

# Intellectual Property Office of Singapore Case Summary: Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd) [2018] SGIPOS 1

Source: <https://www.ipos.gov.sg/protect-ip/hearings-mediation/legal-decisions>

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The Opponent (Guccio Gucci SpA) is the owner of the GUCCI trade mark, registered in respect of a wide range of goods and services in Singapore, including “Porcelain and ceramic articles; drinking glasses and glass flasks” (in Class 21) and retail services (in Class 35). In this application, it opposed under various provisions of the Trade Marks Act an application by a Singapore company, Guccitech Industries (Private Ltd) (“the Applicant”), to register in relation to various



kitchen and cooking appliances the mark

(“the Application Mark”).

The IP Adjudicator found that (a) the dominant and distinctive part of the Application Mark is the word GUCCI and therefore it is very similar to the Opponent’s GUCCI mark registered in Class 21 and 35; (b) the goods in respect of which registration for the Application Mark was sought are in certain respects similar to the goods and services for which the Opponent has obtained registration of the GUCCI mark; and (c) there is a likelihood of confusion as a result, taking into account the particularly distinctive nature of the GUCCI mark. Therefore, the opposition to the Application Mark succeeded under Section 8(2)(b) of the Trade Marks Act (“the Act”).

Likewise, it was held that the Opponent had proved on a balance of probability that it could prevent in a passing off action use of the Application Mark in relation to all or some of the specification of goods and therefore the opposition under Section 8(7)(a) of the Act succeeded.

In addition, the IP Adjudicator found, on the basis of the voluminous evidence submitted by the Opponent, that the Opponent’s GUCCI mark is both well known in Singapore and well known to the public at large in Singapore, as required by the ground for refusal of a trade mark application contained in Section 8(4) of the Act. In those circumstances, use of the Application Mark would dilute unfairly the highly distinctive character of the Opponent’s GUCCI marks by removing the exclusivity the Opponent currently enjoys in the use of GUCCI as an indication of the trade origin of goods and/or services and would give to the Applicant an unfair advantage. For these reasons the opposition to the Application Mark under Section 8(4) of the Act succeeded also. This is a rare instance where a mark has been found to be well known to the public at large, and where the use of the Application Mark has been found to both cause dilution in an unfair manner and take unfair advantage of the distinctive character of the earlier well known mark.

However, the IP Adjudicator rejected the Opponent’s claim that the Applicant had made its application to register the Application Mark in bad faith, finding instead that it had taken a risk when applying for the Application Mark and gambled on the Opponent either doing nothing in response or failing in its opposition. It had failed in that gamble but that did not mean the application had been made in bad faith contrary to Section 7(6) of the Act.

*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/guccio-gucci-v-guccitech-industries-2018-sqipos-1.pdf?sfvrsn=0>.*