

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

Trade Mark No. T1414543D
Hearing Date: 8 November 2017

IN THE MATTER OF A TRADE MARK APPLICATION BY

GUCCITECH INDUSTRIES (PRIVATE LTD)

AND

OPPOSITION THERETO BY

GUCCIO GUCCI S.P.A

Hearing Officer: David Llewelyn
IP Adjudicator

Representation:

Mr Philip Ling and Mr Yap Jie Han (Wong Tan & Molly Lim LLC) for the Applicant
Ms Sue-Ann Li and Mr Jon Chan Wenqiang (Ravindran Associates) for the Opponent

GROUND OF DECISION

1 Registration of a trade mark under the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) accords to its proprietor certain exclusive rights. The more distinctive the trade mark and the more extensive the use of it has been, the more expansive those rights become. At the same time, the likelihood may increase of other traders wishing to benefit in some way by taking an unfair free-ride on its notoriety. It is for this reason that trade mark law now provides special protection for trade marks that are well known. On the other hand, the law is careful not to allow a trader to obtain a patent-like monopoly through the use of a trade mark. The function of a trade mark is to

indicate the trade origin of the goods and/or services for which it is registered and the defences in the Act are available where a mark is used by a third party in a descriptive or other way that does not harm the legitimate rights of the trade mark owner.

2 Guccitech Industries (Private Ltd) (“the Applicant”), applied to register the trade

GUCCITECH
INNOVATION SAVES SPACE

mark (“the Application Mark”) in Singapore on 11 September 2014 under Trade Mark No. T1414543D in Class 11 in respect of “Adjustable coated baffle grease filters (parts of cooker hoods); air extractor hoods for use with cookers; apparatus for cooking; apparatus for cooking out of doors; apparatus for generating steam for cooking purposes; apparatus for the cooking of foodstuffs using a steam-air mixture; appliances for cooking; appliances for cooking foodstuffs; autoclaves (electric pressure cookers); barbecue cooking apparatus; combined cooking stoves and gas containers; commercial cooking apparatus; cooker hobs; cooker hoods; cookers; cookers having vitreous enamelled surfaces; cookers incorporating grills; cooking apparatus and installations; cooking appliances; cooking grills; cooking hobs; cooking installations; cooking machines; cooking ovens; cooking plates (rings); cooking ranges; cooking rings; cooking stoves; cooking tunnels; cooking units; cooking utensils, electric; crepe cookers; devices to treat water to prevent deposits in cooking apparatus; domestic autoclave pressure cookers (electric); domestic cooking apparatus; domestic cooking appliances (electric); domestic gas cookers; domestic pressure cookers (electric); egg cookers; electric apparatus for cooking foods; electric cookers; electric cooking apparatus; electric cooking pans; electric cooking pots; electric cooking stoves; electric cooking utensils; electric domestic cooking appliances; electric food cooking machines; electric pots for cooking; electric pressure cookers; electric slow cookers; electric steamers for cooking; electric steaming apparatus for cooking; electric utensils for cooking; electrical apparatus for the cooking of foodstuffs; electrical apparatus for the preparation (cooking) of foodstuffs; electrical apparatus for the preparation of foodstuffs by cooking; electrical appliances for cooking; electrical cooking apparatus; electrical cooking utensils; electrical installations for cooking; electrical rice cookers; electrically heated domestic cooking utensils; electrically operated cooking ranges; electrically operated cooking ranges adapted for roasting; electromagnetic cooking appliances; exhaust hoods (cooker hoods); extraction hoods for cookers; filters for use with apparatus cooking; fondues (cooking apparatus); gas cookers; gas cooking apparatus incorporating cooking grills; gas cooking appliances; gas operated apparatus for cooking; griddles (cooking appliances); grilling (cooking) apparatus; grills (cooking appliances); hoods for cookers; hot plates for cooking; inset cooking tops; installations for cooking; installations for cooking consisting of halogen heating devices; installations for cooking incorporating halogen heating devices; kebab cooking machines; machines for preparing food (electric, cooking); machines for use in processing meat (cooking or freezing); machines for use in processing vegetables (cooking or freezing); machines for use in the preparation of food (cooking); machines for use in the processing of foodstuffs (cooking or refrigerating); microwave cookers; microwave devices for cooking; microwave installations for cooking foods; microwave ovens (cooking apparatus); multiple cooking plates; non-electric cooking appliances; ovens utilising air frequency fields for cooking; pressure cookers (autoclaves), electric; pressure cooking saucepans, electric; pressure vessels for cooking; rice cookers; rock and ceramic heat distributing materials for use in barbecue grills and cookers; sight glasses for use in heating for cooking; sight panels for use in heating for cooking; smoke

cooking units; smoke generating apparatus for cooking; smoke generators for cooking; spit roasters (cooking apparatus); spits (cooking apparatus); spits (parts of cooking apparatus); stands adapted for cookers; stands for cookers and stoves; steam cookers; stoves (cooking apparatus); stoves for cooking; surface units being parts of cooking apparatus; vapour extraction hoods for cookers; vapour extractor hoods for cookers.”

3 The application was accepted and published on 26 December 2014 for opposition. Guccio Gucci S.p.A (“the Opponent”), filed its Notice of Opposition to oppose the registration of the Application Mark on 27 April 2015. The Applicant filed its Counter-Statement on 27 August 2015.

4 The Opponent filed evidence in support of the opposition on 21 June 2016. The Applicants filed its evidence in support of the application on 21 April 2017. The Opponent filed its evidence in reply on 20 June 2017. Following the close of evidence, the Pre-Hearing Review was held on 19 July 2017. The Opponent and the Applicant both filed their written submissions (respectively, “Opponent’s WS” and “Applicant’s WS”) on 6 October 2017. The opposition was heard on 8 November 2017.

Grounds of Opposition

5 The Opponent relies on the grounds contained in Sections 8(2)(b), 8(4), 8(7)(a) and 7(6) of the Act in this opposition.

Opponent’s Evidence

6 The Opponent’s evidence comprises the following:

- (i) A Statutory Declaration made by Mr Vanni Volpi, Intellectual Property Director of the Opponent, made on 9 May 2016 in Florence (Italy) (“Volpi-1”); and
- (ii) a Statutory Declaration in Reply made by the same Mr Vanni Volpi on 16 June 2017 in Florence (Italy) (“Volpi-2”).

Applicant’s Evidence

7 The Applicant’s evidence comprises a Statutory Declaration made by Mr Tan Kim Poh, Director and Shareholder of the Applicant on 21 April 2017 in Singapore (“Tan-1”).

Applicable Law and Burden of Proof

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

Background

9 The Applicant, Guccitech Industries (Private Limited), was incorporated in Singapore in 2010 and, *inter alia*, is engaged in the business of designing and manufacturing household appliances. In Tan-1, his statutory declaration on behalf of the Applicant, of which he is a director and in which he is a shareholder, Mr Tan Kim

Poh states, at [11], that “My aspiration for the applicant is that it will one day be a cutting-edge and innovative player in the household appliance market, synonymous with state-of-the-art designs and products.” As an example of this, Mr Tan describes, at [12] to [14], how the Applicant, “after a long period of research and painstaking experimentation”, has designed a stove that may be folded up when not in use and two designs for this have been registered by the Applicant under the Registered Designs Act (Cap 266, 2005 Rev Ed) (copies form Exhibit TKP-4). It should be noted that for each of these designs at least one of the representations of the article (a foldable stove) includes the word GUCCITECH.

10 Mr Tan describes, at [17] of Tan-1, the Applicant as an associated company of Gucci Tex International Pte Ltd, that was incorporated in Singapore in 1993 and is itself, in the words of Mr Tan, “the regional marketing arm of an Indonesian company, PT Gucci Ratu Industries, which has been engaged in the textile manufacturing business for more than 35 years with an annual turnover in the region of US50 million.”

11 Mr Tan explains also, at [20] to [22], how the Application Mark was created by a Dutch design company, Pezy Group, and exhibits (at Exhibit TKP-5) three presentations by the design company, one dated 28 January 2014 and two 30 April 2014, that set out *inter alia* how they had arrived at the new logo [the Application Mark] and how it should be used on product packaging.

