

**IN THE MATTER OF TRADE MARK APPLICATIONS T02/19037E AND T03/00022G BY POLO
SPIRIT PTE LTD**

AND

**OPPOSITION THERETO BY
S. TOUS S.L.**

*Before Principal Assistant Registrar P Arul Selvamalar
19 November 2008*

Trade Marks – Opposition to registration – whether the Application Mark is identical to an earlier trade mark and is to be registered for goods or services identical with those for which the earlier trade mark is protected - Section 8(1) of the Trade Marks Act (Cap. 332) 1999 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) 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.

On 17 December 2002, the Applicants filed a trade mark application T02/19037E for a mark comprising a slightly rotated device of a bear with the letters and words, “QQ BEAR” on its rear left paw (Application Mark 1) in Class 18 for “Leather and imitations of leather and goods made of these materials”. On 8 January 2003, the Applicants filed another trade mark application T03/00022G for the same device of a bear without the words QQ Bear (Application Mark 2) for the same goods in the same class. The Opponents opposed the application on the grounds that (i) the Application Mark 2 is identical to the Opponents’ mark under section 8(1), (ii) there exists a likelihood of confusion on the part of the public because Application Mark 1 is confusingly similar to their mark under Section 8(2)(b); (iii) that the Application Marks were objectionable under the law of passing off under Section 8(7)(a); and (iv) that the applications were made in bad faith and contrary to Section 7(6).

The Opponents are a Spanish company established since 1920 whose director Rosa Oriol designed the bear device in 1985. They have applied for registration of their bear device in various classes in various countries and their earliest registration in Spain is dated 1998. The Applicants who applied for the application marks in Singapore in 2002 and 2003, offered no explanation why Application Mark 2 is identical to the Opponents’ bear device. With respect to Application Mark 1, they only state that the letters QQ Bear in the mark will distinguish the marks, without any explanation why the bear device in this mark is also identical to the Opponents bear, albeit rotated. The Applicants also did not say anything about the ownership of their marks or how they came to apply for the marks in Singapore from 2003 to 2008 when they filed their Counter Statements and first Statutory Declaration. Only in 2008 when they filed their second Statutory Declaration, the Applicants explained that they came across the mark in China and that they obtained the consent to apply for the marks in Singapore from a company (Lorence) in China, who also supplied them the goods for sale in Singapore. However they do not say that Lorence is the owner of the marks in China. There was no supporting evidence of the consent from Lorence to the Applicants or the supply of goods from Lorence to the Applicants for sale in Singapore. Soon after filing the applications in Singapore, the Applicants applied for the marks in China.

Held, disallowing registration:

1. The Registrar found that the Opponents own the trade mark rights in the device of the bear and the Applicants have made applications for identical bear devices in Singapore. The Registrar found that where there is evidence of prior use and ownership of an identical mark by someone else and there is an identical application in Singapore, it is the applicant’s duty to explain how he came to apply for identical marks in Singapore. The Applicants had not given a credible account of their consent and licensing arrangements with Lorence and had been silent on the issue of ownership. Their application for the marks in China, soon after obtaining Lorence’s consent to apply for the marks in Singapore, was inconsistent. The Registrar found that where the applicants claim that they are licensees from third parties located outside Singapore,

they must explain what they did to satisfy themselves that the person consenting to their applications in Singapore and giving them license, are the owners. The Registrar drew an inference that the Applicants acted in bad faith from all the circumstances of the case. The opposition under section 7(6) of the Act was therefore successful.

2. The Opponents did not have an earlier trade mark for their bear device in Singapore before the dates of application for the Application Marks, as required by section 8(1) and 8(2)(b) of the Act. Therefore the oppositions under sections 8(1) and 8(2)(b) failed.
3. There was also insufficient evidence to show that the Opponents had goodwill and reputation in the business of trading under their bear device in Singapore. The oppositions under section 8(7) therefore failed.

Provisions of legislation discussed:

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

Cases referred to:

- Gromax Plastics Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] 2 SLR 551
- Demon Ale Trade Mark [2000] RPC 345 at 356
- McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Karison Exports Ltd v Premo International Pte Ltd [2005] SGIPOS 6
- Vitamins Ltd Application [1956] RPC 1
- Application by Brown Shoe Co Inc [1959] RPC 29
- Harrison v Teton Valley Trading Co Ltd [2005] FSR 10
- Twinsectra Ltd v Yardley [2002] 2 AC 164
- Royal Brunei Airlines Sdn Bhd v Tan [1995] 2 AC 378
- Tiffany & Co. v Fabriques de Tabac Reunies SA [1993] 3 SLR 147
- Hyundai Mobis v Mobil Petroleum Company, Inc [2007] SGIPOS 12
- Reckitt & Colman Products Ltd v Borden Inc. & Ors [1990] 1 All ER 873
- Erven Warnick BN v J Townsend & Sons (Hull) Ltd [1979] AC 731
- WILD CHILD Trade Mark [1998] RPC 455
- Colgate-Palmolive Company v The Proctor & Gamble Company [2007] SGIPOS 13
- Kopitiam Investment Pte Ltd v RC Hotels Pte Ltd [2008] SGIPOS 8
- Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd [2008] 3 SLR 296
- Armstrad Consumer Electronics PLC v The British Phonographic Industry Limited [1986] FLR 159
- Royal Enfield Trade Marks [2002] RPC 24
- Delight Express Limited v In-comix Food Industries Sdn Bhd [2004] SGIPOS 14
- E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5
- Wallersteiner v Moir [1974] 1 WLR 991
- Point Solutions Ltd v Focus Business Solutions Ltd [2006] FSR 31
- Pacific Rim Industries Inc. v Valentino Globe B.V. [2008] SGIPOS 6
- Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co Ltd [2008] SGIPOS 9
- Polo/Lauren Co. LP v. Shop-In Department Store Pte Ltd [2005] 4 SLR 816
- British Sugar plc. v James Robertson & Sons Ltd [1996] RPC 281
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- Polo/Lauren Company L.P. v United States Polo Association [2002] 1 SLR 326
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another [2006] 1 SLR 712
- A G Spalding Bros v A W Gamage (1915) 32 RPC 273
- Gennette TM [1968] RPC 148

Representation:

- Mr. Justin George (Ravindran & Associates) for the Applicants
- Mr. Paul Teo (Drew & Napier LLC) for the Opponents