

**Intellectual Property Office of Singapore Case Summary: Christie Manson & Woods Limited v Chritrs Auction Pte. Limited [2016] SGIPOS 1**

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The Opponents, Christie Manson & Woods Limited, sought to oppose the registration of the following mark (the “Application Mark”):

Application Mark	Services
<div style="text-align: center;">  <p>Application Number: T1202934H</p> </div>	<p>Class 35: Auctioneering.</p>

on the basis (among other things) of their earlier marks:

Opponents' Earlier Marks	Services
<div style="text-align: center;"> <p><b>CHRISTIE'S</b></p>  <p>Trade Mark Number: T9102985J</p> <p>Mark Clauses:                      1) The transliteration of the Chinese characters appearing in the Mark is "Jia Shi De" which convey no meaning.                      2) Registration of this Trade Mark shall give no right to the exclusive use of the word "Christie's".</p> </div>	<p>Class 35: Auctioneering services.</p>
<div style="text-align: center;"> <p><b>CHRISTIE'S</b></p> <p>Trade Mark Number: T9600045A</p> </div>	<p>Class 36: Real estate services; estate agency services; real estate brokerage; advice, and information services relating thereto.</p>

While the Opponents relied on various provisions of the Trade Marks Act (the “Act”), the Opponents only succeeded under Section 7(6) of the Act given that, on the facts, the Application Mark was applied for in bad faith. As such, the Application Mark was refused registration.

In coming to this finding of bad faith under Section 7(6) of the Act, the Registrar observed that it is difficult to believe that “CHRITRS is a meaningless word that was invented by the Applicant as a means of coming up with a unique mark for his business” as asserted by the Applicants. It does not make sense for the Applicants to come up with an unpronounceable name for their business, and it is a remarkable coincidence that six (6) of the letters in the Application Mark “CHRITRS” are the same as the Opponents’ “CHRISTIE’S” mark, and the first four (4) letters are identical. The Registrar was persuaded that the Applicants’ use of a Chinese name “佳士德” (pronounced “Jia Shi De”) (later changed to “佳德” (“Jia De”) due to related proceedings in Hong Kong) together with “CHRITRS” is a factor that must be taken into account in determining bad faith. The Applicants’ initial Chinese name “佳士德” is practically identical to the Opponents’ Chinese name “佳士得”; both are pronounced “Jia Shi De”, and the first two (2) Chinese characters are identical. The Opponents’ Chinese name is neither a translation or transliteration of CHRISTIE’S, which

makes the Applicants' choice of a Chinese name which is practically identical to that of the Opponents all the more unbelievable. In these circumstances, the Applicants' sole director should have made full use of the opportunity to submit to cross-examination and vindicate the Applicants' creation and choice of the Application Mark, as well as their reasons for applying to register the same, if the Applicants had nothing to conceal. Instead, he was absent for cross-examination on the day of the hearing without any satisfactory reason, and an adverse inference was drawn against the Applicants. (See paragraphs [165]-[184] of the decision.)

As a preliminary issue, both parties were involved in related proceedings in Hong Kong and Taiwan, as well as a domain name dispute in Hong Kong. The Registrar held that the relevance of these proceedings hinged upon the similarity of the laws of the particular jurisdiction with those of Singapore and also upon the individual facts of each case. Nonetheless, the Registrar could take cognisance of specific observations which are of relevance. (See paragraphs [26]-[28] of the decision.)

In relation to Section 8(2)(b) of the Act (mark similarity), the Registrar considered the effect of marks which are subjected to disclaimers under Section 30(1)(a) of the Act. The Opponents argued that disclaimers should only be taken into account in infringement proceedings and not opposition proceedings. There were conflicting positions taken by the Registrar on this issue in previous cases. The Registrar considered the previous cases, examined the corresponding position in the UK, and held that a disclaimer applies equally to registration/opposition proceedings as it does to infringement proceedings. Since the only possible point of similarity between the Application Mark and the

CHRISTIE'S

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Opponents' mark in Class 35 (" 佳士得 ") rests solely on the word "Christie's", which had been disclaimed, the opposition under Section 8(2)(b) relating to the Opponents' mark in Class 35 must fail. (See paragraphs [43]-[63] of the decision.)

In relation to Section 8(2)(b) of the Act (identity/similarity of services), the Registrar found that the service of selling real estate via auction falls within "auctioneering services" in Class 35 (applied for in the Application Mark), but does not fall within "real estate services" (for which the Opponents' mark in Class 36 is registered). Accordingly, there is no identity in the parties' respective services of interest. In coming to this conclusion, the Registrar observed that the scope of trade mark protection should be precise. Further, a trade mark search carried out prior to the application to register (or to use) a trade mark should be able to uncover relevant prior marks owned by third parties. Specifications should therefore be confined to the substance or the core of the possible meanings attributable to a general phrase. The Registrar also came to the conclusion that "auctioneering services" in Class 35 and "real estate services" in Class 36 are not similar once the auction of real estate is disregarded, as there is no or minimal overlap in the uses, users, physical nature of the acts of services and trade channels, and the services are also not competitive. (See paragraphs [79]-[100] of the decision.)

Notably, the Registrar considered in brief whether the Registrar is empowered to allow an opposition in relation to part of a specification of goods/services. The Registrar agreed that the language of the relevant provisions in the Act with respect to opposition proceedings (under Sections 8(1) and 8(2)) – as opposed to revocation (Section 22(6) of the Act) and invalidation (Section 23(9) of the Act) proceedings – suggests that the Registrar does not have the power to allow partial oppositions. However, partial oppositions are permitted in the UK, where the relevant statutory provisions are similar to Singapore. The Registrar has also in fact previously permitted a partial opposition. Further, there also does not appear to be any strong policy reason for not permitting partial oppositions; indeed, it could be unfair not to permit partial oppositions. Nonetheless, in view of the importance of this issue, the Registrar left the question open for consideration in a subsequent case, hopefully with the benefit of full submissions. (See paragraphs [102]-[114] of the decision.)

*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 <https://www.ipos.gov.sg/resources/hearing-mediation>.*