

**In The Matter Of A Trade Mark Application By
Grimoldi S.R.L**

And

**Opposition Thereto By
Guccio Gucci S.P.A**

*Before Principal Assistant Registrar Mr Dennis Low
13 July 2005*

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 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, Grimoldi S.R.L, filed the application for trade mark applications T02/12107A, “GRIMOLDI MILANO & Device” (the ‘Applicant’s Mark’), in Class 14 in respect of “Gold; silver; platinum; precious metals and alloys thereof; objects made of precious metals and alloys thereof; diamonds; brilliants; precious stones; jewellery articles; jewels; cufflink and tie pins; wristwatches; clocks in general; watchstraps; chronometric instruments; items of jewellery plated with precious metals; clock and jewellery cases and caskets.”

The Opponents Guccio Gucci S.p.A, proprietors of a number of Double-G registered marks (‘the Double-G Marks’) in class 14 in Singapore, lodged a Notice of Opposition against the trade mark application on the 17 March 2003. One of the Opponents’ Double-G marks was first used in Singapore on watches since 1986.

The Opponents contended that by reason of the fact that the Applicants’ mark is, in respect of, inter alia, a device which is confusingly similar to the said Double-G marks, and applied onto identical or similar goods, there exist a likelihood of confusion on the part of public. They also contended that the Applicants’ mark will convey to an ordinary consumer the same idea/impression as the Opponents’ Double-G marks. Hence registration of the Applicants’ mark would be contrary to section 8(2)(b) and section 8(4)(a) of the Act.

The Opponents further contended that in view of the Opponents’ long and extensive use of the Double-G marks in Singapore for over 17 years, by reason of substantial use of the mark in Singapore, the Opponent’s mark has become well-known and is distinctive of and is identified with the Opponents. The use by the Applicant of the Applicant’s mark was calculated to cause confusion to the public and lead to the damage and erosion of the goodwill and reputation built up by the Opponent. The confusion and deception to the trade and to the public is contrary to law and will lead to the Applicants passing-off their goods as the Opponents’ goods. Further or in the alternative, the registration of the Applicants’ mark will cause purchasers of the Applicants’ goods to believe that there is some connection in the course of trade between the Applicants and the Opponents when no such connection exists.

The Applicants submitted that there is no similarity between the two marks, either visually, phonetically or conceptually. The Opponents’ marks are essentially devices, all being variations of two letter Gs; the Double-G device is the one and only essential feature of the Opponents’ marks. In contrast, the Applicants’ mark comprises of the words ‘GRIMOLDI’ and ‘Milano’, a dark rectangle device, as well as a device of 2 wheels which simulate the faces of 2 clocks. The applicants thus submitted that there is no visual similarity between their mark and the Opponents’ marks. The Applicants submitted that their mark is referred to verbally by the phrase ‘GRIMOLDI MILANO’ while the Opponents’ marks are usually referred to as ‘Gucci or ‘Double G’ device. The pronounceable names of the two marks are dissimilar and are phonetically distinguishable when compared as whole marks. Conceptually, the Opponents’ mark consists of a Double-G device which represents the initials of their name, ‘GUCCIO GUCCI’. On the other hand, the Applicants’ mark is a composite mark which consists of other elements.

Held, allowing the application mark to proceed to registration:

1. The goods of both the Applicants and the Opponents are identical or at the least very similar – all being luxury goods which include jewellery and watches.
2. Visually, the marks look different, if presented side by side. It is clear that the Applicants' mark and the Opponents' Double-G marks share a device which may be similar. The device which the Applicants claimed to be 2 clock faces at 'quarter past 7' and 'quarter to 2' can be deemed as a Double-G device, and it is clear that these 2 clock faces is in the same stylisation as the letter 'G' which appears in the first letter of the word 'GRIMOLDI'. However, the Opponents do not have the exclusive use of the letter 'G' or a pair of letter 'G'; and such Double-G devices cannot be said to have much imaginative content. It is also hard to believe that a consumer, when looking at the mark, would not notice the other elements contained in the Applicants' mark, especially the word 'GRIMOLDI', which is a dominant and distinctive feature of the mark.
3. The two marks, being known to their respective consumers as 'Gucci' and 'GRIMMOLDI', are unlikely to be mispronounced and mistaken for each other. Conceptually, the Opponents' mark consists of a Double-G device which represents the initials of their name, 'GUCCIO GUCCI'. On the other hand, the Applicants' mark is a composite mark which consists of other elements.
4. In this case, it is very unlikely that an average Singaporean consumer for luxury goods such as jewellery and watches is not aware of the brand of the goods when making his or her purchase. There is no evidence of actual confusion; the evidence tendered is indirect and not conclusive. The ground of opposition under section 8(2) therefore fails.
5. The two marks in this case are not similar and the consumers are unlikely to be confused; on the evidence there was no misrepresentation on the part of Applicants. Further, the Opponents have not submitted any evidence to substantiate their allegation of misrepresentation or the likelihood of damage. The ground of Opposition under section 8(4) therefore fails.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 2(1), 8 (2)b, and 8 (4)a.

Cases referred to:

- Sabel BV v Puma AG [1998] R.P.C. 199
- Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] R.P.C. 117
- Lloyd Schuhfabrik Meyer & Co Gmbh v Klijensen Handel B.V. [2000] F.S.R. 77
- React Music Limited v Update Clothing Limited [2000] R.P.C. 285
- De Cordova and Ors v Vick Chemical Co [1951] RPC 103
- Re 'Bulova Accutron' Trade Mark [1969] RPC 102
- UK Trade Mark Office Decision No. O/132/01 – Opposition by RADO UHREN AG against TM No. 1551892
- Pianotist Co Ltd's Application (1906) 23 RPC 774
- Kellogg Co v Pacific Food Products [1999] 2 SLR 651
- QS by S. Oliver Trade Mark [1999] RPC 520 London Lubricants (1920) Limited's Application (1925) 42 RPC 264
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and Another and Another Appeal [2000] 3 SLR 145 British Sugar v James Robertson [1996] RPC 281
- CODAS Trade mark [2001] RPC 240 The European Limited v Economist Newspapers Limited [1996] FSR 431
- The Polo/Lauren Company L.P. v United States Polo Association [2002] 1 SLR 326, The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175,
- Reckitt v Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873

Representation:

- Mr Ian Oei (Drew and Napier LLC) for the Opponents.
- Mr Samuel Yuen (Henry Goh (S) Pte Ltd) for the Applicants.