formerly known as Haq & Selvam

Welcome to our September 2010 Newsletter on Trade Marks.

We hope you will enjoy it as a useful resource for matters relevant to Singapore. Below is a synopsis of some interesting decisions held in Singapore.

The cases of *The Polo/Lauren Co, LP* v *Shop-In Department Store Pte Ltd* [2006] and *Novelty Pte Ltd* v *Amanresorts Ltd and another* [2009] presented some new developments on the scope of protection rendered to well-known trade marks, how a likelihood of confusion is assessed and a closer look at the principles to establish passing-off of a trade mark. Recent decisions in 2009 and 2010 demonstrates that the Courts and the Intellectual Property Office of Singapore ("IPOS") take a strict, but practical, approach in assessing these claims including assessing extraneous factors such as a trade practices, how the marks of the respective parties are actually used in commerce and whether confusion, misrepresentation and damage is likely to occur in a business sense. The cases below reflect the Court and IPOS's view on these issues.

(i) A case of "HYSTERICAL GLAMOUR"

Ozone Community Corp ("OCC") v Advance Magazine Publishers Inc ("AMP") [2010]

In this case, the proprietors of the well-known "GLAMOUR" trade mark could not prevent the registration of "HYSTERICAL GLAMOUR" for identical and similar goods.

OCC applied for the trade mark "HYSTERICAL GLAMOUR" for goods in class 16 including printed matter. "AMP" the registered proprietor for the "GLAMOUR" trade marks, opposed OCC's application. AMP's mark is the name of a fashion magazine. The Principal Assistant Registration found in AMP's favour as both trade marks appealed to the "glamour" concept and covered an overlapping range of goods.

The High Court held on appeal that the marks were visual distinguishable and AMP's mark was not particularly distinctive in relation to the goods. Apart from "printed matter", OCC's other goods, which were primarily paper products and stationery, were dissimilar to AMP's goods. The High Court considered that the average Singaporean would have little difficulty in discerning that OCC's "HYSTERIC GLAMOUR" goods did not originate from the same source as AMP's "GLAMOUR". As for AMP's claim of passing-off, the High Court held that AMP did not demonstrate significant volume of sales and "GLAMOUR" trade mark had acquired a "secondary meaning" through such limited use. Goodwill was not established and the claim of passing-off failed.

(ii) LV's Quatrefoil mark is not well-known on its own; decision reversed on Appeal

Louis Vuitton Malletier ("LV") v City Chain Stores (S) Pte Ltd ("CC")[2009]

CC appealed against the High Court's decision which found in favour of LV on the basis that CC's Solvil flower device infringed LV's Flower Quatrefoil trade mark. CC's Solvil flower was not identical to LV's Flower Quatrefoil, however, it was similar. The issue before the Court of Appeal was whether there had been trade mark infringement, whether the claim of passing-off had been established and whether the provisions concerning the protection of well-known trade marks had been breached.

The Court considered that infringing use had to be trade use. The prominent use of CC's Solvil flower was for decorative use only and not use as a trade mark. Neither the target consumer nor the general public would confuse the marks because of the distinct overall appearances of how the parties used the marks, the different location of the stores and LV's restriction of sales of its goods by other retailers. The goods of the respective parties would not be sold in the same outlets.

Goodwill and reputation for LV's Flower Quatrefoil trade mark was established. On the issue of misrepresentation, the perspective of the average consumer would have to be considered (as above). Misrepresentation was unlikely. The Court held that LV's Flower Quatrefoil trade mark was not well-known on its own as it was always used with the famous LV Monogram . The Court considered it unlikely that the Flower Quatrefoil had acquired its own distinctive to function as a badge of origin. CC's appeal was allowed.

(iii) "MOBIL" and "MOBIS" for related goods are not confusable

Mobil Petroleum Company Inc v Hyundai Mobis [2009]

Mobil appealed against the decision of the High Court. Hyundai applied to register the "MOBIS" trade mark for automobile apparatus and equipment, parts and fittings for automobiles. Mobil is the registered proprietor of 26 trade mark registrations consisting of "MOBIL" on its own and as a composite element of trade mark.

