

# SIMILARITY OF TRADE MARKS - DECISION BY THE SINGAPORE HIGH COURT IN ROVIO ENTERTAINMENT LTD V KIMANIS FOOD INDUSTRIES SDN BHD

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Choosing between which versions of a trademark to register is a common dilemma for proprietors especially in cases where the trademark consists of both textual and device components. Usually due to cost constraints, not all versions of the trademark actually used are applied for. The instant case discusses the extent of protection conferred to a proprietor of a registered trademark in respect of preventing the registration of a subsequent mark deemed to be in conflict with the earlier registered mark

In 2012, Kimanis Food Industries Sdn Bhd (“**Kimanis**”) filed an application to register the mark “Angry Bite” covering snack food in Class 30. Rovio Entertainment Ltd (“**Rovio**”), the proprietor of earlier registered marks “Angry Birds (word)” and “Red Bird”, opposed the Kimanis’ trademark application. Rovio has registered its marks in several Classes including Class 30.

The Principal Assistant Registrar (“**PAR**”) of the Intellectual Property Office of Singapore dismissed Rovio’s opposition and awarded costs to Kimanis. The PAR found that there are more dissimilarities than similarities between the marks, there is no likelihood of confusion, and that the use of the Angry Bite mark would not indicate a connection between Kimanis’ goods and that of Rovio. With respect to the other grounds relied upon by Rovio in its opposition, the PAR found that there was no passing off as there was insufficient evidence to show goodwill in Rovio’s marks and there was no misrepresentation. The PAR also found that there was no copyright infringement as there was no proof that Rovio’s marks are original creations and there was no proof of copying. Rovio filed an appeal against the decision of the PAR before the High Court.

The following were at issue before the High Court:

1. Whether the marks are similar and there is likelihood of confusion, and whether in determining similarity, the separately registered Angry Birds word mark and the Red Bird mark can be considered as a composite mark or are to be considered separately against Kimanis’ mark ;
2. Whether Rovio’s marks are well-known marks and whether the whole or an essential part of the Angry Bite mark is identical or similar to either the Angry Birds wordmark or the Red Bird mark, such that the use of the Angry Bite mark would indicate a connection between the parties’ respective goods and the connection would likely damage the interest of Rovio ;
3. Whether the registration of the Angry Bite mark is liable to be prevented under the tort of passing off; and
4. Whether the registration of the Angry Bite mark is liable to be prevented under the law of copyright.

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## Determining the similarity of the marks

In its appeal, Rovio submitted that the PAR erred in comparing the Angry Birds word mark and the Red Bird mark separately against the Angry Bite mark. Rovio argued that the PAR should have considered whether the Angry Bite mark is similar to a composite mark made up of both the Angry Birds word mark and the Red Bird mark. Rovio asserted that it would be untenable to require trademark proprietors to register every permutation of their marks in order to be afforded with holistic protection under the TMA. Although not in fact registered, Rovio submitted that the composite mark could have been successfully registered as a trademark as its components (ie. the Angry Bird word mark and the Red Bird mark) were successfully registered. And as Rovio does, in fact, use the two separately registered marks as a composite on its products, Rovio submitted that the High Court should consider it as a composite mark in conducting the similarity comparison.

Kimanis, on the other hand, relied on the case of Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc. 1 SLR 911, wherein the Court of Appeal made a statement that “assessment of marks similarity is mark-for-mark without consideration of any external matter”. Rovio, however, argued that the Court of Appeal in making the said statement was not directly referring to whether two separately registered marks may be considered as a composite mark in comparing marks for similarity. Although the High Court agreed that Staywell was indeed not addressing the case of separately registered marks by the same proprietor, the High Court nevertheless noted that the holding in the said case still lends support to Kimanis’ position. The proprietor’s other registered marks can be considered as “external added matter” which should not be taken into account in a similarity of marks comparison.

Another case cited for the High Court to consider was the UK Trade Mark Registry’s case of Infamous Nut Co Ltd’s Trade Marks RPC 7 involving applications to register four device marks each comprising a monkey eating a nut. The applications were opposed by a proprietor of a series of registered marks consisting of monkeys holding a nut, wherein it was argued that one factor to consider was the ownership of a series or family of marks comprising a common theme. The Registry held that “**where the opponent relies on proprietorship of more than one earlier trademark, the registrability of the applicant’s mark must be considered against each of the opponent’s earlier trademarks separately**”. Again, Rovio argued that the case does not relate to an attempt to combine two separately registered marks. Nevertheless, noting that nothing in the Registry’s reasoning indicates that the Registry’s findings are to be limited to its specific facts or to series marks only, the High Court stated that the Registry’s approach is of general guidance when considering situations where an opponent relies on more than one earlier registered mark in opposing a new mark. The High Court stated that if it is impermissible to consider other registered trademarks within a series in determining similarity with the opposed mark, the same rule must apply, and even more so, where the earlier registered marks are not registered as a series.

Stating that there is no direct local authority on the issue of whether two registered marks may be combined as a composite whole in a similarity of marks comparison, the High Court turned to the wording of Section 8(2)(b) of the TMA which provides:

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“A trademark shall not be registered if it is **similar to an earlier trademark** and is to be registered for goods or services identical with or similar to those for which the earlier trademark is protected.”

