

**IN THE MATTER OF A TRADE MARK APPLICATION T03/20621F BY
PACIFIC RIM INDUSTRIES INC.**

AND

**OPPOSITION THERETO BY
VALENTINO GLOBE B.V.**

*Before Principal Assistant Registrar P Arul Selvamalar
14 February 2008*

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 (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the Application Mark is similar to an earlier trade mark which is well known in Singapore and is to be registered for goods or services not similar to those for which the earlier trade mark is protected – whether the use of the Application Mark on such goods or services would indicate a connection between them and the proprietor of the earlier mark – whether there is 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 (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(7)(a) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – whether the application to register is made in bad faith – Section 7(6) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the definition of a trade mark under Section 2(1) and the requirements under Sections 7(1) of the Trade Marks Act (Cap. 332) 1999 Rev. Ed.

On 18 December 2003, the Applicants filed their trade mark application (T03/20621F) for the mark “Emilio Valentino & Device” in respect of leather goods in Class 18. The Opponents and their associated companies, who have four registrations in Class 18 (T96/11520H, T99/04403D, T00/21726H and T89/07702I) as well as other marks in other classes, opposed the application on 5 grounds. The Opponents contended that (i) there exists a likelihood of confusion on the part of the public because the Application Mark is confusingly similar to their marks under Section 8(2)(b); (ii) that their marks are well known marks in Singapore and registration of the Application Mark would be contrary to Section 8(3); (iii) that the Application Mark was objectionable under the law of passing off (Section 8(7)a); (iv) that the application was made in bad faith and contrary to Section 7(6); and (v) that the Application Mark was not distinctive under Section 7(1).

The Opponents’ Valentino Marks have been applied for, registered and used worldwide on a wide variety of goods and services in the fashion industry. The Opponents also argued that the Valentino Marks have been continuously and extensively used in Singapore since 1980 and worldwide since 1961. The Opponents filed their annual sales turnover in Singapore for the years 1990 to 1997, as well as for the period of September 2001 to March 2006. No sales figures were submitted for the years 1997 to September 2001. The Opponents also filed their annual advertising and promotional expenditure in Singapore and worldwide for the years 1990 to September 1994 and for the period of January 2001 to March 2006.

The Opponents argued that the application was made in bad faith, as prior applications for marks identical to the Application Mark had been made by a Hor Soon Hong (HSH), the sole proprietor of Impressions (Int’l) Import and Export (“Impressions”); and as HSH had claimed, in an affidavit filed at the High Court to quash a search warrant which had been successfully applied for against Impressions by the Opponents, that he (HSH) is the common law proprietor of the Emilio Valentino marks in Singapore.

The Applicants disputed that the Opponents had continuously used their marks in Singapore since the date of first use and submitted a Straits Times article which described how Valentino left Singapore in 1997 and returned in 2001. The Applicants argued that their goods have been traded under the Application Mark since 1999, furnishing advertising evidence and Singapore sales figures for the years 2001 to 2005.

Held, allowing the Application Mark to proceed to registration:

1. The Opponents raised further particulars relating to bad faith in their first Statutory Declaration. On this preliminary issue of whether bad faith had been properly pleaded, as the Opponents had pleaded Section 7(6) in their Notice of Opposition, and as the Applicants had responded to the further particulars in their evidence, there is no prejudice and the further particulars of bad faith are allowed to be argued in this opposition.
2. The Registrar compared the Opponents' marks T99/04403D and T00/21726H comprising the letter V with the endless belt device and the word Valentino below it, with the Application Mark, as these were the two marks closest to the Application Mark. Comparing the marks as wholes, no visual similarity was found. While the Application Mark also contained the word Valentino, it also comprised a different V device and an additional word Emilio, and a line separating the device and the words. The marks were found to be aurally distinct as the emphasis will be at the beginning of the marks when they are pronounced. The Applicants' goods were found to be similar to the goods in T89/07702I. The Registrar found that various traders in the fashion industry use the word Valentino and the word "Valentino" is not distinctive solely of the Opponents. The Registrar found that the use of the mark "Emilio Valentino" which sounds Italian, would not imply that there is a connection between the Opponents and the Applicants, or that the Application Mark is a variant of the Valentino Marks, as there were many Valentino marks on the Trade Marks Register in class 18 in the names of different proprietors. The channels of distribution, the prices and the target markets of the Opponents' and Applicants' goods are different. The Registrar found that there was no likelihood of confusion among a substantial number of average consumers if the Application Mark is registered. The opposition under Section 8(2)(b) therefore failed.
3. To establish that their Valentino Marks are well known, the Opponents ought to show a continuous presence in Singapore via sales or advertising and promotion. Even if there was a break in the business presence, if the Opponents were able to show that their Valentino Marks remained well known via continuous advertisement and promotion, the Registrar would have taken this into account. In this case, the Opponents stopped advertising and promotions for 7 years. The Opponents have not made out their case that the Valentino Marks were well known in Singapore. The opposition under Section 8(3) therefore failed.
4. Even if the Registrar was persuaded that the Opponents enjoyed goodwill in their business under the Valentino Marks, she was not persuaded that there would be misrepresentation because the Opponents' reputation/goodwill is in the retail of clothing and this application is for leather goods. There would also be no damage as there is no misrepresentation. The Opponents have not made out a case for passing off. The opposition under Section 8(7)(a) therefore failed.
5. The mere incorporation of the word "Valentino" in the Application Mark does not lead to an inference that the application was made in bad faith. The fact that the Applicants are a Californian registered company which has allowed HSH/Impressions to manufacture its goods in China and market the goods with the word Italy, under a mark which is "Italian sounding", cannot lead to an inference of bad faith. The statements in the affidavit that was tendered in the High Court, that HSH was the proprietor of the Emilio Valentino mark in Singapore, must be considered in the context of the affidavit and the application to quash the search warrants. The affidavit filed by HSH in another proceeding is insufficient evidence to establish that the Applicants are not the owners of the Application Mark. By the date of the hearing of the opposition, there was no other person (HSH/Impressions) claiming to be the proprietor of the mark Emilio Valentino. The Registrar was satisfied that the Applicants are the owners of the Application Mark in Singapore. The opposition under Section 7(6) therefore failed.
6. The Application Mark is inherently distinctive under Section 7(1)(b) and therefore satisfies the definition of a trade mark under Section 2(1). The Registrar also found the Application Mark to be capable of distinguishing the Applicants' goods from the Opponents' goods. The opposition under Section 7(1) therefore failed.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 2(1), 7(1), 7(6), 8(2)(b), 8(3) and 8(7)(a).

