

**In The Matter Of A Trade Mark Application
Goldlion Enterprises(Singapore) Pte Ltd
To Register A Trade Mark**

And

Opposition Thereto By Baume & Mercier SA

*Before Principal Assistant Registrar Ms. Anne Loo
7 April 2005*

Trade Marks – Opposition to registration – whether the application mark is distinctive of the Applicants and is not capable of distinguishing the Applicants’ goods by reason of extensive use of the Opponents’ marks - Section 2(1) and 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected – Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the application mark is similar to an earlier trade mark and is to be registered for goods or services which are dissimilar to those for which the earlier trade mark is protected - Section 8(3) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4)(a) of the Trade Marks Act 1998 [Cap. 332]

The Applicants Goldlion Enterprises (S) Pte Ltd, filed the application for a series of 3 marks on the 16 November 2000, for the mark “JEAN MERCIER” 14 in respect of “Watches; clocks; tie clips; tie pins; buckles of precious metals; keychains; cufflinks; jewellery and costume jewellery; all included in Class 14 ”. The application was accepted for registration and advertised on 1 February 2002 for opposition.

The Opponents Baume & Mercier SA, lodged a Notice of Opposition against the trade mark application on the 31 May 2002. The Opponents are the registered proprietor of the mark “BAUME & MERCIER” marks in Class 14 in 174 countries and these marks have also been registered in Arabic, Cyrillic, Japanese and Korean characters.

The Opponents opposed the Mark on the basis that it does not fall within the definition of a trade mark under Section 7(1)(a) of the Trade Marks Act as it is a the Applicants’ mark is not distinctive of the Applicants and is not capable of distinguishing the goods of the Opponents by reason of extensive use of the Opponents’ marks. The Applicants’ mark having adopted one of the key essential features of the Opponents’ marks (“MERCIER”) is similar to the Opponents’ marks and given that the Applicants’ mark is to be registered for goods that are identical or similar to the goods covered by the Opponents’ marks in class 14, there exists a likelihood of confusion on the part of the public.

The Opponents’ claim that their marks are well-known marks in Singapore and the use of the Applicants’ mark on the goods for which the application mark is sought to be registered will indicate a connection between those goods and the Opponents. There will exist a likelihood of confusion on the part of the public as a result of such use and the interests of the Opponents are likely to be damaged by such use. This would be in contravention of section 8(3) of the Act. The Applicants’ mark being visually and phonetically identical or confusingly similar to the Opponents’ marks, and in view of the substantial goodwill and reputation acquired by the Opponents in their marks, the use or proposed use of the Applicants’ mark in respect of the goods applied for is likely to deceive and/or cause confusion and/or lead the Applicants’ goods being passed off as or mistaken as goods originating from the Opponents and be injurious to the goodwill and proprietary rights of the Opponents.

The Opponents also claim that the Applicants in choosing to register the mark “JEAN MERCIER” are seeking to take advantage of the Opponents’ earlier rights and reputation in the Opponents’ marks incorporating the word “MERCIER” and therefore the Applicants’ mark was not chosen in good faith.

