

**IN THE HEARINGS AND MEDIATION DIVISION OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T0900197G  
5 July 2011

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**IDM APPAREL PTE LTD**

**AND**

**OPPOSITION THERETO BY**

**CALVIN KLEIN TRADEMARK TRUST**

Hearing Officer: Ms Lee Li Choon  
Principal Assistant Registrar of Trade Marks

Mr Samuel Seow with Ms Desiree Toh (Samuel Seow Law Corporation) for the Applicants  
Ms Eunice Ng (Drew & Napier LLC) for the Opponents

*Cur Adv Vult*

**GROUND OF DECISION**

1 IDM Apparel Pte Ltd ("the Applicants"), applied to protect the trade mark,



**Gioven Kelvin**  
PARIS

("Application Mark") in Singapore on 5 January 2009 in Class 24 in respect of "Banners; bath linen (except clothing); bed blankets; bed clothes; bed covers; bed linen; bedspreads; blinds of textile; coasters (table linen); coverings of plastic for furniture; covers for cushions; curtain holders of textile material; curtains of textile or plastic; door curtains; drugget; fabrics for textile use; face towels of textile; frieze (cloth); furniture coverings of textile; gauze (cloth); haircloth (sackcloth); handkerchiefs of textile; hemp cloth;

household linen; jersey (fabric); knitted fabric; labels (cloth); linen cloth; linings (textile); mattress covers; non-woven textile fabrics; pillowcases; place mats of textile; quilts; sanitary flannel; sheets (textile); sleeping bags (sheeting); table cloths (not of paper); table linen (textile); table mats (not of paper); table napkins of textile; tapestry (wall hangings), of textile; all included in Class 24."

2 The application was accepted and published on 20 February 2009 for opposition purposes. Calvin Klein Trademark Trust ("the Opponents"), filed their Notice of Opposition to oppose the registration of the Application Mark on 5 June 2009. The Applicants filed their Counter-Statement on 5 October 2009.

3 The Opponents filed evidence in support of the opposition on 12 May 2010. The Applicants filed evidence in support of the application on 13 September 2010. The Opponents filed their evidence in reply on 19 January 2011. On 7 March 2011, both the Opponents and the Applicants informed the Registrar that they are proceeding with the opposition hearing. Pursuant to that, the opposition was heard on 5 July 2011.

### **Grounds of Opposition**

4 The Opponents rely on section 7(6), section 8(2)(b), section 8(4)(a) and (b)(i), section 8(4)(b)(ii)(A), section 8(4)(b)(ii)(B) and section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this opposition.

### **Opponents' Evidence**

5 The Opponents' evidence consists of the Statutory Declaration executed by Deirdre Miles-Graeter, Vice President of Licensing and Business Affairs of Calvin Klein, Inc in New York on 29 March 2010 and filed on 12 May 2010 as well as the Statutory Declaration in Reply executed by the same Deirdre Miles-Graeter in New York on 10 January 2011 and filed on 19 January 2011.

### **Applicants' Evidence**

6 The Applicants' evidence consists of the Statutory Declaration executed by Tan Cha Boo, Director of the Applicants on 9 September 2010 and filed on 13 September 2010.

### **Applicable Law and Burden of Proof**

7 The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed)("the Act"). Under the Act, there is no overall onus on the Applicants either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

### **Background**

8 The Opponents, Calvin Klein Trademark Trust, is a business organised and existing under the laws of the State of Delaware, USA. The Opponents are the proprietor of the "CK" and "Calvin Klein" trade marks in Singapore and throughout the world. In Singapore, the

Opponents have obtained registration for several "CK", "CK-related", "Calvin Klein" and "Calvin Klein-related" marks including the following:

 (T8902964D) in Class 25;
  (T9601578E) in Class 24;
  (T9508639E) in Class 24;
 Calvin Klein (T9508651D) in Class 24.

9 The Opponents' "CK" marks were first used in Singapore in 1986. The Opponents' "CK" marks have been used worldwide for more than 40 years and their first use in the United States was in 1968. The worldwide sales turnover of goods bearing the Opponents' "CK" marks is in the region of billions of dollars and the Opponents spend up to \$300 million or more annually in advertising expenditure worldwide, including Singapore.

10 The Applicants are the owner of the following marks which are registered:

- (a)  (T0302036H) in Class 25
- (b)  (T0308963E) in Class 25
- (c)  (T0312789H) in Class 25
- (d)  GIOVEN KELVIN (T0507392B) in Class 25
- (e)  GIOVEN KELVIN (T0722899J) in Class 14
- (f)  Gioven Kelvin (T0804508C) in Class 18
- (g)  Gioven Kelvin (T0905248B) in Class 25
- (h) **GIOVEN KELVIN** (T0006472J) in Class 25
- (i)  Gioven Kelvin (T1006627J) in Class 25

11 Prior to filing the application for registration of the Application Mark, the Applicants have already used the Application Mark to represent their business and promoted it to

distinguish it from other businesses. In particular, the marks (a) to (f) above were filed and registered before the date of application of the Application Mark.

## GROUNDS OF DECISION

### MAIN DECISION

#### Ground of Opposition under Section 8(2)(b)

12 Section 8(2)(b) of the Act reads:

##### **“Relative grounds for refusal of registration**

**8.** —(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(b) it 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, there exists a likelihood of confusion on the part of the public.”

#### *Opponents’ Submissions*

13 The Opponents rely on their earlier registrations  T8902964D in Class 25,



(T9601578E) in Class 24,



(T9508639E) in Class 24 and



(T9508651D) in Class 24 for this ground of opposition. The

Opponents' case is that the Application Mark is visually and conceptually similar to the Opponents earlier registrations because of the following:

- (a) The distinctive and dominant element of the Application Mark is the letters "GK" which is similar to the Opponents' marks which essentially comprise the letters "CK".
- (b) The Application Mark contains two letters, "G" and "K" whilst the Opponents' marks also contain two letters, "C" and "K".
- (c) The first letter "G" in the Application Mark is closely similar to the first letter "C" in the Opponents' marks.
- (d) The second letter "K" in the Application Mark is identical and prominently displayed inside the letter "G" in the Application Mark, just

like the Opponents' mark,



- (e) The words "Gioven Kelvin" in the Application Mark are visually similar to the words "Calvin Klein".
- (f) The Application Mark is conceptually similar to the Opponents "Calvin Klein" marks.

14 As for aural similarity, the Opponents' case is that the letters "GK" in the Application Mark sound very close to the letters "CK" in the Opponents' marks. Further, the word "Kelvin" in the Application Mark is phonetically identical to the word "Calvin" in the Opponents' "Calvin Klein" marks.

15 The Opponents argue that there is an overlap between the Class 24 goods of the Application Mark and the Class 24 goods registered in the Opponents' marks. As for Class 25 goods, the Opponents' case is that the goods are similar when they are compared by their uses, users, physical nature and trade channels.

