





Intellectual Property Office of Singapore Case Summary: Valentino S.p.A. v Matsuda & Co [2020] SGIPOS 8

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Published: 7 August 2020

Where a business chooses as its trade mark (or one of its trade marks) a name, whether a given name, a surname or a combination of the two, that choice comes with a risk: that others may be able to use it (or them) in good faith without impinging upon the trade mark owner's rights.

This is a trade mark dispute between two businesses whose respective marks contain the word "Valentino", a relatively common name. The marks are set out below.

Application Mark	Opponent's Earlier Marks
	
	
	

The above marks relate to leather goods in Class 18 and clothing in Class 25, among others.

At the hearing, counsel for the Opponent focused primarily on the third of the Opponent's Earlier Marks above (the "Opponent's Composite Mark").

The IP Adjudicator considered the opposition on the following grounds:

(1) Confusing similarity under Section 8(2)(b) and Section 8(4) of the Trade Marks Act ("the Act")

At the first step, it was considered whether the respective marks were similar to each other.

Visually, the IP Adjudicator assessed that the marks were more dissimilar than similar taking into account the words and the logos in them. The IP Adjudicator also evaluated that the aural comparison of the marks was neutral and favoured neither party. Conceptually, the IP Adjudicator was persuaded that the marks were more dissimilar than similar. The dominant conceptual element of the Application Mark is the signature-style rendition of the name 'Valentino Rudy' which is combined with a distinctive square box device; different from the Opponent's Composite Mark.

Thus, overall, bearing in mind imperfect recollection by the average consumer, the Application Mark was found more dissimilar than similar to the Opponent's Composite Mark. In relation to the other two Opponent's Earlier Marks set out above, the Application Mark is even more dissimilar.

As the first element of marks-similarity was not made out, the inquiry ended at that stage without the need for the IP Adjudicator to determine the other elements under Section 8(2)(b) and Section 8(4) of the Act. These grounds of opposition failed.

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

The IP Adjudicator readily found that the Opponent had goodwill in its business in Singapore. Following the finding of a lack of marks-similarity in the ground under Section 8(2)(b), it was also determined that there was no misrepresentation in the tort of passing off under Section 8(7)(a).

The ground of opposition under Section 8(7)(a) of the Act thus also failed.

Accordingly, registration of the Application Mark was allowed.

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/valentino-v-matsuda-co-2020-sgipos-8.pdf>.