an indication of connection, the likelihood of damage may be inferred.*" The Opponents further submitted that, "*if a consumer buys the*

*"LOVOL" goods thinking that there is a connection between those goods and the Opponents' "VOLVO" goods and if the Applicants' product does not perform like the Opponents' goods, then the consumer's perception of the Opponent's goods would diminish. The interests of the Opponent are likely to be damaged and these interests could include loss of pecuniary interests such as sales and profits."*

58 The Opponents therefore submitted that the Application Marks should be refused registration pursuant to Section 8(4)(a) and (b)(i) of the Trade Marks Act.

### ***Applicants' Submissions***

59 The Applicants' main point is that the marks are visually, aurally and conceptually dissimilar and therefore, the requirement that the whole or an essential part of the Application Marks must be identical with or similar to the Opponents' marks is not made out. On whether the Opponents' marks are well known to the relevant sector of the public, the Applicants' submission is that the Opponents have not shown that that is the case. On the requirement that use of the Application Marks would indicate a connection between the Applicants' goods and the Opponents such as is likely to damage the interests of the Opponents, the Applicants cited *Amanresorts* wherein the Court of Appeal stated that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [Opponents'] interests" requirement under Section 8(4)(b)(i) (which is *pari materia* with Section 55(3)(a)) are the corresponding tests for "misrepresentation" and "damage" for the passing off claim. The Applicants therefore submitted that as there is no confusing similarity between the marks, the element of misrepresentation is not made out. Consequently, the element of "damaging connection" under Section 8(4)(b)(i) is also not made out.

### ***Decision on Section 8(4)(a) and (b)(i)***

#### *Similarity between the marks in the whole or an essential part*

60 First, the whole or an essential part of the Application Marks ( **LOVOL** ;



) have to be identical with or similar to the Opponents' marks



("VOLVO"; ; ) (earlier trade marks). On this requirement, I have already found above that the Application Marks are on the whole not similar to the Opponents' marks under section 8(2)(b). The essential part of the Application Marks is the word, "LOVOL". The word "LOVOL" is not similar to the Opponents' "VOLVO" marks. Having reached this conclusion, strictly speaking, the ground of opposition under section 8(4)(a) read with section 8(4)(b)(i) can be disposed of right away since the important condition of similarity is not even met. In addition, as stated by the Court of Appeal in *Amanresorts* ([229]), *"In recognition of the fact that many trade marks are*

*potentially "well known in Singapore", Parliament has granted such trade marks only one advantage over ordinary trade marks, namely, the former are protected from registration and/or the use of identical or similar trade marks on dissimilar goods or services – such protection takes the form of protection covered by the "damaging connection" condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA", Section 8(4)(a) and (b)(i) is applicable where the marks are either identical or similar but in relation to dissimilar goods or services. In this case, the marks are not identical or similar and as I have found above, in fact, the goods are similar. However, for completeness, and in case I am wrong that the Application Marks and the Opponents' marks are not similar, I will now turn to examine the other requirements under this ground of opposition.*

*Is "VOLVO" well known in Singapore?*

61 In assessing whether a trade mark is “well known in Singapore”, the matters in Section 2(7) may be relevant. Section 2(7) states:

“Subject to subsection (8), in deciding, for the purposes of this Act, ***whether a trade mark is well known in Singapore***, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (a) the duration, extent and geographical area of –
  - (i) any use of the trade mark; or
  - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

62 It is clear that the factors listed in section 2(7) above are not an exhaustive list as Section 2(7) makes it explicit that it shall be relevant to “take into account ***any*** matter from which it may be inferred that the trade mark is well known”. The Court of Appeal in ***Amanresort*** at [137] said that the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires (subject to one particular factor which will be elaborated on later), and to take additional factors into consideration. Thus, it is clear that the factors in Section 2(7) (with the exception of the factor in section 2(7)(a) which has a deeming effect in section 2(8)) are merely a set of guidelines to assist the Registrar in determining whether the mark is a well known trade mark. Section 2(7)(a), however, has a special effect. This is because of section 2(8) which states that, “Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be ***deemed to be well known*** in Singapore.”