16 The Opponents thus say that there is a likelihood of confusion. Further, the Opponents urge the Registrar to find likelihood of confusion by taking into account the common practice of fashion designers expanding their fashion lines beyond clothing into bed linen, citing *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 3 SLR 147 and *In the Matter of Application No.2402450 by Pucci Petwear Ltd to Register the Trade Mark "PUCCI" in Classes 6,20 and 21 and Opposition Thereto Under No.94664 by Emilio Pucci SRL* (0-024-08) in support of their case.

### ***Applicants' Submissions***

17 The Applicants argue that the burden of proof is strictly on the Opponents. The Applicants urge the Registrar to reach the conclusion that the Application Mark is visually, aurally and conceptually different from the Opponents' marks when a comparison of the Application Mark and each of the four earlier registrations is done. Specifically, the Applicants' response is that the Application Mark consists of several distinctive and dominant components, including the words "Gioven Kelvin" which are very different from the Opponents' marks. The Applicants urge the Registrar to consider that in comparison of marks, the principle is to take the Application Mark as a whole and that there should not be nitpicking for similarities in the individual parts of the mark.

18 The Applicants also submit that the goods registered for the Opponents' mark  are different from the goods sought to be registered for the Application Mark when compared on their respective uses, users, physical nature and respective trade channels.

19 Further, the Applicants argue that there are differences between the market positioning of the Application Mark and the Opponents' marks in that the Application Mark and the Opponents' marks are used on products which are entirely different in pricing and positioning. The Applicants' trade is in mass-produced and mass-priced items sold at heartland stalls and outlets targeted at lower-middle income consumers whilst the Opponents' marks are targeted towards the higher income consumer. Thus, the Applicants say that there is no likelihood of confusion. The Applicants also point to their own registrations for various "Gioven Kelvin" and "GK Gioven Kelvin" marks and say that they have established their own branding and goodwill and therefore, there is no likelihood of confusion.

**Decision on Section 8(2)(b)**

*Criteria under Section 8(2)(b)*

20 An “earlier trade mark” is defined in Section 2 as follows:

“**earlier trade mark**” means –

a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks;”

The Opponents rely on the following earlier marks in Classes 24 and 25 for this ground of opposition:

- (i)  (T8902964D) in Class 25 in respect of "*Suits, jackets, blazers, pants, jeans, coats, shirts, vests, sweaters, belts, ties, underwear, pyjamas and socks, all for men and boys; skirts, shirts, blouses, jackets, pants, jeans, coats, vests, dresses, sweaters, shorts, scarves, belts, night gowns, robes, underwear, stockings, tights and socks, all for women and girls; all included in Class 25*", registered as from 11 May 1989.
- (ii)  (T9601578E) in Class 24 in respect of "*Textiles; fabric; linens; sheets; towels; bedspreads; shams; blankets; pillow cases; comforters; duvets; dust ruffles; all included in Class 24*", registered as from 12 February 1996;
- (iii)  (T9508639E) in Class 24 in respect of "*Textiles; fabrics; linens; sheets; towels; bedspreads; shams; blankets; pillow cases; comforters; duvets; dust ruffles; all included in Class 24*", registered as from 11 September 1995; and
- (iv) **Calvin Klein** (T9508651D) in Class 24 in respect of "*Textiles; fabrics; linens; sheets; towels; bedspreads; shams; blankets; pillow cases; comforters; duvets; dust ruffles; all included in class 24*", registered as from 11 September 1995.

21 As the above marks ("Opponents' marks (i), (ii), (iii) and (iv)") are all registered before the date of application of the Application Mark, all of them qualify as "earlier marks" within the definition of Section 2.

21 As for the requirements under section 8(2)(b), the test is that as enunciated by the Court of Appeal in the *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("**Polo/Lauren**") ([8]-[9]) for section 27(2)(b) of the Act (the requirements for infringement under section 27(2)(b) are the same as those under the relative grounds for refusal of registration in section 8(2)(b) (see also [15] of the *Polo/Lauren*)). The Court of Appeal adopted the test in *British Sugar PLV v James Robertson & Sons Ltd* [1996] RPC 281 ("**British Sugar**") and held that the following conditions must be present. I will paraphrase the conditions for the instant case under consideration. First, the Application Mark,



„**Gioven Kelvin**„  
PARIS must be shown to be similar to the Opponents' earlier marks (i), (ii), (iii) and (iv). Second, the Application Mark and the Opponents' earlier marks (i), (ii), (iii) and (iv)

must be used in relation to similar goods. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. On the question of similarity, it is a matter of degree. The greater the similarity between the two marks, the greater the likelihood of confusion will be. However, if either of the first two conditions is not satisfied, there will not be any need to go into the third question of determining whether there exists a likelihood of confusion.

22 The Court of Appeal also said at [25]-[26] that it does not necessarily follow that just because the marks are similar and the goods are similar, confusion will automatically arise. In assessing the question of likelihood of confusion, regard must be had to extraneous factors such as trade practices. At [28], the Court of Appeal also pointed out other important factors such as steps taken by by the *Applicants* to differentiate his goods from those of the *Opponents* and the kind of customer who would be likely to buy the goods of the *Applicants* and *Opponents* have to be taken into consideration in assessing whether there is a likelihood of confusion.

23 On similarity between the marks, the comparison is as to their visual, aural and conceptual similarities. As for similarity of goods, the test is that as held in *British Sugar* ([296]) which has been followed in all our local cases. The following factors may be used to assess if the goods are similar:-

- (a) the respective uses of the goods;
- (b) the respective users of the goods;
- (c) the physical nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) for self-serve consumer items, whether in practice they are found or likely to be found, in particular, on the same or different shelves; and
- (f) the extent to which the respective goods are competitive.

24 In comparing the marks, I have to compare the Application Mark as applied for and the Opponents' earlier marks as registered.

*Visual Comparison between Application Mark and Opponents' mark (i)*



25 Visually, the Application Mark,  contains a juxtaposition of elements which appear to be the letters "G" and "K" to provide a stylistic effect or to essentially form a device element. In addition, the Application Mark contains the words, "Gioven Kelvin" prominently placed below the juxtaposition. Opponents' mark (i), on the other hand, does not contain any word. Opponents' mark (i) contains solely a device component which may also be said to be a juxtaposition of elements which appear loosely to be the letters "C" and "K".

26 Looking at Opponents' mark (i), it appears to be a device mark at a quick glance. One will have to examine the mark a little more closely to realise that the mark could be a juxtaposition of elements and the elements could have been intended to be the letters "C" and

"K". The reason why I say that Opponents' mark (i) appear to be a device mark is because the device exists devoid of other elements; the juxtaposition of the letters is such that the letters are no longer immediately recognizable as mere letters individually; and the letter "k" with its long stem is a distorted "k", even if it is meant to be the letter "K". In the Application Mark, there is also a device seemingly consisting of the letters "G" and "K", also in a juxtaposition in such a way that it forms a device. It is also not immediately clear that the device consists of letters "G" and "K" unless one examines the mark a little more closely. The juxtaposition of the letters "G" and "K" is in a similar fashion to the juxtaposition of the elements in Opponents' mark (i). As the letters "G" and "C" are also visually similar, the device consisting of the letters "G" and "K" within the Application Mark bears some similarity to Opponents' mark (i). However, I need to consider the Application Mark as a whole. As a whole, the Application Mark bears the words "Gioven Kelvin" in addition to the device as described. Although the device in the Application Mark is striking and distinctive, as the Application Mark contains words, visually, the words will appear prominently and further, in the context of those words, the device will also be seen more clearly as a device or juxtaposition of the letters "G" and "K" as these letters are the initials of the words in the mark, "Gioven" and "Kelvin". Opponents' mark (i) on the other hand, has no words. As such, it will be seen as a device rather than the letters "C" and "K". Even if one were to decipher the letters in the device, to one, the mark may appear as "CK" (the letter "C" followed by the letter "K"), to another, the mark may appear as "KC" (the letter "K" within the letter "C" and as such be remembered as "KC" rather than "CK"). Thus, on the whole, the Application Mark is visually different from Opponents' mark (i).



