

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

Trade Mark No. 40201701277U
Hearing Date: 28 November 2018

IN THE MATTER OF A TRADE MARK APPLICATION BY

MONEYMAX JEWELLERY PTE. LTD.

AND

OPPOSITION THERETO BY

CARTIER INTERNATIONAL AG

Hearing Officer: Lim Fung Chian Mark
Principal Assistant Registrar of Trade Marks

Representation:

Mr Sukumar Karupiah (Ravindran Associates LLP) for the Opponent

Mr Aaron Thng (Amica Law LLC) for the Applicant

GROUND OF DECISION

Introduction

1 Can anyone have a monopoly over love? More precisely, can a trader prevent other traders from registering a trade mark which includes the word “LOVE” for use on jewellery?

2 In the seminal decision of *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 (“*Love & Co*”), the plaintiff launched a jewellery store bearing the name “Love & Co”. The defendant had registered the plain word mark “LOVE” for jewellery. The plaintiff was concerned that the defendant would allege trade mark infringement by the plaintiff. Accordingly, the plaintiff proactively applied to invalidate the defendant’s trade mark. In

allowing the application, it is clear that Justice Chan Seng Onn was of the view that no trader should be permitted to monopolise the word “LOVE” whose use is ubiquitous in the jewellery trade.¹


3 In these proceedings, Cartier International AG (“Opponent”) relies on its trade mark  to prevent the registration by MoneyMax Jewellery Pte. Ltd. (“Applicant”) of



(“the Application Mark”) on jewellery. As is readily apparent, the only similarity between the marks is the inclusion of the word “LOVE”. As noted by the court in *Love & Co*, “LOVE” is a word which is commonly used by jewellery traders, and should not be monopolised by any trader. I am of the view that the Opponent should clearly not be permitted to prevent registration of the Application Mark just because it incorporates the word “LOVE”. I set out my reasons below.

Chronology of Proceedings

4 On 19 January 2017, the Applicant applied to register the Application Mark for jewellery in Class 14 and retail and other services relating to jewellery in Class 35.² The Application Mark was published for opposition purposes on 31 March 2017.

5 The Opponent filed its Notice of Opposition on 28 July 2017. Among other things, it relies on its prior registration for  for jewellery (among other things) in class 14 in support of the opposition.³

¹ The *Love & Co* case is considered in greater detail at [19]-[22] below.

² The full specification of goods and services applied for is as follows:

Class 14: Jewellery; gold jewellery; jewellery chains; jewellery charms; jewellery rings; gold rings; jewellery ornaments; jewellery watches; lockets [jewellery]; necklaces [jewellery]; pearl jewellery; pendants [jewellery]; silver jewellery; gold thread jewellery; jewellery, precious stones; precious jewellery; bracelets [jewellery]; bracelets made of embroidered textile [jewellery]; charms for jewellery; earrings; gold earrings; gold-plated earrings; ear ornaments in the nature of jewellery; jewellery boxes; jewellery foot chains; containers especially adapted for presentation and display of jewellery or watches; gold; horological instruments made of gold.

Class 35: Retail services for jewellery; advertising services relating to jewellery; online retail services relating to jewellery; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet or a general merchandise web site in the global communications network; business management; business administration; retail sale services; advertising and promotional services; provision of advertising space by electronic means and global information networks; on-line advertising on a computer network; organization of fairs and exhibitions for commercial and advertising purposes; administrative processing of purchase orders; provision of assistance (business) in the establishment of franchises; organisation and management of customer loyalty programmes; online ordering services.

³ The full specification of goods for which the mark is registered is as follows: Cuff-links, tie-clips, rings, bracelets, earrings, necklaces, brooches (jewellery), watches, chronometers, clocks, watch straps, watch bracelets, boxes of precious metals for watches and jewellery.

6 The Applicant filed its Counter-Statement in support of the application on 27 September 2017.

7 The Opponent filed evidence in support of the opposition on 16 March 2018. The Applicant filed evidence in support of the application on 14 June 2018; the evidence was subsequently re-filed on 28 September 2018 to comply with certain formalities. The Opponent filed its reply evidence on 24 August 2018. The Pre-Hearing Review was held on 17 September 2018, after which the opposition was heard on 28 November 2018.