Held, allowing registration

1. Section 7(1) does not require a finding that there is confusing similarity between one mark with another. The key issue under section 7(1) is distinctiveness. The Applicants' "JEAN MERCIER" mark is not a mark that lacks distinctiveness, devoid of distinctive character; and is not descriptive of the goods of the application. It is a sign capable of being represented graphically and capable of distinguishing the goods dealt with in the course of the Applicants' trade from the goods dealt with by the any other person. The ground of opposition under Section 7(1) failed.
2. The ground of opposition under Section 7(6) failed as it was not conclusive from the evidence or the submissions that there was bad faith by the Applicants. The assertions by the Opponents that there is bad faith by the Applicants when making the application for the "JEAN MERCIER" mark are not supported by any evidence of direct copying by the Applicants or by evidence of fraudulent or dishonest dealings. The Opponents' submission that the Applicants had known of their mark and were seeking to take advantage of the Opponents' reputation is but an inference that there is bad faith but which is unsupported by any evidence. An allegation of bad faith "... 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."
3. Although upon examination the wording of the specification of goods of the Opponents' registrations and of the Applicants' application the goods appear to be identical goods, the decision whether goods are identical or similar entails more than a mere comparison of the specifications of goods. Considering the factors such as the trade and marketing channels, the pricing of the goods and the consideration that the "average consumer, who is considered to be reasonably well informed and reasonably observant and circumspect", the goods are at best similar goods.
4. The marks are different visually, aurally and conceptually. The Opponents' mark "BAUME & MERCIER" are 2 words separated by an ampersand, giving the impression of a mark comprised of either 2 names or 2 separate words. The Applicants' mark is one of a proper name, a surname ("MERCIER") preceded by a forename ("JEAN"). The ampersand appearing in the Opponents' mark is enunciated as "and"; hence the Opponents' mark read as "Baume and Mercier" is aurally different from the Applicants' mark which is enunciated as "Jean Mercier". From the Opponents' evidence, the mark is consistently used in the form which comprises the word "BAUME" together with the ampersand sign ("&"), the word "MERCIER". When affixed onto the goods, besides the words "BAUME & MERCIER", the word "GENEVE" and the device of a Greek letter "phi" () always appear collectively on the face of the watches. The average consumers are well informed and circumspect enough not to be confused. Although the goods are similar goods, the marks are not similar and that there does not arise any likelihood of confusion between the Opponents and the Applicants marks. The ground of opposition under Section 8(2)(b) fails.
5. As the goods are similar goods to the Opponents' goods and the marks not identical or similar so as to cause confusion or deception in the market, the ground of opposition under section 8(3) of the Act will not avail to the Opponents and it is not necessary to make a finding whether the mark is well-known under the section.
6. The Opponents' evidence established substantial use and goodwill in the sale of luxury watches bearing the composite mark "BAUME & MERCIER" with the device of the Greek letter "Phi" () and the word "GENEVE". There is no evidence however submitted to show use of the word "MERCIER" independently of the word "BAUME", the ampersand and the Greek letter "Phi" () as a trade mark. The Opponents cannot claim to have goodwill and reputation in the word "MERCIER" alone.
7. As the Opponents' and the Applicants' marks are not similar and there is no likelihood of confusion arising from the use of their marks in a normal way as a trade mark for their respective goods; the first element of passing off that is deception or confusion arising out of goodwill and reputation in their mark is not proven. The elements of misrepresentation and injury to the Opponents' reputation will not need to be examined. As the elements of reputation, misrepresentation and damage required for an action for passing off were not made out, the ground of opposition under Section 8(4)(a) fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(4), 7(6), 8(2b), 8(3) and 8(4a).

Cases referred to

- The Pianotist Company Ltd Application (1906) 23 RPC 774.
- Newsweek Inc v British Broadcasting Corporation [1979] RPC 441

- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873.
- In the Matter of Trade Mark Application No. 2011973 by team Lotus Ventures Ltd to Register the Team Lotus Device and In the Matter of Opposition Thereto Under Opposition 45584 by Group Lotus
- Gromax Plastics Ltd v Low Nonwovens Ltd [1999] RPC 367
- Dawaat Trademark [2003] RPC 11
- Lloyd Shuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77,
- Sabel BV v Puma AG [1998] RPC 199
- Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc. [1999] E.T.M.R 1
- Joined Cases C-108/97 and C109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] E.T.M.R 585
- Case C-210/96 Gut Springenheide and Tusky [1998] E.C.R. I-4657
- Re Wong Seng & Son Bhd's Application and Salamander AG's Opposition [1993] AIPR 252
- McDonald's Corp v Future Enterprises Pte Ltd [2004] SGCA 50
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd & Anor [2000] 3 SLR 145
- Kellogg & Co. v Pacific Food Products Sdn Bhd [1998] 3 SLR 28
- The Nutritive Trade Mark [1998] RPC 621
- Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- Uni-charm Corporation and Opposition by Procter & Gamble Company [7 May 2003]
- Rainforest Coffee Products Pte Ltd v Rainforest Café Inc [2003] 2 SLR 549
- P.T. Super World Wide Foodstuff Industries and Opposition by Hiang Kie Pte Ltd (assigned to Coffee Club Private Limited) [17 April 2003]
- Davidoff Extension SA v Davidoff Commercio E Industria Ltda [1987] SLR 462
- "Autoanalyzer" Trade Mark - Trade Mark Registry Board of Trade [1970] RPC 201, JERYL LYNN Trade Mark [1999] FSR 491

Representation

- Mr Aloysius Leng assisted by Ms Laurel Loi (Abraham Low LLC) for the Applicants
- Mr Nathan Lau and Mr Kevin Wong (M/s Ella Cheong Sprusons & Ferguson) for the Opponents

[The appeal from this decision to the High Court has been dismissed]