63 With the above analysis as to the operation of our legislative provisions as regards “well known trade marks”, it shall first be considered as to the “degree to which [the Opponents’ marks] are known to or recognised by any relevant sector of the public in Singapore”. As stated in the *Amanresorts* ([140]), once it is determined that the trade mark in question *is well known to “any relevant sector of the public in Singapore”* (emphasis mine), the deeming provision in section 2(8) kicks in and *the mark is deemed to be well known in Singapore*. In section 2(9), “relevant sector of the public in Singapore” in section 2(7) and 2(8) includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

As for the ambit of “all actual consumers and potential consumers in Singapore of the goods”, the *Amanresorts* has settled this issue as “the actual consumers and potential consumers of, specifically, the [*Opponents*] goods only (([142] to [154]), specifically, [154]). Applying the law to the facts of this case, the relevant sector of the public would be actual and potential consumers in Singapore of the Opponents’ goods in Classes 12 and 7, that is, consumers who will buy construction equipment, machines, implements and tools, engines and power systems for leisure crafts and workboats, vehicles, trucks, cars and the like. The question is, is “VOLVO” well known to this “relevant sector of the public”? And the relevant point in time to determine this question is as at the date of 24 April 2008, the date of application for registration of the Application Marks. As the Opponents have not tendered any direct evidence that shows that their “VOLVO” marks are well-recognised by this relevant sector of the public, the deeming provision therefore does not apply.

64 I will now turn to the guidelines listed in Section 2(7)(b)-(e). On the duration, extent and geographical area of the use and promotion of the Opponents’ marks, it is clear the Opponents have used their “VOLVO” marks in respect of Class 7 and Class 12 goods for many years not just in Singapore but also in many countries all over the world. More specifically, the evidence shows that the “VOLVO” trade mark was first put to use in Singapore for construction equipment in 1979. Thus, by April 2008, the “VOLVO” trade mark has been used by the Opponents for this type of goods for close to 30 years. Through Statutory Declarations, the Opponents have cited sales figures of the “VOLVO” trade mark in Singapore and Southeast Asia for construction equipment, machines, implements and tools which are rather impressive. The amounts of money that have been spent on advertising and promoting the “VOLVO” trade mark in Singapore and in Southeast Asia in respect of construction equipment, machines, implements and tools are also impressive.

65 In respect of engines and power systems for marine use for both leisure craft and workboats, the sales in Singapore or in Southeast Asia for “VOLVO PENTA” goods are not insignificant. The Opponents’ evidence is that “VOLVO” trucks are used in respect

of construction, agriculture, and transporting cargo such as timber and waste materials. As for trucks, the VOLVO trade mark was first used in Singapore on 17<sup>th</sup> August 1989. The Opponents have submitted evidence showing sales figures of their "VOLVO" trucks with the highest sales figures being S\$14.7million in 2000.

66 As for "VOLVO" cars, they have been distributed and sold in Singapore for several decades, through SM Motors Pte Ltd. The latter has been promoting and selling "VOLVO" cars since 1978. The units sold range from 212 in 1997 to 1396 in 2000 and 1140 in 2005.

67 As for "VOLVO" buses, the "VOLVO" bus first appeared in Singapore in 1980. The Opponents have also submitted evidence showing sales figures in relation to their "VOLVO" buses and suffice to say that sale of the "VOLVO" buses in Singapore is not insignificant.

68 As for registrations in Singapore and outside of Singapore, I note that the Opponents have registrations for their "VOLVO" marks in Classes 7 and 12 in numerous jurisdictions.

69 Weighing all the factors in section 2(7), my conclusion is that the Opponents' "VOLVO" mark is well-known to the relevant sector of the public and therefore, well-known in Singapore. At this point, I will quote the Court of Appeal in *Amanresorts* ([229]) that, "*it will be recalled that it is not too difficult for a trade mark to be regarded as "well known in Singapore" – essentially, the trade mark in question need only be recognised or known by "any relevant sector of the public in Singapore" [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule.*" As the threshold is not very high, a mark that has been in use for so many years and in many jurisdictions including Singapore would cross this threshold of being "well known in Singapore".

#### *Damaging connection between the Applicants' goods and the Opponents*

70 Next, I will move on to the other elements that need to be established under this ground, namely, whether use of the Application Marks on the goods sought to be registered would indicate a connection between the goods claimed and the Opponents and whether the interests of the Opponents are likely to be damaged as a result.

71 The Court of Appeal in *Amanresorts* ([234]) held that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [Opponents'] interests" requirement would yield the same results as those obtained from applying the corresponding tests vis-à-vis the claim for passing off which are, whether the [Applicants] have made a misrepresentation to the relevant sector of the public...which causes that section of the public to mistakenly think that the goods have the same source as or is connected with the Opponents' goods, and whether such misrepresentation has resulted in or is likely to result in damage to the interests of the Opponents. As I have found the Application Marks and the Opponents' marks to be dissimilar and that, taking into

account all the surrounding circumstances, there is no likelihood of confusion, my conclusion is also that it is unlikely that potential customers would be misled into thinking that the Applicants' goods originate from the Opponents or that there is some connection between the two parties. Consequently, there is also no likelihood that the interests of the Opponents would be damaged as a result. The elements of "connection" and "likelihood of damaging the Opponents' interests" under Section 8(4)(a) and (b)(i) are thus not made out, even though "VOLVO" may be well known in Singapore.

