

**Question Q 155**  
**Conflicts between trademarks and company and business names**

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**Question 1**

1. As far as national Law or case law is concerned:

- i. To indicate if in their own countries there is legislation, or other sources of law, to protect:
  - i) company names,  
**Yes; The Companies Act**
  - ii) business names  
**Yes; The Business Registration Act**
- ii. To explain if national proceedings are necessary for nationals to obtain the right to use a:
  - i) company name,
  - ii) business name.

**(b)(i) Company names**

**Before a company can be incorporated under the Companies Act, a name must be reserved for it under section 27(12).**

**The Registrar of Companies & Businesses has the discretion not to register a company if, in his opinion, its name contravenes one of the prohibitions in section 27(1), unless the Minister gives his consent.**

**A company will be refused registration if its name falls within any of the following categories; i.e. if it is:**

- a. **undesirable;**
- b. **identical to the name of other company or corporation, or to any other business name;**
- c. **so similar to the name of any other company or corporation, or to any other business name, as to be likely to be mistaken for it;**
- d. **a name of a kind that the Minister has directed the Registrar not to accept for registration.**

**(b)(ii) Business names**

**Every person carrying on business in Singapore shall make an application to the Registrar in the prescribed manner for registration under the Business Registration Act. The Registrar of Companies & Businesses can exercise his discretion and refuse registration of a business name or cancel a business name already registered if it is -**

- a) **is identical to that of another corporation or the name under which another person carries on business;**
- b) **so nearly resembles the name of any corporation or the name under which another person carries on business as to be calculated to mislead, except where such other corporation is in the course of being dissolved or wound up or such other person signifies its or his consent in such manner as the Registrar may require; or**

- c) **is, in the opinion of the Registrar, undesirable or is a name of a kind which the Minister has directed the Registrar not to accept for registration.**

**It must be noted that the use of differentiating words, particularly words that describe a different industry or different area of business activity, will very often be sufficient to bring the company or business outside the ambit of identical or resembling company/business names. For example, PRUDENTIAL PHOTO STUDIO and PRUDENTIAL ASSURANCE CO. are likely to be considered sufficiently different for both to be accepted.**

- c) Whether a trademark could be invalidated and its use forbidden on the grounds of earlier:
- i) company names and/or
  - ii) business names

If so, explain the criteria followed to do so.

**There is no specific provision in our trade marks legislation that will cause a mark to be invalidated or its use forbidden purely by reason of prior registration of company name or business name. However, it is possible to invalidate the trade mark or prevent its use in such a case, on grounds of passing off, provided that the criteria for passing off are satisfied. Please note that common field of activity and confusion arising there from is usually required**

- d) Whether the use of a:
- i) company names and/or
  - ii) business names

could be forbidden on grounds of an earlier trademark application/registration. If so, explain the criteria followed to do so.

**There is no specific provision in our company or business legislation that will cause the company or business name to be de-registered or changed purely by reason of prior trade mark registration. However, it is possible to effect this on grounds of passing off provided that the criteria for passing off are satisfied. Please note that common field of activity and confusion arising there from is usually required. We wish to stress that it is more difficult to effect this than it would be under the trade marks law.**

- e) Whether the answers to above paragraphs c) and d) would be different if the earlier trademarks or company or business names are so well known that they have got a strong reputation across the market.

**See above**

- f) Whether special rules apply when the company name, the business name and/or the trademark correspond to the family name of the owner, or of a person somehow connected with the owner of the right.

**No**

- g) If there is any link or relationship between the Trademark Office and
- i) the Registers of Companies

- ii) the Register of Business names
- iii) other similar Registers (where companies and/or businesses are recorded).

in order to coordinate their practices and whether the content of one register is transmitted to that of another.