12 The Opponent, Guccio Gucci S.p.A, is the owner of the globally renowned brand GUCCI that can trace its history as far back as 1921 when Mr Guccio Gucci opened a shop in Florence, Italy. The history and business activities of the Opponent are set out in text and images in Exhibit VV-1 to Volpi-1. Today it is part of the Kering group (known as PPR or Printemps-Pinault- Redoute until 2013) that owns other brands such as Bottega Veneta and Yves Saint Laurent “but Gucci was its star performer”, accounting for “nearly two-thirds of its profit” (see the 2015 article in Business Insider (<http://www.businessinsider.sg/kering-and-gucci-2015-financial-results-sales-income-outlook-2016-2/#.Vxb4Tix-ND8>) referred to in Volpi-1 at [25]).

13 The Opponent states, at [27] of Volpi-1, that its sales in Singapore of products under the GUCCI trade marks in the years 2010, 2011, 2012, 2013 and 2014 were “[m]ore than tens of millions” SGD (sensibly, this was not challenged by counsel for the Applicant at the hearing before me.) The range of products on which the GUCCI trade mark is used today is broad and extends far beyond the bags, shoes and clothing for which it is most known. In Volpi-1, Mr Volpi makes reference to and gives examples of beauty and cosmetics products such as eyeliner pencils and foundation (at [23]); lifestyle products like bicycles, neck cushions, gloves, goggles and yachts (at [24] to [29]); food and beverage services (at [35] to [38]), including cafés; and games products (at [39] to [43]) such as playing cards, chess and backgammon sets, all under the GUCCI mark. In addition, he refers to the use of the GUCCI mark on products used in the technology area such as mobile phone covers and USB devices (at [44]).

14 Also, the Opponent advertises and promotes its products extensively and has done so for many years, including in Singapore where it is stated by Mr Volpi (at [29] of Volpi-1) that its “expenditure has been in the region of hundreds of thousands of euros”. He exhibits at Exhibit VV-4 copies of such advertising and promotion in Singapore bearing the GUCCI trade marks. (Again, the Applicant has sensibly not sought to

challenge the extent of the promotion and advertising of the GUCCI trade marks in Singapore.)

15 Before proceeding to the grounds for my decision, I wish to put on record that, much as it may be interesting to an historian of brands or an *aficionado* of fashion, a significant number of the 6,852 pages of exhibits submitted by the Opponent in support of its case is irrelevant to the issues to be decided and yet would have needed to be read (at least quickly) by the Applicant’s lawyers and was read or looked at carefully and considered by this tribunal. While I am aware from my own experience that clients involved in contentious matters often demand quantity in the belief that it assists their case in some way, I would respectfully suggest that counsel in trade mark opposition proceedings should seek to restrain such an impulse to bury the tribunal and the opposing party in material that is irrelevant or excessive.

MAIN DECISION

Ground of Opposition under Section 8(2)(b)

16 Section 8(2)(b) of the Act reads:

“(2) A trade mark shall not be registered if because —

...

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

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

Decision on Section 8(2)(b)

17 In order to establish whether this ground of opposition is satisfied, a step-by-step analysis is required wherein there must be determined, first, whether the marks are similar; and if so, secondly, whether the goods or services are identical or similar; and again if so, thirdly, whether as a result of the previous two determinations there exists a real likelihood of confusion.

Similarity of Marks

Application Mark	Opponent’s Mark
	GUCCI

18 The first step (of marks-similarity, for which I reproduce both immediately above) requires consideration of the two marks in question without reference to the goods or services in respect of which they are registered or are sought to be registered but bearing in mind that the average consumer would exercise some care and a measure of good sense when making his or her purchases of whatever may be the goods. At this stage, it is not permissible to imbue this hypothetical person with the attentiveness that

s/he may exercise when it comes to considering the actual goods in question, as this is a matter for the likelihood of confusion stage if it is reached.

19 The marks-similarity assessment must take into account the presence or absence of visual, aural and conceptual similarities (as re-affirmed by the Court of Appeal in *Sarika Connaissance Café Pte Ltd v Ferrero SpA* (“*Nutella*”) [2013] 1 SLR 531 at [16]). This is an overall evaluation of the marks, as applied for (by the Applicant) and registered (by the Opponent), without consideration of any other material or matters. Obviously, ‘similarity’ can lie anywhere on a spectrum that ranges from identical (or 100% similarity) to no similarity (or 100% dissimilarity), with various degrees of low and high in between. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) cautioned against a “checkbox exercise” rather than a “sensible appraisal of the marks as a whole”.

20 Each of the two marks must be considered as a whole and not broken down into its component parts, for that is the way the average consumer of whatever may be the relevant goods/services would consider them, although the possible impact of imperfect recollection must be borne in mind. When considering a composite mark such as the Application Mark, this latter consideration requires an evaluation of what is or are the essential element(s) of the mark, for it is that or those that the average consumer would pay attention to.

21 At this stage, the comparison is solely between the mark applied for and the earlier mark, without reference to any other matter or material: as explained by the Court of Appeal in *Staywell*, at [20]: “*this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods*”.

22 The Application Mark is a composite mark comprised of three elements: the word GUCCITECH with an initial letter G in a stylized form and, below the word and in much smaller lettering, the strapline INNOVATION SAVES SPACE. The Applicant contends that the stylization of the G “is designed to represent and symbolize the [Applicant’s] Foldable Stove” in two different ways: first, the spacing between the two parts of the letter is intended to represent the letters G and T in the word GUCCITECH (that is also the predominant part of the Applicant’s company name) and, secondly, the truncated version of the letter T within the stylized letter G refers to the stove arm and its folding feature. The strapline is the Applicant’s motto that refers to the attributes of its foldable stove, being that it is “innovative” and “saves space” (at [17(d)] of the Applicant’s WS).

23 The Opponent owns many registered trade marks in Singapore but in relation to this ground relies on its registrations for the word GUCCI in Classes 21 and 35 (the “Opponent’s Marks” or the “GUCCI Marks”), as set out below.

Mark & Registration No.	Specification
<p style="text-align: center;">GUCCI</p> <p style="text-align: center;">TM No. T8301755E</p>	<p>Class 21: Porcelain and ceramic articles; drinking glasses and glass flasks.</p>

Mark & Registration No.	Specification
<p data-bbox="280 300 544 371">GUCCI</p> <p data-bbox="284 412 552 443">TM No. T1319783Z</p>	<p data-bbox="595 277 1334 1957">Class 35: 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, such services may be provided by retail stores or wholesale outlets; wholesaling services and on-line retail services; online retail store services; advertising and promotional services, all the aforementioned provided by electronic means including e-mail; on-line advertising on a computer network; polling and opinion research services; marketing studies; advertising and promotion services and consultancy related thereto; arranging of fashion shows for advertising and promotional purposes; business management assistance; marketing; business management consultancy; relocation services for businesses; management of computer files; accounting; business auditing; rental of automatic vending machines; research of sponsors; advertising; rental of advertising space; dissemination of advertising matter; direct mail advertising; direct mail advertising (tracts, brochures, printed matter, samples); arranging newspaper subscriptions for others; publication of publicity text; business management; business administration; office functions; distribution of prospectuses and samples; business consultancy, information or enquiries; business research; commercial or industrial management assistance; business or industrial appraisals; accounting; document reproduction; employment agencies; management of computer files; data entry and data processing; systematization of information into computer database; organization of exhibitions for commercial or advertising purposes; modeling for advertising or sales promotion; outdoor advertising, shop window dressing; import-export agencies; sales promotion (for others); marketing research; auctioneering; promotion of products by television with offer of sale; organization of commercial events; arranging and conducting business management administrative exhibitions; presentation of goods on communication media for retail purposes; provision of business information and business advice to consumers; business administration of licensing of products and services; retail services relating to the sale of stationery products, leatherwear, imitation jewellery, eye wear, umbrellas, glassware, porcelain, cutlery, sports articles, of linens of house, furnishing, of dress and footwear articles and of telecommunication apparatus.</p>

24 The word GUCCI has a high degree of technical distinctiveness without use or reference to particular goods or services: it is not a word like POLO, CAESAR or REGIS that is also a word in the English language. As the Court of Appeal held in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”), in relation to the comparison between the earlier CAESAR mark and the later CAESARSTONE mark after noting that “*we do not think that the presence of such a descriptive element [STONE] can fairly be regarded as being effective to displace similarity*”:

“the real question here is whether the word ‘stone’ serves to *sufficiently and substantially distinguish* [the later from the earlier mark]. In our judgment, ..., it does not.”

(Emphasis in original).

