

## DIFFERENTIATING BETWEEN BRAND AND TRADE MARK

*City Chain v. Louis Vuitton Malletier*

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Defining a brand is like trying to catch a will-o'-the-wisp. Its meaning has been the subject of much debate in the world of advertising and marketing. But there is general agreement that “[a] brand is a set of associations linked to a name, mark, or symbol associated with a product or service”<sup>1</sup> and that brands “are created through a wide range of touch points; every time customers interact with a brand they form associations”.<sup>2</sup> One of its more obvious manifestations may be characterised by a logo, or in legal parlance, a trade mark. Interbrand, a leading brand consulting firm, publishes an annual ranking of global brands using a rigorous methodology that incorporates financial analysis of earnings and brand impact on consumption decision; the Louis Vuitton brand was ranked 16th in both 2008 and 2009, the highest ranking for a luxury fashion brand.<sup>3</sup> Another marketing research and consulting firm also accorded Louis Vuitton its highest luxury brand ranking, noting that “[a]ll the luxury brands score high on brand contribution, reflecting the tight bond they have with customers.”<sup>4</sup>

A trade mark is as functional as it is symbolic. The best and most successful brands are immediately recognised by their trade marks; but more importantly, they “can compress and express simple, complex and subtle emotions ... They have an immense emotional content and inspire loyalty beyond reason.”<sup>5</sup> As Lewinson J in the English High Court remarked in *O2 Holdings Ltd. (formerly O2 Ltd.) v. Hutchison*

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<sup>1</sup> Tim Calkins, “The Challenge of Branding” in Tim Calkins & Alice Tybout, eds., *Kellogg on Branding* (New Jersey: John Wiley & Sons, 2005) 1 at 1.

<sup>2</sup> *Ibid.* at 6.

<sup>3</sup> E.g., Interbrand, “Best Global Brands”, online: <[http://www.interbrand.com/best\\_global\\_brands.aspx](http://www.interbrand.com/best_global_brands.aspx)>. The rankings were also endorsed by Business Week, see Bloomberg Businessweek, “100 Best Global Brands”, online: <[http://bwnt.businessweek.com/interactive\\_reports/best\\_global\\_brands\\_2009/](http://bwnt.businessweek.com/interactive_reports/best_global_brands_2009/)>.

<sup>4</sup> See Millward Brown, “BrandZ Top 100 2009 Report”, online: <[http://www.millwardbrown.com/Libraries/Optimor\\_BrandZ\\_Files/2009\\_BrandZ\\_Top100\\_Report.sflb.ashx](http://www.millwardbrown.com/Libraries/Optimor_BrandZ_Files/2009_BrandZ_Top100_Report.sflb.ashx)>, in which Louis Vuitton was ranked 29th, but it was nonetheless the highest ranked luxury fashion brand, with its brand value almost three times more than the next highest luxury brand, Hermes.

<sup>5</sup> Wally Olins, *On B@nd* (Thames & Hudson, 2003) at 19.

*3G Ltd.:*

Brands are big business ... Defining a brand is not easy. A lawyer would tend to think of goodwill, trade marks and so on. But a brand includes more elements; such as image and reputation; the values that the brand owner tries to inculcate in the buying public. A brand is what customers choose to buy. Many decisions about brands are made by customers emotionally or intuitively rather than rationally.<sup>6</sup>

Thus, a well-known brand can have a significant “power of attraction”<sup>7</sup> with its “brand image [being] created in a number of ways: personal experience; word of mouth; how the brand is presented in stories in the media; packaging; point of sale display; retail staff; and, of course, advertising.”<sup>8</sup>

Recognising the essential function of a trade mark as a designation of source or origin does not, however, preclude an acknowledgment that a trade mark *may* have other functions.<sup>9</sup> The European Court of Justice (“ECJ”) noted that the “trade mark acquires a life of its own, making a statement ... about quality, reputation and even, in certain cases, a way of seeing life.”<sup>10</sup> Under Article 5(2) of the European Trade Marks Directive,<sup>11</sup> a third party who uses a sign similar to a trade mark with a reputation can be held to take “unfair advantage” of the mark, where such use gives that party an advantage in the marketing of his goods or services, notwithstanding that it does not give rise, as far as the public is concerned, to a likelihood of confusion or likelihood of detriment to the mark or to its proprietor.<sup>12</sup> Admittedly, such an approach blurs the distinction between the protection of the source-designating function of a trade mark and the brand values which are embodied by a trade mark.

