

Intellectual Property Office of Singapore Case Summary: Guess?, Inc v Jen, Chi [2019] SGIPOS 3

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Guess?, Inc, the Opponent, opposed the registration of:



sought to be registered by Jen Chi, (the “Applicant”) for the following goods in Class 25:

Shirts; T-shirts; clothing; skirts; pants; raincoats; boots; shoes; bandanas (neckerchiefs); ties (for wear); hats; socks; gloves (clothing); belts (clothing); coats; aprons (clothing); sleep mask.

One of the main grounds of opposition was Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed). The Opponent relied on its following earlier marks, amongst others:

S/N	Opponent’s Earlier Marks	
1	Opponent’s Earlier Registered Device Mark	<u>Class 25</u>
		Articles of outer-clothing; vests; underpants and footwear being articles of clothing
2	Opponent’s Earlier Registered GUESS Mark	<u>Class 25</u>
		Men’s, women’s and children’s outerwear and underwear, jeans, shirts, jackets, vests, pants, sweaters, jumpsuits, shorts, hats, overalls, dresses, skirts, sweatshirts, t-shirts, sweatpants, neckties, brassieres, camisoles, bathing suits, sport coats, suits, robes, pyjamas, belts, briefs, coats, leotards, hosiery, gloves, pantyhose, scarves, ponchos, slippers, sun visors, tights and footwear.

To succeed under section 8(2)(b), the Opponent must establish (among other things) that the Application Mark is similar to the Opponent’s earlier marks. As the Registrar found that the Application Mark is more dissimilar than similar to each of the Opponent’s earlier marks, the opposition under section 8(2)(b) failed.

In view of the finding of dissimilarity, the ground of objection under section 8(4)(b)(i) also failed since one of the elements that must be satisfied is that “the whole or essential part of the trade mark must be identical or similar to an earlier mark”.¹ The Registrar was however prepared to hold that the **Opponent’s Earlier Registered GUESS Mark** is well known in Singapore.

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/2019/guess-v-jen-chi-2019-sgipos-3.pdf>.

¹ Which is essentially the same as the similar element under Section 8(2)(b).