25 Looking at it as a whole, the dominant and distinctive part of the Application Mark is the word GUCCI, notwithstanding the addition in the word GUCCITECH of the descriptive -TECH suffix and the presence of the strapline INNOVATION SAVES SPACE in much smaller lettering. I consider also that the stylized G is a component of the Application Mark that is unlikely to be accorded meaningful attention by the average consumer, albeit that it may be noticed in passing. Thus, it must follow that visually the two marks are very similar and the Applicant has failed to sufficiently distinguish its mark from the Opponent’s. On this point, I have taken into consideration the submission (at [15 (g)] of the Applicant’s WS) that, on the basis of the differences, the average consumer “would easily tell the two marks apart” but note that such a submission does not address the essential enquiry at this stage, whether the marks are more similar than dissimilar. In my view, they clearly are.

26 In relation to aural similarity, the Applicant contended (at [16] of the Applicant’s WS) that I should follow what it describes as “[o]ne of the established approaches applied by Courts and Tribunals [ie] ... carrying out a quantitative assessment as to whether the two marks have more syllables in common than not”, citing in support *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at [55], and stated that the Application Mark has nine syllables whereas the Opponent’s GUCCI Marks have only two. However, counsel for the Applicant admitted at the hearing that the correct aural comparison is between the Application Mark’s three syllable GOO-CHEE-TEK (and I note in passing that counsel for the Applicant also had no hesitation in accepting that the Application Mark would be pronounced in this way) and the Opponent’s two syllable GOO-CHEE.

27 Notwithstanding this admission and the fact that even on a purely quantitative basis there is aural similarity between the two syllable GOO-CHEE and the three syllable GOO-CHEE-TEK, I do not consider that it is appropriate or helpful when considering a composite mark comprised of different elements of widely varying degrees of distinctiveness (or, to put it in the converse, descriptiveness) to conduct a simple syllable count. To do so could have the consequence that a later mark could be differentiated sufficiently from a third party’s distinctive earlier mark incorporated in it merely by adding sufficient matter of a descriptive nature as to overwhelm in purely quantitative terms the distinctive element that comprises the opponent’s earlier mark: for example, a later mark comprising NIKE: MAKES YOU RUN BETTER would then

be more dissimilar than similar to NIKE even though the only distinctive part of the later mark is the word NIKE.

28 Instead, I consider that the aural comparison should be between the Opponent's mark GOO-CHEE (a combination of sounds that does not form part of the English language) and, while not ignoring the presence of -TEK, the dominant and distinctive two-syllable GOO-CHEE of the word GOO-CHEE-TEK. Also, the strapline would again play a relatively insignificant role in the aural rendition of the Application Mark, notwithstanding the fact that in considering the Application Mark from the *aural* perspective I may not take into account the smaller lettering in which it is included in the composite mark. In view of the fact that the dominant and distinctive part of the Application Mark remains GOO-CHEE notwithstanding the addition of other matter that is either descriptive or without trade mark significance, I find that the two marks are very similar aurally.

29 As far as conceptual similarity is concerned, the word GUCCI has an Italian connotation although it does not have any dictionary meaning in the English (or indeed the Italian) language; I recognise that there are Italians and others in Singapore who may be aware that it was the family name of the founder Mr Guccio Gucci but do not consider that this awareness is shared by the average consumer. In view of that Italian connotation of the word GUCCI, the fact that the entirety of that word comprises the dominant and distinctive part of the Application Mark means that the Application Mark is very similar conceptually to the Opponent's Marks.

30 My overall impression of marks-similarity is thus that they are very similar visually, aurally and conceptually; and so I proceed to consider similarity of the goods in respect of which registration is sought by the Applicant and those for which the Opponent's Marks are registered in Classes 21 and 35.

Similarity of Goods or Services

31 The Applicant's specification of goods is an extremely detailed list of appliances and other goods used in or as part of the process of cooking or preparing food, which I have set out in full in [2] above and need not repeat.

32 The Opponent's TM No. T8301755E is registered in Class 21 for "Porcelain and ceramic articles; drinking glasses and glass flasks" and the Opponent's TM No. T1319783Z in Class 35 for various wholesale and retail services including: "retail services relating to the sale of stationery products, leatherwear, imitation jewellery, eye wear, umbrellas, glassware, porcelain, cutlery, sports articles, of linens of house [sic], furnishing, of dress and footwear articles and of telecommunication apparatus" (again, for clarity, I shall refer to these two registered trade marks relied on by the Opponent under this ground together as either "the GUCCI Marks" or "the Opponent's Marks"). The complete specification for both is set out at [23] above.

33 When comparing the respective specifications, I must consider the full spectrum of goods (or services) named therein and whether, based on their nominal and fair use, any or all of them are similar. In doing so, I bear in mind the non-exhaustive factors set out by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 286 that have been applied in a number of decisions, including *Monster Energy*

Company v Mixi [2017] SGIPOS 12 at [75]-[76] which also cited the Court of Appeal in *Staywell* at [43] to the effect that particular factors such as uses and end-users may be relevant at the goods-similarity stage.

34 The Opponent contends that the goods comprising the Applicant's specification of goods and the specification of goods in its T8301755E (Porcelain and ceramic articles; drinking glasses and glass flasks) are similar as the latter are used in the *consumption* of food and the former in its *preparation*. Indeed, it was accepted by the Applicant's counsel at the hearing that cooking appliances such as those contained in the Application Mark's specification of goods may be found in proximity to the Opponent's porcelain and ceramic articles and drinking glasses in the kitchen section of a department store such as Takashimaya.

35 As far as the specification of services in T1319783Z is concerned, the Opponent cites Tan, *Law of Trade Marks and Passing Off in Singapore* (3rd ed, 2014) at [8.115] that:

“goods and services can also be regarded as similar to each other. This will, for instance, be the case where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such, and vice versa”.

I would respectfully agree with the general view expressed by the learned author Mr Tan Tee Jim SC, although I consider that the example given is the only circumstance where goods could be found to be similar to the retail services in a specification (it cannot be the case that a general retail services specification that does not refer to any particular goods must be regarded as similar to *any* goods that may be sold in a retail outlet.)

36 Again I must consider a notional and fair use of the mark GUCCI in relation to all the services contained in the specification for T1319783Z but particularly those referred to at [32] above, namely, “retail services relating to the sale of stationery products, leatherwear, imitation jewellery, eye wear, umbrellas, glassware, porcelain, cutlery, sports articles, of linens of house [sic], furnishing, of dress and footwear articles and of telecommunication apparatus.” The latter services encompass a broader range of goods in respect of which the retail services are provided than the goods covered by T8301755E, namely “Porcelain and ceramic articles; drinking glasses and glass flasks”. I would refer particularly to “cutlery” and what I assume is meant to be “house furnishing”, both of which in a department store or specialist outlet may reasonably be expected to be in proximity to some of the goods contained in the specification of goods for the Application Mark. Thus, for the reasons expanded upon below in relation to the Opponent's registered trade mark T8301755E, I consider the services for which the Opponent's T1319783Z trade mark is registered to be similar to at least some of the goods contained in the Applicant's specification of goods, and I refer in this context to the subset of that specification that I describe at [42] below.

37 Turning to a comparison of the specification of goods in respect of which the Application Mark is sought to be registered and those contained in the Opponent's other registration, T8301755E, that it relies on under this ground, I should say first of all that I do not consider it correct to examine a specification of goods or services as if it is a testamentary disposition, although that for the Application Mark is granulated and

detailed. What is required is to use practical common sense, whilst bearing in mind that the presence or absence of a particular description of goods in a specification does not have the consequence that it had under the old pre-1999 trade mark law (which protected only against use on or in relation to the same goods as those in the specification), now that under the Act a trade mark owner may be protected against use (or registration) of an identical or similar mark in relation to *similar* goods or services which may not even fall within the same class. (Obviously, these are rights accorded by the Act to all trade mark proprietors regardless of whether, or the extent to which, they have used their registered trade mark and, over and above these, there are enhanced rights given to the owner of a well known registered trade mark vis-à-vis use even on *dissimilar* goods.)

38 To reiterate, at this stage the comparison I have to make is between the specification of goods in respect of which the Application Mark is applied for and the specification of goods in the Opponent's registered mark T8301755E. I must not, and do not, consider any actual use of either or both marks in question (and refer here to the Court of Appeal in *Nutella* at [47], whilst bearing in mind that that case involved an infringement under Section 27 rather than an opposition under Section 8).

