

**In The Matter Of An Application By
Hu Kim Ai Trading As Geneve Timepiece
For Declaration Of Invalidation**

Of

**Registered Trade Mark T01/16758B
In The Name Of Rhine Watches Limited**

*Before Principal Assistant Registrar Ms Anne Loo
29 July 2005*

Trade Marks – Invalidation – Likelihood of confusion - whether the registered 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 – Sections 23(3) and 8(2) of Trade Marks Act [Cap. 332, 1999 Rev Ed.

The Applicants, Hu Kim Ai Trading As Geneve Timepiece (“the Applicants”) of No.2 Jln SBC 8 Tmn Sri Batu Caves, 69100 Batu Caves, Selangor, Malaysia, initiated an application for the declaration of invalidation of the trade mark Registration No. T01/16758B for the mark consisting of the word “VALENLEO” and the device of 5 stars in Class 14 in respect of “watches; horological and chronometric instruments and jewellery” in the name of Rhine Watches Limited (the “Registered Proprietors”) of G/F, 33 Sheung Heung Road, Tokwawan, Kowloon, Hong Kong on the 2 November 2001. The Applicants are the registered proprietors of trade mark number T01/09283C in Class 14 which consists of a five star device for “clocks; horological and chronometric instruments; watches; parts and fittings therefor, all included in Class 14.” The Registered Proprietors failed to respond to the application for declaration of invalidity and did not file a Counter statement, respond to the Applicants’ statutory declaration filed on the 1 February 2005 or file any evidence. The Registrar’s Notice for Pre-hearing Review was sent to the Registered Proprietors at their last known address for service but the Registered Proprietors failed to attend the Pre-hearing Review or the hearing.

The Applicants relied on section 23(3) by reference to section 8(2) of the Trade Marks Act (Cap 332, 1999 Rev. Ed.) (“the Act”), and allege that the Registered Proprietors’ registered trade mark is identical to the Applicants’ earlier trade mark and is registered for the goods similar to those for which the Applicants’ trade mark is protected, and in the alternative, that the Registered Proprietors’ registered trade mark is similar to the Applicants’ earlier trade mark and is registered for goods identical with or similar to those for which the Applicants’ earlier trade mark was registered.

The Applicants claim that their 5 star device mark is an original, unique and independently created mark which was conceived as a mark by them in early 1991 in Malaysia and was first used in Singapore on or about late 1999, and registered in other countries. The Applicants’ 5 star device mark has been applied onto the various parts or components as well as accessories of the Applicants’ watches including the watch dial, the winding crown, the back cover glass, the oscillating weight, the back cover case, the bracelet buckle, the buckle button; as well as onto the watch box, the paper sleeve, instruction leaflet, certificate of warranty and brand tag of the watch. Besides use of the mark on the goods, the Applicants have also advertised and promoted the Applicants’ 5 star device mark in Singapore through advertisement in magazines, websites, signboards and other means of advertising.

Held, allowing the application for declaration of invalidation to proceed.

1. The plea under Section 8(2)(a) fails as the Applicants’ mark and the Registered Proprietors’ mark are not identical.
2. The plea under Section 8(2)(b) succeeds. With the exception of “clocks” in the Applicants’ specification and “jewellery” in the Registered Proprietors’ specification, the other goods are identical. Watches have, over time, evolved from their traditional function as being merely time keepers to being distinguished as items of fashion and fashion accessories. Consumers these days may not purchase watches as purely timepieces. In some cases, especially where the watches are made of or plated with precious metals and are encrusted with precious or semi-precious gemstones, watches have even been regarded as couture jewellery where the time-keeping function is purely incidental compared to the value as items of adornment. Advertisements similarly tout watches as fashion must-haves, and in the cases of watches heavily embellished with gemstones, these are often advertised either together with or side by side with jewellery advertisements. Since both the Applicants and the Registered Proprietors are trading in such

watches which are encrusted with precious gemstones, the Applicants' goods and the item "jewellery" listed in the Registered Proprietors' goods may be considered similar goods. Although the Applicants' jewel encrusted watches may not enter the market through the same traditional trade channels as jewellery per se, they have the same uses, the same physical nature and will be bought by the same end users.

3. With regard to the similarity of the marks, the comparison of the two marks is very much a question of visual and conceptual similarity, rather than aural similarity since while the Registered Proprietors' mark is a composite mark bearing a device and a word, there are no other elements in the Applicants' mark apart from the device with 5 stars. With the presence of the word "VALENLEO" in the Registered Proprietors' mark, it is clear that the marks as wholes are not identical. The marks in question when applied onto the goods of the specification appear on very small surfaces on the watches. Of these surfaces, the face of the watch is what a consumer of these goods would pay most attention to. On the small surface of the face of a watch, the device is the most obvious and will be the first item that will strike the consumer's eye. This is particularly so in this matter which relates to the 5 star device as the device is an easily recognisable and describable device. The supporting evidence lodged by the Applicants shows that the Registered Proprietors have used their mark in almost exactly the same manner in which the Applicants have.
4. Having regard to the marks as they appear on the register and as they are used in a normal and fair manner and taking all of the factors into consideration, comparing the marks as wholes and comparing the Applicants' and Registered Proprietors' mark used in a normal and fair manner, the overall visual and conceptual impressions of the two marks are similar and there does exist a likelihood of confusion. Bearing in mind that the marks are similar, the marks when used on particularly small surface areas such as the face of a watch will potentially increase the likelihood of confusion. The Applicants' evidence showing the use of their device on the certificate and on their packaging which was copied by the Registered Proprietors also supports this conclusion. The certificate of warranty with the device of 5 stars in a repeating pattern is a clever method that the Applicants have employed to create brand reinforcement and will remain in the consumers' minds as they look at the certificate, the product literature and even the packaging. Consumers cannot be assumed to have the luxury of comparing the brands side by side. What remains in their minds is a recollection of what they have seen, and as the decided cases have held, the recollection may not be altogether correct. Since the idea or concept of the two marks revolves around the device of 5 stars, visually, this would be the strongest recollection a consumer would have of the marks - especially in this matter where the Applicants' mark is purely a device mark. There is a strong likelihood that a consumer would be confused and be caused to wonder whether the Registered Proprietors' goods and the Applicants' goods emanate from one source.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) 23(3) and 8(2)

Cases referred to:

- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [2000] FSR 77
- Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc. [1999] RPC 117
- Balmoral Trade Mark (1999) R.P.C. 197
- Sabel BV v Puma AG [1998] RPC 199
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
- In the matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark (1906) 23 RPC 774
- The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] SGHC 175 Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651
- McDonald's Corp v Future Enterprises Pte Ltd [2004] SGCA 50

Representation

- Mr Adrian Ee (M/s Ramdas & Wong) for the Applicants
- Registered Proprietors absent