

**IN THE MATTER OF REGISTERED TRADE MARK NOS T03/06306G &
T03/06307E**

**IN THE NAME OF
RAFFLES CORPORATE CONSULTANTS PTE LTD**

AND

**APPLICATIONS FOR DECLARATION OF INVALIDITY THEREOF BY
RAFFLES FINE ARTS AUCTIONEERS PTE LTD**

Before Principal Assistant Registrar Sandy Widjaja

8 January 2010

Trade Marks – *Applications for invalidation – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4) read with section 23 of the Trade Marks Act [Cap. 332] 1999 Rev. Ed.*

On 9 March 2007, the Applicants, Raffles Fine Arts Auctioneers Pte Ltd, filed their Applications for Declaration of Invalidity for two registered trademarks in the name of Raffles Corporate Consultants Pte Ltd, the Registered Proprietors, *viz* T03/06306G and T03/06307E in class 35 and class 36 respectively (“the Raffles Marks”). These marks comprise the sole word “Raffles” in plain capital font respectively. The certificates for registration for the Raffles Marks were issued on 14 December 2004 and 6 October 2003 respectively. The Applicants filed applications for declaration of invalidity on the basis that they had earlier rights via unregistered marks “Raffles” and “Raffles Fine Arts” (“Unregistered Marks”) used in relation to business consultancy and financial solutions (“Services”) such that the Raffles Marks would amount to passing off ie Section 23(3) read with Section 8(4) of the Trade Marks Act (Cap 332, 1999 Rev Ed) renumbered as Sections 8(7) of Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”). The Registered Proprietors on the other hand raised Section 24 as a defence, on the basis that the Raffles Marks had been in use since 1996 without any objections from the Applicants.

The Applicants were registered as at 13 November 1992 with the then Accounting & Corporate Regulatory Authority. Consistent with the description of the Applicants’ activities in the ACRA Instant Information, from the evidence lodged, it can be fairly concluded that the Applicants are reputable in the arts field which includes art auction

sale services. However it is also the Applicants' case that they also provide the Services from the very beginning since its formation.

It was deposed by Registered Proprietors that the Registered Proprietors and the companies and businesses within its group have all used the Raffles Marks since 5 September 1996 in relation to the services which they render, which include financial consultancy, secretarial services, book-keeping services and business management consultancy.

Held, disallowing the applications for declaration of invalidity:

1. In relation to the element of goodwill, firstly, the mark which is distinctive of the Services is "Raffles Fine Arts Auctioneers" and not "Raffles" per se. Secondly, taking into account of the relevant date, there are only a total of thirty transactions with a total billing in the amount of approximately SGD 165,000.00 in an eight year period. In relation to promotion of the Services, there are three posters which are relevant. The Applicants claimed that posters are re-used for publicity. However, aside from statements made by the Applicants in their statutory declarations, there is no other evidence to substantiate this fact. Taking into account the sales volume and the promotion of the Unregistered Marks, the Registrar is of the view that there is insufficient goodwill for the purposes of an action for passing off.
2. The element of misrepresentation is also not made out. The two marks (the Unregistered Marks and the Registered Marks) are different and cannot be said to be similar. There is also one reason which is peculiar in this instance. The word "Raffles" is commonly used in trade in Singapore. The public, being accustomed to names incorporating "Raffles" are likely to be more discerning of marks consisting of the word "Raffles". Thus the likelihood of confusion would be very remote.
3. As the first and second elements for the action for passing off are not made out, it is not necessary to consider if damage is made out in this instance. Thus the applications for declaration of invalidity fail under Section 8(7) read with Section 23.
4. In relation to Section 24 it is clear from the words of the provision that it is acquiescence (for a period of 5 years) of *use in the course of trade of a registered trade mark*. A natural and plain reading of the provision is that the use must be *use of a trade mark which has been registered*. Following the interpretation above, whether the relevant date is the date of application for registration or the date of completion of the registration procedure, in this instance, Section 24 is not made out since 5 years from the (earlier) date of application for registration ie 30 April 2003 will end on 30 April 2008 and the applications for declaration of invalidation were made on 9 March 2007. Therefore in either case, the Applicants are not barred from seeking for declarations of invalidity under Section 23.

Provisions of legislation discussed:

Trade Marks Act (Cap. 332) 1999 Rev. Ed. Sections 8(4), 23 and 24 renumbered as Sections 8(7), 23 and 24 of Trade Marks Act (Cap. 332) 2005 Rev. Ed.

Cases referred to:

Novelty Pte Ltd v Amanresorts Ltd and Another [2009] SGCA 13
Anheuser-Busch Inc v Budejovicky Budvar NP [1984] FSR 413 at 470
Harrods Ltd v R Harrod Ltd (1923) 41 RPC 74
CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550
Reckitt & Colman Products Limited v Borden Inc. [1990] RPC 341
Sir Robert McAlpine Ltd. V Alfred McAlpine Plc [2004] RPC 36
Phones 4U Ltd v Phone4u.co.uk Internet Ltd [2007] RPC 5
Ravenhead Brick Co Ltd v Ruabon Brick & Terra Cotta Co Ltd (1937) 54 RPC 341
Sabel BV v Puma AG [1998] RPC 199
Lego Systems Aktieselskab v Lego M Lemelstrich Ltd [1983] FSR 155
Nation Fitting (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR 712
Brestian v Try [1958] RPC 161
Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133
Chelsea Man Menswear Limited v Chelsea Girl Limited and Another [1987] RPC 189
Sunrider Corporation (t/a Sunrider International) v VITASOY International Holdings Ltd [2007] RPC 641
Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik [2008] All ER (D) 274 (Feb)
WILD CHILD TM [1998] RPC 445
N.V. Sumatra Tobacco Trading Company v Reemsta Cigarettenfabriken GMBH [2006] SGIPOS 1
AG Spalding & Bros v. AW Gamage Ltd [1915] 32 RPC 273
Society of Motor Manufacturers & Traders Ltd v. Motor Manufacturers' & Traders' Mutual Insurance Co Ltd [1925] Ch 675
Future Enterprises Pte Ltd v McDonald's Corp [2007] SGCA 18

Representation:

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