The issue before the Court of Appeal was, whether "MOBIS" was likely to indicate a "connection" to "MOBIL", thereby giving rise to a likelihood of confusion and damage to the interests of Mobil. It was undisputed that "MOBIL" was a well-known trade mark. However, a connection was not established- a mere association between "MOBIL" and "MOBIS" was not sufficient to meet this requirement. There was no confusion as the Court of Appeal considered the trade channels of the parties were different. The average consumer who saw "MOBIS" automobile parts would be slow to confuse them with "MOBIL". As a result of these differences, Mobil would not have suffered from a diversion of sales and "MOBIS" would not have restricted the ability of Mobil to expand the use of their trade mark. There was no "damage" per se and the High Court's decision was upheld.

(iv) Use at product launch is not sufficient to demonstrate that a trade mark is well-known.

Chery Automobile Co Ltd ("Chery") v Tencent Holdings Limited ("Tencent") [2010]

Tencent applied to register "QQ" for automobiles and other goods in class 12. Chery is the fourth largest passenger vehicle manufacturer in China. They have a "QQ" model of cars which was launched in Singapore in July 2006. They did not have a trade mark registration in Singapore. Chery claimed their "QQ" trade mark was well-known based on their

extensive sales at the time of the launch in Singapore. Chery also claimed Tencent had applied for their “QQ” trade mark in bad faith.

The Registrar considered that there should be an element of dishonesty or dealings which fall short of acceptable commercial standards of behavior in order for a claim of bad faith to succeed. There was insufficient evidence to demonstrate this. The fact that Tencent had knowledge of Chery’s mark since 2003 was not a sufficient basis to conclude that the mark was applied in bad faith.

The Registrar also concluded that the sales of Chery’s “QQ” model cars in Singapore (270 automobiles) was not sufficiently wide for her to reach a finding that their mark was well-known. The claims of a likelihood of confusion, that Tencent’s mark would indicate a connection to Chery’s goods thereby causing damage, also failed. Chery claimed passing-off by virtue of the law of copyright. The Registrar concluded that the mark was not a literary work and therefore not a subject matter protectable under copyright.

(v) How “RAFFLES” composite marks would be viewed in Singapore.

Raffles Fine Arts Auctioneers Pte Ltd (“RFA”) v Raffles Corporate Consultants Pte Ltd (“RCC”) [2010]

RCC are the registered proprietors of the “RAFFLES” marks in classes 35 and 36 for services relating to financial consultancy and business management. RFA filed a Declaration of Invalidity based on their unregistered trade mark rights in “RAFFLES” and “RAFFLES FINE ARTS”. RFA achieved a reputation in art auction sales services. They commenced use of their marks in November 1992 and the marks are used on their advertising materials and stationery. RFA made a claim of passing-off against RCC’s marks.

The Registrar found that “RAFFLES FINE ARTS” was distinctive of RFA’s services but not “RAFFLES” on its own. RFA was required to tender evidence of sales volume and extent of advertising. As RFA’s use was limited to some 30 transactions amounting to $165,000 over an 8 year period and there was no evidence of publicity, there was insufficient goodwill to support the claim of passing-off.

As for misrepresentation, the Registrar considered the general public in Singapore would be accustomed to names incorporating “RAFFLES” since this is the name of the founder of Singapore. The public would be more discerning of marks consisting of this word and would focus on dissimilar aspects of the marks instead. Confusion between RFA’s and RCC’s mark is remote. As goodwill and misrepresentation were not made out, there was no need to consider the issue of damage and the claim of passing-off failed.

(vi) Likelihood of confusion- similarities that outweigh visual dissimilarities leading to a likelihood of confusion

Festina Lotus v Romanson Co Ltd [2010]

Festina is the registered proprietor for various “FESTINA & crest device” composite trade marks. Their registrations covered various classes including class 14. Romanson applied to register “J.ESTINA & crown device” for goods in class 14. The Principal Assistant Registrar found in favour of Romanson on the issue of a likelihood of confusion. An appeal was filed IN the High Court.

The High Court considered that the marks were visually distinguishable. However, there were some conceptual similarities in that both marks consisted of non-English words and that the respective “crown” and “crest” devices denoted

“class” or “status”. The marks were also found to be aurally similar. The goods of the parties were also similar or would be marketed through the same channels. In view of these findings, the Court held that the likelihood of confusion was a probability and not just a possibility. Festina’s claim of bad faith was also considered. The failure of Romanson to provide the Court with a credible explanation of how the “ESTINA” element was derived, led to the conclusion that Romanson blatantly copied Festina’s mark. This fell short of acceptable standards of commercial behavior, particularly considering that both parties were engaged the same trade and had competing businesses.

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with best regards,
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