

## Intellectual Property Office of Singapore Case Summary: Rolex S.A. v FMTM Distribution Ltd [2020] SGIPOS 6

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This is a trade mark dispute between two businesses in the watchmaking industry. The Applicant, FMTM Distribution Ltd, is part of the Franck Muller group, and applied to register “MARINER” (“the Application Mark”) in respect of watches and other specified goods in Class 14.

Rolex S.A., the Opponent, itself an established watchmaker, opposed the registration of the Application Mark. The Opponent’s essential argument is that “MARINER” is confusingly similar to its earlier trade mark “SUBMARINER” (“the Opponent’s Mark”), also in Class 14, in respect of horological instruments.

The IP Adjudicator allowed the opposition on the following grounds:

### (1) Confusing similarity under Section 8(2)(b) of the Trade Marks Act (“the Act”)

First, it was considered whether the two marks were more similar than dissimilar.

Visually, the IP Adjudicator assessed that the marks were of relatively similar lengths, were single words, and the entirety of the Application Mark was encompassed in the Opponent’s Mark. Aurally, the IP Adjudicator found that the two marks shared three identical (or at least very similar-sounding) syllables which formed a substantial part of the Opponent’s Mark, and the entirety of the Application Mark; and the only difference was the single syllable “Sub”. Conceptually, the IP Adjudicator was persuaded that both marks similarly convey the ideas of the sea and a sailor.

Thus, the Application Mark is more similar than dissimilar to the Opponent’s Mark.

The Applicant accepted at the hearing that the respective goods were similar. Hence, the last issue in dispute was whether, because of the marks-similarity and goods-similarity, there exists a likelihood of confusion on the part of the public.

Both parties accepted the Court of Appeal’s remarks in an earlier, unrelated case, that “*a watch is a product which is commonly available and purchased by the general public*”. The consideration was not confined to how *luxury* watches were typically purchased. The IP Adjudicator found that the public would exercise some care and good sense in making a watch purchase. However, the average consumer would not have specialist knowledge in relation to watches that he might bring to bear in making a purchase.

The IP Adjudicator concluded that there was a likelihood of confusion and the ground of opposition under Section 8(2)(b) of the Act succeeded.

### (2) Passing off under Section 8(7)(a) of the Act

The IP Adjudicator agreed with the Opponent that it had goodwill in its business in Singapore. Following the finding of likelihood of confusion in the ground under Section 8(2)(b), it was also determined that there was misrepresentation in the tort of passing off under Section 8(7)(a). The IP Adjudicator also found a real likelihood of damage to the Opponent’s goodwill because the parties are in direct competition with each other.

The elements of passing off were established and the ground of opposition under Section 8(7)(a) of the Act succeeded.

Since the opposition was successful, registration of the Application Mark was refused.

*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/2020/rolex-v-fmtm-distribution-2020-sgipos-6.pdf>.*