The Evidence

8 The following Statutory Declarations (“SDs”) were tendered in evidence.


- a. SD of Mr Louis Arthur Michel Maries Roukine, the Maison Lead IP Advisor⁴ for the Opponent, dated 9 March 2018 (“the Opponent’s SD”).
- b. SD of Ms Elim Lau, the Senior Marketing Manager of the Applicant, dated 13 June 2018; on 27 September 2018, Ms Lau declared a supplementary SD which was identical to her earlier SD save for the inclusion of an affirmation clause as required under the Oaths and Declarations Act (Cap. 211) (“the Applicant’s SD”).
- c. SD in Reply of Mr Roukine dated 21 August 2018.

Background

9 The Opponent is part of the Richemont Group, one of the leading global luxury goods companies. It has a wide range of jewellery collections, including its “Love” collection.

10 As mentioned, the Opponent has a prior registration for L[⊖]VE^e for jewellery (among other things) in class 14. The letter “O” in the word “LOVE” is replaced with the device of a slotted screw head:  (the “Screw-head Device”); and, unlike the other letters, the letter “E” is in lower case (“e”).

11 The Applicant points out that the Opponent had failed in its attempt to register the word “LOVE” in plain block letters for the same goods in class 14.⁵ At the hearing, the Opponent confirmed that it is not claiming any rights to the word “LOVE” simpliciter.

12 This concession was properly made as the evidence shows that “LOVE” simpliciter has never been used on any of the Opponent’s jewellery pieces. Instead, it is mainly the Screw-head Device  which appears on the Opponent’s jewellery, specifically, bracelets, rings, earrings and necklaces/pendants (an illustration of this can be seen in the image in the next

⁴ “Maison” refers to a fashion house, in this case, “Cartier”. Essentially, Mr Roukine is the lead IP Advisor for brands owned by the Opponent.

⁵ See Applicant’s Written Submissions (“AWS”) at [12].

paragraph). Even on advertisements and catalogues, only the stylized “LØVE” mark (as opposed to the word “LOVE” simpliciter) appears.

13 The first piece in the Opponent’s “Love” collection, the LØVE bracelet, was designed in 1969. It is secured, and can only be removed, using a gold screwdriver that is sold together with the bracelet. Accordingly, it was apparently referred to as “modern love handcuffs”, and is intended to symbolise the attachment between two parties. An image of a LØVE bracelet together with the accompanying screwdriver is reproduced below⁶:



14 The Applicant is a leading pawn-broking chain with pawnshops across Singapore and



Malaysia. The Application Mark () is displayed on the storefront and within each of the Applicant’s stores.⁷ As can be seen, the Application Mark comprises the word “LOVE” positioned above the word “GOLD”, and the Chinese characters, 珍金, enclosed within a rectangular device. The transliteration of the Chinese characters in the mark is “Zhen Jin” which has no meaning.⁸

15 Apart from the Applicant and the Opponent, numerous other traders have registered a mark incorporating the word “LOVE” for jewellery. These include **LOVE**, TRUE LOVE, “LOVE & LOVE”, “Love Bridge”, “PERFECT LOVE” and many more.⁹

⁶ Information from articles entitled “10 Things You Didn’t Know about the Cartier Love Bracelet” (Singapore Tatler, 10 March 2017), “10 Things You Didn’t Know about the Cartier Love Bracelet” (Harper’s Bazaar Singapore, 31 August 2017), “This \$5,000 bracelet that has been around for decades is the new millennial status symbol” (Business Insider US, 1 January 2016), “Cartier Is Keeping Us In The Loop For Love” (Elle Singapore, undated) and “Cartier’s most iconic watches and jewellery” (LifeStyle Asia, 11 November 2013 (updated on 29 January 2014)); and image from the Harper’s Bazaar Singapore article (all included in Exhibit marked “LR-8” in the Opponent’s SD).

⁷ See Applicant’s SD at [5] and [6], and Exhibit B thereto.

⁸ Based on the publication of the mark in the Trade Marks Journal No. 013/2017 dated 31 March 2017. The parties do not dispute that this translation (i.e. that it has no meaning) and transliteration of the Chinese characters is correct.

⁹ The Applicant has carried out a search of the Trade Marks Register which shows a total of 86 marks registered in class 14 which include the word “LOVE” (see AWS, Annex D).

MAIN DECISION

16 When the Notice of Opposition was originally filed, the following grounds of opposition were pleaded: Sections 7(1)(a), 7(1)(b), 7(1)(c), 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B) and 8(7)(a) of the Trade Marks Act (Cap. 332, Rev Ed. 2005) (“TMA”). Subsequently and prior to the hearing, the grounds of opposition under Sections 7(1)(a), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B) were dropped.

