

Case Summary: Xiaomi Inc. v MiChat Pte Ltd [2021] SGIPOS 2¹

Xiaomi Inc (“**the Opponent**”) has its core business in manufacturing and retailing of smartphones and smart hardware connected by an Internet of Things (IoT) platform, which product names contain the “Mi” prefix. MiChat Pte Ltd (“**the Applicant**”) is a newcomer to the instant messaging platform scene. In terms of business overlap, the Opponent had in fact earlier in 2010 launched its messaging application, “Mitalk”, although today there are many more platforms to choose from.

The Opponent had registered several marks in Singapore including pertinently: **mitalk** in Classes 9, 35 and 42 (“**Opponent’s Earlier Mitalk Mark**”), and **mi** in 27 classes including Classes 9, 38, 42 and 45 (“**Opponent’s Earlier Mi Mark**”).

Although the opposition case began as against a single application claiming multiple classes, the Applicant thereafter applied for a division of their application into two distinct applications some months after the opposition application had commenced. The divided applications were for the same mark but each designated different classes, namely **MiChat** in Classes 9 and 42 (“**Application Mark-1**”) and **MiChat** in Classes 38 and 45 (“**Application Mark-2**”).

The Assistant Registrar (“**AR**”) later decided that while Application Mark-1 has been successfully opposed, the other could proceed to registration. Of note, the opposition succeeded under grounds section 8(2)(b) and section 8(7)(a) of the Trade Marks Act (“**TMA**”) in relation to Application Mark-1.

- (i) section 8(2)(b): marks similar for identical or similar goods and services

The AR held that the ground of opposition under s 8(2)(b) succeeded in relation to Application Mark-1.

The AR proceeded to only consider the Opponent’s Earlier Mitalk Mark for the purposes of this ground and found that it was overall more similar than dissimilar in comparison to Application Mark-1. Specifically, the AR was convinced that the Applicant’s mark was, in comparison to the Opponent’s Earlier Mitalk Mark:

- visually more similar than dissimilar to a low extent;
- aurally more similar than dissimilar to a low extent; and
- conceptually considerably more similar than dissimilar.

There is also at least some overlap in the respective goods/services. Having regard to her earlier finding that Application Mark-1 was overall more similar than dissimilar in comparison to the Opponent’s Earlier Mitalk Mark, the AR found that there would be a likelihood of confusion on the part of the public.

- (ii) section 8(7)(a): registration of mark is contrary to the law of passing off

The AR also held that the ground of opposition under s 8(7)(a) succeeded in relation to Application Mark-1 as importantly:

- the Opponent had the relevant goodwill in its business as a whole;

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- on a balance of probabilities, there was a likelihood of misrepresentation that the Applicant and Opponent are one and the same or that they are economically linked for the purposes of Application Mark-1; and
- there will be damage via blurring or the diversion of sales.

An appeal to the High Court on the AR's decision is now pending. Gateway Law Corporation represented the Opponent at the IPOS proceedings and is representing the Opponent in the appeal.

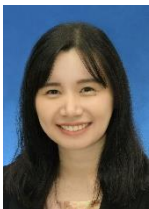
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This article is intended to offer an overview of the case and some perspectives from a practitioner's standpoint but is not intended to be comprehensive nor should it be construed as legal advice.