

Intellectual Property Office of Singapore Case Summary: **Seiko Holdings Kabushiki Kaisha v Choice Fortune Holdings Limited [2014] SGIPOS 8**

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Published: 16 July 2014

The case is noteworthy as a trade mark has been found to be well known to the public at large for the first time by the Principal Registrar of Trade Marks. In previous years, the Singapore courts have found the trade marks **CLINIQUE** and **NUTELLA** well known to the public at large. This makes the trade mark in this case, **SEIKO**, only the third one to join this "rare and exclusive class" of trade marks, as so described by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR(R) 216.

Choice Fortune Holdings Limited ("the Applicants") applied on 6 January 2011 to register **SEIKI** ("the Application Mark"), in Singapore in Class 9 in respect of "Television sets; liquid crystal display televisions; disc players with DVD and optical disc format that uses a blue-violet laser; combo drive with optical disc format that uses a blue-violet laser" ("the Application Goods").

Seiko Holdings Kabushiki Kaisha ("the Opponents") opposed the registration, arguing that the Application Mark was

confusingly similar to their earlier trade mark **SEIKO** (the "**SEIKO** mark") which was already registered in respect of a wide variety of goods, including the similar goods "apparatus for recording, transmission or reproduction of sound or images". The Opponents also alleged that the use of the Application Mark would cause dilution in an unfair manner of the distinctive character of the **SEIKO** mark.

In relation to the first ground, the Principal Registrar of Trade Marks held that although there was similarity of marks and of goods, there was no reasonable likelihood of confusion. This was partly because the average consumer will usually exercise care and pay attention in the selection and purchase of electronic goods such as television sets and disc players. Such goods are not generally bought on a routine and frequent basis, and it would not be uncommon for prospective buyers to check the visual and audio quality at a physical store, with some engagement with salespeople. Hence, the circumstances of sale are such that the average consumer is not reasonably likely to be confused.

In relation to the second ground, the Opponents discharged their burden of proof to establish that **SEIKO** is well known to the public at large in Singapore. The use and advertisement of the **SEIKO** mark in Singapore has been long and extensive, reaching the general public in areas of high human traffic such as in MRT stations and shopping malls. The **SEIKO** mark was hard to miss in normal daily life in Singapore, be it during a commute by bus or train, or shopping, watching sports or browsing periodicals. A survey commissioned by the Opponents also demonstrated that 72% of the 402 respondents were aware of the **SEIKO** mark.

However, under the "global approach" of the Court of Appeal in *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531, there needed to be a link in that the consumer will call to mind the **SEIKO** mark after seeing the Application Mark used in relation to the Application Goods, and that there is consequently a real and serious likelihood of damage to the distinctive character of the **SEIKO** mark. The Opponents did not succeed in proving this. The marks here were not so highly similar and, comparing the Application Goods with the Opponents' goods for which the **SEIKO** mark is well known, namely timepieces, it would be a stretch to say that electronic goods such as television sets and disc players are so similar to timepieces that it would be likely for consumers to draw a mental link between the Application Mark and the **SEIKO** mark.

The Application Mark could therefore proceed to registration.

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>.