

IN THE MATTER OF REGISTERED TRADE MARK NO T07/04281A
IN THE NAME OF
IC COMPANYS A/S

AND

APPLICATION FOR DECLARATION OF INVALIDITY THEREOF BY
CBR TEXTILE GMBH

Before Principal Assistant Registrar Sandy Widjaja

13 April 2010

Trade Marks – *Application for invalidation – whether the Application mark satisfies the definition of a trade mark in Section 2(1) - Section 7(1)(a) read with section 23 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Application for invalidation – whether the Application mark is devoid of any distinctive character - Section 7(1)(b) read with section 23 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Application for invalidation – whether the Application mark consists of exclusively of signs or indications which may serve, in trade, to designate the characteristics of goods or services - Section 7(1)(c) read with section 23 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Application for invalidation – whether the Application mark consists of exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade - Section 7(1)(d) read with section 23 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

Trade Marks – *Application for invalidation – whether the application to register is made in bad faith - Section 7(6) read with section 23 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.*

IC Companys A/S is the registered proprietor (“Registered Proprietors”) of the trade mark registration number T07/04281A (International Registration No. 792497) as shown below:

COMPANYS

with respect to the following services in Class 35:

“Advertising; business management; business administration; office functions; retail services in relation to clothing, footwear, headgear, bags, and leather goods, sunglasses, spectacles, perfumery, watches and jewellery; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet”.

The date of the subsequent designation is 4 September 2006.

The Applicants, CBR Textile GmbH, (“Applicants”) applied for a declaration of invalidity of the Registered Mark on 4 November 2008. The Applicants and their related companies own and operate fashion retail outlets under the name and trademark “CBR COMPANIES” throughout the world. The Applicants’ “CBR COMPANIES” retail outlets are multi-label concept stores which appeal to a large target group and provide trendy merchandise to women.

The Registered Proprietors are a group of companies formed in 2001 by the merger of Carli Gry International A/S and InWear Group A/S and is listed on the Denmark stock exchange. It is the Registered Proprietors’ evidence that they rank among the largest clothing companies in Northern Europe with close to 2500 employees. There are sales companies in 16 countries and the Registered Proprietors own a portfolio of independent brands. Goods under these brands are sold in the Registered Proprietors’ retail and franchise stores and via more than 12,000 distributors in more than 40 countries.

The Applicants relied on Section 23(1) read with Sections 7(1)(a), (b), (c), (d) and Section 7(6) of the Act and Rules 5(1) and 18 of the Trade Marks (International Registration) Rules.

Held, allowing the application mark to proceed to registration:

1. In relation to the ground of invalidation under Section 7(1)(a), applying the genericisation test above, the Registered Mark ie COMPANYS cannot be said to be synonymous with the services claimed, namely *“Advertising; business management; business administration; office functions; retail services in relation to clothing, footwear, headgear, bags, and leather goods, sunglasses, spectacles, perfumery, watches and jewellery; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to*

- conveniently view and purchase those goods from a retail outlet*” when it is not even a word with a known meaning nor is it a common misspelling.
2. Under the ground of invalidation under Section 7(1)(b), English is commonly spoken in the local scene. Thus in relation to the word “COMPANY”, it is commonly understood that the plural version is not obtained by merely adding the letter “S” at the end but with the removal of “Y” and the addition of “IES”. In view of this, COMPANYS is not a common misspelling of COMPANIES. Instead, COMPANYS is a clear misspelling COMPANIES to the extent that the relevant consumers who are reasonably well informed and reasonably observant and circumspect would be able to perceive the difference between COMPANYS and COMPANIES. Thus the addition of “S” to COMPANY would cause the Registered Mark as a whole to be perceptibly different from COMPANY or COMPANIES and provide sufficient inherent distinctive characteristic to the Registered Mark as a whole.
 3. In relation to the ground of opposition under Section 7(1)(c), the Registered Mark ie COMPANYS does not consists exclusively of descriptive matter in relation to the services claimed. While COMPANY / COMPANIES are dictionary words, COMPANYS is not. With the addition of S to COMPANY, the Registered Mark does not describe / designate any specific character of the services claimed. At most it merely evokes ideas including that the services claimed are provided by companies for companies.
 4. Under the ground of invalidation under Section 7(1)(d), the words which are commonly utilized by traders in relation to Class 35 services are COMPANY and COMPANIES only. It is also COMPANY / COMPANIES which can be found in the dictionary and not COMPANYS. Bearing in mind that the provision sets a high hurdle and that there is a need for a sufficiently convincing body of evidence, this ground of invalidation is not made out.
 5. With respect to the ground of invalidation under Section 7(6), there is no conclusive evidence that the Registered Proprietors have no intention to use the Registered Mark as registered in Singapore. It is to be remembered an allegation of bad faith is a serious one and should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference. Thus it is not sufficient to claim that the Registered Proprietors’ choice of mark is made in bad faith merely on the basis that it is similar to the word COMPANIES. Finally, the fact that the Registered Proprietors brought an application for interlocutory injunction against the Applicants in the Swiss Court also cannot be considered as conclusive evidence of bad faith since it is rather speculative to infer that the Registered Proprietors will bring about actions against other traders in Singapore on that basis.