39 I confess readily that my initial reaction on this issue was that the goods are not similar. However, upon further reflection I consider that that was not a correct reaction in the trade mark law context in which I must decide, namely whether the goods are similar when taking into account the marketplace in which they are likely to be purchased and used. In this connection, I emphasise once again that trade mark law no longer limits, as it did before 1999, the protection accorded to a registered trade mark to the right to prohibit use in the course of trade on goods that are identical or of the same description as those for which the mark is registered. The protection was very deliberately extended by the Act in a number of important ways, and the extension to 'similar' goods or services (in both infringement and opposition scenarios) is one of those ways. For an example of the consequences, I refer to the Court of Appeal's analysis of the similarity of goods issue in *Nutella*, at [40] to [53], at the end of which it upheld, at [53], the trial judge's finding that the appellant's coffee beverage was similar to the respondent's 'chocolate products' specification.

40 Although clearly the respective goods to be considered under this ground (a wide range of 'cooking appliances', on the one hand, and porcelain and ceramic articles and drinking glasses, on the other) are not the same or even of the same description, that is not sufficient to dismiss the ground for refusal under Section 8(2)(b). I must also decide whether they are 'similar'.

41 In trade mark law, the word 'similar' is not a synonym for 'competing' or, as an economist may say, substitutable (although whether the goods are or may be is an important factor in many cases). It is broader than that and must be interpreted as meaning more than whether some or all of the goods in the later specification fall within the former (as in such circumstances there would be overlap and that is dealt with by the word 'identical') and in the right context may also encompass goods that are complementary, such as lighters and tobacco products. Thus, in this case, both sets of goods may be offered for sale and sold by the same sellers, they may be viewed and chosen for purchase by the same purchasers on the same occasion in the same place (or in very close proximity, as in the neighbouring 'kitchenware' and 'tableware' sections

in the Takashimaya department store in Ngee Ann City or the 'Table Top' and 'Kitchen' sections at Tang's in Orchard Road), for use on the same occasion in the same place (the kitchen or in close proximity to it) as part of the preparation and presentation of food for subsequent consumption. For example, a fondue or a rice cooker may well be purchased in the same place on the same occasion as plates that will be used in close proximity for the delivery of its cooked contents: or, to put it into its notional trade mark context for the purposes of this opposition, a GUCCITECH rice cooker or mini-oven displayed for purchase in one part of the Housewares section may be chosen for purchase first, closely followed by GUCCI plates, bowls and glasses in the neighbouring aisles, or vice versa. In such circumstances I consider it is unduly artificial to draw rigid lines around the rice cooker or mini-oven (and other cooking appliances) and characterise them as not similar to other goods which are intimately connected with (indeed are a necessary corollary to) the purpose for which they are purchased and will be used.

42 I have reviewed carefully the Applicant's lengthy specification of the goods in respect of which it seeks registration. In doing so, I have identified a subset which is most likely to be sold at wholesale and retail outlets in proximity to 'porcelain and ceramic articles and/or drinking glasses' covered by the Opponent's registered mark T8301755E and is therefore most likely to be viewed and purchased by the same universe of potential buyers (who may be end-users or could be purchasers for others). This subset (and I do not intend for it to be viewed as either a finding that all other goods are not so similar as there is much repetition in the specification or that there is no repetition and redundancy in the subset) is comprised of "apparatus for cooking; apparatus for cooking out of doors; appliances for cooking; appliances for cooking foodstuffs; cookers; cooking apparatus and installations; cooking ovens; electric cooking utensils; fondues (cooking apparatus); machines for use in processing meat (cooking or freezing); machines for use in processing vegetables (cooking or freezing); machines for use in the processing of foodstuffs (cooking or refrigerating); microwave devices for cooking; pressure vessels for cooking; rice cookers; rock and ceramic heat distributing materials for use in barbecue grills and cookers; spit roasters (cooking apparatus); stands for cookers and stoves; steam cookers; stoves (cooking apparatus); surface units being parts of cooking apparatus; vapour extraction hoods for cookers."

43 This subset and the Opponent's specification do not overlap meaningfully (although I note that the Applicant's specification does include "ceramic heat distributing materials for use in barbecue grills and cookers" which on a very strict analysis overlaps with ceramic articles included in the Opponent's specification). Thus, none of the goods contained in the two specifications can be described as identical. On the other hand, they are similar in the sense that they are all goods complementary or used in the process of preparing food by whatever means and in that food's subsequent consumption. I consider it would be unrealistic to draw a fine line between the goods used in the preparation of food and those used in its consumption as both are often sold and used in close proximity: for example, in a retail environment cooking appliances like rice cookers or microwave ovens are often sold in the same section as ceramic articles and drinking glassware and food cooked in a domestic or commercial oven in a kitchen is often placed immediately on porcelain plates for service or consumption. Thus, in view of the inclusion in the specification of goods for the Application Mark of at least the above subset, I consider that there is the requisite similarity of goods.

44 I am cognisant of the warning given by the Court of Appeal in *Nutella* that “*the concept of similarity of goods should not be over extended or be interpreted too broadly*” (at [46]) but nevertheless consider, for the reasons given above, that the respective goods in the two specifications are similar. In arriving at this conclusion I have taken some comfort from the decision of Mr Simon Thorley QC (sitting as a deputy High Court judge) in *Pfizer Lrd v Eurofood Link (UK) Ltd* [2001] FSR 17 where he found similar the plaintiff’s ‘pharmaceutical and veterinary preparations’ and the defendant’s ‘non-alcoholic beverage intended to be marketed as capable of stimulating the libido’. In doing so, the learned judge held, “*not without some hesitation*” (at [53]), that “*the goods, whilst superficially different, do have similarities in that both are designed to appeal to those suffering from impotence*” (at [52]). I too have hesitated but have come to the same conclusion. Of course, as also noted by the Court of Appeal in *Nutella*, at [48], even if a specification is interpreted broadly “*a registered owner still needs to establish further the third element, namely, likelihood of confusion*”. I now move on to consider that element.

Likelihood of Confusion

45 As I have found that there is the requisite similarity of marks and of services and goods, I now proceed to consider whether there is a likelihood of confusion with either or both of the GUCCI Marks as a result of those similarities.

46 In *Caesarstone* at [56] the Court of Appeal explained:

“The likelihood of confusion inquiry directs the court to look at (a) how similar the marks are; (b) how similar the goods or services are; and (c) given this, how likely it is that the relevant segment of the public will be confused (*Staywell* at [55]). In opposition proceedings, the inquiry takes into account the actual and notional fair uses of both the existing and the application mark (*Staywell* at [60].”

At this stage, the following factors relating to consumer perception may be taken into account (*Staywell* at [96(a) and (b)]):

- For the marks, the degree of similarity, their reputation and the impression given, bearing in mind the possibility of imperfect recollection of the marks; and
- For the goods’ similarity, how and in what circumstances consumers would normally purchase goods of that type, whether they are expensive or not; the nature of the goods and whether prospective purchasers would give more or less attention than usual to their purchase, and the likely characteristics of the relevant consumers and whether they would tend to exercise care or have specialist knowledge when making a purchase.

47 As emphasised by the Court of Appeal in *Caesarstone* at [57], there are two possible types of confusion:

“The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may

perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated (*Hai Tong* at [74])”.

48 I have already found that the marks are very similar even without taking into account any use, as I am now required to do at this stage. Thus, any evidence of use of the Opponent’s GUCCI Marks relied upon under this ground of refusal could enhance the contribution the mark’s distinctiveness will make to the likelihood that the marks-similarity will result in confusion. However, it is not open to me under this ground to take into account use by the Opponent of the mark GUCCI in relation either to (a) goods other than those included in the specification of goods for the Opponent’s mark that I have found is similar to the Application Mark, namely T8301755E registered in respect of “Porcelain and ceramic articles; drinking glasses and glass flasks”, or to (b) services other than the services included in the specification of services for the Opponent’s mark GUCCI No. T1319783Z, “retail services relating to the sale of stationery products, leatherwear, imitation jewellery, eye wear, umbrellas, glassware, porcelain, cutlery, sports articles, of linens of house [sic], furnishing, of dress and footwear articles and of telecommunication apparatus”, that I have also found are similar to some or all of the goods contained in the specification of goods for the Application Mark. Thus, I may not and do not take into account under this ground of refusal any use of the Opponent’s other 28 registered marks comprised of the GUCCI word alone (set out at [68] below).

