

**In The Matter Of Application No. 2086/90
By Matsuda & CO
To Register A Trade Mark In Class 25**

And

**In The Matter Of Opposition Thereto
By Mario Valentino S P A**

*Before Assistant Registrar Chua Ser Ching
18 and 25 July 2001*

Trade Mark - application for registration - opposition - opponent has prior registrations - coexistence of opponent's mark with other similar marks - Trade Marks Act (1992 Revised Edition) s 12, 15 and 23(1).

The Applicant applied for the registration of a mark consisting of the words "Valentino Rudy" in respect of Class 25 goods. The Opponent is the registered proprietor of "Valentino" in Classes 25 and 18.

The Applicant claimed that no one has the exclusive right to "Valentino" as it is common in the market, as evidenced by the Opponent's coexistence with other similar marks.

Held, allowing the opposition:

- On the plain wording of s23, the Applicant's application is barred by the Opponent's earlier registration.
- The subject mark is confusingly similar to the Opponent's mark since it incorporates the whole of the Opponent's mark. The s15 ground of opposition is made out since the Opponent has a reputation in Singapore for the goods concerned.
- An appeal against the decision of the Assistant Registrar was heard on 10 January 2002 before the Honourable Judicial Commissioner, Tay Yong Kwang.
- The Court reversed the decision of the Assistant Registrar and directed that the application be accepted and the trade mark registered.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332, 1992 Revised Edition), Sections 12, 15 & 23(1).

Representation:

- Mr Lim Teng Leong (M/s Donaldson & Burkinshaw) for the Applicant;
- Ms Cecilia Girvin (Drew & Napier LLC) for the Opponent.