In *City Chain Stores (S) Pte. Ltd. v. Louis Vuitton Malletier*,<sup>13</sup> the Court of Appeal of Singapore overturned a lower court’s decision,<sup>14</sup> finding that there was neither trade mark infringement nor dilution in the defendant’s use of a quatrefoil flower mark on a watch. The decision is important on two key counts: a sound rejection of a broader European approach which protects the brand values behind a trade mark, and a narrow interpretation of the meaning of a “well-known” mark in the context of a dilution claim.

<sup>6</sup> *O2 Holdings Ltd. (formerly O2 Ltd.) v. Hutchison 3G Ltd.*, [2006] EWHC 534 (Ch) at para. 4 [*O2 Holdings*].

<sup>7</sup> *Adidas-Salomon A.G. and Adidas-Benelux B.V. v. Fitnessworld Trading Ltd.*, C-408/01, [2004] F.S.R. 21, cited in *Intel Corporation Inc. v. CPM United Kingdom Ltd.*, [2007] EWCA Civ 431 at para. 18.

<sup>8</sup> *O2 Holdings*, *supra* note 4 at para. 5.

<sup>9</sup> E.g., Rochelle Cooper Dreyfuss, “Expressive Genericity: Trademarks as Language in the Pepsi Generation” (1990) 65 *Notre Dame L. Rev.* 397; Alex Kozinski, “Trademarks Unplugged” (1993) 68 *N.Y.U.L. Rev.* 960; Megan Richardson, “Trade Marks and Language” (2004) 26 *Sydney L. Rev.* 193.

<sup>10</sup> *Arsenal Football Club P.L.C. v. Reed*, C-206/01, [2003] Ch. 454 at para. 46 [*Arsenal*].

<sup>11</sup> EC, *First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks*, [1989] O.J. L 40/1. This has been superseded, with renumbering but no change of substance, by EC, *Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks*, [2008] O.J. L 299/25.

<sup>12</sup> *L’Oréal S.A. v. Bellure N.V.*, C-487/07, [2009] E.T.M.R. 55, 2009 WL 1704371 [*L’Oréal*].

<sup>13</sup> [2010] 1 Sing. L.R. 382 (C.A.) [*Louis Vuitton*].

<sup>14</sup> *Louis Vuitton Malletier v. City Chain Stores (S) Pte. Ltd.*, [2009] 2 Sing. L.R. (R.) 684 (H.C.).

At the heart of the dispute is the Flower Quatrefoil mark. This mark is one of four constituent elements that make up the Louis Vuitton Monogram Canvas design (“the Monogram”) which has been applied to Louis Vuitton’s goods since 1896. The Monogram was first registered as a trade mark in France in 1905 and is registered as a trade mark in Singapore in respect of a number of classes.

The appellant, City Chain, operates 360 stores and counters in Hong Kong, Macau, China, Thailand, Malaysia and Singapore. There are over thirty City Chain outlets in Singapore. In November 2006, City Chain launched a range of watches in Singapore bearing its own SOLVIL trade mark as well as decorative flower patterns on their dials and straps (“the Solvil watches”). These watches were later sold in other City Chain outlets in Asia. The Solvil Flower resembles, but is not identical to, Louis Vuitton’s Flower Quatrefoil. Moreover, these flowers are arranged in a randomly repeated fashion and are varied in size. The Louis Vuitton watch, bearing the Flower Quatrefoil mark as a randomly repeated pattern on the dial (“the Louis Vuitton watch”), had been sold in Singapore from 2004, but only at the three Louis Vuitton boutiques. The trial judge was of the view that the Solvil watch could easily be mistaken for the Louis Vuitton watch at a glance when worn on the wrist as people did not generally scrutinise another person’s watch at close range.