49 The Opponent has submitted much evidence of use of the trade mark GUCCI *in Singapore* in relation to a variety of goods and in relation to the goods contained in this specification (first registered in 1983) these are included in a number of the photographs contained in Exhibit VV-4 to Volpi-1. Also, in Volpi-2, Mr Volpi states, at [19], that “Gucci has a business presence and has shown interest in the household products industry since many decades” and includes photographs of drinking glasses and porcelain products (also in Exhibit VV-15). He also deposes, at [20], that “in 2013, the Opponent also acquired Richard Ginori, the renowned Italian manufacturer of fine porcelain tableware, to better compete in the high-end tableware sector” and exhibits, in Exhibit VV-16, a screenshot of the Richard Ginori website and newspaper articles that reported the acquisition by Gucci.

50 I do not give any weight to the latter evidence, which either does not impact on the position in Singapore (as in the case of Ginori) or lacks proof that the materials referred to and exhibited were either distributed in Singapore or illustrate products that were offered for sale in Singapore. Nevertheless, in the light of the other evidence of use in Singapore in relation to goods falling within the specification, I attribute a heightened distinctiveness to the Opponent’s mark in question over and above even that inherent in a word that to the average consumer of the relevant goods (porcelain and ceramic articles; drinking glasses and glass flasks) in Singapore is equivalent to an invented word that has no meaning at all, either in relation to the relevant goods or any other goods or services, other than as an indication of origin, i.e. a trade mark.

51 The Applicant appears to accept in relation to this ground of refusal that “the reputation of the GUCCI Word Mark is well known”, one assumes in Singapore (although, in relation to Section 8(4)(b)(ii), it puts the Opponent to strict proof that it is “well known to the public at large in Singapore”), but contends that “the ostensible reputation of the Gucci Word Mark [T8301755E and T1319783Z] is likely to have an effect contrary to a likelihood of confusion not least because of the words

‘INNOVATION SAVES SPACE’ which form a key component of the Applicant’s Mark” (at [28b] of the Applicant’s WS). In support of this contention, the Applicant relies on the Court of Appeal decision in *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512, a case that involved an opposition to the registration of MOBIS by the owner of the well known trade mark MOBIL. However, having reviewed carefully the decision of the Court of Appeal in that case, I do not consider it helps the Applicant. The decision in that case was premised on the fact that the mark applied for MOBIS was similar but noticeably different to the well known MOBIL mark. In the case before me the Application Mark has taken the whole of the Opponent’s word mark GUCCI (which as a word has no meaning, or allusive quality like MOBIL) and sought, through the addition of a descriptive suffix –TECH and (in a much smaller type) a non-distinctive slogan (or strapline as it is known in the marketing industry) that could well refer to the products of many businesses, to argue that it is not similar to GUCCI. I have found already that they have not succeeded in that argument.

52 After careful consideration of all the evidence, I consider there is a real possibility that when encountering the Application Mark the average consumer, visiting a department store for example to buy cooking appliances, would naturally assume that goods sold under it come from a source that is in some way economically linked with the owner of the registered trade mark T8301755E. Whilst I accept that the Application Mark includes the stylised G, the suffix –TECH and the words INNOVATION SAVES SPACE in much smaller lettering, the *dominant and distinctive part*, and the one on which the average consumer would focus, is the word GUCCI (the whole of the mark registered by the Opponent in relation to ‘porcelain and ceramic articles; drinking glasses and glass flasks’.)

53 In this context, I consider that the average consumer of the goods contained in the specification of the Application Mark, some of which are relatively inexpensive items like rice cookers, electrical cooking utensils and fondues, would pay a normal degree of attention to their purchase, more than for a purchase of a ‘fast moving consumer good’ (FMCG) but less than if they were considering the purchase of a car. Unlike the consumers of Class 19 goods such as tiles which the Court of Appeal in *Caesarstone* found, at [64], would be “indifferent to the mark used in relation to the goods”, the average consumer of goods included in the specification of goods for the Application Mark and for those contained in the Opponent’s mark T8301755E would certainly pay attention to the relevant mark and at that point would be likely to think wrongly that there exists some trade link between the two.

54 When comparing the services covered by the specification for the Opponent’s registered mark T1319783Z, and particularly “retail services relating to the sale of stationery products, leatherwear, imitation jewellery, eye wear, umbrellas, glassware, porcelain, cutlery, sports articles, of linens of house [sic], furnishing, of dress and footwear articles and of telecommunication apparatus”, there is extensive evidence contained in the exhibits to Volpi-1 and Volpi-2 that permits me to find that the Opponent’s T1319783Z registered in respect of retail services has acquired as a result of its use in Singapore over the years since 1979 a heightened distinctiveness that exceeds even its inherent distinctiveness. As a consequence, I consider that, were there to be notional and fair use of the Application Mark across the spectrum of its specification of goods, there is a serious likelihood that the average consumer would

assume, contrary to the fact, that there is some form of trade connection with the owner of the GUCCI mark for those retail services.

55 I draw some support for my findings from the fact that Section 2(4) of the Act specifies that “use” of a trade mark for the purposes of the Act includes use other than by way of a graphic representation. Therefore, the notional and fair use of the Application Mark and the Opponent’s GUCCI Marks must take into account possible oral use. As I have noted above at [26], counsel for the Applicant accepted at the hearing that oral use of the Application Mark would be GOO-CHEE-TEK (and admitted that INNOVATION SAVES SPACE would not be enunciated). In the light of this, it is common-sense to conclude that where the Application Mark is used orally (whether over the telephone or in spoken advertising) the average consumer would be likely to assume wrongly that there is some trade connection between GUCCITECH and the GUCCI Marks used by the Opponent.

56 I therefore find there is a serious likelihood of confusion between the Application Mark and both of the GUCCI Marks.

57 In concluding on this ground for refusal, I emphasise that due to their inherent distinctiveness coupled with extensive use in Singapore and elsewhere that has heightened that distinctiveness, I am of the view that the Opponent’s registered GUCCI marks T8301755E and T1319783Z are in the same category as invented words such as LENOVO, SONY, EXXON and VOLVO that have no significance in themselves other than as an indication of a particular trade origin of goods or services. In that light, confusion is highly likely where the whole of that mark is taken without authorisation by a third party.

58 The ground of opposition under Section 8(2)(b) therefore succeeds.

Ground of Opposition under Section 8(4)

59 Section 8(4) of the Act reads:

“(4) 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;
 - (ii) if the earlier trade mark is well known to the public at large in Singapore —

- (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (B) would take unfair advantage of the distinctive character of the earlier trade mark.”

Decision on Section 8(4)

Whether whole or an essential part of the applicant’s mark is identical or similar to the earlier mark

60 In order for an opposition to succeed under one or more of the different limbs under Section 8(4), it is necessary for the opponent to establish first of all that the whole or an essential part of the applicant’s mark is identical or similar to the earlier mark. If that is proven, the other parts of the provision need to be established.

61 In relation to this first element, Justice George Wei in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 considered, at [142]-[145], whether in view of the different wording of the two provisions there is any difference in the marks-similarity analysis required under Section 8(4) and that under Section 8(2)(b) and concluded (at [146]) that there is not.

62 I have found already in relation to the Section 8(2)(b) ground of refusal that the Application Mark is very similar to the Opponent’s mark GUCCI as the entirety of that mark comprises the dominant and distinctive part of the Application Mark. Thus, in the context of this ground of refusal, I need only adopt the different wording of the section and find that an essential part of the Application Mark is identical to the Opponent’s GUCCI mark, both of which I reproduce again below for convenience.

Application Mark	Opponent’s Mark
	

As I have stated above at [25], I do not consider that the presence in the Application Mark of the descriptive suffix –TECH or (in much smaller lettering) the words INNOVATION SAVES SPACE alters this.

Well known in Singapore

63 The mark GUCCI has been used in Singapore since 1979 (see Volpi-1, at [5], which is not contested by the Applicant). I am satisfied, on the basis of the voluminous evidence contained in the more than 6,000 unnumbered pages in the exhibits to that statutory declaration and to some of which I have already referred, that the mark GUCCI is well known in Singapore to, at the very least, the average consumer of the goods offered for sale at retail outlets operated by the Opponent under the GUCCI mark at locations such as Changi Airport, the Paragon shopping mall in Orchard Road, the Takashimaya department store in Orchard Road and at The Shoppes retail complex in Marina Bay Sands, as required by Section 8(4)(a).

