

Intellectual Property Office of Singapore Case Summary: Xiaomi Inc. v MiChat Pte Ltd [2021] SGIPOS 2

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Published: 22 February 2021

The main issue in this case is whether “MiChat” is similar to “mitalk”.



MiChat Pte Ltd (“*Applicant*”) sought to register “MiChat” (“*Application Mark*”) in the following classes:

S/N	<i>Application Mark</i>	Goods / Services
1	<p>MiChat 40201810931X-01 “<i>Application Mark-1</i>”¹</p>	<p>Class 09 Computer programs, recorded; computer peripheral devices; computer software, recorded; electronic publications, downloadable; computer programs [downloadable software]; computer game software; computer software applications, downloadable; computer screen saver software, recorded or downloadable; downloadable graphics for mobile phones; counters; intercommunication apparatus; Global Positioning System [GPS] apparatus; theft prevention installations, electric; Internet messaging software; Electronic message handling apparatus; Electronic panels for displaying messages; Carriers for message transmission.</p> <p>Class 42 Technical research; computer programming; computer software design; installation of computer software; conversion of computer programs and data, other than physical conversion; providing search engines for the internet; software as a service [SaaS]; information technology [IT] consultancy; electronic data storage; cloud computing; creating and designing website-based indexes of information for others [information technology services]; data security consultancy; data encryption services; monitoring of computer systems for detecting unauthorized access or data breach; Design and development of software for instant messaging.</p>
2	<p>MiChat 40201810931X-02 “<i>Application Mark-2</i>”</p>	<p>Class 38 News agency services; wireless broadcasting; message sending; communications by computer terminals; computer aided transmission of messages and images; information about telecommunication; electronic bulletin board services [telecommunications services]; providing user access to global computer networks; providing internet chatrooms; providing online forums; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Electronic mail and messaging services; Video messaging services; transmission of digital files.</p> <p>Class 45 Physical security consultancy; escorting in society [chaperoning]; dating services; marriage agency services; on-line social networking services; lost property return; monitoring intellectual property rights for legal advisory purposes; licensing of computer software [legal services]; registration of domain names [legal services]; legal administration of licences; On-line social introduction services; Online social networking services accessible by means of downloadable mobile applications; Personal introduction agency services.</p>

Xiaomi Inc. (“*Opponent*”) opposed the application. One of its main grounds of opposition was under Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed). To succeed under section 8(2)(b), the *Opponent* has to establish that: (1) the *Application Mark* is similar to one of its earlier marks; (2) the goods/services applied for are similar to the goods/services for which the *Opponent* has protection; and (3) as a result, there is a likelihood of confusion.

¹ The Application Mark was initially filed as a single application covering 4 classes. It was divided into 2 separate applications after the filing of the Notice of Opposition and before the filing of the Counter-Statement.

The **Opponent** relied on its following earlier marks, amongst others:

S/N	Opponent's Earlier Marks	Goods / Services
1	<p data-bbox="201 192 600 226">Opponent's Earlier Mitalk Mark</p>  <p data-bbox="201 331 344 365">T1219547G</p>	<p data-bbox="660 192 767 226">Class 9:</p> <p data-bbox="660 226 1495 555">Computer memories; computers; recorded computer programs; computer keyboards; recorded computer operating programs; computer peripheral devices; recorded computer software; monitors; data processing equipment, namely mouse, readers, scanners; compact discs; printers for use with computers; central processing units; notebook computers; calculators; electronic publications (downloadable); downloadable software, namely computer programs; mouse pads; wrist rests for use with computers; computer game programs; downloadable mobile phone ringtones; downloadable music files; downloadable image files; universal serial bus hardware; portable computers.</p> <p data-bbox="660 555 778 589">Class 35:</p> <p data-bbox="660 589 1495 678">Advertising; on-line advertising on a computer network; commercial administration of the licensing of the goods and services of others; sales promotion for others; marketing.</p> <p data-bbox="660 678 778 712">Class 42:</p> <p data-bbox="660 712 1495 1137">Technical research; industrial design; packaging design services; styling (industrial design); computer rental; computer programming; computer software design; updating of computer software; consultancy in the design and development of computer hardware; rental of computer software; recovery of computer data; maintenance of computer software; computer systems analysis; computer system design; duplication of computer programs; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; hosting computer sites (web sites); installation of computer software; data conversion of computer programs and data (not physical conversion); computer software consultancy; rental of web servers; computer virus protection services; providing search engines for the Internet; digitization of files by scanning; remote monitoring of computers.</p>
2	<p data-bbox="201 1137 552 1171">Opponent's Earlier Mi Mark</p>  <p data-bbox="201 1294 344 1328">T1310968Z</p>	<p data-bbox="660 1137 767 1171">Classes:</p> <p data-bbox="660 1171 1495 1238">3, 5, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 30, 34, 35, 36, 38, 41, 42, 43, 45²</p>