**No special links or relationships between the Trademark Office and the Registers of Companies and Businesses.**

h) Who is the authority responsible for dealing with conflicts between trademarks and company and business names:

- i. when the company or business name is to be authorized

**the Registrar of Companies & Businesses**

- ii. if and when opposition proceedings are available

**Where a company has been registered by a name that offends against section 27(1) of the Companies Act, the Registrar may direct the company to change its name. See section 27(2), Companies Act.**

**An appeal from the decision of the Registrar to require a change of name lies to the Minister of Finance, whose decision is final. See section 27(5), Companies Act.**

**Where an opposition is lodged against a published trade mark application on the basis of prior rights acquired through prior use of a company/business name, then the matter is heard by the Registry of Trade Marks.**

**It is possible to seek a cancellation of a Business Name on the basis of prior rights based on use of a similar trade mark in Singapore. However, this is filed with the Registry of Companies or Business. This is usually not very effective however, unless one is able to show strong evidence of prior rights (akin to a passing off action) and also that the opposing business name registration has not in fact been used by the proprietor of that business name.**

- iii. when legal actions take place.

**The courts**

i) Is there protection for business names in your country, that is restricted to a part of the country (town, village, etc.) corresponding to the place where the business was established?

If so, how are the conflicts dealt with that arise between these rights and trademarks and other nationwide companies and business name rights?

**No**

**Question 2**

2a) Whether you agree that an earlier trademark right could be used to prevent the adoption or use of identical or confusingly similar company or business names. If so, whether the identity or similarities of the goods/services of the trademark and the activities undertaken under the company or business

name or other criteria such as dilution or risk of association, as well as the reputation or notoriety of the trademark, should be taken into account.

**Yes, we agree that that an earlier trademark right could be used to prevent the adoption or use of identical or confusingly similar company or business names.**

**Yes, the identity or similarities of the goods/services of the trademark and the activities undertaken under the company or business name as well as other criteria such as dilution or risk of association, the reputation or notoriety of the trademark should be taken into account.**

*See Tan Gek Neo Jessie v Minister for Finance [1991] 2 MLJ 391 (The JC Penny's case)*

2b) Whether you agree that an earlier company or business name could be used to prevent the use and/or registration of an identical or confusingly similar trademark. If so, whether the identity or similarities of the goods/ services of the trademark and the activities undertaken under the company or business name or other criteria such as dilution or risk of association, as well as the reputation or notoriety of the company or business name, should be taken into account.

**Yes as in 2(a) above.**

2c) Whether you are of the opinion that there should be a national register with all company and business names recorded.

**Yes, there should be a national register with all company and business names recorded. Singapore already has this in place.**

2d) If you are of the opinion that before a national adopts a new company or business name, authorization should be given by the Register of Companies and/or Business names and, if so

**(Yes, we are of the opinion that before a national adopts a new company or business name, authorization should be given by the Register of Companies & Businesses. This is already the case in Singapore.)**

l) whether authorization should depend on whether the new name is not:

- i) identical to an earlier company or business name and/or,
- ii) confusingly similar to an earlier company or business name and/or,
- iii) identical to an earlier trademark and/or,
- iv) confusingly similar to an earlier trademark.

**Yes, authorization ought to depend on whether the new proposed name is identical to the earlier company or business name. Indeed this is already the case in Singapore. A company/business name which is identical to that of a prior-registered company/business name will not be registered. However, the addition of descriptive material will bring a name out of the ambit of being an identical business/company name. For example, "Lego Pte Limited" would not be considered to be identical to "Lego Retail Pte Limited" notwithstanding the commonality of LEGO.**

**However, the Registrar does allow the simultaneous registration of similar names where they feel that there will not be confusion. This element of "confusion" considered by the Registrar of Companies and Businesses however is a different test or certainly a different degree to that being used by the Registry of Trade Marks.**

The RCB evaluates the possibility of confusion in the context of debtors and creditors and consumers being confused as to the identity of the business entity. As such, where an industry identifier is added which brings it clearly out of the industry of a prior-registered company/business, and particularly where the distinctive part of the company/business name is itself not extremely distinctive, then often such a similar name is accepted.

In the earlier example, PRUDENTIAL is not a very distinctive name in any case, being a derivation of PRUDENT and PRUDENCE. As such the addition of PHOTO STUDIO or even MAID AGENCY is likely to be sufficient to distinguish these entities from the name of the well-known insurance company.