72 Accordingly, the ground of opposition under Section 8(4)(a) read with Section 8(4)(b)(i) also fails.

### **Ground of Opposition under Section 8(4)(a) and (b)(ii)**

73 Section 8(4)(a) and (b)(ii) of the Act reads:

#### **“Relative grounds for refusal of registration**

**8.** — (4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i)...

(ii) if the earlier trade mark is well known to the public at large in Singapore –

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.”

#### ***Opponents' Submissions***

74 The Opponents submitted that the "VOLVO" trade mark is well known to the public at large in Singapore because the "VOLVO" mark is inherently distinctive; has been used extensively in Singapore; has registrations in several jurisdictions and has been the subject of successful enforcement against other similar marks in various jurisdictions.

75 On the element of "dilution", the Opponents submitted that the meaning of "dilution" is as provided in Section 2(1) of the Act which defines "dilution" as, "the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is (a) any competition between the proprietor of the trade mark and any other party; or (b) any likelihood of confusion on the part of the public." The Opponents also cited the remarks made in *Tan Tee Jim's "Law of Trade Marks and Passing Off in Singapore"* wherein the author said that dilution would occur when there is either blurring or tarnishing of a trade mark. On "tarnishing", the author said that this would occur where a conflicting trade mark is used in relation to goods or services which are unwholesome or immoral or where there is a damaging connotation to the positive



image of the well-known mark. On "blurring", the author said that this would occur when the singularity or distinctiveness of the trade mark is impaired or eroded. The Opponents submitted that there is "blurring" as the distinctiveness of "VOLVO" would be eroded over time because the registration and use of "LOVOL" could open the floodgates for other look-alike and sound-alike marks to be used and registered for similar goods. The Opponents contended that the "LOVOL" trade mark reduces or erodes the strong capacity of the "VOLVO" trade marks to exclusively identify the goods of the Opponents and that the value of the distinctive "VOLVO" marks are diminished and consequently, there is a negative impact on its goodwill.

76 The Opponents therefore concluded that the "LOVOL" mark should be refused registration in accordance with Section 8(4)(b)(ii)(A) of the Act.

77 On Section 8(4)(b)(ii)(B) of the Act, the Opponents submitted that the test for "unfair advantage" is as enunciated by Jacobs AG in *Adidas-Saloman, Adidas Benelux v Fitnessworld Trading Ltd [2004] 2 WLR 1095* that the concept of taking unfair advantage of the repute of a trade mark encompassed "*instances where there [was] clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation*". The Opponents submitted that the Applicants have not furnished any legitimate basis for their choice of the "LOVOL" name other than to establish an association with the "VOLVO" trade marks. The Opponents further submitted that at the time of its application in Singapore, the "LOVOL" trade mark did not have the same level of market presence and has not been used long enough to create an identity of its own. As such, this would have an impact on the economic behaviour of the consumer in their perception of the "LOVOL" goods. By the application, the Applicants are free-riding or feeding on the goodwill of the well-known "VOLVO" trade marks.

78 The Opponents therefore concluded that the Application Marks should be refused registration in accordance with Section 8(4)(b)(ii)(B) of the Act.

### ***Applicants' Submissions***

79 The Applicants' main points of submissions are that the Opponents have not shown that their marks are well known to the public at large and that, in any event, the Opponents have failed to show that the Application Marks and the Opponents' marks are sufficiently similar such that the public would make a mental association between the two marks which is a necessary element for an objection under Section 8(4)(b)(ii). In fact, proving mental association between the marks (that is, the perception of the trade mark sought to be registered must call to mind the memory of the special known trade mark) is not good enough. It is also necessary to prove that the mental association would cause dilution, or take unfair advantage, of the distinctive character of the well-known trade mark. The Applicants' main contention is that because the Opponents have failed to prove that the public would make a mental association between the Application Marks and the Opponents' marks, the Opponents have also failed to show that there is a real risk of dilution occurring and therefore, this ground of opposition fails.

***Decision on Section 8(4)(a) and (b)(ii)***

*Similarity between the marks in the whole or an essential part*

80 As required under Section 8(4)(a), the first element that has to be made out is that the whole or an essential part of the Application Marks is identical with or similar to the Opponents' marks. As I have found that the marks are not similar, the ground of opposition under Section 8(4)(a) and (b)(ii) therefore fails. Again, the matter can be disposed off here. However, in case I am wrong on this finding and for completeness, I will proceed to deal with the other requirements under this ground.

