

## Intellectual Property Office of Singapore Case Summary: Time Inc. v Li San Zhong [2014] SGIPOS 14

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Time Inc., the Applicants for Invalidation ("the Applicants") sought the invalidation of the Subject Mark



in the name of Registered Proprietor Li San Zhong ("the Proprietor") and registered in Class 16 in respect of "Books; educational materials (other than apparatus) for use in teaching; printed programmes; printed publications; calendars; cards; magazines (periodicals); newsletters; patterned stationery; patterns for embroidery; periodic publications; periodical magazines; posters; printed patterns; printed periodical publications".

The case is interesting as, among other things, the Applicants contended that the Subject Mark contained two of their most famous trade marks, "FORTUNE" and "TIME", and was therefore confusingly similar to the latter (earlier) marks; or was therefore registered in bad faith.

However, the approach to comparing marks in Singapore is (a) mark-for-(a) mark and does not permit a comparison of the totality of the earlier marks (in this case "FORTUNE" and "TIME") on the one hand with the Subject Mark on the



other. Comparing "FORTUNE" and , and comparing "TIME" and  , the respective pairs of marks were not found similar on the whole. The Applicants also could not establish a likelihood of confusion, even if it were assumed that the competing marks were similar. Among other considerations, the consumer was thought to be likely to exercise a sufficient degree of care in selecting reading content of interest to him.

On a separate ground of invalidation, the Principal Assistant Registrar agreed with the Applicants that "FORTUNE" and "TIME" were well known marks in Singapore, in that they were well known to the relevant sector of the public. This referred to the actual and potential consumers in Singapore of magazines such as the Applicants' FORTUNE magazine and TIME magazine and includes business people, both locals and foreigners; as well as the adult population in Singapore that is interested in financial matters and current affairs. However, because no confusing connection was found between the Subject Mark and the Applicants, this ground of invalidation also failed.

The Applicants also argued that the Subject Mark was chosen in bad faith to confuse customers into thinking that there exists an association between the Subject Mark and them, because the former contained two of their most famous trade marks, "FORTUNE" and "TIME". Beyond this bare assertion, the Applicants could not discharge the burden of proof bearing in mind the high threshold before the serious allegation of bad faith is established. Proof of bad faith is rarely possible by a process of inference.



The application for a declaration of invalidity was refused and the Subject Mark could remain registered as a trade mark.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>.*