

HOW CLOSE IS J.ESTINA TO FESTINA ?

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Many a time clients have enquired whether a trademark search is necessary before they apply for a trademark registration. And many a time we have responded with a “Yes, it is highly advisable as it will ascertain whether the application will be a smooth and successful process or whether there will be a rocky road ahead, resulting in a refused registration”.

This case evidences that trademark searches are indeed necessary and that search results should be accompanied by a legal opinion from an experienced IP lawyer with regard to the similarity of the prior mark on the Register to the subject mark applied for. Festina Lotus S.A (“the Appellant”), founded in Switzerland in 1902, was a company that sold and distributed watches and was also the registered proprietor of two variants of trademarks registered in Singapore. The Appellant’s first and second marks are shown below:



FIRST MARK



SECOND MARK

Romanson Co. Ltd. (“the Respondent”) was a manufacturer that founded its business in 1998, ventured into the jewellery market in 2002, and only applied to have its mark registered in 2005. The Respondent’s mark is as set out below:



Having lost the opposition at Registry level, the Appellant appealed to the High Court of Singapore. The Court assessed the marks in dispute and was of the opinion that the two marks were conceptually very similar, based on the fact that the “crest” and “crown” found in the marks were both symbolical representations of status and class. The Court also found that the goods were similar not just to the Appellant’s first mark (which was registered under Class 14) but to the Appellant’s second mark as well (which was registered under Classes 9, 18 and 25) since all of these goods that were registered under the said Classes could be labelled as “fashion accessories”. Therefore the Court extended their scope to include goods that were registered in different classes as well.

Another issue that the Court also took into account was that of bad faith on the Respondent’s part. The Court held that the Respondent acted in bad faith because firstly, the Respondent knew of the Appellant’s presence in the market as the Appellant had a strong market presence in Hong Kong and Japan. Secondly, the Respondent claimed that its mark was conceptualized on a princess, namely Jovanna Estina but could not submit any evidence to support its claim that such a person even existed. As a result of this, the Court found there to be bad faith on the Respondent’s part and held that the Respondent had blatantly copied the Appellant’s mark. The Court decided the case in favour

of the Appellant and the mark  J.ESTINA was refused registration.

So next time, when asked “how close is too close?” between proposed marks and marks on the Register, this case will be a prime example to trademark applicants! This case also proves that failing to win at the opposition stage is not the end all to a registrant or owner of a prior mark. The High Court, upon appeal, may hold a different opinion to the Registrar at Singaporean IP Office.



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