

## APRIL 2008 Singapore: Hyundai Mobis v Mobil Petroleum Company, Inc

01 Apr 2008

---

In this case, Hyundai Mobis (Hyundai) applied to register the mark Mobis for a class of goods related to automobile parts. However, Mobil Petroleum Company, Inc (Mobil) filed an opposition with the Trade Marks Registry to object to the registration of the mark on the following grounds:

- i. the marks Mobil and Mobis were confusingly similar
- ii. Mobil was a well-known mark
- iii. the Mobis mark was being passed off as originating from Mobil
- iv. the application for the Mobis mark was made in bad faith.

Hyundai on the other hand stated that the mark Mobis was derived from the combination of the words mobile and system. They also pointed out that out of nine other countries in which Mobil had opposed their mark, Hyundai managed to obtain registration in seven countries. Furthermore, Hyundai raised the point that Mobil's lack of a registration in class 12 should also be taken into account.

The Registrar in examining the case before her applied the *Pianotist* test to determine if the marks were confusingly similar and found the marks Mobis and Mobil visually and aurally similar although the endings of these marks were different. According to the Registrar, there was a risk of an average Singaporean slurring the end of the consonants of both marks.

As for the respective goods claimed by the parties, the Registrar noted that the channels in which these goods were traded might overlap but nevertheless she was of the view vehicle parts cannot be considered similar to fuels and lubricants under the relevant provision of the Trade Marks Act as the very nature of the goods was different. The Registrar further pointed out that the purchase of Hyundai's goods entailed the making of considered and not off-the-cuff decisions on the part of consumers. Given the circumstances in which the goods were purchased, the Registrar found that there was no likelihood of confusion among the majority of consumers in Singapore.

The other issue that the Registrar had to consider was whether Mobil's mark was well known. Applying the list of relevant factors under the Trade Marks Act in this regard, the Registrar had no doubt that it was. However, the Registrar did not think that use of the Mobis mark would indicate a connection between Hyundai's goods and Mobil. Although consumers were aware of Mobil's well-known mark, this, according to the Registrar, was insufficient to establish a connection between Hyundai's vehicle parts and Mobil.

The Registrar also found that the opposition failed on all the other grounds including passing off and bad faith, and that the application for the Mobis trade mark could therefore proceed to registration.

It would appear that Mobil's case failed largely due to the lack of a tangible connection between Hyundai's claimed goods and Mobil. The Registrar was therefore of the view that there was no likelihood of confusion, given that consumers would not think of Mobil when they bought Hyundai's goods. If a connection were established, this case would probably have been decided differently.



*Kevin Wong and Mary Thomas*

### **Ella Cheong Spruson & Ferguson (Singapore) Pte Ltd**

152 Beach Road,  
#30-00 Gateway East  
Singapore 189721  
Tel: +65 6333 7200  
Fax: +65 6333 7222  
[mail@ecsf-asia.com](mailto:mail@ecsf-asia.com)  
[www.ecsf-asia.com](http://www.ecsf-asia.com)