

NOVEMBER 2007 Singapore: Trade mark for generic Maglev invalidated

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In this recent case in Singapore, the applicants, Siemens AG, sought to invalidate the mark Maglev, owned by a Taiwanese company, Sunonwealth Electric Machine Industry Co. Ltd (the respondents). Siemens alleged, among other things, that the respondents' mark is devoid of any distinctive character, has become generic in the trade, and was applied for in bad faith.

By way of background, the respondents' mark was registered in Class 11 for "ventilating fans for commercial equipment, for commercial or industrial use", with effect from November 15 2000.

In response to the applicants' claims, the respondents argued that their mark had become distinctive, and produced as evidence a product pamphlet which describes the MagLev motor fan in connection with the introduction in 1999 of its patented "Magnetic Levitation System", subsequently branded under the abbreviation "MagLev" in 2003. On another page, the pamphlet states: "MagLev = Standard magnetic flux + Maglev Flux." Other evidence that was adduced showed the product being described as "Maglev Magnetic Levitation System Motor Fan".

However, the respondents did not plead Section 23(2), which provides that where a mark has been registered in breach of the abovementioned grounds, it shall not be declared invalid if, as a result of its use, it has acquired a distinctive character in relation to the goods and services for which it is registered. They also did not file written arguments or attend the hearing to argue their case.

The applicants, on the other hand, advanced the following arguments and evidence in support of their application:

Generic mark

The applicants said that the mark has become generic in the trade, arguing that they had used magnetic levitation technology in connection with railway projects in Germany and China for high-speed trains which float off the tracks so that they may reach speeds of up to 500km/hr. The same technology has also been used in other countries since as early as 1975.

It was further submitted that "maglev" is a common term used in papers and articles as well as dedicated websites when referring to such technology. The term is listed in the 1988 New Oxford Dictionary as a noun which means "a transport system in which trains glide above a track, supported by magnetic repulsion and propelled by a linear motion", originating from the late 20th century from the words "magnetic levitation". It was also noted that there have been international conferences on maglev technology since 1972.

Bad faith

The applicants argued that the non-disclosure of the derivation of the mark to the examining Registrar was tantamount to fraud in the registration as an omission to inform the Registrar was as culpable as a fraudulent act.

In arriving at her decision to allow the invalidation application, the Registrar made the following salient points. First, that the mark is devoid of distinctive character. The Registrar said that a mark is distinctive if it distinguishes one's goods from another's. In the instant case, while it is not expressly indicated in the respondents' product pamphlet that their products use magnetic levitation technology, it does state that the standard magnetic flux and Maglev flux are used in their fans. Therefore, the respondents' fans do employ the type of technology that the term "Maglev" refers to, namely, magnetic levitation. When these fans are referred to as Maglev fans, consumers will wonder if this means the technology used or whether this is a brand name. On this account, the mark is devoid of distinctive character as it is incapable of distinguishing the respondents' products without their attempting to educate the public through their product pamphlets. As such, this ground of invalidation succeeded.

Secondly, the Registrar agreed that the mark has become generic in the trade. Based on the evidence adduced, the word maglev has become customary in the language and in the established practices of the trade as designating the type of products which use that technology and, in other words, generic. This ground therefore also succeeded.

Finally, on the allegation that the application for the mark was made in bad faith, the Registrar said that the omission to inform the examining Registrar about the derivation of the mark does not in itself necessitate the inference that the respondents acted in bad faith. Therefore this particular claim failed.

This case highlights to trade mark owners the importance of evaluating the registrability of their brand names as trade marks prior to seeking trade mark protection to avoid the risk of rejection by the Trade Mark Office or challenges from third parties.



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