

Managing Intellectual Property

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High Court agrees that jWEST application was in bad faith

In the December/January issue of *MIP*, it was reported that opposition proceedings had been brought by Mark Richard Jeffery and Guy Anthony (the Opponents), owners of the trade mark Jeffery-West in Class 25 against Nautical Concept Pte Ltd (the Applicant), who applied to register the mark jWEST in Class 25. That article summarized the decision of the Principal Assistant Registrar (Registrar), who found that the application for jWEST was made in bad faith and that jWEST was confusingly similar to Jeffery-West.

The Applicant subsequently appealed to the High Court against the Registrar's decision. At the time the article was written, the hearing had concluded but we were waiting for the appeal decision.

This article is an update on developments in this case and in particular summarizes the Applicant's subsequent High Court appeal against the Registrar's decision.

At this appeal, the High Court considered two issues:

- Whether the jWEST mark was applied for in bad faith (section 7(6)); and
- Whether the marks Jeffery-West and jWEST were confusingly similar to each other (section 8(2)(b)).

Bad faith

The Judge referred to section 8(6) of the Trade Marks Act (TMA) to determine whether bad faith had existed in this case. Section 8(6) states that in deciding whether an application was made in bad faith, "it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier mark". Further, once bad faith is established, the applicant's mark will not be allowed to proceed further, even if the marks are not confusingly similar.

Upon hearing the arguments and evidence presented, the Judge agreed with the Registrar's observations and her conclusion that the application was made in bad faith, thus upholding the Registrar's ruling that the Opponents succeeded under section 7(6) of the TMA. The Judge was of the view that the Applicant's actions were not of the standards of "acceptable commercial behaviour observed by reasonable and experienced men".

Confusing similarity of the marks

The Judge agreed with the Registrar that the mark jWEST was "visually different" from Jeffery-West. However, he disagreed with the Registrar in respect of the aural similarity of the two marks. In this regard, the Judge found that both marks were not confusingly similar to each other and there was no credible evidence to show otherwise.

He went on to add that the average Singaporean was not likely to be confused between the two marks as there were enough differences between Jeffery-West and jWEST, including the price of the respective shoes, which are sold through separate channels.

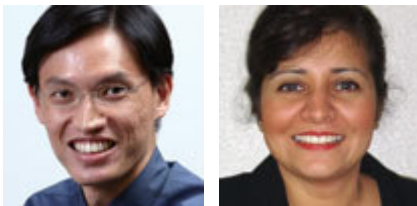
As such, the Judge overturned the Registrar's finding in ruling that the Opponents failed under section 8(2)(b).

The Rothmans test

Taking into account the recent case of *Rothmans of Pall Mall Limited v Maycolson International Ltd* (which was featured in the November 2006 issue of *MIP*), once an application is made in bad faith (regardless of whether the respective parties' marks in question are confusingly similar), the application will be refused registration. Similarly, in this latest case the Opponents have succeeded in preventing the Applicant from registering the mark jWEST in Singapore, on the basis of bad faith.

The consistent judicial sentiments represented by these two cases emphasize the point that to avoid an application from being refused due to bad faith, it is important for an applicant to bear in mind the test laid out in the *Rothmans* case. That is, they should take positive steps to make further enquiries before registering a mark. These enquiries may include trade mark conflict searches or even general internet searches. In the same case, the Court ruled that bad faith is "a distinct and independent argument" from the argument of confusing similarity of marks, which meant that a trade mark application would be refused if bad faith can be established.

At the time this article was written, no further appeal had been filed by either party.



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