64 Volpi-2 filed by Mr Volpi refers, at [62], [63] and [64], to searches conducted using the Google search engine, on dates that are not revealed but I consider it reasonable to assume were done on or around the date on which Mr Volpi swore his statutory declaration. These searches, a screenshot from each of which is reproduced in the paragraphs referred to, disclose what is easy to anticipate: that use of the search terms “guccitech” and “gucci tech” will result overwhelmingly in a search result showing sites offering for sale products of the Opponent. However, four of the first five results from the first of the two google.com.sg searches reproduced at [63] (it is not clear from the face of the document how or if they interrelate), using “guccitech” as the search term, are for the Applicant’s “automatic standing stove” (which is the top result) and for the Applicant’s corporate information (Guccitech Industries (Pte Ltd) in two of them and Guccitech Industries (Private) Ltd in the third). The fourth of the five top results is for “Gucci Tech & Accessories for Men. Nordstrom”, which relates to the Opponent’s products. In the screenshots reproduced at [64], in response to the search term “Gucci tech”, nine of the first ten results are for the Opponent’s products and one for “guccitech.com.sg-Singapore Business Directory” (at the date of writing of these Grounds, this domain name does not appear to be active). Additionally, in the screenshot copies of searches conducted on Google on 6/7/2016 that form Exhibit VV-10, a search for “GUCCI tech” had 17,800,000 results of which 17 of the first 20 related to the Opponent’s GUCCI products, two to the Applicant and one to a record album called “I’m Gucci”.

65 At the hearing, counsel for the Applicant put considerable emphasis on the facts which are set out in [9-10] above, that the Applicant was founded in 2010, is a company associated with another Singapore company Gucci Tex International Pte Ltd, incorporated in 1993, that is itself linked with an Indonesian company, PT Gucci Ratu Industries, and yet the Opponent had not objected before filing its opposition against the Application Mark. However, I attribute no significance to this for three reasons: first, there is no obligation placed on a trade mark proprietor to sue any- and everyone that it considers is infringing its rights (although not to do so may give rise to limitation and acquiescence issues); secondly, the Applicant has raised (in my view for good reason) no legal argument based on acquiescence or undue delay; and, thirdly, there is no evidence before me that suggests that the Opponent has behaved other than as a diligent trade mark proprietor would when a third party applies to register a trade mark that it considers infringes or conflicts with its own.

66 It is appropriate to state at this juncture (although this is relevant to each of the grounds of opposition) that the registration of a company or business name, whether at ACRA in Singapore or at another company registry, accords as such to its owner no right to use of the name in the course of trade in Singapore, either as a company or business name or as an indication of the trade origin of a product or service offered for sale under or by reference to the name. At that point, its use may constitute passing off if it harms by deception the goodwill generated by a third party through an earlier use in trade of the name, or one similar to it; and it may also infringe a registered trade mark owned by another, especially where that trade mark is particularly distinctive of its owner’s products and/or services. In addition, if the company decides to seek registration under the Trade Marks Act of the company or business name in connection with particular goods or services, the owner of an earlier registered trade mark may decide, as in this case, to oppose its registration on one or more of the grounds of refusal

in the Act, and in that context its prior registration as a company or business name does not provide any justification.

Indicate a connection likely to damage the interests of the owner of the earlier trade mark

67 I have already found in relation to the ground of refusal contained in Section 8(2)(b) that there is a likelihood that confusion would result from the similarity between the Opponent's mark GUCCI and the Application Mark and the similarity of the goods in the specification for the Opponent's mark T8301755E and those contained in the Applicant's specification of goods. In the light of all the evidence, I find likewise under this ground of refusal that use of the Application Mark in relation to at least some, if not all, of the goods for which it is sought to be registered would be likely to be taken by the average consumer of those goods to indicate *some* trade connection (it need not understand what that trade connection is) with the owner of the earlier GUCCI mark that is well known in Singapore.

68 Such a misapprehension (that the Applicant's goods bearing the Application Mark are in some way connected with the Opponent's business) would inevitably result in damage to the Opponent's interests as it would mean that the Opponent would lose its present exclusivity in the use of the word GUCCI as a trade mark (as can be seen from the 30 separate registrations it owns in Singapore for the word GUCCI). In this connection, I set out the other 28 marks registered by the Opponent in Singapore in relation to the GUCCI mark.

Mark & Registration No.	Specification
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906909C</p>	<p>Class 2: Paints, varnishes, lacquers; colouring matters, dyestuffs; metals in foil and powder form for painters and decorators.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T7979400C</p>	<p>Class 3: Non-medicated toilet preparations, cosmetic preparations, perfumes, eau-de-cologne, soaps, dentifrices, preparations for the hair; anti-perspirants, depilatory preparations, and toilet articles included in Class 3.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8103249B</p>	<p>Class 6: Metal key-rings, metal buckles and other goods in non-precious metal, not included in other classes.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906910G</p>	<p>Class 8: Razors, cutlery, forks, spoons.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8205239Z</p>	<p>Class 9: Spectacles, glasses, sun glasses, calculators, all included in Class 9.</p>

Mark & Registration No.	Specification
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906911E</p>	<p>Class 12: Cars.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T7979401A</p>	<p>Class 14: Goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery and imitation jewellery, precious stones, horological and other chronometric instruments.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8404184J</p>	<p>Class 16: Books and booklets, playing cards, stationery, pen-cases, pens.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T7979402Z</p>	<p>Class 18: Articles of leather or imitation of leather and not included in other classes; trunks, suitcases, travelling cases, handbags, purses, wallets; umbrellas; parasols and walking sticks; whips, harness and saddlery.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906912C</p>	<p>Class 20: Furniture, mirrors, picture frames.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906913A</p>	<p>Class 22: Ropes, strings, nets, tents, awnings, tarpaulins, sails, sacks.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T7979403H</p>	<p>Class 25: Articles of outer clothing for men and women; knitwear; shirts, T-shirts, skirts, trousers, scarves, cravats, ties, hats, socks, shoes and belts for wear.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T7979884Z</p>	<p>Class 26: Belt clasps, necktie clasps (not of precious metal or coated therewith), clasps for clothes, and parts and fittings therefor, all included in Class 26.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906914Z</p>	<p>Class 27: Carpets, rugs, mats and matting; non-textile wall hangings.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8404185I</p>	<p>Class 28: Games, toys, playthings and sporting articles.</p>

Mark & Registration No.	Specification
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906915H</p>	<p>Class 29: Jams; jellies.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906916F</p>	<p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (except salad dressings); spices; ice.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8906917D</p>	<p>Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T8103250F</p>	<p>Class 34: Tobacco, raw or manufactured, cigarettes; smokers' articles, lighters for smokers; matches.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T1118836A</p>	<p>Class 35: The bringing together, for the benefit of others, of a variety of perfumery, cosmetic goods, clothing, footwear, headgear and accessories therefore, glasses, leather goods, watches, jewellery and stationery (excluding transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet and by means of telecommunications.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T9103395E</p>	<p>Class 35: Franchising advisory services; import-export agency and public relations services; advertising; business appraisals [sic]; business management assistance; marketing studies; all included in Class 35.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T9103396C</p>	<p>Class 36: Credit card and debit card services; insurance services; all included in Class 36.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T9103397A</p>	<p>Class 37: Repair of bags, handbags, leather goods, keyrings, jewellery, watches, clocks, eyewear, clothing, pens and of lighters; setting of gems; all included in Class 37.</p>
<p style="text-align: center;">GUCCI</p> <p>TM No. T9103398Z</p>	<p>Class 38: Message delivery and sending services, all included in Class 38.</p>

Mark & Registration No.	Specification
<p style="text-align: center;">GUCCI</p> <p style="text-align: center;">TM No. T9103025E</p>	<p>Class 39: Transportation [sic] of passengers and goods by road, rail and sea; warehousing of consumer goods; travel agency services; all included in Class 39.</p>
<p style="text-align: center;">GUCCI</p> <p style="text-align: center;">TM No. T9103400E</p>	<p>Class 40: Polishing of gems; glass blowing; dressmaking and tailoring; embroidery; engraving; treating of textiles; working and staining of leather; all included in Class 40.</p>
<p style="text-align: center;">GUCCI</p> <p style="text-align: center;">TM No. T9103401C</p>	<p>Class 41: Staff training services relating to the retail trade, all for others; included in Class 41.</p>
<p style="text-align: center;">GUCCI</p> <p style="text-align: center;">TM No. T9103402A</p>	<p>Class 42: Professional consultancy services relating to franchising; clothing rental; design of packaging; consultancy services relating to fashion and to cosmetics, beauty salon services; hotel, restaurant, bar and coffee shop services; provision of compground [sic] facilities; all included in Class 42.</p>

69 The wide range of goods and services in respect of which the GUCCI mark is registered illustrates the extent of the Opponent's actual or potential business activities and there is no challenge from the Applicant to the validity of any of these registered trade marks. Once again I emphasise that the word GUCCI is one that has no significance in Singapore other than as a trade mark belonging to the Opponent and that enviable position would be lost by the Opponent if the Application Mark were permitted to take its place on the register of trade marks. The fact that there are companies incorporated in Singapore, Indonesia and possibly elsewhere that use the word Gucci in their name neither detracts from the exclusivity that the Opponent has in the use of the word as a registered trade mark in Singapore nor means that the Opponent is not able to prevent such use were it so minded.