At the outset, the Registrar was of the view that the **Opponent's Earlier Mi Mark** is more dissimilar than similar to the **Application Mark** in **totality**. This is because the **Opponent's Earlier Mi Mark** is so stylistic that it may **not** even be perceived as the **sole** word "Mi" by the average consumer.

Thus the focus of the proceedings was on the **Opponent's Earlier Mitalk Mark**.

On the issue of mark-similarity, it was found that, the **Application Mark** is, in comparison to the **Opponent's Earlier Mitalk Mark**:

- (a) Visually more similar than dissimilar to a low extent;
- (b) Aurally more similar than dissimilar to a low extent; and
- (c) Conceptually considerably more similar than dissimilar;

such that it is **overall more similar than dissimilar** in comparison to the **Opponent's Earlier Mitalk Mark**.

In coming to this conclusion, the Registrar was of the view that, having regard to the evidence, the "Mi" component is **not uncommon** for the goods and services of interest such that there is no reason for it to be granted any additional protection that is usually reserved for marks which are technically distinctive. However, the "Mi" component is also not **so common** that the **Applicant** is entitled to cross a **lower** level of alteration to show that it is dissimilar to the **Opponent's**

² For the full specifications, see Annex A of the Notice of Opposition.

Earlier Mitalk Mark. Further, the “Mi” component is **still relatively** more distinctive than “talk” (or “chat”) since “talk” (or “chat”) is a common English word, which additionally is descriptive of some of the goods and services of interest in the present case.

The element of similarity of goods/services is **not** satisfied for **Application Mark-2** (Classes 38 and 45). This is because while the services in Classes 38 and 45 are related to the goods in Class 9, they are clearly not substitutes.

For **Application Mark-1** (Classes 9 and 42), it is obvious that the element of goods/services similarity has been satisfied. Specifically, the item **computer software applications, downloadable** sought to be registered for the **Application Mark** is similar to “recorded computer software” and “downloadable software, namely computer programs” registered for the **Opponent’s Earlier Mitalk Mark**.

In relation to the likelihood of confusion, there are at least two ways how this can occur. The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated. As mobile applications are generally free for downloading (or at most charged at a low price), the relevant consumer (who is a member of the general public in this instance) will not pay much attention when downloading or purchasing a mobile application. This is so even though a mobile application is generally downloaded / purchased for a specific function such that there would be some care exercised by the relevant consumer.

Overall, the Registrar was of the view that the effect of the low (or no) price will take **precedence** over the fact that mobile applications have specific functions, such that the general public will not pay much attention when downloading / purchasing a mobile application. Hence the element of the likelihood of confusion is also satisfied for **Application Mark-1** (Classes 9 and 42).

Accordingly, the Opposition under section 8(2)(b) succeeded in relation to **Application Mark-1** (Classes 9 and 42).

Disclaimer: The above is provided to assist a layperson to understand the main reasons for the Registrar's 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/2021/xiaomi-v-michat-2021-sgipos-2.pdf>.