Louis Vuitton alleged trade mark infringement under sections 27(1) and 27(2) of the *Trade Marks Act*,<sup>15</sup> trade mark dilution under sections 55(3) and 55(4),<sup>16</sup> and passing off under the common law. Although Singapore’s trade mark legislation is based on the *Trade Marks Act 1994* (U.K.),<sup>17</sup> the Court of Appeal pointed out that the courts in Singapore were not bound by the determinations of the ECJ.

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<sup>15</sup> Cap. 332, 2005 Rev. Ed. Sing. s. 27(1) states that:

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

s. 27(2) states that:

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because –

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.

<sup>16</sup> s. 55(3) states that:

... the proprietor of a well known trade mark shall be entitled to restrain by injunction the use in Singapore, in the course of trade and without the proprietor’s consent, of any trade mark ... where the use of the trade mark –

...

- (i) would cause dilution in an unfair manner of the distinctive character of the proprietor’s trade mark; or
- (ii) would take unfair advantage of the distinctive character of the proprietor’s trade mark.

<sup>17</sup> As one of the main purposes of the 1994 U.K. Act was to implement the *First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks*, it was observed that authoritative guidance on the interpretation of the U.K. Act would have to come from the European Court of Justice: *Louis Vuitton*, *supra* note 13 at 389.

The Court of Appeal considered a number of decisions from different jurisdictions, in particular the U.K.<sup>18</sup> and ECJ cases,<sup>19</sup> before finally deciding to adopt the narrow view that trade mark use is required for trade mark infringement. The Court observed that in the “broader Community approach” taken by the ECJ,

where a sign is used other than as an indication of origin (and, perhaps, is descriptive) ...the court may nonetheless conclude that, taking all relevant matters into account, the use will have an adverse impact on the functions of the mark including its essential function.<sup>20</sup>

The Court also acknowledged that this broader approach “has the advantage of greater flexibility in allowing the courts to achieve justice in individual cases.”<sup>21</sup> However, the unanimous opinion shared Lord Walker’s concerns in *R. v. Johnstone* that “the broader Community approach could lead to uncertainty in determining when the third party’s use would affect or was likely to affect the functions of the trade mark.”<sup>22</sup> In particular, the Court relied on law professor Ng-Loy Wee Loon’s arguments in its rejection of the Community approach,<sup>23</sup> but intimated that “for the purposes of the present appeal, whichever approach we adopt, the same result will be obtained.”<sup>24</sup>

On the facts, the Court found that “the predominant use of the Solvil Flower [on the watches] is for decorative purposes ...[and] is not trade mark use.”<sup>25</sup> Hence on the stricter approach, there was no trade mark infringement. Even on the broader Community approach, it was held that although the Solvil Flower was similar though not identical to the Louis Vuitton Flower Quatrefoil mark, there was no likelihood of confusion capable of sustaining the plaintiff’s trade mark infringement claim. In determining whether there was a likelihood of confusion on the part of the public, the Court construed the “average consumer” as the “general public”,<sup>26</sup> but also referred to the “target consumers” of both the Solvil and the Louis Vuitton watches.<sup>27</sup>

In respect of the trade mark dilution claim, the Flower Quatrefoil mark did not meet the stringent threshold requirement of a “well known” mark under sections 55(3)(b)(i) and 55(4)(b)(i) of the *Trade Marks Act*. When determining whether a trade mark is “well known to the public at large in Singapore”, the courts must have regard to section 2(7) of the Act, which enumerates a number of factors to be considered, like the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore and the duration, extent and geographical

<sup>18</sup> *E.g.*, *Arsenal Football Club P.L.C. v. Reed*, [2003] R.P.C. 39; *R. v. Johnstone*, [2003] F.S.R. 42 [*Johnstone*]; *Rxworks Ltd. v. Dr. Paul Hunter*, [2008] R.P.C. 13 [*Rxworks Ltd.*]; *Whirlpool Corp. v. Kenwood Ltd.*, [2009] R.P.C. 2; *L’Oréal S.A. v. eBay International A.G.*, [2009] EWHC 1094 (Ch).

<sup>19</sup> *E.g.*, *Arsenal*, *supra* note 10; *Anheuser-Busch Inc. v. Budejovický Budvar, Národní Podnik*, [2005] E.T.M.R. 27; *Adam Opel A.G. v. Autec A.G.*, [2007] E.T.M.R. 33; *Celine S.a.r.l. v. Celine S.A.*, [2007] E.T.M.R. 80; *L’Oréal S.A. v. Bellure N.V.*, [2008] E.T.M.R. 1.