*Visual Similarity between Application Mark and Opponents' mark (ii)*

27 Comparing Opponents' mark (ii) and the Application Mark visually, whilst Opponents' mark (ii) is seen clearly as the letters "C" and "K" together, with the letter "C" followed by the letter "K", the Application Mark's letters form a device or juxtaposition that appears very different. Further, as the words "Gioven Kelvin" are prominently displayed in the Application Mark, the letters would be seen as "G" and "K", the initials of "Gioven" and "Kelvin" respectively, if one sees the letters in the device. The letters in the Application Mark are therefore also different from the letters in Opponents' mark (ii). On the whole, the Application Mark and Opponents' mark (ii) are visually different.



*Visual Similarity between Application Mark and Opponents' mark (iii)*

28 Opponents' mark (iii) is like the Application Mark in that both are composite marks comprising two words and two letters of the alphabet. However, in the Application Mark, the letters form a unique device which appear visually different from the letters "C" and "K" in Opponents' mark (iii) which are clearly the letters "C" and "K". Further, the words in the Application Mark ("Gioven Kelvin") are very different from the words ("Calvin Klein") in Opponents' mark (iii). The Application Mark and Opponents' mark (iii) are clearly visually different.

*Visual Similarity between Application Mark and Opponents' mark (iv)* Calvin Klein

29 As for Opponents' mark (iv), the words "Calvin Klein" look very different from the words, "Gioven Kelvin" in the Application Mark. Further, the Application Mark contains a device made up of the letters, "G" and "K" above the words whereas Opponents' mark contains only the words "Calvin Klein". Therefore, the Application Mark is also very visually different from Opponents' mark (iv).

30 On the whole, the Application Mark is visually different from all of the Opponents' earlier marks.

*Aural Similarity between Application Mark and Opponents' marks (i), (ii), (iii), (iv)*

31 In relation to aural similarity, the Opponents' earlier marks are "CK" in mark (ii), "CK Calvin Klein" in mark (iii) and "Calvin Klein" in mark (iv). In Opponents' mark (i), as the mark consists only of a component that looks more like a device than a juxtaposition of letters "C" and "K", the mark may not be compared aurally. Even if Opponents' mark (i) were to be described aurally, it will be described as "CK". The Application Mark, on the other hand, sounds aurally as "GK Gioven Kelvin". That is very different from either "CK" or "CK Calvin Klein" or "Calvin Klein". As a whole, as the Application Mark contains the words, "Gioven Kelvin" which are very different words from the Opponents' "Calvin Klein", the Application Mark and the Opponents' earlier marks (i), (ii), (iii) and (iv) are aurally different.

*Conceptual Similarity between Application Mark and Opponents' marks (i), (ii), (iii), (iv)*

32 Conceptually, the Application Mark may be remembered as the letters "GK" with the name, "Gioven Kelvin". Opponents' mark (i) may be remembered as a device. Opponents' mark (ii) will be the letters "CK", Opponents' mark (iii) will be the letters "CK" and the name, "Calvin Klein" and Opponents' mark (iv) will be the name, "Calvin Klein". As a name, "Gioven Kelvin" is very different from "Calvin Klein". From this comparison, I conclude that there is no conceptual similarity.

*Comparison of the marks on the whole*

33 In the above, I have found that the device consisting of the letters "G" and "K" within the Application Mark bears some similarity to Opponents' mark (i). Other than that, there is no visual, aural or conceptual similarity between the Application Mark and the Opponents' earlier marks. Accordingly, on the whole, by comparing the marks per se, my conclusion is that the Application Mark is not similar to any of the Opponents' earlier marks.

*Similarity of Goods*

34 As the goods in Opponents' marks (ii), (iii) and (iv) are in the same Class 24 as the goods in the Application Mark and as the category of goods for both Application Mark and the Opponents marks (ii), (iii) and (iv) is the same general category of bedding goods, the goods overlap and are definitely similar. As for Opponents' mark (i), this mark has been registered for Class 25 goods which are essentially clothing items. The goods in both Class 24 and Class 25 are goods generally made of fabric or cotton and therefore have a similar physical nature. The trade channels are also the same, being generally, departmental stores. I also take into consideration the knowledge that it is not an uncommon practice for traders to expand their fashion lines from clothing to home fashion. In conclusion, the goods sought to

be registered under the Application Mark are similar to the goods registered for the Opponents' earlier marks.

### *Likelihood of Confusion*

35 Section 8(2)(b) requires that the likelihood of confusion has to arise from the identity or similarity between the Application Mark and the Opponents' earlier trade marks as well as from the identity or similarity between the goods. As I have found that the Application Mark and the Opponents' earlier trade marks are not similar on the whole, although the marks are used on goods which are similar, there is no likelihood of confusion. It is not necessary for me to look at the surrounding circumstances to assess whether there is a real likelihood of confusion. The Court of Appeal in *Polo/Lauren* states ([8]), "*First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public..., if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion.*"

### *Conclusion*

36 In conclusion, I find that there is no real likelihood of confusion amongst the relevant consumers as to the source of the Applicants' goods if the Application Mark is allowed to proceed to registration because the Application Mark is on the whole not similar to any of the Opponents' earlier registered marks. Accordingly, the opposition under section 8(2)(b) fails.

### **Ground of Opposition under Section 8(4)**

37 Section 8(4)(a) of the Act reads:

#### **“Relative grounds for refusal of registration**

**8.** — (4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
  - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
  - (ii) if the earlier trade mark is well known to the public at large in Singapore –
    - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
    - (B) would take unfair advantage of the distinctive character of the earlier trade mark."

### ***Opponents' Submissions***

38 The Opponents' case is that the Application Mark is similar to the Opponents' marks, in particular, the marks containing the letters, "C" and "K" or "CK". The Opponents also argue that from their evidence, they have shown that, as at the application date of 5

January 2009, the "CK" trade marks are well known to the relevant sector of the public who are consumers who will buy textiles, fabric, linens, sheets, towels, bedspreads, comforters, pillow cases, blankets and such. The Opponents say that the Applicants have made a misrepresentation to the actual and potential consumers of the Opponents' goods and there is a likelihood of confusion such that this group of consumers would be misled into thinking that the Applicants' goods originate from the Opponents or that there is a connection between them. On the ground of opposition under section 8(4)(b)(ii), the Opponents say that their evidence clearly shows that the "CK" trade marks are also well known to the public at large in Singapore. The Opponents submit that there would be "blurring" and therefore, dilution because, the distinctiveness of the Opponents' "CK" marks would be eroded over time as the registration and use of the Application Mark may potentially open the floodgates for the registration and use of other marks that are confusingly similar to the Opponents' "CK" trade marks.

