

**IN THE MATTER OF TRADE MARK APPLICATION T05/14255Z
BY LOHMUN LEATHER PRODUCTS**

AND

**OPPOSITION THERETO BY
THE POLO/LAUREN COMPANY, L.P.**

*Before Principal Assistant Registrar Mr Louis Chan Ken Yu
08 April 2008*

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 Section 7(1) of the Trade Marks Act (Cap. 332) 2005 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) 2005 Rev. Ed.

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) 2005 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) 2005 Rev. Ed.

Trade Marks – Opposition to registration – trade mark which consists of or contains the flag, state emblem or official sign etc of a Convention country - marks which consists of or contains the Swiss Federal Cross - Section 56 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – trade mark which consists of or contains any flag, emblem, abbreviation or name of an international intergovernmental organization of which a Convention country is a member - Section 57 of the Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Trade Marks – Opposition to registration – trade mark which consists of or contains any representation of the Crest of Singapore, or Singapore flag, any word etc likely to lead persons to think that the applicant recently has had the Singapore Government’s authorization etc, the words “Red Cross”, or “ANZAC” etc - Rule 12 of the Trade Marks Rules 2008 Rev. Ed.

This is an opposition against the trade mark application T0514255Z in Class 18 in respect of “luggage, luggage straps, travelling bag, leather wallets, handbags, backpacks, duffle bags, tote bag, shoe bag, waist pouch, suitcases, sling bags, overnight case, garment bag and shoulder bag” for the mark, “Swiss Polo & device”, as shown below:



The Applicant, Lohmun Leather Products Pte Ltd, filed the Applicant’s Mark on 19 August 2005, with a clause stating that the mark is limited to the three colours as represented. The Applicant, established in 1978, is a local importer and retailer of various types of bags, including luggage.

The Opponent, The Polo/Lauren Company, L.P., is the proprietor of various trade marks containing the word, “POLO”, either on its own or in conjunction with other words and/or a polo player device in respect of a variety

of goods throughout the world. The Opponent claims that it has acquired a significant reputation and goodwill in the same via numerous registrations, applications, extensive usage, promotion and advertisement.

Held, disallowing registration:

1. Under Section 8(2)(b) of the Act, the Applicant's Mark is not similar to the Opponent's Marks. The Registrar is of the view that even if he is wrong in that finding, he is not satisfied with the evidence before him that there is a likelihood of confusion between the marks as the relevant trade channels, target customers, and marketing programme under both marks are distinct. This ground of opposition, therefore does not succeed.
2. As the Registrar has already decided that there would be no confusion under Section 8(2)(b) of the Act, he is of the view that for the same reasons, there would be no misrepresentation for the purposes of passing off. Thus the opposition under Section 8(7)(a) under the law of passing off is dismissed.
3. The opposition succeeds under Section 56(1) and 56(4) of the Act and Rule 12(d) of the Rules. The Registrar is of the view that the Applicant's Mark conflicts with Section 56(1) of the Act as the Applicant's Mark contains the Swiss national flag which consists of the Swiss Federal Cross in white on a red background. In the alternative, the Applicant's Mark imitates the Swiss national flag and would still offend Section 56(1) when read with Section 56(4) of the Act. There are no surrounding facts suggesting that this is a case where the proposed mark is used in a manner that does not require authorisation. On the contrary, the Singapore Swiss Embassy has objected to its registration.
4. On the facts, the Registrar is not convinced that the Applicants had misappropriated the Opponents' Mark or the Swiss elements, for the purposes of satisfying the bad faith requirement under Section 7(6) of the Act.
5. The question of distinctiveness under Section 7(1) is to be determined by reference to the mark under consideration only and not by comparing the mark with other marks. The Applicants' Mark is capable of distinguishing their goods and, therefore, the opposition under Section 7(1) fails.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 7(1), 7(6), 8(2), 8(7), 56 and 57.

Cases referred to:

- *The Polo/Lauren Co., LP v. Shop-In Department Store Pte Ltd* [2005] 4 SLR 816 (High Court)
- *The Polo/Lauren Co., LP v. Shop-In Department Store Pte Ltd* [2006] 2 SLR 690 (Court of Appeal)
- *The Polo/Lauren Co., LP v. United States Polo Association and anor* [2002] 1 SLR 326
- *Boby Footwear Pte Ltd v The Polo/Lauren Company, L.P.* [2005] SGIPOS 16
- *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd* (1953) 86 CLR 536
- *Opposition by Bencom s.r.l. to Registration of Trade Mark Application 912346(25) - Killer Instinct - filed in the name of Peter Loccisano and Matthew Rooke*
- *In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark Application* (1906) RPC 774.
- *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
- *McDonald's Corp v Future Enterprises Pte Ltd* [2004] SGCA 50
- *De Cordova v Vick* (1951) 68 RPC 103
- *The European Limited v The Economist Newspapers Limited* [1996] FSR 431
- *An Application by Harrods Ltd to Register a Trade Mark* (1935) 52 RPC 65
- *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177
- *Royal Enfield TM* [2002] RPC 24
- *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367
- *Rothmans of Pall Marll Limited v Maycolson International Ltd* [2006] 2 SLR 551
- *Goldlion Enterprises Singapore Pte Ltd v Baume & Mercier SA* [2005] SGIPOS 10
- *Soldan Holding and Another v. Ferrero S.p.A.* [2001] SGIPOS 5

Representation:

- Mr Sukumar Karrupiah (M/s Ravindran Associates) for the Opponents.
- M Yew Woon Chooi, Mr Calvin Lim and Ms Cheryl Li (M/s Rodyk & Davidson LLP) for the Applicants.