

IN THE MATTER OF TRADE MARK APPLICATION T0720701B BY

NG WEE PING

And

OPPOSITION THERETO BY

S.TOUS, S.L.

Before Principal Assistant Registrar Ms Lee Li Choon



25 June 2010

Trade Marks – *Opposition to registration – whether the application should be refused registration in classes 14, 18 and 25 as the Application Mark is similar to the Opponents' mark which is an earlier trade mark and the Application Mark is to be registered for goods similar to those for which the earlier trade mark is protected and there exists a likelihood of confusion on the part of the public - Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Revised Edition)*

Trade Marks – *Opposition to registration – whether the Application Mark is similar to the Opponents' earlier trade mark that is well known in Singapore and whether the use of the Application Mark in relation to the goods for which the Application Mark is sought to be registered would indicate a connection between those goods and the Opponents and is likely to damage the interests of the Opponents - Section 8(4) of the Trade Marks Act (Cap 332, 2005 Revised Edition)*

Trade Marks – *Opposition to registration – whether in view of the long and extensive use of the Opponents' mark and other variants in relation to the Opponents' goods, there is substantial goodwill and reputation subsisting in the Opponents' marks such that the use or proposed use of the Application Mark in respect of the proposed specification is likely to mislead the public into believing that the Applicant's goods originate from or are somehow associated with the Opponents when there is none, causing damage to the Opponents' business and goodwill and as such, the registration is liable to be prevented in Singapore by virtue of the law of passing off – Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Revised Edition)*

This is an opposition against the trade mark application T0720701B by Ng Wee Ping for

the device mark,  as a series of 2 marks (the representation of the 2 marks in series is as follows: ) in classes 14, 18 and 25 for use on:

Class 14

Goods made of precious metals, their alloys or plated therewith, in particular, ornamental objects, boxes and cases, powder compacts; jewellery, jewellery articles (including fashion jewellery) in particular, rings, rings for keys, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, ornamental pins, medallions; timepieces and chronometric instruments including watchstraps, watches, wristwatches, pendulum clocks, pendants, alarm clocks, caskets and cases for timepieces.

Class 18

Leather and imitation leather; travelling bags, travelling sets (leather goods), trunks and suitcases, garment bags for travel purposes, vanity cases, backpacks, shoulder bags, handbags, attache cases, document holders and briefcases of leather, clutch bags, wallets, purses, key cases, card cases; umbrellas.

Class 25

Clothing and underwear including sweaters, shirts, tee-shirts, lingerie, belts (clothing), scarves, neckties, shawls, vests, skirts, raincoats, overcoats, suspenders, trousers, denim trousers, pullovers, dresses, jackets, sashes for wear, gloves, tights, socks, bathing suits, bath robes, pajamas, nightshirts, shorts, pockets (clothing); shoes, boots, slippers; headgear.

The Opponents was established in Manresa, Spain in 1920. In or around 1985, an employee of the Opponents came up with a drawing of a bear design which subsequently became known as the “TOUS Bear” mark and symbol of the Opponents. The Opponents’



“TOUS Bear” mark looks like this : . In addition, the Opponents have earlier registrations (T0315786Z, T0315787H, T0315788F) all dated 7 May 2003 for the bear



mark, in respect of the following goods:

Class 14 : Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewelry, precious stones; timepieces and chronometric instruments.

Class 18 : Bags, wallets and key holders of leather.

Class 25 : Clothing, footwear, headgear and belts (clothing).

The Opponents also have an earlier registration for the same “TOUS Bear” mark in class 9 in respect of “spectacles and spectacle frames” in Singapore. The Opponents’ jewellery products bearing the “TOUS Bear” mark were sold soon after 1985 in Spain. As the Opponents’ business grew, the Opponents’ range of products expanded from jewellery to other accessories such as bags, small leather articles, gloves, shawls, glasses, perfumes, chinaware and watches. The “TOUS Bear” mark appears on many of the Opponents’ products. The Opponents have an international presence with numerous distributors and more than 300 points of sale worldwide. In particular, the Opponents have numerous retail stores in Hong Kong, Japan, Korea and China.