### ***Applicants' Submissions***

39 The Applicants' response is that the Application Mark is very different from any of the Opponents' earlier trade marks. Thus, this ground of opposition cannot be made out. The Applicants also argue that the Opponents have not lodged a single shred of evidence on sales and marketing revenue for Singapore in relation to Class 24 goods and therefore, the Opponents have failed to show that the Opponents' marks are well known to the relevant sector of the public or well known to the public at large for Class 24 goods. The Applicants also say that it is highly unlikely that the actual or potential customers of the Opponents' Class 25 goods would be misled into thinking that the goods bearing the Application Mark originate from the Opponents or that there is some connection between the two parties, an ingredient that is necessary to establish the ground of opposition under section 8(4)(b)(i). On the ground of opposition under section 8(4)(b)(ii), the Applicants say that there is no unfair advantage as the Application Mark is very different and there is no evidence of the Applicants free-riding on the coat tails of a famous mark. The Applicants further argue that there is no dilution because, in addition to the marks being so different, the Opponents have also consented to or otherwise acquiesced with the registrations of the Applicants' marks bearing the words "Gioven Kelvin" for many years.

### ***Decision on section 8(4)(b)(i)***

40 The first requirement under section 8(4) is that the whole or an essential part of the Application Mark has to be identical with or similar to the Opponents' earlier marks. On this requirement, I have stated above that the Application Mark is on the whole not similar to any of the Opponents' earlier marks. However, I have alluded to my finding of some degree of similarity between the device comprising the letters "G" and "K" in the Application Mark and Opponents' mark (i). I shall just focus on the comparison between the Application Mark and Opponents' mark (i) for the purpose of assessing the ground of opposition under section 8(4)(b)(i) as it is not required that the whole of the Application Mark be similar but that only an essential part of the Application Mark be similar. As for Opponents' marks (ii), (iii) and (iv), as there is hardly any similarity at all, it is not necessary for me to assess these earlier registrations for this ground of opposition since the first requirement of similarity in relation to an essential part of the Application Mark is not even made out.

41 As the device comprising the juxtaposition of the letters "G" and "K" in the Application Mark is prominently displayed above the words "Gioven Kelvin", it is clear that

the device in the Application Mark forms a distinctive component of the mark as well. Thus, the device is an essential part of the Application Mark.

42 On this aspect, I find that indeed, the device which forms an essential part of the Application Mark is similar to Opponents' mark (i) as the juxtaposition of the letters "G" and "K" appears very similar to the juxtaposition of the letters "C" and "K" in Opponents' mark (i). Further, the visual representation of the letter "G" in the Application Mark appears very similar to the visual representation of the letter "C" in Opponents' mark (i). When described aurally, the device in the Application Mark will be described as "GK" which sounds similar to "CK", if the device in Opponents' mark (i) is to be described aurally. Thus, an essential part of the Application Mark is similar to Opponents' mark (i).

43 I will now proceed to deal with the ground of opposition under section 8(4) in two parts – first, under section 8(4)(b)(i) which requires the earlier trade mark (Opponents' mark (i)) to be well known in Singapore and second, under section 8(4)(b)(ii) which requires the earlier trade mark (Opponents' mark (i)) to be well known to the public at large in Singapore.

44 As stated by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") ([229]), "*In recognition of the fact that many trade marks are potentially "well known in Singapore", Parliament has granted such trade marks only one advantage over ordinary trade marks, namely, the former are protected from registration and/or the use of identical or similar trade marks on dissimilar goods or services – such protection takes the form of protection covered by the "damaging connection" condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA*", the ground of opposition under section 8(4)(a) and (b)(i) is applicable where the marks are either identical or similar but in relation to dissimilar goods or services. In this case, the Opponents' mark (i) is registered for Class 25 goods and the Application Mark is applied for Class 24 goods. As there is no requirement that the goods be similar under this ground of opposition, it does not matter whether I find the goods to be similar or not, although, as I have found in the above, the goods of the Application Mark and the goods of Opponents' mark (i) are similar.

45 Having established that an essential part of the Application Mark is similar to Opponents' mark (i), the elements that have to be established before registration shall be refused under section 8(4)(b)(i) are:

- (i) that the Opponents' mark (i)  is well known in Singapore; and
- (ii) that the Applicants' use of  in relation to Class 24 goods would indicate a *connection* between the Applicants' products and the Opponents and is *likely to damage* the interests of the Opponents.

Is the Opponents' mark (i)  well known in Singapore?

46 Section 8(5) provides, "A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith." From this provision, it is clear to me that I have to assess whether the

Opponents' mark (i)  was well known in Singapore as at the application date of the Application Mark, that is, 5 January 2009 as section 8(4) only blocks registration of a trade mark vis-a-vis an earlier trade mark that is already well known in Singapore at the time of the filing of the said trade mark.

47 In assessing whether a trade mark is “well known in Singapore”, the matters in section 2(7) may be relevant. Section 2(7) states:

“Subject to subsection (8), in deciding, for the purposes of this Act, *whether a trade mark is well known in Singapore*, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of –
  - (i) any use of the trade mark; or
  - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.”

48 It is clear that the factors listed in section 2(7) above are not an exhaustive list as section 2(7) makes it explicit that it shall be relevant to “take into account *any* matter from which it may be inferred that the trade mark is well known”. The Court of Appeal in *Amanresorts* at [137] said that the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires (subject to one particular factor which will be elaborated on later), and to take additional factors into consideration. Thus, it is clear that the factors in section 2(7) (with the exception of the factor in section 2(7)(a) which has a deeming effect in section 2(8)) are merely a set of guidelines to assist the Registrar in determining whether the mark is a well known trade mark. Section 2(7)(a), however, has a special effect. This is because of section 2(8) which states that, “Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be *deemed to be well known* in Singapore.” As stated in *Amanresorts* ([140]), once it is determined that the trade mark in question *is well known to “any relevant sector of the public in Singapore”* (emphasis mine), the deeming provision in section 2(8) kicks in and *the mark is deemed to be well known in Singapore*. The High Court in *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 (“*Ferrero*”) at [158] quoting the Court of Appeal in *Amanresorts* at [139], also held that in determining whether a trade mark is well known in Singapore, the *most crucial factor* is that set out in section 2(7)(a) of the Act, viz, “the degree to which the trade mark is known to or recognised by any relevant sector of the

public in Singapore”. Thus, it is very clear that, if Opponents' mark (i)  is well known

to the relevant sector of the public in Singapore, Opponents' mark (i)  shall then be deemed to be well known in Singapore.