<sup>20</sup> *Rxworks Ltd.*, *supra* note 18 at para. 53, cited in *Louis Vuitton*, *supra* note 13 at 394.

<sup>21</sup> *Louis Vuitton*, *ibid.*

<sup>22</sup> *Ibid.* at 395. See also *Johnstone*, *supra* note 18 at paras. 86-87.

<sup>23</sup> *E.g.*, Ng-Loy Wee Loon, “Time to Re-think the Ever Expanding Concept of Trade Marks?” [2008] *Eur. I.P. Rev.* 151; Tan Tee Jim & Ng-Loy Wee Loon, “Intellectual Property Law” (2005) 6 *Sing. Ac. L. Ann. Rev.* 334.

<sup>24</sup> *Louis Vuitton*, *supra* note 13 at 398.

<sup>25</sup> *Ibid.* at 399.

<sup>26</sup> *Ibid.* at 402.

<sup>27</sup> *Ibid.* at 404.

area of any use of the trade mark. Remarking that the Singapore approach “would be in line with the US approach in determining famous marks”,<sup>28</sup> the Court held:

there is no evidence of the degree to which the Flower Quatrefoil mark on its own is known to, or recognised by, any relevant sector of the public in Singapore; there is no evidence that the Flower Quatrefoil mark has been used on its own as a trade mark; there was limited promotion of the Flower Quatrefoil mark on watches; and there is no evidence of any value associated with the Flower Quatrefoil mark.<sup>29</sup>

Regarding the passing off claim, a narrow interpretation of goodwill was adopted. Relying on a number of its previous decisions on name marks, the Court held that “it is not sufficient to establish goodwill in the Louis Vuitton brand generally, but rather, goodwill in the Flower Quatrefoil mark must be proved.”<sup>30</sup> While local goodwill might subsist in the Louis Vuitton Monogram in its entirety, the requisite goodwill had to be established in respect of its constituent elements—especially in the Flower Quatrefoil—in a passing off claim. Based on the sales information available, as well as the limited advertisements in Singapore magazines, the Court found that “there is no evidence to show that the goodwill in the watches was on account of the Flower Quatrefoil mark as opposed to other marks on the ... watches such as the LOUIS VUITTON mark.”<sup>31</sup> On the issue of misrepresentation, it was held that Louis Vuitton’s goodwill in relation to the Flower Quatrefoil mark would be “limited largely to those of a high income level who would have been exposed to the Respondent’s advertising and/or once-in-a-lifetime customers and aspirants who would save up to buy the Respondent’s products.”<sup>32</sup> As such, misrepresentation had to be analysed *not* from the perspective of the general public, but from the perspective of these relevant customer segments. Given the differences in the marketing and sale of the Solvil and Louis Vuitton watches, there could be no likelihood of misrepresentation leading to confusion.<sup>33</sup> The fact that the general public might from a distance mistake a Solvil watch for a Louis Vuitton was a wholly irrelevant consideration.<sup>34</sup>

In summary, what was ultimately fatal to Louis Vuitton’s claims was the fact that “the Flower Quatrefoil mark has always been used and linked to the Monogram and/or LOUIS VUITTON marks and there is no evidence that the Flower Quatrefoil mark was ever used on its own.”<sup>35</sup> The Flower Quatrefoil mark had rarely been used in isolation from the LV mark, LOUIS VUITTON mark or the Monogram mark. What this decision has demonstrated is the reluctance of the highest appellate court in Singapore to extend broad protection to brand values, relying on strict interpretations of “use as a trade mark”, “well known mark” and “goodwill”. Perhaps this decision augurs well for small and medium enterprises in Singapore’s pro-competition climate, but it does not encourage creativity in design. Fashion aficionados know at a glance

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<sup>28</sup> *Ibid.* at 414.

<sup>29</sup> *Ibid.*

<sup>30</sup> *Ibid.* at 406. See also *Tong Guan Food Products Pte. Ltd. v. Hoe Huat Hng Foodstuff Pte. Ltd.*, [1991] 1 Sing. L.R. (R.) 903; *Da Vinci Collection Pte. Ltd. v. Richemont International S.A.*, [2006] 3 Sing. L.R. (R.) 560.

