

**In The Matter Of Application No. 2913/91  
By Interlicence And Distribution Ltd  
To Register A Trade Mark In Class 25**

**And**

**Opposition By Dorgi Manufacturing Pte Ltd**

*Before Assistant Registrar Wendy Chang  
9 February and 7 April 1999*

**Trade Mark** - Application for registration - Opposition - Registration under s 10 - Relevance of prior registration and use - Likelihood of confusion or deception - Allegation of passing off - Application allowed

Interlicence and Distribution Ltd applied for registration of the word VUARNET in Part A of the register in Class 25 in respect of "Men's, women's and children's clothes, namely: tights, socks, undergarments, singlets, tee-shirts, shirts, blouses, trousers, bermuda shorts, shorts, skirts, jupe-culottes, pullovers, waistcoats, sweaters, gabardines, raincoats, coats, overcoats, jackets, waist-high jackets, bath robes, dressing gowns, pyjamas, aprons, overalls, uniforms, scarves, silk scarves or head scarves, gloves, belts, swimming suits, boots, slippers, shoes, including sports shoes, shoe soles, headbands, hats, caps, peak caps, brimless caps". Dorgi Manufacturing Pte Ltd opposed the registration under sections 10, 12(1), 15 and 23 of the Trade Marks Act (Cap. 332, 1992 Rev. Ed.) (the Act). The opponents also alleged that registration of the applicants' mark would facilitate passing off.

The opponents contended that since they had prior registration of the trade mark "du VERNET" and device of three horizontal bars in Class 25 for "men's shirt, polo shirt, slack" and in view of their long and extensive use of the mark in Singapore, use of the applicants' mark would be likely to deceive or cause confusion and the applicants' mark could not be distinctive of the applicants' goods.

The applicants argued that there would be no confusion or deception as the marks were visually and phonetically dissimilar. Their mark was the patronymic name of Mr Jean Vuarnet, a famous French ski champion. The applicants had goodwill and reputation in their mark and were not taking unfair advantage of the opponents' purported reputation or goodwill.

**Held, allowing registration:**

- As long as the mark for which registration was applied for satisfied the conditions of section 10 of the Act, it qualified for registration under that section. The possibility of confusion arising from a normal and fair use of the opponents' and applicants' marks was properly to be considered under sections 15 and 23, not section 10.
- The fact that the opponents had established use and reputation in their mark did not go to show that the applicants were not the proprietors of their mark. The opposition based on section 12(1) failed.
- The marks were visually and phonetically distinguishable. Further, consumers would not speak so hurriedly or carelessly when buying clothing as to lead to a real tangible danger of confusion. The purchase of clothing would be attended by the degree of personal attention consistent with it being an item of personal adornment. There would be ample opportunity for the purchaser to be exposed to both the visual and phonetic aspects of trade marks before making a purchase. Under these circumstances, it was unlikely that the ordinary purchaser would be so careless as to mistake the applicants' mark for the opponents'. The opposition based on sections 15 and 23 failed.
- Passing off was a separate and distinct action from opposition proceedings. The issue of passing off was not considered in opposition proceedings. It was also not within the Registrar's jurisdiction to make a decision on the tort of passing off.

**Provisions of legislation discussed:**

- Trade Marks Act (Cap. 332), 1992 Revised Edition, sections 10, 11, 12, 15 and 23

**Cases referred to:**

- Jellinek (1946) 63 RPC 59
- Smith Hayden & Co Ltd's Application (1946) 63 RPC 97
- Pianotist Co's Application (1906) 23 RPC 774
- Bali Trade Mark (1969) RPC 472
- Fitchetts Ltd v Larbet & Co Ltd
- De Cordova v Vick Chemical Co (1951) RPC 106
- Sandow (1914) 31 RPC 196
- Rysta (1943) 60 RPC 87
- Aristoc Ltd v Rysta Ltd (1945) 62 RPC 65
- Tiffany & Co v Fabriques de Tabac Reunies SA (1999, unreported)
- Ciba (1983) RPC 75

**Representation:**

- Adrian Tan (Drew & Napier) for the applicants;
- Gooi Chi Duan (Donaldson & Burkinshaw) for the opponents.