49 It shall first be considered as to the “degree to which the Opponents’ mark  is known to or recognised by any relevant sector of the public in Singapore”. In section 2(9), “relevant sector of the public in Singapore” in section 2(7) and 2(8) includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods to which the trade mark is applied.

As for the ambit of “all actual consumers and potential consumers in Singapore of the goods”, the Court of Appeal in *Amanresorts* has settled this issue as “the actual consumers and potential consumers of, specifically, the [*Opponents*] goods only (([142] to [154]), specifically, [154]). Applying the law to the facts of this case, the relevant sector of the public would be actual and potential consumers in Singapore of the Opponents’ goods, that is,

consumers who will buy Opponents' clothing items bearing the  mark. The question is,

is  well known to this “relevant sector of the public”? And the relevant point in time to determine this question is 5 January 2009.

50 The Opponents' evidence shows that the Opponents own registrations for the  mark in Hong Kong (1994B02501), United Kingdom (1359536) and United States of America (1439226). Other than these registrations mentioned, the other registrations owned by the Opponents are for "CK" in their usual representation (such as in Opponents mark (ii)), for "CK Calvin Klein" (such as in Opponents' mark (iii)) and for "Calvin Klein" (such as in Opponents' mark (iv)). The Opponents cited impressive worldwide annual sales turnover in the region of \$2 to \$3 billion in the few years leading to January 2009. However, it is not

clear as to how much of the amount of sales turnover relates to use of the  mark by the Opponents, if there is any. From the Opponents' evidence (especially copies of advertisements in Exhibit "DMG-8" of the Opponents' SD), I do not see any shred of

evidence relating specifically to use of the  mark by the Opponents. There is no doubt a lot of use of the Opponents' "CK" and "Calvin Klein" marks (represented in a manner similar to Opponents' mark (ii), (iii) and (iv) above) worldwide. But, there is no evidence of use of

the  mark at all, whether worldwide or in Singapore.

From the Opponents' evidence, I am unable to conclude that there is a lot of use of the



mark and that the  mark is well known to actual and potential consumers in Singapore of the Opponents' goods.

Therefore, I am not able to conclude that the Opponents'  mark is well recognised by the relevant sector of the public and therefore well known in Singapore.

51 Weighing all the other factors in section 2(7)(b)-(e) and taking into consideration the

fact that the evidence shows that the Opponents own registrations for the  mark only in three jurisdictions other than Singapore, I am also not convinced that the other factors point

to the Opponents'  mark being well known to the relevant sector of the public in Singapore and therefore, well known in Singapore.

*Is there a damaging connection between the Applicants' goods and the Opponents*

52 As the Opponents'  mark has not been found to be a well known mark in Singapore, it is not necessary for me to move on to the other requirements that need to be established under this ground of section 8(4)(b)(i), namely, that use of the Application Mark on the goods sought to be registered would indicate a connection between the goods claimed and the Opponents and that the interests of the Opponents are likely to be damaged as a result. The Court of Appeal in *Amanresorts* ([161]-[177], [229] and [233]) held that the term "connection" in section 55(3) which is in *pari materia* to section 8(4)(b)(i) does not mean mere connection, but a connection which is likely to give rise to confusion. In *Amanresorts*, the Court of Appeal in *Amanresorts* ([75]-[76]) noted that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [Opponents'] interests" requirement would yield the same results as those obtained from applying the corresponding tests vis-à-vis the claim for passing off which are, whether the [Applicants] have made a misrepresentation to the relevant sector of the public which causes that section of the public to mistakenly think that the [goods] have the same source as or is connected with the [Opponents'] [goods], and whether such misrepresentation has resulted in or is likely to result in damage to the interests of the Opponents. As settled in *Amanresorts* ([77]), whilst actual confusion is not necessary, confusion is an essential element and I must be able to infer a likelihood of confusion from the surrounding facts. Given this rather strict test, when it comes to this element of damaging connection, I doubt that the finding will be in favour of the Opponents as I will have to take into consideration the fact that Application Mark will be used in the manner that it was applied for and that there are other differentiating elements in the Application Mark which will most likely negate confusion in reality, even though an

essential part of the Application Mark may be similar to the Opponents'  mark. Thus, the ground of opposition under section 8(4)(b)(i) fails.

53 I will now move on to the ground of opposition under section 8(4)(b)(ii). Under this ground of opposition, the Opponents must prove first and foremost, that the Opponents'



mark is "well known to the public at large in Singapore". As I have not been able to

find that the Opponents'  mark meets the lower threshold of renown under section

8(4)(b)(i), needless to say, the Opponents'  mark does not meet the much higher threshold under this ground of opposition. As stated by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*Louis Vuitton*") at [94]:

*"The expression "well known to the public at large" should be given a sensible meaning, bearing in mind that by virtue of s2(8) of the Act, where a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore. Thus the test "well known to the public at large in Singapore" must mean more than just "well known in Singapore". To come within the former test, the mark must necessarily enjoy a much higher degree of recognition. It must be recognised by most sectors of the public though we would not go so far as to say all sectors of the public."* (emphasis mine).

Thus, this ground of opposition under section 8(4)(b)(ii) also fails.

#### *Conclusion*

54 Accordingly, the opposition pursuant to the grounds under section 8(4)(b)(i) and section 8(4)(b)(ii) fails.

#### **Ground of Opposition under Section 8(7)(a)**

55 Section 8(7)(a) reads:

##### **“Relative grounds for refusal of registration**

**8.** — (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;”

#### ***Opponents' Submissions***

56 The Opponents submit that they clearly have goodwill in their business in Singapore through the use of the Opponents' "CK" marks. The Opponents' first use of their "CK" marks was in 1986. The Opponents' case is that goodwill in their business through the use of their "CK" marks is also established through the substantial worldwide sales turnover as well as the very significant amount in annual expenditure on promotion and advertising of their "CK" marks. The Opponents further say that use of the Application Mark would cause confusion or deception amongst the public and that as a result, the Opponents would suffer damage.

#### ***Applicants' Submissions***

57 The Applicants' response to the opposition under this ground is that the Opponents have failed to adduce evidence to show that there is goodwill belonging to them in relation to the goods claimed under the Application Mark. The Applicants also say that the Opponents have failed to prove that use of the Application Mark by the Applicants constituted a misrepresentation that the goods of the Applicants had the same source as the Opponents' goods as there is no evidence that there would be any confusion amongst the relevant consumers. On the element of damage, the Applicants' response is that the Opponents have not shown any damage. Therefore, the Applicants say that the Opponents have failed to prove their opposition under passing off as required under section 8(7)(a).

### ***Decision on Section 8(7)(a)***

58 Section 8(7)(a) is applicable if use of the Application Mark in Singapore is liable to be prevented by virtue of the law of passing off. It is well accepted that the common law action of passing off comprises the following three limbs of (i) goodwill; (ii) misrepresentation; and (iii) damage. In particular, each limb has been succinctly distilled in the case of ***Johnson & Johnson v Uni-Charm Kabushiki Kaisha*** [2007] 1SLR(R) 1082 ("**Johnson**") which followed ***WILD CHILD Trade Mark*** [1998] RPC 455 as follows:-

- (i) that the [*Opponents*' ] goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (ii) that there is misrepresentation by the [*Applicants*] (whether or not intentional) leading or likely to lead the public to believe that goods offered by the [*Applicants*] are goods of the [*Opponents*]; and
- (iii) the [*Opponents*] have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the [*Applicants*' ] misrepresentation.