Cases referred to:

- *Sabel v Puma AG* [1998] RPC 1999
- *Lloyd Schuhfabrik Meyer Co GmbH v Klijsen Handel B.V.* [1999] E.T.M.R. 690
- *Re Wong Seng & Son Bhd's Application and Salamander AG's Opposition* [1993] AIPR 252
- *De Cordova v Vick* (1951) 68 RPC 103

- In the matter of application no 2142579 by The Cartoon Network LP, LLLP to register the trade mark CARTOON NETWORK in classes 9, 16, 18, 25, 28, 30, 32, 35, 41 and 42 and the opposition thereto under no. 52625 by Cartoon Triangle Apparel Inc., dated 17 April 2003 (UK IP Office decision)
- In the matter of Application No. 2167713 by Johnson & Johnson to register the trade mark CALCIMILK in class 29 and in the matter of opposition thereto under no. 49112 by Unigate Dairies Limited, dated 7 September 2001 (UK IP Office decision)
- Matsuda & Co v Valentino Globe B.V. (formerly known as Globeelegance B.V.) [2001] SGIPOS 8
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd (1991) SLR 133
- Newsweek Inc v British Broadcasting Corporation (1979) RPC 441
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Shell & Co (Aust) Ltd v Rohm & Haas [1949] 78 CLR 601
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] SGHC 51
- DALIC Trade Mark [1998] 2 SLR 231
- RH Macy & Co Inc v Trade Accents [1992] 1 SLR 581
- The Seven Up Co v O.T. Ltd & Anor [1947] 75 C.L.R. 203
- In the matter of Trade Mark Application m 2011973 by Team Lotus Ventures Ltd to register Team Lotus Device and in the matter of Opposition thereto under Opposition m 45584 by Group Lotus Ltd, dated 23 October 1998 (UK IP Office decision)
- In the Matter of Application No. 2203648 by Tesco Stores Limited to register a Trade Mark and in the matter of Opposition No. 50578 by Wal-Mart Stores Incorporated, dated 30 August 2001 (UK IP Office decision)
- Demon Ale Trade Mark [2000] RPC 345
- In the matter of Application No. 2008447A by S T Dupont to register a mark in Class 25 and in the matter of opposition thereto under No. 44948 by E.I Du Pont de Nemours and Company, dated 7 December 2001 (UK IP Office decision O/546/01)
- In the Matter of Application No. 2167825 by Tony Knight to register a Trade Mark in Class 25 and In the Matter of Opposition thereto under No. 50544 by Patrol Jeanswear Ltd., dated 28 November 2001 (UK IP Office decision O/529/01)
- Itochu Corporation v Worldwide Brands, Inc [2007] SGIPOS 9
- Stichting Lodestar v Austin Nichols & Co. Inc. [2006] SGIPOS 11
- In the Matter of Broadhead's Application for Registration of a Trade Mark (1950) 67 RPC 209
- Nautical Concept Pte Ltd v Mark Richard Jeffery & Anor [2006] SGHC 239
- In the Matter of London Lubricants (1920) Limited's Application to Register a Trade Mark (1925) 42 RPC 264
- La Societe Des Brasseries Et Glacieres Internationales v Asia Pacific Breweries Ltd [2006] SGIPOS 5
- The Polo/Lauren Co., LP v. Shop-In Department Store Pte Ltd [2005] 4 SLR 816 (High Court); [2006] 2 SLR 690 (Court of Appeal)
- 10 Royal Berkshire Polo Club Trade Mark [2001] RPC 32
- Richemont International SA v Goldlion (Singapore) Pte Ltd [2006] 1 SLR 401
- McDonald's Corp v Future Enterprises [2005] 1 SLR 177
- Yunnan Baiyao Group Co Ltd v Tong Jun Chew Pte Ltd and another [2002] SGHC 246
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281

Representation:

- Mr Samuel Seow and Miss Trina Ha assisted by Miss Stella Teo (Samuel Seow Law Corporation) for the Applicants
- Mr P Sivakumar assisted by Miss Sulochana (Joseph Lopez & Co) for the Opponents