Provisions of legislation discussed:

Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 7(1)(a), (b), (c), (d), Section 7(6) and Section 23(1).

Cases referred to:

Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal [2009] 2 SLR(R) 814
Kopitiam Investment Pte Ltd v RC Hotels (Pte) Ltd [2008] SGIPOS 8
Electrix Ltd v Electrolux Ltd [1959] 3 W.L.R. 503
Kwik Kopy TM [1982] RPC 102
Kellogg Co v Pacific Food Products Sdn Bhd [1998] 3 SLR(R) 904
Love & Co Pte Ltd v The Carat Club Pte Ltd [2009] SLR (R) 561
AD2000 Trade Mark [1997] RPC 168
Newmans Chocolates Ltd v Societes des Produits Nestle SA [2003] SGIPOS 2
Premier Luggage and Bags Ltd v The Premier Company (UK) Ltd [2001] FSR 29
British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
In re Ripley & Son's Trade Mark 14 TLR 299
Froot Loops Trade Mark [1998] RPC 240
Uni-Charm Corporation v The Procter & Gamble Company [2003] SGIPOS 12
Nation Fittings (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR 712
Procter & Gamble Company's Application (Complete) [1999] ETMR 664 (OHIM Third BoA)
Nichols Plc's Trade Mark Application [2003] RPC 16
Nichols Plc v. Registrar of Trade Marks [2005] RPC 12
Societe des Produits Nestle SA v Nutricia International BV [2009] SGIPOS 6
Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Case C-363/99)
Viacom International Inc v Gary Lee Ongkowitzjaja [2004] SGIPOS 9
West (T/A Eastenders) v Fuller Smith & Turner PLC [2002] FSR 55
West (T/A Eastenders) v Fuller Smith & Turner PLC [2003] EWCA Civ 48
Dart Industries Inc. v OHIM (Case T-360/00)
Societe des Produits Nestle SA v International Nutrition Co Ltd A/S [2005] SGIPOS 20
Re an Application for a mark "MAKES LIFE Better" by Aki Habara Electric Corporation Pte Ltd [2004] SGIPOS 13
Hormel Foods Corp v Antilles Landscape Investments NV [2005] RPC 28
Merz & Krell GmbH & Co [2002] ETMR 21
Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
Harrison v Teton Valley Trading Co Ltd [2004] 1 WLR 2577
Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR(R) 551
Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR(R) 1073
Ferrero SpA's Trade Marks [2004] R.P.C. 29
PT Swakarya Indah Busana v Dhan International Exim Pte Ltd [2009] SGHC 280
McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR(R) 177
Royal Enfield Trade Marks [2002] RPC 24
AJIT Weekly Trade Mark [2006] RPC 25
Barlow Clowes International Ltd v Eurotrust International Ltd [2005] UKPC 37
Twinsectra Ltd v Yardley [2002] 2 AC 164

Representation:

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Ms. Ngoi Soon Hui (Drew & Napier LLC) for the Registered Proprietors