*Is "VOLVO" well known to the public at large in Singapore*

81 Under this ground, the Opponents' marks must be shown to be "well known to the public at large in Singapore". There is no legislative definition of what constitutes, "well known to the public at large in Singapore". As stated by the Court of Appeal in ***City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2010] 1 SLR 382 ("Louis Vuitton")*** ([87]), there is also no guidance from the explanatory notes to the "Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks" to which our Section 8(4) is supposed to give effect to. However, it was noted by the said Court of Appeal that it was observed in ***Amanresorts*** at [229] that in the United States, section 2 of the Trademark Dilution Revision Act 2006 also amended the 1996 version of section 43(c) of the US Trademark Act 1946 (commonly known as 'the Lanham Act') (15 USC (US) 1127) by adding a definition of a 'famous' trade mark. And a 'famous' trade mark is one which is

"widely recognised by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register."

From the above analysis, the Court of Appeal concluded that in determining whether a trade mark is "well known to the public at large in Singapore", one must certainly have regard to section 2(7) of the Act. The Court of Appeal then went on to say at [94]:

*"The expression "well known to the public at large" should be given a sensible meaning, bearing in mind that by virtue of s2(8) of the Act, where a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore. Thus the test "well known to the public at large in Singapore" must mean more than just "well known in Singapore". To come within the former test, the mark must necessarily enjoy a*

*much higher degree of recognition. It must be recognised by most sectors of the public though we would not go so far as to say all sectors of the public. This approach would be in line with the US approach in determining famous marks.*" (emphasis mine).

82 I have already looked at the factors in section 2(7) and concluded that "VOLVO" is well known in Singapore. The question is, is "VOLVO" recognised by *most sectors* of the Singapore public? I do not think so. Unlike marks that are "well known in Singapore", where the threshold is not that high and relatively easy to cross (see above), the category of marks that are "well known to the public at large in Singapore" are reserved for the "rare and exclusive class" (see Court of Appeal's remarks in *Amanresorts* at [233] and in *Louis Vuitton* at [88]). It is noted also that the Opponents have not submitted any survey evidence to show the degree to which "VOLVO" is recognised by the public, let alone evidence to satisfy the requirement that "VOLVO" is recognised by most sectors of the public. In any event, I need not have come to this finding since my finding that the marks are dissimilar would already have rendered section 8(4)(a) and (b)(ii) inapplicable. As there are 2 important criteria that are not met here – the Application Marks and the Opponents' marks are not similar and the Opponents have not shown that their "VOLVO" marks are well known to the public at large, the ground of opposition under Section 8(4)(a) and (b)(ii) necessarily fails. It is therefore totally unnecessary for me to move on to determine if either of the elements of "unfair dilution" in Section 8(4)(b)(ii)(A) or "unfair advantage" in Section 8(4)(b)(ii)(B) required under this ground of opposition has been made out.

83 The ground of opposition under Section 8(4)(a) and (b)(ii) therefore fails.

#### **Ground of Opposition under Section 8(7)(a)**

84 Section 8(7)(a) reads:

##### **“Relative grounds for refusal of registration**

**8.** — (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;”

#### ***Opponents' Submissions***

85 The Opponents cited the case of *Reckitt & Colman Products Ltd v Borden Inc [1990] 1 WLR 491* ("*Reckitt*") for the elements of passing off, namely, goodwill, misrepresentation and damage.

86 On goodwill, the Opponents' case is that the "VOLVO" trade marks are distinctive indicia capable of being the vessels of goodwill as it is a completely made-up name and has built up a significant reputation and goodwill through years of use in Singapore and worldwide. The Opponents further submitted that the "LOVOL" trade mark constitutes a

misrepresentation as the "LOVOL" goods could be perceived as originating from the same source as the Opponents' goods and/or that the two were somehow connected. The Opponents submitted further that, as "LOVOL" is similar to "VOLVO", use of "LOVOL" may result in the likelihood of confusion or the belief that the goods are somehow related or connected to the Opponents.

87 On damage, the Opponents submitted that there is damage through the dilution to the goodwill attached to the Opponents' "VOLVO" marks through use of the "LOVOL" marks and that dilution would satisfy this requirement based on *Amanresorts* at [122].

88 The Opponents therefore concluded that the Application Marks should be refused registration pursuant to Section 8(7)(a) of the Act.

