

The Subway Way

By Annette Wong, KASS International Sdn Bhd, Malaysia

Long gone are the days where the word “Subway” only brought to mind visions of underground trains. Nowadays, more often than not, our thoughts are filled with tantalising images of fresh, tasty and succulent sandwiches, and... clothing? Well, Intellectual Property Office of Singapore (IPOS) surely thinks so!

In this case, the proprietor of Prosperous Enterprise (the Applicant) had registered the mark

“”

in Class 25, for clothing. He was in the business of selling women’s apparel. In 2005, he forgot to renew the registration of his mark, causing the registration to subsequently lapse. Upon realizing this, he sought to re-register his trademark in 2007, but once the application was published in June 2007, Doctor’s Associates Inc (the Opponent), owner of the famous

“”

trademark in a multitude of classes, wasted no time in opposing the application. The Opponent is the proprietor of restaurants, and is in the business of selling sandwiches and other food and drinks around the world.

The Opponent argued that even if the Applicant used the “” mark before the date of their application for re-registration in 2007, it is not a defence. Their argument centred on the premise that as long as the date of subject application is after the Opponent became well known, the Applicant’s registration should be refused.

The Applicant sought to refute the Opponent’s argument by pointing out that they had been using the

“”

mark within the particular class unopposed for 23 years. Furthermore, they contend that no confusion had arisen during those 23 years of use in relation to the marks. So, it is unreasonable to claim that confusion amongst the public had given them the unfair advantage of free-

riding on the popularity of the Opponent’s “” mark.

The learned Registrar allowed the Applicant’s registration to proceed after considering and concluding that the Opponent failed to establish:

- i) There was a damaging connection made out from the use of the “” mark by the Applicant.
- ii) There was unfair advantage or unfair dilution of the Opponent’s “” mark.
- iii) First use of the “SUBWAY” mark is irrelevant as compared to being the first to register the “SUBWAY” mark.
- iv) The test of passing off.

The learned Registrar conceded that the Opponent’s “” mark is relatively well known in Singapore, but declined to conclude that their mark is well-known to the public at large.

Crucially, she ruled that the Applicant had begun using their “” mark some 8 years

prior to the Opponent’s use of their “” mark. She considered – but remained unconvinced – that an ordinary sensible purchaser exercising caution would be confused into thinking that the Applicant’s goods originated from the Opponent or contemplate the possibility that both are closely related to one another. Consequently, she determined that the Applicant had acquired goodwill

in their business under the “” mark. This was subsequently used as the crux of her reasoning to conclude that the Opponent failed to establish that the Applicant’s use of their

“” mark signified a damaging connection, took unfair advantage and/or cause unfair dilution to the Opponent’s “” mark.

In Singapore, it is a rule of thumb wherein the proprietor who first uses the mark has more concrete rights in comparison with the proprietor who first files to register the mark. Hence first use of the mark may be given priority over first filing to register the mark.

The abovementioned case is a classic example whereby the Applicant’s “” mark was first used and registered in 1988 whilst the Opponent’s “” mark was registered in 1989 prior to their first use of the mark in 1996. The Applicant had inadvertently allowed their application to lapse from 2005 to 2007. Due to this lapse, the Opponent took the opportunity to argue that the Applicant’s “” mark was unprotected in those 2 years and their attempt at renewal in 2007 came during a time when the Opponent’s “” mark had allegedly enjoyed sufficient popularity in Singapore, hence, the Applicant should not be afforded protection on their similar mark which may confuse the public to believe that they are associated to the Opponent and pass off their business as the Opponent’s.

The learned Registrar correctly established that confusion will not arise as the Applicant had already garnered goodwill to their “” mark as they were the first to use the mark in Singapore on the labels of their women’s clothing.

Annette Wong is a Trademark Executive at KASS International, an established intellectual property firm in Malaysia (with offices in KL, Penang, Singapore and Indonesia).

For more information, visit www.kass.com.my or drop an e-mail to ipr@kass.com.my.