

Intellectual Property Office of Singapore Case Summary: Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp. [2018] SGIPOS 2

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Clarins Fragrance Group, formerly known as Thierry Mugler Parfums S.A.S. (“the Opponent”), is in the fragrance business. Among its products is a line of perfumes bearing the sign “ANGEL”. The Opponent is the registered proprietor in Singapore of the “ANGEL” trade mark in Class 3 for “perfumes” and various other goods.

BenQ Materials Corp. (“the Applicant”), is a company listed on the Taiwan Stock Exchange. It is involved in various fields of business, including the manufacture and sale of healthcare and personal care products such as facial care products and contact lenses. In late 2014, it engaged a third party brand strategist to assist it in developing a brand name and strategy for its new line of skin care products. These products were later launched, advertised and sold under

derma
“*Angel*”. On 5 May 2015, the Applicant applied to register “*derma Angel*” in Class 3 for “cosmetics” and various other goods (“the Application Mark”).


Subsequently, the Opponent filed to oppose the Application Mark.

The Opponent relied on four grounds under the Trade Marks Act (Cap. 332, Rev Ed 2005), namely: (a) Section 8(2)(b); (b) Section 8(4)(b)(i); (c) Section 8(4)(b)(ii); and (d) Section 8(7)(a). It also tendered documentary evidence with a view to proving that “ANGEL” has acquired a high level of distinctiveness through use. In this connection, it argued that on the evidence, “ANGEL” is a trade mark that is not only well known but also well known to the public at large in Singapore.

Distinctiveness

After evaluating the documentary evidence relating to Singapore (specifically, internet printouts from retail websites, forum pages, articles and blogs), the Hearing Officer found that perfumes bearing “ANGEL” were offered for sale to, and purchased by, at least some consumers in Singapore. However, because there was no direct testimony (e.g. from retailers of the goods) or precise sales figures (for “ANGEL”) supported by documentary evidence, he found it difficult to draw any meaningful conclusions on the size of the market and the extent of sales in Singapore.

There was also documentary evidence (including press clippings and various other magazine printouts) which showed that over the years, the Opponent advertised its “ANGEL” perfume in connection with a female celebrity (who personifies


the “ANGEL”) and the following “THIERRY MUGLER” signature mark: . Pertinently, it was found that the Opponent had engaged in extensive advertising in many parts of the world, including neighbouring Malaysia, Hong Kong and the Philippines. However, there was no evidence that the Opponent’s advertising was ever directly aimed at the public in Singapore. Even if some members of the public in Singapore may have been exposed to the Opponent’s advertising abroad, especially through the internet, its impact was likely to have been limited.

What the Hearing Officer found striking about the Opponent’s evidence was that “ANGEL” never appeared without “THIERRY MUGLER” (sometimes in signature form) at least somewhere in the same document. The effect of this was that actual and potential consumers would be educated that “ANGEL” perfume is from or by “THIERRY MUGLER”.

It was ultimately found, on the evidence as a whole, that the Opponent’s “ANGEL” had not acquired a greater level of acquired distinctiveness through use.

Similarity of marks

It is well established that there are three aspects to be considered in assessing whether two competing marks are similar: the visual, aural and conceptual.

The Hearing Officer found the competing marks to be visually dissimilar on account of the first word in the Application Mark, “derma”, as well as the “” element. On aural similarity, the comparison would be between “ANGEL” and “DERMA ANGEL”. Since the latter has one more first word and two additional syllables, the marks were found to be aurally dissimilar. As for conceptual similarity, the comparison was between “ANGEL” (i.e. a heavenly or spiritual or celestial being) on one hand and “DERMA ANGEL” (which has no sensible meaning) on the other. Accordingly, the marks were found to be conceptually dissimilar. Overall, the marks were found to be dissimilar.

One common thread that runs through all the pleaded grounds of opposition is the requirement of similarity of marks. (Although similarity of marks is not a stand-alone element of passing off (under Section 8(7)(a)), a key question there is whether there is such a similarity between the two marks such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived into thinking that the Applicant’s goods are, or emanate from a source that is linked to, the Opponent’s.) Since the competing marks were found to be dissimilar, the opposition failed on all pleaded grounds.

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/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2018/clarins-fragrance-group-v-benq-materials-2018-sgipos-2.pdf?sfvrsn=0>.