

**In The Matter Of A Trade Mark Application No. T02/12589A By
Nautical Concept Pte Ltd**

And

**Opposition Thereto By
Mark Richard Jeffery And Guy Anthony West**

*Before Principal Assistant Registrar P Arul Selvamalar
14 February 2006*

Trade Mark – 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 Mark – 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 Mark – Opposition to registration – whether the earlier trade mark is well known in Singapore - whether use of the later trade mark would indicate a connection - whether there exists a likelihood of confusion – whether the interests of the proprietor of the earlier trade mark are likely to be damaged – Section 8(3) of the Trade Marks Act 1998 [Cap.332]

Trade Mark – 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]

Trade Mark – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the definition of a trade mark under Section 2(1) and the requirements under Section (7)(1) of the Trade Marks Act 1998 [Cap.332]

The Applicants, Nautical Concept Pte Ltd, a Singapore company, applied for a mark T02/12589A, “JWEST” (stylised) in Class 25 in respect of “Shoes, boots, slippers and sandals; sports shoes and sports boots; gymnastic shoes; athletic shoes; sneakers; shoes and boots for walking and climbing; socks and stockings; soles for footwear; all included in Class 25” on 26 Aug 2002. The Opponents, Mark Richard Jeffery and Guy Anthony West are the co-founders of the UK company Jeffery-West & Co Ltd and the owners of the registered mark JEFFERY-WEST [T02/08210F] in Singapore, since 5 June 2002 in Class 25 for “articles of clothing, footwear and headgear”.

The Opponents argued that the applicants knew of the Opponents mark and that the application was made in bad faith, contrary to Section 7(6) of the Trade Marks Act 1998. The Opponents further argued that the Application Mark is confusingly similar to their mark under Section 8(2)(a) and (b) of the Act. They argued that their mark was well known under Section 8(3) of the Act and that the application was objectionable under Section 8(4)a of the Act by virtue of the law of passing off. They also argued that the mark did not satisfy the definition of a trade mark and that it was devoid of distinctive character under Section 7(1)(a) and (b) of the Act.

The Opponents have been selling footwear branded Jeffery – West since mid-1980s in England. They have registrations for the mark in the United Kingdom, the European Community, Australia, Indonesia and Malaysia. Their worldwide sales figures range from S\$3.46 million in 1998 to S\$5.68 million in 2002. They first sold footwear in Singapore in 1992 through C K Tang.

The Applicants have been selling footwear in Singapore since 1994. They say that the mark JWEST was first used by them in 1998 but they did not apply for it until 2002. The Registrar did not accept this evidence and found that their mark was used only since 2002. The Applicants director, Lee, knew the Opponents since 1992 or 1993 when the company he worked for distributed the Opponents’ shoes to C K Tang in Singapore. The Applicant company was set up in 1994 and from 1995 to 1996 the Applicants became the Opponents agents in Singapore.

The Applicants distributed ladies shoes under the brand JW and men’s shoes under the brand Jeffery West for the Opponents. This relationship ended in 1996 and there appears to be no communication between the parties until 1999 when the Opponents were alerted of the Applicants use of the mark Jeffery West in Singapore.

Thereafter the Opponents visited the Applicants in Singapore and there were discussions about the transfer of the ownership of the marks Jeffery West and JW to the Opponents, as the applicants had applied for registrations of those marks in Singapore in 1997. There was also discussion about an undertaking not to use the marks Jeffery West for men's shoes. Thereafter the Applicants withdrew their applications for Jeffery West and JW. However they continued to use the mark JW for women's shoes and they filed an application in 2000 for the mark JW for women's shoes which has since been registered.

Held, disallowing registration,

1. The Opponents mark Jeffery West and the Applicants mark JWEST, are more similar than dissimilar. Visually the marks are dissimilar although phonetically there are similarities. Conceptually both marks have a common element but more importantly the Applicants mark JWEST will be perceived as an abbreviation of the Opponents mark Jeffery West. The opposition under Section 8(2)b succeeds as the marks are similar, the goods are similar and there is a likelihood of confusion among a substantial number of consumers, if the application mark proceeds to registration.
2. The Registrar did not believe the Applicants explanation for the derivation of the mark JWEST. The Applicants had had past dealings with the Opponents and were aware of the Opponents' use of their marks Jeffery West and JW on men's and ladies shoes. Even if the applicants thought that their JWEST mark was dissimilar to the Opponents mark Jeffery-West, they should have sought the Opponents' consent to use the mark JWEST. Their conduct in applying for the trademark JWEST, without confirming with the Opponents that they were not interested in using the mark JWEST; their incredible explanation for the choice of the mark JWEST, their failure to mention distributing the Opponents' shoes branded Jeffery West and JW, and the Applicants inconsistent explanation for not applying for the mark JWEST earlier, lead to the inference that the application was made in bad faith. The opposition under Section 7(6) succeeds.
3. Opponents fail under section 8(4)a as there is insufficient evidence to establish the kind of reputation and goodwill that the Opponents need in Singapore to make out a case of passing off. The Opponents fail under section 8(3) as there is insufficient evidence to establish the kind of recognition that the Opponents mark must enjoy in Singapore to establish that their mark is well known. Opponents fail under section 7(1)a and 7(1)b as the Applicants' mark is distinctive

Provisions of Legislation discussed:

- Trade Marks Act [Cap.332, 1998 Rev Ed.] Sections 7(6), 8(2)b, 8(3), 8(4)a, 7(1)a and 7(1)b

Case referred to:

- Kundry SA's Application [1998] ETMR 178
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367
- Nation Fittings (M) Sdn Bhd v Oystertec Plc [2005] SGHC 225
- Harrisons TM Application [2005] FSR 10
- Travelpro TM [1997] RPC 864
- McDonalds Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Pianotist Co's Application (1906) 23 RPC 774
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B V [1999] ETMR 690
- Re Wong Seng & Son Bhd's Application
- Salamander AG's opposition [1993]
- Polo/Lauren Co LP v Shop In Department Store Pte Ltd [2005] SGHC 175
- Dermik Laboratories Inc v Galderma S.A [2005] SGIPOS 17
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
- Newsweek Inc v Broadcasting Corporation [1979] RPC 441
- Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd [2004] 4 SLR 208
- Harrods (1935) 52 RPC 65
- The European Limited v The Economist Newspaper Limited [1998] FSR 283
- Richemont International SA v Goldlion Enterprise (S) Pte Ltd [2005] SGHC 208
- Royal Enfield TM [2002] RPC 24
- Delight Express Limited v In-Comix Food Industries Sdn Bhd [2004] SGIPOS 14
- Give Me Five (SRIS 0/133/99)
- British Sugar v James Robertson [1996] RPC 281

- The Polo/Lauren Company LP v United States Polo Association [2002]1 SLR 326
- 10 Royal Berkshire Polo Club TM [2001] RPC 32
- Consorzio Del Prosciutto Di Parma v Marks & Spencer Plc [1991 RPC 351
- Alteco Chemical Pte Ltd v Chong Yean Wah t/a Yamayo Stationery Manufacturer
- Philips Electronics NV v Remington Consumer Products Ltd [1999] ROC 809

Representation:

- Mr. Alban Kang and Ms Joyce Ang (ATMD) for the Applicants
- Mr. Nathan Lau and Mr. Kevin Wong (Ella Cheong, Spruson & Fergusons) for the Opponents

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