

Intellectual Property Office of Singapore Case Summary: Multi Access Limited v Guangzhou Pharmaceutical Holdings Limited [2019] SGIPOS 15

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Mr Wong Chak Bong was the founder of the “王老吉” (the Chinese character mark is referred to as “Wang Lao Ji” in Mandarin and “Wong Lo Kat” in Cantonese) herbal tea during the Qing dynasty. Mr Wong’s famed secret herbal recipe for countering internal heat, influenza and a host of other ills, became widely known and popular in China and the secret formula was passed down to his descendants from generation to generation.

Multi Access Limited (“the Opponent”), derived title from the 5th generation descendants who had used the Chinese character mark and the different romanised derivations of the mark in Mandarin and Cantonese, in Hong Kong. Guangzhou Pharmaceutical Holdings Limited (“the Applicant”), sold the herbal tea bearing the Chinese character mark in mainland China. Both the Opponent and the Applicant have registrations of Chinese character mark and its derivations in numerous jurisdictions. The Applicant applied to protect its mark “WONGLO” (the Application Mark) in Singapore under an international registration in classes 5, 30 and 32.

The Opponent opposed the Applicant’s mark on the following grounds: that the Application mark is so similar to the Opponent’s Mark that the public is likely to be confused between the marks under section 8(2)(b) of the Trade Marks Act (“TMA”). Further, the Opponent argued under section 8(4)(a) read with 8(4)(b)(i) TMA that its mark is well-known in Singapore and that use of the Application Mark would indicate a connection with the Opponent and would damage the interests of the Opponent. Finally, the Opponent argued under section 8(7)(a) TMA that the use of the Application Mark was liable to be prevented in Singapore by the tort of passing off. These 3 grounds rely on a finding of similarity between the Application Mark and the Opponent’s Mark.

The marks in contention are set out below:

The Application Mark	The Opponent’s Mark
WONGLO	WONG LO KAT

The Opponent argued that the two marks were highly similar in that the Application Mark which consisted of 2 syllables, corresponded exactly to the first 2 of the 3 syllables in the Opponent’s Mark. The average consumer in Singapore with imperfect recollection is likely to slur and/or carelessly pronounce the “WONG” and “LO” such that there would be no discernible aural distinction between “WONG LO KAT” and “WONGLO”, notwithstanding there was a difference in spacing in the marks. Further the Opponent argued that both marks convey the same concept in that they are derived from and inspired by the common name of the founder of the Wong Lo Kat herbal tea. The Applicant countered that the Opponent’s Mark consisted of 3 distinct words and that it would be difficult to under-enunciate the additional syllable “KAT” in the Opponent’s Mark which starts with a cacophonous “K” consonant sound and ends with a plosive “T” sound. The Applicant also stressed that consumers purchasing the goods will not have access to historical origins of the marks and this external matter ought not to be considered when deciding marks similarity.

Compared as wholes, the average consumer with an imperfect recollection will remember the Opponent’s Mark as a Chinese full name: “WONG LO KAT”. The Application Mark on the other hand is a one-word mark “WONGLO”, which has no meaning and will be perceived as an invented word. The element “KAT” can hardly be considered insubstantial or minor and there is a low tendency for the ending of the Opponent’s Mark WONG LO KAT mark to be slurred.

The hearing officer was of the view that the Opponent’s Mark taken as a whole gives the impression that it is a personal full name, as opposed to merely a personal name. In particular, the mark comes across as a Chinese full name, with the surname (or family name) preceding the normally disyllabic given name (composed of a generational name and a chosen name). The hearing officer also examined the evidence of use filed by the Opponent to assess if the Opponent’s Mark had acquired distinctiveness and concluded that the low number of invoices filed and the short period of use which the invoices covered (transactions made within one single month in 2014) was not sufficient to establish the same.

As the marks were found to be overall more dissimilar than similar, opposition proceedings were therefore unsuccessful and protection in Singapore was conferred on the Applicant’s International Registration in Classes 5, 30 and 32.

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 <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/multi-access-v-guangzhou-pharmaceutical-holdings-2019-sgipos-15.pdf>.