

Managing Intellectual Property

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Jeffery West wins jWest spat

This was an opposition brought by Mark Richard Jeffery and Guy Anthony (the opponents), owners of the registered mark Jeffery-West in Class 25, against Nautical Concept (the applicant) who applied to register jWEST as a trade mark in Class 25 for similar goods (shoes and footwear).

The mark jWEST was opposed on various grounds and below is a summary of the successful grounds of opposition, the parties' relevant arguments and evidence submitted as well as the findings of the Principal Assistant Registrar (Registrar).

Bad faith

One of the main grounds for opposing the mark jWEST was bad faith. This stemmed from the fact that the applicant had past dealings with the opponents by virtue of having sold and/or distributed the opponents' shoes in Singapore. The opponents felt that the applicant had "copied the essential or prominent features of their mark". The applicant, on the other hand, argued that the mark jWEST was invented on the basis of its purported significance in relation to, among other things, the faith, family, a friend, business aspiration and place of residence of its managing director (who had also set up the applicant company).

The applicant further argued that it had applied to register the mark jWEST after discovering that the opponents had not filed for the mark JW or Jeffrey West in Singapore. The applicant claimed that it thought the opponents were no longer in business. This argument was rejected by the Registrar who explained that all the applicant had to do was make a call or send an email to the opponents confirming whether they had indeed gone out of business and to seek their consent to use the mark jWEST in Singapore.

In deciding whether there was bad faith, the Registrar applied the test of "the honest reasonable man". She felt that an honest reasonable man would have asked for the opponents' consent to use the mark jWEST, which would have shown that the applicant acted in good faith. The applicant's argument that the marks are not confusingly similar, and hence there can be no misappropriation of the mark, did not carry much weight with the Registrar having regard to the past dealings between the parties and the applicant's knowledge of the opponents' mark.

The Registrar also rejected the applicant's various explanations on the derivation of the mark jWEST and the reasons given for not having applied to register the mark much earlier than the opponents when it could have done so, especially since the mark jWEST meant so much to its managing director.

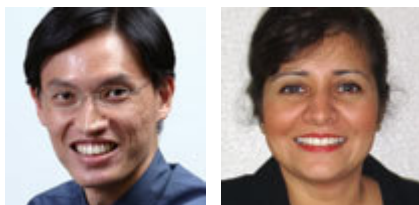
Confusing similarity of the marks

The opponents argued that the respective marks Jeffrey-West and jWEST (the latter appearing to be an abbreviation of the former) were confusingly similar. Further, the goods claimed in both applications were very similar, namely, shoes/footwear. In its defence, the applicant claimed that as it was selling only women's shoes, unlike the opponents, who were only selling men's shoes (a claim denied by the opponents), there was unlikely to be confusion in the marketplace.

Nonetheless, the Registrar's overall assessment was that the marks were visually, phonetically and conceptually more similar than dissimilar and it did not matter that the parties were selling shoes to different markets as both of their applications covered men's and women's footwear. Taking into account the Singaporean customer and the fact that the marks and goods were similar, the Registrar concluded that, if the opposed mark did proceed to registration, it was likely that the relevant shoe consumers would be confused.

The Registrar decided that there was sufficient evidence to convince her that the applicant's application was made in bad faith. She also decided that the respective marks and goods were of the requisite confusing similarity to be likely to cause confusion on the part of the public if the applicant's mark was allowed to proceed to registration. Consequently, the opponents' opposition succeeded before the Registrar.

The applicant appealed to the High Court against the Registrar's decision. At the time of writing, the appeal hearing had concluded and we now await the High Court's decision.



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