

**In The Matter Of Application No. 4863/93  
By Goh Aik Chew, Goh Aik How And Goh Aik Guan Trading As Broadway Leather Company**

**And**

**Opposition By Aigle S.A**

*Before Senior Assistant Registrar Nor' Ashikin Samdin  
25 May 2000*

**Trade Mark** - Application for registration - Opposition by registered proprietor of a similar mark containing identical French word - Whether the marks nearly resemble each other - Likelihood of deception and confusion - Whether goods are of the same description - Application disallowed

Broadway leather Company ( the Applicants ) applied for registration of a composite mark comprising the French word "AIGLE" and the device of an eagle in Class 18 in respect of attache cases, bags, bands of leather, beach bags, belts, boxes of leather or leather board, briefcases, canes, card cases, cases of leather or leather board, collars for animals, dog collars, frames, furniture, handbags, handles, harness, haversacks, leashes, leather, leather straps, music cases, pouches of leather for packaging, purses, not of precious metal, school bags, school satchels, shoes, shopping bags, shoulder belts of leather, sling bags for carrying infants, tool bags of leather, travelling bags, travelling trunks, trunks, umbrellas, walking sticks, wallets, wheeled shopping bags. The application was advertised in the Gazette on 21 March 1997.

The Opponents, a French company, were the registered proprietors of the composite mark comprising the French word "AIGLE" and the device of an eagle in Classes 18 and 25. The Opponents claimed that the mark was first used in France in 1853. The Opponents also claimed long and extensive use of the mark on leather and plastic boots in Singapore and around the region. By virtue thereof, the Opponents claimed that the Applicant cannot, pursuant to section 12(1) of the Trade Marks Act, Cap. 332 1992 Edition ( the Act), claim to be the bona fide proprietor of the mark for which registration is sought. The Opponents further submit that in view of the presence of the identical French word "AIGLE" in the application mark and the device of an eagle, registration and use of the said mark would be contrary to sections 23 and 15 of the Act respectively. The Opponents also submit that as the mark is not distinctive of the Applicants' goods, registration of the same would be contrary to section 10 of the Act.

The Applicants claim that as their application for registration in Singapore precedes the Opponents' application, it is registration of the Opponents' mark that is contrary to section 23 of the Act. The Applicants also counterclaimed that by virtue of their long and extensive use of the mark in Singapore, the application mark has become distinctive of the Applicants' goods.

**Held, disallowing registration:**

- The objection under section 23 fails as the Opponents, not being the registered proprietor of any "AIGLE" marks in Singapore, have no locus standi to oppose the mark under section 23.
- The goods in question, being leather belts and boots, are clothing or wearing apparel which are usually sold in the same section of departmental stores and therefore considered goods of the same description.
- The objection under section 15 succeeds as the marks are visually and phonetically confusingly similar. As the evidence adduced clearly establishes both reputation and use of the "AIGLE" mark by the Opponents, registration of the application mark would give rise to a real tangible danger of confusion and cause a substantial number of persons to wonder if the goods of the Applicants and the Opponents emanate from the same source.
- The use of the word "PARIS" in the application mark is deceptive as the Applicants' goods are neither manufactured nor imported from Paris. Such deceptive use therefore constitutes an offence under section 4 of the Consumer Protection Act, Cap. 53 1985 Edition and is contrary to law under section 15 of the Act.
- As the evidence adduced shows that the Opponents' use of the "AIGLE" mark pre - dates use of the application mark by the Applicants, and given the extensive use and reputation of the Opponents' mark in Japan and

Taiwan, two countries from which the Applicants imports their goods, a presumption arises in favour of the Opponents that the Applicants are likely to be aware of the Opponents' "AIGLE" mark and the goods on which it is used. The Opponents, a French company, by the same name, has established that their mark, which means "EAGLE" in English, was first used in Paris in 1853. The Applicants are a local business which no connection with France or Paris whatsoever. This renders their choice of the French word "AIGLE" even more suspect when they could have chosen the English equivalent instead, especially since no such word existed in the trade mark register. The deceptive use of the word "PARIS" in the Applicants' mark further taints the Applicants' claim to be the bona fide proprietor of the "AIGLE" mark. As the Applicant was did not even attempt to rebut the unfavourable presumption that they were not the bona fide proprietor of the "AIGLE" mark, the objection under section 12 succeeds.

- The section 10 objection fails as the application mark satisfies the requirements under the said provision. The considerations which apply under sections 15 and 23 do not apply to section 10 as Parliament could not have intended section 10 to be redundant.

**Provisions of Legislation Discussed:**

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

**Cases referred to:**

- Bali Trade Mark [1969] RPC 472
- Pianotist Co.'s Application [1906] 23 RPC 774
- Golden Jet [1979] RPC 19
- Players [1965] RPC 636
- Re Jellinek's Application [1946] RPC 59
- Smith Hayden [1946] 63 RPC 97
- Mustang Survival [1999, UK, unreported]
- Wally Whale [1999, UK, unreported]
- De Cordova v Vick Chemical Co [1951] RPC 106
- Sandow [1914] 31 RPC 196
- Aristoc Ltd v Rysta Ltd [1945] 62 RPC 65
- In the Matter of Playboy Pte Ltd [1999, unreported]
- Tiffany & Co. v Fabriques de Tabac Reunies SA [1999 unreported]

**Representation:**

- Ms Pamela Yeo ( M/s Low Yeap Toh & Goon ) for the Applicants
- Ms Gooi Chi Duan ( M/s Donaldson & Burkinshaw ) for the Opponents