17 For these proceedings, it would be convenient to first examine the “relative” grounds of opposition (i.e. Section 8(2)(b), 8(4)(b)(i) and 8(7)(a) TMA) before the “absolute” grounds of opposition (i.e. Sections 7(1)(b) and 7(1)(c) TMA).

18 As the applicable law is the TMA, there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

The Decision in *Love & Co*

19 Before going into the various grounds of opposition, it would be useful to examine the relevant aspects of the decision in *Love & Co* (briefly mentioned at [2] above) in greater detail.

20 As mentioned, the plaintiff successfully invalidated the defendant’s plain word mark “LOVE” which was registered in respect of jewellery, precious stones and precious metals in class 14. The basis for the invalidation was that the mark was “devoid of any distinctive character” under Section 7(1)(b) TMA and that the mark designated one of the “intended purposes” of jewellery under Section 7(1)(c) TMA.¹⁰

21 On the mark being “devoid of any distinctive character”, the learned Judge observed that “*the word “love” is almost a breathing word in the jewellery trade*” (at [64]). He was therefore “*of the belief that the almost ubiquitous use of the word “love” inscribed on jewellery items and in advertisements in the jewellery industry, renders it difficult for members of the public to realise or expect that the defendant’s ordinary and rather simple “LOVE” mark is meant to distinguish the defendant’s jewellery from another trader’s*” (at [65]).

22 He also found that the mark fell foul of Section 7(1)(c) TMA as “*one of the “intended purposes” of jewellery is to use them as gifts to express love and affection*” (at [77]). He perceptively observed that “*otherwise it would make little sense for the defendant to register “LOVE” as one of its trade marks, and thereby seek to monopolise that word commonly used in the jewellery trade by other jewellery traders*” (at [75]).

“Relative” Grounds of Opposition

23 Section 8 TMA sets out “relative grounds for refusal of registration.” Under this section, the reasons for refusing to register a trade mark are considered “relative” to other earlier rights.

¹⁰ The evidence in support of his finding is set out in detail in the judgment. The judge also found that the mark had not “acquired a distinctive character as a result of the use made of it” under Section 7(2) TMA. As the issue of “acquired distinctiveness” is not relevant to the current proceedings, I say no more about it.

24 In these proceedings, the Opponent relies on its rights in its prior registered **LOVE** trade mark to oppose the Application Mark.

25 The specific grounds it relies on are Sections 8(2)(b), 8(4)(b)(i) and 8(7)(a) TMA, which read:

Section 8(2)(b)

A trade mark shall not be registered if because –

...

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

there exists a likelihood of confusion on the part of the public.

Section 8(4)(b)(i)

*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...*

Section 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...*


(emphasis added)

26 As perceptively noted by the learned IP Adjudicator Associate Professor Burton Ong in *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 (“*MEC v NBA*”) at [83]:

The common basic criterion in all these grounds of opposition is that there must be identity or similarity between the competing marks. The mark-similarity threshold is thus a leash that circumscribes the ambit of the territory to which the trade mark proprietor can claim as its own, the length of which corresponds to the strength of the trade mark (i.e. its distinctiveness and whether it is well known).

27 In the case of Section 8(7) TMA, the requirement of mark-similarity is encapsulated in the second element of the tort of passing off, namely, misrepresentation. (The other two elements which need to be established are the existence of goodwill and the infliction of damage.): see *MEC v NBA* at [77]-[78]. An operative misrepresentation hinges on the similarity (if any) between the Application Mark and the Opponent’s **LOVE** mark.

28 In order to make a meaningful comparison between the marks, it is first necessary to ascertain what aspects of the Opponent’s **LOVE** mark are distinctive: see, for example: *The Polo/Lauren Co LP v Shop-in Department Store Pte Ltd* [2006] 2 SLR(R) 690 at [23]-[24]; *Ferrero SpA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 at [49] & [70]-[74]; *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [19]-[20]; and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 at [24]-[25]. After all, protection of the mark is derived from these distinctive aspects in the first place.

29 As alluded to above, the word “LOVE” simpliciter is not distinctive in relation to jewellery. Accordingly, any distinctiveness in the Opponent’s **LOVE** mark resides in the Screw-head Device  and possibly the use of a small letter “e”.



30 Neither of these elements is present in the Application Mark ().

31 It must follow that the Application Mark is not “similar” to the Opponent’s **LOVE** mark within the meaning of Sections 8(2)(b), 8(4)(b)(i) and 8(7)(a) TMA. Otherwise, the protection conferred on the Opponent’s **LOVE** mark would *de facto* extend to the word “LOVE” simpliciter itself.