### ***Goodwill***

59 It is clear that passing off protects a person's business or goodwill and not the mark used. The mark is only a tool used by the person to educate his customers to identify the goods that originate from his business. While this is so, the role of the mark is crucial when proving the element of goodwill. As stated in the ***Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon***, Chapter 17 at paragraphs 17.1.1 – 17.1.4, this is because the test which has been used by the courts to determine whether a person's business has goodwill is whether the mark adopted by him has become *distinctive of his goods* in the sense that it is *associated or identified exclusively with his goods*. In this case, it is clear that the Opponents' business has goodwill through their marks "CK" and "Calvin Klein" as these marks are associated or identified exclusively with the Opponents' goods. However, it is not so clear that there is goodwill in Singapore associated with the Opponents' business through their

 mark, since the evidence does not conclusively establish that there was use of this mark by the Opponents at all, especially in relation to use in Singapore.

### ***Misrepresentation***

60 The key element for misrepresentation is deception. The main issue to be resolved is whether the Applicants had made a false representation that led to or is likely to lead to deception or confusion amongst the public. The nature of the deception or confusion may relate to the trade source of the goods. Although the key element is deception, it is not necessary to prove that the Applicants have an intention to deceive or mislead the public. It

has been said that the state of the mind of the Applicants is immaterial but rather what matters is the *impact on the persons to whom the misrepresentation is addressed* (see *Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon*, Chapter 18 at paragraph 18.0.1).

61 The misrepresentation in this instance, if any, is the use of the Application Mark by the Applicants. There would be misrepresentation if the public may be misled into thinking that the goods provided by the Applicants share the same source as the Opponents' goods; or that the goods of the Applicants are connected to the Opponents. I have already concluded above that the Application Mark is, on the whole, dissimilar to the Opponents' marks (in that the Application Mark contains a clearly distinguishable name, "Gioven Kelvin") and as such, that there is no likelihood of confusion amongst the public that the Applicants' goods and the Opponents' goods originate from the same source. As stated in *Amanresorts* ([77]), "*a misrepresentation is actionable under the law of passing off only if it gives rise to confusion.....evidence of confusion is not required before a passing off action can succeed. It is open to the court to infer a likelihood of confusion from the surrounding facts. Confusion is still an essential element of the tort of passing off..(emphasis mine)*". As I have found no likelihood of confusion, this essential element of the tort of passing off has not been made out. Therefore, the Opponents have not discharged their burden of proving that the element of misrepresentation, a key element to a claim of passing off and which is to be inferred from a likelihood of confusion, has been made out.

#### *Damage*

62 As the element of misrepresentation for the action for passing off is not made out, it is not necessary for me to consider if damage is made out in this instance. In any case, there would be no damage since it is not proven that there is misrepresentation.

#### *Conclusion*

63 Accordingly, the opposition under Section 8(7)(a) also fails.

#### **Ground of opposition under Section 7(6)**

64 Section 7(6) of the Act reads:

"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

#### ***Opponents' Submissions***

65 The Opponents' case is that the Application Mark was not applied for in good faith as it contains the letters "GK" and the words "Gioven Kelvin" which the Opponents had

previously objected to in relation to the  marks in Classes 18 and 24 under Singapore Trade Mark Application Nos. T0412611I and T0412612G in the name of Impressions Int'l Import and Export Pte Ltd ("Impressions"). The Opponents

say that Impressions and the Applicants are connected as one of the two directors and shareholders of the Applicants, Hor Soon Hong is the sole proprietor of Impressions. The Opponents say that both Hor Soon Hong and the other director and shareholder of the Applicants, Tan Cha Boo, share a close relationship as they both live at 9 Marine Vista, #19-05 Neptune Court. The Opponents' case is that following negotiations in April 2005, the Opponents refrained from taking action against Impressions upon Impressions' agreement to

voluntarily withdraw the **GIOVEN  KELVIN** marks in Classes 18 and 24 under T0412611I and T0412612G in their letters dated 25 April 2005 to the Opponents' solicitors, Drew & Napier LLC, and to IPOS (our office). The Opponents say that there was further confirmation that there was no intention to use the marks in Singapore as stated in a letter dated 10 May 2005 from Impressions' solicitors, Samuel Seow Law Corporation. The Opponents' case is that despite this prior agreement, the Applicants proceeded with the applications and registrations for trade marks in Singapore comprising of the letters and/or words "GK" and/or "Gioven Kelvin" and/or "GK Gioven Kelvin", in particular, the following Singapore Trade Mark Applications:

- (a)  **GIOVEN KELVIN** (T0507392B) in Class 25 on 9 May 2005
- (b)  **GIOVEN KELVIN** (T0722899J) in Class 14 on 3 December 2007
- (c)  **Gioven Kelvin** (T0804508C) in Class 18 on 8 April 2008
- (d)  **Gioven Kelvin** (T0900197G) in Class 24 on 5 January 2009 (Application Mark)

66 The Opponents say that it is clear from the Opponents' solicitors' letter dated 4 May 2005 to Impressions in which the Opponents objected to the use of any mark containing the letters and/or words "GK", "Gioven Kelvin" and "GK Gioven Kelvin" that the Opponents would similarly object to the application, registration and use of the Applicants'

 **GIOVEN KELVIN** (T0507392B) in Class 25 that was applied for on 9 May 2005, a day before Impressions' solicitors' letter dated 10 May 2005 in response to the Opponents' solicitors' said letter dated 4 May 2005.

67 The Opponents say that the Applicants have blatantly attempted to hijack and take advantage of the Opponents' rights and reputation in the Opponents' "CK" marks by attempting to register the subject Application Mark which is also similar to the Opponents'

"CK" marks, in particular, the Opponents'  mark under Singapore Trade Mark Registration No. T8902964D. The Opponents said that even if there is no confusion between the Application Mark and the Opponents' "CK" trade marks, or even if there was no breach of duty on the part of the Applicants by applying to register the Application Mark, the Application Mark was clearly applied for in bad faith in light of the prior negotiations and agreement and therefore, the application to register the Application Mark ought not to be allowed.

### *Applicants' Submissions*

68 The Applicants' response is that the Applicants are the first and ultimate owner of the Application Mark and they have the rights to its registration. The Applicants deny that the negotiations in 2005 had any relevance in establishing bad faith on the part of the Applicants in filing for registration of the Application Mark because the negotiations involve an entirely

separate mark . The Applicants say that the negotiations that arose from the letter from the Opponents' solicitors dated 4 May 2005 in which the Opponents' solicitors had asked for an undertaking not to "at any time in the future offer for sale any goods bearing a mark containing the letters and/or words "GK", "Gioven Kelvin" and "GK Gioven Kelvin" led to a rejection of the offer by the Applicants by virtue of the letter dated 10 May 2005 from the Applicants' solicitors. The Applicants say that since then, the Opponents had no further contact with Impressions' solicitors and that by course of conduct, the Opponents are deemed to have accepted the counter offer that in consideration of Impressions withdrawing its applications for the registration of the 2005 Mark

(  ) in Classes 18 and 24, the Opponents would withdraw their claims against Impressions, with no further lingering restrictions.