<sup>31</sup> *Louis Vuitton*, *ibid.* at 405-06.

<sup>32</sup> *Ibid.* at 409.

<sup>33</sup> *Ibid.* at 410.

<sup>34</sup> *Ibid.* at 409.

<sup>35</sup> *Ibid.* at 414-15.

that the visual similarity between the Solvil watch and the Louis Vuitton watch is more than mere coincidence; the use of the four-point Solvil Flower in a random pattern on the dial is a studied imitation of the use of the Flower Quatrefoil mark on the dial of the Louis Vuitton watch. The dismissal of Louis Vuitton's claims has given City Chain a free-ride to trade on the star aura of Louis Vuitton. One may argue that City Chain has been accorded an unfair commercial advantage: instead of having to go through the effort and expense of developing and creating its own unique designs, it can simply take the easier route of making tweaks to the designs of a famous luxury brand. Commentator Bonita Trimmer points out that:

if another business can take advantage of a mark's positive image, rubbing some of its 'power of attraction' onto itself, without having to make the investment the trade mark owner has made to create it, it may well, again, be tempted to do so.<sup>36</sup>

It is interesting to note that in 2009, Gucci commenced similar actions against Guess? Inc. in New York for, *inter alia*, trade mark infringement, trade mark dilution and false designation of origin under section 43(a) of the *Lanham Act*.<sup>37</sup> Guess? had launched a comprehensive range of bags, wallets and shoes with patterns similar to Gucci registered marks, like the Interlocking GG, Stylised G and Green-Red-Green Stripe marks. Gucci's statement of claim filed with the New York District Court relied on the rationales of misappropriation of skill and labour and unfair competition in seeking an injunction and other compensatory relief.

A trade mark is often identified by distinctive visual elements; it embodies a bundle of affective values for the consumer, and its meaning is shaped by producers and consumers. Commentator Jennifer Davis argues that in the case of the brand values which attach to certain marks, they have been "nurtured by the proprietor and, as such, the question is not whether they belong in the public domain, but to what extent they may be protected through trade mark registration".<sup>38</sup> The protection for well-known trade marks is increasingly extending beyond their meaning as badges of origin. In the United States, despite the availability of trade mark dilution actions,<sup>39</sup> free speech considerations often trump the proprietary interests of trade

<sup>36</sup> Bonita Trimmer, "The Power of Attraction: Do Trade Marks have an 'Image' Problem in the English Courts?" [2009] Eur. I.P. Rev. 195 at 197.

<sup>37</sup> Complaint: Gucci America Inc. v. Guess? Inc. and Guess? Italia S.r.l., Filed United States District Court, Southern District of New York, 6 May 2009, online: <<http://www.scribd.com/doc/15036303/Complaint-Gucci-v-Guess>>.

<sup>38</sup> Jennifer Davis, "Between a Sign and a Brand: Mapping the Boundaries of a Registered Trade Mark in European Union Trade Mark Law" in Lionel Bently, Jennifer Davis & Jane C. Ginsburg, eds., *Trade Marks and Brands: An Interdisciplinary Critique* (New York: Cambridge University Press, 2008) 65 at 81-82 [Davis, "Between a Sign and a Brand"]. *Contra* Rosemary Coombe, "Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue" (1991) 69 Tex. L. Rev. 1853 at 1876 (arguing that trade mark owners have "the ability to restrict and control meaning" because they "own" the sign).

<sup>39</sup> See *Trademark Dilution Revision Act 2006*, Pub. L. No. 109-312, § 2, 120 Stat. 1730 at 1730-32 (2006) (amending 15 U.S.C. § 1125(c) (1946)):