### *Applicants' Submissions*

89 On goodwill, the Applicants conceded that the Opponents have goodwill in Singapore for construction equipment, machines implements, tools and cars in which the "VOLVO" trade mark is used but not for the other goods. For these other goods including trucks and buses, the Applicants' point of contention is that the Opponents have not provided sales figures or amount spent on promotion in Singapore prior to the relevant date of 24 April 2008. On misrepresentation, the Applicants' submission is that as there is no likelihood of confusion under Section 8(2)(b), there is therefore no misrepresentation that is likely to lead the public to believe that the goods offered by the Applicants are goods of the Opponents. As the Opponents have also not adduced any evidence to show that they have suffered damage as a result of the use of the Application Marks, the element of damage is also not made out. The Applicants therefore contended that the ground of opposition under Section 8(7)(a) fails.

### *Decision on Section 8(7)(a)*

90 It is well accepted that the common law action of passing off comprises the following three limbs of (i) goodwill; (ii) misrepresentation; and (iii) damage. In particular, each limb has been succinctly elaborated in the case of *Johnson & Johnson v Uni-Charm Kabushiki Kaisha [2007] ISLR(R) 1082 ("Johnson")* which followed *WILD CHILD Trade Mark [1998] RPC 455* as follows:-

- (i) that the [Opponents' ] goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (ii) that there is misrepresentation by the [Applicants] (whether or not intentional) leading or likely to lead the public to believe that goods offered by the [Applicants] are goods of the [Opponents]; and
- (iii) the [Opponents] have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the [Applicants' ] misrepresentation.

### *Goodwill*

91 It is clear that passing off protects a person's business or goodwill and not the mark used. The mark is only a tool used by the person to educate his customers to identify the goods that originate from his business. While this is so, the role of the mark is crucial when proving the element of goodwill. As stated in the *Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon*, Chapter 17 at paragraphs 17.1.1 – 17.1.4, this is because the test which has been used by the courts to determine whether a person's business has goodwill is whether the mark adopted by him has become *distinctive of his goods* in the sense that it is *associated or identified exclusively with his goods*. In this case, the Opponents have used the "VOLVO" marks since 1962 in respect of Class 12 goods and since at least the 1970s in respect of Class 7 goods. The sales volume and amount of expenditure in advertisement and promotion under the Opponents' "VOLVO" marks have been substantial. The simple conclusion is that the Opponents have shown that there is goodwill associated with the Opponents' business through the Opponents' "VOLVO" marks in respect of Class 7 and Class 12 goods in which the "VOLVO" marks have been used.

### *Misrepresentation*

92 The key element for misrepresentation is deception. The main issue to be resolved is whether the Applicants had made a false representation that led to or is likely to lead to deception or confusion amongst the public. The nature of the deception or confusion may relate to the trade source of the goods. Although the key element is deception, it is not necessary to prove that the Applicants have an intention to deceive or mislead the public. It has been said that the state of the mind of the Applicants is immaterial but rather what matters is the *impact on the persons to whom the misrepresentation is addressed* (see *Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon*, Chapter 18 at paragraph 18.0.1).

93 The misrepresentation in this instance, if any, is the use of the Applicants' "LOVOL" marks by the Applicants. There would be misrepresentation if the public may be misled into thinking that the goods provided by the Applicants share the same source as the Opponents' goods; or that the goods of the Applicants are connected to the Opponents. The Opponents' case is that there is misrepresentation because the Applicants' "LOVOL" marks and the Opponents' "VOLVO" marks are confusingly similar. I have already concluded above that the marks are not similar and that there is no likelihood of confusion amongst the public that the Applicants' goods and the Opponents' goods originate from the same source. As stated in *Amanresorts* ([77]), "*a misrepresentation is actionable under the law of passing off only if it gives rise to confusion.....evidence of confusion is not required before a passing off action can succeed. It is open to the court to infer a likelihood of confusion from the surrounding facts. Confusion is still an essential element of the tort of passing off..(emphasis mine)*". As I have found no likelihood of confusion, this essential element of the tort of passing off has not been made out. Therefore, the Opponents have not discharged their burden of proving that the element of misrepresentation, a key element to a claim of passing off and which is to be inferred from a likelihood of confusion, has been made out.

*Damage*

94 As the element of misrepresentation for the action for passing off is not made out, it is not necessary for me to consider if damage is made out in this instance. In any case, there would be no damage since it is not proven that there is misrepresentation.

95 Accordingly, the opposition under Section 8(7)(a) also fails.

**Conclusion**

96 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the Application Marks in T0813228H (Classes 7 and 12) & T0813229F (Classes 7 and 12) shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 03rd day of January 2011

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Lee Li Choon

Principal Assistant Registrar of Trade Marks  
Hearings and Mediation Division  
Intellectual Property Office of Singapore