69 The Applicants also pointed out that the earlier entity which the Opponents had contacted in the earlier negotiations in 2005 were not the Applicants. They also contended that the 2005 Mark in question looked very different from the Application Mark and had already been withdrawn. The Applicants deny that there was any agreement on the part of the Applicants not to use any marks, however constituted, bearing the words "Gioven Kelvin". The Applicants say that the Opponents were represented by solicitors at all relevant times and that if the Opponents had intended for Impressions or the Applicants not to use any mark bearing the words "Gioven Kelvin", the Opponents would have pursued the matter. The Opponents would not have allowed the Applicants to have filed a whole series of marks bearing the words "Gioven Kelvin" across a whole spectrum of Classes including Class 25. In any event, subsequent to the settlement reached on 25 April 2005, the Applicants did not file registrations or use any mark that is in the form that the Opponents objected to (that is, in this

form :  ). The Applicants further say that when they subsequently file for registrations of different looking marks containing the words "Gioven Kelvin", they were not formally objected to until the Application Mark.

70 The Applicants therefore submit that there was no act of dishonesty and that the Opponents have failed to prove the charge of bad faith.

### *Decision on Section 7(6)*

71 The Singapore Court of Appeal in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14 ("*Valentino*") has authoritatively concurred with and applied the test for determining bad faith as enunciated by the English Court of Appeal. The Court of Appeal at [29] referred to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal* [2009] 2 SLR(R) 814 ("*Wing Joo Loong*") as follows:

In *Wing Joo Loong*, this court observed at [105] that “[t]he test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal” [emphasis in original]. It would be useful to set out in full the observations of this court at [105]–[106] which are as follows:

105 The test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal in *Harrison v Teton Valley Trading Co Ltd* [2004] 1WLR 2577, where Sir William Aldous, with whom Arden and Pill LJ agreed, expressed the test as follows (at [26]):

The words ‘bad faith’ suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as [being] in bad faith by persons adopting proper standards.

This test, which was referred to by Sir Aldous (*id* at [25]) as the “combined” test of bad faith, contains both a subjective element (*viz.*, what the particular applicant knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think).

106 Recently, this combined test of bad faith was succinctly explained in *Ajit Weekly Trade Mark* [2006] RPC 25 as follows (at [35] and [41]):

35 ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability [for] breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 A.C. 164, with *Gromax Plasticulture* ([103] *supra*) ... providing the appropriate standard namely, acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

41 ... [T]he upshot of the Privy [Council’s] decision in [*Barlow Clowes International Ltd v Eurotrust International Ltd* [2006] 1 WLR 1476] is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinsectra*, i.e. the combined test; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standards of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the objective element...

72 Further, the Court of Appeal in *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR 1073 (“*Weir Warman*”) summarises at [48] as follows:

It would be fair to say that the term ‘bad faith’ embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve ‘no breach of any duty, obligation, prohibition or requirement that is legally binding’ upon the registrant of the trade mark.

In the above, the court made a reference to *Demon Ale Trade Mark* [2000] RPC 345, 356 (“*Demon Ale*”) where Hobbs QC stated:

[T]he expression ‘bad faith’ has *moral overtones* which appear to make it possible for an application for registration to be rendered invalid under section 3(6) by behaviour which *otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding* upon the applicant. (emphasis added)

73 One important point that needs to be stressed concerning this ground of opposition is that an allegation of bad faith is a serious matter and should not be lightly inferred. This point was made very clear by the High Court in *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2009] SGHC 280 (hereinafter, “*PT Swakarya*”) (refer to Lai Siu Chiu J’s comments at [60] to [62] wherein the learned judge also made reference to statements made by Chao Hick Tin JA in *McDonald’s Corp v Future Enterprises Ltd* [2005] 1 SLR 177 (hereinafter, “*McDonald’s*”) at [78]). This important point first originated from the English case, “*Royal Enfield Trade Marks* [2002] RPC 24 where it was held at [31], “*An allegation that a trade mark has been applied for in bad faith is a serious allegation...A plea of fraud should not lightly be made...and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts...In my judgment precisely the same considerations apply to an allegation of ...bad faith made under section 3(6) (which is in pari material with our section 7(6)). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference*” (emphasis mine).

74 I now turn to apply the law to the facts of this case. There is a subjective element, viz the mental state of the Applicants and an objective element, viz, the perspective of ordinary traders adopting proper standards. I have to judge the subjective mental state against the standard of what would be an acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined. That is to say, I have to look at the mental state of the Applicants (in this case, the knowledge that they have at the relevant time) and assess that mental state from the perspective of ordinary traders adopting proper standards. I have to ask whether the knowledge of the Applicants was such that their decision to apply for registration for the Application Mark for Class 24 goods would be regarded as in bad faith by ordinary traders adopting proper standards. And the relevant point in time for this assessment of the mental state of the Applicants from the perspective of ordinary traders is the date of application viz, as at 5 January 2009.

75 From the evidence of the Opponents (see Exhibit marked "DMG-11" of Opponents' SD), it is shown that on 25 April 2005, Paul Hor Soon Hong trading as Impressions (Int'l) Import and Export, by a letter to the counsel for Calvin Klein Trademark Trust (the Opponents), Drew & Napier LLC, agreed to withdraw trade mark applications T0412611I and T0412612G in which registration was originally sought for the mark,

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in respect of, "Leather goods; all included in Class 18" and in

respect of "Textiles and textile goods, not included in other classes; bed and table covers; bed blankets; bed clothes; bed covers; bed linen; bedspreads; all included in Class 24" respectively. The withdrawal was pursuant to two letters from the Opponents informing Impressions (Int'l) Import and Export ("Impressions") (the applicant in T0412611I and T0412512G) of the Opponents' intention to oppose trade mark applications T0412611I and T0412512G. I note that the mark in T0412611I and T0412512G contain the letters "GK"



represented in a manner that is very similar to Opponents' marks, , in T9601578E



and in T9508639E. The agreement was that the withdrawal of T0412611I and T0412612G would serve as full and final settlement of all and any claims the Opponents and any of its agents, officers, employees and successors-in-title have against the said Paul Hor Soon Hong or Impressions in respect of the stated applications. Subsequent to that agreement, on the same day, the said Paul Hor Soon, on behalf of Impressions wrote to our office to withdraw the two applications. From the trade marks register, I can see that the trade marks were accordingly updated as withdrawn on 27 April 2005.

