

Intellectual Property Office of Singapore Case Summary: Lacoste v Carolina Herrera, Ltd [2014] SGIPOS 3

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A first of its kind in Singapore, this case addresses, amongst other things, the issue of whether a company can claim exclusive trade mark rights to a common element found in a "family" or "series" of registered marks, by virtue of the company's registration of these marks only.

The applicants applied to register "L . 12 . 12" in Classes 3¹, 18² and 25³ (the "**Application Mark**"). The opponents opposed the registration, alleging rights to the common element "212" by virtue of their registration for the following marks in Class 3 (below). There was no trade mark registration for "212" alone, although the opponents claimed to be the only registered proprietor for marks with the element "212" in Singapore.

TM Numbers	Trade Mark
T0201161F	212 ON ICE
T0906637H	212 VIP
T0524829C	212 SEXY
T9705073H	212 by Carolina Herrera

(collectively, the "**212 Marks**")

The Registrar of Trade Marks held that the opponents did not have exclusive trade mark rights to the element "212". Trade mark registration does not automatically give rise to a presumption that the consumer perceives the registered marks as a family or series of marks. In order to claim rights over the element "212", the opponents needed to give evidence that a sufficient number of these marks had been used and are recognised by the consumer or public as being a family or series of marks.

The opponents' evidence showed, at best, that only distributors and/or certain third party businesses may be familiar with the opponents' use of "212" for its perfumes (i.e. in Class 3). There was insufficient evidence to indicate consumer or public awareness of the opponents' use of "212" as a family or series of marks. On this point, the Registrar also found that, in any event, the element "212" was not similar to the Application Mark. The Application Mark therefore proceeded to registration.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at

<http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>.

¹ Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices

² Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery

³ Class 25: Clothing, footwear, headgear