32 The grounds of opposition under these sections fail at the threshold, and it is not necessary to consider the other elements of these provisions.

“Absolute” Grounds of Opposition

33 Section 7 TMA sets out “absolute grounds for refusal of registration.” Unlike “relative” grounds which deal with conflicts with earlier rights, “absolute” grounds are mainly concerned with the nature of the mark applied for itself. One “absolute” ground commonly relied on is that the mark lacks distinctiveness — other traders might legitimately wish to use the same mark

for their own goods and services, and a single trader should not be conferred a monopoly over such a mark.

34 Here, the Opponent relies on Sections 7(1)(b) and 7(1)(c) TMA, which state as follows:

7. —(1) The following shall not be registered:

(a) ...


(b) trade marks which are **devoid of any distinctive character**;

(c) trade marks which **consist exclusively** of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services...

(emphasis added)

35 These were the same grounds on which the plaintiff successfully invalidated the defendant's plain word mark "LOVE" in the *Love & Co* case: see discussion at [19]-[22] above.



36 The Opponent attempts to rationalise that the Application Mark () is not distinctive (under Section 7(1)(b) TMA) and/or is descriptive (under Section 7(1)(b) TMA) as follows:

- a. The Chinese words 珍金 should be ignored as they are of secondary significance compared to the English words "LOVE GOLD"¹¹;
- b. The word "LOVE" is not distinctive and is descriptive of jewellery (applying *Love & Co*)¹²;

¹¹ See Opponent's Written Submissions ("OWS") at [30]-[39] and [55]. In support of this submission, the Opponent relied on cases involving a comparison between a mark comprising English words, and another mark comprising a combination of English and Chinese words (see, e.g., *Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Limited* [2018] SGIPOS 11, involving a

comparison between " ST. REGIS " and ). During the oral hearing, the Opponent was not able to produce any authorities for the proposition that Chinese words can be disregarded for the purposes of absolute grounds of objections.

¹² OWS at [56]-[58].

- c. The word “GOLD” is similarly not distinctive and is descriptive of jewellery¹³;
- d. The combination of the words “LOVE” and “GOLD” “only adds to the descriptiveness of the goods and services”¹⁴;
- e. Therefore, the Application Mark is not distinctive and is descriptive of jewellery.

37 The Opponent’s approach is clearly misguided. In assessing distinctiveness, a mark should be considered as a whole and not broken up into its component parts.

38 For example, in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941



at [35], the Court of Appeal held that the composite mark - was sufficiently distinctive for perfume under Section 7(1)(b) TMA, even though the words “LADY” and “ROSE” when used separately would not have been distinctive.



39 Indeed, in *Love & Co*, the defendant had another trade mark *the LOVE DIAMOND* registered in respect of diamonds in Class 14. The registration was on condition that the mark gave no right to “the exclusive use of the word “Diamond” and the device of the diamond.” This mark was not the subject of invalidation proceedings. Nonetheless, the Court observed that this mark “with the intricate motif design for the “O” and the attractive arrangement of the words, is unique and distinctive as a logo and a word mark” (see [9] – [12] of the judgment). Once we take away the word “Diamond” and the device of the diamond, we are left with the word “LOVE” itself. Contrary to the High Court’s observations, this mark would not be distinctive applying the Opponent’s approach (“LOVE” ≠ distinctive; “DIAMOND” ≠ distinctive;



diamond device ≠ distinctive → *the LOVE DIAMOND* ≠ distinctive).



40 Here, it is not disputed that the Chinese words 珍金 in the Application Mark () have no meaning. These words comprise a significant portion (at least a third) of the mark as a whole. In my view, the combination of these Chinese words, enclosed in a rectangular device, with the words “LOVE” and “GOLD”, and the arrangement of each of these features as depicted in the Application Mark, render the Application Mark as a whole distinctive.

41 I reject the grounds of opposition under Sections 7(1)(b) and 7(1)(c) TMA.

¹³ OWS at [59]-[64].

¹⁴ OWS at [65]-[68], [72] and [73]; quoted text from [68] OWS.

Conclusion

42 A L Θ V Θ bracelet may represent a metaphorical shackle of a person's loved one. The word "LOVE", however, should be free for traders to incorporate into their trade marks for jewellery.

43 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I dismiss the opposition with costs to the Applicant.

Date of Issue: 20 December 2018