As for use in Singapore, the Opponents have been using the “TOUS BEAR” mark since at least 2002. In addition, the Opponents have also established an online store “TOUS shops” in the US, Puerto Rico and Canada. The “TOUS BEAR” mark has been advertised worldwide, including in Italian Vogue which is available in Singapore from major bookstores and newsstands, and in Ronda Iberia, which is the in-flight magazine of the Spanish national airline Iberia which flies to Singapore. The Opponents have also registered the “TOUS BEAR” mark in at least 50 countries such as the US, UK, Korea, Hong Kong, Italy, Australia and Japan.

Held, allowing registration:

1. The Application Mark and the Opponents’ mark are visually dissimilar and



distinguishable from each other. The Opponents’ earlier trade mark, consists of a unique design of a teddy bear with rather distinctive and memorable features such as facial features comprising of three dots and chubby, short lower limbs. The overall





impression of the Opponents’ earlier trade mark, is that of a cute, bloated-bodied creature with distinctive and memorable features and a three-dimensional





appearance. The Application Mark, on the other hand, appears flatter and two-dimensional. It is also a silhouette and has no facial or bodily features. Although the two marks are conceptually and aurally similar, aural and conceptual similarity between the two marks is not the most important factor. In this case, the question whether the marks are on the whole similar depends more on their visual similarity. As the marks are visually dissimilar, the marks are therefore, overall, dissimilar. It is also clear that the goods are similar. On the question of likelihood of confusion, from common knowledge as well as from the Register, it is clear that the device of a bear or a teddy bear is quite commonly used either as a trade mark or as an element (ornament, motifs, charms) as far as trade in goods in Classes 14, 18 and 25 are concerned. As consumers are inundated with marks that bear the shape of a bear or a teddy bear, it is likely that they will exercise a little more care and will not be quick to draw the conclusion that the goods with

different-looking “teddy bear” marks come from the same commercial undertaking simply because the concept of a teddy bear is used in the marks. Thus, there is no real likelihood of confusion amongst the public. Therefore, the opposition under Section 8(2)(b) of the Trade Marks Act (Cap 332) 2005 Revised Edition fails.

2. As the Application Mark and the Opponents’ marks are dissimilar, the opposition under Section 8(4) of the Trade Marks Act (Cap 332) 2005 Revised Edition also fails. In any

event, the Opponents failed to prove that their marks,  or  is well known in Singapore.

3. Whilst the Opponents have shown that there is goodwill associated with the

 or  mark, there is no misrepresentation as the Application Mark and the Opponents’ marks are not similar and there is also no likelihood of confusion amongst the public that the Applicant’s goods and the Opponents’ goods originate from the same source. Therefore, the elements for passing off have not been made out and the opposition under Section 8(7)(a) of the Trade Marks Act (Cap 332) 2005 Revised Edition fails.

Provisions of legislation discussed:

Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 8(2)(b), 8(4), 8(7)(a).

Cases referred to:

The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] 2 SLR(R) 690
The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR(R) 816
MediaCorp News Pte Ltd v Astro All Asia Networks PLC [2009] 4 SLR(R) 496
Caterpillar Inc v Ong Eng Peng (formerly trading as Catplus International) [2006] 2 SLR(R) 669
Newmans Chocolate Ltd v Societe Produits Nestle SA [2003] SGIPOS 2
Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp) [2007] 1 SLR(R) 1082
Goldlion Enterprises (Singapore) Pte Ltd v Baume & Mercier SA [2005] SGIPOS 10
British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
Novelty Pte Ltd v Amanresorts Ltd and Another [2009] SGCA 13
Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] 1 SLR(R) 903
WILD CHILD Trade Mark [1998] RPC 455

Representation:

Mr Ng Wee Ping in person for the Applicant

Mr Paul Teo and Ms Joanna Lim from Drew & Napier LLC for the Opponents