

**In The Matter Of An Application By  
JM Collective Pte Ltd  
To Register A Trade Mark**

**And**

**Opposition Thereto By  
Perlini's Pte Ltd**

*Before Principal Assistant Registrar Mr Kelvin Sum  
7 January 2005*

**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 earlier trade mark is well known in Singapore - whether use of the later trade mark would indicate a connection between goods or services - whether there exists a likelihood of confusion on the part of the public – whether the interests of the proprietor of the earlier trade mark are likely to be damaged by such use – 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 JM Collective Pte Ltd filed the application for trade mark applications T01/17732D in Class 18 in respect of “Airline travel bags, wallets, bags, satchels, purses, pocket wallets, pouches, tote bags, brief cases, key holders and cases; vanity cases [not fitted], travelling bags, portfolio cases made from leather and imitation in Class 18” and T00/17698G in Class 25 in respect of “Clothing, headgear, footwear made of leather and imitation leather, high heeled pumps, low heeled pumps, boots, sandals, classic pumps, platforms and outdoor slippers, clogs, mules, causal shoes, sport shoes”, both applications for the mark “PERLLINI”.

The Opponents, Perlini's Pte Ltd, are the prior registered owners of the registered mark “PERLINI'S” in Class 14 (T95/05487F) in respect of “Jewellery; goods in precious metals or coated therewith, not included in other classes”. The Opponent's mark was first used in Singapore on 8 November 1989 in relation to the goods applied for. The Opponents were also the registered proprietors of the said trade mark in class 14 in the other countries.

The Opponents contended that the opposed mark “PERLLINI” is very similar to the Opponent's mark “PERLINI'S” in that both marks are conceptually, phonetically and visually very close and will give rise to confusion. They also contended that both the Applicants goods and the Opponents goods are of a similar description and closely related even though they are in different classes.

The Opponents further contended that by reason of substantial use of the mark in Singapore 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 deceive and cause confusion to the public and lead to the damage and erosion of the goodwill and reputation built up by the Opponent.

The Applicants stated that the Applicant's mark is an invented mark of the Applicants, the merchandise (in particular handbags) under the Applicants mark are sold in 16 departmental outlets all over Singapore without confusion to the public. The Applicants also claim to enjoy tremendous support from well-known department stores without confusion to the public. Further, the Applicants enjoy extensive promotion and advertising from the media, resulting in an acquired reputation and invaluable goodwill in their mark as a key supplier of the handbags, shoes and clothing at competitive prices to local department stores in Singapore and in the neighbouring countries. They should therefore be allowed to register their mark.

**Held, allowing the application mark to proceed to registration:**

1. The words, though not identical, are structurally and aurally similar. However, the Opponents goods and the Applicants goods are very distinct items and are different goods that are unrelated to each other. The goods applied for by the Applicant in their two trade mark applications are neither identical nor similar to goods for which the Opponent's mark is registered under. There would not be likelihood of confusion. 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.
2. The Opponents have not discharged the burden of proving that their mark is well known in Singapore. The advertising and sales figures alone, coupled with the continued expansion of the number of stores in Singapore, are not enough by themselves to establish that the Opponent's mark is well-known. The sales and advertising figures are not conclusive in themselves, and the effect that the advertising material has on the public is unclear; and the print material, though extensive, does not again prove that the mark is well-known. The ground of opposition under section 8(3) therefore fails.
3. On the evidence there was no misrepresentation or intention to deceive. The creation of the name is supported by reasonable evidence by the Applicants. The similar mark is being used on a completely different type of goods. There was no evidence that the Applicant was seeking to usurp the same market as the Opponent's goods. The ground of Opposition under section 8(4) therefore fails.
4. When bad faith is pleaded as a ground of opposition, there must be clear and sufficient evidence to make out the serious allegation of bad faith. In this case, there are only bare allegations of the visual and aural similarity of the marks giving rise to an inference of misappropriation and copying unsupported by any sort of direct evidence. There is also not enough indirect or circumstantial evidence that would lead me to an inference of bad faith. There is insufficient evidence to lead to a finding of bad faith. There is no misappropriation of the Opponents' mark, and the Applicants' have not been shown to have acted in bad faith in their selection of their mark. The opposition based on Section 7(6) fails.

#### **Provisions of legislation discussed**

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

#### **Cases referred to:**

- Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Saga Foodstuffs Manufacturing (Pte) Ltd v Best Food Pte Ltd [1995] 1 SLR 739,
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281,
- Compagnie Generale Des Eaux v Compagnie Generale Des Eaux Sdn Bhd [1997] FSR 610.
- WILD CHILD TM [1998] RPC 455
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550,
- Sabel v Puma [1998] RPC 199
- Kellogg Co v Pacific Food Products [1999] 2 SLR 651.
- QS by S. Oliver Trade Mark [1999] RPC 520
- Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and Another and Another Appeal [2000] 3 SLR 145
- CODAS Trade mark [2001] RPC 240
- The Polo/Lauren Company L.P. v United States Polo Association [2002] 1 SLR 326,

#### **Representation:**

- Ms Cecilia Gervin (M/s Drew and Napier LLC) for the Opponents.
- Mr Lai Kwok Seng (M/s Lai Mun Onn and Co.) for the Applicants.