Subject to the principles of equity, the owner of a famous mark that is distinctive ... shall be entitled to an injunction against another person who ... commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

mark owners,<sup>40</sup> as evident in the repeated failure of Mattel to protect the Barbie mark<sup>41</sup> and in cases like *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*<sup>42</sup> and *Hormel Foods Corp. v. Jim Henson Productions*.<sup>43</sup> However, the ECJ appears willing to extend protection to the brand values which might be embodied in a trade mark beyond its source designation function, as demonstrated in the *Arsenal* case.<sup>44</sup> The “communication functions” of a mark, especially well-known trade marks with a reputation, are becoming increasingly important in Strasbourg jurisprudence.<sup>45</sup> Such developments were welcomed by a number of academic commentators<sup>46</sup> but at the same time, they have garnered a fair share of criticisms.<sup>47</sup> More recently, the ECJ in *L'Oréal S.A. v. Bellure N.V.* held that:

the taking of unfair advantage of the distinctive character or the repute of a mark ... does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor.<sup>48</sup>

The Court noted that:

As regards the concept of “taking unfair advantage of the distinctive character or the repute of the trade mark”, also referred to as “parasitism” or “free-riding”, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign.<sup>49</sup>

In interpreting Article 5(2) of the European Trade Marks Directive, the ECJ was of the view that an infringing use of a well-known mark might occur by any one of the following: blurring, tarnishment or parasitism (taking unfair advantage or free-riding).<sup>50</sup> With regard to parasitism, the ECJ exhibited a strong reliance on an unjust

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The Act incorporates robust First Amendment protections that render non-actionable, *inter alia*, uses that parody, criticise or comment on the famous mark owner. *Lanham Act* § 43(c)(3)(A)(ii), 15 U.S.C. § 1125(c)(3)(A)(ii) (2006).

<sup>40</sup> See Richardson, *supra* note 9 at 219: “the results are perverse if all expressive uses no matter how meager their contribution to social discourse, how destructive they may be to a trade mark’s integrity or imagery, and how commercial their flavour now find exemption.”

<sup>41</sup> *E.g.*, *Mattel Inc. v. MCA Records Inc.*, 296 F.3d 894 (9th Cir. 2002); *Mattel Inc. v. Pitt*, 229 F. Supp.2d 315 (S.D. N.Y. 2002); *Mattel Inc. v. Walking Mountains Productions*, 353 F.3d 792 (9th Cir. 2003).

<sup>42</sup> 507 F.3d 252 (4th Cir. 2007).

<sup>43</sup> 73 F.3d 497 (2nd Cir. 1996).

<sup>44</sup> Davis, “Between a Sign and a Brand”, *supra* note 38 at 86–87. See *Arsenal*, *supra* note 10. See also Jennifer Davis, “To Protect or Serve? European Trade Mark Law and the Decline of Public Interest” (2003) 25 Eur. I.P. Rev. 180.

<sup>45</sup> *E.g.*, Trimmer, *supra* note 36; Christopher Morcom, “L’Oreal v Bellure—Who Has Won?” [2009] Eur. I.P. Rev. 627.

<sup>46</sup> *E.g.*, Helen Norman, “Time to Blow the Whistle on Trade Mark Use” [2004] 1 Intellectual Property Quarterly 1; Robert Sumroy & Carina Badger, “Infringing ‘Use in the Course of Trade’, Trade Mark Use and the Essential Function of the Trade Mark” in Jeremy Phillips & Ilanah Simon, eds., *Trade Mark Use* (Oxford University Press, 2005) 164.

<sup>47</sup> *E.g.*, Ng-Loy Wee Loon, *supra* note 23.

<sup>48</sup> *L’Oréal*, *supra* note 12 at para. 81.

<sup>49</sup> *Ibid.* at para. 41.

<sup>50</sup> *Ibid.* at paras. 38–43.

enrichment rationale:

an advantage [is] taken unfairly by that third party of the distinctive character or the repute of the mark ... [when] that party seeks by that use to ride on the coat-tails of the mark ... in order to benefit from the power of attraction, the reputation and the prestige of that mark...<sup>51</sup>

The Office of Harmonisation for the Internal Market (OHIM) Board of Appeal was of the view that:

As to unfair advantage ... that is taken when another undertaking exploits the ... repute of the earlier mark to the benefit of its own marketing efforts. In that situation that undertaking effectively uses the renowned mark as a vehicle for generating consumer interest in its own products.<sup>52</sup>