The PAR, in dismissing Rovio’s opposition, alluded to the argument that in view of the consistent use of the singular (e.g. “an earlier trademark”, “a registered trademark”) in the provisions of the TMA, a plain reading of the statutory provisions indicate that they refer to a single trademark. Rovio, however, asserted that the use of singular and plural in statutes should not be taken literally unless there is evidence of Parliament’s intent. The High Court stated that adopting Rovio’s position that “an earlier mark” should include a composite of two or more separately registered trade marks would be problematic. An “earlier mark” must still be “a registered trademark”, and in this case, it is undisputed that the composite of Rovio’s mark (which Rovio was asserting) is not “a registered trademark”.

Rovio further argued that it is untenable to require trademark proprietors to register every permutation of their marks and that protection for registered trademarks would be severely reduced if the law is to be construed as not protecting composites of two or more separately registered marks by the same proprietor.

The High Court has taken the view that, contrary to Rovio’s position, the statutory purpose behind trademark protection points against allowing the combination of Rovio’s trademarks for the similarity of marks comparison. Rovio’s claim that it is impractical or untenable to expect trademark proprietors to register each combination of the marks they intend to use was not substantiated. The High Court noted that trademarks used in businesses may indeed evolve such that the trademark registrations earlier obtained may no longer sufficiently protect those marks actually used. However, the High Court stated that it does not follow that it would be unduly onerous to require a trademark proprietor to register the evolved mark. The High Court also stated that liability for trademark infringement is strict and thus the public must be able to know with objective certainty which trademarks are protected by registration. If a trademark proprietor is allowed to claim protection over all possible permutations of its registered marks, it would mean granting excessive protection of an uncertain scope. It would limit competition, render competitors vulnerable to unpredictable risks of infringement, and increase the likelihood of trademark litigation.

The High Court affirmed the decision of the PAR that Rovio’s two separately registered trademarks cannot be combined so as to form a single composite mark. The High Court proceeded with comparing the Angry Bite mark with the Angry Birds word mark and the Red Bird mark separately.

## **Comparison between the Angry Bite mark and the Angry Birds wordmark**

The High Court affirmed the PAR in its finding that two marks are visually similar in the letters “ANGRY BI”. The other elements of the Angry Bite mark distinguish it from the Angry Birds word Mark. In terms of aural similarity, the High Court agreed with the PAR’s finding that there was some aural similarity. Although both marks have the “ANGRY” component, “BIRD” and “BITE” contain some aural dissimilarity. And in terms of conceptual similarity, the only similarity is the emotion of anger conveyed.

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## Comparison between the Angry Bite mark and the Red Bird mark

The High Court affirmed the PAR's finding that although the angry eyes and eyebrows may be the dominant and distinctive components of both marks, the marks are visually dissimilar on the whole. On aural similarity, the PAR's finding that there can be no aural similarity as the Red Bird Mark has no aural component was affirmed. The High Court also agreed with the PAR's finding that the Angry Bite mark and the Red Bird mark are conceptually dissimilar. The Angry Bite mark conveys an idea of a creature biting angrily, and the Red Bird mark, on the other hand, conveys a bird with angry eyes. Only the emotion of anger is the common feature between the two.

The High Court held that the Angry Bite Mark is not similar to either the Angry Birds wordmark or the Red Bird mark and that there is no likelihood of confusion.

**Whether Rovio's marks are well-known marks and that the whole or an essential part of the Angry Bite mark is identical or similar to either the Angry Birds wordmark or the Red Bird mark likely to indicate a connection between the parties' respective goods and damage the interest of Rovio**

The High Court did not disturb the finding of the PAR that Rovio's marks are well-known marks in Singapore. Nevertheless, the High Court also affirmed the PAR's finding that the marks are not similar (as earlier determined in the comparison of the marks under Section 8(2)(b)) and there was no confusing connection between the parties' respective goods. The High Court agreed with the PAR that the principles applicable in comparing marks under both Sections 8(2)(b) and 8(4) of the TMA are the same despite some difference in their respective wording. The High Court held that the opposition failed on this ground.

## Opposition grounds based on the tort of passing off and the law of copyright

The High Court held that the opposition on the ground that the application must be prevented under the tort of passing off should fail. Although the High Court found that Rovio has established goodwill in Singapore, there was no showing of misrepresentation on Kimanis' part in the use of the Angry Bite mark. Without misrepresentation, there is no basis to claim damage to Rovio's goodwill.

The High Court further held the opposition the ground that the application must be prevented by virtue of the law of copyright should likewise fail. Although the High Court stated that Rovio would likely be able to show its trade marks are original artistic works (required in a copyright infringement claim), the High Court held that a case for copyright infringement has not been made out because Rovio was not able to show that Kimanis copied a substantial part of the Red Bird mark and Angry Birds word mark. Although Kimanis' designer may have been inspired by Rovio's marks and used the theme of anger or angry characters, the High Court noted that this is not something that is prohibited by the copyright that subsists in Rovio's marks.

The ruling, in this case, stresses the importance of being circumspect in choosing the version of the trade mark to be registered. As the assessment of similarity is mark-for-mark, a trade mark proprietor can only

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rely on the features of the trade mark as registered. Thus, a proprietor when filing a trade mark application must determine whether the version sought to be registered would provide the most protection. In cases where a proprietor uses multiple versions of the trade mark, it is prudent to register each version of the mark as actually used.

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