

**Mobil defeated on appeal in *MOBIS Case***  
**Singapore - One Legal LLC**  
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Examination/opposition  
 National procedures

In *Mobil Petroleum Company Inc v Hyundai Mobis* ([2009] SGCA 38, August 5 2009), the Singapore Court of Appeal has rejected *Mobil Petroleum Company Inc's* opposition against the registration of *Hyundai Mobis's* trademark MOBIS.

Mobil sought to oppose the registration of the MOBIS mark for goods in Class 12 of the [Nice Classification](#) on the grounds that it was confusingly similar to its registered trademark MOBIL for goods in Class 4. Mobil was unsuccessful before the principal assistant registrar and the High Court (for further details please see "[Mobil fails to prevent registration of MOBIS](#)"). The applicable law in this case was the [Trademarks Act 1999](#), as the application for the registration of the MOBIS mark was made on April 17 2002.

Before the Court of Appeal, Mobil raised the following questions:

- whether use of the MOBIS mark by Hyundai would indicate a "connection" between Hyundai's goods and Mobil; and
- whether such a connection would result in a likelihood of confusion and damage to Mobil's interests under Section 8(3) of the act.

Further, Mobil questioned whether the mere likelihood of damage was sufficient to oppose registration of the MOBIS mark under Section 8(3). Section 8(3) provides as follows:

"A trademark which -

- (a) is identical with or similar to an earlier trademark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trademark is protected,

shall not be registered if -

- (i) the earlier trademark is well known in Singapore;
- (ii) use of the later trademark in relation to the goods or services for which the later trademark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trademark;
- (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 trademark are likely to be damaged by such use."

In coming to a decision as to whether there was such a "connection", the court drew a distinction between the statutory protection for well-known marks and the law of passing off - there is no requirement to show goodwill under the statutory provision and a well-known mark need not be used within the jurisdiction in order to avail itself of the protection afforded under the law.

The court added that the *raison d'être* of trademark law is to prevent confusion in the course of trade. Therefore, it must still be shown that the public would be misled into thinking that the goods bearing the later mark are somehow connected to the proprietor of the well-known mark.

The court held that a mere association between the marks was insufficient to constitute a "connection" for the purposes of Section 8(3). The court was of the opinion that there could be more than one type of connection and that connections could be of varying degrees. The court went on to discuss three possible forms - namely, connection as to origin, connection as to quality and business connection.

Applying the above, the court found no indication of a connection between the MOBIS mark and Mobil. A mere recollection of Mobil's mark on seeing the MOBIS mark was insufficient to establish a "connection" under Section 8(3)(ii) - at most, an average consumer would be reminded that the MOBIS mark resembles Mobil's mark, but nothing more.

With regard to confusion, the court held that the applicable test under Section 8(3)(iii) was the global confusion test enunciated in *Polo/Lauren v Shop-In Department* ([2006] SGCA 14). Under this test, the requirements for a finding of confusion under Section 8(3)(iii) will be satisfied so long as a substantial portion of the relevant public is likely to be misled. The court was of the view that a substantial portion of the relevant public (ie, sensible motorists) would not be confused, even if a 'connection' within the meaning of Section 8(3)(ii) existed.

Finally, the court considered the potential damage to Mobil's interests. The term 'interests' is wide enough to embrace the protection against erosion of distinctiveness by dilution (blurring or tarnishment). However, the court made it clear that:

- Section 8(3)(iv) does not protect against non-confusing types of dilution by blurring or tarnishment; and
- confusion is still required to establish the "connection" required under this provision.

Accordingly, "damage to interest" would not include non-confusing types of dilution. The court recognized that apart from pecuniary loss, other types of damage could be covered under Section 8(3)(iv). It was of the opinion that the proprietor of a well-known mark can suffer damage such as:

- restrictions on the use of the well-known mark; and
- risk of litigation.

The court concluded that Mobil had suffered no pecuniary loss as it did not sell automobile parts. Moreover, use of the MOBIS mark would not restrict Mobil's use and exploitation of the MOBIL mark as it did not show any intention to venture into the business of automobile parts or provide a one-stop solution for motorists.

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