70 The ground of opposition under Section 8(4)(a) read with Section 8(4)(b)(i) therefore succeeds.

71 I now proceed to consider the ground of refusal contained in Section 8(4)(b)(ii)(A) and (B). As I have found already that an essential part of the Application Mark is identical or similar to the Opponent's GUCCI Marks (which necessarily means that the same applies to the Opponent's 28 other GUCCI marks registered in various classes in Singapore (see [68] above)), to succeed on this ground the Opponent must first of all establish on a balance of probability that the GUCCI marks are well known to the public at large in Singapore. The Applicant has, as I state above, put the Opponent to strict proof of this fact.

72 The status of being a trade mark that is well known to the public at large in Singapore was described by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 at [233] as “*coveted*” and is “*a rare and exclusive class.*” In deciding whether a particular trade mark falls in that class, it is necessary to take into account the evidence adduced in relation not only to the factors set out in Section 2(7) of the Act but also all other relevant evidence that goes to show that the mark in question has a “*much higher degree of recognition*” than is required to be “*well known in Singapore*” (which requires only that the mark be well known to a particular relevant sector of the public in Singapore).

73 The notoriety that I have found the GUCCI mark enjoys for retail services in Singapore has been enhanced by extensive advertising and promotion, as well as editorial coverage, for a wide range of products for both women and men (including clothing, footwear, jewellery, watches, leather wear and products such as bags, eyewear, fragrances, household products) in local newspapers and magazines such as Straits Times, Today, The Edge Singapore, Urban, Harper’s Bazaar Singapore, Elle Singapore, Her World Singapore, Female Singapore, Prestige, 8 Days, Style, Style Men, The Peak, Icon Singapore, Singapore Tatler, Esquire Singapore, August Man, Nanyou plus various other Chinese language publications such as Nüyou, and online *inter alia* at bagaholicboy.com, esquiresingapore.com, lofficielsingapore.com, herworldplus.com, luxury-insider.com, senatus.com, mens-folio.com, xinmsn.com, lifestyleasia.com, singaporetatler.com, asiatatler.com, as well as on blogs such as fash-eccentric. Copies of such advertising, promotion and editorial material published between 2009 and 2014 are included in Exhibit VV-4 to Volpi-1. (This exhibit also contains swathes of material that has no relevance to these proceedings or is needlessly excessive and duplicative, including (by way of only one example) copies of advertising campaigns for products marked “US only” and “Japan only”.)

74 In addition, the Opponent advertises and promotes its products on the leading social media platforms, including Facebook (16.2 million likes and 15.9 million likes), Instagram (17.8 million followers), Twitter (4.97 million followers) and YouTube (136,000 subscribers) (all figures as at 4 October 2017), see Volpi-1 at [33], the screenshots copies of which form Exhibit VV-5 to that declaration and the Opponent’s WS at [55]. The vast majority of these followers and subscribers are of course outside Singapore but the overall numbers do at least attest to how well known the GUCCI trade mark is globally.

75 Notwithstanding all the evidence adduced by the Opponent, at the hearing the Applicant’s counsel urged me to take into account the fact that the Opponent had not conducted and submitted in evidence a survey as to the degree to which the GUCCI trade mark is well known to the public at large in Singapore. I have taken this into account but conclude that it would have been a waste of money for the Opponent to have done so (and I commend the Opponent’s counsel for resisting this temptation). Once there is sufficient relevant evidence before the tribunal on the basis of which it can conclude that the GUCCI mark is well known to that degree, it is of no further assistance to adduce yet more. In my view, there is far more than sufficient evidence on which to find that the GUCCI trade mark is indeed a member of the rare and exclusive class of trade marks that is well known to the public at large in Singapore. It would be contrary not only to the weight of that evidence but also to corroborative common general knowledge (to borrow a term from patent law) to find otherwise. This

is not a case such as that considered by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [96] where the proprietor of the earlier mark had failed to adduce evidence of use or promotion sufficient to establish the distinctiveness necessary for a trade mark to be well known to the public at large in Singapore.

76 If allowed to proceed to registration, the Application Mark, the dominant part of which I have found is the whole of the word that comprises the Opponent GUCCI trade mark, would dilute the distinctiveness of the Opponent's marks by depriving the Opponent of the exclusivity it currently has in the registration and use of the word GUCCI as an indication of origin of goods and services. To adopt the definition of 'dilution' in Section 2(1) of the Act, there would be a "lessening of the capacity of the [Opponent's] trade mark to identify and distinguish goods or services". In addition, the Applicant would obtain an unfair advantage as a result of the misapprehension that those seeing its registered trade mark would harbour when seeing within it the word GUCCI and assuming, as I have found is likely, that there is some trade connection with the owner of the well known GUCCI trade mark. Thus, the ground of refusal under Section 8(4)(b)(ii) succeeds under both heads (A) and (B).

Conclusion on Section 8(4)

77 All limbs of the grounds of opposition under Section 8(4) therefore succeed.

Ground of Opposition under Section 8(7)(a)

78 Section 8(7)(a) of the Act reads:

“(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”.

Decision on Section 8(7)(a)

79 The Opponent relies on this ground of refusal as it argues that its GUCCI marks have generated a goodwill in Singapore that would be harmed by the misrepresentation in the marketplace that would be made through the use by the Applicant of the Application Mark in relation to all or any of the goods contained in the specification of goods. This, it contends, would be liable to be prevented through the law of passing off.

80 In considering a ground of appeal based on passing off the tribunal must conduct a notional exercise and decide whether, on the basis of the facts before it, a passing off action brought by the Opponent in respect of notional and fair use of the Application Mark would be likely (or, in the words of the provision, liable) to succeed.

81 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 (“*Singsung*”) affirmed that the requirements for a successful passing off action are the classical trinity of goodwill, misrepresentation and damage, at [28], while noting

that “the critical question, in cases involving a misrepresentation as to trade origin, is whether the defendant is putting forward goods, which it, in one way or another, is passing off as the plaintiff’s or as related to the plaintiff”, at [30].

82 As noted also by the Court of Appeal in *Singsung*, “[g]oodwill is the legal property that the law of passing off protects” and “goodwill, in the context of passing off, is concerned with goodwill in the business as a whole, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses”, at [32] and [34], respectively. Thus, in relation to this head of opposition (unlike the others previously considered) I must take into account not only particular earlier registered marks on which the Opponent has relied under other grounds but also the full extent of the Opponent’s position in the marketplace at the relevant time, including all of its use of the GUCCI mark in Singapore in relation to the full range of its products and services. In this context, I note (in addition to the 30 registered trade marks for the word GUCCI already referred to at [23] and [68] above) the Opponent’s ownership of a number of ‘GUCCI [plus]’ registered trade marks:

Mark & Registration No.	Specification
GUCCI TIMEPIECES TM No. T9902016Z	Class 14: Horological and chronometric instruments.
GUCCI RUSH TM No. T9812154Z	Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices; all included in Class 3.
GUCCI FLORA TM No. T1408673Z	Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.
GUCCI INTERLOCKING TM No. T1407486C	Class 14: Jewellery, precious stones; agates; jet, unwrought or semi-wrought; amulets [jewellery], anchors [clock and watch making]; rings [jewellery]; spun silver [silver wire]; silver, unwrought or beaten; barrels [clock and watch making]; pendulums [clock and watch making]; cuff links; bracelets [jewellery]; watch bands; busts of precious metal; watch cases; clock cases; watch chains; chains [jewellery]; charms [jewellery]; necklaces [jewellery]; chronographs [watches]; chronometers; stopwatches; chronoscopes; diamonds; tie clips; statuettes of precious metal; gold thread [jewellery]; wire of precious metal [jewellery]; silver thread; copper tokens; cloisonne jewellery; badges of precious metal; iridium; clock hands [clock and watch making]; alloys of precious metal; ingots of precious metals; movements for clocks and watches; medals; lockets [jewellery]; precious metals, unwrought or semi-wrought; watch springs; coins; works of art of precious metal; olivine [gems]; earrings; jewelry of yellow amber; ivory [jewellery]; ornaments [jewellery]; ornaments of jet; shoe ornaments of precious metal; hat ornaments of precious metal; gold, unwrought or beaten; clocks; atomic clocks; wristwatches; watches; master clocks;

