

Client Alert

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Auction House Christie's Succeeds in Opposing Registration of Competitor's Chrित्रs Mark

Background

Chrित्रs Auction Pte Ltd (the "**Applicant**") sought to register the word mark "CHRITRS" (the "**Application Mark**") in Class 35 for "auctioneering services". Famed auction house Christie Manson & Woods Limited (the "**Opponent**") opposed the registration of the Application Mark based on the provisions in the Trade Marks Act ("**TMA**") relating to confusing similarity, well known marks, passing off and bad faith.

The Opponent succeeded on the ground that the Application Mark was applied for in bad faith with the Registrar rejecting the other grounds.


Decision


Confusing Similarity – Section 8(2)(b) of the TMA

To succeed on the grounds of confusing similarity, the Opponent sought to show that the Application Mark was identical/similar to the Opponent's prior mark; was to be registered in relation to similar goods/services, and that there existed a likelihood of confusion. Several of the Opponent's marks were relied upon and considered in turn.

CHRISTIE'S

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The Opponent's earlier mark  was registered in Class 35 for "auctioneering services" with a disclaimer of the word "Christie's", whereby registration of the mark gave the Opponent no right to the exclusive use of the word "Christie's". The Registrar noted that there were presently two lines of Registry cases which diverged as to the effect of disclaimers in opposition proceedings. Nevertheless, the Registrar ultimately held that disclaimers applied in opposition proceedings and as the only point of similarity with the Application Mark rested solely on the word "Christie's" which has been disclaimed, the opposition based on this mark failed.

The Registrar then considered the word mark "CHRISTIE'S" and  registered in Class 36 for, amongst others, real estate services and held that although real estate sales could be concluded via auctions, this was not the usual practice. In addition, Class 35 services are not normally cross-searched against prior marks in Class 36. In light of the above, the Registrar found that the Class 36 services which the Opponent's marks were registered for were not similar to the Applicant's Class 35 "auctioneering services".

The Registrar also considered if he could allow the Application Mark to be registered with the objectionable goods/services excised from the specification in the event that confusing similarity was only established in relation to some of the goods or services. While the Registrar noted that a lack of express language in the TMA permitting partial opposition seemed to suggest that partial opposition was not permissible, he noted that partial oppositions had been permitted in the UK, even though there is no express

provision for it in the UK Trade Marks Act. Nevertheless, the Registrar left the issue open to be decided for future cases.

Well known mark - Section 8(4) of the TMA

The Registrar accepted that "CHRISTIE'S" was well known to the relevant sector of the public in Singapore for auctioneering services. However, the Registrar held that the Opponent did not manage to establish that there was a confusing connection with the Application Mark, given the minimal similarity between the Opponent's various marks and the Applicant's mark.

The Opponent also relied on the grounds of a mark being "well known to the public at large in Singapore" which does not require proof of confusion. However, the Registrar found that the Opponent's revenue and advertising expenditure in Singapore fell short of establishing that the mark was well known to the public at large.

Passing off - Section 8(7)(a) of the TMA

Given that the Registrar found no likelihood of confusion between the Application Mark and the "CHRISTIE'S" mark, the passing off ground did not succeed.

Bad faith - Section 7(6) of the TMA

Nonetheless, the Registrar held that the application was made in bad faith and that the Application Mark should not be registered. In the present case, the Registrar found that the Opponent had established a prima facie case for the serious allegation of bad faith and had sufficiently supported this by evidence, for the following reasons:

- (a) It did not make sense for the Applicant to come up with an unpronounceable name for their business;
- (b) The substantial visual similarity between the Application Mark "CHRITRS" and the Opponent's "CHRISTIE'S" mark;
- (c) The Applicant's use of its Chinese name together with "CHRITRS";
- (d) The fact that the Applicant's initial Chinese name "佳士德" (pronounced "Jia Shi De") is phonetically identical to the Opponent's Chinese name "佳士得" (also pronounced "Jia Shi De") and the first two characters were identical. (The Applicant's Chinese name was later changed to "佳德" ("Jia De") following from related proceedings in Hong Kong); and
- (e) The fact that the Opponent's Chinese name is neither a translation or transliteration of CHRISTIE'S, which makes the Applicant's choice of a practically identical Chinese name all the more unbelievable.

In the given circumstances, if the Applicant had nothing to conceal, the Applicant's director and sole witness should have made full use of the opportunity at the hearing to vindicate the Applicant's creation and choice of the Application mark but he failed to do so. The Registrar therefore concluded that the Application Mark was applied for in bad faith. The Opponent therefore succeeded in opposing the Applicant Mark from proceeding to registration.

Comments

The Registrar's decision on the effect of a disclaimer is an important one. A proprietor of a mark that is subject to a disclaimer will have to be mindful of the limitation such a disclaimer would pose. Parties will also need to be mindful of the impact of not appearing to testify to defend their position when the opportunity has been afforded to do so.