

The battle of “MiChat” vs “MiTalk”

Case Brief: *Xiaomi Inc v MiChat Pte Ltd* [2021] SGIPOS 2

Introduction

- The recent decision of the Registrar of Trade Marks (the “Registrar”) in *Xiaomi Inc v MiChat Pte Ltd* [2021] SGIPOS 2 (“*Xiaomi v MiChat*”) saw the battle between the mark “MiChat” against “mitalk” wherein the Registrar decided that the latter was more similar than dissimilar to the earlier mark, hence the latter mark should not be allowed registration.

Key Takeaways

- We summarise the key takeaways from *Xiaomi v MiChat* as follows:
 - Highly stylistic marks that may not be perceived by word(s) may be rendered more dissimilar than similar when compared to legible word marks;
 - Some differences between trademarks that possess a moderate (i.e. “not high”) level of technical distinctiveness may be sufficient to render them more dissimilar than similar; and
 - Since the relevant consumers would not pay much attention when downloading or purchasing mobile applications, they are likely to perceive mobile applications bearing similar trademarks as emanating from the same source or from sources that are economically linked.

Background



- The Applicant, MiChat Pte Ltd (“MiChat”), sought to register the following trademarks:

S/N	Application No.	Trademark	Class(es)
1	40201810931X-01 (“Application Mark 1”)	MiChat	9 and 42
2	40201810931X-02 (“Application Mark 2”)	MiChat	38 and 45


(collectively, the “Application Marks”)


- The Opponent, Xiaomi Inc (“Xiaomi”), opposed the registration of the Application Marks. One of Xiaomi’s main grounds of opposition was under section 8(2)(b) of the Trade Marks Act (the “TMA”).
- In order for Xiaomi’s opposition under section 8(2)(b) of the TMA to succeed, Xiaomi had to establish that:
 - The Application Marks are similar to one of its earlier trademarks;
 - The goods and/or services in the Application Marks are similar to the goods and/or services in that earlier trademark; and
 - As a result of (1) and (2), there exists a likelihood of confusion on the part of the public.

6. Xiaomi relied on, among others, its following earlier trademarks:


S/N	Application No.	Trademark	Class(es)
1	T1219547G		9, 35 and 42
2	T1310968Z		3, 5, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 30, 34, 35, 36, 38, 41, 42, 43 and 45

The Registrar's Decision


7. At the outset, the Registrar was of the opinion that Xiaomi's earlier "" trademark is evidently more dissimilar than similar to the Application Marks on the grounds that it is so stylistic that it may not even be perceived solely as the word "mi" by the average consumer.


8. Thus, the focus of the trademark opposition proceedings was on Xiaomi's earlier "" trademark.

A. Similarity of Trademarks


9. The Registrar concluded that the Application Marks are visually, aurally and conceptually more similar than dissimilar to Xiaomi's earlier "" trademark.


10. In arriving at this conclusion, the Registrar considered the evidence and was of the opinion that on the one hand, the "mi" component is not so uncommon that it should be granted any additional protection that is usually reserved for trademarks that are technically distinctive.

11. On the other hand, the "mi" component is also not so common that MiChat is entitled to cross a lower threshold of alteration to render the Application Marks more dissimilar than similar to Xiaomi's earlier "" trademark.

12. In other words, the "mi" component has a moderate (i.e. "not high") level of technical distinctiveness such that some differences between the Application Marks and Xiaomi's earlier "" trademark may be sufficient to render them more dissimilar than similar.

B. Similarity of Goods and/or Services

13. The Registrar held that it is obvious that the goods and/or services in Application Mark 1 (Classes 9 and 42) are similar to the goods and/or services in Xiaomi's earlier "" trademark because there is some overlap between them.

14. For example, "computer software applications, downloadable" in Application Mark 1 (Classes 9 and 42) is similar to "recorded computer software" and "downloadable software, namely computer programs" in Xiaomi's earlier "" trademark.

15. However, the Registrar held that for Application Mark 2 (Classes 38 and 45), the element of similarity of goods and/or services is not satisfied because while the services in Classes 38 and 45 are related to the goods in Class 9, they are clearly not substitutes.

C. Likelihood of Confusion

16. The Registrar considered that on the one hand, mobile applications are generally downloaded or purchased for a specific function such that there would be some degree of care and attention exercised by the relevant consumers.
17. On the other hand, since mobile applications are generally free or inexpensive to download, the relevant consumers would not pay much attention when downloading or purchasing mobile applications.
18. Overall, the Registrar was of the opinion that the effect of mobile applications being generally free or inexpensive to download takes precedence over the fact that mobile applications have specific functions.
19. Thus, the Registrar concluded that on balance, there exists a likelihood of confusion on the part of the public that the Application Marks and Xiaomi's earlier "mitalk" trademark emanate from the same source or from sources that are economically linked.
20. In light of the above, Xiaomi's opposition under section 8(2)(b) of the TMA succeeded in relation to Application Mark 1 (Classes 9 and 42) but failed in relation to Application Mark 2 (Classes 38 and 45).

Conclusion

21. In light of *Xiaomi v MiChat*, trademark proprietors, especially mobile application developers, seeking to register a trademark should be well-advised to conduct trademark searches to ascertain whether there are any earlier trademarks that may pose as an obstacle to the registration of the intended trademark.
22. If a trademark search reveals similar earlier trademarks, it would be unwise to proceed with registering the intended trademark without evidence, such as a market survey, that there does not exist a likelihood of confusion between the intended trademark and those similar earlier trademarks.

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