76 Subsequent to the above event, I note from information on the trade marks register that the Applicants lodged the following applications on the stated dates:

- (a)  GIOVEN KELVIN (T0507392B) in Class 25 on 9 May 2005
- (b)  GIOVEN KELVIN (T0722899J) in Class 14 on 3 December 2007
- (c)  Gioven Kelvin (T0804508C) in Class 18 on 8 April 2008  
PARIS
- (d)  Gioven Kelvin (T0900197G) in Class 24 on 5 January 2009 (the Application Mark)  
PARIS

77 I note that prior to the negotiations concerning T0412611I and T0412612G, on 27 August 2003, the Applicants had already applied for and obtained registration for



(T0312789H) in Class 25 ("mark (e)"). The above marks (a), (b), (c) and (e) are all registered in the name of IDM Apparel Pte Ltd (the Applicants). Mark (d) is the Application Mark. The registered mark (c) (T0804508C) in Class 18 is identical to the Application Mark. The registered mark (e) (T0312789H) contains the "GK" device that I have found in the above to be an essential part of the Application Mark that is similar to

Opponents' mark (i)  , except that the device in T0312789H is in reverse colour combination with white lettering against a black background.

78 In the Opponents' SD in Reply, the Opponents lodged copies of company searches of Impressions and IDM Apparel Pte Ltd (the Applicants) in Exhibit "DMG-18". From "DMG-18", it is seen that the two directors of the company IDM Apparel Pte Ltd (the Applicants) are Hor Soon Hong (I/C No.S1615788J) and Tan Cha Boo (I/C No. S2579740Z) and the company IDM Apparel Pte Ltd was registered on 10 January 2005. Both directors are also the shareholders of equal share of IDM Apparel Pte Ltd. From the same Exhibit "DMG-18", it can also be seen that a company search result from BizNet shows that Hor Soon Hong (I/C No. S1615788J) is the owner and manager of Impressions which was registered 9 February 2001 and the business commencement date was registered as 7 February 2001. I note that the Applicants' SD is executed by Tan Cha Boo (I/C No. S2579740Z) and in the Applicants' SD, the said Tan Cha Boo said he was the director of IDM Apparel Pte Ltd (the Applicants). From the evidence, I am satisfied that the owner of Impressions, Hor Soon Hong, who withdrew the trade mark applications T0412611I and T0412512G is now also the director and shareholder of the Applicants who subsequently obtained registrations for the marks mentioned in paragraph 76. I also note that the Applicants' SD was executed by the only other director of the Applicants, Tan Cha Boo. Having established the nexus between Impressions and IDM Apparel Pte Ltd (the Applicants) in that the said Hor Soon Hong is the owner of the former and is also director and shareholder of the latter, I can now examine the subjective knowledge of the Applicants against the objective standard of an ordinary trader adopting proper standards to assess if there was bad faith as per the test for bad faith detailed by me above.

79 The evidence shows that in the two earlier applications T0412611I and T0412512G which the Opponents had opposed and which the Applicants had voluntarily withdrawn, the mark comprises the letters "GK" represented in a similar fashion to Opponents marks (ii) and (iii). Now that I have established that the owner of those two earlier applications T0412611I and T0412512G is now also the director and shareholder of the Applicants, it may be inferred that when the owner of Impressions withdrew the two earlier applications T0412611I and T0412512G, he had conceded on the Opponents' case against him. Despite this, he had subsequently caused the Applicants to proceed to obtain registration for a mark identical to the Application Mark in Classes 18 on 8 April 2008 (mark (c)) and now, applied to register the Application Mark in Class 24.

80 I have already found in the above that the device comprising the juxtaposition of the letters "G" and "K" in the Application Mark is an essential part of the Application Mark which is similar to Opponents' mark (i) as the juxtaposition of the letters "G" and "K" appears very similar to the juxtaposition of the letters "C" and "K" in Opponents' mark (i) and as the letters "C" and "G" appear very similar, especially in the way the letters "G" and "K" are visually presented in the Application Mark. Given that the same person (Hor Soon Hong) who has knowledge of the relevant events is involved in the sequence of events and given the similarity between an essential part of the Application Mark and a registered mark belonging to the Opponents (Opponents' mark (i)), it can be said that, viewed in isolation, the act of applying to register the Application Mark is rather questionable.

81 However, the above has to be viewed in the context that prior to the negotiations between the Opponents and the Applicants in April 2005, the Applicants had, on 27 August

2003, already filed for registration of this mark  (T0312789H) in respect of Class

25 goods. Registration for this mark was obtained on 14 September 2004 and this was prior to the negotiations between the Applicants and Opponents. Although the device in T0312789H is the same device comprising letters "G" and "K" as the device in the Application Mark, the white lettering against the black background makes the device in T0312789H clearly different from Opponents' mark (i). It is therefore right that T0312789H

proceeded to registration without any issue. In addition to  (T0312789H), the Applicants already owned registrations for **GIOVEN KELVIN** for Class 25 goods

  
Gioven Kelvin (T0006472J) and also for Class 25 goods (T0308963E). In the context that the Applicants already own the following registrations for Class 25 goods:

 (T0312789H), **GIOVEN KELVIN** (T0006472J), and   
Gioven Kelvin

  
Gioven Kelvin (T0308963E), it can be said that by applying for  (T0804503C for Class 18 goods) and the present Application Mark for Class 24 goods, the Applicants were merely seeking to stretch their brand and expand their monopoly beyond Class 25 goods. Further, it can be seen that the Applicants had combined elements of their registered marks into a composite whole in the Application Mark. Thus, the Application Mark contains the "GK"

device  (which has been registered in T0312789H) and the words, "Gioven Kelvin", also already registered in the Applicants' name (see T0006472J). I also note that the

  
Opponents did not object to T0804503C  in Class 18, which is for a mark identical to the Application Mark and which was also registered. Judging this state of mind of the Applicants against the objective standard of ordinary persons adopting proper standards, I do not find that the Applicants' conduct had fallen short of proper standards of honesty as the Applicants already had proprietary claims to the elements in the Application Mark as at the date of application.

82 The Opponents tried to argue that the Applicants are bound by an undertaking not to use any mark containing the letters and/or words "GK", "Gioven Kelvin" and "GK Gioven Kelvin" or any mark containing any confusingly similar variations of "CK" and/or "Calvin Klein". They claim that the evidence of this is through a letter from the Opponents' solicitors to Impressions dated 4 May 2005 (see Exhibit "DMG-11"). I find that there is no such binding undertaking by the Applicants as, (i) it was a unilateral letter that came after the Applicants had agreed to withdraw T0412611I and T0412612G; and (ii) the unilateral letter had been responded to by the Applicants with a denial of any admission of use and the need for such an undertaking. Thus, there was no understaking by or on behalf of the Applicants such that the Applicants' application for registration of the Application Mark would be called into question.

*Conclusion*

83 I would reiterate that an allegation of bad faith is a serious allegation and the Opponents have the onus to prove it distinctly. A case of bad faith cannot be made out merely by inference. As the Opponents have not surfaced concrete evidence to prove their case that the application by the Applicants was made in bad faith, the ground of opposition under section 7(6) therefore fails.

**Conclusion**

84 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all the grounds of opposition. Accordingly, the Application Mark may proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 31st day of August 2011

Lee Li Choon  
Principal Assistant Registrar  
Hearings and Mediation Division  
Intellectual Property Office of Singapore