

IN THE MATTER OF REGISTERED TRADE MARK NO T05/25465Z

**IN THE NAME OF
ROMANSON CO., LTD**

**AND
OPPOSITION THERETO BY
FESTINA LOTUS, S.A.**

Before Principal Assistant Registrar Sandy Widjaja

10 November 2009

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.

The Applicants, Romanson Co., Ltd. (“Applicants”) filed a trade mark application for the mark shown below, T05/25465Z, for goods in class 14 (“Application Mark”) on 16th December 2005:-


J.ESTINA

The Application Mark was then accepted and advertised in the Trade Marks Journal on 24th May 2006.

The Applicants were established in April 1998 as a manufacturer of watches. Having successfully established its watch business, the Applicants ventured into the jewellery

market in 2002 as part of its growth and development. As part of the process of the launch of the new line of business, the Applicants came up with a name for the new line of business culminating in a mark (“Trade Mark” which is identical with the Application Mark).

The Opponents, Festina Lotus, S.A. (“Opponents”) were founded in Switzerland in 1902 and is the owner of various trade mark registrations in Singapore in Classes 14, 3, 9, 18, 25 and 16. In particular, the Opponents’ class 14 mark is as follows:-



The Opponents are one of the world’s leading maker and retailer of watches and other fashionable timepieces. The opposition proceeded on three grounds, namely, Sections 8(2)(b), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev. Ed). It was the Opponents’ case that the marks and goods are similar, and that they have reputation and goodwill in the business locally. The Opponents’ case is also that the Applicants have filed the application in bad faith as the Applicants must have known of the Opponents’ brand “FESTINA” due to the successful sales of the Opponents’ watches internationally, in particular, Hong Kong and Japan.

Held, allowing the application mark to proceed to registration:

1. Under the ground of opposition under Section 8(2)(b), only the earlier mark in class 14 is relevant. The goods in the other classes cannot be said to be similar to that of the Application Mark such that these marks of the Opponents cannot be considered to be earlier marks.
2. The Opponents’ class 14 mark and the Application Mark are visually and conceptually dissimilar although they are aurally similar. In terms of visual similarity, “J. Estina” is a dominant aspect of the Application Mark. This is because the word “J.Estina” constitutes half or more of the Application Mark. The crown device is much smaller in relation to the word “J.Estina”. The Opponents’ class 14 mark on the other hand has the word “Festina” subsumed within the crest which forms the dominant part of the mark. In relation to conceptual similarity, the use of crests is considered to be a design element which lends a “high-class” look to a mark design. This is not so for a device of a crown which connotes the idea of royal patronage.
3. In relation to the element of the likelihood of confusion, taking into account of all relevant surrounding circumstances, including the nature of the goods, the price of the goods, the nature of the consumers, the nature of the industry and the respective trade channels, as well as the steps taken by the Applicants to differentiate their goods from the Opponents, there is no likelihood of confusion. The goods in question can be considered as fashion statements and

- thus they are not normally bought at whim. The consumers of such personal items would also be a conscious and discerning lot. It is also common for consumers of such goods to exercise some form of brand loyalty and this further reduces the likelihood of confusion. As there is a proliferation of different brands in the watch industry, consumers will also be more cautious in their selection to ensure that they are purchasing the product that they are looking for. In relation to the trade channels, the mode of sale of the goods via different counters at departmental stores is such that the visual element of the mark is the main differentiating factor. Since it has been decided that the marks are visually dissimilar, this factor will also lessen the likelihood of confusion. Last but not least, the Applicants have taken steps to differentiate their goods from that of the Opponents such that the images that are portrayed by the respective marks are different.
4. Under the ground of opposition under Section 8(7)(a), the element of goodwill is not made out. It is clear from the evidence that the Opponents have no business presence in Singapore. There is no evidence of any sales or promotion in Singapore. Further, the various registration certificates and invoices in the different countries may not pertain to the Opponents' class 14 mark. For the same reasons, that there is no likelihood of confusion under Section 8(2)(b), there will also be no misrepresentation if the Application Mark is used.
 5. In relation to the ground of opposition under Section 7(6), the actions of the Applicants are not sufficient to show that the Applicants fell short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant area of trade and are thus insufficient to make out a case of bad faith.

Provisions of legislation discussed:

Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 8(2)(b), 8(7)(a) and 7(6)

Cases referred to:

Sabel BV v Puma AG [1998] ETMR 1
Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999] ETMR 690
Canon Kabushiki Kaisha v Metro Goldwyn-Mayer Inc [1999] ETMR 1
British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281
Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 402
Mobil Petroleum Company Inc v Hyundai Mobis [2008] SGHC 104
Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co., Ltd [2008] SGIPOS
Hyundai Mobis v Mobil Petroleum Company Inc [2007] SGIPOS 12
Nation Fittings (M) Sdn Bhd v Oystertec PLC [2006] 1 SLR 712
The Polo/Lauren Co., LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690
Zing Trade Mark [1978] RPC 47
Roamer Watch v African Textile Distributors [1980] RPC 457

Aristoc v Rysta (1945) 60 RPC 87
Pianotist Co.'s Application (Pianola) (1906) 23 RPC 774
Meidi (M) Sdn Bhd v Meidi-Ya Co Ltd Japan & Anor [2008] 1 CLJ 46
Newsweek v BBC [1979] RPC 441
London Lubricants (1925) 42 RPC 264
McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
Reckitt & Colman Products Ltd v Borden Ltd [1990] RPC 341
Alteco Chemical Pte Ltd v Chong Yean Wah t/a Yamayo Stationery Manufacturer
[2000] 1 SLR 119
Erven Warnink v Townsend & Sons [1979] 3 WLR 68
Syarikat Zamani Hj Tamin & Anor v Yong Sze Fun & Anor [2006] 5 MLJ 262
Burberry's v JC Cording & Co. Ltd [1909] 26 RPC 693
Star Industrial Co Ltd v Yap Kwee Kor [1976] 2 FSR 256
Future Enterprise Pte Ltd v Tong Seng Produce Pte Ltd [1998] 1 SLR 1012
Gromax Plasticulture v Don & Low Nonwovens Ltd [1999] RPC 367
Demon Ale Trade Mark [2000] RPC 345

Representation:

Ms. Teresa O'Connor (Infinitus Law Corporation as instructed by Henry Goh (S) Pte Ltd)
for the Opponents

Ms. Shanti Jaganathan (Harry Elias Partnership) for the Applicants

[The appeal from this decision to the High Court has been successful.]