We have also encountered several instances where a business/company name using a well-known trade mark is nevertheless accepted where differentiators particularly indicative of a different industry are used.

The basic difficulty is that the test for confusion used by the RCB appears to be a somewhat less stringent one than that employed by the Registry of Trade Marks.

We are of the view that the RCB ought to use the same test of confusing similarity as used by the Registry of Trade Marks and that the officers involved in the approval of such company/business names ought to be provided with additional training in this regard having regard to the importance of trade names and its impact on trade mark rights.

In order to effect this, the Registers of Trade Marks and that of the Companies and Businesses ought also to be linked.

Immediately therefore, a practical difficulty will surface since the Register of Trade Marks is divided into the different trade mark classes. It is known also that it is possible for identical or similar trade marks (apart from well-known marks) to co-exist without confusion for different goods and services.

II) whether the activities of the company should be taken into account in order to evaluate the similarities of paragraph I) above.

**Yes, see however the difficulties outlined in the paragraph above.**

III) How do you envisage coordinating the criteria on similarities to be applied by the Register of Companies and/or Business names for accepting or rejecting new Company or business names and the Trademark Office and/or the Courts when deciding on similarity between trademarks?

The Registry of Companies and Businesses requires the applicant to indicate at the time of applying for the company or business name, the field of activity that it is to be engaged in. However the company/business is not limited to one field of activity, nor are these fields of activity classified at the moment in any sort of system that will make it easily searchable as against the trade mark classification system. Nor is a company or business prohibited from increasing or diversifying such fields of business activities when it desires to do so, provided it is contained within the ambit of the M&A. And in any event such M&A can be amended easily by the company.

It is therefore necessary for additional measure to be taken to co-ordinate the 2 classification systems to facilitate such cross-referencing. It is also necessary to monitor future diversification of business activities to prevent causing confusion in the sense of overlapping areas of business where no such confusion existed at the time of registration of the trade mark or business/company name. It is also necessary to implement measures for trade marks to be checked against the business/company name registrations in the course of examination of the applications.

**One issue will be whether to allow such changes/expansion in business activities where confusion may be caused. On the one hand it is desirable that IP rights are adequately protected. On the other hand it is also not desirable for the economy of any country to stifle business diversification and growth unwontedly.**

**The need therefore is to strike a reasonable balance between the two.**

- IV) Should the Register of Companies and/or Business names consult the database of trademarks of the Trademark Office for examination of new company or business names?

**Yes, see however the difficulties outlined in the paragraph above.**

- e) Once a company or business name has been adopted, how do you believe conflicts with trademarks should be solved?

- i) By the same rules and proceedings applied to conflicts between trademarks;

**It appears that the legal concepts applicable to the resolution of conflicts between trade marks are better developed under existing trade mark laws as compared to legal concepts applicable to the resolution of conflicting company or business names under company law. To resolve conflicts between the uses of company or business names and trade marks, it may be necessary to harmonize the manner in which conflicts are resolved within each individual branch of the law concerned. One example is the concept of a "well-known mark" that is recognized as a relative ground of refusal of registration of a trade mark. However, a similar ground of refusal is not found in the Companies Act.**

**Amendments to existing legislation governing the registration of companies and businesses may be necessary.**

- ii) By other means (please specify).

- f) Do you see any parallelism with conflicts between trademarks and Internet domain names? If so, how do you suggest trying to unify the way in which these problems are to be solved?

**Yes, there is some parallelism with conflicts between trademarks and Internet domain names to the extent that similar issues on confusion as to origin or dilution of trademarks or unfair competition are also raised in conflicts between company or business names and trademarks. However one should bear in mind that domain names are accessible internationally and as such issues on jurisdiction must be resolved and addressed. In comparison, the issue of jurisdiction does not arise in the case of company or business names since they are localized in that they must be registered within a particular jurisdiction. The approach to resolving these conflicts may thus be different for domain names and trademarks as compared to company or business names and trademarks. In the case of conflicts between company or business names and trademarks, changes in the national laws may adequately address the issue but in the case of domain names and trademarks, international consensus are important to reduce potential disparities in national laws that will render enforcement of rights difficult, if not impossible.**