

Intellectual Property Office of Singapore Case Summary: Tiger Coatings GMBH & Co. KG v Seng Fong Paints Pte Ltd [2019] SGIPOS 10

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Published: 21 June 2019

To what extent does a trade mark registration for a word protect a device representation thereof? How would one compare the similarity of marks in such cases? These are, in essence, some of the questions posed in this opposition dispute.

Seng Fong Paints Pte Ltd (“the Applicant”), applied to register the following two “Application Marks” in Singapore. Tiger Coatings GMBH & Co. KG (“the Opponent”), opposed their registration, claiming that the Application Marks and its four “Earlier Marks” below were confusingly similar under Section 8(2)(b) of the Trade Marks Act (“the Act”).

Application Marks	Earlier Marks
<p>1.  LNK Brand</p> <p> LNK Brand</p>	<p>1. TIGER</p> <p>2. TIGER DRYLAC</p> <p>3. </p> <p>(collectively the “Non-Pictorial Marks”)</p>
<p>2.  LNK Coatings</p> <p> LNK Coatings</p>	<p></p> <p>(the “Cartoon Tiger Mark”)</p>

Much of the decision dealt with the comparison of the respective marks.

On the issue of visual similarity, apart from drawing the conclusion in relation to the Application Marks that consumers were likely to recall the textual element “LNK” in combination with a tiger device, rather than the tiger device alone, the IP Adjudicator observed that, in any event, the word “tiger” did not feature at all in the Application Marks. In the present case, the IP Adjudicator did not think that the Opponent could rely on its Non-Pictorial Marks to argue that the word “tiger” in these marks is enough to trigger in the mind of a consumer the image of a tiger, such that the Application Marks may still be said to be visually similar.

As for the Cartoon Tiger Mark, while there is indeed a visual representation of a tiger, the tiger is presented in a very cartoonish manner. It fancifully and unusually wields what appeared to be a paint-spray in its right paw, and its left paw points downwards to what appeared to be a container. In contrast, the tiger device in the Application Marks is “realist”, strikingly different from the tiger device in the Opponent’s Cartoon Tiger Mark. Taking into account the textual element “TIGER” in the Cartoon Tiger Mark, compared to the bold textual elements “LNK Brand” and “LNK Coatings” in the Application Marks, the visual differences are further emphasized. There is therefore no visual similarity between the Application Marks and all the Earlier Marks.

With regard to aural similarity, the Opponent’s argument was that the Application Marks would be verbalised as “tiger”, especially since they contain a “manifestly straightforward and direct device” such that the relevant public would refer to it as a “tiger” mark. In response, the Applicant asserted that the Application Marks contain textual components (“LNK Brand” and “LNK Coatings”) which have no corresponding relation whatsoever to any element of the Earlier Marks. There is thus no need to identify how and whether the Applicant’s tiger device would be verbalised by the relevant public simply because the relevant public would verbalise the marks with reference to the textual components.

The IP Adjudicator rejected an overly technical or mechanistic approach to determining whether textual or device elements of a mark would be more relevant in determining the issue of aural similarity. Rather, this should also be assessed on the basis of what would strike a consumer, looking at the marks fairly and having regard to their imperfect recollection thereof, as being the most prominent and distinctive elements of the marks, what these elements might connote, and whether these elements would be used by consumers in referencing the mark aurally. In this case, he found that the Earlier Marks will be aurally referred to using the “tiger” element. As for the Application Marks, however, given the prominence of “LNK Brand” and “LNK Coatings”, the terms “brand” and “coatings” whilst non-distinctive would clearly indicate to the consumer that “LNK” is in fact the brand communicated by the mark. Hence, that would be the part of the Application Marks that will be verbalised. There is therefore no aural similarity.

As regards conceptual similarity, the Opponent argued that the idea or concept conveyed by the Application Marks is that of a tiger, similar to the Earlier Marks. However, the IP Adjudicator did not think that the test of the conceptual similarity can be set so low that similarity may be found so long as some vague general concept may be identified as common across both marks being compared, especially when comparing textual and device representations, such that for example, a word mark for “tiger” should thus be automatically regarded as conceptually similar to any device representation of a tiger. The presence of the predominant “LNK Brand” and “LNK Coatings” played a significant role in his conclusion that the marks were not conceptually similar.

The IP Adjudicator went on to consider the remaining elements of “similarity of goods” and “likelihood of confusion” in case he were wrong on the above. He found that there was similarity of goods, but no reasonable likelihood of confusion. Thus, the ground of opposition under Section 8(2)(b) of the Act failed.

The Opponent also opposed the registration of the Application Marks based on Section 8(7)(a) of the Act, and alleged that the use of the Application Marks in Singapore is liable to be prevented by the law of passing off. The IP Adjudicator was satisfied that the Opponent enjoyed the requisite goodwill in Singapore. However, but having regard to his findings that the respective marks were dissimilar, and that there was no likelihood of confusion, the element of misrepresentation could not be established in the Opponent’s allegation of passing off.

The opposition therefore failed on both grounds and the Application Marks were allowed to 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 <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/tiger-coatings-v-seng-fong-paints-2019-sqipos-10.pdf>.