It appears that recent European developments in trade mark laws have embraced the idea that encoded meanings can confer on a trade mark a set of brand values which are worthy of protection.<sup>53</sup> A consumer does not buy a product; he or she buys a brand that promises an expectation. Scholars have also contended that from the consumer perspective, the brand overwhelms the trade mark. Jonathan Schroeder, whose research focuses on the production and consumption of images, remarks that “[c]ontemporary branding’s reliance on visual images implies rethinking legal perspectives on trade marks.”<sup>54</sup> Similarly, Trimmer has also urged the courts to “modernise their perception of where the real value in trade marks lie and become just a little more image conscious”.<sup>55</sup>

With Louis Vuitton being consistently ranked as the most valuable luxury brand in the world,<sup>56</sup> it is not surprising that the company is so aggressively seeking to enforce its intellectual property rights.<sup>57</sup> After the Court of Appeal handed down its decision against Louis Vuitton, there has been a concerted effort to increase awareness of the Flower Quatrefoil mark in Singapore; it is prominently employed on its own on the façade of the Louis Vuitton boutiques in Singapore today. There is no doubt

<sup>51</sup> *Ibid.* at para. 50.

<sup>52</sup> *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, [2005] E.T.M.R. 5 at para. 19.

<sup>53</sup> *E.g.*, *L’Oréal*, *supra* note 12; *Arsenal*, *supra* note 19. *Contra O2 Holdings*, *supra* note 6 at para. 7. See also a more recent discussion by the English Court of Appeal in *Whirlpool Corp. v. Kenwood Ltd.*, [2009] EWCA Civ 753 at paras. 136-38.

<sup>54</sup> Jonathan E. Schroeder, “Brand Culture: Trade Marks, Marketing and Consumption” in Lionel Bently, Jennifer Davis & Jane C. Ginsburg, eds., *Trade Marks and Brands: An Interdisciplinary Critique* (New York: Cambridge University Press, 2008) 161 at 162.

<sup>55</sup> Trimmer, *supra* note 36 at 201.

<sup>56</sup> *E.g.*, *Millward Brown*, *supra* note 4; *Interbrand*, *supra* note 3.

<sup>57</sup> *E.g.*, *Louis Vuitton Malletier S.A. v. Akanoc Solutions, Inc.*, 591 F. Supp.2d 1098 (N.D. Cal. 2008); *Louis Vuitton Malletier S.A. v. Dooney & Bourke Inc.*, 454 F.3d 108 (2nd Cir. 2006); *Louis Vuitton Malletier v. eBay Inc.*, No. 2006077799 (Paris Commercial Court, Première Chambre B, 30 June 2008); *Louis Vuitton Malletier S.A. v. Bags O’Fun Inc.*, 2002 FCT 78, [2002] 2 F.C. D-34; *Louis Vuitton Malletier S.A. v. Toea Pty. Ltd.*, [2006] FCA 144. See also Complaint: *Louis Vuitton Malletier S.A. v. Hyundai Motor America*, Filed United States District Court, Southern District of New York, 26 February 2010, online: <<http://www.scribd.com/doc/27694336/Complaint-LV-Hyundai>>; Jim Edwards, “Louis Vuitton’s Suit Against Hyundai’s Super Bowl Ad Is So Ridiculous It May Just Win” (2 March 2010), online: BNET <<http://industry.bnet.com/advertising/10005854/louis-vuittons-suit-against-hyundai-super-bowl-ad-is-so-ridiculous-it-may-just-win/>>.

that the Court of Appeal was correct in its rejection of ECJ jurisprudence, as trade mark laws in Singapore do not have the equivalent of Article 5(2) of the European Trade Marks Directive that prohibits unfair competition. But given the Singapore Government's present enthusiasm for brand building,<sup>58</sup> perhaps it is the right time to consider enacting a similar provision.

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<sup>58</sup> See *e.g.*, Singapore Brand Conference, online: <<http://www.singaporebrand.org/>>; Inderjit Singh, Address (Singapore Brand Conference 2010, 25 March 2010), online: Spring Singapore <<http://www.spring.gov.sg/NewsEvents/PS/Pages/Speech-by-Mr-Inderjit-Singh-at-the-Singapore-Brand-Conference-2010-20100325.aspx>>; Singapore Prestige Brand Award, online: <<http://www.spba.com.sg/award.html>>.