

Court clarifies meaning of “connection”



By Karol Goh

In the recent decision of *Mobil Petroleum Company Inc v Hyundai Mobis* [2009], the Singapore Court of Appeal (the Court) considered the meaning of the term “connection” in Section 8(3) of the Trade Marks Act (1999 Rev Ed) (the Act). This case originated from a trade mark opposition commenced at the Registry of Trade Marks by the appellant, Mobil, to oppose registration of the respondent’s “MOBIS” trade mark. At the lower instance, the trade mark “Mobil” was found to be well known, a finding not contested on appeal.

One of the issues before the Court was determining the test for establishing a *connection* between the later trade mark sought to be registered and the earlier well known trade mark under Section 8(3)(b)(ii) of the Act. This section of the Act reads:

A trade mark which –

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if –
 - (i) the earlier trade mark is well known in Singapore;
 - (ii) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
 - (iii) there exists a likelihood of confusion on the part of the public because of such use; and
 - (iv) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

The Court held that a “connection” under Section 8(3)(b)(ii) of the Act, whether as to business, origin or quality, was one that indicated an existing relationship between the goods and services of the opposed mark and the proprietor of the well known mark.

The Court found in this case that use of the mark “MOBIS” would not result in an indication of a connection as to origin, quality or business between “MOBIS” and the “Mobil” mark or the appellant. At most, the average consumer would be reminded that “MOBIS” resembled to an extent the “Mobil” mark and nothing more.

In coming to its decision, the Court referred to its decision in *Novelty Pte Ltd v Amanresorts Limited* [2009], a case which also concerned well known trade marks. In that case, the Court had found that the requirement of “connection” under Section 55 of the Trade Marks Act (2005 Rev Ed) (TMA 2005) was the same as the element of misrepresentation constituting the tort of passing-off.

The relevant part of Section 55(3)(a) of the TMA 2005 reads as follows:

- ...the proprietor of a well known trade mark shall be entitled to restrain by injunction the use in Singapore, in the course of trade and without the proprietor’s consent, of any trade mark which, or an essential part of which, is identical with or similar to the proprietor’s trade mark, in relation to any goods or services, where the use of the trade mark –
- (a) would indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor...

Interestingly, the Court held that the term “connection” under Section 8(3)(b)(ii) of the Act, unlike Section 55 of the TMA 2005, did not require an element of confusion since the requirement of confusion was already encapsulated under Section 8(3)(b)(iii).

Although the Act has since been amended, this decision is still relevant because Section 8(3) of the Act has been retained under the TMA 2005 in relation to oppositions to applications for registration of a trade mark made before 1 July 2004.

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