Mark & Registration No.	Specification
	clocks and watches, electric; osmium; palladium; pearls made of ambroid [pressed amber]; pearls [jewellery]; beads for making jewelry; semi-precious stones; platinum [metal]; key rings [trinkets or fobs]; dials [clock and watch making]; sundials; rhodium; clockworks; ruthenium; boxes of precious metal; cases for clock- and watchmaking; jewelry cases [caskets]; cases for watches [presentation]; tie pins; pins [jewellery]; ornamental pins; brooches [jewellery]; spinel [precious stones]; statues of precious metal; paste jewellery; chronometrical instruments; alarm clocks; watch glasses.
GUCCI BAMBOO TM No. T1303364J	Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
GUCCI MUSEO FOREVER NOW TM No. T1302089A	Class 3: Soaps, perfumery, essential oils, preparations for body and beauty care.
GUCCI NICE TM No. T1301051I	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. Class 25: Clothing, footwear, headgear.
GUCCI GUILTY TM No. T1014527H	Class 3: Perfumeries, essential oils for use in the manufacture of scented products; cosmetics, namely eye make-up and facial make-up, non-medicated skin care preparations, namely, creams lotions, moisturizers, texturizers and toners; bath gel, shower gel, foam bath and personal deodorants; hair lotions, dentifrices, toilet soaps.

83 It is without question on the evidence (and the Applicant sensibly does not contest this) that the Opponent is the owner of valuable goodwill in Singapore built up over more than 40 years' use of its GUCCI marks on or in relation to a range of products and services.

84 In view of my finding that use by the Applicant of the Application Mark in relation to some or all of the goods in the specification of goods is likely to cause confusion or to wrongfully indicate a connection with the Opponent to whom the GUCCI marks belong, it is self-evident that such use would also constitute a misrepresentation that would lead to deception on the part of a substantial number of actual or prospective customers. By way of example of how such a misrepresentation may be made, I refer to the images submitted by the Applicant as part of its applications

to register the designs D2014/1045/G and D2014/1026/C in respect of a “cooker hob/stove” and which are included in the representation of the Registered Designs (copies of which form Exhibit TKP-4 to Tan-1), both of which bear the mark GUCCITECH (a close-up version of which is reproduced at [126] of the Opponent’s WS and I reproduce below). Despite the fact that the design registrations disclaim (design) protection for the word GUCCITECH, if such use of GUCCITECH (which is essentially the Application Mark without the non-distinctive strapline) were to occur in the actual marketplace in Singapore, I consider that the average consumer of either or both of the Opponent’s and Applicant’s goods would, by reason of the use of the mark GUCCITECH, be deceived into believing that there is some form of trade connection between the maker of such a product and the Opponent, to whom the 30 registered GUCCI marks belong.

D2014/1025/G	D2014/1026/C
	
	
 <p data-bbox="459 1568 579 1597" style="text-align: center;">Close-up</p>	 <p data-bbox="1013 1568 1133 1597" style="text-align: center;">Close-up</p>

85 For the avoidance of doubt, although it is true that all the circumstances of the notional passing off case (involving the Application Mark and the GUCCI marks) may be taken into account under Section 8(7)(a), I do not consider it is open to me to take into account the evidence adduced by the Opponent (at [150] to [152] of the Opponent’s WS) on the basis of which it contends that the Applicant’s associated company Gucci Tex International Pte Ltd has illegitimately used a device comprising a “GG” that is similar to what the Opponent describes as its “distinctive and well known interlocking “GG” logo” that has been registered as a trade mark in Singapore. This involves issues that may well be taken into account in an actual passing off action but the notional assessment under Section 8(7)(a) must necessarily be limited to all circumstances surrounding the comparison between the Application Mark and the GUCCI marks, and

whether or not Gucci Tex International Pte Ltd has engaged in passing off and/or trade mark infringement is not a matter I am in a position to make any comment on.

86 However, in the event of the Applicant using the Application Mark in relation to all or any of the goods contained in its specification of goods, I do consider there would be a “real tangible risk of substantial damage” being caused to the Opponent through such deception (as the Court of Appeal expressed the passing off requirement in *Singsung* at [41]).

87 Thus, I find that the Opponent has proved on a balance of probability that it could prevent in a passing off action use by the Applicant of the subject matter of the Application Mark in relation to all or any of the specification of goods.

Conclusion on Section 8(7)(a)

88 The ground of opposition under Section 8(7)(a) therefore succeeds.

Ground of Opposition under Section 7(6)

89 Section 7(6) of the Act reads:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

Decision on Section 7(6)

90 In *Wing Joo Loong Ginseng Hong (Singapore) Co Pte v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”), the Court of Appeal applied, at [107] to [117], a combined test for bad faith that involves consideration of both what the particular applicant knows and what ordinary persons adopting proper standards would think. However, as concluded by the Court of Appeal in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203, after a review of the authorities (including *Wing Joo Loong*) on the test for bad faith at [25] to [29]: “[i]n the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case”, at [29]. It is a serious claim that must be supported by the evidence, at [30].

91 The Applicant was incorporated as a company in Singapore in 2010 under a name that included the word GUCCI in its entirety. It registered designs in Singapore that bore a mark GUCCITECH (albeit disclaimed) that included in its entirety the word GUCCI and then decided to apply for a registered trade mark for that mark along with added matter (the words INNOVATION SAVES SPACE) of little or no inherent trade mark significance. In following this course of action, it seems from the submissions of its counsel at the hearing that the Applicant was encouraged by the Opponent’s failure since 2010 to object at any time to its company name. It pressed ahead with, first, its registered design applications bearing the mark (which were duly granted) and, secondly, made the application to register the Application Mark. The last step was a step too far for the Opponent and hence these proceedings.

92 The Applicant has at no point denied knowledge of the Opponent's trade mark GUCCI. It seems to have taken the view that its use of that word in its corporate name and later as part of its trade mark was neither unfair nor behaviour with which the Opponent would be concerned. If that was so, that view turns out to have been a mistaken one. When a trade mark is as well known as the Opponent's GUCCI trade mark, not just in Singapore but globally, its owner is given extensive rights by trade mark and unfair competition laws to prevent its unauthorised use as an indication of trade origin by third parties, notwithstanding any attempts by which those third parties may seek to disguise or justify their taking of that trade mark in its entirety for use on their own products.

93 In the light of all the evidence, it is clear that the Applicant was misguided in its belief there would be no consequence from its use of the word GUCCI and, in the vernacular, was willing to push the envelope to see how far it would stretch without breaking. It has now broken but I do not consider that the Applicant made the application in bad faith: it would have been stupid to have done so and there is no evidence before me from which I can impute stupidity. To the contrary, the Applicant seems to be a well-run business (and I would refer here to the detailed advice it took on its branding strategy from the Dutch design company, Pezy Group, which forms Exhibit TKP-5 to Tan-1), with significant design and marketing ability. It has gambled on how the law and the facts would be interpreted, as does any business that uses in whole or in part another's trade mark (particularly when it is one that is well known): although it has now lost, it was not so unreasonable a gamble as to justify a finding of bad faith. (Again, in relation to this ground, I should make clear that I ignore the Opponent's contentions regarding alleged behaviour of the Applicant's associated company (see [85] above) as this ground of refusal relates only to the Applicant's behaviour and state of mind).

Conclusion on Section 7(6)

94 The ground of opposition under Section 7(6) therefore fails.

Overall Conclusion

95 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds under Section 8(2)(b), under all the limbs of Section 8(4) and under Section 8(7)(a), but fails under Section 7(6).

96 The parties will have noted my comments concerning the extent and nature of the evidence adduced by the Opponent in this case. I consider it to have been, albeit perhaps unintentionally, a potentially oppressive use of the opposition procedure under the Act. In the circumstances, I consider it correct and fair to depart from the usual order in opposition proceedings under which costs are awarded to the successful opponent, and order that the parties bear their own costs in these proceedings.

97 Lest it be misunderstood, I attribute no blame at all for the state of affairs I describe above to counsel who appeared before me at the hearing, whose written and oral submissions I found succinct and helpful.

Date of Issue: 23 January 2018